

## Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

**Nineteenth Session  
Canberra, February 8 to 10, 2012**

### SEARCH STRATEGY INFORMATION IN THE PCT

*Document prepared by the International Bureau*

1. The Annex contains a proposal by the Canadian Intellectual Property Office for a specific way forward on providing search strategy information to help designated Offices to properly assess an international search report. This involves International Authorities which are willing and able to provide this information uploading their search strategy documents in whatever format they might be and making them available on PATENTSCOPE. It should be noted that this should not preclude further work on harmonizing the format of search strategies to allow more effective understanding of searches in the future.
2. The International Bureau supports this practical approach which can be implemented without any change to the legal framework and would simply observe that this would not mean that designated Offices would *only* be able to retrieve the documents manually from the PATENTSCOPE website. They would also be available through automated processes including PADOS and PATENTSCOPE web services and could, in the longer term, also be included onto the DVDs provided for communications under PCT Article 20 and Rule 87.
3. The only technical issue which may need to be considered is if any International Authority records search strategies in a format which cannot be reliably viewed in a browser. In this case, it might be desirable if the International Authority which conducted the international search would provide a rendering of the information into PDF, plain text or TIFF format in addition to the native format.
4. *The Meeting is invited to comment on the proposal in the Annex for delivering search strategy information.*

[Annex follows]

## SEARCH STRATEGY INFORMATION FOR INTERNATIONAL SEARCH REPORTS TO BE PROVIDED ON PATENTSCOPE

*Proposal by the Canadian Intellectual Property Office*

### SUMMARY

1. The Canadian Intellectual Property Office (CIPO) presented a proposal at the 18th session of the Meeting of International Authorities (MIA) of providing more detailed information in the international search report about the search performed, in response to concerns raised by PCT Member States regarding the quality of the searches of the international search report<sup>1</sup>. Most Authorities were open to the general concept of the proposal, however, there were some issues raised surrounding the earlier proposal which were considered to be major practical barriers for implementation<sup>2</sup>. This amended proposal being put forth by CIPO addresses the issues raised by the Authorities while maintaining the increased transparency of the international searches performed. The new proposal includes the use of PATENTSCOPE as an avenue to relay the search strategy information for an international application.

### BACKGROUND

2. Currently, the Patent Cooperation Treaty (PCT) International Search Report (form PCT/ISA/210) provides a very limited area for details of the search strategy used by the examiner. Concerns were raised by PCT Member States in the 2008 PCT User Survey regarding the quality of the searches of the international search report<sup>3</sup>.

3. In response to the concerns regarding the quality of the international search report, CIPO presented a proposal at the 18th MIA to improve the information available concerning the scope of an international search which had been conducted by enlarging the relevant box in the international search report and providing details of the scope of the search<sup>4</sup>. This type of information is already held by most International Searching Authorities on the international application file, but does not appear in the international search report, in part because of limitations of the form<sup>5</sup>.

4. Most Authorities at the 18th MIA who took the floor on the matter were supportive of the general concept underlying the proposal, recognizing that it could improve confidence in the quality of the search. However, some issues surrounding this proposal raised by the Authorities were considered to be major practical barriers.

5. The main issues raised were<sup>6</sup>:

(a) the amount of examiner time which could be involved in preparing explanations of the scope of the search of the type shown in the examples, independent of the particular system used to perform the search;

(b) the diversity of methods used for recording searches, which could limit the extent to which the information could be useful to applicants and examiners from different Offices;

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<sup>1</sup> As example, document PCT/WG/3/14 Rev. paragraphs 26, 37, 41, 46, 48, 52, 55, 59 and 77

<sup>2</sup> PCT/MIA/18/16, paragraph 64

<sup>3</sup> PCT User Survey 2008, PCT/MIA/17/7

<sup>4</sup> PCT/MIA/18/9

<sup>5</sup> PCT/MIA/18/16, paragraph 63

<sup>6</sup> PCT/MIA/18/16, paragraphs 65-66

(c) the amount of information technology (IT) investment needed by International Authorities to change their processes to record and provide search strategy information; and

(d) how the information provided could be interpreted by the users.

6. Unless these issues were resolved, some Authorities stated that they were unlikely to justify either the additional burden on examiners or the IT development costs involved<sup>7</sup>.

7. The Meeting agreed that further consideration of this subject would be useful and agreed that CIPO should discuss the issues further with other Offices, noting that related work was going on in other fora which should be taken into account, and prepare revised proposals which seek to address the concerns of International Authorities<sup>8</sup>.

8. Similar work is being carried out by the Five IP Offices (IP5). IP5 is developing a common approach amongst its member offices in documenting search information with the goal of sharing said information between the Offices in order to reduce duplication of work and increased efficiency in the process for each office. It does not appear that, at this time, discussions of the IP5 relating to search strategies are advanced to the extent that their work can be used as a basis for a common search strategy format for International Authorities, although this may change moving forward.

9. In view of the concerns expressed by the International Authorities, the following amended proposal is put forth as a possible option.

#### **AMENDED PROPOSAL**

10. The aim of the original proposal was to address the concerns raised by PCT Member States as to the quality of the searches carried out. Adding information regarding the search strategy increases the transparency of the work performed in the International Authorities which results in increased confidence in the search results delivered. This new proposal maintains the goal of increasing the transparency of the search strategy of the International Search Authorities and attempts to address the concerns raised by the Authorities in regards to the initial proposal<sup>9, 10</sup>.

11. It is currently proposed that the search strategies and the search results, as presently held by International Searching Authorities, would be posted as a "Related document" in the "Documents" tab for the international application on PATENTSCOPE. This would allow any interested party to readily view the search information upon which the international search report for an international application was based.

12. Participating International Authorities could submit their search records to the International Bureau at the time of submission of the international search report via the current system of uploading through EDI in min-spec format<sup>11</sup> using the appropriate code. The International Bureau would then scan the records into the international application folder in PATENTSCOPE as "Related documents", which would become a publically visible file upon publication of the

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<sup>7</sup> PCT/MIA/18/16, paragraph 66

<sup>8</sup> PCT/MIA/18/16, paragraph 68

<sup>9</sup> PCT/MIA/18/9

<sup>10</sup> PCT/MIA/18/16, paragraphs 65-66

<sup>11</sup> *PCT minimal specifications for transmitting documents to the International Bureau*, available from the WIPO website at <http://www.wipo.int/patentscope/en/pct-edi/>

international application. The documents would be published in their original format, such as PDF, TXT (and potentially contained in a ZIP).

13. The documents would also be posted in their original language. The International Bureau would not be responsible for translation of the search strategy documents. Machine translation would not be available at present but possibly in the future.

## **ISSUES IDENTIFIED BY THE INTERNATIONAL AUTHORITIES**

### **(A) AMOUNT OF TIME**

14. Some Authorities expressed concerns with the amount of examiner time which could be involved in preparing explanations of the search strategy.

15. The consequence of the new proposal, posting the Authorities' search records on PATENTSCOPE, is that little or no additional time or effort would be required by the examiner, other than as required by their respective offices for information recorded in their search records.

16. In CIPO's experience, the implementation of the mandatory requirement for examiners to record their search strategies added only a small amount time to the international work, and this was offset by the accrued benefits of copying of the information contained in the record into the written opinion, the ease of transferring search information between examiners, and in the ability of the examiner to review the search to determine the extent of a top-up search required in national phase.

### **(B) DIVERSITY OF METHODS USED FOR RECORDING SEARCHES**

17. Concern was also expressed that the diversity of methods used for recording searches and the lack of consistency in the format and presentation of the information could limit the extent to which the information could be useful to applicants and examiners from different Offices.

18. The conclusion of an informal survey of search records from seven (7) Authorities revealed that, while the format of each search record form is different, the information contained is similar between Authorities. Common information of the forms included databases used, classifications searched, keywords and search strings. While the use of a standardized presentation would facilitate the ease of understanding of this information, the current search records would still be of use to applicants and examiners and would increase transparency of the international search.

### **(C) SIGNIFICANT INFORMATION TECHNOLOGY INVESTMENT**

19. Authorities were concerned about the significant IT investment that could be needed to change their processes to provide additional information regarding the international search.

20. Since the current proposal uses existing systems used by Authorities to transmit documents to the International Bureau, there will be little additional IT requirement for either the Authorities or the International Bureau in implementing the current proposal.

(D) INTERPRETATION OF THE INFORMATION PROVIDED

21. There was also concern expressed regarding the possible misinterpretation of the content of the search results documented in the search record by third parties as to the completeness of the of the prior art identified.

22. The PCT system recognizes the practical aspects of the search, as it provides guidelines in outlining the minimum documentation to be search by an ISA. The minimum documentation encompasses the commonly accessible art where the relevant art most probably is found. Furthermore, the examiners are provided with guidelines that a search is terminated when one or more documents is found to clearly demonstrate the lack of novelty over the entire subject matter claimed or when the probability of finding relevant prior art becomes low in relation to effort needed<sup>12</sup>. The recorded search may thus be a reflection of the relevant prior art but may not be a complete record of all relevant prior art in existence.

23. To avoid any misinterpretation, a disclaimer could be included in the search strategy record noting the fact that the search detailed in the search record may not encompass every piece of relevant prior art. For example:

*“The search detailed in these records was done in accordance with the PCT Search and Examination Guideline 15.57.”*

**NEXT STEPS**

24. Comments are invited from all Authorities and the International Bureau, and if appropriate all PCT Member States could be surveyed, preferably by the International Bureau, on the new proposal for disclosure of search strategy information. Once approved, the system to relay search strategy information on PATENTSCOPE would be implemented at the International Bureau. A follow-up assessment with users and Authorities after a trial period will be performed, preferably by the International Bureau on behalf of all International Authorities.

[End of Annex and of document]

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<sup>12</sup> PCT International Search and Preliminary Examination Guidelines, paragraph 15.57