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(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

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A COMMON FRAMEWORK FOR
INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION

Initial Task Force Report prepared by the United Kingdom

INTRODUCTION

1. At the third session of the Working Group on Reform of the PCT, held in Geneva from November 18 to 22, 2002, it was decided to establish a "virtual" task force to consider the proposals put forward by the United Kingdom for a common quality framework (PCT/R/WG/3/4) and other points raised during the discussion on those proposals. The United Kingdom was asked to coordinate the work of the task force and submit an initial report to the Working Group and to the Meeting of the International Authorities (MIA) by the end of April 2003.

2. To facilitate discussion the United Kingdom prepared a discussion document which was posted for comment on the electronic forum website the International Bureau had created for the task force. All the responses received on that discussion paper can be viewed on the e-forum site (<http://www.wipo.int/pct/reform/qualityframework>).

3. The present document constitutes the initial report of the task force. It contains a synopsis of the comments received on the discussion document together with brief analysis by the United Kingdom. Attached in Annex I is a framework document which takes into account the comments received on the discussion document and sets out the key components of a quality framework the aim of which is to provide a model on which each Authority can base

its own detailed quality system. Reproduced in Annex II are the comments on the other points raised when document PCT/R/WG/3/4 was discussed. The United Kingdom is very grateful for the detailed and constructive comments received and thanks all those who made comments.

4. It should be stated at the outset that in light of the strong opposition expressed by the Authorities to the idea of an independent review mechanism, as proposed in the discussion document, that feature has now been replaced in the framework document by an internal review system for self-assessment.

QUALITY MANAGEMENT SYSTEM (QMS)

5. This part of the framework document sets out the basic features of a management system considered necessary to support the international search and preliminary examination process.

6. A proposal by the Netherlands to restructure this part of the framework by grouping the requirement criteria into two broad categories, namely: (a) technical competences of searchers and examiners, and (b) management and administration systems, has not been adopted at this stage but the document can be reformatted along these lines if others consider it appropriate. Moreover, the additional requirement criteria listed in Annex 3 of the Netherlands' submission may be too prescriptive for a document the aim of which is to provide a set of broad requirement criteria on which each Authority can base its QMS. However, these can be added if others consider them appropriate.

7. On a general point, the United States of America felt that there should be flexibility in the requirements to meet the time limits for issuing search and examination reports and that those time limits should be re-evaluated. However, we would suggest that this is not a matter which falls within the remit of the task force.

8. Japan asked who would judge the effectiveness and appropriateness of the measures taken by Authorities to meet the requirements criteria while the United States of America indicated that it should be for each Authority to decide what is appropriate. To take account of these comments it is made clear in the framework document that it is for individual Authorities to make these judgements.

Resources

9. Singapore stated that the resources specified in this section were an essential element in achieving and maintaining quality. Austria, in expressing support for this item, mentioned that it already has the listed resources in place. However, Japan wondered whether some of the resources mentioned were appropriate while Spain, Sweden and the European Patent Office (EPO) indicated that an Authority should not be tied to a standard list. To address these concerns the resources listed are presented as "examples" of the kind of resources an Authority should consider establishing to support the search and examination process.

10. Canada and the United States of America, while agreeing that each Authority should acquire and maintain sufficient resources, believe that it should be left to the individual Authorities rather than an outside body to determine what constitutes sufficient staffing and

appropriate equipment and facilities. This point has been taken into account by the replacement of the idea of an independent review mechanism with internal review systems in each Authority.

11. Sweden asked if there was any thought of establishing ISAs with responsibility for less than all technical fields. The International Federation of Intellectual Property Attorneys (FICPI) proposed that the complementary resources and competences of the Authorities could be pooled so that different Authorities could conduct parallel, supplementary, non-overlapping searches the results of which could be drawn together in a final composite international search report. The United Kingdom considers that this is more appropriate for discussion by the Working Group as part of the general discussion on PCT reform.

12. The Russian Federation suggested the creation of a centralised distance learning and training course for all staff involved in the search and examination process, analogous to WIPO World Academy's "General Course in Intellectual Property."

Administration

13. Canada, Spain, Sweden and the EPO, in referring to control mechanisms postulated under this item, indicated that it is not possible to guarantee that search and examination reports will always be issued on time and that backlogs will be kept to a minimum. They therefore preferred a less rigid approach. Japan also questioned the feasibility of imposing a strict requirement for the control mechanism with regard to backlogs. These concerns have been taken into account in the framework document by proposing more flexible administration criteria.

14. Australia suggested that the administration arrangements should also provide for preventative action and continuous improvement. These suggestions have been reflected in the attached document.

15. Singapore, in supporting the concept of a control mechanism, suggested that each Authority should include a report on backlog to the proposed external review panel. Although it is now proposed to drop the idea of an external panel, reporting on backlogs should form part of the internal reporting mechanism within each Authority. This is taken into account in the framework document.

16. The United States of America supported the concept of each Authority establishing a control mechanism but felt that the Authorities themselves should determine how to deal with backlogs. This will be possible under the proposed internal review arrangement.

17. Canada also felt it may be of limited value to establish procedures for measuring user perception.

Quality Assurance

18. The EPO said that it should be left to each Authority to decide what quality assurance procedures to implement rather than be subject to a standard set of procedures. Canada, Spain and Sweden also felt that the proposals were too rigid and needed to be more flexible. To address these concerns the attached framework document sets out what aspects a quality

assurance systems should cover, for example verification, validation and monitoring of search and examination work, and leaves it to individual Authorities to set up appropriate arrangements.

19. Australia believes that the quality assurance procedures should also verify the action taken by an Authority to address deficiencies and prevent recurrence. This suggestion has been taken on board in the framework document.

20. Japan expressed concern over the use of the terms “effective,” “suitable” and “reliable” which it felt were unclear. The words “suitable” and “reliable” have now been deleted and it is made clear in the framework document that it is for each Authority to determine whether the measures it takes to meet the QMS requirement criteria are effective and appropriate.

21. Japan also questioned the feasibility of providing “evidence” of conformity while the United States objected to such evidence being made available outside the Authority. To overcome these concerns no reference is made in the framework document to the provision of “evidence.”

22. Singapore expressed support for the quality assurance proposal which it viewed as a means of meeting and maintaining user expectations.

23. Austria said that more practical languages should be used to clarify what needs to be accomplished with regard to measuring, recording, monitoring and analyzing the performance of a quality management system. In this regard, as explained above, the framework document now simply sets out the basic requirement criteria of a QMS leaving it to individual Authorities to decide how to build those requirements into their individual QMSs.

Feedback Arrangements

24. In view of their opposition to an external review panel, Australia, Canada, Japan, Spain, Sweden, the United States of America and the EPO could not support the proposal that each Authority establish arrangements to allow for feedback from such a body.

25. Canada did however say that it would support the sharing of best practice between Authorities and leave it to each Authority to react as appropriate. It also made the point that a well-functioning feedback mechanism is an essential element of the proposed quality framework which needed a means by which users could voice their opinion and their views could be assessed. EAPO felt that the feedback mechanism could include arrangement of meetings and seminars.

26. The Russian Federation suggested that it would be useful to establish a common central database containing information about applications filed under the PCT in order to provide quality assessment of international searches and examinations in comparison with the national phase. The information would allow examiners to assess the quality of their work and identify any mistakes they may have made.

27. Japan expressed concern about using subjective indexes, like user satisfaction and perception, because of the variations between countries in user characteristics and filing strategies. Singapore, on the other hand, said that two-way communication/feedback arrangements should help clarify doubts and reservation while FICPI felt that it was important to canvass users' views.

28. The United Kingdom appreciates that there may be variations between countries but believes that the views of customers on the service they receive is a central plank of any quality system if the organisation providing the service is to be able to understand and meet its customer needs and expectations.

29. Japan questioned the meaning of “constructive feedback” and felt that feedback from national and regional Offices to Authorities should be flexible and voluntary. The word “constructive” has accordingly been deleted from the framework document while it is left open for each Authority to arrange how it might receive feedback from national and regional Offices.

30. Canada also expressed concern about the nature of comments from national and regional Offices and suggested the creation of a centralized feedback repository, controlled by the International Bureau.

31. Austria felt that the use of the word “mechanism” where used in respect to feedback from national and regional Offices should be replaced with something more precise. Accordingly, the word “mechanism” is not now used in the framework document and the passage in question has been revised.

Communication and Guidance to Users

32. Japan, Singapore, Spain and the EPO found the proposals under this item acceptable though the EPO expressed a preference for the use of the word “communication” in place of “dialogue.” Austria also said it preferred “communication.”

33. FICPI stressed that it was important for Authorities to warn applicants about proceeding without professional help.

INTERNAL REVIEW

34. Singapore supported the concept of a review mechanism, as proposed in the discussion document, which involved the use of an independent assessment panel, and made several recommendations. The Netherlands agreed that a common quality framework should be supported by a quality review panel acting initially as a forum for disseminating best practice, monitoring progress and providing advice and subsequently as an assessment body. Hungary suggests that, besides the use of an independent panel, the possibility of a uniform internal validation system should be explored. New Zealand said that, while it could understand the sensitivities in publishing the identity of an Authority that did not meet quality standards, it would be extremely useful for national Offices to know how much credibility to place on the search and examination reports from particular Authorities. FICPI supported the idea of an independent review and said that the findings should be made publicly available to ensure transparency.

35. Austria also felt that some outside control of the work of the Authority could be helpful in securing the quality of search and examination reports but, because of the practical and cost implications, questioned the feasibility of an independent review panel.

36. Canada, Spain and the EPO stated that they could not support the concept of an external review panel. Sweden also expressed scepticism and mentioned the difficulties in identifying and choosing suitable candidates for such a panel and the bureaucracy and costs implications. Japan also referred to the practical implications and the effect on an Authority's discretion to act and indicated that a review arrangement should be considered in the context of self-assessment.
37. The United States of America could see a benefit in Authorities sharing information about how they achieved and monitored compliance with quality standards but could see little or no benefit in an Authority disclosing the results of its internal review to other bodies. The United States of America strongly opposed the concept of an independent review panel and took the view that each Authority must retain the right to determine how to allocate its resources. It also doubted the ability of an external panel to provide advice to an Authority without knowledge of that Authority's resource constraints and to define and evaluate quality beyond objective statistics. Like others, the United States of America also expressed concerns over the resources needed to maintain such a panel.
38. Australia put forward an alternative approach whereby the results of an internal performance audit and system audits should be made publicly available or at least available to other Offices using a standard reporting template. This it said would assure Offices that the QMS were operational and effective and provide a means of disseminating best practice.
39. In light of the reservation expressed by the Authorities to the concept of an independent review panel the original idea of a review mechanism has been replaced in the attached framework document with a scheme that recommends that each Authority establish its own internal review system for self-assessment. The document sets out a model review arrangement on which individual Authorities should base their own in-house systems.
40. The framework document also proposes that each Authority present an annual report to MIA and that MIA in turn submit a general progress report to the PCT Assembly. This should help disseminate best practice between Authorities and promote confidence among national and regional Offices in the work undertaken by those Authorities and hopefully discourage the duplication of work in the national and regional phase. It is for future debate whether the specific results of each Authority's internal review are made available to other Authorities and national and regional Offices.

IMPLEMENTATION

41. If the quality framework set out in the attached document is acceptable, consideration will need to be given as to how it should be implemented. For instance, should it be incorporated in the agreements between the International Authorities and the International Bureau, the International Search and Preliminary Examination Guidelines, the PCT Administrative Guidelines, the PCT Regulations or should it be implemented by some other means? Australia believed it should form part of the agreements between an Authority and the International Bureau while the EPO were of the view that quality should remain an issue for each Authority and would not be appropriate for inclusion in such agreements. The Netherlands would like to see the framework incorporated in the PCT Guidelines initially but ultimately presented in a document of a more general nature.

COMMENTS BY TASK FORCE MEMBER OR OTHERS SUGGESTIONS MADE BY DELEGATIONS WHEN DOCUMENT PCT/R/WG/3/4 WAS DISCUSSED AT THE THIRD SESSION OF THE WORKING GROUP ON REFORM OF THE PCT

42. The detailed comments made by those who subscribed to the task force e-forums site on the other points made by the Working Group when PCT/R/WG/3/4 was discussed are reproduced in Annex II. The following is a summary of those comments.

A common central database containing the entire PCT minimum documentation and accessible by all Authorities would help to ensure consistency

43. Canada, Japan, the Russian Federation, Sweden, the United States of America and FICPI supported this proposal though the United States of America expressed concern over funding and maintaining such a database. Australia and Sweden also questioned how it would help improve consistency of citation. Austria, Spain and the EPO and felt that the idea of a central database was more a matter for consideration by the PCT Committee on Technical Cooperation.

Mechanisms could usefully be provided for feedback from designated and elected Offices, as well as from applicants and their representatives who receive searches carried out by different Offices on applications from the same patent family

44. There was general support for this proposal though Australia, Austria and the EPO indicated that the feedback should be directed to the Authorities only. Sweden asked in instances feedback would be given while the United States of America and Canada felt that it should be better defined. what

It may be useful for the International Bureau to arrange meetings or seminars at which Offices could exchange experience in quality control

45. There was general support for this idea though Austria raised the question of cost while Sweden felt that bilateral visits would probably be more beneficial than meetings.

An extensive examiner exchange program would encourage the development of consistent standards and practices

46. There was general support for this proposal though reservations were expressed about an "extensive" exchange program in view of the resource implications for Authorities. The United States of America suggested that it might be worth exploring other ways of improving communication and cooperation among Authorities to achieve consistency. FICPI also suggested supplementing an exchange program with a common training program for examiners.

"Top-up" searches might be introduced into the PCT system, providing for additional search, late in the international phase, for potentially relevant material which had not yet been included in the relevant search databases at the time of the main international search

47. Views were mixed on this proposal. Australia and Sweden were not in favor of a "top up" search which the latter felt would result in duplication while Austria also expressed concerns and wondered whether it would result in a new fee and if the results would be -

published. Canada also felt that the proposal was not feasible given current work pressures. The EPO also had reservation over “top -up” searches being carried out in the international phase while the United States of America said that such searches should only be performed as part of the international preliminary examination report (IPER). Singapore thought that “top up” searches could be beneficial but that a detailed time/cost/benefit analysis should be undertaken. The Russian Federation also felt they could be beneficial but expressed concerns about the effect on time limits and suggested that they should be performed in conjunction with the preparation of an IPER. FICPI, expressed strong support for the proposal.

In relation to the reference to “inventive concept(s)” in the suggested quality criteria in the Appendix, the search could consider the limitation of every claim, rather than a general inventive concept

48. Spain and Sweden were opposed to this proposal while the EPO did not consider it feasible. Canada also felt that it would not add any value as the claims may change during the international and national phase. The United States of America in contrast supported the proposal on the grounds that it would increase the usefulness to national and regional Offices of the Preliminary Report on Patentability.

The definition and monitoring of quality may be a matter to be dealt with in the agreement between the International Bureau and various Authorities

49. Canada and the EPO did not consider quality to be appropriate for inclusion in the agreements between the Authorities and the International Bureau while Australia, in contrast felt that it should be part of those agreements. Canada felt that a quality framework should be incorporated in the Search and Examination Guidelines. Austria questioned the role of the International Bureau if quality was included in the agreements.

[Annex follows]

ANNEXI

ACOMMONFRAMEWORKFOR
INTERNATIONALSEARCHANDPRELIMINARYEXAMINATION

INTRODUCTION

1. This document sets out the main features of a quality framework for international search and preliminary examination. It describes a minimum set of criteria which each International Authority (“Authority”) should use as a model for establishing their individual quality scheme.

QUALITY MANAGEMENT SYSTEM

2. Each Authority should establish and maintain a quality management system (QMS) which sets out the basic requirements with regard to resources, administrative procedures, feedback and communication channels required to underpin the search and examination process. The QMS established by each Authority should also incorporate a quality assurance scheme for monitoring compliance with these basic requirements and the International Search and Preliminary Examination Guidelines.

3. Adoption by the Authorities of common QMS requirements, which are recognised by all Authorities and national and regional Offices, should help achieve a consistent approach. This, in turn, should help build confidence among national and regional Offices in the work done by the Authorities. It will be for each Authority to ensure that the measures they have taken to meet the requirements are effective and appropriate.

Resources

4. An Authority should be able to accommodate changes in workload and should have an appropriate infrastructure to support the search and examination process and comply with the QMS requirements and Search and Examination Guidelines. The following are examples of the kind of resources and infrastructure an Authority should consider establishing:

(a) A complement of staff sufficient to deal with the inflow of work and which has the technical qualifications to search and examine in the required technical fields and the language facilities to understand at least those languages in which the minimum documentation referred to in PCT Rule 34 is written or translated.

(b) Appropriately trained/skilled administrative staff, resources at a level to support the technically qualified staff and facilitate the search and examination process.

(c) Appropriate equipment and facilities, such as IT hardware and software, to support the search and examination process.

(d) Possession of, or access to, at least the minimum documentation referred to in PCT Rule 34, properly arranged for search and examination purposes, on paper, in microform or stored on electronic media.

(e) Comprehensive and up-to-date work manuals to help staff understand and adhere to the quality criteria and standards and follow work procedures accurately and consistently.

(f) An effective training and development programme for all staff involved in the search and examination process to ensure they acquire and maintain the necessary experience and skills and are fully aware of the importance of complying with the quality criteria and standards.

(g) A scheme for periodically testing all staff for knowledge of the requirements and standards of search and examination.

(h) A system for continuously monitoring and identifying the resources required to deal with demand and comply with the quality standards for search and examination.

Administration

5. An Authority should have in place the following minimum practices and procedures for handling search and examination requests and performing related functions, such as data-entry and classification:

(a) Effective control mechanisms regarding timely issue of search and examination reports to a quality standard consistent with the Search and Examination Guidelines.

(b) Appropriate control mechanisms regarding fluctuations in demand and backlog management.

(c) An appropriate system for handling complaints and taking corrective and preventative action where appropriate, and the application of monitoring procedures for measuring users satisfaction and perception and for ensuring their needs and legitimate expectations are met.

(d) An effective system for ensuring the continuous improvement of the established processes.

Quality Assurance

6. An Authority should have procedures regarding timely issue of search and examination reports of a quality standard in accordance with the Search and Examination Guidelines. Such procedures should include:

(a) An effective internal quality assurance system for self assessment, involving verification and validation and monitoring of searches and examination work for compliance with the Search and Examination Guidelines and channeling feedback to staff;

(b) A system for measuring, recording, monitoring and analysing the performance of the quality management system to allow assessment of conformity with the requirements; and

(c) A system for verifying the effectiveness of action taken to address deficiencies and to prevent issues from recurring.

Feedback Arrangements

7. To help improve performance and foster continual improvement, each Authority should:

(a) Communicate the results of their internal quality assurance process to their staff to ensure that any necessary corrective action is taken and for the dissemination and adoption of best practice; and

(b) Provide for effective communication with WIPO and designated and delected Offices to allow for prompt feedback from them so that potential systemic issues can be evaluated and addressed.

Communication and Guidance to Users

8. An Authority should have in place the following arrangements for ensuring effective communication with users:

(a) Effective communication channels so that enquiries are dealt with promptly and that appropriate two-way communication is possible between applicants and examiners.

(b) Clear, concise and comprehensive guidance and information to users (particularly unrepresented applicants) on the search and examination process which could be included on each Authority's website as well as in guidance literature.

INTERNAL REVIEW

9. In addition to establishing a quality assurance system for checking and ensuring compliance with the requirements set out in its QMS, each Authority should be required to establish its own internal review arrangements to determine the extent to which it has established a QMS based on the above model and the extent to which it is complying with the QMS requirements and the Search and Examination Guidelines. The reviews should be objective and transparent so as to demonstrate whether or not those requirements and guidelines are being applied consistently and effectively and should be undertaken at least once a year.

10. It is open to each Authority to set up its own arrangements but the following is proposed as a guide to the basic components of an internal review mechanism and reporting system.

Monitoring and Measuring

11. The input to each review should include information on:

- (a) conformity with the QMS requirements and Search and Examination Guidelines;
- (b) any corrective and preventative action taken to eliminate the cause of non-compliance;
- (c) any follow-up action from previous reviews;
- (d) the effectiveness of the QMS itself and its processes ;
- (e) feedback from customer, including designated and delected Offices as well as applicants; and
- (f) recommendations for improvement.

12. Suitable arrangements should be established for monitoring, recording and measuring compliance with the QMS requirements and Search and Examination Guidelines. Arrangements should also be made to measure customer satisfaction, which should include the views of designated and delected Offices as well as applicants and their representatives.

Analysis

13. The collected data should be analysed to determine to what extent the QMS requirements and Search and Examination Guidelines are being met. The results of the internal review should be presented to senior management within the Authority so that they can gain an objective appreciation of performance against the QMS requirements and Search and Examination Guidelines and identify opportunities for improvement and whether changes are needed.

Improvement

14. Each Authority should:

- (a) have an established system to continually improve its performance against the QMS requirements and to review the effectiveness of its QMS; and
- (b) identify and promptly take corrective action to eliminate the cause of any failure to comply with the QMS requirements and Search and Examination Guidelines.

REPORTING ARRANGEMENTS

15. There should be two stages in the reporting arrangements.

Stage 1

16. Each Authority should be required to submit an initial report to MIA describing what it has done to implement a QMS based on the broad requirements set out in the present document. This would help identify and disseminate best practice among Authorities. MIA should then submit a general initial report on progress to the PCT Assembly.

Stage 2

17. Following the initial reporting in stage 1, annual reports should be prepared by each Authority on the results of its internal review. The reports should be submitted to MIA using a standard template. Without naming specific Authorities, MIA should, in turn, present a general progress report each year to the PCT Assembly.

[Annex II follows]

ANNEXII

COMMENTSMADBYMEMBERSOFTHETASKFORCEON
THEOTHERSUGGESTIONSMAD BYDELEGATIONSWHEN
DOCUMENTPCT/R/WG/3/4WASDISCUSSEDATTHETHIRDSESSIONOF
THEWORKINGGROUPOONREFORMOFTHEPCT

- (A) ACOMMONCENTRALDATABASECONTAININGTHEENTIREPCT
MINIMUMDOCUMENTATIONANDACCESSIBLEBYALLAUTHORITIES
WOULDHELPTOENSURECONSISTENCY ?

CommentbyAustralia: “Weunderstandthishasbeendrivenbyuserdissatisfactionwhere potentiallydifferentcitationshavebeenraisedbydifferentOfficesagainstthesameinvention. Howeverwedonotbelievethattheprovisionofacommon centraldatabasewilladdressthis problem.”

CommentbyAustria: “Thiswasalreadydiscussedinthelastmeetinganditwasconsidered thatthisquestionshouldbediscussedintheframeworkofthePCTCTC.”

CommentbyCanada: “CIPOfullysupportstheestablishmentofacommoncentraldatabase containingtheentirePCTminimumdocumentationasameansofpromotingconsistency amongInternationalAuthorities.”

CommentbytheEPO : “ShouldbereferrdtothePCTCommitteeonTechnical Co-operation.”

CommentbyJapan: “Wesupport.”

CommentbyRussianFederation: “Rospatentsupporttheestablishmentofacommoncentral databasecontainingtheentirePCTminimumdocumentation.”

CommentbySpain: “ThismattershouldbestudiedinthePCT/CTC.”

CommentbySweden: “Wewonderinwhatway“commoncentraldatabase...”couldhelp improveconsistencyandwhowillfinancehostingofthedatabase,updatingitandthe necessaryhigh -speed-links.”

Commentbythe UnitedStatesofAmerica : “Thisproposalsupportstheestablishmentofa commoncentraldatabase.TheUnitedStatessupportsthisproposalinprinciple,buthas concernsoverfundingandmaintenanceofsuchadatabase.”

CommentbytheInternationalFederationofIntellectualPropertyAttorneys (FICPI): “...a commondatabaseisa *sinequanon* totheobjectiveofachievingconsistency.Itisequally importantthatsearchers/examinersshouldinterrogatethedatabaseinacommonwayand shouldbeprovidedwiththesamesearchtoolsandacommon practicemanual.”

(B) MECHANISMS COULD USEFULLY BE PROVIDED FOR FEEDBACK FROM DESIGNATED AND ELECTED OFFICES, AS WELL AS FROM APPLICANTS AND THEIR REPRESENTATIVES WHO RECEIVED SEARCHES CARRIED OUT BY DIFFERENT OFFICES ON APPLICATIONS FROM THE SAME PATENT FAMILY

Comment by Austria: “This obviously covers only a feedback to the Authorities, not to a QRP.”

Comment by Australia: “We support this because feedback is an inherent part of a quality system. However, we believe the feedback should be given directly to the International Authority.”

Comment by Canada: “While, in general, CIPO supports a feedback mechanism, once again we would appreciate a more detailed description of the proposed mechanism.”

Comment by the EPO: “Supported, however, feedback should only be to the International Authorities themselves, not to any external body.”

Comment by Spain: “We can support.”

Comment by Sweden: “It is not clear to what instances the feedback will be given.”

Comment by the United States of America: “The United States can support a proposal to implement a system that would allow the national and regional Offices the ability to provide feedback to the Authorities. However, the nature of the feedback must be better defined in line with our previous comments to paragraph 6(d)(ii) above.”

(C) IT MAY BE USEFUL FOR THE INTERNATIONAL BUREAU TO ARRANGE MEETINGS OR SEMINARS AT WHICH OFFICES COULD EXCHANGE EXPERIENCE IN QUALITY CONTROL

Comment by Australia: “We believe this would foster understanding between Offices and enable all Offices to learn and contribute.”

Comment by Austria: “The Austrian Patent Office can support this; however, also in this context we would like to raise the question of costs.”

Comment by Canada: “CIPO fully supports a greater forum for the exchange of ideas concerning quality control.”

Comment by the EPO: “Supported.”

Comment by Japan: “We support.”

Comment by the Netherlands: “Organisation of meetings and seminars to exchange experience will be very useful. It could also be worthwhile to organise presentations on key aspects of the quality system.”

Comment by Sweden: “Bilateral visits would probably yield more than the proposal international meetings.”

Comment by Spain: “We can support.”

(D) AN EXTENSIVE EXAMINER EXCHANGE PROGRAM WOULD ENCOURAGE
THE DEVELOPMENT OF CONSISTENT STANDARDS AND PRACTICES

Comment by Australia: “We support this but have reservations about an “extensive” program as the feasibility of such a program would be dependent on the available human and financial resources of individual International Authorities.”

Comment by Austria: “In principle the Austrian patent Office can support this, however in the current workload situation we are not in favour that the exchange should be extensive.”

Comment by Canada: “While the productivity and financial implications associated with an extensive exchange program raises some concern, on general CIPO is supportive of this type of initiative.”

Comment by the EPO: “Supported, however the word extensive should be removed, as this would perhaps not be realistic in the current work environment.”

Comment by Japan: “We support.”

Comment by Spain: “We can support.”

Comment by Sweden: “This proposal is very well worth pursuing, since it is an effective means to ensure harmonisation. However, for economical and production reasons we are not in favour of “extensive” examination exchange, but we have good experience of a more moderate exchange of examiners.”

Comment by the United States of America: “This proposal calls for establishment of an extensive examiner exchange program. While we share the goal of encouraging development of consistent standards and practice, we have some reservations concerning the effectiveness of such a program in achieving this goal. While it is possible that a limited, voluntary exchange program might have some value, an extensive program as proposed would be very resource intensive and would likely yield little in the way of results for the amount of funds expended. It may be helpful to investigate other ways of improving communication and cooperation among offices to achieve the stated goal of consistency in a more effective manner.”

Comment by FICPI: “...searchers should be given common training, preferably under central control...supplemented with systematic and extensive exchange of examiners between offices.”

(E) “TOP-UP” SEARCHES MIGHT BE INTRODUCED INTO THE PCT SYSTEM, PROVIDING FOR ADDITIONAL SEARCH, LATE IN THE INTERNATIONAL PHASE, FOR POTENTIALLY RELEVANT MATERIAL WHICH HAD NOT YET BEEN INCLUDED IN THE RELEVANT SEARCH DATABASES AT THE TIME OF THE MAIN INTERNATIONAL SEARCH

Comment by Australia: “We would not support the concept of supplementary searches being carried out routinely because we believe this would largely result in duplication of work. However, we acknowledge that there may be limited occasions when a “top -up” search may be necessary.”

Comment by Austria: “We have some concerns about this proposal. At this time there is no possibility for this in present PCT -Rules. In addition we are wondering if this would not result in a new fee for the applicants. How would the results of the “Top -up” search be published?”

Comment by Canada: “This proposal is not feasible in the current environment of unprecedented growth and escalating backlogs.”

Comment by the EPO: “This was mentioned by some delegates during the last meeting of the PCT Reform Working group, however we have reservations as to the feasibility of such a system and in any event would oppose a permanent move to restrict the possibility of designated Offices carrying out their own supplementary search reports after entry to the national/regional phase.”

Comment by Russian Federation: “Top-up” searches could be beneficial, but we have some concerns about time limits. It seems to us that such searches should be performed in conjunction with the preparation of an IPR.”

Comment by Singapore: “The proposal on top -up searches as we understand from previous PCT documents, is focused on giving applicants an opportunity to file such requests with another Authority (An Authority different from the Authority that conducted the International Search) if time permits and the applicant furnishes whatever fees necessary. The results of such searches could be relied upon during the national or regional Phase, and possible fee reductions could be in place, where appropriate. Such top -up searches could be beneficial but a more detailed time/cost/benefit analysis of having this feature in the international phase of the PCT should be made.”

Comment by Sweden: “During the time there have been proposals for additional searches, for parallel searches, for stocked searches and now for top -up search. The international search is done normally within 16 months from priority date and in that case 4 months from the international filing date. At that time the documentation databases should be updated with relevant material. The cost to make a new database -search must be weighed against the possibility to find relevant material added after the ordinary search. We think that service can be given by other than the ISA. Thus we oppose to introduce the proposed top -up-search.”

Comment by the United States of America: “The concept of performing a “top -up” or updated search may have some benefits so long as it is envisioned that such a search is only to be performed in conjunction with the preparation of an IPR (i.e. not at a time prior to 30 months in cases where no Demand has been filed or where the issuance of the IPR occurred substantially prior to the 30 month period.”

Comment by FICPI: “The PCT searching system at present suffers from the disadvantage that it is not able to find prior art, especially prior patent applications, which were filed shortly before the international filing date. For this reason FICPI strongly supports the proposal to provide for additional “top -up” searching later in the international phase.”

(F) IN RELATION TO THE REFERENCES TO “INVENTIVE CONCEPT(S)” IN THE SUGGESTED QUALITY CRITERIA IN THE APPENDIX, THESE SEARCH COULD CONSIDER THE LIMITATIONS OF EVERY CLAIM, RATHER THAN A GENERAL INVENTIVE CONCEPT

Comment by Austria: “It is not clear to us what this proposal means. However, we have the vague impression this has nothing to do with the question of quality.”

Comment by Canada: “CIPO does not believe that this suggestion would add any value to the process as the claims may change during both the international and national phase.”

Comment by the EPO: “Not feasible.”

Comment by Spain: “We are not able to support this point.”

Comment by Sweden: “Not support. The quality of search and examination in PCT is defined through PCT Articles, Rules, Administrative Instructions and Guidelines for search and examination. In the agreement between the ISA / IPEA and WIPO it is stated that in carrying out search and examination the ISA and IPEA shall apply and observe all the common rules for search and examination.”

Comment by the United States of America: “The United States support this proposal. We believe that it would increase the usefulness of the Preliminary Report on Patentability to all national and regional Offices.”

(G) THE DEFINITION AND MONITORING OF QUALITY MAY BE A MATTER TO BE DEALT WITH IN THE AGREEMENT BETWEEN THE INTERNATIONAL BUREAU AND VARIOUS AUTHORITIES

Comment by Australia: “Assuming that the quality system is set up appropriately, we believe that this should be part of the agreement between an Authority and WIPO and that it should be a requirement to be met by all new Authorities.”

Comment by Austria: “Also in this point we are not clear what is meant. Does this mean that the International Bureau shall control the work of the Authority? However in this case it would mean that only the formal aspects of the report would be viewed because the IB lacks the technical staff and knowledge to review the contents of the reports.”

Comment by Canada: “CIPO feels that the quality assurance framework and the associated standards should be reflected in the Search and Preliminary Examination Guidelines and not in the agreement between the International Bureau and the respective International Authorities.”

Comment by the EPO: “Once again our view is that quality must remain an issue for each international Authority and would not be appropriate for inclusion in the agreement between the authority concerned and the International Bureau.”

[End of Annex II and of document]