

Patent Cooperation Treaty (PCT) Working Group

Sixth Session
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MANDATORY RECORDATION OF SEARCH STRATEGY

Document submitted by the United Kingdom and the United States of America

SUMMARY

1. The present document contains a proposal to amend the International Search and Preliminary Examination Guidelines to provide that, when forwarding the international search report (ISR) to the International Bureau (IB), the International Searching Authority (ISA) will also provide the IB with a copy of the search strategy used to perform the search. Under this proposal, in order to increase the level of transparency with respect to the work performed by the ISA and thus provide increased confidence in the quality of PCT searches, examiners would record their search strategy (as discussed in paragraph 15.58 of the International Search and Preliminary Examination Guidelines) and make such information available to other Offices in the format used by the ISA.

BACKGROUND

2. As detailed in documents such as the PCT Roadmap (PCT/WG/2/3, Annex I) and The Need for Improving the Functioning of the PCT System (PCT/WG/3/2), there has been a renewed effort to make more effective use of the PCT in order to, *inter alia*, reduce duplication of work, increase the confidence in the international work product, and provide a more accurate, higher quality search and patentability opinion at the international phase. As noted in paragraph 77(i) of PCT/WG/3/2, the quality of the international search is difficult to assess because there is usually only a very limited record of the search strategy available.

3. At the 2011 Meeting of International Authorities (MIA), a proposal was made by representatives of the Canadian Intellectual Property Office (CIPO) for consideration and adoption by the Authorities for the modification of the international search report to provide a section to record the search strategy used in performing the international search. As noted in the proposal by CIPO, providing a more comprehensive and detailed explanation about the search strategy would increase confidence in the quality of the international search reports and make the reports more useful to the national Offices.

4. At the MIA, the general concept of making the search strategy available received significant support from a majority of the Authorities, with only one Authority expressing significant concerns.

5. As to the specific proposal, there were three areas of concern that were voiced at the MIA (and during subsequent discussions on the matter by the Authorities), all of which were related to providing the information in a specific uniform format. Those three areas of concern were:

- reaching an agreement on a uniform format in view of the diversity of methods used by the Authorities for recording searches;
- the amount of examiner time that would be involved in preparing explanations of the scope of the search in a format different than they currently use; and
- the IT investments needed to accommodate such a change in recordation format.

6. At the fifth session of the PCT Working Group, held in Geneva from May 29 to June 1, 2012, the United Kingdom and the United States of America presented a joint proposal entitled "PCT 20/20", containing twelve proposals for further improvement of the PCT system (document PCT/WG/5/18), including a specific proposal for "Mandatory Recordation of Search Strategy." The proposals received varying levels of support by the Working Group (see the Summary by the Chair of the fifth session, document PCT/WG/5/21, paragraphs 27 to 29). However, many delegations felt that they could provide only preliminary views on the proposals and noted that more time was needed to carefully study the proposals, to consult with user groups and to consider the possible impact on respective national laws and practices. Following the discussions, the Delegations of the United Kingdom and of the United States of America agreed to further elaborate on the proposals and to provide more details on how to take the proposals forward, for discussion at the next session of the Working Group.

7. Taking into account the discussions and the comments received during the fifth session of the Working Group, the United Kingdom and the United States of America prepared revised versions of the original proposals for further improvement of the PCT system. Those revised and expanded proposals were communicated by the International Bureau, by way of a Circular (Circular C. PCT 1364, dated December 20, 2012, Annex I), to Offices of all PCT Contracting States in their capacity as a receiving Office, an International Searching and Preliminary Examining Authority and/or a designated and elected Office under the PCT, to Geneva-based missions and foreign ministries of PCT Contracting States and of States that are invited to attend meetings of the PCT Working Group as observers, as well as to certain organizations that are invited to attend meetings of the PCT Working Group as observers. The Circular invited recipients to review and further comment on those revised proposals and, in particular, to consult with user groups on those proposals and to consider the possible impact of those proposals, if adopted, on respective national laws and practices.

8. The revised and expanded PCT 20/20 proposals contained in Circular C. PCT 1364 included the following expanded discussion on the proposal for mandatory recordation of search strategy.

“21. When performing automated searches of the prior art, examiners prepare a set of search queries to discover the most relevant prior art. The search terms and related logic used are generally preserved in the application file. In order for national Offices to make use of a search performed by the international authority, it would be beneficial for the national Office to have access to the search logic used by the authority. For example, an examiner in the national Office would not necessarily need to repeat the search done by the first examiner. In addition, the examiner in the national Office would be able to confirm that a proper search had been performed by the first examiner, thus building confidence and promoting work sharing. Accordingly, not only should it be mandatory for examiners to record search strategy, but such strategy should be made available to other Offices. Consideration could be given to establishing a uniform format for posting such search strategies so that examiners can easily understand and review the work of other examiners without spending unnecessary time analyzing the particular unique layouts of search strategy results.”

9. To date, 31 responses to the Circular have been received, including comments from 24 national and regional Offices and 7 user groups. The responses included comments on the proposal for mandatory recordation of search strategy from 17 of the national and regional Offices and 6 of the user groups, with a vast majority of those national and regional Offices and every user group which commented expressing support for the proposal.

10. Four of the Offices which responded did indicate that, while the requirement should be made to be mandatory, there were continued concerns that a uniform format should be agreed upon first.

11. Further, the expanded proposals were discussed at the twentieth session of the Meeting of International Authorities under the Patent Cooperation Treaty (PCT/MIA), held in Munich from February 6 to 8, 2013. A summary of those discussions is set forth in paragraphs 52 - 102 of the Annex to Document PCT/WG/6/3 (MIA report).

12. With regard to the specific discussions at the MIA on the topic of mandatory recordation of search strategy, paragraph 71 of the MIA report states:

“71. Authorities agreed that discussion in this area was desirable. It was necessary to define minimum requirements before considering making it mandatory to record search strategies and it was also desirable in the long run to seek consistency of content and presentation. However, many Authorities emphasized that work on those matters should not hold up the progress in sharing the existing search strategies to the extent that Authorities were willing to make them available.”

PROPOSAL

13. The Offices of the United Kingdom and the United States of America agree that, while it is indeed desirable in the long run to agree on a standard format for recording search strategies, the ultimate goal of uniformity should not hold up progress that can be made presently by sharing existing search strategies.

14. Therefore, the Annex to this document contains a proposal to modify the International Search and Preliminary Examination Guidelines to provide that, when the ISA transmits the ISR to the IB, it shall also transmit a copy of the search strategy relied upon to perform the international search in whatever format the search strategy is currently recorded by the ISA.

15. Making search strategies available will serve two extremely useful purposes. First, it will make this important information available to national Offices immediately. The immediate availability of this information will increase the level of transparency, and thereby increase the level of confidence, with respect to the work performed by the ISA. This will, in turn, allow the national Offices to improve the efficiency of their searches by reducing duplication.

16. Second, by making the search strategies available in the various formats in which they are currently recorded, it will allow the Offices to review the various formats in which the strategies are recorded and, as a result of the experience gained in utilizing the differing formats, make a more informed decision as to which aspects of the different formats are most useful when making a recommendation on a uniform format to be used by all Offices in the future.

17. Further, making the strategies available in the current formats in which they are presently recorded by the different Authorities will allow this information to become available, while negating the concerns expressed regarding the amount of examiner time which would be involved in preparing explanations of the scope of the search in a format different than that which they currently use. It would also address concerns regarding the IT investments needed to accommodate a change in recordation format.

18. *The Working Group is invited to comment on the proposals set out in the Annex to this document.*

[Annex follows]

PROPOSED MODIFICATIONS TO THE
PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES¹

Chapter 15
The International Search

15.01 – 15.57 [No change]

~~Recording the Search~~ Strategy Recordation

15.58 In recording the search history (i.e., search strategy) of the International Search, the examiner, lists the classification identification of the fields searched. If the IPC is not used for this purpose, the classification used is indicated. See paragraph 16.49. ~~Depending on the policy of an International Searching Authority, the~~ The examiner ~~may find it useful to~~ should record the search history in sufficient detail to allow examiners of national stage applications to fully interpret and rely upon the international search. This includes recording the details of any patent and non-patent literature searches as well as searches conducted on the Internet, including the key words and query operators, expressed as complete search queries to the extent practical, logic employed as the basis of a text search which resulted in the discovery of prior art, or the amino acid or nucleic acid sequence employed as the basis of a sequence search and the sequence alignment corresponding to prior art cited in the international search report that was obtained from the sequence search, or the chemical structure employed as the basis of a chemical structure search or details of other non-classification or non-text searches performed. See paragraphs 16.49 through 16.56 for additional guidance on recordation of the search history. The recorded search history should also include any query used in any of the foregoing searches. Provision of the actual search query from these search histories is generally easily accomplished by direct printing of the search query from the automated system used to construct and perform the search query from a given electronic search resource. Where an electronic database is used, the name of the database should be provided; the actual search queries used may also be useful information that, ~~depending on the policy of the International Searching Authority, may~~ should be provided and made available to examiners of national stage applications ~~if practical~~. Examiners are also encouraged to record the search history to include the details of searches used to determine compliance with the requirements of novelty, inventive step, industrial applicability, support, sufficiency, or other appropriate requirements. ~~However, unless required at the option of the International Searching Authority, there is no requirement to include all details of patent and non-patent literature searches that were performed during the search process.~~

15.58.01 At the time it transmits the international search report to the International Bureau in accordance with Rule 44.1, the International Searching Authority shall also transmit a copy of the complete recorded search strategy to the International Bureau in a format established by the International Searching Authority. The International Bureau shall then make the search strategy as provided by the International Searching Authority available to the public.

15.59 – 15.70 [No change]

[End of Annex and of document]

¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.