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**PATENT COOPERATION TREATY (PCT)
WORKING GROUP**

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ENHANCING THE VALUE OF INTERNATIONAL SEARCH AND
PRELIMINARY EXAMINATION UNDER THE PCT:

MAKING INTERNATIONAL PRELIMINARY EXAMINATION MORE USEFUL

Document prepared by the International Bureau

SUMMARY

1. The international phase of the PCT would be most beneficial to elected Offices¹ if it resulted in the international application entering the national phase in a form which is ready for grant. Where this is not possible, the international preliminary report on patentability should be as relevant as possible to determining what defects may remain which are relevant to any particular national law.

¹ This document generally refers to elected Offices since most of the analysis is made in respect of international preliminary examination under Chapter II. Nevertheless, it should be recalled that many points are equally relevant to designated Offices in view of equivalent provisions in written opinions of the International Searching Authority where international preliminary examination is not demanded.

2. The Working Group is invited to consider whether it would be useful to take steps to make it more attractive to applicants to use Chapter II to seek to enter the national phase with a “clean” international preliminary report on patentability, and for international reports to be more relevant to assisting elected Offices to determine whether the requirements of their national laws have been met.

BACKGROUND

3. This document is based on document PCT/MIA/16/3, which was presented to the 16th session of the Meeting of International Authorities, held in Seoul from March 16 to 18, 2009. The text in this document has been updated to take into account some of the comments made in that meeting.

Previous Discussions

4. At its first session, held in Geneva May 26 to 30, 2008, the PCT Working Group discussed the document “Enhancing the Value of International Search and Preliminary Examination under the PCT” (PCT/WG/1/3). Several sections of the annex to that paper addressed questions relating to either:

(i) whether the content of international preliminary reports on patentability needed to be improved in order to make them more relevant to designated and elected Offices (notably “Content of Written Opinions and International Preliminary Reports on Patentability” at paragraphs 28 to 31); or

(ii) whether actions could be taken to improve the use of Chapter II such that the international application was likely to result in the application being immediately in order for grant on entry into the national phase, avoiding the same defects needing to be addressed several times over in various national phases (notably “National Phase Entry in Acceptable Form” at paragraphs 41 to 49).

5. The results of those discussions are outlined in paragraphs 39 to 43 and 49 to 53 of document PCT/WG/1/16 as follows:

“Content of Written Opinions and International Preliminary Reports on Patentability (paragraphs 28 to 31 of annex to document PCT/WG/1/3)”

“39. Delegations representing a range of different designated Offices stated that international preliminary reports on patentability were very useful to assist examination in the national phase, provided that the reports were sufficiently complete and well-argued; such reports could sometimes be used directly as a first Office action in the national phase.

“40. One delegation commented that it was essential for International Authorities to make comments on major issues of clarity and support in order to properly address matters of novelty and inventive step, though it considered that minor matters could reasonably be left to the national phase.

“41. Several delegations expressed their concern about a lack of consistency in the depth and coverage of international reports from different Authorities. They expressed the view that the reports could be more effectively used if they were more consistent.

Furthermore, one delegation considered that, to the extent that the coverage of certain subjects was a matter of discretion for the International Authority concerned, it would be useful to make it clear whether the absence of a comment reflected that there was no objection or that the subject had not been considered.

“42. One delegation considered that the current structure of the forms for written opinions and international preliminary reports on patentability was too rigid and dependent on the marking of check-boxes to allow examiners to address all issues efficiently.

“43. Following concerns expressed by one delegation that designated Offices were not able to understand reports in all the languages in which they were established, the Secretariat pointed out that translations into English were prepared for all reports which were not established in that language; if those translations were not being received by any Office, the International Bureau would assist in ensuring their communication to the Office concerned.

...

“National Phase Entry in Acceptable Form (paragraphs 41 to 49 of the annex to document PCT/WG/1/3)

“49. All delegations which took the floor on this matter expressed the view that no benefits would be gained by permitting amendment of the description and the drawings during the international phase without demanding international preliminary examination. In this context, it was noted that the informal procedure followed at present, under which the International Bureau made available to designated Offices any comments submitted by the applicant on the international search report or the written opinion by the International Searching Authority, appeared to be sufficient for the applicant to express disagreement, if desired, or otherwise respond to the report or opinion prior to the start of national processing. It was also noted that the applicant had the right, under Article 28, to amend the entire application before any designated Office upon national phase entry. While some delegations and one representative of users believed that a centralized procedure would sometimes be useful, under which the applicant would be given the opportunity to amend the application under Article 28 once with effect for several or all designated Offices, in a similar manner to the present procedure in respect of Article 19 amendments of the claims, other delegations considered that such a procedure would have little benefit.

“50. In order to improve the usefulness of international search reports for the purposes of Chapter II proceedings and national phase processing, one representative of users suggested that it might be reasonable to expect the applicant to provide a response before the next stage of processing. For example, the applicant could be required, when filing a demand for international preliminary examination or a request for supplementary international search, or when entering the national phase, to submit to the International Preliminary Examining Authority, the Authority carrying out the supplementary search or the designated Office, respectively, a substantive response to any objections raised in the written opinion established during the main search, the supplementary search report or in the international preliminary report on patentability. If such a requirement existed, examiners might be inclined to take greater care in the establishment of opinions and reports.

“51. It was noted that the use of Chapter II had declined dramatically since the introduction, in 2004, of the written opinion by the International Searching Authority and the change in the national phase entry time limit under Article 22 from 20 to 30 months from the priority date. It was recognized that applicants in the past used Chapter II mainly to “buy time” rather than to amend the application with a view to bringing it in order for national phase entry. However, several delegations and one representative of users noted that applicants who, under the present system, were still interested in overcoming deficiencies in the international phase were deterred from proceeding into Chapter II by the practices of some International Preliminary Examining Authorities, which gave the applicant very little opportunity for a real dialogue with the examiner. In the view of one representative of users, this resulted in a generally unsatisfactory “price/usefulness ratio” for services offered under Chapter II. In addition, the representative expressed the view that, from the applicant’s perspective, it made little sense to incur additional expenses for the Chapter II procedure if designated/elected Offices during national phase processing generally paid little attention to the reports established during the international phase.

“52. The Working Group agreed that, in view of the decline in the use of Chapter II and the corresponding reduction in workload for International Preliminary Examining Authorities, it may be appropriate to review the general approach taken in Chapter II processing, with a view to considering how to encourage applicants to overcome deficiencies in the application during the international phase rather than only after national phase entry, for example, by giving more opportunity for dialogue with the examiner, or by encouraging increased collaboration between the applicant and the Authority along the lines of the suggestion mentioned in paragraph 50, above.

“53. The Working Group invited the International Bureau to further study the issue with a view to submitting more specific recommendations to the Working Group at its next session.”

6. The discussions in the 16th session of the Meeting of International Authorities are outlined in paragraphs 42 to 49 of document PCT/MIA/16/15, as follows:

“Enhancing the Value of International Search and Preliminary Examination Under the PCT: Making International Preliminary Examination More Useful

“42. Discussions were based on document PCT/MIA/16/3.

“43. The Meeting expressed its general support for the proposed ways in which international preliminary examination might be made more useful as set out in paragraphs 6 to 20 of document PCT/MIA/16/3, subject to the comments and suggestions appearing in the following paragraphs.

“44. One Authority suggested that the focus on citation of relevant documents (see paragraph 11 of document PCT/MIA/16/3) should be restricted to documents relevant to the question of novelty and should not encompass citations relevant to the question of inventive step.

“45. Several Authorities, commenting on the proposed possible modification of the PCT International Search and Preliminary Examination Guidelines set out in paragraph 12 of document PCT/MIA/16/3, stated that objections, especially those relating to inventive step, should in general be maintained in the case of doubt, but

raised concerns with regard to the statement that objections “in fields where it is known that there are significant differences in national laws, should be maintained in a final report in the event of doubt, even if the examiner would drop them in a national report”. It was noted in this connection that such an approach would potentially require detailed knowledge by the examiner of the national laws of all Contracting States, that the examiner would in some cases raise objections in the international report that would later be dropped by the same Office in the national phase, and that there were differences in practice within the same Office acting as both the International Authority and a designated Office in respect of the same international application, which would result in the need for applicants to amend the international application upon national phase entry before that Office. Such factors would not help in building wider trust in international reports if the suggested approach were to be implemented.

“46. One Authority, commenting on the issue of the significance of secret prior art to be explained in written opinions and reports set out in paragraph 13 of document PCT/MIA/16/3, noted that any such explanations would be likely to be of small benefit to applicants in view of different definitions as to what constituted prior art under the various applicable national laws of Contracting States.

“47. One Authority, commenting on the proposal that the questions of clarity and support should be commented on in written opinions and international preliminary examination reports (see paragraph 14 of document PCT/MIA/16/3), suggested that, in view of the vastly different practices of Offices on those issues, a thorough analysis should first be carried out on how to overcome those differences in practice before encouraging Authorities, or before making it mandatory for Authorities, to comment on those issues.

“48. One Authority expressed its general concern about the fact that certain of the proposals set out in document PCT/MIA/16/3 would in fact constitute a reversal of some of the positive effects which had been achieved when Member States had agreed, as part of PCT reform, to modify the legal framework to streamline Chapter I and Chapter II procedures. It furthermore stated that, in its view, it was not necessary for an International Preliminary Examining Authority to comment on possible formality defects in international applications, as proposed in paragraph 14 of document PCT/MIA/16/3, as this matter properly lay within the domain of receiving Offices.

“49. One Authority stated that, while it generally supported the proposal, set out in paragraph 16 of document PCT/MIA/16/3, to provide at least one written opinion by the International Preliminary Examining Authority during the Chapter II procedure before a negative final report is established, in addition to that which had previously been drawn up by the International Searching Authority, and while it was considering changing its current practice to provide for such a written opinion in all cases, it considered it to be sufficient if such a practice were implemented by Authorities on a voluntary basis without being obliged to do so. That Authority further stated that it did not support the proposal, set out in paragraph 16 of document PCT/MIA/16/3, to enable applicants to request additional searching following amendment at the time of filing the demand to overcome defects which had prevented a full search from being carried out, noting that such an additional search would only contribute to the overall complexity of the system.”

Essential and Optional Parts of International Preliminary Examination

7. The main features of the process of international preliminary examination and the content of the international preliminary examination report (henceforth “final report”) are set out in PCT Articles 34 and 35 and Rules 66 and 70. Some of the features which may be of particular relevance are as follows (some details have been omitted to avoid complications which are not relevant to most cases):

(a) the applicant has a right to amend the application before the international preliminary examination has begun, or else in response to a written opinion of the International Preliminary Examining Authority (Article 34(2)(b); Rules 66.1 and 66.4*bis*);

(b) at least one written opinion must be sent unless the International Preliminary Examining Authority intends to issue a “clean” final report (Article 34(2)(c)), but in many cases, the written opinion of the International Searching Authority may be considered as being a written opinion of the International Preliminary Examining Authority (Rule 66.1*bis*), in which case it is a matter for the discretion of the examiner whether any further opinion is sent before a final report is established.

(c) written opinions and final reports *must* comment on:

(i) novelty, inventive step and industrial applicability (Rules 66.2(a)(ii) and 70.6), including comments on the validity of priority claims to the extent that this affects one of these matters;

(ii) certain disclosures which do not fall within the definition of prior art for the purposes of Articles 33(2) and (3), but which might still be of relevance under some national laws (Rules 64.3, 70.9 and 70.10);

(iii) any reasons for which one or more priority claims are treated as not having been made for the purpose of the international preliminary examination (Rules 66.7 and 70.2(b));

(iv) any lack of unity of invention (Rules 68 and 70.13);

(v) any amendment which is considered to go beyond the disclosure of the international application as filed (Rules 66.1(e) and 70.2(d)); and

(vi) any claims which have not been the subject of the international preliminary examination for one or more of a number of possible reasons (Article 34(4); Rules 66.2(a)(i), (vi) and (vii), 70.2(d), 70.12(iii) and 70.13).

(d) written opinions and final reports *may* comment on:

(i) defects in form or content (Rules 66.2(a)(iii) and 70.12(i) – in principle, this is mandatory to the extent that the examiner notices the defect, but in practice examiners do not check these details unless, for example, poor drawings affect clarity);

(ii) the clarity of the claims, description and drawings, or whether the claims are fully supported by the description (Rule 66.2(a)(v) and 70.12(ii)).

(e) written opinions and final reports *must not* comment on whether the claimed invention is, or is not, patentable under any particular national law (Article 35(2)).

MATTERS FOR CONSIDERATION

8. Measures to make international preliminary examination more useful to applicants, elected Offices and third parties will generally fall into two interlinked categories:

(a) *Content of the report*: measures to make the reports more relevant and useful to assisting the assessment of patentability for the national phase (both by applicants and by elected Offices);

(b) *Effectiveness of the process*: measures (potentially in the national phase as well as the international phase) to increase the incentive and opportunity for defects in the international application to be eliminated in the international phase so that there is less examination work remaining to conduct in each elected Office in the national phase.

9. The quality of the work performed by the International Searching Authority and the quality management systems aimed at ensuring the necessary quality are, of course, very important to both aspects, but are not specifically addressed in this paper: the issues are addressed on the assumption that the contents of the reports meet appropriate levels of quality for at least those matters which are indicated in paragraph 7(c), above, as being essential and that the international preliminary examination carried out at least in minimum compliance with the process requirements of the Rules.

Content of the Report

10. The fundamental questions which must be addressed in terms of content of the reports are:

(a) are the standards against which the international application is assessed appropriate to the needs of applicants and elected Offices for assisting the determination of patentability in all Contracting States?

(b) would it be beneficial to conduct a more complete examination in the international phase, including greater consideration of the matters which are currently optional?

11. In assessing these questions, it must be considered whether additional work – or changes to work – in the international phase can result in greater certainty and reduction of work overall by both applicants and elected Offices as a whole. If some matters do not currently seem worth pursuing in the international phase because of significant differences between requirements in different Contracting States, it should be considered whether they fall into the category of procedural matters where closer consistency might be sought without addressing matters of substantive patent law harmonization.

12. The intention of the definition of prior art under the PCT (including the matter in Rules 33.2, 33.3, 64.2 and 64.3, which is not strictly prior art according to the definition for the international phase but must still be cited) is that the international reports should draw attention to every document which could be relevant to novelty and inventive step according to the national laws of any Contracting State. However, it should be considered whether any prior art is missing and whether the information provided about some disclosures is sufficient to assist national processing.

– Aside from the differences in determination of novelty and inventive step, considered below, are there any forms of relevant disclosure for national laws of Contracting States which do not fit into one of the categories listed in Rules 33 and 64?

13. Apart from the matters of relevant dates and types of relevant disclosures, the details of how novelty and inventive step are determined are not closely defined and will, for the foreseeable future, almost inevitably be heavily influenced by the national laws of the Office which acts as International Authority. In a large majority of cases, it is believed that the various different processes for assessing these requirements lead to almost identical results in practice save for certain particular fields of technology. Nevertheless, it is necessary to consider how best to deal with cases on the borderlines.

– Should the PCT International Search and Preliminary Examination Guidelines (“the Guidelines”) be modified to indicate that objections (especially those relating to inventive step, or in other matters where it is known that there are significant differences in national laws) should be maintained in a final report in the event of doubt, even if the examiner would drop them in a report established under the laws relating to the national system operated in his Office? This would ensure that the potential question was brought to the attention of all elected Offices, but could result in a further step in the national phase before the Office which acted as International Preliminary Examining Authority which could otherwise have been avoided. In any case, it must be clear that such a guideline should not be used simply as a reason to avoid reaching a conclusion on difficult cases. Alternatively, where an objection to lack of inventive was raised in an initial written opinion, but subsequently dropped as a result of arguments by the applicant, should the reason for which the originally cited document is not, after all, considered to be relevant to inventive step always be indicated in the final report?

14. Furthermore, it should be noted that oral disclosures and “secret prior art” disclosures are only indicated as simple references with an indication, where appropriate, of whether the priority claims appear to be valid. In some cases, it might therefore not be clear what the relevance of these documents is considered to be.

– Should the significance of oral disclosures and “secret prior art” be explained in a similar way to the items which are properly considered prior art for the purposes of the international phase? Is there any benefit to maintaining a distinction between these categories of disclosure, or should some or all of this material be incorporated into the formal definition of prior art, subject simply to a requirement that the special cases be appropriately indicated so that they can be ignored in States where they are not relevant (similar to the approach which is used on the international search report, applying category indicators “E”, “P”, “O”, etc. to distinguish such citations from normal relevant publications)?

15. As regards those matters which are indicated as being optional in paragraph 7(d), above, it was suggested in the first session of the PCT Working Group that it would be useful for these to be included to a greater extent, and that it was a problem that it was not clear whether the absence of such comments meant that the examiner considered that there were no relevant defects, or that the matter had simply not been considered (see paragraphs 40 and 41 of document PCT/WG/1/16, reproduced above). Such matters seem to fall into several general categories:

– Should formalities defects be highlighted? It should be recalled that the requirements of Rule 11 are only enforced in the international phase by the receiving Office and International Bureau to the extent necessary for the purpose of reasonably uniform international publication (or reproduction, depending on which particular documents are concerned). Similarly, few, if any, Contracting States enforce all of these requirements strictly. Consequently, it would probably be a waste of examiner time to note such defects unless they have a real effect on the ease of reading or understanding the specification (probably most commonly in the case of poor quality drawings or drawings which include too much text). In the view of the International Bureau, such matters are probably best left as being optional within the Rules, but might benefit from guidance in the International Search and Preliminary Examination Guidelines as to matters which are of special interest and which may be worth highlighting.

– Should clarity and support be commented on? *Prima facie*, this will frequently be critical information to the extent that there is real doubt about the scope of the claims since it will strongly affect the question of how novelty and inventive step have been assessed and, consequently, how the international search was conducted. In cases where there are minor issues which do not leave any real uncertainty, it may be best to comment to the same extent as would be done in the national process in the Office: this will allow the report to be used by the Authority directly in the national phase and may be, at least for the interim, as good a guide to the extent to which comments might be useful for other Offices as any more specific guidelines which could be agreed in the short term.

Effectiveness of the Process

16. In view of the common belief that the differences in claim interpretation between different States leads to a need to adopt significantly different drafting approaches for national phases, it might have been expected that there would be little incentive for applicants to amend their claims in the international phase to a “final” condition. However, the experience of the Patent Prosecution Highway shows that this need not necessarily be the case. Furthermore, as noted in paragraph 51 of document PCT/WG/1/16, reproduced above, as well as in other documents relating to the Working Group on Reform of the PCT, some representatives of users indicate that they would find international preliminary examination useful if it provided a sufficient opportunity for dialogue with the examiner before the final report was established. On the other hand, as pointed out in paragraph 50 of document PCT/WG/1/16, likewise reproduced above, effective dialogue may mean that the applicant has responsibilities as well as the Authority in ensuring that alleged defects can be reassessed efficiently.

– Should Rule 66 be amended to guarantee the applicant a right to at least one written opinion established by the International Preliminary Examining Authority in addition to that of the International Searching Authority before a “negative” final report is drawn up? If so, should this right be limited to the case where the applicant has answered the matters raised in the written opinion of the International Searching Authority, either by amendment of the international application or by a reasoned response to the issues raised (such amendment or response preferably to be provided at the time of making the demand, but at least before international preliminary examination begins)?

17. It may also be possible to offer benefits by offering additional information on prior art to be found during the international phase. Apart from the existing possibilities of supplementary search being performed by another International Authority at an early stage, or by the International Preliminary Examining Authority (where it is a different Office to the International Searching Authority) at the same time as international preliminary examination, this could take the form of additional searching by the examiner or the availability of information from third parties. It should be noted that Rule 70.7 already *permits* the examiner to cite prior art which was not included in the international search report, but does not *require* the examiner to conduct any search for such prior art.

– Should a “top-up” search to find “secret prior art” which has been published since the main international search was conducted be made a mandatory part of international preliminary examination?

– Should there be any other opportunity to request additional searching following amendment at the time of filing the demand to overcome defects which had prevented a full international search being carried out by the International Preliminary Examining Authority?

– Should the PCT offer a system allowing third parties to submit relevant prior art following international publication, which would then be made available to the International Preliminary Examining Authority (as well as to designated and elected Offices)? If so, noting that many third parties will not be skilled in interpretation of claims or in assessing the relevance of disclosures to novelty and inventive step, what measures might be taken to reduce the risk of examiners being sent long lists of material which prove to be irrelevant? Conversely, noting that in some national systems third party observation systems exist but are only occasionally used, what measures can be taken to ensure that it is attractive to third parties to submit prior art?

Developing a Rounded Package

18. Some of the matters which are discussed above could be most effective in the context of a major review of the timing of international search and preliminary examination to ensure that there was sufficient time for the work to be conducted effectively and that any particular piece of work is done at the best time. Amongst the matters to be considered will be the time limits for establishing the international search report, for making the demand for international preliminary examination, for establishing the preliminary examination reports and for entering the national phase.

19. Against pure issues of efficiency of search and examination, it will also be important to consider the needs of applicants, third parties and designated and elected Offices in terms of when certain information becomes available to them and in terms of avoiding unnecessary delays (and the resulting uncertainty) to national phase processing. Perhaps most significantly, any proposal to extend time limit in Article 39(1) must avoid returning to a situation where Chapter II is used solely for the purpose of delaying national processing and must deliver significantly greater benefits in terms of the international application entering the national phase in a state which is more likely to be immediately in order for grant.

20. The International Bureau intends to consider such matters in the light of comments relating to the various possible ways in which the international process could be improved in order to propose a fully rounded package.

21. It should be remembered that for real benefits to be felt from the international preliminary examination, it will be important that applicants both choose to use it and use it effectively. Some aspects of applicant behavior can be controlled through the legal framework, but the most effective results will be provided by ensuring that there is an incentive for them to work cooperatively and to eliminate defects, as far as possible, before national phase processing begins. It would be desirable to discuss what measures might be taken by national Offices outside of the international legal framework to encourage applicants to overcome defects in the international phase and to enter the national phase with a “clean” international preliminary examination report. Such measures might include fee benefits, simplifications and acceleration of processing (similar to the Patent Prosecution Highway) or any other means which could be devised. The result of such measures being applied in a sufficiently wide range of States would be likely to result in a much larger change in applicant behavior than could be achieved through improvements to the international phase alone.

22. The Working Group is invited to comment on ways in which international preliminary examination might be made more useful, including, but not limited to, the matters referred to in paragraphs 8 to 21, and to give preliminary views on what features might form part of an appropriate package of measures.

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