

## **Patent Cooperation Treaty (PCT) Working Group**

**Fourth Session  
June 6 to 10, 2011, Geneva**

### **Implementation of Recommendations to Improve the Functioning of the PCT**

*Document prepared by the International Bureau*

#### **SUMMARY**

1. The present document contains a report on the status of the implementation of each of the recommendations to improve the functioning of the PCT system endorsed by the PCT Working Group at its third session in June 2010.

#### **INTRODUCTION**

2. At its third session, held in Geneva from June 14 to 18, 2010, the PCT Working Group endorsed a series of recommendations to improve the functioning of the PCT system, based on a study prepared by the International Bureau (document PCT/WG/3/2) and related submissions from certain Member States (documents PCT/WG/3/5 and PCT/WG/3/13). The Working Group's discussions are outlined in the report of the session (document PCT/WG/3/14 Rev., paragraphs 14 to 137). At its Forty-First (24<sup>th</sup> Extraordinary) Session, held in Geneva from September 20 to 29, 2010, the PCT Assembly discussed and noted the Working Group's report (see paragraphs 5 to 28 of document PCT/A/41/4).
3. A consolidated list of all those recommendations is contained in the Annex to this document.

4. The recommendations endorsed by the PCT Working Group cover a variety of actions which should be undertaken by the International Bureau, applicants, Contracting States and national Offices (acting in both their national and international capacities) to make the PCT system more effective both for processing patent applications and for supporting technology transfer and technical assistance for developing countries.
5. As indicated during the discussions in the PCT Working Group, the International Bureau has undertaken to assist the implementation of recommendations endorsed by the Working Group by various means, as appropriate, such as the preparation of studies and proposals, or the sending of circulars or letters to the parties and bodies concerned (see document PCT/WG/3/14 Rev., paragraph 86).
6. The present document contains a report on the status of the implementation of each of the recommendations endorsed by the PCT Working Group. The report takes into account comments and suggestions received in reply to various Circulars (C.PCT 1287, 1288 and 1295) which the International Bureau has sent to Offices in their various PCT capacities (as a receiving Office, an International Searching and Preliminary Examining Authority and/or a designated and elected Office), to Geneva-based missions and foreign ministries of PCT Contracting States and of States that are invited to attend meetings of the PCT Working Group as observers, as well as to certain organizations that are invited to attend meetings of the PCT Working Group as observers.
7. Separate working documents have been prepared by the International Bureau to report in greater detail on the implementation of certain recommendations and to present the studies which the Working Group had requested the International Bureau to carry out. In such a case, the present document simply refers to the working document setting out the detailed report or study (see documents PCT/WG/4/4, 5, 6 and 7).

#### **REPORT ON THE IMPLEMENTATION OF RECOMMENDATIONS ENDORSED BY THE PCT WORKING GROUP**

8. Following the division into groups of issues and recommendations used in document PCT/WG/3/2, the present report on the implementation of those recommendations follows the same division into the following six groups:
  - (a) backlogs; improving quality of granted patents (see paragraphs 9 to 31, below);
  - (b) timeliness in the international phase (see paragraphs 32 to 42, below);
  - (c) quality of international search and preliminary examination (see paragraphs 43 to 57, below);
  - (d) incentives for applicants to use the system efficiently; skills and manpower shortages (see paragraphs 58 to 75, below);
  - (e) cost and other accessibility issues; consistency and availability of safeguards (see paragraphs 76 to 92, below);
  - (f) technical assistance; PCT information and technology transfer (see paragraphs 93 to 104, below).

### **Recommendations Related to Backlogs; Improving Quality Of Granted Patents**

9. The recommendations endorsed by the Working Group with regard to the issue of “backlogs; improving quality of granted patents” are set out in paragraphs 143, 146 and 149 of document PCT/WG/3/2 and in paragraph 92 of document PCT/WG/3/14 Rev. (the latter recommendation was treated as having been inserted into document PCT/WG/3/2 as paragraph 149*bis*). Comments and clarifications relating to those recommendations are set out in paragraphs 87 to 91 of the report of the third session of the Working Group (document PCT/WG/3/14 Rev.).
10. To take forward these recommendations the International Bureau invited Offices in their various PCT capacities, by way of a Circular (C. PCT 1295, dated March 8, 2011), to submit comments and responses to the issues raised in the Circular with regard to those recommendations. The International Bureau received a total of 16 responses to the Circular. The issues raised in the Circular were also discussed at the 18th session of the PCT Meeting of International Authorities, held March 15 to 18, 2011 in Moscow (see the report of the meeting, document PCT/MIA/18/16, reproduced in the Annex to document PCT/WG/4/2).

#### *Recommendations Set Out in Paragraph 143*

11. The Working Group at its third session endorsed the following recommendations in relation to international search reports (ISRs) and international preliminary reports on patentability (IPRPs) in order to make them more useful tools for assisting national Offices in addressing quality and backlog issues:

“143. *Recommendations* – Consequently, the following recommendations are made in relation to ISRs and IPRPs in order to make them more useful tools for assisting national Offices in addressing quality and backlog issues:

“(a) The Offices which act as International Authorities should continue to take steps to improve both the actual and perceived quality and consistency of the reports which they establish in accordance with the current Treaty, Regulations and Guidelines, to ensure that they provide content which designated and elected Offices *wish* to take into account. This issue is considered further in paragraphs 152 to 172 [of document PCT/WG/3/2], below.

“(b) The Offices which act as designated and elected Offices should continue to review the intended contents of ISRs and IPRPs and make any further recommendations for improvement within the limitations that the reports must be useful to all Contracting States and may not contain any comment on whether an invention is patentable or unpatentable according to any particular national law.

“(c) The IB and the Offices which act as International Authorities should review the proposals for changes to the details of what should be contained in ISRs and IPRPs and report to the next session of this Working Group, including any recommendations which may appear appropriate, for example for changes to the Rules or Administrative Instructions (including the Forms).

“(d) This exercise should in no way affect the right of designated and elected Offices to use the resulting ISRs and IPRPs in whatever way they see fit, in accordance with their national laws and policies.”

12. The responses to Circular C. PCT 1295 indicated that Offices found the intended contents of international reports do generally meet their needs. The most commonly expressed desire for improvement is to make it mandatory to include comments on at least significant issues of clarity (notably, where there is any doubt about the scope of the claims) and sufficiency of disclosure. One Office suggested that, insofar as these issues apply to specific claims, the written opinion form could include “Yes/No” boxes as is done for novelty, inventive step and industrial applicability.
13. With regard to the performance of International Authorities in meeting the requirements, most respondents indicated that they were satisfied in most cases, but that there was a need for improved quality control and greater consistency of approach and some respondents indicated a need for more detail on the scope of the search (see also paragraph 55, below). A number of Offices indicated that a change of approach in presenting the report might help. This might involve moving away from the current “box” format of report to a more linear form, merging or slightly modifying some of the boxes and/or using more standard clauses to guide examiners in presenting arguments consistently and fully.
14. The International Authorities have begun consideration of possible improvements in this area and the responses will be presented to the International Authorities in more detail to assist those discussions.

*Recommendations Set Out in Paragraphs 146 and 147*

15. The Working Group at its third session endorsed the following recommendations with regard to the making available of national search and examination reports:
  - “146. *Recommendation* – In relation to other [national] reports, it is recommended that designated and elected Offices which conduct search and examination in the national phase should consult with the IB on ways of making their national reports available to other designated and elected Offices, either by providing the national reports for inclusion on PATENTSCOPE, or else by providing notifications that reports are available in a way which permits a link to be added in PATENTSCOPE to a national file inspection system. This should be coordinated with other activities aimed at sharing national search reports between national Offices (such as those described in paragraphs 45 to 47 of document SCP/14/3) to minimize the work involved for Offices in making the reports available and to ensure that the reports are available to other Offices as easily and effectively as possible.
  - “147. The IB should ensure that such reports are made available through PATENTSCOPE in a way which permits efficient access by national Offices, both by looking at the conventional web pages or using automated processes to retrieve all relevant reports. Ideally, the citations should be made available in machine-readable format so that direct links can be provided to at least the easily available cited patent documents.”
16. A number of national Offices indicated that they already had public file inspection systems or that they were expecting to launch such systems soon and were generally interested in ensuring that all Offices were able to access information from other Offices effectively. However, it was observed that some national laws require the application files to remain secret until the final examination report has been issued; such Offices would probably not be able to participate in any file inspection or document sharing arrangements. One Office indicated that it had prepared proposals for legislation on publication of its national search reports to make this information more readily available.

17. Generally, there are two possible models on how national Offices may wish to share their national search and examination reports and other related documents (“dossier information”) with other Offices. One model may be referred to as the “open model”, the other as the “closed model”.
18. Under the “open model”, an Office agrees to make all of its dossier information available to the general public (and thus any other Office that wishes to access such information), without any restriction, for example, via a dedicated website. Under the “closed model”, an Office maintains control as to who can access such dossier information and grants access—usually on the basis of reciprocity—only to a limited number of other Offices participating in such a closed model, with the aim of enabling examiners in participating Offices to obtain access to dossier information of other Offices through a single point of access.
19. One example of an open model is WIPO’s PATENTSCOPE. As of the end of March 2011, the PATENTSCOPE system allows users to search within 7.7 million published patent documents, covering both international applications as well as national and regional patent collections, either by including the documents themselves in PATENTSCOPE or by providing a link to be added in PATENTSCOPE to existing national public file inspection systems. At present, PATENTSCOPE contains the patent collections from the following countries and regions: Argentina, Brazil, Chile, Colombia, Costa Rica, Cuba, Ecuador, El Salvador, Guatemala, Honduras, Israel, Mexico, Morocco, Nicaragua, Panama, Peru, Republic of Korea, Singapore, South Africa, Spain, Uruguay, Viet Nam, and ARIPO, EPO and Latipat (WIPO-EPO regional project for Latin American countries on patent front page database). The main features of PATENTSCOPE are the following:
  - (a) full text search facilities for published international applications under PCT back to the first publication in 1978 in an enhanced quality of data, and some 20 national and regional data collections;
  - (b) access to the file contents including ISRs and IPRPs, applicant’s informal comments on the written opinion, priority documents, etc.;
  - (c) searchable national phase entry data for over 30 countries;
  - (d) downloadable weekly collections of published applications through subscription services;
  - (e) graphical view and presentation of search results;
  - (f) Cross Lingual Information Retrieval (CLIR) function, allowing users to perform searches simultaneously in multiple languages (Chinese, English, French, German, Korean, Japanese Portuguese, Russian and Spanish);
  - (g) a new machine translation tool which allows users to translate titles of inventions and abstracts from English to French and Chinese and *vice versa*;
  - (h) RSS feeds to track technology developments in specific areas.
20. Examples of a “closed model” include the IP5’s “One Portal Dossier” project and a project by the Vancouver Group which is supported by WIPO’s “CASE” platform.

21. The “One Portal Dossier” project, one of the 10 Foundation Projects of the IP5 Offices (the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the State Intellectual Property Office of the People’s Republic of China (SIPO) and the United States Patent and Trademark Office (USPTO)) aims to enable examiners from each of the five Offices to obtain access to dossier information of each of the other Offices through a common portal, accessible only to examiners from the participating Offices.
22. The project undertaken by the Vancouver Group of Offices (the Australian Patent Office (IP Australia), the Canadian Intellectual Property Office (CIPO) and the United Kingdom Intellectual Property Office (UKIPO)) is equally designed to make dossier information available only to examiners of the three participating Offices. A technical platform entitled “WIPO CASE” has been developed by WIPO to provide a secure mechanism for the participating Offices to exchange dossier information. Upload of documents into the system is automated, and examiners in participating Offices can search and download documents uploaded by other offices. In the near future, the system will be upgraded to allow for references to documents in online digital libraries, which will eliminate the need to upload all documents into a central repository. More search features will also be added, in particular to support patent family searching. The system can support different models of work-sharing, depending on the practices of Offices and the agreements between Offices. For example, it may be used in cases where mutual exploitation agreements exist between Offices, or Offices may simply upload document for any other participating Office to use at their discretion.
23. The WIPO CASE platform will also be used to support efforts by a group of Offices of nine South American countries (Argentina, Brazil, Chile, Colombia, Ecuador, Paraguay, Peru, Suriname and Uruguay) who have agreed on a regional project referred to as PROSUR (regional cooperation system on IP) aimed at developing “a common platform that allows the integration, exchange of information and system compatibility for the nine participating countries”, those Office have requested WIPO’s technical assistance for applying the WIPO CASE platform to PROSUR.
24. While, in the view of the International Bureau, the “open model” is the most appropriate for sharing the final work products of patent search and examination, the “open” and “closed” models are not mutually exclusive but can co-exist, supplement each other and be used by Offices in parallel. While “closed model” projects (such as the One Portal Dossier project and the WIPO CASE platform) are designed to serve the Offices’ specific needs, notably that of examiners, to have access to the working documents of other Offices to enhance the efficiency and quality of search and examination, many Offices—including those participating in the “closed model” projects—have also made their final work products (at least national search and examination reports) available to the public through their web sites and/or by inclusion by reference in PATENTSCOPE. Furthermore, the closed model may always have a role in some cases, since it can facilitate sharing of information even when the patent application in question has not been published.
25. The International Bureau encourages Offices to consider several short-to-medium term goals. Firstly, offices can already send the final work products (search reports, examination report, granted claims) for PCT national phase applications to the International Bureau for inclusion in PATENTSCOPE, for the benefit of other Offices and of the general public. Secondly, Offices should consider creating their own online public file inspection systems to make available the search and examination reports of all applications examined by that Office. Thirdly, Offices should consider participating in closed model programs where these are appropriate for sharing resources to improve the quality and efficiency of patent search and examination.

26. Offices responding to Circular C. PCT 1295 emphasized that document-sharing platforms such as WIPO CASE need to ensure that they are readily accessible to Offices with significantly different levels of infrastructure and models for making file information available. Important features would include effective means of linking between different systems and between search reports and cited documents, as well as machine translation of documents, including between language pairs for which current machine translation systems are either non-existent or of relatively poor quality. One Office noted that making documents available in a structured (XML) format would assist understanding and effective use by other Offices.
27. The International Bureau will continue its work towards ensuring the technical compatibility of all the platforms, in particular through the standardization of data formats, so as to enable Offices of any group to interchange dossier information of any kind, based on mutual agreement, and taking into account the varying degree of access needs by the different “user” communities, that is, on the hand, examiners of participating Offices applying the “closed model” approach and, on the other, the general public in “open model” projects.
28. In line with the recommendation set out in paragraph 146 of document PCT/WG/3/2, the International Bureau would like to strongly encourage designated and elected Offices which conduct search and examination in the national phase to consult with the International Bureau on ways of making their national reports available to other designated and elected Offices, with a view to further enriching PATENTSCOPE as a tool for Offices wishing to collaborate and share their work with others with a view to addressing quality and backlog issues.
29. In addition, the International Bureau would also like to encourage pairs or groups of Offices (existing or yet to be formed) wishing to exchange national dossier information under a “closed model” to consult with the International Bureau to explore possibilities on whether the “WIPO CASE” platform can assist those Offices in providing a secure mechanism for such an exchange.

*Recommendations Set Out in Paragraph 149*

30. Document PCT/WG/4/7 contains a report on the status of the implementation of the recommendations set out in paragraph 149 of document PCT/WG/3/2 (made in relation to the setting up of a Third Party Observation System).

*Recommendations Set Out in Paragraph 149bis*

31. Document PCT/WG/4/4 contains the study which the Working Group recommended to be carried out by the International Bureau “to analyze the root causes behind the surge of patent applications and the consequent heavy load on the international patent system” (see paragraph 92 of document PCT/WG/3/14 Rev.; that recommendation was treated as having been inserted into document PCT/WG/3/2 as paragraph 149bis).

**Recommendations Related to Timeliness in the International Phase**

32. The recommendations endorsed by the Working Group with regard to the issue of “timeliness in the international phase” are set out in paragraph 154 of document PCT/WG/3/2. Comments and clarifications relating to those recommendations are set out in paragraphs 93 to 95 of the report of the third session of the Working Group (document PCT/WG/3/14 Rev.).

*Recommendations Set Out in Paragraph 154*

33. The Working Group at its third session endorsed the following recommendations in relation to “timeliness in the international phase”:

“154. *Recommendations* – The following recommendations are made in relation to ensuring that ISRs and IPRPs are delivered in accordance with the time limits set by the Treaty. For the reasons pointed out in paragraph 153 [of document PCT/WG/3/2], above, these recommendations are in very general terms:

“(a) Receiving Offices should ensure that they have adequate staff, facilities and training to receive and check international applications, and where necessary to send invitations for correction, promptly on receipt. They should also ensure that procedures, such as those for receiving fees, are easy to use for applicants and permit the Office to make the necessary checks quickly and accurately.

“(b) The IB and receiving Offices should ensure that applicants have access to accurate, up-to-date information on the filing requirements for international applications, especially fees, in order to minimize the number of defects which need to be corrected before the international application is forwarded to the ISA and the IB.

“(c) The IB should review the Receiving Office Guidelines to ensure that they are both up-to-date and easy to follow. The IB should also, where necessary in cooperation with national Offices and subject to the availability of resources, seek to make the Guidelines available in as many languages of publication as possible (at present, they are available in English, French, Japanese, Portuguese, Russian and Spanish).

“(d) International Authorities should ensure that they have adequate resources to conduct the expected number of international searches and international preliminary examinations in addition to their national work and that, in cases where backlogs do build up, international work is given appropriate priority to ensure that the results are available to designated and elected Offices in the national phase and, as far as possible, to third parties by the time of international publication.”

34. To take forward these recommendations, the International Bureau invited Offices in their various PCT capacities, by way of a Circular (C. PCT 1287, dated January 11, 2011), to submit reports, responses and comments to the issues raised in the Circular with regard to those recommendations. The International Bureau received a total of 28 responses to the Circular.

35. The eighteenth session of the Meeting of International Authorities under the PCT, held in Moscow in March 2011, also discussed the “actions” addressed to International Authorities set out in the Circular (see paragraphs 33 to 37 of document PCT/MIA/18/16, reproduced in the Annex to document PCT/WG/4/2).

*Recommendations set out in paragraphs 154(a) and (b)*

36. Many receiving Offices provided information on the staffing, facilities and training provided to staff in dedicated units dealing with PCT applications, with performance being monitored to address any future needs. While receiving Offices in general make efforts to ensure that formalities staff are adequately trained, including with support provided by the International Bureau, a few Offices expressed a desire for further specialized training under the PCT.

37. In order to ensure that work is completed within the requirements of the PCT, responses from a few Offices mentioned setting internal targets. One response mentioned that the periods set in these targets were shorter than the equivalent time period under the PCT, thereby ensuring that work is completed within the PCT requirements. Moreover, in some

cases these targets are published as commitments on the Office's website. For example, good experiences were reported on including provision of PCT services in the Office's customer service charter.

38. In addition to providing access to up-to-date information on filing PCT applications to minimize defects, some receiving Offices perform checks on PCT applications before or when they are filed. For example, providing applicants with the opportunity to have a pre-filing consultation over the telephone was reported by one Office. Another practice mentioned by one receiving Office was an over-the-counter check of PCT applications filed by hand so the applicant could promptly begin to correct any defects before receiving an official communication from the Office. It was also mentioned that online filing software can be configured not to accept applications with defects that would prevent it being accorded an international filing date.

*Recommendation set out in paragraph 154(c)*

39. The PCT Legal Division continually updates the PCT Receiving Office Guidelines to reflect changes to the legal framework or to address new problems faced by Receiving Offices. Such modifications are carried out in consultation with national Offices and other interested parties. An example of such consultation is Circular C. PCT 1296, which deals with legal changes relating to fees, but also provides clarification on procedures relating to the use of e-mail, the WIPO Digital Access Service for Priority Documents and correction of mistakes. Further language versions of the Guidelines will be made available when resources of the International Bureau and of national Offices assisting in this type of work permit.

*Recommendation set out in paragraph 154(d)*

40. International Authorities provided information on allocation of resources to international searches and international preliminary examinations. The inclusion of work performed as an International Authority in internal and external Office targets (see paragraph 37, above) was also mentioned in examples of good practices. One Authority also mentioned making informal contact by telephone with the applicant prior to establishing the international preliminary examination report in order to clarify the situation if a satisfactory response to the written opinion under Chapter II had not been received.
41. One issue raised concerning timeliness in producing international search reports was the quick transmission of search copies and the need for the International Bureau to take further measures to improve communication to the International Searching Authority in case of missing search copies. One Authority also had some concerns as to the way in which the International Bureau measured timeliness of international search reports, noting that Authorities were required to establish those reports in "normal" cases within 3 months from the date of receipt of the search copy, rather than within 16 months from the priority date, the latter being the time limit on which the International Bureau bases its statistics. This Authority mentioned that this contributed to the not so favorable timeliness statistics of some Authorities in the event of problems with the timely receipt of search copies beyond the control of the Authority concerned.
42. In response to this particular concern, it is important to bear in mind that a change to measuring timeliness from the date of receipt of the search copy would require all International Authorities to provide the International Bureau with correct and reliable information on the date of receipt of search copies.

## Recommendations Related to the Quality of International Search and Examination

43. The recommendations endorsed by the Working Group with regard to the issue of “quality of international search and preliminary examination” are set out in paragraphs 165 and 170 of document PCT/WG/3/2. Comments and clarifications relating to those recommendations are set out in paragraphs 96 to 102 of document PCT/WG/3/14 Rev.

### *Recommendations Set Out in Paragraph 165*

44. The Working Group at its third session endorsed the following recommendations to address the issue of quality of international search and preliminary examination:

“165. The following *recommendations* are therefore made to address the *actual* quality of ISRs and IPRPs:

- “(a) The International Authorities should continue to develop their internal quality management systems in accordance with the quality framework set out in Chapter 21 of the International Search and Preliminary Examination Guidelines such that their internal processes, including quality assurance processes, promote the establishment of high quality ISRs and IPRPs. The work should take into account the aim of developing useful and transparent quality metrics for measuring the usefulness of international reports in assisting the assessment of patentability by designated Offices.
- “(b) International Authorities should continue to seek ways of effectively searching documentation in languages which are not official languages of their Office. This should involve both technical means and trials of arrangements whereby examiners in Offices with complementary skills work together to establish a report.
- “(c) Offices whose national patent collections are not readily available in electronic form should consider digitizing them (with the assistance of the IB, if desired) and making them available to International Authorities and other Offices for search purposes.
- “(d) The IB should coordinate the development of a centralized system permitting designated Offices to give feedback to International Authorities.”

### — *Paragraph 165(a)*

45. The responses to Circular C. PCT 1295 indicated strong support for the further development of the quality framework for International Authorities. Apart from the issues discussed by the Meeting of International Authorities at its 18th session (see paragraphs 10 to 18 and 52 to 55 of document PCT/MIA/18/16, reproduced in the Annex to document PCT/WG/4/2), Offices indicated a need to specifically consider the quality of classification, for quality reviews to check the consistency between information in international search reports and their associated written opinions, and for International Authorities to ensure that they were open to feedback from designated Offices.

### — *Paragraph 165(b)*

46. International Authorities are trying out a number of ways of effectively searching documentation in languages which are not official languages of their Office. These include technical means such as bulk machine translation of documents into English and machine translating search terms into other languages to search original documents. In addition, the European Patent Office, the Korean Intellectual Property Office and the United States Patent and Trademark Office are conducting a pilot project for collaborative search and examination, with examiners from each of the Offices working together to establish a report

on a single international application. Details of this can be found in documents PCT/MIA/18/7 and paragraphs 56 to 58 of document PCT/MIA/18/16 (reproduced in the Annex to document PCT/WG/4/2).

47. WIPO's PATENTSCOPE database provides free access to a number of language tools to assist searching of documents in different languages and understanding the results. Notably, the "cross-lingual expansion" tool allows search terms to be expanded to include synonyms in the original language and equivalent terms in other languages, with the appropriate terminology being selected according to field of technology to improve accuracy. The system also offers machine translation of the search results into various languages using Google Translate to allow at least a basic understanding.

— *Paragraph 165(c)*

48. It is estimated that between 80 and 100 patent Offices have patent data in electronic format that can be included in search databases to improve the collections available to patent examiners worldwide. However, of that number, relatively few Offices have complete digitized collections covering all time periods and including titles, abstracts, classifications and searchable full-text of patent documents.
49. The International Bureau provides support to Offices, on demand, for the digitization of patent documents and for the capture and formatting of patent bibliographic data for the purposes of dissemination and inclusion in patent search databases. To date, the International Bureau has assisted 15 Offices with the formatting of data for dissemination and that data is now available via WIPO's PATENTSCOPE service; subject to the agreement by the Office concerned, such data are also available for inclusion in other search databases. The International Bureau has also assisted 7 Offices with the digitization of their patent documents through provision of the "WIPO SCAN" software and related technical assistance, and a further 25 projects are currently being assessed. In addition to WIPO's assistance, technical assistance for digitization and dissemination of patent documents is also provided by several large Offices.
50. In line with the recommendation set out in paragraph 165(c) of document PCT/WG/3/2, the International Bureau would like to strongly encourage Offices to consult with the International Bureau on ways of digitization their national patent collections documents for the purposes of dissemination and inclusion in patent search databases.
51. Several Offices responding to Circular C. PCT 1295 noted that they had either recently completed the digitization of their patent documentation or else expected to complete this shortly. There was support for making such information as easily accessible as possible, including putting it in centrally accessible repositories and databases such as PATENTSCOPE. However, some Offices were concerned that their documentation was in languages which are not widely spoken in other countries and consequently might not easily be understood, noting that the machine translation tools between some language pairs may not be of sufficient quality.

— *Paragraph 165(d)*

52. Document PCT/WG/4/7 contains a report on the status of the implementation of the recommendations set out in paragraph 165(d) of document PCT/WG/3/2 (made in relation to the development of a centralized system permitting designated Offices to give feedback to International Authorities).

*Recommendations Set Out in Paragraph 170*

53. The Working Group at its third session endorsed the following further recommendations to address the issue of quality of international search and preliminary examination:

“170. The following *recommendations* are made primarily to address the quality of ISRs and IPRPs as *perceived* by designated Offices, but should also improve the actual quality of reports:

- “(a) Offices which act as International Authorities should recognize the quality of their own work and not *routinely* conduct more than a “top-up” search when an international application for which they acted as International Authority enters their national phase. This should, of course, not prevent examiners from conducting whatever searches are necessary to ensure a high quality granted patent *in individual cases* where it can be seen that the scope of the international search was deficient, or where there is other need for additional searching, such as because the scope of the claims has significantly changed or because some inventions were not searched due to a lack of unity of invention.
- “(b) International Authorities should seek to make available more information relating to search strategies so that examiners in designated Offices can more easily assess the scope of the international search which has been conducted.
- “(c) International Authorities should seek to cite documents from a wide range of sources, where this is possible without reducing the quality of the search.
- “(d) International Authorities should encourage their examiners to give good explanations of the relevance of cited documents, especially in cases where the examiner considers that there is either a lack of inventive step, or else that the documents together show all the features of the claims but the examiner nevertheless considers that the combination is inventive over those disclosures (since an examiner from another jurisdiction might either come to a different conclusion, or else it might take a significant amount of analysis to reach the same conclusion).”

— *Paragraph 170(a)*

54. All International Authorities have recognized it as a desirable goal to trust the quality of their own work and not *routinely* to conduct more than a “top-up” search when an international application for which they acted as International Authority enters their national phase, though not all of them are yet in a position to be able to implement it. This recommendation appears only to require assessment of its state of implementation in future years.

— *Paragraph 170(b)*

55. Many designated Offices and International Authorities in principle support the idea of sharing information concerning search strategies to help other Offices understand the scope of the international search which has been conducted. However, there is significant disagreement over the appropriate form and extent of this documentation. Moreover, some Offices (both acting as International Authorities and not) have expressed concern over whether the extra work which may be involved is justified or whether search strategies are appropriate for sharing between Offices rather than being used as tools to assist purely internal quality processes. Several International Authorities are conducting trials of systems for recording search strategies automatically, including looking at how easy the strategies are to understand. Following discussion of the issue in the Meeting of International Authorities, the Canadian Intellectual Property Office has agreed to review the comments made during the discussions at the Meeting and to prepare further proposals for

consideration by the International Authorities (see paragraphs 63 to 68 of document PCT/MIA/18/16, reproduced in the Annex to document PCT/WG/4/2).

— *Paragraph 170(c)*

56. Both the Meeting of International Authorities (see paragraph 27 of document PCT/MIA/18/16, reproduced in the Annex to document PCT/WG/4/2) and the responses to Circular C. PCT 1295 concluded that it was not appropriate to work on the *appearance* of diversity of citations. Artificially selecting documents from a wide range of sources would involve extra work for examiners both in the International Searching Authority and in designated Offices, where the diverse citations would need to be collected and read. It was important to ensure that the search had covered a sufficiently diverse range of databases, but it was necessary to show this more directly; the fact that citations were mainly selected from a single source should not lead to the assumption that only that source had been properly searched.

— *Paragraph 170(d)*

57. Most Offices addressing the question of sufficiency of explanations of citations in response to Circular C. PCT 1295 indicated that they believed that the explanations were in fact sufficient in a majority of cases. However, it was recognized that this was an important issue, especially in relation to inventive step where approaches to the assessment can differ significantly between national laws, so that it was important to fully understand how the examiner in the International Searching Authority viewed the relevant citations. It was suggested that this should be a point of particular consideration during quality reviews and that the consistency of level of description could also be considered as part of discussions on the use of standard clauses. One Office suggested that the section explaining the relevance of the documents should always be prefaced by a summary of the invention by the examiner to help understand how the features of the citation relate to the features required by the claim.

**Recommendations Related to the Issues of Incentives for Applicants to Use the System Efficiently; Skills and Manpower Shortages; Access to Effective Search Systems**

58. The recommendations endorsed by the Working Group with regard to the issues of “incentives for applicants to use the system efficiently; skills and manpower shortages; access to effective search systems” are set out in paragraphs 176, 181 and 185 of document PCT/WG/3/2. Comments and clarifications relating to those recommendations are set out in paragraphs 103 to 110 of document PCT/WG/3/14 Rev..

*Recommendations Set Out in Paragraph 176*

59. The Working Group at its third session endorsed the following recommendations in respect of improving the quality of international applications during the international phase:

“176. Consequently, the following *recommendations* are made in respect of improving the quality of international applications during the international phase:

- “(a) The IB and national Offices should recommend to applicants that they prepare applications in good time and conduct their own prior art search before drafting their claims.
- “(b) International Authorities should offer applicants a good opportunity for dialogue with the examiner during international preliminary examination, including at least one written opinion before establishing a “negative” IPRP.
- “(c) Contracting States should consider possible incentives which could be introduced either internationally or at the national level to encourage

applicants to file higher quality applications and to have defects corrected in the international phase.”

— *Paragraph 176(a)*

60. In response to Circular C. PCT 1295, Offices indicated that they undertook a variety of activities to help explain to applicants the importance of preparing their application to a high standard in good time. These activities included seminars, publications, opportunities to talk to examiners and low priced searches before an application is filed. One Office also noted that fast search and examination of first-filed national applications allowed an excellent opportunity to identify and eliminate defects before filing an international application claiming priority. One Office suggested that it may be useful to develop a checklist for applicants to help them identify whether they have taken all the appropriate steps. In some countries, patent agents may also offer some time free to assist first time applicants. The International Bureau proposes to set up a forum to allow national Offices to share publications and seminar agendas and documentation which may assist other Offices in improving their activities in this area.

— *Paragraph 176(b)*

61. A majority of International Authorities have reported that they either always provide the applicant with a written opinion during the process of international preliminary examination before establishing the international preliminary examination report or intend to do so soon, unless either the report will be positive or the applicant has offered no meaningful response to the written opinion of the International Searching Authority. However, two Authorities consider that the requirements of Rule 66 are sufficient and that, while such a written opinion can be issued when the examiner considers it appropriate, there should be no right to expect more than the written opinion of the International Searching Authority and a single opportunity to amend the application or present arguments before the international preliminary examination report is established.

— *Paragraph 176(c)*

62. A variety of Offices indicated that some form of accelerated processing, including the Patent Prosecution Highway or other specific national arrangements, may be an appropriate way of providing an incentive for the applicant to file higher quality applications and eliminate any remaining defects in the international phase. Other Offices considered that it should be sufficient incentive that the process will be quicker and cheaper for high quality applications because Offices will raise fewer objections. One Office suggested that partial refunds might be offered to applications where no objections were made; another Office suggested that additional fees may be appropriate for each additional action which was necessary as a result of defects. Also suggested were better guidance for applicants and improved filing tools which provided automated “plausibility” tests to attempt to identify possible defects before the filing was completed.

*Recommendations Set Out in Paragraph 181*

63. The Working Group at its third session endorsed the following recommendations with regard to offering training in search and substantive examination:

“181. Consequently, it is *recommended* that national Offices which are able to offer training in search and substantive examination should consider coordinating their activities in order to provide complementary training which can bring benefits to as wide a range of recipient Offices as possible. This might include indicating the amount and type of training which they were able to offer; allowing requests for training to be matched to the courses available; and running regional rather than national training where several Offices are found to have similar language and

substantive needs. The IB should consider a similar approach in relation to training in PCT procedural processes such as the work of a receiving Office.”

64. Document PCT/WG/3/2, which formed the basis for the discussions on this matter during the third session of the Working Group which led to the endorsement of the above recommendation, describes the present situation with regard to training in search and substantive examination: while the International Bureau assists with such training on request to the extent permitted by its capacity, in general, such training tends to be negotiated bilaterally without the International Bureau or other Offices being involved or even aware that it is taking place. As a result, some Offices which make requests for training might receive assistance in overlapping areas from several different Offices and for others it may not be possible to arrange anything.
65. There clearly is a need for better coordination in order to provide complementary training which can bring benefits to as wide a range of recipient Offices as possible. While this recommendation is, first and foremost, addressed to national Offices which are able to offer training in search and substantive examination, the International Bureau would be happy, if so requested, to take on a more active role in facilitating and coordinating of such training activities, notably for examiners of Offices of developing and least developed countries. For example, the International Bureau could establish an international (annual or bi-annual) catalogue of training courses available to recipient Offices, thus facilitating what the recommendation envisages: to enable donor Offices to indicate the amount and type of training which they are able to offer; to allow requests for training to be matched to the courses available; and to organize regional rather than national training events where several Offices are found to have similar language and substantive needs.
66. In addition, while the International Bureau has only limited capacities to be able to directly help national Offices to address their training needs, it will continue to assist Offices in the planning and the design of training activities (objective, type, amount, duration, target trainees, training methods, working languages, funding) and continue to provide general training courses for Office staff, including examiners, for example, on general basics of the patent system, on patent drafting and on patent information, both in the form of workshops and seminars and by distance learning. The International Bureau will also, of course, continue to provide specific training on PCT procedures.
67. In this context, the International Bureau envisages offering tailored assistance to those small and medium sized Offices who wish to make use of national or international search and examination reports established by other Offices as tools to assist them in carrying out national search and examination. To that end, the International Bureau envisages to launch a service entitled WIPO-ICE (“International Cooperation on Examination”), designed to respond to the particular challenges facing small and medium sized Offices (both of States which are and those which are not members of the PCT) in substantive examination and who seek tailored assistance to address their needs. In addition to the provision of generic training in search and examination, training of examiners under the ICE project will particularly focus on retrieving search and examination results from other Offices and applying them in the respective national context. These results not only include the search and examination reports established during the international phase of the PCT procedure and the results of other national Offices before which an application has entered the national phase, but also results for applications that have not been filed via the PCT system but under the Paris Convention route. To that extent, the ICE service may be seen as complementing the PCT system, in particular with regard to applications which have not been filed as international applications under the PCT.

*Recommendations Set Out in Paragraph 185*

68. The Working Group at its third session endorsed the following recommendations with regard to access to effective search systems:
- “185. It is *recommended* that the International Bureau and Contracting States continue to seek practical and affordable ways for national Offices to develop online searching capabilities.”
69. With regard to obtaining access to effective search systems for national Offices, it is recalled that Offices may wish to use a number of publicly available free-of-charge patent databases on the Internet. The geographical coverage of patent data has been extended by active exchange of patent raw data and the electronic publication of patent gazettes on the Internet. WIPO publishes and updates a list of IPOs patent databases available on the Internet ([http://www.wipo.int/patentscope/en/dbsearch/national\\_databases.html](http://www.wipo.int/patentscope/en/dbsearch/national_databases.html)).
70. The International Bureau continues to develop its PATENTSCOPE search services and makes these available freely for searching patent information. On request by national Offices, it has assisted in digitizing national patent collections and provided Offices with online portals allowing users access specifically to the national patent collection in addition to integrating the collection into the broader PATENTSCOPE service for allow it to be searched at the same time as other patent collections (see paragraphs 49 to 51, above).
71. PATENTSCOPE has increased its geographical coverage to some 20 countries of national data and two regional organizations' data which virtually cover more than 50 countries. The responses to Circular C. PCT 1295 encouraged WIPO to extend this coverage further. The Guide to patent databases prepared by WIPO in response to requests from Member States made in the context of the Committee on Development and Intellectual Property (CDIP) contains more practical information about various ways of national Offices to develop online searching capabilities. The study (CDIP/3/INF/2/STUDY/III/INF/1) may be found at [http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=146973](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=146973). The WIPO Guide to Technological Databases may be found at WIPO's web site in the context on Technology and Innovation Support Centers (TISCs, see below). The development of skills and familiarity to databases are necessary to obtain further capabilities.
72. With regard to searching capability of scientific and technical journals articles (so called non-patent literature), WIPO launched a partnership program in 2009 which is called the Access to Research for Development and Innovation (aRD*i*). For this project, 12 major publishers contributed. The aRD*i* program currently provides patent Offices and academic and research institutions in 107 least developed and developing countries with free or very low cost access to over 50 journals, based on the PCT Minimum Documentation. This program is continuing to negotiate with publishers to increase the range of documentation available for both patent searching and technical information purposes. A number of similar initiatives exist, operated by other intergovernmental organizations and non-governmental organizations and are, as far as possible, closely coordinated with aRD*i*.
73. The Access to Specialized Patent Information (ASPI) program, launched in September 2010 by WIPO in cooperation with six commercial patent database providers, has also made a significant contribution to improving access to advanced patent search systems. Similarly to the aRD*i* program, the ASPI program permits patent Offices and academic and research institutions in 115 least developed and developing countries to obtain access to participating database providers' flagship products for free or at a nominal cost. The responses to Circular C. PCT 1295 reaffirmed the importance of maintaining and developing this program.

74. The project to establish Technology and Innovation Support Centers (TISCs), being carried out by WIPO within the framework of its Development Agenda, aims to develop, *inter alia*, capacities in least developed and developing countries to make more effective use of search systems and the information accessible through these systems. Thus, the project should contribute to improving the quality of patent applications filed through the PCT system and increase the benefits derived by least developed and developing countries from participating in the international patent system. The responses to Circular C. PCT 1295 affirmed that it was important not only to provide access to databases but to ensure that examiners in national Offices had the necessary skills to use them effectively.
75. It is recommended that the International Bureau and Member States continue to seek practical and affordable ways for national Offices to develop online searching capabilities.

#### **Recommendations Related to Cost and Other Accessibility Issues; Consistency and Availability of Safeguards**

76. The recommendations endorsed by the Working Group with regard to the issues of “cost and other accessibility issues; consistency and availability of safeguards” are set out in paragraphs 191, 193, 194, 195 and 198 of document PCT/WG/3/14 Rev.. Comments and clarifications relating to those recommendations are set out in paragraphs 111 and 112 of document PCT/WG/3/14 Rev.
77. To take forward these recommendations, the International Bureau invited Offices in their various PCT capacities, by way of a Circular (C. PCT 1287, dated January 11, 2011), to submit reports, responses and comments to the issues raised in the Circular with regard to those recommendations by February 18, 2011. The International Bureau received a total of 28 responses to the Circular.

#### *Recommendations Set Out in Paragraph 191*

78. The Working Group at its third session endorsed the following recommendations with regard to the level of PCT fees:
  - “191. It is *recommended* that the IB and Contracting States further review the level of fees for different types of applicant and seek innovative solutions to the problem of ensuring that applicants are not excluded from use of the system by the level of the fees.”
79. To pursue this recommendation, Offices were asked to provide suggestions for financially sustainable ways forward, with a view to developing appropriate levels of fees for different types of applicants and for seeking innovative solutions to the problem of ensuring that applicants are not excluded from use of the system by the level of fees. As well as taking forward the recommendation set out in paragraph 191, this invitation was also intended as a follow-up to the discussions at the third session of the Working Group concerning revised proposals on eligibility criteria for reductions in certain fees (see document PCT/WG/3/14 Rev., paragraphs 158 to 181).
80. Many Offices responding to the invitation expressed their support for fee levels that would not exclude applicants from use of the PCT. Suggestions to this effect included the use of entirely income-based criteria to determine the eligibility for fee reductions (for example, those used by the European Patent Office to determine eligibility for a 75% reduction in the fees for the international search and for international preliminary examination), and the mixed income and innovation-based criteria proposed at the third session of the PCT Working Group (see document PCT/WG/3/4 Rev.).

81. The International Bureau will further study the matter, notably the issue of suitable eligibility criteria for fee reductions, with a view to finding alternative solutions which could be agreed upon by all Member States. To that extent, it wishes to again encourage all Member States to make suggestions as to a possible way forward.

*Recommendations Set Out in Paragraph 193*

82. The Working Group at its third session endorsed the following recommendations with regard to the further simplification of procedures:
- “193. It is *recommended* that the IB and Contracting States bring to the attention of the International Bureau any ways in which they consider procedures could be simplified for applicants without needing to change national laws.”
83. A number of changes to specific procedures and forms were suggested by Offices. The International Bureau is studying those proposals in detail and will, where appropriate, make proposals with regard to specific modifications to forms and procedures.
84. As for more general proposals, one Office suggested that an overall review of procedures and Regulations could be conducted. A number of Offices also expressed a desire for fewer PCT forms and procedures, but did not identify any individual forms and procedures that could be abolished.

*Recommendations Set Out in Paragraph 194*

85. The Working Group at its third session endorsed the following recommendations with regard to PCT online systems:
- “194. It is *recommended* that the IB review the PCT Applicant’s Guide to ensure that it is up-to-date and provides useful, easy to understand information.”
86. The Annexes of the Applicant’s Guide are revised almost every day to take into account changes notified to the International Bureau by national Offices. The main text is regularly reviewed to ensure that it remains up to date. The International Bureau is developing new systems to assist this process and to allow changes to be reflected quickly and accurately in different language versions of the Guide.

*Recommendations Set Out in Paragraph 195*

87. The Working Group at its third session endorsed the following recommendations with regard to PCT online systems:
- “195. It is *recommended* that the IB and Offices developing online PCT systems ensure that, when updating Forms and online systems, special attention is given to ensuring that the language, interfaces and associated help mean that it is not necessary to consult the Regulations in most cases.”
88. Responses from Offices to C.PCT 1287 to provide relevant experiences and “best practices” in updating Forms and online systems highlighted two main issues. Firstly, a number of Offices expressed a desire for online systems and guidance to be available in more languages. This included user aids and help facilities for software and guidelines for commonly-used PCT forms (especially Form PCT/RO/101). Secondly, the process of notifying changes and making updates by the International Bureau attracted several comments. Here, the IB was asked to send updates for PCT-SAFE and new or revised forms to Offices at an earlier stage to allow more time to adapt their own systems before their entry into force.

89. Two responses mentioned that a PCT web-based filing system could be introduced to complement software-based systems. These Offices mentioned that this could be beneficial to applicants and their representatives since such a system would have the most up-to-date forms and information removing the administrative burden of making regular software updates. Establishment of a PCT web-based filing system would have consequences on the orientation of future development of systems for the management and transmission of cases between the IB, Offices and users at other stages of the PCT process. Recent developments on PCT e-services are given in Document PCT/WG/4/12.
90. In the event that the Regulations do need consulting, one Office suggested inserting links on the website version of the PCT forms to references made to individual Rules and sections of the Administrative Instructions, opening these in a separate window to facilitate consultation.

*Recommendations Set Out in Paragraph 198*

91. The Working Group at its third session endorsed the following recommendations with regard to notifications of incompatibility:
- “198. It is *recommended* that Contracting States review their compatibility with the Regulations and Administrative Instructions and seek to determine whether they can withdraw notifications of incompatibility.”
92. As a result of the review conducted by Offices on notifications of incompatibility, a few Contracting States have indicated that they may be able to lift some or all of their notifications in the near future. Contracting States who concluded that notifications should remain in place for the foreseeable future are nevertheless encouraged to make periodical reviews of their necessity and address these points when opportunities arise to make legislative changes.

**Recommendations Related to Technical Assistance; PCT Information and Technology Transfer**

93. The recommendations endorsed by the Working Group with regard to the issues of “technical assistance; PCT information and technology transfer” are set out in paragraph 129 of document PCT/WG/3/14 Rev., which replace or add to the relevant recommendations set out in paragraphs 204, 207 and 211 of document PCT/WG/3/2. Comments and clarifications relating to those recommendations are set out in paragraphs 113 to 128 and paragraphs 130 to 137 of document PCT/WG/3/14 Rev.

*Recommendations Set Out in Paragraph 204*

94. The Working Group at its third session endorsed the following recommendations with regard to requests for technical assistance by Offices and Contracting States:
- “204. It is *recommended* that, when requesting technical assistance in the context of the PCT, just as in any other area, Offices and Contracting States ensure that the purpose of the request is clear and that the International Bureau is aware of related national policies. The International Bureau should make sure that advice, training and systems which are delivered take the needs and national policies properly into account.”
95. The International Bureau will continue to seek to obtain sufficient details of related national policies before delivering programs for technical assistance on patent and PCT related matters and, where appropriate, will encourage and assist the regional Bureaus in helping Member States to develop and articulate such policies to guide development work.

*Recommendations Set Out in Paragraph 204bis*

96. Document PCT/WG/4/5 contains the study which the Working Group recommended to be carried out by the International Bureau “to look into the issue of coordination of technical assistance for developing countries as envisaged in Article 51 of the PCT, in a focused manner and guided by the Development Agenda recommendations, and to make recommendations on “terms of reference” for the possible establishment of the Technical Assistance Committee” (see paragraph 129 of document PCT/WG/3/14 Rev.; that recommendation was treated as having been inserted into document PCT/WG/3/2 as paragraph 204bis).

*Recommendations Set Out in Paragraph 207*

97. The Working Group at its third session endorsed the following recommendations with regard to delivering effective patent status information:

“207. It is recommended that the IB work with national Offices to deliver effective patent status information covering not only PCT applications and subsequently granted patents but also normal national applications, including information concerning opposition of patents (pre and post-grant), revocation and lapse of patents, issuance of compulsory licenses, etc. This information would be integrated into a search system allowing technology which has fallen into the public domain to be identified more readily. The IB would take up a pilot project to develop an integrated system for automatic updating of the status of the application by linking it with national offices/organizations.”

98. As part of WIPO’s Development Agenda Project DA\_16\_20\_01, the International Bureau has conducted a study to investigate the availability and reliability of legal status data from primary sources such as national patent registers and patent gazettes. It is envisaged that the findings of that study will be published in May 2011. The International Bureau will further assess the information received and make proposals for making this information more readily accessible and integrating it into search databases to allow public domain technology to be more easily identified.
99. To the extent that the International Bureau already receives national phase status information relating to international applications, this is made available and searchable in PATENTSCOPE, including providing links to any national Offices’ online registers or file inspection systems wherever possible.

*Recommendations Set Out in Paragraph 211*

100. The Working Group at its third session endorsed the following recommendations with regard to establishment of a system for promoting licensing:

“211. It is recommended that a system for promoting licensing should be established, including by introducing a register that encourages applicants to signal their willingness to license their potential patents.”

101. The International Bureau has concluded that such a system can be implemented without any change to the PCT legal framework, save for the creation of a new form permitting the applicant to indicate a willingness to license his invention and, optionally, to indicate the relevant terms. The International Bureau will shortly issue a Circular containing a draft of such a form with the aim of allowing the system to become operational around July 1, 2011.

*Recommendations Set Out in Paragraph 211bis*

102. Document PCT/WG/4/6 contains a status report on the study which the Working Group recommended to be carried out by the International Bureau “to review and assess how well the PCT system has been functioning in terms of realizing its aim of disseminating technical information and facilitating access to technology as well as organizing technical assistance for developing countries” (see paragraph 129 of document PCT/WG/3/14 Rev.; that recommendation was treated as having been inserted into document PCT/WG/3/2 as paragraph 211 *bis*).

*Recommendations Set Out in Paragraph 213*

103. The Working Group at its third session endorsed the following recommendations with regard to the availability of working documents of the PCT Working Group in the six official languages of the United Nations:

“213. Noting the desire by many Contracting States to have all working documents of the PCT Working Group available in the six official languages of the United Nations, so as to encourage and facilitate engagement in the discussions by all Contracting States, it is recommended that this issue be included in the study by the IB on the overall WIPO language policy currently under way.”

104. A study prepared by the International Bureau on WIPO’s language policy will be presented to the 17<sup>th</sup> session of the Program and Budget Committee, scheduled to take place from June 27 to July 1, 2011.

*105. The Working Group is invited:*

- (i) to note the content of the present document;*
- (ii) to comment on whether and, if so, which additional activities in the areas covered by the recommendations endorsed by the Working Group at its third session should be undertaken; and*
- (iii) to comment on whether it wishes to make any further recommendations to improve the functioning of the PCT system.*

[Annex follows]

## ANNEX

RECOMMENDATIONS TO IMPROVE THE FUNCTIONING OF THE PCT  
ENDORSED BY THE WORKING GROUP AT ITS THIRD SESSION, JUNE 2010

(reproduced from documents PCT/WG/3/2 and PCT/WG/3/14 Rev.)

*Addressing Backlogs; Improving Quality of Granted Patents*

143. *Recommendations* – Consequently, the following recommendations are made in relation to ISRs and IPRPs in order to make them more useful tools for assisting national Offices in addressing quality and backlog issues:
- (a) The Offices which act as International Authorities should continue to take steps to improve both the actual and perceived quality and consistency of the reports which they establish in accordance with the current Treaty, Regulations and Guidelines, to ensure that they provide content which designated and elected Offices *wish* to take into account. This issue is considered further in paragraphs 158 to 172, below.
  - (b) The Offices which act as designated and elected Offices should continue to review the intended contents of ISRs and IPRPs and make any further recommendations for improvement within the limitations that the reports must be useful to all Contracting States and may not contain any comment on whether an invention is patentable or unpatentable according to any particular national law.
  - (c) The IB and the Offices which act as International Authorities should review the proposals for changes to the details of what should be contained in ISRs and IPRPs and report to the next session of this Working Group, including any recommendations which may appear appropriate, for example for changes to the Rules or Administrative Instructions (including the Forms).
  - (d) This exercise should in no way affect the right of designated and elected Offices to use the resulting ISRs and IPRPs in whatever way they see fit, in accordance with their national laws and policies.
146. *Recommendation* – In relation to other reports, it is recommended that designated and elected Offices which conduct search and examination in the national phase should consult with the IB on ways of making their national reports available to other designated and elected Offices, either by providing the national reports for inclusion on PATENTSCOPE, or else by providing notifications that reports are available in a way which permits a link to be added in PATENTSCOPE to a national file inspection system. This should be coordinated with other activities aimed at sharing national search reports between national Offices (such as those described in paragraphs 45 to 47 of document SCP/14/3) to minimize the work involved for Offices in making the reports available and to ensure that the reports are available to other Offices as easily and effectively as possible.
147. The IB should ensure that such reports are made available through PATENTSCOPE in a way which permits efficient access by national Offices, both by looking at the conventional web pages or using automated processes to retrieve all relevant reports. Ideally, the citations should be made available in machine-readable format so that direct links can be provided to at least the easily available cited patent documents.

149. *Recommendation* – The IB should make available a system allowing third parties to submit observations on published international applications, including references to disclosures which they believe mean that the claimed invention may not be novel or inventive. It should remain open to designated Offices to decide to what extent they should review disclosures cited through such a system (the International Bureau intends to issue a document covering this subject in greater detail).
- 149bis. It is recommended that a follow-up study be conducted by the IB, which should involve WIPO's Chief Economist, to analyze the root causes behind the surge of patent applications and the consequent heavy load on the international patent system.”

*Addressing Timeliness in the International Phase*

154. *Recommendations* – The following recommendations are made in relation to ensuring that ISRs and IPRPs are delivered in accordance with the time limits set by the Treaty. For the reasons pointed out in paragraph 153 [of document PCT/WG/3/2], above, these recommendations are in very general terms:
- (a) Receiving Offices should ensure that they have adequate staff, facilities and training to receive and check international applications, and where necessary to send invitations for correction, promptly on receipt. They should also ensure that procedures, such as those for receiving fees, are easy to use for applicants and permit the Office to make the necessary checks quickly and accurately.
  - (b) The IB and receiving Offices should ensure that applicants have access to accurate, up-to-date information on the filing requirements for international applications, especially fees, in order to minimize the number of defects which need to be corrected before the international application is forwarded to the ISA and the IB.
  - (c) The IB should review the Receiving Office Guidelines to ensure that they are both up-to-date and easy to follow. The IB should also, where necessary in cooperation with national Offices and subject to the availability of resources, seek to make the Guidelines available in as many languages of publication as possible (at present, they are available in English, French, Japanese, Portuguese, Russian and Spanish).
  - (d) International Authorities should ensure that they have adequate resources to conduct the expected number of international searches and international preliminary examinations in addition to their national work and that, in cases where backlogs do build up, international work is given appropriate priority to ensure that the results are available to designated and elected Offices in the national phase and, as far as possible, to third parties by the time of international publication.
165. The following *recommendations* are therefore made to address the *actual* quality of ISRs and IPRPs:
- (a) The International Authorities should continue to develop their internal quality management systems in accordance with the quality framework set out in Chapter 21 of the International Search and Preliminary Examination Guidelines such that their internal processes, including quality assurance processes, promote the establishment of high quality ISRs and IPRPs. The work should take into account the aim of developing useful and transparent quality metrics for measuring the usefulness of international reports in assisting the assessment of patentability by designated Offices.

- (b) International Authorities should continue to seek ways of effectively searching documentation in languages which are not official languages of their Office. This should involve both technical means and trials of arrangements whereby examiners in Offices with complementary skills work together to establish a report.
  - (c) Offices whose national patent collections are not readily available in electronic form should consider digitizing them (with the assistance of the IB, if desired) and making them available to International Authorities and other Offices for search purposes.
  - (d) The IB should coordinate the development of a centralized system permitting designated Offices to give feedback to International Authorities.
170. The following *recommendations* are made primarily to address the quality of ISRs and IPRPs as *perceived* by designated Offices, but should also improve the actual quality of reports:
- (a) Offices which act as International Authorities should recognize the quality of their own work and not *routinely* conduct more than a “top-up” search when an international application for which they acted as International Authority enters their national phase. This should, of course, not prevent examiners from conducting whatever searches are necessary to ensure a high quality granted patent *in individual cases* where it can be seen that the scope of the international search was deficient, or where there is other need for additional searching, such as because the scope of the claims has significantly changed or because some inventions were not searched due to a lack of unity of invention.
  - (b) International Authorities should seek to make available more information relating to search strategies so that examiners in designated Offices can more easily assess the scope of the international search which has been conducted.
  - (c) International Authorities should seek to cite documents from a wide range of sources, where this is possible without reducing the quality of the search.
  - (d) International Authorities should encourage their examiners to give good explanations of the relevance of cited documents, especially in cases where the examiner considers that there is either a lack of inventive step, or else that the documents together show all the features of the claims but the examiner nevertheless considers that the combination is inventive over those disclosures (since an examiner from another jurisdiction might either come to a different conclusion, or else it might take a significant amount of analysis to reach the same conclusion).

*Creating Incentives for Applicants to Use the System “Efficiently”*

176. Consequently, the following *recommendations* are made in respect of improving the quality of international applications during the international phase:
- (a) The IB and national Offices should recommend to applicants that they prepare applications in good time and conduct their own prior art search before drafting their claims.
  - (b) International Authorities should offer applicants a good opportunity for dialogue with the examiner during international preliminary examination, including at least one written opinion before establishing a “negative” IPRP.

- (c) Contracting States should consider possible incentives which could be introduced either internationally or at the national level to encourage applicants to file higher quality applications and to have defects corrected in the international phase.

*Addressing Skills and Manpower Shortage*

181. Consequently, it is *recommended* that national Offices which are able to offer training in search and substantive examination should consider coordinating their activities in order to provide complementary training which can bring benefits to as wide a range of recipient Offices as possible. This might include indicating the amount and type of training which they were able to offer; allowing requests for training to be matched to the courses available; and running regional rather than national training where several Offices are found to have similar language and substantive needs. The IB should consider a similar approach in relation to training in PCT procedural processes such as the work of a receiving Office.

*Addressing Access to Effective Search Systems*

185. It is *recommended* that the International Bureau and Contracting States continue to seek practical and affordable ways for national Offices to develop online searching capabilities.

*Addressing Cost and Other Accessibility Issues*

191. It is *recommended* that the IB and Contracting States further review the level of fees for different types of applicant and seek innovative solutions to the problem of ensuring that applicants are not excluded from use of the system by the level of the fees.
193. It is *recommended* that the IB and Contracting States bring to the attention of the International Bureau any ways in which they consider procedures could be simplified for applicants without needing to change national laws.
194. It is *recommended* that the IB review the PCT Applicant's Guide to ensure that it is up-to-date and provides useful, easy to understand information.
195. It is *recommended* that the IB and Offices developing online PCT systems ensure that, when updating Forms and online systems, special attention is given to ensuring that the language, interfaces and associated help mean that it is not necessary to consult the Regulations in most cases.

*Addressing Consistency and Availability of Safeguards*

198. It is *recommended* that Contracting States review their compatibility with the Regulations and Administrative Instructions and seek to determine whether they can withdraw notifications of incompatibility.

*Technical assistance; PCT Information and Technology Transfer*

204. It is recommended that, when requesting technical assistance in the context of the PCT, just as in any other area, Offices and Contracting States ensure that the purpose of the request is clear and that the International Bureau is aware of related national policies. The International Bureau should make sure that advice, training and systems which are delivered take the needs and national policies properly into account.

204*bis*. It is recommended that a study be conducted by the IB to look into the issue of coordination of technical assistance for developing countries as envisaged in Article 51 of the PCT, in a focused manner and guided by the Development Agenda recommendations, and to make recommendations on “terms of reference” for the possible establishment of the Technical Assistance Committee. This study will be presented for decision to the 4<sup>th</sup> session of the Working Group.

The study should also identify and assess existing agreements with relevant international financing organizations and inter-governmental organizations for financing of technical assistance projects (see PCT Article 51(4)), and make recommendations regarding the possibility of seeking further such agreements.

207. It is recommended that the IB work with national Offices to deliver effective patent status information covering not only PCT applications and subsequently granted patents but also normal national applications, including information concerning opposition of patents (pre and post-grant), revocation and lapse of patents, issuance of compulsory licenses, etc. This information would be integrated into a search system allowing technology which has fallen into the public domain to be identified more readily. The IB would take up a pilot project to develop an integrated system for automatic updating of the status of the application by linking it with national offices/organizations.

211. It is recommended that a system for promoting licensing should be established, including by introducing a register that encourages applicants to signal their willingness to license their potential patents.

211*bis*. It is recommended that a follow-up study be conducted by the IB to review and assess how well the PCT system has been functioning in terms of realizing its aim of disseminating technical information and facilitating access to technology as well as organizing technical assistance for developing countries.

The study should also propose recommendations and suggestions on how to improve the realization of that aim, including on sufficiency of disclosure, for consideration by Contracting States at the 4<sup>th</sup> session of the PCT Working Group, recognizing that action on certain issues may require discussion in other WIPO fora.

In this context, appropriate changes should be made in the proposed form for third party observations (document PCT/WG/3/6 Annex 2, p.2), including “sufficiency of disclosure” aspects, for discussion at the next session.

213. Noting the desire by many Contracting States to have all working documents of the PCT Working Group available in the six official languages of the United Nations, so as to encourage and facilitate engagement in the discussions by all Contracting States, it is recommended that this issue be included in the study by the IB on the overall WIPO language policy currently under way.

[End of Annex and of document]