

Patent Cooperation Treaty (PCT) Working Group

Tenth Session
Geneva, May 8 to 12, 2017

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

Document prepared by the International Bureau

SUMMARY

1. The International Bureau proposes that the Quality Subgroup continues to review the draft application form for appointment as an International Searching and Preliminary Examining Authority that has been discussed since 2015, based on the experiences of its use in the procedure for seeking extension of appointment, with a view to agreeing on a standard version of the form at a later date.

BACKGROUND

2. At the fifth informal meeting of the Quality Subgroup of the Meeting of International Authorities (PCT/MIA) in February 2015, the Subgroup discussed the requirements that an Office should meet to act effectively as an International Authority and how these could be better expressed in the criteria for appointment. As part of the follow up to these discussions, the Subgroup recommended “to elaborate on the development of a standard application form for any request for appointment, with a view to ensuring that all pertinent quality issues were indeed covered in any request for appointment” (see paragraph 50 of the Summary by the Chair of the meeting, reproduced in Annex II to document PCT/MIA/22/22).

3. The Quality Subgroup has discussed a draft application form for appointment as an International Searching and Preliminary Examining Authority through its electronic forum and at its sixth and seventh informal meetings in 2016 and 2017. Discussions at the seventh informal

meeting in February 2017 are summarized in paragraphs 60 to 65 of the Summary by the Chair, reproduced in Annex II to document PCT/MIA/24/15; paragraph 65 sets out the next steps as recommended by the Subgroup, as follows:

“65. The Subgroup recommended that the International Bureau invite further comments on details of drafting of such an application form through the electronic forum for a period of around two weeks before seeking to establish a proposal to the PCT Working Group or Committee for Technical Cooperation.”

4. The Annex to this document reproduces the most recent draft of the application form, as considered by the Quality Subgroup in February 2017.

EXPERIENCE IN THE USE OF DRAFT APPLICATION FORM FOR APPOINTMENT AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY

5. As part of the procedure to extend the appointment of International Searching and Preliminary Examining Authorities with effect from January 2018, many International Authorities have used the draft application form as the basis for their submission to the PCT Committee for Technical Cooperation (PCT/CTC) to give its advice on their extension of appointment (see documents PCT/CTC/30/3 to 24). In this regard, the form has been able to provide useful guidance to Authorities on the information that could be of potential interest to the Committee. However, from the experience of Authorities using the draft application form for the first time, the International Bureau does note that there is considerable variation in the scope and depth of information provided, as well as the emphasis given to the specific parts of the application.

6. Based on this experience, International Bureau is not yet able to recommend an “optimal” format for an Office to submit its application for appointment or extension of appointment as an International Authority for consideration by the PCT/CTC or the PCT Assembly. Indeed, it seems clear that different information will be needed in certain cases, depending on the nature of the Office (for example, single national Office or intergovernmental organization) and on the motivation for the application (does the Office seek to provide services based largely on national interests, regional interests, language-based interests or other factors?).

7. However, one of the aims of the PCT/CTC, as stated in Article 56(3)(ii), is for the Committee to contribute, by advice and recommendations to the securing of the maximum degree of uniformity in the documentation and working methods and the maximum degree of uniformly high quality in the reports of the International Searching and Preliminary Examining Authorities. Toward this end, it does seem clear that the draft form has been useful in helping Offices seeking appointment or extension of appointment to consider what issues are likely to be considered relevant by other Offices for the purposes of the review by the PCT/CTC. Moreover, during the process of extension of appointment when the PCT/CTC and PCT Assembly have many applications to consider at the same session, a certain degree of uniformity between applications could facilitate the Committee to give its advice to the Assembly on the extension of each appointment, and for the Assembly to reach a decision on the matter efficiently, consistently and thoroughly.

8. On the other hand, while the purpose of the documentation to be provided for extensions of appointment in 2017 was to make the processes of appointment and extension of appointment generally similar (see paragraph 10 of document PCT/WG/9/14), this may not be appropriate in view of the differences between the two situations. Ideally, it should be clear that an operational International Authority meets the minimum requirements for appointment and improves its search systems and quality-related processes on an ongoing basis. As such, it could be argued that the PCT/CTC should be able to take these matters for granted and look more generally at the questions of whether the extensions of appointment are beneficial to the system and what particular steps should be taken, individually or collectively, to increase the uniformity and quality of the reports issued by the International Authorities. For that purpose, it might be more appropriate for some of the issues set out in the draft application form, either to

be incorporated into the annual quality reports, or else be the subject of a similar annual process in parallel to those reports and therefore not require explicit inclusion in any application for extension of appointment.

9. The next time that the Committee for Technical Cooperation is likely to consider many applications at a single session will be in 2027, provided the Assembly approves a 10 year duration for the agreements that the International Bureau has with each Office in relation to its functioning as an International Authority. Rather than the Working Group or Committee for Technical Cooperation adopting the draft application form at this stage, as recommended by the Quality Subgroup (see paragraph 3, above), discussions could continue in the Quality Subgroup to improve on the draft application form based on the experience of its use in the present process of extension of appointments. Making further revisions to the present form to achieve greater uniformity between applications would appear preferable to reaching agreement on a standard application form for use by all current and prospective International Authorities that may not achieve this aim. The fact that this draft form is publicly available, together with a variety of documents for the PCT/CTC based on the draft form will, however, already suffice to give any individual potential candidate Office a better sense of what the other Contracting States will wish to see in order to evaluate their applications without the need to approve a final version at this stage.

SUGGESTED WAY FORWARD

10. The International Bureau therefore suggests that Quality Subgroup should continue to review the draft application form, taking into account the experiences of using the form in the process for extension of appointment of International Authorities and any feedback on the form from the Working Group, with a view to adoption of a standard form at a later date. Meanwhile, any Office seeking appointment as an International Searching and Preliminary Examining Authority would be free to use the draft application form as a basis for its submission to the Committee for Technical Cooperation if it so wishes.

11. One matter that the Quality Subgroup could consider in its further review of the draft application form is the information that should be recorded by operational International Authorities on an ongoing basis, in a similar way to the annual reporting on the Quality Management Systems. For example, instead of setting out the scope of search databases or providing a full list of scientific journals that an Authority has access to in the application for extension of appointment every 10 years, this information could be made publicly available and updated as appropriate, both giving confidence in the ongoing capabilities of the Authority and providing a reference tool for other Authorities and national Offices to help improve their own services. Examiner training is another example of detailed information that could be recorded on an ongoing basis. An application for extension of appointment would then make reference to this information, which would ideally cover all the minimum requirements under Rules 36 and 63 and already show that they had been met. This would enable the application form for extension of appointment to focus on the benefits that the extension of appointment of an Office would bring to the PCT System as a whole.

12. For an initial appointment, whether an Office meets the minimum requirements in the present procedure is largely a matter for self-certification, with the recommended assistance of one or more existing International Authorities who help in the assessment of the extent to which the Office meets the criteria for appointment. In addition to this process, a prospective International Authority in the future could supply the information on the minimum requirements in a similar way to how existing Authorities would record these details on an ongoing basis, as described in paragraph 11, above. The application form could be more directed to issues of interest to the Committee for Technical Cooperation and the Assembly, such as the contribution that the prospective Authority could make to the international patent system.

13. *The Working Group is invited:*

(i) to comment on the draft application form for appointment as an International Searching and Preliminary Examining Authority under the PCT, as set out in the Annex to this document;

(ii) to take note of the observations set out in paragraphs 5 to 9, above; and

(ii) to approve the suggested way forward, as set out in paragraphs 10 to 12, above.

[Annex follows]

DRAFT APPLICATION FORM

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

[Only the questions in Sections 1 and 2 (concerning procedural issues and minimum requirements for appointment) are mandatory. The questions in the other sections are examples of the type of information which may be useful to allow members of the PCT Committee for Technical Cooperation to form a rounded view of the Office and its application and may be omitted, varied or supplemented according to the particular circumstances of the Office.]

1 – GENERAL

Name of Office or intergovernmental organization:

Date on which application for appointment was received by the Director General: *[to be filled in by the International Bureau – this may need to distinguish between the dates of a request to convene the PCT/CTC and the date on which this form and any accompanying material was received]*

Session of the Assembly at which appointment is to be sought:

Expected date at which operation as ISA/IPEA could commence:

Existing ISA/IPEA(s) assisting in assessment of extent to which criteria met:

2 – SUBSTANTIVE CRITERIA: MINIMUM REQUIREMENTS FOR APPOINTMENT

2.1 – SEARCH AND EXAMINATION CAPACITY

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

Employees qualified to carry out search and examination:

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

[The above breakdown is intended to show the fields to which the examiners are currently assigned, even though some may be qualified also to work in others. Where the examiners are split between different Offices, subject to working arrangements other than direct employment, not all examiners expected to be made available for PCT work, or other special arrangements apply, details should be provided as additional columns of the table or explanatory text below.]

Training Programs

[Give a summary of the training programs for new examiners and ongoing training activities for existing examiners, including typical times spent on training.]

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

Access to the minimum documentation for search purposes:

- Full access
- Partial access (indicate areas currently missing and how you intend to obtain access to the missing areas)

Search systems:

[Indicate IT systems or paper collections used for search of different forms of prior art]

Rules 36.1(iii) and 63.1(iii): That Office or organization must have a staff which is capable of searching and examining the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated.

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

Other languages in which large numbers of examiners are proficient:

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

2.2 – QUALITY MANAGEMENT

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

National quality management system: *[Please attach a QMS report according to the template used by International Authorities indicating the extent to which the national quality management system meets the requirements of Chapter 21 of the PCT International Search and Preliminary Examination Guidelines and, where relevant, the adjustments which have been planned to ensure that the system will meet the requirements for operation as an International Authority. Include information concerning whether the standard is externally reviewed in conformance with ISO 9001 or other international standard, and for how long the system has been in operation.]*

If applying as an international organization consisting of a group of national Offices, outline the arrangements to ensure appropriate distribution, and consistent timeliness and quality of reports:

3 – INTENDED SCOPE OF OPERATION

Language(s) in which services would be offered:

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

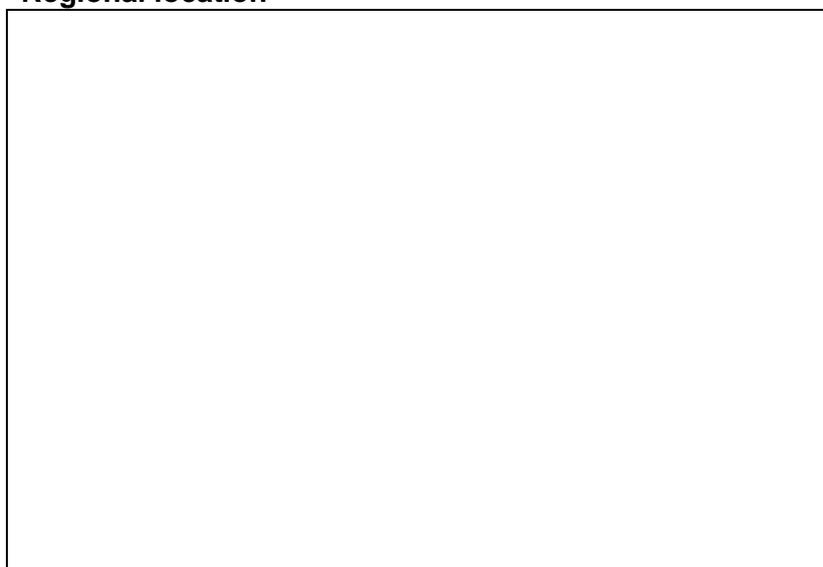
Limitations on scope of operation:

4 – STATEMENT OF MOTIVATION

[Brief indication of reasons for applying, including what benefits the Office expects appointment to bring to: (i) its State or region, (ii) itself, and (iii) the PCT system as a whole.]

5 – APPLICANT STATE(S)

Regional location



[Map showing State(s) and neighboring States]

Regional organization memberships:

Population:

GDP *per capita*:

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

Number of research universities:

Summary of national patent information network (for example patent libraries, technology and innovation support centers):

Major local industries:

Major trading partner States:

Other key information: [for example summary of or link to national innovation strategies or regional development plans involving IP]

6 – PROFILE OF PATENT APPLICATIONS

Number of national applications received – by technical field

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

[Breakdowns need not be in the above form, but should give a general idea of the distribution of work within the Office and be compatible with the indication of fields of expertise of examiners, below. More detailed breakdowns such as using the 35 fields of technology in the WIPO IPC – Technology concordance table¹ could be considered. Brief explanations of methodology may be useful.]

Number of national applications received – by route

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

Number of international applications received as RO

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

Main Offices/States in which priority is claimed from national applications:

[The questions below were moved from the section “Search and Examination Capacity” in the previous draft]

¹ http://www.wipo.int/ipstats/en/statistics/technology_concordance.html

Average time taken for national patent processing

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

[Noting that national systems vary considerably in details such as when search and examination need to be requested, Offices frequently measure performance in different ways. The indicator should state whether it is measured from filing, priority, request for the relevant process or some other point. Where the national system includes routes with radically different effects (such as deferred examination), the indicators may be split into different categories.]

National backlogs

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

7 – SUPPORT REQUIRED

[Give an indication of what assistance will be sought from the International Bureau or other Contracting States, for example to train examiners or to develop IT systems to deal with new Forms, communications and workflows.]

8 – OTHER

[Add any additional comments which are considered relevant to the application.]

9 – ASSESSMENT BY OTHER AUTHORITIES

[The application should ideally include assessments by the Authorities referred to in section 1, which could either be included as part of the form or else submitted separately.]

[End of Annex and of document]