

Patent Cooperation Treaty (PCT) Working Group

Eighth Session
Geneva, May 26 to 29, 2015

REPORT

adopted by the Working Group

1. The Patent Cooperation Treaty Working Group held its eighth session in Geneva from May 26 to 29, 2015.
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): Australia, Austria, Belarus, Belgium, Brazil, Cameroon, Canada, Chile, China, Colombia, Cuba, Czech Republic, Democratic People's Republic of Korea, Denmark, Dominican Republic, Ecuador, Egypt, El Salvador, Finland, France, Gabon, Germany, Ghana, Greece, Guatemala, Honduras, Hungary, India, Iran (Islamic Republic of), Israel, Italy, Japan, Latvia, Lithuania, Madagascar, Mexico, Morocco, New Zealand, Nicaragua, Nigeria, Norway, Panama, Poland, Portugal, Republic of Korea, Romania, Russian Federation, Saudi Arabia, Serbia, Singapore, Slovakia, South Africa, Spain, Sweden, Switzerland, Thailand, Trinidad and Tobago, Tunisia, Turkey, Ukraine, United Arab Emirates, United Kingdom, United Republic of Tanzania, United States of America, (64); (ii) the following intergovernmental organizations: European Patent Office (EPO), the Nordic Patent Institute (NPI) (2).
3. The following intergovernmental organizations were represented by observers: African Intellectual Property Organization (OAPI), African Regional Intellectual Property Organization (ARIPO), Eurasian Patent Organization (EAPO), South Centre (4).

4. The following international non-governmental organizations were represented by observers: Asian Patent Attorneys Association (APAA), European Law Students' Association (ELSA International), Innovation Insights, Institute of Professional Representatives before the European Patent Office (EPI), International Center for Trade and Sustainable Development (ICTSD), International Federation of Industrial Property Attorneys (FICPI), Patent Information Users Group (PIUG) (7).

5. The following national non-governmental organizations were represented by observers: American Intellectual Property Law Association (AIPLA), Asociación de Agentes Españoles Autorizados ante Organizaciones Internacionales de la Propiedad Industrial (AGESORPI), Brazilian Association of Intellectual Property (ABPI), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA) (5).

6. The list of participants is contained in Annex VII.

OPENING OF THE SESSION

7. Mr. Francis Gurry, Director General of WIPO, opened the session and welcomed the participants. Mr. Claus Matthes (WIPO) acted as Secretary to the Working Group.

8. The Director General stated that the Working Group had become an extremely productive and exceptionally important meeting for WIPO. The PCT was a successful example of international cooperation. But further success depended on this cooperation continuing, where the Working Group provided the means of taking forward the PCT in the rapidly-changing global environment. As examples of the success of the PCT system, the number of international patent applications showed a growth rate of 4.1 per cent in 2014, taking the total to about 215,000. International applications had been filed in 124 countries, which was an extremely good and encouraging result. There also had been an increase of more than 8 per cent in the number of applicants compared to 2013, reaching a total of nearly 50,000. The top filer in 2014 had been Huawei Technologies of China with nearly 3,500 published PCT applications. In terms of countries of origin of applicants, the United States of America had continued to lead with nearly 61,500 international applications, with Japan in second place with more than 42,000 applications, and China, which had registered double digit growth for the 12th consecutive year, in third place with more than 25,000 international applications. The success of the PCT system had also been shown in the record number of national phase entries, which grew by 4.3 per cent. All these results showed the success of the PCT system as the central element of the international patent system. However, cooperation within the Working Group was needed to meet the challenges before the system in order to make it even more attractive and keep pace in the global economy.

9. The Director General highlighted two of the challenges the PCT system was facing. The first challenge concerned the issue of fluctuations of exchange rates. Recent history had demonstrated the impact of the rise in value of the Swiss franc on the revenue to WIPO, where 75 per cent of this revenue came from fees in the PCT system. The present mechanism for adjusting fees due to exchange rate fluctuations involved changing equivalent amounts when there were movements of more than 5 per cent over a period of a month in the exchange rate between two currencies. This was a lengthy process, taking four to six months for the new amounts to take effect. One of the proposals in this session of the Working Group related to the International Bureau conserving the real value of the filing fee by hedging, noting that this was unrelated to risk hedge funds. The proposal to hedge the international filing fee would be the first of two stages, the second stage being the hedging of the search fee. However, this second stage was more complex and needed further consideration before moving forward with a proposal. The second challenge related to the transparency of the international patent system. Patent legal status data was a major source of economic intelligence. While recognizing the burden on designated Offices, providing data on entry into the national phase was extremely important for the international patent system and relatively easy to implement. This would provide an improved basis on which to assess the functioning of the PCT system as well as

giving applicants and other interested parties a better overview of what was happening in the international patent system. The Director General therefore encouraged the Working Group to tackle both of these challenges in a forward-looking manner.

ELECTION OF A CHAIR AND TWO VICE-CHAIRS

10. The Working Group unanimously elected Mr. Victor Portelli (Australia) as Chair for the session. There were no nominations for Vice-Chairs.

ADOPTION OF THE AGENDA

11. The Working Group adopted the revised draft agenda as proposed in document PCT/WG/8/1 Rev. 2.

OPENING STATEMENTS

12. The Delegation of Singapore updated the Working Group on the progress of the Intellectual Property Office of Singapore (IPOS) towards beginning operations as an International Searching and Preliminary Examining Authority, following its appointment by the PCT Assembly at its forty-sixth session in September 2014. IPOS had achieved ISO 9001:2008 certification for its patent search and examination processes in November 2014 and now had more than 100 patent examiners. Moreover, processes had been put in place to handle international search and preliminary examination work, and examiners had undergone training for their new role. IPOS intended to begin operations as an International Searching and Preliminary Examining Authority on September 1, 2015.

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT ON THE TWENTY-SECOND SESSION

13. Discussions were based on document PCT/WG/8/2.

14. The Secretariat introduced the document, which reported on the twenty-second session of the Meeting of International Authorities (MIA) under the PCT and the fifth informal session of the PCT/MIA Quality Subgroup. In terms of activities of the Quality Subgroup, the focus continued to be on practice measures to improve the quality and usefulness of PCT international work products to applicants and Offices. In terms of measures which could contribute to the better understanding of work products by other Offices, progress was made in discussions on a minimum set of information to be included in search strategies to be made publicly available. The Subgroup also discussed the use of standardized clauses in written opinions and international preliminary reports on patentability, which would further facilitate the understanding of these reports by Offices and applicants, as well as facilitate translation of these reports. Under the header "quality improvement measures", the Subgroup had discussed how to improve the guidance for examiners on unity of invention. Discussions had also continued with regard to establishing formal mechanisms for providing feedback by designated Offices on work products established by International Authorities. A long term goal in the work of the Subgroup was the establishment of quality metrics to measure quality and, if at all possible, usefulness to Offices and applicants. In this area, the Subgroup agreed for the International Bureau to continue to produce annual reports on characteristics of international search reports; reports for previous years had been made available on the WIPO web site, which the Secretariat encouraged the Working Group, especially the user community, to study. It was, however, important to note that the aim of such reports was not to measure quality on the basis of these characteristics, but to see what could be learned and assist further work to improve quality, either in each Authority individually, or as measures to be taken up collectively. More broadly, discussions had continued on the overall aim of establishing a PCT metrics framework, which would allow metrics to be developed covering a wide range of processes, not only within International Authorities, but also in receiving Offices, the International Bureau and designated and elected Offices. By looking at the interaction between these actors, it could be possible to see how processes might be improved. At this early stage, there was agreement to concentrate efforts on developing a small number of metrics as a first step, using data available to the

International Bureau, rather than setting out to collect new data which would further delay the exercise. In this regard, the focus would initially be on metrics established with regard to timeliness of certain processes. Finally, the Meeting of International Authorities had approved the continuation of the mandate of the Quality Subgroup and the convening of a physical meeting in conjunction with the next meeting of Meeting of International Authorities, to take place in spring 2016.

15. The Working Group noted the report of the twenty-second session of the Meeting of International Authorities, based on a Summary by the Chair of that session contained in document PCT/MIA/22/22 and reproduced in the Annex to document PCT/WG/8/2.

PCT STATISTICS

16. The Working Group noted a presentation by the International Bureau on the most recent PCT statistics¹.

17. The Secretariat, in response to a suggestion by the Delegation of the European Patent Office to present timeliness of International Searching Authorities by showing the proportions of international applications published at the same time as the international search report, acknowledged that the Meeting of International Authorities had agreed to include this indicator in the *PCT Yearly Review*. Unfortunately, this would not be presented in the *2015 PCT Yearly Review*, but it would be part of the publication in the future.

PCT ONLINE SERVICES

18. Discussions were based on document PCT/WG/8/20.

19. The Secretariat explained that the document outlined some of the recent developments in PCT online services hosted by the International Bureau and priorities identified for further work in the coming year. Among the main developments were the browser-based services offered by ePCT and the eSearchCopy service. While automation had previously been mainly limited to larger Offices, it was now possible for all Offices to offer secure electronic services and benefit from electronic communication with the International Bureau and other Offices. Since April 16, 2015, ePCT had been available in all 10 languages of publication, both for applicants and Offices. ePCT also offered online filing at 17 receiving Offices with several more due to begin in the coming months. Over half of these Offices had the system introduced as a new level of service for their applicants at close to zero cost for them using servers hosted by the International Bureau that were customized to local requirements. For these Offices, the ePCT-filing services had been well received by applicants and had become the most-used filing method in most of these Offices. ePCT-filing had a number of advantages over traditional e-filing. Reference data and validation rules were always up to date and detected a wider range of problems. It was also possible to review drafts by generating a preview, resulting in fewer areas needing correction before receiving Offices. Overall, 52 Offices had access to ePCT browser-based services. Many of these Offices which did not previously have electronic communications with the International Bureau were now using ePCT for all communications with the International Bureau. For 27 Offices, in roles as receiving Offices or as International Searching and Preliminary Examining Authorities, it was possible to upload post-filing documents through ePCT, delivered to the Office either through the browser interface or by secure FTP batches at its preference.

20. The Secretariat continued by providing details of the eSearchCopy system, which was in operation for a small number of pairs of receiving Offices and International Searching Authorities. eSearchCopy allowed the search copy to be generated from the record copy and sent automatically by the International Bureau on behalf of the receiving Office to the

¹ A copy of the presentation is available on the WIPO website at http://www.wipo.int/meetings/en/details.jsp?meeting_code=pct/wg/8.

International Searching Authority when the necessary fees had been paid. This therefore held the potential to reduce costs and transmission delays, and to allow cheaper, more consistent import of data by International Searching Authorities, particularly those which were competent to act for international applications filed at many receiving Offices. The number of applications being sent by eSearchCopy remained small, but the mix of Offices operating the service demonstrated that the main processes worked well, whether for delivery by PCT-EDI batch or individually using the ePCT browser-based interfaces. Further evaluation remained to be performed, notably for the pilot at the European Patent Office, which acted as an International Searching Authority for 105 receiving Offices worldwide. Although minor improvements would be needed to minimize the risk of delays in onward transmission of search copies in certain cases, the initial prospects showed that this service could be useful for a large number of Offices, reducing costs and improving the service offered to applicants.

21. The Secretariat concluded by stating that the infrastructure was in place to improve significantly the efficiency of international phase processing and to give better results to applicants, to Offices and to third parties who used the results of all these processes. The International Bureau would continue to refine the centralized services available and to look further at issues such as full text application bodies, centralized payment of fees, and machine translation issues. However, the International Bureau believed that the main priority for the coming year should be the collective use of the available services by receiving Offices, International Searching and Preliminary Examining Authorities and the International Bureau to ensure that ePCT delivered its potential for users worldwide, particularly for International Searching Authorities which were competent for many receiving Offices around the world and therefore serving applicants over a wide geographical area. This would require more receiving Offices being able to receive international applications that had been prepared and filed using ePCT, as well as more receiving Offices and International Authorities accepting post-filing documents uploaded by the applicant using ePCT. Receiving Offices and International Authorities also needed to transmit additional document types to the International Bureau to make available to applicants through ePCT, especially important documents such as invitations to pay additional fees, which could otherwise take up to two weeks to reach the applicant by conventional post. There should also be more pairs of Offices using the eSearchCopy service. Furthermore, it was desirable to move towards the exchange of directly useable data instead of image-based forms, in particular for search reports and information concerning important status information such as the fact that the search copy had been received. Finally, there was potential to identify opportunities for improving the efficiency or usefulness of the entire PCT system by enabling near real-time interactions between Offices or between applicants and Offices using web services. The Secretariat therefore invited Offices to work together with the International Bureau for ePCT to deliver better results for applicants, third parties and other Offices.

22. The Delegation of Australia welcomed the ongoing development of ePCT. As a user of the system, IP Australia saw considerable value in the progress that could be made. Both IP Australia and its applicants were particularly interested in the ability to pay fees upfront in ePCT. With the implementation of e-PCT filing, IP Australia had a least one filing channel compliant with Annex F of the Administrative Instructions and would therefore be withdrawing its final remaining notification of incompatibility.

23. The Delegation of the United States of America supported the priorities laid out in the document and indicated that the United States Patent and Trademark Office planned to participate in the work. With regard to specific priorities, the Delegation fully supported Offices providing documents to the International Bureau for making available to applicants through ePCT, eSearchCopy, and further near-real-time interactions using web services. However, the electronic filing system at the United States Patent and Trademark Office was only able to accept and process the same information that was prepared via PCT-SAFE in its EFS-web mode, and was therefore not able to accept full applications created in ePCT. Regarding receiving Offices and International Authorities accepting post-filing documents uploaded by the

applicant using ePCT, an applicant could not file these documents at the United States Patent and Trademark Office using ePCT, but this might be possible in the near future if several obstacles could be overcome. One obstacle related to pre-publication information being stored on a computer not housed in the United States of America, another was the legal basis under which the International Bureau could, on behalf of the United States Patent and Trademark Office in its capacity as a receiving Office, assign a date of receipt to such papers. The Delegation looked forward to working with the International Bureau on these issues.

24. The Delegation of Chile expressed satisfaction with the ePCT system and looked forward to participating with the International Bureau in future developments. The National Institute for Industrial Property of Chile had started to accept applications through ePCT in January 2015 and one third of applications were now filed electronically. The development of eSearchCopy was of particular value to facilitate delivery of the search copy to the International Searching Authority.

25. The Delegation of Japan appreciated the progress made to the functionality of ePCT and future development of the system and added that the Japan Patent Office had been using the eSearchCopy service. However, it was necessary to clarify certain legal issues and to address challenges in IT systems before the Japan Patent Office could accept ePCT as a filing method for international applications. In this regard, the Delegation requested the International Bureau to offer information on two points: first, the technical specifications for receiving Offices to develop their own services to accept applications filed using ePCT, and second, the methods of sending electronic certificates to applicants through servers hosted by receiving Offices.

26. The Delegation of the European Patent Office supported the development of ePCT services for both Offices and applicants, pointing to four principles which were important for the success of the system. First, ePCT should improve efficiency, based on a system that was transparent and would hopefully further improve timeliness. Second, ePCT needed to be interoperable with IT systems of other Offices. Third, ePCT needed to be legally sound, based on the legal framework. And finally, ePCT needed to be business-orientated and user-friendly. ePCT offered great potential for further developments. Having implemented ePCT-filing of international applications, the European Patent Office was particularly interested in the possibilities for applicants to upload post-filing documents, which it was exploring with the International Bureau as part of its internal IT roadmap. In terms of the eSearchCopy project, the European Patent Office had also signed a Memorandum of Understanding with the International Bureau to work together to put in place a system, beginning with a one year pilot from July 1, 2015 involving seven receiving Offices. After the pilot, the European Patent Office hoped to extend the service to many more receiving Offices. In terms of exchanging directly-usable data rather than image-based forms, the European Patent Office continued to improve the quality of data already existing in digital format, especially search reports, and the Office intended to digitize all processes under its IT roadmap. The Delegation was also particularly interested in efforts of other Offices so data could be more easily searched and machine-translated. Within the IP5 cooperation, one of the upcoming projects in the Global Dossier Task Force related to full digitization of documents in the patent procedure. The European Patent Office exchanged documents whenever possible in bulk format, and would soon begin discussions with the International Bureau and other Offices on how further automation using machine-to-machine systems could be achieved where web services currently communicated with the systems at the European Patent Office. The Delegation therefore looked forward to the further development of near-real-time interactions using web services to contribute to full digitization efforts.

27. The Delegation of Israel welcomed the development of PCT online services, which provided an efficient and effective service for applicants and Offices using a web interface. The Israel Patent Office had been part of the eSearchCopy trial, and since October 1, 2014, had started to use the live service by receiving search copies through eSearchCopy as an International Searching Authority for applications filed at the United States Patent Trademark Office as the receiving Office. Taking into account the advantages of eSearchCopy, the

Delegation hoped the service could be implemented for other pairs of receiving Offices and International Searching Authorities. In respect of ePCT-filing, as a consequence of the phasing out of PCT-EASY from July 1, 2015, the Israel Patent Office had started a project with the International Bureau to ensure continuing availability of applicant software for filing international applications at the Israel Patent Office, which it hoped to complete later in 2015. Given that the uploading of a patent specification onto a remotely-hosted server using ePCT would not comply with national security laws in Israel, the International Bureau had proposed a mechanism to create a bibliographic e-filing package not containing the patent specification for upload onto the Israel Patent Office online uploading site, which would require the applicant to upload the package plus the specification document when using the Israel Patent Office e-filing upload server. Finally, with regard to measurable data, the Israel Patent Office supported moving towards full text and machine readable formats as an alternative to pdf, and was interested in exchanging data in XML format and willing to transmit test examples to the International Bureau for consideration. For example, reports could be exported with live hyperlinks to enable applicants to navigate to the cited documents. The Delegation also suggested that the International Bureau could investigate options for transmitting demands to the International Preliminary Examining Authority in XML format.

28. The Delegation of France reported that PCT online services had received positive feedback from users. The National Institute of Industrial Property was in favor of the general suggestions in the document and was working on bringing about a greater use of the services offered by ePCT. The Delegation welcomed the launch of the eSearchCopy pilot between the European Patent Office and a selection of the receiving Offices for which it acted as International Searching Authority and hoped this would be a success to allow more receiving Offices to join the eSearchCopy system.

29. The Secretariat responded to the points raised by delegations. In terms of legal issues, the ePCT system had been designed to work effectively with the existing technical systems in Offices and legal constraints as far as they could be determined. In terms of the time of receipt of a document at a server hosted by the International Bureau, the servers were set to the local time in the receiving Office. For example, an international application filed at IP Australia through a remote server in Geneva would register the time in Canberra when the application was received. An applicant was also able to check the time at the receiving Office, International Searching Authority and International Bureau before uploading a document. As for national security issues, the International Bureau was willing to work with Offices with these concerns on a bilateral basis. In terms of the technical specifications required for ePCT filing raised by the Delegation of Japan, these were identical to receiving applications from PCT SAFE, noting that the same concerns existed in PCT SAFE; a server capable of receiving an application from PCT SAFE should be able to receive applications from ePCT unless applications from other clients were specifically blocked, since the format of what was sent and transmission protocols were identical. In response to the second question raised by the Delegation of Japan on electronic signatures, there were several different issues, such as how an applicant could place a text stream signature on a particular document, how packages were digitally signed and the digital certificates used to verify the user logging into the system. ePCT was able to support some existing digital certificates from other Offices and the International Bureau was working to make the system easier to use while safeguarding full security by seeking a more user-friendly but equally secure alternative to digital certificates. The International Bureau also welcomed hearing from Offices with specific concerns to guarantee security in the filing of applications and signature of forms electronically.

30. The Representative of the American Intellectual Property Law Association (AIPLA) raised the question of copyright protection of non-patent literature and the balance that needed to be struck between viewing a cited document and the interests of the copyright owner, particularly where there was no access to international library databases. In the United States of America, this balance was addressed in the Patent Information Retrieval (PAIR) system. In private PAIR,

which was only accessible to the particular practitioner working on a patent application, access was provided to scanned documents in pdf format. However, the public would not be able to access underlying non-patent literature documents in PAIR after publication.

31. The Secretariat, in response to the question raised by the Representative of the American Intellectual Property Law Association (AIPLA), reminded the Working Group of the obligations under Article 20(3) for the International Searching Authority to provide copies of documents cited in the international search report at the request of the designated Office or the applicant. To meet this obligation, the typical arrangement was for International Searching Authorities to send paper copies to the applicant. However, designated Offices often considered it did not warrant the effort to make individual requests, but instead searched for documents in their own collections or asked the applicant to provide a copy. The International Bureau had arrangements for handling copies of cited documents in the ePCT system, though they were currently only routinely used in relation to documents uploaded with third party observations, rather than documents cited in international search reports. In providing services to applicants and designated Offices as required by Article 20(3), any non-patent literature documents received by the International Bureau were made privately available to applicants and designated Offices but, in order to respect copyright, were not publicly available on PATENTSCOPE. The distribution of such documents was thus limited to Offices where the making available of documents would be likely to fall under a statutory exemption for processing purposes or a fair use exception. A third party wishing to view the document would be required to contact the publisher or obtain a copy from a library.

32. The Working Group noted the contents of document PCT/WG/8/20.

SUPPLEMENT TO “ESTIMATING A PCT FEE ELASTICITY” STUDY

33. Discussions were based on document PCT/WG/8/11.

34. The Chief Economist of WIPO explained that the document supplemented the study on PCT fee elasticity presented at the seventh session of the Working Group (document PCT/WG/7/6) by exploring the effects of possible fee reductions for universities in developed and developing countries, as had been requested by the Working Group (see paragraph 23 of the Summary by the Chair of the session, document PCT/WG/7/29, and paragraph 68 of the Report of the session, document PCT/WG/7/30). In economic terms, elasticity was the term used for describing how sensitive one variable was to a change in another variable. In the specific context of the patent system, fee elasticity measured how responsive applicants were to changes in the application fee. In the PCT, high fee elasticity would mean a small fee change would result in a large difference in the volume of international applications, while low fee elasticity or an inelastic demand would mean a large fee change would have little effect on the number of applications filed. The study presented at the seventh session of the Working Group had estimated that the international filing fee was largely inelastic; a 10 per cent fee increase would result in a decrease in the overall filing volume by 0.278 per cent. The study also suggested that filing volumes from universities and public research organizations were more price sensitive than the average applicant. The supplementary study used the same data and model, studying how the historical variation in the fees in the local currency due to variations in exchange rates affected the inclination of the applicant to use the PCT or the Paris route, taking into account inflation, unemployment rate, whether the origin of the applicant was from a PCT member state, the size of the patent family and the field of technology. To determine whether the applicant was from a developing or developed country, the criterion used was whether a natural person from the country would be entitled to a reduction in the international filing fee.

35. The Chief Economist continued by presenting the results of the supplementary study. The study confirmed that applications from universities and public research organization were more sensitive to fee variations than the average applicant. This was especially the case for applications from universities in developing countries, which were three times more sensitive to fee changes than applications from developed countries, but represented a much smaller

sample size. This difference was not observed for public research organizations, but there were relatively few public research organizations from developing countries in the dataset and it was not clear that all had been correctly identified. Focusing on the data for universities, the implied fee elasticity for university applicants from developing countries was four times as large as the one for university applicants from developed countries, which in turn was twice as large as the fee elasticity for other applicants. Using these elasticity estimates to analyze the impact of hypothetical fee reductions for universities from developing and developed countries on filing volumes and fee income, a 50 per cent fee reduction would have resulted in 139 additional filings from universities in developing countries at a loss of more than one million Swiss francs, representing about 0.36 per cent of total PCT fee income. For universities from developed countries, in view of the much larger sample size, the number of additional filings generated by a 50 per cent fee reduction was higher than for universities from developing countries, even if it was smaller in relative terms. But notably, the impact of a fee reduction on income was considerably greater; a 50 per cent fee reduction for universities from developed countries would result in a loss in revenue of more than seven million Swiss francs, close to 2.5 per cent of PCT income. The document showed similar simulations for hypothetical fee discounts of 10 and 20 per cent. Overall, universities were more price sensitive than the average applicant to filing PCT applications, and this was more pronounced for universities in developing countries. However, the additional filing volume generated by a fee reduction would be relatively small compared to the overall filing volume, and if the fee discount were to be applied to universities from developed countries, there would be a significant loss of revenue to WIPO from PCT fees.

36. The Delegation of Japan, speaking on behalf of Group B, underlined that financial sustainability and income neutrality should be a prerequisite for introducing any fee changes. From this perspective, the conclusion of the supplementary study that the number of additional filings generated by fee reductions would remain relatively small and that fee reductions from universities would have a noticeable effect on income did not indicate that such fee reductions should be applied. The Delegation indicated openness to discuss proposals that could make the PCT system more accessible for potential users in universities and government research institutes with the prerequisite of achieving financial sustainability. While the study showed that fee reductions for universities from developing countries were more cost effective at generating additional filings than reductions for universities from developed countries, the Delegation expressed the view that the development aspect had recently been taken into account in a horizontal manner when Member States had agreed, in 2014, on the revised criteria for fee reductions for applicants from developing countries.

37. The Delegation of the United States of America stated that it was desirable to increase the number of international filings by universities and government research institutes, as these applicants were under-represented in PCT filings, and noted the conclusion of the study that universities exhibited higher fee elasticity than other applicants. The Delegation therefore supported a reduction in the international filing fee for all universities and government research institutes, provided this did not result in an increase in the international filing fee for other applicants. However, applicants from certain developing countries already qualified for a reduction in PCT fees, which the Delegation believed that this was a better approach for spurring additional filings from those countries than differentiating between universities based on their location. The Delegation therefore did not support a reduction in PCT fees for universities in some countries but not others.

38. The Delegation of China expressed the view that the study demonstrated that fee reductions for universities from developing countries were cost effective at generating additional filings. Based on the study, the Delegation hoped that the PCT Fee Schedule could be amended to provide for fee reductions for universities and public research organizations from developing countries to enhance accessibility to the PCT system for users in these countries.

39. The Delegation of the African Intellectual Property Organization (OAPI) supported the introduction of fee reductions for universities and public research organizations in both developing and developed countries. OAPI had performed a similar study by comparing patenting activity and research by universities, research centers and individuals. In universities and research centers, there was more convincing research activity but less involvement in patent filings than individuals, the latter benefitting from fee reductions. As a result, OAPI had recently decided to reduce its fees for universities and certain research centers.
40. The Delegation of Brazil proposed to introduce a fee reduction for universities and government research institutions from developing countries as a first stage and consider extending this to all applicants in these groups at a later stage. The Delegation also asked the Chief Economist about the effect of limiting reductions to developing countries. In particular, given that the fee elasticity for universities from developing countries was higher, the Delegation enquired whether reductions could increase filing volumes from these applicants to a level so as to have little or even a positive effect on PCT fee income revenue.
41. The Chief Economist, in reply to the question raised by the Delegation of Brazil, underlined that the study showed that any type of fee reduction would lead to decline in revenue from PCT fees. However, this was not always the case in situations where filing volume was extremely sensitive to price, meaning that a small fee reduction would unleash a significantly greater inflow of applications, resulting in an increase in revenue. Nevertheless, all academic studies on patent fee elasticity had produced estimates that were far away from any fee elasticity levels where reductions could have a positive effect on revenue from fees. Moreover, the smaller decline in fee income resulting from restricting reductions to universities and public research organizations in developing countries was primarily due to there being far fewer filings from these applicants compared to developed countries, rather than the greater fee elasticity for universities from developing countries.
42. The Delegation of Ecuador reported that it had witnessed a reduction in the number of filings from universities, government research institutions, small and medium-sized enterprises (SMEs) and independent researchers. In view of the aim to increase research and development from these organizations and individuals, the Delegation supported the proposal from the Delegation of Brazil, despite the drop in the revenue from PCT fees this would entail.
43. The Delegation of Mexico informed the Working Group that the Mexican Institute of Industrial Property provided discounts for universities and government research institutions in an effort to encourage innovative activity and development in the country, which could lead to positive effects on the economy. The Delegation was therefore in favor of applying a discount for PCT applications for universities and public research organizations in developing countries as an initial measure, pointing out that the percentage share from these applicants was less than individual applicants who, as nationals or residents in a developing country, were able to benefit from a fee discount.
44. The Delegation of Chile expressed support for the proposal from the Delegation of Brazil to introduce PCT fee reductions for universities and public research institutions from developing countries.
45. The Delegation of Iran (Islamic Republic of) supported the proposal from the Delegation of Brazil to introduce PCT fee reductions for universities and public research institutions from developing countries.
46. The Delegation of the Dominican Republic endorsed the proposal by the Delegation of Brazil to introduce PCT fee reductions for universities and public research institutions from developing countries.

47. The Delegation of the African Regional Intellectual Property Organization (ARIPO) supported the implementation of PCT fee reductions for universities and public research organizations from developing countries.

48. The Delegation of Spain supported the proposal from the Delegation of Brazil regarding reducing PCT fees for universities. In Spain, a fee reduction existed for universities and an exemption was in place for public universities. The percentage share of patent applications received from these applicants had increased from 5 to 15 per cent, which indicated that these fee reductions had a positive effect on improving the number of applications.

49. The Representative of the American Intellectual Property Law Association (AIPLA) supported the position of providing for fee reductions for all universities without differentiation between those based in developed and developing countries, adding that the classification of a developing country could change over time.

50. The Chair, in summarizing the discussions, stated that, while there was support by many delegations for PCT fee reductions for universities and government research institutes, different views had been expressed on whether such reductions should apply to all such types of applicants or only to those from developing countries. In any case, without a significant rise in the number of filings, any reductions would result in a loss in revenue to WIPO. The issue therefore needed to be considered in a holistic manner, also addressing the issue as to how to compensate for any losses. The Chair invited any Member State to come forward with proposals in this context for discussion at a future session of the Working Group.

51. The Working Group noted the contents of document PCT/WG/8/11.

PCT FEE INCOME: POSSIBLE MEASURES TO REDUCE EXPOSURE TO MOVEMENTS IN CURRENCY EXCHANGE RATES

52. Discussions were based on document PCT/WG/8/15.

53. The Secretariat recalled that the International Bureau had consulted PCT stakeholders by way of Circular C. PCT 1440, dated January 19, 2015 (reproduced in Annex I to the document), on possible measures to reduce the risk of exposure of PCT fee income to movements in currency exchange rates. Around the same time as this Circular was issued, there had been a sudden and very strong surge of the Swiss franc against many major currencies, which had a significant impact on the overall income to WIPO in the months following that sudden surge. This highlighted the need to take action to reduce the risk of exposure of PCT fee income to movements in currency exchange rates and provide greater predictability to the budgetary process, thereby adding to the financial stability, not only of the PCT, but of the entire Organization. The need to reduce this exposure was further illustrated in the graph under paragraph 18 of the document, which included updated figures from 2006 to 2014, showing the impact of currency fluctuations on the international filing fee and handling fee income. The impact of exchange rates on these two fees had resulted in a loss of income for eight of the past nine years, with a total loss over this period of more than 32 million Swiss francs.

54. The Secretariat continued by explaining the possible measures that had been proposed in Circular C. PCT 1440 to reduce the risks of exposure of fee income to currency exchange rates and the responses to the Circular on each proposal. One of these proposals, namely, to add a small percentage margin to the equivalent amounts of the international filing fee and search fee, received little support in reply to the Circular. The International Bureau was therefore no longer pursuing this possibility. A second proposal, namely, to enable applicants to pay the international filing fee in Swiss francs and the search fee in the currency fixed by the International Searching Authority instead of the currency prescribed by the receiving Office, also did not receive much support. Therefore, this proposal was also no longer being pursued. However, the Secretariat clarified that there had never been any intention to make it mandatory for receiving Offices to collect the international filing fee only in Swiss francs and the search fee only in the currency

fixed by the International Searching Authority. The idea had rather been to encourage receiving Offices to consider offering that option for applicants, if possible under national law and practice. And indeed, many receiving Offices already provided the possibility for applicants to pay the international filing fee in Swiss francs. The Circular also discussed a related idea to develop solutions to allow applicants, at the time of filing using the ePCT-filing system, to pay the international filing fee directly to the International Bureau and the search fee directly to the International Searching Authority, regardless of the receiving Office with which the application was filed. This idea had received overwhelming support in reply to the Circular. The International Bureau would therefore be further investigating appropriate mechanisms to allow the option of making these payments through ePCT to the International Bureau, acting on behalf of participating receiving Offices, with a view to making a more detailed proposal in a PCT Circular.

55. The Secretariat continued by introducing the two main proposals set out in Circular C. PCT 1440. First, the proposal to introduce a netting structure for financial transactions between receiving Offices, International Searching Authorities and the International Bureau, had received strong support in principle. The International Bureau would therefore be developing this proposal further, taking into account the replies received to the Circular, with a view to presenting a more detailed proposal for discussion by the Working Group at its next session. The second proposal was to commence hedging of international filing fee income as far as the risk resulting from transactions in the main currencies for PCT filing fee income, namely euro, Japanese yen and United States dollar, was concerned. This would involve entering into foreign exchange contracts with these currencies and using a blended hedge rate to calculate equivalent amounts rather than the spot rate as at present. The document addressed some of the issues raised in response to the Circular, notably, the currencies proposed to be hedged, the entering into foreign exchange forward contracts, calculation of the blended hedge rate, the accuracy of forecasts of currency flows, the costs and risks of hedging, and how the fixing of equivalent amounts for an entire year would work. The document also included a concrete proposal in Annex II to modify the Directives relating to the establishment of equivalent amounts in order to begin hedging in the three currencies. Finally, the document addressed questions raised in the responses to the Circular on the impact of hedging international filing fees on WIPO's investment policy. As for hedging of the risks resulting from International Searching Authorities requesting to be reimbursed by the International Bureau under Rule 16.1(e) for losses in search fee income, further work was required before making a concrete proposal. In particular, it was necessary to have more reliable forecasting of search fee currency flows, address complicating factors, such as irregular requests from International Searching Authorities for reimbursement and search fees being adjusted during the year, and also take into account any netting structure in a proposal to hedge search fees. The International Bureau would therefore be running a "proof of concept" simulation with regard to the possible hedging of risks resulting from International Searching Authorities requesting to be reimbursed by the International Bureau under Rule 16.1(e). The Secretariat concluded by pointing out that in order to begin hedging international filing fee income for 2016, the PCT Assembly, at its next session in October 2015, would need to adopt modifications to the Directives relating to establishment of equivalent amounts.

56. The Delegation of Japan welcomed the proposal for hedging the international filing fee as setting equivalent amounts for a fixed period would improve predictability for applicants, financial stability International Bureau and operational efficiency of International Authorities. However, it was necessary to balance the merits and disadvantages when introducing the proposed exchange hedging system, taking into consideration the cost of hedging described in paragraphs 33 and 34 of the document. In this regard, the Delegation asked the International Bureau to clarify three points. First, the Delegation requested more information on the date of entry into force of the hedging if adopted by the Assembly in 2015. Second, the Delegation sought assurance that the new way of setting equivalent amounts would not affect the business of receiving Offices and that ample time would be given from the establishment of the new equivalent amount of the international filing fee until implementation for the Japan Patent Office

to inform users. Third, the Delegation asked for the methods for calculating the blended hedge rate for setting equivalent amounts to be more clearly specified in the Directives of the Assembly. The Delegation also requested the International Bureau, as an example, to provide the equivalent amounts in Japanese yen based on the blended hedge rate in 2015. Regarding implementing the proposed netting structure, it was necessary to consider the accounting issues in Member States, especially sending the amount of balance limiting receivables. For example, according to the accounting act in Japan, certain procedures were needed to deal with offsetting income and expenditure.

57. The Secretariat, in response to the questions raised by the Delegation of Japan, clarified that, in view of the importance and urgency of bringing stability to PCT income, the intention would be for the new Directives on setting equivalent amounts to come into effect on January 1, 2016, if possible. Although blended hedge rates would be used for setting equivalent amounts instead of the spot rates, this would not affect the operational side of receiving Offices. Moreover, the same timescale would apply as under the present Directives for making annual changes to equivalent amounts to enter into force on January 1 each year. Equivalent amounts would therefore be fixed on the first Monday of October, which would leave about two months to inform applicants. The only exception to this schedule would be in the first year, where equivalent amounts would need to be fixed later in October, given that this could only take place after the Assembly, meeting from October 5 to 14, 2015, had adopted the new Directives. As for the method of setting blended hedge rates, the document had provided examples for United States dollar which showed the equivalent amount of the international filing fee to be 6 United States dollars more using the blended hedge rate compared to the spot rate, a difference of less than 1 per cent. The Secretariat had also prepared figures of equivalent amount of the international filing fee in euros and Japanese yen. For the latter currency, taking a spot rate on May 13, 2015, and hypothetical forward contracts for 10 million Swiss francs at the end of June, September and December in 2015, the international filing fee using the blended hedge rate worked out at 1,725 Japanese yen compared to 1,719 Japanese yen using the spot rate. The Secretariat indicated that it was willing to provide more detailed examples. In summary, the International Bureau would anticipate the currency flow in the three hedging currencies for each calendar month and would take out a forward contract for each currency in each month, giving a total of 36 forward contracts, with the blended hedge rate being the weighted average of the 12 forward contracts for a given currency. The Secretariat was also willing to include further details in the Directives to show how a blended hedge rate would be calculated, but indicated that the present Directives did not indicate the current basis of using the exchange rates on the web site www.xe.com for calculating the spot rate. An alternative to inserting the method of calculation of blended hedge rates into the Directives could be for the Assembly to adopt an Understanding in this regard at the same time as the Directives.

58. The Delegation of the European Patent Office supported the hedging solution, as it would be more efficient and more predictable for receiving Offices and applicants to have one equivalent amount of the international filing fee a year. The Delegation asked about being able to review any revisions to the draft Directives in Annex II before presentation to the Assembly, and also urged the International Bureau to provide the equivalent amounts for January 2016 as early as possible in October to allow receiving Offices to implement the new amounts into their IT systems. Regarding netting, the Delegation expressed full support for the proposal in the document. The European Patent Office had been part of a pilot program for the past one and half years where the search fee received at the United States Patent and Trademark Office acting as a receiving Office for an international application selecting the European Patent Office as the International Searching Authority was transferred to the International Bureau in United States dollars. The International Bureau would then send the amount of the search fee in euros to the European Patent Office. The Delegation looked forward to an extension of this type of netting solution to more Offices. Moreover, by applying this solution together with the eSearchCopy service to centralize the transfer of both the search fee and the search copy would bring further efficiency gains for International Searching Authorities.

59. The Secretariat, in response to the questions raised by the Delegation of the European Patent Office, informed the Working Group that, if any further modifications to the Directives were needed, the intention would be to present a revised version of the Directives during the session. With regard to the timing of new equivalent amounts entering into force, the dates of the Assembly in 2015 would mean that equivalent amounts could only be set later in October. This would nevertheless allow two months for Offices to implement the new equivalent amounts to enter into force on January 1, 2016. It could, however, be possible exceptionally to divert from the standard procedure in the first year and bring new equivalent amounts into effect on February 1 if needed, but the preference for the International Bureau was to maintain the full calendar year cycle.

60. The Delegation of the United States of America in principle supported the introduction of hedging and fixing the equivalent amount of the international filing fee for 12 months, which would increase efficiency of the system. Implementation of the proposed hedging needed to be transparent, and any additional costs resulting from the system should not be borne by the users of the system, but rather should be offset by increased operational efficiency at the International Bureau. However, in terms of a netting structure between receiving Offices, International Searching Authorities and the International Bureau, the Delegation expressed concern that this would result in additional work and thus impose excessive burdens on receiving Offices.

61. The Delegation of Israel supported the proposal to fix equivalent amounts of the international filing fee only once a year using a hedging solution. This should benefit most stakeholders who would experience less frequent changes to the equivalent amounts of the international filing fee. With regard to introducing a netting structure for the transfer of fees, while the Delegation supported the idea behind the proposal, it was necessary for Offices to have sufficient time to prepare their IT systems to receive and transmit fees in accordance with the netting mechanism to ensure the transfer of fees. The Delegation agreed with the Delegation of the European Patent Office that the PCT system would more efficient by combining the netting solution with the eSearchCopy service.

62. The Delegation of Spain stated that it was in favor of the proposed change to the calculations to set equivalent amounts once a year for a period of twelve months for currency operations. The netting system would also guarantee steady currency flows that would not vary with currency exchange rate fluctuations as International Searching Authorities would receive the full amount of the search fee. The Delegation was also supportive of the idea of adding a small percentage to the fixing of equivalent amounts of the international filing fee and search fee, and to encourage payment of the international filing fee in Swiss francs and the search fee in the currency of the International Searching Authority.

63. The Delegation of China understood the aims behind the proposed hedging mechanism but hoped that the measures would be assessed and based on the long term trends of currency exchange rates rather than short term fluctuations. It was also important to take into consideration the effect of these measures on the income of the Offices and the impact on users of the system. Moreover, the Delegation hoped more professional and detailed information could be made to Offices, such as the cost and risk of the proposed measures, the kind of hedging strategies and how to set equivalent amounts. Regarding the proposal of setting equivalent amounts, the Delegation was pleased that this proposal was no longer being pursued. It was also not possible at this stage for applicants filing an international application at the State Intellectual Property Office of the People's Republic of China to pay the international filing fee in Swiss francs.

64. The Secretariat, in response to the request by the Delegation of China for more detailed information on the risks of hedging, pointed out that the financial instrument being proposed was a forward contract and was one of the most straightforward financial instrument to hedge foreign currency risk. A forward contract for each flow of the three currencies proposed to be

hedged would be taken out based on forecast monthly inflow. As the amounts would vary each month, the blended hedge rate would be a weighted average calculated using a spreadsheet, which the International Bureau could make available.

65. The Delegation of Colombia supported the establishment of equivalent amounts of the international filing fee for a fixed period of time, which would reduce volatility and make it easier to collect fees. However, it was important to consider the available financial instruments for forward contracts. In terms of a possible netting structure, the Delegation believed that the setting up of a general platform should improve the efficiency of fee transfers and the management of this work at the receiving Office. As for setting an additional percentage on equivalent amounts of the international filing fee and search fee, the Delegation believed that this would only add greater costs to the user rather than improving efficiency in Offices. Finally, the Delegation understood the collection of the international filing fee in Swiss francs and the search fee in the currency fixed by the International Searching Authority would not be an obligation for receiving Offices, but the Swiss franc was not a widely used currency in Latin America. To make transfers more efficient, the International Searching Authority could use an electronic system to collect the search fee, which could lead to efficiency savings being passed onto the user.

66. The Delegation of Canada supported the principle of fixing equivalent amounts for a period of 12 months in conjunction with a hedging strategy, and expressed interest in receiving information on recent revenue in the PCT system by currency. The Delegation asked the Secretariat how the hedging proposal accorded with the risk appetite statement set out in document WO/PBC/22/17 presented to the Program and Budget Committee at its twenty-second session from September 1 to 5, 2014.

67. The Secretariat, in response to the request by the Delegation of Canada, offered to provide more detailed information on PCT fee income in the various currencies in which fees were received by the International Bureau.

68. The Delegation of France agreed with the setting of equivalent amounts for a period of 12 months accompanied by currency exchange hedging, which would improve predictability for the applicant. The Delegation was also in favor of a netting structure and suggested that this could be extended to other fee collecting WIPO services, such as the Madrid or Hague Systems, if shown to be successful in the PCT system.

69. The Delegation of the United Kingdom supported the change to calculating equivalent amounts for 12 months and hedging the currency inflows of the international filing fee. However, the Delegation asked whether there were any restrictions on the "rolling forward" of forward contracts, as described in paragraph 34 of the document, and about how the International Bureau would report on exercising this option. Moreover, in the interest of transparency, the Delegation requested the International Bureau to report on the impact of hedging on WIPO finances.

70. The Secretariat, in response to the query from the Delegation of the United Kingdom about "rolling forward" any forward contract, confirmed that there was no limit on taking this action. In essence, such "rolling forward" would require the conclusion of a new forward contract, which could be done, at least in theory, again and again. The Secretariat further confirmed that, if implemented, it would be happy to regularly report to Member States on any rolling forward of forward contracts and any impact hedging had on WIPO finances.

71. The Delegation of the Russian Federation supported hedging fees and introducing a netting structure. Given that issues of fee income were not confined to the PCT system and also concerned the Madrid and Hague Systems, the Delegation requested the implementation mechanism of these measures to be discussed by the WIPO Program and Budget Committee.

72. The Secretariat, in response to the suggestions made by the Delegation of the Russian Federation, indicated that it would forward the document to the Program and Budget Committee, which could provide a different perspective on the issue. The final decision on the hedging proposals would, however, rest with the PCT Assembly. In terms of expanding the hedging and netting arrangements to other IP systems administered by WIPO, such as the Madrid and Hague Systems, this had been considered by FTI Treasury in its review. However, there was a much lower risk of exposure of fee income to movements in exchange rates in these systems as most fees were paid in Swiss francs.

73. The Delegation of Mexico stated that it was in favor of the proposal on hedging and establishing equivalent amounts of the international filing fee for a fixed 12 month period. However, the Delegation shared the concerns that had been indicated by the Delegation of Canada about risk appetite for the Organization.

74. The Representative of the American Intellectual Property Law Association (AIPLA) observed that the document illustrated the urgency to take action to reduce exposure to currency exchange rate fluctuations. The fixing of equivalent amounts of the filing fee for one year would be a benefit to the applicants, particularly for attorneys with a large volume of applications. There also needed to be full transparency to be clear how forward contracts had been purchased by the International Bureau. With respect to the comments on the differences between the spot rates and the blended hedge rates, rather than thinking about this as users having to bear the fee of buying currency contracts, it could be seen as a loss reduction mechanism for the PCT system as a whole, noting that users ultimately experience both the benefits and shortfalls associated with these currency differentials. In this regard, the Representative encouraged more simulations to be performed with respect to currency movements. In the interests of transparency, the Representative also asked for more detailed documentation on how the blended hedge rate would be set.

75. The Secretariat, in response to the comments raised about transparency of the process for fixing the blended hedge rate, referred to the possibilities indicated in its response to the questions raised by the Delegation of Japan (see paragraph 57, above) and indicated that it would be willing to look into this matter, whether by adding more details to the Directives or including an additional details on the process of fixing the blended hedge rate on a yearly basis.

76. The Secretariat, in response to the queries raised by the Delegations of Canada and Mexico about the risk appetite statement, stressed that the greatest risk found by FTI Treasury in its review was the absence of any measures at present to reduce exposure to currency exchange fluctuations. The International Bureau had very limited netting in place, for example, using inflows in United States dollars to make payments to the U.N pension fund, but otherwise the currency was converted into Swiss francs without any hedging to reduce the effect of future exchange rate changes.

77. The Chair summarized the interventions made by delegations. There had been strong support for hedging the international filing fee to reduce the risk of WIPO to losses in income revenue and for fixing the international filing fee for a 12 month period to provide more certainty for receiving Offices, agents and applicants. Given the timing of PCT Assembly, there could be difficulty setting the equivalent amounts to come into effect on January 1, 2016, and it remained to be decided whether a later implementation would be needed for the first year. There had also been strong support for a netting structure and exploring this across Offices within the PCT system, but there appeared to be no purpose of pursuing this option within the Madrid or Hague Systems, as the bulk of fees were received in Swiss francs. However, there were many practical details that needed to be worked out, and transparency would be the key for Member States in understanding, appreciating and accepting a hedging approach in respect of PCT fees.

78. The Working Group agreed on the proposed modifications to the Directives of the PCT Assembly Relating to the Establishment of Equivalent Amounts of Certain PCT Fees set out in Annex II to document PCT/WG/8/15 with a view to their submission to the Assembly for consideration at its next session, in October 2015, subject to possible further drafting changes to be made by the Secretariat or, alternatively, the submission to the Assembly of a draft Understanding setting out details of the new process for fixing equivalent amounts in the currencies proposed to be hedged based on blended hedge rates, to be adopted by the Assembly together with the Directives as proposed to be modified.

COORDINATION OF TECHNICAL ASSISTANCE UNDER THE PCT

79. Discussions were based on document PCT/WG/8/16.

80. The Secretariat reminded the Working Group that the fifth session of the Working Group had agreed that reports on technical assistance should be included as regular item for future sessions of the Working Group. The Secretariat had submitted reports on this subject to the Working Group at its sixth and seventh sessions, which had been well-received. As with previous reports, the document had been split into two parts. The first part covered those activities which had a direct bearing on the use of the PCT by developing countries, and which were directly delivered to those countries under the PCT. The second part covered technical assistance activities extending beyond activities with a direct bearing on the use of PCT by developing countries, and which, since 1978, had been carried out under the supervision of other WIPO bodies. Information on the technical assistance activities which had a direct bearing on the use of the PCT by developing countries was set out in the Annexes to the document. These activities focused on assisting developing countries to make best use of the PCT system, taking into account specific country needs, notably the level of development of its national patent system, and the level of its participation in any regional and in the international patent system. Annex I contained a comprehensive list of all such technical assistance activities carried out in 2014; Annex II contained a list of all such activities which had either been carried out so far in 2015 or which were planned to be carried out in the remainder of 2015. With regard to technical assistance activities which extended to the use of the PCT by developing countries and carried out under the supervision of other WIPO bodies, in particular, the Committee for Development and Intellectual Property (CDIP), paragraphs 5 to 7 of the document set out some examples of such activities and projects. More general information on technical assistance activities undertaken by WIPO for the benefit of developing countries could be found in particular on the WIPO Intellectual Property Technical Assistance Database (IP-TAD), referred to in the document.

81. The Secretariat continued by recalling that the Working Group had the pending issue of reviewing the functioning of the PCT in terms of organizing technical assistance for developing countries. The Working Group, at its fifth session, had decided to await the outcome of the discussions of the External Review of WIPO Technical Assistance in the Area of Cooperation for Development ("the External Review"; document CDIP/8/INF/1) and related documents in the Committee for Development and Intellectual Property (CDIP) before considering how to proceed with regard to the technical assistance related parts of the PCT Roadmap recommendations. In this regard, the document provided an update to the ongoing discussions in the CDIP in paragraph 9. At the next session of the CDIP, discussions would continue, based on an update of the Management Response contained in document CDIP/9/14 produced a few years ago, a proposal made by the Delegation of Spain, and any other proposals made by Member States. The Secretariat therefore proposed to await discussion of this issue in the CDIP before picking up the issue in the context of the PCT Working Group.

82. The Delegation of Japan, speaking on behalf of Group B, expressed gratitude for the details of technical assistance activities provided in the document, which showed that PCT-related technical assistance programs formed an essential element of broader WIPO technical assistance activities aimed at extending and enhancing the PCT system. In this

regard, the Delegation looked forward to discussions on the training of examiners, where information sharing and coordination had been substantiated, based on experiences by PCT experts. The Delegation also remained open to discuss specific items on PCT-related technical assistance emerging from the work of PCT practitioners. However, the issue of provision of technical assistance had to be seen in the broader context, taking account of common core interlinked aspects. In this context, the Delegation referred to the ongoing discussions in that regard in the Committee on Development and Intellectual Property (CDIP), which had devoted more time to debating technical assistance activities at its most recent session. To that extent, it continued to be of the opinion that the Working Group had to await the outcome of discussions in the CDIP on the External Review of WIPO Technical Assistance in the Area of Cooperation for Development (document CDIP/8/INF/1) before commencing discussion on specific PCT-related technical assistance in the Working Group.

83. The Delegation of Mexico acknowledged and expressed gratitude for the technical assistance activities being carried out by the International Bureau together with the Mexican Institute of Industrial Property. This assistance had brought direct benefit to users of the PCT system in Mexico and had facilitated collaboration with other IP Offices in Latin America, where the Mexican Institute of Industrial Property had been able to share its experiences in the use of the PCT system.

84. The Delegation of China expressed appreciation for the work carried out by the International Bureau in the field of technical assistance and hoped for more work to be carried out in facilitating access to technology, where China would be willing to make a positive contribution.

85. The Delegation of Ecuador stated that it was pleased with the technical assistance activities that it had benefited from, such as human resources and help to examiners. The cooperation with Offices was important to improve the online services provided to users of the PCT system and for the assistance, coordination and communication among receiving Offices and International Searching Authorities.

86. The Delegation of the United States of America aligned itself with the statement made by the Delegation of Japan on behalf of Group B and commented that the list of technical assistance activities related to the PCT provided by WIPO in 2014 and planned for 2015 provided useful data for Member States. The list showed many examples of technical assistance activities for developing countries that had a direct bearing on the use of the PCT in developing countries, as well as PCT related technical assistance activities that were carried out under the supervision of other WIPO bodies. Examples in the latter category included the "Specialized Databases' Access and Support", "Developing Tools to Patent Information" and "Business Solutions for IP Offices" projects, which were designed to address technical assistance needs in member States, including those related to the PCT. The Delegation noted that a large number of activities listed in the Annexes to the document related to providing detailed PCT-related information and PCT-related training of Office officials, which showed the needs of Member States relative to the PCT were being addressed by the existing WIPO bodies.

87. The Delegation of Chile commended the International Bureau for cooperation and assistance in PCT-related activities, including international search, and referred to recent assistance in the areas of quality improvement and management procedures, which it believed were of extreme importance for improving PCT procedures in Latin America.

88. The Working Group noted the contents of document PCT/WG/8/16.

TRAINING OF EXAMINERS

89. Discussions were based on document PCT/WG/8/7.

90. The Secretariat introduced the document, which set out proposals for better coordination of examiner training between national Offices, taking into account questions of effective long-term planning, sharing of experiences in delivering effective training and matching needs for examiner training with Offices able to supply the relevant needs. One of the PCT Roadmap recommendations endorsed by the Working Group in 2010 related to the issue of examiner training, where collective action by the International Bureau and Member States was seen to be required and appropriate. At last year's Working Group, the International Bureau had reported on discussions at the Meeting of International Authorities on how technical assistance activities around examiner training might be improved, including a discussion of experiences, best practices and lessons learned, the extent to which Member States could support such technical assistance both individually and collectively, either directly through Offices capable of providing examiner training, or indirectly by contributing funds to support longer term, well-designed, planned and coordinated training, education and capacity-building programs. International Authorities had also discussed the role that the International Bureau should play to facilitate international cooperation in the area of examiner training and the sharing of tools and training materials. The discussions at last year's Working Group had concluded with a recommendation that the International Bureau should prepare proposals for better coordination of examiner training between national Offices. In line with that recommendation, the document presented issues to be tackled and recommendations as to how to proceed in that regard.

91. The Secretariat continued by outlining the issues with regard to examiner training set out in the document. First, it was important to bear in mind that the International Bureau did not have the capacity, in terms of human and financial resources, to provide examiner training itself. The document therefore recommended that the International Bureau should act as a facilitator and coordinator, rather than as a service provider, focusing on mobilizing and coordinating donor Offices' training resources. The International Bureau would nevertheless continue to provide Offices with training on procedural issues associated with search and examination, including on the use of such systems, to assist and provide such training, also including teaching how to use existing work sharing systems. Second, it had been recognized that, in terms of substance of examiner training, there was no "one-size-fits-all" approach. Training needed to be provided in a flexible modular format to meet the divergent needs of recipient Offices. Moreover, it was particularly apparent from the presentation given by IP Australia on the Regional Patent Examiner Training (RPET) Program at last year's session of the Working Group that what was needed was longer term, well-designed, planned and coordinated training, education and capacity-building programs. The document therefore recommended providing training in flexible, modular formats to meet divergent needs, and more concretely, to develop, jointly with partner Offices, a program concept for the provision of longer term training to be provided by donor Offices, similar to the IP Australia RPET Program. Third, there was a need to improve coordination of training provided by the various donor Offices. For example, the WIPO Singapore Office had compiled information from all Sectors within WIPO on training assistance provided to Association of Southeast Asian Nations (ASEAN) Member States. This was a relatively straightforward measure, but a big step in coordination of such assistance. A recommendation in the document was therefore to develop jointly with partner Offices a plan to improve the coordination of training offered by national Offices, for example, by setting up a web platform for sharing information, experiences, best practices, tools and materials, for the International Bureau to organize a donor conference for those Offices who were willing and capable of donating either staff and/or financial resources, and finally, to develop model training components as a guide for Offices in developing countries to defining their needs and developing their own training programs. Finally, the document recommended to explore ways to strengthen existing cooperation with partner institutions, such as under existing Funds-in-Trust programs, or within the framework of the WIPO International Cooperation on the Examination of Patents (ICE) service under which donor Offices carried out searches for national patent applications. In particular, the International Bureau encouraged all Offices which had additional capacities to contribute with more searches to be donated to that program, for the benefit of developing countries. If general agreement prevailed on all the recommendations

in the document, the first step suggested in the document would be that the International Bureau would sit down with potential partner Offices to have a brainstorming session as to concrete steps forward.

92. The Secretariat concluded by referring to discussions by the Meeting of International Authorities in 2015, where Authorities expressed support in general for the ideas set out in the document. A suggestion was made that all Authorities needed a better understanding of examiner training programs being offered by encouraging International Authorities to exchange information in this area. One suggestion was that the list of issues to be addressed under the initiatives needed to be narrowed down, so to focus on less rather than more, and that priorities and policies had to be defined first before thinking of moving to a first concrete step. Concerns were also expressed by one Office as regards to development of content of model training components and curricula by the International Bureau, which it was felt should be left to the donor Offices, whereas the International Bureau should primarily act as a coordinator, even if it was recognized that it is important to guarantee uniformity and consistency of training modules if those were indeed established, maintained and drafted by various national Offices. Finally, the Secretariat informed the Working Group that the PCT had secured an additional staff resource whose job description would be to focus on issues with regard to examiner training with responsibility for running the WIPO International Cooperation on the Examination of Patents (ICE) service. The Secretariat therefore hoped concrete progress could be made on examiner training for the benefit of developing countries.

93. The Delegation of the United States of America stated that, over the years, the United States Patent and Trademark Office (USPTO) had provided examiner training programs on search and examination procedures under the PCT, both at its headquarters and in other countries. More recently, the USPTO had provided training for PCT examiners in India and Chile, along with a week-long training at the USPTO. The Delegation acknowledged the growing need for training and supported technical assistance to developing and least developed countries in the interest of improving the quality of PCT work products. It would therefore be beneficial for all to improve coordination and planning, as well as the substantive content of such training programs, to make them as efficient and effective as possible. The Delegation agreed that the International Bureau was in the best position to play matchmaker by collecting requests for training and matching recipient and donor offices, and so was pleased to hear that additional resources would be available for this work. The Delegation also supported the idea to create a database of training needs so that the donor and recipient offices would be able to plan and coordinate their training activities in advance, thereby allowing for better coordination of regional activities as well as refresher or follow-up training. That database needed to contain both requests for future training and completed training activities to ensure better planning and more efficient use of human and financial resources. However, the Delegation voiced some concerns, which had been referred to by the Secretariat. In the view of the Delegation, the substantive content of the training sessions needed to be left to the donor Office working directly with the requesting Office in order to ensure that the appropriate meets and bounds of the needed training were established. With regard to holding a donor conference, the Delegation did not see the need at this stage to expend resources on such an event, unless it took place in conjunction with another WIPO meeting. The Delegation reiterated the view that the International Bureau should function primarily as a coordinator of training activities by keeping track of what training had been done by donor Offices and for which recipient Offices. International Authorities could then contact the International Bureau when they were approached by another Office which had requested training to see what type of training had already been or was scheduled to be performed for that Office, thereby helping to ensure that efforts were not being duplicated, something that the USPTO had experienced firsthand in the past. The International Bureau could also keep records on the type of training that different Authorities were prepared to give, so that when a request for training was received, there would be knowledge of which International Authority to approach to arrange the training, with any existing *ad hoc* system in this area being formalized.

94. The Delegation of the European Patent Office stated that, like the United States Patent and Trademark Office, the European Patent Office (EPO) had been providing and supporting different types of training to Offices over the years, both on EPO premises and outside. The EPO was interested in contributing further to examiner training and welcomed the International Bureau's proposal to act as facilitator, which would add to transparency and avoid duplication. The Delegation supported the creation of web platform and agreed that a brainstorming session was a good way forward to help best match training resources with needs.

95. The Delegation of Japan welcomed the discussion, which it expected would contribute to enhancing further the capacities of examiners in developing countries. Since 1987, the Government of Japan had offered training programs on patent examination through WIPO Funds-in-Trust and its own national funds in order to enhance the in-house capacity of examiners at IP Offices in developing countries. The Japan Patent Office (JPO) had welcomed trainees, mainly from the Asia-Pacific region, but also from Africa and Latin America. In order to respond to various different skill sets, the JPO had provided both basic and advanced training courses, including those for specific technical fields, and a three months operational patent examination training program, where trainees could develop their abilities to conduct international search under the PCT. Moreover, the Delegation had been cooperation with WIPO to establish a long-term training course with trainees coming to the JPO several times over the period of about two years, which would provide the opportunity to follow up the effectiveness of the training. Through this new initiative, the JPO expected trainees to reach a high enough level to be able to train examiners in their own countries. The Delegation looked forward to hearing the outlines of current initiatives on examiner training from other donor Offices. Regarding the proposals from the International Bureau, the Delegation agreed that better coordination of examiner training between national Offices would lead to conducting better examiner training. However, it was necessary to have more information on the types of examiner training programs that IP Offices were providing before starting the discussion on what would be appropriate training to match the needs of developing countries. In this context the Delegation proposed that Offices begin sharing information on the types of training being provided by donor Offices and on the needs of developing countries, under the coordination of the International Bureau. The Delegation also reiterated the view that any donor conference should be held back-to-back with another PCT meeting.

96. The Delegation of Australia supported the aim to improve coordination of technical assistance activities and training of examiners in developing countries. IP Australia had been active in developing competency-based training through the Regional Patent Examiner Training program, which had been very successful and benefited trainees through its interactive learning focused design. The Delegation was willing to share further its experiences with the program and contribute to brainstorming activities and workshops to the extent possible, and to explore ways to streamline and strengthen cooperation with existing patent institutions.

97. The Delegation of Spain affirmed its commitment to sustainable development policies and reported on its cooperation with national Offices in South America through strategic policies to deliver technical assistance by sharing technological information and training examiners. As part of the technical assistance program, the Spanish Patent and Trademark Office had welcomed trainees from these Offices. The Delegation also informed the Working Group that it was further developing a program for economic and technological training extending across the Latin American region, having started a program in this respect in 2004.

98. The Delegation of Colombia endorsed the proposals made in the document and agreed with all previous interventions, particularly those from the Delegations of the United States of America, Japan and Spain. Communication was essential for sharing knowledge to pool efforts and streamline measures. New procedures for patent examination therefore needed to be widely communicated on a cooperative basis. As referred to by the Delegation of Spain Colombia had started cooperating with Latin-American and Iberian countries, and was also working with the Spanish development agency. A seminar for patent Office directors and

managers in Latin America had been held in Colombia, and a number of cooperation programs had been set up, bringing in those who could act as leaders for training programs. The Delegation therefore welcomed the coordination role that the International Bureau could play to circulate proposals and needs on training and assistance for national Offices.

99. The Delegation of Israel informed the Working Group that the Israel Patent Office, in both its national and international capacities, had been holding an annual training course on examination of patent applications to assist national Offices in developing countries to enhance their capacities in patent examination. All relevant course materials were made available electronically to participants, who were encouraged to remain in contact with examiners at the Israel Patent Office. The Delegation indicated willingness for the Israel Patent Office to participate in the development of a program for the provision of long-term training together with other patent Offices and the International Bureau acting as facilitator and coordinator. In order to organize training activities better with donor Offices able to offer onsite training for examiners of Offices in developing and least developed countries, and in order to share and coordinate training materials and tools, best practices and lessons learned, the Delegation fully supported the proposal to establish and coordinate a network of donor Offices with a web platform for sharing information. This web platform could be complemented by continued follow-up and feedback between the donor office and trainees and could be used for updating patent examiners on technical developments, emerging trends, and recent innovations.

100. The Delegation of China appreciated the work conducted by the International Bureau and Member States concerning technical assistance to developing countries, and underlined that the search and examination of IP Offices in developing countries would be greatly improved by training examiners, which was important to the future development of PCT system and the enhancement of patent quality. These efforts needed to be continued and coordinated. As a developing country, China understood the importance and urgency of training for developing countries and was making efforts in this regard; over the past three years, the State Intellectual Property Office of China had conducted 10 training programs to 233 examiners and officials from 42 nations or regional IP offices of developing countries. These programs covered content on various levels, including IP law, management, patent examination, and transmission and utilization of patent information. The Delegation was willing to take part in activities related to technical assistance organized by WIPO, and continued to provide the training courses to IP Offices of the developing countries and least developed countries within its capacity.

101. The Delegation of Nigeria supported the proposals of other delegations that had called for examiner training for developing countries and thanked WIPO and other collaborators such as the Japan Patent Office through its Funds-in-Trust scheme for the training that had been provided to the Trademarks, Patents and Designs Registry in Nigeria.

102. The Delegation of Canada supported the development of examination capabilities of national Offices and was prepared to assist with this through technical assistance activities to a maximum extent possible. The examiner training program at the Canadian Intellectual Property Office was designed in a modular fashion and the Delegation expressed willingness to make it available along with other resources through existing WIPO facilities or other means. With respect to a donor conference, the Delegation shared the preference that this should be held at the same time as another WIPO meeting.

103. The Delegation of Norway stated that it generally had a positive view to quality improvement proposals and noted that the proposal had derived from the PCT Roadmap, an important document for improving the PCT system. The Delegation believed that coordination and facilitation of examiner training by the International Bureau would contribute to further improvements of the PCT system. The Norwegian Intellectual Property Office had been providing examiner training in collaboration with the International Bureau. In view of

collaboration with WIPO on a long-term project in a different area, the Delegation believed that a long-term approach was important for examiner training and affirmed its positive view of the proposals in the document.

104. The Delegation of Cuba expressed support for the proposals on training of examiners outlined in the document. Long term well-designed projects would allow Offices in developing countries and least developed countries to improve their capacity for examination, which in turn would contribute to better quality procedures. These programs also needed to be followed up by participants, consolidating and reviewing the knowledge acquired. The Delegation also thanked the Spanish Patent and Trademark Office and the International Bureau for the courses given in Cuba, which had been of great benefit.

105. The Delegation of the African Intellectual Property Organization (ARIPO) fully supported the proposals in the document and informed the Working Group that ARIPO had benefited greatly from the Regional Patent Examiner Training program offered by IP Australia, with one examiner having completed the program and two currently undertaking the training. The Delegation expressed profound gratitude to IP Australia and also the Japan Patent Office, which had also providing training to examiners at ARIPO.

106. The Delegation of the African Intellectual Property Organisation (OAPI) shared the view expressed in support of training examiners in developing countries, adding that coordination and sharing of training programs could better improve efficiency. The Delegation also expressed appreciation for a recent training program that had been provided to OAPI by the European Patent Office.

107. The Chair, summarizing the interventions from delegations, recognized the strong support for the International Bureau to increase its role in coordinating examiner training between Offices. It was also clear that any brainstorming session or donor conference should not be standalone event for reasons of cost and time, and instead take place back-to-back with another PCT meeting or international IP meeting. The Chair emphasized that training was not a one-way process; all partners learnt from the experience and benefited from programs. To take the work forward on examiner training, the Chair proposed that the International Bureau collect information on training activities provided by Offices for the benefit of other Offices through a Circular and consider possibilities for any brainstorming session.

108. The Working Group requested the International Bureau to issue, as a first step, a Circular requesting information from Offices on examiner training activities carried out by Offices for the benefit of other Offices, notably from developing countries. This would better inform the next phase of discussions on how the International Bureau could act as a coordinating body to most useful effect.

APPOINTMENT OF INTERNATIONAL AUTHORITIES

109. Discussions were based on document PCT/WG/8/3.

110. The Secretariat reminded the Working Group of the ongoing discussions on possible revisions of the procedures and substantive criteria for appointment of International Authorities. These discussions had resulted in the adoption by the PCT Assembly in 2014 of an Understanding concerning new procedures for appointment of International Authorities, as set out in paragraph 2 of the document. At last year's Meeting of International Authorities and Working Group, Member States had agreed that it was premature at that stage to recommend changes to the substantive criteria for appointment. Instead, it had been agreed to await discussions in the Quality Subgroup of the Meeting of International Authorities on what appropriate quality requirements an Office needed to meet to act effectively as an International Searching and Preliminary Examining Authority, and how these quality requirements could be better expressed in possible new appointment criteria. These discussions had continued at the fifth informal meeting of the Quality Subgroup in 2015, based on a document prepared by the

International Bureau setting out specific areas for consideration and further study, as reproduced in paragraph 6 of document PCT/WG/8/3. During these discussions, International Authorities had again noted the political and sensitive nature of the issues at stake. As a result, Authorities had agreed that, at this stage, it would not appear appropriate to consider amendments to the existing requirements for appointment as set out in the Regulations. Authorities had further agreed that it would neither be appropriate nor realistic to suggest any areas for consideration which would require direct evaluation of the search and examination quality of an Office. Rather, Authorities had agreed that at this stage, the focus of further work should be on procedural issues related to quality, such as the extent to which an Office seeking appointment already had in place a quality management system and internal review arrangements, in accordance with Chapter 21 of the PCT International Search and Preliminary Examination Guidelines, or where such system was not yet in place at the time of appointment, the extent to which an Office had an equivalent system operational in respect of its national search and examination work. One area of possible further work identified by the Quality Subgroup and subsequently confirmed by the Meeting of International Authorities was to review the present Chapter 21 of the International Search and Preliminary Examination Guidelines with a view to strengthening the requirements with respect to quality management systems, notably by making requirements mandatory which at the moment were only recommendations, or by adding certain requirements which might be missing from the current text of the Guidelines. With that in mind, the Meeting of International Authorities recommended two specific proposals for further work. The first such recommendation would be to modify the Understanding of the procedures for appointment as adopted by the PCT Assembly in 2014 to make it a requirement to have systems similar to those under Chapter 21 operational at the time of appointment, rather than simply a preference. The second recommendation was to consider developing a standard application form for any requests for appointment with a view to ensuring that all pertinent quality issues were indeed covered in any request for appointment made by an Office in the future. The Working Group was therefore invited to note the update on the work in the Quality Subgroup and Meeting of International Authorities, in particular, the two recommendations by the Quality Subgroup.

111. The Delegation of Japan underlined the importance of International Searching and Preliminary Examining Authorities providing high quality international search reports and international preliminary examination reports in order for the PCT system to function effectively for the benefit of users. In this context, the Delegation supported the direction of the work in the Quality Subgroup and especially looked forward to meaningful discussions on the review of Chapter 21 of the International Search and Preliminary Examination Guidelines with a view to strengthening the quality management systems for producing higher quality international work products. The Delegation also looked forward to the International Bureau developing a standard application form for requests for appointment as an International Authority, which could lead to more efficient procedures for appointing International Authorities.

112. The Delegation of the European Patent Office stated that it supported the recommendations endorsed by the Meeting of International Authorities on further work and looked forward to discussions at the next Quality Subgroup Meeting.

113. The Delegation of the United States of America agreed that discussions on the appointment of International Authorities should continue in the Quality Subgroup. However, referring to past discussions which had focused on the qualifications of prospective Authorities, the Delegation questioned whether the Working Group should also be investigating the need for a new prospective Authority, especially in view of the costs of establishing the Authority. The Delegation therefore requested the International Bureau to provide detailed information on the costs incurred, for example, in training examiners and establishing IT system in the prospective Authority.

114. The Delegation of China was pleased with the progress in discussions on the appointment of new International Authorities with the adoption of the Understanding on the procedures by the PCT Assembly in 2014 and the ongoing work in the Quality Subgroup on quality requirements, adding that providing higher quality work would make the PCT system more attractive. In the meantime, the Delegation looked forward to more national and regional Offices being appointed as International Searching and Preliminary Examining Authorities to provide services to users in more languages and from different regions.

115. The Delegation of Colombia agreed with the comments made by the Delegation of China and added that new Authorities needed to be made available, which would lead to more efficient services in delivering international search reports and international preliminary examination reports.

116. The Delegation of Israel underlined the need for further measures which might contribute towards determining the quality of work produced by an Office and supported the development of indicators for efficient assessment on whether or not an Office seeking appointment had met the quality requirements. Such measures needed to guarantee as far as possible the high quality of work products of International Authorities so that designated Offices would be able to use these work products in the national phase. The Delegation highlighted appropriate indicators for efficient assessment. These included the demonstration of an effective national quality management system complying with Chapter 21 of the International Search and Preliminary Examination Guidelines, a training program for national work products and an existing IT system. Applications for appointment also needed to include more details of the professional and language skills and experience of examiners in the Office.

117. The Chair summarized the discussions by underlining the strong support for the recommendations by the Quality Subgroup to focus further work on procedural issues related to the quality requirements that an Office should be required to meet to act effectively as an International Authority. Notably, delegations supported the specific recommendations to review Chapter 21 of the International Search and Examination Guidelines with a view to strengthening the requirements with respect to quality management systems and to develop a standard application form for any request for appointment, as set out in paragraph 7 of document PCT/WG/8/3. In terms of the issue raised by the Delegation of the United States of America on the need for further International Authorities in view of the costs of establishment, the Chair pointed out the different workloads of International Searching and Preliminary Examining Authorities. Although the International Bureau could provide some information on the set-up costs, recently-appointed International Authorities might be better placed to provide that information.

118. The Secretariat indicated that it would be willing to list the direct costs to the International Bureau in the lead up to an Office seeking appointment as an International Authority. However, these costs were limited to advisory missions, as the International Bureau did not have the capacity or skills to train examination staff in prospective Offices. Most of the costs were therefore shouldered by the Office seeking appointment as an International Authority and by other Offices advising on the appointment. In particular, the International Bureau would not be able to provide any information on costs with regard to the quality requirements and training for staff in the prospective Office.

119. The Working Group noted the update on the ongoing discussions in the Quality Subgroup of the Meeting of International Authorities, and in the PCT/MIA itself, on the quality related aspects of the criteria for appointment of International Authorities, in particular the recommendations by the Quality Subgroup set out in paragraph 7 of document PCT/WG/8/3.

120. The Working Group invited the International Bureau to provide information concerning the expenses typically incurred by the International Bureau in relation to the appointment of a new International Searching and Preliminary Examining Authority.

PCT DIRECT – A NEW SERVICE FOR STRENGTHENING THE USE OF THE PCT

121. Discussions were based on document PCT/WG/8/17.

122. The Delegation of the European Patent Office (EPO) informed the Working Group that the EPO had been offering a service “PCT Direct” since November 1, 2014. This service allowed applicants to submit, when filing the international application, a letter containing informal comments aimed at addressing objections raised in the search opinion established by the EPO on a priority application. Applicants could also provide their informal comments as track changes to the claims and/or description, thereby facilitating the work of the examiner, who would be likely to have performed the search on the priority application. Overall, the service increased the chances of the search examiner producing a positive written opinion for the applicant, and there were potential time gains in the production of the search report, thus benefitting both the applicant and International Searching Authority. Since 2014, the EPO had received more than 1,000 PCT Direct requests, averaging 200 per month. From July 1, 2015, the service would be extended to international applications filed at other receiving Offices where the priority application had been searched by the EPO. Applicants would therefore be able to benefit from the service for any international application where the priority application was searched by the EPO, irrespective of the receiving Office, and could file a PCT Direct request using online filing tools such as ePCT or the European Patent Office online filing software (eOLF) and new online filing (CMS) application. The Receiving Office Guidelines were in the process of being revised to accommodate the new procedure within PCT Direct.

123. The Delegation of the Republic of Korea inquired about the expected number of PCT Direct requests on expansion of the service from July 1, 2015, whether the EPO was required to respond to the PCT Direct letter from the applicant, and if the letter needed to be written in a particular language.

124. The Delegation of the European Patent Office (EPO), in response to the questions raised by the Delegation of the Republic of Korea, stated that the EPO expected an increase of about 100 PCT Direct requests a month, rising to about 300, but this was difficult to predict. The PCT Direct letter was intended to facilitate the work of the search examiner; a proper dialogue between the examiner and the applicant would only take place if the applicant had filed a demand under Chapter II. The EPO therefore did not reply to a PCT Direct letter. There were also no restrictions on the language of the letter. However, as the EPO must have performed the search on the priority application, the EPO had not faced issues concerning the language of PCT Direct letters.

125. The Delegation of Israel stated that the Israel Patent Office had been offering a similar service since April 1, 2015, but had only received two such letters to date. As the examiner benefited from the search performed on the earlier application, a refund of 50 per cent of the search fee was offered. The Delegation further emphasized the usefulness of the new service for applicants seeking to obtain a positive international search report and written opinion in view of their intention to later request Patent Prosecution Highway (PPH) acceleration in the national phase. In order to support the new service, the Delegation requested the International Bureau to update the electronic filing tools PCT-SAFE and ePCT along with the minimum specification for electronic PCT document exchange.

126. The Secretariat, in response to the request from the Delegation of Israel on electronic filing tools, confirmed that both PCT-SAFE and ePCT would support the submission of PCT Direct letters as of July 1, 2015. Similar support could be offered for other International Searching Authorities which notified requirements to the International Bureau for equivalent services.

127. The Delegation of Japan supported amending the Receiving Office Guidelines to include PCT Direct and asked for further details on the timescale for making these modifications.

128. The Secretariat, in response to the question from the Delegation of Japan, informed the Working Group that a Circular would be sent in the next few weeks to consult with Member States and users on proposed modifications to the Receiving Office Guidelines to clarify the procedures to be followed by receiving Offices when receiving such PCT Direct letters. The International Bureau intended to promulgate the Guidelines as soon as possible, but this would probably come after July 1, 2015.

129. The Delegation of Canada acknowledged the benefit of PCT Direct to examiners, but asked for further details on the benefits for the applicant, how the European Patent Office or other Office matched the work done internationally with the national or regional application, and whether PCT Direct could be used when the earlier application was also filed under the PCT.

130. The Delegation of Colombia asked the Delegation of the European Patent Office for further details of PCT Direct, namely, whether the applicant could request PCT Direct service after filing the international application, whether there was a fee for PCT Direct, whether the applicant had to file the priority document or other material, and whether the PCT Direct letter was made available in the PCT online registry. The Delegation also asked whether the International Bureau published the PCT Direct letter on PATENTSCOPE.

131. The Delegation of the European Patent Office, in response to the questions raised by the Delegations of Canada and Colombia, clarified that there was no fee for the service. The main condition was that the priority application had to have been searched by the EPO and this could be an earlier international application. The main benefit to the applicant was that PCT Direct offered the applicant the possibility to explain the reasons behind amending an application, which could be taken into account by the examiner in establishing the international search report and written opinion. The PCT Direct letter had to be filed together with the international application and be indicated as an accompanying item in the request form (PCT/RO/101) in the "Other" field. Furthermore, any PCT Direct letter would become accessible to third parties via PATENTSCOPE and, after regional phase entry, via the EPO's Register.

132. The Delegation of China welcomed the PCT Direct service and hoped that the European Patent Office would review the service after a period of implementation and share its experiences from the review with PCT Member States.

133. The Delegation of the European Patent Office, in response to the intervention made by the Delegation of China, confirmed that it would continue reporting on experiences with the PCT Direct service at future sessions of the Working Group.

134. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) welcomed the new PCT Direct service, which added value to the PCT system by providing an option for the applicant to make observations at no extra fee. The Representative asked how the European Patent Office took into account the PCT Direct letter if the priority of the subsequently filed international applicant was not considered valid.

135. The Delegation of the European Patent Office, in response to the question raised by the Representative of the Institute of Professional Representatives before the European Patent Office (EPI), confirmed that the examiner would usually take a PCT Direct letter into account, even if it was determined during the search stage that the priority claim relating to the earlier application was not valid.

136. The Representative of the Japanese Intellectual Property Association (JIPA) expressed interest in the PCT Direct service and hoped that statistical analysis could show the added efficiency for the user. The Representative enquired about the period for submitting a PCT Direct request, particularly the time an applicant would have to prepare the PCT application and

PCT Direct request after receiving the search report on the priority application from the European Patent Office, and also requested further details about the operation of the PCT Direct service for international applications filed to a receiving Office other than the European Patent Office.

137. The Delegation of the European Patent Office (EPO), in response to the questions raised by the Representative of the Japanese Intellectual Property Association (JIPA), explained that in view of the EPO's aim to deliver regional search reports within six months of filing and the requirement to file the PCT Direct letter together with the international application before the expiration of the priority period, applicants would typically have six months within which to decide what action to take and to prepare the necessary documents. The EPO would also be monitoring use of the PCT Direct service and performing statistical analysis; at present, around 20 per cent of eligible applications were using the service. In terms of the operation of the service for other receiving Offices, the PCT Direct letter attached by the applicant with the request form would be forwarded to the EPO with the search copy.

138. The Working Group noted the contents of document PCT/WG/8/17.

TRANSMITTAL BY THE RECEIVING OFFICE OF EARLIER SEARCH AND/OR CLASSIFICATION RESULTS TO THE INTERNATIONAL SEARCHING AUTHORITY

139. Discussions were based on document PCT/WG/8/18.

140. The Delegation of the Republic of Korea introduced the document, which it had submitted jointly with the Delegation of the European Patent Office. The proposals in the document, aimed at sharing earlier search and/or classification results, had first been discussed at the seventh session of the Working Group and had been well-received, but certain questions and concerns had been raised (see paragraphs 231 to 247 of document PCT/WG/7/30). The document attempted to address those points, and also take into account further comments made at the Meeting of International Authorities in February 2015 (see paragraphs 54 to 58 of the Annex to document PCT/WG/8/2).

141. The Delegation of the European Patent Office provided further background and explanation behind the document. The current system of providing earlier search results was applicant-driven, with Rule 12*bis* allowing an applicant to request an earlier search to be considered by the International Searching Authority. The proposal in the document moved towards an Office-driven approach, with the transmittal of documents being covered by proposed Rule 23*bis*.2. Elements that related to the transmission of the earlier search results transferred by the receiving Office to the International Searching Authority had been moved from Rule 12*bis* to the proposed Rule 23*bis*.1. The main provisions bringing in the Office-driven approach were contained in proposed Rule 23*bis*.2. The Delegation then provided details of Rule 23*bis*.2. In paragraph (a) of this Rule, the objective was that the receiving Offices which had at their disposal earlier search results and/or earlier classification results from the priority application filed to the Office would simply forward them to the competent International Searching Authority by attaching them to the search copy along with any further documents the receiving Office considered to be useful for the International Searching Authority. Earlier search results could be a search report as such, but a list of cited prior art would also be welcomed by the International Searching Authority. In paragraph (b), in the case where the receiving Office was different from the Office where the priority application was filed, the transmittal of results to the International Searching Authority would be left to the option of the receiving Office, given that the receiving Office may not be aware of a previous search or have the results of such a search at its disposal. Paragraph (c) provided exceptions to the transmittal of earlier search and classification results when such results were already available to the International Searching Authority, whether because the earlier search was carried out by the International Searching Authority or because the receiving Office was aware that the search or classification results were available to the International Searching Authority in an acceptable form. Paragraph (d) provided the possibility for notification of incompatibility on either the transmittal of the earlier

search results or earlier classification results, since many national laws prevented receiving Offices transferring earlier unpublished search results. Finally, the changes proposed in Rule 41 were consequential to these proposed changes in Rule 23*bis*. If the earlier search results related to a search performed by the same Office acting as the International Searching Authority, they had to be taken into account, but if the earlier search was performed by a different Office from the International Searching Authority, they could be taken into account at the discretion of the examiner, but it would not be obligatory. Finally, the European Patent Office had conducted an internal implementation impact analysis and concluded that it would be possible to receive and process earlier search and classification results by the end of 2016, if the proposed rule were adopted at the PCT Assembly in 2015.

142. The Delegation of the United Kingdom supported the proposed amendments to the Regulations, which would improve the efficiency and quality of international search. As the European Patent Office was the competent International Searching Authority for international applications filed at the United Kingdom Intellectual Property Office, the proposed Rule 23*bis*.2 would require the United Kingdom Intellectual Property Office to send national search and classification results to the European Patent Office for all international applications claiming priority from a national application filed in the United Kingdom. Recent changes to national legislation had provided the possibility to send this information without the consent of the applicant. In order to share the search and classification results, the Delegation indicated an interest in extending the current arrangements for information sharing with the European Patent Office under the Utilisation Implementation Project.

143. The Delegation of the United States of America expressed support for the goal of the proposal to increase cooperation and work sharing, and drew a parallel with systems like the Global Dossier and Common Citation Document between the IP5 Offices. However, confidentiality requirements under national law in the United States of America precluded the furnishing of information such as a list of prior art cited in an unpublished application, unless specifically authorized by the applicant. Until a time when national laws could be modified, the United States Patent and Trademark Office would be unable to provide all the information required under the proposed Rule 23*bis* for unpublished applications and would therefore need to take advantage of the notice of incompatibility provided in Rule 23*bis*. As the revised proposal in the document had addressed the concerns previously expressed by the Delegation, it was able to express full support for the proposed amendments.

144. The Delegation of Sweden expressed empathy for the proposal and added that the Swedish Patent and Registration Office provided a reduction in the search fee if the results of an earlier search could be taken into account. However, it would not be possible under national legislation for the Swedish Patent and Registration Office as a receiving Office to transmit search results on unpublished applications, so it would need to make a notification of incompatibility as provided for by Rule 23*bis*.2(d).

145. The Delegation of Australia stated that it was supportive of the principles underlying work sharing and believed that sharing of work information between the Offices had the potential to improve quality and consistency of the international search. In this regard, IP Australia was willing to exchange information if the applicant had provided consent to transmit the information. However, exchange of unpublished information would not be possible under national law in Australia without consent from the applicant. The Delegation therefore suggested providing a check box on the request form for the applicant to authorize transmission of unpublished search and classification results to the International Searching Authority. Finally, while the current process of exchange of priority applications was acceptable to Australia, the Delegation believed that this could be improved by allowing exchange through ePCT.

146. The Delegation of Israel stated that under national law, it was not possible to transmit data on unpublished patent applications to the International Searching Authority without the consent of the applicant. Therefore, the incompatibility provisions would be needed. However, the

Delegation supported the proposal to move to a more Office-driven approach to the sharing of search and classification results on earlier applications between the receiving Office and the International Searching Authority.

147. The Delegation of Germany stated that it supported the idea to reduce the workload and improve quality through cooperation and work sharing. However, by moving from an applicant-driven to an Office-driven approach, the applicant lost the option to decide on whether the receiving Office was allowed to transmit the search results to the International Searching Authority prior to publication. From experience with the Patent Prosecution Highway, applicants were not always interested in search results being transmitted to another Office. Therefore, although its national law allowed for the transmission of documents relating to earlier national search or classification to the International Searching Authority under proposed new Rule 23*bis*.2(a), the Delegation could support the addition to the PCT Regulations of that new Rule only if a further provision was added under which a receiving Office was entitled to provide its applicants the choice of not having any such earlier national search or classification results transmitted to the International Searching Authority.

148. The Delegation of Japan requested clarification on three points. First, the Delegation asked for confirmation of the deletion of the part of Rule 23*bis*.2(d), following the Meeting of International Authorities, in relation to the applicant being determined to have given authorization to transmit information if it was not expressly indicated that the authorization had not been given. Second, under national law, the Japan Patent Office would not be able to transmit information on unpublished applications without explicit permission from the applicant, so the Japan Patent Office would be required to use the declaration of incompatibility. Third, the Delegation asked for further information on how a receiving Office could check whether the applicant had given approval to transmit information on an unpublished application.

149. The Delegation of Spain informed the Working Group that the Spanish Patent and Trademark Office was participating in cooperation with the European Patent Office and other national Offices of Contracting States of the European Patent Convention through the Utilisation Pilot Project, which involved exchange of information with the European Patent Office on unpublished applications without the authorization of the applicant under Article 130 of the European Patent Convention. The Delegation drew parallels between this information exchange and the proposal in the document, for which it expressed full support. Moreover, the Delegation emphasized that the most important information related to an unpublished application was the patent specification itself. When filing an application based on an earlier priority at a different Office, the information in the specification needed to have been disclosed to the subsequent Office. The Delegation therefore considered the search results and classification of the priority application to be of lesser importance and Offices should therefore consider legal means to share this information without the consent of the applicant.

150. The Delegation of Norway supported the general idea of work sharing and collaboration between Offices, but Norwegian legislation did not allow participation in the proposed system, due to not being allowed to transmit data on unpublished applications without the consent of the applicant. The Delegation expressed interest in hearing about cases where a receiving Office on its own initiative already transmitted data to an International Searching Authority, and whether making this data publicly available on international publication of the application depended on whether the data had been transmitted with the consent of the applicant and on whether the priority application had been considered withdrawn without having been made publicly available.

151. The Delegation of Egypt stated that the timescale for the Egyptian Patent Office to perform national searches would make it difficult for the International Searching Authority to benefit from the search. In addition, national law did not permit the transmission of information on unpublished application without the permission of the applicant.

152. The Delegation of Colombia supported the proposal in the document and did not perceive any obvious problems with sharing of earlier search and classification results, referring to Decision No. 486 Establishing the Common Industrial Property Regime of the Andean Community. To enable the exchange of information, the Delegation requested strengthening of the ePCT system to ensure that the information exchange procedures would not be weighed down by the volume of information being exchanged.

153. The Delegation the Russian Federation indicated some hesitation in approving the modifications due to the mandatory nature of the proposals. The Federal Service of Intellectual Property (Rospatent) would not be able transmit information on unpublished applications without the authorization of the applicant. It was also not clear whether the applicant would have the right to prohibit the sending of search results or whether this would fall under the responsibility of the receiving Office.

154. The Delegation of Iran (Islamic Republic of) acknowledged the extra duty on the receiving Office to transmit the earlier search results to the International Searching Authority and agreed with the proposal, provided it was optional for the receiving Office.

155. The Delegation of Mexico stated that the content of the proposal had merits, but was inconsistent with national law in Mexico, which obliged confidentiality to be maintained on an application, not only until publication but also until grant of the patent. The Delegation was therefore hesitant to support the proposal.

156. The Delegation of China expressed support for the proposal, which would improve international search quality, enhance consistency between the search results of a national Office and an international search report and avoid duplication of work.

157. The Delegation of Brazil stated that it shared the concerns regarding the confidentiality of data on unpublished applications and inquired how the exchange would be of benefit if the earlier search had been made in a language unfamiliar to the examiner at the International Searching Authority.

158. The Delegation of the European Patent Office responded to the interventions made by delegations by referring to the cooperation between nations to facilitate the aims in the preamble to the Treaty. When the receiving Office had at its disposal information that could be helpful to the International Searching Authority, there would be no additional work to send this information to the International Searching Authority together with the search report to help bring about an international search report of enhanced quality and timeliness. The Delegation pointed out the flexibilities in the proposals. In addition to the possibility to opt out by filing a notification of incompatibility, the search results could be limited to a list of cited prior art if the search report itself could not be transmitted. It was also possible only to transmit the classification results, which would still be more beneficial than the International Searching Authority receiving no information on the earlier application. As for language of the search results, most information was provided in an automated manner which allowed for machine translation if needed. Moreover, the most important information was the list of documents, which was easily identified and language-neutral. In terms of consent from the applicant, the possibility for the applicant to request information to be transmitted from the receiving Office to the International Searching Authority already existed under Rule 12*bis*, which would remain the case for any Offices making a notification of incompatibility in relation to Rule 23*bis*. For those Offices not making a notification of incompatibility, the burden on the applicant would be less, as there would be no need to make a request for transmission of earlier search results to the International Searching Authority and no administrative fee could be charged for this transmission, which would be performed automatically between the receiving Office and the International Searching Authority. With regard to the framework for exchanging information under Article 130 of the European Patent Convention, the European Patent Office indicated willingness to work with other European Patent Convention Contracting States to allow

exchange of documents in the confidentiality phase. The provisions also allowed cooperation with Offices that were not in Contracting States of the European Patent Convention, and the European Patent Office was open to discuss possibilities with Offices that were willing to participate in work sharing programs through these provisions.

159. The Chair summarized that all delegations that had taken the floor had supported the general goal of the proposal to facilitate the work of International Searching Authorities. Most delegations had appreciated the reason for introducing the provision of sending earlier search results from a receiving Office to an International Searching Authority in order to provide information to perform its work in timely manner to high quality. Many delegations, however, had stated that, under their respective national laws concerning confidentiality, their Offices were prohibited from transmitting information on unpublished applications without the consent of the applicant. Moreover, in some jurisdictions, it was unlikely that these restrictions on transmission of information could be removed in foreseeable future. If the proposals were to be adopted, the Offices would therefore have to make use of the possibility to "opt out" by way of notification of incompatibility and that it had to be understood that some of those Offices would not be in a position to withdraw any such notification of incompatibility in the foreseeable future. Nevertheless, delegations could give this matter some thought in their national laws on how to strike the balance between the need to respect confidentiality and the potential benefits to the applicant and the PCT system of sharing more information between Offices. Furthermore, no delegation had explicitly stated that it could not accept the proposal, even if some delegations were hesitant and would need to issue a notification of incompatibility.

160. Following informal discussions, the Working Group continued discussion on an amended draft with a further proposal to amend Rule 23*bis*.2 by adding a new paragraph (*a-bis*) as follows:

"(*a-bis*) Notwithstanding paragraph (a), a receiving Office may notify the International Bureau by [DATE] that it may, on request of the applicant submitted together with the international application, decide not to transmit the results of an earlier search to the International Searching Authority. The International Bureau shall publish any notification under this provision in the Gazette."

161. The Delegation of the European Patent Office introduced the proposed new paragraph by explaining that, while there was a possibility under Rule 23*bis*.2(d) for Offices whose national legislation prevented the transmittal of information on unpublished applications to the International Searching Authority to opt out of the provisions, the new paragraph would allow an Office whose national legislation did not prohibit this transmission nonetheless to allow applicants to prevent the transmission of the earlier search and classification results. A receiving Office wishing to provide this possibility to applicants would have to notify the International Bureau, and a list of these receiving Offices would be published in the Gazette. For a receiving Office that had made this notification, an applicant wishing to prevent this transmission would need to do so by making a specific request to the receiving Office at the time of filing.

162. The Delegation of the United States of America expressed concerns with regard to proposed new Rule 23*bis*.2(*a-bis*), noting that it was inappropriate to have the possibility to allow an Office to opt out of a PCT provision without an overwhelming need to do so, such as in the case of incompatibility of the provision with its national law. The Delegation expressed the view that this should not become an established mode of operation. Moreover, paragraph (*a-bis*) as proposed to be added was inconsistent with the goal of promoting work sharing and cooperation between Offices with a view to bringing benefits in improving the quality of patent search and examination products. The Delegation therefore requested the International Bureau to monitor the use of this provision by applicants; if it were to be rarely used by applicants, prompt consideration should be given to its removal.

163. The Delegation of France stated that it could support the proposed new draft.
164. The Delegation of Sweden reiterated that it would not be able to transmit earlier search and classification results under proposed Rule 23bis.2(a) and stressed that the opt-out provision in Rule 23bis.2(d) needed to be explained to clarify that those Member States making such a notification may never be able to change their national legislation to comply with the new requirement to transmit earlier results.
165. The Delegation of Mexico explained that the incompatibility of the proposal with its national law could be dealt with by the notification under Rule 23bis.2(d) and therefore the Delegation had no objection against the text.
166. The Delegation of Germany stated that the proposed new Rule 23bis.2(a-bis) was essential for its national Office and added that the sharing of workload should be beneficial to both applicants and Offices. In this regard, the Delegation preferred more applicant-driven solutions such as the Patent Prosecution Highway. While being able to transmit information on unpublished applications under its national law, the Delegation wished to retain the possibility for applicants to request that the earlier search results should not be transmitted to the International Searching Authority.
167. The Delegation of the United Kingdom stated that it could support the revised proposal, but aligned itself with the comments expressed by the Delegation of the United States of America on the proposed new Rule 23bis.2(a-bis), which was not desirable in the interests of work sharing. The use of the provision therefore needed to be monitored by the International Bureau and removed in the event of very low use.
168. The Delegation of Spain stated that it could support the proposed new Rule 23bis.2(a-bis).
169. The Delegation of Australia thanked the Delegation of the European Patent Office for removal from the revised proposal of the reference to Rule 12bis.2(a) in Rule 23bis.1, which covered transmittal of documents where a request had been made under Rule 4.12. However, the Delegation expressed disappointment that many receiving Offices in the proposal would be required to rely on the incompatibility provision in Rule 23bis.2(d), with little prospect of resolving the matter, since it related not only to intellectual property law but also privacy laws which only permitted information to be used for its intended purpose. The Delegation therefore believed that the Working Group needed to recognize the fundamental divergences in relation to access to information and thereby provide receiving Offices with the option only to forward documents where authorized by the applicant.
170. The Delegation of Austria supported the proposal. Like the United Kingdom Intellectual Property Office, the Austrian Patent Office sent data to the European Patent Office under the Utilisation Pilot Project. The Delegation expressed the desire that the sharing of information could work more in the reverse direction as well, with the feedback from the International Searching Authority to the Office of first filing in relation to the priority application taking place before publication given that this early feedback could assist the Office of first filing in the prosecution of the earlier application, as well as being useful for the PCT.
171. The Delegation of Colombia supported the proposal, which it believed was in line with the overarching aims of the PCT and would be an improvement for all parties.
172. The Delegation of Brazil shared the concerns expressed by the Delegations of the United States of America, Sweden and Australia on the long term incompatibility between the PCT and national legislation. The Delegation also suggested that the wording "shall" in Rule 23bis.2(a) could be replaced by "may" and therefore avoid the need for a further incompatibility provision.

173. The Chair, in response to the suggestion made by the Delegation of Brazil, stated that the wording “shall” had been included to compel Offices to transmit the information required, unless a Member State decided a specific exception applied. By contrast, the wording “may” did not compel anyone to do anything and therefore not achieve its intention. This would be to the detriment of International Searching Authorities, who would not be able to obtain useful information from a receiving Office on an earlier application, which improved the quality of the international search.

174. The Chair summarized that the original simple idea of sharing the results of an earlier search had become more complicated with the incompatibility provision for those countries whose national laws did not permit search results to be transmitted without the consent of the applicant. These national laws might not even change in the long term. In addition, even where the transmittal of search results was possible, a further carve out allowed Member States to give the applicant the choice not to transmit the search results. Although these provisions might not be ideal, the Working Group could not change the laws of Member States that would not allow for transmission of data on unpublished patent applications. Moreover, without the provisions, there would be no basis for an Office-driven approach for International Searching Authorities to receive information on earlier searches performed by the receiving Office. The Chair therefore proposed that the Working Group should approve the revised proposal for submission to the Assembly.

175. The Working Group approved the proposed amendments to Rules 12*bis*, 23*bis* and 41 of the Regulations as set out in Annex I with a view to their submission to the Assembly for consideration at its next session in October 2015, subject to possible further drafting changes to be made by the Secretariat.

REPORT ON IMPLEMENTATION AT THE EUROPEAN PATENT OFFICE OF THE MANDATORY REPLY TO A NEGATIVE SEARCH OPINION

176. Discussions were based on document PCT/WG/8/24.

177. The Delegation of the European Patent Office introduced the document by reporting that as of July 1, 2005, the European Patent Office had been issuing an extended European Search Report as now provided for by Rule 62 of the European Patent Convention (EPC). At the same time, the PCT Regulations had been amended to require the International Searching Authority to establish a written opinion under Rule 43*bis*. One of the purposes behind these work products was to enhance the procedural efficiency by providing a product corresponding to the examiner’s first communication at search stage. However, as the discretion to respond to a negative written opinion was left to the applicant and many applicants did not do so, the first communication at examination under EPC Article 94(3) was often merely a copy of the search opinion. The gains in procedural efficiency were therefore limited. As part of a strategic renewal program at the European Patent Office launched in 2009, new Rules 70a and 161 had been introduced into the EPC, entering into force on April 1, 2015. These Rules made it mandatory for an applicant to reply to an opinion accompanying a negative search report established by the European Patent Office. An applicant therefore became obliged to reply to objections relating to lack of novelty, inventive step or industrial applicability by submitting comments and/or amendments; otherwise, the application would be deemed to be withdrawn. Applicants were not, however, required to reply to a positive opinion, including cases where patentability requirements were considered to be satisfied but minor issues such as clarity remained outstanding. After the reply to a negative search opinion became mandatory, the number of applications that were accompanied by amendments when entering the national phase rose dramatically. In 2009, only 18.3 per cent of Euro-PCT applications where the EPO had issued a negative written opinion were accompanied by amendments when entering the national phase; in 2011, the first complete year after a reply to a negative search opinion became mandatory, this percentage increased to 85.5 per cent. For regional patent applications under the EPC, the corresponding percentages were 34.2 per cent in 2009 and 81.3 per cent in 2011. Since 2011, these percentages had further improved slightly. In terms of

“direct grant” applications where the examiner could issue an “intention to grant” as the first communication following amendments to a negative search opinion, the percentage rose from 59.8 per cent in 2009 to 65 per cent in 2011, and this percentage had remained stable since. A mandatory reply to a negative written opinion had therefore brought about the benefits of legal certainty and efficiency, both for applicants and examiners, with an increase in the overall rate of direct grants of applications.

178. The Delegation of Japan stated that it recognized the importance of promoting the linkage between international and national phases, but in discussing the implementation of a mandatory response to a negative written opinion in the PCT system, it was important to consider the additional burden that would be placed on users of the PCT system.

179. The Delegation of the United States of America stated that it was encouraged by the positive results of introducing a requirement for a mandatory response to a negative search opinion on prosecution of applications in the European regional phase. The United States Patent and Trademark Office was continuing to investigate how to implement a similar requirement and strongly believed that prosecution should continue to move forward at the time of national and regional phase entry and not be allowed to stagnate or even regress, as was sometimes the case. For this reason, a similar proposal was included as one of the proposals under the joint PCT 20/20 proposal by the United Kingdom and the United States of America (document PCT/WG/5/18). As the United States Patent and Trademark Office investigated a unilateral implementation of a mandatory response to a negative written opinion and the European Patent Office continued with its requirement, the Delegation hoped a mandatory response to a negative written opinion could become part of the PCT legal framework in the future.

180. The Representative of the Asian Patent Attorneys Association (APAA) stated that it was not in favor of a mandatory requirement to respond to a negative search opinion upon national phase entry and expressed concern about the loss of flexibility that this would entail for the applicant. There were many strategic reasons as to why applicants might want to commence national phase proceedings on the basis of a negative search opinion and without immediately responding to any negative statements in a search opinion. By the European Patent Office’s own admission, applicants did not overwhelmingly reply to a negative search opinion when such a reply was only discretionary. Moreover, the Representative was of the opinion that the comment in paragraph 4 of the document that applicants responded in a positive manner to a mandatory reply was not correct. Given the consequences that an application would be withdrawn if the applicant did not reply, most applicants had responded positively to a negative opinion at search stage since they had no realistic choice to do otherwise. While a mandatory reply to a negative search opinion had reduced examination times, speed did not necessarily equate to efficiency. To give an example from an Australian perspective, in many cases an attorney may delay a response to a first examination report on a patent application in Australia, especially when IP Australia had issued the search report. Reasons for these delays included the desire to wait for prior art and search reports from other jurisdictions in order to amend the application before grant in Australia, given that amendment possibilities were more restricted after a patent had been granted. The Asian Patent Attorneys Association (APAA) therefore was not favor of extending the system at the European Patent Office of requiring a mandatory reply on national phase entry to other jurisdictions.

181. The Delegation of the European Patent Office, in response to the intervention by the Representative of the Asian Patent Attorneys Association (APAA), underlined that the European Patent Office considered the rights of applicants when introducing a mandatory reply to a negative search opinion. However, it was important that patent Offices worldwide should be striving to reduce pendency times to protect the rights of third parties. The implementation of the provision would help in this endeavor where the European Patent Office had acted as the International Searching Authority on a patent application.

182. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) reported that its members were used to responding to an opinion accompanying a negative search report drawn up by the European Patent Office, which was a useful measure and enhanced legal certainty. However, such requirements should be limited to cases where the application had entered the national phase before the Office which had established the search opinion in its capacity as an International Searching Authority.

183. The Delegation of the European Patent Office, in response to the comment raised by the Representative of the Institute of Professional Representatives before the European Patent Office (EPI), confirmed that the European Patent Office had no intention of implementing mandatory replies to earlier work in international phase when this had not been performed by the European Patent Office.

184. The Representative of the American Intellectual Property Law Association (AIPLA) stated that AIPLA generally joined in the spirit of the objectives of the remarks made by the Asian Patent Attorneys Association (APAA) in the preference for the applicant to have options open to them during the patent prosecution process. With the growth of more sophisticated searching and larger stakes in litigation, the issue of cross border estoppel had become much more important. Being forced to make an early reply in one Office could therefore be detrimental to the operation in another Office. Furthermore, it was not necessarily useful for smaller applicants to have an expedited procedure, as these applicants might be awaiting results of research to be able to commercialize their inventions

185. The Chair summarized the interventions by acknowledging the efficiencies gained at the European Patent Office by requiring a reply to a negative search opinion. While Member States were supportive of the approach, representatives of patent attorney associations preferred the possibility either not to respond to a negative search opinion or not to have an application withdrawn as a consequence of not responding to a search opinion. However, patent attorneys also worked for competitors of patent applicants, who would not necessarily favor the uncertainty of leaving all options open for a patent applicant for as long as possible.

186. The Working Group noted the contents of document PCT/WG/8/24.

INFORMATION CONCERNING NATIONAL PHASE ENTRY AND TRANSLATIONS

187. Discussions were based on document PCT/WG/8/8.

188. The Secretariat highlighted the success of the patent system in making available searchable information concerning developments in all fields of technology. But this information did not inform users whether the technology was free to use in a particular State. This difficulty had been apparent in work towards systems to help users in developing countries identify technology in the public domain in accordance with the WIPO Development Agenda and the recommendation adopted by the Working Group at its third session referred to in paragraph 7 of the document. The document therefore proposed that designated Offices should notify the International Bureau of national phase entries, national publications of the international application or grant of national patents based on a national phase entry within one month of the date of the relevant event. The particular period chosen was an arbitrary one, but the key issue was that the information should be provided regularly, so that the International Bureau was able to provide reliable up-to-date information on these important issues to users. While it would be desirable to receive information on direct national patent applications as well, this went beyond the scope of the PCT Regulations, but Offices were nevertheless encouraged to send this information. Moreover, an Office would not be required to send the PCT data separately if it was contained in a suitable feed of other national patent information from which the International Bureau could extract the necessary details.

189. The Secretariat continued by explaining the background behind the timing of the proposal. Whereas the International Bureau had been working for several years to encourage the supply of this information on a voluntary basis, IT developments had reached a level where automation should no longer make the extraction of the necessary information a burden for national Offices. And for those Offices which did not maintain their own automation systems, the WIPO Industrial Property Automation System (IPAS) could be customized to local needs. IPAS was being used by more than 60 Offices, and a new data export module allowed the appropriate information to be easily exported and transmitted to the International Bureau.

190. The Secretariat also pointed out the issue of access to translations of international applications which were provided in the national phase, allowing technical information to be made available in languages beyond the original language of publication. As noted in paragraphs 13 to 16, Rule 95.1 allowed the International Bureau to request copies of such translations from the designated Office, but that was rarely done. In preparing the document, the International Bureau considered making the provision of these translations mandatory, but analysis showed that most were already published on PATENTSCOPE or similar online collections. The key issue was therefore not whether these documents were available, but more being able to associate them with the relevant international application and to be searchable and accessible by users with a preference for a particular relevant language. This goal would be greatly assisted by the provision of the information in the proposed rule change in the document. The burden of setting systems to provide copies of translations was, however, considered disproportionate to the small number of additional language versions of documents which would be made available in practice, but the underlying goal would be achieved by the proposals in the document. The Working Group was therefore invited to consider the proposed amendments to Rules 86 and 95 to require designated Offices to provide information to the International Bureau concerning national phase entry, national publications and granting of international applications.

191. The Delegation of the Republic of Korea supported the proposal and informed the Working Group that the Korean Intellectual Property Office had been providing the information listed in proposed Rule 95.1 on a monthly basis. This information was useful for businesses and other interested parties and would be more complete by adopting the proposed changes to the Rules.

192. The Delegation of the European Patent Office welcomed the proposal and indicated willingness to grant the International Bureau access to its database to retrieve the information required in the proposed Rule 95.1. However, in the case of early national phase entry at the European Patent Office before international publication, the restrictions under Articles 128 and 130 of the European Patent Convention (EPC) would apply. Moreover, the acts listed in Rule 159 of the EPC did not need to be completed simultaneously, and in the absence of an explicit request for early processing, national phase entry would occur after the expiry of the 31 month time limit stated in the EPC, even if the steps in Rule 159 had been performed earlier. The European Patent Office therefore requested the one month time limit for providing the information on national phase actions to be extended to two months to facilitate compliance by designated Offices.

193. The Delegation of Norway expressed full support to the proposed amendments to Rules 86 and 95 in the document.

194. The Delegation of the United States of America supported the proposed amendments in the document and already made such information available to WIPO and other interested parties, through free weekly downloads from the web site of the United States Patent and Trademark Office. Requiring such information from all national Offices would provide improved access to information on where protection was being sought. The Delegation appreciated that the one month time period proposed in Rule 95 for providing the information was arbitrary, but expressed concern on whether even two months was appropriate for certain types of

information and suggested that more flexible language could be used. With regard to paragraph 10 of the document on providing information on actions on national applications, in view of the revival and reinstatement practices at the United States Patent and Trademark Office, the Office would have difficulty in providing definitive information that the national stage had not been entered or that an international application had been refused. However, information on the lapse of a granted patent or reinstatement of lapsed applications or patents was already made available by the United States Patent and Trademark Office on its web site.

195. The Delegation of Israel supported the proposal to improve availability of information concerning the national phase entries, which the Israel Patent Office already provided on a monthly basis to the International Bureau in XML format in compliance with WIPO Standard ST.36. The Delegation also supported the proposal from the Delegation of the European Patent Office for the period to provide this information to be two months.

196. The Delegation of the United Kingdom supported the proposed changes to improve access to patent information, but would not be able to comply with the revised Rule 95.1 since the United Kingdom Intellectual Property Office was overhauling its IT systems as part of a project due for completion in 2017. As the changes needed to supply the national phase information to the International Bureau would be implemented as part of this overhaul, it would not be possible to implement the changes before this date.

197. The Delegation of Austria reported that the Austrian Patent Office used ePCT to feed information to the International Bureau on national phase entry. The Austrian Patent Office would also be able to supply information on national publication of an international application and grant information as soon as certain technical problems had been solved.

198. The Delegation of France supported the proposal which would improve quality and agreed with the suggestion by the European Patent Office to extend the period for transmission of the information to two months.

199. The Delegation of Spain supported the proposal with the more flexible timeline suggested by the Delegations of the European Patent Office and the United States of America.

200. The Delegation of Japan supported the general direction of the proposal to provide information through PATENTSCOPE on whether national phase entry had taken place at designated Offices. The Delegation requested clarification on the terminology used in Rule 95.1 for the event of national phase entry, the national publication of the international application and the term "associated publication".

201. The Delegation of Canada stated that the Canadian Intellectual Property Office already provided information on national and international applications through a weekly export package to the International Bureau and it would endeavor to provide any additional information required. The Delegation therefore expressed support of the proposals, but requested clarification on some of the wording in the proposed amendments, namely, whether the date of publication referred to the date the document was published or the date it was laid open to public inspection, whether the proposed Rule 95.1(ii) should include the word "national" and if it was meant to encompass divisional applications, and the meaning of "associated publication" in Rule 95.1(iii), which was not found elsewhere in the Regulations. The Delegation also pointed out the problems with compliance with the proposed Rule 95.1(i) for early national phase entry where the application was not yet open to public inspection.

202. The Delegation of Cuba supported the proposed amendments in the document and added that it had been sending national phase information to the International Bureau since 2009.

203. The Delegation of New Zealand supported the proposal, which would improve the quality and nature of information available to users, given the importance of the status of an application during the examination process at a designated Office. The Intellectual Property Office of New Zealand was providing information on a monthly basis to the International Bureau and would be pleased to provide further information requested in a timely manner.

204. The Delegation of Brazil stated that it shared the concerns expressed by the Delegation of the United States of America over the one month publication deadline and also those expressed by the Delegations of Japan and Canada, notably regarding the language and concept of “any publication” referred to proposed Rule 95.1(ii) and what was encompassed by the obligation.

205. The Delegation of Mexico added its support to the requests from other delegations for a more flexible timeline in Rule 95.1, particularly the information on national phase entry, where it suggested a time period of 18 months from the priority date, corresponding to when international publication would take place.

206. The Delegation of China supported the proposal in principle to promote the dissemination of technological information for users on the legal status of an international application in the national phase. However, the language barrier would affect users using this information effectively. The Delegation therefore proposed amending the Regulations so that the information on national phase actions could be provided in the language for local users in order to promote the transmission and utilization of such information. Like other delegations, the Delegation believed that the one month time period proposed in Rule 95.1 was too short, and suggested an extension to six months.

207. The Delegation of Colombia supported the proposal but requested clarification on the wording “any publication” in Rule 95.1(ii) and “associated publication” in Rule 95.1(iii). The Delegation informed the Working Group that the Superintendencia de Industria y Comercio of Colombia had already been providing the information proposed in this Rule and continuing to do so would not pose a barrier, unless the quantities of information to be handed became much larger.

208. The Delegation of Germany expressed full support for the proposed Rule change but indicated technical problems with transmitting information on the date of events referred to in Article 22 or 39 within one month of their occurrence if this occurred before the end of the 30 month period for national phase entry, as the electronic work flow at the German Patent and Trademark Office only started after this date.

209. The Delegation of Portugal supported the proposal but supported a longer period than one month to supply the required information to the International Bureau.

210. The Delegation of Chile supported the proposal so far it moved towards improving access to technical information and providing the possibility for users in developing countries to be able to identify information in the public domain. The National Institute of Industrial Property of Chile used the Industrial Property Automation System (IPAS) system, which allowed all the necessary information on national phase actions to be collected. The Delegation agreed with an extension beyond the one month period for transmitting the required information to the International Bureau.

211. The Delegation of the United States of America suggested that Rule 95.1(i) could be amended to require notification to the International Bureau within two months of the occurrence of the relevant event or as soon as reasonably possible thereafter.

212. The Secretariat indicated that it would revise the proposal in the document for the Working Group to consider later in the session for submission to the Assembly in 2015, taking into account the interventions from delegations. In terms of entry into force, this could be looked at when submitting the proposed changes to the Assembly, noting that some Member States

would not be able to implement the changes from July 2016. Addressing the comment made by the Delegation of China on the language of the information, the PATENTSCOPE database was available in the 10 PCT publication languages, and the information after publication was already made available in bulk format for integration into systems from other service providers. Consequently, to introduce a Rule concerning bulk distribution of national phase data only could lead to doubt concerning the use and bulk distribution of other PCT data. The Secretariat therefore suggested that the issue could be subject of an Understanding of the Assembly rather than being explicitly included in the Regulations.

213. The Delegation of China repeated its suggestion to amend the Rules to provide a legal basis for the bulk distribution of the information shared by the International Bureau.

214. The Delegation of the United Kingdom expressed support for submitting the proposal to the Assembly in 2015 if adequate time was given for implementation by designated Offices.

215. The Representative of the Japan Patent Attorneys Association (JPAA) supported the proposal in view of the interest and importance of a competitor being able to follow an international application as it entered the national phase. However, the requirement for designated Offices to transmit all the national phase entry information required within one month of an event could be burdensome for some Offices, but at least the information on a national phase entry taking place should be provided.

216. The Representative of the Asian Patent Attorneys Association (APAA) stated that it was strongly in favor of the proposal. APAA had members in a number of countries, so to have national phase information available would be useful for applicants and those wishing to use technology in the public domain. As some delegations had indicated difficulties with meeting the time frame for transmission of the required national phase information to the International Bureau, the Representative asked whether the PATENTSCOPE database could indicate the dates of the latest uploads of national phase information for each country.

217. The Representative of the Japan Intellectual Property Association (JIPA) supported the proposal, which would benefit applicants and users of the patent information databases who would be able to obtain details of national phase actions at an earlier stage from a single easily-accessible data source. The Representative hoped that the information on the current status of the application, including abandoned or not entered into the national phase, would be made available in a timely manner and accessible through improved search tools in PATENTSCOPE.

218. The Representative of the American Intellectual Property Law Association (AIPLA) supported the proposal and associated itself with the suggestion made by the Representative of the Asian Patent Attorneys Association to show when the last update was made. In terms of the time for notifying the International Bureau on national phase information, a longer period than 60 days would appear to eviscerate the value of the exercise, given the need for companies looking for the freedom to use a technology to have up-to-date information.

219. The Secretariat, responding to the suggestion from the Asian Patent Attorneys Association (APAA) to indicate the date of the latest upload of national phase information, informed the Working Group that these dates were already listed in the PATENTSCOPE database for each Office that provided this information to the database.

220. The Secretariat presented a revised proposal. This required the designated Office to notify the International Bureau of information within two months, or as soon as reasonably possible thereafter. Rule 95.1(i) had been clarified since it was not possible that the acts referred to in both Article 22 and 39 could take place on the same international patent application. In Rule 95.1(ii), the amended text referred to national publication and not the laying open to public inspection, the intention being that any national publication number would be

sent to the International Bureau. In Rule 95.1(iii), the text had been amended to refer to the publication of the granted patent under national law; information, for example, about the Gazette where the granted patent was advertised would be desirable information to provide, but not obligatory.

221. The Delegation of the United Kingdom suggested adding “or practice” to proposed Rule 95.1 (ii) as re-publishing an international application that had already been published by the International Bureau was not a legal requirement in the United Kingdom, but was performed under national practice.

222. The Delegation of Egypt informed the Working Group that, as it did not publish patent applications at 18 months from the priority date, but only published approved and rejected applications, the Delegation asked the International Bureau whether the application or publication number needed to be provided.

223. The Secretariat, in response to the comments made by the Delegation of Egypt, proposed that any application number allotted to the application be included in the information in Rule 95.1(i). Where a country did not publish pending patent applications like Egypt, Rule 95.1(ii) would not apply.

224. The Delegation of China reiterated its preference for a time limit of six months to provide the national phase information in Rule 95.1, adding that two months would be difficult to fulfill. The Delegation also stressed the need to strike a balance between the responsibility of Offices to transmit information to the International Bureau, and the responsibility of the International Bureau to distribute the information in bulk format.

225. The Chair, in response to the comments made by the Delegation of China on the time limit for notifying the International Bureau, stressed that the original period of one month had been proposed as the information was not detailed or difficult to transmit. This had been amended to two months, or as reasonably possible thereafter, in response to requests from Member States. While there could be circumstances such as early national phase entry or grant, where there might be difficulties in transmitting the information within two months, but the International Bureau would work with Member States to ensure that Offices provided this information as best as they could in the interest of having up-to-date information. The Chair therefore did not support a time period longer than two months for normal cases of national phase entry as this would show lack of interest and no intention to provide the information on a timely basis.

226. The Delegation of Greece queried the references to “national law” in Rules 95.1(ii) and (iii) and wondered whether it should be rephrased to “applicable law”.

227. The Delegation of the United States of America, in response to the question by the Delegation of Greece, referred to Article 2(x) as follows: “references to ‘national law’ shall be construed as references to the national law of a Contracting State or, where a regional application or regional patent is involved, to the treaty providing for the filing of regional applications or the granting of regional patents”.

228. The Secretariat presented a further revised proposal, which included an Understanding to be adopted by the Assembly that the information concerning national phase events in Rule 88.1(iv) would not only be made available to the public by means of the Gazette on PATENTSCOPE, but also as part of the bulk PCT bibliographic data offered to Offices and other subscribers to the PATENTSCOPE subscription data services. Noting that there were no explicit statements for bulk data services in the Regulations, the idea behind the Understanding was to achieve consistency and be clear that data would be made available in bulk form to national Offices. The requirement to provide any national application number that had been assigned to the application had been added to Rule 95.1(i); in a few Member States, this would not apply, as the international phase number continued to be used after national phase entry.

In Rule 95.1(ii), the reference to publication under national law or practice had been clarified. Finally, the Secretariat stressed that these provisions applied to the national phase entry, the national publication of the application that had entered the national phase and the grant of the application. It therefore did not apply to a divisional application or continuations of an application, which could be provided to the International Bureau on a voluntary basis.

229. The Delegation of the United States of America expressed support for the further revised proposal.

230. The Delegation of the European Patent Office stated that it supported the further revised proposal.

231. The Delegation of China stated that it was pleased to have an Understanding agreed on provision of bulk data by the International Bureau, but wished to include a responsibility for the International Bureau to supply any translation it received. The Delegation also request more time to consult internally on the rules in the State Intellectual Property Office of the People's Republic of China.

232. The Chair, in response to the comments made by the Delegation of China, underscored the need to arrive at a single version of the proposed amendments to the Rules to be submitted to the Assembly and sought clarification from the Delegation whether it could accept going ahead with the further revised proposal. Second, the Chair pointed out that the International Bureau had made it clear that information it received would be made available in PATENTSCOPE and, where possible, transmitted in bulk format to Offices. The Chair therefore requested the Delegation of China to indicate what difficulties it had with this provision. Finally, the Chair did not see any consensus from other delegations to push the timetable for providing the national phase entry information out to six months. Some other delegations indicated difficulties with two months, but it was important to have a target which emphasized the importance of providing timely information to the extent practical.

233. The Delegation of China responded to the questions raised by the Chair by stating that it had been seeking a legal basis for its concerns in the Rules. In terms of timing, the Delegation wished to consider the matter after the end of the session and provide any comments as soon as possible.

234. The Delegation of Colombia stated that it could approve the further revised proposal as it had amended the time for designated Offices to provide the national phase entry information to two months, or as soon as possible thereafter, and had clarified what was meant by publication of the application in the national phase by an Office.

235. The Delegation of Canada expressed support for the further revised proposal.

236. The Chair summarized the discussions by concluding that there was fairly strong consensus for requiring designated Offices to notify the International Bureau within two months, or as soon as possible thereafter, of national phase entry, of publication of the international application under the national law or practice of the designated Office, and of grant of the patent. The Delegation of China had raised issues on how the provisions might work, but given the consensus from the Working Group to move forward, the Chair asked the International Bureau to work with the Delegation over the coming weeks to address what the Delegation was seeking to achieve and whether this could be dealt with at a practical level or by a subsequent proposal at another session of the Working Group.

237. The Working Group agreed on the proposed amendments to Rules 86 and 95 set out in Annex II with a view to their submission to the Assembly for consideration at its next session, in October 2015, subject to possible further drafting changes to be made by the Secretariat.

238. The Working Group agreed to recommend that, subject to further discussions between the Secretariat and the Delegation of China on possible drafting changes to the proposed Understanding or possible alternative ways to address the issue, such as explicitly addressing it in the Regulations, the Assembly adopt the following Understanding at the same time as the proposed amendments to Rules 86 and 95: "In adopting the amendments to Rule 86.1(iv), the Assembly noted that the information concerning national phase entry will be made available to the public not only by way of inclusion in the Gazette on the PATENTSCOPE website but also as part of the bulk PCT bibliographic data offered to Offices and other subscribers to the PATENTSCOPE subscription data services."

REVIEW OF THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

239. Discussions were based on document PCT/WG/8/6.

240. The Secretariat explained that the option for an applicant to request supplementary international search had been available for just over six years. After the first three years of operation in October 2012, the Assembly had reviewed the supplementary international search system and had decided to perform a further review in 2015, taking into account further developments until then, notably in relation to efforts to move towards collaborative search and examination models and in relation to efforts to improve quality of the main international search. To gather information for this year's review, the International Bureau had sent out Circular C. PCT 1429 in October 2014 to Offices and user groups, and had also made direct contact with users who had requested supplementary international search in the past to seek their views and experiences. The document summarized the responses to the Circular. In general, uptake of supplementary international search had remained very low but had increased over the past three years. The experiences of those requesting the service and International Authorities that provided supplementary international search had largely been positive. To prepare the review by the Assembly this year, paragraphs 23 to 29 of the document highlighted issues that the Working Group could consider. These included proposals that were submitted in reply to the Circular on how to improve the system by amending the legal framework, and other initiatives that the International Bureau and Offices could take to make the service more attractive to users. There was also an update in the paper on collaborative search and examination work between International Authorities, including a proposal to begin a third pilot project over the next three years between the European Patent Office, the Korean Intellectual Property Office and the United States Patent and Trademark Office that was discussed in the Meeting of International Authorities in February 2015 (see document PCT/MIA/22/13). With these issues in mind, the Working Group needed to consider how to move forward. Discussions could begin on how the supplementary international search system might be modified or even discontinued. Alternatively, the Working Group could recommend continuing to monitor the system in the coming years and perform another review of the supplementary international search system in the future. This review could consider further developments, particularly the conclusion and evaluation of the third pilot on collaborative search and examination, which could take place five years from now. If the Working Group wished to monitor the system for a further five years, paragraph 31 of the document included a draft recommendation to put to the Assembly for a decision.

241. The Delegation of the European Patent Office supported the recommendation to continue to monitor the supplementary international search system for a further five years and review the system again in 2020. However, the Delegation proposed to remove the linkage between the supplementary international search and the pilot on collaborative search and examination in the draft recommendation in paragraph 31 of the document. Supplementary international search provided the possibility for a further international search to be requested after the main international search, but under a collaborative search and examination model, the applicant would have to make a choice upfront to have an application searched by more than one International Searching Authority for a higher search fee. A collaborative model therefore had the advantage that an enhanced search would be performed before international publication,

but the disadvantage that the applicant would have to pay a higher search fee at the outset. If collaborative search and examination were integrated into the PCT legal framework, the option could co-exist with supplementary international search. It could therefore be possible for an applicant to request a supplementary international search after a collaborative search on the application had been performed. In terms of the proposals in the document, the Delegation expressed interest in further exploration of the idea of allowing applicants to request supplementary international search on the basis amended claims submitted under Article 19. The Delegation could also support the postponement of the decision of an applicant to file a request for supplementary international search. The present deadline of 19 months from the priority date for filing a supplementary international search request and 28 months for the International Searching Authority to establish the report left nine months to perform the supplementary international search. With efforts made at the European Patent Office to produce search reports within a six month time frame, postponing the deadline for filing a supplementary international search request to 22 months would give six months to produce the supplementary international search report and the filing deadline would be identical to the time frame for filing a demand for international preliminary examination under Chapter II. As for uptake of supplementary international search, the Delegation agreed that the low number of International Authorities offering the service was a reason for the low interest from a European perspective and drew attention to the particular interest from user communities in Europe to have searches for earlier prior art in the Asian languages. Concerning fees for supplementary international search, International Authorities had the flexibility to adjust fees, but at the European Patent Office, the supplementary international search was produced in the same way as the “main” international search. Applicants with a supplementary international search report produced by the European Patent Office therefore had the same advantages as an applicant entering the European regional phase with an international search report drawn up by the European Patent Office and would have the European supplementary search fee waived. However, the Delegation understood other International Searching Authorities offering a cheaper supplementary international search service in specific document collections, which provided applicants with a choice of different types of supplementary international searches according to their needs.

242. The Delegation of the Nordic Patent Institute agreed with the recommendation in paragraph 31 of the document and could support the proposal by the European Patent Office to remove the linkage with the collaborative search and examination pilot. With regard to specific proposals to improve the system, the Delegation could also support allowing the supplementary international search to be based on Article 19 amendments and prolonging the deadline for filing a supplementary international search a request to 22 months. The Nordic Patent Institute was also willing to work further on raising awareness and promoting services to users. With regard to the fees, the Nordic Patent Institute offered two types of supplementary international searches, a full search and, and since May 1, 2013, a less expensive limited search limited to the document collections in Danish, Icelandic, Norwegian, and Swedish, but unfortunately no requests had been received for the latter search. The Delegation concluded by supporting the continued monitoring of the supplementary international search system as it made little financial sense to stop providing this option to applicants at this time.

243. The Delegation of Israel stated that it would be able to support the proposal by the European Patent Office to remove the linkage between supplementary international search and the pilot on collaborative search and examination in the draft recommendation in paragraph 31 of the document.

244. The Delegation of China stated that it had been paying close attention to the development of the supplementary international search system and supported the proposal to continue to monitor the system until 2020.

245. The Delegation of the Republic of Korea stated that the Korean Intellectual Property Office had no concrete plan to offer supplementary international search at this stage, but might do so in the future. Meanwhile, the Delegation supported continuing to monitor the service.

246. The Delegation of the Russian Federation stated that it had had a positive experience with providing supplementary international search and supported the continuation of the system. The Federal Service for Intellectual Property (Rospatent) provided a supplementary international search service with a reduced fee compared to the main search, even in cases where the results of the main search were not yet available and Rospatent needed to perform a search not only on national documentation in the Russian language but also on the entire PCT minimum documentation. Moreover, for the national phase where results of the “main” international search and supplementary international search were available, there could be no need for Rospatent to perform a further search. The Delegation supported the direction of the document in paragraphs 23 to 29 and agreed with the comments made by the Delegation of the European Patent Office on the link between collaborative search and examination and supplementary international search.

247. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) reported on a limited survey that it had conducted among its members giving reasons for the low interest in supplementary international search. The survey highlighted that supplementary international search was not offered by certain Authorities of potential interest to applicants, namely, the United States Patent and Trademark Office, the Korean Intellectual Property Office, the Japan Patent Office, the State Intellectual Property Office of the People’s Republic of China and the Indian Patent Office. Applicants also indicated a wish to have national procedures deferred pending issuance of a search report in order to give added value so the applicant could decide afterwards whether to enter the national phase or not. In terms of collaborative search, users could be interested in this possibility if it was available at reasonable cost. Finally, one applicant reported that a further search could be obtained by early entry in the national phase at a designated Office, with the results of this further search being used to decide on national phase entry before other designated Offices.

248. The Representative of the Japan Intellectual Property Association (JIPA) agreed with the reasons for low use of supplementary international search listed in paragraphs 14 to 16 of the document, particularly the language barrier and costs of the service. For some users in Japan, it was not clear that the benefits for a supplementary international search outweighed the extra costs. JIPA therefore supported the monitoring of user benefit, especially how the documents found in a supplementary international search were used by the designated Office after national phase entry, as described in paragraph 11 of the document.

249. The Chair summarized that the Working Group had shown general support for making the proposed recommendation in paragraph 31 of the document to the Assembly, with an amended text to separate the linkage with the collaborative search and examination pilot by replacing the text in paragraph (d) of the recommendation: “... efforts to move towards collaborative search and examination models and ...” with the wording: “... developments in collaborative search and examination and ...”. The Chair also suggested that the Secretariat could investigate further the suggestions to improve the supplementary international search system made by the Working Group such as consideration of Article 19 amendments in a supplementary international search and extending the time limit to file a request for supplementary international search.

250. The Working Group invited the International Bureau to present a document to the next session of the Working Group to discuss possible improvements to the supplementary international search system.

251. The Working Group agreed to recommend to the PCT Assembly to adopt the following recommendation:

“The PCT Assembly, having reviewed the supplementary international search system three years after the date of entry into force of the system and again in 2015, decided:

“(a) to invite the International Bureau to continue to closely monitor the system for a period of a further five years, and to continue to report to the Meeting of International Authorities and the Working Group on how the system is developing;

“(b) to invite the International Bureau, International Authorities and national Offices and user groups to continue their efforts to raise awareness of and promote the service to users of the PCT system;

“(c) to invite the International Authorities which offer supplementary international searches to consider reviewing the scope of their services provided under the system and consequently the levels of fees charged for the services provided, which should be reasonable; and to invite Authorities which currently do not offer the service to reconsider whether to offer the service in the near future;

“(d) to review the system again in 2020, taking into account further developments until then, notably in relation to developments in collaborative search and examination, and in relation to efforts to improve the quality of the “main” international search.”

NATIONAL PHASE ENTRY USING EPCT

252. Discussions were based on document PCT/WG/8/19.

253. The Secretariat introduced the document, which followed on from discussions at the seventh session of the Working Group on the concept of using ePCT to trigger national phase entry (see document PCT/WG/7/12 and paragraphs 283 to 305 of document PCT/WG/7/30). This would streamline the process to the benefit of both applicants and designated Offices in two ways. First, it would reuse the bibliographic data and would supply it to the national Office in a format which allowed it to be imported directly into the systems at the designated Office. This would eliminate the need to retype information by the applicant into national forms and in turn by the Office into its own internal systems with the opportunity for introducing errors. Second, it would offer a secure common platform for uploading and review of documents and data by the original agent and by the associate agent in the relevant country where national phase entry was contemplated before it was submitted. This would therefore increase the confidence on both sides of the operation that the instructions had been properly understood so the results of submitting the request to enter the national phase would be more likely to be error free.

254. The Secretariat continued by referring to the seventh session of the Working Group, where various issues on the concept had been raised by applicants and Offices. The document outlined the ways in which the existing ePCT system could overcome challenges equivalent to these issues. ePCT could check that requirements had been met for different Offices and be able to prevent submission of an action without providing a national agent, necessary signatures, and documents which were clearly necessary. ePCT could give warnings of possible problems for the applicant to verify the application, and ePCT had a system to handle different time zones. In addition, ePCT provided a flexible access rights management system with an interface in different languages, which could allow an instructing agent in one country to provide access to a partner agent in another country on a case-by-case basis. For the system to work effectively, a reliable knowledge of the formal local requirements was required, including languages, time limits, legal representation and the types of documents needed. But substantive local requirements would remain the responsibility of the local attorney. Further discussions were, however, required before finding a suitable solution for the payment of national phase entry fees. There appeared to be enough interest for centralized payment of

application fees and in time it should be possible to find a solution for fees payable to designated Offices as well as receiving Offices. But in the meantime, the Secretariat hoped that Offices would agree to be part of a pilot group for testing a system for national phase entry using ePCT without the centralized fees component.

255. The Secretariat concluded by underlining that the ePCT system would only be useful for national phase entry in Offices which could guarantee that its use would be effective in the sense that the documents would be received, processed and given proper legal effect, which should not be a difficulty in many designated Offices. The International Bureau was therefore looking for a small representative group of designated Offices and user representatives who were interested in finalizing the requirements so that a system could be produced which was relevant to a wide range of designated Offices as possible. The International Bureau invited comments on the approach and asked for volunteers to participate in the process, whether by indicating interest during interventions on the document or by contacting the Secretariat after the session.

256. The Delegation of Japan expressed interest in participating in the pilot project to explore the possibility of national phase entry using ePCT and requested further information on legal and technical requirements before taking a final decision on participation. In particular, the Delegation asked whether the pilot would include real or dummy international applications as it would be necessary for participants in the pilot to check national legal requirements if actual international applications were to be tested in the pilot.

257. The Delegation of New Zealand welcomed the development of ePCT services to support national phase entry. The Intellectual Property Office of New Zealand was a strong supporter of ePCT, using the system for international applications, and was working with the International Bureau and IP Australia on implementation of an eSearchCopy service. In addition, the Intellectual Property Office of New Zealand already provided a similar arrangement to assist national phase entries as part of its online case management facility and would be pleased to participate in the proposed pilot and share experiences in implementing a full entrance protocol.

258. The Delegation of Australia stated that it welcomed exploring improvements to the system and expressed interest in reviewing the prototype interface and feeding into the development of the interface to ensure that the system met the needs of both IP Australia as a user of ePCT and its stakeholders. In particular, it was important to ensure that the system provided for appropriate involvement of local agents and the ability to pay fees via ePCT. Once IP Australia had a better understanding of the resources required to become part of the pilot, it could consider further participation in the small group to validate and test the system.

259. The Delegation of the United States of America stated that it supported the concept of ePCT to trigger national phase entry in that it related directly to the cross-filing functionality envisioned for the IP5 Global Dossier. Experts at the United States Patent and Trademark Office had indicated that it should be straightforward to solve technical difficulties, but there were significant legal challenges to overcome before such a system could be implemented in the United States of America. For example, under national law, applicants could only receive a filing date as of the date an application was either deposited directly with the United States Patent and Trademark Office or, under certain described conditions, deposited with the U.S. Postal Service. Provided these legal issues could be resolved, the United States Patent and Trademark Office would be interested in participating in the pilot discussed in the document and the Office looked forward to working with the International Bureau to develop the IT and legal framework necessary for participation.

260. The Delegation of Israel supported the concept of using ePCT for national phase entry, and believed that the service would be beneficial for all stakeholders. However, the system needed to take into account the various substantive and formal requirements of different

jurisdictions. With regard to the fees, a centralized payment system would require amending patent law in Israel since an international application could not enter the national phase until the fee had been paid.

261. The Delegation of Canada stated that ePCT had many features of benefit to applicants and Offices for facilitating the process of national phase entry. The Canadian Intellectual Property Office would also be interested in participating in a pilot, but it was first necessary to verify the legal issue of delegating actions on an application to a non-Canadian citizen.

262. The Delegation of the European Patent Office expressed interest in participating in a pilot project with the International Bureau and other Offices. However, there were challenges to be overcome. In particular, there was a risk of delay in the processing of an application when entering the national phase for two major reasons. The European Patent Office could not start processing an application until all the requirements for entry into the European phase had been met. Even if the date of submitting any document via ePCT was considered the date of submission, until the information was received by the European Patent Office, no communication could be issued as a designated Office. Another problem was the delays in the processing of corrections of deficiencies, where the system would need to assure forwarding by ePCT to the designated Office to verify them from the date of submission and inform the applicant of any deficiencies, for instance, relating to the representation. A second set of challenges related to the risk of confusion if a centralized payment system meant that not all fees could be payable for entering the European phase via the centralized system, leading to fees being paid via different systems with the risk that the fee deadline for entering the European regional phase could be missed. Finally, there could be further complications for requests for early national phase entry. The Delegation therefore suggested that early national phase entry cases be removed from the pilot.

263. The Delegation of Mexico referred to paragraph 16(f), which outlined that the ePCT system for national phase entry was planned for use only with Offices that agreed to receive information and documents electronically, which was not possible under its national legislation.

264. The Delegation of China welcomed the exploration of using ePCT to enter the national phase, but hoped the legal, technical and practical aspects could be adequately considered before such a function was put to use and shared the concerns about meeting strict deadlines for entering into the national phase.

265. The Chair summarized comments from members of the Working Group by commenting on the general support for a system to facilitate national phase entry using ePCT. However, there were legal, technical and administrative issues that needed to be resolved before broad application. Some Offices were willing to be part of pilot group to test and validate the approach, while others would not be able to be involved at this initial stage.

266. The Representative of the American Intellectual Property Law Association (AIPLA) referred to the policy perspective behind the patent system to achieve public disclosure in return for granting a public monopoly for a limited time period. The system would be better served if the application was reviewed by an attorney before entering the national phase for two reasons. First, the application would be higher quality with more focus, easing the work of designated Offices. Second, some economic value filtering would occur as applicants would need to consider whether it would be worthwhile to engage the services of an attorney to prosecute his application in a different jurisdiction. It was also important that the client knew who had responsibility for a national phase action, where a local attorney could be necessary to correct errors made in the prosecution. By contrast, making national phase entry possible through a single click could lead to a "registration system" with an overabundance of flawed applications and the issue of ambiguous agent representation, which could particularly disadvantage inexperienced small and medium-sized enterprises not understanding the implications of not

having counsel. In reality, the lack of a review by an attorney could in the long run lead to more work for attorneys fixing problems that could have been avoided by an initial review by an attorney.

267. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) stated that ePCT could facilitate national phase entry provided the system could handle specific national requirements and was used by persons with experience in processing applications before the designated Office. However, there were hazards linked to the use of a system by users without this experience, and by applicants deciding to enter the national phase at a late stage without time to find a local professional representative or wishing to delay the appointment of such a representative. The proposed system would encourage national phase entry by applicants without appointing a professional representative with the right to practice before the designated Office. This would not be recommended, as certain mistakes and omissions could impact on the fate of an application in the national phase. First, particular requirements of some designated Offices, such as calculation of fees and filing of certified translations, might result in deficiencies during prosecution in the designated Office. Second, the appointment of a professional representative after national phase entry limited the available time that the authorized representative would have to correct the deficiencies that might occur during national phase entry, at increased cost to the applicant. Third, applicants might not receive communications from the designated Office, as some did not send these abroad, which could be critical for the fate of the application. Furthermore, the use of an interface administrated by an authority other than the designated Office might create confusion on who would be responsible in case of a malfunction, the administrating authority or the designated Office. EPI therefore believed that the interface could be a useful tool for persons who were familiar with international legislation, the national legislation of the designated Office and the respective procedures, but there were hazards when reviewed by persons who were unfamiliar with legislation and procedures and who would be encouraged to delay the appointment of a professional representative until after national phase entry. Furthermore, the system may be an incentive for the establishment of service providers that would perform automatically the national phase entry in many countries and would not be liable for the procedural steps that they performed. In moving forward with the project, the Representative provided some suggestions to the International Bureau on how to proceed. First, it was essential to define whether the International Bureau or the designated Office was responsible if the interface was not compliant with the national requirements of the designated Office. Second, a helpdesk should be provided for users to give information of both a technical and legal nature regarding national phase entry. Third, the requirements of designated Offices needed to be included in the interface as far as possible, and the interface should not accept a request for national phase entry at a designated Office unless these basic requirements were fulfilled. And finally, the interface needed to be comprehensive on the requirements of each designated Office to cover matters like the duty of the applicant to disclose prior art. EPI would monitor the progress of the pilot and would be willing to join the group to provide comments in order to minimize the hazards with the use of ePCT in national phase entry.

268. The Representative of the Japan Patent Attorneys Association (JPAA) agreed with the basic concept of ePCT and understood that the proposal was made with the aims to be user-friendly and enhance the efficiency of processing of work in Offices. Although the concerns expressed by representatives of patent attorneys had been acknowledged in the document, it was unclear how professional representatives would be involved in the ePCT system when used to enter the national phase. It was important to bear in mind that users included applicants and patent attorneys, the latter ensuring high quality work to contribute to the smooth processing of cases in Offices. The Japan Patent Office had electronic filing in place for some time, and it was important to ensure consistency between ePCT and the present electronic filing system at the Japan Patent Office. There were many technical issues that needed to be studied and at this stage JPAA was not able to agree on a system for national phase entry using ePCT.

269. The Representative of the International Federation of Industrial Property Attorneys (FICPI) shared the concerns expressed by other representatives of patent attorney associations and elaborated on two points. The first point was relevant applicable law and liability for actions on a case. In a paper-based system, national phase entry took place in the territory of the designated Office, so any error was subject to national law and the decisions of courts of that jurisdiction. In ePCT, information was sent to the designated Office through a user interface under control by WIPO with an application date being assigned by shifting the data in a cloud from the International Bureau part to the designated Office part. It therefore needed to be clear that the user had full access to the data and during national phase entry the data was brought under the national law of the designated Office with the applicant having access to a judicial review under the legal system in the event of a failure in the ePCT system. The second point was the relevant cost disadvantage that national phase entry through ePCT would have for small and medium-sized enterprises. Whereas large filers would be able to file in multiple countries using ePCT or the global dossier, small applicants would not have the expertise to use ePCT and would therefore still be required to engage the services of a local attorney

270. The Representative of the Asian Patent Attorneys Association (APAA) indicated that it had provided a paper to the International Bureau with some concerns and suggestions on the proposal. APAA welcomed the emphasis in paragraph 4 of the document to the instructing agent and local agent needing to be confident that the key information was in a “mutually satisfactory form” and the reference in paragraph 9 for “a proposed requirement to specify a national attorney”. APAA was ready to assist with the proposal by ensuring engagement with local attorneys at the earliest opportunity so that ePCT national phase entry could meet its aims without increasing the risks to applicants.

271. The Representative of the American Intellectual Property Law Association (AIPLA) referred to the specific national legal filing requirements that had been pointed out by the Delegation of the United States of America, which could have harsh consequences when these were not met by the applicant. Referring to paragraph 9 of the document, the Representative asked for clarification on whether it was a forced requirement to have a national attorney. If this were not the case, it was important that there was a clear individual that received an electronic handshake from the coordinating attorney to be given responsibility for causing the national phase entry. The Representative also reminded Member States of Article 27(7) which allowed the receiving Office and designated Office to apply national law in as far as it related to any requirement that an applicant be represented by an agent having the right to represent applicants before the Office.

272. The Secretariat, responding to the interventions, reassured the Working Group that there was no intention to have a system where one individual could enter the national phase in the rest of the world at the touch of a button. The system being considered was instead intended to facilitate collaboration and avoid some of the mundane work, such as retyping applicant information. An appointed local agent was always expected to be part of the national phase entry process of finalizing the submission and providing substantive input when needed. While an attorney could abuse the system by paying the fees and entering the national phase by inserting the local name and address of any individual with no qualifications to act before the relevant Office and not even known to the attorney, there would be no interest to do this as the attorney would never hear anything again about the application. Ultimately, the tool being proposed could be provided by any commercial organization, provided Offices were willing to provide suitable electronic interfaces for information to be readable. In terms of applicable national law, this would be that of the designated Office. The International Bureau could nevertheless host a server on behalf of the national Office, but all actions would be a matter for that Office, so something arriving at the server would be considered as received by that Office. In any case, the transfer of information from the International Bureau to national Office systems should ideally be close to instantaneous. The Secretariat therefore underlined the need for creativity in finding solutions to make the system work, rather than use certain issues as a reason to continue with repetitive manual tasks when options were available to avoid this.

273. The Representative of the American Intellectual Property Law Association (AIPLA) suggested that a better approach might be simply to give access to the international phase data and a set of standard interfaces at national Offices and leave the implementation to users' systems directly. The centralization of a system involved risks which had not been tested in litigation. In this area, the Representative considered that there was an ambiguity between Article 27 and Rule 51 *bis* which did not quite read consistently with each other because in Rule 51 *bis*.1(b), the designated Office may require that the applicant be represented by an agent and/or have an address in the designated State for the purpose of receiving notifications. An applicant claiming to have an address in that State which was not considered to meet the requirements of the Treaty could therefore lose his filing date.

274. The Chair summarized the interventions by noting that many of the areas which had been cited as having potential for bad practice were equally relevant to the paper world. However, the PCT system needed to face up to the reality of the digital era. It was important to take account of the issues, but using them to attempt to stop progress would simply mean that alternative mechanisms would appear and Offices and users would have lost their opportunity to help shape them. IP Australia had an ePCT server hosted by the International Bureau and this had not presented problems with national filing dates through time zone issues or loss or rights. The Chair therefore urged Member States to think about these issues to find solutions to enable ePCT to be effective. Furthermore, the Chair reassured patent attorneys that the authorization system in ePCT would be configured to ensure that local agents were not passed work that they had not accepted it. It was also acknowledged that the ability to pay centrally correctly relevant fees in all national jurisdictions was a major part of a national phase entry system.

275. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) asked about the timescale of the next steps in the project.

276. The Secretariat, in response to the question raised by the Representative of the Institute of Professional Representatives before the European Patent Office (EPI), informed the Working Group that the International Bureau would be putting together a first draft interface in demo environment which it planned would be deployed in ePCT in September or October this year. The International Bureau would be in contact with delegations and observer organizations interested in being involved in the pilot group, which would be invited to look at draft interfaces and provide their input.

277. The Working Group noted that the International Bureau intended to prepare a first draft interface in the Demo ePCT environment, likely in autumn 2015, which would help to inform more concrete discussions with potential pilot Offices and users. It further noted the intention of the International Bureau to invite participation by pilot Offices and users, by way of a PCT Circular, in the near future.

PCT MINIMUM DOCUMENTATION: DEFINITION AND EXTENT OF PATENT LITERATURE

278. Discussions were based on document PCT/WG/8/9.

279. The Secretariat introduced the document, which provided a status report on the work about to resume in the PCT minimum documentation task force. The aim of the project was to redefine the patent part of the PCT minimum documentation in a way that improved the availability of technical information, both in terms of the technical and linguistic coverage of patent documents and the ease of searching information contained in the documents. The current phase of work within the task force had two main parts, both aimed at ensuring that Offices had the necessary information available to them in order to progress to the next stage of making proposals to amend Rule 34 which were both realistic and effective in meeting the intended goals. These two parts involved considering potential formats to be used in documenting national collections effectively and assessing the technical formats and the means of distribution which were currently used for making national collections available to

International Searching Authorities, the International Bureau and database providers. This would allow the task force to work out which of these formats should be used for Offices wishing to have their collections included in the minimum documentation.

280. The Delegation of the European Patent Office welcomed the reactivation of the task force, as the documentation searched by International Searching Authorities was a fundamental pillar in quality and the existing version of the PCT minimum documentation to did not reflect the current digital world. It was also appreciated that the work to develop the "Authority File" format conducted under the IP5 auspices would be taken into account. The Delegation stated that it considered that the work needed to ensure the qualities of correctness, completeness and timeliness of patent data, as well as ensuring that the data was made available in a barrier-free manner. It was also important to consider utility models, which were now very numerous and important from a prior art point of view, and to consider the importance of having certain information available in English. Moreover, the mechanism for adding new collections to the PCT minimum documentation needed to be easy.

281. The Delegation of Japan welcomed the reactivation of the task force and expressed willingness to share its experiences under the activities of the IP5 Offices with sharing information on patent publications in electronic formats.

282. The Delegation of China believed that expanding that PCT minimum documentation would have a positive and far-reaching effect on improving quality of international search. The Delegation therefore supported the reactivation of the PCT minimum documentation task force to study a standard format for patent documents to become part of the PCT minimum documentation.

283. The Working Group noted the contents of document PCT/WG/8/9.

PCT SEQUENCE LISTING STANDARD

284. Discussions were based on document PCT/WG/8/13.

285. The Delegation of the European Patent Office, in its role as leader of the Task Force for the preparations of recommendations on the presentation of nucleotide and amino acid sequence listings based on eXtensible Markup Language (XML) for adoption as a WIPO standard, reported that the draft WIPO Standard ST.26 had been informally agreed at the fourth session of the Committee on WIPO Standards in May 2014, but that no decisions had been taken because the session had been adjourned without adoption of the agenda. The European Patent Office hoped that the agreement would be formalized soon. The Task Force was now performing a technical assessment of the transition from ST.25 to ST.26.

286. The Representative of the Japan Intellectual Property Association (JIPA) stated that, while the JIPA generally supported the move from WIPO Standard ST.25 to new Standard ST.26, which was in line with current technical trends, the Representative was concerned that this move might result in applicants making errors when filing sequence listings under the new Standard. It was thus important to give sufficient time for the transition by applicants from the old to the new Standard and to ensure that measures for relief were available in the event of errors.

287. The Working Group noted the contents of document PCT/WG/8/13.

REVISION OF WIPO STANDARD ST.14

288. Discussions were based on document PCT/WG/8/10.

289. The Secretariat introduced the document, which provided an update on the ongoing work of the Task Force to the Committee on WIPO Standards to revise WIPO Standard ST.14 concerning references cited in patent documents. There were two components of the task:

first, to prepare and present a proposal on revision of category codes provided in paragraph 14 of WIPO Standard ST.14, and second, to study the convenience of revised recommendations for identification of non-patent literature in ST.14 to bring the WIPO Standard closer in line with the International Standard ISO 690 2010, which contained guidelines for citing bibliographic references and citations to information resources. The second component also covered citing of documents in languages that were different from the search report in which they were cited. As agreed at informal consultation sessions during the fourth session of the Committee on WIPO Standards in May 2014, the Task Force had focused on the second component of the task dealing with the recommendations for citing non-patent literature. Paragraphs 6 and 7 of the document discussed this work, which included identifying provisions where ST.14 and the ISO Standard could be more closely aligned and preparing draft text to cover the citation of non-patent literature in a language other than English or the language of the search report.

290. The Delegation of the European Patent Office reiterated its position for maintaining category “X” and not introducing categories “N” and “I” in the citation category codes in paragraph 14 of WIPO Standard ST.14. The European Patent Office supported a closer alignment of ST.14 with International Standard ISO 690:2010, in line with the present considerations by the Task Force, rather than a full alignment.

291. The Working Group noted the contents of document PCT/WG/8/10.

COLOR DRAWINGS

292. Discussions were based on document PCT/WG/8/21.

293. The Secretariat introduced the document, which reported on the work towards allowing electronic filing and processing of PCT applications containing color drawings during the international phase. Unfortunately, the work had encountered problems in that the intended approach would have incurred significant additional costs for handling application files in PDF format. Consequently, the timetable suggested to implement the service would be delayed compared to what had been envisioned at the seventh session of the Working Group. The International Bureau remained committed to the concept of allowing the electronic filing and effective processing of color drawings in cases where this improved the quality of the disclosure, but this needed to be done without introducing significant ongoing costs to the International Bureau or International Authorities that would end up being passed onto the applicants. The International Bureau welcomed comments on the document, but also invited Offices that had systems in place to process color drawings in PDF format to contact the International Bureau informally to discuss the arrangements they had found to be effective.

294. The Delegation of Denmark stated that the Danish Patent and Trademark Office had been able to process color drawings in patent applications for some time, and that it would be willing to share experiences in this area with the International Bureau.

295. The Delegation of the European Patent Office informed the Working Group that it did not have the systems to support the end-to-end processing of color drawings in patent applications, but was eager to discuss standards in this area, especially with Offices that had implemented processing of applications in color. The European Patent Office was in the process of revamping its IT systems, after which the systems would be able to handle color drawings.

296. The Delegation of Japan supported the proposal to continue to discuss the issue of color drawings separately with IP Offices, since the formats for color drawings and IT systems that needed to be developed at each Office were different. The Japan Patent Office needed further time to develop systems to accept color drawings as a receiving Office, International Searching and Preliminary Examining Authority or designated Office and it would continue to share information with the International Bureau in this area.

297. The Delegation of the United States of America stated that it would be willing to assist the International Bureau in the technical work to be able to process color drawings and pointed out that the United States Patent and Trademark Office had encountered various technical issues in processing color while implementing the Hague Agreement on the International Registration of Industrial Designs.

298. The Delegation of New Zealand informed the Working Group that the Intellectual Property Office of New Zealand accepted specifications with color drawings and would be pleased to share its experiences with the International Bureau or other interested Offices.

299. The Delegation of Egypt stated that the Egyptian Patent Office would need to update its IT systems to receive color drawings. However, it was important that black and white drawings could continue to be received.

300. The Delegation of Israel informed the Working Group that the Israel Patent Office had IT systems in place to be able to accept and handle color drawings in international applications filed electronically and had recently changed its legal framework and technical systems to permit the filing of color drawings.

301. The Delegation of China raised two practical questions about the implementation of color drawings in the international phase. First, if the applicant filed color drawings in the international phase but the designated Office required black and white drawings when the application entered into the national phase, who had the responsibility to file back and white drawings, the applicant or the International Bureau (the latter having converted the color drawings into black and white)? Second, if the applicant filed color drawings in the international phase, would the black and white version no longer be included in the international publication? In such a situation, would the two sets of drawings have equal legal effect and which set would prevail if there were differences in the disclosure of information?

302. The Representative of the Asian Patent Attorneys Association (APAA) underlined the importance of color drawings in some fields of technology and was pleased with the progress in this area. However, the PCT Regulations stipulated the use of black and white drawings, so until the Rule was changed, applicants could not submit color drawings in some designated States. The Representative therefore hoped that the Regulations were amended so all PCT Member States could accept color drawings.

303. The Representative of the International Federation of Industrial Property Attorneys (FICPI) supported the efforts to allow processing of applications with color drawings, which could provide a better understanding of the invention. Software systems of applicants supported different data formats so this might not pose a problem for applicants. The Representative also noted that present practices of using three-dimensional shaded drawings could introduce additional costs to applicants when these were not accepted by Offices.

304. The Representative of the Japan Patent Attorneys Association (JPAA) welcomed the proposal to enable processing of color drawings since color drawings promoted clear cut disclosure of inventions and made a contribution to effective examination and/or public use of inventions. In order not to lead to confusion, the JPAA requested operational tests to be performed before implementation of the proposal. The JPAA also suggested that it might be appropriate to begin accepting color drawings in international applications filed in XML format even before the problems were resolved for those filed in PDF format.

305. The Representative of the American Intellectual Property Law Association (AIPLA) informed the Working Group that any PDF document was accepted on filing at the United States Patent and Trademark Office as a receiving Office, but the applicant could have a problem in the international stage where a color drawing would have to be reproduced in black and white or greyscale.

306. The Secretariat, responding to the interventions made by delegations, explained that it would be highly unlikely that Rule 11.13 could be amended in the near future to require all designated Offices to accept color drawings in the national phase, given the need to amend national laws in many Member States. Referring to the first question raised by the Delegation of China, if the applicant filed a color drawing and the designated Office required black and white, it would ultimately be the applicant's responsibility to provide the correct drawing. There was scope within this project to work on mechanisms for making this as simple as possible, and the International Bureau was looking for feedback before making technical proposals in this area. But the intention would be to conduct the entire international phase in color and provide a system for automatic conversion to black and white which applicants could use if they found it adequate. However, the applicant would have the responsibility to convert the color drawing into black and white without adding subject matter, and therefore care needed to be taken when filing color drawings in the first place. As for the second question about the effect of filing a color drawing, the international publication would be in color with a black and white version being made available on PATENTSCOPE for designated Offices to use if necessary. The International Bureau would look into the legal framework in situations of having a set of color and black and white drawings when it had prepared details of a technical proposal, which could be submitted to a future session of the Working Group.

307. The Working Group noted the contents of document PCT/WG/8/21.

CLARIFYING THE PROCEDURE REGARDING INCORPORATION BY REFERENCE OF MISSING PARTS

308. Discussions were based on document PCT/WG/8/4.

309. The Secretariat informed the Working Group that it had continued discussions on the incorporation by reference of missing parts, both informally with the European Patent Office and the United States Patent and Trademark Office, and at the Meeting of International Authorities at its twenty-second session in Tokyo in February 2015. The document summarized the results of these discussions. At present, there were different interpretations by receiving Offices and designated/elected Offices of the provisions of Rules 4.18, 20.5 and 20.6, which resulted in different practices when the application on the filing date contained a set of claims or a complete description but those description or claim elements had been erroneously filed by the applicant and the applicant then requested incorporation by reference of all the claims and/or all the description contained in the priority document as a missing part. Some Offices took the view that this practice should not be allowed, since the provisions concerned missing parts of the claims or the description elements. This implied that other parts of the element had indeed been filed, so replacement of a complete element should therefore not be permitted. However, other Offices considered this practice to be permissible, otherwise it would result in the applicant who did not include any claims or any description in the application as filed to be able to include those elements by incorporation by reference, whereas an applicant who had erroneously filed the wrong set of claims and/or description would not be allowed to correct the mistake. The applicant in the latter situation would therefore be penalized for attempting to file a complete application, albeit with the wrong claims or description.

310. The Secretariat continued by updating the Working Group on discussions at the Meeting of International Authorities in February 2015, where the International Bureau had prepared a discussion paper (document PCT/MIA/22/14 Rev.), and the European Patent Office had submitted comments (document PCT/MIA/22/14 Add.). The paper from the International Bureau had proposed two options on possible ways forward, listed in paragraph 8 of the document. Option A would be to leave the situation "as is" and leave the fate of requests for incorporation by reference to the divergent practices of receiving Offices. This would result in a trap for applicants if incorporation by reference were accepted by the receiving Office and the applicant discovered at a later stage that a designated Office did not recognize the incorporation. Option B would involve an amendment of the PCT Regulations to require all receiving Offices, for the purpose of the international phase, to permit incorporation by

reference. This would provide the applicant with a path or bridge to reach the national phase if there were a remedy available under the national law of the designated Office. The discussions at the Meeting of International Authorities reported in paragraph 13 of the document showed that, while there was support from many of the Authorities for option B to amend the PCT Regulations for the purpose of international phase only, there was strong opposition by at least one Authority for the reason set out in paragraph 89 of the Summary by the Chair of the session (document PCT/MIA/22/22, reproduced in the Annex to document PCT/WG/8/2). Given this continued divergence of views, the International Bureau believed that, unless the particular concerns by that Authority had been overcome, continuing efforts to find a solution would appear to be disproportionate to the number of cases actually affected. Consequently, the document recommended that no further action be taken at this stage to attempt to align the divergent practices which existed in this area, and the International Bureau should work with Member States to modify the Receiving Office Guidelines to clarify these divergent practices and the consequences on the fate of applications in the national phase.

311. The Delegation of the United States of America stated that it continued to hold the strong view that, where the international application contained an (erroneously filed) set of claims and/or an (erroneously filed) description but the applicant nevertheless requested the incorporation by reference of all of the claims and/or all of the description contained in the priority application as a "missing part", such incorporation by reference was clearly covered not only by the spirit and intent but also by the wording of the current Regulations. It could not support the compromise solution set out as Option B in the document, as that solution was inequitable, offering nothing to applicants from Member States whose Offices already today allowed such incorporation by reference both in their capacity as receiving Offices and designated Offices. The solution would only benefit applicants from those Member States whose Offices did not do so. It urged user groups from Member States whose Offices did not allow for the incorporation in the situation at hand to "lobby" those Offices with a view to changing their position. It further suggested that the International Bureau should publish a list indicating the practice of Offices of all PCT Contracting States with regard to incorporation by reference in the current situation. The Delegation further stated that, in addition to Options A and B, there were at least two more options which should be considered. First, Rule 4.18 could be amended to specifically allow for the incorporation by reference, in the situation at hand, of all of the claims and/or all of the description contained in the priority application as a "missing part". Second, an entirely new provision could be added to the Regulations to deal with the situation at hand.

312. The Delegation of the European Patent Office recalled the original purpose of the missing parts provisions as included in the PCT Regulations, which had been to align the PCT with the provisions of the Patent Law Treaty (PLT). The provisions had been designed to provide a safety net for applicants and thus, being provisions designed to deal with exceptional situations, had to be interpreted in a strict manner. In its view, there were no provisions, either in the PLT or in the PCT, which dealt with the issue of whether or not to allow the applicant to incorporate all of the claims and/or all of the description contained in the priority application as a "missing part" where the international application as filed already contained an (erroneously filed) set of claims and/or an (erroneously filed) description. It could accept the compromise solution set out as Option B in the document but recognized that this would not appear acceptable to others. It thus suggested to focus on modifying the Receiving Office Guidelines to clarify the continued divergent practices of Offices and to raise awareness among the applicant community.

313. The Chair noted that it would appear strange to him that the Regulations allowed the applicant to validly file certain documents in *force majeure* circumstances after a time limit had expired without filing anything at all within the relevant time limit, but that they did not allow the applicant to correct the mistake of having filed a wrong set of claims and/or a wrong description. Electronic mechanisms to file patent applications did not generally permit a filing without all mandatory requirements. Therefore, with an increasing number of electronically-filed applications, there could be very few instances of missing parts. However, there would still be

rare cases where applicants would attach the wrong document in error. If it were not possible to address that situation by way of incorporation by reference of a "missing part", then perhaps, along the lines of the suggestion made by the Delegation of the United States of America, an attempt should be made to explore whether it would be possible to draft an entirely new provision which would allow the applicant, in very limited and exceptional cases, to replace the wrongly filed claims and/or description of the international application as filed with the equivalent "correct" version of the claims and/or description contained in the priority application.

314. The Delegation of China stated that it considered that Option A could lead to confusion among applicants about the different practices of receiving Offices, since they would not be able to predict the fate of request for incorporation by reference. As for option B, incorporation by reference of a complete set of claims and/or description for the purposes of the international phase only would affect the scope of the original disclosure. The procedure for international search should therefore be taking into account the possibility of charging additional fees and the failure to meet the time limit for producing the international search report. This option could bring a new risk into the system, noting that national laws might refuse the request for incorporation. The Delegation therefore understood that incorporation by reference of complete claims and/or description elements should not be permitted and the PCT Regulations should be amended to clarify this issue and avoid confusion by applicants and Offices.

315. The Delegation of Israel expressed support for option B to allow incorporation by reference of the entire description and/or entire claims for the purposes of the international phase only, thereby ensuring that international search was carried out by taking into account the matter requested to be incorporated by reference.

316. The Delegation of the United Kingdom supported option B as the best compromise solution, given the diverging opinions among Offices. The Delegation also stated that it would be in favor of a new provision as proposed by the Delegation of the United States of America to clarify that incorporation by reference to replace a complete set of wrongly-filed claims and/or description could be permitted.

317. The Delegation of Mexico supported option B, but added that there could be a specific indication that there should be a clear error for this incorporation to be considered.

318. The Delegation of the Russian Federation expressed support for option B and believed this option to be more universal and fair to applicants. The Delegation also raised two points in relation to the proposed modification to Rule 4.18 suggested by the Delegation of the United States of America. First, it would be difficult to implement since it would require many States and Offices to change their national practices. Second, the Delegation questioned the competence of the Working Group to modify Rule 4.18, as by aligning national laws it could encroach on sovereign rights.

319. The Delegation of Portugal supported option B, but Rule 4.18 could be revised in the future. By contrast, option A would maintain diverted practices amongst receiving Offices, which was not the goal of the PCT.

320. The Delegation of Colombia supported option B as this best responded to the possibility of an applicant forgetting a part of the application or erroneously filing information which did not correspond to the priority application and would allow the correct application to be searched in the international phase. On the other hand, the divergences of practices of receiving Offices in option A caused too much uncertainty.

321. The Delegation of Canada stated that, given the lack of consensus on the procedure regarding this incorporation by reference of missing parts, the Canadian Intellectual Property Office supported the recommendations of the International Bureau that no further action be taken at this stage to align the divergent practices of Offices, and that efforts should be made to

clarify the Receiving Office Guidelines to increase applicant awareness of divergent practices. The Delegation also pointed out its previous position of amending Rule 20 to allow for a full specification to be replaced for erroneous filings with a provision to cover incompatibilities with national laws.

322. The Delegation of France believed that the lack of consensus on this point would make it wiser to opt for the compromise solution proposed by the International Bureau as option A and better inform applicants of the existing different practices in this area.

323. The Delegation of Egypt supported amended the Regulations with a new provision to allow missing parts to be submitted, adding that the Egyptian Patent Office gave one month for the applicant to submit a missing part.

324. The Delegation of Japan supported the proposal from the International Bureau to modify the Receiving Office Guidelines to clarify the current practices at receiving Offices, which it believed was a realistic approach considering the divergent views on this issue.

325. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) stated that its members supported the incorporation by reference to allow replacement of an erroneously-filed description and/or set of claims and believed there were two strong arguments in favor of this practice. First, a narrow interpretation of the incorporation by reference provision favored an applicant who filed an incomplete application compared to an applicant who erroneously filed the wrong claims and/or description. Second, third parties would not be harmed, as an international application was not published at the time that the applicant requested the incorporation by reference. The Representative further suggested the Working Group might also consider amending Rule 4.18 with a view to allowing the incorporation by reference of missing elements or parts also in the situation where a priority claim was not contained in the international application as filed but was later added or corrected under Rule 26*bis*.

326. The Representative of the American Intellectual Property Law Association (AIPLA) agreed with the position expressed by the Delegation of the United States of America. In a fast-moving world, it was important to be able to remedy errors that might be made, especially for smaller enterprises, individual inventors and applicants from developing countries, which would all be likely to have fewer resources and less time to eliminate all errors in an application. By contrast, the current divergence of practices was not helpful. However, if the Regulations were not modified to allow incorporation by reference to replace a complete set of claims and/or description, it was preferable to maintain the current practice as in option A rather than the middle-ground alternative as outlined in option B.

327. The Representative of the Asociación de Agentes Españoles Autorizados ante Organizaciones Internacionales de la Propiedad Industrial (AGESORPI) agreed that in the future, the most common error would not be a missing part but an erroneously filed part, due to mix-ups when preparing an application. The Representative therefore agreed that it would be desirable to correct an erroneously filed part, but emphasized that this needed not only to be in strictly limited circumstances but also to be done a very early stage in processing to avoid uncertainty for third parties.

328. The Chair summarized the discussion by acknowledging the divergent views expressed by the Working Group on incorporation by reference of missing parts. Several delegations expressed their preference for Option A as set out in document PCT/WG/8/4 (to leave the situation "as is" but modify the Receiving Office Guidelines to clarify the continued divergent practices of Offices and raise awareness among the applicant community), whereas several other delegations expressed a preference for Option B (require receiving Offices to permit incorporation for the purposes of the international phase). There was therefore no consensus to move forward, but it was clear that most Member States would value the International Bureau

clarifying the Receiving Office Guidelines as best as possible and to set out the issues that were involved in this particular matter at this point in time. Where it was potentially possible to incorporate missing or erroneously-filed parts, this needed to be done before subsequent steps of international search and preliminary examination were undertaken. There was some support for the International Bureau to prepare, for discussion at the next session of the Working Group, a draft of a new provision which would allow the applicant, in very limited and exceptional circumstances, to replace the wrongly filed claims and/or description of the international application as filed with the "correct" version of the claims and/or description contained in the priority document.

329. The Working Group requested the International Bureau to prepare, for discussion at its next session, a working document containing a draft of a new provision which would allow the applicant, in very limited and exceptional cases, to replace the wrongly filed claims and/or description of the international application as filed with the equivalent "correct" version of the claims and/or description contained in the priority application.

330. The Working Group further requested the International Bureau, pending the ongoing discussions of the issues at hand in the Working Group, to prepare and consult on modifications to the Receiving Office Guidelines aimed at clarifying the continued divergent practices of Offices, and to continue to raise awareness among the applicant community on the consequences of the continued divergent practices of Offices.

SAME DAY PRIORITY CLAIMS

331. Discussions were based on document PCT/WG/8/5.

332. The Secretariat introduced the document by explaining that, in the context of discussions on incorporation by reference of missing parts, the question had arisen on whether a priority claim based on an earlier application with the same filing date as the international application was a valid claim under the Paris Convention and thus the PCT. In order to incorporate a missing part, it was necessary to have valid priority claim. As a consequence, where applicants filed an international application and claimed the priority of an application filed on the same day as the PCT application, some Offices interpreted the Paris Convention in such a way that such same day priority claims were allowed. In these receiving Offices, same day priority claims may have served as the basis for any requests for incorporation by reference, but this interpretation would not be binding on the designated Offices. Any designated Office could therefore cancel the same day priority claim and the incorporation by reference of the missing part. On the other hand, at Offices not accepting same day priority claims, any same day priority claims would be cancelled and the document could therefore not serve as a basis for incorporation by reference of a missing part. Applicants proceeding with an international application where the receiving Office had not accepted a request for incorporation from an earlier document with the same filing date as the international application would therefore have to enter the national phase early before any designated Office accepting same day priority claims to request restoration of the priority claim and continue on the basis of the restoration. Although the differences of practice created a complicated situation, the number of same day priority claims was relatively small (just over 200 in 2013), with the largest number coming from the receiving Offices of the Republic of Korea, the United States of America and China. Among these requests, only two cases were the subject of a request for incorporation by reference. The Secretariat also referred to the discussions on same day priority claims by the PCT Assembly in 1991 (document PCT/A/XVIII/4); however, at that time, the Assembly had not decided on the question, due to lack of time.

333. The Secretariat continued by referring to possible options for the Working Group with regard to same day priority claims. The first option would be to refer the matter to the Paris Union Assembly, as this was an issue of how the Paris Convention should be interpreted. However, in view of the divergent views expressed in the context of the PCT, chances of achieving agreement on how to interpret the Paris Convention would appear slim. Should the

issue be referred to the Paris Union Assembly, it could either adopt a common Understanding or formally amend Article 4 of the Paris Convention through a Revision Conference. The latter option would, however, involve a cumbersome and lengthy ratification procedure, which could be considered disproportionate to the size of the problem, noting that only a few cases were affected by the issue. The second option would be for the PCT Union Assembly to decide on the matter. However, this raised questions as to whether this body would be competent to decide on the matter, and if any decision were taken, whether this would be binding on designated Offices or only have effect in the international phase. The third option would be to amend the PCT Regulations with regard to the international phase, so as to request all receiving Offices not to cancel any same day priority claims with a view to building a bridge for the applicants to pursue the matter further in the national phase. The final decision on accepting same day priority claims would then be a matter for the national laws in the designated States. Finally, the fourth option would be to do nothing and leave the fate of same day priority claims, as far as the international phase is concerned, to the national law of the receiving Offices, and as far as the national phase is concerned, to the national law of the designated Offices.

334. The Delegation of the United Kingdom informed the Working Group that the United Kingdom Intellectual Property Office did not accept same day priority claims as these would not be in line with the Paris Convention or the PCT. Any decisions on same day priority claims should be referred to the Paris Union Assembly, but pending such referral, the practice in the PCT should stick to the status quo. Therefore, the Delegation considered either Option 1 or Option 4 to be acceptable.

335. The Delegation of the European Patent Office stated that the European Patent Office took a literal interpretation of Article 4(C)(4) of the Paris Convention, according to which the day of filing was not be included in the priority period, so same day priority claims were not allowed. In view of the diverging practices and low numbers of applications affected by the provisions, the European Patent Office supported Option 4 to amend the Receiving Office Guidelines to clarify different practices and raise awareness among applicants.

336. The Delegation of Canada believed that the issue should be brought to the Paris Union Assembly in line with Option 1 as soon as possible for a final determination on the matter. In the interim, it could support Option 3 for the benefit of consistency of applicants in the international phase.

337. The Delegation of the United States of America stated that the United States Patent and Trademark Office did not object to same day priority claims in the international phase, primarily due to the introduction in the Regulations of the restoration of priority provisions in 2007. In that context, the express requirement that an earlier application, the priority of which was claimed in the international application, had to be filed "prior to the international filing date" had been deleted. Given the extremely small number of applications in which same day priority claims had a substantive consequence with regard to incorporation by reference, and the equally small chance that either the Paris Union Assembly or the PCT Union Assembly could reach agreement on the matter, neither Options 1 nor 2 were desirable to the United States Patent and Trademark Office. With regard to Options 3 and 4, Option 3 would be preferable. However, it was not clear to the United States Patent and Trademark Office that Option 3 was necessary in view of the changes to the restoration of priority provisions in 2007. The United States Patent and Trademark Office was therefore interested in the basis used by other Offices to declare same day priority claims to be void.

338. The Delegation of Israel supported the invention made by the Delegation of Canada in support of Option 3 as a first step.

339. The Delegation of France stated that Options 2 and 3 did not seem appropriate. Option 1 was the most logical, but there would be a lengthy timeframe for implementation. Therefore, Option 4 was the most realistic with a clarification on different practices being made in the Receiving Office Guidelines.
340. The Delegation of Colombia expressed support for Option 3, and also agreed with the Delegation of Canada that it could be appropriate to refer to the issue to the Paris Union Assembly.
341. The Delegation of Germany stated that it believed Option 3 to be the most realistic and practical option.
342. The Delegation of Egypt supported Option 4 to leave it to designated Offices to decide on whether to accept same day priority claims in the national phase according to their respective national laws.
343. The Delegation of Spain noted that, as the problem had not been resolved in the PCT Union for the past 20 years, it supported referring the issue to the Paris Union Assembly in accordance with Option 1, but could accept a compromise solution.
344. The Delegation of China referred to the purpose of priority to provide a condition for applicants to file applications abroad within a specified time limit. From this perspective, claiming priority from an application filed on the same day was not necessary. In addition, the divergent practices and interpretation of this issue in different Member States would cause uncertainty with legal consequences for applications, which would damage the interests of applicants. Therefore, the Delegation hoped the Paris Union Assembly could give a clear and unique interpretation to this matter so as to harmonize the practice of all Member States in the interests of applicants and therefore supported Option 1.
345. The Delegation of the Russian Federation stated that it had never encountered a situation where one application had claimed priority from an application filed earlier in the same day, but acknowledged it could exist in theory. Among the options presented in the document, Option 3 was fair for Offices to deal with the situations of divergent national laws.
346. The Delegation of Austria supported Option 3, in line with the Delegation of Canada. Like the Delegation of the Russian Federation, the Delegation had never experienced any problems with applications due to claiming priority from an application with the same filing date.
347. The Delegation of Portugal stated that Option 1 would be best option in the long term, but Option 3 could be a sensible solution in the interim.
348. The Representative of the American Intellectual Property Law Association (AIPLA) stated that AIPLA would favor Option 3 under the existing circumstances. A practical way to deal with the issue at hand might be to not only apply a date stamp but also a time stamp to an application so as to record the actual time at which an application was received by an Office, allowing the identification of an “earlier” application where several applications had been received on the same day. This information could be added in the “other” box in Box IX of the Request Form PCT/RO/101.
349. The Delegation of Ecuador asked the Secretariat whether the Office of the Legal Counsel had been consulted on the competent body for deciding same day priority claims, and suggested that Legal Counsel could provide some input to help delegations find solutions to the questions to the issue.

350. The Secretariat, in response to the question from the Delegation of Ecuador, confirmed that the Office of the Legal Counsel had been consulted on the issue of same day priority claims, but that it was up to the Member States of the Paris Union to agree on how to interpret the provisions of the Paris Convention.

351. The Chair acknowledged that Option 3 to amend the Regulations to allow same day priority claims for the purposes of the international phase and for designated Offices to deal with this issue under their respective national laws was the most supported option. Option 1 was also supported by many delegations, but given the small number of applications which involved same day priority claims, the issue might not be considered to be of sufficient importance to justify referral to the Paris Union Assembly at this stage.

352. While noting the divergence of views, the Working Group requested the International Bureau to prepare, for discussion at its next session, a proposal for amendment of the PCT Regulations to expressly require receiving Offices not to cancel same day priority claims so as to prepare the ground for decisions on the matter to be taken by designated Offices in the national phase under the applicable national laws.

OMISSION OF CERTAIN INFORMATION FROM PUBLIC ACCESS

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

354. The Secretariat explained that the proposal to provide the International Bureau with a basis in the Regulations to omit certain sensitive information from public access had been discussed at the seventh session of the Working Group (document PCT/WG/8/12). While there had been general support to the proposal, it had been suggested that the criteria specifying which information could be excluded from publication and public access were too broad (see paragraphs 408 to 418 of the report of the session, document PCT/WG/7/30). The document for the present session therefore provided a narrower and more defined set of criteria. In addition, based on feedback from some delegations during the present session, the Secretariat had revised the proposal from that in the Annex to the document. In Rules 48.2(l) and 94.1(e), the word “reasoned” had been added, relating to the request from the applicant for omission of information, and the first criterion had been amended from stating that the information was “obviously irrelevant to the disclosure of the invention” to stating that the information did “not obviously serve the purpose of informing the public about the international application”. In the second criterion, the word “clearly” had been added concerning prejudicing the personal or economic interests of any person. Finally, in Rules 48.2(n) and 94(f), a reference had been added to the International Preliminary Examining Authority.

355. The Delegation of Germany supported the revised proposal, which took into account its previous concerns relating to the protection of private data.

356. The Delegation of Canada supported the proposed changes to Rules 9.2, 48.2, 94.1 and 94.2, but pointed out that Rules 94.2*bis* and 94.3 appeared more restrictive regarding access to the international application than that provided for in Article 30(2)(a), which did not prohibit national Offices from providing access to the international application by third parties as of the date of receipt of the communication of the international application under Article 20 or the date of receipt of a copy of the international application under Article 22. As these events could take place before international publication, the Delegation proposed that these Rules could make direct reference to Article 30(2)(a).

357. The Delegation of Japan expressed concern about the additional burden on receiving Offices and International Searching Authorities to provide access on request of documents contained in its file. In addition, in view of the availability of information on PATENTSCOPE relating to an application after international publication, the Delegation questioned the necessity of the proposed addition of new Rules 94.1*bis* and 94.1*ter*. As for the proposed amendment to Rule 9.2, the Delegation referred to the comments it had made at the seventh session of the

Working Group that it was the role of the competent receiving Office to request corrections from the applicant. Applicants could make corrections by complying with the present Rule 9.2 and the receiving Office would transmit a corrected record copy and search copy to the International Bureau and International Searching Authority, respectively. An amendment to Rule 9.2 could result in duplicate or redundant records.

358. The Delegation of Sweden expressed concern that the final sentences in proposed Rules 94.2(b) and 94.2*bis* relating to the furnishing of copies of documents being subject to reimbursement of the cost of the service were a matter for national legislation.

359. The Delegation of Australia informed the Working Group that its national laws had for some time contained the possibility of removing certain sensitive information from the public file inspection and therefore supported the principles underpinning the omission of information from public access. With regard to proposed Rules 48.2(l) and 94.1(e), the Delegation requested clarification on the scope of the term "economic interests". While this was tempered with the "prevailing public interest", it asked for guidelines to be provided on what should be omitted from publication under these provisions. Furthermore, in order to comply with the proposed Rules which prohibited disclosure by receiving Offices and International Authorities of information omitted from public access by the International Bureau in accordance with Rules 94.1(d) and (e), it was necessary for Australia to amend national legislation.

360. The Delegation of the United States of America stated that it continued to support the proposals to amend Rule 9.2 as well as the proposed amendments to Rule 94 to clarify that the receiving Office, International Searching Authority and International Preliminary Examining Authority may provide access to an application file. At the seventh session of the Working Group, the Delegation had also agreed in principle to the proposed changes to Rule 48, but had significant concerns with regard to the breadth of the proposal. The proposed modifications to Rule 48 presented to the Working Group at this session had been made to address these concerns, specifically the inclusion of the language that the omitted information had to be obviously irrelevant to the disclosure, as well as the requirement that there be no prevailing public interest to have access to that information. As both of those changes were intended to ensure that subject matter relevant to the disclosure and patentability of the invention would not be omitted, the Delegation supported these changes. The Delegation also agreed with the statements of the Delegation of Australia with regard to better defining what constituted economic and personal interests. Finally, the Delegation reiterated its request made at the seventh session for amendments to be made to the Guidelines or Administrative Instructions, as appropriate, to include a discussion of what types of material would be proper for treatment under Rule 48 if the proposal were to be adopted.

361. The Delegation of Israel supported the proposed scope of the changes to the Regulations to allow protection of private information of the applicant in certain cases and joined with the request made by the Delegation of the United States of America for Administrative Instructions or other Guidelines to indicate the type of information that could be treated under the provision.

362. The Delegation of the European Patent Office agreed that it would be useful to protect the rights of applicants in cases where sensitive information had been disclosed that was irrelevant to the application. As this was an exception to the Rule, the scope needed to be restricted, as foreseen in Rules 48.2(l) and 94.1(e). The Delegation also supported the request for guidance on the scope of these restrictions.

363. The Delegation of China agreed with the proposed amendments to the Regulations, which it believed would benefit the interest of applicants and rights holders.

364. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) asked whether it would be possible for designated Offices to receive information on a confidential basis when information supplied by the applicant to the receiving

Office with a request for restoration of priority under Rule 26*bis*.3 had been withheld from public access, and pointed out that the documents seen by the receiving Office and designated Office when considering a request for restoration of right of priority on an application needed to be the same.

365. The Secretariat, in response to the question from the Representative of the Institute of Professional Representatives before the European Patent Office (EPI), explained that if an applicant submitted a request for restoration of right of priority with additional documents which might be considered sensitive, the applicant may have an interest in not having these documents publicly available. However, after entry to the national phase, a designated Office wishing to review the decision on restoration of right of priority could ask for any supporting documents from the applicant that had not been made publicly available under the provisions in Rule 49*ter* that allowed the designated Office to ask for further supporting evidence when reviewing a request for restoration of right of priority.

366. The Representative of the American Intellectual Property Law Associations (AIPLA) supported the comments made by the Delegations of Germany and the European Patent Office in support of the proposal. With respect to the question raised by the Representative of the Institute of Professional Representatives before the European Patent Office (EPI), the Representative suggested that applicants seeking restoration of right of priority could retain an authenticated copy of any documents submitted to the receiving Office for providing to a designated Office at a later stage to prove the documents were identical.

367. Following informal discussions, the Secretariat presented a revised draft of the proposal. In relation to the concerns raised by the Delegation of Sweden about proposed Rules 94.2(b) and 94.2*bis* relating to the furnishing of copies of documents being subject to reimbursement of the cost of the service, the Secretariat informed the Working Group that identical wording was already present in Rule 94.3 and the Delegation of Sweden therefore no longer held these concerns. In relation to the inconsistencies with Article 30(2)(a) raised by the Delegation of Canada, the Secretariat proposed that, in Rules 94.2*bis* and 94.3, the wording “but not before the international publication of the international application” should be replaced with “but not before the earliest of the dates specified in Article 30(2)(a)”. The wording “contained in its file” had also been added in Rule 94.2*bis* in relation to allowing access to documents in line with the formulation used in other Rules. The Secretariat had been informed by the Delegation of Japan that it could accept the amendments proposed to Rule 9.2. However, with regard to the concerns raised by the Delegation of Japan on the additional burden on receiving Offices and International Searching Authorities to provide access on request by the applicant to documents contained in its file, the wording “shall” in Rules 94.1*bis*(a) and 94.1*ter*(a) had been replaced by “may”. Offices could therefore decide on whether they wished to give access to documents at the request of the applicant. The International Bureau nevertheless hoped that most Offices would give the applicant access to documents on the file of the application, whether as a receiving Office or International Searching Authority, and that applicants under the PCT would not be treated in a less favorable manner compared to an applicant requesting access to the file of one of its national applications.

368. The Delegation of Canada stated that it supported the revised proposal.

369. The Working Group approved the proposed amendments to Rules 9, 48.2 and 94 of the Regulations as set out in Annex III with a view to their submission to the Assembly for consideration at its next session in October 2015, subject to possible further drafting changes to be made by the Secretariat.

TRANSMITTAL TO THE INTERNATIONAL BUREAU OF COPIES OF DOCUMENTS RECEIVED IN THE CONTEXT OF A REQUEST FOR RESTORATION OF RIGHT OF PRIORITY

370. Discussions were based on document PCT/WG/8/14.

371. The Secretariat explained that the document proposed to amend Rule 26*bis*.3 to require receiving Offices that had considered a request for restoration of the right of priority to submit all the documents received from the applicant to the International Bureau, unless the receiving Office decided not to forward these documents because they contained sensitive information. The standard used to define the sensitive information was similar to the one used in document PCT/WG/8/12 for the omission of certain information. The International Bureau would publish any documents received from the receiving Office, which would enable any designated Office to undertake a review under Rule 49*ter*.1 of the decision taken by the receiving Office. A similar proposal had been discussed at the seventh session of the Working Group. This proposal had been supported in principle but concerns had been expressed about requiring receiving Offices to submit sensitive information to the International Bureau. The proposal in the Annex to the document had taken these concerns into account by including an exception to transmitting sensitive information in the proposed changes to Rule 26*bis*.3. In addition, based on feedback from some delegations during the present session, the Secretariat had amended Rule 26*bis*.3(h)(iv), which now made reference to a new subparagraph (h-*bis*), with details of the situations where a receiving Office, either upon a reasoned request from the applicant or on its own decision, was not required to transmit documents to the International Bureau. The situations in this subparagraph were that the document or part did not obviously serve the purpose of informing the public about the international application, that publication or public access to any such document or part would clearly prejudice the personal or economic interests of any person, and that there was no prevailing public interest to have access to that document or part.

372. The Delegation of the Republic of Korea thanked the International Bureau for resolving the problems with regard to making sensitive information publicly available without the consent of the applicant. Although the Korean Intellectual Property Office maintained its notification of incompatibility with regard to restoration of the right of priority, it had been reviewing the possibility of revising its national laws to remove the incompatibility. The Delegation stressed the importance of information being disclosed to the designated Offices to review decisions taken by receiving Offices, and if this issue was solved, it could support the proposal.

373. The Delegation of Japan supported the proposal, as it had resolved the problems concerning the transmittal by the receiving Office of sensitive information, and requested the International Bureau to modify the Receiving Office Guidelines with a view to providing guidance on what types of information the receiving Office should withhold from transmission to the International Bureau on the basis of proposed rule 26*bis*.3(h-*bis*). The Delegation also asked how the receiving Office would notify the International Bureau of the fact that the receiving Office had excluded sensitive information from transmission to the International Bureau.

374. The Delegation of the European Patent Office expressed full support for the proposals and, like the Delegation of Japan, asked for clarification on how the receiving Office would notify the International Bureau when it had decided not to transmit a document or part of document containing sensitive information.

375. The Delegation of the United States of America supported the proposed changes and echoed the concerns raised by the Delegation of Japan on the specific types of information that could be withheld by the receiving Office. The Delegation also agreed with the Delegation of Japan that it was necessary to provide clarification on this matter in the Receiving Office Guidelines, emphasizing that the type of information to be withheld should be specific personal information such as bank account, personal identity and credit card numbers. Without any definition of the information in the Receiving Office Guidelines, the wording could allow a receiving Office to withhold general economic information that would be necessary for the designated Offices to understand the reasoning behind a decision taken by the receiving Office on restoration of right of priority.

376. The Delegation of Israel expressed support for the proposal and informed the Working Group that the practice of the Israel Patent Office acting as a receiving Office was to submit the entire file including the statement of reasons as well as any declarations and/or any other evidence to the International Bureau in order to enable the designated Offices to perform the limited review of the decision by the receiving Office. The Israel Patent Office applied the due care standard to requests for the restoration of right of priority. The Delegation therefore supported the proposal to allow the receiving Office to retain right not to furnish any personal sensitive information to the International Bureau, and also believed it would be useful to define such information in the Administrative Instructions or Receiving Office Guidelines.

377. The Delegation of Denmark agreed with the remarks made by other delegations, especially with regard to the standard to be applied when determining whether any particular document or information should be omitted from transmission to the International Bureau. It was therefore important for receiving Offices to be consulted through PCT Circulars to have a clear understanding of the information to be omitted, as envisaged in paragraph 10 of the document.

378. The Delegation of Chile supported the proposal with regard to the criteria to be applied before making a decision to withhold information from transmission to the International Bureau.

379. The Delegation of Canada agreed with the proposed amendments to the Regulations and introducing further details in the Receiving Office Guidelines. In particular, the Delegation pointed to a possible need to amend paragraphs 166(C) and (O), since those paragraphs stated that it was preferable for the receiving Office to send declarations or evidence.

380. The Delegation of Spain supported the proposed amendment relating to withholding transmission of information where there was no prevailing public interest to have access to the information.

381. The Delegation of China agreed to the proposal to modify the PCT Regulations and supported the requests made by other delegations for further information in the Receiving Office Guidelines.

382. The Chair summarized that the Working Group had shown support for the proposal to amend the PCT Regulations and for the International Bureau to modify the Receiving Office Guidelines with a view to providing guidance on what types of information the receiving Office should withhold from transmission to the International Bureau.

383. The Working Group approved the proposed amendments to Rules 26*bis* and 48.2(b) of the Regulations as set out in Annex IV with a view to their submission to the Assembly for consideration at its next session in October 2015, subject to possible further drafting changes to be made by the Secretariat.

DELAYS AND FORCE MAJEURE FOR ELECTRONIC COMMUNICATIONS

384. Discussions were based on document PCT/WG/8/22.

385. The Secretariat explained that the document followed up on a proposal made to the seventh session of the Working Group to amend the Regulations dealing with extending time limits or excusing delays in meeting time limits to cover specifically the non-availability of electronic communications. As agreed at the seventh session of the Working Group, the International Bureau had followed up by consulting Offices on their practices in this area through a Circular, as explained in the document. In addition, the document referred to discussions in the Working Group on the Legal Development of the Madrid System for the International Registration of Marks on providing for remedies due to failure in electronic communications services, where a recommendation had been made for consideration by the Madrid Union Assembly. In terms of the proposals for providing for an automatic extension of

all time periods due to a significant outage in the Office's electronic communication systems for receiving documents on a specific day, Offices responding to the Circular did not agree on the idea of setting a threshold for extending all time limits expiring on that day. Instead, the preference was that the Office affected should take any decision on extending time limits, and the document pointed out the possibilities in this regard under the PCT. This would avoid the need to amend Rule 80, as had been proposed in document PCT/WG/7/24. On the other hand, the document proposed to amend Rule 82*quater* to include general unavailability in electronic communication services among the circumstances where evidence could be provided to an Office to excuse a delay in meeting a time limit. In making this amendment, this would aim to provide consistency between Offices in considering delays arising from such situations, in contrast to Offices themselves deciding whether or not failure or unavailability of electronic communication systems was something which fell under the "other like reason in locality where the interested party resides" part of Rule 82*quater*. In addition, if the Working Group were to agree to submit this proposal to amend the Regulations to the PCT Assembly, the document also proposed that an Understanding be adopted on how this provision should be applied, so this would cover general outages affecting a widespread geographic area or many individuals, as distinct from localized problems affecting a single building or a user.

386. The Delegation of Japan supported the purpose of the proposal to provide a remedy for users who were disadvantaged as a result of a failure in an electronic filing service, particularly as electronic filing had become the main method of filing patent applications. In terms of implementation of the provisions, the Delegation requested the International Bureau to set out clear standards in consultation with Contracting States.

387. The Delegation of the United States of America stated that it sympathized with the purpose of the proposal, but considered that the proposed amendment was encompassed by the existing wording "or other like reason in the locality where the interested party resides" in Rule 82*quater*.1(a). The term "general unavailability" was also unclear and could lead to applicants concluding that unavailability of electronic communications was a sufficient reason to excuse a failure to meet a time limit when other forms of communication were still available to the applicant. The Delegation also pointed out that general unavailability of electronic communications would not normally be accepted as a reason to excuse a delay to meet a time limit at the United States Patent and Trademark Office if alternative filing means, such as postal services, would have been available to the applicant. Finally, the Delegation questioned the need to deviate from the existing wording of Rule 82*quater*.1(a) by specifying a type of communication among a list of causes of disruptions that applied to different communication means.

388. The Delegation of Israel supported the proposed modification to Rule 82*quater*. With about 90 per cent of international applications being filed electronically, additional protection was necessary for cases where filing of documents was not possible due to loss of Internet connectivity beyond the control of the applicant.

389. The Delegation of the European Patent Offices supported the proposed modification to Rule 82*quater*.1(a) and explained that a similar provision existed under Rule 134(5) of the European Patent Convention in that "a general breakdown in any of the technical means of communication permitted by the President of the European Patent Office" could be reason to excuse a delay in meeting a time limit. Nevertheless, the Delegation had some sympathy with the comments made by the Delegation of the United States of America in that a general unavailability in electronic communications services could be covered by the phrase "other like reason in the locality where the interested party resides" in Rule 82*quater* if guidelines provided more explanation and clarity on this point.

390. The Delegation of China supported the proposal to add a general unavailability of electronic communications services to the provisions on excusing delay in meeting a time limit, and added that the proposal provided clear and helpful changes and would be to the benefit of applicants.

391. The Delegation of Canada acknowledged the need to excuse a delay to meet a time limit due to failure of electronic communications services but considered that the reason “general unavailability of electronic communication services” would not fit into Rule 82*quater* when considering the other reasons cited in Rule 82*quater*.1(a), all of which had a much higher level of gravity. Moreover, the loss of electronic communications in the locality of the applicant would not prevent the applicant using other communication means to meet the time limit, which had not been taken into account in the Regulations. The Delegation also believed that the provisions should be applied on a case-by-case basis, including an assessment of the actions taken by the applicant to ensure a deadline was met and what other filing options were available at the time. The proposed new provisions could therefore be perceived to be too prescriptive.

392. The Chair, in response to the remarks made by the Delegation of Canada, clarified that the failure to meet a time limit had to be caused by the general unavailability of electronic communications services. In requiring that any evidence had to be proven to the satisfaction of the Office to excuse a delay in meeting a time limit, paragraph (b) of Rule 82*quater*.1 provided an Office with discretion to consider the circumstances of each case.

393. The Delegation of the United Kingdom informed the Working Group that it had national legislation to allow the United Kingdom Intellectual Property Office to grant extensions of time where the failure to meet a time limit was attributable to delay in or failure of a communication service, including e-communication services. The Delegation was therefore in favor of the proposal to amend Rule 82*quater* to explicitly include delays due to unavailability of electronic communication services. This would provide international applicants with a useful safeguard and improve consistency of practice. As the Rule could be interpreted differently between Offices with regard to the meaning of a general unavailability of communication services, the Delegation agreed that there should be clear guidelines to ensure consistency. It also supported the proposal to invite the Assembly to adopt the Understanding in paragraph 25 of the document.

394. The Delegation of Spain stated that it was in favor of the proposal but highlighted that the Working Group may need to look at further issues concerned with problems caused by electronic communications in the future. For example, there had been cases where the Spanish Patent and Trademark Office had not received a document uploaded through a system for electronic submissions of documents, even though the applicant had been issued with a filing receipt which demonstrated that he had taken an action.

395. The Delegation of Colombia supported the proposed amendment to Rule 82*quater*, but agreed with the suggestion made by the Delegation of Spain to study further issues concerned with failure of electronic communications.

396. The Representative of the Japan Patent Attorneys Association (JPAA) expressed a desire for the proposal to also cover loss of Internet access and unavailability of the server of the applicant’s Internet Service Provider.

397. The Chair, in response to the remark made by the Representative of the Japan Patent Attorneys Association (JPAA), clarified that the loss of Internet access and unavailability of a server would be factors that could be considered under the provision of “general unavailability of electronic communication services” in deciding whether to excuse a delay in meeting a time limit. However, the extent of the disruption and other circumstances in the particular case would be important factors for an Office in deciding whether or not to excuse the delay.

398. The Chair referred to the remarks made by the Delegation of the United States of America that “the general unavailability of electronic communications services” was included in the phrase “other like reason in the locality where the interested party resides”. On the other hand, the Delegation of Canada had contrasted the “the general unavailability of electronic communications services” with the more serious events preceding this phrase, like war, natural calamity or civil disorder, which could imply that general unavailability of electronic communications services could not be interpreted as another “like reason”. Therefore, the Chair concluded that there would be no harm to state “the general unavailability of electronic communications services” explicitly in the Rule so it was clear that this was covered by the provisions. In terms of alternative filing means being available to the applicant, the Chair accepted that this would be the case in many situations, but an applicant in a remote location relying on the Internet to file on the final day of a time period when this was not available during the day would not have the same possibilities as an applicant in a city near to a post office or about to use another connection to the Internet.

399. The Chair concluded by acknowledging the widespread support to include a proper way of dealing with real instances of delays in the electronic world. The Chair therefore proposed that the Working Group should approve the proposed amendment to Rule 82*quater* and the Understanding in paragraph 25 of document PCT/WG/8/22 to set the context under which these extensions would be provided. As many delegations had pointed out, there also needed to be specific guidance on how the provisions should be applied so there would be a higher chance that the provisions would be applied consistently across the PCT system.

400. The Delegation of Norway suggested that the guidance should indicate that the general unavailability of electronic communications should be unexpected or unforeseen.

401. The Chair acknowledged that the suggestion made by the Delegation of Norway would be a useful clarification to any guidance given that an unexpected outage was different from situations where an Internet Service Provider had provided a forewarning of unavailability of a service between certain times on a given date.

402. The Delegation of the United States of America stated that it could accept the proposed amendment to Rule 82*quater* if it was clear in the relevant guidelines that the unavailability of electronic communications in itself was not necessarily a reason to excuse a delay in meeting a time limit. If alternative communication means were available, the practice at the United States Patent and Trademark Office had never been to excuse the failure to meet a time limit. Furthermore, the other provisions in Rule 82*quater* covered reasons for which any type of communication was unavailable to the applicant.

403. The Chair acknowledged the point made by the Delegation of the United States of America and accepted that the applicant needed to show a level of due care to meet the time period. This included exhausting all reasonable steps possible to meet the deadline, such as investigating alternatives to electronic communication.

404. The Delegation of the European Patent Office pointed out that the European Patent Office did not accept a stamp by the post office as a basis for establishing the date of receipt for an application. The Receiving Office Guidelines would therefore need to be worded generally to cover other means of filing that were acceptable to the receiving Office.

405. The Chair acknowledged the suggestion made by the Delegation of the European Patent Office for the International Bureau to take into account in drafting proposed modifications to the Receiving Office Guidelines.

406. The Working Group approved the proposed amendments to Rule 82*quater* as set out in the Annex to document PCT/WG/8/22 and reproduced in Annex V and the Understanding as set out in paragraph 25 to document PCT/WG/8/22 and reproduced below, with a view to their submission to the Assembly for consideration at its next session in October 2015, subject to possible further drafting changes to be made by the Secretariat.

"Application of Rule 82*quater*.1 with regard to a General Unavailability of Electronic Communications Services:

"In considering a request under Rule 82*quater*.1 to excuse a delay in meeting a time limit that has not been met due to a general unavailability of electronic communication services, the Office, Authority or the International Bureau, should interpret general unavailability of electronic communications to apply to outages that affect widespread geographical areas or many individuals, as distinct from localized problems associated with a particular building or single user."

407. The Working Group requested the International Bureau to consult on proposed modifications to any of the Receiving Office Guidelines, International Search and Preliminary Examination Guidelines and Administrative Instructions, as appropriate, to clarify how delays in meeting time limits due to failure in electronic communications services should be applied, including the possibility that such delays may not be excused where other means of communication were available.

LANGUAGES FOR COMMUNICATION WITH THE INTERNATIONAL BUREAU

408. Discussions were based on document PCT/WG/8/23.

409. The Secretariat explained that the International Bureau intended to improve its services to applicants by allowing new options to communicate with the International Bureau in languages other than English or French. In the past, the International Bureau had received occasional correspondence in languages other than English and French. Notwithstanding the requirement in Rule 92.2(d) for the applicant to correspond with the International Bureau in one of these two languages, if the document could be understood and there was no requirement to have a public record of the document in English or French, the International Bureau would not ask for a translation from the applicant, as this would add to delays and create additional work. Since April 16, 2015, the ePCT interface had been available in all 10 languages of international publication. As a result, the frequency of correspondence in languages other than English or French had increased. As an informal trial measure, the International Bureau had been accepting communications from applications using ePCT in the language of publication, even if this was neither English nor French, and had not been asking for translation of any such correspondence. The document proposed to seek approval to regularize this process in a manner which would be helpful to applicants but without causing difficulties for third parties and designated Offices. When considering a language regime for a processing system, it was desirable to allow users of the system to send correspondence in one of their normal working languages, but against this it was necessary to consider two key factors. First, the Office receiving the correspondence needed to process it effectively, and second, users outside the Office needed to understand the correspondence at a later stage. Regarding the need to see and understand the correspondence, the International Bureau did not believe there were difficulties, as the key results would be available to the public either in the international publication or in a standardized form whose contents could be readily used without reference to the original correspondence. In terms of processing the application, the International Bureau had strengthened language skills among staff processing applications and felt confident to conduct a trial where more correspondence would be received in languages other than English or French. Consequently, the document proposed an amendment to Rule 92.2(d) to include an enabling provision to add more languages for the applicant to send letters to the International Bureau. Languages would be added progressively through modifying the Administrative

Instructions when the International Bureau considered that it had the staff and systems to support the new language effectively. Although a first implementation intended to limit the trial to documents received through ePCT, if the processing could be done satisfactorily, the intention was to extend the arrangements across all means of communication. Finally, the Secretariat pointed out that the proposal extended only to the language of correspondence to the International Bureau. Communications from the International Bureau would continue to be in English or French only, but technical work was underway to make improvements for the future to render forms on demand into languages other than the original

410. The Delegation of the United States of America expressed support for the proposal, noting that languages would be added when the International Bureau had sufficient resources and therefore it would not entail significant additional costs or require extra staff.

411. The Delegation of Japan supported the general idea of allowing applicants to use languages other than English and French regulated by Rule 92.2(d) in correspondence with the International Bureau. The Delegation, however, expressed concerns about the implementation. First it should not be allowed to increase costs or reduce timelines because of added workload. Second, it was essential to ensure that this did not result in difficulties for designated Offices by allowing the submission in alternative languages of documents which were important for the Office to be able to read. Finally, it would be desirable to provide better consultation and notice for national Offices concerning impending changes to ePCT which could have an effect on the Regulations and on the Offices.

412. The Delegation of Spain expressed support for the proposed measure, which would be a step forward in bringing down languages barriers to users, which often brought about extra costs.

413. The Delegation of China supported the proposal in principle, which would allow applicants to submit communications to the International Bureau in any language of publication, thereby reducing burden on applicants. Noting that the pilot extension was presently limited to communications made using ePCT, the Delegation expressed its hope that it could be extended to other modes of communication as soon as possible.

414. The Chair, in response to the remarks made by the Delegation of China, clarified that, while the trial would be limited to ePCT, the proposed changes to Rule 92.2(d) were broader and would provide the opportunity in the future for languages other than English or French to be used for all forms of communication.

415. The Delegation of Chile welcomed the proposal, as it would promote ease of access to the PCT for Spanish speakers and expressed satisfaction that ePCT could now be used in all 10 publication languages.

416. The Delegation of Canada supported the proposed amendments to Rule 92.2(d) once the trial had been concluded and its results were shared.

417. The Delegation of Mexico supported the proposal, which would allow applicants to use ePCT to correspond in the Spanish language. The availability of ePCT in the 10 publication languages had allowed the Mexican Institute of Industrial Property to offer receipt of applications via electronic means to the benefit of Spanish-speaking applicants in Mexico.

418. The Delegation of Ecuador expressed support for the proposal in the document.

419. The Chair summarized that there was support for the proposal from delegations. In response to the remarks made by the Delegation of Japan, the Chair clarified that the proposal would not affect the staffing and operational costs for the International Bureau, and that the greater inclusiveness of the language regime would be implemented in a steady way when it

was clear that it could be supported without further implications for costs and staffing. Furthermore, Member States and Offices would be consulted when changes to the language regime were proposed.

420. The Working Group agreed on the proposed amendments to Rule 92.2(d) set out in the Annex to document PCT/WG/8/23 and reproduced in Annex VI with a view to their submission to the Assembly for consideration at its next session, in October 2015, subject to possible further drafting changes to be made by the Secretariat.

OTHER MATTERS

421. 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 October 2015 and September/October 2016 sessions of the Assembly, and that the same financial assistance should be made available to enable attendance of certain delegations at this session should be made available at the next session.

422. The International Bureau indicated that the ninth session of the Working Group was tentatively scheduled to be held in Geneva in May/June 2016.

SUMMARY BY THE CHAIR

423. The Working Group noted the contents of the Summary by the Chair in document PCT/WG/8/25 and that the official record would be contained in the report of the session.

CLOSING OF THE SESSION

424. Mr. John Sandage, Deputy Director General of WIPO spoke to close the session on behalf of the Director General. Attending the first session of the Working Group since his appointment, the Deputy Director General noted the wide range of complex issues that the Working Group had tackled in the spirit of cordiality and in a very effective and productive way, and congratulated delegations for approaching their work during the session with seriousness and effectiveness, which he hoped would continue for future sessions.

425. The Chair closed the session on May 29, 2015.

426. The Working Group adopted this report by correspondence.

[Annexes follow]

DRAFT AMENDMENTS TO THE PCT REGULATIONS
RECOMMENDED IN RELATION TO AGENDA ITEM 13

TRANSMITTAL BY THE RECEIVING OFFICE OF EARLIER
SEARCH AND/OR CLASSIFICATION RESULTS
TO THE INTERNATIONAL SEARCHING AUTHORITY

TABLE OF CONTENTS

Rule 12 <i>bis</i> Submission by the Applicant of Documents Relating to Earlier Search Copy of Results of Earlier Search and of Earlier Application; Translation	2
12 <i>bis.1</i> <i>Furnishing by the Applicant of Documents Related to Earlier Search in Case of Request Under Rule 4.12</i> Copy of Results of Earlier Search and of Earlier Application; Translation	2
12 <i>bis.2</i> <i>Invitation by the International Searching Authority to Furnish Documents Related to Earlier Search in Case of Request Under Rule 4.12</i>	4
Rule 23 <i>bis</i> Transmittal of Documents Relating to Earlier Search or Classification	6
23 <i>bis.1</i> <i>Transmittal of Documents Relating to Earlier Search in Case of Request Under Rule 4.12</i>	6
23 <i>bis.2</i> <i>Transmittal of Documents Relating to Earlier Search or Classification for the Purposes of Rule 41.2</i>	7
Rule 41 Taking into Account Results of Earlier Search	9
41.1 <i>Taking into Account Results of Earlier Search in Case of a Request under Rule 4.12</i>	9
41.2 <i>Taking into Account Results of Earlier Search in Other Cases</i>	9

Rule 12bis

Submission by the Applicant of Documents Relating to Earlier Search

~~Copy of Results of Earlier Search and of Earlier Application; Translation~~

12bis.1 Furnishing by the Applicant of Documents Related to Earlier Search in Case of Request Under Rule 4.12 ~~Copy of Results of Earlier Search and of Earlier Application; Translation~~

(a) Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search carried out by the same or another International Searching Authority or by a national Office, the applicant shall, subject to paragraphs (b) to (d) ~~(e) to (f)~~, submit to the receiving Office, together with the international application, a copy of the results of the earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are presented by the Authority or Office concerned.

~~(b) The International Searching Authority may, subject to paragraphs (c) to (f), invite the applicant to furnish to it, within a time limit which shall be reasonable under the circumstances:~~

~~(i) a copy of the earlier application concerned;~~

~~(ii) where the earlier application is in a language which is not accepted by the International Searching Authority, a translation of the earlier application into a language which is accepted by that Authority;~~

~~(iii) where the results of the earlier search are in a language which is not accepted by the International Searching Authority, a translation of those results into a language which is accepted by that Authority;~~

[Rule 12bis.1, continued]

~~(iv) a copy of any document cited in the results of the earlier search.~~

(b) ~~(e)~~ Where the earlier search was carried out by the same Office as that which is acting as the receiving Office, the applicant may, instead of submitting the copy ~~copies~~ referred to in paragraph (a) ~~paragraphs (a) and (b)(i) and (iv)~~, indicate the wish that the receiving Office prepare and transmit it ~~them~~ to the International Searching Authority. Such request shall be made in the request and may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee.

(c) ~~(d)~~ Where the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, no copy ~~or translation~~ referred to in paragraph (a) ~~paragraphs (a) and (b)~~ shall be required to be submitted under that paragraph ~~those paragraphs~~.

~~(e) Where the request contains a statement under Rule 4.12(ii) to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language, no copy or translation referred to in paragraphs (b)(i) and (ii) shall be required to be submitted under those paragraphs.~~

(d) ~~(f)~~ Where a copy ~~or translation~~ referred to in paragraph (a) ~~paragraphs (a) and (b)~~ is available to the receiving Office or the International Searching Authority in a form and manner acceptable to it, for example, from a digital library ~~or in the form of the priority document~~, and the applicant so indicates in the request, no copy ~~or translation~~ shall be required to be submitted under that paragraph ~~those paragraphs~~.

12bis.2 Invitation by the International Searching Authority to Furnish Documents Related to
Earlier Search in Case of Request Under Rule 4.12

(a) The International Searching Authority may, subject to paragraphs (b) and (c)
~~paragraphs (e) to (f)~~, invite the applicant to furnish to it, within a time limit which shall be
reasonable under the circumstances:

(i) a copy of the earlier application concerned;

(ii) where the earlier application is in a language which is not accepted by the
International Searching Authority, a translation of the earlier application into a
language which is accepted by that Authority;

(iii) where the results of the earlier search are in a language which is not accepted by
the International Searching Authority, a translation of those results into a language
which is accepted by that Authority;

(iv) a copy of any document cited in the results of the earlier search.

(b) Where the earlier search was carried out by the same International Searching
Authority, or by the same Office as that which is acting as the International Searching Authority,
or where a copy or translation referred to in paragraph (a) is available to the International
Searching Authority in a form and manner acceptable to it, for example, from a digital library, or
in the form of the priority document, no copy or translation referred to in paragraph (a) shall be
required to be submitted under that paragraph.

[Rule 12bis.2, continued]

(c) Where the request contains a statement under Rule 4.12(ii) to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language, no copy or translation referred to in paragraphs (a)(i) and (ii) ~~paragraphs (b)(i) and (ii)~~ shall be required to be submitted under those paragraphs.

Rule 23bis

Transmittal of Documents Relating to Earlier Search or Classification

23bis.1 Transmittal of Documents Relating to Earlier Search in Case of Request Under

Rule 4.12

(a) The receiving Office shall transmit to the International Searching Authority, together with the search copy, any copy or translation referred to in Rule 12bis.1(a) related to an earlier search in respect of which the applicant has made a request under Rule 4.12, provided that any such copy or translation:

(i) has been submitted by the applicant to the receiving Office together with the international application;

(ii) has been requested by the applicant to be prepared and transmitted by the receiving Office to that Authority; or

(iii) is available to the receiving Office in a form and manner acceptable to it, for example, from a digital library in accordance with Rule 12bis.1(d).

(b) If not included in the copy of the results of the earlier search referred to in Rule 12bis.1(a), the receiving Office shall also transmit to the International Searching Authority, together with the search copy, a copy of the results of any earlier classification effected by that Office, if already available.

23bis.2 Transmittal of Documents Relating to Earlier Search or Classification for the Purposes of Rule 41.2

(a) For the purposes of Rule 41.2, where the international application claims the priority of one or more earlier applications filed with the same Office as that which is acting as the receiving Office and that Office has carried out an earlier search in respect of such an earlier application or has classified such earlier application, the receiving Office shall, subject to paragraphs (b), (d) and (e), transmit to the International Searching Authority, together with the search copy, a copy of the results of any such earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are available to the Office, and a copy of the results of any such earlier classification effected by the Office, if already available. The receiving Office may also transmit to the International Searching Authority any further documents relating to such an earlier search which it considers useful to that Authority for the purposes of carrying out the international search.

(b) Notwithstanding paragraph (a), a receiving Office may notify the International Bureau by [DATE] that it may, on request of the applicant submitted together with the international application, decide not to transmit the results of an earlier search to the International Searching Authority. The International Bureau shall publish any notification under this provision in the Gazette.

(c) At the option of the receiving Office, paragraph (a) shall apply mutatis mutandis where the international application claims the priority of one or more earlier applications filed with an Office different from the one which is acting as the receiving Office and that Office has carried out an earlier search in respect of such an earlier application or has classified such earlier application, and the results of any such earlier search or classification are available to the receiving Office in a form and manner acceptable to it, for example, from a digital library.

[Rule 23bis.2 continued]

(d) Paragraphs (a) and (c) shall not apply where the earlier search was carried out by the same International Searching Authority or by the same Office as that which is acting as the International Searching Authority, or where the receiving Office is aware that a copy of the earlier search or classification results is available to the International Searching Authority in a form or manner acceptable to it, for example, from a digital library.

(e) To the extent that, on [DATE], the transmission of the copies referred to in paragraph (a), or the transmission of such copies in a particular form, such as those referred to in paragraph (a), without the authorization by the applicant is not compatible with the national law applied by the receiving Office, that paragraph shall not apply to the transmission of such copies, or to the transmission of such copies in the particular form concerned, in respect of any international application filed with that receiving Office for as long as such transmission without the authorization by the applicant continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [DATE]. The information received shall be promptly published by the International Bureau in the Gazette.

Rule 41

Taking into Account Results of Earlier Search

41.1 *Taking into Account Results of Earlier Search* [in Case of a Request under Rule 4.12](#)

Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search and has complied with Rule 12*bis*.1 and:

(i) the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, the International Searching Authority shall, to the extent possible, take those results into account in carrying out the international search;

(ii) the earlier search was carried out by another International Searching Authority, or by an Office other than that which is acting as the International Searching Authority, the International Searching Authority may take those results into account in carrying out the international search.

[41.2 *Taking into Account Results of Earlier Search in Other Cases*](#)

[\(a\) Where the international application claims the priority of one or more earlier applications in respect of which an earlier search has been carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, the International Searching Authority shall, to the extent possible, take the results of any such earlier search into account in carrying out the international search.](#)

[Rule 41.2, continued]

(b) Where the receiving Office has transmitted to the International Searching Authority a copy of the results of any earlier search or of any earlier classification under Rule 23bis.2(a) or (b), or where such a copy is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library, the International Searching Authority may take those results into account in carrying out the international search.

[Annex II follows]

DRAFT AMENDMENTS TO THE PCT REGULATIONS
RECOMMENDED IN RELATION TO AGENDA ITEM 15

INFORMATION CONCERNING NATIONAL PHASE ENTRY AND TRANSLATIONS

TABLE OF CONTENTS

Rule 86 The Gazette	2
86.1 <i>Contents</i>	2
86.2 to 86.6 <i>[No change]</i>	2
Rule 95 Availability of Translations Information and Translations from Designated and Elected Offices.....	3
95.1 Information Concerning Events at the Designated and Elected Offices.....	3
95.1 95.2 <i>Furnishing of Copies of Translations</i>	4

Rule 86
The Gazette

86.1 *Contents*

The Gazette referred to in Article 55(4) shall contain:

(i) to (iii) *[no change]*

(iv) information, ~~if and to the extent furnished to the International Bureau by the designated or elected Offices, on the question whether the requirements provided for in Articles 22 or 39 have been complied with in respect of the international applications designating or electing the Office concerned~~ concerning events at the designated and elected Offices notified to the International Bureau under Rule 95.1 in relation to published international applications;

(v) *[No change]*

86.2 to 86.6 *[No change]*

Rule 95

~~Availability of Translations~~

Information and Translations from Designated and Elected Offices

95.1 Information Concerning Events at the Designated and Elected Offices

Any designated or elected Office shall notify the International Bureau of the following information concerning an international application within two months, or as soon as reasonably possible thereafter, of the occurrence of any of the following events:

(i) following the performance by the applicant of the acts referred to in Article 22 or Article 39, the date of performance of those acts and any national application number which has been assigned to the international application;

(ii) where the designated or elected Office explicitly publishes the international application under its national law or practice, the number and date of that national publication;

(iii) where a patent is granted, the date of grant of the patent and, where the designated or elected Office explicitly publishes the international application in the form in which it is granted under its national law, the number and date of that national publication.

~~95.1~~ 95.2 *Furnishing of Copies of Translations*

(a) *[No change]* At the request of the International Bureau, any designated or elected Office shall provide it with a copy of the translation of the international application furnished by the applicant to that Office.

(b) *[No change]* The International Bureau may, upon request and subject to reimbursement of the cost, furnish to any person copies of the translations received under paragraph (a).

[Annex III follows]

DRAFT AMENDMENTS TO THE PCT REGULATIONS
RECOMMENDED IN RELATION TO AGENDA ITEM 24

OMISSION OF CERTAIN INFORMATION FROM PUBLIC ACCESS

TABLE OF CONTENTS

Rule 9	Expressions, Etc., Not to Be Used.....	2
9.1	<i>[No change] Definition.....</i>	2
9.2	<i>Noting of Lack of Compliance</i>	3
9.3	<i>[No change] Reference to Article 21(6)</i>	3
Rule 48	International Publication	4
48.1	<i>[No change]</i>	4
48.2	<i>Contents</i>	4
48.3 to 48.6	<i>[No change].....</i>	5
Rule 94	Access to Files	6
94.1	<i>Access to the File Held by the International Bureau</i>	6
94.1bis	<i>Access to the File Held by the Receiving Office.....</i>	8
94.1ter	<i>Access to the File Held by the International Searching Authority.....</i>	8
94.2	<i>Access to the File Held by the International Preliminary Examining Authority</i>	9
94.3	<i>Access to the File Held by the Elected Office.....</i>	10

Rule 9

Expressions, Etc., Not to Be Used

9.1 [No change] Definition

The international application shall not contain:

- (i) expressions or drawings contrary to morality;
- (ii) expressions or drawings contrary to public order;
- (iii) statements disparaging the products or processes of any particular person other than the applicant, or the merits or validity of applications or patents of any such person (mere comparisons with the prior art shall not be considered disparaging *per se*);
- (iv) any statement or other matter obviously irrelevant or unnecessary under the circumstances.

9.2 *Noting of Lack of Compliance*

The receiving Office, ~~and~~ the International Searching Authority, the Authority specified for supplementary search and the International Bureau may note lack of compliance with the prescriptions of Rule 9.1 and may suggest to the applicant that he voluntarily correct his international application accordingly, in which case the receiving Office, the competent International Searching Authority, the competent Authority specified for supplementary search and the International Bureau, as applicable, shall be informed of the suggestion. ~~If the lack of compliance was noted by the receiving Office, that Office shall inform the competent International Searching Authority and the International Bureau; if the lack of compliance was noted by the International Searching Authority, that Authority shall inform the receiving Office and the International Bureau.~~

9.3 *[No change] Reference to Article 21(6)*

"Disparaging statements," referred to in Article 21(6), shall have the meaning as defined in Rule 9.1(iii).

Rule 48

International Publication

48.1 [No change]

48.2 Contents

(a) to (k) [No change]

(l) The International Bureau shall, upon a reasoned request by the applicant received by the International Bureau prior to the completion of technical preparations for international publication, omit from publication any information, if it finds that:

(i) this information does not obviously serve the purpose of informing the public about the international application;

(ii) publication of such information would clearly prejudice the personal or economic interests of any person; and

(iii) there is no prevailing public interest to have access to that information.

Rule 26.4 shall apply *mutatis mutandis* as to the manner in which the applicant shall present the information which is the subject of a request made under this paragraph.

[Rule 48.2, continued]

(m) Where the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Bureau notes any information meeting the criteria set out under paragraph (l), that Office, Authority or Bureau may suggest to the applicant to request the omission from international publication in accordance with paragraph (l).

(n) Where the International Bureau has omitted information from international publication in accordance with paragraph (l) and that information is also contained in the file of the international application held by the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, the International Bureau shall promptly notify that Office and Authority accordingly.

48.3 to 48.6 [No change]

Rule 94

Access to Files

94.1 Access to the File Held by the International Bureau

(a) [No change] At the request of the applicant or any person authorized by the applicant, the International Bureau shall furnish, subject to reimbursement of the cost of the service, copies of any document contained in its file.

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application and subject to Article 38 [and paragraphs \(d\) to \(g\)](#), furnish, ~~subject to the reimbursement of the cost of the service,~~ copies of any document contained in its file. [The furnishing of copies may be subject to reimbursement of the cost of the service.](#)

(c) [No change] The International Bureau shall, if so requested by an elected Office, furnish copies of the international preliminary examination report under paragraph (b) on behalf of that Office. The International Bureau shall promptly publish details of any such request in the Gazette.

[\(d\) The International Bureau shall not provide access to any information contained in its file which has been omitted from publication under Rule 48.2\(l\) and to any document contained in its file relating to a request under that Rule.](#)

[Rule 94.1, continued]

(e) Upon a reasoned request by the applicant, the International Bureau shall not provide access to any information contained in its file and to any document contained in its file relating to such a request, if it finds that:

(i) this information does not obviously serve the purpose of informing the public about the international application;

(ii) public access to such information would clearly prejudice the personal or economic interests of any person; and

(iii) there is no prevailing public interest to have access to that information.

Rule 26.4 shall apply mutatis mutandis as to the manner in which the applicant shall present the information which is the subject of the request made under this paragraph.

(f) Where the International Bureau has omitted information from public access in accordance with paragraphs (d) or (e), and that information is also contained in the file of the international application held by the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, the International Bureau shall promptly notify that Office and Authority accordingly.

(g) The International Bureau shall not provide access to any document contained in its file which was prepared solely for internal use by the International Bureau.

94.1bis Access to the File Held by the Receiving Office

(a) At the request of the applicant or any person authorized by the applicant, the receiving Office may provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(b) The receiving Office may, at the request of any person, but not before the international publication of the international application and subject to paragraph (c), provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(c) The receiving Office shall not provide access under paragraph (b) to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication in accordance with Rule 48.2(I) or from public access in accordance with Rule 94.1(d) or (e).

94.1ter Access to the File Held by the International Searching Authority

(a) At the request of the applicant or any person authorized by the applicant, the International Searching Authority may provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(b) The International Searching Authority may, at the request of any person, but not before the international publication of the international application and subject to paragraph (c), provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

[Rule 94.1ter, continued]

(c) The International Searching Authority shall not provide access under paragraph (b) to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication in accordance with Rule 48.2(I) or from public access in accordance with Rule 94.1(d) or (e).

(d) Paragraphs (a) to (c) shall apply mutatis mutandis to the Authority specified for supplementary search.

94.2 Access to the File Held by the International Preliminary Examining Authority

(a) At the request of the applicant or any person authorized by the applicant, ~~or, once the international preliminary examination report has been established, of any elected Office,~~ the International Preliminary Examining Authority shall provide access to any document ~~furnish, subject to reimbursement of the cost of the service, copies of any document~~ contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(b) At the request of any elected Office, but not before the establishment of the international preliminary examination report and subject to paragraph (c), the International Preliminary Examining Authority shall provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(c) The International Preliminary Examining Authority shall not provide access under paragraph (b) to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication in accordance with Rule 48.2(I) or from public access in accordance with Rule 94.1(d) or (e).

94.2bis Access to the File Held by the Designated Office

If the national law applicable by any designated Office allows access by third parties to the file of a national application, that Office may allow access to any documents relating to the international application, contained in its file, to the same extent as provided by the national law for access to the file of a national application, but not before the earliest of the dates specified in Article 30(2)(a). The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

94.3 Access to the File Held by the Elected Office

If the national law applicable by any elected Office allows access by third parties to the file of a national application, that Office may allow access to any documents relating to the international application, including any document relating to the international preliminary examination, contained in its file, to the same extent as provided by the national law for access to the file of a national application, but not before the earliest of the dates specified in Article 30(2)(a) ~~the international publication of the international application~~. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

[Annex IV follows]

DRAFT AMENDMENTS TO THE PCT REGULATIONS
RECOMMENDED IN RELATION TO AGENDA ITEM 25

TRANSMITTAL TO THE INTERNATIONAL BUREAU OF COPIES OF DOCUMENTS
RECEIVED IN THE CONTEXT OF A REQUEST FOR RESTORATION OF RIGHT OF
PRIORITY

TABLE OF CONTENTS

Rule 26 <i>bis</i> Correction or Addition of Priority Claim	2
26 <i>bis</i> .1 and 26 <i>bis</i> .2 [No change].....	2
26 <i>bis</i> .3 Restoration of Right of Priority by Receiving Office.....	2
Rule 48 International Publication	4
48.1 [No change]	4
48.2 Contents	4
48.3 to 48.6 [No change].....	4

Rule 26bis

Correction or Addition of Priority Claim

26bis.1 and 26bis.2 [No change]

26bis.3 *Restoration of Right of Priority by Receiving Office*

(a) to (e) [No change]

(f) The receiving Office may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (b)(ii)(b)(iii) be filed with it within a time limit which shall be reasonable under the circumstances. ~~The applicant may furnish to the International Bureau a copy of any such declaration or other evidence filed with the receiving Office, in which case the International Bureau shall include such copy in its files.~~

(g) [No change]

(h) The receiving Office shall promptly:

(i) [no change] notify the International Bureau of the receipt of a request under paragraph (a);

(ii) [no change] make a decision upon the request;

(iii) notify the applicant and the International Bureau of its decision and the criterion for restoration upon which the decision was based.

[Rule 26bis.3(h), continued]

(iv) subject to paragraph (h-bis), transmit to the International Bureau all documents received from the applicant relating to the request under paragraph (a) (including a copy of the request itself, any statement of reasons referred to in paragraph (b)(ii) and any declaration or other evidence referred to in paragraph (f)).

(h-bis) The receiving Office shall, upon a reasoned request by the applicant or on its own decision, not transmit documents or parts thereof received in relation to the request under paragraph (a), if it finds that

(i) this document or part thereof does not obviously serve the purpose of informing the public about the international application;

(ii) publication or public access to any such document or part thereof would clearly prejudice the personal or economic interests of any person; and

(iii) there is no prevailing public interest to have access to that document or part thereof.

Where the receiving Office decides not to transmit documents or parts thereof to the International Bureau, it shall notify the International Bureau accordingly.

(i) and (j) [No change]

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 (vi) [No change]

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

~~(viii) [Deleted] where applicable, an indication that the applicant has, under Rule 26*bis*.3(f), furnished copies of any declaration or other evidence to the International Bureau.~~

(c) to (k) [No change]

48.3 to 48.6 [No change]

[Annex V follows]

DRAFT AMENDMENTS TO THE PCT REGULATIONS
RECOMMENDED IN RELATION TO AGENDA ITEM 26

DELAYS AND FORCE MAJEURE FOR ELECTRONIC COMMUNICATIONS

[There are no changes to these draft amendments compared to those set out in the Annex to document PCT/WG/8/22.]

TABLE OF CONTENTS

Rule 82 <i>quater</i> Excuse of Delay in Meeting Time Limits.....	2
82 <i>quater</i> .1 Excuse of Delay in Meeting Time Limits.....	2

Rule 82^{quater}

Excuse of Delay in Meeting Time Limits

82^{quater}.1 Excuse of Delay in Meeting Time Limits

(a) Any interested party may offer evidence that a time limit fixed in the Regulations for performing an action before the receiving Office, the International Searching Authority, the Authority specified for supplementary search, the International Preliminary Examining Authority or the International Bureau was not met due to war, revolution, civil disorder, strike, natural calamity, [a general unavailability of electronic communications services](#) 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.

(b) [No change] Any such evidence shall be addressed to the Office, Authority or the International Bureau, as the case may be, not later than six months after the expiration of the time limit applicable in the given case. If such circumstances are proven to the satisfaction of the addressee, delay in meeting the time limit shall be excused.

(c) [No change] The excuse of a delay need not be taken into account by any designated or elected Office before which the applicant, at the time the decision to excuse the delay is taken, has already performed the acts referred to in Article 22 or Article 39.

[Annex VI follows]

DRAFT AMENDMENTS TO THE PCT REGULATIONS
RECOMMENDED IN RELATION TO AGENDA ITEM 27

LANGUAGES FOR COMMUNICATION WITH THE INTERNATIONAL BUREAU

[There are no changes to these draft amendments compared to those set out in the Annex to document PCT/WG/8/23.]

TABLE OF CONTENTS

Rule 92 Correspondence.....	2
92.1 [No change]	2
92.2 Languages	2
92.3 and 92.4 [No change].....	2

Rule 92
Correspondence

92.1 [No change]

92.2 Languages

(a) *[No change]* Subject to Rules 55.1 and 55.3 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. However, where a translation of the international application has been transmitted under Rule 23.1(b) or furnished under Rule 55.2, the language of such translation shall be used.

(b) *[No change]* Any letter from the applicant to the International Searching Authority or the International Preliminary Examining Authority may be in a language other than that of the international application, provided the said Authority authorizes the use of such language.

(c) *[Remains deleted]*

(d) Any letter from the applicant to the International Bureau shall be in English, ~~or~~ French [or any other language of publication as may be permitted by the Administrative Instructions.](#)

(e) *[No change]* Any letter or notification from the International Bureau to the applicant or to any national Office shall be in English or French.

92.3 and 92.4 [No change]

[End of Annex VII follows]

LISTE DES PARTICIPANTS/
LIST OF PARTICIPANTS

I. MEMBRES/MEMBERS

(dans l'ordre alphabétique des noms français des États)
(in the alphabetical order of the names in French of the States)

1. ÉTATS/STATES

AFRIQUE DU SUD/SOUTH AFRICA

Elena Mihail ZDRAVKOVA (Mrs.), Senior Manager, Patents and Design, South Africa Companies and Intellectual Property Commission (CIPC), Pretoria, ezdravkova@cipc.co.za

Boitumelo Brenda MOSITO (Mrs.), Team Manager, Patents and Design, South Africa Companies and Intellectual Property Commission (CIPC), Pretoria, bsepato@cipc.co.za

ALLEMAGNE/GERMANY

Lena ZIEGLER (Mrs.), German Patent and Trademark Office, Munich

Markus SEITZ, German Patent and Trademark Office, Munich, markus.seitz@dpma.de

Pamela WILLE (Ms.), Counsellor, Permanent Mission, Geneva, wi-2-io@genf.auswaertiges-amt.de

ARABIE SAOUDITE/SAUDI ARABIA

Mohamed ALTHARWY, Head, Application Management Unit, King Abdulaziz City for Science and Technology (KACST), Riyadh, ssodais@kacst.edu.sa

AUSTRALIE/AUSTRALIA

Victor PORTELLI, General Manager, Patents and Plant Breeder's Rights Group, IP Australia, Canberra, victor.portelli@ipaustralia.gov.au

Keith PORTER, Assistant Director, International Policy and Cooperation, IP Australia, Canberra, keith.porter@ipaustralia.gov.au

Andrew SAINSBURY, First Secretary, Permanent Mission to the World Trade Organization (WTO), Geneva

AUTRICHE/AUSTRIA

Katharina FASTENBAUER (Ms.), Head, Patent Support and PCT Department, Austrian Patent Office; Deputy Vice President Technics, Vienna, katharina.fastenbauer@patentamt.at

BÉLARUS/BELARUS

Lizaveta KOMAR (Ms.), Leading Specialist, Medical Division of the Examination Center of Industrial Property, National Center of Intellectual Property, Minsk, komes@mail.ru

BELGIQUE/BELGIUM

Jeroen VANDECASTEELE, expert, Office belge de la propriété intellectuelle (ORPI), Service public fédéral, économie, Bruxelles

Mathias KENDE, deuxième secrétaire, Mission permanente, Genève

BRÉSIL/BRAZIL

Gisela NOGUEIRA (Ms.), Technical Head, PCT Division, National Institute of Industrial Property (INPI), Rio de Janeiro

Rodrigo MENDES ARAUJO, First Secretary, Permanent Mission, Geneva

CAMEROUN/CAMEROON

Likiby BOUBAKAR, secrétaire permanent, Comité national de développement des technologies, Ministère de la recherche scientifique et de l'innovation, Yaoundé, likibyboubakar@gmail.com

CANADA

Elaine HELLYER (Ms.), Program Manager - International, Canadian Intellectual Property Office (CIPO), Department of Industry, Gatineau, elaine.hellyer@ic.gc.ca

CHILI/CHILE

Henry CREW ARAYA, Jefe, Departamento PCT, Subdirección de Patentes, Instituto Nacional de Propiedad Industrial (INAPI), Ministerio de Economía, Santiago de Chile, hcrew@inapi.cl

Marcela PAIVA (Sra.), Consejero, Misión Permanente ante la Organización Mundial del Comercio (OMC), Ginebra, mpaiva@gov.cl

CHINE/CHINA

HU Anqi (Ms.), Deputy Director, Treaty and Law Department, State Intellectual Property Office (SIPO), Beijing, huangqi@sipo.gov.cn

YANG Ping (Mrs.), Project Administrator, International Cooperation Department, State Intellectual Property Office (SIPO), Beijing, yangping@sipo.gov.cn

COLOMBIE/COLOMBIA

José Luis SALAZAR, Jefe, Oficina de Patentes, Superintendencia de Industria y Comercio, Bogotá, jlsalazar@sic.gov.co

Juan Camilo SARETZKI-FORERO, Primer Secretario, Misión Permanente, Ginebra, juan.saretzki@misioncolombia.ch

CUBA

Eva María PÉREZ (Srta.), Jefe, Departamento de Patentes, Oficina Cubana de la Propiedad Industrial (OCPI), La Habana, ocpi@ocpi.cu

DANEMARK/DENMARK

Thomas Xavier DUHOLM, Deputy Director, Policy and Legal Affairs, Danish Patent and Trademark Office, Ministry of Business and Growth, Taastrup, tdu@dkpto.dk

ÉGYPTE/EGYPT

Rasha Hamdy Abdel Hamid ABDEL MAGID (Ms.), Senior Patent Examiner, Egyptian Patent Office, Academy of Scientific Research and Technology (ASRT), Ministry of Scientific Research, Cairo, ra_hamdy@egypo.gov.eg

Irini GIRGIS (Ms.), Senior Patent Examiner, Egyptian Patent Office, Academy of Scientific Research and Technology (ASRT), Ministry of Scientific Research, Cairo

EL SALVADOR

Katia CARBALLO (Sra.), Ministra Consejera, Misión Permanente, Ginebra, kcarballo@minec.gob.sv

ÉMIRATS ARABES UNIS/UNITED ARAB EMIRATES

Ali ALHOSANI, Deputy Undersecretary, Intellectual Property Division, Department of Intellectual Property, Ministry of Economy, Abu Dhabi, aialhosani@economy.ae

Khelfan Ahmed AL SUWAIDI, Director, Industrial Property Division, Ministry of Economy, Abu Dhabi, KAISuwaidi@economy.ae

ESPAGNE/SPAIN

Javier VERA ROA, Consejero Técnico, Departamento de Patentes e Información Tecnológica, Oficina Española de Patentes y Marcas (OEPM), Ministerio de Industria, Energía y Turismo, Madrid

Xavier BELLMONT ROLDAN, Consejero, Misión Permanente, Ginebra

ÉQUATEUR/ECUADOR

Juan Carlos CASTRILLON, Ministro, Misión Permanente, Ginebra, jcastrillon@mmree.gob.ec

ÉTATS-UNIS D'AMÉRIQUE/UNITED STATES OF AMERICA

Charles A. PEARSON, Director, International Patent Legal Administration, United States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria, charles.pearson@uspto.gov

Richard R. COLE, Deputy Director, International Patent Legal Administration, United States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria, richard.cole@uspto.gov

Michael A. NEAS, Deputy Director, International Patent Legal Administration, United States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria, michael.neas@uspto.gov

Paolo M. TREVISAN, Patent Attorney, Office of Policy and International Affairs, United States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria, paolo.trevisan@uspto.gov

FÉDÉRATION DE RUSSIE/RUSSIAN FEDERATION

Andrey ZHURAVLEV, Deputy Director, Federal Institute of Industrial Property (FIPS), Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow, Azhuralev@rupto.ru

Gennady NEGULYAEV, Senior Researcher, Information Resources, Classification System and Standards in Industrial Property, Federal Institute of Industrial Property (FIPS), Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow, Gnegouliaev@rupto.ru

FINLANDE/FINLAND

Riitta LARJA (Ms.), Deputy Head of Division, Finnish Patent and Registration Office, Helsinki,
riitta.larja@prh.fi

Juha REKOLA, Development Director, Finnish Patent and Registration Office, Helsinki,
juha.rekola@prh.fi

FRANCE

Olivier HOARAU, chargé de mission, Direction juridique, Affaires internationales, Institut national de la propriété industrielle (INPI), Paris, ohoarau@inpi.fr

Nathalie RAUFFER-BRUYÈRE (Mme), ingénieur brevet, Direction des brevets, Institut national de la propriété industrielle (INPI), Paris, nraufferbruyere@inpi.fr

GABON

Edwige KOUMBY MISSAMBO (Mme), premier conseiller, Mission permanente, Genève,
prisquentage@yahoo.fr

GHANA

Alexander BEN-ACQUAAH, Minister Counsellor, Permanent Mission, Geneva,
ben-acquaaha@ghanamission.ch

GRÈCE/GREECE

Myrto LAMBROU MAURER (Ms.), Head, International Affairs, Industrial Property Organization (OBI), Athens, mlab@obi.gr

GUATEMALA

Flor de María GARCÍA DÍAZ (Srta.), Consejera, Misión Permanente ante la Organización Mundial de Comercio (OMC), Ginebra, flor.garcia@wtoguatemala.ch

HONDURAS

Giampaolo RIZZO-ALVARADO, Embajador, Representante Permanente Alterno, Misión Permanente, Ginebra, gilliam.gomez@hondurasginebra.ch

Gilliam Noemi GÓMEZ GUIFARRO (Sra.), Primer Secretaria, Misión Permanente, Ginebra,
gilliam.gomez@hondurasginebra.ch

HONGRIE/HUNGARY

Mihály Zoltán FICSOR, Vice-President, Hungarian Intellectual Property Office, Budapest,
mihaly.ficsor@hipo.gov.hu

Szabolcs FARKAS, Vice-President, Hungarian Intellectual Property Office, Budapest,
szabolcs.farkas@hipo.gov.hu

Csaba BATICZ, Deputy Head, Industrial Property Law Section, Hungarian Intellectual Property Office, Budapest, csaba.baticz@hipo.gov.hu

INDE/INDIA

Anil Kumar RAI, Counsellor, Humanitarian Affairs, Permanent Mission, Geneva,
anilkrai@gmail.com

IRAN (RÉPUBLIQUE ISLAMIQUE D')/IRAN (ISLAMIC REPUBLIC OF)

Hamid AZIZI MORAD POUR, Head, Patent Commission and Member of Legal Committee, State Organization for Registration of Deeds and Properties, Tehran, hamidazizimp@gmail.com

Mohammad MOEIN ESLAM, Expert, Patent Commission and Member of Legal Committee, State Organization for Registration of Deeds and Properties, Tehran,
m.moeineslam@gmail.com

ISRAËL/ISRAEL

Michael BART, Director, PCT Department, Israeli Patent Office (IPO), Jerusalem,
michaelb@justice.gov.il

ITALIE/ITALY

Ivana PUGLIESE (Ms.), Senior Patent Examiner, General Directorate for the Fight Against Counterfeiting, Italian Patent and Trademark Office, Rome, ivana.pugliese@mise.gov.it

JAPON/JAPAN

Yoshinari OYAMA, Deputy Director, International Policy Division, Japan Patent Office (JPO), Tokyo, pa0800@jpo.go.jp

Yoshihiro NAGAHASHI, Deputy Director, International Cooperation Division, Japan Patent Office (JPO), Tokyo, pa0800@jpo.go.jp

Yoichi KANEKI, Assistant Director, Administrative Affairs Division, Japan Patent Office (JPO), Tokyo, pa0800@jpo.go.jp

Kunihiko FUSHIMI, First Secretary, Permanent Mission, Geneva, kunihiko.fushimi@mofa.go.jp

LETTONIE/LATVIA

Mara ROZENBLATE (Mrs.), Expert, Patent Office of the Republic of Latvia, Riga,
mara.royenblate@lrpv.gov.lv

LITUANIE/LITHUANIA

Vida MIKUTIENE (Ms.), Head, Applications Receiving and Document Management Division,
State Patent Bureau of the Republic of Lithuania, Vilnius, vida.mikutiene@vpb.gov.lt

MADAGASCAR

Haja RASOANAIVO, conseiller, Mission permanente, Genève

MAROC/MOROCCO

Karima FARAH (Mme), directeur, Pôle brevet et innovation, Office marocain de la propriété
industrielle et commerciale (OMPIC), Casablanca, farah@ompic.ma

MEXIQUE/MEXICO

Román SOTO TRUJANO, Subdirector Divisional de Procedimiento Administrativo de Patentes
Dirección Divisional de Patentes, Instituto Mexicano de la Propiedad Industrial, México, D.F.

Sara MANZANO MERINO, Asesor, Misión Permanente, Ginebra, smanzano@sre.gob.mx

NICARAGUA

Silvio ZAMBRABA, Ministro Consejero, Misión Permanente, Ginebra,
szambrana@cancilleria.gob.ni

NIGÉRIA/NIGERIA

Aisha Yunusa SALIHU (Mrs.), Senior Assistant Registrar, Trademarks, Patents and Designs
Registry, Federal Ministry of Trade and Investments, Abuja, sayishah@yahoo.com

Peters EMUZE, Chargé d'Affaires, Permanent Mission, Geneva, info@nigerian-mission.ch

Chichi UMESI (Ms.), First Secretary, Permanent Mission, Geneva, chichiumesi@yahoo.com

NORVÈGE/NORWAY

Dag BRAATEN, Senior Executive Officer, Legal Section, Patent Department, Norwegian
Industrial Property Office (NIPO), Oslo, dbr@patentstyret.no

Inger RABBEN (Ms.), Senior Adviser, Patent Department, Norwegian Industrial Property Office
(NIPO), Oslo, ira@patentstyret.no

NOUVELLE-ZÉLANDE/NEW ZEALAND

Mark PRITCHARD, Senior Advisor, Patent Practice, Intellectual Property Office of New Zealand, Ministry of Business Innovation and Employment, Wellington,
mark.pritchard@iponz.govt.nz

PANAMA

Zoraida RODRÍGUEZ MONTENEGRO (Sra.), Representante Permanente Alternativa, Misión Permanente ante la Organización Mundial del Comercio (OMC), Ginebra,
deputy@panama-omc.ch

POLOGNE/POLAND

Piotr CZAPLICKI, Director, Patent Examination Department, Patent Office of the Republic of Poland, Warsaw, pczaplicki@uprp.pl

Marek TRUSZCZYŃSKI, Deputy Director, Patent Examination Department, Patent Office of the Republic of Poland, Warsaw, mtruszczyński@uprp.pl

PORTUGAL

Susana ARMÁRIO (Ms.), Patent Examiner, National Institute of Industrial Property (INPI), Ministry of Justice, Lisbon, sarmario@inpi.pt

Filipe RAMALHEIRA, First Secretary, Permanent Mission, Geneva, ese1@missionportugal.ch

RÉPUBLIQUE DE CORÉE/REPUBLIC OF KOREA

CHOI Kyosook, Deputy Director, Patent System Administration Division, Korean Intellectual Property Office (KIPO), Daejeon, ks.choi@korea.kr

BAEK Jaehong, Senior Deputy Director, Multilateral Affairs Division, Korean Intellectual Property Office (KIPO), Daejeon, tultuly100@korea.kr

BAK Chulsung, Assistant Deputy Director, Korean Intellectual Property Office (KIPO), Daejeon, pppppcs@naver.com

RÉPUBLIQUE DOMINICAINE/DOMINICAN REPUBLIC

Ysset ROMAN (Ms.), Ministro Consejero, Misión Permanente ante la Organización Mundial del Comercio (OMC), Ginebra, ysset.roman@ties.itu.int

RÉPUBLIQUE POPULAIRE DÉMOCRATIQUE DE CORÉE/DEMOCRATIC PEOPLE'S
REPUBLIC OF KOREA

KIM Tong Hwan, Officer, National Coordinating Committee for WIPO, Democratic People's Republic of Korea (DPRK), Pyongyang, kim.myonghyok@gmail.com

KIM Myong Hyok, Second Secretary, Permanent Mission, Geneva, kim.myonghyok@gmail.com

RÉPUBLIQUE TCHÈQUE/CZECH REPUBLIC

Světlana KOPECKÁ (Ms.), Director, International Department, Industrial Property Office, Prague, skopecka@upv.cz

Eva SCHNEIDEROVÁ (Ms.), Director, Patents Department, Industrial Property Office, Prague, eschneiderova@upv.cz

RÉPUBLIQUE-UNIE DE TANZANIE/UNITED REPUBLIC OF TANZANIA

Loy MHANDO, Senior Assistant Registrar, Business Registrations and Licensing Agency (BRELA), Ministry of Industry and Trade, Dar es Salaam, loymhando@yahoo.com

ROUMANIE/ROMANIA

Monica SOARE-RADA (Ms.) Head, European Patents and PCT Section, State Office for Inventions and Trademarks (OSIM), Bucharest, monica.soare@osim.ro

Sandra CUJBA (Ms.), Examiner, Patent Administration Division, State Office for Inventions and Trademarks (OSIM), Bucharest, sandra.cujba@osim.romailto:adriana.aldescu@osim.ro

ROYAUME-UNI/UNITED KINGDOM

Hazel CRAVEN (Mrs.), Senior Legal Adviser, Patent Legal Section, Intellectual Property Office, Newport, hazel.craven@ipo.gov.uk

Anisah LIGHTWALLA (Ms.), Adviser, International Policy, Intellectual Property Office, London, anisah.lightwalla@ipo.gov.uk

SERBIE/SERBIA

Aleksandra MIHAILOVIĆ (Ms.), Head, Department for Legal Issues of Patents, Intellectual Property Office, Belgrade, amihailovic@zis.gov.rs

SINGAPOUR/SINGAPORE

Hoi Liong LEONG, Director, IPOS-International, Intellectual Property Office of Singapore (IPOS), Singapore, leong_hoi_liong@ipos.gov.sg

Alfred YIP, Deputy Director, Registries of Patents, Designs and Plant Varieties Protection, Intellectual Property Office of Singapore (IPOS), Singapore, simon_seow@ipos.gov.sg

SLOVAQUIE/SLOVAKIA

Luboš KNOTH, President, Industrial Property Office of Slovak Republic, Banská Bystrica, tomas.klinka@indprop.gov.sk

L'udmila HLADKÁ (Mrs.), Senior Expert, President's Office and International Affairs, Industrial Property Office of the Slovak Republic, Banská Bystrica, ludmila.hladka@indprop.gov.sk

Tomáš KLINKA, Adviser, Legal and International Affairs, Industrial Property Office of Slovak Republic, Banská Bystrica, tomas.klinka@indprop.gov.sk

SUÈDE/SWEDEN

Måns MARKLUND, Director, Quality Manager, Swedish Patent and Registration Office, Stockholm, mans.marklund@prv.se

Marie ERIKSSON (Ms.), Head, Legal Affairs, Swedish Patent and Registration Office, Stockholm, marie.eriksson@prv.se

SUISSE/SWITZERLAND

Beatrice STIRNER (Mme), conseillère juridique, Division du droit et des affaires internationales, Institut fédéral de la propriété intellectuelle (IPI), Berne, beatrice.stirner@ipi.ch

Tanja JÖERGER (Mme), conseillère juridique, Division du droit et des affaires internationales, Institut fédéral de la propriété intellectuelle (IPI), Berne, tanja.joerger@ipi.ch

Ursula SEIGRIED (Mme), conseillère juridique, Division du droit et des affaires internationales, Institut fédéral de la propriété intellectuelle (IPI), Berne, ursula.siegrfied@ipi.ch

Olaf BOEDTKER, expert, Division des brevets (IPI), Berne, dat.boedtker@ipi.ch

Franziskus WEISSBARTH, stagiaire, Division droit et affaires internationales, Institut fédéral de la propriété intellectuelle (IPI), Berne

THAÏLANDE/THAILAND

Sudkhet BORIBOONSRI, Counsellor, Permanent Mission to the World Trade Organization (WTO), Geneva, sudkhet82@hotmail.com

Piyapa SIRIVEERAPOS (Ms.), Intern, Permanent Mission to the World Trade Organization (WTO)

TRINITÉ-ET-TOBAGO/TRINIDAD AND TOBAGO

Richard ACHING, Manager, Technical Examination, Intellectual Property Office, Port of Spain,
richard.aching@ipo.gov.tt

TUNISIE/TUNISIA

Nafaa BOUTITI, sous-directeur, Institut national de la normalisation et de la propriété industrielle (INNORPI), Ministère de l'industrie, de l'énergie et des mines, Tunis,
nafaa.boutiti@innorpi.tn

TURQUIE/TURKEY

Serkan ÖZKAN, Patent Examiner, Patent Department, Turkish Patent Institute, Ankara,
serkan.ozkan@tpe.gov.tr

UKRAINE

Dmytro PAVLOV, Head, Right to Results of Scientific and Technical Activity Division, State Enterprise "Ukrainian Intellectual Property Institute" (SE UIPV), Kyiv, dmitry_pavlov@uipv.org

Valentyna KOMARKIVSKA (Ms.), Chief Expert, International Applications Division, State Enterprise "Ukrainian Intellectual Property Institute" (SE UIPV), Kyiv,
valentina_komarkivska@uipv.org

2. ORGANISATIONS INTERGOUVERNEMENTALES/ INTERGOVERNMENTAL ORGANIZATIONS

INSTITUT NORDIQUE DES BREVETS (NPI)/NORDIC PATENT INSTITUTE (NPI)

Grétar Ingi GRÉTARSSON, Vice Director, Taastrup, ggr@npi.int

OFFICE EUROPÉEN DES BREVETS (OEB)/EUROPEAN PATENT OFFICE (EPO)

Camille BOGLIOLO, Lawyer, Directorate 5.2.2, International Legal Affairs PCT, Munich,
cbogliolo@epo.org

Isabel Auria LANSAC (Ms.), Lawyer, Directorate 5.2.2, International Legal Affairs PCT, Munich,
iaurialansac@epo.org

Elena OVEJERO (Ms.), Administrator, Directorate Quality Analysis and Policy, Principal Directorate Quality Management, Munich, eovejero@epo.org

Piotr WIERZEJEWSKI, Administrator, Patent Procedures Management, Munich,
pwierzejewski@epo.org

Paul SCHWANDER, Director, Information Management, The Hague, pschwander@epo.org

II. OBSERVATEURS/OBSERVERS

1. ORGANISATIONS INTERGOUVERNEMENTALES/ INTERGOVERNMENTAL ORGANIZATIONS

ORGANISATION AFRICAINE DE LA PROPRIÉTÉ INTELLECTUELLE (OAPI)/ AFRICAN INTELLECTUAL PROPERTY ORGANISATION (OAPI)

Hamidou KONE, chef du Service des brevets et autres créations à caractère technique,
Yaoundé, kone_hamidou@yahoo.fr

ORGANISATION EURASIENNE DES BREVETS (OEAB)/EURASIAN PATENT ORGANIZATION (EAPO)

Dmitry ROGOZHIN, Director, Formal Examination Division, Deputy Director, Examination
Department, Moscow, rogozhin@eapo.org

ORGANISATION RÉGIONALE AFRICAINE DE LA PROPRIÉTÉ INTELLECTUELLE (ARIPO)/ AFRICAN REGIONAL INTELLECTUAL PROPERTY ORGANIZATION (ARIPO)

John KABARE, Senior Patent Examiner, Industrial Property, Harare, jkabare@aripo.org

SOUTH CENTRE

Emmanuel K, OKE, Intern, Innovation and Access to Knowledge Programme, Geneva,
oke@southcentre.int

2. ORGANISATIONS INTERNATIONALES NON GOUVERNEMENTALES/ INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS

Association asiatique d'experts juridiques en brevets (APAA)/Asian Patent Attorneys Association (APAA)

Shigeyuki NAGAOKA, Member, Patents Committee, Tokyo, snagaoka@konishinagaoka.com

Paul HARRISON, Co-Chair, Patents Committee, Sydney, paulharrison@shelstonip.com

Association européenne des étudiants en droit (ELSA International)/European Law Students' Association (ELSA International)

Miloš PUPIK, Head of Delegation, Brussels, milos.pupik@gmail.com

Felix MEYER, Delegate, Brussels, felix.meyer@meyer-und-meyer.eu

Philip GRAY, Delegate, Brussels, philipgray1@gmail.com

Claus Roland GAWEL, Delegate, Brussels, claus.gawel@gmail.com

Centre international pour le commerce et le développement durable (ICTDS)/International Center for Trade and Sustainable Development (ICTSD)

Michael BARRET, Junior Associate, Geneva, mbarrett@ictds.ch

Ahmed ABDEL LATIF, Senior Programme Manager, Geneva, abdellatif@ictsd.ch

Fédération internationale des conseils en propriété industrielle (FICPI)/International Federation of Intellectual Property Attorneys (FICPI)

Patrick ERK, German and European Patent Attorney, Berlin, patrick.erk@ficpi.org

Innovation Insights

Ania JEDRUSIK (Ms.), Policy Advisor, Geneva, ajedrusik@innovationinsights.ch

Institut des mandataires agréés près l'Office européen des brevets (EPI)/Institute of Professional Representatives before the European Patent Office (EPI)

Emmanuel SAMUELIDES, European Patent Attorney, Munich, msamuel@deslab.ntua.gr

Patent Information Users Group (PIUG)

Guido MORADEI, Delegate, Varese, guido.moradel@guaestio.it

3. ORGANISATIONS NATIONALES NON GOUVERNEMENTALES/
NATIONAL NON-GOVERNMENTAL ORGANIZATIONS

Asociación de Agentes Españoles Autorizados ante Organizaciones Internacionales de la Propiedad Industrial (AGESORPI)

Santiago JORDÁ PETERSEN, Representante, Barcelona, mail@curellsunol.es

Association américaine du droit de la propriété intellectuelle (AIPLA)/American Intellectual Property Law Association (AIPLA)

Brooke SCHUMM III, Chair, PCT Issues Committee, Baltimore, schumb@danmclaw.com

Association brésilienne de la propriété intellectuelle (ABPI)/Brazilian Association of Intellectual Property (ABPI)

Maurício TEXEIRA DESIDERIO, Industrial Property Agent, Rio de Janeiro, mdesiderio@dannemann.com.br

Association japonaise pour la propriété intellectuelle (JIPA)/Japan Intellectual Property Association (JIPA)

Takaaki KIMURA, International Activities Center, Tokyo, m.endo-jpaa@nifty.com

Yoshiteru MIZUMOTO, Expert, International Patent Committee, gyoumukokusai@jpaa.or.jp

Japan Patent Attorneys Association (JPAA)

Akio YOSHIOKA, Chairperson, International Patent Committee, Tokyo, a-yoshioka@da.jp.nec.com

Shinya HATA, Vice Chairperson, International Patent Committee, Tokyo, hata.shinya@jp.panasonic.com

Tatsuhiko UEKI, Member, International Patent Committee, Tokyo, ueki@hira.furukawa.co.jp

III. BUREAU/OFFICERS

Président/Chair: Victor PORTELLI (AUSTRALIE/AUSTRALIA)

Secrétaire/Secretary: Claus MATTHES (OMPI/WIPO)

IV. SECRETARIAT DE L'ORGANISATION MONDIALE DE LA PROPRIÉTÉ
INTELLECTUELLE (OMPI)/
SECRETARIAT OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

Francis GURRY, directeur général/Director General

John SANDAGE, vice-directeur général, Secteur des brevets et la technologie/Deputy Director General, Patents and Technology Sector

Matthew BRYAN, directeur, Division juridique du PCT/Director, PCT Legal Division

Janice COOK ROBBINS (Mme), directrice, Division des finances, Département des finances et de la planification des programmes, Secteur administration et gestion/Director, Finance Division, Department of Program Planning and Finance, Administration and Management Sector

Carsten FINK, économiste en chef, Division de l'économie et des statistiques/Chief Economist, Economics and Statistics Division

Claus MATTHES, directeur, Division du développement fonctionnel du PCT/Director, PCT Business Development Division

Matthias REISCHLE, directeur adjoint et chef, Section des affaires juridiques du PCT, Division juridique du PCT/Deputy Director and Head, PCT Legal Affairs Section, PCT Legal Division

Michael RICHARDSON, directeur adjoint, Division du développement fonctionnel du PCT/Deputy Director, PCT Business Development Division

Thomas MARLOW, administrateur chargé des politiques, Division du développement fonctionnel du PCT/Policy Officer, PCT Business Development Division

Silke WEISS (Mme), administratrice de programme, Section de la communication et des relations avec les utilisateurs du PCT, Division juridique du PCT /Program Officer, PCT Outreach and User Relations Section, PCT Legal Division

[End of Annex VII and of document]