

Patent Cooperation Treaty (PCT) Working Group

**Fifth Session
Geneva, May 29 to June 1, 2012**

IMPLEMENTATION OF RECOMMENDATIONS TO IMPROVE THE FUNCTIONING OF THE PCT

Document prepared by the International Bureau

SUMMARY

1. This document summarizes work which has been done or is under way related to the implementation of the PCT Roadmap recommendations. Items which appear to require specific consideration by the Working Group at this stage are the subject of separate documents, referred to below.

INTRODUCTION

2. The PCT Working Group, at its third session held in Geneva from June 14 to 18, 2010, endorsed a series of recommendations to improve the functioning of the PCT system ("PCT Roadmap recommendations"), based on a study prepared by the International Bureau (document PCT/WG/3/2) and related submissions from certain Member States (documents PCT/WG/3/5 and PCT/WG/3/13). The discussions by the Working Group are outlined in the report of the session (document PCT/WG/3/14 Rev., paragraphs 14 to 137), which was noted by the PCT Assembly at its forty-first (24th Extraordinary) session held in Geneva from September 20 to 29, 2010 (see paragraphs 5 to 38 of document PCT/A/41/4).

3. A report on the status of the implementation of the recommendations (document PCT/WG/4/3) was discussed at the fourth session of the Working Group, held in Geneva from June 6 to 10, 2011 (see paragraphs 31 to 71 of document PCT/WG/4/17). A consolidated list of all the recommendations can be found in the Annex to document PCT/WG/4/3.

4. Details on the implementation of many of the recommendations are provided in other documents prepared by the International Bureau for this session of the Working Group, in particular, documents PCT/WG/5/4, 5, 6 and 7. The present document provides an update on some of the activities by Member States and the International Bureau towards implementation of recommendations not covered in any of the other documents prepared for this session.

OVERVIEW

5. The PCT Roadmap as expressed in documents PCT/WG/2/3 and PCT/WG/3/2 included a number of specific recommendations. However, the essential underlying theme was to review what the Treaty was trying to achieve for the benefit of all interested parties: applicants, national Offices, third parties and civil society more generally, and to encourage users of the system to take steps to improve the results. For the most part, this was not a matter of changing the Treaty or Regulations, but of taking administrative and technical steps to improve the implementation of what was already mandated.

6. As such, while significant progress has been made towards implementing many of the recommendations, the major achievements of the process can be seen in more general terms, including the following:

(a) The importance of PCT work product quality (especially international search reports and written opinions, but also the administrative processing at the International Bureau and national receiving Offices which supports this work) now features very prominently on the PCT agenda.

(b) In turn, the role of the PCT system and especially the importance of the quality of PCT work products is more widely recognized in discussions outside of the PCT context, both nationally in terms of seeking to make national patent systems more responsive to national policy needs by encouraging use of the system by nationals and residents and by appropriate integration of PCT work products into national patent granting procedures, and internationally in terms of the improving the functioning of the international patent system as a whole.

(c) The PCT's role in the effective dissemination of technical information, both directly and by supporting broader initiatives, has been examined, focused and brought more effectively to the attention of interested parties.

(d) There is greater understanding of the concerns and needs of Contracting States in relation to the quality of international applications and PCT work products, and of the capacity of Contracting States, both developed and developing, to perform their own effective search and examination, and the needs for continued technical assistance for developing and least developed countries in that regard.

7. In addition to consideration of matters arising from the recommendations considered so far, Member States should continue to consider what else should be done to further the aims of the Treaty and, where it is in their own power, to take appropriate action, or else to bring proposals and issues for discussion to the attention of the Working Group.

RECOMMENDATIONS RELATED TO BACKLOGS; IMPROVING THE QUALITY OF GRANTED PATENTS

Content of International Search Reports, Written Opinions and International Preliminary Reports on Patentability

8. In order to advance the discussions on how to improve the content of international search reports, written opinions and international preliminary examination reports, in particular with a view to increasing their usefulness for designated Offices, the International Bureau issued Circular C. PCT 1326, dated December 16, 2011, inviting PCT stakeholders to comment on proposed modifications to the PCT International Search and Preliminary Examination Guidelines aimed at providing further guidance on the inclusion of observations on clarity and support. The proposals were also discussed by the Meeting of International Authorities (PCT/MIA) at its nineteenth session held in February 2012. The proposals were generally welcomed by both the recipients of Circular C.PCT 1326 and by International Authorities. A further Circular will be issued shortly to consult on a broader package of proposed modifications to the Guidelines, incorporating a revised version of the proposed modifications, taking into account the responses received in reply to Circular C.PCT 1326 and the comments made by International Authorities at the nineteenth session of the PCT/MIA (see paragraphs 29 to 34 and Annex III of document PCT/MIA/19/14 Prov.).

9. The use of standardized clauses in written opinions and international preliminary reports on patentability have the potential to further facilitate the understanding of issues raised in those opinions and reports, providing benefit to the applicant, third parties and designated Offices during the examination of the application in the national phase. The Quality Subgroup of the PCT/MIA at its second informal session, held in February 2012, agreed to commence a pilot project aimed at developing model clauses in a limited area and at identifying general principles that could be used in the formulation of further clauses (see paragraphs 12 and 13 of the Annex to the Summary by the Chair, document PCT/MIA/19/13, reproduced in the Annex to document PCT/WG/5/2).

Availability of National Search and Examination Reports

10. The International Bureau offers various systems allowing the sharing of national search and examination reports. These include the PATENTSCOPE database for making reports available publicly and the WIPO CASE (Centralized Access to Search and Examination results) platform for exchanging dossier information privately between specific groups of Offices. Further information is provided in paragraphs 22 to 31 of document PCT/WG/5/6.

Third Party Observations

11. Document PCT/WG/5/7 contains an update on the implementation of the third party observations system due to go live on July 1, 2012.

The Surge in Worldwide Patent Applications

12. Document PCT/WG/5/4 contains a supplement to the study "The Surge in Worldwide Patent Applications" (document PCT/WG/4/4), as requested by the fourth session of the Working Group.

RECOMMENDATIONS RELATED TO TIMELINESS IN THE INTERNATIONAL PHASE

Electronic Transmission of Search Copies

13. One factor affecting the timeliness in producing international search reports is the transmission of search copies to International Searching Authorities. In order to facilitate the quick transmission, the International Bureau continues to encourage the electronic transfer of search copies and other documents necessary for international search from the receiving Office to the International Searching Authority via the International Bureau, using the receiving Office's existing communication link to the International Bureau, the PCT Electronic Document Interchange (PCT-EDI) system. Electronic transmission in this way should reduce delays compared to sending a paper copy of the search copy by post.

14. Following general support received for the proposal at the eighteenth session of the Meeting of International Authorities in March 2011 (see documents PCT/MIA/18/15 and paragraphs 98 to 105 of PCT/MIA/18/16), the International Bureau consulted receiving Offices and International Authorities on a revised proposal by way of Circular C. PCT 1332, dated February 17, 2012. Under the revised proposal, search copies would be constructed, usually by an automated process, using documents contained in the electronic record copy package received from the receiving Office and transmitted to the International Searching Authority, following a check by the International Bureau that the Authority is competent to carry out the international search and, optionally, upon receipt of a notification from the receiving Office that the search fee has been paid by the applicant.

15. At the time of preparing this document, the International Bureau has received 27 replies to the Circular. With the exception of one receiving Office citing a low volume of international applications received, receiving Offices were supportive of the proposal and stated they would be able, now or in the near future, to transmit search copies and fee payment notifications as proposed in the Circular. However, clarification on the format for fee payment notification was requested by some Offices. International Searching Authorities also agreed with the proposed mechanism and stated that they either required or preferred the notification that the search fee had been paid at the same time or before the transmission of the search copy. Some Authorities also noted that they would require time for implementation of the required electronic systems. International Searching Authorities also indicated that it was desirable to have the possibility of a supplemental OCR text available at the time of transmission of the search copy. The International Bureau is currently analyzing the responses to the Circular in order to finalize a plan to implement the proposed mechanism for transmission of search copies through the PCT-EDI system which meets the requirements of the interested Offices.

Timeliness Statistics

16. Information on the timeliness of submission to the International Bureau of international applications by receiving Offices and of international search reports and international preliminary reports on patentability (Chapter II) by International Authorities will be presented to the Working Group as part of the presentation by the International Bureau on PCT Statistics under agenda item 4 of the present session. Further information is also provided in the 2012 PCT Yearly Review, soon to be published on WIPO's website.

RECOMMENDATIONS RELATED TO THE QUALITY OF INTERNATIONAL SEARCH AND EXAMINATION

Internal Quality Management Systems of International Authorities

17. At the February 2012 session of the PCT/MIA Quality Subgroup, the European Patent Office (EPO) presented results from a pilot collaborative study on quality metrics of international search reports (ISRs), carried out by the Trilateral Offices (the EPO, the Japan Patent Office (JPO) and the United States Patent and Trademark Office (USPTO)). Phase 1 of that study consisted of collecting and analyzing the characteristics of citations in ISR established by these three Offices in their capacities as International Searching Authorities, such as the average number of documents cited, proportion of X and Y category citations, and the languages of citations in the ISR. In the near future, the EPO plans to expand this study to also cover ISRs established by the State Intellectual Property Office of the People's Republic of China (SIPO) and the Korean Intellectual Property Office (KIPO), thereby comprising all five of the IP5 group of Offices. PCT/MIA agreed to further assist and supplement this study by expanding it to cover ISRs established by all other International Searching Authorities.

18. Phase 2 of the Trilateral Offices' pilot collaborative study consists of an analysis of the contribution of a sample of ISRs established by the Trilateral Offices in their capacity as International Searching Authorities to the first Office actions by those Offices in their capacities as national Offices ("re-use of ISR in the national phase"). At its nineteenth session, PCT/MIA agreed to take this study forward by requesting the Quality Subgroup to develop the concept of a pilot project to study the usefulness for the national phase of international search reports of participating Offices, based on a set of quality metrics to be developed by the Subgroup. To do this comprehensively would require a great deal of information which is not currently available in machine-processable form and a significant amount of skilled manual analysis. It was therefore necessary to identify a starting point which was practical and could permit useful information to be gained within a reasonable timescale. One possibility identified by PCT/MIA in this context is to identify international search reports containing only "A" citations, where the case entered the national phase without any amendments to the claims and where the national search report contained "X" and/or "Y" citations (see paragraph 20 of the PCT/MIA Summary by the Chair, document PCT/MIA/19/13, reproduced in the Annex to document PCT/WG/5/2).

19. The Quality Subgroup also considered a proposal to modify Chapter 21 of the PCT International Search and Examination Guidelines and the reporting templates there under to require Authorities to report in their annual quality reports on a number of quality indicators for international work products, aimed at ensuring that a correct search strategy was adopted, that the search report was complete and correct, that relevant observations were raised, that the examination report was comprehensive and informative (including an indication as to what kind of quality metrics were used), and that written formalities were complete and correct. This proposal will be taken forward by a questionnaire to be sent by the International Bureau to all International Authorities. Based on the analysis of the feedback to the questionnaire, the Quality Subgroup will consider making a proposal to the PCT/MIA in 2013 (see paragraphs 16 and 17 of the Annex to document PCT/MIA/19/13).

Effective Searching of Patent Documentation in Different Languages

20. The PATENTSCOPE database provides a number of language tools to assist in the searching and translation of patent documents. In the past year, the number of languages covered by the Cross Lingual Information Retrieval (CLIR) function, which allows for searches using appropriate terminology to be performed simultaneously in multiple languages, has risen to 12, with the addition of Dutch, Italian and Swedish. Moreover, PATENTSCOPE provides for a machine translation tool to translate titles of inventions and abstracts from English into French and Chinese and vice versa (see paragraphs 22 to 31 of document PCT/WG/5/6 for further information on PATENTSCOPE).

21. The searching of patent documentation by the International Searching Authority in languages that are not official languages of the Authority is an important element for establishing high quality work products in the international phase of the PCT procedure. International Authorities are evaluating the benefits of various approaches to addressing this problem. Technical approaches include techniques similar to those used in CLIR to create multilingual search statements and loading machine translations of documents into the search engine for use in performing the search using queries in a single language.

22. In addition, as has been reported to the Working Group on previous occasions, the European Patent Office, the Korean Intellectual Property Office and the United States Patent and Trademark Office are carrying out a collaborative search and examination project, under which examiners from the participating Offices with different language specialties work together collaboratively on a single international application with the aim of establishing a high quality international search report and written opinion. The European Patent Office will present an update report to the Working Group at the present session (document PCT/WG/5/9).

Digitization of Patent Documents

23. The International Bureau wishes to continue to encourage Offices whose national patent documents are not readily available in electronic form to consult with the International Bureau on digitizing and making them available to other Offices. An update report on recent activities with regard to the digitization of national patent collections, including a project under the Development Agenda, is given in paragraphs 41 to 45 of document PCT/WG/5/6.

Feedback to International Authorities

24. Document PCT/WG/5/7 contains an update on the development of a centralized system for designated Offices to give feedback on the content of international reports to International Authorities.

Availability of Search Strategies of International Searching Authorities

25. International Authorities have continued their discussions on the best ways of increasing the availability to designated Offices and third parties of search strategies used by International Searching Authorities for the establishment of international search reports. Pending further discussions (see below), Authorities agreed that International Authorities willing to do so would be free to provide their search strategies to the International Bureau for making available on PATENTSCOPE, along with any explanation provided by International Authorities on the contents of the search strategy and how best to understand and use it. In addition to increasing transparency of the international search, this should facilitate the assessment of international search reports by designated or elected Offices when examining applications in the national phase. Authorities further agreed to continue the discussions with the view to identifying best practices to assist internal development of search strategies within Offices, scope for effective use by different interested parties and possible recommendations for developing more consistent approaches between Offices (see paragraph 26 of the PCT/MIA Summary by the Chair, document PCT/MIA/19/13, reproduced in the Annex to document PCT/WG/5/2).

RECOMMENDATIONS RELATED TO THE ISSUES OF INCENTIVES FOR APPLICANTS TO USE THE SYSTEM EFFICIENTLY; SKILLS AND MANPOWER SHORTAGES; ACCESS TO EFFECTIVE SEARCH SYSTEMS

Extending Opportunity for Dialogue with the Examiner during International Preliminary Examination

26. The Meeting of International Authorities at its nineteenth session discussed practices in relation to giving applicants an extended opportunity for dialogue during the international preliminary examination procedure (see paragraphs 9 and 10 of document PCT/MIA/19/2). In particular, where the applicant has attempted to overcome any deficiencies found to exist in the international application by way of arguments or amendments but where the Authority still considers the application to be deficient the International Preliminary Examining Authority would issue a *second* written opinion, in addition to that of the International Searching Authority, which is considered to be the *first* written opinion of the International Preliminary Examining Authority. Such an additional opportunity for dialogue in the international preliminary examination procedure would appear to be particularly beneficial for applicants intending to benefit from accelerated national examination schemes, such as the Patent Prosecution Highway (PPH), paving the way to file further amendments and/or arguments with a view to obtaining a positive international preliminary report on patentability (Chapter II).

27. The practice of issuing a second written opinion in the above situation is followed by several but not all International Authorities. In this regard, it is noted that the European Patent Office in its capacity as an International Preliminary Examining Authority has revised its practice under Rule 66.4 with effect from October 1, 2011, and will now issue a second written opinion, prior to establishing an international preliminary examination report, where the applicant has made a bona fide attempt to overcome any objections raised in the first written opinion yet the Authority considers that the application still is deficient. However, all Authorities who took the floor on the matter at the most recent session of the PCT/MIA expressed the view that the additional opportunity for dialogue should not be mandatory but remain optional to provide sufficient flexibility, noting the need to avoid unnecessary repetition or delay. One Authority also mentioned that additional written opinions would result in additional late reports (see paragraphs 41 and 42 of document PCT/MIA/19/14 Prov.).

Incentives to Encourage High Quality Applications and Early Correction of Defects

28. In response to Circular C. PCT 1295, dated March 8, 2011, a number of suggestions were received to encourage high quality applications and early correction of defects. These included incentives of a financial nature, such as fee reductions for online filing (where built-in formality checks would reduce defects), or the charging of additional fees for applications having formality defects. "Best practice" guidelines for applicants and attorneys in the PCT could also limit the number of defects. A discussion of this issue can be found in the draft report of the nineteenth session of the Meeting of International Authorities (see paragraphs 43 to 48 of document PCT/MIA/19/14 Prov.), which also noted the EPO's *Handbook of Quality Procedures Before the EPO*, which sought to achieve similar benefits in the context of that Office's work under the European Patent Convention (see paragraphs 24 to 27 of document PCT/MIA/19/14 Prov.).

29. Another incentive for the applicant to file higher quality applications and eliminate defects at an early stage in the international phase is through offering accelerated processing of the application where certain criteria are fulfilled. Examples of accelerated treatment within the PCT are the PCT-Patent Prosecution Highway (PCT-PPH) and the PCT(UK) Fast Track. Under the PCT-PPH, a request for accelerated treatment can be made based on the latest PCT work product (written opinion or international preliminary report on patentability) where the claims are considered to be allowable; as of December 2011, nearly 4,000 such requests have been

received¹. For the future, the meeting of the Offices of the Plurilateral Patent Prosecution Highway in October 2011 began discussions on how the existing PCT-PPH arrangements could be streamlined into a comprehensive PPH framework along with other PPH arrangements. Further statistics on use of the PCT-PPH will be presented to the Working Group and can be found in the 2012 PCT Yearly Review. For details of the PCT(UK) Fast Track, see document PCT/WG/4/14.

Coordinated Training in Search and Examination

30. The International Bureau, together with Offices of Member States which are able to offer training in search and substantive examination, notably for examiners of Offices of developing and least developed countries, continues its efforts to work towards better coordination of such training activities, with the aim of bringing benefits to as wide a range of recipient Offices as possible, as had been recommended by the Working Group. To that effect, the International Bureau has continued its discussions with potential “donor Offices” with regard to the amount and type of training which they are able to offer, to allow requests for training to be matched to the courses available, and to organize regional rather than national training events where several Offices are found to have similar language and substantive needs.

31. In addition, while the International Bureau has only limited capacities to be able to directly help national Offices to address their training needs, it will continue to assist Offices in the planning and the design of training activities (objective, type, amount, duration, target trainees, training methods, working languages, funding) and continue to provide general training courses for Office staff, including examiners, for example, on general basics of the patent system, on patent drafting and on patent information, both in the form of workshops and seminars and by distance learning. The International Bureau will also, of course, continue to provide specific training on PCT procedures.

32. In this context, the International Bureau has focused in particular on offering tailored assistance to those small and medium sized Offices that wish to make use of national or international search and examination reports established by other Offices for members of the patent family filed with the other Offices, as well as final results of examination by these Offices, such as granted claims or rejection rulings. To that end, the International Bureau included specific training workshops among the services offered through the WIPO-ICE program (“International Cooperation on Examination”; formerly using the acronym ICSEI), designed to respond to the particular challenges in substantive examination facing small and medium sized Offices, both of States which are and those which are not members of the PCT. In addition to the provision of generic training in search and examination, training of examiners under the ICE program will particularly focus on retrieving search and examination results from other Offices and applying them in the respective national context. These results not only include the search and examination reports established during the international phase of the PCT procedure and the results of other national Offices before which an application has entered the national phase, but also results for applications that have not been filed via the PCT system but under the Paris Convention route, or for applications for the same invention that do not claim any priority (technical families). A first sub-regional workshop for examiners of Asian Offices has been conducted from November 29 to December 1, 2011² in collaboration with EPO, JPO and the Intellectual Property Corporation of Malaysia. Another workshop for examiners from English speaking African Offices is planned to take place end of June or early July 2012.

¹ <http://www.jpo.go.jp/cgi/cgi-bin/pph-portal/statistics/statistics.cgi>

² http://www.wipo.int/meetings/en/details.jsp?meeting_id=24346

Developing Online Searching Capabilities of Offices

33. Paragraphs 32 to 40 of document PCT/WG/5/6 describe recent activities by the International Bureau towards developing online searching capabilities of Offices by facilitating access to technical databases for users in developing and least developed countries.

RECOMMENDATIONS RELATED TO COST AND OTHER ACCESSIBILITY ISSUES; CONSISTENCY AND AVAILABILITY OF SAFEGUARDS

Availability of Fee Reductions

34. Following the inconclusive discussions at the third session of the Working Group concerning revised proposals on eligibility criteria for reductions in certain fees (see document PCT/WG/3/14 Rev., paragraphs 158 to 181), the International Bureau continues its efforts to seek alternative solutions to the issue of suitable eligibility criteria for fee reductions for applicants from developing and least developed countries which could be agreed upon by all Member States, and in this context also aims to provide suggestions for financially sustainable ways forward to make the PCT system more accessible to SMEs, universities and not-for-profit research institutions. To take forward the recommendation set out in paragraph 191 of document PCT/WG/3/2, the International Bureau again wishes to encourage Member States to work together with the International Bureau to review the level of fees for different types of applicants and seek innovative solutions to the problem of ensuring that applicants are not excluded from use of the system by the level of the fees.

Withdrawal of Notifications of Incompatibility

35. Since the previous session of the Working Group, two notifications of incompatibility with the PCT Regulations have been withdrawn: Lithuania on Rule 49*ter*.2 (with effect from February 2012) and Japan on Rule 49.6 (with effect from April 2012).

RECOMMENDATIONS RELATED TO TECHNICAL ASSISTANCE; PCT INFORMATION AND TECHNOLOGY TRANSFER

Technical Assistance, Dissemination of Technical Information and Facilitating Access to Technology

36. Documents PCT/WG/5/5 "Coordination of Technical Assistance and Financing of Technical Assistance for Developing Countries under Article 51 of the PCT" and PCT/WG/5/6 "The PCT's Aims of Organizing Technical Assistance for Developing Countries; Disseminating Technical Information and Facilitating Access to Technology; Sufficiency of Disclosure" respond to requests from the Working Group formulated as part of the recommendations endorsed by the Working Group at its third session in 2010. These documents also discuss other recommendations in this area. In particular, paragraphs 61 to 63 of document PCT/WG/5/6 discuss collaboration between the International Bureau and national Offices towards improving patent status information, and the possibility since January 2012 to allow applicants to indicate their willingness on PATENTSCOPE to license their invention and provide information on any licensing terms.

Language coverage of Working Group Documents

37. The Working group endorsed a recommendation to increase the availability of PCT Working Group documents in other official languages of the United Nations. In this regard, the Assemblies of the Member States of WIPO at their meeting in 2011 approved a recommendation of the Program and Budget Committee as follows (see paragraphs 173 to 184 of document A/49/18):

“The language coverage for documentation for meetings of the WIPO Main Bodies, Committees and Working Groups, as well as for core and new publications, shall be extended to the six official languages of the United Nations (Arabic, Chinese, English, French, Russian and Spanish) in a phased manner that commenced in 2011 (as detailed in Section II [of document WO/PBC/18/15] above) and subject to approval of the resource requirements proposed in the draft 2012/2013 Program and Budget. The cost of language coverage for documentation for Working Groups will be assessed in the light of experience gained in 2012/2013 and in the context of the 2014/2015 Program and Budget.”

38. Pending the assessment of the cost of the language coverage for documentation for Working Groups referred to above, it is envisaged that the language coverage of documentation for the PCT Working Group will be extended to all six official languages of the United Nations during the 2014/15 biennium.

39. *The Working Group is invited to note the content of the present document.*

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