E

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

PCT/MIA/19/14
ORIGINAL: ENGLISH ONLY
DATE: AUGUST 29, 2012

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

Nineteenth Session
Canberra, February 8 to 10, 2012

REPORT

adopted by the Meeting

INTRODUCTION

1. The Meeting of International Authorities under the PCT ("the Meeting") held its nineteenth session in Canberra from February 8 to 10, 2012.

2. The following International Searching and Preliminary Examining Authorities were represented at the session: the Austrian Patent Office, the Brazilian National Institute of Industrial Property, the Canadian Intellectual Property Office, the Egyptian Patent Office, the European Patent Office, the Federal Service for Intellectual Property of the Russian Federation, IP Australia, the Israel Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, the National Board of Patents and Registration of Finland, the Nordic Patent Institute, 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.

ITEM 1: OPENING OF THE SESSION

4. Ruth Bell, elder of the Ngunnawal people, offered a traditional welcome to country to the participants.

5. Fatima Beattie, Deputy Director General of IP Australia, welcomed the participants and chaired the session, except for items 10 to 12, which were chaired by Greg Powell, Supervising Examiner, IP Australia. James Pooley, Deputy Director General of the World Intellectual Property Organization welcomed participants on behalf of the Director General.

ITEM 2: ADOPTION OF THE AGENDA

6. The Meeting adopted the agenda as set out in document PCT/MIA/19/1 Rev., subject to:

(a) the addition of document PCT/MIA/19/7 Add. under item 7 and document PCT/MIA/19/8 Add. under item 8;

(b) deciding that the Chair should present a summary of the session under item 13 and that the report would be adopted by correspondence.

ITEM 3: PCT STATISTICS

7. The Meeting noted a presentation by the International Bureau on the most recent PCT statistics[1].

ITEM 4: QUALITY

(a) Report from the Quality Subgroup

8. The Meeting:

(a) noted with approval the Summary by the Chair of the Meeting's Quality Subgroup set out in Annex II to this document;

(b) approved the continuation of the Subgroup's mandate, highlighting the particular importance of the quality-related work set out in paragraphs 49 to 52 below;

(c) agreed that the annual reports submitted by the International Authorities should be made publicly available on WIPO's website; and

(d) agreed that the International Bureau should submit a report to the PCT Assembly on the work undertaken in relation to the quality framework, including a reference to the annual reports, an aggregate report to be drafted by the Quality Subgroup, and annexes comprising the report from the Quality Subgroup as set out in the Annex to this document and relevant sections of this summary or the report of the session.

(b) Trilateral Collaborative Study on Metrics

9. The Meeting noted a presentation by the European Patent Office (EPO) on the "Collaborative Study on Metrics"[1] carried out by the Trilateral Offices (the EPO, the Japan Patent Office (JPO) and the United States Patent and Trademark Office (USPTO)). Following on from a small and limited study which had been made by a national non-governmental organization, the Trilateral Offices had agreed to undertake a pilot collaborative study of quality metrics of international search reports (ISRs). The aim was to work together on collecting data

and agreeing an approach which allowed a better understanding of commonalities and differences between the Offices. The EPO had created a technical environment to assist the analysis.

10. The study was conducted in three phases:

(a) Phase 1 consisted of a statistical analysis of 720,000 ISRs established between 2004 and 2009. This looked into the characteristics of the citations in the ISRs from different Offices, such as the average number of citations, the frequency of citation of non-patent literature, the proportion of reports including X and Y category citations and the languages of citations, as well as how these characteristics had changed over time.

(b) Phase 2 consisted of a sample-based study of 1152 files per International Searching Authority (ISA), looking at the contribution of the ISR to the national first actions.

(c) Phase 3 had been postponed, but was proposed to consist of a detailed analysis of the underlying causes of divergence based on a subset sample. However, this would require a great deal of skilled work.

11. The conclusions so far had been that the PCT was valuable in order for the applicant to decide on national phase entries and to overcome patentability objections early. There was also significant agreement where the written opinion of the ISA (WO/ISA) did not find the main claims to be novel and inventive. However, many new documents were found in the national phase and agreement was low where the WO/ISA did find the claimed invention to be novel and inventive.

12. The Trilateral Offices felt that the study had provided insight into current working of the PCT and identified areas for improvement. It had also enhanced mutual understanding of common and differing practices and developed a basis for ongoing collaboration, including the establishment of metrics-based benchmarks.

13. In the ensuing discussion of the presentation, one Authority noted the equivalence of the case of positive written opinions with the criteria for use of the PCT Patent Prosecution Highway (PPH) and wondered how the findings of the study corresponded with the findings of studies on PPH. The representative of the European Patent Office noted that the figures on reuse, even where the ISA was the same Office as the designated Office, varied significantly between Offices and this affected how likely it was that the first action at the designated Office was going to be positive. The reasons for this were not yet clear, but the work done provided a good basis for further investigation and dialogue.

14. Other Authorities noted that Phase 3 promised the most interesting results. The representative of the European Patent Office indicated that the timing of Phase 3 was not yet known and would depend on the capacity available to the Trilateral Offices. Given the extremely large amount of skilled work which would be required for Phase 3, any study was likely to focus on a few specific areas where major differences had been identified, rather than extending broadly across the whole range of international applications.

(c) PCT-PPH Information Update; PPH Metrics

15. The Meeting noted a presentation by the European Patent Office on the current status, latest developments and future plans with regard to the PPH and PCT-PPH arrangements the EPO has in place with various other Offices, including information on the results of a preliminary analysis carried out in respect of the applications which have been processed under the PPH arrangements to date[1].

16. The EPO currently had three PPH pilots underway: bilateral PPH pilots with the USPTO and JPO and a Trilateral PCT-PPH pilot. The EPO considered the last of these to be the most important as it boosted and offered efficiency for the utilization of PCT work products. The development of PPH at the EPO over the preceding two years (and longer at other Offices) had shown the scheme to help applicants gain faster protection and help Offices with workloads and to increase quality. The EPO had therefore decided to extend for a further two years and revise all of its pilots. The initial take-up had been slow and so it was necessary to improve the system, including the use of the "Mottainai" principles to allow increased eligibility and to permit the self-certification of claims.

17. The "PPH 2.0" proposals from the USPTO sought to build further on the Mottainai principles, to streamline and liberalize the documentation requirements and to establish a common framework to replace the web of bilateral PPH agreements. The trend was harmonization and simplification of requirements. This might lead in the future to an arrangement where participation was simple and based on ticking a "PPH" box in a similar manner to what was currently permitted at the EPO for acceleration of examination under the "PACE" program.

18. Quality was an important issue. The EPO in principle saw the future goal to be to embrace the work of all Offices which perform search and examination. However, the quality of the system was affected by the incoming products. If the quality of such products did not meet the necessary minimum standards, then looking at them was a waste of time.

19. The representative of the European Patent Office noted that take-up of PPH within EPO had been limited and that it was a net exporter of reports to other Offices, rather than being able to benefit significantly itself from the use of other Offices' reports. However, the overall use of PCT-PPH had been significant, reinforcing the importance of the link between the two systems.

20. The EPO had undertaken some preliminary analysis of the results of examination under the PPH scheme by the Office. It was noted that, given the limited number of PPH requests which had been received and processed, the information available was not sufficient to give statistics which could be considered meaningful in a more general context. Requests for PPH at EPO were increasing, but still very low in number. On the other hand, as Office of first filing (OFF), EPO contributed over 30% of the reports for the total worldwide PCT-PPH filings. Within the EPO, PPH was most used in the fields of audio-video-media, civil engineering or industrial chemistry. An interesting statistic was that of the applications which were based on positive PCT or national written opinions, only 7% received a positive opinion in the first action from the EPO. If this were found to be the outcome on a larger scale, it might mean that little direct benefit could be achieved from use of the results. The system did seem to have some filtering effect in that, while only 35% of the PPH applications did not have additional X or Y category documents cited against them, this was greater than the 26% which had been found to be the case for non-PPH accelerated search requests in relation to regional phase entries, weighted to match the PCT-PPH population according to ISA. There was, in practical terms, little difference in pendency for EPO PPH compared to other forms of acceleration: an average of 143 days from PPH request to first action across all PPH requests, 156 days in the case of a regional phase entry for PCT-PPH and 188 days from the date of request for accelerated search for a PACE (non-PPH) request in relation to a regional phase entry with ISA/JP or ISA/US. There was a decrease in the average number of claims in the application, notably in relation to applications received under the USPTO-EPO bilateral PPH; this might be attributed largely to the EPO's claim fees.

21. The EPO had carried out a survey among examiners to gain their feedback on experience of PPH. 44% indicated that they had cited at least some of the prior art or a family member of a citation listed by the Office of first filing (OFF). 23% stated that they found the work of the OFF useful or very useful (38% for PCT-PPH; 19% for bilateral PPH). 13% found the OFF work results made processing efficient or very efficient (24% for PCT-PPH; 10% for bilateral PPH). 56% of users of the Japanese to English machine translation found the results to be at least "usable".

22. The representative of the United States Patent and Trademark Office stated that PPH was seen as a priority with benefits for Office and applicant alike. There had been almost 90,000 PPH requests before USPTO and eventual allowance rates reached around 87% for Paris-route PPH and 91% for PCT-PPH, compared with only around 50% for normal applications. The processing typically involved fewer actions, resulting in cost savings for applicants and Offices, as well as a reduction in the rate of appeals.

23. In relation to a query about the difference between the high rates of eventual grant reported by the USPTO compared to the very high rates of new citations and low rates of positive first written opinions reported by the EPO, the representative of the European Patent Office stressed that its sample size was very low, but agreed that quality was indeed a matter of paramount concern. The representative observed that the PCT had Chapter 21 of the PCT International Search and Preliminary Examination Guidelines to require International Authorities to have some sort of quality process, but there was nothing equivalent in PPH as such.

(d) EPO Manual of Best Practice (Quality Procedures before the EPO)

24. The Meeting noted a presentation by the European Patent Office on what had finally been named the "Handbook of Quality Procedures Before the EPO"[1].

25. The Handbook had been the product of collaboration between the EPO, the Institute of Professional Representatives before the EPO and Business Europe, all of which had endorsed the final product. The quality of the final product which emerges from a process was closely related to the quality and efficiency of the process. Benefits could only be achieved from applying any guidance if it can be used and applied by both the Office and the applicants who use the system. Other Offices had produced codes of practice, but this had been done without the direct involvement and endorsement of the users and consequently there was a limit to the benefit which could be achieved. The Handbook was a complement to the Guidelines for Examination, highlighting the significant steps and decisions in the process and highlighting to both internal and external users what the consequences were of following, or not following, a recommended route. It provided guidance to improve the cooperation between applicants and representatives and examiners and formalities examiners. The Handbook was not intended to limit the choice of strategies available to applicants and did not contain new legal provisions. The Handbook covered the entire range of EPO procedures, including online filing, fees, filing of patent applications at the EPO, communications and replies, oral proceedings, third party observations, limitations and revocation, opposition and complaints.

26. The active collaboration between the three parties had meant a longer process than otherwise, but a more useful result which could be accepted by all. It provided for all parties guidance to improve procedural practice, offering opportunities for reference and training. It might be particularly useful for non-European practitioners who might not be familiar with all the details of European practice. The end result of following the guidance would be that a high quality result should be achieved.

27. The content of the Handbook had been finalized and endorsed by all parties at the end of 2011 and the final document was expected to be published at the end of the month on the EPO website in English, with French and German versions appearing later in the year and printed versions by the end of the year. The EPO would be giving presentations introducing the Handbook to other interested parties during the course of 2012.

(e) Recommendations Endorsed by the Working Group Related to Quality

28. Discussions were based on document PCT/MIA/19/2.

Clarity and Support

29. The Meeting expressed general support for the proposed modifications of the provisions in the International Search and Preliminary Examination Guidelines which gave guidance to Authorities on the inclusion of observations on clarity and support, as set out in Circular C. PCT 1326, taking into account the informal further drafting proposals set out in Annex III, but reserving the right to make further comments later.

30. Several Authorities noted that they believed that their practice was already compliant with the proposed modifications since they already provide comments in relation to any significant issues of clarity and support.

31. Some Authorities emphasized their support for the proposal to withdraw the originally proposed addition to paragraph 17.48 (as shown in Annex III) concerning the inclusion of a positive statement where the claims were considered to satisfy the requirements of clarity and support, rather than merely omitting Box VIII from the report. Some Authorities in particular noted the importance of retaining the possibility of omitting minor issues of clarity from the report where it was considered that there was no value in raising them. Nevertheless, one Authority emphasized the importance of retaining the language "*need* not be included", always retaining the possibility for an Authority to establish an exhaustive report where that was appropriate.

32. One Authority noted that one case where it was not appropriate for an Authority to comment on issues which might be considered relevant to clarity or support was where the issue was one which is unique to the Authority's particular national law and wondered whether there might nevertheless be a way of warning applicants that such issues might occur.

33. One Authority noted that it might be better to avoid references to specific numbering of checkboxes on forms and instead refer to the concepts involved since the Guidelines were not updated as frequently as the forms.

34. The International Bureau informed the Meeting that a further revised version of the proposed modifications, taking into account the responses received in reply to the Circular and the comments made at the Meeting, would be included in the Circular which it intended to issue within the next 2 months to consult on a broader package of modifications to the Guidelines aimed at incorporating all changes agreed since the last substantial update of the Guidelines in 2004. Following this major revision, it was intended that the Guidelines should be revised more frequently, reflecting changes to the Rules or Administrative Instructions (including Forms) as they came into effect.

Scope of Search

35. The Meeting deferred discussion of this section to the specific agenda item in the context of document PCT/MIA/19/5. See paragraphs 65 to 68, below.

Explanations of Cited Documents

36. The Meeting noted the suggestions by Offices with regard to the issue of explanations of cited documents received in response to Circular C. PCT 1295, as set out in document PCT/MIA/19/2. With regard to the issue of a possible revision of WIPO Standard ST.14, see paragraphs 96 to 102, below.

37. Some Authorities stated that they did not see any benefit in seeing a summary by the examiner of the claimed invention.

38. In relation to a query of what was meant by the reference to “degree of compatibility” in paragraph 6 of the document, the International Bureau undertook to seek clarification and to raise the issue again at a later date if required.

Standardized Clauses

39. The Meeting noted with approval the discussions and the way forward agreed by the Quality Subgroup as set out in the Summary by the Chair of its session, reproduced in Annex II.

Access to Written Opinions

40. Several Authorities expressed their general support for the proposal to further consider an amendment of the PCT Regulations aimed at making the written opinion by the International Searching Authority available prior to the present 30 months deadline, stressing the need to consider the relationship with Article 38 and to consult with users to obtain their views on such a change. One Authority stated that it considered the current arrangements to be sufficient, noting that the written opinion of the International Searching Authority was available to the designated Office in cases where the applicant entered the national phase early.

Second Written Opinion by the IPEA

41. Several Authorities stated that, already today, it was their practice to issue a second written opinion where the applicant had attempted to overcome any deficiencies found to exist in the international application by way of argument or amendment but where the Authority still considered the application to be deficient. All of those Authorities expressed the view, however, that such additional opportunity for dialogue should not be made mandatory in all cases but rather remain optional for Authorities so as to give sufficient flexibility, notably to avoid unnecessary repetition and delay in cases where no substantive response is attempted by the applicant.

42. One Authority noted that the period available for Chapter II work was quite short and issuing additional written opinions would result in many additional late reports, which could become a burden for applicants. One Authority noted that they use informal communications in Chapter II to ensure dialogue with the applicant while minimizing the delays associated with written reports. Some Authorities reiterated their opinion that they considered the streamlining of Chapter II procedures to be one of the main achievements of the PCT reform process which should not be undone. One Authority noted that the right to a personal interview which existed at that Office was rarely taken up. With PCT-PPH there had been a further reduction in the use of Chapter II. It was not clear that there was a real applicant need for additional written opinions, which would likely result in fee increases.

Incentives to Encourage High Quality Applications and Early Corrections of Defects

43. The Meeting noted the suggestions by Offices with regard to the issue of incentives to encourage high quality applications and early corrections of defects received in response to Circular C. PCT 1295, as set out in document PCT/MIA/19/2.

44. There was general support for the principle of actions to encourage the filing of international applications of higher quality, with form and content which was easier to process quickly and effectively. However, several Authorities opposed the idea of pre-filing formalities checks, which would be a costly service which would not reduce overall work.

45. There was some interest in the concept of a “defects fee” to give an incentive to check international applications more carefully before filing and to cover the costs of additional processing where defects were found, but several Authorities considered that the costs would be likely to exceed the benefits, or else that they would unduly hit small and medium-sized enterprises and private applicants.

46. Several Authorities indicated that they were opposed to the idea of refunds by the International Authority in cases where a positive written opinion was established since the amount of work involved for the Authority in the international phase was very similar whether the report was positive or negative. One Authority was concerned that offering such refunds might encourage examiners to make spurious arguments to avoid giving a positive report. However, there was support for incentives in the national phase, such as the PPH program, which offered accelerated processing as a benefit to reflect the reduced work which would normally be required by the national Office at that stage.

47. Authorities expressed support for fee differences to encourage the electronic filing of international applications, such as those in the Schedule of Fees under the PCT Regulations and under the America Invents Act.

48. Some Authorities supported the idea of developing better “best practice” guidelines for applicants using the PCT, similar to what had been done for regional processing with the *Handbook of Quality Procedures Before the EPO* (see paragraphs 24 to 27, above).

(f) Further Quality-Related Work

49. The International Bureau welcomed the work which had been begun by the International Authorities, the main points of which had been set out in the summary of the quality subgroup meeting in Annex II, as well as the related work which was under way by those Offices in their individual capacities and other groups, such as the Trilateral and IP5 cooperation. However, the importance of the quality work was such that International Authorities needed to overcome any reservations which they might have about talking about both quality systems and the quality of the resulting work. Metrics were needed to provide a self-reinforcing system of improvement. While this could not be done overnight, it was also not sufficient to wait for the results of the study of each small step before putting issues on the table and taking action to develop further and more meaningful metrics.

50. The International Authorities agreed that this work was important and needed to go ahead, but it was necessary to realize that even the work equivalent to “Phase 1” of the Trilateral study referred to in paragraph 10, above, involved a substantial investment in skilled time. This needed to be done consistently to be useful and it was unlikely that the European Patent Office would have the capacity to provide the analysis for all of the International Authorities in a single year.

51. Several International Authorities stated the importance of moving quickly towards not just the “Phase 1” study of the nature of citations in international search report, but of assessing their usefulness. A simple example of this might be determining the proportion of international applications where the international search report contained only “A” category citations but “X” or “Y” category documents were cited in the national phase. Another International Authority pointed out that this represented only a small part of the question which “Phase 2” sought to address and to do this properly would involve an extremely large amount of work. The International Bureau suggested that it might be worth conducting a small scale project in this area which might be of very limited statistical significance but which would help to determine the data which would need to be collected and the matters which would need to be researched to ensure that it would be possible to conduct a meaningful analysis in the future. Several International Authorities agreed, noting that it was very unlikely that they would have the resources to go back through their files to analyze old data, but that it may be possible to set up systems to collect data as the examination process was in progress to make analysis easier and more meaningful in the future. Some limited detailed analysis of past data might be useful, but most Offices would need to limit analysis of old files to what could be achieved with the data already available.

52. The Meeting agreed:

(a) as recommended by the Quality Subgroup, to proceed with the study proposed by the European Patent Office on a set of characteristics of international search reports established by International Authorities, noting that the resources available to the European Patent Office in 2012 would allow that Office to carry out that study only in respect of search report data from a maximum of two Authorities (in addition to the Authorities belonging to the IP5 group of Offices, which were already the subject of an equivalent ongoing study); the Meeting invited Authorities interested in participating in this study in 2012 and beyond to notify the European Patent Office accordingly;

(b) to request the Quality Subgroup to develop the concept of a pilot project under which Offices willing to participate would analyze the usefulness for the national phase of international search reports, based on a set of quality metrics to be developed by the Subgroup; one possibility might be to identify international search reports containing only “A” citations, where the case entered the national phase without any amendments to the claims and where the national search report contained “X” and/or “Y” citations.

ITEM 5: FUTURE DEVELOPMENT OF THE PCT

(a) Recommendations Endorsed by the Working Group Relating to the Setting Up of a Third Party Observations System and of a Quality Feedback System

53. Discussions were based on document PCT/MIA/19/3.

54. Several International Authorities reiterated their support for the third party observation system. One Authority noted that there was a strong legitimate interest in being able to make anonymous observations and that this had not caused any difficulty for its own third party observation system.

55. The Meeting noted with approval that the third party observation system was expected to begin operation on July 1, 2012.

56. One International Authority noted that greater information on the effectiveness of international search reports for national phase processing would be valuable for “Phase 2” metrics referred to in paragraphs 10 and 51, above and restated its support for the quality feedback system as long as its use was not mandatory for examiners. Some Authorities restated their position that it might not be considered appropriate for their own examiners to send feedback to other Offices. Another International Authority had concerns about the possibility of problems if feedback was received after a patent had already been granted by the Office which acted as International Searching Authority and also observed that, while it was not intended that feedback should be made public, it might be difficult to refuse to give access if requested. That Authority wondered whether the desired objective might be more effectively achieved using arrangements based on the Common Citation Document.

57. In response to a query from an International Authority, the International Bureau confirmed that the proposed e-mails to the International Authority transmitting quality feedback would identify the designated Office from which the feedback had been sent.

58. Despite the concerns, the Meeting noted that the quality feedback system would be able to commence operation within a timescale similar to that of the third party observation system.

(b) Collaborative Search and Examination Pilot Project – Intermediate Report of Pilot Phase 2

59. Discussions were based on document PCT/MIA/19/4.

60. The Meeting noted an intermediate report by the European Patent Office on phase 2 of the Collaborative Search and Examination Pilot Project carried out jointly by the European Patent Office, the Korean Intellectual Property Office and the United States Patent and Trademark Office.

61. The first phase had been reported in the previous session of the Meeting (see document PCT/MIA/18/7). The purpose of that phase had been to test the feasibility of the collaborative approach and to gain a qualitative feel for the advantages which might be found. The second pilot was on a larger scale and sought to make a quantitative assessment of the costs and benefits. Eight examiners from each Office were each responsible for eight applications and collaborated in the examination of a further sixteen. This would result in 192 files being processed in total during the pilot.

62. A number of lessons had already been learned concerning operational constraints and differences in practice. EPO examiners had greatly appreciated the feedback received from the partner examiners. In most cases this had resulted in the addition of further citations to the international search report and in two thirds of cases even amendments to the written opinions. In most cases, the examiners had spent more time on these cases than they would have done on a normal one. The substantive conclusions had yet to be analyzed. Questionnaires had been sent to the applicants involved, but the responses had yet to be received and assessed.

63. The representative of the United States Patent and Trademark Office stated that the USPTO considered that this pilot was an example of true worksharing, with duties shared through the entire process. The Office was very optimistic at the prospect for quality improvements. At the end of the first phase it had been concluded that virtually no national phase search work was needed on the international applications which had been through the process. As stated in the working document, the price of the work conducted appeared to be 2 to 3 times the cost of a normal search but it was hoped that this could be reduced in a production-scale environment. Contributing examiners took less time on their collaboration than

they would on a search that they conducted for themselves but ended up with a product which they felt able to use.

64. Another International Authority noted that this approach had some similarities with internal arrangements where a group of examiners from one Office came together to formulate a search strategy. This was a matter which had been raised in the quality subgroup and should be considered further.

(c) Search Strategy Information in the PCT

65. Discussions were based on document PCT/MIA/19/5.

66. Several International Authorities stated their intention to make their search strategies available to the International Bureau as soon as possible. Another Authority stated that the strategies which it recorded were in a form designed only to assist internal processes. While it was in discussion with other Authorities on appropriate manners and means for sharing search strategies, it did not yet consider it appropriate to do so.

67. Recalling discussions in the quality subgroup, the International Bureau stated that International Authorities would be welcome to provide any information which they considered appropriate to help others understand the contents of their search strategies and the International Bureau would make such information available in association with PATENTSCOPE when the search strategies started to be published.

> 68. The Meeting agreed that those Authorities which were willing should begin to provide their search strategies to the International Bureau in whatever form they might be available and that the International Bureau should make them available on PATENTSCOPE. The International Bureau should also publish any explanation provided by International Authorities of the contents of their search strategy and how best to understand and use it.

(d) Any Other Issues

69. The representative of the European Patent Office stated that the EPO would, once sufficient experience had been gained, provide a report on its recently introduced procedure to require applicants entering the regional phase to address any outstanding issues in the international preliminary report on patentability.

ITEM 6: REVIEW OF SUPPLEMENTARY INTERNATIONAL SEARCH

70. Discussions were based on document PCT/MIA/19/6.

71. The International Bureau gave a preliminary report on the responses by Authorities, Offices and users of the supplementary international search system received in reply to Circular C. PCT 1329. Up to that point, responses had been received from around 20 Offices, 1 user group and 3 applicants who had used the system. Reasons for filing requests for supplementary international search included interest in Russian documentation, interest in search of subject matter which had not been searched under Rule 39 by the main International Searching Authority and one case where a supplementary international search had been sought as an alternative to paying supplementary fees to the main International Searching Authority following a finding of lack of unity of invention. User experiences had generally been good. Most reports had been received on time, though there were no specific comments from users on the quality of the reports. All of the reports so far had been established in English. The Offices offering the service stated that they always took the main international search into account when it was available, but it was too late in a regrettably large proportion of cases.

72. Reasons given by the relevant International Searching Authorities for not offering the service included workload problems and concerns that it would involve duplication of work and distracted from the focus of attention on improving the main international search. The Korean Intellectual Property Office (subject to workload issues) and the State Intellectual Property Office of the People's Republic of China had indicated that they were considering offering the service in the future, as well as the Egypt Patent Office once it had started acting as an International Authority.

73. Very few international applications with supplementary international search reports had yet begun processing in the national phase. However, 2 Offices offered limited feedback; one found that the supplementary search report had cited useful documents not found in the main international search report, whereas the other Office had found the supplementary search report essentially to be a duplicate of the main report.

74. Reasons given for low uptake included high cost, lack of national phase recognition of the additional work, the limited range of additional language skills on offer through the service (Asian and Portuguese language documentation searches were particularly sought), insufficient awareness, the sufficiency of the main international search and the lateness of the main international search. Suggestions for changes were essentially the counter to these points, together with interest in covering areas such as software and business method applications which may not be searched by the International Authorities normally available to some applicants. Collaborative search was also a possible alternative development.

75. The responses to the Circular had also included comments hoping for the extension of the Patent Prosecution Highway to a wider range of Offices and for improvements to the timeliness of Chapter II reports for those international applications which used the latter service.

76. The representative of the Federal Service for Intellectual Property of the Russian Federation (Rospatent) noted that it was the largest provider of supplementary international searches and felt that the service was very useful for applicants to get prior art in specific languages or specific technology areas. This could often provide advantages on national phase entry. Rospatent offered searches primarily on Russian and former Soviet Union documentation as well as the possibility of full searches including the PCT minimum documentation in cases where the main International Searching Authority had made a declaration that no international search report would be established because of certain subject matter. The supplementary international searches had been on international applications from a range of countries and some major companies. The largest number by country of origin came from Spain and by International Searching Authority from the European Patent Office. The searches had uncovered a number of additional X category documents. For the future of the service, Rospatent suggested that accelerated national phase procedures should be available for international applications having used the service, that fee reductions should be available in the national phase and that the timing of the deadline for request should be adjusted to ensure that it was always possible to receive the international search report before deciding whether or not to request supplementary international search.

77. Some International Authorities emphasized the importance of reviewing the supplementary international search system, both from the point of view of its low use and from the fact that many participating Authorities offered full searches, rather than true supplementary searches, which implied automatic duplication of work and an assumption that the original international search was not of a sufficiently high quality.

78. Issues which one or more International Authorities indicated as appropriate to consider included:

(a) the cost of a supplementary international search;

(b) the scope of an international search: finding appropriate sets of documentation which an International Authority can usefully search to extend what can be expected to have been searched by the main International Searching Authority;

(c) the language specializations of participating Offices;

(d) the timing of the deadline for requesting searches in relation to main international searches which may be delivered late;

(e) incentives in the national phase for seeking improved searches in the international phase;

(f) more flexible handling of unity of invention; and

(g) awareness of the system – advertising might include issuing standard flyers with forms such as PCT/ISA/220.

ITEM 7: PCT MINIMUM DOCUMENTATION – DEFINITION AND EXTENT OF PATENT LITERATURE

79. Discussions were based on documents PCT/MIA/19/7 and 7 Add.

80. All International Authorities which took the floor supported the general principle behind the proposal to encourage PCT Contracting States to make their patent documentation readily available in a common electronic format which would be easy to load into search databases, and to add this documentation to the PCT minimum documentation. It was suggested that this would improve the quality of the search and also the confidence of those Contracting States in the system. However, the specific details would need careful consideration. Some of the main concerns included the following.

(a) This work needed to be carefully coordinated with the IP5 common documentation task.

(b) The “authority file” needed to be as simple as possible.

(c) The period within which International Authorities would be expected to have new documentation included in their search systems needed careful review.

(d) It would be important to ensure that the documentation formats and related information were suitable for private sector search database suppliers (which were used by many International Authorities) as well as for the International Authorities themselves.

(e) Defining character sets may be an issue.

(f) Utility models would be a particularly important part of the project.

(g) Careful consideration would be needed of what information was desirable and what was essential for a national collection to be included in the minimum documentation.

(h) Reliable arrangements were required to ensure the availability and updating of IPC codes for all documents.

(i) Careful consideration was needed to how many deliveries of documentation updates and over what period would be required before it could be assumed that a national Office’s systems for delivering new documentation were reliable.

(j) It may be desirable to seek approval by the PCT Assembly for new documentation collections, or at least to provide a formal notification to the Assembly.

(k) Standardization of the appropriate format of publication numbers for use in databases would be highly desirable.

(l) Careful consideration was required of how to deal with both corrected publications and corrected information concerning publications.

81. The Meeting agreed that the International Bureau should issue a Circular inviting International Authorities to nominate representatives for a task force to consider the technical issues set out in the document. Further consideration might also be required for other matters, such as effective classification of the documentation concerned.

ITEM 8: PCT SEQUENCE LISTING STANDARD

82. Discussions were based on documents PCT/MIA/19/8 and 8 Add.

83. The Meeting noted a progress report by the European Patent Office (in its role as the leader of the corresponding Task Force of WIPO's Committee on WIPO Standards (CWS)) on the development of a WIPO standard for the presentation of sequence listings in XML format. Considerable progress had been made and a final proposal was expected to be posted shortly. The proposed new XML standard had a number of differences from ST.25, structurally in the arrangement of procedural and definition of listings, and substantively in the contents of the biotechnological aspects. It would be possible to represent structures which were not possible in ST.25 and it offered the benefit of alignment with the XML standards used in relation to industry databases.

84. Most International Authorities which took the floor expressed support for the new standard since it offered the opportunity to improve searching facilities and to handle types of sequence listing which were not currently possible. However, opinions differed on the most appropriate way of bringing the standard into use for the PCT.

85. Some Authorities wished to bring it into use as quickly as possible in any particular receiving Office in order to be able to benefit from its improved features quickly, noting that the BISSAP software developed by the EPO allowed users to select either output format and to convert between the two.

86. Others were concerned that a "clean" transition was needed in order to ensure reliable processing. One of the benefits of ST.25 was that it was a common standard accepted across all receiving Offices, International Authorities and designated Offices. It was not clear whether conversion would indeed be possible in all cases between ST.25 and the new XML standard. On the face of it, the new features in the XML standard would mean that this would not be possible for at least some sequences. Furthermore, one International Authority was concerned that differences in the bibliographic data embedded within files according to the two standards might make it difficult for applicants having filed in one format to produce a listing in the other format for the purpose of a national phase which did not accept the original since it might involve adding information which was not included in either the original sequence listing or the main part of the description. Careful study was needed. Ideally, a good range of example listings should be provided for testing and to ensure that the issues were properly understood, covering especially sequences which included features new to the XML standard.

87. The Meeting agreed that:

(a) it would be preferable if the CWS Task Force, before concluding its work on the development of the new XML standard, would also look into the issue of whether it will be possible for any tool to be developed which would allow for the easy and complete conversion of sequence listings filed in one format (ST.25 or XML) into the other;

(b) based on the conclusions reached by the Task Force on the issue of the feasibility of developing a conversion tool, the appropriate PCT bodies should commence a discussion on the most appropriate mechanism for transition from ST.25 to the new XML standard.

ITEM 9: COLOR DRAWINGS IN INTERNATIONAL APPLICATIONS

88. Discussions were based on document PCT/MIA/19/9.

89. The International Authorities which took the floor all confirmed their view that in principle it was important to allow the use of color drawings in international applications. This would make drafting the application easier in some cases for applicants and assist understanding of the invention by examiners and third parties. However, only one International Authority (the Korean Intellectual Property Office) was currently fully able to handle color drawings. Some other International Authorities had projects under way to allow their use, but expected it to be some years before all the technical and legal issues had been addressed. Several International Authorities were able to receive color drawings in an initial filing, which was technically relatively cheap and simple, but required black and white replacement drawings before any further processing could take place, a process that could result in an additional burden to applicants. One International Authority believed that it could overcome the technical barriers relatively easily but that legal changes would be difficult.

90. In introducing a system, it would be necessary to give good notice of an intended start date in order to permit International Authorities to schedule their legal and technical work properly. Furthermore, careful planning would be needed to take account of the fact that there would inevitably be designated Offices which would continue to require black and white documents. Conversion to black and white would typically require the preparation of completely new documents since automatic conversions would frequently be inadequate.

91. The Meeting:

(a) noted a summary of responses to Circular C. PCT 1317 which had been received by the International Bureau;

(b) affirmed the importance of work to allow the use of color drawings in the PCT system, while recognizing the time, cost and legal issues which would be involved; and

(c) noted that a proposal would need to balance the convenience to applicants of a system where color drawings could be used in all Offices during both the international and national phases against the time which would be involved in overcoming all of the legal and technical barriers to achieve this.

ITEM 10: PCT ONLINE SERVICES (ePCT)

92. Discussions were based on document PCT/MIA/19/10 and a demonstration of the current ePCT applicant portal by the International Bureau.

93. The Meeting welcomed the information on the current state of work and recognized the importance of such developments to communications with and between Offices as well as between the applicant and International Bureau. The International Bureau invited International Authorities to engage in an ongoing discussion with the International Bureau to determine ways to make the overall system more effective for applicants and Offices alike. For International Authorities, the International Bureau was particularly interested in the machine interfaces and data which should be communicated to make the most effective use of each others' local systems.

94. The representative of the Korean Intellectual Property Office (KIPO) recalled that KIPO had been involved in the development and distribution of the PCT-ROAD receiving Office software since 2005 and hoped that this could be used with ePCT.

95. Some International Authorities expressed their hope to work closely with the International Bureau in developing their IT systems so as to reduce development costs and to improve the functionality of the system for both Offices and applicants by improving the sharing of information between the systems of Offices having a role in international phase processing.

ITEM 11: REVISION OF WIPO STANDARD ST.14

96. Discussions were based on document PCT/MIA/19/11.

97. Most International Authorities considered that it would be useful to review WIPO Standard ST.14 to ensure that it met the needs of today's patent system, though there were differences of opinion in exactly what was needed.

98. Most International Authorities supported the principle of distinguishing between documents currently cited as category "X" for novelty and those cited for inventive step, considering it a useful distinction, particularly in the light of development of systems such as the Common Citation Document, though the particular letter "I" might not be appropriate since in some fonts it could be mistaken for "L". However, some International Authorities were concerned that the use of category "X" was well established and either usage implied that the document might constitute a reason for refusal of the relevant claim, or else that distinguishing might be an unnecessary burden on the examiner. One International Authority suggested that it would also be useful to consider the grouping of "Y" category documents to ensure that it was clear how they were supposed to be used together.

99. There was some support for the clarification of the use of "O", "E" and "P", though one Authority was doubtful that it was necessary, provided that they met the need of indicating that careful assessment was required in the national phase in accordance with the particulars of the relevant national law. One Authority suggested that, rather than extending the use of "E" or introducing a new category for documents of the same date, it may be desirable to use the code "L" and give the reason for the citation according to the definition of that term.

100. There was some desire to ensure that the standards for citation of non-patent literature were appropriate, but concern to ensure that the system should not be directly bound by ISO 690:2010, which had not been developed specifically for the needs of search reports and other patent system needs.

101. One International Authority suggested that the International Bureau would be a suitable task force leader. The International Bureau responded that this was a matter for the Committee on WIPO Standards, but that the International Bureau would prefer not to take on this task if the mandate of the task force extended beyond the definitions of citation categories and also included the standards for citation of non-patent literature since it lacked the expertise gained through day to day engagement with this complex subject.

102. While some International Authorities expressed certain reservations, the Meeting recommended that the International Bureau should propose the creation of a task force under the Committee on WIPO Standards to consider revision of WIPO Standard ST.14. The draft mandate of such a task force should extend to all matters within the scope of ST.14, including the definition of citation categories and the recommended presentation of non-patent literature.

ITEM 12: FUTURE WORK

103. The Meeting noted that the next session was expected to be convened in February or March 2013, probably immediately following a meeting of the Quality Subgroup. In the absence of alternative proposals from an International Authority, the meeting would be held in Geneva.

ITEM 13: SUMMARY BY THE CHAIR

104. The Meeting noted the Summary by the Chair (document PCT/MIA/19/13).

ITEM 14: CLOSING OF THE SESSION

105. The Meeting closed February 9, 2012.

106. The Meeting adopted this report by correspondence.

[Annex follows]

[1] The presentations are available on WIPO's website at http://www.wipo.int/meetings/en/details.jsp?meeting_code=pct/mia/19

ANNEX I

LIST OF PARTICIPANTS

I. INTERNATIONAL AUTHORITIES

(in the English alphabetical order of their names)

AUSTRIAN PATENT OFFICE

Katharina FASTENBAUER (Mrs.), Head, Patent Support and PCT Department

BRAZILIAN NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY

Luiz Otávio BEAKLINI, Coordinator for Total Quality Procedures

Leonardo GOMES DE SOUZA, PCT Expert, Directorate of Patents

CANADIAN INTELLECTUAL PROPERTY OFFICE

Kathleen MURPHY (Ms.), Program Manager, International

EGYPTIAN PATENT OFFICE, ACADEMY OF SCIENTIFIC RESEARCH AND TECHNOLOGY

Rasha Hamdy Abdel Hamid ABDEL MAGID (Mrs.), Technical Examiner

EUROPEAN PATENT OFFICE

Milena LONATI (Ms.), Principal Director Quality Management / Head of delegation

Eugen STOHR, Director, International Legal Affairs – PCT

Mark WEAVER, Director, Directorate 2.0.21, Practice and Procedure

Camille BOGLIOLO, Lawyer, International Legal Affairs – PCT

FEDERAL SERVICE FOR INTELLECTUAL PROPERTY OF THE RUSSIAN FEDERATION (ROSPATENT)

Andrey ZHURAVLEV, Deputy Director, Federal Institute of Industrial Property

Gennady NEGULYAEV, Senior Researcher, Federal Institute of Industrial Property

IP AUSTRALIA

Fatima BEATTIE (Ms.), Deputy Director General

Greg POWELL, Supervising Examiner

Julie GALE (Ms.), Acting IP Rights Quality Review Manager, Quality Improvement Section

Tharu FERNANDO (Ms.), Senior Examiner of patents

Julia HU (Ms.), International ICT Cooperation

Andrew WILKINSON, International Policy & Cooperation

ISRAEL PATENT OFFICE, MINISTRY OF JUSTICE

Michael BART, Head, PCT Division

JAPAN PATENT OFFICE

Nari NAKASHIMA, Director, Quality Management Office, Administrative Affairs Division, First Patent Examination Department

Kotaro HISAJIMA, Deputy Director, Quality Management Office, Administrative Affairs Division, First Patent Examination Department

Tatsuya TADA, Deputy Director, Examination Standards Office, Administrative Affairs Division, First Patent Examination Department

KOREAN INTELLECTUAL PROPERTY OFFICE

JO, Jae Shin, Director, Patent Examination Cooperation Division, Electric & Electronic Exam Bureau

KIM, Jongkyoo, Deputy Director, Patent Examination Cooperation Division, Electric & Electronic Exam Bureau

YEO, Un Yong, Assistant Director, International Application Division, International Cooperation & Customer Support Bureau

NATIONAL BOARD OF PATENTS AND REGISTRATION OF FINLAND

Juha REKOLA, Development Director

Riitta LARJA (Ms.), Deputy Head of Division

NORDIC PATENT INSTITUTE

Grétar Ingi GRETARSSON, Vice-Director, Nordic Patent Institute

SPANISH PATENT AND TRADEMARK OFFICE

Javier VERA ROA, Director, Patents and Technological Information Department

Isabel SERIÑÁ RAMÍREZ (Ms.), Advisor, Patents and Technological Information Department

STATE INTELLECTUAL PROPERTY OFFICE OF THE PEOPLE'S REPUBLIC OF CHINA

LI, Bo (Ms.), International Communication Division, Patent Examination Administration Department

SWEDISH PATENT AND REGISTRATION OFFICE

Måns MARKLUND, Quality Manager, Patent Department

UNITED STATES PATENT AND TRADEMARK OFFICE

Minna MOEZIE (Ms.), Attorney-Advisor, Office of Policy and External Affairs

Charles PEARSON, Director, Office of PCT Legal Administration

Michael NEAS, Supervisor, Office of PCT Legal Administration

II. OFFICERS

Chair: Fatima BEATTIE (Ms.) (IP Australia)

Secretary: Michael RICHARDSON (WIPO)

III. SECRETARIAT OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

James POOLEY, Deputy Director General, Innovation and Technology Sector

Claus MATTHES, Director, PCT Business Development Division

Michael RICHARDSON, Deputy Director, PCT Business Development Division

[Annex II follows]

ANNEX II

PCT QUALITY SUBGROUP
SECOND INFORMAL SESSION
CANBERRA, FEBRUARY 6 AND 7, 2012

SUMMARY BY THE CHAIR

(reproduced from document PCT/MIA/19/13)

1. REPORTS ON QUALITY MANAGEMENT SYSTEMS UNDER CHAPTER 21 OF THE PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

(a) Reports by International Authorities

1. One Authority noted that one issue of interest raised by the reports was the question of who the person or unit responsible for quality should report to; should this be the head of the Office or was it acceptable to report to the person operationally responsible for international search and preliminary examination? Authorities agreed that the appropriate structure depended on the extent of the quality management system and that reporting should be to the most senior person at least in the area to which the quality management system applied. In the case of a common system for an entire Office, this should be the President; in the case of a system specific to international search and preliminary examination this might be, for example, the Vice-President responsible for search and examination operations (though reporting to the President was acceptable or even desirable in this case as well).

2. One Authority wondered about the extent to which other Authorities were able to use a common quality management system for both international and national work products. Authorities agreed that, in most cases, the needs were found to be very similar. While the products differed slightly, particularly in format, the main differences in quality management were typically found to relate to how strictly timing of work needed to be assessed.

3. In response to a query by one Authority, Authorities noted that keeping quality related instructions up to date was a resource-intensive activity and that it was important to ensure that this was a top priority for a sufficient group of staff. Most Authorities had a selection of resources available, typically accessed using an Intranet. Responsibility for keeping these up to date might lie with either a particular unit or else a cross-cutting committee. It was observed that formal manuals frequently took time to update and in this case were often supplemented by interim instructions pending the publication of a new version, for example on an annual basis.

4. The Subgroup agreed to continue review of the reports and, to assist this process and provide additional information for the Member States, to compile an aggregate report covering matters of interest from all of the individual reports, including areas where practice was particularly close or particularly different between Authorities as well as any issues of special relevance noted. This would build on work already begun on the Subgroup's electronic forum, with different Authorities taking the lead for each section of the reports. The lead Offices should complete their first drafts by mid-May for comment by other Offices, to allow the work to be completed by the end of June, ready for publication of a document to be submitted to the PCT Assembly at the end of July.

(b) Proposals for Modifications to Chapter 21

5. In relation to a proposal by a designated Office to include, in paragraph 21.06, a requirement for assessing IT infrastructure, the International Bureau agreed to seek more detail on what requirements the infrastructure would be required to meet.

(c) Proposals for Modifications to the Reporting Template

6. The Subgroup recommended that, instead of submitting full reports every five years and cumulative updates in the intervening years, Authorities should submit each report in the form of a full report, making the differences from the previous year's report clear, for example using "track changes" or other form of highlighting. The supplementary template would therefore no longer be required.

2. BETTER UNDERSTANDING OF THE WORK OF OTHER OFFICES

(a) Trilateral/IP5 Catalogue of Differing Practices - Update

7. The European Patent Office introduced the Catalogue of Differing Practices, which was the result of work carried out in the context of the cooperation between first the Trilateral Offices and subsequently extended to the IP5 Offices and which had now been published on the IP5 website. The Catalogue was intended to form a springboard for further work, both in helping examiners to understand work from other Offices and in identifying areas where convergence of practices was feasible. However, one of the main findings was that the terminology used by different Offices was inconsistent: the same term could often be understood in different ways by different people.

8. An expert study was now under way in one limited field (definition of prior art) to establish whether it was practical to condense the findings into something which was clear and useful. It was possible that this might form the basis of a glossary. A report on the feasibility of such an approach was expected by the end of 2012.

(b) Search Strategies

9. Authorities agreed that work in this field could be divided into several areas. There was continued support from several Authorities for making available search strategies or search listings in whatever form they were currently recorded in their systems. However, this was considered by some Authorities to be a matter of assisting utilization of work rather than a quality issue as such. Authorities could simply go ahead with this if they wished to do so. Noting that search strategies would differ between Authorities and might not be self-explanatory, the International Bureau agreed, where an Authority wished to do so, to publish them on PATENTSCOPE together with any general explanation which an Authority wished to provide of how to understand and make best use of its search strategy documents.

10. In relation to the utility of search strategies for assessing quality, whether as a purely internal matter or between Authorities, Authorities agreed that a greater degree of understanding was required and that a greater degree of consistency was at least desirable. It needed to be clear who the search strategies were aimed at and what they were to be used for. Facilities for recording strategies or search listings varied considerably between different search systems and approaches needed to be found which worked in relation to all searching systems used and allowed the contents to be used readily. It was agreed that the target audience would always be someone with the skills of an examiner, whether that was in fact an examiner in a designated Office or a quality unit within the International Authority. Exactly what was required would still depend on what use was intended.

11. The Subgroup agreed to consider matters further on the electronic forum beginning with:

(a) Willing Authorities would post examples of search strategies or search listings to assist in identifying best practices to assist internal development within Offices, scope for effective use by different interested parties and possible recommendations for developing more consistent approaches between Offices;

(b) Authorities would seek to find a common understanding of terminology, including items such as “search statement”, “search strategy” and “search listing”.

(c) Use of Standardized Clauses

12. Authorities noted that standardized clauses had a number of separate roles, including helping end users to quickly understand the issue being raised through consistency in use, as well as guiding examiners to cover all required issues to an appropriate level of detail. Use of clauses should never be compulsory, but there was significant interest in seeking to develop a set of model clauses, which could assist discussions of quality and consistency and be adopted by Authorities and used by examiners to the extent considered appropriate.

13. The Subgroup agreed to begin a pilot, seeking to develop model clauses in a limited area to be selected by the pilot group. The discussions would seek to identify general principles which would be useful in developing further clauses which were appropriate to making reports which would be useful to readers, assumed to be skilled examiners or patent attorneys. The pilot would be led by the Canadian Intellectual Property Office and assisted by the National Board of Patents and Registrations of Finland, the Spanish Patent and Trademark Office and the United States Patent and Trademark Office, as well as the International Bureau. The work would be conducted using the electronic forum so that other Authorities could follow the progress and comment.

(d) Other ideas

14. The Subgroup agreed to add a “brainstorming” area to the electronic forum, where Authorities could post any ideas for quality improvement, even if they were not clearly immediately practical. It was observed that much could be learned from considering and even trying out radically different approaches and sharing even “wild” ideas could lead to further, practical progress.

15. There was some discussion of how quality could be monitored and maintained in outsourcing arrangements. One Office observed that outsourcing could be highly effective if properly monitored and appropriate action taken if quality standards were not acceptable. Contract conditions could often be changed, if necessary, faster than changing practices within an Office. It was essential to provide a high degree of scrutiny in the early stages of outsourcing; this could be reduced at later stages, but needed to be kept at an appropriate level and acted on promptly. Another Office observed that outsourcing could be extremely valuable in cases of sudden unexpected influxes of work, especially if the work was conducted by another examining Office which clearly had all the necessary skills.

3. QUALITY IMPROVEMENT MEASURES

16. Discussions were based on a proposal by the Swedish Patent and Registration Office to further study an earlier suggestion made by IP Australia to modify Chapter 21 of the PCT Search and Examination Guidelines and the reporting templates there under to require Authorities to report in their annual quality reports on a number of quality indicators for international work products.

17. The Subgroup agreed that the International Bureau should invite Authorities, by way of a Circular, to reply to the Questionnaire proposed by the Swedish Patent and Registration Office, subject to minor modifications (responses to item (b) of each of the questions should not only indicate “yes/no” but should give further details as to what kind of checklist was used by the Authority; responses to item (d) of each of the questions should indicate what kind of quality metrics were used by the Authority) and further clarification as to what was meant by “written

formalities" in question 5 (all formal, non-substantive issues to be dealt with in the context of establishing a report or written opinion). One Authority stressed the importance of not only addressing the issue of final product quality but also of process quality, that is, the efficiency of the process of obtaining a high quality final product. The Secretariat indicated that it would aim at sending the Circular within 4 weeks following the meeting, with a time limit of 6 weeks for Authorities to respond to the Questionnaire.

4. QUALITY METRICS

18. Discussions were based on a proposal by the European Patent Office to carry out a study on a set of characteristics of international search reports established by all International Authorities (PCT search results; intermediate prior art cited in ISRs; patent and non-patent literature citations in ISRs; and official and non-official language citations), with the aim of developing indicators of what should be the focus of the work of the International Authorities in the near future when seeking to improve the quality of the international work products. The study would be carried out by the EPO in the analysis environment which it had developed for a similar study carried out in the context of the Trilateral Office cooperation and would use search report data publicly available in the EPO's PATSTAT database.

19. The Subgroup agreed to proceed with the study as proposed by the European Patent Office and to share the results through the electronic forum. It was noted that the proposed metrics would enhance mutual understanding of common and different practices. In addition, changes in the metrics if repeated over a number of years might also provide significant pointers for quality units. A more direct measure of quality, such as re-usability by Offices in the national phase, would require significant manual work by examiners to assess results. While this work was not practical at present, direct quality metrics remained the goal of the Subgroup.

5. FURTHER WORK

20. The Subgroup recommended that its work should continue, but considered that it was necessary to seek improved working arrangements. Each task on the electronic forum should have a clear leader posting an initial working document and Authorities should be given a clear deadline for response to questions. The International Bureau would assist in making these arrangements, including posting e-mails to the main PCT/MIA mailing list and, where appropriate, sending Circulars to emphasize particularly important arrangements.

21. The Subgroup recommended that further physical meetings should be held, but that the Meeting of International Authorities should recommend the timing following its experience in the 19th session, which was to be held immediately after the Subgroup meeting. Ideally, Subgroup meetings would be held separately from the Meeting of International Authorities, encouraging the participation of quality experts and allowing follow-up activities to be conducted in advance of the Meeting. However, this would be significantly more expensive than holding the two meetings back to back and it was not clear whether the benefits would be sufficient to warrant the additional expense.

[Annex III follows]

ANNEX III

PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES:
REVISED PROPOSED MODIFICATIONS
(see paragraph 29 of the main body of this document)

[Text with in blue with underline and strikeout ("underline and strikeout") shows deletions proposed from the draft modifications set out in Circular C. PCT 1326]

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 may 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, 4th and 5th 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).

[End of Annex III and of document]