

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

Twenty-Sixth Session
Cairo, February 13 to 14, 2019

PROMOTING LINKAGE BETWEEN THE INTERNATIONAL PHASE AND NATIONAL PHASE

Document prepared by the Japan Patent Office

BACKGROUND

1. Since the sixth session of the PCT Working Group was held in May 2013, the Japan Patent Office (JPO) has worked on advancing "linkage between the international phase and the national phase." In this regard, via the e-forum of the PCT Working Group, the JPO has invited other IP Offices to provide comments on useful measures and ideas for advancing the linkage. At the twenty-first to twenty-fifth sessions of the Meeting held between 2014 and 2018, there were discussions on the information provided by each Authority.

PROGRESS AT AND AFTER THE TWENTY-FIFTH SESSION OF THE MEETING

2. At the twenty-fifth session of the Meeting held on February 21 to 23, 2018, the JPO proposed modifying the PCT International Search and Preliminary Examination Guidelines (the ISPE Guidelines) (document PCT/MIA/25/3). At that session, it was agreed that the Japan Patent Office should work together with the International Bureau to incorporate the proposed modifications into the ISPE Guidelines (see paragraph 42 of PCT/MIA/25/13).

3. After that, Circular C. PCT 1535 was issued on March 9, 2018, proposing modifications to the ISPE Guidelines. In accordance with the proposal, the ISPE Guidelines were modified in July 2018. Although modifications were made to the ISPE Guidelines, they did not fully reflect the details that were discussed at the twenty-fifth session.

PROPOSAL

4. Considering the circumstance described above, the JPO proposes further modifications be made to the ISPE Guidelines.

I. CLARIFICATION OF THE ISPE GUIDELINES

5. Paragraph 17.50 of the ISPE Guidelines revised on July 1, 2017 provides that "If, in the opinion of the examiner, there are significant and pertinent issues as to the clarity of the claims, the description and the drawings, or the question whether the claims are fully supported by the description, observations should be made to the effect in Box No. VIII of the written opinion and/or examination report." However, paragraph 2.03 explains a secondary objective of the written opinion as "to identify whether there appear to be any defects in the form or contents of the international application, for example with regard to the clarity of the claims, the description, and the drawings, or whether the claims are fully supported by the description." This statement in paragraph 2.03 might cause a misunderstanding that the observations should always be made when there are issues as to the clarity or the support requirements, regardless of whether the issues are "significant and pertinent" or not.

6. Considering paragraphs 17.49 and 17.50 of the ISPE Guidelines which correspond to Rule 66.2(a)(iii) and (v) of the Regulations under the PCT, respectively, it is apparent that "defects in the form or contents" mean formal defects, for example, failure to comply with one or more of the requirements specified in Rules 5 to 11, not substantive defects as to the clarity or the support requirements. Therefore, it is considered to be inappropriate to state "clarity of the claims, the description, and the drawings, or whether the claims are fully supported by the description" as the example of "defects in the form or contents" in paragraph 2.03.

7. The JPO proposed, at the twenty-fourth session, modifying paragraph 2.03 of the ISPE Guidelines (i) to resolve a misunderstanding that all issues as to the clarity or the support requirements should be identified, regardless of whether the issues are "significant and pertinent" or not, and (ii) to amend the statement of "clarity of the claims, the description, and the drawings, or whether the claims are fully supported by the description" as the example of "defects in the form or contents."

8. "Failure to comply with one or more of the requirements specified in Rules 5 to 11" was described as the example of "defects in the form or contents" in the modification proposed at the twenty-fourth session of the Meeting. One Authority, however, showed a concern in a comment to Circular C. PCT 1535 issued on March 9, 2018. The Authority stated that the scope of the proposed changes went beyond the competence of the International Searching Authority (ISA) because the requirements specified in Rules 5 to 11 concern the matters belonging to the formal examination entrusted to the receiving Office or to the designated Office as well as the matters belonging to the international search. The Authority also suggested that the modified paragraph 2.03 of the ISPE Guidelines be discussed again at the twenty-sixth session of the Meeting.

9. Considering the concerns shown above, the JPO would like to propose a modified version of paragraph 2.03 of the ISPE Guidelines again, in the hopes that every Authority supports it.

Chapter 2

Overview of the International Search Stage

Objectives

2.01-2.02 [No change]

Rule 43bis

2.03 At the same time as establishing the international search report, the search examiner establishes a written opinion. The written opinion has the primary objective of formulating a preliminary and non-binding opinion on the questions of whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious) and to be industrially applicable. A secondary objective is to identify whether there appear to be any defects in the form or contents of the international application, ~~for example with regard to the clarity of the claims, the description, and the drawings, or whether the claims are fully supported by description, or any significant and pertinent issues as to the clarity of the claims, the description, and the drawings, or the question whether the claims are fully supported by the description.~~

2.04 [No change]

II. PROVIDING HIGH QUALITY AND EASY-TO-USE ISRS AND WRITTEN OPINIONS

10. Providing high quality and easy-to-use international search reports (ISRs) and written opinions is essential for improving predictability of patent acquisition for users and eliminating unnecessary duplication of work by Authorities and designated Offices (DOs).

11. Effective means need to be established that enhance the utilization of work products by ISAs and International Preliminary Examining Authorities (IPEAs). These include, but are not limited to, performing international searches in light of differences in patent laws among DOs or establishing ISRs that are easy to use by other Offices. International Authorities so far have been working together and have made ISPE Guidelines clearer in terms of indicating the corresponding part of a patent family document written in English (paragraph 15.69 of ISPE Guidelines) and conducting searches also on subject matter that is not considered patentable under national laws of some Offices (paragraph 9.02 of ISPE Guidelines).

12. Needless to say, each ISA at its own discretion can decide whether to adopt these means. On the other hand, it is hoped that each ISA will take a proactive stance to further improve usability and promote work sharing. Additionally, the most important work ethic is for examiners to realize that one aspect of their work is to enhance the utilization of work products by ISAs and IPEAs, by enhancing the quality of the international searches and to establish useful ISRs and written opinions that can be utilized in many other Offices. Furthermore, examiners always should continuously work under this ethic.

13. Therefore, we propose that paragraph 15.09 of the ISPE Guidelines be modified as provided below.

Chapter 15

The International Search

The Examiner

15.08 [No change]

Rule 43bis.1 (a)

15.09 The examiner is also required to provide a written opinion on novelty, inventive step and industrial applicability of the claimed invention at the same time as he establishes the international search report. The international search report and written opinion together serve to inform the International Preliminary Examining Authorities of the documents and arguments necessary to complete the relevant assessments themselves if a demand for international preliminary examination is made, as well as to inform the designated Offices for the purposes of their consideration of the application in the national phase (the written opinion being transmitted to them in the form of an international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty) if no international preliminary examination report is established under Chapter II of the Treaty). Consequently it is essential that the examiner is familiar with the requirements of examination. [In addition, it is most desirable that the examiner perform high-quality, international searches and furthermore establish worthwhile international search reports and written opinions that can be utilized in many designated Offices and elected Offices.](#)

III. OTHER PROPOSALS

14. For the sake of reference, any items that were discussed at the PCT/MIA or on the e-forum and which are not related to the additional modifications described above, are shown in the Annex of this document.

15. The Meeting is invited to consider the proposed modifications of the ISPE Guidelines in paragraphs 9 and 13 above, and whether any of the measures and ideas referred to in the Annex to this document can be stipulated in the Regulations under the PCT or the ISPE Guidelines.

[Annex follows]

SUMMARIES OF COMMENTS AND PROPOSALS POSTED ON THE E-FORUM

ISA MEASURES

Existing practices

(a-1) Taking into account earlier search (Rule 41): Each IP office has its unique rules.

(i) Even if examination on the earlier application has not yet begun, searches are conducted before the ISR is established (JP).

(ii) Amount of fees reimbursed: fixed amounts: (CA, IL, JP); amounts based on extent of usage: (RU).

(iii) Amount of fees reimbursed is based on the subject-matter claimed: Fees are reimbursed when the subject matter is the same (EP); fees are reimbursed when unity exists among the claims of the earlier application and the IA (JP).

Comments at PCT/MIA

- There is a need to clarify the method to specify the earlier application.
- There is no benefit in including this measure since hardly any applications would require it, since there are so few applications where the length of time from the time they are filed to the time the ISRs are established is short.
- We are against making this mandatory, since we are basically performing this same procedure already.
- Rule 41.1 should be broadly applied.

(a-2) In citing patent documents written in languages other than English, indicate the corresponding part of the patent family documents written in English, if a patent family document in the English language exists (JP).

Comments at PCT/MIA

- Although this may be beneficial, it creates more work. No need to make it mandatory.
- The patent family information by OPD is sufficient.
- At the twenty-second session, PCT/MIA agreed to advance the modification of the PCT International Search and Preliminary Examination Guidelines, in order that this measure be implemented based on the support by a number of Authorities. The JPO was urged to improve the proposal to implement the measure in the ISPE Guidelines.

Current Situation

- **This practice has been reflected in the ISPE Guidelines.**

(a-3) Obtain search information from the office of earlier examination (EP); or from other ROs (AU).

Comment at PCT/MIA

- Already implemented with regard to national applications.

(a-4) Utilize international-type search results for provisional applications, before the complete PCT applications are filed (CA).

(a-5) Provide the International Bureau and applicants search strategies, along with ISA & WOSA (IL).

(a-6) Clarify the determination on claims which include functional expressions by fully specifying the point determined to have novelty and inventive step when establishing a written opinion. For example, not describe that “the control unit which calculates X” is neither disclosed nor obvious but describe that the feature of the control unit to “calculate X” is neither disclosed nor obvious to highlight that the claimed invention is determined to have novelty and inventive step due to the functional expression (JP).

Proposals

(b-1) Prepare WO/ISAs and such reports using expressions that can be easily translated into English.

Comments at PCT/MIA

- Discussion about the Standard Clauses is sufficient.
- We cannot agree, since some information might be omitted as a result of simplifying descriptions.

(b-2) Detailed and clear description of reasoning in WO/ISA (EP).

(b-3) Clearly identify the scope of the search (in order to enable other IP offices to establish search strategies) (CA).

Comment at PCT/MIA

- This proposal seems to closely relate to measure (a-5).

Current Situation

- This issue has been discussed under agenda item “Better Understanding of Work of other Offices” at the Quality Subgroup Meeting.

(b-4) Conduct searches also on subject matter that is not considered patentable under one’s own national laws (CA, IL).

Comments at PCT/MIA

- Not only applicants but also the Contracting States may benefit from this.
- Additional databases are needed to conduct searches on subject matter that is excluded from patentability under national laws.

Current Situation

- This proposal has been reflected in the ISPE Guidelines.

(b-5) Timely establish search reports of such quality that the ISA itself will fully rely on that search when the PCT application enters the national phase (IL).

(b-6) Obtain search and classification information (KR) from other IP offices (RU).

- *Note: New Rule 23bis.2 that took effect from July 1, 2017 introduced "Transmittal of Documents Relating to Earlier Search or Classification for the Purposes of Rule 41.2".*

NATIONAL OFFICE MEASURES

Existing measures

(c-1) Reduce fees for the national phase if Chapter II was carried out by the same office in the national phase (AU, EP).

Comments at PCT/MIA

- We are already doing this (Same response by multiple IP offices).
- We have concerns/hesitations about adopting this measure.
- Fees are reduced at the national phase for applications determined to be patentable at the international phase. On the other hand, reducing fees based on Chapter II is inappropriate, since it would encourage users to utilize Chapter II for a different purpose from the original one.

(c-2) Assign the same examiners to conduct both the national and international phase examinations, to the maximum extent possible (AU, EP, IL, JP).

Comments at PCT/MIA

- We are already doing this (Same response by multiple IP offices).
- We are against making this mandatory, since it is not always possible.
- If the same examiners do both phases, they will not conduct additional searches at the national phase, except for top-up searches.

(c-3) The IP office carrying out the national phase examination limits national phase searches to documentation from specific countries such as one's own country, or in languages such as one's own, even when international phase work products by other IP offices are available (RU).

Comments at PCT/MIA

- This is interesting, in terms of reducing duplicate work. Some examiners already do this at their own discretion.
- I have concerns about making rules on search methods, including the scope of additional searches.

(c-4) Fees are reduced for applications when ISRs have been already issued. (CA, RU) The fees are further reduced if the ISR was issued by the same office as DO/EO (JP).

(c-5) Publish search reports in one's native language for all national phase applications, utilizing the International Search Report (AT).

(c-6) Utilize PCT-PPH (CA, IL).

Comments at PCT/MIA

- We support utilizing PCT-PPH (Same response by multiple IP offices)
- PCT-PPH is highly effective in encouraging applicants to overcome the reasons of refusals during the international phase prosecution.
- By increasing the number of offices participating in the PCT-PPH or by integrating the PPH and PCT systems, applicants will be encouraged to use Chapter II and amend claims as necessary at the international phase so as to make those claims patentable before entry into the national phase.

Current Situation

- This issue has been discussed at various forums, including those of the PCT/MIA.

Proposals

(d-1) In view of the fact that the patent family information described in the ISRs is not necessarily complete, create a system that adds to patent family information in documents cited in the ISRs, when the national phase is begun (JP).

Comment at PCT/MIA

- This proposal would be quite useful.

(d-2) Designated offices can require applicants to submit Chapter II reports in certain cases, such as when issues that have been pointed out in the international phase have not been resolved for all claims (BR).

(d-3) Make it mandatory to respond to negative opinions presented in the international phase, when entering the national phase. Apply sanctions against any cases of non-response (UK/US joint proposal). Mandatory only if national and international phases are conducted by the same IP office (EP etc. PCT/WG/6/24 paragraphs 95 to 101).

Comment at PCT/MIA

- IP Australia gave an update at the Meeting, commenting on a trial it had conducted. For the trial, applicants who were about to enter the national phase were invited to take into account the written opinions or international search and preliminary examination reports, before the national examination had actually started, and make amendments and/or provide comments on the opinions or reports. As a result of this invitation, the number of applications that applicants amended and/or commented on before national examination had begun, had doubled (see paragraph 37 of PCT/MIA/24/15).

(d-4) Develop a feedback system from designated office to ISA/IPEA on how the prior art cited in the ISRs are used in the national phase and the examination results in the national phase (JP, RU).

Comments at PCT/MIA

- The proposal could create a burden on the DOs, and some IP offices cannot do this because of their national laws. Examiner's written opinion on the IPER would be sufficient.
- The Canadian Intellectual Property Office reported on its experience of developing a feedback process through its collaboration in the Vancouver Group of Offices. One challenge was the volume of cases with ISA/CA and DO/GB. But, more importantly, the time lag between the international search and national phase examination sometimes resulted in the designated Office giving feedback on issues that had already been resolved by the International Searching Authority. The International Bureau reminded the Subgroup of the requirement for Offices to provide information about national phase entries from July 1, 2017. It also suggested that problems and experiences of other Offices could be discussed on the Subgroup electronic forum (see paragraphs 21 and 22 of Annex II of PCT/MIA/24/15).

HOW WORK PRODUCTS IN THE INTERNATIONAL PHASE AND SEARCH RESULTS BY OTHER OFFICES ARE USED

Existing practices

(e-1) Enable access to not only previous searches but also to prior examination reports and claim sets (CA).

Comments at PCT/MIA

- Preferably IB should provide an IT system that enables offices to submit their search results along with relevant claims and examination results.
- We support this idea, whose direction is the same as that of the global dossier, OPD, WIPO-CASE.

(e-2) Perform top up searches and expand classification for search subjects and like (AU).

(e-3) Suggest to those, whose earlier applications have already been filed in other countries and been granted patent rights, to conform the claims to the allowed claims in order to obtain a direct allowance (PH). An applicant is entitled by law to request that an application be allowed on the basis of a foreign patent with claims identical to those granted in the foreign country (Israel Patent Law Section 17 (c)) (IL).

(e-4) Provide automatic electronic access to documents cited by other offices for patent family applications (EP).

(e-5) Provide tool for finding similar applications from the same applicant and the prior art cited in such applications (EP).

(e-6) Examiners have to give due diligence to examination results by other IP offices, not just in the FA phase but throughout entire examination process, to ensure that foreign examination results considered are up to date (AU).

(e-7) Review applicability or relevance of decisions on search result, novelty, invention, requirement of description, and like made by other offices in light of their own laws and regulations (AU).

(e-8) Check the claims that were searched by the other office to see if the claims under examination are similar enough to rely on the results of earlier searches (AU).

(e-9) Review a previous search in conjunction with the corresponding examination report to fully understand the previous search (CA).

(e-10) In your own office, put to use information on appropriate classification and relative documents obtained from the results of other offices (PT).

WAY OF PROVIDING SEARCH AND EXAMINATION INFORMATION

Existing practices

(f-1) Search information containing a full history of the International Search including a listing of databases consulted (including the IPC categories where relevant), the steps undertaken in the search, the specific terms keyed into the search engines, any chemical structures or gene sequences if relevant, the documents viewed, and the examiners who conducted the search (AU).

(f-2) Electronically publish search strategy information (AU).

Proposals

(g-1) Require each IP office to submit search and examination results to WIPO, which will be the sole and central source of reference (e.g. WIPO-CASE) (AU, CA, IL).

Comment at PCT/MIA

- Global Dossier is intended to be linked to WIPO-CASE, thus it may help in achieving the objective.

(g-2) Indicate clearly the relevance of citations, novelty or inventive steps of claims, using category of documents or summary tables (AU).

(g-3) Document sharing among offices, as well as sharing best practices, contributes to improving the quality of patents (PT).

Comment at PCT/MIA

- The JPO and EPO informed that they have published their own PCT Guidelines at the twenty-third session of PCT/MIA (see paragraph 35 of PCT/MIA/23/14).

[End of Annex and of document]