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INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY

Thirty-Eighth (22nd Extraordinary) Session Geneva, September 22 to 30, 2008

PCT WORKING GROUP: REPORT OF THE FIRST SESSION

Memorandum prepared by the International Bureau

SUMMARY

1. This document sets out the results of the first session of the Patent Cooperation Treaty (PCT) Working Group ("the Working Group"), held in Geneva from May 26 to 30, 2008.

INTRODUCTION

2. The Assembly at its thirty-sixth (16th Ordinary) session, held in Geneva in September-October 2007, considered a memorandum prepared by the International Bureau (document PCT/A/36/1) on the status of the work being undertaken in connection with reform of the PCT, including the results of the session of the Working Group on Reform of the PCT which had been held since the Assembly's 2006 session.

3. Among other things, the memorandum contained a recommendation to the Assembly that it formally declare that the work of both the Committee on Reform of the PCT and the Working Group on Reform of the PCT had been completed and that the mandate of both bodies, which were established by the Assembly at its 29th session in 2000 and at its 30th session in 2001, respectively, had come to an end (document PCT/A/36/1, paragraphs 24 and 25(ii)).

4. During the Assembly's considerations of the memorandum, the Secretariat proposed that, should the need arise to consider a matter which required submission to the Assembly, a Working Group of the PCT Assembly should be convened to do preparatory work rather than submitting the matter straight to the Assembly. The Secretariat further proposed that, subject to the availability of sufficient funds, the same financial assistance that had been made available to enable attendance of certain delegations at the sessions of the Committee and the Working Group on Reform of the PCT should also be made available to enable attendance of certain delegations at the sessions of the new Working Group. Those financial arrangements were that the Organization had offered financial assistance to two countries per region so as to enable one delegate from each country to attend sessions; in addition, the same financial assistance was offered to China and to three regional Offices, namely, ARIPO, OAPI and the Eurasian Patent Office (document PCT/A/36/13, paragraph 133).

5. The Assembly (document PCT/A/36/13, paragraph 134):

> "(i) noted the report of the ninth session of the Working Group on Reform of the PCT contained in document PCT/R/WG/9/8 and reproduced in Annex I of document PCT/A/36/1;
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> "(ii) decided that the work of both the Committee on Reform of the PCT and the Working Group had been completed and that the mandate of both bodies, which were established by the Assembly at its 29th session in 2000 and at its 30th session in 2001, respectively, had come to an end; and
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> "(iii) approved the proposal concerning the convening of a new Working Group, and the proposal to offer financial assistance to enable attendance of certain delegations at the sessions of that Working Group, as set out in paragraph 133 [of document PCT/A/36/13] …".

6. Pursuant to the Assembly's decision, and following consultation with PCT Member States and users of the PCT system concerning the possible convening of a session of the Working Group prior to the September 2008 session of the Assembly, the Director General convened the first session of the Working Group in Geneva from May 26 to 30, 2008.

7. At its first session, the Working Group agreed that the report of the session (document PCT/WG/1/16) should be submitted to the Assembly at its present session to inform the Assembly of the discussions and decisions that had been made at that session (document PCT/WG/1/16, paragraph 169).

8. That report, which sets out the status of the matters discussed by the Working Group, noting the range of views expressed and areas where agreement had been reached, is reproduced in the Annex to this document.

FIRST SESSION OF THE PCT WORKING GROUP

9. The matters considered and the results of their consideration at the first session of the Working Group are outlined in the following paragraphs. In particular, the Working Group agreed that a number of proposed amendments of the Regulations[1] should be submitted to the Assembly for adoption at its present session. The proposals are set out in document PCT/A/38/2.

10. *Supplementary international search: further consequential amendments (document PCT/WG/1/16, paragraphs 98 to 105).* The Working Group agreed on proposed amendments of Rules *45bis.2 and 3;* 90.1, 4 and 5; and 90*bis*.5 and 6, and the proposed addition of new Rule 90*bis*.3*bis*, with a view to their submission to the Assembly for consideration at its present session (document PCT/A/38/2).

11. *Processing under Article 14(4) (document PCT/WG/1/16, paragraphs 135 to 139).* The Working Group agreed on proposed amendments of Rule 29.4 with a view to their submission to the Assembly for consideration at its present session (document PCT/A/38/2).

12. *Amendment of claims (document PCT/WG/1/16, paragraphs 144 to 149).* The Working Group agreed on proposed amendments of Rules 46.5 and 66.8 with a view to their submission to the Assembly for consideration at its present session (document PCT/A/38/2).

13. *Timeliness of the international search and examination (document PCT/WG/1/16, paragraphs 12 to 18).* While sharing concerns concerning the late establishment of international search reports and written opinions under Chapter I of the Treaty, the Working Group agreed that the problem of late international search reports was best addressed in the context of continuing discussions by the Meeting of International Authorities and the Working Group related to improving the quality and timeliness of the international search, rather than by adjusting the time limit for entering the national phase.

14. *International form for national phase entry (document PCT/WG/1/16, paragraphs 19 to 25).* The Working Group agreed that further consideration should be given to the possibility of providing streamlined means for entering the national phase and invited the Secretariat to study the matter and report to the Working Group on its feasibility.

15. *Enhancing the value of international search and preliminary examination under the PCT (document PCT/WG/1/16, paragraphs 26 to 61).* The Working Group welcomed the document prepared by the International Bureau as important, timely and useful. The issues which it set out were considered to form a useful background for exploring how the use of the PCT could be improved to meet the needs of a continually growing number of users in a modern context. The Working Group proceeded to a detailed discussion on how the operation of the PCT system as a whole, especially the conduct of international search and preliminary

[1] References in this document to "Articles" and "Rules" are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT ("the Regulations"), or to such provisions as proposed to be amended or added, as the case may be. References to "national laws", "national applications", "the national phase", etc., include references to regional laws, regional applications, the regional phase, etc.

examination, the presentation and transmission of its results, and the use of those results by designated Offices, might be improved to use the PCT system to its full potential and to maximize its value to applicants and designated Offices.

16. In this context, the Working Group agreed, in particular, that, in view of the decline in the use of Chapter II and the corresponding reduction in workload for International Preliminary Examining Authorities, it may be appropriate to review the general approach taken in Chapter II processing, with a view to considering how to encourage applicants to overcome deficiencies in the application during the international phase rather than only after national phase entry, for example, by giving more opportunity for dialogue with the examiner, or by encouraging increased collaboration between the applicant and the Authority. The Working Group invited the International Bureau to further study the issue with a view to submitting more specific recommendations to the Working Group at its next session.

17. *Filing and processing of sequence listings under the PCT; processing of computer program listings (document PCT/WG/1/16, paragraphs 62 to 64).* There was general support for proposed modifications of the Administrative Instructions to no longer permit the filing of "mixed mode" sequence listing applications and for the proposed measures to provide a greater incentive for applicants to submit a searchable text file of the sequence listing from the outset, as part of the international application, thereby reducing the processing required by receiving Offices, the International Bureau and International Authorities alike in handling multiple versions of sequence listings.

18. There was no support for a proposal to modify the Administrative Instructions to allow for the filing of "mixed mode" computer program listing applications.

19. *Physical requirements of the international application (document PCT/WG/1/16, paragraphs 65 to 89).* The Working Group discussed possible changes to the physical requirements of international applications aimed at facilitating electronic processing and especially improving the quality of the optical character recognition (OCR) process, having regard to the consequences for national phase processing and for national applications to which requirements may be extended under the Patent Law Treaty (PLT).

20. The Working Group agreed that the Secretariat should submit a report to the ST.22 task force of the Standards and Documentation Working Group of the Standing Committee on Information Technologies (SCIT/SDWG) on the proposals related to optical character recognition, taking into account the comments thereon made by the Working Group. It further agreed that the International Bureau should develop further recommendations in relation to the physical requirements of the international application, taking into account the comments made by the Working Group and any conclusions reported by the ST.22 Task Force and the SCIT/SDWG, and in particular should develop proposals for modifying the PCT Receiving Office Guidelines to clarify cases in which a requirement stipulated in the Regulations need not be strictly enforced by receiving Offices in the international phase

21. The Working Group further decided that the SCIT/SDWG should be invited to make recommendations on technical standards appropriate for color photographs and drawings in both patent and trademark applications.

22. *Criteria for addition of languages of publication under the PCT (document PCT/WG/1/16, paragraphs 90 to 97).* Those delegations which took the floor on the matter expressed general support for the suggested criteria for assessing future requests for the addition of languages of publications that were developed by the Secretariat. The Working Group noted that the Secretariat was considering the submission to the present session of the Assembly of a draft common understanding setting out those criteria, taking into account the views expressed by the Working Group (document PCT/A/38/4).

23. *Transmittal of the international application, translations and related documents (document PCT/WG/1/16, paragraphs 106 to 113).* The Working Group noted with approval the International Bureau's plans to offer a service whereby the receiving Office would be able (with the agreement of the International Bureau and the International Searching Authority) to transmit the search copy and other documents necessary for international search to the International Searching Authority in electronic form via the International Bureau, using the receiving Office's existing communication link to the International Bureau, for example, via the Electronic Data Interchange (EDI) system.

24. *Incorporation by reference of missing elements and parts of the international application (document PCT/WG/1/16, paragraphs 114 to 127).* The Working Group agreed to refer proposals for amendments of the PCT Regulations relating to the procedure in the case of confirmation of incorporation by reference of missing elements or parts of the international applications to the Secretariat for further consideration.

25. In this context, the Working Group agreed that the PCT Receiving Office Guidelines should be modified to clarify the procedures to be followed where the incorporation by reference resulted in a duplicated set of descriptions, claims or drawings.

26. *Rectification of obvious mistakes (document PCT/WG/1/16, paragraphs 128 to 134).* There was no agreement in the Working Group that proposed amendments to the Regulations, permitting the contents of the request to be taken into account for the purposes of considering whether mistakes in the description, claims or drawings were obvious and thus rectifiable, be submitted to the Assembly at this stage.

27. *Treatment of extraneous matter (document PCT/WG/1/16, paragraphs 140 to 143).* The Working Group agreed that the PCT Receiving Office Guidelines should be modified to clarify that, where it was not apparent to the receiving Office whether certain papers were or were not filed as part of the international application, the Office should invite the applicant to clarify the situation within a time limit, following which, if no such clarification had been provided, the papers concerned would be disregarded.

28. *Claims fees and searching of independent claims (document PCT/WG/1/16, paragraphs 150 to 160).* Following extensive discussions in the Working Group, the Chair concluded that there was broad support for further consideration of the proposal for the introduction of claims fees within the PCT, and that a more detailed proposal would be useful in this regard. The International Bureau could also assist in the investigation of a suitable legal basis. Noting that a number of possible flexibilities had been mentioned which might alleviate the concerns of some delegations in connection with the proposed limitation of the international search to one independent claim per category, a more detailed proposal on that question could also be provided.

29. *Section headings in PCT applications vis-à-vis the Trilateral Offices' "Common Application Format" (document PCT/WG/1/16, paragraphs 161 to 164).* The Working Group noted a presentation given by one delegation on the Common Application Format developed by the European Patent Office, the Japan Patent Office and the United States Patent Office (the "Trilateral Offices") in the course of their trilateral cooperation. It further noted that related proposals for modifications to the Administrative Instructions (concerning recommended headings used in the international application) would shortly be the subject of regular consultations under Rule 89.2, as part of a bigger package of proposed modifications of the Administrative Instructions.

FURTHER WORK

30. The Working Group noted a statement by the Secretariat that it intended, as it had done in preparation for the present session of the Working Group, to send, towards the end of 2008, a Circular to all members and observers of the Working Group, inviting proposals for matters to be discussed by the Working Group, in order to determine whether a session of the Working Group should be convened in the first half of 2009.

31. The Working Group agreed to recommend to the Assembly that, subject to the availability of sufficient funds:

(i) one session of the Working Group should, if necessary, subject to the consultations mentioned in paragraph 30, above, be convened between the September 2008 and September 2009 sessions of the Assembly; and

(ii) the same financial assistance that had been made available to enable attendance of certain delegations at the May 2008 session of the Working Group should be made available to enable attendance of certain delegations at that next session.

32. The Assembly is invited:

(i) to note the report of the first session of the PCT Working Group contained in document PCT/WG/1/16 and reproduced in the Annex of this document;

(ii) to approve the recommendation concerning the further work of the PCT Working Group set out in paragraph 31, above.

[Annex follows]

ANNEX

REPORT OF THE FIRST SESSION OF THE PCT WORKING GROUP

(adopted by the Working Group; reproduced from document PCT/WG/1/16)

INTRODUCTION

1. The Patent Cooperation Treaty Working Group held its first session in Geneva from May 26 to 30, 2008.

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): Albania, Angola, Australia, Austria, Belgium, Brazil, Cameroon, Canada, China, Colombia, Côte d'Ivoire, Cuba, Denmark, Dominican Republic, El Salvador, Finland, France, Germany, Hungary, Israel, Italy, Japan, Lao People's Democratic Republic, Latvia, Libyan Arab Jamahiriya, Lithuania, Malaysia, Mexico, Moldova, Netherlands, Norway, Poland, Portugal, Republic of Korea, Romania, Russian Federation, Serbia, Singapore, Slovakia, Slovenia, South Africa, Spain, Sudan, Sweden, Switzerland, Trinidad and Tobago, Tunisia, Turkey, Ukraine, United Kingdom, United States of America; (ii) the European Patent Office (EPO).

3. The following Member States of the International Union for the Protection of Industrial Property (Paris Union) participated in the session as observers: Argentina, Haiti, Saudi Arabia, Thailand.

4. The following intergovernmental organizations were represented by observers: African Intellectual Property Organization (OAPI), African Regional Intellectual Property Organization (ARIPO), African Union (AU), Eurasian Patent Organization (EAPO), European Community, World Trade Organization (WTO).

5. The following international non-governmental organizations were represented by observers: Asian Patent Attorneys Association (APAA), Businesseurope, Centre for International Industrial Property Studies (CEIPI), International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP), International Association for the Protection of Intellectual Property (AIPPI), International Federation of Industrial Property Attorneys (FICPI), Institute of Professional Representatives Before the European Patent Office (EPI).

6. The following national non-governmental organizations were represented by observers: German Association for the Protection of Industrial Property and Copyright (GRUR), Japan Patent Attorneys Association (JPAA), Intellectual Property Institute of Canada (IPIC).

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

OPENING OF THE SESSION

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

ELECTION OF A CHAIR AND TWO VICE-CHAIRS

9. The Working Group unanimously elected Mr. Alan Troicuk (Canada) as Chair for the session, and Mr. Yin Xintian (People's Republic of China) and Mr. Gennady Negulyaev (Russian Federation) as Vice-Chairs.

ADOPTION OF THE AGENDA

10. The Working Group adopted as its agenda the draft contained in document PCT/WG/1/1 Rev. 2[2].

PROPOSALS BY ISRAEL

11. Discussions were based on document PCT/WG/1/2. Upon the suggestion of the Chair, the Working Group agreed to discuss, under item 4(a) of the agenda, only the proposals outlined in sections 2 and 5 of the Annex to document PCT/WG/1/2, and to discuss the remaining proposals by Israel outlined in sections 1, 3 and 4 of that Annex under agenda items 4(e), 4(c) and 4(d), respectively.

Timeliness of the International Search and Examination (section 2 of annex to document PCT/WG/1/2)

12. One delegation expressed its support for the general concept of the proposal by Israel to grant more time for applicants to enter the national phase where the international search report is not available at the expiration of 30 months from the priority date, provided that appropriate language could be found to implement such a change within the framework of Articles 22 and 39 of the Treaty[3].

13. All other delegations which took the floor on this matter, while sharing the concerns raised by the Delegation of Israel concerning the late establishment of international search reports and written opinions under Chapter I of the Treaty, stated that they could not support the proposal, considering that discussions should instead focus on how to improve the quality of international search reports and, in particular, their timeliness, in accordance with the obligations of International Searching Authorities.

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[2] This and the working documents for the session are available on WIPO's website at http://www.wipo.int/meetings/en/details.jsp?meeting_code=pct/wg/1.

[3] References in this document to "Articles" and "Rules" are, unless otherwise indicated, to those of the Patent Cooperation Treaty ("PCT" or "the Treaty") and the Regulations under the PCT ("the Regulations"), or to such provisions as proposed to be amended or added, as the case may be. References to "national laws", "national applications", "the national phase", etc., include reference to regional laws, regional applications, the regional phase, etc. References to an "Authority" or "International Authority" are to an International Searching Authority and/or International Preliminary Examining Authority, as the case requires. References to "the Assembly" are to the International Patent Cooperation Union (PCT Union) Assembly.

14. A number of possible causes for delay in the establishment of international search reports were mentioned by delegations, such as late receipt of the search copy by the International Authority, matters relating to the issue of unity of invention, and delays in the payment of fees, and it was felt that a careful analysis should be carried out before moving to amend the legal framework. Some delegations noted that any prolongation of the time limit for national phase entry would add to the uncertainty as to the status of an international application, causing disadvantage to third parties and the general public.

15. One representative of users suggested that International Authorities should review the list of States for which they were willing to act as competent Authority, with the aim of broadening their competency to include all States whose national Offices did not themselves act as an International Authority.

16. Another representative of users expressed the view that applicants should be entitled to a refund of the international search fee where the international search report was not available in time for national phase entry at 30 months from the priority date.

17. Another representative of users suggested that, rather than delaying national phase entry, applicants should be required to enter the national phase within the current 30 month time limit but should be given more time after national phase entry to furnish the translations required for national phase processing, which accounted for the largest part of the costs involved.

18. The Working Group agreed that the problem of late international search reports was best addressed in the context of continuing discussions by the Meeting of International Authorities and the Working Group related to improving the quality and timeliness of the international search, rather than by adjusting the time limit for entering the national phase.

International Form for National Phase Entry (section 5 of annex to document PCT/WG/1/2)

19. The Secretariat recalled that earlier discussions on a proposal similar to that now presented by the Delegation of Israel had taken place during the fifth session of the Working Group on Reform of the PCT. During those discussions, some delegations had noted that their Offices' national phase entry forms required extensive details and that there was no uniformity as to the contents of the forms used by the various Offices, and thus felt that it would not be practicable to establish a form including all such details for all Offices. Other delegations had felt that a simple standardized form which could optionally be used to enter the national phase before a number of designated Offices would be useful for applicants and for at least some Offices, while noting that further details would have to be provided later to certain Offices. It had been noted during those discussions in the Working Group that a form acceptable as a minimum requirement could also have a harmonizing effect on national phase entry requirements in the longer term.

20. The Secretariat further noted that the Working Group on Reform of the PCT had agreed that further consideration should be given at a subsequent session to the possibility of providing streamlined means for entering the national phase, and had invited the Secretariat to make proposals including a suitable draft form. The Secretariat had undertaken some work on this but had not succeeded in developing a satisfactory draft form, due to the complexity of the issues involved.

21. Several delegations, while expressing sympathy with the aims of the proposal by Israel, expressed concerns as to its feasibility, in particular in light of the diverse requirements of national Offices, and felt that it would be almost impossible to draft a form which would be useful in practice for a significant number of applicants and Offices. One delegation noted that the proposal to adapt the PCT-SAFE software to include such a new national phase entry form might be misleading for applicants should they assume that, by simply filling in one form, they had complied with the requirements of all designated Offices which, due to the complexities and differences in national laws, was not an achievable objective.

22. One delegation expressed the view that it would not be proper for the PCT to intervene in what essentially were national phase matters that should be left to the national Offices and their applicable laws.

23. One delegation stressed the fact that the main purpose of the proposal was not to harmonize national phase entry requirements but rather to design a form which would take existing national requirements into account.

24. The Secretariat recalled that, in the context of the introduction of Rule 4.17 to provide for the optional inclusion in the request form of certain statements for the benefit of national Offices during national phase processing, it had been possible to overcome similar concerns relating to the complexity of the issues at hand, and suggested that, in light of that experience, it may be useful to at least further study the issue.

> 25. The Working Group agreed that further consideration should be given to the possibility of providing streamlined means for entering the national phase and invited the Secretariat to study the matter and report to the Working Group on its feasibility.

ENHANCING THE VALUE OF INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION UNDER THE PCT

26. Discussions were based on document PCT/WG/1/3.

27. The Secretariat, in introducing the document, noted that the issues of work sharing between Offices and avoidance of duplication of work had been high on the agenda in the discussions of major patent Offices in the recent past. Yet, surprisingly, the PCT did not feature prominently in these discussions, although the issues which had lead to the adoption of the PCT in 1970 were the same as those which were now discussed in the context of work sharing schemes, such as the Patent Prosecution Highway and the New Route, and although the system had been set up as the work-sharing tool for applications filed internationally.

28. It was, of course, recognized that a great number of applications filed internationally were filed outside of the PCT system via the Paris route, and that some Offices received the great majority of applications not via the PCT but via the Paris route, so there would be, no doubt, a great need for effective work-sharing arrangements outside of the PCT system. Furthermore, it would be the expectation and hope that, eventually, any progress in work sharing in respect of non-PCT filings would also flow over to the PCT and result in an improved use of that system.

29. However, there were concerns that the PCT system was being neglected and not being used to its full potential, and that some of the recent work-sharing initiatives were, in effect, trying to “re-invent the wheel”. If there were deficiencies in the PCT system, they should be addressed and fixed in the PCT, rather than designing new systems outside of, or as an alternative to, the PCT. It appeared that those deficiencies lay not in the overall design of the system but more in the way the system was being used by national Offices, including those which also acted as International Authorities; there was thus no need for a new PCT reform exercise but a need to consider how the PCT system as a whole, especially the conduct and the use of the results of international search and preliminary examination, might be improved to use the PCT system to its full potential and to maximize its value to applicants and Offices.

30. Delegations welcomed the document as important, timely and useful. The issues which it set out were considered to form a useful background for exploring how the use of the PCT could be improved to meet the needs of a continually growing number of users in a modern context.

31. Some of the general observations made by delegations included the following:

(a) The primary concern of many delegations was that the PCT should offer high quality and timely international search reports.

(b) An international search should always be at least as high in quality as a national search carried out by the same Office. Some Offices emphasized that there was an ongoing need for “topping up” international searches with a national search of material in local languages which might not have been fully considered in the international search.

(c) Written opinions could be used to greater effect in the national phase if they consistently included detailed reasoning and covered all significant defects, not only those related to novelty, inventive step and industrial applicability, but also, notably, those relating to lack of clarity and support in the description for the claims.

(d) Improvements in efficiency for Offices should not be introduced at the expense of the flexibility which applicants currently enjoyed in the PCT system.

(e) To improve the overall system, it was necessary to consider the responsibilities of applicants as well as of Offices in their various capacities.

(f) Some of the issues addressed in the document concerned matters facing national systems as well as the international patent system.

(g) Changes to the PCT system designed to enhance the value of international search and preliminary examination must not be at the expense of the provision in Article 27(5) that nothing in the Treaty and Regulations was intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desired.

(h) In order to address wide-ranging issues, such as backlogs, application pendency and diversity of the prior art, a multi-pronged approach would be needed.

(i) It would be necessary to proceed step by step, rather than attempting a single major project.

(j) Much experience outside the PCT, including quality systems and work-sharing projects such as the Patent Prosecution Highway, could be drawn on to assist in reaching effective outcomes.

(k) It would be desirable to make search results from many Offices available in a centralized way, particularly if this could be done using common standards facilitating the effective collation and use of the results without the need for sophisticated local systems.

32. One delegation suggested a modification in terminology in the French text only for paragraph 31(a) of the Annex to document PCT/WG/1/3.

Content of International Search Reports (paragraphs 19 to 27 of annex to document PCT/WG/1/3)

33. It was emphasized by certain delegations that the main requirements for the content of an international search report, such as an indication of documents and their relevance, were already appropriately defined; the important issue was ensuring that the reports were drawn up to a consistently high standard. It may be desirable to make search strategies more widely available, but possibly not in the international search report itself.

34. Following developments in the European Patent Network, a number of delegations believed that it would be desirable to introduce product quality standards into the PCT system to complement the common framework for quality management systems, though one delegation noted that it may be difficult to define an appropriate standard, noting the limited precedent in existing national laws on which to draw. The Representative of the European Patent Office confirmed that the European Patent Office was working on proposals for developing the PCT quality framework for submission to International Authorities and Contracting States over the course of the next year. One delegation noted that much work had already been done on the basic requirements of quality systems and, while further development was appropriate, it was also important to work on the development of trust between Offices in other ways.

35. Delegations recognized that there continued to be a particular problem with searching prior art in different languages: machine translation was improving but the best search results in any particular language collection would be achieved by Offices whose examiners were native speakers of that language. More effective ways of collaboration needed to be found so as to make the best use of searches performed by different Offices.

36. Nevertheless, ways (such as machine translation) needed to be found to ensure that all International Searching Authorities were able to effectively search at least the complete PCT minimum documentation, without limitations such as those related to the provision of English language abstracts in Rule 34.1(e). One delegation called for full text versions of as many patent documents as possible to be made available so that they could be used effectively in providing machine translations of those documents and in projects aimed at improving the overall quality of machine translation systems.

37. One delegation suggested that further work on the definition of the PCT minimum documentation would be useful, as well as cooperation in related matters of increasing knowledge in useful databases and effective search techniques.

38. The Secretariat pointed out that some information on national phase search and examination results could already be accessed through PATENTSCOPE®. It was hoped to make this available even more effectively in the future and to offer information from a greater range of Contracting States. It was also observed that the WIPO Digital Access Service for Priority Documents would soon become available and that it had been suggested that the same service might eventually be extended to offer access by Offices to other material prior to publication of the application concerned, to the extent that this was permitted by national law or on the request of the applicant.

Content of Written Opinions and International Preliminary Reports on Patentability (paragraphs 28 to 31 of annex to document PCT/WG/1/3)

39. Delegations representing a range of different designated Offices stated that international preliminary reports on patentability were very useful to assist examination in the national phase, provided that the reports were sufficiently complete and well-argued; such reports could sometimes be used directly as a first Office action in the national phase.

40. One delegation commented that it was essential for International Authorities to make comments on major issues of clarity and support in order to properly address matters of novelty and inventive step, though it considered that minor matters could reasonably be left to the national phase.

41. Several delegations expressed their concern about a lack of consistency in the depth and coverage of international reports from different Authorities. They expressed the view that the reports could be more effectively used if they were more consistent. Furthermore, one delegation considered that, to the extent that the coverage of certain subjects was a matter of discretion for the International Authority concerned, it would be useful to make it clear whether the absence of a comment reflected that there was no objection or that the subject had not been considered.

42. One delegation considered that the current structure of the forms for written opinions and international preliminary reports on patentability was too rigid and dependent on the marking of check-boxes to allow examiners to address all issues efficiently.

43. Following concerns expressed by one delegation that designated Offices were not able to understand reports in all the languages in which they were established, the Secretariat pointed out that translations into English were prepared for all reports which were not established in that language; if those translations were not being received by any Office, the International Bureau would assist in ensuring their communication to the Office concerned.

Trust in Reports Prepared Other than for Specific National System; Preliminary and Non-Binding Nature of PCT Reports; Complete Reports (paragraphs 32 to 40 of annex to document PCT/WG/1/3)

44. The Secretariat clarified that the meaning of the term “binding”, as used in the document, reflected the view in some work-sharing systems that, in order for a report to be used by a second Office, it needed to be near-final in the sense that it clearly stated that at least some claims within an application were suitable for inclusion in a granted patent in the Office establishing the report. It was not intended to suggest that the results should in turn be binding on the second Office.

45. One delegation stated that, though there was no direct link between the question of whether a report was binding on the Office by which it was established and the quality of that report, it was only natural that examiners would be more thorough where there was no further review before a patent was granted; one way of addressing this might be to combine national and international processing (see also paragraphs 59 to 61, below). Another delegation believed that the quality of national and international searches ought to be the same and that, if there was perceived to be a difference, this should be investigated before taking actions which might not in fact be appropriate.

46. Another delegation stated that national and international search reports should be treated identically and be subject to the same quality standards. It considered that, if all Offices which acted as International Searching Authorities accepted their own international search reports as search reports also for the national phase, this would give their reports more standing.

47. One representative of users stated that it should be expected that an International Searching Authority would establish international search reports which were *at least* as good as those established for national searches. It was considered that this was a sensible approach even for Offices which had to deal with large workloads since it would then not be necessary for this work to be repeated in the national phase. If the work was done properly, it would be easier for all designated Offices to rely on the results, to the benefit of all users of the system.

48. There was common agreement that there should be no delay in the establishment of international search reports to allow a greater proportion of "secret prior art" to be found. One delegation commented that, to the extent that such art was available at the time of search, it should be included in the international search report for its relevance to inventive step as well as to novelty.

National Phase Entry in Acceptable Form (paragraphs 41 to 49 of annex to document PCT/WG/1/3)

49. All delegations which took the floor on this matter expressed the view that no benefits would be gained by permitting amendment of the description and the drawings during the international phase without demanding international preliminary examination. In this context, it was noted that the informal procedure followed at present, under which the International Bureau made available to designated Offices any comments submitted by the applicant on the international search report or the written opinion by the International Searching Authority, appeared to be sufficient for the applicant to express disagreement, if desired, or otherwise respond to the report or opinion prior to the start of national processing. It was also noted that the applicant had the right, under Article 28, to amend the entire application before any designated Office upon national phase entry. While some delegations and one representative of users believed that a centralized procedure would sometimes be useful, under which the applicant would be given the opportunity to amend the application under Article 28 once with effect for several or all designated Offices, in a similar manner to the present procedure in respect of Article 19 amendments of the claims, other delegations considered that such a procedure would have little benefit.

50. In order to improve the usefulness of international search reports for the purposes of Chapter II proceedings and national phase processing, one representative of users suggested that it might be reasonable to expect the applicant to provide a response before the next stage of processing. For example, the applicant could be required, when filing a demand for international preliminary examination or a request for supplementary international search, or when entering the national phase, to submit to the International Preliminary Examining Authority, the Authority carrying out the supplementary search or the designated Office, respectively, a substantive response to any objections raised in the written opinion established during the main search, the supplementary search report or in the international preliminary report on patentability. If such a requirement existed, examiners might be inclined to take greater care in the establishment of opinions and reports.

51. It was noted that the use of Chapter II had declined dramatically since the introduction, in 2004, of the written opinion by the International Searching Authority and the change in the national phase entry time limit under Article 22 from 20 to 30 months from the priority date. It was recognized that applicants in the past used Chapter II mainly to "buy time" rather than to amend the application with a view to bringing it in order for national phase entry. However, several delegations and one representative of users noted that applicants who, under the present system, were still interested in overcoming deficiencies in the international phase were deterred from proceeding into Chapter II by the practices of some International Preliminary Examining Authorities, which gave the applicant very little opportunity for a real dialogue with the examiner. In the view of one representative of users, this resulted in a generally unsatisfactory "price/usefulness ratio" for services offered under Chapter II. In addition, the representative expressed the view that, from the applicant's perspective, it made little sense to incur additional expenses for the Chapter II procedure if designated/elected Offices during national phase processing generally paid little attention to the reports established during the international phase.

52. The Working Group agreed that, in view of the decline in the use of Chapter II and the corresponding reduction in workload for International Preliminary Examining Authorities, it may be appropriate to review the general approach taken in Chapter II processing, with a view to considering how to encourage applicants to overcome deficiencies in the application during the international phase rather than only after national phase entry, for example, by giving more opportunity for dialogue with the examiner, or by encouraging increased collaboration between the applicant and the Authority along the lines of the suggestion mentioned in paragraph 50, above.

> 53. The Working Group invited the International Bureau to further study the issue with a view to submitting more specific recommendations to the Working Group at its next session.

The Importance of Timing and First Filings (paragraphs 50 to 54 of annex to document PCT/WG/1/3)

54. One delegation stated that national first filings played an important role in filtering out, at an early stage, applications which were of a quality which did not warrant subsequent filing as international applications.

55. One representative of users expressed the view that, from a user's perspective, it was more attractive to first file a national application and then to re-file the application in the form of an international application, rather than to commence with an international application, noting that the term of a granted patent would start from the filing date and moreover that almost all Offices charged "progressive" renewal fees for granted patents.

Availability and Use of Information (paragraphs 55 to 57 of annex to document PCT/WG/1/3)

56. Several delegations suggested that it would be helpful to designated Offices if information on national phase processing, in particular, national search and examination results of other designated Offices, were available from a centralized database, accessible by all designated Offices. In this context, one delegation suggested that it would be useful for designated Offices if supplementary international search reports contained an annex explaining why certain documents were considered to be relevant, similar to the written opinion by the (main) International Searching Authority.

57. It was noted that the International Bureau's PATENTSCOPE® Search Service already included, under the "national phase" tab, status information as to national phase processing of an international application which had entered the national phase, including, where available, national search and examination reports. The Secretariat encouraged all Offices to make such information available to it for inclusion in the Service, to the benefit of all designated Offices and third parties.

58. In this context, one representative of users suggested that discussions on substantive patent law harmonization should be resumed within WIPO since it was considered that harmonization of substantive requirements for the grant of a patent was essential for effective avoidance of duplication of work.

Revising the Distinction Between International and National Phases (paragraphs 58 to 65 of annex to document PCT/WG/1/3)

59. The Delegation of Japan, referring to an informal paper made available by it to the Working Group, gave a short overview of the "parallel processing" of national and international applications in the Japan Patent Office, highlighting the benefits for users. The Delegation pointed out that users could enjoy a reduction of the international search fee and were provided with an international search report and written opinion which had substantially the same conclusions as a first national action for directly comparable applications. Under that procedure, the same examiner would conduct a search and prepare a search and examination report for the national and international applications at the same time, thereby minimizing the risk of arriving at different conclusions for the two applications. Patent Offices and Authorities could reduce their workloads as a result of this procedure. The Delegation stated that such parallel processing in Japan was held in high regard by users, including small and medium-sized enterprises (SMEs) and universities.

60. One delegation, agreeing that parallel processing could improve the overall processing of applications and particularly the quality of the international search report, suggested that the PCT might eventually be amended to allow for the filing of a single application constituting both a national application and an international application with an Office which also acted as an International Authority.

61. A representative of users expressed the view that, while efficiencies may very well be gained by the parallel processing of corresponding national and international applications, the basic assumption that it would ever be acceptable to view international searches as less important than national searches was wrong; if Authorities would accord the same importance to both kind of searches, there would be no need to introduce parallel processing systems.

FILING AND PROCESSING OF SEQUENCE LISTINGS UNDER THE PCT; PROPOSAL BY ISRAEL TO SIMPLIFY THE PROCESSING OF COMPUTER PROGRAM LISTINGS

62. Discussions were based on documents PCT/WG/1/2 (Annex, section 3) and PCT/WG/1/4.

63. There was general support for the proposed modifications of the Administrative Instructions:

(i) to no longer permit the filing of "mixed mode" sequence listing applications, where the body of the description was in paper format and a sequence listing was provided either both on paper and in electronic form on a physical medium, or else only in electronic form on a physical medium;

(ii) to provide that, instead of a maximum of 400 page fees payable, no page fee would be payable for a sequence listing filed in ST.25 text format but full page fees would be payable for all pages of a sequence listing filed in an ST.25 image format (as well as for sequence listings filed on paper, as at present);

(iii) to include in the page count all pages containing tables related to sequence listings;

(iv) to make copies of sequence listings submitted for the purposes of international search publicly available; and

(v) to clarify the acceptable electronic document formats for the filing of sequence listings under the basic common standard.

64. There was no support for the proposal by Israel to modify the Administrative Instructions to allow for the filing of mixed mode computer program listing applications, where the body of the description was in paper format and a computer program listing was provided in electronic form on a physical medium, and to apply the same fee incentive for applicants filing such mixed-mode applications as was presently granted to applicants filing mixed-mode sequence listing applications. It was noted that computer program listings were not machine-readable and were not able to be searched in the way that sequence listings were, but rather computer program listings required consideration by the examiner; consequently, there was no processing advantage or policy objective to be gained by offering a fee incentive related to format in the case of computer program listings. Moreover, it was felt that applicants should not in any event be encouraged, by way of a fee incentive, to file such program listings, noting that they would usually not contribute to the understanding of the invention.

PHYSICAL REQUIREMENTS OF THE INTERNATIONAL APPLICATION

65. Discussions were based on documents PCT/WG/1/2 (Annex, section 4) and PCT/WG/1/5.

66. The Delegation of Israel stated that it considered that the International Bureau's outline of the issues relating to color drawings in document PCT/WG/1/5 fully reflected the matters which the Delegation believed needed to be addressed in connection with its proposal set out in section 4 of the Annex to document PCT/WG/1/2.

67. One delegation suggested that consideration be given to moving much of the content of Rule 11 to the Administrative Instructions, noting that this would match the approach which had been taken to the specific case of electronic filing and would allow for greater flexibility should the need for further changes arise. The delegation also suggested that such a move might also facilitate a more complete integration of the Common Application Format (see paragraphs 161 to 164, below) into the PCT system if this were considered appropriate in the future.

68. In response to a query as to whether such a move would alter the effects of the provisions concerned under national laws, having regard to PCT Article 27(1) ("no national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations"), the Secretariat noted that both the Treaty (in Article 58(4)) and the Regulations (in Rule 89) specifically provided for the establishment and the content, respectively, of the Administrative Instructions. Article 27(1) would therefore operate in relation to requirements set out in the Administrative Instructions as it did in relation to requirements set out in the Treaty and the Regulations themselves.

69. Following a brief discussion, noting that there were policy implications involved in moving provisions to the Administrative Instructions and that the particular reasons for setting out the specific requirements and processing details of electronic applications in the Administrative Instructions did not apply in the more general case, there was no support for the proposal to move the content of Rule 11 to the Administrative Instructions.

70. One delegation, while expressing its general support for the draft proposals aimed at facilitating fully electronic processing on a text data basis, emphasized the need to ensure that any amendments adopted in order to facilitate optical character recognition processes by Offices would not introduce new requirements which would unnecessarily burden applicants or Offices.

71. The Working Group agreed that:

(i) the Secretariat should submit a report to the ST.22 Task Force of the Standards and Documentation Working Group of the Standing Committee on Information Technologies (SCIT/SDWG) on the proposals related to optical character recognition as set out in document PCT/WG/1/5 and the comments thereon appearing in the following paragraphs;

(ii) the SCIT/SDWG should be invited to make recommendations on technical standards appropriate for color photographs and drawings in both patent and trademark applications;

(iii) the International Bureau should develop further recommendations in relation to the physical requirements of the international application, taking into account the comments set out in the following paragraphs and any conclusions reported by the ST.22 Task Force and the SCIT/SDWG, and in particular should develop proposals for modifying the PCT Receiving Office Guidelines to clarify cases in which a requirement stipulated in the Regulations need not be strictly enforced by receiving Offices in the international phase.

Rule 11.2

72. One delegation suggested that it would be useful to include in this Rule the requirement that printed documents be presented with a minimum resolution of 300 dpi.

Rule 11.3

73. It was observed that the words “all elements of the international application shall be on paper” were slightly misleading since this did not apply to electronically filed applications, which were subject to special requirements set out in the Administrative Instructions. However, noting that many other references in the Regulations were similarly specific to applications filed on paper, it was agreed that it would not be appropriate to address this particular item in isolation.

74. Several delegations questioned the proposed amendment which would require that all elements of an application be presented on paper which shall be “substantially free of wood cellulose”, noting that paper’s main constituent is wood cellulose.

Rule 11.6

75. Several delegations considered that there was no apparent need to maintain the requirement for a smaller bottom margin on sheets containing drawings than that required for sheets containing the description, claims and abstract. There was the same requirement to allow adequate space to stamp information concerning substitute sheets in both cases.

Rule 11.7

76. One delegation considered that applicants should be permitted to choose whether to place page numbering in the top or bottom margin of the sheet. The Secretariat observed that this would be consistent with the recommendations in draft WIPO Standard ST.22 and would appear to be acceptable, provided that Offices were not concerned that it would interfere unduly with the placement of stamps in the bottom margin of substitute sheets.

77. One delegation considered that it would be preferable to maintain the current requirement that page numbering *not* be placed in the margin, in order to avoid interfering with the other items which may be placed within the top margin. The International Bureau pointed out the aim of excluding the page numbers from the area that was included in the optical character recognition process so that they would not appear in full text documents as false paragraphs.

78. It was agreed to investigate a sample of international applications to assess the extent of risk of interference between different items in the margins, as well as of inclusion of page numbering accidentally into the OCR text.

Rule 11.8

79. It was agreed that it would be desirable to address the appropriate manner of numbering replacement paragraphs where entire paragraphs were added or deleted by way of an amendment, correction or rectification of an obvious mistake.

80. One delegation observed that it may be desirable to recommend that paragraph numbering be contained within curly brackets ("{ }") rather than square brackets ("[ ]").

81. It was observed that paragraph numbering, while highly desirable, was of limited use in cases where applicants used extremely long paragraphs, some of which may span several pages.

Rule 11.9

82. One delegation considered that the proposed amendment of paragraph (c), which would require "additional spacing at the end of each paragraph", should establish a preferred practice rather than a mandatory requirement. While the delegation recognized the value of that requirement for assisting the identification of the extent of paragraphs, it considered that it was not appropriate to require an Office to invite the applicant to furnish replacement sheets where the application did not comply with the requirement. Another delegation, supporting those views, suggested that consideration be given to making strong recommendations ("shall preferably" or "it is strongly recommended") rather than strict requirements in relation to various other matters dealt with in Rules 11.9 to 11.11.

83. Several delegations considered that the term "non-cursive font" should be clarified by making a clearer distinction between fancy script fonts (which should not be used) and italics (which were commonly and validly used for headings, certain types of citation and other purposes).

84. It was observed that the proposed requirement for a single column format did not apply to the contents of tables, which were the subject of a special provision in Rule 11.10.

Rule 11.10

85. In response to an observation by a representative of users, the Secretariat pointed out that the use of a strict requirement ("shall have") for table borders in draft Rule 11.10(c) was not inconsistent with a recommendation ("should have") in draft WIPO Standard ST.22, since that entire Standard was only a recommendation and was not directly enforceable, except where the recommendations had been incorporated into (mandatory) requirements of the PCT Regulations or national laws.

86. One delegation stated that, while it agreed with the principle behind draft Rule 11.10(d), it nevertheless considered that a more clear statement was required that any table or chemical or mathematical formula which required to be placed sideways on the sheet (using the sheet in landscape orientation) should be presented on its own sheet, separate from any normal paragraph text (which was not permitted to be presented sideways).

Rule 11.11

87. In response to a query from a representative of users, the Secretariat explained that the intention behind proposed Rule 11.11(b) had not been to preclude designated Offices from requiring translation of words in drawings upon national phase entry. Rather, the purpose was to require that any words appearing in drawings were accompanied by a reference number, to which the International Bureau would be able to refer to provide a key of translated terms outside the drawing itself in the event that the drawing was published on the front page of the published international application together with the abstract.

88. The Working Group agreed that Rule 11.11(b) should be further reviewed with a view to ensuring that its meaning was clear and to clarify that the applicant, where the drawing did not contain any such reference sign, would be entitled to add such reference sign by way of a correction of a formal defect under Article 14(1)(b).

Rule 26.3

89. A representative of users questioned whether the text proposed to be added to Rule 26.3(a) relating to the checking of the physical requirements referred to in Rule 11 ("… the receiving Office shall check … the international application … to the extent that compliance therewith is necessary …, where the application is not filed in electronic form in character coded format, for the purpose of accurate optical character recognition") applied only to applications filed in XML or also to applications filed in other character coded formats, such as searchable PDF format. In response, the Secretariat stated that this was one of a number of particular issues still needing to be clarified, but noted that applications filed in searchable PDF format had often proved particularly difficult to process.

CRITERIA FOR ADDITION OF LANGUAGES OF PUBLICATION UNDER THE PCT

90. Discussions were based on documents PCT/WG/1/2 (Annex, section 1) and PCT/WG/1/6.

91. The Working Group noted that the Secretariat was considering the submission to the Assembly of a draft common understanding setting out criteria for the addition of future languages of publication under the PCT, taking into account the views expressed at the present session as outlined in the following paragraphs.

92. Those delegations which took the floor on the matter expressed general support for the suggested criteria for assessing future requests for the addition of languages of publications that were developed by the Secretariat and set out in document PCT/WG/1/6.

93. Several delegations suggested a modification of the proposed second criterion set out in paragraph 15(b) of document PCT/WG/1/6 (combined number of applications which are first filed in the language concerned in all Offices which accept that language), which is based on a fixed number of applications filed worldwide without claiming priority (for example, "20,000"), by referring instead to a percentage of such applications. The Secretariat noted that the percentage figure equivalent to 20,000 applications was, on the basis of the assumptions indicated in the document, about 2.5%.

94. One delegation, while recognizing the importance of the proposed second criterion set out in paragraph 15(b) of document PCT/WG/1/6, felt that the envisaged number of 20,000 applications was too high and that the inclusion of a language as a PCT language of publication might in some cases act as a trigger to boost the use of the language to that level for first filings. The delegation suggested that, instead of a fixed number, reference should be made to the "filing trend" in the country concerned, as set out in the proposal by Israel contained in section 1 of the Annex to document PCT/WG/1/2.

95. Several delegations favored the inclusion, in the proposed third criterion, of the text which was presented in document PCT/WG/1/6 in square brackets, so that that criterion would read: "A new language of publication should only be added if adequate machine translation tools are publicly available for translation into at least English, and which can be integrated into at least one public database providing free access to international applications freely or at acceptable cost to the database supplier".

96. Some representatives of users expressed the concern that, if international applications were published in too wide a range of languages, it would become very difficult, if not impossible, for third parties to monitor the scope and content of published international applications in order to determine possible risks of infringement, and suggested that this be recognized in paragraph 6(e) of the document. The suggestion was made that the third criterion set out in paragraph 15(c) of the document also be amended so as to include a reference to that important aspect of the disclosure function of the international patent system.

97. Several delegations expressed the view that, in general, the criteria for the future addition of a publication language should be set at a relatively high level and, once in force, should be strictly applied.

SUPPLEMENTARY INTERNATIONAL SEARCH: FURTHER CONSEQUENTIAL AMENDMENTS

98. Discussions were based on document PCT/WG/1/7.

99. The Secretariat informed the Working Group that, at the 15th session of the Meeting of International Authorities under the PCT, held in April 2008, at least three International Authorities had announced that they intended to offer the supplementary international search service as of January 1, 2009, and at least one other Authority as of January 1, 2010.

100. The Working Group approved the proposed amendments of the Regulations set out in the Annex to document PCT/WG/1/7 with a view to their submission to the Assembly for consideration at its next session, in September-October 2008, subject to the comments and clarifications appearing in the following paragraphs and to possible further drafting changes to be made by the Secretariat.

101. One delegation sought explanation of the relationship between the provisions concerning the refund of the supplementary search handling fee and the supplementary search fee in Rules 45*bis*.2(d) and 45*bis*.3(d) as proposed to be amended, and the provisions concerning the refund of the supplementary search fee in Rule 45*bis*.3(e). In response, the Secretariat explained that, whereas the former provisions governed the refund of fees by the International Bureau where the international application itself was withdrawn or considered withdrawn, or the supplementary search request was withdrawn or considered not to have been submitted, the latter provisions governed the refund by the Authority specified to carry

out the supplementary search in the special case where, in accordance with Rule 45*bis*.5(g), the Authority found that carrying out the search was excluded by a limitation or condition, for example, as to the subject matter for which supplementary searches will be carried out by that Authority. In that special case, it was a matter for the Authority to determine, in accordance with the applicable agreement between the Authority and the International Bureau, the extent to which, and under which conditions, it would provide for a refund of the supplementary search fee.

102. It was agreed that Rule 90*bis*.3*bis*(b) should be further reviewed with a view to ensuring that the communication under Article 20(1) (as applicable by virtue of Rule 45*bis*.8) of the supplementary search report, or of the declaration that no such report would be established, would be effected not only where the supplementary search request was validly withdrawn in a notice submitted to the International Bureau and transmitted by that Bureau to the Authority carrying out the supplementary international search only after that Authority had sent the supplementary search report to the applicant (and to the International Bureau), but also in the case where the supplementary search request was validly withdrawn in a notice submitted to the Authority, but received by that Authority too late to prevent the transmission of the supplementary search report to the applicant (and to the International Bureau).

103. It was agreed that Rule 90*bis*.5(b)(i) should be further amended to also refer to "the Authority carrying out the supplementary international search" as a possible recipient of a statement explaining the lack of signature of one of the applicants.

104. It was agreed that Rule 90*bis*.6(b-*bis*) should be further reviewed with a view to clarifying that, where a request for supplementary search was withdrawn under Rule 90*bis*.3*bis*, it was the supplementary international search by the Authority carrying out that search, and not the processing of the entire international application, that would be discontinued.

105. One representative of users suggested that, where the applicant withdrew a request for supplementary international search after the relevant documents had been sent to the Authority carrying out the supplementary search (after which no refund of the supplementary search fee would be given anyway), the supplementary international search report should nevertheless be established, noting that it would be in the interest of the general public to obtain the results of the supplementary international search in respect of the international application concerned. That suggestion received no support from delegations.

TRANSMITTAL OF THE INTERNATIONAL APPLICATION, TRANSLATIONS AND RELATED DOCUMENTS

106. Discussions were based on document PCT/WG/1/8.

107. All delegations which took the floor on the matter expressed general support for the International Bureau's plan to offer a service whereby the receiving Office would be able (with the agreement of the International Bureau and the International Searching Authority) to transmit the search copy and other documents necessary for international search to the International Searching Authority in electronic form via the International Bureau, using the receiving Office's existing PCT Electronic Data Interchange (EDI) communication link to the International Bureau, and to offer International Searching Authorities access to the full text of international applications captured using optical character recognition (OCR). Several

delegations expressed interest in exploring ways of using the system for the benefit of their national Offices in their capacities as receiving Offices and/or International Searching Authorities.

108. Following a query by one delegation, the Secretariat noted that, at present, it was envisaged that the new service would rely solely on EDI system links, since this could be offered at essentially zero cost through the existing infrastructure, whereas providing an equivalent service through other systems would require significant development work for which no budget was currently provided. However, the proposed service would be entirely optional, and any other form of communication link which existed between the sender and the recipient of data (such as, for example, the Trilateral Network) could be used provided that both the sender and the recipient of data so agreed.

109. Several delegations suggested that it would be very useful if the International Bureau could make the search copy available to the International Searching Authority in text format and not in an image format so as to facilitate the processing of the international application by the Authority.

110. It was noted that the communication of documents from the receiving Office via the International Bureau to the International Searching Authority would not require any changes to the present legal framework since the International Bureau would only be performing the role of an “e-courier” service, similar to the role performed at present by the postal service in the case of communication of paper documents. It was further noted that the proposals were not intended to affect in any way the present arrangements with regard to the payment by applicants of fees related to the international search; as at present, the applicant would be required to pay the search fee to the receiving Office, which would continue to transmit that fee directly to the International Searching Authority, with no involvement of the International Bureau whatsoever.

111. Following a query by one delegation, the Secretariat stated that, while many of the details, including details of a technical nature, of how the final system would operate remained to be determined, the receiving Office would not, at least in the trial arrangement, delay the transmittal of the search copy to the International Bureau until after the receipt of the payment of the search fee. Rather, the search copy would be transmitted from the receiving Office to the International Bureau prior to the receipt of the payment of the search fee, and the search copy would immediately be made available by the International Bureau to the International Searching Authority. The Authority, however, would “pick up” the search copy only after it had been notified of the receipt of the search fee by the receiving Office.

112. Following a query by one delegation, the Secretariat confirmed that the communication of documents via the EDI system would take place in a secure environment, as witnessed by the fact that that system was already being used in the vast majority of cases for the communication in electronic form of record copies from the receiving Offices to the International Bureau.

113. The Working Group noted with approval the International Bureau’s plans, as outlined in document PCT/WG/1/8, for automated transmittal of the international application and other documents.

PROPOSALS BY THE UNITED STATES OF AMERICA WITH RESPECT TO MISSING ELEMENTS AND PARTS

114. Discussions were based on document PCT/WG/1/9.

Proposed Amendment of Rule 4.18 (paragraphs 3 to 6 of document PCT/WG/1/9)

115. The Delegation of China noted that it had, in the PCT Reform Working Group, opposed the introduction of provisions in the Regulations allowing for the incorporation by reference of missing elements or parts, since it believed that those provisions were not compatible with the provisions of the Treaty nor the provisions of the Paris Convention in that they, in effect, allowed the applicant to add subject matter to the international application after the international filing date. The Delegation noted that it wished to reiterate its general concerns about the provisions relating to incorporation by reference and stated that its Office had informed the International Bureau of the incompatibility of the Rules concerned with the applicable national law applied by that Office in its functions as a designated Office, and would thus not apply the Rules concerned. Thus, applicants entering the national phase in China having made use of those provisions would run the risk of losing the international filing date so far as the national phase in China was concerned.

116. One delegation, noting that the provisions relating to incorporation by reference of missing elements and parts had only recently been introduced into the Regulations, suggested that proposals for amendments of the provisions concerned should be deferred until a later date and only be discussed after Offices had gained more experience in this area.

117. The Secretariat observed that, in the case of incorporation by reference, there would always be an element of uncertainty as to what subject matter constituted the international application on its international filing date, whether or not the priority application or applications which formed the basis for the incorporation were uniquely identified on the date of filing. Certainty as to the subject matter of the international application would only be achieved once the applicant had confirmed the incorporation by reference and specified which elements or parts of the priority application(s) were incorporated in the international application. However, this short period of uncertainty would not seem to materially affect anyone: neither designated Offices nor third parties would have any knowledge of the international application until the matter had already been decided; furthermore, the receiving Office, which did not give substantive consideration to the content of the international application, also need not be concerned by the uncertainty.

118. Several delegations raised concerns as to the language of Rule 4.18 as proposed to be amended and suggested that it should be made clear how the applicant was required to identify the earlier application(s) to which priority was claimed in the international application for the purposes of incorporation by reference. Several delegations suggested that the applicant be required, in effect, to comply with all of the requirements of Rule 4.10 by indicating, on the international filing date, the number of the earlier application, its filing date and the country in which or for which it was filed, although concerns were expressed as to the compatibility of such a requirement with the right of the applicant under Rule 26*bis* to correct a priority claim after an international filing date had been accorded by, for example, furnishing the missing number of the earlier application. In this context, it was noted that Article 5(6)(b) of the Patent Law Treaty (PLT) and Rule 2(4) of the PLT Regulations contained similar provisions relating to incorporation by reference of missing elements or parts to those set out in Rule 4.18 and also did not further specify which requirements the

applicant had to meet in order to validly "claim the priority of an earlier application" for the purposes of incorporation by reference. Concerns were also raised as to the possibility of using means of identifying earlier applications which were dependent on information (such as "docket numbers") that was not used in all States, or else would not be available to the designated Offices to confirm that the receiving Office had correctly confirmed the identity of the earlier application.

119. Following an extensive discussion, the Working Group agreed to refer the matter to the Secretariat for further consideration.

Proposed Amendment of Rule 20.6 (paragraphs 7 to 9 of document PCT/WG/1/9)

120. One delegation and two representatives of users supported the proposal for amendment of Rule 20.6 to give the applicant an additional opportunity to comply with the requirements for incorporation by reference of a missing element or part where the element or part to be incorporated contains minor differences from the earlier application and thus cannot be considered to be completely contained in the earlier application, as required by Rule 4.18 and 20.6(a). One representative of users expressed the view that, without such additional opportunity to comply with the requirements under those Rules, the sanction, namely, loss of the international filing date, would be too harsh.

121. Several delegations expressed concerns about the proposal, one delegation noting that more time was needed by Offices to gain experience with the application of the provisions relating to incorporation by reference of missing elements and parts before further amending those provisions to provide for additional remedies for applicants. Concerns were expressed with regard to the proposed additional one-month time limit, which would prolong uncertainty as to what constituted the subject matter of the international application on the international filing date and would also delay transmission of the record copy and search copy.

122. Several delegations suggested that, rather than dealing with the issue in the Regulations, receiving Offices should simply delete *ex officio* any additional matter contained in the sheet or sheets embodying the element as contained in the earlier application or embodying the part concerned so that that element or part was indeed completely contained in the earlier application concerned, and that the PCT Receiving Office Guidelines should be modified accordingly.

123. The Chair concluded that, in view of the discussions, there was no agreement to submit the proposed amendments of Rule 20.6 to the Assembly for adoption.

124. The Working Group agreed to refer the matter to the Secretariat for further consideration.

Proposed Modification of the PCT Receiving Office Guidelines (paragraphs 10 to 12 of document PCT/WG/1/9)

125. One representative of users asked whether it would be permissible for receiving Offices, following the incorporation by reference of a second "correct" set of drawings or claims, to simply delete the originally filed "incorrect" set of drawing or claims and to replace them with the "correct" set of drawings or claims incorporated by reference. Responding, the Secretariat noted that, in the context of Rules 4.18 and 20.6, it was possible to incorporate by reference

certain matter from an earlier application but it was not possible to delete any matter contained in the international application as filed. If the incorporation gave rise to irregularities in the numbering of drawings or claims, the irregular numbering should be correctable as a formality defect, but that could not be by way of deletion of the "incorrect" claims or drawings, and care would be needed to ensure that any correction did not result in altering the disclosure in the application.

126. The Working Group noted that, in a case where the international application, on the international filing date, contained the necessary claim(s) *element* and description *element* (see Article 11(1)(iii)(d) and (e)), it was not possible under Rules 4.18 and 20.6(a) for the claims or description contained in a priority application to be incorporated as a *missing element*. However, it appeared to be possible, in such a case, for part or all of the description, or part or all of the claims, contained in the priority application to be incorporated under those Rules as a *missing part*. The situation was in need of clarification for the benefit of receiving Offices and users.

127. The Working Group agreed that the PCT Receiving Office Guidelines should be modified to clarify the procedures to be followed under Rules 4.18 and 20.6 in the circumstances outlined in paragraphs 125 and 126, above. Where incorporation by reference resulted in a duplicated set of descriptions, claims or drawings, the set incorporated by reference should be placed sequentially before the originally filed set.

PROPOSALS BY THE UNITED STATES OF AMERICA WITH RESPECT TO RECTIFICATION OF OBVIOUS MISTAKES

128. Discussions were based on document PCT/WG/1/10.

129. Several delegations supported the proposal for amendment of Rule 91.1(d) so as to permit the contents of the request to be taken into account for the purposes of considering whether mistakes in the description, claims or drawings were obvious and thus rectifiable.

130. Several other delegations expressed concerns about the proposal, questioning the need for the amendment, noting that mistakes such as the one referred to in paragraph 5 of document PCT/WG/1/10 (reference to the priority claim contained in the description which contains a mistake when compared with the priority information contained in the request) could easily be corrected in the national phase. One delegation noted that existing case law with respect to corrections of mistakes in the disclosure (description, claims and drawings) limited its Office to taking into account only the description, claims and drawings in determining whether the mistake and the intended correction were obvious.

131. One delegation questioned whether it would be possible, in the example referred to in paragraph 5 of document PCT/WG/1/10, to determine, by taking into account the content of the request as well as the description, whether the information concerning the priority claim contained in the description was "obviously" wrong and the corresponding information contained in the request "obviously" correct. The Secretariat noted that the criteria set out in Rule 91.1(c) needed to be satisfied in every case.

132. One representative of users noted that the proposed amendment would only be applicable to applicants from one particular Contracting State where it was common practice to refer to the priority claim in the first paragraph of the description, a practice not used elsewhere. The representative suggested that, instead of permitting the contents of the request to be taken into account in such cases, the content of the priority document itself should be permitted to be taken into account, for the benefit of applicants from all Contracting States.

133. The Chair noted that a proposal to permit the content of the priority document to be taken into account in rectifying obvious mistakes in the description, claims and drawings had been discussed at great length by the Working Group on Reform of the PCT but no consensus had been reached.

134. The Chair concluded that, in view of the discussions, there was no agreement that the proposed amendments of Rule 91.1 be submitted to the Assembly at this stage.

PROPOSALS BY THE UNITED STATES OF AMERICA WITH RESPECT TO PROCESSING UNDER ARTICLE 14(4)

135. Discussions were based on document PCT/WG/1/11.

136. The Working Group approved the proposed amendments of the Regulations set out in the Annex to document PCT/WG/1/11 with a view to their submission to the Assembly for consideration at its next session, in September-October 2008, subject to the comments and clarifications appearing in the following paragraphs and to possible further drafting changes to be made by the Secretariat.

137. The Working Group agreed that Rule 29.4 should be amended to read as follows:

"29.4 *Notification of Intent to Make Declaration Under Article 14(4)*

"(a) Before the receiving Office issues any declaration under Article 14(4), it shall notify the applicant of its intent to issue such declaration and the reasons therefore. The applicant may, if he disagrees with the tentative finding of the receiving Office, submit arguments to that effect within two months from the date of the notification.

"(b) Where the receiving Office intends to issue a declaration under Article 14(4) in respect of an element mentioned in Article 11(1)(iii)(d) or (e), the receiving Office shall, in the notification referred to in paragraph (a) of this Rule, invite the applicant to confirm in accordance with Rule 20.6(a) that the element is incorporated by reference under Rule 4.18. For the purposes of Rule 20.7(a)(i), the invitation sent to the applicant under this paragraph shall be considered to be an invitation under Rule 20.3(a)(ii)."

138. The Delegation of Japan expressed concern that the operation of the provisions for incorporation by reference under proposed amended Rule 29.4 as set out in document PCT/WG/1/11 might not be consistent with Article 14(4), noting that the operation of that Article presupposed that the receiving Office had accorded a filing date, albeit mistakenly. There was thus a presumption that an application to which Article 14(4) applied contained all of the required elements under Article 11(1)(iii), even where that was not in fact the case. The revised text of proposed amended Rule 29.4 as set out in paragraph 137, above, appeared on preliminary examination to overcome the difficulty, but the Delegation was not in a

position to express its agreement without further consideration. On the other hand, the Delegation did not wish to stand in the way of a consensus that the matter be submitted to the Assembly for consideration at its next session.

139. The Working Group requested the Secretariat to further study how best to provide that receiving Offices which had informed the International Bureau under Rule 20.8(a) of the incompatibility of the provisions relating to the incorporation by reference with their applicable national law would not be required to apply Rule 29.4(b), for example, by way of an additional paragraph in Rule 29.4 or by way of an agreed understanding to be adopted by the Assembly in conjunction with the adoption of the proposed amendments of Rule 29.4.

PROPOSALS BY THE UNITED STATES OF AMERICA REGARDING THE TREATMENT OF EXTRANEOUS MATTER

140. Discussions were based on document PCT/WG/1/12.

141. Several delegations expressed concerns about the proposal to amend the Regulations to provide for a detailed procedure relating to "extraneous matter" filed with the international application with the aim of clarifying whether or not that matter was to form part of the application, noting that the inclusion of express provisions to this effect in the Regulations might encourage applicants to file extraneous matter, rather than deterring them from doing so. It was felt that the issue should continue to be dealt with in the PCT Receiving Office Guidelines which, if necessary, could be modified to clarify some of the issues raised in document PCT/WG/1/12.

142. It was agreed that receiving Offices needed guidance as to how to proceed in cases where it was not clear which of the papers filed were intended to be included in the application and which papers were not intended to be included, that is, whether particular papers were indeed "extraneous". There was no support for the suggestion by one delegation to amend the Regulations to simply provide that extraneous matter does not form part of the application. It was agreed that the applicant should be invited to clarify the status of the papers, but the matter should not be left open-ended. The papers concerned should not, in any event, be expressly treated as an "appendix" to the international application.

143. The Working Group agreed that the PCT Receiving Office Guidelines should be modified to clarify that, where it was not apparent to the receiving Office whether certain papers were or were not filed as part of the international application, the Office should invite the applicant to clarify the situation within a time limit, following which, if no such clarification had been provided, the papers concerned would be disregarded.

PROPOSALS BY THE UNITED STATES OF AMERICA WITH RESPECT TO AMENDMENT OF CLAIMS

144. Discussions were based on document PCT/WG/1/13.

145. The Working Group approved the proposed amendments of the Regulations set out in the Annex to document PCT/WG/1/13 with a view to their submission to the Assembly for consideration at its next session, in September-October 2008, subject to the comments and clarifications appearing in the following paragraphs and to possible further drafting changes to be made by the Secretariat.

146. There was wide support for the proposal to amend the Regulations to require that, in the case of amendments of the claims under Articles 19 and 34, applicants submit a complete set of claims rather than, as at present, replacement sheets only for those sheets of claims which, on account of an amendment, differed from sheets previously filed. Several delegations pointed to similar provisions in their applicable national laws and to their positive experience in practice with such an approach.

147. Several representatives of users expressed concerns about the additional burden that might be placed on applicants, in particular in cases where only minor amendments were made affecting some but not all claims, and suggested that the furnishing of a complete set of claims should be optional for the applicant, in addition to the presently prescribed procedure. One representative doubted the overall efficiency savings unless a system was in put in place which could reliably identify all differences between the original and the amended claims, since both examiners and third parties would be concerned to ensure that no changes other than the ones indicated in the accompanying letter had in fact been made.

148. The Delegation of Japan noted the variety of different methods of making amendments which might be used in the context of a system where many international applications were filed, and much of the processing was undertaken, in electronic form. While the Delegation did not wish to stand in the way of a consensus that the proposed amendments be submitted to the Assembly for consideration at its next session, it wished to place on record that it would have preferred more time to consider the proposals and, in particular, to consult with Japanese users.

149. The Secretariat was asked to further consider whether it was appropriate, in the sentence proposed to be added at the end of Rule 46.5(a), to refer to “all prior versions of the claims”, noting that, under Article 19, there is only one opportunity for the applicant to amend the claims. Consequential changes may also be required to Rule 66.8.

PROPOSALS BY THE EUROPEAN PATENT OFFICE WITH RESPECT TO CLAIMS FEES AND SEARCHING OF INDEPENDENT CLAIMS

150. Discussions were based on document PCT/WG/1/14.

151. In introducing the document, the Representative of the European Patent Office observed that the average size of patent applications was increasing and that the page fee was not a sufficient deterrent to filing unnecessarily large international applications under the PCT. Many national and regional systems had introduced claims fees. Since the PCT system did not provide for a comparable bar on large applications, it might become the preferred route for this kind of application. Such a development would, however, be detrimental to the good functioning of the PCT system. The use of the patent system was changing, as was the public perception of it. There was increasing criticism of practices which were perceived to be abuses of the system. If nothing was done to check these practices, the sustainability of the patent system was in doubt. The Representative was concerned for the interests of applicants, but also for the interests of the public at large. Legal certainty and the quality of granted patents were essential. Earlier in the session, the Working Group had stressed the importance of improving the quality of international searches, but some ways of drawing up descriptions and claims resulted in great difficulty for Offices and the public at large in assessing the true scope of the invention. In order to maintain a fair balance between the interests of applicants and third parties, Offices should not accept the tendency of certain applicants to obscure their inventions for as long as possible from examiners and the public. Excessive numbers of

claims, particularly independent claims of the same category, put the quality of the search at risk; examiners had in effect to guess at the true scope of the invention which was deliberately obscured by the manner of drafting the claims. Both quality and efficiency were at stake.

152. The Representative of the European Patent Office stated that two specific proposals were made: (i) to permit claims fees under the PCT in the same way as in many national and regional systems; and (ii) to allow International Searching Authorities to limit the international search to one independent claim per category in situations where the inclusion of more than one independent claim was not justified. The latter proposal was motivated by the wish to improve the quality of the international search by more clearly and openly defining the actual scope of the invention. It was essential to respect the standards of clarity and conciseness which were set out in PCT Article 6 and understood by the Contracting States. The interest of designated Offices in receiving the most complete international search possible had been taken into account in the proposal. The current situation was not compatible with the desire for improved quality. It had to be recognized that it was current practice for EPO examiners to make objections to multiple independent claims in the same category in PCT written opinions based on Article 6, and no complaints had been received so far about this practice. An equivalent approach to international search might therefore provide an appropriate way forward.

153. The problem of excessive numbers of claims was recognized by all delegations which took the floor. There was widespread support in principle for considering the potential of claims fees as a means of addressing the problem, subject to certain concerns, as noted below. Representatives of users also recognized a need for action, noting that most applicants also had an interest in the patent system as third parties, and “mega-applications” represented a major problem to them in attempting to monitor the risk of infringing the rights of others. Nevertheless, it was stressed that there were sometimes genuine reasons for complex applications and that it was important to find a fair balance and to ensure that applicants had an opportunity to receive a search report covering all their claims. It was observed that Rule 6.1 offered applicants the opportunity to use a reasonable number of claims in consideration of the nature of the invention as well as this being seen as a cap on the permitted number. It was also noted that multiple fees for extra claims could be incurred where there was both an international fee as well as additional claims fees to be paid to many of the designated Offices in the national phases.

154. One representative of users considered that the increasing number of claims was merely one aspect of a deeper problem in the patent system, founded mainly in the evolution of the system to embrace inventions which would not be considered as “technologies” in the traditional sense. The representative suggested that WIPO should critically study whether the direction which the patent system was taking might be damaging the system itself. Offices were overloaded and the prosecution of applications took many years, denying the protection which was the purpose of making the application and reducing the incentive to make further investment in research.

155. Many delegations expressed concern as to the appropriate sanction for failure to pay the claims fee, should it be introduced. Withdrawal of the international application was felt by many to be unduly harsh, though it was observed that the costs would be clear in advance of filing the international application and that it was open to an applicant who did not wish to pay all the fees to submit a smaller number of claims. Non-search of the additional claims was, in principle, more widely favored by most delegations, but some doubted that there was

a proper legal basis for this in the Treaty. Some, though not all, delegations considered that Article 17 strictly required search of all claims except for those which fell into certain defined categories (very unclear claims, certain subject matter, and cases of lack of unity of invention), and that none of these embraced excessive claims.

156. Several delegations reaffirmed the importance of any claims fee being an option which an International Searching Authority could use; no Authority should be compelled to introduce such a fee.

157. A number of delegations emphasized the importance, especially to smaller Offices without any search capacity, of establishing an international search which covered all the claims whenever possible. One representative of users stated that International Authorities should aspire to achieving the highest common standards in scope and depth of reports.

158. Several delegations noted that the acceptability and usefulness of a system of claims fees would depend enormously the details of such a system, and it would thus be useful to have a more detailed proposal on which to base future discussion. The number of claims which should be permitted before additional fees were incurred should be carefully considered so as not to unfairly disadvantage applicants from sectors of industry where larger numbers of claims were essential, though one delegation commented that charging higher fees to applicants with larger numbers of claims might anyway be seen as a more fair distribution of payments compared to costs. The Representative of the European Patent Office observed that 15 claims were permitted under the European Patent Convention before claims fees were charged. Moreover, the levels of the fees and their relationship with page fees would need to be set appropriately. There was also a risk that a claims fee might significantly complicate the system. One representative of users commented that it might be unfair to charge fees for any claims which were subsequently not searched because of a lack of unity of invention.

159. There was little support for the proposal to permit International Searching Authorities to limit international searches to one independent claim per category. The Representative of the European Patent Office pointed out that such a requirement (to which there were a number of exceptions covering cases where additional claims were considered necessary) was provided for in EPC Rule 43(2), which had a basis in EPC Article 84, which was equivalent in scope to PCT Article 6. However, some delegations and representatives of users stated that they considered that such a proposal would be contrary to PCT Article 6 and/or PCT Article 17 (for the same reasons as noted in paragraph 155, above). In response to a comment from one representative of users, the Representative of the European Patent Office acknowledged that, at present, EPC Rule 43(2) was enforced in connection with examination but not in connection with search, but stated that this approach was expected to change shortly. Some delegations considered that the proposed limitation on the international search would be undesirable for policy reasons in addition to legal ones, most notably, because of the increased risk that international applications would enter the national phase with many claims not searched.

160. The Chair concluded that there was broad support for further consideration of the proposal for the introduction of claims fees within the PCT, and that a more detailed proposal, which could be prepared by the European Patent Office, would be useful in this regard. The International Bureau could also assist in the investigation of a suitable legal basis. Noting that a number of possible flexibilities had been mentioned which might alleviate the concerns of

some delegations in connection with the proposed limitation of the international search to one independent claim per category, it would also be open to the European Patent Office to provide a more detailed proposal on that question.

PROPOSALS BY THE EUROPEAN PATENT OFFICE, THE JAPAN PATENT OFFICE AND THE UNITED STATES PATENT AND TRADEMARK OFFICE FOR MODIFICATION OF THE PCT ADMINISTRATIVE INSTRUCTIONS: SECTION HEADINGS IN PCT APPLICATIONS VIS-À-VIS THE TRILATERAL OFFICES' COMMON APPLICATION FORMAT

161. Discussions were based on document PCT/WG/1/15.

162. The Delegation of Japan presented an overview to the Working Group[4] on the Common Application Format (CAF) developed by the European Patent Office, the Japan Patent Office and the United States Patent Office in the course of their trilateral cooperation (the "Trilateral Offices"). The Delegation stated that the PCT had demonstrated the value of a common format which could be used in a wide range of States. At the request and with the help of user groups, the Trilateral Offices had sought to extend these benefits to national applications. The Offices had agreed upon and published the CAF, which set out a format for the description, claims, drawings and abstract in patent applications which would be acceptable to any of those Offices. Since the format had been established taking into account the framework of the PCT system, it was believed that an application drafted in that format should also be acceptable as an international application under the PCT. However, since some of the section headings were not exactly the same as those which were recommended in the PCT Administrative Instructions, it was desired to modify the Administrative Instructions to provide for the CAF headings as alternatives.

163. One delegation noted that many applicants did not use headings at all and suggested that the recommendation ("shall preferably") for these headings should be changed to a requirement ("shall"). However, it was pointed out that the Regulations, in Rule 5.1(c), provided that headings were optional, and there was no support for amending that Rule.

164. The Working Group noted that these proposals would shortly be the subject of regular consultations under Rule 89.2, as part of a bigger package of proposed modifications of the Administrative Instructions. The Secretariat indicated that, although paragraph 16 of the document proposed that the CAF-related modifications should enter into force on January 1, 2009, informal comments received from certain Offices relating to other parts of the package of proposed modifications suggested that such a commencement date would not leave enough time for implementation, and that, consequently, it was likely that the entire package would enter into force only on a later date, perhaps July 1, 2009. In any case, the question of the date of entry into force would also be the subject of the consultations.

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[4] The presentation is available from the WIPO website at www.wipo.int/meetings/en/details.jsp?meeting_code=pct/wg/1.

FURTHER WORK

165. One delegation expressed concern about the ever-increasing complexity of the text of the Regulations, notably where multiple cross-referencing was used, and asked whether consideration had been given to redrafting the entire Regulations "from scratch" and simplifying the drafting. The Secretariat noted that, while the legal framework was admittedly complex, applicants and Offices alike were using the system on a daily basis and seemed content with the way the overall system was working, as proven by the steady increase in the number of applications filed under the PCT. The Secretariat further stated that, while it shared the delegation's desire for a greatly simplified text in principle, such a redraft would be a major challenge, notably in view of the fact that it would have to be done within the framework of the existing Treaty, which had given rise to the need for some complexity in the drafting of amendments of the Regulations.

166. The Secretariat informed the Working Group that any further drafting changes to the proposed amendments of the Regulations which had been approved by the Working Group with a view to their submission to the Assembly for consideration at its next session, in September-October 2008, would be posted on the PCT Working Group electronic forum[5] for comment by members and observers of the Working Group, with a view to preparing final texts for submission to the Assembly.

167. One delegation asked about future sessions of the Working Group, noting that the Assembly had, in September-October 2007, decided that the work of both the Committee on Reform of the PCT and the Working Group on Reform of the PCT had been completed and that the mandate of both bodies had come to an end. The Secretariat recalled that the Assembly had also decided, at that same session, that, should the need arise to consider a matter which required submission to the Assembly, a Working Group of the Assembly should be convened to do preparatory work rather than submitting the matter straight to the Assembly.

168. The Secretariat stated further that it intended, as it had done in preparation for the present session of the Working Group, to send, towards the end of 2008, a Circular to all members and observers of the Working Group, inviting proposals for matters to be discussed by the Working Group, in order to determine whether a session of the Working Group should be convened in the first half of 2009.

169. The Working Group agreed that the present report should be submitted to the Assembly for consideration at its next session, in September-October 2008, to inform the Assembly of the discussions and decisions that had been made at the present session.

170. The Working Group agreed to recommend to the Assembly that, subject to the availability of sufficient funds:

(i) one session of the Working Group should, if necessary, subject to the consultations mentioned in paragraph 168, above, be convened between the September 2008 and September 2009 sessions of the Assembly; and

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[5] See WIPO's website at http://www.wipo.int/pct-wg/en.

(ii) the same financial assistance that had been made available to enable attendance of certain delegations at this session of the Working Group should be made available to enable attendance of certain delegations at that next session.

ADOPTION OF THE REPORT OF THE SESSION

171. The Working Group unanimously adopted this report on May 30, 2008.

[Annex *[of document PCT/WG/1/16]* follows]

ANNEX
[of document PCT/WG/1/16]

LIST OF PARTICIPANTS

[not reproduced here]

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