

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

**Twenty-Third Session**  
**Santiago, January 20 to 22, 2016**

### **SUMMARY BY THE CHAIR**

#### **INTRODUCTION**

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its twenty-third session in Santiago from January 20 to 22, 2016.
2. The following International Searching and Preliminary Examining Authorities were represented at the session: the Austrian Patent Office, the Brazilian National Institute of Industrial Property, the Canadian Intellectual Property Office, the European Patent Office, the Federal Service for Intellectual Property of the Russian Federation (Rospatent), the Finnish Patent and Registration Office, the Indian Patent Office, the Intellectual Property Office of Singapore, IP Australia, the Japan Patent Office, the Korean Intellectual Property Office, the National Institute of Industrial Property of Chile, 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, the United States Patent and Trademark Office and the Visegrad Patent Institute.
3. The list of participants is contained in Annex I to this document.

#### **ITEM 1: OPENING OF THE SESSION**

4. Mr. John Sandage, Deputy Director General of WIPO, welcomed the participants on behalf of the Director General. In his opening remarks, he in particular thanked the National Institute of Industrial Property of Chile (INAPI) for hosting the meeting, highlighted the main achievements of INAPI since its creation in 2009, notably accession to the PCT in 2009 and appointment as an International Authority in 2012, and emphasized the role of work sharing between Offices and the importance of the PCT in this context.

5. Mr. Maximiliano Santa Cruz, National Director of the National Institute of Industrial Property of Chile (INAPI), welcomed the participants for the first Meeting of International Authorities taking place in Chile. In his opening remarks, he in particular stressed the role of the PCT as the backbone of the international patent system and, noting the excellent cooperation of Member States in their efforts to further improve the system, as a very good example of a well-functioning multilateral framework.

6. Mr. Luis Felipe Céspedes, Minister of Economy, Development and Tourism of Chile, addressed the Meeting in the afternoon of January 20, 2016. In his address, he in particular highlighted the importance of innovation as an engine for growth and increase in productivity for a country like Chile, and INAPI's role and achievements in the just six years since its creation in 2009.

## **ITEM 2: ELECTION OF A CHAIR**

7. The session was chaired by Mr. Maximiliano Santa Cruz, National Director of the National Institute of Industrial Property of Chile.

## **ITEM 3: ADOPTION OF THE AGENDA**

8. The Meeting adopted the agenda as set out in document PCT/MIA/23/1 Rev.

## **ITEM 4: PCT STATISTICS**

9. The Meeting noted the presentation by the International Bureau on the most recent PCT Statistics<sup>1</sup>.

## **ITEM 5: MATTERS ARISING FROM THE QUALITY SUBGROUP**

### **(A) QUALITY**

10. There were no interventions under this agenda item.

### **(B) APPOINTMENT OF AUTHORITIES**

11. There were no interventions under this agenda item.

### **(C) OTHER MATTERS**

12. There were no interventions under this agenda item.

### **(D) ENDORSEMENT OF THE REPORT OF THE QUALITY SUBGROUP AND RECOMMENDATIONS FOR FURTHER WORK**

13. The Meeting noted with approval the Summary by the Chair of the Meeting's Quality Subgroup set out in Annex II to this document, agreed with the recommendations contained in that Summary by the Chair and approved the continuation of the Subgroup's mandate, including the convening of a physical meeting of the Subgroup in 2017.

## **ITEM 6: RE-APPOINTMENT OF EXISTING INTERNATIONAL AUTHORITIES**

14. Discussions were based on document PCT/MIA/23/9.

15. One Authority indicated that it was essential for an Authority to show to the PCT Committee for Technical Cooperation (PCT/CTC) that it met the minimum requirements for appointment by providing details along the same lines as had been proposed in the application form discussed by the Quality Subgroup.

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<sup>1</sup> Available from the WIPO web site at: [http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=327156](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=327156)

16. One Authority suggested clarifying the wording of Article 4 of the model agreement covering subject matter not searched by the International Authority.

17. One Authority suggested that there could be a peer review process under which the documentation submitted for reappointment by one Authority was reviewed by one or more other Authorities to verify compliance with the minimum documentation requirements under Rule 36.1(ii).

18. One Authority suggested that the re-appointment process should be processed according to the requirements of the existing rules and avoid increasing the workload of existing International Authorities.

19. The Meeting noted the contents of document PCT/MIA/23/9.

#### **ITEM 7: PCT ONLINE SERVICES**

20. Discussions were based on document PCT/MIA/23/6.

21. All Authorities which took the floor on the matter expressed their great satisfaction with the various electronic services offered by the International Bureau to support the effective and efficient operation of Offices in their various PCT capacities.

22. Authorities which already benefitted from receipt of search copies in electronic form confirmed that they had been very happy with the results of the eSearchCopy project and hoped that more receiving Offices would participate in the project in the near future. One Authority stated that it had commenced a pilot project with a number of receiving Offices and hoped that that pilot project would indeed confirm the expected benefits, notably with regard to the more timely submission of search copies to Authorities, as well as quality and data consistency. Several other Authorities not yet participating in the eSearchCopy project expressed a strong interest in joining it in the near future.

23. Authorities which, in their capacity as receiving Offices, were offering ePCT filing and were using ePCT for Offices equally expressed their great satisfaction with those ePCT components, with ePCT filing often making up the majority of filings at the Offices. One Authority, while reporting a very modest uptake of ePCT filing at this stage, mainly due to the fact that it offered its own similar e-filing tool, stated that it had received more than 1800 demands in 2015 via ePCT. Another Authority stated that it was particularly satisfied with the excellent services and informal communications with the International Bureau's ePCT team.

24. In response to the request for feedback on priorities of Authorities for further work, several Authorities expressed a strong interest in the addition to ePCT of centralized fee payment mechanisms. One Authority, however, noted that since the payment of the search fee triggered the search by the ISA, the centralized fee payment would need to be carefully considered. It indicated that it would favor, in the future, a netting system that would be linked to the eSearchCopy service with a view to supporting the work of the ISAs.

25. Other priorities stated included the availability of international search reports and written opinions in XML format; the further development of web services; the inclusion in ePCT of subsequently filed documents; the issue of security of documents and data and compatibility with each Office's examination procedural requirements, and the access by designated Offices to the international application and related documents in the case of early national phase entry, in particular national phase entry prior to international publication.

26. The Meeting noted the contents of document PCT/MIA/23/6.

**ITEM 8: EFFECTIVE WORK SHARING BEYOND INTERNATIONAL REPORTS**

27. Discussions were based on document PCT/MIA/23/2.

28. Authorities which already had joined WIPO CASE as accessing and/or providing Offices expressed their strong support for WIPO CASE, noting its potential as the global platform to provide access to search and examination information regarding national and international applications and thus facilitating work sharing between Offices, and strongly encouraged other Authorities to join the system. Several Authorities particularly thanked the Japan Patent Office for its efforts in linking the IP5's One Portal Dossier (OPD) platform to WIPO CASE.

29. Several Authorities which to date had not joined WIPO CASE, or which had not joined WIPO CASE as both accessing and providing Office, stated their intention to do so in the near future.

30. One Authority suggested to consider using WIPO CASE for the secure transfer of documents related to WIPO's ICE (International Cooperation on Examination) service and offered to participate in any pilot in that regard. It further suggested to improve the access to existing training material on WIPO CASE on WIPO's web site. Another Authority suggested that the International Bureau should focus on accessibility and usability of WIPO CASE as demand and use grows.

31. The Meeting noted the contents of document PCT/MIA/23/2.

**ITEM 9: PROMOTING LINKAGE BETWEEN THE INTERNATIONAL PHASE AND THE NATIONAL PHASE**

32. Discussions were based on document PCT/MIA/23/8.

33. The Japan Patent Office (JPO) delivered a presentation<sup>2</sup> on the "Handbook for PCT International Search and Preliminary Examination in the Japan Patent Office", which had been published in both Japanese and English in October 2015 and made available on the JPO web site<sup>3</sup>. This presentation further highlighted two of the measures in the Annex to document PCT/MIA/23/8, namely (a-2) "In citing patent documents written in languages other than English, indicate the corresponding part of the patent family documents written in English, if a patent family document in the English language exists", and (b-4) "Conduct searches also on subject matter that is not considered patentable under one's own national patent laws". With regard to the former measure, the JPO wished for incorporation as soon as possible in the International Search and Preliminary Examination Guidelines, as had been supported at the twenty-second session of the Meeting in 2015.

34. Authorities which took the floor on the matter welcomed the initiative taken by the Japan Patent Office to collect input and feedback from other Authorities on possible measures to further strengthen the linkage between the international and the national phase of the PCT procedure. Several Authorities noted, however, existing limitations under national laws which prevented the implementation of some of the proposed measures. One Authority expressed concern about adding excessive extra workload to the international phase examiner.

35. The European Patent Office informed the Meeting that it had published PCT Guidelines for examiners, which explained how the International Search and Preliminary Examination Guidelines were implemented at the European Patent Office. Applications under the PCT were treated in an integrated manner with applications under the European Patent Convention, with

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<sup>2</sup> Available from the WIPO web site at: [http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=327176](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=327176)

<sup>3</sup> Available from the JPO web site at: [http://www.jpo.go.jp/tetuzuki\\_e/t\\_tokkyo\\_e/pct\\_handbook\\_e.htm](http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pct_handbook_e.htm)

recognition of the written opinion from the European Patent Office and the same examiner dealing with both cases.

36. IP Australia informed the Meeting that it had started a trial this month, under which the applicant entering the national phase was invited to take into account the written opinion or international search and preliminary examination report before starting national examination by making amendments and/or providing comments on the opinion or report. This trial would run at least until the end of 2016.

37. The Meeting agreed that the Japan Patent Office should work together with the International Bureau to consider the comments received on the measures in the Annex to document PCT/MIA/23/8, with a view to consolidating the measures and taking forward a selection which had received broad support from Authorities.

#### **ITEM 10: TRANSMITTAL BY THE RECEIVING OFFICE OF EARLIER SEARCH AND/OR CLASSIFICATION RESULTS TO THE INTERNATIONAL SEARCHING AUTHORITY**

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

39. Authorities expressed support for the proposed amendments to the PCT Regulations set out in the document, noting that it would appropriately address the apparent conflict between, on the one hand, Rule 23*bis*.2(a) and, on the other hand, Article 30(2)(a) as applicable by virtue of Article 30(3) and Rule 94.1*bis*, and thus provide further clarity to receiving Offices. Several Authorities pointed to the need to provide further guidance on the issue in the Receiving Office Guidelines.

40. Several Authorities stated their intention to notify the International Bureau of the incompatibility of Rule 23*bis* with their national laws, irrespective of the further proposed amendment to Rule 23 as proposed in the document.

41. Following queries by several Authorities, the International Bureau stated that it would be happy to further consider the suggestion to modify the existing request form with a view to possibly adding a check box which would allow the applicant to indicate his authorization to the transmittal by the receiving Office to the International Searching Authority of earlier search and classification results.

42. Following a query by one Authority on whether the transmittal of results of earlier searches and/or classifications between Offices using eSearchCopy may be transmitted separately from the search copies, the International Bureau stated that it will provide guidance for the procedure to be followed by receiving Offices.

43. The Meeting noted the contents of document PCT/MIA/23/3 and welcomed the International Bureau's intention to submit the proposed amendments to the PCT Regulations to the PCT Working Group for consideration.

#### **ITEM 11: PCT DIRECT – A NEW SERVICE FOR STRENGTHENING THE USE OF THE PCT**

44. Discussions were based on document PCT/MIA/23/13.

45. Several Authorities expressed their interest in the new service offered by the European Patent Office, noting the role it could play in further linking search and examination carried out in respect of an earlier application the priority of which is claimed in the international application and the international phase of the PCT procedure.

46. The Meeting noted the contents of document PCT/MIA/23/13 and invited the European Patent Office to continue to inform the Meeting at future sessions of its experiences with the new service

**ITEM 12: COLLABORATIVE SEARCH AND EXAMINATION – THIRD PILOT**

47. Discussions were based on document PCT/MIA/23/12.

48. The United States Patent and Trademark Office and the Korean Intellectual Property Office, both Authorities which had participated in phases 1 and 2 of the pilot on collaborative search and examination, stated that they envisaged to also participate in this third phase, noting that the first two pilots had delivered promising preliminary results. In this context, the United States Patent and Trademark Office further referred to ongoing collaborative search pilots it carried out with both the Japan Patent Office and the Korean Intellectual Property Office.

49. One Authority expressed the view that, prior to commencing with phase 3 of the pilot, phases 1 and 2 of the pilot needed to be properly analyzed and a number of issues addressed, such as those related to fees, numbers of applications to be covered in the next phase of the pilot and certain operational issues.

50. Following the query by one Authority, the European Patent Office clarified that applicants would not be given a choice with regard to the International Authorities which should establish the collaborative international search report. It further clarified the relationship of this pilot with the existing supplementary international search system, stating that, it was intended that collaborative search and examination would be complementary to the supplementary international search system rather than replacing it.

51. The Meeting noted the contents of document PCT/MIA/23/12.

**ITEM 13: IMPROVEMENTS TO SUPPLEMENTARY INTERNATIONAL SEARCH**

52. Discussions were based on document PCT/MIA/23/4.

53. Authorities supported changing the deadline for requesting supplementary international search from 19 to 22 months from the priority date, which would correspond to the deadline for filing a demand for international preliminary examination.

54. Some Authorities expressed concerns about allowing the possibility to request a supplementary international search on amended claims. These concerns included that such a supplementary search would be contrary to the original intention to limit supplementary search to national collections or documents in particular languages, that possible amended subject matter should be searched already as required under paragraph 15.25 of the International Search and Preliminary Examination Guidelines, and the limited additional value that this would provide compared to Chapter II.

55. Some Authorities stated that if a written opinion were introduced as part of supplementary international search, this should be left to the discretion of the Authority providing the supplementary search. In this regard, concerns were also expressed that a mandatory written opinion could deter other Authorities from offering supplementary international search. Some of these Authorities also commented that Authorities offering a written opinion might raise the fees for supplementary international search to cover the extra work of providing the opinion. One Authority, however, did indicate it could be favorable to an amendment to Rule 45*bis*.7(e)(i) to make it mandatory to include explanations with regard to the citations of documents considered to be relevant. Another Authority expressed regret that the opinion it already offered with the supplementary international search report was provided to the same standard as a written opinion accompanying the “main” international search, but could not form the basis of a request under the Patent Prosecution Highway (PPH). That Authority therefore suggested that, at the option of the Authority offering SIS, such opinion should be considered as having the same status as any other written opinion under Chapter I or II.

56. One Authority, which did not offer supplementary international search, stated that it followed developments in supplementary international search and continued to promote the service to applicants.

57. In terms of other improvements that could be offered to supplementary international search, one Authority stated that it reduced fees at national phase entry for applications on which it had performed a supplementary international search, and suggested that other Offices could offer fee reductions in the national phase for such applications. Another Authority believed uptake of supplementary international search could be increased if the service were offered by one of the larger International Authorities in Asia.

58. The Meeting noted the contents of document PCT/MIA/23/4.

#### **ITEM 14: PCT MINIMUM DOCUMENTATION**

##### **(A) DEFINITION AND EXTENT OF PATENT LITERATURE**

59. Discussions were based on document PCT/MIA/23/5.

60. All Authorities which took the floor on the matter welcomed the reactivation of the PCT minimum documentation task force and stressed the need for the PCT minimum documentation to take into account the digital age of electronic searching.

61. Some Authorities reported on progress to establish their own "Authority file", similar to those that had been established for the IP5 Offices.

62. The Canadian Intellectual Property Office proposed that all International Authorities should provide a list of all databases that it had access to for searching patent applications.

63. The Meeting decided that the PCT minimum documentation task force should:

(a) hold further discussions on the questions that had already been put to the task force, and

(b) further consider the proposal by the Canadian Intellectual Property Office in paragraph 62, above.

##### **(B) ADDITION OF INDIAN TRADITIONAL KNOWLEDGE DIGITAL LIBRARY**

64. Discussions were based on document PCT/MIA/23/10 and a presentation given by the Indian Patent Office as set out in paragraphs 65 to 71.

65. The Indian Patent Office recalled the discussions at the 2015 session of the Meeting, at which concerns had been raised with regard to certain provisions in the draft access agreement, notably in relation to the confidentiality and non-disclosure requirements, the necessity to monitor and report statistics on the use of citations from the TKDL, and the proposed termination provisions and possible implications for an International Searching Authority losing access to the full PCT minimum documentation if the access agreement to the TKDL was terminated under the termination provisions of the draft agreement.

66. With regard to the necessity to monitor and report statistics, upon consideration, the Indian Patent Office no longer wished to maintain such reporting requirement and would modify the draft access agreement accordingly.

67. With regard to the proposed termination provisions and possible implications for an International Searching Authority losing access to the full PCT minimum documentation if the access agreement to the TKDL was terminated under the termination provisions of the draft agreement, it was the view of the Indian Patent Office that those provisions and implications

were similar, if not identical, to those applied in respect of non-patent literature where an Authority lost access to such non-patent literature, for example, due to the non-payment of subscription fees. In the view of the Indian Patent Office, the agreements with publishers contained termination clauses that either party could give notice to the other party and the access could be terminated.

68. With regard to the proposed confidentiality and non-disclosure requirements set out in the draft access agreement, the Indian Patent Office recalled that the Meeting, at its tenth session, had decided, as requested by the PCT Committee for Technical Cooperation, to consider, *inter alia*, the inclusion in the PCT minimum documentation of traditional knowledge periodicals and databases (document PCT/MIA/10/4). Notably, Annex I to that document listed specific criteria for the addition to the PCT minimum documentation of traditional knowledge periodicals, which had later formed the basis for the addition of 13 of such periodicals to the PCT minimum documentation. Annex II to document PCT/MIA/10/4 provided certain basic criteria of availability that were taken into consideration.

69. At its twelfth session, the Meeting had considered the issue of PCT minimum documentation based on document PCT/MIA/12/6. Annex III of this document contained an initial proposal from the Task Force leader, which listed some criteria for patent literature as well as for periodicals of non-patent literature. Regarding traditional knowledge databases, no criteria were suggested, which was treated under specialized databases. There was therefore a need to develop criteria for the inclusion of databases, including traditional knowledge databases, in the PCT minimum documentation. Unfortunately, work on that latter task had, however, never been taken up by the Task Force and remained outstanding.

70. The Indian Patent Office further stated that discussions on the issue of traditional knowledge databases had further taken place in WIPO's Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, in the context of its text based negotiations with the objective of reaching an agreement on a text or texts of an international legal instrument which will ensure the effective protection of traditional knowledge, traditional cultural expressions and genetic resources. Document WIPO/GRTKF/IC/28/5 set out specific draft provisions dealing with the issue of confidentiality of traditional knowledge databases, including, in draft Article 3*bis*, provisions setting out that Intellectual Property Offices of Member States should ensure that information held in traditional knowledge databases was maintained in confidence, except where the information was cited as prior art during the examination of a patent application. It was recognized, though, that discussions in the IGC continued and that the draft provisions referred to above had not yet been agreed.

71. The Indian Patent Office observed that the TK database was considered a specialized database for which criteria for selection were not yet established and pointed out that the criteria for periodicals could not be applied in the same manner for TK databases. The Indian Patent Office therefore stated that its request for the inclusion of the Indian TKDL, and notably the provisions of its proposed draft access agreement, should be reconsidered against this background and the additional information provided. Since an outcome from the PCT minimum documentation Task Force could be delayed, the Indian Patent Office requested all Authorities to consider provisional inclusion of the Indian TKDL in the PCT minimum documentation pending study by the Task Force.

72. Authorities which took the floor on the matter supported in principle the proposal to add the Indian TKDL to the PCT minimum documentation, noting that it would greatly enhance the quality of international search, as confirmed by those Authorities which had already been given access to the TKDL.



73. Several Authorities stated that they looked forward to receiving a revised proposed draft access agreement, taking into account the modifications to the proposed monitoring and reporting requirements, as well as their intention to possibly reconsidering the issue of the termination clauses in light of the additional information provided by the Indian Patent Office.

74. The European Patent Office and the United States Patent and Trademark Office provided detailed statements, as set out in the following paragraphs, included in this Summary by the Chair in their entire length, as requested by one Authority.

75. The European Patent Office stated that, as a principle, it believed that the PCT minimum documentation should cover the broadest documentation possible. For that reason, it was of the opinion that, before any effort was made to include non-patent collections in the PCT minimum documentation, priority should be given to the patent documentation itself. It noted that at present, Indian patent publications were not part of the PCT minimum documentation. It was therefore of the view that priority should be given on the inclusion of Indian patent information into the PCT minimum documentation.

76. The European Patent Office further stated that, as an active user of the TKDL, it supported the request of India to add the Indian TKDL to the non-patent literature (NPL) part of the PCT minimum documentation, subject to a number of conditions.

77. First, the European Patent Office had underlined, during the 2015 session of the Meeting, that the access agreement would have to be amended to further facilitate TKDL use by International Searching Authorities. This had not yet happened. The European Patent Office appreciated, however, the willingness of India to revise the access agreement in the future. For the European Patent Office, the facilitation of the TKDL use practically meant that it had to become possible to integrate the TKDL data bulk into the Office's internal search systems. Today, the access to the TKDL was possible only via an external separate TKDL website. From a practical view, the PCT minimum documentation had to be accessible and searchable by standard tools accessible by examiners at the respective International Searching Authorities.

78. The European Patent Office continued by stating that it followed that it would accept to include the TKDL in the PCT minimum documentation only at the condition that TKDL content was made available to International Searching Authorities to be loaded into their internal databases and could thus be incorporated in the standard search tools available at the respective International Searching Authorities. Search in PCT minimum documentation could not be conducted using multiple non-uniform user interfaces. It followed that the access agreement had to be modified accordingly. For example, a provision dedicated to that aspect could be added under the "Responsibilities of CSIR (Provider)", after item (i).

79. Second, as indicated at the 2015 session of the Meeting, the European Patent Office considered that the obligations of the User (Office) mentioned under paragraphs 2(i) and (ii) of the access agreement should be amended in order to include further rights which were required by the activities of patent Offices. Indeed, the license should include the right for the European Patent Office (licensee) and for authorized users:

- (a) to access, download, print, store, process and include in internal documents and files of the licensee selected items of licensed material in connection with the patenting procedure;
- (b) to supply the patent applicants and their representatives as well as other patent authorities and parties in the course of the patenting procedure with evidentiary copies (print or electronic) of selected items of Licensed Material;
- (c) to provide access to third parties to selected items of the licensed material in connection with file inspection; and

(d) to provide selected items of licensed material to other patent authorities in connection with the patenting procedure. Any electronic file deliverable to a non-subscriber should be in the form of a non-reworkable PDF or equivalent. The licensee should notify external parties that copyrighted texts may not be copied or used in other electronic or printed publications or redistributed without the express permission of the copyright holder.

80. In addition, the European Patent Office noted that granting access to the TKDL, in accordance with the proposed agreement, required Authorities to provide non-standard access statistics. Those could be provided, but implementation would require additional resources. Therefore, the European Patent Office suggested removing from the access agreement the obligation of the user (Office) mentioned under paragraph 2(iii) of the access agreement (quarterly submission of number of times content of TKDL was cited).

81. The United States Patent and Trademark Office stated that it considered the Indian TKDL to be a very valuable resource, which it had made available to examiners and staff at the Scientific and Technical Information Center (STIC). It welcomed the proposed addition of the Indian TKDL as a part of the PCT minimum documentation, which would be beneficial to Authorities as well as national Offices, and would provide examiners with an excellent resource that could improve the quality of the international work products. It further stated that it would be glad to consider any revised proposals which India may provide regarding the TKDL and to provide more detailed comments based on a revised draft access agreement.

82. The United States Patent and Trademark Office stated further that, in view of the access agreement set forth in the document, it was concerned that the non-disclosure and confidentiality requirements proposed by India as a condition to granting access to the TKDL would make it very burdensome or impossible for some Offices to utilize that resource. In its view, since it was mandatory for Authorities to have access to the PCT minimum documentation, all the collections forming part of the PCT minimum documentation should be equally available to the Authorities and to the parties involved in international search and preliminary examination. As a matter of principle, it believed that prior art which could be used by an Authority in a search report and written opinion should be available also to the applicants and their representatives, to enable them to make an informed decision on pursuing their rights.

83. The United States Patent and Trademark Office expressed the view that PCT Rules 36.1 and 63.1 required that Authorities had access to the PCT minimum documentation. It asked the Secretariat to elaborate on the effect on an Office's status as an Authority should it fail to comply with one or more of the non-disclosure provisions and lose access to the TKDL, should the TKDL become part of the PCT minimum documentation.

84. In concluding, the United States Patent and Trademark Offices stated that it believed that important benefits could be gained by the International Authorities by accessing and fully utilizing the information contained in the TKDL database. However, it did not believe it was proper to limit such access by restrictive confidentiality and non-disclosure requirements. Fundamentally, it was required to ensure that the TKDL, like all other collections included in the PCT minimum documentation, was accessible by all the parties involved in international search and preliminary examination.

85. Upon a suggestion by the Secretariat, the Meeting decided to proceed as follows with regard to the matter under discussion:

(a) The Meeting invited the PCT Minimum Documentation Task Force, as a matter of urgency, to recommence its discussions on the addition of databases, including traditional knowledge databases, to the PCT minimum documentation, as set out in document PCT/MIA/12/6.

(b) The Meeting invited the Indian Patent Office to submit a detailed working document to the Task Force, including a revised draft of the access agreement, setting out its proposals with regard to the inclusion of the Indian TKDL into the PCT minimum documentation, taking into account previous discussions in the Meeting, the Task Force and the IGC, as well as the discussions held at the present session of the Meeting.

(c) The Meeting invited the International Bureau, also in its current role as the Task Force leader, to closely work with the Indian Patent Office in the coming months with a view to moving the issue forward, where appropriate by means of informal consultations and written communications, such as PCT Circulars, to ensure proper preparation of the discussions at the next session of the Meeting in 2017.

#### **ITEM 15: PCT SEQUENCE LISTING STANDARD**

86. Discussions were based on document PCT/MIA/23/7.

87. Authorities which took the floor on the matter supported the adoption of WIPO Standard ST.26 and agreed that the European Patent Office in its role as Task Force leader and the International Bureau should explore alternative ways to facilitate this process if the Committee of WIPO Standards was not convened in March 2016. One Authority indicated that sufficient time would be needed to be allowed for the transition to ST.26 in view of the changes required to IT systems.

88. In response to a question from one Authority on the status of informal discussions on the agenda of the fourth session of the Committee on WIPO Standards, the International Bureau informed the Meeting that these discussions were still ongoing without agreement.

89. The Meeting noted the contents of document PCT/MIA/23/7.

#### **ITEM 16: REVISION OF STANDARD ST.14**

90. Discussions were based on document PCT/MIA/23/11.

91. Authorities which took the floor on the matter supported the decision of the Task Force to keep category "X" unchanged, but expressed different views on how categories "E" and "O" should be combined with categories "X", "Y" and "A". One Authority supported the text in the draft Standard that indicated that the combination was preferable; one Authority stated that the combination should be obligatory; and a further Authority stated that the combination should be obligatory for category "O" but opposed including any requirement or advice on the combination of category "E" with categories "X", "Y" and "A". It further stated that a "may" provision for category "E" would be acceptable. For category "E", this Authority further referred to the availability of the written opinion of the International Searching Authority on PATENTSCOPE at the same time as international application as providing adequate information on the relevance of citations in this category.

92. One Authority expressed consideration of the usefulness of including informal translations for non-patent literature in the Standard as well as the workload for examiners. Another Authority indicated that the insertion of non-Latin text into search reports could be problematic for older documents where the characters were not available in selectable text format that could be copied directly into the search report.

93. The Meeting noted the contents of document PCT/MIA/23/11.

**ITEM 17: FUTURE WORK**

94. The Meeting noted that the next session was expected to be convened in the first quarter of 2017, immediately following a meeting of the Quality Subgroup. The Meeting was pleased to receive an offer by the Representative of the Nordic Patent Institute to host the 2017 sessions of the Meeting of International Authorities and of the Quality Subgroup in one of its three Member States.

[Annexes follow]

LIST OF PARTICIPANTS

**I. INTERNATIONAL AUTHORITIES**

(in the English alphabetical order of their names)

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Gisela Aparecida SILVA NOGUEIRA (Ms.), Manager, PCT International Division

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[Annex II follows]



PCT/MIA QUALITY SUBGROUP  
SIXTH INFORMAL SESSION  
SANTIAGO, JANUARY 18 AND 19, 2016

SUMMARY BY THE CHAIR

**OPENING OF THE SESSION**

1. Mr. Maximiliano Santa Cruz, National Director of the National Institute of Industrial Property of Chile (INAPI), opened the session and welcomed the participants. Mr. Sergio Escudero, Head of International and Public Policy Department, INAPI, chaired the session.

2. The Secretariat, in its opening remarks, recalled the quality related work which had been carried out since the beginning of the discussions which eventually had led to the introduction of Chapter 21 of the International Search and Preliminary Examination Guidelines (“the Guidelines”) back in 2004 and the good work which had been done by the Subgroup since its first session held back in 2010. That notwithstanding, it had to be recognized that there was a need to improve the process of advancing discussions on quality related issues between physical meetings of the Subgroup. With reference to the agenda item on Quality Management Systems, efforts should be made to move beyond the by now routine reporting on existing quality management systems towards discussing specific quality management activities with a view to establishing “best practices” as to how to “fill the existing quality framework under Chapter 21 with life”. Similarly, with reference to the agenda item on Quality Metrics, efforts should be made to move beyond the mere reporting on characteristics of international search reports towards seeking metrics which were directly associated with the quality of the international phase work products, as had been envisaged at the beginning of the metrics discussions when the report on characteristics had been considered to be stage one of an intended three stage process. Finally, the Secretariat encouraged Authorities to make further proposals on other possible quality improvement measures for discussion by the Subgroup at future sessions.

**1. QUALITY MANAGEMENT SYSTEMS**

**(A) REPORTS ON QUALITY MANAGEMENT SYSTEMS UNDER CHAPTER 21 OF THE PCT SEARCH AND EXAMINATION GUIDELINES**

3. Authorities expressed appreciation for the compilation and summary of the complete collection of Quality Management Systems reports for 2015. The Subgroup was satisfied to continue with the current reporting mechanism, with November 30 set as the deadline for submission to the International Bureau. Some Authorities did, however, regret that the earlier timing of the meeting had left little time to study the reports and the paper summarizing the Quality Management Systems in detail and expressed a general preference to schedule future Subgroup and MIA meetings in the month of February. One Authority added that, while there often was not enough time to fully analyze the reports of other Authorities prior to the meeting, in the past, it had often done so over the year and then raised pertinent issues internally and bilaterally with other Offices. The reports were therefore a valuable source of information and more useful than might initially be perceived.

4. In the context of the discussions of Quality Management Systems of International Authorities between the physical meetings of the Subgroup, the International Bureau raised the general question of the effectiveness of the Quality Subgroup’s electronic forum wiki as a communication medium. Informal postings on the wiki usually only met with responses from very few other Authorities. The International Bureau therefore asked whether more formal communication channels, such as PCT Circulars, would result in more responses from Authorities. The Subgroup agreed that, in certain situations, more formal deadlines and a

clearer invitation to respond to specific issues or questions would be appropriate, provided that such more formal means of communication would not replace but rather supplement informal means, notably the Subgroup's electronic forum ("mixed mode").

5. In reply to the question by one Authority whether it would be possible to see the responses of other Offices to PCT Circulars, the International Bureau replied that it had internally discussed the issue of publishing responses from Offices in the past. While this would not appear appropriate for all Circulars, noting the impact publication may have on the replies submitted by Offices, in the context of Circulars sent to a limited group of Offices, such as the International Authorities, it could be envisaged to publish all responses received only to that limited group, for example, on the Subgroup's electronic forum, as long as it had made been clear at the outset that responses would be published. In general, the International Bureau encouraged more activity by all Authorities on the wiki between meetings, for example, by bringing topics of interest from bilateral discussions to the Subgroup as a whole, and updating other Authorities on changes to Quality Management Systems during the year.

6. The Subgroup recommended:

(a) to continue reporting on existing Quality Management Systems of Authorities using the present reporting mechanism, indicating changes from the present year, with a deadline of November 30 for submission of reports to the International Bureau;

(b) that the International Bureau should consider communicating with Authorities in a more formal way through PCT Circulars as a complement to the electronic forum; furthermore, it should be explored whether the electronic form could be used to share responses from Authorities to Circulars.

#### (B) SHARING OF QUALITY POLICIES AND GUIDELINES, INFORMATION ON SAMPLING OF CASES IN QUALITY ASSURANCE PROCESSES, AND CHECKLISTS IN QUALITY ASSURANCE PROCESSES

7. While there had been relatively low interest over the past year in the discussion pages on the electronic forum on the topics of sharing of quality policies and guidelines, information on sampling of cases in quality assurance processes and checklists in quality assurance processes, the Subgroup nevertheless considered that the International Bureau should make one "final call" for contributions from Authorities with a fixed deadline for responses before closing the discussions on any of these subjects. There might also be a need for the continued discussion on any of these topics should it be agreed to tighten the requirements under Chapter 21 of the PCT International Search and Preliminary Examination Guidelines with a view to making certain requirements, such as the establishment of quality policies, mandatory. On sampling rates in quality assurance processes, some Authorities stated that this was dependent on resources and varied between years and therefore saw little value in continuing to share this information. One Authority pointed out that it had made its quality policy available on its web site so as to provide an overview with high level quality indicators, but that it did not make detailed information on its quality strategy available. Another Authority stated that it had been contributing to the discussions on all three topics since 2013 and, even if there was little activity, that it considered the information that had been posted to have been very useful; it encouraged more Authorities to contribute and share information on these topics.

8. The Subgroup recommended that the International Bureau should make a final call for Authorities to contribute to the discussion pages on the sharing of quality policies and guidelines, information on sampling of cases in quality assurance processes, and checklists in quality assurance processes.

### (C) QUANTITATIVE OBJECTIVES AND GOALS ON QUALITY

9. The Japan Patent Office stated that it appreciated the postings from Authorities to the discussion page that had been set up after the Subgroup's meeting in 2015 and informed the Subgroup that it had outsourced a research study to a private company on the use of quantitative metrics regarding patent examination quality. One Authority had been sharing information on how it used quantitative metrics on a bilateral basis with Offices. In the absence of interest from Authorities to share more information, the Subgroup agreed that discussions on this subject should be closed.

10. The Subgroup recommended to close the discussion page on quantitative objectives and goals on quality.

### (D) METHODS OF COLLECTING USER FEEDBACK AT THE EUROPEAN PATENT OFFICE

11. In line with the agreement reached at the fifth session of the Subgroup that discussions among Authorities on existing quality management systems should now move beyond Authorities merely reporting on their existing systems and focus on specific quality management activities carried out by Authorities with a view to learning from each other's experiences, the European Patent Office (EPO) delivered a presentation on the methods of collecting user feedback as an integral part of the EPO's quality management system. Feedback from users was collected across the entire procedure (filing, search, examination, grant and opposition) by way of user satisfaction surveys covering both search and examination as well as patent administration, visits to applicants, meetings with industry and patent professionals ("partnership for quality") and detailed external complaints handling procedures.

12. Questions posed during the ensuing discussions related, among others, to issues such as the EPO's preference for phone based interviews as opposed to written surveys, the exact nature of the questions asked during such interviews as well as their average length, the different roles of examiners and centralized quality and complaint units in complaint handling procedures, and PCT-specific user feedback. Several Authorities took the opportunity to inform the Subgroup of their own methods of collecting user feedback.

13. The Subgroup recommended:

- (a) to continue the discussions on methods of collecting user feedback on the Subgroup's electronic forum;
- (b) to request the Secretariat to create a specific work item on the electronic forum and to invite Authorities to post contributions on the topic within specific deadlines.

### (E) MECHANISMS FOR FEEDBACK AND ANALYSIS ON INTERNATIONAL SEARCH REPORTS AND WRITTEN OPINIONS BY THE INTERNATIONAL SEARCHING AUTHORITIES

14. The Japan Patent Office presented a summary of the preliminary findings of a pilot study it had carried out in 2015 jointly with the Swedish Patent and Registration Office. The study had looked at a framework under which, following the first office action in the national phase, the designated Office would give feedback on the written opinions and international search reports established by the International Authority. The International Authority would then analyze and utilize the feedback and share the results of the analysis with the designated Office.

15. Building on the earlier pilot study carried out in 2014, the findings had shown that, thanks to improvements made to the standardized feedback form used for the 2015 pilot study, cases in which there were no discrepancies between the search and examination results of the Authority and the designated Office as well as cases where there had been such discrepancies

could be readily identified. Similarly, it had been possible to readily identify reasons why certain documents cited in the international search report had not been cited by the designated Office. However, despite the improvements to the form, concerns remained as to the additional work load for examiners participating in the pilot, noting that, compared to the 2014 pilot, it had only been possible to decrease the time it took to fill in the required feedback forms from 60 minutes to about 54 minutes on average in the case where there had been any discrepancies. Overall, the pilot had nevertheless confirmed the importance and the effectiveness of functioning feedback systems for the continued improvement of the quality of international work products. To further develop the concept, participation in a broader pilot study by more Offices in their capacities as International Authorities and designated Offices would be required.

16. One Authority stated that it looked forward to receiving a more detailed analysis of the pilot, envisaged to be carried out by Japan Patent Office and the Swedish Patent and Registration Office. Another Authority suggested to consider the use of clerical staff to ease the burden on examiners in filling in the required feedback forms.

17. The Subgroup accepted the offer by the Japan Patent Office to further report, on the Subgroup's electronic forum and during the next session of the Subgroup, on how to possibly further develop the feedback concept.

18. The Subgroup, noting the need for participation by other Offices in their capacities as International Authorities and designated Offices to further develop the concept, invited interested Offices to contact the Japan Patent Office.

#### (F) QUALITY METRICS AT THE EUROPEAN PATENT OFFICE

19. In line with the agreement reached at the fifth session of the Subgroup that discussions among Authorities on existing quality management systems should now move beyond Authorities merely reporting on their existing systems and focus on specific quality management activities carried out by Authorities with a view to learning from each other's experiences, the European Patent Office (EPO) delivered a presentation on the use of quality metrics in the EPO's quality assurance processes. It highlighted the role of its internal annual quality report as an essential tool for informed decision making by managers, the role of internal dashboards supporting a continuous focus on quality by both managers and staff members, and the importance of metrics, which formed the basis for essentially all efforts to improve production, process, service and product quality.

20. Questions posed during the ensuing discussions were related, among others, to issues such as the setting of quality targets, the form in which dashboards were presented, and the inclusion of specific PCT related metrics in the EPO's internal quality assurance process.

21. The Subgroup recommended to continue the discussions on metrics-based quality assurance on the Subgroup's electronic forum. It welcomed announcements by the Canadian Intellectual Property Office and the Spanish Patent and Trademark Office to make presentations similar to that by the EPO, notably from the viewpoint of smaller Offices with fewer resources available to be devoted to quality assurance processes, either on the Subgroup's electronic forum or at next year's session of the Subgroup.

#### (G) QUALITY MANAGEMENT IN THE INTERNATIONAL BUREAU'S PCT OPERATIONS DIVISION

22. The International Bureau delivered a presentation on quality management in the International Bureau's PCT Operations Division, focusing on the main quality assurance processes concerning tasks of receiving Offices, tasks of the International Bureau (both in its role as a receiving Office and as "IB proper", and with regard to tasks directly performed by it and those which had been outsourced to contractors) and tasks of International Authorities; the documentation of IB processes; the impact of automation on formalities examination and

quality assurance; metrics used; and quality related issues currently under consideration, including the need for a further consolidation of documentation, the setting up of quality management system and the development of a quality policy. The International Bureau noted that the presentation was intended to contribute to the discussions on the establishment of a broader metrics framework for the entire PCT system, given that it related to issues going beyond the work carried out by the International Authorities, and indicated that its intention was to raise those broader issues also with the entire PCT membership, either by way of a working document for discussion by the PCT Working Group or by way of Circulars.

23. One Authority questioned whether it would be possible for the International Bureau to share with receiving Offices its “step-by-step” PCT Processing Service Guidelines. It further emphasized the importance and usefulness of informal communications between staff at receiving Offices and the International Bureau’s staff in the relevant Processing Teams.

#### FURTHER WORK

24. The Subgroup recommended that the Secretariat should invite Authorities to propose topics related to their Quality Management Systems for discussion during the coming year on the Subgroup’s electronic forum and at next year’s meeting, and to invite Authorities to volunteer to take the lead in the discussions on any new topic selected.

## 2. QUALITY METRICS

### (A) CHARACTERISTICS OF INTERNATIONAL SEARCH REPORTS

25. In general, Authorities found the form of the report on characteristics of international search reports to be valuable, notably as a self-assessment tool. While not a direct measurement of quality, Authorities agreed that the graphs enabled trends to be seen over time and allowed measures to be taken when needed. One Authority reported that it had taken action when it had observed a relatively low ratio of the number of search reports with at least one XY citation to the number of search reports with A citations only. In terms of presentation, one Authority suggested that the graphs for a given characteristic should be presented with identical scales to make comparison between Authorities easier. Another Authority stated that it wished to have the opportunity to review the data before publication by the International Bureau.

26. While expressing concerns about dedicating additional resources, some Authorities provided suggestions of further metrics that could be developed, including: the percentage of search reports with a finding of lack of unity of invention, broken down by receiving Office and nationality and residence of the applicant and by the International Searching Authority; the re-use of documents cited in the international search report in the national phase where the applicant had filed amendments under Article 19 and/or Article 34; the number of Office actions and the allowance rate in the national phase by origin of international search report, and a breakdown of the percentage of X, Y or E citations in characteristic 1.1 by origin of the applicant for a given International Searching Authority. One Authority stated that it measured the allowance rates for international applications which had entered the national phase before its Office in its capacity as a designated Office where it had acted as the competent International Authority and had issued a positive IPRP, but did not consider these rates to be as relevant when a different Authority had performed the international search.

27. The Subgroup recommended that the International Bureau should continue to produce the report on characteristics of international search reports, taking into account the feasibility of the suggestions made by Authorities with regard to possible further metrics and any further ideas posted on the electronic forum at a later stage.

**(B) PCT METRICS FRAMEWORK**

28. Authorities recognized the importance of timely and reliable information for Offices in their various PCT capacities for the performance of the PCT system as a whole and welcomed the recent developments, notably the addition of new reporting tools in ePCT and the additional data on the 19 PCT metrics available via the WIPO IP Statistics Data center.

29. One Authority, while stating that it had found the data available in respect of e-filings to be extremely useful, expressed a concern as to the data accuracy in relation to paper filings. Another Authority suggested to consider the development of an easy tool to report issues related to the data discrepancies (“push of a button”). Yet another Authority suggested to improve the quality of the data relating to existing metrics before considering the addition of further metrics.

30. Several Authorities welcomed the offer to develop systems which allowed the International Bureau to “push” reports to Offices on a regular basis, provided such system remained optional for Offices and was flexible enough to meet individual demands.

31. In response to the query by one Authority as to the proposal to offer metrics concerning the quality of international applications and receiving Offices’ work products, the International Bureau replied that analysis of the data contained in Form RO/IB/106 (invitation by the receiving Office to correct certain defects in the application) as well as of the data contained in Form PCT/IB/313 (invitation by the International Bureau to the receiving Office to also invite the applicant to correct further defects in respect of which the receiving Office had not yet invited the applicant to correct) would make it possible to offer such metrics.

**3. BETTER UNDERSTANDING THE WORK OF OTHER OFFICES**

**(A) PUBLICATION OF DATA RELATED TO SEARCH STRATEGIES: PILOT AT THE EUROPEAN PATENT OFFICE**

32. Authorities welcomed the update by the European Patent Office on its pilot on the publication of data related to search strategies, noting that the pilot was one of the three tracks agreed upon at last year’s session with regard to the sharing of search strategies, the other two being the use of the existing process of recording the information in Form PCT/ISA/210 and the provision of full search records in whatever format Authorities produced them for publication on PATENTSCOPE.

33. Several of the Authorities which already made available their full search strategies on PATENTSCOPE stated that they wished to continue doing so, noting that the generation of full search records for the publication on PATENTSCOPE required little additional time and effort by the examiner. One Authority, while supporting the publication of search strategy information in a different form for users unfamiliar with the search terminology language, stated that it would have difficulties joining the EPO’s pilot before defining the additional workload and expenses that this would entail. Another Authority stated that it would continue to use existing Form PCT/ISA/210 for providing search information.

34. In response to queries from several Authorities on the extraction of keywords to be included in the search information and whether the tool assisting in that process could be provided as a feature in EPOQUE-Net, the EPO stated that the key words were extracted automatically from the search tools used by the examiner, including in the information only those elements which had generated relevant citations. Those elements not only included search terms from EPOQUE-Net but also covered terms used to search other databases and the Internet, as well as chemical structures searched in specialist databases. The EPO expressed its general willingness to discuss the automatic generation of search strategy information bilaterally with other Offices interested in joining the pilot. Regarding the scope of this pilot, the EPO clarified that it aimed at providing applicants and third parties more

information in confidence as to how the search was carried out. It was not aimed at worksharing, which could be better tackled than by mere publication of search reports on PATENTSCOPE.

35. Authorities expressed different views on the question as to who the main addressee of search strategy information to be published on PATENTSCOPE should be. While the EPO expressed the view that that the target addressee of information which was published on PATENTSCOPE were applicants only, who would not wish to be overloaded with complex search strategy information, notably search queries, other Authorities emphasized the importance of full search records for the purposes of work sharing between Offices and thus saw both applicants and examiners as target addressees. Whereas those Authorities expressed the view that both target groups could be reached by the publication of full search records on PATENTSCOPE, the EPO stated that, in its view, both groups had different interests which needed to be met by different means.

36. The United States Patent and Trademark Office again suggested, as it had done at the previous session of the Subgroup, that the International Bureau should conduct a survey to determine the most useful form and content for search records. The survey should be sent to selected applicants, Offices in their capacity as International Preliminary Examining Authorities and designated Offices, and user groups. In terms of content, the survey should include examples of search strategies under the three different practices to enable the practices to be compared and contrasted, rather than having the EPO's pilot evaluated only by the EPO, as had been suggested by the EPO. The EPO indicated that, in view of the fact that each of these different practices was based on different objectives and targeted to different user groups, it was of the opinion that Offices should first carry out their own evaluation. Noting that the EPO's pilot had only commenced in November 2015 and that it thus appeared premature to carry out any evaluation already at this stage, it was agreed to come back to the question as to how best to evaluate the three different approaches at next year's session of the Subgroup..

#### (B) STANDARDIZED CLAUSES

37. Several Authorities reported on their implementation of the standardized clauses for PCT work products, including in the form of the translations into French and Spanish that had been made available. Authorities reaffirmed that their use should be optional and left to the discretion of the examiner. Authorities that did not intend to use the standardized clauses welcomed their use by other Authorities, noting the value of having an exemplary set of clauses.

38. In response to a query from the State Intellectual Property Office of the People's Republic of China, the International Bureau indicated that it would be willing to translate the standardized clauses into Chinese.

39. One Authority suggested that standardized clauses could be developed relating to certification of a priority document. Another Authority stated that it disagreed with clauses VIII.9 and VIII.10 in relation to lack of conciseness, and considered that this objection should be put in Box VII of the written opinion.

40. The Japan Patent Office reported that it had published a "Handbook for International Search and Preliminary Examination at the Japan Patent Office" in October 2015, which was available in Japanese and English. While the Japan Patent Office did not intend to implement the standardized clauses, it intended to use the clauses in developing its own templates for written opinions.

41. The Subgroup recommended:

- (a) that Authorities using the standardized clauses should continue to report on their implementation on the dedicated page of the Subgroup's electronic forum and share experiences of their use; and
- (b) to continue to gain further experience in the use of the clauses before considering modifications to the English version, in line with the recommendation at the fifth session of the Subgroup to wait for at least one year after the implementation date of the standardized clauses before obtaining wider feedback and elaborating on whether the clauses should be expanded to cover other areas.

#### **4. QUALITY IMPROVEMENT MEASURES**

##### **(A) UNITY OF INVENTION**

42. Authorities taking the floor stated that they intended to post detailed comments on the proposals by IP Australia to amend Chapter 10 of the International Search and Preliminary Examining Guidelines on Unity of Invention. The Subgroup acknowledged that it was important that the process went hand in hand with the follow up to the report by the IP5 Offices on their respective approaches to unity of invention; one of the IP5 Offices stressed the importance of considering a harmonized approach to unity of invention before deciding what information should be added to the Guidelines.

43. The Subgroup recommended that discussions of the proposals among Authorities should continue on the Subgroup's electronic forum. If and when sufficient progress had been made, further consultations should be carried out by way of PCT Circulars.

44. Several Authorities indicated that they would be making detailed comments on the Subgroup's wiki to the additional unity issues that had been identified by the United States Patent and Trademark Office.

45. The Subgroup recommended to establish a discussion page on the Subgroup electronic forum for comments on the additional unity issues identified by the United States Patent and Trademark Office.

#### **5. APPOINTMENT OF INTERNATIONAL AUTHORITIES**

##### **(A) STRENGTHENING REQUIREMENTS FOR QUALITY MANAGEMENT SYSTEMS**

46. Authorities generally supported the proposal to strengthen the requirements on quality management systems set out in Chapter 21 of the International Search and Preliminary Examination Guidelines. While some Authorities stated that they could support making mandatory all requirements which currently were optional, others stated that they preferred a more refined approach, with some suggesting that a distinction should be made between the most basic, high level requirements (which should become mandatory) and other, low level requirements in respect of which Authorities should be given more flexibility.

47. The Subgroup recommended that Authorities should be given a further opportunity to provide detailed comments on each of the requirements set out in Chapter 21 with a view to whether or not they should be made mandatory and to further discuss the proposal at its next session. To facilitate the furnishing of comments, it requested the International Bureau to provide more detailed explanations as to the various requirements, together with preliminary suggestions as to whether they should be made mandatory or remain optional, and make available a template for the provision of comments.



48. Authorities recognized the need for a transitional period and other transitional arrangements for existing Authorities should certain requirements which at present were optional become mandatory. One Authority suggested that such a transitional period should be at least 18 months.

49. The International Bureau stated that, in view of the recommendation by the Subgroup to allow for more time to submit detailed comments on each of the requirements set out in Chapter 21 and to continue the discussions at its next session, any agreement on which requirements should become mandatory could not be taken into account in the context of the upcoming reappointment process for existing Authorities. Taking into account the need for further discussions and for transitional arrangements for existing Authorities, the more likely scenario would be that any new mandatory requirements would only enter into force at a much later point in time, say, in 2018 or 2019, and would then become applicable to both existing Authorities and Offices seeking appointment as of the same date.

50. There was general support for the proposal to further modify paragraph (d) of the Understanding on Procedures for Appointment of International Authorities with a view to making it mandatory for any candidate Office to have an operational quality management system for national search and examination work in place already at the time of appointment by the PCT Assembly. One Authority emphasized the strong incentive this would set for future candidate Offices to introduce a quality management system for national search and examination work, although it recognized that requirements under such national quality management systems could not be expected to be as stringent as those under Chapter 21 of the Guidelines.

51. One Authority expressed the view that it was premature to modify paragraph (d) of the Understanding on Procedures for Appointment of International Authorities. More time should be given to assess the effectiveness of the procedures under the Understanding, which had only been adopted by the Assembly in 2014 and had therefore only been applied to the most recent appointment.

#### (B) APPLICATION FORM FOR APPOINTMENT AS INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

52. Several Authorities stated that the draft application form would provide additional information of value to the PCT Committee for Technical Cooperation (PCT/CTC) and suggested further refinements to the form. These included removing the distinction between mandatory and optional sections of the form, a requirement for a candidate Office to demonstrate the quality level of their national work, such as by showing that searches were of high quality by comparing applications from patent family members at other Offices, submitting the results of the Office's quality review, adding further points in section 2.2 to demonstrate that the candidate Office had a quality management system in place, and providing clarification of what was meant by "sufficient technical qualifications".

53. Other Authorities, while generally supporting the creation of a standardized format for an Office seeking appointment as an International Authority to submit relevant information to the PCT/CTC, expressed the view that the form should not request information that went beyond the minimum requirements specified in Rules 36 and 63 and the "Understanding on Procedures for Appointment of International Authorities" agreed by the PCT Assembly in 2014. One of these Authorities expressed the concern that information requested on the number of national applications received, the technical field of applications, and national backlogs could be difficult for candidate Offices to provide. Instead, information required to be provided should be more closely linked to the requirements for an Authority to have sufficient resources to meet the requirements under Chapter 21 of the International Search and Preliminary Examination Guidelines. Another Authority stated that the application form should not apply to the re-appointment of existing Authorities. The International Bureau suggested that not to use the

form for re-appointment in the future may create a double standard even though the pending re-appointment process would not likely be affected.

54. One Authority stated that information on national backlogs could give a misleading view and added that its own national backlogs did not impede timely delivery of international work products.

55. The International Bureau reminded the Subgroup that one of the main purposes of the form was to facilitate the application process for Offices seeking appointment. This would ensure that issues of potential relevance for the PCT/CTC when giving its advice to the Assembly were adequately considered by the candidate Office. It was not mandatory to include information beyond the minimum requirements for appointment, but it was important that Offices were aware of what further information of interest to the PCT/CTC could be provided. However, given that there was no consensus on the possible contents of the standard application form, it did not appear possible at this stage to submit the draft form to the PCT Working Group or the PCT/CTC for further discussion.

56. The Subgroup recommended to continue discussions on the Subgroup's electronic forum with a view to discussing a revised form at its 2017 session.

## **6. OTHER IDEAS FOR QUALITY IMPROVEMENT**

57. There were no interventions by Authorities under this agenda item.

[End of Annex II and of document]