

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Third (25th Extraordinary) Session Geneva, October 1 to 9, 2012

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/50/1): 1, 3 to 8, 10 to 12, 15 to 21, 29, 37 and 38.
2. The report on the said items, with the exception of item 29, is contained in the General Report (document A/50/18).
3. The report on item 29 is contained in the present document.
4. The meeting of the Assembly was presided over by Ms. Susanne Ås Sivborg (Sweden), Chair of the PCT Assembly.

PCT WORKING GROUP: REPORT ON THE FIFTH SESSION

5. Discussions were based on document PCT/A/43/1.
6. The Secretariat explained that the purpose of document PCT/A/43/1 was to inform the Assembly about the discussions and agreements reached during the fifth session of the PCT Working Group, held in Geneva in May/June 2012. The Summary by the Chair, set out in Annex I to the document, contained an overview and summary of the items discussed and the agreements reached during that session. In addition, since the publication of document PCT/A/43/1, the final report of the fifth session of the Working Group (document PCT/WG/5/22)

had been adopted by Member States by correspondence, having been made available as draft report (document PCT/WG/5/22 Prov.), in both English and French, for comments by all participants in the meeting on the Working Group's electronic forum.

7. The Secretariat further stated that, as could be seen from the Summary by the Chair, in addition to a number of more technical issues, the focus of the discussions in the Working Group had again been on the continued implementation of the Recommendations which had been endorsed by the Working Group at its third session in 2010 on how to improve the quality of the services offered by the PCT system, for the benefit of all stakeholders. The Working Group further had agreed on a number of proposed amendments to the PCT Regulations for adoption by the Assembly, as set out in document PCT/A/43/2. Finally, Annex II to the document reproduced the statements made by delegations during the fifth session of the Working Group on the agenda item "Contribution of the Working Group to the Implementation of the Respective Development Agenda Recommendations", further to the decision by the 2010 WIPO General Assembly on the Development Agenda Reporting Mechanism.

8. The Delegation of China expressed its support for the work of the PCT Working Group.

9. The Delegation of Brazil, speaking on behalf of the Development Agenda Group, stated that in order to be fully integrated into the PCT system, and to benefit from it, developing countries needed to promote capacity building and invest in human resources. Having access to technical assistance was one of the advantages accruing to Member States under the PCT. Technical assistance was also necessary for implementing the objectives of the Treaty, allowing all countries to use and reap the benefits of the patent system. Therefore, the Working Group necessarily had to take PCT Article 51 into account in its debates. The Delegation stated that technical assistance should include, *inter alia*, the training of personnel at the Offices and should facilitate access to appropriate tools for search and examination, such as patent databases and technological infrastructure. To conclude, the Delegation highlighted the need for improvements to allow for small and medium-sized enterprises as well as individuals to benefit adequately from the PCT system. The Development Agenda Group supported deeper discussions to provide concrete solutions for these actors responsible for a substantial amount of growth, employment and innovation, particularly in developing countries.

10. The Delegation of Japan stated that it wished to deliver a brief general statement on the PCT system. The Delegation stated that many of the PCT applications were filed by Japanese applicants and Japan was one of a few nations recording an increase in the number of PCT filings, even in the midst of the recent severe economic circumstances. Fees from the PCT accounted for 70 per cent of the revenue in WIPO, making the PCT system an indispensable tool for WIPO in the promotion of innovation in developing countries, for small and medium-sized enterprises (SMEs) in all countries, and an important tool for business development and economic growth for key players. The Delegation expressed the expectation that meaningful and valuable fruits would be borne through practical and productive discussions in the Working Group and that the PCT system would subsequently become truly user-friendly. To that end, the Delegation welcomed the proposals on PCT improvements made by the United States of America and the United Kingdom and also by the European Patent Office. The Delegation concluded by affirming its commitment to constructive discussions in the PCT-related bodies in WIPO.

11. The Delegation of the Republic of Korea stated that it wished to make a general statement on the operation of the PCT system, which had been through major changes mainly arising from progress in automation and rule changes. For example, the revision of roles among international Offices and designated officials kept evolving, including formalities examination by receiving Offices and the International Bureau, with the transmission of documents and also the responsibility of formalities examiners changing accordingly. Moreover, the Delegation

expected the ePCT project currently being undertaken by WIPO to accelerate the changes of PCT systems of operation. The Delegation therefore considered it very helpful for WIPO to share the big picture of the PCT system at an operational level.

12. The Delegation of Sweden emphasized the great importance of the PCT system and its commitment to the valuable work of the PCT Working Group striving to improve the functioning of the system. The Delegation therefore stated that it was committed to improving the quality of the PCT system to the benefit of the users and other stakeholders. It was important that International Authorities, such as the Swedish Patent and Registration Office, continuously improved the work processes and the quality of the results delivered, and looked forward to continuing the cooperation with other International Authorities. The Delegation also wished to support the candidacy of the National Institute of Industrial Property of Chile to become an International Authority.

13. The Delegation of Iran (Islamic Republic of) stated that it had noted with appreciation the activities of the PCT Working Group to improve the functioning of the PCT system. Proposed amendments needed to be based on the Development Agenda and consider the interests of all parties involved, namely, the applicants, the users and the public. The different levels of development among Member States should also be taken into account. The Delegation believed that improvement of the functional capacity of the national intellectual property Offices of developing countries through providing technical assistance was one of the core goals of the PCT and patent system. This also fostered the economic development of the developing countries by encouraging their domestic innovation capacities and assisting them in ensuring high quality patents through a meaningful examination of the technical aspects of innovations. Indeed, technical assistance of WIPO to the industrial property Offices of Member States lay at the heart of its functions; paragraph (v) of Article 4 of the Convention Establishing the World Intellectual Property Organization explicitly stated that it “shall offer its cooperation to States requesting legal-technical assistance in the field of intellectual property”. Furthermore, this issue was also highlighted in Article 51 of the PCT. This principle needed to be respected by all members and attempts to blur this function had to be prevented. The Working Group therefore needed to give priority to the improvement of the human resources of the national intellectual property Offices, consider establishing organizational connections between intellectual property Offices to exchange experiences and to collaborate on issues of common interest, especially on technical examination and collaborative searches.

14. The Delegation of Sudan stated that it agreed with the intervention by the Islamic Republic of Iran and, as a least developed country, requested the Organization to provide technical assistance with regards to the PCT procedures. Sudan had been receiving international applications since 1984 which were not subjected to objective examination in the national phase. The Delegation therefore asked the Organization to provide technical assistance and training in favor of the Office of the Registrar General of Sudan.

15. The Delegation of Peru highlighted the efforts made by many developing countries – including Peru – despite their very meager resources, to avoid blatant cases of biopiracy, as well as the incorrect grant of patents, frequently owing to the lack of inventive step of a patent application that the examiner responsible failed to observe adequately. In that regard, the Delegation called on national intellectual property Offices to strengthen still further their cooperation links and information exchange, and was of the opinion that that was a challenge in relation to which WIPO could be of great assistance. For that reason, a “global observatory” or an “information exchange center” could be set up which, while respecting the principles of territoriality and confidentiality that governed the process of patent evaluation, but emphasizing the cooperative nature of WIPO members, would be of use to national intellectual property Offices in their analysis of the state of the art for the patent applications filed with them. Such cooperation mechanisms would be of particular importance with regard to applications concerning genetic resources, derivatives thereof or associated traditional knowledge.

16. The Assembly:

- (i) noted the Summary by the Chair of the fifth session contained in document PCT/WG/5/21 and reproduced in Annex I of document PCT/A/43/1;
- (ii) noted the excerpts from the draft report of the fifth session of the Working Group contained in document PCT/WG/5/22 Prov. and reproduced in Annex II of document PCT/A/43/1, concerning the contribution by the Working Group to the implementation of the respective Development Agenda Recommendations; and
- (iii) approved that, subject to the availability of sufficient funds, one session of the Working Group should be convened between the October 2012 and September/October 2013 sessions of the Assembly; and that the same financial assistance that had been made available to enable attendance of certain delegations at the fifth session of the Working Group should be made available to enable attendance of certain delegations at that next session.

QUALITY MANAGEMENT SYSTEMS FOR INTERNATIONAL AUTHORITIES

17. Discussions were based on document PCT/A/43/2.

18. The Secretariat, in introducing document PCT/A/43/2, noted that the purpose of the document was threefold. Firstly, to inform Member States of the availability, on WIPO's web site, of the latest reports by International Authorities on the state of their existing quality management systems. A summary of the main points of interest, prepared by the Quality Subgroup of the Meeting of International Authorities, was contained in Annex I to the document. Secondly, to report on the outcome of the second meeting of the Quality Subgroup, which took place in Canberra in February 2012, as set out in Annex II to the document. As could be seen from the report, the focus of this second meeting of the quality subgroup had again been on effective quality improvement measures, that is, measures to improve the overall quality and usefulness of the international work products of the PCT, that is, the PCT international search reports and the international preliminary reports on patentability. Finally, the document also reproduced, in its Annex III, the relevant sections (in relation to the quality framework) of the Summary by the Chair of the nineteenth session of the Meeting of International Authorities, held in Canberra in February 2012.

19. The Delegation of Australia stated that it had enjoyed hosting the Quality Subgroup meeting which had been held in Canberra in warm February conditions. Australia strongly supported the international phase of the PCT and believed that high quality work in the international phase was essential to enable the PCT to fulfill its aim of minimizing the duplication of work. That is, for international work to be relied on, applicants and other Offices needed to have confidence that it was both relevant and done properly. Australia supported the Quality Subgroup and believed that the work being carried out therein would help to improve the quality management systems in place in IP Offices around the world. The Delegation also believed that a robust exchange on quality issues was essential for International Searching Authorities to achieve consistent production of high quality work.

20. The Delegation of the United States of America supported the continued work of the Meeting of International Authorities and the Quality Subgroup and their efforts to find ways to improve work product quality within the PCT system. In particular, the Delegation placed great importance on the value of transparency in the search and examination process and believed that transparency was key to quality improvement. The United States Patent and Trademark Office had published search strategies for domestic and international searches for some time through its Patent Application Informational Retrieval (PAIR) system and would begin to submit search strategies for international applications for publication in PATENTSCOPE in the near

future. The Delegation commended the Quality Subgroup and the Meeting of International Authorities for supporting the voluntary publication of search strategies and encouraged all International Authorities to take advantage of this option.

21. The Assembly noted the contents of document PCT/A/43/2.

REVIEW OF THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

22. Discussions were based on document PCT/A/43/3.

23. The Secretariat, in introducing document PCT/A/43/3, recalled that the PCT Union Assembly, at its thirty-sixth session held in September/October 2007, adopted amendments to the Regulations so as to introduce a supplementary international search system to the PCT. These amendments had entered into force on January 1, 2009. Along with adopting these amendments, the Assembly had decided that the International Bureau should report on the financial and operational situation of the supplementary international search system and that the Assembly should review the supplementary international search system three years after the date of entry into force of the system. Annex I to document PCT/A/43/3 set out the requested report by the International Bureau on the financial and operational situation of the supplementary international search system, three years after its entry into force; that report had been reviewed and extensively discussed by the Working Group at its fifth session.

24. The Secretariat further stated that, clearly, the very low uptake by applicants of the supplementary international search system during the first three years of its existence was disappointing, in particular in view of the strong demand by the user community for the establishment of such a system. On the other hand, the statistics for the first three years and the feedback received by the International Bureau in reply to a Questionnaire sent out to all major stakeholders suggested that there were very concrete reasons for the low uptake, notably the very limited mix of languages offered by the Authorities currently carrying out supplementary searches. In addition, there were a number of further developments, as set out in the document (such as the fact that some Authorities had only recently begun to offer the service, and that work-sharing arrangements such as PPH might provide a stronger incentive to use the system) which suggested that it might be too early to “give up” on the eventual acceptance and success of the system. Thus, based on a recommendation by the PCT Working Group, the document invited the Assembly to take the decision to continue to monitor the operation of the system for a further three years, during which time Offices should seek to raise awareness of the system and International Authorities should review the scope and cost of the services which they offer under that system.

25. The Delegation of China thanked the IP Offices of those countries and regions that offered supplementary international searches for the wealth of experience that they had built up in the process. The Delegation considered it of great utility to continue tracking and studying the supplementary international search system. China supported the International Bureau's proposal to monitor the supplementary international search system for another period of three years and was ready to offer its cooperation to the International Bureau in promoting the service to users. The Delegation suggested that future refinements and modifications of the PCT system should go by the principle of orderly and incremental progress and feasibility in the context of reality, taking into account the needs of all stakeholders and the potential problems that might exist, so that the rules that entered into force could function in practice as they had been intended.

26. The Assembly noted the report by the International Bureau on the financial and operational situation of the supplementary international search system contained in paragraphs 7 to 34 of document PCT/WG/5/8 and reproduced in the Annex to document PCT/A/43/3.

27. The Assembly, having reviewed the supplementary international search system three years after the date of entry into force of the system, decided:

- (a) to invite the International Bureau to continue to closely monitor the system for a period of another three years, and to continue to report to the Meeting of International Authorities and the Working Group on how the system is developing;
- (b) to invite the International Bureau, International Authorities and national Offices and user groups to increase their efforts to raise awareness of and promote the service to users of the PCT system;
- (c) to invite the International Authorities which offer supplementary international searches to consider reviewing the scope of their services provided under the system and consequently the levels of fees charged for the services provided, which should be reasonable; and to invite Authorities which currently do not offer the service to reconsider whether to offer the service in the near future;
- (d) to review the system again in 2015, taking into account further developments until then, notably in relation to efforts to move towards collaborative search and examination models and in relation to efforts to improve the quality of the “main” international search.

PROPOSED AMENDMENTS TO THE PCT REGULATIONS

28. Discussions were based on document PCT/A/43/4.

29. The Secretariat, in introducing document PCT/A/43/4, explained that the effect of the proposed amendments would be a simplification of PCT procedures for applicants from all Contracting States. In particular, inventors no longer had to be named as applicants solely for the purposes of the designation of the United States of America, with consequential impact on signature requirements and with regard to the furnishing of certain documents containing oaths or declarations of inventorship. All of these changes were consequential on the recent enactment in the United States of America of the America Invents Act.

30. The Secretariat further stated that the proposed amendments had been discussed in great detail by the PCT Working Group, which had unanimously agreed to recommend that this Assembly should adopt the amendments as proposed. Annex I contained a marked-up text of the proposed amendments of the Regulations, with changes highlighted by underlining and strikethrough. Annex II contained a clean text of the amended Rules as they would stand after amendment. A proposed draft decision with regard to entry into force and transitional arrangements was set out in paragraph 7 of the document.

31. The Delegation of the United States of America stated that it appreciated the work of the PCT Working Group in addressing the challenges and opportunities presented by the American Invents Act. The proposed changes to the PCT Regulations represented a significant simplification for the applications from all Contracting States and the United States of America supported their adoption.

32. The Delegation of El Salvador expressed its thanks for the work that had been done in the PCT Working Group. El Salvador recognized that the Treaty needed improvement to make it more effective and to satisfy the needs of the applicants, the patent Offices and third parties in all Contracting States. In all such improvements, El Salvador believed that the level of development of the Member States of the Treaty needed to be taken into account and asked that the work of adopting amendments to the PCT should be done gradually through a

member-driven process that involved third parties and all of those interested through consultations, seminars and information workshops.

33. The Assembly:

- (i) adopted the proposed amendments to the Regulations under the PCT set out in the Annex to this report;
- (ii) decided that the amendments of Rules 4.15, 51*bis*.1, 51*bis*.2, 53.8 and 90*bis*.5 set out in the Annex to this report shall enter into force on January 1, 2013, and shall apply to any international application whose international filing date is on or after that date.

APPOINTMENT OF THE NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY OF CHILE AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

34. Discussions were based on document PCT/A/43/5 Rev.

35. The Chair stated that the PCT Committee on Technical Cooperation had held its twenty-fifth session to give advice to the PCT Union Assembly on the request of the National Institute of Industrial Property of Chile to be appointed as an International Searching and Preliminary Examining Authority under the PCT. Having listened to the presentation by the Delegation of Chile, all delegations which had taken the floor on the matter had expressed their support for the appointment; some delegations had made constructive proposals aimed at strengthening and further developing the quality of the work carried out by International Authorities. The Committee had given a unanimous favorable advice on the appointment of the National Institute of Industrial Property of Chile as an International Searching and Preliminary Examining Authority under the PCT.

36. The Delegation of Chile expressed its sincere thanks to the PCT Union Assembly and to the 26 delegations that had taken the floor, including one speaking on behalf of GRULAC. It was an honor for Chile to now become part of the group of International Searching Authorities and International Preliminary Examining Authorities. It was the personal commitment of the Director of the National Institute of Industrial Property of Chile and the commitment of the Government of Chile to ensure that the appointment was going to be of great benefit to the entire PCT system and to ensure that the Institute did good work. It was also a commitment to promote the Latin America region. The Delegation again wished to thank all who had given their support over the recent months to the Institute's candidacy.

37. The Delegation of Trinidad and Tobago stated that it applauded the continuous efforts of the International Bureau, the Authorities and the Member States to evolve the PCT system as the needs of users changed. It wished to also support the appointment of the National Institute of Industrial Property of Chile as an International Searching Authority and International Preliminary Examining Authority under the PCT. It had every confidence in the Institute's capacity based on its track record. Even though its working language was not Spanish, Trinidad and Tobago appreciated the diversity of Authorities available to applicants. It noted the efforts of Authorities with respect to setting up a quality management systems and fully appreciated the steps taken by many Authorities to meet the demands of both growing workloads and the ever present need for a high degree of validity of their work. It anticipated that the National Institute of Industrial Property of Chile, like all other Authorities, would follow in that direction as well. More important would be its commitment to the quality management process. It therefore welcomed related PCT quality initiatives and looked forward to working closely with WIPO with respect to their implementation. It further requested that ample consideration be given to the

differing developmental levels of the various PCT Member States so that new developments were able to accommodate those differences.

38. The Delegation of New Zealand stated that it wished to join other delegations in supporting the appointment of the National Institute of Industrial Property of Chile as an International Authority and congratulated the National Institute of Industrial Property on its success in modernizing its operations. The Delegation hoped that the appointment of the National Institute of Industrial Property of Chile would encourage greater use of the PCT by applicants from Latin America.

39. The Representative of the European Patent Office stated that it had intended to make its statement during the session of the PCT Committee on Technical Cooperation but had not been able to do so. The European Patent Office supported the comments made by the Delegation of the Russian Federation during the session of the PCT Committee on Technical Cooperation on the importance of quality in the PCT, that the PCT rules for becoming an International Searching and Preliminary Examining Authority were outdated and that a review thereof now appeared necessary. It therefore wished to encourage this issue to be dealt with by a PCT working group in the near future.

40. The PCT Assembly, having heard the Representative of the National Institute of Industrial Property of Chile and taking into account the advice of the PCT Committee for Technical Cooperation, unanimously

(i) approved the text of the draft Agreement between the National Institute of Industrial Property of Chile and the International Bureau as set out in Annex III to document PCT/A/43/5 Rev; and

(ii) appointed the National Institute of Industrial Property of Chile as an International Searching Authority and an International Preliminary Examining Authority with effect from the entry into force of the Agreement until December 31, 2017.

41. The Director General of WIPO stated that he wished to formally, on behalf of the International Bureau, congratulate Chile, the Delegation of Chile and the National Institute of Industrial Property of Chile. The International Bureau would be delighted to work with the Institute to bring its status as an International Authority into operation.

LOAN GRANTED BY THE PCT UNION TO THE HAGUE UNION

42. Discussions were based on document PCT/A/43/6.

43. The Secretariat, in introducing document PCT/A/43/6, recalled that, in 2008, the PCT Union Assembly had authorized the granting of a loan to the Hague Union of an amount of 3 million Swiss francs to cover the share of the Hague Union in the financing of an IT modernization program. The purpose of the present document was to inform the Assembly that, earlier during the day, the Madrid Union Assembly had decided that the Madrid Union should assume the financing of the Hague Union's contributions to the IT modernization project, rather than the PCT Union. Consequently, the loan would no longer be "on the PCT's books".

44. The Assembly noted the contents of document PCT/A/43/6.

[Annex follows]

AMENDMENTS OF THE PCT REGULATIONS TO
ENTER INTO FORCE ON JANUARY 1, 2013

TABLE OF CONTENTS

Rule 4 The Request (Contents).....	2
4.1 to 4.14 <i>bis</i> [No change].....	2
4.15 <i>Signature</i>	2
4.16 to 4.19 [No change].....	2
Rule 51 <i>bis</i> Certain National Requirements Allowed under Article 27	3
51 <i>bis</i> .1 <i>Certain National Requirements Allowed</i>	3
51 <i>bis</i> .2 <i>Certain Circumstances in Which Documents or Evidence May Not Be Required</i> ...	3
51 <i>bis</i> .3 [No change].....	4
Rule 53 The Demand	5
53.1 to 53.7 [No change].....	5
53.8 <i>Signature</i>	5
53.9 [No change].....	5
Rule 90 <i>bis</i> Withdrawals.....	6
90 <i>bis</i> .1 to 90 <i>bis</i> .4 [No change]	6
90 <i>bis</i> .5 <i>Signature</i>	6
90 <i>bis</i> .6 and 90 <i>bis</i> .7 [No change]	6

Rule 4

The Request (Contents)

4.1 to 4.14*bis* [No change]

4.15 *Signature*

The request shall be signed by the applicant or, if there is more than one applicant, by all of them.

4.16 to 4.19 [No change]

Rule 51bis

Certain National Requirements Allowed under Article 27

51bis.1 Certain National Requirements Allowed

(a) Subject to Rule 51bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

(i) to (iii) [no change]

(iv) where the international application designates a State whose national law requires, on October 9, 2012, the furnishing of an oath or declaration of inventorship, any document containing an oath or declaration of inventorship,

(v) to (vii) [no change]

(b) to (f) [No change]

51bis.2 Certain Circumstances in Which Documents or Evidence May Not Be Required

The designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:

(i) relating to the identity of the inventor (Rule 51bis.1(a)(i)) (other than a document containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request or if a declaration as to the identity of the inventor, in accordance with Rule 4.17(i), is contained in the request or is submitted directly to the designated Office;

[Rule 51bis.2, continued]

(ii) [no change]

(iii) relating to the applicant's entitlement, as at the international filing date, to claim priority of an earlier application (Rule 51bis.1(a)(iii)), if a declaration as to that matter, in accordance with Rule 4.17(iii), is contained in the request or is submitted directly to the designated Office;

(iv) containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if a declaration of inventorship, in accordance with Rule 4.17(iv), is contained in the request or is submitted directly to the designated Office.

51bis.3 [No change]

Rule 53

The Demand

53.1 to 53.7 [No change]

53.8 *Signature*

The demand shall be signed by the applicant or, if there is more than one applicant, by all applicants making the demand.

53.9 [No change]

Rule 90bis
Withdrawals

90bis.1 to 90bis.4 [No change]

90bis.5 *Signature*

Any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 shall be signed by the applicant or, if there are two or more applicants, by all of them. An applicant who is considered to be the common representative under Rule 90.2(b) shall not be entitled to sign such a notice on behalf of the other applicants.

90bis.6 and 90bis.7 [No change]

[End of Annex and of document]