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Le Bureau international de l'Organisation Mondiale de la Propriété Intellectuelle (OMPI) présente ses compliments et a l'honneur de transmettre ./ ci-joint le rapport (document PCT/MIA/10/11) de la dixième session de la Réunion des administrations internationales instituées en vertu du PCT, qui s'est tenue à Genève du 13 au 15 septembre 2004.

Comme la langue de travail de la session était l'anglais, le rapport est disponible seulement en anglais.

Le rapport et les documents de travail sont disponibles sur le site Internet de l'OMPI (voir <http://www.wipo.int/pct/en/meetings>).

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

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

**Tenth Session
Geneva, September 13 to 15, 2004**

REPORT

adopted by the Meeting

INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its tenth session in Geneva from September 13 to 15, 2004.
2. The following International Searching and Preliminary Examining Authorities were represented at the session: the Austrian Patent Office, the Canadian Intellectual Property Office, the European Patent Office, IP Australia, the Japan Patent Office, the Korean Intellectual Property Office, the National Board of Patents and Registration of Finland, the Spanish Patent and Trademark Office, the State Intellectual Property Office of the People’s Republic of China, the Swedish Patent and Registration Office, and the United States Patent and Trademark Office.
3. The list of participants is contained in Annex I to this document.

OPENING OF THE SESSION

4. Mr. Francis Gurry, Deputy Director General, on behalf of the Director General, opened the session and welcomed the participants. He greeted especially the representatives of the National Board of Patents and Registration of Finland, which was represented for the first time in the Meeting, and of the Canadian Intellectual Property Office, for which this was the

first session of the Meeting since that Office commenced functioning as an International Authority on July 26, 2004.

ELECTION OF A CHAIR

5. The meeting unanimously elected Mr. Francis Gurry as Chair.

ADOPTION OF THE AGENDA

6. The Meeting adopted for its agenda the draft contained in document PCT/MIA/10/1 Rev., subject to the replacement of the sub-headings of item 6 with the following:

“(a) General exchange of experience

“(b) Investigation of validity of priority

“(c) Presenting reasoning when no (or limited) international search can be performed

“(d) Reissue of search reports and written opinions

“(e) Transmittal of ISR and WO/ISA

“(f) Further review of the PCT International Search and Preliminary Examination Guidelines.”

CONTENTS OF THIS REPORT

7. The Meeting agreed that this report would contain the principal conclusions reached at the session rather than a record of the discussion in its entirety.

UNITY OF INVENTION

8. Discussions were based on documents PCT/MIA/10/2 and 2 Add.1.

9. The Meeting approved the proposed modifications of Annex B of the Administrative Instructions and noted that the International Bureau would send a circular consulting other interested parties with a view to promulgation of the modifications as soon as possible.

ENHANCED INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION SYSTEM

10. Discussions were based on documents PCT/MIA/10/6 and 6 Add.1.

General Exchange of Experience

11. The Meeting noted with satisfaction the comments by Authorities to the effect that the enhanced international search and preliminary examination system that had come into operation on January 1, 2004, was running smoothly, noting that this had required a substantial investment by Authorities and the International Bureau in training and in

development of computer systems. Certain areas where particular problems had been encountered are mentioned in the following paragraphs.

12. There had been a few initial difficulties, particularly in that some applicants were uncertain as to how and when they could respond to the written opinion of the International Searching Authority. Those difficulties had largely been overcome by the provision of additional information to users by the Authorities and the International Bureau. Some Authorities were considering providing further training for users to help them to understand the differences between the procedures under Chapters I and II.

13. A particular question was raised in connection with the case where the same Office acted as both International Searching Authority and Preliminary Examining Authority and wished to start the international preliminary examination at the same time as the international search in accordance with Rule 69.1(b). The Meeting agreed that there was a need for clarification as to whether the period for response should be fixed by the International Preliminary Examining Authority in accordance with Rule 66.2(d) rather than being governed by Rules 43*bis*.1(c) and 54*bis*.1(a). The Secretariat agreed to study the question further and to propose any necessary modifications to the PCT International Search and Preliminary Examination Guidelines (document PCT/GL/ISPE/1, "the Guidelines") and to Form PCT/ISA/237,¹ using the PCT/MIA electronic forum.

14. A further difficulty was noted in connection with determining whether the demand had been filed within the time limit under Rule 54*bis*.1 when the same Office did not act as both International Searching Authority and International Preliminary Examining Authority. The International Preliminary Examining Authority was not able to make such a determination until it had been notified by the International Bureau of the date of transmittal to the applicant of the international search report. The International Bureau agreed to study the matter further and to prepare any necessary proposals, possibly including modification of the Administrative Instructions, to overcome the problem.

15. One Authority noted the importance to the applicant and to examiners in the national phase of comparing the invention to the closest prior art even when there were no "X" or "Y" citations relevant to novelty or inventive step. Other Authorities observed that the written opinion of the International Searching Authority was more like the international preliminary report on patentability (Chapter II of the PCT) than a written opinion of the International Preliminary Examining Authority; the former required, under Rule 70.6, both positive and negative statements with respect to novelty and inventive step, whereas the latter, under Rule 66.2(a)(ii), only required negative comments to be made.

16. One Authority noted that it may be desirable for the Guidelines to clarify whether the International Preliminary Examining Authority should issue a further written opinion when the applicant filed amendments under Article 34 on filing a demand after having received the

¹ References in this document to "Articles", "Rules", "Sections" and "Forms" are to those, respectively, of the Patent Cooperation Treaty (PCT), the Regulations under the PCT ("the Regulations"), the Administrative Instructions under the PCT ("the Administrative Instructions") and the Forms contained in Annex A to the Administrative Instructions, or to such provisions as proposed to be amended, modified or added, as the case may be. References to "national laws", "national applications", "the national phase", etc., include reference to regional laws, regional applications, the regional phase, etc.

written opinion of the International Searching Authority. The Secretariat pointed out that this matter was, under the Guidelines, expressly left to each Authority to decide in the particular circumstances of the case.

17. One Authority pointed out that the portions of the new versions of Forms PCT/ISA/210, PCT/ISA/237, PCT/IPEA/408 and PCT/IPEA/409 which related to sequence listings were confusing and, in certain circumstances, misleading. An international application might contain either a sequence listing only, or else a sequence listing and tables, and the required indications regarding the listing and any tables might be different. Also, the term “written format” was ambiguous in view of the redefinition in Part 8 of the Administrative Instructions of the term “computer readable form”. Finally, the question of time of filing should not apply to tables, since Rule 13^{ter} did not permit the furnishing of a table relating to sequence listings after the international filing date for the purpose of the international search, but only provided for the furnishing of the sequence listing itself. The Meeting was pleased to accept the offer of the United States Patent and Trademark Office to present detailed proposals for modification of the sequence listing parts of these Forms.

18. The Meeting agreed with the suggestion by one Authority that Box No. I (“Basis of This Opinion”) of Form PCT/ISA/237 was confusing for both applicants and examiners since, in most cases, no boxes at all would be checked because the international search was carried out on the basis of the international application in the language in which it was filed and there was no sequence listing. It was suggested that the indications regarding the language version which had been searched might be moved to the cover sheet. Alternatively, item 1 of Box No. I should contain two boxes, one indicating that the international search was carried out on the basis of the international application in the language in which it was filed and an alternative indicating that the international search was carried out on the basis of a translation.

19. The Meeting was pleased to accept the offer of the United States Patent and Trademark Office to present a detailed proposal for modification of the cover sheet and Box No. I of Form PCT/ISA/237.

20. The Secretariat recalled that advice on the enhanced international search and preliminary examination system was available for applicants and Offices. In particular, there had been articles in the PCT Newsletter, and the PCT website contained a great deal of information, including short videos and PowerPoint presentations in several languages, introducing the recent changes. Selected PCT seminar presentations and materials would be available shortly on DVD, and the International Bureau had installed video-conferencing facilities which could be used for face-to-face discussions with Offices, applicants and agents. The Secretariat assured the Meeting that it would be pleased to help in the preparation of any further training which Authorities wished to provide.

Investigation of Validity of Priority

21. Discussions were based on Annex II of document PCT/MIA/10/6.

22. It was recognized that there was potential for confusion in comprehending indications made in item 1 of Box No. II of Form PCT/ISA/237. This would arise particularly where the International Searching Authority wished to indicate that a copy of the earlier application (the priority document) or a translation thereof was not in the possession of that Authority even though the priority document had been furnished by the applicant or was otherwise available to the receiving Office or the International Bureau. For example, the priority document might

not be available because the receiving Office had not yet forwarded the priority document to the International Bureau or because the International Searching Authority had not requested a copy from the International Bureau. It was also noted that the Communication on Request system did not yet permit the International Searching Authority to retrieve priority documents electronically prior to publication of the international application concerned.

23. The Meeting agreed that item 1 of Box No. II of Form PCT/ISA/237 should be modified to read as follows:

- “1. The validity of the priority claim has not been considered because the International Searching Authority does not have in its possession a copy of the earlier application whose priority has been claimed or, where required, a translation of that earlier application. This opinion has nevertheless been established on the assumption that the relevant date (Rules 43*bis*.1 and 64.1) is the claimed priority date.”

24. Furthermore, it was recognized that none of the statements in Box No. II should be included when there were no citations with relevant dates which fall between the claimed priority date and the international filing date since, in this case, it would not be necessary to check the validity of the priority claim as it would not be relevant to the opinion on novelty and inventive step.

25. The Secretariat agreed to propose modifications of the Guidelines to make it more clear that, for all written opinions and international preliminary reports on patentability, Box No. II need only be included when there is a need to investigate the validity of the priority claim. At the same time, a modification would be proposed to indicate that item 3 of Box No. II (“Additional observations, if necessary”) could be used to indicate that the priority claim had been checked and considered to be valid.

26. It was agreed that the issue of checking of the validity of priority claims should be revisited at such time as systems were in place enabling Authorities to access priority documents in electronic form “on demand” when establishing written opinions.

27. One Authority noted, in relation to this and other proposals for modification of the Forms, that the benefits of each change to the Forms, and the timing for making and grouping such changes, should be weighed against the considerable cost of implementing changes to the computer systems within the International Authorities which generated them.

Presenting Reasoning When No (or Limited) International Search Can Be Performed

28. Discussions were based on document PCT/MIA/10/6, Annex I, and document PCT/MIA/10/6 Add.1.

29. There was consensus amongst the International Authorities that the international search should be as complete as possible for any international application. Nevertheless, there were certain circumstances in which searching the full scope of a claim was not possible, or in which, for policy reasons, some Offices did not conduct searches. When no search had been made, or the search did not cover the full scope of the claims, it was important that both the applicant and third parties should be aware of the extent to which the international search had been conducted and of the reasons for any limitations. Since the international search report (or the declaration under Article 17(2)(a)) was published with the international application, it

was desirable that the detailed reasoning be set out in that report itself, rather than in the written opinion of the International Searching Authority, the content of which would only become available 30 months from the priority date.

30. In the case of international applications which were overwhelmingly characterized by subject matter which was excluded from search by the International Searching Authority but which included a trivial element of “technical” subject matter, the Meeting noted that it was important that the claimed invention should be treated as a whole, rather than as a collection of elements. It was, however, considered that, in general, a search covering only one aspect of the claims was better than no search at all, provided that the extent of the search and the reasons for any limitations were made clear.

31. The Meeting agreed that the Secretariat should draft proposals for modifying the Guidelines to emphasize that the international application should be searched to the maximum extent possible and that any limitations should be set out, with reasons, in the international search report (or the declaration under Article 17(2)(a)).

Reissue or Correction of Search Reports and Written Opinions

32. It was noted that the circumstances which would justify reissue or correction of an international search report or written opinion (such as the omission of a citation) would often be such that it would be appropriate for the Authority concerned to withdraw the originally issued report *ab initio*, in which case the date of reissue would be considered to be the date of transmission of the report for the purposes of calculating time limits, noting that this might materially affect the choices available to the applicant. In other cases, however, a corrected report would be in the nature of a simple correction of minor details, and the original date on which the report was issued should stand. The Authority had a discretion to decide whether the original date or the date of reissue would be the applicable date in a particular case. It was important, however, that the position be clear on the face of the reissued or corrected report. The Authority should also use its discretion as to whether both the international search report and the written opinion should be reissued or corrected if an error concerned only one of them (although it was noted that the reissue or correction of an error in one would often require reflection in the other, in particular to ensure that any change to the deemed date of mailing was properly reflected as one and the same date on both documents). Similar considerations to those outlined in the previous sentences would apply where an Authority wished to withdraw or correct a declaration under Article 17(2)(a). The Meeting did not consider that these matters needed to be addressed in the Guidelines.

33. In relation to the possible occurrence of discrepancies between the international search report and the written opinion of the International Searching Authority, the Secretariat agreed to review paragraph 17.12 of the Guidelines to make it clear that the possibility of indicating a different classification term in a written opinion from that which had been indicated in the international search report only applied in the case of a written opinion established at a later time by the International Preliminary Examining Authority.

Transmittal of ISR and WO/ISA

34. The Meeting noted the request from the International Bureau that, when mailing the international search report and the written opinion of the International Searching Authority, the Authority should place the written opinion on top of the international

search report and attach both documents together physically, preferably with a paper clip or staple.

Further Review of the PCT International Search and Preliminary Examination Guidelines

35. The Meeting agreed that it would not be desirable to conduct an extensive review of the Guidelines at this time. Any modifications should be limited, for the time being, to the issues noted in this report, the correction of certain minor errors which had been noted by the International Bureau, and any changes which were required to reflect the amendments of the Regulations that had been submitted to the PCT Assembly for adoption at its 33rd session in Geneva in September-October 2004.

QUALITY FRAMEWORK FOR PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION

36. Discussions were based on document PCT/MIA/10/3 and also took into account initial reports presented by the various Authorities on implementation so far of systems for quality management, as provided by Chapter 21 of the PCT International Search and Preliminary Examination Guidelines (document PCT/GL/ISPE/1).

37. It was noted that the quality framework outlined in that Chapter had been introduced in the context of the enhanced international search and preliminary examination system that came into operation comparatively recently, on January 1, 2004, and that further and more detailed discussions of quality management matters would need to take place at future sessions of the Meeting. The International Bureau agreed that it would also present a report on quality management in the context of its related work for consideration at such future discussions, noting that the nature of that work was very different from the search and examination work carried out by the Authorities.

38. The Meeting, in accordance with paragraph 21.17 of the Guidelines, adopted a general initial report on quality management, set out in Annex II, for submission to the PCT Assembly at its 33rd session in September-October 2004.

MINIMUM DOCUMENTATION

Traditional knowledge

39. Discussions were based on document PCT/MIA/10/4.

40. The Meeting noted the five periodicals that had been selected for inclusion in the non-patent literature list under Rule 34 and also supported the inclusion of six additional traditional knowledge related periodicals as proposed by the European Patent Office. The Meeting also approved the proposed new format to be adopted when publishing the updated minimum documentation list of periodicals.

41. The Meeting discussed how future additions to the non-patent literature list should be handled and how to proceed with regard to the selection of traditional knowledge related databases for use by International Searching Authorities when carrying out international searches. A number of Authorities expressed the view that the current method of addition of periodicals to the non-patent literature list was satisfactory, but only until such time as a comprehensive review had been undertaken. They emphasized the need for a more practical

approach to the handling of non-patent literature than simple access to listed periodicals, such as by the use of databases and, in general, a flexible toolbox approach, focusing on particular fields of technology.

42. One Authority, while stating that it was in favor of a comprehensive review of current practices, emphasized the importance of the recent exercise which provided a timely inclusion of traditional knowledge related periodicals into the non-patent literature list and, as such, brought improvements to the coverage of prior art relating to traditional knowledge in international searches. Although the Authority was of the opinion that it would not be practical to search all journals included in the non-patent literature list, it considered that a possible step towards a solution could be to stimulate publishers to include these journals within their databases.

43. The Meeting agreed that it would be better to address the question of selection of traditional knowledge related databases within the wider spectrum of the proposed comprehensive review of PCT minimum documentation.

Comprehensive Review

44. Discussions were based on document PCT/MIA/10/5.

45. The European Patent Office introduced the topic by highlighting some of the main points included in its discussion paper contained in the Annex to document PCT/MIA/10/5. Noting that the concept of the PCT minimum documentation under Rule 34 was established in the paper age, when it afforded a level of security to both the applicant and the International Searching Authority, the Office questioned whether, in today's electronic age, Rule 34 was still relevant. It expressed the view that to search only what was specified in Rule 34 provided a false sense of security and that there was a danger of thereby degrading the functioning of the patent system. It considered that there was a need for a much more comprehensive view of what search material International Searching Authorities should have access to, noting that, today, the range of documents available in electronic form was virtually limitless. While the Office recognized that there were some copyright problems in respect of non-patent literature and that there was a need to agree on some special issues, such as, for example, the handling of sequence listings, it expressed the view that the general strategy should be based on the notion of access to all patent documents and all non-patent literature.

46. The Meeting agreed that a comprehensive review of the approach to the PCT minimum documentation was necessary. However, a number of Authorities cautioned that the review should be conducted carefully, with an emphasis initially on non-patent literature and the list under Rule 34. The copyright issues involved in supplying copies of documents and maintaining databases were highlighted.

47. In considering the appropriate forum for the review, one Authority noted that there were a number of technical considerations to be considered, including issues such as load software implications and the need for standard formats, the adoption of an intellectual property digital library approach to access non-patent literature, the use of search grids focusing on particular fields of technology, and how information should be accessed through the Internet. While it was noted that the issue should eventually be referred to other bodies, such as the PCT Committee for Technical Cooperation or the Standing Committee on Information Technologies, the Meeting agreed that discussions should, at least initially, be continued among the Authorities with the aim of obtaining agreement in principle, at the policy level, on

the overall approach and framework for international search. It was considered that the initial discussions should aim at seeking a definition of the objectives which should be met in any new approach to PCT Rule 34 and, in broad terms, the legal and technical means by which the objectives might be achieved. Discussions might also cover technical issues having a broader impact, such as possible solutions to copyright issues, for example, by the use of linking information (Digital Object Identifiers) for exchanging non-patent literature.

48. The Meeting invited Authorities to provide comments on the points highlighted in document PCT/MIA/10/5, using the PCT/MIA electronic forum, in preparation for discussions at the next session.

49. In the context of developing tools for the more effective searching of non-patent literature, the Secretariat gave a presentation² on exploratory work it had done towards developing a tool entitled “Search Guidance Intellectual Property Digital Library”, as referred to in the Guidelines (see, for example, paragraph 15.16). The Secretariat encouraged Authorities to provide feedback, using the PCT/MIA electronic forum, to aid further development of such tools.

COPYRIGHT IN NON-PATENT LITERATURE CITED BY THE INTERNATIONAL SEARCHING AUTHORITIES

50. Discussions were based on document PCT/MIA/10/8.

51. The Meeting agreed that it seemed unlikely that a common international solution could be found to the problems identified in document PCT/MIA/10/8, relating to the possibility of providing copies of citations in international search reports of documents forming part of non-patent literature to the applicant, to other Authorities and national Offices, and to members of the public, as well as to the placing of copies on the International Searching Authority’s files. The matter depended on national law and practice, which was by no means uniform, as well as on the provisions of the Berne Convention, whose application and interpretation also varied among jurisdictions.

52. The Meeting noted that WIPO’s Standing Committee on Copyright and Related Rights had included in its future work program a consideration of the scope of limitations and exceptions under the Berne Convention in the digital environment (see document SCCR/8/2, paragraphs 23 to 26), but it was not clear whether or when the matter might be addressed by that Committee. A suggestion that the matter be taken up by WIPO’s Standing Committee on Information Technologies was not generally agreed.

53. Among the possible approaches and other matters mentioned by various Authorities were: the citation of documents by means of linked internet references as a means of avoiding the provision of copies; the inclusion of suitable provisions in contracts between Authorities and the providers of search databases relating to the preparation and provision of copies, as well as the insurmountable difficulties that would be encountered in pursuing such an approach in certain jurisdictions; the cost factor for large and small Authorities that would accompany the conclusion of broader contractual rights to prepare and provide copies; and possible difficulties in deciding how and to whom royalty payments, if any, needed to be paid.

² The presentation is available on WIPO’s website at www.wipo.int/meetings/en/details.jsp?meeting_code=PCT/MIA/10.

54. The Meeting recognized that individual Authorities would benefit from sharing their experiences and from being informed of approaches that had been found or were being examined in other Authorities, and agreed that the Secretariat should invite such an exchange of information via the PCT/MIA electronic forum. The matter should be retained on the agenda for future sessions of the Meeting as an item for information and discussion.

AVAILABILITY OF SEQUENCE LISTINGS IN ELECTRONIC FORM

55. Discussions were based on document PCT/MIA/10/9.

56. The Meeting welcomed the new direction taken by the draft proposals, which overcame many of the concerns expressed in the Working Group on Reform of the PCT and appeared to be better focused on meeting the needs of International Authorities, particularly in reducing the need to request a further copy of a sequence listing from the applicant for the purposes of the international search.

57. Some concerns remained as to possible budgetary implications, both for the International Bureau and for the Authorities and other Offices needing to access sequence listings, as well as to whether the technical infrastructure would be capable of handling the extremely large files which may be received. The International Bureau pointed out that it had an obligation, independent of the present proposals, to receive and store electronically filed international applications containing sequence listings. As to the provision of copies to Authorities and Offices, one Authority emphasized the importance of the provisions in Rule 13*ter* as proposed to be amended by document PCT/A/33/2 to the effect that an Authority or Office was not precluded from requesting a copy of a sequence listing directly from the applicant in the event that the listing was not “available to it in a form and manner acceptable to it”.

58. The Secretariat indicated that it would attempt to take the views expressed at the session into account in preparing the final version of a document for submission to the Working Group.

ELECTRONIC EXCHANGE OF DOCUMENTS

59. Discussions were based on document PCT/MIA/10/10.

60. The Secretariat gave a presentation of the PCT Electronic Data Interchange (EDI) Service,³ which provided a flexible, secure mechanism for the bi-directional exchange of patent documentation between Offices and the International Bureau. The protocols used were compatible with a wide range of applications which were available in numerous languages and thus did not require the development of customized software. A number of International Authorities and other Offices had been involved in pilot exchanges of documents of different types and in different document formats. The International Bureau had undertaken to accept and, where necessary, convert documents in the formats used by individual Offices where bilateral discussions had determined that this was practical.

³ The presentation is accessible on WIPO’s website at www.wipo.int/meetings/en/details.jsp?meeting_code=PCT/MIA/10.

61. Following the success of the various pilot exchanges that had been undertaken, the Meeting noted the request by the Secretariat that International Authorities provide contact points within their Offices for establishing work plans for the progressive implementation of electronic transmission of documents.

PCT STATISTICS

62. The Secretariat gave a presentation of some recently developed statistical reports relating to the PCT procedure.⁴ The new reports were designed to assist in improving PCT services generally, and the work of the International Bureau in particular, in several ways:

(a) by giving more useful and accurate information concerning the use of the PCT system and of the patent system in the more global sense; it was noted in this connection that the Secretariat was revising the questionnaires sent to Offices and Authorities in the course of the production of the “WIPO Industrial Property Annual Statistics” (formerly published on paper and now in electronic form⁵), in particular with a view to eliminating distortions stemming from different counting methods for PCT designations;

(b) by providing better management information as to developments in the PCT system in terms of use of the system by applicants and of the activities of receiving Offices, International Authorities, designated and elected Offices, and the International Bureau, both for the purposes of management of PCT operations and for making better projections for the purposes of WIPO’s Program and Budget;

(c) for internal management purposes within WIPO’s Office of the PCT, such as by providing better indicators of productivity, with a view to achieving more efficient operations.

63. Matters covered by the presentation included filing trends (based on international filing date rather than, as in previous such reports, on receipt by the International Bureau of record copies), transmittal of record copies, international search and international preliminary examination activities, and international publication and republication, with breakdowns according to the Offices or Authorities concerned and indicators as to the timeliness of performance of certain critical procedures. The Secretariat drew attention to the fact that PCT statistical indicators reports were now available on WIPO’s website,⁶ together with the possibility of subscribing to a statistics e-mail updating service, and noted certain comments made in the discussion with a view to improving the usefulness of the reports.

64. The Meeting noted the Secretariat’s presentation with gratitude.

PCT FORMS: INTERNATIONAL SEARCH REPORTS, WRITTEN OPINIONS AND INTERNATIONAL PRELIMINARY REPORTS ON PATENTABILITY

65. Discussions were based on documents PCT/MIA/10/7 and 7 Add.1.

⁴ The presentation is accessible on WIPO’s website at www.wipo.int/meetings/en/details.jsp?meeting_code=PCT/MIA/10.

⁵ See WIPO’s website at www.wipo.int/ipstats/en.

⁶ See WIPO’s website at www.wipo.int/pct/en/statistics/index.htm.

66. It was recalled that the issue of the format of Forms for international search reports, written opinions and international preliminary reports on patentability had emerged from discussions some years earlier of electronic formats and how to tag information. There was a risk of duplication of work which was presently going on in the Consultative Group on Proposals for Change to the PCT E-filing standard⁷ and the Standing Committee on Information Technologies Information Technology Projects Working Group.⁸

67. While some Authorities expressed their interest in making progress in the development of a “linear” format for reports and opinions, others indicated that they would not wish to make the necessary investment to adopt such a format at this time and preferred to await further developments concerning the underlying data structure. Certain advantages of the traditional “box” format were noted, which would need to be taken into account in the development of any new format, including that the fact that a box was not checked might itself convey useful information, and that it was useful to distinguish standard text clearly from non-standard (“free”) text both to ease comprehension and to facilitate translation.

68. The Meeting agreed that there should be an exchange of information between the Meeting and any other bodies involved in the development of electronic formats for reports and opinions issued by the International Authorities, but that development of a new format by the Meeting should not continue at this stage. Further consideration could be given to this issue at a future session of the Meeting, depending on the progress made elsewhere on electronic formats and standards.

69. The Secretariat informed the International Authorities that it believed that a more general review of the Forms sent to or by the International Authorities would be desirable in the near future.

FURTHER WORK

70. The Meeting discussed various aspects of its future work program. The value of the Meeting as a forum for exchange of views and experience among the International Authorities was emphasized, noting that they had responsibility for performing specialized functions under the PCT and together represented a substantial and recognized body of expertise in search and examination work.

71. There was general agreement with the view that sessions of the Meeting should be convened regularly in order to maintain momentum and to ensure that the flow of information and development of ideas continued in a mutually beneficial way.

72. It was agreed that certain matters considered at the present session needed further work at the next sessions of the Meeting, including the planned comprehensive review of the minimum documentation (see paragraphs 44 to 49, above), the development of quality management systems for international search and preliminary examination (see paragraphs 36 to 38, above), and a further sharing of views and experience relating to copyright in non-patent literature (see paragraphs 50 to 54, above).

⁷ See WIPO’s website at www.wipo.int/pct/efiling_standard/en/.

⁸ See WIPO’s website at www.wipo.int/meetings/en/topic.jsp?group_id=119.

73. It was noted that a number of matters directly relating to the work of the International Authorities had arisen in connection with ongoing work on reform of the PCT, and some of these had been considered at the present and previous sessions of the Meeting, including quality management, the processing of sequence listings, and copyright in non-patent literature. It was agreed that it would be useful for consideration of such matters to continue at future sessions of the Meeting, complementing the work of the Working Group on Reform of the PCT, together with consideration of other matters relating to the work of the Authorities. This would be of benefit to the Secretariat in the preparation of improved drafts for consideration by the Working Group, which was responsible for preparing proposals and recommendations for consideration by the PCT Assembly. Among such matters of particular importance for the work of the Authorities were restoration of the right of priority (with consequences for the scope of relevant prior art), rectification of obvious errors (the Authorities being responsible for authorizing certain kinds of rectification), supplementary and updating international searches, and the publication of international applications in multiple languages (with consequences for such applications' prior art effect).

74. The Secretariat suggested that the Meeting may also wish at its coming sessions to consider what role the Meeting might have in assisting an Office that in the future sought appointment by the Assembly as International Authority, noting the existing qualifications for appointment of Authorities in terms of minimum documentation and numbers and expertise of search and examination staff, as well as the new approaches that were now being developed for accessing technical literature for search purposes, and the greater importance being accorded to the introduction of quality management systems.

75. It was agreed that consideration of matters via the PCT/MIA electronic forum was very useful. Authorities were encouraged to continue to use the forum in order to advance discussions as much as possible between sessions of the Meeting.

76. The Meeting agreed that its next session should be convened in January 2005, with the possibility of a further session in March 2005, on the understanding that the Secretariat may propose earlier dates if the circumstances of its work program permitted.

77. The Meeting unanimously adopted this report on September 15, 2004.

[Annex I follows]

ANNEX I

LIST OF PARTICIPANTS

I. INTERNATIONAL AUTHORITIES

(in the English alphabetical order of their names)

AUSTRIAN PATENT OFFICE

Peter HOFBAUER, Head, Department for Search and Technical Support

CANADIAN INTELLECTUAL PROPERTY OFFICE

Nathalie C. TREMBLAY (Mrs.), Project Officer, Patent Branch

EUROPEAN PATENT OFFICE

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Colin PHILPOTT, Director, Practice and Procedure

Mark WEAVER, Director, Directorate 2.4.04, Biotechnology

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IP AUSTRALIA

Dave HERALD, Deputy Commissioner of Patents, Deputy Registrar of Designs

JAPAN PATENT OFFICE

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KOREAN INTELLECTUAL PROPERTY OFFICE

In-Sun CHOI, Patent Policy Planning Division, Mechanics and Metals Examination Bureau

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NATIONAL BOARD OF PATENTS AND REGISTRATION OF FINLAND

Kristiina GRÖNLUND (Ms.), Head, Search and Advisory Service

Raimo HELLGREN, Senior Examiner

SPANISH PATENT AND TRADEMARK OFFICE

Gerardo PENAS GARCÍA, Head, Technological Information Unit

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Javier VERA ROA, Head, Patent Services (Mechanical)

Marcos GÓMEZ MARTÍNEZ, Counsellor, Permanent Mission, Geneva

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

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Jon SANTAMAURO, Intellectual Property Attaché, Office of the United States Trade Representative, Permanent Mission, Geneva

Charles PEARSON, Director, Office of PCT Legal Administration

Dominic KEATING, Patent Attorney, Office of International Relations

Stephen G. KUNIN, Deputy Commissioner for Patent Examination Policy

Esther KEPPLINGER (Mrs.), Deputy Commissioner for Patent Operations

II. OFFICERS

Chair: Francis GURRY (WIPO)

Secretary: Michael RICHARDSON (WIPO)

III. INTERNATIONAL BUREAU
OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

Francis GURRY, Deputy Director General

Jay ERSTLING, Director, Office of the PCT

Patent Policy Department:

Philip THOMAS, Director

Claus MATTHES, Head, PCT Reform Section

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Jørgen BLOMQVIST, Director, Copyright Law Division

Isabelle BOUTILLON (Ms.), Director, PCT Management Division

Juan Antonio TOLEDO BARRAZA, Director, PCT Operations Division

Matthew BRYAN, Acting Director, PCT Legal Division

Diego Agustín CARRASCO PRADAS, Acting Director, PCT External Legal Relations
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Neil WILSON, Acting Chief Information Officer, IT Division

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Mikhail MAKAROV, Deputy Director

William GUY, Head, Technology Documentation Section

Mary BONSELL (Mrs.), Senior Technical Information Officer

William MEREDITH, Head, PCT Functional Support Section

[Annex II follows]

ANNEX II

QUALITY MANAGEMENT SYSTEM FOR
INTERNATIONAL AUTHORITIES UNDER THE PCT

(Report to the PCT Assembly)

SUMMARY

1. Each of the International Searching and Preliminary Examining Authorities has its own quality management system which seeks to ensure that the Authority provides high quality services in its role under the PCT. This document reports to the Assembly, in general terms, how these systems correspond to the common quality framework set out in Chapter 21 of the PCT International Search and Preliminary Examination Guidelines (document PCT/GL/ISPE/1, “the Guidelines”) and highlights certain features which individual Authorities presented to the other Authorities for discussion and as suggestions of good practice.

BACKGROUND

2. Chapter 21 of the Guidelines sets out a common quality framework for international search and preliminary examination. This recognizes that some variability is inherent in the international search and examination process, but that minimizing inconsistencies between and within the International Searching and Examining Authorities is crucial to the unqualified acceptance of an Authority’s work product by other Offices. Consequently, it provides a minimum set of criteria that each International Authority should use as a model for establishing its own individual quality management system.

3. In accordance with paragraph 21.17 of the Guidelines, the International Authorities presented initial reports to the Meeting of International Authorities under the PCT describing what they had done to implement quality management systems, so that best practice among Authorities could be identified and disseminated. The Meeting of International Authorities adopted this general initial report on progress at its tenth session, held in Geneva from September 13 to 15, 2004, for submission to the PCT Assembly.

REPORT

General

4. Each International Authority has a quality management system in place. In general, each system is part of a broader quality system for the national or regional Office concerned as a whole, covering also its roles in national or regional procedures, work as a PCT receiving Office, and any other roles. However, each has ensured that the system recognizes and deals with the specific requirements of international search and preliminary examination under the PCT.

5. Each system is different, according to what has been considered appropriate to the particular circumstances of the Office. However many have reviewed a range of different general quality systems and incorporated the best fitting tools and processes based on well known and respected models, including the ISO 9000 series of quality system guidelines and requirements, the European Foundation for Quality Management Excellence Model, and the principles of Total Quality Management.

Resources and Administration

6. The Guidelines indicate that an International Authority should have an appropriate infrastructure to support the search and examination process and the ability to accommodate changes in workload.
7. Each of the International Authorities has access to search material in excess of the PCT minimum documentation referred to in PCT Rule 34. To a continually increasing extent, the search material is accessed through electronic databases. Significant resources are being devoted to the improvement of the search tools available to examiners for the search of these databases and to the training of the examiners so as to be able to use these tools to best effect.
8. The quality of any report is dependent on the ability of the examiner preparing it. The Authorities have stringent selection criteria to recruit people with the appropriate technical, linguistic and analytical aptitude. This is then reinforced by training over several years, including both formal courses and on the job training.
9. Each of the Authorities also provides ongoing training and development throughout the career of its examiners. This may include: refresher courses and seminars; further language training; technical training including conferences, lectures or university courses, site visits and industrial internships; and seminars and workshops covering new procedures, software tools and search techniques. Some of the Authorities also have examiner exchange programs to share knowledge and foster consistency between Authorities.
10. This training is also backed up by manuals and guidelines. In addition to the PCT International Search and Preliminary Examination Guidelines, each Authority provides up to date guidance on practice within the Authority and manuals and tips for a wide variety of tasks, especially concerning the best use of the electronic search tools which are available. In some cases, guidance is available through easily searchable databases, as well as through conventional manuals and notices in electronic form.
11. The Authorities provide a high standard of IT support for the search and examination process. In addition to the online search facilities referred to in paragraph 7, above, a number of systems have been developed to assist the preparation of reports, minimizing the risk of discrepancies between search and examination reports and allowing easy inclusion of useful additional information such as equivalent documents from a patent family.
12. Each Authority maintains a number of groups responsible for continually reviewing the manner in which various aspects of the search and examination work is done and for disseminating recommendations on best practice.
13. The examiners in each Authority cover the entire spectrum of technology. Various methods are used, depending on the particular circumstances of the Authority, to ensure the appropriate distribution of work and to allow the flexibility to react to varying levels of demand in different fields while ensuring the necessary depth of knowledge in a particular field to ensure a high quality of search and examination.
14. The examination process is supported by specifically trained administrative staff ensuring the proper flow of work. In addition, most of the Authorities use electronic systems

to monitor the workload providing not only information and warnings concerning the state of individual international applications, but also the ability to assess overall levels of demand and the distribution of workload in different fields.

Quality Assurance

15. Each of the International Authorities uses more than one means of ensuring the quality of international search reports and international preliminary reports on patentability, including measures to ensure the accuracy of individual reports as they are established and assessment of sample reports at a later stage with feedback to encourage improvement for the future when deficiencies or particularly good practice are noted.

16. The methods used to ensure the quality of individual reports include using a team of examiners to consider together the appropriate search strategy and having the final report considered by a second examiner, either a peer or a supervisor, before it is issued. Particular attention is paid to reports prepared by trainees. In addition, some Authorities have a system of obtaining a second opinion in “high risk” cases, such as where the examiner considers that there may be a lack of unity of invention. Some Authorities include second opinions by specialist examiners on particular aspects of the search and examination process, such as the classification of the international application.

17. Many of the Authorities conduct testing of random samples of reports after they have been issued to determine the overall quality of examination being performed and to identify any issue which could usefully be drawn to the attention of individual examiners or the examining staff as a whole. Some use citation analysis to identify trends and make comparisons.

Communication with Users

18. Each of the Authorities has means for communicating with users on several different levels. For routine queries concerning particular international applications, each report includes contact details, allowing the applicant to contact the examiner, in general by telephone, letter, fax or personal interview and, in some cases, by e-mail or video-conference.

19. Each Authority also has a mechanism for dealing impartially with user complaints and comments which are received. Some of the Authorities described work which is under way towards improving the recording and tracking of complaints and comments which are made informally, for example by oral comments or incidental comments in letters primarily related to other matters.

20. A number of Authorities also solicit user feedback more generally, for example, through user meetings (including sessions arranged with agents and applicants in general, and ones focusing on applicants from specific fields) and independently administered surveys.

Feedback

21. Each Authority provides feedback to examiners on the results of the various quality assessment processes. Depending on the nature of issues encountered, the feedback will be given to individual examiners or else, where an issue of general relevance is noted, to all examiners. Feedback includes both recommendations as to how to avoid errors which have

been noted and dissemination of best practice, such as in model reports when examples of particularly good practice are noted. In some Authorities, rewards are offered to staff who make an outstanding contribution to the improvement of quality.

Guidance to Users

22. The Authorities provide guidance to users in numerous ways, such as web sites, advice lines and centers, and running courses on various aspects of the PCT procedure. The literature provided includes, in some cases, translations of the entire Guidelines and Administrative Instructions into local languages as well as more basic guidance.

Internal Review of Quality Management Systems

23. The Authorities treat the issue of quality management seriously, with high level consideration being given to the results of assessments and proposals for improvements in both quality and the process of quality management. A number of Authorities have set up ongoing committees with a specific mandate to review and improve quality management systems.

FURTHER WORK

24. The Meeting of International Authorities has not yet had time to fully assess the merits of the various aspects of all the quality management systems described in the reports of individual Authorities. Consequently, the Meeting decided to continue discussion of these systems using its electronic forum and to continue formal discussion at the next session.

25. Particular attention will be given to the issue of how best to share information concerning quality systems in future reports and discussions, so as to be able to benefit from best practice among the International Authorities, with a view to moving towards practices in quality management and quality assessment which would result in greater acceptance of all Authorities' work products by other Offices.

[End of Annex II and of document]