

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Seventh (20th Ordinary) Session
Geneva, October 5 to 14, 2015

APPOINTMENT OF THE VISEGRAD PATENT INSTITUTE AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT - UPDATE ON RECENT DEVELOPMENTS

Document prepared by the International Bureau

1. As foreshadowed in paragraph 9 of document PCT/A/47/6, the Delegation of Hungary on behalf of the States signatory to the Agreement on the Visegrad Patent Institute has submitted an update on recent developments concerning the request of the Appointment of the Visegrad Patent Institute as an International Searching and Preliminary Examining Authority under the PCT. This update is set out in the Annex to this document.

2. *The Assembly of the PCT Union is invited to take note of the "Update on Recent Developments" set out in the Annex to document PCT/A/47/6 Add.*

[Annex follows]

APPOINTMENT OF THE VISEGRAD PATENT INSTITUTE
AS AN INTERNATIONAL SEARCHING
AND PRELIMINARY EXAMINING AUTHORITY
UNDER THE PCT – UPDATE ON RECENT DEVELOPMENTS

INTRODUCTION

1. At the twenty-eighth session of the PCT Committee for Technical Cooperation (PCT/CTC), held from May 26 to 29, 2015 in Geneva, the PCT/CTC unanimously agreed to recommend to the Assembly of the PCT Union that the Visegrad Patent Institute (VPI) be appointed as an International Searching Authority (ISA) and an International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT).
2. This document aims to give an update on developments since the twenty-eighth session of the PCT/CTC in accordance with paragraph 9 of document PCT/A/47/6.

RATIFICATION OF THE VPI AGREEMENT

3. As explained in paragraph 30 of Annex II to document PCT/CTC/28/2, the Agreement on the Visegrad Patent Institute (VPI Agreement) was signed in Bratislava on February 26, 2015, by the Heads of the V4 national IP Offices as the duly authorized representatives of their governments. The VPI Agreement is subject to ratification in accordance with the respective constitutional requirements of the Contracting States (parliamentary approval is needed in all the four countries). Under Article 18(1) of the VPI Agreement, that Agreement shall enter into force two months after the Czech Republic, Hungary, the Republic of Poland and the Slovak Republic have all deposited their instruments of ratification.
4. Hungary and the Slovak Republic have already ratified the VPI Agreement.
5. In Hungary, Act LXIX of 2015 on the Promulgation of the Agreement on the Visegrad Patent Institute was published in the Hungarian Official Gazette (No 78) on June 5, 2015 (within the Hungarian legal system this kind of Act also constitutes the Parliament's consent to be bound by the international treaty in question, and an authorization for the head of state to issue the ratification instrument). The Act entered into force on the following day. Mr. János Áder, the President of the Republic signed the instrument of ratification on June 3, 2015, and it was deposited with the Hungarian Government as Depositary later in June 2015.
6. In the Slovak Republic, the VPI Agreement was approved by the National Council on June 30, 2015 (Resolution No 1870). Mr. Andrej Kiska, the President of the Slovak Republic signed the instrument of ratification on July 22, 2015. The instrument was deposited with the Hungarian Government as Depositary in the same month. In accordance with the respective constitutional requirements, the promulgation of the VPI Agreement will be published in the Collection of Laws of the Slovak Republic after the notification from the Depositary that it has received the last instrument of ratification necessary for the entry into force of the Agreement.
7. In the Republic of Poland, the Act authorizing the President of the Republic to ratify the VPI Agreement has already been approved by both Chambers of the Parliament and signed by Mr. Andrzej Duda, the President of the Republic of Poland. The Act was published on September 8, 2015 in the Journal of Laws, under item 1325. Following a two-week *vacatio legis*, the instrument of ratification will be issued by the President of the Republic and will then be deposited with the Hungarian Government as Depositary without delay.
8. In the Czech Republic, the parliamentary process is well under way, with a few positive intermediary decisions already taken, and is scheduled to be completed by the end of September 2015. The Senate has already given its approval for the ratification (Senate Resolution No 194 of July 23, 2015), and the second reading in the Chamber of Deputies is the last step of the ratification process in the Parliament. The VPI Agreement will be on the agenda

of the Chamber of Deputies on September 16, 2015. This means that the President of the Republic will be in a position to sign the instrument of ratification well before the forty-seventh session of the Assembly of the PCT Union.

9. Based on the progress made in the national ratification processes, it can be safely expected that the VPI Agreement will have been ratified by all the four contracting states and the relevant instruments will have been deposited by the date of the forty-seventh session of the Assembly of the PCT Union, while it will enter into force only a number of weeks after that date pursuant to Article 18(1) of the VPI Agreement (i.e. two months after the deposit of the fourth instrument of ratification). This does not hinder the Assembly from taking a positive decision on the VPI's appointment, since the Assembly is being invited to appoint the VPI as an International Authority only with effect from the entry into force of the Agreement to be signed between the VPI and the International Bureau of WIPO (see paragraph 10(iii) in document PCT/A/47/6). The latter agreement would be signed once the VPI Agreement has entered into force and the VPI has been formally established. This will enable the VPI to become operational on July 1, 2016, as planned.

10. The representatives of the V4 countries are ready to give an oral update on the state of play of the ratification processes to the Assembly at its forty-seventh session.

CONSISTENCY AND SMOOTH WORKFLOW AT THE VPI

11. At the twenty-eighth session of the PCT/CTC, besides the resounding support for the appointment of the VPI as an ISA/IPEA under the PCT, references were made to the importance of developing appropriate mechanisms to ensure consistency of approach amongst the four Offices, as well as procedures between the four Offices, in order to ensure smooth work flow and smooth production of consistent work products (see paragraph 15 of document PCT/CTC/28/4).

12. Following the advice from the PCT/CTC, the national Offices of the Visegrad cooperation (V4) have continued and even stepped up their efforts to establish a working environment ensuring consistency and smooth workflow at the VPI. Various work-streams have been launched to that effect and have already delivered a number of tangible results laying the groundwork for the VPI's efficient and high-quality operation as an International Authority.

13. Soon after the twenty-eighth session of the PCT/CTC, the V4 Offices completed, and reached preliminary agreement on, the drafts of the Implementing Regulations and the Financial Regulations to the VPI Agreement. This was required not only for the purposes of national ratification procedures but also with a view to establishing a solid regulatory framework for further work on the development of the work processes, QMS and IT tools at the VPI. The preliminary agreement on the Implementing Regulations and the Financial Regulations was endorsed by the Heads of the V4 Offices at their meeting held in Martin, the Slovak Republic on June 3, 2015. The Implementing Regulations cover, among other things, the following issues: relationship with the PCT, liability, various aspects of the work performed under the PCT (e.g. competence of the VPI, languages, tasks of the VPI as an ISA or IPEA, international-type searches, supplementary international search), the possibility of contract work, administrative provisions on the quality management system, payments, communications and file administration. The schedule of fees is attached as an annex to the Implementing Regulations. The Financial Regulations contain provisions on, *inter alia*, the establishment and implementation of the budget, auditing, reimbursements to the participating national Offices, contributions to be made by the Contracting States, and the distribution of any surplus. It is to be noted that, under Article 12(1) of the VPI Agreement, the Administrative Board of the VPI shall be competent to adopt formally the Implementing Regulations and the Financial Regulations once the Agreement has entered into force.

14. After having clarified the essential elements of the joint work, the participating national Offices of the VPI have set up two working groups, in addition to the already existing main committee of experts in charge of establishing and “building up” the VPI.

15. The Technical Experts’ Working Group of the VPI consists mainly of patent experts and/or examiners of the participating national Offices. Its main task is to identify the differences in, and harmonize, the search and examination practices of the participating national Offices. The Technical Experts’ Working Group held its first meeting in Banská Bystrica, the Slovak Republic on June 9, 2015. It made an overview of the essential steps of the search and examination processes and compared them to those set out in the PCT International Search and Preliminary Examination Guidelines (PCT/GL/ISPE). It was established that the VPI’s participating national Offices are bound by the same international and European legal framework, and thus there is nothing that would prevent the VPI from acting in a fully consistent manner. Nevertheless, the working group agreed that there were still a few technical aspects requiring further discussion.

16. The Technical Experts’ Working Group held its second meeting in Warsaw, Poland on September 1 and 2, 2015. Experts from the Israel Patent Office also attended the meeting and shared their experience as an existing PCT ISA/IPEA. The aim of the meeting was to finalize the essential elements of the VPI’s working model, including the workflow between the participating national Offices and the VPI’s Secretariat, and to further discuss open questions such as the flowcharts relating to the workflow and the PCT processes.

17. At their meeting held in Martin, the Slovak Republic on June 3, 2015, the Heads of the V4 Offices decided to establish the VPI’s IT and Quality Management Working Group, comprising IT, quality management and patent experts. Its task is to deal with issues arising with regard to the setting up of the VPI’s quality management system and to identify IT-related requirements and solutions that are necessary for ensuring a smooth workflow. The working group held its first meeting in Budapest, Hungary on July 22, 2015. All the essential elements of receiving and handling international applications and of the communication between the VPI’s participating national Offices were agreed upon. Requirements of the VPI’s common administration system were identified and prioritized. An agreement was also reached on possible IT solutions for the first, initial period of the VPI’s operation. The basic features of the VPI’s website were defined (e.g. responsibility of maintenance, language issues, main elements and structure of content). Following the first meeting, several working documents have been drafted which serve as a basis for the Working Group’s next meeting to be held on September 23, 2015, in Prague, the Czech Republic.

18. Between March and September, 2015, representatives of the Israel Patent Office, the Japan Patent Office, the Korean Intellectual Property Office and the Nordic Patent Institute (all are existing International Authorities under the PCT) visited the VPI’s participating national Offices to share their experience in the field of PCT-related work, IT matters and quality management. These visits have certainly contributed to advancing the activities of both VPI working groups.

19. Although there are still a few pending issues, the progress already made in these working groups is remarkable. Progress in these matters is also indispensable for developing further the VPI’s planned quality management system.

QUALITY MANAGEMENT AND IT ISSUES

20. Paragraph (d) of the Understanding on the Procedures for Appointment of International Authorities, adopted by the PCT Union Assembly at its forty-sixth session in September 2014 (see document PCT/A/46/6, paragraph 25, hereinafter referred to as the “PCT Understanding of 2014”), contains clarification with regard to the requirement that the national Office or intergovernmental organization seeking appointment must have in place a quality management system and internal review arrangements in accordance with the common rules of international search. It states that where such system is not yet in place at the time of the appointment by

the Assembly, it shall be sufficient that such system is fully planned and, preferably, that similar systems are already operational in respect of national search and examination work to demonstrate the appropriate experience. In compliance with this requirement, paragraphs 50 to 60 of Annex II to document PCT/CTC/28/2 and Appendix I to that Annex already contain a detailed description of the quality management system and the internal review arrangements of the VPI and the participating Offices¹ as well as a preliminary report on the VPI's quality framework.

21. The VPI's Quality Management System (QMS) will be based on the systems of the participating national Offices and extended in order to fully cover the PCT procedures of the international phase as well as to comply with the PCT/GL/ISPE, and especially with Chapter 21 thereof.

Leadership and policy – the VPI's Quality Manual

22. Since the establishment of the VPI's IT and Quality Management Working Group, intensive preparatory work has been carried out aiming at the establishment of the VPI's QMS. As one of the main results, a draft Quality Manual of the VPI has already been drawn up. It describes the essential components of the VPI's QMS and will be made available to the public. Moreover, the working group has also decided that all policies, processes and procedures will be fully documented at the VPI. The VPI's QMS will be compatible with the requirements of Chapter 21 of the PCT/GL/ISPE and will ensure that the VPI's work is performed in a uniform manner and at a consistently high level of quality.

Resources

23. The VPI's compliance with ISA and IPEA requirements with respect to examiners/human resources is described in detail in paragraphs 41 to 43 of Annex II to document PCT/CTC/28/2 and in paragraphs 20 to 24 of Appendix I to that Annex. In this regard, as a result of further preparatory work undertaken by the participating Offices, both the language skills and the technical competence of patent examiners of the participating Offices of the VPI have already been mapped and a database has been set up on the patent examiners' technical competences and language skills. It can be established that all the relevant technical fields are fully covered by the participating Offices' examiners, which means that even in case of a higher number of incoming international applications the VPI will possess sufficient capacity for performing the work at a high level of quality.

Management of administrative workload

24. The administrative workload will be managed by the Director and the Secretariat of the VPI, and it will be distributed among the participating Offices following a work-sharing model developed by the Technical Experts' Working Group. The VPI will have in place appropriate, effective and harmonized control mechanisms in order to ensure the timely issuance of search and examination reports in accordance with the applicable quality standards. The participating Offices will be responsible for monitoring compliance with the harmonized standards and reporting thereon. Statistical performance reports will be prepared at regular intervals. Standardized tables have already been drafted to this end. As to some other results already achieved in this area, see paragraph 17 of this document.

¹ In this context, paragraph 58 of Annex II to document PCT/CTC/28/2 needs to be updated with the following information. The Patent Office of the Republic of Poland (PPO) was granted an ISO 9001:2009 certificate (identical with ISO 9001:2008) in July 2011, and it was in force for three years, until July 2014. Due to extensive work being carried out at that time in the PPO with the aim of improving and changing the internal procedures, the application for an extension of the ISO certification was then postponed till March 2015. A new Certificate of Quality Management System, namely PN-EN ISO 9001:2009, was granted to the PPO by the Polish Centre for Testing and Certification on March 24, 2015, which will be in force until March 23, 2016.

Quality assurance

25. The VPI's primary quality objective is to issue high-quality search and examination reports in a timely manner. The relevant search and examination processes have been identified and described in detail in the draft Quality Manual, which also serves as guidelines for search and examination. It will be made available to internal users as well as to external ones via the website of the VPI.

26. Specifying performance (P), time (T) and quality (Q) indicators is in progress. Self-assessment will be carried out by using checklist forms (a number of such forms have already been prepared). The latter are intended to be applied in harmonized procedures for verifying and accepting search and examination reports. Annual internal audits will be performed. These harmonized tools and procedures will ensure that search and examination of any application will lead to the same result irrespective of the participating Office performing the task.

Communication

27. The main lines of communication will be determined by the Director and the Secretariat working at the VPI's headquarters. Each participating Office of the VPI will appoint at least two contact persons responsible for internal communication. The participating national Office that produces the PCT work product in question will generally be responsible for communicating, on behalf of the VPI, with the applicant(s) and the International Bureau. Nevertheless, in certain cases, the VPI's Secretariat will be responsible for external communication. The VPI will organize user forums, where issues related to services provided by the VPI can be discussed. User satisfaction survey forms will be available both electronically (on the website of the VPI) and physically at the participating Offices. The draft Quality Manual sets out the VPI's quality objectives and the guidelines of search and examination. Once the Quality Manual has been finalized, it will be made available on the website of the VPI as well as at the customer services of the participating Offices, and it will be translated into the languages of the participating Offices.

Documentation

28. The VPI's QMS will be clearly described at different levels so that all processes, products and services can be monitored, controlled and checked for conformity. The relevant the documents will form part of the VPI's Quality Manual. The VPI will maintain records required by paragraph 21.23 of the PCT/GL/ISPE. International search and examination processes as well as processes of contractual international work to be performed by the VPI have been identified, and draft process flowcharts have already been developed. P, T and Q indicators have also been identified. Checklists have already been drafted, which will be filled in by the participating Offices upon completion of the product. These documents and the relevant procedural, technical and other aspects are currently under deliberation in the Technical Experts' Working Group and the IT and Quality Management Working Group, taking also account of the fact that the ISO systems of the participating national Offices already provide a solid basis in that regard.

Search process documentation

29. Examiners will make a record of their search processes and store them for the purposes of review and documentation. At its first meeting, the Technical Experts' Working Group decided that such documentation should only be used internally for the purposes of quality assurance. The Working Group also approved that checklists would be used and search strategies would be recorded. All the information relevant to the search process will be duly documented in full accordance with paragraph 21.24 of the PCT/GL/ISPE. With regard to the classes searched, the IPC classes will be indicated automatically, and CPC classes (where applicable), which help to refine the search in the relevant databases, will also be recorded.

Internal review

30. A review mechanism will be put in place for monitoring compliance with quality standards, under which objective and transparent reviews will be carried out. A joint internal review team within the VPI will also be established consisting of quality management experts of the participating Offices. Audits will be carried out on a regular basis through the use of checklists, and auditors will have to prepare written reports containing their observations. Besides internal audits, external reviews will take place at regular intervals. It is envisaged that internal and external audits will be undertaken once a year with the aim of assessing the conformity of the VPI's QMS with the applicable standards. It is intended that the first internal audit will be carried out six months after the VPI becomes operational, at the latest. In parallel with this, an independent external auditor will be selected for future external audits and ISO certification.

MISCELLANEOUS

31. As a further milestone, the VPI's logo was chosen by consensus at the high-level meeting of the V4 IP Offices, held in Prague, the Czech Republic on July 28, 2015. The logo will be instrumental in developing the VPI's own marketing image and raising awareness of its services among potential users. The logo is reproduced in Table 1.

Table 1 – The VPI's Logo



32. It is also to be noted that the Heads of the V4 IP Offices have requested the revision of WIPO Standard ST.3 in order to include the VPI in Annex A, Sections 1 and 2, and to assign "VP" as the two-letter code for the VPI.

[End of Annex and of document]