

Patent Cooperation Treaty (PCT) Working Group

Sixth Session
Geneva, May 21 to 24, 2013

REPORT

adopted by the Working Group

INTRODUCTION

1. The Patent Cooperation Treaty Working Group held its sixth session in Geneva from May 21 to 24, 2013.
2. The following members of the Working Group were represented at the session: (i) the following Member States of the International Patent Cooperation Union (PCT Union): Algeria, Australia, Austria, Barbados, Belarus, Belgium, Benin, Brazil, Brunei Darussalam, Canada, Chile, China, Colombia, Czech Republic, Denmark, Dominican Republic, Egypt, El Salvador, Estonia, Finland, France, Georgia, Germany, Hungary, India, Ireland, Israel, Italy, Japan, Latvia, Lithuania, Madagascar, Malaysia, Mexico, New Zealand, Nigeria, Norway, Panama, Philippines, Poland, Portugal, Republic of Korea, Romania, Russian Federation, Saudi Arabia, Singapore, Slovakia, South Africa, Spain, Sri Lanka, Sudan, Sweden, Switzerland, Tunisia, Ukraine, United Kingdom, United States of America, Zimbabwe (58); (ii) the following intergovernmental organizations: European Patent Office (EPO), the Nordic Patent Institute (NPI) (2).
3. The following Member States of the International Union for the Protection of Industrial Property (Paris Union) participated in the session as observers: Iran (Islamic Republic of), Venezuela (Bolivarian Republic of) (2).
4. The following intergovernmental organizations were represented by observers: African Intellectual Property Organization (OAPI), African Regional Intellectual Property Organization (ARIPO), Eurasian Patent Organization (EAPO), European Union (EU), South Centre (5).

5. The following international non-governmental organizations were represented by observers: Asian Patent Attorneys Association (APAA), European Law Students' Association (ELSA International), Institute of Professional Representatives before the European Patent Office (EPI), International Federation of Industrial Property Attorneys (FICPI), Third World Network (TWN) (5).
6. The following national non-governmental organizations were represented by observers: All-China Patent Agents Association (ACPAA), American Intellectual Property Law Association (AIPLA), Brazilian Association of Intellectual Property (ABPI), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Polish Chamber of Patent Attorneys (6).
7. The list of participants is contained in Annex III.

OPENING OF THE SESSION

8. 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.
9. The Director General informed the Working Group that Brunei Darussalam and Panama had acceded to the PCT in 2012, and that Saudi Arabia had deposited its instrument of accession on May 3, 2013. The Director General also informed the Working Group that the Egyptian Patent Office had commenced operations as an International Searching Authority and International Preliminary Examining Authority on April 1, 2013.
10. The Director General further stated that the full agenda for the session demonstrated the interest prevailing in the development of the PCT system, indicating the recognition of the PCT system as the central node in the international patent system. Moreover, the PCT formed the financial basis of WIPO, generating about 75 per cent of the revenue of the Organization. The PCT was therefore crucial both to the international patent system and the operations of WIPO.
11. The Director General acknowledged the political and financial sensitivity of PCT fee reductions to be discussed during the session. With regard to conducting a review into the possibility of extending fee reductions to small and medium-sized enterprises (SMEs), universities and not-for-profit research institutes, the Director General pointed out the difference between the impact of any such reduction on the applicant and on WIPO as an organization. From the point of view of SMEs, universities and not-for-profit research institutes, PCT fees made up less than 1 per cent of international patenting fees. The two major elements of international patenting costs were lawyer/attorney fees and translation costs; fees paid to Offices were a third but less significant element of the overall costs. Moreover, when considering Office fees, in most cases, fees payable at a national and regional level made up a considerably larger portion than the international filing fee. Putting this into the context of the debate on fee reductions on SMEs, universities and not-for-profit research institutes, the impact of such reductions would therefore be considerable for WIPO, yet the impact for applicants in terms of altering filing behavior was believed to be less than 1 per cent. The Director General also underlined the high importance and sensitivity of the other issue related to PCT fee reductions, namely, the class of countries eligible for such PCT fee reductions.
12. The Director General further informed the Working Group of some key figures for 2012, which had been a successful year for the PCT system. By the end of 2012, there were 146 Contracting States, and now there were 147 Contracting States, following the recent accession of Saudi Arabia. In 2012, a record number of international applications had been filed, a rise of 6.6 per cent compared to 2011. Following this success, it might be expected that the number of international applications filed in a single year could pass 200,000 for the first time in 2013. International applications had been filed by 45,134 applicants from 120 different countries in 2013. The top filer had been ZTE Corporation from China, followed by Panasonic Corporation from Japan. By country of origin, at 51,429 applications, the United States of America remained the

source of the highest number of PCT applications, followed by Japan (43,659 applications), Germany (18,758 applications), China (18,614 applications), and the Republic of Korea (11,846 applications). There had been a record number of more than 500,000 national phase entries in 2011. About 4,500 national phase entries in 2012 included requests to accelerate national procedures under bilateral PCT-Patent Prosecution Highway (PPH) agreements. This increase of more than 60 per cent from the previous year indicated the importance of linkage between the PCT and the PPH. Finally, an estimated 55 per cent of worldwide non-resident patent applications had come through the PCT as national phase entries, bearing testimony to the importance of the PCT system.

13. The Director General concluded by highlighting some of the recent updates to ePCT, which constituted a very important development in the administration of the PCT system. With over 6,000 users of the ePCT system from more than 100 countries, ePCT provided live access to files of international applications held by the International Bureau and the possibility to submit documents and data, thereby eliminating postal delays and transcription errors, reducing processing delays and allowing immediate feedback on the processing status. ePCT filing had now entered a live pilot phase with a small group of volunteer applicants. The International Bureau hoped to make this service available to all users in the third quarter of 2013. Through ePCT, an increasing range of services were being offered to national Offices in their roles as receiving Office, International Searching Authority and International Preliminary Examining Authority. In particular, the International Bureau provided a hosted solution, allowing national Offices in their role as receiving Office to offer the benefits of e-filing to their nationals and residents even if they could not themselves support the necessary IT infrastructure at this stage. Staff at the International Bureau working on ePCT would be available throughout the meeting to demonstrate the system to participants, discuss possibilities for its use and respond to any questions.

ELECTION OF A CHAIR AND TWO VICE-CHAIRS

14. The Working Group unanimously elected Mr. Victor Portelli (Australia) as Chair for the session. There were no nominations for Vice-Chairs.

ADOPTION OF THE AGENDA

15. The Working Group adopted the revised agenda as set out in document PCT/WG/6/1 Rev.

PCT STATISTICS

16. The Working Group noted a presentation by the International Bureau on PCT statistics, based on the recently published *2013 PCT Yearly Review*¹.

EPCT

17. Discussions were based on document PCT/WG/6/2 and a presentation by the International Bureau on the ePCT system².

18. The Delegation of the Republic of Korea underlined the importance of making the interface available in all 10 PCT languages of publication as quickly as possible.

¹ A copy of the presentation is available on the WIPO web site at: http://www.wipo.int/edocs/mdocs/pct/en/pct_wg_6/pct_wg_6_presentation_statistics.ppt. The *2013 PCT Yearly Review* is available on the WIPO web site at <http://www.wipo.int/ipstats/en/statistics/pct/>.

² A copy of the presentation is available on the WIPO web site at: http://www.wipo.int/edocs/mdocs/pct/en/pct_wg_6/pct_wg_6_presentation_epct.ppt.

19. The Delegation of Australia stated that ePCT was an excellent tool, with IP Australia being one of the top users. The Delegation looked forward to future developments of the system and enquired about which Offices were currently using ePCT.
20. The Delegation of El Salvador commented that ePCT for Offices appeared to be pilot project and enquired about the duration and status of the pilot and the participation of Offices from developing countries. The Delegation also supported the remarks made by the Delegation of the Republic of Korea in relation to the availability of the ePCT interface in all publication languages, adding that having this available as quickly as possible would be useful both for technical staff in Offices and for users and inventors. Finally, the Delegation asked for clarification on the IT infrastructure required by an Office to support the ePCT system, and stated that it hoped to give further feedback on the system later in the year from the perspective of a developing country.
21. The Secretariat, responding to the questions raised by the Delegation of El Salvador, stated that ePCT for Offices was a pilot in the sense that the interface was not yet available in all languages of publication; furthermore, the International Bureau did not yet have total confidence in providing the level of service necessary for an Office to rely on ePCT entirely for its day-to-day work without the need to have an alternative as a backup. Both these points were being addressed and the system was expected to continue in the future. In fact, availability of the service had been close to 100 per cent over the past three months, with total downtime only being a few minutes. The Secretariat added that a broad range of Offices were using ePCT in their capacity as receiving Offices, including Offices from developing countries, and there were several Offices using the system as International Searching and Preliminary Examining Authorities. In relation to IT infrastructure required for an Office to use ePCT, all that was required was a web browser and Internet connection, along with a scanner for the Office of adequate quality for putting applications filed on paper into the system.
22. The Delegation of Israel welcomed the recent developments of ePCT, which provided an efficient and effective service for applicants and Offices which use the web interface. The Israel Patent Office had recently begun to use ePCT as a receiving Office and as an International Searching and Preliminary Examining Authority, together with the PCT-EDI system for transmission of documents as it used batch processes. With immediate access and file inspection to view the most recent data and the documents in the files of international applications for which the Office was acting as receiving Office, International Searching Authority or International Preliminary Examining Authority, the system provided opportunities for effective communication and expediting services, including sending search copies and delivering international search reports and demands. It was therefore necessary to extend ePCT as soon as possible to allow transmission of search copies from receiving Offices to different International Searching Authorities, either via the International Bureau or directly to the relevant International Searching Authority. The Delegation also supported the use of ePCT to assist applicants entering the national phase in different countries by using ePCT to create the required forms from bibliographic data already existing in the system. Finally, it was necessary to review the minimum specification documentation related to the PCT-EDI system in order to ensure transmission of a wider range of documents to the International Bureau.
23. The Delegation of Japan requested the International Bureau to proceed with further development of the ePCT system, taking into consideration compatibility with existing systems at all national Offices, such as original character codes and data formats, so that exchange of documents and information could be smoothly performed between the applicant, receiving Office and the International Bureau. In particular, it was necessary for the Japan Patent Office to explore in detail the feasibility of accepting ePCT filings in the future on the understanding that such filings could be accepted at receiving Offices with changing existing systems.

24. The Delegation of China thanked the International Bureau for its continued work on developing the ePCT system and looked forward to full implementation of the ePCT system and the benefits this would bring to applicants and Offices worldwide. The Delegation also expressed its willingness to participate and cooperate in the development of the system and hoped for the interface to soon be available in Chinese.

25. The Delegation of the United States of America thanked the International Bureau for its continued efforts to develop the ePCT system, especially as it related directly to the Global Dossier System described in both the Expanded PCT 20/20 Proposals (document PCT/WG/6/15) and PCT Kaizen (from Partial to Total Optimization) (document PCT/WG/6/14 Rev.). The Delegation welcomed indications that electronic filing of international applications via the web interface and real-time credit card transactions would soon be available, both of which would be significant improvements for applicants. However, the Delegation expressed concerns with regard to the establishment of the legal and IT framework for the collection of fees by the International Bureau that were due to be paid to Offices in their role as a receiving Office, International Searching Authority or International Preliminary Examining Authority. For example, if the Office did not receive timely notification of a payment through the ePCT system, the result could be improper withdrawal of the international application. The Delegation also welcomed the indication of upcoming improvements regarding electronic access to information for designated Offices and the retrieval of documents. On this matter, the United States Patent and Trademark Office had experienced difficulties in the past with obtaining certain documents that it had been entitled to receive.

26. The Delegation of the European Patent Office stated that it was convinced of the potential of ePCT to improve the PCT system, making the system more accessible for applicants and more efficient for Offices. The European Patent Office had recently begun a pilot project to allow online web filing of PCT applications. The Delegation hoped that efforts invested in the pilot projects concerning the electronic transmission of search copies and the transfer of search fees would shorten processing times and facilitate the work of International Searching Authorities.

27. The Chair concluded by underlining the importance of continued technical collaboration between Offices and the International Bureau in order to realize the full potential of ePCT to assist Offices, agents and applicants to deal with the challenges of the growing PCT system.

28. The Working Group noted the contents of document PCT/WG/6/2 and the presentation by the International Bureau on the ePCT system.

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT ON THE TWENTIETH SESSION

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

30. Introducing the document, the Secretariat referred to the discussions on quality that had taken place at the most recent sessions of the Meeting of International Authorities and of the Quality Subgroup. The Meeting of International Authorities had approved the continuation of the mandate of the Quality Subgroup, with a further physical meeting to be held in 2014, and had also agreed that the International Bureau should submit a report to the Assembly on quality-related work by the Meeting, including a reference to annual quality management reports from International Authorities.

31. The Secretariat further pointed out three items on quality that had been discussed by the Quality Subgroup and the Meeting of International Authorities. First, the International Bureau had presented a report on the characteristics of international search reports, building on an earlier study that had been performed by the European Patent Office for the Trilateral Offices by extending it to cover all International Authorities. This report had been sent to International Authorities as Circular C. PCT 1360, which was available on the WIPO web site. The report would

be continued on an annual basis. The aim of the exercise was not to measure quality as such, but rather to identify what could be learned from the characteristics and from their similarities and differences in order to point to areas of further work to improve the quality of the PCT work products, for the benefit of applicants and Offices. Second, the Meeting of International Authorities had agreed, based on a proposal by the European Patent Office, to commence work on the establishment of a PCT Metrics Framework. The aim was to develop a set of metrics to allow evaluation of the entire PCT system, covering the work of Offices acting in as receiving Offices, International Searching and Preliminary Examining Authorities and designated/elected Offices, as well as the work of the International Bureau. A first draft of the PCT Metrics Framework was being discussed by the Quality Subgroup on its electronic forum. The draft PCT Metrics Framework would, in due course, be circulated to a wider audience for further consultation, including all Contracting States, with the aim of making the metrics report available on an annual basis, thus allowing for identification of areas of further work to improve the system. Third, the Meeting had taken note of a status report on a pilot project carried out by the Swedish Patent Registration Office titled "Analysis of the Usefulness for the National Phase of International Search Reports". The idea behind this pilot was to take international search reports and to see how they were used in the national phase, in particular, identifying applications for further analysis where the international search report only contained background art citations, but citations relevant to novelty and/or inventive step had been found in the national phase. This labor-intensive exercise had been carried out on a small scale; work would continue in the Quality Subgroup to provide structured feedback to International Authorities on international applications by developing ongoing projects, such as the proposed arrangements for an PCT-EDI/ePCT quality feedback system.

32. The Delegation of Brazil stated that it placed high importance on the ongoing debates in the Working Group and the possible ways being discussed to improve the quality of reports produced by International Authorities. The results from these debates benefitted both developed and developing countries, generating greater efficiency and reliability in processing patent applications. The Delegation considered the Working Group to be the adequate forum for discussions regarding the improvement of the PCT since it was of a broad and technical nature and since the discussions could benefit from the participation of all the membership of the PCT. The Delegation therefore requested more detailed information regarding the reporting from the Meeting of International Authorities in the Summary by the Chair to be made available to the Working Group. Noting that that many of the items on the agenda of the Meeting of International Authorities, including those related to quality, were of interest to all WIPO Member States, the Delegation suggested that sessions of the Meeting of International Authorities should be held in Geneva, allowing for the broader participation of Geneva-based missions of Member States in the discussions.

33. The Working Group noted the report on the twentieth 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/20/14 and reproduced in the Annex to document PCT/WG/6/3.

PCT KAIZEN

34. Discussions were based on document PCT/WG/6/14 Rev.

35. The Delegation of Japan introduced the document, explaining that the word "Kaizen" referred to a Japanese philosophy of continuous improvement of working practices, personal efficiency etc. Against the backdrop of the increasing number of international patent applications filed under the PCT in recent years, making the PCT system today a global infrastructure for applicants to file their patent applications worldwide, the Delegation stated that there remained important issues to be solved. For example, work products of the international phase were not being thoroughly and efficiently utilized in the national phase. Under such circumstances, the Delegation believed that the International Bureau, International Authorities and Contracting States had the important mission to maximize the benefits of the PCT system and to further improve it in order to create a more user-friendly system. To achieve this objective, the Delegation considered that developing a

common understanding of the future direction might lead to effective and fruitful discussions. The Delegation emphasized that the proposal would not to immediately amend the Treaty or Rules, but instead was based on the principle of maximizing the PCT system within the existing framework.

36. The Delegation continued by stating that the basic concept of the proposal was that total optimization and effective implementation of the Plan-Do-Check-Act (PCDA) cycle were necessary to further improve the PCT system. Based on this concept, the aim was to achieve PCT Kaizen, namely, to establish a framework for continuous improvement in every aspect of the PCT system. Past steps for improving the PCT system had mainly focused on partial optimization, in other words, by enhancing the quality and improving functional capabilities of each player in the PCT system. However, the Delegation believed that efforts to implement partial optimization might be insufficient to maximize the benefits of the PCT system. Accordingly, the Delegation believed that it was important to take a total optimization approach as a general corporate management approach to maximize the benefits. In other words, it should be essential to obtain an overview of the whole process and operations of the PCT system from the perspective of managing the system in order to facilitate collaboration among all the operational elements. That is to say, the entire PCT system should be considered as one business process.

37. The Delegation added that efficient implementation of the PDCA cycle would lead to higher quality and effective use of international search reports as well as improvement in the whole operational process, thereby continuously improving the PCT system and maximizing the benefits. In this regard, among the mechanisms to achieve this improvement, the Delegation emphasized the importance of creating the intelligence designed for analyzing and improving the PCT process and establishing IT infrastructure for facilitating such intelligence. Based on this, the PDCA cycle would continue to move efficiently in every phase of the system. The Delegation emphasized the importance of developing a common understanding of the future direction of the PCT system and hoped for support from the Working Group for its proposal.

38. The Delegation further continued with introducing the five specific proposals set out in the document designed for implementing the PCT Kaizen concept. The first proposal involved measures for improving the quality of search/ examination at the international phase, which was also detailed in Annex II to the document. The Japan Patent Office had conducted a detailed analysis on discrepancies between the results of the international phase and those of the national phase. The result of this analysis contained useful information for improving the quality of search and examination, not only for the Offices that conducted the analysis but also for other Offices. It was therefore beneficial to share information on problems with other Offices to find solutions together. Based on such awareness, the Delegation proposed establishing two frameworks, as described in paragraph 11 of the document. The Delegation underlined that the information to be shared between Offices was not to determine which Office was right or how many mistakes had occurred; rather, the important point of sharing information should be to find why the discrepancies occurred and ways to consider how Offices could solve them. As there were other projects similar to these frameworks, the Delegation expressed willingness to cooperate with other Offices on this issue, adding that the frameworks should be flexible, based on voluntary cooperation between interested Offices.

39. The second proposal involved promoting the linkage between the international and the national phase, relating both to high quality international search reports and efficient operational processes. The Delegation recognized that many Offices had already implemented and/or proposed several measures to strengthen the linkage under their current legal frameworks. Some of these measures had been implemented and produced positive effects, while others were still at the proposal stage and required further scrutiny. The Delegation therefore proposed sharing and analyzing these measures in order to promote further linkage between the international and the national phase. To that end, the International Bureau had set up a PCT Working Group electronic forum so that information on such measures could be shared. The Japan Patent Office had

already posted information on its measures on this forum. The Delegation requested other Offices to share information on the electronic forum so the Delegation could deepen discussion on this issue based on the analysis of this information.

40. The third proposal involved refining collaborative search and examination. Under the basic principle that International Searching Authorities should take responsibility for their international search reports, it was important to improve their individual capacities. On the other hand, contrary to this principle, collaborative search and examination provided a possibility of achieving higher quality international search reports and creating positive effects through cooperation among examiners at various International Searching Authorities, as well as allowing for the possibility to share expertise. The Delegation therefore welcomed a follow up evaluation for analyzing the balance between the various costs related to collaborative search and examination practices with the advantages that the searches could offer, taking into account the disadvantages resulting from collaborative search and examination practices, such as increased workload and costs to both users and Authorities. The Delegation believed that it was necessary to conduct this evaluation from the perspective of making an empirical analysis as to the effect that reducing workload had on the national phase. Although the Japan Patent Office did not have a plan to join the collaborative search and examination pilot (see document PCT/WG/6/22 Rev.) at this moment, the Delegation welcomed discussion for the purposes of exploring the collaborative search and examination practices and refining them.

41. The fourth specific proposal dealt with creating intelligence designed for analyzing and improving the PCT process. The Delegation stated that it was vitally important that the PCT system had a certain degree of intelligence serving as an indicator for observing how the PCT system was effectually operating. Intelligence could be created by processing and formulating available data accumulated conventionally or unconventionally. The PCT system had collected and accumulated many items of data, utilized mainly for the purpose of informative statistics. However, the majority of existing data was more or less static, serving to monitor PCT processing, such as the international filing date, the date of receipt and the date of issuance of the international search report. The Delegation therefore believed that sufficient attention had not been paid to enhancing such data to create more value-added information to contribute to improving the PCT process, which the Delegation referred to as intelligence, a popular business term. In this respect, the Delegation shared two aspects of PCT intelligence. First, the PCT system required a certain mechanism to deliberate what kind of intelligence should be established to contemplate on current PCT issues by identifying real reasons behind the scene. Under that mechanism, it was important to see what kind of data would be further needed and to share the intelligence among Contracting States. Second, great importance needed to be given to having a common understanding of how the PCT intelligence was important to PCT Kaizen and it was vital to maintain such intelligence. It was not solely the responsibility of the International Bureau to create and maintain PCT intelligence. Nor was it the intention to burden Contracting States by asking for data while waiting for information to be furnished. Nevertheless, the Delegation hoped that the Working Group would understand that the cooperative management approach in PCT Kaizen as being indispensable to achieving the utmost effectiveness and efficiency of PCT operations.

42. The fifth proposal involved creating IT infrastructure conducive to PCT Kaizen by development of the Global Dossier. The Global Dossier was aimed at further integrating and sharing application and examination information maintained by each Office and providing various services in a unified manner. One example was building a common user interface that enabled dossier information at the international phase and at the subsequent national phase in various countries to be displayed on one portal site through a dossier access system that provided seamless and instant access to information base on using ePCT. Since the Global Dossier was also part of the Expanded PCT 20/20 proposals by the Delegations of the United Kingdom and the United States of America (see document PCT/WG/6/14), the Delegation of Japan proposed to make a joint effort on the integration of the Global Dossier into a common IT infrastructure in the PCT system.

43. In conclusion, the Delegation hoped that through active discussion, the Working Group could develop an understanding of how to improve the PCT system. The five proposals could be refined and new proposals could be made by Contracting States based on the PCT Kaizen concept. Finally, the Delegation underlined its willingness to contribute to the discussions towards achieving a truly attractive PCT system for users worldwide.

44. The Delegation of the European Patent Office stated that it welcomed the PCT Kaizen proposal and that it had been following these concepts with interest for some time. The Delegation further stated that the European Patent Office was also keen to strengthen and optimize the PCT system as a whole. The European Patent Office had developed the proposal for a PCT Metrics Framework with the aim of generating a solid statistical overview of PCT products and procedures. The Delegation stressed that a vigorous statistical approach was essential to better understand the functioning of the PCT system. For this reason, the European Patent Office was committed to working further with other International Authorities and the International Bureau on establishing the PCT Metrics Framework. This would facilitate greater understanding of how the PCT system was functioning and provide common datasets to support discussions between Offices and help to identify areas where improvements would be desirable and thus establish a basis for efforts to enhance PCT services and products. When embarking upon a project generating statistics, the availability of data needed to be investigated. Not only did such a step indicate which metrics could be produced using data resources, but it also helped to identify areas where efforts could be made to enhance the data collection in the future. Therefore, gaining an understanding of data availability was key. The PCT Metrics Framework initiative therefore had many similarities with the PCT Kaizen proposal, and the European Patent Office looked forward to collaborating with the Japan Patent Office on developing these concepts in the future.

45. The Delegation of India expressed interest in PCT Kaizen and indicated its intention to reflect on the five specific proposals for the next session of the Working Group.

46. The Delegation of El Salvador congratulated the Delegation of Japan on the PCT Kaizen concept which could provide excellent results in the Working Group. The Delegation stated that it shared the PCT Kaizen philosophy and that the National Center of Registries in El Salvador had ISO 9001 certification.

47. The Delegation of Israel stated that the Israel Patent Office recognized the importance of improving the quality of search and examination in the international phase, adding that providing feedback to examiners from the designated Office would achieve this aim. In addition, attention needed to be given to improving the quality of work products with respect to formal requirements in the international phase. Concerning the proposal to promote the linkage between the international phase and the national phase, the Israel Patent Office acting in the capacity as an International Searching Authority widely applied the practice under PCT Rule 41.1 of taking into account the results of an earlier search, and provided for a refund of 50 per cent of the search fee on request of the applicant. The Delegation further stated that it also supported the establishment of work products that used wording that was understandable to designated Offices and applicants.

48. The Delegation of the United States of America stated that it was encouraged by the general nature of the forward-looking proposal from the Delegation of Japan and agreed that achieving a higher level of quality and optimization of PCT processes was a theme that should continue to be pursued. The Delegation welcomed the document as complimentary to the discussions on the future vision of the PCT as contained in the PCT 20/20 proposal from the United Kingdom and the United States of America, noting that many of the specific proposals set forth in the PCT 20/20 proposal would contribute directly to achieving the goals set forth in the PCT Kaizen paper. While welcoming these proposals in general, the Delegation queried the extent to which Offices would be expected to modify their processes and systems so as to adopt the specific Plan-Do-Check-Act business model set forth in the Kaizen paper. Furthermore, the Delegation noted that much of the substance of the five proposals contained in the document was of a general nature, and questioned whether the Japan Patent Office had more concrete examples of the types of actions

they would propose to be taken under the concept of Kaizen. With regard to the specific proposals, the Delegation was encouraged by the indication of support from the Japan Patent Office for the ongoing efforts for collaborative search and examination and for the supplemental search system. In relation to data collection, the Delegation agreed with the statement in paragraph 5 of Annex III to the document that it was necessary to strike a good balance between the labor required to collect the information and benefits to be gained from such information, adding that, when data were collected, it should be clear how the data would improve the PCT system as a whole.

49. The Delegation of China generally supported the PCT Kaizen proposals, to the extent that they did not affect the national phase procedures. The Delegation stated that it was especially interested in suggestions to make the system more efficient and attractive for applicants and other users, such as improving quality of international products, increasing basic information designed for analyzing and improving the PCT process. The Delegation stated that it was indicated interested in future collaboration with the Japan Patent Office on these ideas.

50. The Delegation of the United Kingdom supported the overall vision for PCT improvement presented in the PCT Kaizen paper. The Delegation welcomed the development of these proposals, which would complement other proposals on PCT improvement so that the proposals could successfully complete their aims.

51. The Delegation of Austria thanked the Delegation of Japan for their comprehensive document. In referring to the proposal to create a feedback framework from the designated Office to the International Searching Authority, the Delegation suggested exploring the possibility of integrating the Office of First Filing into the framework. As the source of many applications in the PCT, the applicant already had the possibility to furnish the results of search and examination at the Office of First Filing to the International Searching Authority. The Delegation therefore suggested enabling the International Searching Authority to communicate feedback to the Office of First Filing, thereby enabling the Office of First Filing to use the results of international search as it wished in its national procedures, stressing that the use of these results should remain discretionary. This would contrast with the feedback from the designated Office to the International Searching Authority taking place after national phase entry at 30 months when the Office of First Filing would normally have completed processing on the application.

52. The Delegation of the Republic of Korea appreciated the document and agreed that, in order to incorporate the results of the international phase with those of the national phase, the results of the national phase should be fed back to the International Searching Authority and other Offices should share them. To this end, an electronic interface and common format needed to be established in advance and how to analyze the feedback should be studied. There was also a need for flexibly applying each scope and methodology. Further, as providing an opportunity for the applicant to submit their opinions on international search reports established in the international phase, the Delegation believed that, when it came to utilizing the results, it might be desirable that statistics and cases are analyzed and ways to promote utilizing the results of any search are commonly agreed. Finally the Delegation agreed on the idea to create an electronic forum for sharing opinions for strengthening the linkage between the international phase and the national phase, as set out in paragraph 23 of the document.

53. The Delegation of Australia agreed with the statement set out in the document stating that high quality international search and preliminary examination reports were the cornerstone of the PCT system. In relation to feedback frameworks outlined in paragraph 11 of the document, the Delegation of Australia believed that feedback needed to be detailed and structured to enable International Authorities to identify easily any systemic issues around their work. The Delegation supported the development of the Global Dossier and perceived synergies between the project and the PATENTSCOPE, ePCT and the WIPO Centralized Access to Search and Examination (CASE) systems, pointing out that the open architecture principles of the Global Dossier would enable linkage with other initiatives, such as WIPO CASE.

54. The Delegation of Brazil commented that the proposals concerning measures to improve the linkage between national and international phases in the PCT should be discretionary for national Offices, and further discussion was needed to find the right remedy for implementing this proposal. In relation to the Global Dossier, the Delegation expressed the view that the proposal appeared to encroach on the autonomy of national Offices who should be able to decide how best to take advantage of international work products under the PCT. Moreover, it was the prerogative of national Offices to decide whether or not to engage in collaborative examination projects, which would not be case if the Kaizen project were applied as it had been presented, adding that there was no multilateral instrument on this subject. The Delegation also pointed out that PATENTSCOPE could be used for sharing patents and related documents. The Delegation therefore could not perceive a significant gain to be achieved by creating another tool with a similar aim.

55. The Delegation of Mexico stated that its national law on intellectual property permitted the Mexican Institute of Industrial Property to accept a substantive examination done by foreign patent offices, but this was discretionary in nature and non-binding. With respect to the proposal to promote the linkage between the international phase and the national phase, it was therefore necessary to try to identify the legal means for including this kind of clause.

56. The Representative of the Japan Intellectual Property Association (JIPA) welcomed the proposal from the Delegation of Japan and especially supported collecting and increasing intelligence in the PCT system because in general, in order to implement an effective quality control program, data had to be collected and analyzed. In addition, JIPA desired such intelligence to be open to users in order to discuss issues based on collected and analyzed intelligence. Further, JIPA hoped that many International Search Authorities and designated Offices would cooperate with one another and that work products of the international phase would be able to be utilized more effectively. JIPA also expressed interest in participating in further discussions as a user.

57. The Representative of the Japan Patent Attorneys Association (JPAA) expressed strong support for the PCT Kaizen proposal, emphasizing that improving the quality of international search was the most important matter to achieve reliable results from the perspective of the PCT applicant.

58. The Representative of Third World Network expressed concern that PCT Kaizen had the potential to lead to harmonization of substantive law in an indirect manner.

59. The Representative of the American Intellectual Property Law Association (AIPLA) stated that, as the PCT was a procedural treaty, there were fair concerns about the effect of proposals on the substantive law of individual States. However, from the broader perspective, the growth of the Global Dossier in the IP5 plurilateral coordination should not need to be considered as a vehicle to enforce harmonization which many States did not want to see. In underlining the frustration when a search conducted in one State appeared to have no effect with respect to other States, the Representative believed that the PCT Kaizen proposal deserved careful consideration because it reflected a plurilateral trend in many patent jurisdictions which could have spillover effect. The Representative believed that WIPO needed to maintain itself in a position to keep up with plurilateral developments and be conscious that many Offices were on a trend towards harmonization, even if it was probably not correct to say that the PCT Kaizen approach would lead to substantive law harmonization.

60. The Chair summarized the key points of the discussions. Most delegations had congratulated the Delegation of Japan for their thoughtful paper on future development of the PCT and supported its general direction. A number of delegations had indicated that the PCT Kaizen paper and its approach to quality and sharing of work were consistent with the betterment of the PCT. There were, however, some concerns raised that the ideas and notions within the paper were general and needed to become more specific or targeted at a later stage to address how the

effects within the Kaizen paper would be realized. Acknowledging the concerns that had been raised as to whether the Global Dossier and the sharing of search and examination work between countries constituted substantive law harmonization by stealth, the Chair did not believe this to be case. Instead, the document described efforts by independent International Search and Examining Authorities to collaborate and share work to facilitate the difficult job of searching and examining patent applications, noting that relevant prior art was published in many different languages. Moreover, none of the specific PCT Kaizen proposals abrogated the responsibility and the right of each national office to apply the laws, practices and procedures of its jurisdiction as was appropriate. Finally, the Chair did not consider that the Global Dossier and providing access to the work of other Offices was an inappropriate action under the PCT, but acknowledged the other views from interested parties that had been expressed on this issue.

61. The Delegation of Japan thanked delegations for their positive comments on the PCT Kaizen proposal. With regard to the proposal for promoting the linkage between the international phase and the national phase, the Delegation stated that the goal of the proposal was to set up a framework to utilize the work products of the international phase based on the premise of the non-binding and preliminary nature of the international work products; the intention was not to import mandatory utilization of international work products. The Delegation concluded by indicating its intention to consider the proposals further, taking into account the comments raised by delegations in order to present more concrete proposals at future sessions.

62. The Working Group noted the proposals outlined in document PCT/WG/6/14 Rev. and invited the Delegation of Japan to take into account the comments made, to discuss issues further with interested parties, to merge proposals with ones of a similar nature made by other delegations where possible, and to submit more concrete proposals to the next session of the Working Group.

EXPANDED PCT 20/20 PROPOSALS

63. Discussions were based on document PCT/WG/6/15.

64. The Delegation of the United Kingdom introduced the document by stating that, by working together with the Delegation of the United States of America, it had prepared an expanded version of the PCT 20/20 proposals for further improvement of the PCT system that had been presented to the fifth session of the Working Group (document PCT/WG/5/18). The Expanded PCT 20/20 proposals took into account comments made by delegations at the fifth session of the Working Group, the responses to revised proposals in Annex II to Circular C. PCT 1364 dated December 20, 2012, and the discussions at the twentieth session of the Meeting of International Authorities in February 2013 (see paragraphs 52 to 102 of document PCT/MIA/20/3). The Delegation acknowledged that support had been expressed for a number of the proposals. Document PCT/WG/6/15 provided further brief discussion on all the PCT 20/20 proposals, some of which were the subject of separate documents at this session of the Working Group.

65. The Delegation of Mexico commented that the Mexican Institute of Industrial Property already applied a fee reduction of 50 per cent for national applications from natural persons, micro industries, public and private higher education institutions and scientific research centers from the private and public sectors. The Delegation added that the proposals for standardized fee reductions for national stage applications would be incompatible with its national legislature as the entity for deciding on fees. Applying an extra 50 per cent discount as proposed in paragraph 16 of the document over and above existing reductions was considered to be too much of a discount.

66. The Delegation of the European Patent Office thanked the Delegations of the United Kingdom and the United States of America for the revised proposals and had comments on two issues in the document. First, in relation to limited Chapter I amendments, the Delegation of the European Patent Office indicated that a number of concerns had been raised with respect to changes in claim numbering which might potentially affect the disclosure of the application, as

indicated in paragraph 57 of document PCT/MIA/20/14. The Delegation underlined that such amendments should be considered by a substantive examiner under Chapter II or upon entry into the national phase, rather than by formalities officers at the level of the receiving Office. In addition, the Delegation had concerns with respect to the proposed modification of Rule 20 since a replacement, in the view of the European Patent Office, could be considered as an amendment which should only be allowed by a substantive examiner under Chapter II or during the national phase. Second, in relation to the part dealing with the integration of national and international phases, the European Patent Office was supportive of these efforts as offering huge potential for improvement of the PCT system. The Delegation strongly believed in the recognition by a designated Office of its own work performed as an International Searching Authority when the international application entered the national phase. The Delegation therefore questioned the absence in the document of this idea, which had been included in the original PCT 20/20 document as a proposal that the selection of an International Searching Authority would also be deemed a national phase entry in that Office with the international search report and written opinion constituting both the international work product and national Office first action, but was not subject of a separate proposal at this session of the Working Group.

67. The Delegation of the United States of America responded to the comments raised by the European Patent Office. In relation to the integration of national/international phases, the Delegation explained that document PCT/WG/16 discussed in more detail the idea of requiring a response from the applicant to negative indications by the International Authority when entering the national phase, adding that this had been identified by the Meeting of International Authorities as one of the proposals in respect of which it was hoped that fast progress could be achieved in the Working Group (see paragraph 101 of document PCT/MIA/20/14). By contrast, the proposal under which the selection of an International Searching Authority would also be deemed to be a national phase entry in that Office would require further consideration. As for the third item on integration of the national and international phase, namely, the International Searching Authority using a national action on a similar set of claims in a parent application or family member when adopting the international search report, the Delegation believed that many Authorities already followed that practice and that it had decided not to further pursue this proposal at this time. With regard to claim renumbering under Rule 91 which would then be taken up by the International Searching Authority, the Delegation acknowledged the comments made by the European Patent Office on limited Chapter I amendments and stated that it would take these comments into account with a view to presenting more refined proposals at the Meeting of International Authorities in 2014.

68. The Delegation of Japan thanked the Delegations of the United Kingdom and the United States of America for their contributions to improve the PCT system. As stated in the PCT Kaizen proposal, the Delegation acknowledged the importance of continuously improving the PCT system to make it more user-friendly and looked forward to further refining the proposals through constructive discussion among Contracting States and users.

69. The Delegation of South Africa questioned the rationale behind allowing the replacement of entire sets of a description, claims or drawings and wondered how it could be ensured that the scope of the invention would not be widened. Furthermore, since the Companies and Intellectual Property Commission in South Africa did not perform substantive examination, the Delegation had difficulties with the idea of integrating the Patent Prosecution Highway into the PCT.

70. The Delegation of the United States of America, responding to the questions raised by the Delegation of South Africa, stated that, with regard to the replacement of parts of the application, the problem arose from applications filed electronically, where fewer internal checks appeared to have been performed. In order to remedy such situations, applicants attempted to use incorporation by reference to provide the correct parts, resulting in an International Searching Authority having an application that contained multiple sets of claims. The issue hinged on incorporation, the subject of document PCT/WG/6/20 to be discussed during the session.

71. The Delegation of India thanked the Delegations of the United Kingdom and the United States of America for their revised proposals, but expressed concern regarding the integration of the Patent Prosecution Highway into the PCT for fast-tracking national phase applications. The Delegation understood the aim of the PCT to be to facilitate the filing of a patent application by assisting an applicant seeking protection in multiple jurisdictions to decide whether to pursue an application at a national level based on the international search report and international preliminary report on patentability. The reduction of backlogs in Offices by avoiding duplication of search and examination of patent applications and expediting the grant of applications in the national phase was not a stated objective of the PCT. The Delegation therefore believed that the proposal to integrate the Patent Prosecution Highway into the PCT went beyond the objectives of the PCT. Finally, the Delegation requested the Secretariat to compare elements in the Expanded 20/20 Proposals with those in the PCT Kaizen document to integrate them into a document for the next session of the Working Group.

72. The Delegation of Brazil stated that, regarding limited Chapter I amendments, corrections to the claims during the national phase should be attached to the original text of the claims, thereby allowing Offices to be able to evaluate better whether the corrections were acceptable.

73. The Delegation of Sri Lanka stated that more time was need to evaluate the ideas in the proposal and suggested that it could be refined for consideration at future sessions of the Working Group.

74. The Working Group noted the contents of document PCT/WG/6/15. Further comments by delegations on specific proposals set out in the document are included under other agenda items.

MANDATORY RESPONSE TO NEGATIVE COMMENTS IN THE NATIONAL PHASE

75. Discussions were based on document PCT/WG/6/16.

76. The Delegation of the United States of America introduced the document, which proposed to amend the Regulations under the PCT by adding new Rules 51*ter* and 76*bis* as set out in the Annex to the document so as to require applicants, when entering the national or regional phase, to submit a response to any negative comments made during the international phase. By requiring a response to negative comments, the proposal aimed to reduce the amount of duplicative work performed by national and regional Offices acting as designated/elected Offices, thereby promoting the advancement of the prosecution of the international applications in the national and regional phase and increasing the overall efficiency of the PCT system. The Delegation commented that applicants often entered the national phase with either the same claims that were originally filed in the international application or those claims which were amended under Chapter II, often without submitting any remarks or amendments directed to overcoming the objections set forth in the international phase work product. This behavior was considered by the Delegation to trivialize the work performed by the International Searching and Preliminary Examining Authority, resulting in unnecessary duplication of work by national and regional Offices, thus delaying the prosecution of the application and the issuance of a valid patent. Instead, the Delegation believed that work at each stage of an international application should build upon and further the progress made in the previous stage. In this regard, the Delegation provided the example of the European Patent Office, which had already unilaterally implemented a similar idea to the proposal by requiring a mandatory response to negative comments for regional phase applications where the European Patent Office had served as the International Searching or Preliminary Examining Authority. This example had had a significant and positive effect on European regional phase filings, with an almost fivefold increase in the percentage of applications with amended claims when entering the European phase, and a doubling of the percentage of applications which could be granted on first action.

77. The Chair clarified that the proposal had two main aims, namely, to give full value to the work performed in the international phase, and to place the designated/elected Office in a better position when examining an application in the national phase under its own substantive laws. Referring to the proposed amendments to the Regulations, the Chair stressed that imposing a sanction on an applicant for failure to submit a response to negative comments was not a requirement under the proposal. Instead, the proposed Rules provided for this possibility at national phase entry where an Office considered this appropriate for its national approach.

78. The Delegation of the Republic of Korea supported the rationale behind the proposal but queried whether a designated Office would be able to impose a sanction without inviting the applicant to submit a response.

79. The Delegation of the United States of America, responding to the question from the Delegation of the Republic of Korea, stated that paragraph (c) in proposed Rules 51*ter* and 76*bis* intended to give the applicant an opportunity to submit the required response before imposing a sanction, drawing parallels with other provisions in the PCT, such as the filing of declarations where the applicant was provided with an opportunity to submit any missing item.

80. The Delegation of Sweden stated that it fully supported the proposal.

81. The Delegation of Canada supported the proposal and the advancement of the prosecution of international applications in the national and regional phase, and agreed that the proposals would help reduce duplication of work at designated/elected Offices. As implementation of the proposal would require amendment to national laws which would take some time, the Delegation enquired about adding a notice of incompatibility to deal with transition periods. The Delegation also suggested providing for the possibility of demanding a fee prior to imposing any other type of sanction, with such a fee being requested at the same time as inviting the applicant to furnish the response to the negative comments. In this way, the Office would be able to cover administration costs for issuing any invitation to the applicant to furnish the response. Furthermore, the applicant would have an incentive to provide the response to objections on entering the national phase rather than waiting for the invitation.

82. The Delegation of Germany expressed concern that the sanctions provided for in the proposal might impinge on the sovereignty of national laws. The Delegation therefore proposed adding a phrase, such as "... if the national law provides for such sanction" in the text in paragraph (b) of proposed Rules 51*ter* and 76*bis*.

83. The Delegation of Singapore stated that it was generally supportive of the principles behind this proposal. However, under the national law in Singapore, after national phase entry, applicants had a number of options available to them, including relying on the PCT international search and preliminary examination results with no need for further search or examination, or requesting for a fresh search and examination to be done without relying at all on the PCT international search and preliminary examination results. For the latter, as the applicants had decided not to rely on the PCT international search and preliminary examination results, the Delegation was of the view that the applicants should not be required to respond to any outstanding objections raised during the international phase, i.e. any response should not be mandatory.

84. The Delegation of South Africa stated that, as a non-examining Office, the Companies and Intellectual Property Commission would not be able to make use of a provision to require a mandatory response to negative comments in the international phase, and was therefore not able to make such a response mandatory for applicants.

85. The Delegation of the European Patent Office supported the proposal in principle in that it strengthened the PCT in the sense that the PCT work products would be considered in the national phase. As set out in the document, the European Patent Office had such a system in place since 2010, but the mandatory response only covered work where the European Patent Office had acted

as the International Searching Authority or the International Preliminary Examining Authority. The Delegation stated that it could only support this proposal if it were limited to international work products performed by the same Office, leaving it to designated Offices to decide whether or not they would require a mandatory reply when the international work product was issued by another Office. In the latter situation, the European Patent Office performed a supplementary search when the application entered into the regional phase and that, when issuing the report of this supplementary search, the international search report and written opinion were attached and a mandatory reply was required. Adding the further requirement to respond to negative objections when entering the national phase would therefore mean an applicant would have to reply twice. In terms of draft Rules 51*ter* and 76*bis* set out in the Annex to the document, the Delegation stated that, under the system at the European Patent Office, the scope of the negative statements in the written opinion which required a response went beyond Article 33 and included negative statements on clarity and support as well as formal objections. In particular, the Delegation considered it a benefit if applications faced with clarity and formal objections set out only in the written opinion had to be amended to overcome these objections when entering the national or regional phase. As to the response required from the applicant, the Delegation cited its own negative experience that applicants sometimes filed formal and minor amendments which did not really overcome the objections. The Delegation believed that this problem could occur with the current drafting of the provisions in that the response needed to be an amendment to the claims which overcame the objections and/or a substantive argument which distinctly set forth the errors in the objections. In addition, the Delegation did not believe that it was appropriate to refer to "errors in the objections"; an applicant's disagreement with the examiner on a matter did not imply that there were errors. Finally, with regard to the sanction for failure to submit a response, the Delegation considered that the sanction and way to invite the applicant to submit a response should be left to the designated/elected Office under its respective national law, as suggested by the Delegation of Germany.

86. The Delegation of China stated that, while a reply to negative comments when entering the national phase was useful, it would be necessary to amend its national law to implement the proposal. The Delegation therefore indicated a preference for more flexible wording to provide the applicant an opportunity to reply to a negative written opinion from the International Searching Authority when entering the national phase, but such a reply should not be mandatory.

87. The Delegation of Denmark expressed the views of users in Denmark, who were divided on their support for the proposal, citing both advantages and disadvantages. Users stated that a time limit, such as six months, for submitting a response could be necessary when implementing a requirement for a mandatory response. Users also cited potential difficulties with making a response, given the diverse practices and rules in different countries and the impact on costs to the applicant in making different responses in various languages when entering the national phase.

88. The Delegation of Japan stated that a mandatory response to negative comments when entering the national phase merited discussion as a way to promote linkage in the PCT between the international and national phases, which was part of the PCT Kaizen proposal. The Delegation believed that the proposed amendments to the Regulations under the PCT were well considered in leaving the imposition of sanctions as an option, but that there would need to be further exchange of opinions from users and Offices before introducing the proposals into the PCT. In this regard, the Delegation drew the attention of the Working Group to the electronic forum that had been established to exchange information and discuss future measures that could be taken by Offices acting under the PCT and proposed that delegations could utilize this forum to share experiences and discuss other matters relating to mandatory responses.

89. The Delegation of Switzerland reiterated the reservations that had been expressed by the Delegations of Germany and the European Patent Office.

90. The Delegation of Chile stated that, like the Delegation of Switzerland, it shared the concerns that had been expressed by the Delegations of Germany and the European Patent Office, in particular with regard to the sanctions and compulsory nature of the implementation of the proposal.

91. The Chair, summarizing the interventions from members of the Working Group, acknowledged that there had been strong support for the preparation of the proposal, both in conceptual and practical form. Delegations had indicated that a mandatory response could be useful in specific instances, but should not necessarily be mandated in every national jurisdiction. Delegations had responded positively to setting out a high level approach in the Regulations under the PCT while balancing this with sovereignty under national laws, such as the suggestion by the Delegation of Germany to add in subparagraph (b) of the draft provisions that sanctions would only apply if the national law provided for such sanctions. This would therefore allow countries intending to impose sanctions for not furnishing a mandatory response to proceed under the auspices of the PCT while other countries not wishing to provide sanctions would be able to continue their existing practice. Referring to the drafting comments made by the European Patent Office, the Chair did not believe the text would permit the applicant to make trivial amendments, as there was a requirement to amend the claims to overcome the objections, and it could always be debated exactly what constituted a substantive argument. The Chair nevertheless supported the comments of the European Patent Office concerning errors in the objections and wondered whether an alternative softer wording could be found. The Chair also acknowledged the benefits of requiring a response on clarity and more minor issues under the practice at the European Patent Office but indicated that the proposal had been made at the highest level to include novelty, inventive step and industrial applicability only, and it would be for Member States to decide whether to extend the scope beyond these objections.

92. The Representative of the Japan Intellectual Property Association (JIPA) welcomed the proposal as improving the quality of work in the international phase and the national phase. Although the proposal was one method to promote the linkage between the international and the national phase, the Representative believed that it was premature to implement this proposal for several reasons. At the present time, the use of documents cited in the international search report in the national phase was not unified among the designated Offices. In the case of a designated Office with a policy of repeating the search from scratch, regardless of the result of work performed by the International Searching Authority, the mandatory requirement to respond to negative comments in the written opinion would only result in an increase in workload for applicants. It was therefore necessary for designated Offices to clarify their policy on the use of results from the International Searching Authority, as the European Patent Office had done in relation to work performed by a different International Authority. Moreover, the Representative considered that the significant and positive impact of a mandatory requirement at the European Patent Office depended on the implementation of such a policy, and it was questionable that the same effect would be achieved for all combinations of International Searching Authorities and designated Offices. In relation to the requirement to submit responses to overcome negative statements under Articles 33(2), (3) or (4), the Representative pointed out that the standards of industrial applicability were different among Contracting States, and that inventive step objections were often based on prior art decided in the national phase. Furthermore, by allowing each designated Office to determine the sanction it could apply against applicants failing to submit a response to negative comments, there could be the possibility for an Office to consider withdrawn any application that was based on a national phase entry of an international application. The Representative therefore strongly hoped that the nature of any sanction would be considered carefully and believed that it was unreasonable to mandate a response from the applicant to negative comments in all cases.

93. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) reminded the Working Group that its members were familiar with responding to negative comments when entering the regional phase before the European Patent Office, but this only applied to international searches that had been performed by the European Patent Office. From the discussions of the proposal, the Representative was not convinced that such a

requirement should be implemented in the Regulations under the PCT, noting the different granting procedures at different designated Offices. For example, some Offices did not examine applications, whereas at other Offices, examination could be deferred for up to five to seven years.

94. The Representative of the Asian Patent Attorneys Association (APAA) disagreed with the proposal and pointed out that the consideration of inventive step varied between International Searching Authorities. Negative comments made by one International Searching Authority could be positive comments in a different International Searching Authority. The Representative therefore believed that the applicant should have right to wait for a designated Office to make an inventive step determination before submitting a response to any inventive step indication made in the international phase.

95. The Representative of the Federation of Industrial Property Attorneys (FICPI) welcomed the integration of the international search with the examination in the national phase, especially where the work in the international and national phase had been performed by the same Office. However, where different Offices were involved, FICPI believed that integration would only be of benefit to the quality of the patent system if such integration were introduced once a top up and a collaborative search had been carried out in the international phase. Currently, the patent quality and the legal certainty with regard to the validity of a patent family member was derived not only from search and examination in the international phase, but also in considerable part by the independent or the often overlapping and duplicate search and examination work of the national Offices, which was also made available to the public. It would therefore be a regression of the existing quality in the patent system if, due to integration of the national and international phases, it became mandatory to rely on the work product of the international phase in its present form without top up and collaborative searches, replacing the often complementing or truly supplementary work of the individual national Offices. The Representative added that the relationship between the right available to the applicant under Article 28 to amend the claims of an application once and the mandatory requirement in the proposal to amend the claims of an application to overcome any objections was unclear.

96. The Representative of the All-China Patent Agents Association (ACPAA) stated that the examination of an application entering the national phase should be conducted based on national regulations within the framework of national laws. The requirement for the applicant to make a mandatory response to negative comments in the international phase at the time of entering the national phase would replace the first office action in the national phase, thereby interfering with national regulations. Theoretically, the proposal was therefore contrary to the non-binding nature of international work products. The Representative therefore concluded that it should not be mandatory for an applicant to reply to any negative comments in the international phase.

97. The Representative of Third World Network (TWN) had two objections to the proposal. First, from a conceptual framework, the proposal had been made on the incorrect assumption that the application of patentability criteria was uniform across International Searching Authorities. As well as enabling patent Offices to charge additional fees for applying sanctions, applicants from developing countries would, as a consequence, be burdened with making unnecessary responses when designated Offices relied on comments in the international phase. Instead, the patentability criteria needed to be judged in the national phase, giving each designated Office the opportunity to make its own objections that the applicant would then need to address. Second, the proposal would interfere with the non-binding nature of the work in the international phase. Referring to the Patent Prosecution Highway as a mechanism attempting to increase efficiency, the Representative pointed out that that this proposal could undermine efficiency as it put additional burden on the applicant.

98. The Representative of the American Intellectual Property Law Association (AIPLA) commended the Delegation of the United States of America for making the proposal, believing it to merit discussion and constructive comment. However, the Representative agreed with some of the concerns about the proposal that had been expressed by the Representative of Third World

Network. In particular, the different application of patentability criteria under national laws could have a negative impact on smaller businesses. For example, in the United States of America, it was possible to overcome an obviousness rejection by secondary considerations, often involving research or demonstrating improvement in sales, which took time to prove. An applicant from a small business would therefore find it more difficult to establish the evidence that would be admissible in a declaration in the United States of America to overcome an obviousness objection when entering the national phase. The possible imposition of sanctions could also be more problematic for small businesses, noting that the Delegation of Germany had made particularly appropriate points in this regard. Furthermore, since patentability criteria were applied differently around the world and many International Searching Authorities did not conduct searches for certain inventions that could be patented in the United States of America, it would be particularly difficult for an applicant to respond to comments made by the International Searching or Preliminary Examining Authority at each designated/elected Office when entering the national phase 30 months from the priority date.

99. The Chair summarized the points that had been made by the observer organizations. The first issue was that any requirement for a mandatory response was, in a sense, against the general objective of the international phase to provide a preliminary non-binding opinion on the application. The second issue was the differing ways that designated/elected Offices treated work done in the international phase, whether this had been performed by the same or a different Office. As an anecdote, IP Australia applied a similar approach to that applied by the European Patent Office, offering a fee reduction to applicants in the national phase where it had performed work in the international phase, reusing this work in full by in effect re-issuing the international report, but this was not consistently the case in other International Authorities, with some Offices *de facto* re-searching an application as soon as it entered the national phase. Another issue was that a mandatory response at national phase entry required applicants to deal with a whole range of national laws at 30 months and provide amendments and/or submissions for potential objections or issues without knowledge of the substance of such objections. This was different in the example of the European Patent Office because the applicant would already have received the objections requiring a response, but this did not apply to every jurisdiction. The final issue raised by observer organizations was that the costs for an applicant in the prosecution of an application could rise as the fees for engaging attorneys in various jurisdictions to respond to negative comments would be brought forward to an earlier stage of the process.

100. The Delegation of the United States of America thanked delegations for their comments, which it would take into account in further work on the proposal. However, the Delegation concluded that the proposal was not at a stage to be presented to the Assembly this year. In response to the concerns expressed by delegations about the nature of sanctions, the Delegation believed that the present wording in paragraph (b) of draft Rules 51*ter* and 76*bis* already addressed these comments, as it made it entirely optional whether national Offices wished to apply any sanction. One Office might decide to impose sanctions for not responding to negative comments, but for an Office that automatically re-searched an application, it would not be required to demand applicants to submit a response to negative comments raised in the international phase; instead, such Office could conduct the further search without any implications on national sovereignty. In this regard, the Delegation stressed that that the provision had been drafted with a view to leaving the utmost flexibility to Offices in its implementation. Finally, the Delegation acknowledged that several delegations had underlined the need to consult with users, and added that this had been part of the rationale for issuing Circular C. PCT 1364 in December 2012. The Delegation therefore invited delegations who had not already done so to consult with users in the coming year to be able to re-examine a revised proposal at the next session of the Working Group.

101. The Delegations of the United Kingdom and the United States of America indicated that they would take all comments made and concerns expressed into account with a view to presenting a further revised proposal at a future session of the Working Group.

FORMAL INTEGRATION OF THE PATENT PROSECUTION HIGHWAY INTO THE PCT

102. Discussions were based on document PCT/WG/6/17.

103. The Delegation of the United States of America introduced the document which proposed to amend the PCT Regulations and the Administrative Instructions to provide for expedited national phase processing through formal integration of the Patent Prosecution Highway (PPH) into the PCT. This had been one of the PCT 20/20 proposals from the United Kingdom and United States of America. Currently, under PCT-PPH programs, an applicant receiving a favorable written opinion or international preliminary report on patentability from an International Authority would be able to request that a corresponding national or regional phase application receive expedited processing and examination, provided that all claims in the national phase application sufficiently corresponded to the claims which had received a positive indication from the International Searching or Preliminary Examining Authority. The national Office could then use the international phase work products to streamline its own prosecution. The PPH had shown to provide benefits for Offices and applicants alike, including accelerated examination, a significantly higher allowance rate and a decreased cost of prosecution, resulting from the fact that PPH cases generally had fewer actions prior to allowance or grant and reduced pendency. Formal incorporation of the PPH into the PCT would obviate the need for many of the large numbers of agreements between individual Offices and help to standardize the differing PPH requirements, thus simplifying the requirements. In response to Circular C. PCT 1364 dated December 20, 2012, that contained revised PCT 20/20 proposals, including a specific proposal to amend the PCT Regulations to provide for PPH treatment for applicants entering the national phase under certain conditions, a majority of Offices and every user group which had responded to the Circular had expressed some level of support for the proposal. Further, the proposal had received widespread support from discussions at the twentieth session of the Meeting of International Authorities under the PCT held in Munich in February 2013. Therefore, on behalf of the United Kingdom and the United States of America, the Delegation submitted the present proposal to amend the PCT Regulations and Administrative Instructions as set forth in the Annexes to the document for consideration by the Working Group.

104. The Delegation of Brazil stated that it looked forward to the Working Group discussing the experience of the Patent Prosecution Highway, developed by patent Offices in bilateral and plurilateral settings, and commended the efforts made by the proponents to consult a broad base of stakeholders through Circular C. PCT 1364. The Delegation recalled that inclusiveness was one of the underlying rationales of the Development Agenda. The alleged benefits of the PPH incorporation singled out by the proponents, among them accelerated examination, a significantly higher allowance rate, a decreased cost of prosecution and reduced pendency based on the experience of implementation of a group of patent Offices, needed to be fully fleshed out so as to address concerns raised in the debates of the Working Group or pointed out in response to the Circular. Indeed, it was necessary to take into account the diversity of the legal frameworks and the resources of patent Offices in developed and developing countries, independent of whether they were International Searching or International Preliminary Examining Authorities. The possible impact on Offices in terms of cost relating to human and technological resources also needed to be looked at. In the same manner, due consideration had to be given to the comparative benefits to be reaped by resident and non-resident applicants, and large, medium and small enterprises, given the broad impact and scope of the proposed amendment. One fundamental issue that needed to be considered in the integration of PPH into the PCT was the work done by the International Searching or International Preliminary Examining Authority, where the experience of more than three decades of the PCT and discussions in the Working Group had shown that quality remained an issue. If the PPH were to rely on the results of work performed under Chapter I or Chapter II, it would be necessary to assess all International Authorities to ensure they were able to deliver work of consistent and reasonably-uniform quality. Furthermore, it needed to be borne in mind that the incorporation of the PPH into the PCT, even as a normative set of rules, was a substantive change in the nature of the Treaty, as its scope would be extended to the national phase, thereby influencing the process of examination of patent applications by national Offices. This was

highlighted in paragraph 16 of the document, where the issue of preservation of sovereignty was discussed in the context of granting patents. This issue was not a small one, and it needed to be considered not only in its legal dimension but also in terms of how the PPH rules would be implemented. Given that formally integrating the PPH into the PCT was a substantive change to the nature of Treaty, the Delegation believed that an amendment to the Regulations would not suffice, nor would it be legally correct, as the substantive activities of Offices in the national phase would be affected. In order to implement the integration of the PPH into the PCT, it was therefore necessary to convene a diplomatic conference under the procedure in Article 60.

105. The Delegation of India highlighted the concerns it had previously expressed on the formal integration of the PPH into the PCT, pointing out the differences in patent law and practices across jurisdictions, adding that patent law was specific to a country and that the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) allowed for certain flexibilities. With this in mind, the proposal to integrate the PPH into the PCT could be perceived to be an attempt to harmonize the examination of patent applications in different countries by encouraging the reuse of work done in the international phase without undertaking further examination of the application in the national phase, as one aim of the proposal was to accelerate the examination process and reduce pendency. Moreover, the Delegation was concerned that, by granting patents hastily by accelerating the examination process and thereby reducing the pendency times, the consistency in the quality of patents could be compromised. The Delegation therefore urged caution in amending the PCT Regulations to fast track integration of the PPH into the PCT. It was also important to bear in mind that membership of the PPH was voluntary and it should not be binding on other countries to accept an international report for the sake of accelerating the examination process.

106. The Delegation of Canada stated that the Canadian Intellectual Property Office continued to benefit from various PPH agreements. The Delegation referred to a non-paper that it had submitted with regard to the proposed change to the Regulations, allowing Offices to be able to suspend with notice the application of the PCT-PPH at its Office due to workload constraints. Approximately 80 per cent of national patent applications at the Canadian Intellectual Property Office originated from the PCT; so acceleration of even a portion of these applications could have a large impact on the workload, resulting in non-accelerated applications not being examined in a timely manner. The suspension would be intended to be a temporary measure, which could be lifted once an Office was able to deal with the influx of cases. The Delegation also pointed out that patent law in Canada had certain national phase requirements external to the PPH, such as the application needing to be open to public inspection and the applicant having to request examination prior to acceleration taking place, which should be taken into account in the Administrative Instructions. Finally, the Delegation underlined that for the applicant to benefit from expedited processing, the claims in the application should sufficiently correspond throughout the course of examination to those indicated as having novelty, inventive step and industrial applicability in the request for expedited processing.

107. The Delegation of Japan supported the proposal in principle, having implemented PCT-PPH arrangements with many other IP Offices.

108. The Delegation of the European Patent Office supported the proposal in principle, seeing benefits for applicants and Offices alike. First, as far as applicants were concerned, they would benefit from equal treatment with any other applicants benefitting from acceleration schemes at the designated Office. For example, the European Patent Office had a scheme for accelerated prosecution of both Paris-route and PCT applications known as the "PACE" program. In practice, this had little effect on the workload as only 5 per cent of users requested the accelerated procedure. Second, Offices had the potential to reduce backlogs by taking into consideration international search and preliminary examination reports. The Delegation pointed out that the European Patent Office, along with other International Authorities, was intensively working on enhancing the quality of PCT work products, particularly in the framework of the Meeting of International Authorities, to ensure that search work might indeed be reduced if a designated Office

so wished. With respect to some concerns that had been raised, the proposal already allowed for flexibility by having an opt-out provision should national laws not be compatible with the proposed scheme. However, the Delegation referred to ongoing work in the Patent Prosecution Highway Working Group to coordinate, streamline and harmonize the PPH participation and eligibility requirements as well as practices under the PPH. The Delegation also considered that the proposed Rules and Administrative Instructions should be regarded as containing minimum requirements, thereby not restricting an Office's flexibility to design its own practice in a more liberal manner.

109. The Delegation of Australia supported the development of a truly plurilateral system which incorporated PCT work with consistent requirements between all member Offices as the most effective way of increasing the use of the PPH system. With respect to the specific proposals, the Delegation sought clarification on the phrase "prior to the start of processing" in the proposed Rules since this wording could limit availability of the system under practice at IP Australia. This practice required a PCT national application to enter the national phase as it exited the international phase, therefore giving the applicant only about five days from national phase entry to make any required amendments prior to the start of processing of the application. The Delegation therefore believed that the PCT-PPH should be available to all applicants, provided the requirements were fulfilled before examination rather than before processing, therefore allowing national phase amendments to be considered. The Delegation also questioned the binding effect the Administrative Instructions setting out the procedure for expedited processing would have since a request for expedited processing had to be made before any accelerated treatment. Finally, the Delegation underlined the importance of high quality international search in the process. To that end, it supported the mandatory recordation of search strategies, as discussed in document PCT/WG/6/19, as building confidence in the PPH.

110. The Delegation of Switzerland supported the proposal in principle, but as the Swiss Federal Institute of Intellectual Property did not examine inventive step in a patent application, it would not be able to offer the accelerated procedure. It would therefore be necessary for Switzerland to make a reservation of incompatibility with national law if the proposal were accepted.

111. The Delegation of the Republic of Korea supported the idea behind the proposal, seeing the benefits from the use of PPH. The Delegation did, however, have a concern about the structure of the relevant provisions since the requirement to meet the criteria of Article 33 (2) to (4) was in draft Rule 52*bis* whereas the necessity for all the relevant claims to be free of observations in Box VIII of the opinion or report was in Section 901 of the draft Administrative Instructions. Instead, the Delegation preferred both requirements to be together in Rule 52*bis*.

112. The Delegation of Israel generally supported the proposal as leading to increased worldwide work sharing between patent Offices. In addition, accelerated national processing of the international application with a positive international preliminary report of patentability could encourage applicants to amend applications in the international phase to overcome defects rather than filing amendments many times before the different national Offices. With regard to the proposed amendments to the Administrative Instructions, the Delegation proposed to add, at the end of Section 901(a)(i), the following sentence: "the application cannot file a request under the PCT-PPH on the basis of the international search report only".

113. The Delegation of South Africa stated that it would need to enter a reservation of incompatibility with national law if the proposal were accepted as the Companies and Intellectual Property Commission did not conduct substantive examination of patent applications.

114. The Chair summarized the feedback from members of the Working Group to the proposal. Concerns had been expressed, especially by the Delegations of Brazil and India, about the quality of national search and examination work which should not be jeopardized by expedited processing. However, there was general support for the proposal, noting that the Delegation of the European Patent Office had pointed to the flexibilities built into the draft Rules to allow only Offices wishing to

provide this type of approach to adopt a system of expedited processing. The possible impact on backlog and workload issues from expedited processing had been raised by the Delegation of Canada, which could affect some Offices. Nevertheless, there had been general support for moving forward, particular from delegations who considered it appropriate to implement a procedure in their patent systems.

115. The Delegation of the United States of America acknowledged the support from delegations and addressed the concerns that had been raised. The Delegation did not believe that the proposal affected the sovereignty of a national Office, or that the work of an International Authority would change from being non-binding in nature. The proposal was more of a bargain between applicants and Offices where both sides could benefit. By bringing into the national phase only claims that had been indicated to meet the Article 33 requirements by an International Authority, either in Chapter I or Chapter II, the application could be advanced and examined out of turn, and the Office would benefit, as these cases would normally have narrower and fewer claims to examine. However, the remainder of the examination procedure would not be affected in any way. With regard to the workload concerns expressed by the Delegations of Canada and Australia, the Delegation of the United States of America acknowledged the issue and could be supportive of a paragraph allowing for temporary suspension of expedited processing if such concerns were to materialize. With regard to the need for a notice of incompatibility with national law, the Delegation pointed to the possibility provided in paragraph (b) of the proposed Rules 52*bis* and 78*bis*. As for the comment made by the Delegation of Australia on the use of the phrase "prior to the start of processing" in the proposed Rules, the Delegation of the United States of America stated that it had attempted to use terminology that would be generic to facilitate implementation in designated/elected Offices. However, it would be willing to consider alternatives that would achieve the aim of requiring any amendments to the claims needed to be made to qualify for expedited processing to be submitted before the designated/elected Office had started search and examination of the application. With regard to the concerns expressed by the Delegation of the Republic of Korea about the provisions for acceleration being placed in the Administrative Instructions as opposed to the Rules, the Delegation of the United States of America pointed out that this had been done intentionally to give greater flexibility in amending the provisions if needed following any agreement in the Plurilateral PPH Working Group on a basic set of requirements to be fulfilled for all PPH agreements. Responding to the request by the Delegation of Israel to add a clause in Section 901(a)(i) of the Administrative Instructions to clarify that an international search report alone could not form the basis of a request for expedition, the Delegation of the United States of America agreed with the intention of the provision and added that a request should also not be based on a supplementary international search report. However, it considered that all the work products that could be used for a request were explicitly stated in Section 901(a)(i), i.e. the written opinion of the International Searching Authority, the written opinion of the International Preliminary Examining Authority and the international preliminary examination report. Nevertheless, the Delegation could consider adding that the international search report and supplementary international search report could not be leveraged for acceleration of the application. Finally, the Delegation disagreed with the view expressed by the Delegation of Brazil that a diplomatic conference needed to be convened to implement the proposal and an amendment to the Regulations under PCT would not suffice, especially as the proposals provided States with the option to file a notice of incompatibility, but requested the Secretariat to provide some objective thought on this matter.

116. The Secretariat, responding to the question about the necessity to convene a diplomatic conference, stated that while it may be able to develop an opinion on the matter, an answer to this question would need to be determined by Member States based on their perception of how the issue was evolving in terms of the proposal going beyond the scope of what could be dealt with in the Regulations. One of the principles behind the PCT was for Offices to benefit from an international search and optionally an international preliminary examination when examining a patent application under its national laws. In other words, the national Office could take advantage of previous non-binding work produced in the international phase, rather than searching and examining an application from scratch. The PPH had a similar basic idea to this principle in that

previous work was taken into account by providing applicants meeting certain requirements with a head start when processing their applications. Importantly, the PPH did not propose to change the non-binding character of work performed in the international phase; on the contrary, Offices applying PPH agreements conducted a full substantive search and examination under their respective national laws taking into account the results from the Office of first examination. Therefore, as there was no change in the PCT system beyond the accelerated processing of certain applications in the national phase, the Secretariat did not consider this to be a dramatic change in the nature of the PCT to require amendment to the Treaty itself. However, the Secretariat was willing to consider this matter and reiterated that Member States would have to decide whether a more substantial change beyond amending the Regulations would be necessary to implement the proposal.

117. The Delegation of Brazil recalled that the process of discussion should be guided by the relevant recommendations from the Development Agenda, especially recommendation 15, namely: “Norm-setting activities shall: be inclusive and member-driven; take into account different levels of development; take into consideration a balance between costs and benefits; be a participatory process, which takes into consideration the interests and priorities of all WIPO Member States and the viewpoints of other stakeholders, including accredited intergovernmental organizations (IGOs) and non-governmental organizations; and be in line with the principle of neutrality of the WIPO Secretariat.” The Delegation was emphasized that it was unable to support an approach that would introduce the PPH procedure into the PCT system affecting more than 140 Member States based on bilateral arrangements which had been negotiated outside of the PCT system between around 20 Member States, and stressed that WIPO was a member-driven Organization. There was therefore a need for a thorough debate about what these changes would entail to the Organization and the PCT.

118. The Representative of the Japan Intellectual Property Association (JIPA) stated that it expected the proposal to realize the user benefit of the current system with more simplified and less costly procedures.

119. The Representative of the Asian Patent Attorneys Association (APAA) generally supported the proposal and provided a suggestion to amend the wording “prior to the start of processing” in the draft Rules to “prior to the start of processing and/or examination”, which could address the concerns that had been raised by the Delegation of Australia. This wording could give an applicant flexibility in the countries where a request for examination was required separate from national phase filing and could also address the issue in countries such as Australia, where applicants had great difficulty to amend the claims prior to national phase entry. While this could deliver a two stage process in expediting an application in the national phase, this may not cause great difficulty and might overcome the concerns that had been raised.

120. The Representative of Third World Network (TWN) recalled the objections raised by observers on the issue of mandatory top-up searches. The Representative highlighted that judgment on patentability issues and practice differed between patent Offices. With this in mind, in the context of developing countries, it was important that patent quality should not be compromised in the interests of greater efficiency, as this could affect the lives of many people when considering the patenting of medicines. For example the Supreme Court of India, in a judgment dated April 1, 2013, rejecting an application for a patent by Novartis, had ruled that for pharmaceuticals, if the product for which patent protection was claimed was a new form of a known substance with known efficiency, the subject product, in addition to meeting the requirements of novelty and inventive step, had to pass a test of enhanced efficacy. This case was only applicable in India, and other jurisdictions could examine the question of patentability differently, and it was important to preserve this diversity. The Representative also emphasized that the PPH was a plurilateral body created outside of the multilateral framework. Integrating the PPH into the multilateral framework therefore required further deliberation beyond amendment of the Regulations in order to follow the standards of international law making in view of participation and ensuring transparency and accountability.

121. The Representative of Institute of Professional Representatives before the European Patent Office (EPI) supported formal integration of the PPH into the PCT for the advantages that had been expressed by other delegations. The Representative believed this could increase demands in Chapter II of the PCT, which could benefit both applicants and Offices. In addition, the Representative stressed the need for PCT work products to be of the highest possible quality. Finally, the Representative opposed the inclusion of a fee for demanding expedited processing, as this could be seen as discriminatory against small and medium-sized enterprises, universities and research centers.

122. The Representative of the American Intellectual Property Law Association (AIPPLA) joined other delegations in their support for the proposal, which would create a framework for the continued and developing use of the PPH for users and applicants. With regard to paragraph (a) in both draft Rules 51*bis*.1 and 78*bis*.1, the Representative suggested that the text “may, within the discretion of any national Office” could be substituted for the word “shall” to emphasize the voluntary nature of the program. The Representative added that integrating the PPH into the PCT could provide enormous benefit to an applicant in a developing country who would be able to obtain a patent quickly based on a favorable international preliminary examination report in participating countries.

123. The Chair summarized the points that had been made by the observer organizations. First, users of the system had expressed general support for the proposal, seeing the benefits of being able to expedite their applications based on the work done in the international phase where there had been an indication of a positive outcome for their application. There had, however, been some negative indications around the charging of additional fees to seek expedition of an application. It was also important that the quality of work in national Offices should not be degraded, nor should Offices depart from exercising their sovereignty by examining patent applications and granting patents under their respective national laws. The Chair believed that this would not be case, as the proposal clearly stated that quality of work in Offices would not be degraded, but rather the scheme assisted in improving the quality by bringing to the attention of the national Office work that had previously been performed on the application. Offices therefore had the possibility to undertake additional work to which had been conducted in the international phase. The Chair also did not believe that the proposal removed national sovereignty since Offices maintained the responsibility to search and examine applications, granting patents only to those inventions for patentable subject matter in the jurisdiction and fulfilling the requirements of national law in terms of novelty, inventive step, industrial applicability.

124. The Delegation of Japan explained to the Working Group that the PPH did not change substantive examination of patent applications, and referred to the PPH portal web site³, which contained further information on the PPH. The Japan Patent Office would be hosting a plurilateral PPH meeting in Tokyo in June 2013, where discussions regarding the standardization of PPH requirements would be conducted. The results of the meeting would be made available on the Japan Patent Office web site⁴.

125. The Chair concluded the discussion by suggesting that it might be useful if Offices participating in the plurilateral meeting in June 2013 be invited to prepare additional information elaborating on how the PPH worked for them, its real effects in terms of expediting applications and the quality of granting of rights, for the benefit of the entire membership of the PCT system.

126. The Working Group noted the intention of the United States of America and the United Kingdom to bring forward revised proposals and further information at the next session of the Working Group, taking into account the comments made and the concerns raised.

³ The PPH portal can be found on the Japan Patent Office web site at:
<http://www.jpo.go.jp/ppph-portal/index.htm>

⁴ http://www.jpo.go.jp/torikumi_e/t_torikumi_e/patent_highway_e.htm

MANDATORY TOP-UP SEARCHES

127. Discussions were based on document PCT/WG/6/18.

128. The Delegation of the United Kingdom introduced the document, submitted jointly with the Delegation of the United States of America, which proposed to amend the PCT Regulations and Administrative Instructions to make top-up searches a mandatory part of the Chapter II preliminary examination process. The Delegation thanked respondents who had provided comments and suggestions on the proposal outlined in Circular C. PCT 1364 dated December 20, 2012, noting the support Offices and users had expressed in response to the Circular and in discussions at the twentieth session of the Meeting of International Authorities in February 2013. Taking into account comments that had been received, the proposed amended Rule included a provision to allow the International Preliminary Examining Authority to decide not to perform a top up search if it considered that it would serve no useful purpose at that stage. This provision therefore provided a level of flexibility to the proposal, as some respondents considered that a top-up search might not be practical in all circumstances. In addition, the proposal included a notice of incompatibility if the Rule was not compatible with the national law applied by the International Preliminary Examining Authority. In addition, Annex II to the document proposed amendments to the Administrative Instructions to provide limitations to the top up search, and Annex III proposed amendments to the International Search and Preliminary Examination Guidelines to define the scope of the top-up search and circumstances when a top-up search may serve no useful purpose. The Delegation concluded by underlining that a mandatory top-up search in the Chapter II process would provide significant benefit to applicants, increasing the likelihood of applications satisfying the requirements of novelty and inventive step before entering the national phase, giving the potential for quicker grant and cost saving for the applicant, and reducing duplication of work by national Offices.

129. The Delegation of Australia supported top-up searching as part of the Chapter II examination process and stated that it could agree to this being mandatory, except where a top-up search would serve no useful purpose. The Delegation added that for discovering secret prior art, a top up search could efficiently been done by rerunning the previous search over the art which had been published in the intervening period. However, the Delegation asked for clarification with respect to draft Rule 66.4(a), which appeared to oblige the International Preliminary Examining Authority to perform a top-up search before issuing all opinions during international preliminary examination. The view of the Delegation was that the search for secret prior art should only need to be performed once during the Chapter II process, except under very exceptional circumstances.

130. The Delegation of Israel stated that the Israel Patent Office favored a flexible approach, giving International Preliminary Examining Authorities the option to perform top up searches and decide on the scope of top up-searches. In general, adoption of this proposal would increase the quality and the reusability of the Chapter II international work products in the national phase.

131. The Delegation of Canada supported the inclusion of the top-up search in Chapter II, noting the increase in quality that entailed from the discovery of secret prior art. The Canadian Intellectual Property Office was currently implementing a similar proposal for top-up searches, restricting the search to subject matter previously searched during Chapter I. Under the proposal at the Canadian Intellectual Property Office, a top-up search would be required for all claims where documents relevant to novelty or inventive step had not been found; it would be at the discretion of the examiner in respect of claims where such documents had been cited in the international search report.

132. The Delegation of Germany expressed its support for the proposal.

133. The Delegation of France stated that it was favorable to the proposal, as it would improve the quality of patents by better information on the prior art. The proposal had also been supported by users that had been consulted on a national level.

134. The Delegation of Norway supported the proposal.

135. The Delegation of Sweden supported the proposal.

136. The Delegation of the European Patent Office generally supported the concept of having top-up searches in Chapter II since it increased the quality of the international preliminary examination report before the application entered the national or regional phase. The European Patent Office had tabled a proposal at the Meeting of International Authorities in February 2013 setting out a voluntary approach for top-up searches in Chapter II, only requiring amendment to the International Search and Preliminary Examination Guidelines (see paragraph 7 of the Annex to PCT/MIA/20/11). However, although the proposal in the present document focused on amending the PCT Regulations to provide for a mandatory top-up search, it had some flexibility included in the draft by allowing Authorities not to carry out a top-up search if it would serve no useful purpose. In this context, the Delegation considered that the wording "serve no useful purpose" might be in need for harmonization between Authorities; Authorities should provide at least some explanation of how they would apply this criterion. In relation to the proposed Rule changes, the Delegation questioned the wording "prior art that may be relevant under Rule 64" in draft Rule 66.1*ter*, since intermediate prior art was only covered in Rule 64.3 and cited in Box VI of the written opinion of the International Searching Authority to draw it to the attention of the applicant. It was therefore not clear whether the top-up search should be limited to intermediate prior art or whether it should be wider in scope. The Delegation also considered that the wording "consider a top-up search prior to the establishment of the written opinion or the international preliminary examining report would serve no useful purpose, that Authority may decide not to perform a top-up search at that stage" in draft Rule 66.1*ter* (b) as being unclear, as it could be interpreted as being either prior to establishing a written opinion or prior to establishing the international preliminary examination report, or both. As an alternative, the Delegation proposed the following wording to put less emphasis on the timing of such a top-up search: "if the International Preliminary Examining Authority considers that a top up search as set out in paragraph (a) above would serve no useful purpose, that Authority may decide not to perform a top up search in the international phase". In connection with supplementary international search, the Delegation questioned that a top-up search may not be necessary when a supplementary international search report had been issued, as this might have discovered the relevant secret prior art. As for the proposed modifications to the Administrative Instructions, the Delegation pointed out that the proposed Section 618 more or less repeated the wording of draft Rule 66.1*ter*, with the addition of the words "shall be limited to". The Delegation therefore questioned whether this Section in the Administrative Instructions was intended to add anything further. In relation to the proposed modifications to the International Search and Preliminary Examination Guidelines, the Delegation questioned whether "secret prior art" in paragraph 19.21.01 was an established term. In relation to paragraph 19.12.02, the Delegation wondered why an invention might be searched in the Chapter II procedure but not in the main international search. Another issue pointed out by the Delegation was the phrase "serve no useful purpose" used in paragraph 19.12.03; the Delegation wondered whether, if the applicant did not file an amendment or filed amendments that did not overcome the objections where there were multiple novelty-defeating references, a top-up search would need to be performed. The Delegation considered that in this situation a top-up search could be delayed until the objections had been overcome to verify novelty and inventive step of the amended claims. Furthermore, the Delegation asked whether the examiner would need to record that a top-up search had not been performed in the international preliminary examination report, stating the reasons for not conducting the top-up search. Finally, the Delegation drew attention to the suggested modifications to the International Search and Preliminary Examination Guidelines it had proposed in Appendix I of the Annex to document PCT/MIA/20/11, which could be taken into account in taking the proposal forward.

137. The Delegation of the Nordic Patent Institute supported the proposal, and informed the Working Group that it was in the process of implementing a mandatory top-up search in Chapter II. However, the implementation would not be limiting the search to intermediate prior art. Instead, the scope of the top-up search would be left to the discretion of the examiner. The Delegation

agreed with comments from the Delegation of the European Patent Office in relation to the draft text in the Administrative Instructions and the International Search and Preliminary Examination Guidelines and stated that the wording could be revised to allow for more flexibility.

138. The Delegation of Japan believed top-up searches in Chapter II to be important but considered that further clarification was necessary in the drafting of the proposed amendments, especially regarding the scope of discretion for examiners.

139. The Delegation of China acknowledged that some International Authorities already conducted top-up searches under Chapter II and believed this would make the international search and preliminary examination procedure more complete. However, the Delegation preferred top-up searches to be optional, rather than a mandatory procedure.

140. The Delegation of the United Kingdom, responding to the comments made by delegations, clarified that the proposed amendment to Rule 66.4 was not intended to require more than one top-up search during Chapter II. The intention was that, when the International Preliminary Examining Authority issued a written opinion, Rule 66.1*ter* would apply, requiring a top-up search unless this search would serve no useful purpose, as stipulated in paragraph (b). In effect, if the top-up search had already been performed during the Chapter II procedure, an examiner might consider that a further top-up search would serve no useful purpose. The Delegation concluded by recognizing the significant support for the proposal; while a number of drafting issues had been raised in relation to the Administrative Instructions and International Search and Preliminary Examination Guidelines, these could be discussed at an appropriate stage in order to reach agreement and move the proposal forward.

141. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) supported the proposal.

142. The Representative of the Japan Intellectual Property Association (JIPA) believed that mandatory top-up searches would improve the quality of work products in the international phase. However, from the users' perspective, the Representative had concerns about possible delays and fee increases for international preliminary examination due to a mandatory top-up search, and expressed the desire that Authorities should issue high quality international preliminary examination reports in a timely and efficient manner.

143. The Representative of the American Intellectual Property Law Association (AIPLA) strongly supported the idea of a top-up search in Chapter II, emphasizing the increased legal certainty and quality in being able to uncover secret prior art. The Representative also urged Offices to take into consideration the concern expressed by the Representative of the Japan Intellectual Property Association (JIPA) about possible fee increases for a mandatory top-up search.

144. The Chair, in summarizing the discussions, stated that the proposal had received strong support from delegations and asked the Secretariat to work together with the Delegations of the United Kingdom and the United States of America to produce revised proposals in order to seek agreement on draft amendments to the Regulations that could be submitted to the Assembly for adoption this year. If agreement were reached in the Working Group, the drafting of the Administrative Instructions and International Search and Preliminary Examination Guidelines could then be examined further.

145. The Secretariat introduced a revised draft of the proposed amendments to the Regulations. The revised draft distinguished between the "secret prior art" as defined in Rule 64.3 from the "relevant prior art" in Rule 64.1 and evidence of non-written disclosures in Rule 64.2. The top-up search would primarily be directed to the secret prior art, but would not exclude any other prior art that had not been available to International Searching Authority at the time of the international search. The revised draft also clarified the conditions when a top-up search could be considered to serve no useful purpose where the top-up search should be omitted or limited, such as no (or

limited) main international search, subject matter not examined by the International Preliminary Examining Authority or lack of unity of invention. The paragraph had also been added to Rule 70 to require the international preliminary examination report to indicate whether or not a top-up search had been performed. Furthermore, the draft removed the added reference to Rule 66.1*ter* in Rule 66.4 which required a top-up search to be performed before issuing all written opinions and international preliminary examination report unless the top-up search served no useful purpose. Instead, the issue of postponing the top-up search to a later written opinion or the international preliminary examination report could be included in the International Search and Preliminary Examination Guidelines.

146. The Delegation of the European Patent Office supported the revised proposed amendments to the Regulations, but noted that further explanations would be required in the International Search and Preliminary Examination Guidelines, for example, to explain the concept of “no useful purpose” and how and when the top-up search would be performed in the context of Chapter II.

147. The Delegation of the Nordic Patent Institute supported the revised proposed amendments to the Regulations.

148. The Delegation of the United Kingdom thanked the Secretariat for proposing the revised amendments to the Regulations, which received its full support.

149. The Delegation of Japan gave provisional support to the revised proposal, but required further time to review the Regulations, particularly as the incompatibility notice with national law in paragraph (c) had been deleted from Rule 66.1*ter*. Regarding draft Rule 70.2, the Delegation enquired whether an amendment to Form PCT/IPEA/409 would be necessary, as this would require time to change internal IT systems at the Japan Patent Office, and requested to be able to use the current form during a transition period, for example, by adding the information in a separate box. Finally, the Delegation underlined that it would be important to discuss implementation details, such as amendments to the Administrative Instructions, Forms and the International Search and Preliminary Examination Guidelines, and allow sufficient time for internal preparation prior to implementation.

150. The Chair concluded that the Working Group had reached an agreement in principle on the revised draft amending the Regulations. The International Bureau would produce a final draft and proposed transitional provisions, which would be sent to Member States for a short consultation after this session of the Working Group.

151. The Working Group approved the proposed amendments of the Regulations set out in Annex I to this document with a view to their submission to the PCT Assembly for consideration at its next session, in September–October 2013, subject to any further comments to be made by Contracting States or affected Offices during a short consultation period to be set by the International Bureau following the session.

MANDATORY RECORDATION OF SEARCH STRATEGY

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

153. The Delegation of the United Kingdom introduced the document, submitted jointly with the Delegation of the United States of America, which had been one of the PCT 20/20 proposals outlined in document PCT/WG/6/15. The Delegation thanked respondents who had provided comments and suggestions on the proposal outlined in Circular C. PCT 1364 dated December 20, 2012, and noted the support Offices and users had expressed in response to the Circular and in discussions at the twentieth session of the Meeting of International Authorities in February 2013 while, at the same time, acknowledging areas that might need amendment. The proposal suggested modifying the International Search and Preliminary Examination Guidelines to require that when International Searching Authorities transmitted the international search report to

the International Bureau, Authorities should also transmit a copy of the search strategy relied upon to perform the international search in whatever format it had been recorded in by the International Searching Authority. The Delegation explained that the flexibility in the format of the information was intended to minimize any time taken by the examiner to alter the format and help to avoid IT changes, as International Searching Authorities could continue to use existing formats for recordation of search strategies. Making search strategies available in this way would be extremely beneficial to designated Offices, increasing the level of transparency and confidence with respect to the work performed by the International Searching Authority, and in turn, allowing Offices to improve the efficiency of their searches by reducing duplication. In addition, making the search strategies available in the various formats in which they were currently recorded would allow Offices to review the various formats in which the strategies are recorded and, as a result of the experience gained in utilizing the differing formats, thus would enable Member States to make a more informed decision as to which aspects of the different formats would be most useful when taking a decision on a uniform format to be used by all Offices in the future.

154. The Delegation of Japan supported the rationale to exchange search strategies among International Authorities and the national and regional Offices, as this could contribute to improving the quality of examination and enhance work sharing. Consideration also needed to be given to making available the search strategy to the public, while focusing on standardization on the format and context to have the maximum benefit from the search strategy. However, the Delegation could not support the proposal to make it mandatory to record such strategies by amending the PCT International Search and Preliminary Examination Guidelines, as doing so would be premature. Not all International Authorities were ready to record their search strategies systematically, share them between IP Offices and disclose them to the public. Careful consideration therefore needed to be given to this matter, based on the prospective of what purpose could be achieved from recording such strategy and whether it could be effective in terms of the resources needed to prepare internal operations and IT systems. In this regard, the Delegation believed that the voluntary exchange of search strategies by International Searching Authorities in whatever format as was established by the International Search Authority would be useful for evaluating effectiveness of exchanging search strategies and considering an appropriate format for recording such a strategy.

155. The Delegation of Canada supported the proposal to make the recordation of search strategies mandatory and agreed that these should be made available to other Offices. Examiners at the Canadian Intellectual Property Office were currently required to record the search strategy when preparing international work products, which were referred to as “examination notes” and were being sent to the International Bureau for inclusion on PATENTSCOPE.

156. The Delegation of Australia expressed its support for initiatives to maximize quality and the use of international search results through the publication of the search history or strategy, which would increase transparency and build confidence with respect to the work undertaken by an International Searching Authority and facilitate work sharing. Since October 2, 2012, IP Australia had provided copies of more than 1500 search strategies, referred to as “search information statements”, to the International Bureau for publication on PATENTSCOPE. Search information statements contained a full history of the search, including keywords, classification marks, etc. The Delegation encouraged other International Authorities to provide their search strategies to the International Bureau for publication on PATENTSCOPE in whatever format they were available until a unified format could be agreed upon.

157. The Delegation of Israel stated that it was fully supportive of the proposal, as mandatory recordation of the search strategies would provide increased confidence in the quality of the PCT searches and help the examiner in designated Offices. The Delegation also believed that the search strategy should also be provided to applicants, for them to understand how the claims had been searched. The Israel Patent Office as an International Searching Authority had already started to send search strategies to the applicant and the International Bureau.

158. The Delegation of China believed that recording the search strategy and making it available to the public could increase the level of transparency and confidence in the quality of patent searches to some extent, but the Delegation considered it necessary to define minimum requirements before making it mandatory to record such strategies. It was therefore desirable that a uniform format and the consistency of content and presentation could first be agreed upon in order to achieve its goal.

159. The Delegation of the Russian Federation supported the idea in principle of submitting the search strategy together with the international search report and acknowledged the pilot projects, where such strategies were being sent on a voluntary basis to the International Bureau from certain Offices. The Delegation did, however, consider it premature to make submitting and publishing search strategies mandatory, as there was insufficient feedback on their usefulness to the public. In relation to the document, the Delegation noted that the search history and search strategy had been considered as equivalent to each other. The Delegation disagreed with this view as it believed that a search history contained a complete sequence of all search queries, whether successful or not, whereas a search strategy removed unnecessary or redundant search queries, making it more useful to the public. As an example, for chemical cases, a search history could occupy several tens of pages which would require considerable extra work for an examiner to refine in order to document a clear search strategy that would be understandable to the public. The added workload in recording the search strategy therefore needed to be carefully weighed up at each Office. Moreover, the Delegation indicated that there were other mechanisms to make search strategy uniform throughout databases, but this required restructuring ideas. In summary, the Delegation considered the exchange of search strategies or search histories to be useful on a voluntary basis, but more time was needed for Offices to prepare for wider exchange of search information.

160. The Delegation of Finland supported the proposal, as it believed that the availability of the search strategies for other Offices would increase the confidence in the quality of the international search report, making it more useful to designated Offices. A standard format could then be agreed on at a later stage, based on the experience gained. The National Board of Patents and Registration of Finland had started to transmit copies of search strategies to the International Bureau at the beginning of April 2013.

161. The Delegation of El Salvador agreed with the aims and motivation behind this proposal, which would add value for designated Offices as well as the International Bureau. Easily accessible search strategy information would increase transparency as well as legal security, and thus enhance quality. However, the Delegation questioned the mandatory nature of the proposal and suggested having an interim period, where strategies would be shared on a voluntary basis to learn from this experience before it becoming mandatory.

162. The Delegation of Chile agreed with the content of the proposal, stressing the importance for examiners in national Offices to be able to view the results of international search as a means to enhance quality and transparency. However, it was also necessary to devise a common format to make it possible to share all information.

163. The Delegation of South Africa supported the proposal, which would be extremely valuable for applicants and for countries with national patent Offices not performing a substantive examination. The result of the international search, in whatever format, would be useful; it was not necessary to wait for a standardized format before sharing search strategies, which could overburden the examiner performing the international search.

164. The Delegation of Norway stated that it was positive about the recordation of search strategies, believing this would increase transparency to the benefit of both Offices and applicants.

165. The Delegation of the European Patent Office stated that it was currently assessing the issue of sharing some information on its search strategies in the future. However, if the European Patent Office were to decide to share information on search strategies, this would not be as extensive as what was defined as a complete search strategy record in the proposed draft International Search and Preliminary Examination Guidelines. The Delegation agreed with the views expressed by the Delegations of Japan and China that, first of all, a definition of the scope of a search strategy was needed and that a common format should be ensured in order for search strategies to be useful and usable. In view of this, the Delegation agreed with the Delegation of the Russian Federation that it was premature to make publishing search strategies mandatory at this stage. As only a few International Searching Authorities currently shared their search strategies, the Delegation suggested that work should continue in line with the agreement reached at the twentieth session of Meeting of International Authorities as outlined in paragraph 71 of the Summary by the Chair (document PCT/MIA/20/14): “Authorities agreed that further discussion in this area was desirable. It was necessary to define minimum requirements before considering making it mandatory to record search strategies and it was also desirable in the long run to seek consistency of content and presentation.” The Delegation therefore supported further discussions on this matter between International Authorities.

166. The Delegation of Denmark supported the proposal for mandatory recordation of search strategy.

167. The Representative of the Japan Intellectual Property Association (JIPA) supported the mandatory recordation of search strategies, as the publication of search strategies would improve the applications.

168. The Representative of the American Intellectual Property Law Association (AIPLA) stated that AIPLA was generally in favor of the mandatory disclosure of search strategies and that the goals of sharing search strategies would increase transparency and quality. To further this aim, the Representative suggested that the International Bureau could begin work on a standard format for the presentation of search strategies and that, in the meantime, delegates should encourage International Searching Authorities to share their search strategies on a strictly voluntary basis.

169. The Secretariat indicated that the International Bureau was willing to support International Searching Authorities in the development of a common format or template for sharing search strategies. In addition, as an interim measure for some International Authorities, an arrangement could be offered where search strategies sent electronically could be assigned one of two codes, at the choice of the International Searching Authority. The one code currently used automatically would make the search strategy available to the public as from the date of international publication, but an alternative code could be used to make the strategies not available on PATENTSCOPE but visible through ePCT only to the applicant and to national Offices. Authorities selecting the alternative code could, at any later time, switch to the making their search strategies available to the public.

170. The Chair thanked the Secretariat for the proposal to provide for the possibility to limit the sharing of search strategies to the applicant and national Offices, which might address the concerns that had been expressed by some International Searching Authorities about publishing voluminous search histories. Summarizing the discussion, the Chair acknowledged that some International Searching Authorities, such as the National Board of Patents and Registration of Finland and IP Australia, already provided their search strategies in existing formats to the International Bureau for publication on PATENTSCOPE. Sometimes such search strategies extended to several pages, but in any event, they provided a subsequent reader with an idea of what the examiner had searched and gave an ability to judge the search based not only on the citations that had been provided, but on the logic and the reasoning used by the examiner in the first instance. This was already happening without any agreement on mandatory sharing of search strategies. The Chair also noted that delegations agreed in principle with sharing search strategies, which would improve the quality of work and assist in work sharing. However, there

were concerns expressed by the Delegations of Japan and China that there should be a standard format for providing search information before mandatory sharing took place. Nevertheless, sharing could go ahead without a standard format since examiners were capable of interpreting the work of other examiners, and where this was more difficult, the examiner would be able to make a judgment on the citations. The Chair also acknowledged the difficulties of formulating the search strategies for chemical structures in a concise manner. Another relevant consideration was whether IT changes were necessary to communicate the information to the International Bureau for making it available on PATENTSCOPE. As there was strong support in principle for sharing search strategies, the key question was whether there needed to be an agreed format. This issue had been considered at the Meeting of International Authorities, which had considered that a common format was not necessary to move forward, perhaps because there could be some value in having the information from the search strategy in whatever form it had been recorded, and also because agreeing on a common format could take several years. Furthermore, the sharing of search strategies could provide experience of working with the system that could be used in deciding on a common template for recording search strategies.

171. The Delegation of the United Kingdom stated that it was encouraged by the International Searching Authorities already sharing their search strategies, but recognized the concerns expressed by other Authorities that making the sharing of search strategies mandatory was premature at this stage. Nevertheless, the Delegation considered that including a change to the Guidelines at this stage would be extremely beneficial and thus suggested that the Guidelines be amended to strongly encourage International Searching Authorities to share search strategies while not making it mandatory. The Delegation also supported the interim arrangement proposed by the Secretariat to limit the sharing of search strategies to other Offices.

172. The Delegation of the European Patent Office stated that, according to their understanding, the Meeting of International Authorities did not agree that a common format was not needed for sharing search strategies; some Authorities expressed this view, but others considered that it was essential that a common format for the recordation of search strategies was agreed upon between International Authorities in order to make search strategies useable and useful. The Meeting of International Authorities therefore had mandated the Quality Subgroup to look into the matter further. The Delegation therefore believed that more time was needed to gain experience on whether the sharing of search strategies was useful. With respect to the International Search and Preliminary Examination Guidelines, the present text already provided for the flexibility for an International Searching Authority to share search strategies, so there was no need for further revision until further discussions at the Meeting of International Authorities had taken place.

173. The Delegation of the United States of America stated that it was encouraged by the delegations that agreed in principle to the mandatory recordation of search strategies and encouraged International Authorities to make their search strategies public to the extent possible. For those unable to allow their search strategies to be published, the Delegation encouraged posting of search strategies or histories on the electronic forum of the Quality Subgroup to enable adequate preparation for the next session of the Meeting of International Authorities, where it might be possible to have a paper on a minimum format for search strategies.

174. The Delegation of Japan agreed with the comments expressed by the Delegation of the European Patent Office and wished to contribute to further discussions of this issue in the Meeting of International Authorities and the Quality Subgroup. Discussion in these bodies would enable it to consider whether the resources associated with this initiative could be justified in view of changes to the IT environment and the format of search strategies for providing to the public.

175. The Chair stated that he was encouraged by International Searching Authorities considering their own search strategies and added it could be useful for less experienced International Searching Authorities to be able to view how searching was conducted by their more experienced counterparts. The Chair also encouraged Offices already providing search results to the International Bureau to continue to do so, adding that the possibility offered by the Secretariat to

limit the sharing of search strategies to other Offices could encourage participation from other Offices. The Chair acknowledged the view expressed by the Delegations of European Patent Office and Japan on the outcome of the Meeting of International Authorities that, in the absence of an agreed format, it was premature to move forward on the sharing of search strategies. With this in mind, the Chair proposed that the suggestion made by the Delegation of the United States of America to post search strategies and histories on the electronic forum of the Quality Subgroup could be a way of undertaking further groundwork prior to the next Meeting of International Authorities. This work could include developing a potential format and template for search strategies which could be fed into discussions at the next session of the Working Group. With a common template as a basis, the Working Group may then be in a better position to decide on mandatory recordation of search strategies and, if agreement were reached in principle, deal with other issues such as IT and business process changes.

176. The Working Group recommended that the Quality Subgroup of the Meeting of International Authorities under the PCT should continue to review this subject, focusing in the first instance on developing a consistent format, and that International Authorities should share information on search strategy reporting formats to help move the work forward as quickly as possible.

PCT FEE REDUCTIONS

FEE REDUCTIONS FOR SMALL AND MEDIUM-SIZED ENTERPRISES, UNIVERSITIES AND NOT-FOR-PROFIT RESEARCH INSTITUTES

177. Discussions were based on document PCT/WG/6/10, paragraphs 3 to 46.

178. The Secretariat introduced this part of the document by highlighting the four main issues: the rationale and effectiveness of differentiated fees for small and medium-sized enterprises (SMEs), universities and not-for-profit research institutes, the potential impact of fee reductions on SME income, possibility eligibility criteria for fee reductions, and implementation issues.

179. On the first issue, the Secretariat stated that patent fees, in essence, served two distinct functions: to recover cost, and to serve as a regulatory tool to influence filing behavior. The document largely focused on the latter function, but noted that any changes to the fee structure would need to be made in a manner that would be consistent with the cost recovery objectives of the Organization, as PCT fees funded many of the activities of WIPO outside of the PCT. The document concluded that fees only had a modest influence on filing behavior, but there were no existing studies that examined the specific fee elasticity for SMEs. In addition, there were no studies providing estimates of fee elasticity for PCT applications which could be compared with values of national pre-grant patent fee elasticity. On the question of fee preferences to SMEs, studies did not necessarily imply that active participation of SMEs in the international patent system caused economic growth and economic wide job creation. On the contrary, in the aggregate, studies had indicated that it would be better if fee reductions were open to all firms. The document then proposed an alternative, namely, to consider providing targeted support for young start-up firms. As a final matter on this issue, the document questioned whether fee reductions for SMEs, universities and not-for-profit research institutes would be the best policy instrument for extending a preference to these patent applicants. In this regard, it was important to keep in mind that the PCT fees represented fraction of overall patenting costs, yet a large proportion of revenue to the Organization. The policy leverage of a fee discount would therefore be very limited.

180. The Secretariat continued by stating that a problem with assessing the potential impact of fee reductions on PCT income was the lack of data on the number of applications that could be received from applicants, such as SMEs, universities and research institutes, that could potentially benefit from fee reductions, resulting in great uncertainty as to what impact to expect on PCT income. There was no universal definition of what constituted an SME, and the International

Bureau did not have available data on how many PCT applications were filed at present by applicants to be considered under national criteria as small and medium-sized entities. Notwithstanding the lack of information, the impact on fee reductions was apparent. In the top 15 countries of origin for international applications, more than 99 per cent of all enterprises could be considered as SMEs under national criteria. Moreover, a study referred to in the document suggested that on average, in nine industrialized countries analyzed in the study, almost 30 per cent of all patents were granted to SMEs. Taking these figures into account, it could be estimated that as much as 20 per cent of PCT applications were filed by SMEs. Applying fee reductions as discussed in the document to these applications would result in a loss for the International Bureau of 26 million Swiss francs per year. Additional sources of income would therefore need to be found to counterbalance the substantial loss of income. But even then, given the considerable uncertainty as to the numbers of applications to be expected, there might be the need to determine an upper limit on the overall amount of resources that should be made available to finance such fee reductions, and if so, how to implement this upper limit. As for financing any agreed reductions, one potential source of income could be abolishing existing fee reductions for electronic filing of applications. Although these had served the system very well, more than 90 per cent of applications benefited from these fee reductions, which cost the PCT system 30 million Swiss francs every year and could rise to more than 40 million Swiss francs in the coming years.

181. The Secretariat then outlined possible criteria for fee reductions for SMEs, universities and research institutes. Noting the diverse criteria used by countries in their national systems, studies indicated that existing diverse structural, cultural and political reasons ran counter to having a universally agreed definition of an SME in the medium term. One possible solution to this problem could be twofold. First, an effort could be made to agree on a standalone definition for the purposes of PCT fee reductions, as had been achieved in the context of determining fee reductions for applicants from developing countries. Alternatively, Member States could be left to apply their own national criteria when deciding to grant PCT fee reductions for SMEs. However, this could raise concerns of forum shopping if applicants had the choice between different receiving Offices and a dilution of applicable national criteria to support local SMEs when filing applications with local receiving Offices. Similar issues also existed for universities and research institutes.

182. The Secretariat concluded the introduction to the document by indicating some implementation issues which would need to be addressed if a set of criteria were agreed. One question was who should check for compliance with whatever the criteria should be to grant such fee reductions, for example, the local receiving Office or the International Bureau. In addition, the basis for making a decision on the eligibility for reductions needed to be determined, such as the kind of documentation or official records showing that that applicant was indeed an SME. Furthermore, where there was more than one applicant, would all have to comply with the fee reduction criteria? Finally, the consequences for applicants incorrectly claiming SME status and profiting from reductions that they were not eligible for needed to be considered - the PCT did not provide for any consequences to be applied and it would have to be left to national law to apply such consequences.

183. The Delegation of Belgium, speaking on behalf of Group B, welcomed efforts to make the PCT system more easily accessible to specific categories of entries, including SMEs. On the other hand, fee reductions needed to be considered in a pragmatic manner and many elements required deliberation before deciding on further direction. In particular, as the noted in the document, fees were important, but only had a modest influence on filing behavior. In addition, fee reductions needed to be set in an income-neutral way. Furthermore, the Delegation underlined that it would be difficult to determine the beneficiaries of potential fee reductions.

184. The Delegation of Barbados noted the issues identified in the document which merited consideration in determining a workable solution. The Delegation supported the idea of PCT fee reductions for applications in electronic form and an upper limit for each budgetary biennium which could be made available for this purpose, recognizing that these matters had to be addressed within the financial context of the International Bureau. Moreover, suitable criteria should be

determined in respect of SMEs, universities and not-for-profit research institutes, which should take into account factors such as number of employees, annual revenue or turnover, number of students on its roll, available resources and funding arrangements, such as extent of grants and other governmental subsidies. In conclusion, the Delegation acknowledged the difficulties in determining suitable criteria and urged further consideration to be given to arrive at criteria that would be acceptable to Member States.

185. The Delegation of El Salvador pointed out the technical nature of the document and asked for further details on the impact of fee reductions on the Organization.

186. The Chief Economist, responding to the interventions from the Delegation of El Salvador, stated that there were no estimates specific to the PCT system on how changes in the PCT fees or in the PCT structure would affect filing behavior. There were a significant number of studies conducted in different jurisdictions answering similar questions with respect to the pre-grant fees, but not with regard to the PCT system. This issue could therefore be studied further; however, it was important to bear in mind the PCT fees had remained relatively stable for several years, making filing behavior difficult to compare. Nevertheless, it could be possible to make some rough estimates on how PCT fees would affect filing behavior.

187. The Delegation of the Republic of Korea supported the statement made by the Delegation of Belgium on behalf of Group B. In addition, the Delegation highlighted that, as progress had been achieved in the Working Group, for example, in endorsement of the PCT Roadmap in 2010, user needs and the likely benefit for current and future users of the system had been one of the major driving forces. Against the backdrop of divergent interests on this issue, as had been demonstrated in previous sessions of the Working Group, and the difficulty of achieving a common solution, the Delegation hoped that consensus could be achieved during the current session of the Working Group.

188. The Delegation of Algeria, speaking on behalf of the African Group, highlighted the importance of this issue for countries in Africa, which hoped to make the system more balanced, effective and inclusive. The best way to achieving this for the African Group was through two actions: technical assistance and capacity building in individual countries, and fee reductions, since PCT Contracting States had very different economic situations and levels of development, and businesses currently did not have the same level of access to the PCT or the same needs. Acknowledging that it could be useful to consider the best way in which a fee reduction could be more representative of the level of development of the different economic players, the Delegation noted that the Secretariat had proposed first having a discussion on the principle of fee reductions, adding that it was necessary to discuss to which applicants and how fee reductions should be applied for the system to operate in a pragmatic manner. The African Group was willing to engage in this discussion and considered this could bring added value. Furthermore, the Delegation considered that the Chief Economist could analyze the statistical impact of fee reductions for SMEs and research institutes in developing countries, which could be of assistance to the Working Group. Finally, the Delegation encouraged all Contracting States to take a pragmatic approach on fee reductions for developing countries to make the PCT system more attractive and inclusive.

189. The Delegation of Chile stated that it believed the issue of fee reduction for SMEs, universities and research institutes to be a very pertinent one, which needed to be considered from different perspectives, *inter alia*, the impact on the PCT system and on the income of WIPO. In principle, it endorsed increasing the motivation for SMEs, universities and research institutes to use the PCT system. Nevertheless, the Delegation did not consider it had all the background information to analyze the impact of fee reductions and the incentives it would offer to SMEs, universities and research institutes. The Delegation therefore requested various approaches to be studied in more detail to identify solutions that would be satisfactory to SMEs, universities and research institutes, while avoiding any negative impact on the income of the Organization.

190. The Delegation of India supported the statement made by the Delegation of Algeria on behalf of the African Group and also agreed with some issues that had been raised by the Delegation of El Salvador. The Delegation encouraged the Secretariat to produce a more detailed report for the next session of the Working Group to have a clearer picture to decide on PCT fee reductions, which would have a positive impact to developing and least developed countries.

191. The Delegation of Japan recognized the importance of the fee reduction for SMEs, universities and not-for-profit research institutes. However, the effects of using revenue from fee reductions for electronic filing as the basis for these reductions, along with other issues, such as the effect on companies not eligible for the proposed fee reductions and the checking of eligibility for reductions, should also be taken into consideration and analyzed further. Furthermore, the Delegation sought clarification on the scope of the proposal, emphasizing that, beyond the international filing fee, any fee reductions offered by receiving Offices, International Searching Authorities and International Preliminary Examining Authorities were a matter of national policy.

192. The Delegation of Brazil supported the statements made by the Delegation of Algeria speaking on behalf of the African Group and the Delegation of India on the importance of the Working Group having further information on the subject of fee reductions as a basis for taking a decision on this matter.

193. The Chief Economist provided an indication of what further work could be carried out on fee reductions in the PCT. It could be possible to estimate fee elasticity, i.e. the impact of a percentage change of the fee on the volume of filings. This could be helpful for two different reasons. First, fee elasticity would enable the policy leverage of a fee discount to be assessed; a low estimate would indicate that fees were less important to applicants and did not affect filing behavior, whereas a large estimate would indicate that fees could offer more leverage. Second, fee elasticity was an important variable in evaluating the impact on revenue of a fee discount. The Chief Economist stated that data for assessing fee elasticity were available for the PCT system as a whole, which would allow for a range of scenarios to be produced once methodological issues had been resolved. However, it would be more difficult to present fee elasticity for different types of applicants. Although data for universities and research institutes could be extracted to provide specific estimates of fee elasticity, small and medium-sized enterprises did not identify themselves as such when filing an international patent application. Estimates for small and medium-sized enterprises could therefore only be achieved by subjective and imprecise methods, such as applying a threshold on the number of filings to obtain a rough definition of a small and medium-sized enterprise; but even then, it was not clear what this threshold should be. The Chief Economist therefore had reservations on what was feasible for estimating the fee elasticity for small and medium-sized enterprises. On that note, it would be interesting to study the experience of those national jurisdictions that currently applied a fee discount for small and medium-sized enterprises where those entities had to identify themselves in the patent application process to see what their experience had been and obtain some estimates on the share of applicants representing small and medium-sized enterprises.

194. The Chair summarized the proposal that the Chief Economist would study the fee elasticity for universities and research institutes using existing data held by the International Bureau. As a similar study in relation to small and medium-sized enterprises would be difficult, it might be useful to acquire information, data and anecdotes from countries where fee discounts for small and medium-sized enterprises were in place to learn from these experiences. Contracting States could therefore supply this information to the Secretariat who may be able to elaborate on this issue at a later point in time.

195. The Delegation of Algeria, speaking on behalf of the African Group, expressed the desire to have a global vision on the costs on the PCT system, in particular on whether patenting costs could be borne by small and medium-sized enterprises in developing and least developed

countries. The Delegation therefore asked whether it would be possible to compare the financial capabilities of small and medium-sized enterprises in developing and least developed countries in making an international patent application.

196. The Chief Economist, replying to the question from the Delegation of Algeria, indicated that such a comparison would effectively address the ultimate impact of any PCT discount on filing volumes and behavior of applicants and their ability to innovate and take advantage of the patent system. In view of the limited data on small and medium-sized enterprises, the Chief Economist considered that a study on this scale would not be possible since, in addition to estimating fee elasticity, it would require surveys of companies, covering both those using and those not using the PCT system, to analyze how fees relate to their financial structure and operating costs. This study might be feasible in principle, but it would require far greater resources than the study that had been proposed on how PCT filing fees affected filing behavior, where existing data were available.

197. The Delegation of Belgium, speaking on behalf of Group B, provided some comments, following the proposed study by the Chief Economist on the issue of fee reductions for small and medium-sized enterprises, universities and not-for-profit research institutes. First, Group B considered that it might be useful to have a document prepared by the Secretariat, providing a variety of definitions of small and medium-sized enterprises used for fee reductions in patent laws existing at a national or regional level. Second, this document should entail a description of the mechanisms already in place in some countries concerning fee reductions for small and medium-sized enterprises, universities and not-for-profit research institutes. Third, Group B encouraged further study on the elasticity of fee reductions covering not-for-profit research institutes and universities. Finally, such fee reductions should be financially sustainable and income-neutral for WIPO.

198. The Delegation of Brazil acknowledged the difficulty of defining a small and medium-sized enterprise, but by applying a specific definition, the Delegation considered that it might be possible to analyze the beneficiaries of such a fee reduction.

199. The Delegation of China acknowledged the difficulties and the complexities of establishing a fee reduction policy for small and medium-sized enterprises, universities and not-for-profit research institutes. The Delegation nevertheless supported any efforts of further studies on these aspects, since it was one of the important measures to enhance the accessibility of the PCT system and looked forward to discussing the issue in the next session of the Working Group.

200. The Delegation of the United States of America supported the statement made by the Delegation of Belgium speaking on behalf of Group B. The Delegation supported fee reductions for certain entities, which was part of the expanded PCT 20/20 proposals (see document PCT/WG/6/15). Worldwide reductions in fees for small and medium-sized enterprises would promote growth for small businesses and build support for patent systems. In this regard, the United States of America was unilaterally implementing a three tier fee reduction system with regard to all international stage fees from January 2014 with a standard fee, a reduced fee for small entities and an even smaller fee for micro entities. The Delegation noted the comments about the difficulty in achieving an agreed definition for small and medium-sized enterprises, which had also been made in the responses to Circular C.PCT 1364 concerning the PCT 20/20 proposals, dated December 20, 2012. The difficulty of arriving at an agreement on such a definition did not, however, prevent efforts being made to resolve this issue.

201. The Representative of the American Intellectual Property Law Association (AIPPLA) stated that a number of its members favored reductions in fees for small and medium-sized enterprises, universities and not-for-profit research institutes in principle. The Representative referred to a non-paper that had made available as a suggested way forward, emphasizing that it was not an official position of the AIPPLA, and was willing to respond individually to any questions from delegations in the non-paper.

202. Noting that it may not be possible for the Chief Economist to carry out a detailed study on the question to what extent fee reductions would enable small and medium-sized enterprises to better participate in the international patent system, due to the limitations of the existing data and the lack of resources for collecting more detailed information, the Working Group requested the Chief Economist to carry out a study on the issue of the elasticity of PCT fees for the group of applicants for which data were readily available to the International Bureau, which would probably include universities and research institutes.

203. In addition, the Working Group agreed that the International Bureau should invite all Member States which at present granted reductions of national pre-grant patent fees to applicants which, under applicable national criteria, were considered to be small and medium-sized enterprises to provide information to the Secretariat on the national experiences gained, notably in terms of numbers of applications benefiting from such fee reductions and on any measurable impact on the filing behavior of such groups of applicants.

204. The Working Group further requested the International Bureau to prepare a working document, for discussion by the Working Group at its next session, on the various existing definitions of what constituted a small and medium-sized enterprise under applicable national or regional laws or practices in relation to fee reductions for national or regional IP/patent applications. That document should also contain a description of applicable mechanisms already in place in some countries concerning fee reductions for small and medium-sized enterprises, universities and research institutes.

205. The Working Group agreed that the study by the Chief Economist referred to in paragraph 202, above, any information submitted by Member States referred to in paragraph 203, above, and the requested working document referred to in paragraph 204, above, would form the basis for the continuation of the discussions of the issues set out in paragraphs 3 to 47 of document PCT/WG/6/13 by the Working Group at its next session.

FEE REDUCTIONS FOR CERTAIN APPLICANTS FROM CERTAIN COUNTRIES, NOTABLY DEVELOPING AND LEAST DEVELOPED COUNTRIES

206. Discussions were based on document PCT/WG/6/10, paragraphs 48 to 85.

207. The Secretariat, introducing the document, stated that the eligibility criteria for fee reductions for applicants from developing and least developed countries had previously been discussed by the Working Group without reaching an agreement. Consequently, the current criteria dated from the mid-1990s. The document set out a brief summary of the concerns raised by delegations during the third session of Working Group, when the criteria had last been discussed, along with some comments from the International Bureau. While recognizing the need to reflect development and innovation aspects better in the criteria, concerns had been expressed with regard to possible indicators for applying innovation-based criteria, the rationale behind thresholds in applying income-based criteria, applying reductions for applicants from all developing countries, and on the imbalance between developing and least developed countries. The document attempted to address these concerns, noting that discussions were not sufficiently advanced to present more detailed proposals on new criteria. The Secretariat therefore considered that a broader and more general discussion as to the main principles which should govern the establishment of new criteria could be beneficial to guide the International Bureau in attempting to formulate a possible new set of eligibility criteria. The document therefore posed questions in relation to using a mix of criteria, whether size of country should be taken into account, and the way forward in relation to applying both income-based and innovation-based criteria.

208. The Delegation of Barbados stated that it was supportive in taking the matter forward considering a mix of criteria. In this regard, the Delegation requested adding the status of a country as a small island state to the criteria to be considered by the International Bureau in formulating future proposals.

209. The Delegation of the Republic of Korea underlined the importance of fee reductions for developing and least developed countries that would result in fees ensuring the principle of cost-neutrality for the International Bureau. The Delegation suggested applying a multistep reduction rate, with higher reductions applied to countries with both income per capita and number of PCT applications below certain maximum levels, and lower reductions applied according to eligibility criteria formulated from a combination of the three individual criteria suggested in the document. The Delegation also drew the attention of the Working Group to the effect on applicants and customer service which needed to be considered, and encouraged the International Bureau to continue in its endeavors to enhance the quality of customer service.

210. The Delegation of the United States of America expressed general support for fee reductions for applicants of certain countries with the aim of encouraging innovation in low income states. However, it was aware that reducing fees for applicants of countries that may not necessarily be low income states could have budgetary implications for WIPO, a particularly critical issue during the current uncertain economic conditions where national budgets had been reduced in many countries. The Delegation supported the use of the two-step test originally proposed by International Bureau, where both income-based and innovation-based criteria were considered when determining eligibility of a country for fee reductions. The Delegation also supported a periodic review of the eligibility of countries to ensure that those receiving fee reductions continued to meet the eligibility criteria.

211. The Delegation of India underlined the importance of fee reductions for developing and least developed countries and requested further discussion of the issue at the following session of the Working Group. In the meantime, the Delegation encouraged members of the Working Group to reflect upon the various options outlined by the Secretariat on a mix of both income-based and innovation-based criteria, which could be beneficial for patent applicants from developing and least developed countries to decide on future eligibility criteria.

212. The Delegation of Algeria, speaking on behalf of the African Group, stated that the aim of the discussion on fee reductions, in the view of the African Group, should be to enable applicants in developing and least developed countries to be able to take full advantage of the PCT system. To achieve this goal, the only criteria that should be taken into account were resources and size of country, not the number of PCT applications, which would be contradictory. However, if the Working Group intended to have a more general discussion on fee reduction covering all Contracting States, consideration could also be given to innovation-based criteria. The Delegation therefore urged the Working Group to consider the aim of the debate and which applicants any fee reductions should serve; in the opinion of the African Group, these applications should be from developing and least developed countries.

213. The Delegation of El Salvador supported the position of the Delegation of India that it would be of interest to have further discussion of the issue at the following session of the Working group, and agreed with adding the criterion proposed by the Delegation of Barbados. A further discussion would also provide for the possibility to consider more concrete information on fee reductions.

214. The Delegation of Brazil supported the calls from other delegations for further discussion on eligibility criteria for fee reductions from applicants from developing and least developed countries. The Delegation underlined the need for more information, stressing that the Working Group still needed to recognize the problem that fee reductions were trying to solve. If the aim was to make the PCT more inclusive, this should be taken as the main goal and new criteria should be drafted to improve access for those countries with limited numbers of applications. In this regard, size of country would not be adequate in itself as many developing countries would still benefit from rules that would improve their access to the system.

215. The Delegation of Belgium, speaking on behalf of Group B, stated that it was of the view that further work and discussion was urgently needed in order to develop a system of fee reductions that was dynamic and could take into account, providing regular review, the changes that occurred

in the development of the economy worldwide. For these reasons, it suggested that the Working Group should invite the International Bureau to prepare a document, for discussion by the Working Group at its next session, that should further examine a system of fee reductions that would combine the two criteria of income and innovation, as suggested in document PCT/WG/6/10, since this combination had the potential of being able to grasp the different elements of socioeconomic development of a country that should justify fee reductions for its applicants. Once the criteria were fixed, the decisive discussion would be in determining the thresholds and their levels. The Secretariat had already provided interesting information on that regard, showing how they could be fixed in order to ensure proper justification in the application of the fee reduction, taking into account the socioeconomic reality of the country. Moreover, the objective of a system of fee reductions should be to ensure that the PCT system was attractive and affordable for applicants in all parts of the world, and in particular, in developing and least developed countries currently using the system infrequently, while ensuring a sustainable level of revenue for WIPO. The current use of PCT fees, not only for financing PCT activities but also for many other important activities of the International Bureau, including development activities and technical assistance, needed to be preserved. With this in mind, the Delegation proposed that the Secretariat could make a projection on possible thresholds, so as to enable the Working Group to hold thorough discussions on the possibility of identifying new beneficiary countries that at present did not benefit from fee reductions.

216. The Delegation of Brazil stated that it could not support the suggestion by the Delegation of Belgium, speaking on behalf of Group B, for a working document to be prepared by the International Bureau that was limited in scope to the two criteria of income and innovation. Instead, the discussions by the Working Group at its next session should be open-ended and not limited to the set of criteria set out in document PCT/WG/6/10.

217. The Chair summarized the interventions on fee reduction eligibility criteria for applicants from developing and least developed countries. There was no clear way forward, and a number of delegations had indicated a requirement to have further information in relation to this issue for discussion at the next session of the Working Group. There were some questions raised by delegations as to what it was that this initiative was trying to achieve, and what the ultimate aim of the discussions was. With the ultimate aim in mind, the Working Group might be able to frame formal or more specific proposals, but this question in some sense remained unanswered. On this question, the Chair believed that a general objective of the paper was to set forth a clear and useful fee reduction approach which would provide developing and least developed countries access to the PCT system via a mechanism of fee reductions, since applicants from these countries had difficulties to pay fees at the current level. There had been some interventions supporting a mixed approach of both economic and innovative criteria for determining fee reductions, where details would need to be finely elucidated at a later stage. However, other delegations had suggested that the number of filings was not a good innovative indicator for determining eligibility, and, if used, could disadvantage countries with low population currently using the PCT system. The Chair therefore encouraged Member States to provide input and concrete suggestions on a possible way forward to the Secretariat, in preparation for a continued discussion of the matter at the next session.

218. The Working Group agreed to continue its discussions on the matter at its next session and that the Secretariat would seek to update its working document to assist discussions.

COORDINATION OF TECHNICAL ASSISTANCE UNDER THE PCT

219. Discussions were based on document PCT/WG/6/11.

220. The Secretariat, introducing the document, reminded the Working Group that it had agreed at its fifth session that reports on technical assistance relating to the PCT should be included as a regular agenda item for future sessions of the Working Group. The document was the first report of this kind and also gave an update on the discussions of the External Review of WIPO Technical

Assistance in the Area of Cooperation for Development, currently ongoing in the Committee for Development and Intellectual Property (CDIP), noting the decision of Working Group at its last session to await the outcome of those discussions in the CDIP before deciding how to proceed with regard to the technical assistance related PCT Roadmap recommendations.

221. With regard to the report on the technical assistance projects relating to the PCT, the Secretariat reminded the Working Group that, since the start of the operations of the PCT system in 1978 and in line with the reorientations of the tasks of the PCT Committee for Technical Assistance decided by Member States, the organization of technical assistance for developing countries within WIPO in the area of patents had in essence been split into two different sets of activities. First, there were those activities which had a direct bearing on the use of the PCT by developing countries and that were currently delivered by the PCT Divisions of the Innovation and Technology Sector. On the other hand, the second set of technical assistance activities were those which extended beyond activities which had a direct bearing on the use of the PCT by those developing countries, which since 1978 were carried out under the supervision of other non-PCT related WIPO bodies. With regard to the former, the Annexes to the document set out those technical assistance activities which had a direct bearing on the use of the PCT by developing countries and which had been carried out or were scheduled to be carried out in 2012 (Annex I) and 2013 (Annex II). With regard to technical assistance carried out under the supervision of other WIPO bodies, the document set out a number of such examples of activities carried out under the supervision of the CDIP, the Committee on WIPO Standards or, indeed, the WIPO General Assembly. Furthermore, more general activities for developing countries, many of which were aimed at assisting countries and developing their patent systems, which was the main mandate of PCT Article 51, could be found on the WIPO Technical Assistance Database.

222. The Secretariat continued by updating the Working Group on the discussions on the External Review of WIPO Technical Assistance in the Area of Cooperation for Development (“the External Review”; document CDIP/8/INF/1) and related documents at the eleventh session of the Committee for Development and Intellectual Property (CDIP), referring to the Summary by the Chair of that session. Some progress had been made in these discussions with the CDIP agreeing on work by the Secretariat on three proposals from the list of recommendations contained in that report and from the list in the Joint Proposal by the Development Agenda Group and the Africa Group on WIPO’s Technical Assistance in the Area of Cooperation for Development (document CDIP/9/16), with discussions continuing at the next session of the CDIP on the External Review and a further report from the Secretariat. The Working Group therefore needed to decide whether to await the decisions in the CDIP before taking up discussions on the issue of technical assistance or do otherwise, that is, to start discussions on the issue of technical assistance in this body.

223. The Delegation of Brazil stated that the document presented a good start to discussions on technical assistance, which was an important part of the PCT system, pointing out that Brazil had been mentioned in a series of activities in the document. The Delegation was also satisfied to see the understanding of the Secretariat of the useful work of other WIPO bodies in development activities in patents. The Delegation hoped for more technical assistance activities to be implemented under the PCT, with the Working Group not only relying on activities under the supervision of other WIPO bodies.

224. The Delegation of Belgium, speaking on behalf of Group B, stated that the tables in both Annexes to the document clearly indicated that approximately 100 PCT-related technical assistance programs formed part and parcel of WIPO’s well-coordinated and timely technical assistance in improving the PCT. The report reconfirmed and reiterated the points that WIPO undertook technical assistance in a wide variety of WIPO bodies. The Delegation therefore did not believe that specific PCT-related assistance should be separated from WIPO’s broader technical assistance efforts.

225. The Delegation of Algeria, speaking on behalf of the African Group, stated that the document was an excellent one, presenting a broad range of technical assistance activities taking place in the context of the PCT. The Delegation expressed satisfaction that coordination of technical assistance was now a regular item on the agenda of the Working Group, adding that technical assistance deserved to be dealt with the same importance by the Working Group as substantive issues. The Delegation was especially happy that the document related not only to activities that had been performed, but also to those still to be carried out, which was not yet the case in other bodies, thus providing a broader perspective of technical assistance activity. The African Group therefore expressed its particular satisfaction to the Secretariat for the preparation of a prospective report. However, the Delegation asked the Secretariat for additional clarification on some issues addressed in the report. Whereas it understood the references made in the document to the Committee for Development and Intellectual Property (CDIP), the Delegation sought clarification on the relationship between the work in the PCT and the Committee on WIPO Standards, as referred to paragraph 13 of the document. In more general terms, the Delegation believed that the coordination of technical assistance relating to patent systems should be discussed and managed in the context of the PCT. While some delegations at the fifth session of the Working Group had expressed the preference to wait for the outcome of discussions of the External Review of WIPO Technical Assistance in the Area of Cooperation for Development and related documents in the CDIP before discussing the issue in the Working Group, the Delegation questioned why the Secretariat was already adopting this approach. In this regard, it was important to distinguish between the different terms of reference of the CDIP and the Working Group. The CDIP had responsibility for evaluating technical assistance and discussing new proposals for projects not only on patent systems but also related to development in general terms, as well as discussing links between the patent system and development. By contrast, the task of the Working Group was to discuss technical assistance to enable countries receiving assistance to play a greater role in the PCT. The Delegation therefore believed that the issues of the two bodies were different.

226. The Secretariat responded to the questions from the Delegation of Algeria on behalf of the African Group. In relation to the first question on the relationship between technical assistance under the PCT and the Committee on WIPO Standards, the Secretariat highlighted the example in paragraph 13(e) of the document of training courses on the use of the International Patent Classification system for developing countries. This fell within the scope of Article 51 of the PCT as organizing and supervising technical assistance for developing countries in developing their patent systems. However, in the sense that it extended beyond the beyond the PCT and dealt with patent classification in general, the responsible body was the Committee on WIPO Standards. It was therefore important to have in mind that the extent of Article 51 was not limited to technical assistance under the PCT but was concerned with the development of patent systems in general. With regard to awaiting the outcome of discussions of technical assistance by the Committee for Development and Intellectual Property, the Secretariat stated that this was a decision taken by Member States at the previous session of the Working Group, noting the similarities between the questions raised and the issues discussed in the External Review of WIPO Technical Assistance in the Area of Cooperation for Development. Moreover, the terms of reference of this review included questions specific to PCT-related technical assistance, given that the parallel requests for technical assistance to be reviewed were made in the CDIP and the third session of the Working Group. It was therefore considered most efficient to combine the requests by including questions specific to the PCT to recipients of the questionnaires distributed to Member States and other users of the international patent system when conducting the External Review of WIPO Technical Assistance in the Area of Cooperation for Development supervised by the CDIP. This review therefore did encompass how well the PCT had been functioning in terms of delivering technical assistance, not only with regard to PCT-specific technical assistance, but covering patent systems in general as defined by Article 51. The Secretariat therefore had the view that Member States at the previous meeting of the Working Group considered it would be wise use of capacities and resources to await the outcome of discussions in CDIP as those issues were similar. However, it would be for Member States to decide if the Working Group should now begin discussions on technical assistance related parts of the PCT Roadmap recommendations, or continue to wait for the fate of discussions on technical assistance in the CDIP.

227. The Delegation of India thanked the Secretariat for providing the report on technical assistance under the PCT. With regard to assistance for International Authorities, the Delegation indicated the possibility of the Office of the Controller-General of Patents, Designs and Trademarks in India becoming operational as an International Searching and Preliminary Examination Authority by the end of this year. The Delegation referred to the intervention from the Delegation of Algeria speaking on behalf of the African Group by supporting further discussion of technical assistance related to the PCT in the Working Group rather than deferring this debate while discussions of the External Review of WIPO Technical Assistance in the Area of Cooperation for Development were ongoing in the CDIP, given that not all PCT-related technical assistance activities were covered by other WIPO bodies, leaving possibilities for consideration by the Working Group. The Secretariat had explained that the mandate of Article 51 was not confined to the Working Group but extended to technical assistance projects under the supervision of other WIPO bodies, such as the Committee on WIPO Standards (CWS) and the CDIP. However, work in the CWS was not currently being reported to the WIPO General Assembly as part of the Development Agenda coordination mechanism. It could therefore be beneficial for developing countries to have technical assistance work discussed in the Committee for Technical Assistance as envisaged by Article 51.

228. The Delegation of Australia stated that the document clearly indicated the large amount of work performed by the International Bureau in the area of technical assistance. In this regard, the Delegation updated the Working Group on the Regional Patent Examiner Training Program (RPET) provided by IP Australia. This was a community-based program based on IP Australia's existing examiner training program, combining e-learning, real time virtual classroom opportunities, online collaboration forums as well as traditional face-to-face training, whereby experience patent examiners in IP Australia provided one-to-one mentoring assessment and intensive training on a full-time basis for up to two years. The inaugural program had commenced on April 8, 2013, with training being provided to eight participants from Malaysia, Indonesia, Philippines, Kenya and the African Regional Intellectual Property Office. The Delegation indicated that the program was the most significant development cooperation activity undertaken by IP Australia for many years, which had been made possible by financial support from the ASEAN-Australia-New Zealand Trade Agreement Economic Cooperation Work Program. In addition, WIPO had funded the participation of the African Offices in the program.

229. The Delegation of Belgium, speaking on behalf of Group B, expressed satisfaction for the excellent quality of the report provided by the International Bureau on PCT-related technical assistance and reiterated its position that discussion of PCT-related technical assistance in the Working Group should await the outcome of the ongoing discussions of WIPO technical assistance in the CDIP.

230. The Delegation of Japan supported the statement made by the Delegation of Belgium on behalf of Group B, and thanked the International Bureau for their efforts on technical assistance in the PCT system, which was provided in an effective and comprehensive manner, as shown in the Annex to the document.

231. The Delegation of Algeria, speaking on behalf of the African Group, noted the comments from some other delegations that similar development issues were being discussed in the CDIP and enquired about the possibility of the document being submitted to the CDIP for its consideration.

232. The Chair replied to the question from the Delegation of Algeria by indicating that the Working Group could submit the document to the CDIP or any other body; this would be a decision for the membership of the Working Group to take. The Chair therefore asked delegations whether the report should be submitted to the CDIP, and if so, for what purpose would the report be submitted to this body.

233. The Delegation of Belgium underlined the importance of avoiding duplication of work, stressing that the CDIP already had two documents from the International Bureau with links to PCT-related technical assistance to consider at its next session, namely, the Management Response to the External Review of WIPO Technical Assistance in the Area of Cooperation for Development (document CDIP/9/14), and the Status of Implementation of Certain Recommendations Extracted from the Report on the External Review of WIPO Technical Assistance in the Field of Cooperation for Development (document CDIP/11/4). The Delegation therefore did not consider it necessary to submit the document to the CDIP, as there were already means to discuss PCT-related technical assistance in this Committee.

234. The Delegation of Switzerland supported the position of the Delegation of Belgium as the CDIP already had documents to consider that discussed activities undertaken on technical assistance. The Delegation therefore questioned whether it would be appropriate to send a further document to the CDIP, which could increase the risk of redundancy or duplication in the discussions. The report on PCT-related technical assistance had regularly been referred to by the Working Group. Delegations requiring more information on this subject could therefore look at the comments made in the discussion in the Working Group, leaving a more general discussion to take place in the CDIP, which could take into account the various other aspects of technical assistance provided by WIPO.

235. The Delegation of Brazil disagreed with the comments made by the Delegations of Belgium and Switzerland that submission of the document to the CDIP would result in duplication of work. The document provided evidence of the efforts of the Working Group to implement the Development Agenda and make the PCT more inclusive for developing countries, which would greatly benefit the work of the CDIP.

236. The Delegation of India considered that technical assistance activities needed to be discussed in the CDIP in a holistic manner, with a proper mechanism to submit the document on PCT-related technical assistance for its consideration by the CDIP. Alternatively, there should be a full discussion of PCT-related technical assistance in the Working Group, relating this to the External Review of WIPO Technical Assistance in the Area of Cooperation for Development.

237. The Delegation of Algeria, speaking on behalf of the African Group, responding to the comments made by the Delegations of Belgium and Switzerland, did not believe that the submission of the document to the CDIP would have an impact on duplication of work. The Delegation of Algeria had suggested submitting the document to the CDIP on the basis that Group B preferred to await the discussions of the External Review of WIPO Technical Assistance in the Area of Cooperation for Development in the CDIP before further consideration of technical assistance related parts of the PCT Roadmap by the Working Group. The Delegation therefore considered it contradictory that members of Group B were advocating that a document on technical assistance should not be submitted to the CDIP to assist in its deliberations on this subject and requested further clarification from these delegations.

238. The Delegation of Belgium, speaking on behalf of Group B, acknowledged the interesting debate on PCT-related technical assistance and thanked the delegations who had contributed to the discussions, particularly the example of technical assistance in examiner training described by the Delegation of Australia. The Delegation of Belgium also stated that it was willing to discuss PCT-related technical assistance further in the Working Group. However, the CDIP had two documents to consider on technical assistance currently being undertaken or already implemented to serve as the basis of further discussion at its next session, adding that Member States in the CDIP were free to make further proposals to add to the debate in this forum.

239. The Delegation of Brazil suggested that the document could be submitted as information to the CDIP to take note of since it provided examples of activity in implementation of the Development Agenda.

240. The Chair noted the differing positions taken by delegations on submitting the document to the CDIP and the possible solution proposed by the Delegation of Brazil. However, as all delegations were aware of the contents of the document, the Chair questioned the purpose of its submission as an information paper to the CDIP. Given that any member of the CDIP could make reference to the information in the document in the context of the discussions in the CDIP and the lack of consensus in the Working Group, the Chair concluded that the document would not be submitted to the CDIP.

241. The Working Group noted the contents of document PCT/WG/6/11.

APPOINTMENT OF INTERNATIONAL AUTHORITIES

242. Discussions were based on document PCT/WG/6/4.

243. The Secretariat, introducing the document, recalled that at the sessions of the Committee for Technical Cooperation and the Assembly in 2012, the Delegations of Spain, Portugal and the Russian Federation, and the representative of the European Patent Office, had stated that there was a need to review the requirements and procedures for appointment as an International Authority. To facilitate such a review by Member States, the Secretariat had put together the document, which outlined the current requirements and procedures for appointment. The document also provided some background information on discussions at the Washington Diplomatic Conference, pointing out that, although the provisions of both the Treaty and the Regulations were drafted in a way that they provided for more than one International Authority to be tasked with carrying out international searches and international preliminary examinations, the Treaty also included a specific reference to the goal of creating a single International Authority. The document also elaborated on developments in the requirements and procedures for appointment of International Authorities, the number of which had risen from seven to 18, of which 16 were active, the most recent being the Egyptian Patent Office, which began operations on April 1, 2013. The role of the Committee for Technical Cooperation was also discussed which had, in recent years, rarely met as a true expert body but more as formality and at the same time as the Assemblies of the Member States of WIPO. Furthermore, the document showed distribution of workload between the International Authorities; almost 94 per cent of all searches were performed by the European Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, the State Intellectual Property Office of the People's Republic of China and the United States Patent and Trademark Office. Interestingly, while many International Authorities were able to carry out searches and preliminary examinations for non-resident applicants, most of the work was performed for domestic applicants. Finally, the document listed some issues for consideration by the Working Group in deciding whether current requirements and procedures should be reviewed, noting that the existing requirements, save for some minor changes in recent years, were drafted in the context of the situation in 1970. The Working Group was therefore invited to discuss whether the existing Rules and Guidelines truly reflected what is necessary to provide the high quality of the international search and preliminary examination envisaged by the PCT, and whether the processes for appointment and extension of appointment of International Authorities were appropriate and in line with the current wishes of Contracting States; that is, both in terms of the number, regional and linguistic distribution of Authorities, and also in terms of the level of scrutiny appropriate to evaluate the ability of Offices seeking appointment to perform search and examination to the necessary high standard.

244. The Delegation of the Russian Federation stated that, as indicated in paragraph 14 of the document, there had only been one substantive change to the requirements for appointment of International Authorities in more than 40 years. Therefore, the Delegation did not consider that the existing Rules and Guidelines truly reflected what was necessary to provide the high quality of international search and preliminary examination envisaged by the PCT, and that a review of those requirements was indeed needed to strengthen and ensure the quality of PCT work products. The objective of such a review should be to ensure that Offices seeking appointment as International Authorities continued to meet the highest levels of quality expected from them by users of the PCT.

Moreover, given that the Committee for Technical Cooperation had rarely met as a true expert body able to give meaningful advice to the PCT Assembly on the appointment of International Authorities, a review of the appointment procedures was also needed to ensure that each request for appointment was assessed with respect to the established requirements in a fair and transparent manner, and to ensure that the PCT Assembly was properly advised on all relevant elements, as required by Article 16(3)(e). In view of the above, the Delegation proposed that the Working Group should recommend that the PCT Assembly task the International Bureau with an in-depth review of the requirements and procedures for the appointment of International Authorities and with developing appropriate revisions to these requirements and procedures. The Delegation further proposed that any such revisions should be developed in consultation with the Meeting of International Authorities and would not affect any Office already holding an appointment at the time of entry into force of the revised requirements and procedures. In this context, the PCT Assembly could also decide to limit the number of Offices holding an appointment as an International Authority to the current number until entry into force of any revised requirements and procedures. This limitation would not only ensure the ongoing quality of the PCT work products by those Offices currently acting as an International Authority, but would also provide assurance to an Office considering submitting an application to become an International Authority as to the exact requirements needed to be satisfied in order to become an International Authority.

245. The Delegation of the Republic of Korea fully supported the proposal from the Delegation of the Russian Federation. The Delegation added that a number of Offices at the most recent session of the Meeting of International Authorities had stressed that the Committee for Technical Cooperation should act as a proper technical advisory body to the PCT Assembly with regard to an Office meeting the technical and legal requirements for appointment as an International Authority (see paragraph 108 of document PCT/MIA/20/14), noting that the Committee for Technical Cooperation was being convened essentially as a formality during the same period as the WIPO Assemblies.

246. The Delegation of the United States of America stated that it shared concerns regarding the adequacy of the requirements for appointment of an International Authority in the current intellectual property environment. The work products generated by the PCT system were increasingly being relied upon by national Offices, applicants, and third parties as accurate tools for the assessment of patentability, due in large part to the recent improvements made by International Authorities and their increased level of commitment to quality. Since the requirements for appointment of an Authority were first drafted, the fields of technology as well as the complexity level and the amount of art in each field had expanded greatly. Additionally, the number of filings continued to rise year after year. All of these factors combined to increase the burden on International Authorities to produce quality search reports, written opinions and international preliminary examination reports. In order to continue the increasing acceptance of the international work products, and to ensure that any Offices which desired to become an International Authority were able to meet the level of quality demanded by the users of the PCT system, it seemed that the requirements should indeed be updated to reflect the realities of the 21st century. Therefore, the Delegation strongly supported the proposal by the Delegation of the Russian Federation that the International Bureau, working in conjunction with the Meeting of International Authorities, be tasked with reviewing the requirements and procedures by establishing a proposal for updating those requirements and procedures, with the caveat that the adoption of any new requirements should not affect the appointment of any current Authority, and that the number of authorities be limited to the current level until such time as any new requirements were adopted.

247. The Delegation of the European Patent Office supported the proposal made by the Delegation of the Russian Federation in its entirety and agreed with the comments made by other delegations who had taken the floor. The proposal would offer the opportunity to update the requirements that International Authorities and Offices seeking appointment should comply with to ensure that the quality of work met the expectations of users as well as designated Offices so that international work products could be better reutilized and therefore more effective.

248. The Delegation of Japan underlined the importance of International Authorities providing a high quality international product to enable the PCT system to function effectively. The discussion of the appropriate requirements and procedures for being appointed as an International Authority was therefore desirable from the perspective of making continuous improvements to the PCT system. In particular, it was important to review whether the existing requirements and procedures were adequately addressing not only the technical scope, which had expanded and become more complex, but also the development of information technology in recent years. In conducting the review of requirements and procedures, the Delegation believed that a number of issues should be considered, such as whether the current requirements were appropriate, whether any of the requirements were no longer necessary, and whether any new requirements were necessary for preparing high quality international search reports and international preliminary examination reports. On the other hand, it should be noted that reviewing the existing requirements and procedures, such as the number of examiners and capacity of examination, would not excessively narrow the scope of opportunity for Offices to be appointed as an International Searching and Preliminary Examining Authority from the perspective of fairness between the Offices already appointed and those Offices seeking to be appointed in the future.

249. The Delegation of China considered that the purpose of the minimum requirements for appointment of Offices as International Authorities should be to ensure that any Office being appointed did fulfill the task of providing the services of international search and preliminary examination. The Delegation generally supported reviewing and updating the appointment requirements to see whether the existing rules and guidelines truly reflected what was necessary to provide international search and preliminary examination. On the other hand, high quality service was important, which should be convenient and accessible to applicants from countries of different development levels and languages by ensuring that any national Office in a Contracting State fulfilling the minimum requirements as to manpower and documentation had the possibility to be appointed as an International Authority. As to the appointment procedure, the Delegation hoped that members of the Committee for Technical Cooperation could provide valuable opinions and suggestions based on their professional capacities.

250. The Delegation of Switzerland fully supported the proposal from the Russian Federation, which aimed to improve quality and ensure a transparent procedure.

251. The Delegation of Hungary believed that the requirements for appointment of International Authorities should ensure high quality service. However, as there might be Offices currently preparing requests for appointment as an International Authority, it would be unfair to limit appointments by not allowing for any increase in the number of International Authorities until a new set of rules was adopted. The Delegation therefore could not support this limitation in the proposal by the Delegation of the Russian Federation, but was favorable to having a review of the existing appointment criteria by the International Bureau working together with the Meeting of International Authorities. While this review was being performed and any new requirements and procedures were still to be put in place, appointments of new International Authorities should continue to take place under the current requirements.

252. The Delegation of Australia stated that, in general, it believed that the rules and guidelines provided sufficient protocol to enable an Office to be appointed as an International Authority. With this mind, the Delegation believed that a careful study needed to be undertaken before making proposals to change the current requirements and procedures. IP Australia had considered minimum numbers of examining staff and had found that, to maintain technical competence to a sufficient depth across the its 11 specific technology streams, approximately 148 effective staff were required. 100 full time employees with sufficient technical qualifications to carry out searches and preliminary examinations should therefore be considered to be the bare minimum. In addition, the development of agreed internal product quality standards would assist high quality international search and preliminary examination being maintained as envisaged by the PCT, and should therefore be in place in all Offices acting as an International Searching or Preliminary Examining Authority.

253. The Delegation of Norway stated that it could not support the part of the proposal made by the Delegation of the Russian Federation on suspending the appointment of new International Authorities. Instead, the requirements as in place today should continue to apply until any changes were agreed.

254. The Delegation of Denmark supported the comments made by the Delegations of Hungary and Norway opposing the limitation of new appointments as International Authorities, stating that it was not clear when new rules and procedures would be put in place. The duration of the limitation on appointments proposed was therefore indeterminate.

255. The Delegation of Chile stated that it was important to begin with the requirements already in place, which it believed were sufficient in order to appoint new International Searching and Preliminary Examining Authorities, and then consider what problems existed with those requirements. It was also important that any exercise carried out in the Working Group to review requirements and procedures took into account the importance of maintaining a system for appointing International Authorities that was accessible to all Offices interested in performing this function if they fulfilled the requirements to ensure quality.

256. The Delegation of France supported fully the proposal expressed by the Delegation of the Russian Federation.

257. The Delegation of Brazil supported the revisions of the requirements for appointment of International Authorities on the understanding that this exercise should not evaluate existing International Authorities, as outlined in the proposal by the Delegation of the Russian Federation. The process also needed to be open and thorough, as indicated by the Delegation of Australia. It was also necessary to discuss what criteria would guarantee a better quality product. On this matter, the Delegation of Brazil expressed a preference for this debate to take place in the Working Group so as to have a broader discussion of elements forming part of the new requirements for the appointment of International Authorities.

258. The Representative of the American Intellectual Property Law Association (AIPLA) referred to the general position of AIPLA in favor of mandatory disclosure of search strategies. In the absence of this mandatory disclosure, there could be concerns that quality levels would fall without a review on rules and procedures on the appointment of Offices as International Authorities, as proposed by the Delegation of the Russian Federation. If there were a proliferation of Authorities, there would be a reduced likelihood of other Offices relying on international work products. However, AIPLA did not take a position on how the rules should apply prospectively.

259. The Chair summarized the discussion on the requirements for appointment as an International Searching and Preliminary Examining Authority, thanking the Delegation of the Russian Federation for its proposals on this matter. The Chair did not see a consensus on a moratorium on the appointment of new International Authorities, pending the outcome of a review of the requirements and procedures for appointment, adding that a number of delegations were opposed to halting new appointments if the current requirements were fulfilled by an Office. However, there was a clear intention to review the requirements, which were limited in number with some possibly being outdated and not so relevant to current issues facing International Authorities. There may also be further criteria that Offices should consider prior to seeking appointment as an International Searching and Preliminary Examining Authority. There was also a general consensus that that a review be led or guided by the International Bureau in consultation with the Meeting of International Authorities, and that the review be an objective and scientific process, detached from the current discussions as to who was being appointed at any particular point in time. Once those criteria had been agreed at the Meeting of International Authorities, the issue could then return to the Working Group prior to approval by the Assembly of a new set of requirements for appointment of an Office as an International Searching Authority or International Preliminary Examining

Authority. However, the Chair did not believe that a review should be conducted on the assumption that there would be a “grandfather clause” that any new criteria would not apply to existing International Authorities, as had been proposed by some delegations.

260. The Secretariat indicated that the International Bureau would be willing to lead a review on the criteria and procedures for appointment of an Office as an International Searching and Preliminary Examining Authority under the PCT, subject to approval by the PCT Assembly. The first step would therefore be for the Working Group to recommend to the Assembly to mandate the International Bureau to undertake this review. However, with regard to “grandfathering”, the Secretariat believed that for a thorough and neutral review to be conducted, it would be necessary to consider the “ideal” requirements for an International Authority without any assumptions that any new criteria would not apply to existing International Authorities. As an example, all Agreements between the International Bureau and International Authorities would need to be renewed in 2017, which would require submission to the PCT Assembly for approval in 2016. If a new set of requirements had been agreed on by that date, it would be for Member States to decide whether the old or new requirements should apply to reappointments of existing International Authorities.

261. The Chair summarized that there would be no embargo on the appointment of new International Searching and Preliminary Examining Authorities, with the current requirements continuing to apply under they were changed. There was support for a review of the appointment criteria with a recommendation to be made to the PCT Assembly to task the International Bureau in coordination with the Meeting of International Authorities with this review, which would not include any assumptions that the new criteria would not apply to existing International Authorities. Rather, the application of any new set of requirements, including a possible “grandfather” clause, would need to be considered by Member States when discussing future implementation of the new requirements.

262. The Working Group agreed to recommend to the PCT Assembly that the International Bureau should undertake a review of the criteria and procedures for appointment of an Office as an International Searching and Preliminary Examining Authority under the PCT and make proposals for necessary changes, if appropriate, in coordination, where appropriate, with the Meeting of International Authorities, for discussion by the Working Group at its next session.

CLARIFYING THE PROCEDURE REGARDING THE INCORPORATION BY REFERENCE OF MISSING PARTS

263. Discussions were based on document PCT/WG/6/20.

264. The Delegation of the European Patent Office introduced the document by explaining that, since April 1, 2007, applicants had been allowed to incorporate by reference parts of the description, claims or drawing under Rule 20 and keep their international filing date. The European Patent Office had incorporated this provision into the Regulations under the European Patent Convention in December 2007 and subsequently withdrawn its notification of incompatibility under the PCT. To date, while certain explanations as to the appropriate procedures under Rule 20 to be applied by receiving Offices had been added to the Receiving Office Guidelines, it had been considered premature to review the overall procedures for incorporation by reference of missing parts until more experience had been gained with processing of requests for incorporation. Over the last few years, the European Patent Office acting as International Searching Authority had noticed that there had been a divergence in practice between several receiving Offices in cases where the full specification, that is the description and the claims, had been erroneously filed, and the applicant had intended to incorporate by reference a complete new specification unrelated to the application as originally filed. In the view of the European Patent Office, the legal framework under Rule 20 made it clear that a description or a set of claims might be considered as a missing part, but incorporation of the whole specification (description and claims) unrelated to the application as filed was not allowed under Rule 4.18. Moreover, the decision of the Board of Appeal of the European Patent Office in case J 0027/10 dated December 9, 2011, had confirmed

that a missing part should only qualify if it was missing from an already filed text, thus an erroneously filed specification would not qualify as a missing part. As designated Offices could review decisions of receiving Offices regarding incorporation by reference of missing parts under Rule 82~~ter~~.1(b), the Boards of Appeal could review decisions of other receiving Offices, applying the legal principle from case J 0027/10. Finally, in addition to the current legal uncertainty, in practical terms, the situation had led to some difficulties. When acting as an International Searching Authority, the European Patent Office had experienced cases where it had established a search report on the basis of a search copy sent by the receiving Office where the claims and the description related to each other, but at a later date, the receiving Office sent a new specification with an incorporation by reference, requesting a new search to be performed. The European Patent Office believed that this situation was not acceptable. The Delegation therefore requested the Working Group to agree on a common understanding on incorporation by reference of missing parts. Either the full specification, that is, the description and the claims, did not qualify as a missing part under Rule 20, in which case the Receiving Office Guidelines should be amended as proposed in the Annex to the document, or a full specification should qualify as a missing part under Rule 20, in which case, the Working Group should agree to amend this rule to clarify the matter.

265. The Delegation of the United States of America sympathized with the situation that the Delegation of the European Patent Office was trying to address, but disagreed with the interpretation of the European Patent Office that the ability of applicants to add a second set of claims or an entire specification was prohibited by the language of Rules 4.18 or 20.5(a). The Delegation believed that this matter had been decided by Member States at the first session of the Working Group and referred to paragraphs 126 and 127 of the report of the session (document PCT/WG/1/16), where it was stated that “the Working Group noted that, in a case where the international application, on the international filing date, contained the necessary claim(s) element and description element (see Article 11(1)(iii)(d) and (e)), it was not possible under Rules 4.18 and 20.6(a) for the claims or description contained in a priority application to be incorporated as a missing element. However, it appeared to be possible, in such a case, for part or all of the description, or part or all of the claims, contained in the priority application to be incorporated under those Rules as a missing part.” This position was further supported by the Working Group agreeing to modify the Receiving Office Guidelines to clarify the procedures to be followed under Rules 4.18 and 20.6 in the circumstances where incorporation by reference resulted in a duplicated set of description, claims or drawings. In this situation, the set incorporated by reference was to be placed sequentially before the originally filed set. In view of the agreement by the Working Group at its first session and the subsequent amendment to the Receiving Office Guidelines, the Delegation believed that the language of Rule 20 clearly allowed applicants to incorporate an entire specification from a prior application. Moreover, the Delegation objected to the interpretation of the Regulations under the PCT by the European Patent Office in that it would establish an inequitable treatment for applicants in similar but slightly different situations. Under this interpretation, an applicant who did not submit a description and claims, whether inadvertently or intentionally, would be allowed to submit them at a later stage by way of incorporation by reference, whereas an applicant who attempted to file a specification but inadvertently submitted the wrong specification would not be allowed to submit the correct elements and would in essence be penalized for attempting to file a complete application, albeit the wrong application. This latter situation, which the practice of the European Patent Office would prohibit, was in fact the type of situation that the Member States were attempting to address when they adopted the practice of incorporation by reference. Referring to the concern expressed in paragraph 7 of document PCT/WG/6/20 that it was unclear when an application contained two sets of description or claims which set should be searched, the Delegation of the United States of America believed that the Working Group at its first session resolved this problem by deciding that a newly submitted description and claims should be arranged before the originally inadvertently submitted set, thereby the later submitted description and claims would be searched. However, the Delegation was sympathetic with the situation referred to in paragraph 8 of the document, where a later submitted description and claims were forwarded to the International Searching Authority after the international search had begun, and agreed that it was unfair for the International Searching Authority to be required to

search an unrelated set of claims when a search had already been performed. Furthermore, the Delegation noted that there was a relation between incorporation by reference of missing parts and the proposals to allow limited Chapter I amendments in the PCT 20/20 Proposals from the United Kingdom and the United States of America (see paragraphs 10 to 12 of document PCT/WG/6/15), which would allow applicants to replace any erroneously submitted set of claims or specification. The Delegation believed that a solution could be found to address all concerns and suggested to refer the matter to the International Bureau to work with the Delegations of the European Patent Office and the United States of America in an attempt to reach a solution that could be submitted to the next session of the Working Group.

266. The Delegation of Switzerland fully endorsed the position stated by the Delegation of the European Patent Office and believed that the interpretation of the Delegation of the United States of America to allow full replacement of a description or a set of claims was not justified under Rule 20.

267. The Delegation of Japan stated that it shared the concerns expressed by the Delegation of the European Patent Office of the possibility of a second international search being required because of the current system of incorporation by reference, but on the other hand, it needed to consider the current system was to provide a remedy for users. The Delegation believed that the proposal in the document needed to be discussed and considered alongside the limited Chapter I amendments in the PCT 20/20 proposals by the United Kingdom and the United States of America. Regarding the proposal in the document to modify the Receiving Office Guidelines, the Delegation believed it was necessary to consider whether this would be sufficient to address the concerns of the European Patent Office without any changes to the Regulations under the PCT. In general, the Delegation believed that it would be difficult for the receiving Office to make a decision based on a technical viewpoint, adding that any decisions made by the receiving Office should remain within the scope of formalities examination.

268. The Delegation of the United Kingdom also sympathized with the difficulties faced by the European Patent Office. However, while the Delegation supported amendment to the receiving Office Guidelines to align them with the Regulations, it was of the view that the Regulations allowed for incorporation by reference of more than one element, including both the description and claims, where appropriate. The Delegation therefore could not agree with amendments that implied that this practice was not permitted and supported the proposal by the Delegation of the United States of America to work further on this issue with the European Patent Office and the International Bureau.

269. The Delegation of China supported the proposal by the European Patent Office for clarifying the procedure regarding incorporation by reference of missing parts, which was beneficial for performing an international search.

270. The Delegation of Canada agreed that duplication of a completed international search as indicated in paragraph 8 of the document was problematic and supported the proposal by the Delegation of the United States of America for working further on incorporation by reference of missing parts.

271. The Representative of the American Intellectual Property Law Association (AIPLA) supported the position of the Delegation of the United States of America. Incorporation by reference was an important part of practice and errors were unfortunately occasionally made. The Representative therefore considered the position of the European Patent Office would be too strict on applicants and supported the proposal by the Delegation of the United States of America for further work on incorporation by reference on missing parts.

272. The Delegation of the European Patent Office indicated its willingness to work with the Delegation of the United States of America and the International Bureau to seek solutions and submit a revised proposal for the next session of the Working Group.

273. The Delegation of the Russian Federation supported the Delegations of the United States of America and the European Patent Office working further on incorporation by reference of missing parts, and believed that there could be value in the European Patent Office circulating examples of deviations in the provisions concerning implementation of incorporation by reference to other Offices to facilitate their understanding of the problems, especially as the proposal of the Delegation of the European Patent Office had been based on practical experience.

274. The Secretariat addressed the comments by the Delegation of the Russian Federation by explaining the problems of incorporation by reference of missing parts with the example of an international application being filed claiming priority from an earlier application but including an incorrect set of claims. As a set of claims were present, this element was not missing from the application. Therefore, the issue at stake was whether the correct set of claims from the priority application could be incorporated into the international application. It was not possible to remove the incorrect set of claims as this would constitute an amendment that was not allowed prior to international search. Therefore, if the applicant incorporated the set of claims from the priority application by reference after the International Searching Authority had completed the search on the application as originally filed, the International Searching Authority would be required under the current legal provisions to carry out a full second search based on the newly incorporated claims which had been inserted before the original claims in the international application without being able to demand a further fee for this second search. Moreover, as European Patent Office acting as a designated Office would probably not recognize the incorporation by reference under the current rulings of the Boards of Appeal, the application would certainly run into difficulties before this Office. There were therefore two issues arising from this example, one for the International Searching Authority about being able to request a second international search fee, and the other for the fate of the application before the European Patent Office, as the jurisprudence of the Boards of Appeal could result in the incorporation being declared to be invalid. The Secretariat therefore indicated its willingness to work together with the Delegations of the United States of America and the European Patent Office to solve these difficulties and return to the Working Group at a later date.

275. The Delegation of the Russian Federation indicated that the response from the Secretariat had addressed the problems that their proposal was intending to solve.

276. The Chair concluded that the Working Group should invite the Delegations of the United States of America and the European Patent Office to work together with the International Bureau and return to the next session of the Working Group with a revised proposal to try to solve the problems of implementing the provisions of incorporation by reference of missing parts.

277. The Working Group invited the Delegations of the United States of America and of the European Patent Office to work together with the International Bureau on a revised proposal to be submitted to the next session of the Working Group.

IMPROVING THE TIMELINES TO ISSUE AND PUBLISH INTERNATIONAL SEARCH REPORTS

278. Discussions were based in document PCT/WG/6/21.

279. The Delegation of the European Patent Office introduced the document by underlining the importance of timeliness in quality as a whole, based on valid expectations by applicants of delivery of work on time. Rule 42.1 currently stated that the international search report should be established either three months from the receipt of the search copy or nine months from the priority date, whichever time limit expired later. This period applied irrespective of the publication date. International Searching Authorities carrying out large numbers of international searches for many receiving Offices not only faced internal challenges to cope with this work load but also were heavily dependent on the timeliness of receiving Offices. The current wording of Rule 42.1 resulted in an unnecessary number of A2 and A3 publications. This caused additional work and cost for the International Bureau as well as inconvenience to applicants by not having the

international search report published together with the international application at 18 months from the priority date. Although much progress had been made on reducing the number of A2 and A3 publications where the European Patent Office had played a role, there remained further room for improvement. Therefore, with the aim to improve further the overall timeliness of A1 publications, the European Patent Office proposed to review Rule 42 with a view to having more international search reports published at the time of international publication by giving International Searching Authorities more flexibility to manage their work load. In the proposed revised Rule 42 set out in the document, there would be a principle of differentiation between applications under priority from first filings. There would be no change for the processing of first filings, meaning that international search reports would have to be established three months from the receipt of the search copy by the International Searching Authority or nine months from the date of filing of the international application, whichever period expired later. The Delegation added that if the latter period applied, the European Patent Office aimed to issue the international search report within six months from the international filing date. Filings under priority would need to be processed with a view to be ready three months from the receipt of the search copy or 17 months from the priority date, whichever time limit expired later, thus leaving one month for the International Bureau to prepare the application for international publication. In the case of a search copy received within 13 months from the priority date, the additional month in the proposed amendments would allow International Searching Authorities to carry out more searches on time but leave resources for any priority files arriving at a later stage. For example, there were instances when the European Patent Office received a search copy at a very late stage, for instance 16 months from the priority date, when it would be almost impossible with the three months timeliness requirement in Rule 42.1 to have the search report ready at 17 months for publication at 18 months. On the other hand, there were cases where the search copy was received twelve months from the priority date or even earlier, where the International Searching Authority would be under obligation to establish the international search report within three months of receipt of the search copy. The proposals therefore provided the necessary flexibility for International Searching Authorities to prioritize applications to conduct searches on time for publication and maximize the number of A1 publications.

280. The Delegation of Australia stated that it understood the pressures on an International Searching Authority to meet the three month time limit to generate an international search report and acknowledged the duplicate efforts when publishing an application as an A2 and A3 document. However, the Delegation did not consider the extension of the time period to 17 months would improve timeliness. Instead, timely transmission of the search copy to the International Searching Authority should ensure that search reports were completed in time for international publication, which was not being addressed by the proposed amendment to Rule 42.1. The Delegation believed that the increased uptake and use of the ePCT by receiving Offices could provide a solution to facilitate the timely transmission of search copies. Moreover, the proposed amendment to Rule 42 would allow International Searching Authorities currently issuing international search reports in a timely manner to move back deadlines in some cases, denying applicants of an early indication of the relevant prior art. In conclusion, while the Delegation of Australia could accept the amendments proposed in the document, it believed that the proposal would reduce one of the intended benefits for applicants in the PCT, early detection of the validity of their application.

281. The Delegation of Japan stated that, in order to achieve the aims of the proposal with a revision to the Regulations, discussion should be continued, carefully considering the following viewpoints. First, with regard to the present three month time limit in Rule 42.1, the Delegation believed that this period had been introduced to make the timing of receipt of international search reports by the applicants appropriate, and therefore thought it necessary to seek opinion from users before deciding on a new time limit for establishing international search reports in order to ensure that the system would not be inconvenient to users. In addition, the Delegation believed that introducing different time limits, depending on whether the applicant claimed priority or not, would require careful discussion to consider fairness to applicants filing international applications directly and those filing international applications based on an earlier priority application by

analyzing the impacts in each situation. Furthermore, in order to improve the timeliness of international search reports, the Delegation believed that it was important to analyze the reason why the international search report time limit was not fulfilled. As pointed out in the PCT Kaizen proposals in document PCT/WG/6/14 Rev., the Delegation indicated its interest in advancing discussions to give thought to possible reasons behind late international search reports, rather than simply responding by setting a longer time limit.

282. The Delegation of the United States of America supported the initiative of the European Patent Office to improve timeliness of international search reports to the extent that it agreed that International Searching Authorities should strive to meet the current requirements with respect to timeliness. In the past few years, the United States Patent and Trademark Office had significantly improved its performance in this area and was now issuing approximately 90 per cent of search reports in time for publication at 18 months from the priority date. With regard to the proposal from the European Patent Office, the Delegation was not necessarily opposed to the proposed amendments to Rule 42 as they would indeed provide International Searching Authorities with more flexibility in managing their applications. However, the United States Patent and Trademark Office had expressed concern at the Meeting of International Authorities in February with respect to whether the time between establishment of the international search report and the written opinion at 17 months and international publication at 18 months from the priority date was sufficient for translations to be performed, since this would be crucial for the proposal to achieve its intended aim of reducing the number of applications requiring A2 and A3 publications. The Delegation therefore asked the International Bureau to provide its comments on this specific point. The United States Patent and Trademark Office considered that this problem was more an issue of perception. While the Delegation appreciated that the International Bureau had recently begun publishing timeliness statistics in relation to date of transmission of the search copy, statistics were still published based on establishment of the international search report with respect to the priority date, rather than being based on the measure of timeliness as set forth in the Regulations.

283. The Delegation of the Republic of Korea acknowledged the heavy work load faced by a number of International Search Authorities and the lack of correlation between the time limit for establishing international search reports under Rule 42.1 and international publication, causing additional work load due to A2 and A3 publications. While the Delegation agreed on a limit for timeliness, it was concerned of the time required to review an international search report and the written opinion.

284. The Delegation of China believed that an international search report published at the same time as the international publication provided valuable reference information for applicants and the public and was one of the most important advantages of the PCT system. However, the key for timeliness of publication of the international search report was receiving Offices and International Searching Authorities strictly abiding by the time limits set out in the Regulations under the PCT. The proposal from the European Patent Office to postpone the time limit of completing the search report for some PCT applications so that the International Authorities had more flexibility to manage their searching tasks had certain rationality. However, the proposed 17 month period was very close to international publication, therefore bringing new pressure on international publication if a large number of search reports were finished close to the expiry of this period. In addition, according to the Regulations, the International Searching Authority was required to send the international search report to the International Bureau and the applicant after it had finalized the report. The proposal would therefore result in some international search reports being delivered to the applicant later than at present, affecting the interests of the applicant. The Delegation of China could therefore not support the proposal.

285. The Delegation of Germany supported the proposal to amend Rule 42 to improve the timeliness to issue and publish international search reports, as it considered this a useful and appropriate tool to achieve this goal.

286. The Secretariat stated that the International Bureau had concerns with regard to moving the effective time limit for establishing international search reports in respect of the vast majority of applications from 16 months from the priority date to 17 months. Those concerns related to both the internal procedures at the International Bureau, as had been alluded to by some delegations, and to the perspective of the applicant. With regard to internal procedures, if the vast majority of applications reached the International Bureau at 17 months from the priority date, it would put immense pressure on operational staff to have the international application published together with the search report and the translation at 18 months from the priority date. The International Bureau currently received the search report approximately six to seven weeks before the date of international publication, leaving sufficient time for the report to be translated. As translation work was largely outsourced, shortening the time limit would clearly affect operations. Moreover, from the applicant's perspective, moving the time limit for establishing the international search report would reduce the time period for applicants to decide whether to proceed further with the application or withdraw prior to publication. While the Secretariat had sympathy for the work load issues of International Authorities, this could be addressed by introducing more flexibility for International Searching Authorities without changing the general aim that international search reports should be delivered within 16 months from the priority date.

287. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) stated that the European Patent Office issued most international search reports on time and acknowledged the pressure to ensure this timely delivery. However, EPI believed that applicants also had a legitimate expectation to have the international search report as early as possible and the present Rule was quite appropriate for setting the time frame for the delivery of these search reports. Shifting the deadline towards the end of the 18 month period before international publication would leave less time for the applicant in the procedure under Chapter II if this was selected and little time to consider a possible withdrawal before international application. EPI therefore could not support the proposed amendment to Rule 42. Instead, what needed addressing was the time for the search copy to be transmitted from the receiving Office to the International Searching Authority.

288. The Representative of the Japan Intellectual Property Association (JIPA) welcomed more applications being published together with the international search report. However, applicants needed time to consider international search reports before international publication. For example, when international search reports were "negative", some applicants withdrew their application to keep the invention secret or avoid it being published as prior art on a subsequent application. While the current provisions in Rule 42.1 allowed applicants appropriate time to consider international search reports, this would not be the case by shortening the time between issuing of the international search report and international publication to one month, as proposed by the European Patent Office. JIPA therefore hoped Offices would continue discussion giving careful consideration to the effect on applicants.

289. The Delegation of the European Patent Office acknowledged the support by delegations towards the goal of establishing international search reports sufficiently on time to ensure publication together with international application at 18 months from the priority date. However, there were also concerns expressed with the proposed change to Rule 42. The Delegation nonetheless stressed the need to continue working on this issue, in particular addressing receiving Offices with delays in sending search copies as a matter of concern for International Authorities and for applicants alike. The Delegation also welcomed further proposals coming from delegations as well as the International Bureau to study further ways to improve timeliness in general.

290. The Chair summarized that there had been no consensus for changing the time limit set out in Rule 42. However, the issue remained of timeliness of international search reports so as to be available both to the applicant in a sufficient amount of time to be able to decide whether to continue to pursue the application, and to be available in enough time to allow the technical preparations to be completed for publication of the international search report at the same time as the international application. Although there was no agreement to change the Rule 42 time limit,

there did appear to be consensus on working on the issues of delays at receiving Offices, and also for International Searching Authorities to ensure that they prioritized their international search work as well as possible in view of the large work load and the general three month period to issue the international search report.

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

291. Discussions were based on document PCT/WG/6/13.

292. The Secretariat introduced the document by reminding the Working Group that, when the Rules requiring written opinions to be established by the International Searching Authority at the same time as the international search report were adopted, it had been decided that the written opinion should be kept confidential until 30 months from the priority date. If no international preliminary examination had been demanded, the written opinion would then be published at 30 months as the "international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)". The discussions in the fifth session of the Working Group suggested that most Contracting States were interested in revisiting the decision to keep these written opinions confidential, but many felt that they needed additional time to consult their user groups and therefore requested the International Bureau to prepare a revised proposal for this session. The Secretariat explained that the exact reasons for the decision to keep the written opinion confidential were not well documented, but two main issues were discussed leading up to that decision. First, there was the analogy with the Chapter II process where such a written opinion established by the International Preliminary Examining Authority was confidential and was never published. Second, there were concerns that the arguments in the written opinion might be detrimental to the interest of applicants, noting that the procedures under Chapter I offered no formal means for response to the written opinion. On the confidentiality issue, the document argued that the Article 38 should not be considered as an absolute barrier to publishing the written opinion. It was clear that the document was established as part of the Chapter I process since, in most cases, the international preliminary examination would not have been demanded. Moreover, the fact that it might be treated later on as a written opinion under Chapter II did not change this situation, adding that the application itself and the international search report also became parts of the Chapter II process but would clearly not become confidential as soon as a demand for international preliminary examination had been made. The Secretariat therefore suggested that the matter was essentially a policy decision, balancing the interests of applicants and third parties. It was clear there was a third party interest in having the written opinion available as early as possible. As for the applicant, it would appear that any damage due to publication of the written opinion would be very limited. The most negative part of an opinion, the fact that a claimed invention was considered to lack novelty or inventive step, could be seen in any case from the international search report; and indeed, in some cases, the publication of the explanations in the written opinion might help show that, although novelty objections had been made against a wide range of claims, these could easily be overcome and so may not be that detrimental to the applicant. Therefore, the first point the Working Group had to consider was whether or not it agreed with the argument in relation to Article 38 that it would be permissible to amend the Regulations to allow for earlier publication of the written opinion, considering whether the balance of interest was indeed in favor of giving more information to the third parties at an early stage. If this were agreed, the Secretariat recommended making the written opinion available immediately from the date of international publication, rather than waiting to see whether a demand for international preliminary examination had been made, since the administrative procedures would be considerably more complex and error prone in the latter situation. Furthermore, the main value to third parties would in any case be lost, as they would probably only look at the written opinion in the international phase if it were published at the same time as the international search report. Consequently, the International Bureau recommended deleting Rule 44*ter*, which would result in the written opinion of the International Searching Authority being given the same publication status

as any other document related to international search transmitted to the International Bureau. In other words, from the date of international publication, it would be part of the file open to public inspection and viewable on PATENTSCOPE.

293. The Delegation of the United States of America stated that it had supported the proposal to make the written opinion publicly available as of the date of international publication since 2002, when it had first proposed establishing a written opinion at the same time as the international search report, which at the time had been called an “enhanced international search”. The proposal was also one of the proposals in the PCT 20/20 document (paragraph 18 of the Annex to document PCT/WG/5/18). Making the written opinion of the International Searching Authority available to the public at the time of publication would promote transparency within the PCT processes, as well as bring the PCT into line with many other national systems which made similar documents available upon national publication. The Delegation also added that the majority of Offices and user groups supported the proposal when responding to Circular C. PCT 1364, dated December 20, 2012 consulting Offices and users on a revised and expanded set of the PCT 20/20 proposals. Furthermore, at the twentieth session of the Meeting of International Authorities in February 2013, the proposal was one of four proposals where “there was particular interest and hope for fast progress in the PCT Working Group” (see paragraph 101 of document PCT/MIA/20/14). The Delegation agreed with the legal and technical analysis by the International Bureau set forth in the document and thus supported the approach in paragraphs 20(c) and 24 to make the written opinion of the International Searching Authority available to the public in all cases from the date of publication by deletion of Rule 44*ter*.

294. The Delegation of the United Kingdom supported making the written opinion available as of the date of international publication, believing that this would reduce duplication, promote transparency and bring the PCT into line with many national systems. It therefore supported the approach in paragraph 20(c) as recommended by the International Bureau to make the written opinion available to the public in all cases from the date of international publication, and it believed that the deletion of Rule 44*ter* to achieve this would be consistent with Article 38.

295. The Delegation of Israel supported the proposal to delete Rule 44*ter*, which would improve transparency and proceedings.

296. The Delegation of Sweden supported the proposed deletion of Rule 44*ter*.

297. The Delegation of Canada supported the proposed deletion of Rule 44*ter*.

298. The Delegation of Finland supported the proposed deletion of Rule 44*ter*.

299. The Delegation of Germany supported the proposed deletion of Rule 44*ter*.

300. The Delegation of Australia supported the proposed deletion of Rule 44*ter*.

301. The Delegation of Japan supported the proposed deletion of Rule 44*ter*.

302. The Working Group agreed to recommend to the PCT Assembly that the written opinion of the International Searching Authority should be made available to the public as of the date of international publication by deleting PCT Rule 44*ter* and, consequential on that deletion, by deleting the reference to Rule 44*ter*.1 in Rule 94.1(b).

RESTORATION OF THE RIGHT OF PRIORITY

303. Discussions were based on document PCT/WG/6/12.

304. The Secretariat introduced the document by explaining that restoration of the right of priority had entered into force in 2007, providing a safeguard for applicants to request an Office to excuse the missing of the priority period when filing an international application. In effect, there were two

points when such a request could be made: first, before the receiving Office close to the time of filing, or second, before the designated Office after entering the national phase. A review or restoration of the right of priority had been presented to the fifth session of the Working Group (document PCT/WG/5/13), which had largely analyzed practices of receiving Offices. In this earlier document, there had been a set of draft modifications to the PCT Receiving Office Guidelines which had been issued as Circular C. PCT 1372 on February 20, 2013 for comments by Offices and user groups. The International Bureau was currently analyzing responses to this Circular and hoped to publish a revised set of the Guidelines on the web site in the near future. However, due to an insufficient number of responses from designated Offices, it had not been possible to perform a meaningful analysis or draw conclusions on the practices of designated Offices at the fifth session of the Working Group. The document for present session therefore focused on designated Offices, where an online questionnaire for designated Offices had been issued. 38 responses had been received to the questionnaire.

305. In relation to designated Offices, the Secretariat explained that there were two main scenarios to consider. First, in cases where a receiving Office had taken a positive decision to request restoration of the priority right, the question arose of how designated Offices should deal with the particular case. The second scenario was where the applicant either had not requested restoration with the receiving Office, maybe because the Office did not even offer the possibility, or had unsuccessfully requested restoration with the receiving Office and was making the same request to the designated Office. In terms of the main findings of the review, even though restoration of the right of priority had been in place for about five years, not many cases had reached the designated Offices. In cases where a positive decision had been taken by the receiving Office, in the majority of cases these positive decisions were upheld by the designated Office, even though the designated Office was entitled to perform a limited review. There was one clear exception foreseen in the Regulations, that is, if a receiving Office accepted the restoration under the “unintentional” criterion, and the designated Office applied the “due care” criterion, which in the average normal case was perceived to be of a higher standard. It was also noted that only a few direct requests under Rule 49*ter* had been made before designated Offices. In addition, a number of Member States and Offices were currently not yet in a position to apply restoration of the priority right having submitted notifications of incompatibility. In this regard, the Secretariat urged Member States to look into whether they could withdraw their notifications of incompatibility, in line with the recommendations of the PCT Roadmap. Furthermore, from the responses received, it had been noticed that it was not always clear which criterion for restoration of the right of priority was being applied by certain Offices, and the Secretariat encouraged Offices to verify the information on their practices available on the WIPO web site so that this information could be complete and accurate for the benefit of applicants. The Secretariat concluded that Rule 26*bis*.3 and Rules 49*ter*.1 and 2 appeared to be working as intended and thanked Offices that had participated in the review.

306. The Delegation of the United States of America thanked the International Bureau for its efforts in presenting the results of the review and informed the Working Group that, with the recent passage of legislation implementing the Patent Law Treaty, the United States of America expected to be able to withdraw its notification of incompatibility in the near future.

307. The Delegation of Sweden appreciated the document and supported its conclusions and recommendation in full.

308. The Delegation of Japan considered the results of the review of restoration of the right of priority to be informative and beneficial. It also indicated that the Japan Patent Office had been working to accommodate the restoration of the right of priority in its intellectual property system, as a step to being able to withdraw its notifications of incompatibility.

309. The Delegation of Israel thanked the International Bureau for the preparation of the modifications to the PCT Receiving Office Guidelines on the interpretation of the due care and intentional criteria, following the review at the fifth session of the Working Group, and stated that it believed the Guidelines could be useful for designated Offices when deciding on requests for restoration of priority right under Rules 49*ter*.1 and 49*ter*. 2.

310. The Delegation of the European Patent Office considered the document to be very useful in gaining a better understanding of the practice of receiving and designated Offices in application of restoration of the right of priority. The Delegation supported the invitation to Offices which still had a notice of incompatibility in force to consider revising national laws with a view to being in a position to withdraw the notice of incompatibility, and fully supported the idea of designated Offices referring to the proposed draft modifications to the Receiving Office Guidelines for useful guidance on the interpretation of the “due care” and “unintentional” criteria.

311. The Delegation of Switzerland thanked the International Bureau for the document and fully endorsed its proposals.

312. The Delegation of El Salvador informed delegations that El Salvador had restoration of the right of priority in case of force majeure or unexpected circumstances, and fully agreed with the recommendations contained in the document.

313. The Delegation of Spain indicated that the Spanish Patent and Trademark Office was close to withdrawing its notification of incompatibility on restoration of the right of priority.

314. The Delegation of China stated that it maintained its notice of incompatibility with national law in respect of the provisions on the restoration of the right of priority. The Delegation nevertheless supported the efforts to give clear guidelines to receiving Offices on practices in the international phase.

315. The Delegation of Mexico stated that it maintained its notice of incompatibility with national legislation in relation to the provisions for designated Offices. However, in light of the results outlined in the document, the Delegation would endeavor to transmit the content of these proposals to the concerned authorities, so that the latter could consider the withdrawal of incompatibility notices.

316. The Representative of the Asian Patent Attorneys Association (APAA) stated that APAA, with its diverse membership, would be willing to provide guidance with regard to interpretation and experience of the due care and unintentional criteria.

317. The Working Group noted the contents of document PCT/WG/6/12.

SUPPLEMENTARY INTERNATIONAL SEARCH

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

319. The Secretariat introduced the document by recalling the decision of the PCT Assembly when reviewing the supplementary international search system in 2012 (paragraph 27 of document PCT/A/43/3), which required the International Bureau to continue to monitor the system for a further three years and report on developments to the Meeting of International Authorities and the Working Group. The document began with an update on the development of the supplementary international search system. Until mid-May, 19 requests for supplementary international search had been received in 2013, 13 to the European Patent Office and six to the Federal Service for Intellectual Property, Patents and Trademarks of the Russian Federation. In addition, the document reported on recent awareness-raising activities and discussed the scope of supplementary international search services offered by International Authorities.

320. The Delegation of the European Patent Office expressed support for the system, providing users with interest in a search report for a particular region or language the opportunity to obtain such a report in a very flexible manner within the international phase. The European Patent Office currently provided a full search as a supplementary international search and had no intention of changing the scope of this service as the supplementary international search could allow users to be dispensed with the search when entering the regional phase before the European Patent Office. As for awareness-raising activity, the European Patent Office conducted a worldwide survey which indicated that about 40 per cent of users were not aware of the existence of the service, rising to 50 per cent of users from the United States of America. The European Patent Office had already started to raise awareness by explaining the system in seminars and presentations it gave on general PCT matters. The European Patent Office also already included standard text on supplementary international search with forms communicating search reports and hoped other International Authorities would also implement such a standard text. In terms of requests received at the European Patent Office, the majority related to searches performed by the State Intellectual Property Office of the People's Republic of China and the Korean Intellectual Property Office, confirming that the system was being used to cover different languages. Moreover, feedback from users had indicated that for the system to become a success, it would be vital to have participation from these Offices and the Japan Patent Office to provide greater language diversity and more supplementary international search possibilities. The European Patent Office therefore hoped these Offices could join the system in the near future.

321. The Delegation of the Nordic Patent Institute was supportive of supplementary international search and announced that it had launched a new supplementary international search service on May 1, 2013. This service provided an option for PCT applicants of choosing a less expensive supplementary international search covering only the documents in Danish, Icelandic, Norwegian and Swedish held in the search collections of the Nordic Patent Institute and its member states. This could therefore be a particularly beneficial option for applications with certain technologies where the Nordic countries have played a leading role, for example, within the oil and gas technology, marine technology, biotechnology, chemistry and pharmaceutical industries. Discussing the low uptake of supplementary international search, the Delegation believed the cause was general lack of awareness, which needed to be addressed before taking any decision to amend or abolish the system. The Delegation therefore fully supported the suggestion to add a standardized text explaining this option on all the forms by which the Authorities communicated the international search report in written form to the applicants as a practical way to raise awareness of the system. In addition, the Nordic Patent Institute intended to be more proactive in promoting these services by including it more prominently in the promotion of its commercial search services.

322. The Delegation of the United States of America stated that it had initially supported the establishment of supplementary international search, largely due to the user groups indicating a strong desire for this to become an additional service in the PCT. However, the clear lack of use of supplementary international search was disappointing, especially in view of that fact that it was the result of a demand from users. In relation to awareness-raising activity, the Delegation noted the low awareness of supplementary international search among users in the United States of America from the survey conducted by the European Patent Office and underlined that the United States Patent and Trademark Office publicized the supplementary search system, for example, by discussing the system in presentations on the PCT system to user groups.

323. The Delegation of the United Kingdom applauded the efforts to raise awareness of the supplementary international search system. In particular, it fully supported the idea of including standard text regarding supplementary international search when communicating the international search report and written opinion. In addition, the Delegation reported that users in the United Kingdom had shown particular interest in the expansion of supplementary international search to other IP5 Offices (in addition to the European Patent Office), and supported broadening the service in this way.

324. The Delegation of Israel reported that it had studied supplementary international search. Applicants in Israel had indicated the high costs of the service as the cause of the low uptake. The expectation from users was that the supplementary international search would focus on aspects other than the main search; in other words, it would indeed be supplementary and much less expensive than the main international search. Another issue was that the lack of an option for supplementary search in any of the three main Asian languages (Japanese, Korean and Chinese). This could be an interesting option for the applicant with a potential market in this region. Finally, as to the plans to provide such service in the future, the Israel Patent Office viewed supplementary international search procedures positively, but had no intention to offer the service in the near future, due to the workload considerations.

325. The Delegation of China appreciated the experience accumulated by the International Authorities offering supplementary international searches and supported continued monitoring of the system and carrying out a further review of the system in 2015. The Delegation noted the desire for more International Authorities to offer supplementary international search, particularly those located in Asia, and indicated that the State Intellectual Property Office of the People's Republic of China (SIPO) was considering the possibility of offering the service in the near future.

326. The Delegation of Japan reported that the Japan Patent Office raised awareness and promoted the supplementary international search service to users through seminars. However, referring to the cost and time needed to revise internal IT systems to make any changes, the Delegation suggested deferring the discussion regarding the inclusion of standardized text on forms until after the review of the supplementary international search system by the Assembly in 2015.

327. The Delegation of the Russian Federation supported many of the views expressed delegations, especially the points made by the Delegation of Israel concerning the need to reduce fees and involve the International Authorities working in the Asian languages used in the PCT. The Delegation also proposed that an accelerated route similar to the Patent Prosecution Highway was offered by a designated Office in the national phase where a supplementary international search had been performed by that Office during the international phase. In relation to communicating standardized text on supplementary international search with international search reports, the Delegation could support International Authorities inserting their own text, but suggested that this be prepared by the International Bureau and then approved, either at the Meeting of International Authorities or at the Working Group.

328. The Delegation of the Republic of Korea supported the supplementary international search system, but the Korean Intellectual Property Office had no intention to offer supplementary international search due to limited resources and the changes required to internal IT systems.

329. The Delegation of Australia informed the Working Group that it had recently updated the information on the IP Australia web site targeted at PCT applicants to promote the availability of supplementary international search. The information could also be found in the IP Australia International Patent Guide. With respect to offering the service, IP Australia did not offer supplementary international search at this stage, adding that it did not cover additional documentation in specific languages beyond the PCT minimum documentation. Nevertheless, the Delegation supported supplementary international search as an option for Authorities to offer their customers.

330. The Representative of the Federation of Industrial Property Attorneys (FICPI) offered an alternative explanation concerning lack of awareness, namely, that it was deeply rooted in the mental landscape of applicants that all additional efforts beyond the minimum search required in a patent application were paid by competitors. For example, the burden was on competitors to make third party observations if they wished, and in any post grant proceedings, the additional searching was performed by competitors of the patent proprietor. Any supplement to the prior art search

provided by an Office was therefore the task of interested parties. It may therefore not be lack of awareness alone that prevented applicants from requesting supplementary international search, but also strong economic considerations.

331. The Representative of the American Intellectual Property Law Association (AIPLA) stated that AIPLA did not have a formal position on supplementary international search but agreed with the comments expressed by the Representative of the Federation of Industrial Property Attorneys. Applicants with a "clean" international search report could be eligible for treatment under the Patent Prosecution Highway and may not have any intention of endangering this possibility by requesting a supplementary international search, paying a fee for work that would best be performed by a competitor. Moreover, even if relevant prior art had been found during the main international search, the cost effectiveness of a supplementary international search had to be considered carefully, as additional searches would probably be performed at the national phase.

332. The Representative of the Asian Patent Attorneys Association (APAA) did not have formal position on supplementary international search, but experience showed that systems with additional searching were of benefit to applicants. However, there was a reticence for supplementary international searches, given the historical situation with some Offices when entering the national phase that the quality and confidence attached to searches conducted in the international phase was somewhat questionable. Therefore, from a practitioner's perspective, the cost/benefit was not sometimes recognized by applicants because of these difficulties when entering the national phase.

333. The Representative of the Japan Intellectual Property Association (JIPA) stated that, as the supplementary international search system was optional, it was necessary to consider the cost effectiveness from the user's point of view. The Representative therefore wished to have more quantitative data, for example, the number of international applications where designated Offices indicated new prior art not cited in the international search report, whether or not findings as to the patentability of the invention in the international phase changed in the national phase, and how many obstructions from designated Offices existed on average.

334. The Chair summarized the discussion by acknowledging the general support for supplementary international search and the interest in the major Asian Offices providing the service. Delegates also indicated that it could be sensible and appropriate where possible to include text relating to supplementary international search in information provided to applicants. However, this was not a mandatory requirement, but something that could be considered when reviewing forms or material provided to customers.

335. The Working Group noted the contents of document PCT/WG/6/5.

STATUS REPORT ON THE COLLABORATIVE SEARCH AND EXAMINATION PILOT PROJECT

336. Discussions were based on document PCT/WG/6/22 Rev.

337. The Delegation of the European Patent Office (EPO) reported on the second pilot project on collaborative search and examination that it had performed with the Korean Intellectual Property Office (KIPO) and the United States Patent and Trademark Office (USPTO). The first pilot project between the three Offices had been on a very limited scale and was more a proof of concept. Following on from the first pilot project, the objective of the second pilot project had been for examiners to work together and establish a high quality international search reports with a more quantitative assessment. The document provided an evaluation of the second pilot by the European Patent Office, including feedback from all examiners, as well as recommendations on how to build on these experiences. The document also contained some results from examiners in the collaboration at KIPO, who also viewed collaborative search and examination as a positive development. On the basis of the second pilot, the Delegation pointed out important factors that

had to be taken into account between projects established in a collaborative manner between Offices, namely, different operational methods, priorities, working procedures, laws and practices. However, it was important to note that the pilot had demonstrated that these constraints could be overcome. Another important factor was that convergence in practices was not always possible, but this had not been the aim of the pilot. Instead, users participating in the pilots had underlined that the real value was to observe a broader patenting landscape in different jurisdictions rather than a uniform opinion, which could allow applicants to adopt a strategy taking into account regional constraints. Overall, the written opinion of the International Searching Authority could be considered as a concatenation from the different Offices. In terms of communication, e-mail was found to be most appropriate and sufficiently interactive, avoiding the cost and scheduling required for a videoconference. E-mail did have one significant disadvantage in not providing sufficient security when dealing with unpublished matter. The second pilot had shown that collaboration increased motivation and usually improved over time once a basic knowledge threshold had been passed. Referring to the ideas to strengthen the link between the international and national phase in the PCT Kaizen proposals (document PCT/WG/6/14 Rev.), the Delegation considered that collaborative search and examination could be seen as an appropriate tool to increase the quality and make the transition between the international and national phases easier and faster for applicants, thereby improving the PCT system and giving additional options to applicants. According to the EPO examiners participating in the pilot, in the majority of the cases, the results obtained in the collaborative phase would be directly usable in the regional phase, even in cases where the EPO examiners were not the primary examiners for the application. However, it had to be underlined that collaborative search and examination could only be seen as an additional possibility for applicants available in parallel with standard PCT Chapter I and some users had expressed concern over the possible cost of a collaborative search as well as the timeliness, even if it could be assumed that users opting for a collaborative search and examination would enter national phases in the collaborating offices. Therefore, the European Patent Office was of the opinion that, should this project be continued, the most appropriate way would be to allow applicants to choose the applications that should be treated in a collaborative manner. The European Patent Office would continue working together on the initiative with the USPTO and KIPO, in particular, looking back at first and second pilot and studying the usefulness of the collaborative reports in regional and national phases. In conclusion, the EPO evaluation of the second pilot showed that collaborative search and examination could be an efficient working scheme leading to time saving solutions rather than incurring cost of additional workload. This was based not only on the fact that the added value was expected, but also on the perception of the European Patent Office of the ability and efficiency to avoid the work duplication.

338. The Delegation of the Republic of Korea stated that eight examiners from the Korean Intellectual Property Office (KIPO) had completed 137 PCT applications during the second pilot project and had analyzed 128 cases either as the first examiner or as a peer examiner. In 92 per cent of all cases, the result from the collaboration had been improved. New citations had been found in 77 per cent of cases, with feedback on issues such as the search strategy, interpretation of claims and prior art or patentability in 71 per cent of cases resulting in the inclusion of additional citations. Examiners at KIPO also shared the view of the European Patent Office on trusting the final product obtained in collaborative manner. In 84 per cent of cases, KIPO examiners would trust the collaborative results in the national phase. In 29 per cent of cases, KIPO examiners would only need additional time for other administrative matters, while in 55 per cent of cases the examiner would require a little more time for a complimentary search. The Delegation was therefore encouraged by the results of collaborative search and examination and the quality of the work in the international phase which could bring potential efficiencies in the national phase examination process.

339. The Delegation of the United States of America thanked the European Patent Office for preparing the report on collaborative search and examination. The Delegation continued to be encouraged by the potential benefits that collaborative search and examination might bring with regard to increasing the quality of the international work products, and to the potential time saving in the national phase examination process. If such a system were eventually adopted, the

Delegation believed that the cost should not be significantly greater than that for the main international search. Otherwise it would be likely that applicants would not support such a system, adding that cost was a reason for the infrequent use of the supplementary international search system. The Delegation acknowledged that the United States Patent and Trademark Office (USPTO) had experienced some operational difficulties in the pilot, primarily related to locating an adequate number of applications in the agreed upon areas of subject matter, and obtaining consent for distribution of unpublished applications to the counterpart International Searching Authorities for use in the pilot. It could be anticipated that in the production environment, these issues would not be an impediment to completing the work, as applicants would have requested collaborative search and examination, thereby consenting to the consideration of these unpublished applications with the partner Offices. Regarding the statement in the sixth bullet of paragraph 14 concerning problems resulting from the use of different classification schemes, the Delegation concurred with this remark, but also noted that some examiners indicated that searching a different classification system actually resulted in additional prior art being found that might not have been found from searching the same classification system. The Delegation also agreed with the statement in the penultimate bullet under paragraph 14 that a collaborative tool would enhance the functionality of the collaborative system or a future collaborative pilot. Patent examiners at the USPTO indicated that having the work reviewed by the peer examiners would be beneficial for several reasons, such as serving to provide validation to their own work products, providing them with additional search terms and strategies that they may not have thought of otherwise, and in discovering prior art in the languages of the peer examiners. Finally, the Delegation noted that there was a certain level of pride to be involved in the collaboration and that the exercise was beneficial simply for the reason that the examiner knew their work would be reviewed and therefore made an extra effort to ensure the work was of high quality. With regard to specific findings concerning applications in phase two, in which the USPTO served as the primary authority, the Delegation reported that in approximately 41 per cent of the applications completed, additional references supporting lack of novelty had been cited in the final international search report. In 23.5 per cent of the cases, additional references supporting lack of incentive step had been cited. Documents defining the general state of the art had been cited in approximately 30 per cent of the cases. In 23 per cent of the search reports presented to peer examiners, the final product remained unchanged from the draft, but there was the aspect of validation of that work product. Additionally, 35 per cent of the applications saw a change in the citation of the same reference to different claims indicating a difference in claim interpretation by the examiners. Overall, in 67 per cent of the applications, USPTO examiners had perceived that the quality was greatly improved by making the final work product more complete and providing confidence in the work product. Feedback directly received from the examiners in administering the pilot also supported the conclusion that collaboration increased the quality of the final work product, which users could have greater confidence in. Finally, regarding the discussion in paragraphs 36 to 43 of the document of the possibility of an applicant-driven third pilot, the Delegation was interested in exploring such a pilot and had had some productive discussions on this subject. However, participation in such a pilot by the United States Patent and Trademark Office would depend on several factors, including agreement on any changes to the pilot framework that would be necessitated by an applicant-driven nature of the pilot, current government resource restrictions and the availability of a collaboration tool for the third pilot.

340. The Delegation of Japan thanked the three Offices involved in the collaborative search and examination pilot project and stated that it would continue to observe the progress of the collaboration while anticipating further refinement of collaborative search and examination. Japanese users had stated that they were looking forward to the results of the project, expressing possible interest in using collaborative search and examination, which would depend on factors such as fees and translations. The Delegation considered that improvement of the overall quality, efficiency and optimization of fees based on the quality and the efficiency merited important consideration. A user-driven pilot would also enable quantitative evaluation of the pilot project by focusing on improving the quality, efficiency and fees, and it would be possible to make predictions on workload and the number of applications if collaborative search and examination were launched. In conducting this evaluation, the Delegation therefore believed that it would be

necessary to consider the perspective of all those involved with the collaborative search and examination pilot project, including the cost and the workload to the IP Offices and the users. One of the concepts of PCT Kaizen (document PCT/WG/6/14 Rev.) was to enhance the quality of search at the international phase by operating the Plan-Do-Check-Act (PDCA) cycle through providing mutual feedback among IP Offices. The Delegation therefore believed that one of the important outcomes of this project was to find out what elements should be further strengthened in order to improve the quality of searches in a single International Searching Authority, based on analyzing the knowledge acquired from this project and then sharing the information gathered among IP Offices.

341. The Delegation of China acknowledged the work between the three Offices in the collaborative search and examination pilot project and hoped the participating Offices could continue to provide information on the ongoing collaboration and work in the future.

342. The Delegation of El Salvador thanked the three Offices for their work in the collaborative search and examination pilot project and agreed with the views and objectives of the pilot. Collaborative search and examination offered potential to improve the quality of international search and preliminary examination and the Delegation looked forward to hearing about further efforts in this area between these Offices in the future.

343. The Representative of the Japan Intellectual Property Association (JIPA) expected that collaborative search and examination would improve the quality of international search reports and written opinions. In particular, users were interested in being able to view the quantitative data collected through the pilot project, especially data that indicated the benefit compared to cases involving a single International Searching Authority. For example, the number of applications for which designated Offices presented new prior art not cited in the international search report, whether or not findings as to the patentability of the invention in the international phase changed in national phase, and the decrease on average in the number of actions by designated Offices would be of interest to users, as these would be linked to the likely amount of the fee for a collaborative search and examination. The Representative therefore requested the participating Offices to make more quantitative data on the project available to users.

344. The Representative of the Federation of Industrial Property Attorneys (FICPI) stated that FICPI viewed collaborative search and examination as a promising step towards increasing quality and urged all International Authorities to join any further continuation of this pilot project or subsequent pilot projects in order to obtain data that were more statistically significant. However, the success of and acceptance of collaborative search and examination would depend on the costs, considered alongside the benefits for Offices, such as work sharing and trust building and a decrease in the time for subsequent processing. All in all, taking into consideration the cost of work in the national phase, FICPI preferred a cost neutral collaborative search and examination. With regard to voluntary collaborative search and examination, the Representative feared that this could attract a similar number of users as supplementary international search, for the reasons explained in his intervention on this subject. The Representative further questioned the relationship between, on the one hand, the proposal to integrate the Patent Prosecution Highway (PPH) into the PCT and, on the other hand, collaborative search and examination during the international phase, and described an awkward scenario of an application fast-tracked under PPH being granted by one Office where other Offices that did not participate in the PPH scheme discovered prior art that put the validity of the application into question. Finally, FICPI perceived some difficulties in the practical and legal implementation of collaborative search and examination if applicants were faced in the international phase with documents by a foreign Office, which the applicant could not understand, that had been evaluated under practices of an unfamiliar patent regime. However, FICPI regarded this as only a secondary problem. Noting that the result of the collaborative search and examination would not be binding in the national phase, the report produced from collaborative search and examination would be a valuable document made available to the public, which could be taken note of by the applicant and interested users.

345. The Representative of the Asian Patent Attorneys Association (APAA) congratulated the three participating Offices, expressed enthusiasm for collaborative search and examination, which would increase the confidence and reliability of the international search product, and looked forward to the third pilot project. The Representative suggested that, to address the comments made by the Delegation of the United States of America about the reluctance of the applicant to allow unpublished specifications to be passed to other Offices, there could be an opportunity to seek a collaborative outcome in Chapter II.

346. The Representative of the American Intellectual Property Law Association (AIPLA) stated that AIPLA supported the possibility of a collaborative search and examination, providing an opportunity at an early stage for the user to obtain a strong first look and a sense of the likely scope of claims that would be ultimately granted. In the view of the AIPLA, a collaborative search might, in the long run, become a substitute for the supplementary international search. The Representative was less intimidated by the fees for a collaborative search and examination. Even if no applicant wanted higher fees, applicants might become more willing to pay extra costs after experience with the collaborative search.

347. The Delegation of the European Patent Office thanked all delegations for their comments and the Delegations of the United States of America and the Republic of Korea for their insights on the collaboration. Addressing the issue of quantitative data, such as how many new citations had been added to the report, this information should be published, but it also needed to take into account the outcome of the application in the national or regional phase. Therefore, for the time being, the information on the collaboration was based on the perception of examiners. The European Patent Office was analyzing the applications from the two pilot projects that had entered the regional phase before the European Patent Office. The United States Patent and Trademark Office and the Korean Intellectual Property Office could also analyze how files from the collaborative pilot projects progressed in the national phase at their respective Offices, for example to determine whether the number of Office actions was less than average and whether new prior art was found in the national phase. However, it was premature to provide such data at this stage, as many of these cases remained pending. It was also premature to determine the potential fee for a collaborative international work product, since the potential benefits in the national phases remained to be analyzed and quantified. In a further pilot project, the Delegation welcomed support from users in selecting applications to be treated in a collaborative manner. All cases in the first and second pilot related to published applications. In future collaborative work requiring the user to opt in, the user would be required to give consent to allow the sharing of any unpublished application between the collaborating Offices. This sharing currently took place by e-mail, but the Delegation believed it would be more appropriate to use a tool allowing for collaboration in a more secure and efficient manner.

348. The Working Group noted the contents of document PCT/WG/6/22 Rev.

THIRD PARTY OBSERVATIONS

349. Discussions were based on document PCT/WG/6/6.

350. The Secretariat introduced the document by reminding the Working Group that the third party observation service went “live” in July 2012. Use had been similar to what had been expected, with an average of slightly less than one observation per day. None of the concerns about possible difficulties and abuse had so far emerged in practice, such as flooding the applicant or designated Offices with prior art of no relevance. In fact, very few of the international applications receiving third party observations had more than two observations made and none had reached the limit of ten, which had been applied as a safety measure. The few observations that had been rejected had generally been rejected due to errors or because the observations clearly related to inventorship, entitlement, clarity or sufficiency rather to novelty and inventive step. Most of the observations, as expected, had been submitted anonymously, which had not caused any obvious difficulties. A large majority had included copies of all the cited documents, sometimes

accompanied by a translation into English of either the whole document or relevant sections of document. Feedback received from people making third party observations had been generally positive. The main request for improvements had been to allow longer explanations, as the present limitation to 500 characters for brief explanations of relevance was considered insufficient, especially for applications with many claims. Some third parties also wished to have the possibility to submit observations on issues other than novelty, inventive step and industry applicability. At the moment, national phase processing had begun on very few of the relevant international applications and it was unlikely that any had yet reached the stage of being examined. The International Bureau therefore proposed to review the system and the request for improvements in more detail in 2014, by which time designated Offices might have some experience of using the observations. Meanwhile, the Secretariat believed the system to be meeting expectations well in accordance with its limited role.

351. The Delegation of the European Patent Office stated that it had experienced that the third party observations system had worked well with no major difficulties, but encouraged third parties to provide translations with observations in case they were needed. The Delegation supported the further improvements to the system proposed by the International Bureau in the document, such as the increase of the 500 character limit. Extending the system to allow observations on clarity and support also had its merits, as such observations were allowed under the third party observations system at the European Patent Office.

352. The Delegation of the United States of America was pleased that concerns about possible abuse had not materialized and requested the International Bureau to continue monitoring the system in this respect. The Delegation expressed interest in having information on how third party observations were relevant and useful in the national phase and hoped this could be provided by the International Bureau at future meetings.

353. The Delegation of Australia fully supported an international system for third party observations and believed this would provide relevant prior art. IP Australia did not yet have the capacity to receive third party observations through the PCT Electronic Data Interchange (PCT-EDI) system, but it checked PATENTSCOPE regularly for any observations. IP Australia had recently received its first third party observation on an international application during international preliminary examination. As tools for automated notification of observations were still being developed, notification was made by the International Bureau. However, it suggested that the Centralized Access to Search and Examination (WIPO CASE) system could be modified to make allowance for notifications of third party observations, which an Office would then be able to retrieve from PATENTSCOPE.

354. The Delegation of China believed that the third party observation system could help improve the quality of examination, both in the international phase and in the national phases, and encouraged users and the public to make use of the system.

355. The Delegation of Chile agreed that the third party observation system was very relevant but, as the system had only been put in place recently, the National Institute of Intellectual Property of Chile had yet to receive any third party observations. However, the Delegation hoped the system would be useful in receiving observations relevant to examination in the national phase and agreed with the proposals by the Secretariat for further improvements and revision to the system.

356. The Delegation of El Salvador joined other delegations in welcoming the third party observations system, which could provide useful information to designated Offices and improve the quality of patents granted. The Delegation also hoped for further efforts to be made to raise awareness of the system.

357. In reply to a question by the Chair to provide further information on the treatment of observations from third parties that were not related to novelty, inventive step or industrial applicability, such as whether the observations were provided to the applicant or sent to national

Offices, the Secretariat indicated that the third party making the observation would be informed if it had been rejected, giving reasons for the rejection. The observation would remain on the file of the application, but would be unpublished and treated as if it had not been made. It would therefore not be available to the applicant or to designated Offices, who would not know the observation had been made

358. The Chair thanked the Secretariat for this further information and suggested that the system might be expanded to other matters, like the system at the European Patent Office, if a significant number of useful observations were received that did not relate to novelty, inventive step and industrial applicability.

359. The Representative of the Japan Intellectual Property Association (JIPA) stated that the effect of the third party observation system on the examination of a patent application by the designated Office was not clear and requested the International Bureau to investigate this issue and make the results of this research available to users on the WIPO web site.

360. The Chair, responding to the request made by the Representative of the Japan Intellectual Property Association (JIPA), indicated that, as the third party observation system had only recently been set up, there was little information about the treatment of applications by designated Offices where third party observations had been received in the international phase. In addition, it was not clear that all national and regional Offices provided information on how third party observations were dealt with from a legal or a procedural perspective on their respective web sites, and the Chair did not consider it worthwhile for the Secretariat to undertake an encyclopedic investigation to consolidate what was available. However, it could prove useful at some time to provide basic information as to how these third party notifications may be dealt with in the national or regional phase and the Secretariat would continue to monitor the treatment of third party observations by designated Office.

361. The Secretariat, in response to the question from the Delegation of Australia about notification of third party observations, indicated that the third party observations documents could be made available through WIPO CASE, and it would be exploring the possibility of a more active notification system to draw attention to third party observations that had been made. A notification feature would also be an important part of the services in ePCT for designated Offices, which the International Bureau intended to launch later in 2013. The Secretariat also urged designated Offices to make the International Bureau aware of situations where they were not able to get hold of observations in an adequate manner and use them effectively in the national phase.

362. The Chair stated that, from his experience being responsible for the work of IP Australia as an International Searching and Preliminary Examination Authority, it had been useful to receive a third party observation for the examiner to take into account during international preliminary examination rather than know the work considering the observation would be duplicated in the national phase. The Chair concluded by highlighting the positive outcome of introducing the third party observation system expressed by delegations, and by showing appreciation for the efforts of the International Bureau to make designated Offices aware of observations submitted on an application.

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

PCT SEQUENCE LISTING STANDARD

364. Discussions were based on document PCT/WG/6/9.

365. The Delegation of the European Patent Office presented the document in its capacity as leader of the Task Force on Sequence Listings created by the Committee on WIPO Standards at its first session in October 2010. The Task Force was currently undertaking a sixth round of discussions on the draft standard to take into account comments received during public

consultations which had taken place in 2012. As many comments from the public required consultation with database providers, the European Patent Office, in partnership with the United States Patent and Trademark Office and the Japan Patent Office, had engaged in discussions with their respective database providers to ensure that these comments were taken into consideration. The draft new standard was expected to be finalized by the end of summer 2013, ready for adoption by the Committee on WIPO Standards at its fourth session in 2014. Following adoption of the new standard, the implementation and transition from the current WIPO Standard ST.25 would be assessed. The Delegation stated that it understood that under the mandate given to the Task Force by the Committee on WIPO Standards and also by the Working Group, the Task Force would pursue efforts to bring the new standard into effect, and it asked for confirmation from the Working Group in this respect.

366. The Delegation of the United States of America stated that it had been working closely with the European Patent Office in the Task Force, and agreed to the timetable as proposed in the document, with expectation of adoption of the new standard by the Committee on WIPO Standards in 2014.

367. The Delegation of Japan stated that it supported the roadmap suggested in the document.

368. The Working Group noted the contents of document PCT/WG/6/7.

PCT MINIMUM DOCUMENTATION

369. Discussions were based on document PCT/WG/6/9.

370. The Secretariat introduced the document, which contained a progress report on the issues currently under discussion in the Task Force set up to prepare a detailed draft of all the technical specifications relating to the proposal to amend PCT Rule 34. Under Rule 34 as proposed to be amended, it would be a right for PCT Contracting States to have the patent documentation published by their national Offices included as part of the PCT minimum documentation, provided that it was made available reliably in a specified electronic format which was easy for International Authorities to load into their databases. The work on this subject was progressing slowly, but there appeared to be a broad consensus on most of the fundamental details, including agreement that the aim of this work should be to promote searching across documentation from as wide a range of national Offices over as wide a period of time as possible. However, work remained to be done in terms of the technical details to encourage Offices to make their documents available in as useful a format for searching as possible, without making these requirements too difficult to deter national offices from making their collections available. Further work was also required on identifying the most appropriate way to express the full range of disclosures, efficiently taking into account modern searching techniques, maximizing the chances of finding relevant prior art in a variety of languages, and avoiding confusion and duplication of effort by considering multiple members of the same patent family several times over. In summary, the work was progressing slowly, but the Secretariat hoped to return to the next session of the Working Group with a positive proposal for an amendment to Rule 34 to improve the range of documentation available to the International Searching Authorities, thereby contributing to raising the quality of international searches.

371. The Delegation of the European Patent Office expressed support for the work performed in the Task Force and indicated that it had already provided extensive written input to the International Bureau on the questions raised in the document.

372. The Delegation of the Republic of Korea supported the proposals by the International Bureau to expand the PCT minimum documentation in principle, which should improve the quality of international search. Discussions to date had focused on electronic data format with a view to improving the usability and the availability of patent documentation, suggesting that patent data should be provided according to a standard, ideally WIPO Standard ST.36 or ST.96. The Delegations added that the use of machine translation services should be considered in order for

examiners to utilize patent documentation for useful searching and examination, which could be studied further by the International Bureau. In relation to the proposal in paragraph 8(b) of the document to analyze the formats of patent information for compatibility with WIPO Standard ST.36 and Annex F of the PCT Administrative Instructions, the Delegation requested WIPO Standard ST.96 adopted in 2012 to be considered in this work. Finally, the Delegation stated that it agreed to the proposals in paragraph 9 on documenting patent collections that the inventory of patent documents in the PCT minimum documentation published by the International Bureau should be regularly updated to reflect the current situation.

373. The Delegation of the United States of America supported the concept of improving the availability of information on prior art. In relation to the questions in paragraph 13 of the document, it noted that it was important to take the costs of making documentation available into account. In some cases, there might not be specific value in adding certain collections to the documentation which might be duplicative if these incurred significant costs. The Delegation supported the timeline for further work along with the inclusion of WIPO Standard ST.96 in the considerations concerning the format of patent information stated in paragraph 8(b) of the document.

374. The Delegation of China believed that the expansion of the PCT minimum document would have a positive effect in improving the quality of international search and the study of relevant technical and legal resources was essential in this work. The Delegation emphasized that the scope and range of the PCT minimum documentation should be clear after expansion and the documentation needed to be accessible and effectively used by the International Searching Authority.

375. The Delegation of El Salvador agreed with the observations made by the International Bureau in the document. The Task Force needed to continue providing observations on the content of the PCT minimum documentation to have more documents included that could be useful for the search examiner and also to continue working on technical information. The Delegation agreed that members of the Task Force would need to reach a consensus about the formats and how updating would take place and asked for more guidance from the Committee on WIPO Standards in this respect. Finally, the Delegation underlined that needs of developing countries should be considered with regard to availability of documentation in particular languages when undertaking any evaluation of costs and benefits of adding further document collections.

376. The Working Group noted the contents of document PCT/WG/6/9.

REVISION OF WIPO STANDARD ST.14

377. Discussions were based on document PCT/WG/6/8.

378. The Secretariat introduced the document by explaining that the Annex included a status report of the work of the Task Force led by the International Bureau that had been established at the second session of the Committee on WIPO Standards in 2012 for revision of WIPO Standard ST.14, dealing with the recommendation for inclusion of references cited in patent documents. There had been two specific requests to the Task Force: (a) to prepare and present a proposal on a revision of category codes provided for in paragraph 14 of WIPO Standard ST.14, and (b) to study the convenience of revising the recommendations in the area of non-patent literature citations to bring WIPO Standard ST.14 closer into line with International Standard ISO 690 2010 which contained guidelines for citing bibliographic references and citations on information resources.

379. The Secretariat updated the Working Group on the outcome of the discussions at the third session of the Committee on WIPO Standards of the status report in the Annex which had been reported in the Summary by the Chair to that session (document CWS/3/13, paragraphs 19 to 23). First, with reference to paragraphs 5 to 9 of the status report, there had been provisional agreement by the Committee on WIPO Standards to include the new citation categories "N" and "I"

and the Committee had agreed to refer the definition of the category “X” back to the Task Force with the guidance to focus on the definition in paragraph 7(a) of the status report, which would exclude category “X” from future use but have a transition period whereby the three category codes “X”, “N” and “I” would exist in parallel. In relation to paragraph 10 in the status report, there had been preliminary agreement to revise the definition of category “P”, and it had been agreed that the combination of categories “E” and “O” with other categories as discussed in paragraph 12 should be optional. For the unusual situation of citing documents sharing the same date as the application searched, the Committee had decided that the Task Force should not focus on the issue and leave the recommendations as they were at present, but should any new code be introduced for this purpose, it should be proposed with a definition. Finally, the Committee for WIPO Standards had agreed that the Task Force would study further the use of citing non patent literature documents in languages other than the language of the document in which they were cited, as referred to in paragraphs 21 and 22 in status report.

380. The Secretariat further reported that the Task Force had met informally during the third session of the Committee on WIPO Standards and had begun discussing details of the necessary transition period for implementation of the revised Standard and the way to reflect the transition in an editorial note in the draft Standard shown in paragraph 16 in the Annex to the document. Participants in the Task Force considered that a transition period beginning with the use of the new categories “N” and “I” and concluding with the ceasing of category “X” should be an option for Offices and those following this approach should make the transition period as short as possible. However, in determining the length of a transition period, the Task Force had highlighted the time for International Searching Authorities to implement the new citation category codes for use in international search reports as an important factor to take into account. The International Bureau therefore intended to consult International Authorities on the length and the implementation of the transition between the category codes and possibly include some drafts to show how the revised Administrative Instructions under the PCT might look if the revised WIPO Standard ST 14 were adopted in the form currently under discussion by the Task Force. The adoption of the revised WIPO Standard ST.14 would take place during the fourth session of the Committee on WIPO Standards in 2014 at the earliest.

381. The Delegation of the United States of America agreed that the proposed modification of WIPO Standard ST 14 would reduce confusion on the part of all users of PCT system. With respect to the question as to whether or not the use of category “X” should be allowed in conjunction with new categories “N” and “I”, the Delegation continued to support a clear transition, whereby an Office beginning to use the new categories would cease using “X”, since use of all three categories could lead to confusion and uncertainty for applicants in interpreting search reports. In addition, the simultaneous use of the three codes could lead to inconsistencies between International Searching Authorities. Therefore, any transition period allowing for the use all three citation category codes needed to be as short as possible, with a firm date established where all International Searching Authorities would be required to use only the “N” and “I” category codes. With regard to the issues raised in paragraphs 11 and 12, concerning whether categories “E” and “O” should be used in combination with other citation categories, the Delegation reiterated that the use of these codes on their own provided little guidance to applicants, third parties, or examiners reviewing search reports, and therefore preferred their use with other codes to be mandatory as presented in paragraph 11(a) of the status report. Therefore, as the Committee on WIPO Standards had chosen to follow the approach set out in paragraph (b) that this should be optional, the Delegation supported the alternative language “should preferably”, as discussed in the final sentence of paragraph 12 of the status report.

382. The Delegation of Canada shared the concerns about inconsistencies and lack of clarity if the use of the three citation categories “X”, “N” and “I” were permitted at the same time, and therefore preferred category “X” to be discontinued when the new citation categories “N” and “I” were introduced. Regarding categories “E” and “O”, the Delegation believed that it would be preferable that they be combined with other citation categories as this would provide further information on the relevance of the document to the claimed subject matter.

383. The Delegation of Japan considered that, before discussing the detail of transition period, it was necessary to determine whether or not the proposal provided in paragraph 7(a) of the status report was acceptable for Offices preferring to use category “X” if a transition period were introduced. There was merit in providing a transition period for Offices to set a time for preparing to switch over to using categories “N” and “I”, but the potential coexistence of “X”, “N” and “I” in a single search report could confuse users and examiners in designated Offices. The Delegation therefore supported the general idea of making the transition period as short as possible, including the option of there being no transition period at all. On the other hand, since the information related to categories “N” and “I” could be acquired from written opinions, the Delegation believed that not introducing categories “N” and “I” and maintaining the current situation was worth considering as a possible way forward, as long as category “X” was necessary for some Offices.

384. The Delegation of the European Patent Office supported the comments made by the Delegation of Japan. The use of citation category “X” had merits, for example, in cases where there were many cited documents relevant for novelty or inventive step when taken alone and it would be unduly burdensome for the examiner to distinguish between “N” and “I” for all of these documents. An approach in the Administrative Instructions under the PCT or the International Search and Preliminary Examination Guidelines whereby examiners could use “N” and “I” for the main cited document, but not necessarily all cited documents, therefore warranted consideration. The Delegation also did not think that the continued use of “X” would cause confusion, believing that this was clearer than “N” and “I” for some documents, given that the assessment of novelty differed between Offices. For example, some Offices included equivalents and trivial modifications in assessing novelty and would therefore probably cite a document “N”, whereas the European Patent Office, applying a strict novelty approach, would probably cite the same document “I”; by contrast, the existing category “X” would be appropriate for all interpretations. The European Patent Office was therefore not in favor of discontinuing the use of citation category “X” and believed that further thought should be given to this issue.

385. The Delegation of Australia aligned itself with the position of the Delegations of the United States of America and Canada regarding the need for a clean transition between the use of category “X” and categories “N” and “I”. While the Delegation could accept a transition period when category “X” could still be used, Offices needed to endeavor to provide a clean transition as and when their system allowed. This would therefore result in clear reports rather than work products with a mixture of the old and new citation categories. Regarding categories “E” and “O”, the Delegation believed that it would be preferable that they be combined with other citation categories, as this would make international search reports more informative.

386. The Representative of the American Intellectual Property Law Association (AIPPLA) supported the position of the Delegation of the United States of America, as it was important to provide as much illuminating information as possible in search reports. A distinction between a citation showing the invention to be a mere incremental step and one that broadly anticipated the application being searched was therefore useful. The Representative also suggested that a minimum number of countries should be ready to implement the new citation category codes together and any transition period should be as short as possible, with a clear cut off date where the old category codes would cease to be used. This would avoid International Searching Authorities gradually switching to the new category codes over a prolonged period, which could be less helpful to users.

387. The Working Group noted the contents of document PCT/WG/6/8.

OTHER MATTERS

PROPOSAL BY BRAZIL

388. Discussions were based on an informal paper presented by the Delegation of Brazil, reproduced in Annex II to this document.

389. The Delegation of Brazil observed that increased use of international preliminary examination under Chapter II could increase the quality of applications entering the national phase and reduce the burdens on elected Offices in examining international applications to ensure that the requirements regarding patentability criteria pointed out in the written opinion of the International Searching Authority and of the national legislation were met. International preliminary reports on patentability under Chapter II provided additional information, for the benefit of examination of PCT applications under the legislation of elected States, and the Working Group was making efforts to improve the quality and timeliness of reports produced under Chapter II, such as the proposal for a mandatory top-up search in document PCT/WG/6/18. However, under the current rules, it was a matter for the applicant to decide whether to request a report under Chapter II; designated Offices could not interfere with this decision. The Delegation therefore considered it useful to discuss the possibility of amending the provisions which regulated requests for international preliminary examination, with a view to increasing the benefits of the Treaty, both to applicants and designated Offices, by allowing the possibility for a designated Office to require Chapter II international preliminary examination to be conducted before national phase entry.

390. The Delegation of Brazil continued by stating that more frequent use of Chapter II was in the interest of both applicants and designated Offices, taking into account that one of the goals of international preliminary reports on patentability was to address the observations set forth in the international applications as pointed out in the written opinion of the International Searching Authority before initiating the national phase of a PCT application. Frequent use of Chapter II could be boosted by granting to designated Offices the right to request from applicants the submission of an international preliminary report on patentability as a condition for entry into the national phase. The following cases were suggested as grounds for designated Offices to request an international preliminary report on patentability under Chapter II: (a) when all of the claims in the international application did not appear to satisfy the patentability criteria, according to the written opinion; (b) when part of the claims did not appear to satisfy the patentability criteria and such claims were not withdrawn by applicants; (c) when the applicant filed amendments under Article 19 or in the national phase entry; and (d) when there was a suggestion by the International Searching Authority/ International Preliminary Examining Authority to amend the claims and such amendments were not done by the applicant. Adapting the PCT to provide for the right of designated offices to request an international preliminary report on patentability would require changes in specific provisions. Nevertheless, a major revision was not envisioned, since the proposal did not purport to change the time limit for making an amendment, nor the beginning of the national phase, nor the Rules regarding the selection, by the applicant, of the International Searching and Preliminary Examining Authority, as provided by the PCT. Specifically, the Delegation added that the proposal did not alter the pertinent provisions of the PCT. The Regulations under the PCT made it fully clear that it was a matter for national legislation of Member States to prescribe the substantive conditions of patentability as it deemed fit, as well as the non-binding nature of the work done by the different International Searching and Preliminary Examining Authorities. In a nutshell, the Delegation believed that PCT members needed such flexibilities to put in place a patent system adequate to meet their needs, while raising the quality of the examination carried out by the national or regional IP Offices and of the work done by the International Searching and Preliminary Examining Authorities under the PCT. Among the expected gains of the proposal, applicants and Offices would be able to fully use measures implemented by the Working Group for the improvement of the work carried out during the international phase. Furthermore, stimulating the use of Chapter II in the international phase would improve the quality of the quality of patents, thus strengthening the PCT system. The Delegation therefore looked forward to engaging in a fruitful discussion in stimulating the use of Chapter II and

requested the International Bureau to prepare a legal opinion regarding the necessity of amending the pertinent provisions of the PCT, should the Working Group agree to discuss this proposal on a more concrete basis.

391. The Delegation of the United States of America appreciated the work of the Delegation of Brazil. With regard to paragraph 2 of the paper, the Delegation of the United States of America pointed out that the stated intention of the PCT system to foster the economic development by perfecting the legal protection of inventions while simplifying and rendering more economical the obtaining of protection was also one of the key goals of the Patent Prosecution Highway. Turning to paragraph 10 of the paper, setting the provision of an international preliminary report on patentability under Chapter II as a condition for national phase entry, the Delegation pointed out that Article 31 of the Treaty only provided for the applicant to be able to request international preliminary examination; this possibility was not available to other parties. Moreover, the Delegation disagreed with the comments in paragraph 12 of the paper that major revision of the Treaty and Regulations would not be needed, given that Articles 22 and 27 set forth the basic requirements and the minimum time limit of 30 months for national phase entry. The Reform of the PCT which had come into force in 2002 had abolished a system where applicants were forced to use Chapter II simply to extend the national phase entry deadline, even if they later decided not to prosecute the application in the national phase. That system had created burdens on International Authorities having to deal with many needlessly filed Chapter II demands, and had created a financial burden on applicants who had been required to use Chapter II if they did not want to enter the national phase already at 20 months from the priority date. However, the Delegation fully agreed with the intention of the proposal to undertake active prosecution at the earliest stage in order to resolve outstanding issues, adding that this was also the driving force behind the proposals from the United Kingdom and the United States of America to require a mandatory response to negative comments in the national phase (document PCT/WG/6/16) and to integrate the Patent Prosecution Highway into the PCT (document PCT/WG/6/17), where the Working Group had not reached an agreement. Overall, the Delegation believed that incentives, such as the possibility for accelerated treatment or fee reductions, were the appropriate mechanism for active early participation by applicants to resolve issues, both of which were components of the PCT 20/20 proposals.

392. The Delegation of Chile agreed with the general idea of the paper in terms of international preliminary examination, which was an important source of information for applicants as well as designated Offices. Changing the situation to require international preliminary examination could lead to significant changes in the functioning of the PCT, which required further analysis to ensure it did not have negative effects, such as overloading the system. The Delegation therefore requested the issue to be discussed further at the following session of the Working Group.

393. The Delegation of Japan considered the proposal to be interesting as a measure to improve the quality of international products and promote linkage between the international phase and the national phase. However, as there had been little time to consider the details, the Delegation requested having a detailed discussion at the next session of the Working Group, which would allow for the possibility to consult with users in the meantime.

394. The Representative of the American Intellectual Property Law Association (AIPLA) stated that AIPLA had not had the opportunity to examine the proposal, but a few preliminary observations could be made at this stage. Just as there had been opposition to integration of the Patent Prosecution Highway into the PCT due to possible implications on national sovereignty, there could be potential for impinging on the sovereignty of Offices by compelling applicants to require an examination earlier in the system, in violation of Article 31. In effect, this could be seen as creating an asymmetry of a faster rejection process occurring with no corresponding faster allowance process. This could affect small businesses, especially those in developing and least developed countries, needing the full 30 months prior to national phase entry to test and commercialize their invention before paying further fees.

395. The Representative of the Asian Patent Attorneys Association (APAA) disagreed with the idea in paragraph 10 of the paper that designated Offices should be given the right to request submission of an international preliminary report on patentability under Chapter II as a condition for entering the national phase. The reality was that more than 90 per cent of applicants did not make a Chapter II demand, showing that Chapter II was not attractive. The Representative could therefore not agree with mandatory use of Chapter II.

396. The Secretariat stated that, while the compliance of the specific proposal with the provisions of the Treaty had to be further considered, one of the agreed recommendations of the PCT Roadmap had been to encouraging the use of Chapter II in appropriate cases to allow applicants to enter the national phase with a “clean” international preliminary report on patentability. About 10 years ago, 90 per cent of applicants had used the Chapter II procedure as they had a strong incentive to do so, namely, an additional 10 months prior to national phase entry. This incentive had disappeared when the time limit for national phase entry had been set at 30 months from the priority date for both Chapter I and Chapter II cases. Noting that the proposal by Brazil also aimed at making the Chapter II process more attractive, the Secretariat would be happy to assist the Delegation of Brazil in assessment of the legal aspects and the options available in this regard.

397. The Delegation of Brazil thanked delegations for the comments made on the paper and reiterated the need for Chapter II to be used more for the purpose of improving patent quality. Regarding the comments made by the Delegation of the United States of America that major changes to the legal provisions of the PCT would be required to implement the proposal, the Delegation wished to discuss the matter further with the International Bureau and reiterated its interest in a legal opinion, which could form the basis of further discussion at the next session of the Working Group.

398. The Working Group noted the intention of the Delegation of Brazil to confer with the International Bureau on what possibilities of this nature might be possible within the scope of the Articles of the Treaty and, if possible, to present a proposal to the next session of the Working Group.

FUTURE WORK

399. 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 September/October 2013 and September/October 2014 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.

400. The International Bureau indicated that the seventh session of the Working Group was tentatively scheduled to be held in Geneva in May/June 2014.

SUMMARY BY THE CHAIR

401. The Working Group noted the contents of the Summary by the Chair in document PCT/WG/6/23.

402. The Working Group further noted that the official record of the session 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.

CLOSING OF THE SESSION

403. The Chair closed the session on May 24, 2013.

404. *The Working Group adopted this report by correspondence.*

[Annexes follow]

MANDATORY TOP-UP SEARCHES

Draft Amendments of the Regulations Approved by the Working Group
(see paragraph 151 in the main body of this document)

Rule 66

Procedure Before the International Preliminary Examining Authority

66.1 and 66.1.bis [No Change]

66.1ter Top-up Searches

The International Preliminary Examining Authority shall conduct a search (“top-up search”) to discover documents referred to in Rule 64 which have been published or have become available to the said Authority for search subsequent to the date on which the international search report was established, unless it considers that such a search would serve no useful purpose. Article 34(3) and (4) and Rules 66.1(e) and 68 shall apply *mutatis mutandis*.

[COMMENT 1: The top-up search would be directed primarily towards “secret prior art” (Rule 64.3) but may also uncover normal “relevant prior art” (Rule 64.1) which had not reached the files of the ISA in time for the main search or evidence of non-written disclosures (Rule 64.2).]

[COMMENT 2: The proposal retains the flexibility to exclude a top-up search if it “would serve no useful purpose”. The final sentence covers the specific cases where the top-up search should be omitted or limited because of no (or limited) main international search, subject matter not to be examined or lack of unity of invention.]

66.2 to 66.8 [No change]

Rule 70

**International Preliminary Report on Patentability
by the International Preliminary Examining Authority
(International Examination Report)**

70.1 *[No change]*

70.2 *Basis of the Report*

(a) to (e) [No change]

[\(f\) The report shall indicate the date on which a top-up search under Rule 66.1*ter* was made,
or else state that no top-up search was made.](#)

[COMMENT: Draft Rule 70.2(f) is intended to allow elected Offices to identify in each case whether an international phase top-up search has been carried out.]

70.3 to 70.17 *[No change]*

[Annex II follows]

COPY OF INFORMAL DISCUSSION PAPER PRESENTED BY BRAZIL
(see paragraphs 388 to 398 the main body of this document)

PROMOTING THE USE OF CHAPTER II OF PCT TO IMPROVE PATENT QUALITY

BACKGROUND

1. At the thirty-sixth session of the PCT Assembly, Members decided to establish the present Working Group as a forum for preparatory work on the improvement of the PCT system for further submission to the Assembly. Brazil has actively participated in the Sessions of the Working Group in light of the shared interest of continuously improving the PCT system as a way of increasing its benefits for applicants and industrial property offices. The Working Group has brought concrete results for the refining of particular Regulations and significant progress was made in the Quality sub-group.
2. The stated intention of the PCT system is to foster the economic development by perfecting the legal protection of inventions while simplifying and rendering more economical the obtaining of protection for inventions where protection is sought in several countries. This objective is made possible to be attained by the legal provisions for use by patent applicants.
3. The Preamble to the PCT also has provisions regarding broader benefits accruing to Members in general and IP offices in particular. These benefits include not only the progress of science and technology made possible by patent protection, but also the facilitation of access by the public to the technical information contained in patent documents.
4. Furthermore, the importance of fostering and accelerating the economic development of developing countries was highlighted, including by promoting the adoption of measures to increase the efficiency of their legal system and to facilitate access to technology and information contained in patent documents.
5. Lastly, the cooperation among nations is defined in the Preamble as a mechanism for greatly facilitating the attainment of these aims.
6. With that in mind, Brazil submits below elements for the consideration of the Working Group regarding acceptance of International Preliminary Examination Report (IPRP) under Chapter II by designated Offices.

PROPOSAL

7. International Preliminary Reports on Patentability (IPRPs) under Chapter II provide valuable information for industrial property offices and may be wholly or partly used in the examination of PCT applications under the legislation of elected States. Members have been consistently concentrating their efforts in the WG on improving the quality and timeliness of IPRPs. Among the tangible results of such efforts are the top-up searching amendment⁵ and the third party observation system⁶ approved in the last session of the Working Group.
8. Under the current rules, it is a matter for the applicant to decide whether to request an IPRP, or not. Designated Offices may not interfere in this decision. Brazil deems it useful to discuss the possibility of amending the provisions which regulate requests for international preliminary examination, with a view to increasing the benefits of the Treaty both to applicants and designated Offices.

⁵ Document PCT/WG/5/11 Add. Mandatory top-up searches are discussed in document PCT/WG/6/18.

⁶ Document PCT/WG/5/7.

9. Brazil submits that more frequent use of Chapter II is in the interest of both applicants and designated Offices, taking into account that one of the goals of IPRPs is to address the observations set forth in the international application as pointed out in the Written Opinion of the International Searching Authority before initiating the national phase of a PCT application.

10. Frequent use of Chapter II could be boosted by granting to designated Offices the right to request from applicants the submission of an IPRP as a condition for entering the national phase.

11. The following cases are suggested as grounds for designated Offices to request an IPRP under Chapter II:

- (a) when all of the claims in the international application do not appear to satisfy the patentability criteria, according to the Written Opinion;
- (b) when part of the claims do not appear to satisfy the patentability criteria and such claims are not withdrawn by applicants;
- (c) when the applicant files amendments under Article 19 or in the national phase entry, and;
- (d) when there is a suggestion by the International Searching Authority/International Preliminary Examining Authority (ISA/IPEA) to amend the claims and such amendments are not done by the applicant.

12. Adapting the PCT to provide for the right of designated offices to request an IPRP would require changes in specific provisions. Nevertheless, a major revision is not envisaged, since the proposal does not purport to change the time limit for making a demand (Rule 54*bis*), nor the beginning of the national phase (30 months) nor the rules regarding the selection, by the applicant, of the ISA/IPEA as provided by the PCT.

13. In specific, this document and the discussion proposed do not purport to alter pertinent provisions of the PCT and the regulations thereof which fully make clear that it is matter for national legislation of members to prescribe the substantive conditions of patentability as it deems fit⁷, as well as the non-binding nature of the work done by the different ISA/IPEA^{8,9}. In a nutshell, it is Brazil's belief that PCT Members need such flexibilities to put in place a patent system adequate to meet their needs while raising the quality of the examination carried out by the national/regional IP offices and of the work done by the ISA/IPEA under the PCT.

14. Among the expected gains of the proposal, applicants and Offices will be able to fully use measures implemented by the Working Group for the improvement of the work carried out during the international phase. Furthermore, stimulating the use of Chapter II in the national phase will improve the quality of the examination of patents, thus strengthening the PCT system.

⁷ Article 27(5): "Nothing in this Treaty and the Regulations is intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires (...)"

⁸ Article 33(1): "The objective of the international preliminary examination is to formulate a preliminary and non-binding opinion (...)"

⁹ Article 35(2): "The international preliminary examination report shall not contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable according to any national law."

15. Brazil looks forward to engaging in fruitful discussions with Member States regarding its proposal of stimulating the use of Chapter II.

16. Should Members agree to discuss this proposal on a more concrete base, Brazil suggests that the International Bureau prepare a legal opinion regarding the necessity of amending pertinent provisions of the PCT.

[Annex III follows]

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