

Patent Cooperation Treaty (PCT) Working Group

Eighth Session
Geneva, May 26 to 29, 2015

APPOINTMENT OF INTERNATIONAL AUTHORITIES

Document prepared by the International Bureau

SUMMARY

1. The present document gives an update on the ongoing discussions in the Quality Subgroup of the Meeting of International Authorities (PCT/MIA) and in the Meeting of International Authorities itself on the requirements which Offices should meet in order to perform international search and preliminary examination to the necessary level of quality, and on how these requirements could be better expressed in the criteria for appointment of Offices as International Searching and Preliminary Examining Authorities.

BACKGROUND

PROCEDURES FOR APPOINTMENT

2. At its forty-sixth session, the PCT Assembly adopted an Understanding concerning new procedures for appointment of an International Authority (document PCT/A/46/4 and paragraphs 18 to 26 of document PCT/A/46/6), as follows:

“Procedures for Appointment of International Authorities:

“(a) A national Office or an intergovernmental organization (“Office”) seeking appointment is strongly recommended to obtain the assistance of one or more existing International Authorities to help in the assessment of the extent to which it meets the criteria, prior to making the application.

“(b) Any application for appointment of an Office as an International Authority is to be made well in advance of its consideration by the PCT Assembly so as to allow time for an adequate review by the Committee for Technical Cooperation (PCT/CTC). The PCT/CTC should meet as a true expert body at least three months in advance of the PCT Assembly, if possible back-to-back with a session of the PCT Working Group (usually convened around May/June of any given year), with a view to giving its expert advice on the application to the PCT Assembly.

“(c) Consequently, a written request to the Director General to convene the PCT/CTC is to be sent by the Office preferably by March 1 of the year in which the application is to be considered by the PCT Assembly and in any case in time to allow the Director General to send out letters of convocation of the PCT/CTC not less than two months prior to the opening of the session.

“(d) Any such application should be made on the understanding that the Office seeking appointment must meet all substantive criteria for appointment at the time of the appointment by the Assembly and is prepared to start operation as an International Authority as soon as reasonably possible following appointment, at the latest around 18 months following the appointment. With regard to the requirement that the Office seeking appointment must have in place a quality management system and internal review arrangements in accordance with the common rules of international search, where such system is not yet in place at the time of the appointment by the Assembly, it shall be sufficient that such system is fully planned and, preferably, that similar systems are already operational in respect of national search and examination work to demonstrate the appropriate experience.

“(e) Any document by the Office in support of its application for consideration by the PCT/CTC should be submitted to the Director General at the latest two months prior to the opening of the session of the PCT/CTC.

“(f) Any such application is then to be submitted to the PCT Assembly (usually convened around September/October of any given year), together with any advice given by the PCT/CTC, with a view to deciding on the application.”

CRITERIA FOR APPOINTMENT

3. The issue of criteria for appointment was first discussed during the twenty-first session of the Meeting of International Authorities, held in Tel Aviv in February 2014. The Meeting concluded that “the key issue at stake was ensuring that Offices were able to perform international search and preliminary examination to the necessary level of quality” and recommended that the requirements for this, and how these could be better expressed in the criteria for appointment should be referred to the Quality Subgroup. The topic was summarized as follows:

“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.”

4. At its seventh session, held in Geneva in June 2014, the PCT Working Group endorsed this recommendation. The discussions by the Working Group were summarized as follows (paragraphs 51 and 52 of document PCT/WG/7/29):

“51. With regard to the substantive criteria for appointment, all delegations which took the floor agreed with the assessment set out in document PCT/WG/7/4 that it was premature at this stage to present any concrete proposals for changes to the current criteria. Several delegations expressed preliminary views with regard to some of the issues related to possible new substantive criteria set out in document PCT/WG/7/4. Several delegations expressed the view that there might not be the need to establish new criteria and that proper “enforcement” of the existing criteria might be sufficient.

“52. There was broad agreement in the Working Group that there was a need for further thorough discussions among Member States about the issues at stake, including, in particular, what appropriate quality requirements an Office should be required to meet to act effectively as an Authority and how these could be better expressed in the criteria for appointment. The Working Group noted that the PCT/MIA had referred this issue to its Quality Subgroup for further consideration and agreed to await the outcome of the discussions in that Subgroup and in the PCT/MIA before further considering the issue at its next session in 2015.”

5. A detailed record of the discussions can be found in paragraphs 119 to 177 of the report of the session (document PCT/WG/7/30).

ISSUES

6. The Quality Subgroup continued its discussions on the quality requirements to act effectively as an Authority and how these could be better expressed in the criteria for appointment at its fifth informal meeting, held in Tokyo in February 2015. In preparation for the fifth informal meeting, the International Bureau had prepared a paper for discussion by the Subgroup, setting out the following considerations:

(a) Many of the comments so far made, both in the PCT Working Group and in the Quality Subgroup, have focused on the difficulty in expressing the required level of quality of work products in figures which are not direct measures of that quality, such as the number of examiners. Several of the comments identified the need to maintain a suitable range of International Authorities in order to meet the varying regional and linguistic needs of applicants from different States.

(b) Of those comments so far which have suggested specific areas for consideration by the quality subgroup, the following are some of the main issues which have been suggested for study:

- (i) the quality and scope of the databases and tools available to examiners for performing the international search;
- (ii) the qualifications, depth and breadth of technical knowledge and length of experience of examiners;
- (iii) the training programs for examiners;
- (iv) working environment factors affecting retention of examiners;
- (v) better evaluation of Offices' quality management systems;
- (vi) evaluation of a working national equivalent of the required quality management system over an extended period prior to appointment;
- (vii) strengthening the requirements of the quality management systems (such as making more of the recommendations mandatory);
- (viii) elaboration of a standard application form for appointment;
- (ix) demonstration of experience of the Office, such as by the number of searches performed annually or indicators concerning complaints and appeals against decisions;
- (x) evaluation of national search quality;
- (xi) the availability of Authorities in a region or with particular language skills.

(c) In order to move forward with any proposed changes to the criteria, or to conclusively determine that no change is required, it will be necessary for the Quality Subgroup to identify ways in which these or other issues could be set out as requirements which can be evaluated in a practical manner. Any proposals will need to:

- (i) allow a good degree of certainty to candidate Offices as to the standards which need to be met;
- (ii) allow the evaluation to be meaningful, but possible to conduct in a manner which is practical and acceptable to Offices and Contracting States;
- (iii) avoid presenting a burden in time or effort which represents a barrier to appointment greater than necessary to ensure the required quality standards for international search and preliminary examination reports;
- (iv) be of a nature that the existing International Authorities could agree to undertake, to the extent relevant, in relation either to their ongoing commitment to reporting of quality management systems, or else in relation to their periodic need for reappointment as International Authorities.

7. The discussions by the Quality Subgroup and its recommendations as to further work are summarized in the Summary by the Chair of the meeting (Annex II to document PCT/MIA/22/22, paragraphs 46 to 51, reproduced in the Annex to document PCT/WG/8/2) as follows:

“46. Based on a recommendation by the Meeting of International Authorities at its twenty-first session, subsequently endorsed by the PCT Working Group, the Authorities discussed what appropriate quality requirements an Office should be required to meet to act effectively as an International Authority and how these could be better expressed in the criteria for appointment.

“47. Discussions were based on specific suggested areas for consideration which had been made to date both in the Working Group and the Subgroup. Noting the political and sensitive nature of the issues at stake, Authorities agreed that, at this stage, it would not appear appropriate to consider amendments to the existing requirements for appointment as set out in the Regulations. Authorities further agreed that it would neither be appropriate nor realistic to suggest any areas for consideration which would require a direct evaluation of the search and examination quality of an Office.

“48. Authorities agreed that the focus of further work should rather be on procedural issues related to quality, such as the extent to which an Office seeking appointment already had in place a quality management system and internal review arrangements in accordance with Chapter 21 of the International Search and Preliminary Examination Guidelines or, where such system was not yet in place at the time of appointment, the extent to which an Office had an equivalent system operational in respect of national search and examination work.

“49. The Subgroup recommended that one area of possible further work should be to review the present Chapter 21 of the Guidelines with a view to strengthening the requirements with respect to quality management systems, notably, by making certain requirements mandatory which to date were only recommendations or by adding certain requirements which might be missing from the current text. In that context, the Subgroup also noted that, at present, under paragraph (d) of the Understanding on the Procedures for Appointment as adopted by the PCT Assembly in 2014, the requirement to have systems similar to those under Chapter 21 operational at the time of appointment was not a mandatory requirement (“preferably”) and recommended that this provision might be reviewed with a view to making it mandatory.

“50. The Subgroup further recommended, as a second procedural issue related to quality, to elaborate on the development of a standard application form for any request for appointment, with a view to ensuring that all pertinent quality issues were indeed covered in any request for appointment.

“51. The Subgroup recommended that the International Bureau should take the lead in further developing proposals on the issues set out in paragraphs 49 and 50, above, although it was noted that further work in this area would greatly benefit from and indeed depend on active contributions by Authorities.

“52. After some discussion, the Subgroup reconfirmed its understanding that any possible new requirements related to the issue of quality would apply to both existing Authorities (with appropriate transitional measures, if needed) as well as Offices seeking to be appointed, in line with the discussions of this issue at the twenty-first Meeting of International Authorities and the discussions in the seventh session of the PCT Working Group.

“53. Upon request, the International Bureau confirmed that any new requirements related to quality would only apply if and when approved by all Member States; before entry into force of any such new requirements, the current requirements would continue to apply to any Office seeking appointment.”

8. The recommendations set out in paragraphs 49 to 51 were subsequently endorsed by the Meeting of International Authorities at its twenty-second session, held in Tokyo in February 2015 (see paragraph 13 of document PCT/MIA/22/22, reproduced in the Annex to document PCT/WG/8/2).

9. The Working Group is invited to note the update on the ongoing discussions in the Quality Subgroup of the Meeting of International Authorities (PCT/MIA), and in the PCT/MIA itself, on the quality related aspects of the criteria for appointment of International Authorities, in particular the recommendations by the Quality Subgroup set out in paragraph 7, above.

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