

Patent Cooperation Treaty (PCT) Committee for Technical Cooperation

**Thirtieth Session
Geneva, May 8 to 12, 2017**

EXTENSION OF APPOINTMENT OF THE AUSTRALIAN PATENT OFFICE AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

Document prepared by the International Bureau

1. All of the existing International Authorities were appointed by the PCT Assembly for a period ending on December 31, 2017. In 2017, the Assembly will therefore need to make a decision on the extension of the appointment of each existing International Authority that wishes to seek an extension of its appointment, having first sought the advice of this Committee (see PCT Articles 16(3)(e) and 32(3)). Information concerning this process and the role of the Committee is set out in document PCT/CTC/30/INF/1.
2. On March 7, 2017, the Australian Patent Office submitted its application to extend its appointment as an International Searching Authority and International Preliminary Examining Authority under the PCT. This application is reproduced in the Annex to this document.
3. *The Committee is invited to give its advice on this matter.*

[Annex follows]

APPLICATION OF THE AUSTRALIAN PATENT OFFICE
FOR EXTENSION OF APPOINTMENT
AS AN INTERNATIONAL SEARCHING AND
PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

1 – GENERAL

a. Name of national Office:

Australian Patent Office (part of the government agency known as IP Australia).

b. Contact related to the contents of this report:

Martin Devlin, Policy Officer, International Policy and Cooperation
Policy and Governance Group, IP Australia
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c. Date on which application for re-appointment was received by the Director General:

March 7, 2017

d. Session of the Assembly at which re-appointment is to be sought: Forty-Ninth
(21st Ordinary) Session of the PCT Union Assembly (2017).

e. Expected date at which re-appointment as ISA/IPEA could commence:

1 January, 2018.¹

f. Existing ISA/IPEA(s) assisting in assessment of extent to which criteria met:

The Australian Patent Office (APO) has sought assistance from the Canadian Intellectual Property Office (CIPO) in reviewing its application for re-appointment as an International Authority (ISA/IPEA) and suitability for re-appointment. The APO has provided a draft submission to the International Bureau for comment and incorporated this initial feedback as part of formalizing this application. Further information regarding review by other Authorities can be found at Section 8 of this application.

2 – SUBSTANTIVE CRITERIA: MINIMUM REQUIREMENTS FOR APPOINTMENT

2.1 – SEARCH AND EXAMINATION CAPACITY

Rules 36.1(i) and 63.1(i): The national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out searches and examinations.

Employees qualified to carry out search and examination:

Source: Sourced from IP Australia's Internal Reporting Team.

¹ The Australian Patent Office seeks to continue its appointment without break. However, due to Australia's domestic treaty processes, it may be necessary to seek a 1 year extension of the current agreement. This would be followed by the adoption of a new agreement once the updated model under discussion with other Authorities has been released.

Technical field	Number (in full-time equivalent)	Average experience as examiners (years)
Mechanical	125.98	8.93
Electrical/electronic	87.94	8.92
Chemistry	93.86	9.06
<i>Total</i>	<i>307.78</i>	<i>9.03</i>
	Excludes trainees	Years from recruitment (includes training time)

Training Programs: The APO develops the skills of patent examiners under a competency based training framework (IP Rights Examiner Program, IPREP). We have implemented a new training program under this framework for Patents examiners called Self-paced Training in Examining Patents (STEP). The new online blended learning modules allow trainees to start in their section, rather than as a separate training group, with a section based Workplace coach who oversees their trainees from day 1 and is responsible for developing the training and assessment plan. Trainees and workplace coaches are supported by the Learning Community Facilitator who facilitates and leads the new examiners through the online Learning Community; and the Coach Coordinator who facilitates and leads workplace coaches' community of practice, supports the coaches and moderates assessments. All training is available online through self-paced material, participation in online communities and virtual classrooms. Trainees can start at any time, from anywhere, rather than having to wait for a group start date. Trainee examiners are able to progress at their own speed, not held back to a rigid timetable. They are also able to go back and review learning as required. The expectation is that new patent examiners will have attained the Acceptance Delegation competencies within 2 years. Depending on the individual's skills, knowledge and application, examiners may achieve the competencies in a shorter period of time.

The APO has an ongoing development program called the Technical Examiner Learning Program (TELP) to aid all examination staff in maintaining their currency in technological developments. The TELP operates across all technology areas and includes in-house technical training sessions by experts in the field, attendance at conferences or visits to various companies in the relevant industries. We also have a competency based program for experienced examiners to undertake development to become Hearing Officers.

IP Australia has established the IP Rights Technical Excellence Centre (IPTeC) which provides a single point of access to all IP Rights learning and development services. IPTeC delivers all aspects of job specific learning, including patents technical learning. Since July 2011, a number of courses were offered to patent examiners in searching (including essential steps; keywords and classification marks); and advanced searching techniques (including for nanotechnology applications). Further courses have been developed and run since July 2013 and include – Advanced Furthers, EPOQUE training, Searching Masterclass, a Re-examination Online Module, IP Reform Training and Searching Non Patent Literature.

Rules 36.1(ii) and 63.1(ii): That Office or organization must have in its possession, or have access to, at least the minimum documentation referred to in Rule 34, properly arranged for search purposes, on paper, in microform or stored on electronic media.

Access to the minimum documentation for search purposes: (X) Full access

Search systems:

Our examiners use an electronic document management system (Patent Administration Management System - PAMS) to process, store, retrieve and examine national patent applications. IP Australia also has an electronic system for international search and examination work (INTESS). Examiners are provided with a Patent Examination Workbench

which includes a wide assortment of examiner resources, including access to patent search tools (EPOQUE) and search engines (STN) covering at least the minimum documentation; electronically-available Manuals (e.g. Patent Manual of Practice and Procedure and Quality Management System Manual); patent law materials; and WIPO and PCT materials. We have implemented a series of PCT best practices, which have been incorporated into the Manual of Practice and Procedure; and the IP Rights Examiner Program (IRPEP) training. These practices regularly undergo review. Additional support tools for examiners include ready access to internal and external databases, technical books, journals and legal resources on IP Australia's Patent Examination Workbench. This includes, but is not limited to, IEEE, MEDLINE, Nature, PubMed, Questel-Orbit, WIPO CASE.

The APO's Search Technical Team (STT) ensures examiners are provided with best-practice search techniques and access to high quality search tools. The STT provides two primary capabilities:

- in-section support, training, and promotion of best-practice search techniques and;
- evaluation of search tools and databases for patent examination.

In addition the STT activities encompass:

- classification activities, including the IPC and CPC;
- maintaining expertise in EPOQUE and STN amongst other search tools;
- providing subject matter experts to the training projects team;
- maintaining the searching volume of the Patent Manual of Practice and Procedure, and;
- contract management responsibility for the commercial search tools used by examiners

Rules 36.1(iii) and 63.1(iii): That Office or organization must have a staff which is capable of searching and examining the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated.

Language(s) in which national applications may be filed and processed: English

Other languages in which large numbers of examiners are proficient: Apart from English, The APO has a policy of maintaining examiner competencies in other languages. This currently includes examiners competent in French, German, Japanese, Chinese, Russian, Spanish and Korean covering all the main technology areas

Services available to assist search or understanding of prior art in other languages:

To assist in searching and understanding prior art in other languages, examiners have access to, but are not limited to, the following resources:

- WIPO Translate
- WIPO Pearl
- Google Translate
- Esp@cenet – Patent Translate (uses Google Translate)

2.2 – QUALITY MANAGEMENT

Rules 36.1(iv) and 63.1(iv): That Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international search.

The APO continues to meet or exceed the requirements set out in Chapter 21 of the guidelines. We are committed to the continual improvement of our core business functions and

corresponding quality management system (QMS). Our QMS report is in full compliance with Chapter 21 of the PCT International Search and Examination Guidelines and all of APO's annual quality reports since 2006 are available on the WIPO website at <http://www.wipo.int/pct/en/quality/authorities.html>. Our QMS has been certified under ISO 9001 since 2006.

Customer Service Charter Timelines: Our Customer Service Charter Report is updated and published quarterly on our website² which, for example, states our standard for international search report issuance against average performance delivered over the most recent quarter.

PATENT REGISTRATION AND EXAMINATION STANDARD

- We will issue international search reports within **10 weeks** of receiving the search copy of the international application unless the application is for more than one invention.
- We will issue international-type search reports for patents within **6 weeks** of receiving the request for the search, unless the search request covers more than one invention, or we ask you to supply a written search statement.
- We will respond to correspondence relating to the examination of your application within **20 working days** of receiving the correspondence.

Patent product quality standards tier 1

Product quality standards that relate to matters which would adversely affect (or have the potential to affect) the validity of the Intellectual Property (IP) right:

- correct search procedure is adopted for all searches
- all relevant objections/considerations which would adversely affect (or have the potential to affect) the validity of the patent are taken.

Patent product quality standards tier 2

Product quality standards that relate to matters which would require a considerable amount of rework and/or inconvenience to the applicant or IP Australia:

- all other important objections/considerations are taken
- the report/opinion is free of invalid objections/considerations
- all reports and opinions are comprehensive and informative

Patent product quality standards tier 3

Product quality standards that relate to other important procedures required by the patents manual:

- search results are correctly communicated and stored
- written formalities are complete and correct.

² See, for example: <https://www.ipaustralia.gov.au/tools-resources/publications---reports>.

3 – INTENDED SCOPE OF OPERATION

Language(s) in which services would be offered: English

State(s) or receiving Office(s) for which Authority is competent: The APO acts as a competent ISA for Australia, Brunei, Ghana, Indonesia, India, International Bureau (For Nationals and Residents of Nigeria, Saint Lucia, Saint Vincent and the Grenadines, Sri Lanka and United Arab Emirates), Kenya, Republic of Korea, Liberia, Malaysia, New Zealand, Papua New Guinea, Philippines, Singapore, Thailand, United States of America, Viet Nam, South Africa and Zimbabwe

Limitations on scope of operation: The APO does not have any limits on the scope of its operation except for which States it acts as a competent authority.

4 – STATEMENT OF MOTIVATION

IP Australia recognises WIPO as the primary forum for advancing Australia's IP interests internationally and we will continue to play a bridge-building role, supporting WIPO to help ensure it is an efficient and effective international organisation. As a result of successive agreements between the Australian Government and the International Bureau, the APO has been an ISA/IPEA since 31 March 1980 and we have built a strong reputation within the PCT community. We continue to demonstrate support for WIPO, including prioritizing PCT reforms, as it is the preeminent body for the development of international IP law and practice. Our participation in various technical and policy meetings and committees assists Australian applications through streamlined international IP systems, improved quality through Office based work-sharing initiatives, and enhanced usability of the PCT. Continuing our appointment as an International Authority underpins our ongoing international engagement: as an organisation we strive to bridge the divide between developing and developed nations in WIPO, delivering innovative international products and capacity-building in the Asia-Pacific region. We do so through various cooperation activities and leading by best example.

The Regional Patent Examination Training Program (RPET), for example, has been an ongoing award-winning success, with positive feedback from participants and the wider global IP community. As a world-first in virtual training, RPET continues to provide a key mechanism for enhancing search and examination practices in the region. RPET provides a comprehensive end-to-end training program and infrastructure that:

- provides for more sustainable patent examination training to overseas offices; and
- can be leveraged to support work sharing and cooperative initiatives with other IP offices.

Through RPET, patent examination standards in participating offices are enhanced, leading to the grant of higher quality patents and increased business confidence throughout the ASEAN region. Effective collaboration enhances our reputation as a quality and committed provider of IP training and development, also strengthening senior and working level relationships with participating offices and program partners.

Another example of our regional engagement, Australia's WIPO Funds-In-Trust (FIT), was first established in 2012. We have worked closely with WIPO and recipient member states to deliver practical outcomes towards improved IP systems globally, but principally in the Indo-Pacific. The initiative, WIPO Re:Search, has been particularly successful, facilitating collaborative research on neglected tropical diseases. Improved IP systems, administration and technology transfer in the region benefits Australians seeking to trade in these countries. The FIT also provides a range of humanitarian benefits in line with broader Australian Government priorities (e.g. access to books for persons with impaired vision in developing countries). The FIT has also increased Australia's profile, credibility and standing in WIPO amongst member states and WIPO's Secretariat. This strengthens our reputation as a constructive contributor to WIPO's

normative agenda and improved geographical reach of WIPO's global systems and services to business stakeholders.

IP Australia has an interest in promoting development of the IP system to the benefit of our users and we do this by collaborating with other IP Offices to influence regional and global IP system development. We do this by working with similar mid-size offices, such as UK-IPO and CIPO, on sharing search strategies and we work with other donors on capacity-building activities. As an ISA/IPEA, we can continue to influence development of the international IP system from a position of operational credibility, supporting other IP Offices and systems in the Asia-Pacific region. The services we provide as an ISA/IPEA are highly valued and sought-after by Australian innovators: the overwhelming majority of Australian applicants choose IP Australia as their ISA and as well as applicants from other jurisdictions, including the United States of America, New Zealand, Singapore, Malaysia and the Republic of Korea, use our ISA services. We provide world-class patent search and examination services at an early stage in the international patent application process. This provides considerable benefit for industry and technology in Australia, in part because the examination and support staff are readily accessible to applicants and/or their legal advisers. This represents a large skills and knowledge base conveniently available to the business and research sector. This assists Australian innovators to make early decisions about their patent application, potentially saving them time and expense.

5 – PROFILE OF PATENT APPLICATIONS

Source: Sourced from IP Australia's Internal Reporting Team.

Number of national applications received – by technical field

	2012	2013	2014	2015	2016
Not indexed	4	4	2	5	12
Chemical	8,881	10,144	8,395	9,354	9,205
Electrical	6,977	7,625	7,071	7,943	7,979
Mechanical	10,477	11,883	10,469	11,326	11,227
Total	26,339	29,656	25,937	28,628	28,423

Number of national applications received – by route

	2012	2013	2014	2015	2016
Standard direct (AU)	1,553	1,776	1,223	1,371	1,620
Standard direct (NON AU)	5,678	7,179	5,520	6,193	7,400
National Phase Entry	19,108	20,701	19,194	21,064	19,403
Total	26,339	29,656	25,937	28,628	28,423

Number of international applications received as RO

	2012	2013	2014	2015	2016
Not Recorded	32	2		1	6
Chemical	753	744	744	669	595
Electrical	920	828	832	877	774
Mechanical	1,208	1,113	1,167	1,120	1,081
Total	2,913	2,687	2,743	2,667	2,456

Top 10 originating nations, filing or Nation Phase Entry in calendar year 2016

United States of America	12,922
Australia	2,620
Japan	1,610
Germany	1,395
United Kingdom	1,180
Switzerland	1,149
China	892
France	808
Netherlands	609
Canada	547

Average time taken for national patent processing (first report/granting date in calendar year 2016)

Indicator	Measured from	Time (months)	
To search	n/a	Search and examination tasks are undertaken by the same examiner at the time the examiner starts examining.	
To first examination	Request for examination	Varies by discipline, but on average:	6.9
		Mechanical	6.1
		Electrical/electronic	7.9
		Chemistry	7.3
To grant	Request for examination	Varies by discipline, but on average:	23.0
		Mechanical	22.7
		Electrical/electronic	21.6
		Chemistry	24.5

Past Data: (to demonstrate the reduction in turnaround times and the fluctuations in outputs)

Patent turnaround times				
Turnaround times (From request for examination to grant in months)	2013	2014	2015	2016
	24.6	23.8	24.7	23.0

National backlogs

Measure	Number of applications (as of 2017-2-14)
All pending applications	42,082
Applications awaiting search (where relevant fees paid)	As search and examination tasks are undertaken by the same examiner at the same time there is no separate and specific data.
Applications awaiting first examination (where relevant fees paid)	18,031

Past data:

Patent Inventory (taken at December 2016)				
Inventory (Number of applications awaiting first action)	2013	2014	2015	2016
	59,123	51,798	47,672	42,206

6 – SUPPORT REQUIRED

The APO will need nominal ongoing support from the International Bureau.

7 – OTHER

National Innovation and Science Agenda (NISA)

On 7 December 2015, the Australian Government released its NISA. The NISA is part of the Government's commitment to establishing Australia as a leading innovative nation. IP Australia is well placed to support relevant changes under the NISA, including those related to data sharing.

The NISA is focused on creating an environment that provides clear pathways and incentives for people and business to innovate. This includes investing in key enablers of innovation like science, research, education and infrastructure; as well as providing the right financial, regulatory, and tax settings to enable businesses to experiment, test and market new ideas.

IP Australia currently offers a number of services that support the NISA. These are primarily aimed at bolstering the commercialisation of public sector research, and collaboration between the research and business community, where intellectual property (IP) can be a contentious issue. These services include:

- The IP Toolkit for Collaboration developed jointly with the Department of Industry, Innovation and Science (DIIS) and launched on 10 September 2015, is an online resource intended to improve collaboration between researchers and the business community. IP Australia engaged consultants to review the current IP Toolkit and consider possible enhancements to its accessibility and functionality. IP Australia and DIIS are now working together towards a beta launch of the enhanced IP Toolkit in the first half of 2017.
- Source IP (launched on 23 November 2015) provides an online marketplace to connect the business community with IP generated from public sector research agencies and universities in Australia. Recent developments have enhanced the user experience and better highlight the commercial relevance of the site.
- The Intellectual Property Neural Open-data Visualisation and Analysis (IP NOVA) tool was launched on 22 October 2016 and was developed from a partnership between IP Australia and small to medium sized enterprises (SMEs). It is a free cloud-based data visualisation tool that enables anyone to explore the IP landscape by searching for IP rights by technology, electorate, location or company names.
- The Patent Analytics Hub provides services which can measure the impact of research and identify opportunities for collaboration and partnerships. IP Australia has expanded its range of services to provide increased support for universities and publicly-funded research organisations.
- IP Government Open Data (IPGOD) is a resource containing 100 years of Australian IP data linked to broader business datasets to support evidence-based policy. IP Australia has launched a live version (IPGOLD) to reflect the most current data and to meet the requirements of the Australian Government's Public Data Policy Statement.

Collaboration with other Authorities

IP Australia is committed to continual improvement and continues to pursue avenues for collaboration on good practice between International Authorities. Current formal initiatives in this area are:

Vancouver Group Initiatives:

The Vancouver Group was established in 2008 and is made up of the IP Offices of Australia, Canada and the United Kingdom. The Vancouver Group aims to:

- share information and experiences on common issues and areas relevant to managing a mid-sized national IP office, and
- contribute to a more effective multilateral approach to work sharing in a manner that supports the principles of the Patent Cooperation Treaty.

There are four areas of focus for the Vancouver Group (or initiatives) and a lead office has been assigned to coordinate planning and activities under each initiative.

1. Mutual Exploitation (led by IP Australia)
2. Business Performance Reporting (led by CIPO)
3. Trade Marks Business Processes (led by IP Australia)
4. Economic Research (led by UKIPO).

Global Patent Prosecution Highway (GPPH) Pilot

IP Australia participates in the GPPH which is an arrangement between 22 IP offices. Under the GPPH, accelerated processing of patent applications is available in any participating office based on positive assessment of at least one patent claim for the same invention in another participating office. The GPPH uses the same agreement and formal requirements for each office which simplifies the process for applicants. IP Australia has participated in the pilot since its launch in January 2014 and has seen strong, steady growth in the number of GPPH requests filed.

Memorandum of Understanding (MOU) with the EPO:

IP Australia and the EPO signed a Memorandum of Understanding (MOU) on the sidelines of the 2015 WIPO General Assemblies. The areas for co-operation are wide-ranging and include reciprocal access to patent information and the establishment of a Patent Prosecution Highway (PPH) pilot programme between the two offices. These activities are aimed at improving the global IP system to support applicants and encourage innovation. Under the PPH, applicants whose claims have been examined by the EPO or the APO may ask for accelerated processing of their corresponding application at the other office, while the Offices will share existing work results, speeding up the process and reducing costs for applicants.

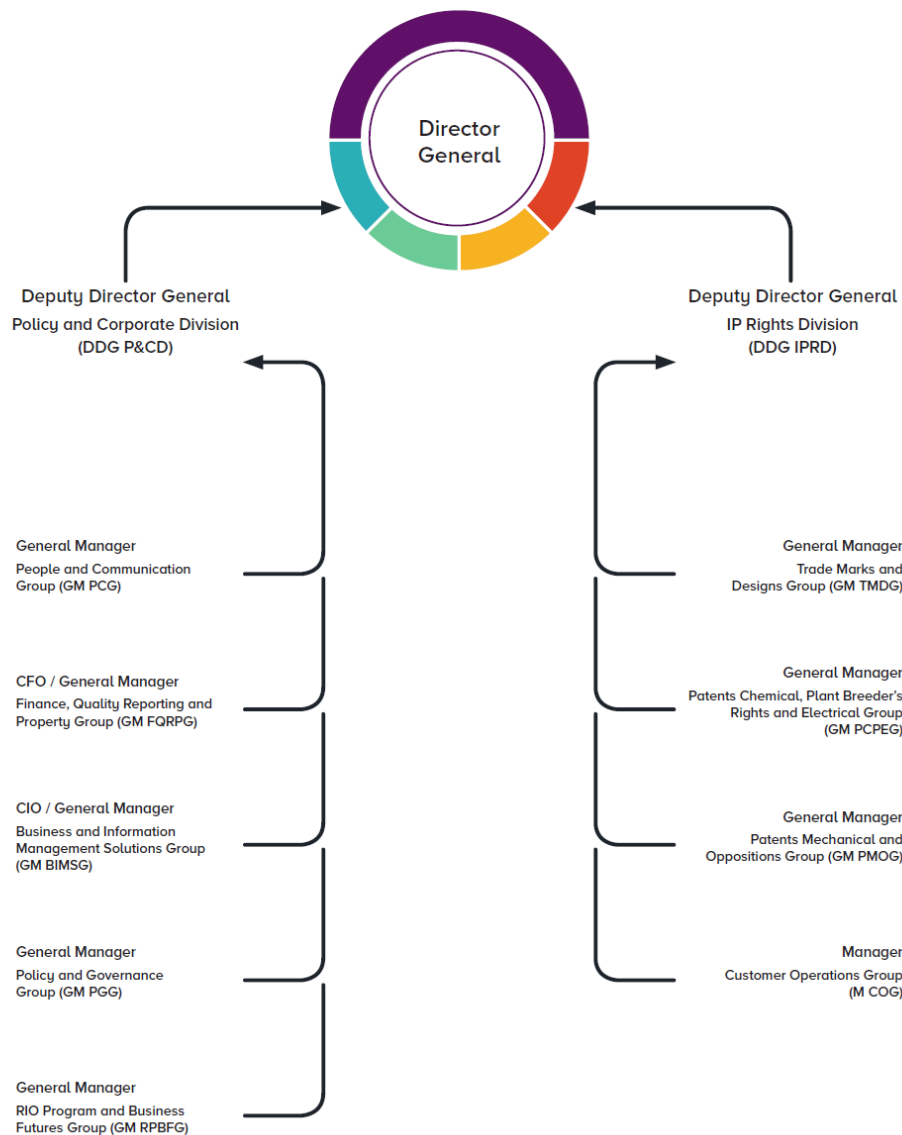
The MOU also encompasses a pilot project for the APO to gain experience in the Cooperative Patent Classification (CPC). This could pave the way for future cooperation in the technical harmonisation endeavour the CPC represents, which already has 19 participating patent offices around the world. The EPO and the APO will also cooperate to ensure the interconnectivity of Global Dossier and WIPO CASE to allow reciprocal access to patent related dossier information.

Organisational Chart

IP Australia's organisational chart (below) shows recent changes to its structure that increases its capacity to deliver robust IP rights. The move to split the Patents group into two groups provides for an increased capacity to handle future workloads and the increasing complexities of the intellectual property landscape. The addition of a second Deputy Director General (Policy

and Corporate Division) also increases capacity in the areas of policy evaluation and development as well as domestic and international policy collaboration.

IP Australia - Organisation Chart



8 – ASSESSMENT BY OTHER AUTHORITIES

IP Australia’s certification under ISO 9001:2008 provides external validation of the robustness of IP Australia’s approach to quality.

The APO recently participated in a pilot of a Paired Review of our Chapter 21 Quality Management System requirements at the recent PCT-MIA Quality Subgroup meeting. The Paired Review allowed for the APO’s QMS to be considered by another office (Spain) and provided an opportunity to answer any questions. Feedback on the APO’s QMS was positive. This review process from other offices has validated the APO’s approach to the various aspects of the QMS and demonstrated consistency in this approach with many aspects of quality systems other offices have in place.

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