

Patent Cooperation Treaty (PCT) Working Group

Fifth Session
Geneva, May 29 to June 1, 2012

SUMMARY BY THE CHAIR

AGENDA ITEM 1: OPENING OF THE SESSION

1. Mr. Francis Gurry, Director General of WIPO, opened the session and welcomed the participants. Mr. Claus Matthes (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. Susanne Ås Sivborg (Sweden) as Chair for the session and Mr. Andrés Guggiana (Chile) as Vice-chair; there was no nomination for a second Vice-chair. Ms. Sivborg chaired the discussions on all agenda items, except for the discussions on agenda items 6(f) to 7(a), which were chaired by Mr. Guggiana.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

3. The Working Group adopted the revised draft agenda as proposed in document PCT/WG/5/1 Rev. 3, with the following addition as new agenda item 8 (and consequential renumbering of agenda items 8, 9 and 10):

“8. Contribution of the Working Group to the implementation of the respective Development Agenda Recommendations.”

4. One Group stated that it agreed to the inclusion of this new agenda item on the understanding that it was in no way to be considered to create a precedent towards becoming a “standing item” on the agenda of future meetings of the Working Group.

AGENDA ITEM 4: PCT STATISTICS

5. One delegation expressed the wish that the PCT Yearly Review should contain statistics regarding Rule 42 timeliness.

6. The Working Group noted a presentation by the International Bureau on PCT statistics, based on the recently published *PCT Yearly Review 2012*.

AGENDA ITEM 5: MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT ON THE NINETEENTH SESSION

7. The Working Group noted the report on the nineteenth session of the Meeting of International Authorities under the PCT, based on the Summary by the Chair of that session contained in document PCT/MIA/19/13 and reproduced in the Annex to document PCT/WG/5/2.

AGENDA ITEM 6: FUTURE DEVELOPMENT OF THE PCT SYSTEM**(A) IMPLEMENTATION OF RECOMMENDATIONS TO IMPROVE THE FUNCTIONING OF THE PCT SYSTEM**

8. Discussions were based on document PCT/WG/5/3.

9. The Working Group welcomed the announcements by some delegations of projects aimed at implementing specific PCT Roadmap recommendations endorsed by the Working Group (by the Delegation of Germany with regard to the commencement of a pilot project, carried out jointly with WIPO, to make the external client of the online search system of the German Patent and Trademark Office available to specific developing countries fulfilling certain criteria; by the Delegation of Australia with regard to the commencement of a new training initiative, aimed at providing long-term training in substantive examination to examiners of selected developing country Offices; and by the Delegation of the United States of America, encouraging Offices from developing countries that wished to receive training by the United States Patent and Trademark Office's Global IP Academy to approach the Office or the Delegation).

10. The Working Group discussed the continued need for training, both with regard to patents in general and more specifically with regard to the PCT, for Office staff and users in developing and least developed countries, and the need for awareness-raising activities especially among small and medium-sized enterprises, universities and research institutions. Some Member States requested the International Bureau to intensify its efforts in providing technical assistance and capacity building to developing countries in accordance with PCT Article 51. In this context, ongoing efforts by the International Bureau to work together with donor Offices should be reinforced, noting the positive examples of the projects announced by the Delegations of Australia, Germany and the United States of America. Some delegations emphasized the need for fee reductions for certain applicants, especially small and medium-sized enterprises, universities and not-for-profit research institutes, especially but not limited to those from developing and least developed countries. While noting the complexity of the issue and of the issue of finding a financially sustainable way forward to make the PCT system more accessible, the Working Group agreed to request the Secretariat to prepare a further discussion paper on these issues for consideration at the sixth session of the Working Group.

11. The Working Group noted the contents of document PCT/WG/5/3.

(B) THE SURGE IN WORLDWIDE PATENT APPLICATIONS

12. Discussions were based on document PCT/WG/5/4.

13. The Working Group welcomed the study set out in document PCT/WG/5/4. Some delegations suggested that follow up work should be undertaken to further explore in greater detail other possible causes stated in paragraph 5 of the study, including defensive patenting, and to expand on the issues touched upon in paragraphs 43 and 45 of that document with regard to the possible role of the TRIPS Agreement, and to look into issues such as the increasing number of low-quality patents being granted and possible north-south differences in explaining the growth in patenting worldwide.

14. Some other delegations expressed the view that the document, together with document PCT/WG/4/4, constituted an exhaustive and comprehensive response to the request by the Working Group for a study on the possible causes for the surge, which had clearly concluded that there was no single factor that could fully explain the increase in the number of patent applications filed worldwide. Noting the constraints as to the generation of new empirical evidence referred to in document PCT/WG/5/4, those delegations considered further follow up work to be unnecessary and that no further resources should be dedicated to such work.

15. Some delegations stated that they would like to submit further literature references related to the surge in worldwide patent applications and requested the International Bureau to issue an invitation in that regard.

16. The Working Group noted the contents of document PCT/WG/5/4.

(C) COORDINATION OF TECHNICAL ASSISTANCE AND FINANCING OF TECHNICAL ASSISTANCE PROJECTS FOR DEVELOPING COUNTRIES UNDER ARTICLE 51 OF THE PCT

17. Discussions were based on document PCT/WG/5/5.

18. A number of different views were expressed. Some delegations expressed their views that matters related to the provision of technical assistance in the context of the PCT should be specifically referred to the PCT Committee for Technical Assistance, and that that body should be convened soon, emphasizing the importance that the issues referred to in PCT Article 51, especially paragraph (3)(b), needed to be considered by an appropriate Member State body. Particular reference was made in this context to the recommendations contained in the "External Review of WIPO Technical Assistance in the Area of Cooperation for Development" (document CDIP/8/INF/1) currently under consideration in WIPO's Committee on Development and Intellectual Property (CDIP), notably the need to take into account some of the basic principles for development related activities, such as that they should be demand-driven, tailored to meet specific needs and properly evaluated. Those delegations also emphasized the need for technical assistance to be guided by the relevant Development Agenda recommendations.

19. Some other delegations stated that they did not see the need to refer such issues to the PCT Committee for Technical Assistance or to convene that body but rather should be discussed in the CDIP, so as to avoid any duplication of effort, noting the broad mandate of that Committee to discuss any development related IP issues.

20. The Working Group agreed to the suggestion made by one delegation that reports similar to that provided for in Annex II to document PCT/WG/5/5 with regard to the technical assistance projects relating to the PCT carried out in the 2010/2011 biennium should be included as a regular agenda item for future sessions of the Working Group. In that regard, some delegations

suggested that the International Bureau should improve the quality and the scope of reporting and provide, for the information of the Working Group, detailed information on the PCT technical assistance activities for developing countries, including a copy of the work plan on future PCT technical assistance and capacity building activities for developing countries and information pertaining to PCT technical assistance activities carried out under the supervision of other WIPO bodies. One delegation stated that it was important to note that work plans are developed and driven by the International Bureau, and it was not for the Working Group to decide on the work plan itself. The Chair confirmed the agreement of the Working Group with the foregoing.

21. The Working Group noted the contents of the study set out in Annex I to document PCT/WG/5/5 and the information on technical assistance projects relating to the PCT set out in Annex II to that document.

(D) THE PCT'S AIMS OF ORGANIZING TECHNICAL ASSISTANCE FOR DEVELOPING COUNTRIES, DISSEMINATING TECHNICAL INFORMATION AND FACILITATING ACCESS TO TECHNOLOGY; SUFFICIENCY OF DISCLOSURE

22. Discussions were based on document PCT/WG/5/6.

23. Some delegations which took the floor on this matter expressed their support for the suggestion set out in document PCT/WG/5/6 to await the discussions on the "External Review of WIPO Technical Assistance in the Area of Cooperation for Development" (document CDIP/8/INF/1) currently ongoing in the CDIP before considering how to proceed with regard to the technical assistance related parts of the PCT Roadmap recommendation. In this context, some delegations reiterated the importance of drawing lessons from the report, for the PCT to take ownership of relevant parts of the recommendations made in that report and for there to be better coordination and clarity on the extent to which PCT was involved in technical assistance related projects undertaken by other areas of WIPO and supervised by other WIPO bodies, such as the CDIP.

24. With regard to the information set out in document PCT/WG/5/6 on the PCT's informational aims of disseminating technical information and facilitating access to technology, the Secretariat—in response to queries by some delegations—provided clarification on the collaboration between the PCT and other areas of WIPO on technical assistance activities and how the activities of the International Bureau, particularly in relation to PATENTSCOPE, ARDI, ASPI and TISCs, were aimed at meeting the objectives of PCT Article 50(3), surpassing what could have been contemplated by the founders of the PCT when drafting the provisions in the 1960s.

25. With regard to the issues of sufficiency of disclosure, some delegations expressed an interest in carrying out a review of the PCT-related sufficiency of disclosure requirements with a view to look into the issue as to how the PCT can better contribute to the examination by national Offices of international applications in the national phase with regard to their compliance with sufficiency of disclosure requirements under applicable national laws. For future work, the International Bureau was requested to treat this issue in a separate document. Some other delegations reiterated that the PCT was a procedural treaty dealing with form and content, whereas sufficiency was a matter of substantive patent law which should be dealt with by national law and pointed to the fact that the responses received in reply to the relevant Circular sent out by the International Bureau had not provided any indication of concern with the current way in which this matter was handled by the PCT. One delegation provided details of ways in which it was seeking to improve availability of information concerning national patents and search reports.

26. The Working Group took note of the contents of document PCT/WG/5/6.

(E) PCT 20/20

27. Discussions were based on document PCT/WG/5/18, containing proposals by the United Kingdom and the United States of America for further improvements to the PCT system.

28. Delegations provided preliminary views on the proposals set out in the document. While noting that more time was needed to carefully study the proposals, to consult with user groups and to consider the possible impact on respective national laws, all delegations which took the floor on the matter generally welcomed the initiative taken by the United Kingdom and the United States of America, noting in particular the positive spirit in which the proposals were made, recognizing the importance of the further development of the PCT system for the international patent system as a whole. On the other hand, some delegations expressed some preliminary concerns as to particular proposals contained in the document.

29. The Delegations of the United Kingdom and the United States of America agreed to further elaborate on the proposals set out in document PCT/WG/5/18, providing more detail on how to take the proposals forward, for discussion at the next session of the Working Group.

(F) PROPOSALS FOR FURTHER IMPROVEMENT OF PCT SERVICES AND PRODUCTS

30. Discussions were based on document PCT/WG/5/20, containing proposals by the European Patent Office for further improvement of PCT services and products.

31. Delegations provided preliminary views on the proposals set out in the document. While noting that more time was needed to carefully study the proposals, to consult with user groups and to consider the possible impact on respective national laws, all delegations which took the floor on the matter generally welcomed the initiative taken by the European Patent Office. Whereas some delegations expressed support for at least some of the proposals, concerns were raised by some delegations on particular proposals in the document, notably those which would affect national laws or national phase processing.

32. The Delegation of the European Patent Office agreed to further elaborate on the proposals set out in document PCT/WG/5/20 to enable a more in-depth analysis at the next session of the Working Group.

(G) THIRD PARTY OBSERVATIONS SYSTEM; QUALITY FEEDBACK SYSTEM

33. Discussions were based on document PCT/WG/5/7.

34. Some delegations welcomed the information that the third party observation system was expected to begin operation on July 2, 2012. In response to queries from some delegations, the International Bureau confirmed that designated Offices were free to use third party observations to the extent which they considered appropriate to their needs and in compliance with their national laws. Flexibility was also required for International Preliminary Examining Authorities. Concerns were restated of possible burdens for applicants with the hope that procedures be reviewed in the future to mitigate those burdens.

35. The Working Group noted the contents of document PCT/WG/5/7.

(H) REVIEW OF SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

36. Discussions were based on document PCT/WG/5/8.

37. Some delegations supported the proposal for the International Bureau to continue monitoring the supplementary international search system for a further three years, and for the PCT Assembly to conduct a further review of the system in 2015. One delegation, expressing concern about the very low uptake of supplementary international searches, believed the future of the system should be considered carefully if uptake did not improve over this period. Some delegations expressed the hope that more Authorities would offer supplementary international services in the future, particularly with expertise in Asian languages. Two International Authorities already offering supplementary international searches indicated that they were considering offering a more specialized service at a lower cost, in addition to or instead of a complete new search, subject to further consultations internally and with users.

38. Based on a proposal by one delegation, the Working Group agreed to amend paragraphs (b) and (c) of the recommended draft decision for adoption by the PCT Assembly set out in paragraph 37 of the document as follows (new text underlined):

“(b) to invite the International Bureau, International Authorities and national Offices and user groups to increase their efforts to raise awareness of and promote the service to users of the PCT system;

“(c) to invite the International Authorities which offer supplementary international searches to consider reviewing the scope of their services provided under the system and consequently the levels of fees charged for the services provided, which should be reasonable; and to invite Authorities which currently do not offer the service to reconsider whether to offer the service in the near future;”.

(I) COLLABORATIVE SEARCH AND EXAMINATION PILOT PROJECT: STATUS REPORT

39. Discussions were based on document PCT/WG/5/9.

40. Some delegations reiterated the importance of the collaborative nature of the pilot project, noting the potential to improve quality and efficiency of the process and stated that they looked forward to a full report when the second phase of the pilot project was completed. Some delegations stressed the importance of any participation in collaborative search and examination systems being voluntary for International Authorities and the need for the preservation of discretion for national Offices in applying national patentability criteria when examining applications during the national phase.

41. The Working Group noted the contents of document PCT/WG/5/9 and invited the Offices participating in the pilot project to present a more detailed evaluation at the next session of the Working Group.

(J) AVAILABILITY OF WRITTEN OPINION BY THE INTERNATIONAL SEARCHING AUTHORITY AS OF THE DATE OF INTERNATIONAL PUBLICATION

42. Discussions were based on documents PCT/WG/5/10 and 10 Add.

43. Some delegations expressed support for the proposals set out in document PCT/WG/5/10 as further clarified by document 10 Add. Some other delegations, while supporting the proposals in principle, stated that they needed more time for consultations with users. Some delegations considered that further consideration would be needed of certain aspects, such as

the relevance of PCT Article 38 to the issue, the opportunity for applicants to provide comments on the written opinion and for those comments to be made available on PATENTSCOPE, whether there was indeed a strong interest of users in such a change, and the issue of timing of translations and resulting costs.

44. The Working Group agreed to consider the proposals in further detail in a future session of the Working Group.

(K) TOP-UP SEARCHING AND ACCELERATED PROCESSING

45. Discussions were based on document PCT/WG/5/11, containing proposals by the United Kingdom for incorporating a top-up search into the international preliminary examination procedure and offering the option of accelerated processing in the international phase, and document PCT/WG/5/11 Add., containing proposals by the United States of America for amendments to the PCT Regulations to introduce a top-up search.

46. Delegations provided preliminary views on the proposals set out in documents PCT/WG/5/11 and 11 Add., with some delegations noting that more time was needed to carefully study the proposals and to consult with user groups.

47. With regard to top-up searching, some delegations expressed support for the proposals which would improve quality and utility of the international work products for designated Offices, either in general terms or specifically. Some other delegations expressed concern over the obligatory character of the proposed amendment of Rule 66. Recommendations in the PCT International Search and Preliminary Examination Guidelines might be an alternative. Consideration would be needed of compatibility with certain PCT Articles and Rules and of the appropriate procedures in certain cases, such as where major amendments had been made. The representative of one international non-governmental organization expressed concerns that the proposal would impose work products on national Offices and was aimed at harmonizing substantive patent law.

48. With regard to accelerated processing, some delegations indicated interest in the concept, which could be of great interest to certain users of the system, but some other delegations suggested that the existing time limits were difficult to meet and that accelerating procedures for some international applications would inevitably delay others. Some delegations expressed opposition to the principle of discrimination between levels of service. Some delegations suggested that the issues with meeting the existing deadlines should be addressed first and that accelerated procedures would introduce complexity and should only be considered if it could be shown that they were the only appropriate solution to a clear problem.

49. The Working Group invited the United Kingdom and the United States of America to take on board the comments made and the concerns expressed by the Working Group with a view to presenting more detailed and further refined proposals at a future session of the Working Group.

(L) ePCT UPDATE

50. Discussions were based on document PCT/WG/5/12, a presentation by the International Bureau, including statistics on use of the system as well as details of the most recent release and of further releases expected this year¹, and a demonstration of the applicant portal.

51. Delegations welcomed the work on ePCT. Specific concerns of delegations included ensuring the necessary interoperability with existing systems used by national Offices, including PCT-ROAD, and ways to allow the proposed web-filing system to be offered for use with national receiving Offices in a way which ensured compatibility with national laws, particularly in relation to national security.

52. The Working Group noted the planned work by the International Bureau on implementation of the project.

AGENDA ITEM 7: PCT PROCEDURAL AND LEGAL FRAMEWORK

(A) RESTORATION OF THE RIGHT OF PRIORITY

53. Discussions were based on document PCT/WG/5/13.

54. Some delegations welcomed the review of the practices of Offices relating to the restoration of the right of priority as being very useful, notably the practice guidelines issued by the International Bureau in its capacity as a receiving Office, and stated that they supported the recommendations for further work set out in paragraphs 29 to 31 of the document. Some delegations whose national Offices did not at present apply the provisions dealing with the restoration of the right of priority indicated that the review had triggered internal discussions to establish whether it was possible to amend the applicable national law to allow for existing notifications of incompatibility to be withdrawn. One delegation expressed the view that the PCT provisions relating to the restoration of the right of priority was not compatible with its national law and with the Paris Convention and stated that it was thus not in a position to withdraw its existing notification of incompatibility.

55. The Working Group agreed to the further work suggested in paragraphs 29 to 31 of document PCT/WG/5/13.

(B) PCT SEQUENCE LISTING STANDARD

56. Discussions were based on documents PCT/WG/5/14 and 14 Add.

57. All delegations that took the floor on the issue reiterated the importance of a smooth transition from the current WIPO Standard ST.25 to the proposed new XML-based standard. Once the final report of the CWS Task Force investigating the possibility of a tool to allow for easy and complete conversion of sequence listings between the two standards was available, discussions could begin on the best transition mechanism. One delegation stated that it would request that experts from its IP Office also have the opportunity to assess the proper functioning of the conversion tool should the Task Force conclude that conversion between the two standards was possible.

¹ The presentation is available on the WIPO website at http://www.wipo.int/meetings/en/details.jsp?meeting_id=25017

58. The Working Group noted the contents of documents PCT/WG/5/14 and 14 Add.

(C) COLOR DRAWINGS IN INTERNATIONAL APPLICATIONS

59. Discussions were based on document PCT/WG/5/15.

60. Delegations broadly supported the concept of permitting color drawings in international applications to assist effective disclosure, at least in cases where it was necessary for proper understanding of the invention. However, a number of concerns were expressed, notably with regard to the possibility of misleading applicants if color drawings were not effective for the national phase in all designated Offices, with regard to the risk of introducing differences in formal requirements which might be contrary to Article 27, and with regard to possible consequences on national law for Contracting Parties to the Patent Law Treaty. Some concerns applied equally to the proposed interim arrangements as to the proposals for amendments to the Regulations.

61. The Working Group agreed that the International Bureau should continue to evaluate the issues and present further information and proposals to Contracting States when it appears appropriate.

(D) PCT MINIMUM DOCUMENTATION – DEFINITION AND EXTENT OF PATENT LITERATURE

62. Discussions were based on document PCT/WG/5/16.

63. Some delegations expressed support for the general goal of broadening the definition of the PCT minimum documentation, increasing the availability of technical information and improving the quality of the international search. A number of technical, legal and procedural issues would need to be carefully considered to ensure that International Authorities would in fact be able to include all the necessary material in their search databases in a timely manner (or ensure that service providers do so) and to provide training and facilities for their examiners to search it effectively.

64. The Working Group agreed that the International Bureau should continue to work on this matter in accordance with the principles set out in paragraphs 6 to 9 of document PCT/WG/5/16 and that the task force referred to in paragraph 11 of that document should consider the technical issues identified by the Working Group.

(E) REVISION OF WIPO STANDARD ST.14

65. Discussions were based on document PCT/WG/5/17.

66. The Working Group noted the contents of document PCT/WG/5/17.

(F) CHANGES TO THE PCT REGULATIONS NECESSITATED BY THE AMERICA INVENTS ACT

67. Discussions were based on document PCT/WG/5/19 and 19 Corr.

68. It was noted that the proposals would represent a significant simplification to the PCT system for applicants from all Contracting States, not only from the United States of America.

69. The Working Group approved the proposals set out in the Annex to document PCT/WG/5/19, including the correction in document PCT/WG/5/19 Corr. (English version only), with a view to their submission to the Assembly for consideration at its next session, in October 2012.

AGENDA ITEM 8: CONTRIBUTION OF THE WORKING GROUP TO THE IMPLEMENTATION OF THE RESPECTIVE DEVELOPMENT AGENDA RECOMMENDATIONS

70. Some delegations made statements on the contribution of the Working Group to the implementation of the respective Development Agenda Recommendations. The Chair stated that all statements would be recorded in the report for the fifth session of the Working Group and that they would be transmitted to the WIPO General Assembly in line with the decision taken by the 2010 WIPO General Assembly relating to the Development Agenda Coordination Mechanism.

AGENDA ITEM 9: OTHER MATTERS

71. The Working Group agreed to recommend to the Assembly that, subject to the availability of sufficient funds, that one session of the Working Group should be convened between the October 2012 and September/October 2013 sessions of the Assembly, and that the same financial assistance that had been made available to enable attendance of certain delegations at this session should be made available at the next session.

72. The International Bureau indicated that the sixth session of the Working Group was tentatively scheduled to be held in Geneva in May/June 2013.

AGENDA ITEM 10: SUMMARY BY THE CHAIR

73. 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. The report would reflect all interventions made during the meeting, and would be adopted by the Working Group by correspondence, after having been made available for comments on the Working Group's electronic forum as a draft in both English and French.

AGENDA ITEM 11: CLOSING OF THE SESSION

74. The Chair closed the session on June 1, 2012.

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