

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

Seventh Session
Geneva, June 10 to 13, 2014

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT ON THE TWENTY-FIRST SESSION

Document prepared by the International Bureau

1. The Annex to this document sets out the results of the twenty-first session of the Meeting of International Authorities under the Patent Cooperation Treaty (PCT/MIA), held in Tel Aviv from February 11 to 13, 2014, as outlined in the Summary by the Chair. Annex II to this Summary by the Chair contains a summary of the fourth informal session of the PCT/MIA Quality Subgroup, which was held immediately prior to the Meeting of International Authorities in Tel Aviv on February 9 and 10, 2014.

2. *The Working Group is invited to note the results of the twenty-first session of the Meeting of International Authorities under the PCT, as set out in the Summary by the Chair (document PCT/MIA/21/22), reproduced in the Annex to this document.*

[Annex follows]

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

TWENTY-FIRST SESSION, TEL AVIV, FEBRUARY 11 TO 13, 2014

SUMMARY PREPARED BY THE CHAIR

(noted by the Meeting; reproduced from document PCT/MIA/21/22)

INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its twenty-first session in Tel Aviv from February 11 to 13, 2014.
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 Egyptian Patent Office, the European Patent Office, the Federal Service for Intellectual Property of the Russian Federation (Rospatent), the Finnish Patent and Registration Office, IP Australia, the Israel Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, the National Institute of Industrial Property of Chile, the Nordic Patent Institute, the Spanish Patent and Trademark Office, the State Intellectual Property Office of the People’s Republic of China, the State Intellectual Property Office of the Ukraine, the Swedish Patent and Registration Office, and the United States Patent and Trademark Office.
3. The list of participants is contained in Annex I to this document.

ITEM 1: OPENING OF THE SESSION

4. Mr. James Pooley, Deputy Director General of WIPO, welcomed the participants on behalf of the Director General.

ITEM 2: ELECTION OF A CHAIR

5. The session was chaired by Mr. Asa Kling, Director of the Israel Patent Office.
6. Mr. Kling welcomed the participants, especially Boris Simonov, Director General of the Russian Federal Service for Intellectual Property, as well as the Delegation of the Intellectual Property Office of the Ukraine, which was participating in the Meeting for the first time. The Israel Patent Office was pleased to host this meeting. Israeli applicants were, per capita, amongst the highest users of the PCT system. Since the Office began operating as an international Authority in June 2012, on a competitive basis, it had been designated as competent International Searching Authority (ISA) by a large and increasing proportion of Israeli applicants – 658 cases in 2013 and over 1000 in total. The ILPO had been able to deliver international search reports in timely fashion in over 90 per cent of the cases. It was hoped soon to open the services of the Authority also to applicants from further receiving Offices. The recent trend towards closer links between Offices, including through the Patent Prosecution Highway (PPH), would help in reducing costs and workload as well as increasing the quality of granted patents. The Israel Patent Office was playing its part in that process and it was hoped that the session would be successful in making the PCT system more effective.

ITEM 3: ADOPTION OF THE AGENDA

7. The Meeting adopted the agenda as set out in document PCT/MIA/21/1 Rev.

ITEM 4: PCT STATISTICS

8. The Meeting noted the presentation by the International Bureau on the most recent PCT Statistics¹.

ITEM 5: PCT ONLINE SERVICES (EPCT)

9. Discussions were based on document PCT/MIA/21/2.
10. The International Bureau indicated that ePCT now offered all the most essential services required for applicants and receiving Offices, as well as transmission possibilities which were in use by some International Authorities. ePCT-filing was available in Demo mode for many receiving Offices beyond the International Bureau and would be opened for live use at some Offices from March 1, both for filing to conventional e-filing servers hosted at those Offices and to servers hosted for the receiving Offices by the International Bureau.
11. While many further refinements to the software were intended, the biggest benefits would come from Offices making use of the system. This did not necessarily mean that Offices should use the ePCT web browser interface – doing so might result in a reduction in quality and efficiency in cases where processes were already well automated. Rather, it meant ensuring that systems were compatible with allowing applicants to send and receive documents using ePCT and maximizing the amount of useful data available to applicants and other Offices, both for information and for more effective automation.
12. Offices which already used ePCT in their roles as receiving Offices and International Authorities confirmed that they found the system useful and easy to use. One Authority noted positive feedback which it had received on ePCT-filing from applicants who had tried out the Demo mode filings to that Office as receiving Office. Other Offices indicated their support for the general approach proposed in the document, subject to the need to assess technical and security issues. Existing electronic filing systems had been found to be very successful and useful by these Offices in their roles as receiving Office and by their applicants. The proposed approach to the use of ePCT offered opportunities to reduce delays and improve the quality and efficiency of the system. Several Authorities expressed their wish to ensure that ePCT and local IT systems were well aligned and integrated.
13. Several Authorities indicated that the forthcoming eSearchCopy system was expected to provide particular benefits for both receiving Offices and International Authorities and expressed the hope that live use could begin soon.
14. The International Bureau noted that receiving Offices might need to be able to forward text files representing sequence listings even if system checks detected that they were not in valid ST.25 format.
15. Authorities were interested in increasing the number of procedures which could become fully automated “self-service” systems. However, caution was also expressed and the International Bureau was invited to make appropriate consultations before eliminating manual checks in situations where errors could have significant undesired consequences.
16. It would be important for applicants to have quick and easy access to ePCT-filing, without needing to obtain a WIPO digital certificate first.

¹ Available from the WIPO web site at www.wipo.int/meetings/en/details.jsp?meeting_code=pct/mia/21

17. In relation to the legal issues noted in paragraph 42 of the working document, several Offices noted the importance and difficulty of signature issues. Timezone issues might also be difficult. There was a willingness to consider all of the other issues considered in the document; some Authorities mentioned that legal safeguards against non-availability of online services and a general review of Annex F might be particular priorities.

18. The International Bureau agreed to provide a more detailed ePCT roadmap, including an expected timetable for technical developments.

ITEM 6: QUALITY

(A) REPORT FROM THE QUALITY SUBGROUP

19. The Meeting noted with approval the Summary by the Chair of the Meeting's Quality Subgroup set out in Annex II to this document.

(B) MATTERS ARISING FROM THE REPORT FROM THE QUALITY SUBGROUP

20. The Meeting agreed with the recommendations contained in the report from the Subgroup.

(C) FUTURE QUALITY-RELATED WORK

21. The Meeting:

(a) approved the continuation of the Subgroup's mandate, including the convening of a further physical meeting of the Quality Subgroup in 2015;

(b) requested the Subgroup, in preparation for the Meeting's discussions of the issue of criteria for appointment of International Authorities at its next session (see paragraphs 44 to 54, below) to consider the quality related aspects to be taken into account when reviewing the criteria for appointment.

ITEM 7: FURTHER IMPROVEMENTS TO THE PCT SYSTEM

(A) DISCUSSION OF EXPANDED PCT 20/20 PROPOSALS

22. Discussions were based on document PCT/MIA/21/7.

23. Comments by Authorities on the issues set out in document PCT/MIA/21/7 included the following:

(a) With regard to the proposal to provide for "self-service changes" as part of the ongoing development of the ePCT system, several Authorities requested the International Bureau to provide information on the implementation of such self-service changes and the extent to which it had been possible to fully automate such changes and to which extent human intervention by formality examiners was still required. In response to these requests, the International Bureau indicated that it would be happy to provide the requested information to the Meeting at its next session.

(b) Concerns were expressed by several Authorities with regard to the proposal to allow for limited Chapter I amendments, noting the issue of added subject matter and the need for appropriate checks by a substantive examiner. Some issues could more appropriately be dealt with as rectifications of obvious mistakes under Rule 91

(c) Concerns were expressed by several Authorities with regard to the proposal to simplify the withdrawal of international applications by modifying existing signature requirements, noting the impact of such a withdrawal and thus the need for appropriate safeguards, though there was interest in this concept, especially in relation to withdrawals made at a very early stage.

(d) With regard to the proposal to provide for standardized fee reductions in the national phase, one Authority noted the importance for designated Offices to fully recognize the results of the international work products where they had been established by the same Office in its capacity as an International Authority.

(B) INTRODUCTION OF A MANDATORY RESPONSE TO A NEGATIVE WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY OR INTERNATIONAL PRELIMINARY EXAMINATION REPORT

24. Discussions were based on document PCT/MIA/21/8.

25. Several Authorities, while generally expressing sympathy for the proposal, stated that more discussion was needed, notably with users so as to obtain their input and feedback, noting the considerable additional burden on applicants and agents if the proposal was implemented. Several Authorities stated that implementation of the proposal would require changes to national laws. One Authority questioned whether the proposal was in line with PCT Article 27(5) and could thus indeed be dealt with in the PCT, or whether it should not rather be left to the national laws of designated Offices.

26. One Authority suggested that applicants should only be required to respond to any negative written opinion after national phase entry at the time when the national substantive examination actually started, rather than already at the time of national phase entry. Another Authority questioned how to deal with the case that the applicant merely submitted a formal response to any negative statement, for example stating in generic terms that national conditions for patentability differed from the international standards applied in the report, rather than responding in substance to any negative statements contained in the opinion or report.

27. One Authority stated that a mandatory response to any negative written opinion or report was already a requirement under its current national phase procedure but only where the Office had itself acted as the International Authority. Where that was not the case, it established, after national phase entry and against payment of an additional fee, a supplementary search report and written opinion and invited the applicant to respond to that report and opinion; a mandatory requirement to respond to the written opinion and report already upon national phase entry would thus serve no useful purpose under its procedures. Furthermore, it suggested that a response by the applicant should also be required to address negative statements concerning issues other than those under PCT Article 33(2), (3), or (4), such as issues of clarity of the claims.

28. One Authority, referring to the increasing importance of so-called "patent trolls" among applicants, wondered whether the PCT system should indeed be changed to provide such applicants with yet another opportunity to further amend their applications with a view to obtain a granted patent, noting especially that they would not use this opportunity to improve the application in the way which was hoped for.

(C) FORMAL INTEGRATION OF THE PATENT PROSECUTION HIGHWAY INTO THE PCT

29. Discussions were based on documents PCT/MIA/21/9 and PCT/MIA/21/18 Rev..

30. Several Authorities expressed their support in general for the proposal contained in documents PCT/MIA/21/9 and 18 Rev. to amend the Regulations and Administrative Instructions to formally integrate the PPH into the PCT, and to allow applicants to request accelerated processing in the national phase on the basis of positive international work products established by any Authority. Some preferred the "opt-out" provision for those Member States whose national law was not compatible with such a procedure (the first alternative for paragraph (b) in Rules 52*bis*.1 and 78*bis*.1 proposed in Annex I to document PCT/MIA/21/9). Others preferred or could accept an "opt-in" provision: either a simple opt-in as provided in the second alternative in document PCT/MIA/21/9, or else a qualified opt-in as provided in document PCT/MIA/21/18. It was noted, however, that certain details contained in the proposed new

Sections of the Administrative Instructions deviated from the equivalent provisions contained in the existing Global PPH arrangement and should thus be reviewed and aligned accordingly. Several Authorities, pointing to the recent establishment of the Global PPH arrangement and to the fact that this arrangement, as well as almost all existing bilateral or plurilateral PPH arrangements, were still in the stage of “pilots”, suggested to use those arrangements as a “test-bed” and to first await the experiences gained with those pilots before moving towards formal integration of the PPH into the PCT.

31. One Authority stated that, while inclusion of the PPH into the PCT would indeed be a step forward, PPH would in any case flourish, be it within or outside of the PCT.

32. Several delegations requested further explanations as to the reasoning behind the proposal set out in document PCT/MIA/21/18 Rev. to provide for a qualified “opt-in” approach as is the case with supplementary international search. Concerns were expressed as to the possibility for designated Offices to choose whether or not to accept a PPH request on the basis of international work products by specific Authorities only rather than by all Authorities, noting that this would add complexity to the system and would require the continued existence of a “spaghetti bowl” of bilateral arrangements between Offices rather than moving to a truly global, all inclusive PPH arrangement under the roof of the PCT. In response to those queries, the European Patent Office explained that it considered that the qualified opt-in approach would provide more flexibility for designated Offices to join the system whenever they were ready and would make it easier for an Office which at present had pilot PPH arrangements with only a limited number of partner Offices and wished to maintain that flexibility to offer PPH as an additional service for its users, and that such an approach might be more attractive to a number of Member States.

33. One Authority stated that inclusion of PPH in the PCT and thus accelerated processing of international applications in the national phase might pose a problem for its Office, noting that at present more than 70 per cent of all applications processed by its Office were PCT applications. It further stated that, in view of PCT Articles 27(5) and (6), it considered that implementation of the proposal to formally integrate the PPH into the PCT would require an amendment of the Treaty and thus the convening of a diplomatic conference.

(D) PROMOTING LINKAGE BETWEEN THE INTERNATIONAL PHASE AND THE NATIONAL PHASE

34. Discussions were based on document PCT/MIA/21/17.

35. Comments by Authorities on the issues set out in document PCT/MIA/21/17 included the following:

(a) With regard to the proposal to facilitate the International Searching Authority taking into account national search and examination results by the Office with which a first national application had been filed, several Authorities, while generally supporting the concept, expressed concerns with regard to existing confidentiality provisions under national laws which would not allow Offices of first filing to share search and examination results with the ISA. Furthermore, such results would in most cases not be available in time to be of use to the Authority in establishing the international search report. Others stated that their national laws did not prevent them from making such results available and that timing was such that they could be available in time to be used in the context of international search.

(b) With regard to the proposal, where non-English language cited documents had an English language equivalent, to also cite the relevant parts of that equivalent, several Authorities stated that this proposal required further study, noting the additional workload this would mean for examiners. Other ongoing projects, such as the Common Citation

Document, would allow the easier automatic identification and retrieval of those patent family members. One Authority stated that it already included such patent family document citations in its reports.

(c) With regard to the proposal to draft written opinions with a view to facilitating subsequent translations into English, several Authorities referred to the ongoing discussions in the Quality Subgroup on the issue of standardized clauses; a concern was expressed as to the importance of allowing examiners to express objections effectively and the potential discriminatory impact of such an approach *vis-à-vis* non-English languages.

(d) With regard to the proposal to offer fee reduction in the national phase if a Chapter II preliminary examination had been carried out, several Authorities pointed to the fact that they already today offered fee reductions, either in all cases or where the Chapter II report was entirely positive. Others felt that this should be left to each designated Office to decide and not be regulated by the PCT.

(e) With regard to the proposal to assign an application in the national phase to the same examiner that had carried out the work during the international phase, several Authorities stated that this was already their practice today, noting though that this was not always possible, due to work load and other practical considerations. Consequently, this should not be made a mandatory requirement but rather expressed as a preference.

(f) With regard to the proposal to limit the national phase search to the documentation of specific countries or regions, several Authorities expressed concerns as to the impact of such artificial limitation of the national search and stated that this should be left to the discretion of national Offices.

(g) With regard to the proposal to set up a system to give feedback to third parties which had submitted observations on an applications as to whether such observations were taken into account in the national phase, one Authority felt that this was too burdensome for Offices

(h) With regard to the proposal to provide access to the International Searching Authority under Rule 12.1*bis* not only to the results of an earlier search but also to prior examination reports, one Authority noted that those were rarely available in time to be of use for the Authority in the preparation of the international search report.

(E) PCT 3.0

36. Discussions were based on document PCT/MIA/21/19.

37. Comments by Authorities on the issues set out in document PCT/MIA/21/19 included the following:

(a) With regard to the proposal to amend the Regulations so as to allow applicants to formally comment on written opinions by the International Searching Authority, several Authorities questioned the need for such an amendment, noting the present opportunity to submit informal comments to designated Offices, which was rarely used by applicants, and the further opportunity to comment or to amend the application upon national phase entry. In reply to a query by one Authority, the International Bureau confirmed that, if so wished, it would be happy to automatically forward any informal comments received from the applicant to the International Searching Authority. Furthermore, any Authority would be free to transmit any such informal comments erroneously sent to it to the International Bureau using via the ePCT system.

(b) With regard to the proposal to modify Annex F of the Administrative Instructions to allow for the submission of electronic image files in JFIF format, several Authorities stated that they supported the proposal, provided that sufficient lead time was given for implementation. With reference to the discussions on document PCT/MIA/21/6, the International Bureau indicated that it would be happy to support image files in that file format if a sufficient number of Offices and Authorities were ready to accept that format, taking into account the additional issues discussed under item 16 of the agenda, below. One Authority indicated that it was evaluating formats for use in future systems and was contemplating the use of .PNG.

(c) With regard to the proposal to facilitate work sharing between receiving Offices and International Searching Authorities by making available the search and examination results of the Office of first filing to the Authority, several Authorities, while generally supporting the concept, expressed concerns with regard to existing confidentiality provisions under national laws which would not allow Offices of first filing to share search and examination results with the ISA. Furthermore, such results would in most cases not be available in time to be of use to the Authority in establishing the international search report. It was recognized, though, that such sharing would be possible with the permission of the applicant, and that having access to earlier search and examination results were beneficial even if only for a relatively small number of applications.

(d) With regard to the proposal to formally introduce collaborative search and examination into the PCT system, several Authorities, while noting the encouraging results of the pilots carried out (see paragraphs 60 to 64, below), stated their preference to first await the conclusion of any further pilots and a detailed analysis of the experiences gained before moving to formally introduce such collaborative search and examination system into the PCT.

(e) With regard to the proposal to facilitate work sharing between receiving Offices and International Searching Authorities by making IPC codes of applications accorded by the receiving Office on applications the priority of which was claimed in the international application available to the International Searching Authority, several Authorities supported further discussions on the issue. Such cooperation was considered valuable, possibly in the context of the WIPO Committee on Standards (CWS). Authorities noted the link to the discussions on the possible making available of search and examination results by the Office of first filing to the International Searching Authority. Other Authorities noted that where the previous applications were provisional applications, there was generally no classification information available. Additionally, one Authority noted that confidentiality issues may need to be considered.

(f) With regard to the proposal to include in WIPO Standard ST.14 recommendations as to how to cite non-patent literature in languages other than the language of the international search report, the International Bureau noted that, when it came to translations of those reports, consistency in those translations was indeed a challenge, notably where a report established in one non-English language contained a non-patent literature citation in a different non-English language and was then to be translated by the International Bureau into English. It was noted that the issue was of importance from two different aspects: applicants had to be able to understand the citation, so a translation was required where users did not understand the language of the title of the citation, and users had to be able to retrieve the cited document, so that it was important to maintain the citation in its original language. Authorities noted that language(s) in which they operated, as well as IT systems, were issues to be taken into account.

(F) PILOT PROJECT “E-PATENT EXAMINER”

38. Discussions were based on document PCT/MIA/21/15 and a presentation by the Federal Service for Intellectual Property (Rospatent)².

39. Rospatent introduced the results of the E-Patent Examiner feasibility study. The system had been developed to address a variety of issues including the explosion in volume, formats and languages of prior art, as well as the subjectivity of the views of patent examiners. The system sought to take a landscape of fundamental principles, disclosures of ideas and scope for invention. Using natural language processing on the description and claims, the system sought to place the invention within that landscape, using statistics and semantic identifiers to extract the sense of the invention and compare it with other documents in a language-independent manner. The computational resources involved were in the cloud and highly scalable, allowing the potential for large numbers of searches without the need for significant local computing resources.

40. The project had been begun in order to address the problems of the patent system in a radical way. The start of the century had seen a worldwide backlog of over 2 million applications and this had continued to grow. PCT-PPH and similar projects could help to some extent, but only addressed the edges of the problem. Businesses didn't want to wait. Various other automated patent search systems had been attempted but not been effective. This system took a new approach. It was only six months old, but had already demonstrated good results in over 100 tests. Patent classification systems had difficulty keeping the backfiles up to date, but this system was independent. Machine translation was attempting to reduce barriers, but tended to rely on English as a common language, which was not truly effective for all Offices – this system was also language independent.

41. Rospatent proposed to begin a pilot international project administered by WIPO. The system had potential benefits for a variety of different parties – business as well as Offices. If the fundamental principles could be shown to be effective and the system trained with databases supplied as a common tool, it could be effective for everyone and avoid the need for massive duplication of systems. It was believed that it should be possible to scale the system to allow 2 million searches per month or more to be carried out by the “robot examiner”. However, it required examination of the robot examiner to determine whether it could be truly effective and useful.

42. Authorities expressed interest in this visionary proposal which promised to revolutionize the patent system. One Authority agreed that data mining techniques were a significant factor in the future of searching and that the concept deserved scrutiny, but considered that the knowledge and experience of examiners was exceptional and crucial and that computer systems were a useful input, rather than a replacement for human judgment. Authorities invited Rospatent to provide them with further information before next steps could be agreed.

43. Rospatent agreed to provide Authorities with a link to the service developed in the feasibility study to allow them to better understand the proposal.

ITEM 8: APPOINTMENT OF INTERNATIONAL AUTHORITIES

44. Discussions were based on documents PCT/MIA/21/3 and PCT/MIA/21/21.

45. Authorities agreed that the process for appointment needed to be reviewed to allow effective expert consideration of applications for appointment. The formal process should involve the following stages:

² Available from the WIPO web site at www.wipo.int/meetings/en/details.jsp?meeting_code=pct/mia/21

- (a) The application for appointment would be made in the year before it was to be considered by the Assembly in September, to allow time for adequate review in the following stages.
 - (b) International Authorities would discuss the application and provide expert advice to the Committee for Technical Cooperation (CTC). In practical terms, this would be done at the Meeting of International Authorities.
 - (c) The CTC would meet as an expert, technical body, well in advance of the Assembly. In practical terms, this would usually mean a back-to-back meeting with the PCT Working Group.
 - (d) The Assembly would take a decision as set out in PCT Article 16, taking into account the advice of the CTC. The Assembly should not make provisional appointments. The candidate Office should meet all the criteria at the time of appointment, save that the requirement of a working quality management system should be reflected by having in place a working *national* system equivalent to that required by Chapter 21 of the PCT International Search and Preliminary Examination Guidelines ("Chapter 21") and a plan showing how this would work for the Office in its role as International Authority following appointment.
46. Ideally, before making their formal application for appointment, candidate Offices would be offered the assistance of one or more existing International Authorities in assessing the extent to which their Office met the requirements for appointment and in preparing their application in a manner which set out the necessary information in a way which allowed effective assessment by Contracting States. However, Authorities agreed that this step would need to remain optional. The International Bureau should assist the candidate Office in finding an Authority or Authorities willing to give such assistance.
47. While the formal part of the proposed process, set out in paragraph 45, above, would require at least nine months, one Authority observed that Offices should allow at least 18 months for the entire process, including the informal steps in preparing the application. It was important that the role of existing International Authorities be seen as transparent and useful both in ensuring proper expert advice was available to the Assembly and as being supportive to candidate Offices.
48. It was noted that applications tended to vary in the degree of detail given to different aspects of the requirements for appointment. Authorities considered that it would be useful if guidance could be given on the content and level of detail which was needed. One Authority suggested that greater information on technical and language skills of examiners would be useful.
49. Authorities agreed that it was premature to recommend any changes to the criteria for appointment. The key issue at stake was ensuring that Offices were able to perform international search and preliminary examination to the necessary level of quality. However, it was not clear how this could be measured more effectively. In particular, several Authorities observed that numbers of examiners, either in total or per technical field, were not a determinative factor in quality. While agreeing with that point, one Authority noted that a lot of factors had changed since the 1970s including types of technology within applications, volumes of prior art, the languages expected to be searched and technology available to assist the search. A benchmarking exercise might be useful to determine how these factors affected examiners in different fields of technology and different Offices. The length of time and numbers in which Offices had been performing national search and examinations might also be a factor in ensuring suitable experience. Random evaluations of national search and examination quality might be considered.

50. Some Authorities indicated that the provisions in paragraphs 11 to 15 of Chapter 21 were sufficient in ensuring that Authorities had the appropriate resources to work effectively and that if any change were needed, it was that there should be greater transparency in the measures taken to show that these requirements were met.

51. One Authority indicated that contractors who performed international search and preliminary examination work on behalf of an Authority should be treated on equivalent terms to employees of that Authority, noting that it was the responsibility of the Authority to ensure that the contractors met or played the proper role in meeting the various necessary requirements.

52. If new criteria were to be agreed, Authorities noted the need for appropriate transitional measures to allow sufficient time to adapt without disruption to Offices or the PCT system.

53. Authorities noted the increasing desire for effective examiner training, discussed further in item 9, below.

54. The Meeting recommended that the Quality Subgroup consider further the quality requirements to act effectively as an Authority and how these could be better expressed in the criteria for appointment.

ITEM 9: TRAINING OF EXAMINERS

55. Discussions were based on document PCT/MIA/21/4 and a presentation by IP Australia.

56. The International Bureau noted that Member States had endorsed a proposal in 2010 to discuss how technical assistance activities around examiner training might be improved, the extent to which Member States could support such activities, and the role that the International Bureau could play to facilitate cooperation in the area of examiner training and the sharing of tools and training materials. Since that date, a wide range of Offices had continued to supply training – in some cases in increasing amounts and according to long term plans between the relevant Offices – but a large proportion of the training remained *ad-hoc*, with very little coordination between the Offices offering the training.

57. Many Authorities outlined a wide range of types of examiner training and general IP training which they had provided in accordance with the requests of a large number of Offices within their regions or globally, as one-off sessions or as part of long term programs with extensive follow-up. Some of these Authorities kept local databases of training needs to match requirements and resources. Some Authorities proposed that WIPO create an internal database of training needs and resources. The focus of examiner training was sometimes based on issues such as novelty or unity of invention and sometimes on the searching requirements or other special needs associated with different types of subject matter. Hands-on training was desirable where possible. Demand was increasing and frequently requests were made at short notice, which were difficult to accommodate within the budgets and planning processes of the Authorities. Several Offices were experimenting with providing online training, but some had found that this did not achieve as high a level of engagement from examiners as direct, personal tuition. Feedback was often sought from course participants, but sharing information and feedback between Authorities might further assist the improvement of tuition.

58. IP Australia outlined its Regional Patent Examination Training program³. This was an in-depth training program lasting up to two years. It had been developed because IP Australia had found that short courses did not have sufficient impact. The first intake had been six examiners from ASEAN Offices, funded by IP Australia and two examiners from African Offices, funded by WIPO. A second intake was about to begin with 15 examiners. The program offered one on one support, mostly online, with each participating examiner being supported by an IP

³ The presentation and syllabus information are available from the WIPO web site at www.wipo.int/meetings/en/details.jsp?meeting_code=pct/mia/21

Australia trainer and a local supervisor. The course attempted to apply concepts in practice, using online resources, virtual classrooms and online collaboration using a variety of tools. The time commitment was considerable – around 2½ days per week for the first six months. This had required negotiation with local Office management around the work targets of the participants in order to ensure that they were able to maximize their participation. The participants reported good development of skills; the training was competency-based so that it could be completed more quickly than the maximum two years depending on progress. The training had been based on international (PCT) standards, which had resulted in some issues with respect to local standards, such as treatment of dependent claims. There had been early issues with IT security restrictions preventing effective use of some of the tools, but these had now been largely resolved. The role of the local supervisor had been found to be vital. Visits of supervisors to IP Australia had helped to clarify issues in this area. A Community of Practice had been launched. Though the first intake of the program had not yet completed its course, the approach appeared very successful.

59. The Meeting recommended that the International Bureau prepare proposals for better coordination of examiner training between national Offices, taking into account questions of effective long term planning, sharing of experience in delivering effective training and matching needs for examiner training with Offices able to supply the relevant needs.

ITEM 10: COLLABORATIVE SEARCH AND EXAMINATION PILOT PROJECT

60. The European Patent Office presented an oral update report on the Collaborative Search and Examination Pilot project carried out jointly by the Korean Intellectual Property Office, the United States Patent and Trademark Office and the European Patent Office. It recalled that the aim of the project was to allow examiners from different Authorities in different regions and with different language capabilities to work together to establish one high quality international search report and written opinion, benefitting from input from examiners from all three Offices. The objective of the first pilot project launched in May 2010, based on a very small number of applications, had been to test basic assumptions related to the feasibility of a collaborative approach in search and examination of international applications as well as to generally assess the advantages and disadvantages from a qualitative point of view. The subsequent second pilot project, completed in October 2012, had been based on a larger number of international applications, had built on the lessons learnt during the first pilot and allowed a more quantitative assessment of the approach and a fine-tuning of the operational working model.

61. Feedback from users and participating Offices on the first two pilots had been very positive. The main conclusions had been that collaborative search and examination was a realistic concept, that collaboration between examiners clearly added to the quality of the international search report and the written opinion, which in turn increased the legal certainty for applicants, and that no major additional time investment would be required by examiners from the Authorities which had established the collaborative search report and written opinion once the application had entered the regional and national phases before those Offices in their capacity as designated Offices.

62. On the other hand, questions had been raised by users in particular with regard to the likely increased costs and issues with regard to the timeliness of collaboratively established reports and written opinions. The European Patent Office was therefore currently reviewing the methodology of the project with a view to possibly launching a third pilot, this time being applicant driven so as to be able to better assess the real interest of users as well as reviewing the impact of the project in the regional and national phases. Results of this possible third pilot had to be awaited before discussions on a possible inclusion of collaborative search and examination into the PCT system could begin; at present, such discussions appeared premature.

63. The Japan Patent Office stated that, should certain conditions be met and noting that only limited resources would be available, it was interested in participating in a possible third pilot project.

64. Several Authorities expressed their concern as to the likely increased cost for such service and the thus likely low uptake by applicants, noting the negative experiences which had been made with the supplementary international search system, where high cost was seen as one of the major obstacles to the success of that system. On the other hand, it was noted that cost savings in the national phase could, at least partially, make up for any additional expense during the international phase. One Authority expressed the view that the system should only be introduced if all Authorities participated in it. While one Authority stated that the system, if introduced, should not be replacing supplementary international search but rather supplement it and be offered as an additional service, another Authority stated that the fate of the supplementary international search system needed to be determined independently of the possible introduction of a collaborative search and examination system.

ITEM 11: CLARIFYING THE PROCEDURE REGARDING THE INCORPORATION BY REFERENCE OF MISSING PARTS

65. Discussions were based on document PCT/MIA/21/14.

66. The European Patent Office reported that the responses to the questionnaire set out in Annex I to the working document reflected a wide range of views both on the correct interpretation of existing Rule 20 and on what the most appropriate policy should be if the provisions concerning incorporation by reference ought to be if the PCT Regulations were to be amended. This applied equally to the issues of whether it was permissible to incorporate an entire part by reference if an incorrect version had been submitted, and of whether it was appropriate to accept a priority claim from an application filed on the same day as the international application.

67. One Authority indicated that it was important that applicants should not lose rights in cases where they reasonably believed a problem to have been properly fixed. It was considered inequitable that an applicant who had supplied no claims at all was able to fix the problem when an applicant who had accidentally supplied the wrong claims was barred from doing so. It was also observed that it did not have to be the case that the conditions for recognizing a priority claim for Paris Convention purposes had to be the same as recognizing them for the purpose of allowing the opportunity of incorporation by reference.

68. Authorities agreed that there was a need to clarify the Rules one way or the other. This was important not only for applicants but for third parties. Modifications of the Receiving Office Guidelines could not fix the problem when there were fundamental disagreements over the interpretation of the Rules.

69. The Meeting recommended that the International Bureau send a Circular to all Contracting States containing the same questionnaire as shown in Annex I to document PCT/MIA/21/14.

ITEM 12: OPTIONS OR CONSEQUENCES WHEN INVITING THE APPLICANT TO SELECT A COMPETENT INTERNATIONAL SEARCHING AUTHORITY AFTER THE CHOSEN INTERNATIONAL SEARCHING AUTHORITY DECLARES ITSELF NON COMPETENT

70. Discussions were based on document PCT/MIA/21/10.

71. Several Authorities stated that they had not experienced any problems with international applications in respect of which the applicant had not chosen a competent Authority to carry out the international search and had not responded to invitations by the receiving Office to do so. In any case, they suggested that, in such cases, the approach should be for the receiving Office to

set a “default” Authority to become competent to carry out the international search rather than considering the application to be withdrawn; the latter was only possible once the applicant had not responded to any invitation to pay any outstanding search fee.

ITEM 13: PCT MINIMUM DOCUMENTATION

72. Discussions were based on document PCT/MIA/21/12.

73. Several Authorities stated that it was important to ensure that Authorities and database suppliers were able to obtain patent documents from a central source in easy to use formats, rather than having to obtain sets individually from the source Offices in differing formats. The format requirements should also facilitate the translation of documents into other languages, rather than Authorities having to exclude them from search because of lack of ability to use them in their original languages.

74. The Meeting recommended that the project aimed at increasing and better documenting the extent of the patent literature part of the PCT minimum documentation should continue.

ITEM 14: PCT SEQUENCE LISTING STANDARD

(A) REPORT FROM TASK FORCE ON SEQUENCE LISTINGS

75. Discussions were based on document PCT/MIA/21/16.

76. The European Patent Office, as leader of the Task Force created by the Committee on WIPO Standards (CWS), provided an update on the progress of the discussions in the Task Force. While discussions had been taking more time than originally expected and were ongoing, there still was the expectation that a final draft would be presented to the CWS for adoption at its May 2014 session. Discussion on the very important question as to how best to transition from the existing WIPO Standard ST.25 to the new sequence listing standard would continue in the Task Force.

77. Several Authorities stressed the importance of finding an appropriate solution to the issue of the transition from ST.25 to the new standard, noting that the question of whether both Standards should, for a limited period, coexist in parallel or whether ST.25 should cease to be applicable when the new Standard entered into force would largely depend on the issue of whether it was possible to easily convert a sequence listing which had been prepared in compliance with one Standard to a listing which was compliant with the other. It was also noted that, following adoption by the CWS of the new standard and agreement on appropriate transitional arrangements, work would have to commence to modify the equivalent PCT Sequence Listing Standard under Annex C of the Administrative Instructions.

(B) TREATMENT OF A SEQUENCE LISTING SUBMITTED IN AN INTERNATIONAL APPLICATION ON THE INTERNATIONAL FILING DATE

78. Discussions were based on document PCT/MIA/21/11.

79. Several Authorities generally welcomed a discussion on how best to address the situation that an applicant incorrectly indicates or does not indicate that a sequence listing forms part of the international application and where that error is only recognized after national phase entry, although it was noted that this situation had so far not occurred in many cases and had not posed major problems for most national Offices so far.

80. One Authority questioned whether the best approach to address the issue was indeed to consider any sequence listing filed together with the international application to form part of the application, no matter whether it was furnished in image format or in text format for the purposes of international search, or whether it would not be sufficient to address the issue by modifying the checklist in the request form and adapting e-filing systems accordingly. In any case, a

sequence listing furnished in text format with the application as filed should only be allowed to be indicated as being for the purposes of search if there was also a sequence listing in PDF format furnished as part of the main body of the description.

81. Following a request by one Authority, the International Bureau stated that it would be happy to look into improving the transmission of sequence listings to designated Offices, noting that they did not currently form part of the “application package” but had to be obtained separately from PATENTSCOPE.

ITEM 15: REVISION OF WIPO STANDARD ST.14

82. Discussions were based on document PCT/MIA/21/5.

83. Several Authorities expressed support for the concept of introducing categories “N” and “I” to denote cited documents relevant, when taken alone, to novelty or inventive step, respectively. These Authorities considered the distinction between the two situations currently represented by the single category “X” to be useful and not to present any extra effort for examiners, who already need to make the relevant distinction in order to prepare a written opinion. The only issue seen by these Authorities related to timing, noting that there would be a need to change certain IT systems.

84. On the other hand, one Authority opposed the introduction of the distinction unless also allowing the alternative of category “X”, indicating that a number of IT systems would need to be changed and that views on whether some documents related to novelty or inventive step might not be fixed until after issues had been clarified with the applicant.

85. Another Authority noted that it had originally supported the distinction, but no longer saw it as a priority given the fact that written opinions of the International Searching Authority would soon be available from the date of international publication, rather than only at 30 months from the priority date.

86. The International Bureau stated that, in its view, the distinction had appeared useful for the purpose of systems collating citation information from different sources, such as the Common Citation Document. However, it was not essential to the core PCT process, given that the information could be seen in the written opinion of the International Searching Authority. Accordingly, the International Bureau believed that consistency of international search reports was more important and that categories “N” and “I” should only be introduced if it was agreed that they would be a complete replacement for category “X”, the latter only being used at the same time as “N” and “I” for a short transitional period. It did not seem that the Meeting could offer clear guidance and the matter should be left to the Task Force.

ITEM 16: COLOR DRAWINGS IN INTERNATIONAL APPLICATIONS

87. Discussions were based on document PCT/MIA/21/6.

88. Authorities agreed that it was desirable to move ahead on allowing color drawings in international applications. This would make the system more attractive and improve the quality of disclosures for patent information and searching purposes. Most Authorities supported the “preferred” approach set out in paragraphs 18 to 25 of the working document, though it was noted that the alternative option could be brought in more quickly. Authorities would need to study the likely effects on document transmission times and increased requirements for processing power, storage capacity and internal bandwidth, as well as the time needed to prepare systems before finalizing proposals. The processes for providing black and white versions of color drawings to designated Offices which retained such a requirement would also need careful attention.

89. The Meeting recommended that the International Bureau continue to prepare proposals for allowing international phase processing of color drawings based on the approach set out in paragraphs 18 to 25 of document PCT/MIA/21/6.

ITEM 17: TRANSLATION OF ABSTRACTS AND REPORTS OF INTERNATIONAL APPLICATIONS

90. Discussions were based on document PCT/MIA/21/20.

91. One Authority noted that Offices had a common interest in reducing delays and improving the timeliness of various processes. The eSearchCopy system should be significant in this regard. Ensuring timely payment of fees by applicants was difficult; consideration might be given to making late payment fees according to Rule 16*bis* mandatory. XML international search reports offered wide benefits to the system as a whole, not only in relation to translation. Efficiency was important in translation, but careful consideration needed to be given to whether measures to reduce translation costs might have unintended consequences. The written opinion of the International Searching Authority was a core product of the system and examiners should not be pressured to reduce the length at the expense of quality. Objecting to the number of words in drawings might result in delays in sending the search copy due to dialog between the applicant and the receiving Office.

92. The Meeting noted the issues affecting timely and cost-effective translation.

ITEM 18: REVISION OF THE PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

93. Discussions were based on document PCT/MIA/21/13.

94. The International Bureau reaffirmed that it intended to revise the International Search and Preliminary Examination Guidelines regularly in the future when there were relevant changes to the Regulations or Administrative Instructions.

95. The Meeting expressed its broad support for the proposals on Guidelines and Forms set out in the Annexes to the working document, save that in proposed paragraph 19.12.05, the words “will first issue” should be replaced by “may first issue”, noting that not all Authorities would usually issue an invitation to pay additional fees at the Chapter II stage in the circumstances referred to.

ITEM 19: FUTURE WORK

96. The Meeting noted that the next session was expected to be convened in the first quarter of 2015, probably immediately following a meeting of the Quality Subgroup.

[Annex I to document PCT/MIA/21/22, containing a list of participants, is not reproduced here]

[Annex II (to document
PCT/MIA/21/22) follows]

ANNEX II (to document PCT/MIA/21/22)

PCT QUALITY SUBGROUP, FOURTH INFORMAL SESSION
TEL AVIV, FEBRUARY 9 AND 10, 2014

SUMMARY BY THE CHAIR

1. REPORTS ON QUALITY MANAGEMENT SYSTEMS UNDER CHAPTER 21 OF THE PCT SEARCH AND EXAMINATION GUIDELINES

1. Authorities reported on changes made in 2013 to their respective Quality Management Systems, with several Authorities highlighting their efforts to obtain ISO 9001 certification in the future and to improve communication with users by way of streamlining complaint handling procedures and carrying out user feedback surveys. Authorities expressed their general satisfaction with the current reporting mechanism and saw no need for changes to the reporting template.

2. The Subgroup noted that several Authorities had posted their quality policies and guidelines on the Subgroup's e-forum, following the establishment of a task under the lead of the Spanish Patent and Trademark Office and posting by that Office on the e-forum of information on its quality policy along with a document describing the eight quality management principles underlying ISO 9001.

3. The Subgroup recommended that Authorities which had not yet done so should share information on their quality policy and guidelines by posting it on the Subgroup's e-forum.

2. BETTER UNDERSTANDING THE WORK OF OTHER OFFICES

(A) SEARCH STRATEGIES

4. The Authorities reaffirmed that sharing information concerning search strategies was important in order to increase confidence in international search reports and to make them more useful to the end users. However, doubts remained about how best to provide information which was useful and accessible for end users without introducing significant additional work for International Searching Authority (ISA) examiners and potential for confusion among some readers. The potential users of such search reports included examiners at the designated Offices, applicants and third parties interested in the specific international application.

5. Most Authorities regarded examiners in the designated Offices as the primary target for search strategies. They would usually be skilled in understanding the general concepts and difficulties of online searching, even if they were not familiar with the specific searching languages or have access to the same databases as the examiner who carried out the international search. Some Authorities expressed the view that information useful to examiners should not be held back solely because of the risk of certain aspects of a full search strategy might be confusing or even misleading to non-experts. The International Bureau also suggested that detailed search strategy information may be useful to examiners from other Offices as a learning tool to seek tips in searching techniques best suited to particular subject matter.

6. On the other hand, it was agreed that examiners needed to be able to assess the most important aspects of the search strategy quickly and effectively. Too much information could actively prevent effective use. Some Authorities were also concerned about the effect that possible external evaluation of search strategies might have on the actions of examiners. The European Patent Office indicated that the pilot on collaborative searching had found that a clear and concise presentation of the databases, classifications and keywords used in a first search

had been the most important and effective way of assisting understanding between examiners at different Offices of the search done so far. Authorities noted that such an approach did not preclude ISAs from providing more information if they considered it useful to do so as long as the main information was presented in a readily accessible way and several Authorities encouraged those others not already doing so to provide search strategy information in whatever format was already generated internally.

7. At present, Authorities saw little value in trying to harmonize the presentation of fuller search strategy information. Work should concentrate on identifying the substance of what was useful. Authorities were not ready yet to set minimum requirements. Based on discussions in the Subgroup's e-forum, the International Bureau had provided a list of detailed information items which it might be appropriate to include. For the reasons indicated above, several Authorities suggested that large volumes of information might be unhelpful and that some, such as details of exactly which search query results had been viewed by the examiner, might be impossible to extract automatically from existing systems.

8. Some Authorities indicated that they had experimented with different depths of information about online searches for internal purposes. In general, three quarters of a page to two pages had been found appropriate for a useful record of a typical search. It was noted that this would usually involve some manual effort by the examiner, but that this was limited to selecting portions of records to cut and paste. It was found that different examiners went to different lengths to "clean up" search records to eliminate "blind alleys" which had not been found useful; this had been left as a matter of individual examiner discretion with little difficulty.

9. The International Bureau agreed that information should not be provided if it was unhelpful and that IT development or imposition on examiner time should only be done if the benefit clearly justified it. However, while it was important to find improvements which could be achieved quickly, the discussions should also set out useful goals for the future and not be limited by what was easy with existing IT systems or lay within the "comfort zone" of ISAs.

10. The United States Patent and Trademark Office provided suggested definitions of the terms "search statement", "search listing", "search strategy" and "search history" or "search record" to assist future discussions of these issues in the Subgroup.

11. The Subgroup recommended that the European Patent Office should lead a contact group to complete the details of a proposal for a pilot whereby participating ISAs would provide database, classification and keyword information in a harmonized manner and to make proposals as to the most efficient way to present such data, while noting that the extraction of such data should be automated to limit the burden on examiners. The contact group would seek to evaluate the effectiveness of this approach for Offices and usefulness for applicants. The results of this evaluation would be reported at the next session of the Meeting of International Authorities in 2015 with a view to beginning a one year pilot. The IB would support the contact group in its work, using the Subgroup's electronic forum.

12. In the meantime, the Subgroup encouraged further Authorities to make their fuller search strategies available on Patentscope and for the Subgroup to further discuss the extent to which they found such information useful and whether additional content should be provided. The aim should be to make recommendations for preparing useful search strategy information in a manner which minimizes the manual effort required by examiners at the ISA.

(B) STANDARDIZED CLAUSES

13. Authorities welcomed the draft set of standardized clauses covering novelty and inventive step considerations in Box No. V and objections under PCT Articles 5 and 6 in Box No. VIII of written opinions and international preliminary reports on patentability which had been posted by

the International Bureau on the Subgroup's e-forum, subject to minor drafting issues which should be addressed via the e-forum. Many Authorities indicated their intention to use those standardized clauses once a final wording had been agreed and subject to a sufficient lead time required for implementation, notably with regard to necessary changes to internal IT systems, any required translations and training for examiners. Authorities stressed the optional nature of those clauses and the need for continued flexibility and discretion for the examiner to address all relevant issues in a manner which was deemed appropriate in the given case.

14. While some Authorities expressed their interest in working towards the establishment of further standardized clauses covering other texts in written opinions and international preliminary reports on patentability, the Subgroup recommended to await implementation of this first set of clauses and experiences gained by Authorities, designated Offices, the International Bureau and users of the system before further extending this project.

15. Noting the currently limited set of standardized clauses and their optional nature, Authorities considered it premature at this stage to formally include this first set of clauses in the International Search and Preliminary Examination Guidelines and to revisit the question of possible inclusion in the Guidelines at a later stage. With regard to any required translations of the standardized clauses for inclusion in reports established in languages other than English, the International Bureau stated that it would work together with the Authorities concerned in preparing such translations.

16. The Subgroup recommended that:

- (a) Authorities should submit any further comments on the wording of the draft set of standardized clauses to the International Bureau via the Subgroup's e-forum before the end of April 2014;
- (b) the International Bureau should then finalize the clauses, taking into account any comments received, and formally communicate the final wording of those clauses to all Authorities by way of a Circular; the date of actual first use of those clauses in reports should then be left to each Authority, depending on its specific implementation needs.

(C) SAMPLING OF CASES IN QUALITY ASSURANCE PROCESSES

17. Authorities discussed the use of sampling of cases in their quality assurance processes, noting the usefulness and value of sampling if carried out in a balanced and not too formalistic manner. Authorities reported on their different sampling rates applied in different cases, depended on many factors, varying from low (often randomized) minimum percentage rates up to 100 per cent in certain cases, such as formality review, unity of invention cases or where a first international search had only revealed "A" citations. It was noted that the issue of sampling might also be governed by the ISO 9001 certification for Authorities which had obtained or were seeking such certification.

18. While all Authorities which took the floor on the matter agreed on the usefulness of further sharing of information on the different sampling practices by Authorities and invited Authorities which not had done so to post related information on the Subgroup's e-forum, Authorities expressed their preference for not pursuing any further work at this stage towards establishing "best practices" in this area, noting the different circumstances in which Authorities operated and the existing need for flexibility.

19. The Subgroup recommended that Authorities which had not yet done so should share information on their sampling practices and sampling rates by posting it on the Subgroup's e-forum.

3. QUALITY IMPROVEMENT MEASURES

(A) PROGRESS REPORT ON WORK FOR ESTABLISHING MECHANISMS FOR FEEDBACK AND ANALYSIS ON WOISA/ISR

20. The Japan Patent Office presented a progress report⁴ on its work towards establishing a proposed mechanism for designated Offices to provide feedback on international preliminary reports on patentability in respect of international applications where discrepancies had been found in search and examination results between the international and national phases of the PCT procedure, drawing heavily on the experiences gained from the collaborative analysis conducted together with the European Patent Office as part of Phase 3 of the Collaborative Metrics Study. It encouraged all Authorities to participate in a project to pilot such feedback and analysis mechanism, notwithstanding the considerable investment this would require in human resources for the mainly manual analysis to be carried out. Such a pilot would be entirely optional for both Authorities and designated Offices willing to receive and to provide such feedback, respectively, and to collaboratively carry out the required analysis of the applications in respect of which discrepancies were found.

21. Authorities welcomed the report by the Japan Patent Office, stressing the value of feedback and subsequent thorough analysis of the root causes for discrepancies in search and examination results and the importance of such mechanism for improving the quality of international reports and thus further developing the full potential of the PCT as a work sharing tool for Offices. Two Authorities expressed their concern about the possible impact of feedback received by an Authority on a patent granted by that Authority at a later stage in its capacity as a designated Office.

22. The Subgroup recommended that:

- (a) Authorities should submit any comments on the draft Quality Feedback Form established by the Japan Patent Office via the Subgroup's e-forum;
- (b) the International Bureau should, via the e-forum, invite Authorities in their capacities as both International Authorities and designated Offices to participate in what in essence would be bilateral projects (between an Authority and a designated Office) to pilot the proposed feedback and analysis mechanism;
- (c) Authorities (in their capacity as both International Authority and designated Office) should report back in general terms at the next session of the Subgroup about experiences gained and results obtained from the pilot project.

(B) CHECKLISTS IN QUALITY ASSURANCE PROCESSES

23. Authorities supported the optional use of checklists in the Authorities' quality assurance processes which had been posted by the International Bureau on the Subgroup's e-forum.

24. Noting the need to maintain the required flexibility and discretion for Authorities, Authorities did not at this time see sufficient value in further work towards the establishment of sample guidance checklists or a set of minimum elements and common format for such lists. However, further examples of checklists used by Authorities might be useful for information.

⁴ Available from the WIPO web site at www.wipo.int/meetings/en/details.jsp?meeting_code=pct/mia/21

25. The Subgroup recommended that:

(a) the International Bureau should include the proposed draft modifications to Chapter 21 of the International Search and Preliminary Examination Guidelines to provide for the optional use of checklists in the Authorities' quality assurance processes in its upcoming Circular to all interested parties for the purposes of consultation on other proposed modifications of those Guidelines.

(b) Authorities should post to the Subgroup's e-forum examples of checklists which might provide useful examples for other Authorities.

(C) UNITY OF INVENTION

26. Authorities supported the proposal by IP Australia, posted on the Subgroup's e-forum, for further work by Authorities to improve explanations and examples for complex cases of unity of invention, noting that the current examples given in the International Search and Preliminary Examination Guidelines, while generally seen as very useful in most cases, did not provide sufficient guidance for examiners in such complex cases.

27. The Subgroup recommended that:

(a) Authorities which had not yet done so should share existing guidelines, training materials and other information relevant to the consideration of cases of unity of invention by posting such material on the Subgroup's e-forum;

(b) the International Bureau should create a task on the Subgroup's e-forum to commence work by Authorities towards improving explanations and examples for complex cases of unity of invention, and to invite Authorities interested in leading this task to inform the International Bureau accordingly.

4. QUALITY METRICS

(A) CHARACTERISTICS OF INTERNATIONAL SEARCH REPORTS (CIRCULAR C. PCT 1398)

28. Many Authorities indicated that they had found the report on characteristics of international search reports very valuable as a "self-reflection" tool. Careful scrutiny was worthwhile to find information which allowed better understanding of the Authority's work and to identify areas where unexpected results were found, inviting deeper investigations.

29. The volume of information in the report made this difficult, but all of the information was found useful by at least some. Although most of the information was initially intended to allow Authorities to see trends within their own Offices, several Authorities found comparisons with other Authorities useful and preferred that the charts containing information for all Authorities continue to be provided together, rather than being separated out into separate reports for each Authority.

30. Consequently, there did not seem to be a need to fundamentally change the nature of the report. However, it would be useful to make the underlying data easier to identify and access. The European Patent Office indicated that an organization concerned with the semiconductor industry had indicated its interest in information specific to its sector and suggested that this might be a good technical field to use as a test bed for improving access to the breakdowns of information by field.

31. One major concern about the reports was that the information was old and it would take several years before the data would allow Authorities to see the effects of any actions which they might take to improve specific matters seen as problems, such as the citation of non-patent literature. Unfortunately, little prospect was seen of improving this situation until Authorities

were able to deliver citation information to the International Bureau in a machine-readable format which could be imported directly into a database from which the statistics could be prepared.

32. The International Bureau noted a desire for tools to allow deeper study of particular subjects, such as breakdowns in further ways or identification of individual international applications which had specific characteristics. However, it saw little prospect of delivering specific tools in the near future and suggested that interested Authorities use the European Patent Office's PATSTAT database, from which most of the information concerned was derived.

33. The Subgroup recommended that the International Bureau should continue to prepare this report in future years, but should seek to improve the presentation and accessibility to underlying information, including measures to allow the information on breakdowns by technical area to be more easily accessible.

34. The Subgroup also recommended that Authorities should share their findings from the report to assist other Authorities in their own analysis and to inform the International Bureau in understanding the ways in which the report was used in order to present the information in a way better suited to the needs of Authorities. The Subgroup's e-forum was likely to be the appropriate place for this.

35. The Subgroup finally recommended that interested Authorities should contact the European Patent Office to conduct bilateral discussions of aspects of the report with a view to preparing a set of practical examples for discussion by the Subgroup of information which could be found within the data which could provide useful information to Authorities.

(B) A PCT METRICS FRAMEWORK

36. The International Bureau reported on its progress in preparing the metrics requested. Although a wide range of metrics appeared possible from the data available, the International Bureau had found significant difficulties in preparing these in a way which would clearly be useful. A small proportion of the requested metrics had been prepared as examples for consideration. Further work would be done when the true requirements were better understood.

37. Concerns fell into several categories:

(a) Presenting all of the requested items of information as static files would result in several hundred data files (even without graphical views) and it would be difficult for Offices to easily and reliably find the right one for any particular purpose and be certain of exactly what it represented.

(b) Some of the proposed metrics had the potential to be misleading. For example, because of the spread of times between priority dates and filing dates, mean times from either of those dates may differ greatly from the median times. This could easily lead to incorrect conclusions if the spread is not seen; on the other hand, spreads were generally difficult to take in as a single figure without graphical representation.

(c) To get the best from information would often require combining information from different statistics, but these often had different baselines so that they were not directly comparable (for example, some statistics would be based on international applications with priority dates within particular periods, others filing dates, others the date on which a particular action occurred).

- (d) Many metrics would be difficult to assess from tables of data, but could be represented graphically in a variety of different ways. It would not be practical to provide static graphical images for all of the proposed metrics, but where this was done, the purpose needed to be clear so as to select the most effective format.
- (e) Some data fields contained a significant number of defects – errors were introduced, for example, by manual transcription by the International Bureau, and many data items were never received from the Offices responsible for the relevant action. The limitations needed to be understood properly to allow the errors to be reduced where possible and for the metrics to be presented in a way which takes adequate account of significant omissions.
38. Authorities observed that additional breakdowns would be useful, such as times to actions from date of receipt of search fees or from the time when national security clearance was completed, or whether invitations to pay additional fees had been made due to lack of unity of invention. However, the International Bureau noted that in general it did not hold such information and would need to be sent in machine-processable form by the responsible Offices to be able to provide such metrics.
39. It was noted that the metrics included in this agenda item were in fact similar in nature to those relating to characteristics of international search reports and that the subjects should, for many purposes, be considered as one.
40. The International Bureau suggested that it would probably be most effective to handle different metrics in different ways:
- (a) Some metrics were particularly important to the effective management of receiving Offices, International Authorities and the International Bureau. These should be produced as regular reports in graphical and table formats, tuned for easy understanding of the regular important issues by the Offices concerned in order that they could take any necessary action to address problems or changes in workload.
- (b) Other metrics could be expected to be frequently useful for understanding issues which require the Office to perform significant analysis specific to the problem. The International Bureau was currently testing an extension to the WIPO IP Statistics Data Center⁵ to include PCT Statistics in addition to the general patent, trademark, industrial design and utility model information which was currently available. This should be publicly available soon. It was hoped that this would be able to provide most of the statistics in this category in a manner which would be more up to date and easier to use than maintaining a large number of static files.
- (c) Some detailed metrics might in reality only be needed as one-off pieces of information. The International Bureau's capacity to perform bespoke queries was very limited, but this might nevertheless be the most effective approach for some matters.
41. The Subgroup agreed to await the availability of PCT information in the WIPO IP Statistics Data Center and assess the needs for further development based on analysis of the metrics so far provided and the effectiveness of the Data Center.

⁵ ipstatsdb.wipo.org/ipstatv2/ipstats/patentsSearch

(C) UPDATE ON PHASE 3 OF THE COLLABORATIVE METRICS PROJECT

42. The European Patent Office gave a presentation of the work done by the European Patent Office and Japan Patent Office on analysis of the national phase first action by one Office of international applications processed by the other as ISA. This had involved detailed scrutiny of 221 cases from IPC subclass G08G (Traffic Control Systems). The method consisted of three main inter-related activities. Each had delivered useful information which deepened the Office's understanding. The three steps had been:

- (a) exchange and analysis of structured data;
- (b) categorization of applications according to outcomes in the international phase and national first actions; and
- (c) deeper analysis of cases of particular interest.

43. This methodology had allowed an efficient collection of large quantities of useful data in between 10 and 30 minutes per case for step (b). Step (c) required some additional time per file, yet this was time well invested since it involved examiners from both Offices reaching a consensus on the reasons for discrepancies. The results of the analysis had been broadly consistent with other studies performed, such as in relation to applications processed under the Patent Prosecution Highway.

44. The Japan Patent Office stated that it had found the project extremely useful and hoped to extend it to further fields of technology, subject to availability of resources.

5. OTHER IDEAS FOR QUALITY IMPROVEMENT

45. Upon the suggestion by one Authority, the Subgroup recommended to devote some time at the next session of the Subgroup to discussions of quality related issues common to all Authorities which had obtained or were seeking ISO 9001 certification, on the understanding that participation in such discussions would be open to all Authorities, including those which had not obtained or were not seeking certification at this stage.

[End of Annex and of document]