Patent Cooperation Treaty (PCT) Working Group

Eighteenth Session
Geneva, February 18 to 20, 2025

COORDINATION OF PATENT EXAMINER TRAINING

Document prepared by the International Bureau

SUMMARY

1.   This document proposes the development of an online course with the WIPO Academy to provide foundational training on patent examination, primarily for new or inexperienced patent examiners at small Offices. The document also proposes to start a small-scale pilot project to create a networking platform for patent examiners.

INTRODUCTION

2.   At its seventeenth session in 2024, the PCT Working Group had discussions based on the findings from the Survey conducted by the International Bureau for coordination of patent examiner training for small and medium Offices. The International Bureau also made proposals to develop introductory materials on patent examination to be included in the e-learning repository under development and adding an electronic networking platform on that repository (see document PCT/WG/17/11).

3.   The Working Group invited the International Bureau to continue to work with interested Offices in developing training materials, taking into account comments made in the Survey and during the session (see paragraphs 11 and 12 of the Summary by the Chair, document PCT/WG/17/21). Some delegations asked the International Bureau to prepare more detailed implementation plans for the proposals.

"WIPO ACADEMY FOUNDATION COURSE ON PATENT EXAMINATION" FOR NEW OR INEXPERIENCED PATENT EXAMINERS OF SMALL OFFICES

4.   As noted in the previous session of the Working Group, e-learning materials provided by donors are often on specific topics rather than providing an overview of the patent examination process. The responses to the said Survey and discussions at the Working Group also

reaffirmed that there is a need for foundational training for new or inexperienced examiners to learn the basics of patent prosecution procedures, e.g. prior art searches and assessing patentability requirements so that they can prepare themselves to take more specific and detailed trainings.

5.   Based on the Survey findings and individual discussions with Offices, the International Bureau found that small Offices are often looking for assistance on where and how they should start training their examiners, particularly when they are introducing substantive patent examination in the relevant jurisdictions.

6.   Even though there are long-term capacity building programs made available by other Offices on patent examination (see paragraph 11 of PCT/MIA/21/4 and paragraph 16 of PCT/WG/14/13 for examples), they often have limitations in terms of the number of participants due to their intensive nature and may not be available immediately any time there are needs for training. New or inexperienced examiners would also need basic knowledge of each step of patent examination to make an informed decision about which advanced and jurisdiction-specific training courses suit their needs.

7.   Therefore, the International Bureau proposes an online "WIPO Academy Foundation Course on Patent Examination" to equip new and inexperienced examiners with key technical and procedural competencies essential for effective patent examination.

OBJECTIVES

8.   The course aims to provide examiners with a conceptual understanding of the international patent system and technical and procedural knowledge of globally common aspects of patent examination. It will also focus on practicing skills, such as using databases for prior art searches, communicating with applicants, and assessing patentability requirements. Foundational competencies from this course will enable learners to effectively contribute to substantive examination and serve as a cornerstone for further specialized training.

9.   The "WIPO Academy Foundation Course on Patent Examination" is expected to contribute by:

- Strengthening capacities of small Offices worldwide by offering a foundational tool for training and professionalizing examiners.

- Offering Member States a flexible, cost-effective, and scalable training solution through the use of online learning tools. Self-paced online modules will accommodate the busy work schedules of examiners while also reaching large numbers.

- Disseminating knowledge of existing examination procedures and practices at an introductory level for better understanding of work products of other Offices.

- Raising the quality of examination and, in turn, the quality of patents granted by the Offices.

TARGET PARTICIPANTS

10.   The main target participants of the foundation course will be new or inexperienced substantive patent examiners of small Offices.

11.   The course will be offered for free to all examiners at Patent Offices, and any staff of Intellectual Property Offices of WIPO Member States. It may be explored whether the course can be made available, possibly at a reasonable fee, to students, patent agents/attorneys, and anyone else interested in the topic.

CONTENTS AND FORMAT

12.   The "WIPO Academy Foundation Course on Patent Examination" will be centered on self-paced online modules. Complementing features such as live lectures and virtual discussion forums with instructors/subject-matter experts may be considered. Participants would receive a WIPO Academy certificate after completing the coursework and passing a final examination.

13.   The contents will focus on a conceptual understanding of the patent system, and technical and procedural knowledge of patent examination. This course will lay the foundation for more advanced materials, which will be available in the e-learning repository and/or jurisdiction-specific training programs offered by other Offices or WIPO. Proposed items to be included in the course are set out in the Annex to this document.

14.   The WIPO Academy will provide the online platform for administration, delivery, and management of the foundation course through the WIPO eLearning Center.

15.   The course will initially be developed and launched in English. The International Bureau will consider providing more language versions later upon requests by WIPO Member States.

DEVELOPMENT OF THE COURSE

16.   The "WIPO Academy Foundation Course on Patent Examination" will be jointly developed and administered by the PCT International Cooperation Division and the WIPO Academy IP eLearning Section.

17.   Contributions by Offices are essential to minimize errors, ensure neutrality, accommodate different practices, and also to reduce duplications with existing materials and programs provided by other Offices. The International Bureau proposes to establish a Task Force including interested Offices so that they can contribute to scoping and development of the course, for example, by sharing and checking information on practices in their jurisdictions. The International Bureau will also consider hiring external consultants to write and develop the course materials within a reasonable timeframe.

UTILIZATION OF THE COURSE

18.   The online foundation course will serve to meet immediate and basic training needs of small Offices. This course may serve as prerequisite criteria for more advanced and/or jurisdiction-specific training programs offered by the International Bureau or other Offices to maximize efficiency and effectiveness.

19.   The International Bureau will continue to provide on-site trainings to meet diverse training needs of Offices after launching of the foundation course.

NETWORKING PLATFORM AMONG PATENT EXAMINERS

20.   This project aims to establish a virtual networking platform for patent examiners to promote collaboration, knowledge-sharing, and continuous professional development among patent examiners.

21.   The initiative will launch as a small-scale pilot project targeting a specific region, bringing together a group of examiners who share the same language and specialize in a common technology field.

OBJECTIVES

22.   The objectives of this project will be to: (i) enhance examination practices: share best practices, tips, and experiences to improve the consistency and quality of patent examination; (ii) facilitate knowledge exchange: provide access to academic and scientific articles, case studies, and significant patent decisions; (iii) promote collaboration: enable examiners to

discuss challenges, ask questions, and collectively discuss complex cases; and (iv) foster continuous learning: keep examiners updated on the latest developments in patent law, technology trends, and examination practices and tools.

PILOT FEATURES

23.   The pilot features will be: (i) with a regional focus: starting in a specific region to leverage a shared language and cultural context; (ii) technology-specific: initial focus on a specific technology sector to address targeted needs; (iii) with an interactive platform; and (iv) community engagement: forums, virtual meetups, and discussion boards for active participation.

EXPECTED OUTCOMES

24.   The expected outcomes will be: (i) the creation of a robust community of patent examiners with shared expertise; (ii) improved examination practices and decision-making; and (iii) identification of scalable practices for future regional and technological expansions of the networking platform.

25.   By starting with a focused pilot, the project will test and refine its framework, paving the way for a broader implementation that could support patent examiners globally.

26.   The Working Group is invited to comment on:

(i)   the proposal to develop the "WIPO Academy Foundation Course on Patent Examination" for new or inexperienced patent examiners of small Offices, set out in paragraphs 4 to 19, above; and

(ii)   the proposal to conduct a pilot for a networking platform among patent examiners as outlined in paragraphs 20 to 25, above.

[Annex follows]

PROPOSED MODULES FOR THE INTRODUCTORY DISTANCE LEARNING COURSE FOR NEW OR INEXPERIENCED EXAMINERS OF SMALL OFFICES

INTRODUCTION

1.   This Annex is to provide outlines of the proposed course for discussions at the eighteenth session of the PCT Working Group. The modules are subject to changes according to discussions at the session and of the proposed Task Force, as well as demands by the potential beneficiary Offices.

2.   The following modules are based on known commonalities of patent search and examination. Whenever there are different practices or discrepancies, the International Bureau will accommodate as many of them as possible equally, with the assistance of the proposed Task Force.

PROPOSED MODULES

(1)   BASICS OF THE PATENT SYSTEM AND PATENT APPLICATION

3.   This module will cover the concept of exclusive rights, terms of protection, right of priority, and elements of a typical patent application such as the description and claim(s). The territorial nature of patent right and patentability criteria will be emphasized.

(2)   COMMON STEPS OF PATENT PROSECUTION

4.   Most commonly appearing steps of patent prosecution such as formality check, classification and prior art search will be listed in the order patent examiners are likely to perform them.

(3)   FORMALITY EXAMINATION

5.   The course will focus on substantive examination, considering that it is not feasible to cover all different national/regional formal requirements. However, some commonalities of formality examination will be covered briefly in this module to help users understand the overall patent prosecution procedures.

(4)   CLASSIFICATION

6.   The concept of patent classification will be introduced, mainly based on the International Patent Classification (IPC). Other classification schemes will also be covered to help the users understand what they will find from the work products of other Offices.

(5)   SUFFICIENCY OF DISCLOSURE, SUPPORT OF CLAIMS BY THE DESCRIPTION AND CLARITY

7.   Criteria often reviewed before prior art searches will be covered. Basic concepts relating to claims such as independent and dependent claims will also be explained here, while noting that there are discrepancies across jurisdictions in definitions of terms and requirements relating to claims.

(6)   PATENTABLE SUBJECT MATTER AND INDUSTRIAL APPLICABILITY

8.   Considering the interconnection between the two criteria under some national practices, they will be covered together in this module. Subject matters commonly not considered patentable will be listed but with a reminder that there are different laws and practices.

(7)   PRIOR ART SEARCH

9.   The concept of prior art search, a list of most commonly used search tools, pros and cons of classification search and keyword search, as well as where to search for Non-Patent Literature will be covered.

(8)   NOVELTY AND INVENTIVE STEP

10.   The idea of "a person skilled in the art" and the basics of comparing between prior art and the present invention will be explained. Basic concepts associated with the inventive step will be covered. Detailed more jurisdiction-specific information would be covered in more advanced courses than this introductory course.

(9)   UNITY OF INVENTION

11.   The basic concept of the unity of invention and how lack of it is handled in different jurisdictions, e.g. with divisional applications, rejection, or search on selected claims. The information in the PCT International Search and Preliminary Examination Guidelines will be utilized.

(10)   WORK SHARING

12.   This module will explain how to find and use patent families and work products of other Offices. It will also cover how some common actions during prosecution are called differently in each jurisdiction.

(11)   PCT AND PATENT EXAMINATION

13.   The basic concept of the PCT System will be revisited and it will be covered how to read and use PCT International Search Reports and International Preliminary Reports on Patentability.

(12)   FIRST OFFICE ACTION

14.   This module will cover what are typically included in the first Office Action letters and what the examiners should consider in order to make clear and effective communications to the applicants.

(13)   PROCEDURES AFTER THE FIRST OFFICE ACTION AND AMENDMENT REQUIREMENTS

15.   It will be covered what a patent examiner can expect from the applicant after the first Office Action and what kind of follow-up action(s) should be made, as well as what amendment requirements exist across different jurisdictions.

(14)   MISCELLANEOUS TOPICS

16.   Brief introductions will be provided on post-grant/rejection procedures, other kinds of protection such as utility models, unique features of claims in some technical fields, etc. This module will guide the users to find more advanced materials, when necessary, rather than giving technical details on the subjects.

(15)   CLOSING

17.   This last module will refresh the participants of the core messages from the previous modules and provide a wrap-up. It will also provide a list of further training programs provided by the Offices and WIPO.

[End of Annex and of document]