

PCT/WG/15/19

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# Patent Cooperation Treaty (PCT) Working Group

**Fifteenth Session**

**Geneva, October 3 to 7, 2022**

Summary by the Chair

# Agenda Item 1: Opening of the session

1. Ms. Lisa Jorgenson, Deputy Director General, Patents and Technology Sector, opened the session and welcomed the participants on behalf of Mr. Daren Tang, Director General of WIPO. Mr. Michael Richardson (WIPO) acted as Secretary to the Working Group.
2. The list of participants is set out in document PCT/WG/15/INF/1.

# Agenda Item 2: Election of a Chair and two Vice Chairs

1. The Working Group unanimously elected Ms. Aleksandra Mihailović (Serbia) as Chair. There were no nominations for Vice‑Chairs.

# Agenda Item 3: Adoption of the agenda

1. The Working Group adopted the revised draft agenda as set out in document PCT/WG/15/1 Prov.3.

# Agenda Item 4: Meeting of International Authorities Under the PCT: Report of the Twenty‑Ninth Session

1. Discussions were based on document PCT/WG/15/2.
2. The European Patent Office (EPO) informed the Working Group that Montenegro had joined the European Patent Organisation on October 1, 2022. The EPO had taken over all functions as a receiving Office for nationals and residents of Montenegro. Montenegro had also closed the national route for obtaining patent protection in Montenegro.
3. The Working Group noted the contents of document PCT/WG/15/2.

# Agenda Item 5: Coordination of Technical Assistance Under the PCT

1. Discussions were based on document PCT/WG/15/10.
2. The Secretariat, in its introduction to the document, informed the Working Group of a proposal by African Group for an Independent External Review of WIPO Technical Assistance in the Area of Cooperation for Development (document CDIP/29/9) submitted to the twenty‑ninth session of the Committee on Development and Intellectual Property, to take place from October 17 to 21, 2022.
3. The Working Group noted the contents of document PCT/WG/15/10.

# Agenda Item 6: Patent Examiner Training

## (a) Coordination of Patent Examiner Training

## (b) Repository of e‑Learning Resources

1. Discussions were based on documents PCT/WG/15/4 and PCT/WG/15/7.
2. Delegations expressed interest in sharing material related to patent examiner training. Delegations also supported the proposed survey to identify the needs of patent Offices in terms of patent examiner training. One delegation suggested working towards developing some common modules under the aegis of WIPO that included courses on assignment of International Patent Classification (IPC) codes and fundamentals of conducting search, which are basic competences to be acquired by examiners.
3. Delegations supported the creation of a repository for e-learning resources, with some Offices showing interest in providing resources for the repository. One delegation noted that the content in the repository would need to be maintained and kept up-to-date. This delegation asked how material would be reviewed to ensure that any new content was consistent with the PCT and did not contradict other content in the repository. One IP Office needed time to review copyright issues before being able to provide its recorded training program on a WIPO platform.
4. In response to the issue related to the maintenance of the e-learning system, the International Bureau indicated that the content of the majority of training data could be accessible via hyperlinks, and the content as such need not be part of the proposed learning management system, reducing the maintenance overhead. The International Bureau would regularly check the validity of such links and add links to further relevant e-learning resources. In case Offices would wish to upload e-learning content to the repository to be shared with other offices, they could be given certain administration rights for the repository to maintain the uploaded content. Offices could consider using a simplified copy of the learning management system at a local level to create further content or customized learning resource management.
5. The International Bureau indicated that it would present to the Working Group, at a future session, a more detailed concept for the operation of such repository and the roles of the International Bureau and other Offices in the administration and use of such repository.
6. The Working Group noted that further information had been given in a side event on the coordination of examiner training, including a presentation of a Moodle-based learning management system[[1]](#footnote-2). In particular, it was demonstrated that the current compilation of e‑learning resources was converted to a database accessible for guest users without registration. The International Bureau announced that a copy of this database would be made available for uploading to other Moodle‑based learning management systems.
7. The Working Group:
   * 1. noted the content of documents PCT/WG/15/4 and PCT/WG/15/7;
     2. supported the development of an independent repository for e-learning resources as presented in paragraphs 20 and 21 of document PCT/WG/15/4; and
     3. approved the International Bureau conducting a survey as proposed in paragraph 16 of document PCT/WG/15/7.

# Agenda Item 7: PCT Online Services

1. Discussions were based on document PCT/WG/15/15.
2. Delegations indicated that their Offices used the PCT online services extensively and appreciated the cooperative efforts made by the International Bureau in online services. Particular projects of relevance included migrating away from PCT-EDI batch transfers to using machine-to-machine services with the International Bureau, supporting the transition from PCT‑SAFE filing to ePCT‑Filing, and implementing online receiving Office and International Authority processing using ePCT. The European Patent Office noted the successful integration of ePCT‑Filing into its eOLFv2, which it hoped would provide a good model for its Front Office solutions for other Offices in Europe. Several International Authorities indicated the status of XML report implementation. Some requests were made for improved data availability.
3. In response to a question related to the security of Machine-to-Machine online solutions, the Secretariat explained that the ePCT system had been designed from the outset with security in mind and invited Offices with security concerns around implementing machine-to-machine processing to discuss such issues with the International Bureau.
4. In respect of eliminating paper communications, some delegations appreciated the functionality in ePCT that enabled a largely paper‑free process throughout the pandemic, reminded the International Bureau that the envisaged eNotifications for official communications via the International Bureau would be beneficial to applicants when implemented, and noted progress in Offices’ own delivery mechanisms.
5. The Working Group noted the contents of document PCT/WG/15/15 and invited the International Bureau to continue the development of online services taking into account the comments made.

# Agenda Item 8: Processing International Applications in Full Text Format

1. Discussions were based on document PCT/WG/15/14.
2. Delegations that took the floor supported the move towards full text processing of international applications, but many details remained to be determined. Delegations underlined the importance of user dialogue in reaching this goal noting the importance of communications between an Office and the applicant, and between applicants and agents, in addition to communication of application data between Offices. The option to file in XML format was not widely used at many of the Offices at which it was available. Several delegations informed the Working Group of progress at their IP Offices towards accepting XML filings in the PCT, their processing in full text and the generation of international work products in XML. One delegation recognized the benefits of full text processing, but was not able to invest in the required resources at this stage. One delegation stated that its national IP Office would soon complete upgrading its system to convert PDF and paper applications into XML format as the version for processing, but was not presently planning to extract the information from DOCX filings. One delegation indicated that it used WIPO’s DOCX converter for its national filings and, with modifications based on user feedback, it had been accepted by applicants.
3. Issues of particular concern to various delegations included:
   1. the importance of accepting replacement content at the level of headings, paragraphs, claims and drawings, rather than pages;
   2. the consequential effects on paragraph numbering and cross‑referencing, which would also affect the specifications of application processing software at Offices;
   3. rules for file formats such as for tables and drawings;
   4. the status of the DOCX file compared to XML used for processing, at what stage and by whom conversion should take place, the ability of applicants to see immediately the results of conversion, and what possibilities should be available in the case of discrepancies of substance between the original and a conversion (on which opinions differed);
   5. whether compatibility could be maintained between Offices using WIPO Standard ST.36 and those using ST.96;
   6. whether common conversion software was needed or, if not, what degree of consistency was necessary between different conversion tools; and
   7. the support that the International Bureau could offer to Offices of different types to handle processing of full text application bodies through ePCT services.
4. The Secretariat indicated that it was considering holding online workshops with Offices and users to explore ways to advance full text processing of international applications. It was important to engage applicants so that requirements that were proposed would present solutions that users could trust. One delegation indicated that it had conducted similar workshops and noted that the experiences and views of the users were diverse and changed over time, noting their different levels of experience with XML. It would be important to seek the views from a suitably wide range of users.
5. The Working Group invited the International Bureau to continue to investigate the relevant issues with processing international applications in full text format to identify practical ways forward that would give clear and simple arrangements for applicants and would deliver the necessary technical results and legal certainty.

# Agenda Item 9: WIPO Fee Transfer Service

1. Discussions were based on document PCT/WG/15/17.
2. Delegations expressed satisfaction with the WIPO Fee Transfer Service, appreciating the benefits of the improvements in administrative efficiency that it delivers. Most delegations broadly supported the first proposal in Annex I, aimed at making use of the service mandatory for transfer of fees collected by one Office for the benefit of a different Office. One delegation indicated the wish for the proposals to go further to ensure that International Searching Authorities could safely rely on transfers occurring in the month following the delivery of a search copy. However, some delegations had not had time to complete consultations and analysis. Furthermore, other delegations considered that it was an important part of the current arrangements that Offices were free to choose whether to use it and suggested that mandatory use of the Service might not be compatible with national laws, or that it might be difficult for Offices to change their financial systems in time for the new requirements.
3. The Secretariat clarified that the proposal related only to fees collected by one Office for the benefit of a different Office and that it would result in no changes at all for Offices already participating in the Fee Transfer Service. It understood that the Offices not currently participating in the system were not against the principle of participating but were prevented by the fact that the Rules stated that the fees were to be transferred to the beneficiary Office (in general, the International Searching Authority) and that present Rule 96.2(c) was not considered a sufficient legal basis for them to pay to the International Bureau. It was understood that introducing an explicit requirement in the Regulations that fees were to be transferred to the International Bureau should overcome this difficulty.
4. Some delegations supported the second proposal, to add the option of supporting “centralized payments”, where the International Bureau would offer the option in some cases of collecting certain fees on behalf of the Office that would normally do so. However, delegations stated that more study was required of many details of the indicative draft amendments in Annex II. Issues included potential additional burdens or uncertainties for applicants faced with payment to different systems, implications on computerized systems and financial processes, the scope of types of payment covered and the range of Offices that would be affected. It was pointed out that for many fees, centralized payment would offer no benefits to either applicants or Offices and would indeed be difficult or impossible to offer in some cases, particularly before the receipt of the record copy by the International Bureau.
5. The Secretariat clarified that the proposals were an indicative draft, intended to help begin the necessary discussions. The proposal was intended to offer an option for certain cases where it was useful, could be fully automated and the relevant national Office was willing and able to make the necessary arrangements to ensure that the financial and procedural requirements were met. The International Bureau was neither capable nor desirous of offering a centralized service covering all fee payments. Furthermore, it wished to be certain that any arrangements for centralized payment were practical and would not result in excessive development or support costs before moving beyond anything other than small scale pilots.
6. The Chair concluded that there was significant support in principle for the proposals, but that further consideration was required.
7. The Working Group invited the International Bureau to further consider the proposals set out in Annexes I and II of document PCT/WG/15/17 and to submit proposals to the next session of the Working Group.

# Agenda Item 10: Filing Medium of International Applications and Related Documents

1. Discussions were based on document PCT/WG/15/13 and a presentation given by the Delegation of Brazil[[2]](#footnote-3).
2. All delegations advocated the filing of applications in electronic form and several supported the proposed amendments in the Annex to document PCT/WG/15/13, noting that the proposal left flexibility for national Offices to choose the approach appropriate to their requirements and that the International Bureau could offer a route for filing paper if required. However, some delegations expressed concerns regarding the issue of making the electronic format mandatory. These delegations mentioned that, under some exceptional circumstances, and despite the very low volume of applications still received in paper form, filing in paper form should remain an option for applicants. Some delegations considered that the very high rate of use of electronic filing showed that they had already reached the point where paper filing was only used in exceptional circumstances.
3. Some delegations were concerned that the proposed amendments would be inconsistent with the Patent Law Treaty (PLT), which requires the Offices of Contracting Parties to accept filings and, in certain circumstances, subsequently filed documents on paper. Although the PLT did not apply to international applications, it had been a general principle that the PCT should be developed in consistency with the PLT.
4. The Chair concluded that there was significant support for the principle of taking the next step away from paper filings, but concerns remained over safeguards and compatibility with the Patent Law Treaty.
5. The Working Group:
   * 1. invited the Delegation of Brazil to work with the International Bureau and interested Contracting States on a revised proposal to be discussed at a future session of the Working Group; and
     2. invited the International Bureau to study the issues concerning electronic‑only entry into the national phase.

# Agenda Item 11: Formalities Checking in the PCT

1. Discussions were based on document PCT/WG/15/6.
2. Some delegations supported the proposal for the International Bureau to take on the primary role for formalities examination since it was in the best position to judge the requirements for the international publication for which it was responsible and to deliver a consistent result.
3. Some other delegations doubted the benefits. Issues included that the receiving Office was able to perform a more timely check and remained responsible for other correspondence with the applicant, so introducing a second body might cause confusion. In countries where many applications were filed on paper, correspondence with the International Bureau could add considerable time and expense for applicants. There were also concerns over the consistency of the proposal with Article 14(1). Several of these delegations suggested that it was more appropriate to build on the existing system, but improving the communications between the receiving Office and International Bureau.
4. Some delegations, while recognizing the difficulty of the task, noted that the International Bureau should attempt to define “reasonably uniform publication”, so that Offices and applicants alike could understand the requirements necessary in the filing and processing of international applications.
5. A variety of drafting issues were raised, including concerns of consistency, possible duplication of duties and the need to include additional details concerning timing, changes to PCT Forms and procedures. Several Offices considered it undesirable for the International Authorities to play any role in correction of formalities defects other than through rectification of obvious mistakes or amendments as part of international preliminary examination. Further consideration was needed of the scope of issues related to “informal drawings”.
6. The Secretariat indicated that it saw no consensus on the proposal, but noted that, in addition to the above points, it had heard strong interest in a variety of the issues, including the need to define clearly the requirements for physical requirements of the international application, bringing Rule 11 more into line with the requirements of electronic applications. A representative of users emphasized the importance of allowing color drawings as part of such changes. There was interest in the ability to point out certain formalities defects without necessarily requiring them to be corrected, though one Office considered that this would risk confusion and problems in the national phase. Independent of formalities checking, the Secretariat noted interest in expanding the languages for communication between applicants and the International Bureau and agreed to raise this issue separately at a future session of the Working Group.
7. The Working Group invited the International Bureau to further investigate options for the improvement of formalities examination, taking into account the comments made.

# Agenda Item 12: Mixed-Language International Applications

1. Discussions were based on document PCT/WG/15/18.
2. Delegations expressed sympathy for the difficulties that a receiving Office faced in the scenario of an international application containing more than one language, with all such languages being accepted filing languages at that receiving Office. However, as the proposal had only been recently submitted to the Working Group, delegations required more time to study the proposal before providing definitive views.
3. A variety of possible drafting issues were raised concerning time limits for submitting the translation and ensuring that the proposal worked for special cases, such as an application relating to a translation tool, where inclusion of text in a language different from the bulk of the disclosure was an important aspect of describing the invention.
4. In response to a question from one delegation on the wording of Article 3(4)(i) in the English and French texts of the Treaty, the Secretariat referred to Article 67(1)(a), where it states that both texts are equally authentic.
5. The Working Group invited the European Patent Office to submit a revised proposal to a future session of the Working Group, taking into account the comments made during the session and subsequent discussions on the proposal.

# Agenda Item 13: Formal Integration of the Patent Prosecution Highway into the PCT: Revised Approach

1. Discussions were based on document PCT/WG/15/16.
2. Many delegations indicated that they supported the PPH system and found it to be useful for applicants and Offices alike, bringing accelerated processing, efficiencies and improved quality. These delegations supported the extension of the PPH system and several affirmed both their belief that it was of common benefit and the importance of finding a clear and consistent approach. Some delegations indicated that they were interested in improvements to the patent system, but needed more information to be able to determine what was best for the particular circumstances of their national Office. Some delegations that used the PPH system and found it useful nevertheless indicated that this was based on implementing it in accordance with the specific needs of their Office and retaining the ability to place appropriate limitations on it to ensure that national priorities could be met, including issues of quality and efficient workflow for non‑PPH applications. Some delegations commented that there should be transparency of effect of any bilateral arrangements within the context of a multilateral Treaty and there should be consideration of other policy issues such as the effects on technology transfer and how such programs facilitate achievement of the United Nations Sustainable Development Goals, keeping in mind the special needs of developing and least developed countries (LDCs) and how these fit into the WIPO Development Agenda. There was also a recommendation to study the impact of PPH agreements on applicants who are not able to avail PPH.
3. The Working Group agreed that an information‑sharing workshop would be useful. Various subjects were suggested, including benefits, areas to make more consistent, required flexibilities and improved statistics to make use of the system more transparent and help feed information into analysis and policy‑making. The Secretariat agreed to facilitate a discussion of appropriate arrangements. A likely first step would be to send a Circular inviting interested parties to participate in informal discussions through appropriate fora, possibly including exchanges of email, online meetings and the PCT Working Group wiki.
4. The Working Group invited the Secretariat to work with interested parties to arrange an information‑sharing workshop at a future in person session of the Working Group, taking into account the comments made during the meeting.

# Agenda Item 14: PCT Minimum Documentation

## (a) Proposed Amendments to the PCT Regulations

## (b) Status Report and Extension of Mandate

1. Discussions were based on documents PCT/WG/15/11 and PCT/WG/15/12 and a presentation given by the European Patent Office[[3]](#footnote-4).
2. Delegations supported the proposed changes to the Regulations and Administrative Instructions set out in the Annexes of document PCT/WG/15/11 in principle, and the extension of the mandate of the PCT Minimum Documentation Task Force described in document PCT/WG/15/12. Two user groups also expressed support for the proposals, which would better define the scope of prior art. However, some delegations indicated that it was important that International Authorities were clear about the practical details of implementation of the proposal before adoption of the proposed amendments to the PCT Regulations. In order to ensure that this could be achieved, the International Bureau encouraged any delegation with concerns about how the requirement to make patent documents available would apply to its own collection to send concrete examples to the Task Force before its next session, to be held from November 14 to 18, 2022 so that drafting issues of the Administrative Instructions could be resolved.
3. The European Patent Office clarified that the proposed Understanding in Annex II to document PCT/WG/15/11 was intended for International Authorities that did not publish or grant patent applications and had been established under an intergovernmental agreement with the national Offices of the States party to that agreement performing international search and preliminary examination. At present, there were two such International Authorities, the Nordic Patent Institute and the Visegrad Patent Institute.
4. Some delegations proposed modifications to the drafting of the proposed Annex H to the Administrative Instructions in Annex III to document PCT/WG/15/11 for further consideration at the next meeting of the Task Force. One of these delegations proposed modifications to address concerns about the International Bureau sharing documents with International Authorities, which it believed should require the consent of the providing Office. This delegation also stated that providing indications in the Authority File on whether the abstract, description, and claims were searchable should be optional. Another delegation recommended that the patent documents in the PCT minimum documentation should be made available on PATENTSCOPE. Following the Indian Cabinet approval on August 17, 2022 to widen access of the Indian Traditional Knowledge Digital Library (TDKL) to users besides patent Offices, some delegations stated that the issues concerning the compatibility of the TKDL with the proposed criteria for inclusion in the minimum documentation appeared to have been resolved. Nevertheless, the Indian Patent Office considered that Traditional Knowledge continued to have special concerns and intended to provide a modified paragraph 36 of the proposed Annex H to the Administrative Instructions before the upcoming Task Force meeting.
5. The Working Group invited the PCT Minimum Documentation Task Force to consider the remaining issues with the proposals in document PCT/WG/15/11, mainly in the terms of the practical implementation in the Administrative Instructions, with a view to bringing a revised proposal to the next session of the Working Group.

# Agenda Item 15: Citation of Non Written Disclosures

1. Discussions were based on document PCT/WG/15/5.
2. Delegations supported the principle of extending the definition of prior art under the PCT to include non-written disclosures. This inclusion would help to improve the quality of international search reports and international preliminary examination reports. Delegations also mentioned the fact that, increasingly, some technical disclosures might be available only in non‑written form, so that the extension would be needed to capture all the relevant prior art. Delegations confirmed that the extension of the definition of prior art under discussion would be in line with the various national patent laws. Some delegations also underlined the current difficulties Authorities may be confronted with when citing non-written material in an international search report. A number of drafting issues were raised and delegations indicated that they had national practices that could form the possible basis of new guidelines for the PCT.
3. Many delegations observed, however, that the proposed extension of the definition of prior art would present challenges from a technical and legal point of view. In particular, copyright issues may arise when non-written material is stored in a repository and made available to different interested parties. Practical issues such as those mentioned in paragraph 6 of the document would also need to be further discussed before any amendments to the PCT Regulations were adopted.
4. The Chair concluded that there appeared to be general agreement on the principle that non‑written disclosures should be considered prior art within the PCT, but that a number of related issues needed to be further considered before the Regulations were amended.
5. The Working Group invited the International Authorities to study the requirements for effective implementation of including non‑written disclosures as prior art, taking into account the comments made, and to make recommendations on further work.

# Agenda Item 16: Sequence Listings

## (a) Implementation of WIPO Standard ST.26

## (b) Sequence Listings Task Force: Status Report

1. Discussions were based on documents PCT/WG/15/3 and PCT/WG/15/9.
2. Delegations observed that in general the implementation of WIPO Standard ST.26 using XML for sequence listings had been successful. A small number of applications had been affected by a bug in the WIPO Sequence software that had been rectified through the release of a new version of WIPO Sequence shortly after its identification. Delegations described the actions put in place to minimize any further the filing of such cases. One delegation suggested that a legal remedy for applicants seeking relief needed to be investigated.
3. Delegations appreciated the collaborative efforts that had gone into the development of both WIPO Standard ST.26 and the associated WIPO Sequence software. They looked forward to further improvements to WIPO Sequence and the intended implementation of improved XML sequence listing viewing facilities for the public in PATENTSCOPE. Delegations hoped that the viewing facilities could be released as a module, both as a further improvement to WIPO Sequence and for use in other services by national Offices.
4. Addressing the proposal that the Committee on WIPO Standards develop a new standard to enable the transmission of sequence listings in WIPO Standard ST.26 format as part of priority documents and certified copies, delegations that took the floor expressed support, proposed that the standard would be separate from WIPO Standard ST.26 itself and welcomed discussion in an international forum. It was observed that an adopted standard would need to be implemented in keeping with longer-term national implementation plans, covering other issues such as application bodies, and another observed that some Offices continue to issue priority documents and certified copies on paper. The Secretariat confirmed that, as WIPO Standards are recommendations in general, the new standard would be a recommendation, but that consistent implementation would be important if Offices wished to be able to use the contents effectively in an interoperable manner. One delegation noted that further consideration was needed for Offices that continued to issue certified copies in paper and PDF formats.
5. In response to a query, the Secretariat confirmed that it was intended that when revisions to WIPO Standard ST.26 are approved, the Committee on WIPO Standards should make recommendations on the date of entry into force of the new version and that the Director General would typically decide that this should be the applicable date for the purposes of the PCT, in accordance with paragraph 5 of Annex C to the Administrative Instructions.
6. The Working Group:
   * 1. noted the contents of documents PCT/WG/15/3 and PCT/WG/15/9; and
     2. recommended to the Committee on WIPO Standards to undertake assessment to develop a new standard to enable the transmission of sequence listings in WIPO Standard ST.26 format as part of priority documents and certified copies.

# Agenda Item 17: IP5 PCT Collaborative Search and Examination: Status Report

1. Discussions were based on document PCT/WG/15/8.
2. The Working Group noted the contents of document PCT/WG/15/8.

# Agenda Item 18: Other matters

1. The International Bureau agreed to work with the Eurasian Patent Office and the Federal Service for Intellectual Property (Rospatent) towards the making available of a number of Forms not currently available in Russian language versions in ePCT. The International Bureau also agreed to review the availability of other Forms in all PCT languages of publication.
2. The Secretariat explained the effect of the new WIPO General Rules of Procedure on the election of officers for the Working Group and indicated that it may propose Special Rules of Procedure at a future session. Comments were welcome on the particular needs of the Working Group based on its typical schedule and working methods.
3. The Working Group agreed that it was desirable to hold a further session before the next session of the PCT Assembly, scheduled to take place from July 6 to 14, 2023. The Working Group noted that the sixteenth session would provisionally take place in remote format only, from February 6 to 8, 2023.

# Agenda Item 19: Summary by the Chair

1. The Working Group noted the present summary, established under the responsibility of the Chair.

# Agenda Item 20: Closing of the session

1. The Chair closed the session on October 7, 2022.

[End of document]

1. Presentations from the side event are available from the WIPO website at: <https://www.wipo.int/meetings/en/details.jsp?meeting_id=73655>. [↑](#footnote-ref-2)
2. A copy of the presentation is available at: <https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=586611>. [↑](#footnote-ref-3)
3. A copy of the presentation is available at: <https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=587071>. [↑](#footnote-ref-4)