

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

**Fourth Session  
June 6 to 10, 2011, Geneva**

Summary by the Chair

### **AGENDA ITEM 1: OPENING OF THE SESSION**

1. Mr. James Pooley, Deputy Director General of WIPO, opened the session and welcomed the participants. Mr. Claus Matthes (WIPO) acted as Secretary to the Working Group.

### **AGENDA ITEM 2: ELECTION OF A CHAIR AND TWO VICE-CHAIRS**

2. The Working Group requested the International Bureau to chair the session until nominations were received for a Chair and two Vice-chairs. In the absence of such nominations, the session was chaired by Mr. James Pooley (WIPO), except for the discussions on agenda items 7(b) and (c), which were chaired by Mr. Claus Matthes (WIPO).

### **AGENDA ITEM 3: ADOPTION OF THE AGENDA**

3. The Working Group adopted the revised draft agenda (document PCT/WG/4/1 Rev.) as proposed, with the following addition as new agenda item 10 (and consequential renumbering of agenda items 10, 11 and 12):  
  
"10. Contribution of the Working Group to the implementation of the respective Development Agenda Recommendations."

#### **AGENDA ITEM 4: PCT STATISTICS**

4. The Working Group noted a presentation by the International Bureau on PCT statistics, based on the recently published *PCT Yearly Review 2010*.

#### **AGENDA ITEM 5: MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT ON THE EIGHTEENTH SESSION**

5. The Working Group noted the report of the eighteenth session of the Meeting of International Authorities under the PCT contained in document PCT/MIA/18/16 and reproduced in the Annex to document PCT/WG/4/2.

#### **AGENDA ITEM 6: FUTURE DEVELOPMENT OF THE PCT SYSTEM**

##### **Implementation of Recommendations to Improve the Functioning of the PCT System**

6. The Working Group noted the contents of document PCT/WG/4/3. The Working Group discussed various matters which needed to be taken into account in relation to the continued implementation of the recommendations endorsed by the Working Group at its third session. Several delegations again emphasized that the PCT system can and should function more effectively, within the existing legal framework, to deliver results which meet the needs of applicants, Offices and third parties in all Contracting States, without limiting the freedom of Contracting States to prescribe, interpret and apply substantive conditions of patentability and without seeking substantive patent law harmonization or harmonization of national search and examination procedures.

##### **The Surge in Worldwide Patent Applications**

7. Discussions were based on document PCT/WG/4/4. A number of delegations welcomed the study by the International Bureau on the surge in worldwide patent applications as comprehensive and useful. Other delegations expressed concern that the study failed to address the root causes of the surge in worldwide patent applications and other possible underlying causes for the surge, as mandated by the third session of the Working Group, notably issues relating to so-called strategic patenting behavior. Moreover, these delegations expressed that the study should not have presented recommendations and considered that the statement it contained relating to the importance of work sharing arrangements was unsupported by the findings of the study.
8. After some discussion, the Working Group agreed to request the Office of the Chief Economist to prepare a supplement to, or revision of, the study, for consideration by the Working Group at its next session, taking on board the comments made during the session and any further literature references subsequently submitted by delegations.

##### **Coordination of Technical Assistance and Financing of Technical Assistance Projects for Developing Countries under Article 51 of the PCT**

9. Discussions were based on document PCT/WG/4/5. A number of delegations called for the Committee for Technical Assistance to be convened at an early opportunity, preferably in advance of each session of the Working Group. Others considered that further consideration was needed of how best to achieve the objectives of ensuring effective overview and direction of the relevant technical assistance activities, taking into account the work of other bodies and the difficulty in clearly delineating development cooperation related activities which related to the PCT.

10. The International Bureau clarified that the focus of the second part of the study on extra-budgetary funding reflected the understanding of the International Bureau as to the type of additional funding which was envisaged by Article 51(4). The study was not intended to suggest that funding of technical assistance activities from WIPO's regular budget should be reduced in favor of using more extra-budgetary resources.
11. The Working Group agreed that the International Bureau should provide more detailed information on the existing technical assistance projects relating to the PCT and their sources of funding, for discussion at the next session of the Working Group, in order to allow a more informed discussion on the question of the future of the Committee for Technical Assistance and related issues of the funding of technical assistance projects.

#### **The PCT's Aims of Disseminating Technical Information, Facilitating Access to Technology and Organizing Technical Assistance for Developing Countries**

12. The Working Group noted the contents of document PCT/WG/4/6 and requested the International Bureau to present the study as recommended by the Working Group in its third session and contained in paragraph 211*bis* of the Annex to document PCT/WG/4/3.

#### **Third Party Observation System; Quality Feedback System**

13. Discussions were based on document PCT/WG/4/7. The Working Group supported the introduction of the system which was now under development but noted a number of concerns with regard to specific features of the system which the International Bureau would further consider in the implementation of the system. The pilot would be closely monitored, in particular with regard to possible abuses.

#### **UK Experiences of Encouraging More Effective Use of the International Phase: PCT (UK) Fast Track**

14. The Working Group noted the contents of document PCT/WG/4/14, containing a report by the United Kingdom (UK) Intellectual Property Office (IPO) on the UK experiences with its PCT (UK) fast track service introduced in 2010 to encourage more effective use of the international phase.

#### **Collaborative Search and Examination Pilot Project: Status Report**

15. The Working Group noted the contents of document PCT/WG/4/15, containing a report by the European Patent Office (EPO) on a pilot project carried out by the United States Patent and Trademark Office, the Korean Intellectual Property Office and the EPO to test the concept of collaborative search and examination. A number of delegations welcomed the information on this possible route for improving the quality of international reports. Some delegations reiterated that such reports should remain non-binding on national Offices.

#### **AGENDA ITEM 7: PROPOSED CHANGES TO THE PCT PROCEDURAL AND LEGAL FRAMEWORK**

##### **PCT Minimum Documentation: Addition of Patent Documents of the People's Republic of China**

16. Discussions were based on document PCT/WG/4/8.
17. The Working Group approved the proposed amendments of the Regulations set out in the Annex to this Summary by the Chair with a view to their submission to the Assembly for consideration at its next session, in September-October 2011.

### **Presentation of Sequence Listings under the PCT**

18. Discussions were based on document PCT/WG/4/9. The Working Group supported the proposal set out in document PCT/WG/4/9 to review the relationship between Annex C of the PCT Administrative Instructions and the relevant WIPO Standard(s). Several delegations emphasized the importance of transitional arrangements covering the co-existence of WIPO Standard ST.25 and the future XML-based standard.

### **Proposed Amendments of Rules 17.1(b-bis) and 20.7(b)**

19. Discussions were based on document PCT/WG/4/10 Rev.
20. The Working Group approved the proposed amendments to the Regulations set out in the Annex to this Summary by the Chair with a view to their submission to the Assembly for consideration at its next session in September-October 2011.

### **Excuse of Delay in Meeting Certain Time Limits due to *Force Majeure***

21. Discussions were based on document PCT/WG/4/12.
22. The Working Group approved the proposed amendments to the Regulations set out in the Annex to this Summary by the Chair with a view to their submission to the Assembly for consideration at its next session in September-October 2011.

### **AGENDA ITEM 8: SUPPLEMENTARY INTERNATIONAL SEARCHES**

23. The Working Group noted the contents of document PCT/WG/4/11. Various International Authorities encouraged users to provide feedback with a view to identifying how to make the system more attractive. One Authority expressed the need to focus on the goal of improving the search of the main International Searching Authority.

### **AGENDA ITEM 9: PCT ONLINE SERVICES**

24. Discussions were based on document PCT/WG/4/13. Several delegations expressed support for the pilot system and the general vision for the future. In response to certain concerns raised, the International Bureau assured the Working Group that there would be extensive consultation to address usability, costs, approach and architecture to ensure that the system was effective and desirable, respecting both the international and national legal frameworks as well as practical constraints which existed.

### **AGENDA ITEM 10: CONTRIBUTION OF THE WORKING GROUP TO THE IMPLEMENTATION OF THE RESPECTIVE DEVELOPMENT AGENDA RECOMMENDATIONS**

25. A number of delegations made statements on the contribution of the Working Group to the implementation of the respective Development Agenda Recommendations. The Chair stated that all statements would be recorded in the report for the fourth session of the Working Group and that it would be transmitted to the WIPO General Assembly in line with the decision taken by the 2010 WIPO General Assembly relating to the Development Agenda Coordination Mechanism.

### **AGENDA ITEM 11: OTHER MATTERS**

26. Upon request of one delegation, the International Bureau agreed to assess the practice under the Rules dealing with the restoration of the right of priority, five years after their entry into force, and to report back to the Working Group at its next session in 2012.

27. The Working Group agreed that the draft report of the session, taking into account comments received from delegations after the session, should be submitted to the Assembly for consideration at its next session.
28. The Working Group agreed to recommend to the Assembly that, subject to the availability of sufficient funds, that one session of the Working Group should be convened between the September 2011 and September 2012 sessions of the Assembly, and that the same financial assistance that had been made available to enable attendance of certain delegations at this session should be made available at the next session.
29. The International Bureau indicated that the fifth session of the Working Group was tentatively scheduled to be held in Geneva in May/June 2012.

**AGENDA ITEM 12: SUMMARY BY THE CHAIR**

30. The Working Group noted that the present document was a summary established under the responsibility of the Chair and that the official record would be contained in the report of the session. The report would reflect all interventions made during the meeting, and would be adopted by the Working Group by correspondence, after having been made available for comments on the Working Group's electronic forum as a draft in both English and French.

**AGENDA ITEM 13: CLOSING OF THE SESSION**

31. The Chair closed the session on June 9, 2011.
  32. *The Working Group noted the contents of this summary by the Chair.*

[Annex follows]

## ANNEX

## Draft Amendments of the PCT Regulations

## Approved by the Working Group

## Rule 17

## The Priority Document

17.1 *Obligation to Submit Copy of Earlier National or International Application*

(a) and (b) [No change]

(b-bis) Where the priority document is, in accordance with the Administrative Instructions, made available to ~~the receiving Office or~~ to the International Bureau from a digital library prior to the date of international publication of the international application, the applicant may, ~~as the case may be,~~ instead of submitting the priority document, ~~:-~~

~~(i) request the receiving Office to obtain the priority document from such digital library and transmit it to the International Bureau; or~~

~~(ii) request the International Bureau prior to the date of international publication to obtain the priority document from such digital library.~~

~~Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office or the International Bureau to the payment of a fee.~~

(c) and (d) [No change]

17.2 [No change]

## Rule 20

### International Filing Date

20.1 to 20.6 [No change]

20.7 *Time Limit*

(a) [No change]

(b) Where neither a correction under Article 11(2) nor ~~or~~ a notice under Rule 20.6(a) confirming the incorporation by reference of an element referred to in Article 11(1)(iii)(d) or (e) is received by the receiving Office prior to ~~after~~ the expiration of the applicable time limit under paragraph (a), any such correction or notice received by that Office after the expiration of that time limit but before it ~~that Office~~ sends a notification to the applicant under Rule 20.4(i), ~~that correction or notice~~ shall be considered to have been received within that time limit.

20.8 [No change]

## Rule 34

### Minimum Documentation

#### 34.1 *Definition*

(a) and (b) [No change]

(c) Subject to paragraphs (d) and (e), the “national patent documents” shall be the following:

(i) [No change]

(ii) the patents issued by the Federal Republic of Germany, [the People's Republic of China](#), the Republic of Korea and the Russian Federation,

(iii) to (vi) [No change]

(d) [No change]

(e) Any International Searching Authority whose official language, or one of whose official languages, is not [Chinese](#), Japanese, Korean, Russian or Spanish is entitled not to include in its documentation those patent documents of [the People's Republic of China](#), Japan, the Republic of Korea, the Russian Federation and the former Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than six months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

(f) [No change]



## Rule 82

### Irregularities in the Mail Service

82.1 [No change]

82.2 [Deleted] *Interruption in the Mail Service*

~~(a) Any interested party may offer evidence that on any of the 10 days preceding the day of expiration of the time limit the postal service was interrupted on account of war, revolution, civil disorder, strike, natural calamity, or other like reason, in the locality where the interested party resides or has his place of business or is staying.~~

~~(b) If such circumstances are proven to the satisfaction of the national Office or intergovernmental organization which is the addressee, delay in arrival shall be excused, provided that the interested party proves to the satisfaction of the said Office or organization that he effected the mailing within five days after the mail service was resumed. The provisions of Rule 82.1(c) shall apply *mutatis mutandis*.~~

**Rule 82quater**

**Excuse of delay in meeting time limits**

82quater.1 Excuse of Delay in Meeting Time Limits

(a) Any interested party may offer evidence that a time limit fixed in the Regulations was not met due to war, revolution, civil disorder, strike, natural calamity or other like reason in the locality where the interested party resides, has his place of business or is staying, and that the relevant action was taken as soon as reasonably possible. Any such evidence shall be submitted not later than six months after the expiration of the time limit applicable in the given case.

(b) If such circumstances are proven to the satisfaction of the national Office or intergovernmental organization which is the addressee, delay in meeting the time limit shall be excused, provided that any such excuse shall have no effect in any designated or elected Office where the processing or examination of the international application has already started.

[End of Annex and of document]