

## **Patent Cooperation Treaty (PCT) Working Group**

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

### **MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT ON THE TWENTY-FOURTH SESSION**

*Document prepared by the International Bureau*

1. The Annex to this document sets out the Summary by the Chair of the twenty-fourth session of the Meeting of International Authorities under the Patent Cooperation Treaty (PCT/MIA), held in Reykjavík, Iceland from February 8 to 10, 2017. Annex II to this Summary by the Chair contains the Summary by the Chair of the seventh informal meeting of the PCT/MIA Quality Subgroup, which was held immediately prior to the Meeting of International Authorities in Reykjavík on February 6 and 7, 2017.

2. *The Working Group is invited to note the Summary by the Chair of the twenty-fourth session of the Meeting of International Authorities under the PCT (document PCT/MIA/24/15), reproduced in the Annex to this document.*

[Annex follows]

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

TWENTY-FOURTH SESSION, REYKJAVÍK, FEBRUARY 8 TO 10, 2017

SUMMARY BY THE CHAIR

*(noted by the Meeting; reproduced from document PCT/MIA/24/15)*

**INTRODUCTION**

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its twenty-fourth session in Reykjavík from February 8 to 10, 2017.
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 of the Russian Federation (Rospatent), the Finnish Patent and Registration Office, the Indian Patent Office, the Intellectual Property Office of Singapore, IP Australia, the Israel Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, the National Institute of Industrial Property of Chile, the Nordic Patent Institute, the Spanish Patent and Trademark Office, the State Intellectual Property Office of the People’s Republic of China, the Swedish Patent and Registration Office, the Turkish Patent and Trademark Office, the Ukrainian Intellectual Property Institute, the United States Patent and Trademark Office and the Visegrad Patent Institute.
3. The list of participants is contained in Annex I to this document.

**ITEM 1: OPENING OF THE SESSION**

4. Mr. John Sandage, Deputy Director General of WIPO, welcomed the participants on behalf of the Director General. In his opening remarks, he especially welcomed the President and other members of the Delegation of the Turkish Patent and Trademark Office who were attending the Meeting for the first time following appointment as an International Searching and Preliminary Examining Authority at the forty-eighth session of the PCT Assembly in October 2016. The Deputy Director General highlighted the landmark of the 3 millionth published PCT application that took place on February 2, 2017. The work of International Authorities to produce international work products to high standards was a cornerstone to the success of the PCT, making it the choice of applicants seeking patent protection internationally. At the time of this achievement, a memorandum by the Director General entitled “The PCT System – Overview and Possible Future Directions and Priorities” had been made available to provide “food for thought” on directions and priorities for future work in further improving the PCT System.
5. Mrs. Borghildur Erlingsdóttir, Chair of the Board of the Nordic Patent Institute and President of the Icelandic Patent Office, welcomed the participants on behalf of the Nordic Patent Institute. In her opening remarks, she underlined the importance of the International Authorities as the pillar in the PCT System. Mrs. Erlingsdóttir also explained the role of the Nordic Patent Institute in providing both international work under the PCT and commercial prior art searches for clients worldwide.
6. Professor Dr. Habip Asan, President of the Turkish Patent and Trademark Office, noted that this was the first time that the Office had attended the Meeting, following its appointment as an International Searching and Preliminary Examining Authority by the PCT Assembly at its forty-eighth session in October 2016. Dr. Asan thanked the Member States for their confidence in the Office performing its new functions, and the Korean Intellectual Property Office and the Spanish Patent and Trademark Office for their assistance in the process. Since the

appointment, several significant changes had occurred as a result of the adoption of a new industrial property law. The name of the Office had changed from the Turkish Patent Institute to the Turkish Patent and Trademark Office. The new law had enabled the hiring of an additional 50 patent examiners to further strengthen the capacity of the Office and its ability to provide service to the region. Patent grant procedures had been shortened and streamlined. Post-grant opposition procedures had been established to help ensure the quality of patents in force. Various procedural improvements were offered, such as re-establishment of rights. Ownership of inventions originating from universities was now given to universities themselves rather than the academics, with the academics receiving at least 30 per cent of the income generated from commercialization of the invention. . Special provisions had also been made for the right to use state-funded inventions by public institutions. Provisions on the disclosure of origin of inventions based on genetic resources had also been included.

## **ITEM 2: ELECTION OF A CHAIR**

7. The session was chaired by Mrs. Borghildur Erlingsdóttir, Chair of the Board of the Nordic Patent Institute.

## **ITEM 3: ADOPTION OF THE AGENDA**

8. The Meeting adopted the agenda as set out in document PCT/MIA/24/1 Rev.

## **ITEM 4: PCT STATISTICS**

9. The Meeting noted the presentation by the International Bureau on the most recent PCT statistics<sup>1</sup>.

## **ITEM 5: MATTERS ARISING FROM THE QUALITY SUBGROUP**

10. The Meeting noted with approval the Summary by the Chair of the Quality Subgroup set out in Annex II to this document, agreed with the recommendations contained in that Summary and approved the continuation of the Subgroup's mandate, including the convening of a physical meeting in 2018.

## **ITEM 6: PCT ONLINE SERVICES**

11. Discussions were based on document PCT/MIA/24/9.

12. All Authorities which took the floor broadly appreciated the recent developments of the PCT online services and generally agreed with the proposed priorities for further work by the International Bureau and International Authorities. ePCT offered numerous advantages for applicants, especially those geographically remote from their chosen receiving Office or International Authority. Several Authorities expressed appreciation for the International Bureau's cooperation in ensuring that the system was configured properly for their needs.

13. While most Authorities, in their role as receiving Office, had implemented or were in the course of implementing services to work with ePCT-filing, several Authorities noted that traditional filing clients, such as PCT-SAFE continued to be significantly used and remained important for certain parts of their applicant base, particularly in relation to issues arising from national security laws. On the other hand, one Authority indicated that its receiving Office had taken the decision to stop accepting international applications filed using PCT-SAFE. With carefully targeted communications and working closely with its major clients, providing telephone support and assistance with matters such as setting up accounts, the transition had been successful and now 80 per cent of its international applications were filed using ePCT-filing.

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<sup>1</sup> A copy of the presentation is available on the WIPO website at [http://www.wipo.int/meetings/en/doc\\_details.jsp?meeting\\_code=pct/mia/24\\_statistics](http://www.wipo.int/meetings/en/doc_details.jsp?meeting_code=pct/mia/24_statistics)

14. Several Authorities emphasized the importance of moving towards the use of XML formats for exchange of application bodies, file wrapper information, international search reports and written opinions and process information. Several Authorities were developing tools and processes for conversion of .docx files to Annex F XML and were cooperating among themselves and with the International Bureau to seek consistency and solve problems, including ones relating to page numbering. The European Patent Office indicated that it intended to propose modifications to Annex F to directly support filing in .docx format. This would offer various benefits, including overcoming some of the issues currently associated with accepting color drawings. One Authority noted that at present all electronic filing services encountered difficulties with the need to convert drawings to black and white TIFF files. One Authority noted especially the possibility of exchange and view of language-independent information as important.

15. Several Authorities expressed their interest in web services and one noted its active investigation of possibilities for using web services to allow ePCT services to underpin its new filing services.

16. Several Authorities considered that the ePCT reporting tools offered significant benefits. One Authority requested further reporting functions around outstanding Chapter II reports.

17. Several Authorities noted that they were using ePCT for most receiving Office functions, which was useful for them and appreciated by applicants. Some were also using ePCT for communications in their role as International Authorities. Cooperation was required in helping to deliver international search reports and written opinions effectively in XML format.

18. In general, most Offices which used ePCT browser-based services liked the system, but considered that more could be done in terms of training and information concerning new functionality for both Offices and applicants.

19. The Meeting:

- (a) noted the recent developments in PCT online services;
- (b) expressed satisfaction with the direction of future development;
- (c) indicated the need to consider carefully the planning of PCT-SAFE decommissioning and consult the receiving Offices for that purpose; and
- (d) noted the International Bureau's recommendations to International Authorities with regard to their activities and services to interact with the International Bureau's online services.

#### **ITEM 7: eSEARCHCOPY**

20. Discussions were based on documents PCT/MIA/24/7 and 10.

21. The International Bureau reported that, since the document had been prepared, 13 more pairs of receiving Offices and International Searching Authorities had either begun exchanging documents or had a definite start date assigned in addition to those which had been referred to in Annex I to document PCT/MIA/24/10.

22. The European Patent Office reported that its initial pilot of the eSearchCopy service with seven receiving Offices had been concluded successfully and had established an effective methodology which could be used for extending the service to additional receiving Offices. It was intended to have three groups of around four Offices joining the system over the course of 2017, with periods of two months dual running of eSearchCopy and paper transmissions to confirm that systems were working effectively before moving completely to eSearchCopy. Evaluations of the pilot had found improvements in timeliness and reductions in costs for both

receiving Offices and the European Patent Office as International Searching Authority. It was noted that the system assisted International Searching Authorities to make use of electronic bibliographic data from the receiving Office. The Office invited contacts from other Authorities who wished their receiving Office to send them search copies using eSearchCopy, noting that this would likely be for 2018, as the groups proposed for 2017 had already been filled.

23. Various Authorities noted that they were using eSearchCopy, in several cases in their roles as receiving Office as well as International Searching Authority. The experience had been good and the service was recommended to others. Problems remained with the quality of drawings in certain cases, but these were similar to those which were already encountered with transmission and scanning of paper search copies, rather than new ones. Support was indicated for the intended improvements to the service listed in Annex II to document PCT/MIA/24/10. One Authority considered that it was important to carefully evaluate the issues and processes relating to subsequently filed documents, where it was essential that information concerning changes should reach the International Searching Authority quickly.

24. One Authority observed that, in its role as receiving Office, all search copies being sent to other Offices as International Searching Authority were already sent electronically so transition to eSearchCopy was not a priority for that Authority itself, but it was open to discussion with Authorities who wished to change.

25. Several Authorities expressed their interest in the proposed “netting” pilot, noting that this had the potential for significant benefits, particularly when combined with eSearchCopy. However, there were significant financial and audit issues, so the proposal would need to be considered with great care.

26. The Meeting noted the contents of documents PCT/MIA/24/7 and 10.

#### **ITEM 8: EXTENSION OF APPOINTMENT OF INTERNATIONAL AUTHORITIES**

27. Discussions were based on document PCT/MIA/24/2.

28. Authorities recognized the importance of ensuring that the Committee for Technical Cooperation was able to proceed efficiently. This would involve:

- (a) careful drafting of application documents to ensure that they were clear and complete;
- (b) reading other Authorities’ applications as soon as possible after they were published and bringing areas of potential concern to their attention well in advance of the session so that responses could be considered, potentially issuing “Add.” documents to clarify significant points if necessary; and
- (c) ensuring that introductory interventions during the session were short and focused on the most important issues – the Committee should normally be able to assume that an existing Authority met the minimum requirements set out in PCT Rules 36 and 63 and that delegates had read the documents in advance to seek any clarifications which were needed of such matters.

29. Several Authorities noted that they intended to use the draft application form which had been discussed by the Quality Subgroup as the basis for their application and encouraged others to do likewise. Some Authorities had already sent draft versions of their applications, which the International Bureau would review as soon as possible.

30. Authorities agreed that it was desirable for reasons of transparency to maintain as much consistency as possible between the main bodies of the agreements between the International Bureau and International Authorities and to set out differences as clearly, completely and consistently as possible in the Annexes. This included clear statements of, or references to

agreements on limitations of scope or number of international applications for which an Authority is competent. The draft set out in the Annex was considered to be a good basis for a model agreement for all Authorities, noting that:

- (a) Authorities whose agreements were established in multiple languages might require a statement that each language was equally authentic;
- (b) some Authorities would require minor variations in the text for specific national reasons; and
- (c) it should be recognized that most text shown in the Annexes – especially, but not only that in square brackets – was intended as examples to guide drafting consistency. Omission or variation of texts within the annexes would be acceptable, provided that the result was consistent with the Authorities' obligations under the Treaty (including Rules and Administrative Instructions). The model did not include all possibilities within the Annexes, such as concerning the basis on which the Authority decides the extent to which refunds should be given in relation to earlier searches in respect of which had been provided.

31. The Meeting:

- (a) noted the specific dates which applied to the timetable which had been agreed by the PCT Working Group, as set out in paragraph 4 of document PCT/MIA/24/2;
- (b) noted the measures proposed in paragraph 10 of document PCT/MIA/24/2 for ensuring an efficient and useful session of the PCT/CTC; and
- (c) approved the model agreement set out in the Annex to document PCT/MIA/24/2 as the basis for bilateral discussions between the International Bureau and individual International Authorities, taking into account the issues set out in paragraph 30, above.

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

32. Discussions were based on document PCT/MIA/24/11.

33. The Japan Patent Office stated that the measure (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" had received broad support from Authorities at the Meeting in 2015 and wished for its adoption in the PCT International Search and Preliminary Examination Guidelines. To refer to the documents in English there were two options, Box C or the patent family index. The Japan Patent Office hoped that paragraph 15.69 and 16.82 should soon be modified. As for measure (b-4) "Conduct searches also on subject matter that is not considered patentable under one's own national patent laws", the Japan Patent Office already followed this practice in its international search procedure. The Japan Patent Office also proposed to modify the Guidelines to clarify that lack of clarity of claims, description and drawings, and lack of support of the claims was not an example of a "defect in the form and contents".

34. Authorities welcomed the initiative by the Japan Patent Office to strengthen the linkage between the international and national phase of the PCT. Authorities reiterated their support for measure (a-2) and also supported measure (b-4) provided that it would be optional for International Searching Authorities to search subject matter that was not considered patentable under their respective national laws.

35. Some Authorities supported the measure to clarify the International Search and Preliminary Examination Guidelines in paragraph 2.03. However, one Authority stated that the present wording in this paragraph had existed before the International Search Guidelines and International Preliminary Examination Guidelines had been merged, and had been part of the overview of international search. This Authority suggested modifying this paragraph to add the word “observation” before “significant and pertinent issues”, and add this term to the glossary to clarify the matter.

36. In relation to measure (c-6) “Utilize PCT-PPH”, two Authorities supported the initiative to integrate the Patent Prosecution Highway (PPH) into the PCT, which had been part of the PCT 20/20 proposal to the PCT Working Group by the United Kingdom and United States of America.

37. IP Australia updated the Meeting on the trial that it had started in 2016, under which the applicant entering the national phase was invited to take into account the written opinion or international search and preliminary examination report before starting national examination by making amendments and/or providing comments on the opinion or report. As a result of this invitation, the number of applications where amendments or comments had been made by the applicant before national examination had doubled.

38. The Meeting agreed that the Japan Patent Office should work together with the International Bureau to incorporate the proposed modifications to the PCT International Search and Preliminary Examination Guidelines in document PCT/MIA/24/11, taking into account the comments made in paragraphs 32 to 37, above. The Meeting confirmed that either Box C or the patent family Annex of Form PCT/ISA/210 could be used for indicating relevant parts of patent family members.

#### **ITEM 10: TRANSMITTAL OF THE COPIES OF DOCUMENTS CITED IN INTERNATIONAL SEARCH REPORTS OR INTERNATIONAL PRELIMINARY EXAMINATION REPORTS**

39. Discussions were based on documents PCT/MIA/24/8 and 8 Add.

40. Authorities agreed on the importance of ensuring that applicants and designated Offices were able to obtain copies of documents from the International Searching or Preliminary Examining Authority as required by PCT Rules 44.3 and 71.2 when they were not able to obtain them from other sources. Authorities agreed to review, correct and complete the relevant entries in the *PCT Applicant's Guide*. Several Authorities also made information available on their websites. One Authority suggested that further information might be appropriate, noting that it might not occur to a user in a designated Office to look for the information in the *PCT Applicant's Guide*.

41. Authorities noted the technical availability of a service for securely sharing copies of prior art documents with applicants and Offices through ePCT, but noted that even though this would not make the documents available to the public, there would still be copyright and contractual issues in regularly sharing documents that way. For some Authorities, it might be significant that PCT Rules 44.3 and 71.2 provided a basis for making documents available to applicants and designated Offices, but not to the International Bureau, which would also have access. In some cases, the technical limitations of document types which could be exchanged through ePCT and PCT-EDI might provide limitations since Authorities did not control the format of non-patent literature documents at source. One Authority noted that it had a technical service for exchanging such documents with certain other Offices (and could make it available to others), but in practice most designated Offices had adequate means of access to the majority of relevant non-patent literature documents, so the level of use was extremely low and did not justify technical work to develop new systems.

42. The Meeting recommended that all International Authorities should provide clear methods for applicants and designated Offices to obtain copies of cited documents and to ensure that the methods and costs were set out clearly in the *PCT Applicant's Guide*.

#### **ITEM 11: NUMBER OF WORDS IN ABSTRACTS AND FRONT PAGE DRAWINGS**

43. Discussions were based on document PCT/MIA/24/13.

44. All Authorities which took the floor agreed that, even though some did not themselves make significant use of the abstract in their own searches, it was important that abstracts were effective for their uses as both scanning tools and search material for those who did use them. Authorities noted that only the examiner at the International Searching Authority was in a position to judge the quality of an individual abstract. It was also emphasized that the recommended range of lengths was only a guideline, which it may be appropriate not to follow in individual cases. The needs of effective disclosure would vary between different fields of technology and between different individual cases.

45. Authorities further noted that it would be useful to expand the guidance in the International Search and Preliminary Examination Guidelines to include information concerning recommended lengths in different languages and also to consider whether further material from sources such as WIPO Standard ST.12 ("General Guidelines for the Preparation of Abstracts of Patent Documents") might be useful. The interplay between the relevant parts of the PCT Articles, Rules, Receiving Office Guidelines and International Search and Preliminary Examination Guidelines would need to be carefully considered. One Authority indicated that it would review its current instructions to examiners to prepare a text by modifying Claim 1 in the event that the abstract was unsuitable or missing and invited information from other Authorities on what approach they took in this situation. Another Authority confirmed that it considered that the text used in Claim 1 would often be too general to be useful as part of an abstract.

46. Authorities nevertheless considered that it was a duty of the applicant to provide a suitable abstract and significant revision of the abstract by the International Searching Authority should not become the normal case. However, this was difficult to enforce in view of the options open to the receiving Office and the International Searching Authority. The former could note defects in Form PCT/RO/106, but was not in a position to judge the substantive merits and the only sanction available for failure to comply was to treat the international application as withdrawn. The International Searching Authority was able to make observations in Box VII of the written opinion, amend the abstract and choose different drawings, but was not able to request anything of the applicant. In the case of the drawings, the applicant was not able to make amendments without demanding international preliminary examination, which would not in any case be reflected in the international application as published. One Authority noted that the applicant may have reasons for drafting an abstract in a particular way and might not wish the International Searching Authority to modify it.

47. Authorities agreed that there was probably limited scope for the receiving Office to become directly involved in ensuring the quality of the abstracts and there was no need to change the advice given in paragraph 147 of the Receiving Office Guidelines. However, receiving Offices might consider actions in relation to filing systems, such as providing word counts or machine translation systems to give a better indication to applicants of whether their abstracts fell within the normally recommended ranges.

48. In relation to drawings containing text, Authorities agreed that examiners should give better consideration to whether a figure selected to accompany an abstract would be readable when accompanied by translated text and reduced to fit on the front page. However, one Authority noted that such figures might still remain useful if delivered with sufficient resolution to be expanded effectively on-screen. It also noted that the possible case of being able to select



multiple figures to accompany the abstract needed to be taken into account. Authorities requested the International Bureau to seek ways to make the text of any drawings selected to accompany the abstract searchable.

49. In response to a question from the Korean Intellectual Property Office, the International Bureau indicated that it would be happy to work with that Office to verify and establish suitable equivalent ranges of number of words if the figures proposed did not appear appropriate.

50. The International Bureau emphasized that, even though the indicated period for response to Circular C. PCT 1486 had expired, it remained interested in responses to ensure that the needs of different types of user had been properly understood and to assist the identification of effective options to bring to the PCT Working Group for consideration. It particularly hoped to receive input from user groups, since so far feedback had been received only from Offices. One Authority suggested that users' views be sought by posing more specific questions on which method was desirable in order to address issues with abstracts and front page drawings.

51. The Meeting recommended that the International Bureau provide further information and proposals to the PCT Working Group, taking into account the above comments and any additional feedback from Offices and users.

## **ITEM 12: USE OF NATIONAL CLASSIFICATION SYMBOLS IN INTERNATIONAL APPLICATIONS**

52. Discussions were based on document PCT/MIA/24/12.

53. Authorities supported the proposal for International Searching Authorities with sufficient experience in using the Cooperative Patent Classification (CPC) symbols to transmit them to the International Bureau in XML format for inclusion in the PATENTSCOPE database. One

Authority indicated that it understood the term "sufficient experience" to mean that it would be sufficient for the International Searching Authority to utilize the CPC as part of their regular national classification process.

54. The European Patent Office stated that validation of the CPC symbols should be done at source before transmission to the International Bureau to improve the quality of data. In this regard, the European Patent Office provided a web service for other International Searching Authorities to validate the CPC symbols. Another Authority questioned whether the International Bureau had the resources to validate and correct the CPC symbols provided by the International Searching Authority.

55. One Authority stated that there could be value to adding national classification symbols on the front page of published international applications. This Authority, in its capacity as a designated Office, did not currently retrieve XML data from PATENTSCOPE. Moreover, in its capacity as an International Searching Authority, the Authority did not transmit international search reports to the International Bureau in XML, but it hoped to do so in the future. Another Authority stated that only International Patent Classification (IPC) symbols should be included on the front page of international patent applications.

56. The Korean Intellectual Property Office thanked Authorities for their comments on the document and stated that it would continue working with the International Bureau in preparation of the discussions at the PCT Working Group.

57. The Meeting noted the contents of document PCT/MIA/24/12.

## **ITEM 13: PCT COLLABORATIVE SEARCH AND EXAMINATION THIRD PILOT**

58. Discussions were based on document PCT/MIA/24/3.

59. The European Patent Office reported that further progress had been made by the pilot group since document PCT/MIA/24/3 had been prepared. Notably, it had been agreed at the second session of the pilot group (held on February 3 and 4, 2017), that “complex” applications (such as biotechnology cases and cases lacking unity of invention) should be permitted in the pilot and that applications in languages other than English should be permitted, though this would probably begin at a later stage. Effective evaluation was needed of the financial scheme, the adherence to timetables and procedures and the extent to which the collaboration affected the end results. Methodologies were under discussion, seeking ways of collecting data to measure as many aspects as possible automatically.

60. Authorities expressed their interest in this pilot and requested to be kept informed of results, particularly around costs for the additional Offices. One Authority recalled previous indications that it saw great potential for collaboration between Offices, and that it was conducting two bilateral pilots to evaluate different models of collaborative search and examination of national applications.

61. The Meeting noted the contents of document PCT/MIA/24/3.

#### **ITEM 14: PCT SEQUENCE LISTING STANDARD**

62. Discussions were based on documents PCT/MIA/24/6 and PCT/MIA/24/14.

63. The European Patent Office updated the Meeting on the work of the Sequence Listings Task Force. Some Offices participating in the Task Force had been undertaking user consultations on a revision of WIPO Standard ST.26, which was being prepared for adoption at the fifth session of the Committee on WIPO Standards (CWS), due to take place from May 29 to June 2, 2017. However, most of the recent work of the Task Force had focused on the transition from WIPO Standard ST.25 to WIPO Standard ST.26. The Task Force had recently met through a WebEx to discuss the responses to Circular C. PCT 1485/C. CWS 75. At this WebEx, the participants had expressed a preference for the reference date for the transition to ST.26 to be based on the international filing date, rather than the priority date of the international application, although responses to the Circular had mixed views on this issue. The European Patent Office therefore sought opinion on this matter from the Meeting. Meanwhile, the Task Force was clarifying considerations in the transformation of a sequence listing from ST.25 to ST.26, with a view to providing further information on any possible risk of adding matter in making the transformation, which it hoped would be extremely low.

64. The Japan Patent Office thanked the Task Force for taking into account its concerns over the transition to ST.26 by expressing willingness to accept January 1, 2022 as the earliest possible transition date. The United States Patent and Trademark Office added that it was in the process of evaluating the transition and hope to be able to inform the Task Force soon of the earliest date when it could move to ST.26.

65. Some Authorities supported the international filing date to be the date on which the transition from ST.25 to ST.26 should be based, adding that this would reduce the overlapping period of the two standards and simplify legal situations such as restoration of priority. One of these Authorities also added that the transition from ST.23 to ST.25 around 20 years ago had resulted in this Authority still being required to process a few applications filed with sequence listings in compliance with the earlier standard. One other Authority preferred the priority date to be the reference for the transition between ST.25 and ST.26.

66. On the subject of handling international applications filed on paper disclosing sequence listings, some Authorities supported the third option proposed in paragraph 21 of Circular C. PCT 1485/C. CWS 75. One Authority did not agree with this approach, as this could involve filing voluminous sequence listings on paper; instead, it wished for the applicant to be able to

file an international application on paper with the sequence listing in electronic form as a “mixed mode” filing. This could be useful in certain situations, such as where a power outage prevented a fully electronic filing to be performed.

67. In response to the idea of “mixed mode” filings, the International Bureau suggested that it might be more appropriate to deal with exceptions using flexibilities of the type presently available in Section 703 of the Administrative Instructions to deal with certain cases which were not in the required electronic form. Rather than having general provisions to deal with mixed mode filings, exceptional situations could be dealt with using these flexibilities. One Authority supported this rationale.

68. In response to a question from one Authority concerning modifications to PCT legal provisions to implement ST.26, particularly Annex C of the Administrative Instructions, the International Bureau informed the Meeting that it would prepare modifications when decisions had been taken over the transition, including the authoring and validation tool and how to deal with the more usual situations. At this stage, the main priority was for Offices to provide input to the International Bureau on the authoring and validation tool for sequence listings in ST.26.

69. The Meeting noted the contents of documents PCT/MIA/24/6 and PCT/MIA/24/14.

#### **ITEM 15: PCT MINIMUM DOCUMENTATION TASK FORCE: STATUS REPORT**

70. Discussions were based on document PCT/MIA/24/4.

71. The European Patent Office underlined the need to revise the definition of the PCT minimum documentation for two main reasons. First, the definition needed to take account of digitization of documents that were previously held as paper collections. Second, there might be less need to have documents or abstracts available in English since machine translation tools were readily available to understand the contents, where needed. The European Patent Office defined four objectives in line with the initial mandate and thanked the United States Patent and Trademark Office for offering to lead the fourth objective in the Task Force relating to non-patent literature and prior art databases, including those in the area of traditional knowledge. The European Patent Office looked forward to a successful conclusion of the task in 2019 in line with the proposed timetable.

72. Authorities stressed the importance of defining the criteria for inclusion in the PCT minimum documentation in a suitable way for the digital age, and thanked the European Patent Office for leading the Task Force and the United States Patent and Trademark Office for leading the objective relating to non-patent literature and prior art databases.

73. The Indian Patent Office looked forward to participating in the discussions on the Task Force electronic forum, particularly reviewing the criteria for including non-patent literature to take account of the variety of sources and formats of information beyond science and technology periodicals. The Indian Patent Office referred to active discussions taking place in the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore on the protection of traditional knowledge and indicated that it intended to share a revised draft of the access agreement with the Task Force, setting out proposals with regard to the inclusion of the Indian Traditional Knowledge Digital Library in the PCT minimum documentation.

74. The Meeting noted the contents of document PCT/MIA/24/4.

#### **ITEM 16: AUTHORITY FILE**

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

76. Authorities emphasized the importance of an Office establishing its Authority file to enable interested parties to assess the completeness of its published patent documents and encouraged participation in the Task Force to develop a proposal for a WIPO standard for Authority files.

77. One Authority referred to the work of the IP5 Offices in establishing their own Authority files. The Authority files of IP5 Offices were updated on an annual basis, but there were discussions on making more frequent updates in the future. This Authority encouraged other Authorities to prepare their own Authority file. In this regard, the Austrian Patent Office informed the Meeting that it was working with the European Patent Office to prepare its own Authority file.

78. The International Bureau echoed the comments of Authorities on the importance of Offices establishing an Authority file, which would ensure that searches were as effective as possible by sharing information on the availability of documents from their respective patent publications.

79. The Meeting noted the contents of document PCT/MIA/24/5.

#### **ITEM 17: FUTURE WORK**

80. The Meeting noted that the next session was expected to be convened in the first quarter of 2018, immediately following a meeting of the Quality Subgroup

[Annex I to document PCT/MIA/24/15, containing a list of participants is not reproduced here]

[Annex II (to document  
PCT/MIA/24/15) follows]

ANNEX II (to document PCT/MIA/24/15)

PCT/MIA QUALITY SUBGROUP, SEVENTH INFORMAL MEETING  
REYKJAVÍK, FEBRUARY 6 AND 7, 2017

SUMMARY BY THE CHAIR

## **OPENING OF THE SESSION**

1. Mrs. Lone Hartung, Director, Nordic Patent Institute, welcomed the participants to Iceland and gave a presentation on the Nordic Patent Institute. In addition to PCT international search and preliminary examination, patent examiners performing work of the Nordic Patent Institute performed different types of commercial prior art searches on request to clients worldwide.
2. The Secretariat informed the Subgroup about the memorandum by the Director General of WIPO entitled “The PCT System – Overview and Possible Future Directions and Priorities”, which had been published at the time of the publication of the 3 millionth international patent application on February 2, 2017. The memorandum suggested that the primary route to addressing the future challenges in the PCT System was through greater emphasis on the “Cooperation” element of the Treaty. This relied primarily on changes to behaviors and actions, rather than the legal framework. In particular, three of the five directions for the future proposed related to quality, which underpinned the entire PCT System.
3. Mr. Grétar Ingi Grétarsson, Vice-Director, Nordic Patent Institute, chaired the session.

## **1. QUALITY MANAGEMENT SYSTEMS**

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

(B) QUALITY MANAGEMENT SYSTEM AT THE CANADIAN INTELLECTUAL PROPERTY OFFICE

4. Authorities were content with the present system of reporting on the quality management systems and the compilation and summary provided by the International Bureau. Authorities found the reports of other Authorities useful to study and consider in the implementation of their quality management systems. Authorities also welcomed the presentation made by the Canadian Intellectual Property Office as a concrete example of the implementation of quality management in an International Authority.
5. To facilitate the reading of the QMS reports, one Authority suggested that Authorities should include a summary in the introduction of the report with all changes to their quality management system that had taken place since the previous report and other matters of likely interest.
6. Several Authorities noted their progress in moving from ISO 9001:2008 to ISO 9001:2015. One Authority explained the benefit of visualizing processes through charts compared to text, having used flow charts in preparing for the certification of this move, as well as in process development more generally. Process charts could therefore be useful in future reporting on quality management systems, provided they were presented in a way that could lead to meaningful comparisons. The Subgroup accepted the offer of the Swedish Patent and Registration Office to lead discussions through the electronic forum on how process charts could facilitate QMS reporting, beginning with an invitation for Authorities to share their process charts.

7. One Authority noted that the purpose of its quality management system was to support the promotion of innovation and to ensure that search and examination work was performed properly. It underlined the importance of objectivity and impartiality in reviewing quality management systems, and reported on development of examination guidance and quality information that it had undertaken in 2016.

8. The Subgroup recommended:

- (a) to continue reporting on existing Quality Management Systems using the present reporting mechanism, indicating changes from the previous report, but adding a summary in the introduction to the report, as proposed in paragraph 5, above;
- (b) that other Authorities could present an overview of their Quality Management System to future meetings of the Subgroup; and
- (c) that Authorities wishing to participate should share suitable examples of existing process charts used in their quality review procedures through the electronic forum of the Subgroup, with a view to exploring how these could improve reporting on quality management systems, as explained in paragraph 6, above.

#### (C) AUDITING OF THE QUALITY MANAGEMENT SYSTEMS OF INTERNATIONAL AUTHORITIES

9. Authorities supported the idea of a peer review procedure of quality management systems between Offices and looked forward to the feedback from the four Authorities that were participating in the pilot during the present meeting. However, several Authorities stressed that participating in the activity should be optional, based on an “opt in” procedure rather than “opt out” option. Further consideration was needed of certain details, including the arrangements to ensure confidentiality of the feedback, whether the activity should necessarily cover the entire system or could have sessions focused on particular aspects, as well as certain issues of terminology. The term “paired review” for the exercise was strongly preferred to “audit”. One of the IP5 Offices also suggested that it had ample opportunities to discuss quality with other IP5 Offices during the year and that it would be preferable to be paired with smaller Offices for the exercise. This Authority also suggested that each Office could have two reviewing Offices and review two other Offices. While supporting the idea of peer review, the Nordic Patent Institute indicated the practical difficulties of participation in the exercise at the physical meeting of the Subgroup since it had a quality expert in the three IP Offices of their Member States, and suggested videoconferencing could help in this regard. One Authority noted that full scale implementation might imply significant costs which should be assessed for both the participating Authorities and for the hosting Authority, which might need to provide additional facilities.

10. Four International Authorities reported on their participation in the paired review pilot: Canadian Intellectual Property Office, IP Australia, the Spanish Patent and Trademark Office and the Austrian Patent Office. Authorities were invited to sit in pairs and discuss Chapter 21 reports as per the methodology set out in the paper.

11. Afterwards, each Authority was invited to fill out a feedback form. A quick review of the feedback indicated that topics discussed included: client and user feedback, workflow management, QC/QA sampling, search recording and training. Overall the results were very positive with all Authorities reporting that the activity and information exchange was useful and that they planned to follow up with actions based upon this activity. All Authorities found that one hour was an acceptable time for the activity. The only area for improvement identified was improving the facilities for the discussions. Ideally, Authorities would select the time and facility for the discussion that best suited their preferences. All Authorities recommended that the activity be repeated at future meetings of the Quality Subgroup.

12. The Subgroup recommended that interested Authorities should perform a paired review of reports of Quality Management Systems at the next meeting. The International Bureau would include a deadline for Authorities to indicate their wish to participate in the review in the Circular requesting reports from Authorities for 2017.

(D) STRENGTHENING REQUIREMENTS FOR QUALITY MANAGEMENT SYSTEMS

13. Authorities supported stronger requirements for quality management systems and the changes to this effect proposed in Chapter 21 of the PCT International Search and Preliminary Examining Guidelines. While an Authority performed a self-assessment of its QMS, one Authority emphasized that amending “should” to “shall” would make a difference in quality management, since a defect in a requirement would be treated as a non-conformity rather than merely as a suggestion for improvement.

14. One Authority supported the changes but believed that other requirements could be further strengthened, with changes from “should” to “shall” in the second and third occurrence in paragraph 21.10, and for the requirements in paragraphs 21.19 and 21.24(i) to (iii) to be made mandatory. While these further changes were supported by some other Authorities, the Subgroup decided that the proposed changes set out in the Annex to the working paper would be a first step to strengthening the QMS requirements, leaving the possibility for further changes to be considered at a later stage.

15. One Authority preferred paragraph 21.10 to remain an optional requirement, since it was impossible for an Office to have an appropriate infrastructure to cater for all possible changes to workload, which could be extreme and unexpected. In response to this comment, another Authority stated that it viewed this requirement as needing to have a plan on how to manage changes in workload and have the resources to fulfil that plan, rather than needing to respond to all eventualities in the same way as a normal workload level.

16. One Authority provided drafting changes to paragraphs 21.08 and 21.12, which the Subgroup discussed and agreed to incorporate into the Guidelines in a modified version.

17. Authorities supported the proposal by the Secretariat to replace periodic reporting to the PCT Assembly on quality matters to reporting on an *ad hoc* basis on matters of likely interest to the broader PCT membership.

18. The Subgroup recommended that the International Bureau should issue a Circular to consult Offices in their capacity as a receiving Offices, International Searching and Preliminary Examining Authority and/or designated or elected Office, and organizations representing users of the PCT System on the changes proposed in the Annex to the paper, incorporating the drafting modifications referred to in paragraph 16, above.

19. The Subgroup recommended the removal of the requirement for annual reports on quality to be submitted to the PCT Assembly.

(E) USER FEEDBACK

(F) USER FEEDBACK AT THE EUROPEAN PATENT OFFICE

20. Authorities appreciated the presentation given by the European Patent Office on user feedback, which distinguished a variety of sources of metrics based and non-metrics based feedback. The different forms of feedback had various advantages and disadvantages but, in general, it was desirable to seek more quantifiable and structured forms of feedback where possible. In response to a question about feedback sources, the European Patent Office indicated that increasing the use of metrics in feedback was desirable. Two Authorities encouraged the greater sharing by all Authorities of user feedback, which could be of general interest to the Subgroup.

21. In terms of feedback between Offices, the Canadian Intellectual Property Office reported on its experience of developing a feedback process for its international work products from the United Kingdom Intellectual Property Office in its capacity as a designated Office 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.

22. 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 in analyzing cases across the lifetime of the pre-grant patent process could be discussed on the Subgroup electronic forum.

23. The Subgroup agreed to the suggestion of the International Bureau to open a discussion on the electronic forum of the Subgroup to share experiences of feedback across the lifetime of the pre-grant process.

#### (G) METRICS-BASED QUALITY MANAGEMENT IN PRACTICE AT THE EUROPEAN PATENT OFFICE

24. The European Patent Office gave a presentation on its metrics-based quality management processes. A variety of processes at various phases in the life of a patent application and post-grant, such as opposition, allowed data to be collected in a standard format and to be analyzed. This included a process review of around 6 per cent of applications following search and all applications prior to grant, as well as smaller volumes of very detailed quality audit. This information is used to prepare an annual quality report, which is discussed with Operations and refined to ensure that the issues were properly understood and could, where necessary, be acted on at an early stage. The final report is used as part of an annual cycle of setting objectives, implementing action plans, measuring performance, making recommendations and revising objectives for the following year. A key aspect of the overall report was that it brought together data from multiple sources to give a fuller view than could be achieved from any of the sources alone.

#### (H) QUALITY METRICS USED FOR QUALITY ASSURANCE AT THE SPANISH PATENT AND TRADEMARK OFFICE

25. The Spanish Patent and Trademark Office gave a presentation on quality metrics used for quality assurance. The quality management groups of each department held meetings every four months to monitor the state of the quality management system with data input from a variety of sources. Systems were provided to gather and analyze information from controls, checklists and revisions at various stages, many of which were conducted on all international applications. Performance was monitored against objectives in five service charters, including one for international search and preliminary examination. The systems put in place by the Office demonstrated that with proper consideration, quality was possible for all Offices and did not need to be a matter of quantity of work.

## **2. QUALITY METRICS**

### (A) CHARACTERISTICS OF INTERNATIONAL SEARCH REPORTS

26. Authorities expressed appreciation for the reports on characteristics of international search reports and found them to be valuable, primarily as a self-assessment tool. One Authority noted that the improved view of breakdowns by technical field together with the averages across all Authorities had been found particularly useful. One Authority noted that it was conducting similar analysis across its national search reports.



27. Authorities indicated that they would typically look first at the trends within their own Authority, but also note trends within other Authorities and consider whether there were reasons for differences. The findings could be fed back either into formal quality management processes or more directly to operational areas of the Authority. Comparisons with different Authorities had led to significant changes in practice, including the extent to which examiners would continue to seek additional prior art once good novelty citations had been found. However, in some cases it was difficult to determine what relevance a particular characteristic might have to quality processes. It was suggested that improved chart styles might assist interpretation.

28. One Authority noted that it was providing international search reports in XML format and that, if done more universally, this would greatly reduce the delay between establishing reports and being able to analyze trends in characteristics.

29. Some Authorities invited other Authorities to contact them informally if trends had been found for which no obvious reason could be seen. Such bilateral discussions could be beneficial to both sides.

30. Some Authorities invited the International Bureau to assist in bringing interesting trends to the attention of Authorities, either by conducting its own review of the characteristics or by automatically highlighting characteristics which differed by more than a specified amount. The International Bureau indicated that this would need more consideration. A manual review would have significant consequences for workload or timing of the release of the reports. An automated system would need the parameters to be considered very carefully, both in terms of whether differences should be from the average for all Authorities or from previous results for the individual Authority, as well as for how the deviation should be calculated, noting that normal statistical fluctuations of some of the characteristics could be very large for Authorities delivering small numbers of international search reports during a quarter.

31. Authorities emphasized that they remained interested in a number of further characteristics referred to in previous sessions, should the required data become available. This included especially a comparison of the citations made in the international phase with those used in the national phase. In addition, Authorities expressed interest in further characteristics, including the percentage of reports containing category X or Y citations in non-official languages and the percentage of search reports by the top applicants for a particular Authority. It was suggested that it would be useful to include details of the number of international search reports which had been established by the Authority in any particular quarter to give appropriate context to the figures. It was also suggested that the characteristics concerning “non-official languages” might be more generally useful as “citations in languages different from the language of the international application”. One Authority indicated that it could be difficult to interpret graphs with significant peaks and troughs and suggested looking into appropriate ways to show trends in these situations.

32. The Subgroup recommended that the International Bureau further investigate developing the reports on characteristics to provide improved views of the characteristics and breakdowns by technical field, if possible offering an interactive service, allowing Authorities to select from a variety of different views, for example, comparing equivalent characteristics between specified Offices or across different technical fields. Stacked bar charts should be considered for groups of characteristics which can be represented as a complete set of distinct options for the contents of an international search report.

#### (B) PCT METRICS – DEFINING NEEDS AND OBTAINING DATA

33. International Authorities expressed appreciation for the improved metrics which had become available over recent years, especially through the WIPO IP Statistics Data Center and ePCT reporting for Offices. Some Authorities called for further breakdown options with the Data Center (for example, dividing information by both the 35 fields of technology and by the country

of origin). In addition, the ePCT reporting could offer better reference guides on how to obtain the desired detailed reports. One Authority invited the International Bureau to provide improved information concerning the transmission of search copies.

34. In response to queries from a number of Authorities concerning a variety of situations where ePCT reporting would continue to show cases as outstanding for some time after they had in fact been dealt with by the Authority or receiving Office, the International Bureau indicated that it was aware of the problems and believed that suitable fixes had been identified. These should be deployed in the coming months.

35. Some Authorities welcomed suggestions that reports might be “pushed” to Offices by email, though one Authority indicated concern that it would not wish reports of the type generated by ePCT at present to be sent that way.

36. In response to a review of information available concerning unity of invention, one Authority stated that Box IV of the written opinion of the International Searching Authority could be used in a variety of different situations, which could lead to misinterpretation if not properly distinguished. Consequently, care needed to be exercised when sharing such data.

37. The Subgroup noted that the International Bureau would continue to develop its services for making available data. The International Bureau invited Authorities to continue to send suggestions for improvement at any time and to give priority to making available information from their Offices which would be needed to deliver more useful metrics for which the data was not presently available.

### **3. BETTER UNDERSTANDING OF WORK OF OTHER OFFICES**

#### **(A) STATUS UPDATE: PILOT PROGRAM ON SEARCH STRATEGIES AT THE EUROPEAN PATENT OFFICE**

38. The European Patent Office gave a status update on its pilot program on search strategies. The purpose of providing the search strategy sheet was to increase confidence in the search results in a manner which made it easy to find the most relevant information. A consultation with European users had found that the pilot approach met their needs. Consequently, it had been decided to extend the pilot to the end of 2017 and the European Patent Office renewed its invitation to other Authorities to join the pilot.

39. Several Authorities emphasized the importance of making search strategies available, while noting the issues of examiner time and IT systems which were involved in preparing them, as well as the varying needs of different potential target audiences. Other Authorities noted that they were making their search strategies available on PATENTSCOPE in other forms or were investigating technical arrangements to do so in the near future. One Authority noted that it was improving its search strategies to provide better information concerning classifications used in the future. Authorities invited the European Patent Office to continue to share further experience gained during the pilot.

40. In response to questions from Authorities, the European Patent Office indicated that the reason for providing this information on a separate sheet rather than within the international search report was that it was easier to fully automate the process that way and that it was an essential requirement to avoid additional manual burdens on examiners. This also allowed easier modifications during the pilot, which allowed for evolution and improvement.

#### **(B) EVALUATION OF DIFFERENT APPROACHES TO SHARING SEARCH STRATEGIES**

41. Several Authorities indicated that the three track approach to sharing search strategies had been running for two years and considered that it was time to survey a wide range of users, including designated Offices, on the different approaches.

42. One Authority noted that, within the three tracks, there were many variations. Before a survey could usefully be run it would be necessary to conduct a study, comparing concrete examples of all the different types of search strategy which were being made available, assessing how useful the information provided was, how easy it was to produce and how long it took users of different levels of expertise to decipher. This would help to define the appropriate questions and ensure that users were able to make meaningful comments. Another Authority considered that it was important to promote the existence of the search results to ensure that users had the necessary practical experience to be able to give informed views.

43. Authorities noted the different potential audiences. Some favored very simple indications of strategy, suitable for informing applicants who would typically not be experts in prior art search. Others considered designated Offices to be a particularly important target group, for which more detailed strategies would be important. The importance of being able to produce the strategy documents without additional examiner burden was again emphasized.

44. One Authority noted that it intended to make its own survey of users in the near future concerning the search strategies which it had been making available since 2013.

45. The International Bureau agreed that it was essential to ensure that any survey asked appropriate questions to users, who should have enough information to give an informed response. A variety of types of information would be needed, but it was important to make real progress towards a conclusion and not simply to revisit issues which had been discussed in detail in the past, such as differences in terminology, which did not necessarily need to be resolved at this stage.

46. The Subgroup recommended that the International Bureau open a discussion on the electronic forum concerning next steps, with a view to ensuring that the existing forms of search strategy were well understood, as well as the issues which a survey should aim to discover. A PCT Circular could be used for gathering further information if necessary.

#### (C) STANDARDIZED CLAUSES – IMPLEMENTATION AND EXPANSION

47. Several Authorities reported on their implementation of the standardized clauses. Authorities reaffirmed that the use of the clauses should be optional and left to the discretion of the examiner. Authorities that had implemented the standardized clauses were encouraged to report this on the electronic forum if they had not already done so.

48. Authorities that did not intend to use the standardized clauses welcomed their use by other Authorities. These Authorities usually had their own set of clauses, some of which were similar to the standardized clauses.

49. Authorities appreciated the availability of the clauses in French and Spanish. The State Intellectual Property Office of the People's Republic of China thanked the International Bureau for the efforts to make the clauses available in Chinese since the previous meeting and added that use of the clauses could help improve quality. In response to a query from the Egyptian Patent Office, the International Bureau indicated that it would be willing to translate the standardized clauses into Arabic.

50. Some Authorities made comments on the drafting of certain clauses. With this in mind, the International Bureau indicated that, before the invitation for final comments on the modified English version in the Annex to the paper presented to the meeting and the respective translations, Authorities could be invited to submit comments on the drafting through the electronic forum. These could then be taken into account in the implementation of a modified version of the clauses.

51. In response to a request by one Authority, the International Bureau indicated that it would be willing to explore the possibility of inserting the standardized clauses into the PCT International Search and Preliminary Examination Guidelines.

52. Several Authorities expressed interest in developing standardized clauses on lack of unity of invention. To begin this process, Authorities could begin posting the clauses currently used in this area at their Office.

53. The Subgroup recommended:

(a) that Authorities using the standardized clauses should continue to report on their implementation on the dedicated page of the Subgroup's electronic forum and share experiences of their uses;

(b) that Authorities should submit comments on the drafting of the standardized clauses on the electronic forum with a specified deadline, after which a modified set of standardized clauses would be proposed for comments with a view to implementation;

(c) that Authorities should share clauses in the area of unity of invention on the electronic forum to consider whether new standardized clauses could be made developed in this area; and

(d) that the International Bureau should investigate possibilities of making the standardized clauses more available, such as in the PCT International Search and Preliminary Examination Guidelines, as an option for Offices to use.

#### **4. QUALITY IMPROVEMENT MEASURES**

##### **(A) UNITY OF INVENTION**

54. Authorities appreciated the progress that had been made since the previous meeting on revising Chapter 10 of the PCT International Search and Preliminary Examination Guidelines.

55. Some Authorities were content for the International Bureau to consult on the revisions to Chapter 10 that were posted by IP Australia on the electronic forum during the previous year and had met with broad support by participants in the discussions. However, some other Authorities wished to post further comments. One of these Authorities added that it considered that parts of the Chapter 10 requirements were too strict and could be more flexible to examiners.

56. One Authority informed the Subgroup about the ongoing work on unity of invention in the Patent Harmonization Experts Panel (PHEP) among the IP5 Offices. This Authority was also undertaking its own work in parallel on how examiners could improve the quality of objections on lack of unity of invention, which would feed into the PHEP work and the proposed revisions.

57. One Authority underlined the impact on users of the PCT System on modifying practice in unity of invention, and stated that the user community should be consulted about any modifications to the PCT International Search and Preliminary Examining Guidelines on this matter.

58. The Subgroup recommended that Authorities should be provided with an opportunity to post further comments on the electronic forum within a specified deadline. The International Bureau would then issue a Circular during summer 2017 to consult Offices in their capacity as a receiving Office, International Searching and Preliminary Examining Authority and/or designated or elected Office, and organizations representing users of the PCT System on proposed modifications to Chapter 10 of the PCT International Search and Preliminary Examining Guidelines.

**(B) THE CANADIAN INTELLECTUAL PROPERTY OFFICE'S NON-ASCII CHARACTER DETECTOR PROGRAM**

59. Authorities appreciated the presentation made by the Canadian Intellectual Property Office. The European Patent Office agreed to provide a contact point to receive enquiries about the possibility to integrate the non-ASCII detector into the BiSSAP tool for authoring sequence listings in ST.25 format. As ST.26 is an XML-based Standard, the challenges are likely to be of a different nature.

**5. APPLICATION FORM FOR APPOINTMENT AS INTERNATIONAL SEARCHING OR PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT**

60. International Authorities confirmed their support in principle for an application form for use by Offices seeking appointment as an International Authority. Most Authorities broadly agreed with the content in the draft as presented, subject to issues of drafting and clarity on the extent to which variations would be acceptable. Several Authorities indicated that they would be using the draft form as the basis for their submissions to the PCT Committee for Technical Cooperation (PCT/CTC) in May 2017.

61. One Authority stated its preference that the form should be limited to issues directly related to the minimum requirements for appointment set out in PCT Rules 36 and 63, but that it could accept a more wide-ranging form, provided that it included language to make clear the difference between the minimum requirements and general background information, that some parts were optional and that the PCT/CTC should use the different types of information in different ways. Specifically, it was suggested that the final clause of the explanatory text at the beginning of the form be changed to a new sentence reading "They [the questions not relevant to the minimum requirements] may be omitted, varied or supplemented according to the particular circumstances of the Office and they are to be considered as mere information which could not be grounds to review as such."

62. The International Bureau stated that it did not believe that the members of the PCT/CTC could be limited in how they used the information supplied to them in reaching their decision on the advice to give to the Assembly, save that they should not give positive advice concerning an Office which did not meet the minimum requirements. However, it would work with the Authority to seek suitable words to distinguish the different natures of the various parts of the form.

63. A number of Authorities indicated that they would wish to maintain previous comments or make further comments on details of drafting. A number of Authorities suggested that "workload" might be a more appropriate term than "backlogs" in Part 6 of the form.

64. In response to concerns of a number of Authorities, the International Bureau emphasized that applicant Offices would always need to use their discretion and provide answers meeting the intentions behind the questions, rather than trying to provide information which was either impossible or clearly not relevant to their circumstances. For example, intergovernmental organizations consisting of a group of different national Offices would need to vary certain questions. Furthermore, the question concerning international applications filed at the receiving Office of a national Office which did not intend to act as an International Authority for its own applicants would clearly not be relevant information and should be omitted in that case, perhaps providing more relevant information concerning its target audience instead.

65. The Subgroup recommended that the International Bureau invite further comments on details of drafting of such an application form through the electronic forum for a period of around two weeks before seeking to establish a proposal to the PCT Working Group or Committee for Technical Cooperation.

## **6. OTHER IDEAS FOR QUALITY IMPROVEMENT**

66. Authorities considered that the format in this session had been useful, whereby a number of topics had been prepared in the electronic forum, leading up to a discussion during the session. A variety of areas were suggested for consideration for similar treatment over the coming year:

- (a) Issues concerning quality standards such as ISO 9001, including adapting quality management systems for external certification, resources which were required and issues in external audits.
- (b) Risk management.
- (c) Training methods and needs.
- (d) Analysis of how Chapter 21 relates to ISO 9001.
- (e) Effective methods for checking examiner work products.
- (f) PCT search timeliness and challenges and actions taken for improvement.

67. It was observed that several of these subjects could be grouped as sub-items of a general discussion around ISO 9001 issues.

68. The Subgroup recommended that a further session of the Subgroup be held in 2018.

69. The Subgroup recommended that the International Bureau create pages for discussion of the topics referred to in paragraph 66, above with a view to preparing areas for possible discussion at the next session and seeking Authorities to make presentations or provide papers to focus discussions.

[End of Annex and of document]