

Patent Cooperation Treaty (PCT) Working Group

Eighth Session
Geneva, May 26 to 29, 2015

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

Document prepared by the International Bureau

1. The Annex to this document sets out the results of the twenty-second session of the Meeting of International Authorities under the Patent Cooperation Treaty (PCT/MIA), held in Tokyo from February 4 to 6, 2015, as outlined in the Summary by the Chair. Annex II to this Summary by the Chair contains a summary of the fifth informal session of the PCT/MIA Quality Subgroup, which was held immediately prior to the Meeting of International Authorities in Tokyo on February 2 and 3, 2015.

2. *The Working Group is invited to note the results of the twenty-second session of the Meeting of International Authorities under the PCT, as set out in the Summary by the Chair (document PCT/MIA/22/22), reproduced in the Annex to this document.*

[Annex follows]

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

TWENTY-SECOND SESSION, TOKYO, FEBRUARY 4 TO 6, 2015

SUMMARY PREPARED BY THE CHAIR

(noted by the Meeting; reproduced from document PCT/MIA/22/22)

INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its twenty-second session in Tokyo from February 4 to 6, 2015.
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, the Egyptian Patent Office, the Federal Service for Intellectual Property of the Russian Federation (Rospatent), the Finnish Patent and Registration Office, the Indian Patent Office, the Intellectual Property Office of Singapore, IP Australia, the Israel Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, the National Institute of Industrial Property of Chile, the Nordic Patent Institute, the Spanish Patent and Trademark Office, the State Intellectual Property Office of the People’s Republic of China, the State Intellectual Property Service of the Ukraine, the Swedish Patent and Registration Office, and the United States Patent and Trademark Office.
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.
5. Mr. Hitoshi Ito, Commissioner of the Japan Patent Office, welcomed the participants to the Japan Patent Office for the first Meeting of International Authorities taking place in Tokyo.

ITEM 2: ELECTION OF A CHAIR

6. The session was chaired by Mr. Naoyoshi Takiguchi of the Japan Patent Office.

ITEM 3: ADOPTION OF THE AGENDA

7. The Meeting adopted the agenda as set out in document PCT/MIA/22/1 Rev. 2.

ITEM 4: PCT STATISTICS

8. The Meeting noted the presentation by the International Bureau on the most recent PCT Statistics¹.

ITEM 5: QUALITY

(A) REPORT FROM THE QUALITY SUBGROUP

9. The Meeting noted with approval the Summary by the Chair of the Meeting’s Quality Subgroup set out in Annex II to this document.

¹ Available from the WIPO web site at www.wipo.int/meetings/en/details.jsp?meeting_code=pct/mia/22

(B) MATTERS ARISING FROM THE REPORT FROM THE QUALITY SUBGROUP

10. The Meeting agreed with the recommendations contained in the Summary by the Chair from the Subgroup.

(C) FUTURE QUALITY-RELATED WORK

11. The Meeting approved the continuation of the Subgroup's mandate, including the convening of a physical meeting of the Quality Subgroup in 2016.

ITEM 6: APPOINTMENT OF INTERNATIONAL AUTHORITIES

12. Discussions were based on document PCT/MIA/22/3.

13. The Meeting:

(a) reviewed the progress of discussions in the Quality Subgroup on the issue of appointment of International Authorities; and

(b) endorsed the recommendations of the Quality Subgroup set out in paragraphs 49 to 51 of the Summary by the Chair of the Subgroup, reproduced in Annex II to this document.

ITEM 7: REVIEW OF PCT IMPROVEMENT PLANS

14. Discussions were based on document PCT/MIA/22/19.

15. All Authorities which took the floor on the matter welcomed the overview prepared by the United States Patent and Trademark Office on the various proposals for improvement of the PCT system which had been presented by the International Bureau and several national and regional Offices in the recent past, and the opportunity to comment on the five issues which had been identified by the United States Patent and Trademark Office as warranting further discussion. One Authority noted that the recognition by a designated Office of its own work when it acted as an International Authority was not listed in the document while this was a priority under the PCT Roadmap.

16. With regard to the issue of requiring a mandatory response by the applicant to any outstanding negative indications contained in the international search and preliminary examination report when entering the national phase, several Authorities, while generally recognizing the benefits, stated that they did not favor making such a requirement mandatory under the PCT, noting the heavy burden on applicants. Rather, applicants should be encouraged or invited by Offices to furnish such a response.

17. The European Patent Office stated that it had unilaterally implemented such mandatory response where it had acted as International Authority and the applicant entered the regional phase before the Office as a designated Office, and that its experience with this approach had been very positive. It encouraged other Offices to do the same and stated that it would be happy to share its experiences in a report to be submitted for information at the upcoming May 2015 session of the PCT Working Group.

18. With regard to the issue of formally incorporating the Patent Prosecution Highway into the PCT, several Authorities stated that, while they fully supported the proposal, given the opposition to this proposal by a number of Member States at the most recent session of the PCT Working Group, it might not be opportune to bring this proposal back to the Working Group at this stage; rather, for the moment, efforts should focus on enlarging the group of Offices participating in the Global PPH scheme.

19. One Authority stated that, while it recognized that PPH could be an interesting approach, it was not in a position to support the proposal at this stage. Another Authority stated that it had strongly opposed the proposal to formally integrate the PPH into the PCT during sessions of both the PCT Working Group and WIPO's Standing Committee on the Law of Patents and wished to do so also during this session of the Meeting.

20. With regard to the issue of reviewing existing reservations, notifications or declarations of incompatibility of national laws with provisions of the PCT legal framework, several Authorities updated the Meeting on recent withdrawals of such declarations or intentions to withdraw such declarations in the near future. It was noted that up-to-date information on the status of any such declarations was available on WIPO's web site.

21. With regard to the issue of issuance of a written opinion during the international preliminary examination procedure in cases where the international preliminary examination report would be negative and the applicant had made an attempt to overcome any objections, most Authorities which took the floor on the matter confirmed that this was their current practice. One Authority highlighted its positive experiences of this procedure since it had changed its approach in this regard in 2011, noting that it would sometimes even issue a second written opinion. Overall, it saw great merits in improving the attractiveness for applicants of the Chapter II procedure and encouraged other Authorities to do the same.

22. The Meeting noted the contents of document PCT/MIA/22/19.

ITEM 8: PROMOTING LINKAGE BETWEEN THE INTERNATIONAL PHASE AND THE NATIONAL PHASE

23. Discussions were based on document PCT/MIA/22/20.

24. All Authorities which took the floor on the matter welcomed the initiative taken by the Japan Patent Office to collect input and feedback from other Authorities on possible measures to further strengthen the linkage between the international and the national phase of the PCT procedure.

25. Several Authorities stated that they had already implemented a number of the proposed measures, notably those which related to the national phase of procedures.

26. Several Authorities offered their support for various proposed measures set out in the Annex to document PCT/MIA/22/20. Particular support was expressed for an optional measure (a-2) "In citing patent documents written in languages other than English, indicate the corresponding part of the patent family documents written in English, if a patent family document in the English language exists."

27. The Meeting noted the contents of document PCT/MIA/22/20. It invited the Japan Patent Office to further develop the proposal relating to possible measure (a-2) with a view to proposing a corresponding modification to the PCT International Search and Preliminary Examination Guidelines.

28. The Meeting further agreed to continue its discussions on the other possible measures set out in the Annex to document PCT/MIA/22/20 on the PCT Working Group e-forum and invited the Japan Patent Office to continue to lead those discussions.

ITEM 9: PCT DIRECT – A NEW SERVICE FOR STRENGTHENING THE USE OF THE PCT

29. Discussions were based on document PCT/MIA/22/21.

30. Several Authorities stated that they had found the new service offered by the European Patent Office to be very interesting and that they were considering offering a similar service in the future, noting that it would tie in well with related initiatives aimed at further linking the

international phase of the PCT procedure with both the “pre-PCT phase” (search and examination carried out in respect of earlier applications the priority of which is claimed in the international application) and the national phase of the PCT procedure.

31. One Authority stated that, as an Office of first filing, it was able to provide first search and examination results to the applicant within six months from the date of filing, to which applicants usually responded within two months. It therefore already had the applicant’s response on file when the application, in the form of an international application, was searched and examined by it again in its capacity as an International Authority.

32. The Meeting noted the contents of document PCT/MIA/22/21 and welcomed the envisaged extension of the PCT Direct service to receiving Offices other than the European Patent Office. It invited the European Patent Office to work with the International Bureau with a view to proposing any necessary modification to the Receiving Office Guidelines and any necessary modifications to forms or electronic filing tools.

ITEM 10: TRAINING OF PATENT EXAMINERS

33. Discussions were based on document PCT/MIA/22/5.

34. All Authorities which took the floor on the matter expressed their support in general for the initiative taken by the International Bureau aimed at better coordinating technical assistance activities around training of examiners of patent Offices in developing and least developed countries.

35. One Authority, while generally supporting the initiative, stated that it was premature to discuss possible concrete activities before the following three issues had been addressed: (i) all International Authorities needed a better understanding of examiner training programs currently being offered; (ii) the list of issues to be addressed under the initiative needed to be narrowed down; and (iii) priorities and policies had to be defined first. This Authority offered to prepare and share with other Authorities a brief outline of its own examiner training activities and invited the other Authorities to do the same. Another Authority stated that the above-mentioned issue (i) needed to be elaborated before carrying out any concrete activities.

36. Several Authorities expressed concerns with regard to the proposal that the International Bureau should develop, jointly with partner Offices, model training components and curricula, noting that the content of such components should be left to the donor Offices, and that the International Bureau should primarily act as a coordinator. On the other hand, one Authority stressed the importance of uniformity and consistency of training modules and the International Bureau should help regarding the training and contents of the programs, notably if training to examiners in one Office were to be provided by different donor Offices.

37. Several Authorities provided suggestions as to the possible content of the web platform or database to be created, such as requests for training received; training already provided; matchmaking between demand and supply; feedback on training, training material; etc. Two Authorities reported that they already were carrying out work under WIPO’s International Cooperation for Examination (ICE) program indicating that they would be happy to look into taking on more cases.

38. Several Authorities indicated that they would be happy to attend a possible donor conference, provided it was held back-to-back with another PCT-related meeting.

ITEM 11: COLLABORATIVE SEARCH AND EXAMINATION – THIRD PILOT

39. Discussions were based on document PCT/MIA/22/13.

40. All Authorities which took the floor on the matter welcomed the announcement that it was envisaged to carry out a third pilot on collaborative search and examination, noting that the first two pilots had delivered promising preliminary results.

41. The Japan Patent Office stated that it would positively consider joining the envisaged third pilot but noted, as was recognized by the other participating Offices (the European Patent Office, the Korean Intellectual Property Office and the United States Patent and Trademark Office) that more discussion was needed among the participating Offices on a number of issues, such as how many Offices collaborated in the establishment of an international search report and a written opinion, how many cases each participating Office would be required to take on during the pilot, and questions related to the language of PCT applications in respect of which the Offices would collaborate.

42. One Authority stated that, in order for collaborative search and examination to be successful, particular attention had to be paid to the issue of cost for applicants, as experience with supplementary international search had shown. Other issues to be considered included the availability of reliable machine translation tools and an IT tool to facilitate the collaboration among Authorities.

43. The Meeting noted the contents of document PCT/MIA/22/13.

ITEM 12: REVIEW OF SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

44. Discussions were based on document PCT/MIA/22/6.

45. The International Bureau provided an update to the Meeting with some preliminary observations on the responses received to Circular C. PCT 1429, reproduced in the Annex to document PCT/MIA/22/6. A summary of these responses would be included in the document for consideration by the eighth session of the PCT Working Group in May 2015. While the number of supplementary international search requests remained low, the responses indicated that the users of the service considered it to be useful in particular circumstances and there were no demands to discontinue supplementary international search at this stage. In view of the three year collaborative search and examination third pilot described in document PCT/MIA/22/6 to begin later this year, the International Bureau suggested a five year period before a further review of the supplementary international search system if the PCT Assembly were to decide on a further review of the system.

46. Despite the low use of the supplementary international search service, there were no clear views expressed on discontinuing the service at this stage. The ongoing costs of providing the service at a Supplementary International Searching Authority were minimal compared to necessary investment to begin offering supplementary international search. Those Authorities expressing a view on the suggested five year review period were favorable to this idea, but there were differences in opinion on the correlation between supplementary international search and a possible collaborative search and examination model in the PCT.

ITEM 13: PCT ONLINE SERVICES

47. Discussions were based on document PCT/MIA/22/2.

48. All Authorities which took the floor on the matter expressed their great satisfaction with the various electronic services offered by the International Bureau to support the effective and efficient operation of Offices in their various PCT capacities.

49. Authorities which already participated in one of the several trials of the eSearchCopy project confirmed that they had been very happy with the results and hoped to move from trials into "production" in the near future. Several other Authorities not yet participating in trials expressed a strong interest in joining such trials in the near future. One Authority stated that it

would very soon commence such trials with a number of receiving Offices and hoped that those trials would indeed confirm the expected benefits, notably with regard to the more timely submission of search copies to Authorities.

50. Authorities which, in their capacity as receiving Offices, were offering ePCT filing and were using ePCT for Offices equally expressed their great satisfaction with those ePCT components. One Authority stated that, although it had only begun offering ePCT filing in December 2014, ePCT filing already made up more than half of applications filed. Several other Authorities stated that national security provisions prevented them, in their capacity as receiving Offices, from offering ePCT filing to applicants. In this context, one Authority suggested to modify ePCT so as to allow for the upload of a foreign filing license when filing an international application. One Authority emphasized the importance for Offices to be closely involved in the phasing out of legacy systems, notably PCT-SAFE, and the need for a good transition to the new services.

51. One Authority stressed the importance of well-functioning machine-to-machine transmissions and expressed its strong interest in working with the International Bureau to ensure that Offices' needs were taken into account in the development of the new ePCT web services, notably as they related to the security aspects of such transmissions.

52. Several Authorities expressed a strong interest in the ongoing search fee transfer pilot between the United States Patent and Trademark Office, the European Patent Office and the International Bureau, and in extending this approach to other pairs of Offices, noting the benefits such transfer would bring to both receiving Offices and Authorities, notably if combined with the electronic transmission of search copies via the International Bureau. It was noted that the possible transfer of search fees via the International Bureau was the subject of a PCT Circular (C.PCT 1440). One Authority expressed its concern about making a centralized payment option available under ePCT and stated that fee payments should continue to be handled by receiving Offices.

53. Noting the clear benefits for all, Authorities generally welcomed ongoing efforts to move to XML-based search and examination reports and to generally move to exchange XML data rather than images of forms. However, it was noted that the current IT systems of many Authorities did not yet allow those Authorities to deliver such XML reports and data. One Authority stated that it had a strong interest in obtaining search and examination reports in XML once the International Bureau received those from other Authorities, as it could then stop OCRing them and thus save costs.

ITEM 14: TRANSMITTAL BY THE RECEIVING OFFICE OF EARLIER SEARCH AND/OR CLASSIFICATION RESULTS TO THE INTERNATIONAL SEARCHING AUTHORITY

54. Discussions were based on document PCT/MIA/22/4.

55. Several Authorities stated that, in view of the late submission of the document, they required more time to study the proposal in more detail. Both the Korean Intellectual Property Office and the European Patent Office invited Authorities to communicate comments on the proposal to them by e-mail.

56. All Authorities which took the floor on the matter stated that, while they in general supported the goals of the proposal, there were several issues which required further consideration. Issues raised by Authorities included:

- (a) language issues and translation requirements where the results of the earlier search were in a language different from the international application;

- (b) how the receiving Office could be aware whether or not earlier search or classification results could already be available to the International Searching Authority “in a form and manner acceptable to it”;
- (c) confidentiality requirements with regard to earlier search and classification results relating to unpublished applications, in particular where the national law applicable in an Office required the specific authorization by the applicant to share such results with others, not addressed by the provisions proposed under proposed new Rule 23*bis*.2(d);
- (d) whether it was useful to transmit earlier classification results based on the CPC rather than the IPC;
- (e) the additional burden on receiving Offices;
- (f) the way in which the “reservation” provision was drafted, noting that it would make the effectiveness of the reservation by a receiving Office in essence dependent on an action by the applicant; and
- (g) whether search strategies would be included in the earlier search results to be transmitted to the International Searching Authority.

57. The Korean Intellectual Property Office and the European Patent Office responded to most of these questions and agreed to elaborate on them further in the document to be presented at the PCT Working Group in May 2015.

58. The Meeting noted the contents of document PCT/MIA/22/4 and invited the Korean Intellectual Property Office and the European Patent Office to further develop the proposals for presentation to the PCT Working Group, taking into account the comments above and any further comments they might receive in the coming weeks.

ITEM 15: REQUIREMENTS UNDER RULE 6.4

59. Discussions were based on document PCT/MIA/22/17.

60. All Authorities which took the floor on the matter supported the proposals to modify the International Search and Preliminary Examination Guidelines as set out in paragraphs 1 to 3 of the Annex to the document. The proposals set out in paragraphs 4 and 5 of the Annex to the document required further discussion. In particular, Authorities expressed divergent opinions on which of the alternatives in paragraph 4 would be preferable.

61. The International Bureau stated that it would be happy to work together with the Korean Intellectual Property Office to help prepare a further revised proposal for consultation with International Authorities on modifications to the International Search and Preliminary Examination Guidelines by way of a PCT Circular.

ITEM 16: PCT MINIMUM DOCUMENTATION

(A) DEFINITION AND EXTENT OF PATENT LITERATURE

62. Discussions were based on document PCT/MIA/22/7.

63. All Authorities which took the floor on the matter supported the proposed reactivation of the PCT minimum documentation task force to further discuss the proposal for the wider documentation of national patent collections.

64. One Authority emphasized the need for bibliographic data to be in text format in accordance with WIPO Standards ST.36 and ST.96. Another Authority underlined that the minimum documentation had to be freely accessible to IP Offices for bulk download and that bibliographic data, the abstract and citation information had to be provided in English. One

Authority suggested to also address the following issues in the task force, in addition to those outlined in paragraph 10 of the document: media-less exchange of documents, the open distribution of patent information and the possible addition of utility model collections to the PCT minimum documentation.

65. The Meeting welcomed the proposed reactivation of the PCT minimum documentation task force and agreed that the appropriate next steps would be investigation of the subjects set out in paragraph 10 of document PCT/MIA/22/7.

(B) ADDITION OF INDIAN TRADITIONAL KNOWLEDGE DIGITAL LIBRARY

66. Discussions were based on document PCT/MIA/22/8 and a presentation given by a representative from the Indian Council of Scientific and Industrial Research.

67. All Authorities which took the floor on the matter supported in principle the proposal to add the Indian Traditional Knowledge Digital Library (TKDL) to the PCT minimum documentation, noting that it would greatly enhance the quality of international search, as confirmed by those Authorities which had already been given access to the TKDL.

68. Several Authorities expressed concerns about certain provisions contained in the draft access agreement set out in Annex II to the document, notably in relation to the confidentiality and non-disclosure requirements, the necessity to monitor and report statistics on the use of citations from the TKDL, and the implications for an International Searching Authority losing access to the full PCT minimum documentation if the access agreement to the TKDL was terminated under the termination provisions of the draft agreement. One Authority emphasized the importance for Authorities to be able to load the data from the TKDL into the Authorities' own IT systems. One Authority stated that if added to the PCT minimum documentation, the TKDL should have the same level of access as other collections in the PCT minimum documentation and should be equally available to the applicant. The Representative of the Indian Council of Scientific and Industrial Research clarified that this access would be available as per the terms and conditions of the TKDL access agreement, which provided for uninterrupted access to the TKDL.

69. The International Bureau stated that it would be happy to closely work with the Indian Patent Office and the Indian Council of Scientific and Industrial Research in the coming months with a view to finding appropriate arrangements, to be set out in the draft access agreement, which would be acceptable to all International Searching Authorities and thus allow all of them to agree to the addition of the TKDL to the PCT minimum documentation. Agreement by all Authorities did not have to wait for another year until the next Meeting of International Authorities but could also be achieved by consulting with Authorities in the coming months through PCT Circulars.

(C) NON-PATENT LITERATURE UNDER THE PCT MINIMUM DOCUMENTATION

70. Discussions were based on document PCT/MIA/22/18 and a presentation given by the Indian Patent Office.

71. All Authorities which took the floor on the matter expressed the view that it would appear very difficult to get the more than 30 different publishers of non-patent literature (NPL) to agree to make NPL data available in a particular format for inclusion in the PCT minimum documentation. This would incur additional costs to the publishers and would bring very little, if any, benefit to them. The European Patent Office had experience of these difficulties from its efforts to obtain data from NPL publishers in an ST.36-like format for inclusion in the EPO's EPOQUE system. Several Authorities further questioned whether it would be desirable to exclude useful documents from the PCT minimum documentation simply because publishers were not willing to provide such documents in a particular format. The European Patent Office also emphasized the need to update the current list of journals defining the PCT minimum documentation for NPL.

72. The Meeting agreed to refer the question of the format of non-patent literature to the PCT minimum documentation task force for further consideration.

73. The International Bureau stated that it would be preferable if an Authority could take the lead in the task force and invited interested Authorities to contact the International Bureau.

ITEM 17: PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

74. Discussions were based on document PCT/MIA/22/9.

75. All Authorities which took the floor on the matter recognized the need to promulgate the modifications to the International Search and Preliminary Examination Guidelines which had been agreed among Authorities as soon as possible. However, it was also noted that there was a need for a final check by Authorities of the text of the Guidelines in the form in which there were intended to be promulgated. It was thus agreed to have a final brief round of consultations by way of a PCT Circular before promulgation of the final text.

76. One Authority stated that the International Search and Preliminary Examination Guidelines should be precise and avoid mere repetition of the relevant provisions in the Regulations. This Authority looked forward to further discussions by the Meeting next year to this effect.

77. Another Authority, referring to paragraph 19.12.05 of the International Search and Preliminary Examination Guidelines, urged other Authorities to perform a top-up search during international preliminary examination that covered all prior art that could be relevant documents under Rule 64.

78. The Meeting noted the contents of document PCT/MIA/22/9. It requested the International Bureau to initiate a final round of consultations on the International Search and Preliminary Examination Guidelines in the form in which they were intended to be promulgated, for a quick final review by Authorities before promulgation in the second quarter of 2015.

ITEM 18: PCT SEQUENCE LISTING STANDARD

79. Discussions were based on document PCT/MIA/22/10.

80. All Authorities which took the floor on the matter supported the adoption of WIPO Standard ST.26 and the proposed roadmap set out in the Annex to the document.

81. The Meeting noted the contents of document PCT/MIA/22/10.

ITEM 19: REVISION OF STANDARD ST.14

82. Discussions were based on document PCT/MIA/22/11.

83. The Meeting noted the contents of document PCT/MIA/22/11.

ITEM 20: COLOR DRAWINGS

84. Discussions were based on document PCT/MIA/22/12.

85. Although some Authorities indicated that they would be in a position to adapt their IT systems to be able to process applications with color drawings within one year or less, other Authorities stated that it would not be possible to have the systems in place, as had been envisaged, by July 2016 and gave preliminary indications that at a minimum of two years or more would be needed before the implementation of a solution to process color drawings would be possible.

86. One Authority referred to the ongoing work on color drawings in the IP5 Working Group 2 and proposed to continue technical level discussions to better coordinate the transition to color. This Authority also indicated that it would communicate further information on the format of color drawings to the International Bureau. One Authority stated that the handling of color drawings was being addressed during its accession to the Hague Agreement. Another Authority requested the International Bureau to provide sample data packages to enable it to start testing a possible solution within the Office.

ITEM 21: CLARIFYING THE PROCEDURE REGARDING THE INCORPORATION BY REFERENCE OF MISSING PARTS

87. Discussions were based on documents PCT/MIA/22/14 Rev. and 14 Add.

88. Several Authorities supported the proposed compromise solution set out as Option B in document PCT/MIA/22/14 and further refined in document PCT/MIA/22/14 Add. to amend the PCT Regulations to require receiving Offices to permit the incorporation by reference for the purposes of the international phase only. This would provide the applicant with a “bridge” into the national phase before those designated Offices which, under their national laws, allowed the incorporation by reference where the applicant had erroneously filed the wrong set of claims or the wrong description. Several drafting suggestions were offered in case that Option B were to be agreed upon.

89. One Authority strongly opposed the proposed compromise solution, stating that the incorporation by reference of an entire set of claims or an entire drawing as a missing part was clearly covered not only by the spirit and intent but also by the wording of the current Regulations. The compromise solution would offer nothing to applicants from Member States whose Offices already today allowed such incorporation by reference both in their capacity as receiving Offices and designated Offices and would only benefit applicants from those Member States whose Offices did not do so. It suggested, as an additional Option C, to amend the Regulations to clarify that such incorporation was to be allowed, with effect for both receiving Offices and designated Offices.

90. It was recognized that one of the root causes of the divergent views and practices on the issue of incorporation by reference of an entire set of claims or an entire description as a missing part might be the differences in approach taken in the Patent Law Treaty (PLT) and the PCT with regard to reference filings (under the PLT) and incorporation of missing elements and parts (under the PCT).

91. Authorities agreed that, as there was no consensus on the issue and that the current divergent practices of receiving Offices and designated Offices would thus continue to exist, it was important to raise the awareness of applicants about those divergent practices and the possible consequences for applications during both the international and national phases of the PCT procedure. In this context, it was also agreed to review the Receiving Office Guidelines with a view to clarifying those divergent practices of receiving Offices.

ITEM 22: SAME DAY PRIORITY CLAIMS

92. Discussions were based on document PCT/MIA/22/15.

93. All Authorities which took the floor on the matter stated that they agreed with the analysis by the International Bureau as set out in document PCT/MIA/22/15.

94. Several Authorities stated that the preferred option would be to refer the matter to the Paris Union Assembly with a view to seeking a common interpretation of Article 4 of the Paris Convention. However, it was recognized that it was unlikely that the Paris Union would agree on such a common interpretation; even if it did, a formal revision of the Paris Convention would be a cumbersome and lengthy procedure and might be considered disproportionate to the size of the problem. Among those Authorities, views differed whether to at least amend the

PCT Regulations so as to require all receiving Offices to not cancel any same day priority claims so as to prepare the ground for later decisions on the matter by designated Offices on the basis of their national laws, or whether to do nothing and to leave the situation as it is today.

95. Other Authorities suggested that the matter should be referred to the Paris Union Assembly in any case and that, pending a decision by the Paris Union Assembly, an amendment of the PCT Regulations should be considered so as to at least deal with the issue for the purposes of the international phase.

96. One Authority expressed the view that the PCT Regulations should be amended to provide that same day priority claims should not be permitted.

97. One Authority stated that, in its capacity as a receiving Office, it accepted same day priority claims, noting that the PCT Regulations had been amended in 2007 to allow for the restoration of the right of priority and that, in that context, the express requirement that an earlier application, the priority of which was claimed in the international application, had to be filed "prior to the international filing date" had been deleted. It did not, however, accept same day priority claims as a designated Office, nor in respect of direct national filings.

ITEM 23: MISSING IPC CLASSES FROM INTERNATIONAL PATENT APPLICATIONS

98. Discussions were based on document PCT/MIA/22/16.

99. Authorities welcomed the solutions proposed in the document to help identify applications with missing IPC classes for the Authority to communicate the classification codes, even if some Authorities were already transmitting this data to the International Bureau by email. The solutions proposed in the document based on ePCT and on PCT-EDI both received support for further development. One Authority did, however, consider that expediting the transmission of the search copy, along with any IPC classes that had already been applied by the receiving Office, would be more effective in reducing numbers of applications reaching international publication without any IPC classification codes.

ITEM 24: FUTURE WORK

100. The Meeting noted that the next session was expected to be convened in the first quarter of 2016, immediately following a meeting of the Quality Subgroup. The Meeting was pleased to receive an offer by the Representative of the National Institute of Industrial Property of Chile to host the 2016 sessions of the Meeting of International Authorities and of the Quality Subgroup in Chile.

[Annex I to document PCT/MIA/22/22, containing a list of participants, is not reproduced here]

[Annex II (to document
PCT/MIA/22/22) follows]

ANNEX II (to document PCT/MIA22/22)

PCT/MIA QUALITY SUBGROUP, FIFTH INFORMAL SESSION
TOKYO, FEBRUARY 2 AND 3, 2015

SUMMARY BY THE CHAIR

OPENING OF THE SESSION

1. Mr. Yoshitake Kihara, Deputy Commissioner of the Japan Patent Office opened the session and welcomed the participants. Mr. Masahiro Nishina, Director, Quality Management Office, Administrative Affairs Division, Japan Patent Office chaired the session.

1. QUALITY MANAGEMENT SYSTEMS

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

2. Authorities expressed appreciation for the compilation and summary of the complete collection of Quality Management Systems reports for 2014 and were satisfied to continue with the current reporting mechanism. Authorities were further satisfied with using the current template, indicating changes from the previous year, for future reporting on their Quality Management Systems.

3. Authorities were content to continue the sharing of quality policies and guidelines, information on sampling of cases in quality assurance process and checklists used in quality assurance processes. In particular, it was considered useful to see the checklists of other Authorities and how these were being used in practice.

4. One Authority stated that it wished to learn more about how other Authorities used quantitative metrics. In reply, several Authorities shared their experiences on their quantitative goals, which could exist at various levels in the Quality Management System; while, in some Authorities, they were for internal use only, others made them available on their web site.

5. One Authority suggested an amendment to paragraph 21.08 of the PCT International Search and Preliminary Examination Guidelines (“the Guidelines”) by adding a requirement for an Office to regularly review its quality policy as well as its quality objectives. In response to this suggestion, the International Bureau indicated its intention to publish a consolidated set of the Guidelines in the coming months; any proposals for further modifications could be collected with a view to consulting on these by way of a PCT Circular.

6. The Subgroup recommended:

(a) to continue reporting on existing Quality Management Systems of Authorities using the present reporting mechanism, indicating changes from the previous year;

(b) to continue the sharing of quality policies and guidelines, information on the sampling of cases in quality assurance processes, and checklists in quality assurance processes, and encouraged Authorities which had not already done so to upload this information onto electronic forum; and

(c) that Authorities should provide any suggestions for further modifications to the Guidelines to the International Bureau to be able to consult all Authorities through a PCT Circular, following promulgation of a consolidated version of the Guidelines in the near future.

(B) QUALITY MANAGEMENT SYSTEMS IN INTERNATIONAL AUTHORITIES

7. The European Patent Office delivered a presentation on its Quality Management System, which it had adapted as part of attaining ISO 9001:2008 certification in 2014 for its patent granting process. The Japan Patent Office gave a presentation on its Quality Management System for patent examination documented in the Quality Management Manual, published in August 2014.

8. For future sessions of the Subgroup, the European Patent Office suggested that discussions among Authorities on existing quality management systems should now move beyond Authorities merely reporting on their existing systems and focus on specific quality management activities carried out by Authorities with a view to learning from each other's experiences. As a first step, it proposed that one or two topics should be selected for discussion at the next session of the Subgroup. Authorities would be expected to post individual papers on their experiences with the selected topics on the electronic forum, with a view to preparing a detailed discussion by the Subgroup at its next session. In order of preference, the European Patent Office proposed that user feedback, quality assurance and quality metrics could be discussed next year.

9. All Authorities which took the floor on the matter welcomed the proposal in principle, but noted that further discussion on the electronic forum was necessary in the coming months to decide on the topic or topics for next year's session.

10. The Subgroup recommended that the European Patent Office should lead discussions on the electronic forum as to which topics of the Quality Management Systems should be discussed in detail at next year's session. This should be decided by the Subgroup within the next three months to allow adequate time for Authorities to submit material on their own experiences before the next session.

2. BETTER UNDERSTANDING THE WORK OF OTHER OFFICES

(A) SEARCH STRATEGIES PROPOSAL FOR IMPLEMENTATION OF PUBLICATION DATA RELATED TO SEARCH STRATEGY IN THE PCT FRAMEWORK

(B) SEARCH STRATEGIES

(C) PRINCIPLES FOR RECORDING SEARCH STRATEGIES

11. Sub-items (a), (b) and (c) were discussed together.

12. Authorities agreed that information on search strategies should be made public, but there were different views as to the level of detail that should be provided. Factors to be considered included the examiner resources required to clean up search histories in order to record strategies, the potential for automatically generating this information and translating queries if needed, and the target user of this information.

13. Some Authorities expressed support for a proposal from the European Patent Office for the sharing of information on search strategy databases, classification symbols and keywords only, information which could be automatically extracted from a search history for inclusion in a sheet separate from but formally part of the international search report. This would begin with a pilot to evaluate the technical implementation for the delivery of this information. These Authorities believed that the target user should be the applicant only, who would prefer a concise list of terms rather than a detailed search history. Other Authorities believed that all users must be considered and this included patent examiners so as to promote and facilitate work sharing.

14. Some other Authorities, however, believed in a fuller transparency and recommended sharing of more detailed information, including the databases, the terms used in a search, how these terms were combined to form a search query and how the results of each query were combined, with optional sharing of further information, such as indicating which query results were viewed by the examiner. These Authorities, in general, were sharing their search strategies on the PATENTSCOPE database and encouraged other Authorities to do the same.

15. Some Authorities also raised the matter of the translation of keywords from the original search query language if this was not part of Form PCT/ISA/210, and the extent of duplication of work beyond the existing information included in Form PCT/ISA/210. Other Authorities were of the view that keywords should not be translated, in part due to machine translation inaccuracies, and that it was easier to render search strategy data on a separate sheet rather than in Form PCT/ISA/210.

16. The Subgroup recommended, following a suggestion by the United States Patent and Trademark Office, to follow a three-track process for Authorities to follow in the sharing of search strategies, as follows:

- (a) a group of Authorities would continue with the existing process of recording the information required in Form PCT/ISA/210, ensuring that this is completed properly;
- (b) a group of Authorities would join a pilot project led by the European Patent Office to record databases, classification symbols and keywords as a separate Annex to the international search report; and
- (c) a group of Authorities would provide full search records in whatever format they produced them for sharing on PATENTSCOPE.

17. The United States Patent and Trademark Office suggested that the International Bureau should at some point conduct a survey to determine the most useful form and content for search records. The survey would be provided to select applicants across technology areas, Offices in their capacity as International Preliminary Examining Authorities and designated Offices, and user groups. The survey should provide sample application numbers and ask specific questions so that the optimum content and format could be determined. In response to this proposal, and taking due account of the fact that there was no consensus on the objectives set for the publication of search strategies, the European Patent Office was of the view that it was more appropriate that each of the groups listed in paragraphs 16(a) to (c), above, would assess the results of the pilot or practice in view of their respective objectives.

(D) STANDARDIZED CLAUSES

18. Authorities welcomed the standardized clauses agreed upon by Authorities at the previous session and subsequent consultations. It was reaffirmed that their use should be optional, both with regard to their use in general as well as with regard to the use by Authorities wishing to use only some but not all of the clauses. Some Authorities provided information on their intention to begin using the clauses when they had been incorporated into their IT systems and noted the recent availability of the clauses in French and Spanish in addition to English. Other Authorities, while generally noting only minor differences with their own clauses, did not intend to move to using the standardized clauses in the near future.

19. The Subgroup accepted an offer of the Canadian Intellectual Property Office to manage a dedicated page to be established on the Subgroup's electronic forum to provide information on which Authorities were using the clauses and share experiences on their implementation.

20. The Subgroup recommended a period of at least one year during which Authorities using the clauses could gain experience with the clauses before obtaining wider feedback and elaborating whether the standardized clauses should be expanded to cover other areas.

3. QUALITY IMPROVEMENT MEASURES

(A) UNITY OF INVENTION

21. IP Australia presented a proposal to revise the International Search and Preliminary Examination Guidelines in order to improve explanations and examples for lack of unity, based on comments and existing training material provided by other Authorities, following discussion of this issue at the 2014 session of the Subgroup. In essence, the proposal was to leave the existing examples unchanged, but to rearrange them with a view to moving them into several different categories, supplemented by a few proposed new examples where it was felt that more clarity and guidance beyond what was presently provided for in the Guidelines was required.

22. Many Authorities which took the floor on the matter supported the proposal in principle. Others stated that all of the proposed changes would find their agreement.

23. One Authority stated that, while it was generally supportive of the proposal, it felt the need to also carefully review all of the existing examples; it further noted that further modifications to the introductory paragraphs of Chapter 10 of the Guidelines would be needed should the proposal to move the examples into several different categories be implemented.

24. The Subgroup recommended that discussion of the proposals among Authorities should continue on the Subgroup's e-forum, including proposals for a possible revision of the existing examples, the new examples proposed by IP Australia and the proposed categorization. If and when sufficient progress had been made, further more formal consultations should be carried out on the basis of a PCT Circular.

25. IP Australia stated that it would be happy to continue to lead this exercise, provided that it did not result in too much additional work given limited resources. In such a case, it would seek to address the issue as to how best to move forward with this exercise via the e-forum.

(B) MECHANISM FOR FEEDBACK AND ANALYSIS OF INTERNATIONAL SEARCH REPORTS AND WRITTEN OPINIONS OF THE INTERNATIONAL SEARCHING AUTHORITY

26. The Japan Patent Office presented the preliminary findings of a pilot study it had carried out jointly with the Swedish Patent and Registration Office. The study looked at a framework where, following the first office action in the national phase, the designated Office would give feedback on the written opinions and international search reports established by the International Authority. The International Authority would then analyze and utilize the feedback and share the results of the analysis with the designated Office.

27. The findings showed that, while there were many cases in which there were no discrepancies between the search and examination results of the Authority and the designated Office, in some cases the designated Office had carried out additional searches and found new citations that had not been presented in the international search report. On the other hand, in some of those cases the designated Office had preferred to cite other documents that were written in the same language as that used in the documents filed by the applicant. The findings had also raised some concerns as to the additional work load for examiners participating in the pilot, noting that it took about 60 minutes to fill in the required feedback forms. Despite these issues, both Offices had come to the conclusion that the pilot had been very useful in the context of evaluating quality of the work products of an Authority and of the designated Office. Noting the small number of applications which formed the basis of the pilot, both Offices had

agreed to continue the pilot so as to gain more experience and data for an appropriate analysis. Furthermore, it was hoped that the workload for examiners could be brought down to a more appropriate level by further simplifying forms and/or automating procedures.

28. One Authority, while recognizing the usefulness of the pilot for the purposes of improving the quality of international work products, stated that it shared the concerns as to the additional work load for examiners. It further noted the impact on efficiency on the overall international patent system if designated Offices continued to prefer citing documents in their “own” language rather than relying on the equivalent documents in the “source language” as cited in the international work products.

4. QUALITY METRICS

(A) CHARACTERISTICS OF INTERNATIONAL SEARCH REPORTS (CIRCULAR C. PCT 1434)

29. All Authorities which took the floor on the matter stated that they had found the report on characteristics of international search reports in its present form very valuable, notably as a “self-assessment” tool. There did not seem to be a need to fundamentally change the nature of the report.

30. One Authority saw particular value in characteristics 1.1, 1.3 (notably in light of the further breakdown provided under 1.9), 2.8 and 2.9 and suggested to replace characteristic 3.1, related to the percentage of patent citations in non-official languages, with a characteristic showing the percentage of patent citations which were not in the language of the application. This Authority further stated that it was content with the presentation of the report, notably the availability of Excel tables, but wondered whether there were any plans to present the characteristics in the form of an online tool as part of WIPO’s IP Statistics Data Center.

31. The International Bureau confirmed its intention to publish similar characteristics reports in the future, in line with a previous agreement to publish such reports on a regular (annual) basis.

32. The Subgroup recommended that Authorities which had suggestions for further improvements of the report should share those suggestions and ideas on the Subgroup’s e-forum.

(B) A PCT METRICS FRAMEWORK

33. All Authorities which took the floor on the matter supported the work towards establishing a PCT metrics framework, noting the importance of timely and reliable information for Offices in their various PCT capacities to assess internal processes and procedures and, more generally, the importance for the performance of the PCT system as a whole. Authorities expressed general support for the way forward proposed by the International Bureau with regard to the general direction (concentrating efforts on developing a small number of metrics which could be determined using data already held by the International Bureau’s data bases), the metrics already available and the proposed new metrics for early development, focusing mainly on the timeliness of certain processes.

34. Authorities recognized the usefulness of machine readable data for the establishment of improved and more meaningful future metrics and in this context noted the importance of ongoing efforts by Authorities to transmit search and examination reports and related data to the International Bureau in XML format, as well as existing possibilities for applicants to upload documents in machine readable format through ePCT. One Authority stated that it was not yet in a position to transmit such reports in XML but offered to work with the International Bureau to transmit the reports in other non-image based formats.

35. One Authority expressed concerns as to the expenditure of resources for the development of data to support certain metrics which it found not to be useful for the assessment of processes and procedures.

36. Several Authorities, while generally supporting the proposed ways in which metrics could be represented, expressed concerns as to the use of traffic lights, noting the sensitivity and difficulty of defining performance targets for Authorities which would determine whether the traffic light would be shown as green, amber or red.

37. One Authority stated that a metric should be developed to show those international applications which had been recorded in the International Bureau's systems as having been filed but for which the Authority had not yet received the search copy.

(C) A PCT METRICS FRAMEWORK – PROPOSALS FOR FUTURE DEVELOPMENT

38. The European Patent Office presented its proposals for the future development of the PCT metrics framework. With regard to presentational issues, it strongly favored the further development and expansion of WIPO's IP Statistics Data Center to include further metrics, both for use by the public and by Offices. It further noted that, in its view, it was essential to recognize that different type of information was useful for different audiences and that thus layers of access rights to data should be introduced, such as access to publically available data, access to data available to all Offices only and access to data available to individual Offices only. In particular with regard to metrics accessible to the public it noted that such metrics should be treated with care, should not be susceptible to misinterpretation and must be relevant, meaningful and aimed at aiding decision making by users. In this context, it proposed that the currently published metrics concerning the timeliness of international search reports should be further improved with a more meaningful metric for applicants, such as "percentage of international applications which become A1 publications".

39. With regard to the latter proposal, several Authorities expressed concerns as to the usefulness and meaningfulness of such a new metric, noting that the "performance" of four parties (the applicant, the receiving Office, the International Authority and the International Bureau) contributed to the timeliness of A1 publications. It was further noted that such an A1 metric could be published in addition to but not replace the existing metrics, noting the relevance for applicants, among others, to have reliable information on the performance of Authorities with regard to the different timeliness criteria under PCT Rule 42.

40. The Subgroup recommended that the International Bureau should review the metrics it currently published on the timeliness of international search reports with a view to publishing statistics on all of the following: the timeliness measured against the 3 month from the date of receipt of the search copy deadline (where that deadline applied), the timeliness measured against the 9 months from the priority deadline (where that deadline applied), and the A1 publication timeliness.

41. One Authority expressed its concern as to the introduction of different layers of access rights to data and stated that all data should be available to the general public, noting national legislation on the freedom of information. It was noted, though, that many of the data of particular use for Offices related to unpublished international applications and thus required particular security measures to be in place.

(D) SUMMARY OF RESULTS FROM JAPAN PATENT OFFICE – EUROPEAN PATENT OFFICE METRICS STUDIES

42. The European Patent Office presented an update on the joint collaborative metrics work it had performed with the Japan Patent Office. This had compared the type of citations for claim 1 made for applications in the international phase with those made in the national/regional phase where one of the two Offices had acted as International Searching Authority and the other Office had acted as designated Office in the national/regional phase. As well as random

sample across all technologies, the two Offices had assessed two technical fields, namely G08G (traffic control systems) and H01L23 (inorganic semiconductors). The manual categorization of citations took about 15 minutes per file.

43. There was approximately 90 per cent correspondence in the type of citation between the international and national phase when novelty or inventive step had been cited in the international search report even if different citations were selected by the examiner in each Office. However, in cases where the International Searching Authority considered claim 1 to be novel and inventive, the first action in the national/regional phase only agreed with this assessment in about 20 to 30 per cent of cases. There was general consistency in these figures between the two technology fields studied and the random sample of cases.

44. The Subgroup discussed possible reasons for the divergence between the results between the International Searching Authority and the designated Office, such as language issues (e.g. preference to use an equivalent citation in national language, limits of machine translation to decipher the information needed to cite the document in the national/regional phase), amendments, claim interpretation and human nature. In reply to a query as to whether the low correspondence when only background art citations were listed in the international search report appeared to contradict the high grant rate for applications examined under the Patent Prosecution Highway, it was noted that different metrics applied (first office actions under the collaborative metrics pilot and grant rate under PPH). With regard to the relationship between the findings of this pilot and the Collaborative Search and Examination pilot, the European Patent Office indicated that correspondence between the international and the national/regional phase would be investigated in Phase 3 of the Collaborative Search and Examination pilot (see document PCT/MIA/22/13).

45. The European Patent Office and the Japan Patent Office indicated they would continue their collaboration and present an update to the following meeting of the Subgroup.

5. CRITERIA FOR APPOINTMENT OF AN INTERNATIONAL AUTHORITY

46. Based on a recommendation by the Meeting of International Authorities at its twenty-first session, subsequently endorsed by the PCT Working Group, the Authorities discussed what appropriate quality requirements an Office should be required to meet to act effectively as an International Authority and how these could be better expressed in the criteria for appointment.

47. Discussions were based on specific suggested areas for consideration which had been made to date both in the Working Group and the Subgroup. Noting the political and sensitive nature of the issues at stake, Authorities agreed that, at this stage, it would not appear appropriate to consider amendments to the existing requirements for appointment as set out in the Regulations. Authorities further 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.

48. Authorities agreed that the focus of further work should rather be on procedural issues related to quality, such as the extent to which an Office seeking appointment already had in place a quality management system and internal review arrangements in accordance with Chapter 21 of the International Search and Preliminary Examination Guidelines or, where such system was not yet in place at the time of appointment, the extent to which an Office had an equivalent system operational in respect of national search and examination work.

49. The Subgroup recommended that one area of possible further work should be to review the present Chapter 21 of the Guidelines with a view to strengthening the requirements with respect to quality management systems, notably, by making certain requirements mandatory which to date were only recommendations or by adding certain requirements which might be missing from the current text. In that context, the Subgroup also noted that, at present, under paragraph (d) of the Understanding on the Procedures

for Appointment as adopted by the PCT Assembly in 2014, the requirement to have systems similar to those under Chapter 21 operational at the time of appointment was not a mandatory requirement (“preferably”) and recommended that this provision might be reviewed with a view to making it mandatory.

50. The Subgroup further recommended, as a second procedural issue related to quality, to elaborate on 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.

51. The Subgroup recommended that the International Bureau should take the lead in further developing proposals on the issues set out in paragraphs 49 and 50, above, although it was noted that further work in this area would greatly benefit from and indeed depend on active contributions by Authorities.

52. After some discussion, the Subgroup reconfirmed its understanding that any possible new requirements related to the issue of quality would apply to both existing Authorities (with appropriate transitional measures, if needed) as well as Offices seeking to be appointed, in line with the discussions of this issue at the twenty-first Meeting of International Authorities and the discussions in the seventh session of the PCT Working Group.

53. Upon request, the International Bureau confirmed that any new requirements related to quality would only apply if and when approved by all Member States; before entry into force of any such new requirements, the current requirements would continue to apply to any Office seeking appointment.

6. OTHER IDEAS FOR QUALITY IMPROVEMENT

54. There were no interventions by Authorities under this agenda item.

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