

International Union for the Protection of Industrial Property (Paris Union)

Assembly

Fifty-Sixth (32nd Extraordinary) Session Geneva, September 21 to 25, 2020

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/61/1): 1, 2, 4, 5, 6, 8, 10(ii), 11, 15, 21 and 22.
2. The reports on the said items, with the exception of item 15, are contained in the General Report (document A/61/10).
3. The report on item 15 is contained in the present document.
4. Mr. Abdulaziz Mohammed Alswailem (Saudi Arabia), Chair of the Assembly, presided over the meeting.

ITEM 15 OF THE CONSOLIDATED AGENDA

PARIS UNION ASSEMBLY

5. Discussions were based on document P/A/56/1.

6. Introducing document P/A/56/1, the Secretariat stated that due to the disruption caused by the COVID-19 pandemic, users of the industrial property system had faced difficulties in meeting time limits or the priority period, while intellectual property (IP) offices have struggled with maintaining daily operations. That led to legal uncertainties that challenged the proper functioning of the IP system at the critical time for innovation, affecting the users, third parties and IP offices alike. The Secretariat further stated that the global nature of the Paris Convention might justify an internationally concerted approach to address the issues collectively, particularly in emergencies having a global impact. The Secretariat noted that, in accordance with Article 13 of the Paris Convention, the Paris Union Assembly was the forum in which matters concerning the implementation of the Convention should be dealt with. The Secretariat introduced the structure of document P/A/56/1: the document first provided an overview of the relevant provisions of the Paris Convention; then it addressed possible special relief measures for mitigating the risk of loss of priority right in emergencies; that was followed by a discussion of practical elements that might be considered for the designing of such relief measures; and finally in paragraph 33, the document presented the draft Guidance from the Paris Union Assembly to the countries of the Union on that matter, for consideration and adoption by the Assembly. The Secretariat noted that while the draft Guidelines covered issues relating to national implementation of the right of priority in a specific, limited situation, that is, in emergencies, it did not alter the right of the countries of the Paris Union to interpret the Paris Convention and to implement the Convention in accordance with their national law. It further noted that the Guidance would neither create binding provisions for Member States nor impose any obligation on Member States to implement it. Nevertheless, the Secretariat expressed its view that the Guidance would be a concrete response from the Paris Union members to the challenges posed by the current and future emergencies of global nature, highlighting the internationally concerted approach and collective efforts of the Member States. The Secretariat also noted that it would also improve transparency, facilitating sharing of information and practices among the Paris Union members, users of the IP system and third parties.

7. The Delegation of Saudi Arabia welcomed the proposed Guidance from the Paris Union Assembly on Implementation of the Paris Convention relating to the Right of Priority in Emergencies. Further, the Delegation informed the Assembly that, in October 2020, the Global Forum for Intellectual Property Challenges would be organized on the sidelines of the Kingdom's hosting of the G20 Presidential Year. The Delegation also stated that its Office had adopted a number of measures to support the applicants in emergencies, including with respect to the priority period.

8. The Delegation of the United Kingdom, speaking on behalf of Group B, thanked the Secretariat for preparing document P/A/56/1. The Delegation stated that clear and timely guidance supported IP offices in managing their workloads to take account of the challenging circumstances presented by COVID-19. The Delegation also thanked the Secretariat for noting that the Guidance was non-binding and that the ultimate competence in that area belonged to Member States. The Delegation stated further that while the document was a guidance only, the advice provided would help IP offices to address the challenges faced by applicants when managing the right of priority under the Paris Convention. The Delegation continued that, by supporting the acceptance of digitally certified copies, IP offices would be able to make full use of technology to provide service continuity during such difficult times. The Delegation noted, in addition, that those measures would enable more efficient and effective communication outside the times of crisis. The Delegation was pleased that the document had focused on the procedural aspects of patent granting, tailoring procedural aspects to reflect current

circumstances as a more effective way to meet the needs of applicants, while avoiding wider ranging or less well-defined emergency powers.

9. The Delegation of the Republic of Korea thanked the Secretariat for preparing document P/A/56/1. The Delegation stated that, considering that emergencies such as COVID-19 might reoccur in the future, the Republic of Korea could be flexible with the proposed Guidance from the Paris Union Assembly on Implementation of the Paris Convention relating to the Right of Priority in Emergencies. However, the Delegation wished to clarify that the Republic of Korea had some difficulties in amending its patent law within a short period of time. In that respect, the Delegation requested the Secretariat to conduct a survey among Member States of the Union to see whether requests had been made by users to extend the priority period during the COVID-19 crisis. The Delegation stated that the survey would be very helpful for Member States to consider amendment of national IP laws with respect to that issue.

10. The Delegation of China expressed its appreciation to the Assembly and Member States for making efforts with respect to the application and improvement of priority right system during emergency situations. The Delegation noted that the Guidance did not alter the right of the countries of the Paris Union to interpret the Paris Convention and to implement the Convention in accordance with their national law. Further noting that the Guidance merely elucidated the practices that the Assembly encouraged Member States to consider, and that it did not impose any obligation on Member States to implement it, the Delegation approved such approach. The Delegation further stated that, according to its patent law, if an applicant lost its priority right because he/she had been unable to observe the priority period, that right could not be restored. However, in case of a late submission of a copy of the earlier application, the loss of priority right could be restored. In addition, if the late submission was due to *force majeure*, restoration fees could be waived. The Delegation stated that the Guidance would serve as good reference for countries aiming to improve their legislations. The Delegation continued that, if the Assembly would approve the Guidance, taking into account the impacts of COVID-19 pandemic, China would consider amendments to its patent law and implementing regulations, and consider examining relief measures with respect to priority period in emergencies. The Delegation concluded by stating that it would timely provide relevant information to WIPO to be published on its website so that applicants and the general public would be informed and the legal certainty be increased.

11. The Delegation of the Russian Federation, speaking on behalf of the Group of Central Asian, Caucasus and Eastern European Countries (CACEEC), thanked the Secretariat for preparing a Guidance on the right of priority in emergencies. The Group shared the importance of the Paris Union Assembly having agreed on a unified approach on that issue to reduce uncertainty about the right of priority and minimize the risks of losing rights. The Group appreciated the role of WIPO as a coordinator of publication, dissemination of information and clarifications on the applicability of relief measures. The Group noted that posting information on a website of WIPO, dedicated to tracking relevant changes in the work of IP offices, was important for applicants. In that regard, the Group stated that open access to official information on the relief measures adopted by the offices would make the IP service delivery system more transparent.

12. The Delegation of Japan supported the statement made by the Delegation of the United Kingdom on behalf of Group B, and expressed its appreciation to the Secretariat for preparing the document. The Delegation supported WIPO to provide certain guidance on the implementation of the provisions concerning the priority under the Paris Convention, in order to encourage Member States to consider flexible responses within their national legislation without changing the priority period itself. The Delegation noted that the Japan Patent Office (JPO) had flexibly responded to a request for restoration of priority rights to extend the time limit for submission of certified priority documents, and had publicized the measures taken on its

website. It further stated that the JPO would continue to make efforts for the benefit of the users.

13. The Delegation of Colombia expressed its appreciation to the Secretariat for the preparation of the important document on the implementation of the Paris Convention regarding the right of priority in emergencies which contained practical and timely guidance to the countries of the Union. The Delegation applauded and recognized the Guidance contained in the document. The Delegation expressed its belief that it would lead to a coordinated, transparent and unified approach that would help users of the industrial property systems. Taking into account that the legal rights of Member States would not be affected by the Guidance, the Delegation approved and supported the proposed Guidance.

14. The Delegation of the Russian Federation, speaking in its national capacity, aligned itself with its statement made on behalf of the CACEEC. The Delegation supported the adoption of the Guidance and the harmonization of office approaches with regard to the right of priority in emergencies. The Delegation stated that it was ready to provide the necessary information on the national implementation of provisions relating to the right of priority. Specifically, the Delegation stated that, for the convenience of users, the Russian Federation had adopted the Government Resolution on extension of certain time limits, including those related to payment of patent and other fees. According to that Resolution, the time limits expiring in the period from March 30 to November 30, 2020 might be extended upon a request made before December 31, 2020 by the applicant. The Delegation further stated that the national legislation also provided for the extension of the time limits for filing an application claiming priority of an earlier application, and for submitting a certified copy of the earlier application on which the priority claim was based, in case the applicant had difficulties in receiving the copy from the office of the first filing. In the framework of the Patent Cooperation Treaty (PCT), the Federal Service for Intellectual Property (ROSPATENT), as a receiving office, applied the rules on restoration of the right to priority. The Delegation concluded by stating that it supported the international discussion on the issue of the right of priority in emergencies, and that it would appreciate it if WIPO could act as a coordinator for publication, dissemination of information and clarifications on the applicability of relief measures.

15. The Delegation of Iran (Islamic Republic of) thanked the Secretariat for the initiative and appreciated the presentation of the document by the Secretariat. The Delegation noted that the right of priority based on Article 4 of the Paris Convention was a key mechanism for filing industrial property applications abroad. It highlighted the important role of the priority periods and the need to create a balance between the interests of the applicant and third parties. The Delegation stated that due to the disruption caused by the COVID-19 pandemic, users of the IP system and IP offices had been facing a number of challenges, including implementation of the procedures relating to the priority rights. Accordingly, the Delegation considered that countries of the Paris Union had had to undertake the necessary measures to mitigate the effects of the pandemic on the right holders and the IP offices. The Delegation noted that, as a matter of principle, interpretation of provisions of treaties administered by WIPO was an inclusive competence of each State party to the relevant treaties, and shared the position that the proposed Guidance contained in document P/A/56/1 was not legally binding and did not create any obligation to Member States to implement it.

16. The Delegation of the United States of America supported the statement made by the Delegation of the United Kingdom on behalf of Group B. The Delegation appreciated the opportunity to comment on the proposed draft Guidance for the Paris Union Assembly on implementing the priority related provisions of the Paris Convention during emergencies. The Delegation noted that the proposed Guidance provided the Paris Union members with helpful advice as to what measures they could adopt to minimize loss of priority rights that had resulted from emergencies. The Delegation supported the use of digital technologies to certify priority

documents during the pandemic, which would also allow efficient and effective communication during emergencies as well as under normal circumstances.

17. The Delegation of Algeria expressed its appreciation to the Secretariat for the preparation of the document. The Delegation welcomed the proposed Guidance from the Paris Union Assembly on implementation of the Paris Convention relating to the right of priority in emergencies. Referring to item (i) in paragraph 20 relating to the restoration of rights, in which it stated that a cutoff date for the submission of a request for restoration of rights was usually provided, the Delegation stated that, while noting that the Guidance was non-binding, it would be useful to specify, in a footnote, the maximum period not to be exceeded. For example, the period incurred might be the same provided for, or applied in, the legislation of each Member State in the event of a notification of refusal, such as two months or one month. To conclude, the Delegation supported the proposed Guidance.

18. The Secretariat thanked the delegations for their statements, including those stating the usefulness of the document. Since that was the spirit in which the document was prepared, the Secretariat expressed its pleasure of meeting the expectation of the delegations. Referring to the statement made by the Delegation of the Republic of Korea suggesting a survey on national implementations on the priority issues, the Secretariat stated that the importance of transparency also indicated in the document would open the door for such an initiative so that options for national implementations existed in Member States could be shared. The Secretariat underlined that the Guidance was not binding and it would be up to each Member State to identify the best option for implementation. With respect to the statement made by the Delegation of Algeria on the restoration of rights, the Secretariat noted that, bearing in mind the different national practices existed worldwide on the restoration of rights, the Guidance called attention of IP offices about the need to consider such an option, while maintaining the flexibility and freedom for each office to apply that option under the national legislation.

19. The Paris Union Assembly encouraged the application of the Guidance on Implementation of the Paris Convention relating to the Right of Priority in Emergencies, contained in paragraph 33 of document P/A/56/1, and adopted the said Guidance.

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