



PCT/A/51/4
ORIGINAL: ENGLISH
DATE: DECEMBER 13, 2019

International Patent Cooperation Union (PCT Union)

Assembly

**Fifty-First (22nd Ordinary) Session
Geneva, September 30 to October 9, 2019**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items from the Consolidated Agenda (document A/59/1): 1, 2, 3, 4, 5, 6, 8, 11(ii), 13, 14, 23, 32 and 33.
2. The reports on the said items, with the exception of item 23, are contained in the -General Report (document A/59/14).
3. The report on item 23 is contained in the present document.
4. Mr. Sandris Laganovskis (Latvia) was elected Chair of the Assembly; Mr. Abdulaziz Mohammed Alswailem (Saudi Arabia), Ms. Grace Issahaque (Ghana) (period 2019-2020) and Mr. Shen Changyu (China) (period 2020-2021) were elected Vice-Chairs.

ITEM 23 OF THE CONSOLIDATED AGENDA

PCT SYSTEM

5. The Chair welcomed the accession of Samoa to the PCT Union following the deposit of its instrument of accession on October 2, 2019, bringing the number of PCT Contracting States to 153. The Chair also wished the Intellectual Property Office of the Philippines success in its operations as an International Searching and Preliminary Examining Authority that had started since the previous session of the Assembly in October 2018.

Report on the PCT Working Group

6. Discussions were based on document PCT/A/51/1.

7. The Secretariat introduced the document, which set out a report of the twelfth session of the PCT Working Group. The session had a full agenda, with 25 agenda items and 23 working documents. This demonstrated the continued interest in the development of the PCT System as the central pillar of the international patent system to bring about further improvements for the benefit of Offices and users. A separate document (document PCT/A/51/2), setting out changes to the PCT Regulations approved by the Working Group, had been submitted to the Assembly for decision. The Working Group had also considered the criteria for certain fee reductions that the Assembly was required to review periodically, and a separate document (document PCT/A/51/3) had been submitted to the Assembly for decision on this matter. The Summary by the Chair attached to the document provided an overview of all items discussed during the session.

8. The Delegation of Colombia stated its support for the convening of a PCT Working Group between the present session of the Assembly and that in autumn 2020, and for the same financial assistance that had been made available in previous sessions of the Working Group to be offered again to enable participation of more delegations. The Delegation also believed it to be appropriate to adopt the proposed modifications to the PCT concerning safeguards in the case of outages that might affect Offices, correction or addition of indications in the request under Rule 4.11, erroneously-filed elements and parts of an international application, and transfer of PCT fees. Finally, the Delegation expressed support for maintaining the criteria for establishing the lists of States whose nationals and residents were eligible for reductions of PCT fees. The Delegation added that the data presented to the PCT Working Group showed the importance of applying fee reductions to natural persons resident in those countries benefitting from such reductions, given the reduction in numbers of international applications from countries where these fee reductions had ceased to apply.

9. The Delegation of the Russian Federation noted the document, which reflected questions concerning the functioning of the PCT System, and expressed appreciation for the activities of the International Bureau on PCT-related issues. In particular, the Delegation noted the online services provided to applicants and Offices. The Federal Service for Intellectual Property (ROSPATENT), which acted as a receiving Office, an International Searching Authority and an International Preliminary Examining Authority, used WIPO and PCT online services, for example, in the exchange of documents between Offices. The Delegation noted that the number of Russian applicants using ePCT was increasing. It further supported the projects to ensure effective use of the PCT System in the international phase and for setting up services for the translation of documents used in the national phase and hoped that this work would be continued. The Delegation expressed gratitude to the International Bureau for its constructive work towards seeking a compromise decision for introducing reductions of PCT fees for universities and research and scientific institutions in developing and least developed countries (LDCs), and hoped that this proposal could gain the support needed to be adopted.

Finally, the Delegation stated that it had no objection to the amendments to the Regulations proposed for adoption at the session.

10. The Assembly of the PCT Union:

- (i) took note of the "Report on the PCT Working Group" (document PCT/A/51/1); and
- (ii) approved the convening of a session of the PCT Working Group, as set out in paragraph 4 of that document.

Proposed Amendments to the PCT Regulations

11. Discussions were based on document PCT/A/51/2.

12. The Secretariat introduced the document, which set out proposed amendments to the PCT Regulations. The PCT Working Group had discussed these amendments and had unanimously agreed to recommend that this Assembly should adopt the amendments as proposed. The amendments fell into five groups. Annex I of the document set out provisions concerning safeguards in case of outages affecting Offices, based on a proposal originally submitted by the European Patent Office to allow Offices to simplify the process of excusing failures to meet certain time limits due to outages of electronic systems. Annex II set out provisions concerning correction or addition of indications in the request under Rule 4.11, based on a proposal originally submitted by the United States of America to allow correction of errors or omissions in indications of the type of protection to be sought in the national phase. Annex III set out provisions concerning erroneously-filed elements and parts of the international application. These amendments were aimed at aligning the practices of receiving Offices and designated or elected Offices in the special case where an applicant had erroneously filed a wrong element or part of the international application. In addition, paragraph 7 of the document set out two proposed Understandings by the Assembly aimed at further improving the consistency of application by Offices of the Regulations as amended. Annex IV set out provisions concerning the transfer of PCT Fees. These were enabling provisions, allowing for Administrative Instructions to be made, setting out consistent procedures on transferring fees from one Office to another *via* the International Bureau. This would formalize the "netting pilot" that many Offices had been participating in and had welcomed. The Secretariat emphasized that these Rules would assist Offices that wished to use the new arrangement, but did not provide new obligations on Offices that faced legal or administrative barriers to adopting that approach. Annex V set out provisions concerning availability of the file held by the International Preliminary Examining Authority, based on a proposal originally submitted by Singapore to allow greater transparency by permitting more documents related to the international preliminary examination procedure to be made available to the public. The document proposed that all of the proposed amendments to the Regulations should enter into force on July 1, 2020, and be subject to transitional provisions set out in paragraph 6 of the document, aimed at providing the desired effects as soon as practical, while minimizing the administrative burdens for national Offices.

13. The Representative of the International Federation of Intellectual Property Attorneys (FICPI) stated that FICPI believed that applicants should be permitted to correct very formal and obvious mistakes without losing substantive rights. In this regard, FICPI supported the objectives of the Patent Law Treaty (PLT) and welcomed the introduction of PLT-type provisions into the PCT. Clearly, those provisions that had been added to the PCT had been intended to serve the same purpose as the PLT, namely to make the patent system more user-friendly while preserving a proper balance between the interests of the various stakeholders. For FICPI, this extended to the substitution of erroneously-filed elements or parts thereof with the correct element or part as contained wholly in one or more priority applications, provided that the

requirements of Rule 20 were met, with certain safeguards, as indicated by FICPI at the workshop organized by the International Bureau in June 2018. The Representative expressed concern that the proposed amendments to the PCT Regulations that the PCT Working Group had recommended to be submitted to be considered at this session of the Assembly would not achieve the intended purpose of aligning practices with respect to the incorporation by reference of elements or parts to be found in a priority application. Instead, the proposals would introduce further uncertainty and divergence of practices within Offices. The increased use of ePCT increased the risk for incorrect documents to be uploaded from a computer. Accordingly, there was a need for a remedial provision. Of particular concern was the situation where the incorrect element was a different kind of document, for example, a set of claims instead of a description, or was clearly related to a different invention, possibly for a different client. In such circumstances, there would still be uncertainty as to whether the “element” of the subject application was missing or erroneously filed, even with the proposed rule changes. In the business world, if such a document had been inadvertently sent to a party, it would be either returned by that party without keeping a copy, or all copies would be destroyed by the party. FICPI believed that it was appropriate for the International Bureau or a receiving Office to take similar action and therefore did not support a process that would result in retaining such an incorrect document in WIPO’s database. In the view of FICPI, neither publishing the document marked “erroneously filed” as proposed, nor retaining the document unpublished in the WIPO file following a request under Rule 48.2(I), served the interests of any stakeholders. Therefore, FICPI believed it was appropriate for the International Bureau and the PCT Working Group to resolve this problem by introducing additional or alternative rule changes into the PCT Regulations to achieve a better alignment between the various PCT authorities with respect to the incorporation by reference of elements or parts to be found in a priority application. The incorrect document should be totally removed from the application, possibly by introducing a new Rule to cover such removal.

14. The Secretariat, in response to the comments by Representative of FICPI, stated that the International Bureau believed that the Rules proposed for adoption were a step forward for applicants in mitigating the problems caused by mistakes in the filing process. The Secretariat acknowledged that the proposals did not go as far as FICPI might have liked. However, it appeared clear in discussions during the PCT Working Group that Member States had not been willing to see any matter removed entirely from the file without also changing the international filing date to reflect the timing of the relevant change. Consequently, the Secretariat continued to recommend that the amendments be adopted as proposed. The Secretariat nevertheless encouraged user groups to continue to discuss their concerns about this type of issue with their respective national and regional Offices. If Member States considered that there was a realistic opportunity for further improving these safeguard provisions in the future, the International Bureau would be pleased to introduce further proposals to the PCT Working Group. In the meantime, the International Bureau would make clear in the PCT Applicant’s Guide the means by which errors in filing could best be mitigated, but also emphasized the importance of taking the utmost care to select the correct documents when filing an international application as some mistakes could not be corrected.

15. The Representative of Knowledge Ecology International (KEI) suggested considering different areas where more information within the PCT System could be made available in patent databases, even if this was on a voluntary basis. For example, information about licenses connected to a patent, information on prior art searches in the various jurisdictions where the patent application had been filed, or the international nonproprietary name for medical treatments related to the patent could be more visible to the public.

16. The Secretariat, in response to the comments by the Representative of KEI, pointed out that some of the information referred to was already made publicly available from WIPO databases. The Secretariat expressed willingness to discuss with KEI or other stakeholders how applicants and the general public could be made more aware of the options available to

provide or access such information, as well as how to improve those options in future, whether administratively, or by bringing new proposals to the PCT Working Group to improve the Regulations further in a way that would make the PCT System more useful for all stakeholders.

17. The Assembly of the PCT Union:

(i) adopted the proposed amendments to the Regulations under the PCT set out in Annexes I to V to document PCT/A/51/2, and the entry into force and transitional arrangements set out in paragraph 6 of the same document; and

(ii) adopted the Understanding set out in paragraph 7 of document PCT/A/51/2.

Review of the Criteria for PCT Fee Reductions for Applicants from Certain Countries

18. Discussions were based on document PCT/A/51/3.

19. The Secretariat introduced the document by explaining that at its forty-sixth session back in 2014, the Assembly had adopted amendments to the Schedule of Fees concerning the criteria for determining eligibility for reductions in certain PCT fees. The Schedule of Fees so amended required the Assembly to review the criteria at least every five years. The document provided information concerning the criteria for determining eligibility for fee reductions under item 5 of the Schedule of Fees, the number of applications benefiting from those fee reductions and the number of applications made by different classes of applicant before and after the changes to the lists of eligible States came into effect from July 1, 2015. The PCT Working Group had discussed the information shown in the document and had unanimously recommended to the Assembly to maintain the criteria in their current form and to review them again in five years' time. The document invited the Assembly to review the criteria and follow the recommendation by the Working Group.

20. The Assembly of the PCT Union:

(i) decided, having reviewed the criteria set out in item 5 of the PCT Schedule of Fees, that those criteria be maintained; and

(ii) decided that those criteria be reviewed again by the Assembly in five years' time, as required by that Schedule.

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