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INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Fifteenth Session
Vienna, April 7 to 9, 2008

REPORT

adopted by the Meeting

INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its fifteenth session in Vienna at the Austrian Patent Office from April 7 to 9, 2008.
2. The following International Searching and Preliminary Examining Authorities were represented at the session: the Austrian Patent Office, the Brazilian National Institute of Industrial Property, the Canadian Intellectual Property Office, the European Patent Office, the Federal Service for Intellectual Property of the Russian Federation, IP Australia, the Japan Patent Office, the Korean Intellectual Property Office, the National Board of Patents and Registration of Finland, the Nordic Patent Institute, the Spanish Patent and Trademark Office, the State Intellectual Property Office of the People’s Republic of China, the Swedish Patent and Registration Office, and the United States Patent and Trademark Office.
3. The list of participants is contained in the Annex.

OPENING OF THE SESSION

4. Mr. Richard Flammer, Vice-President of the Austrian Patent Office, welcomed the participants to the meeting. He observed that the participants represented Offices of differing size and from States with differing cultural and economic backgrounds, but that all shared the common mission of raising the quality of the PCT system and making it beneficial for users in all Contracting States.

5. Mr. Francis Gurry, Deputy Director General of WIPO, on behalf of the Director General, also welcomed the participants. He greeted especially the representatives of the Brazilian National Institute of Industrial Property, which was represented for the first time in the Meeting.

6. The session was chaired by Ms. Katharina Fastenbauer of the Austrian Patent Office.

ADOPTION OF THE AGENDA

7. The Meeting adopted as its agenda the draft contained in document PCT/MIA/15/1 Rev., subject to the addition of a further item, "Means of Transmittal of International Reports" (document PCT/MIA/15/7) and a change in the order of items.

PCT STATISTICS

8. The Secretariat presented statistics illustrating the context in which many of the items on the agenda needed to be viewed. These were taken from the PCT Yearly Review, the WIPO Patent Report and the periodic PCT timeliness statistics published on the PATENTSCOPE® website. Notable points included the general rise in numbers of patent applications around the world, with applications by non-residents in most States increasing faster than applications by residents, and the changes in geographic and linguistic origin of patent applications. The latter was reflected by similar changes in publications of scientific journals and had significant implications for Offices' and industry's searches of prior art, as well as in the immediate language skills required for processing the individual applications. The International Bureau was developing a terminology database to assist with this, populated using the work by PCT translators establishing technical translations from the 8 (soon to be 10) PCT languages of publication. The aim was to make this available free of charge for use by Offices, as well as it forming a key part of a cross lingual system for searching international applications. The question was also raised of whether the age profile of patents was changing, with average time for a patent to remain in force reducing as volumes of applications increased and, if so, whether this might have effects on quality and funding for national and PCT search and examination work.

9. International applications were rising at a healthy rate; a 4% rate of growth was predicted for the next few years, though this might depend on the economic situation. Particularly high rates of growth had been seen in the Republic of Korea (which had risen to be the 4th highest PCT filer in 2007) and China (risen to 6th highest filer), as well as Brazil and Singapore. The popularity of PCT compared to the Paris Convention system of filing for applications by non residents varied significantly from State to State. In most States, PCT was the more popular route; the United States was a notable exception, possibly because many applicants who applied in only one State other than their own sought protection there.

10. The popularity of the patent system, including the PCT, had brought some difficulties. To achieve its results, the PCT required efficient processing by a large number of Offices and the level of service expected by applicants was not always being achieved. In particular, there were many record copies which the International Bureau did not receive from the receiving Office until more than 8 weeks after the international filing date; from the limited information available to the International Bureau, it appeared that search copies were often even more significantly delayed. Timeliness of delivery of international search reports and international preliminary reports on patentability also needed to be significantly improved: only half of international search reports were established within the timescale envisaged by the Treaty and a substantial number of reports were not available until later than 30 months from the priority date.

QUALITY FRAMEWORK

11. Discussions were based on document PCT/MIA/15/6, the reports submitted by the International Authorities on their quality management systems in accordance with the PCT International Search and Preliminary Examination Guidelines and the resolution of the PCT Assembly agreed upon in the context of the adoption of Rules relating to supplementary international search (reproduced in paragraph 4 of document PCT/MIA/15/11) that the Meeting should review the quality of the main international search.

12. The Austrian Patent Office made a presentation of its quality management system¹. It was observed that a large amount of information was amassed in quality systems during the operational review of individual applications within examining divisions at the time that reports were established, in addition to that found in audit at a later stage. There was some discussion of the extent to which general conclusions could be reached at this stage and the manner in which this could be fed back into the system, for example, by way of improving guidelines, in order to offer general guidance in addition to feedback to individual examiners.

13. The Spanish Patent and Trademark Office announced that it had recently launched a "Microsite on Quality"². This site would include results on performance indicators (service charters), results of user satisfaction surveys and a special restricted access section to serve as a communication channel with receiving Offices and designated and elected Offices (see paragraph 21.08(b) of the PCT International Search and Preliminary Examination Guidelines).

14. The Authorities reiterated the importance of sharing of information on quality and considered that further work was required. It was suggested that future meetings might select particular detailed issues on which to focus discussions.

¹ The presentation is available from the WIPO website at www.wipo.int/meetings/en/details.jsp?meeting_code=pct/mia/15

² Accessible from the SPTO website at www.oepm.es or www.oepm-calidad.es

15. The European Patent Office recalled its promise at earlier sessions to revise and update Chapter 21 of the PCT International Search and Preliminary Examination Guidelines. It was not intended to introduce major new obligations but to clarify and expand on the requirements of quality management systems for International Authorities and to remove some inconsistencies which had been identified. An internal draft had been completed and it was intended to conduct extensive consultations with other Authorities in advance of presenting a formal proposal to the next session of the Meeting of International Authorities.

16. The Meeting agreed:

(i) that the reports submitted by the Authorities on their quality management systems should be made available on the WIPO website;

(ii) that the European Patent Office should circulate draft proposals for revision of Chapter 21 of the PCT International Search and Preliminary Examination Guidelines to all Authorities by late summer 2008 and prepare a formal proposal for the next session of the Meeting;

(iii) that the International Bureau should present a report to the PCT Assembly, summarizing the above developments.

ENHANCING THE VALUE OF INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION UNDER THE PCT

17. Discussions were based on document PCT/MIA/15/2.

18. The Secretariat, in introducing the document, noted that the issues of work-sharing between Offices and avoidance of duplication of work had been high on the agenda in the discussions of major patent Offices in the recent past. Yet, surprisingly, the PCT did not feature prominently in these discussions, although the issues which had led to the adoption of the PCT in 1970 were the same as those which were now discussed in the context of work-sharing schemes, such as the Patent Prosecution Highway and the New Route, and although the system had been set up as *the* work-sharing tool for applications filed internationally.

19. It was, of course, recognized that a great number of applications filed internationally were filed outside of the PCT system via the Paris route, and that some Offices received the great majority of applications not via the PCT but via the Paris route, so there would be, no doubt, a great need for effective work-sharing arrangements outside of the PCT system. Furthermore, it would be the expectation and hope that, eventually, any progress in work-sharing in respect of non-PCT filings would also flow over to the PCT and result in an improved use of that system.

20. However, there were concerns that the PCT system was being neglected and not being used to its full potential, and that some of the recent work-sharing initiatives were, in effect, trying to “re-invent the wheel”. If there were deficiencies in the PCT system, they should be addressed and fixed in the PCT, rather than designing new systems outside of, or as an alternative to, the PCT. It appeared that those deficiencies lay not in the overall design of the system but more in the way the system was being used by national Offices, including those which also acted as International Authorities; there was thus no need for a new PCT reform exercise but a need to consider how the PCT system as a whole, especially the conduct and

the use of the results of international search and preliminary examination, might be improved to use the PCT system to its full potential and to maximize its value to applicants and Offices.

21. The Authorities welcomed the document as important, timely and useful, containing a wide range of issues which required consideration by the International Authorities as well as applicants and other Offices in order to make the PCT system more effective.

22. Some of the general observations included the following:

(a) action was necessary in the context of backlogs growing in both number and application pendency time, which provided legal uncertainty and difficulties for industry in making investments;

(b) some of the issues were already being at least partially addressed in ongoing projects, such as the review and improvement of quality management systems, or with the forthcoming Rule changes relating to use of earlier searches by other Offices and supplementary international search;

(c) the challenges faced by Authorities had changed over time and the increasing linguistic diversity of prior art especially meant that collaboration was becoming essential in order to achieve high quality results;

(d) most of the issues fell into three broad categories: enhancing quality management and related issues, such as PCT minimum documentation; further enhancement of search and examination, and greater uniformity in results and presentation in order to assist mutual exploitation; and organizational matters such as systems for centralized access and exchange of work results;

(e) the results of international reports may be particularly important to the Offices of developing countries;

(f) improvements in many areas required stricter adherence to the current requirements of the Treaty, Regulations and Administrative Instructions by International Authorities, rather than changes to the legal framework;

(g) the details of patentability were a matter of national law and any review must remain within the Treaty framework.

23. In relation to the content, scope and related quality management systems for international search reports, the following comments were made:

(a) it was important to continually develop quality management systems;

(b) the definition of the PCT minimum documentation needed to be revised to reflect the realities of searching in the digital age;

(c) technical improvements as well as collaboration were required to address the difficulties of searching prior art in a wide range of languages;

(d) it might be desirable to look at ways of collaboration on search prior to the establishment of the international search report, as well as in the consecutive approach envisaged by the Rules relating to supplementary international search;

(e) international searches should be treated as seriously as national searches by Authorities;

(f) timeliness of the establishment of international search reports was important in addition to quality;

(g) further consideration was required of ways to use modern IT to collaborate effectively.

24. In relation to the content of written opinions and international preliminary reports on patentability, the following comments were made:

(a) the usefulness of reports was diminished by the failure to consistently list later published applications (as defined in Rule 33.1(c)) which may be of relevance to inventive step as well as novelty;

(b) for a written opinion to properly address the issues of novelty and inventive step, it was also necessary to address the main points of clarity and support in order for the opinion to be understood in its proper context, but minor matters would be treated in such different ways by different Offices that there might be little benefit in listing them;

(c) it was unrealistic to expect examining Offices to simply accept international reports, but the most comprehensive international report possible would minimize the additional work of a designated Office;

(d) further consideration had to be given to the structure of reports: the current order was often not conducive to clear expression of points and it might be desirable to develop a format which was less rigid, without losing all structure.

25. In relation to questions of (perceived or real) differences between international and national reports, the following comments were made:

(a) there might be a perception by some examiners that a national report needed to be taken more seriously than an international report since there was no further review before national rights were granted;

(b) anecdotally, work done on PCT reports was commonly seen to be less comprehensive than for national reports, but analysis by one Authority of different types of reports prepared by that Office had found no difference in extent or content, only in presentation;

(c) if systematic differences were perceived in content and quality of national and international reports, this should be measured;

(d) it was desirable that Authorities should recognize their own work in the national phase such that international reports would effectively become binding on the Office which produced them as a first national action;

(e) the quality of a report was not necessarily related to whether or not it was binding on the Office producing it, but measures certainly needed to be considered for improving the quality of non-binding reports;

(f) there would necessarily be differences in the extent of “secret prior art” found because of the relative timing of national and international searches, but this was not a reason to delay the international search;

(g) the desires of applicants with regard to timing of reports varied greatly and some flexibility might be desirable, but it was also necessary to take needs of third parties into account;

(h) it might be beneficial to consider PCT “top up” searches at a later stage than the main international search.

26. In relation to making Chapter II more attractive and encouraging entry into the national phase in a form likely to be acceptable for grant, the following comments were made:

(a) applicants often wished to retain flexibility for as long as possible and not commit to a particular course of action within the international phase;

(b) the efficiency of work sharing might sometimes be greater if the application entered the national phase in exactly the form on which the international search was conducted;

(c) it would be necessary to consult with user groups on whether new options would be useful, such as amendment of the description as well as claims without demanding international preliminary examination.

27. In relation to the possibility of promoting international first filings, the following comments were made:

(a) it might be generally cheaper to initially make a national filing, which offered a useful filtering process for applications, increasing the average quality of those which eventually reached the International Searching Authority;

(b) this option was already available for applicants and it was important to maintain user choice in whether it was taken up.

28. In relation to questions of improving electronic sharing of reports and information, the following comments were made:

(a) as much information as possible should be made available to all Offices in character coded electronic form at the earliest stage possible – easy access to national reports of other Offices was particularly important;

(b) the option of “push” of information would be useful, as long as Offices were able to select what information was sent to them;

(c) full text copies of documents cited by other Offices should be easily available.

29. In relation to whether parallel processing of national and international applications was desirable or undesirable, the following comments were made:

(a) such an approach could offer Authorities improvements in efficiency which would also result in increased quality of international reports;

(b) alternatively, it might be considered that it was contrary to the philosophy of the PCT and that, in combination with the supplementary international search system, it could be counter-productive for the Authority as this might involve additional national processing if the reports had to be revised following the discovery of relevant prior art by other Offices.

30. In relation to incentives which could be offered to applicants to use the system more efficiently, the following comments were made:

(a) the complexity of applications was increasing and there was a need to look at measures to reduce excessive numbers of claims, independent claims and options within claims, as well as to consider possibilities such as only searching one independent claim per category;

(b) fee incentives and accelerated processing for applications with positive international preliminary reports on patentability were options;

(c) it might be desirable to require applicants to respond to points raised in the international preliminary report on patentability on entry into the national phase;

(d) there might be a need for greater flexibility within the international phase, including a greater opportunity for applicants to respond to written opinions.

31. The Secretariat informed the Meeting that it would present the paper in other fora, including the PCT Working Group at the end of May, in order to seek feedback on these issues from other Offices and user groups.

USE OF SEARCHES BY OFFICES OTHER THAN THE ONE ACTING AS INTERNATIONAL SEARCHING AUTHORITY

32. Discussions were based on document PCT/MIA/15/10.

33. The Meeting expressed its general support for the draft modifications to the Forms set out in Annex II to document PCT/MIA/15/2 and the draft modifications to the PCT International Search and Examination Guidelines set out in Annex III to that document, subject to the comments and suggestions appearing in the following paragraphs.

34. One Authority expressed its concern about the proposed inclusion in the Receiving Office Guidelines of a provision requiring the receiving Office to forward to the International Searching Authority any of the documents referred to in Rule 12*bis* (such as the copy of the earlier application or translations of the application or of the search results) which the applicant had submitted to that Office rather than the Authority, noting that such provision would encourage applicants to submit those documents to the receiving Office rather than, as foreseen in Rule 12*bis*, to the International Searching Authority. The Authority suggested that the request form should be further modified to clarify that only the copy of the results of

the earlier search should be submitted to the receiving Office, whereas any other document required by the International Searching Authority under Rule 12*bis* should be sent directly to that Authority.

35. One Authority expressed its strong reservation about the proposed inclusion of checkbox item 1(d) on the first sheet of Form PCT/ISA/210 (“This Authority, following the applicant’s request, has taken into account the results of (an) earlier search(es) (Rules 4.12, 12*bis* and 41.1)”). This could cause confusion in some cases where the request had been made but the box had not been crossed. This would also not add significant value for applicants, noting that the applicant, where the Authority had taken into account the results of an earlier search, would in any case receive a separate communication from the Authority concerning the fee refund under Rule 16.3.

36. One Authority proposed that a further item be included in Form PCT/ISA/238, inviting the applicant to clarify what the differences were between the international application and the earlier application concerned.

37. Upon request by one Authority, the Secretariat explained that the Regulations did not provide for a formal invitation procedure for the receiving Office where the applicant had indicated, in the request, his wish that the International Searching Authority take into account the results of an earlier search but not submitted to the receiving Office a copy of the results of the earlier search (and did not comply with the requirements under Rule 12*bis*.1(c) to (f)). Authorities would consequently not be obliged to make any such invitation, but would be free to do so informally if they believed that it would be useful and that a copy would be provided quickly.

38. Following an invitation by the Chair to comment on whether Authorities, as of the date of entry into force on July 1, 2008, of amended Rules 4, 12*bis*, 16 and 41, intended to take into account the results of an earlier search where the earlier search was carried out by another International Searching Authority or by an Office other than that which is acting as the International Searching Authority (see Rule 41.1(ii)), several Authorities indicated that they intended to do so, subject to certain conditions and other details still to be determined. Several Authorities stated that they already took certain searches by other Offices into account. Other Authorities stated that, while they would not (yet) be in a position to formally take the results of such earlier search into account and to provide any fee refunds, they would still consider the results of such earlier search in carrying out the international search.

SUPPLEMENTARY INTERNATIONAL SEARCH

39. Discussions were based on document PCT/MIA/15/11.

40. The Meeting expressed its general support for the preliminary draft Forms and Guidelines set out in Annexes II and III to document PCT/MIA/15/11, subject to the comments and suggestions appearing in the following paragraphs and any further comments which Authorities may wish to make during the formal consultation procedure.

41. Several Authorities questioned the need for the proposed new PCT/ISA Form concerning “Finding of Non-Compliance with the Requirement of Unity of Invention”, noting that, under new Rule 45*bis*.6, such finding should be notified to the applicant as part of the supplementary international search report established on those parts of the application which relate to the main invention rather than by way of a separate notification. In addition, it was noted that the substance of Box No. II of that proposed new PCT/ISA Form (relating to claims which have been found unsearchable in accordance with Article 17(2)(b)) did not relate to the issue of non-unity and should not be included in that Form.

42. One Authority suggested that paragraph 15.79 of the preliminary draft modified International Search and Examination Guidelines be clarified and amended to encourage the supplementary search to be made without unnecessary further consideration of the question of unity of invention.

43. One Authority queried whether it might be possible to offer different scopes of supplementary international search (for example, either a complete search or one which is specifically directed to document collections in particular languages) at different prices.

44. Upon request by one Authority, the Secretariat explained that it was up to any International Searching Authority willing to offer supplementary international searches to determine any limitations and conditions for carrying out such searches as well as the scope of such searches.

45. Several Authorities suggested the inclusion of, for example, an additional Annex to the new PCT/ISA Form containing the supplementary international search report so as to allow Authorities to include explanations with regard to the scope of the supplementary international search, as referred to in paragraph 15.85(v) of the preliminary draft modified International Search and Examination Guidelines.

46. Following the invitation by the Secretariat to comment on whether and when Authorities may be able to offer the service of supplementary international searches (SIS), the Meeting noted the following statements by the Authorities:

(a) Austrian Patent Office: intention to offer SIS as of January 1, 2009, details to be determined;

(b) Brazilian National Institute of Industrial Property: SIS viewed positively but not yet in a position to decide on participation in the system;

(c) Canadian Intellectual Property Office: SIS viewed positively but no intention to offer SIS in the near future;

(d) European Patent Office: intention to offer SIS as of January 1, 2010, details to be determined, limited at the outset to several hundreds of applications per year, to be increased, if needed, to up to several thousand applications by 2013;

(e) Federal Service for Intellectual Property of the Russian Federation: intention to offer SIS as of January 1, 2009, details as to number of applications and technical fields to be determined;

(f) IP Australia: SIS viewed positively but possible participation still under consideration, in any case not as of January 1, 2009;

(g) Japan Patent Office: no intention to offer SIS, focus of all Authorities should be on improving the quality of the main search;

(h) Korean Intellectual Property Office: SIS viewed positively but possible participation still under consideration, taking into account recent increase in number of applications received;

(i) National Board of Patents and Registration of Finland: SIS viewed positively but possible participation still under consideration, perhaps as of January 1, 2010;

(j) Nordic Patent Institute: intention to offer SIS as of January 1, 2009, details to be determined;

(k) Spanish Patent and Trademark Office: no intention to offer SIS, focus of all Authorities should be on improving the quality of the main search;

(l) State Intellectual Property Office of the People's Republic of China: SIS viewed positively but possible participation still under consideration, comprehensive analysis needed;

(m) Swedish Patent and Registration Office: SIS viewed positively but possible participation still under consideration, perhaps as of January 1, 2009;

(n) United States Patent and Trademark Office: SIS viewed positively but no intention to offer SIS in the near future, due to workload considerations.

CLAIMS FEES

47. Discussions were based on document PCT/MIA/15/9.

48. The European Patent Office, in introducing the document, stated that it wished to highlight the fact that, under its proposal, each International Searching Authority would be free to decide whether or not to charge claims fees during the international phase, and that it did not wish to impose such claims fees on any Authority which decided against charging such fees.

49. Several Authorities, while generally supportive of the proposal to introduce claims fees in the PCT, expressed their concerns about the proposal, noting the different requirements of PCT Member States which included such fees under their applicable national laws. Concerns were particularly expressed as to the proposed sanction in case of non-payment of claims fees, noting that, in view of the wording of Article 17, there might be no legal basis for considering claims for which no claims fees had been paid to be abandoned or not to establish an international search report in respect of such claims. In the view of some of those Authorities, the only possible sanction in case of non-payment of claims fees would be to consider the application to be withdrawn under Article 14(3), as in the case of non-payment of other PCT fees due upon filing of the application. Furthermore, doubts were raised as to the usability of the international search report for designated Offices in cases where the applicant, when filing the international application, limited the number of claims to avoid claims fees, only to increase the number of claims upon national phase entry before Offices which, under their

applicable national law, did not charge such fees. One Authority noted that similar problems existed under its national law, where claims fees due during the acceptance stage resulted in applicants reducing the number of claims, only to amend the application to again increase the number of claims at a later stage.

50. Other Authorities welcomed the proposal, noting the burden for International Searching Authorities in searching applications with a large number of claims and the impact on the quality of granted patents. One Authority expressed the view that claims fees could be compared to the already existing requirement to pay page fees for each page in excess of 30 pages.

51. All Authorities which took the floor on the matter stated that they could not support the proposal to introduce into the PCT provisions permitting an International Searching Authority to restrict the scope of the international search report to one independent claim per category (in the manner provided under the European Patent Convention), stating that, in their view, there would be no legal basis in the PCT for such a restriction of the international search.

52. The European Patent Office thanked all Authorities who took the floor on these matters for their comments and stated that it would further consider the matter, including the question whether the proposal should be presented to the PCT Working Group for discussion at its next session at the end of May 2008.

PROPOSAL BY THE EUROPEAN PATENT OFFICE, JAPAN PATENT OFFICE AND UNITED STATES PATENT AND TRADEMARK OFFICE FOR MODIFICATION OF THE PCT ADMINISTRATIVE INSTRUCTIONS

53. Discussions were based on document PCT/MIA/15/8.

54. The Japan Patent Office, speaking on behalf of the Trilateral Offices (the European Patent Office, the Japan Patent Office and the United States Patent and Trademark Office), in introducing the document, outlined the background and the content of the so-called “Common Application Format” (CAF) as agreed among the Trilateral Offices³ and explained the need for the proposed consequential modifications to the Administrative Instructions.

55. The Meeting expressed its general support for the proposed draft modifications of the Administrative Instructions set out in Annex II to document PCT/MIA/15/8, subject to the comments and suggestions appearing in the following paragraphs and any further comments which Authorities may wish to make during the formal consultation procedure on those proposed modifications.

56. One Authority questioned the rationale to add requirements as in Sections 204(b) and 204*bis*, stating that they were just for convenience of electronic processing and not good for all applications. The Secretariat clarified that the Sections of the Administrative Instructions proposed to be modified (Section 204 concerning the use of headings of the parts of the description) and to be added (new Section 204*bis* concerning the numbering of claims) were recommendations only and their wording (“shall preferably”) in line with the drafting style used elsewhere in the Administrative Instructions.

³ The presentation is available from the WIPO website at www.wipo.int/meetings/en/details.jsp?meeting_code=pct/mia/15

57. Noting that the description should always begin with the title of the invention, it was suggested that proposed new Section 204(b) should be further modified to read: ‘The heading “Title of the Invention” shall preferably precede the title of the invention.’

58. It was noted that the inclusion, in Section 204(a) as proposed to be modified, of different headings for matter referred to in Rule 5.1(a)(iii) (“Disclosure of Invention” or “Summary of Invention”) and for matter referred to in Rule 5.1(a)(v) (“Mode(s) for Carrying out the Invention” or “Description of Embodiments”) was to clearly allow the PCT system to accept the different practices which existed under the applicable national laws of Member States. It was further noted that the addition of additional optional headings for those matters would not require any amendments of the Regulations.

LANGUAGES OF PUBLICATION

59. Discussions were based on document PCT/MIA/15/5.

60. The Meeting expressed its general support for the for the proposed criteria for the addition of publication languages set out in document PCT/MIA/15/5, subject to the comments and suggestions appearing in the following paragraphs.

61. The Meeting noted that it may be preferable to replace, in the proposed second criterion (combined number of applications which are first filed in the language concerned in all Offices which accept that language), the fixed number of applications (20,000) with a figure expressed as a percentage of all applications filed worldwide without claiming priority.

62. Following a question by one Authority, the Secretariat stated that the term “adequate machine translation tools” in the proposed third criterion (public availability of adequate machine translation tools for translation into at least English ...) might, in practical terms, mean that at least one database provider considered those tools to be of sufficient quality that he was willing to include those tools in his database.

63. While noting the importance of accessibility of the information to Offices and third parties, one Authority questioned whether it was necessary to include a provision related to the provision of machine translation if the first two criteria had been met, establishing the utility to a significant body of applicants of the addition of the language.

INTERNATIONAL APPLICATIONS PUBLISHED WITHOUT CLASSIFICATION

64. Discussions were based on document PCT/MIA/15/12.

65. The European Patent Office, in introducing the document, observed that, when the issue of international applications published without classification had first been raised, it had found that it was the International Searching Authority (and therefore responsible for the classification) for around 73% of the international applications involved. Since then, it had put in place various mechanisms to allow classification in advance of the establishment of the international search report. However, the majority of cases involved late receipt of search copies from the receiving Offices and consequently further action was required by those Offices.

66. The Secretariat made a presentation⁴ on some of the potential causes and potential courses of action. While a large proportion of the cases involved a small number of receiving Offices and International Searching Authorities, a wide range of receiving Offices and Authorities had occasional difficulties in delivering the necessary documents and information in good time. It was not clear where the delays occurred in all cases because the International Bureau did not systematically receive details of when search copies were sent by the receiving Office (as this may be later than the record copy if the receiving Office has not received, or has not been able to confirm receipt of the search fee), nor of when search copies were received by the International Searching Authority.

67. The United States Patent and Trademark Office recognized that there had recently been critical backlogs at its receiving Office but reported that steps had been taken and improvements in the front-end processing could already be seen. Electronic transfer of search copies to the European Patent Office and Korean Intellectual Property Office as International Searching Authorities was already an intended development but might not be achieved until November 2009. However, since it was already using overnight carriers for delivery of the search copies, this would only have a fairly limited effect in increasing the speed of delivery.

68. It was generally felt that options should be explored for delivering the search copy to the International Searching Authority at an earlier stage, but some Authorities indicated that they would not wish to receive search copies before the search fee had been paid because of the additional burden which would be involved in performing the necessary checks at a later stage, and that there could also be additional burdens for receiving Offices in such an approach.

69. It was suggested that the receiving Office (where it had appropriate systems and staff) might provide a pre-classification of the international application, which could be used if the International Searching Authority did not provide a definitive classification in time. Alternatively, or additionally, automated classification systems, such as IPCCAT and TACSY, could be developed to generate provisional classifications based on analysis of the text of the international application. However, it was observed that such an approach would inevitably result in a large number of mis-classifications and it would be necessary to consult carefully with user groups to find out whether such an approach would be considered better or worse than no classification at all.

70. The Meeting agreed:

(i) that means should be sought of providing search copies to International Searching Authorities in electronic form at an earlier stage;

(ii) in particular, that the International Bureau should make a copy available to the International Searching Authority based on the record copy if the search copy had not yet been received by that Authority when the International Bureau made a special request for classification in advance of the date of publication; and

(iii) that investigations should be made of the possibility of pre-classification either by the receiving Office or by automated systems.

⁴ The presentation is available from the WIPO website at www.wipo.int/meetings/en/details.jsp?meeting_code=pct/mia/15

MEANS OF TRANSMITTAL OF INTERNATIONAL REPORTS

71. Discussions were based on document PCT/MIA/15/7.

72. Several Authorities expressed their concerns about whether it was appropriate to use e-mail for the communication to the applicant of confidential reports (international search reports and international preliminary reports on patentability) and related communications, noting existing security and confidentiality risks, as well as possible technical problems. It was noted that they had raised, or intended to raise, similar concerns in the context of the consultations on the proposed modifications of the request form, allowing the applicant to request the International Bureau to communicate by e-mail certain Forms and documents related to unpublished international applications. With reference to existing or envisaged national file inspection systems under which the applicant was informed, by e-mail, of the availability of a particular communication or report, to be accessed or downloaded by the applicant from a secure Office website, several Authorities stated their preference for the development by the International Bureau of similar systems in respect of international applications.

73. Other Authorities stated their support for the proposals set out in document PCT/MIA/15/7, referring to similar arrangements existing under their national systems and pointing to the fact that communication by e-mail of confidential reports and related documents would only be considered appropriate where the applicant had chosen that means of communication, thus bearing the security and confidentiality risks still remaining with e-mail communications.

74. The Secretariat stated that it indeed intended to develop a private file inspection system to enable applicants to access, in a secure manner, the file of the international application held by the International Bureau, but that it would take some time to finalize and deliver such system, due to budgetary constraints. Noting that the PCT system consisted, in effect, of a network of Offices, it expressed the view that setting up such systems for the communication to the applicant of all documents from all Offices would be a challenge, and encouraged the Authorities, to the extent that they had file inspection systems in place which would permit the secure retrieval of documents by the applicant, to make such systems available also with respect to documents and communications relating to international applications.

PCT MINIMUM DOCUMENTATION

75. Discussions were based on document PCT/MIA/15/4.

Korean Journal of Traditional Knowledge

76. The Secretariat recalled the relationship of traditional knowledge search resources with the work of the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC) and, in particular, the importance of defensive protection of traditional knowledge to avoid inappropriate grants of patents on related inventions.

77. The Korean Intellectual Property Office introduced its proposal to add the Korean Journal of Traditional Knowledge (KJTK) to the PCT minimum documentation. Further to the details which had been provided in document PCT/MIA/15/4, it confirmed that the KJTK was a journal (ISSN 1976-6882), consisting of articles selected from 47 major Korean journals in related fields. The selection criteria for inclusion were essentially based on there being some technical content rather than purely historical matter. The IPC codes applied to the article would be revised as required by the Office as the classification developed. Five examiners within the Office working on particularly relevant subject areas used this database as their primary means of search. In response to queries about difficulties in ease of use if registration was required by individual examiners, the Office indicated that it could, on request, make the site available directly to other Offices, bypassing the login requirement.

78. The Authorities considered the KJTK to be an important source of information, noting the need for high quality resources for examiners for search of traditional knowledge. In relation to suggestions that such resources needed to be integrated into systems allowing effective search across a wide range of databases using a common interface, the Secretariat reminded Authorities of the proposals in the IGC and TRIPS Council on this matter and stated that WIPO was working on such an arrangement and would soon be unveiling a prototype of a TK portal covering a small number of databases. However, the challenges involved were considerable in view of the wide range of types of disclosure involved. It was likely that work would be undertaken soon in the Standards and Documentation Working Group of the Standing Committee on Information Technologies to develop standards to assist in common search of such databases.

79. The Meeting agreed to add the Korean Journal of Traditional Knowledge to the PCT minimum documentation with effect from January 1, 2009.

Comprehensive Review

80. The Authorities confirmed that review of the PCT minimum documentation was still considered a priority, noting the importance of recognizing the realities of searching in the digital age and, in particular, of finding an appropriate way of recognizing the role of databases within the minimum documentation. Appropriate criteria were required to ensure that decisions could be taken without detailed review of each individual proposed addition to the minimum documentation by the Meeting of International Authorities itself.

81. One Authority indicated that it was important for the criteria established by the task force to differentiate between resources that should be part of the minimum documentation and must be accessible and searched, and resources that were useful for enhancement of the search but not necessary for inclusion in the minimum documentation.

82. The Meeting agreed that the European Patent Office should review the work which has already been performed by the task force reviewing the PCT minimum documentation and lead further action by that task force, with the aim of presenting concrete proposals to the next session of the Meeting for appropriate changes to the definition of the minimum documentation under the PCT Regulations.

FILING AND PROCESSING OF SEQUENCE LISTINGS UNDER THE PCT

83. Discussions were based on document PCT/MIA/15/3.

84. The Meeting expressed its general support for the proposed modifications of the Administrative Instructions set out in document PCT/MIA/15/3, subject to the comments and suggestions appearing in the following paragraphs and any further comments which Authorities may wish to make during the formal consultation procedure on those proposed modifications.

85. One Authority, supported by several other Authorities, suggested not to further pursue the proposal not to include in the page count (to determine any page fees due) any pages containing tables related to sequence listings; rather, those pages should be included in the page count and the full page fees should continue to be charged for such pages, irrespective of whether or not they were submitted in electronic form. In this context, the Authority noted that such pages were not machine-processable in the way that the sequence listings were, but rather required manual consideration by the examiner. Furthermore, in view of the absence of a definition of what constituted “tables related to sequence listings”, if no page fees were to be charged for pages containing such tables, applicants could be tempted to include in such tables all kind of subject matter not related to sequence listings in order to avoid the payment of page fees, also noting the lack of expertise in sequence listing related matters in receiving Offices. Also, should the proposal not to include in the page count (to determine any page fees due) any pages containing tables related to sequence listings be dropped, the Authority suggested deleting from the proposed modifications of the Administrative Instructions the requirement that tables related to sequence listings had to be presented in a separate part of the description and be submitted in a particular document format (ASCII).

86. Following a query by one Authority, the Secretariat stated that it believed a useful purpose was served in requiring the International Searching Authorities to submit to the International Bureau any sequence listing in text format furnished to the Authorities for the purposes of international search in order for the International Bureau to be able to make all such sequence listings available, from a centralized PCT source, to the general public through PATENTSCOPE®, despite the fact that some Authorities already made those sequence listings available to private sequence listing database providers.

FUTURE WORK

87. The Meeting noted that it was envisaged that the next session would be held in the spring of 2009 and gratefully accepted the offer of the Korean Intellectual Property Office to host the session in the Republic of Korea.

[Annex follows]

ANNEX

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(in the English alphabetical order of their names)

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[End of Annex and of document]