

Patent Cooperation Treaty (PCT) Working Group

**Tenth Session
Geneva, May 8 to 12, 2017**

REPORT

adopted by the Working Group

1. The Patent Cooperation Treaty Working Group held its tenth session in Geneva from May 8 to 12, 2017.
2. The following members of the Working Group were represented at the session: (i) the following Member States of the International Patent Cooperation Union (PCT Union): Australia, Austria, Barbados, Belarus, Botswana, Brazil, Cameroon, Canada, Chile, China, Colombia, Czech Republic, Denmark, Ecuador, Egypt, El Salvador, Finland, France, Georgia, Germany, Ghana, Guatemala, Hungary, India, Indonesia, Iran (Islamic Republic of), Israel, Italy, Japan, Jordan, Kazakhstan, Lesotho, Lithuania, Madagascar, Mexico, Morocco, New Zealand, Nicaragua, Nigeria, Norway, Panama, Philippines, Poland, Portugal, Qatar, Republic of Korea, Romania, Russian Federation, Saudi Arabia, Senegal, Singapore, Slovakia, Slovenia, South Africa, Spain, Sweden, Switzerland, Tajikistan, Tunisia, Turkey, Uganda, Ukraine, United Arab Emirates, United Kingdom, United States of America, Zambia (66); the following intergovernmental organizations: European Patent Office (EPO), the Nordic Patent Institute (NPI), the Visegrad Patent Institute (VPI) (3).
3. The following Member State of the International Union for the Protection of Industrial Property (Paris Union) participated in the session as an observer: Uruguay (1).
4. The following intergovernmental organizations were represented by observers: African Intellectual Property Organization (OAPI), African Regional Intellectual Property Organization (ARIPO), Eurasian Patent Organization (EAPO), Patent Office of the Cooperation Council for the Arab States of the Gulf (GCC Patent Office), South Centre (5).

5. The following international non-governmental organizations were represented by observers: Asian Patent Attorneys Association (APAA), European Law Students' Association (ELSA International), International Federation of Intellectual Property Attorneys (FICPI), Institute of Professional Representatives Before the European Patent Office (EPI) (4).

6. The following national non-governmental organizations were represented by observers: Asociación de Agentes Españoles Autorizados ante Organizaciones Internacionales de la Propiedad Industrial (AGESORPI), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA) (3).

7. The list of participants is contained in the Annex.

OPENING OF THE SESSION

8. Mr. John Sandage, Deputy Director General, opened the session on behalf of the Director General of WIPO. Mr. Michael Richardson (WIPO) acted as Secretary to the Working Group.

9. The Deputy Director General informed the Working Group that, after a three year gap since the Islamic Republic of Iran had deposited its instrument of accession in July 2013, four new States had acceded to the PCT since the Working Group had last met, namely, Kuwait, Djibouti, Cambodia and Jordan, bringing the total number of PCT Contracting States to 152. Since the ninth session of the Working Group, the Turkish Patent and Trademark Office had been appointed as an International Searching and Preliminary Examining Authority, and had started operations on March 8, 2017, bringing the total number of International Searching and Preliminary Examining Authorities to 22. The Deputy Director General welcomed the new States to the PCT and congratulated the Turkish Patent and Trademark Office and wished it well in its new function.

10. The Deputy Director General reported on a few of the key developments since the ninth session of the Working Group. On February 2, 2017, the PCT reached the important milestone of the publication by the International Bureau of the 3 millionth international application filed under the Treaty. From modest beginnings in 1978, the PCT had become the central pillar of the international patent system. It was the main choice of applicants seeking patent protection internationally in its Member States, and one of the best examples of successful multilateral work sharing and cooperation in intellectual property. In terms of figures for 2016, international applications rose by 7.3 per cent to 233,000, the highest percentage growth since 2011. The share of international applications filed in 2016 with at least one female inventor was estimated to be about 30.5 per cent, which had risen steadily in recent years; the publication "World Intellectual Property Indicators – 2016" included a special section on women's participation in international patenting. International applications were filed in 126 countries, four fewer than in 2015, but the number of international applicants had increased by 4.7 per cent to 50,838 applicants. In terms of the countries of origin of applicants, the United States of America maintained its position as the principal source of international applications with around 57,000 filings, followed by Japan with over 45,000 applications, and China with more than 43,000 applications. After a very high growth rate of 16.8 per cent in 2015, growth in numbers of international applications originating from China rose dramatically in 2016 by the extraordinary amount of 44.7%. ZTE Cooperation of China was the top PCT applicant with 4,123 applications published in 2016, having previously held this spot in 2011 and 2012, overtaking its neighbor Huawei Technologies, which ranked second with 3,692 applications published last year. The number of national phase entries passed 600,000 for the first time in 2015, rising by 3.8 per cent from 2014 to a total of 618,500. The share of PCT national phase entries in non-resident patent filings worldwide remained at about 57 per cent.

11. The Deputy Director General concluded by referring to the agenda for the session. In addition to the session of the Working Group, during the week, the Committee for Technical Cooperation would be holding its thirtieth session. The Committee would be providing advice to the Assembly on the extension of the appointment of all International Searching and Preliminary

Examining Authorities beyond their current expiry at the end of 2017, and on the appointment of the Intellectual Property Office of the Philippines as an International Searching and Preliminary Examining Authority. In this regard, the Secretariat had prepared a guidance document, which set out the role of the Committee in making a technical assessment of how an Office or organization could contribute to the services of the PCT, taking into account the minimum requirements for appointment. As for the Working Group, many of the important items on the agenda related to fees. Later in 2017, the International Bureau hoped to begin a pilot project to introduce a "netting structure", which could reduce the International Bureau's exposure to movements in currency exchange rates, and reduce costs and efforts for receiving Offices and International Authorities. The Deputy Director General also referred to two proposals on fees, one by the International Bureau, which aimed to reduce the numbers of applicants claiming fee reductions as "a natural person" that they were not entitled to, and one by the Delegation of Brazil to provide for fee reductions from universities, notably from developing countries. PCT fees constituted 76 per cent of WIPO's revenue, and enabled the financing of activities across all parts of the Organization, including cooperation in the area of development and capacity-building. It was therefore necessary to exercise care when approaching these questions, bearing in mind that they affected the financial basis of the entire Organization. Finally, the Deputy Director General referred to how the PCT could benefit from fully electronic processes, a common theme to several of the documents for the session. In March 2017, the International Bureau had launched a new "look and feel" to ePCT with a more attractive and user-friendly interface and easier secure access for users and Offices to manage portfolios. The Deputy Director General encouraged delegations to consider how ePCT and other IT services provided by WIPO could help meet their needs as Offices and users of the PCT System to the benefit of the international patent system as a whole.

ELECTION OF A CHAIR AND TWO VICE-CHAIRS

12. The Working Group unanimously elected Mr. Maximiliano Santa Cruz (Chile) as Chair and Mr. Victor Portelli (Australia) as Vice-Chair for the session. There were no nominations for a second Vice Chair. Mr. Santa Cruz chaired the discussions on all agenda items, except for the discussions on the agenda item "Training of Examiners", which were chaired by Mr. Portelli.

ADOPTION OF THE AGENDA

13. The Working Group adopted the revised draft agenda as proposed in document PCT/WG/10/1 Prov. 2.

PCT STATISTICS

14. The Working Group noted a presentation by the International Bureau on the most recent PCT statistics¹.

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT OF THE TWENTY-FOURTH SESSION

15. Discussions were based on document PCT/WG/10/3.

16. The Secretariat introduced the document, which reported on the twenty-fourth session of the Meeting of International Authorities (MIA) under the PCT and the seventh informal session of the PCT/MIA Quality Subgroup. The Secretariat highlighted two topics that were discussed at these sessions, quality, and the extension of appointment of International Authorities. As in recent years, quality had been a main focus of discussions. Within the Quality Subgroup, there were useful exchanges of information by International Authorities on their respective quality management systems. In particular, for the first time, a peer review exercise took place within a

¹ The presentation is available from the WIPO website at:
http://www.wipo.int/meetings/en/details.jsp?meeting_code=pct/wg/10

group of four International Authorities, where each Authority conducted a detailed review of the Quality Management System of another Authority in the group in advance of the meeting, and then discussed the report of that Authority in an interview with the representative of that Authority attending the Quality Subgroup. All Authorities in this group therefore reviewed the Quality Management System of another Authority, and also had their own Quality Management System reviewed in detail by one of the other Authorities participating in the exercise. All four participating International Authorities found this exercise to be useful and recommended conducting this in future years, where it would be open for other International Authorities to participate if they wished. In terms of requirements of Quality Management Systems, there was agreement for the International Bureau to consult on modifications to Chapter 21 of the PCT International Search and Preliminary Examination Guidelines with a view to strengthening the requirements. The Quality Subgroup also agreed to discuss a number of issues related to quality management systems in the year ahead, in particular, on ISO 9001 certification, where some Authorities had recently attained the certification or had adapted their quality management to meet the requirements of ISO 9001:2015, the most recent version of this standard. Another issue that International Authorities agreed to discuss in the coming year was timeliness of international search reports and measures taken for improvement. In terms of reporting on and monitoring quality, Authorities continued to discuss the development of metrics, where possibilities could be provided through the IP Statistics Data Center, and also by offering services in ePCT to give Offices reports on their performance and flag up situations if performance had fallen outside standard parameters and could require further investigation and action. Authorities also continued discussions on improving international work products. Some Authorities had been making more information available on their search strategies, and discussions had begun on how best to get feedback from the different types of users of these search strategies. There was also agreement on further work to improve the standardized clauses that International Authorities used in international reports, and also on modification of the PCT International Search and Preliminary Examination Guidelines on unity of invention. While quality was a recurring theme discussed by International Authorities, the procedure for extension of appointment of International Authorities related to the work of the Committee for Technical Cooperation and the Assembly in 2017. At the MIA, all International Authorities noted the timetable for the procedure that had been agreed by the Working Group at its ninth session, and the process to be followed to ensure an efficient and useful session of the Committee for Technical Cooperation, which would take place during the same period as this session of the Working Group. International Authorities also discussed a model agreement that would be used to draw up the individual agreements to take effect from January 1, 2018 that each International Authority would have with the International Bureau, and that the Assembly would need to approve at its session in October this year.

17. The Delegation of the United Kingdom underlined the importance of the PCT in underpinning the global patent system. It was therefore vital that the quality of work in the international phase was maintained. The Delegation therefore welcomed the continuing work of the Quality Subgroup. In particular, the Delegation indicated its support for the continuing of the peer review exercise on the Quality Management Systems of International Authorities as a way of facilitating Offices in sharing best practices. The Delegation also welcomed the work on user feedback, and stated that the United Kingdom Intellectual Property Office was working with the Canadian Intellectual Property Office and the Japan Patent Office to develop a process for designated Offices to provide feedback to the International Searching Authority with a view to beginning a pilot study, and it encouraged other Offices to consider similar initiatives. The Delegation also noted the continued work of the Quality Subgroup on sharing of search strategies and the update of the pilot program at the European Patent Office, and it supported efforts to share search strategies to the fullest extent possible. In this regard, the United Kingdom Intellectual Property Office was working to overcome IT constraints to enable it to share its own search strategies in the future. The Delegation also noted with interest the other ideas for quality improvement discussed in the Quality Subgroup, particularly the focus on standards such as ISO 9001, where the United Kingdom had held certification for its patent processes since 2003 and would be willing to share its own experiences with interested Offices.

18. The Delegation of Iran (Islamic Republic of) referred to paragraph 38 of the Summary by the Chair of the Meeting of International Authorities set out in the document, and asked the Secretariat for clarification on the follow up to incorporating the proposed modifications in document PCT/MIA/24/11 into the PCT International Search and Preliminary Examination Guidelines. In particular, the Delegation stressed that any proposal on modification of the Guidelines involving integration of the Patent Prosecution Highway (PPH) into the PCT referred to in paragraph 36 of the Summary by the Chair of the Meeting of International Authorities set out in the document should be submitted to the Working Group for discussion and approval.

19. The Delegation of the Nordic Patent Institute thanked the International Bureau and delegates of the International Authorities who attended the twenty-fourth session of the Meeting of International Authorities and the informal meeting of the Quality Subgroup in Reykjavík in February 2017 for contributing to the success of these meetings.

20. The Secretariat, in response to the question that had been raised by the Delegation of Iran (Islamic Republic of) about utilization of the PCT-Patent Prosecution Highway (PCT-PPH) referred to in paragraph 36 of the Summary by the Chair of the Meeting of International Authorities set out in the document, clarified that the International Bureau would ensure that all Offices concerned would be consulted on any modification to the Administrative Instructions or International Search and Preliminary Examination Guidelines in connection with this issue. While this was most commonly done by way of PCT Circulars, issues would be referred to the PCT Working Group where this appeared appropriate.

21. The Working Group noted the report of the twenty-fourth session of the Meeting of International Authorities, based on a Summary by the Chair of that session contained in document PCT/MIA/24/15 and reproduced in the Annex to document PCT/WG/10/3.

PCT ONLINE SERVICES

22. Discussions were based on document PCT/WG/10/21.

23. The Secretariat introduced the document by explaining that the latest release of ePCT on March 29, 2017 contained two major features. First, the user interface had a new “look and feel” which aimed to make the ePCT environment easier to use and gave a more consistent presentation of information. Meanwhile, the old version was being maintained in parallel for a limited transition period. Second, a new identity management system had been introduced which provided users with a choice of strong authentication methods to access ePCT. In addition to the traditional digital certificate, users could now choose a one-time password generated either by a standard app on their mobile device such as a smartphone or tablet, or by requesting a text message (SMS) to their mobile phone number. The new identity management system would open up new opportunities for machine to machine services, and users had reported it to be easier to use than registering for a digital certificate. For IP Offices, the use of ePCT browser-based services depended on the functions of each Office and local IP systems. Some Offices were using ePCT as their primary processing tool, while other Offices used it as a back-office support to view files for cases which could not be handled automatically through batch transfers. ePCT-Filing was used by 46 receiving Offices, with one Office having joined in the previous week, and around 68 per cent of applications to the receiving Office of the International Bureau were filed by ePCT in the first quarter of 2017. Since the publication of the document, it had become possible for applicants to upload documents to more Offices, bringing the total to 56 Offices, including 54 in their role as a receiving Office and 15 in their role as an International Searching and Preliminary Examining Authority, as well as to the International Bureau. With regard to priorities for future work, the International Bureau was planning to develop the features listed in paragraph 3 of the document. With regard to amendment of the Rules, an amendment to Rule 95 would enter into force on July 1, 2017 which requires the transmission of information concerning national phase entries, national publications and grants of international applications, which should improve the quality and completeness of the information provided in ePCT and PATENTSCOPE. Work on the proposed pilot for national

phase entry assisted by ePCT had been put on hold during implementation of the new “look and feel”, but interested Offices would be contacted shortly with a view to restarting the process. Other changes to ePCT were also planned, as explained in paragraphs 30 to 32 of the document. The Secretariat concluded by stating that the International Bureau was ready to work with Offices towards a more effective and consistent use of online services in the processing of international applications.

24. The Delegation of Israel welcomed the development of PCT online services and thanked the International Bureau for the continued efforts to further improve the system to provide an effective and efficient service for applicants and Offices using the web interface. Regarding ePCT-filing, the Israel Patent Office used the ePCT system regularly for its work as a receiving Office and International Searching and Preliminary Examining Authority for viewing and downloading all documents. With effect from July 2016, the Israel Patent Office, in its capacity as a receiving Office, had started to accept, via the e-filing servers at the Israel Patent Office, packages prepared for submission using ePCT-filing, in addition PCT-SAFE. A large majority of applications received by the Israel Patent Office as a receiving Office were filed using PCT-SAFE software, with only about 10 per cent of applications received by ePCT-filing. The Delegation therefore hoped that the International Bureau would continue to maintain the PCT-SAFE software. Furthermore, all applicants, including those who were not located in Israel, were able to receive key communications in electronic form. Regarding eSearchCopy, as an International Searching Authority, the Israel Patent Office used the eSearchCopy system regularly for receiving international applications filed by applicants in the United States of America using either the United States Patent and Trademark Office or the International Bureau as a receiving Office, and as a receiving Office for transmitting search copies to the European Patent Office as an International Searching Authority. Regarding the use of XML, the Delegation supported moving towards full text in a machine-readable format as an alternative to PDF. Moreover, the automated systems at the Israel Patent Office were able to transmit international work products in XML format, and the Delegation was willing to transmit examples to the International Bureau for comments and considerations. Finally, with regard to the management reports, the Delegation supported the idea to expand ePCT services to International Searching Authorities by the development of management reports concerning outstanding search copies and international search reports. These management reports were useful tools to allow Offices to identify possible problem cases at an earlier stage and help determine causes of delays. In addition, it would be desirable to have the summary of the international applications known to the International Bureau for which the Office was competent as an International Preliminary Examining Authority where the international preliminary report on patentability under Chapter II was outstanding. Developing a “push system” which delivered such reports regularly to International Authorities would be welcome.

25. The Delegation of the United States of America supported the priorities laid out in the document and indicated that the United States Patent and Trademark Office planned to participate in and support the International Bureau in these areas to the extent that its resources permitted. The United States Patent and Trademark Office had enabled the creation of ePCT packages for filing in its electronic filing system, but the Delegation supported the comments made by the Delegation of Israel regarding the maintenance of PCT-SAFE in view of national security issues for applicants in the United States of America with using ePCT. The Delegation agreed with the discussion in paragraphs 24 to 27 of the document regarding efforts to increase the use of XML and indicated that the United States Patent and Trademark Office was working towards that aim. Finally, with regard to the use of docx discussed in paragraph 27 of the document, the United States Patent and Trademark Office had been considering this matter regarding national filings and had agreed to collaborate with the European Patent Office and the International Bureau to explore the possibility for docx filings from applicants. In piloting docx submissions, the United States Patent and Trademark Office had encountered issues regarding the applicability of physical requirements to filings that were not made in image format. In this regard, it could be appropriate to review how the physical requirements in PCT Rule 11 affected filings made in non-image formats.

26. The Delegation of Denmark thanked the International Bureau for the development of PCT online services and indicated that the Danish Patent and Trademark Office, in its capacity as a receiving Office, was highly satisfied with the services and cooperation with the International Bureau. One practical feature that had been useful was the ePCT mail or chat feature which allowed receiving Offices to communicate directly with the International Bureau and receive a swift response. In conclusion, the Delegation stated that it did not have any particular suggestions or other priorities beyond those outlined in the document.

27. The Delegation of Chile welcomed the document. In 2016 when the National Institute of Industrial Property of Chile had begun accepting filings through ePCT, about 50 per cent of international applications that it received were filed through online services, but more than 70 per cent were now using ePCT. The Delegation thanked the International Bureau for its support in implementation of ePCT in the Latin America and Caribbean region to enable other countries to use the system. The Delegation also supported the recent developments in ePCT, in particular, the intention to generate management reports using information from the system. With regard to eSearchCopy, the National Institute of Industrial Property of Chile was part of the system and the Delegation encouraged other Offices to use it as well. The National Institute of Industrial Property of Chile was also working with the International Bureau to enable it to transmit the international search reports that it produced as an International Searching Authority to the International Bureau in XML format.

28. The Delegation of India expressed appreciation for the work of the International Bureau in improving PCT online services so as to make them more user-friendly and by providing further facilities to users and receiving Offices, which has overcome certain difficulties that were faced in the past. The Delegation supported the development of ePCT online services. It informed the Working Group that India had amended its national laws to make it mandatory for patent attorneys to file applications through an e-filing system, with its online filing system offering a 10 per cent fee reduction for its applicants. In line with this same objective, the Indian Patent Office had undertaken several initiatives to promote the use of ePCT and reduce paper filings among Indian applicants in order to maximize the advantages that could be obtained using the system, and the Delegation hoped more applications would be using the new ePCT system in the future. The Delegation also looked forward to further improvements in the ePCT system, especially with regard to payment of fees and more complete processing of applications so as to reduce processing times and make the system more transparent.

29. The Delegation of Australia welcomed the ongoing development of ePCT and commended the International Bureau on the new “look and feel” of the latest version. IP Australia had begun accepting international applications through ePCT since April 14, 2014, and had ceased to accept applications filed using PCT-SAFE from September 1, 2016. In May 2016, approximately 70 per cent of international applications were filed at IP Australia using ePCT, with PCT-SAFE filings accounting for 12 per cent of filings; both these figures represented significant increases and decreases, respectively, from the previous year. The PCT processing team at IP Australia had worked directly with patent attorneys to assist them with the transition from PCT-SAFE to ePCT, which included being able to answer questions over the phone, as well as providing basic training and support in setting up user accounts. This had enabled a smooth transition for the majority of filers moving from PCT-SAFE to ePCT. Over 80 per cent of filers at IP Australia were currently using ePCT, a fantastic result which would ensure a more efficient and streamlined filing for customers, as well as improvements in internal processing for the PCT team at IP Australia. The Delegation thanked the International Bureau for its assistance in this process. Looking to the future, the Delegation stated that it would like all filings to be made through ePCT. One enhancement for applicants would be the ability to pay fees upfront using ePCT, especially the international filing fee component, rather than applicants being required to use the fee paying mechanism available at IP Australia. In this area, the Delegation recognized the substantial work being undertaken, as explained in document PCT/WG/10/6. The Delegation looked forward to the results of the netting pilot and remained hopeful that a successful pilot could lead to a solution and a significant uptake in the

use of ePCT. More broadly, the Delegation invited the Working Group to consider how solutions might not necessarily involve moving a paper process to a digital process, but rather the digital environment giving rise to new solutions that could not be considered or would be constrained by a paper-based environment. In this regard, IP Australia was actively considering these issues internally and looked forward to working with the International Bureau in the years ahead.

30. The Delegation of the European Patent Office supported the efforts of the International Bureau to develop its online services for both Offices and users alike, in particular in ePCT, which still had much potential. In this regard, the European Patent Office had excellent cooperation with the International Bureau, which was focused on providing the best services possible to users and Offices. The Delegation noted the positive developments, and commented on four specific matters. First, the European Patent Office expressed serious concerns regarding the implementation of the signature requirements in the ePCT-Filing tool in view of the fact that the signature could be performed independently from the rest of the request form. The ePCT-Filing tool allowed users to prepare an international application while operating in several different sections and applying the signature once only regardless of the number of changes made to the application itself. This therefore did not ensure that the individual who had signed the application had in fact approved the content including uploaded documents where the application had not been prepared sequentially, applying the signature at the end. Second, regarding the use of ePCT browser-based service, the European Patent Office was supportive of measures that could lead to a reduction in paper-based processes for handling applications, especially when those measures improved timeliness and could be efficiently implemented. In this regard, the European Patent Office privileged interacting with PCT files using its own patent administration system, which usually required exchanges of work data. The Delegation also echoed the comments from the Delegation of Australia with regard to looking for solutions provided by the electronic environment, rather than in the paper-based procedure. Third, with respect to the next steps for ePCT, the Delegation welcomed steps for further effective automation of services, where the European Patent Office was discussing with the International Bureau about how best to integrate an ePCT web service into its future consolidated filing solution. Finally, with respect to the use of XML, the Delegation encouraged more International Searching Authorities to send international search reports and written opinions to the International Bureau in XML format, which would substantially help further processing and automate translation efforts, and the European Patent Office was looking forward to receiving more search reports in XML, and whenever available, translated into English by the International Bureau. The European Patent Office was also developing a filing option to enable the receipt of applications in Open Office XML (“docx”) format, where the European Patent Office was discussing with the other IP5 Offices a proposal for change which it intended to post soon to adapt Annex F of the PCT Administrative Instructions to support docx as a legally valid filing format.

31. The Delegation of China thanked the International Bureau for its efforts to improve the ePCT system and extend its functions. For future development of online services, the Delegation requested more attention to be given to language accessibility and data updates to make the system more user-friendly for both applicants and Offices.

32. The Delegation of Japan welcomed progress made on PCT online services including the ePCT system and thanked the Secretariat for its effort in this regard. In relation to color drawings, the Delegation noted that the proposals in paragraph 31 of the document, where it was stated that an interim solution could be made available on or after October 1 2017, depending on the responses received from Member States to Circular C. PCT 1505. In this regard, the proposals would have effects on national regulations and IT systems, which would both need to be adjusted. Therefore, it would be difficult for the Japan Patent Office to implement the interim solution for color drawings by the target date.

33. The Delegation of Switzerland announced that the Swiss Federal Institute of Intellectual Property would soon be introducing ePCT-filing, which the Delegation believed would be of great benefit for the Office and applicants. The Delegation thanked the International Bureau for its support to clarify questions regarding the implementation of ePCT-filing and looked forward to continued cooperation in the future.

34. The Delegation of Austria stated that the Austrian Patent Office used ePCT as a receiving Office, International Searching and Preliminary Examining Authority, and as a designated/elected Office. The Austrian Patent Office had implemented ePCT-Filing through the online filing service hosted by the International Bureau. As an International Searching Authority, the Austrian Patent Office accepted eSearchCopy from nearly all of its receiving Offices that sent search copies; as a receiving Office, the Austrian Patent Office sent search copies using eSearchCopy to the European Patent Office. The Delegation thanked the International Bureau for its good cooperation in developing its ePCT services. In terms of suggestions for improvement, the Delegation suggested making a separate document code for Form PCT/ISA/206 to invite the applicant to pay additional fees where the International Searching Authority considered there was lack of unity of invention, which could allow it to be more easily uploaded and made available in its correct name.

35. The Delegation of Brazil stated that the National Institute for Industrial Property of Brazil was an active user of PCT online services and hoped to eliminate the use of paper over the next few years as part of its actions to rationalize procedures and streamline the processing of applications. In this regard, the Delegation underlined the importance of international cooperation, which allowed access to tools which could later be adapted for use in local domains. The National Institute for Industrial Property of Brazil followed discussions regarding XML format with great interest, and was initiating internal debates for establishing technical requirements for adapting XML formats for use in its internal services and to receive patent applications, where it hoped to present further information at the following session of the Working Group.

36. The Secretariat, in response to the comments raised by the Delegations of Israel and the United States of America with regard to the continued support of PCT-SAFE, reiterated that the International Bureau wished to work with Offices towards ending support for PCT-SAFE in order to eliminate the cost of maintaining duplicate systems. However, this would not be done unilaterally while PCT-SAFE remained important to a significant body of users who were unable to use ePCT-filing due to national security restrictions. With regard to the question of signatures raised by the European Patent Office, the Secretariat pointed out that, even with a paper-based system, it was not possible to be sure that the signature from a patent attorney indeed related to all attached documents. The International Bureau was willing to look into this matter, but it was important that any solutions to address this issue did not make it more difficult for Offices and applicants. In terms of language support, applications could be viewed in different languages as Figure 3 of the document demonstrated, where the application had been filed in Japanese with the processing in English and Japanese, and the application could be viewed in Russian. Multiple language information was one reason why the International Bureau encouraged Offices, especially International Searching Authorities, to produce reports using XML, which would allow for language-neutral data to be put into a stylesheet specifically produced for that language. More generally, the International Bureau hoped Offices could provide the information needed for good language support. Finally, in relation to color drawings, the Secretariat stressed that the solution to be implemented in the near future was only an interim solution, and not seeking to deal with the issues of the time when the entire system would support applications in color. The interim solution recognized that some international applications were filed with color drawings and this information was currently disregarded when the application was published in black and white. The International Bureau would discuss the interim solution with the Japan Patent Office and other interested Offices about implementing this arrangement in their national systems, but it nevertheless hoped to go ahead with the implementation, adding that it was not essential for all receiving Offices to start the service for color drawings at the

same time. As part of the consultations in Circular C. PCT 1505, Offices were asked whether not being able to implement the interim solution would act as a barrier or not, and it was hoped that receiving Offices could move ahead at different speeds so information became available on the widest scale possible.

37. The Working Group noted the contents of document PCT/WG/10/21.

eSEARCHCOPY

38. Discussions were based on documents PCT/WG/10/13 and 22.

39. The Secretariat, in introducing document PCT/WG/10/22, stated that the eSearchCopy service was working well and the International Bureau encouraged more receiving Offices and International Searching Authorities to use this route for sending and receiving search copies. The service began on September 20, 2014, when the receiving Offices of Malaysia and New Zealand started transmitting search copies using eSearchCopy to IP Australia. With the addition on May 1, 2017 of the receiving Office of the International Bureau transmitting search copies to the Indian Patent Office and the receiving Offices of Bulgaria, Denmark, Germany and Singapore joining the PCT Paperless service at the European Patent Office, 41 receiving Offices and 17 International Searching Authorities now participated in eSearchCopy. eSearchCopy accounted for about 24 per cent of search copies transferred between receiving Offices and International Searching Authorities when the two Offices were different. Further growth was also expected over 2017 as more Offices joined the PCT Paperless service at the European Patent Office. In addition to the greater usage of eSearchCopy, the document showed that the timeliness of receipt of search copy had improved. The quality of search copies was also equal to or better than those previously received on paper. In this regard, the Secretariat pointed out that controls were in place involving parallel run testing with paper copies to ensure that new receiving Offices participating in eSearchCopy were able to make good scanned copies when an international application was filed on paper. In addition, one aim of eSearchCopy was that International Searching Authorities would only require a single process and software regardless of the number of receiving Offices from which it received search copies. The eSearchCopy service also enabled receiving Offices to offer electronic filing to applicants as the service also avoided transformation of electronically filed copies to physical media for transmission to the International Searching Authority. Furthermore, through eSearchCopy, the International Bureau could offer a better service to International Authorities by improved tracking and management reports, such as those available in ePCT. For receiving Offices interesting in participating in eSearchCopy, there were certain pre-requisites, notably being able to send record copies to the International Bureau using ePCT or PCT-EDI, to add translations and sequence listings for the purpose of search only, and to be able to identify payment of the search fee and notify this to the International Bureau in order to trigger transmission of the search copy to the International Searching Authority. For receiving Offices that accepted paper filings only, eSearchCopy had benefits as the applicant would only need to submit one paper copy of the application, which would be scanned and retained at the receiving Office while the record copy and search copy would be transmitted electronically. For the future, the International Bureau would continue to contact Offices to encourage them to participate, noting that priorities would be set based on transmission volumes and prerequisites for participation. The International Bureau would also continue to coordinate with the European Patent Office regarding the implementation of PCT Paperless.

40. The Delegation of the European Patent Office, in introducing document PCT/WG/10/13, noted that the pilot implementations of the eSearchCopy/PCT Paperless service had been successfully concluded last year and that the service was fully operational with 12 receiving Offices. By the end of 2017, the Delegation intended to have about 20 receiving Offices using the service. The Delegation also hoped to move all receiving Offices for which the European Patent Office was competent to act as an International Searching Authority to this system eventually, but that there was a need for a two to three month trial period of dual running for each Office to ensure that the service had been implemented effectively, checking consistency,

quality and timeliness. This took resources and consequently the implementation needed to be done in small groups of about four Offices. The Delegation concluded by encouraging all receiving Offices for which the European Patent Office was competent to act as an International Searching Authority that had not yet discussed the PCT Paperless service with the European Patent Office to make contact. Finally, the Delegation indicated that the PCT Regulations might need to be adapted to reflect the situation of search copies being transmitted via the International Bureau.

41. The Delegation of Spain stated that the Spanish Patent and Trademark Office had been participating in eSearchCopy as a receiving Office to transmit search copies to the European Patent Office and no longer sent search copies on paper. As an International Searching Authority, the Office had made contact with receiving Offices, especially those in Latin America, and it hoped to start receiving search copies through the eSearchCopy service in the near future.

42. The Delegation of Israel stated that the Israel Patent Office had been using eSearchCopy since October 2014 and received search copies through eSearchCopy for applications filed at the United States Patent and Trademark Office and the International Bureau acting in its capacity as a receiving Office. As a receiving Office, the Israel Patent Office transmitted more than 300 search copies to the European Patent Office through eSearchCopy and had stopped the paper based flow in May 2016. With regard to the transfer of search fees from receiving Offices to International Searching Authorities via the International Bureau, while the Delegation supported these mechanisms, Offices would need time to prepare their IT systems to ensure a smooth transition to be able to receive and transmit search fees in a timely manner. Regarding further improvements to the eSearchCopy service, the Delegation supported the extension to enable the delivery of color drawings to the International Searching Authority and improvement to bibliographic data packages that were being delivered by the system, such as adding email addresses and telephone and fax numbers of agents and applicants. In conclusion, taking into account the advantages of the eSearchCopy service, the Delegation hoped that it would be implemented for the transmission of search copies between more receiving Office and International Searching Authority pairs.

43. The Delegation of Austria thanked the European Patent Office for being able to receive search copies from applications filed at the Austrian Patent Office through eSearchCopy. The Delegation also commended the eSearchCopy service which made the receipt of search copies much easier for an International Searching Authority.

44. The Delegation of India stated that it was committed to promoting the transmission of search copies through the eSearchCopy service. Out of the six International Searching Authorities besides the Indian Patent Office which were competent for applications received at the Indian Patent Office, the Austrian Patent Office, IP Australia and the Swedish Patent and Registration Office had already started receiving search copies through the service. The Delegation had requested the other International Searching Authorities to be able to receive search copies filed at the Indian Patent Office, and especially wished that the European Patent Office would be able accept search copies through eSearchCopy as the International Searching Authority most selected by applicants in India. The Indian Patent Office had also started receiving search copies through eSearchCopy from this this year.

45. The Delegation of Canada stated that it appreciated the advantages of eSearchCopy. The Delegation sympathized with the wishes of the International Bureau to decommission legacy systems and was investigating the impact of the discontinuation of PCT-SAFE for applicants and the Canadian Intellectual Property Office with the hope of decommissioning PCT-SAFE in the future. The Delegation also welcomed hearing about the requirements to begin using eSearchCopy as a receiving Office.

46. The Delegation of Germany thanked the International Bureau and the European Patent Office for their help and support in providing the eSearchCopy/PCT Paperless service and announced that the German Patent and Trade Mark Office had started the evaluation phase in PCT Paperless on May 1, 2017 with the hope to enter into full production on July 1, 2017.

47. The Delegation of the United States of America thanked the International Bureau for its continued efforts in the development and promotion of eSearchCopy services as described in document PCT/WG/10/22. Concerning the apparent minimal use of eSearchCopy by the United States Patent and Trademark Office as shown in the Annex to the document, the Delegation pointed out that, in its capacity as a receiving Office, the United States Patent and Trademark Office exchanged all search copies electronically, with most being transmitted by direct bilateral exchange with the International Searching Authority. The United States Patent and Trademark Office was willing to transition to eSearchCopy should this be desired by its partner Offices. As for the pilot described in paragraph 9 of the document, the transfer of search fees to the European Patent Office via the International Bureau was going well and it supported extending these pilot arrangements to other Offices in the near future.

48. The Delegation of Chile expressed its support for the eSearchCopy service. As an International Searching Authority, the National Institute of Industrial Property of Chile received search copies through eSearchCopy for applications filed at the receiving Offices of Colombia and Mexico, as well as the International Bureau, and it expected to expand this service to other Offices in Latin America. Moreover, the National Institute of Industrial Property of Chile had made contact with the European Patent Office and the Spanish Patent and Trademark Office to enquire about these Offices receiving search copies for applications filed at National Institute of Industrial Property of Chile in its capacity as a receiving Office.

49. The Working Group noted the contents of documents PCT/WG/10/13 and 22.

PROGRESS REPORT: POSSIBLE MEASURES TO REDUCE EXPOSURE OF PCT FEE INCOME TO MOVEMENTS IN CURRENCY EXCHANGE RATES THROUGH NETTING

50. Discussions were based on document PCT/WG/10/6.

51. The Secretariat introduced the document, which presented an update on the possible introduction of a netting structure for all PCT fee transactions. This idea had been first presented to the Working Group in 2015 (see paragraph 7 of document PCT/WG/8/15) as part of a set of recommendations from a firm of treasury consultants who had been engaged to review aspects of WIPO's asset management, most notably its exposure to foreign exchange. The basic idea was to set up a netting structure for PCT fee transactions between receiving Offices, International Searching Authorities and the International Bureau by consolidating all the transactions between participants and calculating a net settlement, usually a single payment or receipt. A receiving Office would therefore send to the International Bureau not only the international filing fees collected but also the search fees. The International Bureau would then collect together the search fees received from several receiving Offices for a particular International Searching Authority, and pass them to the Authority concerned as one payment. This would reduce the number of transfers as both receiving Offices and International Searching Authorities would only need to deal with transfers to and from the International Bureau. Moreover, the International Searching Authorities would receive the full search fee in the fixed currency, and therefore would no longer need to claim for any losses incurred due to exchange rate fluctuations under Rule 16.1(e). Where a receiving Office was also an International Searching Authority, the Office and the International Bureau would exchange information on the fees collected as the receiving Office and the search fees payable by the International Bureau representing the amounts collected from other receiving Offices. The international filing fees and search fees would then be netted, with the result being that either the receiving Office would pay the International Bureau in its local currency, that is if this is freely convertible into Swiss francs, or otherwise in Swiss francs, euros or United States dollars, or if a net amount was due to the receiving Office, the International Bureau would transfer the net amount due in

the currency in which the Authority had fixed the search fee. As the document indicated, an analysis of the implications of setting up a netting structure was currently ongoing. The International Bureau had undertaken a request for proposal (RFP) in order to select the netting software needed to operate the structure. A supplier had been recommended, and the International Bureau was in the process of negotiating a contract. The International Bureau was hopeful that tests could be performed using data from 2016 in the second quarter of 2017 to analyze the impact of netting. The International Bureau then intended to invite a few Offices that acted as both a receiving Office and an International Searching Authority and had a high volume of PCT fee transfers to participate in a netting pilot in a test environment in the third quarter of 2017. This pilot would involve both filing fees and search fees. If the pilot were successful, a proposal would then be made to the Working Group to extend the approach to as many Offices as possible. In addition, the International Bureau was also interested in including the distribution payments in the Madrid and Hague Systems in order to reduce the amount of currency conversions involved with these payments, and would consult with the Madrid and Hague Unions on an expanded netting process in the event of a successful pilot.

52. The Delegation of Israel supported the proposal to introduce a netting structure for the transfer of fees, but it would be necessary for Israel Patent Office to have sufficient time to prepare its IT systems to receive and transmit fees in accordance with the proposed netting mechanism. At present, the Israel Patent Office would need to consider this matter carefully, as not only the search process was being triggered by the receipt of the search fee, but other tasks and actions were based on this mechanism. A centralized payment mechanism would require fundamental changes in system and work procedures at the Israel Patent Office.

53. The Delegation of the United States of America expressed general support for possible approaches to reduce the losses in income incurred by WIPO due to exchange rate fluctuations and it looked forward to reviewing these issues with the benefit of the detailed analysis by the consultant, as referred to in paragraph 11 of the document, in order to understand better the details of how the netting proposal would work. The Delegation still had concerns about the proposal for the netting structure, which could result in additional work for receiving Offices and impose extra burden on Offices in their various capacities under the PCT. The Delegation nevertheless supported the pilot project that the International Bureau intended to start later in 2017 to test the software and the methods for implementing a possible netting structure, and if asked, the United States Patent and Trademark Office would be willing to participate. The Delegation further stated that any netting scheme for PCT fees would have to ensure transparency of all transactions and participation should be voluntary given that financial and IT systems at some Offices might not be compatible with conducting the required operations.

54. The Delegation of the European Patent Office highlighted the positive experience with the pilot where it received the search fee from the International Bureau in euros for applications received at the United States Patent and Trademark Office for which it acted as the International Searching Authority. The Delegation therefore welcomed the opportunity to work in collaboration with the International Bureau in order to launch another pilot scheme involving search fee transfers in order to develop a more effective system for all Offices. Reducing the costs of financial transactions was appreciated by the European Patent Office on the condition that the system of monthly transactions functioned correctly, which required the parties to make their transactions within the necessary time frame, and to use the appropriate electronic tools to exchange information. The Delegation expressed interest in having further information, for instance, in a financial impact study, on the exchange rate costs described in paragraph 17 of the document. The Delegation underlined an advantage in linking netting structure with the eSearchCopy service, with the International Bureau acting as a hub for search copies and fees, which would make the system more effective for International Searching Authorities. Finally, in the future, the Delegation hoped that amendments could be made to the PCT Regulations to make it possible for receiving Offices to transfer the search fees to International Searching Authorities via the International Bureau when the payment currency was not the same as that fixed by the International Searching Authority.

55. The Delegation of China supported the proposal to commence a pilot project for the netting of search fees and international filing fees. The Delegation proposed that the pilot project should include different International Searching Authorities to make the procedure of collecting and transferring fees more cost effective.

56. The Delegation of Japan expressed interest in the Japan Patent Office joining the pilot for the netting of fees and requested more details about its implementation in order to study the arrangements and identify possible issues that could arise from participating in a netting scheme. As for the agreement with the International Bureau to change the route for transferring search fees indicated in paragraph 14 of the document, the Delegation requested the International Bureau to present an expected agreement between the various pairs of Offices that would participate in the pilot.

57. The Delegation of Chile supported the proposal, which would be useful for making efficiency gains in relation to transactions between Offices.

58. The Secretariat indicated that it would prepare a model agreement as requested by the Delegation of Japan and circulate this among members of the Working Group. The Secretariat would also be willing to discuss the problems related to participation in the pilot that delegations had indicated. Delegations from certain Offices would also be approached to invite them to participate in the netting pilot project.

59. The Working Group noted the contents of document PCT/WG/10/6 and invited the International Bureau to prepare a draft model agreement for use by all participating receiving Offices and International Authorities.

SECOND SUPPLEMENT TO “ESTIMATING A PCT FEE ELASTICITY STUDY”

60. Discussions were based on document PCT/WG/10/2.

61. The Chief Economist explained that a study entitled “Estimating a PCT Fee Elasticity” (document PCT/WG/7/6) was presented to the Working Group in 2014 and provided a first ever estimate of the overall fee elasticity of PCT applications, that is, how an applicant’s choice on whether to use the PCT or the Paris route for filing patent applications abroad was affected by changes in the international filing fee. This study pointed to a generally inelastic fee response. However, universities and public research organizations were on average more price sensitive than other applicants. As a follow up to the first study, the Working Group asked the Chief Economist to provide a supplementary study which would explore the effects of possible fee reductions for universities and public research organizations originating in different country groups, which was presented to the eighth session of the Working Group in 2015 (see document PCT/WG/8/11). Subsequent to the discussions that took place at the ninth session of the Working Group in 2016, the Secretariat had been asked to work with the Chief Economist to produce a second supplement that would provide more detailed simulations on the one hand, with respect to public research organizations and on the other hand, with respect to fee discounts that would be implemented with a maximum ceiling per applicant from which those applicants would benefit from the fee discount. The Working Group had also requested the second supplement to provide more detailed information on the approach taken to identify universities and public research institutions in the PCT database. However, as the document pointed out, the International Bureau was unfortunately not able to provide separate estimates and simulations for public research organizations since the sample size was not sufficient to come up with a meaningful estimate; the database only contained 78 patent families with a public research organization from a developing country, and 90 per cent of those patent families had a PCT equivalent. All the estimates in the document therefore related to university applicants, and the distinctions made between those located in developed and developing countries; the definition of a developing country followed the list published in the *Official Notices (PCT Gazette)* – 12 February 2015. In addition to the simulations, the study showed the distribution of university PCT applicants in developed and developing countries based on

number of applications filed. Around 64 per cent of universities from developed countries filed between one and five international applications in a given year and that share was significantly higher for universities from developing countries, which suggested that universities in developing countries were smaller entities. This difference was important for understanding the simulation results given that by applying the fee elasticity estimate from the first supplementary study to the university applicant base from both developed and developing countries, all university applicants were assumed to behave in the same way. As a caveat, small entities, such as universities filing fewer than five international applications per year, would not necessarily have the same fee sensitivity as large universities filing more than 100 international applications in any given year. However, in view of the relatively low number of observations, it was difficult to provide separate fee elasticity estimates depending on the size of the applicant. The simulations therefore assumed that all universities in developing countries behaved in the same way, and likewise for all universities in developed countries. The document then simulated the number of additional filings and the associated income loss for different ranges of fee discount (25, 50 and 75 per cent) and ceiling levels on the number of international applications for which an individual applicant would be able to benefit from the fee discount. For developed countries, a fee discount of 25 per cent and a ceiling of five international applications would result in around 25 additional filings with an estimated income loss of 780,000 Swiss francs, while a fee discount of 75 per cent and no ceiling would result in around 250 additional filings with an estimated income loss close to 7 million Swiss francs. For developing countries, a fee discount of 25 per cent and a ceiling of five international applications would result in around 25 additional filings and an estimated income loss of 180,000 Swiss francs, while a fee discount of 75 per cent and no ceiling would result in around 200 additional filings and an estimated income loss of around 1.4 million Swiss francs. In addition to the assumptions concerning the filing behavior of universities, a further caveat in the data was the reliance on the historical variation in PCT fees to identify the estimated parameters. Care therefore needed to be exercised for large discounts of 50 and 75 per cent, which went beyond historical variations in the international filing fee.

62. The Delegation of Brazil referred to paragraph 12 of the document and pointed out that only 3 per cent of the university applicant base in developing countries represented large university filers. There was therefore significant room for improvement of the conditions which affect the number of patent applications filed by universities, both through actions by national governments to promote innovation and support research and development in universities, as well as by the international community, such as through fee reductions at the international level. Referring to the proposal by the Delegation that had been tabled at this session of the Working Group (see document PCT/WG/10/18), the Delegation pointed out that many countries, including Brazil, already offered fee reductions for universities for national applications. The document showed that fee reductions for universities from developing countries had a very limited impact on PCT fee income, notably in case a ceiling in the number of applications filed by a university applicant in a given year were to be implemented. It was therefore high time that a fee reduction was applied for universities in developing countries, which would contribute to ensuring that the PCT System would have a positive impact on the promotion of innovation in the economies of Contracting States and allow progress in the international patent system. The Delegation further referred to paragraph 17 of the document, which stated that a given fee reduction granted to universities from developing countries would result in more additional filings compared to the same fee reduction granted to universities from developed countries. In the view of the Delegation, any fee reduction should therefore primarily target universities from developing countries as the demand would increase by a greater proportion, making this the most cost effective way of introducing a fee reduction.

63. The Delegation of the United States of America noted the difficulty in determining accurate quantitative values for the changes in the number of additional applications filed as a result of fee reductions and the consequential impact on PCT fee income. Although the Delegation had in the past supported a reduction in the international filing fee for all universities, it now appeared that administering such fee reductions in practice would be complex and potentially

open to abuse, while such reductions would not necessarily result in a predictable and large increase in the number of additional applications filed by universities that benefitted from such fee reductions.

64. The Delegation of the United Kingdom stated that there was insufficient evidence to show that the likely increase in the number of additional applications filed by universities that benefitted from such fee reductions would indeed stimulate innovation and increase the number of commercially viable patents granted to universities; rather, the granting of fee reductions might result in weaker patents and thus fewer partnerships with industry.

65. The Working Group noted the contents of document PCT/WG/10/2.

FEE REDUCTIONS FOR CERTAIN APPLICANTS FROM CERTAIN COUNTRIES, NOTABLY DEVELOPING AND LEAST DEVELOPED COUNTRIES

PROPOSAL ON PCT FEE POLICY TO STIMULATE PATENT FILING BY UNIVERSITIES

66. Discussions were based on document PCT/WG/10/18.

67. The Delegation of Brazil introduced the proposal in the document for a 50 per cent PCT fee reduction for universities from certain countries, notably developing and least developed countries. The Delegation stated that the proposal was the logical next step of the work on the overall fee elasticity of PCT applications and would facilitate a collective decision on that matter. The Working Group, at its sixth session in 2013, requested the Chief Economist to conduct a study on the issue of the elasticity of PCT fees for the groups of applicants for which data was readily available to the International Bureau, which included universities and research institutes. This study, entitled "Estimating a PCT Fee Elasticity" (document PCT/WG/7/6), was presented at the seventh session of the Working Group in 2014. The study provided the first ever estimate of the overall fee elasticity of PCT applications that is, how an applicant's choice on whether to use the PCT or the Paris route for filing patent applications abroad was affected by changes in the international filing fee. It showed that universities and public research organizations were more price sensitive than other applicants. At the eighth session of the Working Group in 2015, the International Bureau confirmed the finding that, within that group, universities and public funded research institutions from developing countries were the most price sensitive (see document PCT/WG/8/11). The conclusion of the study was that those universities were eight times more sensitive to variations in PCT fees compared to an "ordinary" applicant. Responding to the invitation by the Chair at that session to present proposals that dealt with the issue of foregone income in relation to new fee policies (see paragraph 50 of document PCT/WG/8/26), Brazil tabled a proposal for a fee reduction for universities and public research organizations from certain countries at the ninth session of the Working Group (see document PCT/WG/9/25). This proposal received general support from potential beneficiary countries, while other delegations suggested discussions of a fee reduction that included developed countries. Some delegations also expressed concerns regarding the definition of a public research organization and the financial impact of the fee reduction (see paragraphs 85 to 122 of the Report of the ninth session of the Working Group, document PCT/WG/9/28). Some delegations, including four regional groups, also expressed broad support for the proposal in document PCT/WG/9/25 at the forty-eighth session of the PCT Assembly in October 2016 (see paragraphs 6 to 17 of the Report of that session, document PCT/A/48/5). At this session of the Working Group, the International Bureau had prepared a second supplement to the study "Estimating a PCT Fee Elasticity" (see document PCT/WG/10/2), which provided new simulations and confirmed that, regarding universities from developing countries, "the same fee discount yields a small absolute filing response but a bigger relative response in developing compared to developed countries" (see paragraph 17 of document PCT/WG/10/2). Additionally, this study contained scenarios of the effects of different annual ceilings with regard to additional applications and the financial cost to PCT fee income. The study cautioned that "the lower the ceiling for eligible applications, the weaker the filing response" (see paragraph 17 of document PCT/WG/10/2). This implied that any such ceiling should be high enough to generate an effective fee response.

68. The Delegation of Brazil continued by explaining that, since the ninth session of the Working Group, it had engaged in informal discussions with interested delegations to share ideas on PCT fee policy. There had been general support for the proposal made to the ninth session of the Working Group, with some States preferring a more ambitious proposal, while others preferring something more cautious. Considering the general support, Brazil had presented the proposal in the document for this session of the Working Group. The document contained a revised proposal on fee reductions focusing on universities from certain countries in a tiered approach. In the first phase, it was proposed that a fee reduction would be approved of at least 50 per cent for universities from certain countries, notably developing and least developed countries, taking advantage of the current country-based criteria used for fee reductions. During this stage the economic impact would be limited when compared to a horizontal reduction for all Member States. In a second phase, Member States would evaluate the results and decide on whether to extend it to universities from developed countries or to benefit public research organizations from beneficiary countries. Taking into account comments received from some Member States regarding financial sustainability and the findings of the second supplement to the study “Estimating a PCT Fee Elasticity”, the Delegation proposed a ceiling of 20 applications per university per year. Referring to the Figures 1b and 2b of the study, this ceiling would generate 102 additional international applications per year at an annual cost of 660,000 Swiss francs. In April 2017, the Director General had announced a surplus of 32 million Swiss francs for WIPO in 2016. The possible annual loss of revenue would represent a very small fraction of this surplus and would have concrete, positive effects on filings by universities. As PCT applications contributed to the advancement of innovation and helped disseminate technology, in the short term, the additional 102 applications would bring to the market new, more efficient products and services. In the medium and long term, the fee reduction would further stimulate research and development. Additionally, those 102 additional applications would correspond to 6 per cent of all applications filed by universities from developing countries in 2015, which was a robust result in view of the reduced numbers of applications from these countries. Considering that some delegations had expressed concerns with the definition of public research organizations at the ninth session of the Working Group, the revised proposal in the document restricted the fee reduction to universities, which would need to be accredited with the competent authority of the respective Member State, but could be public or private. In this way, all universities from beneficiary countries would receive the reduction. As a result, this could enhance the use of their resources for research and development. Moreover, national lists of accredited universities could be made available and communicated to the International Bureau. With regard to beneficiary countries, the proposed amendment to the Schedule of Fees in the Annex to the document relied on the same criteria applied in item 5 of the Schedule, which had been discussed at length by Member States before arriving at a balanced consensus. Furthermore, at the ninth session of the Working Group, one delegation had suggested the introduction of an evaluation period for the fee reduction. This was provided for in the final sentence of the proposed amendment to the Schedule of Fees, where the criteria set out in the proposed new item 6 would be reviewed every five years by the PCT Assembly. This would also give enough time to consider the initial implementation of the proposal. In terms of the concerns raised at the ninth session of the Working Group about financial sustainability and income neutrality, the Delegation acknowledged that these concerns were legitimate ones. Brazil was committed to WIPO maintaining a healthy surplus due to its PCT fee income, and the proposal would not have been made if the Delegation believed that this surplus could be jeopardized. The reality, however, was that a holistic analysis of the WIPO budget showed that the budgetary impact of the proposed fee reduction would be minimal. According to the studies presented by the International Bureau, the proposal would maximize the number of additional PCT applications but would result in a loss of only a mere 0.2 per cent of total PCT revenue for 2016, estimated to be 285 million Swiss francs. Today, there were two main fee discounts in the PCT System, one that applied to electronic filing and mainly benefited developed countries, and the other that provided discounted benefits for certain countries but excluded the most effective users of the PCT System. According to the Program and Budget 2016/17, the electronic filing fee discount resulted in forgone revenue of 48.4 million

Swiss francs for 2016. By contrast, the proposal would incur a smaller revenue loss of 660,000 Swiss francs. Moreover, in the Memorandum by the Director General titled “The PCT System – Overview and Possible Future Directions and Priorities” published on February 2, 2017, it was stated that original objective of electronic filing-related fee reductions had been accomplished with fewer than 5 per cent of applications being filed on paper. The discount proposed in the document would be a powerful boost to attain one of the most important goals in the mission of WIPO to promote intellectual property in countries as an instrument for innovation, knowledge and economic growth, and indeed, as a tool for development. In this sense, it was important to consider the reduction as well-allocated resources, and not as foregone income or revenue losses. As stated by the Secretariat at the sixth session of the Working Group when discussions had begun on fee reductions, fees in essence served two distinct functions: to recover costs, and to serve as a regulatory tool to influence filing behavior (see paragraph 179 of the Report of that session, document PCT/WG/6/24). The proposal in the document aimed at making full use of PCT fees as a regulatory tool by positively influencing the filing behavior of universities but without substantially affecting the cost recovery function of those fees. The implementation of such a fee policy would enable the use of a large pool of scientific and technological talent in these universities. There was a genuine need to tap this knowledge source and to create additional incentives to enable the production of innovative products and services. The proposed fee reduction would encourage the use of the PCT System and increase the diversity in the geographical composition of applications, generating additional demand in the medium term for PCT services, which was fully in line with the mission of WIPO. In conclusion, the Delegation called on all Member States to support and approve the proposal. The revised proposal reflected Brazil’s intensive discussions with many other delegations, and by addressing everyone’s concerns, the Delegation had produced a stronger proposal.

69. The Delegation of Senegal, speaking on behalf of the African Group, recalled that representatives of various regional groups had endorsed the idea of fee reductions for universities and public research organizations at the ninth session of the Working Group. The Delegation agreed with the objectives of the proposal in the document to stimulate the use of the PCT by universities, and also to increase the geographical diversification of international patent applications. The gradual approach to introducing the fee reductions, as well as the percentage reduction proposed, would guarantee an optimal implementation of the proposal to achieve the expected results. Furthermore, the proposal took into account the parameters on the economic impact, including concerns on extending fee reductions to public research organizations. Finally, the proposal took account of macro budgetary indicators of WIPO necessary for its proper functioning. The African Group therefore reiterated its support for the proposal in the document.

70. The Delegation of Colombia, speaking on behalf of the Group of Latin America and the Caribbean (GRULAC), including those States who were observers to the Working Group, expressed its support for the proposal in the document. The proposal was based on solid estimates made by the Chief Economist in document PCT/WG/7/6, as well the first and second supplementary studies in documents PCT/WG/8/11 and PCT/WG/10/2, respectively, that universities in developing countries were eight times more sensitive to prices than a normal applicant. This implied that a fee reduction for university applicants from developing countries was the most effective and profitable alternative. The revised proposal in the document included language which responded to the concerns expressed by delegations during the ninth session of the Working Group as regards the beneficiaries and the financial impact of this reduction. These changes were reflected in the text by limiting the beneficiaries to universities with a maximum of 20 applicants per year. At this maximum, the estimated cost would be 660,000 Swiss francs per year, which represented a mere 0.23 per cent of total income of WIPO and would have concrete and positive effects for beneficiary countries. The implementation of this fee reduction would enable the use of a large pool of scientific and technological talent in these universities. There was a real need to take advantage of this knowledge resource and stimulate the development of products as well as innovation. The proposal would be a positive step in the right direction by fostering innovation and creativity in accordance with the broader objectives of

the PCT System. GRULAC therefore appealed to all Member States to consider positively the proposal, which was duly structured and took account all the technical considerations, which made it a serious and feasible project with a phased implementation to allow its proper evaluation.

71. The Delegation of Tajikistan, speaking on behalf of the Group of Central Asian, Caucasus and Eastern European Countries (CACEEC), supported the proposal, which it considered had merit and would stimulate patent filing by universities, notably in developing and least developed countries, including members of the CACEEC. The proposal could also increase the diversity in the geographical composition of international applications. According to the estimates by the Secretariat, the possible loss of income from the proposal represented a minor fraction of the projected surplus for WIPO, and therefore CACEEC called upon States to approve the proposal.

72. The Delegation of Turkey, speaking on behalf of Group B, opposed the suggestion in paragraph 13 of the document to discuss the proposal in tandem with measures intended to reduce the number of fee reductions being claimed by applicants not intended to be eligible for the reduction, as contained in document PCT/WG/10/8. Document PCT/WG/10/8 proposed to include more clear language in the Schedule of Fees to explain which applicants could legitimately benefit from the fee reduction, and was therefore unrelated to the document under discussion. Moreover, document PCT/WG/10/8 presented a common sense solution to a problem, which would cost little to implement and could significantly reduce cases of abuse. Group B believed that the appropriate order of discussion on fee reductions should be to discuss the progress report in document PCT/WG/10/20 to see how fee reductions were working in practice, then the proposal by the International Bureau in document PCT/WG/10/8 to clarify the Schedule of Fees, which should be adopted without delay. The Delegation therefore suggested moving promptly to the progress report and the proposal by the International Bureau after conclusion of proposal on PCT fee policy to stimulate patent filing by universities.

73. The Delegation of Iran (Islamic Republic of) commended the proposal in the document. The proposal was based on the results of studies by the International Bureau which had confirmed that universities and publicly funded research institutions from developing countries were most sensitive to changes in PCT fees. Like other developing countries, universities and public research institutes played a key role in creativity and innovation in Iran (Islamic Republic of), which would be stimulated with a fee reduction, thereby providing a motivation to use the PCT System. A fee reduction for universities and public research institutes from developing countries would make the PCT System more accessible for potential users in these organizations and increase the geographical diversity in filings of international patent applications as it could promote the use of the PCT System by more applicants from different countries. The Delegation acknowledged the possible loss of revenue but reminded the Working Group that the proposal was not restricted to developing and least developed countries since a possible extension to developing countries would be considered in the second phase. Given the extensive discussions on the consequences of the proposal and the widespread support from Member States and regional groups, the Delegation called on the Working Group to approve the proposal at the current session.

74. The Delegation of Indonesia welcomed the proposal in the document and encouraged other Member States to support and approve the proposed fee reductions.

75. The Delegation of Egypt supported the proposal in the document, which would enhance the role of universities and their contribution to the patent system and IP in general. Moreover, the proposed fee reduction would not have an adverse effect on the annual revenue of WIPO since the projected loss represented a small fraction of the surplus of the Organization.

76. The Delegation of Uganda aligned itself with the statement made by the Delegation of Senegal on behalf of the African Group. Universities from developing and least developed

countries were no longer mere recipients of information and knowledge; they were also contributors of knowledge. Their contributions therefore needed to be encouraged through guaranteeing access to affordable internationally-available IP protection systems, including the PCT System. The Delegation therefore supported the proposal by Brazil for a reduction of fees for applicants from universities of developing and least developed countries, to encourage more applications through the PCT System. The Delegation was mindful of the financial implications of the proposal to the revenue of WIPO, but it also took note of the briefing of the Director General to Ambassadors on April 20, 2017, where the Director General informed Member States that the Organization had a substantial surplus in its revenues and the projections of further growth were also encouraging. Therefore, the Delegation believed that the proposed reduction in fees for applicants from universities from developing and least developed countries would not pose a great threat to the revenue of the Organization, and it looked forward to approval of the proposal by the Working Group.

77. The Delegation of China, speaking on behalf of the delegations representing the BRICS States at the session, expressed its support for the proposal, which would adjust fee reduction policy in the right direction for the development of the PCT System. It would not only give better encouragement to university innovation and creativity, but also further promote technology dissemination and expand accessibility. By extending the scope of fee reductions to universities, especially those from developing countries, the proposed fee reduction for universities would be a real assistance by WIPO for developing countries in enhancing innovative activities, as a valuable supplement to training and education programs carried by the Organization. As indicated in the proposal, the reductions would also give potential applicants from universities the opportunity to file more PCT applications, which might, to a great extent, balance the revenue loss to WIPO from the reductions.

78. The Delegation of Nigeria recalled the positive developments in the PCT System, including the 3 millionth published international application in February 2017. In that context, the Delegation supported the proposal by Brazil, which was comprehensive, well thought out had taken into account the concerns that delegations had raised in the past. And in that context Nigeria wishes to lend its support to the proposal that has been made by Brazil. From the study in document PCT/WG/10/2, the revenue loss to WIPO represented a small fraction of total income for the Organization. The proposed fee reductions would facilitate development and foster innovation, facilitate transfer of technology, increase diversity of applicants to PCT System and would serve to promote socio-economic development for wider geographic participation. The Delegation concluded by encouraging other Member States to support the proposal.

79. The Delegation of Morocco endorsed the revised proposal of Brazil. The proposed reductions had been based on statistics from studies by the International Bureau and would encourage creativity in universities.

80. The Delegation of South Africa aligned itself with the statements made by the Delegation of Senegal on behalf of the African Group and the Delegation of China on behalf of the delegations representing the BRICS States at the session. Universities played an important role in improving the innovative capacities of nations, notably in developing and least developed countries where industrial development had not yet taken root. One of the roles of WIPO was to stimulate innovative capacities of Member States, which this proposal would aim to fulfill. The Delegation acknowledged concerns about financial impact, which had been addressed by including a ceiling of 20 international applications, as well as limiting beneficiaries to universities.

81. The Delegation of the United Arab Emirates supported the general principle behind the proposal by Brazil in that it aimed to stimulate international patent filing by universities. However, the Delegation believed that any fee reduction policy for universities should be expanded to all PCT Member States, with particular attention to developing countries. The

performance of these universities should set the eligibility to grant this fee reduction, which would increase the diversity in geographical composition of requests for international applications and would encourage the use of PCT System.

82. The Delegation of Qatar endorsed the proposal by Brazil and aligned itself with the comments made by the Delegation of United Arab Emirates.

83. The Delegation of India aligned itself with the statement made by the Delegation of China on behalf of the delegations representing the BRICS States at the session. The Delegation believed that fee reductions for various categories of applicants such as individuals, small and medium-sized enterprises (SMEs), startups, and universities and research institutions served to achieve an objective to incentivize them to promote their innovations and also encourage them to further promote research and development activities since applications from these types of applicants were very cost sensitive. The Delegation informed the Working Group that in 2014, India had extended fee concessions to SMEs to the extent of 50 per cent as compared to legal entities in order to promote innovations in this sector. Considering the impact and in order to further promote the innovations, again in May 2016, India had further extended the fee concessions support to startup companies to the extent of 80 per cent and also introduced a facility of expedited examination for their applications to enable them to harness the benefit of their new innovations by early commercialization. Furthermore, India had also registered facilitators to assist startups for applying for patents, trademarks and designs, with the Indian Patent Office reimbursing the fee of the facilitators. Many inventions from universities in the past had contributed to well-being of mankind and latest technological developments. Moreover these universities had a large pool of scientific and technological talent, where there was a genuine need to tap this fertile knowledge resource to stimulate the creation of IP assets. Therefore, the Delegation believed that the proposal of Brazil for a fee reduction to the universities from developing and least developed countries was a welcome step, which would provide further impetus in boosting creativity and innovations in universities and technical institutions, especially to protect their inventions globally by utilizing the PCT System. At the same time, the reductions would not have any major financial impact on WIPO. Accordingly, the Delegation continued to support the proposal of Brazil regarding fee reduction to universities in developing and least developed countries.

84. The Delegation of Lesotho aligned itself with the statement made by the Delegation of Senegal on behalf of the African Group and supported the proposal submitted by Brazil. The envisioned benefits of the proposal were developmental at the core and would stimulate use of the PCT System by universities and widen the geographical diversity of filing countries, including least developed countries.

85. The Delegation of Tunisia supported the proposal made by Brazil, which it considered to be well-founded. Encouraging the creation of innovative projects required enhancing results of research, which was the beginning of a project. Helping universities to file more patents by reducing fees would have a positive impact and encourage innovations in developing and least developed countries.

86. The Delegation of Georgia supported the aims of the proposal, which it considered would be an effective tool to create opportunities to stimulate innovation in universities in developing and least developed countries. The Delegation, however, stated that it needed more time to explore the details of the proposal before being able to consider giving it its full support.

87. The Delegation of the Russian Federation supported the proposal, which it believed would contribute to inventive activity in universities of developing countries. If the proposal were to be implemented, it would be a good addition to WIPO training and education programs in developing countries. The Delegation believed that the potential income losses to WIPO which might arise due to the fee reductions could be considered an investment for the whole PCT community and further expand the PCT System.

88. The Delegation of China supported the proposal of PCT fee reductions for universities, hoping this could stimulate the use of the PCT System by more countries globally, thus enhancing the influence of the PCT System and boosting the consistent increase of international applications. Based on the discussions of this session, the Delegation considered that the proposal could be improved in some aspects such as the percentage of the reduction, the scope of the universities being eligible, and the ceiling on the number of applications. Extending the fee reduction to universities would have some impact on the income of WIPO, but according to a survey of users in China, nearly 70 per cent of universities and scientific institutions indicated that they would file more applications if they could benefit from a fee reduction. The Delegation suggested that the fee reductions could be applied for an initial three year period as a pilot, after which the effects could be evaluated before deciding whether to revise the pilot.

89. The Delegation of the United States of America stated that, having reviewed the proposal and the studies and data on fee elasticity presented on fee elasticity by the International Bureau, it did not believe that the proposal presented an effective and workable way to promote additional innovation and commercialization of inventions developed in universities. The Delegation supported the statement made by the Delegation of Turkey on behalf of Group B that opposed the suggestion in paragraph 13 of the document to discuss the proposal in tandem with the measures proposed to reduce the number of fee reductions being claimed improperly in document PCT/WG/10/8. To the extent that there might be a natural surplus in the WIPO budget for the current biennium, the Delegation considered that such surplus should be given to applicants by fee reductions to all PCT applicants rather than attempting to target it to only specific users.

90. The Delegation of Portugal recognized merit in the proposal, which would aim to stimulate research and development in universities and promote PCT filings given that the numbers of applications by universities were more price-sensitive. Although the Delegation recognized merit in the proposal and agreed with the underlying principles, it believed that discussions regarding the proposal should continue in order to improve it.

91. The Delegation of the United Kingdom stated that it remained unconvinced that reducing fees for universities would achieve the aim of stimulating innovation since there was insufficient evidence that increasing the number of applications from universities would result in a significant increase in patents which were commercially viable. The Delegation was therefore unable to support the proposal at this stage.

92. The Delegation of Israel supported the interventions made by the Delegation of Turkey on behalf of Group B and the Delegations of the United States of America and the United Kingdom. The Delegation believed that these types of fee reductions could be more effectively implemented on a national level. For example, the Israel Patent Office introduced a fee reduction of 40 per cent for public universities in Israel in 2015. In conclusion, the Delegation believed that the current proposal would not fulfil its stated goal and for this reason the Delegation could not support it.

93. The Delegation of Denmark expressed support for the statement made by the Delegation of Turkey on behalf of Group B that the proposal in the document was separate from that relating to tackling abuse of the eligibility for the 90 per cent fee reduction in document PCT/WG/10/8. Both proposals therefore needed to be treated separately. As the Delegation had stated at the ninth session of the Working Group, it had difficulties with introducing PCT fee discounts for special groups such as universities and public research organizations. In this regard, the Delegation supported the view of the Delegation of Israel that it would be more beneficial for applicants with limited resources to test their application at a national level before embarking on a more expensive international patent system. Moreover, it should be up to national policies in Member States to provide such support if they believed that fee discounts would foster innovation. Furthermore, the main costs of obtaining patent protection were

associated with advisors and translations rather than payment of official fees. For Danish applicants in Denmark, the official PCT international filing fee would amount to a very small fraction, 3 per cent, of the total cost associated with filing and processing a PCT application and subsequent national phase entries. With regard to the aims of the proposal as outlined in the summary of the document, the Delegation of Denmark was not convinced that these aims justified a PCT reduction. First, the Delegation did not believe that it should be a purpose in itself to merely increase the number of international applications. While universities should take measures to foster innovation that would translate into applications and commercial returns, the Delegation did not believe that the PCT fees were an impediment to filing an international application when compared to costs for attorneys and translators. Second, the Delegation questioned whether a fee reduction was the best tool to increase geographical diversity in PCT applications. Instead, the PCT System could be promoted by offering better framework conditions unrelated to IP and raising awareness of intellectual property rights. On a more detailed point, the proposal did not mention what constituted a university, which would lead in to difficulties in administration of such reductions. At this point in time, the Delegation was therefore not able to support the proposal.

94. The Delegation of Canada supported the statement made by the Delegation of Turkey on behalf of Group B and the comments made by the Delegation of Denmark with respect to where the majority of costs in bringing an invention to market lay. While the Delegation could support the general idea of fee reductions for international applications from universities, these reductions needed to be applied on an equal footing for all universities. However, the Delegation had concerns regarding the differences applied by States on what constituted a university, and therefore did not believe that Member States should be left to apply their own national definitions and eligibility criteria. Any definition based on national accreditation would also be difficult to enforce for applications filed at the receiving Office of the International Bureau given that it would be impractical for the International Bureau to maintain a list of all qualifying institutions and to verify that fewer than 20 international applications had been filed by an institution in a given year. The administrative, IT and related financial burdens to administer the proposal would therefore need to be estimated to arrive at a comprehensive analysis of the benefits of the proposal. The Delegation supported measures to ensure that procedures and fee structures were appropriate to encourage the use of PCT System in a manner that was efficient and beneficial for all applicants and which followed an established, clear, efficient and objective process, and it was open to discussions in that regard. In summarizing the discussions of the first supplement to “Estimating a Fee Elasticity Study” (document PCT/WG/8/11), the Chair stated that the issue of fee reductions for universities and government research institutes “needed to be considered in a holistic manner, also addressing the issue as to how to compensate for any losses” (see paragraph 19 of the Summary by the Chair of the eighth session of the Working Group, document PCT/WG/8/25). Using a surplus that would not always be realized did not address how any losses in fee income would be compensated for in the long term. Furthermore, the Delegation noted that the surplus of 80 million Swiss francs for the 2014/15 biennium indicated in document PCT/WG/10/18 was higher than the figure of 32 million Swiss francs for 2016. The Delegation therefore could not support the proposal in its present form.

95. The Delegation of Spain supported the statement made by the Delegation of Turkey on behalf of Group B disagreeing with the comments in paragraph 13 of the document since the proposal for fee reductions was a separate measure from the International Bureau tackling the abuse by applicants of an existing fee discount. As for the proposal itself, the Delegation saw merit in having a ceiling of 20 applications per university per year. The proposal, did, however, have generalized widespread repercussions on fee income, despite the surpluses being reported in recent years.

96. The Delegation of the Republic of Korea acknowledged that the studies by the International Bureau showed that PCT filings from universities in developing countries were more responsive to fee reductions than those in developed countries, but in general terms the

numbers of filings were inelastic. While the idea of a fee reduction for universities from developing countries had some merits, this would be better discussed from the perspective of PCT fee income. If the object of fee reductions for universities in developing countries was to encourage universities to participate in patenting activity, then the Delegation believed that the fee reduction should also be applied to universities in developed countries. In this way, research and development activity and innovation in universities would be treated in an equal and fair manner.

97. The Delegation of Australia noted that while many issues for consideration by the Working Group were related to the administration and operation of the PCT System, attending to aspects of day-to-day business, the proposal in the document was different in that it addressed the purpose of the PCT System to incentivize and reward innovative activity. The Summary by the Chair of the eighth session of the Working Group (document PCT/WG/8/25) invited members to come forward with proposals with respect to fee reductions for universities and publicly funded research organizations. Brazil had followed up on this and the Delegation thanked the Delegation of Brazil for engaging in discussions in this regard and bringing forward a revised proposal to this session. Removing publicly-funded research institutes that would be difficult to define and proposing a limit of 20 international applications per year were sensible approaches to limiting the impact on the budget of WIPO. There remained issues to discuss such as the definition of a university, such as whether it included privately-funded as well as publicly-funded universities. In addition, the Delegation noted that least developed countries were still part of the proposal, even though all applicants from these countries already qualified for fee reductions of 90 per cent. But more particularly, a targeted fee reduction could lead to further gaming of the system, resulting in abnormal filing behaviors as reported in document PCT/WG/10/8. Moreover, it was more difficult for a receiving Office or the International Bureau to determine whether universities were gaming the system since they filed more applications than natural persons and often filed in the name of a university before assigning the rights to a different entity. The Delegation realized that fee reductions could potentially eliminate impediments to filing PCT applications, but there was a need for caution. The studies by the International Bureau have shown that the effect of the proposed fee reduction would be to bring 102 applications that would have been filed through the Paris route into the PCT route. The question to ask was therefore whether the cost of 600,000 Swiss francs was an appropriate price to pay for transferring these applications into the PCT System. The costs and benefits therefore needed further analysis. But returning to the purpose of the proposal, a key issue that universities confronted was to understand whether seeking patent protection would be useful. IP Australia was a donor to WIPO Patent Information Services (WPIS) and provided up to 20 state-of-the-art searches per year for intellectual property offices in developing countries that had limited resources to perform substantive examination. The reports from these searches provided a means for applicants to evaluate their invention compared to the prior art and to use that evaluation to decide whether or not to file applications in the international patent process. As of January 2016, IP Australia had expanded this contribution to include examination reports with those state of the art searches, but this service had not been used. The Delegation therefore believed that there was opportunity to increase awareness of this service. Other IP Offices provided searches for WPIS, and with more Offices doing so, there could be more than 250 free searches for universities in developing countries, which would provide real assistance to those universities. The Delegation concluded that it was willing to engage in further discussion on fees, but in the meantime, more use of WPIS could be made by universities in developing countries.

98. The Delegation of Switzerland acknowledged the goal sought by this proposal to increase patenting by universities, but it remained unconvinced that international filing fee reductions were the most appropriate way to achieve this goal. The Delegation supported the statement made by the Delegation of Turkey on behalf of Group B in opposing the suggestion in paragraph 13 of the document to discuss the proposal in tandem with measures intended to reduce the number of fee reductions claimed by ineligible applicants in document PCT/WG/10/8. Moreover, the Delegation of Switzerland had other concerns and endorsed the

comments made by the Delegations of the United States of America, the United Kingdom and Denmark. Referring to the proposal by Brazil, the Delegation of Switzerland pointed out that while the studies in documents PCT/WG/7/6 and PCT/WG/8/11 showed higher elasticity for universities and public research organizations, it was important to remember that the main conclusion of these studies was that PCT fees were highly inelastic. It was therefore important that a cost-benefit analysis was made on the proposal by Brazil. The Delegation also noted the comments in paragraph 16 of the second supplement to the fee elasticity study in document PCT/WG/10/12 that “simulation of additional filings for large fee reductions – especially 50 per cent and above – should be treated with caution”. In other words, a fee reduction was not the right way to stimulate filings by universities, and the Delegation stated that it would be open to discuss other potential ways to achieve this objective.

99. The Delegation of Turkey, speaking in a national capacity, supported the statement that the Delegation had made on behalf of Group B that the fee reduction for certain universities should not be discussed in tandem with measures intended to reduce the number of fee reductions being claimed by ineligible applicants contained in PCT/WG/10/8. The Delegation believed that Universities played an important role in economic and technological development by converting scientific innovations into patenting activity and licensing the output of their academic research. In this regard, the Delegation informed the Working Group that an important revision in its national law had recently entered into force concerning the ownership of patents by universities which enabled universities to be entitled to ownership of the patents for inventions that it had developed. Through this change, Turkey was aiming to enhance the existing innovative potential of universities. The Delegation concluded that it was ready to work further on the proposal by Brazil.

100. The Delegation of Germany supported the statement made by the Delegation of Turkey on behalf of Group B. The Delegation also raised questions about how universities would be defined in the proposal, for example, whether it would cover both small and large universities and both those that were privately and publicly-funded. In addition, the Delegation raised the issue of whether any threshold should be defined with regard to budgets of universities. The Delegation also asked whether the reductions in the proposed item 6 to the Schedule of Fees in the Annex to the document would be cumulative with the existing reductions in item 5. But more importantly, it was necessary to consider the merits of the proposal, where the Delegation endorsed the comments made by the Delegations of the United States of America, the United Kingdom, Israel, Denmark and Canada. In relation to supporting innovation in universities by fee reductions at a national level, this could be implemented more easily, noting that the existing reductions in item 5 of the Schedule of Fees were prone to be abused by applicants that were not intended to benefit from such reductions. Furthermore, PCT fee elasticity was highly inelastic. The proposal by Brazil therefore did not appear to be the most useful way to increase patent filings for universities to stimulate innovation. The Delegation was therefore not in a position to support the proposal at this stage.

101. The Delegation of Japan supported the statement made by the Delegation of Turkey on behalf of Group B. The Delegation shared the intention of the proposal to further promote the use of the PCT System, especially by universities, but remained unconvinced by the rationale behind the proposal. The Delegation also underlined that the PCT fees were the source of the majority of revenue for WIPO, and it was therefore necessary to take a cautious approach on the adoption of additional fee reductions, taking into account the financial burden covered by users who would not be benefiting from the proposed measure. In addition, it had not been demonstrated that the fee reduction was an appropriate means of responding to the request to promote research and development activities in developing countries. It was therefore necessary first to clarify this point before discussing the issue of fee reductions.

102. The Delegation of Botswana aligned itself with the statement made by the Delegation of Senegal on behalf of the African Group. The Delegation therefore supported the proposal made by Brazil and believed that reducing the fees could have a major impact in improving the PCT System and encouraging innovation at the same time.

103. The Delegation of France endorsed the statement made by the Delegation of Turkey on behalf of Group B. The Delegation favored the measures that would make the PCT System more accessible for certain applicants and help increase patent filings, but any fee reduction needed to be envisaged within a balanced budget, noting that revenue from the PCT was used to finance many WIPO activities. As for the proposal by Brazil, the Delegation shared the concerns that had been expressed, including those by the Delegations of the United Kingdom, Denmark, Canada and Australia. Finally, the Delegation agreed with the remarks made by the Delegation of Switzerland that the studies on PCT fee elasticity that the International Bureau had performed were not conclusive that reductions would have a positive impact on patent filings by universities given that PCT fees were highly inelastic.

104. The Representative of the Patent Office of the Cooperation Council for the Arab States of the Gulf (GCC Patent Office) expressed support for the proposal which would increase the filing of applications from universities in developing and least developed countries and aligned itself with the comments made by the Delegations of United Arab Emirates and Qatar, which were both GCC Member States.

105. The Delegation of Brazil aligned itself with the statements made by the Delegation of Colombia on behalf of the Group of Latin America and the Caribbean (GRULAC) and the Delegation of China on behalf of the delegations representing the BRICS States at the session. The Delegation acknowledged the broad support for the proposal, which gave incentives to applicants from universities but had a low financial impact, which could be seen rather as an investment. The Delegation continued by addressing some of the concerns and comments that were expressed by other delegations. First of all, regarding the extension of the proposed fee reduction to developing countries, the second phase of the proposal would require an evaluation to discuss measures to extend the benefits to all universities. The Delegation was in favor of supporting research and development activities by universities, for which it saw many merits and benefits and it wished to enhance these activities by appropriate use of fees as a regulatory tool. Referring to activities to support research and development by universities by other Member States, the Bayh-Dole Act of 1980 had been credited with stimulating industry technology transfer and research collaboration in the United States of America. The Bayh-Dole Act had sought to facilitate patenting and licensing by universities of inventions based on federally-funded research and was complemented with a reduction of 50 per cent for universities in a range of fees at the United States Patent and Trademark Office (USPTO), including the filing and maintenance fees. The PCT search fee at the USPTO was also subject to the 50 per cent reduction for universities, and the European Patent Office offered a 30 per cent fee reduction for universities. In addition, the accelerated commercialization program in Australia allowed researchers to apply for assistance through a university or other publicly funded research organization. Countries such as Japan also had programs that aimed at promoting cooperation between industry and universities, such as the Japan Innovation Network. Moreover, the Delegations of Israel, India and Canada had referred to fee reductions offered to universities, which were also offered in Brazil. Regarding the costs that were associated with filing international applications such as those of attorneys and translators, it was not realistic to address these costs through the PCT. In this regard, Member States had national policies such as programs aimed at qualification of patent attorneys and courses on patent drafting. And WIPO had the Inventor Assistance Program launched in October 2016, which was at a preliminary stage. These discussions on assistance programs for inventors were relevant for discussions within WIPO, but the PCT Working Group was not the most appropriate forum. By contrast, the proposal was aimed at a specific impediment to defining PCT fees that could be solved in the Working Group. Secondly, the Delegation referred to comments regarding the commercialization of inventions made by universities, which followed

the filing of a patent application. Whatever patent was granted, universities would be able to license, sell or explore partnerships with the private sector for the commercialization of the invention protected by the patent. The proposal for a fee reduction would thus create incentives for the filing of applications for future commercial exploitation which could generate relevant results in terms of income for those applicants. Studies by the Innovation Agency in the United Kingdom had found that universities in the United Kingdom generated 86 million pounds sterling of IP revenue in 2013. The proposal would work in that direction by allowing universities, through their inventions, to work as an instrument for economic growth and creativity and explore partnerships with industry. Referring to the existing fee reductions for least developed countries under item 5(b) of the Schedule of Fees, this could work alongside the proposal, thereby providing an additional 50 per cent discount. However, the Delegation was open to discussion on this matter, but acknowledged that least developed countries were entitled to efforts by the international community to spur economic growth and development. The Delegation disagreed with the comment by the Delegation of Denmark that the PCT was not an impediment to patenting by universities, which it believed had been proven in the studies by the Chief Economist. Regarding the definition of universities, the Delegation referred to the footnote in the proposed modification of the Schedule of Fees, which proposed that each Member State inform the International Bureau of the list of accredited universities. To establish a university was not a mere act like starting a business, it was subject to control, evaluation and monitoring by governments. This institutional background would reduce the likelihood of abuse, and it was generally expected that an international agreement should be applied in good faith. Additionally, the proposal included a five year evaluation period, which would allow the benefits and challenges of the system to be evaluated to determine future actions to be taken. With reference to comments on the contribution of universities to economic growth, the Delegation referred to an academic paper by the economist Edwin Mansfield in 1991 entitled *Academic Research and Innovation*. Concerning the comments by the Delegation of Switzerland that fee reductions might not be the most appropriate way to increase patent filings, the Delegation of Brazil referred to the study by the Chief Economist which had shown that universities in developing countries were eight times more sensitive to fee changes than other applicants. The Delegation acknowledged the WIPO Patent Information Services (WPIS) referred to by the Delegation of Australia and stated that these could work together with the fee reductions to spur economic growth in developing countries, and were not a replacement for reductions. Finally, referring to the wish to discuss the fee reductions with other measures suggested by the Secretariat, the Delegation intended to have a broader discussion of fee reductions and noted that that the documents were grouped under the same agenda item. In the view of the Delegation, both the fee reductions and the measures to tackle abuse by applicants of the eligibility for fee reductions as a natural person should be submitted to the PCT Assembly in October 2017. Finally, with reference to the comment by the Delegation of Australia regarding the Paris route and the PCT, the PCT was designed for obtaining patent protection in several countries, was used by the majority of non-resident patent applicants, and had many advantages over the Paris route. To decide whether an invention is of sufficient commercial value and chance of being patentable for the application to be worth pursuing in other countries came in addition to the other well-known benefits in the PCT System.

106. The Chair proposed that efforts be made to advance discussions on the issue before the next session of the Working Group. The International Bureau should send a Circular before the end of July offering interested parties an opportunity to propose issues to be discussed in a workshop to be held during the next session of the Working Group. Such issues might include:

- (a) issues which had been raised in this session, such as definitions of “university”, financial impact or the relationship with the existing fee reductions;
- (b) sharing of Member States’ national or regional fee reduction programs; and

(c) other measures which might be considered as additions or alternatives to fee reductions as ways of stimulating innovation by universities in developing countries and elsewhere.

107. The responses should be made publicly available and may serve as the basis of both the agenda of the workshop and further proposals by Member States.

108. The Working Group invited the International Bureau to issue a Circular as set out in paragraph 106, above, and to convene a workshop, to be held during the next session of the Working Group.

109. The Delegation of Brazil expressed appreciation for the broad support for its proposal regarding fee reductions for universities and was grateful for the statements by the Delegation of Senegal on behalf of the African Group, the Delegation of Colombia on behalf of the Group of Latin America and the Caribbean (GRULAC), the Delegation of Tajikistan on behalf of the Group of Central Asian, Caucasus and Eastern European Countries (CACEEC), the Delegation of China on behalf of the BRICS delegations attending the session, the Delegations of Iran (Islamic Republic of), Indonesia, Egypt, Uganda, Nigeria, Morocco, South Africa, the United Arab Emirates, Qatar, India, Lesotho, Tunisia, Georgia, the Russian Federation, China (in its national capacity), Portugal, and Botswana and the Representative of the Patent Office of the Cooperation Council for the Arab States of the Gulf (GCC Patent Office). These countries and regional groups represented more than two thirds of the members of the PCT. Their legitimate aspirations for the improvement of the conditions of access of their universities to the PCT System required a positive and urgent response from this Organization and, in particular, this Working Group. The approval of a fee reduction of universities from those countries would generate increased technological innovation and creativity and strengthen the PCT System, which were among the PCT's most important goals. Moreover, the reduction could be implemented in a way which did not jeopardize the PCT surplus in any way. The Delegation thanked other delegations for their constructive attitude and openness to explore potential solutions and had taken due note of your comments that had been raised, which it would positively consider when discussing a revised proposal in the near future. The Delegation did, however, regret that arguments presented by some delegations appeared to be in contradiction with views these delegations had expressed at the PCT and other WIPO bodies. The Delegation therefore hoped that these delegations could show a more constructive approach at the next session of the Working Group. The Delegation expressed willingness to listen to all delegations in the spirit of mutual respect. While the proposal had wide support, it had not achieved a consensus from Member States. The Delegation appreciated the willingness of the Working Group to continue working towards concrete measures to improve the accessibility of the PCT System to universities and underlined its commitment to positive incentives for universities to use the PCT System, especially from developing and least developed countries.

PROPOSAL TO REDUCE THE NUMBER OF FEE REDUCTIONS BEING CLAIMED BY APPLICATIONS NOT ELIGIBLE FOR THE FEE REDUCTION

110. Discussions were based on document PCT/WG/10/8.

111. The Secretariat introduced the document by explaining that at the ninth session, the Secretariat had indicated that the International Bureau was aware of more than 1,000 international applications in 2014 that had benefitted from fee reductions from applicants that should probably not have been eligible for these reductions. This corresponded to a loss of fee income for WIPO of about 1 million Swiss francs. From the figures presented in document PCT/WG/10/20, it would appear that that loss had increased to around 5 million Swiss francs for 2016. Referring to the table in paragraph 11 of document PCT/WG/10/8 which set out more details on the latest filing figures categorized by the number of applications filed by individual applicants during a given calendar year, it was clear that the number of applications benefitting from the 90 per cent fee reduction from applicants that had filed many applications had risen sharply in 2015 and 2016. The document also set out the information requested by the

Delegation of Brazil at the ninth session of the Working Group concerning the impact of charging a fee for changes under Rule 92*bis* which would result in the addition of legal entities that would not have been eligible for the fee reduction to the applicants. Paragraph 8 of the document showed that the numbers of individuals acting as an applicant on behalf of a legal entity who would appear to be the real beneficial owner were significantly larger than the number of applications in respect of which a change in the applicant was actually recorded. Efforts aimed at influencing the behavior of applicants by requesting fees for making changes under Rule 92*bis* to include an applicant not eligible for the fee reduction would therefore appear less important than clarifying the eligibility requirements on filing an international application. Consequently, the International Bureau did not intend to amend Rule 92*bis* at this stage. In summary, in view of the recent data in both documents PCT/WG/10/8 and PCT/WG/10/20, there would appear to be a more urgent need than last year to clarify the eligibility of applicants able to benefit from fee reductions in order to address the considerable loss of PCT fee income, estimated at 5 million Swiss francs for 2017 and likely to rise further if trends continued without agreement from Member States to provide a legal basis to stop this applicant behavior taking place.

112. The Delegation of the European Patent Office noted that the proposed changes confirmed an obligation but no sanction to a change of ownership to a non-eligible entity by the deletion of the proposed modification to Rule 92*bis*. One aspect that had not been touched upon at the ninth session of the Working Group was the fact that some International Searching Authorities reduced the international search fee by 75 per cent for certain applicants under similar conditions. As that fee was collected by the receiving Office, the Delegation hoped that consideration could be given to that problem in the future in order to support International Searching Authorities which had fee reduction schemes for applicants from developing countries. If such schemes were prone to abuse by applicants, this could discourage International Searching Authorities offering such discounts. Moreover, the search fee did not have to be paid at the time of filing, so it was possible to be eligible for the reduced search fee on the filing date, add a further applicant that was not eligible for the reduction a few days later, and then pay the reduced search fee even though the applicants had ceased to be eligible for the fee reduction.

113. The Secretariat confirmed that the proposed modification to Rule 92*bis* to apply a fee for a transfer of ownership to a non-eligible applicant in document PCT/WG/9/10 had been removed. The proposal in the document aimed at clarifying the eligibility for fee reductions at the time of filing. In the case of applicants fraudulently claiming reductions for search fees, International Searching Authorities were able to deal with these applicants as they considered appropriate and accordingly set their own search fees in their agreements with the International Bureau under Article 16(3)(b). Furthermore, applying a fee for transfer of ownership would introduce risks of charging fees for an individual who had claimed the reduction in good faith and later sold the invention to a large corporation. The proposal to clarify the Schedule of Fees was, however, targeted more to applicants filing large numbers of applications, including in extreme cases more than 50 international applications on one day, using the fee reduction for natural persons, which were straightforward to identify. The proposed modification to Rule 92*bis* could nevertheless be discussed at a later stage, if it was considered necessary.

114. The Working Group approved the proposed amendments to the Schedule of Fees set out in the Annex to document PCT/WG/10/8 and the Understanding set out in paragraph 14 of that document, with a view to their submission to the Assembly for consideration at its next session in October 2017.

PROGRESS REPORT ON IMPLEMENTATION OF FEE REDUCTION CHANGES

115. Discussions were based on document PCT/WG/10/20.

116. The Secretariat explained that the Working Group, at its seventh session in June 2014, had requested the International Bureau to provide a progress report two years after the

implementation of the changes from July 1, 2015 to the eligibility criteria for countries for which natural persons qualified for a 90 per cent reduction in PCT fees. From the changes in eligibility criteria, 10 States became eligible for the first time and two States lost their eligibility. The Annex to the document compared numbers of applications from residents and nationals of each PCT Member State for the periods of 18 months immediately before and after the change in the eligibility criteria. The document showed that applicants would file as a natural person rather than as a corporate entity if a fee reduction was available, but there was no obvious effect on the overall filing levels as a result of the change that could be attributed to the change in eligibility criteria for fee reductions rather than general fluctuations in filing numbers due to economic conditions or specific activities in a country to promote patent filings.

117. The Delegation of the United Arab Emirates referred to the fall in numbers of international applications from the United Arab Emirates following natural persons ceasing to be eligible for fee reductions, which was a cause for concern. The Delegation therefore enquired whether the document could be updated and presented to the next session of the Working Group with more recent statistics.

118. The Secretariat confirmed that an updated document could be prepared for the next session of the Working Group.

119. The Working Group noted the report in document PCT/WG/10/20.

COORDINATION OF TECHNICAL ASSISTANCE UNDER THE PCT

120. Discussions were based on document PCT/WG/10/19.

121. The Secretariat reminded the Working Group that, at its fifth session, the Working Group had agreed that reports on technical assistance should be included as a regular agenda item for future sessions. Since then, the Secretariat had submitted reports on this subject to the Working Group, which covered both PCT related technical assistance activities for developing countries with a direct bearing on the use of the PCT in those countries, and also information on PCT related technical assistance carried out under the supervision of other WIPO bodies and indeed covered by other parts of the WIPO Secretariat. The document maintained the same reporting format as in previous years, which had been well received. Annex I included background on the types of assistance that the International Bureau undertook with relation to the PCT to assist developing countries to make use of the PCT system, and then listed all the technical assistance activities that had taken place in 2016; Annex II listed such activities as they had been undertaken already in 2017 and also those that were planned for the remainder of the year. As for activities related to developing patent systems of developing countries that went beyond the use of the PCT in those countries, and that were therefore undertaken outside of the PCT sector and fell under the supervision of other WIPO bodies, paragraphs 5 to 7 of the document set out some examples of such activities. This included several improvements to the PATENTSCOPE database such as the searching of chemical structures.

122. The Secretariat continued by referring to the update in the document on the ongoing discussions of the External Review of WIPO Technical Assistance in the Area of Cooperation for Development (“the External Review”; document CDIP/8/INF/1) and related documents in the Committee for Development and Intellectual Property (CDIP). The Secretariat recalled that the Working Group had the pending issue from the PCT Roadmap recommendations of reviewing the functioning of the PCT in terms of organizing technical assistance for developing countries. The Working Group, at its fifth session, had decided to await the outcome of the discussions of the External Review and related documents in the CDIP before considering how to proceed with regard to the technical assistance related parts of the PCT Roadmap recommendations. In this regard, the document provided an update in paragraph 11 of the discussions on this subject at the eighteenth session of the CDIP in October/November 2016. During this session of the CDIP, there had been an agreement to close the sub-agenda item “An External Review of WIPO Technical Assistance in the Area of Cooperation for Development” and to open

discussions on WIPO technical assistance in the Area of Cooperation for Development focused on the revised Spanish proposal, which was reproduced in the Annex III to the document. The revised Spanish proposal included six measures to be taken by the WIPO Secretariat on technical assistance to developing and least developed countries. Discussions on WIPO technical assistance focused on the revised Spanish proposal would take place over the next six sessions of the CDIP, beginning the following week at its nineteenth session. Following these sessions, discussion on the final implementation of the revised Spanish proposal and related documents, including the External Review, would take place. In the revised Spanish proposal, measure 1(a) required a one day seminar to be organized in the margins of CDIP 19. This seminar, known as the “WIPO Roundtable on Technical Assistance and Capacity Building: Sharing Experiences, Tools and Methodologies”, would be taking place on Friday of the week of this session of the Working Group. At this roundtable, Member States and WIPO officials, including those working in the PCT, would be sharing experiences, tools and methodologies on technical assistance. Finally, paragraph 13 of the document discussed how the Working Group might proceed with the discussions of PCT-related technical assistance with regard to the roadmap recommendations. One possibility here would be to continue to wait the outcome of discussions in the CDIP on the revised Spanish proposal and its final implementation, along with related documents on technical assistance including the External Review, which could avoid duplication of effort between the two bodies.

123. The Delegation of Senegal, speaking on behalf of the African Group, welcomed the technical assistance activities carried out by the International Bureau for the benefit of IP Offices in developing and least developed countries, which was vital to achieve a more balanced global IP system. Technical assistance needed to be demand driven. The International Bureau, working with Member States, should identify the gaps to improve innovation and creativity along with the structural causes, adapting technical assistance to the regional and national context. The African Group therefore encouraged the International Bureau to continue its capacity building work.

124. The Delegation of Iran (Islamic Republic of) stated that the document contained useful informative material for the Working Group and also emphasized the difference between the discussions on technical assistance related to the PCT and those in a broader context in the Committee on Development and Intellectual Property (CDIP). Regarding paragraph 13 of the document, it underlined the importance of continuing the reporting by the Secretariat on PCT-related technical assistance to each session of the Working Group.

125. The Delegation of Brazil stated that the document contained useful information on technical assistance, which was made easily accessible for delegates through the consolidated tables. Technical assistance was one of the tools to enable the use of IP for development with Recommendation 1 of the WIPO Development Agenda stating that WIPO technical assistance should be, *inter alia*, development-orientated, demand-driven and transparent, taking into account the priorities and special needs of developing countries, especially least developed countries. Technical Assistance was also the subject of Article 51 regarding the establishment of a Committee for Technical Assistance, and these elements needed to provide a basis for the work of the PCT in this area. Regarding the document, WIPO’s efforts in technical assistance needed to be strengthened and supported by Member States. In the case of South-South cooperation activities in which Brazil had participated in recent years, these had provided many opportunities for addressing the needs of development through an exchange of ideas and experience between countries with similar socio-economic realities. It was also important to facilitate access to patent databases by Offices in developing countries to enhance their examining capacities. Regarding paragraph 13 of the document, the Delegation supported the comments made by the Delegation of Iran (Islamic Republic of) that the recommendation in Article 51 had a more specific mandate when compared to the technical assistance under the WIPO Development Agenda Recommendations. It was therefore important for the Secretariat to continue reporting to the Working Group on PCT-related technical assistance.

126. The Secretariat clarified that the discussions in the CDIP aimed at reviewing WIPO technical assistance and considering how delivery of technical assistance could be improved in the future were additional to the reporting by the Secretariat to the Working Group on PCT related technical assistance. The Secretariat intended to continue with its reporting to the Working Group, in accordance with the agreement by the Working Group in 2012 that such reporting should be a regular agenda item at future sessions of the Working Group. Concerning the discussions which were ongoing in the CDIP, any recommendations on implementation of technical assistance that the CDIP would make in the future would include a component relating to the PCT; such recommendations would then return to the Working Group for consideration at a future session.

127. The Working Group noted the contents of document PCT/WG/10/19.

TRAINING OF EXAMINERS

SURVEY ON PATENT EXAMINER TRAINING

128. Discussions were based on document PCT/WG/10/7.

129. The Secretariat introduced the document, which evaluated a survey for 2016 regarding the training of substantive patent examiners. This survey followed on from a survey presented to the ninth session of the Working Group covering the 2013-2015 period (see document PCT/WG/9/18), where the Working Group had agreed that the International Bureau should invite Offices to report annually on any training activities carried out or received by the Office, and for the International Bureau to make a compendium of such activities available on the WIPO website. In addition, the document covered follow up actions agreed by the Working Group with regard to the International Bureau inviting Offices able to provide examiner training to increase training opportunities, and the International Bureau inviting Member States to consider setting up or expanding Funds-in-Trust arrangements in the area of training of examiners. To address all these issues, the International Bureau had issued Circular C. PCT 1497, dated January 6, 2017 and had received 40 replies to date. With regard to training activities carried out in 2016, there were no major changes in medium-to-long term comprehensive training programs, with the same three Offices (IP Australia, the European Patent Office and the Japan Patent Office) providing such programs. For on-the-job training, the numbers of donor Offices providing such training in 2016 was similar to the 2013-2015 period, but more beneficiary Offices were covered. While there was some improvement, the Secretariat underlined the need for Offices to provide on-the-job training to smaller IP Offices, which often did not have the benefit of experienced colleagues for trainee examiners to learn from. The majority of training activities offered to IP Offices of developing and least developed countries were classroom-type activities, where the survey showed similar results compared to the previous survey. One Office had managed to arrange training to cover 197 national patent examiners through attending overseas workshops and inviting assistance as guest trainees from four different Offices for their domestic training courses, which had been an efficient way of organizing examiner training utilizing external resources. For e-learning activities, of the 17 Offices reporting on participation in virtual classrooms or distance-learning activities, 11 Offices had utilized courses provided by WIPO, including those developed by the WIPO Academy, and 11 Offices had utilized the resources of the European Patent Academy, which were available to IP Offices of Contracting States of the European Patent Convention. In terms of increasing training opportunities, 11 donor Offices had provided specific responses with several indicating an intention to continue with current examiner training, but no Offices had plans to become a donor Office in the future. While having external examiners as guest trainers at examiner training events had been identified as an efficient way of delivering training and sharing best practices, one Office identified funding issues as a barrier to proving this activity. Finally, in terms of Funds-in-Trust arrangements, four Offices with these arrangements in place reported on the activities covered in 2016, but no Office indicated plans to set up similar Funds-in-Trust arrangements for examiner training in developing countries. The International

Bureau would conduct a similar survey in 2017, which it would report to the Working Group at its eleventh session in 2018.

130. The Delegation of Canada stated that work undertaken by the International Bureau in compiling the results of examiner training was a much needed and worthwhile exercise. IP Offices sharing examiner expertise with other Offices was a key part of the “cooperation” element of the PCT. The Delegation agreed that inviting guest trainees to classroom-type training was an effective training mechanism for examiners to assist other Offices and encourage the sharing of best practices. The Canadian Intellectual Property Office (CIPO) offered a three month basic training course to its new patent examiners. The next such course would be delivered in English and was planned for September 2017. It was possible to accommodate one or two patent examiners from beneficiary Offices on this course; the Delegation hoped that more spaces for examiners from other Offices could be available for future courses if there was continued interest. A year after joining CIPO, examiners attended a one month advanced course, followed a course on international work lasting one week. Attendees of the basic course were eligible to return for these courses. In terms of attending these training courses, logistically it was more straightforward for the participants to attend in person, which would also enable them to participate in discussions outside the seminars themselves and build up a rapport with examiners at CIPO. Beyond absorbing incremental costs for external participants such as providing training manuals, CIPO was not able to fund attendance by external participants on these courses.

131. The Delegation of the United States of America reported that the United States Patent and Trademark Office (USPTO) had provided many examiner training programs on search and examination procedures, both at its headquarters and at other IP Offices. The USPTO also continued to provide training in support of technical assistance and capacity building for developing and least developed countries through the Global Intellectual Property Academy. The offered patent programs focused on topics including administration, budgeting and examining procedures. For example, in 2016, the USPTO provided training for representatives from IP Offices in many countries including Cambodia, Indonesia, Malaysia, Myanmar, Philippines, Singapore, Thailand, Viet Nam, Bahrain, Kuwait, Oman, Saudi Arabia, Jordan and the Cooperation Council for Arab States of the Gulf. Moreover, the USPTO offered online training through its website.

132. The Delegation of Australia stated that it remained supportive of examiner training and improving patent quality. As alluded to in paragraph 29 of the document, the Australia Funds-in-Trust for the 2017/18 biennium had included additional means for specific examiner training activities, which would be implemented based on the needs identified in the responses to the survey for 2013 to 2015 issued as Circular C. PCT 1464, along with the results of additional research conducted by the International Bureau among certain countries in the Association of South East Asian Nations (ASEAN) region. IP Australia delivered patent training to Offices as part of the Regional Patent Examiner Training (RPET) program for Offices in the ASEAN region, and had also been working with the European Patent Office to ensure that the training offered to the ASEAN region by the two Offices complemented each other to maximize outcomes. The Delegation appreciated efforts from the International Bureau to collect information on training activities and make this available as a compendium on the WIPO website, and believed that the International Bureau was in an ideal position to match demand for training with what was available. The Delegation indicated willingness to share experiences of the RPET program and the successor RPET-Mentoring program and work with the International Bureau and other Offices to maximize outcomes for examiner training.

133. The Delegation of Japan referred to the activities of the Japan Funds-in-Trust in paragraph 31 of the document. The Government of Japan had been making voluntary contributions to WIPO for the purpose of providing technical assistance to developing and least developed Countries on capacity building in the field of intellectual property for about 30 years. Specific areas of activities implemented under the Funds-in-Trust included building institutional

capacities, human resources, human resource development and office automation. Through these voluntary contributions, Japan was committed to continue to assist WIPO activities for the benefit of the developing and least developed countries. On top of the Funds-in-Trust arrangements, the Japan Patent Office had been conducting the Operational Patent Examiner Training (OPET) program since 2009, which invited patent examiners from countries in Asia, Africa and Latin America to participate in a three month program, as described in paragraph 9 of the document, and a further program would be conducted in 2017.

134. The Delegation of the Republic of Korea reported that the Korean Intellectual Property Office (KIPO) had provided training on substantive examination to its examiners and those of IP Offices of other PCT Contracting States, as described in document PCT/CTC/30/16. KIPO had opened the Intellectual Property Training Institute (IPTI) in 1987 to provide examiner training, and organized the WIPO Asia Pacific Regional Workshop annually with WIPO. The IPTI had been designated as an official training institute for WIPO in 2006 and had jointly held a summer school on IP with WIPO since 2008. In 2017, KIPO had provided several IP related training courses including patent law and examiner procedure, trademark law and examiner procedure and PCT international search and preliminary examination. KIPO had also cooperated with the Turkish Patent and Trademark Office, especially for training patent examiners. The Delegation hoped that the International Bureau would continue to survey examiner activities and KIPO would continue to participate in training programs with other Offices as a donor or user.

135. The Delegation of Spain stated that the Spanish Patent and Trademark Office (SPTO) had been providing technical assistance activities as a donor Office, collaborating with IP Offices in Latin America and other areas of the world in coordination with the European Union or WIPO. The SPTO was active in training and information activities, among which included patent examiner training in the PCT. The SPTO also conducted a training program on Patent Searches and Examination (CIBIT) whose objective was to teach Ibero-American patent examiners to search in different databases and to use different technological information services; since 1999, more than 100 patent examiners in Latin America had benefited from this training. Moreover, online courses in industrial property in Latin America had created a network of expertise in Latin America to share and harmonize experiences in this area. Furthermore, since the establishment in 2004 of the Spain Funds-in-Trust with 2 million Swiss francs invested, many development and training activities in Latin America had been developed. The Delegation concluded by stating that it was willing to share experiences in supporting these types of initiatives and continuing the ongoing coordination with WIPO of these programs in the future.

136. The Delegation of Israel stated that the Israel Patent Office over the years had been providing technical assistance, especially for developing and least developed countries. In cooperation with the WIPO Academy, the Israel Patent Office held an annual training course on search and examination of patent applications with a special highlight on pharmaceuticals, which aimed to assist developing countries to enhance their capacities in patent examination. The Delegation welcomed the potential role of WIPO in coordinating the training of substantive patent examiners, where the International Bureau could keep records of proposals and needs regarding examiner training and best practices from Offices and trainees. The Delegation therefore believed that the development of a learning management system would contribute to further improvement of patent examination and of the PCT System.

137. The Delegation of China supported the conducting of an annual survey on patent examiner training for donor and beneficiary Offices, which would be helpful for the International Bureau to understand the training of patent examiners in Member States and coordinate training activities. During the years of internal PCT examiner training, the State Intellectual Property Office of the People's Republic of China (SIPO) had accumulated experience and developed training materials and a training management system, and it was willing to share its experiences in this regard with the International Bureau and PCT Member States. In recent years, SIPO had

been devoted to providing diversified training to examiners from developing countries, with six batches of training being provided for IT officials and examiners from over 20 developing countries in 2016 alone. China was also actively considering utilizing China Funds-in-Trust for its efforts with WIPO to provide training to examiners from developing countries, and would be holding a training course for examiners from developing countries in mid-May 2017 jointly using funds from the Chinese Government and China Funds-in-Trust. In the future, SIPO would provide more training activities in the PCT field to examiners from developing countries within its capacity so as to increase the overall quality in the PCT and to enhance the opportunities for Offices to exchange and share their knowledge in law examination practices and techniques.

138. The Chair thanked delegations for their work in contributing to the training of patent examiners and other capacity building activity around the world, and the International Bureau for conducting the survey to compile details of patent examiner training provided by IP Offices. In view of limited resources, the Chair underlined the importance of these activities being coordinated to optimize their benefits.

139. The Representative of the Asian Patent Attorneys Association (APAA) expressed appreciation for the training of examiners offered by WIPO Member States to other Offices, and was confident that the quality of examination would improve with these continued efforts.

140. The Working Group noted the contents of document PCT/WG/10/7.

COORDINATION OF PATENT EXAMINER TRAINING

141. Discussions were based on document PCT/WG/10/9.

142. The Secretariat introduced the document, which contained a proposal for improved coordination of patent examiner training. Paragraph 10 of the document summarized deficiencies in the current support provided by donor Offices to the training of patent examiners in developing countries. These deficiencies highlighted the need for improved coordination, which would aim to assure that individual patent examiners acquired competences according to their job descriptions, supply from donor Offices was matched by individual or institutional demand, participation in training activities and assessment of learning was tracked, training opportunities were used efficiently, and training collaborations between beneficiaries and donor were monitored and evaluated. To achieve these objectives, the document proposed to use competency frameworks, which could be tailored to examiners and the capacities of the Office concerned to plan and coordinate training, noting the different needs of Offices. In order to facilitate the coordination of this training, the document proposed to develop a learning management system which would organize and manage patent examiner training, as described in paragraphs 15 and 16 of the document. In terms of competency models, 27 Offices had reported that they had developed a competency model for training substantive patent examiners in their responses to the patent examiner training survey for the period 2013-2015 issued with Circular C PCT 1464. However, only two Offices had shared their models in their responses to the patent examiner training survey for 2016 in Circular C. PCT 1497. This could be due to different conceptions of competency models, which therefore underlined the need to develop a competency framework to achieve the objectives in paragraph 12 of the document. Currently, no IP Office used a Learning Management System (LMS) for full training of examiners, but the WIPO Academy had deployed an LMS based on the open source platform Moodle for individual online courses in distance learning programs. The International Bureau intended to develop an LMS for the management of examiner training activities and monitoring the progress of participants. The Secretariat concluded by indicating that it would report on progress of the development of a competency framework and learning management system to the Working Group at its session in 2018.

143. The Delegation of the European Patent Office supported the general principle of better coordination of patent examiner training by the International Bureau. However, due to the sustained growth of patent filings at the IP5 Offices which represented 82.5 per cent of the

2.9 million patent applications filed worldwide in 2015, a number of measures had been implemented internally at the European Patent Office to ensure high quality and timely filing of applications. This had involved reallocating staff that had formerly been dedicated to alternative activities to the core activities of search, examination and opposition. In this context, the resources of the European Patent Office dedicated to training of examiners of other Offices needed to be carefully managed in order to best address the specific needs of partner offices when tailoring training activities. Indeed as reflected in the document, in examiner training, it was not a case of one-size-fits-all. The engagement of the European Patent Office in any patent examiner activities needed to be consistent with its bilateral and multilateral cooperation policy. For instance, the European Patent Office had continued its program in developing in-house training capacity for national patent examiners in IP Offices of the Association of South East Asian (ASEAN) States, which was implemented in parallel to the regional activities of IP Australia. An excellent synergy was found with the work of IP Australia, demonstrating that technical assistance could be beneficial for all parties involved. Therefore, in addition to and in line with its cooperation policy, the European Patent Office would continue to support WIPO examiner training activities in third countries for the reuse of work products and for search and examination in specific technical areas. In this context, improved coordination and early planning between the European Patent Office and the International Bureau in relation to training activities allowed for enhanced efficiency in the use of the limited resources available.

144. The Delegation of the United States of America agreed that it would be beneficial for all to improve coordination and planning with regard to training programs. Specifically, the Delegation supported the principle of donors describing the content of training activities and defining prerequisites for participation in terms of competences, given that in the past, the United States Patent and Trademark Office had delivered training to personnel without the necessary experience or previous training to benefit fully from the activity. In addition, the Delegation underlined that donor Offices should only be asked to deliver training on topics that they were willing to give training on.

145. The Delegation of Japan stated that it would be useful, from the standpoint of recipient countries, for information on training programs of various donor countries to be provided in a structured manner. However, the Delegation also believed that specific arrangement of training programs such as selection of the beneficiary countries and the contents of each course should remain at the discretion of each donor country within its available resources. The Delegation therefore wished to continue to discuss how training could be effectively carried out to meet the needs of developing countries while respecting the national priorities of donor countries.

146. The Delegation of the United Kingdom supported the efforts to improve coordination of examiner training and stated that it would be willing to share examiner competencies at the United Kingdom Intellectual Property Office as a part of this work. In delivering training, assessment and management of individual examiners needed to remain the responsibility of the respective IP Offices.

147. The Working Group noted the contents of document PCT/WG/10/9.

ENGLISH TITLE OF INVENTION

148. Discussions were based on document PCT/WG/10/17.

149. The Delegation of the Republic of Korea introduced the document by reporting that the Korean Intellectual Property Office had received complaints from patent applicants with regard to the title of the invention in English for applications that had been filed in Korean. The Delegation believed that the English title should be established as close as possible to that which the applicant intended. Moreover, if the title was not translated using common terminology in the relevant field, the document could not be utilized as a reference as it would not be retrievable from the database at the Korean Intellectual Property Office. The document therefore proposed that an applicant could establish an English title of the invention along with

the original title at the time of filing the international application. In addition, the Delegation believed that if an applicant was not satisfied with the English title of invention, he or she should have the opportunity to communicate this opinion to the International Bureau. The Delegation therefore anticipated that applicants would be more satisfied with the PCT System with more accurate translations and the relation between the international and national phase would be strengthened.

150. The Delegation of the European Patent Office supported the principle of further enhancing the correctness of translations into English of the title of the invention. Applicants filing an international application in a language other than English could therefore be encouraged to furnish an English version of the title of the invention, but this should be an option, not a requirement. In turn, the International Bureau should consider the suggestion by the applicant, but would not be bound by it. The European Patent Office therefore looked forward to receiving more information regarding implementation of the proposal.

151. The Delegation of the United States of America stated that the proposal would appear to have benefits for both applicants and Offices, and it appreciated that the proposal did not envisage it being mandatory for applicants to provide an English translation of the title of the invention. Likewise, since a translation of the title into English supplied by a non-native speaker could have inaccuracies, the Delegation appreciated that the International Bureau would not be required to accept the translation as submitted. In conclusion, the Delegation supported the general idea of the proposal, but it also requested the Secretariat to provide an indication of what changes to the legal framework might be necessary.

152. The Delegation of Spain welcomed the proposal, particularly as it had the flexibility as the applicant would not be obliged to provide a translation into English, and also because the International Bureau would not be required to accept any translation provided by the applicant.

153. The Delegation of Canada supported the comments made by the Delegations of the European Patent Office and the United States of America. In relation to the legal framework, the Delegation indicated that it was already possible for Offices to accept documents from applicants that were not listed in the PCT Regulations for the examiner to take into consideration. This proposal was therefore similar to the present situation.

154. The Delegation of the Russian Federation supported the proposal and reported that similar cases to the situation described in the document had occurred with the English translation of the title of invention from Russian. The Delegation appreciated that the proposal would not be mandatory for the applicant, nor would it be binding on the International Bureau to accept any translation proposed by the applicant.

155. The Delegation of Japan supported the idea of the applicant providing a translation of the title of the invention into English to reflect the applicant's technical expertise. However, to avoid adding undue burden on the applicant, providing an English translation should be optional, and any translation provided should only be used by the International Bureau for reference purposes. However, if the applicant had the possibility to add an English title in Box I of the Request Form, it would be necessary for the Japan Patent Office to consider the implementation schedule as it would take time to modify internal systems. Furthermore, as the proposal related to improving the quality of English translation established for international publication, applicants might prefer to provide the English translation of the title of the invention after the international filing date, which could be submitted to the International Bureau instead of the receiving Office.

156. The Delegation of Chile supported the general principle of the proposal, provided supplying an English title was not an obligation for applicants. The Delegation added that the English translation of the title from the applicant could be useful for the PCT System, in particular with regard to the technical information made available to the International Bureau.

157. The Delegation of China supported the proposal and giving the option for applicants to submit the title of the invention in English would be beneficial. The Delegation also enquired about what amendments would be required to the PCT legal framework to implement the proposal.

158. The Delegation of India supported the proposal, which would be useful for the PCT System by helping examiners find prior art more accurately, and looked forward to seeing its implementation. However, the Delegation considered that the applicant should be left to authenticate the title in English as representing the true intent of the title in the original language.

159. The Representative of the Japan Patent Attorneys Association (JPAA) supported the option for the applicant to file the title of the invention in English for international applications filed in other languages such as Japanese, provided this would not become mandatory in order to prevent placing additional burden on the applicant.

160. The Representative of the Asian Patent Attorneys Association (APAA) supported the proposal, which would be beneficial for the applicant to be able to submit an English translation of the title of invention.

161. The Representative of the Asociación de Agentes Españoles Autorizados ante Organizaciones Internacionales de la Propiedad Industrial (AGESORPI) supported the proposal to provide the option for the applicant to file a translation into English of the title of an international application filed in another language. However, if the applicant had filed a translation into English, the Representative believed that this should be the translation into English used in the international publication given that the applicant was responsible for the translation of the title just as the applicant was responsible for any translation of the application provided for the purposes of international search or international preliminary examination.

162. The Secretariat acknowledged the support from the delegations for the proposal, provided that submitting a translation remained an option, and not an obligation. In relation to the comments made by the Representative of the Asociación de Agentes Españoles Autorizados ante Organizaciones Internacionales de la Propiedad Industrial (AGESORPI), the Secretariat pointed out that the PCT Regulations gave the International Bureau the responsibility to establish the translation into English of the title of the invention. The International Bureau intended to retain this responsibility, but would find it useful to have any suggestion from the applicant which it could take into account. In terms of the next steps in taking the proposal forward, a basic process of allowing the applicant to submit the title of the invention in English could probably be implemented by modification to the PCT Administrative Instructions. However, providing the applicant the opportunity to review a translation of the title of the invention at a later stage would have implications on timing of other processes and could have an impact on the PCT Regulations. As a first step, the proposal could therefore be implemented by allowing the submission of the title in English without a review procedure by the applicant. As part of the initial consideration, the International Bureau could explore the feasibility for the applicant to submit an English translation of the title of invention after the international filing date through an ePCT action, as suggested by the Delegation of Japan; this option would need to take into account the timescale of the translation process. The Secretariat also acknowledged that changes to the filing of an international application would affect systems at receiving Offices, which would need to be taken into account when deciding on when any provision could enter into force. The Secretariat concluded by suggesting that the International Bureau could work further with the Korean Intellectual Property Office and other interested Offices to develop a detailed proposal for consultation through a PCT Circular. However, if amendments to the PCT Regulations were needed, it would be necessary to bring the issue to the next session of the Working Group to examine the proposal further.

163. The Working Group invited the Korean Intellectual Property Office to work with the International Bureau and other interested Offices to develop a detailed proposal for permitting applicants to propose an English language title of the invention, taking into account the necessary changes to the legal framework and the work which would be needed to implement the system at national Offices and advertise the system to applicants.

NUMBER OF WORDS IN ABSTRACTS AND FRONT PAGE DRAWINGS

164. Discussions were based on document PCT/WG/10/23.

165. The Secretariat stated that the document followed on from discussions at the ninth session of the Working Group, where document PCT/WG/9/16 had presented information to show that a significant proportion of applications had abstracts with either significantly more words than the recommended maximum of 150 words when translated into English set out in Rule 8.1(b), or fewer than the recommended minimum of 50 words under this Rule. This document also pointed out that a large number of front page drawings which accompanied the abstract contained significant numbers of words, contrary to the requirements of Rule 11. Excessively long abstracts and front page drawings with many words had a significant impact on the budget of the International Bureau. While a higher budget could be provided in the future for these translations, it was important that such translations served a useful purpose and it was indeed worthwhile to meet these extra costs. Following the discussions at the ninth session of the Working Group, the International Bureau had issued Circular C. PCT 1486. Responses to this Circular were received from 26 national and regional Offices, which were set out in paragraph 12 of the document. The comments in the responses stated that the length of the abstract was not a direct indicator of quality; both short and long abstracts could be of high quality, and in some cases, a long abstract was necessary to convey the invention to the reader. But when large numbers of abstracts fell outside the recommended range, it was relevant to consider whether the recommendations were appropriate or being followed. Another relevant observation was the different uses of abstracts. Some Offices relied on the full text of documents and commercially prepared abstracts for search purposes, and the abstract on the front page of the international publication was barely used. However, the abstract remained important for some searching, and at the international publication date, the abstract on the international publication was the only abstract available to third parties monitoring new patent applications being published. The International Bureau therefore believed that it was important that the abstract of international application was produced to a high standard. Finally, in terms of the feedback from the Circular, it was emphasized that only the International Searching Authority could conduct a meaningful review of the abstract. Paragraphs 17 and 18 of the document discussed the review of abstracts by the International Searching Authority. In particular, at the twenty-fourth session of the Meeting of International Authorities in February 2017, the International Authorities had agreed to review the guidance for performing this review in the PCT International Search and Preliminary Examining Guidelines. This would also have to be considered alongside modifications to the PCT Applicant's Guide given that applicants should be providing a suitable abstract that did not require significant revision by the examiner at the International Searching Authority. In terms of next steps, in addition to consulting on changes to the PCT International Search and Preliminary Examining Guidelines and the PCT Applicant's Guide, the International Bureau intended to compare the material in WIPO Standard ST.12 to the advice currently given in the PCT. The Secretariat also invited any delegation to provide any guidelines on drafting abstracts at their IP Office which had helped to improve the quality of abstracts received from applicants. The International Bureau also intended to modify ePCT-Filing to be able to perform a word count on the abstract, which would warn the applicant where the abstract fell outside the recommended range without preventing the applicant from performing the filing. Furthermore, paragraph 14 of the document suggested that guidelines on the equivalent length of 50 to 150 words in English for the other PCT publication languages could be included as a guide for applicants, which could also be built into

ePCT. The Secretariat concluded by welcoming comments on the steps proposed, particularly from user groups who could provide further insight into how the user community used abstracts.

166. The Delegation of Japan stated that the response from the Japan Patent Office to Circular C. PCT 1486 had taken into account the views from Japanese users. The Delegation agreed with the proposal in paragraph 13 of the document to modify the *PCT Applicant's Guide*, where the Japan Patent Office was willing to provide information on drafting abstracts to the International Bureau. The Delegation also acknowledged the difficulty of applicants preparing abstracts in languages other than English to know if their abstract would fall within the recommended range. The Delegation therefore supported the idea in principle of stating ranges in other languages as outlined in paragraph 14 of the document, which could be useful for the applicant. However, this would not only have an impact on the practice of users, but would also require modifications to domestic regulations and internal IT systems to include a range for the number of Japanese language characters. The implementation date for any such guidance would therefore need to be considered further. With regard to paragraphs 15 and 16 of the document, the electronic filing system at the Japan Patent Office already included a function related to the suggested number of Japanese characters in the abstract. A similar function in ePCT would therefore be useful for applicants, but it would be better if it included a warning based on the number of words in an automated translation into English, rather than counting the words themselves in the input text. Finally, in relation to paragraphs 17 and 18 of the document, the Delegation requested the Secretariat for further information on how it intended to modify the *PCT International Search and Preliminary Examination Guidelines* in order to ensure that abstracts and accompanying drawings were fit for purpose, while recognizing the duty to applicants to provide suitable abstracts.

167. The Delegation of the United States of America expressed appreciation for the work of the International Bureau on the issue of words in abstracts and front page drawings, and sympathized with the issues regarding the resources needed to translate long abstracts and large amounts of text in the front page drawing. The Delegation therefore supported the steps outlined in paragraphs 19 and 20 of the paper. In particular, the Delegation suggested that the information on abstracts drafted in languages other than English be included in the *PCT Applicant's Guide* and the *PCT International Search and Preliminary Examination Guidelines* in some form. The Delegation was also willing to provide the International Bureau with the instructions on abstracts in the Manual of Patent Examining Procedure at the United States Patent and Trademark Office.

168. The Delegation of Australia expressed sympathy for the problems caused by lengthy abstracts and many words on the front page drawing, and indicated willingness to comment on any proposals to modify the *PCT Applicant's Guide* and the *PCT International Search and Preliminary Examination Guidelines*. The Delegation stated that any Circular to consult on these proposals should also ask for guidance provided by IP Offices on the drafting of abstracts in order for the International Bureau to have as much information as possible when making any proposal for the Working Group to consider at a future session. The Delegation welcomed introducing a warning that the International Bureau proposed to implement in ePCT when an abstract was outside the recommended length, which would not add undue burden to users or receiving Offices, but would raise awareness of suitable abstract lengths. Moreover, the Delegation supported other efforts to raise awareness of the advantages of a properly drafted abstract, such as through social media and the *PCT Newsletter*, which could reduce the work involved in revising abstracts in the context of prior art searching. Furthermore, there could be possibilities to use automated translation tools to reduce the costs of translation.

169. The Delegation of Spain stated that the Spanish Patent and Trademark Office had recommendations that were intended to advise applicants and agents to avoid excessively long abstracts and unnecessary flow diagrams on the front page of the published application. The Delegation agreed that modifications could be made to the *PCT Applicant's Guide* and the *PCT International Search and Preliminary Examination Guidelines*. In addition, training programs

and patent seminars could be used to raise awareness of preparing appropriate abstracts. The Delegation also underlined the importance of International Searching Authorities revising abstracts where needed, adding that while IP Offices had sophisticated search tools, the front page abstract of a patent publication was essential for many other users of the patent system. As search databases first consulted the abstract of a patent publication before the description, there would be negative consequences if the abstract had not been drafted properly. In Spain, as a result of the new patents legislation, the Spanish Patent and Trademark Office had updated its guide for applicants, which had broadened the recommendations in the drafting of abstracts to help patent applicants, and it was willing to share these guidelines with the International Bureau.

170. The Delegation of the Russian Federation acknowledged the concerns about the length of abstracts and the additional translation costs that could be incurred. The Delegation supported the measures suggested in the document to improve parts of the *PCT Applicant's Guide* and the *PCT International Search and Preliminary Examination Guidelines* dealing with abstracts. While the Delegation did not object to having a warning in ePCT for applicants when the number of words in an abstract fell outside a given range, it was hesitant to follow the table in paragraph 14 of the document for determining a suitable range in languages other than English, pointing out that differences in language syntax resulted in longer abstracts in English compared to Russian. It was therefore difficult to advise an applicant using Russian on a recommended range of words for the abstract.

171. The Delegation of Denmark stated that the Danish Patent and Trademark Office had brief guidelines on drafting abstracts, but did not have in depth guidelines to offer for the International Bureau. However, the Delegation supported the next steps as proposed in the document, which it considered to be sound and reasonable.

172. The Delegation of the European Patent Office stated that the recommended abstract length from 50 to 150 words in English should be a guide from which deviation could be justifiable in certain cases. A restrictive approach was therefore not desirable. Depending on the technical field and number of embodiments covered by the application, a shorter abstract might be sufficient in certain cases, whereas a longer abstract might be required in other cases. Regarding paragraph 14 of the document, the development of guidelines and recommendations relevant to drafting abstracts in languages other than English could be a helpful tool, particularly for translations into English from languages not using the Latin alphabet. The European Patent Office therefore welcomed the establishment of guidelines in each of the languages of publication containing recommended ranges for the length of the abstract, which should help the English translation of such abstracts to remain within the recommended range. Moreover, it could be useful to have feedback from patent professionals and information users about their particular needs. Since there should be flexibility to deviate from the length of abstract in certain cases, the European Patent Office aligned itself with the comments in paragraph 16 of the document that receiving Offices should not assess the quality of abstracts to determine whether it was appropriate to deviate from the recommended length of abstract or check word counts, nor should there be fee-related incentives to regulate the length of abstracts. The European Patent Office in its capacity as a receiving Office invited the applicant to correct defects such as the abstract being in a different language from the application, the absence of an abstract or the physical requirements not being met. The European Patent Office therefore considered the guidance in paragraph 147 of the *PCT Receiving Office Guidelines* to be sufficiently clear. While the usefulness of including warnings to applicants in electronic filing systems when the abstract fell outside a given range could be investigated, any warning should not prevent the applicant from filing an abstract outside the recommended range as stated in paragraph 20 of the document. The European Patent Office agreed with the comments in paragraph 17 of the document that only the International Searching Authority was in a position to judge the merits of an individual abstract, and the International Searching Authorities should amend non-compliant abstracts in a more systematic way with regard to the guidelines in WIPO Standard ST.12/A, as discussed in paragraph 18 of the document. Nevertheless, it needed to

be made clear that it should be the task of the applicant to draft the abstract in accordance with the Regulations. Amendments to abstracts by the examiner at the International Searching Authority should be an exception and not standard practice. Moreover, the length of an abstract was not necessarily a reliable indicator of the quality of information. Abstracts that were too short could generally be more problematic than ones that were too long; in the former situation, the abstract may not cover all relevant aspects of the invention, whereas in the latter case, relevant information could nevertheless be retrieved using searching and highlighting functions. Emphasis should therefore be on compliance with Rule 8.1(a), where the European Patent Office agreed with the balance in paragraph 6 of the document, which could be added to paragraph 16.37(a) of the *PCT International Search and Preliminary Examination Guidelines* as a further clarification. While the European Patent Office considered the guidance in paragraphs 16.36 and 16.37 of the Guidelines to be sufficient, addition of the considerations in paragraphs 6(a) and (b) could be useful. Concerning the choice of the figure, the Delegation questioned the added value of indicating the reason why the examiner selected the particular figure, rather than the one suggested by the applicant. Drawings with a large amount of text did not comply with Rule 11.11(a) and large amounts of text in drawings which were represented in reduced size at the front page of the application might have limited use in the paper version of the document. At present, the text and drawings were not searchable electronically, but as a pdf file, a drawing with text could be enlarged on the screen, provided the quality was sufficient to be readable. The European Patent Office therefore considered a relevant factor in paragraph 8(a) of the document was whether the text was readable when enlarged on a screen. If the figure representing the information was a flow chart in a language of publication, it could be useful to have large quantities of text available at the side with reference letters and numerals in compliance with the considerations in paragraph 8(b) of the document. This could be added to paragraph 16.37 of the *PCT International Search and Preliminary Examination Guidelines* while acknowledging that it was a disadvantage that the text was not available at the right location in the flow chart. Furthermore, the European Patent Office considered it worthwhile that the International Bureau reflect on means to render the text in front page figures searchable, especially for flow charts. In conclusion, in view of the number of issues related to the question of number of words in abstracts and front page drawings, the European Patent Office suggested that the International Bureau consider the matter further and prepare a document, initially for consideration at the 2018 Meeting of International Authorities.

173. The Delegation of Israel stated that while national legislation in Israel did not require the filing of an abstract as part of a patent application and patent examiners at the Israel Patent Office as a designated Office did not generally rely on the abstract as the primary source of information review, as an International Searching Authority, patent examiners at the Israel Patent Office seldom made changes to abstracts. The Delegation supported the idea to modify the *PCT Applicant's Guide*, the *PCT Receiving Office Guidelines* and the *PCT International Search and Preliminary Examination Guidelines*. Furthermore, in order to improve the quality of abstracts, the Delegation believed that International Searching Authorities needed to make more effort to review the quality of abstracts to ensure compliance with the PCT Regulations. For example, the International Searching Authority in its quality assurance process should include the checking of abstracts and the figure to be published with the abstract.

174. The Delegation of China supported the efforts to improve the quality of abstracts. In this regard, the Delegation hoped to collect further views from users, paying attention to differences between technical fields. The Delegation looked forward to the International Bureau proposing relevant modifications to the *PCT Applicant's Guide*, the *Receiving Office Guidelines* and *International Searching and Preliminary Examination Guidelines*. Meanwhile, the Delegation recommended that the International Bureau emphasize during training seminars that applicants should prepare abstracts of high quality.

175. The Delegation of India stated that the Indian Patent Office, in its capacity as an International Searching Authority, was restricting abstracts to 50 to 150 words, but with some flexibility, particularly for complex inventions which could not be conveyed accurately within the

upper limit. The Delegation underlined the importance of the abstract, not only for providing technical information, but also helping third parties and patent examiners understand the nature of the invention.

176. The Delegation of Ukraine emphasized the importance of abstracts for prior art searching by applicants. The Delegation agreed that the length of an abstract could be varied depending on the technical field of the invention. Furthermore, the Delegation supported the request from the Delegation of the European Patent Office to reconsider the issue at the 2018 Meeting of International Authorities. At the State Enterprise Ukrainian Intellectual Property Institute, abstracts were re-considered as part of the quality assurance system.

177. The Delegation of the Republic of Korea acknowledged the costs and resources needed to translate abstracts. However, without accurate guidance, the Korean Intellectual Property Office could not easily control the length of abstracts in Korean. With regard to the table showing equivalent lengths of abstracts in different languages in paragraph 14 of the document, the Delegation questioned the numbers for Korean since the structure of the language was different from English, and therefore requested the International Bureau to recalculate the numbers taking into account equivalents to Chinese or Japanese characters. Moreover, the Delegation asked whether this table considered different technical fields, pointing out that in certain areas, such as chemicals, the correlation between the English and Korean terms were different from other fields of technology. The Delegation therefore suggested that the International Bureau compile information on the characteristics of abstracts in Korean in several technical fields, which the Korean Intellectual Property Office could review and communicate to users. The Korean Intellectual Property Office was also willing to analyze lengths of abstracts in domestic applications for different technical fields and inform the International Bureau of this work in about six to eight months' time.

178. The Representative of the Japan Intellectual Property Association (JIPA) stated that any recommended lengths of abstracts in the different PCT publication languages should only be guidelines, as was currently the case for English in Rule 8.1(b). As had been discussed in the document, JIPA also believed that the length of abstract provided no measure of the quality of the invention, and strict implementation of recommended lengths of abstracts could cause additional burden which would not be beneficial.

179. The Representative of the Japan Patent Attorneys Association (JPAA) expressed concern that a limit on the number of words in an abstract would be a burden on the applicant. In some fields of technology, patents were becoming increasingly more complicated with more elements in the claims, making it difficult to convey the invention in a limited number of words. Any guidance on the length of abstract should therefore be a recommended option, and not be obligatory for the applicant.

180. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) stated that abstracts were drafted by applicants and used by third parties, and in some cases the abstract was the only written information on an application available to the third party in a language he or she understood. It was therefore important that the abstract contained sufficient information for a third party to be aware of the content of the application. Furthermore, European patent attorneys had not experienced any problems to date with the treatment of patent abstracts by the European Patent Office in its capacity as a receiving Office.

181. The Secretariat indicated that further information and discussion was necessary before being able to propose suitable modifications to the *PCT Applicant's Guide* and the *International Search and Preliminary Examination Guidelines*. The International Bureau intended to draft a Circular with preliminary proposals and further questions, which would most likely be further discussed at the next sessions of the Meeting of International Authorities under the PCT and the PCT Working Group in 2018. Contributions from Offices on possible modifications, especially concerning guidelines on drafting abstracts, did not need to wait for the Circular to be issued

and would be welcome immediately. The International Bureau would also add a word count tool to ePCT-Filing.

182. The Working Group agreed that:

(a) the International Bureau should issue a Circular to invite further comments on drafting of abstracts to help in drafting potential modifications to the *PCT Applicant's Guide* and *International Search and Preliminary Examination Guidelines*; and

(b) Offices willing to share their guidelines on preparing abstracts should send these to the International Bureau as soon as possible, to be taken into account in the preparation of the Circular.

USE OF NATIONAL CLASSIFICATION SYMBOLS IN INTERNATIONAL APPLICATIONS

183. Discussions were based on document PCT/WG/10/4.

184. The Secretariat introduced the document, which followed up the proposal from the Republic of Korea discussed at the ninth session of the Working Group for the International Searching Authority to include, on the front page of international applications, national classification symbols that had been assigned by the International Searching Authority and indicated in the international search report, in addition to International Patent Classification (IPC) symbols (see document PCT/WG/9/26). While the document referred to national classification systems, this was understood primarily to refer to the Cooperative Patent Classification (CPC) run by the European Patent Office and the United States Patent and Trademark Office, and increasingly used by other Offices. In essence, the CPC was a more detailed version of the IPC, which was updated more frequently than the IPC to keep pace with changes in technology. Delegations at the ninth session of the Working Group had been supportive of the general idea to make this information available to end users in search systems. Subsequently, the International Bureau had issued Circular C. PCT 1488. The document discussed the content of this Circular and the responses received, along with discussions on the use of national classification symbols at the twenty-fourth session of the Meeting of International Authorities (MIA) in February 2016. In the discussions at the MIA, where were summarized in paragraph 18 of the document, there was general convergence on the notion that making the symbols available was very useful, but there was some divergence in views on exactly what that meant. The proposal by the International Bureau was slightly different from the original one from the Republic of Korea in that what was now being proposed was to allow for the possibility of International Searching Authorities to transmit the CPC symbols to the International Bureau, providing that the data has been validated by the International Searching Authority, and it was sent in a machine readable format to enable automatic processing without the need for manual intervention from staff at the International Bureau, where transcription errors could be introduced. The document also recommended that the CPC information be made available electronically for use in databases, but not published on the front page of the international application. The Secretariat acknowledged that some Offices, in their responses to the Circular, had indicated that the information on the front page would be useful, but in the view of the International Bureau, the benefits were outweighed by the disadvantages. Given the close relationship between the IPC and the CPC, there would be considerable duplication; in many cases the same code would be repeated or shown at slightly finer level of detail. Noting the limited amount of space on the front page, this type of duplication could therefore be more of a distraction than an aid. Secondly, the CPC was not maintained in multiple languages in the same way that the IPC was. So the meaning of these codes might not have the same level of accessibility to non-English speakers as IPC codes. And finally, the CPC underwent more frequent modifications than the IPC, so CPC information in a fixed format on the front page of the publication was very likely to go out of date quickly, more so than the IPC. Nevertheless, if the information were provided in electronic format and made available for searching purposes, the International Bureau could also explore mechanisms to make sure that the information flowed through as the documents were

reclassified later to make sure that the search systems had an accurate CPC classification from the moment of international publication to could be searched, and that information could hopefully be updated and searched effectively at a later date. The Secretariat therefore particularly welcomed comments on the next steps proposed in paragraph 19 and 20 of the document that the International Bureau would receive CPC information from Offices in electronic format only, and this information would be made available on PATENTSCOPE and search databases, rather than putting the information on the front page.

185. The Delegation of the Republic of Korea stated that the original proposal in document PCT/WG/9/26 concerned national classification symbols, which were not only limited to the Cooperative Patent Classification (CPC). The Korean Intellectual Property Office had been classifying domestic patent applications according to the CPC, and international applications had been added from July 2016. Classification using the CPC had been useful for search purposes. The Delegation thanked the International Bureau for its efforts with the proposal and highlighted the inefficiencies of duplication of work where the International Searching Authority applied CPC symbols, but as these were not made available, the designated Office would then apply CPC symbols again during national classification procedure. The Delegation therefore hoped that Offices could utilize the CPC symbols applied by the International Searching Authority.

186. The Delegation of the United Kingdom supported the next steps proposed in paragraphs 19 and 20 of the document and reiterated the remark that it had made during discussions at the ninth session and in response to Circular C. PCT 1488 that International Searching Authorities should only provide CPC data to the International Bureau if they had experience of applying the CPC. If other national classifications schemes were to be included in the proposals, translations of the classification keys of such schemes should be available at least into English as such additional classifications would be of limited use if Offices, applicants and third parties were not able to understand them. Finally, as the IP5 Offices were already engaged in work to harmonize patent classification practice, proposals for publishing patent classification data in the PCT needed to be consistent with this work.

187. The Delegation of Japan stated that only the International Patent Classification, which had been established and developed based on global consensus, should be included on the front page of the international publication. The Delegation therefore supported the proposal of the International Bureau not to include national classification symbols on the front page of the international application. With regard to International Searching Authorities transmitting Cooperative Patent Classification (CPC) symbols to the International Bureau as proposed in paragraph 19 of the document, the Japan Patent Office did not assign CPC symbols to application. The Delegation therefore requested confirmation on whether the transmittal of symbols from the Japan Patent Office's FI classification system would be covered by the proposal, and expressed its support for the proposal on the understanding that FI terms could be made available through PATENTSCOPE if transmitted in a machine-readable format.

188. The Delegation of Brazil supported the proposal. The National Institute of Industrial Property of Brazil had been using the Cooperative Patent Classification (CPC) as its national classification scheme with successful results, and providing such information to the International Bureau would enhance its use.

189. The Delegation of China stated that allowing for the possibility of International Searching Authorities to transmit CPC symbols and national classification information to the International Bureau to make this information available in search databases would give more information to applicants and improve the efficiency of searching documents. The Delegation therefore supported the proposed next steps in paragraphs 19 and 20 of the document, and looked forward to the International Bureau specifying the requirements for transmitting this information.

190. The Delegation of Israel stated that the Israel Patent Office supported the sharing of national classification information if the data was in machine readable format, and it agreed with the way forward suggested in paragraphs 19 and 20 of the document. The Israel Patent Office had been using the Cooperative Patent Classification (CPC) as its national classification system in addition to the International Patent Classification (IPC) since September 2016. The Israel Patent Office also encouraged examiners to use the CPC in performing prior art searches on national patent applications, and its search strategy template had been updated to include information on the CPC. For international patent applications, the internal system could only create international search reports with IPC symbols, but the Israel Patent Office intended to add CPC information in 2018.

191. The Delegation of the United States of America continued to support the general concept of providing certain national classifications and specifically the Cooperative Patent Classification (CPC) with published international applications, which would be beneficial to both applicants and Offices. Nineteen Offices currently classified patent applications using the CPC, and it was used for search purposes by more than 45 Offices. The United States Patent and Trademark Office (USPTO) therefore supported the proposal that International Searching Authorities with experience and expertise in a national classification scheme could include national classification symbols and specifically the CPC in international search reports, in addition to International Patent Classification (IPC) symbols. With regard to the inclusion of national classification symbols on the front page of the international publication, rather than merely including the information in the PATENTSCOPE database and in the XML data associated with the publication, the USPTO continued to support the inclusion of the information in both locations, and considered that there was further value to Offices applicants and third parties if national classification symbols were present on the front page. The Delegation therefore believed that this issue needed further discussion. The USPTO was trying to eliminate the cost associated with duplicative classifications, and therefore wished to gain leverage from using the CPC symbols that may have been applied by the International Searching Authority. However, the USPTO did not transmit or receive XML data to or from the International Bureau for purposes of national phase entries in the United States of America, nor did the USPTO expect to be able to do so in the near future, primarily due to budget and resource constraints. Regarding the concerns raised by the International Bureau about including national patent classification symbols on the front page of the international publication, concerning the limited space available, the Delegation noted the front page information already extended to a second page in many applications and this did not seem to have caused any significant issues. With regard to the concern related to the similarity between the IPC and the CPC symbols, and that inclusion of both would be distracting to readers of the publication, the USPTO believed that users of the PCT System would be able to distinguish between the two classification schemes without any difficulty. In conclusion, the Delegation supported the International Bureau moving forward with the proposals to include CPC symbols related to the international application in the PATENTSCOPE database, but at the same time, it hoped that the International Bureau would leave the option open for providing such information on the front page of the international publication in the future.

192. The Delegation of the European Patent Office expressed support for the proposals in paragraphs 19 and 20 of the document and thanked the International Bureau for taking up the suggestion that it had made at the Meeting of International Authorities that the validation of Cooperative Patent Classification (CPC) symbols be performed at source before transmission to the International Bureau. The Delegation also echoed the remarks made by the Delegation of the United Kingdom that a certain expertise with a classification system needed to be assured before transmission to the International Bureau. Furthermore, the Delegation agreed with the comments made by the Delegation of the United States of America that there were certain advantages of including national classification symbols on the front page of the international publication, and it wished this option to be investigated further. For example, there would be greater transparency with more complete classification information on the front page and therefore increased quality.

193. The Delegation of Spain supported the proposal to include additional classifications to the International Patent Classification (IPC) in PATENTSCOPE and other databases, which would improve prior art searches. The Delegation agreed with the Delegation of the Republic of Korea that these additional classifications were not limited to the Cooperative Patent Classification (CPC), but could also cover other national classifications, and indicated that making the Japanese FI classification terms available would be beneficial. The Delegation further agreed with the proposal that any transmission should be electronic to avoid transcription errors.

194. The Delegation of India acknowledged that the PCT Regulations required the International Patent Classification (IPC) and requested the International Bureau to provide more detail on the usefulness and advantages of adding the Cooperative Patent Classification (CPC) symbols on the front page of the international publication, especially for Offices which did not use the CPC in their national classification system.

195. The Delegation of Canada agreed with the proposal not to include national classification symbols on the front page of the international publication for the reasons outlined in the document. The Delegation also agreed with the comments made by the Delegations of the United Kingdom, the United States of America and the European Patent Office that the Cooperative Patent Classification (CPC) should only be provided if the International Searching Authority had expertise with the CPC to avoid degradation of quality. However, it was not clear what level of expertise should be needed and how this could be adequately determined. Moreover, the Delegation hoped that the use of the CPC did not occur to the detriment of the quality of the International Patent Classification (IPC) symbols assigned to the patent application. While Article 4 of the Strasbourg Agreement concerning the International Patent Classification stated that competent authorities should assign complete symbols of the classification applied to the invention to which the application relates, this was unlikely to be intended to be performed using concordance tables from other classification systems, which could add to the degradation of the IPC symbols and data. While the Canadian Intellectual Property Office could support adding national classifications to the electronic file, it was important to ensure that changes made to the length of portions of the XML file would need advance warning to change IT systems.

196. The Chair summarized that there was general agreement on the proposals in the document except that some delegations wished to leave the option open of including national patent classification symbols on the front page of the international publication. The Delegation of India had also asked for the International Bureau to provide more details of the benefits of including the Cooperative Patent Classification (CPC) on the front page, particularly for Offices not using the CPC.

197. The Secretariat indicated that the International Bureau would be willing to present further information concerning the benefits of publishing the Cooperative Patent Classification (CPC) on the front page, particularly for Offices which did not use that classification. The International Bureau would also consult with Offices through a Circular on the appropriate technical standards which would be required for effective exchange of national classification symbols, both from the International Searching Authorities to the International Bureau and from the International Bureau to patent information users. A suitable warning would be required for changes to the format of any existing data exchanges to which the new information was to be added. The International Bureau also indicated that it would be willing to work with the Delegation of the Republic of Korea and other interested Offices in development of the proposal. Furthermore, the Secretariat acknowledged that the proposal was not limited to the CPC and could include national patent classification schemes such as the Japanese FI terms.

198. The Working Group agreed that the International Bureau should issue a Circular to Offices and user groups to consult on the next steps, as outlined in paragraph 197, above.

ISSUANCE OF A PROVISIONAL OPINION ACCOMPANYING THE PARTIAL SEARCH RESULTS

199. Discussions were based on document PCT/WG/10/14.

200. The Delegation of the European Patent Office introduced the document by explaining that the European Patent Office (EPO) over recent years had been developing additional services for the benefit of users, such as providing search strategy information and PCT-Direct. The new service described in the document consisted of making the provisional opinion on the patentability of the invention available to the applicant at the time of issuing the partial international search report and the invitation to pay additional fees in cases of lack of unity of invention. Applicants therefore had a better idea of whether to pay additional fees for searching further inventions. The provisional opinion was issued in EPO Form 1707, which was annexed to Form PCT/ISA/206 and made available in PATENTSCOPE. However, if other International Searching Authorities were interested in providing this additional service to applicants, the EPO suggested that the International Bureau develop a specific PCT document to use for this provisional opinion in order to facilitate processing in other Offices.

201. The Delegation of the United States of America raised the question of how the making available of the provisional opinion on the invention searched in cases of lack of unity of invention could affect the numbers of cases where applicants paid the additional search fees under protest, as provided by Rule 40.2(c).

202. The Delegation of Spain stated that the service provided by the European Patent Office was a positive development and helpful to the applicant. In cases of lack of unity of invention, for practical purposes, the search examiner at the Spanish Patent and Trademark Office prepared the written opinion at the same time as the international search report on the claims searched. However, by not issuing the written opinion with the international search report, work was required at a later stage.

203. The Delegation of Austria supported the idea in the document, and stated that the Austrian Patent Office provided a similar service to applicants

204. The Delegation of the Republic of Korea welcomed the service provided by the European Patent Office, which would benefit applicants by better informing them about whether or not to pay the additional fees for further searches. However, providing the partial written opinion could result in increased workload for the search examiner. The Delegation therefore expressed interest in the European Patent Office providing updates on the new service.

205. The Delegation of China welcomed the initiative to improve services provided under the PCT and hoped that the European Patent Office would conduct an assessment of the implementation of the service after a period of time, and update the Working Group on the service at future meetings.

206. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) thanked the European Patent Office for introducing the new service to provide a provisional written opinion with the partial international search report in cases of lack of unity of invention. This service had been requested by EPI for some time since applicants wished to know the opinion of the International Searching Authority on the patentability of the first invention searched before deciding how to react to the object of lack of unity of invention.

207. The Representative of the Asociación de Agentes Españoles Autorizados ante Organizaciones Internacionales de la Propiedad Industrial (AGESORPI) welcomed the new Service provided by the European Patent Office. If the written opinion had been drawn up at the same time as the search on the first invention, it made little sense to withhold this information from the applicant instead of providing it to the applicant.

208. The Delegation of the European Patent Office acknowledged the requests for an interim report on the service at the next session of the Working Group. However, the Delegation clarified that the new service was not a pilot and had been fully operational since April 1, 2017. As the Delegation of Spain had pointed out, examiners at the European Patent Office had already prepared a written opinion at the time of inviting the applicant to pay additional fees for the inventions that had not been searched. Rather than holding the written opinion back, it was sent to the applicant, which could assist with the decision on whether to pay the additional fees.

209. The Secretariat stated that the International Bureau would be willing to work with the European Patent Office to investigate a possible official PCT form for use by International Authorities which wished to follow the practice of issuing the partial written opinion with the invitation to pay additional fees in the case of lack of unity of invention. The key point here would be to ensure that the form for the partial written opinion could be readily distinguished from the final written opinion of the International Searching Authority.

210. The Working Group noted the contents of document PCT/WG/10/14.

PILOT ON COLLABORATIVE SEARCH AND EXAMINATION – STATUS REPORT

211. Discussions were based on document PCT/WG/10/11.

212. The Delegation of the European Patent Office introduced the document, which provided an update on the third pilot project on Collaborative Search and Examination (CS&E). The main features of the project were listed in paragraph 8 of the document. Firstly, the pilot project would be based on an applicant-driven approach, with applicants being able to file their requests for participation together with the international application at the receiving Offices of the IP5 Offices and the receiving Office of the International Bureau. There would also be a balanced workload distribution among the five Offices with 100 applications per Office with consistency between applications in different fields of technology. All IP5 Offices would be participating in the pilot, and it would include all kinds of applications, such as those with lack of unity of invention or those containing sequence listings. The IP5 Offices were working on a common set of quality and operational standards to monitor the pilot to ensure that an objective assessment on the merits of any proposed product could be made for both Offices and users. The collaborative tool for the pilot would be provided by the International Bureau based on the ePCT system. Finally, the pilot project would initially accept applications filed in English, but at a later date would be extended to all working languages of the IP5 Offices. As an update to paragraph 11 of the document, the Delegation informed the Working Group that the fourth session of the CS&E Pilot Group had taken place in Munich on May 4 and 5, 2017. Further progress in the preparatory phase had been made during this session. In particular the Group had prepared operational arrangements that it hoped would be adopted at the IP 5 Heads of Office meeting on June 1, 2017, where the launch of the operational phase would also be decided.

213. The Delegation of the United States of America stated that it was encouraged by the results of the first two pilots on the Collaborative Search and Examination (CS&E) and the potential benefits that this could provide with regard to increase the quality of international phase work products. The Delegation was encouraged by the potential time-saving benefits that CS&E could bring to the national stage examination process. In addition to the pilot discussed in the document, the Delegation informed the Working Group that the United States Patent and Trademark Office was testing two different schemes for bilateral collaborative search in pilot products with the Japan Patent Office and the Korean Intellectual Property Office in relation to national search and examination. The United States Patent and Trademark Office Delegation looked forward to working with the other IP5 Offices as the third CS&E Pilot began.

214. The Delegation of the United Kingdom stated that collaboration between different Office was an effective way of improving the quality of patent search and examination and avoiding duplication of work. The Delegation welcomed the third pilot between all IP5 Offices and looked forward to hearing the results.

215. The Delegation of the Republic of Korea reminded the Working Group that the Korean Intellectual Property Office had participated in the first and second pilot projects. Through Collaborative Search and Examination (CS&E), applicants could be provided with a high quality service, and workload could be reduced at designated Offices by utilizing the reports produced through CS&E. The Delegation hoped that the pilot could lead to a high quality service to users of the PCT System.

216. The Delegation of China stated that the State Intellectual Property Office of the People's Republic of China had participated in preparations of the third pilot, and it hoped that Offices and Member States would follow the pilot during the operational phase and provide suggestions for improvement for better contribution to the PCT System as a whole.

217. The Delegation of Japan stated that the Japan Patent Office would continue to participate actively in the discussions in the PCT Collaborative Search and Examination Pilot Group in the lead up to a successful third pilot project.

218. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) welcomed collaborative search, pointing out the interest of applicants to have a comprehensive search report at an early stage in the patent prosecution procedure. However, if collaborative search and examination were offered as a standard service to all users, it would need to be provided at a reasonable cost.

219. The Working Group noted the contents of document PCT/WG/10/11.

PCT MINIMUM DOCUMENTATION – STATUS REPORT

220. Discussions were based on document PCT/WG/10/12.

221. The Delegation of the European Patent Office presented the document as leader of the PCT Minimum Documentation Task Force ("the Task Force"). The present PCT Minimum Documentation Task Force had been set up following a decision by the Meeting of International Authorities in 2012, but discussions had not been particularly active. Earlier in 2016, the European Patent Office had taken over the leadership of the Task Force. Following the ninth session of the Working Group, the European Patent Office had presented a high level position paper on how to proceed with the seven objectives of the mandate given to the Task Force listed in paragraph 8 of the document. As these objectives were interrelated to one another, the paper had grouped them into four objectives A to D, as listed in paragraph 10 of the document. The European Patent Office would be leading the discussions on objectives A to C, and the United States Patent and Trademark Office would be leading the discussions on objective D relating to non-patent literature and traditional knowledge-based prior art and the revised proposal of India to request the inclusion of the Indian Traditional Knowledge Digital Library (TKDL) database in the PCT minimum documentation. As an update, the European Patent Office had recently posted the first discussion paper regarding objective A on the Task Force wiki referred to paragraph 13 of the document.

222. The Delegation of the United States of America stated that it continued to support the work of the PCT Minimum Documentation Task Force to clarify the definition and extent of both patent and non-patent literature in PCT minimum documentation and recommend criteria and standards for including patent collections in the minimum documentation. The United States Patent and Trademark Office was reviewing the first discussion paper on objective A and believed that it was particularly timely to review and update the inventory of patent and non-patent literature in the PCT minimum documentation since this has last been conducted

in 2001 for patent documentation and in 2010 for non-patent literature. The United States Patent and Trademark Office also looked forward to working in the Task Force, particularly with regard to objective D.

223. The Delegation of the Republic of Korea stated the PCT minimum documentation was one of the most important factors for performing international search and preliminary examination, and it was desirable to increase the extent of the minimum documentation. The Delegation underlined the need to clarify the scope of the minimum documentation in Rule 34 as the Korean Intellectual Property Office had only made documents available to foreign countries from 1978 onwards and did not have published documents dating back to 1920. It was unclear from which year patents needed to be searched from, and whether the entire document was included, or just the abstract and main drawing.

224. The Delegation of India stated that the purpose of including non-patent literature in the PCT minimum documentation was to ensure a comprehensive search. Criteria for inclusion needed to take into account the usefulness of the information, ease of searching, and the source and format beyond standard journal articles. Following agreement in principle by the Meeting of International Authorities to add the Indian Traditional Knowledge Digital Library (TKDL) to the PCT minimum documentation, the Government of India was currently revising the terms and conditions in the access agreement to the TKDL. The Indian Patent Office looked forward to sharing the agreement further with International Authorities after this revision had been completed.

225. The Delegation of Canada stated that document provided a useful outline of the work of the PCT Minimum Documentation Task Force and the Canadian Intellectual Property Office looked forward to contributing to the papers posted on the Task Force. The Canadian Intellectual Property Office believed that modernizing the patent and non-patent literature parts of the PCT minimum documentation would be useful, and it supported broadening the definition of the minimum documentation to include as many publications as possible.

226. The Delegation of Japan supported the work plan proposed in the document by the European Patent Office and was grateful to the United States Patent and Trademark Office for leading the discussions on objective D. The Japan Patent Office looked forward to contributing to the future discussions in the Task Force.

227. The Delegation of China supported the work of the PCT Minimum Documentation Task Force to review the criteria and requirements for inclusion of patent documents, non-patent literature and traditional knowledge databases to standardize the PCT minimum documentation and thus improve the quality of international search.

228. The Working Group noted the contents of document PCT/WG/10/12.

PCT SEQUENCE LISTING STANDARD

229. Discussions were based on document PCT/WG/10/15.

230. The Delegation of the European Patent Office updated the Working Group on the work of the Task Force on Sequence Listings. WIPO Standard ST.26 was adopted by the Committee on WIPO Standards (CWS) at its reconvened fourth session in 2016. Since then meetings had taken place in the Task Force to improve ST.26 further, and a revision of ST.26 had been presented for adoption by the CWS at its fifth session, to take place from May 29 to June 2, 2017. Together with improvements of a technical nature, a guidance document had been added as an Annex to ST.26. In addition, the Task Force had considered how to implement the transition from ST.25 to ST.26, where a set of recommendations would be proposed to the fifth session of the CWS, which were included in the Annex to the document. In particular, paragraph 4 of these recommendations indicated that the “big bang” scenario was the preferable option. Consequently, the transition date between ST.25 and ST.26 would need to

be decided on, which the Task Force had tentatively agreed to be January 2022. The International Bureau had also agreed to provide the authoring and validation software tool for ST.26. With regard to whether the transition date should be determined with reference to the international filing date or the priority date, paragraph 6 of the Annex to the document indicated that the Task Force had provisionally decided that the international filing date would be the most suitable. Once the recommendations were adopted, work would continue on the authoring tool and on discussing revision to Annex C of the *PCT Administrative Instructions* and any future revisions to ST.26 before the standard came into effect.

231. The Delegation of Israel supported the work of Task Force on Sequence Listings and the provisional date for the transition from WIPO Standard ST.25 to ST.26.

232. The Delegation of the United States of America supported the revised text of WIPO Standard ST.26 and hoped that it would be adopted at the fifth session of the Committee on WIPO Standards (CWS). The United States Patent and Trademark Office would continue to participate in the Task Force and provide support to the International Bureau on the development of the authoring and validation tool and on consequential revisions of relevant legal provisions under the PCT. On the latter task, the Delegation enquired about the timeline for revision of the relevant PCT legal provisions by the International Bureau. Finally, the Delegation agreed with paragraph 9(c) of the Annex to the document that future revisions to ST.26 be determined by CWS members and not according to a pre-defined schedule.

233. The Representative of the Japan Patent Attorneys Association (JPAA) expressed support for the “big bang” transition scenario, with the transition date being determined with reference to the international filing date. The JPAA was also ready to cooperate in the development of the tool to assist in transformation of a sequence listing from WIPO Standard ST.25 to ST.26.

234. The Working Group noted the contents of document PCT/WG/10/15.

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

235. Discussions were based on document PCT/WG/10/16.

236. The Secretariat referred to the applications for appointment or extension of appointment as an International Searching and Preliminary Examining Authority prepared for consideration at the thirtieth session of the PCT Committee for Technical Cooperation (PCT/CTC), where many shared a common structure. This structure had evolved from work over the past two years in the Quality Subgroup of the Meeting of International Authorities to create a standard application form to provide the information that an Office or organization would need to demonstrate to Member States that it met the minimum requirements for appointment as an International Searching and Preliminary Examining Authority and would make a useful contribution to the PCT System if they were appointed. The result of that work had been the draft application form in the Annex to document PCT/WG/10/16. The Quality Subgroup had recommended that the draft application form be subject to one final round of comments on details before being presented to the Working Group with a view to recommending that it be adopted by the Assembly as a standard part of the application procedure. However, although many Offices had used the basic structure to present their application to the PCT/CTC, there was considerable variation in the scope and depth of the information provided. For this reason, the final round of comments had not taken place, and the International Bureau now believed that more discussion was needed to determine an optimal way of presenting the information. As such, the International Bureau recommended that this matter be given further consideration by the Quality Subgroup before attempting to reach a definitive conclusion. That type of discussion might, for example, consider whether some of the key issues were ones which, at least in the case of extension of appointments, might be better considered as a matter of ongoing assessment and updated annually, rather than every 10 years when the Assembly needed to approve an extension of appointment. Moreover, the next time the PCT/CTC would consider

many applications in a single session would be in 2027, provided the PCT Assembly later in the year approved the proposed 10 year duration of appointment. Furthermore, the draft could still be used as guideline for any Office or organization seeking appointment as an International Searching and Preliminary Examining Authority in the future without the need for the adoption by the Assembly. The Secretariat therefore recommended further discussion by the Quality Subgroup of the content of the draft application form and what it should achieve.

237. The Delegation of the United Kingdom welcomed the work of the Quality Subgroup on the draft application form. In the view of the Delegation, the use of a standard format for applications to become an International Searching and Preliminary Examining Authority was invaluable not only to the Committee for Technical Cooperation in assessing those applications, but also in helping the applicant Office assure that all relevant information was taken into account. When reviewing the applications for appointment, the Delegation had found it helpful to have the pertinent information structured in the format provided by the form. The Delegation therefore welcomed further efforts by the Quality Subgroup to refine the draft form and it believed that the end goal should be to mandate its use for all new applications. In the meantime, the Delegation strongly encouraged Offices seeking appointment in the near future to make use of the draft form to help ensure that their applications presented all relevant information in a clear and focused way. The Delegation therefore supported the way forward suggested by the International Bureau in the document.

238. The Delegation of Israel supported the draft application form, which the Israel Patent Office had used for its submission for extension of appointment. The Israel Patent Office also supported recording the scope of the search databases and examiner training on an ongoing basis and making this available, such as by incorporation into the annual quality management system reports. This would enable the application form for extension of appointment to focus on the benefits that the extension of appointment of an Office would bring to the international patent system as a whole. Finally, the Israel Patent Office fully supported the suggested way forward as set out in paragraphs 10 to 12 in the document.

239. The Delegation of Brazil recognized the purpose of having the information needed for appointment as an International Searching and Preliminary Examining Authority presented in a standardized form. However, the Delegation could not support the inclusion of items 5 and 6 in the draft application form in the Annex to the document since these items did not relate to the minimum requirements set out in Rules 36 and 63. While this information could be provided by a prospective International Authority, it did not appear necessary to include it in the standard application form. The Delegation supported further evaluation on the usefulness of the draft application form and continuation of the discussions in the Quality Subgroup.

240. The Delegation of Australia stated that the form served as useful basis in the application of IP Australia for extension of its appointment as an International Searching and Preliminary Examining Authority. The form had also been straightforward to use as a basis for consultation with other Office before submission. However, after reviewing the submissions from other International Authorities, the Delegation believed that more work was needed in the Quality Subgroup to ensure that there was consistent use of the form, but it hoped that the form could soon be finalized. In addition, the Delegation suggested that the format of the form was revisited closer to the next extension of appointment process. The Delegation also supported the concept of using the annual quality report or a parallel process to cover operational requirements, which could improve the readability of the information in the form. Overall, the Delegation believed that it was important that the form covered all the minimum requirements in Rules 36 and 63, and while not mandatory, other information could be valuable for the Committee for Technical Cooperation to make a meaningful recommendation on the appointment to the Assembly.

241. The Delegation of the European Patent Office stated that the Quality Subgroup had been working on the draft application form for more than two years, and the content had achieved

consensus among Authorities at the Meeting of International Authorities in February 2017. It was also accepted that parts 5 and 6 of the form were not mandatory, but were valuable information to the PCT membership nonetheless. In addition, the form had enabled an efficient procedure dealing with the applications for extension of appointment at the thirtieth session of the Committee for Technical Cooperation. While it might be several years until the form needed to be used by many Offices at the same time, the Delegation believed that the form was mature in its present format and could be finalized by consultation through a PCT Circular to gather final comments and make the form mandatory for any new Offices or organizations seeking appointment as an International Searching and Preliminary Examining Authority.

242. The Delegation of Japan agreed to continuing discussion of the draft application form in the Quality Subgroup in view of the discussions in the Working Group and the Committee for Technical Cooperation.

243. The Delegation of the United States of America agreed with the comments made by the Delegation of the European Patent Office that the draft application form was now mature and ready for consultation through a PCT Circular. The form had been discussed at the Meeting of International Authorities where consensus had been reached. It was therefore surprising that a Delegation whose national Office operated as an International Searching and Preliminary Examining Authority now indicated difficulties with two sections of the form. The Delegation therefore hoped that the form could be finalized before the next sessions of the Meeting of International Authorities and Working Group.

244. The Delegation of China supported the recommendation of the International Bureau to continue work on the draft application form, which it believed should be consistent with the requirements of the PCT Regulations to ensure basic quality requirements and avoid additional burden. The Delegation also suggested there should be a difference between new appointments and extensions of appointment. The Delegation noted that some Offices had used the form for their applications for extension of appointment, and it suggested that the International Bureau collect comments from Offices on the form.

245. The Delegation of Brazil, in response to the comments by the Delegation of the United States of America, clarified that at the Meeting of International Authorities in February 2017 some Authorities preferred the form to be limited to matters in the PCT and the Regulations under the PCT, but could accept a broader form, provided it differentiated between the minimum requirements for appointment and more general information from International Authorities that was not obligatory. In this sense there was not full agreement on the content of the draft application form. These discussions were referred to in paragraph 3 of the document.

246. The Delegation of the European Patent Office wished to clarify two aspects. First, that the conclusions of the discussions at the Meeting of International Authorities were that further information could be added to the form. Second, the chapeau in the draft application form in the Annex to the document clearly indicated that only the questions in Sections 1 and 2 were mandatory.

247. The Delegation of the Republic of Korea stated that the Korean Intellectual Property Office had used the draft form for its application for extension of appointment, and reported that it had been convenient to use and allowed Member States to review whether the minimum requirements under Rules 36 and 63 had been fulfilled and to obtain general information about the candidate Offices. The Delegation therefore supported the interventions made by the Delegations of the European Patent Office and the United States of America.

248. The Delegation of Canada reported that the Canadian Intellectual Property Office had used the draft application form when preparing its application for extension of appointment. From that experience and observations made in reviewing the submissions from other International Authorities, the Delegation noted the ease with which it could find information. The

Canadian Intellectual Property Office was of the opinion that the form should be promoted and highly recommended to candidate Offices even in its draft form. The Delegation considered that it would be an inefficient use of time for the Working Group to consider the draft application form at this stage, and agreed that the Quality Subgroup should continue its discussions.

249. The Secretariat observed that it would appear that there remained only very few differences of principle, as long as it were clearly understood that only Sections 1 and 2 of the proposed form were intended to be mandatory. The main concerns appeared to be, in essence, matters of drafting guidelines to help Offices understand which sections were essential, what level of detail was relevant to different sections and what variations would be appropriate for Offices in different positions, whether in terms of their organizational structure or because of different motivations for wishing to act as an International Authority. A secondary issue appeared to be whether some aspects of the form might be better handled differently for extension of appointments. For example, it might be appropriate to have ongoing documentation of some of the matters relevant to the minimum requirements in a manner similar to the existing quality reports. This could then be referred to as part of an application for extension, without the need to reproduce this information on the form itself.

250. The Working Group invited the International Bureau to issue a Circular to seek feedback on a refined draft application form and any outstanding issues in order to determine whether a proposal could be brought directly to the Assembly or whether the issue should be further considered by the Quality Subgroup of the Meeting of International Authorities and/or the Working Group.

CORRECTION OF THE INTERNATIONAL APPLICATION IN CASE OF “ERRONEOUSLY” FILED ELEMENTS AND PARTS – ANALYSIS OF ISSUES RELATED TO THE PATENT LAW TREATY

251. Discussions were based on document PCT/WG/10/10.

252. The Secretariat recalled that the interpretation of the PCT provisions dealing with incorporation by reference of missing parts of an application had been discussed in previous sessions of the Working Group, but there had been no agreement concerning the incorporation of an entire element of the international application by reference where such element was already contained in the application as filed, such as when the applicant had filed the wrong description or set of claims. As a possible way forward, the Working Group at its eighth session in 2015 had requested the Secretariat to prepare a working document containing a draft provision to allow the applicant, in very limited and exceptional cases, to replace the wrongly filed claims and/or description of the application as filed with the equivalent correct version of the claims and/or description as contained in the priority document. This proposal had received a mixed response at the ninth session of the Working Group, with some delegations considering the approach to be a reasonable and user-friendly one, while others expressing concerns about the compatibility of the proposal with the Patent Law Treaty (PLT). In particular, under PLT Article 2(1), PLT Contracting Parties would not be free to create more favorable requirements than those in PLT Article 5 concerning the filing date. Moreover, the gap between the filing date requirement applicable to international applications and those applicable to national and regional applications would further widen. To address these concerns, the Working Group in 2016 had asked the Secretariat to present an assessment of PLT-related issues for discussion at the present session. The document provided this assessment. First, the document addressed the question of the compatibility of the proposal with the PLT. In itself, the question of compatibility did not arise since the PLT did not govern the filing date requirements of the PCT. Pursuant to PLT Article 3 as far as international applications were concerned, the PLT only applied in a PLT Contracting Party in respect of the time limits for national phase entry and any procedure after national phase entry had commenced, subject to the provisions of the PCT. Thus, as far as filing date requirements were concerned, the filing date requirements set out in PLT Article 5 did not apply to international applications, neither during the international phase nor during the national phase of the procedures. In other words, the filing date requirements of

PCT applications and of national and regional applications filed with or in respect of a PLT Contracting Party were governed by two distinct and different regimes: the PCT for international applications and the PLT for national or regional applications. Second, the document attempted to address the concern that should the proposed approach be adopted in the PCT, this might result in a widening of the gap between the PCT and PLT filing date requirements in a PCT Contracting State which was also a PLT Contracting Party. The document outlined the different filing requirements between the PCT and the PLT and examined whether it was possible for a PLT Contracting Party to align its law with the proposed approach in respect of a national or regional application while remaining in compliance with the PLT. To tackle this question, the document provided a brief overview of the relevant filing date provisions in the PLT, particularly Article 5(6). To tackle the question of whether a PLT Contracting Party could apply the proposed approach in the PCT in compliance with the PLT, the document considered two aspects. First, the issue of incorporation by reference of the correct element that had erroneously been omitted on filing without loss of filing date (see paragraphs 29 to 31 of the document) , and second, the removal of the wrongly filed element from the application (see paragraphs 32 to 38 of the document). For the first issue, the compatibility with the PLT would depend on whether a “missing” part of the description or drawing within the meaning of PLT Article 5(6) would need to be objectively missing from the application from the perspective of an Office, such as a drawing being referred to in the application but not being filed, or alternatively, whether it was merely sufficient for the element or part to be missing from the applicant’s perspective because it was not filed as intended. As this was a PLT provision, the interpretation of the term “missing” would be a question for PLT Contracting Parties to determine. As for the removal of the wrongly filed element, this would depend on the interpretation of the term “requirements” in PLT Article 2. If “requirements” were interpreted as “requirements for applicants or owners”, a requirement for an Office to invite an applicant to remove the erroneously-filed elements or parts would not have a negative impact on PLT compliance, whereas if it also includes “requirements for Offices”, this could be seen as being more favorable to the applicant than what was prescribed in PLT Article 5 and thus contrary to PLT Article 2(1). Again, the interpretation of these provisions fell within the competence of PLT Contracting Parties. Finally, the document analyzed the effect of the proposal on PLT Contracting Parties under PLT Article 6 relating to the formal requirements of an application which do not have an impact on the filing date. First, as regards the incorporation by reference of the correct element or part without loss of filing date in the proposal, this would not have any effect on PLT Contracting Parties as PLT Article 6 did not apply to filing date requirements. However, as regards the removal of wrongly-filed elements or parts, the document showed that PLT Article 6 would only have an effect on Offices of PLT Contracting Parties if that part of the proposed approach would concern form and contents of an application. In that regard, the question of what constitutes concerns the “form and contents” of an application was a matter for PLT Contracting Parties to decide. However, the procedures for removing content after the filing date appeared to be rather amendment or correction procedures, which would alter the substantive information in the application and not relate to form and contents of an application. The removal of wrongly filed elements or parts from an application would therefore not appear to have an effect on Offices of PLT Contracting Parties under PLT Article 6(1). In conclusion, with regard to the PLT, there was no clear answer to conclude that the proposal was compatible with the provisions in the PLT, but the document did not identify a clear problem of incompatibility.

253. The Delegation of the European Patent Office (EPO) informed the Working Group that the European Patent Organisation had signed the Patent Law Treaty (PLT) but had not ratified the Treaty so was not bound by its provisions. However, 20 Contracting States of the European Patent Convention were party to the PLT. Moreover, the legislative intent behind the revision of the European Patent Convention in 2000 was to ensure compliance with the international obligations of its Contracting States, and the European Patent Office needed to act in a manner not to put its Contracting States in breach of their international obligations. The European Patent Office agreed with the International Bureau that there was no obligation under the PCT to comply with a filing date requirement in the PLT, but it acknowledged that the provisions of

the PCT should be aligned with the PLT to the maximum extent possible. While the PCT provided for uniform formality requirements with respect to international patent applications, the PLT was designed to simplify and harmonize the formality requirements with respect to national and regional applications and patents. However, in order to avoid creating new internationally applicable standards different from those of the PCT, the PLT referred to the provisions of the PCT where appropriate. Indeed, the filing requirements laid down in the PCT and the PLT were not identical, for example, the lack of the requirement that claims needed to be filed under the PLT. Nevertheless, as both the PCT and the PLT had the goal of harmonization, amendments to the PCT which would depart from the PLT were not desirable and would result in different treatment of international applications and national or regional applications. The Delegation noted that no conclusion could be derived from the International Bureau's paper as to the compatibility of the proposal on correcting "erroneously" filed elements and parts with the PLT. Therefore, such a question was left open. However, the Delegation wished to comment on the assessment by the International Bureau. First, the European Patent Office did not agree with the argument in paragraph 30(a) of the document that the legislative history of PLT Article 5(6) might indicate a "missing" part could be "missing" from the application in the sense that the applicant intended to file them but instead filed something different. According to the legislative history of PLT Article 5(6) as discussed in paragraphs 19 to 21 of the document, the word "unintentional" which might be a basis for the applicant's subjective perspective in assessing whether drawings or parts of a description were missing was removed from the final version of PLT Article 5(6). The drafters of the PLT therefore intended that the assessment of whether drawings or part of the description was missing must be made objectively regardless of the applicant's intentions. This was also the interpretation of the PLT in the jurisprudence by the EPO Boards of Appeal. The European Patent Office also believed that it was a fundamental principle of both the European Patent Convention and the Patent Law Treaty that the content of an application could not be extended after the filing date. This provided legal certainty and was in the interest of third parties; the public should not be taken by surprise by claims or other content of the disclosure which could not have been reasonably expected on the filing date based on the application documents as originally filed. Furthermore under the award theory underlying the patent system, the applicant should not be awarded an exclusive right for subject matter which was not disclosed on filing the application, which was underlined in Article 123(2) of the European Patent Convention and was a ground for opposition or revocation of a patent. The European Patent Office also doubted the conclusion in paragraph 30(b) of the document and instead argued that, to determine whether a part was "missing" from an application under PLT Article 5(6), an objective assessment by the Office needed to be made. A broader interpretation of the definition of a "missing" part would therefore be a more favorable requirement, which would contravene PLT Article 2(1). The European Patent Office thus had doubts regarding compliance of the proposal with the PLT. In terms of the PLT allowing a disclosure to be changed after the filing date, the scope of PLT Article 5(6) should be limited so as not to allow the extension of the subject matter beyond the scope of the application as filed without changing the filing date. Moreover, as laid down in PLT Article 2(1), the Contracting Parties could not provide for requirements which would be more favorable to the applicants than the requirements of PLT Article 5. PLT Article 5(6) was therefore binding on the Contracting Parties, who could not create additional or more far reaching possibilities to amend the scope of the disclosure without actually changing the filing date. However, the European Patent Office could, subject to consultation with all of the Contracting States of the European Patent Organisation, support the proposed new approach on the following conditions: (i) the removal of any erroneously filed element or part would not be allowed; (ii) the EPO as receiving Office and as a designated Office would be given the option of making a notification of incompatibility in relation to the proposed PCT Rule 20.5*bis*; and (iii) an International Searching Authority would be entitled to charge an additional fee in the case that the incorporation of a "correct" element or part had occurred after the Authority had begun to draw up the international search report. The Delegation further suggested that, in order to advance the discussions, the Secretariat should convene a workshop dedicated to this issue, ideally during the 2018 session of the Working Group.

254. The Delegation of the United Kingdom stated that it was reassured by the conclusion in the document that the proposal would have no effect on the Offices of Patent Law Treaty (PLT) Contracting Parties under PLT Article 6(1). Turning to the analysis of the effect of PLT Article 5 and the questions in paragraph 39, regarding paragraph (a), practice at the United Kingdom Intellectual Property Office followed a broad interpretation of the term "missing". In the view of the Delegation, PCT Rule 20 did not preclude the incorporation by reference of a correct part or element to replace a wrongly filed one, and the United Kingdom Intellectual Property Office interpreted its corresponding provisions in national law in the same way. With regard to paragraph (b), the Delegation considered that the term "requirements" should be limited to those for applicants or owners in line with many other references to "requirements" in the PLT. The Delegation therefore did not believe that the removal of an erroneously-filed part or element from an application would fall within the scope of PLT Article 2(1), so PLT Contracting Parties would be free to align their law with the proposal in the document for the PCT. The Delegation therefore concluded that the implementation of the proposals would not have any negative consequences under the PLT. However, the Delegation raised the issue of the proposed amendments to Rule 20.5(a), which would explicitly state that the provisions on missing parts did not apply where any elements or parts had been erroneously filed. As United Kingdom national law interpreted the term "missing parts" broadly, these amendments would make it difficult to continue interpreting this term in this way and result in an inconsistency between the national law in the United Kingdom and the PCT. As this was likely to be a problem for other national IP Offices, the Delegation believed that further consideration of the issues was needed before the Working Group could move forward in agreeing any amendments to the Regulations. The Delegation therefore supported the proposal by the Delegation of the European Patent Office to hold a workshop on this issue during the session of the Working Group in 2018.

255. The Delegation of the United States of America stated that it continued to hold the strong view that, where the international application contained an erroneously filed set of claims and/or an erroneously filed description but the applicant nevertheless requested the incorporation by reference of all of the claims and/or all of the description contained in the priority application as a "missing part", such incorporation by reference was clearly covered not only by the spirit and intent but also by the wording of the current Regulations. It was clear that this type of error was what Member States were attempting to address when these provisions were adopted. The Delegation continued to support the aim of the proposal in document PCT/WG/9/13. With regard to the analysis, the Delegation noted the comments in paragraph 8 of the document that the filing date requirements under PLT Article 3 as far as international applications were concerned only applied in a PLT Contracting Party in respect of time limits for national phase entry and any procedure after national phase entry and were "subject to the provisions of the PLT". The Delegation fully concurred with the statement set out in the document that, as far as filing date requirements were concerned, the filing date requirements in PLT Article 5 did not apply to international applications, neither during the international phase, nor during the national phase. The PLT therefore had no bearing with regard to applications under the PCT. Since the proposal was beneficial to applicants, the Delegation believed that it should therefore be adopted. With regard to the question as to whether the adoption of such a provision by Member States with regard to national practice would violate the PLT, the Delegation noted that the document did not give a clear-cut answer to this question and made legal arguments for both sides. The United States of America had adopted procedures related to incorporation by reference of a "correct" element or part as a "missing element or part", which under the interpretation of the PLT in the United States of America were clearly allowed. As such, the Delegation did not agree with the argument that adoption of this procedure in the PCT would be a widening of the gap between the PCT and the PLT since as far as the United States Patent and Trademark Office was concerned, it would result in a narrowing of that gap. As for the discussion in paragraph 29(a) of the document that the proposal would not seem to be allowed under the PLT for Offices using an objective test to determine if a part appeared to be missing, the Delegation pointed out that if the application as filed were to be compared with the priority document, an Office could objectively determine that something was missing. Therefore, regardless of the test applied to determine whether something was "missing" as described in

paragraphs 29(a) and (b) of the document, it could be concluded that incorporating the "correct" part of the description or drawing would be allowed under the PLT. Regarding the discussion in paragraphs 32 to 38 of the document as to whether removal of the erroneously filed part of the application was compatible under the PLT, the Delegation noted that certain amendments of this type were already allowed under the provisions of the PCT. For example, Rule 9.1 provided that certain subject matter shall not be contained in the international application, including expressions or drawings contrary to morality or public order or disparaging statements. Rule 9.2 further provided that if such matter were included in the international application, the applicant would be provided with an opportunity to remove them. In fact, it would seem that an erroneously filed element could arguably be considered irrelevant or unnecessary under the provisions of Rule 9.1(iv). However, the Delegation was open to a modification of the proposal in the document whereby the erroneously filed part of the application remained in the application, similar to the procedure currently followed by numerous Offices under the current provisions. While this would not be an ideal situation, it would allow applicants to introduce the correct subject matter into the specification for it to be searched and examined, which seemed to be the most important aspect of the proposal. In conclusion, the Delegation again noted that the PLT had no bearing on the matter with regard to PCT filings in both the international and national phases and therefore called for the proposal presented at the ninth session of the Working Group to be adopted. To do otherwise would only serve to harm other applicants. This was a situation where an applicant might have made a mistake. For example, a filing clerk assembling the application may have mixed claims up between two different applications and inserted the incorrect set, and it seemed unjust to penalize the applicant where the intended subject matter was in the priority application. In this case there was no question that the applicant was in possession of the subject matter and if it had been incorporated by reference and it would not be considered to be added matter.

256. The Delegation of Japan understood the concerns expressed that the provisions relating to formalities requirements under the PCT should not diverge from national formalities requirements that conform to the Patent Law Treaty. However, it was not desirable for users if the interpretation and practices differed among different countries. The Delegation therefore reiterated its support for the proposal in the document.

257. The Delegation of China expressed the view that the gap between the PCT and PLT filing date requirements might lead to confusion among applicants and stated that it was not advisable to amend the PCT Regulations before Member States had arrived at a common understanding of all of the issues in question. It believed that too flexible provisions would have a risk of being abused by applicants and it was necessary to take into account issues such as the disclosure of the invention as well as the procedures for carrying out international search. It further stated that, in its opinion, it was not possible to replace an entire set of claims and an entire description by way of incorporation by reference of a "correct" element or part.

258. The Representative of the Japan Patent Attorneys Association (JPAA) supported the removal of corresponding wrongly filed elements or parts from the applications as incorporation by reference without loss of the filing date because it was very beneficial for a user who made a mistake. While this might result in different requirements in respect of PCT applications on the one hand and national and regional applications on the other, users would understand such differences and act accordingly.

259. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) stated that it did not consider the incorporation by reference of erroneously filed documents to add subject matter to the application. Third parties would not be taken by surprise, as the application would not have been published at the time of incorporation, and the "correct" element or part to be incorporated by reference would be on file, since it had to be contained in the priority document. The Representative also welcomed the proposal by the European Patent Office to clarify the issue by discussion at a workshop.

260. The Secretariat stated that it would be willing to convene a workshop dedicated to the issue of incorporation by reference of "correct" elements or parts. This could be held towards the beginning of the week of the next session of the Working Group, which would allow conclusions to be reported back to the Working Group itself. The Secretariat also acknowledged the comments from the Delegation of the European Patent Office with regard to showing flexibility to the present situation with the treatment of missing elements or parts by allowing a full search to be performed by the International Searching Authority, even if the incorporation might not be accepted by designated Office in the national phase. This could be among the ideas explored during the workshop. The Secretariat also acknowledged the remarks made by the Delegation of United Kingdom about the interpretation of missing parts and the need for this to be interpreted differently at a national level.

261. The Working Group requested the Secretariat to convene a workshop dedicated to the issue of incorporation by reference of "correct" elements or parts, ideally during the 2018 session of the Working Group.

TRANSMITTAL BY THE RECEIVING OFFICE OF EARLIER SEARCH AND/OR CLASSIFICATION RESULTS TO THE INTERNATIONAL SEARCHING AUTHORITY

262. Discussions were based on document PCT/WG/10/5.

263. The Secretariat explained that the proposed amendments in the documents were intended to amend a reference to Rule 4.1(b)(ii), consequential to the amendment of Rule 12*bis*, and to amend Rule 41.2(b) to correct a reference to a paragraph in Rule 23*bis*.2.

264. The Working Group approved the proposed amendments to the PCT Regulations set out in the Annex to document PCT/WG/10/5 with a view to their submission to the Assembly for consideration at its next session in October 2017.

OTHER MATTERS

265. The Working Group agreed to recommend to the Assembly that, subject to the availability of sufficient funds, one session of the Working Group should be convened between the October 2017 and September/October 2018 sessions of the Assembly, and that the same financial assistance that was made available to enable attendance of certain delegations at this session should be made available at the next session.

266. The International Bureau indicated that the eleventh session of the Working Group was tentatively scheduled to be held in Geneva in May/June 2018.

SUMMARY BY THE CHAIR

267. The Working Group noted the contents of the Summary by the Chair in document PCT/WG/10/24 and that the official record would be contained in the report of the session.

CLOSING OF THE SESSION

268. The Chair closed the session on May 11, 2017.

269. *The Working Group adopted this report by correspondence.*

[Annex follows]

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