

C. PCT 1519

October 24, 2017

Madam,
Sir,

This Circular is addressed to your Office in its capacity as a receiving Office, International Searching Authority (ISA), International Preliminary Examining Authority and/or designated/elected Office under the Patent Cooperation Treaty (PCT).

Background

The Quality Subgroup of the Meeting of International Authorities under the PCT has discussed a draft application form for appointment as an International Searching and Preliminary Examining Authority through its electronic forum and at its sixth and seventh informal meetings in 2016 and 2017. The applications for appointment by the Turkish Patent Institute (document PCT/CTC/29/2) and the Intellectual Property Office of the Philippines (document PCT/CTC/30/2 Rev.), as well as many of the applications for extension of appointment considered at the thirtieth session of the PCT Committee for Technical Cooperation have been based on various drafts of this form.

At its seventh session, the Subgroup recommended that the International Bureau invite further comments on drafting issues, particularly with regard to explanatory notes concerning which parts of the Form should be considered mandatory, which parts should be optional, and what types of variations should be encouraged to take account of the particular circumstances of an Office and its reasons for application. The Subgroup also invited the International Bureau to prepare a proposal for consideration by the PCT Working Group

/...

and/or Committee for Technical Cooperation with a view to the form becoming an official part of the process of application for appointment (see paragraphs 60 to 65 of Annex II to document PCT/MIA/25/15).

However, at the tenth session of the PCT Working Group, the International Bureau observed that, while most of the applications presented to the PCT Committee for Technical Cooperation held that week had been based on the draft application form as a template, in fact there was considerable variation in scope and depth of the information provided. As such, the International Bureau indicated that it was “not yet able to recommend an ‘optimal’ format for an Office to submit its application for appointment or extension of appointment as an International Authority for consideration by the PCT/CTC or the PCT Assembly. Indeed, it seems clear that different information will be needed in certain cases, depending on the nature of the Office (for example, single national Office or intergovernmental organization), the size of the Office, the degree and visibility of previous involvement which the Office has had with the international patent system (and so, the extent to which its capabilities are already widely known) and on the motivation for the application (does the Office seek to provide services based largely on national interests, regional interests, language based interests or other factors?).” (see paragraph 6 of document PCT/WG/10/16).

./ The most recent draft of the application form, as considered by the Quality Subgroup in February 2017, is attached as an Annex to this Circular.

Issue

Offices are invited to comment on both the format and wording of the draft application form set out in the Annex to this Circular, and what further guidance for candidate ISAs should accompany it. These comments are invited to be submitted from the perspective of delegates to the PCT Committee for Technical Cooperation, who need to obtain and understand the information necessary to be in a position to give advice to the PCT Assembly on whether an Office should be appointed as an International Searching and Preliminary Examining Authority, or whether an existing appointment should be extended.

Comments are invited on any topics which may be relevant to this issue. However, the following questions may be of particular interest:

(a) *Types of information* – According to PCT Articles 16 and 32, meeting the minimum requirements should be a necessary, but not sufficient condition of appointment. For the purposes of a Committee member endeavoring to determine whether appointment should be recommended, is the type of information referred to in sections 3 and onward of the draft useful? If so, should the information in these sections be required, recommended or merely suggested? If not, would different types of information be more useful?

For this question, it should be understood that variations must in any case be permitted where the particular questions are not relevant to the application. For example, in the case of an intergovernmental organization, regional information might be more appropriate instead of national statistics. Another situation could be where an Office only intended to provide its services to applicants from other countries, in which case information concerning the target countries might be more appropriate instead.

(b) *Depth of information* – Are there particular sections where a high level of detail is required or others where only a very general indication of the relevant points should be recommended? In general, it would appear necessary to document internal processes to

/...

the extent necessary to give confidence that the Office possesses the necessary competencies and infrastructure to perform effectively. For example, it is necessary to indicate that IT systems are in place to cover all key areas effectively (search, production of reports and other forms, administrative processes, communications), but not to set out the detailed specifications of the system unless this is necessary to support a particular point within the application for appointment.

(c) *Differences between initial appointment and extension* – Is it appropriate to use the same form for extension of appointment as for an initial appointment?

The general background of existing Authorities should be well known to PCT Contracting States and it would seem more important to invite a statement or declaration as to their ongoing compliance with the minimum requirements and other performance targets than to expect an extensive new presentation of facts which should be well known, once every ten years. An application for extension of appointment might reasonably be simply a statement of the desire to continue in the role, an indication of the particular benefits which the Office sees itself as bringing to the system and reference to the documentation of its performance and compliance through ongoing processes such as the annual reports of quality management systems.

(d) *One-off versus ongoing assessment* – As a corollary to the suggestion that the process for extension of appointment might be better approached with a much reduced form compared to initial appointment, Article 16(3)(c) emphasizes that Offices must continue to meet the minimum requirements for the duration of their appointment. At present, International Authorities make annual reports on their quality management systems, which are made available initially for review by other Authorities and then published for inspection by any interested party. Would similar treatment be appropriate for other aspects of the minimum requirements, for example by extending the quality management reports to include information concerning numbers of examiners and breakdowns of skillsets?

Responses

Replies to this Circular should be returned by December 15, 2017, preferably by e-mail to the PCT Business Development Division (pct.bdd@wipo.int). Responses received will be presented to the Quality Subgroup of the Meeting of International Authorities under the PCT, with a view towards preparing a revised proposal for consideration by the PCT Working Group.

Yours sincerely,



John Sandage
Deputy Director General

Enclosure: Annex – Draft Application Form for Appointment as an International Searching and Preliminary Examining Authority under the PCT

DRAFT APPLICATION FORM

**APPLICATION FOR APPOINTMENT AS AN INTERNATIONAL SEARCHING
AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT**

[Only the questions in Sections 1 and 2 (concerning procedural issues and minimum requirements for appointment) are mandatory. The questions in the other sections are examples of the type of information which may be useful to allow members of the PCT Committee for Technical Cooperation to form a rounded view of the Office and its application and may be omitted, varied or supplemented according to the particular circumstances of the Office.]

1 – GENERAL

Name of Office or intergovernmental organization:

Date on which application for appointment was received by the Director General: *[to be filled in by the International Bureau – this may need to distinguish between the dates of a request to convene the PCT/CTC and the date on which this form and any accompanying material was received]*

Session of the Assembly at which appointment is to be sought:

Expected date at which operation as ISA/IPEA could commence:

Existing ISA/IPEA(s) assisting in assessment of extent to which criteria met:

2 – SUBSTANTIVE CRITERIA: MINIMUM REQUIREMENTS FOR APPOINTMENT

2.1 – SEARCH AND EXAMINATION CAPACITY

Rules 36.1(i) and 63.1(i): *The national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out searches and examinations.*

Employees qualified to carry out search and examination:

Technical field	Number (in full-time equivalent)	Average experience as examiners (years)	Breakdown of qualifications
Mechanical			
Electrical/electronic			
Chemistry			
Biotech			
<i>Total</i>			

[The above breakdown is intended to show the fields to which the examiners are currently assigned, even though some may be qualified also to work in others. Where the examiners are split between different Offices, subject to working arrangements other than direct employment, not all examiners expected to be made available for PCT work, or other special

arrangements apply, details should be provided as additional columns of the table or explanatory text below.]

Training Programs

[Give a summary of the training programs for new examiners and ongoing training activities for existing examiners, including typical times spent on training.]

Rules 36.1(ii) and 63.1(ii): That Office or organization must have in its possession, or have access to, at least the minimum documentation referred to in Rule 34, properly arranged for search purposes, on paper, in microform or stored on electronic media.

Access to the minimum documentation for search purposes:

Full access

Partial access (indicate areas currently missing and how you intend to obtain access to the missing areas)

Search systems:

[Indicate IT systems or paper collections used for search of different forms of prior art]

Rules 36.1(iii) and 63.1(iii): That Office or organization must have a staff which is capable of searching and examining the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated.

Language(s) in which national applications may be filed and processed:

Other languages in which large numbers of examiners are proficient:

Services available to assist search or understanding of prior art in other languages:

2.2 – QUALITY MANAGEMENT

Rules 36.1(iv) and 63.1(iv): That Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international search,

National quality management system: *[Please attach a QMS report according to the template used by International Authorities indicating the extent to which the national quality management system meets the requirements of Chapter 21 of the PCT International Search and Preliminary Examination Guidelines and, where relevant, the adjustments which have been planned to ensure that the system will meet the requirements for operation as an International Authority. Include information concerning whether the standard is externally reviewed in conformance with ISO 9001 or other international standard, and for how long the system has been in operation.]*

If applying as an international organization consisting of a group of national Offices, outline the arrangements to ensure appropriate distribution, and consistent timeliness and quality of reports:

3 – INTENDED SCOPE OF OPERATION

Language(s) in which services would be offered:

State(s) or receiving Office(s) for which Authority would offer to be competent:

Limitations on scope of operation:

4 – STATEMENT OF MOTIVATION

[Brief indication of reasons for applying, including what benefits the Office expects appointment to bring to: (i) its State or region, (ii) itself, and (iii) the PCT system as a whole.]

5 – APPLICANT STATE(S)

Regional location



[Map showing State(s) and neighboring States]

Regional organization memberships:

Population:

GDP *per capita*:

Estimated national R&D expenditure (% of GDP):

Number of research universities:

Summary of national patent information network (for example patent libraries, technology and innovation support centers):

Major local industries:

Major trading partner States:

Other key information: [for example summary of or link to national innovation strategies or regional development plans involving IP]

6 – PROFILE OF PATENT APPLICATIONS

Number of national applications received – by technical field

Year \ Technical Field	n-5	n-4	n-3	n-2	n-1
Mechanical					
Electrical/electronic					
Chemistry					
Biotech					
<i>Total</i>					

[Breakdowns need not be in the above form, but should give a general idea of the distribution of work within the Office and be compatible with the indication of fields of expertise of examiners, below. More detailed breakdowns such as using the 35 fields of technology in the WIPO IPC – Technology concordance table¹ could be considered. Brief explanations of methodology may be useful.]

Number of national applications received – by route

Year \ Route	n-5	n-4	n-3	n-2	n-1
National first filing/internal priority					
Paris priority					
PCT national phase entry					

Number of international applications received as RO

Year \ Technical Field	n-5	n-4	n-3	n-2	n-1
Mechanical					
Electrical/electronic					
Chemistry					
Biotech					
<i>Total</i>					

Main Offices/States in which priority is claimed from national applications:

[The questions below were moved from the section “Search and Examination Capacity” in the previous draft]

¹ http://www.wipo.int/ipstats/en/statistics/technology_concordance.html

Average time taken for national patent processing

Indicator	Measured from	Time (months)
To search		
To first examination		
To grant		

[Noting that national systems vary considerably in details such as when search and examination need to be requested, Offices frequently measure performance in different ways. The indicator should state whether it is measured from filing, priority, request for the relevant process or some other point. Where the national system includes routes with radically different effects (such as deferred examination), the indicators may be split into different categories.]

National backlogs

Measure	Number of applications
All pending applications	
Applications awaiting search (where relevant fees paid)	
Applications awaiting first examination (where relevant fees paid)	

7 – SUPPORT REQUIRED

[Give an indication of what assistance will be sought from the International Bureau or other Contracting States, for example to train examiners or to develop IT systems to deal with new Forms, communications and workflows.]

8 – OTHER

[Add any additional comments which are considered relevant to the application.]

9 – ASSESSMENT BY OTHER AUTHORITIES

[The application should ideally include assessments by the Authorities referred to in section 1, which could either be included as part of the form or else submitted separately.]

[End of Annex and of Circular]