

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Fourth (19th Ordinary) Session
Geneva, September 23 to October 2, 2013

DRAFT REPORT

prepared by the International Bureau

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/51/1 Prov.3): 1 to 6, 8, 11 to 16, 19 to 23, 37, 47 and 48.
2. The report on the said items, with the exception of item 37, is contained in the General Report (document A/51/20 Prov.1).
3. The report on item 37 is contained in the present document.
4. Ms. Susanne Ås Sivborg (Sweden) was re-elected Chair of the Assembly; Mr. Tian Lipu (China) and Mr. Toomas Lumi (Estonia) were elected Vice-Chairs.

PCT WORKING GROUP: REPORT OF THE SIXTH SESSION

5. Discussions were based on document PCT/A/44/1.
6. The Secretariat, in introducing document PCT/A/44/1, referred to the Summary by the Chair of the sixth session of the PCT Working Group, which was annexed to the document and which gave a good overview and a summary of the items discussed and the agreements reached during the meeting. The full final report of the session, taking into account the minor comments the International Bureau had received from delegations on the draft report, would be available on the WIPO web site shortly. In addition to a number of more technical and legal issues, the focus of the discussions in the Working Group at its sixth session had again been on

various proposals by Member States aimed at strengthening the role of the PCT as the central node of the international patent system; discussions by Member States on most of these proposals would continue in the Working Group at its upcoming 2014 session.

7. The Secretariat highlighted the issue of criteria and procedures for appointment of International Authorities, which had been discussed by the Working Group at its sixth session. In this regard, the Working Group had agreed to recommend to the Assembly that the International Bureau should undertake a review of the current criteria and procedures, in coordination, where appropriate, with the Meeting of International Authorities, for discussion by the Working Group at its next session in 2014. Consequently, the Assembly was invited to approve this specific recommendation by the Working Group. Finally, the Working Group had agreed on a number of proposed amendments to the PCT Regulations for approval by the Assembly at its present session, as set out in document PCT/A/44/3.

8. The Delegation of Japan stated that the number of international patent applications filed under the PCT had increased and the PCT was now a truly global framework, enabling applicants to file patent applications worldwide. However, there was still room for improvement of the PCT system. Member States had an important mission to fulfill, which was to maximize the benefits of the PCT system and to further improve it in order to create a more user-friendly system. Against this background, Japan had submitted the PCT Kaizen proposal at the most recent session of the PCT Working Group, aimed at creating a common understanding of the future direction of the PCT system. Having obtained broad support for its PCT Kaizen proposal from Member States, Japan wished to further elaborate on the proposal at the next session of the PCT Working Group. The Delegation also welcomed the proposals on PCT improvements which had been made by the United States of America, the United Kingdom, the European Patent Office (EPO) and Brazil. The Delegation expected practical and productive discussions to bear meaningful and valuable fruit, allowing the PCT to become a truly user-friendly system. The Delegation further agreed that the issue of the criteria and the procedures for the appointment of International Searching and Preliminary Examining Authorities should be discussed at the next session of the PCT Working Group. It expressed the view that it was important to review whether the existing criteria and procedures were adequately addressing not only the technical scope of applications, which had expanded and become more complicated in recent years, but also the development of information technology.

9. The Delegation of Belgium, speaking on behalf of Group B, stated that it wished to thank the Chair of the most recent session of the PCT Working Group for his efficient chairing of the meeting. In a similar vein, it wished to thank the Secretariat for the work done over the past year. Group B welcomed the progress that had been made towards improving the operation of the PCT system. It believed that a more efficient PCT system could bring benefits to both Offices and users. It believed that further work and discussions on the issue of fee reductions were urgently needed in order to develop a system of fee reductions that took into account changes that had occurred in the economy worldwide. It therefore looked forward to the study by the International Bureau on this issue, linking the topic of fee reductions with notions such as, firstly, the variety of definitions of small and medium-sized enterprises (SMEs) that are used for fee reductions granted under national and regional patent legislation; secondly, descriptions of mechanisms that were already in place in some countries in this area; and thirdly, the elasticity of fee reductions covering non-profit research institutes and universities. The Delegation reiterated that fee reductions should be financially sustainable and income neutral.

10. The Delegation of Chile stated that it wished to take this opportunity to once again thank the Member States and the Secretariat for the trust they had placed last year in appointing the National Institute of Industrial Property of Chile (INAPI) as an International Searching and Preliminary Examining Authority. INAPI would begin its operations as an International Authority in October 2014, as already had been announced earlier (see document A/51/20). The Delegation had made available a brochure, setting out the progress INAPI had made in recent years, notably in terms of access to the PCT minimum documentation and examiner training, for

which the Delegation particularly liked to thank the IP Offices of the United States of America, Canada, China and Austria. Furthermore, INAPI had continued to improve the design of its quality control systems.

11. The Delegation of El Salvador stated that, while it generally supported further work in the PCT Working Group, including modifications to the PCT Regulations, Member States needed to consider what had been achieved so far in terms of implementation of the PCT Roadmap. In this context, Member States needed to take into account, in particular, the development aims of the Treaty before taking any further steps.

12. The Delegation of the United States of America stated that it supported the statement by the Delegation of Belgium on behalf of Group B. It had noted the summary by the Chair of the sixth session of the PCT Working Group contained in document PCT/WG/6/23 and looked forward to the report of the session. The Delegation supported approval of the recommendation by the Working Group concerning the review of the criteria and procedures for appointment of an Office as an International Searching and Preliminary Examining Authority under the PCT. Attention to work product quality as well as timeliness was critical to the continuous success of the PCT system. The Delegation further supported the approval of the recommendation by the Working Group that, subject to sufficient funds, one session of the Working Group should be convened between the 2013 and 2014 sessions of the Assembly. The Delegation further stated that, in 2013, the Working Group had considered matters related to transparency and maintenance of expected quality within the PCT system and had agreed on ways to improve the system in these areas. This work had resulted in the amendments to the PCT Regulations as set out in document PCT/A/44/3. It commended the Working Group for its efforts over the past year and looked forward to continuation of this work in the year ahead. Mandatory recordation of search strategies and incorporation of the Patent Prosecution Highway (PPH) into the PCT system were reforms which should improve transparency and efficiency; notably, the proposal to incorporate the PPH into the PCT would be an effective mechanism to promote increased and more effective use of the PCT Chapter II procedure. Thus, both proposals warranted further consideration.

13. The Delegation of South Africa stated that South Africa had acceded to the PCT on March 16, 1999. Gradually, the number of patent applications received in South Africa through the PCT route had increased and now constituted more than 80 per cent of total patent applications filed. Over the years, South Africa had received, and continued to receive, excellent technical assistance, including educational and outreach programs provided by WIPO. The Companies and Intellectual Property Commission in South Africa had cooperated with WIPO to offer training on PCT issues, which the Delegation hoped would continue. The Delegation commended the Secretariat for the outstanding work done to facilitate the development of the PCT system, as well as the valuable contribution of Member States that had submitted proposals for future development of the PCT system. The Delegation further expressed the view that the agenda of the sixth session of the PCT Working Group on substantive topics had been quite intense and ambitious and had been aimed at introducing drastic changes to the PCT system. These topics could be divided into two groups: on the one hand, issues concerning the operation of rules and introducing new levels of automation and information technology; and, on the other hand, issues concerning the improvement of the quality of patents, work sharing and patent search and examination, as well as the link between the international and national phase procedures. The second group of issues had a big impact on national Offices. Therefore, a number of delegations from developing countries, including South Africa, had felt that they had not been ready to participate effectively in such developments and had expressed their concerns that this would lead to harmonization of substantive patent laws. The Delegation drew attention to the fact that the PCT Roadmap had been approved in 2009 by the PCT Union Assembly with the proviso that it should deliver results which met the needs of applicants, Offices and third parties in all Contracting States without limiting the freedom of Contracting States to prescribe, interpret and apply substantive conditions of patentability and without seeking substantive patent law harmonization or

harmonization of national search and examination procedures, taking an incremental approach in a member driven process, involving broad based consultations with all stakeholder groups, including regional consultation workshops and taking into account the recommendations contained in the WIPO Development Agenda (DA). In light of the above, the Delegation wished to caution against the linkage between national and international phases, especially with regard to proposals which would affect the manner of national phase processing, such as PCT Kaizen, the formal integration of the PPH into the PCT, and the mandatory response to negative comments in the national phase. The Delegation further expressed its concern that the rapid development of the PCT system would pose a substantive hardship on developing countries to cope with such a development. That process was not in line with the proviso set out in the approval of the PCT Roadmap given by the PCT Union Assembly at its 2009 session, according to which an incremental approach should be taken in the development of the PCT system.

14. The Delegation of Sweden thanked the Secretariat for the work in the area of the PCT. It emphasized the great importance of the PCT system and its commitment to the valuable work of the PCT Working Group, striving to improve the functioning of the system. In that vein, the Delegation supported the recommendation of the PCT Working Group that the International Bureau should undertake a review of the criteria and procedures for appointment of Offices as International Searching and Preliminary Examining Authorities, as suggested in document PCT/A/44/1, paragraph 5(ii), as well as the recommendation for future work set out in paragraph 5(iii). For the sake of efficiency, the Delegation further wished to comment on the other documents related to the work of the PCT Working Group yet to be discussed during the present session of the Assembly. It was important that International Authorities, such as the Swedish Patent and Registration Office, continuously improved the work processes and the quality of the results delivered to improve the overall quality of the PCT system, for the benefit of the users and other stakeholders. The Delegation therefore noted with appreciation the report on ongoing quality-related work set out in document PCT/A/44/2. Furthermore, the Delegation supported the proposed amendments to the PCT Regulations set out in document PCT/A/44/3.

15. The Delegation of India stated that it wished to take this opportunity to express its appreciation of the work being carried out by the PCT Working Group as announced by the Secretariat. As it had mentioned in its opening statement, the Delegation was pleased to announce that the Indian Patent Office would commence functioning as International Searching and Preliminary Examining Authority from October 15, 2013. Furthermore, the Delegation expressed the view that the PCT system needed to be made more accessible, in particular for applicants from developing and least developed countries (LDCs), and in this regard emphasized the importance of technical assistance as well as fee reductions for SMEs, universities and research institutes, and individuals from developing and LDCs. With respect to the proposal to integrate the PPH into the PCT, India had, time and time again, expressed its concerns about harmonization of examination procedures for patent applications and considered that this would impede the process of examination in developing countries where the capacity to examine was yet to achieve the maturity that was seen in the patent Offices of developed countries.

16. The Delegation of Egypt expressed its appreciation for the cooperation which had made it possible for the Egyptian Patent Office to commence acting as an International Searching and Preliminary Examining Authority in 2013. This had been the result of the good cooperation between Egypt and WIPO; in this context, it expressed the hope that technical assistance and training by WIPO would continue. The Delegation had some ideas as to how to develop bilateral cooperation with WIPO so that the Egyptian Patent Office's activities could be expanded throughout the Arab region and Africa. The Delegation further stated that it supported the intervention made by the Delegation of India with regard to the issue of fee reductions for SMEs, universities and research institutions, which it felt could be very useful in the context of the PCT system.

17. The Delegation of Spain stated that it wished to endorse the statement by the Delegation of Belgium, on behalf of Group B, and statements by other delegations with regard to the following points: firstly, the revision of fees to make the system more efficient for users; and secondly, further work to ensure quality and sustainability of the PCT system, which would have an effect on the trust placed in it.

18. The Delegation of Trinidad and Tobago stated that it concurred with the Secretariat that the PCT was the central node of the international patent system. In fact, PCT applications constituted 97 per cent of all patent applications in Trinidad and Tobago. The Delegation commended the work of the PCT Working Group and the evolution of the PCT system. As technology and innovations evolved, the work of the PCT continued to evolve in a thoughtful and progressive manner. It looked forward to continue working with other Member States on these new initiatives. It further supported the expansion of the options among a growing group of International Searching and Preliminary Examining Authorities and welcomed the inclusion of the State Intellectual Property Service of Ukraine as an International Authority under PCT. In closing, it urged that future PCT improvements that were presently under discussion needed to continue to take in account the capacities of all Contracting States; it looked toward to the continued utility of the PCT to all Contracting States.

19. The Assembly:

(i) noted the Summary by the Chair of the sixth session of the PCT Working Group contained in document PCT/WG/6/23 and reproduced in the Annex of document PCT/A/44/1;

(ii) approved the recommendation by the Working Group concerning the review of the criteria and procedures for appointment of an Office as an International Searching and Preliminary Examining Authority under the PCT set out in paragraph 3 of document PCT/A/44/1; and

(iii) approved the recommendation concerning the further work of the PCT Working Group set out in paragraph 4 of document PCT/A/44/1.

QUALITY-RELATED WORK BY INTERNATIONAL AUTHORITIES

20. Discussions were based on document PCT/A/44/2.

21. The Secretariat stated that the main purpose of document PCT/A/44/2 was to report on the outcome of the third informal session of the Quality Subgroup of the Meeting of International Authorities under the PCT, which had taken place in Munich in February of this year. The Summary by the Chair of the session was attached in the Annex to the document. The focus of this third informal session had again been on effective quality improvement measures, that is, measures to improve the overall quality and usefulness of the PCT's work products, namely, international search reports and international preliminary reports on patentability. The Quality Subgroup had further focused on the development of quality metrics for international search reports and the development of quality metrics for the entire PCT system, covering the work of receiving Offices, International Authorities, designated and elected Offices, and the International Bureau. The document further informed Member States of the availability on the WIPO web site of the latest reports by International Authorities on the state of their existing quality management systems, as had been the practice for a number of years. Those reports had also been discussed by the Quality Subgroup, as set out in paragraphs 1 to 6 of the Summary by the Chair.

22. The Delegation of Japan stated that, in order to improve the quality of search and examination results in each International Authority, it believed that it was extremely important to establish an international framework that could give feedback on international search reports

and written opinions by International Searching Authorities, as referred to in paragraph 5 of document PCT/A/44/2. The Delegation was grateful for the hard work by the Secretariat on this issue. Based on such a feedback mechanism, Offices would be able to easily provide feedback on examination results to one another. As a result, the addition of such a feedback mechanism would further enhance the value of the PCT system in the future. Against this background, the Japan Patent Office (JPO) was now considering a pilot program aimed at analyzing and utilizing feedback from Offices and then providing feedback on the results to those Offices at the earliest possible time through the cooperation with other offices. Over time, as a number of pilot programs were implemented and the feedback framework became more sophisticated, it expected that the framework would develop into an effective and efficient system that would be conducive to improving the quality of search and examination results of International Authorities.

23. The Delegation of the United States of America noted with appreciation the important work of the Quality Subgroup. It especially noted the work of the Quality Subgroup with regard to the availability of search strategies and continued to encourage all Authorities to make their search strategies available, as this was an important tool to aid examiners in evaluating the sufficiency of the search performed during the international phase.

24. The Assembly noted the contents of document PCT/A/44/2.

PROPOSED AMENDMENTS TO THE PCT REGULATIONS

25. Discussions were based on document PCT/A/44/3.

26. The Secretariat, in introducing document PCT/A/44/3, explained that the effect of the proposed amendments to the PCT Regulations would be, firstly, to require International Preliminary Examining Authorities to conduct a top-up search during the PCT Chapter II procedure, subject to various exceptions set out in the Rule as proposed to be amended; and, secondly, to allow opinions of the International Searching Authority and informal comments submitted by the applicant in response to such opinions to be available on PATENTSCOPE from the date of international publication. The proposed amendments had been discussed in great detail by the PCT Working Group, which had unanimously agreed that the Assembly should adopt the amendments as proposed.

27. The Delegation of Japan stated that it supported the proposed amendments to the PCT Regulations. It requested that, as a next step, detailed discussions on the implementation of top up searches should be held at the earliest opportunity; in this context, it was necessary to study further the discretion of each International Preliminary Examining Authority whether to conduct top-up searches on specific international applications, and possible transitional arrangements if practices were to be changed.

28. The Delegation of the United States of America supported the adoption of the proposed amendments of the Regulations under the PCT set out in Annex I to document PCT/A/44/3. The proposed amendments of Rules 66 and 70 related to top-up searching would help to maintain work product quality within the PCT system; the amendment of Rule 94 and deletion of 44*ter*, relating to the making available of written opinions by the International Searching Authority at the time of international publication, would promote transparency within the system. The Delegation further supported adoption of the decisions concerning entry into force and transitional arrangements in respect to the proposed amendments, as set out in Annex I to document PCT/A/44/3.

29. The Delegation of Norway considered that the proposed amendments relating to mandatory top-up searches for International Preliminary Examining Authorities would improve the quality of the PCT services provided during the national phase, for the benefit of third parties and national Offices. It thus supported the proposal to introduce such top-up searches. Furthermore, it supported the proposal to make the written opinions of the International

Searching Authorities available at the same date as the international publication of the international application.

30. The Assembly:

- (i) adopted the proposed amendments to the Regulations under the PCT set out in the Annex to this report;
- (ii) decided that the amendments of Rules 66 and 70 set out in the Annex to this document shall enter into force on July 1, 2014, and shall apply to any international application, irrespective of its international filing date, in respect of which a demand for international preliminary examination is made on or after July 1, 2014.
- (iii) decided that the deletion of Rule 44*ter* and the amendment of Rule 94 set out in Annex I to this document shall enter into force on July 1, 2014, and shall apply to any international application whose international filing date is on or after July 1, 2014.

APPOINTMENT OF THE STATE INTELLECTUAL PROPERTY SERVICE OF UKRAINE AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

31. Discussions were based on document PCT/A/44/4 Rev.

32. The Secretariat stated that the only changes in document PCT/A/44/4 Rev. compared to the original document PCT/A/44/4 were to be found in Appendix 4 of the document, setting out the draft Agreement between the Intellectual Property Service of Ukraine and the International Bureau; those changes were highlighted by the usual underlining and strike through of the text concerned.

33. The Chair referred to the twenty-sixth session of the PCT Committee for Technical Cooperation (PCT/CTC) which had been held earlier and the fact that that Committee had given a favorable opinion on the proposed appointment of the State Intellectual Property Service of Ukraine as an International Searching and Preliminary Examining Authority under the PCT.

34. The Delegation of Ukraine expressed its most sincere gratitude to the Director General of WIPO and to the Delegations of Japan, Austria, Finland, Chile and Hungary, all of which had expressed their favorable opinion and comments during the session of the PCT/CTC. The State Intellectual Property Service of Ukraine considered it as a great honor to be appointed as an International Searching and Preliminary Examining Authority under the PCT, and saw its appointment as an obligation to make a contribution to the development of the global patent system. The Delegation highly appreciated the support by all delegations that had assisted the State Service in its endeavor to be appointed as an International Authority.

35. The Assembly, having heard the Representative of the State Intellectual Property Service of Ukraine and taking into account the advice of the PCT Committee for Technical Cooperation, unanimously:

- (i) approved the text of the draft Agreement between the State Intellectual Property Service of Ukraine and the International Bureau as set out in Appendix IV to document PCT/A/44/4 Rev; and
- (ii) appointed the State Intellectual Property Service of Ukraine as an International Searching Authority and an International Preliminary Examining Authority with effect from the entry into force of the Agreement until December 31, 2017.

36. The Director General of WIPO, Mr. Francis Gurry, congratulated the Delegation of Ukraine and the State Intellectual Property Service of Ukraine on the appointment of the State Intellectual Property Service of Ukraine as an International Searching and Preliminary Examining Authority under the PCT, and welcomed the State Intellectual Property Service of Ukraine to the family of International Authorities.

[Annex follows]

AMENDMENTS OF THE PCT REGULATIONS
TO ENTER INTO FORCE ON JULY 1, 2014

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Rule 44~~ter~~

[Deleted]

Rule 66

Procedure Before the International Preliminary Examining Authority

66.1 and 66.1.bis *[No Change]*

66.1~~ter~~ *Top-up Searches*

The International Preliminary Examining Authority shall conduct a search (“top-up search”) to discover documents referred to in Rule 64 which have been published or have become available to the said Authority for search subsequent to the date on which the international search report was established, unless it considers that such a search would serve no useful purpose. If the Authority finds that any of the situations referred to in Article 34(3) or (4) or Rule 66.1(e) exists, the top-up search shall cover only those parts of the international application that are the subject of international preliminary examination.

66.2 to 66.8 *[No change]*

Rule 70

International Preliminary Report on Patentability by the International Preliminary Examining Authority (International Examination Report)

70.1 *[No change]*

70.2 *Basis of the Report*

(a) to (e) *[No change]*

(f) The report shall indicate the date on which a top-up search under Rule 66.1 *ter* was made, or else state that no top-up search was made.

70.3 to 70.17 *[No change]*

Rule 94

Access to Files

94.1 *Access to the File Held by the International Bureau*

(a) [No change]

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application and subject to Article 38, furnish, subject to the reimbursement of the cost of the service, copies of any document contained in its file.

(c) [No change]

94.2 and 94.3 *[No change]*

[End of Annex and of document]