

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Sixth (27th Extraordinary) Session
Geneva, September 22 to 30, 2014

PROCEDURES FOR APPOINTMENT OF INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES UNDER THE PCT

Document prepared by the International Bureau

SUMMARY

1. As recommended by the PCT Working Group, the PCT Assembly is invited to adopt an Understanding with regard to the procedures for appointment of an Office as an International Searching and Preliminary Examining Authority (“International Authority”) under the PCT, designed to ensure that:

(a) the PCT Committee for Technical Cooperation (PCT/CTC) meets as an expert body in advance of the PCT Assembly considering a request for appointment of an Office as an International Authority; and

(b) Offices seeking appointment meet the necessary criteria at the time of appointment, rather than the appointments being provisional on further steps being completed before the Office begins operation as an International Authority.

BACKGROUND

2. At its forty-fourth session, held from September 23 to October 2, 2013, the PCT Assembly approved a recommendation that the International Bureau should undertake a review of the criteria and procedures for appointment of an Office as an International Authority and make proposals for necessary changes, if appropriate, in coordination where appropriate with the

Meeting of International Authorities (PCT/MIA), for discussion by the PCT Working Group at its next session (paragraph 3 of document PCT/A/44/1 and paragraph 19(ii) of document PCT/A/44/5).

3. As a first stage in the review of the criteria and procedures for appointment of an Office as an International Authority, as mandated by the PCT Assembly, the International Bureau sought the input from the PCT/MIA, which discussed the issue at its twenty-first session, held in Tel Aviv from February 11 to 13, 2014, based on a document prepared by the International Bureau (document PCT/MIA/21/3) and a document submitted by the European Patent Office (EPO), the Federal Service for Intellectual Property (ROSPATENT) and the United States Patent and Trademark Office (USPTO) (document PCT/MIA/21/21). The discussions by the Meeting are set out in paragraphs 44 to 54 of the Summary by the Chair of the session (document PCT/MIA/21/22 in English only, reproduced in all six languages of the United Nations in the Annex to document PCT/WG/7/3).

4. The issues were then discussed by the seventh session of the PCT Working Group, held from June 10 to 13, 2014, based on document PCT/WG/7/4. The discussions by the Working Group are set out in paragraphs 40 to 52 of the Summary by the Chair of the session (document PCT/WG/7/29, reproduced in the Annex to document PCT/A/46/1).

5. The discussions of the Working Group can be summarized as follows:

(a) With regard to the substantive criteria for appointment, the Working Group agreed that it was premature to recommend any changes. Noting that the key issue at stake was ensuring that Offices were able to perform international search and preliminary examination to the necessary level of quality, the PCT/MIA tasked its Quality Subgroup to further consider the quality requirements to act effectively as an Authority and how these could be better expressed in the criteria for appointment. The Working Group agreed to await the outcome of discussions in that Subgroup and the PCT/MIA before further considering the issue at its next session in 2015.

(b) With regard to the procedures for appointment, the Working Group agreed that the procedures for appointment would greatly benefit from the inclusion of a proper expert review of the application of an Office prior to a decision being taken by the Assembly. It thus recommended that the PCT Assembly adopt an Understanding as set out below in order to ensure that the PCT/CTC, entrusted by the Treaty to give its advice to the Assembly on any application for appointment, should always meet as a true expert body, well in advance of the PCT Assembly, to ensure that the process leading up to the decision by the PCT Assembly is in fact useful and efficient. Several delegations indicated they would have preferred to include in the procedures a more formal role for the existing International Authorities, in the form of discussion by the PCT/MIA with a view to preparing further technical advice for discussion by the PCT/CTC; however, there was no consensus in the Working Group on this issue.

(c) The Working Group furthermore recommended that Offices seeking appointment should meet all the necessary criteria at the time of appointment, save for a specific exception regarding quality management systems as indicated in paragraph (d) of the draft Understanding, below, since such systems cannot be brought into effective operation until the Office seeking appointment actually commences operation as an International Authority.

PROPOSAL

6. The Working Group thus recommended that the PCT Assembly adopt the following Understanding:

“Procedures for Appointment of International Authorities”:

“(a) A national Office or an intergovernmental organization (“Office”) seeking appointment is strongly recommended to obtain the assistance of one or more existing International Authorities to help in the assessment of the extent to which it meets the criteria, prior to making the application.

“(b) Any application for appointment of an Office as an International Authority is to be made well in advance of its consideration by the PCT Assembly so as to allow time for an adequate review by the Committee for Technical Cooperation (PCT/CTC). The PCT/CTC should meet as a true expert body at least three months in advance of the PCT Assembly, if possible back-to-back with a session of the PCT Working Group (usually convened around May/June of any given year), with a view to giving its expert advice on the application to the PCT Assembly.

“(c) Consequently, a written request to the Director General to convene the PCT/CTC is to be sent by the Office preferably by March 1 of the year in which the application is to be considered by the PCT Assembly and in any case in time to allow the Director General to send out letters of convocation of the PCT/CTC not less than two months prior to the opening of the session.

“(d) Any such application should be made on the understanding that the Office seeking appointment must meet all substantive criteria for appointment at the time of the appointment by the Assembly and is prepared to start operation as an International Authority as soon as reasonably possible following appointment, at the latest around 18 months following the appointment. With regard to the requirement that the Office seeking appointment must have in place a quality management system and internal review arrangements in accordance with the common rules of international search, where such system is not yet in place at the time of the appointment by the Assembly, it shall be sufficient that such system is fully planned and, preferably, that similar systems are already operational in respect of national search and examination work to demonstrate the appropriate experience.

“(e) Any document by the Office in support of its application for consideration by the PCT/CTC should be submitted to the Director General at the latest two months prior to the opening of the session of the PCT/CTC.

“(f) Any such application is then to be submitted to the PCT Assembly (usually convened around September/October of any given year), together with any advice given by the PCT/CTC, with a view to deciding on the application.”

7. The Working Group further recommended that the PCT Assembly adopt the following decision concerning entry into force in respect of the proposed Understanding:

“The procedures for appointment of International Authorities set out in the above Understanding shall apply to any application for appointment as an International Authority submitted after the closure of the present session of the PCT Assembly.”

8. *The Assembly is invited to adopt the proposed Understanding on “Procedures for Appointment of International Authorities” set out in paragraph 6 of document PCT/A/46/4 and the decision concerning entry into force set out in paragraph 7 of the same document.*

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