

Patent Cooperation Treaty (PCT)

Working Group

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REQUIREMENTS AND PROCEDURES FOR APPOINTMENT OF OFFICES AS INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES UNDER THE PCT

Document prepared by the International Bureau

SUMMARY

1. During the 25th session of the CTC¹ and the 43rd session of the PCT Assembly, the Delegations of Spain, Portugal and the Russian Federation and the representative of the European Patent Office stated that there was a need to review the requirements and procedures for appointment as an International Authority. As background information for such a review by PCT Member States, this document sets out the current requirements and procedures together with information on how the procedures have been applied in the past.
2. The issue has also been discussed at the most recent session of the Meeting of International Authorities (PCT/MIA), held in Munich from February 6 to 8, 2013. The discussions at that session are outlined in the Summary by the Chair of that session, paragraphs 103 to 109, reproduced in the Annex to document PCT/WG/6/3.

¹ The following abbreviations are used in this document:

CTC: PCT Committee for Technical Cooperation

ISA: International Searching Authority

IPEA: International Preliminary Examining Authority

PCT: Patent Cooperation Treaty

RWC: *Records of the Washington Conference*, WIPO Publication Number 313(E)

Summary Minutes: The Summary Minutes of Main Committee I of the Washington Conference at pages 527 to 605
RWC

Washington Conference: The Washington Diplomatic Conference on the Patent Cooperation Treaty

Furthermore, references to Articles and Rules refer to those provisions of the PCT and the Regulations under the PCT, respectively.

BACKGROUND

3. The requirements and procedures for appointment as an International Authority are provided for in PCT Articles 16 and 32 and Rules 36 and 63.

Positions at the Washington Diplomatic Conference

4. Both Articles 16 and 32 as well as the more detailed Regulations concerned with the appointment, role and responsibilities of International Authorities are drafted in a way which assume that more than one International Authority is tasked with carrying out international searches and international preliminary examinations.

5. That notwithstanding, at the Washington Diplomatic Conference leading to the conclusion of the PCT, a majority of delegations agreed to a proposal by the Delegation of Canada² to write into the Treaty a specific reference to the goal of creating a single International Searching Authority, by adding the opening words of Article 16: "If, pending the establishment of a single International Searching Authority...".

6. Correspondingly, the CTC was given the following tasks (Article 56(3)):

"(3) The aim of the Committee shall be to contribute, by advice and recommendations:

"(i) to the constant improvement of the services provided for under this Treaty,

"(ii) to the securing, so long as there are several International Searching Authorities and several International Preliminary Examining Authorities, of the maximum degree of uniformity in their documentation and working methods and the maximum degree of uniformly high quality in their reports, and

"(iii) on the initiative of the Assembly or the Executive Committee, to the solution of the technical problems specifically involved in the establishment of a single International Searching Authority."

7. Furthermore, a proposal³ was accepted that, before appointment of an International Authority, the Assembly should "seek the advice of the Committee for Technical Cooperation referred to in Article 56 once that Committee has been established" (Article 16(3)(e)).

8. However, even at the time of the Diplomatic Conference, it was clear that not all States considered the goal of a single International Authority to be both desirable and realistic. For example, the Delegation of Brazil had presented an alternative proposal⁴ that "any contracting party whose national Office fulfills the minimum requirements, especially as to manpower and documentation, may be designated as the seat of an International Searching Authority".

² Document PCT/DC/31 at page 234 RWC. The proposal was introduced as follows (paragraph 406 of the Summary Minutes at page 539 RWC): "... It was desirable that the PCT make clear that the multiplicity of International Searching Authorities was merely a temporary solution and that the ultimate goal was to have only one such Authority. ..."

³ Document PCT/DC/21 at page 230 RWC.

⁴ Document PCT/DC/34 Rev. at page 235 RWC and paragraph 446.1 of the Summary Minutes (Main Committee I) at page 541 RWC. The position and proposal were described as follows: "... it might very well happen that in practice decentralized searching worked better than centralized searching. Even if there was only one International Searching Authority, it was probably going to be necessary that it have several branches in different parts of the globe. ..." (paragraph 428 of the Summary Minutes at page 540 RWC) and "The request to become an International Searching Authority was, in a certain sense, a political matter since it was in the interest of the State or the region in question to have an International Searching Authority within its boundaries" (paragraph 453.3 of the Summary Minutes at page 541 RWC).

9. The Brazilian proposal had been supported by various delegations either very generally⁵ or because various practical problems meant that a solution involving a single Authority would be a very long way in the future⁶.

Developments Since Entry into Force of the Treaty

10. The Annex to this document contains a list of the appointments of Offices as International Authorities, including the sessions of the CTC where recommendations were made and of the Assembly where appointments were made.

11. Since the Treaty has entered into force, the number of International Authorities has risen from the initial seven (five as both ISA and IPEA; one each as ISA or IPEA only) to eighteen (fifteen active and three appointed but not yet having begun operations). The only Office to have given up its status was the United Kingdom Patent Office, whose original appointment was for fifteen years (rather than the 10 years of the other Authorities), but whose appointment was understood from the outset to be non-renewable as a result of its obligations in the context of the European Patent Convention.

12. The CTC met most years up until 1995 in the context of its role in securing “the maximum degree of uniformity in [the International Authorities’] documentation”, but has rarely met as a true expert body, able to give meaningful advice to the PCT Assembly on the appointment of International Authorities. Only in the case of the appointment of the Korean Industrial Property Office (now the Korean Intellectual Property Office) has the CTC been convened separately from the PCT Assembly in order to give such advice. In all other cases, the CTC has either not been convened (at the time of the first seven appointments it had not been created; the Assembly explicitly decided that it did not need to hear such advice for three further appointments) or else it has been convened essentially as a formality during the same period as the WIPO Assemblies. In the latter case, the participants have been largely, if not exclusively, the same delegates as those attending the PCT Assembly and few questions have been considered other than when the Office expects to obtain outstanding parts of the PCT minimum documentation which it has noted as not yet being available. In effect, the Contracting States have been content to appoint Authorities on the basis of a self-certification that the minimum requirements have been met (or in a number of cases an undertaking that deficiencies will be corrected before beginning operation) and a political assessment of the desirability of the appointment.

13. The CTC has never met to give advice on the extension of existing appointments and the PCT Assembly has never asked the CTC to look into the matter of technical problems specifically involved in the establishment of a single ISA.

14. The minimum requirements for appointment as an International Authority (Rules 36 and 63) have been modified on the following occasions:

- (a) (effective July 1, 1992) It was clarified that physical possession of the PCT minimum documentation was no longer required if it could be accessed through electronic media.

⁵ For example, the Delegation of Spain supported the proposal “because it made clear that any national Office fulfilling the stated requirements had the right to become an International Searching Authority” (paragraph 450 of the Summary Minutes at page 541 RWC).

⁶ For example, the Delegation of Israel gave the example that “... as long as the Spanish and Portuguese languages could not be handled by the International Patent Institute, the Latin American countries might wish to institute their own regional Searching Authorities...” (paragraph 455 of the Summary Minutes at page 541 RWC).

(b) (effective January 1, 2004) As a result of the introduction of the written opinion of the ISA it became necessary to be appointed as both an ISA and an IPEA.

(c) (effective April 1, 2007) A requirement was introduced to have in place a quality management system and internal review arrangements.

REQUIREMENTS AND PROCEDURES FOR APPOINTMENT

15. The requirements for an Office to be appointed and to operate as an International Authority are⁷:

(a) at least 100 full-time employees with sufficient technical qualifications to carry out searches and preliminary examinations;

(b) possession of, or (since July 1, 1992) access to, the PCT minimum documentation, properly arranged for search and examination purposes;

(c) a staff which is capable of searching the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated;

(d) (since April 1, 2007) the Office must have in place a quality management system and internal review arrangements in accordance with the common rules of international search; and

(e) (since January 1, 2004) the Office must be appointed both as an International Searching Authority and as an International Preliminary Examining Authority.

16. The Office must also conclude an agreement with the International Bureau setting out rights and obligations of the parties and formally undertaking to apply and observe all the common rules of international search and preliminary examination, this being taken to mean the PCT Articles and Rules relating to international search and preliminary examination as well as the PCT International Search and Preliminary Examination Guidelines. These agreements all follow a standard format; the main differences lie in the Annexes which indicate the States and languages for which the ISA agrees to act and the fees and refund policies which will apply.

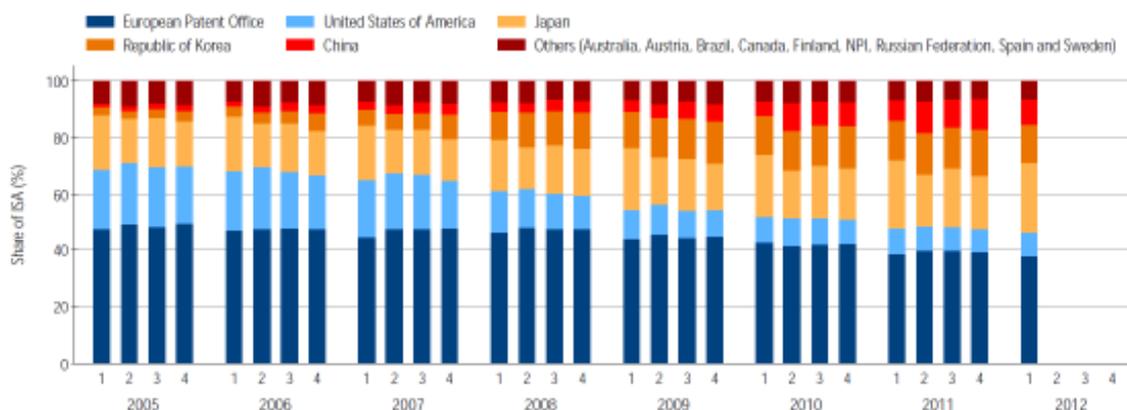
17. The decision to appoint an Office as an International Authority is made by the PCT Assembly, having heard the interested Office and, in principle, the advice of the CTC. However, as noted above, the advice of the CTC has in practice been regarded as a formality.

ACTIVITY OF INTERNATIONAL AUTHORITIES

18. The large majority of international searches are carried out by the European Patent Office (specified as ISA for 37.7% of international applications in Q1 2012), the Japan Patent Office (24.4%), the Korean Intellectual Property Office (13.6%), the State Intellectual Property Office of the People's Republic of China (9.1%) and United States Patent and Trademark Office (8.9%) (the distribution is very similar for international preliminary examination) – the remainder form 6.2% in total. The distribution of international searches requested from different Offices between 2005 and the start of 2012 is shown below.

⁷

As set out in equivalent terms in Rule 36 for ISAs and Rule 63 for IPEAs.



Source: WIPO Statistics Database, July 2012

Note: 2012 data are provisional and incomplete. NPI (Nordic Patent Institute).

19. Most of the International Authorities work predominantly for “their own” applicants, that is, ones which are nationals or residents of the State for which the national Office acts, or a Member State of the regional organization for which the regional Office acts. The exceptions are:

- (a) Australian Patent Office: around 38% of international searches are performed for applicants from other countries in the Asia-Pacific region and 12% for applicants from the United States of America;
- (b) Austrian Patent Office: acts exclusively for applicants from developing countries;
- (c) European Patent Office: around 23% of international searches are performed for applicants from the United States of America; acts as International Searching Authority for a large proportion of international applications from many Contracting States around the world;
- (d) Korean Intellectual Property Office: around 57% of international searches are performed for applicants from the United States of America;
- (e) Federal Service for Intellectual Property, Patents and Trademarks (Russian Federation): around 47% of international searches are performed for applicants from the United States of America;
- (f) Spanish Patent and Trademark Office: While the largest part of its work comes from Spain, the Office provides international searches for around 85% of international applications filed in Spanish around the world;
- (g) Swedish Patent and Registration Office: Around 20% of international searches are performed for applicants from neighboring countries, rather than Sweden.

ISSUES

20. During the 25th session of the CTC and the 43rd session of the PCT Assembly, the Delegations of Spain, Portugal and the Russian Federation and the representative of the European Patent Office stated that there was a need to review the requirements and procedures for appointment as an International Authority.

21. Clearly, the procedures and requirements provided for in the Treaty and the Regulations were set up in the context of the situation in 1970.

22. At that time, the fact of allocating the resources which were required to necessary to amass the entire PCT minimum documentation on paper and to arrange it and continually update it in a manner allowing it to be searched was in itself testament to a commitment to conducting searches at a high level of quality. Today, with the availability of electronic databases from a wide variety of sources, the patent part of the minimum documentation is effectively available for search by anyone and the challenge of searching the non-patent literature part is gradually reducing.

23. While the reason for the requirement of 100 examiners is not explicitly stated in the Records of the Washington Diplomatic Conference, it appears clear that this requirement is not relevant to the workload of the Office in its role as an International Authority, which might require the equivalent of one or two examiners or else several thousand examiners depending on the number of international applications for which the Authority is competent. Rather, it is usually assumed to have been an estimate of the minimum number of examiners required to understand the full range of technology in a depth sufficient to conduct a high quality search or preliminary examination. Even accepting this number as a reasonable initial assumption, it is not clear whether this has changed either as a result of improvements in searching technology (which might reduce the required number) or as a result of the ever increasing range and complexity of technology (which might increase the number).

24. The requirement under Rules 36.1(iii) and 63.1(iii) in relation to having a staff “which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated” has generally been taken to mean that a good range of language skills are expected in examiners, facilities are available to examiners for translation on demand and that abstracts in appropriate languages are provided to assist searching as far as possible. However, it is not clear how this type of requirement ought to be considered in the light of the combination of the greatly increased linguistic diversity within the PCT minimum documentation and the improvement in cross-language searching tools available to assist examiners who do not themselves understand all of the relevant languages.

25. The requirement for a quality management system was introduced in response to a proposal by the United Kingdom to the PCT Assembly, stating that “Quality standards for search and examination should be set out for International Search Authorities and International Preliminary Examination Authorities to meet.”⁸ However, this was implemented as a requirement for International Authorities to provide a more effective self-assessment of the extent to which they met the existing criteria for appointment and followed the “common rules of international search”.

26. As noted in paragraphs 14 and 15, above, the minimum requirements for appointment have been reviewed on three occasions in the past, but two of these were simply making necessary consequential changes to the reality of the fact that searching was increasingly conducted using electronic systems and the fact that International Searching Authorities were being called on to establish written opinions in addition to search reports.

27. However, on none of these occasions was serious consideration given to the questions as to:

- (a) whether the existing Rules and Guidelines truly reflect what is necessary to provide the high quality of international search and preliminary examination envisaged by the PCT; and

⁸ Paragraph 8 of document PCT/A/31/8.

(b) whether the implementation of the processes for appointment and extension of appointment of International Authorities are appropriate to the current wishes of the Contracting States, whether in terms of the number, regional and linguistic distribution of Authorities or the level of scrutiny which is considered appropriate of their ability to perform international search and preliminary examination to the necessary standard.

28. The Working Group is invited to comment on the questions raised in paragraph 27 of this document.

[Annex follows]

LIST OF APPOINTMENTS OF INTERNATIONAL SEARCHING
AND PRELIMINARY EXAMINING AUTHORITIES

Office	Capacity	CTC	PCT/A	Effective
AT	ISA+IPEA	-	1st session Apr 10 to 14, 1978	Jul 1, 1978
EP	ISA+IPEA	-	1st session Apr 10 to 14, 1978	Jul 1, 1978
GB	IPEA	-	1st session Apr 10 to 14, 1978	Jul 1, 1978 (ceased 1993)
JP	ISA+IPEA	-	1st session Apr 10 to 14, 1978	Jul 1, 1978
SE	ISA+IPEA	-	1st session Apr 10 to 14, 1978	Jul 1, 1978
SU (now RU)	ISA+IPEA	-	1st session Apr 10 to 14, 1978	Jul 1, 1978
US	ISA	-	1st session Apr 10 to 14, 1978	Jul 1, 1978
AU	ISA+IPEA	-	3rd session Apr 25 to May 1, 1979	Mar 31, 1980
US	IPEA	-	14th session Sep 8 to 12, 1986	Jul 1, 1987
CN	ISA+IPEA	13th session Sep 22 to 23, 1992	20th session Sep 21 to 29, 1992	Jan 1, 1994
ES	ISA	16th session Sep 21 to 22, 1993	21st session Sep 20 to 29, 1993	Sep 22, 1993
KR	ISA+IPEA	19th session May 26 to 30, 1997	24th session Sep 16 to Oct 1, 1997	Dec 1, 1999
ES	IPEA	-	30th session 23 Sep to Oct 3, 2001	Jun 1, 2003
CA	ISA+IPEA	20th session Sep 23 to Oct 1, 2002	31st session Sep 23 to Oct 1, 2002	Jul 26, 2004
FI	ISA+IPEA	20th session Sep 23 to Oct 1, 2002	32nd session Sep 22 to Oct 1, 2003	Apr 1, 2005
XN	ISA+IPEA	22nd session Sep 25 to Oct 3, 2006	35th session Sep 25 to Oct 3, 2006	Jan 1, 2008
BR	ISA+IPEA	23rd session Sep 24 to Oct 3, 2007	36th session Sep 24 to Oct 3, 2007	Aug 7, 2009
IN	ISA+IPEA	23rd session Sep 24 to Oct 3, 2007	36th session Sep 24 to Oct 3, 2007	-
EG	ISA+IPEA	24th session Sep 22 to Oct 1, 2009	40th session Sep 22 to Oct 1, 2009	-
IL	ISA+IPEA	24th session Sep 22 to Oct 1, 2009	40th session Sep 22 to Oct 1, 2009	Jun 1, 2012
CL	ISA+IPEA	25th session Oct 1 to 9, 2012	43rd session Oct 1 to Oct 9, 2012	-

[End of Annex and of document]