

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

Eighteenth Session
March 15 to 17, 2011, Moscow

Report

adopted by the Meeting

INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its eighteenth session in Moscow from March 15 to 17, 2011.
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 Egyptian Patent Office, the European Patent Office, the Federal Service for Intellectual Property, Patents and Trademarks of the Russian Federation, IP Australia, the Israel Patent Office, 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. Claus Matthes, on behalf of the Director General, opened the session, welcomed the participants and thanked the Federal Service for Intellectual Property, Patents and Trademarks of the Russian Federation (Rospatent) for hosting the session and for the excellent arrangements it had made. He especially welcomed the representatives from the Japan Patent Office, who had traveled from Japan despite the difficult circumstances following the devastating earthquake in Japan.

5. Ms. Liubov Kiriy, Deputy Director General, Federal Service for Intellectual Property, Patents and Trademarks of the Russian Federation (Rospatent), welcomed the participants on behalf of the Director General of Rospatent, Mr. Simonov. Rospatent greatly appreciated that delegations had found an opportunity to attend this Moscow session of the Meeting hosted by Rospatent. At the same time, she wished to express Rospatent's profound sympathy and condolences to the delegation of Japan on the occasion of the tragedy which had befallen Japan. She further expressed Rospatent's sincere thanks to the World Intellectual Property Organization for supporting the idea of organizing this session in Moscow.
6. Ms. Kiriy further stated that the Russian Federation always considered the Patent Cooperation Treaty as one of the major international tools within the international patent system. The Russian Federation was among the first countries to sign the PCT Treaty. Rospatent had always made great efforts to comply with the PCT requirements, in particular those applicable to International Authorities. Today, Rospatent acted as International Searching and Preliminary Examining Authority for more than twenty countries. It paid great attention to harmonizing its applicable national law with the PCT legal framework. Provisions of the PCT Treaty, the Regulations, the Administrative Instructions and the Guidelines had been implemented in national legislative norms. Rospatent had built its national search system covering patent documentation beyond the PCT Minimum Documentation. It had improved its quality management system so as to comply with the requirements of the Chapter 21 of the PCT Search and Examination Guidelines.
7. She expressed the view that the PCT system had become more and more popular with applicants from the Russian Federation. Rospatent hoped that, with the economic recovery of the Russian Federation, the number of applicants using the PCT route would further increase. To that end, Rospatent had undertaken to invest a great deal of resources in the education and training for applicants and patent attorneys. Rospatent highly appreciated the latest developments in the PCT system, notably the increasing efforts to improve the quality of international search and examination reports, to enhance mutual trust towards in PCT work products, to simplify the PCT system and to make it more attractive for applicants. It welcomed the recent trend towards establishing closer links between the PCT system and the various PPH programs, enabling applicants to request PPH acceleration of their international applications after national phase entry on the basis of the international work products. In this context, Rospatent noted with satisfaction that the agenda of the present session contained many items aimed at further improving the PCT system and enhancing confidence in its work products. In Rospatent's opinion, confidence in the high quality of international search and examination reports was essential for the effective use of those reports to assist in reducing costs, workload and unnecessary duplication of work, and increasing the quality of granted patents.
8. The session was chaired by Mr. Zaurbek Albegonov of the Federal Service for Intellectual Property, Patents and Trademarks of the Russian Federation (Rospatent).

PCT STATISTICS

9. The International Bureau made a presentation on the PCT statistics in 2010. In 2010, an estimated 162,900 PCT applications had been filed, representing an increase of 4.8% compared to 2009, representing a return almost to the 2008 level. The strongest growth originated from China (+56.2%). The Republic of Korea (+20.5%) and Japan (+7.9%) also experienced significant growth. European countries showed mixed performance, including Germany (+2.2%), Spain (+10.3%), France (-0.6%), United Kingdom (-3.7%) and the Netherlands (-8.2%). Filings from the United States of America experienced continued

decline (-1.7%), though applicants from this country remained the largest group of users of the PCT system. In 2009, an estimated 450,000 PCT national phase entries had been filed at patent Offices worldwide, representing a decrease of 3.0% over 2008. These accounted for about 56% of total patent applications filed abroad. In terms of the number of issued international search reports and international preliminary examination reports, the European Patent Office remained the most selected International Authority in 2010. Timeliness remained a cause for concern. In 2010, only about 64.3% of international search reports were established within 16 months from the priority date, and the proportion of IPRP transmitted after 32 months increased.

QUALITY FRAMEWORK: REPORT AND RECOMMENDATIONS FROM THE QUALITY SUBGROUP

10. Discussions were based on document PCT/MIA/18/2.
11. The Meeting:
 - (a) noted with approval the report of the quality subgroup set out in the Annex to document PCT/MIA/18/2;
 - (b) approved the continuation of the subgroup's mandate and requested it to report to the next session of the Meeting on the subjects of:
 - (i) effective processes and solutions for quality assurance; and
 - (ii) effective quality improvement measures,taking into account the comments in paragraphs 12 to 18, below, and any new information presented to the subgroup in the meantime, including the updating of International Authorities' reports on quality management systems which would take place in the second half of 2011;
 - (c) agreed that the annual reports submitted by the International Authorities should be made publicly available on WIPO's website; and
 - (d) agreed that the International Bureau should submit a report to the PCT Assembly on the work undertaken in relation to the quality framework, including a reference to the annual reports and annexes comprising the report from the quality subgroup as set out in document PCT/MIA/18/2 and the relevant section of this report.
12. Several Authorities stated that they had found the process of analysis and discussion of the reports to be extremely useful. Effective quality management procedures were felt to be important for the future of the PCT system. It was very beneficial for Authorities to recognize areas where they did not fully comply with the requirements of the quality framework and exchanging information helped to identify opportunities for improvement.
13. The Authorities which had sent representatives to the physical quality subgroup meeting hosted by the Swedish Patent and Registration Office in Stockholm from December 2 to 3, 2010, confirmed that the discussions had been very useful and made a great contribution to the successful discussions using the electronic forum. Face to face discussions had permitted in-depth consideration of issues where there had not previously been sufficient understanding and had been a key factor in organizing and promoting the activities which had taken place after the meeting. Consequently, despite the wish to minimize costs, it

was felt that some physical meetings would be important in the future to support the work carried out using the subgroup's electronic forum.

14. Further to the information set out in the Annex to document PCT/MIA/18/2, it was noted that the Authorities had concluded that, in some respects, neither the templates which had been agreed for reports nor the quality framework itself were sufficiently clear to achieve a common understanding in all areas and that the reports had provided significantly different levels of detail in some areas. There was room for further improvement in both, which might well form part of the recommendations of the subgroup to the next session of the Meeting. One Authority expressed concerns about the possible nature of such changes, noting that the templates were already fairly detailed and required a significant effort to collect and present the necessary information. It was hoped that any changes would be of the nature of improvements to clarity rather than necessarily requiring an increased level of detail.
15. One Authority stated that it had found the detailed tables which had been put together by the subgroup to assist its analysis work to be extremely useful.
16. Other issues which required further analysis included greater harmonization of checklists for use in quality management processes and consideration of the appropriate ways to deal with non-conformities with the requirements of the quality framework.
17. Several Authorities expressed their concern over the fact that the revised version of Chapter 21 of the PCT International Search and Examination Guidelines, on which the annual reports were based, had not yet been officially promulgated. The International Bureau confirmed that this was a priority and that the necessary consultation with other Contracting States should be undertaken as soon as possible.
18. Noting the wide range of meetings already scheduled for 2011 in various fora with an interest in various aspects of patent quality, it was concluded that the best timing for a further physical meeting of the quality subgroup would probably be in early 2012, following the submission and initial analysis of the annual update to quality reports by International Authorities. This would allow the meeting to finalize any proposals for improvements to the quality framework and reporting templates based on the additional experience gained from the further reports. It was also emphasized that, in addition to the procedural aspects of quality management which had been the main focus of discussions up to this point, the meeting should also address the question of effective quality improvement measures, notably the development of quality metrics. In this context, it was noted that some details of national quality metrics had been provided by some Authorities as a starting point for discussions in this area.

THE FUTURE OF THE PCT

Recommendations Endorsed by the Working Group Relating to Quality

19. Discussions were based on document PCT/MIA/18/3.
20. In response to a comment by one Authority, the International Bureau acknowledged the late publication of the documents for the Meeting and stated that improved timeliness of meeting documents by the International Bureau generally was an important objective for the coming year. The International Bureau hoped that Offices and Member States would also attempt to provide their documents as early as possible to allow them to be properly considered by all delegations before meetings began.

21. The Meeting did not consider under this agenda item the issues set out in paragraphs 14, 16, 20 and 24 of the Annex to document PCT/MIA/18/3, noting that they were the subject of more detailed consideration under other agenda items during the session.

Content of Written Opinions

22. In relation to the appropriate content of written opinions and international preliminary reports on patentability (paragraphs 4 and 5 of the Annex to document PCT/MIA/18/3), the Meeting agreed that the International Bureau should await responses to Circular C. PCT 1295 to see whether any detailed proposals for changes to the content of reports would be received from designated Offices aimed at making those reports more useful for assisting the process of national search and examination. The International Bureau should then prepare a Circular containing proposals for improvements to the International Search and Preliminary Examination Guidelines and, possibly, preliminary proposals for changes to the PCT Regulations based on any such responses from designated Offices and on the comments below. Consideration could also be given to providing an electronic forum to assist any discussions.
23. The Meeting noted the relevance of the issues to be discussed in the context of documents PCT/MIA/18/8 and 9 (see paragraphs 59 to 68, below). Some Authorities noted that the box format of written opinions was not always conducive to the effective reporting of problems with clarity and sufficiency of disclosure. It was noted that the Meeting, in previous sessions, had been generally in favor of moving towards a linear format of written opinions, though it had not wished at the time to take forward the question of ensuring that sufficient consistency of format remained to allow users (especially those who were not native speakers of the language of the report) to identify and understand the types of content easily. It was suggested that this matter could be taken up in the context of the use of standardized clauses in reports, as proposed in document PCT/MIA/18/8.
24. The Meeting agreed that it was important that reports should always include significant issues of clarity and support for the claims and noted that most Authorities already instructed their examiners accordingly. There should remain flexibility, however, over the extent to which minor issues needed to be reported, especially where responses to other objections would necessarily result in major redrafting of the part of the application concerned, following which the minor issues would no longer be relevant. As an interim step, this matter should be clearly reflected in the PCT International Search and Preliminary Examination Guidelines. Inclusion of this requirement in PCT Rule 66 could be considered later as part of any broader package of changes which might be considered necessary. It was highly desirable that, if changes were to be made to Rule 66, they should all be made at the same time to reduce confusion over which version of the Rule was applicable to which international applications.
25. One Authority stressed the importance of ensuring that reports were equally valuable to all designated Offices. In particular, it was important that international searches should include details of patent applications falling into the category of PCT Rule 33.1(c) which might be relevant to inventive step in some States. It was observed, however, that the timing of the international search was such that the results could not be considered complete and there would always be a need for national phase top-up searches. A second issue raised was the importance of ensuring that the indication of any claims which had been cancelled as a result of amendments was filled in properly.

Sharing of National Reports and Other File Information

26. In relation to arrangements to access national phase search reports and other information which might assist national processing in other Offices (paragraphs 8 and 10 of the Annex to document PCT/MIA/18/3), it was noted that several Offices already provided online file inspection systems and that others were due to be launched shortly, including one from IP Australia and extensions to the availability of documents from the Spanish Patent and Trademark Office. It was observed that, in order for such systems to be useful to other Offices, it was essential that they should be kept fully up to date.

Increasing Diversity of Sources of Citations

27. In relation to addressing perceptions that the scope of a search conducted by one Authority might be too limited if the citations were predominantly patent documents published by that Authority in its capacity as a national or regional Office (paragraph 22 of the Annex to document PCT/MIA/18/3), it was pointed out that there were valid reasons why this would frequently be the case which did not in any way mean that the scope was actually limited. It was natural, when presented with a choice of equivalent documents, to select the version which was easiest for the examiner to access and assess. The most appropriate way of countering the perceptions might be to ensure that the scope of the search was properly documented. One Authority queried whether there had been any actual assessment of the extent to which Authorities did favor citation of their own publications over those from other sources.

Encouraging Efficient Use of the System

28. One Authority considered that its most effective action in encouraging efficient use of the system (paragraphs 25 and 30 of the Annex to document PCT/MIA/18/3) was the requirement for representatives before the Office to pass a rigorous examination. Other measures included information for small businesses and in seminars on the cost savings which could be achieved by early elimination of defects. Another Authority commented on the importance of regular meetings with user groups to discuss the relevant issues, as well as providing guidance on good drafting practice and effective systems to allow applicants to conduct effective searches prior to filing an application.
29. The rapidly increasing use of the Patent Prosecution Highway (PPH) in relation to international applications was noted. This arrangement was considered to be a good example of a way to encourage use of Chapter II to eliminate defects in an international application at an early stage.
30. In relation to offering further opportunities for dialog between the applicant and examiner in Chapter II (paragraph 29 of the Annex to document PCT/MIA/18/3), one Authority indicated that it would soon be formally announcing procedures whereby applicants would be guaranteed the opportunity of a second written opinion as part of its international preliminary examination procedures in cases where a proper response had been made to the written opinion of the International Searching Authority but matters had nevertheless been left outstanding.
31. Another Authority agreed that proper communication between applicants and examiners was important, but considered that additional written opinions, while remaining an option in certain cases, were not appropriate as a matter of course. Before that Authority, there was an absolute right to a personal interview with the examiner if requested in the demand, but this was rarely taken up. The ability to accept the written opinion of the International Searching Authority as if it were a written opinion of the International Preliminary Examining Authority was seen as a major achievement of the reforms of the PCT in recent years. Guaranteed rights to additional written opinions would go beyond what most Offices

offered in their national systems and would not necessarily result in improved quality of the international applications concerned.

Access to Effective Search Systems

32. It was noted that most of the Authorities were already involved in one way or another in improving access to the content of search systems. The Docupat project was noted as one further area in which WIPO and various Member States were working to capture additional information for the benefit of Offices.

Timeliness in the International Phase; Cost and Other Accessibility Issues; Consistency and Availability of Safeguards

33. Discussions were based on document PCT/MIA/18/4.
34. In introducing the document, the International Bureau proposed that the Meeting should focus its discussions on the “actions” set out in the Annex to document PCT/MIA/18/4 which were specifically addressed to International Authorities, notably, the issue of timeliness of international work products. It thanked those Authorities which had already replied to Circular C.PCT 1287 and encouraged those which had not yet done so to do so in time to enable the International Bureau to take those comments into account in its report to the PCT Working Group on the implementation of the recommendations on how to improve the functioning of the PCT system which had been endorsed by the Working Group. It stated that Offices which had already replied to Circular C.PCT 1287 had in particular reported on good experiences with “customer service charters” applicable to PCT services offered by Authorities (including commitments as to the timeliness of those services) and noted the importance of further looking into the issue of the timely transmission of search copies to International Searching Authorities.
35. One Authority stated that, while it fully supported the overall aim of improving the timeliness of international work products, it had some concerns as to the way in which the International Bureau measured timeliness of international search reports, noting that Authorities were required to establish those reports in “normal” cases within 3 months from the date of receipt of the search copy, rather than within 16 months from the priority date, the latter being the time limit on which the International Bureau based its statistics. This would no doubt contribute to the not so favorable timeliness statistics of some Authorities, given that often there were problems with the timely receipt of search copies, which were beyond the control of the Authority concerned. The Authority further stated that measures should be taken by the International Bureau to improve the communication to the International Searching Authority in case of missing search copies, in case of Rule 19.4 transfers and subsequent changes of competent receiving Offices, and in this context referred to its proposals as to the possible future design of the PCT operating in the electronic environment as set out in the non-paper submitted by it in relation to document PCT/MIA/18/14.
36. In response to the concerns expressed with regard to the basis of the International Bureau’s statistics on timeliness of international search reports, the Secretariat stated that it shared those concerns but noted that it was not in a position to move, as had been suggested, to “xx months from the date of receipt of the search copy” as the new measure for its statistics as it did not receive reliable information from all Authorities on the date of receipt of search copies.
37. With regard to “action 5” (“appropriate level of fees”), one Authority referred to the 75% fee reduction it granted to applicants from certain developing countries and noted that a national scheme under which subsidies were granted to national applications which

subsequently had been filed as international applications under the PCT had been a great success. With regard to “action 7” (improvements of online systems”), the Authority expressed its gratitude to the International Bureau for its translation into Spanish of a great number of informational material on the PCT system, to the benefit of Spanish speaking users. With regard to “action 8” (“withdrawal of notifications of incompatibility”), the Authority stated that it had just withdrawn one such notification and was in the process of reviewing another one which, if withdrawn, would leave the Office with no such notifications outstanding.

Recommendations Endorsed by the Working Group Relating to the Setting Up of a Third Party Observations System

38. Discussions were based on document PCT/MIA/18/5.
39. The Meeting welcomed and endorsed the proposals for a third party observations system on the understanding that the use of the observations in the national phase would be entirely at the discretion of designated Offices in accordance with their national laws and practices, and subject to the comments in the following paragraphs.
40. In response to comments expressing concern over the possibility of harassment of applicants by submission of large quantities of observations associated with different e-mail addresses, each of little or no additional relevance to any other, the International Bureau agreed to include a field to identify a “principal” on behalf of whom the observation was made and to closely observe patterns of actual use in order to identify ways of limiting observations to 10 cited documents per principal if such harassment should occur in practice.
41. It was suggested that, even if the person making the observations requested their identity not to be included in the public record, this information should nevertheless be made available to designated Offices.
42. In response to concerns that non-patent literature citations as well as certain patent literature citations were frequently difficult for applicants and Offices to locate and thus that providing copies of any cited documents should be mandatory, the International Bureau recalled the need to respect copyright restrictions when forwarding documents but agreed to further review the proposals relating to the uploading of cited documents.
43. It was observed that 2000 characters for an explanation of relevance of a document was not really brief and that 500 might be a more suitable figure for English language explanations.
44. The International Bureau explained that the essence of amendments which would be proposed to the International Preliminary Search and Preliminary Examination Guidelines would be that, where observations were received before the issue of any particular report by an International Authority, the Authority should take the observations into account if this was practical. One Authority suggested that Chapter II written opinions and international preliminary reports on patentability should have a checkbox introduced to the form to indicate whether such observations had in fact been taken into account and that this might encourage third parties to make observations at an early stage.
45. One Authority considered that it ought to be possible to submit observations and responses by the applicant at later times than the 28 and 30 month time limits proposed in the document, subject to the understanding that they may or may not be acted upon by any particular designated Office. The International Bureau observed that these limits had been agreed by the PCT Working Group as appropriate at least for the outset, but that the

system would be set up so that time limits could be changed quickly and easily if there was agreement to do so.

46. The International Bureau confirmed that development of interfaces in all PCT languages of publication would be a high priority after initial testing and pilot use of the system had confirmed that the system which had been developed did in fact meet the needs of applicants, Offices and third parties.
47. Several Authorities emphasized the need for a review of the use of the system and costs involved. The International Bureau confirmed that this would take place, noting the need for several different types of review. There would need to be constant monitoring of use of the system in the early phases to assess level of use and any abusive use which might occur. Initial reports on this would be offered to Contracting States at an early opportunity, probably around a year from the system being opened for general use. An assessment of how useful the observations made through the system were to designated Offices, on the other hand, might need to wait 2 years or even longer in order that enough international applications on which observations had been made had actually reached the stage of national phase processing. The data from the system would be regarded as part of the file of the international applications involved and consequently would be kept for a much longer period, ensuring that it would be available for use in analyzing the costs and benefits involved.
48. Some concern was expressed about the length of the pilot which would be carried out. The International Bureau stated that it did not wish to limit the initial offering of the system from the outset either in time or in numbers of documents. The system was expected to be used in a relatively small proportion of applications and was unlikely to provide a burden on Offices. One Authority which offered an easy-to-use observations system in relation to its national patent processing observed that applicants' competitors did not have the time or inclination to routinely use the service. The International Bureau confirmed that, if monitoring of the system detected a potential problem, it would take any necessary action to address it including, if necessary, suspending the service while changes were made.
49. Facilities would be needed to allow applicants to handle the receipt of observations effectively. This might involve encouraging the provision of e-mail addresses to which observations could be forwarded or the use of the e-PCT private file inspection system arrangements, which the International Bureau would be launching soon.
50. Integration of machine translation into the system to assist the understanding of observations made in different languages would be useful at as early a stage as possible, as would the possibility for the third party to submit translations of cited prior art in addition to the original documents themselves.
51. One Authority noted that it would itself be launching a similar system for use with its own national and national phase applications, but that the system would permit a much broader range of observations to be made, including matters of clarity and sufficiency of disclosure. The International Bureau recalled that the PCT Working Group had specifically decided that the initial version of the PCT third party observations system should be limited to matters of novelty and inventive step, but that the system would be designed to allow easy extension to a broader range of issues if and when the Contracting States agreed to their inclusion.

Recommendations Endorsed by the Working Group Relating to the Setting Up of a Quality Feedback System

52. Discussions were based on document PCT/MIA/18/6.
53. The Meeting generally endorsed the desire for a system for offering feedback from designated Offices to International Authorities, but several Authorities expressed major concerns over the detail of the proposal. Most notably, those Authorities considered that it was not appropriate for an Office to make public comments directly on the work of another Office. Moreover, the entry of individual new citations in such a system would not be an efficient way of bringing these citations to the attention of other Offices and the public. Consequently, it was considered that the feedback offered through this system should remain confidential and be accessible only to the Authority concerned. For additional citations, greater priority should be given to making national phase search reports easily available to other Offices.
54. One Authority emphasized that the system should encourage feedback to be seen by Offices in a positive light and help them to understand one another, rather than to introduce suspicion. No Office had perfect quality. This needed to be understood and improvements continually sought, rather than problems being hidden away.
55. The International Bureau concluded that it needed to review the proposals further. The most likely outcome seemed to be that the proposal in its current form would be withdrawn since, without the public citations element, the overlap in functionality with the third party observation system was very limited. One possible option to be explored would be to provide a feedback form which designated Offices could submit to International Authorities through the International Bureau using their existing PCT-EDI connections. This would have the benefit of overcoming the authentication issues referred to in paragraph 5 of the document. It would be open to any International Authority to automate the generation of such forms for its examiners if this seemed useful.

Collaborative Search and Examination Pilot Project – Report of Pilot Phase 1

56. Discussions were based on document PCT/MIA/18/7, containing a report by the European Patent Office (EPO) on a pilot project carried out by the United States Patent and Trademark Office, the Korean Intellectual Property Office and the EPO to test the concept of collaborative search and examination. In introducing the document, the European Patent Office gave further information on the objectives of the pilot phase 1 of the project, the project design, the methodology and the communication means used. It highlighted the very encouraging achievements, notably with regard to improvements to the quality of both international search reports and written opinions and with regard to the possibility of efficiency gains when considering the overall amount of investment in terms of time and resources spent by each participating Office as an Authority contributing to the collaborative search and as a designated Office processing the same application in the national phase. It further indicated that a second, larger phase pilot project would be launched in June 2011 and completed in 2012, on which it would be happy to report at future meetings.
57. The United States Patent and Trademark Office, as one of the Authorities which had participated in the pilot, stated that it indeed had been very encouraged by the results achieved in pilot phase 1 of the project, notably the potential for substantial efficiency gains for participating Authorities when processing the same application in the national phase in their roles as designated Offices. The Korean Intellectual Property Office as the other participating Authority stressed the importance of the timeliness of the collaborative search efforts, noting the challenge it would pose for the three Authorities involved in the pilot to

collaboratively produce a high quality report and written opinion within the short 3-months time frame available under the PCT.

58. All Authorities which took the floor on the matter thanked the participating Authorities for the very interesting and encouraging report. In response to the query by one Authority as to whether the Authorities participating in the pilot would be interested in obtaining feedback on the quality of the collaborative search reports by other designated Offices processing the same application in the national phase, the European Patent Office stated that, while this would certainly be envisaged in future stages of the project, current arrangements with applicants participating in the pilot prevented it from revealing to the public which search reports had been established collaboratively by several Authorities.

Standardized Clauses in PCT International Search and Preliminary Examination Reports

59. Discussions were based on document PCT/MIA/18/8, containing a proposal by the Canadian Intellectual Property Office to introduce standardized clauses for use by International Authorities when establishing international search reports, written opinions and international preliminary examination reports. In introducing its proposal, the Canadian Intellectual Property Office highlighted the potential benefits of the use of standardized clauses, which would contribute to improving the usefulness of those reports for designated Offices, notably for Offices whose main language was not English (noting that all reports, if not established in English, were translated into English by the International Bureau) and result in better explanations of objections, more consistent compliance with requirements of the Treaty with regard to the contents of reports, and more generally simplification of the presentation of reports.
60. All Authorities which took the floor on the matter expressed general sympathy for the idea to introduce standardized clauses and supported further exploration of the proposal, provided that the use of such standardized clauses was not made mandatory but remained optional for Authorities, leaving enough flexibility and discretion for Authorities to deviate from such clauses where their use was deemed not appropriate. Many Authorities stated that such standardized clauses were already used by their examiners when establishing both national and international search and examination reports, and offered to share those clauses with the other Authorities.
61. One Authority, supported by several others, expressed concerns as to the feasibility of the proposal, noting that many of the standardized clauses presently used by Authorities were aligned with national laws and practices and thus not easily to be standardized, at least not without major changes to those laws and practices, which it could not support at this point. It further questioned whether the use of such standardized clauses would impact the proposal to move to a linear format instead of the current "box format" for international reports.
62. The Meeting agreed that the International Bureau should consult with all Authorities, by way of a Circular, with a view to further refining the proposal before consulting on such further refined proposal more broadly with other Offices and users of the system. The Meeting further agreed that the Circular should invite Authorities to submit existing standardized clauses to the International Bureau so as to enable the International Bureau to establish whether there was sufficient common ground for moving forward with the proposal. In this context, the International Bureau offered to explore the possibility of arranging for the translation into English of those existing standardized clauses already in use by Authorities which were not in that language.

Search Strategy Information in PCT

63. Discussions were based on document PCT/MIA/18/9, containing a proposal by the Canadian Intellectual Property Office to improve the information available concerning the scope of an international search which had been conducted by enlarging the relevant box in the international search report and providing details of the scope of the search and, where relevant, the reasons for cutting a search short. In introducing its proposal, the representative of the Canadian Intellectual Property Office expressed the view that this could help to address the concerns which had been raised about the quality of international searches. This type of information was already held by most International Searching Authorities on the international application file, but did not appear in the international search report, in part because of limitations of the form.
64. Most Authorities which took the floor on the matter were supportive of the general concept underlying the proposal, recognizing that it could improve confidence in the quality of the search. However, while some Authorities were strongly supportive and considered that the proposal could be implemented subject only to further consideration of relatively minor issues of form, other Authorities considered that major practical barriers remained which would probably take a long time to resolve. The United States Patent and Trademark Office observed that its PCT search strategies were already available online from the date of international publication through its Public PAIR system.
65. The largest issues were seen to be:
 - (a) the amount of examiner time which would be involved in preparing explanations of the scope of the search of the type shown in the examples, independent of the particular system used to perform the search; and
 - (b) the diversity of methods used for recording searches, which would greatly limit the extent to which the information could be understood or used by applicants or examiners from different Offices.
66. In addition, significant IT investment would be needed by International Authorities to change their processes to provide this information and would need to be justified. Several Authorities expressed the view that there were limited benefits to be derived from the availability of search strategies unless sufficient consistency was achieved in the format of the information: those Authorities stated that they thus were unlikely to justify either the additional burden on examiners or the IT development costs involved.
67. On the other hand, the particular arrangements shown in the examples in the document were seen as particularly useful by one Authority because the search strategy was reflected in normal language rather than as a specialized database query. This made the information more accessible and easier to understand. Another Authority stated that the actual search query would usually be more useful, even though it might sometimes be difficult for the applicant or general public to properly understand such a query.
68. The Meeting agreed that further consideration of this subject would be useful. The quality subgroup was suggested as a body to consider the issues, but while it was noted that some aspects of recording search strategy certainly fell within its mandate, one Authority felt that it was not the proper body to consider the full breadth of this issue. The Meeting agreed that the Canadian Intellectual Property Office should discuss the issues further with other Offices, noting that related work was going on in other fora which should be taken into account, and prepare revised proposals which seek to address the concerns of International Authorities.

SUPPLEMENTARY INTERNATIONAL SEARCH

69. Discussions were based on document PCT/MIA/18/10.
70. Several Authorities which took the floor on the matter expressed their disappointment on the low uptake of the system by users, noting the economic downturn in 2008 and 2009 as one possible contributing factor, in addition to the possible reasons stated in the document.
71. One Authority stated that it offered supplementary international searches for a fee set at about 70% of the fee it charged for the main search and, as a result, had attracted the vast majority of requests for supplementary searches filed to date, and wondered whether there was a need for a review of the level of fees set by other Authorities offering the service. In this context, the Authority noted that it had received a substantial number of requests for supplementary searches in cases where the main international search report had not been received by it, forcing it to carry out a full second search for a reduced supplementary search fee; to address this issue, it was considering to change its fee structure so as to allow it to charge a supplementary search fee identical to the fee it charged for the main search where the main international search report was not available to it when it commenced the supplementary search.
72. One Authority, noting that the very low uptake made it impossible to draw meaningful conclusions as to the reasons why applicants opted or did not opt for the service, suggested that the International Bureau should carry out a survey to obtain detailed feedback from the user community, and indicated that it would do the same with its own user community.
73. One Authority expressed the view that one of the main reasons for the low uptake of the supplementary search system was that the system did not address the real needs of applicants. It only added additional complexity and costs for applicants who, in any case, noting the non-binding nature of the international work products, had to face search and examination by designated Offices during national phase processing. It expressed the view that the system was not consistent with the PCT philosophy which foresaw only one high quality search by one Authority and a national phase procedure to supplement the international search by focusing on national documents which did not form part of the PCT minimum documentation. The introduction of that system in effect meant that national phase procedures had been advanced, causing the whole system to become more complicated and burdensome for applicants. The system further added to the workload of Authorities, bore the risk of duplication of work and contributed to legal uncertainty where the main search and the supplementary search produced contradictory results. Noting the level of fees, the Authority expressed the view that the system was accessible to big applicants only, but not to small and medium size enterprises and individual inventors, which was one of the main reasons for the low uptake of the system. From its point of view, there was a need to review the entire system, focusing on improving the usefulness of the international search and preliminary examination for all stakeholders, with just one search carried out as complete as possible and to the highest possible quality standard.
74. In response to the invitation by the Secretariat to those Authorities which to date did not offer supplementary international searches to indicate possible future plans to do so, the representatives from both IP Australia and the United States Patent and Trademark Office indicated that, while they fully supported the system, they had at this point no plans to offer the service in the near future.

PCT MINIMUM DOCUMENTATION

Definition and Extent of Patent Literature

75. Discussions were based on document PCT/MIA/18/11.
76. The International Bureau explained that the basic purpose of the proposal was to encourage national Offices to make their patent documentation available in a format which allowed it to be effectively included in International Authorities' search collections. The aim would be to extend the patent literature part of the PCT minimum documentation to be as close as practically possible to covering all technological disclosures made in patent publications in any country.
77. All Authorities which took the floor on the matter agreed that the proposals went in the right general direction, moving away from assumptions from a paper-based world and encouraging extension of the search databases which were available and thus improving quality. However, it was considered that further consideration was needed before it the proposals were ready to be taken forward. Some of the issues to be considered included:
- (a) whether the availability referred to in draft Rule 34.1(b) should extend to database providers or whether it was sufficient that the relevant documents be available to the International Authorities themselves;
 - (b) the definition of a patent family – since an extended patent family, including types of application such as a continuation-in-part, could contain additional material in later publications, it was important that the definition be sufficiently narrow as not to accidentally eliminate matter from the search which appeared in only certain members of the family;
 - (c) possible differences between the documentation which was available to all Offices to include in their search databases and what might be available in the specific systems of certain Offices;
 - (d) the detail of what information was considered mandatory and what should be optional – several Authorities considered that some of the bibliographic data referred to in paragraph 26(iii) of the document should be mandatory, especially the priority information which was essential to building family information databases;
 - (e) whether it was acceptable to extend the documentation without referring the matter to the PCT Assembly, to the Meeting of International Authorities or to a suitable alternative technical body for review;
 - (f) the appropriate forms of documents which could be accepted.
78. In relation to the questions of acceptable formats of documents, one Authority expressed the preference that documents be provided in ST.33 compliant TIFF format. Where full text documents were involved, it was preferred that the future ST.96 (XML4IP) format be considered in preference to ST.36 as being the desired basis for future work, though another Authority observed that the ST.96 standard had not yet been agreed. It was also suggested that PDF files might be commonly used and easier to handle and that some Authorities might wish to avoid using ZIP files. One Authority expressed the view that Offices should be allowed to continue to produce whatever formats they already used and should not be obliged to make costly changes to IT systems to comply with the standard decided.

79. The International Bureau explained that the options mentioned relating to format were not intended as a proposal as such, but as examples of the type of format which might be specified. The details should follow consultations with International Authorities over the formats which they would most easily be able to process. The International Bureau had no preferences in this matter, save that it was important to reach an agreement. The International Bureau saw it as an important feature of the proposal that Offices digitizing their patent collections should be able to work to a clearly defined standard whereby if they met the conditions, they would have absolute certainty that their documentation would be accepted as part of the minimum documentation, rather than performing the work only to be disappointed later on. Further consideration could be given to dealing with the question of Offices whose documentation was already accepted by International Authorities in a format which might not be consistent with the standard which was decided on. One example might be that the Assembly could take a decision to allow the inclusion of collections in any format where this was acceptable to all International Authorities, but that the specifically defined standard should be required in cases where an Office wished simply to make a notification that their documentation should be included.
80. One Authority observed the similarity of the proposal to a part of the proposals which had been considered by the Meeting at its 16th session in document PCT/MIA/16/7 and emphasized the need to review the issues which had prevented further action at that time.
81. The International Bureau stated that, while there seemed to be consensus to move ahead with a proposal along these general lines, the items where consensus was lacking were such that there seemed little prospect of being able to address the detailed issues sufficiently well to bring a completed proposal to the Working Group this year. Consequently, it would conduct further informal discussions with IT and documentation experts and request additional information, for example through Circulars, with the intention of revisiting the proposal the following year.

Addition of Chinese Patent Documentation

82. Discussions were based on document PCT/MIA/18/12 and 12 Add.1.
83. The representative of the State Intellectual Property Office of the People's Republic of China gave a presentation¹ setting out the importance which its patent documentation had assumed. The proportion of patent documentation from China had increased from 0.9% of the world total in 1985 to 18.2% in 2009 and a very large proportion of the applications were Chinese first filings. There was a large body of technical information developing which could not be found in any other country's patent documentation. Consequently, this was a very important collection. Furthermore, the Office had gone to great lengths to ensure that it was available in formats which could be used by other Offices and non-Chinese users, including providing English abstracts and machine translations. In 2010, there had been over 62 million visitors from outside China to the website giving access to the patent documentation.
84. The Meeting strongly welcomed the proposal to add the Chinese patent documentation to the PCT minimum documentation, emphasizing its importance to allowing a thorough search to be conducted and encouraged the Office to present a proposal to the PCT

¹ The presentation is available on the WIPO website at
http://www.wipo.int/meetings/en/details.jsp?meeting_code=pct/mia/18

Working Group including proposals as to the appropriate amendments to the PCT Regulations, taking into account the matters raised in the following paragraphs.

85. It was important for all International Authorities to be certain of the exact sources and formats of data so that they could test their ability to load it effectively. The Office should, if necessary, conduct bilateral discussions with the other Authorities to ensure that they had all the necessary information in time to recommend an appropriate date of entry into force as part of a proposal to the PCT Assembly, which needed to be submitted by July in order for it to be discussed at the September/October 2011 session of the Assembly.
86. The current definition of patent documentation excluded utility models from many other countries. The Authorities agreed the value of the Chinese utility models as a prior art collection, but believed that it should be considered as a second step, together with the possible inclusion of utility models from other countries.
87. In response to an expression of interest in receiving full text information in ST.96 (XML4IP) format, the Office stated that it would consider this once that standard had been finalized.

PCT SEQUENCE LISTING STANDARD

88. Discussions were based on document PCT/MIA/18/13.
89. A representative from the European Patent Office, noting that the Office acted as leader of the task force established by the CWS to prepare a recommendation on the establishment of a new XML WIPO sequence listing standard, stated that a first draft of a possible new standard had been posted on the task force's wiki just last week, with comments by task force members expected to be submitted by April 8. The task force's aim was to finalize its discussions by the end of June 2011 with a view to adopting a proposal at the CWS November 2011 meeting. The representative further stated that a software tool had been developed by the European Patent Office to support the new XML standard, for use by applicants and Offices, and that it was envisaged to make that tool available for applicants filing direct European patent applications as of April 2011; that tool could also, if so wished, be made available to applicants and Offices for use in respect of international applications, once the new WIPO XML sequence listing standard and a revised PCT sequence listing standard had been approved and implemented.
90. All Authorities which took the floor on the matter supported the proposal to review the relationship between the PCT Sequence Listing Standard and WIPO Standard St.25 (and any future WIPO XML sequence listing standard) with a view to establishing, on the one hand, a general "filing-route neutral" WIPO Standard (or Standards) on the presentation of sequence listings in national, regional and international applications (be they in text format or in the XML format) and, on the other hand, a PCT Standard dealing only with PCT-specific issues.
91. One Authority stated that, while it fully supported the development of a new XML sequence listing standard and the consequential modification of WIPO Standard ST.25 and of the PCT sequence listing standard, it wondered whether the envisaged time table for discussion and adoption of the envisaged new XML standard was overly ambitious. The substantive changes envisaged for WIPO Standard ST.25 and the PCT sequence listing standard required a thorough review and careful consideration. New software had to be developed for applicants to prepare and validate sequence submissions. Offices would need new software for internal validation of submissions, as well as modifications to internal handling systems. New stylesheets were required to render XML submissions readable by humans. Offices needed to change national and regional legal frameworks to ensure that only one standard was effective in a particular Office regardless of whether the

sequence listing was filed in a national, a regional or an international application. As undesirable as they might be, transitional provisions could most likely not be avoided; as a result of making substantive changes to WIPO Standard ST.25, a simple conversion to XML would not render an ST.25 sequence listing compliant with the new XML standard.

92. In response to a comment made by one Authority as to the need for stylesheets to make any XML sequence listing readable to humans, the representative of the European Patent Office as the CWS task force leader stated that such stylesheets had been prepared and had been posted on the CWS task force's WIKI in the form of an Annex to the main proposal for a new XML sequence listing standard.

PARAGRAPH AMENDMENT OF PCT APPLICATIONS

93. Discussions were based on document PCT/MIA/18/14.
94. The Meeting agreed that the way forward outlined in the document appeared an appropriate approach in order to achieve the benefits desired from XML processing and that the broad requirements indicated were correct, notably in respect of the types of document which would need to be generated, as set out in paragraph 8(d) of the document. One Authority expressed the hope that a standards-based approach could be taken to developing the tools which would be needed in order to reduce costs and increase benefits. Furthermore, while the Authority agreed that paragraph numbering should be seen as an administrative issue, it felt that, once a number had been applied to a paragraph, that number should not be changed.
95. The European Patent Office introduced an informal paper² outlining how the type of review involved could take the opportunity to introduce significant simplifications to the system by rethinking the processes of information flow and moving away from systems which simply mimicked paper processing. This did not need to involve any change to the legal framework or of the responsibilities of different Offices, but rather aimed at a more effective use of IT systems to replace processes with more modern ones which avoided the risk of confusion between the Offices which played different roles in the processing of the international application and eliminated unnecessary delays.
96. Several Authorities noted that they had not had sufficient opportunity to review the non-paper to make detailed comments but agreed that it would be useful to simplify processing when introducing the new systems which would necessarily be required: generally, it was felt that the EPO's paper, including the concept of a central "master file", was a good basis for further consideration of the possibilities.
97. The International Bureau stated that it would continue to work on the subject and would consult further with Offices in due course, most likely by means of a Circular.

TRANSFER OF SEARCH COPIES USING PCT-EDI

98. Discussions were based on document PCT/MIA/18/15.
99. All Authorities which took the floor on the matter generally supported the proposal to transmit the search copy and other documents necessary for international search to the

² Available on the WIPO website as Paper No. 1 at
http://www.wipo.int/meetings/en/details.jsp?meeting_code=pct/mia/18

International Searching Authority in electronic form via the International Bureau, using the receiving Office's and the International Authorities' existing EDI communication links to the International Bureau, subject to the following comments and suggestions.

100. One Authority stated that it fully supported the proposal, noting that it would fit into its own plans to automate receiving Office procedures by January 2012.
101. Several Authorities expressed a concern as to whether the existing EDI communication links complied with the necessary security requirements and wondered whether the International Bureau had carried out a security risk assessment of the EDI system.
102. Several Authorities expressed a preference for implementing the proposal in a way which would allow Authorities to receive search copies in electronic form via the International Bureau at the same time and together with all the other required documentation (such as translations) and information, notably on the payment of the search fee, rather than receiving first a copy of the record copy (as the search copy) and then later other required documents and fee payment related information. In this context, specific issues required further consideration, such as how to deal with *ex-officio* corrections by the receiving Office made subsequent to the transfer of the search copy to the Authority, how to handle sequence listings (which often were filed on physical data carriers such as DVD), how to deal with the transmission of the search copy to a second Authority which had become competent (for example, following a change of the competent receiving Office under Rule 19.4), whether bibliographic data were to be made available to the Authorities in XML format, how best to ensure a proper virus check prior to the submission of the documents to the Authority, and whether this new system was intended to be mandatory for all receiving Offices. One Authority suggested that this new approach could assist the International Bureau in checking whether the International Authority chosen by the applicant was indeed competent to carry out the international search, which at present was a problem in some cases.
103. Several Authorities which at present already received search copies from the International Bureau acting as a receiving Office via existing EDI links stated their full satisfaction with the system; security had never given cause for concern. One Authority, while generally supporting the proposal, expressed the view that the current EDI system needed to be improved prior to the implementation of the proposed transfer of search copies, referring to problems with regard to allowable document formats, the speed of data transmission, instability of the system and frequent changes of the system.
104. In response to the issues raised during the discussions, the International Bureau stated that security assessments had indeed been made of PCT-EDI. If there was nevertheless perceived to be a need for further review, the International Bureau would be willing to cooperate, though there had been no security issues with the EDI system in the past which would have given rise to concerns for the International Bureau, nor any of the many receiving Offices and International Authorities which already used that system at present. It needed to be recalled that the vast majority of record copies (which are identical in content and security concern to search copies) were today transferred by receiving Offices to the International Bureau via the existing EDI links, including by most, if not all, of the receiving Offices which also acted as International Authorities. Proper virus checks were standard procedure in that context. The International Bureau further confirmed that it was in a position to communicate to the Authorities the bibliographic data relating to international applications in XML format together with the search copies. As to the question which of the two options for implementation of the proposal was, from its perspective, the preferred option, the International Bureau stated that preliminary analysis suggested that it was much simpler to implement the proposal so that all the documents

required by the International Searching Authorities were automatically forwarded to that Authority in the order and at the time they were received by the International Bureau from the receiving Office, rather than holding them back, bundling them and sending them as a package only once all the required documentation and information, notably relating to search fee payment, had been received. This would provide additional benefits to International Searching Authorities in planning resource requirements by providing them with warning at the earliest opportunity of the searches which they would need to perform; it merely required Authorities to be aware that they may wish to wait until confirmation was received that the search fee had been paid before starting the search. On the other hand, if there was agreement by all Authorities to implement the latter option, the International Bureau was certainly in a position to implement that option, though it would be very reluctant to offer a mixed system where Authorities were permitted to select either system.

105. Noting the broad general support for the proposal, the International Bureau stated that it would further refine the proposal, taking into account the comments made and the concerns expressed, and consult with all Offices in their various PCT capacities (as receiving Offices and/or International Authorities) by way of a Circular.

FUTURE WORK

106. The Secretariat stated that the next session of the Meeting was expected to be held in early 2012. The Meeting was pleased to receive an offer by the representative of IP Australia to host the 2012 session of the Meeting in Australia.

[Annex follows]

ANNEX

LIST OF PARTICIPANTS

I. INTERNATIONAL AUTHORITIES

(in the English alphabetical order of their names)

AUSTRIAN PATENT OFFICE

Katharina FASTENBAUER (Mrs.), Head, Patent Support and PCT Department

BRAZILIAN NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY

Gisela APARECIDA SILVA NOGUEIRA (Ms.), Deputy Coordinator for PCT

Luiz Otávio BEAKLINI, Coordinator, Quality Coordination

CANADIAN INTELLECTUAL PROPERTY OFFICE

Kathleen MURPHY (Ms.), Program Manager, International

EGYPTIAN PATENT OFFICE, ACADEMY OF SCIENTIFIC RESEARCH AND TECHNOLOGY

Kamal Mohamed Abdel GAID (Eng.), Senior Technical Examiner

EUROPEAN PATENT OFFICE

Milena LONATI (Ms.), Principal Director Quality Management / Head of delegation

Hubert PLUGGE, Director Quality Management Support

Mark WEAVER, Director, Directorate 2.0.21, Practice and Procedure

Alfred SPIGARELLI, Director, DG1 Business Services

Camille BOGLIOLO, Lawyer International & Legal PCT Affairs

FEDERAL SERVICE FOR INTELLECTUAL PROPERTY, PATENTS AND TRADEMARKS OF
THE RUSSIAN FEDERATION (ROSPATENT)

Andrey ZHURAVLEV, Deputy Director, Federal Institute of Industrial Property

Gennady NEGULYAEV, Senior Researcher, Federal Institute of Industrial Property

Liudmila POPOVA (Ms.), Head, International Patent Cooperation Division, Federal Institute of Industrial Property

IP AUSTRALIA

Bob BARTRAM, Director, Patent Examination

ISRAEL PATENT OFFICE, MINISTRY OF JUSTICE

Michael BART, Head, PCT Division

JAPAN PATENT OFFICE

Masahiro HIRATSUKA, Director, Quality Management Office, Administrative Affairs Division

Tomoya YANAGISAWA, Deputy Director, Examination Standards Office, Administrative Affairs Division

Masafumi SHIMIZU, Assistant Director, Examination Standards Office, Administrative Affairs Division

KOREAN INTELLECTUAL PROPERTY OFFICE

SEONG Baekmoon, Senior Deputy Director, Patent Examination Support Division

JEON Hobeom, Deputy Director, International Application Division

NATIONAL BOARD OF PATENTS AND REGISTRATION OF FINLAND

Juha REKOLA, Development Director

Riitta LARJA (Ms.), Deputy Head of Division

NORDIC PATENT INSTITUTE

Grétar Ingi GRETARSSON, Vice-Director, Nordic Patent Institute

SPANISH PATENT AND TRADEMARK OFFICE

D. Javier VERA ROA, Director, Patents and Technological Information Department

D. Gerardo PENAS GARCIA, Advisor, Support Unit

STATE INTELLECTUAL PROPERTY OFFICE OF THE PEOPLE'S REPUBLIC OF CHINA

GAN Shaoning, Deputy Commissioner, SIPO

ZENG Zhihua, Director General, Patent Documentation Department, SIPO

YANG Xing, Director, Patent Examination Administration Department

WANG Wenbei (Ms.), Project Administrator, International Cooperation Department, SIPO

SWEDISH PATENT AND REGISTRATION OFFICE

Marie ERIKSSON (Ms.), Head of Legal Affairs, Patent Department

Måns MARKLUND, Quality Manager, Patent Department

UNITED STATES PATENT AND TRADEMARK OFFICE

Richard COLE, Senior PCT Legal Examiner, Office of PCT Legal Administration

Minna F. MOEZIE (Ms.), Attorney-Advisor, Office of Policy and External Affairs

Nikita ZHARINOV, Intellectual Property Specialist, US Embassy, Moscow

II. OFFICERS

Chair: Zaurbek ALBEGONOV, Acting Director, International Cooperation Department,
Federal Service for Intellectual Property, Patents and Trademarks of the
Russian Federation (Rospatent)

Secretary: Michael RICHARDSON (WIPO)

III. SECRETARIAT OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

Claus MATTHES, Director, PCT Business Development Division

Takashi YAMASHITA, Director, PCT International Cooperation Division

Michael RICHARDSON, Deputy Director, PCT Business Development Division

[End of Annex and of document]