

## Patent Cooperation Treaty (PCT) Working Group

**Fourteenth Session**  
**Geneva, June 14 to 17, 2021**

### IMPLEMENTATION OF THE INTERPRETATIVE STATEMENT AND RECOMMENDED PATENT COOPERATION TREATY (PCT) PRACTICE CHANGES IN LIGHT OF THE COVID-19 PANDEMIC

*Document prepared by the International Bureau*

#### **SUMMARY**

1. This document reports on the experiences of Offices in the implementation of the *Interpretative statement and Recommended Patent Cooperation Treaty (PCT) Practice Changes in light of the COVID-19 Pandemic* (“the Interpretative statement”) that the International Bureau issued on April 9, 2020, as requested by the Working Group at its thirteenth session in October 2020.
2. Offices that had received requests to excuse delays in meeting a time limit citing COVID-19 related issues had excused the delay in all cases, following the Interpretative statement in considering the COVID-19 pandemic to fall within the scope of Rule 82*quater*.1 and not requiring evidence that the virus affected the locality where the interested party resides. The processing of these requests does not appear to have been particularly time or resource consuming. All Offices delayed the issuance of notifications that an application had been considered withdrawn where the pandemic may have caused a delay in payment of fees, either waiting at least two months after expiry of the deadline before issuing the notification, or checking with the applicant before issuing the notification to avoid an application unintentionally being considered withdrawn.

## BACKGROUND

3. At the thirteenth session of the PCT Working Group in October 2020, the European Patent Office, France, Switzerland and the United Kingdom submitted a proposal titled *Strengthening PCT Safeguards in case of General Disruption* (document PCT/WG/13/10). Paragraphs 6 to 10 of the Summary by the Chair of the session (document PCT/WG/13/14) summarize the discussions of the proposal, and paragraphs 32 to 59 of the draft Report of the session (document PCT/WG/13/15 Rev.) provide a full record of these discussions. Paragraph 10 of the Summary sets out the follow up for the next session of the Working Group, as follows:

"10. The Working Group expressed support for the principle of providing for better safeguards for applicants and Offices in cases of general disruption outside their control and:

(a) invited the European Patent Office, France, Switzerland and the United Kingdom to submit a revised proposal to the next session of the Working Group, taking into account the comments made by delegations; and

(b) requested the International Bureau, in cooperation with the Member States, to assess the experiences of Offices in the implementation of the *Interpretative statement and Recommended Patent Cooperation Treaty (PCT) Practice Changes in light of the COVID-19 Pandemic* that it issued on April 9, 2020 and to submit a report to the next session of the Working Group."

4. This document discusses the follow-up in paragraph 10(b) of the Summary by the Chair of the thirteenth session of the Working Group, reproduced in paragraph 3, above.

## INTERPRETATIVE STATEMENT AND RECOMMENDED PATENT COOPERATION TREATY (PCT) PRACTICE CHANGES IN LIGHT OF THE COVID-19 PANDEMIC

5. The International Bureau issued an *Interpretative statement and Recommended Patent Cooperation Treaty (PCT) Practice Changes in light of the COVID-19 Pandemic* ("the Interpretative statement") on April 9, 2020 (see [https://www.wipo.int/pct/en/news/2020/news\\_0009.html](https://www.wipo.int/pct/en/news/2020/news_0009.html)). The Interpretative statement gives details of how the International Bureau applies the circumstances of the global COVID-19 pandemic to requests under Rule 82*quater*.1 for excuse of delay in meeting time limits. The Interpretative statement also announced that the International Bureau, in its capacity as a receiving Office, would delay the issuance of notifications of considering international applications as withdrawn (Form PCT/RO/117), for example, for failure to pay fees within the prescribed time limit, until May 31, 2020, and waived the charging of late payment fees under Rule 16*bis*.2. The Interpretative statement urged other Offices to adopt the same interpretation of Rule 82*quater*.1 and the same practice with regard to issuance of notifications considering applications as withdrawn.

6. On May 27, 2020, the International Bureau announced that it would extend the period for deferring the issuance of notifications considering international applications as withdrawn for failure to pay fees within the prescribed time limit in its role as a receiving Office until June 30, 2020, (see [https://www.wipo.int/pct/en/news/2020/news\\_0014.html](https://www.wipo.int/pct/en/news/2020/news_0014.html)). The International Bureau, in its role as a receiving Office, restarted the issuance of Form PCT/RO/117 for failure to pay the required PCT fees as of July 1, 2020. In the announcement dated July 3, 2020 to confirm the end of this period, the International Bureau stated that it would continue to waive the payment of any applicable late payment fees under Rule 16*bis*.2 until further notice (see [https://www.wipo.int/pct/en/news/2020/news\\_0017.html](https://www.wipo.int/pct/en/news/2020/news_0017.html)).

## RESPONSES TO CIRCULAR C. PCT 1612

7. On December 8, 2020, the International Bureau issued Circular C. PCT 1612 with a questionnaire for receiving Offices and International Searching and Preliminary Examining

Authorities on their experiences in implementing the Interpretative statement. Thirty-six Offices responded to the Circular.

## IMPLEMENTATION OF INTERPRETATIVE STATEMENT BY OFFICES IN THEIR PCT FUNCTIONS

### Requests under Rule 82 quater.1

8. All Offices responding to the questionnaire in C. PCT 1612 agreed that Rule 82 *quater.1* applies in the circumstances of the COVID-19 pandemic. One Office did not formally cite Rule 82 *quater.1* as the basis for its relief policies but had developed these policies with the Interpretative statement in mind.

9. All Offices that had treated a Rule 82 *quater.1* request during the COVID-19 pandemic had treated the request favorably and had not required evidence that the virus had affected the locality of the interested party. While one Office did not require evidence, it required a statement that the delay related to COVID-19 as part of the request for relief. However, many Offices had not received such a request, with some of these Offices stating that they were not able to give a definitive answer on whether it would require evidence in such a case.

10. Only a few Offices had received a request under Rule 82 *quater.1* to excuse a delay in meeting a time limit on an international application due to the COVID-19 pandemic. For Offices that had received requests, the numbers of requests received were very low, typically below five, with no Office receiving more than 15 requests. Requests that Offices had received related to excuse of delays in meeting a time limit to pay fees, filing a demand under Chapter II, and requesting a rectification of an obvious mistake.

11. As applicants have addressed very few requests to Offices under Rule 82 *quater.1* and the processing time to handle such requests depends on the case, it is difficult to determine the time taken for an Office to handle an average request. Some Offices indicated additional time of under 30 minutes for the officer processing the application, with one Office stating that these requests had a *de minimis* effect on operations. Some other Offices considered the additional pending time for a case with a request under Rule 82 *quater.1* rather than the time spent by an official on the case itself; these Offices stated such cases would take several additional working days to be processed.

12. Only four Offices indicated that they had received a Rule 82 *quater.1* request before the COVID-19 pandemic. Given the limited experience of Offices in handling requests and the low numbers of requests received during the pandemic, it is not possible to assess the time saving in processing Rule 82 *quater.1* requests by not requiring evidence that the virus affected the locality in which the interested party resides.

### Issuing Notifications that an International Application is considered withdrawn

13. All Offices had considered delaying issuing notifications that an international application is considered withdrawn (PCT/RO/117), but not all Offices applied this provision all the way to May 31, 2020, as recommended in the Interpretative statement. Where an Office ceased to apply the provision before this date, the Office communicated the date when it would reissue notifications to applicants and/or confirmed with the applicant that they did not wish to proceed with the application before issuing the notification. Most Offices also followed the Interpretative statement in only issuing notifications when a deadline had expired two months previously. Where an Office did not delay issuing notifications until this time, the Office reported that it informed applicants before issuing the notification to prevent the COVID-19 pandemic resulting in an application being considered withdrawn.

#### Waiving Late Payment Fees under Rule 16bis.2

14. Where an Office usually charged late payment fees under Rule 16bis.2, almost all Offices had followed the recommendation in the Interpretative statement to waive these fees. Offices that did not waive late payment fees cited lack of legislative authority or the need to change IT systems as reasons for not waiving these fees.

#### Other Measures to alleviate Difficulties in meeting Time Limits for International Applications because of the COVID-19 Pandemic

15. A few Offices either had granted a general extension to all time limits between certain dates, or had declared all days over a specified period as excluded days for the purpose of deadlines. Offices that had deemed days to be excluded by declaring that the Office was not open to the public for the transaction of official business did not necessarily cease providing all services; some of these Offices continued to maintain electronic services for filing, payment of fees and responding to enquiries. These Offices therefore did not need to consider delaying issuing notifications during these periods. The European Patent Office, that applied a general extension to time limits from March 15 to June 2, 2020, detected 71 international applications that benefitted from the extension with regard to late payment of fees. In all but one of these applications, the applicant paid the fee one or two days after the deadline; in only one case did the applicant defer payment until the end of the period when a general extension applied.

16. Two Offices stated that they applied favorable measures for handling requests for restoration of priority right under Rule 26bis.3 due to the COVID-19 pandemic. One of these Offices that applies the “due care” criterion waived the requirement for the applicant to submit documentary evidence to accompany requests. Another Office waived the fee for requesting restoration of priority from the onset of the pandemic until July 30, 2020 provided the request was accompanied by a statement that the failure to file the international application in a timely manner was due to the COVID-19 pandemic.

#### Requests involving Reversal of an earlier Action

17. The situation of an applicant requesting the reversal of an earlier action citing issues related to COVID-19 arose with two individual applicants in relation to non-payment of fees. For one applicant, the receiving Office had issued invitations to pay unpaid fees within one month of the international filing date on four applications. A different receiving Office had received repeated requests to delay notifications considering applications as withdrawn from a single applicant due to non-payment of fees. In one case when the International Bureau had begun re-issuing notifications, this Office initially refused one of these requests but then allowed it after the International Bureau had confirmed that a receiving Office still had the discretion to delay the notification. However, the Office continued to receive requests from this applicant to delay notifications and later refused the request due to the impact on subsequent processing in the international phase.

18. One Office stated that it avoided any decision to reverse an earlier action as no legal basis existed to reverse the issue of Form PCT/RO/117 in the absence of Office error.

#### Other Comments on Implementation of the Interpretative Statement

19. Since the COVID-19 pandemic affects countries differently, one Office suggested that the International Bureau should determine measures for Offices, but the Office applying the measures should be able to decide on the period of application depending on its individual circumstances.

20. One Office had extended the period considered to be within 12 months of an earlier application for manual filing of international applications since the Office was not open for the receipt of hard copy submissions. However, this Office noted concern about how designated/elected Offices would determine the priority claims in the national phase since it had

remained possible to file applications electronically during this period, so the Office could not be considered completely closed under Rule 80.5(i).

21. The Office receiving repeated requests from an applicant to delay notifications of withdrawal referred to in paragraph 17, above, wished to have further clarity on the procedure for extending deadlines and issuing notifications that an international application was considered withdrawn, such as a clear cut-off date when fees had to be paid.

#### RELATED MEASURES IN THE NATIONAL OR REGIONAL PROCESS

22. In relation to measures to assist applicants with difficulties in meeting national or regional time limits due to the COVID-19 pandemic, slightly more than one third of Offices had been closed at some stage. More than three quarters of Offices stated that they excused delays in meeting a time limit. A similar number of Offices provided for extensions of time limits in their national or regional processing. Slightly under half of Offices responding to the Circular needed to defer actions that would have resulted in a case being considered withdrawn.

23. The China National Intellectual Property Administration (CNIPA) has a provision for the applicant to request restoration of rights after missing a time limit due to *force majeure*. The applicant must file the request within two months of removal of the impediment, but no later than two years after the expiration of the time limit. CNIPA issued a notice on January 28, 2020 to indicate that this provision applied to circumstances related to COVID-19. In a request for restoration, no request fee shall be paid, but a request letter for restoration of rights shall be submitted to explain the grounds of doing so, relevant certifications shall be attached, and the formalities required to be completed before the loss of rights shall be carried out.

24. The United Kingdom Intellectual Property Office (UKIPO) declared a period of interruption from March 23 to July 29, 2020 that extended all time limits for national applications that expired during the period. The UKIPO continued to waive extension/reinstatement fees until April 2021.

25. IP Australia introduced a free online streamlined process for an applicant to request an extension of time of up to three months to respond to an Office deadline for applications affected by the COVID-19 pandemic. The process requires the applicant ticking a box to indicate that the deadline could not be met due to the COVID-19 pandemic, without needing to upload a declaration. However, making a false declaration could put the validity of the IP right at risk. If needed, the applicant could request a further extension of up to three months. The streamlined extension is not available for deadlines when IP Australia acts as a receiving Office or other time limits in the international phase of the PCT.

26. Offices gave differing responses to the periods where they applied national measures to assist applicants in meeting time limits. These periods usually began in mid-March to April 2020. Some procedures continued to apply at the time of response, such as the waiving of late fees, or the streamlined option to request an extension at IP Australia citing COVID-19 circumstances.

27. The number of national or regional applications that took advantage of measures applied by Offices depended on the particular measure and period in question; responses varied from a handful of cases to several thousand. In the case of the general extension of time limits at the European Patent Office, 1,264 regional applications benefitted from the extension with regard to payment of fees. In 504 of these cases, the applicant delayed payment until the end of period when extensions applied; for the other cases, the payment was delayed only by one or two days.

28. Offices gave varying replies to the time to process an individual case for a national or regional application. While this depended on the nature of the request, the processing time to excuse a delay or grant an extension to the time period was typically under 30 minutes.

## CONCLUSIONS ON EXPERIENCES IN THE IMPLEMENTATION OF THE INTERPRETATIVE STATEMENT

29. All Offices agreed with the position of the International Bureau in the Interpretative statement that Rule 82*quater*.1 applies under the circumstances of global COVID-19 disruption within the scope of “natural calamity ... or other like reason”. However, the use of Rule 82*quater*.1 as a basis for requests to excuse delay in meeting a time limit due to the COVID-19 pandemic has been low. Many Offices have not received any requests under this provision, and no Office received more than 15 such requests. The few Offices that had received requests under this provision citing COVID-19 related issues had allowed all requests, following the Interpretative statement by treating such requests favorably and not requiring evidence that the virus affected the locality in which the interested party resides. The time taken for the officer processing one of these requests does not appear substantial, potentially taking less than 30 minutes and having a minimal effect on operations, if numbers of requests remain small.

30. All Offices applied the part of the Interpretative Statement urging delay in the issuance of notifications that an international application was considered withdrawn (Form PCT/RO/117) where the time limit for an applicant to meet a requirement had expired. However, not all Offices applied this provision until at least May 31, 2020. A few Offices restarted issuing these notifications from an earlier date where work had resumed in the country. Almost all Offices followed the recommendation of the International Bureau of only issuing such notifications where deadlines had expired at least two months previously. Offices that issued notifications at an earlier point indicated that they made contact with the applicant after expiry of a time limit and only issued the notification when the applicant confirmed intention not to proceed with the international application. The Interpretative statement therefore appears to have achieved the aim of avoiding international applications being considered withdrawn when this was not the applicant’s intention, even if not all receiving Offices delayed issuing notifications of withdrawal until May 31, 2020 in line with the practice at the International Bureau.

31. Almost all Offices had followed the recommendation in the Interpretative statement to waive late payment fees. Offices that did not waive these fees cited lack of legislative authority or the need to change IT systems as reasons for not waiving them.

32. *The Working Group is invited to note the contents of this document.*

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