

Patent Cooperation Treaty (PCT) Working Group

Sixth Session
Geneva, May 21 to 24, 2013

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT ON THE TWENTIETH SESSION

Document prepared by the International Bureau

1. The Annex to this document sets out the results of 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, as outlined in the Summary by the Chair. Annex II to this Summary by the Chair contains a summary of the third informal session of the PCT/MIA Quality Subgroup, which was held immediately prior to the Meeting of International Authorities in Munich on February 4 and 5, 2013.

2. *The Working Group is invited to note the results of the twentieth session of the Meeting of International Authorities under the PCT, as set out in the Summary by the Chair (document PCT/MIA/20/14), reproduced in the Annex to this document.*

[Annex follows]

MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PATENT COOPERATION TREATY (PCT)

TWENTIETH SESSION, MUNICH, FEBRUARY 6 TO 8, 2013

SUMMARY PREPARED BY THE CHAIR

(noted by the Meeting; reproduced from document PCT/MIA/20/14)

INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its twentieth session in Munich from February 6 to 8, 2013.
2. The following International Searching and Preliminary Examining Authorities were represented at the session: the Austrian Patent Office, the Brazilian National Institute of Industrial Property, the Canadian Intellectual Property Office, the European Patent Office, the Federal Service for Intellectual Property of the Russian Federation, IP Australia, the Israel Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, the National Board of Patents and Registration of Finland, the National Institute of Industrial Property of Chile, the Nordic Patent Institute, the Spanish Patent and Trademark Office, the State Intellectual Property Office of the People’s Republic of China, the Swedish Patent and Registration Office, and the United States Patent and Trademark Office.
3. The list of participants is contained in Annex I to this document.

ITEM 1: OPENING OF THE SESSION

4. Mr. Benoît Battistelli, President of the European Patent Office, welcomed the participants to this 20th session of the Meeting, which coincided with the 35th anniversary of the beginning of operations of the PCT and the 40th anniversary of the European Patent Convention. The two systems had been developed together and both had been success stories far beyond original expectations. Referring to the ongoing discussions among Member States on the PCT Roadmap and the proposals submitted by the United States Patent and Trademark Office, the Japan Patent Office and the European Patent Office on further improvements to the PCT system, Mr. Battistelli stated that he was confident that Member States would agree on further steps to be undertaken to improve the PCT system, notably with regard to quality, efficiency and timeliness of procedures, to the benefit of all stakeholders. Referring to the document prepared by the International Bureau on the appointment of new Authorities, Mr. Battistelli indicated that the time was ripe to review the criteria under PCT Rule 36 with a view to ensure the highest standards of quality expected by users of the PCT system.
5. Mr. James Pooley, Deputy Director General of the World Intellectual Property Organization, welcomed the participants on behalf of the Director General. He especially welcomed the representatives from the National Institute of Industrial Property of Chile, following its recent appointment as an International Authority. Mr. Pooley further highlighted the success of the PCT as a multilateral treaty which brought benefits to a large number of constituents; no doubt, the fact that all constituents could influence the future of the system by engagement in meetings of relevant PCT bodies, such as the present one, had contributed to that success.

ITEM 2: ELECTION OF A CHAIR

6. The session was chaired by Ms. Margot Fröhlinger, Principal Director, Directorate General Legal/International Affairs, European Patent Office, except for agenda items 8 and 9, which were chaired by Mr. Eugen Stohr, Director, Directorate General International/Legal Affairs, European Patent Office.

ITEM 3: ADOPTION OF THE AGENDA

7. The Meeting adopted the agenda as set out in document PCT/MIA/20/1 Rev.

ITEM 4: PCT STATISTICS

8. The Meeting noted the presentation by the International Bureau on the most recent PCT Statistics¹.
9. One Authority, while underlining the importance of information on the timeliness of International Searching Authorities in accordance with Rule 42, suggested that future presentations should include information on the timeliness of transmission by receiving Offices of the search copy to the International Searching Authority.

ITEM 5: PCT ONLINE SERVICES (ePCT)

10. Discussions were based on document PCT/MIA/20/2.
11. The International Bureau summarized the existing features of ePCT, noting in particular that the term "ePCT" in its broadest sense incorporated not only the web interface for Offices and applicants but also a large range of systems used internally by the International Bureau and for communication between the International Bureau and other Offices. The aim of the system was to allow all of these systems to be used together to provide a more efficient and effective service for applicants and Offices which wished to use the web interface without needing to have any knowledge of what lay behind. Meanwhile, the underlying systems should be developed also for the benefit of Offices which hosted their own PCT IT systems and the applicants which used the services of those Offices.
12. An important recent development was the introduction of a set of new services specifically developed for receiving Offices. This was the first major step towards the goal of providing, by the end of 2014, a complete receiving Office service, including as many aspects as possible where the receiving Office directly entered any necessary data (or confirmed data provided by the applicant) rather than uploading independently produced forms the contents of which would then need to be read and possibly transcribed by the International Bureau. This offered a significant saving in time and risk of errors. A similar approach was under way, and more advanced, in relation to services for applicants dealing with the International Bureau. However, it was necessary to extend the service to allow interactions between the applicant and Offices other than the International Bureau, as well as between Offices in different capacities.
13. Some particularly important aspects of future development for Authorities included the following:
 - (a) A pilot was about to begin of transmission of search copies from receiving Offices to the International Searching Authority via the International Bureau. This should significantly reduce postal delays and allow the earlier establishment of international search reports.
 - (b) If further documents were made available through the system, including ones not currently sent to the International Bureau, this would allow a more complete file inspection and offer immediate access by applicants without postal delays.

¹ The presentation is available from the WIPO web site at http://www.wipo.int/meetings/en/details.jsp?meeting_code=pct/mia/20

(c) It was intended to offer transmission of documents from applicants to Authorities willing to receive such documents via PCT-EDI or through the ePCT web interface (with suitable notifications to warn the Authority that a new document was available this way). This could permit faster responses to actions, including written opinions and invitations to pay additional fees.

(d) Services would allow generation of forms or equivalent data entry supporting the administrative aspects of the work of the International Authorities.

(e) The International Bureau should assist in developing services (probably independent of the web browser interface) to support Authorities in providing international search reports and preliminary reports on patentability in XML format.

(f) If possible, it was hoped to allow applicants to make credit card payments to the International Bureau for fees due to at least some receiving Offices and International Authorities.

14. Finally, the International Bureau observed that the system had been designed so as to allow the browser interface to be provided in any of the languages of international publication. Testing was about to begin on this aspect of the system and it was hoped to provide more information soon on what timetable would be practical for introducing additional language versions. Several Authorities emphasized the importance which they placed on this point.

15. All Authorities that took the floor on the matter welcomed the development of the ePCT system and the vision which had been set out. Several Authorities noted that they had cooperated closely in the development of the Office services and were either testing the services or already using them regularly for their work. The system offered great opportunities for more effective communications and expediting services by eliminating one of the major causes of delay, including in relation to search copies and delivery of international search reports. The various other aspects, including web filing, integrated credit card payments and more effective use of data were also appreciated. It was noted that the development of the system was generally in line with the proposals concerning the Global Dossier (section J of the Annex to document PCT/MIA/20/10) and PCT Kaizen (document PCT/MIA/20/12) and that the projects should be coordinated appropriately.

16. In relation to queries from Authorities, the International Bureau made the following comments:

(a) There did not appear to be any immediate need for changes to the PCT Regulations to support ePCT. The need to remain compatible with Offices using paper meant that the system did not attempt to fundamentally change the underlying processes or responsibilities for tasks. However, there would be proposals to modify the Administrative Instructions, for example to define more effective data structures for information being passed between Offices and to permit the use of data and/or alternative presentations of information in place of the current paper-based forms.

(b) The benefits of ePCT so far were in terms of service. Its use was not yet on a scale where cost benefits could be seen, but it was part of a longer term automation plan whose cost savings could be seen primarily in greater resource-efficiency, having allowed the International Bureau to process an ever-increasing number of international applications without the need for additional staff, the details of which had been given in other meetings. The provision of full text (XML) international search reports and preliminary reports on patentability would offer another chance for significant savings, notably by allowing translators to use machine assistance tools more effectively in providing translations of reports established in languages other than English.

(c) The system had not yet been heavily promoted with applicants. This was expected to begin once the web filing system had been made available to all applicants.

(d) Messages sent by the applicant using the ePCT informal message service were all fully logged, just like conventional documents being uploaded into the system.

(e) The plans to discontinue the PCT-EASY service would be the subject of a consultation with Offices. A long period of notice would be proposed to give applicants and Offices the opportunity to change their systems before the service was finally withdrawn.

(f) The ePCT-Filing service would initially be only for filings with the International Bureau acting as receiving Office but would eventually offer filings to all receiving Offices in at least two ways: (i) by delivering packages using the interoperability protocol so that Offices currently accepting electronic filings using PCT-SAFE or equivalent applications would be able to accept filings without making any changes to their systems whatsoever; or (ii) by delivering international applications to a hosted service where the receiving Office could process the international application using the web interface. Either way, the receiving Office would itself have the same responsibilities and would not be delegating tasks to be undertaken by the International Bureau.

17. Authorities welcomed the report on the use of the third party observation service and agreed that it was a valuable contribution to the PCT system. One Authority was pleased to note that concerns that the system might be abused had so far proved unfounded. The International Bureau commented that a further report would be made to the PCT Working Group at its next session. While various comments had been received, most notably relating to the 500 character limit on the "brief explanations of relevance", it was not likely that it would be necessary to propose significant changes to the system in the near future.

18. The Meeting noted the contents of document PCT/MIA/20/2.

ITEM 6: QUALITY

19. Discussions were based on document PCT/MIA/20/3.

20. The Meeting:

(a) noted with approval the Summary by the Chair of the Meeting's Quality Subgroup set out in Annex II to this document and agreed with the recommendations which it contained;

(b) approved the continuation of the Subgroup's mandate, including the convening of a further physical meeting of the Quality Subgroup in 2014;

(c) agreed that the annual reports submitted by the International Authorities should be made publicly available on WIPO's web site; and

(d) agreed that the International Bureau should submit a report to the PCT Assembly on the ongoing quality-related work by the Meeting, including a reference to the annual reports on quality management systems, the Summary by the Chair of the Quality Subgroup meeting and the Summary by the Chair of this session.

ITEM 7: COLLABORATIVE SEARCH AND EXAMINATION PILOT PROJECT

21. Discussions were based on document PCT/MIA/20/4.
22. The Meeting noted a report by the European Patent Office on phase 2 of the Collaborative Search and Examination Pilot Project carried out jointly by the European Patent Office, the Korean Intellectual Property Office and the United States Patent and Trademark Office. In its report, the European Patent Office highlighted the positive evaluation of the pilot by both participating European Patent Office examiners and participating applicants, notably the fact that: (i) in more than 60 per cent of applications, the feedback received from the examiners from other Authorities included comments on search strategies, interpretation of claims and prior art or patentability, and that in 30 per cent of applications the feedback included additional search hints (classes, key words, databases); (ii) in 87 per cent of applications, the feedback resulted in citations being added by the first examiner to the final report; (iii) in 92 per cent of all cases, first examiners had perceived the final international search report and written opinion to have improved as a result of the collaboration with peer examiners, with more than 30 per cent of cases perceived to have been improved “significantly”.
23. The United States Patent and Trademark Office, part of the group of Authorities jointly carrying out the pilot, stated that the results of the pilot were indeed very encouraging, increasing the quality of the international work products and resulting in time savings during national phase procedures. The findings of its own evaluation of the pilot had been very similar to those of the European Patent Office. It expressed the hope that the service could eventually be offered at a cost which would not be significantly higher than the present cost for international search.
24. The Korean Intellectual Property Office, also part of the group of Authorities jointly carrying out the pilot, stated that it, too, felt encouraged by the results of the pilot, referring to its findings that in 90 per cent of all cases results had improved, in 77 per cent of cases new citations had been added to the reports, and in 70 per cent of cases useful comments had been received on issues such as search strategies, interpretation of claims and prior art or patentability. One of the issues requiring further attention, on the other hand, was the possible impact on the timeliness of the international search report.
25. All Authorities which took the floor on the matter appreciated the efforts of the three Authorities jointly carrying out the pilot and welcomed the findings as promising and encouraging, noting that a detailed analysis still had to be carried out, taking due account of the pros and cons for such a collaborative search and examination system. It was noted that the pilot had been carried out without the use of any sophisticated IT tool, which would be required if the system were introduced and thus volumes became much higher. In this context, the Brazilian National Institute of Industrial Property indicated that it had developed a platform to assist collaboration by Offices which it intended to introduce at the upcoming session of the PCT Working Group in May 2013. A suggestion was made to study the possibility of taking advantage of a similar tool developed in the context of the Cooperative Patent Classification.
26. The Meeting noted the contents of document PCT/MIA/20/4.

ITEM 8: SUPPLEMENTARY INTERNATIONAL SEARCH

27. Discussions were based on document PCT/MIA/20/5.
28. All Authorities which took the floor on this matter expressed their disappointment on the low uptake of the system by applicants. Views expressed as to the likely causes included, in particular, the cost of the service, the fact that no Authority whose official languages included an Asian language was participating in the system, and the continued lack of awareness by applicants.

29. The European Patent Office reported on the results of a market research study it had carried out, showing that, of 430 European patent attorneys familiar with the PCT procedure which had been surveyed, 39 per cent had not been aware of the supplementary international search system. Of those who had been aware of the system, 43 per cent had found it useful. Of those who had been aware but were not using it, more than 50 per cent had stated that they saw no need for an additional search, whereas 28 per cent had referred to the high costs of the service as the main reason for not using it.

30. Several Authorities reported on their activities to raise awareness of the system. One suggestion which found the general interest of the Meeting was to include a standardized generic text on all forms by which the Authorities communicated the international search report and the written opinions to applicants (Form PCT/ISA/220).

31. Several Authorities which currently did not offer the service expressed their generally favorable view of the system but cited workload considerations as the main reason for not being able to offer the service in the foreseeable future.

32. The Brazilian National Institute of Industrial Property announced that it intended to offer the service from January 2014.

33. The Meeting noted the contents of document PCT/MIA/20/5.

ITEM 9: PCT MINIMUM DOCUMENTATION

34. Discussions were based on document PCT/MIA/20/6.

35. One Authority suggested that the Task Force set up to consider the various technical issues involved in the review of the PCT minimum documentation should include in its agenda the issue of performing a cost/benefit analysis to determine whether to add a national patent collection to the PCT minimum documentation.

36. One Authority underlined the importance of data required for building patent families from the files of International Authorities. It stressed the need for greater standardization and consistency with WIPO Standard ST.36 and for the PCT minimum documentation to be available to all Authorities.

37. One Authority expressed the view that document PCT/WG/5/16 was a good starting point for the considerations by the Task Force. It emphasized that any document collection to be considered for potential inclusion in the PCT minimum documentation should be ready for use with no need for further processing by International Authorities and include a list of patent family members and details of priority claims. In this way, it would be possible for Authorities to distinguish between documents with national priority claims from other patent family members, thereby facilitating identification of what needed to be added to their search collections. The Authority further stated that it preferred to maintain the requirement for approval by the PCT Assembly prior to addition of a new document collection to the minimum documentation.

38. One Authority stated that there should not be any distinction between documentation collections from PCT Contracting States and other States; it did not see a need for the PCT Assembly to approve inclusion of a new collection, provided adequate checks had been performed by the International Bureau. It also supported the International Bureau hosting collections of national documents.

39. The Meeting noted with approval the timeline of further work suggested in paragraph 21 of document PCT/MIA/20/6.

40. The Meeting noted the contents of document PCT/MIA/20/6.

ITEM 10: PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

41. Discussions were based on document PCT/MIA/20/7.
42. One Authority requested a longer period for International Authorities to provide comments on the proposed modifications to the Guidelines in response to Circular C. PCT 1371. Furthermore, it indicated the need for a period after agreement on the modifications for examiners and users to become familiar with the modified Guidelines prior to their promulgation.
43. Noting that none of the Authorities appeared to oppose a longer consultation period, the International Bureau suggested to extend the period for International Authorities to submit comments on Circular C. PCT 1371 to July 31, 2013.
44. The Meeting noted the contents of document PCT/MIA/20/7.

ITEM 11: PCT SEQUENCE LISTING STANDARD

45. Discussions were based on document PCT/MIA/20/8.
46. The European Patent Office, as leader of the Task Force on Sequence Listings created by the Committee on WIPO Standards, provided an update on the progress of the discussions in the Task Force. Whereas the part of the envisaged new Standard relating to XML had largely been agreed upon, in view of the comments received during a public consultation on the envisaged new Standard, discussions with database providers were ongoing on the part relating to the sequence listings. The Task Force hoped that the draft Standard could be finalized before the end of 2013, with a view to adoption by the Committee on WIPO Standards in 2014.
47. The Meeting noted the contents of document PCT/MIA/20/8.

ITEM 12: REVISION OF WIPO STANDARD ST.14

48. Discussions were based on document PCT/MIA/20/9.
49. The International Bureau provided an update to the Meeting of the work of the Task Force created by the Committee on WIPO Standards to undertake a revision of WIPO Standard ST.14. For both the revision of category codes and the convenience of revising the citation of non-patent literature to bring ST.14 in line with International Standard ISO 690:2010, the Task Force was preparing a progress report to the third session of the Committee on WIPO Standards, due to take place from April 15 to 19, 2013.
50. One Authority highlighted the importance of agreeing a time period for implementation after adoption of a revised Standard. Another Authority considered that a revision to ST.14 would be desirable to bring about greater consistency in practices for citation of documents, but questioned whether the proposals under consideration by the Task Force would indeed achieve this goal, notably the distinction between novelty and inventive step when a document was taken alone. Yet another Authority indicated that it intended to present its findings in the area of transliteration for the citation of non-patent literature to the Task Force.
51. The Meeting noted the contents of document PCT/MIA/20/9.

ITEM 13: FURTHER IMPROVEMENTS TO THE PCT SYSTEM

52. Discussions were based on documents PCT/MIA/20/10, 11 and 12, taking related issues from each document together, as noted below.

(A) SELF-SERVICE CHANGES (92B/S/PRIORITY CLAIMS)

53. Discussions were based on paragraphs 1 to 4 of the Annex to document PCT/MIA/20/10.

54. Authorities agreed that it was desirable in principle to develop ePCT to permit applicants to control the processing of their international applications as directly as possible. However, for many types of changes, significant obstacles were seen in eliminating the step of human review. Various aspects of security needed to be considered, most notably reliably demonstrating that the user of a particular account was in fact an authorized person. Furthermore if an error in a Rule 92*bis* change was only discovered in the national phase, it could be very difficult and expensive to correct. Consequently, it might be worthwhile for the applicant to accept a short delay while a formalities review took place. Where multiple applicants were involved, a human formalities review might notice issues which suggested that an action might not be representing the wishes of all of the applicants. In other types of situation, such as withdrawal of the international application, reviews might be important because it sometimes might not be possible to correct errors at all. It was suggested that the views of applicants should be sought before eliminating human formalities review in any such situation. One Authority noted that review of these issues might highlight areas where there were diverse practices in relation to the need for powers of attorney between the International Bureau and the various receiving Offices and offer an opportunity to improve consistency.

55. It was noted that sometimes automated changes might simply not be possible, for example where a change of owner was registered by the new owner of the international application, who would not have any status in the system unless "eOwner" rights had been transferred by the previous owner. For some types of changes, it might be desirable to have manual checking because the time limits might be based on very complicated rules, or be dependent on the date of issue of an invitation to correct which would not necessarily be known to the system. It was also important to take account of the fact that some actions were within the competence of the receiving Office rather than the International Bureau.

(B) LIMITED CHAPTER I AMENDMENTS / CLARIFY PRACTICE ON INCORPORATION BY REFERENCE OF MISSING PARTS

56. Discussions were based on paragraphs 5 to 9 of the Annex to document PCT/MIA/20/10 and paragraphs 12 to 16 and Appendix III of the Annex to document PCT/MIA/20/11.

57. Authorities were generally supportive of the principles behind the proposals to permit correction or rectification of international applications in the particular situations referred to in the proposal by the United States Patent and Trademark Office. However, a number of Authorities believed that these proposals might be dealt with better by modification of the PCT Administrative Instructions or Receiving Office Guidelines to make clear that they were permissible under the existing Regulations and to provide greater consistency in handling of the relevant issues between receiving Offices and International Authorities. In whatever way the issue was resolved, it would be important to ensure that the legal framework and the procedure which was adopted to implement it ensured that the changes were reviewed by a substantive examiner, not simply dealt with as a formalities issue, and that there was no introduction of added subject matter.

58. The European Patent Office clarified that it was able to agree with the underlying principles expressed by the United States Patent and Trademark Office in relation to situations where a new set of claims was added using incorporation by reference to replace, or rather supplement, an incorrect set which had accidentally been included in the original filing. The main difficulty lay where an entire application, including the description as well as the claims, was “replaced”. The European Patent Office hoped that, with that understanding, the draft text in Appendix III of the Annex to document PCT/MIA/20/11 might form the basis of a way forward.

(C) SIMPLIFY WITHDRAWAL OF INTERNATIONAL APPLICATIONS

59. Discussions were based on paragraphs 10 to 12 of the Annex to document PCT/MIA/20/10.

60. Authorities were sympathetic to the desire to simplify the signature requirements in certain situations, notably including withdrawal of international applications. However, there were also concerns about the appropriate safeguards in cases where there were multiple applicants and it was suggested that this proposal would shift the burdens significantly between representatives and applicants and that the proposals would need careful consideration. The International Bureau noted that the same issue had been discussed at length in the Working Group on Reform of the PCT without reaching a satisfactory resolution. It also noted a practical difficulty in the proposal that it was not necessary to have addresses on file for all applicants so it would not always be possible to contact all applicants to give them an opportunity to object to a withdrawal.

(D) STANDARDIZING FEE REDUCTIONS FOR NATIONAL STAGE APPLICATIONS

61. Discussions were based on paragraphs 13 and 14 of the Annex to document PCT/MIA/20/10.

62. Authorities supported the principle of encouraging applicants to achieve a positive international preliminary report on patentability during the international phase to reduce the burden of search and examination in the national phase. However, while some Authorities supported the proposals and noted that they already had fee regimes which met or were similar to the proposals, others were concerned that the policy on national phase fees should remain entirely a matter of national policy. Some Authorities noted that their Office had already reduced national phase fees and that there was little scope remaining for further reductions. PCT national phase entries made up a very large proportion of the total number of applications processed in some Offices and consequently the potential effect on revenues of proposals such as this might be very significant. The details of fee policies were usually in the hands of ministers rather than Offices. In many cases, the most pressing calls for fee reductions according to national policies lay with small and medium-sized entities rather than recognizing national phase work.

63. The International Bureau noted that, while this was indeed at present entirely a matter of national policy and law, the spirit of the PCT was to recognize and make use of the international phase work so as to reduce the work required in the national phase. It was particularly disappointing where a designated Office failed to give any recognition in the form of reduced fees in cases where a designated Office had itself established the international search report in its earlier role as International Searching Authority. The United States Patent and Trademark Office noted that the proposals were intended to represent a general concept. The specific conditions and reductions could be varied as considered appropriate and these discounts could co-exist with other reasons for variations in fees.

(E) INTERNATIONAL SMALL/MICRO ENTITY REDUCTION

64. Discussions were based on paragraphs 15 and 16 of the Annex to document PCT/MIA/20/10.

65. All Authorities were sympathetic to the desire to make the system more accessible to small and medium-sized entities; however, it was recognized that it would be difficult to find definitions and levels of reduction which would be acceptable to all Offices concerned. Some Authorities suggested that it might be better to leave both the definitions and the levels of reduction to the individual Offices concerned. The definitions of small entities varied enormously between States and most had no separate concept of micro entities. In many States, small entities made up a very large proportion of all businesses. It was observed that fees were the main form of income for most Offices and the financial consequences of reductions would need to be analyzed carefully. One Authority noted that use of its reductions for small entities had greatly diminished because of litigation where a patent had been lost because the applicant had continued to pay reduced rate fees when it was no longer entitled, even though it was acknowledged that this was not done deliberately. Some Authorities stated that it would be better to encourage the provision of reductions, rather than making them mandatory. If provisions were included in the PCT, one Authority suggested that it might be better to include them into the relevant Rules and agreements specific to each individual type of fee.

66. The International Bureau noted that, at the fifth session of the PCT Working Group, it had been requested to prepare a paper on small entity fee reductions for fees payable to the International Bureau. A discussion paper would therefore be presented to the next session of the PCT Working Group covering at least some of these issues.

(F) INTEGRATE NATIONAL/INTERNATIONAL PHASES, USE A NATIONAL FIRST ACTION ON THE MERITS FOR PCT SEARCH REPORT, REQUIRE RESPONSE TO NEGATIVE COMMENTS AT THE NATIONAL PHASE

67. Discussions were based on paragraphs 17 to 20 of the Annex to document PCT/MIA/20/10.

68. Many of the Authorities supported the principles of this proposal. It was desirable to reduce duplication in the system and to strengthen the link between the international and national phases, especially in the Office which acted as International Searching or Preliminary Examining Authority. This would improve quality and reduce costs. However, it was emphasized that the national phase outcomes must always be determined by the relevant designated Office. Some aspects were, however, easier than others. Parts of the proposal had already been implemented unilaterally by some Offices. Other parts might require changes to national laws. Careful consideration was necessary to the appropriate implementation of the proposals.

(G) MANDATORY RECORDATION OF SEARCH STRATEGY

69. Discussions were based on paragraphs 21 to 23 of the Annex to document PCT/MIA/20/10.

70. The United States Patent and Trademark Office stated that it was pleased with the progress which had already been achieved in this area, particularly with regard to the fact that several Authorities were already making their search strategies publicly available, or were in the process of making them available, and that it had been agreed that the Quality Subgroup would discuss various aspects of what content was desirable (see paragraph 20, above and paragraphs 7 to 10 of the Annex to this document).

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.

(H) COLLABORATIVE SEARCHING (2 + OFFICES), ELIMINATE SUPPLEMENTARY INTERNATIONAL SEARCH / REFINING THE COLLABORATIVE SEARCH AND EXAMINATION

72. Discussions were based on paragraphs 24 to 29 of the Annex to document PCT/MIA/20/10 and paragraphs 23 to 27 of document PCT/MIA/20/12.

73. The United States Patent and Trademark Office outlined the approach which had been taken in the pilot referred to in paragraph 24 of the Annex to document PCT/MIA/20/10 and noted that overall the approach had involved less work for the examiners than would have been the case for the equivalent normal processes in two thirds of the applications concerned. Little additional search work would have been required in the national phases before the Offices participating in the pilot. Further analysis was required, but it was thought that additional international phase costs could be less than half of the normal international search fee for each additional International Authority, which could make such an approach very attractive for applicants.

74. Authorities expressed interest in this concept, but Authorities awaited completion of analysis of the pilot project. Further investigation was needed into a variety of issues, including the real efficiencies which could be expected, the likely fees and any effects on national phase laws and processes. Authorities were particularly interested in the means which had been used for sharing search strategies, which might provide useful input for discussions in the Quality Subgroup. The United States Patent and Trademark Office emphasized that it was not intended that the proposal should change the status of the international phase reports with respect to national laws; the reports would not be binding on designated Offices.

75. Several Authorities stated that the arrangement would only be desirable if all International Authorities would participate and the applicant was given a degree of choice about whether to use the service and which Authorities would be involved. It was suggested that if the document was resubmitted to the PCT Working Group, the title of the section should have the reference to supplementary international search amended or removed.

(I) MANDATORY TOP-UP SEARCHES / INTRODUCE OPTIONAL TOP-UP SEARCHES IN CHAPTER II

76. Discussions were based on paragraphs 30 to 32 of the Annex to document PCT/MIA/20/10 and paragraph 7 of the Annex to document PCT/MIA/20/11.

77. Authorities agreed that it would frequently be desirable for some form of top-up search to be conducted as part of international preliminary examination, but while there was some support for the proposal itself, most believed that the decision of whether to conduct a top-up search and what extent it should have should be at the discretion of the particular International Authority. One Authority noted that its applicants generally supported the notion of a top-up search, but did not wish to see any corresponding increase in Chapter II fees. Another Authority stated that it would be important to make clear that top-up searches would only be for the purpose of finding recently published prior art and not for extending the subject matter which had been originally searched.

78. The International Bureau noted that international preliminary examination was undertaken only by applicants who had a real wish to eliminate defects in their international applications before entering the national phase and that it would be in the interests of both applicants and elected Offices to give further serious consideration to this proposal. At very least, Chapter II reports should make clear whether or not a top-up search had been conducted so that elected Offices could be properly aware of the extent of the work which had been conducted in the international phase.

(J) DEVELOPMENT AND IMPLEMENTATION OF THE GLOBAL DOSSIER AND INCORPORATION OF SAID SYSTEM INTO THE PCT / CREATING AN IT INFRASTRUCTURE THAT IS CONDUCIVE TO "PCT KAIZEN"

79. Discussions were based on paragraphs 33 to 38 of the Annex to document PCT/MIA/20/10 and paragraphs 38 to 42 of document PCT/MIA/20/12.

80. The United States Patent and Trademark Office noted that the Global Dossier was currently a fairly abstract concept, but it was nevertheless very important, supporting the principle of minimizing the number of additional steps which were required to build on a first filing as it progressed through PCT or Paris routes before various Offices and to make best use of the work done and the information available from all those Offices by bringing as much information as possible into a single view.

81. Authorities welcomed the concept of a Global Dossier and looked forward to the development of more specific plans. The importance of an open architecture was emphasized, allowing the system to make use of synergies with existing platforms, including PATENTSCOPE, ePCT, WIPO-CASE and One Portal Dossier. Duplicate platforms should be avoided. It was also important to ensure that the arrangements took account of the needs of countries at different stages of development.

(K) FORMAL INTEGRATION OF THE PATENT PROSECUTION HIGHWAY INTO THE PCT, FAST TRACK OF NATIONAL PHASE APPLICATIONS, IMPROVE REUSE OF PCT WORK AT THE NATIONAL PHASE

82. Discussions were based on paragraphs 39 to 42 of the Annex to document PCT/MIA/20/10.

83. Authorities expressed general support for the proposal. Some Authorities emphasized the importance of accelerated treatment of an application being applicant-driven, the impact of expedited processing on resources in an Office, the need for PCT Contracting States to be able to make reservations of incompatibility with their national laws and the development of common guidelines by the Japan Patent Office within the Plurilateral Patent Prosecution Highway (PPH) Network. Should this proposal go forward, it would be necessary to have a common

understanding of the meaning of “sufficiently correspond” in the proposed new rules. While the proposal referred to PCT Articles 32(2) to (4) (novelty, inventive step and industrial applicability), it would also need to be certain whether other matters were relevant, for example, the effect of support and clarity points made in Box VIII. In addition, the Administrative Instructions would need to clarify what was meant by accelerated procedures, as treatments currently differed between PCT-PPH agreements.

(L) MAKING THE WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY AVAILABLE TO THE PUBLIC AFTER INTERNATIONAL PUBLICATION

84. Discussions were based on paragraphs 43 to 48 of the Annex to document PCT/MIA/20/10.

85. The United States Patent and Trademark Office drew the attention of Authorities to the options in paragraph 48 of the Annex to the document providing for three legislative options for making the written opinion of the International Searching Authority publicly available at an earlier stage. It expressed a preference for deletion of Rule 44*ter* and an understanding from Contracting States that Article 38 would not apply.

86. Authorities were supportive of the proposal as promoting transparency in the system, but expressed different preferences for the legislative options outlined in the document. Some Authorities favored the deletion of Rule 44*ter*, whereas some other Authorities considered that the making of the written opinion of the International Searching Authority available after 22 months from the priority date if no Chapter II demand had been filed as the option that would maintain the confidential nature of the international preliminary examination required by Article 38. Some Authorities also underlined the importance of the opinions of users, who needed to be consulted.

87. The International Bureau stated that it supported the concept of making the written opinion available at the time of international publication, provided that this did not require translation of the written opinion, as explained in document PCT/WG/5/10 Add. If PCT Contracting States could accept the deletion of Rule 44*ter* as being compatible with Article 38, this would be the simplest of the proposed options. With regard to making available the written opinion after 22 months from the priority date in the absence of a demand under Chapter II, the International Bureau was not always promptly informed that such a demand had been made. This could therefore result in the publication of the written opinion of applications where international preliminary examination had in fact been requested, leaving the question of whether published documents would subsequently need to be retracted.

(M) IMPROVE TIMELINESS FOR ESTABLISHMENT OF INTERNATIONAL SEARCH REPORTS

88. Discussions were based on paragraphs 9 to 11 and Appendix II of the Annex to document PCT/MIA/20/11.

89. Several Authorities expressed their full support for the proposal, which would allow International Searching Authorities to focus their efforts on establishing international search reports for international applications which were nearing the date of international publication. Two Authorities supported the proposal in principle but raised issues for further consideration. In particular, it would need to be considered whether the time between establishment of the international search report and the written opinion at 17 months and the international publication at 18 months from the priority date was sufficient for translations to be performed as this would be crucial to whether the proposal would achieve its intended aim of reducing the proportion of applications requiring A2 and A3 publication.

90. The International Bureau pointed out that the proposal resulted in later deadlines. For example, it would result in later establishment of international search reports for applications claiming priority but filed early during the 12 month priority period. Moreover, for the proposal to have the desired effects, it would be particularly important to address the question of ensuring that the International Searching Authorities received the search copy within 14 months from the priority date in almost every case.

91. The European Patent Office and the International Bureau agreed to work together to analyze the possible effects of the proposal on the preparations for international publication.

(N) IMPROVING QUALITY OF SEARCH/EXAMINATION AT THE INTERNATIONAL PHASE

92. Introducing the overall PCT Kaizen proposal, the Japan Patent Office stated that it aimed to maximize benefits based on the idea of “total optimization”. This was designed to optimize the efficiency and productivity of the entire system by taking a look at the system as one big process, coordinating each element and function. In this regard, the International Bureau, Contracting States and International Authorities should make efforts towards continuous improvement, ensuring smooth operation of the “Plan-Do-Check-Act” (PDCA) cycle.

93. Discussions were based on paragraphs 11 to 13 of document PCT/MIA/20/12.

94. In relation to the proposal to improve quality of search and examination in the international phase by the development of two feedback frameworks as outlined in paragraph 11 of document PCT/MIA/20/12, the Meeting referred to the discussions on quality feedback mechanisms that had taken place in the Quality Subgroup and agreed that the work should continue in the Subgroup (see paragraphs 16 to 19 of the Annex to this document).

(O) PROMOTING LINKAGE BETWEEN THE INTERNATIONAL PHASE AND THE NATIONAL PHASE

95. Discussions were based on paragraphs 14 to 22 of document PCT/MIA/20/12.

96. Authorities noted the overlap with proposal (F) of the Expanded PCT 20/20 Proposals in document PCT/MIA/20/10 (see paragraphs 67 and 68, above).

97. The Japan Patent Office agreed to share its guidelines referred to in paragraph 20 of document PCT/MIA/20/12 for utilizing the prior art search and examination results in the international phase. The Meeting recommended that other designated Offices should similarly be invited to share such guidelines to assist common understanding of best practices.

(P) INCREASING BASIC INFORMATION DESIGNED FOR ANALYZING AND IMPROVING THE PCT PROCESS

98. Discussions were based on paragraphs 28 to 37 of document PCT/MIA/20/12.

99. Several Authorities expressed their support for the proposal to be taken forward, but acknowledged the need for the work not to be too resource intensive, and for concrete examples to be developed for actions envisaged by the Japan Patent Office in this area under the Kaizen process. The Meeting agreed that this process should be pursued in the Quality Subgroup.

OTHER ISSUES

100. The Meeting noted that the proposals set out in paragraph 8 of the Annex to document PCT/MIA/20/11 (Incorporate PCT Metrics in the PCT ISPE Guidelines) had been considered under Agenda item 6 (see paragraph 20, above, and paragraphs 25 to 28 of Annex II to this document).

SUMMARY

101. The Chair concluded that there was agreement that all of the issues in the three documents should continue to be considered, but that, in addition to issues for the Quality Subgroup, there was particular interest and hope for fast progress in the PCT Working Group on items A (Self-Service Changes), F (Integrate National and International Phases), K (Integration of PPH), L (Availability of Written Opinions) and M (Improve Timeliness of ISRs).

102. The Meeting noted the contents of documents PCT/MIA/20/10, 11 and 12.

ITEM 14: APPOINTMENT OF INTERNATIONAL AUTHORITIES

103. Discussions were based on document PCT/MIA/20/13.

104. All Authorities which took the floor appreciated the efforts of the International Bureau to put this document together.

105. One Authority stated that it considered both the current requirements (notably in relation to quality management systems and the minimum number of examiners) as well as the current procedures for appointment sufficient and that they should only be changed if there is sufficient evidence to do so. While more than 40 years had passed since those requirements and procedures had been put in place, that did not automatically mean that those requirements and procedures were no longer appropriate.

106. Most Authorities which took the floor considered that there was a need for a review of the requirements and procedures, which had been set up in the 1970s and might no longer be appropriate today. It was recognized that ensuring a high quality international search and preliminary examination was very important and that a careful study was required before considering making proposals for change of current requirements and procedures.

107. With regard to the requirements for appointment, suggestions by one or more Authorities as to the issues to be considered included the following:

(a) Access to the PCT Minimum Documentation: the current requirement should be clarified so as to ensure that an Office seeking appointment had access to the entire PCT Minimum Documentation at the time it submitted its request for appointment, rather than appointing an Office on the basis of a commitment to comply with this requirement after appointment but prior to the start of operations as an Authority.

(b) Minimum number of examiners: the requirement of 100 examiners should be reviewed with a view to increasing that number, either as a requirement applicable to all Offices seeking or holding appointment or applicable only to Offices from certain regions. Offices should be required to demonstrate that those examiners had the sufficient level of expertise in a wide range of technical fields. Only full time examiners employed by the Office and not any form of "external experts" should be considered in this context.

(c) Quality management systems: An Office seeking appointment should be required to demonstrate to have had experience with a national quality management system similar to that under Chapter 21 of the PCT International Search and Preliminary Examination Guidelines. Furthermore, any Office seeking appointment should be required to have a quality management system complying with Chapter 21 of the Guidelines in place at the time it submitted its request for appointment, rather than appointing an Office on the basis of a commitment to comply with this requirement after appointment but prior to the start of operations as an Authority.

(d) Additional requirements to be complied with by an Office seeking appointment should be added, such as: (i) a certain (yet to be determined) minimum number of national filings per year; (ii) proof of sufficient experience in carrying out search and examination to the expected level of quality; (iii) support by other Member States, demonstrated by the fact that the receiving Offices of those States committed to choose the Office in its capacity as an Authority to be competent to carry out international search and preliminary examination in respect of applications filed by “their” applicants, rather than that Office acting as an Authority only for its “own” applicants.

(e) Offices should be encouraged to seek, at least initially, only a limited appointment, in line with PCT Article 65, which provided for the possibility of limiting the number and/or kind of applications to be searched and examined by that Authority.

(f) Any revised requirements for appointment should not affect any Office already holding an appointment.

(g) The number of Offices holding appointment should be limited to the current number until agreement had been reached on a new set of requirements.

108. With regard to the procedures for appointment, suggestions as to the issues to be considered included the following:

(a) The Meeting of International Authorities should act as an advisory body to the Committee on Technical Cooperation (PCT/CTC) with regard to the compliance of an Office seeking appointment with the applicable technical and legal requirements for appointment.

(b) Future sessions of the Committee on Technical Cooperation (PCT/CTC) should no longer be held in the context of the WIPO Assemblies, back-to-back with the session of the PCT Assembly deciding on the appointment, but rather in advance of that session, such as back-to-back with a session of the PCT Working Group, so as to allow it to function as a proper technical advisory body.

109. The Meeting agreed to request the International Bureau to inform the PCT Working Group on the views expressed and the proposals made during its present session, preferably by including an excerpt from the Summary by the Chair of this session in the document to be submitted on the issue to the PCT Working Group for consideration at its next session in May 2013.

ITEM 15: FUTURE WORK

110. The Meeting noted that the next session was expected to be convened in the first quarter of 2014, probably immediately following a meeting of the Quality Subgroup. The Meeting was pleased to receive an offer by the Representative of the Israel Patent Office to host the 2014 sessions of the Meeting of International Authorities and of the Quality Subgroup in Israel.

ITEM 16: SUMMARY BY THE CHAIR

111. The Meeting noted this Summary by the Chair.

ITEM 17: CLOSING OF THE SESSION

112. The Meeting closed February 8, 2013.

[Annex I to document PCT/MIA/20/14, containing a list of participants, is not reproduced here]

[Annex II (to document
PCT/MIA/20/14) follows]

ANNEX II (to document PCT/MIA/20/14)

PCT QUALITY SUBGROUP, THIRD INFORMAL SESSION
MUNICH, FEBRUARY 4 AND 5, 2013

SUMMARY BY THE CHAIR

1. REPORTS ON QUALITY MANAGEMENT SYSTEMS UNDER CHAPTER 21 OF THE PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

(A) REPORTS BY INTERNATIONAL AUTHORITIES

1. Authorities shared the updates they had made to their Quality Management Systems in 2012. The Subgroup agreed on the importance of Authorities reviewing their Quality Management Systems to identify gaps to build more confidence and trust in their systems. The preparation of quality reports was seen as a useful self-reflection tool and some Authorities perceived value in learning from the experiences by studying the reports of other Offices, notably in the case of an Authority commencing operations. Furthermore, the sharing of experiences was seen as a valuable opportunity to achieve greater consistency between Authorities by learning from one another and incorporating best practices.
2. Authorities discussed the establishment and review of their quality policies and making available quality goals under paragraph 21.18 of the Guidelines. A few Authorities stated that they made their quality policy available online and supported the making available of quality goals and results. However, one Authority, while emphasizing that it made some of its targets publicly available, believed that the quality goals could be stated as strategic aims rather than specific targets. The Spanish Patent and Trademark Office offered to prepare guidelines on the establishment of a quality policy and to post these on the Subgroup's electronic forum.
3. On the subject of sampling rates on actions during internal quality assurance processes, the Subgroup agreed that the proportion of cases analyzed would depend on a number of factors, such as the nature and level of detail of the review, the stage in the processing of an application, the need to achieve a statistically significant number of cases, the action to be undertaken following the review and the availability of resources. Some Authorities pointed to situations where they felt that it was necessary to review a particular type of action for 100 per cent of cases. Although it was accepted that there were good reasons for a wide distribution of sample rates between different Offices and different functions, Authorities agreed that there could be benefit to sharing information on sampling rates as part of an overall picture on how sampling is structured within an Authority.
4. The Subgroup also discussed the issue of how quality assurance systems could be used across national and international work products produced by an Office. Whereas in many cases the needs for quality assurance were very similar, there were differences in timing of actions for international work products. In this regard, one Authority pointed out that for international work performed under contract, systems needed to be different so that action could be taken with the contractor prior to dispatch of the report.
5. Authorities welcomed the method of reporting used to produce the quality reports for 2012 by indicating "track changes" or other highlighting on the full report to indicate differences in their Quality Management Systems from previous reports.

6. The Subgroup recommended:

(a) to establish a task on the Subgroup's electronic forum under the lead of the Spanish Patent and Trademark Office to share quality policies and guidelines for their review and establishment,

(b) to share further information through the Subgroup's electronic forum on the sampling of cases in their quality assurance process, including sampling rates of cases.

(c) to continue to produce annual reports on their Quality Management Systems in future years using a full report, indicating changes that had been made to their systems in the preceding year.

2. BETTER UNDERSTANDING THE WORK OF OTHER OFFICES

(A) UTILITY OF SEARCH STRATEGIES (CIRCULAR C. PCT 1357)

7. Several Authorities stated that they were in the process of making their search strategies (in the form in which they were currently recorded in their systems) available to the International Bureau for inclusion in PATENTSCOPE, in addition to the two which already do so. One Authority stated that, in order to do this, it had changed its practice and now recorded such search strategies on a form in English rather than its official language; it was also translating its guidelines on the use of search strategies into English.

8. Authorities noted that the main target audience and major beneficiary of search strategies were the examiners in designated Offices, providing them with a tool to assist in the understanding and evaluation of the quality of the international search. Authorities further noted the importance of search strategies as an educational tool for continued improvement and learning, for internal quality control and for the confidence of examiners at later stages of processing (in the same or a different Office), as well as a means to increase the transparency for applicants. The right balance needed to be struck between completeness of information and usability. Large volumes of information could make it difficult to find the significant issues. Eventually it would be desirable to standardize presentation of information, but the immediate need was to see, understand and learn from the strategies which were available. Several Authorities stated that it was very useful to see which search query results an examiner had specifically viewed in addition to the strategy itself. Concerns were expressed at a suggestion that an explanation of the examiner's view of the inventive concept should be included since it would often be difficult and time-consuming to express this clearly. However, there would be occasions when it would be appropriate to make explanations in Box V of the written opinion about the way in which an unclear claim had been interpreted.

9. Authorities agreed that a greater degree of understanding and thus further discussion was required in relation to several aspects:

(a) the different purposes of search strategies, as indicated in paragraph 8, above;

(b) the terminology to be used; in this context, several Authorities expressed their support for the definitions suggested by the Israel Patent Office in its submission on the Subgroup's electronic forum as the basis for preparing proposals to include suitable definitions in the PCT International Search and Preliminary Examination Guidelines;

(c) the minimum elements which should be included in search strategies to be made available to other Offices or the public, as well as any corresponding modifications which may be appropriate to the quality framework under Chapter 21 of the International Search and Preliminary Examination Guidelines.

10. The Subgroup recommended to continue the discussions on the Subgroup's electronic forum, based on an analysis of the examples of search strategies already posted by various Authorities, identifying common elements, differences and gaps. Authorities which had not already provided examples of strategies were invited to do so.

(B) STANDARDIZED PARAGRAPHS (CIRCULAR C. PCT 1328)

11. Authorities re-confirmed their agreement that the use of standardized paragraphs should never be mandatory, noting the need for flexibility for the examiner to address all relevant issues in a manner which he or she deemed appropriate in the given case. In this context, several Authorities expressed concerns with regard to the proposed inclusion of subheadings in Boxes V and VIII, which were felt to be unnecessary and too limiting for examiners. One Authority expressed the view that the PCT already provided enough structure for reports and that not much, if anything, would be gained by further adding to that structure; this Authority mainly used standardized clauses as a tool to guide inexperienced examiners to cover all required issues to an appropriate level of detail.

12. Authorities agreed that there was sufficient merit in continuing to seek to develop model standardized paragraphs. The Subgroup recommended that further work should be initially focused on standardized paragraphs for novelty considerations in Box V, and that the work should continue to be led by the Canadian Intellectual Property Office, assisted by the National Board of Patents and Registrations of Finland, the Spanish Patent and Trademark Office and the United States Patent and Trademark Office, as well as the International Bureau. To broaden the basis for further work, Authorities which had not already done so were invited to post any standardized clauses presently used by them on the Subgroup's electronic forum.

3. QUALITY IMPROVEMENT MEASURES

(A) QUALITY IMPROVEMENT MEASURES (CIRCULAR C. PCT 1356)

13. Authorities noted the usefulness of checklists as part of the quality assurance process of Authorities. The Subgroup recommended to modify Chapter 21 of the PCT International Search and Preliminary Examination Guidelines (and the reporting template) to provide for the optional use of such checklists. The Subgroup would need to consider the exact wording for a modification to paragraph 21.18 to accommodate this point. The Subgroup further recommended to commence work on the possible content of such checklists on the Subgroup's electronic forum. It was important to distinguish between checklists for the purposes of quality assurance and checklists for examiners and other staff preparing international search reports and conducting related tasks.

14. With regard to the need to re-evaluate search results where no relevant X or Y documents had been found by the examiner, Authorities noted the link with the ongoing discussions on quality metrics and the utilization of international reports by and feedback mechanisms for designated Offices.

15. With regard to the current practices of Authorities to determine compliance with quality indicators and assessing reports by a grading system, while several Authorities reported on the existence of such systems, Authorities agreed that the focus of future work should be on the development of quality metrics and standards rather than on identifying best practices of how to classify non-compliant work products.

(B) UTILIZATION AND ANALYSIS OF FEEDBACK ON WOISA/ISR AND SHARING OF ANALYSIS RESULTS

16. The Japan Patent Office (JPO) presented the results of an analysis of files in the national phase where the JPO had acted as the International Searching Authority but the designated Office had taken a different decision on the case. In this process, the JPO had categorized the causes of discrepancies and identified situations where the quality of search and examination of results by International Authorities and designated Offices would improve with appropriate feedback mechanisms in place. In other cases, differences were due to the misunderstanding by designated Offices of citation information in international search reports from the JPO where there could be room for improvement in increasing accuracy of machine translation and how Japanese non-patent literature references were transliterated into the Latin alphabet, or due to differences in laws and practices or claim interpretation. Concerning transliteration of non-Latin characters, the International Bureau indicated that this could be taken forward by the Task Force currently undertaking a revision of WIPO Standard ST.14.

17. The Japan Patent Office proposed that a framework could be developed under which International Searching Authorities analyzed and utilized feedback on the international search report and written opinion from designated Offices based on their first actions, and shared the results of this analysis with designated Offices. In this context, phase 3 of the Metrics Study between the Japan Patent Office and the European Patent Office could shed light as a first step in developing this framework.

18. Authorities welcomed the proposal as an important step to enhancing quality and increasing work sharing and pointed to similarities with the pilot project conducted by the Swedish Patent and Registration Office to be presented to the Subgroup. It was, however, pointed out that any analysis of differences in results between the international and national phase would be labor intensive without the existence of structured data. In order to address this challenge, the International Bureau emphasized the need for national phase data to be provided reliably in a structured format, such as XML.

19. The Subgroup noted the value of the exercise undertaken by the Japan Patent Office and recommended that the work on developing feedback frameworks should continue.

4. QUALITY METRICS

(A) CHARACTERISTICS OF INTERNATIONAL SEARCH REPORTS (CIRCULAR C. PCT 1360)

20. With reference to the report on “Characteristics of International Search Reports” issued with Circular C. PCT 1360, the International Bureau emphasized that none of the matters measured were intended to provide nor did they provide any sort of measure of quality as such. Rather, the characteristics showed the most useful information which could be extracted from the structured information currently available, helping Authorities to identify trends and issues which might be the focus of more detailed work. It was particularly important to note that the information included figures for breakdowns by technical field, in addition to the overall figures which were the subject of the main charts. The International Bureau believed that it had been an extremely useful exercise, which should be repeated and refined. In particular, the report should form the basis of discussions of what Authorities would ideally like to measure.

21. Authorities agreed on the usefulness of the report, provided that its limitations were properly understood, and supported further versions of the report being prepared in the future.

22. It was noted that there was a wide range of reasons for differences between the findings for different Authorities. Nevertheless, the reasons for such differences would in some cases be something which quality departments might wish to investigate. It was also noted that it may be useful to break down further some characteristics, such as showing the difference between cases prosecuted by private applicants and with professional representation. Various other desired improvements had been set out in the Quality Subgroup's electronic forum. Some were deemed possible based on existing data. Others would require new data to be provided in structured format. Most useful would be detailed information on national phase processing and citations.

23. It was noted that the characteristics reflected international search reports only to the end of 2010. The data currently relies on use of EPO tools to extract citation information from scanned search reports, with collected data made available via PATSTAT (a database released for statistical use on a twice-year basis containing data for published applications). If all Authorities were to provide international search reports in XML format, the reports could be more up to date.

24. The Subgroup recommended that:

- (a) the International Bureau should provide similar reports in coming years;
- (b) the International Bureau should complete the assessment of which of the desired improvements were possible using existing data and make recommendations for changes which should be included in the next version;
- (c) the Subgroup should continue to analyze what improvements were desirable and make recommendations on the additional data which should be collected to support this.

(B) A PCT METRICS FRAMEWORK

25. The European Patent Office presented a proposal to prepare metrics covering a wide range of aspects of the PCT process, including the work of receiving Offices, International Searching and Preliminary Examining Authorities, the International Bureau, designated and elected Offices and the interactions between those Offices and between Offices and applicants, aimed at helping to assess how effectively the PCT system as a whole was performing and to identify areas where processes could be improved.

26. The International Bureau reminded Authorities of the information which was already available on this subject from the WIPO web site² and confirmed its willingness to work further on this subject if national Offices in their various capacities were willing to provide the necessary additional information in a structured format. It was suggested that this was a sufficiently important matter to be treated as a specific project, with milestones for contributions and completion.

27. Authorities agreed that metrics covering the entire PCT process would be very useful in supporting improvements to the system, though there were some concerns about the resources which would be required to support some of the metrics referred to in the proposal. It was also important to properly understand the data and any limitations which it may have, for example, due to different frequencies of data delivery by national Offices.

28. The Subgroup recommended that the European Patent Office, International Bureau and other interested Offices should continue to develop this proposal, including discussions in the IP5 context.

² <http://www.wipo.int/ipstats/en/statistics/pct/>

(C) PILOT PROJECT “ANALYSIS OF THE USEFULNESS FOR THE NATIONAL PHASE OF INTERNATIONAL SEARCH REPORTS”

29. The Swedish Patent and Registration Office (PRV) reported on a pilot project to evaluate international applications which had entered the national phase in Sweden having only “A” category citations and determine whether any “X” or “Y” category documents had been cited as a result of further search in the national phase. There was a sufficiently small number of applications involved that this could be done for a year’s worth of applications. This also meant that the results were not statistically significant, but were nevertheless interesting. Such additional citations had been found in 6.8 per cent of cases. The relevance of the new citations had not been assessed, but it had been shown that this was an example of a practical way to identify cases which could be useful to analyze in more detail. The pure statistical data might also provide useful information if measured continually and used to identify trends and differences between Offices or technical fields.

30. Authorities thanked the PRV for its work. It was noted that this and similar exercises which had been carried out in other contexts showed that it was possible to get interesting information from relatively simple procedures. It was, however, important to ensure that the statistics were not used in isolation, but were followed up with detailed analysis of the cases involved to determine the reasons for differences. A full analysis would ideally have the engagement of both the designated Office and the International Searching Authority and include detailed feedback from examiners in addition to the pure data concerning the additional cited documents. There would be at least two aims of analysis, covering both improvement at the level of the individual application and of the overall system.

31. It was also observed that the national phase search was done from a different starting point, with the second Office able to focus on perfecting the search, for example giving particular attention to documents in different languages. It might be useful to make a comparison with other, roughly equivalent, situations, such as those which may occur using the Patent Prosecution Highway.

32. The Subgroup recommended that it should continue to prepare and assess proposals such as this for helping to analyze the usefulness of international search reports for the international phase. As one activity, the Subgroup welcomed the proposal by the Japan Patent Office that the Subgroup should commence work on the development of a draft template³ for providing structured feedback on international applications from designated Offices to the International Searching Authority. That work would be done through developing ongoing projects, such as the proposed arrangements for an ePCT/PCT-EDI quality feedback system, phase 3 of the Trilateral Collaborative Metrics study and the feedback mechanisms proposed by the Japan Patent Office.

33. In relation to all three sub-items under the heading “Quality Metrics” as well as other activities related to work sharing, the Subgroup recommended that it should seek to identify a range of structured data which should be provided by Offices to support the various aspects of the work. Further, the Subgroup should recommend timelines and milestones which could form the basis of a project by at least the Offices which act as International Authorities to support the development of improved metrics to measure the effectiveness of the PCT system as a whole as well as to improve the functioning of the PCT system as a work sharing platform.

³ See, for example, paragraph 5 of document PCT/MIA/16/5.

5. OTHER IDEAS FOR QUALITY IMPROVEMENT

34. One International Authority noted that it wished to improve the internal training which it provided on PCT issues and had found the examples given on unity of invention in Chapter 10 of the PCT International Search and Preliminary Examination Guidelines to be limited.

35. The Subgroup recommended that International Authorities should make available any training materials or good examples of unity of invention issues on the Quality Subgroup electronic forum for the consideration of all International Authorities. If consensus could be found on good examples, this might lead to revision of the Guidelines.

[End of Annex and of document]