

International Patent Cooperation Union (PCT Union)

Assembly

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QUALITY-RELATED WORK BY INTERNATIONAL AUTHORITIES

Document prepared by the International Bureau

SUMMARY

1. This document contains a brief report on the ongoing quality-related work by the International Searching and Preliminary Examining Authorities under the PCT (“International Authorities”), pursued mainly through the work of the Quality Subgroup set up by the Meeting of International Authorities at its seventeenth session in 2009.

ONGOING QUALITY-RELATED WORK

2. A third informal session of the Quality Subgroup took place in Munich in February 2013, just prior to the twentieth session of the Meeting of International Authorities. The Summary by the Chair of that third informal session is reproduced in the Annex to this document.

3. Among the items discussed by the Quality Subgroup at its third informal session was a report, produced for the first time, on the characteristics of international search reports established by all International Authorities. The aim of the report is not to measure quality on the basis of the characteristics, but to see what can be learned from those characteristics about the international search reports established by all International Authorities in order to assist direction of the work under way to improve quality, whether internally within individual Authorities or collectively between the Authorities, including, eventually, the development of

statistically measurable aspects of quality. The Quality Subgroup recommended to the Meeting of International Authorities that similar reports should be prepared in the coming years (see paragraphs 20 to 24 of the Summary by the Chair of the third informal session of the Quality Subgroup, reproduced in the Annex to this document).

4. The Quality Subgroup further discussed a proposal by the European Patent Office (EPO) to develop a set of metrics for the entire PCT system, covering the work of receiving Offices, International Searching and Preliminary Examining Authorities, designated/elected Offices and the International Bureau as well the interactions between the various Offices and applicants (see paragraphs 25 to 28 of the Summary by the Chair of the third informal session of the Quality Subgroup, reproduced in the Annex to this document). A first preliminary draft of a proposed “PCT Metrics Framework” is currently being discussed among the International Authorities on the Quality Subgroup’s electronic forum, with the aim of further developing the proposal before presenting it to a wider audience of all PCT Member States for further consultation and eventually agreement.

5. Finally, the Quality Subgroup noted reports by the Japan Patent Office (JPO) and the Swedish Patent and Registration Office (PRV) on the results of analyses carried out by both Offices of the differences between international search reports and subsequent national search and examination reports established by designated Offices after national phase entry (where International Searching Authority and designated Office were not the same Office). The Quality Subgroup welcomed the reports and agreed that work should continue aimed at developing feedback frameworks under which International Searching Authorities analyzed and utilized feedback on international search reports and written opinions from designated Offices and shared the results of their analyses with designated Offices (see paragraphs 16 to 19, and 29 to 33 of the Summary by the Chair of the third informal session of the Quality Subgroup, reproduced in the Annex to this document).

6. At its twentieth session, held in Munich in February 2013, the Meeting of International Authorities noted with approval the Summary by the Chair of the third informal session of the Quality Subgroup and agreed with all recommendations of the Quality Subgroup. In addition, the Meeting of International Authorities approved the continuation of the Subgroup’s mandate, including the convening of a further physical informal session of the Quality Subgroup in 2014. It further agreed to the publication of annual reports submitted by International Authorities on their quality management systems, which are available on the WIPO web site at <http://www.wipo.int/pct/en/quality/authorities.html>. The Summary by the Chair of the twentieth session of the Meeting of International Authorities (document PCT/MIA/20/14) is available on the WIPO web site¹.

7. The Assembly of the PCT Union is invited to note the contents of this document.

[Annex follows]

¹ See http://www.wipo.int/meetings/en/details.jsp?meeting_id=28303

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

SUMMARY BY THE CHAIR

(reproduced from Annex II to PCT/MIA/20/14)

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.

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

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.

(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]