

International Patent Cooperation Union (PCT Union)

Assembly

Fifty-Third (23rd Ordinary) Session
Geneva, October 4 to 8, 2021

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/62/1): 1 to 6, 10(ii), 11, 12, 21, 32 and 33.
2. The reports on the said items, with the exception of item 21, are contained in the General Report (document A/62/13).
3. The report on item 21 is contained in the present document.
4. Ms. María Loreto Bresky (Chile) was elected Chair of the Assembly; Ms. Florence Galtier (France) and Mr. GAN Shaoning (China) were elected Vice-Chairs.

ITEM 21 OF THE CONSOLIDATED AGENDA

PCT SYSTEM

Appointment of the Eurasian Patent Office (EAPO) as an International Searching and Preliminary Examining Authority under the PCT

5. Discussions were based on document PCT/A/53/1.
6. The Secretariat introduced the document by explaining that the Committee for Technical Cooperation had met in October 2020 to consider an application for appointment of the Eurasian Patent Office (EAPO) as an International Searching and Preliminary Examining Authority under the PCT. The Committee had reviewed the application and unanimously agreed to recommend the appointment to the Assembly. Following the advice of the Committee, Article 16(3)(b) and Article 32(3) required the Assembly to hear the Representative of the EAPO, and then to decide on the appointment and approve the text of a draft agreement between the Eurasian Patent Organization and the International Bureau, as set out in the Annex to the document. With regard to the agreement, the proposed draft followed the same form as the agreements in place with the existing International Authorities. The agreement would remain in force until December 31, 2027, in line with the review and renewal of the other existing agreements.
7. The Representative of the EAPO explained that the application for appointment of the EAPO as an International Searching and Preliminary Examination Authority under the PCT was the result of more than 26 years of work. The possibility of EAPO to apply for the status as an International Searching and Preliminary Examining Authority was stipulated in Article 20 of the Eurasian Patent Convention (EAPC) of September 9, 1994, which was drafted together with WIPO, including the personal involvement of the then Director General, Dr. Arpad Bogsch. The States party to the EAPC, at the creation of the EAPO, had set the objective of such participation in the PCT System. At the thirty-fifth meeting of the Eurasian Patent Organization Administrative Council, held on September 10 and 11, 2019, these States unanimously voted to allow the EAPO to apply for the status of an International Searching and Preliminary Examining Authority. The Eurasian Patent Organization represented an economically-developing region with over 200 million people and an economically-active population of more than 100 million people. The Global Innovation Index consistently noted the advantages of the countries of the Eurasian region in the field of human capital. The Eurasian region had scientific schools with a rich history and traditionally strong positions in education. In general, there were about 2,500 organizations in the region engaged in scientific research, half of which were higher educational institutions (with about 2,000 universities in the region), bringing together a faculty of more than 350,000 people. Given that the EAPC Member States had more than 62 million people under the age of 25, the region had strong potential in the development of human resources that was far from fully realized. All the EAPC Member States were committed to development as reflected in the state programs and plans for the development of national economies adopted in the countries of the region. This approach was already yielding practical results. For example, in most EAPC Member States, there was a high level of development and use of information and telecommunication technologies. If appointed as an International Searching and Preliminary Examining Authority, innovators in the Eurasian region would be able to use the EAPO at all stages of the PCT from filing the international application, international search and preliminary examination, and in the regional phase. As a designated Office, an applicant would be able to rely on previous interaction with the EAPO using the same communication channels and information resources, and be able to communicate with experts using their national language. The appointment of the EAPO as an International Searching Authority and an International Preliminary Examination Authority would expand and improve the efficiency of the use of the PCT System by inventors and companies from the countries of the region. This, in turn, was one of the important prerequisites for the development of science-intensive

technologies and high-tech and innovative sectors of the economies of the Eurasian region. In terms of the technical aspects of the appointment, the Representative noted that the Committee for Technical Cooperation, at its thirty-first session from October 5 to 8, 2020, had made a positive recommendation to the Assembly. Moreover, the COVID-19 pandemic had not resulted in a negative impact on the activities of EAPO and its readiness to perform the functions of an International Authority. EAPO had well-developed electronic systems that ensured full electronic interaction with applicants, the possibility of remote working for any employee and a paperless patent procedure. EAPO received more than 90 per cent of its applications electronically, and this figure continued to grow. In addition, EAPO had extensive experience in using the electronic services provided by the International Bureau, being the first Office in the region to use the ePCT system and the WIPO Digital Access Service (DAS) for the retrieval of priority documents. The EAPO was now ready to begin work as an International Searching Authority and International Preliminary Examining Authority as soon as possible at the beginning of 2022. The Representative concluded by thanking the China National Intellectual Property Administration (CNIPA) and the Federal Service for Intellectual Property (ROSPATENT) for their advice and assistance with the application to ensure that the EAPO was compliant with all the requirements to become an International Searching and Preliminary Examining Authority. The Representative also thanked the 14 States whose national IP Offices had given written support for the application, namely, Kazakhstan, Colombia, the Russian Federation, Azerbaijan, China, the Czech Republic, Armenia, Chile, the Republic of Moldova, Belarus, Canada, Brazil, Egypt and Mexico. Finally, the Representative acknowledged the assistance and advice from the Secretariat and the trust and confidence that the PCT membership would place in the EAPO performing the duties of an International Searching and Preliminary Examining Authority.

8. The Delegation of the Russian Federation aligned itself with the statement made by the Delegation of Belarus on behalf of the Group of Central Asian, Caucasus and Eastern European Countries (CACEEC) under item 5 of the Consolidated Agenda (document A/62/1) expressing support for the appointment of the EAPO as an International Searching and Preliminary Examining Authority under the PCT (see paragraph 5 of document A/62/13). The appointment would serve the interests of applicants and the countries in the Eurasian region and promote greater use of the PCT System. The Delegation stated that expanding the functions of the EAPO within the PCT System would create additional advantages for applicants because EAPO would be able to carry out all the stages in examination of an international application. The EAPO met all the requirements for appointment set out in the PCT Regulations, having a sufficient number of highly qualified patent examiners, the required technical and information infrastructure and an effective quality management system.

9. The Delegation of Spain underlined the important and valuable contribution of all Member States in developing the international intellectual property registration systems. In line with this, the Spanish Patent and Trademark Office (OEPM) had been working collaboratively over many years to develop and improve the patent system in general with its representatives taking an active role in the WIPO decision-making bodies within the PCT System. The OEPM participated in the WIPO Fee Transfer Service as both a receiving Office and as an International Searching Authority to reduce the risks related to foreign currency exchange rates. Furthermore, the Office had actively participated as part of the Delegation of Spain at the PCT Working Group, notably working closely with the European Patent Office, and the Delegations of France, Switzerland and the United Kingdom towards the amendment of Rule 82*quater*. This was important as it helped to strengthen the safeguards for applicants and third parties when there were general disruptions, as had been the case of COVID-19, which stood in the way of meeting time limits set out in the PCT Regulations. The Delegation also supported the amendments to Rules 12, 13*ter*, 19, and 49 required for the implementation in the PCT of WIPO Standard ST.26 for the presentation of nucleotide and amino acid sequence listings using XML. The Delegation supported the appointment of the EAPO as an International Searching and Preliminary Examining Authority in accordance with the unanimous recommendation of the

thirty-first session of the Committee for Technical Cooperation, since the Office met the technical requirements set out in Rule 36. The Federal Service for Intellectual Property of the Russian Federation as well as the China National International Property Administration had reported on this matter favorably. The appointment would benefit the PCT System in the Eurasian region making it easier for applicants from the region to file international applications and give them further incentive to use the PCT System. The Delegation indicated that it opposed the continuation of the supplementary international search system because the costs were not justified and the OEPM did not have the information it needed to provide to its users. Use of the service had been low and the Delegation therefore supported the decision of the Working Group to review the system no later than 2027.

10. The Delegation of Japan supported the appointment of the EAPO as an International Searching and Preliminary Examining Authority under the PCT. The Delegation welcomed the EAPO's contribution to enhancing the PCT System, which was an important instrument for all innovators seeking patent protection internationally. The appointment of the EAPO would bring benefits to the large number of applicants from the region by increasing their options of International Searching and Preliminary Examining Authorities. The Delegation hoped that the EAPO would play an important role in the future development of the PCT System.

11. The Delegation of China supported the appointment of the EAPO as an International Searching and Preliminary Examining Authority under the PCT. This would further promote the development and use of the PCT System.

12. The Delegation of the United States of America supported the appointment of the EAPO as an International Searching and Preliminary Examining Authority under the PCT and approval of the agreement between the EAPO and the International Bureau contained in the Annex to document PCT/A/53/1. The Delegation also supported the adoption of the proposed decision set forth in paragraph 7 of document PCT/A/53/2, whereby the International Bureau would continue to monitor and report to the Meeting of International Authorities and the PCT Working Group on significant developments relating to the supplementary international search system, and would review the system again as recommended by the International Bureau or by a Contracting State, no later than 2027. Finally, the Delegation supported the adoption of the proposed amendments to the PCT Regulations set out in Annexes I to III of document PCT/A/53/3 and the entry into force and transitional arrangements set forth in that document.

13. The Delegation of the Republic of Korea supported the appointment of the EAPO as an International Searching Authority and an International Preliminary Examining Authority. The Korean Intellectual Property Office and the EAPO had been closely cooperating in the field of PCT, in particular, through a Memorandum of Understanding on bilateral cooperation and a Memorandum of Understanding on the Patent Prosecution Highway signed on September 25, 2018. The Delegation believed that the appointment of the EAPO as an International Searching and Preliminary Examining Authority would make the PCT System more convenient for users, and the Republic of Korea wished to take the opportunity of the appointment to strengthen its cooperation with the EAPO in the area of the PCT.

14. The Representative of the Intellectual Property Latin American School (ELAPI) stated that ELAPI intended to collaborate in the development of new strategies to accelerate discussions on "Patents and Health". In this work, there was a need to consider both the perspective of the protection and the diffusion of new relevant technologies, and the urgent need to be able to face global emergencies like the COVID-19 pandemic and probably others in the future, with the sole objective of recognizing the importance of condensing many months or years of research into a single document. This would allow the patent applicant who has developed the technology to benefit from their efforts, and likewise enable other researchers and developers where the patent was not protected to use the knowledge in the patent to develop technology around the invention or even disruptive technologies based on the advances to date in the specific field of

the invention. ELAPI believed that regulation would always be better than any prohibition. ELAPI hoped to use its experience in Latin America, particularly as it relates to PCT applications at the National Institute of Industrial Property of Chile, as well as global experience during the COVID-19 pandemic, to contribute to improving the system of protecting technology through patents by incorporating tools that connect, enable and facilitate the transfer of technology in a cross-cutting way. This started from the early diffusion of new technologies towards allowing licenses to ensure that technologies developed for human health could finally fulfil their intended objectives, both for those developing the technology and those benefiting from it internationally. Incentivizing the incorporation of IP protection mechanisms in scientific research such as patents for inventions was key to the agile development of new technologies which otherwise could remain secret for more than 10 years, as could have been the case with vaccine technologies based on viral mRNA. ELAPI offered its academic support to the Assembly, Committees and Member States, especially the Group of Latin American and Caribbean Countries (GRULAC), in order to help strengthen the patent system, as an axis and vehicle for global technological development.

15. The Assembly of the PCT Union, in accordance with Articles 16(3) and 32(3) of the PCT:

(i) approved the text of the draft Agreement between the Eurasian Patent Organization and the International Bureau set out in the Annex to document PCT/A/53/1; and

(ii) appointed the Eurasian Patent Office as an International Searching Authority and International Preliminary Examining Authority with effect from the entry into force of the Agreement until December 31, 2027.

16. The Director General of WIPO, Mr. Daren Tang, congratulated the EAPO on its appointment as an International Searching Authority and International Preliminary Examining Authority under the PCT on behalf of the International Bureau. The EAPO and the International Bureau had a long history of fruitful cooperation, with the EAPO operating as a receiving Office and as a designated and elected Office since its establishment more than 25 years ago. The International Bureau looked forward to strengthening cooperation with the EAPO in its new role as an International Searching and Preliminary Examining Authority.

17. The Delegation of Saudi Arabia congratulated the EAPO on its appointment as an International Searching and Preliminary Examining Authority.

18. The Representative of the EAPO thanked the delegations for their trust and confidence in approving the appointment of EAPO as an International Searching and Preliminary Examining Authority. The Representative stated that the EAPO would endeavor to justify this new responsibility. EAPO would work with the International Bureau and other Offices and organizations as an International Authority, with the aim of strengthening intellectual property and the way it supported innovation in the Eurasian region and worldwide.

Review of the Supplementary International Search System

19. Discussions were based on document PCT/A/53/2.

20. The Secretariat explained that the document represented a third review by the Assembly of the supplementary international search system, which began operation in 2009. The thirteenth session of the PCT Working Group had considered this matter and details of these considerations were in documents PCT/WG/13/4 Rev. and PCT/WG/13/14. The system had never been widely used and had certain costs to maintain. Some delegations had wished to end supplementary international search. Other delegations had considered that it remained beneficial to some applicants and should be maintained pending further developments, such as

the outcome of the collaborative search and examination pilot or the making available of further options within the supplementary international search system. In the absence of consensus on the substance of a way forward, the Working Group had agreed with the proposal of the Chair of the Working Group to recommend that the International Bureau should continue to monitor the system and report on significant developments. Furthermore, the Working Group had recommended that the Assembly should review the system again at a time to be recommended by the International Bureau, or on request by a PCT Contracting State, but no later than 2027. The Secretariat observed that 2027 had been chosen to allow time for the PCT Working Group to receive a final report from the collaborative search and examination pilot. The Working Group could then consider whether an arrangement based on that experience might form a useful part of the PCT System, addressing aspects of the issues that the supplementary international search had aimed to cover.

21. The Representative of the Health and Environment Program (HEP) supported the proposal and commended the progress of WIPO towards achieving gender parity, as seen by both Ms. Bresky as Chair and Ms. Jorgenson as Deputy Director General on the podium, which set a good example to other organizations, showing that women in high places could do an excellent job.

22. The Assembly of the PCT Union:

- (i) noted the review of the supplementary international search system (document PCT/A/53/2); and
- (ii) adopted the proposed decision set out in paragraph 7 of that document.

Proposed Amendments to the PCT Regulations

23. Discussions were based on document PCT/A/53/3.

24. The Secretariat introduced the document, which presented two sets of proposed amendments to the PCT Regulations. The amendments proposed in Annex I related to the move from WIPO Standard ST.25 to WIPO Standard ST.26 for the presentation of sequence listings in applications containing disclosure of nucleotides and amino acids. The amendments proposed in Annex II provided for strengthening safeguards for applicants and third parties in the case of general disruption that affected their ability to meet time limits in the international phase of PCT processing. The PCT Working Group had reviewed and approved both sets of proposals. The proposed entry into force of the amendments was set out in paragraph 5 of the document. Since the General Assembly had approved the proposal in document WO/GA/54/14 to set the implementation date for WIPO Standard ST.26 as July 1, 2022, both sets of amendments would come into force on that date. The amendments relating to WIPO Standard ST.26 would apply to international applications filed on or after that date. The amendments relating to safeguards would apply to time limits that expired on or after that date.

25. The Assembly of the PCT Union adopted the proposed amendments to the Regulations under the PCT set out in Annexes I and II of document PCT/A/53/3, and the entry into force and transitional arrangements set out in paragraph 5 of the same document, noting that the date decided by the WIPO General Assembly relating to the entry into force of the amendments in Annex I of the document was July 1, 2022.

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