

Patent Cooperation Treaty (PCT) Working Group

**Twelfth Session
Geneva, June 11 to 14, 2019**

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT ON THE TWENTY-SIXTH SESSION

Document prepared by the International Bureau

1. The Annex to this document sets out the Summary by the Chair of the twenty-sixth session of the Meeting of International Authorities under the Patent Cooperation Treaty (PCT/MIA), held in Cairo, Egypt on February 13 and 14, 2019. Annex II to this Summary by the Chair contains the Summary by the Chair of the ninth informal meeting of the PCT/MIA Quality Subgroup, which was held immediately prior to the Meeting of International Authorities in Cairo on February 11 and 12, 2019.

2. *The Working Group is invited to note the Summary by the Chair of the twenty-sixth session of the Meeting of International Authorities under the PCT (document PCT/MIA/26/13), reproduced in the Annex to this document.*

[Annex follows]

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

TWENTY-SIXTH SESSION, CAIRO, FEBRUARY 13 AND 14, 2019

SUMMARY BY THE CHAIR

(noted by the Meeting; reproduced from document PCT/MIA/26/13)

INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its twenty-sixth session in Cairo on February 13 and 14, 2019.
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 China National Intellectual Property Administration, the Egyptian Patent Office, the European Patent Office, the Federal Service for Intellectual Property of the Russian Federation, the Finnish Patent and Registration Office, the Indian Patent Office, the Intellectual Property Office of the Philippines, the Intellectual Property Office of Singapore, IP Australia, the Japan Patent Office, the Korean Intellectual Property Office, the National Institute of Industrial Property of Chile, the Nordic Patent Institute, the Spanish Patent and Trademark Office, the Swedish Patent and Registration Office, the Turkish Patent and Trademark Office, the Ukrainian Intellectual Property Institute, the United States Patent and Trademark Office and the Visegrad Patent Institute.
3. The list of participants is contained in Annex I to this document.

ITEM 1: OPENING OF THE SESSION

4. Mr. Michael Richardson, Director, PCT Business Development Division, welcomed the participants on behalf of the Director General of WIPO and thanked the Egyptian Patent Office for hosting the Meeting. In his opening remarks, he acknowledged the key role that Egypt has played since its accession to the PCT in 2003. Following a request from Egypt, Arabic became a language of publication in the PCT from April 1, 2006; since then, the PCT languages of publication had included all six official languages of the United Nations. But without an International Searching Authority able to accept Arabic, applicants filing in this language were required to meet the costs of translating the international application for the purposes of international search, putting them at a disadvantage compared to applicants using other PCT publication languages for their filing. The appointment of the Egyptian Patent Office as an International Searching and Preliminary Examining Authority in 2009 was therefore a key milestone in the recent history of the PCT. The Egyptian Patent Office became the first International Authority in Africa, the first International Authority in the Arab region, and the first International Authority to offer international search and preliminary examination in Arabic. It was therefore opportune that, on the tenth anniversary of its appointment, the Egyptian Patent Office was hosting this year’s Meeting of International Authorities.

5. As of the start of operations of the Egyptian Patent Office as an International Searching and Preliminary Examining Authority on April 1, 2013, applicants have had the possibility to use Arabic throughout the international phase. This had brought about a significant change in the use of Arabic in the PCT. Before this date, the International Bureau had published only one international application in Arabic; this total was now about 125. While filings in Arabic were still at low levels compared to filings in other PCT publication languages, of the 10 States that had acceded to the PCT since 2010, five were Member States of the Arab League, namely Djibouti, Jordan, Kuwait, Qatar, and Saudi Arabia. And of the eight Arab countries whose

receiving Offices had nominated the Egyptian Patent Office as a competent International Searching and Preliminary Examining Authority, four of those were States that acceded to the PCT less than 10 years ago.

6. The International Bureau also thanked the Academy of Scientific Research and Technology of Egypt (ASRT) for its collaboration with WIPO in promoting innovation and creativity not just in Egypt, but across the Arab region. More than 40 WIPO Technology and Innovation Support Centers (TISCs) now operated in Egyptian universities, providing innovators with access to information and services to help them exploit their innovative potential, and protect their ideas through intellectual property rights. The Global Innovation Index had also shown a resulting rise in innovative activity in Egypt, with Egypt's score increasing in 2018, bringing its ranking up 10 places from the previous year. The International Bureau looked forward to deepening its cooperation with ARST in the near future.

7. In concluding, the Mr. Richardson highlighted the importance of cooperation and the collective responsibility of Offices and other stakeholders in the future development of the PCT as an emerging theme from the meeting agenda. In this regard, he hoped to see proposals for action by International Authorities, individually and collectively, to improve the processes and results of the PCT for applicants, designated Offices and the general public alike.

8. Prof. Mahmoud M Sakr, President of the Academy of Scientific Research and Technology (ASRT), welcomed the participants to the session and expressed pleasure that Egypt was hosting the Meeting for the first time. Prof. Sakr expressed his gratitude for the process that had been made in the field of intellectual property through the various efforts by WIPO and its continuous support to IP Offices, especially those in developing countries. The protection of IP promoted innovation and technological development, and was considered an important driver for economic growth. Thanks to the efforts of WIPO, Egypt now had an effective IP system that maintained optimal balance between the right holder and the general public, promoted competitiveness and drove economic growth. The PCT had great advantages for the general public and patent applicants, in particular giving applicants another 18 months to decide on whether to apply for foreign patent protection compared to route provided by the Paris Convention. The work of International Authorities was essential to the PCT System. Thanks to international search and preliminary examination, the need for national searching at an IP Office was reduced. With the increasing value of intangible assets in the economy, it was important to focus on making improvements to the benefits available to patent applicants using the PCT. Examples in this regard were the continual improvement of the quality framework through work in the Quality Subgroup, the increase use of electronic services, and collaborative and harmonization activities, such as the work with the European Patent Office on harmonization of search reports.

9. Prof. Sakr continued by expressing gratitude and pride in the achievements of the Egyptian Patent Office as the first IP Office using the Arabic language to be appointed as an International Searching and Preliminary Examining Authority, with clear recognition from the PCT Assembly of the Egyptian Patent Office's competence to undertake such a task. The Egyptian Patent Office was concerned about building an intellectual property system in which people could demonstrate their creativity fully in a wide variety of fields, including science and technology, with results that would lead to maintaining and advancing industrial competitiveness and improving people's lives and which would help the Egyptian Patent Office be an effective player in the international community. Having joined the PCT in 2003, the Egyptian Patent Office had been a reference to other IP Offices, especially those using the Arabic language. In this regard, cooperation between the Egyptian Patent Office and other IP Offices had been essential to the exchange of information and harmonization of best practices, with one example being the annual workshop on patent search and examination for both African and Arab countries, funded by WIPO. The ASRT attached great importance to developing cooperation with Africa and supporting the efforts of countries of the continent in building capacities in the

field of intellectual property, especially patents. In concluding, Prof. Sakr congratulated Dr. Mona Yahia, Acting President of the Egyptian Patent Office, for her work, and paid tribute to the leadership of Mr. Adel El-saaed Oweida as President of the Egyptian Patent Office. Prof. Sakr wished the meeting every success to benefit from the potential and opportunities to achieve an optimal and effective international patent system.

10. Mr. Thomas Marlow (WIPO) acted as Secretary to the Meeting.

ITEM 2: ELECTION OF A CHAIR

11. The session was chaired by Dr. Mona Yahia, Acting President, Egyptian Patent Office.

ITEM 3: ADOPTION OF THE AGENDA

12. The Meeting adopted the agenda as set out in document PCT/MIA/26/1 Prov. 3.

ITEM 4: PCT STATISTICS

13. The Meeting noted the presentation by the International Bureau on the most recent PCT statistics¹.

14. One Authority pointed out that factors such as time delays in transmitting information, and recording errors could cause some discrepancies between the statistics held by the International Bureau and the records of a particular International Authority. Therefore, efforts should be taken to have them checked and adjusted for greater consistency.

ITEM 5: MATTERS ARISING FROM THE QUALITY SUBGROUP

15. The Meeting noted with approval the Summary by the Chair of the Quality Subgroup set out in Annex II to this document, agreed with the recommendations contained in that Summary and approved the continuation of the Subgroup's mandate, including the convening of a physical meeting in 2020.

ITEM 6: PCT ONLINE SERVICES

16. Discussions were based on document PCT/MIA/26/9.

17. In introducing the document, the International Bureau highlighted the importance of Offices working towards a common IT strategy. The International Bureau sought to decommission PCT-SAFE in favor of ePCT, which offered better validations and was always up to date. Nevertheless, the importance of the role played by PCT-SAFE as a "reference implementation" needed to be recognized. While national Offices would continue to develop their own services, it was essential to ensure that data produced by such systems that might be exchanged with other Offices was created according to consistent standards. Authorities emphasized the importance of sharing detailed plans as far as possible in advance in order to assist the alignment of services at national Offices, particularly with respect to bibliographic data in the request form, conversion of application bodies from formats such as DOCX, and XML for search and examination reports.

18. Several Authorities noted that they found benefits in the use of collaborative systems, including WIPO DAS and WIPO CASE as well as ePCT and eSearchCopy, and encouraged other Authorities to use these systems. Common tools and services such as IPAS could also be useful and should be further developed to assist in meeting data exchange needs, including with regard to national phase information.

¹ A copy of the presentation is available on the WIPO website at https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=429001

19. The European Patent Office recalled its aim that all of the receiving Offices for which it was competent as an International Searching Authority should be sending search copies via eSearchCopy by the end of 2020. Authorities thanked the International Bureau for the increasing user friendliness of its products, but emphasized the need to continue technical improvements, including ensuring the highest quality bibliographic data availability, such as in the context of eSearchCopy.

20. Authorities agreed with the need to improve the systems and standards for production of XML search reports and written opinions and to ensure that it was possible to reuse XML between different stages of search and examination as referred to in paragraph 21 of the document, but emphasized that this applied across the systems used at all stages by all Offices and should not be limited to the reports generated within ePCT. Several Authorities noted that they were now either generating or preparing to generate search reports using XML tools.

21. Authorities noted the need to develop processes for the filing of applications using DOCX format and the processing of color drawings. Authorities were also interested in allowing ePCT to transmit the official version of documents to the applicant where so requested, removing the need for Authorities to send paper copies of documents.

22. One Authority noted its effective introduction of ePCT web services in the Office's role as designated Office.

23. The Meeting noted the developments in PCT online services and agreed with the priorities set out in the document, taking into account the above comments.

ITEM 7: SAFEGUARDS IN CASE OF OUTAGES AFFECTING OFFICES

24. Discussions were based on document PCT/MIA/26/5.

25. The European Patent Office highlighted the context of the proposal, where online filing was used for the large majority of applications and both applicants and Offices were increasingly dependent on online systems. Alternatives in general either did not have an equivalent effect, as in the case of mailing an application, or else were becoming increasingly difficult to use or even being withdrawn, such as fax services. Some receiving Offices applied national law safeguards and practices, but there was a need for consistency and transparency. By being optional ("may"), the proposal did not offer complete harmonization, but provided a step in that direction. In particular, it was important to find an arrangement that avoided the applicant needing to provide evidence on a case-by-case basis when the cause of the problem lay with the Office. It was also important that the fact of the outage having occurred was the subject of a public record for the sake of transparency and predictability in particular, as this would ensure that designated Offices were aware of the circumstances in which delays in meeting PCT time limits were excused. The European Patent Office further indicated that, following informal comments, it had recognized that there may be difficulties with applying the proposal to the priority period and that it could accept moving forward without the proposed amendment of Rule 2.4(b) as long the necessary clarifications would otherwise appear in the PCT Guidelines.

26. Authorities agreed the importance of the issue and that it was desirable to ensure that suitable safeguards existed to mitigate the effect of outages. It was observed that filing deadlines usually expired at midnight local time, at which time Offices typically had little or no support available to resolve technical problems that had arisen. Some Authorities supported the proposal, though others had concerns over the details.

27. Several Authorities indicated that they considered that they believed that the proposal as presented in the document would indeed not work for designated Offices with national laws applying a strict interpretation of the Paris Convention. One Authority also noted that the

provisions could not apply to domestic priority claims, the effect of which the Treaty left to national law. Some Authorities were concerned that any situation where there was doubt, first as to whether the Office would declare an outage and second as to the practical effect for the national phase, could mislead applicants into trying to rely on safeguards to their detriment. A further issue was whether provisions were of any value if national courts might not recognize delays that had been excused by Offices.

28. Several Authorities were concerned by the optional nature of the provision, leaving uncertainty and a lack of harmonization in arrangements.

29. Some Authorities indicated a need for greater clarity that any excuse for delay should require the relevant action to be taken at the latest by the next working day after the outage. Some Authorities were concerned that an outage in one system for performing an action should not automatically excuse a delay in meeting a time limit if other options were available. In this case, a system based on the applicant presenting the specific facts of the case might be more appropriate. However, it was observed that even if other electronic options had been available, it might not be practical for an applicant to use them if specific preparations were necessary, such as obtaining certificates or smartcards. Several Authorities considered that scheduled outages of services notified in advance should not be covered by a safeguard arrangement, though other Authorities suggested that any form of outage caused an effective change of deadlines that applicants should not be penalized for. It was observed that the extent to which an Office was open for business if documents and fees could not be submitted, even though many of its staff might be working, was one with implications extending beyond the scope of this specific proposal.

30. One Authority suggested that the nature of the proposed safeguard and position in the Rules were not appropriate. Previous suggestions, offering extensions of time limits in a manner equivalent to Rule 80.5, might be more appropriate than excusing the missing of the deadline.

31. It was observed that this type of safeguard provision was important, but was not a full solution and that Offices should give due attention to ensuring very high availability of online services and clear, practical alternatives for use when they do fail.

32. The Meeting noted the intention of the European Patent Office to bring a further amended proposal on this subject to the PCT Working Group.

ITEM 8: PROPOSAL TO PROVIDE FOR CORRECTION OR ADDITION OF INDICATIONS UNDER RULE 4.11

33. Discussions were based on document PCT/MIA/26/7.

34. Authorities agreed that it was appropriate to permit correction or addition of indications under Rule 4.11, and considered that the similarity of the proposed Rule *26quater* to that of existing Rule *26ter* gave confidence that the details were appropriate and could be effectively administered.

35. The Meeting invited the United States Patent and Trademark Office to present the proposals to the PCT Working Group.

ITEM 9: PROMOTING LINKAGE BETWEEN THE INTERNATIONAL PHASE AND THE NATIONAL PHASE

36. Discussions were based on document PCT/MIA/26/6.

37. All Authorities supported the proposed modification of paragraph 2.03 of the International Search and Preliminary Examination Guidelines. This would not change the meaning of the paragraph, but would bring greater consistency of terminology. Authorities agreed with the intentions expressed in the proposed modification of paragraph 15.09, but some Authorities did not consider it appropriate to include the text in the Guidelines because it did not introduce a clear and concrete recommendation it referred merely to a desire. Furthermore, paragraphs 15.18 and 15.20 of the Guidelines referred already to concrete measures addressing the desire in the proposed paragraph. One Authority highlighted that the Guidelines in general should comprise only concrete and achievable measures.

38. Several Authorities encouraged the Japan Patent Office to continue consultations with a view to deciding which of the further ideas outlined in the Annex to the document were appropriate to develop into specific proposals. Items (d-1) (continuous development of patent family information), (d-4) (feedback from designated Offices), (e-4) (automatic access to documents cited against other patent family members) and (e-5) (tools for finding prior art from similar applications from the same applicant) were mentioned as items of particular interest.

39. The Meeting invited the International Bureau to include the proposed modifications to the International Search and Preliminary Examination Guidelines in the next appropriate PCT Circular for further consultation.

ITEM 10: PROPOSAL TO PROMOTE THE IMPROVEMENT OF THE INTERNATIONAL SEARCH REPORT AND WRITTEN OPINION

40. Discussions were based on document PCT/MIA/26/11.

41. Authorities welcomed the principle of a survey with a view to improving the form, content and format of the international search report and the written opinion of the International Searching Authority and sought further information on how the envisaged questionnaires would be developed and administered.

42. One Authority suggested that it would be appropriate for the International Bureau to administer any survey agreed. Another Authority considered that any surveys of examiners should be administered only by their own Offices and that responses to the main survey, taking examiner views into account, should rather be delivered only by the Offices themselves. User groups should also be addressed.

43. Questions for the survey might include issues of how Offices currently used other Offices' reports and the formats in which Offices would prefer to access the content of such reports. The results were likely to favor delivery of material in XML format.

44. It was observed that any change to the form and content of reports would affect multiple systems and have significant costs – these would need to be weighed against the expected benefits. Implications in national proceedings should also be considered.

45. The China National Intellectual Property Administration emphasized that the objective of the first stage of work was to prepare the questionnaires – the need for and value of any substantive work would be judged by the results. The provisional idea was to design several different questionnaires suitable for different target audiences. The process of preparing the questionnaire would also consider the most effective way to conduct the survey.

46. The Meeting invited the China National Intellectual Property Administration to post more detailed proposals on the Quality Subgroup's electronic forum as the basis for further discussions of the proposal.

ITEM 11: APPOINTMENT AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY (ISA/IPEA) AND DECLARATION BY RECEIVING OFFICES AS COMPETENT ISA/IPEA

47. Discussions were based on document PCT/MIA/26/12.

48. The Indian Patent Office indicated that the proposal in the document was aimed at making the PCT services more accessible and useful to the applicants. Under the existing practice, the requirements and the procedure for appointment as International Authority were common for all offices seeking appointment. Furthermore, each receiving Office (RO) specified the International Searching and Preliminary Examining Authorities competent for the search and examination of international applications filed with such Office. This was applicable to the international applications filed with the International Bureau as RO by its nationals/residents. Thus, the applicant could choose only those ISAs and IPEAs that were declared competent by the receiving Offices of the country of the applicant's nationality/residence.

49. The Indian Patent Office continued by stating that, under the existing mechanism, any applicant from any of the Member States could not utilize the services offered by all of the International Authorities offering the services. In case of multiple applicants from different countries, the applicants had more choice since selection of an ISA/IPEA was possible if at least one of the applicants was eligible to choose the office as ISA/IPEA. Thus, the choices were not uniformly available to all the applicants. To make the PCT system more efficient and accessible, the Office proposed that all applicants should have equal opportunities to make use of the system. Such choice should not be restricted due to lack of bilateral arrangements. By simplifying the procedure and making available more choices to the applicant, the PCT system would better enable the ease of doing business by PCT applicants. This would encourage more applicants to use the PCT System.

50. The Indian Patent Office therefore proposed that all Authorities should consider changes in the existing mechanism so that the International Authorities may act for all the States. The step of declaration as competent ISA/IPEA by the receiving Offices of each of the Member States of the PCT could be ultimately done away with so that the applicants who are nationals/residents of any of the Member States of the PCT could choose any of the International Authorities as ISA for their international applications. As far as choice of IPEA is concerned, this choice could be based on which Authority was chosen as ISA for the application, if such condition applied for the IPEA.

51. The Indian Patent Office concluded by stating that this proposal could be implemented without any changes to the Treaty and Regulations, if all receiving Offices declared all International Searching and Preliminary Examining Authorities as competent. Certain technical hurdles that were foreseen in implementing this proposal included the arrangements by receiving Offices for the transmittal of search fees and search copies to the ISAs. Until such arrangements were in place, either directly between Offices or through the International Bureau, the Indian Patent Office proposed that, to start with, the applicants filing international applications through the International Bureau as receiving Office (RO/IB) might be allowed the choice of any of the International Authorities as ISA/IPEA. Once the Authorities agreed in principle to the proposal, such detailed modalities could be worked out.

52. Authorities indicated that they had not had sufficient time to prepare formal responses to the proposals set out in the document. Some preliminary considerations were that there would be technical and legal difficulties involved in allowing a totally free choice of International Searching Authority, including effective delivery of search copies between Office pairs where

eSearchCopy was not available, the need for translations, and the need to change national laws or the provisions of certain other international agreements. It was observed that many applicants could already arrange some of the benefits proposed by virtue of the choices gained from co-applicants with different nationality or residence.

53. The Meeting invited the International Bureau to open an area on the Quality Subgroup's electronic forum for discussion of the issues arising from the proposals in the document.

ITEM 12: PILOT ON NETTING OF PCT FEES

54. Discussions were based on document PCT/MIA/26/3.

55. All Authorities that took the floor supported the netting pilot. Several of these Authorities updated the Meeting on their participation in the netting pilot in their capacity as receiving Offices. From this perspective, the pilot had been working well, although one Authority indicated that it sometimes had difficulties in meeting the monthly payment date for transfer to fees to the International Bureau following receipt of the invoice. Some other Authorities indicated their intention to join the pilot in their capacity as a receiving Office in the near future.

56. The European Patent Office updated the Meeting on its netting pilot as an International Searching Authority. Thirty receiving Offices that had specified the European Patent Office as a competent International Searching Authority had now joined the pilot, and it hoped all such receiving Offices would be in the pilot by the end of 2020. The European Patent Office also indicated its desire for the netting pilot to be linked to the eSearchCopy service. The European Patent Office was supportive of having a proper legal basis in the PCT Regulations for the netting of PCT fees.

57. The Japan Patent Office highlighted the benefits of its participation as an International Searching Authority. While its pilot only involved three receiving Offices, the consolidation of payments into a single transaction improved efficiency and it looked forward to more of its receiving Offices joining.

58. Some Authorities, while supporting the pilot and its development, stated reasons for not participating at this stage in their capacity as an International Searching Authority. For one Authority, there were difficulties in converting its national currency into United States dollars and vice versa, and it needed to make changes to its filing procedures before participation. Another Authority did not consider itself a suitable candidate for the pilot due to the small number of search fees it currently passed on and the lack of large transfer fees to that Authority, but it was willing to join if the pilot were to become a more permanent arrangement. A third Authority looked forward to more of its competent receiving Offices joining the pilot with the European Patent Office before taking a decision on this matter.

59. One Authority, which participated in the pilot in its capacity as a receiving Office, expressed willingness for the pilot to be extended to fees related to the Madrid and the Hague Systems. Another Authority hoped to join the pilot in its capacity as an International Searching Authority, but would have difficulties with the requirements in paragraph 29 of the document for an Office to pay and receive fees related to one WIPO-administered IP system to and from the account of another system.

60. One Authority indicated that any amendments to the PCT Regulations should allow receiving Offices and International Searching Authorities the option of whether to participate, noting that financial regulations in some countries might make it difficult for certain Offices to be involved in netting.

61. In response to a question by one Authority, the International Bureau confirmed its intention to table a proposal to amend the PCT Regulations and Administrative Instructions to cover the netting of PCT fees at the twelfth session of the PCT Working Group, scheduled to take place in June 2019.

62. The Meeting noted the contents of document PCT/MIA/26/3.

ITEM 13: USE OF NATIONAL CLASSIFICATION SYMBOLS IN INTERNATIONAL APPLICATIONS

63. Discussions were based on document PCT/MIA/26/10.

64. Authorities noted the importance of classifications such as the Cooperative Patent Classification (CPC), particularly in fast-developing fields of technology. Several Authorities indicated that they intended eventually to provide CPC symbols for international applications, but at present were still awaiting training and experience. One Authority suggested that the CPC would need to be translated into at least the 10 PCT languages of publication in order to gain proper acceptance and use.

65. The preferred option was to provide symbols as part of an international search report in XML. One Authority noted that an XML structure had already been defined for the exchange of CPC symbols and that it would be desirable to use this in order to avoid complication of systems or loss of information due to transformation to a different structure. C-sets were considered important and transmission should retain the set information.

66. One Authority currently unable to generate XML search reports noted that it transmitted IPC information in batches covering multiple international applications and consequently a text format offering the same possibility would be desirable.

67. In response to a query, the International Bureau indicated that the agreement had been that Authorities supplying CPC symbols should ensure that they are validated before transmission. It was likely that the International Bureau would nevertheless validate symbols on import, though it had not yet been considered what action would be taken with respect to symbols that were not valid according to the indicated CPC version.

68. The Meeting invited the International Bureau to take the above points into account when preparing the forthcoming consultation on the transmission of national classification symbols in relation to international applications.

ITEM 14: PCT COLLABORATIVE SEARCH AND EXAMINATION THIRD PILOT

69. Discussions were based on document PCT/MIA/26/4.

70. The European Patent Office reported that after two years of preparations, the collaborative search and examination pilot had launched successfully in July 2018. There were a number of operational complexities because of the differences from standard processing which required special arrangements outside of the normal local IT systems, but this had been expected and the pilot had proceeded well.

71. There had been considerable interest in this applicant-driven process. The United States Patent and Trademark Office had already reached the limit of 50 applications accepted into the pilot for the first year. The European Patent Office and China National Intellectual Property Administration had reached their quotas for English language applications. The European Patent Office had begun to accept applications filed in French and German into the pilot from January 1, 2019. The China National Intellectual Property Administration would begin to accept Chinese language applications from March 1, 2019. The Japan Patent Office and Korean Intellectual Property Office expected to begin accepting applications in their national languages

soon. The participating Authorities saw considerable potential benefits in quality and time-saving for national phase processes, but there were challenges with regard to the processes and the likely costs.

72. In response to a query from an Authority, the International Bureau clarified that this pilot had been developed specifically as a project between the IP5 Offices, which would not be extended to include other International Authorities. It would be open to other Authorities to conduct similar pilots if they so wished and the software developed by the International Bureau was sufficiently flexible that it would probably be possible to support such an arrangement. However, the matters to be agreed and implemented by participating Offices were sufficiently complex that this would be a time-consuming task, which should not be taken lightly.

73. The Meeting noted the status report in document PCT/MIA/26/4.

ITEM 15: PCT MINIMUM DOCUMENTATION TASK FORCE

74. Discussions were based on document PCT/MIA/26/8.

75. The European Patent Office highlighted the progress that had been made by the task force via several rounds of discussion in the task force electronic forum, and encouraged Offices to participate actively in such discussions. On Objective A, the inventories of the existing minimum documentation had been completed and updating of the formal documentation could begin soon. On Objective B, much progress had been made on the objectives to be pursued with regard to the criteria and standards for including a patent collection in the PCT minimum documentation. In particular, there appeared to be great support for extending the possibility of inclusion to collections in any language, provided that suitable technical criteria were met. It would now be necessary to follow up certain details and prepare specific language to embody the principles. There was considerable interest in extending the same concepts to utility models as well as patents, though larger concerns remained. There had also been much progress on Objective C, concerning the bibliographic details and text components of patent data that needed to be provided for collections forming part of the minimum documentation. The Office suggested that the outstanding details were complex and that finalizing them through the electronic forum may be slow and difficult. It might therefore be desirable to hold a physical meeting of the task force where the experts could meet face to face. Two days would likely be needed.

76. The United States Patent and Trademark Office indicated that responses had been received from 15 International Authorities to Circular C. PCT 1544, following up on questions relating to Objective D, concerning the use of non-patent literature and traditional knowledge-based prior art sources. A full analysis would be provided on the task force wiki and to the PCT Working Group to form the basis of further discussions. An initial review suggested that some of the main concerns related to the fact that the best sources of non-patent literature were constantly changing and difficult to document. Many searches used sources outside the minimum documentation. Accessibility to non-patent literature was sometimes difficult and there were concerns over confidentiality restrictions that might limit the ability of examiners, applicants and third parties to properly evaluate prior art references.

77. Authorities welcomed the progress that had been made in all areas. Effective use of disclosures in a wide variety of languages was important. Several Authorities indicated that they could consider the idea of amending Rule 36 to make delivery of national patent information an obligation of an International Searching Authority. One Authority noted that it was not clear to what extent the proposals addressed patent collections of PCT Contracting States that were neither part of the existing minimum documentation nor those of International Searching Authorities.

78. The details of what information Offices should be expected to provide would need to be considered. One Authority noted that full text versions of its patent document collection had been prepared going back as far as 1940 and that work was under way of preparing the information for earlier years.

79. Several Authorities expressed a strong interest in the extension of the minimum documentation to include utility models on a basis equivalent to patent documents. Even though utility models were not as closely harmonized as patent documents, they represented a significant source of prior art disclosures. However, the volume of documents was very large and the availability of English language abstracts was much lower. A variety of technical and cost-benefit issues would need to be addressed, with regard both to the inclusion of document sets into databases and the effects on examiner time of searching the additional material. Some similar issues would also affect patent specifications, where large parts of many collections would be essentially duplicates of disclosures already part of the minimum documentation.

80. Some Authorities noted the cultural significance of traditional knowledge digital libraries and the issues of ownership and secrecy of the knowledge and highlighted the importance of finding an effective solution that addressed the need to ensure availability of information necessary for proper determination of novelty and inventive step.

81. One Authority noted that there was already significant variation in International Authorities' ability to provide copies of non-patent literature. Some sent the applicant full texts; others only a summary or a reference. This Authority noted that International Authorities had, under Objective D, indicated the need to provide prior art references to the applicant, to third parties and to the general public. However, this Authority stated that, for items already included in the minimum documentation there were already differences in availability due to differences in access to the documents by International Searching Authorities as well as their rights to provide copies depending on their agreements with the publishers. International Searching Authorities therefore did not all have the same level of access to the non-patent literature part of the minimum documentation. Effective access to copies of prior art documents was also a matter of concern for non-patent literature more broadly, covering both the right to access collections and the cost of doing so. This Authority suggested that standardized agreements should be sought to allow all Authorities the same level of access to the non-patent literature part of the minimum documentation with prices proportionate to the size of the Offices. One Authority cautioned that further evaluation of some points may be required since it had not been in a position to provide full feedback according to the timetables.

82. The International Bureau observed that 11 International Authorities had submitted Authority files according to WIPO Standard ST.37 within the period requested as part of the work of the relevant task force of the Committee on WIPO Standards and a number of others had indicated that they expected to be in a position to deliver files shortly. The International Bureau invited International Authorities to discuss any problems that they had encountered with the relevant experts, with a view to finding appropriate solutions.

83. The Meeting noted the status report in document PCT/MIA/26/8 and agreed that the possibility of convening a physical meeting of the task force should be considered through the task force's electronic forum.

ITEM 16: PCT SEQUENCE LISTING STANDARD

84. Discussions were based on document PCT/MIA/26/2.

85. The European Patent Office introduced the document by thanking the International Bureau for its work in developing the ST.26 authoring and validation software tool. The European Patent Office encouraged other Offices to participate in the testing of the tool and

highlighted the importance of involvement in the work to be undertaken by the task force as a whole in the lead up to the transition date to ST. 26 on January 1, 2022.

86. One Authority highlighted the outstanding issues in paragraph 9 of the document. This Authority pointed out that free text qualifiers in ST.26 were limited to printable characters from the Unicode Basic Latin code table. This precluded the use of languages using non-Latin characters, as well as accented characters used in other commonly-used PCT filing languages. One Authority emphasized its constitutional requirements to provide equal treatment of its national languages, and expressed a desire for the software tool to allow applicants to proceed without a requirement to file an English translation.

87. The International Bureau, in response to a query on the amendments that would be required to the PCT Regulations and Administrative Instructions, clarified that it would be preparing a document for the twelfth session of the PCT Working Group, scheduled to take place in June 2019. The PCT Assembly would need to adopt any changes to the PCT Regulations at the latest at its session in 2020 for implementation in time for the transition from ST.25 to ST.26 on January 1, 2022. The International Bureau also encouraged experts at International Authorities to test the authoring and validation software and provide feedback. As for free text, the International Bureau pointed out that the character limitation had been adopted in ST.26 in order for sequence listings in patent applications to be in the same format as used by commercial database providers, and encouraged Authorities to look into technical solutions that would ensure this requirement was met.

88. The Meeting noted the contents of document PCT/MIA/26/2.

ITEM 17: FUTURE WORK

89. The Egyptian Patent Office indicated that it might make a proposal to revise the options available in Form PCT/ISA/203, which might require an amendment to PCT Rule 39.

90. The Meeting noted that the next session was expected to be convened in the first quarter of 2020, immediately following a meeting of the Quality Subgroup.

[Annex I to document PCT/MIA/26/13, containing a list of participants is not reproduced here]

[Annex II (to document
PCT/MIA/26/13 follows)]

ANNEX II (to document PCT/MIA/25/13)

PCT/MIA QUALITY SUBGROUP, NINTH INFORMAL MEETING
CAIRO, FEBRUARY 11 AND 12, 2019

SUMMARY BY THE CHAIR

INTRODUCTION

1. Prof. Mahmoud M Sakr, President of the Academy of Scientific Research and Technology (ASRT), welcomed the participants to the session and expressed pleasure that Egypt was hosting the Quality Subgroup for the first time. Prof. Sakr emphasized that the intellectual property (IP) sector had become a key element in supporting the developmental plans in any given country and was a driving force in the efforts of building a competitive and diversified economy based on innovation and knowledge. Prof. Sakr thanked WIPO for its continuous support and cooperation to lead the development of a balanced and effective international IP system that enabled innovation and creativity for the benefit of all. Quality was an essential aspect of the patent system to ensure it served the purpose of promoting innovation, contributing to the dissemination and transfer of technology and fostering technological, social and economic development of the country concerned. Errors in patent grant and administration procedures could cause legal uncertainty and increase costs for all users of the patent system: rights holders, competitors, patent information users and patent Offices. The Quality Subgroup provided the opportunity to exchange ideas and have fruitful discussions on quality management systems for different International Authorities to gain a better understanding of the work of other Offices, especially in respect of search strategies and standardized clauses. Delegates could also share opinions about ideas for quality improvement to achieve an optimal and effective international IP system that met the needs of users, which was of capital importance towards economic development. Egypt had paid due attention to the IP sector and the Egyptian Patent Office was keen to develop and modernize its infrastructure, build smart information systems and promote awareness in the community of IP, thus contributing to realizing a qualitative leap in Egyptian society through incubation of technology and providing an environment that encouraged the building of the capacities of young people, and the promotion of innovation and creativity. The Egyptian Patent Office was committed to offering high quality procedures and practices and recognized the importance of a quality management system to ensure that all patent processing steps could be completed in a timely and high quality manner. Prof. Sakr concluded by wishing that the ideas and experiences from the quality experts representing the International Authorities could add to the success of the meeting and reach positive outcomes from the event for Authorities to gain the utmost benefit.

2. Dr. Mona Yahia, Acting President, Egyptian Patent Office, chaired the session.

1. QUALITY MANAGEMENT SYSTEMS

(A) REPORTS ON QUALITY MANAGEMENT SYSTEMS UNDER CHAPTER 21 OF THE PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

(B) QUALITY MANAGEMENT SYSTEMS AT INTERNATIONAL AUTHORITIES

3. Authorities agreed that the system of reporting on the quality management systems (QMS) was useful, and appreciated the summary provided by the International Bureau. In addition to the reports of the quality management systems of other Authorities, the Subgroup found the presentations by the China National Intellectual Property Administration (CNIPA), the European Patent Office (EPO), the Japan Patent Office (JPO) and the National Institute of

Industrial Property of Chile (INAPI)² to be useful to gain a better understanding of practices in quality management.

4. In response to a question on its presentation, the EPO confirmed that requests for accelerated examination through the program for accelerated prosecution of applications (PACE) and the Patent Prosecution Highway (PPH) were offered without an additional fee for the applicant. Since the EPO had introduced a six month target for delivering search reports in its “Early Certainty from Search” initiative in 2014, the number of PACE requests for search had dropped to virtually zero; for examination, PACE requests had been made on approximately 5 to 6 per cent of cases.

5. The presentation from the JPO included a proposal for further enhancing the QMS of International Authorities. The increasing number of Authorities made it difficult for International Authorities to review the all the QMS reports, and Authorities were not always able to reflect opinions of users in the discussions by the Subgroup. The JPO therefore suggested that the Quality Subgroup could have more thorough discussions on how to enhance the QMS of International Authorities and means for sharing information, and on how to improve ways to reflect user opinions in these discussions, yet respecting initiatives being implemented by International Authorities for improving QMS, and considering resources available at each International Authority. For example, the Quality Subgroup could select to review the QMS of a single Authority and listen to opinions of selected users of that Authority and share the results. The Quality Subgroup could then hold a question and answer session based on these user opinions and the QMS report of that Authority.

6. The Subgroup recommended:

- (a) to continue reporting on existing QMS using the present reporting mechanism, indicating changes from the previous report and including these changes in a summary along with other matters of likely interest as part of the introduction to the report; and
- (b) that other Authorities should present overviews of their QMS to future meetings of the Subgroup.

(C) PROCESS CHARTS IN QUALITY MANAGEMENT SYSTEMS

7. Authorities appreciated the process charts that had been posted on the Subgroup’s electronic forum, which had been useful information to understand quality management at other Offices, share examples of best practices and provide a means for continuous improvement. The Intellectual Property Office of the Philippines stated that the charts had been helpful in setting up procedures as it prepared to begin operations as an International Searching and Preliminary Examining Authority. Some Authorities indicated that they intended to share process charts in the future but were not ready to do at this stage; one Authority, however, indicated that charts of its processes were intended only for internal use. Furthermore, under both Chapter 21 and ISO 9001, the use of process charts is optional.

8. One Authority proposed that the page for processing charts on the Subgroup’s electronic forum could be given more prominence to improve visibility of the charts, make them easier to access and facilitate uploading by Authorities.

² https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=429049,
https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=429051, and
https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=429351

9. The Subgroup recommended that:
- (a) Authorities may share further examples of process charts used in international search and preliminary examination, whether on the Subgroup's electronic forum or in their reports on their quality management systems; and
 - (b) the International Bureau should give more prominence to the page on the Subgroup's electronic forum containing the process charts.

(D) MODIFICATIONS TO CHAPTER 21 OF THE PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

(i) Incorporation of Risk-Based Thinking Principles

10. Authorities supported the principle of incorporating text related to identifying risks and opportunities in their work as International Searching and Preliminary Examining Authorities. Some of the Authorities indicated that they would be willing to accept the modifications set out in the paper, as proposed by the Spanish Patent and Trademark Office.
11. One Authority emphasized that Chapter 21 and ISO 9001 were distinct standards. Authorities should be free to adopt their own methodologies to achieve the results of Chapter 21, without any requirement to adopt the practices or attain certification under ISO 9001. This Authority pointed out that the term "risk-based thinking" was considered as a key element of ISO 9001:2015 and proposed that the drafting of guidance in Chapter 21 on considering of risks and opportunities by Authorities should more clearly show the distinction between ISO 9001 and Chapter 21.
12. Another Authority recognized that Chapter 21 and ISO 9001 were different, but considered that the latter could provide a useful basis to improve the definition of terms on risk in the proposed modifications. This Authority stated that the definitions of risk-based thinking and risks and opportunities from ISO 9001 could help to this effect.
13. In response to the comments by these two Authorities, it was recognized that ISO 9001 could help clarify the meaning of terms in Chapter 21. However, it was important to maintain the distinctiveness of the two standards, which could be lost in the case of exact alignment of terminology. With this in mind, the Subgroup discussed an amended version of the proposed text with more generic definitions of risks and opportunities.
14. In paragraph 21.11 of the amended text, the term "risk-based practices" had replaced "risk-based thinking". With reference to this paragraph, risk was to be understood as the effect of uncertainty due to factors that could cause an Authority's operational processes and quality management system to deviate from requirements or planned results. Such deviation could have negative effects, which could for instance be minimized by putting into place preventive controls, or bring positive developments in terms of new opportunities.
15. In response to a question from one Authority, the Spanish Patent and Trademark Office clarified that the term "risk-based practices" had been used because "risk-based thinking" was closely linked to ISO 9001. It was important that Chapter 21 allowed Authorities to determine how to incorporate practices on risk into their QMS, which did not necessarily require following risk-based procedures that complied with ISO 9001.
16. The Subgroup recommended that the International Bureau should consult through a PCT Circular on the following modifications to Chapter 21 to incorporate risk-based practices into the International Search and Preliminary Examination Guidelines, noting the understanding of term "risk-based practices" and the general scope of risk in paragraph 14, above:

“21.03 Each Authority shall establish and maintain a quality management system (QMS) which complies with the following requirements with regard to:

1. Leadership and policy
2. Risk-based practices
- ~~3.~~ Resources
- ~~4.~~ Management of administrative workload
- ~~5.~~ Quality assurance
- ~~6.~~ Communication
- ~~7.~~ Documentation
- ~~8.~~ Search process documentation

Additional Provisions:

- ~~9.~~ Internal review
- ~~10.~~ Reporting arrangements

21.10 Top Management should promote practices to ensure that risks and opportunities that can affect its QMS and the conformity of international search and examination are addressed.

2. Risk-based practices

21.11 Each Authority should establish its own risk-based practices to enable the Authority to determine the factors that could cause its operational processes and its quality management system to deviate from requirements or planned results, to put in place preventive controls to minimize negative effects, and to make use of opportunities as they arise.

21.12 It is open to each Authority to set up its own arrangements to determine the effect of uncertainty on objectives, but the following is proposed as a guide to the basic components of risk based practices as an element of the QMS. There is no requirement for formal methods of risk management or a documented risk management process.

21.13 The arrangements for establishing risk based practices should include:

(i) understanding the Authority’s context (external and internal issues that affect its ability to achieve the intended results of the QMS) and understanding the needs and expectations of interested parties.

(ii) identification of risks and opportunities related to the performance of the QMS, as a basis for planning;

(iii) planning and implementation of actions to address risks and opportunities;

(iv) checking the effectiveness of the actions taken; and

(v) continuously updating risks and opportunities.

21.14 All processes of the QMS present differing levels of risk in terms of the Authority’s ability to meet its objectives, and the effects of uncertainty are not the same for all authorities. Each Authority is responsible for the actions it decides to take to address risks and opportunities.”

(ii) Further Modifications to Chapter 21

17. Authorities expressed different views in terms of support for the proposed modifications to paragraph 21.10 of the Guidelines to make it mandatory for each Authority to have an appropriate infrastructure to support the search and examination process.

18. One Authority affirmed its support for mandatory inclusion of all the elements in paragraph 21.21 in the internal documentation of search processes. Some other Authorities, while supporting a requirement to document its search process internally, wished to maintain flexibility on the elements that an Authority should include in this documentation. One of these Authorities considered that the listing of all search statements in the documentation may be over burdensome on an examiner, and that it may not always be realistic to identify and give full justification for limitation of search. Furthermore, given the development of intelligent automatic search tools, it might not always be possible to maintain the items listed in paragraph 21.21. Nevertheless, this Authority believed that every Authority should maintain appropriate documentation of search processes. Authorities also underlined that internal documentation of search should be discussed separately from the sharing of search strategies. On this point, the International Bureau clarified that Chapter 21 covered what was required to support Authorities' internal quality processes. Different provisions, such as Rule 43.6 and paragraph 15.62, dealt with what should be made available to others together with the international search report.

19. One Authority agreed with the proposed modifications to paragraphs 21.23 and 21.24 in terms of mandatory input for internal review of the QMS of an Authority. On this point and more generally, other Authorities raised the concern that development of Chapter 21 should not necessarily focus on making further recommendations within the Guidelines mandatory, but on what Authorities need to do to improve their quality processes, leaving flexibility on how to achieve that.

(E) REPORTING ON COMPLIANCE WITH THE MINIMUM REQUIREMENTS UNDER RULES 36 AND 63

20. The International Bureau recalled that, following discussions at the eighth session of the Subgroup, the PCT Assembly had adopted an application form for use by Offices seeking appointment as an International Authority. The summary of the session (see paragraphs 68 and 69 of Annex II to document PCT/MIA/25/13) noted that "[t]he issue of the extent to which it should apply to extensions of appointment could be considered at a later date. Authorities were open to considering the possibility of extending the scope of quality reports to cover ongoing compliance with the minimum requirements, noting concerns that this should not result in a separate, new and burdensome reporting requirement." The issues were complex and the International Bureau was not able to offer specific proposals on how compliance might be efficiently reported, but it was desirable to provide reassurance that Authorities continued to comply with the minimum requirements for appointment on an ongoing basis; applications for extension of appointment could then simply refer to the appropriate reports.

21. International Authorities were only able to give very provisional feedback on this issue, but there remained some interest in the possibility of extending quality reporting to include reporting details of compliance. However, it was important to distinguish clearly between ensuring compliance with requirements and reporting on the details of compliance. Any reporting should not necessarily be part of the existing quality management system reports, which did not contain reporting on other details of compliance. One Authority noted that it already provided much of the relevant information in existing publications. It was also noted that many of the complexities concerning the state of the PCT minimum documentation had been resolved by the work of the relevant task force and that others would also be addressed if the recommendations of the task force were adopted. It was also suggested that external auditors might be an appropriate approach to confirming compliance with requirements, in alignment with ISO 9001 approaches.

22. The Subgroup agreed to continue consideration of how continued compliance with the minimum requirements under Rules 36 and 63 might be efficiently reported.

(F) FEEDBACK FROM PAIRED REVIEW OF QUALITY MANAGEMENT SYSTEMS OF INTERNATIONAL AUTHORITIES

23. The nine Authorities that participated in the paired review agreed that the exercise had been beneficial for understanding the QMS of other Authorities, and receiving feedback on its own QMS, which they would take back to their Authority. Authorities participating for the first time had found their sessions to be helpful. One Authority that participated from the beginning of the paired review added that it had learnt new things from each year's sessions.

24. It was agreed that the paired reviews should be continued at next year's quality subgroup meeting. Participating Authorities also encouraged other Authorities to join the paired review sessions, which would have the benefit that two participating Authorities would meet each other in the paired review sessions less frequently.

25. In terms of logistics, some participating Authorities wished for their paired review dialogue to take place in a separate room. One Authority with experience in regular use of teleconferencing for discussions with other Offices believed that videoconferencing facilities to allow participation from those not attending the Subgroup could lose the benefits of a face-to-face meeting.

26. As the paired review had now taken place for three years, Authorities did not consider it necessary to complete a detailed feedback form on logistics for each paired review dialogue. One Authority also proposed that more space was made available on the form to include best practices that could be gained from the discussions. The International Bureau agreed to adapt the feedback form to include a part for comments on logistics and more space to provide substantive comments, including best practices, and stated that the completion of either section of the form should be optional for the participating Authorities.

27. The Subgroup noted the feedback from the paired review exercise and recommended that interested Authorities should perform a paired review of reports of Quality Management Systems at the next meeting. The International Bureau would invite Authorities to participate through the Circular requesting reports on the Quality Management Systems with a deadline to allow participating Authorities to make contact with the Authority they would be reviewing and share questions.

2. BETTER UNDERSTANDING THE WORK OF OTHER OFFICES

(A) OBJECTIVES OF A FUTURE SURVEY ON SEARCH STRATEGIES

28. The United States Patent and Trademark Office introduced a proposal to prepare a future survey of potential users of search strategy information on how they would propose to use that information. This would not aim to harmonize the collection of search strategies between International Authorities, but would inform the considerations of International Authorities, individually and collectively, on the subjects that they had been discussing now for some years.

29. Various International Authorities supported this proposal, observing that further information would be useful, including whether different users may be interested in information not covered by any of the current tracks A, B or C. Some Authorities were keen to seek the views of as wide a range of interests as possible, though concern was noted that opening a survey too freely would make the results very difficult to assess. One Authority suggested that greater convergence was first required on what was meant by a search strategy and what a survey should achieve. In particular, there was concern about the idea that the International Bureau should address a survey to worldwide users without first having gained agreement between national Offices regarding the objectives and target groups of such survey. Conducting a survey might also create expectations to deliver additional information if users so requested.

30. The Subgroup agreed to consider the development of two surveys under the leadership of the USPTO. One would be for the International Bureau to send to IP Offices as a PCT Circular based on feedback received in the Subgroup electronic forum. The second would be for interested national Offices to consider sending to their own users, providing a consistent basis for Offices to feed further user information into the discussions on the Subgroup electronic forum.

(B) STANDARDIZED CLAUSES

(i) Responses to Circular C. PCT 1547

31. The International Bureau summarized the responses to Circular C. PCT 1547. Most of the proposed modifications to the clauses, including the translations, appeared to be acceptable to International Authorities. With regard to the concerns expressed by some International Authorities over the terminology used in certain clauses, it was emphasized that the relevant clauses were ones where several options had been presented because it had not been possible to find universally accepted language - International Authorities would not be obliged to mandate their examiners to use the relevant clauses. This was not the close standardization that had originally been hoped for but represented a step towards greater consistency.

32. Authorities thanked the International Bureau for the work done in preparing the clauses in different languages and emphasized the importance of making the various language versions easily available for use by examiners, including through ePCT. Various Authorities indicated that they had embedded the previous versions of the clauses into their local systems and intended to update them with the modifications. Authorities continued to differ on whether clarity and conciseness of the claims were more properly the subject of Box VII or VIII. One Authority was concerned that the explicit incorporation of the clauses into the Guidelines would raise an expectation from applicants that they be used by all Authorities.

33. The Subgroup recommended that draft paragraph 17.55A of the PCT International Search and Preliminary Examination Guidelines be adopted as set out in Circular C. PCT 1547, save that the sentence referring to the location of the clauses be omitted. The modifications to the clauses should be approved and the International Bureau should seek to establish new versions in the additional languages. The clauses relating to clarity and conciseness should be annotated to indicate that Authorities were free to use them in Box VII if they considered that to be appropriate.

(ii) Implementation and Expansion

34. The Canadian Intellectual Property Office reported on the progress in the development of clauses relating to unity of invention and invited Authorities to comment on whether it was desirable to expand work to the drafting of clauses in other areas, noting the length of time it had taken to achieve a limited consensus with the existing clauses.

35. Various Authorities emphasized the value they saw in the use and further development of standard clauses. One Authority noted that it might be desirable to develop further clauses concerning unity of invention to deal with special cases, including in relation to biotechnology inventions. Other Authorities noted that the work on clauses for unity of invention might be strongly boosted by the consensus that might be emerging in other work on that subject (see paragraphs 46 to 51, below).

36. The Subgroup agreed to continue the development of standard clauses for unity of invention and other areas through the Subgroup's electronic forum.

(C) PRACTICE DISCUSSION FORUM

37. The Canadian Intellectual Property Office reported on the feedback received following discussions of sample “difficult cases” in the test environment provided within the Subgroup’s electronic forum. The Office considered a forum for such discussions to be potentially useful, but only if enough Authorities would use it for both posting and discussing unusual cases. It would be necessary to consider carefully how such a forum would be set up and who would be invited, including the questions of which staff within any particular Authority would have access and whether it should be extended to cover receiving Offices as well as International Authorities.

38. International Authorities viewed the idea of a discussion forum positively, provided that suitable arrangements were found. For the forum to be useful, it would be essential for relevant officers at Authorities to be aware of its existence and authorized to use it. The forum could not be open directly to individual examiners. Each Authority would be expected to be represented by a small number of officers responsible for advising examiners on difficult cases, who would pass on suitable versions of questions from their examiners or suggest ideas in response to questions from other Authorities.

39. The forum would likely need to be more secure than the Subgroup’s electronic forum. Furthermore, the discussions would need to avoid giving details identifying specific cases, but this type of issue should be manageable through the professionalism of the type of user who would be expected to participate. Some Offices might wish their officers to formally represent the Authority and would have difficulty authorizing individual officers to submit questions or comments without an internal agreement process that might render their participation less effective. It was observed that in similar discussions within Offices, the presentation of points of view eventually decided to be “incorrect” or otherwise less desirable was often valuable in helping to see the full scope of the issues involved and that quick, personal responses may be valuable. In any case, the Authority competent for the specific case would need to retain responsibility for any decision taken, irrespective of whether the approach had been suggested by an officer from another Authority. Furthermore, in the long term, the access to the forum should be broadened to all Offices in case matters concerning receiving Offices should be discussed.

40. The Subgroup invited the International Bureau to further discuss possible technical options with the Canadian Intellectual Property Office and to make any further proposals to the International Authorities, for example, through the Subgroup’s electronic forum.

3. CHARACTERISTICS OF INTERNATIONAL SEARCH REPORTS

41. International Authorities expressed their appreciation for the reports on characteristics of international search reports and indicated that the information was useful. The characteristics did not offer measures of quality, but offered useful information on which to base further investigations. However, the range of reports was sometimes overwhelming, leaving it difficult to find and identify the most relevant and interesting information. Some of the characteristics may be of little relevance or essentially duplicative. The comparisons that Authorities would like to make did not necessarily correspond with the lines presented together on the various individual charts. Authorities would like to be able to select the specific charts in which they are interested from a tool such as the IP Statistics Data Center. Failing that, better access to suitably structured versions of the underlying data to prepare alternative views would be useful to some Offices.

42. An additional option regarding language of citations would be the percentage of search reports with at least one patent citation in a language different from that in which the international application was searched. However, the most useful characteristics would be ones comparing the citations used in the national phase to those from the international search report.

43. One Authority recalled the issue that the data description indicated that international applications with no recorded citations were ignored “as no meaningful international search was carried out for these applications.” However, the fact of no citations was itself a relevant piece of information, on which information would be useful.

44. It was observed that small sample sizes, as with the number of reports issued annually by some Authorities, could be misleading. One Authority noted that it intended to take measures aimed at increasing the number of applications for which it conducted international searches.

45. The Subgroup invited the International Bureau to continue to establish reports on the characteristics of international search reports and to investigate options for improving the delivery of the information, taking the above comments into account.

4. UNITY OF INVENTION

46. The European Patent Office introduced the results of work undertaken by the Patent Harmonisation Experts Panel (PHEP) in the context of the IP5 cooperation to seek alignment of practices with regard to the assessment and presentation of a “minimum reasoning” concerning unity of invention in international applications³. This work had been conducted over the course of several years looking at a number of case studies with the involvement of user groups. As a result, the Offices had achieved agreement on a way to present a logical and complete chain of reasoning, using examples drawn from a variety of fields of technology. The IP5 Offices now wished to bring results into the work to update the PCT International Search and Preliminary Examination Guidelines.

47. International Authorities thanked the IP5 Offices for the extensive work that had gone into preparing the case studies. The proposals were interesting, but further work would be needed to prepare proposed modifications to be considered for inclusion in the Guidelines. One Authority noted that a case study in the field of biotechnology would be particularly useful since this area frequently encountered particular difficulties with the assessment of unity of invention. The European Patent Office confirmed that biotechnology examples were included.

48. IP Australia introduced proposals for modifications to the PCT International Search and Examination Guidelines concerning unity of invention, including a number of new examples, which were the outcome of discussions that had been taking place within the Subgroup since 2014. IP Australia noted that a few minor comments had been received recently, but considered that these could be easily addressed. The proposals were therefore essentially ready to be considered for inclusion in the Guidelines as soon as possible.

49. A number of Authorities indicated their support for the proposals and for introducing the new examples as soon as possible, since this would be a significant benefit to examiners in establishing good and consistent reports on a difficult subject. However, several Authorities noted the importance of unity of invention practice to other parties, most notably applicants who would be invited to pay additional fees in the event of a finding of lack of unity of invention. Consequently, it was important to have an effective consultation with users before establishing the Guidelines. The EPO suggested that some time be given for final comments to be given on the proposals by IP Australia with a view to ensure that they were aligned to the “minimum reasoning” (see paragraph 46, above).

50. The importance of the work conducted by the IP5 Offices was recognized and it would be highly desirable to incorporate guidance based on that work into the Guidelines as soon as possible in order to avoid any possible misalignment between the two sets of proposals. That

³ A presentation is available on the WIPO website at:
https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=429371

said, most Authorities wished to see the proposals introduced by IP Australia moved forward as soon as possible.

51. The Subgroup invited Authorities concerned to present specific proposals to address the outstanding comments via the electronic forum within a period of around two weeks, with agreement shortly thereafter. If possible, further proposals might also be made to cover some of the outcomes of the work undertaken by the PHEP. The International Bureau should prepare a PCT Circular on the basis of the agreed text for consultation with designated Offices and user groups. Any outstanding matter would be further considered for discussion in the Subgroup electronic forum with a view to concluding this review exercise at the Subgroup meeting next year.

5. OTHER IDEAS FOR QUALITY IMPROVEMENT

52. One Authority suggested that the Quality Subgroup or Meeting of International Authorities might share information on initiatives underway at their Offices concerning the use of artificial intelligence and consider how these could improve their work as International Authorities.

53. The Japan Patent Office recalled the preliminary proposals made at the end of its presentation on quality management systems (see paragraph 5, above) and invited Authorities to give feedback towards developing the proposals. One Authority noted that these proposals included review of the QMS of one Authority by multiple parties, which could offer a lively and interesting extension to the review process.

[End of Annex and of document]