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المنظمة العالمية للملكية الفكرية

ВСЕМИРНАЯ ОРГАНИЗАЦИЯ
ИНТЕЛЛЕКТУАЛЬНОЙ СОБСТВЕННОСТИ

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The International Bureau of the World Intellectual Property Organization
./. (WIPO) presents its compliments and has the honor to transmit herewith the
report (document PCT/MIA/11/14) of the eleventh session of the Meeting of
International Authorities under the PCT, which was held in Geneva from
February 21 to 25, 2005.

As the working language of the session was English, the report is available
only in English.

Both the report and the working documents are available on WIPO's Web
site (see <http://www.wipo.int/pct/en/meetings>).

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Eleventh Session
Geneva, February 21 to 25, 2005

REPORT

adopted by the Meeting

INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its eleventh session in Geneva from February 21 to 25, 2005.

2. All of the twelve International Searching and Preliminary Examining Authorities were represented at the session: the Austrian Patent Office, the Canadian Intellectual Property Office, the European Patent Office, the Federal Service for Intellectual Property, Patents and Trademarks of the Russian Federation, IP Australia, the Japan Patent Office, the Korean Intellectual Property Office, the National Board of Patents and Registration of Finland, the Spanish Patent and Trademark Office, the State Intellectual Property Office of the People’s Republic of China, 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.

OPENING OF THE SESSION

4. Mr. Francis Gurry, Deputy Director General, on behalf of the Director General, opened the session and welcomed the participants.

ELECTION OF A CHAIR

5. The Meeting unanimously elected Mr. Francis Gurry (WIPO) as Chair.

ADOPTION OF THE AGENDA

6. The Meeting adopted for its agenda the draft agenda as contained in document PCT/MIA/11/1 Rev.

PCT MINIMUM DOCUMENTATION

Search Guidance Intellectual Property Digital Library

7. Discussions were based on document PCT/MIA/11/8 and a presentation¹ by the Secretariat of the prototype that had been developed to aid confirmation of the requirements for the Search Guidance Intellectual Property Digital Library (SGIPDL) (see paragraph 12 of document PCT/MIA/11/8).

8. The Meeting confirmed its support for the SGIPDL development and agreed that a task force be established by the Secretariat in order to determine the SGIPDL requirements and oversee the further development of the prototype. The Meeting noted that a number of Authorities had indicated their intention to nominate representatives for the task force, in which all Authorities were invited to participate, and whose work would be carried on using electronic communication.

Comprehensive Review

9. Discussions were based on document PCT/MIA/11/6 and a presentation¹ given by the European Patent Office outlining the factors influencing the need for a review of the concept, definition and content of PCT minimum documentation. These factors included:

- (a) the increased availability of information in electronic form which brought with it better opportunities to search a wider range of both patent and non-patent literature documentation;

- (b) the increasing number of periodicals published worldwide;

- (c) the growing importance of free-of-charge sources such as “open access” publications and public search results;

- (d) the need for specialized databases in certain fields;

- (e) the increasing need to consult sources of information which had previously been little considered, such as traditional knowledge; and

- (f) the future role that could be played by automated translation.

10. The Meeting agreed that a comprehensive review of the PCT minimum documentation was necessary and that a task force be established by the Secretariat to undertake such review.

11. It was considered that the review should address patent documentation, including questions of additional countries, languages and whether utility models might also be included, as well as non-patent literature, and that the issues listed in paragraph 10 of document PCT/MIA/11/6 were a good starting point for the task force's work. The Meeting agreed that Mr. Gérard Giroud (European Patent Office) should act as task force leader. All of the Authorities would be invited to nominate task force representatives, providing the various types of required expertise. The task force would conduct its review using electronic communication and would make progress reports to the Meeting.

12. While, in general, the Meeting felt that any proposals for changes in the near future to the PCT minimum documentation should be considered as part of the comprehensive review and should not be addressed individually, it was agreed that, in view of the time needed for a comprehensive review, the proposal to add Korean patent documents to the minimum documentation (see paragraphs 19 to 22, below) should exceptionally be dealt with by the task force as a separate question in parallel with the comprehensive review.

Traditional Knowledge

13. Discussions were based on document PCT/MIA/11/5.

14. The Meeting noted that an updated list of periodicals of the non-patent literature minimum documentation under PCT Rule 34, including 11 new traditional knowledge periodicals approved at earlier sessions of the Meeting, had been made available on WIPO's website² and would also be published in a Special Issue of the PCT Gazette.

15. The Meeting discussed a proposal by the International Bureau to reconsider the inclusion in the non-patent literature minimum documentation list of the periodical *Indian Journal of Traditional Knowledge* and the abstracting journal *Medicinal and Aromatic Plants Abstracts*. It was noted that online accessibility of those journals had improved since their last review in June 2004 and that searchability of the journals had been allowed by the publisher.

16. The Meeting agreed that the two journals mentioned in paragraph 15 now met the criteria which had been set in the seventh session of the Meeting (see paragraph 12 of document PCT/MIA/7/5) and should be introduced into the list of periodicals under PCT Rule 34.

17. The Meeting underlined the importance of ensuring continuous access to the two journals and encouraged the establishment of technical contacts with the publishers with a view to further improving access.

18. The Meeting also recognized the importance of the further selection of traditional knowledge-related databases, with the aim of their use in the search process, and agreed that the matter be examined under the framework of the comprehensive review of the PCT minimum documentation (see paragraphs 9 to 12, above).

Korean Patent Documents

19. Discussions were based on document PCT/MIA/11/9 and a proposal for amendment of Rule 34 (attached as Annex II to this document) presented during the session by the Korean Intellectual Property Office which was intended to be submitted by that Office to the PCT Assembly for adoption in 2005, as well as additional background information related to the proposal outlining, in particular, that:

(a) the Office is in the top 10 in the world in terms of the number of patent applications received, both as a national Office and as a receiving Office under the PCT;

(b) an ever-increasing number of first patent filings are made with the Office, particularly in the fields of information technology and biotechnology, making patent documents from the Republic of Korea a particularly important source of technical information;

(c) the use of the Office's free Internet-based patent document search service (KIPRIS) by users from outside the Republic of Korea is increasing rapidly; and

(d) patent documents published by the Office are available in electronic format (either image or full-text), and English language abstracts (available since 1979) are available in searchable SGML format.

20. The Office stated that its immediate proposal was limited in scope to patents and published patent applications and did not extend to the inclusion of utility models from the Republic of Korea in the minimum documentation. However, the Office requested that the possible inclusion of utility models as part of the minimum documentation be considered as part of the comprehensive review of the PCT minimum documentation (see paragraphs 9 to 12, above).

21. It was furthermore noted that, under the Office's proposal, International Authorities other than the Office would not be required to include documents from the Republic of Korea prior to 1979 in their documentation since English language abstracts of those documents were available only from 1979 onwards.

22. The Meeting:

(i) expressed its support for the proposal that patent documents from the Republic of Korea be included in the PCT minimum documentation;

(ii) noted that the Korean Intellectual Property Office intended to submit a proposal accordingly to the Working Group on Reform of the PCT for consideration at its seventh session in May 2005, and subsequently to the PCT Assembly for consideration at its thirty-fourth session in September-October 2005;

(iii) requested that the task force referred to in paragraph 10, above, consider, as a matter of priority, the actions which would be required by the Authorities to allow them to efficiently search the patent documentation from the Republic of Korea referred to in paragraphs 20 and 21, above, and the time by which this could be achieved, and that the task force should report on this question by July 1, 2005;

(iv) recommended that, after consideration of the proposal by the Working Group on Reform of the PCT and the making of the report by the task force, the proposal should be submitted to the PCT Committee for Technical Cooperation (for its recommendation under PCT Article 56(3)), prior to its submission to the PCT Assembly (for adoption), with a view to entry into force of the amendments on a date to be recommended by the task force.

IMPLICATIONS OF IPC REFORM FOR INTERNATIONAL AUTHORITIES

23. Discussions were based on document PCT/MIA/11/7.

24. The Meeting noted the effects of changes resulting from International Patent Classification (IPC) reform to the classification of PCT applications in international search reports established by International Searching Authorities, in particular relating to the revision of the advanced level of the IPC with effect from January 1, 2006, when the reformed IPC will enter into force. The Meeting agreed that a system of monitoring of the validity of IPC symbols assigned should be introduced by Authorities on the basis of the IPC Valid Symbols File produced by the International Bureau.

25. The Meeting also noted that the revised WIPO Standards ST.10/C and ST.8, and new Standard ST.36, should be applied for recording of classification symbols of the reformed IPC.

26. The following considerations were put forward in the course of discussions:

(a) it would be difficult for some Authorities to implement the new WIPO Standards and the symbol validation procedure by January 1, 2006;

(b) it would be preferable not to change the international search report form, in view of the Authorities' established administrative procedures;

(c) it would be impossible to implement the new Standard ST.10/C, prescribing recording of classification symbols in a tabular form, on the existing international search report form; instead, a linear recording of IPC symbols, using indicators prescribed by that Standard, could be used;

(d) although Standard ST.36 would be preferable for electronic transmission of international search reports, the International Bureau should accept reports established according to other electronic standards;

(e) for PCT applications in which no priority was claimed, an international search report was required to be established within nine months from the filing date; at that time, future amendments of the advanced level could be not known and validation by the International Searching Authority would be impossible;

(f) the Valid Symbols File should be provided by the International Bureau sufficiently in advance to be used for checking the validity of IPC symbols in most cases where priority is claimed;

(g) an additional check of the validity of IPC symbols should be made by the International Bureau upon receipt of international search reports.

27. The Secretariat explained that the Valid Symbols File would be made available to patent Offices, including the International Authorities, at least three months before the entry into force of amendments to the advanced level, which level should be used for classifying PCT applications. In addition to validation by the International Authorities, a system of monitoring the validity of classification symbols would be established at the International Bureau. Where invalid symbols were found to have been entered on an international search report, the Authority concerned would be notified and requested to update or correct the classification.

28. The Secretariat indicated that, in order to assist further investigation of the effects of IPC reform, a PCT Circular would be issued shortly, requesting information from Authorities concerning their plans in respect of recording IPC symbols in international search reports when the reforms come into effect.

PCT REFORM PROPOSALS WITH RELEVANCE TO THE INTERNATIONAL AUTHORITIES

29. The Meeting discussed a number of preliminary draft documents having implications for the operations of the International Authorities, that had been made available for comment³ prior to the finalization of proposals for consideration at the seventh session of the Working Group on Reform of the PCT, which is expected to be held in May 2005. Comments and suggestions on the various proposals, as set out in the following paragraphs, would be taken into account by the Secretariat in preparing revised proposals.

Missing Elements and Parts of the International Application

30. Discussions were based on document PCT/MIA/11/4 and the preliminary draft document for the seventh session of the Working Group on Reform of the PCT which had been made available for comment on the WIPO website as PCT/R/WG/7 Paper No. 1 Rev.

31. The Meeting generally supported the draft proposals, subject to the following comments and suggestions:

(a) Rule 4.18 should be further amended by deleting the words “to the effect” so as to require applicants to use the exact wording of Rule 4.18 for any statement of incorporation by reference included in the request. In addition, the phrase “for the purposes of Rule 20.6” should be inserted at the end of Rule 4.18 so as to make clear that an incorporation by reference could not provide support for later filed amendments which would otherwise be considered to contain new matter.

(b) The International Bureau should further study the issue addressed in the comment on Rule 20.1(c).

(c) In the titles of Rules 20.3 and 20.5, the words “Apparent” and “Apparently”, respectively, should be deleted, noting that, while certain paragraphs of those Rules deal with “apparently” missing elements or parts, other paragraphs of those Rules deal with “actually” missing elements or parts.

(d) Rule 20.5(c) and (e) should be further amended, or the Administrative Instructions modified accordingly, so as to ensure that the International Searching Authority is promptly informed by the receiving Office of any decision by that Office under Rule 20.5(c) to correct the international filing date or to consider the correction of the international filing date under Rule 20.5(e) as not having been made.

(e) Rule 20.6 should be further amended so as to make an incorporation by reference subject to a finding by the receiving Office that the requirements of Rule 4.18 and Rule 20.6 have been complied with and that the apparently missing element or part is completely contained in the earlier application concerned. Rules 20.3(b) and 20.5(d) should also be further amended accordingly.

(f) Rule 82^{ter}.1(b) should be further amended so as to have the effect that, where the applicant, for the purposes of Rule 20.6, relied on a separately submitted (non-certified) copy of the earlier application and did not comply with Rule 17.1(a), (b) or (b-*bis*) in relation to the priority document, any designated Office may treat the application as if the international filing date had been accorded under Rule 20.3(b)(i) or 20.5(c), as applicable, provided that the designated Office must first give the applicant an opportunity to furnish the priority document within a time limit which shall be reasonable under the circumstances, similarly to Rule 17.1(c).

(g) The Administrative Instructions should be modified to provide that a notification by the receiving Office to the International Bureau that a missing element or part has been incorporated by reference under Rule 20.6 should include an indication as to whether the applicant, for the purposes of Rule 20.6, relied on compliance with Rule 17.1(a), (b) or (b-*bis*) in relation to the priority document or on a separately submitted (non-certified) copy of the earlier application concerned, and Rule 48.2(b) should be amended so as to ensure that this information is published on the front page of the published pamphlet.

(h) The title of proposed Rule 20.8 should be changed from “Transitional Reservations” to “Incompatibility with National Laws”. The Meeting noted that this and other Rules with similar effect, providing for Offices to give notifications because of the existence of certain provisions in national laws with the result that the related Rules concerned did not apply to such Offices for as long as the situation continued, did not in fact constitute “transitional” reservations since they did not bind Offices giving such notifications to withdraw them in the future, although they may have been adopted in the hope that the incompatibility would be removed at some time.

Restoration of the Right of Priority

32. Discussions were based on document PCT/MIA/11/4 and the preliminary draft document for the seventh session of the Working Group on Reform of the PCT which had been made available for comment on the WIPO website as PCT/R/WG/7 Paper No. 2 Rev.

33. The Meeting noted that there were outstanding concerns expressed by a number of delegations in the Working Group, some of which were shared by certain International Authorities, as to the compatibility of the proposals with Article 8 of the PCT when read together with Article 4 of the Paris Convention for the Protection of Industrial Property.

34. The Meeting generally supported the draft proposals, subject to the concerns noted in paragraph 33, above, and to the following comments and suggestions:

(a) Rule 26bis.2(a) should be further amended so as to make it clear that the International Bureau would not be required to notify the applicant of the possibility of submitting a request for the restoration of the right of priority in accordance with Rule 26bis.3 where the receiving Office had given a notification of incompatibility under proposed Rule 26bis.3(i).

(b) In Rule 26bis.3(a), the words “, at the option of the Office,” should appear after “one of the following criteria (‘criteria for restoration’)” at the end of the chapeau, rather than at the end of item (i).

(c) The references in Rule 26bis.3(c) to paragraphs (a)(iii) and (a)(iv) should be to paragraphs (b)(iii) and (b)(iv), respectively.

(d) Following a query by one Authority, the Secretariat confirmed, with respect to Rule 49ter, that there was no requirement for designated Offices to inform the International Bureau about decisions on requests for restoration of the right of priority taken by a designated Office in the national phase.

International Publication in Multiple Languages

35. Discussions were based on document PCT/MIA/11/4 and the preliminary draft document for the seventh session of the Working Group on Reform of the PCT which had been made available for comment on the WIPO website as PCT/R/WG/7 Paper No. 3 Rev.

36. The Meeting generally supported the text of the draft proposals. One Authority noted that, while it supported the proposals, it remained desirable to address the underlying issue of a possible revision of Article 64(4) at some stage in the future, and in this context referred to the ongoing discussions on substantive patent law harmonization in the Standing Committee on the Law of Patents.

Recording of Changes by the International Bureau

37. Discussions were based on document PCT/MIA/11/4 and a further revised draft of the preliminary draft document for the seventh session of the Working Group on Reform of the PCT which had been made available for comment on the WIPO website as PCT/R/WG/7 Paper No. 5.

38. The Meeting noted the concerns expressed by one Authority as to the legal basis in the Treaty for making Rules for procedures extending into the national phase of processing of international applications, noting that the examples given in the document of features of the Treaty dealing specifically with matters obtaining long after the international phase is over were provided for in the Treaty itself rather than, as in the case of the proposals at hand, in the Regulations, and there are no Rules in which a single request made in the national phase affects the operation in each Office.

39. The Meeting generally supported the draft proposals, subject to the following comments and suggestions:

(a) The “Background” part of the document should be reviewed so as to further clarify that the proposals applied only to requests for the recording of changes to be made during the international phase and during the national phase in respect of designated or elected Offices before which national processing of the international application has started and has not yet been completed, but not to granted patents.

(b) Rule 92*bis*.2(b) should be further amended with a view to allowing requests for the recording of changes to be filed with the receiving Office as well as with the International Bureau, keeping in mind the fact that the provisions of Rule 92*bis*.2(g) could pose difficulties for some receiving Offices.

(c) Rule 92*bis*.4(c) should be further amended, or the Administrative Instructions modified, so as to clarify that, where a single request for the recording of a change was filed in respect of multiple applications, the International Bureau would issue, if so desired by a designated or elected Office which was not yet bound by the Patent Law Treaty, separate notifications for each international application concerned by the change.

(d) Rule 92*bis*.4(c) should be further reviewed, or other solutions explored, so as to enable designated and elected Offices whose official languages use alphabets other than the Latin alphabet to participate in the new system without imposing too heavy a burden on such Offices for translations or transliterations.

(e) Rule 92*bis*.5 should not be limited to the case where an old applicant is, upon request of a new applicant, removed and replaced by the new applicant, but rather the Rule should be further amended so as to generally ensure that one applicant cannot remove (all or any) other applicants without their consent.

(f) Rule 92*bis*.6(a) should be further amended so as to clarify that the limitations imposed on designated and elected Offices with regard to the furnishing of further evidence supporting a change would not apply to the courts or any other competent organs of or acting for the designated State concerned.

(g) Rule 92*bis*.6 should be further reviewed to see whether a further reservation provision for designated and elected Offices might be needed instead of, or in addition to, proposed new Rule 92*bis*.6(b).

Rectification of Obvious Mistakes

40. Discussions were based on document PCT/MIA/11/4 and the preliminary draft document for the seventh session of the Working Group on Reform of the PCT which had been made available for comment on the WIPO website as PCT/R/WG/7 Paper No. 6.

41. The Meeting generally supported the draft proposals, subject to the following comments and suggestions:

(a) The proposed amendment of Rule 82*ter*.1, requiring designated or elected Offices to rectify errors by the receiving Office or the International Bureau concerning the international filing date or a priority claim if the receiving Office or the International Bureau accepted that the decision which it took was in error, should not proceed, noting that it would appear to deny a designated or elected Office its right (under Article 26) to reject an international application for failure to comply with the requirements of the Treaty or the

Regulations where the decision by the receiving Office or the International Bureau to reverse an earlier (correct) decision was itself incorrect.

(b) Rule 91.1(b)(ii) should be further amended, or the Administrative Instructions modified, so as to ensure that, where the International Searching Authority is not also acting as International Preliminary Examining Authority, the International Searching Authority is aware of the fact that it is no longer competent to authorize a request for the recording of a change where the International Preliminary Examining Authority has become the “competent authority” in accordance with proposed new Rule 91.1(b)(iii).

(c) Rule 91.1(b) should be further reviewed with regard to the question as to which authority should be competent to authorize the rectification of obvious mistakes in Article 19 amendments, noting that the International Searching Authority would usually not be in a position to authorize such rectifications without also checking whether the Article 19 amendment added new matter, which it otherwise would not be required to do, given that Article 19 amendments are submitted to the International Bureau and published without any such check.

(d) The definition of rectifiable mistakes in Rule 91.1(c) should use the term “obvious” rather than “manifestly obvious”.

(e) Rule 91.1(d)(i) should be further reviewed so as to put it beyond doubt that, where the mistake was in the description, claims or drawings, the competent authority could take into account all of these elements of the international application (description, claims and drawings) and not only the element containing the mistake (for example, the applicant should be able to refer to the description in order to show that a claim contained a mistake).

(f) Rule 91.1(d)(ii) should be further reviewed in view of the clear divergence of views expressed by delegations as to whether, and if so, to what extent, extrinsic documents (that is, documents other than the one in which the mistake occurred) should be able to be relied upon where the mistake was not in the description, claims or drawings. One Authority suggested that extrinsic evidence should be able to be used in a more liberal way, but that view did not find favor with other Authorities.

(g) The comment on Rule 91.1(f) should be modified to clarify that the deletion of the words “even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets” contained in present Rule 91.1(c) (which is proposed to be moved to Rule 91.1(f)(i)) was not intended to modify the principle but was merely a drafting change.

(h) Rule 91.1(f)(ii) should be further amended, or other solutions explored, so as to allow applicants, in certain limited circumstances (for example, where the Office of filing of the priority application had corrected the date of filing of the priority application after the filing of the international application) to correct the priority date regardless of whether the time limit under Rule 26*bis* for the correction of priority claims had expired.

(i) Rule 91.1(e) should be further reviewed with a view to whether it was desirable to publish the reasons for a refusal of a request for rectification of an obvious mistake and comments submitted by the applicant together with the international application or whether it might not be preferable to simply make those reasons and comments available to the public by other means, for example, by way of file inspection.

(j) The wording of Rule 91.3(d)(ii) should be aligned with that of similar wording in Rule 91.1(e)(ii).

Improving the Quality of International Searches

42. Discussions were based on document PCT/MIA/11/4 and the preliminary draft document for the seventh session of the Working Group on Reform of the PCT which had been made available for comment on the WIPO website as PCT/R/WG/7 Paper No. 8.

43. The Meeting noted the concern expressed by some Authorities as to the possible duplication of work among Offices.

44. The Meeting noted that supplementary international search was a service that had been strongly called for by applicants, and supported further investigation into the possibility of introducing this into the PCT system. It was emphasized that participation in such a system must be optional for Authorities as well as for applicants, and that supplementary searches should, to the greatest extent possible, be complementary to the main international search rather than duplicating the work done. It was also emphasized that such a service should not be allowed to impinge on the ability to deliver the main international searches and preliminary examinations in a high quality and timely manner.

45. There was general agreement that the issue of different language specializations was the central criterion around which it was needed to focus any supplementary search, though it was necessary to find appropriate terms to define the operation of that criterion. The official language(s) of an International Authority accepted for the purposes of international search were not a good guide to language specializations, which would in general be significantly broader.

46. Several International Authorities stated that, in general, it would not be necessary for a supplementary search to consider the PCT minimum documentation (except to the extent that the documentation required by International Authorities may vary, depending on the availability of English language abstracts for documents in certain languages which are not in an official language of an Authority) since that minimum documentation will have been searched by the main International Searching Authority. Rather, any supplementary search should be focused primarily on documents that did not form part of the minimum documentation and that had been published in languages of specialization of the Authority carrying out the supplementary search. Some Authorities emphasized that any Authority should be free to conduct a supplementary search as broadly as it was prepared to do, though concern was expressed that it might become an expectation of applicants that a broader search should be carried out, with consequent effects on workload and cost for the Authority performing the supplementary search.

47. It was suggested that it might be appropriate for participating International Authorities themselves to set out the languages which would be the main focus of their supplementary searches and the extent to which they would usually expect to search beyond this. Applicants could then decide for themselves whether to use the service.

48. The Meeting noted that consideration should be given to the situation where the main International Searching Authority has issued a declaration or indication under Article 17(2)(a) or (b).

49. Concern was expressed that supplementary searches might be requested in order to overcome a negative main international search report. However, it was generally agreed that the supplementary search should not include a written opinion but only short comments to the extent that would be necessary to understand why each newly found document was relevant. (One Authority commented that in many cases, simply the X or Y categories together with the relevant claim numbers would be sufficient for this purpose.) Consequently, the Authority conducting the supplementary search would not comment on the main International Searching Authority's written opinion. However, it was suggested that it may be appropriate for a supplementary search report to cite a document which appeared to have been considered by the main International Searching Authority only on the basis of an English language abstract, though it might in many cases be difficult to determine whether this was actually the case.

50. It was noted that it might be difficult to deliver supplementary international search reports in time to be used for the purposes of international preliminary examination, or even in time for the beginning of the national phase. Nevertheless, it was generally considered that, for reasons of simplicity of the system, a supplementary international search should not be started until the main international search report had been established. This would avoid conflict with the main search, allow the question of unity of invention to be addressed first by the main International Searching Authority (see also paragraph 52, below) and allow a more complementary supplementary search since the Authority conducting the supplementary search would have a better idea of the scope of the search which had already been carried out. It was considered, however, that it should be possible for the applicant to submit the request for supplementary international search at an earlier stage, including at the time of filing the international application.

51. One Authority indicated that it would normally be capable of delivering supplementary search reports before the end of the international phase even if the request was made fairly late (for example, within 26 months from the priority date); nevertheless, it was felt that the system would be less confusing if the time limit was the same as that for filing a demand for international preliminary examination (noting, though, that any supplementary search requested towards the end of that time limit would rarely be completed in time to be taken into account by the International Preliminary Examining Authority, unless it was in fact conducted as part of the international preliminary examination).

52. The Meeting agreed that applicants requesting a supplementary search on an international application in respect of which lack of unity of invention had been found to exist should be able to choose which inventions should be the subject of the supplementary search, but only from amongst those which had been the subject of a search by the main International Searching Authority, since the supplementary search was intended to be a complement to the main international search and not a complete new international search. It was generally felt that the simplest approach to unity of invention would be for Authorities conducting a supplementary international search to accept the findings of the main International Searching Authority on the matter, though it was recognized that there may occasionally be difficulties in this approach and that some Authorities might wish to be able to identify further lack of unity beyond that which had been mentioned in the international search report, or to raise the issue even where no finding of lack of unity had been made by the International Searching Authority.

53. The Meeting agreed that it would be most efficient for requests for supplementary international search to be submitted to the International Bureau rather than directly to the International Searching Authorities involved since Authorities would anyway need to contact

the International Bureau to request a copy of the international application (and possibly other documents) before the supplementary search could begin. It was noted, however, that it might in certain circumstances be desirable to allow certain documents, such as translations, to be sent directly to the International Searching Authorities involved.

54. It was clarified that the proposal to “publish” supplementary international search reports should be understood as meaning that they should be made available to the public, rather than there should be a formal “republication” of the pamphlet including the supplementary international search report. Furthermore, the file inspection and document communication systems would need to be arranged so that any person or body (such as designated and elected Offices) that wished to view or receive a copy of the international search report would also be shown or sent any supplementary international search report(s) automatically.

55. The Meeting expressed its agreement with the suggestion that a new draft document on this subject should be prepared by the Secretariat for consideration by the Working Group on Reform of the PCT, including draft proposals for amendment of the Regulations which could be discussed in detail.

PCT FORMS

56. Discussions were based on document PCT/MIA/11/12, containing proposals by the United States Patent and Trademark Office. The Office indicated that the proposals set out in Annexes I to IV of document PCT/MIA/11/12 had been incorporated into its response to Circular C. PCT 1012, consulting on proposed modifications to the Forms to take into account amendments of the Regulations under the PCT adopted by the PCT Assembly at its 33rd (19th extraordinary) session held from September 27 to October 5, 2004 (see document PCT/A/33/7), which will enter into force on April 1, 2005.

57. The Meeting expressed broad agreement with the aims of the proposals in document PCT/MIA/11/12 and noted that similar principles may also apply to Forms PCT/ISA/201 (International-Type Search Report) and 203 (Declaration of Non-Establishment of International Search Report). A number of Authorities indicated that they would give supplementary written responses to Circular C. PCT 1012, taking these proposals into account. Such supplementary responses would need to be provided quickly in view of the need to prepare and publish the final versions of the Forms in time to come into force on April 1, 2005.

APPLICATION OF PCT RULES 13.1 AND 13.2

58. Discussions were based on document PCT/MIA/11/11, submitted by the European Patent Office.

59. The Meeting expressed its understanding that Rules 13.1 and 13.2 meant that, for unity of invention to exist, there must be common “special technical features” found in each claim. Consequently, in the simplified case described in document PCT/MIA/11/11, where there are no special technical features at all found in a claim, there cannot be *common* special technical features with the other claims and consequently lack of unity of invention existed.

INTERIM PROTEST PROCEDURE AT THE EUROPEAN PATENT OFFICE

60. Discussions were based on document PCT/MIA/11/13, submitted by the European Patent Office.

61. The Meeting noted the interim protest procedure and variants of the official Forms which the European Patent Office intended to use until the entry into force of the Act revising the Convention on the Grant of European Patents of November 29, 2000.

PCT STATISTICS

62. The Secretariat presented the latest statistics available concerning filing trends and the processing of international applications.¹ It was noted that a growth rate of around 5% per annum had continued since 2001 and was predicted to remain roughly constant for the immediate future. The highest growth rate was in international applications from the Asia-Pacific region. The number of demands made for international preliminary examination had, as expected, dropped significantly since the changes to the Rules which came into force on January 1, 2004. It was predicted that the number of demands made would continue to fall, though at a lower rate, and it was noted that those predictions had a significantly lower level of certainty than for the level of international applications.

63. Electronic filing had taken off rapidly. In recent months (not shown on the charts), over 13% of international applications had been filed in fully electronic form, even though only 8 receiving Offices offer this service. In some receiving Offices, more than 70% of international applications were now being filed in fully electronic form. It was expected that less than half of international applications filed in 2005 would be filed in paper form only.

64. There had been a slight level of improvement in the time taken to deliver record copies from receiving Offices to the International Bureau in recent months. The timeliness of international search reports had also improved slightly (noting that the timing was measured relative to the date of international publication, rather than against the time limit set out in PCT Rule 42). However, the proportion of international preliminary examination reports issued more than 28 months after the priority date was increasing.

65. The Meeting noted the presentation on PCT statistics given by the Secretariat.

QUALITY FRAMEWORK

Quality Management Systems in the International Authorities

66. Discussions were based on document PCT/MIA/11/10 and presentations¹ by the European Patent Office and the Spanish Patent and Trademark Office explaining the quality management systems that they were using and developing. Some other Authorities also briefly outlined the status of their consideration and implementation of quality management systems.

67. The Meeting noted that there were a number of aspects of quality management systems that were applicable in any International Authority, including: the overall mission or charter;

organizational arrangements and structures; quality control; quality standards; manuals and documentation; human resources; user and customer needs; and quality audit mechanisms and procedures. It was recognized that each Authority bore responsibility for its own quality management systems, and that some of those aspects were primarily matters for internal consideration and implementation.

68. There were some areas in which coordination and cooperation among the various Authorities and consideration by the Meeting would be likely to be productive, noting particularly the international nature and context of the PCT system, including:

(i) quality standards (noting that the PCT International Search and Preliminary Examination Guidelines already represented a common approach to many aspects of search and examination, and included a chapter on a common quality framework for international search and preliminary examination);

(ii) manuals and documentation (noting particularly the existing Guidelines);

(iii) examiner skills and training (where cooperation may be of benefit, although a common approach would not be a useful objective).

69. Equally, it was recognized that the various Authorities operated in different spheres and subject to different constraints and expectations, among the factors being the size of the Authority (volume of work, staff numbers and other resources), attitudes to audit procedures, the profile of domestic and foreign applications received, and local perceptions as to an optimal balance between the price (fees) and quality of service provided.

70. The Meeting noted that the presentations given during the present session provided a useful means of exchanging experience and expertise on quality management and that such presentations could lead to the identification of areas in which greater coordination and cooperation may be desirable and feasible.

71. Several Authorities suggested that it would be desirable to have a more uniform approach to the preparation of reports for consideration by the Meeting with a view to the submission of future reports on quality management to the PCT Assembly. For this purpose, it would be useful if a template and/or questionnaire could be developed for use, if they wished, by all Authorities.

72. The Meeting agreed:

(i) that presentations by Authorities on their quality management systems should be a regular feature of future sessions;

(ii) that the Secretariat should work with interested Authorities with a view to proposing, at the next session, a work plan for development of coordinated approaches on quality issues, such as those mentioned in paragraph 68;

(iii) that it would be desirable to develop a more uniform style and content for reports on quality management made by Authorities to the Meeting for use in reporting to the PCT Assembly, for which purpose a standard template and/or questionnaire would be useful;

(iv) that Authorities should be invited to submit such reports by the end of May 2005, to be used in the preparation of a report by the Meeting to the Assembly for consideration at its 34th session in September-October 2005, and that the Secretariat should as a matter of urgency consult Authorities with a view to providing a first version of a suitable template and/or questionnaire for the purpose.

A Quality Framework for the International Bureau

73. Discussions were based on document PCT/MIA/11/3 Rev.

74. The International Bureau stated that this was a timely moment for it to be considering this matter. It had, until recently, been difficult for the International Bureau to keep pace with the enormous rate of increase of filing of international applications under the PCT which there had been for many years. A reorganization of working practices and the implementation of further and improved information technology systems, together with a slight reduction in the rate of growth, meant that in the past year the International Bureau had been better able to take stock of its situation. This provided an opportunity to focus on quality and improvement of procedures at the same time as the process which was being undertaken by the International Authorities under chapter 21 of the PCT International Search and Preliminary Examination Guidelines. The International Bureau's review of its quality systems had only just begun. While there was much to be proud of, it was also clear that there was much work to be done and the International Bureau was committed to the process. One of the next major steps was applying the metrics, such as those shown in Annex II to document PCT/MIA/11/3 Rev., to determine and assess compliance with appropriate standards.

75. The International Bureau noted the fact that the figures showed a slower delivery of services by the International Bureau to applicants using the Japan Patent Office as receiving Office than to many other applicants. However, this needed to be seen in the light of the fact that over 70% of the rapidly increasing number of international applications filed using the Japan Patent Office as receiving Office were filed in fully electronic form, so the staff concerned were very involved in the development and testing of the systems for processing international applications. The systems for handling the early stages of such electronic processing by the International Bureau were not yet fully in place. The efficiency of publication of these international applications, on the other hand, was very high.

76. Some International Authorities commented that the items setting out the need for appropriate staff, equipment and facilities under paragraphs 3(a) and (b) of the draft quality framework in Annex I to document PCT/MIA/11/3 Rev. should not mean that the International Bureau should seek increases in these areas, but should work for improvements using the current staff and budget. One Authority also stated that there needed to be a cost-benefit analysis of any further major changes to the systems or personnel of the International Bureau which might be proposed in order to develop the International Bureau's quality strategy.

77. The International Bureau pointed out that it was already handling a workload 30% heavier than in than in 2001 with fewer staff and that it expected further efficiency gains as electronic communications with Offices were improved and further elements of the information technology systems for handling international applications were completed.

78. The Meeting noted the report by the International Bureau on its draft quality framework in document PCT/MIA/11/3 Rev. and the International Bureau's intention to submit further

documents on the subject to the Working Group on Reform of the PCT as well as to the PCT Assembly.

Assistance Relating to Offices Seeking Appointment as International Authorities

79. Discussions were based on document PCT/MIA/11/2.

80. One Authority emphasized that the quality of international search reports and international preliminary reports on patentability was essential to the entire PCT system. The increasing range of technology, quantity of prior art and variety of methods of publication meant that performing a full search was becoming increasingly difficult. While an appropriate number of examiners in an International Authority and access to the PCT minimum documentation, properly arranged for search purposes, were not in themselves indicators of quality, they remained necessary to ensuring high quality international search and preliminary examination. Furthermore, to achieve quality in the modern search environment, the requirements of Rule 36.1 should be considered an absolute minimum. It was also important that all existing and new International Authorities should conform to the requirements of the quality framework set out in Chapter 21 of the PCT International Search and Preliminary Examination Guidelines. As noted in document PCT/MIA/11/2, the requirement that the Authority should apply all the common rules of international search and preliminary examination was already implicit in the requirement of Articles 16(3)(b) and 32(3) and the agreements between each International Authority and the International Bureau. Nevertheless, it was suggested that an explicit addition might be made to Rules 36.1 and 63.1, requiring that every International Authority should have an appropriate quality system in accordance with the quality framework in the Guidelines.

81. It was noted that a number of Authorities already gave various forms of assistance to other patent Offices through bilateral arrangements, but emphasized that this must necessarily remain an optional matter for the Authorities, given the resource implications which were involved. One Authority suggested that the development of templates and/or questionnaires to assist the existing International Authorities in reporting on their quality systems (as suggested in paragraph 72, above) might assist the Meeting in developing guidelines which could be of benefit to Offices wishing to develop quality systems in preparation for seeking appointment as an International Authority.

82. The Meeting noted that offering advice on the quality systems of Offices seeking appointment as an International Authority would be a significant change in role and that further time was required for Authorities to consider the implications.

FUTURE WORK

83. It was noted that some of the matters considered at the present session would require further consideration at future sessions, including the comprehensive review of PCT minimum documentation, the Search Guidance Intellectual Property Digital Library, PCT statistics, the various issues under the heading of the quality framework and, subject to the result of consideration by the Working Group on Reform of the PCT, proposals for reform of the PCT which have relevance to the International Authorities.

84. The Secretariat noted that user groups had expressed interest in having a wider choice available to them in selecting an International Searching Authority. Such a proposal would,

of course, have wide-ranging consequences for International Authorities, which might be discussed at a future session. One Authority stated that applicants in its country were interested in such a possibility and requested the International Authorities to consider the matter, noting that it would of course be necessary also for receiving Offices to afford their client applicants a wider range of possible International Searching Authorities.

85. The Secretariat also noted that it may also be desirable to convene a forum bringing together the Chief Information Officers from the International Authorities to discuss IT issues, such as the PCT Electronic Data Interchange (PCT/EDI) service and ways to increase the use of electronic communications between the International Bureau and the International Authorities.

86. The Secretariat indicated that the next session of the Meeting was likely to be held in October or November 2005.

87. The Meeting unanimously adopted this report on February 25, 2005.

[Annex I follows]

¹ The presentations made at this session are available at http://www.wipo.int/meetings/en/details.jsp?meeting_code=PCT/MIA/11.

² See <http://www.wipo.int/scit/en/standards>.

³ The preliminary draft documents for the seventh session of the Working Group on Reform of the PCT are available at <http://www.wipo.int/pct/reform/en/draftdocs/wg7/index.html>.

ANNEX I

LIST OF PARTICIPANTS

I. INTERNATIONAL AUTHORITIES

(in the English alphabetical order of their names)

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II. OFFICERS

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Secretary: Michael RICHARDSON (WIPO)

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[Annex II follows]

ANNEX II

PROPOSAL BY THE KOREAN INTELLECTUAL PROPERTY OFFICE
FOR AMENDMENT OF PCT RULE 34

The proposed amendments to PCT Rule 34 which were presented by the Korean Intellectual Property Office (KIPO), intended to be submitted by KIPO to the PCT Assembly for adoption in 2005, are set out below. Proposed additions to the text of the Rule as currently in force are marked by underlining.

Rule 34

Minimum Documentation

34.1 *Definition*

(a) and (b) [No change]

(c) [No change] Subject to paragraphs (d) and (e), the “national patent documents” shall be the following:

(i) the patents issued in and after 1920 by France, the former *Reichspatentamt* of Germany, Japan, the Republic of Korea, the former Soviet Union, Switzerland (in the French and German languages only), the United Kingdom, and the United States of America

(ii) to (vi) [No change]

(d) [No change]

(e) Any International Searching Authority whose official language, or one of whose official languages, is not Japanese, Korean, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan, the Republic of Korea, the Russian Federation and the former Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than six months after such abstracts become generally available. In case of the

interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

(f) [No change]

[End of Annex II and of document]