

## Patent Cooperation Treaty (PCT) Working Group

**Eighteenth Session**  
**Geneva, February 18 to 20, 2025**

### MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT OF THE THIRTY-FIRST SESSION

*Document prepared by the International Bureau*

1. The Annex to this document sets out the Summary by the Chair of the thirty-first session of the Meeting of International Authorities under the Patent Cooperation Treaty (PCT/MIA), held in Beijing on October 16 and 17, 2024. Annex II to this Summary by the Chair contains the Summary by the Chair of the fourteenth informal meeting of the PCT/MIA Quality Subgroup, which was held with a virtual part on September 25 to 26, 2024, and an in-person part in Beijing on October 15, 2024.

2. *The Working Group is invited to note the Summary by the Chair of the thirty-first session of the Meeting of International Authorities under the PCT (document PCT/MIA/31/11), reproduced in the Annex to this document.*

[Annex follows]

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

THIRTY-FIRST SESSION, BEIJING, OCTOBER 16 AND 17, 2024

### SUMMARY BY THE CHAIR

*(noted by the Meeting; reproduced from document PCT/MIA/31/11)*

### INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its thirty-first session in Beijing, China, on October 16 and 17, 2024.
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 China National Intellectual Property Administration (CNIPA), the European Patent Office, the Federal Service for Intellectual Property of the Russian Federation, the Finnish Patent and Registration Office, the Indian Patent Office, the Intellectual Property Office of the Philippines, the Intellectual Property Office of Singapore, IP Australia, the Japan Patent Office, the Korean Intellectual Property Office, the National Institute of Industrial Property of Chile, the Nordic Patent Institute, the Spanish Patent and Trademark Office, and the United States Patent and Trademark Office.
3. The list of participants is contained in Annex I to this document.

### AGENDA ITEM 1: OPENING OF THE SESSION

4. Ms. Lisa Jorgenson, Deputy Director General of WIPO welcomed the participants on behalf of the Director General of WIPO. Mr. Lu Pengqi, Deputy Commissioner of CNIPA, welcomed the participants on behalf of CNIPA.

### AGENDA ITEM 2: ELECTION OF A CHAIR

5. The session was chaired by Ms. Wang Tao, Deputy Director General of the Patent Examination Administration Department of CNIPA.

### AGENDA ITEM 3: ADOPTION OF THE AGENDA

6. The Meeting adopted the agenda as set out in document PCT/MIA/31/1 Prov. 2.

### AGENDA ITEM 4: PCT STATISTICS

7. The Meeting noted the presentation by the International Bureau on the most recent PCT statistics<sup>1</sup>.

### AGENDA ITEM 5: MATTERS ARISING FROM THE QUALITY SUBGROUP

8. The Meeting noted with approval the Summary by the Chair of the Quality Subgroup set out in Annex II to this document, agreed with the recommendations contained in that Summary and approved the continuation of the Subgroup’s mandate.

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<sup>1</sup> A copy of the presentation is available on the WIPO website at [https://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=637628](https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=637628).

## **AGENDA ITEM 6: CITATION OF NON-WRITTEN DISCLOSURES**

9. Discussions were based on document PCT/MIA/31/2.
10. All Authorities that took the floor considered that the international search report and written opinion forms did not require modification to implement the amendments to the PCT Regulations concerning the citation of non-written disclosures.
11. However, it was desirable to improve and harmonize practice in citing non-written disclosures of different types, as well as documents referring to them (category "O" documents) through modifications to the International Search and Preliminary Examination Guidelines.
12. One Authority agreed that the use of the term "document" in PCT Rule 43.5(a), as well as in Form PCT/ISA/210 and the definition of category "O" in WIPO Standard ST.14 and in Section 507(a) of the Administrative Instructions, was sufficiently broad to cover both written and non-written disclosures of a variety of natures. However, the references in Rules 33.1(b), 64.2 and 70.9 to "a written disclosure" referring to an oral or other non-written disclosure would not clearly give a basis for the use of non-written types of documents that might provide evidence of a prior art disclosure.
13. Authorities observed that it should be clear that it will not be necessary to cite a category "O" document simply because a non-written disclosure is to be cited. The non-written disclosures may be cited in their own right when they are recorded in a suitable format. The category "O" document should be included only when this would provide useful additional information concerning the prior art disclosure.
14. Concerns remained over copyright and other issues around maintaining a record of non-written (typically video) disclosures. It was recalled that International Authorities can already save copies of PDF documents in ePCT for the benefit of applicants and designated Offices where this is compatible with their conditions of use of prior art documents. However, there did not appear to be value at present in extending the scope of this system or developing other plans for a centralized repository for such documents. In the meantime, Authorities should maintain and develop their existing processes and provide copies under Rule 44.3 where needed. Authorities nevertheless noted that some Offices already had procedures for recording non-written content and indicated a wish to share best practices.
15. The Meeting agreed that:
  - (a) no modifications to the international search report and written opinion forms would be required to implement the amendments to the PCT Regulations concerning the citation of non-written disclosures;
  - (b) the PCT International Search and Preliminary Examination Guidelines should be modified and that detailed proposals should be discussed through the Quality Subgroup electronic forum as set out in paragraph 11 of document PCT/MIA/31/2;
  - (c) consideration should continue of the issues related to storage of non-written disclosures; and
  - (d) the International Bureau should work with interested International Authorities on possible further amendments to the PCT Regulations concerning the use of category "O" documents.

## **AGENDA ITEM 7: PCT TEXT PROCESSING TASK FORCE**

16. Discussions were based on document PCT/MIA/31/4.

17. All Authorities that took the floor agreed in general terms with the vision set out in the document, but noted the importance of ensuring that steps were taken at an appropriate rate and with adequate support so as not to introduce costly burdens for national Offices with limited IT development capacity or not yet permitting or working on full text processing in their national capacity. One Authority found the tools built into ePCT to be very useful and offered assistance to other Authorities in making effective use of them. Mandatory use of full text processes could not be envisaged in the near future. It was important to strengthen collaboration between the International Bureau and national Offices. A circular to help identify existing capacities and needs might be useful.

18. Full text processing should permit significantly more efficient search and examination, eliminating the risk of errors introduced by OCR processes. However, conversion processes had a variety of difficulties and it was essential to ensure that conversion to XML did not lose substantive content or meaning from documents. Concern was expressed at the practicality of converting PDF documents to an XML format. The ability to file and process color drawings was a particularly important objective. One Authority expressed the importance of the direct recognition of DOCX as an official file format for use within the PCT System. The International Bureau agreed in principle but recalled the difficulty in some cases of determining what was represented by a DOCX file, noting that in some cases two users might open the same DOCX file at the same time but see significantly different things.

19. The Meeting noted the contents of document PCT/MIA/31/4.

#### **AGENDA ITEM 8: MERGING INTERNATIONAL SEARCH REPORT AND WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY**

20. Discussions were based on document PCT/MIA/31/7.

21. International Authorities generally considered that merging the international search report and the written opinion of the International Searching Authority was not a priority, noting the significant implementation costs. In particular, some Authorities expressed the concern that there were at present limited clear benefits associated with the merging of the two forms. One Authority considered that the costs would clearly outweigh the benefits. Other Authorities pointed out that such a change would be very disruptive for users of the PCT System. Some Authorities, however, supported further work on a more detailed study on this matter. Some Authorities showed interest in identifying specific areas of improvement for the international search report and the written opinion.

22. Authorities were open to further investigating the related proposal of ceasing to include the international search report into the international publication itself, but it was noted that legal changes would be required for this proposal, and full consideration should be given to the impact of such a change on patent information users and national patent publication procedures similar to the PCT.

23. The International Bureau observed that it was not opposed to merging the international search report and the written opinion of the International Searching Authority as long as it was carefully considered and that Authorities were ready to fully support the implementation work. A decision on whether or not to pursue this proposal was important mainly to be able to take informed decisions on whether it was useful to pursue alternative ways of mitigating perceived problems. Regarding the proposal to stop including the international search report as a part of the international publication, the International Bureau observed that the proposal reflected the way that patent information was now accessed. For most users, the international search report would be easily available and more conveniently used as a separate document. However, it would be important to seek feedback from affected user groups before agreeing such a change.

24. The Meeting noted the contents of document PCT/MIA/31/7.

## **AGENDA ITEM 9: IMPROVEMENT OF INTERNATIONAL SEARCH REPORT AND WRITTEN OPINION**

### **(A) PROPOSED MODIFICATIONS REGARDING BOXES VII AND VIII OF PCT/ISA/237**

25. Discussions were based on document PCT/MIA/31/9.

26. International Authorities thanked CNIPA for the efforts to clarify the differences between Boxes VII and VIII of the written opinion of the International Searching Authority. This had long since been a point of confusion for examiners and applicants. While one Authority considered that new checkboxes would be the most effective solution, most Authorities were concerned at the costs involved in updating the written opinion by introducing checkboxes. Adding new checkboxes would involve a major change to IT systems, including a revision of the associated DTD. Furthermore, some of the boxes might cause confusion because they reflected practices that were handled by some Authorities in different ways, notably around the issue of multiple dependent claims.

27. Most Authorities preferred to address the issue through means that did not require the use of modifying the Form. Possible options might include checklists for examiners, modifications to the PCT International Search and Preliminary Examination Guidelines and standardized clauses as proposed in Option II of the document. One Authority noted that clauses had already been developed for Box VIII, but was open both to developing clauses for Box VII and modifying or extending the range of clauses for Box VIII. It might also be desirable, where practical, to include hints for examiners in the tools used for preparing the written opinion.

28. The Meeting invited International Authorities to continue discussion on the Quality Subgroup electronic forum of options to clarify the use of Boxes VII and VIII of the written opinion.

### **(B) PROPOSED MODIFICATIONS REGARDING BOX IV OF PCT/ISA/237 AND PCT/IPEA/409 AND GUIDELINES ON LACK OF UNITY OF INVENTION**

29. Discussions were based on document PCT/MIA/31/10.

30. Most Authorities considered it desirable to clarify the information provided in Box IV of Forms PCT/ISA/237 and PCT/IPEA/409 concerning lack of unity of invention, though some expressed concern over the costs involved in updating IT systems and would prefer to seek solutions through modifications to the *PCT Applicant's Guide* and the PCT International Search and Preliminary Examination Guidelines based on the new item (vii) in paragraph 17.39 proposed in Annex III of the document. In some cases, it might be possible to make clarifications with smaller changes, such as where a protest had been made and no lack of unity was eventually found, from which it could be deduced that the protest had been successful.

31. Some Authorities noted that it might be desirable to address clarifications of a similar nature to other boxes as well and that consequential changes would be required in references to renamed boxes. Boxes III and IV might include complex issues in the case of international preliminary examination where the international search had been limited due to a lack of unity of invention.

32. The International Bureau drew a distinction between this and the previous set of proposals in that the aim was to clarify the content for the benefit of the reader of the document, rather than the examiner preparing it. It also noted that costs of IT development would vary considerably depending on the nature of the particular Office's systems. For the International Bureau, proposals dealing with pure text changes that did not fundamentally change the meaning of checkboxes could be implemented quickly and easily. However, even if the changes were so limited, it was highly desirable to complete any reviews of other parts of the

forms so as to implement changes at the same time. Otherwise, version control could become complex and introduce costs and risks related to translation of reports, especially in the case of those reports where the original content was not delivered in XML format that included the relevant version information.

33. The Meeting invited International Authorities to continue discussion on the Quality Subgroup electronic forum of options to clarify the content of Box IV of Forms PCT/ISA/237 and PCT/IPEA/409, taking into account the modifications to the PCT International Search and Preliminary Examination Guidelines proposed in the document as well as any similar issues identified in other parts of the relevant Forms.

#### **AGENDA ITEM 10: EXTENSION OF APPOINTMENT OF INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES**

34. Discussions were based on document PCT/MIA/31/8.

35. Authorities supported the proposed timeline for extension of appointment. Some Authorities added that a decision on the extensions by the PCT Assembly in July 2026 would provide nearly 18 months for completion of relevant national ratification procedures for the new agreements between their Authorities and the International Bureau before the expiration of the present agreements at the end of December 2027. This timeline contrasted with the arrangements in 2017 when the previous extensions only allowed for three months to ratify and sign new agreements.

36. Authorities supported the proposed outline of the format of the application for extension of appointment to be submitted to the PCT Committee for Technical Cooperation proposed in the document, and agreed to further discussions on the PCT/MIA Quality Subgroup electronic forum to finalize the format of the applications that would be proposed to the PCT Working Group at its next session from February 17 to 20, 2025.

37. The Meeting agreed to submit the timetable for the extension of appointment proposed in the document for consideration by the PCT Working Group at its next session from February 17 to 20, 2025. The Meeting also agreed to submit a proposed format for applications that International Searching and Preliminary Examining Authorities would be required to submit to the PCT Committee for Technical Cooperation for advice on their extensions of appointment based on the proposals in the document and further discussions on the PCT/MIA Quality Subgroup electronic forum.

#### **AGENDA ITEM 11: MODEL AGREEMENT BETWEEN AN OFFICE OR ORGANIZATION AND THE INTERNATIONAL BUREAU IN RELATION TO ITS FUNCTIONING AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY**

38. Discussions were based on document PCT/MIA/31/3.

39. Authorities supported the streamlined format of the draft model agreement proposed in the document and the draft amendments to the PCT Regulations required to support the format. Some Authorities underlined that this would facilitate making updates on operational matters and would avoid duplication of information in the present Annexes to the agreements with the *PCT Applicant's Guide*. One Authority underlined that it was important for the content of the present Annexes to be published in the PCT Gazette for legal purposes and the correct information to be available through the *PCT Applicant's Guide*. With regard to Article 10 of the draft Agreement, two Authorities proposed to bring the latest date to start negotiations forward by one year to July 2035. Another Authority, while supporting the new consistent format across all Authorities, indicated that it would require flexibility in certain wording. The International Bureau observed that all Authorities were expected to undertake the same roles and had the same basic obligations, and so variations should be as few as possible and objectively justified.

40. The Meeting agreed that the International Bureau should submit the draft model agreement in Annex I to the document for consideration by the PCT Working Group at its next session from February 17 to 20, 2025, taking into account the comments made during the session and any other drafting matters brought to the attention of the International Bureau.

#### **AGENDA ITEM 12: PCT MINIMUM DOCUMENTATION TASK FORCE: STATUS REPORT**

41. Discussions were based on document PCT/MIA/31/6.

42. One Authority recalled that Committee on WIPO Standards (CWS), at its twelfth session from September 16 to 19, 2024, had approved the creation of the Authority File Task Force to encourage IP offices to provide their patent authority file in compliance with WIPO Standard ST.37 by providing technical support and training, and undertake any necessary revisions and updates to ST.37 (see paragraphs 76 to 78 of the Summary by the Chair of the twelfth session of the CWS, document CWS/12/28). The International Bureau encouraged Authorities to take into account future modifications to ST.37 that would be likely when preparing to meet the requirements from January 1, 2026, for the PCT minimum documentation as well as to take all possible steps to ensure that their patent documentation is available to other Authorities in effective formats prior to that date.

43. The Meeting noted the contents of document PCT/MIA/31/6.

#### **AGENDA ITEM 13: SEQUENCE LISTINGS TASK FORCE: STATUS REPORT**

44. Discussions were based on document PCT/MIA/31/5.

45. The European Patent Office announced that WIPO Sequence Validator version 3.0.0 had been released on October 3, 2024, and a new version of WIPO Sequence would be available soon.

46. The International Bureau observed that possible improvements related to the processing of sequence listings might be proposed at the next session of the PCT Working Group, although this possibility had to be assessed and confirmed later. It was noted that the Sequence Listings Task Force was the appropriate body for some areas of work. The International Bureau pointed out that WIPO Sequence was a success and was the only tool used reliably by applicants in PCT Contracting States, and quite likely in other States too. The International Bureau hoped that the new version of WIPO Sequence Validator would offer significantly improved performance and would be integrated into the ePCT system.

47. The Meeting noted the contents of document PCT/MIA/31/5.

#### **AGENDA ITEM 14: FURTHER WORK**

48. Authorities indicated that they considered the in-person session of the Meeting to have been useful and that the combination of remote and in-person parts of the Quality Subgroup with a period between the two for further development of work had been beneficial for certain items. This would be a desirable approach in the future, but did not necessarily need to extend to all agenda items. One Authority expressed approval that all Authorities participating in the remote and in-person parts had been able to work on an equal footing, which was typically not the case for hybrid meetings.

49. The Meeting noted that the next session would likely be convened around the same time in 2025.

**AGENDA ITEM 15: SUMMARY BY THE CHAIR**

50. The Meeting noted this summary by the Chair.

**AGENDA ITEM 16: CLOSING OF THE SESSION**

51. The Meeting closed on October 17, 2024.

[Annex I to document PCT/MIA/31/11, containing a list of participants is not reproduced here]

[Annex II (to document  
PCT/MIA/31/11) follows]

ANNEX II (to document PCT/MIA/31/11)

PCT/MIA QUALITY SUBGROUP, FOURTEENTH INFORMAL MEETING  
GENEVA, SEPTEMBER 25 AND 26, 2024 (VIRTUAL)  
AND BEIJING, OCTOBER 15, 2024

## SUMMARY BY THE CHAIR

1. Mr. Michael Richardson, Director, PCT Business Development Division World Intellectual Property Organization (WIPO) welcomed participants to the meeting on behalf of the Director General of WIPO, Mr. Daren Tang.
2. The China National Intellectual Property Administration (CNIPA) expressed its appreciation for the opportunity to host the in-person sessions of the Meeting of International Authorities (MIA) under the PCT and the Quality Subgroup (QSG).

### 1. QUALITY MANAGEMENT SYSTEMS

#### (A) REPORTS ON QUALITY MANAGEMENT SYSTEMS UNDER CHAPTER 21 OF THE PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

3. Authorities thanked the International Bureau for reviewing the QMS reports and emphasized that the reports were useful in learning from other Authorities and reviewing their own actions in quality management.
4. The Subgroup agreed that the quality reports should be published and recommended to continue reporting on quality management systems using the present reporting mechanism.

#### (B) PRESENTATIONS ON ASPECTS OF QUALITY MANAGEMENT SYSTEMS FROM INTERNATIONAL AUTHORITIES

5. The European Patent Office (EPO) delivered a presentation on the EPO Quality Dashboard that has been made available to the public, and MyEPO online services to facilitate collaboration between applicants and their representatives and examiners<sup>2</sup>. Both initiatives were part of the EPO Quality Action Plan for 2024 with the objective to achieve excellence in quality. MyEPO provided a suite of online services including Online Filing 2.0, the MyEPO Portal and Central Fee Payment, covering European patents, the Unitary Patent and the PCT. Since the shared area in the MyEPO Portal for real-time interaction between examiners and representatives was a new service that provided an informal exchange like a telephone conversation, feedback from examiners was not yet available.
6. The Federal Service for Intellectual Property (ROSPATENT) presented its quality management system (QMS) and the scope of ISO 9001 certification. The quality policy, objectives and quality control mechanisms were presented with the goal of continuous development and improvement of the processes and quality of search and examination. This was the beginning of a process in relation to the certification that had required changes and considerations, and more work and developments were expected having attained the certification.

#### (C) FEEDBACK FROM PAIRED REVIEW AND SMALL GROUP DISCUSSIONS OF QUALITY MANAGEMENT SYSTEMS OF INTERNATIONAL AUTHORITIES

7. Authorities that had participated in the bilateral paired review sessions had found the sessions to be beneficial and recommended that other Authorities should participate in future

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<sup>2</sup> A copy of the presentation is available on the WIPO website at:  
[https://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=636833](https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=636833).

sessions. The paired review sessions allowed Authorities to learn more about quality management and operational issues in other Authorities and exchange views in an informal setting. More participation would also allow Authorities to discuss quality management with Authorities that they had not been paired with before. Authorities preferred the format of a single bi-directional session discussing the Quality Management Systems (QMS) of both Authorities to having two sessions, one as a reviewing Authority and the other as an Authority whose QMS was being reviewed, as had taken place at previous Quality Subgroup meetings. For planning their sessions, Authorities had shared questions and agreed topics of discussion with their paired Authority, which had helped prepare responses and discussions during the session. In terms of the timing, Authorities considered it may be desirable to hold the paired reviews a longer time before the sessions of the Quality Subgroup. This would give greater flexibility in arranging the discussions and more opportunity for consideration of whether any issues discussed should be raised in the Subgroup. A reminder of the invitation to participate might already be included in the Circular inviting the annual reports of quality management systems.

8. The Authorities participating in the paired review sessions appreciated the small group discussion sessions and thanked the Authorities that had led the sessions for their preparations and enabling fruitful discussions. The format of a lead Office for each small group session was considered important for providing a basis for exploring the subject. The sessions had covered the Use of Statistics in Patent Quality, Examiner Training, and Implications of Artificial Intelligence (AI) on the Operations of International Searching and Preliminary Examining Authorities<sup>3</sup>. The Israel Patent Office that had led the session covering AI proposed that practices could be shared between Authorities to advance discussions on the subject. Other Authorities attending this session had found the sharing of information on AI search systems and discussions on potential use cases in the future to be helpful, as well as the highlighting of technical challenges and ethical considerations. Authorities were open to consider holding small group sessions at other points during the year to enable more topics to be discussed and keep discussions active at times other than the Quality Subgroup meeting, including the possibility of in-person sessions when the relevant experts were attending other WIPO meetings, which could make the exchange of information easier. Participation could be de-linked from the paired review sessions and other ways could be sought to maintain the more dynamic discussions that had taken place in the small groups.

9. The International Bureau proposed a future format for the paired review and small group discussion sessions considering the comments from International Authorities. International Authorities would be invited to participate in the paired review and small group discussion sessions at the same time as the Circular requesting reports from International Authorities on their Quality Management Systems but could request further small group discussions during the year. For the paired review, Authorities would be paired to allow the possibility to exchange informally during the PCT Working Group, with sessions taking place around March each year to allow for follow-up during the remainder of the year, either bilaterally or by proposing topics for small group discussions or the Quality Subgroup. For the small group discussion sessions, Authorities would propose topics and indicate a preference for virtual or in-person discussions, which could, for example, take place at the same time as the PCT Working Group.

10. Authorities broadly supported the proposed future format and timing but noted the practical difficulties of quality experts meeting in person, noting that not many of them would attend the PCT Working Group. Instead, in-person small group discussions could take place as breakout sessions during an in-person Quality Subgroup meeting.

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<sup>3</sup> A copy of the presentation in the session on AI is available on the WIPO website at: [https://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=636825](https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=636825).

11. The Subgroup recommended that the International Bureau invite International Authorities to participate in the paired review sessions when requesting the annual reports on their Quality Management Systems. The International Bureau would pair Authorities in time for informal bilateral discussions during the PCT Working Group. Paired review sessions would take place between Authorities shortly after the PCT Working Group to allow the possibility to provide feedback on the sessions and suggest issues that could be followed up in small group sessions or the Quality Subgroup meeting.

12. The Subgroup recommended that the International Bureau invite International Authorities to participate in small group discussions and propose topics and Authorities to lead a discussion when requesting the annual reports on their Quality Management Systems. Authorities could, however, propose any small group discussion sessions at any time during the year. Participation in small group sessions would be open to all International Authorities, but each session would only involve a few Authorities, and several sessions could take place on the same topic. When proposing discussion topics, Authorities would indicate a preference for in-person discussions or virtual sessions, and any preferred timing, noting that in-person discussions involving the relevant experts may be limited to an in-person meeting of the Quality Subgroup or the margins of the PCT Working Group.

## **2. BETTER UNDERSTANDING OF WORK OF OTHER OFFICES**

### **(A) STANDARDIZED CLAUSES**

13. The Canadian Intellectual Property Office (CIPO) provided an update on the proposed clauses for unity of invention based on the “minimum reasoning” methodology set out in paragraph 10.04A of the International Search and Preliminary Examination Guidelines (“the Guidelines”). CIPO had posted a set of proposed clauses on the Quality Subgroup wiki following feedback on an earlier set of clauses. Examiners would be required to add detailed explanations to support the statements provided in the clauses. As there were many ways to argue non-unity of invention depending on the subject matter and different practices at International Authorities, the proposed clauses could not cover every possible situation. Authorities were free to add specific detailed clauses for other situations they encountered frequently, or where they had language preferences. While CIPO had developed the clauses based on the language provided in the examples in Chapter 10 of the Guidelines, the language used in these examples was not consistent, so the proposed clauses did not necessarily match with each of the examples. CIPO proposed that the language in the examples could be revisited after adoption of the clauses, when the examples could be redrafted if needed.

14. Authorities supported the principle of introducing standardized clauses for unity of invention and agreed that the drafting of the proposed clauses was close to finalization. Authorities nonetheless acknowledged that examiners had discretion on how to use the clauses in each case and could use different wording as the situation demanded, and one Authority stated that it provided its own standardized clauses.

15. While some Authorities could consider possible revisions of the examples in Chapter 10 of the Guidelines after finalization of the clauses, one Authority did not see the need to revisit the wording of the examples, since the variations helpfully reflected the fact that there were different ways to address unity of invention in international applications within the scope of the agreed methodology.

16. The Subgroup approved in principle a set of standardized clauses, subject to any final comments on drafting, to be submitted to the electronic forum by the end of October 2024. The Subgroup considered that there was no general need to revise the examples in Chapter 10 of the Guidelines, noting that some minor variations in terminology were useful to demonstrate the flexibility available within the minimum reasoning. However, it was open to any International Authority to propose changes to examples if there were considered to be a specific problem.

#### (B) ALTERNATIVE PRACTICES IN THE INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

17. International Authorities thanked the International Bureau for collecting and sharing information on the wiki about the use of alternative practices by different Authorities, which was found to be useful. One Authority mentioned that the results may influence their practices, and they would explore the possibility to adopt other practices from other Authorities. On the issue of how to publish the alternative practices, Authorities broadly supported the option based on a compiled table of practices on the WIPO website with hyperlinks to the relevant parts of the practice guidelines of International Authorities, with the table being linked to from the International Search and Preliminary Examination Guidelines. This option offered flexibility to make updates, was easy to maintain in the long run and was a practical choice because all the relevant data would be available in a single location. One Authority stated that the webpage for this publication should contain three separate tables corresponding to the Annex to Circular C. PCT 1669 since the questions were different. Another Authority suggested reviewing the information in the tables before publication as some information was more relevant to applicants than others, for example, information on what subject matter is the subject of international search was important for applicants in selecting an International Searching Authority, while the practices in inviting the applicant to introduce references to background art would be less relevant to choosing an International Preliminary Examining Authority. The International Bureau observed that it was desirable to maintain all the relevant information in a single location. Improvements in the systems underpinning the *PCT Applicant's Guide*, International Search and Preliminary Examination Guidelines and similar texts may offer new options in the future, but for the moment it would be preferable, if possible, to keep all information on a single page and adapt the presentation to allow it to be used efficiently by different audiences.

18. Regarding the removal of unused alternatives in the International Search and Preliminary Examination Guidelines, Authorities emphasized the importance of checking that no Authority followed a practice before it could be removed. So far, 23 out of 24 Authorities had responded to the Circular, and it was noticed that no alternative practices were being followed by all Authorities.

19. Authorities expressed the need for a continuous maintenance of the compiled alternatives, so as to keep the data stored therein up to date. Also, some Authorities observed that they would need more time to review the content of the compiled table and check which portions of the table should be publicly accessible, and keep the other parts only accessible to certain user groups.

20. The Subgroup recommended further work towards publication of the compiled alternatives as a page on the WIPO website, considering the comments from Authorities. The Subgroup also recommended the International Bureau to seek the outstanding information on alternative practices requested in Circular C. PCT 1669 to have information on the alternatives followed at all Authorities, noting the need for a complete picture of the different practices before removing any alternatives. The Subgroup recommended the International Bureau to invite the Authorities to provide on a regular basis an update to review practices, for instance via the annual Circular inviting submission of Quality Management System reports and would encourage the Authorities to proactively share any change in the alternative practices at any time with the International Bureau. The

Subgroup recommended that a mock-up version of the results table be shared with the Authorities via the electronic forum before deciding on a specific format for the publication of the table.

### (C) INTERNATIONAL SEARCH REPORT FEEDBACK PILOT

21. The representative of the Canadian Intellectual Property Office introduced a report by the United Kingdom Intellectual Property Office (UKIPO) on the progress of the latest phase of the international search report feedback pilot, which was now running between the UKIPO and five other Offices who are all International Searching Authorities. Each Office as designated Office provided feedback on a given number of international search reports established by other Offices in their role as International Searching Authority which had formed the basis of a national phase examination. The current phase of the pilot was coming to a close. All Offices had the impression that the pilot had been useful, but that improvements would be desirable for any future phases. Certain feedback on the international search report had been identified to be more useful than other feedback, and some International Searching Authorities had highlighted additional feedback not provided in the pilot that would be desirable for the designated Office to provide in future phases of the pilot. The participating Offices intended to review the results more fully in the near future and to consider possible next steps. Other International Authorities interested in participating in a future pilot were encouraged to contact the UKIPO.

22. Authorities that had participated in the pilot confirmed the views set out in the report. Some issues particularly highlighted included:

- (a) A big problem with utility was the length of time between the international search report being established and feedback being received, but it was difficult to see how to address this effectively given the typical timescales involved in PCT applications.
- (b) Feedback was most useful on applications where no amendments had been made on national phase entry so that the first national phase examination properly matched the scope of the international search.
- (c) The pilot had not been too time intensive at the volume and level of detail that had been used.
- (d) The volume of applications in the pilot was very small - the feedback was interesting for the cases involved but was not sufficient to identify systemic issues.
- (e) There was typically insufficient information concerning the source of new prior art, the tools and search strategy used to find new prior art, and the reason it was considered more relevant than citations from the international search report.
- (f) It would be desirable to understand and take into account the different ways that Offices or individual examiners approached the use of material from other Offices (whether the international search report or other cases of use of material from an Office of earlier examination by an Office of later examination) – the content of feedback might be different depending on whether an examiner started with the earlier work and “topped up” or began search and examination “blind” and then compared results with the earlier work.

23. The Subgroup recommended that the Authorities involved in the pilot continue to evaluate the results of this phase of the pilot and report recommendations and further intended phases as they are concluded.

### 3. CHARACTERISTICS OF INTERNATIONAL SEARCH REPORTS

24. International Authorities appreciated the annual reports showing characteristics of international search report and the online interactive tool in the IP Statistics Data Center that allowed customization of data. This allowed Authorities to identify trends, make comparisons and seek areas for improvement despite the updates taking place only twice a year. The International Bureau indicated its long-term intention to have a PCT citation database to observe changes in real time, but this was limited by resources and the need for all international search reports to be produced in XML format.

25. The Subgroup invited the International Bureau to continue to develop the tools for displaying characteristics of international search reports.

### 4. OTHER IDEAS FOR QUALITY IMPROVEMENT

#### PRACTICAL IMPLEMENTATION OF RULE 26.3*ter(e)*

26. The Korean Intellectual Property Office (KIPO) explained that Rule 26.3*ter(e)* in force since July 1, 2024, applied in a variety of situations relating to patent applications in multiple languages and this could lead to different interpretations. This created difficulty in establishing guidelines and taking consistent decisions on cases, which was important as failure to furnish the required translations could result in an international application being considered withdrawn. An example was shown, demonstrating that the types of disclosure could include both individual technical terms in a language different from the main language of the description, or else large blocks of technical content being included in that different language because the applicant considered that it was important for the purposes of the disclosure. In either case, the content in the language different from the main language of the description might either appear solely in one language or else also be translated. KIPO therefore requested Authorities to discuss experiences and share any relevant guidelines regarding the practical implementation of the new Rule. KIPO also enquired about the possibility of forwarding the application under Rule 19.4 if a decision was not clear.

27. Several Authorities indicated that they had not yet encountered many applications with multiple languages since the Rule 26.3*ter(e)* had entered into force. The European Patent Office stated that such cases would be treated centrally by an experienced formalities officer who could seek advice from PCT legal experts.

28. The International Bureau stated that an international application could be transmitted to the International Bureau under Rule 19.4 in any situation with authorization of the applicant. The International Bureau could also provide suggestions on specific cases reported by Authorities that may avoid having to forward it to the International Bureau to act as a receiving Office on the international application. The International Bureau also pointed out that there were a number of different issues, including the ability of the International Searching Authority to carry out an effective international search, the consistency of the international publication and the effect on machine translations of the international publication for delivering effective information to patent information users. It was important to consider not merely what a literal reading of the Rules would suggest should be the result, but what the most desirable outcome would be for the users of the international application, together with the effect on the formalities and substantive examination processes to achieve the best result.

29. The Subgroup recommended that the International Bureau should create a new topic on the electronic forum to consider the subject and identify possible options for new Guidelines or other options for addressing the issues.

#### CITATION OF DOCUMENTS BASED ON MACHINE TRANSLATIONS

30. The Israel Patent Office suggested that, where an examiner cites a document in an international search report or written opinion based on a machine translation of an original document published in a language not spoken by the examiner, a copy of the machine translation used could be saved for future reference and transmitted to the applicant. This would help to make the basis of the citation clear, particularly in the context where the applicant uses the original document or a translation created by a different machine translation engine. At present, confusion may occur either as a result of translations being different or from the difficulties in referring to specific passages when translations are viewed in different formats, noting that many publications do not include paragraph numbers.

31. The International Bureau observed that International Searching and Preliminary Examining Authorities were already free to take such an approach, but that there were no particular recommendations on the subject and the common IT systems did not make any special provision to distinguish such documents or to link the translations with the relevant original language document.

32. Authorities agreed that clarification and consistency of practice was desirable. There were several related issues involved, including knowing the content of the specific translation used by the examiner so as to understand the basis of the opinion, identifying relevant portions of a machine translation used and the corresponding parts of the original disclosure in cases where the document does not include paragraph numbering, and how best to cite the translation in the international search report. For the last part, it might be desirable to consider amending WIPO Standard ST.14 as well as the PCT International Search and Preliminary Examination Guidelines.

33. The Subgroup recommended that the International Bureau should create a new topic on the electronic forum to consider the subject and identify possible options for new Guidelines or other options for addressing the issues.

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