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Le Bureau international de l'Organisation Mondiale de la Propriété Intellectuelle (OMPI) présente ses compliments et a l'honneur de transmettre ./ ci-joint le rapport (document PCT/MIA/17/12), adopté par la Réunion en anglais seulement, de la dix-septième session de la *Réunion des administrations internationales instituées en vertu du PCT*, qui s'est tenue à Rio de Janeiro du 9 au 11 février 2010.

Les documents de travail sont aussi disponibles sur le site Internet de l'OMPI (voir <http://www.wipo.int/pct/fr/meetings>).

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Seventeenth Session
Rio de Janeiro, February 9 to 11, 2010

REPORT

adopted by the Meeting

INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its seventeenth session in Rio de Janeiro from February 9 to 11, 2010.
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, IP Australia, the Israel Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, the National Board of Patents and Registration of Finland, the Spanish Patent and Trademark Office, the State Intellectual Property Office of the People’s Republic of China, the Swedish Patent and Registration Office, and the United States Patent and Trademark Office.
3. The list of participants is contained in the Annex.

OPENING OF THE SESSION

4. Mr. James Pooley, Deputy Director General for Patents, World Intellectual Property Organization (WIPO), on behalf of the Director General, opened the session, welcomed the participants and thanked the Brazilian National Institute for Industrial Property hosting the session and for the excellent arrangements it had made. He especially welcomed the Egyptian Patent Office and the Israel Patent Office, which were both represented for the first time in this Meeting.

5. Mr. Jorge de Paula Costa Ávila, President, Brazilian National Institute for Industrial Property, welcomed the participants to the meeting. He stated that this event addressed the issues underlying one of the most important discussions in WIPO, that of solving the problems of backlogs. He hoped that the session would be a great success in providing technical support for the discussions which took place in Geneva. He stated that becoming operational as an International Authority had been extremely important for Brazil and would help it in representing the needs of developing countries within the PCT system.

6. The Meeting observed a minute of silence in memory of Mr. Peter Hofbauer, representative of the Austrian Patent Office in the Meeting for many years, who died in a hiking accident in September 2009.

7. The session was chaired by Mr. Luiz Otavio Beaklini of the Brazilian National Institute for Industrial Property.

ADOPTION OF THE AGENDA

8. The Meeting adopted as its agenda the draft contained in document PCT/MIA/17/1 Rev.

PCT STATISTICS

9. The Secretariat presented statistics illustrating the context in which some of the items on the agenda needed to be viewed. Notable points included the decrease, for the first time since PCT began operations in 1978, by 4.5% in the number of international applications filed in 2009, with very robust growth rates, however, in filings from applicants in China and some European States, and statistics relating to the distribution of languages of filing, the mode of filing (paper, electronic, mixed-mode), the distribution of international search work, and the timeliness in the transmittal of international search reports to the International Bureau.

PCT USER SURVEY RESULTS

10. Discussions were based on document PCT/MIA/17/7.

11. The Authorities noted and welcomed the fact that it was intended to repeat the survey in further languages, so as to gain further information from users in regions from which only a limited number of responses had been received.

12. Two Authorities noted that they had recently also conducted surveys with their own users and that the results were generally consistent. One of these Authorities observed that the results were useful not only in identifying areas for improvement but in identifying the issues which most affected the perceptions of the system by its users. It could be very useful to discuss such issues in a quality subgroup.

13. One Authority noted that the user survey responses reflected past experiences, rather than the current situation, because backlogs had recently been reduced.

14. Some of the key issues identified by International Authorities as emerging from the International Bureau's or their own surveys included the following:

- (a) The timely delivery of reports is extremely important.
- (b) The process of demanding international preliminary examination is too complicated.
- (c) Options to extend many time limits would be beneficial.
- (d) Cost reductions in the national phase recognizing the work already done in the international phase would encourage use of the system.
- (e) Fee reductions would be useful, including for small and medium-sized enterprises, universities and applicants from developing countries.
- (f) Forms should be simplified and reduced in number.
- (g) The International Bureau and national Offices should consider trying to establish pools of investors and public financing which might be available to applicants.
- (h) Greater use should be made of e-mail and electronic document transfers.
- (i) The International Bureau and national Offices should do more to promote the benefits of the system.
- (j) International preliminary examination should add more value than at present to the initial work of the international search report and written opinion of the International Searching Authority.
- (k) Applicants should receive at least one written opinion from the International Preliminary Examining Authority before a negative international preliminary report on patentability is established, assuming that the applicant has made a genuine attempt to respond to the issues addressed in the written opinion of the International Searching Authority.
- (l) Simplifications to e-filing systems could bring benefits for applicants and International Authorities alike.
- (m) The quality of international phase work must be improved to encourage its effective use in the national phase.

(n) International applications need to be searched and examined in the national phase according to the specific standards of the relevant national laws.

(o) The frequency of changes to the PCT Regulations and Administrative Instructions can bring complexity.

15. The International Bureau observed that some of these issues would need to be included in the studies to be presented to the third session of the PCT Working Group and that one of these, in particular, would cover fee reductions.

QUALITY FRAMEWORK

Review of Annual Reports

16. Discussions were based on paragraphs 2 and 3 of document PCT/MIA/17/8, and the reports on quality management systems referred to in those documents¹.

17. One Authority commented that the annual reports were becoming increasingly interesting as Authorities' experience with quality management systems and the reports themselves increased. Some of the points where further information was sought included:

(a) in respect of a patent examiner competency program, the details of how the training needs of examiners were being monitored;

(b) an investigation into reports where only "A" category citations had been made showed that these reports were more likely than others to be found deficient – in this case, the relevant Authority observed that it was looking into the possibility of having such cases reviewed by a further examiner before a report was established;

(c) details of the work of a quality task force;

(d) whether a new checklist for international preliminary examination reports dealt with the substantive requirements of such reports or only with the formalities – the relevant Authority clarified that the checklist covered both substantive and formal issues.

18. The Meeting agreed that the International Authorities' annual reports on their quality management systems should again be published and that this fact should be reported to the Assembly.

¹ The reports on quality management systems are now available at <http://www.wipo.int/pct/en/quality/authorities.html>.

Templates for Future Annual Reports

19. Discussions were based on paragraphs 4 and 5 and Annexes I and II of document PCT/MIA/17/8.

20. The European Patent Office introduced the proposed templates, recalling that the first reports on quality management systems had been very diverse in content and difficult to compare. This situation had been improved by the introduction of the existing templates. The proposed new templates aimed both to reflect the new layout and content of Chapter 21 of the International Search and Preliminary Examination Guidelines as expected to come into force shortly and to introduce further structure aimed at assisting comparison of reports. The Office stated that it should not be considered necessary to follow the format rigidly in all cases where this was not appropriate, but merely be used as an aid to ensuring that other Offices could use the reports effectively.

21. One Authority welcomed the templates but noted that they addressed the formal aspects of quality management and did not deal with the question of the quality of the actual search reports and written opinions. The Authority hoped that this aspect would also be addressed.

22. Two Authorities noted that the templates proposed by the European Patent Office included questions which were a great deal more specific than in the current templates. They expressed particular concern about the items corresponding to paragraphs 21.09, 21.18(d), 21.24(a)(iv), 21.22(b) and 21.23(h), which went into matters which appeared to go beyond what was clearly required by the new version of Chapter 21 of the PCT International Search and Preliminary Examination Guidelines.

23. The Meeting agreed that future reports should be established using the templates as shown in Annexes I and II of document PCT/MIA/17/8, subject to the understanding that it was not essential for Authorities to complete all items within the template or to follow those formats rigidly in cases where they did not consider this appropriate.

Creation and Mandate of a Quality Subgroup

24. Discussions were based on paragraphs 6 to 11 of document PCT/MIA/17/8.

25. The International Authorities observed that quality was fundamental to most of the main issues facing the PCT at the moment. The Authorities faced a wide variety of different problems but could nevertheless learn a great deal from each other. Most of the Authorities considered that more effective discussion between Authorities was required outside of the formal sessions of the Meeting. However, if a quality subgroup was to be set up, it was important that it should have clear tasks and deadlines.

26. One Authority considered that the Meeting itself, rather than a subgroup, should continue to consider quality issues rather than moving the subject to a subgroup. Another Authority considered that it was important to address not only the procedural aspects of quality management but the evaluation of the quality of the results being delivered.

27. It was hoped that most of the work could be done without physical meetings, for example, using electronic fora and video-conferencing. Some of the Authorities considered that a physical meeting might be beneficial, but it was noted that this would be very expensive and it would be essential to have a clear and useful agenda if this was to happen. The Swedish Patent and Registration Office offered to host a meeting in or around October 2010 if this was considered appropriate.

28. The Meeting agreed:

(a) that one of the main objectives of the PCT system as a work sharing tool was to provide high quality international search and examination reports which were of the greatest possible value to applicants, third parties and designated and elected Offices in determining whether an international application met the main requirements of patentability in accordance with the different national laws of the various Contracting States;

(b) that the purpose of the common quality framework set out in Chapter 21 of the PCT International Search and Preliminary Examination Guidelines was to ensure that International Authorities set up appropriate systems to ensure that their work resulted in such high quality international reports, consistent with the objectives of and the requirements under the PCT; and

(c) that confidence in the high quality of international search and examination reports established by International Authorities was essential to the effective use of those reports by designated and elected Offices to assist in reducing costs, workload and unnecessary duplication of work and increasing the quality of patents granted by those Offices.

29. The Meeting agreed that such confidence would be best served by an effective evaluation of the value of international reports for the purposes of assisting national phase processing. As a first step towards that goal, the Meeting agreed that a quality subgroup should be convened, which should use an electronic forum as its main means of discussion, but may agree to physically meet, if deemed appropriate. The International Bureau agreed to provide secretarial support for such a meeting if it was held. The quality subgroup should have the following initial tasks:

(a) by the end of February 2010, the International Bureau should set up an electronic forum and each International Authority should nominate one main member and optionally additional members to participate in the subgroup;

(b) by the end of March 2010, the members of the subgroup should confirm whether the forum is suitable for discussion of quality issues and the International Bureau should test with each International Authority means for “virtual” meetings (such as “webinars”) to support interactive discussion sessions between some or all participants;

(c) by the end of July 2010, the subgroup should identify detailed information content requirements for an electronic quality feedback system to be developed (see paragraphs 30 to 35, below) which would both be likely to be used by designated Offices and be useful for assisting International Authorities in reviewing and improving the quality of their work (subject to any recommendations concerning this matter agreed upon by Member States in the third session of the PCT Working Group);

(d) by the end of September 2010, each International Authority should establish a report on their quality management system using the new templates agreed by the Meeting;

(e) by the end of December 2010, the subgroup should review the quality reports submitted by International Authorities and prepare a report for the next session of the Meeting, covering:

(i) effective processes and solutions for quality assurance; and

(ii) effective quality improvement measures.

Quality Feedback Systems

30. Discussions were based on document PCT/MIA/17/3.

31. The International Authorities all supported the principle of developing a system allowing effective quality feedback from designated Offices to International Authorities. One Authority noted that it had already implemented such a system locally, but that a single centralized system which could be used by any designated Office for any International Authority should be significantly more effective.

32. One Authority observed that such a system would aim to achieve two goals: to give feedback to improve the quality of future international reports, and to give additional information to designated Offices to improve the national phase processing of specific international applications.

33. The Authorities agreed that there were strong similarities to the requirements of a third party observation system and that it might be appropriate to use the same basic infrastructure, subject to the need to define exactly what types of information should be passed and the separation of information which was important to make available to all designated Offices (such as new citations found on a particular international application) from comments which it might be appropriate to retain as private feedback available only to the relevant International Authority.

34. Authorities also emphasized the need to ensure that the system did not represent a burden to examiners. It was likely that the best means for response in most cases would be to automatically forward or make reference to the content of a national phase search report without the need for examiners to make specific comment. No response should be expected to feedback on individual international applications, indeed some Authorities noted that under their law it would not be appropriate for examiners to respond to feedback on individual international applications. One Authority stated that such a system should be regarded as a tool for improving quality rather than as an attempt to evaluate quality.

35. The Meeting agreed that the International Bureau should continue to develop proposals for further consideration by the PCT Working Group and that the quality subgroup should consider the information content which would need to be passed by such a system (see paragraph 29(c), above)

SUPPLEMENTARY INTERNATIONAL SEARCH

36. The Secretariat stated that it had included an item related to the supplementary international search system on the agenda so as to get an update by the Authorities which already offered that service (the Nordic Patent Institute, the Federal Service for Intellectual Property of the Russian Federation (Rospatent), the Swedish Patent and Registration Office and, since January 1, 2010, the National Board of Patents and Registration of Finland) as well as an update by other Authorities on whether they intended to offer that service in the near future.

37. Those Authorities which already offered the supplementary international search service indicated that they had only received very few requests by applicants to date. User feedback suggested that the service was seen as being too expensive, that too few Offices with a wider range of languages offered the service to make it really attractive to users, and that the launch of the service had not been enough publicized. One Authority stated that, in all the 14 cases in which it had carried out a supplementary international search, mainly "A" citations had been found, noting that the supplementary search had been limited to Russian documents only.

38. The Austrian Patent Office stated that it intended to offer the supplementary international search service later in 2010.

39. The United States Patent and Trademark Office indicated that, due to workload considerations, it so far had considered it unlikely that it would be in a position to offer the service in the near future but that it now was considering offering the service through contractors.

40. The State Intellectual Property Office of the People's Republic of China stated that it considered offering the service in the near future but that it most likely would have to limit the number of such searches, due to resource and workload considerations.

41. The Brazilian National Institute of Industrial Property stated that it was preparing itself and considering offering the service as of 2011.

42. The European Patent Office stated that, as previously announced, it will offer the service as of July 1, 2010, limited to 700 searches in the first year. With regard to the workload related concerns expressed by other Authorities, it expressed the view that such concerns could be addressed by limiting the number of searches offered in a given year and encouraged all Authorities which to date hesitated to offer the service to do so in the near future to support the commitment shown by other Offices to make the system a success.

43. The Korean Intellectual Property Office stated that, due to the steep increase in the number of main searches carried out by it, it did not see itself in a position to offer the service in the next few years, contrary to what it had expected previously.

44. All other Authorities which took the floor on this matter stated that they had no plans of offering the service in the near future. One Authority recalled that the PCT Assembly had requested that a review of the service should be undertaken after 3 years from the commencement of operations and stated that it looked forward to that review, the results of which should be presented in 2011.

THE FUTURE OF THE PCT

45. In introducing item 5 of the agenda, the Secretariat recalled the background to the memoranda by the Director General on the “Future of the PCT”, which had formed the basis for discussions in the sixteenth session of the Meeting and the second session of the PCT Working Group, and the agreement by the Working Group at its second session that the relevant PCT bodies should continue their work to improve the PCT, noting that the PCT system can and should function more effectively, within the existing legal framework of the Treaty provisions, to deliver results which meet the needs of applicants, Offices and third parties in all Contracting States, without limiting the freedom of Contracting States to prescribe, interpret and apply substantive conditions of patentability and without seeking substantive patent law harmonization or harmonization of national search and examination procedures.

46. The Secretariat further noted that, since the last session of the Working Group, there had been significant advances towards some of the goals expressed in the Director General’s memoranda, most notably, the agreement by the Trilateral Offices (the European Patent Office, the Japan Patent Office and the United States Patent and Trademark Office) to begin pilot projects under which PCT work products will be used for the purposes of work sharing under the so-called bilateral Patent Prosecution Highway (PPH) arrangements.

47. One Authority stated that, in its view, the main challenge was to find an adequate balance between the need to set up a system as efficient as possible to enable in particular the bigger Offices which also acted as International Authorities to deal with workload and backlog issues, and the need for those Offices to “make an extra effort”, considering the PCT system as a whole and the potential benefits of their services to the entire membership of the PCT. Authorities needed to provide search and examination reports of a such a high quality so as to enable other Offices, notably smaller Offices with less examination capacity, to build up sufficient trust in those reports to allow them to exploit those reports in national phase procedures, in accordance with national laws and procedures, in a manner which resulted in real work sharing and less duplication of work.

48. Several Authorities stressed the importance of high quality international search and examination reports for setting up effective work sharing mechanisms based on PCT work products. In this context, one Authority reported on the PPH/PCT pilot project being carried out by the Trilateral Offices under which, upon the request of applicants, PCT work products could be used as a basis for requests for accelerated processing under the PPH work sharing scheme and expressed the hope that this pilot would be successful and lead to a full implementation of such a work sharing arrangement. One Authority reiterated its view that the goals for improving the use of the PCT should include: (i) the rapid resolution of rights; (ii) streamlining and simplifications; (iii) confidence building; and (iv) the elimination of duplication through effective work-sharing.

Report on Questionnaire on the Future Development of the PCT

49. The Secretariat recalled that the Working Group had agreed that the Secretariat should prepare a study on the future of the PCT, for consideration by the Working Group at its next session, which should outline the background of the need to improve the functioning of the PCT system, identify existing problems and challenges facing the PCT system, analyze the causes underlying the problems and identify possible options to address the problems and evaluate the impact of those proposed options, and that, in order to assist the Secretariat in the preparation of that study, it had sent out a Questionnaire in November 2009 (Circular C. PCT 1196), requesting information and views from Offices, Contracting States and other interested parties on the future of the PCT system. The Secretariat thanked all Offices which had provided feedback to the Questionnaire and summarized the responses received in reply to the Questionnaire as follows:

(a) Some 40 responses had so far been received from Offices in their various capacities under the PCT, half of which from developing countries, as well as 5 responses from other interested parties. Geographically, the responses represented a fairly representative sample of PCT Contracting States, except that only one response had been received from an African country and none from any least developed country.

(b) In reply to questions raised under the header “use of PCT reports to aid decision making in the national phase”, while a careful analysis still needed to be carried out, it would appear from the replies that, in general, almost all Offices found the international reports useful. However, this was qualified by comments stating that the usefulness varied according to which Authority had established the report and most Offices having the capacity to conduct their own searches in the national phase did so in all cases, at least to the extent of consulting their particular national databases.

(c) Suggestions for improving the usefulness of reports included (listed in no particular order): (i) providing hyperlinks to cited documents; (ii) providing more information about search strategies; (iii) giving better explanations of objections, notably concerning inventive step; (iv) more consistently observing the requirements of the Treaty in preparing the reports (notably, those relating to the mentioning of applications which constituted prior art under Article 33.1(v) for inventive step purposes); (v) identification of potential Rule 39 matter even if searched and examined; (vi) simplification of the presentation of reports; (vii) any designated Office should rely on its own reports established in its capacity as an International Authority; (viii) need to improve comments on the validity of priority claims; (ix) collaborative search and examination; and (x) more effective use of Chapter II to encourage dialogue and achieve a positive report as a basis for national phase processing.

(d) Other areas where the responses suggested that the PCT could assist in national processing of applications were: (i) sharing of national phase reports and status information; (ii) introduction of a third party observation system; (iii) further encouragement of XML filings, including the move to paragraph-based amendments; and (iv) indicating the filing dates of Rule 4.17 declarations.

(e) Responses to the questions raised under the header “backlogs and timing” confirmed that most (however, not all) medium sized and large Offices had significantly larger backlogs than 10 years ago, some by a factor of 2 or 3. Those Offices which did not report large backlogs were mostly those which belonged to the regional European patent system.

(f) Responses to the questions raised under the header “technical and legal information” suggested that Offices, by and large, were satisfied with most aspects of information provided under the PCT system. Some, however, expressed the desire for the provision of information in a wider range of languages, for national phase information to be made available from a wider range of States, to be updated more frequently, and for more use of electronic means for the transfer of documents to Offices, notably, of priority documents.

(g) Responses to the questions raised under the header “development and training” had revealed a desire for more technical cooperation, capacity building and training programs, including web-based programs, notably for Offices and users in developing and least developed countries, and for material to assist national Offices in providing national training to be available in a wide range of languages. Offices expressed the need to provided more assistance in technology transfer; specific suggestions included the identification of technology which had fallen into the public domain and providing licensing information. Other suggestions in this sector related to the introduction of differentiated fee structures, with lower fees for small and medium sized enterprises, universities and individual inventors, notably from developing and least developed countries.

(h) Finally, responses to the questions raised under the header “other issues” contained a wide range of suggestions, many fairly specific and often relating to electronic filing and processing systems.

Input into the Study on the Future of the PCT

50. Discussions were based on document PCT/MIA/17/4, setting out certain issues and possible options for which the Secretariat believed that it required further input from International Authorities before it could present, as part of the study on the future of the PCT, a useful commentary or set of proposals to the next session of the Working Group.

Making International Search and Preliminary Examination More Useful

51. Several Authorities expressed their support for giving adequate opportunity for dialogue in Chapter II proceedings by guaranteeing at least one (further) written opinion and opportunity to respond prior to the establishment of a negative international preliminary report on patentability. Some of those Authorities suggested that the Regulations should be amended accordingly, whereas others expressed the view that this should be left to the discretion of the Authority concerned, noting that, where the applicant had properly responded to the written opinion of the International Searching Authority, they would, as a general rule, issue a second written opinion and give a further opportunity to respond. Some Authorities noted that, already at present, they would establish a written opinion whether the applicant had responded to the opinion of the International Searching Authority or not.

52. Other Authorities stated that efforts to improve the overall system should focus on Chapter I procedures, notably improving the quality of international search reports, and so as to not undo the benefits which had been achieved when the written opinion by the International Searching Authority, which also served as the first written opinion by the International Preliminary Examining Authority, had been introduced into the PCT system some years ago.

53. Opinions on the idea of introducing top-up searches, whether as part of Chapter I (with the international search being delayed until after publication) or Chapter II, differed. With regard to top-up searches as part of Chapter I procedures, some Authorities believed that the objective of top-up searches might be most effectively addressed by delaying the international search until after international publication, as had been suggested in proposals submitted to earlier sessions of the Meeting and the Working Group by the Japan Patent Office and, as part of a proposal to introduce a three-track system, by the Korean Intellectual Property Office.

54. One Authority expressed the view that search and examination procedures during the international phase, while “preliminary” and “non-binding” on designated Offices, should be as complete as possible so as to enable those Offices which wished to exploit the international work products in the national phase to do so with full confidence in the quality of those products. If that meant that international search had to be delayed until after publication to allow for top-up searches to be carried out under Chapter I, it was in favor of such a delay.

55. Other Authorities expressed concerns about such a delay, noting that top-up searches would not be of the same importance for applications in all technical fields, and that the overall system would stand to lose more than it would gain from such a change. Two Authorities noted that, instead of top-up searches, the focus should be on the expedited creation of a common citation database. One Authority commented that searches would need to be conducted at least 24 months from the priority date in order to be confident that most of the relevant secret prior art had been published and made available in the search databases.

56. With regard to top-up searches as part of Chapter II procedures, one Authority reported on feedback it had received from users who had indicated no real interest in such top-up searches as part of Chapter II, whereas other Authorities supported the idea of top-up searches as part of Chapter II.

Collaborative Search and Examination

57. The European Patent Office presented the outline of a proposal to set up a small scale “pre-pilot” for testing the concept of collaborative search and examination under the PCT among a few Authorities willing to participate in such a pilot. The objectives of such pilot would be to define the conditions under which examiners in different International Authorities in different regions could co-produce international search reports and written opinions, and to evaluate the advantages and disadvantages of such system in terms of both quality and efficiency added to the system, notably, how Offices participating in the collaborative efforts would reuse the international work products during national phase proceedings. It was envisaged that the pilot would operate on a very low scale, on the basis of 12 applications per participating Office, involving 2 examiners of each Office in three big technical areas (mechanics, electricity/physics and chemistry), and that it would run for only several weeks. The results of the pilot would then be evaluated and reported back to other non-participating Authorities.

58. One Authority expressed concerns about the proposed pre-pilot, stating its general believe that each Authority should strive to produce the highest possible quality search and examination report with its own resources. The Authority further stated that it was not sure whether collaborative efforts in the PCT would indeed lead to improved quality work products for the national process, and noted that Authorities would no doubt encounter resource problems should such scheme be implemented on a full scale and used by many applicants. It suggested that trust and confidence building among Authorities should be achieved by focusing on other means and stated that it was not in a position to join the pre-pilot.

59. One Authority stated that, while it did not object to the pilot, collaborative search and examination would not be a priority for it and that it had no interest in joining the pilot at this stage. Another Authority expressed its full support for the pilot and expressed an interest in joining it. Yet another Authority reported on discussions on a regional project of a similar nature which had taken place among Offices in South America and, noting the difficult logistics, stated that, in order to be successful, any such project had to be supported by information technology.

Accessibility of International Search and Preliminary Examination

60. With regard to the proposed training on PCT and patents matters to be made available to certain countries, notably developing and least developed countries, one Authority stated that it would be interested in partnering with other Offices and the International Bureau to provide such training in the near future. It further stated that that, in the context of preparing the response to the questionnaire on the future of the PCT, it had been approached by patent agents who were willing to offer pro bono assistance in drafting and prosecuting patent applications filed by applicants from certain countries and suggested that the International Bureau should further investigate the possibility of setting up a centralized register of agents willing to offer such services.

61. Several Authorities stated that they favored the idea of fee reductions for certain entities, such as small and medium-sized enterprises. Another Authority stated that, in addition to considering reductions in fees due during the international phase, further consideration should be given by national Offices to provide national fee incentives for those applicants who had “worked” on their applications before national phase entry so as to correct any deficiencies found during the international phase, though it was observed that individual Offices needed to consider any reductions as part of their overall fee structure.

62. One Authority stated that, to date, it had been a matter for national Offices to set appropriate incentives in particular for small and medium sized enterprises to encourage use of the patent system, and that doing so on an international level required further consideration and study. With regard to the idea to allow applicants to choose from a greater range of Offices competent to act as an International Authority, the Authority expressed concerns about possible workload issues and ensuing competition among Authorities.

Third Party Observations

63. Discussions were based on document PCT/MIA/17/2.

64. All Authorities which took the floor on the matter supported the principle of a third party observation system under the PCT, considering that this was a practical and effective method of allowing improvements in the information on which designated Offices took their decisions on whether to grant patents in the national phase. Depending on the timing of the observations and the establishment of the relevant reports, it might also improve the quality of some international reports. One Authority considered that a well designed international system should be significantly more used than most national systems.

65. Comments on details of the proposal included the following:

(a) It was important to ensure that the system minimized the risk of burden on examiners, particularly due to excessive numbers of citations being submitted.

(b) Observations should be available to examiners responsible for any international search report, supplementary international search report, written opinion or international preliminary report on patentability which had not yet been established.

(c) The use of any observations should remain at the discretion of the (national or international) examiner in all cases.

(d) The system must be as accessible as possible to third parties: providing the interface in all PCT languages of publication should assist this.

(e) Systems for notifying observations to applicants and Offices would need to be carefully considered to avoid complicating procedures. It may be necessary to allow different options to be selected.

(f) The observations should be free for all designated Offices and International Authorities to use and be made available through PATENTSCOPE[®] in a way which is easy to use.

(g) It may be desirable to introduce a basic system and conduct a pilot for 1 year to identify issues and modes of use before introducing further developments or providing for a specific legal basis.

(h) Some International Authorities considered that observations should be permitted even after the beginning of the normal national phase. On the other hand, other Authorities considered that this might be detrimental to applicants since they should always have the opportunity (but not the obligation) to respond to comments, but late comments might be used as “harassment”. Furthermore, once the national phase had begun, the International Bureau might no longer know who the applicant was, since this would not necessarily be the same as during the international phase. In addition, there might be confusion if comments were possible by both a national and an international route at the same time.

(i) Some International Authorities considered that there would be no difficulty in accepting observations before international publication and that it might be useful to feed such observations into the international search report. Others stated that such an option would need careful consideration.

(j) While applicants should not be required to respond to observations simply because they have been made through the system, it should be clear that Offices can require any further information or comment as would be normal as part of their national processing.

(k) Most International Authorities agreed with the proposal that the third party observation system should be operated on an informal basis, though one Authority considered that the introduction of a specific legal basis might give greater clarity to applicants and third parties.

(l) While all International Authorities agreed that, for simplicity, there should be no fee for submission of observations initially, one Authority noted that it might be necessary to review this situation at a later stage depending on how the system was used.

(m) While anonymous observations should be permitted, it should equally be possible to give a name when submitting observations.

(n) The system should encourage the uploading of citations which might be difficult to obtain (including some patent citations which might not be readily available online): copyright issues would need to be considered, but would not be relevant in all cases and third parties might have the right to make the citations available in other cases.

(o) The 2000 character limit shown in the mock-up screen in Annex II of document PCT/MIA/17/2 might not be considered to be a “brief” explanation of a document’s relevance.

(p) Some Authorities considered that observations should be limited to novelty and inventive step since other issues varied too greatly between the national laws of Contracting States. On the other hand, it was observed that it would be difficult to prevent third parties from making comments on any subject in free text fields and that observations on any subject might be useful to an examiner.

(q) It may be desirable to allow a specific area for third parties to provide translations of relevant sections of a document.

(r) It would be important to record the date when an observation was made.

(s) In terms of feedback on observations from designated Offices, it was likely that the most efficient mechanism would be for Offices to make their national reports available so that other Offices could see which documents were actually cited.

66. The Meeting agreed that the International Bureau should continue to develop proposals for a third party observation system, to be presented to the next session of the PCT Working Group, based on document PCT/MIA/17/2 and the above comments.

Pilot Project on the Three-Track PCT System

67. Discussions were based on document PCT/MIA/17/10, containing a proposal by the Korean Intellectual Property Office for the launch of a pilot project of the so-called “three-track” PCT system.

68. Most Authorities, while generally welcoming the proposal as interesting and worth further study, expressed some concerns with regard to both the proposed accelerated international search as well as the proposed delayed international search.

69. Concerns expressed with regard to accelerating international search included the following:

(a) an entry hurdle (by way of charging a fee) would have to be set in order to only attract those applicants genuinely interested in accelerated search and to avoid too many international searches having priority over others, potentially compromising the quality and timeliness of other (non-accelerated) international searches;

(b) it was already possible under the present system to receive an international search report on a PCT first filing within a very short time limit (in some Authorities, as short as 3 months from the date of filing), an opportunity which, however, was rarely used by applicants; it was thus questionable whether there was indeed the need to formally change the system, further adding to the complexity of the PCT;

(c) delays which often prevented a quick establishment of the international search report were caused by the late receipt of search copies from receiving Offices; efforts should be made to speed up the transmission of search copies; questions were raised as to whether the International Bureau was capable of communicating the necessary documentation early, before publication, to national Offices where the applicant, following accelerated search, had entered the national phase early.

70. Concerns expressed with regard to the delaying international search included the following:

(a) delaying international search was seen as generally being in conflict with the agreed overall goal of rapid resolution of rights;

(b) delaying the establishment of the international search report to 24 to 26 months from the priority date had an impact on international preliminary examination and potentially national phase entry; one Authority, referring to its own similar proposal, suggested that the delay should not go beyond 21 or 22 months from the priority date;

(c) delaying the international search on request of the applicant was contrary to the obligations under Article 21 and Rule 42 to establish the international search report within 3 months from the date of receipt of the search copy and to (in normal circumstances) publish it together with the international application, and could not proceed, even if only for the purposes of a pilot study, without either (limited) suspension or amendment of the legal framework governing the establishment of the international search report and its publication.

71. The Korean Intellectual Property Office thanked all Authorities for the comments and indicated that it would further review its proposal, taking into account the comments received, with a view to possibly presenting it for discussion at the next session of the PCT Working Group.

INTRODUCTION OF A FORM FOR INFORMAL CLARIFICATION BEFORE SEARCH

72. Discussions were based on document PCT/MIA/17/6, containing a proposal by the Japan Patent Office to establish a form for informal clarification before carrying out the international search.

73. All Authorities which took the floor on the matter expressed support for the introduction of the proposed new ISA form, subject to the following comments and suggestions:

(a) the use of the form should not be mandatory but left to the discretion of each International Searching Authority;

(b) the need for the checkboxes relating to identity of the applicant (“identity checked”, “authorization checked” and “personally known”) should be reviewed, noting that the communications referred to would be initiated by the ISA examiner, not the applicant;

(c) a box should be added to allow for the indication of a time limit given to the applicant to reply to the informal communication;

(d) checkboxes should be added to indicate that a copy of the form had been communicated to the International Bureau and to the applicant; it was understood that a copy of the form would be made available to designated Offices via the International Bureau;

(e) a checkbox should be considered to cover the possibility that the clarification had taken place by e-mail, noting that this would be a convenient method of communicating with applicants in different time zones, though one Authority expressed concerns over the security of e-mail for discussion of unpublished applications.

74. One Authority stated that, while if fully supported the development of the new form, a similar new form would be required should the proposed third party observation system be implemented and suggested that both forms should be developed in an integrated manner.

75. The Meeting agreed that, as a next step, the Secretariat should, after further informal discussions with the Japan Patent Office and other Authorities concerned, further develop the proposed new form, taking into account the comments and suggestions received, and formally consult, by way of a PCT Circular, with all Member States and users of the system.

PREFERENTIAL TREATMENT FOR INTERNATIONAL APPLICATIONS RELATING TO "GREEN" TECHNOLOGIES

76. Discussions were based on document PCT/MIA/17/5.

77. Several Authorities reported on their experiences with national schemes under which preferential treatment was accorded, usually in the form of accelerated processing, to patent applications related to environmentally-friendly "green" technologies, with some Authorities noting that a substantial number of requests had been received. One Authority, however, stated that, while its scheme had been in force for almost 6 months, only 4 requests for accelerated processing had been received so far.

78. One Authority reported that it had developed a new parallel classification for environmentally relevant technologies, but that this had not been done with regard to accelerating the patenting process but rather with the aim to make it easier for the public to access information about so-called green patents.

79. All Authorities which took the floor on the matter expressed concerns about the difficulty to determine which applications indeed related to green technologies, noting the absence of an agreed definition. Most Offices relied on a certification or simple statement by the applicant that the application related to such green technologies, but urged caution as to the reliability of such certifications. One Authority stated that only 10% of applications in respect of which accelerated processing had been requested under its scheme had been found to indeed be related to such technologies. One Authority noted that some classifications in the IPC might be considered automatically to relate to green technologies.

80. In view of the absence of an agreed definition or standard, all Authorities which took the floor on the matter stated that they could not envisage a system under which fee reductions were granted to applications relating to particular kinds of technology simply on the basis of a certification by applicants that an application indeed related to such kind of technology. One Authority stated that there was no precedent for granting such a fee reduction for a particular class of applications, noting that, to its knowledge, no such reduction was offered by any Office for applications relating to, for example, public health or food security.

81. Equally, all Authorities which took the floor on the matter shared the concern, as raised in document PCT/MIA/17/5, that the scope under the PCT for accelerated processing of international applications was quite limited, noting the already tight time limits during the international phase. If at all, such acceleration could only be offered in the case of PCT first filings. One Authority stated that its users had indicated that they were not interested in accelerated processing of applications but in a better dialogue during Chapter II processing and exploitation of PCT work products during national phase processing.

82. Noting the absence of an agreed definition of what constituted "green" technologies and the concerns raised with regard to the reliability of self-certifications by applicants, all Authorities which took the floor on the matter also expressed concerns with regard to the idea to specifically indicate and/or draw attention to published international applications which claimed to relate to "green" technologies in order to facilitate licensing and commercialization. All Authorities which took the floor on the matter favored, however, the idea that the International Bureau should look into the possibility of making such licensing

information available in respect of any application, irrespective of the field of technology, for which applicant had made a request to that effect.

PARAGRAPH AMENDMENT OF PCT APPLICATIONS

83. Discussions were based on documents PCT/MIA/17/9 and 11.

84. In introducing document PCT/MIA/17/11, the European Patent Office stated that it was keen to reach agreement on an international standard for paragraph-based amendment of applications and representation of such amended applications in XML format, since it was on the point of implementing such a system for its regional applications and wished to ensure that this would be compatible with PCT and other applications which might be passed in XML format.

85. Several Authorities noted the importance of reaching a conclusion on appropriate standards quickly in order to provide satisfactory service for applicants filing international applications in XML format. The Authorities considered that the proposal for numbering of paragraphs described in paragraphs 10 to 14 appeared to be satisfactory for international phase processing, as far as this could be determined before agreement on the full details of the amendment process. Nevertheless, several Authorities pointed out that there were several aspects yet to resolve, covering both technical and legal issues.

86. Various Authorities emphasized the following points which need to be considered in completion of a standard for paragraph-based amendments:

(a) It is essential for designated Offices to be able to determine which paragraphs have been amended and for what reason so that they can, where necessary, be compared with the original text.

(b) Similar issues apply to amending all elements of an application body, such as tables, figures and equations, as well as to paragraphs.

(c) Specifying changes using "id" attributes of paragraphs could cause difficulties since these are not normally visible to applicants and there is no guarantee that applicants' software will not change such attributes, causing errors due to differences between the versions of the application held by the applicant and by any particular Office, even where the applicant has not actively made any changes.

(d) Offices would be interested in the availability of software components to assist implementation of standard form XML application body processing between Offices.

(e) The system proposed by the European Patent Office, under which all revisions of a document were contained within the XML package, was not consistent with current PCT practice.

(f) It would be necessary to ensure that the system could deal properly with all possible revision scenarios, including handling of amendments by the International Preliminary Examining Authority and rectifications by any International Authority, as well as changes handled by the International Bureau and receiving Office.

(g) It would only be essential for a paragraph-based amendment system to work for international applications filed in XML format, but it might be extended to cover other international applications where the applicant had provided paragraph numbering.

(h) The system needed to continue to allow page-based amendments for applicants and Offices which do not wish yet to use paragraph-based amendments.

(i) It would be necessary to update certain forms, most notably to allow for indication of changed paragraphs rather than pages in the basis of written opinions and international preliminary reports on patentability.

(j) Any changes to standards would require sufficient lead-time to allow implementation in the systems of affected national Offices.

87. In response to a question by one Authority, the Secretariat observed that the International Bureau was aware of the slight differences between the standards in Annex F of the PCT Administrative Instructions and WIPO Standard ST.36 and hoped to resolve these as far as possible in the coming year, as well as to suggest processes for considering changes simultaneously, where they affected both standards.

88. The Meeting agreed that the International Bureau should continue to prepare a proposal for paragraph-based amendment to international applications and representation of amended international applications in XML format on the basis of the proposal for paragraph numbering in paragraphs 10 to 14 of document PCT/MIA/17/9 and the proposals in PFR ST.36 2009/007, taking into account the questions in paragraph 16 of document PCT/MIA/17/9 and the issues noted in paragraph 86, above.

FUTURE WORK

89. The Secretariat noted that a draft study on issues related to the future of the PCT would be published in March, for informal discussion prior to establishing a final study in April for consideration by the PCT Working Group at its session to be held June 14 to 18, 2010.

90. One Authority commented that it would be desirable to recommence discussions on the use of color drawings in international applications.

91. As noted in paragraph 29, above, a quality subgroup would be set up to allow more in-depth discussion of quality issues. International Authorities would need to establish new reports on their quality management systems in accordance with the new templates by the end of September 2010 to allow the sub-group to discuss those reports and prepare a report for the next session of the Meeting.

92. The Secretariat reminded Authorities that the Assembly had recommended that Article 11 of the agreements between the International Authorities and the International Bureau should be amended, if possible with effect from July 2010.

93. The next session of the Meeting was expected to be held in Geneva in early 2011.

ANNEX

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