

PCT NEWSLETTER

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The New WIPO Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge: PCT Implications

The new WIPO Treaty

As you may be aware, WIPO member states on 24 May 2024 approved a new [Treaty](#) related to intellectual property (IP), genetic resources and associated traditional knowledge. It is the first WIPO Treaty to address the interface between intellectual property, genetic resources and traditional knowledge and the first WIPO Treaty to include provisions specifically for Indigenous Peoples as well as local communities.

Once it enters into force (which will be after 15 Contracting Parties have acceded to or ratified it), the new Treaty will establish in international law a new disclosure requirement for patent applicants whose inventions are based on genetic resources and/or associated traditional knowledge. This will mean that where a claimed invention in a patent application is based on genetic resources, each Contracting Party will require applicants to disclose the country of origin or source of the genetic resources. And where a claimed invention in a patent application is based on traditional knowledge associated with genetic resources, each Contracting Party will require applicants to disclose the Indigenous Peoples or local community, as applicable, who provided the traditional knowledge.

Implications for the PCT

An Agreed Statement contained in Footnote 4 of the new Treaty (under Article 7) states:

“The Contracting Parties request the Assembly of the International Patent Cooperation Union to consider the need for amendments to the Regulations under the PCT and/or the Administrative Instructions thereunder with a view towards providing an opportunity for applicants who file an international application under the PCT designating a PCT Contracting State which, under its applicable national law, requires the disclosure of genetic resources and traditional knowledge associated with genetic resources, to comply with any formality requirements related to such disclosure requirement either upon filing of the international application, with effect for all such Contracting States, or subsequently, upon entry into the national phase before an Office of any such Contracting States.”

The International Bureau will monitor developments related to the new Treaty and, when appropriate, support the PCT Contracting States in implementing the new Treaty obligations, as referred to in the footnote, in the PCT. In the meantime, the International Bureau stands ready

Don't miss out on our upcoming PCT Seminars, Webinars, and other PCT-related events – consult the PCT Seminar Calendar in this issue!

to respond to any questions and requests for further information that PCT Contracting States and PCT users may have.

Amendments to the PCT Regulations – Entry into Force on 1 July 2024 (Reminder)

It is recalled that the Assembly of the PCT Union (PCT Assembly) that was held from 6 to 14 July 2023 adopted amendments to the PCT Regulations that will enter into force on 1 July 2024. The amendments are as follows:

- Amendments to PCT Rules 26 and 29, relating to the procedure when an international application contains parts in different languages and all such languages are accepted by the competent receiving Office;
- Amendments to the French text of Rule 82^{quater}.3(c) to resolve an inconsistency between the English and French texts of this Rule.

A PowerPoint presentation showing the amendments to the PCT Regulations is available at:

https://www.wipo.int/pct/en/texts/rule_changes_archive.html

Patent Cooperation Treaty and Regulations

The publication containing the text of both the Patent Cooperation Treaty and the Regulations (WIPO Publication 274), updated as of 1 July 2024 in Arabic, Chinese, English, French, German, Italian, Portuguese, Russian and Spanish, will be available as from that date, in PDF format, at:

<https://www.wipo.int/publications/en/details.jsp?id=4739>

Separate PDF versions of the texts of the Patent Cooperation Treaty and the Regulations under the PCT are already available in those languages at:

<https://www.wipo.int/pct/en/texts/index.html>

You can select languages other than English and Italian at the top right-hand side of the page.

PCT Statistics 2024

The PCT Yearly Review, 2024 edition

The 2024 edition of the *PCT Yearly Review* summarizes PCT activities and developments in 2023. It contains a comprehensive set of statistics relating to PCT filings and the performance of the international patent system in 2023 (including filings by top countries of origin, by top applicants and by technological fields, as well as statistics on participation of women inventors in PCT applications), and also contains statistics relating to national phase entries in 2022 (the latest available year). The PCT Yearly Review also features information on the special theme mentioned below, and includes a summary of the advantages of the PCT.

The special theme in this year's edition of the *PCT Yearly Review* provides a descriptive analysis of "The technological composition of PCT applications". The use of the PCT System has expanded considerably over the past two decades, with substantial shifts in the technological composition of PCT applications. These changes have important implications for the patent system, primarily by increasing the demand for patent drafting and examination skills

in certain technology fields more than in others. More broadly, the evolving technological composition of PCT filings reflects changes in the direction of innovation. These changes have taken place globally, driven largely by emerging technological opportunities. However, they have also occurred at the level of individual countries, with some economies aligning more closely with global trends than others, depending on their technological specialization.

The *PCT Yearly Review* is available in English at:

<https://www.wipo.int/publications/en/details.jsp?id=4740&plang=EN>, and

<https://www.wipo.int/pct/en/activity/index.html>

An Executive Summary will be available shortly in the following nine languages: Arabic, Chinese, English, French, German, Japanese, Korean, Russian and Spanish.

PCT Patent Prosecution Highway (PCT-PPH) Pilots

New two-way PCT-PPH pilot program (National Institute of Industrial Property (Chile) – EPO)

On 1 June 2024, a new two-way PCT-PPH pilot program started between the National Institute of Industrial Property (Chile) and the European Patent Office (EPO). Under this program, accelerated processing in the national phase in one Office is available on the basis of a PCT application with a positive written opinion from either the International Searching Authority (ISA) or the International Preliminary Examining Authority (IPEA), or a positive international preliminary report on patentability (IPRP) (Chapter II) (that is, where at least one of the claims has been determined as patentable), issued by the other Office in its capacity as ISA/IPEA.

Further information on the above-mentioned PCT-PPH agreement is available at:

<https://www.epo.org/en/legal/official-journal/2024/05/a56.html>

[https://www.inapi.cl/docs/default-source/2023/patentes/guias-pph/guia_pph_epo_20231124-\(1\).pdf](https://www.inapi.cl/docs/default-source/2023/patentes/guias-pph/guia_pph_epo_20231124-(1).pdf)

The PCT-PPH page of the PCT website has been updated to include information on this new pilot at:

www.wipo.int/pct/en/filing/pct_pph.html)

Change to Publication Schedule

Publication of 1 August 2024

Due to the fact that Thursday, 1 August 2024, will be a non-working day at WIPO, the PCT applications (as well as any *Official Notices (PCT Gazette)*) which would normally have been published on that day will be published on Friday, 2 August 2024. The date of completion of technical preparations for that publication will, however, remain unchanged, and any changes that should be taken into account for the purposes of international publication should be received by the International Bureau by midnight (Central European Summer Time (CEST)) on Tuesday, 16 July 2024.

Combined July-August Issue

The next issue of the *PCT Newsletter* will be a joint July-August issue that will be published at the beginning of August. If, between the publication of this issue and the July-August issue, there is important PCT news that users should be aware of, we will announce it by way of the PCT e-mail updating service and in the News section of the main PCT webpage. If you have not already subscribed to this service, which notifies PCT users when each issue of the *PCT Newsletter* becomes available and makes important ad hoc announcements when necessary, you can subscribe to it, free of charge at:

https://www3.wipo.int/newsletters/en/#pct_newsletter

Please note that if there are any changes to the PCT Seminar Calendar or the PCT Fee Tables before the publication of the July-August issue, they will be updated at, respectively:

<https://www.wipo.int/export/sites/www/pct/en/docs/seminar-calendar.pdf>

<https://www.wipo.int/export/sites/www/pct/en/docs/fees.pdf>

PCT Information Update

BR Brazil (location and mailing address; number of copies of the international application)

The location and mailing address of the National Institute of Industrial Property (Brazil) has changed, as follows:

Location: Rua Mayrink Veiga, 9
20° andar
Centro
Rio de Janeiro
RJ – CEP 20.090-910
Brazil

The Office has also notified the International Bureau (IB) that it now requires one paper copy of the international application, instead of three, if the application is filed on paper.

(Updating of *PCT Applicant's Guide*, Annex B and Annex C (BR))

CA Canada (fees)

The Canadian Intellectual Property Office has notified the IB of a new amount of the maintenance fee component of its national fee, payable in CAD to the Office in its capacity as designated (or elected) Office, with effect from 29 July 2024. This amount, payable in respect of each one-year period and due at the time of entry into the national phase, where that entry is effected on or after the 2nd or possibly 3rd anniversary of the international filing date, is CAD 56.21 if the applicant is a small entity.

(Updating of *PCT Applicant's Guide*, National Chapter, Summary (CA))

QA Qatar (e-mail address)

The e-mail addresses of the Intellectual Property Department (Qatar) have changed, as follows:

E-mail: malnoaimi@moci.gov.qa
falmotawa@moci.gov.qa
patent-ip@moci.gov.qa

(Updating of *PCT Applicant's Guide*, Annex B1 (QA))

Search fee and fees relating to the international search (Austrian Patent Office, Intellectual Property Office of Singapore, Japan Patent Office)

As from 1 July 2024, there will be a change in the amount payable in EUR for an international search carried out by the Austrian Patent Office, as indicated in Fee Table I(b) (the equivalent amounts in CHF, KRW, SGD, USD and ZAR will be established shortly). There will also be a change in the amount of the following fee payable from the same date:

Additional search fee:EUR 1,845

Furthermore, as from 1 August 2024, there will be a change in the equivalent amounts payable in JPY for an international search carried out by the Intellectual Property Office of Singapore, and the equivalent amounts payable in EUR and SGD for an international search carried out by the Japan Patent Office. The new amounts are indicated in Fee Table I(b).

(Updating of *PCT Applicant's Guide*, Annex D (AT, JP and SG))

Modified Administrative Instructions under the PCT

With effect from 1 July 2024, Sections 305*bis*, 308, 707 and 804 of the Administrative Instructions under the PCT have been modified.

The revised Administrative Instructions containing these modifications are available in Chinese, English, French, Russian and Spanish, in PDF format, on the right-hand side of the page at, respectively:

<https://www.wipo.int/pct/zh/texts/index.html>

<https://www.wipo.int/pct/en/texts/index.html>

<https://www.wipo.int/pct/fr/texts/index.html>

<https://www.wipo.int/pct/ru/texts/index.html>

<https://www.wipo.int/pct/es/texts/index.html>

The texts in English and French are also available in HTML format.

The revised text in Japanese will be available shortly, at:

<https://www.wipo.int/pct/ja/texts/index.html>

The above-mentioned changes are explained in more detail in Circular C. PCT 1668 at:

<https://www.wipo.int/pct/en/circulars/>

Modified PCT Receiving Office Guidelines

The *PCT Receiving Office Guidelines* have been modified with effect from 1 July 2024. For further details please refer to Circular C. PCT 1674 at:

<https://www.wipo.int/pct/en/circulars/>

The consolidated version of the *PCT Receiving Office Guidelines* will be available shortly on the WIPO website at:

<https://www.wipo.int/pct/en/texts/gdlines.html>

New/Updated PCT Resources

Modified PCT Regulations (July 2024)

For further information on the new consolidated version of the PCT Regulations, as in force from 1 July 2024, please refer to “Patent Cooperation Treaty and Regulations”, above.

PowerPoint presentation about amendments to the PCT Regulations

As mentioned in “Amendments to the PCT Regulations”, above, a PowerPoint presentation showing the amendments to the PCT Regulations that will enter into force on 1 July 2024 is now available in Chinese, English, French, German, Japanese, Portuguese, Russian and Spanish at:

https://www.wipo.int/pct/en/texts/rule_changes_archive.html

PCT resources available in Chinese

The following PCT resources have been translated into Chinese, and are available on the PCT website:

- *PCT Receiving Office Guidelines*:

<https://www.wipo.int/export/sites/www/pct/zh/docs/guide/gdvol1.pdf>

- *International Search and Preliminary Examination Guidelines*:

<https://www.wipo.int/export/sites/www/pct/zh/docs/guide/gdvol2.pdf>

New ePCT video tutorials

ePCT video tutorials for IP Offices

The collection of ePCT video tutorials for IP Offices is now available in French.

The videos provide step-by-step demonstrations of how to use the main ePCT Office functionalities and are available at:

https://www.wipo.int/pct/fr/epct/tutorials_offices.html

WIPO Webinar – IP & Women: Patents, the Patent Cooperation Treaty (PCT) and Sustainable Development Goals (SDGs)

A training session organized by WIPO and the Intellectual Property Office of the Philippines (IPOPIL) will be held online 27 June 2024. The webinar, which is free, is designed specifically for women innovators and entrepreneurs and aims to provide insights into the patent system, the Patent Cooperation Treaty (PCT), and how these can be leveraged to advance the Sustainable Development Goals (SDGs). Participants will gain valuable knowledge to navigate the intellectual property landscape and contribute to sustainable innovation.

Although this webinar is mainly aimed at women in the Philippines and all member States of ASEAN, registration is open to all women everywhere who are interested in innovation & intellectual property.

Further information and registration for the webinar is available at:

https://www.wipo.int/meetings/en/details.jsp?meeting_id=83768

Practical Advice

Naming of the inventor

Q: I am a European Patent Agent. My client filed a European patent application in which he waived his right to be mentioned as an inventor. Now he intends to file a PCT application and again does not wish to be mentioned. Is it equally possible in a PCT application to indicate the name of the inventor but keep it confidential?

A: As a general matter, Article 4^{ter} of the Paris Convention for the Protection of Industrial Property guarantees inventors the right to be acknowledged in the patent document and many national or regional patent systems require that the name of the inventor be indicated when the application is filed. Occasionally, inventors wish that their names remain confidential. However, unlike, for example, the European patent system where your client was able to waive his right to be mentioned (Rule 20.1 of the Implementing Regulations to the European Patent Convention) that is, to have his name included in the application and simply request that it remains confidential without any further conditions to be met, the PCT system does not provide a similar mechanism for inventors to request that their name not be made publicly accessible.

Under the PCT system, the only way to ensure that the name of the inventor is not disclosed would be to omit the inventor's name from the international application. And doing so would then oblige the applicant to provide the name of the inventors to each designated Office upon entry into the national phase. Although Contracting States, in their capacity as designated States, do not generally require that the name of the inventor be furnished at the time of filing, most designated Offices would require that the names of the inventors be provided at least upon national phase entry (please refer to PCT Rules 4.1(a)(iv), 4.1(c) and 4.6 for further information).

Therefore, to avoid any problems or delays in the national phase, it is strongly recommended to furnish this information in the international phase, noting that in most Contracting States, the inventors' names will in any event be required and made publicly available during the national phase, subject to any national data protection laws which might apply.

Where indications concerning the inventor are included or added in time under PCT Rule 92^{bis} (before technical preparations for international publication are completed), they will appear in

the international publication in accordance with PCT Rule 48.2(b)(i) and Section 406(c) and Annex D, item 4, of the Administrative Instructions under the PCT. Where inventor data is added later (after publication but before the expiration of 30 months from the priority date) under PCT Rule 92*bis*, the bibliographic data tab on PATENTSCOPE will be updated accordingly and this information will be publicly accessible under Rule 94 as part of the application file held at the International Bureau. Any notice requesting that the name of the inventor not be disclosed will not have any effect if submitted in relation to a PCT application.

Under current procedures, privacy considerations are taken into account to some extent in relation to the inventors' postal addresses and email addresses, in so far as they are excluded from the text-form data displayed in the "PCT Biblio. Data" tab of PATENTSCOPE (as opposed to the published application which is accessible only in image format). As a consequence, these addresses are not searchable by Internet search engines. It should also be noted that the PCT does not require that the address indicated for the inventor in the request form be the inventor's "home" address (PCT Rule 4.4(c)). Instead, the employer's address may be indicated as the inventor's address.

As previously mentioned, most PCT Contracting States mandate that the inventor be indicated in the patent application process. Therefore, it is strongly advised to provide the inventor's name during the international phase.

For further information on the requirement of each designated Office regarding the furnishing of the name and address of the inventor, please refer to Annex B of the *PCT Applicant's Guide* (www.wipo.int/pct/en/guide/index.html).

