

Patent Cooperation Treaty (PCT) Working Group

Eleventh Session
Geneva, June 18 to 22, 2018

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT ON THE TWENTY-FIFTH SESSION

Document prepared by the International Bureau

1. The Annex to this document sets out the Summary by the Chair of the twenty-fifth session of the Meeting of International Authorities under the Patent Cooperation Treaty (PCT/MIA), held in Madrid, Spain from February 21 to 23, 2018. Annex II to this Summary by the Chair contains the Summary by the Chair of the eighth informal meeting of the PCT/MIA Quality Subgroup, which was held immediately prior to the Meeting of International Authorities in Madrid on February 19 and 20, 2018.

2. *The Working Group is invited to note the Summary by the Chair of the twenty-fifth session of the Meeting of International Authorities under the PCT (document PCT/MIA/25/13), reproduced in the Annex to this document.*

[Annex follows]

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

TWENTY-FIFTH SESSION, MADRID, FEBRUARY 21 TO 23, 2018

SUMMARY BY THE CHAIR

(noted by the Meeting; reproduced from document PCT/MIA/25/13)

INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its twenty-fifth session in Madrid from February 21 to 23, 2018.
2. The following International Searching and Preliminary Examining Authorities were represented at the session: the Austrian Patent Office, the Brazilian National Institute of Industrial Property, the Canadian Intellectual Property Office, the European Patent Office (EPO), the Federal Service for Intellectual Property of the Russian Federation (Rospatent), the Finnish Patent and Registration Office, the Indian Patent Office (IPO), the Intellectual Property Office of the Philippines, the Intellectual Property Office of Singapore, IP Australia, the Israel Patent Office, the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the National Institute of Industrial Property of Chile, the Nordic Patent Institute, the Spanish Patent and Trademark Office (SPTO), the State Intellectual Property Office of the People’s Republic of China, the Swedish Patent and Registration Office (PRV), the Turkish Patent and Trademark Office (TURKPATENT), the Ukrainian Intellectual Property Institute, the United States Patent and Trademark Office (USPTO) 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 and thanked the Spanish Patent and Trademark Office, which was hosting the Meeting for the first time. In his opening remarks, he especially welcomed the Delegation of the Intellectual Property Office of the Philippines which was attending its first Meeting of International Authorities following appointment as an International Searching and Preliminary Examining Authority at the forty-ninth session of the PCT Assembly in October 2017. The Deputy Director General also congratulated the Turkish Patent and Trademark Office, which started operations as an International Searching and Preliminary Examining Authority in March 2017.
5. The Deputy Director General referred to the use of Spanish in the PCT since it became the sixth PCT publication language in 1985, joining English, French, German, Japanese and Russian, which were the original five PCT publication languages. At the same time, patent documents in Spanish became part of the PCT minimum documentation. While Spain acceded to the PCT in 1989, becoming the first Spanish-speaking country to do so, it was only after the appointment of the Spanish Patent and Trademark Office as an International Searching Authority in 1993 that other Spanish-speaking countries joined the PCT. Today, the Spanish Patent and Trademark Office acted as a competent International Searching and Preliminary Examining Authority to all 13 Spanish-speaking countries in Latin America and the Caribbean that had acceded to the PCT. It was hoped that, in the near future, the filing of international applications through the Treaty would become an option to more Spanish-speaking patent applicants in this region.
6. The Deputy Director General also thanked the Spanish Patent and Trademark Office for its support in collaboration activities with WIPO in Latin America, notably through the Spain Funds-in-Trust. One example of this collaboration was the LATIPAT project together with the European Patent Office, providing access to patent information in Spanish and Portuguese from Latin American countries through a free database.

7. The Deputy Director General concluded by recalling that all appointments of International Authorities had been extended for the next 10 years by the PCT Assembly in 2017. It now fell to the Authorities to continue to improve their services. In this respect, he referred to the document by International Bureau on the Future of the PCT, which invited comments on how to improve the work of International Authorities to meet the needs of applicants and designated Offices who relied on high quality international search reports and written opinions to take decisions on the prosecution of patent applications and the granting of patent rights in their territory.

8. Mr. Pablo García-Manzano Jiménez de Andrade, Under-Secretary for Energy, Tourism and the Digital Agenda stated that it was a great privilege for Spain to host the twenty-fifth Meeting of International Authorities under the PCT. The protection of IP promoted innovation and technological development as a driver for economic growth. Referring to the mission of WIPO to lead the development of a balanced and effective international IP system that enables innovation and creativity for the benefit of all, the Under-Secretary underlined the need for the international patent system to achieve an optimal balance between the right holder and the general public by promoting competition, disseminating information and driving world economic growth. Having joined the PCT in 1989, the Spanish Patent and Trademark Office had been a reference to other IP Offices, especially those using the Spanish language. In this regard, the cooperation between the Spanish Patent and Trademark Office and other IP Offices had been essential to the exchange of information and the harmonization of best practices. One example was the annual PCT seminar with Offices in Latin America funded by the WIPO Spain Funds-in-Trust. In conclusion, IP Offices needed to aim for excellence to meet users' needs and IP policy was of capital importance towards the development of economies, and the Under-Secretary wished the Meeting success with its work.

9. Ms. Patricia García-Escudero Márquez, Director General of the Spanish Patent and Trademark Office welcomed the participants to the Meeting, especially the Delegation of the Intellectual Property Office of the Philippines whom she congratulated on the recent appointment of the Office as an International Searching and Preliminary Examining Authority. The Director General stated that she was proud of the achievements of the Spanish Patent and Trademark Office as the first IP Office using the Spanish language to work in the PCT and to be appointed as an International Searching and Preliminary Examining Authority. The PCT had great advantages for the general public and patent applicants. In particular, applicants had another 18 months to decide on whether to apply for foreign patent protection compared to the route provided by the Paris Convention. The work of International Authorities was essential to the PCT System. Thanks to the international search and preliminary examination, the need for a national search at an IP Office was reduced or, in some cases, eliminated entirely, particularly when the Chapter II process was used to its full. With the increasing value of intangible assets in the economy, it was important to focus on making improvements to the benefits available to patent applicants using the PCT. Examples in this regard were the continual improvement of the quality framework through work in the Quality Subgroup, the increased use of electronic services where the Spanish Patent and Trademark Office played an active role, and collaborative and harmonization activities, such as the work with the European Patent Office on harmonization of search reports in the PCT.

ITEM 2: ELECTION OF A CHAIR

10. The session was chaired by Mr. Javier Vera Roa, Technical Adviser, Spanish Patent and Trademark Office.

ITEM 3: ADOPTION OF THE AGENDA

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

ITEM 4: PCT STATISTICS

12. The Meeting noted the presentation by the International Bureau on the most recent PCT statistics¹.

ITEM 5: MATTERS ARISING FROM THE QUALITY SUBGROUP

13. 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 2019.

ITEM 6: PCT ONLINE SERVICES

14. Discussions were based on document PCT/MIA/25/6.

15. Authorities agreed with the priorities set out in the document.

16. Several Authorities noted their ongoing use of ePCT services or work which was underway to enable ePCT-Filing. One Authority observed that its forthcoming electronic filing system would embed ePCT services within the framework of its own system, allowing it to offer a single portal for all its services while eliminating the parallel development work involved in ensuring that PCT services remained consistent and up to date. One Authority requested the other Authorities which offered ePCT-Filing to provide information on provisions of their national laws on the accordance of the filing date. Another Authority noted that it had enabled ePCT-Filing as an option, but this was so far only used by a very small proportion of applicants filing applications with its Office as a receiving Office and invited information on what other receiving Offices had done to make ePCT-Filing the preferred choice of applicants. One Authority noted the benefits of having the ePCT browser-based portal available. This gave it the ability to find documents and data on demand which went beyond the items which had been automated for its more common requirements.

17. Several Authorities noted their continued use of PCT-EDI, which was a well-established and robust means of document transmission.

18. Several Authorities expressed satisfaction with the implementation and use of the eSearchCopy system and either noted a strong program for working with receiving Offices to move over to the eSearchCopy system in a phased transition, or else hoped that further receiving Offices would implement it soon. One Authority noted that, while the system itself worked well, transitional issues needed to be handled carefully with receiving Offices moving from paper transmission to eSearchCopy.

19. Several Authorities observed that they intended to implement access to the WIPO Digital Access Service for Priority Documents in the course of 2018. It was suggested that the new participating Offices and forthcoming changes to the arrangements of IP5 Offices would significantly increase the use of the service for both Paris and PCT purposes.

20. Several Authorities noted the work which they had done in their role as designated Offices to improve the quality and scope of national phase information delivered to the International Bureau and hoped that the supply of such data by other Offices would soon improve. One Authority which used the WIPO Industrial Property Automation System (IPAS) requested assistance in setting up the data extraction and transmission.

21. Several Authorities noted the benefits of WIPO CASE. One Authority expressed its hope that effective citation data would become available through that service soon.

¹ 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/25_statistics

22. Authorities noted the International Bureau's concerns about the reliability of fax services; several Authorities indicated that they were encountering the same problems.

23. The EPO noted the importance of ensuring that DOCX filing was introduced effectively as a valid filing format for the PCT system. Several Authorities agreed the importance of moving toward greater use of XML for the application body, international search reports, written opinions and other purposes, noting the improvements which this should offer to efficiency of processing and patent information quality. A number of Authorities indicated that they were close to being able to supply international search reports and other documents in XML format, but required additional assistance in ensuring that the relevant standards had been properly met.

24. The Meeting noted the developments in PCT online services.

ITEM 7: PARTICIPATION IN WIPO CASE IN SUPPORT OF GLOBAL DOSSIER

25. Discussions were based on document PCT/MIA/25/8.

26. International Authorities noted the benefits to work-sharing which came from WIPO CASE, including through its strong links to the IP5 Global Dossier service. The benefits would increase greatly with larger numbers of participating Offices, particularly as providing Offices. Allowing access to file information for public use as well as Office use was particularly helpful. Being a global service, it was important that documents and data be reliably available 24/7.

27. Many International Authorities expressed their support for the WIPO CASE service. Most were using it already or else intending to join soon as providing Offices, in addition to already acting as accessing Offices. Several Authorities indicated that they were working towards making structured citation data available. One Authority noted that it was unable in the near future to bring its delivery of documents to the service into full alignment with what was available in its own file wrapper service, but recognized the importance of full information and hoped to provide this in the near future.

28. The Meeting noted the contents of document PCT/MIA/25/8.

ITEM 8: SAFEGUARDS IN CASE OF OUTAGES AND CYBER-ATTACKS

29. Discussions were based on document PCT/MIA/25/12.

30. The EPO introduced the document, indicating that the main proposal was in Part I, covering cases where an electronic service was unavailable for reasons attributable to an Office, including downtime for maintenance. The EPO considered that there was no specific provision in the PCT sufficient to provide safeguards equivalent to those in Rule 134(1) of the European Patent Convention. Part II of the document invited discussion on issues where problems were at the user end. The EPO considered that the application of Rule 82*quater* was very restrictive, noting that the Receiving Office Guidelines clarified that the provision should only apply where no other means of communication was available. It observed that the postal service was not relevant to the issue within its jurisdiction, since filing dates would be recognized only on the basis of receipt by the Office, not by a mailing date. The EPO noted that similar issues had been discussed two years ago, but that recent events, including large scale cyber-attacks, had highlighted the need to consider the subject again.

31. Authorities recognized the ever-increasing importance of the issues set out in the document. However, they were unable to comment in detail, due to the limited time since the document had been published. The EPO indicated that although it had prepared a document on the subject in the previous year for preliminary discussion with some Offices in another forum, this document had been delayed by the need to seek and analyze feedback through a user questionnaire addressed to these Offices.

32. Some Authorities provided initial feedback on the issues, with some expressing sympathy for an amendment to PCT Rule 80.5 while others considered that Rule not to be appropriate to situations of downtime in electronic filing systems at an IP Office.

33. The USPTO noted that the restrictive interpretation applied to Rule 82*quater* had been deliberate, as discussed during the eighth session of the PCT Working Group (see paragraphs 402 and 403 of the Report of that session, document PCT/WG/8/26) and that its agreement to amending the Rule to cover general unavailability of electronic communication services had been dependent on such a guideline being adopted. Its position on this subject had not changed.

34. The Meeting noted that the EPO intended to continue gathering information with a view to deciding whether to bring proposals for consideration by the PCT Working Group.

ITEM 9: FUTURE DEVELOPMENT OF THE PCT

35. Discussions were based on document PCT/MIA/25/10.

36. The International Bureau noted that it was considering bringing a document to the PCT Working Group reviewing the recommendations in the “PCT Roadmap” which had been endorsed by Member States in 2010 and identifying whether further guidance was appropriate to ensure that the various lines of work on development of the PCT system met the current needs of the system and were mutually supportive.

37. Authorities welcomed the concept of such a review and agreed that the issues which had been identified were relevant and important. However, several Authorities called for a broader scope of review, also identifying, comparing and bringing into context the wide range of proposals which had been made by Offices and Member States in the intervening period.

38. Several Authorities welcomed the approach of primarily seeking administrative improvements within the context of the existing legal framework, including IT developments and measures to improve quality of reports and of patent information.

39. One Authority broadly welcomed the review, indicating that many positive measures, including search strategies and quality feedback mechanisms, had either been introduced or were under development as a result of the recommendations concerned. However, the review should also take into account areas which were of concern to Member States. Specifically, the Authority reiterated concerns, which it had already expressed in previous meetings, that integration of the Patent Prosecution Highway (PPH) into the PCT would be undesirable for some Member States, potentially hindering the implementation of technical assistance-related recommendations of the Roadmap or the Development Agenda.

40. The International Bureau noted the comments by Authorities and indicated that it would take them into account in the preparation of the working document to be considered at the upcoming June 2018 session of the Working Group.

ITEM 10: PROMOTING LINKAGE BETWEEN THE INTERNATIONAL PHASE AND THE NATIONAL PHASE

41. Discussions were based on document PCT/MIA/25/3.

42. Authorities reiterated their support for the principles behind the proposals set out in the main body of document PCT/MIA/25/3. The proposal concerning indication of relevant passages of English language equivalents of cited documents was good practice which would improve the accessibility of the international search report to a wide range of designated Offices, though one Authority suggested that the proposal should be drafted more clearly as a recommendation rather than a requirement for examiners. The emphasis of the desirability of searching subject matter which was not patentable according to the national laws of a particular

International Searching Authority would increase the information available to other Offices as designated Offices, though it was emphasized that an effective search might not always be practical, for example, because of a lack of technical expertise in subject matters which were not patentable. One delegation added that the utilization of search results in the national phase should be further evaluated. The proposal to clarify the objectives concerning identification of defects in form and contents could provide more consistent reports.

43. The Meeting noted that the International Bureau would shortly issue a PCT Circular formally proposing modifications to the PCT International Search and Examination Guidelines, which would take into account the proposals by the Japan Patent Office.

44. Several Authorities indicated their ongoing support for many of the other issues set out in the Annex to document PCT/MIA/25/3, while noting that concerns remained over the principle of some of the ideas which had been suggested, including searches on provisional applications, a mandatory requirement for Chapter II reports in certain circumstances and the introduction of PPH into the PCT.

ITEM 11: PILOT ON NETTING OF PCT FEES

45. Discussions were based on document PCT/MIA/25/5.

46. The International Bureau informed the Meeting that it had started a netting pilot with the EPO involving the search fees collected by the USPTO in its capacity as a receiving Office for the benefit of the EPO, the search fees collected by the International Bureau in its capacity as a receiving Office for the benefit of the EPO, the supplementary search fees collected by the International Bureau for the benefit of the EPO, the international filing fee received at the EPO as a receiving Office and any amounts under Rule 16.1(e) owing to or owed by the EPO to the International Bureau. The first netting transaction would take place on February 22, 2018 based on transactions for January 2018. The receiving Offices of India, Turkey and Switzerland would join the pilot from April 1, 2018 with the first netting transaction due to take place in May 2018. Other receiving Offices which had chosen the EPO as a competent International Searching Authority had been contacted beginning with those receiving fees in currencies other than the euro. At a later stage some receiving Offices collecting fees in euros would be invited to join the pilot.

47. The EPO looked forward to more receiving Offices joining its netting pilot and requested the transfer of fees in the netting pilot to be linked to the transfer of search copies through the eSearchCopy system. The IPO and TURKPATENT looked forward to participating in the pilot with the EPO, and the PRV confirmed its future participation.

48. The other Authorities that had indicated their interest to begin a netting pilot supported the concept of the pilot as set out in the document, with some planning to begin a pilot with the International Bureau in the coming months. Any netting scheme needed to be voluntary and ensure transparency with all transactions, which required accounting systems to be verified and necessary modifications to be made to IT systems in order to synchronize transactions with their recording. This could create additional challenges to a netting pilot that would involve Madrid System and Hague System fee payments; one Authority stated that it presently handled these transactions with the International Bureau on a weekly basis, in contrast with the proposed monthly netting arrangements in the PCT.

49. Two Authorities that had not been included among the participating International Searching Authorities in paragraphs 13 to 17 of the document intended to follow the netting pilot with interest, with a view to possible participation in the future.

50. The Meeting noted the contents of document PCT/MIA/25/5.

ITEM 12: NUMBER OF WORDS IN ABSTRACTS AND FRONT PAGE DRAWINGS

51. Discussions were based on document PCT/MIA/25/11.
52. Several Authorities recognized the importance of good quality abstracts and indicated their agreement with the intended further steps, including not pursuing the option at this time of introducing fees relating to long or low quality abstracts.
53. One Authority recalled the fact that there was no direct correspondence between length and quality of abstracts and that considerations varied between different fields of technology. Education of applicants using guidelines rather than mandatory requirements was considered to be the appropriate way forward. Another Authority indicated that applicants should be reminded of the reasons that drafting a good quality abstract was in their own interests, including ensuring that their disclosure would be found as effective prior art against later applications by competitors and advertising the potential availability and relevance of their own technology. Authorities would provide feedback on the specific proposals for modification of the Applicant's Guide and International Search and Preliminary Examination Guidelines in response to the forthcoming PCT Circular.
54. The Meeting noted the status of work concerning the length and quality of abstracts in international applications.

ITEM 13: PCT COLLABORATIVE SEARCH AND EXAMINATION THIRD PILOT

55. Discussions were based on document PCT/MIA/25/7.
56. The EPO explained that the Collaborative Search and Examination (CS&E) Pilot Group was in its second year of the preparatory phase. At its most recent meeting in Tokyo in November 2017, progress was made on the definition of indicators to monitor the pilot, notably operational indicators. At the next meeting, to take place in Madrid on February 26 and 27, 2018, the CS&E Pilot Group would aim to finalize the operational arrangements of the pilot, discuss the information provided about the pilot on the respective Office websites to trigger participation among the user community, and take a decision regarding the launch date of the operational phase of the pilot.
57. The USPTO, which had participated in the earlier collaborative search and examination exercise with the JPO and KIPO, welcomed the discussions on how the CS&E pilot would improve quality and save time at national examination.

58. The Meeting noted the contents of document PCT/MIA/25/7.

ITEM 14: PCT SEQUENCE LISTING STANDARD

59. Discussions were based on document PCT/MIA/25/2
60. One Authority underlined the need to communicate with applicants on the adoption of the international filing date as the reference date in determining the applicable standard for the filing of sequence listings in international applications concerning the "big bang" transition from ST.25 to ST.26, which would take place in January 2022. This Authority proposed that the validation software should be available in multiple languages.
61. The Meeting noted the contents of document PCT/MIA/25/2.

ITEM 15: PCT MINIMUM DOCUMENTATION

(a) PCT Minimum Documentation Task Force: Status Report

62. Discussions were based on document PCT/MIA/25/4 and a presentation given by the EPO².

63. Authorities noted with approval a report from the EPO that significant progress had been made on identifying many of the issues involved in improving what was currently an extremely complicated situation of how patent documents belonged to the PCT minimum documentation. Notably, there was no clear entity which could be identified as “the minimum documentation” since the requirements varied from Authority to Authority depending on their working languages as well as factors which changed over time, such as availability of English language abstracts. The considerations relevant now were very different from those when the concept of minimum documentation was established. Most patent documents were now available in full text format as part of databases, compared to the largely paper-based systems which had previously been relevant. The ever-improving quality of machine translation between various languages was a particular current issue. Non-patent literature was a particularly difficult issue and further complicated by the fact that it was mainly defined in terms of periodicals, some of which were now either very difficult to obtain or else no longer available in the form in which they had been incorporated into the minimum documentation.

64. In relation to patent-related documents, Authorities noted that one of the main issues to be addressed was the extent to which utility models were included. At present, French utility certificates were included but no other types of utility models, some of which offered an extensive body of technical disclosures. Several Authorities reiterated their view that all utility models which were made available in a suitable format should be included in the minimum documentation. Other Authorities expressed the need for a careful review of the added value which they could offer to a search.

65. One Authority noted the importance of finding the correct definitions of the minimum documentation, noting the requirements of PCT Rules 36 and 63 that Authorities must have continuing effective access to the full range of the documentation.

66. The USPTO, as leader of the task force’s work on non-patent literature, indicated that it would shortly submit a survey to Authorities relating to the use of non-patent literature for search, including issues of source, modality of search, language issues, use of abstracts, conditions on sharing the citations and other types of restriction which may apply.

67. The Meeting noted the contents of the status report of the PCT minimum documentation task force.

(b) Indian Traditional Knowledge Digital Library

68. Discussions were based on document PCT/MIA/25/9 and a presentation given by the IPO³.

69. The IPO recalled the reasons for which it had in 2015 proposed the addition of the Indian Traditional Knowledge Digital Library (TKDL) to the PCT minimum documentation. Several patents had been successfully challenged based on demonstration of the existence of relevant traditional knowledge. The database was already in use at many patent Offices, including ones which acted as International Searching Authorities. The Office introduced various changes

² 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/25_minimum_documentation

³ 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/25_Indian_TKDL

which had been made to the Access Agreement. The Office considered that these addressed all of the concerns which had been previously expressed by International Authorities save for those relating to the desire to be able to load the full database into Authorities' own search systems for more efficient searching together with disclosures from other sources. The Office pointed out that no such requirement had been made of other information providers and that some other parts of the minimum documentation were either difficult or expensive to search. In respect of availability of the information to applicants, the Office also noted that the original material referred to in the database was all published documentation, available from other sources. Furthermore, the IPO offered potential applicants the service of a pre-application search of the database to avoid being surprised by material which could be cited from the database and that other Offices would be able to do the same.

70. Authorities reaffirmed their view that the TKDL represented a valuable source of information for search of patent applications in various fields of technology. Nevertheless, they added that further work on the principles of non-patent literature in the PCT minimum documentation needed to be completed by the task force before it could be added. Specific concerns which were stated included:

- (a) the limitations which the modified Access Agreement still placed on the ability to view and use prior art material;
- (b) the effect on the status of Authorities if their access to the TKDL were to be revoked;
- (c) the efficiency of search if the TKDL could not be searched through systems common to other databases;
- (d) the effect of the preamble to the non-patent literature part of the PCT minimum documentation, which limited the requirement to search the non-patent literature to publications from the period of five years prior to the international filing date of the international application being searched; and
- (e) the contents of the TKDL which were requested to be included in the PCT minimum documentation were not clearly defined.

71. One Authority which did not yet have access to the TKDL indicated that it needed further information on the database and its methods for access.

72. The IPO indicated that it had noted the concerns. It would address these further through the task force and hoped to reach a positive outcome soon.

ITEM 16: FUTURE WORK

73. The Meeting noted that the next session was expected to be convened in the first quarter of 2019, immediately following a meeting of the Quality Subgroup. In view of the agenda for the Quality Subgroup which had increased in size at recent meetings, the Meeting accepted the suggestion by the International Bureau to hold the 2019 Quality Subgroup meeting over three days, with the Meeting taking place over two days.

74. The Meeting was pleased to accept an offer that the International Bureau had received from the Egyptian Patent Office to host the 2019 sessions of the Meeting of International Authorities and of the Quality Subgroup.

[Annex I to document PCT/MIA/25/13, containing a list of participants is not reproduced here]

[Annex II (to document
PCT/MIA/25/13) follows]

ANNEX II (to document PCT/MIA/25/13)

PCT/MIA QUALITY SUBGROUP, EIGHTH INFORMAL MEETING
MADRID, FEBRUARY 19 AND 20, 2018

SUMMARY BY THE CHAIR

INTRODUCTION

1. Ms. Cristina Fernández Ordás, Deputy Director, Legal Coordination and International Relations Department, welcomed the participants to the Spanish Patent and Trademark Office (SPTO). Having been appointed as an International Searching Authority in 1993 and as an International Preliminary Examining Authority in 2001, the Meeting of International Authorities was taking place at the SPTO for the first time. Ms. Fernández emphasized the importance of quality in the PCT as supporting the global development of the patent system, and therefore underlined the need to promote and support quality in the operations of International Authorities. In some Authorities, this had been achieved through ISO Standard 9001 certification. As a general principle in quality, it was necessary to be clear on the functions in an Office and have the necessary resources, and also have feedback mechanisms in place to identify problems and minimize future occurrences of a problem. To deliver a high quality of services, quality and excellence was one element of the Strategic Plan 2017-2020 on Intellectual Property at the SPTO. Ms. Fernández concluded her welcome with a presentation on the SPTO⁴.

2. Mr. Javier Vera Roa, Technical Adviser, Department of Patent and Technological Information, SPTO, chaired the session.

3. One Authority noted the late delivery of several of the papers for the meeting and indicated that it might need to make further comments on the issues through the wiki after the session. It was requested that papers be prepared at least four weeks in advance for future sessions.

1. QUALITY MANAGEMENT SYSTEMS

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

(B) QUALITY MANAGEMENT SYSTEMS AT INTERNATIONAL AUTHORITIES

4. Authorities agreed that the system of reporting on the quality management systems was useful, and appreciated the summary provided by the International Bureau in the paper. In addition to the reports of the quality management systems of other Authorities, the Subgroup found the presentations of quality management at the State Intellectual Property Office of the People's Republic of China (SIPO), the European Patent Office (EPO) and the Intellectual Property Office of Singapore (IPOS)⁵ to be helpful as practical examples at Authorities of different sizes facing their own particular challenges in the search and examination of patent applications. Having expanded over recent years to meet the steady growth of patent applications, SIPO had established an examination guidance system and a quality assurance system to ensure consistent examination and quality among different examination departments. By contrast, the EPO had successfully improved search timeliness and had now set targets to prioritize the timeliness in examination and opposition. Furthermore, IPOS was relatively new to

⁴ http://www.wipo.int/meetings/en/doc_details.jsp?meeting_code=pct/mia/25_qsg_spto

⁵ http://www.wipo.int/meetings/en/doc_details.jsp?meeting_code=pct/mia/25_qsg_epo and http://www.wipo.int/meetings/en/doc_details.jsp?meeting_code=pct/mia/25_qsg_ipos

PCT operations, and was putting procedures together to deal with a growing number of international searches. Despite these differences, many aspects of their quality management approaches had relevance to other Authorities, even though the reasons for which they faced particular challenges might be different.

5. The SPTO reported on its participation in the Harmonization Files Project with the EPO, where it had received 50 PCT files and had issued 45 reports. This had been a positive experience and it intended to continue the work in 2018. Reports on participation in this project had also been included in the quality management system reports of the Nordic Patent Institute and the Finnish Patent and Registration Office.

6. Two Authorities reported on teleworking. One of these Offices had introduced a teleworking option five years ago, and had adapted tools for training and sharing accordingly. For the other Office, teleworking was recent, and had managed to increase productivity by 40 per cent for participating examiners.

7. One Authority stated that it supported extending the requirements of reporting to cover the number of patent examiners and their areas of expertise, which had already been included in some of the reports.

8. The Intellectual Property Office of the Philippines reported that it had been re-certified under ISO 9001:2015 for its public administration covering the process of registration of patents, utility models, industrial designs and trademarks on December 6, 2017.

9. In response to a question about the establishment of the three-person examining division at the EPO, and the “three pairs of eyes” procedure at IPOS, these Offices explained that the combination of the three examiners involved would vary between cases. At the EPO, the chair of the division would usually be a more experienced examiner in the same technical field. At IPOS, the “buddy examiner” would depend on the invention and the subject matter.

10. The Secretariat underlined the importance of learning from reports of the quality management systems of other Authorities to deliver on improved quality. This did not necessarily need to be done multilaterally in the context of the Subgroup. Where appropriate, it could be done bilaterally between Offices of similar organizational structure, or facing similar challenges.

11. The Subgroup recommended:

- (a) to continue reporting on existing Quality Management Systems using the present reporting mechanism, indicating changes from the previous report and including these changes in a summary along with other matters of likely interest as part of the introduction to the report;
- (b) that Authorities should have the option to include process charts in the reports, as discussed in paragraphs 15 to 17, below; and
- (c) that other Authorities should present overviews of their Quality Management Systems to future meetings of the Subgroup.

(C) STRENGTHENING REQUIREMENTS OF QUALITY MANAGEMENT SYSTEMS

12. The International Bureau reported that it had so far received 15 responses to Circular C. PCT 1523 on proposed modifications to strengthen the requirements of quality management systems under Chapter 21. In general, these responses were in favor of the proposals.

13. One Authority had proposed that the requirements on search process documentation in paragraph 21.21 of the International Search and Preliminary Examination should be a mandatory requirement. Another Authority had indicated that it wished to propose a new mechanism for reporting on quality management involving experts in international search in order to ensure that the systems were effective, and may come forward with a concrete proposal in this regard. Both these ideas would be considered as part of a future round of modifications to Chapter 21 after promulgation of the modifications set out in Circular C. PCT 1523. Meanwhile, the proposal on search process documentation could be discussed on the Subgroup wiki.

14. The Subgroup noted the ongoing consultation and recommended discussions to begin on the electronic forum on further proposals to modify Chapter 21.

(D) PROCESS CHARTS IN QUALITY MANAGEMENT SYSTEMS

15. The Swedish Patent and Registration Office (PRV) commented that it had found process charts to be particularly helpful for understanding reports on quality management systems. As an example, the charts on the handling of non-unity of invention shown in the presentation by IPOS had been helpful to understand the procedures in this area. The PRV had used process charts for internal training purposes, and charts had been useful in the transition from ISO 9001:2008 to ISO 9001:2015. Authorities that made comments found the example of a process chart that showed the handling of non-unity of invention at IPOS to be particularly helpful for better understanding of practice. While it was useful to share examples of process charts and to extract interesting details from these charts, one Authority observed that it did not believe that attempting to establish a common template for similar processes across Authorities was the appropriate way forward. In addition to the work involved, this risked losing valuable information specific to the individual Authorities' processes. Instead, the Authority encouraged further Authorities to share examples of their process charts on the wiki and for Authorities to include appropriate process charts in the reporting on the quality management systems.

16. Authorities supported continuing the discussions of process charts on the wiki, encouraging more Authorities to share relevant charts. Authorities were also in favor of the option of including process charts when reporting on the quality management systems under Chapter 21. However, the inclusion of process charts should not be mandatory in the reporting and should not seek to replace descriptive text. One Authority added that any process charts in the reports should be brief and informative.

17. The Subgroup recommended that:

- (a) Authorities should share further examples of process charts used in international search and preliminary examination on the Subgroup electronic forum; and
- (b) Authorities should have the option to include process charts in the reporting on their quality management system if this would facilitate the understanding of an aspect of the report by other Authorities.

(E) RISK MANAGEMENT

18. The SPTO gave a presentation outlining the principles of risk-based thinking in ISO 9001:2015 especially intended for those Authorities with Quality Management Systems that were not based on ISO 9001, to provide information on the benefits and implications of incorporating risk-based principles into Chapter 21. The arrangement gave a more systematic approach to risk as an integral part of the system, rather than preventive action as a separate component of the QMS. This allowed systems to be more proactive rather than reactive, ensuring that the risks were identified, considered and controlled from an early stage. It was important to note that the standard did not have any requirement for specific formal

methodologies of risk management, as long as it was clear that the risks had been properly considered. The Office considered that adding risk-based principles to the requirements of Chapter 21 of the PCT International Search and Preliminary Examination Guidelines could improve the processes of International Authorities and give users greater confidence in them. Furthermore, this could be achieved without significant burden since risk was already implicit in Chapter 21 with preventative actions and addressing issues like changes in workload, backlogs or fluctuations in demand.

19. IP Australia gave a presentation on its risk management approach, which was based on the Australia/New Zealand Standard associated with ISO 31000:2009⁶. This approach had been motivated by a federal government requirement, but the principles were considered potentially more generally useful to International Authorities. The approach included operational planning risk management on an annual cycle with quarterly reporting, together with process level risk management providing transactional risk assessments for a variety of products and services. Examples included new applications filed using ePCT and patent examination processes. The level of risk was used to determine the appropriate sampling levels for the services. In the case of examination, this was adapted to give special provision for trainee examiners (100 per cent sampling of proposed products) and then three levels of sampling of processes by qualified examiners, depending on the outcomes of previous reviews. The approach was felt to encourage preventative action, leading to consistent dealing with adverse outcomes and consequent gains in efficiency.

20. In response to queries, IP Australia indicated that sampling levels were based on the individual examiners, but that it was the processes and outcome rather than the examiners which were the subject of the reviews. Over half of examiners were subject to the lowest level of sampling and only a very small number to the highest level.

(F) RELATIONSHIP BETWEEN CHAPTER 21 AND ISO 9001

21. Following on from the presentation given in the context of the previous agenda item, the Spanish Patent and Trademark Office (SPTO) introduced the paper reporting on the discussions about the comparison between Chapter 21 and ISO. SPTO stated that Chapter 21 was certainly its Quality reference. On the other hand, SPTO expressed that recognized international quality standards were in evolution and therefore the same would be desirable with Chapter 21. Moreover, as ISO 9001 was the most widespread quality standard among the Authorities and with a significant change in its most recent version, it was logical to use ISO 9001:2015 as a reference for this comparison. But Chapter 21 could also benefit from a comparison with any other recognized standard to identify missing aspect to incorporate to Chapter 21. From the comparison itself and discussions on the forum, it was expressed that there was an important alignment between ISO and Chapter 21. In this regard, an external annual assessment (ISO certification or any other) could be used to assure some compliance, provide incentive and reinforce confidence. Especially important was the conclusion that risk management was considered to be particularly useful for a QMS in the framework of the PCT and therefore SPTO proposed its inclusion in Chapter 21.

22. International Authorities broadly agreed with this view but noted that it was important to recognize a clear distinction between Chapter 21 and ISO 9001. The former was specific to patents and the latter was very general. It had to be recognized that compliance with one did not mean compliance with the other. Developments in ISO 9001 were well worth considering but should not be automatically adopted. Nor should there be any requirement that Authorities adopt ISO 9001 approaches or seek ISO 9001 certification. Offices should remain free to adopt alternative methodologies which gave an appropriate result. One Authority noted that it considered a mandatory external audit not to be appropriate.

⁶ http://www.wipo.int/meetings/en/doc_details.jsp?meeting_code=pct/mia/25_qsg_IP_Australia

23. The Subgroup concluded that there was general support to consider the changes to ISO 9001 and evaluate whether they should be reflected in Chapter 21, but that this should not be an automatic process. The Subgroup welcomed the offer from the SPTO to lead discussions through the wiki aimed towards developing a specific text in Chapter 21 related to risk.

(G) USER FEEDBACK

24. The EPO gave a presentation on recent experience of user feedback. This included metrics-based and non-metrics-based aspects. Non-metrics-based feedback was useful, but needed to be validated to ensure that it was appropriate. The Office had recently concluded the latest 3 year cycle of user satisfaction surveys. This provided many indications of improvements in user satisfaction, some of which had been a result of identifying and addressing concrete concerns from the previous cycle. While it was pleasing to see the positive feedback, well-expressed points of concern were particularly valuable in identifying areas for improvement. A variety of new services or improvements in service orientation had been based on the feedback received. In particular, the attention to the concerns of users outside of Europe had identified a number of issues. For example, the Office had prioritized the issuance of search reports and written opinions for all filings to ensure the same service for all users. Furthermore, it had become apparent that those users had not been aware of differences between the procedures, costs and regulations at the EPO compared to those in their home countries. User feedback was ever more important, providing direction for activities and input for quality management systems.

25. In response to queries concerning its recently approved fee reductions which were to take effect from April 1, 2018, the EPO observed that since 2010 feedback received had shown that quality was good but that fees were high. This had initially been addressed by maintaining fees at their existing levels (not increasing for inflation) and improving services, but that this had not been considered enough. Following further user feedback, its Administrative Council had agreed to reduce international search fees as well as to increase to 75 per cent the reduction in the regional examination fee for applications where a positive opinion on novelty, inventive step and other requirements had been given in an international preliminary examination report. This was a significant increase in the reduction, while reflecting the fact that, although in many cases the application was close to a point where it was acceptable for grant, in many cases some substantive work remained to be done.

26. The Subgroup recommended that its work on user feedback should be considered concluded for the present, noting that any Authority could bring further proposals for work in this area if it appeared appropriate and that this did not affect Authorities' ongoing requirement to report on user feedback issues in their annual quality management system reports.

(H) FEEDBACK FROM PAIRED REVIEW OF QUALITY MANAGEMENT SYSTEMS OF INTERNATIONAL AUTHORITIES

27. The six Authorities that participated in the paired review agreed that the exercise had been beneficial and should be repeated at next year's quality subgroup meeting with the hope that other Authorities could join in the review sessions. Among the topics discussed were quality assurance and control, management review of quality management systems, self-assessment, surveying examiners, improvement logs, use of flow charts, teleworking, experience with ISO certification, external contracting of search and examination and the quality review of contractors.

28. Reviewing the report on the quality management system of another Authority had helped acquire a better understanding of the work of that Authority. It was noted that Authorities all shared common goals and that the review exercise had helped to understand differences, for

example, in terminology. While each meeting involved one Authority reviewing the report of another Authority, the experience during the feedback session was felt to be more of a two-way dialogue. Some participants were satisfied with the 60 minutes allocated to each review, but it was accepted that 90 minutes would offer more time to exchange views. Authorities were happy with the facilities with each conversation taking place in a separate room, but wifi access could be useful for the future. In terms of the organization, some Authorities would have appreciated having about four weeks to review the report of their Office, and some questions to the Authority could be sent in advance of the meeting to allow internal consultations. However, this should not be at the expense of the intended informal nature of the sessions, and more notice would require Authorities to decide on participation at an earlier date. One Authority indicated that the review would lead to a more rigorous review of the report of its quality management system next year to consider whether more extensive changes could improve the reporting.

29. Participating Authorities considered it useful for both the reviewing Authority and the Authority being reviewed to complete a feedback form at the end of each review session. In response to the request of an Authority that had not participated in the paired review sessions to share the feedback form, the participating Authorities agreed that the International Bureau could make some examples of the completed feedback forms available to the Subgroup through the wiki if the participating Authorities agreed. Nevertheless, some participants stated that due to the general content and simplicity of the feedback form, mainly focused on logistics, it was believed not to be of great interest for other Authorities.

30. The Subgroup noted the feedback from the paired review exercise and recommended that interested Authorities should perform a paired review of reports of Quality Management Systems at the next meeting. The International Bureau would invite Authorities to participate through the Circular requesting reports on the Quality Management Systems with a deadline to allow participating Authorities to make contact with the Authority they would be reviewing and share questions if desired.

2. BETTER UNDERSTANDING OF WORK OF OTHER OFFICES

(A) DIFFERENT APPROACHES TO SHARING SEARCH STRATEGIES

31. One Authority which had recently started sharing full search strategies with the International Bureau for publication on PATENTSCOPE stated that this request had been conveyed by its applicants during a stakeholder meeting in early 2017.

32. Some International Authorities supported a proposal to prepare and issue a survey among users, aimed at determining what was hoped to be obtained from studying search strategies. One Authority suggested that such a survey should cover the usefulness of search strategies, their clarity, their content and the form in which they were presented. This Authority indicated its intention to conduct its own survey on search strategies.

33. One Authority advised caution, noting that there were different understandings of what was involved in providing a search strategy and, as a result, the expectations of the objectives. It was not clear who were considered to be the users of such strategies. This Authority considered that the primary users were applicants and third parties, enabling them to have increased confidence in the search which had been performed. Consultations which had already been undertaken suggested that such users at the Authority were happy with the strategies which were already provided, with applicants wanting confidence in the direction of the search or material which could be relevant to opposition or appeal hearings. Further work would require a clear understanding of the objective of any survey, understanding which sections of the user communities needed to be addressed. It was important that any survey should not necessarily be aimed at harmonization of search strategies, but rather at achieving a better understanding of their use.

34. Another Authority considered a different approach to be appropriate, noting that search strategies could be used to allow examiners to learn improved search techniques. As such, any survey should be directed not only at applicants and third parties but at examiners in designated Offices, who might be interested in more advanced aspects of search strategies. Another Authority stated that the international work products were used by applicants, designated Offices and other interested parties and hence believed that users should include all of them. Several other Authorities echoed the desire for a broad audience for a survey.

35. One Authority noted a variety of issues concerning the strategies themselves, reflecting risks of manually preparing summaries of searches performed and difficulties in using strategies for searches conducted in languages with which another user might not be familiar. These issues were still under discussion with other Authorities. This Authority suggested that in general, examiners would learn better from conducting their own searches and one to one mentoring with local experts than from trying to decipher the detailed strategies of examiners at other Offices.

36. The Subgroup welcomed the offer by the USPTO to draft proposals for further consideration on the wiki, directed towards agreeing on overall objectives and points to be addressed in a survey directed to the different users of search strategies.

(B) STANDARDIZED CLAUSES

37. Authorities provided updates on the use of the standardized clauses. In this regard, the International Bureau encouraged those Authorities to update the electronic forum to indicate how they were using the clauses in their work.

38. In terms of the proposed modifications, some Authorities preferred to adopt the changes through a Circular, with one Authority suggesting that the clauses could be included as model clauses in an Annex to the International Search and Preliminary Examination Guidelines. The use of the clauses should not, however, be mandatory.

39. Some Authorities reiterated their position that Clauses VIII.9 and VIII.10 on lack of conciseness should be put in Box VII of the written opinion based on paragraph 17.49 of the International Search and Preliminary Examination Guidelines. The International Bureau observed that if there were doubts over how these boxes should be used, the form itself could be changed, and that the present time, before new ST.96-based XML standards were implemented, could be a suitable time to conduct such a review.

40. One Authority informed the Subgroup that it had its own clauses but could provide the standardized clauses developed by the Subgroup for its examiners to use in certain situations. This Authority added that the use of standardized clauses should not be mandatory. While this Authority did not intend to join a pilot to integrate the clauses into ePCT for producing search reports and written opinions, it might contribute to the further drafting and development of the clauses.

41. Authorities welcomed further discussions on the development of standardized clauses on unity of invention on the wiki.

42. In relation to standardized clauses on defective abstracts, one Authority did not see a clear place to use such clauses in the search report and written opinion. Another Authority indicated its intention to modify the clause it used for non-compliance with Rule 8.1(d) to align the text more closely with that shared by another Authority. Some other Authorities stated that they did not provide reasoning when abstracts did not comply with Rule 8.1.

43. A few Authorities that were using the standardized clauses expressed interest in the integration of the standardized clauses into ePCT and participating in a pilot to develop this concept further.

44. The Subgroup recommended that:

(a) Authorities using the standardized clauses continue sharing information on their implementation on the Subgroup electronic forum, whether as the main set of clauses or to supplement clauses from the Authority itself;

(b) the International Bureau issue a Circular to consult on the adoption of the modifications to the standardized clauses in the different languages and propose the idea of their inclusion as an Annex to the International Search and Preliminary Examination Guidelines;

(c) the discussions on development of standardized clauses on unity of invention should continue; and

(d) the International Bureau continue work on including the standardized clauses in search reports and written opinions in ePCT, and Authorities interested in joining a pilot contact the International Bureau if they had not done so already.

(C) POSSIBLE PRACTICE DISCUSSION FORUM

45. Authorities were supportive of the concept of a practice discussion forum, but noted a number of technical concerns concerning confidentiality of unpublished information and ensuring that participants in the forum were able to contribute quickly enough to be useful to a case in progress without introducing undue delays. It was also noted that a similar forum might be useful for receiving Office issues.

46. The Subgroup recommended that the Canadian Intellectual Property Office post a proposed sample discussion item on the wiki to help consider the concepts involved. The International Bureau should then consider possible technical solutions to address the issues of concern, including whether it would be appropriate to offer an equivalent service that would be open to receiving Offices.

3. QUALITY METRICS

(A) CHARACTERISTICS OF INTERNATIONAL SEARCH REPORTS

47. Authorities confirmed that they continued to find the reports on characteristics of international search reports useful. Several Authorities particularly welcomed the individualized reports which had been prepared for their Offices, which made the use of the data as a self-reflection tool easier. They hoped that these would continue to be provided in future. However, several Authorities also emphasized that they wished to make comparisons between different Authorities for some of the characteristics and that for this, the traditional format was more effective, particularly where the most relevant Authorities' characteristics are all presented together on the same chart (notably, for the IP5 Offices).

48. There was general agreement that the ideal solution would be to have an interactive tool similar to that in the WIPO IP Statistics database allowing a variety of options to be selected and displayed in different ways, but it was recognized that development of such a tool was unlikely to be an immediate priority. In the meantime, some improvements to the presentation of the static charts and availability of the underlying data in more easily usable formats would be useful. Some Authorities indicated that the presentation of multiple characteristics together in a single chart may sometimes be beneficial and might be worth further consideration.

49. Authorities noted that it was essential to properly understand what the charts represented. Some key issues included the following:

- (a) The characteristics do not include international applications for which no international search report was established – information on the number and breakdown of such cases might make analysis of some issues more relevant.
- (b) Charts showing percentages of applications or citations with certain characteristics may be misleading where there is a significant change in volumes of reports produced or their nature – more clear information on absolute numbers of reports might be useful in some cases.
- (c) Similarly, breakdowns of reports or citations into very small categories will show figures which might not be statistically relevant and care should be taken not to draw incorrect or unsubstantiated conclusions based on small samples.

50. Following comments from Authorities, the International Bureau agreed to consider the following changes to the characteristics in future reports, or to make the relevant data otherwise easily available:

- (a) A new characteristic should be added showing the percentage of patent citations made which were not in the language of the international application.
- (b) Characteristic 1.8 (percentage of PCT search reports with citations in category O, T or L) should be removed from future reports unless any Authority indicated within the coming few weeks that they found it useful.
- (c) More information should be available concerning technical breakdowns and quarterly levels of production.

51. The International Bureau also agreed to look into possible reports relating to the use of Boxes IV (unity of invention) and VIII (certain observations) of the written opinion forms. Data was available on the existence or otherwise of the relevant boxes in written opinions of the International Searching Authority, but its use needed to be carefully considered in order to avoid giving misleading impressions. In addition, such data was not available for the equivalent forms in the Chapter II procedure.

52. Various further characteristics would be of interest if more detailed and timely information were available. In addition to those previously referred to in earlier sessions or on the wiki, this included more detailed breakdowns of the nature of non-patent literature citations.

53. Some Authorities observed that over past years they had used the characteristics to identify issues for further investigation which had led to changes in practice with resulting changes that were visible in the characteristics. Most notable in this respect was characteristic 1.1 (percentage of PCT search reports with at least one citation in category X, Y or E). It was observed that both extremely high as well as relatively low values for this characteristic might cast doubt on whether the most appropriate category had always been applied to a cited document.

- 54. The Subgroup invited the International Bureau to continue development of the characteristics reports and agreed to continue discussion of improved formats using the wiki.

(B) PCT METRICS – DEFINING NEEDS AND OBTAINING DATA

55. The National Institute of Industrial Property of Chile observed that it found the metrics offered by the International Bureau to be important to the management and operation of its services. It hoped for further improvements to the information available concerning transmission of search copies from receiving Offices and relating to applications filed on paper which were relatively common in its geographical region.

(C) THIRD PARTY OBSERVATIONS

56. Authorities noted the typical timing of observations and concluded that it was unlikely that observations would ever play a significant role in the international phase. It was felt that discussions should concentrate on ensuring that they were effective for the national phase. Initial impressions were positive on the role of international third party observations, but the small numbers which had been the subject of national phase processing meant that practical experience of using third party observations made in international phase was limited. The quality of observations was also variable and their value needed to be considered on a case-by-case basis. One Authority felt that the most useful observations were ones which presented new prior art which had not been available to the International Searching Authority – especially very recent publications or non-patent literature. This Authority suggested that the International Bureau could provide citation statistics related to third party observations such as nature of citation (for example, video, brochure, catalogue, prior use, etc.) and the age and date of publication of the citations included in third party observations. That Authority also felt that there would be limited value in opening observations to a wider range of subjects. It was suggested that persons making observations might be invited to provide translations of the observations into English if the relevant publication was not in this language.

57. Following a query from one International Authority, the International Bureau explained that a facility for observations by applicants had been included with the intention of allowing prior art disclosures from the applicant to be combined with citations from the international search report and any third party observations to assist the process of national phase disclosure requirements. With XML search reports now being received and processed, it was hoped to make this concept a reality in the near future.

4. UNITY OF INVENTION

(A) PROPOSALS TO AMEND CHAPTER 10 OF THE INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

58. IP Australia explained that the outcome on a specific example relating to unity of invention was dependent on how an Authority determined the special technical features of the claimed invention. IP Australia therefore proposed a paragraph to precede the examples in the International Search and Preliminary Examination Guidelines which had received broad support on the electronic forum in 2016 to explain the differences in determining special technical features. This would therefore avoid the need for caveats in many of the proposed examples that had been discussed in the electronic forum since 2015.

59. Some Authorities that took the floor supported the proposed paragraph, but some other Authorities had difficulties with the proposed paragraph. One of the latter group believed that a more consistent practice between Authorities was necessary, and a strict interpretation of unity of invention by International Authorities could make the PCT less attractive to users. Another Authority that had difficulties with the proposed paragraph pointed out difficulties with the final sentence of the proposal in view of the *a posteriori* principle. This Authority accepted the divergent practices between Authorities on unity of invitation, pointing out that certain divergences existed in Chapter 5 of the International Search and Preliminary Examination Guidelines on the consideration of some types of patent claims.

60. One Authority believed there was a need to review the examples in Chapter 10 and proposed that a Task Force be established under the leadership of IP Australia to undertake this review with a view to making a proposal on amendments to the Guidelines.

61. IP Australia indicated its willingness to take on the role of leading a Task Force to review the examples on unity of invention and invited interested Authorities to join the Task Force and participate in the discussions. The work of the Task Force would take place on the Subgroup electronic forum so all Authorities would be able to follow the discussions.

62. The Subgroup accepted the offer of IP Australia to lead a Task Force to review the examples in Chapter 10 of the International Search and Preliminary Examination Guidelines on unity of invention.

(B) IP5 PATENT HARMONISATION EXPERTS PANEL (PHEP)

63. The EPO presented a progress update on the joint project on determination and application of unity of invention criteria that it had undertaken with SIPO in the PHEP which was due for completion at IP5 level by the end of 2018. The intermediate review in the project had analyzed practices against Chapter 10 of the International Search and Preliminary Examination Guidelines. Alignment of practices in mechanical and electrical subject matter was greater compared to chemical subject matter, where substantive patent laws led to different outcomes. However, the aim of the project was to consider improvements to the reasoning of non-unity, reaching a common way of raising objections and ensuring consistency and transparency, rather than achieving alignment of practices.

(C) ADMINISTRATIVE PROCEDURES AND USE OF BOX IV BY INTERNATIONAL SEARCHING AUTHORITIES

64. The EPO explained that an objection of non-unity of invention did not always correspond to a marking in Box IV of the written opinion of the International Searching Authority, and in certain cases, a non-unity objection was not accompanied by an invitation to pay additional search fees. The EPO requested more information on these differences, which could take place through a discussion on the Subgroup wiki, and offered to prepare a questionnaire to understand better practices on non-unity of invention.

65. One Authority stated that its examiners would always mark Box IV in case of lack of unity of invention, but sometimes the applicant was not invited to pay additional fees. Another Authority indicated that an invitation to pay additional fees would always imply that there was non-unity of invention.

66. In response to a comment by one Authority, the International Bureau agreed that the uploading of Form PCT/ISA/206 (for example through ePCT for Offices) could assist in providing information relevant to measuring the extent of unity of invention issues.

67. The Subgroup accepted an offer of the EPO to post a questionnaire for Authorities to complete on the formal aspects of lack of unity of invention at their Office.

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

68. Several Authorities reiterated their view that the only mandatory parts of an application form for appointment should be those which corresponded to the minimum requirements set out in PCT Rules 36 and 63. Other Authorities supported formal adoption of the form in its current state as a required part of the process of application for appointment in order to provide the PCT Committee for Technical Cooperation with a complete view of a candidate Office so as to consider fully their capacity to perform the duties of an International Authority. The issue of the extent to which it should apply to extensions of appointment could be considered at a later date.

Authorities were open to considering the possibility of extending the scope of quality reports to cover ongoing compliance with the minimum requirements, noting concerns that this should not result in a separate, new and burdensome reporting requirement.

69. The Subgroup recommended that:

(a) the International Bureau prepare an improved draft form to present to the PCT Working Group, taking into account the comments made in response to Circular C. PCT 1519, with a view to recommending that a final form be adopted by the PCT Assembly as part of the process for seeking appointment as an International Authority.

(b) consideration be given to developing the requirements for quality reporting to include issues relating to ongoing compliance with the minimum requirements set out in PCT Rules 36 and 63.

6. OTHER IDEAS FOR QUALITY IMPROVEMENT

70. There were no further recommendations for additional areas of work.

[End of Annex and of document]