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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Thirty-Second (14th Ordinary) Session
Geneva, September 22 to October 1, 2003

REFORM OF THE PCT

Memorandum prepared by the International Bureau

INTRODUCTION

1. This document sets out the present status of various aspects of the work being undertaken in connection with reform of the Patent Cooperation Treaty (PCT), including the results of the two sessions of the Working Group on Reform of the PCT ("the Working Group") which have been held since the Assembly's previous session.

2. The Assembly, at its 31st (18th extraordinary) session held in Geneva in September-October 2002, considered the report of the second session of the Committee on Reform of the Patent Cooperation Treaty (PCT) ("the Committee") (document PCT/A/31/5, reproducing the Committee's report which appears in document PCT/R/2/9). Among other things, the Committee's report (at paragraph 140) contained a recommendation to the Assembly concerning the future work program for PCT reform:

"140. The Committee agreed to recommend to the Assembly that:

(i) two sessions of the Working Group should be convened between the September 2002 and September 2003 sessions of the Assembly to consider the matters outlined in paragraphs 135 and 136, above, on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary;

(ii) financial assistance allocated to enable certain delegations to attend the next session of the Committee should, exceptionally, also be made available for those sessions of the Working Group, subject to the availability of sufficient funds.”

3. Paragraphs 135 and 136 of the Committee’s report read as follows:

“135. As to the future work program, the International Bureau suggested that, following the session of the Assembly in September-October 2002, PCT reform should focus on issues of two kinds. First, those proposals for reform which had already been submitted to the Committee or the Working Group, but not yet considered in detail, should be reviewed. Those proposals involved possible changes to both the Treaty Articles and the Regulations. Second, considerations should be given to options for revising the Treaty itself.

“136. The International Bureau offered to prepare, for the next meeting at the working level, a document listing all outstanding proposals, indicating whether they would involve changes to the Regulations or the Treaty itself, as well as a document outlining options for a possible revision of the Treaty itself. In addition, delegations should be invited to make any (further) proposals related to those matters.”

4. The Assembly (see document PCT/A/31/10, paragraph 44):

“(i) took note of the report of the second session of the Committee on Reform of the PCT contained in document PCT/R/2/9a and reproduced in Annex II to document PCT/A/31/5;

[...]

“(iii) unanimously approved the Committee’s recommendations concerning the work program in connection with reform of the PCT to be undertaken between the September 2002 and September 2003 sessions of the Assembly, including the matters to be considered, the convening of sessions of the Working Group and possibly the Committee, and financial assistance to enable attendance of certain delegations, as set out, respectively, in paragraphs 135 and 136, 140 (i) and 140 (ii) of the Committee’s report.”

5. Pursuant to the Assembly’s decision, the Director General convened the third session of the Working Group in Geneva from November 18 to 22, 2002, and the fourth session from May 19 to 23, 2003. It was not felt necessary to convene a session of the Committee between the September 2002 and September 2003 sessions of the Assembly.

THIRD SESSION OF THE WORKING GROUP

6. At its third session, the Working Group considered a number of matters as recommended by the Committee and agreed by the Assembly (see document PCT/R/2/9, paragraphs 49, 125, 135 and 136, and document PCT/A/31/10, paragraphs 44 (ii) and (iii) and 65). The summary by the Chair of the third session (document PCT/R/WG/3/5) is reproduced in Annex I to this document. The summary sets out the status of the matters discussed by the Working Group, noting the range of views expressed and areas where agreement had been reached, and identifying what future work needed to be undertaken. The Working Group agreed that specific proposals should be prepared, as mentioned in the

summary, by the Secretariat and/or the delegations specified, taking into account the discussion and conclusions reflected in the summary and other points of detail noted by the Secretariat, for further consideration by the Working Group, where possible at its next session; such proposals would in the short term involve amendment of the Regulations rather than revision of the Treaty (see document PCT/R/WG/3/5, paragraph 112; see also paragraph 8, below).

7. The matters considered by the Working Group and the results of their consideration at the session are outlined briefly in the following paragraphs.

8. *Options for a possible revision of the PCT:* The Working Group did not reach any conclusions as to proceeding with specific proposals for revision of the Treaty itself but identified a number of difficulties and issues which would need to be addressed in the event that a decision was made, at some time, to revise the Treaty (see document PCT/R/WG/3/5, paragraphs 6 to 12). The Working Group agreed that proposals for consideration in the short term would primarily be dealt with by way of amending the Regulations, but longer term proposals involving revision of the Treaty should also be identified and draft provisions prepared (see document PCT/R/WG/3/5, paragraph 112).

9. *Restoration of the right of priority:* The Working Group agreed that a revised proposal should be prepared by the International Bureau and agreed on an approach to addressing certain divergent views relating, in particular, to the criteria of “due care” and “unintentionality” (see document PCT/R/WG/3/5, paragraphs 13 to 27).

10. *Correction and addition of priority claims:* The Working Group agreed that certain proposed amendments of the PCT Regulations (concerning Rules 26 *bis*.1 and 80.8) should be submitted to the Assembly for adoption at its present session (see document PCT/R/WG/3/5, paragraph 29). However, upon further reflection, it appears that consequential substantive amendments of other Rules are also needed. Proposed amendments of Rules 26 *bis*.1 and 80.8 are thus not included in document PCT/A/32/4, but the International Bureau proposes to resubmit the matter to the Working Group for further consideration.

11. *Outstanding proposals for reform of the PCT:* The Working Group considered proposals in relation to the following matters: concept of designations; nationality and residence requirements; conform PCT requirements to the PLT; formalities review; international filing fee; receiving office as main point of contact; divisional applications; multiple dependent claims; sequence listings; form of amendments; time limit for response to a written opinion; electronic transmission of international search report and international preliminary examination report; copyright issues raised by the international search and preliminary examination procedure; rectification of obvious errors; irregularities in the mail service; international form for national phase entry; time limit for national phase entry; time limit for translations for national phase; status information on national phase entry; prior art effect and reservations under Article 64(4); alignment of the PCT with the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement); technical assistance; international search and preliminary examination; unity of invention; greater regionalization of international searching and preliminary examining authorities. A summary

¹ References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) (“the Treaty”) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be.

of the results of the discussions on those matters, including future steps agreed by the Working Group, are set out in document PCT/R/WG/3/5, paragraphs 30 to 100, 112 and 114. Further consideration of certain of those matters took place at the fourth session of the Working Group; see paragraphs 14 to 25, below.

12. *Common quality framework for international search and international preliminary examination:* A summary of the Working Group's discussions appears in document PCT/R/WG/3/5, paragraphs 101 to 111 and 113; see paragraph 111, in particular, as to the work being undertaken by the Meeting of International Authorities Under the PCT on combined PCT International Search and Preliminary Examination Guidelines and as to the establishment of the "virtual" task force which considered a PCT quality framework.² Further consideration of the matter took place at the fourth session of the Working Group (see paragraph 20, below).

FOURTH SESSION OF THE WORKING GROUP

13. At its fourth session, the Working Group further considered some of the matters mentioned above and also considered certain other matters. The summary by the Chair of the fourth session (document PCT/R/WG/4/14) is reproduced in Annex II to this document. The summary sets out the status of the matters discussed by the Working Group, noting the range of views expressed and areas where agreement had been reached, and identifying what future work needed to be undertaken. The matters considered by the Working Group and the results of their consideration at the session are outlined briefly in the following paragraphs.

14. *Amendments adopted by the PCT Assembly in 2002: Corrigenda and consequential amendments:* The Working Group agreed that a number of proposed corrigenda and consequential amendments, further to the amendments of the Regulations adopted by the PCT Assembly on October 1, 2002, that are due to enter into force on January 1, 2004, should be submitted to the Assembly for adoption at its present session (see document PCT/R/WG/4/14, paragraphs 5 to 15). Proposed amendments are accordingly included in document PCT/A/32/4.

15. *Annex to the international preliminary examination report:* The Working Group agreed that proposed amendments of Rule 70.16 should be submitted to the Assembly for adoption at its present session (see document PCT/R/WG/4/14, paragraphs 16 to 18). Proposed amendments are accordingly included in document PCT/A/32/4.

16. *Computation of time limits:* The Working Group agreed that proposed amendments of Rule 80.5 should be submitted to the Assembly for adoption at its present session (see document PCT/R/WG/4/14, paragraphs 19 to 22). Proposed amendments are accordingly included in document PCT/A/32/4.

17. *Proposed abolition of the handling fee and incorporation into the international filing fee:* After considerable discussion, the Working Group agreed that revised proposals with regard to the amounts of the international filing fee and the handling fees should be prepared by the International Bureau with a view to their submission to the Assembly at its present session, the latter being retained as a separate but reduced fee, taking into account the need to

² The electronic forum established to enable the work of the PCT Quality Framework Task Force is at <http://www.wipo.int/pct/reform/qualityframework/en>.

generates the same level of income from fees as mentioned in documents PCT/R/WG/4/8 and WO/PBC/6/4 (see document PC/TR/WG/4/14, paragraphs 23 to 34). Proposed amendments are accordingly included in document PCT/A/32/1.

18. *Options for restoration of the right of priority:* Divergent views continued to be expressed as to the appropriate criterion for restoring the right of priority (“due care” or “unintentionality”). The Working Group agreed that a further revised proposal should be prepared by the International Bureau for consideration by the Working Group at its next session, combining certain elements of the different options discussed and taking into account suggestions made at the session. (See document PCT/R/WG/4/14, paragraphs 35 to 44.)

19. *“Missing part” requirements (changes related to the Patent Law Treaty (PLT)):* A number of proposals were discussed with a view to their revision by the International Bureau and further consideration by the Working Group (see document PCT/R/WG/4/14, paragraphs 45 to 71).

20. *Common quality framework for international search and preliminary examination:* The Working Group approved the content of the draft quality framework set out in Annex I to document PCT/R/WG/4/12, subject to certain modifications, and agreed that the text should be incorporated, subject to necessary redrafting, into the draft PCT International Search and Preliminary Examination Guidelines which were under review by the Meeting of International Authorities Under the PCT. The Working Group noted as a suggestion that the quality framework might also, when experience in its operation had been gained, be considered for adoption as a WIPO standard or model for use by other Offices as well as the International Authorities. The Working Group agreed that the mandate of the quality framework task force (see paragraph 12, above) had been discharged and that it should be considered disbanded. (See document PCT/R/WG/4/14, paragraphs 72 to 81.)

21. *Options for future development of international search and examination:* The considerable discussion on this issue is summarized in document PCT/R/WG/4/14, paragraphs 82 to 91. There was a divergence in views as to whether the Working Group should at this stage discuss options for future development of international search and examination as set out in document PCT/R/WG/4/7. Some delegations expressed preliminary views as to possibilities for future development. The Chair concluded that document PCT/R/WG/4/7 should remain on the agenda for further discussion at a later session of the Working Group. The International Bureau would explore options which might be available to States that wished to make greater use of international search and examination, such as through optional protocols to the Treaty, for discussion at the next session of the Working Group. (See document PCT/R/WG/4/14, paragraphs 82 to 91.)

22. *Declaration of the source of genetic resources and traditional knowledge in patent applications:* The Working Group considered proposals by the Delegation of Switzerland regarding the declaration of the source of genetic resources and traditional knowledge in patent applications (see document PCT/R/WG/4/13). The considerable discussion is summarized in document PCT/R/WG/4/14, paragraphs 92 to 96. In view of the discussion and the divergence in views, the Delegation stated that it would appear that more time was needed to further study the issues, and requested that the proposals contained in document PCT/R/WG/4/13 be further discussed at the next session of the Working Group.

23. *Late furnishing of fees for late submission of sequence listings:* The Working Group agreed that the International Bureau should prepare revised proposals taking into account the

comments and views expressed at the session (see document PCT/R/WG/4/14, paragraphs 97 to 102).

24. *Automatic indication of all designations possible under the PCT:* A suggestion made by the representative of a user or organization to change the request form was not proceeded with (see document PCT/R/WG/4/14, paragraph 103).

25. *Matters on which consideration was deferred:* Having regard to the time available for discussion during the fourth session of the Working Group, consideration of the following matters was deferred until the next session: aspects of copyright and other rights in non-patent literature made available by intellectual property Offices; simplified protest procedure in case of non-unity of invention; publication of translation furnished by the applicant; international form for national phase entry; rectification of clear mistakes (obvious errors); form of amendments; formalities checking under the PCT; central electronic deposits system for nucleotide and amino acid sequence listings; divisional applications under the PCT; period for performing the international search (see document PCT/R/WG/4/14, paragraphs 104 and 105).

FUTURE WORK

26. It is proposed:

(i) that two sessions of the Working Group should be convened between the September 2003 and September 2004 sessions of the Assembly to consider proposals for reform of the PCT including, in particular, the matters for further consideration identified above, on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary; and

(ii) that financial assistance allocated to enable certain delegations to attend the next session of the Committee should, exceptionally, also be made available for those sessions of the Working Group, subject to the availability of sufficient funds.

27. *The Assembly is invited:*

(i) *to note the summaries by the Chair of the third and fourth sessions of the Working Group on Reform of the PCT contained in documents PCT/R/WG/3/5 and PCT/R/WG/4/14 and reproduced in Annexes I and II of this document; and*

(ii) *to approve the proposals concerning future work contained in paragraph 26(i) and (ii), above.*

[Annex I follows]

ANNEX I

SUMMARY BY THE CHAIR OF THE THIRD SESSION
OF THE WORKING GROUP ON REFORM OF THE PCT
(reproduced from document PCT/R/WG/3/5)

INTRODUCTION

1. This session was opened by Mr. Francis Gurry, Assistant Director General, who welcomed the delegates on behalf of the Director General.
2. Mr. Philip Thomas (WIPO) acted as Chair of the session, as agreed by the Working Group, and Mr. Claus Matthes (WIPO) acted as Secretary. The list of participants is contained in Annex I.^[*]
3. The matters for discussion at the session were the following, as recommended by the Committee on Reform of the Patent Cooperation Treaty (PCT) (“the Committee”) at its second session held in July 2002 and agreed by the Assembly of the PCT Union (“the Assembly”) at its 31st (18th extraordinary) session in September - October 2002 (see the Committee’s report in document PCT/R/2/9, paragraphs 49, 125, 135 and 136, and the Assembly’s report in document PCT/A/31/10, paragraphs 44(ii) and (iii) and 65):¹
 - (i) options for a possible revision of the PCT;
 - (ii) restoration of the right of priority; correction and addition of priority claims;
 - (iii) outstanding proposals for reform of the PCT;
 - (iv) common quality framework for international search and international preliminary examination.

The working documents are listed in Annex II.^{*}

4. This session’s proceedings were informal and there was no formal report. This summary sets out the status of the matters discussed by the Working Group, noting the range of views expressed and areas where agreement has been reached, and identifying what future work needs to be undertaken. Particular interventions are in general not recorded in the summary.

EXPECTED ACCESSION TO THE PCT BY EGYPT

5. The Working Group was pleased to take note of a statement by the Delegation of Egypt that accession by Egypt to the PCT was expected in the near future.

[*] [The list of participants and list of working documents are not reproduced here but are available as Annexes I and II, respectively, of document PCT/R/WG/3/5.]

¹ Working documents for sessions of the Assembly, the Committee and the Working Group are available on WIPO’s Website via <http://www.wipo.int/pct/en/meetings>.

APPROACH TO FURTHER REFORM: OPTIONS FOR REVISING THE TREATY²

6. Discussions were based on documents PCT/R/WG/3/3 and 3 Add.1.
7. In considering what approach should be taken to further reform of the PCT, the Working Group considered the questions of whether the Treaty itself should be revised and, if so, of how a possible revision of the Treaty should be achieved. In particular, the difficulties raised by the possible coexistence of original and revised versions of the Treaty would need to be addressed. It was noted that the Assembly had, on the recommendation of the Committee, requested that options for revising the Treaty be considered by the Working Group.
8. A number of delegations expressed the view that the Treaty would, at some stage, need to be revised. However, the question of whether, and more particularly that of when, a revision should be undertaken would depend on what changes to the PCT system were proposed and on the priority attached to them. If the desired changes were very extensive, they might be better introduced by way of adoption of a new Treaty to replace the existing one than by a revision of the existing one. Related developments in the harmonization of formal, procedural and substantive aspects of patent law needed also to be taken into account, notably, in the form of the Patent Law Treaty adopted in 2000, which had not yet come into force, and the draft Substantive Patent Law Treaty presently being considered by the Standing Committee on the Law of Patents.
9. The Working Group agreed that there was a limit to the kind of changes which could be achieved by amending the Regulations within the boundaries of the provisions of the Treaty, and that the way in which particular changes needed to be implemented would depend on their nature. The approach to further reforms should not be constrained by a limitation to changes achievable by way of amending the Regulations. It was generally felt that the approach to revision of the Treaty should therefore be discussed progressively along with particular proposals for change to the system.
10. Certain delegations felt that further reforms should await the development of experience on the recently adopted changes had been implemented, particularly those relating to the new enhanced international search and preliminary examinations system. Other delegations, however, expressed the desire to proceed now with further reforms aimed at meeting the objectives agreed by the Assembly, including simplification and streamlining of procedures and avoiding unnecessary duplication in the work carried out by PCT Authorities and by national and regional Offices.
11. As to how a revised version of the Treaty should be introduced, it was generally felt that the difficulties which would inevitably be caused by the existence of parallel versions of the Treaty would need to be avoided or minimized. If both versions were to be in force at the same time, great confusion would arise for applicants, third parties, Offices and member

² References in this document to "Articles" and "Rules" are to those of the Patent Cooperation Treaty (PCT) ("the Treaty") and the Regulations under the PCT ("the Regulations"), or to such provisions as proposed to be amended or added, as the case may be. Reference to "national laws," "national applications," "the national phase," etc., include reference to regional laws, regional applications, the regional phase, etc. Reference to "PLT Articles" and "PLT Rules" are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT.

States, both as to the right to file applications and the right to seek protection in the two versions in the Contracting States bound by them.

12. A number of delegations and representatives of users thus expressed a preference for simultaneous termination of the existing system and commencement of the new system. However, it was recognized that this could only be effective if sufficient time was allowed for all countries party to the existing version of the Treaty to adhere to the revised version, and it was inevitable that some time would be needed for this. It would be undesirable if any States party to the existing version were not bound by the new version by the time it came into force. In any event, transitional provisions would of course be needed to enable the continued processing of applications that were pending at the time of the commencement of the revised version.

RESTORATION OF THE RIGHT OF PRIORITY

13. Discussions were based on documents PCT/R/WG/3/2 and 2 Add. 1.

14. There was little support for the proposal by the International Bureau in document PCT/R/WG/3/2 that the criterion for restoration of the right of priority should, at the choice of the applicant, be either "due care" or "unintentionality," with a higher fee being payable where the applicant chooses to request the receiving Office to apply the "unintentionality" criterion.

15. Several delegations and representatives of users emphasized the importance of enabling restoration of the right of priority, noting that unintentional errors and unforeseen difficulties in meeting the priority deadline were a fact of life for applicants and their representatives, notwithstanding their keen desire to respect it. Although a number of delegations expressed the desire for a single criterion to be established in connection with the restoration of the right of priority by receiving Offices in the international phase, there was no agreement as to what that criterion should be.

16. A considerable number of delegations and representatives of users were of the opinion that the criterion to be applied by receiving Offices in the international phases should be "unintentionality," stating that such an approach would be more user-friendly and also simpler for receiving and designated Offices to apply, and that it would bring about more uniformity among Offices. Several other delegations and one representative favored the adoption of the more stringent criterion of "due care," on the understanding that any designated Office would be free to apply a more liberal criterion (such as "unintentionality") to the application when it entered the national phase.

17. It was noted that, under the proposal for a "due care" criterion as just outlined, where the receiving Office refused a request for restoration, the dates for international publication and national phase entry would expire up to 14 months later than would have been the case if the request had been allowed. A subsequent request for restoration before a designated Office in the national phase on the basis of "unintentionality" would be difficult to sustain since, if it were to be allowed, the "proper" dates for international publication and national phase entry would, in retrospect, be up to 14 months earlier than had in fact been the case. The applicant may therefore be obliged to request early international publication and to enter the national phase early, on the basis of time calculated from the earlier priority dates sought, in the hope that the request for restoration would be allowed by the designated Office.

18. The proposal by the EPO in document PCT/R/WG/3/2 Add.1 would enable the applicant to request restoration on the ground of “unintentionality” in the national phase if a request based on “due care” had been refused in the international phase. While some delegations supported the proposal, it was noted that it would oblige the applicant to request restoration during the international phase on the ground of “due care” even in cases where that criterion was clearly not complied with, simply in order to be able to pursue the matter further in the national phase on the ground of “unintentionality”. Some delegations and representatives of users pointed to the desirability of enabling the applicant to place on file, before the publication date, a statement of intention to request restoration later in the national phase and evidence in support of that request.

19. One delegation said that one of its user groups had suggested that a possible approach could be to automatically retain in the international application any priority claim which was based on an earlier application with a filing date earlier than 12 months, but not more than 14 months, from the international filing date, leaving the possibility of restoration to be governed by the national law and decided separately by each designated Office. Several delegations and representatives of users expressed the concern that such an approach, while in compliance with the requirements of the PLT, would lead to a diversity of practices among designated Offices and require the applicant to engage in a multitude of parallel procedures in which essentially the same issue was at stake.

20. Several delegations suggested that guidance should be provided in the context of the PCT as to the application of the two criteria, noting that no such guidance was provided in the context of the provisions concerning the matter in the PLT and that little information was available as to the present practices of the various Offices. One delegation suggested that it would be useful to conduct a survey of present practices by sending a questionnaire to all PCT Offices and Authorities. That survey should seek information as to the application of the criteria of “due care” and “unintentionality” in general, that is, not restricted to cases where restoration of the right of priority was sought, but also in cases, for example, of late payment of annuities, in order to obtain guidance as to the differences between the two criteria and to assist in the establishment of guidelines. The questionnaire should also seek information as to the proof required.

21. Certain delegations suggested that provisions for restoration of the right of priority should not be proceeded with until a majority of PCT Contracting States provided for such restoration under their national law, which would be in compliance with the PLT. However, a majority expressed the view that a solution to this question of principle should not be delayed, noting that the inclusion in the Regulations of provisions dealing with restoration of the right of priority would, in the long term and notwithstanding the likelihood that a number of Contracting States would make transitional reservations, encourage national laws to provide for the matter in a harmonized way.

22. Several delegations expressed concern as to whether the draft provisions as proposed by the International Bureau were compatible with the provisions of Article 8(2)(a), which referred to the Paris Convention with regard to the conditions for, and the effect of, priority claims, and Article 27(5), which stated that nothing in the Treaty and the Regulations was intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desired. In the latter connection, it was pointed out that the inclusion of provisions in the PLT for restoration of the right of priority suggested that the procedure was not regarded as a substantive matter

in the context of the PLT. One delegation commented that the distinction between procedural and substantive aspects of the proposal was unclear and should be further explored.

23. In connection with review during the national phase of a receiving Office's decision on a request for restoration of the right of priority, some delegations questioned whether there was a need, in proposed Rule 26 *bis* 3(j), to distinguish between the "designated Office" on the one hand and the "designated State" on the other, and suggested that the provision might better refer to what was permitted or required in the national law. Other delegations suggested that designated Offices should be able to review any decision by the receiving Office on the grounds that it was erroneous. Doubt was expressed by another delegation as to how far the Regulations could restrict the circumstances in which a decision of the receiving Office could be reviewed by a court in the national phase.

24. One delegation suggested that a provision similar to proposed Rule 26 *bis* 3(k) should be included to enable receiving Offices, as well as designated Offices, to make transitional reservations in relation to proposed Rule 26 *bis* 3(a) to (j).

25. In the light of the discussions, the Working Group agreed that:

(i) the proposal to leave the choice of criterion to the applicant, as proposed in document PCT/R/WG/3/3, was not supported;

(ii) there was no general agreement as to which of the two criteria for restoration provided for in the PLT, namely "due care" or "unintentionality," should apply in the case of determinations by a receiving Office;

(iii) it would be preferable to continue to seek a solution under which a decision of the receiving Office to restore the right of priority would be given proper effect by designated Offices, rather than to leave the matter to be determined separately by each designated Office under a variety of national laws;

(iv) it was necessary to ensure that any provision concerning restoration of the right of priority was compatible with Articles 8 and 27(5), although it was noted that, under the PLT, the restoration of the right of priority was not considered to be a matter of substance;

(v) practical problems and confusion would arise if receiving Offices were obliged to apply one criterion as a receiving Office and a different criterion as a designated Office or national Office;

(vi) whatever solution, if any, were to be found, there would be a need for guidance, preferably in the PCT Receiving Office Guidelines, on the practice to be followed.

26. It was agreed that the International Bureau should prepare a revised proposal presenting three options for further consideration by the Working Group providing, respectively, for the criterion of "due care," for the criterion of "unintentionality," and for the automatic retention of the priority date for the purposes of the international phase, leaving the question whether its restoration was allowable to the national phase. The revised proposal would also provide, under any of those options, for an indication of the intention to request restoration and for supporting evidence to be filed in the international phase and to be included in the international publication.

27. It was also agreed that the International Bureau should send a questionnaire to all PCT Offices and Authorities requesting information as to the application of such criteria under the various national laws and practices.

CORRECTION AND ADDITION OF PRIORITY CLAIMS

28. Discussions were based on document PCT/R/WG/3/2.

29. The Working Group approved the proposed amendments of Rule 26bis.1 and the proposed addition of a new Rule 80.8, to the extent that the latter dealt with the correction and addition of a priority claim under Rule 26bis.1, with a view to their possible submission to the Assembly for adoption at its next session in September - October 2003.

OUTSTANDING PROPOSALS FOR REFORM OF THE PCT

Concept of Designations

30. Discussions were based on document PCT/R/WG/3/1, Annex II, item 1 (eliminate concept of designations).

31. It was agreed that, since the Assembly had now adopted amendments to the Regulations that in effect abolished the procedure for making specific designations, there was no need for further action on the matter in the short term, but that the International Bureau should prepare draft revised provisions of the Treaty, eliminating reference to designations, for consideration in the long term.

Nationality and Residence Requirements

32. Discussions were based on document PCT/R/WG/3/1, Annex II, item 2 (eliminate nationality and residence requirements).

33. It was noted that the concept of nationality and residence requirements had been already considered at the first session of the Committee, which had recommended that this matter not be referred to the Working Group for consideration.

34. Although there was still some support for eliminating the concept, at least in the long term, the Working Group agreed that an international application should not be allowed to proceed if the applicant did not comply with the nationality and residence requirements. However, it was agreed that a more limited question should be considered further by the Working Group, namely, whether an international application filed by an applicant who did not comply with those requirements should be accorded an international filing date, the defect being correctable, and that the International Bureau should present a draft proposal accordingly.

Conform PCT Requirements to the PLT

35. Discussions were based on document PCT/R/WG/3/1, Annex II, items 3 (conform PCT filing date requirements to PLT), 4 (conform PCT missing part - type requirement to PLT) and 29 (combine PLT and PCT into a single agreement).

36. It was recalled that, for conformity with certain provisions of the PLT, the Assembly had already adopted provisions for reinstatement of rights after failure to perform the acts necessary for entry into the national phase (see document PCT/A/31/10, paragraph 45(i)) and the Working Group was still considering a proposal for restoration of the right of priority (see paragraphs 13 to 27, above). It was also noted that the Assembly had already agreed with the view of the Committee that the language requirements for obtaining an international filing date were compatible with the PLT (see document PCT/A/31/10, paragraph 44(ii)). In addition, it was recalled that the requirement for the presence of claims as a filing date requirement under the PCT had raised a question of conformity with the PLT (see document PCT/R/WG/1/9, paragraphs 25 and 26).

37. The Working Group agreed that, as a matter of principle, the PCT should, as far as possible, be brought into conformity with the PLT. Although one delegation considered that this should be done as a matter of priority, other delegations were of the view that, in order to minimize inconsistencies between national and international procedures, the matters should not be proceeded with until more States had adhered to the PLT.

38. One delegation noted that although proposals to conform filing missing part-type requirements with those of PLT had been presented to the Working Group at a near-lie session, those proposals had not been fully considered owing to lack of time. It was agreed that the International Bureau should resubmit the proposals for further consideration.

39. One delegation suggested that revision of the PCT should be looked at from a fundamental viewpoint. An important objective should be to establish a new treaty that applied to both national and international applications and that incorporated the PLT and the future SPLT. Another delegation emphasized that, at the 37th Series of Meetings of the Assemblies of the Member States of WIPO in September-October 2002, the Director General had reiterated his commitment that the Secretariat would arrange a study of the impact of the patents system on developing countries, and noted that the results of that study would need to be taken into account in drafting such a new treaty.

40. It was agreed that, as part of its longer term work, the International Bureau should consider the amendments to the PCT Articles that would be needed to achieve greater conformity with the PLT.

Formalities Review

41. Discussions were based on document PCT/R/WG/3/1, Annex I, item 1 (reduce or eliminate formalities review).

42. Several delegations expressed the view that procedures relating to the checking of formalities by both the receiving Offices and the International Bureau should be reviewed so as to avoid unnecessary duplication of work and further streamline procedures. This would require consideration of many current processes, but would be particularly relevant to procedures relating to international applications filed and processed, in the future, in electronic form.

43. It was agreed that the International Bureau should work with interested delegations and representatives of users, using the PCT reform electronic forum, to identify:

(i) formalities checking processes that were carried out by both receiving Offices and the International Bureau, with a view to proposing changes to the Administrative Instructions and the PCT Receiving Office Guidelines to do away with any unnecessary duplication;

(ii) simplifications in the formalities review that could be progressively implemented together with the planned implementation of electronic filing and processing of international applications under the PCT.

International Filing Fee

44. Discussions were based on document PCT/R/WG/3/1, Annex I, items 15 (eliminate fee for each page in excess of 30 sheets) and 16 (re-assess fees).

45. It was recalled that, following the amendments of the Regulations adopted by the Assembly in October 2002 and the introduction of the “flat” international filing fee, which would come into effect on January 1, 2004, a process to determine the amount of that fee had already started. As part of that process, the structure of fees payable for the benefit of the International Bureau would be reviewed, including the need for a separate handling fee under Chapter II. (See document PCT/A/31/10, paragraphs 50 and 51.) With regard to the fee for each page in excess of 30 sheets, it was intended to review that fee at a later date, once electronic processing of international applications filed in electronic form was more fully implemented. In response to a concern expressed by the Delegation of Japan that elimination of the fee for each page in excess of 30 sheets might increase the filing of unnecessarily long international applications, the International Bureau observed that the need for an extra fee in respect of “mega-” applications might be considered (see also paragraph 96, below). In the light of these comments, the Working Group agreed that any further consideration by it of the matter should await the implementation of more fully electronic processing of international applications.

Receiving Offices as Main Point of Contact

46. Discussions were based on document PCT/R/WG/3/1, Annex I, item 14 (payment of Chapter II fees directly with receiving Offices) and Annex II, item 25 (change address to which particular documents have to be sent).

47. One delegation suggested that, in order to make the PCT more user friendly, an applicant who so wished should be permitted to pay fees under Chapter II to the receiving Office instead of to the International Preliminary Examining Authority, and to permit the submission to the receiving Office of all documents that are required in the international phase. Another delegation referred to the desirability of having a consistent approach to where documents could be filed. However, other delegations, while recognizing certain advantages for applicants, pointed to the problem of prescribing the amounts and currencies of the Chapter II fees payable to receiving Offices for the benefit of the International Preliminary Examining Authority, and to the extra workload involved in transmitting the documents concerned from receiving Offices to the relevant International Authority or the International Bureau, as well as the delays which would be likely to result from such a system. It was also noted that, in the future, with the greater implementation of electronic filing systems, it would become easier for applicants to submit documents directly to International Authorities and the International Bureau.

48. In the light of these comments, the Working Group noted the proposals and decided that the matters should be reconsidered at a later stage in the light of further experience gained with electronic filing and processing of international applications.

Divisional Applications

49. Discussions were based on document PCT/R/WG/3/1, Annex II, item 6 (allow for divisional applications to be filed under the PCT).

50. Several delegations supported the proposal that further considerations should be given to providing under the PCT for the filing of international applications as divisional applications of earlier international applications, with a view to taking the greatest possible advantage of the centralized processing offered by the international phase, particularly in cases where there had been a finding of lack of unity of invention. However, while there was no objection in principle to such a possibility, it was recalled that problems had been identified when such a proposal had been made in the past, in particular with regard to the added complexity involved, to the difficulty in according an international filing date in accordance with both Article 11 and the Paris Convention, and to the need for compliance with time limits for international search and international preliminary examination.

51. It was agreed that the International Bureau, in cooperation with the Delegation of the Netherlands, should further consider the matter and that any proposal which emerged would be considered by the Working Group at a future session.

Multiple Dependent Claims

52. The Representative of the EPO proposed to amend Rules 6.4(a) and 66.2(a), noting that the treatment in these Rules of "multiple dependent claims," and of multiple dependent claims depending on other multiple dependent claims, was unnecessarily complicated and might usefully be simplified. It was agreed that the EPO should submit a written proposal for consideration by the Working Group.

Sequence Listings

53. Discussions were based on document PCT/R/WG/3/1, Annex I, item 5 (eliminate invitation for missing sequence listings).

54. The Representative of the EPO reported that about 50% of international applications containing disclosure of nucleotide and/or amino acid sequences were not accompanied by a sequence listing in computer readable form complying with the prescribed sequence listing standard and this made it impossible for the International Searching Authority to carry out a meaningful international search. The issuance of invitations under Rule 13 *ter.* 1(a)(ii) to furnish missing sequence listings or to correct defective listings was a burden on the Office, particularly as in some cases several invitations were necessary. The Representative therefore proposed that International Searching Authorities should no longer be obliged to issue invitations under that Rule, and suggested that there should be no obligation to search the international application if a sequence listing complying with the standard was not provided on the filing date or, if possible, the late filing of such sequence listings should result in the according of a later international filing date, similar to the case of late furnished drawings.

55. Several delegations and representatives of users opposed the proposal on the basis that applicants should continue to have the right to correct the formal defect of a missing or non-compliant sequence listing in computer-readable form by furnishing such listing upon invitation by the Authority. It was noted that Rule 13 *ter.1(a)(ii)* and (e) did not obligate the Authority to invite the applicant who had not done so to furnish a sequence listing in computer-readable form complying with the required standard. However, if the Authority did not issue such invitation, it would have to carry out a full international search on the basis of the sequence listing that had been furnished (see Rule 13 *ter.1(c)* and (e)).

56. With regard to the proposal to move the international filing date to the date on which a sequence listing in computer-readable form complying with the standard was received by the Authority, noting that the purpose of the sequence listing in computer-readable form was merely to allow the Authority to perform a meaningful search but not to disclose the invention, several delegations questioned whether the proposal was consistent with the filing date requirements of either the PCT or the EPLT. It was noted that, for the purposes of disclosure, a sequence listing part had to be included in the description of the international application itself, and that Rule 20.2 already covered cases where sheets pertaining to that sequence listing part of the description were received after the international filing date.

57. In view of these objections and comments, the Working Group agreed not to proceed with the proposal. However, recognizing that it was desirable that sequence listings complying with the prescribed standards should be furnished together with the international application so as not to delay the start of the international search, it was agreed that the International Bureau should prepare a proposal which would permit Authorities to require the payment of a late furnishing fee where an invitation had to be issued under Rule 13 *ter.1(a)(ii)* or (e).

58. The Working Group also agreed that, in order to facilitate the processing of sequence listings for the purposes of the international and the national phase of the PCT procedure, the International Bureau should further investigate the possibility of establishing a central electronic deposit system for such listings. Under such a system, similar in certain ways to the system for the deposit of biological material with a depositary institution, a reference to deposited sequence listings would replace the need to include such listing in the description and to furnish such listings, in computer-readable form, to Authorities and designated Offices.

Form of Amendments

59. The Representative of the EPO proposed that Rule 66.8(a) be amended to require the applicant to indicate the basis in the description for amendments rather than merely pointing out the difference from the sheets which had been replaced, which would make the process of examination of the amendments significantly easier. Furthermore, the representative proposed to amend Rule 66.8(b) so as to require the inclusion of sheets whose contents had been cancelled. This would render it unnecessary to specify the cancelled sheets in the international preliminary examination report under Rule 70.11, thus simplifying the production of reports. It was agreed that the EPO should submit a written proposal for consideration by the Working Group.

Time Limit for Response to a Written Opinion

60. The Delegation of Australia proposed that Rule 66.2(d) be amended so as to give International Preliminary Examining Authorities more discretion in fixing the time limit for

response to a written opinion. It was agreed that the Delegation of Australia should submit a written proposal for consideration by the Working Group.

Electronic Transmission of International Search Report and International Preliminary Examination Report

61. Discussions were based on document PCT/R/WG/3/1, Annex I, item 18 (allow for electronic transmission of search/examination results).

62. The Working Group noted that it would be premature to make detailed proposals for the electronic transmission of search and examination results in advance of the implementation of electronic processing of international applications.

Copyright Issues Raised by the International Search and Preliminary Examination Procedure

63. Two delegations observed that the making and sending, by the International Searching Authority, of copies of documents cited in the international search report, as provided by Article 20(3) and Rule 44.3, could involve copyright infringement, in particular where it involved non-patent literature and the first digitization of a document. The International Bureau observed that the library community may also experience similar problems. It was agreed that the International Bureau, in cooperation with the Delegation of Canada and other Authorities, should study the matter with a view to having the matter considered by the appropriate body or bodies within WIPO.

Rectification of Obvious Errors

64. The Representative of the EPO proposed that Rule 91.1(b) be amended so as to refer to a "person skilled in the art" rather than "any one" when determining whether a rectification offered by the applicant was "obvious" under Rule 91.1(b). Several delegations supported the proposal and also expressed the view that, in general, Rule 91 was unnecessarily strict. It was agreed that the EPO and the International Bureau should work together to review Rule 91 and to submit a written proposal for consideration by the Working Group.

Irregularities in the Mail Service

65. The Representative of the EPO proposed that Rules 4.10 and/or 82 be amended so as to clarify that Article 48(1) would also apply to the 12-month priority period where the international application was received outside that period because of interruption in the mail service or an unavoidable loss or delay in the mail. Several delegations supported the proposal and suggested that Rule 82, in particular Rule 82.2, should be reviewed more generally, with the aim of broadening its scope and adapting it better to the introduction of electronic filing of international applications. Moreover, related changes were proposed to be made to Rule 80.5, so as to take into account the fact that, in particular in geographically large countries, an Office may have different branch Offices in different parts of the country in different time zones and with different local holidays.

66. It was agreed that the Representative of the EPO and the Delegations of Australia, Canada and the United Kingdom, which had proposed further Rule changes along the lines just mentioned, should present written proposals for consideration by the Working Group.

International Form for National Phase Entry

67. Discussions were based on document PCT/R/WG/3/1, Annex I, item 11 (introduce international forms for national phase entry).

68. Several delegations and representatives of users supported the introduction of a standardized international form for entry into the national phase, including standard text of declarations similar to those provided for in the case of the request for under Rule 4.17, on the understanding that the use of such a form by applicants would be optional and not a requirement for a valid national phase entry. The Working Group agreed that the International Bureau should prepare such a proposal.

Time Limit for National Phase Entry

69. Discussions were based on document PCT/R/WG/3/1, Annex II, item 19 (accommodate further deferral of national phase entry).

70. One delegation proposed that, in order to provide extra flexibility for applicants, the Treaty should be amended to provide for deferral of the time limit for entry into the national phase. While the proposal found some interest, it was opposed by a number of delegations on the grounds that it would increase uncertainty and thus upset the balance of interest between applicants and third parties. In addition, it was noted that the present provisions already permitted a Contracting State to provide for one or more such deferrals and that several States already did so. It was therefore agreed that the proposal should not be proceeded with at this stage. is

Time Limit for Translations for National Phase

71. Discussions were based on document PCT/R/WG/3/1, Annex II, item 21 (defer time limits for submission of translations).

72. Several delegations and representatives of users stated that it would be desirable to permit applicants a further period of time, after the expiration of the period within which they must enter the national phase, for the filing of any required translation of the international application. At present, applicants had to decide whether to enter the national phase in States for which a translation was required significantly earlier than with regard to States where no such translation was required. Making more time available for furnishing of translations would also help to improve the quality of translations, to the benefit of Offices and third parties. It was noted that such an extension was already granted by many designated Offices under their national laws in accordance with Article 22(3). On the other hand, some national laws presently did not allow for such extensions.

73. It was agreed that the matters should be considered further by the Working Group and that the International Bureau should present a draft proposal accordingly.

74. Concern was expressed by some delegations that, since the 30-month time limit under Articles 22 and 39 applied to several acts which may need to be performed by the applicant in order to enter the national phase, it might not be permissible to modify, under Article 47(2), that time limit in respect of only one of those acts, and suggested that revision of Articles 22 and 39 may be needed.

75. It was agreed that the proposals to be prepared by the International Bureau should, if possible, include alternative implementations by way of possible amendments of the Regulations and a possible modification of the time limits under Articles 22 and 39, and a solution for the long term by way of revision of Articles 22 and 39.

Status Information on National Phase Entry

76. Discussions were based on document PCT/R/WG/3/1, Annex I, item 12 (make available to third parties, from a central source, "status information" on whether and where international applications have entered the national phase).

77. Noting that this matter was being dealt with in the context of the Standing Committee on Information Technologies (SCIT), the Working Group agreed that progress in the SCIT discussions should be followed.

Prior Art Effect; Reservations Under Article 64(4)

78. Discussions were based on document PCT/R/WG/3/1, Annex II, item 28 (delete Article 64(4)).

79. Several delegations and representatives of users expressed the view that deletion of Article 64(4) would be of great benefit for applicants since it would put all international applications on an equal footing with regard to their prior art effect, of particular importance following the recent adoption of the overhaul of the designations system, under which all Contracting States will, generally, be designated in all international applications.

80. The Delegation of the United States of America stated that it could not support the proposal to delete Article 64(4) and expressed the view that the matter could not be discussed in isolation from other prior art related issues currently under discussion in other fora, in particular, the Standing Committee on the Law of Patents (SCP). The Delegations suggested that the SCP rather than the Working Group would be the appropriate forum to discuss this matter which, in its view, was of a substantive nature.

81. The Working Group agreed that further consideration of this matter, while it would be within the competence of the Working Group, should be deferred until progress had been made in discussions of prior art issues by the SCP. The possible revision of Article 64 was in any event a long term matter. It was noted that consideration of the question of prior art effect, so far as the PCT was concerned, would also necessitate a review of the scope of and interaction between Articles 11(3) and 27(5) with Article 64(4), and of the practices followed by certain Offices in this regard.

82. As a related matter, the Working Group agreed that the International Bureau should look into the possibility of amending Rule 48 so as to provide for the electronic publication by the International Bureau of translations, furnished by the applicant, of the international application.

Alignment of PCT with the TRIPS Agreement

83. Discussions were based on document PCT/R/WG/3/1, Annex II, item 26 (align the PCT with the TRIPS Agreement).

84. The Working Group agreed that the matters should not be included in the work program of the Working Group at this stage but should be further considered in the longer term context of a possible revision of the Treaty itself.

Technical Assistance

85. Discussions were based on document PCT/R/WG/3/1, Annex I, item 20 (re-energize technical assistance).

86. The Working Group agreed that technical assistance, as envisaged by Article 51, should be provided to assist smaller Offices in respect of changes in procedures and practices, including the enhanced international search and preliminary examination procedure adopted by the Assembly, and to facilitate better use of international search and preliminary examination reports in the States concerned. The Working Group noted with satisfaction the confirmation by the International Bureau that this was a matter of high priority within WIPO's cooperation for development program.

International Search and Preliminary Examination

87. Discussions were based on document PCT/R/WG/3/1, Annex I, item 7 (oblige applicant to file the demand together with the request), and Annex II, items 5 (eliminate distinction between national/international application), 8 and 13 (allow for multiple international searches and international preliminary examinations), 9 and 15 (combine international search and international preliminary examination), 11 (make optimal use of the available ISAs (create "virtual ISA"), 14 (eliminate the concept of demands), 16 (review confidential nature of the I PER), 17 (allow for the filing of the demand together with the request) and 34 (positive examination results in certain PCT Authorities binding to certain Contracting States). See also the discussion of a common quality framework for international search and preliminary examination at paragraphs 101 to 111, below.

88. Some delegations and one representative expressed the view that it would be preferable to study the impact of the new enhanced international search and preliminary examination system on the overall PCT system and, in particular, on the use by applicants of the international preliminary examination procedure, before looking further into a possible merger of international search and international preliminary examination. One delegation felt that it would be preferable to avoid further enhancements of the international search and preliminary examination procedure in the international phase, leaving outstanding matters for resolution in the national phase.

89. A majority of delegations and representatives, however, were of the opinion that the Working Group's future work should include investigation of the possibility of further integrating the international search and international preliminary examination procedures with the aim of further strengthening the international phase, thus reducing the need for duplication of work by designated Offices during the national phase and providing a more useful and final result of the international phase for use by designated Offices.

90. Noting that the role and the use of international search and preliminary examination, and of the resulting products (international search report and international preliminary examination report), had changed over time and would continue to change in the near future, in particular following the recent adoption of the enhanced international search and preliminary examinations system, several delegations and representatives of users expressed

the view that a bold and fresh look should be taken at the overall approach to international search and preliminary examination, including possibilities of providing for additional services such as supplementary searches or “top -up” searches (towards the end of the international phase), “further international processing” upon request by the applicant, and international preliminary examination upon request by third parties. Several delegations also suggested a greater accommodation in the PCT procedure of the possibility for an Office to simultaneously process a national application filed with it and a corresponding international application in respect of which it carried out international search and preliminary examination.

91. Several delegations, including some representing smaller non -examining designated Offices in developing countries, stressed the need to further strengthen the international phase, in particular following the recent adoption of an enhanced international search and preliminary examinations system, so as to ensure that designated Offices, and particularly smaller ones, would derive greater benefits from the results of the international phase.

92. Several delegations and representatives of users stressed the need, should the overall approach to international search and international preliminary examination be changed, to maintain a sufficiently flexible system which would allow the user to choose between different options and to maintain, in particular, a system which would allow the user to choose to receive the international search report before international publication of the international application concerned and before having to decide, with the incurring of further costs, whether or not to request international preliminary examination and whether or not to proceed into the national phase.

93. The Delegation of Mexico expressed its concern that some of the proposals for possible future development that had been discussed in this session were not covered by the mandate given to the Working Group by the Assembly on the Committee’s recommendation, some were new proposals and others were matters that the Committee had recommended, at its first session, not to be referred to the Working Group. After some discussion about the decision of the Assembly in September -October 2002, the Delegation stated that, in the interests of flexibility and so as to make progress on the issues at hand, it did not wish to delay discussion of those matters by the Working Group, but reserved its position as to the possibility of later drawing the Committee’s attention to the matter.

94. The Working Group agreed that the Secretariat should prepare for consideration at its next session an options paper on possible future development of the international search and preliminary examinations system, including options whereby designated Offices, particularly smaller designated Offices, could derive greater benefit from the results of the international phase.

Unity of Invention

95. Discussions were based on document PCT/R/WG/3/1, Annex I, items 4 (simplify the non-unity procedure before the ISA) and 10 (simplify the non -unity procedure before the IPEA), and Annex II, items 10 and 18 (eliminate unity of invention procedure).

96. Certain delegations proposed the abolition of the protests system before International Searching Authorities under Rule 40 and International Preliminary Examining Authorities under Rule 68, with a view to reducing the workload of the Authorities. The majority of delegations and representatives of users, while recognizing that the procedures under Rules 40

and 68 were cumbersome, opposed the proposal to eliminate the protest procedure altogether on the grounds that it would remove the applicant's right to challenge a finding of non-inventive unity of invention by an Authority, thus increasing the burden on applicants and designated Offices in the international phase and resulting in incomplete searches and examinations of a greater number of international applications. It was suggested that the problem of non-inventive unity in excessively complex or "mega-" applications would be better dealt with by other measures such as by introducing an additional fee based on the number of claims present in the application.

97. The Working Group agreed that the International Bureau should prepare a proposal for simplifying the protest procedure under Rules 40 and 68. It was also agreed that, in order to discover more information about the experience of Authorities regarding this issue, the International Bureau should send out a questionnaire asking them to indicate how many invitations they issued per year under Rules 40 and 68, how many additional fees were paid under protest, and how many of the invitations were in respect of applications containing claims more than, say, 10 inventions.

Greater Regionalization of International Searching and Preliminary Examining Authorities

98. Discussions were based on document PCT/R/WG/3/1, Annex I, items 17 (regionalize current International Searching and Preliminary Examining Authorities) and 19 (create Latin American and Caribbean Patent Office and give status of ISA/IPEA).

99. Two delegations reported that the feasibility of establishing a Latin American and Caribbean Patent Office was still being studied. The creation of such an Office would encourage innovation and obtaining patent rights in the region, but there were possible difficulties involved, including the need to cater for a multiplicity of languages.

100. The Working Group agreed that, since the objectives of uniformity of standards and greater exploitation of the results of work undertaken in other Offices were to be addressed in the context of revised PCT International Search and Preliminary Examination Guidelines and the program for sustained quality and efficiency discussed in paragraphs 101 to 111, below, there was no need at present to pursue proposals for greater regionalization of Authorities. It was observed that it might not be possible to establish an International Searching and Preliminary Examining Authority in every region. One delegation noted that there appeared to be no present moves in the direction of establishing "a single International Searching Authority" as contemplated by Article 16(2), but it was agreed that the International Bureau need not prepare a draft proposal for revision of that Article.

COMMON QUALITY FRAMEWORK FOR INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION

101. Discussions were based on document PCT/R/WG/3/4 containing proposals by the Delegation of the United Kingdom for "a program for sustained quality and efficiency."

102. The Delegation introduced its proposal, stating that a common quality framework was now essential because of workload problems, which were stretching the resources of even medium-sized Offices, such as that of the United Kingdom. Offices were, unfortunately, still reluctant to rely on work done by other Offices, because of a lack of confidence. An agreed mechanism underpinning the quality of work performed by Offices would help examining Offices to trust work done elsewhere and would reduce costs and difficulties for applicants.

Furthermore, it would give non-examining Offices, which had no choice but to make use of the work of other Offices, more confidence in the effectiveness of the system. The Delegation suggested that such a mechanism would require three parts:

- (i) a definition of what the work required (setting of search and examination standards);
- (ii) a set of standards for management of an Office, which ensured that the staff performing the work were properly trained and had the necessary support to do the job, together with a quality assessment mechanism, such as procedures for internal review and customer feedback, to ensure it;
- (iii) a validation mechanism, which checked and demonstrated to others that the first two parts were being done properly; this might include a system with assessment jointly by the Authorities.

103. The Delegation of the United Kingdom further offered to coordinate work aimed at developing a program for sustained quality and efficiency as it had suggested.

104. There was general agreement that the quality of international search and preliminary examination was fundamental to the functioning and the success of the PCT system, though it was pointed out that Offices could not be obliged to make use of a quality framework; participation could only be voluntary. There was also general agreement that combined PCT International Search and Preliminary Examination Guidelines would be the best place in which to define the necessary international search and preliminary examination standards and that the existing Guidelines should be modified accordingly to contain such standards. The Working Group noted that such work had already been commenced by the International Bureau and Authorities with a view to consideration of draft proposals by the Meeting of International Authorities at its next session to be held in February 2003.

105. While some delegations indicated that their views were preliminary, pending further consultation and consideration, it was apparent that there were differences on what should be done to ensure that a uniformly high quality of work was achieved. There was support by many delegations for an approach such as that outlined in document PCT/R/WG/3/4, including some form of external validation mechanism. Those delegations generally felt that an open system would provide benefits both to Offices and to applicants. One delegation suggested that a system based on ISO 9000 might be used. Some delegations suggested that Rules 36 and 63 might be amended to include the requirements of whatever form of quality system might be agreed.

106. Other delegations, however, expressed doubts about the idea of an external review panel assessing the work of the Authorities and suggested instead that internal validation mechanisms should be relied on. With regard to an proposed external review panel, there were questions as to whether it was appropriate, as to its composition and methods of review, as to how its results should be used and reported, and as to what sanctions should be available in the event that adverse findings were made about the work of an Authority. It was stressed that the Authorities were aware of the need for quality in their own work and of the needs of the applicants and designated and elected Offices.

107. Some delegations and representatives of users also suggested that user choice was an important part of the solution: if all Authorities had universal competence, then users could

decide for themselves where the best service was available. It was, however, noted that many applicants at present did not have such a choice as to the Authorities they wished to use.

108. Several delegations representing smaller and non-examining Offices stressed the particular importance of the quality of international searches and international preliminary examinations, since they often relied solely on these in decisions as to whether or not to grant rights. For the same reason, those delegations expressed their hope that, following the introduction of the enhanced international search and preliminary examination system, the use of the international preliminary examination procedure under Chapter II would not be allowed to “fade” since they did not have the capacity to do examination work which had not been completed in the international phase.

109. Several delegations and representatives of users stressed the importance to applicants of having the results of the international search in sufficient time to decide whether to withdraw the international application and whether to enter the national phase.

110. Other comments and suggestions included that:

(i) a common central database containing the entire PCT minimum documentation and accessible by all Authorities would help to ensure consistency;

(ii) mechanisms could usefully be provided for feedback from designated and elected Offices, as well as from applicants and their representatives who received searches carried out by different Offices on applications from the same patent family;

(iii) it may be useful for the International Bureau to arrange meetings or seminars at which Offices could exchange experiences in quality control;

(iv) an extensive examiner exchange program would encourage the development of consistent standards and practices;

(v) “top-up” searches might be introduced into the PCT system, providing for an additional search, late in the international phase, for potentially relevant material which had not yet been included in the relevant search databases at the time of the main international search;

(vi) in relation to the reference to “inventive concept(s)” in the suggested quality criteria in the Appendix, the search could consider the limitations of every claim, rather than a general inventive concept;

(vii) users would benefit from having a single search of a quality that could be relied on, without having to pay several Offices to obtain separate searches from each;

(viii) the definition and monitoring of quality may be a matter to be dealt with in the agreements between the International Bureau and the various Authorities.

111. The Working Group agreed that work in this area should continue along the following two paths:

(a) The standards to which PCT search and examinations should conform should be established in the PCT International Search and Preliminary Examination Guidelines. Work

should continue on revision of those Guidelines, which would be needed by January 1, 2004, when the recently adopted enhanced international search and preliminary examinations system came into effect.

(b) A “virtual” task force should be established to consider which of the other points noted above, or in document PCT/R/WG/3/4, should be taken forward and how. The International Bureau would set up a page on its Website, open to registration by any State or organization represented in the Working Group, with an electronic forum and mailing list to facilitate discussion. The work of the task force would be coordinated by the United Kingdom. The results of the work of the task force would be reported to the Working Group and to the Meeting of International Authorities, the first such report being requested by the end of April 2003.

FUTURE WORK

112. The Working Group agreed that specific proposals would be prepared, as mentioned above, by the Secretariat and/or the delegation specified, taking into account the discussion and conclusions reflected in this summary and other points of detail noted by the Secretariat, for further consideration by the Working Group, where possible at its next session. Proposals for consideration in the short term would primarily be dealt with by way of amending the Regulations, but longer term proposals involving revision of the Treaty should also be identified and draft provisions prepared.

113. The Working Group also agreed that further work would be undertaken on the question of a common quality framework for international search and preliminary examinations as outlined in paragraph 111.

114. The Working Group further agreed that the Secretariat would prepare an options paper on possible future development of the international search and preliminary examination system, including options for a system whereby designated Offices, particularly smaller designated Offices, could derive greater benefit from the results of the international phase. Working papers would, where appropriate, be made available on the PCT reform electronic forum for comment and discussion prior to the next session.

NEXT SESSION

115. The International Bureau indicated that the fourth session of the Working Group was tentatively scheduled for May 19 to 24, 2003.

116. This Working Group noted the contents of this summary by the Chair.

[Annex II follows]

ANNEX II

SUMMARY BY THE CHAIR OF THE FOURTH SESSION
OF THE WORKING GROUP ON REFORM OF THE PCT
(reproduced from document PCT/R/WG/4/14)

INTRODUCTION

1. Mr. Francis Gurry, Assistant Director General, on behalf of the Director General, opened the session and welcomed the participants.
2. As agreed by the Working Group, Mr. Philip Thomas (WIPO) acted as Chair of the session except for the discussions relating to the handling fee (see paragraphs 23 to 33, below) which were chaired by Mr. Francis Gurry (WIPO). Mr. Claus Matthes (WIPO) acted as Secretary. The list of participants is contained in the Annex. ^[*]
3. This session's proceedings were informal and, therefore, there was no formal report. This summary, prepared under the responsibility of the Chair, sets out the status of the matters discussed by the Working Group, noting the range of views expressed and areas where agreement has been reached, and identifying what future work needs to be undertaken. ¹
4. The Secretariat explained that it regretted the late issuance of working documents in French and assured the Working Group that it was making efforts to avoid similar problems in the future.

AMENDMENTS ADOPTED BY THE PCT ASSEMBLY IN 2002: CORRIGENDA AND
CONSEQUENTIAL AMENDMENTS ²

5. Discussions were based on documents PCT/R/WG/4/4 (Annex V), 4 Add.3 and 4 Add.5.

Proposed Amendments of the Regulations

6. The proposed amendments of the Regulations set out in Annex V to document PCT/R/WG/4/4 and in the Annexes to documents PCT/R/WG/4/4 Add.3 and 4 Add.5 were approved by the Working Group with a view to their submission to the Assembly of the PCT Union ("the Assembly") in September 2003, subject to the comments and clarifications appearing in the following paragraphs and to possible further drafting changes to be made by the International Bureau.

[*] [The list of participants is not reproduced here but is available as the Annex to document PCT/R/WG/4/14.]

¹ The working documents for this session are available on WIPO's Website via <http://www.wipo.int/pct/en/meetings>.

² References in this document to "Articles" and "Rules" are to those of the Patent Cooperation Treaty (PCT) ("the Treaty") and the Regulations under the PCT ("the Regulations"), or to such provisions as proposed to be amended or added, as the case may be. References to "national laws," "national applications," "the national phase," etc., include reference to regional laws, regional applications, the regional phase, etc. References to "PLT Articles" and "PLT Rules" are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT.

Rule 16bis.2 (see document PCT/R/WG/4/4Add.3)

7. It was noted that the 75% reduction provided for by the Schedule of Fees in the case of certain applicants from qualifying countries (including most developing countries) would, in effect, carry over to any late payment fee payable under Rule 16bis.2 by virtue of Rule 16bis.2(a)(i).

Rule 17.2 (see document PCT/R/WG/4/4, Annex V)

8. Several delegations expressed the opinion that designated Offices should continue to be able to request copies of priority documents from the International Bureau, even if they were available from a digital library. No digital libraries for priority documents had yet been established, and it would be preferable to await experience with them before changing the current system.

9. Accordingly, the International Bureau withdrew its proposal for the addition of new Rule 17.2(a-bis) and for a consequential amendment of Rule 17.2(a). The Working Group approved the proposed inclusion in Rule 17.2(a) of a reference to paragraph 17.1(b-bis).

Rule 44bis.1 (see document PCT/R/WG/4/4Add.3)

10. The Working Group noted that, while the substantive content of an international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty) would be the same as that of the written opinion of the International Searching Authority on which it was based, it would nonetheless be desirable for the applicant to have a copy of the report itself, bearing in mind that it was the report which would be sent to designated Offices.

Rule 60.1 (see documents PCT/R/WG/4/4Add.3 and 4Add.5)

11. Further to deletion of Rule 60.1(d), the Working Group agreed that consequential amendments should be made to Rule 60.1(c) (deletion of the words "Subject to paragraph (d),") and to Rule 60.1(e) (replacement of the reference to paragraph "(d)" by a reference to paragraph "(c)").

Rule 90.2 (see document PCT/R/WG/4/4Add.3)

12. The Working Group agreed that an indication of the address of the applicant should not be a requirement for an applicant to be appointed as, or considered to be, the common representative under Rule 90.2(a) or (b), respectively. The text presented in square brackets in Rule 90.2(a) as proposed to be amended should therefore be deleted, as should the corresponding text in Rule 90.2(b). The Working Group agreed that the Administrative Instructions should be modified to expressly state to whom correspondence intended for the applicant should be sent to in case the address of the applicant concerned had not been furnished.

Rule 90.5 (see document PCT/R/WG/4/4Add.3)

13. The Working Group agreed that proposed new Rule 90.5(c) and (d) should be worded as follows:

“(c) Any receiving Office, any International Searching Authority and any International Preliminary Examining Authority may waive the requirement under paragraph (a)(ii) that a copy of the general power of attorney is attached to the request, the demand or these separate notices, as the case may be.

“(d) Notwithstanding paragraph (c), where the agent submits any notice of withdrawal referred to in Rules 90 *bis*.1 to 90 *bis*.4 to the receiving Office or the International Preliminary Examining Authority, a copy of the general power of attorney shall be submitted to that Office or Authority.”

Rule 94.2 (see document PCT/R/WG/4/4, Annex V)

14. Following the observation by a delegation that Article 38(1) provided for access to the file of the international preliminary examination by elected Offices once the international preliminary examination report had been established, the International Bureau withdrew its proposal to amend Rule 94.2.

15. The Working Group noted that Rule 73.2 as adopted by the Assembly on October 1, 2002, with effect from January 1, 2004, had to be read in light of Article 38(1) and present Rule 94.2 and would not prevent an elected Office from gaining access to the file of the international preliminary examination once the international preliminary examination report had been established.

ANNEXES TO THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT

16. Discussions were based on document PCT/R/WG/4/4 Add.4.

Proposed Amendments of the Regulations

17. The proposed amendments of the Regulations set out in the Annex to document PCT/R/WG/4/4 Add.4 were approved by the Working Group with a view to their submission to the Assembly in September 2003, subject to the comments and clarifications appearing in the following paragraph and to possible further drafting changes to be made by the International Bureau.

Rule 70.16

18. In approving the addition of proposed new Rule 70.16(b), the Working Group noted that the amendments set out in document PCT/R/WG/4/4 Add.4 to the text of Rule 70.16(a) would not proceed until proposed amendments of Rule 91.1 were dealt with (see document PCT/R/WG/4/4 Add.2).

COMPUTATION OF TIME LIMITS

19. Discussions were based on document PCT/R/WG/4/10.

Proposed Amendments of the Regulations

20. The proposed amendments of the Regulations set out in the Annex to document PCT/R/WG/4/10 were approved by the Working Group with a view to their submission to the

Assembly in September 2003, subject to the comments and clarifications appearing in the following paragraphs and to possible further drafting changes to be made by the International Bureau.

Rule 80.5

21. The Working Group noted that the operation of proposed new items (iii) and (iv) of Rule 80.5 was restricted to the particular case of Offices in countries where there were different public holidays in different localities, for example, where there were branches in more than one locality, and was thus independent of items (i) and (ii), which also dealt with the expiration of time limits, and that no consequential amendment of items (i) and (ii) was needed.

22. The Working Group agreed that the word "neither" should be replaced by "none" in the concluding words of Rule 80.5.

PROPOSED ABOLITION OF THE HANDLING FEE AND INCORPORATION INTO THE INTERNATIONAL FILING FEE

23. Discussions were based on the proposals of the International Bureau contained in document PCT/R/WG/4/8 and of the United States of America contained in document PCT/R/WG/4/8 Add. 1.

24. The discussion covered the related questions of the place in the PCT fee structure of the handling fee paid in respect of demands for international preliminary examination under Chapter II of the PCT, having regard to the recent adoption of an enhanced international search and preliminary examinations system, and the amounts of PCT fees and their implications in the context of WIPO's Program and Budget. The Working Group took into account the report of the sixth session of the Program and Budget Committee, held from April 29 to May 1, 2003 (see document WO/PBC/6/4, especially paragraph 116 (i) to (iv)), at which the Proposed Program and Budget 2004 - 2005 (document WO/PBC/6/2) had been considered.

25. In response to questions raised, the Working Group was informed by the Secretariat that the proposed budget for 2004 - 2005 assumed income on the basis of an average PCT fee of 1,678 Swiss francs. Adoption of the proposal on the fee presented by the United States of America in document PCT/R/WG/4/8 Add. 1, which reflected a fee reduction envisaged by the 2001 PCT Assembly, was seen to result in an average PCT fee of 1,416 Swiss francs and a lower than anticipated income during 2004 - 2005 in the range of 70 to 80 million Swiss francs. It was further noted that maintaining a separate handling fee at the current amount of 233 Swiss francs while maintaining the initial average fee of 1,678 Swiss francs would require an international filing fee of 1,472 Swiss francs. This was based on the assumption that 25% of applicants would opt for Chapter II.

26. The Working Group recognized that PCT fee income received by the International Bureau was used to cover more than the recurrent expenses necessary for the immediate service delivered to users on particular application files. It was recognized that various other units and services within the International Bureau provided essential support to the Office of the PCT and that there was certain capital expenditure that had to be undertaken, in particular in relation to buildings and information technology projects, both specifically for the PCT system and for the other units and services whose support was essential to the PCT system. In

addition, the PCT system constituted, in a sense, a network of Offices, performing various functions, whether in the international phase as receiving Offices or in the national phase as national Offices. An important item of expenditure in relation to PCT fee income was the enhancement, through development cooperation activities, of the services of the PCT system conceived in this way as a whole.

27. While there was general recognition of the foregoing range of objects of expenditure for PCT fees, there was a definite divergence in views in relation to the level that was proposed for PCT fees in the 2004 -2005 biennium to cover those objects of expenditure. That divergence derived essentially from differing views of the balance that should be achieved between the use of PCT fee income for the provision and enhancement of services directly to PCT users and the use of PCT fee income for other objects of expenditure related to the PCT system conceived more broadly and including development cooperation.

28. The minority view considered that the balance had gone against PCT users and that there was a tendency for there to be an insufficient focus on the core mission of the Organization. PCT users, according to the delegations supporting this view, were the source of PCT fee income and should be the principal beneficiaries of the expenditure of that income. These delegations also believed that it was wrong to conceive of PCT users as merely taking from the system, since their inventions, and the patents that they asked for through the PCT system, made important contributions to the improvement of social and economic conditions in the world. The same delegations also expected that there should be reductions in the level of PCT fees in the long run as a result of the capital expenditure that had been and was still being undertaken by the Organization in information technology projects, and also as a result of PCT reform and simplification.

29. On the other hand, the great majority of delegations felt that the level of fees proposed for the next biennium was appropriate and considered it to be appropriate, in particular, because of the expenditure that was needed on the infrastructure of the PCT system conceived as a whole. Those delegations also felt that the rights that were ultimately obtained through the PCT were very important rights that justified both the level of the fees and also the fact that PCT fee income was the source of funding of development cooperation activities for the enhancement of the PCT system as a whole. Some of those delegations also expressed concern about the evolution of demand in the patent system, in general, and the PCT system, in particular, and felt that a certain amount of caution needed to be exercised in fixing the level of PCT fees for the next biennium. They finally emphasized that the quality of service that was delivered to PCT users depended not only on the services that were rendered by the International Bureau, but also on the services that were rendered to PCT applicants throughout the PCT system conceived as a whole.

30. On the question of the level of PCT fees proposed in the draft budget for the next biennium, the majority view was that the level was appropriate, although there were certain important dissensions from that position.

31. In relation to the issue of the structure of PCT fees and whether there should be a single international filing fee or a separate handling fee, strong support was expressed for a separate handling fee. There were, however, some differences of views. Those who supported a separate handling fee tended towards an empirical approach to the matter and suggested that it would be preferable to wait to see what use was made of Chapter II after the enhanced international search and preliminary examination system came into effect in January 2004. Those delegations also felt that it was not consistent with the direction and objectives of the PCT

reform to load the handling fee into a single international filing fee. The opposing view, in favor of a single international filing fee, took account very much of the fact that, under the enhanced international search and examination system that would come into operation, much of the work that was done by the International Bureau under Chapter II would be undertaken under Chapter I, justifying the abolition of these separate handling fees.

32. In view of the strong support for a separate handling fee, it was agreed that the International Bureau would prepare a revised proposal with regard to the amounts of the international filing fee and the handling fee, the latter being retained as a separate but reduced fee, taking into account the need to generate the same level of income from fees as mentioned in documents PCT/R/WG/4/8 and WO/PBC/6/4.

33. Certain delegations expressed the wish that further reductions in PCT fees be granted to nationals of developing countries. The International Bureau indicated that it would study what additional options might be available for such reductions.

34. One delegation asked that a study be undertaken of the cost of the various inputs in the services provided by the International Bureau under the PCT and that the results of that study be made available. The Secretariat indicated that it considered that there was, as a result of the deployment of information technology, too much change within the PCT administration to enable the study to be undertaken now, and that it would consider doing it after more stability had been introduced through the deployment of information technology.

OPTIONS FOR RESTORATION OF THE RIGHT OF PRIORITY

35. Discussions were based on document PCT/R/WG/4/1, which set out three options for provisions designed to allow for restoration of the priority right in the international and/or the national phase, as consistently as possible with the principle adopted in the Patent Law Treaty (PLT), and document PCT/R/WG/4/1 Add. 1, which outlined the replies received in response to a questionnaire concerning the application of the criteria of “due care” and “unintentionality” under national practice in cases of restoration of rights. The three options covered in document PCT/R/WG/4/1 were the following:

Option A: “unintentionality” criterion (set out in Annex I of document PCT/R/WG/4/1);

Option B: “due care” criterion (also set out in Annex I of document PCT/R/WG/4/1);

Option C: retain priority claim for international phase leaving restoration for national phase (set out in Annex II of document PCT/R/WG/4/1).

36. The question of restoration of the right of priority had been discussed at several previous meetings in the context of reform of the PCT. Although the Working Group agreed that providing for such restoration was important, there remained no consensus as to how this should be implemented in the PCT procedure.

37. The Working Group agreed that several general principles needed to be recognized in any draft provisions allowing for restoration of the right of priority during the international phase. First, there was a need that a decision by a receiving Office to restore a right of priority be recognized and given effect in designated Offices. Second, it needed to be clear that such a decision relate only to the restoration, as such, of the right of priority and not to

the ultimate validity of a priority claim in terms of substantive patent law, for example, as regards whether the subject matter of a claim was disclosed in the earlier application concerned. Third, a decision by a receiving Office refusing to restore a right of priority should not preclude the possibility that designated Offices might subsequently allow such restoration in the national phase.

38. However, the Working Group remained divided as to whether the appropriate criterion for the restoration of a right of priority was that the failure to file the international application within the 12-month priority period was unintentional (as under Option A) or occurred in spite of due care having been taken (as under Option B), noting that those two alternatives were provided for under the PLT. A number of delegations expressed a preference for Option A and a slightly smaller number for Option B. Two delegations stated that the Offices in their countries had no experience with such restoration procedures and that they would need more time to consider the implications of the proposals in the context of their national laws. One of them requested that the possibility of making a reservation on the issue of restoration of the priority right be included.

39. A large number of delegations stated that they could, at least by way of compromise, support provisions that would allow for a priority claim to be retained in the international application during the international phase, leaving a decision on restoration of the right of priority to be made separately by each designated Office during the national phase, as under Option C. However, several delegations opposed Option C, and some of the delegations that expressed support for it indicated that they would prefer a solution that would give greater certainty to applicants and minimize the need for restoration to be determined before separate designated Offices in the national phase. This might be achieved, for example, by combining certain elements from Options A, B and C. However, such a “combined” solution would necessarily require receiving Offices to apply one or other (or both) of the criteria referred to in Options A and B. Several delegations expressed concern at the possibility that Offices might be obliged to apply different criteria under different procedures, whether in respect of international applications (in the international phase in their capacity as receiving Offices and in the national phase in their capacity as designated Offices) and in respect of direct national filings. Some delegations queried in connection with Option C, in particular, whether a claimed priority date should be taken into account for the purposes of the international search and international preliminary examination where no decision on restoration was made during the international phase.

40. The Working Group invited the International Bureau to prepare, for consideration at the next session, a draft proposal combining certain elements of Options A, B and C. A decision by the receiving Office to restore the right of priority would be binding on those designated Offices that applied the same or a less strict criterion. However, a designated Office that applied a stricter criterion than the receiving Office would not be bound by the receiving Office’s decision but would be permitted to decide the matter in the national phase based on its own criterion. In this connection, the Working Group noted that a decision to restore a right of priority based on the criterion of “due care” would be binding on designated Offices that applied the “unintentional” criterion. In any event, however, whatever criterion was applied and whatever decision was made by the receiving Office, the priority claim would be retained in the application and would be used as the basis for computation of PCT time limits, as under Option C.

41. One delegation suggested that, with a view to avoiding the need for certain Offices to apply different criteria in the international and national phases, considerations should be given

to providing for the International Bureau to decide requests for restoration of the right of priority on a centralized basis. That suggestion was felt by several delegations and a warrant for further consideration but doubts were expressed by certain other delegations. The International Bureau noted that such a procedure could, if desired, be implemented by adapting the existing procedure under Rule 19.4, which already provided for the transmittal of international applications to the International Bureau as receiving Office in certain cases.

42. Two delegations expressed concern that allowing for restoration of the right of priority could conflict with Article 8(2)(a), under which the conditions for, and effect of, any priority claim shall be as provided under the Paris Convention for the Protection of Industrial Property. It was noted that this concern needed to be borne in mind in the drafting of revised proposals.

43. The Working Group noted the following suggestions made by delegations and representatives in respect of the proposals contained in Annexes I and II of document PCT/R/WG/4/1, to be taken into account by the International Bureau in preparing a revised proposal:

(a) The period for submitting a notice correcting the priority claims so as to comply with the requirements of Rule 4.10 should be subject to Rule 80.5 where that period expired on a non-working day (see Rule 26bis.2(b)).

(b) It should be ensured that the computation of time limits under proposed new Rule 80.8 would operate satisfactorily in relation to the time limit for performing the international search under Rule 42.1.

(c) Where the international application as filed did not claim the priority of the earlier application, the request for restoration of the right of priority should be accompanied by a notice adding the priority claims so as to comply with all the requirements of Rule 4.10 (see proposed new Rule 26bis.3(e)).

(d) In addition to the proposals contained in document PCT/R/WG/4/1, Rule 4 should be amended to enable the inclusion in the request form of a request for restoration of the right of priority, at least where that request for restoration was on the ground of "unintentionality."

(e) The importance of a prompt decision by the receiving Office under proposed new Rule 26bis.3(b) should be expressly reflected in the wording of the provisions.

(f) Information concerning a request for restoration should always be published together with the international application, that is, not only upon request made by the applicant (see proposed new Rule 26bis.3(g)(i)).

(g) Under Option C, a request to a designated Office for restoration of the right of priority should be made at the time of entry into the national phase or, at least, not later than the date on which the requirements under Article 22 must be complied with (see proposed new Rule 49ter.1(b)).

44. The Chair invited delegations and representatives to submit directly to the International Bureau, preferably via the PCT reform electronic forum on WIPO's Website, any further comments or suggestions for the preparation of revised proposals concerning restoration of the right of priority.

“MISSING PART” REQUIREMENTS (CHANGES RELATED TO THE PATENT LAW TREATY (PLT))

45. Discussions were based on document PCT/R/WG/4/2.

Existing Rules 20.8 and 20.9

46. The International Bureau explained that it was not proposed to delete existing Rules 20.8 and 20.9, which should have appeared in document PCT/R/WG/4/2 as renumbered Rules 20.6 and 20.7, respectively. Further consequential amendments to both Rules would also be needed.

Rule 20 – Title

47. The proposed amendment of the title of Rule 20 was approved by the Working Group.

Existing Rules 20.1 to 20.3

48. The deletion of Rules 20.1 to 20.3 and the transfer of their content to the Administrative Instructions were approved by the Working Group.

Rule 20.1(d)

49. The Working Group agreed that a decision of the Assembly should be sought, when the proposed amendments were submitted to it, so as to clarify that transitional reservations that had been made under existing Rule 20.4(d) would continue to be effective under that provision when renumbered as Rule 20.1(d).

Rule 20.2(a) and (b)

50. The deletion of Rule 20.2(a) and the transfer of its content to the Administrative Instructions were approved by the Working Group. It was also agreed that the International Bureau should review the wording of Rule 20.2(b), consequential on such deletion.

Rule 20.3(a)

51. The amendment to change the reference to “Article 11(2)” to read “Article 11(2)(a)” was approved by the Working Group.

Rule 20.3(b)

52. The Working Group agreed that the International Bureau should review the wording of the provision in the light of a suggestion that this provision should additionally give the applicant the opportunity to make observations, consistent with existing Rule 20.8 and PLT Article 5(3).

Rule 20.3(c)

53. The Working Group agreed that proposed Rule 20.3(c) should be revised to provide that, where the outstanding requirement(s) under Article 11(1) were complied with after the time limit applicable under Rule 20.3(d) but before the receiving Office sent out a notification

under Rule 20.4(i), the outstanding requirement(s) concerned should be considered to have been complied with before the expiration of that time limit, similarly to the provision in respect of the payment of fees under Rule 16bis.1(d).

Rule 20.3(d)

54. There was a clear division of opinion as to the time limit that should apply under this provision. Some delegations and representatives supported a two-month period in order to be consistent with the PLT. One representative also noted that a two-month period was desirable in countries in which difficulties with communications were experienced. Other delegations and representatives were in favor of a one-month period in view of the stringent time frames that governed the PCT procedure (for example, the requirement under Rule 22.1(a) that the record copy be transmitted in time for it to reach the International Bureau by the expiration of 13 months from the priority date). The Working Group noted that the amendment agreed to in respect of Rule 20.3(c) (see paragraph 53, above) would effectively extend the period under Rule 22.1(a).

Rule 20.4

55. One delegation suggested that this provision should also cover cases in which no observations from the applicant were received by the receiving Office within the applicable time limit. The delegation also suggested that the expression "the application is considered not to have been filed" (see Rule 20.4(i) as proposed to be amended) was inconsistent with Article 25 which provided for a review by designated Offices. One representative suggested the use of the words "is considered not to have been filed as an international application." It was agreed that the International Bureau should review Rule 20.4 in the light of these suggestions.

Rule 20.5(a)

56. The Working Group agreed that, in general, proposed new Rule 20.5 should apply in cases where a missing part of the description, claims or drawings was furnished either before or after an international filing date had been accorded, so that the Rule could result in either the first according of an international filing date or the correction of an international filing date that had already been accorded, depending on the circumstances.

57. The Working Group agreed that a restriction should be added to Rule 20.5(a) with regard to the requirement for the receiving Office to invite the applicant to furnish any missing part, similar to PLT Article 5(5), which is restricted to the situation where the Office notices the apparent omission of a part of the description or drawing "in establishing the filing date." In this context, reference was made to Note 5.19 of the Explanatory Notes on PLT Article 5. The Working Group also discussed the possibility of including an outer time limit under this provision (which could perhaps be fixed to be consistent with the time limit for acting under Article 14(4)).

58. The Working Group agreed that proposed new Rule 20.5(a) should be reviewed with a view to putting it beyond doubt as to the cases in which it applied, that is, in the case of a missing part of the description, a missing part of a claim or of the claims (including the case where an entire claim was missing), and a missing part of a drawing or of the drawings (including the case where an entire drawing was missing). The operation of the Rule in relation to the minimum requirements for according an international filing date under

Article 11(1)(iii)(d) and (e) relating to the description and claims also needed to be clear, as well as in relation to the specific provisions of Article 14(2) concerning references in the international application to missing drawings.

Rule 20.5(b)

59. The Working Group noted that the reference in Rule 20.5(b) to “paragraphs (e) and (f)” should be corrected to read “paragraphs (d) and (e).”

60. The Working Group agreed that a provision should be added, in Rule 20.5(b) or elsewhere, so as to require the receiving Office to promptly notify the applicant and the International Bureau of the international filing date accorded or corrected under Rule 20.5.

Rule 20.5(c)

61. The Working Group noted that, although the considerations were not exactly the same, the clear division of opinion under Rule 20.3(d) as to whether the time limit should be one or two months also existed under this provision.

62. In response to a suggestion that the time limit under this provision should be calculated from the date of receipt of the invitation, the Working Group noted that the general regime under the PCT was that time limits in such cases were calculated from the date on which the invitation was sent and that any change in this respect would therefore need to be considered in the context of that general regime.

63. The Working Group noted that the word “an” should be deleted in the first line of Rule 20.5(c)(ii).

Rule 20.5(d)

64. The Working Group agreed that, in order to ensure that the applicant had sufficient time to take advantage of this provision, the time limit for requesting that a missing part furnished under Rule 20.5(b) be disregarded should be one month from the date on which the applicant was notified of the change of international filing date under that Rule.

Rule 20.5(e)

65. The Working Group noted that the reference in the chapeau to “the time limit under paragraph (b)” should be changed to “the time limit under paragraph (c).” In item (iii), the word “in” should be inserted before the words “the same language.” In item (iv), the reference to “item (iv)” should be changed to “item (iii).”

66. Two delegations and one representative expressed concern that the proposed requirement, presented in square brackets, “on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, [the international application contained an indication that the contents of the earlier application were incorporated by reference in the international application]” would impose an unnecessary (formality) requirement, limiting the situations where missing parts could be filed without loss of the international filing date. The Working Group noted that the requirement was consistent with an optional requirement under PLTRule 2(4)(v) and that, without such a requirement, insofar as it related to missing drawings, the provision could be considered to

conflict with Article 14(2) which prescribed the procedure to be applied where drawings were furnished after an international filing date had been accorded. Although it was agreed that the inclusion in the request of a pre-printed statement that the contents of an earlier application(s) the priority of which was claimed was included by reference appeared to be undesirable, it was suggested that such a pre-printed statement might be restricted to incorporation by reference for the purposes of Rule 20.5(e), for example, using wordings similar to that used in present Rule 4.9(b) with regard to “precautionary” designations in the request. The Working Group invited the Secretariat to review Rule 20.5(e) in the light of these considerations. The Secretariat also invited delegations and representatives to submit suggestions on the electronic forum.

67. In response to a concern of one delegation and one representative, the Working Group invited the Secretariat to consider whether the copy of the earlier application furnished under item (ii) should be certified, taking account of the corresponding provisions under PLT Rule 2(4)(i) and (ii) which provide for the certified copy to be furnished later.

68. In response to a concern of one delegation, the Working Group noted that the obligation was on the applicant to establish where in the earlier application(s) the “missing part” was contained and agreed that the following text should be deleted from the Comment on the item: “; it would thus appear that the receiving Office would be required to compare the missing part furnished later with the “missing part” as contained in the earlier application.”

Rule 26

69. The Working Group agreed that the wording of Rule 26.1 as proposed to be amended should be further amended so as to “give the applicant the opportunity” to make observations rather than “invite” the applicant to do so.

70. The Working Group agreed that Rule 26.5(b)(i) as proposed to be amended should be further amended so as to take into account that the time limit fixed under Rule 26.2 may be extended by the receiving Office. The Working Group agreed further that Rule 26.2(b)(ii) should be reviewed with a view to its possible deletion, noting that Article 14(2) required the sending of an invitation to correct as a condition for considering the application withdrawn where the applicant failed to correct the international application within the prescribed time limit.

Existing Rule 20.8

71. One delegation suggested that the provisions of existing Rule 20.8 be split into two separate provisions: one provision would cover the situation in which the receiving Office realized itself that it had made an error, and the other provision would cover the situation in which the receiving Office only realized that it had made an error after this had been pointed out to it by the applicant. The Working Group agreed that the International Bureau should consider whether the provisions should be split and where in Rule 20 the provision(s) should be included.

ACOMMONQUALITYFRAMEWORKFORINTERNATIONALSEARCHAND PRELIMINARYEXAMINATION

72. Discussions were based on document PCT/R/WG/4/12 containing the initial report of the quality framework task force prepared by the United Kingdom as its coordinator,

document PCT/R/WG/4/12 Add.1 containing proposals by the United Kingdom, and document PCT/R/WG/4/12 Add.2 containing extracts from the report of the eighth session of the Meeting of International Authorities under the PCT (“PCT/MIA”).

73. The Working Group warmly welcomed the draft quality framework set out in Annex I to document PCT/R/WG/4/12, regarding it as an important step of fostering confidence among users and designated Offices in the work of the International Authorities, which should lead to more effective use of international search and preliminary examination reports by designated Offices in the future with consequent cost and workload benefits to applicants and Offices alike. The Working Group noted that the draft differed in a number of significant respects from the first draft which was presented by the United Kingdom Patent Office to the task force, but considered that it was an appropriate compromise between the wishes of designated Offices and applicants and the need of International Authorities to meet the demand for their work.

74. The consensus of the Working Group was that the quality framework should be incorporated into the draft PCT International Search and Preliminary Examination Guidelines which were under review by PCT/MIA. One delegation would have preferred that the framework be approved, as an independent text, by the Assembly and incorporated in the Agreements between the International Authorities and the International Bureau, on the ground that this might allow for speedier implementation and, if required, an amendment of the framework, and that the process of approval of these Agreements by the PCT Assembly provided transparency. Another delegation would have preferred that the framework be implemented in a separate guidelines document. However, it was agreed that including the framework in the PCT International Search and Preliminary Examination Guidelines would have an equivalent effect since each existing Agreement included the following undertaking: “In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT Search Guidelines and the PCT Preliminary Examination Guidelines.” (See also, in this connection, the provisions of Article 16 (3)(b), second sentence, and Article 32(3).) It was also noted that including the framework in the Guidelines rather than in a number of separate Agreements would ensure consistency when possible future changes to the text were being considered.

75. One delegation suggested that the framework might include customer service standards that could be expected by applicants and designated Offices, and it was noted that such a possibility could be further explored when a body of experience had developed with the framework as presently proposed. Express reference to feedback and dialog between the Authorities and applicants and designated Offices could also be explored.

76. One delegation, while expressing its support for the framework, did express concerns over the resource intensive nature of the proposal and over its possible increased cost to applicants.

77. The Working Group also noted the need for certain other issues mentioned in Annex II to document PCT/R/WG/4/12 to be addressed in the broader context of reform of the PCT, although they had been beyond the mandate of the task force. Those issues included a possible common infrastructure for Authorities, including databases and search tools.

78. The Working Group approved the content of the draft quality framework set out in Annex I to document PCT/R/WG/4/12, subject to the modifications set out in paragraph 80,

below, and on the understanding that some redrafting would be necessary when the text was included in the PCT International Search and Preliminary Examination Guidelines. It was noted that PCT/MIA would be considering a further text of the Guidelines, incorporating the quality framework text, at its ninth session in July 2003.

79. The Working Group noted a suggestion that the quality framework might also, when experience in its operation had been gained, be considered for adoption as a WIPO standard or model for use by other Offices as well as the International Authorities.

80. The Working Group agreed to the following modifications of the text set out in Annex I of document PCT/R/WG/12:

- (a) In the title, the word "quality" should be inserted before the word "framework."
- (b) In paragraph 3, the words "which are recognized by all Authorities and national and regional Offices," should be deleted.
- (c) In paragraph 4(a), the word "has" at the end of the first line should be replaced by "maintains."
- (d) Paragraph 4(g) should be deleted and paragraph 4(h) renumbered as paragraph 4(g).
- (e) Paragraph 5(d) should be moved to this section entitled "Quality Assurance" and renumbered as paragraph 6(d).
- (f) Paragraph 17 should be amended to read: "Following the initial reporting in stage 1, annual reports should be prepared by each Authority, identifying the lessons learned and actions taken, and making any recommendations in the light of the review."
- (g) A new paragraph 18 with the heading "Future Developments" should be added, reading: "Proposals for future changes to this framework should be made available by the International Bureau for comment by interested parties prior to their adoption."

81. The Working Group agreed that the mandate of the task force had been discharged and that it should now be considered disbanded. The Working Group expressed its thanks to all those who had contributed to the work of the task force, which had completed its work in a remarkably short time, and especially to the United Kingdom Patent Office for the work which it had done as task force coordinator.

OPTIONS FOR FUTURE DEVELOPMENT OF INTERNATIONAL SEARCH AND EXAMINATION

82. Discussions were based on document PCT/R/WG/4/7.

83. Several delegations considered that it was premature to discuss this document. Reasons for this included: that there was a need for further consultation among member States; that there was a need to evaluate the effect of the new enhanced international search and preliminary examinations system before any further requirements could be determined; and that concerns over the effects of the international patents system more generally on developing countries, particularly in respect of environmental, public health and other public policy

issues, needed to be addressed before any conclusion was reached on fundamental changes to the structure of the PCT system. On the other hand, many delegations wished to exchange preliminary views, whether on broad principles or on more specific options contained in the document, while recognizing that no firm conclusions could be drawn, or specific measures decided upon, at this stage.

84. While some delegations considered that the document presented a useful starting point for discussing ideas about developing international search and examination, other delegations expressed the view that the document did not adequately take into account the relationship between the PCT system and the international patents system more generally, particularly as it affected developing countries with concerns about the social, economic and other general implications of the international patents system for their national interest. The latter delegations recalled that the Director General had given an assurance that a study would be undertaken of the implications of the international patents system for developing countries, and the Secretariat informed the Working Group that the study results were expected to be submitted to the 39th series of meetings of the Assemblies of the Member States of WIPO in September-October 2003.

85. Several delegations emphasized the need to keep in mind the interests of a wider range of stakeholders, including not only applicants and patentees, third parties, industrial property Offices and governments, but also civil society and a range of interest groups not directly involved in the administration of the patents system.

86. Some delegations and representatives of user groups expressed the hope that the eventual destination of the system should be the grant of international patents which met a common international standard, though all recognized that this was a long way off. Others expressed the view that this may not be a desirable goal for the foreseeable future in view of the different social and economic needs and states of technological development of the various member States.

87. Many delegations and user groups indicated that it would be desirable to consider possibilities for enhancing the results of international search and preliminary examination so as to further increase the likelihood that granted patents would be valid. Those measures included the options of extra searches, whether by different Authorities for the benefit of searching prior art in different languages by specialists in those languages, or later on during the examination process in order to find relevant documents that had not been available at the time of the original search. Varying emphasis was given to this by different delegations. Certain delegations noted that some of this work might reduce further work in the national or regional phase, but others felt that it would not be appropriate to consider such matters at this time given the workload presently faced by some Authorities and the problems that they had in meeting the demand for their services. Several delegations expressed interest in the possibility of limited opportunities for allowing observations by third parties during international examination.

88. A number of delegations and representatives of users emphasized the importance to users and third parties of the issuance of a high quality and timely international search report. Some stated that the current time periods for establishing international search and preliminary examination reports, as well as national phase entry, should not be extended. The view was expressed that the present provision for entry into the national phase at 30 months from the priority date struck a good balance between the needs of applicants to assess the value of the application and the need for certainty of third parties as to the status of the application. It

was, however, also pointed out that examination would have to take place over a longer period if a greater dialog was to be entered into during the international phase with a view to achieving a result which would be more widely accepted by designated Offices in the national phase. Two delegations indicated that it would be particularly useful if the system made it possible to process national and equivalent international applications in parallel. One delegation suggested that one way of bringing national and international practices into convergence would be the implementation of a 30-month priority period by national Offices. Some delegations expressed interest in the possibility that further international search or examination might be made available at later stages, after the application had entered the national phase.

89. A number of delegations addressed issues concerning the use made by designated Offices of the results of international search and examination. Many hoped that duplication of work among Authorities and national Offices could be reduced, noting that this objective depended on success achieved in other aspects of the development of the international patent system, including the implementation of a common quality framework (see paragraphs 72 to 81, above) and further harmonization of patent laws. Some delegations considered that the possible introduction of a more formal optional system for recognizing international search and examination reports would be worthy of consideration. It was suggested that this might be particularly useful for countries with small patent Offices which did not wish to develop a patent examination capacity, although a number of delegations questioned the appropriateness of that approach. It was emphasized that any such options should preserve the sovereignty of member States, which should retain the power to make a decision as to whether to grant, or refuse to grant, a patent. One user representative suggested that, if the reports of International Authorities were to play a greater role in the national patent granting procedure, the possibility of introducing appropriate appeal mechanisms within the PCT system should be investigated.

90. The Chair noted that, in the course of the discussion, some delegations had emphasized their view that it would be premature and inappropriate to consider more specific or even general proposals for changing the PCT system in isolation from the resolution of broader issues, but that others had expressed interest in having further discussion of possible optional features of the system. The Chair concluded that document PCT/R/WG/4/7 should remain on the agenda for further discussion at a later session. In addition, the International Bureau would explore options which might be available to States that wished to make greater use of international search and examination, such as through optional protocols to the Treaty, for discussion at the next session of the Working Group.

91. Noting that this summary would include only an outline of the views expressed during the discussion, the Chair pointed out that delegations and representatives could, if they wished, submit more detailed observations for posting on the PCT reform electronic forum.

DECLARATION OF THE SOURCE OF GENETIC RESOURCES AND TRADITIONAL KNOWLEDGE IN PATENT APPLICATIONS

92. Discussions were based on document PCT/R/WG/4/13 containing proposals by Switzerland regarding the declaration of the source of genetic resources and traditional knowledge in patent applications.

93. The Delegation of Switzerland stated that its proposals were intended to continue its constructive participation in the discussion on the issues arising in the context of access to

genetic resources and traditional knowledge and the fair and equitable sharing of benefits arising out of their utilization. In this view, the proposal also amends the Regulation to explicitly enable the Contracting States of the PCT to require applicants to declare the source of genetic resources and traditional knowledge, in case where an invention was directly based on such resources or knowledge, presented as a simple and practical way forward that could be introduced in a timely manner and would not require extensive changes to the provisions of relevant international agreements.

94. Many delegations expressed agreement as to the importance of the issues arising in the context of access to genetic resources and traditional knowledge and of the fair and equitable sharing of benefits arising out of their utilization. However, there was a divergence in views as to how best to achieve the common goal of timely solutions to the issues at hand and as to whether the Working Group was the appropriate forum to discuss those issues, noting that various approaches to those issues were currently being discussed at the international level in different forums, including WIPO's Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore as well as other forums in the context of the Convention on Biological Diversity and the World Trade Organization.

95. Many delegations welcomed the proposals as an important and constructive contribution to the ongoing debate concerning genetic resources and traditional knowledge in the context of the intellectual property system. Some expressed the view that discussion in the context of the PCT, as well as of the draft Substantive Patent Law Treaty currently being considered by WIPO's Standing Committee on the Law of Patents, would be appropriate and complementary to the discussions in other forums. Some other delegations, while not opposing discussion of the proposals by the Working Group, suggested that such discussions should await the outcome of discussions in other forums, while others stated their view that it was not appropriate to address the issues concerning genetic resources and traditional knowledge in the context of the PCT, and opposed discussion of the proposals by the Working Group. Several delegations drew attention to specific aspects of the proposal that may need to be clarified or elaborated.

96. In view of the discussions and the divergence in views, the Delegation of Switzerland stated that it would appear that more time was needed by delegations, including its own, to further study the issues, and the Delegation requested that the proposals contained in document PCT/R/WG/4/13 be further discussed at the next session of the Working Group. The Chair concluded that this would be an appropriate way to proceed.

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

97. Discussions were based on document PCT/R/WG/4/4, Annex I.

98. The Working Group agreed that the Secretariat should prepare revised proposals taking into account the comments and clarifications set out in the following paragraphs.

Rule 13ter.1

99. The Working Group agreed that Rule 13 *ter.1*(a) as proposed to be amended should be further amended so as to also require the payment of a late furnishing fee in the case where an invitation was issued under Rule 13 *ter.1*(a)(i).

100. The Working Group agreed that Rule 13 *ter.1(c)* as proposed to be amended should be further amended to read:

“(c) If the applicant ~~has does not~~ within the time limit fixed in the invitation, ~~comply with an invitation under paragraph (a) within the time limit fixed in the invitation,~~ furnished the required sequence listing and paid any required late furnishing fee ~~comply with an invitation under paragraph (a) within the time limit fixed in the invitation,~~ the International Searching Authority shall not be required to search the international application to the extent that ~~such non-compliance has the result that a~~ meaningful search cannot be carried out without the required sequence listing .”

101. Certain delegations suggested the fixing of a maximum amount for the late furnishing fee, but other delegations noted that the Regulations in general left the fixing of fees to the discretion of each Authority .

102. One delegation expressed concern as to the operation of Rule 13 *ter.1* in the case where an international application is forwarded from one (non -competent) Authority to another (competent) Authority.

AUTOMATIC INDICATION OF ALL DESIGNATIONS POSSIBLE UNDER THE PCT

103. The representative of a user organization expressed the view that applicants should be permitted, by way of a checkbox in the request form, to exclude the designation of their own State when filing an international application, since it was common for applicants to pursue a domestic application in parallel with an international application, and the prosecution of an international application simultaneously with a corresponding national application could lead to difficulties in some jurisdictions. Such an exclusion was not provided for under amended Rule 4.9, which would enter into force on January 1, 2004. The Chair noted that the Assembly, in adopting the relevant amendments of the Regulations, had agreed upon the general principle of a system of automatic and all -inclusive designations. Those amendments were based on the premise that all choices and consequences relating to the designations of particular countries would, under the national law, be able to be made at the time of entering the national phase. The amendments provided for transitional reservations which would allow for the exclusion of certain designations in limited cases where national laws relating to “self-designation” posed a problem for applicants; such transitional reservations had been made by Germany, the Republic of Korea and the Russian Federation. Any problems arising in other countries should be dealt with under the national law concerned.

MATTERS ON WHICH CONSIDERATION WAS DEFERRED

104. Having regard to the time available for discussion during the session, consideration of the following matters, not mentioned above, was deferred until the next session:

- (i) aspects of copyright and other rights in non -patent literature made available by intellectual property Offices (see document PCT/R/WG/4/3);
- (ii) simplified protest procedure in case of non -unity of invention (see documents PCT/R/WG/4/4 (Annex II) and 4 Add. 1);
- (iii) publication of translation furnished by the applicant (see document PCT/R/WG/4/4 (Annex III));

- (iv) international form for national phase entry (see document PCT/R/WG/4/4 (Annex IV));
- (v) rectification of clear mistakes (obvious errors) (see document PCT/R/WG/4/4 Add.2);
- (vi) form of amendments (see document PCT/R/WG/4/4 Add.6);
- (vii) formalities checking under the PCT (see document PCT/R/WG/4/5);
- (viii) central electronic deposits system for nucleotide and amino acid sequence listings (see document PCT/R/WG/4/6);
- (ix) divisional applications under the PCT (see document PCT/R/WG 4/9);
- (x) period for performing the international search (see document PCT/R/WG/4/11).

105. The Chair encouraged delegations and representatives to continue to progress the discussion of current issues via the PCT reform electronic forum on WIPO's Website.

NEXT SESSION

106. The International Bureau indicated that the fifth session of the Working Group was tentatively scheduled for November 17 to 21, 2003.

107. The Working Group noted the contents of this summary by the Chair.

[End of Annex II and of document]