

Patent Cooperation Treaty (PCT) Working Group

Fourteenth Session
Geneva, June 14 to 17, 2021

SUMMARY BY THE CHAIR

AGENDA ITEM 1: OPENING OF THE SESSION

1. Ms. Lisa Jorgenson, Deputy Director General, Patents and Technology Sector, opened the session and welcomed the participants on behalf of Mr. Daren Tang, 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 Ms. Dong Cheng (China) as Chair and Ms. Rekha Vijayam (India) and Mr. Charles Pearson (United States of America) as Vice-Chairs for the session.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

3. The Working Group adopted the revised draft agenda as set out in document PCT/WG/14/1 Prov. 2.

AGENDA ITEM 4: MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT OF THE TWENTY-EIGHTH SESSION

4. Discussions were based on document PCT/WG/14/2.

5. The Working Group noted the contents of document PCT/WG/14/2.

AGENDA ITEM 5: INTERNATIONAL APPLICATIONS LINKED TO UNITED NATIONS SECURITY COUNCIL SANCTIONS

6. Discussions were based on document PCT/WG/14/3.

7. The Working Group noted the contents of document PCT/WG/14/3

AGENDA ITEM 6: STRENGTHENING PCT SAFEGUARDS IN CASE OF GENERAL DISRUPTION

8. Discussions were based on documents PCT/WG/14/9 and 11.

9. All delegations that took the floor supported the proposed amendments to Rule 82*quater*.1 to clarify that an epidemic is a potential situation of *force majeure* relevant to that Rule, as well as to provide an explicit basis for waiving the need to offer evidence of a particular disruption. However, one delegation suggested that a particular format should be prescribed for the waivers referred to in Rule 82*quater*.1(d) to ensure that they were clear and consistent.

10. Following concerns raised by a number of delegations, it was agreed that the proposed Understanding in paragraph 22 of document PCT/WG/14/11 should not be sent to the PCT Assembly.

11. Some delegations raised concerns about the proposed new Rule 82*quater*.3, including:

(a) evidence arising from the current pandemic had not shown that any Office was unable to provide effective relief through the existing provisions of Rule 82*quater*.1, as read in light of the International Bureau's Interpretative statement of April 9, 2020;

(b) there existed a significant potential for confusion where different Offices granted different extensions to time limits (or no extensions), resulting in many different notices, including possible notices of additional periods of extension, with the possibility that more than one notice could apply to the same international application with respect to Offices in different capacities;

(c) the need for a definition of the term "general disruption";

(d) whether extensions would always cover all time limits set by the Regulations pertaining to actions before the relevant Office;

(e) the exact date by which an action would need to be taken following the expiration of an extension of a time limit under this Rule; and

(f) whether, instead of introducing Rule 82*quater*.3, Rule 82*quater*.1 could be amended also to include the situation where the *force majeure* reasons occur in the State of the location of an Office, Authority or International Bureau, as a way of achieving the objective of the proposal while overcoming concerns, and also helping to minimize the number of instances crossing the time limits.

12. Following explanations from the European Patent Office, these delegations nevertheless agreed that they could join the consensus for adoption of the new provision.

13. The Working Group invited the International Bureau to develop modifications to the Administrative Instructions and/or relevant Guidelines covering, in particular:

(a) clarification of what might constitute a general disruption;

(b) formats for notifications of waivers of the need for evidence under Rule 82*quater*.1(d); and

(c) clarification of when the statement under Rule 82*quater*.1(d) should be submitted.

14. The Working Group approved the proposed amendments to Rule 82*quater* as set out in the Annex to document PCT/WG/14/11, with a view to their submission to the Assembly for consideration at its session in October 2021.

AGENDA ITEM 7: FORMAL INTEGRATION OF THE PATENT PROSECUTION HIGHWAY INTO THE PCT

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

16. Various delegations and observer organizations expressed broad support for the proposal, indicating that they found the Patent Prosecution Highway (PPH) to be beneficial and considered that formal adoption into the PCT System would bring benefits to applicants and Offices. The various flexibilities were noted, though some delegations considered that greater flexibility was needed, for example, to suspend expedited examination with respect to particular fields of technology or limit the number of cases accepted per applicant. Some Offices also indicated that further analysis of the likely impact on Offices was needed. Some Offices indicated that they would support the "opt in" alternative contained in subparagraph (b) of the proposed Rules. One delegation indicated that it was important to allow Offices flexibility to use additional criteria to determine which reports they could accept as the basis for a PPH request, including that there should be no objections in the Box VIII field.

17. One Office asked whether other Offices treated PPH requests received before the Article 22 time limit had expired as an express request under Article 23(2) for a designated Office to process or examine an international application.

18. One delegation stated that it was unable to support the proposal. This delegation pointed out that reports in the international phase were non-binding and believed that the PCT System should be impartial by offering a level playing field for all stakeholders in the national phase and not provide a mechanism to permit an applicant to claim preferential treatment based on the content of these reports. The primary purpose of the PCT System was not to grant patents quickly, but rather to help Offices dispose with applications in a timely manner, covering both grants and refusals. The proposal risked favoring the use of Authorities that issued more reports with "A" category documents, which were of lower value to an Office subsequently examining the application. It might also widen the gap between local applicants and foreign applicants able to use the PCT as a tool to secure faster processing, disrupting the availability of results of examination on other cases. Faster processing might also lead to more litigation, where costs in appeal mechanisms across jurisdictions varied widely. The delegation believed that the PPH program did not align with the mission of WIPO to lead the development of a balanced and effective international IP system that enabled innovation and creativity for the benefit of all. The integration of PPH into the PCT did not align with the WIPO Development Agenda and would hinder the recommendations for future work acknowledged in the PCT Roadmap aimed at providing technical assistance to Offices for eliminating differences in search and examination capacities, skills and access to information. Formally integrating PCT-PPH into the PCT would change the basic structure of the PCT System that presently offered equal treatment to all applicants. Even with the "opt-out" options, the adverse effects would remain. Such preferential treatment was against the spirit of the PCT and conflicted with the ideals of WIPO. Such integration within the PCT would also provide coercive power to the PPH program, which would further weaken the position of developing countries in trade negotiations. The delegation observed that receiving Offices did not declare all International Authorities as competent to search the international applications filed at their respective Office. For most international applications, the International Searching Authority was the same Office as the

receiving Office. In this regard, India had presented a proposal for better distribution of workload among International Authorities at the twelfth session of the Working Group (document PCT/WG/12/18). The delegation considered this an important step to help improve the quality of reports without amending the PCT and avoiding discrimination against certain applicants.

19. The Delegation of the United States of America indicated that it did not agree with this characterization of the proposal in the document. It noted that a large majority of delegations that had spoken had broadly supported the proposal. The Delegation considered that the PPH represented a good example of the type of cooperation that the Patent Cooperation Treaty should embrace.

20. The Chair acknowledged the interest in the proposal and the comments and concerns that some delegations had raised, notably with regard to workload at Offices, the flexibilities available, and how the proposal related to the goals of the PCT System. The Chair concluded that the Working Group required more time to discuss the proposal further and invited Japan, the Republic of Korea, the United Kingdom and the United States of America to consider the comments further in submitting a revised proposal to a future session of the Working Group.

21. The Working Group invited Japan, the Republic of Korea, the United Kingdom and the United States of America to consider the comments raised during the session and submit a revised proposal to a future session of the Working Group.

AGENDA ITEM 8: CERTIFIED COPIES OF EARLIER INTERNATIONAL APPLICATIONS

22. Discussions were based on document PCT/WG/14/16.

23. Delegations that took the floor broadly supported the proposals, agreeing that option (iii) in paragraph 11 of the document was the most practical. One Office suggested also allowing for option (ii) in that paragraph as a temporary measure pending more Offices joining the WIPO Digital Access Service for Priority Documents (DAS). Some Offices requested further details of how applicants would obtain access codes and request documents to be made available to DAS.

24. One Office questioned whether the number of applications involved would justify the costs of development of further IT systems. Furthermore, there had not been sufficient time to analyze the proposals to determine whether either the proposed method of certification or the proposed form of any certificate would meet the requirements of Article 4D(3) of the Paris Convention. Some delegations also queried differences in the language of the proposed amendments to the Regulations from that of the proposed Understanding by the Assembly.

25. The Working Group noted the contents of document PCT/WG/14/16 and invited the International Bureau to work with interested parties to address the issues raised during the session and to bring a revised proposal to the next session of the Working Group.

AGENDA ITEM 9: PROCESSING INTERNATIONAL APPLICATIONS IN FULL-TEXT FORMAT

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

27. All delegations that took the floor expressed support for the proposals in paragraph 13 and principles listed in paragraph 28 of the document. Several delegations highlighted the importance of consistency of conversion between Offices. Several delegations noted that their Offices already allowed and encouraged the processing of full-text applications. The question of whether the use of a single tool provided by the International Bureau would be mandatory was significant.

28. Some delegations observed that the proposals had broad consequences. Consideration would be needed in respect of subjects such as responsibility of performing conversions, the requirements of Rule 11, the current sheet-based fees, the concept of "the official copy", the legal status of the original DOCX file, and the ability to use XML that was compliant with WIPO Standard ST.96. One Office suggested that the conversion and comparison tools provided could be locally hosted in addition to the proposed web-services since this would avoid the transmission of confidential documents to a third party. Offices also expressed concerns regarding resources needed to implement the proposal and the requirements for consistent rendering of XML into page images.

29. An observer organization welcomed the proposals, but noted that they would require applicants and Offices to adapt their processes, which might be a significant undertaking within its region. However, international publication in full-text format would provide better accuracy in official documents.

30. The Working Group noted with approval the general direction proposed in document PCT/WG/14/8 and invited the International Bureau to continue working with Offices and user groups to implement the goals outlined in the document.

AGENDA ITEM 10: PCT ONLINE SERVICES

31. Discussions were based on document PCT/WG/14/14.

32. Delegations indicated that their Offices used the PCT online services extensively and were broadly in agreement with the proposed directions for development. Some delegations noted a particular interest in an increased focus on machine-to-machine services. Use of electronic services had increased significantly since the COVID-19 pandemic. Several delegations noted that preparations were under way at their Offices for the decommissioning of PCT-SAFE, though in some cases legal, technical and support issues remained to be finalized.

33. In response to a query, the Secretariat confirmed that the International Bureau would provide support for Offices and applicants through the transition from PCT-SAFE. In addition, the decommissioning of PCT-SAFE meant that the PCT plugin for the eOLF software used at the European Patent Office and certain Offices of members of the European Patent Convention would also come to end of life. However, this did not necessarily have to be from the same date and the International Bureau was working with the European Patent Office to ensure that an effective service could be maintained while Offices developed and implemented the necessary replacement systems.

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

AGENDA ITEM 11: INTERNATIONAL SEARCH REPORT FEEDBACK PILOT

35. Discussions were based on document PCT/WG/14/12.

36. All delegations taking the floor expressed their support for the feedback pilot and interest in further developments. The concept showed potential benefits for quality and consistency of search. One delegation noted the benefit in particular that the pilot did not introduce burdens for applicants and fully respected sovereignty. One delegation indicated that its Office was willing to join the pilot in its capacity as an International Searching Authority. Another delegation observed that any proposals for wider-scale implementation would need consideration regarding the costs and benefits.

37. The Delegation of the United Kingdom noted that the pilot had been kept to a small scale to avoid high costs, but a larger scale approach would require careful consideration. Further International Searching Authorities were invited to participate in future rounds of the pilot.

38. The Working Group noted the contents of document PCT/WG/14/12.

AGENDA ITEM 12: WIPO FEE TRANSFER SERVICE: STATUS REPORT

39. Discussions were based on document PCT/WG/14/7.

40. Delegations that took the floor expressed satisfaction with the WIPO Fee Transfer Service, appreciating the improvements in administrative efficiency. In particular, International Searching Authorities appreciated receiving fewer monthly search fee payments from receiving Offices, with almost all search fee income now coming from the International Bureau. Those Authorities invited any receiving Offices that were yet to join the service to do so as soon as practically possible.

41. One Office requested that the International Bureau consider the possibility of creating a stronger linkage between the WIPO Fee Transfer Service and the eSearchCopy service.

42. In response to a query from a delegation, the Secretariat clarified that the XML generation facilities within ePCT were intended for Offices using ePCT as their main processing tool. Receiving Offices processing record copies and payments in local systems should continue to generate data locally and upload it using PCT-EDI, though an ePCT web service could be offered if there were demand for automation through that route.

43. The Working Group noted the contents of document PCT/WG/14/7 and invited the International Bureau to continue to develop the WIPO Fee Transfer Service to extend and improve it further, taking into account the comments made during the session.

AGENDA ITEM 13: SEQUENCE LISTINGS TASK FORCE: STATUS REPORT

44. Discussions were based on document PCT/WG/14/5.

45. The Secretariat noted that the Sequence Listings Task Force was considering a recommendation to delay the “big-bang” date and invited any interested delegations whose Offices were not already participating to join the discussions in that forum.

46. The Working Group noted the contents of document PCT/WG/14/5.

AGENDA ITEM 14: PCT MINIMUM DOCUMENTATION: STATUS REPORT

47. Discussions were based on document PCT/WG/14/4.

48. The Working Group noted the contents of document PCT/WG/14/4.

AGENDA ITEM 15: IP5 PCT COLLABORATIVE SEARCH AND EXAMINATION: STATUS REPORT

49. Discussions were based on document PCT/WG/14/6.

50. The Delegation of Saudi Arabia indicated that its Office would begin a bilateral collaborative search program with the Korean Intellectual Property Office on July 1, 2021.

51. The Working Group noted the contents of document PCT/WG/14/6.

AGENDA ITEM 16: COORDINATION OF TECHNICAL ASSISTANCE UNDER THE PCT

52. Discussions were based on document PCT/WG/14/17.

53. The Working Group noted the contents of document PCT/WG/14/17.

AGENDA ITEM 17: PATENT EXAMINER TRAINING

(A) COORDINATION OF PATENT EXAMINER TRAINING

54. Discussions were based on document PCT/WG/14/13.

55. Delegations noted the variety of different needs of Offices according to size and capacity. Several Offices noted that they had established effective training structures and were willing to share their experience.

56. The Working Group noted the contents of document PCT/WG/14/13 and invited the International Bureau to conduct a survey along the lines outlined in paragraph 21 of the document, taking into account the comments made during the session.

(B) SURVEY ON USE OF E-LEARNING RESOURCES FOR THE TRAINING OF SUBSTANTIVE PATENT EXAMINERS

57. Discussions were based on document PCT/WG/14/15.

58. Delegations noted the increasing need for e-learning resources during the pandemic though this could not replace the need for live training, allowing interaction with the trainers. Delegations expressed interest in sharing online live events as well as recordings and other tools.

59. The Working Group noted the results of the survey on e-learning resources for the training of substantive patent examiners and invited the International Bureau to develop proposals for the creation of an independent repository of e-learning resources, taking into account the issues noted in document PCT/WG/14/15 and those raised during the session.

AGENDA ITEM 18: OTHER MATTERS

60. The International Bureau indicated that the fifteenth session of the Working Group was tentatively scheduled to take place in May/June 2022.

AGENDA ITEM 19: SUMMARY BY THE CHAIR

61. 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 20: CLOSING OF THE SESSION

62. The Chair closed the session on June 17, 2021.

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