

## **Patent Cooperation Treaty (PCT) Working Group**

**Thirteenth Session**  
**Geneva, May 26 to 29, 2020**

### **MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT ON THE TWENTY-SEVENTH SESSION**

*Document prepared by the International Bureau*

1. The Annex to this document sets out the Summary by the Chair of the twenty-seventh session of the Meeting of International Authorities under the Patent Cooperation Treaty (PCT/MIA), held in Gatineau, Canada on February 6 and 7, 2020. Annex II to this Summary by the Chair contains the Summary by the Chair of the tenth informal meeting of the PCT/MIA Quality Subgroup, which was held immediately prior to the Meeting of International Authorities in Gatineau on February 3 to 5, 2020.

2. *The Working Group is invited to note the Summary by the Chair of the twenty-seventh session of the Meeting of International Authorities under the PCT (document PCT/MIA/27/16), reproduced in the Annex to this document.*

[Annex follows]



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

TWENTY-SEVENTH SESSION, GATINEAU, FEBRUARY 6 AND 7, 2020

### SUMMARY BY THE CHAIR

*(noted by the Meeting; reproduced from document PCT/MIA/27/16)*

### INTRODUCTION

1. The Meeting of International Authorities under the PCT ("the Meeting") held its twenty-seventh session in Gatineau, Canada, on February 6 and 7, 2020.
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, the Finnish Patent and Registration Office, the Indian Patent Office, the Intellectual Property Office of the Philippines, 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 Swedish Patent and Registration Office, the Turkish Patent and Trademark Office, the Ukrainian Intellectual Property Institute, 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.

### OPENING OF THE SESSION

4. Mr. John Sandage, Deputy Director General of WIPO welcomed the participants on behalf of the Director General of WIPO and thanked the Canadian Intellectual Property Office for hosting the Meeting.

### ELECTION OF A CHAIR

5. The session was chaired by Mr. Alan Troicuk, Senior Advisor, Patent Policy and International Affairs, Canadian Intellectual Property Office.

### ADOPTION OF THE AGENDA

6. The Meeting adopted the agenda as set out in document PCT/MIA/27/1 Prov. 2.

### PCT STATISTICS

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

### MATTERS ARISING FROM THE QUALITY SUBGROUP

8. The Meeting noted with approval the Summary by the Chair of the Quality Subgroup set out in Annex II to this document, agreed with the recommendations contained in that Summary and approved the continuation of the Subgroup's mandate, including the convening of a physical meeting in 2021.

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<sup>1</sup> A copy of the presentation is available on the WIPO website at [https://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=468681](https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=468681).

## **PCT ONLINE SERVICES**

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

10. The International Bureau reported that PCT online services were generally working well for the existing procedures. Developments were under way in a wide variety of areas, but Authorities should note that delivery of new services will be slower than has been the case in recent years while significant work is done in the background to move core services to a cloud-based resilient and secure platform, as well as to continue integration of PCT services with the WIPO IP Platform. The International Bureau confirmed that this work would be largely invisible to Office users of PCT services. The end result would ensure and improve the already excellent availability of PCT online services and open the way to the development of future new functionality. However, the main obvious effects in the short term would be a smoother and more consistent experience for applicant and third party users of WIPO services from different areas, such as the Hague and Madrid Systems, PATENTSCOPE and the WIPO Academy. Significant improvements to services more generally required effective coordination of activity and development between the International Bureau and national Offices.

11. Authorities used a variety of PCT online services, including ePCT, eSearchCopy, DAS, PCT-EDI, WIPO CASE, PATENTSCOPE web services and the WIPO Fee Transfer Service. These formed a key part of their processes and were generally considered very effective. Some Authorities expressed their interest in the development of the ePCT reporting services. Some interest was expressed in continuation of development of ePCT services to assist national phase entry. One Authority queried how far proposals should go for data exchange between national applications, filing of international applications and national phase entries, noting the benefits in effective reuse of data, but also the changes in data between stages in view of choices by the applicant and differences in national laws and systems.

12. The eSearchCopy service was working well. The European Patent Office noted that its gradual transition approach had allowed a smooth transition by assessing document delivery with manageable numbers of cases and a backup alternative in case problems were found. It hoped to move fully to this service, preferably by the end of the year, or at least in 2021.

13. Authorities reaffirmed that moving to XML international search reports and written opinions was an important goal and several additional Authorities indicated their intention to begin delivery of XML reports in 2020 or 2021. In response to a query concerning the reference in paragraph 27 of the document to errors and implementation differences, the International Bureau explained that the standard for these reports offered many options, for example with regard to the presentation of relevant passages, categories and relevant claims for cited documents. Authorities had approached this issue differently, providing different structures to the information for similar situations. Moreover, there were many options within the reports, making testing of all possibilities difficult, with minor issues being discovered after months of live use. However, some classes of difficulty also arose from the fact that examiners were often preparing reports in systems that had been designed to export reports using different technologies and sometimes search reports contained display features that the XML was not able to accept. One Authority indicated that it had been assisting the International Bureau with the development of the tools for report creation within ePCT, from which a first round of improvements, including arrangements for import of citation lists from search tools, should be released shortly. That Authority hoped to use ePCT as its primary report generation tool. Consequently, ease of use and reliability would be key.

14. Several Authorities confirmed the importance of moving towards full text processing for application bodies and that accepting DOCX filings appeared to be the most promising way forward on this. The International Bureau indicated that it was not aware of any detailed comparison that had been made between the output of the various different converters under development. One Authority noted that it would soon be launching a pilot of DOCX filing for regional applications and noted the need for greater coordination in this area.

15. Authorities agreed that a move towards passing machine-readable data would be desirable in other areas also. However, priorities needed to be considered. In addition, there may be issues of compatibility for Offices developing new services in line with WIPO Standard ST.96.
16. In response to a comment, the International Bureau confirmed that the indicated number of applications that had been tagged as possibly containing color or greyscale drawings did not provide a realistic estimate of the number of applications that actually did so.
17. Some Authorities indicated their interest in machine-to-machine services, which opened up possibilities for new and more effective processes to be developed. One Authority noted that it hoped shortly to end its use of the Rule 87 DVDs based on instead retrieving the information using web services.
18. Authorities welcomed the possibility that official transmission of documents to applicants might soon be achieved, where agreed by the applicant, by sending a notification and allowing the applicant to download copies of documents from ePCT. This could considerably improve service to applicants while simultaneously reducing costs for Authorities. One Authority noted that it intended to offer a similar service through its own online systems.
19. The WIPO Fee Transfer Service was working well for those Authorities involved. The need for development of consistent, machine-readable information on fee payments was recognized in order to allow the service to work efficiently and effectively in the longer term. Several Authorities expressed their hope that centralized payment systems would be offered soon; others emphasized that this must be an optional arrangement in view of procedural issues that might apply with some currencies or national laws and procedures.
20. One Authority agreed that improvements were desirable in the format, content and transfer of electronic priority documents and suggested improved documentation to help understand the various needs, as well as the mechanisms involved in interactions with the DAS system. One Authority noted that it expected shortly to become a depositing Office in the DAS system.
21. With regard to their additional role as receiving Office, some Authorities indicated that they hoped soon to be able to discontinue the use of PCT-SAFE. One Office noted that it should soon have ePCT-Filing embedded within its local services, allowing a full PCT filing service through its own user accounts.
22. Several Authorities reiterated their support for the increasing use of WIPO CASE by designated Offices. One Authority emphasized the importance of the recent addition of the Cooperative Patent Classification into the PATENTSCOPE search service.
23. Authorities broadly agreed with the proposed direction of developments of PCT online services, which made the system more user-friendly, but noted the need for earlier and more detailed information to plan developments effectively. In addition, developments needed to fit with a variety of different national legal and IT systems, as well as to compete with other priorities for developer time.
24. The Meeting noted the developments in PCT online services and agreed with the priorities set out in the document, taking into account the above comments.

## **PROMOTING LINKAGE BETWEEN THE INTERNATIONAL PHASE AND THE NATIONAL PHASE**

25. Discussions were based on document PCT/MIA/27/10.
26. Authorities supported the aims of the document to improve the linkage between the international and national phase of the PCT. Authorities also agreed on the aim that

international search should be of high quality to be used by Offices in the national phase and ensure high predictability for applicants. However, several Authorities considered that the proposed amendment to paragraph 15.09 was not clear, particularly the comparative term “higher”. These Authorities could not accept the proposed amendment at this stage, although some other Authorities were willing to accept the additional text in the form proposed by the Japan Patent Office. The International Bureau also pointed out that quality of search related both to the search itself and to its scope, which should take into account the PCT definition of relevant prior art, that aimed to ensure that international search was useful for national laws of all Contracting States. The Japan Patent Office therefore agreed to discuss the proposed amendment to paragraph 15.09 on the Quality Subgroup electronic forum to achieve wording that would reach consensus before formal consultation through a PCT Circular.

27. In relation to the proposals in the Annex to the document, Authorities agreed to review the list by Authorities indicating the proposals that they considered should be prioritized and those where they had concerns through the Quality Subgroup electronic forum. This would enable the Japan Patent Office to develop more concrete proposals on particular measures for future sessions of the Meeting.

28. The Meeting invited the Japan Patent Office:

(a) to lead discussions on the Quality Subgroup electronic forum towards reaching consensus on the proposal to amend paragraph 15.09 of the ISPE Guidelines, and

(b) to develop more detailed proposals or invite comments from Authorities through the forum on the remaining issues in the Annex to the document that had not been taken forward to date

#### **INTERNATIONAL SEARCH REPORT FEEDBACK PILOT**

29. Discussions were based on document PCT/MIA/27/3.

30. Authorities that had participated in the pilot appreciated the feedback on their international searches from the United Kingdom Intellectual Property Office as a designated Office and encouraged other International Authorities to participate in the pilot. Some Authorities that did not participate in the pilot indicated an interest in joining the pilot.

31. One Authority questioned whether the small sample size would be sufficient to draw conclusions from the feedback. However, this Authority believed that case-specific feedback from the pilot would be helpful, and was interested in what follow up had been undertaken with regard to the reasons why any additional prior art had been found during the national phase. Another Authority that had performed its own small-scale feedback analysis on search reports reported that it had been difficult to draw broad conclusions, but particular feedback on non-patent literature citations and the search strategy has been useful.

32. One Authority drew a parallel with the proposal “Develop a feedback system from designated Offices to the ISA-IPEA” (d-4) in the Annex to document PCT/MIA/27/10 and suggested that the feedback from the pilot could be considered alongside this proposal to explore a joint feedback mechanism.

33. The Meeting noted the contents of document PCT/MIA/27/3.

#### **PROPOSAL TO PROMOTE THE IMPROVEMENT OF THE INTERNATIONAL SEARCH REPORT AND WRITTEN OPINION**

34. Discussions were based on document PCT/MIA/27/15.

35. Authorities welcomed the principle of a survey with a view to improving the form, content and format of the international search report and the written opinion. However, Authorities raised comments on both the content and the methodology that required further consideration.

36. In terms of content, one Authority considered that Box B3 of the survey to International Searching Authority examiners was beyond the scope of the aim to improve the form. As the surveys would be completed at an individual level, another Authority proposed that the survey to users should provide explanation to clarify the purpose of the survey, as well as the fact that any changes that were suggested from the responses could only be implemented after consultation with Offices affected by the changes, and might require wider discussion by all PCT Contracting States. Furthermore, the implementation of any change to the format of the international search report and written opinion would require time to modify IT systems.

37. As for methodology, one Authority considered that the methodology for surveying IP Offices was unclear, but identified potential similarities with the survey on search strategies under discussion, which also sought feedback at an individual level. In relation to feedback from users, this Authority suggested a dual approach, where the questionnaire could be addressed to user groups, but Offices could also reach out to their own user community. Another Authority stressed that the questionnaire should not be a burden for examiners or users to complete. One Authority enquired about the user groups that would be consulted through a PCT Circular.

38. One Authority suggested merging the international search report and written opinion into a single form since this could make the forms easier to understand and more straightforward to produce given that some information was duplicated between the two. While the present situation might not be ideal, the International Bureau pointed out that the translation and publication of the international search report and written opinion were different, though a suitably-designed XML form might make it practical to generate and process the different parts automatically, as required.

39. The Meeting agreed to discuss the content and methodology of the survey on the Quality Subgroup electronic forum with a view to reaching agreement to conduct the survey.

#### **PROPOSAL TO TRANSMIT THE ANNEXES TO THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT AS SEPARATE DOCUMENTS**

40. Discussions were based on document PCT/MIA/27/4.

41. International Authorities agreed that, in general, it would be easier for both International Preliminary Examining Authorities and elected Offices if the international preliminary examination report and its annexes and other documents were transmitted as separate files, provided that:

(a) this did not introduce any change or uncertainty as to which documents applicants could be asked to translate on national phase entry; and

(b) the files were presented to elected Offices (whether on screen within PATENTSCOPE or through PATENTSCOPE or ePCT web services) in such a manner that it was clear that they formed a package.

42. Related to the latter point, it was also important that the written opinions and letters that are made available to the public under the amended Rules 71 and 94, coming into force in July 2020, are presented in chronological order so that the file can be understood. The International Bureau observed that this would require correct coding of the documents by the International Preliminary Examining Authority when they are transmitted and that it should be ensured that the appropriate standard for this is clearly documented.

43. Some Authorities had automated the process of combining the international preliminary examining report and its annexes. Providing them as separate documents in future would involve development work. The International Bureau indicated that, in view of the fact that no changes to the PCT Rules or Administrative Instructions were envisaged, the arrangement would be a recommendation rather than a requirement. Changes need not be made immediately, noting that some Authorities required substantial time to update IT systems and implement the changes, but should be taken into account when related development work was being done anyway. For many Authorities, this would soon be needed in the context of the development of XML international preliminary examination reports. For those, best practice could be considered, but the standard permitted either separate documents or else a package of documents with high quality indexing that could permit accurate, automatic splitting into components if required.

44. One Authority suggested the development of a form to assist applicants to present arguments under Rule 66.3(a) and letters under Rule 66.8(a) or (b) identifying the differences between replacement sheets and the sheets that they replace, as well as the basis for the amendment in the application as filed.

45. The Meeting recommended that the International Bureau prepare proposals for implementation of the transmission of the international preliminary examination report and its associated annexes and other related documents as separate documents.

#### **APPOINTMENT AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY (ISA/IPEA) AND DECLARATION BY RECEIVING OFFICES AS COMPETENT ISA/IPEA**

46. Discussions were based on document PCT/MIA/27/6.

47. The Indian Patent Office introduced the proposal, which sought to offer more free choice to applicants. The version of the proposal presented to the twelfth session of the PCT Working Group had been supported by several user groups and the Indian Patent Office considered free choice to be more fair than a choice imposed by a receiving Office. The PCT was a multilateral system for protection and it stated that efforts were to be taken to improve this multilateral cooperation to the fullest extent possible and implementation of the proposal would be a good step in that direction. It also stated that the choices made when international applications had applicants from several States demonstrated that applicants welcomed a free choice. Various concerns expressed by Offices and Contracting States, including the predictability of workload in each language and the effect of the Protocol on the Centralisation of the European Patent System, had been taken into account in modifying the proposal. The Indian Patent Office referred to the discussions during the recent Quality Subgroup meeting where “predictability” was getting identified with patent quality. It was of the opinion that the progress of the IP5 Collaborative Search and Examination Pilot indicated that the applicants were interested in availing the services of multiple Offices as this could ensure better predictability. The Office stated that it believed that the applicants were the best judges to ascertain the quality of the services they receive as the ultimate customers of the services, and that in the future, the applicants might wish to avail themselves of any service that would be available or a combination of services to ensure the predictability of the reports. At the time of the publication of the three millionth PCT application, the Director General had issued a memorandum commenting that the primary route to address the issues facing the PCT was to put renewed emphasis on the “Cooperation” element of the Treaty, mostly requiring changes to the behavior and actions of Offices rather than significant changes to the legal framework. The Indian Patent Office was of the opinion that the proposal laid emphasis on behavior and actions of offices to take ahead the cooperation as suggested by the Memorandum by the Director General. The Indian Patent Office also referred to paragraph 78 of the Memorandum that discussed International Searching Authority choice, which concluded that consideration was needed whether competition between Authorities might serve a role to maintain quality and consistency and stated that the proposal was in line with that suggestion. With the collective will of the



International Authorities, measures could be found, such as temporarily limiting numbers of applications being sent to particular Authorities. Technology could be used to meet the challenges.

48. Authorities thanked the Indian Patent Office for the proposals, including the suggestions concerning safeguards. However, Authorities continued to express concerns about offering a totally free choice to applicants. This could have effects on national legislation, Office work forces and IT systems. One Authority was concerned that it would result in competition on pricing and that quality would be neglected. Another Authority pointed to difficulties with management of fees, as well as the effects on the financial interests of Authorities in relation to performing searches for their own nationals. One Authority that already acted for a significant number of receiving Offices and, as a receiving Office, offered a large choice of alternative International Searching Authorities, noted that wide choice brought benefits, but also burdens. Limitations on numbers of searches were difficult to manage and there needed to be a high degree of certainty for the applicant that a particular Authority remained available. Nevertheless, to the extent that the proposal remained optional, this Authority had no objections to it. Another Authority that acted for an even larger number of receiving Office and had never yet refused a request to become a competent Authority wished to retain the right to manage the relationships.

49. The Indian Patent Office expressed understanding of the concerns such as predictability of workload and effect on IT systems. A gradual transition could be envisaged towards a different distribution of work across International Authorities.

50. The Chair concluded that no Authority had expressed opposition, noting the optional nature of the proposal, but that a wide range of Authorities had concerns that implied that it was unlikely that they would offer a free choice, either in their role as receiving Office or as an International Searching and Preliminary Examining Authority.

## **PROPOSAL ON THE HANDLING OF DRAWING INFORMALITIES IN INTERNATIONAL APPLICATIONS UNDER THE PCT**

51. Discussions were based on document PCT/MIA/27/14.

52. Authorities acknowledged the inefficiencies of handling drawings as a receiving Office that did not comply with Rule 11, which had been drafted when applications were received and processed on paper. Like the United States Patent and Trademark Office, other Authorities issued Form PCT/RO/106 on significant proportions of applications due to defects in the drawings. In addition, the requirement that the receiving Office should only check for compliance to the extent that compliance is necessary for the purpose of reasonably uniform international publication stated in Rule 26.3(a)(i) was unclear. Where receiving Offices applied these requirements strictly in view of highlighting potential issues in the national phase, applicants often filed further drawings that still did not meet the requirements since the wording in Form PCT/RO/106 was unclear and could imply the applicant needed to file such drawings or the international application would be withdrawn, which rarely happened in practice. One Authority suggested that additional outreach activity with the user community could explain the situation with drawing informalities and how to avoid certain pitfalls.

53. While there were problems with the interpretation of “reasonably uniform publication” and the explanation in Form PCT/RO/106 on how to correct defects could be improved, some Authorities did not believe that the proposals in the document would necessarily rectify the problems encountered in many international applications with defects in the drawings. Some Authorities also stated that defining the attributes for reasonably uniform publication in paragraph 14 of the document would create a separate standard from Rule 11. The United States Patent and Trademark Office therefore proposed to work with the International Bureau to explore ways to achieve more efficient handling of drawings that do not comply with Rule 11. In this regard, the International Bureau commented that it was important to be clear on the goal of

any proposal. A quick response to the immediate problem was needed, but further lines of work may be appropriate to deal more completely with the underlying issues. In that respect, one Authority suggested that the International Bureau should clarify its needs to achieve a “reasonably uniform publication” as this would help updating the requirements under Rule 11 that needed to be checked by receiving Offices.

54. The Meeting invited the United States Patent and Trademark Office to work with the International Bureau to develop proposals to address the problems with handling informal drawings in international applications and related issues.

#### **PILOT ON THE TRANSFER AND NETTING OF PCT FEES**

55. Discussions were based on document PCT/MIA/27/7.

56. Authorities that were involved with the pilot on the transfer of fees expressed their satisfaction with its progress, noting that it had reduced costs and workload. These Authorities encouraged greater participation, noting that the benefits increased greatly with an increasing number of participating Offices. Authorities awaited the Circular containing proposals for Administrative Instructions formalizing the pilot. It was important that the Administrative Instructions offered sufficient flexibility and took into account special requirements of national laws and procedures. The International Bureau stated that the proposal would aim to address legal barriers that were faced by some Offices and to allow participation with a minimum of change to existing procedures. Nevertheless, it was important also to set out a clear way forward towards exchanging fee information using an effective and consistent machine-readable format. This would allow the International Bureau to reduce its manual workload in checking fee transfers, as well as providing better information to applicants and ensuring that any apparent inconsistencies in amounts reported could be highlighted to Offices immediately, avoiding incorrect transfers being made and needing to be corrected the following month.

57. The European Patent Office was now receiving fee transfers from 37 receiving Offices this way, representing 95 per cent of the volume of searches that it performed for other Offices. It hoped to expand the process to include transfers from all of the receiving Offices for which it was competent, preferably in 2020 or at least by the end of 2021. Other Authorities expressed their intention to expand their participation, either in terms of roles or of partner Offices to or from which transfers were made. Other Authorities expressed their intent to join the service soon. One Authority recognized the benefits of the system in principle, but indicated that it would not be in a position in the near future to make the changes to IT systems necessary to join.

58. The Meeting noted the contents of document PCT/MIA/27/7.

#### **REVIEW OF SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM**

59. Discussions were based on document PCT/MIA/27/5.

60. Some Authorities expressed support for PCT Contracting States to recommend continuation of supplementary international search for a further period. One of these Authorities provided supplementary international search and pointed out that the IT development costs to provide supplementary international search to applicants was significant and it could be expensive to make the changes to cease supplementary international search. Furthermore, this Authority pointed out the number of requests each year for supplementary international search had doubled since the time period for requesting supplementary international search had been increased to 22 months from the priority date in 2017. Another of these Authorities, while not offering supplementary international search, stated that the abolition of supplementary international search could be considered after the evaluation of the collaborative search and examination pilot. This Authority also noted that most supplementary international search requests originated from applications that were filed at the receiving Office of the China National Intellectual Property Administration (CNIPA) and added that CNIPA could nominate other

International Searching Authorities to be competent for international applications filed at its receiving Office.

61. Some other Authorities believed that PCT Contracting States should give serious consideration to the option of abolishing supplementary international search, noting among other reasons, the concerns raised by the International Bureau on disproportionate IT development-related costs to maintain the system. One of these Authorities referred to the reasons why users had originally requested the possibility of a requesting a second search during the international phase, such as the desire for a search to cover documents of particular languages understood by examiners at a particular International Searching Authority. However, given the very low uptake supplementary international search, it could indicate that applicants were generally satisfied with the quality of international searches and this had improved since supplementary international search had been introduced, noting that search engines and machine translation facilities for reading documents in other languages had improved in recent years. One of these Authorities reported that it had received two supplementary international search requests in 2019 after a gap of seven years, which had required extensive resources to process in view of the long time interval since the previous supplementary international search.

62. A further group of Authorities did not have a clear preference on whether to continue supplementary international search. One of these Authorities had received a substantial number of supplementary international search requests from a single applicant that no longer used the service. This Authority nevertheless believed that supplementary international search could be beneficial to an applicant where the application contained subject matter listed in Rule 39 that was searched by some International Searching Authorities, but not by any Authorities that had been nominated to be competent by the receiving Office to carry out the main international search.

63. The Meeting invited the International Bureau to reflect the comments from International Authorities on supplementary international search in paragraphs 59 to 62, above, in the document on supplementary international search for the Working Group to consider in preparation of the review of supplementary international search by the Assembly in 2020.

#### **PCT COLLABORATIVE SEARCH AND EXAMINATION PILOT: STATUS REPORT**

64. Discussions were based on document PCT/MIA/27/13.

65. The European Patent Office (EPO), in introducing the document, informed the Meeting that 35 applications that had been part of the pilot had already entered the regional phase at the EPO. In addition to the outcome during the national phase of applications in the pilot, the evaluation phase beginning on July 1, 2020 would include a survey of the applicants that had participated in the pilot. Some participating Offices in the pilot supported the need to extend the evaluation phase by at least one further year until June 1, 2022.

66. In response to a query from one International Authority, the EPO explained that, for applications in the pilot that were not filed in English, the applicant would be required to file a translation into English, the International Searching Authority would provide a provisional international search report and written opinion in the language of application and in English, with the latter being shared for peer review by examiners at the other Authorities. The examiner at the International Searching Authority would establish the final international search report and written opinion in the language of filing, and the peer contributions in English would be made available on PATENTSCOPE.

67. The EPO clarified that the evaluation phase of the pilot would need to consider the fee to be charged by Authorities if a collaborative search and examination model were set up on a more permanent basis. While the fee would be higher than a single international search, the applicant might benefit from further reductions in any search fees charged by designated

Offices in the national phase. The EPO also provided details of metrics that would be used to evaluate applications that were included in the pilot such as those related to the citations found by the main and peer examiners at the International Searching Authorities and during the national phase, the time to provide peer contributions and process them by the main examiner etc.

68. The Meeting noted the contents of document PCT/MIA/27/13.

## **PCT MINIMUM DOCUMENTATION TASK FORCE**

### **(A) STATUS REPORT**

69. Discussions were based on document PCT/MIA/27/11.

70. The European Patent Office reviewed the progress of the PCT Minimum Documentation Task Force on its Objectives A to C. Work on Objective A (an inventory of the existing PCT minimum documentation) had been completed and was awaiting publication by the International Bureau. Significant progress had been made on objectives B (criteria and standards for inclusion of a national patent collection in the PCT minimum documentation) and C (bibliographic and text components of patent data that should be present in patent collections part of the PCT minimum documentation). The main outstanding issues related to the inclusion of utility models in the minimum documentation and the extent to which detailed data requirements should apply to existing documents as well as to newly published documents in national collections. A deadline for comments on the latest proposals and for summarizing the status of national collections had been extended to February 29, 2020. The European Patent Office intended to summarize the responses and to prepare documents for a further physical meeting of the Task Force, which could take place in Munich on April 28 and 29, 2020, subject to confirmation. The Task Force would seek to develop proposals for presentation to the Meeting and to the PCT Working Group, with a view to recommending that the PCT Assembly approve amendments to the PCT Regulations in 2022, to enter into force before work commences on the next round of reappointment of International Authorities in 2026.

71. Authorities thanked the European Patent Office and the Task Force for the work done and broadly agreed with the indicated aims. The work was important for enhancing the quality of the international search. The physical meeting of the Task Force had been beneficial and allowed significantly greater progress than had been achieved using only the electronic forum.

72. Several Authorities emphasized that they continued to hold the concerns reported in the Task Force. Several Authorities were concerned that the proposals might result in difficulties with the size and usability of the collections in the minimum documentation; further consideration would be required on issues such as language, format and inclusion of patent family members. Too difficult a set of technical requirements might affect the ability of International Authorities to retain their status if they were unable to publish documents meeting those requirements. The extent to which technical requirements applied to old documents would need to be carefully considered; for example, the patent publications of the United States of America prior to 1976 were held as image files and conversion to high quality full text would be a burden that might not be commensurate with the value added.

73. Consideration needed to be given to the extent to which the new parts of the minimum documentation could be added into Offices' own existing search systems and to what extent it might involve relying to a greater extent on commercial search system providers. It was essential that the data be available freely and not be limited to commercial providers.

74. Some Authorities considered that utility models were an important source of technical information, which should be included in the minimum documentation on the same basis as patent publications. There was particular importance to these collections in accessing information on the innovation from certain parts of the world. Others considered that they were

less useful and should be subject to different requirements, or to be included as recommended material, but not required.

75. The Meeting noted the report on progress of the Task Force and recommended that the work continue as proposed, including the convening of a physical meeting of the Task Force as suggested in paragraph 70, above.

#### (B) STATUS REPORT ON OBJECTIVE D

76. Discussions were based on document PCT/MIA/27/12.

77. The United States Patent and Trademark Office reviewed the progress of the PCT Minimum Documentation Task Force on its Objective D (criteria and standards for review, addition and maintenance of non-patent literature and traditional knowledge-based prior art). Only a limited number of responses had been received to the latest questionnaire, but some common views appeared to be emerging in relation to subscription practices, subject matter, quality and reliability, and maintaining the list. The United States Patent and Trademark Office would seek to analyze the responses more thoroughly and to provide new proposals for review at the physical meeting of the Task Force referred to in paragraphs 70 and 75, above. The aim would then be to prepare a revised draft in summer 2020 for comments in the second half of the year, with a view to presenting concrete proposals to the Meeting in 2021. If the new criteria were approved by the Meeting, the Task Force would then move on to evaluate sources of non-patent literature according to the new criteria.

78. Authorities recognized the importance of the non-patent literature and of ensuring that the minimum documentation reflected the sources of non-patent literature likely to be of the highest relevance. One Authority indicated that it hoped to be able to provide an analysis of the number of citations from different sources of non-patent literature made in its search reports over the last ten years and to be able to provide a report on that subject by mid-March to help inform the discussions. Another Authority indicated that it was not able to identify what had been cited, but might be able to provide information on documents requested for consideration by examiners from sources that were not open access. A further Authority stated that providing a report on usage would require substantial time and cost. Therefore careful consideration should be given to ensure that this did not impose significant burden.

79. One Authority was of the view that the selection of titles for inclusion in the PCT minimum documentation should be based on usage statistics in each field of technology and stated that the Authority was willing to share such data in respect of the reports established by them. That Authority expressed concerns that fixing criteria for inclusion of non-patent literature that were not under the control of the International Authorities or the International Bureau would not be an effective solution. The Authority noted that agreements it had with publishers of non-patent literature included clauses that allowed the publisher to terminate access at any time during the subscription period with prior notice. Since the publishers were under no obligation to provide the same services at the same prices to the Authorities, the Authority suggested to have Standard Access Agreements for the titles included in the non-patent literature list. It also suggested that the price of each title should be predictable in relation to the size of an Office.

80. The Indian Patent Office stated that in respect of the Indian Traditional Knowledge Digital Library (TKDL), as concluded in the first physical meeting of the PCT Minimum Documentation Task Force held in May 2019, the list of titles included in the TKDL was made available on the website of the TKDL and the link to the page had been shared by the Indian Patent Office in the Task Force wiki. The Office was of the view that the purposes of creation of such databases were different from those of other scientific journals by commercial publishers and hence the questions for consideration for their inclusion in the PCT minimum documentation should be accordingly different. The Indian Patent Office stated that it intended to discuss the topic further in the Task Force wiki in the coming months.

81. The Meeting noted the report on progress of the Task Force and recommended that the work continue as proposed, including discussion at the physical meeting of the Task Force referred to in paragraph 75, above.

## **PCT SEQUENCE LISTING STANDARD**

### **TASK FORCE STATUS REPORT**

82. Discussions were based on document PCT/MIA/27/9.

83. The European Patent Office introduced the status report, noting that there had been much progress but that significant challenges still remained. National Offices had been requested in Circular C. CWS 128 to provide information concerning their IT implementation roadmaps. It would be necessary to determine whether further developments would affect those roadmaps and, if so, whether it remained possible to meet the target date for implementation of WIPO Standard ST.26, for applications and international applications filed on or after January 1, 2022.

84. The Meeting noted the contents of document PCT/MIA/27/9.

### **IMPLEMENTATION OF WIPO STANDARD ST.26**

85. Discussions were based on document PCT/MIA/27/8.

86. The International Bureau indicated that it would provide draft Rules and Administrative Instructions for discussion at the PCT Working Group. To meet the proposed deadline for implementation of WIPO Standard ST.26 for international applications filed on or after January 1, 2022, it would be necessary for the PCT Assembly to approve amendments to the PCT Regulations at its session in September 2020. The key aspects of modifications to the PCT Administrative Instructions would also need to be agreed before that time, though detailed drafting would continue to be possible. The main issue for agreement concerned the language of free text. It was understood that, to reach agreement, it would be necessary to have a proposal that allowed applicants using languages other than English to be treated effectively equally with English language applicants. The International Bureau presented a proposal for a "language file" that would allow free text to be submitted in languages that were not written using characters limited to the Basic Latin character set specified in WIPO Standard ST.26. Various other details needed to be worked out concerning special cases, but it was hoped that these would not require any particular new provisions in the Rules or Administrative Instructions.

87. Authorities noted the importance of the new sequence listing format and many were well advanced with their legal and technical preparations. One Authority noted that it should overcome problems that it currently faced with sequence listings filed on paper in accordance with WIPO Standard ST.25.

88. Authorities indicated that they could, in principle, accept language files if they overcame the legal and policy concerns of all Contracting States. However, a variety of legal and technical details would need to be confirmed. Moreover, it would result in considerable changes to the expected standards for files to be submitted and processed as part of an international application. The changes to IT system specifications meant that it might be difficult for some Authorities to meet the current target date, though others indicated that they expected to have no difficulty, provided that WIPO Sequence and the related software being developed by the International Bureau supported the revised requirements effectively.

89. In response to comments by Authorities, the International Bureau confirmed that its detailed proposals would make clear that translations of free text would always be provided by the applicant and not by national Offices or the International Bureau. Given that there would, in some cases, be two language versions of the free text on file, it would be possible for inconsistencies to exist due to imperfect translations, but these were not greatly different from some existing potential for inconsistencies and it was believed that these could be resolved on a

case-by-case basis and should not be the subject of specific rules. It would also be made clear that a language file would be a part of the description like any other. Consequently, it would only be part of the application as filed if it was present on the international filing date. It would not be permitted to submit language files at a later stage except as part of a translation, rectification or amendment, where it would be subject to rules exactly equivalent to those for the main body of the application.

90. In response to a suggestion that an alternative arrangement would be to relax the requirements concerning the characters permitted in free text, the International Bureau confirmed that this could work, but would require a more fundamental change to WIPO Standard ST.26 and might also affect the timetables for legal and IT developments. The decision on which way to go was a matter for the Member States, primarily in the context of the Committee on WIPO Standards (CWS), but a decision would be needed quickly if States wished to attempt to keep to the current timetable. The International Bureau proposed that the issue be discussed further in the CWS Sequence Listing Task Force, but ensuring that the Task Force was reinforced with the necessary experts to ensure that any proposal would meet Member States' requirements and that high level support could be relied upon to ensure consistent agreement in all related bodies, including the CWS as well as the PCT Working Group and Assembly.

91. Authorities noted varying positions on the extent to whether the new standard would be required to apply to all applications filed on or after January 1, 2022, or if some exceptions might occur, such as in the case of divisional applications. Authorities generally considered it desirable to treat other special cases, such as sequence listings with paper applications or listings too large to upload in the context of existing general provisions, rather than making special provisions specific to sequence listings.

92. Several Authorities had begun testing WIPO Sequence and found it so far satisfactory. One Authority indicated that it had translated WIPO Standard ST.26 into its national language. Several were organizing meetings with interested users to explain the new arrangements.

93. The Meeting recommended that the International Bureau consult the CWS Sequence Listing Task Force concerning the technical options to be used for language-dependent free text and that Authorities ensure that delegations in that body be reinforced with experts sufficient to assess all the legal and technical issues involved and that high level support should be sought for consistent approaches in all relevant bodies. The International Bureau should take the results of such discussions into account in presenting a proposal to the next session of the PCT Working Group.

## **FUTURE WORK**

94. The Meeting welcomed offers from the China National Intellectual Property Administration (CNIPA) and the Federal Service of Intellectual Property (Rospatent) to host a future session of the Meeting. It was expected that CNIPA would host the session to take place in 2021, with Rospatent hosting in 2022. The next session was expected to take place in first quarter of 2021, immediately following a meeting of the Quality Subgroup.

[Annex I to document PCT/MIA/27/16, containing a list of participants is not reproduced here]

[Annex II (to document  
PCT/MIA/27/16) follows]

ANNEX II (to document PCT/MIA/27/16)

PCT/MIA QUALITY SUBGROUP, TENTH INFORMAL MEETING  
GATINEAU, FEBRUARY 3 TO 5, 2020

SUMMARY BY THE CHAIR

**INTRODUCTION**

1. Mr. Paul Thompson, Associate Deputy Minister, Innovation, Science and Economic Development Canada, and Ms. Johanne Bélisle, Chief Executive Officer, Canadian Intellectual Property Office welcomed the participants and gave an overview of Canada's IP Strategy launched on World IP Day in 2018 and the importance of the PCT and other WIPO Treaties in the Canadian Intellectual Property Office Five-Year Business Strategy 2017-2022.

2. Mr. Scott Vasudev, Director, Patent Policy and International Affairs Division, Canadian Intellectual Property Office chaired the session.

**1. QUALITY MANAGEMENT SYSTEMS**

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

**(B) PRESENTATIONS ON QUALITY MANAGEMENT SYSTEMS AND RISK-BASED PRACTICES AT INTERNATIONAL AUTHORITIES**

3. Authorities agreed that the system of reporting on the quality management systems (QMS) was useful, and appreciated the summary provided by the International Bureau. One Authority expressed interest in knowing more about the service the Intellectual Property Office of the Philippines (IPOPHL) provided for transmitting correspondence to clients through the Internet in a reliable, secure and fast manner. In addition to the reports of the quality management systems of other Authorities, the Subgroup found the presentations<sup>2</sup> by the Finnish Patent and Registration Office (PRH), the Spanish Patent and Trademark Office (SPTO), the Brazilian National Institute of Intellectual Property (INPI-Br) on their QMS and risk-based practices and by the Canadian Intellectual Property Office (CIPO) on the Patent Quality Summit held in February 2019 to be useful to gain a better understanding of practices in quality management systems.

4. Following a query concerning the PRH's use of A1/A2 publication ratio metrics in addition to compliance with the time limit under Rule 42, the International Bureau observed that it had started providing information on A1/A2 publication at the request of another Authority. It provided an interesting measure of the service provided to the general public, who wished to be able to assess likely patentability when they first read the international publication. Metrics could be based on anything useful and targets set by the Rules could be changed if more appropriate ones could be agreed.

5. In response to a question on the format of first office actions depending on the type of applicant such as the size of company applying for a patent, the PRH explained that it used different wording for individual unrepresented applicants. The PRH reported on a recent workshop on improving the readability of the first office action and appreciated the participation of professional representatives who had devoted their time to this exercise. The PRH also confirmed that the number of appeal court decisions was sufficiently small that it was able to

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<sup>2</sup> [https://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=468722](https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=468722),  
[https://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=468867](https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=468867),  
[https://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=468721](https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=468721),  
[https://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=468671](https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=468671).



report on all of them to its management group, not only ones where the Office's decision was overturned. Its Quality Assessment Group comprised senior examiners drawn from the examining divisions, rather than ones specifically devoted to quality assessment.

6. The presentations from the PRH, SPTO and INPI-Br discussed the experiences of engaging staff in risk-management. This was often difficult initially, but it was important for staff to identify the risks in their own work to feed this into the Office-wide risk policy. By bringing risk to an operative level and evaluating risk levels in a way that could be understood by staff, staff would be able to identify opportunities to improve processes, noting the correlation between risk and opportunity. Interactive training activities such as workshops and communication of risk policy to staff had also helped people see the value of risk-management practices across an organization.

7. INPI-Br clarified that its internal audits typically took place around once per year. External audit frequency was decided by the auditor, but averaged around once every three years.

8. In response to the presentation on the Patent Quality Summit, one Office reported that it was undertaking an exercise to define quality. Like CIPO, it agreed on the importance of "consistency" with the word "predictability" being identified from its deliberations.

9. The Subgroup recommended:

(a) to continue reporting on existing QMS using the present reporting mechanism, indicating changes from the previous report and including these changes in a summary along with other matters of likely interest as part of the introduction to the report; and

(b) that other Authorities should present overviews of their QMS to future meetings of the Subgroup.

#### (C) PROCESS CHARTS IN QUALITY MANAGEMENT SYSTEMS

10. About 10 Authorities had used process charts in their annual quality reports. Several had recently posted new or updated charts on the Subgroup's electronic forum and others hoped to share charts soon. The charts had been found useful for understanding the processes referred to by others in quality reports, as well as by the Authorities that had prepared them.

11. One Authority expressed interest in the software used by other Authorities for preparing process charts.

12. The Subgroup recommended that Authorities continue to post process charts to the Subgroup's electronic forum and to use them in annual quality reports where appropriate. The forum could also be used to provide information concerning the creation of charts, including the software used for the purpose.

#### (D) FEEDBACK FROM PAIRED REVIEW OF QUALITY MANAGEMENT SYSTEMS OF INTERNATIONAL AUTHORITIES

13. The Authorities that had participated in the paired review indicated that they had found the process useful and recommended others to participate in future. Informal discussion of reports had clarified various details of other Authorities' reports, identifying similarities and differences in processes that might otherwise be difficult to ascertain, given the variation in the use of terminology. Several Authorities indicated that the discussions had revealed ideas that could be used for improvements in their own systems. Risk-based practices had been of particular interest for several Authorities. One Authority indicated that it had received questions in advance from its partner Authority, which had assisted in preparation for the discussions.

14. The Subgroup noted the feedback from the paired review exercise and recommended that interested Authorities should again perform paired reviews of reports of Quality Management Systems at the next meeting. The International Bureau would invite Authorities to participate through the Circular requesting reports on the Quality Management Systems with a deadline to allow participating Authorities to make contact with the Authority that they would be reviewing and to share questions.

## **2. BETTER UNDERSTANDING THE WORK OF OTHER OFFICES**

### **(A) SURVEY ON SEARCH STRATEGIES**

15. Authorities welcomed a proposal to conduct a survey on search strategies to seek objective information on the types of users of search strategies and the form and content of information that they would consider important. The proposal envisaged two surveys. A first survey would be directed to Offices (designated Offices as well as International Authorities) and be administered directly by the International Bureau. It was expected that each Office would provide a single response, but where necessary distinguishing between the needs and concerns of different categories of users within the Office. An electronic web-based “smart” survey might permit the same question to be presented multiple times, which would allow a respondent to enter a different response depending on the different requirements of their various categories of user. As many of the questions as possible would be presented in a language-neutral fashion (yes/no or rankings) to assist analysis, especially if the survey were made available in multiple languages. A second survey would be in the form of a template that interested Offices could use as the basis of consultations with local user groups and return the results to the International Bureau.

16. While agreeing in principle that such a survey was desirable, various improvements were proposed to the clarity and scope of the questions. For example, explanatory notes on the purpose of the survey and the information sought, examples of the type of search strategies that Authorities currently made available on PATENTSCOPE, and a definition of “search strategy” might be useful. Offices with experience of searches assisted by artificial intelligence might include information on how this could affect the reporting of search strategies. Offices might seek to identify how often examiners actually access the search strategies currently provided. It might also be useful to have further information on what users would find helpful concerning searches in languages other than English. For the survey of users, further consideration should be given to the standard categories to be offered. A question might also be provided on what experience a user had in prior art searching and the databases with which they were familiar. In addition to the content, the procedures for conducting the survey needed to minimize the burden on users. Free text comments might be easier than dealing with a “smart” survey asking the same question in respect of different contexts within the same response.

17. The Subgroup recommended that:

- (a) Authorities should post all their comments on the Subgroup electronic forum by February 21, 2020 as a basis for further discussion of the content and methodology of the surveys; and
- (b) the United States Patent and Trademark Office should post a revised version of the surveys taking into account those comments by mid-April 2020.

### **(B) STANDARDIZED CLAUSES**

18. Authorities supported the use of standardized clauses in international work products, which could help harmonize practices and improve consistency of work. However, in view of the ongoing work on guidelines on reasoning to explain lack of unity of invention, the Subgroup agreed to defer discussing the development of standardized clauses in this area. Some Authorities indicated that they used their own standard clauses, similar to those that the Subgroup had developed; one of these Authorities had already shared its clauses on the

electronic forum. One Authority strongly encouraged the sharing of such standard clauses specific to an Authority. It was also emphasized that any clauses should not be a stand-alone tool, but should instead allow an examiner to provide additional explanation. One Authority that regularly handled cases from applicants who were unfamiliar with the patent system suggested that clauses could be developed to explain fundamental requirements to obtain a patent such as the need to define an invention and disclose it in a sufficient manner. CIPO indicated that it had other priorities and would not be able to continue leading discussions on this topic, and therefore asked if any other Authority was interested in taking on this role.

19. The International Bureau acknowledged the interest in developing clauses on lack of unity of invention at a later date. Even though it was not considered timely to develop new clauses, it remained useful to share clauses for information, including ones for dealing with inexperienced users of the patent system. Further common development work could be considered later. Meanwhile, the International Bureau would continue to work on improving the accessibility of the current standardized clauses, as well as the systems for allowing their use in written opinions generated using ePCT.

20. The Subgroup recommended that:

- (a) Authorities should be invited to share the clauses that they used to explain concepts to inexperienced users of the patent system and should continue to share other clauses they used in their reports if they had not done so already; and
- (b) the International Bureau should continue to improve the interface in ePCT for inserting the clauses into written opinions and for viewing the clauses.

### (C) PRACTICE DISCUSSION FORUM

21. Authorities welcomed the provision of a forum that could be used to discuss unusual issues encountered by Authorities. The discussions could be useful even to Authorities that were not able to contribute and the archive could form a useful record. The Subgroup's electronic forum was considered sufficiently secure for this purpose, noting that the details of cases would be anonymized before sharing with other Authorities.

22. The Subgroup recommended that the International Bureau maintain the discussion forum that had been created. The International Bureau should make available on the Subgroup's electronic forum a current list of users from each Authority with access to the forum and consider whether modifications could be made to highlight that postings to the practice discussion forum may be more urgent than typical postings to the forum more generally.

## 3. CHARACTERISTICS OF INTERNATIONAL SEARCH REPORTS

23. Authorities confirmed that they continued to find the reports on characteristics of international search reports useful as tools for self-reflection including identifying significant changes in trends or differences from the norm, in which case investigation of the reasons may be appropriate. A particular variation was noted in the percentages of citations in the category P,X. One Authority noted that further clarification might be useful on the definition of some characteristics, which may be taken up through the Subgroup's electronic forum.

24. As had been discussed in previous sessions, information on other characteristics would be useful if accurate data became available. This included issues related to unity of invention and national phase processes. Percentage of reports with at least one patent literature citation in a language other than that of the international application might be considered. Alternative views of data that had been provided for some of the characteristics, particularly with regard to technological breakdowns, might be useful for a wider range of characteristics. In addition, raw data in a format that was easier to handle, as well as an interactive tool for producing reports might be useful. However, it was agreed that significant investment in new processes for

generating reports was not justified until the data were available to support a substantive improvement to the information currently presented in the reports.

25. The Subgroup recommended that the International Bureau continue to produce reports in the current form, pending improvements in the quality, timeliness and/or scope of data to justify new development work.

#### **4. PCT METRICS**

26. Several Authorities indicated that they found the metrics provided by the International Bureau to be useful, including the reports that were available from ePCT. This may be either direct use, or else as a cross-check against reports generated by an Authority's own systems, where differences may highlight problems in communication or in data consistency. Authorities were pleased to note measures taken to improve data quality and to eliminate delays between reports being transmitted to the International Bureau and their completion being reflected in the reports.

27. Some Authorities considered that low use might be in part due to a lack of knowledge of the services available, or a shortage of staff with the time to use them effectively. The International Bureau might consider action to promote awareness of the various services. Forthcoming "push" information may also be very beneficial.

28. A variety of improvements were suggested to ePCT reports, including new fields in spreadsheets detailing the international applications with a particular action falling into different time periods compared to time limits, as well as potential new reports. The International Bureau invited International Authorities to send further such suggestions at any time. Of particular benefit would be suggestions on presentation of metrics in order to allow fast and accurate understanding of the information being provided.

29. The Subgroup noted the International Bureau's invitation to provide feedback on existing or potential new services related to metrics at any time.

#### **5. UNITY OF INVENTION**

##### **(A) PHASE I**

30. IP Australia referred to the proposals for modifications to the PCT International Search and Preliminary Examination Guidelines that had been the subject of Circular C. PCT 1573. Modifications had been made to the proposals to address drafting issues identified by Offices and user groups. Proposals that involved major new issues would be considered in a second phase of modifications.

31. The Authorities thanked IP Australia for the work put into leading the development of new examples for unity of invention over the course of several years. The examples as presented to the Subgroup were now considered acceptable subject to the deletion of duplicated text that was raised during the discussion, any typographical corrections or editorial improvements.

32. The Subgroup recommended that the International Bureau incorporate the proposed modifications with the above corrections into the next version of the Guidelines, expected to be promulgated to enter into force on July 1, 2020.

##### **(B) PHASE II**

33. IP Australia referred to the proposals to include guidance and examples on minimum reasoning methodology to determine unity of invention that had been developed during work by the IP5 Offices, the proposal by the Federal Service for Intellectual Property (Rospatent) to explain unity in chemical composition claims, and the comments from the International Association for the Protection of Intellectual Property (AIPPI) received in response to Circular C. PCT 1573 sent on October 7, 2019. IP Australia invited comments from other Authorities on

whether any of these proposals could be incorporated into the agreed modifications in Phase I, or should be part of further discussions on the wiki. Any proposals in the former group would require consultation through a PCT Circular shortly after the meeting.

34. The EPO presented the minimum reasoning methodology, which involved identifying the common matter between the inventions, explaining why this matter could not provide a single general inventive concept based on the same or corresponding special technical features, and, if not apparent, why there was no technical relationship between the common technical matter. The EPO presented two examples using the minimum reasoning argumentation, and invited other Authorities to provide similar cases using this argumentation. The EPO indicated that it was also open to adopting the guidance on minimum reasoning in the International Search and Preliminary Examination (ISPE) Guidelines with the Phase I modifications and consider the examples at a later stage.

35. Rospatent presented a further example to explain how lack of unity of invention could apply in chemical composition claims, where some substances were active ingredients and other were additives or excipients.

36. While the Subgroup generally supported adding guidance on minimum reasoning methodology in the ISPE Guidelines, Authorities considered that the proposed examples of the use of minimum reasoning would require further discussion before incorporation in Chapter 10 of the ISPE Guidelines. One Authority stated that the proposed minimum reasoning guidance required illustrative examples and should not be incorporated on its own. Regarding the new example for chemical composition claims, some Authorities believed that the claims could have unity *a priori* due to the presence of the same two active ingredients in each of the claims. The Subgroup consequently agreed to continue discussions on these further examples through the wiki, along with the AIPPI comments. In these discussions, Authorities should provide any further examples of the use of minimum reasoning to explain lack of unity of invention. The International Bureau would consult through a PCT Circular on any modifications where consensus emerged in the discussions.

37. The Subgroup recommended that Authorities should post any further examples to explain lack of unity of invention using the minimum reasoning methodology by the end of March 2020, and that Authorities should continue discussions on the wiki and aim to reach consensus on further amendments to Chapter 10 of the ISPE Guidelines for the International Bureau to complete consultations with International Authorities, designated/elected Offices and user groups before the end of 2020.

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

38. There were no further recommendations for additional areas of work.

[End of Annex and of document]