

Patent Cooperation Treaty (PCT) Working Group

**Eleventh Session
Geneva, June 18 to 22, 2018**

APPLICATION FORM FOR APPOINTMENT AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

Document prepared by the International Bureau

SUMMARY

1. The Working Group is invited to consider recommending that the PCT Assembly modify its Understanding with regard to the procedures for appointment of an Office as an International Searching and Preliminary Examining Authority (“International Authority”) under the PCT so as to require that Offices seeking appointment use a standard application form as set out in the Annex to the present document.

BACKGROUND

2. At its forty-sixth session, held in Geneva in September 2014, the PCT Assembly adopted an Understanding setting out the procedures which Offices should follow when seeking appointment as an International Authority (see paragraph 12 of document PCT/A/46/6). This Understanding covered the procedural steps, but not the form and content of the application.

3. In the meantime, as has been reported to the Working Group in 2015, the quality subgroup of the Meeting of International Authorities continued with its mandate to review the substantive “minimum requirements” for appointment set out in PCT Rules 36 and 63. However, little progress was made on this issue. It was noted that the types of requirement set out in those Rules, especially with regard to the numbers of examiners, do not have a direct relationship with the quality of work performed. Given the political and sensitive nature of the issues at stake, the subgroup believed that it was not appropriate to consider amendments to

the existing requirements for appointment as set out in the Regulations. Further, the subgroup agreed that it would neither be appropriate nor realistic to suggest any areas for consideration which would require a direct evaluation of the search and examination quality of an Office (paragraph 47 of Annex II to document PCT/MIA/22/22, reproduced in document PCT/WG/8/2).

4. The subgroup instead recommended that the focus of further work should rather be on procedural issues related to quality. To that extent, some issues have been followed up in relation to the development of the quality framework set out in Chapter 21 of the International Search and Preliminary Examination Guidelines. A further recommendation was the development of a standard application form for any request for appointment, with a view to ensuring that all pertinent quality issues were indeed covered in any request for appointment.

5. The International Bureau prepared draft versions of such an application form, which have been discussed since 2016. Those drafts already formed the basis for the applications by the Turkish Patent and Trademark Office and the Intellectual Property Office of the Philippines, as well as many of the applications for extension of appointment considered at the thirtieth session of the PCT Committee for Technical Cooperation (PCT/CTC) in 2017.

6. During this time, there were significant differences of opinion over the appropriate contents of the form. Several Authorities considered that only those parts in the draft form which related to the minimum requirements set out in PCT Rules 36.1 and 63.1 were necessary or appropriate. Others considered that the additional information invited by the other sections of the draft form were important for allowing the PCT/CTC and the PCT Assembly to form a considered judgement of whether an appointment would be beneficial to the system. While it was recognized that, in some cases, certain items of information mentioned in the drafts would not be relevant (for example, country information in the case of regional Offices or in the case of an Office which would not be offering service as an International Authority to applicants from its own country), the latter group of Authorities generally considered that there should be an expectation that most or all sections of the form should be completed to the extent that they were relevant.

7. The Working Group discussed the issue of a possible application form at its tenth session in 2017 (document PCT/WG/10/16). At that session, the International Bureau observed that there was considerable variation in the scope and depth of material which had been provided in the applications based on the draft form and that it was not yet in a position to recommend an optimal format for the form. As such, the Working Group invited the International Bureau to issue a Circular to seek feedback on a refined draft application form and any outstanding issues in order to determine whether a proposal could be brought directly to the Assembly or whether the issue should be further considered by the Quality Subgroup of the Meeting of International Authorities and/or the Working Group.

RESPONSES TO CIRCULAR C. PCT 1519

8. Circular C. PCT 1519 was issued on October 24, 2017. The International Bureau received 15 responses to the Circular: nine from Offices which act as International Authorities and six from Offices which act as designated Offices but not International Authorities.

9. The responses from designated Offices were generally positive towards the form. Some Offices made suggestions for minor improvements, such as requesting further detail on language capabilities or training regimes, making at least the statement of motivation mandatory or providing guidance on the information needed to see that IT systems were suited to allow work to be performed effectively without including unnecessary technical detail.

10. The responses from International Authorities showed the same divisions as described in paragraph 6, above. Several Authorities indicated that only information relating to the minimum requirements was necessary and that adding information on other issues was an unnecessary burden and that some of the suggested items (such as GDP and population) should not be taken into consideration. Other Authorities considered that the form should always be completed to the greatest extent relevant to the particular Office. These differences were not resolved at the twenty-fifth session of the Meeting of International Authorities, held in Madrid in February 2018. Nevertheless, the Meeting approved a recommendation by its quality subgroup that the International Bureau prepare an improved draft form for presentation to the present session of the Working Group, with a view to its adoption by the PCT Assembly as a part of the process for seeking appointment as an International Authority (see paragraph 69(a) of Annex II to document PCT/MIA/25/13, reproduced in document PCT/WG/11/2).

11. In the case of extensions of appointment, there was agreement that a simplified form compared to an initial appointment would be appropriate. However, views varied on exactly what types of difference would be appropriate. A useful consensus is likely to depend on the ways in which the ongoing quality reporting by International Authorities develops in the coming years.

NEXT STEPS

12. In view of the fact that extensions of appointment will not need to be considered again until 2026 and that the reporting on quality issues by operating International Authorities is likely to develop over this time, it is proposed to consider only the issue of new appointments at this stage.

13. The Annex contains a revised draft of the application form, taking into account comments which were received in response to the Circular. Some specific proposals are made, showing additions compared to the version in the Circular using underline and deletions using ~~strikeout~~. Comments (indented and underlined) are also included to explain some of the proposals and to highlight some of the outstanding differences of view.

14. Two further specific proposals were made in the responses to the Circular which do not clearly fit within the existing structure, but which could be added relatively easy as a drafting issue after the Working Group if it were agreed that they should be included.

(a) One designated Office suggested that the candidate Offices might give an indication of the average time which would be allowed to their examiners to conduct an international search and examination, as well as providing details of the working environment which they would offer to ensure that examiners were healthy and productive.

(b) One Office which acts as an International Authority suggested that candidate Offices should provide a demonstration of the quality of their national search and examination, perhaps by way of comparative studies of searches which had been conducted by different Offices on equivalent applications.

15. If the Working Group recommends that a standard application form be adopted for use in applying for appointment as an International Authority, the International Bureau would propose that this be implemented by the PCT Assembly by modifying the Understanding concerning procedures for appointment, as follows:

“Procedures for Appointment of International Authorities

“(a) A national Office or an intergovernmental organization (“Office”) seeking appointment is strongly recommended to obtain the assistance of one or more existing International Authorities to help in the assessment of the extent to which it meets the criteria, prior to making the application.

“(b) Any application for appointment of an Office as an International Authority is to be made well in advance of its consideration by the PCT Assembly so as to allow time for an adequate review by the Committee for Technical Cooperation (PCT/CTC). The PCT/CTC should meet as a true expert body at least three months in advance of the PCT Assembly, if possible back-to-back with a session of the PCT Working Group (usually convened around May/June of any given year), with a view to giving its expert advice on the application to the PCT Assembly.

“(c) Consequently, a written request to the Director General to convene the PCT/CTC is to be sent by the Office preferably by March 1 of the year in which the application is to be considered by the PCT Assembly and in any case in time to allow the Director General to send out letters of convocation of the PCT/CTC not less than two months prior to the opening of the session.

“(d) Any such application should be made on the understanding that the Office seeking appointment must meet all substantive criteria for appointment at the time of the appointment by the Assembly and is prepared to start operation as an International Authority as soon as reasonably possible following appointment, at the latest around 18 months following the appointment. With regard to the requirement that the Office seeking appointment must have in place a quality management system and internal review arrangements in accordance with the common rules of international search, where such system is not yet in place at the time of the appointment by the Assembly, it shall be sufficient that such system is fully planned and, preferably, that similar systems are already operational in respect of national search and examination work to demonstrate the appropriate experience.

“(e) ~~Any document by the Office in support of its application~~ A complete application for appointment for consideration by the PCT/CTC should be submitted to the Director General at the latest two months prior to the opening of the session of the PCT/CTC using the standard form set out [in an Annex to the report of the PCT Assembly]. The application should contain all the information indicated as mandatory within the notes to that form. Where questions in the form are not relevant to the application, the Office should, where appropriate, replace the questions with alternatives which serve an equivalent purpose.

“(f) Any such application is then to be submitted to the PCT Assembly (usually convened around September/October of any given year), together with any advice given by the PCT/CTC, with a view to deciding on the application.”

16. *The Working Group is invited:*

(i) to consider and decide whether to recommend to the PCT Assembly that it should adopt a standard form for application for appointment of an Office as an International Authority, based on the draft application form set out in the Annex to this document and taking into account the issues referred to in the comments in that Annex and in paragraph 14, above;

(ii) if so recommended to the Assembly, to recommend to the PCT Assembly which parts of such a form should be mandatory for use by an applicant Office; and

(iii) if so recommended to the PCT Assembly, to recommend to the PCT Assembly that it modify its Understanding concerning procedures for appointment as set out under paragraph 15, above.

[Annex follows]

ANNEX

DRAFT APPLICATION FORM

**APPLICATION FOR APPOINTMENT AS AN INTERNATIONAL SEARCHING
AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT**

[Only the questions in Sections ~~1 and 2 (concerning procedural issues and minimum requirements for appointment)~~ [Sections to be agreed] are mandatory. The questions in the other sections are examples of the type of information which may be useful to allow members of the PCT Committee for Technical Cooperation to form a rounded view of the Office and its application and may be omitted, varied or supplemented according to the particular circumstances of the Office.]

[COMMENT: Several responses to the Circular indicated that parts of the form going beyond Sections 1 and 2 should be mandatory (though with some variation in the details in order for an Office to provide information serving an equivalent purpose but more appropriate to the specific situation of the applicant Office). If the Form is to be adopted as a required part of the application process, the Working Group should make a clear recommendation on what is mandatory and what is optional.]

1 – GENERAL

(a) Name of Office or intergovernmental organization:

(b) Date on which application for appointment was received by the Director General: *[to be filled in by the International Bureau – this may need to distinguish between the dates of a request to convene the PCT/CTC and the date on which this form and any accompanying material was received]*

(c) Session of the Assembly at which appointment is to be sought:

(d) Expected date at which operation as ISA/IPEA could commence:

(e) Existing ISA/IPEA(s) assisting in assessment of extent to which criteria met:
[Indicate the Authority or Authorities assisting your Office seeking appointment if your Office has followed the recommendation in paragraph (a) of the Procedures for Appointment of International Authorities adopted by the PCT Assembly (paragraph 25 of document PCT/A/46/6).]

2 – SUBSTANTIVE CRITERIA: MINIMUM REQUIREMENTS FOR APPOINTMENT

2.1 – SEARCH AND EXAMINATION CAPACITY

(a) Rules 36.1(i) and 63.1(i): *The national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out searches and examinations.*

(i) Employees qualified to carry out search and examination:

Technical field	Number (in full-time equivalent)	Average experience as examiners (years)	Breakdown of qualifications
Mechanical			
Electrical/electronic			
Chemistry			
Biotech			
<i>Total</i>			

[The above breakdown is intended to show the fields to which the examiners are currently assigned, even though some may be qualified also to work in others. Where the examiners are split between different Offices, subject to working arrangements other than direct employment, not all examiners expected to be made available for PCT work, or other special arrangements apply, details should be provided as additional columns of the table or explanatory text below.]

[COMMENT: One International Authority suggested that the column for a breakdown of qualifications was essentially a matter of policy and could be deleted.]

(ii) Training Programs

*[Give a **summary** details of the training programs for new examiners and ongoing training activities for existing examiners, covering general search and examination, special subject matters and training of trainers, including typical times spent on training.]*

[COMMENT: One Office acting as an International Authority suggested that a reasonable level of detail would be required in order to provide the appropriate level of confidence. However, the International Bureau is unable to offer a proposal which would more accurately convey the actual level of detail which States might require.]

(b) Rules 36.1(ii) and 63.1(ii): That Office or organization must have in its possession, or have access to, at least the minimum documentation referred to in Rule 34, properly arranged for search purposes, on paper, in microform or stored on electronic media.

(i) Access to the minimum documentation for search purposes:

- Full access
- Partial access (indicate areas currently missing and how you intend to obtain access to the missing areas)

(ii) Search systems:

[Indicate ~~if~~ the systems (databases or paper collections) used for search of different forms of prior art. The scope of coverage of databases should be indicated if this is not either well known or obvious from the context.]

[COMMENT: One Office acting as an International Authority pointed out that the focus in this question should be the databases which are available, rather than the IT systems through which they may be accessed, though of course in some cases it may be difficult to separate the two.]

(c) Rules 36.1(iii) and 63.1(iii): That Office or organization must have a staff which is capable of searching and examining the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated.

(i) Language(s) in which national applications may be filed and processed:

(ii) Other languages in which large numbers of examiners are proficient:

[Preferably, indicate numbers and the technical fields in which the proficiencies are available.]

[COMMENT: One response to the Circular pointed out that the above two questions were not in line with the wording found in Rules 36.1(iii) and 63.1(iii). Those rules relate to the ability to search in the languages of the minimum documentation. The intention of this question was to identify the range of languages in which the Office could be seen to have direct expertise, leaving it to the reader to compare this with the requirements of the minimum documentation. In the view of the International Bureau, limiting the questions specifically to the languages of the minimum documentation would risk the Office failing to demonstrate that it may have useful searching abilities going beyond the minimum requirements. However, suggestions for alternative questions are welcome.]

(iii) Services available to assist search or understanding of prior art in other languages:

[Examples might include machine translation integrated into search services or access for examiners, as required, to language specialists.]

2.2 – QUALITY MANAGEMENT

Rules 36.1(iv) and 63.1(iv): That Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international search,

(i) National quality management system: *[Please attach a QMS report according to the template used by International Authorities indicating the extent to which the national quality management system meets the requirements of Chapter 21 of the PCT International Search and Preliminary Examination Guidelines and, where relevant, the adjustments which have been planned to ensure that the system will meet the requirements for operation as an International Authority. Include information concerning whether the standard is externally reviewed in conformance with ISO 9001 or other international standard, and for how long the system has been in operation. If applying as an international organization consisting of a group of national Offices, give details of the systems which apply at each national Office.]*

(ii) If applying as an international organization consisting of a group of national Offices, outline the arrangements to ensure appropriate distribution, and consistent timeliness and quality of reports:

3 – INTENDED SCOPE OF OPERATION

(a) Language(s) in which services would be offered:

(b) State(s) or receiving Office(s) for which Authority would offer to be competent:

(c) Limitations on scope of operation:

(d) Other International Authorities which would remain competent for applications filed at the Office in its capacity as receiving Office:

[COMMENT: One response to the Circular indicated that it would assist assessment of the benefit to the system as a whole if the Office were to indicate whether appointment as an International Authority would be adding to or changing the options available to applicants.]

4 – STATEMENT OF MOTIVATION

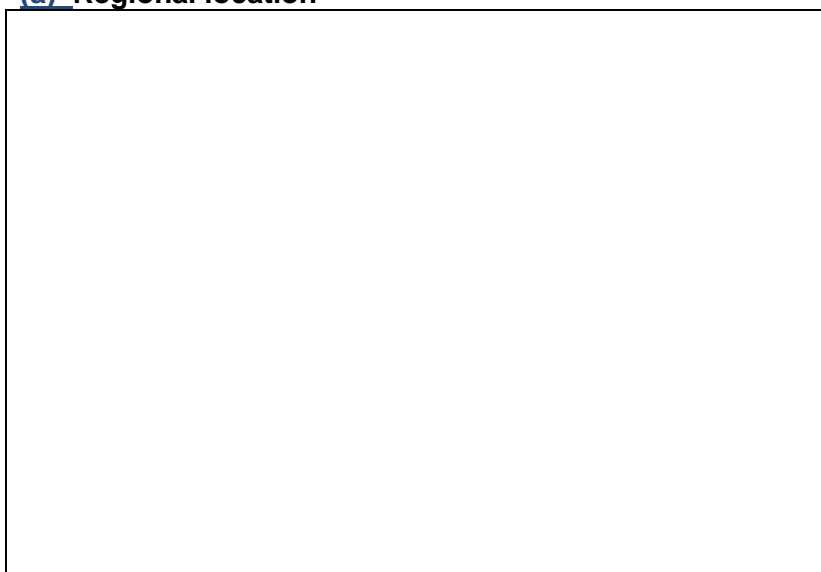
[Brief indication of reasons for applying, including what benefits the Office expects appointment to bring to: (i) its State or region, (ii) itself, and (iii) the PCT system as a whole.]

5 – APPLICANT STATE(S)

[This section is intended to provide information on the likely levels of local demand for services of the Office if appointed and on the general level of support which is provided to innovation and related issues by the relevant government(s). Where the applicant Office is an intergovernmental organization or a national Office which does not intend to offer services to its own nationals and residents, this may not be relevant. In these cases, the section can be either omitted or replaced by alternative information which better serves the intended function.]

[COMMENT: Several responses to the Circular pointed out that the questions in this section would be irrelevant in certain situations. The International Bureau agrees with this, but still considers that the underlying issues are ones which are valid for States to consider when deciding whether an Office should be appointed. The above explanatory note is therefore proposed, though alternative questions which more clearly address the issues would be a better solution if they could be identified and agreed.]

(a) Regional location



[Map showing State(s) and neighboring States]

(b) Regional organization memberships:

(c) Population:

(d) GDP per capita:

(e) Estimated national R&D expenditure (% of GDP):

(f) Number of research universities:

(g) Summary of national patent information network (for example patent libraries, technology and innovation support centers):

(h) Major local industries:

(i) Major trading partner States:

(j) Other key information: [for example summary of or link to national innovation strategies or regional development plans involving IP]

6 – PROFILE OF PATENT APPLICATIONS

[COMMENT: This section was intended to provide information covering the Office's demonstrated expertise through having processed applications across all fields of technology. As most International Authorities are initially used largely by nationals and residents of their own States, in combination with information provided in Section 2, this information also gives an indication of the capacity to absorb further work without risk of introducing major delays for either national or international work. Some responses indicated that this information would be very important for assessing the suitability of the Office; others suggested that the section was not relevant to appointment and should be deleted.]

(a) Number of national applications received – by technical field

Year \ Technical Field	n-5	n-4	n-3	n-2	n-1
Mechanical					
Electrical/electronic					
Chemistry					
Biotech					
<i>Total</i>					

[Breakdowns need not be in the above form, but should give a general idea of the distribution of work within the Office and be compatible with the indication of fields of expertise of examiners, below. More detailed breakdowns such as using the 35 fields of technology in the WIPO IPC – Technology concordance table¹ could be considered. Brief explanations of methodology may be useful.]

¹ http://www.wipo.int/ipstats/en/statistics/technology_concordance.html

(b) Number of national applications received – by route

Route \ Year	n-5	n-4	n-3	n-2	n-1
National first filing/internal priority					
Paris priority					
PCT national phase entry					

(c) Number of international applications received ~~as RO~~ from nationals and residents of the State(s).

[COMMENT: One response to the Circular pointed out that as an indicator of likely demand, applications filed by nationals and residents at other receiving Offices, such as the International Bureau, should be taken into account.]

Technical Field \ Year	n-5	n-4	n-3	n-2	n-1
Mechanical					
Electrical/electronic					
Chemistry					
Biotech					
<i>Total</i>					

~~Main Offices/States in which priority is claimed from national applications:~~

[COMMENT: A number of responses to the circular suggested that the above question was not relevant. Since the International Bureau cannot find any indication of the underlying reason for which it was suggested, it is proposed to delete it.]

(d) Average time taken for national patent processing

Indicator	Measured from	Time (months)
To search		
To first examination		
To grant		

[Noting that national systems vary considerably in details such as when search and examination need to be requested, Offices frequently measure performance in different ways. The indicator should state whether it is measured from filing, priority, request for the relevant process or some other point. Where the national system includes routes with radically different effects (such as deferred examination), the indicators may be split into different categories. The Office should consider breaking the figures down by technology if there is considerable variation between fields.]

(e) National backlogs workload

Measure	Number of applications
All pending applications	
Applications awaiting search (where relevant fees paid)	
Applications awaiting first examination (where relevant fees paid)	

7 – SUPPORT REQUIRED

[Give an indication of what assistance will be sought from the International Bureau or other Contracting States in respect of completing preparations to become an International Authority, for example to train examiners or to develop IT systems to deal with new Forms, communications and workflows.]

[COMMENT: Some responses to the Circular pointed out that the International Bureau should provide assistance to Member States on a regular basis and this should not be a criterion to judge applicants. The International Bureau agrees that all Member States have a right to some form of ongoing assistance, and that some special assistance will be needed by any Office seeking appointment to prepare and check all of the systems and processes necessary to begin operations as an International Authority, as well as ensuring their ongoing maintenance and correct development. However, Contracting States should have a right to assume that an Office which states that it meets the criteria for appointment is, for the most part, capable of “standing on its own feet” and know that there will not be calls for major assistance to meet needs made urgent by the fact of appointment. The question is not intended to refer to matters of technical assistance outside of the Office’s operation as an International Authority, even though it might well be the case that a successful appointment as part of an effective national IP strategy may increase the local demand for patent applications, with a resulting need for greater assistance in these wider issues.]

8 – OTHER

[Add any additional comments which are considered relevant to the application.]

9 – ASSESSMENT BY OTHER AUTHORITIES

[The application should ideally include assessments by the Authorities referred to in section 1, which could either be included as part of the form or else submitted separately.]

[End of Annex and of document]