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AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

Expectations of the PCT User Community for a Sustainable Patent System

Q. Todd Dickinson
Executive Director
AIPLA

Community for a Sustainable Patent System

- Greater use of the PCT by applicants to facilitate the benefits of the international patent system is a desirable goal if the operations of the ISA and IPEA are strengthened through increased emphasis on improvement of the timeliness and quality of their work.

Timeliness of Chapter I Search Reports, Chapter I Written Opinions and Chapter II IPRPs

- ISA and IPEA must complete ISR, Chapter I written opinions and Chapter II IPRPs within the time limits established by the PCT rules.
- If so, enable applicants to make appropriate decisions regarding whether to enter the national or regional phase of the PCT and to make amendments to the application.
- When not available prior to national or regional stage entry, certainty for applicants is lost and applicants are unable to make appropriate business decisions.

Quality of the Chapter I Search Reports, Chapter I Written Opinions and Chapter II IPRPs

- Concerted efforts must be made to adhere to the PCT search and examination guidelines established to ensure international searches are properly planned and executed; claims are correctly interpreted and the application of the industrial applicability, novelty and inventive step standards are uniformly and consistently made.
- Applicants as well as designated or elected offices need reliable work product from each ISA of uniform and consistent quality.
- www.wipo.int/export/sites/www/pct/en/texts/pdf/ispe.pdf

Leverage Earlier National or Regional Searches Performed in Priority or Foreign Counterpart Applications

- Where possible, earlier prior-art searches from corresponding national applications should be utilized by ISA to the maximum extent practicable.
- This will increase the quality of the search and examination while reducing duplication of effort.

International Searches Should Be as Comprehensive as National and Regional Searches

- The scope of the prior art search and how it is conducted for an international application should be comparable to that performed by an ISA when it searches its own national or regional applications.
- ISA should be encouraged to search beyond PCT minimum documentation utilizing its search tools and access to prior art databases of both patent and non-patent literature.

ISAs Should Collaborate in Development and Use of Common Search Systems and prior art Databases

- The ISA should collaborate in the development of comprehensive search systems and databases of the world's prior art and commonly use these resources to conduct comprehensive high-quality searches that can be relied upon by all PCT member states.
- The aim is to bring together a common set of relevant global collections of patent and non-patent literature to assist examiners in their prior art searches.
- Such common search system development should be linked with increased efforts to improve the international patent classification system as well as employing modern search engines using semantic search techniques in addition to natural language searches.

ISAs Should Collaborate in Development and Use of Common Search Systems and prior art Databases

- ISA should record and publish the search logic and queries used to search automated databases.
- Additionally, ISA should jointly develop enhanced machine translation capabilities technical dictionaries and thesauri to permit examiners who do not have language capabilities in the language of publication to perform more informed searches of such prior art.
- Common access to search and examination results should be provided through facilitation of electronic dossier access.

ISA Should Enhance Quality Management Systems (QMS) and Work Together to Achieve Uniform High-Quality Searches and Examinations of International Applications

- Further, each ISA should implement quality management systems consistent with the requirements of Chapter 21 of the PCT search and examination guidelines (PCT/GL/ISPE) and modeled on ISO 9001 standards.
- www.wipo.int/export/sites/www/pct/en/texts/pdf/ispe.pdf

Requirements of Chapter 21 of the PCT Search and Examination Guidelines

Each ISA and IPEA should show that it has established and is maintaining, or is establishing, a QMS which:

- sets out basic requirements regarding resources, administrative procedures, feedback and communication channels required to underpin search and examination (S&E);
- incorporates a quality assurance scheme for monitoring compliance with these basic requirements and with PCT/GL/ISPE.

Requirements of Chapter 21 of the PCT Search and Examination Guidelines

Provide information about the infrastructure in place which ensures the following:

- Adequate quantity of search and examination (S&E) staff, including:
 - means for matching the quantity of S&E staff to the inflow of work;
 - means for ensuring that recruited S&E staff have the necessary technical qualifications;
 - means for ensuring that S&E staff have language skills, or have access to supporting translation arrangements, as necessary to meet Rule 34.
- Adequate quantity and skills of administrative staff to support S&E.
- Provision of appropriate equipment and facilities to support S&E.
- Provision of the minimum documentation supporting S&E, as referred to in Rule 34.

Requirements of Chapter 21 of the PCT Search and Examination Guidelines

- Provision of up-to-date work manuals. These must include explanations of:
 - quality criteria and standards;
 - descriptions of work procedures;
 - instructions ensuring that the work procedures are adhered to.
- Provision of an effective training and development program for all staff involved in S&E, including means to ensure the acquisition and maintenance of the necessary experience, skills and familiarity with work manuals.
- Continuously monitoring and identifying resources, other than staff, required to deal with demand and comply with quality standards for S&E.

Requirements of Chapter 21 of the PCT Search and Examination Guidelines

Provide information on those administrative procedures and control mechanisms which ensure the following:

- Timeliness of S&E and related functions, to quality standards in accordance with PCT/GL/ISPE.
- Coping with fluctuations in demand and backlog management.

Requirements of Chapter 21 of the PCT Search and Examination Guidelines

Provide information on procedures which ensure that S&E reports of a quality standard in accordance with PCT/GL/ISPE are issued. In particular, provide information on:

- Activities related to verification, validation and monitoring; as carried out in order to assess compliance of S&E work with PCT/GL/ISPE.
- Processes for measuring, recording, monitoring and analyzing performance of the QMS to assess its conformity with the requirements of Chapter 21 and, if applicable, any other normative reference for the QMS.

Requirements of Chapter 21 of the PCT Search and Examination Guidelines

- Activities related to verifying the effectiveness of actions taken to deal with deficiencies, including:
 - those actions taken to eliminate, correct or authorize release of deficient S&E work which does not comply with the quality standards;
 - those actions taken to eliminate the causes of deficient S&E work and prevent the deficiencies from recurring.
- Activities ensuring the continuous improvement of established processes underpinning the issue of S&E reports.

Requirements of Chapter 21 of the PCT Search and Examination Guidelines

Give information on arrangements to:

- Provide feedback to staff informing them of results of verification, validation and monitoring carried out in order to assess compliance of S&E work, so that:
 - deficient S&E work is corrected;
 - corrective action, i.e. action necessary to prevent recurrence, is identified and implemented;
 - best practice is identified, disseminated and adopted.
- Accommodate prompt feedback from WIPO, designated and elected offices; so that potential systemic issues, e.g. recurring deficiencies of S&E work, as identified by these bodies, are evaluated and addressed.

Requirements of Chapter 21 of the PCT Search and Examination Guidelines

- Provide communication channels for dealing promptly with inquiries and enabling appropriate two-way communication between applicants and examiners.
- Provide concise and comprehensive guidance and information to users (particularly unrepresented applicants) on the S&E process using the website of your Authority, guidance literature, and other means.

Requirements of Chapter 21 of the PCT Search and Examination Guidelines

- Monitor and react to user needs and feedback, including:
 - measuring user satisfaction and perception;
 - handling complaints;
 - correcting deficiencies identified by users;
 - taking corrective action, i.e. action to eliminate the cause of deficiencies, in response to recurring or systematic deficiencies identified by users.
 - taking preventive action, i.e. action to eliminate the cause of potential deficiencies, in response to potential deficiencies or problems identified by users;
 - ensuring needs and legitimate expectations of users are met.

Requirements of Chapter 21 of the PCT Search and Examination Guidelines

The ISA and IPEA should show that arrangements are in place to ensure that:

- An internal review is carried out to determine:
 - the extent to which a QMS complying with the model of Chapter 21 has been established;
 - the extent to which the Authority complies with the requirements of its QMS;
 - the extent to which the Authority complies with PCT/GL/ISPE.
- The internal review demonstrates whether or not the requirements of the QMS and PCT/GL/ISPE are being applied consistently and effectively.
- The internal review takes place at least once a year.

Requirements of Chapter 21 of the PCT Search and Examination Guidelines

The ISA and IPEA may show that the following arrangements are in place and will be used for the purpose of internal review:

- Arrangements providing information on conformity of S&E work; i.e. information from activities related to verification, validation and monitoring, as carried out in order to assess compliance of S&E work with PCT/GL/ISPE [c.f. point (a) under “Quality Assurance” above].
- Arrangements providing information on the effectiveness, and the extent of implementation, of the QMS and its processes; whereby it can be established to which extent the QMS complies with the requirements of Chapter 21 and, if applicable, any other normative reference for the QMS.

Increasing Collaboration on Training, Training Tools and Examiner Exchange

- ISA should increase their collaboration on search and examination training including development and utilizing of common training tools and expansion of examiner exchange programs.

ISAs Should Commit to Performing Supplemental Searches for Applicants Beyond PCT Minimum Documentation

- ISA should support recent PCT rulemaking efforts to offer supplemental searches for applicants that go beyond the minimum PCT documentation requirements and leverage the language capabilities of examiners in the various ISA to locate the closest prior art applicable to international applications regardless of language of publication.

National or Regional Stage Processing of International Applications

- Designated or elected offices should give priority to examination of national or regional stage entries of international applications based on the international filing date of such applications rather than using the national or regional stage entry date for determining order of examination.
- Use of the PCT should be encouraged by PCT member states.
- In patent regimes based upon 20 patent terms that commence upon the filing of an international application, applicants are already penalized by the normal 30 month delay in entry of the national or regional stage.
- By further delaying the examination of the applications by putting them in examination queue based on the national or regional entry date applicants lose valuable patent term.

National or Regional Stage Processing of International Applications

- The PCT national or regional stage entry applications should be easier to examine than direct national or regional filings as a result of the work performed in the international stage, especially where applicants are able to obtain positive IPRP from ISA or IPEA.
- Use of the PCT can be one of the most effective forms of worksharing for designated or elected offices.
- The work of the ISA can be leveraged to advantage with further enhancements becoming available through use of prior search results by ISA as well as the potential of the supplemental search system.

Conclusion

- An enhanced PCT system for the 21st Century can provide substantial benefits to applicants and PCT member states.
- However, PCT must be enhanced to improve the timeliness and reliability of the work performed by ISA and IPEA
- Increased value of work performed in the international stage of the PCT can be achieved through collaborative measures taken to leverage technical cooperation among international authorities.

Conclusion

- We applaud the initiatives not being taken in the areas of PCT reform and those of the Quintilateral Offices through the launch of their 10 Foundation Projects
- We within the Patent User Community stand ready to work with the international search and examining authorities to improve the operation of the PCT system and the delivery of its potential benefits.

Thank you!

- If you have questions or comments regarding this presentation you can reach me at:

Q. Todd Dickinson
tdickinson@aipla.org

P: 703-415-0780

F: 703-415-0786