

C. PCT 1295

March 8, 2011

Madam,  
Sir,

*Quality of Search and Examination of International Applications*

1. This Circular is addressed to your Office in its capacity as a receiving Office, International Searching Authority, International Preliminary Examining Authority and/or designated/elected Office under the Patent Cooperation Treaty (PCT). It is also being sent to Geneva-based missions and foreign ministries of PCT Contracting States and of States that are invited to attend meetings of the PCT Working Group as observers, as well as to certain organizations that are invited to attend meetings of the PCT Working Group as observers.
2. At its third session, held in Geneva from June 14 to 18, 2010, the PCT Working Group endorsed a series of recommendations to improve the functioning of the PCT system, based on a study prepared by the International Bureau (document PCT/WG/3/2) and related submissions from certain Member States (documents PCT/WG/3/5 and PCT/WG/3/13). The Working Group's discussions are outlined in the report of the session (document PCT/WG/3/14 Rev., paragraphs 14 to 137). The recommendations endorsed by the Working Group cover a variety of actions which should be undertaken by the International Bureau, applicants, Contracting States and national Offices (acting in both their national and international capacities) to make the PCT system more effective both for processing patent applications and for supporting technology transfer and technical assistance for developing countries.
3. This Circular aims to follow up on a number of recommendations endorsed by the Working Group relating to the quality of search and examination of international applications.

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4. The Annex to this Circular sets out the relevant recommendations endorsed by the Working Group and provides commentary on each recommendation and further questions.
5. I invite comments on the matters set out in the Annex to this Circular by all recipients of this Circular, including, but not limited to the specific questions set out in paragraphs 4, 5, 8, 10, 14, 16, 20, 22, 24, 25, 29, 30 and 32 of the Annex. Such comments should be sent by April 11, 2011 to Mr. Claus Matthes, Director, PCT Business Development Division (e-mail: [claus.matthes@wipo.int](mailto:claus.matthes@wipo.int); fax: +41-22-338 7150). The questions are directed to the different types of Office concerned, but responses are welcome from any recipient of the Circular.
6. The International Bureau will take any comments received within the above time limit into account in developing proposals for the PCT Working Group. The issues in this Circular will also be discussed during the 18th session of the Meeting of the PCT International Authorities, which will take place from March 15 to 17, 2011, in Moscow.
7. In general, any responses received in reply to this Circular will be presented in an anonymous fashion; individual responses from Offices will not be attributed without the specific prior permission of the relevant Office or organization.
8. The International Bureau would especially welcome comments and responses to the issues raised in this Circular from Offices of developing and least developed countries as well as Offices with few or no examiners of their own, so as to be able to address and follow-up on matters of relevance or concern to the work of all Offices.

Yours sincerely,



Francis Gurry  
Director General

Enclosure: "Following up Agreed Recommendations Relating to Quality of Search and Examination of International Applications"

ANNEX

FOLLOWING UP AGREED RECOMMENDATIONS RELATING TO QUALITY OF  
SEARCH AND EXAMINATION OF INTERNATIONAL APPLICATIONS

1. The text in the boxes below sets out the relevant recommendations endorsed by the third session of the PCT Working Group. The paragraph numbers refer to the paragraphs in document PCT/WG/3/2 where the recommendations were made, except where specifically indicated as being from PCT/WG/3/14 Rev., in the case of comments included from the report of the session to give additional context.

*Addressing Backlogs; Improving Quality of Granted Patents*

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| <p>143. <i>Recommendations</i> – Consequently, the following recommendations are made in relation to ISRs and IPRPs in order to make them more useful tools for assisting national Offices in addressing quality and backlog issues:</p> <ol style="list-style-type: none"><li>(a) The Offices which act as International Authorities should continue to take steps to improve both the actual and perceived quality and consistency of the reports which they establish in accordance with the current Treaty, Regulations and Guidelines, to ensure that they provide content which designated and elected Offices <i>wish</i> to take into account. This issue is considered further in paragraphs 158 to 172, below.</li><li>(b) The Offices which act as designated and elected Offices should continue to review the intended contents of ISRs and IPRPs and make any further recommendations for improvement within the limitations that the reports must be useful to all Contracting States and may not contain any comment on whether an invention is patentable or unpatentable according to any particular national law.</li><li>(c) The IB and the Offices which act as International Authorities should review the proposals for changes to the details of what should be contained in ISRs and IPRPs and report to the next session of this Working Group, including any recommendations which may appear appropriate, for example for changes to the Rules or Administrative Instructions (including the Forms).</li><li>(d) This exercise should in no way affect the right of designated and elected Offices to use the resulting ISRs and IPRPs in whatever way they see fit, in accordance with their national laws and policies.</li></ol> |
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2. Only one specific suggestion was made in the Working Group concerning the content of the international reports (see paragraph 89 of document PCT/WG/3/14 Rev.): "... one representative of users commented that it would be beneficial to consistently include an assessment of clarity and support in the description, which are currently optional parts of the report".
  3. More generally, several delegations considered that the system needed to ensure sufficiency of disclosure from the perspective of promoting technology transfer (see paragraphs 31, 42, 72 and 123 of document PCT/WG/3/14 Rev.), which would imply a need for International Authorities to actively address this question in their reports if this was going to be handled in the international phase. However, it was observed that sufficiency of disclosure was a substantive issue. Consequently, even if a consistent standard against which to report was agreed, it would be up to the designated and elected Offices to decide what action would be taken to enforce the requirements according to their national laws

(just as is the case for novelty and inventive step at present. This matter is to be the subject of a study, recommended by the Working Group as follows (additional recommendation paragraph 211*bis*, as set out under paragraph 129 of document PCT/WG/3/14 Rev.):

“211*bis*. It is recommended that a follow-up study be conducted by the IB to review and assess how well the PCT system has been functioning in terms of realizing its aim of disseminating technical information and facilitating access to technology as well as organizing technical assistance for developing countries.

“The study should also propose recommendations and suggestions on how to improve the realization of that aim, including on sufficiency of disclosure, for consideration by Contracting States at the 4th session of the PCT Working Group, recognizing that action on certain issues may require discussion in other WIPO fora.

“In this context, appropriate changes should be made in the proposed form for third party observations (document PCT/WG/3/6 Annex 2, p.2), including “sufficiency of disclosure” aspects, for discussion at the next session.”

4. *Designated and elected Offices and other recipients of this Circular are invited to make detailed proposals on possible changes to the required or permitted contents of international reports, which might assist processing of international applications in the national phase before their Office.*
5. *International Authorities are invited to comment on the increased use of the option, or the possibility of making mandatory, observations on the clarity of the claims, description and drawings, or the question of whether the claims are fully supported by the description (Rule 66.2(v)).*

146. *Recommendation* – In relation to other reports, it is recommended that designated and elected Offices which conduct search and examination in the national phase should consult with the IB on ways of making their national reports available to other designated and elected Offices, either by providing the national reports for inclusion on PATENTSCOPE<sup>®</sup>, or else by providing notifications that reports are available in a way which permits a link to be added in PATENTSCOPE<sup>®</sup> to a national file inspection system. This should be coordinated with other activities aimed at sharing national search reports between national Offices (such as those described in paragraphs 45 to 47 of document SCP/14/3) to minimize the work involved for Offices in making the reports available and to ensure that the reports are available to other Offices as easily and effectively as possible.
147. The IB should ensure that such reports are made available through PATENTSCOPE<sup>®</sup> in a way which permits efficient access by national Offices, both by looking at the conventional web pages or using automated processes to retrieve all relevant reports. Ideally, the citations should be made available in machine-readable format so that direct links can be provided to at least the easily available cited patent documents.

6. The discussions of this recommendation in the Working Group were reported in paragraph 90 of document PCT/WG/3/14 Rev. as follows:

“In relation to the recommendation set out in paragraph 146, the need to have access to reports of other national Offices was mentioned as being of particular importance by several delegations from both industrialized and developing

countries. It would be important to ensure that these documents were made available as quickly as possible after their establishment so as to maximize their chances of being of use in other Contracting States. It would also be important to coordinate work with the various other projects of a similar nature which were either under way or being planned. One delegation noted that the alternative option noted in paragraph 148 of seeking reports directly from individual Offices or requesting them through the applicant should also remain available. It was also suggested that the system could extend to include the results of opposition proceedings as well as search and examination reports.”

7. In the short term, and specifically in respect of the PCT, the International Bureau is willing to make available any national search and examination reports or results of opposition proceedings which designated and elected Offices send concerning the national phase of an international application. The PATENTSCOPE® search service also links to Offices' public file inspection systems where these are available and the existence of a national phase entry is notified to the International Bureau. In these cases, making available might alternatively be done by linking to the copy in a file inspection system based on a mere notification that a new report had been established. Such arrangements may also allow access to other background material which help to understand the reports, such as copies of proposed amendments.
8. *Offices are invited to report progress and plans for developing their own national file inspection systems that would serve the purpose of making available national phase search and examination reports and related documents, such as the results of opposition proceedings concerning the national phase of an international application..*
9. For the longer term, and independently of the PCT, the International Bureau is, at the separate request of the Member States, currently developing a system known as CASE (Centralized Access to Search and Examination). This will allow Offices to share documents from their application files with one another. At an initial stage, this would include search reports, search strategies and examination reports for national applications. The initial prototypes are being developed in conjunction with a number of groups of national Offices which wish to work together more closely. Once the fundamental concepts, including different models for information sharing, have been tested with a range of Offices of different sizes, the International Bureau will make a proposal on how this system can be used to provide benefits in the context of the PCT. In the meantime, general comments on any features that such a system should include for PCT purposes are welcome.
10. *Offices are invited to comment on features which they would find important in a system for sharing file information in the context of both the international and national phases of international applications under the PCT.*

<p>149. <i>Recommendation</i> – The IB should make available a system allowing third parties to submit observations on published international applications, including references to disclosures which they believe mean that the claimed invention may not be novel or inventive. It should remain open to designated Offices to decide to what extent they should review disclosures cited through such a system (the International Bureau intends to issue a document covering this subject in greater detail).</p>
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11. This recommendation was the subject of more detailed proposals in Circular C. PCT 1288. Comments on this subject should preferably be made in response to that Circular by March 31, 2011.

*Addressing Timeliness in the International Phase*

154. *Recommendations* – The following recommendations are made in relation to ensuring that ISRs and IPRPs are delivered in accordance with the time limits set by the Treaty. For the reasons pointed out in paragraph 153, above, these recommendations are in very general terms:
    - (a) Receiving Offices should ensure that they have adequate staff, facilities and training to receive and check international applications, and where necessary to send invitations for correction, promptly on receipt. They should also ensure that procedures, such as those for receiving fees, are easy to use for applicants and permit the Office to make the necessary checks quickly and accurately.
    - (b) The IB and receiving Offices should ensure that applicants have access to accurate, up-to-date information on the filing requirements for international applications, especially fees, in order to minimize the number of defects which need to be corrected before the international application is forwarded to the ISA and the IB.
    - (c) The IB should review the Receiving Office Guidelines to ensure that they are both up-to-date and easy to follow. The IB should also, where necessary in cooperation with national Offices and subject to the availability of resources, seek to make the Guidelines available in as many languages of publication as possible (at present, they are available in English, French, Japanese, Portuguese, Russian and Spanish).
    - (d) International Authorities should ensure that they have adequate resources to conduct the expected number of international searches and international preliminary examinations in addition to their national work and that, in cases where backlogs do build up, international work is given appropriate priority to ensure that the results are available to designated and elected Offices in the national phase and, as far as possible, to third parties by the time of international publication.
12. Circular C. PCT 1287 requested more information to follow up this recommendation. In addition, International Authorities are required to report on their procedures relating to paragraph (d) in accordance with the quality framework set out in Chapter 21 of the PCT International Search and Preliminary Examination Guidelines. While further comments on these issues remain welcome, the International Bureau hopes that the responses to these earlier exercises will be sufficient to determine whether further action at the international level would be useful.

165. The following *recommendations* are therefore made to address the *actual* quality of ISRs and IPRPs:
- (a) The International Authorities should continue to develop their internal quality management systems in accordance with the quality framework set out in Chapter 21 of the International Search and Preliminary Examination Guidelines such that their internal processes, including quality assurance processes, promote the establishment of high quality ISRs and IPRPs. The work should take into account the aim of developing useful and transparent quality metrics for measuring the usefulness of international reports in assisting the assessment of patentability by designated Offices.
  - (b) International Authorities should continue to seek ways of effectively searching documentation in languages which are not official languages of their Office. This should involve both technical means and trials of arrangements whereby examiners in Offices with complementary skills work together to establish a report.
  - (c) Offices whose national patent collections are not readily available in electronic form should consider digitizing them (with the assistance of the IB, if desired) and making them available to International Authorities and other Offices for search purposes.
  - (d) The IB should coordinate the development of a centralized system permitting designated Offices to give feedback to International Authorities.
13. Items (a) and (b) are the subject of ongoing work within the individual International Authorities, the Meeting of International Authorities (see especially document PCT/MIA/18/2) and its quality subgroup.
14. *Offices are invited to comment on issues which they consider need to be taken into account in the development of quality management systems for International Authorities.*
15. The International Bureau has assisted a number of Offices to digitize their national patent document collections and is willing to assist with others. One of the objectives of the proposal in document PCT/MIA/18/11, relating to the PCT minimum documentation, is to encourage national Offices to make this information available.
16. *Offices are invited to comment on whether additional activities should be undertaken to encourage or assist national Offices to make their patent documents available in electronic form.*
17. Item (d) is the subject of a proposal in document PCT/MIA/18/6. Following discussions by the 18th session of the Meeting of International Authorities, it is likely that further, specific consultations will be undertaken with designated and elected Offices.

*Addressing the Quality of International Search and Preliminary Examination*

170. The following *recommendations* are made primarily to address the quality of ISRs and IPRPs as *perceived* by designated Offices, but should also improve the actual quality of reports:
- (a) Offices which act as International Authorities should recognize the quality of their own work and not *routinely* conduct more than a “top-up” search when an international application for which they acted as International Authority enters their national phase. This should, of course, not prevent examiners from conducting whatever searches are necessary to ensure a high quality granted patent *in individual cases* where it can be seen that the scope of the international search was deficient, or where there is other need for additional searching, such as because the scope of the claims has significantly changed or because some inventions were not searched due to a lack of unity of invention.
  - (b) International Authorities should seek to make available more information relating to search strategies so that examiners in designated Offices can more easily assess the scope of the international search which has been conducted.
  - (c) International Authorities should seek to cite documents from a wide range of sources, where this is possible without reducing the quality of the search.
  - (d) International Authorities should encourage their examiners to give good explanations of the relevance of cited documents, especially in cases where the examiner considers that there is either a lack of inventive step, or else that the documents together show all the features of the claims but the examiner nevertheless considers that the combination is inventive over those disclosures (since an examiner from another jurisdiction might either come to a different conclusion, or else it might take a significant amount of analysis to reach the same conclusion).
18. Item (a) has been recognized as a desirable goal by all International Authorities, though not all of them are yet in a position to be able to implement it. This recommendation now appears only to require assessment of its state of implementation in future years.
19. Some aspects of Item (b) will be discussed by the 18th session of the Meeting of International Authorities in the context of document PCT/MIA/18/9.
20. *Offices are invited to comment on what level and format of information on search strategies would be useful to help assess the scope of a search carried out by another Office, noting that it will frequently have been conducted using different search languages and different databases to those used by the Office assessing the search.*
21. Item (c) is aimed at addressing the perception that the scope of a search might have been too limited if all the cited documents come from a single source, especially where that source is the collection of patent documents issued by the Office which conducted the search. In most cases this situation merely reflects the fact that there are often many disclosures of equal value for demonstrating what was known before the filing date or priority date of the international application and it is most efficient for the examiner to cite disclosures from documents in the format with which he is most familiar. Nevertheless, it would be useful if examiners were aware of the problem and cited documents from a range



of sources where this can easily be achieved and gives an equally good result. This is not intended to suggest that examiners should cite additional, less relevant prior art solely to give an impression of diversity with the result of causing extra work of no value, both for themselves and for those reading the reports.

22. *International Authorities are invited to comment on whether it is practical to increase the diversity of sources of cited documents without increasing the work involved in making the search or reducing the quality of the search.*
23. The International Bureau considers that item (d) is linked to item (a): it will be more important to International Authorities that the issue of inventive step is reported clearly if the Office which acts as an International Authority hopes to gain benefits from the international phase processing to reduce the work needed in the national phase, either by closely basing its national examination on the international written opinion, or else by hoping that the applicant will have amended the application to overcome any allegations of lack of inventive step before national phase examination begins.
24. *International Authorities are invited to comment on the perception that there is often insufficient explanation of the relevance of cited documents, and on what could be done to improve this.*

*Creating Incentives for Applicants to Use the System “Efficiently”*

176. Consequently, the following *recommendations* are made in respect of improving the quality of international applications during the international phase:
- (a) The IB and national Offices should recommend to applicants that they prepare applications in good time and conduct their own prior art search before drafting their claims.
  - (b) International Authorities should offer applicants a good opportunity for dialogue with the examiner during international preliminary examination, including at least one written opinion before establishing a “negative” IPRP.
  - (c) Contracting States should consider possible incentives which could be introduced either internationally or at the national level to encourage applicants to file higher quality applications and to have defects corrected in the international phase.

25. *In relation to item (a), Offices are invited to comment on what action they have taken to educate applicants about the importance of preparatory searching and the timeliness and quality of actions in relation to preparing and filing patent applications. Offices are also invited to comment on whether there is a need for further action in this area by the International Bureau, national Offices or the Member States collectively.*
26. The issues underlying item (b) has been discussed several times by the Meeting of International Authorities, most recently at its 17th session, reported in paragraphs 51 and 52 of document PCT/MIA/17/12, as follows:
- “51. Several Authorities expressed their support for giving adequate opportunity for dialogue in Chapter II proceedings by guaranteeing at least one (further) written opinion and opportunity to respond prior to the establishment of a negative

international preliminary report on patentability. Some of those Authorities suggested that the Regulations should be amended accordingly, whereas others expressed the view that this should be left to the discretion of the Authority concerned, noting that, where the applicant had properly responded to the written opinion of the International Searching Authority, they would, as a general rule, issue a second written opinion and give a further opportunity to respond. Some Authorities noted that, already at present, they would establish a written opinion whether the applicant had responded to the opinion of the International Searching Authority or not.

“52. Other Authorities stated that efforts to improve the overall system should focus on Chapter I procedures, notably improving the quality of international search reports, and so as to not undo the benefits which had been achieved when the written opinion by the International Searching Authority, which also served as the first written opinion by the International Preliminary Examining Authority, had been introduced into the PCT system some years ago.”

27. The International Bureau agrees with the view that the Chapter I procedures are the most important ones to focus on in order to ensure that the work of the international phase is useful to the Contracting States in allowing them to reduce the risk of invalid patents being granted. Without a high quality international search, any work under Chapter II is wasted and the results will be of no use to designated and elected Offices. Furthermore, it is recognized that Chapter II international preliminary examination is now only demanded for around 10% of international applications.
28. However, while there is always a desire and scope for improvement, the searches are in general of a good quality. Moreover, it was not intended by most Contracting States that the changes to the Article 22 time limit should stop applicants from using Chapter II; rather, the intention was that applicants should not use this route solely in order to “buy time”, without any intention of actually trying to eliminate defects from their international applications before entering the national phase. Since the changes to the Article 22 time limit, applicants will usually go to the expense of demanding international preliminary examination only in cases where there is a real desire to overcome the defects perceived by the examiner at the international search stage so that the international application can enter the national phase with no known defects and stands a good chance of being granted, save in countries where the relevant aspects of substantive patent law are significantly different. This reduces the costs and risks for both applicants and Offices and may have particular benefits in countries which offer accelerated examination schemes or other benefits based on positive PCT reports, such as the Patent Prosecution Highway (PPH). In most cases, the national phase Offices will include the one which acted as International Preliminary Examining Authority. As such, a dialogue between the examiner and the applicant ought to be no additional effort overall (only a change of timing) and would offer great benefits to both the applicant and the other Contracting States where the applicant enters the national phase.
29. *International Authorities are invited to comment further on the extent to which applicants ought to be offered an opportunity for dialogue when they have made amendments or comments in Chapter II in response to a written opinion of the International Searching Authority.*
30. *In relation to item (c), Offices are invited to comment on any specific incentives which they believe might be used to encourage high quality applications and early correction of defects.*

*Addressing Access to Effective Search Systems*

185. It is <i>recommended</i> that the International Bureau and Contracting States continue to seek practical and affordable ways for national Offices to develop online searching capabilities.
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31. The International Bureau continues to develop the coverage and capabilities of the PATENTSCOPE<sup>®</sup> search system. It is also working to facilitate access for least developed and developing countries to commercial patent databases through the Access to Specialized Patent Information (ASPI) program and to scientific and technical journals through the Access to Research for Development and Innovation (aRD<sub>i</sub>) program.

32. *Offices are invited to comment on any further actions which could be undertaken to assist national Offices to gain access to online searching capabilities.*

[End of Annex and of circular]