

C. PCT 1326

December 16, 2011

Madam,  
Sir,

*Quality of Search and Examination of International Applications –  
Content of Written Opinions and International Preliminary Examination Reports*

1. This Circular is being sent to your Office in its capacity as a designated and elected Office and, where applicable, a receiving Office and/or an International Searching and Preliminary Examining Authority 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 interested intergovernmental organizations and certain non-governmental organizations representing users of the PCT system.

*Background*

2. The PCT Working Group, at its third session held in Geneva from June 14 to 18, 2010, 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), as detailed in the report for the session (document PCT/WG/3/14 Rev., paragraphs 14 to 137).

3. As a follow up to the discussions by the Working Group, the International Bureau invited all PCT stakeholders, by way of Circular C. PCT 1295, dated March 8, 2011, to comment on certain matters relating to the quality of search and examination of international applications.

4. Pending responses to that Circular, the issue of quality was further discussed by the Meeting of International Authorities under the PCT (PCT/MIA) at its eighteenth session, held in Moscow from March 15 to 17, 2011, in particular with regard to the question of what should be the appropriate content of written opinions and international preliminary reports on patentability. The PCT/MIA discussions are summarized in paragraphs 22 to 25 of the report of the session (document PCT/MIA/18/16), reproduced in Annex II to this Circular.

./.

/...

5. A summary of the responses to Circular C. PCT 1295 in relation to quality and appropriate content of reports by International Authorities was presented to the PCT Working Group at its fourth session, held in Geneva from June 6 to 10, 2011, as set out in paragraphs 12 to 14 of document PCT/WG/4/3, reproduced in Annex III to this Circular.
6. The discussions by the Working Group of document PCT/WG/4/3 in relation to backlogs and improving quality of granted patents are detailed in paragraphs 41 to 48 of the report of the fourth session of the PCT Working Group, reproduced in Annex IV to this Circular.
7. Annex I to this Circular sets out proposals for modifications to the PCT International Search and Preliminary Examination Guidelines to indicate that observations on significant and pertinent issues relating to the clarity of the claims, the description and the drawings, and to the question of whether the claims are fully supported by the description (PCT Rule 66.2(a)(v)) should always be included in the written opinion and the international preliminary examination report. Other issues concerning the content of the opinion and report covered by Circular C. PCT 1295 will be the subject of further consultations and/or working documents to be prepared by the International Bureau.

*Proposed Modifications to the International Search and Preliminary Examination Guidelines*

8. As can be seen from the summary of the responses to Circular C. PCT 1295 in relation to quality and appropriate content of the written opinion and international preliminary examination reports set out in Annex III, there is a clear desire for the inclusion in every written opinion and international preliminary examination report of observations on at least significant and pertinent issues of clarity and support. This idea also received support at the Meeting of International Authorities (see Annex II), and from the majority of delegations that took the floor on this matter during the discussions at the PCT Working Group (see Annex IV).
9. In order to increase the usefulness of written opinions and international preliminary examination reports to designated/elected Offices and users, Annex I to this Circular sets out a proposal to modify the International Search and Preliminary Examination Guidelines in order to provide further guidance to International Authorities on the inclusion of observations on clarity and support. The proposed modifications aim to clarify that International Authorities should provide more comprehensive information on these matters in the written opinion or international preliminary examination report where the examiner considers that there are significant and pertinent clarity and/or support issues relevant to further processing of the international application, notably in the national phase of the PCT procedure before designated/elected Offices.
10. With regard to the question as to whether or not to include observations on the issue of clarity and support separately from considerations of novelty, inventive step and industrial applicability, the proposed modifications to the Guidelines clarify that due account should be given to the significance and pertinence of such objections in the further processing of the application. In particular, where a positive assessment of novelty, inventive step and industrial applicability is made in respect of all claims, an adequate analysis of clarity and support should be made by the International Authority. In such cases, the examiner should either make any relevant observations on lack of clarity and support, or include a positive statement that he has considered those criteria and that the requirements for clarity and support appear to be satisfied.

/...

11. Account should nevertheless be given to other amendments that may be necessary to the claims, for example, to overcome any negative statement with regard to novelty, inventive step (non-obviousness) and/or industrial applicability. Objections with regard to issues of clarity and support therefore need not be included where amendments will have to be made in order to overcome other objections where the likely result from such amendments is that the clarity and support issues will no longer be relevant to the further processing of the application.
12. Since situations will exist where it will not be appropriate to raise observations on clarity and support or make a positive statement that these requirements appear to be satisfied, the inclusion of a "Yes/No" check box to assess clarity and support in the written opinion and international preliminary examination report (that will not always require completion) is not proposed at this stage.
13. The International Bureau invites comments on the proposed modifications to the PCT International Search and Preliminary Examination Guidelines, to be sent to Mr. Claus Matthes, Director, PCT Business Development Division (e-mail: *claus.matthes@wipo.int*; fax: +41-22-338 7150) by January 29, 2012.
14. In general, any response received in reply to this Circular included in any subsequent report on the responses to this Circular will be presented only in an anonymous fashion; individual responses from Offices will not be attributed without the specific prior permission of the relevant Office or organization.
15. The issues raised in this Circular will also be discussed at the nineteenth session of the Meeting of International Authorities under the PCT, to take place in Canberra from February 8 to 10, 2012. Comments received prior to the above deadline will be reported to the Meeting of International Authorities so that they can be taken into account in the quality related discussions of that Meeting.

Yours sincerely,



James Pooley  
Deputy Director General

- Enclosures:
- Annex I – Proposed Modifications to the PCT International Search and Preliminary Examination Guidelines
  - Annex II – Extract from Report of the Eighteenth Session of the Meeting of International Authorities under the PCT (paragraphs 22 to 25 of document PCT/MIA/18/16)
  - Annex III – Summary of Responses to Circular C. PCT 1295 in Relation to Quality and Appropriate Content of Reports by International Authorities (paragraphs 12 to 14 of document PCT/WG/4/3)
  - Annex IV – Extract from Report of the Fourth Session of the PCT Working Group (paragraphs 41 to 48 of document PCT/WG/4/17)

PCT International Search and Preliminary Examination Guidelines  
Proposed Modifications

*Clarity or Support*

Rule 66.2(a)

17.31 Where the description, the claims, or the drawings are so unclear, or the claims are so inadequately supported by the description that no meaningful opinion can be formed on the questions of novelty, inventive step, or industrial applicability of the claimed invention, then the examination should ~~may~~ be restricted to those claims that are sufficiently clear and supported by the description to enable an opinion or report to be prepared ~~(see Box No. III, 4<sup>th</sup> and 5<sup>th</sup> check boxes)~~. In such a case, the examiner marks the appropriate check box in Box No. III (the 4th and/or the 5th check boxes) and includes observations below the appropriate check box on lack of clarity and/or support to explain the limitation of the examination.

17.32 The issues of clarity and descriptive support of the claims should, as appropriate, ~~may~~ be raised separately from considerations of novelty, inventive step and industrial applicability at Box No. VIII of the opinion or report (see chapter 5 and paragraph 17.48).

17.33 These matters should not be raised in an international preliminary examination report unless they have already been raised in a written opinion.

*Box No. VIII: Certain Observations on the International Application*

Rule 70.12

17.48 If, in the opinion of the examiner, there are significant and pertinent issues as to the clarity of the claims, the description and the drawings, or the question whether the claims are fully supported by the description, observations should be made ~~as to the clarity of the claims, the description and the drawings, or the question whether the claims are fully supported by the description, the examiner includes these observations to this effect in Box No. VIII of the written opinion and/or examination report, and also indicates the reasons therefor~~. In such a case, the examiner should list the numbers of any relevant claims and indicate the reasons for lack of clarity and/or support. In deciding whether or not to include any observations on these matters, due account should be given to the significance and relevance of the observations in any further processing of the application during the national phase before designated/elected Offices. In particular, the examiner should take into consideration other amendments that may be necessary to the claims, for example, to overcome any negative statement with regard to novelty, inventive step (non-obviousness) and/or industrial applicability. Observations with regard to issues of clarity and support therefore need not be included when it is highly likely that amendments will have to be made in order to overcome other objections that could be raised in the national phase and these amendments would also resolve the clarity and support issues. On the other hand, where an opinion or a report includes a positive statement with regard to novelty, inventive step (non-obviousness) and industrial applicability in respect of all claims, the opinion or report should raise any significant and pertinent matters concerning clarity and support. Moreover, where no such matters arise, the opinion or report should include the following statement in Box No. VIII: "The claims appear to satisfy the requirements for clarity and are fully supported by the description and thus do not call for any observations under Rule 66.2(a)(v)" (see also paragraphs 5.31 to 5.58 and 17.09).

## **THE FUTURE OF THE PCT**

### **Recommendations Endorsed by the Working Group Relating to Quality**

#### *Content of Written Opinions*

22. In relation to the appropriate content of written opinions and international preliminary reports on patentability (paragraphs 4 and 5 of the Annex to document PCT/MIA/18/3), the Meeting agreed that the International Bureau should await responses to Circular C. PCT 1295 to see whether any detailed proposals for changes to the content of reports would be received from designated Offices aimed at making those reports more useful for assisting the process of national search and examination. The International Bureau should then prepare a Circular containing proposals for improvements to the International Search and Preliminary Examination Guidelines and, possibly, preliminary proposals for changes to the PCT Regulations based on any such responses from designated Offices and on the comments below. Consideration could also be given to providing an electronic forum to assist any discussions.
23. The Meeting noted the relevance of the issues to be discussed in the context of documents PCT/MIA/18/8 and 9 (see paragraphs 59 to 68, below). Some Authorities noted that the box format of written opinions was not always conducive to the effective reporting of problems with clarity and sufficiency of disclosure. It was noted that the Meeting, in previous sessions, had been generally in favor of moving towards a linear format of written opinions, though it had not wished at the time to take forward the question of ensuring that sufficient consistency of format remained to allow users (especially those who were not native speakers of the language of the report) to identify and understand the types of content easily. It was suggested that this matter could be taken up in the context of the use of standardized clauses in reports, as proposed in document PCT/MIA/18/8.
24. The Meeting agreed that it was important that reports should always include significant issues of clarity and support for the claims and noted that most Authorities already instructed their examiners accordingly. There should remain flexibility, however, over the extent to which minor issues needed to be reported, especially where responses to other objections would necessarily result in major redrafting of the part of the application concerned, following which the minor issues would no longer be relevant. As an interim step, this matter should be clearly reflected in the PCT International Search and Preliminary Examination Guidelines. Inclusion of this requirement in PCT Rule 66 could be considered later as part of any broader package of changes which might be considered necessary. It was highly desirable that, if changes were to be made to Rule 66, they should all be made at the same time to reduce confusion over which version of the Rule was applicable to which international applications.
25. One Authority stressed the importance of ensuring that reports were equally valuable to all designated Offices. In particular, it was important that international searches should include details of patent applications falling into the category of PCT Rule 33.1(c) which might be relevant to inventive step in some States. It was observed, however, that the timing of the international search was such that the results could not be considered complete and there would always be a need for national phase top-up searches. A second issue raised was the importance of ensuring that the indication of any claims which had been cancelled as a result of amendments was filled in properly.

Summary of the Responses to Circular C. PCT 1295 in Relation to Quality and Appropriate Content of Reports by International Authorities (document PCT/WG/4/3)

**Recommendations Related to Backlogs; Improving the Quality of Granted Patents**

...

*Recommendations Set Out in Paragraph 143*

...

12. The responses to Circular C. PCT 1295 indicated that Offices found the intended contents of international reports do generally meet their needs. The most commonly expressed desire for improvement is to make it mandatory to include comments on at least significant issues of clarity (notably, where there is any doubt about the scope of the claims) and sufficiency of disclosure. One Office suggested that, insofar as these issues apply to specific claims, the written opinion form could include “Yes/No” boxes as is done for novelty, inventive step and industrial applicability.

13. With regard to the performance of International Authorities in meeting the requirements, most respondents indicated that they were satisfied in most cases, but that there was a need for improved quality control and greater consistency of approach and some respondents indicated a need for more detail on the scope of the search (see also paragraph 55 [of document PCT/WG/4/3], below). A number of Offices indicated that a change of approach in presenting the report might help. This might involve moving away from the current “box” format of report to a more linear form, merging or slightly modifying some of the boxes and/or using more standard clauses to guide examiners in presenting arguments consistently and fully.

14. The International Authorities have begun consideration of possible improvements in this area and the responses will be presented to the International Authorities in more detail to assist those discussions.

[Annex IV follows]

## **Implementation of Recommendations to Improve the Functioning of the PCT System**

### *Recommendations Related to Backlogs; Improving Quality of Granted Patents*

41. The Delegation of India, speaking on behalf of the Development Agenda Group, welcomed efforts made by the International Bureau to take forward the recommendations in this cluster, especially the issuance of Circular C.PCT 1295 dated 8 March 2011. Despite a limited number of 16 responses, the Delegation nevertheless welcomed the proposed improvements, such as mandatory inclusion of comments on the significant issues of clarity and sufficiency of disclosure. The Delegation also supported the need expressed by respondents for improving quality control and having greater consistency of approach and detail with regard to the scope of search in the international reports. It welcomed the fact that the International Authorities had begun consideration of possible improvements in this area and looked forward to the inclusion of these specific improvements in their report to the fifth session of the Working Group, especially that of the quality subgroup. In noting the proposed two models for sharing search and examination reports, namely, the “open model” such as PATENTSCOPE and the “closed model” such as the IP5’s “One Portal Dossier” project, the Patent Prosecution Highway, and the Vancouver Group, the Delegation stated that decisions about participation in closed plurilateral modes of work sharing should be left to individual Contracting Parties and their patent Offices, to be made on a voluntary basis, in accordance with their specific needs and realities.

42. The Delegation of India further noted the increase in patent applications against a declining trend in research and development expenditures, in particular for second filings (as stated in the study on the surge in work-wide patent applications). In its view, this clearly showed a mismatch between the global level of invention and the number of patents, given the increase in patents without a corresponding increase in the quality of innovations. Therefore, in the view of the Delegation, the lowering of patentability standards in countries from where the majority of patent applications originated was the root cause behind the surge in patent applications and the resulting backlogs. Unless this root issue was addressed, promoting work sharing would only superficially address the symptomatic effects engendered by the root cause of the surge in patent applications and the resulting backlogs. Even in the context of work sharing, the Delegation considered it necessary to ensure that the workload in the international phase was shared equitably among all International Authorities, including those from developing countries. For this purpose, all International Authorities should share their search databases, which had to be based on open models like PATENTSCOPE and not on closed models. However, there should be no change in the legally non-binding nature of international search or examination reports and no national Office should be expected to rely on such reports. Thus, even International Authorities could not be expected not to conduct a top-up search for an application in the national phase, even where the Office itself had processed it as an international application.

43. The Delegation of India concluded in saying that, in order to enhance the quality of work and reduce backlogs, priority should also be given to strengthening national search and examination capacities in patent Offices in developing and least developed countries. It stated that many Offices with inadequate or non-existent search and examination capacity were not in a position to offer meaningful quality feedback on the quality of international search and examination reports. Hence, while the quality feedback mechanism was a positive development, it needed to be complemented by a strengthening of search and examination capacity through technical assistance offered or coordinated by WIPO, in accordance with the WIPO Development Agenda recommendations and taking into account

national legal contexts and development objectives. In this regard, the Delegation reiterated the necessity of rejuvenating the Committee for Technical Assistance mandated under Article 51.

44. The Delegation of the United States of America stated that it wished to comment on specific proposals set out in document PCT/WG/4/3. In relation to paragraph 12, the United States Patent and Trademark Office (USPTO) instructed its examiners to make observations on lack of clarity of claims, but if there were only positive indications on clarity, no remarks would be made. The inclusion of a “Yes/No” box for clarity was therefore not considered appropriate. The Delegation stated that it nevertheless supported an additional section for listing the numbers of claims with negative observations on clarity. Regarding the recommendation that national Offices make publicly available their national reports, the USPTO had implemented this recommendation through its Patent Application Information Retrieval (PAIR) system, and the USPTO provided national phase information to WIPO such that any corresponding US national phase application was identified by application number in the national phase tab for international applications in PATENTSCOPE. Finally, regarding the discussion in paragraph 15 concerning the establishment by the International Bureau of an automated process for retrieval of all other reports for a given applications or family of applications, the Delegation stated that the Trilateral Offices were in the process of developing a common citation document system which would serve this function once fully implemented.

45. The Delegation of Japan stated its commitment to improving the functioning of the PCT and expressed its support for the activities set out in the working documents aimed at achieving this goal. With regard to paragraphs 11 and 12 of document PCT/WG/4/3, in order to enhance the user value of the PCT system, the Delegation considered it preferable that International Authorities proactively post their observations on the quality of the claims, descriptions and drawings, and on whether the claims were fully supported by the description. In addition, the Delegation considered it important to analyze individual practices of International Authorities concerning the description requirement in order to encourage national Offices to utilize observations more effectively.

46. The Delegation of South Africa, speaking on behalf of the African Group, welcomed the findings collected through the Circular C.PCT 1295, in particular, the recommendation made by some Offices to make it mandatory to include comments on at least significant issues such as clarity and sufficiency of disclosure, pertinent to the smooth functioning of the patent system and for a balanced approach between users and public interests. The African Group applauded the PATENTSCOPE system as an open model for sharing of patent information and encouraged other countries to join and use the system which enabled access to patent information and made information readily available. While taking note of the usefulness of closed models, the Delegation was of the view that these should be used by Offices for specific needs, as stated in the document. The African Group welcomed the initiative to invite Offices wishing to emulate the WIPO CASE platform to do so, noting that Offices responding to C.PCT 1295 had stated that document sharing platforms such as WIPO CASE needed to ensure that they were readily accessible to Offices with significantly different levels of infrastructure and models for making file information available. Thus, the issue of different levels of development should be considered in closed models, which should not be used as platforms to overshadow the laws and practices of Member States. The African Group also welcomed the invitation by the Secretariat to Contracting States and their patent Offices to consult the International Bureau on ways to digitize documents in their national patent collections for the purposes of dissemination and inclusion in patent search databases.



47. The Delegation of Australia stated that, in relation to paragraph 12 of the document, it did not see the need for “Yes/No” boxes covering clarity issues. However, as agreed at the eighteenth session of MIA, the Delegation supported mandatory observations on clarity and support of the claims when this was identified as an issue by the International Authority. In this regard, IP Australia currently provided observations on significant issues affecting the clarity of claims, description and drawings and whether the claims were fully supported by the description. In relation to paragraph 15, the Delegation stated that it supported the sharing of information between Offices, which should improve the quality of search and examination of applications as well as increase efficiency through work sharing. With respect to the open and closed models, the Delegation agreed there was a place for both, citing the online national file inspection system at IP Australia (now part of the e-dossier for applications filed after 2005) as an example of the open model and its involvement in the Vancouver Group with the United Kingdom Intellectual Property Office and the Canadian Intellectual Property Office and its active role in developing the WIPO CASE platform as examples of the closed model.

48. The Delegation of India expressed its support for views expressed in relation to the importance of clarity and support and commented on sufficiency of disclosure. On the one side, sufficiency was closely linked with novelty and inventive step, and on the other side it added further requirements beyond clarity and support. Sufficiency of disclosure was therefore extremely important, particularly for pharmaceutical patents which could include Markush formulae, covering literally billions of compounds. The Delegation sincerely believed that the quality of the PCT databases would increase immensely if the reports providing opinions on novelty and inventive step also contained expert opinions on sufficiency of disclosure. The Delegation therefore considered that this should be introduced immediately, particularly as trivial pharmaceutical patents had become an extremely important issue affecting the availability of medicines in developing countries.

[End of Annex IV and of Circular]