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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

**Thirty-Third (19th Extraordinary) Session
Geneva, September 27 to October 5, 2004**

REFORM OF THE PCT

Memorandum prepared by the International Bureau

SUMMARY

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.

INTRODUCTION

2. The Assembly, at its 32nd (14th ordinary) session held in Geneva in September-October 2003, considered a memorandum prepared by the International Bureau on the status of the work being undertaken in connection with reform of the PCT, including the results of the two sessions of the Working Group which had been held since the Assembly’s 2002 session (document PCT/A/32/2, reproducing the summaries by the Chair of the third and fourth sessions of the Working Group, which appear in documents

PCT/R/WG/3/5 and PCT/R/WG/4/14, respectively). Among other things, the memorandum contained a proposal to the Assembly concerning the future work program for PCT reform (document PCT/A/32/2, paragraph 26):

“(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 [in paragraphs 6 to 25 of document PCT/A/32/2], on the understanding that the Committee [on Reform of the PCT] 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.”

3. The Assembly (see document PCT/A/32/8, paragraph 20):

“(i) took note of 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 to document PCT/A/32/2;

“(ii) unanimously approved the proposals concerning the work program in connection with reform of the PCT to be undertaken between the September 2003 and September 2004 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 in paragraph 26 of document PCT/A/32/2.”

4. Pursuant to the Assembly's decision, the Director General convened the fifth session of the Working Group in Geneva from November 17 to 21, 2003, and the sixth session from May 3 to 7, 2004. It was not felt necessary to convene a session of the Committee between the September 2003 and September 2004 sessions of the Assembly.

5. At its sixth session, the Working Group agreed that the summary by the Chair of the sixth session, together with the summary by the Chair of the fifth session, should be submitted to the Assembly at its present session to inform the Assembly of the progress that had been made on the matters referred by the Assembly to the Working Group at its previous session in September-October 2003 (see document PCT/R/WG/6/12, paragraph 149).

6. Those summaries (documents PCT/R/WG/5/13 and PCT/R/WG/6/12), which set 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, are reproduced in Annexes I and II to this document.

FIFTH SESSION OF THE WORKING GROUP

7. At its fifth session, the Working Group considered a number of matters as agreed by the Assembly (see documents PCT/A/32/2, paragraphs 6 to 26, and PCT/A/32/8, paragraph 20). The summary by the Chair (document PCT/R/WG/5/13) is reproduced in Annex I to this document. The matters considered and the results of their consideration at the session are outlined in the following paragraphs.

8. *Simplified protest procedure in case of non-unity of invention.* The Working Group agreed that a number of proposed amendments of the Regulations should be submitted to the Assembly for adoption at its present session. Proposed amendments of Rules 40.1, 40.2, 40.3, 68.2 and 68.3 are accordingly included in document PCT/A/33/2.

9. *Amendments adopted by the PCT Assembly in 2002: corrigenda and consequential amendments (Rules 53.9(b) and 69.1(d)).* The Working Group agreed that the Secretariat should study the matter further, with a view to submitting a revised proposal, if needed, to the Working Group at its next session. Further consideration of this matter took place at the sixth session of the Working Group (see paragraph 25, below).

10. *Publication of translation furnished by the applicant.* Following an explanation by the Secretariat that further study and consultation was needed before a revised proposal could be prepared, taking into account, in particular, the implications of provisions in national laws relating to prior art effect of international applications, the Working Group agreed to revert to the matter at its next session. Further consideration of this matter took place at the sixth session of the Working Group (see paragraph 35, below).

11. *International form for national phase entry.* The Working Group agreed that further consideration should be given at a subsequent session to the possibility of providing streamlined means for entering the national phase, and invited the Secretariat to make proposals, including a suitable draft form.

12. *Formalities checking under the PCT.* The Working Group agreed to defer consideration of possible changes in respect of formalities checking by the International Bureau until experience had been gained of the extensive Rule changes that were due to enter into force in January 2004 and of the recently introduced possibility for electronic filing, which should reduce the incidence of formality defects, noting also that the International Bureau was conducting a pilot study on formalities checking processes. It was agreed that the matter would be revisited in one year, at which time the International Bureau would submit a status report on the matter for the Working Group's consideration.

13. *Restoration of the right of priority.* The Working Group agreed that the approach taken in the proposals should be further developed and invited the Secretariat to prepare revised proposals for consideration at its next session, taking into account the views, comments and suggestions expressed, and the areas where agreement had been reached, as noted in the summary of the session by the Chair (see document PCT/R/WG/5/13, paragraphs 28 to 62). Further consideration of this matter took place at the sixth session of the Working Group (see paragraph 26, below).

14. *Late furnishing fee for late submission of sequence listings.* The Working Group agreed that the certain issues relating to the matter should be further discussed by the International Searching and Preliminary Examining Authorities, with a view to the submission of a revised draft of proposed amendments of the Regulations to the Working Group for approval at its next session and subsequent submission to the Assembly for adoption at its present session. Further consideration of this matter took place at the sixth session of the Working Group (see paragraph 33, below).

15. *Central electronic deposit system for sequence listings.* The Working Group agreed that the Secretariat, in consultation with the Meeting of International Authorities under the PCT, should prepare a revised proposal, including a study of the practical as well as legal considerations mentioned above, for submission to the Working Group at a future session.

16. *Missing part requirements.* The Working Group was generally in favor of the proposals contained in the document, and invited the Secretariat to prepare revised proposals, for consideration at its next session, taking into account the views, comments and suggestions expressed, and the areas where agreement had been reached, as noted in the summary of the session by the Chair (see document PCT/R/WG/5/13, paragraphs 83 to 104). Further consideration of this matter took place at the sixth session of the Working Group (see paragraph 28, below).

17. *Single recordal of certain changes during the national phase.* The Working Group approved a suggestion by the Secretariat that the latter should study the possibility of providing for a request, to be made in a single document submitted to the International Bureau, to record certain changes concerning the applicant, inventor, licensees or security interests in respect of two or more designated or elected Offices in which the international application had entered the national phase, similarly to the procedure under PLT Rules 15, 16 and 17 under PLT Article 14(1)(b). Further consideration of this matter took place at the sixth session of the Working Group (see paragraph 31, below).

18. *Rectification of clear mistakes (obvious errors).* The Working Group invited the Secretariat to further study the different practices and approaches, taking into account the views, comments and suggestions expressed, and the areas where agreement had been reached, as noted in the summary of the session by the Chair (see document PCT/R/WG/5/13, paragraphs 106 to 111). Further consideration of this matter took place at the sixth session of the Working Group (see paragraph 27, below).

19. *Options for future development of international search and examination: making greater use of international reports.* The considerable discussion is summarized in document PCT/R/WG/5/13, paragraphs 112 to 127. There was a divergence of views as to whether, and to what extent, the issues considered in the document should be taken forward by the Working Group. The Working Group agreed with the suggestion that the Director General should undertake consultations, prior to the May 2004 session of the Working Group, on all matters relating to document PCT/R/WG/5/9, to ensure a successful outcome of the Working Group session in May. Without prejudging any of the outcomes, the consultations would relate to matters necessary for him to determine whether further documents should be put to that session and, if so, what subjects they should cover. Further consideration of certain possibilities raised in the document took place at the sixth session of the Working Group (see paragraph 29, below).

20. *Proposals by Switzerland regarding the declaration of the source of genetic resources and traditional knowledge in patent applications.* The considerable discussion is summarized in document PCT/R/WG/5/13, paragraphs 128 to 144. There was a divergence of views as to how best to achieve the common goal of finding timely solutions to the issues considered in the document. The Working Group agreed to discuss the issue again at its next session. Further consideration of this matter took place at the sixth session of the Working Group (see paragraph 30, below).

21. *Aspects of copyright and other rights in non-patent literature.* The Working Group agreed that, in order to ensure discussion of the issues at hand by both patent and copyright experts, the matter should be referred to WIPO's Standing Committee on Copyright and Related Rights (SCCR) with a view to establishing a joint (virtual) task force open to all parties invited to participate in the Working Group and the SCCR. Further consideration of this matter took place at the sixth session of the Working Group (see paragraph 32, below).
22. *Divisional applications under the PCT.* A summary of the Working Group's discussions appears in document PCT/R/WG/5/13, paragraphs 149 to 157. The Working Group agreed that, in light of the views and comments expressed, the proposal should not proceed further.
23. *PCT reform: fast track.* The Working Group agreed that the discussion of the proposals should be deferred to the next session of the Working Group. Further consideration of this matter took place at the sixth session of the Working Group (see paragraph 36, below).

SIXTH SESSION OF THE WORKING GROUP

24. At its sixth session, the Working Group further considered some of the matters mentioned above and also considered certain other matters. The summary by the Chair (document PCT/R/WG/6/12) is reproduced in Annex II to this document. The matters considered and the results of their consideration at the session are outlined in the following paragraphs.
25. *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, with effect from January 1, 2004, should be submitted to the Assembly for adoption at its present session (see document PCT/R/WG/6/12, paragraphs 5 and 6). Proposed amendments of Rules 4.6, 16bis.1, 43bis.1, 44.1, 53.9 and 69.1 are accordingly included in document PCT/A/33/2.
26. *Restoration of the right of priority.* The Working Group agreed that, while there was no agreement as to whether the proposals could be implemented without amending the Articles of the Treaty itself, the approach taken in the proposals should be further developed and invited the Secretariat to prepare revised proposals for consideration at its next session, taking into account the matters, comments and suggestions noted in the summary by the Chair (see document PCT/R/WG/6/12, paragraphs 7 to 42).
27. *Rectifications of obvious mistakes.* There was a clear divergence of views among delegations as to the cases and circumstances in which mistakes in international applications and related documents should be rectifiable under Rule 91. After some discussion, the Working Group agreed that the Secretariat should further consider how to take this matter forward, taking into account the comments and suggestions noted in the summary by the Chair (see document PCT/R/WG/6/12, paragraphs 43 to 57), preferably by making use of the PCT Reform and PCT/MIA electronic forums.
28. *Missing parts requirements.* The Working Group was generally in favor of the proposals contained in the document and invited the Secretariat to prepare revised proposals, for consideration at the next session, taking into account the comments and suggestions set out in the summary by the Chair (see document PCT/R/WG/6/12, paragraphs 58 to 67).

29. *Improving the quality of international searches.* The considerable discussion is summarized in document PCT/R/WG/6/12, paragraphs 68 to 81. There was strong support from both delegations and representatives of users for the principle of allowing further searching to be carried out within the international phase in order to increase the amount of relevant prior art which was found. Representatives of users pointed out the difficulties, expense and additional work which were caused if additional prior art was brought to the applicant's attention only during the national phase. Most delegations considered that the proposals would provide a useful way of reducing the number of low quality patents granted, although two delegations suggested that measures to improve the quality of the existing international search might be more appropriate, or at least that the desire for this measure demonstrated the need to consider the improvement of quality in addition. Some delegations emphasized the need to increase the confidence of designated and elected Offices in using, rather than repeating, work that had been carried out in the international phase. The Working Group invited the Secretariat to prepare revised proposals, for consideration at its next session, taking into account the comments and suggestions set out in the summary by the Chair (see document PCT/R/WG/6/12, paragraphs 68 to 81).

30. *Additional comments by Switzerland on its proposals regarding the declaration of the source of genetic resources and traditional knowledge in patent applications.* The Working Group considered additional comments by Switzerland on its proposals regarding the declaration of the source of genetic resources and traditional knowledge in patent applications. The considerable discussion is summarized in document PCT/R/WG/6/12, paragraphs 82 to 107. In view of the clear divergence of opinions, the Delegation of Switzerland stated that it would attempt to reconcile the different views expressed in a further document to be submitted to the Working Group for discussion at its next session. The Working Group agreed to discuss the issue again at its next session.

31. *Single request for the recording of changes during the national phase.* There was considerable support in the Working Group for further consideration of the concept of permitting requests to be made centrally for the recording of certain changes in respect of international applications which have entered the national phase, noting the significant consequential benefits that would accrue if greater communication resulted in common formats and easier access to patent data for information and statistical purposes. The Working Group invited the Secretariat to prepare revised proposals for consideration at the next session, taking into account the comments and suggestions set out in the summary by the Chair (see document PCT/R/WG/6/12, paragraphs 108 to 122).

32. *Aspects of copyright and other rights in non-patent literature made available by intellectual property offices.* The Secretariat informed the Working Group that, upon further consideration, it appeared that the establishment of a joint (virtual) task force open to all parties invited to participate in the Working Group and WIPO's Standing Committee on Copyright and Related Rights (SCCR), as had been agreed upon in the last session of the Working Group, would be unlikely to resolve the issues that had been identified. The Working Group accordingly agreed with the suggestion of the Secretariat that it would be best for the matter to be further discussed among the International Searching and Preliminary Examining Authorities with a view, in particular, to exploring possible solutions based on existing exceptions to copyright and related rights protection contained in the Berne Convention for the Protection of Literary and Artistic Works. Any progress in relation to the issue could then be reported to the Working Group (see document PCT/R/WG/6/12, paragraphs 123 to 126).

33. *Furnishing of sequence listings for search and examination.* The Working Group agreed that a number of proposed amendments to the Regulations in relation to the furnishing of sequence listings for search and examination should be submitted to the Assembly for adoption at its present session (see document PCT/R/WG/6/12, paragraphs 127 to 131). Proposed amendments of Rules 3.3, 13ter.1, 13ter.2, 13ter.3, 23.1, 76 (title) and 76.5 are accordingly included in document PCT/A/33/2.

34. *Signature requirements.* The Working Group invited the Secretariat to prepare revised proposals, for consideration at the next session, taking into account the comments and suggestions set out in the summary by the Chair (see document PCT/R/WG/6/12, paragraphs 132 to 137).

35. *International publication in multiple languages.* The Working Group invited the Secretariat to prepare revised proposals, for consideration at its next session, taking into account the comments and suggestions set out in the summary by the Chair (see document PCT/R/WG/6/12, paragraphs 138 to 143).

36. *PCT reform: fast track.* After some discussion by the Working Group, the Chair concluded that there had been no support for the proposal in document PCT/R/WG/6/7. Noting the general agreement in the Working Group on the usefulness of the electronic forum, he encouraged all delegations to make greater use of that forum in future (see document PCT/R/WG/6/12, paragraphs 144 to 148).

FUTURE WORK

37. The Working Group, at its sixth session (see document PCT/R/WG/6/12, paragraph 150), agreed to recommend to the Assembly that, subject to the availability of sufficient funds:

(i) two sessions of the Working Group should be convened between the September 2004 and September 2005 sessions of the Assembly to consider proposals for reform of the PCT including, in particular, the matters mentioned 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) financial assistance allocated to enable certain delegations to attend sessions of the Committee should, exceptionally, also be made available, in the measure possible, for those sessions of the Working Group.

38. *The Assembly is invited:*

(i) *to note the summaries by the Chair of the fifth and sixth sessions of the Working Group on Reform of the PCT contained in documents PCT/R/WG/5/13 and PCT/R/WG/6/12 and reproduced in Annexes I and II of this document; and*

(ii) *to approve the proposals concerning future work contained in paragraph 37(i) and (ii), above.*

[Annexes follow]

ANNEX I

SUMMARY BY THE CHAIR OF THE FIFTH SESSION
OF THE WORKING GROUP ON REFORM OF THE PCT
(reproduced from document PCT/R/WG/5/13)

INTRODUCTION

1. Mr. Francis Gurry, Assistant Director General, on behalf of the Director General, opened the session and welcomed the participants.
2. The list of participants is contained in the Annex to this document.
3. The session's proceedings were informal and 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

ELECTION OF A CHAIR AND TWO VICE-CHAIRS

4. The Working Group unanimously elected Mr. Alan Troicuk (Canada) as Chair for the session and Mr. Yin Xintia (China) and Mr. Fabián Ramón Salazar García (Mexico) as Vice-Chairs.

SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION

5. Discussions were based on document PCT/R/WG/5/1, Annex II.
6. The Working Group was in general agreement with the proposed amendments of the Regulations.² Several representatives of users expressed a preference for the retention of the current two-stage review which applied before certain International Searching and Preliminary Examining Authorities, noting that, under the current system, the payment of a fee for the examination of a protest could only be required after a prior review of the justification for the invitation to pay additional fees, whereas, under the proposed new system, it could be required without such prior review.

¹ The working documents for the 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," "PLT Rules" and "PLT Notes" are to those of the Patent Law Treaty (PLT), the Regulations under the PLT, and the Explanatory Notes on the PLT and the Regulations under the PLT.

7. The proposed amendments of the Regulations set out in Annex II to document PCT/R/WG/5/1 were approved by the Working Group with a view to their submission to the Assembly of the PCT Union (“the Assembly”) in September 2004, subject to the comments and clarifications appearing in the following paragraphs and to possible further drafting changes to be made by the International Bureau.

Rules 40.1 and 68.2

8. The Working Group agreed that the time limits under Rules 40.1(ii) and (iii) and 68.2(iii) and (v) should be fixed at one month from the date of the invitations referred to in those Rules.

Rules 40.2 and 68.3

9. The Working Group agreed that Rules 40.2(c), (d) and (e) and 68.3(c), (d) and (e) should be amended to refer to a “review body” constituted in the framework of the International Searching or Preliminary Examining Authority rather than a “board of appeal or other review body,” noting that a board of appeal would be a review body within the meaning of the Rules.

10. The Working Group agreed that Rules 40.2(d) and 68.3(d) should not be deleted, as proposed in document PCT/R/WG/5/1, Annex II, but rather should be amended as follows:

“(d) The membership of the review body referred to in paragraph (c) may include, but shall not be limited to, the person who made the decision which is the subject of the protest. ~~The three member board, special instance or competent higher authority, referred to in paragraph (c), shall not comprise any person who made the decision which is the subject of the protest.~~”

11. The Working Group agreed that the second sentence in each of Rules 40.2(e) and 68.3(e) should be amended by replacing the words “the protest shall be considered withdrawn” with the words “the protest shall be considered not to have been made.”

FURTHER CONSEQUENTIAL AMENDMENTS

12. Discussions were based on document PCT/R/WG/5/10.

13. One delegation questioned whether Rules 53.9(b) and 69.1(d), instead of being deleted, as proposed in document PCT/R/WG/5/10, should rather be amended to limit the application of those Rules to the case where, in accordance with Rule 69.1(b), the national Office or intergovernmental organization that acted as both International Searching Authority and International Preliminary Examining Authority wished to start the international preliminary examination at the same time as the international search.

14. The Working Group agreed that the Secretariat should study the matter further, with a view to submitting a revised proposal, if needed, to the Working Group at its next session.

PUBLICATION OF TRANSLATION FURNISHED BY THE APPLICANT

15. Discussions were based on document PCT/R/WG/5/1, Annex III.
16. The Secretariat explained that further study and consultation was needed before a revised proposal providing for publication of translations of an international application furnished by the applicant could be prepared. The revised proposal should take into account, in particular, the implications of provisions in national laws relating to prior art effect of international applications.
17. The Working Group agreed to revert to the matter at its next session.

INTERNATIONAL FORM FOR NATIONAL PHASE ENTRY

18. Discussions were based on document PCT/R/WG/5/1, Annex IV.
19. The Working Group noted that the use of a form for entry into the national phase could not be insisted upon by any designated Office, but agreed that the provision of streamlined means for entering the national phase was a possibility worth further consideration.
20. Some delegations noted that their Offices' national phase entry forms required extensive details and that there was no uniformity as to the contents of the forms used by the various Offices, and felt that it would thus not be practicable to establish a form which would include all such details for all Offices. It was stated that the legal consequences of non-fulfillment of particular requirements were not necessarily the same before all designated Offices. One representative of users suggested that the use of a standardized form would be of limited value since local attorneys were generally engaged to prosecute entry into the national phase.
21. However, some other delegations and several representatives of users felt that a simple standardized form which could optionally be used to enter the national phase before a number of designated Offices, while noting that further details would have to be provided later to certain Offices, would be useful for applicants and for at least some Offices. It was noted that a form acceptable as a minimum requirement could also have a harmonizing effect on national phase entry requirements in the longer term and that such a form would have to be user-friendly and functional. Further detailed discussion by the Working Group was not possible without having a draft of the form before it. Another possibility for streamlining national phase entry might be to establish a centrally available electronic means of completing different national phase entry forms to be used in proceeding before a number of designated Offices.
22. The Working Group agreed that further consideration should be given at a subsequent session to the possibility of providing streamlined means for entering the national phase, and invited the Secretariat to make proposals including a suitable draft form.

FORMALITIES CHECKING UNDER THE PCT

23. Discussions were based on document PCT/R/WG/5/4.

24. The Secretariat noted that there was an ongoing review of procedures within the International Bureau, drawing especially on the experience of its Receiving Office Section and its interaction with the International Bureau in its specific functions under the Treaty. A number of possibilities for improvement had been noted, particularly in respect of the use of certain Forms which appeared to be unnecessary. It was hoped that proposals would emerge soon in relation to this exercise, in parallel with the work of the Working Group.

25. Several delegations and representatives of users expressed gratitude to the International Bureau for the review of formalities checking that it had undertaken, as outlined in document PCT/R/WG/5/4, and for the information provided on the types and frequency of defects noted which would greatly aid discussions. Some delegations felt that the division of labor between the receiving Offices and the International Bureau as envisaged by the founders of the PCT was still appropriate and added value to the system, in particular from the applicant's point of view.

26. Other delegations called for the elimination of duplicative work by the International Bureau in relation to the work of the receiving Offices. One delegation expressed the view that the International Bureau should only check international applications for compliance with Article 11 and for defects which needed to be corrected in view of international publication. Others stated that duplicative checks did not improve quality overall since each person involved was likely to assume that it was someone else's responsibility to discover defects, and suggested that it would be more appropriate for the International Bureau to carry out a limited quality control of the work of receiving Offices which would involve only a sampling rather than a systematic review of all international applications. One delegation suggested that the formulation of a uniform quality standard for receiving Offices should be considered, with the International Bureau reviewing the application of that standard by receiving Offices.

27. The Working Group agreed to defer consideration of possible changes in respect of formalities checking by the International Bureau until experience had been gained of the extensive Rule changes that were due to enter into force in January 2004 and of the recently introduced possibility for electronic filing, which should reduce the incidence of formality defects, noting also that the International Bureau was conducting a pilot study on formalities checking processes. It was agreed that the matter would be revisited in one year, at which time the International Bureau would submit a status report on the matter for the Working Group's consideration.

RESTORATION OF THE RIGHT OF PRIORITY

28. Discussions were based on document PCT/R/WG/5/7.

29. Many delegations and representatives of users welcomed the general approach taken in the document, noting that it would further align the provisions of the PCT with those of the PLT. Certain delegations emphasized the need to ensure that the reservation provision in respect of the effect in the national phase for their countries was adequate. While some delegations stated that they would have preferred a simpler approach whereby the same criterion for restoration of the priority right was applied by all Offices, it was recognized that agreement on a single criterion was not achievable at the present time and that the proposed approach was thus a good compromise. Several delegations and representatives of users expressed the hope that a clearer form of drafting could be found to make the numerous possibilities involved easier to understand.

30. One user representative hoped that a way could be found, possibly by filing with the receiving Office of the International Bureau, to afford applicants the choice of having either the “due care” criterion or the “unintentionality” criterion applied during the international phase. Two delegations confirmed that their national Offices provided such a choice under national law and that they also intended to do so in their capacity as PCT receiving Offices.

31. Several delegations expressed concern that inclusion of provisions relating to the restoration of the right of priority may conflict with Articles 8(2)(a) and 2(xi) which related the terms “priority claim” and “priority date” to Article 4 of the Paris Convention, which provided for a priority period of 12 months with no provision for restoration where that period was exceeded. Two delegations felt that the introduction of a restoration provision under the PCT would represent such a fundamental change to the system that it ought to be addressed in the Articles of the Treaty itself rather than in the Regulations.

32. The Working Group noted that Rule 4.10 already allowed applicants to claim the priority, in international applications, of earlier applications filed in countries which were not members of the Paris Convention but were members of the World Trade Organization (WTO). Rule 4.10(d) provided the possibility for transitional reservations as to the application of the provision concerned in order to allow Contracting States as designated States to adapt their national laws in order to conform to the provision when it had been adopted by the Assembly. A similar approach could be provided in relation to the changes now under consideration. One delegation expressed its concern that, if a significant number of States were to take advantage of such a transitional reservation provision, the changes would lose much of their effectiveness. Other delegations requested the inclusion of a further transitional reservation provision for receiving Offices whose applicable national law was not compatible with the proposed amendments.

33. One delegation suggested that the term “priority period” should be defined for the purposes of the proposed amendments. It was noted that the same term was used in the PLT and that it derived directly from the Paris Convention.

34. The Working Group noted that, under the proposals, the claimed priority date would be used throughout the international phase for the purpose of calculating time limits (for example, those for international publication and national phase entry), even if restoration of the right of priority was not requested by the applicant during the international phase or if restoration was requested but refused by the receiving Office, provided that the international application was filed within two months from the date on which the priority period expired. The Working Group also noted that such retention of a priority claim did not affect the question of relevant prior art for the purposes of the international search under Rule 33, since the relevant date for the purposes of the international search was in any case the international filing date. It was agreed, however, that Rule 33.1(c) should be reviewed with a view to specifically drawing attention, in the international search report, to written disclosures published within 12 to 14 months prior to the international filing date.

35. The Working Group agreed to refer the question of relevant prior art for the purposes of the written opinion of the International Searching Authority (Rule 43*bis*.1) and the international preliminary examination (Rule 64) to the Meeting of International Authorities under the PCT for consideration via its electronic forum, with a view to the development of a proposal for submission to the next session of the Working Group. It

was noted that item (ii) of Rule 64.1(b), relating to cases where the international application “validly” claimed the priority of an earlier application might need to be reviewed in the light of the proposed amendments.

36. One user representative pointed out that the term of a patent was calculated, in most jurisdictions, from the international filing date, and that allowing priority to be claimed up to 14 months from the filing date of an earlier application would, in effect, enable an extension of term of up to two months. The representative accordingly suggested that restoration be subject to a disclaimer by the applicant of such an extension of term.

37. In response to a suggestion by one delegation that the terminology be changed to refer to the “restoration of the right to claim priority” rather than “restoration of the right of priority,” the Secretariat recalled that this matter had been discussed extensively at previous sessions of the Working Group and that use of the term “right of priority” had been agreed, noting that it was used in the PLT.

38. The Working Group agreed that the approach taken in the proposals should be further developed and invited the Secretariat to prepare revised proposals for consideration at its next session, taking into account the matters noted above and the comments and suggestions as to particular provisions noted in the following paragraphs.

Rule 4.10

39. The Secretariat explained that the proposal to delete the words “, being a date falling within the period of 12 months preceding the international filing date” in Rule 4.10(a)(i) was intended to reflect the distinction between an invitation to correct a defect in a priority claim and an invitation to request restoration of a right of priority. However, on further reflection, it was apparent that this proposal would need to be reconsidered in order to ensure that an applicant could be invited to correct a priority claim which erroneously indicated a filing date of the earlier application being later than the international filing date.

Rule 26bis.2

40. One delegation suggested that it would be more appropriate to “notify” the applicant of the possibility of requesting the restoration of the right of priority than to “invite” the applicant to submit a request for such restoration.

41. One delegation pointed out that no invitation to submit a request for restoration of the right of priority should be needed where the applicant had already submitted such a request or if the time limit for making such a request had expired.

42. The Working Group agreed that the time limit under Rule 26bis.2(a) should be 14 months from the priority date (or two months from the date on which the priority period expired; see paragraph 45, below) or one month from the date of the invitation, whichever expired later.

43. One delegation stated that the use of the term “canceled” was not appropriate in Rule 26bis.2(b) to (d).

44. Several delegations were of the opinion that information concerning a priority claim that has been canceled should be published in all cases under Rule 26bis.2(d), and not only upon request made by the applicant.

Rule 26bis.3

45. There was no support for the suggestion made by one delegation that the period for submitting a request for restoration of a right of priority under Rule 26bis.3(a) should, consistently with the time limit for correcting a priority claim under Rule 26bis.2(b), be increased to 16 months from the priority date. However, it was agreed that the way in which the time limit was expressed in item (i) of Rule 26bis.3(a) (“14 months from the date on which the earlier application was filed”) and in the chapeau of that Rule (“two months from [the date on which the priority period expired]”) should be made consistent, in particular taking into account the possibility that the last day of the priority period might fall on an official holiday or a non-working day.

46. Several delegations and a representative of users suggested that the International Bureau should review decisions under Rule 26bis.3(a)(iii) with a view to establishing a quality standard applicable to all receiving Offices. They also suggested that, in order to promote uniform standards, the terms “due care” and “unintentional” as used in that Rule should be defined or at least explained in the Regulations or guidelines. The Working Group agreed that the Secretariat should consider this matter further.

47. Several delegations and representatives of users supported a suggestion by one delegation that, in order to promote consistency of standards, copies of key decisions of Offices concerning requests for restoration based on the “due care” and “unintentionality” criteria should be made available in a central depository for consultation by Offices, applicants and third parties. One delegation proposed that the said central depository could be supplemented by relevant national legal provisions on the criteria used. The Secretariat agreed that such a facility could be made available on WIPO’s Website.

48. There was no support for the suggestion of one representative of users that the Rules should prescribe a maximum fee for a request for restoration of the right of priority. The Working Group noted that, under Rule 26bis.3(c), an Office which provided for restoration on both the criterion of “unintentionality” and the criterion of “due care” would be free to charge different fees in respect of the two cases.

49. With regard to the possibility for the receiving Office to require that a declaration or other evidence in support of the statement of reasons be furnished under Rule 26bis.3(d), one delegation favored restoration of the right of priority on the basis of a simple statement by the applicant that the failure to comply with the priority period was unintentional. The delegation suggested that such a statement should also be sufficient for restoration on the “unintentionality” criterion under the PCT procedure and that this be made clear, for example, in the Administrative Instructions. Several delegations indicated that under their legislation a formal declaration and possibly the furnishing of evidence would be required rather than a simple statement, while other delegations observed that they had as yet no practice in this area. After some discussion, it was agreed that the question of what information or evidence each receiving Office was entitled to require in support of a request for restoration of the right of priority should be left to national law and practice.

50. One delegation suggested that Rule 26bis.3(d) should be worded so as to encourage applicants to file evidence required under Rule 26bis.3(a)(ii) as soon as possible, preferably together with the filing of the application. In addition, the receiving Office should be permitted to combine the giving of an opportunity to make observations on an intended refusal provided for in Rule 26bis.3(e) with an invitation to file evidence under Rule 26bis.3(d).

51. In reply to a question by a representative of users, the Secretariat confirmed that, under Rule 26bis.3(g), information on the criterion or criteria applied by each Contracting State would be published in the PCT Gazette as well as in the PCT Applicant's Guide and the PCT Newsletter.

Rule 49ter.1

52. A suggestion by one delegation and a representative of users that Rule 49ter.1(c) should be deleted to ensure that a restoration of the right of priority by a receiving Office could not be reversed in the national phase was opposed by another delegation. In reply to a query by a representative of users, the International Bureau explained that the reference to "reasonable doubts" was modeled on terminology used in the PLT.

53. One representative of users suggested that the word "only" should be added before the words "if it has reasonable doubts" in Rule 49ter.1(c). The representative also suggested that wording similar to that used in Rule 51bis.2(b) be considered.

54. One delegation observed that Rule 49ter.1(c) was directed only to designated Offices whereas other provisions of Rule 49ter were directed, more generally, to designated States. The Secretariat suggested that the wording used throughout Rule 49ter should be reviewed for consistency and to ensure that it was clear what principles would need to be applied under the national law in general.

55. The Working Group agreed that a designated Office should not be permitted under Rule 49ter.1(c) to review a decision of the receiving Office to restore a right of priority merely because the information or evidence required by that receiving Office was not the same kind of information or evidence as that required by the designated Office under its national law. Instead, a review under that Rule should only be possible where the designated Office had reasonable doubts as to whether the decision of the receiving Office to restore the right of priority based on that information or evidence was correct. The Secretariat noted that the use of the term "reasonable doubts" in this context was modeled on wording used in the PLT.

Rule 49ter.2

56. One delegation suggested that a request for restoration of the right of priority which has been refused by the receiving Office under Rule 26bis should automatically be considered to be pending before each designated Office.

57. One delegation suggested that Rule 49ter.2(b) should be worded so as to encourage applicants to file evidence required under Rule 49ter.2(b)(ii) as soon as possible, preferably together with the filing of the application. In addition, the designated Office should be

permitted to combine the giving of an opportunity to make observations on an intended refusal provided for in Rule 49*ter.2*(c) with an invitation to file evidence under Rule 49*ter.2*(b)(ii).

58. One delegation stated that, for consistency with Article 27(4), the word “shall” should be replaced by “may” in Rule 49*ter.2*(d).

59. One delegation suggested that consideration should be given as to whether the term “that provision,” which referred to any of the provisions of paragraph (a), was appropriate in Rule 49*ter.2*(f), having regard to other provisions of Rule 49*ter.2*, for example, paragraph (e).

60. There was no support for the suggestion made by one delegation that the time limit under Rule 49*ter.2*(a)(i) should be the applicable time limit under Article 22 instead of one month from that applicable time limit.

61. One representative of users pointed out that a Contracting State which did not provide for restoration of the right of priority in respect of national applications could nevertheless provide for such restoration in respect of international applications in accordance with Rule 49*ter.2*, in which case it would not need to make a reservation under paragraph (f) of that Rule.

62. In reply to a question by a delegation, the Secretariat confirmed that it was implicit in Rule 49*ter.2*(a) that the right of priority might be restored by one designated Office but not by others. The International Bureau observed that it was already inherent from the territorial nature of patents, and the differences in national patent laws, that the scope and validity of a patent granted on a particular international application would not necessarily be the same in all Contracting States.

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

63. Discussions were based on document PCT/R/WG/5/1, Annex I.

64. In introducing the proposals for the introduction of a late furnishing fee for late submission of sequence listings, the Representative of the European Patent Office (EPO) stressed their significance in view of the fact that sequence listings in electronic form for search purposes were furnished late in the case of about 50% of all international applications containing disclosure of sequences. This caused significant difficulties and delays in the international search of these applications. The Representative expressed the view that it was necessary both to cover the additional administrative cost involved and to provide an incentive for applicants to furnish sequence listings complying with the relevant standard at the earliest time possible.

Rules 13ter.1(a) and (a-bis)

65. There was general support for the concept of allowing the International Searching Authority to require a late furnishing fee where it needed to invite the applicant to furnish a copy of the sequence listing complying with the relevant standard, whether the listing was in electronic or (in rare cases) paper form. The Working Group noted, in the latter context, that a further amendment of Rule 13*ter.1*(a)(i) that had been agreed at its fourth session should also be included, namely, the insertion after the words “furnish to it” of the words “and to

pay, where applicable, the late furnishing fee referred to in paragraph (a-bis).” The Working Group also agreed, consequential on that change, that Rule 13ter.1(a-bis) should be further amended by inserting “(a)(i) or” before “(a)(ii)” in both instances.

66. The Working Group agreed that, where sequence listings in both paper and electronic forms were required under Rule 13ter.1(a)(i) and (ii), the payment of only one late furnishing fee would be required.

67. One delegation suggested that the late furnishing fee should be payable in each case where the necessary sequence listing was not provided on the international filing date. A number of other delegations, however, considered that it was not appropriate to require the payment of a late furnishing fee where the listing was received before the International Searching Authority had started the international search, noting that real difficulties in processing would only be caused by late furnished sequence listings where the search had already started.

68. The Representative of the EPO proposed that a maximum amount of the late furnishing fee be fixed, and that the amount should be 25% of the international search fee. A considerable number of delegations and representatives of users expressed agreement with the proposal to introduce a maximum amount. Certain delegations believed that the fixing of fees associated with the international search should be left to the discretion of the International Searching Authorities. Some delegations supported the proposal that the maximum be 25% of the international search fee. Others considered that the maximum should be 25% of the international filing fee, referring to the need for uniformity amongst Authorities as well as consistency with the maximum amount of the late furnishing fee payable to receiving Offices under Rule 12.3(d) and (e) in the case of late furnishing of a translation needed for the purposes of international search. One delegation suggested that the amount was largely arbitrary, since there had been no study on how the level of the fee related to the degree of burden involved for Authorities.

Rule 13ter.1(c)

69. The Working Group agreed that, if a sequence listing and any required late furnishing fee were received after the time limit fixed in the invitation but before the International Searching Authority had declared that a meaningful search could not be carried out, the Authority should use that listing. While one representative of users felt that a specific statement to this effect may be useful, the Working Group concluded that the words “shall not be required to search” provided sufficient flexibility to allow the search to be carried out anyway.

70. The Working Group agreed to further amend Rule 13ter.1(c) as follows:

“(c) If the applicant ~~has does not, 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 only ~~not~~ be required to search the international application to the extent that ~~such non-compliance has the result that~~ a meaningful search can ~~cannot~~ be carried out.”

Rule 13ter.1(f)

71. The Representative of the EPO proposed the deletion of the words “, subject to Article 34,” from Rule 13ter.1(f), suggesting that the reference to Article 34 was confusing and misleading to applicants, noting that the Rule was intended to cover situations in which sequence listings were filed for the purposes of the international search and not as amendments of the international application. On the other hand, it was noted that applicants had a right under Article 34(2)(b) to file amendments of any part of the application as filed, including the sequence listing part. The Representative noted that it was extremely difficult, if not impossible, for an examiner to ascertain what amendment had been made to a sequence listing and to assess whether the amendment resulted in added matter within the meaning of Article 34(2)(b). It was important, in any event, to make a clear distinction between a sequence listing filed as an amendment of the international application and one filed for the purposes of Rule 13ter.

72. Several delegations expressed concern, however, that the simple deletion of the reference to Article 34 would have effects beyond the clarification intended. The Secretariat noted that the structure of Rule 13ter might be improved by making a clearer distinction between a sequence listing forming part of the description and one provided for the purposes of international search, and suggested that it might be desirable to review the wording of the Rule in that context.

73. The Working Group agreed that the issues outlined in paragraphs 63 to 72, above, should be further discussed by the International Authorities, using the electronic forum of the Meeting of International Authorities under the PCT, with a view to the submission of a revised draft of proposed amendments of Rule 13ter to the Working Group for approval at its next session and subsequent submission to the Assembly for adoption in September 2004.

CENTRAL ELECTRONIC DEPOSIT SYSTEM FOR SEQUENCE LISTINGS

74. Discussions were based on document PCT/R/WG/5/3.

75. Many delegations expressed great interest in the proposals contained in the document, noting that there was a real need to provide systems enabling sequence listings to be efficiently filed and made available to International Authorities, designated and elected Offices and third parties, and to avoid the need to handle extraordinarily voluminous applications filed on paper. It was noted that the problem was an international one concerning national patent applications as well as international applications. While the specific proposals made represented a step in the right direction, a number of comments, concerns and suggestions were made, as outlined in the following paragraphs.

76. Several delegations were concerned that, for the purposes of disclosure of the invention, a reference to a deposited sequence listing might not serve the same function for the purposes of national law as the inclusion of the sequence listing part of the description as a part of the international application itself, and that proposed Rule 5.2(a)(ii) might not be sufficient to address this issue. Any solution would need to avoid inconsistency with, for example, Articles 3, 5 and 11.

77. Several delegations suggested that an alternative approach be considered, whereby a sequence listing in electronic form (only) would first be filed with the receiving Office as part of the international application (even if filed on paper); such a procedure had already been established in Part 8 of the Administrative Instructions. That sequence listing could be transmitted by the receiving Office to a sequence listing data bank which would then make it available, in accordance with the usual requirements and restrictions set out in the Treaty as to access to documents, to Authorities, designated and elected Offices and third parties. Even though the remaining part of the international application comprising the request, written description, claims and drawings (if any) might be received in a different format (on paper) and stored separately, the two parts would together be considered to constitute the application. For such a system to be workable, the data bank would of course need to be willing and able to meet the procedural and other requirements of the PCT.

78. It was agreed that, before a decision could be made as to the desirability of a deposit system of the kind proposed, the benefits which would accrue to different users would need to be established. It would need to be clear that the system would meet the requirements of users, including applicants, receiving Offices, the International Bureau, International Authorities, designated and elected Offices, and third parties with different interests, noting the different times and reasons for which a sequence listing would need to be available for different purposes. The data bank would need to allow reliable access to those in respect of whom access to the information was required or permitted at any particular time. It should permit easy downloading of sequence listings to the search databases used for search purposes by patent Offices including International Authorities. The means for both uploading and downloading information would need to be studied carefully, since normal Internet connections might be inadequate for very large sequence listing files. It would also need to offer flexible access, including the selection of specific sequences in cases where a sequence listing contained more than one sequence. The necessary hardware and software requirements (including communication means as well as storage) would need to be studied.

79. Concerning the possibility that such a data bank might be established and operated by the International Bureau, a number of delegations and representatives of users raised the question of the cost of setting up and running the necessary systems and associated infrastructure.

80. One delegation suggested that an existing sequence listing database institution might be able to provide such a facility. The Secretariat noted that the proposal expressly mentioned that possibility, although the main existing sequence listing data banks had in the past not been in a position to undertake all the necessary patent-related functions, such as storage of listings with a guarantee of legal certainty as to their content on the filing date of the application and ensuring that the provisions of the Treaty concerning access and publication would be met.

81. The costs associated with various possibilities for the establishment and maintenance of such a data bank would, in particular, need to be identified and justified in the light of the potential benefits, as would the means by which it might be financed.

82. The Working Group agreed that the Secretariat, in consultation with the Meeting of International Authorities under the PCT, should prepare a revised proposal, including a study of the practical as well as legal considerations mentioned above, for submission to the Working Group at a future session.

“MISSING PART” REQUIREMENTS

83. Discussions were based on document PCT/R/WG/5/8.

84. The Working Group was generally in favor of the proposals contained in the document, and invited the Secretariat to prepare revised proposals, for consideration at the next session, taking into account the comments and suggestions set out in the following paragraphs, noting particularly that certain delegations considered that it would be necessary to include a reservation provision in respect of the effect in the national phase for their countries (see paragraph 91, below).

Rule 4

85. One representative of users expressed concern about possible unintended consequences of the proposed inclusion in the request under Rule 4.18 of a pre-printed statement that the contents of the earlier application(s) the priority of which was claimed were incorporated by reference. The representative suggested that the applicant be given the opportunity to omit the statement, noting that the applicant, in certain cases, may have good reasons not to have the whole contents of the earlier applications automatically incorporated by reference into the later filed application.

86. Suggestions as to how to address that concern included the possibility of limiting the incorporation by reference to drawings contained in the earlier application so as to avoid a possible conflict with Article 14(2) and the possibility of requiring the applicant to check a box in the request to take advantage of the incorporation by reference of the earlier application.

87. The Working Group, noting that the concern would only be relevant in very few cases, agreed that it would be preferable to retain a provision providing for the automatic incorporation by reference of the earlier application, but somehow limited to the purpose of possible subsequent inclusion of missing parts into the later filed application, including the case where the missing part included matter which was new in the application in question but which was completely contained in the earlier application.

88. Several delegations and representatives of users questioned the need for formal confirmation of the “incorporation by reference” statement under Rule 4.18 and suggested that it may be sufficient to further amend that Rule so as to clarify that the “incorporation by reference” (rather than the statement) was for the purposes of Rule 20.5(e); the expiration of the time limit under Rule 20.5(e) for the furnishing of missing parts would thus automatically result in the incorporation by reference ceasing to have effect.

89. One representative of users suggested replacement of the specific reference in Rule 4.18 to Rule 20.5(e) with a more general reference as to the purpose of making such statement (such as, for the purposes of incorporation by reference of missing parts completely contained in the earlier application) so as to ensure that the statement would also be effective in the national phase before designated Offices.

90. One delegation expressed its concern that the proposed incorporation by reference could be considered to conflict with the disclosure requirements under Article 5 and suggested that an amendment of the Treaty may be required. Another delegation expressed its general

concern about the introduction into the PCT, by way of amendments to the Regulations, of the concept of incorporation by reference, since, in its view, the concept would not be supported by any of the provisions of the Treaty and could thus be introduced only by revision of the Treaty itself.

91. Some delegations suggested that a transitional reservation provision be added so as to allow Contracting States whose national law was not compatible with the envisaged amendments of the PCT Regulations not to apply those amendments for as long as such incompatibility existed.

92. Following a suggestion by the Secretariat, the Working Group agreed that possibilities should be explored as to whether the proposed incorporation by reference could be extended to cover the contents of such earlier application for the purposes of overcoming Article 11(1) defects (such as missing claims or a missing description).

Rule 20

93. One delegation noted that the proposals in respect of missing parts in Rule 20 were not consistent with its national law.

94. One delegation suggested that the contents of Rule 20.4(b) should be moved to Rule 20.3.

95. One delegation suggested that Rule 20.5(b) be split into two paragraphs, one dealing with the situation where the missing part was submitted before, and the other after, an international filing date had been accorded. Such a change would result in further simplification of the Rule and, in certain situations, would also afford more time to applicants to meet the requirements under the Rule.

96. One delegation proposed that the applicant should be required to submit a certified copy instead of a simple copy of the earlier application within the same time limit within which the missing part must be furnished. A representative of users noted that in many cases it would not be possible to obtain such a copy within that time limit.

97. The Working Group noted that, under the corresponding provisions in PLT Rule 2.4, a Contracting Party could require that a simple copy be filed within the same time limit as that for furnishing the missing part and, in addition, that a certified copy be filed within a time limit of not less than four months from the date of the invitation to furnish such copy.

98. The Working Group invited the Secretariat to consider whether a similar option was needed in Rule 20.5, taking account of the fact that Rule 17 already required a certified copy of the priority document to be submitted within 16 months from the priority date.

99. In this context, several delegations and representatives of users suggested that a certified copy of the earlier application should not be required under Rule 20.5 in the situations covered by Rule 17.1(b) and (b-bis).

100. Two delegations suggested that the requirement under proposed Rule 20.5(e)(iii) that the missing part be completely contained in the earlier application should be deleted since, in some cases, such a check would be difficult for the receiving Office to perform, for example,

where a translation of the earlier application was required or technical evaluation was necessary. This suggestion was opposed by two other delegations, noting that this matter had been fully discussed in the context of the corresponding provision in PLT Rule 2(4)(iv) and pointing to the fact that, under the PLT, the procedure might be applied by Offices as a purely clerical check (see PLT Note R2.04).

101. One delegation suggested that the International Searching Authority rather than the receiving Office should be responsible for checking whether the missing part was completely contained in the earlier application, as this check would not necessarily be purely clerical, in particular where the earlier application was in a different language.

102. In the course of the discussion, the Working Group noted that Note 5.21 on PLT Article 5(6)(b) expressly stated that, where it was subsequently determined, for example, in the course of substantive examination, that the missing part was not completely contained in the earlier application, the Office may rescind the filing date and re-date the application. However, no similar sanction appeared to exist under the PCT. One representative of users suggested that, in the case of an international application, non-compliance with the requirement that the missing part be completely contained in the earlier application could be dealt with in the national phase under national law provisions relating to added matter. Alternatively, the procedure under Rule 82*ter* could be extended to cover such cases. One delegation suggested that a review procedure analogous to that proposed in respect of restoration of priority (review only in case of reasonable doubts) could be considered.

103. The Working Group invited the Secretariat to study the matter further. The Working Group agreed to defer further consideration of the appropriate time limits (one or two months) under Rules 20.3(d), 20.5(c) and 26.2.

104. One representative of users suggested that the time limits under those Rules should all be two months for consistency with the PLT. One delegation stated that it could accept a two month time limit under Rule 20.3(d) since the international filing date had not yet been accorded at that time, but still favored a one month time limit under the other two provisions.

SINGLE RECORDAL OF CERTAIN CHANGES DURING THE NATIONAL PHASE

105. The Working Group approved a suggestion by the Secretariat that the latter should study the possibility of providing for a request, to be made in a single document submitted to the International Bureau, to record certain changes concerning the applicant, inventor, licensees or security interests in respect of two or more designated or elected Offices in which the international application had entered the national phase, similarly to the procedure under PLT Rules 15, 16 and 17 under PLT Article 14(1)(b).

RECTIFICATION OF CLEAR MISTAKES (OBVIOUS ERRORS)

106. Discussions were based on document PCT/R/WG/5/2.

107. Several delegations and representatives of users expressed support in principle for the amendments proposed in the document. The Secretariat noted that, in general, the criteria for rectification of obvious errors under existing Rule 91 were very strict and not always easy to interpret. There was often great difficulty in deciding how to apply the requirement that a rectification be obvious in the sense that “anyone” would “immediately” realize nothing else could have been intended than what was offered as rectification. Read literally, this would

suggest that a rectification might not be authorized if there was one person who would not immediately recognize that the rectification was obvious. The result was a range of different practices applied by the various Offices and Authorities.

108. One delegation expressed its concern that the proposals did not streamline or simplify the procedures for rectification but rather introduced new standards and added complexity to the system; in their current form, the proposals would not be acceptable to the delegation. The delegation suggested that rectification of mistakes should be restricted to mistakes of a minor nature, such as clerical and typographical errors, so as to keep the system simple and transparent.

109. After some discussion in which differing views were expressed, the Chair concluded that there was at present a wide variation in the interpretation of, and practice under, Rule 91, highlighting the need for an overhaul of the system so as to achieve more harmonized practices. The Working Group invited the International Bureau to further study the different practices and approaches, focusing, in particular, on the issues raised in the discussion. These included:

- (a) the definition of “mistakes” which should be rectifiable;
- (b) the question whether, in the light of such definition of “mistakes”, it was necessary to provide expressly that the omission of “an entire element or sheet of the international application” shall not be rectifiable; if so, what was meant by an “entire element” having regard to the term “elements” in Article 11(1)(iii), and whether it was necessary to explain that no change of meaning was intended by the proposed deletion of the words “even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets;”
- (c) the authorities (receiving Office, International Searching Authority, International Preliminary Examining Authority, International Bureau) which should be responsible for the rectification of mistakes appearing in different elements of the international application (request; description, claims and drawings; corrections and amendments; other documents) and the responsibility of different authorities in different stages of the international phase (Chapter I and Chapter II);
- (d) the basis on which the relevant authority should make the finding whether an alleged mistake is a rectifiable mistake, that is:
 - (i) the notional person who should understand what was intended (for example, a person skilled in the art, or a person in the relevant authority);
 - (ii) the question of what should be the “applicable date” to be used in determining the allowability of a rectification of a mistake, depending on the element of the international application (request; description, claims and drawings; corrections and amendments) or other document in question;
 - (iii) the circumstances (if any) in which account should be taken of the contents of extrinsic documents, including the question as to which documents should be considered to be extrinsic (for example, a cover-

letter or other document of record contained in the files of the receiving Office on the international filing date; an earlier application the priority of which was claimed; instructions from the applicant to the attorney);

(e) the question whether, in accordance with the principle of *lex specialis*, rectification of a mistake should be permitted under Rule 91 if a specific remedy existed elsewhere in the Treaty or Regulations, for example, in respect of correction of priority claims under Rules 26*bis*;

(f) the time limit for submitting a request for rectification, including:

(i) the question whether a request for rectification of a mistake in the international application should be submitted before international publication; and

(ii) the question whether rectification of mistakes in the description, claims or drawings of an international application should be permitted after the start of the international preliminary examination procedure or whether any mistake should be “correctable” at that stage only by way of an amendment;

(g) the need to provide that a rectification under Rule 91 should have no effect in any designated or elected Office where the processing or examination of the international application has already started (in the case of early entry into the national phase);

(h) the question whether the request for rectification should, in all cases, contain a brief explanation of the mistake and the proposed rectification;

(i) what, if any, further action is necessary where a mistake in the description, claims or drawings, or a mistake in the correction of a priority claim, is rectified after the international search report and the written opinion of the International Searching Authority have been established.

110. The Working Group also invited the International Bureau to study suggestions that Rule 82*ter* be amended:

(a) to require designated and elected Offices to rectify certain decisions taken by the receiving Office or the International Bureau during the international phase if that Office or the International Bureau accepted that the decision taken was erroneous;

(b) to avoid designated and elected Offices having to decide disputes between the applicant and the receiving Office or the International Bureau as to whether certain decisions taken by the receiving Office or the International Bureau during the international phase were erroneous.

111. One representative of users stressed the importance of present Rule 82*ter* as the only provision in the PCT which would guarantee applicants a review by designated and elected Offices of certain decisions taken during the international phase by the receiving Office and

the International Bureau, noting that, in particular, certain receiving Offices did not, under their national laws and practices, offer any review procedure with regard to decisions taken by them during the international phase.

OPTIONS FOR FUTURE DEVELOPMENT OF INTERNATIONAL SEARCH AND EXAMINATION: MAKING GREATER USE OF INTERNATIONAL REPORTS

112. Discussions were based on documents PCT/R/WG/5/9 and 9 Corr.

113. The International Bureau recalled that the documents did not contain specific proposals oriented towards a specific goal but rather outlined a very broad range of possibilities, generally disposed towards improving the quality of patents which are issued around the world. They represented the very preliminary stages of an exploratory exercise. Any concrete measures would be a long way off and there would be much time along the way for consideration of the effect of the changes which would come into effect in January 2004, as well as the ramifications of any possible system which States wished to consider in more detail. With respect to the possibilities involving the conclusion of protocols to the Treaty, these were envisaged as options that States might decide to participate in, allowing more flexibility within the system to meet the needs of particular States and users to the extent that they were considered appropriate in any case.

114. A number of delegations considered that further consideration of any of the options presented in the paper was premature and should not be continued in the present exercise of reform of the PCT. Others suggested that the Working Group might return to these issues, but not for at least 12 months. In particular it was felt that major changes had already been made to the system and the extent to which these worked in practice to address the issues at hand needed to be evaluated. It was pointed out that developing countries had taken on significant commitments towards the development of intellectual property law and infrastructure in recent years, especially those relating to the implementation of the TRIPS Agreement, and, even if new protocols were to be voluntary, they would still entail costs in preparation and evaluation of whether to join. In the latter respect, it was noted that it was sometimes difficult to understand the likely effect of a system in advance of joining it. Concern was expressed as to whether developing countries would be able to give sufficient attention to the negotiation process while their limited specialist resources were occupied in the implementation of the TRIPS Agreement. It was suggested that the result of any new protocol might be a further step towards a world patent, which was not desirable given the significant differences in levels of development and policy needs of the Member States. Some delegations expressed the fear that the establishment of a new protocol would transform the nature of the PCT from a treaty that facilitated international patent applications to a treaty that granted patent rights.

115. Furthermore it was noted by some delegations that there may be pressure on their countries to join any such protocols, and to incur the further costs involved in implementation, though other delegations noted that the aim of several of the possible measures was to reduce costs for small (as well as larger) Offices. It was pointed out that States might be able to achieve some of the same benefits, if they wished to pursue them, by way of national measures and bilateral, rather than international, agreements. Also, from the point of view of many developing countries, expansion of technical cooperation and assistance might be a better way of addressing the problems of small Offices. Concern was also expressed that, if protocols were truly optional, the adoption of different protocols by different States may lead to a tiered system, instead of treating all States equally. One delegation was concerned that the existence of protocols might have an effect on the system which changed its effect even

for those which decided not to join the protocols. Some delegations expressed the view that, while the proposed protocols purported to address the workload problems faced by small Offices, those problems in fact were ones faced by large Offices and would be exacerbated by the proposed protocols.

116. Some delegations also considered that certain possible protocols, although leaving options open with regard to national examination and types of law, would reduce policy flexibility to the detriment of addressing specific local needs and policy objectives, including those relating to issues such as public health and the environment, and might form a barrier to development. Any move towards recognition of international search and examination reports might represent an imposition of PCT standards in respect of novelty, inventive step and industrial applicability, pre-judging questions of substantive patent law for which the proper forum for discussion was the Standing Committee on the Law of Patents. Furthermore, relying to a greater extent on international search and examination reports might hinder States which wished to do so from developing search and examination capacity within their national Offices.

117. On the other hand, a number of delegations considered that at least some of the possibilities envisaged in document PCT/R/WG/5/9 merited more detailed consideration. Several delegations considered that drafting of more specific texts regarding particular possibilities would aid discussion. Several delegations indicated, in particular, a wish to strengthen the international phase by improving, and making more consistent, the quality of the search and preliminary examination performed. This could result in the reduction of costs for applicants and of the workload of designated and elected Offices by allowing the results of search and examination to be used to a greater extent. The significant work in this direction which had already been done was noted, recognizing the importance of quality, and including the recent agreement to incorporate a chapter on a quality framework for International Authorities into the revised International Search and Preliminary Examination Guidelines.

118. Some delegations considered that any proposal which represented a move towards a “more binding” effect of an international search or examination report was not appropriate until a greater consistency of quality and degree of harmonization of substantive patent laws had been achieved. On the other hand, the delegation of one State with a small Office considered that PCT reports provided an enormous benefit to them and that any proposal which might improve the quality of those reports, or cause applicants to use the system in a manner which resulted in positive international preliminary examination reports, would be worth considering further. It was noted that a high quality report could be of great use, even if it was made to PCT standards, rather than specific national standards, as long as it was known to what extent the standards of the national law differed. Conversely, one delegation queried, if this was really the case, why it was necessary to spend time on substantive patent law harmonization.

119. One delegation of a State with a small Office considered that it was important to follow up quickly on the recent significant improvements to the system. Another such delegation pointed out that times and needs were inevitably changing and that it was essential to evaluate how the system could work best to the advantage of States which currently operated registration systems. However, another such delegation also noted that it would be necessary to ensure that any further measures taken did not in fact result in reduced quality of reports, which were vital to the national system.

120. Several delegations expressed concern that some of the possibilities would extend the international phase or delay the production of international search and examination reports, to the detriment of reasonable certainty for third parties. On the other hand, one delegation suggested that there may be situations where extra time in the international phase and delayed processing may be of benefit not only to the applicant but to all concerned.

121. Some delegations were of the view that, while many of the possibilities set out in the documents were worth considering, there was a risk that introducing measures by means of several optional protocols might result in a fragmented system, which might be more complex, rather than simpler, for users. It might also be difficult to bring the system back together into a coherent whole at a later stage.

122. Most representatives of users indicated a strong desire to increase the quality of the international search and preliminary examination by providing further options including multiple or top-up searches and additional possibilities for amendment and further examination in the international phase, so as to bring the international application to a point where it could achieve a positive international preliminary report on patentability. This would allow applicants to know that any patent granted would have a high presumption of validity before the cost of translations into many languages need be incurred. However, it was emphasized that it was important that this remain optional. If it made the system more expensive in all cases, even where extra services were not desired, then it would make the PCT route less attractive for users instead of more attractive. User representatives emphasized that, among all the issues, the quality of the international search was of prime importance. One representative of users noted that it would be useful to measure the quality of searches made by different Offices and International Authorities by comparing search results on different members of patent families.

123. One representative of users also suggested that there were further areas which should be considered in relation to the quality of international examination reports, specifically their completeness, since under Rule 66.2(a)(v) at present, it was a matter of discretion for the International Preliminary Examining Authority whether it wished to accompany an international preliminary examination report with observations on clarity of the claims, description, and drawings, or the question of whether the claims were fully supported by the description. It was also noted that well-examined patents were a benefit for competitors, as well as applicants, since their position was more certain, benefiting both innovation and competition.

124. Some representatives of users also expressed a number of reservations. In particular, it was noted that even an optional protocol might become effectively mandatory. They also considered that the lack of harmonization of laws at present suggested that moves towards a system of binding reports would be premature. Also, lack of consistency of quality might lead to forum shopping. It was suggested that some of the objectives in the document might be pursued more effectively at the national level.

125. Some delegations considered that the expressions of concern related to issues which applied more to the creation of protocols than to some of the other matters in the paper, which were more in the nature of improvements to the quality of search and examination reports delivered within the framework of the existing system, without creating any new obligations on States. Several delegations felt that the type of matters considered in paragraphs 32 to 42 of document PCT/R/WG/5/9 fell into the latter category and were worthy of further consideration.

126. There was, clearly, a divergence of views as to whether, and to what extent, the issues considered in the documents should be taken forward by the Working Group.

127. The Working Group agreed with the suggestion that the Director General should undertake consultations, prior to the May 2004 session of the Working Group, on all matters relating to document PCT/R/WG/5/9, to ensure a successful outcome of the Working Group session in May. Without prejudging any of the outcomes, the consultations would relate to matters necessary for him to determine whether further documents should be put to that session and, if so, what subjects they should cover.

PROPOSALS BY SWITZERLAND REGARDING THE DECLARATION OF THE SOURCE OF GENETIC RESOURCES AND TRADITIONAL KNOWLEDGE IN PATENT APPLICATIONS

128. Discussions were based on document PCT/R/WG/5/11 Rev. (a corrected version, in English only, of document PCT/R/WG/5/11).

129. The Delegation of Switzerland introduced the document, noting that it was identical in content to document PCT/R/WG/4/13, which had been introduced to the fourth session of the Working Group. As previously explained, the proposed amendments to the Regulations were intended to increase transparency in the context of access to genetic resources and traditional knowledge and the fair and equitable sharing of benefits arising out of their utilization, and to provide a simple and practical way forward which could be introduced in a timely manner.

130. There was general recognition of the importance of the issues relating to access to genetic resources and traditional knowledge and of the fair and equitable sharing of benefits arising out of their utilization. A number of delegations pointed out that these issues were important to the people of many States. Traditional knowledge and genetic resources were not owned only by indigenous peoples of developing countries. A way needed to be found to support economic and ecological benefits for all.

131. There was a divergence of views as to how best to achieve the common goal of finding timely solutions to the issues at hand. In particular, a number of delegations expressed doubt as to whether the matters were ones which should be addressed by means of changes to the patent system and, even if so, whether the Working Group was the appropriate forum to discuss these issues at the present time, noting that the subject was still being discussed more broadly at the international level in different forums, including WIPO's Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore ("the Intergovernmental Committee").

132. Other delegations welcomed these proposals, believing that it was necessary to address the issues now and that it was timely for this forum to consider, at least to some extent, whether provisions of the type proposed were permissible under the PCT, whether they were desirable, consistent with other international agreements, and whether they would successfully meet the intended objectives.

133. Several delegations considered that the proposals seemed constructive and pragmatic and should be considered in more detail in the Working Group. Some considered that early agreement in this forum might send a useful signal elsewhere, encouraging further progress on these and related issues, including those raised in discussions on substantive patent law

harmonization. One delegation considered that, while the same issues would, of course, affect national patent applications, the PCT was a good starting point because of its importance to applicants wishing to file applications in other countries.

134. A number of delegations considered that such discussions needed to be carefully coordinated with discussions in other forums, with the primary consideration of the policy objectives being done in the Intergovernmental Committee. In addition to the matter of duplication of discussion, those delegations noted that the issues were too broad to address in the context of the PCT in isolation and considered that it was important to ensure that the results which flowed into different policy areas were mutually consistent and supportive. Some of those delegations suggested that consideration might be given to the issues by the Working Group in parallel with the Intergovernmental Committee; others considered that work should wait until the Intergovernmental Committee had formulated a clear policy direction.

135. Other delegations were not convinced that the patent system was the proper context in which to address concerns of benefit sharing. It was emphasized that, while it was important to address the underlying issues, they considered that the Working Group was not the appropriate forum for discussion of the matter. In particular, these delegations saw no conflict between the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and the Convention on Biological Diversity (CBD). In their view, it was possible to implement those agreements in a mutually supportive manner. Furthermore, those delegations suggested that implementing measures whereby patents might be invalidated for failure to comply with the requirements of disclosure of source would be of benefit to no one. Rather, it would decrease certainty in patent rights, increase litigation and reduce patent filings. Without patents, little or no benefit would exist to be shared. It was also pointed out that the Working Group lacked the participation of indigenous peoples, who were represented in the Intergovernmental Committee, which had also recently been given a new and broader mandate. Examples of systems which these delegations considered were more appropriate to address access to resources and benefit sharing had been presented to the Intergovernmental Committee.

136. Some delegations, while welcoming the proposals as a positive start, considered that they did not go far enough. They considered that there may be a conflict between the existing international patent system, as enshrined in such international agreements as the TRIPS Agreement, and the CBD and, in any case, it was pointed out that there remained no effective internationally agreed and effective measures against bio-piracy. The measure proposed in the document under consideration would only permit, and not require, the introduction of laws to require disclosure of source of origin. It was recalled that a number of developing countries had proposed, in the TRIPS Council, an amendment to the TRIPS Agreement to ensure that all Members of WTO would require that patent applicants for inventions that use biological resources or associated traditional knowledge must disclose the source of origin of those resources and provide evidence of prior informed consent and of fair and equitable benefit-sharing.

137. One delegation suggested that the Swiss proposal would not achieve the goals of access and benefit sharing that it set forth, and explained that the proposal was likely to reduce benefits that may be shared by increasing litigation and creating a disincentive for innovation.

138. One delegation considered that the lack of internationally agreed measures against bio-piracy had the potential to undermine the credibility and legitimacy of the patent system. The recent case of patents relating to the maca plant was cited as an example of such difficulties. The Delegation of the United States of America indicated that it had recently reviewed the database concerning these patents and stated that they pertained not to the plant itself but to chemically active isolates, compounds and compositions. Furthermore, the patents cited literature dating back to the 1960s pertaining to the traditional uses of the plant, which was also known as “Peruvian ginseng.” The patents had been found to fully meet patentability criteria and also, in fact, disclosed the source of origin of the maca plant and other information. The Delegation stated that this could not be considered to be a case of bio-piracy, but that it continued to seek true examples of bio-piracy which would help to understand the nature of the problem.

139. One delegation suggested that the idea set out in paragraphs 30 to 32 of document PCT/R/WG/5/11 Rev., relating to the establishment of a list of government agencies competent to receive information on the declaration of source, was of particular interest and worthy of further study.

140. One representative of users stated that an essential feature of any national law requiring proof of having obtained prior informed consent would be a centralized procedure for showing that the requirement had been met. Without this, an alleged failure to obtain permission for use would become a standard attack in any country with such a provision. An applicant may have received consent from one source, but be attacked on the grounds that he should have sought permission from a different source. The consequence would be that fewer patent applications would be filed in these countries, resulting in there being no benefits for the applicant to share at all. Even if such systems were set up in countries with this type of legislation, it was pointed out that this would not help the case of inventions where the information was gained from a different country.

141. Doubt was expressed by one delegation as to the need to define the term “traditional knowledge.” Comparison was made with the Paris Convention, where the term “invention” was not defined, but this had not prevented the development of an international patent system. Concern was also expressed that the proposal in document PCT/R/WG/5/11 Rev. to amend Rule 51*bis*.1 was too narrow in that it required a declaration only where the invention was directly based on the genetic resource or traditional knowledge. Nevertheless, it was recognized that the necessary degree of relationship was a matter which needed to be considered carefully.

142. One representative of users expressed doubts that the proposals in the document were compatible with the TRIPS Agreement and also considered that there would be no basis under the PCT for the proposed Regulations.

143. The Delegation of Switzerland thanked the Working Group for the amount of support which had been shown for the proposals. It recognized that there were problems which needed to be addressed and considered that there was a clear need for further discussions.

144. The Working Group agreed to discuss the issue again at its next session.

ASPECTS OF COPYRIGHT AND OTHER RIGHTS IN NON-PATENT LITERATURE

145. Discussions were based on document PCT/R/WG/5/5.

146. Following a suggestion by the International Bureau, the Working Group agreed that, in order to ensure discussion of the issues at hand by both patent and copyright experts, the matter should be referred to WIPO's Standing Committee on Copyright and Related Rights (SCCR) with a view to establishing a joint (virtual) task force open to all parties invited to participate in the Working Group and the SCCR. It was envisaged that the task force would operate mainly using an electronic forum and that it be coordinated by the International Bureau. The task force would be asked to prepare a report for consideration by both the Working Group and the SCCR.

147. The Representative of the European Community, also on behalf of the Member States of the European Union and of the Acceding Countries, expressed support for the proposed creation of a joint task force. For the sake of completeness, the Representative requested that certain references to EC Directive 2001/29/EC on the harmonization of certain aspects of copyright and related rights in the information society be included in paragraphs 20 and 25 of document PCT/R/WG/5/5.

148. One representative of users expressed the opinion that certain Office practices referred to in document PCT/R/WG/5/5 (submission in electronic form of a search report and copies of cited documents to the applicant; making available of those documents via electronic file inspection systems) were permitted under certain exceptions provided for in existing copyright treaties.

DIVISIONAL APPLICATIONS UNDER THE PCT

149. Discussions were based on document PCT/R/WG/5/6.

150. The Secretariat recalled that the document presented three options which might be considered for providing for international applications as divisional applications of a parent international application, namely, a possible revision of the Treaty, possible amendments of the Regulations providing expressly for divisional applications, and other possible amendments providing a new procedure for "internal division" of international applications.

151. Several delegations and representatives of users expressed concern about adding a procedure to the PCT system which would allow for divisional international applications, noting the added complexity involved, the difficulty with according an international filing date in accordance with both Article 11 and the Paris Convention, the need for compliance with time limits for international search and international preliminary examination, and the added cost for applicants in respect of international search, international preliminary examination and national phase entry in respect of each divisional international application.

152. A number of delegations and a representative of users questioned the need, from an applicant's perspective, to add the possibility of such a procedure to the PCT system. It was noted that, in cases of lack of unity of invention under the present system, applicants could take advantage of well established procedures both during the international phase (obtaining additional international searches and preliminary examinations) and after national phase entry (filing of divisional applications under the national law of the designated States concerned).

Moreover, many applicants appreciated the current procedure since it gave them the option of deferring decisions (and related costs) concerning the filing of divisional applications until after entry into the national phase.

153. One delegation expressed the view that, in the future, should real progress be achieved towards making greater use of positive international preliminary reports on patentability, the possibility of filing divisional international applications during the international phase would be of greater importance than at present.

154. Another delegation was of the opinion that, in general, following the changes adopted in the recent past in the context of PCT reform, users needed time to familiarize themselves with the new system and, in general, preferred a stable rather than a constantly changing PCT system.

155. One representative of users suggested that, rather than adding a procedure to the PCT system which would allow for the filing of international divisional applications, the Regulations could be amended so as to require a designated Office, in the case of the filing of divisional applications based on a parent international application which had entered the national phase before that Office, to apply PCT requirements as to form or contents (Article 27(1) and Rule 51*bis*) not only to the parent international application but also to the divisional applications.

156. Difficulties were seen by at least some delegations with each of the particular options set out in document PCT/R/WG/5/6. A revision of the Treaty would be the least problematic, legally speaking, but it should not be undertaken as an isolated measure. Amendments of the Regulations to provide expressly for the filing of divisional international applications was viewed by some delegations as inconsistent with the provisions of the Treaty concerning the date to be accorded as the international filing date. The option of providing for “internal division” of international applications received some support as a possible mechanism, but some delegations felt that it would be unnecessarily complicated and others stated that no basis for it could be found in the Treaty.

157. The Working Group accordingly agreed that the proposal should not proceed further.

PCT REFORM: FAST TRACK

158. Discussions were based on proposals made by the EPO in document PCT/R/WG/5/12.

159. Noting that the document had only been posted on WIPO's Website on November 14, 2003, the Working Group agreed that the discussion of the proposals should be deferred to the next session of the Working Group.

160. Two delegations, in preliminary statements, while supporting in general the proposal to make greater use of the PCT Reform electronic forum in advance of Working Group sessions, expressed their concern about submitting proposals directly to the PCT Assembly without prior discussion in the Working Group, even if such proposals had been posted on the electronic forum and had not been objected to, and emphasized the importance of inclusive, full and transparent discussion by all Contracting States of matters related to PCT reform.

OTHER MATTERS

161. 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.³

NEXT SESSION

162. The International Bureau indicated that the sixth session of the Working Group was tentatively scheduled for May 3 to 7, 2004.

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

[Annex II follows]

³ See <http://www.wipo.int/pct/reform/en/index.html>.

ANNEX II

SUMMARY BY THE CHAIR OF THE SIXTH SESSION
OF THE WORKING GROUP ON REFORM OF THE PCT
(reproduced from document PCT/R/WG/6/12)

INTRODUCTION

1. Mr. Francis Gurry, Deputy Director General, on behalf of the Director General, opened the session and welcomed the participants.
2. The list of participants is contained in the Annex.
3. The session's proceedings were informal and 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

ELECTION OF A CHAIR AND TWO VICE-CHAIRS

4. The Working Group unanimously elected Mr. Siep de Vries (Netherlands) as Chair for the session and Mrs. Margit Sümeghy (Hungary) and Mr. Yin Xintian (China) as Vice-Chairs.

CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

5. Discussions were based on documents PCT/R/WG/6/5, 5 Add.1 and 5 Add.2.
6. The Working Group approved the proposed amendments of the Regulations² set out in the Annexes to documents PCT/R/WG/6/5, 5 Add.1 and 5 Add.2 with a view to their submission to the Assembly of the PCT Union ("the Assembly") in September 2004, subject to possible further drafting changes to be made by the International Bureau.

RESTORATION OF THE RIGHT OF PRIORITY

7. Discussions were based on document PCT/R/WG/6/1.
8. Several delegations referred to the discussions in previous sessions of the Working Group and expressed their concern that, while they were in favor of the principle of allowing for restoration of priority rights in the case of applications under the PCT consistently with

¹ The working documents for the 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," "PLT Rules" and "PLT Notes" are to those of the Patent Law Treaty (PLT), the Regulations under the PLT, and the Explanatory Notes on the PLT and the Regulations under the PLT.

the provisions for such restoration under the Patent Law Treaty (PLT), the procedure would represent such a fundamental change to the system that it ought to be addressed in the Articles of the Treaty itself rather than in the Regulations. Some of those delegations indicated that they would not wish to block a consensus should the Assembly decide to adopt amendments of the Regulations providing for restoration of the right of priority but that they would make use of the proposed transitional reservation provisions, at least until such time as the matter could be addressed directly under their national laws. Others felt that the possibility for transitional reservations would not be sufficient to address their concerns and stressed the need for amendment of the Treaty itself.

9. One delegation expressed the view that Article 58(1) would not provide a sufficient basis for this matter to be dealt with in the Regulations only. It stated that Article 58(1)(iii) provided a basis only for Rules concerning details useful in the implementation of the provisions of the Treaty but not for Rules concerning matters which were not dealt with by provisions of the Treaty in the first place. The delegation also expressed its concern that a restoration of the right of priority would, in effect, extend the term of a granted patent by up to two months and, in general, questioned whether aligning the PCT requirements to those of the PLT should indeed be one of the objectives of PCT reform, noting that the PLT had not yet entered into force and, in light of differing views on the PLT, may not be ratified by many PCT Contracting States in the near future.

10. Other delegations were of the opinion that, while provisions concerning restoration of the right of priority would not be in conflict with the Paris Convention itself, inclusion of such provisions in the Regulations providing, in effect, for a 14-month priority period in certain cases would be inconsistent with Articles 8(2)(a) and 2(xi) of the PCT, which referred to the Paris Convention with regard to the conditions for, and the effect of, any priority claim contained in an international application, and thus to the 12-month priority period under Article 4C(1) of the Paris Convention.

11. A number of delegations and representatives of users welcomed the general approach taken in the document, noting the importance of provisions for the restoration of the right of priority as a safeguard for applicants. The proposed provisions would not enable an automatic extension of the priority period to 14 months but would be applicable only in particular circumstances after a check by the Office concerned. Referring to the extensive discussions that took place in the context of the adoption of the PLT, those delegations and representatives of users expressed the view that provisions for the restoration of the right of priority were in compliance with the provisions of the Paris Convention, which only provided for a minimum standard with regard to the length of the priority period and thus left room for member States of the Paris Convention to grant longer periods of priority if they so wished. They were of the opinion that the Working Group should proceed with developing proposed amendments to the Regulations unless it was convinced that those amendments would clearly be inconsistent with provisions of the Treaty, which they felt not to be the case.

12. Noting the divergence of views as to whether the inclusion in the PCT of provisions relating to the restoration of the right of priority needed to be addressed in the Articles of the Treaty itself rather than in the Regulations, the Secretariat referred to earlier discussions in the Working Group concerning a possible revision of the Treaty and the apparent difficulties noted by the Working Group in that context, namely, the difficulty of defining the scope of any revision and the need to avoid the existence of two parallel systems during a prolonged period where some Contracting States had ratified a new version of the Treaty and others had

not. The Secretariat pointed out that there were, however, precedents in WIPO for making changes to the effect of treaties in advance of their formal ratification, or which were not in strict agreement with their literal wording, where there was a consensus to do so. For example, the WIPO Assemblies in 1989, 1991 and 1993 had considered radical changes to the system of contributions by Member States under the WIPO Convention and the six other treaties administered by WIPO that provided for contributions to be paid by Contracting States. In consequence, in 1993, a unitary contribution system with revised contribution classes was introduced by consensus. The formal changes to the relevant treaties were only adopted in 2003, after it was agreed that the system had been shown to work, and the system was continuing even though those changes had not yet entered into force. Similarly, in the International Union for the Protection of New Varieties of Plants (UPOV), after the conclusion of the 1991 Act, it was agreed that the 1978 Act should remain open to accession by developing countries even beyond the dates of closing of the 1978 Act which had been set in the 1991 Act. The Secretariat suggested that Contracting States should consider the possibility of a revision of the PCT having a limited scope and whether a way could be found to voluntarily accelerate the effective entry into force of new provisions.

13. After some discussion, the Chair concluded that, while differing views had been expressed as to whether the inclusion in the PCT of provisions relating to the restoration of the right of priority ought to be addressed in the Articles of the Treaty itself rather than in the Regulations, a majority of delegations had expressed the view that, as had been decided by the Assembly, it would be desirable for the PCT to be aligned in that regard to the PLT. The question at hand was thus not whether such restoration should be provided for in the context of the PCT but rather how best to address the concerns expressed by those delegations who saw a need for amending the Treaty itself. On the one hand, the possibility for transitional reservations provided one possible way for Contracting States not to apply the provisions concerned until such time as the position might be solved under their national laws. On the other hand, the suggestion by the Secretariat outlined in paragraph 12, above, merited further consideration.

14. The Working Group agreed that, while there was no agreement as to whether the proposals could be implemented without amending the Articles of the Treaty itself, the approach taken in the proposals should be further developed, and the Working Group invited the Secretariat to prepare revised proposals for consideration at its next session, taking into account the matters noted above and the comments and suggestions as to particular provisions noted in the following paragraphs.

Rule 4.10(a)(i)

15. One delegation suggested, noting particularly the proposed deletion of the words “, being a date falling within the period of 12 months preceding the international filing date,” that the term “priority period,” as used in proposed Rule 26bis.2(a)(i) and elsewhere, should be defined in the Regulations, either in Rule 26bis.2 or in Rule 2. Another delegation noted that the definition should take into account non-working days under Article 4C(3) of the Paris Convention. Another delegation considered that the definition should also make clear that the provisions of Rule 80.5 (concerning expiration of time limits on a non-working day or official holiday) should apply to the priority period.

Rule 26bis.2(a)

16. One delegation suggested that a receiving Office which had made a transitional reservation under proposed Rule 26bis.3(h) should not be required to notify the applicant of the possibility of submitting the request for the restoration of the right of priority in accordance with Rule 26bis.3, and that the proposed amendments of the Regulations should be further amended accordingly.

Rule 26bis.2(b)

17. In response to questions by one delegation and a representative of users, the Secretariat explained that, as defined in proposed Rule 26bis.2(b), a priority claim which was “considered void” was, for the purposes of the Treaty, considered not to have been made *ab initio*. The definition had been introduced as a mere drafting change to simplify the wording of the proposed text and not to change the substance of the present provision. One delegation noted that consequential changes in terminology concerning priority claims “considered not to have been made” should be considered elsewhere, for example, in Rule 82ter.

18. One delegation suggested that the Regulations should be further amended so as to provide that, as already provided under the Receiving Office Guidelines, a notice received after the expiration of the time limit under Rule 26bis.1(a) should be considered to have been received in time if it was received before the receiving Office had declared that the priority claim was considered not to have been made.

Rule 26bis.2(c)

19. It was suggested and agreed that the words “the contents of” should be deleted in Rule 26bis.2(c)(ii).

Rule 26bis.2(d)

20. One delegation suggested that the Administrative Instructions should be modified to ensure that the information to be published under Rule 26bis.2(d) contains a clear indication as to whether a priority claim has been considered void under Rule 26bis.2(b) or whether a priority claim has not been considered void under Rule 26bis.2(c).

Rules 26bis.3(a) and (b)

21. One delegation pointed to the need for clarification of the relationship between Rules 26bis.3(b) and 26bis.2, noting that the present draft would appear to permit an applicant to request the restoration of the right of priority much later than two months following the expiration of the priority period, for example, in the case where the applicant added a priority claim under Rule 26bis.1 and received a notification by the receiving Office under Rule 26bis.3(b), which would appear to afford a further period of one month in the time limit for requesting restoration of that priority claim.

22. One delegation suggested that it should be made clear that Rule 80.5 (concerning expiration of time limits on a non-working day or official holiday) applied to the time limit under this Rule.

Rule 26bis.3(c)

23. One delegation sought clarification as to the evidence which could be required by a receiving Office, and in particular as to whether Offices could require particular forms of evidence (for example sworn statements) and whether they could require further evidence if the evidence originally filed was considered to be insufficient to decide the matter. It was felt that the draft as proposed would permit such flexibility, without having to include express provisions to that effect, thus allowing each receiving Office to establish its own requirements, as had been previously agreed by the Working Group (see paragraph 49 of document PCT/R/WG/5/13). Such an understanding could, if desired, be reflected in the report of the Assembly in the event that it adopted amendments of the Regulations along the lines of the proposals.

24. A number of delegations were concerned that leaving the necessary evidence to be decided by the receiving Office meant that a decision by an Office which had very flexible requirements could result in the restoration of a right of priority on the basis of evidence which might not have been acceptable to a designated Office in a different Contracting State having regard to the latter's national law, even if restoration of the right of priority were permitted under ostensibly the same criteria (due care or unintentionality).

25. Other delegations and a representative of users, referring to one of the basic principles of international cooperation under the PCT, namely, trust in the work and decisions taken by other Offices during the international phase, considered that it was essential that the decisions of receiving Offices should be binding on designated Offices in the circumstances provided for in Rules 49*ter*.1(a) and (b), except in very limited circumstances where there was a particular doubt that a requirement had been complied with. Consistency in the standards to be applied was desirable and might be pursued through the Administrative Instructions, Receiving Office Guidelines and sharing of relevant decisions, with the result that consistency would be encouraged while enabling each receiving Office to deal with matters using procedures familiar to it.

26. A representative of users was concerned that the term "reasonable in the circumstances" was not sufficiently certain as a time limit for filing a declaration or other supporting evidence. A minimum period of one month would be preferred. It was pointed out that Rule 14(6)(b)(i) of the PLT, on which this Rule was based, did not include a specific minimum time limit.

Rule 26bis.3(e)

27. One delegation asked whether the requirement that the applicant should have the opportunity to make observations would enable a formal hearing to be conducted and whether it should be possible to appeal decisions to the national courts. Another delegation considered that since the receiving Office's negative decision can always be reviewed by the designated Office, there was no need to provide for an appeal. The Secretariat pointed out that the PCT was in general silent on these matters. The availability of hearings and appeals was neither required nor precluded by the Treaty; rather, the matter was left to national law.

Rule 26bis.3(h)

28. Two delegations and one representative of users questioned the need for a transitional reservation provision under Rule 26bis.3(h), referring, in particular, to the wording of Article 10. However, other delegations pointed to the need for such a transitional reservation provision so as to afford time for the provisions of the applicable national law, such as those enabling the Office to require the payment of a fee for restoration of the right of priority, to be adapted to the new system.

29. In response to a comment by one delegation that a three month period may be insufficient for Contracting States wishing to make use of transitional reservation provisions, the Secretariat noted that this was the period that had usually been provided for in such transitional reservations when included in the Regulations in the past. Another delegation noted that such reservations would need to be made before entry into force of the provisions concerned.

Rule 48.2(a)(ix)

30. In response to a query by one delegation, the International Bureau explained that, since the list of contents of the pamphlet under Rule 48.2 was comprehensive, information concerning a priority claim which had been considered void was included in Rule 48.2(a)(ix) even though such information was also referred to Rule 26bis.2(d).

Rule 48.2(b)(v)

31. The Chair noted that Rule 48.2(b)(v) should refer to Rule 26bis.2(d) rather than Rule 26bis.2(c).

Rule 49ter.1(a) and (b)

32. Following a query by one delegation as to whether it was possible for a national law to provide for the restoration of the right of priority based on a criterion more favorable than the “unintentionality” criterion, as referred to in the Comment on Rule 49ter.1(b), another delegation suggested that, in practice, an Office would necessarily also accept, under such national law, decisions by a receiving Office based on the criterion of “unintentionality” and that the Comment was thus unnecessary. Another delegation suggested that a reference to more favorable requirements should be included in Rule 49ter.1(b) for consistency with Rule 49ter.2(e).

33. One delegation suggested that, with a view to avoiding the need for transitional reservations under Rule 49ter.1(f) by States which did not wish to introduce provisions relating to the restoration of the right of priority into their national law, and to avoid an inequality between the provisions of Rule 49ter.1(a) and (b), Rule 49ter.1(a) should be restricted to any designated State whose applicable law provided for restoration of the right of priority based on the criterion of “due care”; alternatively, the words “whose applicable law provided for restoration of the right of priority based on that criterion” in Rule 49ter.1(b) should be deleted. That suggestion was opposed by one delegation. The Secretariat noted that, for consistency with the PLT, the proposal had been based on the general rule that Offices should provide for restoration of a right of priority on either the “due care” or the “unintentionality” criterion, any exception to that general rule being provided by way of transitional reservations.

Rule 49ter.1(c)

34. One delegation, supported by another, expressed the view that the reference in Rule 49ter.1(c) to the requirements applied under Rule 26bis.3 should be clarified so as to refer expressly to those procedural and substantive requirements for the restoration of the right of priority under Rule 26bis.3, non-compliance with which would have the consequences provided for in Rule 49ter.1(c). The delegation suggested that the relevant requirements were those set out in Rule 26bis.2(a)(i) and (ii) and the criterion applied by the receiving Office (“due care” or “unintentionality”).

Rule 49ter.1(f)

35. Following a query by a delegation as to the nature of the effects of a reservation made by a designated Office under Rule 49ter.1(f), the Secretariat explained that such a reservation would have both procedural and substantive effects. For example, there would be consequences both in terms of calculating the time limit for national phase entry before the designated Office concerned and in terms of the assessment of novelty and inventive step during the national search and examination. The Secretariat agreed that a Comment to that effect should be added to better clarify the effects of reservations under Rule 49ter.1(f).

36. Another delegation noted that the reference in Rule 49ter.1(f) to “the national law applied by the designated Office” did not appear to apply to “a court or any other competent organ” as in Rule 49ter.1(c). The Secretariat noted that the same national law would presumably be applied by the designated Office and the courts in the designated State, and that it might therefore be preferable in Rule 49ter.1(f) to refer to the national law applied by the “designated State.” A representative of users noted that, in any event, the reference should be expressed so as to be clearly applicable in the case a designated Office which was a regional Office.

Rule 49ter.2

37. The Secretariat noted that comments made in respect of certain provisions of Rules 26bis.3 and 49ter.1 might also be relevant to corresponding provisions of Rule 49ter.2.

38. In response to a query by a delegation, the Secretariat explained that the purpose of Rule 49ter.2 was to enable an applicant to request restoration of the right of priority during the national phase in any of the following cases: where the applicant had not requested such restoration during the international phase; where the receiving Office had made a reservation under Rule 26bis.3(h) and thus the possibility of requesting restoration was not available during the international phase; where the receiving Office did not provide for restoration on the relevant criterion; or where the receiving Office had refused a request for restoration during the international phase.

39. In response to a query by another delegation, the Secretariat confirmed that it was intended to provide for the addition of priority claims only during the international phase (under Rule 26bis) and not during the national phase (unless such additions were possible under the national law itself), and the wording of proposed Rule 49ter.2 should be reviewed so as to ensure that it did not imply that such additions were enabled under the latter Rule.

Rule 49ter.2(g)

40. One delegation suggested that reservations under Rule 49ter.2(g) should apply to at least paragraph (f) in addition to paragraph (a).

41. The Secretariat explained that, although it was likely that a designated Office which made a reservation under Rule 49ter.1(f) would in practice also make one under Rule 49ter.2(g), there were circumstances in which a designated Office may need to make a reservation under only one of those Rules, for example, where its national law provided for restoration of the right of priority by the Office during the national procedure but did not put in place procedures enabling such restoration by it as a PCT receiving Office.

42. In response to a query by one delegation, the Secretariat agreed that proposed Rule 49ter.2(g) should be reviewed with a view to clarifying the basis of the calculation of the time limit referred to in that Rule, that is, whether the calculation should be on the basis of the priority date before or after restoration of the right of priority.

RECTIFICATIONS OF OBVIOUS MISTAKES

43. Discussions were based on document PCT/R/WG/6/3.

44. There was a clear divergence of views among delegations as to the cases and circumstances in which mistakes in international applications and related documents should be rectifiable under Rule 91.

45. After some discussion, the Working Group agreed that the Secretariat should further consider how to take this matter forward, taking into account the comments and suggestions noted in the following paragraphs, preferably by making use of the PCT Reform and PCT/MIA electronic forums.

46. While there was some support for a liberal approach to the correction of obvious mistakes, several delegations considered that proposed amended Rule 91.1(c)(i) was too broad, feeling that mistakes which only became apparent as a result of a lengthy investigation were not appropriate for rectification under Rule 91.

47. One delegation suggested that only mistakes in the request and other documents related to the procedure, but not in the description, claims and drawings, should be rectifiable under Rule 91, noting that mistakes in the description, claims and drawings could be corrected by way of amendments under Articles 19 and 34. It suggested that, since only *obvious* mistakes were rectifiable under Rule 91, it was not necessary that rectifications be physically entered in the application documents in order for their meaning to be known. The delegation suggested that providing for rectifications in the description, claims and drawings added complexity and placed an unnecessary burden on examining staff. It considered that, if rectifications of obvious mistakes in the description, claims and drawings were to be permitted, they should be limited to typographical and clerical mistakes which could be disposed of by clerical staff.

48. A number of delegations and representatives of users pointed out that existing Rule 91 already permitted the rectification of obvious errors in the description, claims and drawings, and considered that it was in the interests of applicants, designated Offices (in particular smaller Offices) and third parties for any mistake, where rectifiable and noted at a sufficiently early stage, to be rectified by only one action in the international phase, thus having effect for

the purposes of the procedure before all designated Offices. While some difficulties were seen with the current proposals, they represented an improvement on the current provisions, which were not clear enough to allow uniform interpretation.

49. One delegation questioned the relationship between Rule 91 and other Rules offering correction procedures in the case of particular kinds of mistakes (such as Rule 26*bis* with regard to the correction of priority claims), and suggested that the more general Rule (Rule 91) should not apply where a more specialized Rule providing for correction was available.

50. One delegation noted that the term “obvious” had a special connotation in connection with patent law, that is, in determining whether the invention involved an inventive step (see, for example, Article 33(1)), and suggested that it might be preferable to avoid use of that term in connection with the rectification of mistakes.

51. Opinions differed on the extent to which extrinsic documents (that is, documents other than the one in which the mistake occurred) should be able to be relied upon in support of a request for rectification. It was noted that the application of two tests was involved: (i) the recognition that there was indeed a mistake, and (ii) an assessment as to whether the proposed rectification was the only meaning which could have been intended. Most delegations which spoke on the matter considered that the fact that there was a mistake needed to be apparent on the face of the document containing the mistake, without referring to extrinsic documents, but a few delegation felt that extrinsic documents should be able to be considered at least in the case of mistakes in the request form. Some delegations considered that the question whether nothing else could have been intended than what is offered as rectification should also have to be answered without reference to extrinsic documents, but others considered that extrinsic documents should be able to be relied upon, at least in certain cases.

52. Among those delegations which favored reliance on extrinsic documents, there was a divergence of views as to whether the list of such documents appearing in Rule 91.1(c)(ii) was appropriate for all situations and whether it should be seen as exhaustive. There was a widespread feeling that it would usually not be acceptable to refer to extrinsic documents in relation to mistakes in the description, claims and drawings. Some delegations considered that the kind of documents which should be accepted as evidence relating to a mistake should be determined by the competent authority, depending on the facts of the particular case. Others felt that documents already on the file of the international application should always be able to be considered, although one delegation expressed concern that such an approach might lead to a large amount of background art being filed with the international application in the hope that it might later be useful for attempting to introduce changes in the application.

53. A number of delegations considered that it should be explicit in the Rule itself, rather than left to Guidelines, that a rectification was not permitted to go beyond the disclosure in the international application as filed. One delegation considered that this should be expressed as a limitation of the legal consequences of a rectification rather than as a component of the test for whether a mistake was obvious and thus rectifiable. It was noted that it may be necessary for a designated Office to have before it, when considering this issue, the application papers both as filed and as rectified.

54. One representative of users expressed the view that the priority document, being a clearly established document of record referred to in the request, should be able to be taken into account in deciding whether there was a rectifiable mistake in the international application. While there was some support for this view, particularly in relation to mistakes which had been introduced by errors in translation, most delegations which spoke on the matter considered that the description, claims and drawings should be viewed on their face in deciding whether there was a clear mistake. It was noted that a remedy in some cases might be available by way of provisions relating to “missing parts” (see documents PCT/R/WG/6/4 and 4 Add.1).

55. There was wide agreement that the current wording providing that “anyone” would need to “immediately” recognize that nothing else could have been intended was incapable of literal application and should be reviewed. A number of delegations considered that reference should be made to “the competent authority” rather than to “anyone.” One delegation suggested that the notional reader in all cases should be an average person with no special skills, and specifically that the application of Rule 91 should not require the involvement of patent examiners. Other delegations felt that rectification of mistakes in the description, claims and drawings should be dealt with by reference to a “person skilled in the art” and that the involvement of patent examiners was essential in relation to such rectifications.

56. There were no objections to the notion of a single time limit for the requesting of rectifications (see proposed Rule 91.2(a)), but several delegations felt that 28 months from the priority date was too late to enable completion of all the necessary actions before the end of the international phase, noting, in particular, that the proposals envisaged the republication of the international application if the rectification of an obvious mistake was authorized after international publication.

57. There was doubt expressed as to whether there was any benefit in allowing rectification of obvious mistakes in the description, claims and drawings during Chapter II proceedings, since such rectifications could in such cases be achieved by way of amendments under Article 34. In this connection, one delegation suggested that the time limit for requesting rectifications might appropriately be aligned with that for filing a demand for international preliminary examination.

MISSING PARTS REQUIREMENTS

58. Discussions were based on documents PCT/R/WG/6/4 and 4 Add.1.

59. The Working Group was generally in favor of the proposals contained in the document and invited the Secretariat to prepare revised proposals, for consideration at the next session, taking into account the comments and suggestions set out in the following paragraphs.

60. While a number of questions remained to be addressed, the revised drafting of Rules 4.18 and 20 in document PCT/R/WG/6/4 Add.1 was in general preferred to that in document PCT/R/WG/6/4. The references to Rules 4.18 and 20 in the following paragraphs are thus to those Rules as they appear in document PCT/R/WG/6/4 Add.1.

Rules 4.18 and 20

61. Some delegations expressed the view that there was no basis in the Treaty itself for the incorporation by reference of a missing element or missing part of an international application and therefore believed that an amendment of the Treaty would be required in order to implement provisions of the kind envisaged.

62. One delegation expressed the view that, since incorporation by reference of a missing element under Rule 4.18 would be conditional on compliance with the requirements of Rule 20.5(a) and (b), the proposed provision was not compatible with Articles 11(2) and 14(2) since, “at the time of receipt” of the international application, the missing element was not incorporated in the international application. The legal fiction established by Rule 4.18, according to which the missing element would be considered to have been incorporated by reference *ab initio* in the international application only if the requirements of Rule 20.5(a) and (b) were subsequently complied with, would not be sufficient to overcome the delegation’s concerns. In that delegation’s view, it would be necessary for such incorporation by reference to be unconditional so as to comply with those Articles.

63. One delegation expressed concerns as to compatibility of the proposal with the Articles of the Treaty and noted that the issue of missing parts could be dealt with, so far as a designated State was concerned, by appropriate provisions in the national law. That delegation and others stated that, in the event that the proposals were to proceed by way of amendment of the Regulations, a transitional reservation for designated Offices would therefore be needed in addition to that proposed for receiving Offices.

64. In response to a query concerning Rule 4.18 as to whether the applicant would need to establish on the face of the application documents that something was missing from them before an incorporation by reference could be effective, two delegations suggested that Rule 4.18 should be interpreted broadly so as to enable the incorporation by reference of any part or element contained in the priority document concerned, without having to satisfy such a test. One delegation pointed to Note 5.21 on PLT Article 5(6)(b) (filing date where missing part of description or drawing is filed), which referred to the question “whether, in a particular case, a missing part of the description or a missing drawing is completely contained in the earlier application.” Another delegation observed that there was no apparent policy reason for applying a strict interpretation of the provisions since the time frame was such that the missing part or element would always be included in the application as published, and there was no possibility of abuse since the relevant subject matter had to be contained in the earlier application.

65. A suggestion by a representative of users that it should be possible for the incorporation by reference of a missing part or element of an international application to be effected by acts taken in the national phase was opposed by several delegations. The International Bureau confirmed that the Comment on Rule 4.18 was not intended to imply such a possibility and should be modified accordingly.

66. In reply to a query by a delegation, the International Bureau explained that Rule 4.18 used the wording “The request *may* contain a statement ...” since it did not seem appropriate to require the applicant to include such a statement in all cases. A reference to the statement was required in Rule 4 since only contents listed in that Rule could be included in the request. In practice, however, it was envisaged that the request form would include a pre-printed statement under Rule 4.18.

67. In response to a query by a delegation, the Secretariat confirmed that, under Rule 20.5(a)(i) as proposed to be amended in document PCT/R/WG/6/4 Add.1, it was intended that, for the purposes of incorporation by reference, the priority claim must have been contained in the international application on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office.

IMPROVING THE QUALITY OF INTERNATIONAL SEARCHES

68. Discussions were based on document PCT/R/WG/6/9.

69. There was strong support from both delegations and representatives of users for the principle of allowing further searching to be carried out within the international phase in order to increase the amount of relevant prior art which was found. Representatives of users pointed out the difficulties, expense and additional work which were caused if additional prior art was brought to the applicant's attention only during the national phase. Most delegations considered that the proposals would provide a useful way of reducing the number of low quality patents granted, although two delegations suggested that measures to improve the quality of the existing international search might be more appropriate, or at least that the desire for this measure demonstrated the need to consider the improvement of quality in addition. Some delegations emphasized the need to increase the confidence of designated and elected Offices in using, rather than repeating, work that had been carried out in the international phase.

70. The Working Group invited the Secretariat to prepare revised proposals, for consideration at its next session, taking into account the comments and suggestions set out in the following paragraphs.

71. Two delegations were concerned about whether it was appropriate to introduce the proposed supplementary search by way of amending the Regulations. In particular, one delegation considered that allowing the international search to be carried out in more than one step was a major change which ought to be addressed by an amendment of the Treaty rather than of the Regulations. Another considered that Articles 15 to 17 referred to a single Authority performing the international search and wondered whether it was consistent with this to have portions of the international search performed by different Authorities. However, another delegation understood these provisions to require that an international search should be carried out on each international application, but in no way to specify that the whole of the international search process must be done by only one authority, or that the international search could not be divided between a main search and a supplementary search.

72. Most delegations were keen to ensure that a supplementary search should be a true complement to, rather than a duplication of, the main search. There was support for the principle that the supplementary search should be oriented primarily to finding disclosures in languages in which the supplementary Authority was specialized but which were not an official language of the main Authority. One delegation felt that a wider approach would be appropriate, taking into account that certain Authorities may have expertise in finding disclosures in particular areas outside the minimum documentation, in order to fill gaps which might exist in the main search. It was agreed that the scope of the supplementary search should be more clearly set out in the Regulations and/or the International Search and Preliminary Examination Guidelines.

73. One delegation noted that the main purpose of the suggested updating of the search during international preliminary examination was to find earlier patent applications which had not yet been published when the international search was carried out. It was suggested that this purpose might be achieved more efficiently by giving International Searching Authorities electronic access to the unpublished applications in other patent offices so that the relevance could be noted at the time of the original search.

74. One delegation expressed concern that the availability of extra searches might lead to a perception that cases in which the main search alone had been conducted were treated at a lower standard, but most delegations agreed that the supplementary search procedure should be available on an optional basis for applicants and for Authorities, which could choose whether to participate in it.

75. Many delegations and representatives of users felt that it would be preferable not to insist that applicants request supplementary searches at the time of filing but rather also to enable them to be requested after the results of the main search were available, for example, within one month of the establishment of the main search report. On the other hand, it was emphasized that the supplementary search procedure should fit in with the time limits for demanding international preliminary examination and for establishing the international preliminary report on patentability (whether under Chapter I or Chapter II), and that the new procedure should not have the effect of extending the international phase.

76. One delegation suggested that applicants should only be able to request supplementary searches as an alternative to demanding international preliminary examination, so that both procedures would not be available in a particular case. On the other hand, one representative of users suggested that supplementary searches should be made available only as part of the international preliminary examination procedure, which would need to be carried out by a different Office from that which had conducted the main international search.

77. A number of delegations expressed concern that the proposals would increase the workload of receiving Offices in collecting and processing extra search copies, issuing invitations for translations, receiving and forwarding translations, and processing supplementary search fees. One alternative would be to require requests for a supplementary search and related documentation to be sent directly to the Authority concerned. Another would be to provide for such requests to be sent to and processed by the International Bureau, which possibility might be particularly useful to the applicant where a number of supplementary searches were requested in respect of a single international application. One delegation expressed the hope that, if receiving Offices were to handle translations, they would choose not to impose fees for late receipt, which were considered an unnecessary burden on applicants.

78. One delegation representing a country with a small Office considered that the proposed supplementary search system would be highly beneficial to such Offices but, like some other delegations, was concerned at the likely high costs for applicants, particularly individual applicants, who wished to use it.

79. A number of delegations emphasized that the supplementary search system, to be feasible, would need to be simple to operate, and felt that the procedures presently proposed were too complicated. The system should be established in as simple a form as possible,

allowing further options to be added later if they were found to be needed. For example, the question of unity of invention should not be dealt with in a way which merely mirrored that applicable to the main search. One possibility was that supplementary searches, particularly if requested at the time of filing the international application, might have to be limited to the invention first mentioned in the claims. Some delegations and representatives of users indicated, however, that it was desirable to allow applicants to specify which claims should be the subject of supplementary search, noting that a more complete search in the international phase of all the inventions which it is desired to pursue would enable suitable amendments to be made before entering the national phase, avoiding the need to pursue amendments separately before a number of different designated Offices.

80. One delegation expressed the view that that the supplementary search should not involve the preparation of a written opinion by the search examiner. However, other delegations and representatives of users believed that an explanation of the relevance of citations discovered in the supplementary search would be necessary, particularly since it was likely that those citations would be in a language which would not be well understood by the applicant, the International Preliminary Examining Authority and some designated Offices.

81. Some delegations expressed concern that it would be impossible to eliminate duplication between the main search and any supplementary search. However, most delegations felt that, by defining the scope of the supplementary search carefully, such duplication could be minimized. Some delegations and representatives of users stated that, in any case, the possible duplication was no more than that which currently occurred when a designated Office repeated work that had already been done in the international phase, and that the amount of work involved overall should in fact be reduced if a more complete search was undertaken during the international phase, making it more likely that suitable amendments would be made before national phase entry.

ADDITIONAL COMMENTS BY SWITZERLAND ON ITS PROPOSALS REGARDING THE DECLARATION OF THE SOURCE OF GENETIC RESOURCES AND TRADITIONAL KNOWLEDGE IN PATENT APPLICATIONS

82. Discussions were based on document PCT/R/WG/6/11.

83. The Delegation of Switzerland introduced the document, noting that it was intended not to modify or replace but rather to complement the proposals by Switzerland presented to the previous session in document PCT/R/WG/5/11 by submitting additional comments on different aspects of the proposals, such as the use of certain terms, the concept of the term “source” used in the proposals, the scope of the obligation to declare the source of genetic resources, and the possible legal sanctions for failure to disclose or wrongful disclosure of the source. The Delegation expressed its hope that, taking into account the additional comments it had made, the Working Group would be able to enter into a more substantive discussion of the proposals. The Delegation explained that the proposed amendments to the Regulations were intended to increase transparency in the context of access to genetic resources and traditional knowledge and the fair and equitable sharing of benefits arising out of their utilization, and to provide a simple and practical way forward which could be introduced in a timely manner.

84. The Delegation of Ireland, speaking on behalf of the European Community (EC) and its Member States, stated that the EC and its Member States would continue their active and constructive participation in discussions on the issue related to the origin of genetic resources and associated traditional knowledge in patent applications in various international forums, such as WIPO's Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC), the TRIPs Council and the Convention on Biological Diversity (CBD). The EC and its Member States would soon present to the IGC a concrete, balanced and effective proposal concerning the possible introduction of a system concerning the disclosure requirement, which should positively support the achievement of the objective of the CBD while, at the same time, not placing an unreasonable burden upon patent Offices and patent applicants.

85. The Delegation further considered that WIPO as the specialized UN agency responsible for the protection of intellectual property worldwide would be, from a technical viewpoint, the most suitable forum for tackling the issues of patent disclosure requirements relevant to genetic resources and traditional knowledge, that the proposals by Switzerland could help to increase transparency with regard to genetic resources and traditional knowledge, and that they could be coordinated with the future work undertaken, especially in the IGC. Accordingly, it urged the Working Group to have a substantial discussion on the proposals by Switzerland.

86. The Delegation of Brazil expressed the view that effective measures were urgently required within the patent system to prevent misappropriation of genetic resources and traditional knowledge and to support the objectives and implementation of the CBD. The Delegation noted that it was appreciative of the clarifications offered in respect of the policy objectives of Switzerland's proposals, particularly of the aim of allowing the providers of genetic resources and traditional knowledge to verify whether the inventor and/or applicant had complied with prior informed consent and whether fair and equitable benefit sharing had been provided for. It noted, however, that, in order to effectively tackle "biopiracy," the actual effects of merely enabling national laws to require disclosure of origin in patent applications would be rather limited. To be truly effective, a requirement for disclosure of origin and prior informed consent would have to be a mandatory one, to be applied by patent authorities in all countries.

87. The Delegation of Brazil further stated that, while it appreciated Switzerland's comments on the definition of the term "source," it was concerned that too broad a definition would ultimately render the disclosure of origin requirement meaningless and ineffective in improving the substantive examination of patent applications and in ensuring compliance with prior informed consent and benefit sharing. Furthermore, if the aim was to ensure respect for prior informed consent and benefit sharing, patent Offices, in addition to requiring the disclosure of the origin of the genetic resources, should also ask applicants to provide information that would attest to their compliance with the national access and benefit sharing laws of the countries where the said resources were obtained. Such a requirement would be reasonable in that no entity interested in legally accessing the genetic resources under the sovereign jurisdiction of a State should have difficulty complying with it.

88. The Delegation of Brazil also expressed its concern as to whether, in establishing the relationship between traditional knowledge and the claimed invention that may trigger a disclosure requirement, the criterion of "conscious derivation" would be enough to give

sufficient security to the custodians of associated traditional knowledge. The Delegation feared that such a criterion could become a convenient means for circumventing prior informed consent. Moreover, in order to ensure that the disclosure of origin mechanism would be truly effective, and that patent applicants would not be rewarded in any way for violating the source countries' laws on access and benefit sharing, disclosure of origin should be a necessary condition for the granting of patent rights. Failure to comply with the requirement should be sanctioned with the non-granting of the patents or their revocation in cases where such patents had been wrongly granted.

89. The Delegation of Egypt, speaking on behalf of the African Group, expressed its appreciation to the Delegation of Switzerland for its proposals and for the additional comments it presented to this session of the Working Group. In the Delegation's view, these proposals reflected the acknowledgment that the protection of genetic resources and traditional knowledge against misappropriation must be addressed in patent related legal instruments and, in particular, by introducing the necessary changes to those instruments so as to ensure that they provided for the declaration of source of genetic resources and traditional knowledge. However, in the Delegation's opinion, although the proposals represented a positive step, they did not match all of the African Group's expectations, in particular, in relation to making the declaration of origin mandatory as it was left to the discretion of national patent legislation. The proposals thus fell short of the comprehensive solution envisaged. In addition, the proposals only addressed inventions which were "directly based" on genetic resources. This might be too restrictive as an approach. The Delegation made reference to the African Group's own proposals, in different fora, including those relating to a mandatory disclosure of origin in order to effectively combat misappropriation of genetic resources and traditional knowledge as well as ensuring prior informed consent and equitable benefit sharing.

90. The Delegation of Algeria supported the position expressed by the Delegation of Egypt on behalf of the African Group.

91. The views expressed by the Delegations of Brazil and Egypt were generally supported by the Delegations of China, India, Indonesia, the Islamic Republic of Iran, Kenya and South Africa.

92. The Delegation of China suggested that the Working Group should discuss the issue more deeply so as to incorporate the proposal into the PCT system and to formulate the operational framework as fast as possible.

93. The Delegation of the Islamic Republic of Iran welcomed, as a positive step, the proposals by the Delegation of Switzerland concerning the declaration of the source of genetic resources and traditional knowledge in patent applications. It expressed the view that the matter required further consideration, including of the way in which traditional knowledge was taken into account in the context of patent laws, and that discussions should continue in parallel in different international forums and in particular in the IGC. The Delegation further stated that, if the necessity of a disclosure requirement was accepted, the provision of sufficient legal sanctions in the case of non-compliance with that requirement should be mandatory.

94. The Delegation of the United States of America noted that, although Switzerland had added clarity to the proposal, certain important concepts, such as the definition of traditional knowledge, remained unclear. The Delegation expressed its concern as to the substance of the proposal itself, noting that it would not achieve its stated goals of achieving timely solutions to access to genetic resources and traditional knowledge as well as the sharing of the benefits derived from such access. Rather, the proposal would sanction provisions in national laws to deny patent rights and challenge granted patents under prescribed circumstances, which would increase litigation, create a disincentive for innovation, and reduce any benefits that may be shared. The Delegation could thus not support the proposal.

95. The Delegation of the United States of America noted that Switzerland compared its proposal to disclosure requirements which were based upon fundamental principles of patent law or required as a practical matter to facilitate patent examination, but in the Delegation's view the disclosure requirement proposed by Switzerland was directed to matters falling outside patent laws such as access and benefit sharing. The Delegation expressed the view that patent laws were not the appropriate means for addressing matters of misappropriation of genetic resources and traditional knowledge, or other matters of general misconduct. Such thinking might lead States to attempt to advance other non-patent related goals, such as a tax reporting requirement, through the patent laws. The Delegation urged the creation of effective national systems of access and benefit sharing with respect to genetic resources and traditional knowledge which were independent from intellectual property laws, such as the access and benefit sharing regime currently in place at national parks in the United States of America, which it viewed as being the most effective way to ensure that benefits were shared with respect to inventions developed from genetic resources or traditional knowledge. Any disclosure requirement in the patent laws would be likely to delay or create uncertainties in patent rights from which benefits might arise, the result of which would be to harm incentives for innovation by undermining the patent system. Without patent rights, there would be little or no benefits to share.

96. The Delegation of the United States of America expressed its view that the IGC would be the most appropriate forum for discussion of the matters at hand and should, under its renewed mandate, continue its important and fundamental work, in particular, finalizing its work on definitions relevant to the establishment of any access and benefit sharing regime.

97. The Delegation of Japan referred to the risk that a decision to amend the PCT Regulations as proposed by Switzerland could prejudice the outcome of discussions in the IGC. The Delegation also noted that a change of the PCT Regulations would not provide a comprehensive solution of the matter since applications for an invention that involved access to genetic resources or traditional knowledge could be filed nationally instead of under the PCT, and that the issue should therefore be discussed in the IGC. The Delegation expressed the view that requiring a declaration of the source of genetic resources would neither be relevant to patentability nor useful for search; rather, it would be meaningless and distort the patent system. Furthermore, requiring prior informed consent would lead to a burden for the applicant, contrary to one of the objectives of PCT reform, namely, simplification of the PCT system.

98. The Delegation of India expressed its concern about the argument that patent laws were not the appropriate means for addressing matters of misappropriation of genetic resources and associated traditional knowledge but that such matters should be dealt with under criminal or other laws. The Delegation noted the existence of cross-linkages between laws in very different fields. For example, in the context of money laundering, there were cross-linkages

between laws in different fields. Similarly, drug marketing approval authorities in certain countries were required to deny approval if the product was under a patent owned by a third person. The Delegation stated that, unless patent laws were accepted as being at the top of a kind of hierarchy in which other laws were subordinate to patent laws, it could not accept the argument that non-compliance with a disclosure requirement related to the origin of genetic resources and traditional knowledge could only be addressed under other laws but not within the framework of patent laws.

99. The Delegations of Algeria, Kenya and South Africa opposed the suggestion in the proposal by Switzerland that, if it were discovered after the granting of the patent that the applicant had failed to comply with the disclosure, the failure to disclose should not be a ground for revocation or invalidation of the granted patent except in the case of fraudulent intent. On the contrary, those Delegations considered that the fact that the applicant did not comply with the disclosure requirement would constitute a reason for the granted patent to be declared void or to be revoked.

100. The Representative of the EPI suggested that the appropriate sanction should depend on whether the disclosure requirement was considered to be a requirement as to substance, in which case the PCT would not be the appropriate forum to discuss the matter, or a requirement as to form and contents, in which case the failure to disclose should not be a ground for revocation or invalidation of the granted patent, except in the case of fraudulent intent, and suggested that this general question should be further considered by the IGC.

101. The Delegation of Norway reported that Norway had recently introduced a disclosure requirement into its national patent law and that non-compliance with that requirement was subject to sanctions in respect of false statements but that the requirement was not a condition of patentability.

102. The Representative of the ABA and the AIPLA expressed the view that the matter of disclosure was essentially a trade issue and should not be dealt with under patent law.

103. The Delegation of Australia, supported by the Delegation of the United States of America, stated that, although it was prepared to discuss disclosure requirements in the Working Group, this could only usefully be done after the basic issues involved had been resolved in the IGC.

104. The Delegations of Algeria, Brazil, Egypt, India and South Africa were of the view that the matter should be considered by the Working Group, in parallel with discussions in other fora of WIPO, noting particularly that the WIPO General Assembly had expressly renewed the mandate of the IGC “without prejudice to work pursued in other fora.” The Delegation of Brazil, furthermore, expressed its concern with the lack of consensus within WIPO with regard to the appropriate forum to discuss matters related to disclosure and other genetic resources related issues. The Delegation of Brazil also stated its understanding that these were relevant matters to be discussed at least in the IGC, the SCP and the Working Group.

105. The Chair invited discussion of the proposed amendments of the Regulations contained in Switzerland’s proposal. While some delegations expressed the desire that the Working Group enter upon a detailed discussion of the proposed amendments, other delegations expressed the view that a detailed discussion would not be productive at this time.

106. The Delegation of Switzerland thanked the Working Group for the consideration given to its proposal and, noting the clear divergence of opinions, stated that it would attempt to reconcile the different views expressed in a further document to be submitted to the Working Group for discussion at its next session.

107. The Working Group agreed to discuss the issue again at its next session.

SINGLE REQUEST FOR THE RECORDING OF CHANGES DURING THE NATIONAL PHASE

108. Discussions were based on document PCT/R/WG/6/10.

109. There was considerable support in the Working Group for further consideration of the concept of permitting requests to be made centrally for the recording of certain changes in respect of international applications which have entered the national phase, noting the significant consequential benefits that would accrue if greater communication resulted in common formats and easier access to patent data for information and statistical purposes.

110. The Working Group invited the Secretariat to prepare revised proposals for consideration at the next session, taking into account the comments and suggestions set out in the following paragraphs.

111. Some delegations expressed concern as to the legal basis in the Treaty for making Rules for procedures extending well into the national phase of processing of international applications. Some delegations felt that the regulation-making power in Article 58(1)(ii) was not a sufficient basis to establish procedures for which there was no general basis in the substantive Articles of the Treaty. Other delegations, however, felt that there was an adequate basis, noting, in particular, that the proposals were consistent with the aims of the Treaty as expressed in the preamble and were in no way inconsistent with any specific provision of the Treaty.

112. Some delegations noted that the Treaty in general governed procedures only to the end of the international phase, whereas, after national phase entry, the application became subject solely to national law. Concerns were expressed that introducing such a system might have consequential effects on the way in which other provisions in the Regulations were interpreted.

113. Other delegations pointed out that the international and national phases were not distinctly defined by the Treaty or Regulations, and that, in fact, certain features of the Treaty dealt specifically with matters obtaining long after the international phase was over. Those features included the fundamental principle that an international application has, for the purposes of the national law in all designated States, the effect of a regular national application having as its filing date the international filing date accorded under the Treaty (see Article 11). Other such features related to the provision of information (see Article 50), and the prohibition on requirements relating to the form or contents being applied to the application additional to those provided for in the Treaty and Regulations (see Article 27(1)).

114. Some delegations were of the view that the proposed system should only be applied in respect of changes concerning pending applications but should not apply to changes concerning granted patents.

115. It was generally agreed, as was proposed, that any such system should be limited, at least at the outset, to changes in the name and address of applicants, agents and inventors, noting that it would be difficult to achieve agreement at this stage on the kind of evidence which should be required for other kinds of matter.

116. A number of delegations were concerned that the proposed system would not be compatible with national laws which require the applicant to notify changes directly to the designated Office in a particular manner and with prescribed kinds of evidence, particularly in the case of a change of name. Moreover, it was noted that dealing with fees might pose difficulties. Consequently, it was felt that participation in any system would need to be on a voluntary basis for designated Offices or subject to transitional reservation provisions, although it was pointed out that the usefulness of the system would be considerably less if a significant number of Offices were to opt out of it.

117. One delegation expressed its concern that it would be too difficult to incorporate the proposed new system into established national procedures and that the new system would consequently result in greater, rather than less, work in designated Offices. It was noted, however, that certain checks would be carried out centrally by the International Bureau rather than the designated Offices concerned, meaning that there ought rarely to be any action required by designated Offices other than the recording itself. Other delegations considered that such a system ought to be very beneficial and should be considered further, even if it would imply changes to established national laws and systems.

118. One representative of users suggested that, since local agents needed to be informed about any changes concerning international applications which had entered the national phase, almost the same amount of work would be involved for the applicant as under the current system. The representative also expressed concern about the reliability of the new system in case of different applicants for different designated States or in case of multiple divisional applications divided from an international application which had entered the national phase, and suggested that a central register of ownership details would be desirable.

119. Delegations were generally content with the proposal that the applicant's request to the International Bureau could be made in either English or French, but some expressed the view that the communication from the International Bureau to the designated Office would need to be in a language accepted by the Office. It was noted that this difficulty would be largely overcome by use of forms using standard language which could be translated into several languages. Delegations of two Contracting States whose official languages used alphabets other than the Latin alphabet stressed the need for translations.

120. One delegation expressed the view that, even if the applicant could make a request for recording of a change centrally to the International Bureau, each designated Office ought to notify the applicant when the change had actually been made.

121. Some delegations stated that, in order for such a system to work reliably, appropriate information technology systems would be needed both at the International Bureau and at the designated Offices. One delegation suggested that the proposal might be premature in that the International Bureau had not yet completed its systems for processing PCT applications in electronic form in the international phase. A delegation from a developing country considered that technical assistance would be required in some cases to ensure that Offices had the necessary capacity to handle electronic files.

National Phase Entry

122. One delegation inquired as to progress that had been made towards the related matter of centralized information on the entry of international applications into the national phase in different designated Offices (a matter on which the Office of the PCT as well as WIPO's Standing Committee on Information Technologies were working). The Secretariat informed the Working Group that preliminary discussions had taken place with a number of Offices which were known to maintain records allowing international applications in the national phase to be identified by means of their international application or publication number. The Secretariat was in the process of identifying common factors between the systems in those Offices and intended to extend the investigations to a larger group of Offices, with the aim of developing possible recommendations to Offices concerning record-keeping in order to allow the necessary information to be collected.

ASPECTS OF COPYRIGHT AND OTHER RIGHTS IN NON-PATENT LITERATURE
MADE AVAILABLE BY INTELLECTUAL PROPERTY OFFICES

123. At previous sessions, the Working Group had considered copyright issues raised by the international search and international preliminary examination procedure, in particular, the possibility 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 (see document PCT/R/WG/5/5).

124. The Working Group had agreed at its fifth session "that, in order to ensure discussion of the issues at hand by both patent and copyright experts, the matter should be referred to WIPO's Standing Committee on Copyright and Related Rights (SCCR) with a view to establishing a joint (virtual) task force open to all parties invited to participate in the Working Group and the SCCR. It was envisaged that the task force would operate mainly using an electronic forum and that it be coordinated by the International Bureau. The task force would be asked to prepare a report for consideration by both the Working Group and the SCCR." (See document PCT/R/WG/5/13, paragraph 146.)

125. The Secretariat informed the Working Group that, upon further consideration, it appeared that the establishment of such a task force would be unlikely to resolve the issues that had been identified. The Secretariat accordingly suggested that it would be best for the matter to be further discussed among the International Authorities with a view, in particular, to exploring possible solutions based on existing exceptions to copyright and related rights protection contained in the Berne Convention for the Protection of Literary and Artistic Works. Any progress in relation to the issue could then be reported to the Working Group.

126. The Working Group agreed with the suggestion of the Secretariat mentioned in paragraph 125, above.

FURNISHING OF SEQUENCE LISTINGS FOR SEARCH AND EXAMINATION

127. Discussions were based on document PCT/R/WG/6/2.

128. The Working Group approved the proposed amendments of the Regulations set out in the Annex to document PCT/R/WG/6/2 with a view to their submission to the

Assembly in September 2004, subject to the further amendments appearing in the following paragraphs and to possible further drafting changes to be made by the International Bureau.

Rule 13ter

129. The Working Group agreed that Rule 13ter.1(a) to (c) should be further amended to read as follows:

“13ter.1 Procedure Before the International Searching Authority

(a) Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the International Searching Authority may invite the applicant to furnish to it, for the purposes of the international search, a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions, unless such listing in electronic form is already available to it in a form and manner acceptable to it, and to pay to it, where applicable, the late furnishing fee referred to in paragraph (c), within a time limit fixed in the invitation.

(b) Where at least part of the international application is filed on paper and the International Searching Authority finds that the description does not comply with Rule 5.2(a), it may invite the applicant to furnish, for the purposes of the international search, a sequence listing in paper form complying with the standard provided for in the Administrative Instructions, unless such listing in paper form is already available to it in a form and manner acceptable to it, whether or not the furnishing of a sequence listing in electronic form is invited under paragraph (a), and to pay to it, where applicable, the late furnishing fee referred to in paragraph (c), within a time limit fixed in the invitation.

(c) The furnishing of a sequence listing in response to an invitation under paragraph (a) or (b) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a late furnishing fee whose amount shall be determined by the International Searching Authority but shall not exceed 25% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets, provided that a late furnishing fee may be required under either paragraph (a) or (b) but not both.”

130. The Working Group agreed that Rule 13ter.2 should be further amended to read as follows:

“13ter.2 Procedure Before the International Preliminary Examining Authority

Rule 13ter.1 shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority.”

Rule 23

131. The Working Group agreed that Rule 23.1(c) should be further amended to read as follows:

“(c) Any sequence listing in electronic form which is furnished for the purposes of Rule 13^{ter} but submitted to the receiving Office instead of the International Searching Authority shall be promptly transmitted by that Office to that Authority.”

SIGNATURE REQUIREMENTS

132. Discussions were based on document PCT/R/WG/6/6.

133. The Working Group invited the Secretariat to prepare revised proposals, for consideration at the next session, taking into account the comments and suggestions set out in the following paragraphs.

Signature Requirements for Withdrawals

134. The proposed amendments of the Regulations in respect of signature requirements for withdrawals were welcomed by one delegation and one representative of users.

135. Three delegations opposed the proposed amendments in respect of signature requirements for withdrawals for a variety of reasons. One view expressed was that the requirements and procedures for signature of documents should not vary at different stages of the processing of applications. The view was also expressed that there was no reason for departing from the approach of the Working Group agreed at its second session that the signatures of all co-applicants should be required for withdrawals. Another concern was that the notification procedure proposed under Rule 90^{bis}.5(c) would impose additional burdens and workloads on Offices, as well as adding complexity to the procedures.

136. One delegation, supported by two representatives of users, suggested that it would be helpful to applicants and offices if provision were made in the request form, in the form of a check-box enabling the applicant to withdraw the designation of one or more States, thus avoiding certain problems arising from the recently implemented automatic and all-inclusive designation system, in particular in respect of States with “self-designation” provisions in their national laws, such as Japan, and the inventorship requirements in designating the United States of America. Another representative of users also noted that such a possibility could be used to avoid problems arising, in particular in the United States of America, from certain recent court decisions, or in order to comply with the terms of licensing agreements. The Secretariat recalled the objectives of the new designation system and noted that to allow, in effect, for the exclusion of certain designations in the request form would constitute a substantial dilution of those objectives, which had been at the forefront when the Assembly decided to adopt the new system; rather, consideration should be given to addressing the difficulties by adjustments of national law.

Signature Requirements for Correspondence

137. The proposed changes in respect of signature requirements for correspondence (see proposed amended Rule 92.1) were welcomed by two delegations and one representative of users. Another delegation questioned whether the proposed changes achieved the stated

objectives or were even needed since, where there was no common agent or appointed common representative, the signature of the “deemed” common representative (see Rule 90.2(b)) would be sufficient.

INTERNATIONAL PUBLICATION IN MULTIPLE LANGUAGES

138. Discussions were based on document PCT/R/WG/6/8.

139. The Working Group invited the Secretariat to prepare revised proposals, for consideration at its next session, taking into account the comments and suggestions set out in the following paragraphs.

140. One delegation confirmed that the proposal as presently drafted would achieve its primary objective of establishing prior art effect of the international application concerned under its national law. In view of this confirmation, the proposal was supported by two other delegations. One of those emphasized, however, the need to discuss a possible revision of Article 64(4) at some stage in the future.

141. One delegation and one representative of users, while welcoming the proposals in relation to the question of prior art effect, stated that the effects of international publication in an additional language other than those relating to prior art effect ought to be further examined and kept in mind as further proposals were developed. Such other effects included, for example, the affording of “provisional protection” to published applications (see Article 29).

142. One representative of users suggested that international publication in additional languages should not be restricted to languages of publication under the PCT, that there should be a longer time limit for submitting translations for publication, that additional language versions should be published only in electronic form as documents downloadable from the Internet, and that the fee for publication should vary depending on the particular electronic format in which a translation was provided.

143. One representative of users, while not opposed to the proposals *per se*, expressed concern that publication of international applications in multiple languages was out of line with one of the basic aims of the Treaty, namely, to give effect under multiple national laws to an international application filed in a single language. The representative suggested that the additional costs involved would deter most applicants from using the proposed system, and that the underlying issue concerning the prior art effect of published international applications should be dealt with in the context of the consideration by WIPO’s Standing Committee on the Law of Patents of a proposed Substantive Patent Law Treaty.

PCT REFORM: FAST TRACK

144. Discussions were based on proposals by the European Patent Office in document PCT/R/WG/6/7.

145. Several delegations expressed opposition to the proposed creation of a drafting sub-committee, noting that the Working Group had already been set up to permit a more efficient and faster discussion of proposals than was possible in the Committee on Reform of the PCT (“the Committee”) itself. Those delegations stressed the importance of having oral discussions by all Contracting States which wished to attend before any proposal was put to

the Assembly. It was pointed out that there was already a degree of flexibility among members of the Working Group in that it had not been considered necessary in all cases to refer issues back to the Committee before proposed amendments were submitted to the Assembly.

146. Moreover, those delegations noted that it would, in any case, be extremely difficult to agree upon the composition of a smaller sub-committee, and stated that it would be undesirable to concentrate discussion in such a group since it would reduce Contracting States' understanding of proposed changes, deprive the discussion of potential alternative insights, and reduce the acceptance of the results which emerged. It was also noted that it was not always easy to identify in advance whether matters were purely technical in nature or whether they gave rise to issues of more political importance.

147. There was general support for more effective use of the electronic forum for resolving drafting matters in advance of meetings, but several delegations emphasized that this should not become the primary means of debate, noting particularly the difficulty for some interested States to be effectively involved given their limited resources.

148. The Chair concluded that there had been no support for the proposal in document PCT/R/WG/6/7. Noting the general agreement in the Working Group on the usefulness of the electronic forum, he encouraged all delegations to make greater use of that forum in future.³

WORK PROGRAM

149. The Working Group agreed that the present summary by the Chair, together with the summary of the fifth session, should be submitted to the Assembly at its next session, to be held in September-October 2004, to inform the Assembly of the progress that had been made on the matters referred by the Assembly to the Working Group at its previous session in September-October 2003 (see document PCT/A/32/8, paragraph 20).

150. The Working Group agreed to recommend to the Assembly that, subject to the availability of sufficient funds:

(i) two sessions of the Working Group should be convened between the September 2004 and September 2005 sessions of the Assembly to consider proposals for reform of the PCT including, in particular, the matters mentioned 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) financial assistance allocated to enable certain delegations to attend sessions of the Committee should, exceptionally, also be made available, in the measure possible, for those sessions of the Working Group.

³ See <http://www.wipo.int/pct/reform/en/index.html>.

OTHER MATTERS

151. The Working Group noted with great pleasure the announcement by the Delegation of Brazil that Brazil's notification of incompatibility with the modifications of the time limits fixed in Article 22(1) had been withdrawn.

152. Following the announcement from the chair by Mr. Siep de Vries of his impending retirement, the Working Group and the Secretariat expressed their thanks to Mr. De Vries for his valuable contribution over many years to the development of the PCT system and wished him all the best for the years to come.

NEXT SESSION

153. The International Bureau indicated that the seventh session of the Working Group was tentatively scheduled for either the week of November 22 to 26, 2004, or that of November 29 to December 3, 2004.

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

[End of Annex II and of document]