

Patent Cooperation Treaty (PCT) Working Group

Tenth Session
Geneva, May 8 to 12, 2017

SUMMARY BY THE CHAIR

AGENDA ITEM 1: OPENING OF THE SESSION

1. Mr. John Sandage, Deputy Director General, opened the session on behalf of the Director General of WIPO. Mr. Michael Richardson (WIPO) acted as Secretary to the Working Group.

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

2. The Working Group unanimously elected Mr. Maximiliano Santa Cruz (Chile) as Chair and Mr. Victor Portelli (Australia) as Vice-Chair for the session. There were no nominations for a second Vice-Chair.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

3. The Working Group adopted the revised draft agenda as proposed in document PCT/WG/10/1 Prov. 2.

AGENDA ITEM 4: PCT STATISTICS

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

¹ The presentation is available from the WIPO website at:
http://www.wipo.int/meetings/en/details.jsp?meeting_code=pct/wg/10

AGENDA ITEM 5: MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT OF THE TWENTY-FOURTH SESSION

5. Discussions were based on document PCT/WG/10/3.
6. One delegation stressed the importance of quality-related discussions by the Meeting of International Authorities. It welcomed the paired review exercise, which provided International Authorities with an opportunity to share best practices in their Quality Management Systems, as well as work on user feedback. It further referred to an ongoing project, carried out with other Offices, aimed at setting up feedback mechanisms which allowed designated Offices to give feedback to International Searching Authorities on their international work products and encouraged other Offices to consider similar initiatives. The delegation also expressed support for the sharing of search strategies to the fullest extent, noting that it aimed to share its own strategies in the near future, and offered to share its experiences with regard to ISO 9001 certification.
7. In response to a comment by one delegation about utilization of the PCT-Patent Prosecution Highway (PCT-PPH) referred to in paragraph 36 of the Summary by the Chair of the Meeting of International Authorities set out in document PCT/WG/10/3, the Secretariat clarified that the International Bureau would ensure that all Offices concerned would be consulted on any modification to the Administrative Instructions or International Search and Preliminary Examination Guidelines in connection with this issue. While this was most commonly done by way of PCT Circulars, issues would be referred to the PCT Working Group where this appeared appropriate.
 8. The Working Group noted the report of the twenty-fourth session of the Meeting of International Authorities, based on a Summary by the Chair of that session contained in document PCT/MIA/24/15 and reproduced in the Annex to document PCT/WG/10/3.

AGENDA ITEM 6: PCT ONLINE SERVICES

9. Discussions were based on document PCT/WG/10/21.
10. All delegations which took the floor expressed appreciation for the functionality for applicants and Offices made available through ePCT and broadly supported the directions for further development proposed in the document. Several delegations noted that the functionality of ePCT and good support from the International Bureau had allowed their Offices to move easily to electronic filing and processing. One delegation noted that, with effective collaboration between the national Office and its users, a complete switch from PCT-SAFE to ePCT-Filing had been achieved easily, resulting in efficiency benefits for both sides. One delegation expressed serious concerns regarding the implementation of the signature requirements in the ePCT filing tool in view of the fact that the signature could be performed independently from the rest of the request form.
11. Delegations expressed particular interest in certain directions of work, including:
 - (a) delivery of XML from Offices (particularly for international search reports and written opinions);
 - (b) use of “docx” for application bodies;
 - (c) delivery of improved management reports;
 - (d) further improved delivery of information in different languages;
 - (e) improving the legal framework around “physical requirements” for electronic filings;

(f) integration with “netting” arrangements as referred to under agenda item 8, below, to allow easier payment mechanisms; and

(g) seeking radical improvements by breaking away from having electronic processes essentially mimicking paper ones.

12. One delegation noted that the proposals relating to color drawings would have effects on national regulations and IT systems, which might need to be taken into account in deciding on appropriate start dates.

13. In response to questions from two delegations, the International Bureau reiterated that it wished to work with Offices towards ending support for PCT-SAFE in order to eliminate the costs of maintaining duplicate systems. However, this would not be done unilaterally while PCT-SAFE remained important to a significant body of users who were unable to use ePCT-Filing due to national security restrictions.

14. The Working Group noted the contents of document PCT/WG/10/21.

AGENDA ITEM 7: eSEARCHCOPY

15. Discussions were based on documents PCT/WG/10/13 and 22.

16. The Delegation of the European Patent Office noted that the pilot implementations of the eSearchCopy/PCT Paperless service had been successfully concluded last year and that the service was fully operational with 12 receiving Offices. The delegation hoped to move all receiving Offices for which the Office was competent to act as an International Searching Authority to this system eventually, but that there was a need for a two to three month trial period of dual running for each Office to ensure that the service had been implemented effectively, checking consistency, quality and timeliness. This took resources and consequently the implementation needed to be done in small groups of about four Offices.

17. Several delegations whose national Offices had implemented eSearchCopy indicated that it was useful and encouraged other Offices to participate, both as receiving Offices and International Searching Authorities. One delegation noted a wish for further improvements, including sending improved bibliographic data and making arrangements for transmitting color drawings. This delegation also noted that, in principle, a link with the “netting” arrangements referred to under agenda item 8, below, might be useful, though care would be needed in any such implementation.

18. The Working Group noted the contents of documents PCT/WG/10/13 and 22.

AGENDA ITEM 8: PROGRESS REPORT: POSSIBLE MEASURES TO REDUCE EXPOSURE OF PCT FEE INCOME TO MOVEMENTS IN CURRENCY EXCHANGE RATES THROUGH NETTING

19. Discussions were based on document PCT/WG/10/6.

20. All delegations which took the floor generally welcomed the proposal to commence a pilot project with a number of receiving Offices and International Authorities for the netting of search fees and international filing fees. Comments by delegations included the following:

(a) the fact that the envisaged centralized payment system required fundamental changes to IT systems and work procedures at national Offices and thus the need to leave sufficient time to review the proposed netting structure prior to its implementation;

- (b) the concern that the proposed netting structure would result in additional work for Offices in their various PCT capacities – and, correspondingly, the need for the pilot to demonstrate that the structure did simplify and make the management of fees more cost-effective for the participating Offices;
- (c) the need for the envisaged structure to be voluntary for Offices;
- (d) the need for the envisaged structure to ensure the transparency of all transactions;
- (e) the need to share with all members of the Working Group the results of the ongoing detailed analysis of the financial implications of the possible setting up of a netting structure;
- (f) the need to eventually link the netting project with the eSearchCopy project;
- (g) the need to eventually align the legal framework to take account of the fact that receiving Offices would no longer transfer search fees directly to the International Searching Authority but via the International Bureau; and
- (h) the need to include various different pairs of receiving Offices and International Searching Authorities and various pairs of currencies.

21. The Working Group noted the contents of document PCT/WG/10/6 and invited the International Bureau to prepare a draft model agreement for use by all participating receiving Offices and International Authorities.

AGENDA ITEM 9: SECOND SUPPLEMENT TO “ESTIMATING A PCT FEE ELASTICITY STUDY”

22. Discussions were based on document PCT/WG/10/2.

23. One delegation stated that the document showed that there was significant room for improvement of the conditions which affect the number of patent applications filed by universities, both through actions by national governments as well as by the international community, such as through fee reductions at the international level. The document showed that fee reductions for universities from developing countries had a very limited impact on PCT fee income, notably in case a ceiling in the number of applications filed by a university applicant in a given year were to be implemented. It further showed that a fee reduction granted to universities from developing countries would result in more additional filings compared to the same fee reduction granted to universities from developed countries. Any fee reduction should therefore primarily target universities from developing countries.

24. One delegation noted the difficulty in determining accurate quantitative values for the changes in the number of additional applications filed as a result of fee reductions and the consequential impact on PCT fee income. In practice, it would appear that administering such fee reductions would be complex and potentially open to abuse, while such reductions would not necessarily result in a predictable and large increase in the number of additional applications filed by universities that benefitted from such fee reductions.

25. One delegation stated that there was insufficient evidence to show that the likely increase in the number of additional applications filed by universities that benefitted from such fee reductions would indeed stimulate innovation and increase the number of commercially viable patents granted to universities; rather, the granting of fee reductions might result in weaker patents and thus fewer partnerships with industry.

26. The Working Group noted the contents of document PCT/WG/10/2.

AGENDA ITEM 10: FEE REDUCTIONS FOR CERTAIN APPLICANTS FROM CERTAIN COUNTRIES, NOTABLY DEVELOPING AND LEAST DEVELOPED COUNTRIES

PROPOSAL ON PCT FEE POLICY TO STIMULATE PATENT FILING BY UNIVERSITIES

27. Discussions were based on document PCT/WG/10/18.
28. The Delegation of Brazil introduced the proposal in document PCT/WG/10/18.
29. Many delegations and regional groups supported the proposal, mentioning the positive effect of reduction of fees for universities in developing countries. Other delegations agreed that the ability of universities to participate effectively in the PCT System was important and it was recognized that this new proposal had incorporated certain concerns expressed in the previous meeting. Nevertheless, some States were not able to support the proposal at this stage for a variety of reasons.
30. The Chair proposed that efforts be made to advance discussions on the issue before the next session of the Working Group. The International Bureau should send a Circular before the end of July offering interested parties an opportunity to propose issues to be discussed in a workshop to be held during the next session of the Working Group. Such issues might include:
 - (a) issues which had been raised in this session, such as definitions of “university”, financial impact or the relationship with the existing fee reductions;
 - (b) sharing of Member States’ national or regional fee reduction programs; and
 - (c) other measures which might be considered as additions or alternatives to fee reductions as ways of stimulating innovation by universities in developing countries and elsewhere.
31. The responses should be made publicly available and may serve as the basis of both the agenda of the workshop and further proposals by Member States.
 32. The Working Group invited the International Bureau to issue a Circular as set out in paragraph 30, above, and to convene a workshop, to be held during the next session of the Working Group.

PROPOSAL TO REDUCE THE NUMBER OF FEE REDUCTIONS BEING CLAIMED BY APPLICATIONS NOT ELIGIBLE FOR THE FEE REDUCTION

33. Discussions were based on document PCT/WG/10/8.
34. One delegation noted that the proposed changes confirmed an obligation but no sanction to a change of ownership to a non-eligible entity by the deletion of the proposed modification to Rule 92*bis*. One aspect that had not been touched upon at the ninth session of the Working Group was the fact that some International Searching Authorities reduced the international search fee by 75 per cent for certain applicants under similar conditions. As that fee was collected by the receiving Office, the delegation hoped that consideration could be given to that problem in the future in order to support International Searching Authorities which had fee reduction schemes for applicants from developing countries.
 35. The Working Group approved the proposed amendments to the Schedule of Fees set out in the Annex to document PCT/WG/10/8 and the Understanding set out in paragraph 14 of that document, with a view to their submission to the Assembly for consideration at its next session in October 2017.

PROGRESS REPORT ON IMPLEMENTATION OF FEE REDUCTION CHANGES

36. Discussions were based on document PCT/WG/10/20.

37. Several delegations observed that there had been a significant reduction in the number of international applications filed by the nationals and residents of the States which, following the change in the eligibility criteria, ceased to be eligible for the fee reduction.

38. The International Bureau agreed to provide an updated report, similar to that set out in document PCT/WG/10/20, to the next session of the Working Group.

39. The Working Group noted the report in document PCT/WG/10/20.

AGENDA ITEM 11: COORDINATION OF TECHNICAL ASSISTANCE UNDER THE PCT

40. Discussions were based on document PCT/WG/10/19.

41. The Delegation of Senegal, speaking on behalf of the African Group, welcomed the technical assistance activities carried out by the International Bureau for the benefit of IP Offices in developing and least developed countries, which was vital to achieve a more balanced global IP system. Technical assistance needed to be demand driven. The International Bureau, working with Member States, should identify the gaps to improve innovation and creativity along with the structural causes, adapting technical assistance to the regional and national context. The African Group therefore encouraged the International Bureau to continue its capacity building work.

42. One delegation emphasized the difference between the discussions on technical assistance related to the PCT and those in a broader context in the Committee on Development and Intellectual Property (CDIP). It underlined the importance of continuing the reporting by the Secretariat on PCT-related technical assistance to each session of the Working Group. This was supported by another delegation, which emphasized the distinction between technical assistance under the WIPO Development Agenda Recommendations and the specific mandate for PCT-related technical assistance under PCT Article 51.

43. The Secretariat clarified that the discussions in the CDIP aimed at reviewing WIPO technical assistance and considering how delivery of technical assistance could be improved in the future were additional to the reporting by the Secretariat to the Working Group on PCT-related technical assistance. The Secretariat intended to continue with its reporting to the Working Group, in accordance with the agreement by the Working Group in 2012 that such reporting should be a regular agenda item at future sessions of the Working Group. Concerning the discussions which were ongoing in the CDIP, any recommendations on implementation of technical assistance that the CDIP would make in the future would include a component relating to the PCT; such recommendations would then return to the Working Group for consideration at a future session.

44. The Working Group noted the contents of document PCT/WG/10/19.

AGENDA ITEM 12: TRAINING OF EXAMINERS

SURVEY ON PATENT EXAMINER TRAINING

45. Discussions were based on document PCT/WG/10/7.

46. All delegations which took the floor stressed the importance of examiner training and welcomed the evaluation of the survey. Delegations representing donor Offices provided details of the examiner training they had delivered or other training resources which they had made available. One delegation stated that it was willing to host up to two guest examiners at its basic examiner training course in September 2017. Delegations which had set up Funds-in-Trust arrangements with WIPO gave information on examiner training activities supported

under these arrangements. A representative of a user group expressed appreciation for the training of examiners offered by WIPO Member States to other Offices, and was confident that the quality of examination would improve with these efforts.

47. The Working Group noted the contents of document PCT/WG/10/7.

COORDINATION OF PATENT EXAMINER TRAINING

48. Discussions were based on document PCT/WG/10/9.

49. All delegations which took the floor supported the principle of improving the coordination of patent examiner training. However, delegations representing donor Offices underlined that resources dedicated to training of examiners in other Offices were limited. Training therefore needed to be carefully managed in order to address the needs of recipient Offices in the best way. Donor Offices should retain discretion on the content of training activities being provided and on the recipient Offices, in line with their respective cooperation policies. Similarly, assessment of the individual examiners had to remain the responsibility of the individual Offices. One delegation stated that it was willing to share its examiner competency framework with the International Bureau.

50. The Working Group noted the contents of document PCT/WG/10/9.

AGENDA ITEM 13: ENGLISH TITLE OF INVENTION

51. Discussions were based on document PCT/WG/10/17.

52. There was general support for the principle of the proposal by the Republic of Korea to allow applicants filing an international application in a language other than English to optionally submit an English language translation of the title. This would be of benefit to the applicant, the International Bureau and patent information users alike. It was emphasized that this must be an option and not an obligation for the applicant. Most delegations agreed that the International Bureau should take the recommended English title into account, but not be obliged to use it. Consideration might be given to allowing applicants to transmit a proposed title directly to the International Bureau, rather than necessarily submitting it to the receiving Office at the time of filing or together with any other translation.

53. The Working Group invited the Korean Intellectual Property Office to work with the International Bureau and other interested Offices to develop a detailed proposal for permitting applicants to propose an English language title of the invention, taking into account the necessary changes to the legal framework and the work which would be needed to implement the system at national Offices and advertise the system to applicants.

AGENDA ITEM 14: NUMBER OF WORDS IN ABSTRACTS AND FRONT PAGE DRAWINGS

54. Discussions were based on document PCT/WG/10/23.

55. Delegations which took the floor agreed on the desirability of reducing translation costs and increasing the quality of patent abstracts. However, it was essential to find an appropriate way of ensuring that International Searching Authorities acted effectively to ensure the quality of abstracts while still emphasizing the obligation of the applicant to provide a good quality draft. In this context, it was important to raise awareness and understanding with applicants. Word counts were not a measure of quality of individual abstracts. An automated word count in filing tools could be useful for providing a warning, but should not prevent filing simply because the length of the abstract fell outside the recommended ranges.

56. Several delegations considered that the proposals for recommended ranges of words or characters in abstracts in different languages of publication might be beneficial in principle, but that further consideration was needed of the details, taking into account the needs of different technical fields, differences in linguistic structure and the comments of applicants. Careful consideration was also needed for the front page drawing, especially concerning how flow charts could be made more useful.

57. The International Bureau indicated that further information and discussion was necessary before being able to propose suitable modifications to the *PCT Applicant's Guide* and the International Search and Preliminary Examination Guidelines. The International Bureau intended to draft a Circular with preliminary proposals and further questions, which would most likely be further discussed at the next sessions of the Meeting of International Authorities under the PCT and the PCT Working Group in 2018. Contributions from Offices on possible modifications, especially concerning guidelines on drafting abstracts, did not need to wait for the Circular to be issued and would be welcome immediately. The International Bureau would also add a word count tool to ePCT-Filing.

58. The Working Group agreed that:

(a) the International Bureau should issue a Circular to invite further comments on drafting of abstracts to help in drafting potential modifications to the *PCT Applicant's Guide* and International Search and Preliminary Examination Guidelines; and

(b) Offices willing to share their guidelines on preparing abstracts should send these to the International Bureau as soon as possible, to be taken into account in the preparation of the Circular.

AGENDA ITEM 15: USE OF NATIONAL CLASSIFICATION SYMBOLS IN INTERNATIONAL APPLICATIONS

59. Discussions were based on document PCT/WG/10/4.

60. Delegations broadly supported the proposal to make available national classification symbols applied to international applications by International Searching Authorities, which had originally been proposed by the Republic of Korea at the ninth session of the Working Group. This would be a useful step towards more effective patent information. Delegations emphasized that such classification should only be done by International Searching Authorities which had experience in use of the relevant classification system. While the most widely relevant such system was the Cooperative Patent Classification (CPC), the same approach might also apply to other national systems, such as the Japan Patent Office's FI classification system, as long as the appropriate conditions were met.

61. Several delegations indicated their preference that the national classification symbols be included on the front page of the international publication as this would increase transparency and would improve patent literature searchability. Other delegations considered that only the International Patent Classification (IPC) was appropriate in this place. One delegation emphasized that the use of the CPC should not be at the expense of the obligation under the Strasbourg Agreement for Offices to classify the document in accordance with the IPC.

62. The International Bureau indicated that it would consult with Offices through a Circular on the appropriate technical standards which would be required for effective exchange of national classification symbols, both from the International Searching Authorities to the International Bureau and from the International Bureau to patent information users. The Delegation of the Republic of Korea indicated that it was willing to contribute to the development of this proposal in any way. A suitable warning would be required for changes to the format of any existing data exchanges to which the new information was to be added. At the request of one delegation, the

International Bureau undertook to present further information concerning the benefits of publishing the CPC on the front page, particularly for Offices which did not use that classification.

63. The Working Group agreed that the International Bureau should issue a Circular to Offices and user groups to consult on the next steps, as outlined in paragraph 62, above.

AGENDA ITEM 16: ISSUANCE OF A PROVISIONAL OPINION ACCOMPANYING THE PARTIAL SEARCH RESULTS

64. Discussions were based on document PCT/WG/10/14.

65. Several delegations and representatives of users expressed interest in or support for the European Patent Office's initiative in making provisional opinions available to accompany partial search reports where the International Searching Authority had found lack of unity of invention. This was valuable information to users trying to decide whether to pay additional search fees. One delegation noted that its Office, in its role as International Searching Authority, had a similar practice.

66. The International Bureau agreed to work with the European Patent Office to investigate a possible official PCT form for use by International Authorities which wished to follow this practice.

67. The Working Group noted the contents of document PCT/WG/10/14.

AGENDA ITEM 17: PILOT ON COLLABORATIVE SEARCH AND EXAMINATION – STATUS REPORT

68. Discussions were based on document PCT/WG/10/11.

69. The European Patent Office informed the Working Group of the progress made at the fourth session of the PCT Collaborative Search and Examination (CS&E) Pilot Group that had taken place in Munich on May 4 and 5, 2017. In particular, the CS&E Pilot Group had prepared operational arrangements, which would be presented for adoption at the IP5 Heads of Office meeting on June 1, 2017. The IP5 Heads would also decide on the launch date of the operational phase of the third pilot project, which it was hoped would be before the next session of the PCT Working Group.

70. All delegations which took the floor welcomed the progress made in the CS&E Pilot Group. Some of these delegations pointed to the benefits that collaborative search and examination could have in improving the quality of international search and preliminary examination, which could in turn bring about time-saving benefits in the national phase by avoiding duplication of work.

71. The representative of a user group welcomed collaborative search, pointing out the interest of applicants to have a comprehensive search report at an early stage in the patent prosecution procedure. However, if collaborative search and examination were offered as a standard service to all users, it would need to be provided at a reasonable cost.

72. The Working Group noted the contents of document PCT/WG/10/11.

AGENDA ITEM 18: PCT MINIMUM DOCUMENTATION – STATUS REPORT

73. Discussions were based on document PCT/WG/10/12.

74. All delegations which took the floor supported the work of the PCT Minimum Documentation Task Force and indicated a willingness to participate in its discussions on the wiki. One delegation underlined that the definition of patent documents in Rule 34 needed to be clarified and added that its national Office made patent documents available from 1978 and did not have published documents dating back to 1920.

75. The Delegation of India stated that the purpose of including non-patent literature in the PCT minimum documentation was to ensure a comprehensive search. Criteria for inclusion needed to take into account the usefulness of the information, ease of searching, and the source and format beyond standard journal articles. Following agreement in principle by the Meeting of International Authorities to add the Indian Traditional Knowledge Digital Library (TKDL) to the PCT minimum documentation, the Government of India was currently revising the terms and conditions in the access agreement to the TKDL. The Indian Patent Office looked forward to sharing the agreement further with International Authorities after this revision had been completed.

76. The Working Group noted the contents of document PCT/WG/10/12.

AGENDA ITEM 19: PCT SEQUENCE LISTING STANDARD

77. Discussions were based on document PCT/WG/10/15.

78. All delegations which took the floor welcomed the envisaged adoption of the revised WIPO Standard ST.26 and the recommendations for transitional provisions from WIPO Standard ST.25 to ST.26 at the fifth session of the Committee for WIPO Standards (CWS), due to take place from May 29 to June 2, 2017. Delegations also agreed that future revisions of ST.26 should be triggered by the CWS and not follow a pre-defined schedule. One delegation enquired about the timeline for revision of the relevant PCT legal provisions by the International Bureau.

79. The representative of a user group expressed support for the “big bang” transition scenario, with the transition date being determined with reference to the international filing date.

80. The Working Group noted the contents of document PCT/WG/10/15.

AGENDA ITEM 20: APPLICATION FORM FOR APPOINTMENT AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

81. Discussions were based on document PCT/WG/10/16.

82. Several delegations noted that the discussions in the thirtieth session of the PCT Committee for Technical Cooperation, during which several Authorities had used the draft application form as the basis for their requests for extension of their appointment, had been proof of the usefulness of that form, with benefits for all parties. The Authorities which had used the application form had an outline and reminder of what information needed to be provided. The delegations reviewing applications were able to find the information of interest to them in each application more effectively.

83. Some delegations felt that the draft application form had been thoroughly discussed and tested. These delegations hoped that it could be adopted soon with only minor further consultation required to finalize the text. Some other delegations considered that significant differences still needed to be resolved as to the subjects to be addressed within the form and whether inclusion of such subjects should be mandatory or optional for Offices seeking appointment. Some delegations considered that there needed to be a clear distinction between initial appointment and extension of appointment and underlined the need to avoid unnecessary work for all parties.

84. The International Bureau observed that it would appear that there remained only very few differences of principle, as long as it was clearly understood that only Sections 1 and 2 of the proposed form were intended to be mandatory. The main concerns appeared to be, in essence, matters of drafting guidelines to help Offices understand which sections were essential, what level of detail was relevant to different sections and what variations would be appropriate for Offices in different positions, whether in terms of their organizational structure or because of different motivations for wishing to act as an International Authority. A secondary issue appeared to be whether some aspects of the form might be better handled differently for extension of appointments. For example, it might be appropriate to have ongoing documentation of some of the matters relevant to the minimum requirements in a manner similar to the existing quality reports. This could then be referred to as part of an application for extension, without the need to reproduce this information on the form itself.

85. The Working Group invited the International Bureau to issue a Circular to seek feedback on a refined draft application form and any outstanding issues in order to determine whether a proposal could be brought directly to the Assembly or whether the issue should be further considered by the Quality Subgroup of the Meeting of International Authorities and/or the Working Group.

AGENDA ITEM 21: CORRECTION OF THE INTERNATIONAL APPLICATION IN CASE OF “ERRONEOUSLY” FILED ELEMENTS AND PARTS – ANALYSIS OF ISSUES RELATED TO THE PATENT LAW TREATY

86. Discussions were based on document PCT/WG/10/10.

87. Delegations expressed divergent views with regard to Patent Law Treaty (PLT) related issues addressed in document PCT/WG/10/10.

88. The Delegation of the European Patent Office (EPO) gave detailed explanations as to why it did not agree with some of the conclusions set out in the document with regard to the possible interpretation of PLT Article 5(5) and 5(6), in line with jurisprudence of the EPO Board of Appeal. In its view, doubts remained about the compliance of the proposed new PCT approach with the PLT. It nevertheless envisaged that, subject to consultation with all of the Member States of the European Patent Organisation, it might be able to support the proposed new approach on the following conditions: (i) the removal of any erroneously filed element or part would not be allowed; (ii) the EPO as receiving Office and as a designated Office would be given the option of making a notification of incompatibility in relation to the proposed PCT Rule 20.5*bis*; and (iii) an International Searching Authority would be entitled to charge an additional fee in the case that the incorporation of a “correct” element or part had occurred after the Authority had begun to draw up the international search report. The Delegation further suggested that, in order to advance the discussions, the Secretariat should convene a workshop dedicated to this issue, ideally during the 2018 session of the Working Group.

89. Several other delegations renewed their support for the adoption of the new approach with regard to the incorporation by reference of “correct” elements or parts and stated that, in their view, the proposed new approach would not fall within the scope of PLT Article 2 and thus could be implemented by PCT Contracting States which were also PLT Contracting Parties. There was wide support for the suggestion by the EPO to convene a workshop to advance the discussions in the Working Group.

90. Two delegations, which were both PLT Contracting Parties, stated that they had concluded that their current national law, under which the incorporation by reference of a “correct” element or part as a “missing element or part” was possible, was indeed in compliance with the PLT. One of those delegations expressed the concern that, against that background, the proposed amendment of PCT Rule 20.5(a), aimed at clarifying that a “missing element or part” did not include the case that an element or part had been erroneously filed, would make it difficult for it to continue to interpret its national law in that way, as it would be in conflict with the

express new PCT provision, if so adopted. The other of those delegations stated that, since it already interpreted the PLT provisions such that they allowed the incorporation by reference of a “correct” element or part as a “missing element or part”, adoption of the new PCT approach would indeed result in a narrowing rather than a widening of the gap between PCT and PLT filing date requirements. It further noted that it fully concurred with the statement set out in the document that the filing date requirements set out in PLT Article 5 simply did not apply to international applications, that the PLT had no bearing on the matter with regard to international applications and that the new approach should thus be adopted. With regard to the proposed removal from the application of any “erroneously filed” element or part, the delegation pointed to existing PCT provisions, such as Rule 9, which allowed the removal of certain parts of the application after the according of an international filing date.

91. One delegation expressed the view that the gap between the PCT and PLT filing date requirements might lead to confusion among applicants and stated that it was not advisable to amend the PCT Regulations before Member States had arrived at a common understanding of all of the issues in question. It believed that too flexible provisions would have a risk of being abused by applicants and it was necessary to take into account issues such as the disclosure of the invention as well as the procedures for carrying out international search. It further stated that, in its opinion, it was not possible to replace an entire set of claims and an entire description by way of incorporation by reference of a “correct” element or part.

92. Two representatives of user groups stated that they supported the proposed new approach. While it might result in different requirements in respect of PCT applications on the one hand and national and regional applications on the other, users would understand such differences and act accordingly. Third parties would not be taken by surprise, as the application would not have been published at the time of incorporation, and the “correct” element or part to be incorporated by reference would be on file, since it had to be contained in the priority document.

93. The Working Group requested the Secretariat to convene a workshop dedicated to the issue of incorporation by reference of “correct” elements or parts, ideally during the 2018 session of the Working Group.

AGENDA ITEM 22: TRANSMITTAL BY THE RECEIVING OFFICE OF EARLIER SEARCH AND/OR CLASSIFICATION RESULTS TO THE INTERNATIONAL SEARCHING AUTHORITY

94. Discussions were based on document PCT/WG/10/5.

95. The Working Group approved the proposed amendments to the PCT Regulations set out in the Annex to document PCT/WG/10/5 with a view to their submission to the Assembly for consideration at its next session in October 2017.

AGENDA ITEM 23: OTHER MATTERS

96. The Working Group agreed to recommend to the Assembly that, subject to the availability of sufficient funds, one session of the Working Group should be convened between the October 2017 and September/October 2018 sessions of the Assembly, and that the same financial assistance that was made available to enable attendance of certain delegations at this session should be made available at the next session.

97. The International Bureau indicated that the eleventh session of the Working Group was tentatively scheduled to be held in Geneva in May/June 2018.

AGENDA ITEM 24: SUMMARY BY THE CHAIR

98. The Working Group noted that the present document was a summary established under the responsibility of the Chair and that the official record would be contained in the report of the session.

AGENDA ITEM 25: CLOSING OF THE SESSION

99. The Chair closed the session on May 11, 2017.

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