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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PATENT COOPERATION TREATY (PCT)**

**Fourteenth Session
Geneva, February 5 to 7, 2007**

REPORT

adopted by the Meeting

INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its fourteenth session in Geneva from February 5 to 7, 2007.
2. All of the 13 International Searching and Preliminary Examining Authorities were represented at the session: the Austrian Patent Office, the Canadian Intellectual Property Office, the European Patent Office, the Federal Service for Intellectual Property of the Russian Federation, IP Australia, the Japan Patent Office, the Korean Intellectual Property Office, the National Board of Patents and Registration of Finland, the Nordic Patent Institute, the Spanish Patent and Trademark Office, the State Intellectual Property Office of the People’s Republic of China, the Swedish Patent and Registration Office, and the United States Patent and Trademark Office.
3. The list of participants is contained in Annex I.

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OPENING OF THE SESSION

4. Mr. Francis Gurry, Deputy Director General, on behalf of the Director General, opened the session and welcomed the participants. He greeted especially the representatives of the Nordic Patent Institute, which was represented for the first time in the Meeting. The session was chaired by Mr. Gurry.

ADOPTION OF THE AGENDA

5. The Meeting adopted for its agenda the draft contained in document PCT/MIA/14/1, subject to the addition of a further item, "Miscellaneous".

RENEWAL OF AGREEMENTS BETWEEN THE INTERNATIONAL AUTHORITIES AND THE INTERNATIONAL BUREAU

6. Discussions were based on document PCT/MIA/14/2, which contained a draft model Agreement between an International Authority and the International Bureau proposed for consideration in the context of negotiations for renewal of the present Agreements under PCT Articles 16(3) and 32(3).

7. The United States Patent and Trademark Office stated that it was not yet in a position to provide fully considered comments on the draft model Agreement.

8. The Chair expressed the view, in response to a question by one Authority, that it was not mandatory, having regard to PCT Articles 16(3) and 32(3), for the Agreements with all Authorities to contain the same Articles or for corresponding Articles to be identically worded, but suggested that uniformity was desirable, where possible, in order to avoid divergence and ambiguity, noting that the present Agreements in fact reflected a high degree of uniformity. One Authority stated its view that the Agreements with all Authorities should, so far as possible, be identical in wording.

9. Comments were made on several particular Articles of the draft model Agreement, as noted in the following paragraphs.

10. *Article 3(2)*: The Swedish Patent and Registration Office noted that the Annex under this provision, in the Agreement with it, would need to mention both the languages in which, and countries for which, it was competent to act.

11. *Article 3(4)*: This provision, which appeared in the present Agreement with the European Patent Office but in no other, expressly governed the circumstances in which that Office could outsource PCT search and examination work to national Offices of European Patent Convention member States and limit its competence for reasons of workload. It was clarified that this provision was not proposed for all Authorities but was illustrative of the kind of clause which might be included in any model Agreement.

12. Two Authorities opposed the inclusion of a standard provision governing how and by whom the work of Authorities could be performed, noting that it was within the prerogative of each Authority to decide, as it saw fit, how work should be undertaken by it or under its responsibility, provided that the requirements of the Treaty and the Regulations were met.

13. One Authority expressed the view that provisions governing outsourcing of work (cf. Article 3(4)(a)(i)) and limitations on competence (cf. Article 3(4)(a)(ii)) should be included in the Agreements with all Authorities, but noted that the wording should be more general than the specific wording set out in draft Article 3(4), which related only to the European Patent Office.

14. In connection with outsourcing of work, the same Authority noted that PCT Article 16(1) provided that “[i]nternational search shall be carried out by an International Searching Authority”, and expressed the view that this would preclude the outsourcing of work in the absence of an express enabling provision in the relevant Agreement under PCT Article 16(3)(b). The Authority similarly believed that any limitations on competence should also be invoked on the basis of an enabling clause in the Agreement, which might or might not be used by any particular Authority.

15. The Authorities mentioned in paragraph 12, above, expressed the view that the wording of PCT Article 16 did not preclude outsourcing of work and that the matter was within the discretion of each Authority. One Authority emphasized that it was of course necessary that any work done be undertaken under the responsibility of the Authority concerned. The other Authority agreed that different considerations might apply on the question of limitations on competence, particularly in relation to providing information about any such limitations.

16. One Authority stated that the wording of Article 3(4)(a)(i) was too broadly expressed.

17. The Chair observed that it may be best, in preparing a revised draft model Agreement, to separate the questions of outsourcing and limiting competence, and expressed the view that it might be possible to find a general wording which would avoid the difference in views. One approach might be to focus on ensuring that information about the practices of Authorities was made available rather than on the legal basis for those practices.

18. *Article 5(2)*: In response to a question by one Authority, the Chair agreed with the view that an Authority was not obliged to give any refund of the search fee except if such a refund was provided for in Annex C of the Agreement with that Authority, the contents of which were essentially a matter for the Authority to decide, noting that the operation of PCT Rule 16.3 expressly depended on the provisions of the relevant Agreement. The Secretariat stated that it was nonetheless desirable for Authorities to refund the search fee in appropriate circumstances. In response to a suggestion by the Secretariat that the provision should be modified if amendments of the Regulations were adopted providing for earlier national searches to be taken into account by the International Searching Authority, one Authority stated its view that the existing wording of Article 5 should be retained unchanged.

19. *Article 12(1)*: The erroneous reference in this provision to December 31, 2007, should be corrected to read December 31, 2017.

20. *Annex C, Part I*: In response to a question by one Authority, the Chair suggested that it would not be necessary to refer in Annex C of the Agreements to the fees charged under PCT Rule 16*bis*, since that provision related to the charging of a fee by the receiving Office rather than an Authority.

21. *Annex C, Part II, paragraph (3)*: One Authority noted that the reference in this provision to refunds of between 25 and 50% of the international search fee should, consistent with the existing Agreements, be to refunds of between 25 and 100%. Another Authority

noted that this paragraph was not a mandatory one but rather that the amount of such refunds was a matter for determination by the Authority concerned.

22. The Meeting:

(i) noted that consultations needed to be undertaken in sufficient time to enable final draft Agreements to be agreed between each Authority and the International Bureau by the end of July 2007, thus enabling timely submission of the drafts to the PCT Committee for Technical Cooperation and the PCT Union Assembly for consideration in September–October 2007;

(ii) invited Authorities each to nominate to the Secretariat a contact person for the purposes of the consultations;

(iii) agreed that the consultations should be undertaken via the PCT/MIA electronic forum.

PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

23. Discussions were based on document PCT/MIA/14/3.

24. The Meeting thanked the United States Patent and Trademark Office for its work on the proposals and provisionally agreed on the proposed modifications of the PCT International Search and Preliminary Examination Guidelines (“the Guidelines”), subject to the comments set out in the following paragraphs.

25. *General:* Modifications to the Administrative Instructions had been proposed in circular C. PCT 1089, but the finalized modifications had not yet been promulgated. Furthermore, consultation procedures were about to begin on modifications to the Receiving Office Guidelines, which might have relevance to the International Authorities, at least insofar as these modifications affected the processing of missing elements and parts of international applications.

26. The Meeting agreed that the Secretariat should, before promulgation of the final version, check the consistency of the Guidelines as proposed to be modified with the modified Administrative Instructions and the proposals for modification of the Receiving Office Guidelines, and that any further modifications should be the subject of consultation via the PCT/MIA electronic forum.

27. *Paragraph 6.13(i):* The words “being a date falling within the period of 12 months preceding the international filing date” should be deleted.

28. *Paragraph 8.02:* It was agreed to delete the second sentence (“No special attributes should be ascribed to the person in the competent Authority ...”). Although similar words had been used in the documents prepared for the discussions in the Working Group on Reform of the PCT (“the Working Group”) leading to adoption of amendments of PCT Rule 91, it was agreed during those discussions that it would be up to the Authority concerned to decide whether a proposed rectification of an obvious mistake should be referred to an examiner or to clerical staff having no special technical knowledge. One Authority indicated that it might wish to make further proposals in relation to this item in the future if appropriate wording could be found.

29. *Paragraph 8.05:* One Authority considered the final sentence of this paragraph to be confusing because it had already been stated that evidence in the priority document may be taken into account and that it would not be clear what was intended by this further statement. Nevertheless, it was agreed to maintain the text as proposed.

30. *Paragraph 16.67:* Several Authorities opposed the introduction of the words “or inventive step (Article 33(3))”, stating that existing paragraph 16.67 correctly reflected a long-standing interpretation of PCT Rule 33.1(c) whereby patent documents filed prior to the international filing date were cited only if they were relevant to novelty and not if they were relevant to inventive step. It was observed that, in a large majority of national procedures, such documents would only be considered relevant in respect of novelty.

31. It was agreed that the specific references both to novelty and to inventive step should be omitted. The United States Patent and Trademark Office considered that the above noted interpretation of PCT Rule 33.1(c) was incorrect and reiterated its view that, whatever the wording of this paragraph, Authorities were required by Rule 33.1(c) to include “E” category documents which were relevant to inventive step. Paragraph 16.67 had replaced the clear statement in paragraphs VI-3.1 and VI-8.24 of the old PCT International Search Guidelines, and it was only due to an oversight during drafting and not on the basis of an informed decision of the Meeting that that paragraph had changed. The Office believed that Rule 33.1(c) had been deliberately drafted to ensure that the international search report would be as extensive as possible, in principle listing all documents which might form relevant prior art under the national laws of any Contracting State, and that it was irrelevant that this might be inconsistent with the practice of particular International Searching Authorities in respect of their actions as national Offices.

32. *Paragraph 17.28:* It was agreed to delete the words in square brackets (“[or else an indication that the priority claim had been checked and was considered to be valid]”).

QUALITY FRAMEWORK

33. Discussions were based on document PCT/MIA/14/4. The Meeting noted the reports on the quality management systems that had been prepared by each of the Authorities, submitted to the Secretariat and made available on the PCT/MIA electronic forum. The reports had been prepared using templates for the purposes of reporting in accordance with Chapter 21 of the PCT International Search and Preliminary Examination Guidelines that had been developed by the European Patent Office and adopted by the Meeting at its 13th session, held in May 2006.

34. There was general satisfaction with the templates used by Authorities in preparing the reports. The European Patent Office noted that the reports were not intended to be prepared *pro forma* but rather should be expected to contain both positive and negative aspects, based on each Authority’s assessment of its own progress in implementing quality management systems. The contents of a frank report would be valuable not only for the Authority concerned but also for other Authorities in learning lessons from the experience of others.

35. The European Patent Office recalled that it had been charged with leading further work on the PCT search and examination quality framework by a decision of the Meeting at its 13th session but stated that recent developments in the European context, in particular the development of a European Quality System in the framework of the intended establishment of

the European Patent Network, had prevented it from making much progress on this matter. The Office noted the importance of those developments for the further work on the PCT search and examination quality framework and suggested that further work by the Meeting on the PCT quality framework, which the Office was prepared to continue to lead, should await progress in the European context.

36. The Meeting:

(i) noted the reports on quality management systems that had been submitted by all International Authorities, agreed that the templates used provided a satisfactory basis for preparing such reports, and invited Authorities to provide comments, via the PCT/MIA electronic forum, on the usefulness of the templates;

(ii) agreed that those reports should be made publicly available on WIPO's website, subject to possible revision by the Authorities concerned in the light of the discussion by the Meeting;

(iii) agreed that the report of the present session of the Meeting concerning the quality framework should form the basis of a report to be transmitted to the Assembly in accordance with Chapter 21 of the PCT International Search and Preliminary Examination Guidelines, and invited the Secretariat to prepare a draft report to the Assembly which would be the subject of consultation with Authorities via the PCT/MIA electronic forum;

(iv) accepted the European Patent Office's offer to continue to lead further work on a number of matters relating to the development of quality systems on which a common approach might be desirable, including quality standards, manuals and documentation, examiner skills and training, and metrics useful for measuring quality, and expressed its gratitude to the Office for its contributions;

(v) agreed that such further work should await developments with regard to the establishment of a European Quality System in the framework of the intended establishment of the European Patent Network, and invited the European Patent Office to report on such developments to the next session of the Meeting.

PCT REFORM PROPOSALS WITH RELEVANCE TO THE INTERNATIONAL AUTHORITIES

International Search: Use of Results of Earlier National Search

37. Discussions were based on document PCT/MIA/14/5.

38. One Authority opposed the proposal to amend the PCT Regulations to permit applicants to request that the international search report be based on one or more searches performed by an Office other than the International Searching Authority that is to undertake the international search. The Authority noted the lack of a quality control system for search reports established by national Offices other than those which act as International Searching Authorities and, consequential thereto, the difficulties in establishing the appropriate fee reductions to be granted to applicants. It also suggested that, should the proposals proceed, provisions should be included to require the applicant to provide a translation of any earlier

search report into a language accepted by the International Searching Authority that is to undertake the international search.

39. All other Authorities which took the floor on this matter supported the proposal, provided that the proposed amendments to the Regulations to be submitted to the Working Group on Reform of the PCT left it to each Authority to decide, if so requested by the applicant, whether and to which extent to use the results of any earlier search, and whether and to which extent to refund the international search fee to the applicant. The Chair stated that the proposal would distinguish between earlier searches by the same Authority and earlier searches by another Office.

40. As to the timing of a request by the applicant that the international search be based on the results of an earlier national search, one Authority expressed the view that such request should be made upon filing of the application. As to whether it should be a requirement that such request could be made only in respect of the results of earlier searches on applications the priority of which is claimed in the international application, one Authority expressed the view that it would be sufficient to require that the earlier search was carried out in respect of a “corresponding” application.

41. The Meeting noted the intention of the Secretariat to post draft proposed amendments of the Regulations relating to the use of the results of earlier national searches on the PCT/MIA electronic forum for comments by Authorities, and to subsequently submit those proposals, taking into account any comments received, to the Working Group on Reform of the PCT for consideration at its ninth session, to be held in April 2007.

Supplementary International Searches

42. Discussions were based on document PCT/MIA/14/7.

43. In introducing the matter, the Secretariat informed the Meeting of the results of further informal discussions undertaken with the European Patent Office and the United States Patent and Trademark Office, seeking to address the divergence of opinion outlined in paragraphs 10 and 12 of document PCT/MIA/14/7. Following those discussions, the Secretariat proposed to address some of the issues outlined in those paragraphs as follows:

(i) *time limit for filing a request for supplementary international search (see document PCT/MIA/14/7, paragraph 12(d))*: applicants should be free to file a request for supplementary search with the International Bureau at any time after the filing of an international application but not later than 19 months from the priority date; any such request should not be forwarded by the International Bureau to the International Searching Authority requested to carry out the supplementary search before the expiration of 17 months from the priority date, unless the main international search report had been received by the International Bureau before the expiration of that time limit; consequently the supplementary search would always be a “sequential” one, allowing it to take into account the main international search report, except in cases where that report was established significantly late;

(ii) *determination of unity of invention*: the supplementary Authority should be free to make its own determination of unity of invention; should that Authority find non-unity, it should only be required to search the “main” invention, to be identified (similar to today’s Chapter II procedure) by that Authority or the applicant (in cases of doubt, the invention first

mentioned in the claims would be considered to be the main invention); applicants should have the opportunity to request a review of any non-unity finding by the supplementary Authority, for example, by an internal review body of that Authority, but such a finding should not be subject to a full-fledged protest procedure as in the case of the main search;

(iii) *relationship between supplementary international search and international preliminary examination*: each supplementary Authority should be free to specify in its agreement with the International Bureau that it would not carry out a supplementary search where it had received, in respect of a particular international application, a demand for international preliminary examination; further consideration should be given to the question of whether the filing of a request for supplementary search should more generally be considered a renunciation (“waiver”) by the applicant of the right to file a demand for international preliminary examination with *any* International Preliminary Examining Authority.

44. As on previous occasions, there remained no consensus among Authorities as to the desirability of introducing a supplementary international search system into the PCT.

45. The general idea of introducing a supplementary international search system was opposed by two Authorities. The Japan Patent Office noted that the objectives of a supplementary search would be similar to those of a national prior art search conducted by a national Office which also acted as an International Searching Authority, and that no difference could be found between an international search report and a national search report in terms of the functions of those reports as well as their contents. Thus, in its view, no good reason could be found to institutionalize in the PCT system a new type of international search which would go beyond the national search. Rather, if an International Searching Authority wished to conduct an international search beyond the extent of a national search (for example, if it wished to carry out a prior art search in documents which are in a different language than that covered by its national search), it should consider offering such a search as an additional service, and possibly outsource that work if there was a need to bring in language specialization not available within the Authority. Furthermore, the Japan Patent Office expressed its concern that a supplementary search system, with more than one Authority establishing an international search report, would make the individual Authority’s responsibility for the establishment of the international search report unclear, and stated that it preferred a decentralized system under which Authorities would compete with each other to provide better and more user-friendly services. The Office also voiced its concern about the discrimination of specific languages, such as, for example, Japanese, noting that the burden of carrying out searches in documents in such a language would be shifted to the Authority which had such language as its main working language, and stated that it could not accept such a shift. The statement made by the Japan Patent Office is set out in full in Annex II.

46. The Spanish Patent and Trademark Office stated that, in its view, the proposed supplementary search system would be contrary to the philosophy of the PCT system, whose goal was to have a single search of high quality, and would be tantamount to recognizing the insufficiency of the present (main) international search. It expressed its concerns about the complexity added to the system, the duplication of work, and the effect and consequences for applicants and national Offices if the main and the supplementary search reports contained different or even contradictory prior art citations.

47. IP Australia stated its support in principle for the concept of a single authoritative report and expressed some sympathy for the arguments put forward by those Authorities which

opposed the introduction of the new system. However, it stated that it would not oppose the introduction of a supplementary search system, recognizing that such a system could assist in addressing language-related problems of the current international search. With respect to the detail of the proposals, it welcomed the progress towards ensuring that the system used sequential searching as far as practical, but stated that it would also support a time limit of 22 months from the priority date for requesting a supplementary search.

48. The State Intellectual Property Office of the People's Republic of China stated that it would not oppose the principle of permitting supplementary searches to be carried out in order to improve the quality of international searches. It emphasized, however, that the primary purpose of the supplementary search should be to overcome the language-related insufficiencies of the main international search. If the supplementary search went beyond this primary purpose, the disadvantages caused by the supplementary search system, such as increasing the complexity of the system, reducing the efficiency of the international search, causing duplication of work and waste of resources, and putting more burden on both Authorities and applicants, etc., would surpass the possible advantages to be obtained from such system. It was for those reasons that it strongly opposed the introduction of a concurrent supplementary search system. Furthermore, the State Intellectual Property Office of the People's Republic of China reiterated that the main approach to improving the quality of international searches should be to improve the quality of the main search and to rely on utilizing the existing international search mechanism to the largest extent. The International Bureau should thus focus all of its efforts on measures to achieve this goal, such as establishing stricter and clearer standards and rules for international search, and encouraging all Authorities to communicate more frequently and efficiently on how to improve the quality of the main search, rather than pinning its hopes on a system of supplementary searches. It expressed the view that, in any case, the proposed supplementary search system should and could only be a supplementary means and should in no case materially change the existing international search system.

49. Eight Authorities supported the proposals for a supplementary international search system, reiterating the strong desire of users for the introduction of such a system, and noting the aim of improving the basis on which applicants could make the decision whether to proceed with the application into the national phase such system and the aim of avoiding new and surprising citations of prior art in the national phase. While the Authorities were not in a position to express views on the specifics of the new proposals, they welcomed the progress made towards reaching agreement noted in paragraph 43, above.

50. Some of those Authorities emphasized that the system was intended to be used only where the applicant saw a specific need. It was likely that applicants would only request a supplementary search from an Authority in cases where there was a strong intention to enter the national phase in the country whose Office acted as that Authority. If an Authority carried out a search in the international phase which in any case would have been done by the same Office in the national phase, work was simply being brought forward in time. Furthermore, the fact that this work was done in the international phase might save much work by other designated Offices in the national phase.

51. The European Patent Office further stated that it did not consider that the proposals for a supplementary search system reduced the scope for introducing competition between International Searching Authorities. In addition, the supplementary search proposal had no bearing on the question of outsourcing of work if an Authority felt that this was a good

method of addressing language issues, but rather provided an alternative route for addressing a real current problem.

52. The Federal Service for Intellectual Property of the Russian Federation expressed concern at the idea that perceived language deficiencies should be addressed by outsourcing part of the search. While this might be an option for some Authorities, issues of confidentiality were involved and in some States the Office might be the only body competent to act in matters of search.

53. The Meeting noted the intention of the Secretariat to post draft proposed amendments of the Regulations relating to supplementary international searches on the PCT/MIA electronic forum for comments by Authorities, and to subsequently submit those proposals, taking into account any comments received, to the Working Group on Reform of the PCT for consideration at its ninth session, to be held in April 2007.

STANDARD OF DRAWINGS REQUIRED FOR INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION

54. Discussions were based on document PCT/MIA/14/6.

55. The Meeting agreed that defects in drawings could cause significant problems for Offices and applicants, both during international search and preliminary examination and during the national phase, noting that it may be impossible for an Authority to judge an international application properly if it was not able to identify the details of the drawings, except that one Authority stated that it did not see any problems in drawings checked by current procedures conducted by its own receiving Office. Furthermore, it was noted that correcting defects in the national phase may be difficult if the relevant features, because of problems in reproduction, were only visible on the home copy or the record copy but not in the international application as published, since the original drawings could not readily be accessed by a designated Office for comparison with replacement sheets. One Authority stated that it had recently performed its own assessment of drawings received as an International Searching Authority and found that significant problems were more common than had previously been appreciated.

56. It was observed that the examples shown in document PCT/MIA/14/6 generally fell into two categories: those where a photograph or greyscale diagram with poor contrast had been provided, which could not be scanned accurately; and those where drawn figures had not been prepared in accordance with the requirements of PCT Rule 11. It was noted that the first category caused more difficulties for Authorities and that the problem was significantly reduced in the case of applications filed electronically, where no scanning was required.

57. Concern was expressed over whether receiving Offices applied the requirements of PCT Rule 26 consistently. It was suggested that many of the problems could be avoided by a stricter application of some of the provisions of Rule 11, though it was also noted that other parts of Rule 11 were stricter than seemed to be necessary. It was suggested that some receiving Offices might be reluctant to invite the correction of defects in view of the extreme sanction of the international application being possibly considered withdrawn in the event of failure to comply. Concern was also raised at the prospect of the introduction of added subject matter in corrected drawings, which might be difficult to assess in the national phase.

58. Possible measures to be considered included:

- (a) allowing for the filing of photographs in electronic form even where the remainder of the application was filed on paper;
- (b) reviewing the Receiving Office Guidelines with a view to clarifying which requirements of Rule 11 were significant for ensuring satisfactory international publication and ensuring that the needs of International Authorities were met;
- (c) recommending that some defects (such as illegibly small diagrams as shown in Example 4 of the Annex to document PCT/MIA/14/6) should not be permitted to be the subject of corrections before the receiving Office but rather should be referred to the International Searching Authority for authorization of the rectification of an obvious mistake, in view of the risk that added subject matter may not otherwise be identified;
- (d) reviewing the requirements of Rule 11 itself with a view to clarifying the requirements which were necessary to ensure appropriate quality reproduction of patent applications, noting the present needs of applicants for adequately representing inventions;
- (e) reviewing Rule 26 and related Rules with a view to clarifying how, when and by whom checks should be performed on whether the drawings meet the appropriate requirements.

59. It was noted that the Working Group had proposed to establish a task force relating to the possible revision of Rule 11 but that to date no proposals for amendment of that Rule had been made. It was felt not to be possible to conduct a full scale review of Rule 11 in time to submit proposals to the Working Group's ninth session in April 2007.

60. The Meeting agreed that the International Bureau should consider how best to address the issues outlined above, whether by modification of the Receiving Office Guidelines or by amendment of the Regulations under the PCT. Proposals should be discussed via the PCT/MIA electronic forum and submitted to the Meeting for discussion at its next session. Work should initially focus on matters relating to drawings, though extension of the task to include a broader review of Rule 11 and related matters might be considered at a later stage. Any proposals agreed by the Meeting should then be the subject of appropriate broader consultation, prior to promulgation of modifications of the Guidelines or the Administrative Instructions, or submission of proposals for amendment of the Regulations to the Assembly.

PCT MINIMUM DOCUMENTATION

61. The Secretariat recalled that, in recent years, the PCT minimum documentation had been updated to include various traditional knowledge-related journals into the list of non-patent literature and to add patent documents from the Republic of Korea to the list in PCT Rule 34. These actions were to be followed by a comprehensive review of the definition of the PCT minimum documentation. Such a review had begun, but progress had been slow and now appeared to have halted.

62. The Meeting agreed that the review process should be restarted and pursued as a matter of priority. The European Patent Office offered to continue to lead this task and agreed to make proposals as to how to proceed.

PCT STATISTICS

63. The Secretariat presented statistics representing PCT filing and processing trends in 2006, based on provisional figures (since not all notifications from receiving Offices had yet been received). There had been an estimated 145,300 filings, representing a 6.4% increase overall, with particularly large increases in filings in the Republic of Korea, China, Italy and Israel. There was no change in the top 5 applicants, but significant increases in use of the PCT by several companies now in the top 20. 31% of international applications were filed in fully electronic form and only 44% were filed on paper only. 19 receiving Offices, including several larger ones, now offered electronic filing, offering the possibility of further significant increases in electronic filing in the coming year. A new method of breaking down applications by technical field was demonstrated, based on the international classification of the applications, but grouping them in a way which it was hoped would be more meaningful to economists and others using the statistics.

64. Following deployment of IT systems and other internal changes in work practices, the work done by the International Bureau (measured by record copies received and publications made) had increased significantly, with a reduction in the number of staff involved, though it was observed that the latter was partially offset by an increase in the outsourcing of translation work. There had been an increase in timeliness of (first) publications of international applications. There had also been improvements in relation to republication (for example, where an international search report is received too late to be included in the main publication), but there was scope for significant improvement in the processes involved, which presently may take several months in some cases.

65. There had not been any significant trend in the timeliness of international search reports. The search report was received by the International Bureau before 16 months from the priority date for 56% of international applications. 18% were received later than 20 months from the priority date. Demands for international preliminary examination were still decreasing, but less rapidly than before. Use of Chapter II appeared to be stabilizing at about 10 to 15% of international applications.

66. Aggregate national phase entry statistics were now being received for 40 to 50 designated Offices. Information on the entry into the national phase of individual international applications is currently received from 27 designated Offices and the relevant information is available through PatentScope on WIPO's website.

67. The Meeting noted the presentation by the Secretariat on PCT statistics.

MISCELLANEOUS

Receipt of IPC Codes from International Searching Authorities

68. The Secretariat noted that in recent weeks there had been a worrying increase in the number of international applications published without International Patent Classification (IPC) codes; in the final 2 weeks of January, over 7% of international applications published had not been classified. This would have a serious effect on the work of International Searching Authorities as well as others searching patent information. The International Bureau would be contacting most of the Authorities in the near future, asking them to review the processes which were in place for supplying IPC codes for international applications

where the international search report had not been established in time for the classification information contained in it to be included in the international publication.

Information Concerning Demands

69. The Secretariat reported that the International Bureau was still not reliably receiving information concerning the receipt of demands by International Preliminary Examining Authorities. As a consequence, international preliminary reports on patentability under Chapter I were being prepared which should not have been, since a Chapter II report was to be established. Of particular concern was the case where such Chapter I reports were established in a language other than English, since these had to be translated, which put a strain on resources in an area that was already under particular pressure. In addition to the unnecessary work involved for the International Bureau, confusion could be caused for applicants, third parties and elected Offices by the establishment and transmittal of the incorrectly established Chapter I report. The International Bureau was analyzing the frequency and origin of the demands in question and would be contacting the Authorities concerned shortly. In the meantime, Authorities were requested to ensure that their systems for notifying demands to the International Bureau under Rule 61 were reliable.

Search Report-Related Information

70. The Secretariat stated that it would like to investigate the possibility of receipt of information relating to international searches at an earlier stage where such information is held in reliable electronic form by International Searching Authorities, in order to streamline processes leading to international publication. Examples might include classification and abstract information, once this had been established by the Authority with little likelihood of being changed prior to establishment of the international search report.

Search Strategies

71. The Secretariat reported that no progress had been made in respect of transmission to the International Bureau of search strategy information from International Searching Authorities (see paragraphs 41 to 46 of document PCT/MIA/13/8) but that it was intended to approach the International Authorities which had indicated interest in this matter shortly to assess requirements. The European Patent Office noted that this subject was linked to the matter of quality standards and, in view of the ongoing discussions on that subject in the context of the European Patent Organisation (see paragraph 35, above), it would not be in a position to consider the subject further at this stage.

Citations of Non-Patent Literature

72. The International Bureau observed that it would be desirable if the PCT system permitted third parties to locate non-patent literature citations as easily as possible. It was also noted that, even where such citations were only available on payment of a fee, publishers often offer a free abstract which could assist interested parties in deciding whether to order copies of the full citation. It might therefore be desirable for the Standards and Documentation Working Group of the Standing Committee on Information Technologies (SCIT) to consider reviewing the standards relating to citation of non-patent literature (see in particular WIPO Standard ST.14) so as to ensure that the standards are defined and used in the most useful way, having regard to current methods of publishing and to the utility of providing links to cited documents from electronic systems.

FUTURE WORK

73. The Meeting noted that it was envisaged that the next session would be held in February or March 2008 and gratefully accepted the offer of the Austrian Patent Office to host the session at its headquarters in Vienna.

[Annexes follow]

ANNEX I

LIST OF PARTICIPANTS

I. INTERNATIONAL AUTHORITIES

(in the English alphabetical order of their names)

AUSTRIAN PATENT OFFICE

Peter HOFBAUER, Head, PCT Department

CANADIAN INTELLECTUAL PROPERTY OFFICE

J. Scott VASUDEV, Chief, Patent Administrative Policy, Classification and International Affairs Division, Patent Branch

Nathalie C. TREMBLAY (Ms.), Project Officer, Patent Administrative Policy, Classification and International Affairs Division

Sara WILSHAW (Mrs.), First Secretary, Permanent Mission, Geneva

EUROPEAN PATENT OFFICE

Colin PHILPOTT, Principal Director, Principal Directorate 2.02, Quality Management

Hubert PLUGGE, Director, Directorate 2.0.22, Quality Management Support

Mark WEAVER, Director, Directorate 2.0.21, Practice and Procedure

Brian DERBY, Principal Lawyer, Directorate 5.2.5, International and Legal Affairs (PCT)

FEDERAL SERVICE FOR INTELLECTUAL PROPERTY OF THE
RUSSIAN FEDERATION (ROSPATENT)

Alexey GVINEPADZE, Deputy Director, Federal Institute of Industrial Property

Andrei ZHURAVLEV, Head, Control and Legal Support Division, Federal Institute of Industrial Property

Gennady NEGULYAEV, Chief Researcher, Information Resources Development Department, Federal Institute of Industrial Property

IP AUSTRALIA

Robert FINZI, Supervising Examiner of Patents

JAPAN PATENT OFFICE

Tsuyoshi ISOZUMI, Deputy Director, International Affairs Division, General Affairs Department

Hiroshi KAWAMATA, Deputy Director, Examination Standards Office, Administrative Affairs Division, First Patent Examination Department

Kenichiro NATSUME, First Secretary, Permanent Mission, Geneva

KOREAN INTELLECTUAL PROPERTY OFFICE

Jooik PARK, Counsellor, Permanent Mission, Geneva

Seiyoung YOON, Senior Deputy Director, Patent Examiner Policy Team, Electric and Electronic Examination Bureau

Il-gyu KIM, Deputy Director, Information Planning Team, Information Policy Bureau

Chang-Dae SEO, Deputy Director, International Application Team

NATIONAL BOARD OF PATENTS AND REGISTRATION OF FINLAND

Eero MANTERE, Senior Vice President

Pekka LAUNIS, Vice President, Counsellor, Industrial Property

Juha REKOLA, Development Director, Patents and Innovations Line

NORDIC PATENT INSTITUTE

Majbritt M. D. VESTERGAARD (Ms.), Special Legal Adviser, Danish Patent and Trademark Office

Flemming Kønig MEJL, Senior Technical Adviser, International Affairs, Danish Patent and Trademark Office

Olav AASEN, Head, Electricity, Physics and Fixed Constructions Section, Patent Department, Norwegian Patent Office

Jostein SANDVIK, Senior Legal Advisor, Legal and Political Affairs, Norwegian Patent Office

SPANISH PATENT AND TRADEMARK OFFICE

Isabel SERIÑÁ RAMÍREZ (Ms), Technical Advisor, Department of Patents and Technological Information

Javier VERA ROA, Head, Applied Mechanical Patents Division, Patents and Technological Information Department

STATE INTELLECTUAL PROPERTY OFFICE OF THE PEOPLE'S REPUBLIC OF CHINA

YU Zhilong, Deputy Director, Guidelines Division, Patent Affairs Administration Department

HE Yuefeng, Deputy Director General, Preliminary Examination and Flow Management Department

SWEDISH PATENT AND REGISTRATION OFFICE

Jan-Eric BODIN, Deputy Head, Patent Department

Marie ERIKSSON (Ms.), Head of Legal Affairs, Patent Department

Kerstin BRINKMAN (Ms.) Director, Patent Department

UNITED STATES PATENT AND TRADEMARK OFFICE

Jon P. SANTAMAURO, Patent Attorney, Office of International Relations

Charles A. PEARSON, Director, PCT Legal Administration

Richard COLE, Senior PCT Legal Examiner, Office of PCT Legal Administration

Mark Robert POWELL, Group Director, Technology Center 2600

II. OFFICERS

Chair: Francis GURRY (WIPO)

Secretary: Michael RICHARDSON (WIPO)

III. SECRETARIAT
OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

Francis GURRY, Deputy Director General, Sector of PCT and Patents, Arbitration and Mediation Center and Global Intellectual Property Issues

Philip THOMAS, Senior Director-Advisor (PCT and Patents)

Matthew BRYAN, Director, PCT Legal Division

Diego Agustín CARRASCO PRADAS, Acting Director, PCT External Legal Relations Division

Mikhail MAKAROV, Acting Director, PCT Information Systems Division, Classification and IP Standards Division

Claus MATTHES, Acting Director, PCT Reform Division

David MULS, Acting Director, PCT Operations Division

William MEREDITH, Head, Patent Information and IP Statistics Section

Antonios FARASSOPOULOS, Head, Classification and IP Standards Division, International Patent Classification Section

Michael RICHARDSON, Senior Legal Officer, PCT Reform Division

[Annex II follows]

ANNEX II

JAPAN'S POSITION ON THE PROPOSED
"SUPPLEMENTARY INTERNATIONAL SEARCH"

Japan is opposed to the proposal for Supplementary International Search (SIS) for the following reasons.

1. SIS proposal in the context of objectives of International Search (IS)

The objectives of International Search Report (ISR) are considered to be as follows:

- (1) provide an applicant with information for making a decision about whether the international application is worth for further proceeding;
- (2) increase the predictability of patentability and reduce the burden of surveillance on the part of third party;
- (3) allow Designated Offices to more easily carry out national/regional searches using the results of international searches; and
- (4) reduce the number of potentially unpatentable applications filed in countries without an adequate examination capability.

These objectives of ISR are similar to the objectives of national/regional prior-art searches to be conducted by the National Offices (NO). For instance, prior-art search reports for national/regional applications is supposed to provide applicants and third parties with useful information in the meanings of (1) and (2) listed above. From the standpoint of the countries that wish to make use of the search results obtained in other countries/regions for corresponding foreign applications, such search results are expected to play the roles mentioned in (3) and (4) listed above.

As described above, no difference can be found between an ISR and a national/regional search report (at least the one prepared by a NO which is qualified as an ISA) in terms of their functions to be performed as well as in terms of their contents to be expected. As a national office, an ISA is considered to have a capability of conducting adequate national/regional searches to the extent necessary and sufficient, including capability of conducting searches of prior-art documents written in specific languages for PCT minimum documents. Therefore, an ISA would be able to satisfy the necessary and sufficient condition for preparation of ISR, if the ISA does the same as what it usually does in its national/regional searches.

No difference can be found between an ISR and a national/regional search report (prepared by a NO which is qualified as an ISA) in terms of their functions to be performed as well as in terms of their contents to be expected. Therefore, no good reason can be found for the SIS proposal which is intended to institutionalize, in the existing PCT scheme, the new type of international search that goes beyond the national/regional search to be usually conducted by a NO/ISA to the extent necessary and sufficient. If an ISA wishes to conduct an international search surpassing the extent of its national/regional search (e.g., an international search for a document in a specific language which is not covered by its national/regional search), that kind of search should be considered an additional service to be voluntarily provided by that ISA, but it should not be institutionalized in the PCT system.

2. Responsibilities and discretions of ISA

Article 15(4) of the PCT stipulates that “the International Searching Authority...shall endeavor to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the Regulations.” It is not Japan’s position to give an excessively broad interpretation to this provision as meaning that ISAs are, in every cases, responsible for conducting searches for every prior art documents written in any of the specific languages for the PCT minimum documents. On the contrary, we believe that, in light of the objectives listed in (1)-(4) of point 1, it is sufficient for a national office acting as an ISA to conduct an international search in the same manner and to the same extent that it conducts a national/regional search.

Taking into account this provision on the duties of an ISA for international searches, however, it seems to be the responsibility of an ISA to conduct a search for the scope of documents to the extent it considers appropriate, including a possible search for prior-art documents written in a specific language.

The ways how to fulfill such responsibilities of ISA should be determined by the ISA within its discretion. If an ISA considers it lacks the sufficient ability to search for documents in a specific language, the ISA may outsource a part of the search to an outside search organization having sufficient ability to conduct a detailed search for documents written in such a specific language, and thereby supplement the search of the ISA, on the condition that the ISA bears full responsibility for the final result of the ISR.

Thus, it should be the responsibility of the ISA to take the necessary measures to fulfill the responsibilities of an ISA outlined in the corresponding provision. It is our understanding that, under the current PCT system, ISAs are already permitted to outsource a part of their search for supplementary purpose, and the decision to outsource a part of their search has been left to the discretion of the ISA. No good reason can be found why such supplementary searches must be institutionalized in the PCT.

It should be added that for the JPO to be an outsourcing organization seems to exceed the scope of the role expected and permitted as a governmental organization.

On the other hand, as an authority or office to officially publish patent documents in a specific language, a NO/ISA should implement measures to enable other ISAs/NOs to more easily conduct prior-art searches for the patent documents. As for the JPO, it has been widely distributing Patent Abstracts of Japan (PAJ) at JPO’s own initiative, which consists of English-version abstracts of Japanese patent documents. The JPO has also been providing access to Japanese patent documents through the Industrial Property Digital Library (IPDL), which can be accessed through the JPO website. Using the machine translation function attached to the IPDL, users can access all patent documents and the specifications contained therein in English. Other ISAs/NOs publishing patent documents in a language other than Japanese are strongly expected to make similar efforts to publish documents in Japanese language.

3. De-centralized system

The proposed SIS can be considered a proposal to unify ISAs in a sense that multiple ISAs can collaboratively conduct a single international search for a single international application. In fact, Article 16(2) of the PCT mentions that “pending the establishment of a single

International Searching Authority,” and thereby suggests that the ultimate objective of this provision is the integration of international searches.

With the rapid progress of information technology, however, we are now in the situation where the searchers/examiners can access the same database from anywhere in the world. This is an unforeseeable development at the time when the PCT was established; i.e., at a time when prior-art documents were in a form of paper collection. Under the current circumstances, a de-centralized system consisting of multiple ISAs can be regarded as more suitable for effectively utilizing the search resources in various parts of the world rather than a centralized system with a single world-ISA. There currently exist 11 separate and independent ISAs. Such a current situation can no longer be regarded as a transitional stage toward achieving the ultimate objective.

In order to make such a de-centralized system work more effectively and efficiently, however, all the ISAs should be held responsible for the ISRs which they produce, and display capability equivalent to other ISAs. If these conditions are not satisfied, an ISA/NO will be unable to rely on an ISR prepared by another ISA.

In light of the above, the JPO cannot shake off the doubt that, in a system that allows two or more ISAs to work on a single international search, an individual ISA's responsibility for the production of an ISR becomes unclear. Instead, a de-centralized system in which ISAs compete with each other for better and more user-friendly service is desirable.

[End of Annex II and of document]