

## **Patent Cooperation Treaty (PCT) Working Group**

**Seventh Session  
Geneva, June 10 to 13, 2014**

### **REPORT**

*adopted by the Working Group*

1. The Patent Cooperation Treaty Working Group held its seventh session in Geneva from June 10 to 13, 2014.
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, Belgium, Benin, Brazil, Brunei Darussalam, Canada, Chile, China, Colombia, Costa Rica, Cuba, Czech Republic, Denmark, Ecuador, Egypt, Finland, France, Germany, Greece, Guatemala, Hungary, India, Iran (Islamic Republic of), Israel, Italy, Japan, Kenya, Kyrgyzstan, Latvia, Lithuania, Mauritania, Mexico, New Zealand, Nigeria, Norway, Poland, Portugal, Qatar, Republic of Korea, Romania, Russian Federation, Saudi Arabia, Singapore, Slovakia, South Africa, Spain, Sweden, Switzerland, Thailand, Ukraine, United Kingdom, United States of America, Viet Nam (54); (ii) the following intergovernmental organizations: European Patent Office (EPO), the Nordic Patent Institute (NPI) (2).
3. The following Member State of the International Union for the Protection of Industrial Property (Paris Union) participated in the session as an observer: Iraq (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), Institute of Professional Representatives before the European Patent Office (EPI), International Federation of Industrial Property Attorneys (FICPI), Third World Network (TWN) (5).

6. The following national non-governmental organizations were represented by observers: All China Patent Agents Association (ACPAA), American Intellectual Property Law Association (AIPLA), Asociación de Agentes Españoles Autorizados ante Organizaciones Internacionales de la Propiedad Industrial (AGESORPI), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Polish Chamber of Patent Attorneys (6).

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

### **OPENING OF THE SESSION**

8. Mr. Francis Gurry, Director General of WIPO, opened the session and welcomed the participants. Mr. Claus Matthes (WIPO) acted as Secretary to the Working Group

9. The Director General informed the Working Group that Iran (Islamic Republic of) had deposited its instrument of accession on July 4, 2013, to become the 148<sup>th</sup> Contracting State of the PCT, and that the Assembly at its forty-fourth session in September/October 2014 had appointed the State Intellectual Property Service of Ukraine as the 19<sup>th</sup> International Searching Authority and International Preliminary Examining Authority. The Director General also informed the Working Group that the Indian Patent Office had started operating as an International Searching Authority and International Preliminary Examining Authority on October 15, 2013, and that the National Institute of Industrial Property of Chile would commence operations as an International Searching Authority and International Preliminary Examining Authority on October 22, 2014.

10. The Director General further informed the Working Group of some highlights for 2013, which had been a successful year for the PCT system. By the end of 2013, there were 148 Contracting States, representing around 98 per cent of world gross domestic product. In 2013, the number of filed international applications passed the 200,000 milestone for the first time to more than 205,000 applications, representing a growth rate of 5.1 per cent. International applications were filed in 123 countries, three more than in 2012. There were more than 45,600 different applicants using the PCT system, again showing a slight increase from the previous year. Panasonic of Japan with 2,881 published PCT applications took over the position as the top individual filer from ZTE Corporation of China. In terms of the origin of applicants, the United States of America had a significantly increased number of applications filed under the PCT compared to last year, and with 57,000 international applications it exceeded its previous filing peak in 2007 before the global financial crisis. In second place by country of origin was Japan, with nearly 44,000 international applications, followed by China in third place with about 21,500 applications, showing an increase of 15.6 per cent in patent filings and overtaking Germany, which had just over 17,900 international applications and became the fourth largest user. There were also significant increases in the use of the PCT from low and middle income countries, for example, Turkey showed the largest increase of 56 per cent in the number of international applications, followed by Mexico with an increase of 22 per cent, and then by Brazil with an increase of 12.2 per cent. There were also a record number of national phase entries, up 5.1 per cent to nearly 540,000, representing a significant number of individual patent applications originating from the PCT system. Among those national phase entries, there were more than 6,300 requests to accelerate national procedures under bilateral PCT Patent Prosecution Highway (PPH) arrangements.

11. The Director General concluded by commenting on the participation of many Offices in the ePCT system and indicated the availability of the International Bureau during the meeting to assist Offices and discuss individual requirements. In this regard, input from delegates could assist the International Bureau in the development of the ePCT system to maximize its advantages and optimize the system for its individual users.

#### **ELECTION OF A CHAIR AND TWO VICE-CHAIRS**

12. The Working Group unanimously elected Mr. Victor Portelli (Australia) as Chair for the session. There were no nominations for Vice-Chairs.

#### **ADOPTION OF THE AGENDA**

13. The Working Group adopted the revised draft agenda as set out in document PCT/WG/7/1 Rev.

#### **OPENING STATEMENTS**

14. The Delegation of Chile informed the Working Group that the National Institute of Industrial Property of Chile (INAPI) would begin offering its services as an International Searching Authority and International Preliminary Examining Authority from October 22, 2014. The Delegation thanked the numerous Offices, particularly in the Latin American and Caribbean region, which had provided support to INAPI to enable it to begin operating as an International Authority within its planned timeframe, and also for the technical assistance provided by the International Bureau. The Delegation also thanked the Offices of the United States of America, Canada, Israel and Australia for their valuable cooperation. Over recent years, INAPI had carried out an active policy of modernization, including an overhaul of its structure and internal processes, an increase in the number of professionals and experts in searching and examining in the various different technical fields, the implementation of a quality control system for managing requests for and examining of patents within the framework of the PCT international phase, and the setting up of its online system using ePCT. As such, INAPI was now ready to undertake the important task of search and preliminary examination of international applications. The PCT had become a highly requested route for patent applicants in Chile as the third highest Latin American country in terms of the number of international applications. This showed not only the widely recognized virtues of the international system, but also the dynamism taken in the international patent system, where the PCT was a perfect complement within a dynamic and open economy to the world. In light of this, the Delegation had taken great interest in the development of the PCT as the back bone of the patent system, and as such believed that it could contribute to strengthening and affecting the patent system, particularly the PCT, in a balanced way such that it could be an instrument which effectively met the needs of users in Chile. The Delegation believed that the agenda of the meeting suitably reflected the challenges that lay ahead for national Offices, in the progressive implementation of technological tools which would safely facilitate the management of a growing number of international applications, particularly in the work of International Authorities. Normatively speaking, the Delegation indicated its intention to continue constructively contributing to discussions on modifications of the Regulations to respond to the needs of users under the framework set by its national legislation.

15. The Delegation of Singapore reported that Singapore was a heavy user of the PCT system, and affirmed its commitment to the Working Group to continually improve the PCT system for the benefit of all users and Contracting States. As PCT applications grew, particularly in Asia, the Delegation underlined that the system could benefit from an increase in production capacity of quality international search and preliminary examination reports. The Delegation believed that Singapore could contribute in this area. To this effect, the Delegation informed the Working Group that it intended to submit an application to the Assembly for the Intellectual Property Office of Singapore (IPOS) to be appointed as an International Searching and Preliminary Examining Authority (ISA/IPEA) under the PCT, for consideration at its next session in September 2014. The Delegation believed there was space for more International

Searching and Preliminary Examining Authorities in the Asian region to cater for the growing demand, where together with other International Authorities in the world, it hoped to present more capacity and options for quality PCT searching and preliminary examining services to businesses and other IP stakeholders, thereby encouraging the greater use of the PCT system in general. With Singapore's long standing focus on research and development, IPOS had been able to draw from a rich talent pool to put together a highly capable search and examination unit in a short span of time. Today, over 95 per cent of patent examiners at IPOS were PhD qualified, with an average of seven years of industry experience in research institutions or companies. Singapore also had the advantage of being a multiethnic society and a globally connected economy. All examiners were fluent in English as the Office working language. In addition, there was a good spread of language abilities covering Chinese, Indonesia and Japanese. Most examiners were not only able to search in languages aside from English, but were also bilingual and able to search and examine the same file in more than one language if required. Apart from investing in recruiting the right examiners and equipping them with a comprehensive set of tools, IPOS had paid particular attention to their training. In this regard, it had collaborated with established patent Offices for the formal training, complemented by examiner exchanges with these Offices. Examiners at IPOS were also guided by experienced in house examiners who had worked in established patent Offices, and the Delegation intended to continue to work with and learn from established patent Offices to ensure quality service in a future role as an ISA and IPEA. The Delegation informed the Working Group that it had recently provided information to Geneva-based missions and was ready to work with all parties to ensure that IPOS would be an ISA and IPEA that provided quality work. Finally, the Delegation expressed the hope that its application would be considered positively by the Assembly, and indicated its willingness to assist delegations which had any questions or requests for clarification.

## **PCT STATISTICS**

16. The Working Group noted a presentation by the International Bureau on the most recent PCT Statistics<sup>1</sup>.

## **PCT ONLINE SERVICES**

17. Discussions were based on document PCT/WG/7/2.

18. The Secretariat outlined the features of ePCT, a set of browser based services available for both applicants and Offices. ePCT offered a wide range of services including online filing, transmission of correspondence after filing between applicants and Offices, status information, and the transmission of usable data to replace sending letters and transcribing information. The Annex to the document provided a provisional timetable for some of the expected improvements to the system in 2014 and 2015. At the moment, ePCT only had an English user interface, but the test environment had all 10 PCT languages of publication, with some of these languages soon ready for release into the demo environment for evaluation by Offices and applicants, with the other languages to follow as soon as possible. However, ePCT was reaching the limit of what could be achieved independently by the International Bureau. The main potential for improvement in the system required action by Offices, where input was desired on what could be done to provide the best services possible to applicants and third parties.

19. The Secretariat indicated that of the 116 receiving Offices, only 28 offered electronic filing. An applicant intending to file electronically in countries whose national Offices did not offer electronic filing would be required to use the International Bureau or, in the case of a few of the European countries, the European Patent Office. Even amongst those 28 Offices with electronic filing, most of them did not offer the transmission and the receipt of post filing documents, and most documents were transmitted from the receiving Office to the International

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<sup>1</sup> A copy of the presentation is available on the WIPO web site at [http://www.wipo.int/edocs/mdocs/pct/en/pct\\_wg\\_7/pct\\_wg\\_7\\_statistics.pptx](http://www.wipo.int/edocs/mdocs/pct/en/pct_wg_7/pct_wg_7_statistics.pptx)

Searching Authority on paper. To take an example, an applicant from an African country using the European Patent Office as the International Searching Authority would file at his receiving Office, which would send the search copy to the European Patent Office on paper, taking a couple of weeks to arrive. Even if the European Patent Office performed the international search in a timely manner, there could be delays with the unity of invention, adding another few weeks to the procedure to send an invitation to pay additional fees and receive a response from the applicant. This could result in the international search report not being prepared in time for publication with the international application, which was not a satisfactory outcome for the applicant, the International Searching Authority, or third parties. The International Bureau was therefore looking to improve the ePCT system to provide equally high service levels for all applications filed at any Office by allowing smaller Offices to offer electronic services to applicants for the electronic filing, transmission and receipt of documents, thereby eliminating delays without the cost to the individual Offices of a setting up and maintaining a complicated IT infrastructure. The system had been developed to ensure compatibility with highly automated services that were already in place. The Secretariat therefore encouraged smaller Offices to consider using ePCT for processing applications and for larger Offices to ensure that their automated services assisted applicants who wish to use this interface.

20. The Secretariat continued by emphasizing that, unlike PCT-SAFE, the filing facility in ePCT did not require installing releases with new information, typically every three months. In addition, it allowed for a wider range of formalities checks. ePCT filing had gone live for receiving Offices of the International Bureau, Austria, Australia, Finland and Sweden, and the International Bureau hoped that all receiving Offices could eventually offer some form of the electronic filing to applicants, with one of the options being ePCT. This could be done for those Offices with a traditional hosted e-filing service, without any change at the receiving Office. Alternatively, the International Bureau could offer a service hosted at the International Bureau. In terms of receiving Office processing, ePCT provided secure login services allowing receipt of electronic filings from hosted services, scanning of paper for electronic transmission to the International Bureau, receipt of post-filing documents uploaded by the applicant, and the creation of some forms. It was also possible to transmit the record copy and other documents to the International Bureau, receive documents from the International Bureau and exchange documents with other participating Offices, eliminating postal delays, and the system was ready for eSearchCopy (see document PCT/WG/7/8). For the applicant communicating to Offices, an applicant was able to upload almost any type of document to be sent to the International Bureau, the only exception being priority documents, where the original was required. The system would also offer the opportunity to send documents to the receiving Office and the International Searching Authority if these were accepted. In terms of communication of those documents, there were two possibilities: through the ePCT web browser interface or via the PCT Electronic Data Interchange (PCT-EDI) system

21. The Secretariat concluded by summarizing that ePCT could offer efficiency benefits for Offices, better service to applicant and third parties, and improved quality of communications. In particular, it could reduce postal delays in transmitting paper documents which currently caused difficulties in meeting time limits and delays in issuing reports. Moreover, errors due to incomplete or incorrectly transcribed information could also be eliminated. But in order to work effectively, all Offices needed to be compatible with the ePCT system. This did not necessarily require using ePCT, but making sure that an Office's own electronic services were able to receive and provide information needed by other Offices using the system.

22. The Delegation of Australia indicated that IP Australia was one of the largest users of ePCT and saw considerable value in the development of the system. Since April 14, 2014, the receiving Office of IP Australia had received approximately 65 ePCT filings and had witnessed a noticeable decline in paper filings. Feedback from its customers had been very positive, with four major firms of patent attorneys in Australia making the transition to ePCT since its release. The Delegation expressed interest for Offices and applicants in being able to pay upfront fees

through ePCT. In this regard, the Delegation noted that real-time credit card payments of fees to the International Bureau as a receiving Office was planned for September/October 2014, and hoped this to be extended to other receiving Offices in 2015.

23. The Delegation of China appreciated the steps taken by the International Bureau to improve the ePCT system. However, the Delegation highlighted the need for a safe, smooth and stable interface between ePCT and the systems of national Offices so that any required national security review could be performed for ePCT filings. In addition, the system did not support Chinese and the absence of a PDF editor resulted in difficulties displaying information in different PDF files. The Delegation also wished to receive update information from the International Bureau in a timely manner.

24. The Delegation of the United States of America thanked the International Bureau for its continued efforts in the development of the ePCT system, especially as it related to the development of the Global Dossier. The Delegation welcomed the expansion of the system to provide for the electronic filing of international applications, as well as the indication that real-time credit card transactions would also soon be available for the payment of fees due at the receiving Office of the International Bureau, which would both provide significant benefits for applicants. Regarding the decommissioning of PCT-EASY, the Delegation trusted that the International Bureau would ensure that the current ability of applicants to create the PCT request and other files for uploading to the e-filing systems of the individual receiving Offices would continue to be available to applicants through PCT-SAFE, and ultimately through the ePCT system. As for future development of the system, contribution should be made to providing the receiving Office and the International Searching and Preliminary Examining Authorities with the ability to upload a sequence listing text file to the International Bureau. The Delegation added that the proposed implementation to allow an applicant to draft an international application and file to receiving Offices using existing e-filing servers maintained directly by the receiving Office or to a server hosted for the receiving Office by the International Bureau would present both technical and legal challenges for the United States Patent and Trademark Office (USPTO). The Delegation nevertheless recognized the benefits to applicants and Offices of ePCT for improving the quality and the efficiency of processing international applications and remained interested in exploring and integrating ePCT functionality within the e-filing system at the USPTO.

25. The Delegation of Israel welcomed the development of ePCT and thanked the International Bureau for its continued efforts to improve the system, which provided an efficient and effective service for Offices using the WIPO interface. The ePCT system was to an extent an alternative option for Offices which were not able to develop and support their own automation system for e-filing and international processing of PCT applications. The Israel Patent Office had already started to use the ePCT system regularly for its work as a receiving Office for viewing and downloading documents and as an International Searching Authority (ISA), especially when priority documents were not usually available and the search examiner needed to check the validity of a priority claim. The Delegation supported the ability to offer a service with the agreement of the International Bureau and receiving Office, where it would be possible for the International Bureau to transmit the search copy and other documents necessary for international search to the ISA in electronic form using the ePCT system. At present, most searches were sent in paper form, except in the cases where the receiving Office was the same Office as International Searching Authority. As about 95 per cent of international applications filed in Israel were in electronic form, the Israel Patent Office in its capacity as receiving Office would be glad to use the ePCT service for the transmission of search copies to the European Patent Office and the United States Patent and Trademark Office as International Searching Authorities. Finally, the Delegation supported a move towards full text documents and structured (XML) data as an alternative to PDF. The Israel Patent Office was looking into producing international search and preliminary examination reports in XML formats and recommended that the International Bureau could also investigate transmitting demands to the International Preliminary Examining Authority in XML format.

26. The Delegation of Portugal informed the Working Group that the Portuguese Institute of Industrial Property was currently implementing the ePCT system in its Office. As a paperless Office, 95 per cent of national filings were filed electronically, but for PCT applications, 50 per cent were filed using PCT SAFE and the remaining 50 per cent on paper. The Delegation underlined the need for a user-friendly fully electronic filing option, but it had concerns regarding the national security requirements for its national applicants or those based in Portugal, which needed to be taken into consideration in the development of ePCT.

27. The Delegation of India appreciated the efforts of the International Bureau in the development of ePCT and the collaboration with the Indian Patent Office in this regard. Nevertheless, there were some issues that needed to be taken into account, namely, how the transmittal of the priority document and the payment of fee should be worked out between the receiving Office and International Bureau when the applicant was claiming priority from a national application, and also how national security requirements could be integrated into the ePCT system, given that an applicant from India had to wait six weeks between filing a national and a PCT application, or obtain prior permission from the Indian Patent Office before filing abroad.

28. The Delegation of the European Patent Office stated that the online services made available to the public through ePCT greatly facilitated the lives of PCT users and provided greater efficiency in their PCT systems. The Delegation hoped that International Authorities would be able to benefit from new electronic exchanges to improve their processing of files within the applicable deadlines under the PCT, as was the case in the eSearchCopy project.

29. The Chair summarized that delegations were very positive about the development of PCT online services. Several delegations had highlighted technical issues that needed to be addressed, such as the lack of support for languages other than English, a lack of an integrated PDF editor and difficulties in certain situations with correctly rendering PDF documents etc. Other delegations had referred to legal issues, including security questions, such as whether an applicant could file an application to a server not directly hosted by the relevant national Office, appropriate procedures for payment of fees and dispersion of fees to relevant Offices. All delegations which took the floor were fully supportive of reducing paper and its transmission, and avoiding the need to make manual entries which could give rise to errors. Most delegations were therefore positive that an electronic system such as ePCT would speed up processing, resulting in an increase in timeliness of deliverance of search copies to the ISA, and communication with the IB and the applicant. However, there were many details that needed to be worked out and not every detail was the same in every Contracting State.

30. The Representative of the American Intellectual Property Law Association (AIPLA) complimented the International Bureau on the ePCT system. The system had enabled reliable access to published applications for users in both developed and developing countries and had reduced errors in applications. This had facilitated applications by inventors from developing countries with less experience with the PCT system, who could now file an application with the International Bureau using ePCT. The system thus ensured worldwide equal access for all applicants regardless of circumstances. AIPLA looked forward to further improvements in ePCT and more countries in their national stages offering the opportunity of electronic filing.

31. The Working Group noted the contents of document PCT/WG/7/2.

#### **MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT ON THE TWENTY-FIRST SESSION**

32. The Secretariat introduced document PCT/WG/7/3, which reported on the twenty-first session of the Meeting of International Authorities (MIA) under the PCT, by drawing the attention of the Working Group to two issues, namely, the quality of international work products and training of examiners of Offices in developing and least developed countries.

33. With regard to quality, the Secretariat indicated that the focus of the Meeting of International Authorities and its Quality Subgroup continued to be on measures to improve the quality of international work products. On the formal side, the Meeting had approved the convening of a further meeting of the Quality Subgroup in 2015 and had agreed that annual reports on the quality management systems of International Authorities should be made available on the WIPO web site, as in previous years. Moreover, the International Bureau should submit a report on the ongoing quality-related work by International Authorities to the upcoming session of the Assembly. With regard to substance, work had continued among the International Authorities on a number of issues relating to quality, in particular, better understanding of work done by other Offices. Here, the Quality Subgroup had continued its work and discussions on the sharing of search strategies used to produce international search reports, the use of standardized clauses in those search reports to harmonize format and content of these search reports. The Subgroup had further discussed specific quality improvement measures, such as establishing mechanisms for feedback by national Offices on the search and the examination reports established by International Authorities and their processing in national phase procedures. It had further discussed the use of check lists in quality assurance processes and initiated discussion on improved guidance for examiners in the complex cases of unity of invention. Discussions had further continued on the issue of quality metrics. There the Meeting had agreed to continue to produce yearly reports on characteristics of search reports, which gave details of convergences or divergences in various metrics, such as the number of X or Y category citations in search reports, the average number of prior art documents cited, and the average of number non-patent or patent literature citations. It was, however, important to note that the aim of this report was not to measure quality on the basis of these characteristics, but to see what could be learned from those characteristics in the search reports issued by International Authorities in order to assist the direction of the work underway to improve quality and to focus on and identify further areas of work to improve the quality of these reports in their presentation and the accessibility of underlying information and data. Finally, as regards the issue of quality, the Meeting had discussed further work on establishing a PCT metrics framework which would aim at developing metrics covering a wide range of aspects of the entire PCT procedure, not only within International Authorities but also in receiving Offices, the International Bureau and designated and elected Offices, thereby covering the interactions between all of these Offices in their various capacities under the PCT. Work continued in this area between International Authorities, with the aim of developing a proposal which would eventually be presented the Working Group for discussion and approval by the entire membership of the PCT.

34. With regard to training of examiners in developing and least developed countries, the Secretariat reminded the Working Group that Member States had endorsed a proposal in 2010 to discuss how technical training could be improved and the role that the International Bureau should play in this context to facilitate cooperation in the area of examiner training and the sharing of tools and training materials (see paragraph 181 of document PCT/WG/3/2). Since the endorsement of that recommendation, as part of the PCT Roadmap, a wide range of Offices had continued to supply such training, in some cases in increased amounts and according to long term plans. However, a large portion of training remained *ad hoc*, delivered on demand with little coordination between Offices offering the training. Some discussion of this subject had taken place at the Meeting of International Authorities. It had been agreed that the International Bureau should prepare a proposal to bring about better coordination of examiner training between national Offices, taking into account questions of effective long term planning, sharing of experience and delivering effective training and, in particular, matching needs for examiner training with Offices that are able to supply the relevant assistance, capacity-building and expertise. It was hoped that the Meeting of International Authorities would continue discussions on this issue next year, and eventually the issue would be brought to the broader membership of the PCT for further discussion in the Working Group.

35. The Working Group noted the report of the twenty-first session of the Meeting of International Authorities, based on the Summary by the Chair of that session contained in document PCT/MIA/21/22 and reproduced in the Annex to document PCT/WG/7/3.

## **FEE REDUCTIONS FOR SMALL AND MEDIUM-SIZED ENTERPRISES (SMES), UNIVERSITIES AND NOT-FOR-PROFIT RESEARCH INSTITUTES**

### **ESTIMATING A PCT FEE ELASTICITY**

36. Discussions were based on documents PCT/WG/7/6 and PCT/WG/7/7.

37. The Secretariat recalled that one of the PCT Roadmap recommendations endorsed in 2010 had related to the review of the level of fees for different types of applicants, where it had been agreed that the Member States and the International Bureau should seek innovative solutions to the problem of ensuring that applicants are not excluded from the use of the system by the level of the fees. At its fifth session in 2012, the Working Group, while noting both the complexity of the issue generally and, in particular, the challenge of finding a financially sustainable way forward to make the PCT system more accessible, had requested the International Bureau to prepare a paper on the issue, which was presented to the sixth session in 2013. This paper had raised a number of issues which, in the view of the International Bureau, required further discussion and eventually agreement by Member States prior to developing a detailed proposal. Those issues included the rationale and effectiveness of fee reductions for SMEs, universities and not-for-profit research institutes, the potential impact of such fee reductions on PCT income and thus income and budget of WIPO as a whole, possible ways to introduce such fee reductions in a financially sustainable income-neutral way, eligibility criteria for such fee reductions, and implementation issues that would need to be addressed. At the sixth session of the Working Group, there had been a useful initial round of discussions, and the Working Group had agreed to continue discussions on these issues at the present seventh session, based on a study by the Chief Economist on the issue of PCT fee elasticity. It had also been agreed that further information from Member States would be collected by the International Bureau on applicable national criteria for fee reductions for SMEs, universities and research institutes, national experiences gained with such fee reductions, and any measurable impact such fee reductions might have had on filing behavior according to the national experience. Furthermore, information had been requested to be gathered by the International Bureau on the various existing definitions of what constituted an SME under applicable international laws and practices, in particular, with regard to fee reductions for national or regional patent applications. The Secretariat indicated that document PCT/WG/7/7 contained this information based the responses to a Circular sent to Member States and various groups representing users of the PCT system. From the responses received and set out in the document, there were various different criteria applied in national and regional laws on the issues such as eligibility criteria, scope of fee reductions applied, the numbers of applicants benefiting from such reductions and any experience and data on the impact fee reductions may have had on filing behavior by applicants. The document further set out a discussion of the definitions of small and medium-sized enterprises under applicable national laws and practices used in the context of fee reductions, which showed divergences among Member States.

38. The Chief Economist of WIPO introduced document PCT/WG/7/6, containing a study on estimating PCT fee elasticity requested by the Working Group at the previous session. In economic terms, elasticity was the term used for describing how sensitive one variable was to a change in another variable. In the context of the patent system, there had been a number of studies that, in the national or regional context, had tried to estimate how sensitive patent applicants were to changes in the patent application fee or to changes in legal costs at large, but for the PCT system, no such estimate existed. The study attempted to exploit the variation in the international filing fee to estimate the demand elasticity. Although this fee had only changed once, having been reduced from 1,440 Swiss francs to 1,330 Swiss francs, exchange rate fluctuations resulted in variation in the international filing fee for the applicant. For freely convertible, currencies like the Euro, the Japanese Yen and the US dollar, a new fee was set in

these currencies at the beginning of the year based on the exchange rate in place in October of the previous year, and the equivalent amount could be adjusted in the event of major currency changes. For non-freely convertible currencies, the fees in the local currency payable by applicants may vary on a daily basis. Taking an index of 100 for the international filing fee in 2004, these currency exchange rate variations were significant, particular for the pound sterling, United States dollar and Korean won. The study looked at more than one million patent families filed since 2004 by looking into the inclination of the applicant to use the PCT system or the Paris route when filing for patent protection in a foreign jurisdiction. This involved a large number of variables. The primary variable of interest was the international filing fee in the local currency divided by the consumer price indices, but the study also accounted for inflation as the real value of the fee, the unemployment rate as a measure of business cycle, whether the origin of the applicant was a PCT member State, the size of patent family, the type of patent applicant, that is, a university or research institution, individual or private company, and the field of technology of the patent application. There was also a variable as the moving average of the PCT market share to account for autonomous changes in the inclination of applicants to use the PCT system.

39. Moving to the results of the study, the Chief Economist continued by stating that the higher the fee, the less likely an applicant would choose the PCT for foreign filings in the patent family. If the international filing fee were to increase by 10 per cent, the overall filing volume would decrease by 0.278 per cent, representing a highly inelastic fee elasticity. Applicants were less likely to choose the PCT when the unemployment rate rose; applicants from universities were 25 per cent and public research organizations were 10 per cent more likely to use the PCT system than other types of applicants, but their filing behavior was also more sensitive to fee changes. The study also showed that a patent family with filings in only two Offices was 20 per cent less likely to opt for the PCT system, whereas a patent family with six or more Offices was 16 per cent more likely to use the PCT system. In conclusion, the international filing fee was statistically significant for applicants when deciding how to file for patent protection internationally, but the filing demand was found to be highly inelastic. There was, however, a major caveat to the study being that it was assumed that the international filing fee affected the choice between the PCT and Paris route, but did not have any impact on an applicant's decision whether to seek patent protection beyond the domestic jurisdiction. It might well be possible that there were applications in only one Office where the applicant might have decided to use the PCT system if the filing fee had been lower. This would be an interesting issue to explore, but would extend the sample size to 7 million patent families, which would be difficult to handle by statistical programs.

40. The Delegation of Japan, speaking on behalf of Group B, stated that fee reduction needed to be considered in a pragmatic manner. Group B recognized the importance to make the PCT system more accessible to SMEs, given these companies had a significant potential market for the PCT system and were important players for innovation. The paper compiling the information on fee reductions was not only useful for further examination of the possibilities of fee reduction for the PCT system, but also for the consideration of domestic policy on patent fee reductions. Group B underlined that financial assistance and income neutrality were a prerequisite for the introduction of a new fee reduction framework. In this regard, prior assessment of the financial impact to WIPO income would be essential preparatory work to decide the actual criteria. However, the results in the study seemed to show the difficulties even to find a specific criteria model to be used for such preparatory exercises. Taking account of this fact, the Delegation considered that the definition of the beneficiaries of a potential fee reduction was difficult to determine at this stage. With regard to universities and not-for-profit research institutes, it was useful to know that universities and public research organizations were more price-sensitive. In this context, it had to be borne in mind that any fee reductions should be paid for through efficiencies through the PCT system and not lead to higher fees elsewhere. Group B remained committed to be engaged in the exercise to make the PCT system more attractive and accessible while preserving the income neutrality of fees and the financial sustainability of the organization.

41. The Delegation of China believed that fee reductions could promote more effective use by SMEs and not-for-profit research institutes. Given the lack of consensus on the definition of SMEs and the level of fee reductions, the Delegation suggested that the International Bureau could undertake further research on this topic, as well as on PCT fee elasticity when determining on whether or not make foreign filings, as indicated by the Chief Economist.

42. The Delegation of India informed the Working Group that it had introduced a 50 per cent fee reduction for small scale industries and SMEs in 2014. The criteria introduced were based on the investment in the plant and facilities and also to the entities which were entrepreneurs engaged in the manufacturing and other kinds of activities. The Delegation requested the International Bureau to compile further information on the various criteria used by different countries for SMEs and universities.

43. The Delegation of Kenya noted the sizable fee changes due to local currency fluctuations and commented that the exchange rate of the Kenyan shilling to the Swiss franc between 2004 and the present day had moved from about 45 Kenyan shillings to the Swiss franc to about 100 to 120 Kenyan shillings to the Swiss franc. For a Kenyan applicant, the international filing fee had more than doubled. The Delegation stated that the study could have focused on the effect of currency fluctuations in terms of their effect in developing and least developed countries, where fluctuations had been very significant.

44. The Chief Economist, responding to the intervention made by the Delegation of Kenya, acknowledged the huge depreciation of currencies in certain developing countries since 2004 and noted that this had been due in certain cases to high inflation. Inflation had been accounted for by dividing the local currency equivalent of the international filing fee by the consumer price index to account for the fact that the general value of the currency might have changed over time due to inflation. Exchange rate fluctuations had also been pronounced in some developed countries, for example, the United States dollar saw a depreciation of more than 50 per cent within two years over the course of the financial crisis, making the international filing fee 50 per cent high for applicants from the United States of America. One area that could be investigated was whether the fee elasticity varied between low and middle income countries compared to high income countries.

45. The Delegation of the United States of America supported the statement made by the Delegation of Japan on behalf of Group B. The Delegation noted with interest that public research organizations, especially universities, were more likely to choose the PCT filing route and that the fee responsiveness was highly inelastic. Given that universities counted for less than 6 per cent of the total PCT filings, the Delegation felt that it would be beneficial to increase the number of filings by universities by reducing the international filing fee for university applicants in all Member States, since they often conducted leading edge research and contributed to the formation of new businesses. As for document PCT/WG/7/7, the Delegation supported fee reductions for small and micro entities across all Member States to promote the growth of small businesses and build support for patenting systems worldwide. Such fee reductions should, however, be balanced by seeking greater efficiencies in the PCT system. Additionally, in view of the generally-accepted difficulties in reaching an agreed-upon definition of what constituted a small or micro entity for the purposes of the international filing fee, the Delegation encouraged individual Offices in their capacity as a receiving Office, International Searching Authority or International Preliminary Examining Authority to establish these discounts for fees payable to their Offices, since establishing criteria for a small or micro entity at a national level would be significantly easier to develop and apply.

46. The Delegation of the Republic of Korea supported discussions on fee reductions for small and medium-sized enterprises, universities and not-for-profit research institutes as offering potential benefit to users of the PCT.

47. The Delegation of the Russian Federation stated that the PCT procedure could be compared to goods in the market with a price where demand could be affected by factors such as unemployment rates and currency fluctuations. As to document PWG/7/7, the document was instructive and the Delegation suggested that this valuable information could be integrated into guidelines, such as the PCT Applicant's Guide, for the use of applicants when deciding on seeking protection in foreign jurisdictions.

48. The Delegation of Spain agreed with the internal policy of reducing fees and supported reductions for small and medium-sized enterprises, universities and research institutes, many of which were aggravated by the financial crisis. This would benefit both industry and the patent system.

49. The Chair summarized the interventions by stating that most delegations welcomed efforts to make the PCT system more accessible to certain types of applicants, such as small and medium sized enterprises, universities and research institutes, but recognized that, as had been discussed at the previous session, many issues needed to be carefully considered and resolved before new fee reductions for such groups of applicants could be introduced. Notably, it was seen to be of particular importance to find possible ways to introduce such fee reductions in a financially sustainable, income neutral way for the Organization. In this context, several delegations had expressed the view that any new PCT fee reductions for certain types of applicants should be paid for by seeking further efficiencies in the PCT system and should not lead to higher fees for other types of applicants. Several delegations had felt that more information was needed to be able to develop a common definition of what constituted a small and medium-sized enterprise for the purposes of PCT fee reductions, and the Chair acknowledged the suggestion from the Delegation of the Russian Federation that the information contained in the Annex to document PCT/WG/7/7 should be further enriched and completed to eventually form the basis for detailed information and guidelines for applicants, perhaps to be included in the PCT Applicant's Guide, on the various requirements and criteria for fee reductions applicable under national laws and practices. However, the aim of discussions should be to arrive at an agreed and uniform approach to reduce costs in the PCT, and it was not clear whether further information would move discussions forward on this matter. In this respect, the Chair asked the Working Group whether there was a desire to investigate fee discounts for universities, and if so, whether there would be need to base it on a level of revenue, given the vastly different endowment levels between universities.

50. The Representative of the Asociación de Agentes Españoles Autorizados ante Organizaciones Internacionales de la Propiedad Industrial (AGESORPI) commented that one problem when modeling such behaviors was that it was assumed that the filing behavior would be smooth around the point being modeled. The Representative suspected that the model could reflect the behavior of a large company making a sizeable number of filings, where deviations in filing numbers would be smooth, say, could be of the order of 10 per cent. By contrast, small and medium-sized enterprises only filed a few applications each year, and so the behavior would not be smooth. For example, if the company filed three applications and the fees rose by 10 per cent, the company would still file these applications because they would all be important, and would not file any more applications if the fee dropped by 10 per cent as it would have no further inventions to patent. The problem was therefore how to model much greater fee changes, for example, a 50 per cent increase or reduction.

51. The Representative of the American Intellectual Property Law Association (AIPLA) stated that AIPLA traditionally supported fee reductions for small and medium-sized enterprises. AIPLA generally advocated fee reductions for universities to be applied on a non-discriminatory basis, and a starting point could be to introduce fee reductions for universities only for a trial period of about three years. However, the Representative questioned whether fee reductions could be met by further efficiencies within the PCT.

52. The Representative of the Asian Patent Attorneys Association (APAA) supported fee reductions for universities, but raised the question of whether the proposal for fee reductions for universities would also extend to public research organizations. In this regard, the Representative gave the example that in Australia and the Pacific region, research was often performed in collaboration between universities and public research organizations.
53. The Chair clarified the question raised by the Representative of the Asian Patent Attorneys Association (APAA) by indicating that the proposal concerned universities only. Public research organizations were more difficult to define, and in some cases received significant support from private donors.
54. The Representative of the American Intellectual Property Law Association (AIPLA) requested information from the Chief Economist as to what magnitude of fee reduction would be needed to see statistically significant changes in filing behavior for universities.
55. The Chief Economist, responding to the question raised by the Representative of the American Intellectual Property Law Association (AIPLA), stated that this would depend on the aims of a fee discount. One purpose was that the applicant would pay less for a patent and therefore save money. But the ultimate perspective was that the money saved could be used for other purposes, like further research. Another purpose of the fee discount would presumably be to increase the number of PCT applications which could help commercialize ideas and enable markets for technology. PCT fee elasticity did, however, remain highly elastic with an elasticity of -0.033. In other words, a reduction of 50 per cent in the international filing fee would lead to an increase in university filings of 1.5 per cent. Furthermore, the share of non-resident filings using the PCT system compared to the Paris-route from university applicants was significantly higher than overall share of about 55 per cent use of the PCT.
56. The Delegation of Kenya highlighted the need to consider other factors beyond patent fee reductions, such as funding of research, which varied widely between developed and developing countries. For a university with nothing to patent, fee reductions would have no effect, and what was needed was help in terms of economic development.
57. The Representative of the American Intellectual Property Law Association (AIPLA) pointed out that small and medium-sized enterprises and universities in least developed countries could benefit from the 90 per cent reduction in the international filing fee available to all applicants from these countries.
58. The Chair acknowledged that there was no clear way forward on the issue of fee reductions for small and medium-sized enterprises, universities and not-for-profit institutes. One proposal had been made to apply a fee discount for universities, but this could mainly benefit well-endowed universities in developed countries. Yet it could be useful to provide some fee reduction for universities in developing and least developed countries to provide some incentive to use the PCT system and commercialize new technology. However, the latter group of universities represented only a small proportion of university filings in the PCT, which put into question a discount for all universities. The Chair therefore proposed that work on this issue should be left until a Member State made a concrete proposal.
59. The Representative of the Federation of Industrial Property Attorneys (FICPI) suggested that Member States should work towards harmonizing the way in which Member States, under their national laws and practices, calculated existing fee reductions for small and medium-sized enterprises, universities and research institutes, noting that the current divergent requirements and practices made it very difficult for applicants to take advantage of the existing fee reductions, up to a point where applicants were advised against taking advantage of such fee reductions in view of the high risks an application could potentially face if such fee reductions had been granted based on wrong or insufficient information furnished by the applicant.

60. The Delegation of Spain informed the Working Group that the Spanish Patent and Trademark Office studied three different scenarios when introducing a fee reduction program for SMEs, universities and research institutes, namely, reductions of 25, 50 and 75 per cent, analyzing the impact of these discounts. The Delegation suggested that impact on revenue to WIPO could be investigated based on these three scenarios.

61. The Chief Economist, in response to the suggestion made by the Delegation of Spain, pointed out that data for universities and public research organizations could be captured, but that was a problem for doing the same for small and medium-sized enterprises.

62. The Chair proposed that the Secretariat could work with the Chief Economist to prepare a small subsidiary study to document PCT/WG/7/6 that would examine the extent to which WIPO's fee revenue would be affected if different levels of fee reductions were offered to universities.

63. The Delegation of Kenya suggested that this proposal could map out the effects between universities in developed and developed countries.

64. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) suggested that, when investigating the effect of fee reductions, the study should look at how many universities would enter the system due to the fee reduction, which was more important than the question of whether universities currently filing PCT applications would continue to do so.

65. The Chief Economist, in response to the suggestion from the Representative of the Institute of Professional Representatives before the European Patent Office (EPI), stated that there were two questions here, the extent to which the international filing fee would have an impact on a decision whether or not to patent an invention internationally in the PCT, and the extent to which the international filing fee would have an impact on applicants already filing internationally to choose the PCT in preference to the Paris-route. With respect to the latter, it could be possible to use existing data to see whether there were universities filing internationally but not using the PCT. But there would be technical limitations that would need to be overcome to investigate universities that only filed domestic applications and study what difference the international filing fee would make to these universities deciding to patent internationally. Attempts could be made to explore how these technical limitations could be overcome, but tackling this question would depend on data availability.

66. The Working Group noted the contents of documents PCT/WG/7/6 and 7.

67. With regard to possible new fee reductions for small and medium-sized enterprises and research institutes, the Working Group agreed that there was no clear way forward. No further work on this issue would thus take place until a Member State would make a concrete proposal.

68. On the issue of possible fee reductions for universities, the Working Group concluded that there was sufficient interest in further exploring possible PCT fee reductions. The Working Group thus requested the Secretariat to work with the Chief Economist to provide a supplementary study on possible fee reductions for this group of applicants only, for discussion at the next session of the Working Group. That supplementary study should cover issues such as the likely impact of any such fee reduction on PCT fee income, including scenarios under which different levels of fee reductions were offered to universities from developing, least developed and developed countries; and estimates as to whether the filing behavior of universities in developing and least developed countries would show a different fee elasticity compared to that from universities in developed countries.

## **FEE REDUCTION FOR CERTAIN APPLICANTS FROM CERTAIN COUNTRIES, NOTABLY DEVELOPING AND LEAST DEVELOPED COUNTRIES**

69. Discussions were based on document PCT/WG/7/26.

70. The Secretariat introduced the document by explaining that the issue of fee reductions for certain applicants from certain countries, in particular developing and least developed countries, had been under discussion since 2008, when the International Bureau had initially been asked to look into the development of a possible new set of criteria for determining who should be eligible for fee reductions. Following that request, the International Bureau had submitted to the third session of the Working Group in 2010 a concrete set of proposals as to possible new criteria for determining eligibility for fee reductions based on the combination of income and innovation based factors. More specifically, the Secretariat had proposed that an international application should benefit from the 90 per cent fee reduction if it was filed by an applicant who was a natural person who was a national of or residing in a State that had a ten-year average GDP below 25,000 United States dollars and fulfilled one of the following criteria, either being a national resident of a country which had filed less than ten international applications per year, per million population, or less than 50 international applications in absolute numbers. In addition, the proposal had also suggested to continue to provide fee reductions for all applicants, whether natural persons or not, from countries who were classified by the United Nations as belonging to the group of least developed countries. These proposals had met with a number of concerns in the Working Group and there had been no agreement at the third session on how to take the proposal forward. Concerns raised during the discussions at that session had included, in particular, the need to reflect better development in innovation aspects in any new set of criteria and, in that context, one proposal had been made to use an innovation-based criteria as the sole indicator for eligibility, irrespective of the economic and development status of the country concerned. Another proposal made in that context had been to offer PCT fee reductions for all developing countries; it had to be noted, however, that there was no agreed upon definition as to which countries should be included in that group of developing countries. Further concerns had been expressed with regard to the indicators proposed to be used for the innovation-based criteria, namely, the number of PCT applications filed by natural persons, the rationale for proposed thresholds for both the income and the innovation based criteria, the process for any future review of the criteria, and in general, it had been felt there was an imbalance between developing and least developed countries benefiting from the fee reductions under the proposed set of criteria.

71. The Secretariat explained that discussions on fee reductions for applicants for developing and least developed countries had resumed at the sixth session of the Working Group last year, based on a document which sought to address concerns raised at previous meetings. At that session, no clear way forward had emerged, but the Working Group had agreed to continue its discussions at this present seventh session of the Working Group and that the Secretariat would seek to update the working document to assist those discussions. The document therefore updated that presented to the previous session of the Working Group, and included information from responses to a Circular sent to Member States and user groups, inviting further comments and suggestions on this issue. Unfortunately, only three responses had been received, in contrast to more than 35 responses to the questions on fee reductions for small and medium-sized enterprises, universities and not-for-profit research institutes. In addition to the comments, the document further updated the statistical information in the country profiles in Annex I, but this did not change the list of beneficiary countries under the criteria suggested by the Secretariat. Annex II updated the statistical information on the number of applications in different countries that had benefited from the existing fee reductions under the existing criteria from 2000 to 2013.

72. The Delegation of Japan, speaking on behalf of Group B, believed that it was urgently necessary to introduce a fee reduction framework that reflected the development of the world economy in a dynamic manner. In this regard, the two criteria in the document, namely gross

domestic product (GDP) and numbers of PCT applications could duly take account of the essential aspects to justify receiving fee reductions. The thresholds for those criteria could therefore be a good basis for a future dynamic and fair fee reduction framework.

73. The Delegation of the United States of America expressed support for fee reductions for applicants of certain countries with the aim of encouraging filings in the PCT system. In the context of fee reductions for natural persons from developing and least developed countries, the Delegation supported an approach that excluded high income countries from qualifying for those discounted fees. The Delegation had some concern about the proposed increase of the threshold to qualify for PCT fee reductions to a per capita GDP maximum of 25,000 United States dollars according to the most recent ten-year average at constant 2005 United States dollar values, since this was twice the level for a high income country defined by the World Bank, currently 12,616 United States dollars per capita of gross national income. The Delegation supported the use of two-part test as proposed by the International Bureau, where both income-based criteria and innovation-based criteria were considered when determining the eligibility of a country for the reduction in fees, with such a country needing to meet both of those criteria. The Delegation also supported periodic reviews of the eligibility of the countries for the fee reduction, for example every five years. Furthermore, during these challenging economic times, any fee reduction should not result in increasing other PCT fees and should instead be balanced by increased efficiencies in the PCT system so as to remain budget neutral.

74. The Delegation of Kenya, speaking on behalf of the African Group, believed that GDP was the most efficient way of deciding the countries which should benefit from fee reductions. Only developing and least developed countries should be eligible for reductions in order to raise levels of innovation and PCT filings in these countries. If developed high income countries were included in the list of eligible countries for fee reductions, the purpose of the reductions would be lost. It was therefore necessary to look at this issue in a balanced manner, considering the purpose of the fee reduction and other factors, such as levels of innovation, to ensure that the policy helped countries not currently integrated in the world economy to do so.

75. The Delegation of the Republic of Korea supported the proposal of a combination of income and innovation-based criteria to be a reasonable solution. However, the Delegation did prefer a multi-level system, whereby a Member State fulfilling both criteria on income and filings would be eligible for a high percentage fee reduction, with those only fulfilling one of the criteria being able for a lower percentage fee reduction. In addition, the Delegation preferred the previous gross national income (GNI) figure rather than GDP figure proposed by the Secretariat, because the GNI included terms for trade with other countries and better reflected the purchasing parity of the consumer within each country. For this reason, the World Bank and the International Monetary Fund had been recommending using the GNI as income index ever since 1993.

76. The Delegation of the Russian Federation indicated that the relationship between the income-based criteria and innovation-based criteria was not clear at first glance, but it seemed that the income-based criteria should have priority in determining eligibility in fee reductions. As far as the innovation criteria were concerned, these should be of a subsidiary nature and it was necessary to think about the extent of their use.

77. The Secretariat, in response to comments made by delegations on the GDP threshold for the income-based indicator, explained that the initial proposal on fee reductions had suggested using the World Bank classification of high, low and medium income countries. A number of countries who would no longer benefit from fee reductions had expressed concerns with this idea and therefore proposed to raise the income level threshold. Although the figure of 25,000 United States dollars was an arbitrary threshold, reverting to the World Bank income categories would not be acceptable to a number of Member States.

78. The Chair summarized that there was some support from delegations on the proposal in the document, but there was no unanimity on the criteria that should be used to consider a country as a developing country for the purposes of fee reductions. However, the Chair believed that the criteria in place were out dated and would remain so until new criteria could be agreed. Meanwhile, this would not be helping developing and least developed countries for which the fee reductions were intended. While not ideal, the Chair therefore asked delegations to provide reasons why the proposal in the document would not be an acceptable way forward to improve the current situation.

79. The Delegation of Kenya considered that the challenge was that the Working Group was trying to create a definition of developing countries, whereas the United Nations had a clear way of dealing with developing countries as distinct from developed countries. Attempting to agree on new criteria therefore complicated matters.

80. The Chair acknowledged that there was a UN list of least developed countries, but there was no clear definition of a developing country. By proposing criteria for a country to be eligible for fee reductions, the document attempted to clarify this matter.

81. Following informal discussions led by the Chair, discussions continued on the basis of a revised proposal.

82. The Chair explained the revised proposal. Paragraph 5(a) of the proposed Schedule of Fees stated that an applicant would benefit from a 90 per cent fee reduction who was a natural person and who was a national of and resided in a State that was listed as being a State whose per capita gross domestic product was below 25,000 United States dollars, according to the most recent ten year average per capita gross domestic product figures at consistent 2005 United States dollar values published by the United Nations, and whose residents who were natural persons had filed less than ten international applications per year per million population, or 50 international applications per year in absolute numbers, according to the most recent five year average yearly filing figures published by the International Bureau. Paragraph 5(b) of the proposed Schedule of Fees stated that all applicants from least developed countries would benefit from the 90 per cent fee reduction. The proposed Directives explained that a review of the criteria would take place every five years. Of the 192 countries listed in document PCT/WG/7/26, the key effects of the proposal would be in twelve countries. Singapore and United Arab Emirates, who currently received reduction in fees, would no longer receive reductions in fees. And there would be 10 countries not currently receiving fee reductions which would be able to claim the 90 per cent fee reduction: Bahamas, Cyprus, Greece, Malta, Nauru, Palau, Portugal, Saudi Arabia, Slovenia and Suriname.

83. The Secretariat pointed out that the proposed Directives would require the list of countries eligible for fee reductions to be reviewed after five years. This would provide some stability for eligible countries. However, if a country not currently benefitting from fee reductions believed its GDP or other criteria had changed to become eligible for fee reductions, the country could write to the Director General at any time to request inclusion on the list of eligible countries.

84. The Delegation of Japan, speaking on behalf of Group B, supported the proposal but suggested that, in addition to reviewing the list of States meeting the fee-reduction criteria every five years, the criteria themselves should also be reviewed.

85. The Delegation of Kenya, speaking on behalf of the African Group, could not support the proposal as it believed that it did not capture the original aim of fee reductions. The Delegation recalled that the genesis of the current discussion had been a proposal by the United States of America and Japan (document PCT/A/36/11), who had proposed reductions in PCT fees as a way of reducing surpluses in revenue and encouraging greater use of the system, particularly by small and medium-sized enterprises. There had also been a counterproposal by Brazil (document PCT/A/36/12), which indicated that fee reductions should take into account the

increased workload and responsibilities which would arise from the formation of the Committee on Development and Intellectual Property to implement the Development Agenda recommendations, and also the need to bridge the gap between developed and developing countries in regard to international filings of PCT applications. Informal consultations had been held to discuss the two proposals and the acting Chair in his summary had indicated that “there had been agreement among delegations to request the International Bureau to carry out a study on criteria for determining the group of developing and least developed countries whose applicants should benefit from a reduction of PCT fees, and present that study to the next session of PCT Assembly in September-October 2008” (see paragraph 62 of document PCT/A/36/13). The question to ask therefore was whether the current proposal addressed this goal. The Delegation noted that the current proposal would include some developed countries while, at the same time, dropping two developing countries, which were currently benefiting from fee reduction. In particular, five countries from the European Union would be part of the beneficiaries. The current proposal therefore raised a number of challenges as to whether the original aim to increase the use of PCT by applicants from developing countries and least developed countries would be achieved. In addition, the European Patent Office did not offer such fee reductions to those countries. The aim of the fee reductions could not have been to replace some developing countries with developed countries. The Delegation therefore proposed that the Secretariat should look into mechanisms to overcome these shortcomings. For example, the criteria could be combined with other measures, such as the level of innovation as captured by the Global Innovation Index published by WIPO and other partners.

86. The Delegation of Spain supported the views expressed by the Delegation of Japan speaking on behalf of Group B, and stated that the proposal clarified the different eligibility criteria. The Delegation observed that PCT fee income outweighed expenditure, and suggested that the surplus could be used to reduce fees as whole and apply fee reductions to more countries to help promote the use of the PCT.

87. The Delegation of Portugal supported the views expressed by the Delegation of Japan speaking on behalf of Group B. The proposal would greatly benefit Portugal, which had been struggling from the economic crisis, with a direct impact on the number of PCT applications filed.

88. The Delegation of Greece commented on the point regarding differentiation of fee reductions raised by the Delegation of Kenya on behalf of the African Group. The Delegation considered that the proposal used two criteria which treated applicants equally in determining whether they met the criteria. The Delegation therefore did not support any differentiation based on whether the country was considered a developed or developing country, and added that certain developed countries had faced severe economic difficulties in recent years, affecting the level of innovation in these countries.

89. The Delegation of the Russian Federation asked for clarification of instances where a country had an income below the maximum to be eligible for fee reductions under the proposal, but exceeded the levels under the innovation criteria.

90. The Secretariat clarified that a country would need to comply with both criteria for its applicants to benefit. A low income country below 25,000 United States dollars but not complying with either innovation criteria would not be eligible for fee reductions. The logic behind this was that where there was high innovative activity expressed by the number of PCT filings, there would be no need to set further incentives. Similarly, applicants in countries with very high income levels but hardly any PCT filings would not benefit as it would not appear that financial reasons were the cause of the country making little use of the international patent system.

91. The Delegation of Kenya commented on the interventions made by the Delegations of Greece and Portugal. While the Delegation recognized that some of the developed countries which would benefit from the fee reductions might have suffered from an economic crisis, that crisis had to be considered to be of a temporary nature and did not change the fact that those countries nevertheless had a very high level of innovation and thus filings of patent applications compared to developing and least developed countries. The temporary nature of an economic downturn on reduced PCT filings could be illustrated by the numbers of filings from applicants from the United States of America, which now exceeded the level in 2007 prior to the global economic crisis. Yet for countries with a very low level of innovation, there needed to be systematic measures taken for them to be able to achieve higher innovation levels. It was thus necessary to consider a country in terms of capacity to innovate.

92. The Delegation of Spain reiterated its support for the proposal but suggested that, if it was not agreed, a system with graduated levels of reductions could be considered so that countries could more easily transition from being a country that benefitted from the fee reduction to a country that no longer benefitted from them.

93. The Delegation of Japan understood that the proposal was not perfect, but it struck a balance and was a step in the right direction. The Delegation believed that Member States should take this step, noting that it was possible to make further adjustments when undertaking the required periodic reviews of the criteria.

94. Following informal consultations led by the Chair, the Secretariat presented a revised proposal to the Working Group. Compared to the previous proposal, this added the requirement to undertake a periodical review of the eligibility criteria every five years. It was also clarified that, when a Member State wished to request inclusion in the list of eligible countries due to a change in its income or innovation levels, only the eligibility of the State making the request would be considered. A request by one State for inclusion on the list would therefore not result in the review of all countries considered eligible for reductions.

95. The Delegation of Kenya, speaking on behalf of the African Group, acknowledged that the criteria were not entirely satisfactory but that it was willing to accept the proposal if, in addition to the review of the eligibility criteria at least every five years, a progress report to assess the effect of fee reductions was made two years after the implementation of the new criteria. The Delegation highlighted the challenges facing developing countries with low innovation levels and considered it important for the Working Group to prioritize the implementation of the Treaty so that the Committee for Technical Assistance provided for by Article 51 could begin its work.

96. The Delegation of Brazil supported the views of the Delegation of Kenya on behalf of the African Group that the convening of the Committee for Technical Assistance should be prioritized to implement Article 51 of the Treaty.

97. The Delegation of the United States of America reiterated the view it had expressed in previous sessions of the Working Group that it could not agree to the convening of the Committee for Technical Assistance under Article 51.

98. The Working Group agreed on the proposed amendments to the Schedule of Fees set out in Annex I to the present Report<sup>2</sup> and on the proposed Directives for Updating the Lists of States Meeting the Criteria for Reduction of Certain PCT Fees set out in Annex II to the present Report with a view to their submission to the Assembly for consideration at its next session, in September 2014, subject to possible further drafting changes to be made by the Secretariat.

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<sup>2</sup> See also paragraphs 432 to 438, below, with regard to the proposal to delete item 4(a) from the Schedule of Fees, as agreed by the Working Group with a view to its submission to the Assembly for consideration at its next session in September 2014.

99. As to the entry into force of the amended Schedule of Fees, the Working Group agreed to recommend to the Assembly that the amendments of the Schedule of Fees set out in Annex I shall enter into force on July 1, 2015, and be subject to the usual provisions concerning the amount payable where the amount of a fee has changed (Rule 15.4 with regard to the international filing fee: payable is the amount applicable on the date of receipt of the international application by the receiving Office; Rule 45bis.2(c) with regard to the supplementary search handling fee: payable is the amount applicable on the date on which the supplementary search handling fee is paid; and Rule 57.3(d) with regard to the handling fee under Chapter II: payable is the amount applicable on the date on which the handling fee is paid). Consequently, the Working Group agreed to recommend to the Assembly that the reductions should apply as follows:

(a) In the case of reductions to the international filing fee, the new reductions should apply to any international application received by the receiving Office on or after July 1, 2015. The old reductions should continue to apply to any international application received before that date, irrespective of what international filing date might later be given to such application (Rule 15.4).

(b) In the case of reductions to the handling fee and the supplementary search handling fee, the new reductions should apply to any international application in respect of which the fee was paid on or after July 1, 2015, irrespective of when the request for supplementary international search or the demand for international preliminary examination, respectively, was submitted (Rules 45bis.2(c) and 57.3(d)).

100. The Working Group recommended that a progress report on the implementation should be made two years after implementation of the amendments.

#### **COORDINATION OF TECHNICAL ASSISTANCE UNDER THE PCT**

101. Discussions were based on document PCT/WG/7/14.

102. The Secretariat reminded the Working Group that the fifth session of the Working Group had agreed that reports on technical assistance should be included as regular item for future sessions of the Working Group. As with the report to the sixth session of the Working Group, the document had been split into two parts. The first part covered those activities which had a direct bearing on the use of the PCT by developing countries, and which were directly delivered to those countries under the PCT. The second part covered technical assistance activities extending beyond activities with a direct bearing on the use of PCT by developing countries, and which, since 1978, had been carried out under the supervision of other WIPO bodies. Information on the technical assistance activities which had a direct bearing on the use of the PCT by developing countries was set out in the Annexes to the document. These activities focused on assisting developing countries to make best use of the PCT system, taking into account specific country needs, notably the level of development of its national patent system, and the level of its participation in any regional and in the international patent system. Annex I contained a comprehensive list of all such technical assistance activities carried out in 2013; Annex II contained a list of all such activities which had either been carried out so far in 2014 or which were planned to be carried out in the remainder of 2014. The Secretariat drew attention to a non-paper with some minor corrections to Annex I. With regard to the technical assistance activities which extended to the use of the PCT by developing countries and carried out under the supervision of other WIPO bodies, the Secretariat drew the attention of the Working Group to paragraph 7, which set out examples of such activities and projects carried out under the supervision of, or being discussed and reported on, in several non-PCT bodies, notably the Committee for Development and Intellectual Property, the Committee on WIPO Standards and the WIPO General Assembly. More general information on technical assistance activities provided by WIPO for least developed countries, developing countries and countries in transition could be found on the WIPO Intellectual Property Technical Assistance Database (IP-TAD).

103. The Secretariat continued by updating the Working Group on the 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 at the thirteenth session of the Committee for Development and Intellectual Property (CDIP) by referring to the Summary by the Chair of that session. Unfortunately, with regard to discussions of the External Review, not much progress had been made in the CDIP, which could not reach an agreement and decided to consider the issue at its next session. In view of the decision by the Working Group at its fifth session to await the outcome of discussions in the CDIP before discussing the issue of how well the PCT had been functioning in terms of organizing technical assistance for developing countries, the Secretariat further proposed to continue to await the outcome of these discussions.

104. The Delegation of Japan, speaking on behalf of Group B, stated that it remained convinced from reading the document that PCT-related technical assistance programs formed part of the well-coordinated work of WIPO in improving the PCT. These programs formed an essential part of the core activities of WIPO to enhance the PCT system, thereby making it more attractive to users. Moreover, the Delegation underlined that WIPO should undertake technical assistance in a coordinated way in order to deliver it in an effective manner. PCT-related assistance should be dealt with in this context and not be separated out from WIPO’s broader technical assistance efforts. Group B therefore maintained its view that the Working Group should continue to await the outcome of discussions of the External Review in the CDIP before discussing the issue of how well the PCT had been functioning in terms of organizing technical assistance for developing countries.

105. The Delegation of Kenya, speaking on behalf of the African Group, acknowledged the lack of progress of the discussions of the External Review in the CDIP. The Delegation believed that the issue of how well the PCT had been functioning in terms of organizing technical assistance for developing countries should be brought to the Working Group. Otherwise, discussions on this matter would remain in abeyance for some time while, at the same time, the PCT system would be facing important challenges to make it more useful for its Member States. Postponing discussions on this matter could therefore undermine efforts to make the PCT system work better. The Working Group therefore needed to engage in discussions on how PCT technical assistance could be offered to Member States, where it was noted that short-term training courses on the PCT were not as useful as long-term training. In this regard, the Working Group could discuss how long-term training could be delivered to benefit patent Offices in developing countries to develop their capacity to undertake examination of patent applications.

106. The Delegation of China stated that the work of WIPO to provide technical assistance, promote access to the PCT system and share technological information in developing countries was very helpful. The Delegation indicated the willingness of the State Intellectual Property Office of the People’s Republic of China (SIPO) to participate in examiner training activities.

107. The Delegation of the United States of America commented that the list of technical assistance activities related to the PCT provided by WIPO in 2013 and planned for 2014 provided useful data for Member States. The list showed many examples of technical assistance activities for developing countries that had a direct bearing on the use of the PCT in developing countries, as well as PCT-related technical assistance activities that were carried out under the supervision of other WIPO bodies. An example in the latter category was the development of patent information tools and business solutions for IP Offices, which were designed and implemented to address the technical assistance needs of Member States, including those related to the PCT. The Delegation therefore agreed that the specific PCT-related technical assistance should not be addressed separately from the technical assistance provided by WIPO as a whole. In acknowledging the ongoing discussions in the CDIP of the External Review of WIPO Technical Assistance in the Area of Cooperation for Development, the Delegation agreed with the suggestion from the Secretariat that the Working Group should continue to wait until these discussions had been concluded before addressing

the question of possible further PCT-related technical assistance mechanisms that could be provided by WIPO. In this regard, the Delegation believed that, during the present challenging economic times, any WIPO programs that could be duplicative or overlapping with existing programs needed to receive additional scrutiny on their impact on the budget of the organization.

108. The Delegation of Japan believed that the International Bureau was engaged actively in providing technical assistance in relation to the PCT system in an effective and comprehensive manner, as shown in the document. The Delegation attached great importance to technical assistance and highlighted an example from Annex I of a regional seminar on effective utilization of the PCT and international work sharing initiatives, funded by WIPO Japan Funds-In-Trust. The Delegation believed that all participants at this seminar were able to deepen their understanding on the effective use of international search reports and international preliminary examination reports in the national phase and sharing of information on search reports and examining practices in the national phase. The Delegation intended to continue supporting these kinds of activities.

109. The Delegation of South Africa supported the statement made by the Delegation of Kenya on behalf of the African Group. The Delegation believed that technical assistance was very important to developing countries to allow them to effectively use the PCT system. The Delegation did not consider that there was a strong link between discussions in the Working Group and the CDIP as PCT-related technical assistance was narrow in focus, whereas the discussions in the CDIP were broader. Furthermore, the discussions in the CDIP during its past two sessions had appeared to reach a stalemate.

110. The Delegation of Australia delivered a presentation on the Regional Patent Examiner Training Program (RPET) provided by IP Australia<sup>3</sup>. IP Australia had 400 patent examiners conducting search and examination work and a number of people performing work as a receiving Office. In the past, IP Australia had received many requests to provide training on searching and examining patent applications as well as running a receiving Office, with requests outnumbering the staff available to deliver such training. It was also found that training delivered over one or two weeks, whether by travel to a recipient Office or receiving trainees at IP Australia, was quickly forgotten as it was not embedded into systems and processes at the recipient Office. There was also no development of competence and understanding in relation to PCT processes or undertaking the tasks for which the training was designed. IP Australia therefore developed the RPET competency-based training program, covering practical matters, such as the running of a receiving Office, searching and examining patent applications and providing written opinions on patentability. In addition, the program was to be delivered over a longer period, with better coordination and assessment, making use of modern telecommunication facilities, such as video conferencing, online learning environments and the Internet.

111. The Delegation provided further detail on the RPET program and stated that the program was a distance-learning capability focusing on PCT search and examination and developed using e-learning content and technologies. The program taught the PCT according to the Rules and Guidelines as applied by IP Australia with the intention of achieving a uniform system across the world on the way applications were searched and examined in the PCT. In interacting with participants, the program used a vast range of e-learning content and technologies to improve the competency of examiners. And in doing that, the program tried to encourage an alignment of international standards and the sharing of best practices. In this regard, the Delegation emphasized that the program did not aim to impose the practice of IP Australia on other Offices; interaction was a two-way process, with IP Australia engaging in

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<sup>3</sup> A copy of the presentation is available on the WIPO web site at:  
[http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=277377](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=277377)

dialogue with other Offices to find the best approach for everyone to improve and become more efficient. In some cases IP Australia had learnt from the recipient Offices and updated its training materials accordingly. The RPET program intended to provide a sustainable development process, avoiding single visits which were not followed up to verify whether the training had been taken on board. By providing an ongoing relationship with the people being trained, the Delegation believed the training would provide a greater degree of confidence in rights issued around the world because only by talking to one another could Offices learn from mistakes by other Offices and share new ideas. The program itself was launched in April 2013 with six participants from the Association of South-East Asian Nations (ASEAN) Offices (Malaysia, Indonesia and Philippines) and two participants from Offices in Africa (African Regional Intellectual Property Office (ARIPO) and Kenya). The second intake in 2014 would consist of 15 trainees with additional examiners from Thailand and Viet Nam. The program included some intensive training, but most of the training took place online, providing one-to-one real-time support through the e-learning environment. This meant there were limited windows during the day for conversation between participants, due to being in different time zones. Another issue with online training was language and time-lag when conversing using video-conferencing facilities. There was also a need to strike a balance between classroom training and on-the-job learning by trainees searching and examining applications and discussing their work with the trainers. A local supervisor had been appointed within each Office receiving the training, whose engagement and involvement in the program was crucial to success. Initially, there had been difficulties with supervisors not allocating enough time for trainees, who were expected to handle the training on top of their day-to-day work. In addition, local supervisors were not actively involved in dealing with issues like novelty, inventive step and unity of invention under the PCT and were more familiar with how these concepts existed in their local laws. IP Australia had therefore invited supervisors to its Office to explain the training program, which had resulted in improved engagement. The training program was not just about passing on knowledge, but it intended to transmit and develop competency. This meant the trainees doing real work overseen by the local supervisor, which was then passed to trainers for assessment and feedback, where both strengths and areas requiring improvement were highlighted. The training program had three phases: the first phase dealt with the key concepts of the PCT, the second phase covered advanced concepts and the third phase applied these to practice on the job. In term of feedback, the trainees had been very satisfied with the training. IP Australia had also found that the concept of competency based training based on providing information and applying it on the job was not widely understood, and that the program required a greater time commitment than originally anticipated for the trainees. Furthermore, the training program had highlighted differences between national practice and international standards, such as the treatment of dependent claims and unity of invention. IT security was another critical issue which presented challenges. Some countries had very slow Internet access and lacked secure networks. It was therefore difficult to set up a secure network amongst eight trainees and two trainers, but this was achieved successfully, including providing access to the network by trainees from outside their Office.

112. The Delegation of El Salvador expressed interest in the RPET program and enquired about accessibility to the program by its national Office, and what criteria were used to select participants.

113. The Delegation of Australia, in response to the questions raised by the Delegation of El Salvador, pointed out that the RPET program was funded by ASEAN and WIPO, and was therefore restricted to ASEAN countries and those countries that WIPO was willing to support. However, the biggest expense in the program was the time required from examiners at IP Australia in order to develop and provide the training and assess the trainees. As well as the source of funding for the program, there was also the question of the maximum possible number of participants in any given group. In this respect, it would be necessary to assess whether the increase to 15 participants for the second group beginning in 2014 would be successful in achieving the aims of the program. As for selecting participants, this had to be decided with the

recipient Offices, considering which individuals would benefit most from the program and had the capability to take what they had learnt and provide training to their own Office after they had achieved the competencies from the program.

114. The Delegation of Kenya commented that the RPET program was a good initiative to build the competency of individual examiners, adding that it was necessary for the competency of all Offices to be brought to the same level in order to cooperate successfully with one another. The Delegation believed that WIPO could move forward with activities to develop competencies through long-term training, which could be more beneficial than short-term courses.

115. The Chair summarized that delegations had expressed satisfaction with the information in the document on technical assistance provided by WIPO. Delegations were generally satisfied with the amount of technical assistance, but also acknowledged that more technical assistance could always be provided and this had its limitations in terms of budget and availability of resources. Some delegations, however, considered that discussions on the issue of coordination of technical assistance were not progressing in the CDIP as well as they should, and, in light of this situation, stated that the Working Group should begin discussions on how well the PCT had been functioning in terms of organizing technical assistance for developing countries. However, the Chair believed that the Working Group should stick to the decision taken at its fifth session to await the outcome of discussions in the CDIP on coordination of technical assistance in light of the broader picture of technical assistance considered by this body before the Working Group tackled the narrower issues of technical assistance related to the PCT. Meanwhile, technical assistance under the PCT would continue to be delivered, such as examiner training programs that had been discussed by the Working Group.

116. The Delegation of Kenya pointed out to the Working Group that the External Review of WIPO Technical Assistance in the Area of Cooperation for Development had been presented to the eighth session of the CDIP, and five further sessions of the CDIP had taken place without any decision. Moreover, over these five sessions, discussions had shifted to best practices in terms of the delivery of the technical assistance rather than the recommendations made by the External Review. It would therefore be unlikely that the more philosophical orientation of the CDIP discussions would produce tangible outcomes which could assist the Working Group in taking forward the coordination of technical assistance in the PCT, such as the training of patent examiners. If the issue of the functioning of the PCT in terms of organizing technical assistance was not separated from the discussions in the CDIP, improvements to technical assistance within the PCT would be postponed indefinitely. Instead, the Delegation wished to see more cooperation and capacity building to facilitate the sharing of information and better understanding between Offices.

117. In relation to the issue of training of patent examiners, the Secretariat reminded the Working Group that, as had been reported in the Summary by the Chair of the twenty-first Meeting of International Authorities (see paragraphs 55 to 59 of the Summary by the Chair, reproduced in the Annex to document PCT/WG/7/3), the Meeting of International Authorities had recommended that the International Bureau should prepare proposals for better coordination of examiner training between national Offices, taking into account questions of effective long term planning, sharing of experiences in delivering effective training, and matching needs for examiner training with Offices able to supply the relevant needs. The International Bureau intended to present such proposals to next year's sessions of the Meeting of International Authorities and subsequently to the next session of the Working Group. Thus, work on specific technical assistance related issues, such as, in this case, training for examiners from developing and least developed countries, would continue to be carried forward, independently of and in addition to the ongoing discussions in the CDIP on the issue of the External Review.

118. The Working Group noted the contents of document PCT/WG/7/14.

## **APPOINTMENT OF INTERNATIONAL AUTHORITIES**

119. Discussions were based on document PCT/WG/7/4.

120. The Secretariat recalled that the Assembly, at its forty-fourth session in September/October 2014, had approved a recommendation that the International Bureau should undertake a review of the criteria and procedures for appointment of an Office as an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) under the PCT and make proposals for necessary changes if appropriate, in coordination where appropriate with the Meeting of International Authorities, for discussion at this session of the Working Group. As a first stage in this review, the International Bureau had sought the input by the Meeting of International Authorities which discussed the issue in Tel Aviv in February 2014. With regard to the procedures for the process, the Meeting had agreed that the process needed to be reviewed to allow effective expert consideration of applications for appointment, by suggesting several stages in the appointment process before the decision on the appointment by the Assembly. With regard to the substantive criteria for appointment, the Meeting had agreed that it was premature to recommend any changes at this stage and had recommended that its Quality Subgroup consider further the quality requirements to act effectively as an Authority and how these could be better expressed in the criteria for appointment (see paragraphs 44 to 54 of document PCT/WG/7/3). Document PCT/WG/7/4 therefore proposed a new set of procedures for appointment in paragraph 27, which allowed the Committee for Technical Cooperation (CTC) to play its envisaged role as a true expert body in giving its advice to the Assembly on possible appointment of an Office by meeting at least three months before the Assembly, preferably at the same time as the Working Group. This therefore had implications on the timing of any application to become an ISA/IPEA, which would need to be submitted by November in the year before consideration by the Assembly. A prospective International Authority would also need to meet all the substantive criteria for appointment at the time of the appointment by the Assembly, and it was also proposed that the application should be included on the agenda of the Meeting of International Authorities to provide advance advice on the application to the CTC. The document also provided some observations on the substantive criteria for appointment, transitional matters for how any new criteria could apply to existing Authorities, and technical assistance to Offices of developing and least developed countries where there was scope for improvement in the coordination and delivery of training by established Offices, including, but not limited to International Authorities.

121. The Delegation of Australia supported the revision of the appointment of International Authorities, including a greater role for the Committee for Technical Cooperation, and believed that the proposed procedure for appointment in the document would provide the necessary review of an application for appointment prior to consideration at the Assembly. However, in respect of the involvement of the Meeting of International Authorities, while International Authorities might have a useful role in providing support and advice to Offices seeking to become an International Authority, the advice by the Meeting of International Authorities should be limited to technical matters only as it would be inappropriate for International Authorities to be able effectively to veto Offices seeking appointment.

122. The Delegation of Israel underlined the need for International Authorities to meet requirements for appointment that ensured the highest standards of quality expected by users of the PCT. The Delegation supported the proposed appointment procedures with assessment and evaluation by experts from the existing International Authorities in October to December, assessment by the Meeting of International Authorities in January/February, discussions by the Committee for Technical Cooperation in May/June and appointment by the Assembly in September/October. Any Office seeking appointment should have in place a quality management system already planned and operational in respect of national search and examination work to demonstrate the appropriate experience. With regard to appointment criteria, the Delegation agreed with approach outlined in the document. More specifically, the requirement of simultaneous appointment as both an International Searching Authority and International Preliminary Examining Authority should not be changed, but amendments should

be made to the criteria so Offices seeking appointment needed to have full access to the minimum documentation at the time of submitting the request for appointment. In addition, the Office should show to the experts evaluating requests that examiners had all necessary skills to use available search tools relevant to that field of technology effectively. Finally, the Delegation considered that applications for appointment should include more details on examiners' professional language skills and experience, training programs, machine translation tools, and searching tools and facilities in the Office.

123. The Delegation of Hungary, speaking on behalf of the Visegrad Group of countries (Czech Republic, Hungary, Poland and Slovakia), stated that the appointment of International Authorities concerned the global development and functioning of the PCT system. The Visegrad Group believed that it was the responsibility of Contracting States in the interest of users and the sustainability of the system to assure that only quality work was done by International Authorities. At the same time, it was important to avoid a discussion on the criteria and procedure to appoint International Authorities which could lead to preventing new appointments of Authorities that are able to deliver quality work for the users of the PCT system. Before deciding on a complete re-shaping of the current system, there needed to be proof that the system might not be adequate. Yet the way that the current criteria were applied did not show clearly that they needed to be amended. The case might rather be that these criteria were not applied in a necessarily strict way. Furthermore, the existing framework gave the possibility to increase the professional preparation of appointments by simply scheduling the Committee for Technical Cooperation to meet back-to-back with the Working Group. Therefore, before deciding on substantial changes in the appointment criterion and procedure, the Working Group needed to examine whether it was possible to achieve results with simple procedural matters.

124. The Delegation continued with comments on the document. The Delegation agreed with the Meeting of International Authorities that it was premature to recommend any changes to the criteria for appointment and noted that not all International Authorities were fully convinced that quality could be achieved by merely setting more demanding appointment criteria. The Delegation acknowledged the recommendation that the Quality Subgroup consider further the quality requirements to act effectively as an Authority and how this could be better expressed in the criteria for appointment. Nevertheless, the mandate given to the Quality Subgroup had to be understood strictly to relate to the examination of quality of the work of an International Authority and the impact of the appointment criteria on this quality. Therefore, it seemed appropriate to wait for the results of the Quality Subgroup and avoid rushing into a decision in the Working Group. While the International Bureau had proposed that suggestions from the Working Group could be fed into the discussions of the Quality Subgroup, the Delegation advocated the reverse order. In other words, the results of the deliberations on the appointment criteria by the Quality Subgroup should first be fed into the discussion by the Meeting of International Authorities, whose comments could then be taken into account in the discussions at the following Working Group. The Delegation considered the discussions on appointment of criteria to be premature, but agreed that provisional appointments should only be allowed in exceptional cases which needed to be justified. In respect of the appointment procedure, the Delegation did not have any concerns with proposals that aimed at streamlining the procedure and could therefore accept the proposal that the Committee for Technical Cooperation (CTC) should meet separately from and not back-to-back with the Assembly, this giving the CTC a greater advisory role which would make the existing procedure more effective. Furthermore, as all International Authorities were *ex officio* members of the CTC, the additional role played by the Meeting of International Authorities (MIA) seemed superfluous. Since not all Contracting States were present at the MIA, it did not seem appropriate to delegate to this body the role of conducting a review of the application, giving it the right to make a pre-assessment. Nor was there any kind of requirement in the PCT to involve the MIA. Therefore, it did not seem to be in conformity with the PCT to prescribe a mandatory review by the MIA. Nevertheless, the Delegation acknowledged the proposal on seeking voluntary assistance from International Authorities by newcomers and carefully reviewing the practice of provisional appointments.

125. The Delegation further underlined that the Visegrad Group subscribed to and was committed to maintaining or raising the quality of work done by the International Authorities. An overly centralized system could hamper initiatives that could serve existing needs of applicants; with the modern communication systems that were commonplace today to provide electronic databases and platforms for exchange of knowledge, the goal of any further centralization was entirely unjustified. The proposed appointment procedure in the document might at first only affect newcomers, but should the procedure be approved, there was a danger that the reappointment process would result in a decrease in the number of International Authorities. This would run the risk of further increasing the already huge backlogs at the larger Offices and of limiting the number of options open to users for entering the PCT system.

126. The Delegation concluded by informing the Working Group that the Visegrad countries were working on the establishment of a new International Searching and Preliminary Examining Authority under the PCT. The presence of an International Authority in Central and Eastern Europe would offer users of the patent system a favorable and efficient option for obtaining patent protection internationally. Users would also benefit from the possibility to communicate with a PCT International Authority in their own language. Those advantages might also contribute to fostering innovation and creativity and to promoting economic growth and competitiveness in the region.

127. The Delegation of Japan asserted the importance of International Searching and Preliminary Examining Authorities providing high quality international search reports and international preliminary examination reports for the PCT system to function effectively. Discussions of the appropriate requirements were therefore desirable from the perspective of continuous improvement of the PCT system. In particular, it was important to review whether the existing requirements and procedures adequately addressed the expansion in recent years of the scope and complexity of technical prior art, as well as the development of information technology. In conducting the review, the Delegation believed that it was necessary to consider whether the current requirements were appropriate and whether there were new requirements necessary for preparing high quality international search reports and international preliminary examination reports. In this context, the Delegation agreed to the proposal on appointment procedures in paragraph 27 of the document.

128. The Delegation of Spain supported work towards greater clarity of international searches, to the benefit of applicants and all Member States, by ensuring resources for international searches and increasing cooperation and quality. The appointment procedure needed to guarantee that an Authority should be fully active and have complied with all requirements in order to ensure high levels of quality, which were the key to the effectiveness of the system. In terms of the number and skill of examiners, the Delegation had concerns about an arbitrary number of examiners required and believed that the technical level of examiners and the search tools were more useful factors in determining the quality of work products. The procedure for appointment should also require complying with Rules 36 and 63. Finally, the Delegation expressed support for separating the meeting of the Committee for Technical Cooperation from the Assembly, as proposed in the document, and indicated willingness to provide technical cooperation with Offices during the appointment procedure.

129. The Delegation of Slovakia supported the statement made by the Delegation of Hungary on behalf of the Visegrad Group of countries. Transparent rules for appointment of International Authorities were the cornerstone for an efficient and well-functioning patent system in today's rapidly-evolving technological world. The Central European region was facing challenges, due to recent technological developments and innovation activities, resulting in the urgent need for adequate support for PCT applications in the region. The services of an International Authority in the local language, as proposed by the Delegation of Hungary, would create a competitive edge and provide added value of supporting local applicants and benefitting the PCT system.

130. The Delegation of the United States of America stated that the increasing reliance on international work products by national Offices, applicants and third parties as an accurate assessment of patentability was largely due to recent improvements and an increased commitment to quality made by International Authorities. The United States Patent and Trademark Office (USPTO) therefore believed that the current requirements and procedures for becoming an International Authority needed to be updated to reflect the realities of the twenty-first century in order to continue the increasing acceptance of the international search and preliminary examination reports. It was important to ensure that any Offices which desired to become Authorities could meet the level of quality demanded by the users of the PCT system, including both applicants and national Offices. With regard to the revision of the criteria, the Delegation supported the recommendation in paragraph 43 of the document that any criteria should be applied to existing Authorities in a transitional manner, and it agreed that discussion on the specific criteria be referred to the Quality Subgroup of the Meeting of International Authorities. With regard to the procedure for appointment, the USPTO fully supported the revised procedure set forth in paragraph 27 of the document and the recommendation in paragraph 28 that the Assembly adopt an understanding to implement those procedures with immediate effect. The Delegation, however, commented that consideration could be given to including a requirement for an onsite review of an Office applying to become an International Authority by one or more suitably-qualified Offices, whether selected by the International Bureau or chosen by the candidate Office. This had been included in document PCT/MIA/21/3 discussed at this year's Meeting of International Authorities and would allow the reviewing Office to comment on the degree to which the appointment criteria had been met, in contrast to the existing visits that the International Bureau undertook where advice could be given on the criteria but it was not possible to judge the substantive criteria. The Delegation also supported the idea in paragraph 23 of the document that provisional appointments should be curtailed. Finally, with regard to the content in the application as discussed in paragraph 25 of the document, the Delegation stated that examiner training, experience and breadth and depth of technical expertise were probably the most important matters to be considered in determining whether an Office would be able to establish international reports of sufficient quality. The level of detail given to those matters should therefore be at least at the level given to the issues of quality management systems, access to the minimum documentation and background issues of IT systems.

131. The Delegation of Poland supported the statement made by the Delegation of Hungary on behalf of the Visegrad Group of countries. The Delegation subscribed to the opinions expressed at the Meeting of International Authorities that it was premature to recommend any changes to the criteria for appointment as it would be advisable first to ensure the strictest application. The proposed changes to the appointment criteria might significantly limit not only the market for the future International Authorities but also subsequently trigger the reappointment process of existing well-performing International Authorities providing a wide range of users with high quality PCT products. Due to the prospect of such limitation for applicants and their access to competitive PCT products and services available in their mother tongue, all interested Member States should give this topic significant consideration and wait for the results of the discussions in the Quality Subgroup. Although the Delegation supported the streamlining of the application procedure, it did not see the rationale behind the change of appointment criteria and believed that stricter application of the current provisions in this respect would suffice.

132. The Delegation of China stated that the service provided by International Authorities needed to be convenient and accessible for applicants speaking in different languages in different regions or nations. An Office should be appointed as an International Authority as long as it has a given number of capable examiners, infrastructure and quality management rules to undertake search and preliminary examination. The Delegation therefore suggested further study and discussion of this issue.

133. The Delegation of the Republic of Korea underlined the importance of quality services provided by International Searching and Preliminary Examining Authorities and supported the proposal set out in paragraph 27 of the document, in particular, the review procedure by the Meeting of International Authorities and the Committee for Technical Cooperation, since the experiences and expertise of existing International Authorities would be very helpful.

134. The Delegation of Canada believed that having a number of International Authorities working in a variety of geographic locations in numerous languages provided a superior service to PCT users, increasing the overall standard of work of the PCT through the sharing of expertise among the International Authorities in joint initiatives and meetings such as the Meeting of International Authorities and its Quality Subgroup. The Delegation fully supported the proposed procedures for appointing a new International Authority in paragraph 27 of the document, which would encourage the assistance and advice from existing International Authorities, followed by technical discussion within the Meeting of International Authorities, which would inform the Committee for Technical Cooperation. With respect to the criteria for appointment, the criteria of utmost importance in assessing the appointment of an Office as a potential International Authority was the quality of work of that Office. The Delegation therefore agreed with the Meeting of International Authorities tasking the Quality Subgroup to consider the quality requirements to act effectively as an International Authority and to decide how these could be better expressed in the criteria for appointment.

135. The Delegation of the Russian Federation supported the main proposals in this document, notably paragraphs 23 and 27, along with the discussion of substantive criteria through the Quality Subgroup. With regard to paragraph 25 on the content of an application, it was a matter of urgency to develop a detailed application format for inviting future candidates to submit sufficiently information for discussion in the different fora, starting with the expert group, then the Meeting of International Authorities, the Committee for Technical Cooperation and the Assembly. As the success of these discussions depended to a great degree on the material submitted, the application needed to contain sufficient information, with the possibility to include supplementary details over the course of the discussions.

136. The Delegation of the Czech Republic supported the statement made by the Delegation of Hungary on behalf of the Visegrad countries.

137. The Delegation of Brazil expressed agreement with the comments in paragraph 15 of the document that the main underlying policy requirement ought to be that an Office which was appointed as an International Authority should be both capable of and willing to conduct international search and preliminary examination in a timely fashion and to a high quality standard.

138. The Delegation of India stated that the role of the International Searching Authority was to produce a reliable and authentic search report that applicants had confidence in relying on to seek patent protection in other countries. This could be achieved only when the International Searching Authority had qualified examiners, quality databases for conducting search containing documents beyond the minimum documentation, and a quality management system to monitor the quality of the reports. The Delegation supported the proposal for establishing the new criteria for appointment of International Searching and Preliminary Examination Authorities, but believed that in considering changes, the observations made by the Meeting of International Authorities in paragraph 49 of document PCT/WG/7/3 needed to be taken into consideration. However, this should not necessarily delay the appointment of new International Searching Authorities.

139. The Delegation of the European Patent Office supported the proposal with regard to reviewing the procedure for new appointments of International Authorities set out in paragraphs 27 and 28 of the document, including the role of the Meeting of International Authorities if this was only consulted for technical advice on the appointment to provide an

opinion to the Committee for Technical Cooperation on whether or not the requirements of Rule 36 had been met. As stated in the paragraph 15 of the document, the essential requirement should be to ensure that Authorities met the highest level of quality so that designated Offices used reports in the national phase.

140. The Delegation of Chile believed that a minimum number of examiners did not appear essential to meeting the required objectives of an International Authority, and that the requirements should be orientated towards quality aspects to guarantee as far as possible the high quality of work products of International Authorities.

141. The Chair summarized the views expressed on the six steps of the appointment procedure outline in paragraph 27, but first acknowledged the views of some delegations that adjustment of the substantive criteria may not be necessary if the current ones were properly applied. There had been strong support for subparagraphs (a), (b) and (c) of paragraph 27 that prospective Offices should obtain assistance from other International Authorities in order to understand and appreciate the tasks; an Office wishing to become an International Authority should provide a thorough application at an early stage; and Offices should meet all substantive criteria on appointment and start operation as soon as reasonably possible. However, there was different views on subparagraph (d) on the involvement of the Meeting of International Authorities, where some delegations had voiced concerns of the possibility for existing Authorities attempting to veto an application, yet other delegations considered the role of this body to be appropriate if it was limited to consideration and advice on technical issues, like the capability to search and access databases for the Committee for Technical Cooperation to consider before making a recommendation on the appointment to the Assembly. With regard to subparagraph (e), there appeared to be general consensus on the Committee for Technical Cooperation meeting back-to-back with the Working Group in order to provide the recommendation to the Assembly stated in subparagraph (f).

142. The Delegation of Singapore requested further information on differences in the considerations to be made by the Meeting and International Authorities and the Committee for Technical Cooperation in the proposed appointment procedure.

143. The Secretariat, in response to the question raised by the Delegation of Singapore, clarified that neither the Meeting of International Authorities nor the Committee for Technical Cooperation would be able to veto an application, but the latter body had a clear role to provide advice to the Assembly. Although the Assembly could ignore the advice, this was unlikely. The intention would be that the Meeting of International Authorities would provide a deeper analysis of the application by experts and give further information to the Committee for Technical Cooperation, thereby allowing further reflection by the prospective International Authority in advance of the Committee for Technical Cooperation and deeper deliberations by this body to make its role in advising the Assembly more meaningful.

144. The Delegation of Hungary reiterated concerns with the appointment procedure. First, it was not able to agree on the involvement of the Meeting of International Authorities. Second, if this body had no role, then the deadline for the application in subparagraph (b) of paragraph 27 could be several months after the proposed deadline of end November the year before consideration by the Assembly

145. The Representative of the American Intellectual Property Law Association (AIPLA) pointed out that market forces applied in the applicant's choice of International Authority. Among AIPLA practitioners, certain Authorities had a reputation of being more competent and producing work that could be relied on to a greater degree than others, but linguistic capabilities were another factor in the choice of the applicant. Prospective Authorities therefore needed to consider whether their Office would be selected by an applicant before a country undertook the

effort and expense to become an International Authority. AIPLA was concerned about the proliferation of International Authorities, but at the same time recognized the opportunities in developments in innovative activities in areas such as Central Europe.

146. Discussions continued on the basis of a proposal by the Delegation of Hungary revising paragraph 27 of the document.

147. The Delegation of Hungary believed that that the scheduling of the Committee for Technical Cooperation three months before the Assembly, preferably back-to-back with the Working Group, would achieve the desired results. In this regard, the Delegation pointed out the roles of the Committee for Technical Cooperation in Article 56(3)(iii) of contributing to the solution of technical problems involved in the establishment of a single International Searching Authority, and the requirement in Article 16(3) that, before the Assembly takes a decision on the appointment of any new International Authorities, it should seek the advice of the Committee for Technical Cooperation. In the view of the Delegation, technical advice by existing International Authorities could easily be given in the Committee for Technical Cooperation, who were all *ex officio* members of this body and could therefore discuss the application and provide technical advice. By applying the existing rules in the necessary way, greater technical preparation could take place before the decision of the Assembly. On the other hand, constructing an additional role for the Meeting of International Authorities would be in conflict with the Rules of the PCT, which did not involve this body in the procedure, and empowering the Meeting with this new competence appeared to be superfluous. Nevertheless, the Delegation welcomed the proposal on seeking voluntary assistance from International Authorities.

148. The Delegation of Sweden commented that the specific timing of the application should be deleted from the procedures and for it to be clarified that the application for appointment should be made well in advance of the Committee for Technical Cooperation.

149. The Delegation of Poland supported the proposal by the Delegation of Hungary.

150. The Delegation of Norway expressed support for the proposal by the Delegation of Hungary, and underlined the need for a procedure that took care of the quality of work products of potential International Authorities.

151. The Delegation of Denmark was also able to support the proposal by the Delegation of Hungary, as it removed the concern of the Meeting of International Authorities taking a vested interest in an application, and brought the meeting of the Committee for Technical Cooperation forward to the same time as the Working Group.

152. The Delegation of the Czech Republic supported the proposal by the Delegation of Hungary.

153. The Delegation of the United States of America believed that the Meeting of International Authorities was the most competent body to evaluate the potential of future International Authorities, and therefore had concerns with the proposal by the Delegation of Hungary. The Delegation also enquired about the change in subparagraph (c) from "must" to "should".

154. The Delegation of Spain agreed with the comments made by the Delegation of Sweden and opposed the change in subparagraph (c) from "must" to "should" in terms of fulfilment of obligations. The Delegation believed that the Meeting of International Authorities had to remain involved in the process, whether in an advisory role or through the exchange of experiences with candidate International Authorities.

155. The Delegation of Greece supported the proposal by the Delegation of Hungary, underlining that the Committee for Technical Cooperation was the competent body to evaluate any applications to become an International Authority.

156. The Delegation of the United Kingdom believed the proposal by the Delegation of Hungary represented a small step forward in terms of improving the current process. However, the Delegation preferred the proposal as originally presented, with the suggested insertion of the word "technical" in subparagraph (d) in terms of the advice provided by the Meeting of International Authorities to the Committee for Technical Cooperation.

157. The Delegation of Japan believed it was important to set aside enough time to study the appointment process. Therefore, the Delegation supported the original proposal that an application for appointment had to be received by the end of November of the year before the Assembly, and the Meeting of International Authorities should discuss the proposal before the Committee for Technical Cooperation, which would meet back-to-back with the Working Group. As many Member States other than those with International Authorities participated in the Committee for Technical Cooperation, it was undeniable that evaluations in this body would be influenced by non-technical viewpoints. Therefore, it was preferable to maintain the original proposal with clarification of the technical role to be played by the Meeting of International Authorities. As for the wording in subparagraph (c) between "must" and "should", the Delegation considered that this should be in line with the wording used in Rule 36.1.

158. The Delegation of Slovakia supported the proposal by the Delegation of Hungary.

159. The Delegation of Singapore supported the intent behind the proposals to change the appointment procedure and underlined that International Searching and Preliminary Examining Authorities played an important role in the PCT system, where quality was paramount. The Delegation was supportive of a proposal which strived to ensure that this was the case. In particular, there should be sufficient detailed information to enable an in-depth discussion and a well-considered decision by the Assembly. However, there was a need to ensure that the process was streamlined and did not involve duplication of effort. Given that all International Authorities were *ex officio* members of the Committee for Technical Cooperation, this body appeared to be sufficiently competent and representative to provide technical advice to the Assembly. In light of this, it might not be necessary to place the application before the Meeting of International Authorities.

160. The Delegation of France did not agree with removing the role of the Meeting of International Authorities from the appointment process as proposed by the Delegation of Hungary, since this would deprive the process of the experience and expertise of this body.

161. The Delegation of Austria pointed out that the proposal included "national" when referring to an Office in subparagraph (a), but not in subparagraphs (b) and (c).

162. The Delegation of Kenya supported the proposal by the Delegation of Hungary.

163. The Delegation of the Republic of Korea shared the same concerns as the Delegations of the United States of America and Japan about the exclusion of the Meeting of International Authorities from the appointment process.

164. The Delegation of Viet Nam expressed its support for the request of the Intellectual Property Office of Singapore to be appointed as an International Searching and Preliminary Examining Authority under the PCT.

165. The Secretariat, responding to the remark made by the Delegation of Austria, explained that the word "national" derived from Article 16(1), which spoke of a national Office or an intergovernmental organization. The full wording in this respect in Article 16 could be reflected in the procedure. With regard to subparagraph (b) on the timing of the application, the text could be changed to clarify that the application needed to arrive well in advance of its consideration by the Committee for Technical Cooperation, where it was preferable to indicate a date so documents would arrive at the International Bureau in good time. As for subparagraph (c), in PCT terminology, "should" was not the same as "must"; the equivalent of

“must” in the PCT Regulations was “shall”. However, there was an exception to all the requirements being met with regard to the existence of a quality management system. One possibility could therefore be to replace “should” with “shall”, but also add a sentence to explain that, should an Office at the time of appointment not have a fully-fledged quality management system in place, it would be acceptable that a PCT quality management system was fully planned, and preferably that there were similar systems already operational in respect of national search work to demonstrate the appropriate experience.

166. The Chair summarized that there was no consensus on the original proposal in the document or that made by the Delegation of Hungary. Some delegations wished to have an active role for the Meeting of International Authorities to conduct a technical assessment of the application, whereas other delegations believed that this technical assessment could be performed by the Committee for Technical Cooperation, as all members of the Meeting of International Authorities were *ex officio* members of the Committee for Technical Cooperation. Other issues related to timings, which depended on the involvement of the Meeting of International Authorities.

167. The Delegation of the United States of America emphasized that its main concern with the proposal by the Delegation of Hungary was that the Committee for Technical Cooperation might not have the technical expertise to evaluate the application outside of political considerations. The Delegation therefore suggested a middle ground that might alleviate these concerns that this body form an expert subgroup composed of representatives of existing International Authorities, which would review the application and provide the Committee for Technical Cooperation with a technical report of its observations and assessment of the application with respect to the appointment criteria.

168. The Chair thanked the Delegation of the United States of America for its suggestion but pointed out that an expert subgroup of the Committee for Technical Cooperation composed of representatives of International Authorities would amount to the Meeting of International Authorities with a different name.

169. The Chair acknowledged that a number of countries, especially those with International Authorities, were uncomfortable with the removal of the role of the Meeting of International Authorities in a formal sense. But as those International Authorities would be able to express their views at the Committee for Technical Cooperation, the Chair urged these countries to reconsider whether it would be possible to accept a proposal where the views of the Meeting of International Authorities could be voiced, although this would be through the membership of International Authorities at the Committee for Technical Cooperation. This would be an improvement on the existing procedure. Whether or not the proposal was considered by the Meeting of International Authorities, any delegation could raise issues on an appointment of a prospective International Authority at any stage of process.

170. Following informal discussions led by the Chair, discussions continued on the basis of a further revised proposal on the procedures for appointment.

171. The Chair explained that the revised proposal set a deadline of March 1 for an Office to apply for appointment as an International Searching and Preliminary Examining Authority in order to be considered by the Committee for Technical Cooperation, which would meet back-to-back with the Working Group. Two months before the meeting of the Committee for Technical Cooperation, the applicant Office would be required to submit a full application for the Committee to provide its advice to the Assembly. There was no formal role of the Meeting of International Authorities in the revised proposal.

172. The Delegation of Canada expressed a preference for a formal role for the Meeting of International Authorities, but could accept the revised proposal as an improvement on the current procedure. The Delegation enquired about the wording of “should” in subparagraph (e) rather than “shall”.

173. The Secretariat, in response to the question raised by the Delegation of Canada, explained that the WIPO General Rules of Procedure had some precise deadlines such as the sending out of letters of convocation not less than two months prior to the opening of the session, but others, such as the submission of meeting documents, were more flexible. The wording proposed allowed for this flexibility, recognizing that time was needed to translate a document into the other five UN languages.

174. The Delegation of Spain suggested making a direct reference to the WIPO General Rules of Procedure when referring to the timing of the submission of the application to become and International Searching and Preliminary Examining Authority.

175. The Chair, in response to the suggestion by the Delegation of Spain, explained that the wording of “should” proposed had the same effect as the WIPO General Rules of Procedure, and did not see benefit to making a direct reference to these Rules.

176. The Working Group agreed to recommend to the PCT Assembly to adopt the following Understanding:

“Procedures for Appointment of International Authorities”:

“(a) A national Office or an intergovernmental organization (“Office”) seeking appointment is strongly recommended to obtain the assistance of one or more existing International Authorities to help in the assessment of the extent to which it meets the criteria, prior to making the application.

“(b) Any application for appointment of an Office as an International Authority is to be made well in advance of its consideration by the PCT Assembly so as to allow time for an adequate review by the Committee for Technical Cooperation (PCT/CTC). The PCT/CTC should meet as a true expert body at least three months in advance of the PCT Assembly, if possible back-to-back with a session of the PCT Working Group (usually convened around May/June of any given year), with a view to giving its expert advice on the application to the PCT Assembly.

“(c) Consequently, a written request to the Director General to convene the PCT/CTC is to be sent by the Office preferably by March 1 of the year in which the application is to be considered by the PCT Assembly and in any case in time to allow the Director General to send out letters of convocation of the PCT/CTC not less than two months prior to the opening of the session.

“(d) Any such application should be made on the understanding that the Office seeking appointment must meet all substantive criteria for appointment at the time of the appointment by the Assembly and is prepared to start operation as an International Authority as soon as reasonably possible following appointment, at the latest around 18 months following the appointment. With regard to the requirement that the Office seeking appointment must have in place a quality management system and internal review arrangements in accordance with the common rules of international search, where such system is not yet in place at the time of the appointment by the Assembly, it shall be sufficient that such system is fully planned and, preferably, that similar systems are already operational in respect of national search and examination work to demonstrate the appropriate experience.

“(e) Any document by the Office in support of its application for consideration by the PCT/CTC should be submitted to the Director General at the latest two months prior to the opening of the session of the PCT/CTC.

“(f) Any such application is then to be submitted to the PCT Assembly (usually convened around September/October of any given year), together with any advice given by the PCT/CTC, with a view to deciding on the application.”

177. The Working Group further agreed to recommend to the PCT Assembly to adopt the following decision concerning entry into force and transitional arrangements in respect of the proposed Understanding:

“The procedures for appointment of International Authorities set out in the above Understanding shall apply to any application for appointment as an International Authority submitted after the closure of the present session of the PCT Assembly.”

### **GENERAL DISCUSSION OF PCT 20/20 PROPOSALS**

178. Discussions were based on document PCT/WG/7/20.

179. The Delegation of the United Kingdom introduced the document by explaining that the United Kingdom and the United States of America had presented a joint proposal “PCT 20/20” to the fifth session of the Working Group in 2012 (document PCT/WG/5/18). Revised and expanded proposals had been presented to the sixth session of the Working Group (document PCT/WG/6/15), following which the Assembly had adopted amendments to the Regulations concerning two of these proposals, namely, mandatory top-up searches and making the written opinion of the International Searching Authority available to the public at the time of international publication of the application. The present document discussed the current status of the remaining proposals. One of these, the formal integration of the Patent Prosecution Highway into the PCT, was the subject of a separate paper (document PCT/WG/7/21). The Delegation welcomed general comments from other delegations on the proposals.

180. The Delegation of Australia considered the proposal on recordation of search strategies to be a high priority. The Delegation underlined that search strategies should be recorded and shared with other Offices and informed the Working Group that the Vancouver Group of IP Offices (Australia, Canada and the United Kingdom) was presently looking at principles to recording and sharing search strategies between their Offices, which included developing a common format for sharing these strategies. These experiences could aid the work being undertaken by the Quality Subgroup of the Meeting of International Authorities in advancing this proposal. Making search strategies publicly available would increase transparency in respect of the work undertaken by the International Searching Authority, and raise quality and facilitate work sharing. For this reason, the Delegation saw particular value in a search strategy containing information on the search carried out, such as databases consulted and search queries keyed into the search engine at each stage, as well as an indication of documents viewed, thereby giving applicants and Offices a clear indication of what had been searched. Given that the readership of search strategies was most likely to be professionals, the Delegation saw particular value in these elements being a required part of a common search form, even if patent professionals were not intimately familiar with the tools. At IP Australia, search information statements contained a full history of the international search, including a listing of databases consulted, the steps undertaken in the search and specific terms keyed into the search engine and an indication of documents viewed and the three person examining team who conducted the search. These search information statements were made available along with an international report. The Delegation therefore strongly encouraged all International Searching Authorities to provide their search strategies to the International Bureau for publication on PATENTSCOPE, as the increased transparency would increase confidence in respect of the work undertaken and increase quality and work sharing.

181. The Delegation of Canada stated that it looked forward to sharing the experiences of the Vancouver Group initiative described by the Delegation of Australia with the Working Group, and it encouraged other Offices to make search records available on PATENTSCOPE.

182. The Delegation of Israel stated that some of the proposals in the document could be expanded further and presented to the next session of the Working Group. First, the Delegation expressed support for limited Chapter I amendments, provided these were of a non-substantive nature, as this would be helpful to both International Searching Authorities and applicants. Second, mandatory recordation of search strategy would contribute to improving the quality of searches and provide greater confidence in PCT work products by increasing transparency of search in the international phase. Since April 2013, the Israel Patent Office had provided copies of more than 1,000 search strategies to the International Bureau for publication on PATENTSCOPE. Other proposals that the Delegation considered could be expanded further were collaborative searching and formal integration of the Patent Prosecution Highway into the PCT.

183. The Delegation of the European Patent Office stated that the European Patent Office already required a mandatory reply to the written opinion from the International Searching Authority or to the International Preliminary Report on Patentability it had produced as an International Searching Authority or as an International Preliminary Examining Authority, and it recommended other Offices to make unilateral efforts in this regard. The European Patent Office had also implemented mandatory top-up search in Chapter II with effect from April 1, 2014, ahead of the date of entry into force of the new Regulations in the PCT on July 1, 2014. Regarding the sharing of search strategies, this issue had been discussed at the twenty-first session of the Meeting of International Authorities, where the European Patent Office had taken on a lead role in a contact group with other International Authorities. As for collaborative search, the Delegation updated the Working Group on the two pilot exercises it had undertaken with the Korean Intellectual Property Office and the United States Patent and Trademark Office. The European Patent Office had conducted an in-depth review of the two pilot projects with the aim to evaluate future collaborative search and examination opportunities in the patent system and assess the need for a third pilot and what its goals and methodology should be to add value to the positive results of the two previous pilots. The result of this review was that there was a need for a third pilot to set a strong basis for any decision on the future of the concept, which should gather feedback from users as well as further refine the methodology. The European Patent Office was therefore going to discuss with the IP5 Offices, particularly those which had participated in the two previous pilots, on taking this forward by sharing views on quality standards, involvement of users and monitoring for setting the basis for a cost-benefit analysis. All aspects of the search process needed to be considered, such as added value for users, operational aspects in the Offices, and cost of a collaborative search product.

184. The Delegation of Egypt expressed interest in reductions in fees for the benefit of micro and small and medium-sized enterprises, which could also apply to universities and non-profit organizations. However, the Delegation reiterated its concern with a proposal to regulate fee reductions in the national stage for small and micro entities, which should be left for national Offices to determine.

185. The Delegation of India commented on the broad nature of the proposals and requested further clarity and more focused content for discussions at the following session of the Working Group.

186. The Delegation of the Republic of Korea commented on the recordation and sharing of search strategies. Although there were potential benefits to this proposal, the Delegation believed further study was needed to weigh up the inevitable increase in workload for examiners and the potential benefit of sharing search strategies with other Offices. On this subject, the Delegation looked forward to the outcome of the discussions in the contact group set by the Quality Subgroup of the Meeting of International Authorities.

187. The Delegation of Japan acknowledged the importance of improving the PCT system in order to create a more user friendly system and referred to the views it had expressed in reply to Circular C. PCT 1364, dated December 20, 2012. The Delegation indicated its intention to contribute actively to the further discussions of the proposal with a view to improving the PCT system.

188. The Delegation of China continued to examine the proposals in the document, but expressed concern about PCT Rules being applied in a standard way in the national phase. For example, requiring a response in the national phase to negative comments raised in international work products might increase examination efficiency, but it would also put an additional burden on applicants.

189. The Delegation of the United States of America echoed the encouragement made by the Delegations of Australia and Canada that International Searching Authorities should voluntarily post their search strategies in PATENTSCOPE in whatever format they were currently prepared, adding that this would be the best way to assess the usability of these strategies, to increase transparency and to determine if a common format was even necessary. The Delegation noted the comments made by the Delegation of India for more focused content and pointed out that, in the context of meetings of the IP5 Offices, it intended to look at all PCT improvement plans that had been put forward in recent years to revisit the status of these items and identify ones with potential value that had not been implemented, as discussed in paragraph 49 of the document. The Delegation therefore hoped to have more specific proposals for improving the system for the next session of the Working Group.

190. The Delegation of Singapore commented on the response to negative comments at the national phase, which it considered would provide national Offices with more information on which they could continue to do examination work at the national phase. However, the applicant should not be overburdened. Although there should be a way to allow such a response to be received, it should not be seen strictly as only being a response to the comments in the international phase, but also an opportunity to take the comments into account with amendments in the national phase. So, rather than an additional step, the applicant would be presented with a seamless process. The Delegation also believed that recordation of search strategies provided useful information for national Offices, which could increase the efficiency of work in these Offices.

191. The Chair responded to the comment made by the Delegation of the Republic of Korea on the extra work of patent examiners in recordation of search strategies by pointing out that search strategies were usually already recorded by the search examiner and kept in the application file for future reference. The mandatory recordation of search strategies may not therefore require a significant amount of additional work, and in any case, the additional work for one examiner would save the time of many other examiners viewing the search strategy who would not need to repeat the work, thereby improving the efficiency of the process.

192. The Representative of the Japan Intellectual Property Association (JIPA) had two comments on the document. First, regarding the integration of international and national phases, JIPA underlined the need that Offices consider the impact on users as well as Offices. In this regard, JIPA hoped that the pilot envisaged by the United States of America described in paragraph 28 of the document would also collect quantitative data relating to the effect on users, such as the duration of examination at the national or regional phase, to make an adequate comparison of the pilot. Second, regarding collaborative searching, JIPA hoped that quantitative data would be collected through the third phase of the pilot referred to in paragraph 37 of the document, such as the number of applications for which the Offices present new prior art cited in the international search report, whether or not findings as to the patentability of the invention in the international phase changed in the national phase and the number of actions by the Offices. These examples would be important for users as these were linked to the total cost for obtaining patent protection.

193. The Representative of the International Federation of Industrial Property Attorneys (FICPI) expressed general support for three of the proposals: top-up searches in Chapter II, mandatory recordation of search strategies, which would increase transparency and quality, and a further pilot on collaborative searching, so eventually this process could replace supplementary international searches.

194. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) welcomed means to facilitate the making of minor changes through limited Chapter I amendments, like the renumbering of claims. However, referring to discussions on missing parts in document PCT/WG/7/19, the Representative emphasized that any solution on replacing entire sets of description, claims and drawings would need to provide legal certainty on acceptance by the designated or elected Office. The Representative expressed support for standardized fee reductions for national phase applications. EPI also agreed with provisions to require a response to negative international reports when entering the national phase, but only when the designated Office was the same as the International Searching Authority; it was not effective to require this if the two Offices were different. EPI also welcomed collaborative searching between Offices, but at no further cost to the applicant. Finally, EPI considered that the global dossier launched by the European Patent Office and the State Intellectual Property Office of the People's Republic of China was a positive development, but the Representative commented that paragraphs 40 to 43 of the document were not clear on whether this proposal referred to the international or national phase of the application process.

195. The Working Group noted the contents of document PCT/WG/7/20.

#### **FORMAL INTEGRATION OF THE PATENT PROSECUTION HIGHWAY INTO THE PCT**

196. Discussions were based on document PCT/WG/7/21.

197. The Delegation of the United States of America explained that the document proposed amending the PCT Regulations to provide expedited national phase processing through formal integration of the Patent Prosecution Highway (PPH) into the PCT. The Patent Prosecution Highway began with the first bilateral agreement between the United States Patent and Trademark Office and the Japan Patent Office, which took effect in 2006. Since then, both applicants and Offices had appreciated the benefit of the PPH, which had expanded into a "spaghetti bowl" of bilateral and plurilateral agreements, allowing both national and international search and examination results to be leveraged in order to have the processing of related applications accelerated. Many of these agreements had since been liberalized in iterations known as PPH Mottainai or PPH 2.0. Moreover, a number of these agreements had now been placed under the umbrella of the Global PPH and IP5 PPH agreements, reducing complications for both Offices and applicants, while realizing the same benefits. These benefits were described in paragraph 5 of the document, where applications under the PPH had a grant rate at the United States Patent and Trademark Office of 86 per cent compared to 53 per cent for other applications. There was also an increase in the first action grant rate and a decrease in examiner actions prior to final disposition, whether that be grant or abandonment. This added up the cost savings and increased predictability for applicants. For Offices, fewer examiner actions meant that Offices could process these applications more efficiently and thereby reduce backlogs, which seemed obvious since, under the PCT-PPH, the designated or elected Office generally started examination on a claim set with fewer claims and a narrower scope, along with an assessment by an International Authority of whether the claims had novelty, inventive step and industrial applicability. Third parties would also be in a better position at an earlier stage to assess their freedom to operate and do business.

198. The Delegation continued by explaining details of the proposed changes to the legal framework of the PCT, which took into account previous discussions of the proposal. This provided alternatives of either an "opt-out" or an "opt-in" clause in draft Rules 52*bis*.1(b) and 78*bis*.1(b). Moreover, there was a suspension clause in draft Rules 52*bis*.1(c) and 78*bis*.1(c), should the demand for accelerated processing exceed the capacity in an Office. The

Delegation also pointed to the bracketed language in draft Rules 52*bis*.1(a) and 78*bis*.1(a), which intended to give the applicant an opportunity to amend the application before substantive search and examination began before the designated or elected Office. As for the Administrative Instructions, draft sections 901 and 902 defined among other things the work products which could be leveraged, how claims before the designated or elected Office had to sufficiently correspond to those indicated as meeting the criteria of Article 33, and other requirements of acceleration including the additional requirements that might be imposed by a designated or elected Office at their option such as specific forms, fees, a copy of the international work product, a copy of the claims and a list of and copies of cited documents. This further added to the flexibilities for participating Offices.

199. The Delegation concluded by turning to paragraph 26 of the document and explained that the proposal did not affect national sovereignty, as it did not provide for an automatic grant of patent applications. If that were the case, the grant rates would be 100 per cent, which was clearly not the case. Under the PPH, the national Office merely used the international phase work products to streamline its own processing, with a national Office making the patentability determination under its respective national laws; PPH did not change the non-binding nature of international work products. Formal integration of the PCT PPH could allow applicants from all Member States to take advantage of benefits of PPH worldwide, regardless of whether their own national Offices entered into a bilateral agreement with another Office, with the “opt-in” or “opt-out” provisions giving flexibility to any Office that decided not to participate..

200. The Delegation of Japan delivered a presentation on the Patent Prosecution Highway<sup>4</sup> and expressed support for the proposal in the document, which would result in the benefits of PCT-PPH being enjoyed by a greater number of applicants in more Offices throughout the world. Since the first bilateral agreement between the United States of America and Japan in 2006, the Japan Patent Office had been working towards extending the network of PPH agreements between an Office of Earlier Examination (OEE) and an Office of Later Examination (OLE). A PPH agreement enabled an applicant to accelerate the examination procedure on request at the OLE if the claims sufficiently corresponded to those indicated allowable by the OEE. The OLE could therefore utilize the work products of the OEE and the application at the OLE would usually have fewer claims with more limited scope as result of the refinement at the OEE. From the user’s perspective, this provided high speed processing and cost savings if the application had been determined to be patentable by the OEE with a decreased number of Office actions at the OLE. The grant rate at the OLE was also high compared to an application where the PPH had not been requested. As of the end of December 2013, there had been a total number of about 50,000 PPH requests. Another achievement was the Global PPH pilot framework launched on January 6, 2014, which enhanced usability of the PPH framework for users in the 17 participating countries. The Delegation therefore believed that integration of the PCT into the PPH would further enhance benefits for users of the PPH.

201. The Delegation of the United Kingdom indicated that it provided a service called PCT(UK) Fast Track which functioned in a similar way to the PPH system based on PCT work products. The service had been introduced in June 2010 to enable applicants to obtain accelerated processing in the UK national phase where they had obtained a positive written opinion or international preliminary report on patentability in the international phase. Although processing was accelerated, the UK Intellectual Property Office still performed a full examination of the application to check that it met the requirements of national law. This service had been welcomed by users and demand currently stood at 6 per cent of national phase entries. Formal integration of the PPH into the PCT would benefit both Offices and applicants by helping to reduce work and to have international applications processed more quickly in the national phase.

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<sup>4</sup> A copy of the presentation is available on the WIPO web site at:  
[http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=277340](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=277340)

202. The Delegation of the European Patent Office supported the proposal as it would give all applicants in the PCT the equal opportunity to request acceleration of applications in the national phase, yet it did not affect examination of the application, as clearly stated in paragraph 26 of the document. The Delegation did, however, consider the “opt-in” solution in paragraph (b) of the draft Rules to be preferable, as this would allow designated Offices the time to decide when the provision should apply in their Office. A similar “opt-in” process in the PCT was the option in Rule 45*bis*.9 of an International Search Authority to offer supplementary searches. In terms of drafting of the legal provisions, the Delegation considered that it might be useful in Rules 52*bis*.1(a) and 78*bis*.1(a) that the applicant made the request when entering the national phase or the regional phase, so that it was clear from the beginning that this was a PPH application. With respect to Rule 78*bis*.1(a), the Delegation believed that this should refer to the international preliminary report on patentability, as the written opinion of the International Preliminary Examining Authority was an intermediate product. This comment also applied to Section 901(a)(i) of the Administrative Instructions. In Section 901(a)(iii) of the Administrative Instructions, the Delegation considered that the requirement to be free from any observations was too restrictive, since the European Patent Office also made minor observations in Box VIII of the written opinion or report which should not impede acceptance of a PPH request. Including this requirement could therefore discourage Authority from including minor objections in this box. Moreover, the Delegation did not think that the timing of a PPH request should depend on whether substantive examination had begun, as stated in Section 901(a)(iv), but the request should be made on entry to the national or regional phase. Finally, under Section 901(b), the Delegation considered the requirement for claims with a narrower scope to be written in dependent form to be unnecessarily restrictive.

203. The Delegation of Colombia informed the Working Group about its experience of collaboration with patent Offices of the United States of America, Spain and with some Offices in the Latin American and Caribbean Region. Colombia had provided over 200 examinations of patentability as part of cooperation in the examination of common patents with a view to increasing efficiency. These cooperation programs had been highly beneficial in helping make decisions bearing in mind the work of other patent Offices without eroding sovereignty. Independently of the use of products in other participating Offices in the PPH system, applications needed to comply with the laws applicable in Colombia, in other words, Decision 486 of the Andean Community adopted in 2000. There was no reduction in quality as a result of rapid examination. On the contrary, by relying on additional high quality information provided by other Offices, Colombia was in a better position to make more rapid decisions without this affecting quality. The process allowed an applicant whose content had been deemed patentable by one Office to forward their application to another Office for the determination of patentability of the application. The forwarded application needed to contain the patentable claims and provision of the text in the Spanish language, including translations, and copies of previous documents presented by the applicant for the early examination phase, including a non-patent literature whenever they were not available for the Colombian Patent Office. The PPH system for the examination of patents in Colombia did not mean that a claim would be automatically granted, as any decision needed to meet the requirements of Colombian law. The Delegation had noticed a distinct reduction in examination and decision times through the PPH, and, as a consequence, the number of rejected claims had reduced, thereby implying cost savings. The Delegation of Colombia considered that there was no need to convene a Diplomatic Conference for the implementation of PPH in the PCT. It would be enough to comply with the basic principles of the Treaty in the cooperation, examination and protection of claims and inventions.

204. The Delegation of Israel supported the proposal and believed that the PPH was not a burden for Office, but on the contrary, could be beneficial for both applicants and Offices. The number of cross-filings between Offices was significant, such that Offices and applicants could stand to benefit from the PPH. Applications with a PPH request were easier to examine, having fewer claims on average and requiring fewer Office actions. The PPH in no way affected national sovereignty, nor provided for mandatory grants of patents. Moreover, the PPH system

could enhance collaboration on search databases and sharing search strategies between the PPH Offices, as they would have an opportunity to consider the work of other Offices. The Israel Patent Office had nine PPH agreements with different Patent Offices and was also part of the Global PPH. Taking into account that more than 80 per cent of all patent applications filed in Israel were PCT national phase applications, the proposal could affect the workload and backlog issues of the Office. However, as proposed, the proposal did include incompatibility provisions for those Offices where national law was inconsistent with the proposal.

205. The Delegation of Canada supported the PPH and its formal integration into the PCT. The PPH provided significant benefits to applicants and efficiencies to Offices by way of increased first action grants and reduction in the number of reports produced by an examiner. As all PPH applications were examined for compliance with Canadian national law and jurisprudence, the PPH did not affect national sovereignty. The Delegation also agreed with the Delegation of the United States of America that incorporation of the PPH into the PCT did not contravene the PCT. As a medium-sized Office, historically being an Office of second filing, 80 per cent of applications at the Canadian Intellectual Property Office originated through the PCT. Acceleration of a portion these applications that fulfilled the requirements of the PPH could have a large impact on the Office. The Delegation was therefore pleased to see the inclusion of Rules 56*bis*.1(c) and 78*bis*.1(c), where an Office could suspend offering the PPH in response to volumes of workloads. Canada had initial concerns about the PPH causing a large influx of requests, especially bearing in mind the proximity of Canada to the largest filing country in the PCT, and had included suspension clauses in its bilateral agreements. However, any significant influx of requests had not occurred. While the PPH was beneficial to many applicants, not all were interested in expedited examination. The Delegation also preferred an “opt-out” clause to an “opt-in” clause, the former being more consistent with other incompatibility provisions in the PCT. The Delegation also informed the Working Group that the Canadian Intellectual Property Office had entered into the Global PPH pilot.

206. The Delegation of Spain stated that the Spanish Patent and Trademark Office had been offering an optional advanced prosecution procedure outside of the PPH for the past 10 years. This procedure covered about 10 per cent of applications to the benefit of applicants. The PPH had not significantly increased the flow of request for expedited processing, and the Spanish Patent and Trademark Office had increased its participation in the PPH. The Delegation was therefore in favor of the proposal, and preferred the “opt-out” provision as this would integrate the PPH into the PCT as far as possible by making it easier for States to participate.

207. The Delegation of Kenya, speaking on behalf of the African Group, noted that the PPH was being used in a limited manner through a number of bilateral and plurilateral agreements between different countries. The proposal was therefore premature, since it presupposed that all patent Offices had the same capability and expertise to undertake examination, that all patent examiners could evaluate international preliminary reports on patentability from International Authorities, that patent examiners could identify gaps inherent in these reports to undertake further examination to address these gaps, and that designated Offices could suggest amendments to the reports that could be taken on board. In order to meet these conditions, the capabilities and expertise of patent Offices needed to be of a similar level, which was not the case. In order to fulfill these conditions, cooperation could take place through the Committee for Technical Assistance under Article 51, which needed to be brought into operation. Furthermore, expedited national processing in the proposal would require Offices to give preferential treatment to foreign applicants and would impact on flexibilities in national patent systems.

208. The Delegation of Brazil referred to the document presented by the Delegations of the United Kingdom and United States of America to the sixth session of the Working Group in 2013 (document PCT/WG/6/17). Besides presenting an overview of the PPH arrangements and the alleged benefits for the participating Offices, the document included the amendment it deemed necessary in order to operationalize the PPH under PCT Rules. On that occasion, the

Delegation of Brazil commented on the matter, stating that the costs and benefits of such norm-setting activity needed to be fully fleshed out in order to properly consider the integration of the PPH into the PCT. Additionally, the Delegation of Brazil noted that the work done by International Authorities under the PCT had to be examined beforehand, in view of the fact that the quality of their work was an issue of discussion at the PCT Working-Group and that the Reports produced by the Authorities would form the basis of the PPH program under the PCT. Furthermore, the Delegation of Brazil indicated that the integration of the PPH into the PCT could not be the result of a mere administrative amendment, since it amounted to a rather major change in the Treaty and in the procedures of the Offices under the national phase of a PCT application. Indeed, a mere amendment to the Regulations would neither suffice nor be legally adequate for the proposed integration. As a consequence, Brazil did not support the document tabled on that occasion (see paragraph 104 of document PCT/WG/6/24). During that session, some Delegations had expressed support for the proposal. Several others, however, had voiced their concern regarding possible negative effects on the quality of national processing of PCT applications due to accelerated search and examination. Questions had also been raised on whether it would be advisable to introduce the procedure into a system which affected more than 140 Member States based on arrangements negotiated outside the PCT and which were currently in force on a limited basis and membership (see paragraphs 26 and 27 of document PCT/WG/6/23). At the twenty-first session of the Meeting of International Authorities (MIA) under the PCT, held on Tel Aviv from February 11 to February 13, 2014, the United States Patent Office (USPTO) had presented a revised proposal (see document PCT/MIA/21/9). The revised proposal maintained that a mere amendment to the Regulations would suffice and be legally adequate for incorporating the PPH into the PCT. However, the revised proposal had failed to indicate the legal basis for such an amendment under the relevant provisions of the PCT

209. The Delegation continued by referring to the document under discussion, which intended to incorporate the PPH into the most relevant WIPO agreement regarding the processing of applications for acquiring industrial property rights. Therefore, it required to be carefully considered by the Member States, especially in view of the scale of the modifications that Offices from all countries would have to undertake if the proposal were to be adopted. The proponents of the proposal had stated that the PPH's goal was to speed up the examination process by allowing patent examiners to reuse search and examination results done by other Offices. In their assessment of the PPH, however, members needed also to take into account the costs and benefits of the mechanism. In view of the lack of the additional information requested by the Chair of the sixth session of the Working-Group concerning "how the PPH worked for [the Parties], its real effects in terms of expediting applications and the quality of granting of rights" (see paragraph 125 of document PCT/WG/6/24), an overview of the statistics available at Japan Patent Office's dedicated PPH web page – referred to by the proponents in their document – had provided some initial insight, albeit limited, on the implementation of the mechanism. The JPO data showed that participation by members in the PPH was actually very restricted, with only two Offices accounting for 85 per cent of the requests as Offices of First Filing (using national products). These two Offices also amounted to 45 per cent of the requests as Offices of Second Filing (using national products). Considering that the majority of resident applicants filed first at the Office of their countries, it was clear that applicants from these two countries were set to be the main beneficiaries of the fast-tracking granted by the program. It would thus be important to take this fact into account as one considered what the advantages of the PPH might be also from the perspective of other participating countries. Another relevant issue for members to consider was the quality of the work undertaken by the International Authorities under the PCT. The fast-track process provided by PPH programs relied upon the work done by the Authorities. The PCT had a Quality Subgroup that had continuously met and reported to the MIA in order to improve the quality of the work by International Authorities (see Annex II to document PCT/MIA/21/22). Indeed, the reports and suggestions of the Quality Subgroup had provided an important background of information for members to properly evaluate the possible merits and downsides of incorporating the PPH into the PCT. The document under discussion also mentioned the fact that an "opt out" provision

was included in the proposal (see paragraph 17). In this regard, several International Authorities had expressed support for a degree of flexibility for the mechanism during the last MIA (see paragraph 30 of document PCT/WG/7/3), either as an "opt out" or as an "opt in" provision. For Brazil, the "opt out" provision was not fully satisfactory in order to adequately address the issue. The difficulty with the "opt out" provision as suggested by the United States of America and the United Kingdom was that the notice of incompatibility that countries would have to issue would imply a "sense of obligation". Indeed, according to the proposal, an Office that submitted a notice of incompatibility "understands this obligation and is working to amend their national laws to allow them to carry out the said obligation" (see paragraph 20 of document PCT/WG/7/21). In a document circulated at the Meeting of International Authorities, the European Patent Office (EPO) had addressed the matter and had suggested that a degree of flexibility would be needed for the incorporation of the PPH (document PCT/MIA/21/18 Rev.). According to paragraph 9 of this document "certain policy considerations as well as workload concerns related to the number of files that can efficiently be processed in an expedited manner should enable Offices to limit the application of the proposed Rules". Thus, the EPO had proposed that Members be allowed to decide whether or not to participate in a PPH mechanism and to define the specific Authorities whose work products would be eligible to trigger expedited processing of PCT applications. The EPO also raised the issue of the impacts on the workload of Offices that the incorporation of the PPH would implicate. This would be another argument in favor of including provisions that ensured the necessary flexibility for countries to determine if and with whom they would engage in a PPH program. The Delegation of Brazil would tend to concur with such views, especially if one took into account the fact that the majority of PCT Members were currently not part of PPH programs. Additionally, it would be essential to preserve Member States' freedom in terms of deciding if and when – without pre-established commitments – the PPH would enter into force for them. In more general terms, the Brazilian Government was concerned with the fact that the proposal put forth by the United States of America and the United Kingdom and the discussion it has unleashed did not seem to take into due consideration a number of relevant Recommendations of the Development Agenda. For instance, Recommendation 15 clearly applied to this discussion, as it stated that "norm-setting activities shall: be inclusive and member-driven; take into account different levels of development; take into consideration a balance between costs and benefits; be a participatory process, which takes into consideration the interests and priorities of all WIPO Member States and the viewpoints of other stakeholders, including accredited inter-governmental organizations (IGOs) and NGOs; and be in line with the principle of neutrality of the WIPO Secretariat". Likewise, Recommendation 17 stated that "in its activities, including norm-setting, WIPO should take into account the flexibilities in international intellectual property agreements, especially those which are of interest to developing countries and least developed countries". A deeper understanding of the relevant Development Agenda Recommendations would contribute to an approach more conducive to accommodate the sensitivity of all PCT members, taking into account their different backgrounds, level of development and legal practices.

210. The Delegation continued by referring to the question of legality of the proposal, where the discussion regarding the legal necessity of convening a Diplomatic Conference needed to take into account both the relevant provisions of the PCT and their understanding from a legal perspective. First of all, and as stipulated by international law, it should not be forgotten that States had the ability to enter into agreements on matters of their choosing, irrespective of the subject, provided certain rules were respected, for example, Article 103 of the Charter of the United Nations, or *jus cogens* provisions under Article 53 of the Vienna Convention on the Law of Treaties ("Vienna Convention 1969"). If they chose to do so, they became bound by the terms of the treaty and had to perform it in good faith (the principle of the *pacta sunt servanda*, Article 26 of the Vienna Convention 1969). Therefore, parties to an agreement were bound only by the subject-matter covered by it. Furthermore, a general rule of interpretation of treaties prescribed that they "shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose" (Article 31 of the Vienna Convention 1969). Lastly, the modification of a treaty should follow either the procedures established by it or a general rule of amendment of multilateral

agreements (Articles 39 and 40 of the Vienna Convention 1969). Turning back to the proposal under discussion, it was of notice that the Delegations of the United States of America and the United Kingdom had failed to indicate the Articles that could provide the legal basis for the incorporation of the PPH into the PCT by the means of amendments to the Regulations. Specifically, these two Delegations had not described the rationale supporting the view that a mere addition of these two Rules to the PCT Regulations might be the legally adequate procedure for incorporating the PPH into the PCT. Actually, from a legal viewpoint, it would seem that such amendments were not sufficient to provide the adequate legal basis for implementing the proposal. The PCT was structured in such a way that the substantive provisions were placed in the body of the Treaty while the Regulations encompassed the Rules regarding the administrative aspects relating to the activities of the International Bureau, International Searching and Preliminary Examining Authorities, national/regional patent Offices and PCT applicants. In this regard, the Regulations consisted of a set of Rules that might, under certain conditions, be adapted in order to address the needs of the Offices and the users. However, the Regulations were not supposed to replace or otherwise impose itself on the provisions of the Treaty. Thus, it was essential to observe the limits to what could be covered by the Regulations and ensure that the main provisions of the PCT remained in the form of Articles. The incorporation of the PPH into the PCT could not be undertaken simply as a minor matter that could be resolved by means of a modification to the Regulations. This was clearly an issue that would have to be properly based on a provision in the body of the Treaty. Consequently, it was a decision that would require amending the body of the PCT and, therefore, could only be decided in a Diplomatic Conference. Indeed, Article 58 provided the legal basis for the consideration of what could or could not be addressed through the means of mere modifications to the Regulations. According to Article 58, the Regulations annexed to the PCT "provide Rules: (i) concerning matters in respect of which this Treaty expressly refers to the Regulations or expressly provides that they are or shall be prescribed, (ii) concerning any administrative requirements, matters, or procedures, (iii) concerning any details useful in the implementation of the provisions of this Treaty." No Article of the PCT made reference to the PPH or provided that it was or should be prescribed by the Regulations. Therefore, the amendments of the Regulations proposed by the United States of America and the United Kingdom were not allowed under subparagraph (1)(i). With regard to the second and third subparagraphs of Article 58(1), their scope was restricted by their own nature and they actually addressed minor issues necessary for the implementation of the PCT, such as units of weight and measures or the currency in which the schedule of fees was expressed. The language in subparagraph (1)(ii) clearly was not intended to encroach upon the national Offices' autonomy to determine the order of examination of patent applications during the national phase. With regard to subparagraph (1)(iii), it used the wording "details useful in the implementation of the provisions of this Treaty." The incorporation of the PPH into the PCT clearly could not be put on the same level of administrative matters or useful details, as it would actually amount to a major modification in the way the Treaty operated, affecting the activities of every patent Office. In light of the above, it was the firm view of the Delegation of Brazil that the amendments proposed in document PCT/WG/7/21 were *ultra vires* provisions not allowed under the PCT framework.

211. The Delegation of the Republic of Korea stated that it supported the proposal. The Delegation had been contacted by both Korean and foreign user groups, who had considered that, even though the PPH scheme was very successful and useful, they preferred to have a more streamlined and simplified system established. The Delegation did not believe that the PPH scheme affected national sovereignty because, from the experience of the Korean Intellectual Property Office as one of the most active participants in the PPH scheme and from a legal point of view, the examiner was able to take the final decision on an application regardless of what was decided at the International Searching Authority. The Delegation also believed that the proposal provided enough flexibility to address the concerns about Offices who would not be able to participate immediately in the scheme.

212. The Delegation of Portugal stated that the Portuguese Institute of Intellectual Property was supportive of the PPH, was soon going to sign its ninth PPH bilateral agreement, and it was part of the Global PPH pilot. The Delegation was supportive of formal integration of the PPH into the PCT system, which would be a benefit for both the Portuguese Institute of Intellectual Property and national applicants. Regarding possible dramatic rises in the workload due to the PPH, the Delegation was not concerned because it did not have any backlogs, but for countries where Offices had elevated backlogs, the suspension clause was believed to be sufficient. Nor did the PPH affect national sovereignty. The international work products provided an immense aid in the examination of patent applications, but the examiner was always free to disagree with the results and to do another search if deemed necessary. Moreover, examiners at the Portuguese Institute of Intellectual Property did sometimes need to provide additional search in internal databases because there could be some Portuguese documents that were state of the art and that could possibly be missed by the international search due to language barriers. The Delegation therefore agreed with the proposals in the document.

213. The Delegation of India reiterated its concerns it had previously expressed on the formal integration of the PPH into the PCT, pointing out the differences in patent law and practices across jurisdictions, adding that patent law was specific to a country and that the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement) allowed for certain flexibilities. With this in mind, the proposal to integrate the PPH into the PCT could be perceived to be an attempt to harmonize the examination of patent applications in different countries by encouraging the reuse of work done in the international phase without undertaking further examination of the application in the national phase, as one aim of the proposal was to accelerate the examination process and reduce pendency. This could therefore be perceived as an attempt to suppress the uses of flexibilities provided under the TRIPS Agreement. Further, Member States needed to keep in mind the relevance of the Development Agenda recommendations, which encouraged this kind of harmonization and normative agenda only after having the confidence of all Member States, developed as well as developing and the least developed countries, in their technical capabilities to have such a process to be undertaken in this Organization under any Committee or Working Group. The aim of the PCT was to facilitate the filing of a patent application by assisting an applicant seeking protection in multiple jurisdictions to decide whether to pursue an application at a national level based on the international search report and international preliminary report on patentability. Therefore, the PCT had no mandate to interfere in the examination procedure for the grant of patent in the national phase. Moreover, the reduction of backlogs in Offices by avoiding duplication of search and examination of patent applications and expediting the grant of applications in the national phase was not a stated objective of the PCT. The Delegation therefore believed that the proposal was beyond the objectives of the PCT. Moreover, Indian patent law prescribed that the examination of applications should take place in the order in which the requests for examinations were filed, so to allow exceptions to this rule would require amendments to national law. Furthermore, granting patents hastily by accelerating the examination process and reducing the pendency times undermined the examination procedure followed in the national Offices, which could also affect the quality of the granted patents. Therefore, the Delegation did not support the proposal to amend the Regulations to enable formal integration of the PPH into the PCT. Any such amendment would require a Diplomatic Conference to be convened, as clearly pointed out by the Delegation of Brazil.

214. The Delegation of Iran (Islamic Republic of) stated that it was not able to support the proposal for formal integration of the PPH into the PCT and pointed out some legal and procedural ambiguities in the proposal. First, the PCT was a procedural treaty, and the result of any reform should be conformed to the procedural matters and not lead to the harmonization of national search and examination procedures. Second, the PCT was concluded as a non-binding treaty in the national patent Offices with regard to the international search and examination reports. The incorporation of PPH into the PCT would make national Offices rely exclusively on international reports. Taking into account the diversity of the legal frameworks and the resources of patent Offices in developed and developing countries, the integration of

PPH with the PCT system could undermine the autonomy of national Offices to conduct a comprehensive search and examination to ascertain that a patent application met the substantive requirements of its national law. Third, the integration of PPH into the PCT was a substantive and fundamental change in the nature of PCT and the possible amendments would have impact on the IP Offices in terms of costs, in particular relating to human and technology resources. The calling of a Diplomatic Conference would therefore be needed for the modification of the PCT in accordance with Article 60 of the Treaty. Moreover, the proposal would challenge the legal structure and nature of the PCT system, setting binding rules on national Offices and could particularly impair the functions of the patent Offices in developing countries.

215. The Delegation of Egypt, speaking on behalf of the Development Agenda Group, reserved its position on the proposal in order to pursue further discussions with experts within the membership of the Development Agenda Group. The Development Agenda Group understood that WIPO, as the specialized UN agency for intellectual property, was the appropriate forum for discussing topics related to patent cooperation, as it possessed the necessary requirements of technical expertise and legitimacy to carry out debate with a proper technical background. In this regard, the proposal had the merit of stimulating discussion and sharing of experiences in the PPH programs by national Offices within the framework of bilateral agreements. The Group considered that the debate and the experience drawn from PPH programs were relatively incipient in terms of fostering discussions on absorption by an international instrument. These discussions needed to take into account the positions of all Member States and the technical and legal resources that governed the patent Offices in developing countries, irrespective of whether or not their Offices acted as an International Searching or Preliminary Examining Authority under the PCT. The Development Agenda Group also believed that the process of discussion should be guided by the relevant Development Agenda Recommendations, in particular, Recommendation 15. Furthermore, the mere amendment of the PCT Regulations would not be a legally possible way forward for a proposed merger of the PCT and the PPH, since the proposed amendment would substantively affect the activities of Offices in the national phase, whose dynamics were not a matter to be dealt with by the PCT. This meant that the incorporation of the PPH into the PCT would amount to a fundamental change in the Treaty and thus the proposed attempt would make it necessary to call for a Diplomatic Conference to be convened, in line with the procedure laid down in Article 60.

216. The Delegation of South Africa supported the statements made by the Delegation of Kenya on behalf of the African Group, the Delegation of Egypt on behalf of the Development Agenda Group, and the Delegations of Brazil and India. The Delegation reminded the Working Group that the PPH was a set of bilateral agreements among Offices which wished to provide for the expedited processing at a national level. Formal integration of the PPH into the PCT would have an overbearing effect on national Offices, with implications for resident applicants. The PCT system should have minimal impact on the national processing by Contracting States, yet the present proposal used mandatory language requiring designated and elected Offices to offer expedited processing of an application at the option of the applicant. The proposal therefore went against the essence of the PCT system. Furthermore, South Africa was in no position to make use of such incorporation of the PPH into the PCT nor was South Africa ready to participate effectively in such development, as this would lead to harmonization of international patent law. With this in mind, the Delegation wished to caution against the linkage between the national and international phase, especially with regard to the provisions which would affect the manner of national phase processing.

217. The Delegation of China supported the proposal to integrate the PPH into the PCT and stated that it was beneficial for national Offices to deepen cooperation and optimize review mechanisms. Full utilization of international work products in national phase should therefore be encouraged so as to offer applicants a service with greater efficiency and high quality even though the procedure at the national phase should be prescribed in national laws.

218. The Delegation of Ecuador supported the statements made by the Delegation of Kenya on behalf of the African Group, the Delegation of Egypt on behalf of the Development Agenda Group, and the Delegations of Brazil and India. The use of the PPH should remain a choice for Offices and if the PPH were integrated into the PCT, a Diplomatic Conference would need to be convened.

219. The Delegation of Switzerland supported the formal integration of PPH in the PCT as proposed in the document, as it would provide useful advantages for applicants and for Offices, allowing the possibility to avoid the multiplicity of bilateral agreements by creating a single platform within PCT, which would make work more transparent. The current proposal, which had been revised from the previous session of the Working Group, provided the necessary flexibility for PCT Member States to decide whether or not to choose an accelerated process at the national level as a function of their national circumstances. In view of its national legislation, Switzerland would be unable to pursue such an accelerated system. However, it would use the flexibilities provided in Rules 52*bis*.1(b) and 78*bis*.1(b), where an “opt-in” provisions would be preferable, as this would respond better to the concerns of countries that were more reticent to participate in the scheme. The Delegation found it difficult to understand the fears and reasons expressed by some delegations, which would lead the Working Group to delaying the decision to integrate the PPH in the PCT, since it believed that it was a useful opportunity for all Member States of the PCT to have the possibility of accelerated treatment of applications, currently only available in countries that were party to PPH agreements. The proposal did not affect the sovereignty of PCT Member States as to the granting of patents, since the examination and the final decision remained with the examiner; what was proposed was simply to take into account the results of international search, which would be useful for national examiners. As to difficulties encountered with an excessive burden of work caused by PPH requests, Member States could request the suspension of the accelerated procedure for a certain period to alleviate any problems. The introduction of such an accelerated procedure did not in any way change the nature or the goals of the PCT and could be undertaken by modification of the Regulations and Administrative Instructions, as proposed. Finally, in response to the remarks of some other delegations, the Delegation believed that the proposal was fully acceptable from the point of view of the Development Agenda. For these reasons, the Delegation fully supported the proposal, which would make the PCT more attractive for applicants in all Member States, not only those in countries that were part of existing PPH agreements.

220. The Delegation of Chile stated that it continued to follow discussions on the issue of integration of the PPH into the PCT to consider the possible benefits it would provide, which would allow it to have a better understanding of the proposal.

221. The Delegation of the Russian Federation believed that the proposal was beneficial for both developed and developing countries. It was also flexible, as it allowed Offices not to take part where it was incompatible with national laws or there were issues of resources. In the opinion of the Delegation, the modifications to the Regulations did not lead to harmonization, but instead had the purpose of reducing workload in Offices. Finally, although it was true that the PPH was not referred to the PCT, it did not contradict the spirit of the Treaty, which aimed to reduce workload for national Offices and facilitate the process of obtaining patent protection from the point of view of applicants, who were interested in reducing pendency times. In terms of the incompatibility subparagraph, the Delegation expressed a preference for an “opt-in” provision to allow an Office to offer expedited processing and examination.

222. The Delegation of Denmark supported the proposal for formal integration of the PPH into the PCT. The Danish Patent and Trademark Office had been participating in the Patent Prosecution Highway since 2008 and also participated in the Global PPH pilot, and had a positive experience of the PPH. Users in Denmark had also been satisfied with the PPH arrangements. The Delegation did not consider the PPH to affect national sovereignty, as it did not provide for automatic or mandatory grant of patent. Instead, the final determination of whether a patent right was granted was left to the national and regional Office concerned. Nor

did the Delegation perceive a problem with Recommendation 15 of the Development Agenda. The PPH was an administrative arrangement where an examiner in one Office could access the work from another Office that had examined an equivalent application and therefore began from a more informed level, making the examination more efficient. This would also lead to increased quality, as the subsequent examiner could do no worse than the first examiner, as he would have all the citations from the first examiner provided to him. Denmark did not need to amend its national law to become part of PPH agreements, and the Delegation did not consider this was the case for the PCT, for example by virtue of Article 58. The Delegation believed that applicants from Member States not participating in PPH programs should not be excluded from the benefits of the PPH, and the flexibilities in the proposal took into account many of the concerns and reservations expressed by some other Member States.

223. The Delegation of the United States of America, responding to the comments made by delegations, stated that did not see any merit in the assertion that the integration of the PPH into the PCT by amendment of the Regulations and Administrative Instructions would be *ultra vires*. Reciting the preamble to the Treaty “the Contracting States, desiring to make a contribution to the progress of science and technology, desiring to perfect the legal protection of inventions, desiring to simplify and render more economical the obtaining of protection for inventions where protection is sought in several countries, ... and convinced that cooperation among the nations will greatly facilitate the attainment of these aims, have concluded the present Treaty”, the Delegation believed that the proposal appeared to be within the desired goals of the Treaty contemplated when it was drafted. In addition, Article 23 provided that “any designated Office may, on the express request of the applicant, process or examine the international application at any time.” This was a fundamental principle of the Patent Prosecution Highway. Moreover, Article 58, which stated that “the Regulations annexed to this Treaty provide Rules ... concerning any administrative requirements, matters or procedures, and concerning any details useful in the implementation of the provisions of this Treaty”, appeared to provide ample support for drafting Regulations that would incorporate the PPH into the PCT. While no Article of the PCT made reference to the PPH or provided that it should be prescribed by the Regulations, other recent improvements to the PCT, such as incorporation by reference and restoration of priority, were likewise not mentioned in the PCT, but were not considered to be *ultra vires*. As pointed out by several delegations, Offices were free to apply their national law during their examination and in no way were obligated to accept the results of the prior search. The proposal therefore did not impinge on any national rights. The Delegation considered it unfortunate that the proposal did not meet with consensus at this session of the Working Group, even more so for applicants seeking protecting on emerging technologies that would not be able to take advantage of the PPH program in certain regions and could thus find it difficult to access markets for technologies with a short shelf life, because of backlogs in some IP Offices, without any mechanism for obtaining patent protection quickly. In terms of comments from delegations about the need to perform a cost-benefit analysis, the Delegation agreed with the comments of the Delegation of Denmark that benefits could be discovered through practical experience. The Delegation of the United States of America therefore suggested that Offices that needed to weigh up the costs and benefits of the PPH more closely before agreeing to the proposal should become involved by trialing a limited term bilateral pilot to see the effect of the PPH on its Office and applicants. In this regard, the Delegation was willing to discuss the PPH further with any interested Office. Furthermore, in terms of the flexibility of the proposal, it was important to bear in mind that no Office was required to participate, and those which did could suspend expedited treatment if their Office became overwhelmed with requests for acceleration.

224. The Chair summarized interventions from Member States by acknowledging that opinions in the Working Group were divided on the proposal, with no clear consensus on how to take the proposal forward. Delegations whose countries were part of existing PPH agreements were in favor of the proposal, but many other delegations did not support the proposal and had cited a number of concerns. The Chair considered it reassuring that countries with PPH arrangements in place found them to be efficient and useful, and their Offices had not been overburdened with

requests for expedited examination, but instead received a small number of requests from applicants who were keen to have their patent applications examined and accepted quickly. Some serious concerns had, however, been cited concerning the legality of making changes to the Regulations, the capacity of Offices to deal with PPH work, and whether the proposal amounted to erosion of national sovereignty and harmonization by stealth. On the final point, the Chair continued to be bemused that certain delegations did not believe this to be case, whereas others continued to raise this point. The Chair reminded the Working Group that an international search report, whether accompanied by a PPH request or not, was studied by an examiner who could use the report to the maximum extent possible to conduct work efficiently and effectively to ensure that poor quality patents were not being granted. This was what the PCT was created for. Some delegations had pointed out the integration of the PPH into the PCT would not fit with their national law, where the Chair pointed to the flexibilities provided in the proposal.

225. The Representative of the Japanese Intellectual Property Association (JIPA) supported the integration of the PPH into the PCT. Although Sections 902 and 903 of the Administrative Instructions provided flexibilities in requirements demanded by designated and elected Offices, the Representative hoped that there would be minimal variations in these requirements between Member States. If this were not possible, the Representative suggested summarizing the differences and publishing them, whether on the PPH portal web site or in information provided by the International Bureau like the Applicants' Guide.

226. The Representative of the International Federation of Industrial Property Attorneys (FICPI) believed that the proposal would be beneficial to users. With an increasing number of International Authorities, even users of small countries could make use of the proposal. In this regard, the Representative cited the experience in his home country, Sweden, where the IP Office was an International Authority but it remained difficult and time-consuming to prosecute applications in many countries, even where the International Searching or Preliminary Examining Authority had produced a positive report on patentability.

227. The Representative of Third World Network (TWN) expressed support for the statement made by the Delegation of Brazil, which had raised a number of pertinent issues with respect to the legal standing of the proposed amendments to the Regulations. The PPH would effectively make an applicant who would otherwise be number 100 in the queue jump the queue to become number one. This would pressurize the examiner to dispose of the application faster, so that others in the line were not too aggrieved. This pressure to act fast created by the PPH could compromise search and examination quality and thus also undermine TRIPS flexibilities with regard to nationally-determined scope of patents. In effect, particularly for patent examiners from developing countries with limited examination capacity, that would be disproportionate to the number of applications to be processed. The PPH also had the potential to lead to substantive harmonization in practice. It could also lead to the discrimination of patent applications originating at the national level. In this context, the PPH could effectively make international search and examination reports more binding and require Offices to process applications out of turn, if not grant applications on the basis of international reports. Although a number of Delegations who supported the proposal had received only a small proportion of applications through the PPH route, it was important to consider the implications of potential escalations in PPH filings over the long-term while undertaking amendments to the Treaty or Regulations. In this context, TWN also noted that the PCT system was essentially a non-binding system and that it should have minimal impact on the policy autonomy of Contracting States with regard to the examination of patent applications. This policy autonomy would include the freedom to determine whether out of turn processing of applications should be allowed or not. In conclusion, noting the comments made by the Delegation of Brazil that there was no legal basis in the PCT for the integration of PPH, the Representative underlined that most national laws, particularly of developing countries, were similar in that way and did not provide any basis for compatibility of the PPH and would therefore require legislative amendments.

228. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) supported the proposal and agreed with remarks made by the Representative of the International Federation of Industrial Property Attorneys (FICPI). Whether formal integration of the PPH into the PCT took place, the Representative hoped that designated Office would proceed with accelerated examination if the applicant requested it when accompanied by a positive opinion from the International Searching Authority.

229. The Representative of American Intellectual Property Law Association (AIPLA) supported the remarks made by the Delegation of the United States of America and indicated that it would submit comments on the proposal in writing.

230. There was no consensus in the Working Group to take this proposal forward at this stage.

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

231. Discussions were based on document PCT/WG/7/27.

232. The Delegation of the Republic of Korea introduced the document, which had been based on earlier proposals submitted in document PCT/MIA/21/19 titled "PCT 3.0", discussed at the Meeting of International Authorities in 2014. Workload had been a major concern of many International Authorities. As pendency periods before the first action or search by national Offices were shortening, more and more first action search results and classification results were becoming available before the time of international search. However, until now there had not been a procedure to share search and classification results of the Office of first filing with the International Searching Authority. Therefore, the document proposed amendments to the Regulations to require the receiving Office which was usually the Office of the first filing, to transmit the search results to the International Searching Authority when it sent the search copy. At least a list of prior art found from the earlier search should be included in the transmitted search results, but it would be appropriate to leave flexibility on further information beyond that list. In terms of flexibility, the Delegation was aware that there may be national laws preventing receiving Offices from transmitting such information, in particular due to confidentiality requirements. Therefore, the proposal specified that transmission of search or classification results should only be required when not prevented by national laws. Under the proposal, International Searching Authorities would be able to reduce their workload by avoiding duplicated work and consistency between the results at international and national phases would be greatly increased.

233. The Delegation of the United States of America supported the goal of the proposal, as it related to increased cooperation and work sharing. This was exactly the type of cooperation envisioned by the creation of systems like the Global Dossier, the common citation document, and even the PCT itself. It had to be noted, however, that the confidentiality requirements that were imposed by national law in the United States of America had been interpreted to preclude the furnishing of information, such as a list of prior art cited in an unpublished application. It was therefore doubtful that the United States Patent and Trademark Office (USPTO) would be able to provide the information indicated in the proposal for unpublished applications, at least at this time. The USPTO had similar statutory restraints on its ability to furnish information such as the classification of an unpublished application. It should be noted that, on receipt of an international application, regardless of whether or not the USPTO was the International Searching Authority, the receiving Office gave a preliminary classification to each application. This classification was often the same as that of the earlier application and could be shared by the USPTO, since it would not be subject to the same confidentiality requirements that had been placed on the earlier national application. The Delegation therefore suggested that the proposal could be modified to provide for situations where the receiving Office was unable to provide the classification of the earlier application but a classification had been assigned to the international application, this could be transmitted by the receiving Office.

234. The Delegation of the United Kingdom supported the proposal as it would help raise quality and reduce duplication of work. However, it would only be able to share search reports before publication of an application with the consent of the applicant, as required under its national law. The Delegation also asked for clarification about what was referred to by “search results and/or classification results which have not been prepared by the receiving Office but which are at the disposal of that Office” in the proposed Rule 23*bis*.1(b).

235. The Delegation of Israel supported the proposal in principle to establish an Office-driven work sharing program between national Offices and International Searching Authorities in which a receiving Office, if available at the time of transmitting a search copy of the international application to the ISA, would submit also the copy of the search and/or examination results on the domestic national application together with the International Patent Classification codes. It would also be beneficial to have an Office-initiated program to exchange work products, so that the International Searching Authority as the Office of later examination could use the result of the receiving Office as the Office of earlier examination, to avoid duplication of work. However, the practical and technical aspects of the proposals needed to be analyzed in greater depth, for example, the issue of translation of search and examination results.

236. The Delegation of Japan commented that the proposal introduced a PCT Rule which did not conflict with the national laws of receiving Offices by establishing a system under which receiving Offices would be required to provide to the International Searching Authorities earlier search and classification results from applications that formed the basis of priority claims for international applications. The proposal could lead to promoting work sharing based on the linkage established between the national and international phases. However, based on this proposal, which called for receiving Offices to send search results to the International Searching Authorities, it created other issues that needed to be considered, such as the increased workload it would impose on receiving Offices, its cost effectiveness, problems with IT systems and language issues. Further discussion of these matters was therefore needed before adopting the proposed new PCT Rule.

237. The Delegation of Spain supported the proposal and indicated that its legislation would allow exchange of information between its receiving Office and the two competent International Searching Authorities for Spanish applicants, namely the Spanish Patent and Trademark Office and the European Patent Office. Furthermore, Article 41 of the European Patent Convention permitted the exchange of the necessary documentation.

238. The Delegation of Australia considered there to be value in discussing the transmittal of search results to the International Searching Authority by the receiving Office and agreed that the sharing of information between Offices had the potential to improve quality and consistency of the international search. While the search results themselves would be useful, the Delegation invited Member States to consider how the proposal could be improved to provide even greater benefits for International Searching Authorities. The Delegation believed that the greatest value from this proposal would be realized if the receiving Office provided its full search information to the International Searching Authority and not just the results of the search. This provided a practical example of the value of search strategy information as the Working Group had discussed in the PCT 20/20 proposals. Where only search results were provided to the International Searching Authority, it would not know how those documents were found or what search techniques were used. As a result, in order to fulfill the requirements of the PCT, the International Searching Authority would have to perform a full search from scratch and they might well find the same documents again. This was duplication of effort and should be avoided. On the other hand, if the full search strategy information were provided, the International Searching Authority would know what was searched and would not have to repeat work that had already been done. Instead it would be able to conduct a narrow focused search with high confidence of finding the best prior art. Australia therefore believed that sharing full search strategies would have the maximum effect of driving efficiencies and reducing backlogs

for International Searching Authorities. In relation to the specific provisions of Rule 23*bis*, the Delegation expressed interest in gaining an understanding of how the procedure would operate with the implementation of eSearchCopy.

239. The Delegation of India stated that it understood this proposal to be an attempt to build trust through work sharing under the PCT system, but was of the view that under the present Rule 4.12, if the applicant wished the International Searching Authority to take into account the results of an earlier international-type or international search carried out by the same or another International Searching Authority or by a national Office, the applicant could indicate this in the request. Therefore, the Delegation considered that instead of placing the responsibility on the receiving Office to transmit the search and/or classification results already prepared by that Office on one or more earlier applications on which a priority claim for the international application was based, the option should be left open to the applicant to indicate the same in the request. Further, Indian patent law did not allow any application to be made open to the public until 18 months from the priority date. Although an applicant could file the request for examination, the examination would commence only after the publication of the application. Normally, the international search reports were required to be completed around the sixteenth month from the priority date. Therefore search results in most cases would not be available in time to be of use to the International Searching Authority in establishing the international search report, as the receiving Office would not be able to provide the earlier search reports before expiry of 18 months. Furthermore, Rule 4.12 did not specifically address the issue relating to classification results already prepared by that Office, which would generally be available if the application were open to the public in view of the specialized and efficient databases used by International Searching Authorities. Under such circumstances, the Delegation felt that the responsibility to transmit results should not be placed on the receiving Office, as proposed in the document. Furthermore, the proposed rules did not clearly state whether the International Searching Authority should be required to take into account such results. Therefore, further discussion on this proposal was required.

240. The Delegation of Canada supported the idea of providing International Searching Authorities with all possible information to help facilitate search and examination. The Delegation agreed with intervention by the Delegation of Japan that more time was required to assess the amount of extra work for receiving Offices and what IT system changes would be necessary. In many instances, the receiving Office and the national Office which conducted the search on the priority application were not the same; in these cases, the receiving Office would not be able to transmit this information. The Delegation also partly shared the concerns expressed by the Delegation of India. While the Delegation of Canada did not feel that the provision should be limited to applicants, it believed that the receiving Office should be required to provide this information, but wondered how this could be integrated with Rule 4.12. Finally, the Delegation supported the intervention of the Delegation of Australia regarding minimizing duplication of work and the possibility of sharing not only the search results, but the full search strategy as well.

241. The Delegation of Portugal agreed with this proposal as sharing information was important for increasing quality and preventing duplication of work. The Portuguese Institute of Intellectual Property already published every written opinion, search report and classification with the patent application at 18 months from the priority date, but as the search report and opinion were completed a few months earlier, it was possible to provide this to the International Searching Authority at an earlier stage. Finally, the Delegation supported the intervention by the Delegation of Australia regarding minimizing duplication of work and the possibility of sharing not only search results but the full search strategy as well.

242. The Delegation of the Russian Federation supported this proposal, but had the problem that, in many cases, the applicant would have to be contacted to obtain consent in order to transmit search results and classification results before publication. The Delegation therefore suggested that the Rule could be modified to state that transmission should be effected on the initiative of the applicant.

243. The Delegation of the European Patent Office emphasized that the proposal aimed to help International Searching Authorities to perform timely high quality work expected from them by the receiving Offices which had selected them as their competent International Searching Authorities. Receiving Offices would be required to transmit any earlier search results or classifications results available to them at the time of transmission of the search copy to the International Searching Authority. In response to the query by the Delegation of the United Kingdom, Rule 23*bis*.1(b) aimed to cover search or classification results from an Office other than the receiving Office where transmission to the competent International Searching Authority was possible. Regarding the comments from the Delegation of Japan on workload and effectiveness, the Delegation believed that the proposal could be implemented in a straightforward and streamlined fashion by adding the search results and classification details to the application package that was sent by the receiving Office to the International Searching Authority, without much further development in IT systems being required. In terms of effectiveness, it was for the International Searching Authority to decide whether to take note of the results. The Delegation also acknowledged the comments made by the Delegations of India and Canada regarding Rule 4.12. The proposed Rule 23*bis* aimed at cooperation between two Offices rather than an applicant-driven exercise, such as under Rule 4.12, which had now been in force for several years. The objective of the proposed rule was simply to automatize, whenever possible, and put into action a proper cooperation between Offices without putting the burden on applicants to have to send any documents themselves to the International Searching Authorities when requested. The provision in Rule 4.12 would nevertheless be needed in the sense that the proposed Rule 23*bis* would cover only those cases where the national rule did not forbid the transmittal of such information. The Delegation acknowledged that many national laws still required applicant consent to share information with other Offices before publication. Therefore, in those cases applicants would still have the possibility to use Rule 4.12 for that matter.

244. The Chair clarified the point that had been raised by the Delegation of Israel regarding translation by indicating that the proposal implied that the search results would be transmitted in whatever language they were available. It would be for the International Searching Authority to perform any translation, but this could be minimal as the documents from the search report should be identifiable.

245. The Delegation of the Republic of Korea clarified that the issue of applicant consent was covered in paragraph 8 of the document, where it stated that the receiving Office would not be required to transmit information when consent from the applicant was needed under national laws. As for concerns about workload and IT systems, the Delegation believed that there would be an increase in work for the receiving Office, but this would be outweighed by the potential benefits for International Searching Authorities and users. Some other delegations had also pointed out that they did not have search results available before publication and the proposal made it clear that receiving Offices would only be requested to transmit search results that were available to it.

246. The Chair concluded that the Working Group could see the value of passing on search results where they were available, but there were issues that required resolving which required further consultation with Member States. The Chair therefore invited the Delegation of the Republic of Korea and the European Patent Office to consult with Member States with a view to retuning to this proposal at the next session of the Working Group.

247. The Working Group invited the European Patent Office and the Delegation of the Republic of Korea to continue discussions with interested parties, with the aim of bringing a refined proposal to the next session of the Working Group.

#### **NON-PATENT LITERATURE UNDER THE PCT MINIMUM DOCUMENTATION**

248. Discussions were based on document PCT/WG/7/28.

249. The Delegation of India recalled that the International Bureau had presented document PCT/WG/6/9 to the sixth session of the Working Group, which set forth issues under consideration by a Task Force set up to prepare a draft of technical specifications relating to a proposal to amend Rule 34 to provide the right for any Contracting State to have the patent documentation published by its national Office included as part of the PCT minimum documentation, provided that it was made available reliably in a specified electronic format which was easy for International Authorities to load into their databases. In the Meeting of International Authorities held in Tel Aviv in February this year, the issue of formatting of information contained in the patent literature and the minimum documentation had also been considered for improving the quality of the information. However, with reference to the non-patent literature part of the PCT minimum documentation, the present list comprised literature of particular importance not only for International Authorities but also for national Offices, but the list had been developed at a time when searching was done through paper journals. Since that time, technology had advanced, but the list had retained the same character and format. It was therefore difficult to conduct an efficient search through non-patent literature if the data had not been ascribed to a specified format. The Delegation therefore requested that the principle of a specified electronic format that was being followed with respect to the patent part of the PCT minimum documentation should also be extended to the non-patent literature part. However, it was appreciated that there might be difficulties in arriving at one standard predefined format for non-patent literature, as the requirements of the Authorities and Offices might be different. In addition, the publishers might not be in a position to cater for the specific format, so there could be a certain degree of freedom to Authorities, Offices and publishers. The Indian Patent Office believed that the issue of access to non-patent literature could not be ignored, as it was critical to the quality of patents. Therefore, to encourage publishers to respond to the requirements of Authorities and Offices, providing access in accordance with a standardized format could be made a prerequisite for inclusion in the PCT minimum documentation. However, journals of publishers who did not provide access in accordance with the format would not be excluded from search as Authorities and Offices would retain the freedom to search any material. However, the status of belonging to the PCT minimum documentation should not be available for such journals. The Delegation recognized that Authorities and national Offices had different requirements and therefore proposed that the Working Group recommend to the Assembly of the PCT Union that the Committee for Technical Cooperation consider this matter, if appropriate in coordination with the Meeting of International Authorities, considering the needs of the Authorities and Offices and the limitations of publishers at their next session, and make proposals for discussion by the Working Group at its next session, regarding a standard format or formats in which a publisher should be willing to provide data to the International Authorities and national Offices before a title could be considered for inclusion in the PCT minimum documentation. Also, the Committee could identify the publishers who were willing to provide data in their proposed formats. A certain level of standardization would enable the International Authorities and Offices to accordingly invest in electronic systems and further contribute in enhancing the quality of examination. Alternatively, the issue could be referred to the Task Force set up to prepare a detailed draft of all the technical specifications relating to the proposal to amend PCT Rule 34. The Delegation concluded by informing the Working Group that the proposal was in conformity with Development Agenda Recommendation 8 "Request WIPO to develop agreements with research institutions and with private enterprises with a view to facilitating the national Offices of developing countries, especially least developed countries, as well as their regional and sub-regional intellectual property organizations to access specialized databases for the purposes of patent searches", and Recommendation 10 "To assist Member

States to develop and improve national intellectual property institutional capacity through further development of infrastructure and other facilities with a view to making national intellectual property institutions more efficient and promote fair balance between intellectual property protection and the public interest. This technical assistance should also be extended to sub-regional and regional organizations dealing with intellectual property”.

250. The Delegation of Iran (Islamic Republic of) supported the proposal in the document, which would provide an effective manner to enable accession to non-patent literature, was aligned with the WIPO development programs to facilitate national Offices of developing countries with access to specialized databases, and promoted balance between private rights and the public interest.

251. The Delegation of the United States of America preferred any further review of the proposal to take place in the context of the PCT minimum documentation task force, as proposed in paragraph 10 of the document. The Delegation did, however, question whether publishers would make the effort and incur additional expense merely for inclusion of their journals in the PCT minimum documentation, and whether it would be desirable to exclude useful documents that might not comply with the format from the PCT minimum documentation.

252. The Delegation of the European Patent Office was of the opinion that it was desirable to have consensus on technical standards for non-patent literature. However, the Delegation believed that adherence to such a standard by publishers should not be a condition for the inclusion of a scientific journal in the PCT minimum documentation. The journals currently listed in the non-patent literature part of the minimum documentations belonged to 30 different publishers, and it seemed unlikely that all of them would agree to such a standard, given that each had their own requirements. Technical documents should therefore be included in the minimum documentation based purely on technical merit and reference to prior art searching. The Delegation reminded the Working Group that the format of citing non-patent literature was being examined by a Task Force set up to revise WIPO Standard ST.14, where the European Patent Office had provided a study to compare ST.14 with International Standard ISO 690:2010. It needed to be borne in mind that the common standards were widely used by libraries, museums, and others and the European Patent Office believed there was a solid basis of progress in this issue without compelling publishers to adhere to standards they might not necessarily want. In addition to this line of thinking, it was not just the common standards that publishers provided; it was also the standards used by examiners when citing NPL which was important. Currently, the most valuable tool for analyzing patent citations was PATSTAT, which gave documents unique identifiers. This was not necessarily always the case with non-patent literature, where different entries for the same publisher existed. For example, you could have a document cited under the Journal of General Virology or J. Gen. Virol or JGV. This made it difficult for Offices and the International Bureau to assess what non-patent literature was being used by examiners at various Offices and made the situation difficult when we came to review the minimum documentation for non-patent literature. In the opinion of the European Patent Office, publishers were not the only consideration which needed to be borne in mind in these discussions.

253. The Delegation of Japan believed that there was great merit in using commercial databases for conducting prior art searches of non-patent literature designated as PCT minimum documentation. That was because commercial databases were constantly being updated to include new documents and they were also regularly viewed in order to seek ways to enhance their search functions. Therefore, the Delegation was not able to commit itself to storing any non-patent literature from the PCT minimum documentation on the Japan Patent Office in-house databases. The Delegation was, however, always interested in procuring non-patent literature documents and working to improve search efficiency and was interested in being informed of future discussions on this subject.

254. The Representative of Third World Network (TWN) supported the proposal from the Delegation of India on non-patent literature under the PCT minimum documentation. The proposal aimed to ensure that Offices had access to non-patent literature that was included in the PCT minimum documentation, which would enable Offices to carry out the high quality search for prior art and thereby also enhancing the quality of granted patents. By approving this proposal, the Working Group would send a positive signal with respect to the mainstreaming of implementation of the Development Agenda in its work, as this proposal was firmly anchored on both Recommendations 8 and 10, as already has been outlined by the Delegation of India.

255. The Delegation of India, in response to the comments made by delegations on the proposal, understood the concerns of publishers to adopt one fixed format. The proposal therefore showed flexibility in this regard, which could be helpful for International Searching Authorities in developing countries. The Delegation intended to improve on the proposal based on the comments received and further consultation with other delegations, if required, in order to present a proposal to the next session of the Working Group.

256. The Delegation of Ecuador stated that access to non-patent literature was a critical part of examination of patents, and commented on the need for support from WIPO in order to establish a mechanism which would allow the authors of scientific documents to assist its Office. An in-depth analysis was therefore required in order to have scientific databases which would provide support and assistance to examiners in developing countries.

257. The Delegation of Brazil indicated willingness to participate in consultations with the Delegation of India, which could address the concerns raised by other delegations on the proposal.

258. The Delegation of Kenya, speaking on behalf of the African Group, expressed its support for the proposal and looked forward to its discussion at the next session of the Working Group.

259. The Working Group invited the Delegation of India to continue discussions with interested parties, with the aim of bringing a refined proposal to the next session of the Working Group.

### **THIRD PARTY OBSERVATIONS**

260. Discussions were based on document PCT/WG/7/11.

261. The Secretariat stated that the third party observations system had been in operation since July 2012. In accordance with expectations and in line with the use of national third-party observation systems, it had been used for a significant but small proportion of the total number of international applications. Eighty per cent of the observations had been made anonymously, which had been shown to be an important feature in allowing third-parties to feel able to participate. Initial fears for potential abuse had not been realized, with only a small number of observations being rejected as not meeting the requirements of the system. None of these rejections had been related to matters which could be considered as deliberate abuse of the system. In general, observations were focused, containing a small number of documents which were presumably considered highly relevant by the third party and very few contained the maximum ten citations allowed in a single observation. Very few international applications had been the subject of more than one observation, and none of them had been the subject of more than three observations. The system had been very useful in bringing non-patent literature to the attention of examiners. Thirty-six per cent of the citations made were non-patent literature, among which the largest group was periodical articles, but a significant number were documents which would be very unlikely to be available to examiners through conventional searching. The system had been used for a wide range of technical fields with three subclasses, CO7D, A61K and AO1N, being subject to the largest numbers. A large proportion of observations had been made in the twenty-eighth month from the priority date. This gave a very limited amount of time for applicants to consider whether still to enter the international phase as a result of the

information that they had received. Nevertheless, the International Bureau considered the balance to be reasonable for the moment. Very few national Offices had any meaningful experience of the observations in national phase processing, since the applications concerned had mainly not yet started national examination. The true effectiveness of the system remained to be evaluated. The International Bureau also had some concerns over whether the observations would reliably be brought to the examiners' attention in all designated Offices. Given the small number of observations, this item had not been a high priority for Offices to set up automated systems for retrieval and incorporation into the national examination file. Nevertheless, the International Bureau planned to work with interested Offices to improve the opportunities which were available for automation. For the present, the main recommendations which the International Bureau wanted to make were to relax two of the restrictions within the system. Firstly, the 500 character per cited document brief explanation of relevance was too brief. In addition, the International Bureau proposed to allow the possibility of uploading additional explanations of relevance such as for cases where the explanation would benefit from the use of formulae or other complex data which could not be put into the web interface. It would also be likely that, in the future, the system could be extended to allow comments on other matters, such as clarity, industrial applicability and sufficiency of disclosure, but this could wait till Offices had greater experience of the national phase processing of the existing third party observations in the international phase.

262. The Delegation of the United States of America stated that it was encouraged by the use of the third party observations system and by the fact that its concerns regarding possible abuse of the system had not been borne out. The Delegation was concerned about the indication in paragraph 14 that a significant portion of the observations were filed in the twenty-eighth month from the priority date. The primary purpose of the third-party observation system was to provide a mechanism to get prior art in front of the examiner and the applicant. Such a delay in submissions by third-parties guaranteed that the prior art would not be able to be considered by the Chapter II examiner and severely limited the ability of applicants to properly consider the prior art before the expiration of the period for national phase entry. As such, the Delegation recommended that consideration could be given in the future to either shortening the time limit for submission or, in the alternative, of providing an incentive to encourage early filing or a disincentive for late filing, such as charging a fee for submissions submitted after a certain date. Concerning the recommendation in paragraph 24 on the length of the comments, the Delegation understood the rationale behind this proposal and was not opposed to increasing the limit, but had some concerns about the proposed size of the increase, as a limit of 5,000 to 10,000 characters was anywhere from two to five pages in text. Therefore, while the Delegation supported an increase, the proposal stretched the definition of a brief comment on the prior art, which could be limited to a more modest amount of say, 1,000 characters. The Delegation had no objection to allowing additional uploaded explanations in cases where, as pointed out in paragraph 25, it required the use of formula or other complex formatting. Finally, the Delegation expressed significant concern regarding the discussion in paragraph 26 of the possible future expansion of the system to also allow for comments on clarity, industrial applicability and sufficiency of disclosure. Decisions on these matters required a legal conclusion based on an individual country's national requirements for granting a patent. A third party would not necessarily be able to provide additional relevant information to the examiner on these matters, since it was the examiner who could be considered to have been trained to correctly apply the legal system to these matters. Moreover, expanding the system to include these matters could lead to the system becoming a forum for third parties to submit general complaints against the application. Finally, in the experience of examiners at the United States Patent and Trademark Office which had been presented with such observations, they rarely found those comments helpful. Therefore, the Delegation disagreed with the comment that expanding the scope of observations to include these additional topics was desirable in principle, especially in view of the fact that the greatest benefit of the third-party system was to provide the examiner with relevant prior art that might otherwise be overlooked.

263. The Delegation of the European Patent Office was generally supportive of the third-party observation system and of improving it. The European Patent Office had made a small evaluation of the third-party observations received so far within the PCT. In about one-third of the cases, the examiner made use of the documents cited. In 22 per cent of the cases, unusual non-patent documents were cited, that is, dissertations, posters and experimental data, rather than journal articles. This therefore gave an indication that the system worked the way it should. The European Patent Office supported all the suggested technical improvements proposed in the document, such as increasing the size of comments and the machine translations, where it considered that a character size of about 5,000 would be appropriate. Regarding the uploading of documents with further information, this could be limited to a single document, which could be clearly distinguished from the prior art documents uploaded at the same time. As to the proposal of making an online listing of all documents cited throughout the procedure, the European Patent Office in principle supported this, but noted there were IT-related issues which needed further consultation to make the systems compatible. Finally, with respect to the proposal of including Article 5 and 6 observations, the European Patent Office already had this provision under the European Patent Convention, was supportive of this goal and suggested to provide some data and feedback from its examiners on observations on these matters for a future session of the Working Group.

264. The Delegation of Japan commented that the International Bureau delivered third-party observations to designated Offices 30 months after the priority date. However, in some cases, examination at the designated Offices had already been completed by that time. The Delegation therefore suggested whether the International Bureau could deliver third-party observations using the ePCT service earlier than 30 months after the priority date. As to the format of observations, the Delegation supported the proposal, which was what users had been requesting.

265. The Delegation of Australia supported the third-party observation system, but IP Australia had experienced difficulty in third-party observations not being brought to the attention of its examiners because of an administrative issue. However, in the extremely small number of cases where the third-party observations were not seen, the documents mentioned with the observations were available from other sources and were used for novelty and other citations in the examination report. This highlighted the high relevance of the documents supplied with observations. IP Australia therefore looked forward to the implementation of ePCT services for designated Offices, which would make the demand for retrieval of the observations, and importantly copies of the citations, much simpler. In relation to the limit of characters per cited document and a brief explanation of relevance, the Delegation supported the expansion of the limit of characters per cited document to two A4 pages, approximately 5,000 characters, to allow more detailed comments to be made.

266. The Delegation of India reiterated its view expressed at the forty-second session of the Assembly in 2011 that the third party observation system should be further standardized to allow observations on clarity and sufficiency of the disclosure. The system should also be user friendly, with the process of submitting documents not being burdensome on the third party to upload documents. The Delegation also informed the Working Group of the third party observation system in India which had been available since 2005, where observations could be made on the grounds of relevant prior art, wrongful filing, lack of or insufficiency of description, prior public knowledge, etc., without limitation of size of the documents submitted. While the Delegation was concerned about extremely lengthy explanations of relevance, it was also aware that such explanation may be necessary in some cases. The Delegation was therefore satisfied that the limit of 500 characters for a brief explanation could be expanded with a provision for providing a detailed explanation of the relevance with the higher character level being introduced. This would ensure that the preciseness and the character of the brief explanation was preserved, which was of high relevance to Offices, while at the same time enabling the user to submit detailed explanation. The Delegation therefore supported the proposal in paragraph 24 of the document to indicate the size up to 5,000 or 10,000 characters.

267. The Delegation of China welcomed the use of the third party observations system and had no objection to the three recommendations in paragraphs 24 to 26 of the document, which would improve the system and be more convenient for examiners and third parties. The Delegation also suggested that the International Bureau track the usage of the system and summarize experiences, especially ones during national phase. The Delegation also noted that some applicants wanted to respond to the third-party observation, and it hoped that the International Bureau could take this into consideration.

268. The Delegation of Spain supported this proposal for improving third-party observations and requested observations from third parties in the international phase being presented to International Authorities over a period of time so they could be analyzed for quality control purposes by International Authorities.

269. The Chair stated that the Secretariat had indicated that it was happy to follow up the request of the Delegation of Spain and continued by summarizing the interventions from members of the Working Group, which had shown strong support for third party observations. There were some details that were problematic, such as observations arriving too late for consideration in the national phase and sometimes not being available, and the suggestion from the Delegation of the United States of America to encourage earlier submission could be considered further. Delegations had also referred to the practical requirements of the national Offices having access to these notifications, which the Secretariat was working on. There was strong support for raising the limit of characters in the brief explanation of relevance from 500 say to 5,000, but not necessarily to 10,000 characters. There was also support for the other recommendations in paragraphs 25 and 26..

270. The Representative of the Japan Intellectual Property Association (JIPA) stated that JIPA hoped the investigation of policy regarding the way designated Offices examined the documents provided by the third-party observation would be continued. Regarding the intended future developments on paragraph 23, JIPA welcomed a system to help applicants more easily meet disclosure requirements of certain Offices, which would reduce costs for applicants, especially when selecting the United States Patent and Trademark Office as a designated or elected Office.

271. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) agreed with the intervention and suggestions made the Delegation of the European Patent Office. However, the Representative disagreed with introducing a disincentive for late filing of third party observations towards the end of the 30-month period.

272. The Representative of the All-China Patent Agents Association (ACPAA) supported the increase of the limit to 5,000 characters to explain the relevance of cited documents, which would provide more detail without significant extra burden on the work of examiners. ACPAA also agreed to measures to ensure timely delivery of cited documents to designated Offices and further proposed that applicants' responses to the observations, if timely filed, be delivered to the designated Office in an equivalent way so the Office could be aware of opinions from both the third party and the applicant when examining a patent application.

273. The Representative of the American Intellectual Property Law Association (AIPLA) supported the expansion to 5,000 characters for explaining relevance of documents, which corresponded to about two typewritten pages. AIPLA also suggested that the Administrative Instructions could clarify that this explanation should be limited to facts in the document and not make legal arguments.

274. The Working Group approved the recommendations in paragraphs 24 to 26 of document PCT/WG/7/11. The limit for brief explanations of relevance would be increased to 5,000 characters.

**ESEARCHCOPY**

275. Discussions were based on document PCT/WG/7/8.

276. The Secretariat explained the concept of eSearchCopy. Receiving Offices would transmit all relevant documents to the International Bureau which would send the search copy for the International Searching Authority once all the required documents had been received and there was an indication that the search fee had been paid. This would eliminate work and postal costs for receiving Offices. International Searching Authorities would get search copies in a consistent electronic format, usually more quickly than they do at present. Given that the International Bureau already transmitted documents electronically to all International Searching Authorities, it had been hoped that this service could be implemented quickly. At present, a trial was underway with four International Searching Authorities receiving electronic copies from the International Bureau, in parallel with paper copies coming from the receiving Office. The trial was working accordance with original specifications, but some enhancements had been requested by International Searching Authorities, some of which needed to be dealt with before the live service could begin. The International Bureau therefore proposed that, after the International Searching involved in the trial had confirmed that the service was satisfactory, a Circular would be sent to receiving Offices and International Searching Authorities proposing a method of introducing the service for live use between any sets of receiving Offices and International Searching Authorities that wished to take advantage of the service. It was expected that, for some International Searching Authorities, the service would be introduced for a few receiving Offices at a time, allowing the transition for each one to be monitored carefully. ePCT would allow the relevant services to be activated immediately for any receiving Office-International Searching Authority pair.

277. The Delegation of the United States of America thanked the International Bureau for the work on establishing the system and was happy and excited to be part of the trial. The Delegation agreed that the establishment of this service would be expected to bring significant efficiency and cost benefit gains to Offices and hoped to implement eSearchCopy at the United States Patent and Trademark Office on a limited basis this fall.

278. The Delegation of Australia supported the development of eSearchCopy. As an International Searching Authority, the Australian Patent Office had experienced instances where it had received a search copy and subsequently sent search results to the International Bureau prior to the International Bureau receiving the record copy. In other instances, the International Bureau had received the record copy but the Australian Patent Office had not received the search copy. eSearchCopy would eliminate these problems by removing the necessity of paper transmission from the receiving Office to the International Searching Authority and deliver the eSearch package in consistent format, enabling applications to be processed more quickly. Once the system was introduced for live use, the Delegation encouraged receiving Offices and International Searching Authorities to take advantage of this service, since there was great value in having the exchange of copies through the International Bureau. It also welcomed the International Bureau taking the lead in coordinating any International Searching Authorities wishing to take advantage of this service. The Delegation also looked forward to having existing ePCT functionality enabled to record the payment of search fees and to improvements of functionality to offer a more complete record of what fees had been paid when and which fees remained outstanding.

279. The Delegation of Israel stated that, given that 95 per cent of international applications were filed at the Israel Patent Office in electronic form, the Israel Patent Office in its capacity as a receiving Office would be interested in using the ePCT service to send search copies to the European Patent Office or United States Patent and Trademark Office when selected as an International Searching Authority. As part of this process, two communications might be required to be transmitted using ePCT, one indicating that a certain Office had been nominated as an International Searching Authority and the second indicating that the search fees had been paid. As an International Searching Authority, the Israel Patent Office had already started to

use electronic search copies regularly for international applications filed by Israeli applicants at the receiving Office of the International Bureau for which the Israel Patent Office was the competent International Searching Authority. Once received via PCT-EDI using automatic secure FTP protocol, the international application was automatically uploaded to internal automation systems for further processing.

280. The Delegation of India supported the sending of search copies in electronic form. Examiners at the Indian Patent Office acting in the capacity as an International Searching Authority worked in a fully electronic environment for the receipt of copies of documents and issuing reports. The proposal of sending the search copy in electronic form would therefore reduce the need for the Indian Patent Office to convert paper copies into electronic form. If accepted by the number of International Searching Authorities, the project would result in faster communication between Offices, but it was important to be clear whether the search fee had been transferred or not. While it was encouraging to note the results of the trial, the management of the search fee and its transfer to the International Searching Authority needed to be properly linked.

281. The Delegation of China stated that eSearchCopy provided a new way of transferring copies with advantages when the receiving Office and the International Searching Authority were not the same. However, it was important that the International Bureau transferred the search copy to the International Searching Authority in a timely manner to start the international search as early as possible.

282. The Working Group noted the status report and the proposed way forward in document PCT/WG/7/8.

#### **NATIONAL PHASE ENTRY USING E-PCT**

283. Discussions were based on document PCT/WG/7/12.

284. The Secretariat stated that the document outlined a concept of using ePCT to trigger national phase entry. Most of the documents and bibliographic data which designated Offices needed to commence national phase processing were already held on file by the International Bureau. Applicants could with such a system add any outstanding documents and information before requesting national phase entry. On confirming that the national phase entry request should be generated, the package would then be created for the designated Office, containing all the required bibliographic data and documents. ePCT would not, however, be the only way of entering the national phase in a given State. Any Office willing to participate in this scheme would confirm their national phase requirements in terms of translations, address for service requirements and time limits. The system would then ensure that at least the minimum requirements were complied with before transmitting a standard format package of documents and data to the relevant designated Office. This was all made possible by the fact that ePCT was designed as a secure collaboration tool. The applicant could give access rights to partner agents in other States which could then cooperate on drafts, where each one could benefit from the certainty that the documents and data already provided for the international phase would be the latest versions and would not need to be transcribed with the risk of errors that that confers into any national forms. They would be able to see the latest version of what additional data was being proposed to complete the relevant national requirements by the other partner agents. The service would be convenient for applicants, but it would also be beneficial to designated Offices, since it would offer bibliographic data in electronic form, reducing the risk of transcription errors. It would also offer an incentive for Offices to improve their information on national phase entry, which was key to improved patent information services. This system would, at the outset, be limited in the sense that payment would need still to be made directly to the designated Office, but the option of centralized payment services could be added at a later date if equivalent services to receiving Offices proved successful and designated Offices wished to take advantage of such an arrangement. The Secretariat indicated that, at this stage, the International Bureau was seeking expressions of interest in the system to determine whether it

would be worth undertaking the extra work to identify the relevant needs and define clear user interfaces and appropriate technical arrangements needed to deliver the information to designated Offices.

285. The Delegation of Sweden expressed general support for the proposal, but recommended that the national application number be assigned by the International Bureau in the ePCT service and not at a later stage when the application had been received by the designated Office. All designated Offices could allocate a separate number series for applications submitted via ePCT. The Delegation believed it was more convenient for the applicants to receive the application number at the time of filing since the application number, for example, was required when paying the fees. It would also be easier for the designated Office to discover if an application was lost during transfer to the designated Office due to technical errors, as this would show up as a gap in the series of application numbers.

286. The Delegation of Australia supported the concept of using ePCT to trigger national phase entry in principle if it resulted in benefit for applicants. However, the present proposal involved a two-step process for entering the national phase: one, to use ePCT to trigger filing; and two, to pay fees to the designated Office. Under Australian law, the national phase could not be entered until the fee was paid. The proposed system therefore increased the risk to an applicant of missing the deadline if the applicant believed he had entered the national phase by following the ePCT process but omitted to pay the fee in time. The proposal could also present difficulties to some Offices with linking the payment of fees to an application. The Delegation also noted that the system might move the deadline for confirming national phase entry from 30 to 31 months to a series of different dates, depending on when the fee payment was required in national Offices. Furthermore, there was the issue of time zones, particularly how provisions of regional Offices could be implemented where an agent connected clients across jurisdictions, such as Australia and New Zealand. The Delegation also wished to see text developed to help applicants navigate the process of using ePCT for national phase entry. In conclusion, the Delegation saw value in using ePCT to trigger national phase entry, particularly when ePCT fee payment was possible, and would welcome the development of a centralized payment service to facilitate this.

287. The Delegation of the United States of America expressed interest in using the ePCT system for national phase entry, especially as this related to the Global Dossier system. Both the United States Patent and Trademark Office and its users were therefore interested in ideas in the document, even though there were significant IT and legal issues which would need to be addressed in the development of the ePCT system. The Delegation anticipated working closely with the International Bureau to coordinate development between the ePCT system and the Global Dossier in view of the fact that facilitation of cross filings was one of the central aims of the Global Dossier system and applicants were excited about the ability to enter the national phase at the touch of a button. The Delegation commented that payment of fees before the 30 month date was a legal issue that would have to be studied and a centralized fee payment capability could be appropriate, as indicated by the Delegation of Australia.

288. The Delegation of Japan supported the concept in the document, which aimed to make the processing of patent applications more convenient for applicants and designated Offices and had potential to serve as a mechanism for providing information on applications in the national phase. However, in considering this issue, attention should be given to the many anticipated legal and systemic issues that would need to be dealt with if ideas in the document came to fruition.

289. The Delegation of Brazil saw merits in this initiative, mainly by providing extra information for the examination to be performed by the designated Offices and had two comments. First, the Delegation was concerned about the compatibility of the template mark-up for the ePCT

national phase application with existing templates used by designated Office. Second, the idea of a centralized payment system needed to be discussed further before any decision was taken in this regard.

290. The Delegation of China appreciated the work in facilitating national phase entry through ePCT and hoped that the International Bureau would fully consider the possible legal, technical and practical issues before putting this facility into use. Possible issues included how to confirm the date of entering national phase, to ensure the safe and effective interface between the ePCT and national systems, and to avoid the negative impact on patent attorneys.

291. The Delegation of India indicated general support for the ideas in the document and shared the experience it had had in simplifying the filing in the national phase. The Indian Patent Office, about two years ago, had changed its system, which obviated the need of filing a complete set of documents when the applicant of an international application entered the national phase in India. This included the removal of tasks relating to necessity of data entries, scanning OCR, uploading a section of normal international applications to a maximum extent that only the fields not available in the international application were required to be entered. The Indian Patent Office, in coordination with the International Bureau, acquired online access to the international application, the benefits of this coordination being passed on to the stakeholders, as redundant processes had been eliminated. An applicant was no longer required to file multiple copies of a document already available which could be accessed electronically from International Bureau and used for national phase entry. This had resulted in more efficient uses of the available resources at the Indian Patent Office and reduction in errors, thereby obviating the need for corrections in many cases. The data relating to PCT international applications entering the national phase in India was received in three parts: XML, pdf and tiff. XML contained the bibliographic and searchable data, pdf contained the OCR of the complete specification and international search report, and tiff contained an image file of the application. For the working environment, XML would be received for the heavier data, with pdf and tiff being used at off-peak hours. The data retrieval followed a simple process; in the first step, the operator took the application filed, entered the application number in the required column, then clicked the retrieval button to establish connection with the server at the International Bureau to fetch the data. Documents filed on the international filing date at the Indian Patent Office needed to correspond with the up-to-date information available at the International Bureau. Any request pending with the International Bureau would not be of any consequence. If any such request was reflected in the document, the information notified published by the International Bureau prevailed. While introducing this process, the Indian Patent Office faced challenges. If the request was made by the applicant before the International Bureau had disposed of the application by way of publication of notice, it could not be taken into consideration. Second, the Indian Patent Office was not in a position to retrieve the data for applications which entered the national phase in India before the publication of the international application by the International Bureau, as data was not available in PATENTSCOPE. In such a case, the benefit of simplified filing was not available to the applicant and full text was not available in XML. Sometimes the change in the name of the applicant was not reflected in XML and received through PATENTSCOPE. Challenges were also faced when the international application was in a language other than English and translation was not available with the International Bureau. In such case, in accordance with the domestic law, the applicant was required to file a translation at the same time. The Indian Patent Office looked forward to a full-fledged implementation of the ePCT system at a global level. It had the potential of reducing the workload of Offices and eliminating the possibility of error, considering the difficulty faced by the Office. The Delegation also wished to draw the attention of the International Bureau to ensure that the fees as well as the time limit to enter the national phase in the designated Office were taken care of in designing the system.

292. The Chair summarized that a number of delegations had expressed interest in the concept of national phase entry using ePCT, noting the potential benefits for applicants and Offices in a simple process which could reduce delays and errors. A number of legal and

technical issues needed to be addressed, including payment of fees, how the date of submission of the documents and data would be determined, potential for confusion from different time limits for different designated Offices and reliably ensuring that all individual national requirements were identified and properly described.

293. The All-China Patent Agents Association (ACPAA) accepted that national phase entry using ePCT could bring certain benefits to the application, but it was a sensitive issue in both legal and technical aspects which needed to be carefully studied before any conclusions were reached. Specifically, ACPAA had the following concerns. First, according to the effective Chinese patent law, a foreign applicant was required to appoint a local patent agent to deal with filing and prosecution of patents on his behalf in China. Therefore, there was a legal barrier for foreign applicants and his home country patent agency for using ePCT to enter the national phase in China. Second, if a foreign applicant asked a Chinese local patent agency to enter a PCT application into the national phase in China by using ePCT, there was a technical issue to be solved, that the ePCT system should be constructed to be able to identify whether the patent agent was legally qualified to satisfy the requirements of Chinese patent law. Another technical issue was how to determine the timing of national phase entry by using ePCT. Many designated Offices, such as the State Intellectual Property Office of the People's Republic of China, took the time when the designated Office received the national phase entry document as the time of national phase entry. Therefore, whether it would be possible for a designated Office to accept the time when the user completed operations for national phase entry in the ePCT system was a question that remained to be resolved. Finally, the current ePCT system was designed to complete filing of individual patent applications. This was an advantage to small businesses or individuals not filing many applications. However, users filing many applications, especially those patent agencies which needed to complete a great deal of patent filings every day, expected the system for receiving electronic filing to have the capability of batch processing, which was absent from the ePCT system. It was thus proposed that there be a programmed modem interface or sub-program for large users' batch filing of patent applications or relevant documents.

294. The Representative of the International Federation of Industrial Property Attorneys (FICPI) stated that FICPI had reviewed the proposal with great interest. The Proposal was in line with its basic aim to make PCT proceedings even more rational and possibly simpler than today. FICPI could see that there were a number of advantages in principle with such a scheme, in addition to those for the designated Offices. For applicants, these included reliable transfer of correct bibliographical data to the designated Offices, possibility to secure national or regional entry before the 30/31 months deadline without any delay in a chain of instructions, obtaining immediate confirmation from each designated Office that national or regional entry had been duly effected, and a possibility to expand the system such that all Office actions were automatically shared with other patent Offices, thus addressing the present burden for applicants, in some jurisdictions, to continually inform the local Office of search results from other Offices. For third parties, these included easy and early access to information on where (in which countries) an applicant had entered the national or regional phase. FICPI was willing to assist in developing a streamlined procedure for national entry that was beneficial for all stakeholders being involved in the national entry process. Upon consultation with its Work and Study Commission, and among the delegates of its national groups, FICPI wished to make some initial observations, to raise a number of questions and to put forward some suggestions.

295. The Representative continued by making several observations on the proposal. First, appointment of a local agent should be compulsory in each jurisdiction. For the system to be secure and reliable and also to operate smoothly, it had to include a compulsory appointment of a local agent, who should also receive the data package, for example, in XML format that was shared with the designated Offices. Typically, the local agent should also be given an opportunity to accept the appointment at an early, fixed date, so that another local agent could be appointed in case the initial agent denied the appointment, for example, because of a conflict of interests. Conflict checking had become more and more frequent and important during recent

years. Furthermore, in some jurisdictions, for example, Australia, the Code of Conduct for patent and trademark attorneys provided that a registered attorney who was an individual must have appropriate competence for work he or she did. Preferably, there should be another deadline for appointing a local agent to ensure that national phase entries occurred in a timely manner. The local agent should also check whether the application documents had been sent, received and could be opened in proper condition, without any error, and correct any errors in the data. For the particular case of Poland, the local agent should also sign the request for entry into Poland. The local agent also needed to assess whether the claimed subject matter was acceptable in the particular jurisdiction, or whether a voluntary claim amendment was necessary to avoid a loss of rights; this measure was also critical for reducing costs. In some instances, the check of patentability could lead the applicant to refrain from filing the application at all in a particular jurisdiction. It was also necessary for a local agent to ensure that the specification complied with local laws and practice and to amend the specification where appropriate. In Australia, where the rules on priority were very strict, the local agent also needed to review priority data against applicant data to check entitlement to any priority claim. A failure to do this might result in total loss of rights. In India, the applicant had to give an address for service and appoint the particular patent Office (among the four possible ones). In most countries, the local agent needed to prepare a quality translation in a prescribed language within a set term. The local agent also needed to assess whether further actions were necessary to avoid loss of rights, for example, payment of maintenance fees, apart from any official fees for national entry, make note of and monitor future actions that were necessary to validly prosecute the national/regional application up to grant of a patent, for example, filing a request for examination, obtaining (specifically in the United States of America) signatures of all inventors on an inventor's declaration, providing information on prior art references and search results from parallel or related applications (very important for example, in the United States of America, Israel and India), and providing information on applicant's entitlement to the invention and the right to priority. In some instances, heavy surcharges could be payable for late submission of declarations or documents, or other missing parts. The local agent should also conform the claim structure, claim wording and the description to local requirements so as to facilitate the examination by the national or regional Office. Such work was regularly being done today by local agents and made it possible to validly prosecute an international application in many different jurisdictions that had a great variety of substantive and formal requirements. FICPI therefore considered that the system would not operate properly without the adaptation and verification work that was performed by local patent attorneys. It was crucial that a local agent was appointed effectively before the national phase entry deadline. This should not be a formality to be completed at some later date.

296. The Representative continued by discussing the risks of loss of rights, non-optimal protection and extra costs. The system as proposed might be acceptable to large multi-national companies who handled their own filings, but there was a real danger that small to medium sized applicants would be attracted to the system by false economy, and then find that rights were lost or optimal protection was not obtained, due to failure to meet local requirements by the prescribed deadlines. Also, in most jurisdictions, extra costs were imposed in case certain acts or submissions were performed later, if at all possible. In many jurisdictions, in case no local representative was appointed, the Patent Office might not inform the applicant about a rejection, for example, if a translation was not filed within the legal time frame. In any case, remedies, such as further processing, had to be created and harmonized in participating jurisdictions, so that the applicant could rely on similar remedies in each jurisdiction, in case the national phase entry had defects or incompatibilities.

297. The Representative continued by emphasizing that payment of the national entry fee should be required at the (30/31 months) national entry deadline. A system for national phase entry which did not involve the payment of the national phase entry fee would be seen as a possibility for applicants to maintain maximum flexibility and was likely to lead to the filing of "provisional" national entry applications which were ultimately not pursued. This would cause a burden for the national Offices and would also involve a great disadvantage to third parties who

could not determine, shortly after 30/31 months, the territorial coverage of the international application. The local agents would also have to monitor an extra term for securing a valid national entry filing. Thus, introducing an incomplete system for national phase entry would simply move the deadline for confirming national phase entry from the well-established and understood set period of 30/31 months to a series of different dates, depending on when fee payments or post-filing formalities were required in the national Offices. It would be preferred if a national phase application was considered as filed only after the national phase entry fee was paid. It also needed to be quite clear who had the responsibility for fee payments. If both the applicant and the local agent were authorized to pay, there might be instances where payments would not be made due to some misunderstanding or some communication gap. Overall, this would certainly increase the uncertainty that was often presented as a defect of the patent system.

298. The Representative also highlighted that national legislation might have to be changed in some countries. FICPI's group in Colombia had pointed out that a Spanish translation had to be filed. However, there was no term for the filing of a translation after national phase entry. Accordingly, the application could be filed with the existing language. Then, an official action would be issued in the Spanish language, which would lead to a loss of applicant's rights if there were no response. In order to solve this, the present law in Colombia would have to be amended, which would accept the entrance in a different language and set a legal deadline for filing a Spanish translation. Most likely, similar changes of the national patent laws would have to be made in other jurisdictions before implementing the proposed national entry system by using ePCT. Certainly, if a centralized payment system were to be introduced, there would be a need for patent law amendments in many countries. Preferably, the option of a centralized payment should be deleted, or at least postponed until all practical matters had been solved. Again, there would be great uncertainty. For instance, which would be the relevant payment date and hour to be taken into account for national deadline purposes? The exchange rates also had to be considered to ensure that full payment was received by the national Office.

299. The Representative continued by posing a set of questions to the International Bureau and national Offices. In terms of possible errors, in the proposed system, how would national Offices deal with errors that occurred on national phase entry, or following national phase entry, that could lead to loss of rights? In particular, how would national Offices deal with the conflict between the interests of the applicant in being able to pursue the application and the interests of third parties who would be adversely impacted by the pursuit of the application? What would happen if a designated Office did not receive the notification of the International Bureau? In Australia, if the proposed system were introduced and incorrectly indicated that national phase had been entered in Australia for a particular application, but no relevant information was transmitted to the Australian Office, the relevant deadline would have to be extended under Australian law under section 223(1). Would all participating countries introduce similar protection? In terms of responsibility for loss of right, would the International Bureau and/or the national Offices be covered by proper insurance against third party claims in the event that rights would be lost due a failure of the proposed system to properly effect national phase entry? In many instances, a serious error might lead to a situation where the application was considered to be withdrawn, without any effective remedy. In terms of incomplete applications, would the system block a national phase entry application that was incomplete or that contained defects, or would such omissions or defects need to be addressed before the national Offices, assuming they were correctable. As for lists of representatives, in the proposed system, who would the national Office correspond with after national phase entry? In some countries, national Offices could only communicate with registered attorneys or agents. What would happen if rights were lost due to a failure to communicate correctly or in a timely way with the local agent? How would an agent be appointed, and how would the eEditor and eOwner rights be given? Would there be a list of representatives for each country? If yes, what would the procedures be for to be included on this list? How would it be checked, if a person to be chosen as representative was able to act as representative? There was also the question of how an agent would go about accepting appointment, for example, after the agent had carried out a

conflict check, and at what point did the appointed agent become responsible for the national application? What was the procedure to be followed if the appointed agent was not willing to accept the appointment, for example, due to a conflict of interest? On cost reductions, how did the International Bureau believe that the system proposed would reduce costs for applications? FICPI believed that cost reductions could be achieved for example, by measures taken by the local agent, who could suggest claim amendments and a reduction of the number of claims as well as other amendments, for example, in view of the particular fee schedule and practice of unity of invention, which would facilitate a smooth prosecution at the particular national Offices. Moreover, were all national Offices presently ready to accept the transfer of data packages from the International Bureau so that national phase entry using ePCT could be achieved efficiently? Also, how would the system cope with different time zones, for example, if the national phase entry process was initiated at a time in one country when the deadline had passed in one or more designated countries? Finally, what would be the procedure for choosing either a patent application or a utility model application when effecting national entry through the ePCT?

300. The Representative concluded by providing some suggestions. Since there were a large number of outstanding questions, FICPI would suggest that a limited pilot study of the proposed system be carried out before the system was implemented more broadly. As to the practical implementation of the proposal, the Canadian group of FICPI had suggested a modified procedure when entering the national phase by using ePCT as follows: "Perhaps the WIPO web page could send the web page shown in Figure 2 in an email to the indicated local agent or representative for service and give that agent an opportunity to accept the appointment by clicking on a button on the web page, before the "package" is sent to the local patent Office. In this way, the local agent will receive instructions by way of such a web page. Perhaps the webpage could also allow the local agent to enter fee amounts or make any corrections or amendments at the time the local agent accept the appointment, so that the local agent can add value by adding any necessary items or requirements for national phase entry and for ensuring that the proper fees are paid". As stated initially, FICPI was willing to assist in developing an effective electronic system for national phase entry and was ready to enter into discussions on how to work this out in practical terms, preferably within the framework of a pilot study. As a final remark, at a time where the major patent Offices were still facing backlogs and having difficulty in coping with still increasing numbers of received applications, FICPI believed that it was essential that these Offices receive national/regional phase applications in a condition which was as clean and regular as possible, in order to avoid further administrative burden and costs, and also avoid increasing the risks of loss of rights for applicants and uncertainty for third parties. This could not be achieved without early involvement of local representatives.

301. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) stated that ePCT was a convenient tool for applicants and worked well as far as it implemented international legislation for international applications. But for expanding the ePCT to the national phase and/or to the interface between the national phase and the international phase, it was necessary to address legal and practical issues. For example, in cooperation between local agents and the agent who handled the international filing, it did not seem to be the most efficient way to have one agent uploading a document and the other triggering national phase entry, and which agent had responsibility in the event of a deficiency? And if the national agent had a question regarding the case, would the agent address the national Office or the International Bureau? The Representative considered there to be many such questions to be addressed, and proposed that further consultation should take place by e-mail before the next session of the Working Group to ensure all the concerns of users and patent attorneys were taken into account in the preparation of any further document on the proposal.

302. The Representative of the American Intellectual Property Law Association (AIPLA) shared the concerns expressed by ACPAA and the spirit of the remarks made by FICPI, in particular the issue of a local agent to accomplish national phase entry. AIPLA was particularly

concerned that, absent an agent being involved who was local, it could off-load onto national Offices work which initially seemed easy because one checked the box, but in fact had severe consequences of compliance which was not met until after a series of notices were sent.

303. The Representative of the Japan Patent Attorneys Association agreed with the basic concept of ePCT and understood that the proposal was made from the viewpoint of eliminating the burden of applicants, their representatives and designated Offices on entering into the national phase. However, JPAA had some concerns with this issue. In principle, the international phase was handled by the PCT and the national phase by the Patent Law Treaty (PLT). The Representative pointed out the provision of mandatory representation in PLT Article 7(2) and indicated that the proposal needed to be designed to accord with and not contradict with the PLT.

304. The Representative of the Asian Patent Attorneys Association (APAA) expressed the concerns of its membership which had been expressed by other user groups. The Representative understood that the International Bureau would be considering these issues and it welcomed the opportunity to be involved in this matter. One item repeated by the observer groups was the relationship between the agent in the international phase and the local agent in the national phase, which was critical for how the process worked. Many APAA members had proposed that the system could benefit from there being a formal agreement or confirmation from the local agent that they accepted the nomination and the national phase entry via ePCT was done through the local agent and not the international phase agent. APAA believed that this might overcome some of the concerns expressed, but welcomed the opportunity to discuss this idea more closely.

305. The Working Group agreed that the International Bureau should continue to develop this concept in consultation with all interested parties, taking into account the comments made.

## **DELAYS AND FORCE MAJEURE FOR ELECTRONIC COMMUNICATIONS**

306. Discussions were based on document PCT/WG/7/24.

307. The Secretariat explained that the PCT had a number of provisions for extending time limits or treating them as having been met despite them having been received after the end of the relevant period. These provisions were drafted when documents were always delivered on paper, either by hand or through the mail. However, today, about 90 per cent of international applications were filed electronically. The risks faced by applicants had changed. Some risks had disappeared through electronic communications, while new risks had emerged, and the nature of others had changed. The existing rules could not all be directly applied to certain new situations. The document therefore proposed amendments to the Regulations to cover situations where there was a relatively clear comparison between a paper based situation and the electronic equivalent in order to clarify how the rules should apply to the electronic situation. The first proposal would add a new subparagraph to Rule 80.5 for the situation where an Office's electronic systems were unavailable to users for a significant period, either because the systems were down or because the Office's communications with the Internet were cut off. This would be a matter with automatic effect based on the facts of the situation, where the applicant or other interested party would not normally need to provide any evidence of the facts because they would already be known to the Office. The second proposal would add a provision concerning widespread and unexpected loss of communication services in an area other than that of the Office. In this case, as in the existing force majeure provisions, the applicant would need to provide evidence of what had happened so it could be determined, on a case-by-case basis, whether the necessary conditions had been met, including the nature of the incident and whether the applicant had, in fact, taken remedial action as soon as reasonably possible in the circumstances. As well as proposing amendments to the Regulations, the document sought

views on further steps where the force majeure provisions could be extended in the future, such as where electronic services may be unavailable to an individual, even though others in nearby locations might have no problems at all.

308. The Delegation of Australia agreed that it was desirable that applications were not prejudiced as a result of failure of electronic systems beyond their control. However, the Delegation did not support the proposed modification to Rule 80.5 as an appropriate solution, as it considered that the proposal was too prescriptive and did not take into account all appropriate circumstances. The question to ask was whether, under all the circumstances, the unavailability of an electronic system reasonably prevented something being done. This was a question that Offices themselves were best placed to determine on a case-by-case basis. As a result, the Delegation preferred an approach that Offices themselves would determine when system availability had caused a significant impediment to filing, and subsequently declare themselves closed for business as appropriate, a possibility available under many national laws, including Australia. The Delegation also noted that many countries had provisions for consideration of circumstances beyond an applicant's control as part of their national law or the service agreements for their electronic systems and, under Article 48(2)(a), these Offices would give the same considerations to PCT filings that were affected by electronic systems as under their national law. The Delegation therefore considered that, even if a patent Office did not declare itself closed, applicants would be able to use these provisions on a case-by-case basis. With regard to the proposed change to Rule 82*quater*, the Delegation expressed support for the proposal.

309. The Delegation of the United States of America agreed with the views expressed by the Delegation of Australia with regard to the proposed changes to Rule 80.5. The Delegation considered the proposals too prescriptive as Offices currently had the ability and the authority to best determine when they should consider themselves closed, so any provision that would require an Office for a brief two hour outage between 12 noon and 2 p.m. in the afternoon to allow everyone to file the next day was considered unreasonable. With respect to Rule 82*quater*, the Delegation had some concerns with the language, for example, "widespread" could be used in a geographical or temporal sense, and the extent of the term was also unclear. The Delegation did not consider Rule 82*quater* to require changing, and believed that the circumstances in the added text were covered by "other like reason in the locality where the interested party resides, has his place of business or is staying".

310. The Delegation of Germany supported amendment of the existing PCT Regulations dealing with the extension of time limits so they covered the non-availability of electronic communication services but was concerned that the proposal was too broad. For example, the Delegation did not think it was an undue burden to ask applicants to retry to electronically submit documents for fees in the late afternoon if an Office's system has been unavailable between 12 noon and, say 3 p.m. The Delegation also agreed with the Delegations of Australia and the United States of America with regard to the appropriate national routes to deal with this problem. Moreover, the proposed amendment to new Rule 82*quater* was also too broad.

311. The Delegation of Japan shared the concerns expressed by the Delegations of Australia and the United States of America and believed that further discussion was needed to strike a balance on the details of the provisions concerning force majeure.

312. The Delegation of Israel supported the interventions made by the Delegations of Australia and the United States of America.

313. The Delegation of the European Patent Office appreciated the additional safeguards in terms of systems being down or because of widespread loss of Internet connectivity, which seemed necessary in light of technical progress and PCT electronic filing rates at about 90 per cent. The Delegation therefore supported the proposals to amend Rule 82*quater*. The

Delegation did, however, consider that the wording of the provision could be improved to specify the services of the receiving Office, which was more in line with the European Patent Convention.

314. The Chair summarized that delegations which had taken the floor agreed that proper protection against failure of electronic communication systems was important. However, the proposed amendment to Rule 80.5 was considered too prescriptive and it was felt that the matter was better left to the discretion of individual national Offices. For example, a two-hour outage in the early afternoon would automatically extend a deadline to the following day, but a four-hour outage in the morning would not. Some delegations supported the proposed amendment to Rule 82*quater*, but others felt it lacked clarity, or else did not offer a distinct benefit over the provisions of the existing Rule.

315. The Representative of the All-China Patent Agents Association (ACPAA) expressed hope that amendments to the provisions could be made to offer adequate protection to applicants against failure of electronic communications and provided three suggestions. First, the Representative suggested that it be clarified whether the wording in the proposed Rule 80.5 “unavailable to users for a period of more than two hours without prior notice, after midday...” referred to a consecutive period of more than two hours when the system was continually unavailable, or a cumulative period of more than two hours when a system was intermittently unavailable. Second, the Office should issue a notice of extension of expiration date in appropriate ways as soon as possible when a system was unavailable for more than two hours after midday. Third, the Office should set up emergency contact details for user access, for example, hotlines, fax numbers and e-mail addresses, so that the applicants and the agents were able to contact the Office when necessary to make sure the expiration date had been extended. Finally, ACPAA agreed with the proposed amendments to Rule 82*quater*, to determine the degree and the extent of a failure of electronic communications.

316. The Representative of the American Intellectual Property Law Association (AIPLA) agreed with the remarks made by the Representative of the All-China Patent Agents Association (ACPAA) and underlined the need to avoid creating a sense of uncertainty.

317. The Representative of the Japan Intellectual Property Association (JIPA) supported the force majeure provisions but demanded that the provisions provided a safeguard against failure of a user’s local IT system, which could occur due to circumstances beyond the user’s control.

318. The Working Group noted that the International Bureau would continue to seek legal and technical means to minimize risks to applicants from possible failure of IT systems.

319. The International Bureau invited Contracting States to provide information on national laws or processes which offered protection for users against the failure of electronic communication systems, which might provide a basis for more appropriate action to address the issues at hand.

## **TIME ZONES USED FOR ELECTRONIC SUBMISSIONS**

320. Discussions were based on document PCT/WG/7/25.

321. The Secretariat introduced the document by explaining that some applicants from eastern States filed by fax or electronically to more westerly Offices when a deadline had passed in their competent receiving Office. The extent of this behavior was not known, but there were between 1,000 and 1,400 applications transferred to the International Bureau under Rule 19.4 each year due to the original receiving Office not being competent, about half of these cases coming from the United States Patent and Trademark Office, one of the most westerly receiving Offices. Filing at a non-competent receiving Office could happen for various reasons, one of which was the geographical time-zone of the Office. Rule 19.4 cases were complicated both for the International Bureau and the original receiving Office, and could cause major delays in

transmission of the search copy to the International Searching Authority. The document invited Offices to consider possibilities, such as allowing the International Bureau to set a more westerly time zone for electronic transmissions to its own receiving Office, allowing any receiving Office to select a time zone to use within the jurisdiction for which it was competent, which could offer a suitable combination of achieving the desired objectives with the minimum possibilities for confusion of applicants between national and PCT arrangements. At this stage, the document sought views of Contracting States for further consideration by the International Bureau for deciding whether to make specific proposals.

322. The Delegation of the United States of America did not consider that there was an issue of applicants deliberately selecting westerly time-zones. If that were the case, the majority of applications filed at the United States Patent and Trademark Office, which were then sent to the International Bureau under Rule 19.4, would be filed by non-US practitioners outside the United States of America. In fact, almost all such cases were filed by US practitioners. The Delegation therefore did not believe that the time-zone issue was a problem that needed addressing or one that would reduce the number of cases referred to the International Bureau under Rule 19.4. More specifically, paragraph 1 of the paper implied that applicants in western States enjoyed benefits that applicants in eastern States did not, which the Delegation did not think was the case, as all applicants had equal time periods for filing their applications. While applicants should not wait until the last possible date to file an international application if possible, applicants who did so knew they had until midnight to file the application. By contrast, under the proposal in paragraph 10(d) where every Office would base their date on a westerly time zone regardless of the location of that Office, that proposal would discriminate against applicants in westerly time zones, as applicants in more easterly time zones would have more hours from the beginning of the day to file their application. Regarding the options in paragraph 10(b) and (c), these already existed, especially where the Office concerned had a presence and the ability to receive applications in the time zone upon which it was basing its date of receipt. Without such a presence, however, it could be questioned as to whether the recording of a filing date based on a time zone conflicted with the requirements of Article 11, requiring that the Office shall accord as the filing date the date of receipt in that Office. Further discussion would therefore be necessary on any of the options in paragraphs 10(b) to (d). The Delegation therefore preferred the option in paragraph 10(a) not to change the current practice.

323. The Delegation of the European Patent Office noted that the time of receipt of any document at the receiving Office was a general principle applied in PCT procedures. While recognizing that in some instances, the provisions of Rule 19.4 were not necessarily fair on all applicants, this practice had the advantage of being clear, providing legal certainty and transparency in terms of the time applicable being that on receipt at the receiving Office. By contrast, the proposal in paragraph 10(d) would effectively give applicants in easterly States another day to meet the deadlines provided by the Paris Convention, adding an imbalance and uncertainty to the whole system. The Delegation therefore supported the option in paragraph 10(a) not to change the current practice.

324. The Delegation of Japan considered that the proposal should be addressed when discussing the idea of electronic communication of PCT documents. Although not in a position to support any of the options proposed in the document, the Delegation believed that adopting different time frames by virtue of the means used to file an application was not only unfair to applicants, but could also complicate operations at Offices and had the potential to cause confusion.

325. The Delegation of the United Kingdom agreed with the interventions made by the Delegations of the United States of America, the European Patent Office and Japan. While the Delegation understood the problem the proposal was seeking to address, applying a different time zone would alter what had actually occurred in terms of the filing date and could cause error and confusion. The Delegation therefore supported the option in paragraph 10(a) not to change the current practice.

326. The Delegation of Australia remarked that applying a different time zone for international applications would result in the undesirable situation of different time zones applying to applications filed by the Paris and PCT routes. This would impact on national law since the Patent Law Treaty may require a State to apply the same time zone to domestic applications as that applied to international applications. Furthermore, this could impact on other IP rights, as it could be considered inequitable that patent applicants could benefit from a time zone that was not available to applicants for other IP rights such as trademarks.

327. The Delegation of Brazil was sensitive to the rationale behind the proposal, which aimed at offering equal conditions for applicants in different time zones, but was concerned that any change could affect the balance between the rights enjoyed by individuals that apply only in national Offices and those who apply via the PCT unless the Office applied a different time zone from their country for domestic applications as well.

328. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) stated that its membership had shown some support for the option in paragraph 10(b) to set the most westerly time zone specifically for the International Bureau, since this option would offer flexibility, provide legal certainty and be fair for all applicants.

329. The Representative of American Intellectual Property Law Association (AIPLA) stated that AIPLA did not have a position on the issue of time zones, but provided two points of information concerning filing in the United States of America. First, an applicant in Hawaii could obtain a filing date by posting by express mail, a right AIPLA would not want prejudiced. Second, the deadline for filing was 12 midnight Eastern Standard or Daylight Time at the headquarters of the United States Patent and Trademark Office. In the summer, an applicant from Hawaii would need to file by 6 p.m. local time; no extra time was given due to a more westerly location.

330. The Working Group noted that there was no support for the proposals set out in document PCT/WG/7/25.

#### **PCT SEQUENCE LISTING STANDARD**

331. Discussions were based on document PCT/WG/7/9.

332. The Delegation of the European Patent Office, in its role as leader of the Task Force for the preparation of recommendations on the presentation of nucleotide and amino acid sequence listings based on eXtensible Markup Language (XML) for adoption as a WIPO standard, reported that the draft WIPO standard ST.26 had been informally agreed at the recent session of the Committee on WIPO Standards, but that no decisions had been taken, because the agenda for the session had not been adopted. It was hoped that the agreement would be formalized soon. The Task Force would now make a technical assessment of the requirements for transitional arrangements by the end of the year, with a view to presenting a report to the Committee in its 2015 session.

333. The Delegation of Japan thanked the European Patent Office for its role as leader of the Task Force and supported the proposed roadmap to consider the transition from ST.25 to ST.26 in the document.

334. The Working Group noted the contents of document PCT/WG/7/9.

#### **REVISION OF WIPO STANDARD ST.14**

335. Discussions were based on document PCT/WG/7/5.

336. The Delegation of the European Patent Office opposed the abolition of the category “X” for citing document in search reports, which was a harmonized standard in use for many years. From July 1, 2014, when the written opinion of the International Search Authority would be made available at 18 months from the priority date, the Delegation believed that all the advantages of abolishing category “X” would no longer apply, but the disadvantages would remain.

337. The Delegation of the United States of America acknowledged that there was no consensus on abolishing category “X” and considered that the new Standard should not be adopted unless all International Authorities were in agreement. The Delegation agreed that some of the advantages of abolishing category “X” would disappear when the written opinion of the International Search Authority became available at 18 months from the priority date, but if there were any agreement on adopting category “N” and “I”, the Delegation stated a preference for category “X” to be discontinued after a short transition period.

338. The Working Group noted the contents of document PCT/WG/7/5.

### **COLOR DRAWINGS IN INTERNATIONAL APPLICATIONS**

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

340. The Secretariat underlined that there was wide agreement on the fact that the current restrictions requiring black and white drawings were undesirable from the point of view of applicants, Offices seeking to examine applications efficiently and third parties trying to understand the invention. However, discussions appeared to be in a “catch-22” situation. There was little incentive and willingness to review the international legal framework and address the issue in the PCT while technical and legal barriers remained at the national level, yet the lack of provision of a solution in the PCT also meant that there was little incentive or direction to address those national barriers. So, the perfect solution, where all Contracting States changed their laws and IT systems to handle color drawings simultaneously, did not seem to be practical. The document addressed these problems by offering an approach which permitted processing of color drawings through the international phase and into the national phase for those designated States where that was permitted, while also providing a route to delivering black and white drawings to designated Offices for use where color drawings were not permissible. Specifically, the proposal would involve the steps set out in paragraph 19 of the document, where the filing of electronic applications with color drawings at any receiving Office willing to receive them in an appropriate electronic form would be permitted, which would likely mean allowing JPEG or PNG file formats, either in XML or embedded into a PDF file. All international phase processing would then be conducted in color, including the formalities examination, the international publication, the international search and preliminary examination. Finally, the proposal would allow the optional central submission of black and white alternative drawings for use in the national phase for those designated Offices that required black and white drawings. Alternatively, the applicant would be permitted to submit replacement sheets to a designated Office which so required at the start of the national phase. The ePCT system could assist this process in several ways. Firstly, by allowing a way for receiving Offices to receive and process electronic applications with color drawings, and secondly, by offering applicants an automated process for creating black and white conversions, allowing them to view the results of that automated process and decide whether it was sufficient or whether they would need to perform a more manual conversion instead. This could be done using facilities already in place for ePCT filings. Initial analysis had shown that any legal approach could be limited to modification of Annex F of the PCT Administrative Instructions. In terms of implementation of the proposal, specific changes and the timing of the implementation would be the subject of detailed consultations by PCT Circulars at a later date, where the timing would be based mainly on when the necessary systems could be in place, both at the International Bureau and at all International Authorities. July 2016 could be a possible likely earliest date for the first filings through this system. For this approach to work effectively, it would, however, be

necessary for all the International Searching Authorities to have at least some system in place for being able to see the color drawings and handle the processing for the purposes of international search and preliminary examination, even if a full system was not available.

341. The Delegation of Israel stated that it had initially supported the proposal of removing the restrictions to use only black and white drawings in international applications because it was difficult to explain some types of invention in certain technical fields. In order to keep pace with technology and processing of the international applications, it was necessary to offer more flexibility in terms of the physical requirements of international applications. Permitting the filing of color drawings in international application would contribute to making the PCT system more attractive for users. The Israel Patent Office began a process of change in 2012 when it became possible for its automated system for international patent applications to be able to handle color drawings for international applications, allowing substantive examiners to view international applications in color and facilitate understanding of the invention. Moreover, the Israel Patent Office had begun making changes to its legal framework, and technical systems to permit the filing and the processing of color drawings in the national phase, which should come into force in a couple of months. The Delegation concluded by supporting the way forward proposed by the International Bureau and hoped to see progress on this issue very soon.

342. The Delegation of Sweden hoped for solutions to make it possible to deal with color drawings in the PCT, which was of interest to users. However, the Delegation queried the proposals in the document to amend the Administrative Instructions, since Rule 11.13 required drawings to be black and white.

343. The Delegation of the United States of America supported the concept of including color drawings in the PCT and agreed in principle to the proposed way forward in the document, as it would be consistent with plans at the United States Patent and Trademark Office for implementing the patent end-to-end electronic processing system and would be in the interests of applicants and examiners. The Delegation recommended that some testing be performed prior to implementation, and indicated that the proposed July 2016 implementation could be achievable.

344. The Delegation of Japan supported the concept of allowing color drawings, but considered that the proposed legal approach of changing the Administrative Instructions, while allowing each Office to follow different practices, could cause confusion to users and Offices. Therefore, the introduction of color drawings should be studied further to set an appropriate time when a certain number of Offices would be able to starting implementing provisions to allow color drawings.

345. The Delegation of the European Patent Office supported the proposed way forward in the document and agreed that the July 2016 date seemed reasonable. The Delegation emphasized that color drawings should be included in databases used by examiners for searching.

346. The Delegation of the Republic of Korea supported the approach proposed in the document. Color drawings would grant more options for applicants, and allow more detailed and precise information in patent documents, enriching patent information to the benefit of the public. The Delegation also believed that all international processing should be made in color as the conversion from color to grayscale would inevitably result in the loss of details.

347. The Delegation of Portugal stated that its national law had recently been change to electronic filing of color drawings and was supportive of the proposal, which also provided flexibilities.

348. The Delegation of China believed that color drawings had advantages for some technical fields to provide an efficient explanation and sufficient disclosure of invention. However, if color drawings became permissible in the international phase, the Regulations should be amended to

clarify the legal effect of color drawings. The Delegation also suggested that black and white drawings should be required at the international phase, while permitting color drawings to be filed at the same time. Therefore, when entering the national phase, applicants could choose either black and white, or color drawings in accordance with the requirements of the designated Office.

349. The Delegation of Denmark supported the proposal, which users supported. The Danish Patent and Trademark Office was already able to deal with color drawings and the proposed July 2016 seem reasonable.

350. The Delegation of Brazil favored the proposal to use color drawings.

351. The Delegation of Austria also supported the proposal and indicated readiness for implementation on July 2016.

352. The Representative of the Japan Patent Attorneys Association (JPAA) supported the proposal and commented that the Japan Patent Office received color drawings for international applications but converted them into black and white drawings, which sometimes resulted in the loss of features, especially in the chemical field. To prevent this from occurring, the Representative suggested that both color and black and white drawings could be filed and included in the international publication. If a designated State allowed color drawings, these would be used; otherwise, the black and white drawings filed by the applicant would be used. This would therefore safeguard against loss of rights when performing a conversion from color to black and white.

353. The Representative of the All-China Patent Agents Association (ACPAA) supported the comments made by the Representative of the Japan Patent Attorneys Association (JPAA).

354. The Secretariat, in response to the question raised by the Delegation of Sweden about amending Rule 11.13, indicated that this was a possible way forward and would ensure uniformity across the whole system. However, if a proposal were made in this regard, there would be difficulties about agreeing a date for entry into force as it not only concerned the international phase, but also affected national laws in Contracting States. However, for the purposes of the international phase, the Secretariat considered that this did not matter as Rule 26 only required the receiving Office to check compliance with the physical requirements set out in Rule 11 to the extent that compliance therewith was necessary for the purpose of reasonably uniform international publication. If the application were published in color, then the fact that it had been submitted in color no longer mattered as it ceased to be a defect that the receiving Office should check. However, Rule 11.13 could not be changed easily, because designated Offices needed the current wording of that Rule to allow them to object to the color drawings in the national phase. But for the international phase, this was not a problem and there were already parts of Rule 11, which were effectively ignored for the purposes of the international phase.

355. The Working Group approved the way forward as set out in paragraphs 19 to 28 of document PCT/WG/7/10.

#### **OPTIONS OR CONSEQUENCES WHEN INVITING THE APPLICANT TO SELECT A COMPETENT INTERNATIONAL SEARCHING AUTHORITY AFTER THE CHOSEN INTERNATIONAL SEARCHING AUTHORITY DECLARES ITSELF NON-COMPETENT**

356. Discussions were based on document PCT/WG/7/22.

357. The Delegation of the United States of America outlined that the document proposed to amend the Receiving Office Guidelines dealing with the situation where, on filing an international application, the applicant had not selected a competent International Searching Authority. This was a problem the United States Patent and Trademark Office was

encountering with increasing frequency. There were three scenarios where the applicant may not have selected a competent International Searching Authority. The first was where they simply had no indication of the chosen International Searching Authority. The second one was where they chose an International Searching Authority that was not competent for the particular receiving Office. The third was where an applicant chose an International Searching Authority offered by that receiving Office, but which had some competency limitations, whether due to field of technology or volume of applications. The document therefore proposed that, where the receiving Office was in a position to invite the applicant to select a competent International Searching Authority, that an invitation would have a default International Searching Authority indicated in the event that the applicant did not respond. This would avoid unnecessary delay in the international processing.

358. The Delegation of Israel indicated that the Israel Patent Office in its capacity as a receiving Office selected a number of competent International Searching Authorities, and had encountered similar situations of an applicant declaring a non-competent Authority. The Delegation therefore supported the proposal in the document.

359. The Delegation of the European Patent Office supported the proposal.

360. The Working Group approved the proposed modifications to the Receiving Office Guidelines set out in the Annex to document PCT/WG/7/22.

#### **TREATMENT OF A SEQUENCE LISTING SUBMITTED IN AN INTERNATIONAL APPLICATION ON THE INTERNATIONAL FILING DATE**

361. Discussions were based on document PCT/WG/7/23.

362. The Delegation of the United States of America explained that the document was directed to the issue of an incorrect or nonexistent indication by an applicant of a sequence listing as forming part of the international application, and whether the current framework provided an adequate remedy. The issue had been discussed at the Meeting of International Authorities in February 2014. Proper characterization of a sequence listing for an international application could be confusing for applicants. Too frequently applicants were unaware that a sequence listing was a part of the international application in the check list of the request and improperly indicated it as an accompanying item only. Unfortunately, often the error was not recognized until the national or regional phase, which could have fatal consequences in the national/regional phase, where the disclosure did not provide sufficient support or information concerning those sequences. Additionally, proper characterization of the sequence listings seemed to be an area of confusion for the International Bureau regarding publication of the international application, with international applications being published incorrectly in several scenarios, such as without any indication of a sequence listing part of the international application, with the sequence listed as part of the application when it was not indicated as such on the request, and with an indication of the wrong format, for example, in image or text as part of the application. The United States Patent and Trademark Office had recently reviewed 12 applications which contained errors related to the initially filed sequence listing. In seven of the 12 applications, the error by the applicant was not recognized until the national phase. Also, in seven of the 12 applications, the sequence listing was provided on the international filing date, but was indicated incorrectly as an accompanying item only. In four additional applications, the request contained no indication as to the status of the sequence listing. Nonetheless, the publication indicated that the sequence listing was part of the application in six of the 12 applications. Finally, in one application, the request indicated only the PDF version of the sequence listing as part of the application, but in contrast, PATENTSCOPE and the international publication indicated that both the PDF and the text versions of the sequence listing were part of the application. Consequently while there were inconsistencies of the status of the sequence listing, in half the applications reviewed, these inconsistencies would not have been obvious to any national or regional Office that relied solely on the publications for status determination without otherwise going to the request form itself. In view of the fatal defect trap

to applicants and the potential confusion for Offices as to what properly constituted the international application as filed, the United States of America was proposing that any sequence listing filed on the international filing date, but which was not specifically indicated in the request, be treated as part of the international application. It was therefore proposed to modify the Receiving Office Guidelines as detailed in paragraph 19 of the document. The document also included a brief description of the legal provisions at issue, the most compelling of which was Rule 5.2, which stated "Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the description shall contain a sequence listing..." The document also analyzed various scenarios which might exist in paragraphs 12 to 18. Again, the proposal was to amend paragraph 225 of the Receiving Office Guidelines, so any sequence listing filed with the international application was considered part of the international application. The Delegation noted that this paragraph indicated the receiving Office would make a corresponding *ex officio* correction to the request and that the applicant would thereby be notified of such change by through Form PCT/RO/146. In that way the applicant would be put on notice and in the event that the applicant were to disagree with the change, the applicant would be in a position to contact the receiving Office and resolve the situation.

363. The Delegation of Israel agreed with the observations of the Delegation of the United States of America that proper characterization of an image or text format sequence listing for an international application might be confusing for applicants and for International Authorities. Since in most international applications were filed electronically, any accompanying sequence listing was already indicated as part of the description, the Delegation considered that automatic inclusion of the sequence listing as part of international application would be perceived as a simplification for all involved parties and the proposed changes to the PCT Receiving Office Guidelines would be sufficient to bring the proposed change into effect.

364. The Delegation of the European Patent Office in principle supported a more streamlined proposal for the filing of sequence listings, but had one concern with the proposal, namely, that it could reintroduce "mixed mode" filings, whereby an applicant files the sequence listing on paper and in electronic form at the same time. The Delegation wished to foresee flexibilities for situations where an applicant had indicated that a sequence listing should not be part of the application at the time of filing that the sequence listing could be treated to this effect, and also that an applicant should be able see any *ex officio* corrections and ask the receiving Office to revise the correction if this was not what the applicant intended.

365. The Delegation of India expressed the view that if no indication was made for one or more sequence listing provided on the international filing date then, by default, that sequence listing should be taken to be part of the international application and be processed accordingly. This would avoid the defect whereby the applicant failed to provide the indication for the sequence listing. However, if such a defect went unnoticed during the international phase, the domestic law should prevail in the national phase.

366. The Delegation of the United States of America, in response to the concerns expressed by the Delegation of the European Patent Office, emphasized that the basis in the previous Part 8 of the Administrative Instructions for submitting electronic sequence listings together with otherwise paper international applications had been abolished from July 1, 2009, and this was not affected by the proposal. A sequence listing supplied on electronic media accompanying a paper application could not therefore be considered to be part of the application, as the legal basis for "mixed mode filings" no longer existed. Where the applicant had completed the request correctly, an image was indicated as part of the application and the text file was indicated as an accompanying item along with a statement of identity; in that case, there would be no need to consider the text file as part of the application. In this regard, the Receiving Office Guidelines were flexible and were a guide to Offices. The Delegation also acknowledged the concerns of the European Patent Office about making *ex officio* corrections

and the need to enter into a dialogue with the applicant who was dissatisfied with any corrections. The Delegation therefore agreed to make some revisions to the proposal to clarify certain scenarios and undertake a consultation with Offices by means of a Circular.

367. The Chair summarized by indicating that most delegations which took the floor were supportive of the inclusion of a sequence listing as part of an application in instances where the particular check box had not been checked in order to avoid the situation where the applicant would be denied a part of the specification at filing. Generally speaking, delegations considered the proposed changes to the PCT Receiving Office Guidelines to be sufficient, but some further consultation on the precise wording would need to take place the International Bureau, the United States Patent and Trademark Office and the European Patent Office to ensure the amendments provided adequate clarity.

368. The Working Group agreed that the objectives of the proposals in document PCT/WG/7/23 could be validly achieved by modification of the Receiving Office Guidelines and supported the principle of the proposals, subject to the comments raised by delegations. A revised proposal could be the subject of consultations by way of a PCT Circular, based on a revised draft to be provided by the Delegation of the United States of America.

#### **CLARIFYING THE PROCEDURE REGARDING THE INCORPORATION BY REFERENCE OF MISSING PARTS**

369. Discussions were based on document PCT/WG/7/19.

370. The Secretariat recalled that the Working Group had discussed a proposal by the European Patent Office at last year's session (document PCT/WG/6/20) to address the different interpretations that Offices had on the provisions related to incorporation by reference of missing parts where the application included erroneously filed elements and then the applicant requested incorporation by reference from the priority application to replace the wrongly-filed claims or description elements. The Secretariat indicated that some Offices interpreted these provisions as not permitting incorporation in cases where there was a complete missing claims or description element, since reference to a missing part implied the completion of an incomplete element and pointed out problems, such as the examiner at the International Searching Authority facing two sets of claims, often unrelated to each other. However, other Offices permitted this practice of incorporation of complete claims and description elements, as otherwise an applicant would be allowed to incorporate when an element was missing, but not when it had been erroneously filed, and therefore the applicants would be penalized for trying to file a complete application but getting it wrong. More recently, the European Patent Office had prepared a document for the Meeting of International Authorities, which included a questionnaire on practice on incorporation by reference of missing parts. Following the discussions by International Authorities, the International Bureau had consulted the full membership of the PCT with this questionnaire, which was reproduced in the Annex to the document. In short, replies to this questionnaire showed differing opinions on whether the practice of incorporating complete sets of claims and/or a description should be permitted and also differing views on all the related issues outlined in the questionnaire. Therefore, given the lack of consensus among Member States, there was no obvious solution to try to resolve these diverging practices. The document therefore proposed, in paragraphs 15 to 17, that the International Bureau would continue to work with any Offices that were interested in the issue to try and achieve greater consistency and legal certainty for applicants with a view to preparing a document for the next Working Group. In particular, paragraph 16 proposed a possible solution that could be explored, which would involve amending the Regulations to require receiving Offices to permit the incorporation by reference of a full specification as a missing part, and provide the basis for International Searching Authorities to charge a further search fee in such cases where they had already started the work on the previous set of claims, and also it would be clarified that the national law of designated Offices could consider that the incorporation had not taken place if this was not permitted under their interpretation. This would therefore

produce a more uniform practice for receiving Offices, even if the incorporated elements could then be disregarded in the national phase. Finally, on the question of validity under PCT Article 8 of a priority claim with the same date as the international filing date, as this Article referred directly to provisions of the Paris Convention, this issue would appear to be more a matter of how to interpret Article 4(C)(2) of the Paris Convention. The document therefore raised the question of whether this should be explored in the Working Group or rather in the WIPO Standing Committee on the Law of Patents.

371. The Delegation of the United States of America stated that the ability of applicants to add a second description, set of claims and/or drawings through the incorporation by reference was allowed by the language of Rule 20.5(a), and that the matter had been decided by Member States at the first session of the Working Group (see paragraphs 126 and 127 of the report of the session, document PCT/WG/1/16). In view of the discussion at previous sessions of the Working Group, the Delegation was surprised by some responses to the questionnaire and the number of Offices which had indicated that they would not allow an applicant to include an entire set of descriptions and claims from a priority application if one were present in the international application. It could not be understood how an Office could hold the position that this matter had not been agreed upon when all Member States had previously agreed to the report of the first session of the Working Group, where it had been specifically indicated that such a practice was allowed, and they also agreed to changes to the Receiving Office Guidelines to address how such submissions were to be treated. The Delegation questioned why Member States had agreed to detailed instructions in the Guidelines at the time if these submissions were not intended to be allowed by the provisions of Regulations. This could not be considered to be a mere oversight. As the Delegation had stated on earlier occasions, an interpretation of the provision which would not allow the incorporation by reference in these situations would establish an inequitable treatment of applicants in similar but slightly different situations. Under this interpretation, an applicant who did not submit a description and claims, whether inadvertently or intentionally, would be allowed to submit them at a later stage by way of incorporation by reference, whereas an applicant who attempted to file a specification but inadvertently submitted the wrong specification, would not be allowed to submit the correct elements and would in essence be penalized for attempting to file a complete application, albeit the wrong application. This latter situation, where an applicant omitted something through an honest mistake and in respect of which the interpretation of some Offices would prohibit incorporation, was in fact the type of situation that Member States were attempting to address when they adopted the practice of incorporation by reference. In view of the fact that this issue had previously been discussed and agreed by the Member States, and especially in view of the highly inequitable nature of the interpretation, whereby such an incorporation was not allowed, the Delegation supported a clarifying amendment to the Regulations to settle any perceived discrepancies between the Regulations and the practice set forth in the Receiving Office Guidelines. Specifically, it would appear that most of the confusion on this matter derived from the presence of the word "otherwise" in the first sentence of Rule 4.18 and as such, the Delegation proposed that this should be deleted. The Delegation also had concerns about the proposal in paragraph 16 that the concept be allowed in the receiving Office procedure, but that a designated Office could then later not recognize the incorporation by reference as this would cause legal uncertainty for applicants in the filing of their international applications. The Delegation underlined that it continued to be sympathetic to the concerns raised with respect to this issue, and its effect on the situation where the later submitted description and claims were forwarded to the International Searching Authority after it had begun to establish the search report. The Delegation therefore looked forward to discussing this issue further with the International Bureau and other International Authorities, especially as it related to the United Kingdom and United States of America joint PCT 20/20 proposal for Chapter I amendments. In particular, the Delegation was willing to explore the idea of fees being charged for these incorporations, but that applicants had to be treated in an equitable and fair manner and in a way that the provisions on incorporation by reference practice were designed to address.

372. The Delegation of Sweden supported the suggestions for further work in paragraph 15 of the document, but was hesitant about the suggestion from the International Bureau in paragraph 16. As for the issue about same day priority claims, the Delegation did not believe that the Working Group was the appropriate forum to discuss questions relating to the Paris Convention.

373. The Delegation of the European Patent Office recalled that incorporation by reference was introduced into the PCT on the basis of the Patent Law Treaty (PLT), where there was no evidence of a basis which would allow for incorporation by reference of missing parts when the original filing was erroneous. The proposal the European Patent Office had submitted to the Working Group last year had aimed to review the Receiving Office Guidelines to align them with the Regulations, as it had hesitations regarding the present wording of the Guidelines, which was shared by a number of other receiving Offices. The present situation showed widespread disagreement with respect to the interpretation of Rule 20. There was therefore a need for further clarification of Rule 20, since the current situation led to legal uncertainty for applicants entering the national phase whenever the designated Offices would actually reconsider the decision taken by the receiving Office. The Delegation reported that the Committee on Patent Law had discussed this issue the previous month, where a majority of Member States of the European Patent Organisation believed that Rule 20 should not allow for missing parts that did not qualify as such under the practice and interpretation of the European Patent Convention. These Member States were, however, also in agreement that more clarity should be introduced to Rule 20. However, there was no discussion as to whether this clarity should allow erroneous filings, as suggested in paragraph 16, or actually make clear that they should not be allowed. The Delegation was supportive of the proposals from the International Bureau in paragraph 16, provided that it was made clear that the designated Offices could, in any event, review decisions by the receiving Offices which had been taken on the basis of erroneous filings, but it needed to consult with its membership before having a definite position on this matter. Finally, with respect to paragraph 17, the Delegation agreed with the idea having same date priority claims discussed in the framework of the WIPO Standard Committee on the Law of Patents.

374. The Delegation of Poland stated that the Polish Patent Office was of the opinion that filing a missing part without affecting the filing date should be admissible, but only when the part was completely contained in the application of which priority was claimed. This view was in line with the national legal system in Poland and with the practice applied by its Office acting in the capacity as a receiving Office. The Delegation expressed the view that incorporation by reference of a whole new description and claims as a missing part was not allowed under Rule 20. Any interpretation which extended the scope of incorporation by reference beyond the provision of PCT would undermine legal certainty. As for claiming the priority of an earlier application bearing the same date as the international filing date, the Delegation had serious doubt whether acceptance by some Offices of such priority claims was in line with provisions of the Paris Convention and PCT Receiving Office Guidelines. This discrepancy in practice between various Offices in this respect therefore needed to be discussed thoroughly and harmonized.

375. The Delegation of India emphasized that the priority date was a substantive issue, which should not be compromised. Further, the missing parts provisions should not cover the incorporation of an entire completed specification, as this could present serious problems when this was not allowed when entering the national phase.

376. The Delegation of Brazil stated that its views were aligned with those expressed by the Delegations of the European Patent Office and Poland.

377. The Delegation of Germany stated that it was hesitant about the proposal in paragraph 16 of the document, but otherwise it agreed with the intervention made by the Delegation of the European Patent Office.

378. The Delegation of the United Kingdom stated that, in its view, Rule 20 did not preclude the filing of a full specification as a missing part, but it agreed that clarification was needed, and in principle, supported proposed solution in paragraph 16 of the document.

379. The Delegation of Israel supported the intervention made by the Delegation of the European Patent Office.

380. The Delegation of Norway supported the further work proposed in paragraphs 15 and 16 of the document to avoid differences in the practice of receiving Offices. However, due to the need for legal certainty and predictability for third parties, the Delegation stated a preference to clearly exclude the possibility of incorporation of a complete new specification by reference.

381. The Delegation of Canada stated that, with respect to paragraph 17 of the document concerning the interpretation of the Paris Convention on the validity of a priority claim based on an earlier application with the same filing date, the Delegation considered that it would be correct to refer the matter to the Standing Committee on the Law of Patents. However, it might be efficient for the Working Group to try to arrive at a decision that could then be proposed to the Standing Committee on the Law of Patents, rather than leaving this body to reach a consensus.

382. The Delegation of China stated that its understanding was that the Regulations did not allow the incorporation by reference of an erroneously filed specification, and suggested the Working Group should reach an opinion on this matter. As for the issue of interpretation of the Paris Convention with regard to same date priority claims, the Delegation believed this matter should be referred to the Standing Committee on the Law of Patents, but it would be efficient for the Working Group to propose a decision before the referral.

383. The Delegation of the United States of America agreed with the views expressed by the Delegation of Canada with regard to the Working Group making a recommendation to the Standing Committee on the Law of Patents on the validity of a priority claim based on an earlier document with the same filing date.

384. The Chair summarized by indicating that, in respect to the interpretation of priority claims under the Paris Convention, there was no strong indication to refer the matter to be considered by the Standing Committee on the Law of Patents, and competent WIPO body for taking a decision on the matter was the Assembly of the Paris Union. As for the issue of incorporation by reference of missing parts, opinions of delegations were divided. The Chair therefore suggested that the International Bureau worked with interested delegations until the next session of the Working Group to resolve this issue. However, any clarification would appear to require some members of the Working Group making significant concessions.

385. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) believed that the language in the provisions relating to incorporation by reference at present allowed wrongly-filed claims and description elements of an international application to be replaced with the specification of the priority document.

386. The Representative of the American Intellectual Property Law Association (AIPLA) understood the differences between the practices on missing parts in Europe and the United States of America, but there should be a way to resolve this. The Representative highlighted a situation when a provisional application was filed under practice in the United States of America that had element A plus B, and then the final specification proposed A plus B plus C claiming priority from the provisional application, but the applicant had forgotten to incorporate A plus B. This incorporation should be possible as the earlier document had been referenced. However, the Representative noted that a more frequent problem was when drawings were missing, and it should be possible to correct a later filed application by incorporating a missing drawing that was present in the provisional application.

387. The Working Group requested the International Bureau to continue to work with interested Offices on the incorporation by reference of missing parts and present a document for the next session of the Working Group. It further requested the International Bureau to prepare a working document on the issue of same day priority claims for consideration by the Working Group at its next session.

## **RIGHT TO PRACTICE BEFORE THE RECEIVING OFFICE OF THE INTERNATIONAL BUREAU**

388. Discussions were based on document PCT/WG/7/13.

389. The Secretariat explained that in 2013, the receiving Office of the International Bureau had received around 750 international applications where the applicant wished to appoint an agent who was not competent to act in accordance with existing Rules 83 and 90, amounting to about 7 per cent of applications received at the International Bureau. In most of these cases, the agent was professionally qualified to act before his own national Office, but not the Office which corresponded to the residency or the nationality of the applicants. These agents therefore could not act as an agent for reasons that had no practical bearing on their ability to perform their relevant duties or communicate reliably with the International Bureau. Consequently, the document proposed to amend Rule 83.1 *bis*, as set out in the Annex, to give the rights to practice before the receiving Office of the International Bureau to any person who had the right to practice before the national Office of any PCT Contracting State or regional Office acting for any PCT Contracting State, irrespective of the nationality or the residency of the applicant. If so appointed, such a person would, as at present, also have the right to act before the International Searching Authority and any International Preliminary Examining Authority during the international phase. The Secretariat further added that it had been pointed out that, in some States, there were no professional requirements to act before their Office and the potential effect of that might be that this amendment might open the door to unqualified persons offering their services, which was not the intention of the proposal. The intention was to have qualified agents acting before the International Bureau, but without the concern over which particular Office before which the agent had the right to practice. This issue could be resolved by way of further drafting changes, depending on the views of the Working Group.

390. The Delegation of the United States of America stated that it had concerns with the proposal and the resulting ramifications, particularly to International Authorities and users. Under the current provisions, there were certain safeguards in place for the Authorities and the applicants with regard to unscrupulous parties acting in a representative capacity. Specifically, if an issue were to arise with the quality of the representation, the applicant would have some recourse through their receiving Office and would have the ability to request action by the receiving Office against the representative. However, under the current proposal, those safeguards were virtually eliminated. A review of the Applicants' Guide revealed that there were numerous Member States which merely required a party to be a resident in the State in order to practice before their national Office, and at least three Offices had no restrictions whatsoever on who could practice before their Office. Therefore, under the wording of the present proposal, the result would be that any person could represent an applicant from any State before the International Bureau, and in turn before any International Authority. This went too far to address the situation which the proposal intended to remedy. The Delegation agreed with the comments in paragraph 9 of the document concerning the undesirability of limiting the proposal to Rule 19.4 cases, as this would only exacerbate the situation of removing all safeguards concerning representation and encouraging intentional filing at non-competent receiving Offices. The Delegation could therefore not support a further limitation for the proposal only to Rule 19.4 cases.

391. The Delegation of Australia wished to add two further comments to those made by the Delegation of the United States of America. First, as an alternative, the filing agent could be given the right to practice before the International Bureau solely for the purpose of rectifying the error. This would generally involve nominating an agent who would be competent to practice

before the International Bureau under the current Rules, but nothing more. Second, the Delegation suggested that the International Bureau educate agents in order to reduce the likelihood of errors of nominating non-competent representatives in the future.

392. The Delegation of Norway stated that it had no provisions for its agents and believed that the proposal should be clear on what the limitations were for agents.

393. The Delegation of Spain shared the views expressed by the Delegation of the United States of America.

394. The Delegation of the European Patent Office agreed with the comments expressed by the Delegation of the United States of America.

395. The Delegation of China stated that filing an international application at a non-competent receiving Office could escape a country's security requirements and violate the rules about patent agents. If the practice of allowing a non-competent agent to act before the International Bureau in its capacity as a receiving Office were permitted, the applicant could exploit this advantage, which may not be to the benefit of the applicant.

396. The Delegation of India suggested that, as the issue involved patent agents, Member States could consult with their stakeholders before the next session of the Working Group.

397. The Delegation of the Russian Federation shared the concerns expressed by the Delegation of the United States of America and added that the proposed modifications to Rule 83.1 *bis*(a) would have consequences on the application of Rule 83.1 *bis*(b) in the Russian Federation, as its national law required a foreign patent attorney to be certified in the Russian Federation if he was going to represent an applicant.

398. The Representative of the International Federation of Industrial Property Attorneys (FICPI) expressed sympathy for the alternative suggested by the Delegation of Australia in order to avoid the situation where rights were lost.

399. The Representative of the Japan Patent Attorneys Association (JPAA) understood the background behind the proposal, but expressed concern since it would allow every agent or representative, regardless of nationality, to be able to represent an applicant before the International Bureau when acting as a receiving Office. This could result in a possibility that the applicant would not have adequate protection in his home country, due to lack of knowledge of local laws by the foreign agent, noting that these laws had not been harmonized. One example was the question of so-called self-designation of PCT applications. In Japan, when the applicant wished to file a foreign application after filing a domestic application on the same intervention, the domestic application was withdrawn after one year and three months under Japanese patent law, Article 42, which was stipulated according to PCT Article 8(2)(b). To avoid this situation, it was necessary to exclude the designation of Japan in the PCT application form at the time of filing, or it was necessary to file an international application at the initial stage, not filing a domestic application. As this was a particular circumstance under the Japanese patent law, appointing a foreign agent not knowledgeable of this mechanism could result in the applicant not being protected well in Japan. Another example was the grace period, where the time period was not harmonized. In the United States of America, this was 12 months from the priority date; in Japan, the European Patent Office and China, the period was six months. In Japan, this was based on the filing date, so an agent not knowing the different national practices might result in lack of patent protection in the home country of the applicant. The Representative therefore wished the International Bureau to consider these matters further by performing a study on this issue.

400. The Representative of the All-China Patent Agents Association (ACPAA) supported the views expressed by the Japan Patent Attorneys Association (JPAA). ACPAA considered that this proposal could be helpful for simplifying the appointment procedure for practice before the

IB, however, the existing provisions had been in force for a long time and were reasonable in that patent attorneys in the home country of the applicant had the advantages of using the same language and being geographically close to the applicant while practicing before the International Bureau. Moreover, adoption of this proposal might adversely impact the practice before International Bureau by patent attorneys in countries where English was not widely used. ACPAA therefore suggested that the Working Group undertake further consideration of this proposal.

401. The Representative of the American Intellectual Property Law Association (AIPLA) agreed with the alternative suggested by the Delegation of Australia and the remarks made by the other observer organizations. AIPLA noted that the limitation proposed by Australia would avoid the problem of an initially incompetent filing from encountering problems downstream as the applicant continued through the process, increasing the burden on the national Offices, as well as jeopardizing applicants' rights. The proposal by the Delegation of Australia would limit the potential damage of a non-competent agent by correction of the initial error.

402. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) stated that EPI was consulting its membership on the proposal and would communicate its position at a later date. The Representative understood the motivation by the proposal but believed the change would have the effect of altering the landscape of professional representation.

403. The Working Group noted that there was no support for the proposals set out in document PCT/WG/7/13.

#### **GENERAL POWER OF ATTORNEY**

404. Discussions were based on document PCT/WG/7/16.

405. The Secretariat provided some background to the document by stating that, before 2004, all applicants had to sign international applications. Where an agent signed an application, a power of attorney had to be submitted signed by all the applicants. Since 2004, Offices had been able to waive this requirement and many Offices had taken advantage of that possibility and no longer required the furnishing of powers of attorney at the time of filing. As a result, powers of attorney were no longer on file, neither at the level of the receiving Office nor consequently at the International Bureau. However, in case of withdrawals filed with the International Bureau, the International Bureau needed to regularly invite agents to submit powers of attorney signed by all applicants for the notice of withdrawal to be effective. In addition, due to an oversight in 2002 when the provisions were adopted to allow for this waiver, the agent was not able to comply with this invitation from the International Bureau by submitting a copy of the general power of attorney to the International Bureau that he had had originally deposited with the receiving Office; the International Bureau was overlooked in Rule 90.5(b) to be one of the possible recipients of a copy of a general power of attorney. The document was therefore proposing to fix this problem. Moreover, while the International Bureau looked at that provision, it was noticed that the International Searching Authority was mentioned as one of the possible recipients of a copy of a general power of attorney even though it was not possible to file a notice of withdrawal with an International Searching Authority. It was therefore proposed to delete the International Searching Authority from Rule 90.5(d).

406. The Delegation of the United States stated that it could support the proposal, but had some concerns where general powers of attorney were already on the file held by the receiving Office, the International Authority or the International Bureau, where the general power of attorney could be received by accessing the electronic files. Therefore the Delegation suggested a clarification at the end of Rule 90.5(d) to state “, when that Office/Authority/Bureau is not already in possession of that copy as such”. In other words, the applicant did not have to submit a copy if it was already on the file of the Office or Authority with which the applicant filed the withdrawal.

407. The Working Group approved the proposals set out in the Annex to document PCT/WG/7/16 with a view to their submission to the Assembly for consideration at its next session, in September 2014, subject to possible further drafting changes to be made by the Secretariat, including a possible clarification to Rule 90.5(d) to the effect that there would be no need to submit a copy of the general power of attorney if the Office already had it in its possession.

#### **OMISSION OF CERTAIN INFORMATION FROM PUBLIC ACCESS**

408. Discussions were based on document PCT/WG/7/18.

409. The Secretariat informed the Working Group that the International Bureau had been faced with situations where an applicant had submitted certain data or documents, either as part of or together with his international application, where these data or documents contained certain sensitive personal information which the applicant would rather not have published or made publicly available. Examples of such information included medical certificates, credit card details, social security numbers and trade secrets. In many of these instances, all parties involved felt that it did not seem right to make such information publicly available. Yet the PCT lacked a general legal basis to exclude such information from being published and/or made publicly available. Having studied relevant provisions of various national laws, it appeared to the International Bureau that a fair number of countries provided legal remedies to prevent such data from becoming publicly available. The document therefore proposed to add similar remedies to the PCT. The proposed rule changes aimed first of all at allowing the Authority specified for supplementary search and the International Bureau in Rule 9 to bring to the attention of the applicant that certain expressions, statements, or other obviously irrelevant matter had been included in the international application and to invite the applicant to voluntarily correct this. This would, however, have limited practical impact because of the limited scope of Rule 9. Secondly, provisions were proposed to allow the applicant to request that certain sensitive and personal information would not be published or made publicly available. Thirdly, additional rules were proposed that would spell out the right of receiving Offices and International Searching Authorities to provide, if they so wished, access to their respective files, a right already contained in Article 30. At the same time, the proposed rules would clarify that access to the file held by those Offices and Authorities would exclude access to any information in respect of which access to the file of the International Bureau had also been withheld from public access. This would avoid that information that was declared sensitive by the International Bureau becoming available through access to the file of the receiving Office or the International Searching Authority.

410. The Delegation of the United States of America supported the proposal to amend Rule 9.2 to allow the International Bureau and Supplementary International Searching Authority to bring subject matter not allowed in an international application under Rule 9.1 to the attention of the applicant. The Delegation also supported the addition of proposed Rules 94.1 *bis* and 94.1 *ter* to clarify when the receiving Office and International Searching Authority may provide access to an application file. However, while the Delegation agreed in principle with the proposed amendments to Rules 48.2 and 94.1, it had concerns regarding their breadth. While applicants should be able to prevent disclosure of certain information which might have been inadvertently disclosed in an application, including proprietary information and personal information, such as credit card numbers, bank account information and government identification numbers, national practice provided a mechanism whereby applicants could request that such information be expunged from an application file when it was realized that such information had been inadvertently included therein. However, the requirements in the United States of America for what might be excluded from public disclosure were more stringent than the proposal. For example, the United States Patent and Trademark Office would not expunge any information forming part of the original disclosure or any information unless it had been established that the information was unintentionally submitted, was not material to a determination of patentability and would cause irreparable harm. However, under the language of the present proposal, it would be enough that applicants established that the disclosure would merely prejudice the

personal or economic interests of any natural person or legal entity. Under such a standard, it could be conceivable that a prior art reference disclosed in the initial description would be considered to prejudice the economic interests of the applicant because it could be combined with another piece of prior art used in an inventive step rejection of the claimed invention, and therefore be removed from the application file. The Delegation also questioned the inclusion of language in Rule 94.1(e) that would provide any person authorized by the applicant with the ability to withhold information or to withhold access to information contained in an application file if that person had no other authority concerning the application. Therefore, this ability should be restricted to the applicant only, as was the case in proposed Rule 48.2(1) with respect to preventing publication of certain subject matter. The Delegation reiterated its sympathy with the aims of the proposal and could possibly support such a proposal if it set forth a stricter set of requirements. In that regard, if the proposal were adopted, consideration should be given to amending the Administrative Instructions to include a discussion of what types of material would be proper for treatment under the proposed amendments to Rules 48.2 and 94.1.

411. The Delegation of Japan supported the purpose of this proposal, but considered that the proposed revision to Rule 9.2 was not necessarily required, as it was the role of the competent receiving Office to request corrections from the applicant.

412. The Delegation of Germany agreed with the need to protect personal information in certain cases. However, the proposed threshold for omission was too low. Instead of the proposed prejudice test, a balancing test could be used. Personal or otherwise sensitive information should only be excluded from publication and file inspection if the legitimate interest of the natural person or legal entity concerned clearly prevailed over the public interest in the disclosure of the respective information. In this regard, the public had a legitimate interest in knowing all information relevant to a decision on a patent application as only in this way could it assess whether the patent was valid or not, an important factor, bearing in mind that the patent granted exclusive rights to its owner.

413. The Delegation of the European Patent Office agreed with the comments expressed by the Delegations of the United States of America and Germany. The Delegation agreed with the proposed amendments to Rule 9, but believed that the scope of the proposal under Rules 48 and 94 was too wide in allowing any information to be omitted from publication or withheld from public access that could prejudice the personal or economic interests of any natural person or legal entity. The Delegation therefore proposed that the scope of both these Rules should be revised and the Administrative Instructions could list the types of information, such as bank details and health certificates, that could be treated under the provisions and include guidance on what kind of information could be taken out of the file that was accessible to the public, given the need to balance the rights of the applicant and third parties.

414. The Delegation of India asked about the case of a court order demanding that access to information in the file be provided where that information had been withheld from access to the public.

415. The Secretariat, in response to the question raised by the Delegation of India, indicated there was no explicit provision in the PCT on the matter of access to information by a court. However, as a preliminary indication, it would appear that a court in the competent jurisdiction would be entitled to gain access to this type of information.

416. The Chair summarized that there was support in principle for a mechanism to allow omission of certain information in a file from public access, but delegations considered the proposals were too broad in scope and could be developed further to provide more specificity and detail to clarify what could be omitted from access by the public. The Chair also considered that the proposals should be dealt with as a package rather than amending Rule 9.2 at this stage, which had received support from delegations.

417. The Representative of the American Intellectual Property Law Association (AIPLA) welcomed the proposal, which would avoid users suffering the indignity of private information being inadvertently made public. However, the Representative considered that the extent of the proposal with regard to deletion of a trade secret or technical information was overbroad and should either require a high burden of proof from the applicant, or this information to be excluded from the proposal. Otherwise, there could be a risk that an applicant included information which he first believed necessary for sufficient disclosure of the invention, but then he requested deletion when it was realized that this information was not necessary to carry out the invention, yet this information would be useful to third parties.

418. The Working Group agreed that the International Bureau should consider the proposals further, taking into account the comments made by delegations.

#### **DECLARATIONS OR OTHER EVIDENCE RECEIVED IN THE CONTEXT OF A REQUEST FOR RESTORATION OF THE RIGHT OF PRIORITY**

419. Discussions were based on document PCT/WG/7/17.

420. The Secretariat introduced the document by explaining that, where an applicant submitted declarations or other evidence in support of a request for restoration of the priority right, the Receiving Office Guidelines already encouraged receiving Offices to forward such declarations or other evidence to the International Bureau, together with the request for restoration, so that the International Bureau could make them available to designated Offices. Since the Regulations did not clearly require the forwarding of such documents to the International Bureau, it was proposed to make the forwarding of such documents a specific requirement for receiving Offices under the Regulations. This would ensure that the International Bureau could always provide full access to any submitted declarations or other evidence to those designated Offices that would wish to review the decision by receiving Offices on the restoration of the right of priority for the purposes of the national phase.

421. The Delegation of Israel supported the proposal and indicated that the practice of the Israel Patent Office acting as a receiving Office was to submit the entire file, including the statement of reasons, as well as any declarations and other evidence received by the receiving Office to the International Bureau, as required by the Receiving Office Guidelines, in order to enable the designated Office to perform the limited review of the decisions by the receiving Office.

422. The Delegation of Japan supported the proposal and informed the Working Group that preparations were underway in Japan to introduce the restoration of right of priority in the first half of 2015. The Japan Patent Office was planning this system based on the PCT Receiving Office Guidelines that enabled copies of declarations and documents providing supporting evidence to be transmitted to the International Bureau. However, the Delegation requested clarification on whether the International Bureau would send the information transmitted from the receiving Office to all designated Offices.

423. The Secretariat, in response to the question raised by the Delegation of Japan, indicated that the information transmitted by the receiving Office in support of a request for restoration of the priority right would be handled in the same manner as the International Bureau handled communication of documents to designated and elected Offices in general, which was covered by Rule 93*bis*. The communication of such documents was effected on request by the Office concerned in agreement between the Office concerned and the International Bureau.

424. The Delegation of the European Patent Office supported the proposal, which corresponded to practice at the European Patent Office, but this Office did not send any sensitive personal information related to the health of the person or confidential information, like credit card details, to the International Bureau. If such information were sent to the International Bureau, the Delegation understood that this would be withheld from accessibility by the public

by the International Bureau, but expressed concern that the information could be published by a designated Office without the consent of the applicant. The Delegation therefore proposed that receiving Offices should retain the right not to furnish personal sensitive information to the International Bureau; such information could be defined in the Administrative Instructions. Designated Offices could nevertheless request this information from the applicant if needed. The Delegation also raised a question on whether it would be possible for a designated Office to request a translation of further evidence requested by the Office into its working language(s) when conducting a review under Rule 49ter.1(d) of a decision taken by the receiving Office on restoration of the right of priority.

425. The Secretariat, in response to the comments and the question raised by the Delegation of the European Patent Office, indicated that, in the view of the International Bureau, a designated Office had the right to request from the applicant a translation of any such declaration or evidence if required for the purpose of a review under Rule 49ter.1(d). As for the possibility for the receiving Office not to furnish sensitive personal information to the International Bureau, the Secretariat shared the concerns and agreed to look into this in further detail.

426. The Chair indicated that it could be possible to consider the proposals together with the proposals relating to the omission of certain information from public access as package. This could explore possibilities to provide for the receiving Office to omit sensitive information from transmission to the International Bureau, which would avoid the International Bureau needing to consider this matter in transmission to designated Offices.

427. The Delegation of the United States of America supported the proposal, which was in line with current practice at the United States Patent and Trademark Office acting as a receiving Office. The Delegation acknowledged the concerns that had been raised by the European Patent Office, but the United States Patent and Trademark Office had not encountered these issues in its own experience, probably as it applied the unintentional standard to requests for restoration of the right of priority.

428. The Delegation of Singapore supported the proposal, which would make the process easier for the applicant and designated Office when the application entered the national phase. Currently, the Intellectual Property Office of Singapore sent all submissions pertaining to a request for the restoration of the right of priority made by an applicant to the International Bureau.

429. The Delegation of India reminded the Working Group that the Indian Patent Office had made a notification of incompatibility with respect to the provisions on restoration of priority right and asked about the impact of the proposal on Offices that had a notification concerning these provisions when a receiving Office had decided to restore the priority right.

430. The Secretariat, in response to the question raised by the Delegation of India, stated that, when a designated Office had made a notification of incompatibility, under Rule 49ter.1(g), it would not be obliged to follow a decision of a receiving Office allowing restoration of right of priority, nor would the applicant be able to request the restoration directly with the designated Office.

431. The Working Group agreed that the International Bureau should consider the proposals further, taking into account the comments made by delegations.

#### **MISCELLANEOUS PROPOSED AMENDMENTS TO THE PCT REGULATIONS**

432. Discussions were based on document PCT/WG/7/15.

433. The Secretariat outlined that the document proposed amendments to the Regulations in three areas: removal of the fee reduction in the Schedule of Fees, following the agreement in principle to decommission PCT-EASY, changing the time limit for making a request for the restoration of right of priority to designated or elected Offices when making an express request for early national phase entry to one month from the date of receipt of the express request by amending Rule 49*ter*.2(b)(i), and deleting the reference to paragraph (a) of Rule 90*bis*.5 in Rule 90.3, consequential on amendment of Rule 90*bis*.5 adopted by the Assembly in 2012.

434. The Delegation of the United States of America supported the proposals to amend the Schedule of Fees to eliminate the fee reduction of PCT-EASY and to amend Rule 90.3. Regarding the proposal to amend Rules 49*ter*, the Delegation understood the rationale and had no specific objections, but suggested that all time limits in this Rule could be extended to two months, in line with the majority of general time periods set out in the Patent Law Treaty.

435. The Delegation of Israel supported the proposals. With regard to decommissioning PCT-EASY, the Delegation supported the proposal and informed the Working Group that the Israel Patent Office started to receive and process international applications in full electronic mode from November 1, 2011. As a result, 95 per cent of international applications were filed at the Israel Patent Office in fully electronic format, with PCT-EASY only being used in about 3 per cent of applications. The Delegation therefore supported the proposal of the International Bureau to withdraw PCT-EASY from the range of filing methods and to concentrate resources on offering optimal systems to allow an applicant to making fully electronic filings. With regard to the restoration of right of priority by designated Offices after early national phase entry, the Delegation also supported this proposal, but designated Offices should remain free to offer longer periods if desired, as proposed in the document.

436. The Delegation of Japan supported the proposal to amend the Schedule of Fees due to the decommissioning of PCT-EASY. The Delegation also supported the proposal to change the time limit regarding restoration of right of priority by designated Offices after early national phase entry and informed the Working Group that the Japan Patent Office was planning to introduce restoration of right of priority in the first half of 2015.

437. The Secretariat, in response to the suggestion by the Delegation of the United States of America to extend all time limits in this Rule to two months, indicated that it would prefer to continue with the proposal in its current form, since it would not require changes to the laws of Contracting States and could therefore be brought into effect quickly, noting that States were always permitted to offer more favorable time periods if their national laws so permitted.

438. The Working Group approved the proposed amendments to the Regulations as set out in the Annex to document PCT/WG/7/15 with a view to their submission to the Assembly for consideration at its next session in September 2014.

## **OTHER MATTERS**

### **LANGUAGE OF REPORT**

439. The Secretariat raised the issue of whether a full meeting report of the session should be established in all six UN languages, or whether a transcript of the discussions in English only should be published as the report of the Working Group. The additional cost for translating a full meeting report of a comparable length to last year's session of the Working Group into all six languages amounted to between 60,000 and 70,000 Swiss francs, work which was generally outsourced to external translators. In view of this expenditure, the Secretariat invited the Working Group to consider the added value of the Secretariat producing a full meeting report in all six languages. Furthermore, an extensive Summary by the Chair would be produced in all six languages, whether the meeting report was translated into all six UN languages or took the

form of a transcript in English only. This Summary was between 15 and 20 pages, so was more detailed and considerably longer than the Summary by the Chair of meetings of some other WIPO bodies.

440. The Delegation of Spain believed that the report was an important issue, but considered that the most important issue was the language policy of WIPO. The Program and Budget Committee had discussed a proposal from the Secretariat to abolish verbatim meeting reports (see paragraph 11 of document WO/PBC/21/15 and paragraphs 919 to 978 of document WO/PBC/21/22), in respect of which the Delegation considered that the proposal to use the transcript as produced by the captioning services was not yet mature. The Delegation believed that the Program and Budget Committee was the appropriate forum to discuss this issue. Furthermore, the aim of the WIPO language policy should not be to provide translations for their own sake, but to give equal weight to each language. The idea of captioning the proceedings and producing a transcript in one language only therefore presented a problem for the Delegation.

441. The Delegation of Japan asked whether the Working Group had the authority to abolish the verbatim report before a decision on this matter had been taken by the Program and Budget Committee, where discussions were ongoing.

442. The Delegation of Ecuador supported the statement made by the Delegation of Spain. All languages should be placed on an equal footing.

443. The Delegation of Chile supported the comments made by the Delegations of Spain and Ecuador. In a technical body like the Working Group, it was important for non-native English speakers that languages were placed on an equal footing.

444. The Delegation of Mexico seconded the statement made by the Delegation of Spain and underlined that the decision on the translation of reports should be taken in the Program and Budget Committee and not the Working Group.

445. The Delegation of Brazil recalled that discussions on the verbatim report took place at the sixth session of the Working Group but were not included in the Summary by the Chair for the session. As several delegations had made interventions on this matter, the Delegation requested that a point on this matter be included in the Summary by the Chair.

446. The Working Group noted that a verbatim report would be established in six languages and adopted by correspondence.

#### **FURTHER WORK**

447. 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 September 2014 and September/October 2015 sessions of the Assembly, and that the same financial assistance should be made available to enable attendance of certain delegations at this session should be made available at the next session.

448. The International Bureau indicated that the eighth session of the Working Group was tentatively scheduled to be held in Geneva in May/June 2015.

#### **SUMMARY BY THE CHAIR**

449. The Working Group noted the contents of the Summary by the Chair in document PCT/WG/7/29 and that the official record would be contained in the report of the session.

#### **CLOSING OF THE SESSION**

450. The Chair closed the session on June 13, 2014.

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

[Annexes follow]

PROPOSED AMENDMENT OF THE REGULATIONS UNDER THE PCT:  
SCHEDULE OF FEES

(as proposed to be amended with effect from July 1, 2015)

Fees	Amounts
1. International filing fee: (Rule 15.2)	1,330 Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets
2. Supplementary search handling fee: (Rule 45bis.2)	200 Swiss francs
3. Handling fee: (Rule 57.2)	200 Swiss francs

**Reductions**

4. The international filing fee is reduced by the following amount if the international application is, as provided for in the Administrative Instructions, filed:

- |   |                             |
|---|-----------------------------|
| <del>(a)</del> <del>on paper together with a copy in electronic form, in character coded format, of the request and the abstract:</del> | <del>100 Swiss francs</del> |
| <del>(b)</del> (a) in electronic form, the request not being in character coded format:   | 100 Swiss francs            |
| <del>(e)</del> (b) in electronic form, the request being in character coded format:   | 200 Swiss francs            |
| <del>(d)</del> (c) in electronic form, the request, description, claims and abstract being in character coded format:                   | 300 Swiss francs            |

5. The international filing fee under item 1 (where applicable, as reduced under item 4), the supplementary search handling fee under item 2 and the handling fee under item 3 are reduced by 90% if the international application is filed by:

- (a) an applicant who is a natural person and who is a national of and resides in a State that is listed as being a State whose per capita gross domestic product national income is below US\$ 25,000 ~~US\$3,000~~ (according to the most recent ten-year average per capita gross domestic product national income figures at constant 2005 US\$ values published used by the United Nations), and whose nationals and residents who are natural persons have filed less than 10 international applications per year (per million population) or 50 international applications per year (in absolute numbers) according to the most recent 5-year average yearly filing figures published by the International Bureau for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997) or, pending a decision by the PCT Assembly on the eligibility criteria specified in this sub-paragraph, one of the following States: Antigua and Barbuda, Bahrain, Barbados, Libya, Oman, the Seychelles, Singapore, Trinidad and Tobago and the United Arab Emirates; or
- (b) an applicant, whether a natural person or not, who is a national of and resides in a State that is listed as being classified by the United Nations ~~classed~~ as a least developed country ~~by the United Nations;~~

provided that, if there are several applicants, each must satisfy the criteria set out in either sub-item (a) or (b). The lists of States referred to in sub items (a) and (b) shall be updated by the Director General at least every five years according to directives given by the Assembly. The criteria set out in sub-items (a) and (b) shall be reviewed by the Assembly at least every five years.

[Annex II follows]

PROPOSED DIRECTIVES FOR UPDATING THE LISTS OF STATES  
MEETING THE CRITERIA FOR REDUCTION OF CERTAIN PCT FEES

The Assembly establishes in the following terms the directives referred to in the Schedule of Fees, it being understood that, in the light of experience, the Assembly may at any time modify these directives:

1. Five years after the establishment of the first list of States which meet the criteria referred to in items 5(a) and (b) of the Schedule of Fees, and every five years thereafter, the Director General shall prepare draft lists of States which appear to meet the criteria referred to in:
  - (i) item 5(a) of the Schedule of Fees according to the most recent ten year average per capita gross domestic product figures from the United Nations published at least two weeks prior to the first day of that session of the Assembly;
  - (ii) item 5(b) of the Schedule of Fees according to the most recent list of countries classified as least developed countries by the United Nations published at least two weeks prior to the first day of that session of the Assembly;

and shall make those lists available to the PCT Contracting States and States entitled to observer status in the Assembly for comment before the end of that session of the Assembly.

2. Following the end of that session of the Assembly, the Director General shall establish new lists, taking into account any comments received. The revised lists shall become applicable on the first day of the calendar year subsequent to that session and shall be used to determine, in accordance with Rules 15.4, 45*bis*.2(c) and 57.3(d), the eligibility for the fee reduction under items 5(a) and 5(b), respectively, of the Schedule of Fees of any relevant fee payable. Any revised list shall be published in the Gazette.

3. Where any State is not included in a particular list but subsequently becomes eligible for inclusion in that list due to the publication, after the expiration of the period of two weeks prior to the first day of the ordinary session of the Assembly referred to in paragraph 1, above, of revised per capita national income figures by the United Nations or of a revised list of States that are being classified as least developed countries by the United Nations, that State may request the Director General to revise the relevant list of States so as to include that State in the relevant list. Any such revised list shall become applicable on a date to be specified by the Director General, that date being no more than three months from the date of receipt of the request. Any revised list shall be published in the Gazette.

[Annex III follows]

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