

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

Twenty-Second Session
Tokyo, February 4 to 6, 2015

APPOINTMENT OF INTERNATIONAL AUTHORITIES

Document prepared by the International Bureau

1. The quality subgroup has been requested to study the requirements which an Office should meet in order to perform international search and preliminary examination to the necessary level of quality, and make recommendations on how these requirements could be better expressed in the criteria for appointment. The Meeting is invited to review the progress and make recommendations for further work.

2. *The Meeting is invited to consider the report of the quality subgroup, and to recommend further work by the subgroup, the Meeting or the PCT Working Group, as appropriate.*

[Annex follows]

APPOINTMENT OF INTERNATIONAL AUTHORITIES
COPY OF PAPER PROVIDED TO THE QUALITY SUBGROUP

SUMMARY

1. The quality subgroup is invited to study the requirements which an Office should meet in order to perform international search and preliminary examination to the necessary level of quality, and make recommendations on how these requirements could be better expressed in the criteria for appointment.

BACKGROUND

PROCEDURES FOR APPOINTMENT

2. At its 46th 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 Prov.), 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. With regard to the criteria for appointment, the 21st session of the Meeting stated 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, the PCT Working Group endorsed this recommendation. The subject was 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 report of interventions can be found in paragraphs 119 to 177 of document PCT/WG/7/30.

ISSUES

6. The quality subgroup has begun to consider the issues involved and will continue its discussions during its meeting to be held February 2 and 3, 2015.

7. 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.

8. 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 (a more complete list of links to the relevant parts of reports of meetings and other comments is available in the pages for the associated task in the quality subgroup forum):

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

9. 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:

- (a) allow a good degree of certainty to candidate Offices as to the standards which need to be met;
- (b) allow the evaluation to be meaningful, but possible to conduct in a manner which is practical and acceptable to Offices and Contracting States;
- (c) 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;
- (d) 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.

10. The Subgroup is invited to study the requirements to perform international search and preliminary examination to the necessary level of quality and make recommendations on how these requirements should be better expressed in the appointment criteria for International Authorities.

[End of Annex and of document]