



PCT/A/50/3
ORIGINAL: ENGLISH
DATE: JULY 23, 2018

International Patent Cooperation Union (PCT Union)

Assembly

Fiftieth (29th Extraordinary) Session
Geneva, September 24 to October 2, 2018

APPLICATION FORM FOR APPOINTMENT AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

Document prepared by the International Bureau

SUMMARY

1. This document contains proposals for the introduction of an application form for use by Offices seeking appointment as an International Searching and Preliminary Examining Authority under the PCT.

BACKGROUND

2. At its forty-sixth session, held in Geneva in September 2014, the PCT Assembly adopted an Understanding setting out the procedures which Offices should follow when seeking appointment as an International Authority (see paragraph 12 of document PCT/A/46/6). This Understanding covered the procedural steps, but not the form and content of the application.

3. In February 2015, following inconclusive discussions as part of its mandate to review the substantive “minimum requirements” for appointment set out in PCT Rules 36 and 63, the quality subgroup of the Meeting of International Authorities Under the PCT recommended the elaboration of a standard application form for use by Offices seeking appointment as an International Authority (paragraph 50 of Annex II to document PCT/MIA/22/22, reproduced in document PCT/WG/8/2).

4. The International Bureau prepared draft versions of such an application form, which have been discussed by the quality subgroup and the Meeting of International Authorities since 2016. Those drafts have already formed the basis for the applications by the Turkish Patent and Trademark Office and the Intellectual Property Office of the Philippines, as well as many of the applications for extension of appointment considered at the thirtieth session of the PCT Committee for Technical Cooperation (PCT/CTC) in 2017 and were the subject of Circular C. PCT 1519, addressed to all Offices with roles under the PCT.
5. At the request of the twenty-fifth session of the Meeting of International Authorities (see paragraph 13 and paragraph 69 of Annex II to document PCT/MIA/25/13), the International Bureau prepared a further draft, taking into account the responses to Circular C. PCT 1519 and submitted it to the eleventh session of the PCT Working Group, held in Geneva from June 18 to 22, 2018 (see document PCT/WG/11/6). The proposal also contained a proposal for how the form might be introduced as a requirement of the application process.
6. The PCT Working Group invited the International Bureau to submit the proposals, with certain amendments, to the present session of the PCT Assembly (see paragraph 102 of document PCT/WG/11/26).
7. Subsequent to the Working Group, the International Bureau recognized the need to be able to further develop the application form based on experience gained. Consequently, the proposal also includes a mechanism allowing the form to be updated without a further formal decision of the Assembly, following consultation with Contracting States and Offices which act as International Searching Authorities, equivalent to the arrangement which applies to the PCT Administrative Instructions.

PROPOSALS

8. The Annex to this document sets out a proposed application form for appointment of an Office as an International Searching and Preliminary Examining Authority under the PCT, together with notes to help understand the appropriate content for each section.
9. In order to introduce this form as a requirement of the application process, it is proposed to modify paragraph (e) of the relevant Understanding of the Assembly as follows:

“Procedures for Appointment of International Authorities

“(a) A national Office or an intergovernmental organization (“Office”) seeking appointment is strongly recommended to obtain the assistance of one or more existing International Authorities to help in the assessment of the extent to which it meets the criteria, prior to making the application.

“(b) Any application for appointment of an Office as an International Authority is to be made well in advance of its consideration by the PCT Assembly so as to allow time for an adequate review by the Committee for Technical Cooperation (PCT/CTC). The PCT/CTC should meet as a true expert body at least three months in advance of the PCT Assembly, if possible back-to-back with a session of the PCT Working Group (usually convened around May/June of any given year), with a view to giving its expert advice on the application to the PCT Assembly.

“(c) Consequently, a written request to the Director General to convene the PCT/CTC is to be sent by the Office preferably by March 1 of the year in which the application is to be considered by the PCT Assembly and in any case in time to allow the Director General to send out letters of convocation of the PCT/CTC not less than two months prior to the opening of the session.

“(d) Any such application should be made on the understanding that the Office seeking appointment must meet all substantive criteria for appointment at the time of the appointment by the Assembly and is prepared to start operation as an International Authority as soon as reasonably possible following appointment, at the latest around 18 months following the appointment. With regard to the requirement that the Office seeking appointment must have in place a quality management system and internal review arrangements in accordance with the common rules of international search, where such system is not yet in place at the time of the appointment by the Assembly, it shall be sufficient that such system is fully planned and, preferably, that similar systems are already operational in respect of national search and examination work to demonstrate the appropriate experience.

“(e) ~~Any document by the Office in support of its application~~ A complete application for appointment for consideration by the PCT/CTC should be submitted to the Director General at the latest two months prior to the opening of the session of the PCT/CTC using the standard form made available for the purpose by the International Bureau. The application should contain all the information indicated as mandatory within the notes to that form. Where questions in the form are not relevant to the application, the Office should, where appropriate, replace the questions with alternatives which serve an equivalent purpose.

“(f) Any such application is then to be submitted to the PCT Assembly (usually convened around September/October of any given year), together with any advice given by the PCT/CTC, with a view to deciding on the application.”

10. It is therefore proposed that the Assembly adopt the following decision:

“The Understanding adopted by the PCT Assembly at its forty-sixth session, held in Geneva from September 22 to 30, 2015, concerning procedures for appointment of International Authorities, is modified by replacement of paragraph (e) with the following:”

“(e) A complete application for appointment for consideration by the PCT/CTC should be submitted to the Director General at the latest two months prior to the opening of the session of the PCT/CTC using the standard form made available for the purpose by the International Bureau. The application should contain at least the information indicated as mandatory within the notes to that form. Where questions in the form are not relevant to the application, the Office should, where appropriate, replace the questions with alternatives which serve an equivalent purpose.”

“The initial form provided for the purpose shall be set out in the Annex to document PCT/A/50/3. This form may be modified by the Director General following consultation with the Contracting States and International Searching and Preliminary Examining Authorities members of the PCT Committee for Technical Cooperation.”

“The procedures for appointment thus modified shall apply to any application for appointment as an International Authority submitted after the closure of the present session of the PCT Assembly.”

11. The Assembly of the PCT Union is invited to adopt the proposed decision set out in paragraph 10 of document PCT/A/50/3, relating to the introduction of an application form for appointment of an Office or intergovernmental organization as an International Searching and Preliminary Examining Authority under the PCT.

[Annex follows]

DRAFT APPLICATION FORM

**APPLICATION FOR APPOINTMENT AS AN INTERNATIONAL SEARCHING
AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT**

1 – GENERAL

- (a) **Name of Office or intergovernmental organization:**
- (b) **Date on which application for appointment was received by the Director General:**
[To be inserted by the International Bureau]
- (c) **Session of the Assembly at which appointment is to be sought:**
- (d) **Expected date at which operation as ISA/IPEA could commence:**
- (e) **Existing ISA/IPEA(s) assisting in assessment of extent to which criteria are met:**

2 – MINIMUM REQUIREMENTS FOR APPOINTMENT

2.1 – SEARCH AND EXAMINATION CAPACITY

Rules 36.1(i) and 63.1(i): The national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out searches and examinations.

- (a) **Employees qualified to carry out search and examination:**

Technical field	Number (in full-time equivalent)	Average experience as examiners (years)	Breakdown of qualifications
Mechanical			
Electrical/electronic			
Chemistry			
Biotech			
<i>Total</i>			

- (b) **Training Programs**

2.2 –MINIMUM DOCUMENTATION

Rules 36.1(ii) and 63.1(ii): That Office or organization must have in its possession, or have access to, at least the minimum documentation referred to in Rule 34, properly arranged for search purposes, on paper, in microform or stored on electronic media.

(a) Access to the minimum documentation for search purposes:

(b) Search systems:

2.3 – LANGUAGES

Rules 36.1(iii) and 63.1(iii): That Office or organization must have a staff which is capable of searching and examining 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.

(a) Language(s) in which national applications may be filed and processed:

(b) Other languages in which large numbers of examiners are proficient:

(c) Services available to assist search or understanding of prior art in other languages:

2.4 –QUALITY MANAGEMENT

Rules 36.1(iv) and 63.1(iv): That Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international search,

National quality management system meeting the requirements of Chapter 21 of the International Search and Preliminary Examination Guidelines:

3 – INTENDED SCOPE OF OPERATION

(a) Language(s) in which services would be offered:

(b) State(s) or receiving Office(s) for which Authority would offer to be competent:

(c) Limitations on scope of operation:

(d) Other International Authorities which would remain competent for applications filed at the Office in its capacity as receiving Office:

4 – STATEMENT OF MOTIVATION

5 – APPLICANT STATE(S)

(a) Regional location:

(b) Regional organization memberships:

(c) Population:

(d) GDP per capita:

(e) Estimated national R&D expenditure (% of GDP):

(f) Number of research universities:

(g) Summary of national patent information network:

(h) Major local industries:

(i) Major trading partner States:

(j) Other key information:

6 – PROFILE OF PATENT APPLICATIONS

(a) Number of national applications received – by technical field:

Year \ Technical Field	n-5	n-4	n-3	n-2	n-1
Mechanical					
Electrical/electronic					
Chemistry					
Biotech					
<i>Total</i>					

(b) Number of national applications received – by route:

Year \ Route	n-5	n-4	n-3	n-2	n-1
National first filing/internal priority					
Paris priority					
PCT national phase entry					

(c) Number of international applications received from nationals and residents of the State(s):

Year \ Technical Field	n-5	n-4	n-3	n-2	n-1
Mechanical					
Electrical/electronic					
Chemistry					
Biotech					
<i>Total</i>					

(d) Average time taken for national patent processing:

Indicator	Measured from	Time (months)
To search		
To first examination		
To grant		

(e) National workload:

Measure	Number of applications
All pending applications	
Applications awaiting search (where relevant fees have been paid)	
Applications awaiting first examination (where relevant fees have been paid)	

(f) Time and environment for examiners for search and examination:

(g) Quality of national search and examination:

7 – SUPPORT REQUIRED

8 – OTHER

9 – ASSESSMENT BY OTHER AUTHORITIES

NOTES ON COMPLETING THE APPLICATION FORM FOR APPOINTMENT AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

In accordance with the Understanding adopted by the PCT Assembly at its fiftieth session (see document PCT/A/50/3), all Offices or intergovernmental organizations (“Offices”) applying for appointment as an International Searching and Preliminary Examining Authority under the PCT should use this form. It should be submitted to the International Bureau, preferably by March 1 of the year in which the application is to be considered by the PCT Assembly and in any case not less than two months prior to the opening of the session of the PCT Committee for Technical Cooperation which is convened to give an opinion on the application.

The application form shall preferably be submitted in DOCX format, using the styles embedded within the template. Any text in diagrams should be limited to a minimum and be embedded or separately provided in a format or presentation which assists translation into the other five languages of documentation for the Committee for Technical Cooperation.

It is mandatory to complete sections 1 and 2 of the form. However, it is strongly recommended to complete all other sections in order to give Member States a rounded picture of the Office and the role which it proposes to play within the PCT System. The notes below provide further information on how to complete the different sections of the form.

Section 1 – General

1(b) The date on which the application for appointment was received should be left blank. This will be filled in by the International Bureau.

1(e) If your Office has followed the recommendation in paragraph (a) of the Procedures for Appointment of International Authorities adopted by the PCT Assembly (paragraph 25 of document PCT/A/46/6), indicate which Authority or Authorities assisted in your assessment. Assessments by those Authorities should normally be included either in section 9 or else as separate annexes to the application.

Section 2 – Minimum Requirements for Appointment

2.1 – Search and Examination Capacity

2.1(a) The breakdowns shown in the table template show an example of how an Office might set out the breadth and depth of experience among its examiners. However, the Office is free to set out information serving an equivalent purpose in a different way if it considers that it will provide a better understanding to members of the Committee for Technical Cooperation.

2.1(b) The Office should give details of the training programs for new examiners and ongoing training activities for existing examiners. This should cover general search and examination, special subject matters and training of trainers, including typical amounts of time spent on the different forms of training.

2.2 – Minimum Documentation

2.2(a) This item should consist of either: (i) a statement “The Office has full access to the PCT minimum documentation for searching”; or (ii) a statement that it has partial access. If the latter, the Office should indicate which areas of the documentation are currently unavailable to it and when and how the Office intends to obtain access to the relevant parts (this will need to be done before the PCT Assembly appoints the Office as an International Authority).

2.2(b) The Office should outline the systems (databases or paper collections) used for search of different forms of prior art. The scope of coverage of databases should be indicated if this is not either well known or obvious from the context. In general, the key interest is the scope of the collections available for search, rather than the particular tools.

2.3 – Languages

2.3(a) This item is provided as a baseline, since members of the Committee for Technical Cooperation should be able to assume without any further consideration that most, if not all, of the examiners will have excellent skills in the languages in which national applications may be filed and processed.

2.3(b) and (c) These items are primarily concerned with information which shows that examiners will be able to deal with cited documents in languages relevant to the PCT minimum documentation. However, information concerning any language may be included. The response to item (b) could usefully include information concerning the numbers of examiners and their distribution within technical fields for which the language expertise is available. The response to item (c) may usefully include information concerning machine translation integrated into search services or access available for examiners on demand to language specialists.

2.4 – Quality Management

The procedures for appointment of an Office as an International Authority (paragraph (d) of the Understanding in document PCT/A/50/3) recognize that the required quality management systems cannot be fully active at this stage. This section should therefore normally consist of a reference to an annexed report according to the template used by International Authorities indicating the extent to which the planned quality management system and the equivalent aspects of the Office's quality management systems with regard to national search and examination work meet the requirements of Chapter 21 of the PCT International Search and Preliminary Examination Guidelines and, where relevant, the adjustments which have been planned to ensure that the system will meet the requirements for operation as an International Authority.

The information directly contained within this section may usefully include a brief overview, including information concerning whether the standard is externally reviewed in conformance with ISO 9001 or another international standard, and for how long the system has been in operation.

If applying as an international organization consisting of a group of national Offices, the annexes should give details of the systems which apply at each national Office.

Where the application is made by an international organization consisting of a group of national Offices, this section should also outline the arrangements which will be made to ensure appropriate distribution, and consistent timeliness and quality of reports.

3 – Intended Scope of Operation

This section is intended to allow the Committee for Technical Cooperation to see how the Office would fit into the PCT System. Additional questions and answers may be added, if appropriate, to give a better understanding of relevant issues other than languages and geographical scope of intended operations.

4 – Statement of Motivation

This section allows the Office to provide a more general and rounded explanation of the reasons for making the application, in particular setting out the benefits which the Office expects appointment to bring to: (i) its State or region; (ii) the Office itself; and (iii) the PCT System as a whole.

5 – Applicant State(s)

Noting that most Authorities at the time of starting operations will be competent for applications from their own States and, perhaps, one or two neighbors, this section allows the Office to provide information on the likely levels of local demand for services of the Office if appointed and on the general level of support which is provided to innovation and related issues by the relevant government(s).

Where the applicant Office is an intergovernmental organization or a national Office which does not intend to offer services to its own nationals and residents, such information may not be relevant. In these cases, the section may be replaced by alternative information which better serves the function of providing information on the region from which applications are intended to be processed in the initial stages of operation.

5(a) A map may be included if this helps emphasize the location, membership of an intergovernmental organization making up the Office, neighboring States, key trade partners, intellectual property partners or other factors which might be relevant to the application.

5(b) It is not intended that Offices provide a comprehensive listing of all regional organization memberships, but it may be useful to highlight organizations which significantly affect the State's intellectual property, trading or technology transfer environment.

5(c) to (i) These items should be taken as examples of the types of facts and figures which may help demonstrate:

- the position of the Office with regard to industries and R&D activity at a national level which may depend on its services,
- the national intellectual property system which it currently supports; and
- the related intellectual property support services available to applicants which may use the Office in its future role as International Authority, which could either assist in developing the market for international applications under the PCT, or be bolstered by the appointment of the Office as an International Authority.

5(g) This section might, for example, include patent libraries or technology and innovation support centers.

5(j) This section might include a summary of or link to national innovation strategies or regional development plans involving IP, helping to show how the application fits within those strategies and plans.

6 – Profile of Patent Applications

This section is intended to provide information covering the Office's demonstrated expertise through having processed applications across all fields of technology. As most International Authorities are initially used largely by nationals and residents of their own States, this information, in combination with the information from Section 2, may also give an indication of the Office's capacity to absorb further work without risk of introducing major delays for either national or international work.

If this section is used, it is not necessary to follow the exact forms of table provided in the template. Alternative statistics or ways of breaking the information down may be used if this gives a better picture of the Office's work. However, if a different type of breakdown by technical field is used, it is desirable that this should be consistent with the indications of fields of expertise of examiners used in Section 2.1.

6(d) National systems vary considerably in details, such as when search and examination need to be requested. Consequently, Offices frequently measure performance in different ways. If this table is included, the indicator should therefore state whether it is measured from filing, priority, request for the relevant process or some other point. Where the national system includes optional routes with radically different effects (such as deferred examination), the indicators may be split into different categories. The Office should consider breaking the figures down by technology if there is a large variation between technical fields.

6(f) The Office may provide information on typical times per application which are spent on search and examination by examiners on national cases, or which would be expected to be allowed for international search and preliminary examination, based on preparatory studies. Details may also be given of the working environment which would be available to ensure that examiners were healthy and productive.

6(g) The Office may provide information demonstrating the quality of their national search and examination, for example by way of any comparative studies which had been conducted with equivalent applications searched and examined by the Office and other Offices.

7 – Support Required

It is expected that some degree of assistance will be needed by any Office seeking appointment to prepare and check all of the systems and processes necessary to begin operations as an International Authority, as well as ensuring their ongoing maintenance and correct development. However, Contracting States should be able to assume that an Office which states that it meets the criteria for appointment is, for the most part, capable of "standing on its own feet" and know whether there will be calls for major assistance to meet needs made urgent by the fact of appointment.

This section should include an indication of what assistance will be sought from the International Bureau or other Contracting States in respect of completing preparations to become an International Authority, for example to train examiners or to develop IT systems to deal with new Forms, communications and workflows.

This section is not intended to include information concerning technical assistance outside of matters which will be required to support the Office's operation as an International Authority, even though it might well be the case that a successful appointment as part of an effective national IP strategy may increase the local demand for patent applications, with a resulting need for greater assistance in these wider issues.

8 – Other

This section offers a space for the inclusion of comments which are considered relevant to the application which do not fit elsewhere.

9 – Assessment by Other Authorities

This section may either include assessments by the Authorities (if any) referred to in section 1(e), or else refer to such assessments submitted separately as annexes.

[End of Annex and of document]