

## **Patent Cooperation Treaty (PCT) Working Group**

**Twelfth Session  
Geneva, June 11 to 14, 2019**

### **DRAFT REPORT**

*prepared by the Secretariat*

1. The Patent Cooperation Treaty Working Group held its twelfth session in Geneva from June 11 to 14, 2019.
2. The following members of the Working Group were represented at the session: (i) the following Member States of the International Patent Cooperation Union (PCT Union): Algeria, Australia, Austria, Azerbaijan, Barbados, Belarus, Brazil, Canada, Chile, China, Colombia, Czech Republic, Democratic People's Republic of Korea, Denmark, El Salvador, Finland, France, Germany, Guatemala, Hungary, India, Indonesia, Iran (Islamic Republic of), Israel, Italy, Japan, Kuwait, Malaysia, Mexico, Mongolia, Nigeria, Norway, New Zealand, Oman, Philippines, Poland, Portugal, Republic of Korea, Romania, Russian Federation, Saudi Arabia, Senegal, Serbia, Singapore, Slovakia, South Africa, Spain, Sri Lanka, Sweden, Switzerland, Tajikistan, Thailand, Turkey, Uganda, Ukraine, United Arab Emirates, United Kingdom, United States of America, Viet Nam, Zimbabwe (60); and (ii) the following intergovernmental organizations: the European Patent Office (EPO), the Nordic Patent Institute (NPI), the Visegrad Patent Institute (VPI) (3).
3. The following Member States of the International Union for the Protection of Industrial Property (Paris Union) participated in the session as an observer: Guyana, Jamaica, Pakistan (3).
4. The following intergovernmental organizations were represented by observers: African Intellectual Property Organization (OAPI), Eurasian Patent Organization (EAPO), Patent Office of the Cooperation Council for the Arab States of the Gulf (GCC Patent Office) (3).

5. The following international non-governmental organizations were represented by observers: Asian Patent Attorneys Association (APAA), Institute of Professional Representatives Before the European Patent Office (epi), International Association for the Protection of Intellectual Property (AIPPI), International Federation of Intellectual Property Attorneys (FICPI), International Institute for Intellectual Property Management (I3PM), Union of European Practitioners in Industrial Property (UNION) (6).

6. The following national non-governmental organizations were represented by observers: Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA) (2)

7. The list of participants is contained in Annex II.

### **OPENING OF THE SESSION**

8. Mr. Claus Matthes, Senior Director, PCT Legal and International Affairs Department, Patents and Technology Sector, opened the session and welcomed the participants on behalf of the Director General of WIPO. Mr. Michael Richardson (WIPO) acted as Secretary to the Working Group.

9. Mr. Matthes reported on the performance of the PCT in 2018. In its fortieth year of operations, the PCT had another very successful year, confirming its role as the central node of the international patent system and the main choice of innovators when seeking global patent protection. In 2018, the number of international applications rose by 3.9 per cent to 253,000. This was the ninth consecutive year of growth and the first time that filings had exceeded more than a quarter of a million applications in a single year. In fact, more applications were filed in 2018 than the total filings over the first 15 years of the PCT. Mr. Matthes congratulated the Intellectual Property Office of the Philippines, which had started operations as the twenty-third International Searching and Preliminary Examining Authority on May 20, 2019 and wished it well in this function. In terms of key figures for 2018, in addition to the rise in the total number of international applications filed, PCT applications were filed in a record number of 127 different countries, one more than in 2017. There were also more than 54,000 different applicants, an increase of 3.8 per cent over the previous year. In addition, more women were involved as inventors with 32.6 per cent of all international applications naming at least one woman as an inventor and women now represented 17.1 per cent of the named inventors in PCT applications. The top country of origin of applicants continued to be the United States of America with about 56,142 applications, followed by applicants from China, who filed 9.1 per cent more applications than in 2017, giving a total of 53,345, a significant but lower growth rate than in recent years. Applicants from Japan came in third with 49,702 international applications, nearly two and half times more than applications filed by applicants from Germany, in fourth place with 19,883 applicants. In terms of national phase entries, after a slight decline in 2016, numbers picked up again, reaching an estimated 630,000 national phase entries in 2017, up by 2.3 per cent. The “market share” of PCT national phase entries in worldwide non-resident patent filings (compared to direct Paris Convention filings) increased by one percentage point to 57.3 per cent in 2017, which is very similar to the market share the PCT held two years earlier in 2015, following a drop in 2016.

10. Mr. Matthes continued by referring to the full agenda of the session, which, as in previous years, gave positive indicator for the health of the system and its importance to stakeholders. Several documents set out proposals for changes to the legal framework aimed at providing further safeguards for applicants, such as in the case of erroneously filed elements and parts (that the Working Group had been discussing for the past seven years), the unavailability of electronic means of communications offered by Offices and when errors were made in the request form. A number of agenda items related to PCT fees. Except for the document on the netting of PCT fees, the other agenda items relating to fees all dealt with the important issue of “cost and accessibility” to the PCT System by certain groups of applicants. First, there was the issue of an update of the lists of States whose applicants were eligible for fee reductions under

the Schedule of Fees, as well as the review of the criteria to grant such fee reductions, as required to be carried out every five years. Second, the Working Group was invited to continue its discussions on the proposal by Brazil to offer fee reductions for universities of both developing and developed countries, based on two documents prepared by the International Bureau. The first of these documents summarized the feedback received in response to a Circular that the International Bureau had issued to consult on issues related to the proposal by Brazil. The second of these documents addressed some of the implementation issues, including a concrete proposal for a possible amendment of the PCT Schedule of Fees, should there be agreement to introduce fee reductions for universities. A number of other agenda items were broadly linked by the common desire to enhance the cooperation aim of the Treaty that formed the basis of the Patent Cooperation Treaty. These items included the proposal by Singapore to improve access by national Offices to certain documents held in the file of the International Preliminary Examining Authority, for the benefit of examiners in national phase proceedings, and the proposal by India to broaden the choices for applicants as far as competent International Searching and Preliminary Examining Authorities were concerned. Other agenda items, such as the document on PCT online services and the document on electronic communications between applicants and Offices, focused on how we could use the digital environment to further the cooperation between Offices, the International Bureau and users of the PCT system. Finally, there were several agenda items relating to technical assistance for applicants and Offices from developing and least developed countries that together made up the majority of PCT Contracting States: an update on technical assistance activities carried out in 2018 and 2019 to date; an introduction of the Inventor Assistance Program (by the Patent Law Division at the International Bureau); and two items relating to the training of examiners.

#### **ELECTION OF A CHAIR AND TWO VICE-CHAIRS**

11. The Working Group unanimously elected Mr. Victor Portelli (Australia) as Chair and Mr. Reza Dehghani (Islamic Republic of Iran) as Vice-Chair for the session. There were no nominations for a second Vice-Chair.

#### **ADOPTION OF THE AGENDA**

12. The Working Group adopted the revised draft agenda as proposed in document PCT/WG/12/1 Prov. 2.

#### **PCT STATISTICS**

13. The Working Group noted a presentation by the International Bureau on the most recent PCT statistics<sup>1</sup>.

#### **MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT ON THE TWENTY-SIXTH SESSION**

14. Discussions were based on document PCT/WG/12/2.

15. The Delegation of the United Kingdom welcomed the continuing discussions by the Quality Subgroup of the Meeting of International Authorities; as an effective way of raising quality, Offices needed to share information and best practices in quality management. While IT constraints prevented the United Kingdom Intellectual Property Office (UKIPO) from sharing its search strategies, the Delegation recognized the importance of this practice and was keen to participate in any future survey on this matter. Moreover, the Delegation believed that the opportunity for national Offices to provide feedback on work in the international phase was key to raising quality. In this regard, the UKIPO had started a small scale pilot with IP Australia and the Canadian Intellectual Property Office to provide feedback as a designated Office on

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<sup>1</sup> The presentation is available on the WIPO website at:  
[https://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=438415](https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=438415).

international search reports and it invited other International Searching Authorities to participate in the pilot. The Delegation planned to report on the result of the pilot to future sessions of the Working Group.

16. The Working Group noted the report of the twenty-sixth session of the Meeting of International Authorities, based on the Summary by the Chair of that session contained in document PCT/MIA/26/13 and reproduced in the Annex to document PCT/WG/12/2.

### **PCT ONLINE SERVICES**

17. Discussions were based on document PCT/WG/12/10.

18. The Delegation of the Nordic Patent Institute (NPI) noted the impressive reliability of the ePCT system and stressed the importance to smaller International Authorities of the features that were available for the creation of reports within ePCT. The Delegation highlighted work required to address the functionality of these reports as outlined in paragraph 19 of the document, including the automatic transfer of family member data into the reports to allow for the reuse of equivalent data. The NPI extended its offer to continue to work with the International Bureau to assist in the development of these features, in view that they would be beneficial to other International Authorities and thus would assist in the functioning of the PCT System as a whole.

19. The Delegation of Israel welcomed the development of PCT online services and thanked the International Bureau for its efforts to improve the system. Regarding ePCT-Filing, the Israel Patent Office (ILPO) advised that it used the ePCT system regularly for its work as receiving Office and International Searching and Preliminary Examining Authority for viewing and downloading documents. With effect from July 2016, the ILPO had accepted the filing of international applications using ePCT-Filing, in addition to PCT-SAFE. However, about 65 per cent of applications were still filed electronically at the ILPO as receiving Office using PCT-SAFE, with the remaining 35 per cent being filed using ePCT. The Delegation therefore advised that although ILPO permitted ePCT-Filing as a receiving Office, it hoped that the International Bureau would continue to maintain PCT-SAFE as an alternative means of filing. Furthermore, the ILPO regularly used eSearchCopy as a receiving Office and as an International Searching Authority (ISA), particularly for receiving search copies of international applications filed at the United States Patent and Trademark Office and the International Bureau in their capacities as receiving Offices. Regarding the WIPO Digital Access Service (DAS), the ILPO started operating as a depositing and accessing Office on May 1, 2019 for both Paris-route and PCT applications. The ILPO used the PCT Electronic Data Interchange (PCT-EDI) service daily for document exchange with International Bureau and had been a providing Office and accessing Office in the WIPO CASE (Centralized Access to Search and Examination) system since November 2014. In respect of future work on PCT online services, the Delegation requested priority to be given to the development of web services for the exchange of information between the IP Offices and the International Bureau.

20. The Delegation of the United States of America supported the direction and priorities laid out in the document and indicated its intention to participate and support the International Bureau in PCT online services to the extent resources permitted. Regarding DAS, the Delegation encouraged all Offices to migrate to using the DAS system, as doing so would allow for a single exchange system that would eliminate the need for multiple bilateral agreements and parallel transmission systems for priority documents between the Offices. Concerning WIPO CASE, the Delegation likewise encouraged all Offices to participate at least to the extent of becoming a providing Office to make as much prior art as possible available to Offices for their search and examination. Finally, the Delegation expressed significant concerns about the possibility of decommissioning PCT-SAFE as users in the United States of America relied heavily on PCT-SAFE and believed that the International Bureau needed to continue this service at least in the short term.

21. The Delegation of Germany expressed satisfaction on the progress and results achieved in the area of PCT online services. The Delegation advised that in respect of electronic filing of PCT applications, the German Patent and Trademark Office (DPMA) provided three different possibilities: PCT-SAFE, the EPO Online Filing client server and its own client server-based filing software, DPMAdirekt, through which it received 90 per cent of electronically-filed PCT applications. The DPMA was therefore interested in exploring the technical possibilities of integrating ePCT filing into DPMAdirekt along the lines mentioned in paragraph 7 of the document. Regarding the topic of DOCX filing, the Delegation inquired whether there were plans to revise Annex F of the Administrative Instructions to allow for the use of XML according to WIPO Standard ST.96, noting that WIPO Standard ST.36, on which Annex F was currently based, had not been updated for some years. Moreover, development of XML resources within the Committee on WIPO Standards (CWS) focused on ST.96. Concluding, the Delegation expressed concern at the number of DOCX converters under development. From a technical perspective, different converters could lead to diverging results and uncertainty for both Offices and applicants. The Delegation therefore suggested that it would be desirable to develop a single DOCX convertor hosted by WIPO for use by all Offices.

22. The Delegation of Japan welcomed the progress made and supported efforts towards the further development PCT online services. In particular, the eSearchCopy system had enhanced the efficiency of operations at the Japan Patent Office and the Delegation encouraged more participation in the eSearchCopy system.

23. The Delegation of Brazil expressed appreciation of the PCT online services provided by the International Bureau and stated that the use of electronic services was crucial for increasing productivity in Offices and providing quality service to applicants. The National Institute of Industrial Property of Brazil (INPI-Br) had been using ePCT since 2014 with great acceptance by applicants. By the end of 2018, approximately 70 per cent of international applications and 85 per cent of demands for international preliminary examination were submitted in Brazil through ePCT. The Delegation supported continued work on ePCT related to improvements of functionality for Offices, including potential use in national phase entry. The Delegation observed that the eSearchCopy system was useful as it facilitated the sending and receiving of search copies. INPI-Br participated in the eSearchCopy system as a receiving Office, sending search copies to both the Swedish Patent and Registration Office and the Austrian Patent Office and as an ISA for receiving search copies from the receiving Offices of Peru and Colombia. Since February 1, 2018, INPI-Br had also started using eSearchCopy as a receiving Office for transmitting search copies to the European Patent Office. INPI-Br had begun participating in DAS in December 2017 with positive results and the Delegation encouraged other Offices to participate to facilitate the transmission of priority documents between Offices. Regarding WIPO CASE, INPI-Br intended to join as an accessing Office and was discussing this matter with the International Bureau. Furthermore, the Delegation recognized the importance of XML in the PCT System, in particular with regard to the implementation of ST.26 for sequence listings, a priority at INPI-Br.

24. The Delegation of India supported and appreciated the recent initiatives and efforts with respect to PCT online services. India fully supported the future goals to move away from transferring information equivalent to traditional paper forms towards transferring application bodies and correspondence as directly reusable data. More than 95 per cent of PCT applications were being filed at the Indian Patent Office using ePCT. The Delegation appreciated the improvements made in the ePCT collaboration mechanism for signatures by applicants who did not have ePCT accounts as this made access PCT online services easier. As a receiving Office, the Indian Patent Office was using eSearchCopy to transmit search copies electronically to all seven ISAs that it specified for international search, except for the United States Patent and Trademark Office. The Indian Patent Office was also using PCT-EDI as well as ePCT to transmit documents to the International Bureau. As a receiving Office, the Indian Patent Office had been participating in the netting pilot with the European Patent Office

as an ISA from April 2018 and with the Austrian Patent Office as an ISA from August 2018. The Indian Patent Office became an accessing Office in WIPO CASE in 2017 and a providing Office as of January 2018. With respect to DAS, the Indian Patent Office was one among the 22 participating Offices, having started sending priority documents through this service from May 2018. Regarding the current priorities, the Delegation agreed with the use of XML as a major format for filing applications, as well as producing international search reports and written opinions, but emphasized that the International Bureau should propose a standard format for filing applications in XML. Moreover, the Indian Patent Office had confirmed its readiness to transmit reports and written opinions in XML format to the International Bureau. Finally, the Delegation welcomed the proposed next steps in the improvement of PCT online services mentioned in the document.

25. The Delegation of Canada supported the initiatives in the document and encouraged improvements that would result in efficiency and cost savings. The Canadian Intellectual Property Office (CIPO) would be encouraging applicants to move away from PCT-SAFE in favor of ePCT with the intention for CIPO to decommission PCT-SAFE ahead of WIPO's timetable. For many years, Canadian applicants had had the option to pre-create files for electronic filing to either CIPO or to the receiving Office of the International Bureau using ePCT, which had been functioning well. Compliance with Rule 95 requiring transmission of national phase entry to the International Bureau was a high priority for CIPO in 2019-2020. Finally, CIPO intended to function as at least a DAS accessing Office in late 2019 once the Patent Law Treaty (PLT) had been implemented in Canada.

26. The Delegation of Chile stated that approximately 80 per cent of international applications at the National Institute of Industrial Property of Chile (INAPI Chile) in 2018 were filed using ePCT and thanked the International Bureau for its support and efforts to encourage other Offices across Latin America to use ePCT as well. INAPI Chile was participating in eSearchCopy and WIPO CASE, which was useful for accessing other documents.

27. The Delegation of the United Kingdom advised that the United Kingdom Intellectual Property Office (UKIPO) was in the process of reviewing its receiving Office functions, giving due consideration to implementing ePCT and the eSearchCopy service during the forthcoming year. The Delegation was pleased to hear the increase in number of Offices participating in WIPO DAS and encouraged other Offices to join in a bid to reduce the amount of paper priority documents being transferred across the world. The Delegation emphasized the importance of the exchange of structured data in XML format as it improved the quality and consistency of data and provided a rich source of data to be used in search systems. The availability of search reports, written opinions and related documents as envisaged in paragraph 19(c) of the document would reduce the need for rekeying of data, improve quality and enable more efficient generation of reports and processing of applications. In view of these benefits, the Delegation was particularly interested in progressing work on XML filing, more machine-to-machine interactions and federated authentication.

28. The Delegation of China observed the continual improvement of PCT online services and supported the efforts of the International Bureau to improve efficiency and data utilization.

29. The Delegation of Australia stated that IP Australia was investigating the use of ePCT in its receiving Office functionality. The Delegation supported the priorities for further development of online services. In particular, the Delegation emphasized the importance of the ongoing development of WIPO CASE, as identified in paragraph 13 of the document, and encouraged and supported Offices to make efforts to join the system, particularly as a providing Office. In this regard, the Delegation highlighted the importance of having structured text data to enrich the data available through the WIPO CASE platform and ensuring that the system was also timely and efficient in the future.

30. The Delegation of Sweden requested that, regarding international reports, a general user guide be made available to specify how to construct XML documents in local systems outside of the ePCT system.

31. The Delegation of the Republic of Korea expressed appreciation of the collaborative effort of the International Bureau to develop improved more efficient IT services. In particular, the interconnection between the national application system at the Korean Intellectual Property Office (KIPO) and ePCT-Filing in place, could be a potential model in the longer term for many Offices, as discussed in paragraph 8 of the document. Since establishing this interconnection in January 2019, the use of ePCT had increased and KIPO expected this to continue.

32. The Delegation of Spain informed the Working Group that the Spanish Patent and Trademark Office (SPTO) was participating in WIPO CASE as a depositing Office and that its registry was online, making available an additional 160,000 patents in Spanish. In relation to eSearchCopy, the SPTO was expanding its usage of the system, liaising with the PCT receiving Offices in Latin American countries that had nominated the SPTO as a competent ISA.

33. The Delegation of Portugal expressed satisfaction with PCT online services, especially ePCT. The Portuguese Institute of Industrial Property (INPI Portugal) had been using ePCT since 2015 and it now received all online filings as a receiving Office through ePCT. INPI Portugal had joined WIPO CASE as an accessing Office in 2017 and had been using eSearchCopy to transfer search copies to the European Patent Office since 2018, both of which were important projects for the future. In addition, the Delegation stressed the importance of further work towards the full processing of color drawings in the international phase, which it believed would benefit both applicants and Offices, pointing out that INPI Portugal permitted color drawings in national applications.

34. The Delegation of the European Patent Office (EPO) advised that it had joined DAS on November 1, 2018 for European applications and had extended its participation to international applications in April 2019. The number of receiving Offices transferring search copies to the EPO through eSearchCopy had risen to around 35, with a further 10 receiving Offices expected to join in the near future. The Delegation further stated the intention of the EPO to complete the migration of all receiving Offices for which it was competent to act as ISA to the eSearchCopy system by the end of 2020. In relation to WIPO CASE, the EPO encouraged more Offices acting as International Searching Authorities to join the service, adding that the comprehensiveness of file wrapper data was key for Offices and it was essential that providing Offices made sure that this was complete and available 24/7. The Delegation pointed out that filings of international applications in XML remained limited in Europe. The EPO was continuing to work with the International Bureau to find technical and practical solutions to allow for the acceptance of DOCX as a valid filing format under the PCT to make XML filing more straightforward for applicants. By extracting XML from DOCX filings, Offices would avoid the costs of PDF processing, which would render patent grant processes more agile, including for publication of patent applications. Furthermore, the EPO supported the increased use of XML in the establishment of search reports and written opinions. Finally, the Delegation expressed support for the wider adoption of near real time machine-to-machine web services that could also be integrated into applicants' patent management systems and for the increased use of ePCT messaging as a solution to avoid paper-based surface mail delays.

35. The Representative of the Asian Patent Attorneys Association (APAA) thanked the International Bureau for its efforts in improving the ease and reliability of its electronic communications with the International Bureau and receiving Offices. The APAA intended to discuss the matters in the document with its membership and report back to the International Bureau outside of the Working Group sessions. In this regard, any surveys of users could have specific questions on the issues to allow the International Bureau to have consistent and easily digestible responses rather than receiving different responses from different observer groups.

36. The Representative of the Japan Patent Attorneys Association (JPAA) believed that more XML data would be beneficial for applicants, as well as opening opportunities for machine translation and artificial intelligence processing. While this facilitated patent processing, it was important that PCT online systems were developed to be secure and prevent leakage of confidential information in the event of an accident.

37. The Chair observed that the Secretariat had taken note of the specific issues to address with individual delegations. The tools that the International Bureau had provided had stimulated use and thought by Offices and applicants. As the expectations of users continued to rise, further development would need to be undertaken to continue to match those expectations.

38. The Working Group noted the contents of document PCT/WG/12/10.

## **ELECTRONIC COMMUNICATION BETWEEN OFFICES AND APPLICANTS IN THE PCT**

39. Discussions were based on document PCT/WG/12/23.

40. The Delegation of the European Patent Office (EPO) acknowledged the challenges in the document to ensure effective means available for communication at all times with appropriate safeguards in place and saw much potential in using the ePCT notifications as an official means for communicating documents from Offices. The EPO already offered a mailbox electronic notification system to subscribed users and the proposed new way to communicate between Offices and applicants would address the challenges the EPO faced with regard to surface mail when sending communications, particularly outside of Europe. The proposed notification system would have advantages in reducing delays, providing greater certainty of delivery and ensuring traceability, noting that it would be possible to register successful receipt of documents. Integration of notifications with patent management systems of applicants using web services would be an important step in the right direction to make this practical.

41. The Delegation of France noted that the International Bureau had abandoned support for fax services for the Madrid and Hague Systems. During consultations for the Hague System, users in France had been in favor of giving up fax services. Nonetheless, the users believed that it was necessary to introduce an effective complementary contingency mechanism for transmissions and maintain all transmission systems in operation for a transitional period. Furthermore, while the Delegation advised that while the fax service had not been generally useable for the filing of applications at the National Institute of Industrial Property (INPI) in France since November 19, 2018, fax services remained important for transmissions in case of outages, with the applicant being required to resubmit the documents within two days to rectify the situation. The Delegation did not foresee a change to this practice in France in the immediate future.

42. The Delegation of Israel advised that, since the use of fax communication to and from the users of the PCT at the Israel Patent Office (ILPO) had decreased dramatically over the past year, the ILPO had decided to cease supporting facsimile transmissions from June 1, 2019 for PCT purposes. The Delegation accordingly requested the International Bureau to update the PCT Applicant's Guide to remove the fax number. Applicants could send communications to the ILPO's dedicated secure website on an e-mail address.

43. The Representative of the Union of European Practitioners in Industrial Property (UNION-IP) acknowledged the rationale for decommissioning the fax service as a means for communication in the PCT given that Internet-based technology made fax transmission less reliable than previously. Nevertheless, the Representative explained that users were concerned about situations where computer systems had failed rather than Internet outages. In such cases, if an applicant needed to send document to an Office, the most successful workaround remained the fax service, provided fax machines continued to be widely available. The

Representative advised that there was a major concern and believed that it was too early to abandon fax services.

44. The Chair observed that it was necessary to minimize complexity of integrated systems. The use of fax was declining sharply – in many offices, the fax machine was largely forgotten and not used or checked regularly. Maintaining additional services for extremely limited use might cause additional confusion and expense for limited benefit, particularly in view of the fact that much of the main perceived benefit was illusory if the services were, in practice, delivered through the Internet.

45. The Working Group noted that the International Bureau would continue to consult Offices and user groups on the issues set out in document PCT/WG/12/23.

## **INTERNATIONAL APPLICATIONS LINKED TO UNITED NATIONS SECURITY COUNCIL SANCTIONS**

46. Discussions were based on document PCT/WG/12/7.

47. The Delegation of the Democratic People's Republic of Korea stated that it wished to reiterate its position and to remind the Working Group that the Democratic People's Republic of Korea had been rejecting the United Nations Security Council Resolutions against the Democratic People's Republic of Korea, which had neither legal ground, nor impartiality. The Delegation stated that voices to stop the brutal United Nations sanctions against the Democratic People's Republic of Korea were now ever increasing among many other countries of the world. Patents were not themselves materials nor services; rather, they were solely intended to protect the intellectual property of human beings. From this perspective, the Delegation insisted that any recommendation of the United Nations Panel of Experts should not cause a negative impact on the mandate of WIPO for an effective international IP system.

48. The Working Group noted the contents of document PCT/WG/12/7.

## **NETTING**

(A) PROGRESS REPORT: PILOT ON NETTING OF CERTAIN PCT FEES

49. Discussions were based on document PCT/WG/12/19.

50. The Secretariat, in introducing the document, noted that both the survey of Offices and the audit report referred to in the document had been positive, identifying benefits of the pilot for both national Offices and the International Bureau. The International Bureau was looking at options to further improve the arrangements and to find ways of allowing Offices currently unable to participate in the pilot to do so in the future.

51. The Delegation of the European Patent Office (EPO) encouraged other Offices to participate in netting and referred to paragraph 19 of the document giving details of the netting pilot between the EPO, in its capacity as an International Searching Authority (ISA), and the International Bureau. The pilot had been operational since January 1, 2018 and had incorporated the earlier arrangement of transferring search fees from the United States Patent and Trademark Office (USPTO) to the EPO via the International Bureau. Receiving Offices were joining the pilot in a phased rollout. As of June 1, 2019, 32 receiving Offices were participating in the pilot. The aim in the rollout was to have the netting system in place with all receiving Offices for which the EPO was a competent ISA by the end of 2020. The Delegation considered that netting of fees was working well and stated that the extension of the netting system to more Offices would improve the management of the transfer of PCT fees, particularly international filing fees and search fees. In this regard, the Delegation underlined that all Offices needed to participate in netting to have maximum benefit. For an ISA that was competent for many receiving Offices, there would be an additional administrative burden if

some receiving Offices continued to transfer search fees directly to the ISA. Only when all receiving Offices transferred search fees to the International Bureau would the ISA no longer have to manage transfers and receipts of fee payments between multiple Offices and instead have fee transfers to and from the International Bureau only, with a single monthly transaction.

52. The Delegation of Israel supported the general concept of the proposal to introduce a netting structure for the transfer of fees and continued to see benefits in netting to improve cash flow management by the International Bureau and the participating Offices by reducing the risk to exchange rate fluctuations. In view of the necessary modifications to IT systems and in order to synchronize transactions, in the initial stage, the Israel Patent Office (ILPO) had joined the pilot as a receiving Office only. With effect from May 1, 2018, search fees collected by the ILPO, in its capacity as a receiving Office, for the EPO as the ISA, were sent via the International Bureau. With regard to expanding the netting project, since the ILPO had separate bank accounts and accounting systems for patents and for trademarks, the ILPO would not be able to expand the netting process to include all transfers of different funds to and from the International Bureau. Participation by the ILPO in the netting pilot would therefore be limited to PCT fees.

53. The Delegation of Austria expressed satisfaction with the participation of the Austrian Patent Office in the netting pilot, both in its capacity as an ISA and as a receiving Office. The Delegation encouraged more Offices to participate in netting and highlighted the successful example of transfer of fees from the receiving Office of the Companies and Intellectual Property Commission of South Africa.

54. The Delegation of the Russian Federation stated that the Federal Service for Intellectual Property (ROSPATENT) had expressed interest in participating in netting. ROSPATENT had attempted to participate in netting by exploring two possible pilot bilateral agreements, one for international applications filed at ROSPATENT selecting the European Patent Office for international search and the other for international applications filed at the United States Patent and Trademark Office for international search a ROSPATENT. However, complexities in the financial system and the strict regulation of fees as a public sector organization prevented either of these arrangements from being set up. To address these difficulties, the International Bureau had made a further offer to transfer fees in Russian rubles, which ROSPATENT would be discussing with the International Bureau.

55. The Delegation of Norway supported the netting pilot and indicated that the Norwegian Industrial Property Office had been satisfied with its participation in the pilot.

56. The Delegation of Germany, speaking on behalf of Group B, thanked the International Bureau for conducting the pilot and the Offices that were participating in the pilot. Group B was pleased to note that the pilot suggested that netting had a number of benefits, including lower cost for participants and generally streamlined procedures. In turn, this could benefit the overall PCT System and potentially other international registration systems. The Delegation stated that Group B would welcome additional details on plans to mitigate the issues identified in the document, such as training and IT changes at participating receiving Offices.

57. The Delegation of France expressed satisfaction with the participation since 2018 in the pilot of the National Institute of Industrial Property of France. The Delegation was open to discussion to extend netting to other IP systems at WIPO and looked forward to further analysis in this regard. The Delegation also hoped for introducing a basis for netting in the PCT legal framework, which could enable more Offices to participate in the pilot and result in more harmonization in netting arrangements.

58. The Delegation of Canada stated that it did not consider the Canadian Intellectual Property Office (CIPO) to be a suitable Office at this stage for setting up netting arrangements. CIPO was the only competent ISA for international applications filed at the Office and almost all international applications searched by CIPO were either filed there or at the International Bureau in its capacity as a receiving Office. CIPO was, however, interesting in discussing options for netting with the International Bureau.

59. The Delegation of Japan expressed appreciation for the continued efforts of the International Bureau in implementing the netting arrangements for PCT fee translations and was grateful for the efforts of the International Bureau to increase the number of Offices participating in the netting pilot. The Delegation believed that this would increase the benefit of the netting structure, which over time would enable better evaluation of the usefulness of the arrangements. For that purpose, the Delegation supported the continued effort in increasing the number of participating Offices in the pilot and in formalizing the netting arrangements by amending the PCT Regulations.

60. The Delegation of the United Kingdom supported the netting pilot as an active participant and was pleased to hear that the pilot already resulted in financial savings, both to International Bureau and to current participants. The Delegation supported the proposals to provide a legal basis for the transfer of fees within the PCT System, so that all Offices might fully realize the benefits that netting had to offer. For example, as a receiving Office, the United Kingdom Intellectual Property Office had found it more efficient to transfer all PCT fees to one account as opposed to distributing the filing and search fees to two different Offices.

61. The Delegation of Germany indicated that the German Patent and Trademark Office would participate in the netting pilot. However, the participation required changes to several IT systems, which would take some time. First, PCT business processes of the case management system needed to be adapted. Second, new features like the output of the XML file detailing for fee payments had to be implemented in the enterprise resource planning system. Finally, the interface between the case management system and the enterprise resource planning system needed to be enhanced to transfer additional data. These changes could only be implemented during specific deployment periods and needed to be orchestrated with other changes to the relevant IT systems. The German Patent and Trademark Office nevertheless hoped to implement these changes in the coming months to enable active participation in netting by the end of 2020.

62. The Delegation of India stated that the Indian Patent Office was one of the receiving Offices participating in the netting pilot with the European Patent Office since April 1, 2018 and with the Austrian Patent Office since August 1, 2018. The Delegation supported the proposal to create a legal framework by providing a clear basis for transferring fees via the International Bureau, yet allowing the provisions in the Regulations to be flexible to allow updates to the Administrative Instructions as required in the future. The Delegation was also content to use the term “the WIPO Fee Transfer Service” for the netting system, as proposed in paragraph 11 of document PCT/WG/12/20.

63. The Delegation of Azerbaijan stated that the Intellectual Property Agency of the Republic of Azerbaijan had unfortunately not been able to take part in netting, but was performing an internal feasibility study with a view to participating in the future.

64. The Secretariat, in responding to the comments from delegations, considered that netting of fees would provide optimum benefits for many Offices as well as for the International Bureau. However, it was recognized that this was not possible for all Offices and participation in the fee transfer process was possible without netting of fees. The proposed change in terminology from “Netting System” to “Fee Transfer Service” would help to clarify this. The Secretariat further indicated that the International Bureau would make efforts to engage with national Offices to

find solutions to problems with participation, to ensure that training needs were met and to assist in setting up IT services correctly, including the creation of appropriate XML files.

65. The Working Group noted the contents of document PCT/WG/12/19.

(B) TRANSFER OF PCT FEES: PROPOSALS TO AMEND THE PCT REGULATIONS AND ADMINISTRATIVE INSTRUCTIONS

66. Discussions were based on document PCT/WG/12/20.

67. The Delegation of the European Patent Office (EPO) supported the proposal to create a consistent legal basis for the transfer of fees via the International Bureau for the netting structure. The EPO agreed with the International Bureau that, for International Searching Authorities and receiving Offices with more than one competent ISA to gain the full benefits of netting, it would be ideal if all the international phase fees being collected by one Office for the benefit of another Office were to use the same fee transfer arrangements. Moreover, the Delegation believed that the final goal should be the participation of all Offices, as only once the new system had been extended to all offices would receiving Offices and International Searching Authorities no longer have to deal with transfers and receipts of payments to and from multiple Offices. In order to streamline the currency flows, the EPO believed that the best option would be to provide for the possibility for an Office acting as an ISA to make it mandatory for the receiving Offices that had specified that Office as a competent ISA to participate in the WIPO fee transfer process. However, the EPO understood that this was not yet feasible. The EPO nevertheless encouraged Offices to participate in the netting system to maximize the benefits to Offices. With a view to encouraging participation, the EPO strongly supported the International Bureau's approach of emphasizing that Offices could use the new process only to the extent of making fee transfers via International Bureau, with netting of fees not being a requirement but the recommended option. However, the Delegation hoped that these flexibilities would not complicate the practical implementation of the fee transfer system. In terms of the proposed amendments to the PCT Regulations, the Delegation generally supported the wording, but had two comments. First, it would be important for collecting Offices to notify the International Bureau as well as beneficiary Offices of the payment of individual fees, and suggested that this should be reflected in Rule 96.2(b). Second, the Delegation suggested deletion of the second sentence of proposed new Rule 96.2(b), noting that Rule 42, setting the time limit for international search, already implied that the ISA had to start the international search immediately upon receipt of the search copy. Finally, the Delegation stated that the European Patent Office had provided feedback to the International Bureau on the proposed new Annex G of the Administrative Instructions.

68. The Secretariat responded to the comments from the European Patent Office on the proposed amendments to the PCT Regulations. Noting the need to ensure that the burdens on Offices were kept to a minimum and to allow the form of the notifications to be made appropriate to the particular fees concerned, the Secretariat proposed to delete the words "to the beneficiary Office" from the text of proposed Rule 96.2(b). The form and recipients of the notifications would be set out in the Administrative Instructions, seeking to avoid the need to set up new notification processes in the short term, while pointing the way to improved data exchange for the future. In response to the suggestion to delete the final sentence of proposed Rule 96.2(b), the Secretariat acknowledged that the ISA was expected to start the international search upon receipt of the search copy. However, the International Bureau preferred to retain this sentence to make clear that beneficiary Offices were obliged to take notification of receipt of a payment by a collecting Office as equivalent to having actually received the fee. It should be explicit that Offices should not wait until transfer of a fee had occurred to begin associated work, such as the international search.

69. The Delegation of Japan stated that netting had been beneficial for reducing the workload of the Japan Patent Office acting as both an ISA and a receiving Office. The Delegation wished to clarify the necessity and function of the notification of acceptance, as provided in proposed Rule 96.2(b). In terms of the draft modifications to the Administrative Instructions, the Delegation underlined that the provisions needed to be sufficiently flexible for complying with the national accounting systems of different Contracting States.

70. The Delegation of the Republic of Korea stated that the Korean Intellectual Property Office was interested in joining netting but this required approval from the competent national ministry. In terms of implementation of the proposal in the document, there needed to be sufficient time for Offices to adapt their IT systems and accounting practices.

71. The Delegation of Brazil informed the Working Group that the National Institute of Industrial Property of Brazil had been participating as a receiving Office in netting pilots with the EPO and the Austrian Patent Office in their roles as International Searching Authorities since February 2019. The Delegation expressed satisfaction with the process, which had brought predictability and had reduced the cost associated with transmittal of fees. The Delegation supported the proposal in the document, noting that it provided flexibility for Offices to participate on a voluntary basis bearing in mind the requirement of some Offices to have approval from the competent finance ministry to participate, as well as the need to make the necessary IT adaptations.

72. The Secretariat, in responding to the remarks from the Delegation of Japan about the notifications to the beneficiary Office, indicated that in the long term, the aim would be to have a data feed providing information on payment of fees for an application. If the data feed went to the International Bureau, the Administrative Instructions could require the International Bureau to forward the information to the ISA.

73. The Chair proposed that the Working Group approve the amendments to the PCT Regulations as set out in Annex I of the document, with the removal of the words “to the beneficiary Office” in Rule 96.2(b), as proposed by the Secretariat in paragraph 68, above. The International Bureau had indicated that it would consult further on the proposed Administrative Instructions set out in Annex II to the document through PCT Circulars and bilateral discussions of issues specific to individual Offices, with a view to bringing the new provisions into force on July 1, 2020. The Chair encouraged national Offices that had technical, legal or administrative difficulties with participating in the new arrangements to provide specific details of the problems so that the International Bureau could seek solutions, whether through further modifications to the Administrative Instructions or by otherwise adapting the technical and financial procedures.

74. The Delegation of Colombia supported the proposal from the Chair for national Offices to submit comments to the International Bureau on the details of the proposed fee transfer arrangements.

75. The Working Group approved the proposed amendments to Rules 15, 16, 57 and 96 of the Regulations, as set out in Annex I to document PCT/WG/12/20, with a view to their submission to the Assembly for consideration at its next session in September-October 2019, subject to the modification to proposed new Rule 96.2(b) as set out in paragraph 68, above, and possible further drafting changes to be made by the Secretariat.

## FEE REDUCTIONS FOR UNIVERSITY APPLICANTS

### (A) FEEDBACK TO CIRCULAR C. PCT 1554

76. Discussions were based on document PCT/WG/12/3.

77. The Delegation of Germany, speaking on behalf of Group B, thanked the Secretariat for conducting the consultation requested by the Working Group at its eleventh session on the proposal by Brazil regarding fee reductions for university applicants and for compiling the results of that consultation. Group B also thanked the Member States that had participated in the process and the Delegation of Brazil for its proposal and engagement. As indicated by the replies summarized in the document, several Member States continued to have concerns regarding the introduction of fee reductions for universities, for example, citing a preference for targeted measures, or indicating concerns regarding fairness and high administration costs for the International Bureau, such as the need to introduce monitoring to prevent abuses, as well as potentially significant additional burden to receiving Offices. Indeed, new questions arose from the consultation process. Overall, Group B believed that the Working Group needed to consider the issue very carefully. As for implementation of any fee reductions for university applicants, Group B noted that the proposed amendments to the Schedule of Fees in document PCT/WG/12/21 themselves provided an indication of the potential administrative complexities underlying the possibility of fee reductions for university applicants. In the view of Group B, this confirmed the need for a careful approach to the issue. It was therefore necessary to consider the concerns expressed by some Member States as to the overall idea of targeted fee reductions before considering the options for implementation. Other measures might be more appropriate for encouraging the use of the patent system by universities, such as expansion of the *pro bono* Inventor Assistance Program to universities in order to reduce the largest financial expense faced by applicants in the patent process, that is, patent practitioner costs.

78. The Delegation of Brazil thanked the countries that had responded to Circular C. PCT 1554 and reminded the Working Group that the document had been prepared in response to the decision at the eleventh session to help Member States in the decision-making process regarding fee reductions for universities. The Delegation referred to economic studies that had found that universities had a positive role in productivity. The knowledge generated by universities enhanced industrial output, with a strong and positive spillover effect on innovation across the economy. This was particularly so in the field of pharmaceuticals, underlying the fact that universities were significant sources of scientific and technical knowledge that could be harnessed for innovation, the main purpose of WIPO. Given this evidence, countries had adopted numerous policies aimed at encouraging R&D efforts by universities. Apart from legislation that facilitated the commercialization of intellectual property resulting from university innovation, such as the United States Bayh-Dole Act and similar provisions in other countries, including Brazil, countries had also adopted measures targeting fee reductions to universities. These fee reductions assisted efforts by universities to access the patent system by reducing the costs of obtaining patent protection. Examples of Offices providing such fee reductions included the European Patent Office (EPO), the United States Patent and Trademark Office (USPTO), the Japan Patent Office (JPO) and the Brazilian National Institute of Industrial Property (INPI-Br). All these IP Offices provided fee reductions ranging from 30 to 50 per cent and granted reductions when acting as an International Searching and Preliminary Examining Authority under the PCT. However, despite these efforts, universities filed only 5.4 per cent of international applications according to the 2019 PCT Yearly Review. The Delegation stated that this share indicated that universities faced many challenges in the process of patent filings in all countries, whether developing or developed. In fact, a study recently published by the European Commission, entitled *Patent costs and impact on innovation*, highlighted that patent costs were the main barrier for patenting by universities in the United States of America, the United Kingdom, Germany, France, Spain, Sweden, Poland, India, the Republic of Korea, Japan and China. This being the case in some of the most developed countries in the world, it was even more so in countries with more limited resources. Member States had been

discussing a PCT fee policy to stimulate filings by universities since the second session of the Working Group in 2009. At that occasion, Member States had “agreed on the importance of fee reductions and capacity building measures, including in patent drafting and filing, and agreed that the relevant PCT bodies should prepare proposals, including fee reductions and capacity building measures, to increase access to the PCT for independent inventors and/or natural persons, small and medium sized enterprises and universities and research institutions, in particular, from developing and least developed countries” (see paragraph 97 of document PCT/WG/2/14). The International Bureau, at the third session of the Working Group in 2010, recognized that “initial fees remain a significant barrier to entry to the system for some applicants”, and stating that “an international application gives time before the greater costs need to be paid and may give assistance in finding such partners. Consequently, while a relatively small part of the total cost, accessibility to this stage of the patent procedure may be particularly important for some innovators” (see paragraphs 187 and 188 of document PCT/WG/3/2). At the workshop held during the eleventh session of the Working Group, a representative from the University of Copenhagen had indicated that the 30 month period offered by the PCT was used to look for companies interested in obtaining licenses and that a PCT application had the effect of spreading the news of an invention as the application would be available on PATENTSCOPE after publication. This was useful for disseminating knowledge about the technology and helping to find a potential licensee. However, if the University of Copenhagen did not find anyone interested by the end of the 30-month period, it would discontinue the prosecution of the PCT application and not enter the national phase because of the high costs of that phase. This eloquent testimony illustrated two key facts. First, the budget of universities was limited, even for those located in developed countries. Second, there was a special nature relating to the interaction and use of the PCT by universities, which was considerably different from an ordinary applicant. Moreover, the study by WIPO’s Chief Economist in 2014 on PCT fee elasticity had concluded that universities were eight times more sensitive to variation of PCT fees in comparison with an ordinary applicant. This implied that universities would respond positively to fee reductions and that fees were an obstacle for using the PCT System. The responses to Circular C. PCT 1515 showed that many countries had consulted universities and received feedback, stating that filing fees were seen as a barrier to entry to the system. Based on such evidence and to complement policies by countries at the domestic or regional level, Brazil had proposed that the PCT Assembly grant a fee reduction to universities from developing and developed countries, facilitating the access to the PCT System and the benefits it would bring. In document PCT/WG/11/18 Rev., Brazil had proposed a 50 per cent reduction for universities in developing countries and 25 per cent for those located in developed countries, but the Delegation emphasized that it was flexible on the amount to be granted to universities from developed countries. In the second supplement to the *Estimating a PCT fee elasticity* study (document PCT/WG/10/2), estimates by the Secretariat indicated that a total income loss of a 50 per cent fee reduction for universities from developing countries would amount to 660,000 Swiss francs if a ceiling of 20 applications per year were applied. This study also showed that the cost of a 25 per cent reduction for applications from developed countries would be 780,000 Swiss francs in the case that a ceiling of five applications per year applied. The total cost of both would thus amount to 1.44 million Swiss francs. To put that number in perspective, the Director General of WIPO had recently announced a surplus of over 80 million Swiss francs in the current biennium alone. Moreover, the proposed Program and Budget for the 2020/21 biennium estimated that income from fees collected by the PCT System in 2020 would reach 330 million Swiss francs. The estimated impact of both proposed reductions therefore amounted to 0.4 per cent of the PCT income for next year, a small fraction of the total income. In this sense, the Delegation believed that this should be seen as “resources well allocated”, rather than foregone income or revenue loss. The proposed fee reduction had also consistently received broad support at the Working Group. Specifically, members of four Regional Groups declared their approval of the proposed fee reduction, raising the number of supporting Member States to 109 countries, or more than two thirds of the 152 PCT Contracting States. Moreover, other delegations had shown openness for discussing a broader fee

reduction that included developed countries. Furthermore, the Program and Budget Committee, at its twenty-ninth session held from May 6 to 10, 2019, had agreed to include an indicator measuring the number of PCT applications filed by universities and research institutions (see paragraphs 205 to 211 and 249 of the Report of the session, document WO/PBC/29/8). This showed that WIPO Member States recognized the necessity of policies addressing the issue of PCT filings from these applicants. Finally, the Delegation considered that the proposal was fully in line with WIPO's mission to encourage creativity through the protection of intellectual property around the world, as stipulated in the WIPO Convention.

79. The Delegation of Guatemala, speaking on behalf of the Group of Latin America and the Caribbean (GRULAC), including those States that were observers to the Working Group, reiterated its support for the proposal for fee reductions for university applicants. The revised proposal by Brazil at the eleventh session of the Working Group (document PCT/WG/11/18 Rev.) included language that responded to the concerns expressed by delegations during the ninth and tenth sessions of the Working Group regarding the beneficiaries and the financial impact of this reduction. The changes were reflected in the text through a broadening of the beneficiaries, with both public and private universities from developing countries benefitting from a 50 per cent reduction and universities from developed countries benefitting from a 25 per cent reduction. The fee reductions also limited the number of applications filed by a university, with developing countries capped at 20 and developed countries at five applications per year, thereby responding to the concerns about the financial impact to WIPO. The implementation of a fee reduction would enable the use of a large pool of scientific and technological talent at universities. There was a real need to take advantage of this knowledge resource and stimulate the research and development of products. The proposal would be a positive step in the right direction by fostering innovation and creativity in accordance with the broader objectives of the PCT System. GRULAC therefore appealed to all delegations to consider the proposal positively, which was duly structured and took account all the technical considerations, making it a serious and viable project with all the necessary steps for an adequate evaluation.

80. The Delegation of Indonesia, speaking on behalf of the Asia and Pacific Group, thanked the members of the Working Group that had responded to Circular C. PCT 1554. The Asia and Pacific Group had always been positive with regard to fee reductions for university applicants. The Asia and Pacific Group noted the responses to the Circular summarized in the document, as well as the concerns reflected and acknowledged the options for implementation and the proposed amendments to the Schedule of Fees reflected in document PCT/WG/12/21. The Delegation concluded by indicated that the Asia and Pacific Group would be ready to join a consensus should this emerge and hoped that such consensus could be reached as early as the present session of the Working Group.

81. The Delegation of Iran (Islamic Republic of) stated that the contribution of research and development from universities to productivity growth in a country's economy could not be overemphasized, as knowledge created by universities was a significant source for innovation. The Delegation expressed the view that the proposal would contribute positively to stimulate the use of the PCT System by universities and increase the geographical diversity in the demands for patent protection and filing activities for PCT international applications. Discussions on a PCT fee policy to stimulate patent filings by universities had a long history in the Working Group. The objective of the discussion was *inter alia* to increase access to the PCT for universities and research institutions, in particular, from developing and least developed countries. The Delegation shared the view that the applications from universities and public research organizations, particularly those located in developing countries, were more price-sensitive compared to other applicants. The Delegation therefore expressed its appreciation to the Delegation of Brazil for initiating the proposal for university fee reductions in the PCT, which would lead to stimulating innovation in countries with limited capacities. As for the feedback to Circular C. PCT 1554 summarized in the document, the Delegation noted that there were some divergent views among respondents from the general remarks on policy of fee

reduction for universities. However, for operational issues, namely, the definition of universities, eligibility in case of multiple applicants, claiming a fee reduction for a university, monitoring fee reductions for universities and a sunset clause, there was a broad common position and understanding among respondents, which the Delegation believed could provide a common ground for agreement.

82. The Delegation of the Russian Federation stated that it had supported the revised proposal by Brazil at the eleventh session of the Working Group. That proposal provided two levels of fee reductions for universities, one for developing countries and one for developed countries. The Delegation believed that the revised proposal was well substantiated and reasoned, and could be considered a compromise and given the long discussions on university fee reductions. The Delegation thanked the Delegation of Brazil for the further comments at the present session and reaffirmed its support for the proposal.

83. The Delegation of China expressed support for the proposal for fee reductions for universities, which would encourage more applicants to use the PCT System, resulting in its wider use and greater influence.

84. The Delegation of Uganda, speaking on behalf of the African Group, renewed its support for the proposal by Brazil for fee reductions to stimulate the filing of patent applications by universities under the PCT System. The Delegation also thanked the Secretariat for summarizing the feedback to Circular C. PCT 1554 and the members of the Working Group for providing their suggestions in the process. The African Group was convinced that the Brazilian proposal was in line with the broad objective of the PCT to simplify and render more effective and more economical the obtaining of patent protection compared to previous means of applying in several countries to patent an invention. This was in the interests of users of the patent system and the Offices that were responsible for administering it. Fee reductions for applicants would broaden the geographical coverage of the system, making it more cost effective and advantageous to a greater number of applicants. This would significantly boost the benefits from the PCT System, particularly for developing countries in terms of increased innovation activity at universities, availability of technology and accelerated industrial progress and involvement. The African Group noted that many delegations or regional groups had supported the proposal given the positive effect of fee reductions for universities in developing countries as well as developed countries. The Delegation also expressed gratitude to the Delegation of Brazil for taking into account comments made by Member States during previous sessions of the Working Group. While the percentages for reductions had not yet been agreed, the African Group noted that the proposed 50 per cent reduction for universities from developing countries as well as the proposed reduction of 25 per cent for universities from developed countries would not lead to astronomical losses to WIPO, given that there were also ceilings in the number of applications where the reduction could be applied, namely 20 per year for developing countries and five per year for developed countries.

85. The Delegation of Indonesia thanked the Delegation of Brazil for the proposal for fee reduction for university applicants that had been discussed at several sessions of the Working Group. The Delegation aligned itself with the statement made by the Delegation of Brazil and echoed the comments made by the Delegations of the Russian Federation and China. In this regard, the Delegation of Indonesia confirmed its support for a PCT fee reduction for university applicants.

86. The Delegation of Chile supported the proposal by Brazil for fee reductions for university applicants. In Chile and other countries in Latin America, universities were relevant actors in the patent world. A reduction of fee rates for these applicants would therefore foster innovation in Chile.

87. The Delegation of the United States of America aligned itself with the statement made by the Delegation of Germany on behalf of Group B. As discussed in paragraph 6 of the document, there were a number of States that still objected to the idea of further targeted fee reductions in general and to targeted reductions for universities, in particular. These Member States expressed this position when the proposal by Brazil was first tabled at the ninth session of the Working Group and according to the survey results, they continued to hold that position. As a result, the Delegation did not see a clear value to further discussions on university fee reductions at this stage. In addition, the Delegation had significant concerns about many of the aspects of implementation of the proposal in document PCT/WG/12/21, so did not see an acceptable way forward in general. The Delegation restated its preference for an across-the-board fee reduction, reflecting the fact that existing applicants had all contributed to the budget surplus of WIPO and that, consequently, all should benefit from it.

88. The Delegation of Canada expressed support in principle for the revised proposal by Brazil tabled at the eleventh session of the Working Group, which addressed many of its original concerns. However, the Delegation recognized that many finer details of the proposed fee reductions remained to be worked out.

89. The Delegation of Japan supported the statement made by Germany on behalf of Group B. While understanding the purpose of the proposal by Brazil to encourage wider use of the PCT System by universities, the Delegation highlighted the responsibility of Member States to explain to users why the proposal should be introduced, especially to users who had greatly contributed to the PCT System but would not benefit from this proposal. The Delegation expressed the view that countries believing in the importance of patent protection of innovation from universities should provide these universities with support through their own domestic programs.

90. The Chair raised two points in response to the comments raised by the Delegations of the United States of America and Japan about the proposal only providing a fee reduction for selected applicants, while all applicants had contributed to the budget surplus of WIPO generated by PCT fees. First, fee reductions already existed for some applicants, notably from developing and least developed countries. PCT Contracting States had therefore in the past agreed to targeted fee reductions as a worthwhile measure to encourage these applicants to use the PCT System. Second, all applicants paid fees to use the PCT System. While these fees covered the administration of the system, the intellectual property rights an applicant could receive were valuable to the rights holder. Targeted reductions could be justified, provided there was a sensible explanation for such reductions. All delegations accepted the contribution of universities to innovation and their special role in research and development. A fee reduction for selected applicants could therefore be seen as a way of ensuring the fees in the PCT were as balanced as could be possible, rather than taking money from one group of applicants to benefit another group.

91. The Delegation of India stated that the document was comprehensive and included divergent views, particularly with respect to eligibility criteria for universities. The Delegation expressed support for PCT fee reductions for university applicants from developing countries and least developed countries in principle since as centers of excellence, universities had the potential to boost innovation in these countries. However, the Delegation could not accept a definition of a university being limited to institutions offering at least a four-year degree or diploma program given that some universities in India that were run or were accredited by the government offered three year degree programs. Moreover, the Delegation disagreed with the requirement for all applicants to be eligible for the fee reduction in the case of multiple applicants and instead believed that only the first named applicant should be required to be eligible.

92. The Delegation of Spain indicated that Spain had had a policy waiving all fees for public universities, but this had not given the desired results. After a zero filing fee for national patent applications was introduced for public universities, a substantial increase in the number of filing of filings was observed. However, this did not go hand in hand with more patents being granted or the greater use of such patents, whereas an intended aim of the proposal was for innovation and creativity to be more widely benefiting society. The Delegation had therefore eliminated its zero fee filing policy for public research institutions and universities when new patent laws entered into force in Spain in 2017. Under the new laws, public research institutions and universities benefitted from a 50 per cent fee reduction, which could be increased to 100 per cent if it could be demonstrated that the patent was being used. By contrast, the 75 per cent fee reductions for applicants from developing countries using the Spanish Patent and Trademark Office as an International Searching and Preliminary Examining Authority were maintained. The Delegation therefore generally favored fee reductions being provided to larger groups, such as applicants from developing countries. In the case of fee reductions for universities, despite the concerns expressed by Group B, the Delegation hoped that any reduction could be expanded to all countries, irrespective of their level of development.

93. The Delegation of Germany noted that details of the proposal by Brazil in document PCT/WG/11/18 Rev. that had been raised at the eleventh session of the Working Group had been addressed in Circular C. PCT 1554 and that document PCT/WG/12/21 presented options to overcome some concerns. The Delegation also noted that the summary of responses to the Circular showed that some respondents had general concerns regarding the proposal. In the opinion of the Delegation, the existing PCT fee structure, which charged applicants equally for the services provided by the International Bureau, the International Searching and Preliminary Examining Authorities and the receiving Offices worked well. The fee structure therefore should not be complicated by creating exemptions for specific groups of applicants. In this regard, one respondent to the Circular had suggested to offer fee reductions if one of the co-applicants was a small or medium-sized enterprise or startup company, as stated in paragraph 32 of the document. This raised the question of equal treatment and why universities should benefit from fee reductions, but not other groups of applicants. Moreover, the proposal by Brazil did not take into account the quality of patents. The Delegation believed that fee reductions for specific groups of applicants were not an effective instrument to foster innovation and high quality patents. When considering introducing new rules, the question should not only be increasing quantity, but also improving quality. The proposal by Brazil aimed at “(i) stimulating the use of the PCT System by universities, and (ii) increasing the geographic diversity in the demands for patent protection and of PCT international application filing activities” (see paragraph 1 of document PCT/WG/11/18 Rev.). Furthermore, from paragraph 12 of document PCT/WG/8/11, it was clear that fee elasticity was low, meaning a highly inelastic response of applicants to fee changes. In this regard, in paragraph 16(b) of document PCT/WG/12/11 discussing fee reductions for certain applicants, notably from developing and least developed countries, the International Bureau observed, “the availability of a reduction does appear to affect applicant behavior, but the effects are difficult to assess. It would appear that the rates of applications by natural persons and in total, as well as the level of use of the reductions, are affected strongly by factors that are unrelated to whether the reduction is available or not.” The Delegation therefore believed that other instruments might be more effective to reach the intended aim of the proposal by Brazil, in addition to fostering innovation and high quality patents. In the opinion of the Delegation, there were possibilities to offer tailor-made incentives and policies for promoting innovation for applicants qualifying for specific programs.

94. The Delegation of Turkey acknowledged that universities played an important role in the innovation ecosystem by converting output from research and development into inventions. In this regard, universities needed to be encouraged to obtain IP rights at a national and international level. Moreover, evidence supported the view that patents were effective at encouraging new inventions, especially for universities. In this context, the PCT System was a suitable tool for universities to patent their inventions at international level. The Delegation

therefore believed that fee reductions for universities would result in increases in both the number of university applicants and the number of PCT applications. Having said that, potential administrative complexities and significant additional burdens to the receiving Offices in case of possible fee reductions should be minimized and considered very carefully, as had been recognized by Group B. In this regard, IT tools needed to be used or improved to facilitate implementation, both for receiving Offices and the International Bureau. Furthermore, if a system for university fee reductions came into effect, it should be subject to a regular review process to evaluate the implementation and the effects on the PCT System as a whole. The Delegation therefore believed that the proposal on fee reductions for universities should be considered in a positive manner and options for implementation needed to be carefully designed with the help of IT tools for smooth operation of the system for reductions.

95. The Delegation of Portugal stated that the document addressed its previous concerns and questions relating to the proposal by Brazil in a clear and concrete manner. For example, the Delegation agreed that a university could be defined using the World Higher Education Database (WHED) Portal and that the applicant should make a declaration to confirm eligibility for the fee reduction as a university. The Delegation also agreed with the proposals relating to eligibility for multiple applicants, the monitoring process and the sunset clause. Overall, the Delegation believed that the document indicated a viable way for implementation of the proposal.

96. The Delegation of Switzerland supported the statement made by the Delegation of Germany on behalf of Group B and was of the opinion that a reduction of PCT fees might not be the best way to support the role of universities in innovation. The study in document PCT/WG/7/6 demonstrated that the reduction of PCT fees would result in no significant increase in patent filings by universities and that the overall estimated fee elasticity was low. It was therefore premature to discuss implementation options while there remained concerns on the principle of a reduction, as outlined in paragraph 6 of the document. The Delegation understood that these concerns were in line with the outcome of the workshop held at the time of the eleventh session of the Working Group, for example, that measures on a national level would be more beneficial to universities than a simple reduction to PCT fees. The workshop showed that the costs of patent filings were not the main costs faced by universities; they were only a small fraction of the whole research and development costs in comparison, for example, to patent attorney costs or costs involved for licensing. The Delegation therefore believed that it would be more efficient if universities received support in the whole research and development phase. For example, some universities in Switzerland had a dedicated unit that provided assistance in matters relating to the filing and prosecution of patent applications, management of rights, contracts with industry and the development of inventions. Moreover, the workshop highlighted that communication between universities and industry was key to success. Furthermore, filing fees acted as quality gauge. The mere reduction of filing fees could therefore result in more low quality patent applications that might not pass through substantive patent examination. For example, some inventions might not be worth the filing fees if the patent were bought or licensed commercially. The Delegation also had further concerns as the implementation of a fee reduction system would result in considerable workload for national IP Offices, as well as administrative and IT issues for IP Offices and universities. In conclusion, the Delegation stated that it still had concerns regarding fee reductions for universities.

97. The Delegation of Australia stated that it was supportive of provisions that increased access to the international patent system, particularly for applicants from developing countries and least developed countries. The Delegation also affirmed its support for research and development in the university sector to promote commercialization and engagement with the IP system. The Delegation thanked both the International Bureau and the Delegation of Brazil for their work in trying to accommodate the concerns that Member States, including Australia, had raised with regard to the proposal by Brazil when it was first tabled. Referring to paragraph 16(b) of document PCT/WG/12/11, which stated that “the availability of a reduction

does appear to affect applicant behavior, but the effects are difficult to assess”, the Delegation underlined the importance of any measures adding value to the PCT System. However, it might be difficult to answer to assess the effects without implementing a provision for a trial period. The Delegation therefore stressed the importance of the sunset clause. The Delegation remained willing to engage in discussions to achieve a balanced solution, but acknowledged the challenges highlighted by the Delegation of Switzerland in knowing whether a proposal would stimulate innovation or the filing of high quality patents. Nevertheless, the Delegation stated that it would not stand in the way of consensus if the Working Group agreed on how to proceed with the proposal.

98. The Delegation of United Arab Emirates supported the proposal by Brazil. The proposed fee reductions aimed to increase international patent filing by universities as an important initiative in stimulating innovation and creativity. The Delegation believed that any fee reduction policy for universities should include all PCT Contracting States, with particular attention to developing countries.

99. The Delegation of Denmark aligned itself with the statement made by the Delegation of Germany on behalf of Group B. The Delegation continued to believe that fee reductions for universities should stimulate the use of the PCT System and that they may not be the best vehicle for improving promotion and commercialization of inventions developed in universities. For example, at the workshop held at the time of the eleventh session of the Working Group, Prof. Dr. Fazilet Vardar Sukan had highlighted the introduction of technology transfer offices as a key initiative to raise IP knowledge and foster the use of IP. A solid framework, nursing and evaluating all the good ideas at a university might therefore be a better way to promote patent applications. Moreover, the studies performed by the International Bureau had indicated that the proposed fee reductions would result in an estimated 139 additional applications at a relatively high price. The Delegation therefore continued to have reservations concerning the costs and benefits of the proposal. Furthermore, the Delegation believed that an applicant should initially file an application through cheaper national routes to determine the patent protection that might be obtained before embarking on applying for patent protection through the PCT. Furthermore, the main costs of obtaining patent protection were associated with advisors, with statutory fees only making up a minor part of the total costs. However, the Delegation recognized the benefits of the PCT System allowing an applicant more time to consider obtaining patent protection in different jurisdictions.

100. The Delegation of the United Kingdom acknowledged that the document showed differences in opinion on how best to implement the proposal by Brazil. In light of these differences, the Delegation supported the comment by the Delegation of Germany, speaking on behalf of Group B, that there was a need to proceed carefully regarding the proposal. While some of the concerns that the Delegation had raised during the eleventh session of the Working Group had been addressed, others remained. The Delegation reminded the Working Group that the United Kingdom did not offer fee reductions as a way of stimulating innovation at universities, but instead encouraged collaboration between universities and industry by assisting with IP knowledge and commercialization strategies. While the Delegation could not support a proposal that would provide for differential fees for university applicants, if the outstanding implementation issues were to be resolved, the Delegation foresaw that it would not prevent the Working Group proceeding if a consensus were to emerge on fee reductions for universities.

101. The Delegation of Senegal supported the statement made by the Delegation of Uganda on behalf of the African Group. The Delegation thanked the Delegation of Brazil for its revised proposal, which it believed would stimulate the use of the PCT by universities and increase the geographical diversity of international patent applications through the PCT. In conclusion, the Delegation reiterated its support for the proposal, which it hoped that the Working Group would approve at its present session.

102. The Delegation of Brazil thanked the Group of Latin America and the Caribbean (GRULAC) including those States that were observers of the Working Group, the Asia and Pacific Group and the African Group, for their support for the proposal for fee reductions for universities. The Delegation also thanked the Delegations of Iran (Islamic Republic of), the Russian Federation, China, Indonesia, Chile, Canada, India, Chile, Turkey, Spain, Portugal, United Arab Emirates and Senegal for their support for the proposal expressed in a national capacity. The Delegation also thanked the Delegation of Australia for indicating flexibility in potentially joining any consensus that the Working Group might reach. First, the Delegation pointed out the importance that States had given to the proposal, even among States that were not members of the PCT. A fee reduction for universities could assist in the efforts of the latter group of States to join the PCT System, showing that the multilateral community was giving attention to issues that acknowledged the special place of universities in the innovation ecosystem. In responding to some of the concerns expressed, the Delegation pointed out that, while patent attorney costs were high, the Working Group did not have any mandate to address this matter. Instead, States had national policies to improve access to professional advice and assistance, such as programs directed to assist in the qualification of patent attorneys and *pro bono* programs. Moreover, in the WIPO Inventor Assistance Program for individual applicants, the Secretariat acknowledged that the international filing fee in the PCT remained a barrier to entry to the system. Other measures at national and regional level for universities, such as courses on patent drafting, workshops on patent strategies, the development of patent evaluation mechanisms and the WIPO Patent Information Service were welcome, but were all complementary to fee reductions. On the other hand, fee reductions dealt with a specific impediment to the filing of PCT applications, which the Working Group could solve. As noted, accessibility to the PCT system could be particularly important for some innovators and the studies on fee elasticity showed this to be the case for universities, particularly in developing countries. Referring to the remarks by the Delegation of Spain about the experience where filing fees were waived for universities, the lack of a rise in the number of granted patents despite an increase in filings could be attributed to factors such as the need for universities to license or sell the invention. Moreover, the publication of a patent application in itself would contribute to the dissemination of technical information and therefore advance innovation and technological development. Referring to the quality of patent applications raised by the Delegation of Switzerland, the Delegation of Brazil had a different view. The Delegation believed that the use of the PCT System enabled higher quality patent applications. First, the written opinion or international preliminary report on patentability issued by the International Searching Authority (ISA) provided additional evidence for the applicant to determine whether to seek patent protection by entering the national phase. In addition, the applicant would be able to amend the application taking into account the comments raised by the examiner at the ISA, thereby improving the quality of patent applications. Furthermore, the decision whether or not to file a patent application took into account the expected benefits of the underlying invention and the costs associated with that patent application. The proposal by Brazil intended to address the issue of the costs, while it was for the applicant to determine whether the expected benefits made the filing of a patent application worthwhile. Regarding the points made by the Delegations of Germany and Switzerland that PCT fee elasticity was low, as well as the point raised in document PCT/WG/12/11 that it was difficult to assess the effects of a fee reduction, the Delegation acknowledged that there were many different aspects that could affect the filing behavior of applicants, but these factors were outside the mandate of the Working Group. Furthermore, the sunset provisions would allow a full evaluation of the effect of the proposed fee reductions. While studies provided indicators of the possible impact of fee reductions, only by implementing the fee reductions and evaluating their effect towards the end of the initial period covered by the sunset clause would it be possible to know their real effect and determine whether to renew or discontinue the reductions.

103. The Chair, in summarizing the interventions from Member States, acknowledged the wide support from delegations to implement fee reductions for universities as a means to increase the involvement of universities in the international patent system. However, some delegations in Group B were not able to agree to fee reductions for universities at this stage.

104. The Representative of the Japan Intellectual Property Association (JIPA) stated that the JIPA understood the importance of facilitating patent applications by universities. However, the Representative underlined that this should not put other applicants at a disadvantage through higher fees, or there being a deterioration in quality of patent applications.

105. The Chair, in response to the comments raised by the Representative of the JIPA, emphasized that there was no suggestion that fees for other users would be raised as a result of implementing fee reductions for universities. Moreover, the additional number of applications by universities predicted from the proposed reductions would have minimal impact on the workload of International Searching and Preliminary Examining Authorities.

106. The Working Group noted the contents of document PCT/WG/12/3.

#### (B) OPTIONS FOR IMPLEMENTATION

107. Discussions were based on document PCT/WG/21/21.

108. The Secretariat introduced the document by updating the Working Group on discussions with the International Association of Universities in relation to the use of information from the World Higher Education Database (WHED) Portal. The International Bureau had received samples of data from the WHED Portal and concluded that the data would be useable in terms of importing the information into IT systems, creating lists that could allow for selection of an institution in ePCT and monitoring the numbers of applications that any institution had filed claiming the fee reduction. Costs for licensing the data would need to be determined. A basic implementation could cost about 10,000 Swiss francs each year, but this would be higher if receiving Offices wished to receive detailed information. One issue to take into account with the data provided from the WHED Portal was that the names of institutions were in Latin characters only. For languages not using Latin script, the names of universities were based on an English translation or a transliteration. For Latin-script languages, there were some differences in the entries between different institutions. For example, in French, some institutions were listed with their French title and others used an English translation of the title. However, the International Bureau did not consider this as an obstacle to using the data and monitoring the use of reductions by universities. While the receiving Office would perform a check that the declaration to claim the fee reduction corresponded to the list of applicants, the International Bureau would count the numbers of fee reductions claimed. The International Bureau considered it unlikely that a university would deliberately claim reductions beyond the number it was entitled to, but in the event that this happened, the International Bureau would contact the receiving Office to request further fees from the applicant.

109. The Delegation of Brazil underlined that the implementation options in the document aimed to reduce the additional work by receiving Offices to a minimum. The receiving Office would not be responsible for the number of reductions claimed, nor would it be expected to check the veracity of the statements made by co-applicants. The receiving Office would perform a simple check that the applicant was an eligible institution, and paragraph 13 of the document stated that “the checks described ... would require negligible additional work by receiving Offices and the International Bureau”. Furthermore, only a very small number of cases would eventually need action by the International Bureau, namely if they exceeded the number of permitted claims for reductions. An important topic was the designation of beneficiary institutions. The International Bureau had been in contact with the organization responsible for the WHED Portal, the International Association of Universities (IAU), created under the auspices of UNESCO. The use of such a database would have the benefit of being

straightforward with the necessary flexibility for eligible institutions to be added on request by a Member State. The International Bureau would make a list available to each receiving Office, enabling a smooth implementation. Bearing in mind that a basic element of the international IP system should be to stimulate technological innovation and creativity by fostering cooperation between States, the proposed implementation in the case of multiple applicants provided a reasonable solution since inventions developed through international cooperation would not be negatively affected with regard to the fee reduction. Furthermore, proposals in the document built upon experience of fee reductions provided for natural persons by including a mechanism to combat possible fraud. Universities would be required to file a declaration stating their eligibility for the fee reduction using a form, which could be easily generated if the international application had been filed using ePCT. Furthermore, universities relied on their reputation to attract students, researchers and funding, and they would not deliberately wish to tarnish this reputation. Indeed, universities could risk administrative or indeed criminal sanctions for attempting to commit fraud at an IP Office. The Delegation therefore saw minimal risk of abuse of fee reductions by universities. Lastly, the proposal included a sunset provision allowing the Working Group to evaluate the results of the fee reduction and decide with concrete evidence whether to renew the fee reduction, taking into account the benefits and the costs. The seven-year period suggested by the International Bureau appeared to be a suitable time to assess the effects of the fee reduction on applicant behavior. To conclude, the proposed fee reduction aimed at making full use of PCT fees as a regulatory tool to influence the filing behavior of universities in a positive way and eliminate impediments to the filing of PCT applications. It would also facilitate access to the PCT System, creating an additional incentive for research and innovation. The proposed fee reduction would encourage the use of the system, increase the diversity in the geographical composition of applications and generate additional demand in the medium term for PCT services. This was fully in line with the mission of WIPO and the higher goals of the intellectual property system.

110. The Delegation of Iran (Islamic Republic of) agreed with the view of the International Bureau that the list of universities from the World Higher Education Database held by the International Association of Universities would be the preferred means to determine eligibility for fee reductions of an institution. As for the sunset clause, the Delegation considered this positively as a way of requiring a regular review of the implementation of the proposal, but could be flexible in terms of the period before the initial evaluation. To conclude, the Delegation considered the implementation options in the document to be a good basis for potential agreement on the proposal.

111. The Delegation of the Russian Federation expressed agreement with the proposed wording to items 5 to 7 of the Schedule of Fees in the Annex to the document. However, the Delegation did not see a need to include the proposed item 8, since it believed the eligibility for fee reductions should be considered only at the time of filing of the international application. The Delegation agreed that the proposed period of seven years was appropriate to assess the impact of the fee reduction on the number of international applications filed by universities in different States and on their subsequent entry into the national phase, as well as the impact on financial and other matters at the International Bureau.

112. In response to the comment by the Delegation of the Russian Federation on proposed item 8 of the Schedule of Fees indicating the time at which eligibility needed to be established for different types of fee reduction, the International Bureau observed that this was not specific to the question of fee reductions for universities, but a clarification of what the scope of existing reductions was intended to be. The different provisions that related to the dates of receipt of the request for supplementary international search and of the demand for international preliminary examination reflected small numbers of relatively low fees. These provisions could be removed, making the relevant date the international filing date, if Member States so wished.

113. The Delegation of the United Kingdom stated that it remained unconvinced over the use of the WHED Portal for determining eligibility of an institution for university fee reductions as it did not consider the Portal to be updated on a sufficiently regular basis to be used as a definitive record of all higher education institutions worldwide. For example, it could be possible for a university not to realize that they were ineligible for fee reductions until they were ready to file, at which time it might be too late to add the university to the database. To avoid this scenario, the International Bureau and receiving Offices would need to ensure that such fee reductions were well publicized in the university sphere. In addition, the Delegation had concerns over the additional work that these reductions would introduce to receiving Offices in checking for eligibility, and in the case of an erroneous claim for the reduction, rejecting the claim and ensuring that the applicant paid the full international filing fee. Given that there did not appear to be any immediate consequences for universities making erroneous declarations and paying incorrect fees, the Delegation expressed concern that receiving Offices could have more additional work than the document stated. If the proposal were implemented, the Delegation agreed with the requirement for all applicants to be eligible for the fee reduction. The Delegation also agreed that unless a cost-effective IT solution were developed to allow receiving Offices to perform eligibility checks, the International Bureau was the most appropriate body to monitor the number of filings from universities, particularly when multiple receiving Offices were involved. To avoid exploitation of the fee reductions, the Delegation agreed that extra checks might be necessary when filing a request for supplementary search, or a demand for international preliminary examination. However, the Delegation continued to have concerns over whether these checks along with the additional work required by receiving Offices would prove to be cost effective in relation to the benefits that this proposal would bring. Document PCT/WG/12/3 highlighted some disagreement over the length of a possible sunset clause and the Delegation underlined the need for an effective evaluation of the fee reductions, which would need to be addressed by the Working Group. In this regard, the Delegation stated that a seven year period would be essential to assess how many international applications had progressed to grant in the national phase. While some benefits could be gleaned from the sharing of innovative ideas through international publication, the true test of the success of the proposal could only be properly measured by the number of applications that progressed to grant.

114. The Delegation of the European Patent Office stated that it had several comments regarding implementation of the proposal at an operational level, especially from the point of view of receiving Offices. Contrary to what was stated in paragraph 13 of the document, the Delegation believed that the additional work for receiving Offices in administering the fee reduction for universities was not negligible. First, it would be necessary to adapt electronic tools for handling the fee reductions. Second, formalities staff would need to conduct the necessary checks to prevent abuses and confirm that the university was eligible for the fee reduction according to the list that would be supplied by the International Bureau. Third, the receiving Office would be required to send a letter to the applicant *a posteriori* to request unpaid fees when the International Bureau had informed the receiving Office that the applicant had exceeded the quota of international applications that were eligible for the fee reduction. While the International Bureau could act as receiving Office for such cases involving university fee reductions by virtue of Rule 19.4(a)(iii), a system would need to be put in place for receiving Offices that wished to handle these applications in an effective manner that would involve minimal additional burden and costs. The Delegation therefore suggested that this matter should be studied further and brought up in future discussions.

115. The Delegation of the United States of America stated that it had continued to have concerns about the proposal in general, as did some other Member States. In particular, it was not clear that these reductions would result in more than a nominal increase in filings by universities. Discussion on specific implementation options therefore appeared premature at this point. In the view of the Delegation, a budget surplus at WIPO should be used to give an across-the-board fee reduction to all applicants since all applicants had contributed to the

surplus, so all should benefit from it. The Delegation stressed that its concerns were also based on the complexity of the proposal and the lack of clear evidence that it would have a significant and positive effect on patent filings. By contrast, the surplus could be better spent by an across-the-board cut in fees. While the proposal included fee discounts for universities from all Member States, it included disparate treatment between applicants from developing and developed countries, both in the amount of the reduction and the maximum number of cases that could be filed per entity. Filings from developed countries created the bulk of the budgetary surplus and those users should at least benefit equally in terms of the amount of the discount. Further, with regard to the cap on filings, even if the cap were uniformly set at 20 applications for all universities, it would disproportionately affect universities from developed nations. Specifically, filings from individual universities from developing and least developed countries rarely exceed 20 applications per university in a year and thus the discount would apply to all or almost all applications from those universities. On the other hand, many universities from developed nations regularly filed more than 20 applications and as such, many of the applications from those universities would not benefit from the discount at all. The proposed cap of only five applications each year for universities in developed countries compared to 20 applications from developing countries further exacerbated this disproportionate effect. Furthermore, while the Delegation welcomed the use of the WHED Portal to determine the eligibility of an applicant for a fee discount, the Delegation continued to have concerns with respect to the tracking of applications from a given entity. Specifically, many universities filed applications under multiple names. For example, an application could be filed by the university itself, by the trustees of the university, or by, for example, the college of engineering within the university. It was not clear how the proposed implementation would address situations of alternative names for the same entity. The Delegation also had concerns about the situation described in paragraph 9 of the document and the final paragraph of item 6 of the proposed amendments to the Schedule of Fees relating to individual researchers studying at or being employed by the university. In order to limit the possibility of gaming the system, the Delegation underlined that all named applicants should be eligible for any fee reduction to apply, as was the case with the reductions in items 5(a) and (b) in the current Schedule of Fees. Regarding the discussion in paragraphs 11 to 13 of the document, the Delegation agreed with the comments expressed by the European Patent Office that the International Bureau was underestimating the impact on receiving Offices. For example, additional processing would be required by the receiving Offices under this proposal in tracking the filings once the International Bureau had notified it that a university had reached its annual quota with fee reductions. In addition, where an application contained universities in different fee categories, the receiving Office would need to determine the applicable reduction. Moreover, where the International Bureau had notified a receiving Office that a university had reached its annual limit but that university then filed a further application claiming a fee reduction, the receiving Office would need to send additional notifications to the applicant and collect and forward unpaid amounts to the International Bureau. In this regard, it was conceivable that the costs incurred by the receiving Office in processing of these applications could rise above the amount of the transmittal fee. Consequently, receiving Offices could increase their transmittal fees, resulting in higher costs for all applicants. Nonetheless, the Delegation welcomed the idea of an Understanding, as proposed in paragraph 17 of the document to prevent abuse, but it was not clear whether this was sufficient, or whether additional sanctions should apply where the applicant had claimed a reduction for which it was not entitled. The Delegation also supported the drafting of the proposed sunset clause in paragraph 18(c) of the document, whereby these reductions would cease after a set time period, absent a specific agreement by Member States otherwise. Any fee reductions would therefore only continue if they were warranted and beneficial and there was consensus among Member States to continue the reductions. Finally, in contrast to the comments from the Delegation of Brazil, the Delegation of the United States of America considered that it was within the purview of the Working Group to address costs outside of the statutory fees, for example, this session was discussing a document on the Inventor Assistance Program. Noting that the fees paid to patent practitioners costs associated

with filing and prosecuting a patent application were the main costs in obtaining patent protection, rather than providing inequitably targeted fee reductions to certain institutions, the Delegation suggested that consideration could be given to expanding the Inventor Assistance Program to allow for participation by universities in developing and least developed countries so as to decrease those significant cost burdens associated with PCT filings.

116. The Delegation of Canada stated that it supported the proposal on university fee reductions in principle. However, the Delegation preferred the onus to be on the applicant for claiming a deduction and making the necessary declaration, rather than requiring receiving Offices to consult a list of universities if they suspected a declaration was missing. In keeping with this view, the Delegation suggested adding the following text at the end of paragraph (a) of the sunset clause in paragraph 18 of the document "... for which a declaration was provided". The Delegation also preferred the fee reductions to be limited to applications filed at the receiving Office of the International Bureau, as this would make counting the number of reductions claimed by a university more straightforward. The Delegation also suggested that a rebate mechanism from the university that would occur at the end of the fiscal year at WIPO would eliminate the possibility of granting the fee reduction to more than the permitted number of applications from any given university. A rebate system would also put the onus on the applicant to list the numbers of the applications for which a discount was requested, thus reducing the workload at the International Bureau and potentially all receiving Offices, as well as addressing the difficulties of monitoring numbers of discounts. Finally, the Delegation expressed interest in knowing about any concerns of loss of rights in the case that underpayments went unnoticed by an Office.

117. The Delegation of Australia welcomed the use of the WHED Portal to determine eligibility for university fee reductions and this overcame some of the Delegation's initial concerns about the definition of a university. As the information on universities was collated in a single place through the Portal, this would enable straightforward verification of the university status. The Delegation also supported a sunset provision of seven years to allow sufficient time to analyze the effect of the fee reductions and decide whether to continue them or not. While the Delegation was heartened to hear from the International Bureau that it did not believe that the verification process for the fee reductions would significantly increase the administrative burden on receiving Offices, the Delegation agreed with the remarks by the Delegations of the United States of America and the European Patent Office that their would be additional burden on receiving Offices. The Delegation also aligned itself with the statement made by the Delegation of Germany on behalf of Group B in paragraph 77 in this regard. With regard to the situation of an applicant paying the reduced fee without having submitted the required declaration, as described in paragraph 11(d) of the document, the process of the applicant either paying additional fees or submitting the declaration would be resource intensive. At IP Australia, all fee reconciliation took place through an automatic workbench, which would be need to be adapted to accommodate this procedure. Furthermore, additional work such as training and making updates to internal procedures would be necessary. Consequently, the Delegation did not believe that IP Australia would be ready to implement these changes in time for the proposed start date.

118. The Delegation of France aligned itself with the concerns and difficulties raised, notably by the Delegations of the United Kingdom and the European Patent Office, concerning the operational implementation of the proposal. Consequently, the Delegation stated that the impact of the proposal on receiving Offices needed to be analyzed further to ascertain clearly the issues and additional work for these Offices.

119. The Delegation of Japan stated that it would be necessary to clarify whether the conditions for different fee reductions were fair, based on the perspective of existing users. The financial situations of universities differed from between individual universities within a single country. A university based in a State listed under item 5(a) of the Schedule of Fees might be a

relatively well-financed university. Therefore, it might be inappropriate to use the current country-based criteria in item 5(a) of Schedule of Fees to determine the percentage reductions and ceilings. Moreover, unless the university list on the WHED Portal were regularly updated and provided by the national authority, it was doubtful that International Bureau should use the data. For example, some countries might have a list of domestic universities held by the relevant national authority and these lists should be considered as the list for the country.

120. The Delegation of Portugal restated its support for the Brazilian proposal since it believe that it would stimulate innovation and patenting activity in universities. The document addressed the Delegation's previous concerns and questions in a clear and concrete manner. The Delegation also agreed with the implementation options set out in paragraphs 5 to 13 and with the terms of the proposal set out in paragraphs 15 to 18 of the document.

121. The Delegation of India stated that it accepted the eligibility criteria in paragraph 5 of the document, namely the list of universities held by the International Association of Universities on the WHED Portal. However, the Delegation could not accept the second requirement in paragraph 6 of the document that the institution needed to offer at least a 4-year university degree since there were universities run or accredited by the Government of India with 3-year degree courses. The Delegation supported the eligibility requirements in paragraphs 7 to 9 of the document in case of multiple applicants and paragraph 10 regarding the submission of a declaration to claim eligibility any fee reduction. The Delegation noted that the proposal by Brazil included reductions for the supplementary search handling fee and the handling fee. In the present Schedule of Fees, the eligibility for fee reductions was only checked at the time of filing of the international application. If there were a change in the applicant to an entity that was ineligible for fee reductions, the new applicant could claim a reduction for these fees as there would be no further check for the eligibility. The Delegation therefore requested that the Schedule of Fees be amended to require continued eligibility, with the International Bureau or the International Preliminary Examining Authority, as appropriate, performing this check.

122. In response to the concerns raised by the Delegation of India over the requirement of 4-year courses for an institution to be accepted onto the list, the Secretariat indicated that it was not a requirement that all degree courses offered by a particular university be a minimum of four years for inclusion on the WHED. The Secretariat also clarified that the question of eligibility for reductions in the supplementary search handling fee and the handling fee was not specific to the question of fee reductions for universities, but proposed a clarification of what the scope of existing reductions was intended to be. The different provisions that related to the dates of receipt of the request for supplementary international search and of the demand for international preliminary examination reflected small numbers of relatively low fees. While the International Bureau had proposed to clarify the need for continued eligibility when a supplementary search request or demand for international preliminary examination was filed, this could be removed so that checks would only be performed based on the eligibility at the time of filing, if Member States so wished.

123. The Delegation of China supported the proposal in principle. On the definition of an eligible university for the fee reduction, the WHED Portal provided a good reference but it did not consist of all universities. This could lead to many universities being excluded from fee reductions if the requirement of listing in the WHED was applied strictly. The Delegation therefore suggested that national Offices could be given the option of supplementing the lists on the WHED Portal. The Delegation also supported the 7-year sunset clause, which would allow fee reductions to be introduced for universities and then evaluated before deciding on whether they should continue.

124. In response to the comment from the Delegation of China about universities that were not in the WHED, the Chair stated that the presence of a fee reduction for universities in the PCT could encourage more universities to request inclusion in the WHED and the IAU could add universities to the WHED outside of the normal review cycle. This could also have a wider benefit to society in providing a more comprehensive list of higher education institutions.

125. The Delegation of Brazil responded to some of the comments made by delegations. In terms of updating the WHED, paragraph 6 of the document stated that “the IAU Secretariat ... has confirmed that it is possible for eligible institutions to be added in-between cycles on request”. As for the comments about the additional work by a receiving Office in processing claims for the fee reduction, paragraph 13 of the document stated that one possibility could be to require universities to file international applications at the receiving Office of the International Bureau to claim the fee reduction. While this was not the option preferred by the Delegation and the technical service at the National Institute of Industrial Property of Brazil (INPI-Br) had indicated that it was willing to implement the proposal, one possibility could be to allow receiving Offices that did not wish to implement university fee reductions to send applications directly to the International Bureau. Regarding the different ceilings between universities in developed and developing countries, the Delegation had proposed the limits on the numbers of applications claiming a fee reduction in order to address concerns about the cost of university fee reductions. Referring to Table 3(a) of document PCT/WG/10/2, increasing the fee reduction to universities of 50 per cent with a ceiling of 20 applications per year would result in a loss of fee income to the International Bureau of 3.10 million Swiss francs. The ceiling of five applications per year for universities in developed countries intended to reduce these costs. Lastly, regarding the Inventor Assistance Program (IAP), the presentation of that program had recognized that international filing fees remained an issue as well as attorney costs and national capacities. The proposal was therefore an effort to take useful steps in the context of the PCT. Furthermore, within the WIPO Program and Budget, the Inventor Assistance Program was part of Program 1 – Patent Law, not Program 5 – The PCT System. Concerning the mandate of the Working Group, paragraph 133 of document PCT/A/36/13 stated “should the need arise to consider a matter which required submission to the Assembly, a Working Group of the PCT Assembly should be convened to do preparatory work rather than submitting the matter straight to the Assembly”. Decisions concerning the IAP were therefore not within this mandate.

126. The Chair summarized the interventions on various matters of the proposal. First, there was seen to be some further work needed with regard to use of information held on the WHED Portal of the IAU. If Member States agreed that a university was required to be in the WHED to be eligible for the reduction, Offices would need to communicate this information to universities. Second, various Offices considered implementation of the fee reductions would create additional work for receiving Offices beyond that described in the document. Although passing this work to the International Bureau in its capacity as a receiving Office was possible, this would remove the proximity between the applicant and the receiving Office. While ePCT could include a list of universities that were eligible for the fee reduction that could be accessed through a drop-down menu, there was insufficient time to adapt IT systems in an Office to automate processes before a proposed implementation date of July 2020. Before completion of these IT changes, receiving Offices would therefore need to perform many processes manually, which would create significant additional workload. The Chair commented that postponing implementation by 12 months might therefore allow more Offices to have IT systems in place to reduce the additional workload involved in administering the proposed reduction.

127. Based on the suggestion from the Delegation of Canada in paragraph 116, above, the Chair proposed consideration of a refund mechanism, whereby universities would pay the full international filing fee at the time of filing, but be able to claim a refund from the International Bureau of 50 per cent of the fee for up to five international applications at the end of the year, irrespective of the country in which the university was based. In making this proposal, the Chair pointed out that this could deal with the issues related to quality of applications since the

applicant would be required to pay the international filing fee in full. Receiving Offices would avoid the administrative complexity of handling fee reductions for university applicants since the refunds would only be issued by the International Bureau. Furthermore, by offering a single reduction rate and ceiling for all universities, the proposal provided equal treatment for universities, regardless of location.

128. The Delegation of Canada, speaking on behalf of Group B, enquired about the drafting of the proposal by the Chair. First, Group B asked about the link between the proposed provision that would be added to the Regulations and the details in the Administrative Instructions in terms of their entry into force and their removal in the case of triggering of the “sunset clause”. In particular, where the Assembly had not taken any decision with regard to the provisions by December 31, 2027, Group B stated that the proposed provision in the Regulations would need to be removed at the same time as the Administrative Instructions that provided for the fee refunds. Group B also had some practical questions on the proposal, including whether all applicants would need to be eligible for the refund, how the refund mechanism would work for more than one university, how the refund would work for universities that existed under more than one legal personality and how an application would be treated when it was eligible for other reductions in addition to the fee refund for universities.

129. The Delegation of Indonesia, speaking on behalf of the Asia and Pacific Group, referred to the aims of the proposal by Brazil in document PCT/WG/11/18 Rev., namely: “(i) stimulating the use of the PCT System by universities, and (ii) increasing the geographic diversity in the demands for patent protection and of PCT international application filing activities.” In relation to the proposal by the Chair, the Asia and Pacific Group considered a refund mechanism to be a different concept and questioned whether the requirement for a university to pay the full international filing fee upfront would achieve the aim of stimulating the use of the PCT System by these applicants. As the nature of the proposal was different and full details of the refund process were not yet available, the Asia and Pacific Group stated that some delegations would not be able to reach a position on the proposal without consultation with capitals. Moreover, for public universities, a refund mechanism could create accounting problems if the refund was not made in the same accounting year as the original fee payment. Furthermore, the equal treatment of universities from both development and developed countries did not mean fair treatment of all universities. The Asia and Pacific Group was therefore unconvinced that an equal refund level and ceiling for universities between developing and developed countries would achieve the aim of the proposal in increasing geographical diversity in international patent applications.

130. The Delegation of Guatemala, speaking on behalf of the Group of Latin America and the Caribbean (GRULAC) stated that the proposal by the Chair differed from the original proposal by Brazil. In addition to the accounting problems linked to the fee payment and refund potentially taking place in different fiscal periods, there would be further difficulties with increased administrative costs for universities in claiming refunds and issues with exchange rates.

131. The Delegation of South Africa, speaking on behalf of the African Group, stated that the African Group had supported the original proposal by Brazil, which it believed to be sensible and timely as it would pave the way for more innovation by universities, which was essential for tackling some of the pressing problems that the world faced. In supporting the original proposal, the African Group had made wide consultations. While appreciating the efforts to find a workable solution, since the proposal by the Chair contained significant differences from the original proposal, it would be necessary for delegations in the African Group to consult again with capitals. Although the proposal maintained a reduction of 50 per cent for universities from developing countries, albeit being administered through a refund, the decrease in the number of applications from a single university to five per year was a substantial change.

132. The Delegation of the Russian Federation, speaking on behalf of the Group of Central Asian, Caucasus and Eastern European Countries (CACEEC) stated that the proposal by the Chair was different from the original proposal by Brazil. While CACEEC agreed with the 50 per cent reduction applying to all universities, there was a need to consult further on the reduced limit of five applications from any university in a given year. Moreover, as many universities from the regional group were State universities, a system of reimbursement could be difficult to apply. Moreover, the proposal required further development. CACEEC therefore believed that the matter should be deferred to the next session of the Working Group.

133. The Delegation of Brazil thanked the Chair for the efforts to find a compromise solution with regard to university fee reductions. While the consultation that the International Bureau had issued in Circular C. PCT 1554 had provided the opportunity for Member States and other stakeholders to express any preoccupations about implementing fee reductions for universities, some delegations had raised further concerns during the present session. The Delegation believed that the Working Group had made much progress with the proposal and was as close as ever to reaching an agreement. The Delegation supported the statement made by the Delegation of Guatemala on behalf of the Group of Latin America and the Caribbean (GRULAC) and acknowledged that a refund mechanism could create administrative burden and accounting problems. In terms of the proposal by the Chair, the Delegation was flexible with the level of the fee reduction and would not block the proposed 50 per cent reduction for all universities, but it would have financial consequences for the International Bureau. However, the Delegation explained that it had proposed the different rates for universities in developing and developed countries bearing in mind the Preamble of the PCT which stated: “desiring to foster and accelerate the economic development of developing countries ... by facilitating access to the ever expanding volume of modern technology.” While access could be facilitated by publication of a patent application under the PCT, the goal could mainly be furthered by the development of technology in developing countries. Therefore, the rationale behind the original proposal was to provide extra incentive to developing countries in that regard. In terms of the threshold of five international applications per year, this could be useful for small universities located away from the main economic centers of a developed country in regions where there was a need to attract more economic investment. On the other hand, a higher ceiling for universities in developed countries would have a significantly greater cost, as reported by the International Bureau in document PCT/WG/10/2, as well as benefitting primarily larger universities which already filed many international applications. The Delegation concluded by expressing willingness to consult further to address the outstanding issues and reach a decision on the proposal.

134. The Delegation of Iran (Islamic Republic of) thanked the Chair for putting forward the new proposal. The Delegation aligned itself with the statement made by the Delegation of Indonesia on behalf of the Asia and Pacific Group with regard to the difficulties of implementing a refund mechanism and in relation to the view that an equal refund level for all universities was not in line with the original objective of the proposal by Brazil. The Delegation therefore indicated a preference to continue with discussions on the original proposal and seek solutions to address comments from delegations.

135. The Delegation of Zimbabwe aligned itself with the statement made by the Delegation of South Africa speaking on behalf of the African Group. The Delegation had supported the original proposal by Brazil. However, the proposal by the Chair appeared to be a new one and deviated substantially from the original. While the Delegation was open to continuing consideration of the proposal by Brazil, it had difficulty negotiating the Brazilian proposal under the auspices of the new proposal by the Chair.

136. The Chair explained that the refund mechanism had been proposed to deal with two issues in the original proposal by Brazil: the administrative complexity for receiving Offices and the perception by some delegations that more poor quality patent applications would enter the PCT System. As for the proposed 50 per cent reduction for all universities, about half of the

international filing fee covered the processing costs, with the other half being used to support other activities at WIPO. Therefore, a 50 per cent reduction would avoid significant losses for the International Bureau in terms of the processing of international applications. Moreover, the simulations in document PCT/WG/10/2 showed that any ceiling above five applications per year would bring about losses to WIPO of more than 2 million Swiss francs, which was unlikely to be acceptable to the Working Group as a whole. While the Chair acknowledged that refunds were problematic to administer, an upfront reduction would also create additional administrative burden. In light of the concerns expressed by some regional groups and delegations, the Chair invited delegations to consider how to take the proposal forward.

137. The Delegation of Indonesia, speaking on behalf of the Asia and Pacific Group, indicated that refunds were a possibility, but many aspects of this idea required clarification. For example, it would be problematic to have a refund in a different fiscal year from the fee payment. In addition, it was important to have draft Administrative Instructions to see how refunds might work in practice. The Asia and Pacific Group did, however, have more difficulty accepting an equal treatment of universities from developing and developed countries as this did not mean fair treatment of all universities. Moreover, the Asia and Pacific Group did not accept the argument that higher upfront fees would raise the quality of patent applications.

138. After further informal discussions with regional coordinators, the Chair concluded that there was no consensus on a way forward. For some universities, particularly in developing countries, it would be difficult to refund the university and the money would instead be refunded to the government at large. This would remove the benefit of the fee reduction from the university, which would defeat the purpose of the proposal. There was more flexibility in relation to the proposed reduction level of 50 per cent and ceiling of five universities. There had also been informal discussions regarding a voucher-type system for fee reductions where the International Bureau would issue a defined quota of vouchers to Offices for an upfront reduction in the international filing fee, with Offices distributing the vouchers to relevant institutions, such as universities, small and medium-sized enterprises, individual applicants etc. This might be considered at another session of the Working Group, but there was no consensus on either the options set out in document PCT/WG/12/21 or the proposal by the Chair.

139. The Delegation of Brazil regretted that agreement had not been possible at the session on the university fee reduction proposal. In particular, the Delegation expressed concern at the lack of constructive spirit shown by some delegations from Group B, especially the Delegations of Switzerland, Germany and Denmark. These delegations had argued that the fee reductions were not the best way of incentivizing innovation and patenting activity in universities. However, as no concrete evidence had been provided, this was at best, a belief. Offices would only know the concrete results of any fee reductions if they were actually implemented. On the other hand, the Delegation of Brazil had referred at this session and previous sessions to economic literature underlying the proposal, along with estimates from the WIPO Chief Economist that universities were far more price sensitive to fee changes than other applicants. In addition, a study from the European Commission had identified patent filing costs as the main barrier to patenting activity by universities. In spite of such strong evidence in favor of fee reductions for universities, the Delegation had shown flexibility over the years, listened to the reasonable concerns being expressed by other delegations and incorporated potential solutions to those concerns in the proposals. For this session, in particular, the International Bureau had prepared document PCT/WG/12/21 that proposed implementation options in light of the comments from these countries. However, despite the opportunity for Member States and IP Offices to express their concerns about university fee reductions in responding to Circular C. PCT 1554, the Delegation expressed surprise to hear new concerns that had not been expressed in replies to the Circular. The Delegation had continued to show a constructive spirit of flexibility in order to find a satisfactory solution, but regrettably, this had not been possible. On a more positive note, the Delegation appreciated the fact that the vast majority of PCT Member States had expressed their full support to the fee reduction proposal. This support had come from countries from

different regions and levels of economic development and across different regional groups. This support showed a clear understanding on the need of using fee reductions to increase access to the PCT by universities. As the Delegation had previously expressed, the text of the PCT was clear since among the goals of the Treaty as described in the Preamble were, “to make a contribution to the progress of science and technology”, which was fully in line with the rationale of the discussion. As for the refund mechanism proposed by the Chair, the Delegation acknowledged the interesting discussions on this idea and was thankful for the creative efforts to address the concerns and overcome the opposition to its proposal. However, these discussions had raised the likely administrative burden that would be put on the universities, which would defeat the purpose of the proposal to facilitate and not hinder access to the PCT System. There were also other practical difficulties arising from such a mechanism such as bank fees, exchange rates and accounting matters. In any case, consensus had not been possible at this session. The Delegation concluded by stating that it would carefully consider the result of this meeting and would revert back at the thirteenth session of the Working Group. The Delegation urged those delegations blocking the consensus to agree on a measure that would be fully in line with the mission of WIPO and the higher goals of the patent system.

140. The Delegation of Canada, speaking on behalf of Group B, indicated willingness to engage on the compromise on fee reductions for university applicants proposed by the Chair, noting the questions that Group B had raised. Group B acknowledged and appreciated the efforts by the Chair during the session to seek to bridge differences on this issue.

141. The Working Group recognized that document PCT/WG/12/21 had been a positive step forward that had enabled progress in the consideration of a possible fee reduction to increase access to the PCT by universities. However, the Chair concluded that there was no consensus for either the options set out in document PCT/WG/12/21 or the alternative that had been proposed by the Chair. It would remain open to the Delegation of Brazil or any other member of the Working Group to bring further proposals to the next session.

#### **CRITERIA FOR FEE REDUCTIONS TO CERTAIN APPLICANTS FROM CERTAIN COUNTRIES, NOTABLY DEVELOPING AND LEAST DEVELOPED COUNTRIES**

142. Discussions were based on document PCT/WG/12/11.

143. The Delegation of the United States of America noted that in the current review cycle, based on the growth in their economies, four countries had moved upwards in the categories of the Schedule of Fees: two from the level described in item 5(a) and two from the level described in item 5(b). The Delegation suggested that the patent system had played some part in these developments. Referring to paragraph 16(c) of the document, the Delegation expressed satisfaction that the measures previously adopted to clarify the eligibility of applicants for fee reductions had been effective. The Delegation also observed in paragraph 16(b) of the document that the variations in effects between different countries showed that filing behaviors were also affected strongly by factors other than fee reductions. Overall, the Delegation believed the fee reductions available under item 5 of the Schedule of Fees were effective and therefore the criteria should be maintained and reviewed again in five years' time.

144. The Delegation of Brazil stated that, like the Delegation of the United States of America, it was encouraged by the results of the measures that had been introduced to combat fraud and misrepresentation. In terms of the data, the Delegation believed that natural persons represented a relevant proportion of applications from beneficiary countries, including upper middle-income countries such as Brazil, Mexico and Turkey. The data also demonstrated the positive effects on filing behavior of targeted fee reductions. Sharp decreases in filing by natural persons had occurred in two countries whose nationals and residents lost entitlements to PCT fee reductions in 2015. By contrast, in countries that had gained access to fee reductions, there was, on average, an increase in filings of applications from natural persons of 8 per cent in the first year and 50 per cent in the second year after introduction of the fee

reduction. The Delegation pointed out that these increases included one country that had experienced a strong financial crisis, which could potentially explain the sharp decrease of 61 per cent in the number of applications. The Delegation concluded by emphasizing that the document confirmed the positive effect on filing behavior after introducing a fee reduction and the negative effect from eliminating a fee reduction. The Delegation therefore supported maintaining the criteria in item 5 of the Schedule of Fees for a further five years and performing a review at that time.

145. The Delegation of Portugal stated that Portugal was one of the 10 States whose natural persons had become eligible for a 90 per cent fee reduction in 2015. This had been an important measure to stimulate patenting activity of natural persons. The Delegation therefore agreed with the proposal in paragraph 17 of the document to maintain the criteria in item 5 of the Schedule of Fees and review the criteria again after five years.

146. The Delegation of Canada enquired whether an amendment was required to item 5(a) of the Schedule of Fees due to the United Nations no longer publishing a list of constant 2005 United States dollar values for gross domestic product. The Delegation also suggested that the International Bureau follow up with the States affected by the change to the criteria in item 5(a) in 2015 for their comments to determine whether the fee reduction had been effective, which would provide evidence beyond the numerical data.

147. In response to the query from the Delegation of Canada, the Secretariat indicated that it would prefer not to amend the Schedule of Fees since the concept had been agreed and adjustment figures continued to be published that made it straightforward to calculate the required values.

148. The Delegation of Japan stated its support for the proposal to recommend to the PCT Assembly that the criteria in item 5 of the Schedule of Fees be maintained and reviewed again in five years.

149. The Delegation of United Arab Emirates, as a State whose natural persons had ceased to be eligible for fee reductions from 2015, supported the suggestion made by the Delegation of Canada to obtain comments from those States affected by the changes in 2015 to assess the impact and this should include those that had ceased to be eligible. However, the Delegation would go along with the consensus for the Assembly to review the criteria in five years' time. The Delegation also raised the question about the use of the term "developing countries" in the title of the document. Although United Arab Emirates was no longer eligible for fee reductions under item 5(a) of the Schedule of Fees, the Delegation considered that United Arab Emirates remained a developing country. At the same time, some high-income and developed countries would still be listed in item 5(a) of the Schedule of Fees.

150. In relation to the query concerning the term "developing countries" in the title of the document, the Secretariat observed that this term had been used for several years while the Working Group had considered a proposal to review the criteria for fee reductions. While the proposal had been generally aimed at "developing countries", the International Bureau acknowledged that there was no single United Nations definition of a "developing country" and that the criteria for fee reductions under item 5(a) were decided by PCT Member States.

151. The Working Group agreed to recommend to the Assembly that the criteria under Item 5 of the PCT Schedule of Fees be maintained, and that the Assembly should review the criteria again in five years' time.

## COORDINATION OF TECHNICAL ASSISTANCE UNDER THE PCT

152. Discussions were based on document PCT/WG/12/22

153. The Delegation of Brazil underlined the importance of technical assistance as a tool to enable the use of intellectual property towards development and to increase the technical capabilities of national and regional patent Offices of PCT Contracting States. In line with Recommendation 1 of the WIPO Development Agenda, technical assistance needed to be development-oriented, demand-driven and transparent, taking into account the priorities and special needs of developing countries. In the PCT, technical assistance was the subject of Article 51, which set out the establishment of a Committee for Technical Assistance. The extensive nature of the PCT across programs demonstrated its contribution to WIPO and its overarching importance to Member States. The Delegation commended the International Bureau for the document and for supporting the work undertaken by other WIPO bodies regarding technical assistance.

154. The Delegation of Iran (Islamic Republic of) expressed appreciation for the information on technical assistance. Technical assistance stemmed from the mandate of WIPO, which was, *inter alia*, to promote the protection of IP throughout the world through cooperation among States. To achieve this mandate, delivery of development-orientated and country-specific technical assistance was highly relevant. WIPO technical assistance programs and projects played a significant role in implementation of the Development Agenda Recommendations, in the development of country plans and in improving the functions of IP Offices. Iran had been among the countries that had benefited from technical assistance carried out by Secretariat under the supervision of PCT or other WIPO bodies. The Delegation concluded by reiterating that the function of the PCT in terms of technical assistance for developing countries was invaluable.

155. The Working Group noted the contents of document PCT/WG/12/22.

## INVENTOR ASSISTANCE PROGRAM

156. Discussions were based on document PCT/WG/12/4 and a presentation on the Inventor Assistance Program (IAP) by the International Bureau<sup>2</sup>.

157. The Delegation of the United States of America stated that the United States Patent and Trademark Office (USPTO) had a patent *pro bono* program similar to the IAP, where inventors in small businesses that met certain financial thresholds and other criteria could be eligible for free legal assistance in preparing and filing patent applications. The USPTO had worked closely with the intellectual property law associations to establish a nationwide network of independently operated regional programs that matched volunteer patent professionals with financially under-resourced inventors and small businesses for the purpose of securing patent protection. Each regional program provided services for residents of one or more States. Through these programs, independent inventors in small businesses could connect with volunteer-registered patent practitioners across the United States of America who could assist them with navigating the process of obtaining a patent. The Delegation believed that by providing patent filing and prosecution services free of charge, programs like the IAP and the USPTO patent *pro bono* program supported patent quality and reduced the instances where inventions were left unexamined due to the lack of financial resources. The Delegation concluding by asking the Secretariat about the composition of the Steering Committee in the IAP and how its members were selected and about the matching between users and practitioners, pointing out that under the USPTO *pro bono* patent program, users were matched with patent attorneys from their own State or local region.

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<sup>2</sup> The presentation is available on the WIPO website at:  
[https://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=438415](https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=438415).

158. In response to the question from the Delegation of the United States of America on the composition of the Steering Committee, the Secretariat informed the Working Group that the Steering Committee had 10 members. Membership reflected the different stakeholders involved such as inventors, patent attorneys, governments, leaders in the international community with experience in *pro bono* work and sponsors of the IAP, and took into account the specific knowledge and experience of the individuals. There were two representatives of the beneficiary countries in the Steering Committee, with representation rotating between the participating countries. Similarly, the jurisdictions of the patent attorney representatives were decided on a rotational basis. The Steering Committee included staff at the USPTO, noting that its experience with *pro bono* programs enabled the representative to provide specific knowledge to the Committee.

159. In response to the question from the Delegation of the United States of America about matching between users and practitioners, the Secretariat confirmed that the IAP, similar to the patent *pro bono* program at the USPTO, was aimed at “matching” inventors with local patent attorneys to assist in the drafting and prosecution of the first national filing. If the application later resulted in the filing of a PCT application and national phase entries before the USPTO or EPO, that local attorney would be “matched” with a *pro bono* patent attorney to assist in the prosecution of the application before those designated Offices. In this context, the representative of a user group emphasized the importance of “pairing” the local patent attorney as early as possible with the *pro bono* attorney, ideally already in the early stages of drafting the application, so that the local attorney could learn and benefit as early as possible from the drafting skills of the *pro bono* attorney.

160. The Delegation of Colombia stated that Colombia had been one of the first participants in the IAP, beginning in the second half of 2015. WIPO had recently recognized one of the inventors from Colombia for an invention that had been developed through the IAP. Overall, the IAP had been successful, resulting in the grant of five patents in Colombia.

161. The Representative of the Asian Patent Attorneys Association (APAA) stated that the intent of the IAP was well-placed, but APAA members had concerns about its implementation. In particular, there could be potential for undercutting or stifling the development of local attorneys, with a distinction made between the prosecution and drafting of patent applications. APAA members covered a large geographic area with many developing countries, where APAA would like to see increased skill sets of attorneys. APAA therefore requested clarification on whether the IAP could involve bypassing the local attorney in terms of drafting a patent. In this regard, the Representative suggested that if the local attorney in a jurisdiction of a beneficiary country did not have the patent drafting skills the attorney could be paired with an attorney outside the jurisdiction with the necessary drafting skills. This would maintain the relationship between the local attorney and the inventor. At the same time, the relationship between the two attorneys would result in better understanding of IP, improved drafting skills and wider global experience with an attorney outside the jurisdiction. Finally, the Representative informed the Working Group that the Institute of Patent and Trademark Attorneys of Australia had a system where members provided *pro bono* advice to enable an inventor to have assistance on the IP system, which had been of great assistance to inventors.

162. The Secretariat, in response to the comments by the Representative of APAA shared the concerns about the drafting skills of local patent attorneys. The IAP intended to reinforce the capacities of local attorneys so that there would be patent specialists in every jurisdiction that would be able to prepare and file patent applications on behalf of residents. In terms of international applications under the PCT, it was possible for a local patent attorney to work together with a *pro bono* patent attorney in another jurisdiction, such as Europe or the United States of America. The local attorney would file the international application, with the other attorney being involved for entry into the national phase. However, contact between the two

attorneys could take place at an early stage, for example, in helping to file the international application, which could improve local skills and the quality of international application.

163. The Representative of the Institute of Professional Representatives before the European Patent Office (epi) noted that, to date, members of the epi had assisted in respect of two applications seeking patent protection in Europe. Furthermore, the epi actively encouraged European patent attorneys to participate in the IAP by assisting applicants who sought patent protection in Europe.

164. In reply to a query from the Delegation of Switzerland about the procedures for countries wishing to join the IAP, the Secretariat indicated that the WIPO website provided further details of the requirements and commitments for an interested country. In particular, the country needed to have a low number of patent filings, particularly from residents, and an indication of a high rate of rejection of applications on formal requirements. In the application to join the IAP, a country was required to indicate actions that it would undertake to promote the program and show that local patent attorneys were willing to assist with the work of the IAP. Furthermore, all participants had to accept the IAP guiding principles. The International Bureau reviewed requests to join the IAP, which it then submitted to the Steering Committee for a decision. At present, there were seven requests by Member States under review. The resources available to the International Bureau only allowed the implementation of the IAP in two or three countries per year, but additional resources could be made available should the demand for participation increase strongly.

165. The Working Group noted the contents of document PCT/WG/12/4.

## **TRAINING OF EXAMINERS**

### **(A) SURVEY ON PATENT EXAMINER TRAINING**

166. Discussions were based on document PCT/WG/12/6.

167. The Delegation of Australia underlined the importance of examiner training in improving patent quality as a means of forging bonds in the international IP community. Collating the various training programs and offerings of respective Offices had set an important value in providing transparency on training activities around the world. With this in mind, IP Australia had reported on its experience in delivering patent examiner training through the Regional Patent Examiner Training (RPET) program or participating in training supported by Funds-in-Trust to help improve these compilations. IP Australia was an advocate for eLearning, having used an eLearning program, the self-paced training and examination of patents (STEP) program for training in-house patent examiners since the beginning of 2015. The STEP program was modeled on the material used by the RPET team to train patent examiners and had shown exceptional value domestically and abroad. The Delegation supported the proposal in paragraph 23 of the document for a one-time survey on policies of IP Offices with regard to e-learning resources and looked forward to providing information on its resources and policies on this subject. The Delegation also supported the proposal to conduct future patent examiner training surveys biennially instead of annually to reduce the workload of offices for reporting while maintaining transparency, as proposed in paragraph 28 of the document.

168. The Delegation of the United States of America affirmed its support for technical assistance for developing countries and least developed countries with respect to examiner training. Over the years, the United States Patent and Trademark Office (USPTO) had conducted a number of examiner training programs on search and examination procedures, both at the USPTO headquarters and in various countries. The USPTO continued to offer this training through its Global Intellectual Property Academy, where patent programs focused on topics including administration, budgeting, examination procedures and operational procedures. In 2018, the USPTO had provided training for representatives from IP Offices from numerous

countries, including Egypt, India, Indonesia, Jordan, Kuwait, Pakistan and Chinese Taipei. The USPTO also made available online training materials through its website. Finally, the USPTO had no objection to the proposed eLearning resources survey or the proposal to change the annual report on examiner training to a biennial report.

169. The Delegation of the United Kingdom stated that while the United Kingdom Intellectual Property Office did not fully utilize the potential of e-learning for examiner training, the UKIPO would be interested in how other Offices utilized this medium and the benefits and challenges associated with it. The Delegation therefore supported the proposal for the International Bureau to carry out the survey on e-learning. The Delegation also supported the proposal to switch to biennial requests for information on examiner training, which would help reduce workload and could encourage more Offices to partake in future surveys.

170. The Delegation of Japan referred to the Operational Patent Examination Training (OPET) program provided by the Japan Patent Office, as cited in paragraph 9 of the document. The program had been running each year since 2009 from the Office's own budget. Lasting two to three months, the OPET program involved patent examiners from Asia, Africa and South American countries and was highly appreciated by the trainees every year. The Japan Patent Office would continue to implement the program in 2019. The Delegation also informed the Working Group that Japan had expanded its Funds-in-Trust for Asia and Africa to global funds and planned to increase the amount of these Funds-in-Trust. The Delegation looked forward to cooperation with the International Bureau in utilizing these funds effectively.

171. The Delegation of China appreciated the efforts by International Bureau in the coordination of patent examiner training and continued to support this work. The Delegation reported that the China National Intellectual Property Administration would continue to make use of Funds-in-Trust to provide training to examiners in developing countries and would make specific plans in this regard. Furthermore, the Delegation agreed with the proposal for the International Bureau to change the frequency of the survey from annually to biennially.

172. The Delegation of Canada supported the proposals in the document to carry out a one-time survey on policies of IP Offices concerning e-learning resources and to conduct the examiner training survey biennially instead of annually.

173. The Working Group:

- (a) noted the contents of document PCT/WG/12/6;
- (b) approved the proposal that the International Bureau should carry out a one-time survey on policies of IP Offices with regard to e-learning resources, as set out in paragraph 23 of document PCT/WG/12/6; and
- (c) approved the proposal that the International Bureau should conduct future surveys on patent examiner training biennially, with the next survey taking place in 2021 to report on activities in 2019 and 2020, as set out in paragraph 28 of document PCT/WG/12/6.

## (B) COORDINATION OF PATENT EXAMINER TRAINING

174. Discussions were based on document PCT/WG/12/5.

175. The Secretariat provided an update on the development of a competency framework and learning management system by continuing cooperation with IP Offices in the Asia and Pacific Region. This cooperation intended to complement other examiner support activities, such as the Regional Patent Examiner Training (RPET) program provided by IP Australia. The

Secretariat also stated that discussions were taking place involving the Regional Bureau of Latin America and the Caribbean to explore the possibility of a similar project in that region.

176. The Delegation of the Philippines provided an update on its cooperation with the International Bureau in developing a custom site of the Learning Management System (LMS) at the Intellectual Property Office of the Philippines (IPOP HL). Having successfully installed a local web-based Moodle site and integrated some e-learning content, IPOP HL would be configuring functionalities and plug-ins to develop this content further towards supporting management of competency-based training of its patent examiners. The LMS tool would complement the training infrastructure developed under the RPET program organized by IP Australia. The Delegation stated that it would be willing to share its experiences with improving the coordination of patent examiner training to other medium-sized and small IP Offices that were willing to embark on a similar endeavor and could provide access to its web-based site for such interested Offices on request.

177. The Delegation of Australia supported the development of a competency framework and learning management system for training patent examiners and appreciated the compatibility with IP Australia's ongoing training programs such as RPET mentoring. The Delegation believed that the amount of skills covered by the competency framework would help reduce duplication of training and coordination of training from different sources since a trainer would be able to search the framework to identify training needs.

178. The Delegation of Canada thanked the Intellectual Property Office of the Philippines and the Intellectual Property Corporation of Malaysia for their involvement in the development of a framework of technical competencies for substantive patent examiners and a learning management system. The Delegation supported these efforts, which would improve the effectiveness of the training offered by donor Offices and the success of participating examiners from beneficiary Offices.

179. The Working Group noted the contents of document PCT/WG/12/5.

## **SAFEGUARDS IN CASES OF OUTAGES AFFECTING OFFICES**

180. Discussions were based on document PCT/WG/12/17.

181. The Delegation of the European Patent Office, in introducing the document, explained that there was no provision in the PCT allowing Offices to excuse applicants not meeting a time limit to submit a document or fee payment when their filing systems were down, unless applicants requested an excuse for the delay on a case-by-case basis under Rule 82. *quater*.1. While Offices could apply national procedures to complement those of the PCT, the present situation had disadvantages. First, applicants had to rely on a heavy and costly procedure to excuse a delay under Rule 82. *quater*.1 and potentially justify decisions to excuse delay in the national phase. And second, there were disadvantages for Offices since they needed to assess requests from users on a case-by-case basis under Rule 82. *quater*.1, which was a burdensome procedure. This added potential uncertainty when such an application entered the national phase in view of the lack of information being publicly available. The proposal in the document therefore aimed to address this situation in a manner that provided flexibility for Offices yet helped convergence of practices and greater legal certainty and transparency. The proposals generally mirrored those in Rule 82. *quater*.1, but there was flexibility for Offices as Rule 82. *quater*.2(a) was a "may" provision. In addition, applicants would not be required to submit evidence to Offices, but instead would only be required to refer to the period of non-availability of electronic communication means, as published by the Office and notified to the International Bureau. Furthermore, the excuse in delay would be limited until the filing systems were up and running again. To address various concerns that had been addressed informally to the European Patent Office prior to the session, the Delegation suggested that the second sentence of its proposed Rule 82. *quater*.2(a) could be deleted, if necessary, and the issues addressed

elsewhere, such as in the Receiving Office Guidelines. Furthermore, improvements were suggested for clarity of the first sentence, so that (if the second sentence were indeed deleted) the proposed paragraph would read:

“(a) Any national Office or intergovernmental organization may provide that, where a time limit fixed in the Regulations for performing an action before that Office or organization is not met due to the unavailability of any of the permitted electronic means of communication at that Office or organization, delay in meeting that time limit shall be excused, provided that the respective action was performed on the next working day on which the said electronic means of communication were available. The Office or organization concerned shall publish information on any such unavailability including the period of the unavailability, and notify the International Bureau accordingly.”

182. The Delegation continued by clarifying that the proposal related only to failures in electronic services and not to paper transmissions. On this subject, some Offices did not consider the date of mailing as stamped by the postal services as the date of receipt of a document under the PCT, but rather than the date stamped when the document arrived at the Office. Furthermore, it would allow an Office to trigger the relevant provisions even if only one of several possible services were unavailable, or if an action could be taken before the International Bureau as well as before a receiving Office. In this respect, it was not always practical for an applicant to change to a different mode or destination for the transmission of a document at short notice. Finally, the period for declaring an outage would be left to the judgement of the Office according to its own criteria.

183. The Delegation of the United States of America stated that its three concerns had been addressed in the introductory remarks made by the Delegation of the European Patent Office. First, the proposal was a “may” provision, which did not impose an obligation on Offices to proceed in a particular manner and allowed each Office to determine what would constitute an outage under its own legal framework. Second, the sentence containing references to “scheduled maintenance” could be deleted from the provision. Third, the introduction had touched on the question of whether an applicant would be able to benefit from this safeguard in the case where a document could have been submitted to either the local receiving Office or to the International Bureau. The delegation did not have strong views on this matter, but it was essential that the provisions were clear. The Delegation concluded by indicating its support for the Working Group to recommend adoption of the proposal by the Assembly in 2019.

184. The Chair confirmed his understanding that the proposed new Rule 82 *quater*.2 made implementation optional for Offices, that it permitted Offices to offer relief in cases where only one of several electronic means of communication was unavailable and where a document was permitted to be furnished either to the receiving Office or to the International Bureau. Furthermore, Offices would determine, using their own criteria, whether a relevant outage had been considered to have taken place.

185. The Delegation of France explained that in the case of outages at the National Institute of Industrial Property (INPI) in France, an applicant was required to resubmit the document by fax within two days to rectify the situation. As the proposed rule differed from national practice in France, it was important that it was optional to avoid differences in practices between national and international applications.

186. The Delegation of Spain stated that the principal beneficiaries of the proposal in the document would be applicants affected by a delay in the online services of an Office, did not have time to react and consequently might lose their rights. As time limits for submitting documents at an Office often expired at midnight, in the event of an outage close to the time limit, IT maintenance staff might not be available to restore the service, resulting in electronic

filing only returning to operation the following morning. The Delegation therefore supported the proposed Rule 82*quater*.2.

187. The Delegation of the Republic of Korea expressed the view that the proposal had become more important than before as the International Bureau would cease to accept facsimile communications from the end of 2019. The Delegation appreciated the flexibility that allowed Offices to determine the situations where it could excuse a delay. As it could be difficult for the Republic of Korea to allow a delay to be excused due to scheduled maintenance, the Korean Intellectual Property Office might restrict the conditions when a delay would be excused due to unavailability of electronic means of communication to unforeseen outages.

188. The Delegation of Canada stated that the proposal had taken into account several of its earlier concerns. While accepting the proposals, the Delegation informed the Working Group that the Canadian Intellectual Property Office would need to decide how it treated applications in the national phase. The proposed Rule 82*quater*.2(b) did not require designated and elected Offices to accept the extension in meeting time limits if information regarding the reasons for the delay were not published before national phase entry. It would therefore be essential for the notification and publication of information to be prompt to avoid loss of rights by applicants in relation to events occurring shortly before national phase entry, adding uncertainty for applicants and other users. In addition, while Rule 82*quater*.2(b) permitted an office not to recognize the extension in a given situation it was not clear if a court would be so limited, which could be especially problematic for priority claims.

189. The Delegation of Japan supported introducing a legal basis to the PCT System for Offices to excuse delays in meeting time limits when electronic means of communication permitted by the Office were not available, noting that more and more documents were transmitted electronically. However, the Delegation stressed that decisions made during the international phase could affect not only applicants, but also designated States and third parties. Accordingly, new rules introduced allow for an excuse of delay needed to ensure transparency, legal predictability and accountability. The Delegation requested that the new rules should use the same expressions as in Rule 82*quater*.1(a), “the receiving Office, the International Searching Authority, the Authority specified for supplementary search, the International Preliminary Examining Authority or International Bureau”. It was also preferable to provide that the International Bureau should publish the information about the outage. Moreover, the Delegation believed that details regarding implementation of the proposal should be provided in the Administrative Instructions, rather than in the Receiving Office Guidelines, including the information that an Office should publish in the case of an outage. For example, if the office has more than one electronic filing facility, some Offices might only excuse a delay when all facilities were disconnected, while other Offices might excuse delays when only one of the electronic filing facilities was unavailable.

190. The Chair, in response to the comments by the Delegations of Canada and Japan, pointed out that each Office would be required to publish a formal notification of the unavailability of their systems and notify the International Bureau. The Delegation acknowledged that if the publication did not take place promptly, another Office might not know the reasons for excusing the delay. Nevertheless, this information would eventually be published.

191. The Delegation of China supported the proposed amendment to allow an Office to excuse the delay of applicants in the case of technical outages at that Office, adding that this would increase the friendliness and increase the legal certainty of the PCT System.

192. The Representative of the International Institute for Intellectual Property Management (I3PM) stated its support for the proposed new Rule 82 *quater*.2. The proposal was a clear improvement to the present situation regarding outages in electronic services at an Office and would make the PCT System more applicant-friendly.

193. The Representative of the Institute of Professional Representatives Before the European Patent Office (epi) supported the proposal to address unavailability of electronic means of communication from the recipient point of view. As unavailability in electronic communications could also occur from the side of the sender, the Representative underlined the opposition of user groups to abolishing transmission by facsimile services.

194. The Representative of the International Federation of Intellectual Property Attorneys (FICPI) supported the proposal to provide for an excuse of delay in the case of outages affecting Offices. In expressing gratitude to the European Patent Office for the proposal the Representative referred to a FICPI Resolution of the Executive Committee passed at its meeting from March 31 to April 4, 2019 titled "Online Filing Systems". The Resolution "... urges procedural and legal safeguards for users in case of problems with the online filing systems to prevent failure to meet a deadline or other loss of right, and encourages IP Office to communicate promptly and clearly with users when there are issues with the online filing systems, and to keep a public record of such issues".

195. The Working Group approved proposed new Rule 82 *quater*.2 of the Regulations, as set out in the Annex to document PCT/WG/12/17 and modified under paragraph 181, above, for submission to the Assembly for consideration at its next session in September-October 2019.

#### **PROPOSAL TO PROVIDE FOR CORRECTION OR ADDITION OF INDICATIONS UNDER RULE 4.11**

196. Discussions were based on document PCT/WG/12/8.

197. The Delegation of the United States of America introduced the document by explaining the two parts of Rule 4.11(a). Rule 4.11(a)(i) provided for the applicant to indicate in the request form that the international application be treated either not for the grant of a patent but for the grant of another kind of protection, or for the grant of more than one kind of protection. Rule 4.11(a)(ii) provided for the applicant to indicate in the request form that the international application be treated either as a continuation or a continuation-in-part of an earlier application. However, there was no legal provision in the PCT or its Regulations for the correction or addition of such indications during the international phase. As such, applicants who needed to make such corrections or additions had to rely on the discretion of individual receiving Offices as to whether to allow the correction or addition. The document therefore proposed a specific legal basis for making a correction or addition of an indication in Rule 4.11 within a period that would ensure inclusion in the international publication through a proposed new Rule 26 *quater*, as set out in Annex I to the document. The proposal had been supported at the twenty-sixth session of the Meeting of International Authorities in February 2019. Referring to Annex II to the document, the Delegation of Germany had provided further modifications to proposed new Section 419 *bis* of the Administrative Instructions to deal with the processing of corrections or additions under the proposed Rule 26 *quater*, which the International Bureau would take into account when consulting on the implementation of the provisions by way of a PCT Circular.

198. The Delegation of the European Patent Office supported the proposal, which would be beneficial for applicants as well as for the third parties since it would facilitate the correction or addition of indications under Rule 4.11 already in the international phase, thus ensuring the inclusion in the international publication. The Delegation believed that this would further strengthen the PCT System, especially in the United States of America.

199. The Delegation of Israel supported the proposal in the document.

200. The Delegation of India supported the proposal in the document to provide a specific legal basis for the correction or addition of indications under Rule 4.11.

201. The Delegation of Germany supported the proposal and thanked colleagues at the United States Patent and Trademark Office for taking into account the concerns that it had raised with regard to the proposed Section 419*bis* of the Administrative Instructions.

202. The Working Group approved the proposed addition of Rule 26 *quater* of the Regulations, as set out in Annex I to document PCT/WG/12/8, with a view to its submission to the Assembly for consideration at its next session in September-October 2019.

### **ERRONEOUSLY FILED ELEMENTS AND PARTS OF THE INTERNATIONAL APPLICATION**

203. Discussions were based on document PCT/WG/12/9.

204. The Chair invited comments from delegations on the general principles of the proposal in the document.

205. The Delegation of China supported the amendments proposed in the document, which would help to clarify the difference between missing parts and erroneously filed parts. This would increase certainty in the international patent application and reduce the inconvenience caused to applicants.

206. The Delegation of the United States of America stated that it continued to be of the view that the ability of applicants to add a full description, set of claims and/or drawings through incorporation by reference was within the spirit and intent of the provisions on incorporation by reference. It was clear that this type of error was what Member States were attempting to address when these provisions were adopted. While the Delegation believed that the proposed new Rules were complex and could be avoided by an amendment to Rule 4.18 clarifying the scope of the current provisions dealing with incorporation by reference, it could support the proposals, provided certain issues were satisfactorily addressed.

207. The Delegation of Canada stated that, from a policy perspective, it made sense to provide a mechanism within the PCT where applicants could obtain relief in the exceptional circumstances of an erroneously filed element or part. Unless this type of error were noticed before the expiry of the priority period when the applicant could file a new application with the correct element or parts, the Delegation believed that the PCT offered no other remedy.

208. The Delegation of the European Patent Office stated the opinion that the document reflected the principles of the general agreement reached at the eleventh session of the Working Group in 2018. The Delegation considered the document provided a balanced solution, with a clear distinction between, on the one hand, provisions applicable to “truly” missing parts and, on the other, provisions applicable to erroneously filed elements and parts. While the Delegation had comments on some of the details, it was supportive of the proposals in general.

209. The Delegation of India pointed out that, under the procedure for verifying compliance with Article 11, Rule 20.5 required the receiving Office either to invite the applicant to furnish a missing part, or confirm the missing part as incorporated by reference. Under Article 11 checks, the receiving Office was expected to determine whether the application contained, on face of it, a part that appeared to be a description and, on the face of it, a part that appeared to be a claim or claims. The Article 11 checks therefore did not require the receiving Office to study the contents of the description or claims. By contrast, in the majority of the cases where the

applicant had erroneously filed the description or claims, in the experience of the Indian Patent Office, such errors were only noticed during search and examination by the technical examiner during international search. It was not clear whether the proposed amendments provided further remedy when the International Searching Authority (ISA) noticed such errors. In all such erroneous filings, the ISA would be the Office to notice the error as it would either program establishment of the search report or result in a mismatch with the priority document while the technical examiner was checking the validity of the priority date. In cases where the applicant might have interested the task of filing and processing of the application to a professional patent agent or attorney, the error would have been committed by the agent or attorney and the applicant might not have had access to the filed application due to client attorney arrangements. The applicant might therefore be oblivious to the error. In conclusion, the Delegation supported the amendments intended to save the application, but suggested that the time limit fixed for such remedy should not prevent the applicant or the receiving Office to rectify the error if noticed by the ISA at the international search stage.

210. The Delegation of Japan stated that it supported revising rules in order to ensure uniform operation in Member States since it was a disadvantage for users to have different interpretations and practices. However, the Delegation pointed out the possibility to delete erroneously filed elements and parts of the international applications by filing amendments under Article 34. An international application with erroneously filed elements and parts that had been deleted under Article 34 might enter the national phase of a State which did not apply the provision of Rule 20.5*bis*(d) having filed a reservation under Rule 20.8(b-*bis*). In this case, it was unclear which elements or parts would be treated as part of the application and which elements or parts would be considered to have been deleted.

211. The Secretariat, in response to the comment from the Delegation of Japan, clarified that the designated Office that had submitted a notification of incompatibility would treat the application, with the correct element or part included in the application, in accordance with proposed new Rule 20.5*bis*(b) or (c). However, the notification of incompatibility would result in the international filing date having been accorded on, or corrected to, the date on which the correct element or part had been received by the receiving Office. This would also be the case where no Article 34 amendment had been made.

212. The Delegation of France thanked the International Bureau for proposing a balanced solution to the problem of erroneously filed elements and parts which could be suitable for all. The proposed new Rule 25*bis* was not entirely compatible with French law. However, as the proposal allowed States to submit a notification of incompatibility and clarified that the erroneously filed elements would be included in the application for reasons of transparency and for the benefit of designated Offices that had submitted such a notification, the Delegation supported the proposal.

213. The Delegation of Brazil expressed caution with providing excessive opportunities for complying with the erroneously filed elements and parts of international application, especially when they could conflict with national legislation. However, the Delegation was supportive of applicants having the opportunity for correction of erroneously filed elements and parts and the proposed amendments in document PCT/WG/12/9.

214. The Delegation of the United Kingdom supported the proposal and the amendments in the document, but had some similar concerns to those expressed by the Delegation of India regarding the identification of erroneously filed elements and parts. The new Rule 20.5*bis* placed an element of responsibility on the receiving Office to spot any erroneously filed parts and to invite the applicant to replace them. At the United Kingdom Intellectual Property Office, non-technical staff performed the checking of international applications as a receiving Office. While it was relatively easy to spot missing parts, it was much more difficult to identify erroneously filed parts, which non-technical staff could miss. The Delegation noted that the

proposed amendments to the Regulations provided an alternative time limit for applicants to replace erroneously filed parts or elements in their application of their own volition. While this could be sufficient when a receiving Office had not spotted an erroneously filed part or element, it was important to bear in mind the difficulties in spotting these errors.

215. In response to the concerns raised by the Delegations of India and the United Kingdom as to the ability of the receiving Office to establish whether an element or a part of the application had been filed erroneously, the Secretariat clarified that there was no expectation that the receiving Office would actively check for such erroneously filed elements or parts. The only obligation on the receiving Office was to invite the applicant to furnish the required correction should it, in the normal process of determining whether papers purporting to be an international application fulfilled the requirements of Article 11(1), notice what appeared to be an erroneously filed element or part.

216. The Delegation of Australia stated that its national law required international patent applications to be treated as a complete application for a standard patent upon entry into the national phase. Accordingly, any amendments made in the international phase prior to entering the national phase which would stand for the purposes of national phase procedures. However, while IP Australia allowed the substitution of multiple elements of the specification where those elements were missing, IP Australia did not interpret its national law to allow for substitution of elements previously filed. The Delegation indicated that this amendment could therefore provide a legal basis to assist IP Australia in a potential change of its current practice to ensure there were no divergences in the treatment of applications when filed through the PCT or directly at IP Australia. However, to align such practices, it might be necessary to amend domestic law. At this time, the Delegation would therefore be likely to send a notice of incompatibility. Nonetheless, the Delegation would be willing to follow the consensus in supporting the proposed amendments to the PCT Regulations in the document to resolve this matter.

217. The Representative of the Union of European Practitioners in Industrial Property (UNION-IP) stated that the proposal was a balanced one, allowing for replacement of erroneously filed elements and parts, but not being open to clear abuse from applicants, who should give due attention to the content when filing a patent application. For these reasons, UNION-IP supported the proposal.

218. The Representative of the Japan Patent Attorneys Association (JPAA) considered that it might not be user friendly to prohibit replacement of an erroneously filed element or part of an application and such prohibition could cause misunderstanding by people dealing with the application. However, it was important to respect the laws of those designated Offices that did not allow such a replacement. Therefore, the Representative considered it appropriate for an application to include in the international phase an erroneous element or part that had been removed at the national phase. On the contrary, in the national phase, if an erroneous element or part has been included in application by mistake, it did not make any sense to publish the erroneous element since replacement of the erroneous element or part would be beneficial for the public. As the number of applications containing an erroneous element or part appeared to be low, the Representative believed it appropriate for the designated offices to decide whether to permit replacement. However, the Representative hoped that Offices would not submit notices of incompatibility and any notices that were received would be published in a way that would be seen easily by users so that applicants would be aware before deciding whether to enter the national phase.

219. The Representative of the Japan Intellectual Property Association (JIPA) stated that JIPA supported the proposal, which reflected many of the concerns and requests expressed at the workshop held in 2018 at the time of the eleventh session of the Working Group. Overall, the amendment to the PCT Regulations would be beneficial for applicants from the standpoint of

safeguards. However, the Representative made two requests in terms of the practice relating to incorporation by reference at receiving and designated Offices. First, the treatment of erroneously filed elements or parts of an application should be harmonized among receiving Offices to ensure fairness for applicants. Second, it was necessary to clarify how each designated Office treated incorporation by reference and that this information was made available to users.

220. The Secretariat, in response to the comments raised by the JPAA and the JIPA, stated that the International Bureau published any information on notifications of incompatibility that remained valid on the WIPO website and the *PCT Applicant's Guide*. The fact that such notifications had been submitted would be widely publicized by the International Bureau so as to ensure that applicants were fully aware of which designated Offices would accept the incorporation by reference of correct elements or parts for national phase processing and which would not.

221. The Secretariat further clarified that, as far as receiving Offices were concerned, it had been proposed to ensure, by way of an Understanding to be adopted by the Assembly, that all applications which had been filed with a receiving Office that had submitted such a notification would be forwarded to the International Bureau as a receiving Office under Rule 19.4(a)(iii), which would apply the provisions concerning the incorporation by reference of correct elements or parts. In essence, every applicant would therefore have access to the provisions providing safeguards in the event of erroneously filed elements and parts, no matter where the application had been filed.

222. The Representative of the Institute of Professional Representatives Before the European Patent Office (epi) expressed its support for the proposal and expected applicants to have equal treatment regarding erroneously filed elements and parts, irrespective of the receiving Office.

223. The Representative of International Federation of Intellectual Property Attorneys (FICPI) also expressed support for the proposal.

224. The Chair summarized that there was general support for the proposal, both from the membership of the Working Group and user groups. The Chair thus invited inventions on the proposed amendments to the PCT Regulations, as set out in the Annex to the document.

225. The Delegation of the United States of America stated that it had specific concerns with regard to a number of proposed new Rules or proposed amendments of existing Rules:

(a) The Delegation questioned whether, where a correct element (say, a correct set of claims) had been incorporated by reference and the erroneously filed element (say, an erroneously filed set of claims) remained in the application, Article 15 permitted an ISA to carry out a search only on the basis of the correct element (the correct set of claims), without taking into account the erroneously filed element (the erroneously filed set of claims), noting that Article 15(3) provided that the international search had to be made “on the basis of the claims, with due regard to the description and the drawings, if any” and that none of the exceptions provided for under Article 17(2)(a) and (b), allowing for no search report to be established, appeared applicable. Such a case was not comparable to the case of a rectification of an obvious mistake (say, in the claims), which did not need to be taken into account by the ISA if it had been authorized by it or notified to it only after it had begun to draw up the search report; in that case, all of the claims (albeit containing an obvious mistake) still formed the basis of the search.

(b) The Delegation further underlined the need for the Administrative Instructions and Receiving Office Guidelines to be clear on the processing of applications. In a “hybrid” situation with both missing and erroneously filed elements and/or parts, there needed to

be clarity on how the provisions would work together. For example, if an application were filed with an incorrect description and no claims, or an application were filed with a missing page of the description and an incorrect set of claims, the Delegation understood that the receiving Office would apply each set of rules to the appropriate portion of the submission. However, designated Offices, particularly those that had submitted a notice of incompatibility, would need to know which of submission had been treated under which set of rules in order to be certain how to process the application. In such situations, applicants could possibly be required to state under which Rules each part of their submission was being filed. Similarly, the Delegation had a concern regarding the administrative processing regarding the proposed Rule 20.5*bis*(e), which allowed the applicant to request that the correct element be disregarded at a later point. In such a situation, the processing steps needed to be clear to be able to identify from the file what was part of the application and what was not.

(c) Finally, the Delegation had two concerns with regard to the additional burden the proposals placed on the applicant. First, the comment on Rule 20.5*bis*(d) set out in the Annex to the document indicated that the applicant should amend the application to remove the correct elements or parts from the application when entering the national phase before an Office that had submitted a notification of incompatibility. Instead, the Delegation suggested further amending proposed new Rule 20.5*bis* to provide for the automatic removal from the application of the correct elements or parts for the purposes of national phase processing before such an Office. Second, the Delegation suggested further amending Rule 20.8(a-*ter*) to provide that any request for the incorporation by reference of a correct element or part furnished to a receiving Office that had submitted a notification of incompatibility would be considered as a request to transmit the application to the International Bureau as receiving Office under Rule 19.4. This would avoid the requirement for applicant to make a separate request to the receiving Office to that effect.

226. The Delegation of the European Patent Office supported the general principles behind the concerns expressed by the Delegation of the United States of America. However, the Delegation pointed out that an automatic transfer to the receiving Office of the International Bureau under Rule 19.4 when an applicant made a request for incorporation by reference of a correct element or part at a receiving Office that had filed a notification of incompatibility would preclude the applicant from having a choice on whether to continue to the application at the initial receiving Office. In this regard, the Delegation expressed interest in hearing the views from users on whether an automatic transfer under Rule 19.4 would be in the applicant's interest.

227. The Secretariat responded to the concerns expressed by the Delegation of the United States of America about the obligation by the ISA to search the correct claims, regardless of whether the applicant had paid the additional search fee. There was a similar situation in the PCT Regulations with regard to rectification of obvious errors. When an obvious error was rectified, the ISA was not able to charge a further fee, but if the ISA had received the notification after it had started the search, the rectification did not have to be taken into account. In that case, all of the claims (albeit containing an obvious mistake) still formed the basis of the search. In the case of filing a correct set of claims, the proposal aimed to be more applicant-friendly by offering the option to pay an additional fee for the examiner at the ISA to search the correct claims. While applicants might decide not to pay the additional fee and have the wrong claims searched, the Secretariat believed the applicant would have an interest in having a search on the correct application. In this regard, the Secretariat did not perceive there to be an inconsistency with the Articles of the Treaty. With regard to the other concerns expressed by the Delegation of the United States of America, the Secretariat agreed with the need for clear guidance in terms of processing applications by the receiving Office. Furthermore, the Secretariat was willing to look into the issue of a request for incorporation by reference of a correct element or part at a receiving Office that had made a notification of incompatibility being

considered as a request to transfer the application to the receiving Office of the International Bureau under Rule 19.4.

228. Following informal consultations, the Secretariat introduced additional amendments to those in the Annex to the document prepared by the International Bureau for the Working Group to consider. These included a new Rule 40*bis* to clarify that the ISA could charge an additional fee both in the case of a missing part received after the Authority had begun to draw up the international search report and in the case of a correct element or part being incorporated by reference. A further issue related to the case where a correct element or part was filed after the ISA had begun to draw up the international search report but could not be incorporated by reference. In this case, the international filing date would change, but new material could be present in the application that the examiner could be required to search. The proposed amendments to Rules 48 and 51*bis* had been made to take into account situations where an erroneously filed element or part had been removed by the receiving Office but the applicant later requested that the correct element or part concerned should be disregarded under Rule 82*ter*. In these cases, the designated Office would require a translation of the element or part. In addition, it would be necessary to include a provision in Rule 48.2 that the contents of the international publication included an indication that an erroneously filed element or part had been removed from the international application. In addition, the proposals included the possibility for the designated Office in Rule 51*bis*.1 to require a translation of the erroneously filed element or part that had been removed if the applicant later requested the correct element or part to be disregarded under Rule 82*ter*. Finally, Rule 82*ter* had been amended to make a clear distinction between missing parts and correct elements or parts.

229. The Delegation of the United States of America thanked the Secretariat for the proposed amendments. However, the Delegation pointed out that the proposed new Rule 40*bis* did not address the comments concerning whether a provision allowing for an additional search fee was contrary to Articles 15 and 17 (see paragraph 225(a), above). While the Secretariat had pointed out that the ISA need not take an obvious error into account for the purpose of the search if the notification of the obvious error arrived after it had begun to draw up the international search report, the Delegation did not believe this to be a comparable situation (see paragraph 227, above). In the case of an obvious error, while the claims as filed would be searched and examined, the error would be obvious to the examiner with only one possible way to correct it. In reality, the error would not therefore have a practical effect on the search. Replacing an entire set of erroneously filed claims was not a comparable situation to an obvious error. The Delegation therefore proposed that the amendments could leave out the provision for requesting an additional fee. Instead, International Searching Authorities could monitor the situation where an additional fee might have been necessary over the next few years and re-consider the matter in the future, if necessary. In this regard, the United States Patent and Trademark Office had been allowing applicants to replace entire elements from the beginning of the provisions on missing parts entering into force and the need to redo a search had happened very rarely. The Delegation also questioned the need for the proposed amendment in Rule 51*bis*.1 to allow designated Offices the possibility to request a translation of parts that had been removed from the international application. This could create legal uncertainty for the applicant in being able to determine whether the translations submitted had complied with national laws, with the consequence that the designated Office might consider the application as abandoned.

230. The Secretariat, in response to the comments by the Delegation of the United States of America, explained that the presence of new claims in the event of replacing an erroneously filed element or part after the ISA had started to draw up the international search report could lead to additional work. As the examiner might need to undertake further searching, it would appear appropriate to allow the possibility to charge an additional fee for this work. In the case of the proposed amendment to Rule 51*bis*.1, the designated or elected Office, when reviewing the incorporation of a correct element or part under Rule 82*ter*, could consider that the receiving

Office had made a mistake in that incorporation. In this situation, the application would revert to the elements or parts that the receiving Office had removed from the application. In such a case, the designated or elected Office might require a translation of those elements or parts. While this scenario was possible, the Secretariat highlighted that it would involve a mistake by both the applicant in making the erroneous filing and by the receiving Office in incorporating the “correct” element or part, which was highly unlikely.

231. The Delegation of the European Patent Office (EPO) agreed with the comments made by the Secretariat regarding the interpretation of the wording of Rule 51 *bis*. Regarding the payment of the additional fee, the EPO experienced about five cases per year where the examiner had started the international search and then received a corrected application from the receiving Office under Rule 20. On these cases, the applicant had made a mistake, but the ISA would incur the costs of the additional work from further searching. The Delegation considered this to be unfair to the ISA and it was important that a loophole did not exist where an applicant could not be charged for the additional work.

232. After further informal consultations, the Secretariat proposed for the Working Group to submit the proposed amendments in Annex I to document PCT/WG/12/9 to the Assembly, along with proposed new Rule 40 *bis* and the proposed amendments to Rules 48.2(b), 51 *bis*.1(a) and (e), and 82 *ter*.1 (see Annex I to this document). The Secretariat also proposed that the Assembly adopt an Understanding clarifying the relationship between the new fee under Rule 40 *bis* and Articles 15 and 17 to clarify that the search, in case of incorporation of a correct element or part, did not need to take into account any erroneously filed element or part that might remain in the application. If the applicant had not paid any search fee requested under Rule 40 *bis*, the search fee would be based only on the incorrect claims.

233. The Working Group approved:

(a) the proposed amendments to Rules 4.18, 12.1 *bis* and 20.5(a) and (b), proposed new Rule 20.5 *bis*, the proposed amendments to Rules 20.6(c), 20.7, 20.8, 55 and 76 as set out in Annex I to document PCT/WG/12/9;

(b) proposed new Rule 40 *bis* and the proposed amendments to Rules 48.2(b), 51 *bis*.1(a) and (e), and 82 *ter*.1 as set out in Annex I to this document;

with a view to their submission to the Assembly for consideration at its next session in September-October 2019.

234. With regard to the issue raised by the Delegation of the United States of America as set out in paragraph 225(a), above, the Working Group agreed to recommend that the Assembly adopt an Understanding to the effect that “Article 15 should be interpreted such that the International Searching Authority, in the case of incorporation by reference of a correct element or part under Rule 20 *bis*.5(d), would only be required to carry out the international search on the basis of international application (‘the claims, with due regard to the description and the drawings, if any’) including the correct element or part incorporated by reference, and did not need to take into account any erroneously filed element or part which, pursuant to Rule 20.5 *bis*(d), remained in the application. Likewise that Article 15 should be interpreted as allowing the search to be based on only the incorrect claims if the fee under new Rule 40 *bis* had not been paid”.

## **PROPOSAL WITH RESPECT TO THE AVAILABILITY OF THE FILE HELD BY THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY**

235. Discussions were based on document PCT/WG/12/12.

236. The Delegation of Singapore introduced the document by explaining that the proposal aimed to promote greater transparency at the international preliminary examination phase. At present, the International Preliminary Examining Authority (IPEA) transmitted to the applicants and International Bureau a copy of the international preliminary examination report and the prescribed annexes, which usually only included the latest sets of amendments and accompanying letters as required under Rule 66.8 or arguments submitted under Rule 66.3. Following that, the International Bureau effected the communication of the international preliminary examination report and the annexes to each elected Office under Article 36 and Rule 73 by publishing those documents online on PATENTSCOPE. However, any other written opinions of the IPEA and previous sets of amendments and letters containing arguments and explanations submitted by the applicants before the establishment of international preliminary examination report were usually not made available online. While an elected office might make such information available by its own website, such arrangements were currently limited to the case where the elected office had itself established the international preliminary examination report in its role as the IPEA. As a result, the international preliminary examination report was often unclear to the examiners of the elected Office what amendments and/or arguments had been considered by the IPEA prior to the establishment of the international preliminary examination report. Such information could be useful for this examiner, especially when the amendments annexed to the international preliminary examination report only addressed minor issues but the applicant had put forward substantive amendments and arguments to overcome objections raised in a previous written opinion. As about 5 to 6 per cent of international applications were subject to the international preliminary examination, the Delegation stated that it would be desirable to make the written opinions of the IPEA as well as the amendments and the letters submitted by applicants available online on PATENTSCOPE. This would enable examiners in elected Offices to access the information from a single platform, thereby having a comprehensive understanding of the result. While the Delegation recognized that there might be a legal concern relating to Article 38, the sixth session of the Meeting of International Authorities in 1997 had agreed on a new approach towards the confidentiality of the files of international preliminary examination and agreed that a more liberal interpretation of Article 38(1) was desirable. Since then, further progress had been made towards providing transparency within the PCT processes as listed in paragraph 2 of the document. In order to require the IPEA to transmit additional documents to the International Bureau for publication on PATENTSCOPE, the Delegation proposed amendments to the Regulations and modifications to the Administrative Instructions, as outlined in paragraph 11 and the Annexes to the document. Furthermore, the Delegation welcomed comments on future work regarding ceasing the practice of including amendments, rectifications and letters as annexes to the international preliminary examination report, but instead having them made available as separate documents, as discussed in paragraph 14 of the document.

237. The Delegation of Indonesia conveyed its support for the proposed amendments in the Annexes and the further work set out in paragraph 14 of the document, adding that this would provide greater transparency of the international preliminary examination process.

238. The Delegation of the European Patent Office (EPO) welcomed the proposals in the document as a measure to enhance transparency for both examiners in elected Offices as well as third parties. In line with Rule 94.3, after publication of the international application and completion of the international preliminary examination report, the EPO allowed third parties to access all documents pertaining to the Chapter II by online file inspection, subject to the limitations foreseen in Article 128(4) and Rule 144 of the European Patent Convention. Prior to establishment of the international preliminary examination report, the file was confidential as established under PCT Article 38, with only applicants being able to authorize access to the file.

Therefore, with the aim of streamlining the transmission of the Chapter II file to the International Bureau, the Delegation suggested hyperlinking to the European Patent Register. With regard to further work discussed in paragraph 14 of the document, the Delegation underlined the need to identify any amendments, rectifications and letters displayed as separate documents in a way that their retrieval entailed limited additional burden for elected Offices. Furthermore, since the applicant was required to furnish translations of all the annexes to the IPEA according to Article 36.2(b), it was in the interest of applicants that the documents forming the current annexes to the IPEA were clearly identified and easily accessible. In addition within the context of the ongoing work towards full text publication of application bodies, the Delegation suggested exploring the possibility of displaying amendments and rectifications in marked up format.

239. The Delegation of the United States of America welcomed the proposal, which would increase transparency of international preliminary examination under Chapter II. The Delegation therefore supported the proposed amendments in the Annexes to the document, along with the suggestion in paragraph 14 to discuss further improvements in the access to information concerning international preliminary examination at an upcoming session of the Meeting of International Authorities.

240. The Delegation of China expressed agreement for the proposal in principle, which would help the elected office make full use of the results of the international phase. However, as the proposal would require changes to practice at the China National Intellectual Property Administration and other International Preliminary Examining Authorities, the Delegation suggested consultation on the implementation of the proposal.

241. The Delegation of Chile supported the proposal, which would provide greater transparency in the international phase and help to promote the use of the system to users.

242. The Delegation of the United Kingdom agreed with the proposal, which would help better shape the international preliminary examination report available to elected offices and the public. The proposal would also improve the linkage between the international and national phase by allowing examiners in elected offices to have full access to the history behind the international preliminary examination report. The Delegation also supported the further work proposed by the International Bureau in paragraph 14 of the document. As amendments attached to the international preliminary examination report during national phase processing could sometimes be missed during national phase processing, the United Kingdom Intellectual Property Office welcomed any initiative to have these as separate documents or even incorporated into the working copy of the international application.

243. The Delegation of Australia supported the proposal in the document and believed that increased transparency would increase confidence in respect of the work undertaken by the IPEA. The proposal would allow a clear and more transparent format for examiners at elected Offices to be aware of which amendments and arguments had been considered by the IPEA prior to the establishment of the international preliminary examination report. The Delegation also supported the Meeting of International Authorities reviewing the issues outlined in paragraph 14 of the document.

244. The Delegation of Canada stated that examiners at the Canadian Intellectual Property Office (CIPO) would welcome the proposal if implemented and the benefits for most applicants were undeniable. However, the Delegation requested more information on implementation, noting that not all applicants had access to the Internet and ePCT had not been fully deployed at certain Offices, including CIPO, which could increase the reliance on postal services. If the use of ePCT were not required, the Delegation asked about the additional work involved to enable the transmission of the additional documents via PCT-EDI. Furthermore, the Delegation queried whether the applicant would have to provide translations of the additional documents that would be transmitted under the proposal. The Delegation therefore believed that it was

necessary to have further discussion of the proposal at the Meeting of International Authorities. Furthermore, for the Canadian Intellectual Property Office to make full text application bodies available for publication would require IT resources that would not be available until 2020/21.

245. The Delegation of Japan stated that it would take a few years to modify the IT system at the Japan Patent Office to allow for the sending of new documents. Therefore, when adopting the proposal, the Delegation requested sufficient time to make the necessary IT modifications before it took effect, or for there to be transitional measures that would allow an IPEA to start the transmission of the additional documents when were ready to do so.

246. The Delegation of Colombia stated that it could support the proposal, adding that transparency in the PCT process was important for Offices to avoid duplication of effort and work.

247. The Delegation of Spain supported the proposal and indicated that modifications to IT systems might be minimal since the IPEA already produced the information, with the main change being the transmission of the information to the International Bureau. Implementation at some IPEAs may therefore be more straightforward.

248. The Representative of the Japan Intellectual Property Association (JIPA) thanked Singapore for the proposal and hoped that there would be no obligation for applicants to file a translation in the national phase of the additional documents that would be transmitted to designated Offices under the proposal. Preparing a translation of these documents in every language of the elected Offices where an international application entered the national phase would be a burden for applicants.

249. The Representative of the Institute of Professional Representatives Before the European Patent Office (epi) also enquired about whether the proposal would require translation of the additional documents that would be made available.

250. In response to the query from the Delegation of Canada and the Representatives of the JIPA and the epi about translation requirements, the Secretariat clarified that the proposal would not require applicants to provide translations of the additional documents that the IPEA would make available under the proposal. One reason for displaying the documents as separate items was this could make it possible in the future to offer a machine translation of the documents, but the International Bureau would not translate these documents manually.

251. In response to a suggestion from the Delegation of the European Patent Office to provide hyperlinks to the additional documents held in the European Patent Register, the Secretariat indicated that the link between WIPO CASE and One Portal Dossier could allow retrieval of the documents to make them available through PATENTSCOPE. This would be a useful arrangement, but further work would be needed to ensure that all issues were addressed effectively so as to obtain the relevant document from all International Preliminary Examining Authorities.

252. After informal discussions, the Chair proposed that the Working Group approve the proposed amendments to the Regulations to be submitted to the Assembly at the upcoming session in September/October 2019. However, in view of the time required for some International Preliminary Examining Authorities to make technical changes needed for the transmission of documents, the Administrative Instructions would be drafted so the transmission of documents would be initially be optional, but would later become mandatory when all Authorities were ready to transmit the relevant documents.

253. The Delegation of Canada stated that the proposal made by the Chair had addressed its main concerns and it would be able to accept this proposed way forward.

254. The Working Group:

- (a) approved the proposed amendments to Rules 71 and 94 of the Regulations, as set out in Annex I to document PCT/WG/12/12, with a view to their submission to the Assembly for consideration at its next session in September/October 2019;
- (b) noted that the International Bureau would consult on further modifications to the proposed Administrative Instructions, so as to make transmission of the relevant documents initially optional for International Authorities, with the intention of making the provisions mandatory after a period sufficient to allow all International Preliminary Examining Authorities to make the required technical changes needed for their transmission; and
- (c) invited the Meeting of International Authorities to undertake the further work outlined in paragraph 14 of document PCT/WG/12/12.

#### **APPOINTMENT AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY (ISA/IPEA) AND DECLARATION BY RECEIVING OFFICES AS COMPETENT ISA/IPEA**

255. Discussions were based on document PCT/WG/12/18.

256. The Delegation of India introduced the document by explaining that the proposal would enable all applicants to choose any of the International Searching and Preliminary Examining Authorities (ISA/IPEAs) for search and examination of their international applications. Under the existing mechanism, an applicant from a PCT Contracting State could not utilize the services offered by all of the International Authorities. Instead, each receiving Office (RO) was required to specify the International Searching and Preliminary Examining Authorities competent for the search and examination of international applications filed with such Office. Accordingly, this step of “declaration as competent ISA/IPEA” had the overriding effect on the recognition/appointment already secured following the due process involving all Contracting States. The result of this process was that multilateral cooperation under the PCT was restricted due to lack of bilateral agreements. In today’s world, businesses were transnational with multiple partners for research, production, marketing etc. The need for patenting the invention and the choice of ISA/IPEA were decided by the applicants based on various factors. In case of multiple applicants from different countries, the applicants had more choice since selection of an ISA/IPEA was possible if at least one of the applicants was eligible to choose the Office as ISA/IPEA. Thus, the choices were not uniformly available to all the applicants and there existed a need to shape the rules for the changing world.

257. The Delegation of India continued by stating that, as a multilateral treaty, the PCT System allowed all applicants to designate or elect all of the Contracting States during the international phase. By allowing the applicants to choose any International Authority as ISA/IPEA, the cooperation among the International Authorities would be more meaningful as the Authorities would recognize the services offered by other Authorities and all Contracting States would recognize equally the services offered by all International Authorities. Furthermore, by simplifying the procedure and making available more choices to the applicant, the PCT System would ease doing business for applicants. There would be better utilization of resources and dissemination of best practices, which would encourage more applicants to use the PCT System. While the PCT system had come a long way during the past four decades of its existence, through concerted efforts Member States could improve the system continually to face the changing global needs. The PCT System was a shining example of successful multilateral cooperation and work sharing, which would be further enhanced under the proposal. The Delegation therefore hoped that all Member States would agree that the spirit of cooperation envisaged by the proposal outweighed any additional workload due to consequential amendments in the legal texts or guidelines, or the procedural changes that

might be required to implement the proposal. Furthermore, the PCT online services like ePCT and eSearchCopy, as well as the netting pilot, provided a good way to implement the proposed changes. Initially, the proposal could start with applicants filing international applications through the International Bureau as a receiving Offices being allowed the choice of any International Authority as ISA/IPEA since mechanisms for transfer of fees and documents were already in place between the different Authorities and the International Bureau. The mechanisms could then be extended gradually to other receiving Offices. The Delegation stated that the Indian Patent Office would be happy to work with the International Bureau and other Offices for any changes required for this smooth implementation of the proposal. Moreover, the Delegation reminded the Working Group that, on the occasion of publication of 3 millionth PCT application in February 2017, the International Bureau had published a Memorandum by Director General of WIPO entitled the "PCT System – Overview and Possible Future Directions and Priorities", which intended to provide "food for thought" on broad directions and priorities for possible future work aimed at further improving the PCT System. In particular, it suggested that the primary road to achieving this aim was to renew emphasis on the cooperation element of the Treaty, mostly requiring changes to the behaviors and actions of Offices, including the International Bureau, rather than significant changes to the legal framework. This proposal, if implemented, would greatly enhance the cooperation element of the PCT. The Delegation therefore invited all participants in this meeting to share their views on the proposal and also to suggest ways for its smooth implementation.

258. The Delegation of Indonesia, speaking on behalf of the Asia and Pacific Group reminded the Working Group that the proposal had been discussed during the twenty-sixth session of the Meeting of International Authorities under the PCT in February. From the discussion page for the proposal set up on the Quality Subgroup electronic forum, one Authority had requested further elaboration of the background, which the Delegation of India had provided. The Asia and Pacific Group stood ready to follow consensus on a way forward as reflected in the proposal and hoped that a positive decision could be agreed as soon as possible.

259. The Delegation of Australia stated that IP Australia, like many other national Offices, benefitted from conducting services for its own local stakeholders, whether by providing timely assistance to local attorneys filing a PCT application, or by raising awareness on recent changes in the PCT with Australian businesses. However, IP Australia's functioning as an ISA/IPEA and receiving Office extended beyond providing services. The role of IP Australia in the PCT also concerned valued relationships with local stakeholders in being able to engage meaningfully on issues important to both IP Australia and those stakeholders. IP Australia's experience in the PCT also allowed it to assist other Offices regionally, whether this be assistance with customer service functions for Offices in neighboring Pacific islands or through patent examiner training in the Regional Patent Examiner Training (RPET) program. There were many considerations that arose from the proposal in the document such as language considerations, time zone and workload forecasting. The Delegation therefore believed these considerations required further robust discussion at the next Meeting of International Authorities under the PCT.

260. The Delegation of Israel expressed its appreciation to India for the proposal, but believed that there would be technical difficulties in allowing applicants a free choice of ISA/IPEA. Moreover, the proposal would have substantial impact on the IT system and workforce of PCT Offices.

261. The Delegation of the Russian Federation noted that the proposal in the document had been made to the twenty-sixth session of the Meeting of International Authorities under the PCT, but had not been discussed in detail. The Delegation pointed out that the PCT System was already capable of offering applicants a great deal of choice of ISA/IPEA, particularly where the applicants included nationals or residents of several States. An applicant was also able to request supplementary international search if the applicant wished to have the application

searched by an Authority that was not a competent ISA for the receiving Office with which the application had been filed. The Delegation further considered that international search and supplementary international search functioned properly. Moreover, within the scope of Rule 35, it was possible for any receiving Office to specify all active ISA/IPEAs as competent for its applications, yet in practice, each receiving Office specified a limited number, thereby allowing Offices to plan their workload. By contrast, certain ISAs might encounter major difficulties under the proposal because of an unpredictable and uneven arrive of search requests. Furthermore, many International Authorities concluded bilateral agreements with certain receiving Offices or limited their competence to the receiving Offices of certain Contracting States in their respective bilateral agreement with the International Bureau under Articles 16(3)(b) and 32(3), thereby allowing better predictability of their work burden. The Federal Service for Intellectual Property (ROSPATENT) therefore believed that the proposal should be considered in more detail by the Meeting of International Authorities and there was a need to prepare a tool for ISA/IPEAs to regulate their own work burden. The Delegation further proposed that the International Bureau might consult ISA/IPEAs through a PCT Circular on whether amendment of the PCT Regulations and modifications to the Administrative Instructions could enable ISA/IPEAs to regulate their own work burden and also suggested that a pilot project could study the practicalities of the proposal.

262. The Delegation of Canada stated that the Canadian Intellectual Property Office did not use the eSearchCopy service and would therefore be required to use regular mail under the proposal, which would result in huge delays in transmitting international search reports and written opinions worldwide to applicants. Furthermore, the Delegation believed that it would be a burden on applicants to understand the nuances between all the options available to them in view of the various notifications, declarations and reservations under which Offices worked. Consequently, applicants might choose a less beneficial option with the potential loss of rights. The Delegation also shared concerns about workload management and translation issues, including the resulting costs for applicants and the International Bureau.

263. The Delegation of Brazil stated that the proposal merited additional reflection. It would potentially increase the options for applicants to choose an ISA/IPEA according to specific demand such as language or the States where national phase entry might take place. While the technical details such as adaptation of IT infrastructure, transmittal of fees and amendment to the PCT Regulations would need to be discussed further, these technical hurdles had been recognized by the Delegation of India and the PCT offered tools to assist implementation should Member States agree on the proposal. The document provided the basis for further discussion of the technical details and the Quality Subgroup electronic forum provided a discussion page to receive comments regarding the document. The Delegation therefore looked forward to discussing the proposal at the next session of the Meeting of International Authorities and/or Working Group.

264. The Delegation of China stated that the proposal would require amendment to the PCT Regulations in terms of competent ISA/IPEAs. In addition, for ISA/IPEAs, the proposals would bring some legal and technical challenges. Therefore the Delegation stated that it would require more time for further consideration and evaluation of the proposal.

265. The Delegation of the United Kingdom expressed interest in finding out whether there had been any demand from applicants to provide for a free choice of ISA. Given that receiving Offices would need to make significant technical changes to both their IT and financial systems, the Delegation stressed that it would need clear evidence from applicants that the proposal was desirable from their perspective before being able to consider such a change. In addition, the Delegation underlined that it required more time to analyze the legal obligations of the United Kingdom with respect to international treaties, particularly the European Patent Convention (EPC) and its Protocol on Centralisation.

266. The Delegation of Japan stated that the proposal related to a fundamental aspect of the PCT System which needed careful discussion considering the relative benefit to users since it also affected domestic regulations and IT systems. For example, there was the risk of not being able to control workload since the number of international search requests might increase or decrease dramatically over a short period of time due to factors that were difficult to predict. As Rule 42 specified a time limit for an ISA to produce the international search report, there was a risk that an ISA would not meet the time limit or the quality of international search reports would be reduced if many applicants selected a single ISA, overburdening it with search requests. This would lead to disadvantages for users, which could potentially undermine the credibility of the PCT System. Furthermore, the proposal might cause competition on price between ISAs, causing quality of international search reports to be neglected, despite this being important for users. The proposal therefore needed further discussion on how it would benefit users over the long term.

267. The Delegation of Chile recognized the concerns that other Delegations had expressed, particularly with regard to workload and the operation of receiving Offices and looked forward to future discussions of the proposal at the Meeting of International Authorities.

268. The Delegation of France stated that the receiving Office of the International Bureau should not be given a competitive advantage over other receiving Offices in terms of being able to offer the applicant a free choice of ISA/IPEA, as envisaged at the start of the implementation of the proposal, since more applications filed to the receiving Office of the International Bureau could be to the financial detriment of other receiving Offices. Moreover, the EPC Protocol on Centralisation involved the National Institute of Intellectual Property (INPI) of France transferring its search activities specifically to the European Patent Office. The Delegation was therefore unable to support the proposal. Since the Protocol was part of the EPC, any revision to the Protocol would require the convening of a diplomatic conference of EPC Contracting States. At least three-quarters of EPC Contracting States would need to be represented at the conference and the adoption of any revised text required a majority of three-quarters of the Contracting States represented and voting at the conference.

269. The Delegation of the European Patent Office thanked the Delegation of India for the efforts invested in the proposal contained in the document. However, the Delegation was not in a position to support the way forward proposed in paragraph 5 of the document. At present, applicants were entitled to file with the receiving Office of the International Bureau either at their own volition under Rule 19.1(a)(iii), or, as foreseen in Rule 19.4, if the international application was transmitted to the receiving Office of the International Bureau because it had been originally filed with a receiving Office that was not competent for reasons of nationality or residence or language, or, with the authorization of the applicant, because there was a specific agreement between the receiving Office where the international application was originally filed and the International Bureau. These safeguards entered into force on January 1, 1994 and were proposed in paragraphs 6 to 8 of a Memorandum by the International Bureau to the eleventh session of the Assembly of the PCT Union in September 1993 (document PCT/A/XXI/2), as follows:

“6. The proposed amendments are intended to give applicants from all PCT Contracting States the option of filing international applications with the International Bureau as receiving Office, as an alternative to filing with competent national (including regional) Offices as receiving Offices. They have been prepared with a view to dealing with two problems, in particular, which may be faced by PCT users.

“7. First, circumstances can arise at times in which, for unavoidable reasons, a receiving Office may experience administrative difficulties resulting in delay and inconvenience for applicants. The proposed amendments would enable applicants, in such circumstances, to choose to file their international applications with the International Bureau as an alternative receiving Office.

“8. Second, it can happen at present that an international application is filed mistakenly with an Office which, under the current wording of the Regulations, is not competent to receive that application because of the residence and nationality of the applicant. The proposed amendments provide a straightforward procedure for handling such applications – namely, they would simply be date-stamped and forwarded to the International Bureau as competent receiving Office – without loss of the initial filing date.”

270. The Delegation of the European Patent Office continued by highlighting that the introduction of these safeguards was coupled to the addition of a new paragraph in Rule 35.3, dedicated to the competent ISA, as proposed by the Delegation of the United Kingdom in document PCT/A/XXI/4. As explained in the proposal by the Delegation of the United Kingdom, which was adopted by the Assembly of the PCT Union: “each Contracting State has the right to specify the competent ISA(s) for international applications filed by its nationals and residents. The text of Rule 35.3 proposed in this document would maintain that right even in the case where the international application is filed with the International Bureau as receiving Office”.

271. The Delegation of the European Patent Office concluded by underlining that it believed that the principles stated at the Assembly of the PCT Union in 1993 still held today, namely, that: firstly, the possibility to have the International Bureau as a receiving Office was introduced as a failsafe mechanism and, secondly, that the right to specify the competent ISA or Authorities for international applications filed by its nationals and residents belonged to each Contracting State. Therefore, the Delegation expressed its concern that offering the choice of any ISA/IPEA to applicants filing with receiving Office of the International Bureau could trigger an unintended competition between the receiving Office of the International Bureau and all other receiving Offices. This would be at odds with the spirit of the decision taken by the Assembly of the PCT Union when adopting the Rule changes in 1993.

272. The Delegation of India thanked other delegations for their comments on the proposal. In response to these comments, the Delegation believed that the proposal could be implemented without amendment to the PCT Regulations. After a decision had been taken to implement the proposal, it would be necessary to amend the Agreements under Articles 16(3)(b) and 32(3) between each ISA/IPEA and the International Bureau and make changes to the Annexes of the *PCT Applicant's Guide* for each Contracting State. As for quality of international work products, the Delegation referred to the requirements under Rules 36 and 63 for an Office to be appointed as an International Authority, including having a quality management system in place, which the Committee for Technical Cooperation would consider when providing its advice to the Assembly on appointment as an International Searching and Preliminary Examining Authority. The Delegation concluded by indicating willingness to discuss the proposal further at the following session of the Meeting of International Authorities, to take place in early 2020.

273. The Representative of International Institute for Intellectual Property Management (I3PM) supported the general idea of the proposal from an IP management point of view, which would enhance the flexibility for applicants by providing more choice of International Authorities. In turn, this could lead to further growth in PCT applications. However, the Representative recognized the legal constraints and technical difficulties of implementing the proposal, which needed to be considered carefully, particularly for Contracting States of the EPC, as highlighted by the Delegation of the European Patent Office. The Representative further acknowledged that the pilot project suggested by the Delegation of the Russian Federation could offer a way to transition to a new system.

274. The Representative of the Japan Intellectual Property Association (JIPA) stated that increased choice of ISA would be beneficial for applicants and would be fairer than a choice that depended on the receiving Office selecting the competent ISA. The Representative stressed the need to guarantee high quality international searches under a system with more applicant choice and potential competition on price.

275. The Chair summarized that delegations had highlighted various issues in the proposal and had proposed that the Delegation of India should take these into account in a further document to be discussed at the next session of the Meeting of International Authorities in early 2020. While the proposal was not solely a matter for ISA/IPEAs, they would be most affected by changes to workload in international search and examination and other points such as different time-zones and translations.

276. The Working Group invited the Delegation of India to prepare a document for discussion at the twenty-seventh session of the Meeting of International Authorities, taking into account the comments made by delegations at the present session of the Working Group and any further consultations on the proposal with delegations, notably those representing IP Offices which acted as International Searching and Preliminary Examining Authorities.

## **SEQUENCE LISTINGS**

### **(A) SEQUENCE LISTINGS TASK FORCE: STATUS REPORT**

277. Discussions were based on document PCT/WG/12/14.

278. The Delegation of the European Patent Office, introducing the document, outlined the progress that the Task Force on Sequence Listings created by the Committee on WIPO Standards in 2010 had made in preparation for the start of use of WIPO Standard ST.26 on January 1, 2022. First, since November 2018, in collaboration with the members of the Task Force on Sequence Listings, the International Bureau had invited a restricted number of users to test the authoring and validation tool for applicants, *WIPO Sequence*, that would be made available with a Graphical User Interface in all 10 PCT publication languages. Offices had been invited to provide their comments on a draft user guide, made available on the WIPO wiki in English, by the end of June 2019. Second, the first release of *WIPO Sequence Validator*, the validation tool for patent Offices, was planned for September 2019. Third, the Task Force had submitted, for consideration at the seventh session of the Committee on WIPO Standards (CWS) in July 2019, a number of substantive amendments and editorial corrections to Annexes 1 and 7 of WIPO Standard ST.26. Fourth, a proposal for the revision of the PCT legal framework, intended for adoption in 2020 and entry into force on January 1, 2022, had been further refined in PCT/WG/12/13. Finally, a number of Offices had posted their implementation plans for WIPO Standard ST.26 on the wiki and the Task Force invited other Offices to post their implementation plans as well.

279. The Delegation of the United States of America welcomed the work done and clarified in respect of paragraph 6 of the document that the tools needed to ensure that certain machine-detectable defects would be identified reliably and that other potential issues requiring human intervention be brought to the attention of an expert for consideration to ensure compliance with the standard. Furthermore, the Delegation reminded the Working Group, in relation to paragraph 7, that the success of the proof of concept did not equate with a finished product and that development and testing was continuing.

280. The Working Group noted the contents of document PCT/WG/12/14.

(B) IMPLEMENTATION OF WIPO STANDARD ST.26

281. Discussions were based on document PCT/WG/12/13.

282. The Secretariat, introducing the document, underlined that the proposals were provisional and intended for discussion and feedback to enable their finalization for adoption in 2020 and entry into force for international applications filed on or after January 1, 2022. By transitioning from WIPO Standard ST.25 to WIPO Standard ST.26, the standard for sequence listings would be aligned with related industry standards and allow applicants to disclose aspects of sequences that were not well handled by ST.25. Furthermore, under WIPO Standard ST.26, Offices would be able to provide sequences to database suppliers after publication in a format that enabled incorporation into search databases used by Offices and the public for disclosure and general search requirements.

283. The Secretariat continued by highlighting a number of issues in the transition to WIPO Standard ST.26. First, database providers needed the language dependent free text sections in English. Second, Offices needed to process and use sequences in their various roles under the PCT. Receiving Offices would need a simple arrangement since, examiners, in general, would not be in position to assess the contents of sequences other than through having information from automated checks built into the filing tools. International Searching and Preliminary Examining Authorities would need to be able to read and search the sequence listing. In the national phase, the process should require minimal effort for both applicants and designated Offices. Third, the software tools should make it straightforward for an applicant to correct or amend a sequence listing and assist Offices in comparing different versions of listings, while acknowledging that identification and assessment of non-trivial changes to a sequence listing post filing would always be difficult. The intention in the proposals was therefore to minimize the number of occasions when a new sequence listing would be required after filing. In relation to the language requirements of the parts of the sequence listing containing the sequence listings themselves, as opposed to the bibliographic data section, ST.26 limited characters to the Unicode Basic Latin character set that excluded accented and non-Latin characters. In practical terms, this would prevent the filing of a sequence listing in compliance with ST.26 with free text in any language of publication other than English. However, questions relating to the language issues in ST.26 were for the Committee on WIPO Standards (CWS) as the WIPO body responsible for maintaining the standard.

284. In terms of discussions by the Working Group, the Secretariat highlighted the questions relating to how to implement ST.26 in the PCT for January 1, 2022 in accordance with the proposed timetable and how to process sequence listings in the PCT, including mitigating translation issues and the handling of sequence listings that were not compliant with the standard. One difference between ST.25 and ST.26 was that the latter permitted the use of "free text" in many more qualifiers than the former. Referring to the different categories of "free text" in paragraph 24 of the document, the Secretariat explained that the proposals aimed to encourage applicants to file any language dependent "free text" in English, which would not be required to be repeated in the main part of the description. The aim for the software tool would be to allow applicants to extract the free text part of sequence listings easily for insertion in to the description where this was needed. Moreover, the software tool should provide efficient facilities for inserting any translated texts and identifying and correcting formal defects prior to filing to minimize errors that would need to be corrected at later stages. However, in the development of the tool, decisions would need to be taken with regard to how strictly the tool would enforce certain requirements such as limitations on the characters permitted in free text qualifiers. The receiving Office would not be expected to check the contents of sequence listings beyond advising applicants of any automatically detected defects, leaving the International Searching Authority and the International Preliminary Examining Authority, where relevant, to check the substance of the application and the compliance of the sequence listing and request the applicant to submit a correction or amendment. While amendments and corrections to a sequence listing might be required in the national phase, translation should be

limited to the main body of the application, which would allow the sequence listing to remain in a single form from filing the international application at the receiving Office to processing in the national phase at the designated or elected Office. The Secretariat concluded by asking the Working Group for high-level guidance on the understanding of the general goals to allow the International Bureau to work further with the Sequence Listings Task Force and bilaterally with Offices on the detailed drafting during the coming year.

285. The Delegation of the United States of America appreciated the efforts made by the International Bureau regarding sequence listings and believed that the document represented a good start towards defining the changes to the Rules and Administrative Instructions that would be necessary for implementation. While the Delegation would provide some specific detailed comments to the International Bureau, it raised two issues. First, with regard to the language issue, the Delegation expressed a concern about paragraph 12 of the document and questioned whether the proposed Rule 20.1(c) which exempted the sequence listing from the language requirement of Rule 12.1(a) was *ultra vires* in view of the language requirements of Article 11. Second, the Delegation suggested that provisions on entry into force should be further considered to allow the possibility to use WIPO Standard ST.26 for any sequence listings newly submitted on or after January 1 of 2022, even if this was in respect of an international application to which WIPO Standard ST.25 would otherwise apply.

286. The Secretariat, in response to the comment expressed by the Delegation of the United States of America about the exemption of sequence listings from translation, stated that the proposals had a similar effect to the existing provisions relating to ST.25. As these provisions had been in force for many years with no concerns, the Secretariat did not believe that the proposals were potentially *ultra vires*.

287. The Delegation of Canada expressed concerns regarding the proposed amendments to the PCT Regulations and modifications to the main body of the Administrative Instructions. In particular, paragraph 22 of the proposed Annex C of the Administrative Instructions implied that the use of some French characters in the language dependent free text portion of a sequence listing would not be compliant with WIPO Standard ST.26. The Delegation understood a need to be accommodating to database providers, but questioned whether WIPO should be setting a precedent whereby providers were effectively setting the requirements for sequence listings in the Regulations and Administrative Instructions which could result in loss of applicant rights. The Delegation advised that Canada would be suggesting a revision to WIPO Standard ST.26 to the Committee on WIPO Standards to allow the filing of sequence listings containing characters not limited to the Unicode Basic Latin ASCII code table characters. The Delegation believed that this would be achievable if *WIPO Sequence* incorporated a translation function. A translated unofficial version of the sequence listing could then be given to the sequence listing database providers. The Delegation also stated that it was a constitutional duty, under section 20(1) of the Canadian Charter of Rights and Freedoms, on all Canadian federal institutions, that any member of the public in Canada had the right to communicate with and receive available services from such entities in English or French. Therefore, Canada could not support the possible mandating that the free text of sequence listings adhere to WIPO Standard ST.26. Furthermore, the Delegation reiterated that WIPO Standard ST.26 and the new rules required the applicant to file a compliant sequence listing. If the sequence listing were not compliant, as in the case of Canada needing to support French characters, the applicant could be invited by the International Searching Authority under Rule 13<sup>ter</sup>.1(a) to submit a compliant one. However, the compliant sequence listing would not form part of the description even if the intent of the originally filed one was to be considered as part of the description. The Delegation suggested that this could result in a loss of rights and proposed as a way forward the possibility of a further modification of the rules to allow that a non-compliant sequence listing in respect of the free text characters could be accepted and kept as part of the description as originally filed. Subsequently, the applicant could be asked for a translated version for the search database providers, which would not be considered as the “as filed” version. Alternatively, that the

Regulations could be amended to indicate that if a sequence listing was filed that was non-compliant with respect to the free text characters, the International Searching Authority could ask for a compliant one that would be considered as the “as filed” version after the International Bureau had verified that no new matter had been added.

288. The Delegation of the European Patent Office stated that the draft amendments to the PCT Regulations and modifications to the Administrative Instructions were an excellent basis for further discussions within the Sequence Listings Task Force and indicated that it would submit detailed comments in writing to the International Bureau. The Delegation raised concerns at the prospect of the return of “mixed-mode filings” where a paper application was accompanied by a sequence listing in electronic form. As noted in the document, the issue of mixed-mode applications was unrelated to the question of the implementation of ST.26 and the Delegation understood the proposal as a side proposal to enhance the handling of sequence listings. The Delegation reminded the Working Group that “mixed-mode applications” had been allowed until 2009, when the former Part 8 of the Administrative Instructions was abolished, and added that handling such mixed-mode applications had been extremely burdensome as such filings had required different repositories and the intervention of specialized personal. Consequently, the abolition of mixed mode filings had been a major step forward, which had also contributed to the gradual reduction of paper filing by applicants. The Delegation also stated that a legal mechanism was in place to deal with exceptional cases, namely Section 703 of the Administrative Instructions which concerned filing requirements and a basic common standard, and suggested that this mechanism could be adapted to act as a failsafe also under ST.26. The Delegation concluded by indicating that the European Patent Office would welcome a PCT Circular regarding the necessary amendments to the PCT legal framework prior to the next session of the Meeting of International Authorities under the PCT in order to facilitate adoption in 2020.

289. The Delegation of China stated that it had concerns with regard to the proposed mandatory requirement for designated Offices to accept English for any free text contained in the sequence listing.

290. The Secretariat, in response to the questions about the limitation of free text to Unicode Basic Latin characters, clarified that external database suppliers did not impose this limitation; rather, it was a conscious proposal of Member States in the Committee on WIPO Standards that had been discussed over several years. The Working Group was only able to recommend whether to continue to implement the Standard and, if so, how listings containing defects according to the Standard should be handled and whether it was possible to identify technical solutions to mitigate the problems. With regard to the comment on mixed-mode filing, the Secretariat stated that allowing mixed-mode filing was a consequence of implementing WIPO Standard ST.26 since the filing of applications on paper in the PCT was permitted, but a sequence listing under ST.26 could not be filed on paper. While an applicant that filed an international application on paper containing a sequence listing would have to file the sequence listing part in electronic form on a physical medium, the Secretariat agreed that this was undesirable and did not expect an applicant would deliberately choose to file a patent application containing a sequence listing in this way. Finally, the Secretariat reminded the Working Group that, in order to meet the implementation deadline of January 1, 2022 for ST.26, the proposed amendments to the PCT Regulations would need to be submitted to the Assembly in 2020. The International Bureau would be continuing to consult on the necessary changes to the PCT Regulations and Administrative Instructions, both during formal meetings and through PCT Circulars.

291. The Working Group invited the International Bureau to continue its consultations on the issues raised in document PCT/WG/12/13.

## **PCT MINIMUM DOCUMENTATION: STATUS REPORT**

292. Discussions were based on document PCT/WG/12/16.

293. The Delegation of the European Patent Office (EPO), as leader of the Task Force, informed the Working Group that discussions on Objective A, namely the revision of the inventory of patent collections belonging to the PCT minimum documentation and the coverage of utility model collections, had been concluded and the updated inventory was being prepared for publication, in the coming months, by the International Bureau. The Task Force had also made significant progress on Objectives B and C relating to the legal and technical requirements for a patent collection to belong to the PCT minimum documentation, respectively. Moreover, the Task Force had made progress on Objective D relating to non-patent literature and traditional knowledge-based prior art, where the United States Patent and Trademark Office (USPTO), as leader of Objective D, had launched a questionnaire and presented some preliminary observations that would set the basis for further discussion. The Task Force had held a physical meeting in Munich on May 21 and 22, 2019 attended by 11 International Authorities and the International Bureau. This meeting had been useful to discuss the major issues to be tackled and gain a better understanding of the challenges ahead. With regard to Objective B, the EPO had proposed to include the patent collections of all International Authorities in the PCT minimum documentation, irrespective of their original language, with the requirement for all Authorities to make their patent collections available under clearly defined technical and accessibility requirements to be agreed upon and specified in an annex to the PCT Administrative Instructions. The Task Force agreed that it was desirable to include the patent collections of all International Searching Authorities in the PCT minimum documentation, but there was a need for further consideration of the practicability of such an objective, in particular, with respect to the volumes of documents and their usefulness. IP Offices that were not International Searching and Preliminary Examining Authorities would have the possibility to include their patent collections in the PCT minimum documentation by notifying the International Bureau that their patent collections were also available according to the same technical requirements as the International Authorities. The Task Force also had discussions on language-based criteria. These discussions were ongoing in terms of whether the PCT minimum documentation should be limited to documents in English or with English abstracts, as proposed by one Authority, or whether the PCT minimum documentation should be language neutral. Another point on objective B still under discussion was the inclusion of utility models, where Rule 34 currently only listed French utility certificates. On this matter, the Task Force was discussing whether to include all utility model collections in the PCT minimum documentation, or none, with both options having their pros and cons. Nevertheless, should the Task Force agree to add utility models, for their inclusion in the PCT minimum documentation, utility model collections would be required to meet the same technical and language requirements as patent collections. For Objective C, the Task Force agreed that all International Authorities should determine the parts of their patent collections that would be able to comply with the proposed technical requirements and by what date compliance would be possible. In this way, it would be possible to envisage a realistic timeline for meeting the requirements and a date from which all patent documents published by International Authorities would have to comply with the new requirements of making the documents available in searchable electronic format. In this regard, a grandfather clause might be considered for documents published before that date. Looking ahead, the EPO, as Task Force leader, would prepare proposals with a view to having all patent collections gradually digitized and thus added to the PCT minimum documentation in order to close the gaps where documents were not in searchable electronic format. In terms of the next steps in the Task Force, discussions would continue on the electronic forum based on new documents prepared by the EPO and USPTO to be posted in July 2019. From these discussions, a document would be prepared by the end of 2019 for discussion at the Meeting of International Authorities in early 2020.

294. The Delegation of the United States of America, as leader of Objective D, thanked the EPO for its leadership of the Task Force and for hosting the physical meeting in Munich. The meeting had been productive, with significant progress made on achieving the final goals of objectives B, C and D with regard to redefining the list and types of documents that should be included in the PCT minimum documentation for both patent document collections and non-patent literature and traditional knowledge-based prior art. The Delegation pointed out that the meeting had helped the Task Force focus more on the goal of setting minimum requirements of documents that each International Authority had to have access to in order to perform a quality search and examination, and less on creating the ideal collection of documents to be searched. The meeting had also been useful for allowing face-to-face discussions amongst working level IT and patent information experts to help ensure that the goals with regard to patent documentation would be realistic. As for non-patent literature, the Task Force had been considering how documents on the list of PCT minimum documentation could be accessed and the discussions during the meeting had shown there was a need to focus more on the content of the documents themselves and whether they should be listed in the form of specific documents. The Delegation concluded by underlining that the meeting had helped the Task Force refocus on the ultimate goals and it looked forward to continued progress on both the patent document aspects and the non-patent literature and traditional knowledge issues.

295. The Delegation of Canada thanked the EPO for leading the Task Force and hosting the physical meeting. The Delegation agreed with the summaries of the meeting presented by the Delegations of the European Patent Office and the United States of America and supported the goals and way forward identified.

296. The Delegation of the Republic of Korea thanked the Delegations of the European Patent Office and the United States of America for their update on the work of the Task Force. The Korean Intellectual Property Office hoped for further progress and agreed with the proposal by the EPO that national patent collections of International Searching Authorities should belong to the PCT minimum documentation.

297. The Delegation of Brazil thanked the EPO for hosting the physical meeting of the Task Force, which was attended by the National Institute of Industrial Property (INPI) of Brazil. The Delegation reiterated the view that utility models should be included in the PCT minimum documentation, adding that utility model protection was widely used by small and medium-sized enterprises as they were cheaper and had a streamlined process to grant. There were therefore a significant source of prior art for searching by examiners and assessing inventive step. Furthermore, the Delegation underlined its wish for the minimum documentation requirements to be language neutral and implemented in an inclusive manner. With the development of machine translation using artificial intelligence, such as the tool WIPO Translate, translation costs could be reduced to a minimum.

298. The Representative of Union of European Practitioners in Industrial Property (UNION-IP) supported the inclusion of utility model publications in the PCT minimum documentation. Many entities used utility model protection instead of filing patent applications, as well as those that used both patents and utility models to protect inventions. As utility models were published earlier than 18 months from the priority date, inventions in published patent applications might have been in the public domain at an earlier stage as a utility model.

299. The Secretariat thanked the Task Force for its work in updating the inventories of the patent literature and non-patent literature parts of the PCT minimum documentation and confirmed that it would update Part 4 of the *Handbook of Industrial Property Information and Documentation* to publish these inventories on the WIPO website.

300. The Working Group noted the contents of document PCT/WG/12/16.

## PCT COLLABORATIVE SEARCH AND EXAMINATION: STATUS REPORT

301. Discussions were based on document PCT/WG/12/15.

302. The Delegation of the European Patent Office (EPO) informed the Working Group that the IP5 Offices had successfully launched the operational phase of the PCT Collaborative Search and Examination (CS&E) pilot on July 1, 2018. The first year of the planned three years of operation of the pilot had passed successfully, with almost 250 applications being accepted, initially in English only and later, with the pilot having been extended to other languages, also in Chinese, German and Japanese. The extension to other languages was the main reason why some Offices that had not quite reached their target of 50 applications. A further extension to accept applications in Korean was expected in the second year of operation. The Delegation expressed satisfaction with the diversity of both applicants and fields of technology covered by the pilot, particularly as the pilot was applicant-driven. There remained some operational challenges, particularly as peer contributions were new work products that needed to be handled in a specific *ad hoc* manner. During the second year of the operational phase to begin on July 1, 2019, the intention would be to process the number of applications required to meet the initial objective of 500 applications in total to be accepted into the pilot. The Delegation pointed out that this was a high number for the Offices processing these applications, but this was necessary to assess whether there was a business case for collaborative search and examination in order to be able to discuss implementation of a model in the PCT. The third year of the pilot would be dedicated to evaluation and assessment.

303. The Delegation of the United States of America thanked the IP5 Offices for their extensive work in the preparation and operation of the pilot and the International Bureau for the development of the collaborative platform in ePCT to support the pilot. The operational phase of the pilot had collected useful data for evaluating and assessing the pilot, which would determine future collaborative activity. In particular, the Delegation looked forward to results from applications in the pilot that entered the national phase to see how collaborative search would meet the needs of designated Offices. The United States Patent and Trademark Office (USPTO) had been learning new things from the pilot; how Offices prepared and used the materials from the peer review was a part that could be re-evaluated. Finally, the Delegation anticipated with interest the discussions at the conclusion of the pilot.

304. The Delegation of China thanked the European Patent Office for its leadership in organizing the CS&E pilot. As a participating Office, the China National Intellectual Property Administration (CNIPA) appreciated the work of the other IP5 Offices and thanked the International Bureau for providing a reliable and practical collaborative platform necessary for smooth operation of the pilot. From March 1, 2019, the CNIPA had accepted filings in Chinese in the pilot, which had worked well. The Delegation looked forward to further cooperation between the IP5 Offices and the International Bureau.

305. The Delegation of Japan expressed its appreciation to the European Patent Office for reporting the progress of the CS&E pilot project. As a participating Office, the Japan Patent Office (JPO) appreciated the smooth operation of the pilot and pointed out that the workload reported in paragraph 8 of the document was not small. However, the JPO considered there was room for improving the collaboration among the participating Offices and with regard to managing the cases in the pilot within each Office. The JPO would continue to consider the details of information exchange and how this could be improved at meetings of the CS&E Pilot Group.

306. The Delegation of the Republic of Korea thanked the European Patent Office for arranging the CS&E pilot. As of June 28, 2019, the Korean Intellectual Property Office (KIPO) would be accepting applications in Korean in the pilot. The specific procedures and conditions for applications filed in Korean were available on the KIPO website.

307. The Delegation of Canada expressed support for the CS&E pilot project and was encouraged by the progress made and the results achieved to date. The Delegation eagerly awaited seeing further results, including the details of all the costs incurred by the participating International Authorities, which it hoped would appear in the final report. The Delegation also expressed interest in hearing possible reasons for the low rates of meeting the deadline for the establishment of final international search reports, as reported in paragraph 8 of the document and whether steps had been taken to improve these rates or, if necessary, to change the deadline to make it more attainable. With respect to filings of applications in French, German, Chinese and Korean, the Delegation enquired whether issues had arisen with respect to the quality of the English translation provided, whether the final international search report and written opinion would be provided in English or in the language of filing, whether the intent was to translate the contribution of the peer examiners into the language of filing and what additional time was necessary to handle these applications compared to those in English. The Delegation also asked about the metrics that would be monitored over the life time of the 500 applications in the pilot.

308. The Delegation of the European Patent Office (EPO), in response to the questions raised by the Delegation of Canada, stated that there were extensive metrics being used to monitor the applications in the pilot. The collaborative tool in ePCT enabled the timeliness of issuing the first preliminary report, the peer contributions and the final search report to be closely followed. In addition, there were other more quality-related aspects concerning the contents of applications and the fate of such applications when they entered the national and/or regional phase. As far as quality of the English translation provided with applications was concerned, the CS&E Pilot Group had not yet discussed this matter since applications in other languages had only recently been accepted into the pilot. However, the EPO was experienced in receiving translations into English and stated that these were normally very good. It was more of a concern that the rates for meeting the deadline for the issuance of the final search reports were not as high as might be expected, especially as the timeliness for Offices providing peer contributions was good. It was premature to draw conclusions from the low timeliness for establishing the final search report, but participating Offices were looking into this matter. In terms of applications that were not filed in English, the applicant would receive the international search report and written opinion in the language of filing. As English was the common working language in the pilot, the applicant would be required to file a translation of the application into English and the main International Searching Authority (ISA) would provide a translation of the provisional international search report and written opinion into English for the peer ISAs to provide their contributions in English. The main ISA would then draw up the final international search report and written opinion in the language of filing. The peer contributions were made available in English in PATENTSCOPE.

309. The Representative of the Japan Intellectual Property Association (JIPA) reported that applicants had received search reports from the main ISA for applications in the pilot, but they could not see details of how the examiner at the main ISA had taken into account the peer contributions from other IP5 Offices. By having detailed information of how the examiner had taken into account peer contributions, the applicant would have a better understanding of the patentability of the invention in the application. The Representative also hoped that the IP5 Offices would evaluate and analyze the pilot cases so far and publish the results.

310. The Representative of the Asian Patent Attorneys Association (APAA) stated that its members looked favorably on the progress of the CS&E pilot. It was unsurprising that applicants' interest in the pilot was high since improving quality of search and examination reports was a priority for all applicants. The Representative was gratified to hear that the project would assess the effect of applications from the pilot in the national phase and was particularly interested in the extent to which the results of collaborative search and examination were accepted in the national phase and whether any additional prior art was raised during national processing. The Representative recalled that the previous triumvirate collaborations between

the EPO, KIPO and the USPTO had reported on national phase processing of the applications and looked forward to further feedback from the present pilot.

311. The Representative of the Institute of Professional Representatives Before the European Patent Office (epi) appreciated the efforts made by the International Authorities in the CS&E pilot and hoped that the collaborative search and examination would soon be a product available as an option to all applicants at reasonable cost.

312. The Delegation of the European Patent Office (EPO) thanked the representatives of the user groups for their interest in the CS&E Pilot. As the pilot was user-driven with real cases, the role of applicants was essential to the exercise. Regarding the comment raised by the Representative of the epi on the eventual cost for an application to have collaborative search and examination, it was part of the mandate of the CS&E Pilot Group to assess all elements of the process and to make proposals for a potential collaborative work product. In response to the comment from the Representative of the JIPA that applicants should be able to identify the extent to which use had been made by the main examiner of the peer contributions, the Delegation pointed out that the peer contributions were made available to applicants in ePCT and published on PATENTSCOPE to permit such evaluation. However, the peer contributions were made available as originally presented by the peer ISA for applicants to assess themselves, without any comments on the contributions from the main ISA. Finally, with regard to the comment from the APAA, the Delegation stated that it would report back to future meetings as fully as possible with regard to the data analyzed concerning applications entering the national phase, noting that at that point, the applications would be published.

313. The Working Group noted the contents of document PCT/WG/12/15.

#### **OTHER MATTERS**

314. The Working Group agreed to recommend to the Assembly that, subject to the availability of sufficient funds, one session of the Working Group should be convened between the September/October 2019 and September/October 2020 sessions of the Assembly, and that the same financial assistance that was made available to enable attendance of certain delegations at this session should be made available at the next session.

315. The International Bureau indicated that the thirteenth session of the Working Group was tentatively scheduled to be held in Geneva in May/June 2020.

#### **SUMMARY BY THE CHAIR**

316. The Working Group noted the contents of the Summary by the Chair in document PCT/WG/12/24 and that the official record would be contained in the present report of the session.

#### **CLOSING OF THE SESSION**

317. The Chair closed the session on June 14, 2019.

*318. The Working Group is invited to comment on contents of the draft report.*

[Annexes follow]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS  
REFERRED TO IN PARAGRAPH 233(a)

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**Rule 40bis**

**Additional Fees in Case of Missing Parts or Correct Elements and Parts**

**Included in the International Application or Considered to Have Been Contained in the  
International Application**

40bis.1 Invitation to Pay Additional Fees

The International Searching Authority may invite the applicant to pay additional fees  
where the fact that a missing part or a correct element or part:

(i) is included in the international application under Rule 20.5(c) or Rule 20.5bis(c),  
respectively; or

(ii) is considered, under Rule 20.5(d) or Rule 20.5bis(d), respectively, to 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;

is notified to that Authority only after it has begun to draw up the international search report.

The invitation shall invite the applicant to pay the additional fees within one month from the date  
of the invitation and indicate the amount of those fees to be paid. The amount of the additional  
fees shall be determined by the International Searching Authority but shall not exceed the  
search fee; the additional fees shall be payable directly to that Authority. Provided any such  
additional fees have been paid within the prescribed time limit, the International Searching  
Authority shall establish the international search report on the international application including  
any such missing part or any such correct element or part.

## Rule 48

### International Publication

48.1 [No Change]

48.2 *Contents*

(a) [No change]

(b) Subject to paragraph (c), the front page shall include:

(i) to (iv) [No change]

(v) where the international filing date has been accorded by the receiving Office under Rule 20.3(b)(ii) ~~or~~ 20.5(d) or 20.5bis(d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part, an indication to that effect, together with an indication as to whether the applicant, for the purposes of Rule 20.6(a)(ii), relied on compliance with Rule 17.1(a), (b) or (b-bis) in relation to the priority document or on a separately submitted copy of the earlier application concerned;

(vi) [No change]

(vii) where applicable, an indication that the published international application contains information concerning a request under Rule 26bis.3 for restoration of the right of priority and the decision of the receiving Office upon such request;

(viii) where applicable, an indication that an erroneously filed element or part has been removed from the international application in accordance with Rule 20.5bis(b) or (c).

(c) to (n) [No change]

48.3 to 48.6 [No Change]

## Rule 51 bis

### Certain National Requirements Allowed under Article 27

#### 51 bis.1 Certain National Requirements Allowed

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

(i) to (vi) [No change]

(vii) any missing indication required under Rule 4.5(a)(ii) and (iii) in respect of any applicant for the designated State:

(viii) in the cases referred to in Rule 82 ter.1, a translation of any erroneously filed element or part removed from the international application in accordance with Rule 20.5 bis(b) or (c).

(b) to (d) [No change]

(e) The national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish a translation of the priority document, provided that such a translation may only be required:

(i) [No change]

(ii) where the international filing date has been accorded by the receiving Office under Rule 20.3(b)(ii), ~~or~~ 20.5(d) or 20.5 bis(d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part, for the purposes of determining under Rule 82 ter.1(b) whether that element or part is completely contained in the priority document concerned, in which case the national law applicable by the designated Office may also require the applicant to furnish, in the case of a part of the description, claims or drawings, an indication as to where that part is contained in the translation of the priority document.

*[Rule 51bis, continued]*

51 bis.2 and 51 bis.3 *[No Change]*

**Rule 82ter**  
**Rectification of Errors Made**  
**by the Receiving Office or by the International Bureau**

*82ter.1 Errors Concerning the International Filing Date and the Priority Claim*

(a) [No change]

(b) Where the international filing date has been accorded by the receiving Office under Rule 20.3(b)(ii), ~~or 20.5(d)~~ or 20.5bis(d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part but the designated or elected Office finds that:

- (i) the applicant has not complied with Rule 17.1(a), (b) or (b-bis) in relation to the priority document;
- (ii) a requirement under Rule 4.18, 20.6(a)(i) or 51 bis.1(e)(ii) has not been complied with;  
or
- (iii) the element or part is not completely contained in the priority document concerned;

the designated or elected Office may, subject to paragraph (c), treat the international application as if the international filing date had been accorded under Rule 20.3(b)(i), ~~or 20.5(b)~~ or 20.5bis(b), or corrected under Rule 20.5(c) or 20.5bis(c), as applicable, provided that Rule 17.1(c) shall apply *mutatis mutandis*.

(c) The designated or elected Office shall not treat the international application under paragraph (b) as if the international filing date had been accorded under Rule 20.3(b)(i), ~~or 20.5(b)~~ or 20.5bis(b), or corrected under Rule 20.5(c) or 20.5bis(c), without giving the applicant the opportunity to make observations on the intended treatment, or to make a request under paragraph (d), within a time limit which shall be reasonable under the circumstances.

*[Rule 82ter.1, continued]*

(d) Where the designated or elected Office, in accordance with paragraph (c), has notified the applicant that it intends to treat the international application as if the international filing date had been corrected under Rule 20.5(c) [or 20.5bis\(c\)](#), the applicant may, in a notice submitted to that Office within the time limit referred to in paragraph (c), request that the missing part concerned, [.or the correct element or part concerned.](#) be disregarded for the purposes of national processing before that Office, in which case that [missing](#) part, [.or that correct element or part.](#) shall be considered not to have been furnished and that Office shall not treat the international application as if the international filing date had been corrected.

[Annex II follows]



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