

Patent Cooperation Treaty (PCT) Working Group

Ninth Session
Geneva, May 17 to 20, 2016

REPORT

adopted by the Working Group

1. The Patent Cooperation Treaty Working Group held its ninth session in Geneva from May 17 to 20, 2016.
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): Albania, Algeria, Australia, Austria, Azerbaijan, Brazil, Canada, Chile, China, Colombia, Costa Rica, Czech Republic, Democratic People's Republic of Korea, Denmark, Ecuador, Egypt, Finland, France, Germany, Greece, Honduras, Hungary, India, Iran (Islamic Republic of), Israel, Italy, Japan, Kazakhstan, Kenya, Lithuania, Malaysia, Mali, Mexico, Morocco, New Zealand, Norway, Oman, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Saudi Arabia, Senegal, Singapore, Slovakia, South Africa, Spain, Sudan, Sweden, Switzerland, Thailand, Turkey, Ukraine, United Arab Emirates, United Kingdom, United States of America (59); the following intergovernmental organizations: European Patent Office (EPO), the Nordic Patent Institute (NPI), the Visegrad Patent Institute (VPI) (3).
3. The following intergovernmental organizations were represented by observers: African Intellectual Property Organization (OAPI), African Regional Intellectual Property Organization (ARIPO), Eurasian Patent Organization (EAPO), Patent Office of the Cooperation Council for the Arab States of the Gulf (GCC Patent Office) (4).
4. The following international non-governmental organizations were represented by observers: Asian Patent Attorneys Association (APAA), European Law Students' Association (ELSA International), International Association for the Protection of Intellectual Property (AIPPI), International Federation of Intellectual Property Attorneys (FICPI), Innovation Insights, Institute

of Professional Representatives Before the European Patent Office (EPI), International Federation of Pharmaceutical Manufacturers Associations (IFPMA) (7).

5. The following national non-governmental organizations were represented by observers: Asociación de Agentes Españoles Autorizados ante Organizaciones Internacionales de la Propiedad Industrial (AGESORPI), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA) (3).

6. The list of participants is contained in the Annex.

OPENING OF THE SESSION

7. 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.

8. The Director General informed the Working Group of developments among International Authorities. The Visegrad Patent Institute, which had been appointed as an International Searching and Preliminary Examining Authority by the Assembly at its forty-seventh session in October 2015, would be starting operations on July 1, 2016. Since the eighth session of the Working Group, two International Authorities had started operations: the Intellectual Property Office of Singapore on September 1, 2015, and the State Enterprise “Ukrainian Institute of Intellectual Property” on February 6, 2016. The Director General congratulated these Offices in reaching these important milestones in the commencement of operations. During the week, the Committee for Technical Cooperation would be meeting to provide its advice to the Assembly, which would meet for its forty-eighth session in October 2016, on the appointment of the Turkish Patent Institute as an International Searching and Preliminary Examining Authority

9. The Director General underlined that the PCT was an outstanding example of successful international cooperation. Moreover, it was expected that the PCT would be providing about 77 per cent of the revenue of the Organization for the 2016/2017 biennium. The PCT was therefore an extraordinarily important element to the Organization and an exceptionally important arrangement for all the participating Member States and IP Offices in their various roles as receiving Offices, designated and elected Office, and as International Searching and Preliminary Examining Authorities.

10. The Director General reported on a few of the key developments since the eighth session of the Working Group. At the end of 2015, there were 148 Contracting States, and it was hoped that this would soon reach 150, which would be an extraordinary achievement. The number of international patent applications rose to about 218,000, representing an increase of 1.7 per cent. The increase was lower than in recent years, but it was believed that this could be explained by technical reasons. Moreover, the preliminary indications for 2016 indicated a higher growth rate. There was also wider participation in the system, with international applications being filed in 132 countries, eight more than in 2014. The top applicant in 2015 was again Huawei Technologies of China, which filed nearly 4,000 published PCT applications. In terms of countries of origin of applicants, the United States of America maintained its position as the principal source of international applications with around 57,000 filings, followed by Japan in second place with some 44,000 international applications, and China, which experienced an extraordinary growth rate of 16.8 per cent, in third place with nearly 30,000 international applications. There were also a record number of national phase entries, increasing by 5.2 per cent from 2013 to 2014. In addition, non-resident national phase entries amounted to more than half a million (almost 502,000) for the first time. In terms of the share of PCT national phase entries in non-resident patent filings worldwide, this had risen by 1.4 per cent to about 57 per cent in 2014, demonstrating the achievements of the PCT System.

11. The Director General highlighted the recent significant advances in terms of the electronic environment of the PCT System and encouraged all Offices that did not use the full functionality made available through services, particularly ePCT, to do so. A new “look and feel” for ePCT

was in its advanced stages of preparation and would be deployed later this year, making the system more user-friendly and intuitive. Nearly 94 per cent of PCT applications were filed in fully electronic form. Thanks to the possibility for systems to be hosted by the International Bureau, it was possible for Offices of all PCT Union Contracting States to provide electronic filing for applicants without the need to have their own domestic electronic filing system. WIPO CASE (Centralized Access to Search and Examination) was another IT service that had made important advances in recent years, with growing participation from Offices. If all International Authorities were to participate in WIPO CASE, it would become an even more important add-on and complement to the PCT System in terms of making available information for national Offices to improve the quality of information accessible in decision-making on patent applications.

12. The Director General concluded by pointing out that many of the important items on the agenda concerned questions associated with fees, such as hedging and netting to reduce exposure to movements in currency exchange rates, and the proposal by the Delegation of Brazil in relation to possible fee reductions for universities, notably from developing countries. Recalling that PCT fees constituted 77 per cent of the revenue of the Organization, the Director General advised on the need to exercise care in approaching these questions, given that these touched the financial basis of the whole Organization.

ELECTION OF A CHAIR AND TWO VICE-CHAIRS

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

ADOPTION OF THE AGENDA

14. The Working Group adopted the revised draft agenda as proposed in document PCT/WG/9/1 Rev. 2.

PCT STATISTICS

15. The Working Group noted a presentation by the International Bureau on the most recent PCT statistics¹ and demonstrations of the WIPO IP Statistics Database² and the management reports in ePCT available to Offices acting in their capacity as a receiving Office, International Searching Authority and International Preliminary Examining Authority.

16. In response to a question by the Delegation of Austria on the management reports in ePCT for receiving Offices concerning search copies which had not yet been sent to the International Searching Authority, the Secretariat confirmed that these were based on receipt at the International Bureau of Form PCT/ISA/202 to notify receipt of the search copy. Therefore, there would be applications where the receiving Office had transmitted the search copy, but this would be reported as not being sent either because the International Searching Authority had not yet notified receipt of the search copy through Form PCT/ISA/202, or the International Bureau had not yet processed the notification. In some cases the International Bureau could process the information received automatically, while in other situations, it would take several days as a manual action was necessary. In the latter case, the International Bureau was looking into ways to improve the process.

¹ A copy of the presentation is available on the WIPO website at http://www.wipo.int/meetings/en/details.jsp?meeting_code=pct/wg/9_statistics

² Available on the WIPO website at <http://ipstats.wipo.int/ipstatv2/index.htm>.

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT ON THE TWENTY-THIRD SESSION

17. Discussions were based on document PCT/WG/9/2.

18. The Secretariat introduced the document, which reported on the twenty-third session of the Meeting of International Authorities (MIA) under the PCT and the sixth informal session of the PCT/MIA Quality Subgroup. As in previous years, the focus had been on measures to improve quality. First of all, the Quality Subgroup discussed the further improvement of quality management systems of International Authorities and the International Bureau, including a presentation by the International Bureau on quality management in the PCT Operations Division. Discussions also focused on the further development of quality metrics, which was relevant to the PCT System as a whole, covering not only International Authorities, but also receiving Offices, the International Bureau and designated and elected Offices. The Quality Subgroup had discussed specific improvements for international work products, aimed at making them more useful for other Offices and applicants. In particular, items discussed related to the sharing of search strategies used by International Searching Authorities and the development of standardized clauses in written opinions and international preliminary reports on patentability. Furthermore, the Quality Subgroup discussed quality improvement measures such as improving and updating the International Search and Preliminary Examination Guidelines on Unity of Invention. Finally, the Quality Subgroup discussed quality-related aspects of the procedures for appointment of International Authorities, which aimed at strengthening the requirements relating to quality as regards quality management systems of International Authorities and Offices seeking appointment as an International Authority, and the idea proposed at the informal meeting in 2015 to develop a standard application form for an Office seeking appointment as an International Authority.

19. The Delegation of the United Kingdom stressed the importance of the quality related discussions by the Meeting of International Authorities, and in particular the efforts aimed at sharing search strategies to provide transparency, facilitate work sharing and increase quality. It expressed its interest in participating in the ongoing pilot study carried out by the Japan Patent Office jointly with the Swedish Patent and Registration Office on possible feedback mechanisms for designated Offices on the written opinions and international search reports established by the International Authority, should it be decided to extend that study to other designated Offices. It further indicated its support for the envisaged standard application form for the appointment of new International Authorities and stated that it was considering a requirement, similar to one under trial by IP Australia, under which the applicant entering the national phase was invited to respond to the written opinion or international search and preliminary examination report before starting national examination, making amendments and/or providing comments on the opinion or report, as necessary.

20. The Working Group noted the report of the twenty-third session of the Meeting of International Authorities, based on a Summary by the Chair of that session contained in document PCT/MIA/23/14 and reproduced in the Annex to document PCT/WG/9/2.

PCT ONLINE SERVICES

21. Discussions were based on document PCT/WG/9/17.

22. The Secretariat explained that the document outlined details concerning the development of PCT online services over the past year and priorities for the coming year and beyond. PCT online services had continued to develop over the past 12 months, offering new and improved tools for use by applicants, receiving Offices, International Authorities and designated Offices. The visible face of this was the ePCT browser-based system, but the aim was to ensure that browser-based systems, internal systems and machine interfaces between the International Bureau and Offices all worked effectively together, not only for individual applicants, but also for designated Offices and patent information users who relied on publication of accurate and timely information on events during the international phase. Consequently, the International

Bureau was working not only on tools to applicants, but the background services to make sure that the information entered by one person could be processed effectively elsewhere, as well as monitoring arrangements to ensure that work flowed as efficiently as possible within the international phase. A highlight of this year's developments would be devoted not to new functionality as such but to the usability of the browser-based services, introducing a new user experience, and improved access management systems. The services available using the new access management system would allow more effective secure machine-to-machine services for applicants and offices. By June 1, 2016, ePCT-filing would be operational for 40 receiving Offices, and it was possible to upload subsequent documents to a similar number of Offices in their role as a receiving Office or International Authority. In this regard it was important that information that was visible to applicants and Offices was as complete and up-to-date as possible since delays in documents and data being made available and processed could cause confusion to other Offices processing a given international application. Short term priorities listed in the document were: first, to ensure that applicants could upload documents to their Office through ePCT, second, to ensure that documents were available online, and third, to evaluate the eSearchCopy service as a means of transmitting documents in a consistent electronic format between one Office as a receiving Office and another Office as an International Searching Authority. The International Bureau also encouraged Offices to move towards sending more documents in XML format. This was especially important for international search reports and written opinions from International Searching Authorities, three of which had started to send XML search reports to the International Bureau. Moreover, the latest release of the ePCT browser-based services which would shortly appear in the production environment also provided a means for preparing XML search reports and written opinions. To go with this, there would also be a new arrangement for publishing XML reports and translations to give more effective access to cited documents. Finally, with regard to the amendments to Rule 95 to come into force on July 1, 2017, requiring designated Offices to send information concerning national phase entries, publications and grants, the International Bureau hoped that Offices would take steps to start sending this information as soon as possible. The International Bureau provided systems to assist Offices with this requirement, as well as with retrieving documents and data required for national phase processing, and was willing to discuss these systems with any interested designated Office.

23. The Delegation of Colombia noted the importance of the PCT online service tools and expressed intention to join the DAS and CASE services, not only as system user but also providing priority documents and search and examination results from national patent applications. The Superintendencia de Industria y Comercio in Colombia intended to launch an internal service for database administration in July 2016 which would enable the exchange of documents for digital access which would allow it to participate in these services.

24. The Delegation of the European Patent Office expressed satisfaction with the improvements in ePCT. The European Patent Office had been offering ePCT-filing since 2014 and would be able to accept subsequently-filed documents from November 2016, thereby enabling its users to make full use of ePCT services. The Delegation supported the development of web services, but added that such services should complement batched-based systems, rather than replace them. The European Patent Office already provided international search reports and written opinions in XML format and believed that more International Searching Authorities providing XML reports would substantially help further processing and automate translation. Finally, the Delegation announced that the European Patent Office intended to join WIPO CASE by the end of 2016 and WIPO DAS over the course of 2018.

25. The Delegation of Israel welcomed the development of PCT online services and thanked the International Bureau for the continued efforts to further improve the system to provide an effective and efficient system for applicants and Offices. The Delegation fully supported the idea to expand ePCT services to International Authorities and designated Offices. Regarding the system, the Delegation strongly supported the promotion of eSearchCopy mechanism and considered it as a priority service for applicants in view of the direct impact on the search quality

and timeliness. As International Searching Authority, the Israel Patent Office had started using the eSearchCopy system for receiving international applications filed at the United States Patent and Trademark Office as a receiving Office, and as a receiving Office, the Israel Patent Office was in the evaluation phase of the eSearchCopy pilot with the European Patent Office acting as International Searching Authority. Taking account of the advantages of eSearchCopy, the Delegation hoped the service would be implemented very soon by all International Searching Authorities. In respect of ePCT-filing, the Delegation stated that the system did not comply with national security provisions in Israel, but the Israel Patent Office was working with the International Bureau to create a bibliographic e-filing package, which would allow Israeli applicants to upload bibliographic information as of July 2016. With regard to machine readable data, the Israel Patent Office fully supported a move towards full text and machine-readable formats as an alternative to PDF. The Israel Patent Office was therefore interested in exchanging data in XML format and was willing to transmit test examples for comments and consideration. The Israel Patent Office had also provided information concerning national phase information in XML format since 2015, and from 2017, it was planning to extend this to include data concerning publication and grants. Finally, with regard to certain management reports available in ePCT, the Delegation fully supported the idea to extend ePCT services to International Searching Authorities by the development of reports concerning outstanding search copies and welcomed the development of a “push” system which delivered such reports on a regular basis. The Delegation also suggested that the International Bureau could investigate options for developing management reports to monitor applications where the International Searching Authority had an arrangement with an upper limit on the number of searches, which could help control workload and ensure transparency.

26. The Delegation of the United States of America supported the priorities laid out in the document and indicated that the United States Patent and Trademark Office planned to participate in and support the International Bureau in these areas to the extent that its resources permitted. With regard to the WIPO DAS service for the exchange of priority documents, the Delegation urged further consideration of the use of DAS for the exchange of priority documents in industrial designs and added that the United States Patent and Trademark Office was considering making its design applications accessible via DAS in order to make it easier for applicants to provide such priority documents to the other Offices.

27. The Delegation of Brazil thanked the International Bureau for the electronic services it provided. The National Institute of Industrial Property of Brazil was an active user of PCT online services, with 60 per cent of international applications filed at the receiving Office in 2015 being fully-electronic filings; this figure rose to 75 per cent taking into account all patent applications. A goal of the National Institute of Industrial Property of Brazil was to eliminate the use of paper format in the next years as part of actions undertaken in order to rationalize the processing of the patent applications, improve the workload and raise the compliance with formalities requirements. International cooperation had also brought improvements by allowing access to online tools and patent databases which were later adapted to local demands. The Delegation indicated readiness to engage further with cooperating partners to bring improvements to those systems. Regarding ePCT, the Delegation understood that the system should be open to eventual adaptation in order to ensure that the applications via the system complied with national security requirements and with regard to the collection of fees and to the amendments of applications in the national phase.

28. The Delegation of Chile stated that the National Institute of Industrial Property of Chile had been using ePCT and WIPO CASE for about three years. Last year, it had started accepting filings through ePCT, and more than 60 per cent of international applications were now received through this means. The Delegation welcomed the proposed improvements and wished to see more international search reports being delivered in XML or text format, which would simplify matters in the future.

29. The Delegation of China expressed appreciation for the continuous efforts to improve ePCT and hoped that the security of the system, language and data compatibility, and improved PDF editing could be given attention in the future development of the ePCT.

30. The Delegation of Australia welcomed the ongoing development of ePCT. IP Australia had begun accepting international applications through ePCT since April 14, 2014. As of April 2016, approximately 70 per cent of international applications were filed at IP Australia using ePCT. The Delegation stated that a facility for upfront payment of fees via ePCT was of considerable interest for IP Australia and users. The Delegation pointed out two concerns, namely the availability of foreign priority documents and the format of Chapter II demands. In this regard, the Delegation expressed willingness to work with the International Bureau to investigate these issues, which if rectified would help Office to streamline their internal processes further.

31. The Delegation of Spain stated that the Spanish Patent and Trademark Office expressed support for ePCT and was investigating how ePCT could be integrated into its existing IT systems, including its electronic patent application system.

32. The Delegation of the Republic of Korea stated that it had recently introduced ePCT and eSearchCopy and requested close cooperation with the International Bureau to ensure IT compatibility and successful data transfer. It was important that applicants did not experience any inconvenience using ePCT. The Delegation added that the Korean Intellectual Property Office would endeavor to raise awareness of the ePCT system among applicants through seminars, workshops and other promotional events.

33. The Delegation of Austria stated that the Austrian Patent Office was intensively using ePCT, with was expected to replace its existing filing system. The Austrian Patent Office offered PCT online filing and was now working with the International Bureau to host the online filing server remotely to provide ePCT-filing to applicants. As an International Searching Authority, the Austrian Patent Office participated in eSearchCopy with various receiving Offices, including those of Algeria, Brazil and South Africa, which helped facilitate processing. The Delegation therefore invited other receiving Offices which specified the Austrian Patent Office as a competent International Searching Authority to consider participating in eSearchCopy. Finally, the Delegation informed the Working Group that the Austrian Patent Office was using ePCT to notify the International Bureau of the national phase entry of an application, which it explained was a straightforward process. It was also easy for an Office using ePCT to retrieve documents if transmission from the applicant failed without needing to contact the applicant.

34. The Working Group noted the contents of document PCT/WG/9/17.

STATUS REPORT ON eSEARCHCOPY PILOT AT THE EUROPEAN PATENT OFFICE

35. Discussions were based on document PCT/WG/9/23.

36. The Delegation of the European Patent Office introduced the report, stating that the Office was competent to act as International Searching Authority for 105 receiving Offices and received around 60 per cent of its work as International Searching Authority from other receiving Offices. Consequently, eSearchCopy was a very useful service and it was essential that it worked as intended and was implemented correctly. The aim of the program was to eliminate the exchange of paper so that exchanges between Offices were electronically based. Benefits to the program for the European Patent Office included streamlining procedures, increasing image quality, and improving timeliness. For receiving Offices, transaction flows would be reduced from two to one and paper copies of applications would no longer be printed to send by mail. The pilot, which was launched in January 2016, was being conducted with six receiving Offices, those of Italy, Norway, Israel, Spain, Finland and Japan, which represented a suitable range to verify the requirements and test the benefits across all types of receiving Offices. During the pilot, search copies were being transmitted to the European Patent Office via the

International Bureau and in parallel, paper documents were being transmitted by the receiving Office to the European Patent Office. In this way, the two processes could be compared in terms of timeliness, quality of scanning for documents originally filed on paper, and completeness and consistency of the received documents. To date, the pilot had proceeded generally smoothly, but had nevertheless raised a number of issues which required follow-up with Offices concerned. In view of the results, the system was expected to go into full operation with the Israel Patent Office as receiving Office at the end of May and should be completed with the other pilot Offices during the summer. It was hoped that this would allow the European Patent Office to extend the service to other receiving Offices by the end of the year. Moreover, the European Patent Office had already switched over to the new electronic transmittal process with the International Bureau in its capacity as a receiving Office in February 2016. The Delegation concluded by thanking the International Bureau for its support in the pilot and by inviting all receiving Offices which had specified the European Patent Office as a competent International Searching Authority that were interested in participating in eSearchCopy to make contact to discuss implementation.

37. The Delegation of Israel stated that the Israel Patent Office, in its capacity as a receiving Office, had commenced the evaluation phase of the eSearchCopy pilot with the European Patent Office acting as an International Searching Authority in February, which was expected to last until the end of May 2016. To date, more than 35 search copies had been transmitted electronically to the European Patent Office via the International Bureau. The Delegation was pleased to hear from the Delegation of the European Patent Office of the expected benefits with regard to more timely submission of search copies to the European Patent Office as International Searching Authority, as well as improved quality and data consistency, and it looked forward to moving to the operational phase.

38. The Delegation of Chile stated that eSearchCopy was an efficient system for speedy transmission of search copies to the International Searching Authority and expressed an interest for the National Institute of Industrial Property of Chile, in its capacity as a receiving Office, to participate in the program with the European Patent Office.

39. The Working Group noted the contents of document PCT/WG/9/23.

EFFECTIVE WORK SHARING BEYOND INTERNATIONAL REPORTS: UTILIZATION OF WIPO CASE

40. Discussions were based on document PCT/WG/9/4.

41. The Secretariat introduced the document by explaining that the WIPO CASE – Centralized Access to Search and Examination - system facilitated the exploitation of search and examination work prepared by other Offices to assist national and international search in respect of patent applications. This issue had been discussed on several occasions in the recent past, notably in the context of discussions on the PCT Roadmap, during which Member States had endorsed a recommendation in 2010 which encouraged Offices of PCT Member States to consult the International Bureau on ways of making national reports available to other designated and elected Offices for the purposes of exploitation in the national phase. The recommendation also encouraged the International Bureau and Member States to coordinate this particular activity with other activities aimed at sharing national search reports between national Offices, with a view to minimizing the work involved for Offices in making the reports available and ensuring that they were available to other Offices as easily and effectively as possible. Search and examination reports that had been made available by some national Offices were accessible via PATENTSCOPE. The WIPO CASE platform facilitated the further sharing of information between Offices in both the national and international phases and could become a valuable add-on and complement to the PCT System. The document set out an update on the WIPO CASE platform and described the main features and developments since it first became operational in March 2011 based on work done by the Vancouver Group Offices (Australia, Canada and United Kingdom). In addition, the document described the conditions

for participation, namely either as accessing Offices, taking advantage of what information had been uploaded into WIPO CASE by other Offices, and/or as providing Offices, making dossier content available on the platform to the extent that Offices were willing to provide their own national search and examination work for the benefit of other Offices. The document also described the linkage between WIPO CASE and the IP5 One Portal Dossier system, which was up and running with regard to four of the IP5 Offices. As of February 1, 2016, seven Offices participated in WIPO CASE as both providing and accessing Offices, one Office participated as a providing Office only, and 11 Offices participated as an accessing Office only. The Secretariat strongly encouraged the participation of all Offices of PCT Member States and other intergovernmental organizations acting under the PCT (in their capacity as an International Searching and Preliminary Examining Authority and/or designated/elected Office under the PCT, and in their capacity as an Office searching and examining patent applications under national laws) to take advantage of the WIPO CASE platform to provide and access search and examination information regarding national and international applications. Referring to paragraph 14 of the document, which set out the advantages of the WIPO CASE system, the Secretariat emphasized that the system could complement the PCT System in several ways. During the international phase, International Authorities could access information on search. This would only be of limited advantage to International Searching Authorities, as any earlier applications were unlikely to be published, but would be beneficial to International Preliminary Examining Authorities. Although search reports were available to the public via PATENTSCOPE, WIPO CASE provided the opportunity to share intermediate work products, such as search strategies in accordance with the general guidelines and framework of the system. This therefore allowed Offices to determine what search information they wished to be made available to the public and what information could be limited to other participating Offices. This could therefore provide a medium for International Authorities not making their full search strategies publicly available on PATENTSCOPE to share these strategies with other Offices. All work products produced by designated Offices during the national phase procedure could also be accessed via WIPO CASE, including claims searched, results of any top-up searches and all other standard work products which these Offices wished to make available via the platform. Furthermore, documents submitted for the purpose of the PCT-Patent Prosecution Highway (PCT-PPH) could be shared via the platform and consulted by other PPH offices through WIPO CASE. And finally, WIPO CASE provided an online forum for exchange of information by examiners, which could also benefit the quality-related work of International Authorities. The Secretariat concluded by referring to the most recent discussions at the Meeting of International Authorities in paragraph 16 of the document, and strongly encouraged those Offices not yet participating in WIPO CASE to do so, pointing out that WIPO CASE could be an add-on and complement to the PCT System that could bring many benefits for all stakeholders.

42. The Delegation of the European Patent Office announced that it would be joining WIPO CASE by the end of 2016, so all IP5 Offices would be able share their data through the system. This would be done in two phases. First, the European Patent Office would implement WIPO CASE data into its examiner system for work sharing purposes. At a later stage, by the end of 2016, the European Patent Office intended to integrate all Offices that provided WIPO CASE data to the public into its suite of applications. The Delegation encouraged all Offices to open up file-wrapper data for public access to make as much available via WIPO CASE.

43. The Delegation of the Philippines stated that the use of WIPO CASE at the Intellectual Property Office of the Philippines had grown with the increased familiarity with the platform and thanked the International Bureau for training patent examiners at the Office in its use. More contributions from Offices and International Authorities had also added to the appeal of the platform to users. An advantage of WIPO CASE for users was the convergence of the corresponding applications into one site or platform, so the user no longer needed to access several sites to find information on corresponding applications. The Delegation hoped that access to non-patent literature cited in search and examination reports could be added in the near future to complete the work sharing experience and enable users to understand search and examination reports better. Furthermore, Offices participating in WIPO CASE as an

accessing Office only, like the Intellectual Property Office of the Philippines, could be encouraged to become providing Offices by offering technical support to build up their databases in a format acceptable for sharing on the WIPO CASE platform.

44. The Delegation of Spain hoped that the Spanish Patent and Trademark Office would be integrated into WIPO CASE as an accessing Office in the coming months, adding that this could contribute to improving the quality of its searches and allow access to the IP5 One Portal Dossier.

45. The Delegation of Israel stated that the Israel Patent Office had joined the WIPO CASE platform as a providing and accessing Office in November 2014. Although examiners at the Israel Patent Office mainly used WIPO CASE for locating relevant citations as a last resort, WIPO CASE was a valuable resource with more than 600 documents accessed up to the end of 2015. For further contribution to work sharing, the Delegation recommended the International Bureau to continue to promote WIPO CASE through presentations and/or webinars to encourage more examining patent Offices to join.

46. The Delegation of the United States of America expressed its support for the concepts outlined in the paper which utilized the WIPO CASE platform for work sharing efforts between IP Offices, including the recommendations identified in paragraph 12 of the document. The United States Patent and Trademark Office had joined WIPO CASE in November 2015 as a providing Office and looked forward to becoming an accessing Office in the near future. Both WIPO CASE and the IP5 Global Dossier sought to offer users in IP Offices better access to patent information. The Delegation therefore hoped for additional coordination between the two systems in the future. IP Offices needed to leverage the work of one another to increase efficiency and quality. Accordingly, the Delegation echoed the comments of other delegations for more Offices to join WIPO CASE and make their dossiers publicly available. Regarding the platform, the Delegation asked the International Bureau whether it was possible for a providing Office to restrict access, as appeared to be the case from paragraph 12 of the Terms and Conditions of WIPO CASE.

47. The Secretariat, in response to the question from the Delegation of the United States of America, confirmed that the system currently provided functionality which allowed a providing Office to restrict access to dossier information, as envisaged under the WIPO CASE Terms and Conditions. However, it was hoped that providing Offices would provide access to as wide a user base as possible.

48. The Delegation of Japan endorsed the developments described in the document, which would enhance the usability of the WIPO CASE platform and contribute to further global work sharing. Specifically, the Delegation appreciated the efforts of the International Bureau in increasing the number of Offices participating in WIPO CASE. As a next step, the Delegation considered it necessary to work on promoting further utilization of its content by more examiners in different countries. In the meantime, PCT users had high expectations for information on searches and examinations to be made publicly available via PATENTSCOPE, which would be beneficial for users to check the updated status of examination being conducted by designated Offices. In this regard, the Delegation informed the Working Group that the Japan Patent was going allow public access to search and examination information and encouraged other Offices to do the same.

49. The Delegation of Chile stated that WIPO CASE was a useful tool for improving quality. The National Institute of Industrial Property of Chile was currently an accessing Office only and used WIPO CASE in the PROSUR (regional cooperation system on IP) process between IP Offices in Latin America, but was looking into the possibility of becoming a providing Office as well.

50. The Delegation of the United Kingdom supported the initiative of the International Bureau to encourage participation in the WIPO CASE platform. As one of the Vancouver Group Offices, the United Kingdom Intellectual Property Office was a founding member of WIPO CASE and acted as both an accessing and providing Office. The Delegation also welcomed the suggestion in paragraph 15 of the document that WIPO CASE could become a valuable add-on to the PCT System if all International Authorities would join the platform.

51. The Delegation of Australia stated that, as one of the Vancouver Group Offices, IP Australia was a strong supporter of the WIPO CASE platform. Examiners found the platform very useful as a single portal for easily accessing work products from other Offices. The Delegation was pleased to see more offices using WIPO CASE and to hear the commitment of other Offices to participate in the future. The Delegation also appreciated the work done by other Offices, including the Japan Patent Office, to increase the user base of the platform. The Delegation therefore encouraged further Offices to join WIPO CASE, which would enable more work products to be accessed through a single portal, and stated that it would continue working with the International Bureau to make sure the platform fulfilled its potential.

52. The Delegation of China highlighted that systems for information sharing on international and national applications, such as the Cloud Patent Examination System (CEPS) developed by the State Intellectual Property Office of the People's Republic of China and WIPO CASE, played a positive role in improving quality and efficiency of international work, and that WIPO CASE would have even greater importance with participation from more Offices. However, the Delegation stressed that authorizing public access to the dossier of a patent application was a matter to be determined by the national law of the Office concerned governing the issue of confidentiality.

53. The Delegation of Portugal expressed support for the WIPO CASE platform and was considering the possibility of joining the platform.

54. The Delegation of Colombia commented that the developments of WIPO CASE to encourage reuse of work of other Offices had been positive since it became operational in 2011. Referring to the information on the WIPO website, the five conditions for joining WIPO CASE appeared to be easy to comply with, and Colombia was interested in at least becoming an accessing member.

55. The Delegation of Canada thanked the International Bureau for developing the WIPO CASE database and the efforts to promote its usage, which it supported as a tool for work sharing among Offices. The Canadian Intellectual Property Office used WIPO CASE in four of the five ways described in paragraph 14 of the document, namely, to access search results as both an International Authority and a national Office, to provide intermediate work products as an International Authority and a national Office, and to consult the database for the earlier allowable claims at the Office of Earlier Examination for purposes of the Patent Prosecution Highway (PPH), including the PCT-PPH, when requested to do so. The Delegation encouraged all Offices to consider becoming providing Offices since the usefulness of WIPO CASE increased as more Offices provided their documents, and indicated willingness to share its experiences with Offices that were not participating in WIPO CASE or were only using it as an accessing Office. In the context of increasing usability, the Delegation suggested that the e-mail notification function in WIPO CASE, allowing Office users to receive an e-mail notification when a new document was added to the dossier of a specific application, be improved with a view to allowing users to add a list of multiple applications for which they wished to receive e-mail alerts. Further, the Delegation noted that the function only worked for Offices who provided their documents in certain ways and hoped that it could be extended to cover documents from all providing Offices, or that providing Offices could explore ways to make their content available in a manner that allowed notifications to be used.

56. The Representative of the Japan Intellectual Property Association (JIPA) supported the WIPO CASE system and expressed the hope that more Offices would join in the near future to bring about greater information exchange. The Representative suggested that information in the WIPO CASE system could replace current obligations on applicants to provide such information to accessing Offices, since this information could be retrieved directly from the system.

57. The Representative of the International Federation of Intellectual Property Attorneys (FICPI) concurred with the remarks made by the Representative of the Japan Intellectual Property Association (JIPA) and strongly supported the WIPO CASE system. The system provided a mechanism for sharing search strategies between Offices, which was a very valuable add-on to the system.

58. The Working Group noted the contents of document PCT/WG/9/4.

NATIONAL PHASE ENTRY USING ePCT

59. Discussions were based on document PCT/WG/9/24.

60. The Secretariat gave a brief demonstration of the "proof of concept" system which had been deployed in the ePCT Demo environment, emphasizing that this was not itself intended to be the basis of a pilot but a step to assist discussion of whether this direction of work was useful and what further development would be required to support a pilot. Further, it needed to be clear that this was primarily intended to support collaboration between agents in ensuring that the actions under Article 22(1) or 39(1) required to enter the national phase were carried out accurately and as intended, rather than to be a comprehensive system to address all national phase requirements.

61. The Delegation of European Patent Office expressed interest in participating in the pilot to see how it fitted in with its own procedure. However, a number of issues needed to be taken into account in the system. These included the need for the European Patent Office to have immediate access to documents on their receipt, in line with its legal requirements, and for the system to be available and fully secure. The Delegation was less in favor of a centralized fee payment system in ePCT, as designated Offices had specific fees for national phase entry and centralization of such fee payments and other parts of national phase entry specific to certain Offices could lead to confusion and add to the complexity of developing the system.

62. The Delegation of the United States of America stated that it supported the concept of ePCT to trigger national phase entry in that it related directly to the cross filing functionality envisioned for the IP5 Global Dossier. As indicated at the eighth session of the Working Group, there were legal and logistical concerns that needed to be addressed before such a system could be implemented in the United States of America. However, the Delegation was encouraged by the progress that had been made in establishing a demo system and looked forward to testing and providing input on the system. Furthermore, provided the legal and logistical issues could be resolved, the United States Patent and Trademark Office would be interested in taking part in a pilot as well as working directly with the International Bureau to develop the IT and legal framework for such a system.

63. The Delegation of Australia welcomed exploring improvements to ePCT that could benefit both applicants and Offices, adding that IP Australia received up to 70 per cent of international applications through ePCT. IP Australia looked forward to trying out the system in a demo environment and welcomed the possibility to give feedback so the system met its needs and those of its stakeholders. In this regard, it was important to ensure the system provided for appropriate involvement of local and regional agents and that fees could be paid through ePCT. Accordingly, the issues outlined in paragraphs 20(a) to (c) of the document were of great importance. The Delegation also had legal concerns that needed to be overcome before IP Australia could consider participation in the system.

64. The Delegation of Israel supported the concept of using ePCT for national phase entry and believed that the service would be beneficial for all stakeholders. However, the Delegation pointed out that with regard to payment issues, under patent law in Israel, an international application could not enter the national phase until the relevant fees had been paid. The Delegation therefore agreed with the comments made by the Delegation of the European Patent Office on the proposed centralized payment system. The Delegation of Israel also expressed concerns with regard to certain national requirements, such as translation of the title of the invention, providing an address for service, etc.

65. The Delegation of China appreciated the efforts of the International Bureau for facilitating the national phase entry of applications through ePCT, which would provide more convenient and better services to users. The Delegation therefore encouraged participation in the proposed pilot, but asked the International Bureau about the resources required by designated Offices to take part in the “proof of concept” system. The Delegation also highlighted the legal and technical issues in paragraph 20 which needed to be addressed, such as the national phase entry date and date of payment of fees, which would require legal and technical changes in the national phase in China.

66. The Delegation of Japan stated that, although the document described a “proof of concept” in the demo environment, it was important to consider how the proposed system could be applied in the national procedure once it was made available. In this regard, there were issues to be addressed before the Japan Patent Office could use a system for national phase entry, including the date of receipt of documents and issuing digital certificates. The Japan Patent Office also needed to study the impact that this new system could have on its existing IT systems. The Delegation therefore asked for the International Bureau to provide more details on the proposed demo environment so that each aspect of the system could be verified by Offices to provide feedback to the International Bureau.

67. The Delegation of the Republic of Korea stated that the legal and technical problems of the using ePCT for national phase entry discussed at the eighth session of the Working Group remained unsolved and needed to be considered in the pilot. In particular, the forms in the national phase varied between countries and in the Republic of Korea required parliamentary approval.

68. The Delegation of Chile supported the “proof of concept” pilot and was interested in how the International Bureau could adapt a system to take into account specific features of every designated Office.

69. The Representative of the Asian Patent Attorneys Association (APAA) expressed appreciation and interest in the “proof of concept” system for ePCT national phase entry and noted potential benefits in certain cases of reducing the need for transcription of bibliographic information with its inherent risk of introducing errors. However, APAA stressed that any advantages of using ePCT for national phase entry could be significantly limited due to different languages and different patent laws between Contracting States. According to the document, the core of the system involved the reuse of bibliographic data from the international phase in the national phase, which avoided the traditional transcription of bibliographic data by a local agent that had been received by exchange of e-mails or letters from the international agent. But, in reality, such collaboration between the local and international agent was unnecessary; all the international agent needed to do was provide the local agent with the application or publication number of the international application and the local agent could then obtain the bibliographic information by downloading the data from the international publication. There would also be no advantage in the proposed system where the national phase language was different from the language used during the international phase. Therefore, the Representative recommended a further review of the reality of communication between an international agent and a local agent performing the national phase entry before initiating the pilot, or at least while the pilot was underway. It was also recommended to conduct a review of the number of errors

that had occurred in the bibliographic data in the national phase, and of the risks and additional cost to applicants due to ePCT national phase entry. Notwithstanding these concerns, as the International Bureau intended to commence a pilot, APAA suggested that the pilot should be designed to be operated via a local agent, who would have sole eEditor access rights for national phase entry. In this way, the international agent would have eViewer access rights only, which would ensure that the professional role of the local agent would not be reduced in respect of national phase entry.

70. The Representative of the Japan Patent Attorneys Association (JPAA) understood from the document that the International Bureau did not intend to reduce the role of the national patent agent at this stage. While the JPAA had supported the introduction of the ePCT system, it did not consider there was sufficient information to give a clear image of the proposed pilot and therefore requested further details.

71. The Representative of the Institute of Professional Representatives Before the European Patent Office (EPI) acknowledged that the tool presented by the Secretariat could assist applicants entering the national phase and that designated and elected Offices would scrutinize the system in order to ensure that it reflected the national conditions at each Office. It was, however, important that using ePCT for national phase entry did not give the impression that national phase entry could be left to the last moment, and that the system should not undermine the role of the national agent.

72. The Secretariat clarified that the International Bureau was not intending to take the "proof of concept" into a pilot at this stage. First it was necessary to identify what further work needed to be done before beginning the pilot, which required input from Offices and applicants. The other important factor was that the system was limited to national phase entry and did not cover other aspects of national phase processing. The essential requirements of national phase entry under Article 22 were to provide a translation and pay a national fee. The system would facilitate this process, but could not perform all national phase processing. Referring to the comment made by the Delegation of the Republic of Korea, the Secretariat pointed out that Rule 49.4 stated that no applicant should be required to use a national form when performing the acts referred to in Article 22. The designated Office should therefore not have any problem with accepting national phase entry through ePCT even if the information generated was in a different format from a commonly-used national phase entry form. While furnishing a translation and paying any fee were the only two essential actions on national phase entry, the system would provide other actions as it would be more efficient to perform these at the same time. It was, however, important to engage a national agent to ensure these actions were performed correctly and there was no substitute for the experience that a national agent could bring to the process. Moreover, any applicant leaving national phase entry actions until the last minute without involving a local agent would be ill advised. The system encouraged the early involvement of local agents, but it would never be possible to prevent an applicant from taking actions that were unlikely to be in his own interests. As the next step, the Secretariat proposed that Offices and applicants be asked to comment on the "proof of concept" system, with the possibility for those willing to share their comments to post them on a wiki for others to build on and provide feedback. After receiving comments, whether by e-mail or through this wiki, the International Bureau could consider what changes were required to the "proof of concept" system, whether to begin a pilot, what form the pilot was going to take, and the timing.

73. The Working Group agreed that the International Bureau should issue a Circular to Offices and user groups providing further information on the "proof of concept" system and clarifying the aspects of the system on which comments were particularly sought. Depending on the feedback given, the International Bureau should then propose any further steps and a timetable for a possible move to a pilot system.

PCT USER SURVEY

74. Discussions were based on document PCT/WG/9/11.

75. The Secretariat explained that the survey that had been performed in 2015 was the second PCT User Survey, the first having been conducted in 2009. The survey provided a indicator of user satisfaction with the services provided by the International Bureau and those of Offices and International Authorities performing work within the PCT System. Overall, there were high levels of overall satisfaction for these services, the global satisfaction indicator being 89 per cent for the International Bureau and 83 per cent for Offices and International Authorities. Respondents had made specific comments which would be shared directly with the Offices. The International Bureau expressed its appreciation for the many PCT users which had completed the 2015 survey and shared their experiences and views on the PCT System. From reviewing the results of the survey, the International Bureau had learnt a great deal. It was intended to carry out similar user surveys every two years in the future, with the next survey planned for 2017.

76. The Delegation of Canada welcomed the PCT User Survey and its results. Continuous improvement was a value that the Canadian Intellectual Property Office held dear. It was therefore heartening to see that user satisfaction had increased over the past six years. The Delegation congratulated the International Bureau and particularly those involved in PCT training for the higher satisfaction ratings.

77. The Delegation of the United States of America commended the International Bureau for the high level of user satisfaction with PCT products and services provided by WIPO, with satisfaction rising in every category compared to the 2009 survey. With regard to PCT services provided by other Offices and International Authorities, the Delegation acknowledged the feedback that it had received from the survey that related to the United States Patent and Trademark Office. The Delegation expressed an interest in receiving the feedback in relation to the services provided by International Searching Authorities and International Preliminary Examining Authorities that were competent for applications filed at the United States Patent and Trademark Office in its capacity as a receiving Office, and stated that it would be happy to reciprocate by sharing its feedback with these Authorities.

78. The Delegation of China welcomed the survey and underlined the importance of Offices knowing about the views of its PCT users, which could be useful to improve the services provided as a receiving Office, International Searching Authority or International Preliminary Examining Authority. The Delegation informed the Working Group that the State Intellectual Property Office of the People's Republic of China had conducted a domestic survey of users for the past few years. The Delegation expressed interest in seeing further details beyond the Executive Summary set out in Annex I of the document, and asked whether a more detailed report could be made available.

79. The Secretariat, in response to the request from the Delegation of China, explained that the Executive Summary set out in the document had been produced on the basis of a raw report from the external service provider who had carried out the survey, but that this raw report had not been received in a format which would have allowed it to be presented to Member States.

80. The Working Group noted the results of the PCT Survey 2015 set out in Annex I to document PCT/WG/9/11.

PCT FEE INCOME: PROGRESS REPORT ON ANALYSIS OF POSSIBLE MEASURES TO REDUCE EXPOSURE TO MOVEMENTS IN CURRENCY EXCHANGE RATES

81. Discussions were based on document PCT/WG/9/9.

82. The Secretariat introduced the document, which presented a progress report on the possible implementation of a hedging strategy for PCT fee income and of a "netting structure" for the transfer of fees. The Secretariat recalled that the Assembly, at its forty-seventh session in October 2015, decided to postpone any decision on the possible implementation of a hedging

strategy, pending further analysis of issues that had been identified in document WO/PBC/24/INF.3 that had been presented to the twenty-fourth session of the Program and Budget Committee in September 2015. The present document described a simulation of a tender process for the sale of Japanese yen, euros and United States dollars to acquire Swiss francs using forward purchase agreements. The results of this simulation showed the irregular receipt of cash in these three currencies, which needed to be considered against the liabilities that WIPO had in euros and United States dollars in the implementation of any hedging strategy. The Secretariat gave a presentation with a further update on this work³. Further information would be provided to the twenty-fifth session of the Program and Budget Committee, scheduled to take place from August 29 to September 3, 2016, but the International Bureau did not expect to proceed with the hedging strategy based on forward contracts in the form which had been set out in the proposal discussed at the eighth session of the Working Group. With regard to introducing a “netting structure” for the transfer of search fees, at last year’s session of the Working Group, the International Bureau had indicated that it would further develop a proposal for consideration at this session. Unfortunately, progress had been delayed, pending the recruitment of a consultant, who would be analyzing the implications of a possible netting structure for all transactions between receiving Offices, International Searching Authorities and the International Bureau. Consequently, the International Bureau intended to present a proposal on whether or not to implement a netting structure for discussion at the 2017 session of Working Group.

83. The Delegation of the Republic of Korea requested that Korean won should be included in the hedging analysis, noting that, while the international filing fee had been collected by the Korean Intellectual Property Office (KIPO) as a PCT receiving Office, since 2013, in Swiss francs, KIPO was considering to again collect international filing fees in Korean won.

84. The Working Group noted the contents of document PCT/WG/9/9 and the presentation made by the International Bureau.

PROPOSAL ON PCT FEE POLICY TO STIMULATE PATENT FILING BY UNIVERSITIES AND PUBLIC FUNDED RESEARCH INSTITUTIONS FROM CERTAIN COUNTRIES, NOTABLY DEVELOPING AND LEAST DEVELOPED COUNTRIES

85. Discussions were based on document PCT/WG/9/25.

86. The Delegation of Brazil introduced the proposal in the document for a 50 per cent PCT fee reduction for universities and public funded research institutions from certain countries, notably developing and least developed countries. The Delegation stated that the proposal was the logical next step of the work on the overall fee elasticity of PCT applications that had been presented to the seventh and eighth sessions of the Working Group, and would facilitate a collective decision on that matter. Two years ago, at the seventh session of the Working Group, the International Bureau had presented a study entitled “Estimating a PCT Fee Elasticity” (document PCT/WG/7/6), which provided a first ever estimate of the overall fee elasticity of PCT applications, that is, how an applicant’s choice on whether to use the PCT or the Paris route for filing patent applications abroad was affected by changes in the international filing fee. It showed that universities and public research organizations were more price sensitive than other applicants. At the eighth session of the Working Group in 2015, the International Bureau confirmed the finding that, within that group, universities and public funded research institutions from developing countries were the most price sensitive (see document PCT/WG/8/11). The Secretariat had then estimated that a 50 per cent fee reduction would generate 139 additional filings per year with a decrease in revenue of only 1.058 million Swiss francs. The Chair, in summarizing discussions at the session, had stated that, “there was support by many delegations for PCT fee reductions for universities and government research institutes. (...)”

³ A copy of the presentation is available on the WIPO website at http://www.wipo.int/meetings/en/details.jsp?meeting_code=pct/wg/9_hedging.

Nonetheless, the issue needed to be considered in a holistic manner, also addressing the issue of how to compensate for any losses” (see paragraph 19 of document PCT/WG/8/25). During the twenty-fourth session of the Program and Budget Committee (PBC) in September 2015, the issue of fee discounts had been addressed in a holistic manner. The Secretariat had informed members that a hypothetical fee discount of 50 per cent for applicants from certain countries, mainly developing countries, would imply foregone income of 1.02 million Swiss francs, for 2016, and 1.05 million Swiss francs, respectively, for 2017. The income forecast by the PBC for the 2016/2017 biennium was then 748.2 million Swiss francs, of which 575.9 million Swiss francs derived from PCT fees. Therefore, the forecast impact of a 50 percent fee reduction for universities from developing countries during the next biennium would amount to a mere 0.2 per cent of WIPO’s total income in the period and to 0.36 per cent of PCT fee income. In February 2016, the Director General had announced a surplus of 80 million Swiss francs for WIPO in the 2014/15 biennium. In this context, the possible loss of revenue in the 2016/17 biennium would represent a very small fraction of the projected surplus, with concrete and positive effects for filings by universities and public funded research institutions. Taking into account the technical findings of the study, it could be concluded that a fee discount for universities and public funded research institutions from certain countries was the most efficient possible change in WIPO’s fee policy. Responding to the invitation by the Chair of the eight session of the Working Group to present proposals that deal with the issue of foregone income in relation to new fee policies, the document proposed a tiered approach. In the first phase, the approval of a fee reduction of at least 50 per cent for universities and public research institutions from certain countries, notably developing and least developed countries, taking advantage of the current country-based criteria used for fee reductions. During this phase, the economic impact would be reduced, when compared to a horizontal reduction for all Member States. In a second phase, during a future session of the Working Group, Member States would evaluate the results of the new fee policy to increase filings by universities and public funded research institutions and decide on whether to increase the discount fee and/or extend it to universities and public research organizations from all countries.

87. The Delegation of Brazil continued by explaining that after making the proposal, it had engaged in informal discussions with interested delegations to share ideas on PCT fee policy. The proposal had met with general support, but some Member States would have preferred a more ambitious proposal, while others would have liked to see a more cautious approach. On this aspect, the tiered formula was a staged approach that allowed for the fine tuning of the fee reduction according to the results obtained. Other Member States had mentioned a degree of concern on issues of financial sustainability and income neutrality. In order to address these concerns, the Delegation could offer two possible solutions. The first solution was that Member states could collectively recognize that the holistic analysis of the WIPO budget indicated that the budgetary impact of the fee reduction would be minimal. The extremely reduced impact of the proposal was clear. Today, there were two main fee discounts in the PCT system, one that benefitted digital filing and as a result mainly benefitted developed countries, and a second fee discount that benefitted certain countries, excluding the most effective users of the IP system. The digital filing fee discount, which mainly benefitted developed countries, would result in foregone revenue of 98.4 million Swiss francs for the current biennium, according to WIPO’s Program and Budget 2016/2017 (see page 193 of document A/55/5 Rev.). The fee discount for certain countries, in comparison, would result in smaller foregone revenue, nonetheless noteworthy, of 18.8 million Swiss francs in this biennium. This data was only a reference to put in context the proposal of fee discounts for universities, whose impact was projected to be around a paltry 2 million Swiss francs for the biennium. A second possibility was guiding the Secretariat to increase the efficiency in other fee reductions, such as the enforcement of the fee policy reported by the Secretariat in document PCT/WG/9/10, titled “Fee Reductions for Certain Applicants from Certain Countries, Notably Developing and Least Developed Countries”. This document proposed measures to reduce the number of fee reductions being claimed by applicants not intended to be eligible for the reduction and to assist the international Bureau in obtaining full and appropriate fee payments. If this new role of the Secretariat was endorsed by member states, it would more than compensate any projected income fluctuation with the

proposed fee reduction. In these informal discussions, the Delegation had heard concerns that north-south interuniversity / inter-institutional cooperation would not benefit directly from the proposed fee reduction. In this regard, the Delegation stated that in its understanding, co-authorship of patent filings should also benefit from the proposal. In this regard, the Delegation offered three hypothetical examples on extension of the fee discount that could benefit universities and public research organizations of non-beneficiary countries in cases of co-authorship of patent request. A first example was the incentive for strengthening intraregional cooperation. For instance, the partnership between the Hellenic Centre for Marine Research (HCMR), a Public Research Institution from Greece, and the University of Geneva, a higher education institution from Switzerland, on Continental Shelf Prehistoric Research could benefit from this proposal. A future patent on equipment for marine archeology resulting from the partnership between Greece, a beneficiary country, and Switzerland, a non-beneficiary country, would be stimulated by the 50 per cent fee discount proposed, as long as both of them were co-authors of the patent application. The new PCT fee policy would also benefit global partnerships that were aimed at addressing the challenges posed by the Zika virus. Since the outbreak of Zika virus in 2015, defined by World Health Organization as a global public health emergency, new partnerships between the National Institutes of Health from the United States of America and Fiocruz from Brazil had been established towards developing early diagnostics for this disease. In case a patent of a new diagnostic was the result of this partnership and in case the Working Group approved the fee reduction proposal, both institutions would benefit from the discount in case of co-authorship. A third example illustrated how the new fee policy could also support other WIPO initiatives, such as WIPO Re:Search. WIPO Re:Search was WIPO's platform for collaborative innovation in neglected diseases. Among its collaboration initiatives, the WIPO Re:Search program hosted a partnership between the University of Lagos in Nigeria and the University of Stanford in the United States of America, to study the efficacy of malaria diagnostics. In case this partnership developed a new technology for the diagnosis of malaria, this cooperation activity would also benefit from the 50 per cent discount as long as both institutions were co-authors of the patent application. The Delegation therefore called on all Member States to support and approve this proposal that would create a smart fee reduction that would benefit the international community, promote the use of the patent system and give a first concrete step on discussions related to PCT fee elasticity.

88. The Delegation of India supported the proposal put forward by Brazil. The number of patent filings had increased in the past few years but the percentage of filings by applicants from India remained low. India had a large pool of scientific and technological talent, research and development institutions and enterprises, and universities and technical institutes. There was a genuine need to tap this knowledge resource and stimulate the creation of the intellectual property. This proposal would stimulate PCT filings in developing and least developed countries, which would be a welcome step in the right direction in fostering creativity and innovation. The Delegation therefore expressed a desire to see a positive outcome on the proposal, which was likely to benefit the public at large.

89. The Delegation of South Africa, speaking on behalf of the African Group, stated that the proposal provided an interesting solution to stimulate PCT filings from universities and public institutions from developing countries that had been shown to be more price sensitive than developed country counterparts. The proposal for a 50 per cent fee reduction in the document would translate into a loss of 1.058 million Swiss francs for WIPO, but in the long run could allow other applicants to use the PCT System. The relatively low cost of filing applications would encourage invention and technological innovation which was key to economic growth and prosperity. The proposal clearly highlighted that any projected loss would be absorbed by the surplus so was a small price to pay to expose more universities and publicly funded institutions to the merits of filing international applications, which would create positive spin offs for all involved. The income forecast for 2016/17 was projected to be 748.27 million Swiss francs, of which 575 million Swiss francs came from PCT fees. However, the African Group acknowledged the need to proceed in a prudent manner for the benefit of WIPO and Member States by first providing a 50 per cent fee reduction for universities and publicly funded

institutions with an aim to look at the economic impact of this first reduction. Should the number of filings increase and succeed in motivating this market, it would be a step in the right direction. It had been demonstrated that high costs deterred applications, so a tiered approach was a good way to stimulate the filing of applications. The cost of the fee could then be reviewed, and, if successful, could be made applicable to all universities across the world. The proposal therefore struck a fine balance between being ambitious in scope but cautious in approach. More importantly, it highlighted how both universities from the north and south could benefit through interinstitutional global partnership and cooperation. The Delegation therefore encouraged members of the Working Group to support the proposal.

90. The Delegation of Australia thanked the Delegation of Brazil for responding to the invitation made by the Chair at the eighth session of the Working Group to bring forward proposals in the context of fee reductions for a future session of the Working Group. While there had been limited time to consider the full implications of the proposal, the Delegation wished to clarify certain points which could assist in consideration of the proposal. At the outset, the Delegation saw benefit in considering fee reductions in the PCT that were balanced, would not be overly detrimental to revenue of WIPO and would achieve a real, as opposed to theoretical, incentive for users of the PCT. On this point, the Delegation underlined the importance of drawing a clear distinction between how fee reductions could serve to eliminate impediments to filing of the PCT applications from certain countries, and how fee reductions could incentivize research and innovation; the two were not necessarily the same thing. Second, the Delegation asked how the proposed 50 per cent fee reduction for universities and publicly funded research institutes from developing and least developed countries worked in combination with the 90 per cent fee reduction that was already available to universities and publicly funded research institutions from least developed countries. Third, the proposal did not define what constituted a university or publicly funded research institute, which could create difficulties in the administration of these fee reductions, a problem that was highlighted in document PCT/WG/9/10. Finally, a 50 per cent fee reduction to increase the number of applications by 139 and reduce WIPO revenue by more than 1 million Swiss francs did not appear to be a good cost-benefit equation. While 1 million Swiss francs was a small proportion of the WIPO revenue, it was nevertheless a real amount. Moreover, while the loss in revenue of 1 million Swiss francs would be assured because many universities and publicly funded research institutions would benefit from the reduction, the additional 139 applications were by no means assured. From experience with research organizations, the Delegation questioned whether researchers at universities or publicly funded research institutes would consider the costs of filing a patent application in the PCT in order to perform and drive forward their research. While filing fees might be a future expense, researchers would be more concerned with the current problems to solve in their research, which could subsequently bring about inventions in the future. In the absence of a clearer understanding of the proposal and the true implications on research and innovation, the Delegation was unable support the proposal at this time.

91. The Delegation of Kenya supported the proposal by the Delegation of Brazil and comments made by the Delegation of South Africa speaking on behalf of the African Group, and the Delegation of India. From the work already carried out on fee policy to stimulate patent filings by the universities and public research institutions, especially from developing countries, the Delegation noted that, at the eighth session of the Working Group in 2015, the International Bureau had confirmed that patent filings from universities and public institutions in developing countries and least developed countries were more price sensitive. It further noted that there had been support by many delegations for reductions in PCT fees for universities and public research institutions. In this regard, the Delegation supported the proposal of the 50 per cent fee reduction for universities and publicly funded research institutions in developing countries to stimulate patent filings.

92. The Delegation of Iran (Islamic Republic of) aligned itself with the comments made by the Delegations of India, South Africa speaking on behalf of the African Group, and Kenya in

supporting the proposal, which it hoped could be approved during this session of the Working Group. The Delegation believed that the fee reduction for universities and public research institutes from developing countries would make the PCT system more accessible for potential users in these organizations and increase the geographical diversity in filings of international patent applications. Like other developing countries, universities and public research institutes played a key role in creativity and innovation in Iran (Islamic Republic of), which would be stimulated with a fee reduction, thereby providing a motivation to use the PCT System.

93. The Delegation of China supported the proposal by Brazil for PCT fee reductions for universities and publicly funded research institutes from developing and least developed countries. Like many other developing countries, there were many universities, publicly funded research institutions and small and medium-sized enterprises in China, and these users had made intense demands for PCT fees to be reduced. The Delegation believed that a more extended PCT fee reduction policy could promote the use of the PCT System by more applicants from different countries and encourage more applications. With higher applicant numbers, this would compensate the initial losses and result in a win/win outcome for different countries and for the IP system.

94. The Delegation of Denmark acknowledged that PCT filings from universities and public research organizations were more price sensitive than average, but the main conclusion from the studies by the International Bureau on PCT elasticity was that PCT fees were highly inelastic for all applicant types. Moreover, as pointed out by the Delegation of Australia, the estimated addition of only 139 additional filings by universities and public research institutions from benefitting countries per year would come at the very high cost of more than 1 million Swiss francs, which did not appear to be an effective cost/benefit ratio. Instead, the Delegation believed that it would be more beneficial for applicants with limited resources to test their application at a national level before embarking on the more expensive international patent system. Moreover, the main costs of obtaining patent protection were associated with patent attorneys. In terms of offering fee reductions for certain applicants, the Delegation concluded that this would be more effectively implemented at a national level.

95. The Delegation of Spain expressed interest in the proposal and could support the idea of different levels for fee reductions for certain applicants from particular countries, depending on income level. There could, however, be a tiered approach that included universities and public research organizations in developed countries, for example, a fee reduction of 90 per cent for least developed countries, 50 per cent for developing countries, and at least 25 per cent for developed countries. But it was also important to consider the financial implications on WIPO revenue.

96. The Delegation of the African Intellectual Property Organisation (OAPI) supported the proposal, which it believed would encourage creativity. While it would create a deficit, the proportion of the deficit was small compared to the size of the surplus that WIPO had generated. Sacrificing a small part of the surplus to fund fee reductions would therefore be a good investment for the benefit of creativity.

97. The Delegation of the Republic of Korea supported the general principle of encouraging more international patent applications from universities and public research institutes, but stated that any fee reduction policy for universities and public research institutes should encompass all PCT Member States.

98. The Delegation of the Russian Federation stated that it could accept the proposal as it would stimulate innovation activity in developing and least developed countries and the losses to WIPO revenue could be compensated for in other ways. However, the Delegation considered that the second phase of the proposal to apply fee reductions for universities and public research institutes in developed countries needed to be treated with caution and further consideration on this matter was necessary.

99. The Delegation of Canada informed the Working Group that the Canadian Intellectual Property Office offered fee reductions to certain entities, including universities. The Delegation supported measures to ensure procedures and fee structures were appropriate to encourage the use of PCT System in a manner that was efficient and beneficial for all applicants and which followed an established, clear, efficient and objective process. Therefore, in principle, the Delegation was supportive of the general proposal, but more time was needed to perform consultations and weigh up various options on how any surplus in WIPO income could be used. The Delegation was therefore not able to support the proposal in its present form.

100. The Delegation of the United States of America noted that overall PCT fee elasticity was inelastic, and remained so for universities and public research organizations and for applicants from developing countries, even if filing behavior was more price sensitive for these applicants. Consequently, the expected number of increased filings due to a hypothetical discount in the international filing fee was very low in view of the significant reduction in projected fee income. While the statistics in the PCT Yearly Review suggested that universities may be underrepresented in PCT filings and it was appropriate to encourage more applications from universities and public research organizations, the most appropriate approach was to reduce the international filing fee for these applicants in all countries. However, the Delegation stressed that any such fee discount should only be implemented if it did not result in increasing the international filing fee for other applicants. Further financial analysis in this regard therefore appeared necessary. The Delegation further supported the comments made by the Delegation of Australia, noting that clarification would be required to define which entities would qualify as universities and public research organizations for the purposes of a filing fee discount before the proposal could be evaluated properly. For these reasons, the Delegation was unable to support the proposal in its present form.

101. The Delegation of France stated that it was devoted to measures that could make the PCT System more accessible to applicants that needed support to file more international patent applications. Any fee reduction should, however, be envisaged in a balanced budgetary framework, noting that PCT income was used extensively to finance activities by WIPO in general. Regarding the proposal, the Delegation expressed several concerns as had been stated by the Delegation of Australia. First, it was difficult to see how the proposed 50 per cent fee reduction would apply to applicants in least developed countries which already benefited from a 90 per cent reduction on fees. Second, an additional 139 PCT filings year on year for a drop in fee revenue of 1 million Swiss francs represented a small benefit for the costs incurred, which would increase by a further 6 million Swiss francs annually if also applied all universities in developed countries. The proposal was therefore not acceptable in its present form and required more work, considering scenarios that would have a lower impact on WIPO income where there was no discrimination between universities in different countries or with a tiered approach to reductions, as proposed by the Delegation of Spain.

102. The Delegation of Switzerland supported the comments made by the Delegation of Australia. It was proven that PCT filing numbers were highly inelastic to fee levels, with the macroeconomic situation in a country having a greater impact on filings than any possible fee reduction. Regarding the proposal, an increase of 139 filings represented 0.06 per cent of the total of 219,000 PCT filings in 2015 for a cost of about 1 million Swiss francs, which represented a disproportionate cost/benefit ratio. Moreover, the 1 million Swiss francs would be a recurrent cost to the PCT, in contrast to the 80 million Swiss francs which represented the surplus for the whole of WIPO in the 2014/15 biennium only. The Delegation also considered the definition of beneficiaries in the proposal to be problematic, as it was not clear whether reductions would apply to private universities as well as public universities, also pointing out that the definition of a public research institute varied from one country to another. For these reasons, the Delegation was not able to support the proposal.

103. The Delegation of Greece supported the proposal, which would not only influence innovation but also enhance filing activity in Greek universities and publicly-funded research institutions, which had experienced budgetary cuts in recent years.

104. The Delegation of the United Kingdom stated that the proposal needed more clarity in certain areas, as had been expressed by the Delegation of Australia and certain other delegations. While the Delegation supported efforts to improve IP awareness in universities and public research bodies, it did not believe that fee reductions for universities and public funded research institutions would translate into commercial returns, since these organizations often lacked the commercial infrastructure and expertise necessary to commercialize inventions. Indeed, filing a patent application under the PCT without a clear commercial product in mind could weaken the strength of the patent being sought. In the view of the Delegation, the aim should be to stimulate quality patents, not merely to increase the number of patents being filed. For this reason, the Delegation supported efforts by WIPO to improve the ability of universities and publicly-funded research institutions to find and build partnerships within the private sector. Building such partnerships early in the publicly-funded research phase improved the research outcomes and quality of patents being sought. By contrast, further subsidies to research institutions themselves would not improve their ability to commercialize their inventions and the quality of patent applications and it might even detract from the effort of securing partnerships with industry, which was a crucial component to achieving commercial success from innovations. The Delegation also remained unconvinced that PCT fee levels were the main impediment to filing a PCT application, as they were a small part of the overall cost of gaining international patent protection. Convincing arguments were therefore necessary in order to consider any further expansion of targeted fee reductions provided under the PCT.

105. The Delegation of South Africa supported the proposal, as it would expand the scope of applications from developing countries. While costs and benefits were relative, it could not be ignored that patent filings from universities and public research institutes in developing countries were price sensitive, and it needed to be considered how this should be best addressed. While the Delegation of Australia had raised the point that the 1 million Swiss franc loss to PCT revenue was assured but the projected annual increase of 139 international applications would not necessarily occur, the increase in filings could exceed this projection and, in any case, there would be an added benefit of increasing the visibility of the PCT System in developing countries, which should be welcomed and encouraged. The Delegation added that the Delegation of Spain had raised some interesting points so that all Member States could benefit from the PCT fee income generated by WIPO, which could be explored further. In conclusion, the Delegation supported any constructive dialogue that would make the PCT System more accessible for potential users in universities and publicly funded research institutions, taking into account development considerations.

106. The Delegation of Israel supported the comments made by the Delegation of Denmark that fee reductions for universities and public research institutions should be considered at a national level. To encourage more innovation by these applicants, the Israel Patent Office had introduced a 40 per cent fee reduction for universities in 2015.

107. The Delegation of Turkey stated that universities and public research institutions played a key role in economic and technological development by converting scientific innovations and inventions through patenting and licensing of output from their research. Turkey was in the process of amending its national laws to modernize its IP system and harmonize national provisions with European Union law and international agreements, with the draft law expected to be ratified by its national parliament later this year. One significant amendment in the draft law related to the ownership of patent rights from research made by university academic staff within their job functions, where ownership of rights would stay with the university but the researchers would be given one third of the income from any patent. This could therefore lead to an increase in licensing income through commercialization of university inventions, which could then be used to finance future research by universities. As PCT filings from universities

and public research institutes were more price sensitive than filings from other users, filings in the PCT System by universities and public research institutes could be stimulated by fee reductions, and any proposals on PCT fee policy to this aim deserved the attention of the Working Group. The Delegation concluded by joining other delegations in asking the International Bureau to perform further studies on the possible implementation of the proposal.

108. The Delegation of Japan associated itself with the comments made by the Delegations of Australia and the United States of America, which had been echoed by a number of other delegations. The majority of WIPO revenue derived from PCT fees and the introduction of any further fee reduction measures needed to be considered carefully, noting that the losses incurred would be borne by applicants who could not benefit from the proposed reductions.

109. The Delegation of Chile concurred with the ideas behind the proposal, but it was necessary to clarify the definition of a public research institution and consider where these organizations were based. The proposal for a tiered approach made by the Delegation of Spain was therefore interesting, and this could be investigated to assess its impact.

110. The Delegation of Austria stated that the proposal provided a good starting point for considering stimulating creativity, but at this stage, it shared the concerns that had been raised by the Delegations of Australia, Denmark, the United States of America and some others.

111. The Delegation of Portugal informed the Working Group that the Portuguese Institute of Industrial Property had established a fee reduction for universities, which had resulted in a significant increase in national patent filings. The Delegation believed that universities were more price sensitive to PCT fees and could benefit from fee reductions, but the proposal was at an early stage and required further consideration.

112. The Delegation of the Patent Office of the Cooperation Council for the Arab States of the Gulf (GCC Patent Office) supported the proposal, which would increase patent applications from universities and public research institutes in developing and least developed countries.

113. The Delegation of Morocco supported the proposal and aligned itself with the comments made by the Delegation of South Africa speaking on behalf of the African Group. Three years ago, the Moroccan Industrial and Commercial Property Office granted a 60 per cent reduction on national patent filing fees, which had led to a considerable increase in applications. With regard to extending protection for these inventions to an international level, the PCT fees represented an obstacle to the filing of international applications.

114. The Delegation of Ecuador supported the proposal, which would foster and promote innovation, and encouraged all delegations to review and adopt it.

115. The Delegation of Germany stated that, due to the concerns expressed by the Delegations of Denmark and Israel, it was not in a position to agree to the proposal at this time.

116. The Delegation of Sudan supported the proposal and wished to know whether private universities would be included in the proposed fee reductions.

117. The Delegation of Brazil thanked the delegations that had given their support to the proposal and responded to the questions that had been raised. The overall impact on PCT fee income of 1 million Swiss francs per year was a projection by the Chief Economist of WIPO, and various factors played a role in patent filings from universities. The projected figure amounted to 0.2 per cent of WIPO's total income in the biennium, but this could indeed be lower. The Delegation further clarified that the objective of the proposal was to stimulate the use of the PCT System and increase the diversity in the geographical composition of applications, creating additional demand in the medium term for PCT services. Regarding the question of how universities could be defined, Brazil had produced a definition at a national level, but the Delegation suggested that the Secretariat could provide further clarification, since this was used

in statistical information published by the International Bureau. It was, however, understood that this could include private universities. In terms of how a proposed 50 per cent fee reduction could work alongside the 90 per cent fee reduction for all applicants in least developed countries, the Delegation understood that an additional 50 per cent discount could be provided, but this was open for discussion by Member States. In response to the remarks that the fee discount should first be implemented in national legislation, this had already been applied in Brazil by offering a 60 per cent fee discount for universities, which had been proven to be successful. For this reason, this proposal had been presented so that universities and public research institutions could benefit from reductions within the international legal framework. The Delegation acknowledged the support that had been received for the suggestion made by the Delegation of Spain for investigating a tiered approach to PCT fee reductions, and it was open to discuss this during the session. The Delegation was also open to discussion and analysis of the effects and balances with regard to the suggestion to grant fee reductions to universities and public research institutions from all Member States.

118. The Chief Economist, in response to the question about the definition of universities and public research institutions, clarified that, for the purposes of the study on PCT fee elasticity discussed at the eighth session of the Working Group, applicant names and existing lists of national public research institutions had been used to identify universities and public research institutions from among all PCT applicants. That approach had worked well and had produced reliable results from a statistical perspective, but it had to be recognized that that approach would not work for the purposes of identifying whether a particular applicant was indeed a university or a public research institution which should benefit from a PCT fee reduction. However, as the question had been addressed by national IP Offices that already applied fee discounts for universities and other entities, it appeared that a formal definition could be established.

119. Following informal discussions, the Working Group requested the Secretariat to work with the Chief Economist to provide a supplement to the study presented at the eighth session (document PCT/WG/8/11), for discussion at the next session of the Working Group. That supplement should provide:

- (a) further information, similar to the information provided in tables 4 and 5 of document PCT/WG/8/11, using the elasticity estimates presented in table 3 of document PCT/WG/8/11 and then calculating the number of additional filings, the average fee payment and the income effect, both in absolute terms and relative to total PCT income, separately for universities and public research organizations benefitting from the hypothetical fee reductions, on a range of hypothetical fee reductions for both developed countries and countries complying with the criteria set out in item 5(a) of the PCT Schedule of Fees;
- (b) information on the income effect in case of a hypothetical limitation of the number of applications which could be filed by any university or public research organization benefitting from the hypothetical fee reductions to a range of international applications per year, including values of 5, 10 and 20 international applications per year; and
- (c) more detailed information on the approach taken to identify universities and public research institutions from among all PCT applicants, as referred to in paragraph 118, above.

120. The Working Group further requested the Secretariat to make that supplement available well in advance of (at least four months prior to) the next session of the Working Group.

121. The Delegation of Australia expressed concerns as to a very low reduction, such as 5 per cent for universities and public research organizations from developed countries, noting the burden on and thus costs for Offices to administer such a low fee reduction. The Delegation further stated that other issues should be taken into account during the discussions at the next session of the Working Group, such as introducing thresholds which would exclude universities or public research organizations which had financial or research assets above a certain level from benefitting from a fee reduction.

122. The Delegation of Spain suggested that the Working Group at its next session might also want to consider introducing an evaluation period for any fee reduction for universities and public research organizations.

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

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

124. The Secretariat explained that a fee reduction of 90 per cent was available under item 5 of the Schedule of Fees for any applicant (whether natural persons or legal entities) from least developed countries, and for natural persons from a list of other States which met the criteria listed in paragraph (a) of that item. Based on technical data, the International Bureau had been able to check for unusual patterns of filing behavior that could indicate that an applicant from one of these States was claiming fee reductions when not intended to be eligible for the reductions. When fee reductions for natural persons from these States had been introduced, there was a clear understanding by Member States that these reductions should only apply to natural persons and that Member States might consider reviewing the situation if applicants were claiming the reduction when filing applications that were not intended to benefit from the fee reductions. Through these checks, numerous cases had been found where a single applicant had claimed the fee reduction for ten or more applications in a year, a pattern of behavior that would be impossible for most normal individuals without the financial backing of a company. In a few cases, individual applicants claiming the fee reduction had filed 50 or more applications in a year. Typically, such cases were filed in the name of a person from a qualifying State, but in circumstances such that there appeared to be a strong interest by a legal entity not entitled to the fee reduction; this legal entity would be likely to be paying the fees and be the real beneficial owner of the application. In some cases, the legal entity subsequently was named as the applicant by recording a change in the person of the applicant in the international phase under Rule 92*bis*. In other cases, apparent ownership was left in the name of the original applicant, but that person was, in fact, the owner, legal representative or senior employee of a large legal entity. In respect of a handful of the most extreme cases, the International Bureau had approached the applicants concerned. In most of these cases, when contacted, applicants had stated that they believed this was a permitted option, but they voluntarily paid back the difference between the discounted fee and correct amount of the international filing fee that should have been paid. Nevertheless, the International Bureau believed that it should be made clear that the proxy applications were not permitted and that Member States should actively discourage such applications. Options as to how to clarify the situation, however, appeared to be limited, notably by the fact that procedures for receiving Offices needed to be practical and not place an unreasonable burden on the large majority of applicants claiming the benefit for fee reductions that were entitled to such reductions. It was therefore not desirable to introduce long complicated declarations or other evidence concerning eligibility for fee reductions, which would be difficult, if not impossible, for receiving Offices to check. The International Bureau nevertheless recommended that certain measures be taken to clarify who may claim fee reductions, and to provide clear measures to ensure that full fees were being paid when so warranted. The proposal in the document was two-fold. First, the International Bureau proposed to clarify the matter of eligibility through a proviso to item 5 of the Schedule of Fees that there be “no beneficial owner of the application which would not satisfy the criteria set out in sub-item (a) or (b), along with the Assembly adopting an Understanding to clarify further the concept of a “beneficial owner of the international application”. Second, the

document proposed to provide for a fee equivalent to the reduction which had been recorded at the time of filing to be payable in the case of a request of a recording of a change in the person of the applicant being made in the international phase which would result in the applicant no longer being eligible for the fee reduction. In other words, if the application was filed by an individual from an eligible State, but during the international phase it was assigned to another person or legal entity not entitled to the fee reduction, the applicant would have to pay the difference between the discounted filing fee and the full amount of the filing fee. It was recognized that this proposal would adversely affect real individual inventor applicants reaching an agreement to sell rights to a company which had no involvement in filing the international application, a case where the patent application could have facilitated the applicant to reach that agreement. Moreover, it was recognized this would not affect any remaining applicants who continued to use proxy applicants to gain the benefit of fee reductions but did not assign rights to the beneficial owner during the international phase, which might be the majority of cases. In this situation, the damage to real inventor applicants would be limited, given that a company willing to purchase the rights or pay for a license fee would likely see the additional fee as a relatively small administrative charge compared to the overall investment in the invention. Consequently, on balance, removing the possibility to claim eligibility for the reduced fee and be able to introduce a change of applicant to one ineligible for the international filing fee reduction in the international phase without further fees was considered an appropriate additional deterrent to the use of proxy applicants for the purpose of gaining fee reductions. At this stage, the key goal was to look forward, not backward, by clarifying the eligibility requirements to reduce the number of cases with inappropriate claims and by assisting in discussions with applicants where unusual patents of behavior were found, which suggested that the fee reduction had been taken advantage of in an unjustifiable manner. If further action was required, this would be undertaken in cooperation with the relevant receiving Offices. Furthermore, in some cases, claiming a fee reduction which the applicant was not entitled to could have consequences within the national phase or, if an agent were involved, for the right of practice of any agent concerned, which would also act as a deterrent for applicants using the system in that way.

125. The Delegation of India raised some issues with the proposal and wished the benefit of fee reductions for natural persons from developing countries to continue. However, when assigned to a legal entity, a special fee could be levied. Referring to a provision to provide for fee reductions for small entities that had been introduced into national patent law in India in 2014, the Delegation proposed that fee reductions for small and medium-sized enterprises from developing countries could be introduced in the PCT. The Delegation therefore suggested that the International Bureau could investigate this issue by compiling information on what constitute a small and medium-sized enterprise.

126. The Delegation of the Russian Federation supported the proposed amendments to the Regulations and the Schedule of Fees. The Federal Service for Intellectual Property (Rospatent), when acting as a receiving Office, had experienced situations where an applicant entitled to the fee reduction had filed an international patent application and had then been replaced by a legal entity not entitled to the reduction. The Delegation also suggested that the Receiving Office Guidelines be amended to provide guidance on how a receiving Office should act in these cases.

127. The Delegation of the United States of America understood the concerns about the actions of certain individual applicants which seemed to take advantage of the available fee reductions in an inappropriate way. However, the Delegation also noted that, in most cases, when contacted, the applicants stated that they believed that they were exercising a permitted option and voluntarily paid back the difference in fees. The Delegation therefore agreed to clarify the criteria for fee reductions with the proposals to amend item 5 of the Schedule of Fees, but suggested a further revision to specify that the presence of beneficial owners was to be considered at the time of filing. The text added to item 5 would then be as follows: "there be no beneficial owners of the international application at the time of filing who would not satisfy the

criteria in sub-item (a) or (b)". The Delegation, however, did not support revising Rule 92*bis* at this time since this revision would risk penalizing applicants that legitimately obtained the fee reduction at the time of filing but at a later time transferred interests in the application to a legal entity. Moreover, revising Rule 92*bis* as proposed might provide an incentive to record changes in the person of the applicant in the national phase rather than the international phase, which could impose additional burdens on national offices and decentralize the process. The Delegation therefore suggested that only the revision to the Schedule of Fees should be made at this stage. The effects of the clarification to the Schedule of Fees could then be evaluated before deciding whether it was necessary to make additional changes.

128. The Delegation of China supported the proposal in principle to clarify the eligibility of applicants for fee reductions, but requested more specific provisions on the functioning of the special fee when making a change in the person of the applicant under Rule 92*bis* to one not eligible for the reduction. For example, the Administrative Instructions could be drawn up to deal with how the request for the special fee should be made, the time limit for payment of the fee and the consequences of not paying the entire fee within the time limit.

129. The Delegation of Denmark regretted that certain applicants appeared to be claiming substantial fee reductions even though they were not eligible for these reductions, and wished to take action to solve this problem. In this regard, the Delegation supported clarification of the eligibility criteria in the Schedule of Fees. However, as amending Rule 92*bis* would penalize inventors that reached an agreement to sell the rights to a company which had no involvement in preparing or filing the application, the Delegation believed that this change should not be pursued at this stage, and instead suggested that the International Bureau could look further into the magnitude of the problem before making the change.

130. The Delegation of Greece expressed concern about the proposal as it could adversely affect the freedom to conduct transactions in ownership of international patent applications in certain cases. The Delegation stated that it had only heard of one Member State where applicants had claimed fee reductions when they were not eligible for the reductions. It would thus be premature to make the proposed amendments to Rule 92*bis* before considering the practice in other States where the fee reduction was available to natural persons. For the time being, it would be better to clarify the eligibility criteria and deal with cases of possible inappropriate claims for reductions on an *ad hoc* basis. In Greece, university researchers would often file patent applications as individuals and then transfer the application to the university when the project to exploit the invention had secured financing, which the Delegation did not consider to be an abuse of the fee reduction. The Delegation therefore proposed that the International Bureau could monitor the situation to see whether further action was necessary in the future.

131. The Delegation of Australia stated that the exploitation of fee reductions in the system to obtain some financial advantage was not unusual, and it believed many Offices had firsthand experience of irregular filing behavior among particular users. However, by closing off loopholes to prevent applicants claiming fee reductions that they were not entitled to, legitimate users could also be prevented from benefitting from the reductions. The Delegation asked about the amount of money that had been lost through fee reductions being claimed by ineligible applicants and the administrative costs of recovering this money when the irregularity had been noticed. The Delegation supported the proposal made by the Delegation of the United States of America to identify that there should be no beneficial owner at the time of filing the international application that would not qualify for the fee reduction, and suggested that information could be added to the Applicant's Guide to this effect. Moreover, the proposed changes to the Schedule of Fees could be useful for the receiving Office or the International Bureau to demand fees when it was clear a particular user was abusing the system. However, the Delegation did not believe it was necessary to amend the Regulations. As the document outlined, in situations where an applicant had claimed a fee reduction but the real beneficial owner was not entitled to the reduction, the applicant had voluntarily paid back the amount that

had been claimed when contacted by the International Bureau. It therefore did not appear necessary to adopt a measure that would recover the amount, noting that this would also include situations where the fee reduction had been legitimately claimed by the applicant.

132. The Delegation of Brazil shared some of the concerns that had been expressed by the Delegations of the United States of America, China, Greece and others, and asked the International Bureau how much income had been gained with the *ad hoc* measures to question whether natural persons were legitimate beneficiaries of the fee discount.

133. The Delegation of Israel expressed full support for the interventions made by the Delegations of the United States of America, Australia and Denmark.

134. The Delegation of Spain supported the proposed amendment to the Schedule of Fees, but added that it was not timely to modify Rule 92*bis* to require reimbursement of a claimed fee reduction on transfer of ownership to an entity not eligible for the reduction. Requiring a fee to be paid back would be taking away a benefit for the applicant which had been claimed in light of the economic reality of the country, while the new owner who was required to pay the special fee had not necessarily benefitted from the filing fee reduction.

135. The Delegation of Japan noted that if an amendment to Rule 92*bis* were to be pursued, it would be necessary to clarify what action should be taken in the event that the request were made initially to the receiving Office rather than to the International Bureau. Furthermore, other fees might need to be considered, such as the handling fee.

136. The Delegation of South Africa agreed that it was important to provide clarity on the eligibility of applicants that were entitled to claim a reduction in the international filing fee to ensure that there was a clear understanding on this matter by all parties. However, this should not place any undue burden on legitimate users. While the Delegation supported clarifying the eligibility, the Delegation noted the concerns that had been raised by some delegations and encouraged the Working Group to reflect further on the matter.

137. The Secretariat responded to the interventions that had been made by the delegations. In response to the suggestion by the Delegation of India to investigate possible fee reductions for small and medium-sized enterprises and definitions as to what constituted a small and medium-sized enterprise for the purposes of PCT fee reductions, the International Bureau noted that the Working Group had pursued this line of enquiry in the past without result. In response to the comment by the Delegation of Greece about the extent of problems of fee reductions being claimed by applicants not intended to be eligible for the reduction, the Secretariat noted that fee reductions had been claimed by individuals who appeared not to be the beneficial owner of the application from several countries, not only one. As for the number of applications involved, it was not possible to be certain of the exact numbers, but the International Bureau was aware of more than 1,000 applications in 2014 – corresponding to a loss of fee income over 1 million Swiss francs – and knew that this was part of a pattern continuing through all recent years. In response to the suggestion by the Delegation of the United States of America, to specify in item 5 of the Schedule of Fees that the presence of beneficial owners was to be considered at the time of filing, and taking into account that it should not be the intention to affect legitimate applicants trying to benefit from fee reductions, the Secretariat agreed that the proposed amendment could clarify that the international filing date should be the date on which the criteria for eligibility should apply, and that changes in status which occurred after that time should not be relevant. There was also a need to give clear guidance to receiving Offices on complying with the requirements to benefit from fee reductions as a natural person, but it was not intended that the receiving Office should be expected to perform any routine checks on the eligibility of applicants when the reductions were claimed. Moreover, the proposed amendment to the Schedule of Fees was primarily intended to clarify the issue of natural persons from certain countries claiming fee reductions, and further awareness could also be raised in the

Applicant's Guide and the PCT Newsletter. In addition, the International Bureau would continue to monitor the claiming of fee reductions by this group of applicants.

138. After informal discussions, the Delegation of Brazil requested the International Bureau to provide additional information, for consideration by the Working Group at its next session, on the potentially positive impact on PCT fee income should the proposed change to Rule 92*bis* be adopted, that is, the annual average level of loss of income which could be avoided.

139. The Chair summarized that all delegations which had taken the floor recognized that there was a need to clarify the criteria for eligibility for the fee reduction for certain applicants from certain countries, and there was wide support for the proposal to amend the Schedule of Fees and adopt an Understanding by the Assembly on the subject. The criteria would also need to be reflected and further explained in the PCT Applicant's Guide. The Chair therefore proposed that the amendment of the Schedule of Fees could be sent to the Assembly in 2016 and that the document for the Assembly could include information on income losses the International Bureau had incurred as a result of ineligible applicants claiming the international filing fee reduction.

140. The Delegation of Brazil stated that it was premature to reach a decision on the proposal during the session, as it was clear how the proposal would impact on applicants who understood to be abiding by the rules for claiming fee reductions. Moreover, the Delegation wished to have additional information on the effect of the proposed change to Rule 92*bis* on PCT fee income to be able to make an informed decision on the proposal at a subsequent session.

141. The Chair noted the request made by the Delegation of Brazil, but underlined that, due to the concerns regarding the proposal to amend Rule 92*bis* that had been expressed by delegations which could unduly restrict the use of the fee reductions by legitimate users, any proposal to the Assembly in 2016 would be limited to the amendment to clarify the Schedule of Fees and therefore exclude the changes to Rule 92*bis*.

142. The Delegation of Australia highlighted the consensus from delegations to make the changes to the Schedule of Fees to indicate that there should be no beneficial owners of the international application that would not satisfy the criteria to benefit from the fee reduction. The Delegation also noted the support for the amendment proposed by the Delegation of the United States of America. The Delegation of Australia agreed with this amendment, as it would give the receiving Office and the International Bureau appropriate practical measures to catch the people who were claiming fee reductions illegitimately, but allow them some degree of discretion and choice as to whether that would apply to those who were claiming the fee reductions in a *bona fide* manner when filing an application but assigning the rights at a later stage. The Delegation also acknowledged that there was consensus not to amend Rule 92*bis*. In terms of the amount of revenue that could be recovered from ineligible applicants claiming the fee reduction, the Secretariat had provided an estimate, which had been made taking into account people who could be easily identified as abusing the system by filing 10 or more applications in a year, but no enquiry had been undertaken with regard to applicants abusing the system filing fewer applications. The Delegation therefore agreed that it was not appropriate to propose a change to Rule 92*bis* at this time, not precluding that that this might be dealt with at a later stage. However, this did not prevent the Working Group sending the changes to the Schedule of Fees with the amendment proposed by the Delegation of the United States of America to the Assembly this year. Moreover, as indicated by the Secretariat, appropriate changes could be made in the Applicant's Guide to inform users intending to take advantage of the fee reductions that they should be the beneficial owner at the time of filing.

143. The Secretariat clarified that, by leaving Rule 92*bis* unchanged, the main focus of the proposed amendments would be to raise awareness that the fee reduction for natural persons from certain countries should only apply when, at the time of filing, there were no beneficial owners of the international application who were not entitled to the fee reduction. There

appeared to a consensus that this should be the case. The proposed amendments would not, however, change the legal basis for the International Bureau to contact applicants who were believed to have been claiming fee reductions for which they were not eligible. In the past, such applicants had only been approached when many international applications had been filed, and there was no intention to investigate applicants which had claimed the reduction on only a few applications. Moreover, the International Bureau had no legal basis to conduct investigations on the veracity of particular claims for fee reductions by looking into contractual arrangements the applicant might have with a company or other legal entity. The International Bureau could, nevertheless, provide additional information on the number of applicants that were believed to be claiming the fee reduction when not entitled to do so, along with estimates of the money that had been recovered from the individuals who had voluntarily paid back the difference in fees over the past few years in the proposal which the Secretariat hoped could be submitted to the Assembly later this year. Only a limited number of applicants who were clearly abusing the provision by claiming reductions on at least 10 applications, and in some cases, more than 100 applications, had been contacted by the International Bureau to date. There was no intention, however, to approach individual applicants that had only filed a few applications. Instead, the main focus needed to be on raising awareness that the reduction should only be claimed by natural persons when, at the time of filing, there were no beneficial owners of the international application not entitled to the fee reduction. In conclusion, the Secretariat hoped that the proposal to amend the Schedule of Fees could be considered by the Assembly this year. In this way, it would send out a clear message on the eligibility for reductions on the filing fee for natural persons from certain countries and give support to receiving Offices to approach applicants who may not be abiding by the rules.

144. The Delegation of Brazil thanked the Delegation of Australia and the Secretariat for the information. As there appeared to be no legal basis for requesting payment of the full amount of fees after the reduction had been claimed, the Delegation of Brazil urged the International Bureau to proceed with caution in this regard. In view of the apparent legal uncertainty and lack of mandate for the International Bureau to request payment to make up the full international filing fee, the Delegation requested the further information on the impact of the measures on the finances of WIPO.

145. After further informal consultations, the Delegation of Brazil asserted that the discussions on the proposed clarifications to the Schedule of Fees and amendments to Rule 92*bis* should take place in tandem. Recognizing that the Working Group could not agree to the changes to Rule 92*bis*, discussions on the changes to the Schedule of Fees should also be postponed in order to allow the Secretariat to revise the document to take into account concrete measures taken by Member States and the International Bureau to address the issues raised in the document. The Delegation reiterated its request for the Secretariat to provide additional information, for consideration by the Working Group at its next session, on the potentially positive impact on PCT fee income should the proposed change to Rule 92*bis* be adopted, that is, the annual average level of loss of income which could be avoided.

146. The Working Group invited the Secretariat to provide the additional information set out in paragraph 145, above, for consideration by the Working Group at its next session.

COORDINATION OF TECHNICAL ASSISTANCE UNDER THE PCT

147. Discussions were based on document PCT/WG/9/8.

148. The Secretariat reminded the Working Group that, at its fifth session, the Working Group had agreed that reports on technical assistance should be included as a regular agenda item for future sessions. Since then, the Secretariat had submitted reports on this subject to the Working Group, which covered both PCT-related technical assistance activities for developing countries with a direct bearing on the use of the PCT in those countries, and also information on PCT-related technical assistance carried out under the supervision of other WIPO bodies and indeed covered by other parts of the WIPO Secretariat. The document maintained the same

reporting format as in previous years, which had been well-received. Annex I included background on the types of assistance that the International Bureau undertook with relation to the PCT to assist developing countries to make use of the PCT system, and then listed all the technical assistance activities that had taken place in 2015; Annex II listed such activities as they had been undertaken already in 2016 and also those that were planned for the remainder of the year. As for activities related to developing patent systems of developing countries that went beyond the use of the PCT in those countries, and that were therefore undertaken outside of the PCT sector and fell under the supervision of other WIPO bodies, paragraphs 5 to 7 of the document set out some examples of such activities. This part of the document also described the more comprehensive WIPO Intellectual Property Technical Assistance Database (IP-TAD), with a link to the database website, which had been set up under a Development Agenda recommendation a few years ago.

149. The Secretariat continued referring to the update in the document on the ongoing discussions of 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 in the Committee for Development and Intellectual Property (CDIP). The Secretariat recalled that the Working Group had the pending issue from the PCT Roadmap recommendations of reviewing the functioning of the PCT in terms of organizing technical assistance for developing countries. The Working Group, at its fifth session, had decided to await the outcome of the discussions of the External Review and related documents in the CDIP before considering how to proceed with regard to the technical assistance related parts of the PCT Roadmap recommendations. In this regard, the document provided an update in paragraph 9 of the discussions on this subject at the sixteenth session of the CDIP in November 2015. In terms of the discussions of the External Review and related documents at the seventeenth session of the CDIP in April 2016, the Secretariat referred to the Summary by the Chair of that session by informing the Working Group that all delegations were in agreement with the revised Spanish proposal, as attached to Appendix I of the Summary, which contained six measures to be taken by the WIPO Secretariat in relation to its technical assistance to developing and least developed countries. The CDIP also decided to continue discussions of the External Review and related documents at a future session. So, as discussions were still continuing in the CDIP on the broader issue of WIPO technical assistance, the Secretariat recommended that the Working Group continue to await the outcomes of these discussions before picking up the issues in the context of the PCT Working Group.

150. The Delegation of South Africa, speaking on behalf of the African Group, welcomed the report on technical assistance and expressed appreciation for workshops and seminars that had been held in several African countries, such as Angola, Malawi, Mozambique, South Africa and Zimbabwe. The African Group reiterated its belief that PCT-related assistance was an integral part of broader WIPO technical assistance and encouraged the International Bureau to continue to explore ways on how PCT-related technical assistance could enhance capacity building in developing countries and contribute to the ongoing debate on the relevance and impact of IP on development. In this regard, the development of IP in a country could not be treated in isolation to broader developmental goals, and the delivery of technical assistance needed to be tailored around an assessment of the needs of a country.

151. The Delegation of South Africa, speaking in its national capacity, expressed appreciation to the International Bureau for the ePCT Office and ePCT filing workshops in 2015 and the training workshop in 2016 that took place in South Africa. The Delegation also thanked the Delegations of Brazil and Japan for their training workshops to coordinate patent examination training at its national Office.

152. The Delegation of China expressed appreciation for the work of the International Bureau to help developing countries improve their ability to use the PCT System. China had accumulated rich experience in PCT search and in the use of the PCT System generally since

joining the Treaty and was willing to take part in technical assistance activities within the scope of its capacities.

153. The Working Group noted the contents of document PCT/WG/9/8.

TRAINING OF EXAMINERS

154. Discussions were based on document PCT/WG/9/18.

155. The Secretariat introduced the document, which evaluated the results of a questionnaire regarding the training of examiners. This questionnaire had been addressed to Offices which had provided such training to other Offices (donor Offices) and Offices which had received training from other organizations (beneficiary Offices). To date, the International Bureau had received 47 replies, and those Offices that had not yet replied were encouraged to do so. About half of the Offices who replied as beneficiary Offices were also donor Offices. In terms of the relevance of external examiner training for beneficiary Offices in developing countries, the smaller Offices emphasized the importance of external support, an aspect that was also relevant to Offices of smaller member States of the European Patent Convention. For Offices with a long track record in substantive patent examination, most training of new patent examiners was carried out in-house, with examiner exchange between Offices taking place to share best practices and improve understanding of examination practices in other Offices. There was also support for a more active role for WIPO in coordinating patent examiner training by organizing training to ensure efficient use and avoid duplication, organizing funding of training activities and sharing of best practices. The activities undertaken by Offices for four types of examiner training were reported in the document, namely medium or long-term comprehensive training programs, on-the job training, classroom-type training activities and e-learning activities. In particular, it appeared that the potential e-learning opportunities did not appear to be fully exploited, despite appearing to be an effective way to imparting knowledge between different Offices. Finally, the questionnaire reported on the management of examiner training. In terms of recommendations, the document suggested that the International Bureau compile a list of training activities carried out by Offices each year to improve transparency, invite Offices to provide more on-the-job and classroom type training activities, invite Member States to set up further funding arrangements to provide for training of examiners in developing countries, and to compile a list of self-study materials and courses relevant to the training of substantive examiners. Furthermore, for better management of examiner training, it was recommended that the International Bureau compile competency models developed by Offices providing substantive examiner training and to explore the development of a learning management system for the tenth session of the Working Group.

156. The Delegation of the Republic of Korea supported the idea of increasing training opportunities for patent examiners, and agreed with the suggestions that the International Bureau should play a greater role in coordinating patent examiner training and fostering cooperation between Offices. The Korean Intellectual Property Office was also willing to provide information on its training activities, course materials and training management systems. While the Republic of Korea already funded training of examiners in other Offices through Funds-in-Trust, the Delegation urged caution in expanding existing Funds-in-Trust or setting up new Funds-in-Trust, until the concept of improved coordination of examiner training had been developed, analyzed and a consensus had been reached on coordination of examiner training.

157. The Delegation of Kenya welcomed the proposed activities and expressed appreciation for WIPO's contribution to facilitate and coordination external training of patent examiners from developing countries through Funds-in-Trust. External training support was essential for patent examiners to learn about new tools. Examiners at the Kenya Industrial Property Institute had participated in the Regional Patent Examiner Training program organized by IP Australia, which had helped with on-the-job training in Kenya and faster processing of patent applications. The Kenya Industrial Property Institute had also received training from the European Patent Office

and the patent Offices of Norway, Israel, the United States of America and the Republic of Korea. However, one challenge was to retain patent examiners in substantive patent examination, as some needed to be involved in outside activities such as IP promotional assignments, outreach activities or advisory services.

158. The Delegation of the United States of America reported that the United States Patent and Trademark Office had provided various patent examiner training programs over the years to examiners in other Offices, both at the United States Patent and Trademark Office and at the beneficiary Offices. The latter included training at the Indian Patent Office and the National Institute of Industrial Property of Chile when these Offices began their work as International Searching and Preliminary Examining Authorities. The demand for training programs was growing and the Delegation continued to support technical assistance to Offices in developing and least developed countries in the interest of improving quality of PCT work products. The Delegation therefore agreed that it would be beneficial to improve coordination and planning as well as substantive content of training programs to make them as efficient and effective as possible. With regard to the conclusions in paragraphs 43 to 65 of the document, the Delegation agreed with the suggestions related to improving transparency, demand and supply, and coordination of training in paragraphs 46, 47 and 50. In this regard, the International Bureau was in the best position to collect requests for training, match donors and recipients for potential training activities and keep track of what training had been conducted. Concerning self-study training materials, the United States Patent and Trademark Office made several training resources and e-learning modules available on its website. It was willing to share these materials with the International Bureau, and had, in the past, made materials available for posting on the IP outreach campaign section of the WIPO website. However, the Delegation expressed concerns it had with regard to the discussion on management of examiner training in paragraphs 53 to 65. In its view, it was the responsibility of individual Offices to track and coordinate the training of individual examiners; this was not the responsibility of the International Bureau. Moreover, the resources of the International Bureau should not be expended on the development of competency models or learning management systems for specific countries. Finally, with regard to the discussion in paragraph 57 of the document about Offices with a small number of examiners not being able to conduct stand-alone examination and prior art searches in all areas of technology, the Delegation pointed out that this was one of the reasons why work sharing regimes such as the Patent Prosecution Highway and the Collaborative Search and Examination pilot had been developed, so that all Offices could benefit from the knowledge, expertise and information of one another.

159. The Delegation of the Philippines stated that the Intellectual Property Office of the Philippines had been a recipient Office in several examiner training programs from other Offices, including the European Patent Office, the United States Patent and Trademark Office, the Japan Patent Office and the Korean Intellectual Property Office, and its examiners were also participating the Regional Patent Examiner Training Program organized by IP Australia. As a result of these activities, the Intellectual Property Office of the Philippines had been able to develop an in-house training program for new examiners beginning with classroom type training. Successful participants would then proceed to different substantive examining divisions to undergo on-the-job training and mentoring. However, there was much work still to be done in examiner training, where the proposed learning management system could play an important role.

160. The Delegation of Brazil recognized the benefits of international cooperation for the training of examiners, and added that high quality examiners were crucial for the correct implementation of the patent system to ensure that only applications that complied with legal requirements were granted. In the past, Brazil had benefited from training from many countries, which had enabled attainment of higher standards of patent examination. Nowadays, the National Institute of Industrial Property of Brazil also acted as a providing Office to train examiners in other developing countries. In 2015, two regional courses took place in Rio de Janeiro, with the participation of 15 countries from Latin America. Financing for these events

provided opportunities for countries to participate that may not have been able to have attended due to budgetary constraints, with WIPO's Brazil Funds-in-Trust being used to support these examples of South-South Cooperation. Considering the benefits brought by existing Funds-in-Trust, the Delegation supported the suggestion in paragraph 48 of the document of the International Bureau inviting Member States to consider setting up further Funds-in-Trust arrangements with a view to making additional funds available for the training of examiners in developing countries. Cooperation from WIPO for the training of examiners was a relevant activity for the organization, which could complement bilateral and regional training initiatives. However, it was important to maintain flexibility for national Offices to set up training activities according to the availability of resources. Taking into account the many different legal definitions regarding substantive patent examination, training by WIPO needed to focus primarily on matters directly related to the PCT; other matters needed to be addressed according to the requests by the Office receiving assistance. Regarding duplication of efforts, due care needed to be taken since the targeted audience could vary over time, even if the training content remained the same. Additional transparency was also welcome to clarify the training received and provided. The Delegation concluded by underlining that it valued the efforts undertaken by WIPO regarding the training of examiners and was open to receiving or providing such assistance.

161. The Delegation of China stated that the document offered many useful suggestions, for example, improving transparency in terms of supply and demand, sharing study materials and courses, and exploring the development of learning management systems. The Delegation considered that these were practical suggestions that could be implemented gradually and evaluated periodically, and it agreed that the International Bureau could play a more positive coordination role in the process. The State Intellectual Property Office of the People's Republic of China (SIPO) had seven patent cooperation centers with more than 10,000 substantive patent examiners. Through the in-house training of these examiners, SIPO had accumulated rich experience in examiner training, having a comprehensive curriculum, evaluation plan and training systems. In recent years, SIPO had provided training for some developing countries through bilateral cooperation, and as a beneficiary Office had benefitted from training provided by other Offices. Such training activities increased patent examination ability in developing countries and provided opportunities for Offices to share and exchange experiences, skills and practices. SIPO hoped there would be more opportunities to communicate with other Offices to share practices and experiences in examiner training, and was willing to provide training to examiners from developing countries within the scope of its abilities and resources. As for the detailed suggestions in the document, the Delegation required more time to conduct internal consultations, but was willing to share more information on its national experiences with the International Bureau.

162. The Delegation of Japan welcomed the document and hoped that discussion would lead to further building of capacities of patent examiners in Member States. The Japan Patent Office had been providing technical assistance activities, including training for patent examiners by bilateral interaction with other governments, mainly through Funds-in-Trust arrangements of the Government of Japan with other IP Offices. The Japan Patent Office was committed to improving such activities through more effective use of the funds. Although the Delegation appreciated the efforts of the International Bureau to compile information on training activities, it suggested that priority should first be given to collecting information from Member States that had not yet provided their input, as suggested in paragraph 43 of the document. With further information, examiner training could be discussed carefully, bearing in mind individual national priorities and specific circumstances of each of the donor Offices and resource constraints.

163. The Delegation of Spain underlined its commitment to promoting the strategic development of intellectual property rights through activities of technical assistance, which undoubtedly had repercussions on the PCT. The objective was to cooperate with the beneficiary Office itself, particularly in Latin America, whom the Delegation considered as an associate for strategic reasons. The Delegation was also interested in the national technical

assistance programs organized by WIPO and the European Union. As far as training activities were concerned, the Delegation highlighted a long distance training program with the Center for Economic and Technological Development in Latin America, and WIPO Funds-in-Trust arrangements by the Government of Spain, where a Memorandum of Understanding had been signed with WIPO to train examiners. The Delegation supported the initiatives proposed in the document, such as the annual reporting of activities in paragraph 45 of the document, which would improve awareness of the other training activities being carried out by WIPO, including those under the Funds-in-Trust programs.

164. The Delegation of the European Patent Office supported examiner training activities. Due to the limited amount of resources and in order to avoid duplication of efforts, the Delegation supported the International Bureau playing a greater role in contributing to increasing transparency relating to the supply and demand of patent examiner training. This could be achieved by disseminating information about delivered or planned training activities over a given period of time. Increased transparency would help all patent Offices to make more informed planning of their training activities. Meanwhile, it had to be highlighted that Offices could have specific internal priorities and varying resources which needed to be taken into account when planning training activities. With respect to paragraph 50, for instance, it was not desirable to add an extra overarching layer in the planning process of training patent examiners in other Offices, since this could reduce flexibility of Offices in the decision-making process related to training. With respect to paragraph 45, the European Patent Office believed that reporting to WIPO should not be on all training activities, but limited to those that were actually offered to other Offices. Finally, with respect to paragraph 60, the curricula and the competency models developed for the training of examiners at the European Patent Office were confidential information which could not be shared as such, but in any event, this appeared to be going beyond the mere coordination of examiner training activities by the International Bureau.

165. The Delegation of the African Intellectual Property Organization (ARIPO) stated that ARIPO had greatly benefited from the training that was being offered by IP Australia through the Regional Patent Examiner Training program. Two examiners at ARIPO had successfully completed the training, with two more currently on the program, which was one of the most comprehensive patent examiner training programs being currently offered. The Delegation thanked the Japan Patent Office and the Korean Intellectual Property Office for the training that they had not only extended to ARIPO examiners but also to examiners from ARIPO member States, such as Kenya. The Delegation concluded by supporting the efforts being undertaken by WIPO to coordinate patent examiner training.

166. The Delegation of Israel stated that the Israel Patent Office, acting in both national and international capacities, provided technical assistance especially for developing and least developed countries. In cooperation with the WIPO Academy, the Israel Patent Office held an annual training course on search and examination of patent applications with a special highlight on pharmaceuticals, which aimed to assist developing countries to enhance their capacities in patent examination. The potential role of WIPO in coordinating the training of substantive patent examiners should be in establishing a web platform for collecting and sharing training information, such as training materials and tools, best practices, and also lessons learned and feedback from Offices and trainees. The International Bureau could also keep a record on proposals and needs regarding examiner training. In conclusion, the development and management of a system for coordination and management of training by the International Bureau would contribute to further improvement of patent examination and of the PCT System.

167. The Delegation of the African Intellectual Property Organisation (OAPI) appreciated the ideas in the document for the training of examiners, highlighting that it had benefited from the support of other Offices in examiner training, particularly the European Patent Office, with most of the examiners at OAPI having undertaken classroom training at the Center for International Intellectual Property Studies (CEIPI). Examiners had also benefited from further refresher training that had been provided by the European Patent Office and the IP Offices of China, the

Republic of Korea and other partners. The Delegation thanked the organizations that had provided training and supported the efforts proposed in the document for better coordination of training, which would intensify and make training more effective for patent examiners, particularly in developing countries.

168. The Secretariat acknowledged the support from delegations for the recommendations in paragraphs 45, 47, 50 and 52 of the document. While some delegations had raised concerns about the recommendations in paragraphs 60 and 65 with regard to the management of examiner training by preparing competency models and exploring the development of learning management systems, the recommendations were at a fact-finding stage. For the management of examiner training, the International Bureau would be inviting Offices to share information on existing activities. This information would be used to prepare a compilation of competency models to develop an inventory of the various competencies that may be required for substantive patent examiners. For learning management systems, a draft concept would be prepared for discussion at the next session of the Working Group. Taking the concerns that had been expressed by some delegations on these two recommendations into account, the Secretariat suggested moving ahead with these recommendations and returning to the Working Group at its next session with more detailed proposals based on further input from Offices on each of the recommendations.

169. The Working Group agreed that the International Bureau should proceed with the suggestions set out in paragraphs 45, 47, 48, 50, 52, 60 and 65 of document PCT/WG/9/18, taking the above comments into account.

EXTENSION OF APPOINTMENT OF INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES

170. Discussions were based on document PCT/WG/9/14.

171. The Secretariat introduced the document by reminding the Working Group that all periods of appointment as International Searching and Preliminary Examining Authorities would expire on December 31, 2017. The Assembly would therefore need to make a decision on the extension of each appointment at its session in September/October 2017, having first sought the advice of the Committee for Technical Cooperation. The minimum requirements for appointment of an International Authority were stated in Rules 36 and 63, which needed to be satisfied during the period of appointment. In addition, an Authority was required to conclude an agreement with the International Bureau, to be approved by the Assembly, setting out the details of its operation as an International Searching and Preliminary Examining Authority. Furthermore, the Assembly, at its session in September 2014, had adopted an Understanding with regard to the procedure for the appointment of International Authorities, which was reproduced in the Annex to the document. While, strictly speaking, the Understanding only related to the appointment of new International Authorities and not the extension of existing appointments, the International Bureau proposed that the "spirit" of that Understanding also be applied to the extension of appointments. In particular, this should cover the timing, including the meeting of the Committee for Technical Cooperation as a true expert body well in advance of the Assembly and the submission of the required documentation by an Authority seeking an extension to its appointment. Taking into account the spirit of the Understanding, the document proposed a timetable for the procedure to extend existing appointments. This would begin by the International Bureau issuing a Circular to invite Authorities to comment on a draft model agreement and raise any specific issues relating to their operation. The Meeting of International Authorities would then discuss the draft model agreement in early 2017. Each Authority would be required to submit documentation to the Director General to request extension of its appointment two months prior to the date of the thirtieth session of the Committee for Technical Cooperation, which would meet back-to-back with the tenth session of the Working Group in May/June 2017 to provide its advice to the Assembly. The new agreements between the International Bureau and each Authority would take effect from January 1, 2018. As with previous extensions, the appointment period would be for 10 years and thus would expire on

December 31, 2027. The document further proposed in paragraph 11 that the Working Group should agree on the procedure for the extension of existing appointments proposed in the document without the need for a formal decision by the Assembly to this effect. This would therefore allow the process to begin by the International Bureau issuing the proposed Circular by the end of June 2016. Finally, the document summarized the discussions by the Meeting of International Authorities in paragraphs 12 and 13.

172. The Delegation of the United States of America supported the proposed process and timetable in paragraph 8 and the proposals in paragraphs 9 to 11 of the document. However, the Delegation expressed concern regarding the suggestion made during the discussions at the Meeting of International Authorities of a peer review process to be carried out with other Authorities, which it believed would be burdensome and impractical due to the large number of Authorities, and would not bring significant benefit to the procedure. Likewise, the Delegation did not consider paragraph (a) of the Understanding, which strongly recommended the assistance of other Authorities during the process, should apply to the extension of appointment.

173. The Delegation of the United Kingdom agreed that the renewal process should follow the same principles as the process for appointment of new International Authorities, including consideration of applications by the Committee for Technical Cooperation as a true expert body. In the interests of building and maintaining trust in the quality of international phase work so that national offices could confidently rely on it, it was vital that the renewal process was both thorough and transparent. With this in mind, it was important that the applications for reappointment included clear details of how each Authority continued to meet the criteria for appointment. To ensure the relevant information was available to the Committee for Technical Cooperation, the Delegation supported the development of a standard application form as discussed by the Quality Subgroup of the Meeting of International Authorities, which should be used for extensions as well as new appointments. Finally, given the increasing number of International Authorities and likely applications from Offices wishing to become International Authorities in the future, the Delegation stated that it would welcome any mechanism which would facilitate the process of checking that the Offices met the necessary requirements and ease the process for the applicant Offices.

174. The Delegation of the European Patent Office supported the proposal which were balanced and sufficiently detailed to enable International Searching and Preliminary Examining Authorities to request extension of their appointments. The Delegation also aligned itself with the comments made the Delegation of the United States of America on the peer review process and those made by the Delegation of the United Kingdom with regard to the use of a standard form for applications for appointment and extension of appointment as International Authorities. .

175. The Delegation of Brazil expressed interest in extending the appointment of the National Institute of Industrial Property of Brazil (INPI) as an International Searching and Preliminary Examining Authority. When INPI began operations in 2009, it was selected as the International Searching Authority for 66 international applications. In 2015, this figure had risen to 446 international applications which originated from Brazil and 13 other PCT Contracting States. The Delegation believed that the appointment process would ensure that minimum requirements were met by International Authorities and quality services would be offered to users. The Delegation therefore supported the timetable outlined in paragraph 8 of the document, and also wished to avoid an unnecessary increase in workload for existing Authorities. With regard to any peer review process, the Delegation agreed with the remarks made by the Delegation of the United States of America. While the Delegation was committed to ensure high quality work by Authorities, it saw little added value in such a process in view of other efforts taken by Authorities on quality.

176. The Delegation of Israel supported the timetable and procedures set out in paragraphs 8 to 10 of the document, without the need for a formal decision by the Assembly, whose main task should be to approve the advice of the Committee for Technical Cooperation.

177. The Delegation of China supported the process and timetable for extension of appointments of International Authorities in paragraphs 8 to 11.

178. The Delegation of the Republic of Korea expressed hope that the appointment of the Korean Intellectual Property Office as an International Searching and Preliminary Examining Authority would be extended in 2017. While Rules 36.1 and 63.1 should apply for extensions of appointment, the procedures should not bring too much extra work for International Authorities and the International Bureau. In particular, as had been recognized in paragraph 10 of the document, all existing Authorities regularly provided reports on their existing quality management systems under Chapter 21 of the PCT International Search and Preliminary Examination Guidelines. The Delegation therefore considered that it should be sufficient for Authorities to refer to their most recent report on their quality management system and include other documentation to describe the number of patent examiners and their access to the PCT minimum documentation.

179. The Secretariat responded to the interventions by clarifying two points. First, with regard to the suggestion of a peer review process made by one Authority during the discussions at the Meeting of International Authorities, this did not receive explicit support from other Authorities and was therefore not part of the proposed procedure for extension of appointments in 2017. Second, in relation to a standard application form for the initial appointment of International Authorities and extensions to appointments, the Secretariat pointed out that discussions on the possible contents of such a form were ongoing in the Meeting of International Authorities and that such a form would thus not be available and used in the context of the current process of reappointment. The International Bureau would, nevertheless, support the introduction of such a form in the future.

180. The Working Group noted the contents of document PCT/WG/9/14. It agreed with the proposed procedures and timetable set out in paragraphs 8 to 10 of document PCT/WG/9/14, which should govern the process for the extension of existing appointments, without the need for a formal decision by the PCT Assembly to that effect.

COLLABORATIVE SEARCH AND EXAMINATION – THIRD PILOT

181. Discussions were based on document PCT/WG/9/20.

182. The Delegation of the European Patent Office updated the Working Group on the third Collaborative Search and Examination pilot. Following two earlier pilot projects between the European Patent Office, the United States Patent and Trademark Office and the Korean Intellectual Property Office that took place in 2010 and 2012, the IP5 Offices were of the view that a full testing of the concept with all five Offices would be needed before proposing a product within the PCT. In particular, the objectives of such a third pilot would be to check users' adherence and interest for Collaborative Search and Examination product, to agree on a common set of quality standards to be applied in the Collaborative Search and Examination project, and to evaluate the economic value of the additional service provided by the Collaborative Search and Examination written opinion of the International Searching Authority. The third pilot would be applicant driven, giving the choice for applicants to decide on which applications they wished to be treated under the pilot, and it was expected that at least 100 applications from each participating Office would be treated. The operational phase of the pilot would last at least three years in order to monitor applications up until national phase entry. A decision on the pilot would be taken at the IP5 Heads of Office meeting on June 2, 2016, after which it was hoped that the pilot would be launched within one year. The IP5 Offices would then meet as a group to decide on operational aspects prior to the launch. The European Patent Office would also continue to report on a regular basis, both to the Meeting of

International Authorities and the Working Group, on any progress made during the pilot program.

183. The Delegation of Japan stated that the Collaborative Search and Examination program would enable applicants to obtain high quality and globally reliable examination results. The Japan Patent Office therefore wished to advance the pilot program based on a partnership between the IP5 Offices.

184. The Delegation of China stated that the Collaborative Search and Examination pilot would produce positive effects on the quality of international search reports. Users from different countries, including those from China, had also showed interest in the pilot. The State Intellectual Property of the People's Republic of China would therefore consider taking part in the third pilot and encouraged all International Authorities and other Member States to follow the progress of the pilot and contribute by offering useful advice, which could help the PCT System to provide better services to users worldwide. For the specific roadmap and execution of the third pilot, the Delegation pointed out concerns on the fee, language and selection rights of the Authorities in the third pilot, which were important to test the intention of applicants to use a future service offering collaborative search and examination.

185. The Delegation of the United States of America stated that it was encouraged by the results of the first two pilots conducted between the United States Patent and Trademark Office, the European Patent Office and the Korean Intellectual Property Office, and the potential benefits that collaborative search and examination may hold with regard to increasing the quality of international phase work products. The Delegation was also encouraged by the potential time-saving benefits that collaborative search and examination could bring to the examination process during the national phase. Collaborative search even outside of the PCT had great potential. In this regard, the United States Patent and Trademark Office was testing two different schemes for bilateral collaborative projects with the Japan Patent Office and Korean Intellectual Property Office in relation to search and examination in national applications. In conclusion, the Delegation looked forward to working with the other IP5 Offices and the International Bureau on starting the third pilot.

186. The Delegation of the Republic of Korea reminded the Working Group that the Korean Intellectual Property Office had participated in the first and second pilot projects. Examiners in the pilot projects had felt an improvement in quality of international search reports, but the earlier pilots had not noted the feedback from users. The Delegation expected collaborative search and examination to improve search quality and reduce the workload of Offices, and it hoped to receive the views of users during the third pilot.

187. The Delegation of the United Kingdom expressed the view that collaboration between different Offices while search and examination was carried out was an effective way to improve the quality of patent search and examination and avoid duplication of work. The Delegation therefore welcomed the proposed Collaborative Search and Examination third pilot and looked forward to hearing about the results from the pilot.

188. The Representative of the Institute of Professional Representatives before the European Patent Office (EPI) welcomed the launch of the Collaborative Search and Examination third pilot and the active participation of the European Patent Office. An international search report and written opinion from collaborative work between examiners would assist applicants in decisions that needed to be made at various stages during an application for a patent. EPI also hoped that any collaborative model could be provided at an affordable price to users.

189. The Representative of the International Federation of Intellectual Property Attorneys (FICPI) stated that FICPI was positive to the notion of collaborative searches, which were a good alternative to supplementary searches where searches on an application were generally conducted independently. By building on the work of other examiners, collaborative searches

could be a cost effective way of involving more than one examiner on a search, even though it was understood that this would involve substantial costs. It was therefore important to strike a balance in terms of these costs. FICPI looked forward to hearing the results of the third pilot.

190. The Working Group noted the contents of document PCT/WG/9/20.

PCT DIRECT AT THE EUROPEAN PATENT OFFICE: STATUS REPORT

191. Discussions were based on document PCT/WG/9/21.

192. The Delegation of the European Patent Office (EPO) provided an update on the "PCT Direct" service that it had been offering since November 1, 2014. This service allowed applicants to submit, when filing an international application, a letter containing informal comments aimed at addressing objections raised in the search opinion established by the EPO on a priority application, thereby improving the linkage between the two applications. From July 1, 2015, the service had been extended to international applications filed at receiving Offices other than the EPO where the priority application had been searched by the EPO and where the filing tools had been adapted to support the service. The service, provided free of charge, aimed to encourage efficiency at the EPO since the same examiner often performed both the international search and the search on the priority application. From the perspective of applicants, the opportunity to reply to the earlier search opinion enabled the applicant to overcome any objections that might have been raised and allow informal comments to be taken into account when drawing up the international search report and written opinion. Over the previous 12 months, the EPO had received an average of 200 PCT Direct requests per month, which it hoped would continue to increase. Moreover, the EPO had received positive feedback from the user community. The Delegation therefore encouraged other International Searching Authorities to consider offering a similar service to their applicants.

193. The Delegation of Israel stated that the Israel Patent Office had been offering a similar service to PCT Direct since April 1, 2015. This service allowed applicants, when requesting an international search at the Israel Patent Office, to be able to react to objections that had been raised in the search opinion of an earlier application searched by the Israel Patent Office, often by the same examiner that performed the international search. To date, the service had been requested on 16 international applications. Twelve international search reports and written opinions had been established under the service, six of which were fully positive. Where the examiner benefited from the search performed on the earlier application, a refund of 50 per cent of the search fee was offered.

194. The Delegation of the Nordic Patent Institute stated it was hoping to offer a similar service later in 2016 in respect of international applications using the Nordic Patent Institute as International Searching Authority where the international application claimed the priority of an earlier application already searched by one of the national patent Offices of the Nordic Patent Institute's member States.

195. The Delegation of the Republic of Korea expressed interest in the PCT Direct service, which could facilitate the work of International Searching Authorities and lead to improvements in the quality of the international search report. While the service allowed effective communication from the applicant to the search examiner concerning the results of a search on a priority application, the Delegation asked whether the examiner could provide any feedback on the opinions submitted by an applicant through PCT Direct.

196. In response to the question raised by the Delegation of the Republic of Korea, the Delegation of the European Patent Office confirmed that the PCT Direct service was considered a service to applicants, not a new procedure obliging the International Searching Authority to enter into a dialogue with the applicant on the merits of the applicant's arguments set out in the PCT Direct letter; if the applicant wished to have such a dialogue with the examiner, a demand for international preliminary examination would have to be filed. Still, the PCT Direct service

added to the transparency of the Chapter I procedure, as the PCT Direct letter by the applicant was published on PATENTSCOPE together with the international application.

197. The Working Group noted the contents of document PCT/WG/9/21.

SPECIFYING NATIONAL CLASSIFICATION ON THE FRONT PAGE OF PUBLISHED INTERNATIONAL APPLICATIONS

198. Discussions were based on document PCT/WG/9/26.

199. The Delegation of the Republic of Korea informed the Working Group that the Korean Intellectual Property Office (KIPO) had been using the Cooperative Patent Classification (CPC) for national patent applications since January 2015, which was a powerful tool to categorize patents and search prior art. Over the forthcoming two months, KIPO planned to classify international patent applications using the CPC. The Delegation therefore proposed that national classification systems such as the CPC should be added to the front page of published international patent applications. The CPC had been developed by the European Patent Office and the United States Patent and Trademark Office in 2013 and further subdivided the International Patent Classification (IPC), resulting in about 260,000 segmentations. The CPC was used for search by more than 45 patent Offices and over 25,000 examiners, as had been indicated at the CPC Annual Meeting in February 2016. By providing more classification information, the quality of international search reports could improve. The Delegation therefore proposed that the CPC and other national classification information could be added to the front page of the international patent application when published.

200. The Delegation of the European Patent Office supported the proposal and added that if Offices had electronic access to national classification symbols in published international applications, this could reduce the burden for examiners classifying the document in the national or regional phase. However, neither the indication of national classification symbols on the front page of international applications, nor the communication of such data to the International Bureau should be made compulsory.

201. The Delegation of Canada stated that the Canadian Intellectual Property Office could accept adding national classification symbols on the front page of published international applications. The Delegation also supported the inclusion of the CPC on the front page if this was the classification system used by the Office for its national applications. However, it would be inappropriate to add the CPC if the Office normally used a different classification system. The Delegation pointed out that the inclusion of national classification symbols on the front page of the international publication would presumably involve a change to the XML associated with international publication (for example, additional fields, lengths, or order of fields) so that the classification information could be imported efficiently into the search databases where it could be useful. This would likely require a significant lead time so that users of the XML could ensure that their systems were able to process it properly.

202. The Delegation of the United States of America supported the general concept of the proposal and agreed that providing certain classifications on the front page of the published international application in addition to the IPC could be beneficial. The Delegation noted that the proposal specifically made reference to the CPC, but publication of other national classification symbols was also contemplated. The Delegation agreed that the CPC would be a strong candidate for inclusion on the front page of published international applications, especially in view of the large number of International Searching Authorities that used the CPC for the classification of applications and the increasing number of countries that searched using the CPC. However, the Delegation also agreed with the comments made by the Delegation of Canada that any additional classification to the IPC should only be published on the front page if the International Searching Authority used the classification in the course of its classification of national patent applications.

203. The Delegation of Japan stated that the impact on systems at the International Bureau and national Offices needed to be carefully examined before arriving at a conclusion on the matter.

204. The Delegation of Sudan enquired whether it was necessary for an Office to classify an international application if it was only conducting formalities examinations.

205. The Delegation of Israel supported the proposal and agreed with the comments made by other delegations. The CPC would be implemented at the Israel Patent Office from September 2016 for all appropriate technical fields in accordance with the rules of the CPC and definitions.

206. The Delegation of Chile supported the proposal of specifying the CPC on the front page of international applications and added that examiners at the National Institute of Industrial Property of Chile used the CPC in their work operating as an International Searching and Preliminary Examining Authority.

207. The Delegation of China stated that according to Section 504 of the Administrative Instructions, the CPC could already be provided in the international search report and made available to examiners and the public. However, the State Intellectual Property Office of the People's Republic of China did not add the CPC to international applications.

208. The Delegation of the Russian Federation stated that it did not object to specifying national classification symbols on the front page of international applications, but it was necessary to distinguish between the situations where the CPC was used as a national classification and those where the CPC was used as a supplementary classification to the IPC. The Federal Service for Intellectual Property (Rospatent) used the IPC as its national classification. Earlier in 2016, the Rospatent had begun to use the CPC as well within the framework of a bilateral agreement with the European Patent Office. In this case, the CPC was not the national classification and there should be no need to add the CPC to the front page of the international patent application.

209. The Delegation of the United Kingdom stated that the inclusion of national classification data on published international applications was a useful step and it therefore supported the proposal. The Delegation, however, had several observations. First, the practice of publishing classification data under the PCT needed to be consistent with the work being undertaken by the IP5 Offices to harmonize classification practice. Second, it was also important to ensure that translations of the definitions of classification symbols added to the front page of the specification were made available since additional classifications would be of limited use if Offices, applicants and third parties were unable to interpret them. In this regard, the Delegation suggested that such translations should be made available in English, at least. Finally, the Delegation asked about what safeguards, such as validation before publication, would be in place to maintain the quality of published classification data, with accurate classifications being used to ensure the value and efficiency of classification-based search. In the United Kingdom, all IPC and CPC codes applied to a patent application were validated before publication. On this question, the Delegation noted the proposal made by the Delegation of Canada, which had been supported by the Delegation of the United States of America, that national classification codes should only be published if they were applied by an Office when classifying its national applications. This proposal could go some way to allaying concerns about the quality of published patent classifications, and the Delegation was therefore willing to support it.

210. The Delegation of Australia stated that IP Australia classified its national applications under the IPC, and was of the opinion that the most appropriate place to indicate national classification formats was in the international search report. Moreover, the additional benefit of

including national classification schemes other than the CPC in international applications was unclear.

211. The Delegation of Spain supported the proposal and added that including the CPC on the front page of international applications would lead to an improvement in prior art searches as the information would be imported into search databases.

212. The Secretariat expressed its support for the principles behind the proposal, but acknowledged that various practical matters needed to be investigated. From a legal perspective, a modification to Annex D of the Administrative Instructions would be necessary, and Rule 48 may also require amendment. However, the main concerns of the International Bureau were associated with providing and validating the information it received from International Searching Authorities. Ideally, information should be provided in XML so that the information could be imported directly into systems at the International Bureau without transcription. In the case of the CPC, the International Bureau might have the capacity to validate classification information, but validation at source was more desirable. Furthermore, the International Bureau needed to consider the IT standards to support the publication of the additional data, where it appeared preferable to make changes to the XML standards for both the international search report and international publication. This would affect the timescale of any implementation. However, in general, the International Bureau supported the proposal and indicated willingness to work together with the Korean Intellectual Property Office in drawing up a complete proposal.

213. The Delegation of the Republic of Korea thanked the delegations for their support for the proposal. The Delegation hoped to discuss the proposal to include national classification symbols to improve the quality of international search reports and reduce workload at future meetings. Initially, providing the national classification could be optional, as was classification of an application by an Office only performing formalities examination.

214. The Working Group invited the Korean Intellectual Property Office to work with the International Bureau to develop and discuss the legal and technical issues related to implementation of the principles set out in document PCT/WG/9/26 and also invited the International Bureau to issue a Circular to collect comments and information on national classification from Offices. All the above information would be considered by the Working Group at its next session.

PCT MINIMUM DOCUMENTATION STATUS REPORT

215. Discussions were based on document PCT/WG/9/22.

216. The Delegation of the European Patent Office reported on the PCT Minimum Documentation Task Force. A task force had been set up in 2005 under the leadership of the European Patent Office to undertake a comprehensive review of the PCT minimum documentation, but progress was stalled in view of lack of consensus on certain issues. The present PCT Minimum Documentation Task Force had been set up following a decision by the Meeting of International Authorities in 2012, but discussions had not been particularly active. Earlier in 2016, the European Patent Office had taken over the leadership of the Task Force. One of the main reasons for little activity in the Task Force was the ongoing work among the IP5 Offices as part of the documentation foundation project, where each Office had made an inventory of its documentation with a view to achieving common documentation between Offices. In terms of urgent matters, the Meeting of International Authorities had referred to the Task Force the request to add the Indian Traditional Knowledge Digital Library to the PCT minimum documentation. On this request, mechanisms would need to be defined for International Authorities to take a decision. The European Patent Office would also be tabling some topics for discussion. The Task Force would need to conduct an analysis of the existing definition of the PCT minimum documentation to identify any shortcomings, noting that the definition needed updating to be fit for the digital age. It was necessary to define the criteria to

add a patent collection of a certain country to the PCT minimum documentation. The Task Force also had to discuss the criteria for the inclusion of utility models, which could provide a valuable addition to the PCT minimum documentation. Moreover, the Task Force would need to consider non-patent literature collections, taking into account that access to specific collections was usually acquired on a commercial basis and nowadays involved groups of journals rather than individual subscriptions. The Delegation concluded by inviting each International Authority to nominate one or more representatives to join the Task Force electronic forum if it had not done so already.

217. The Delegation of Canada stated that the outline of the proposed work by the European Patent Office was a good first step and it looked forward to contributing when proposals were posted on the Task Force electronic forum.

218. The Working Group noted the contents of document PCT/WG/9/22 and invited Offices to designate participants in the Task Force led by the European Patent Office.

PCT SEQUENCE LISTING STANDARD

219. Discussions were based on document PCT/WG/9/15.

220. The Delegation of the European Patent Office, as leader of the Task Force on Sequence Listings, informed the Working Group that, following the adoption of the WIPO Standard ST.26 at the reconvened fourth session of the Committee on WIPO Standards (CWS) in March 2016, the Task Force was working on the technical assessment of the transition from WIPO Standard ST.25 to ST.26. The Task Force would be working together with the International Bureau on the changes that would be required to Annex C of the Administrative Instructions and would be consulting the PCT Member States on the transition scenarios with a view to proposing recommendations on the transition to the fifth session of the CWS in 2017.

221. The Delegation of Japan welcomed the formal adoption of ST.26 by the CWS. The Japan Patent Office supported the Task Force continuing to discuss the timing and scenarios of the transition from ST.25 to ST.26 with the aim of the transition being approved at the fifth session of the CWS in 2017.

222. The Delegation of the United States of America welcomed the formal adoption of ST.26 and agreed with the roadmap proposed in the document to start the eighth round of consultations aimed at completing the technical assessment of the transition from ST.25 to ST.26. While the Delegation continued to support the work of the Task Force on the transition to ST.26, due to competition for limited resources at the United States Patent and Trademark Office, it could not make a firm commitment to the timing of the transition at this stage.

223. The Delegation of Australia welcomed the formal adoption of ST.26 for the presentation of sequence listings at the reconvened fourth session of the CWS. The Delegation stressed the need for a coordinated effort to achieve a smooth transition to ST.26. In this respect, the roadmap set out in the document was a useful start. It was also important that any technical solution implemented should be compatible across IP Offices, rather than each Office delivering its own technical solution to achieve the transition. To achieve this objective, the Delegation suggested that ePCT could provide a central and coordinated way to file XML-based sequence listings for later transmission to Offices in the national phase and asked the International Bureau to consider this matter further.

224. The Delegation of Israel supported the adoption of ST.26, but a smooth transition from ST.25 to ST.26 needed to be ensured. A transition period would give all International Authorities and national Offices sufficient time to prepare their IT systems to process sequence listing filed in compliance with the new standard.

225. The Working Group noted the contents of document PCT/WG/9/15.

REVISION OF WIPO STANDARD ST.14

226. Discussions were based on document PCT/WG/9/7.

227. The Secretariat informed the Working Group that a revised WIPO Standard ST.14 had been adopted at the reconvened fourth session of the Committee on WIPO Standards (CWS) in March 2016. The revised ST.14 as adopted was as set out in the Annex to document CWS/4BIS/3 with the amendments referred to paragraphs 11 to 14 of the Summary by the Chair of the session (document CWS/4BIS/15 Rev.). The Secretariat explained that the CWS had selected option (b) in paragraph 9 of document CWS/4BIS/3 for the definition of category "E" in relation to its use with categories "X", "Y" or "A". There was also a revision to paragraph 16 of the draft Standard in the Annex to document CWS/4BIS/3, to take into account the concerns raised by an International Authority at the twenty-third session of the Meeting of International Authorities in January 2016 in relation to the use of non-Latin text in search reports when the text came from older documents where the text would not be available in a selectable text format that copied directly into the search report (see paragraph 92 of document PCT/MIA/23/14, reproduced in the Annex to document PCT/WG/9/2). The final wording of paragraph 16 of the revised ST.14 was reproduced in paragraph 13 of document CWS/4BIS/15 Rev. With the adoption of the revised WIPO Standard ST.14, Task No. 45 created by the CWS at its second session in 2012 had been completed. Overall, the revised Standard included refinements to the definition of category codes in paragraph 20 of the Standard, and changes to the citation of non-patent literature in reports. However, in terms of the definition of category "X" for the lack of novelty or inventive step when the document is taken alone, the Task Force had agreed to maintain the existing definition rather than replace it with categories "N" and "I" to distinguish between novelty and inventive step based on a single document. The revised WIPO Standard ST.14 would be published on the WIPO website after the adoption of the Report of the CWS, which was expected to take place later in May.

228. The Delegation of Japan welcomed the adoption of the revised Standard ST.14 and asked when the revised ST.14 would take effect in the PCT.

229. The Delegation of the European Patent Office stated that it supported the revisions to Standard ST.14 adopted by the CWS. In particular, the European Patent Office agreed with option (b) in paragraph 9 of document CWS/4BIS/3 and the amendments made to paragraph 16 of the Standard. The European Patent Office also supported the outcome not to include the revisions to the definition of category "P" that had been prepared by the Task Force to extend its scope to cover documents published prior to the (international) filing date but on or after the priority date claimed in the application, as indicated in paragraph 11 of document CWS/4BIS/3.

230. The Delegation of the Republic of Korea welcomed the adoption of the revised Standard ST.14 and commented that paragraph 16.73 of the PCT International Search and Preliminary Examination Guidelines describing the use of category "E" would need to be amended to take into account the changes made in option (b) of paragraph 9 of document CWS4BIS/3.

231. The Delegation of the United States of America supported the comments made by the Delegation of the Republic of Korea and added that other consequential amendments would need to be made to the PCT International Search and Preliminary Examination Guidelines.

232. The Secretariat, in response to the question raised by the Delegation of Japan about the implementation of the revised ST.14 in the PCT, informed the Working Group that it would issue a PCT Circular to begin the consultation process to make the necessary modifications to implement the revised Standard in the PCT Administrative Instructions and International Search and Preliminary Examining Guidelines.

233. The Working Group noted the contents of document PCT/WG/9/7.

COLOR DRAWINGS

234. Discussions were based on document PCT/WG/9/19.

235. The Secretariat explained that a solution for processing of color drawings filed electronically in the international phase had been proposed at the seventh session of the Working Group, but the solution had been discovered to be impractical to implement and could have reduced the quality of service for some applications containing black and white drawings. The document proposed a different solution, which would only offer full processing of color drawing in the international phase for applications filed in XML format. The process which would be followed was set out in paragraph 7 of the document. The key aspects of processing were that, where the application was filed in XML format, the receiving office would conduct its formalities examination based on a PDF or HTML rendering of that, showing the drawings in color. The application would then be sent to the International Searching Authority in both XML and color PDF formats. The International Bureau would treat the XML version as the official publication and also make color HTML and color PDF views available. The XML version would be communicated to designated Offices as the official published application on the basis of which national phase processing would usually commence. But, if necessary, the International Bureau could also produce a black and white TIFF view as an automated conversion, for the benefit of designated Offices which were not able to accept color. The applicant would, however, always be able to submit amended black and white drawings if necessary to meet formalities requirements in Offices which require black and white drawings if the automated conversion was not considered adequate. The International Bureau believed that the proposed arrangement could work as it depended on more modern components of IT systems which the International Bureau was intending to develop to support better full text processing of international applications in the future. However, it was important to be aware of its limitations. First, all International Authorities would need to be able to accept search copies in color, either as XML or PDF. This would require agreement on technical standards, such as acceptable formats for color drawings, and assumed Offices would be able to adapt their systems so that examiners working on international searches were able to view a color PDF file as the search copy, even if the process was not fully integrated into the IT systems at the International Authority. These limitations could affect the timing of when the process could begin. Second, the process would not involve amendments to Rule 11 to make explicit provision to allow color drawings. As the Working Group had discussed at previous sessions, while the International Bureau believed that this should be the goal for the future, there was little prospect of amending this Rule to come into force in the near future, due to effects on the national phase. Finally, XML filings were relatively unusual at most receiving Offices. The International Bureau had taken steps to encourage greater use of XML, such as the process in ePCT for uploading docx filings, but there were legal issues and questions concerning the quality of the conversion to XML format which would mean the uptake of this process would take time. As a result, the Secretariat suggested revisiting an interim proposal that had been made in 2012, where the International Bureau would make available on PATENTSCOPE a color PDF version of the application as originally filed, in addition to the conversions in black and white which were currently made available. This solution would be relatively quick to implement, and could be incorporated into PCT SAFE and ePCT-filing in January 2017. Ideally, there would be a front page notice that the publication was a black and white version of an application which originally contained color drawings, which would inform people that the original version could be found on PATENTSCOPE. The Secretariat concluded by inviting feedback on two main issues. First, was the proposal for color processing of XML files set out in the document acceptable, especially to International Authorities who would need to be able to handle search copies adequately? And second, were Offices interested in the interim solution set out in paragraphs 11 to 15 of the document to deal with the short term issues and provide a route for applicants only able to file in PDF format?

236. The Delegation of Israel stated that it had supported previous proposals to lift the restrictions to the use only black and white drawings in an international application since it was

sometimes difficult to explain inventions in some technical fields without the possibility to use color. The IT systems at the Israel Patent Office were able to handle color drawings in an automated way throughout the international phase when the application had been filed in XML or PDF format. Moreover, the Israel Patent Office had changed its legal frameworks and technical systems in order to permit the filing and the processing of color drawings in the national phase. The Delegation therefore supported the approach proposed in the document, which would allow full color processing in the international phase for applications filed in XML format, and it considered the timeline of the middle of 2018 in the document to be reasonable.

237. The Delegation of the European Patent Office underlined the importance of finding a coordinated solution to process applications with color drawings. There was an overdue necessity to be able to include color in patent applications, not only to give additional possibilities for applicants, but also for examiners, who were confronted with prior art in color. The European Patent Office could accept patent applications in color and had the possibility to access to the originally-filed color drawing on an *ad hoc* basis, but it did not process them “end to end”. The European Patent Office believed the limitation of color drawings to XML filings was too restrictive; applicants would expect Offices to support color for Word and PDF formats and it was likely that Offices already processing color drawings also accepted both these formats. As far as the transition to processing color drawings was concerned, the European Patent Office could implement a technical solution by the middle of 2018 if this was well-planned, but it did not have a date when it would be able to cover “end to end” processing of color documents under its new systems. Furthermore, the Delegation suggested that the International Bureau made a list available of Offices that were able to support color, which should be updated regularly. From the legal point of view, certain aspects needed to be investigated to ensure that the change was in line with the Patent Law Treaty. First of all, color drawings filed on paper should be sufficient for according a filing date and such filing should not result in a loss of filing date. Secondly, color drawings should be able to be filed on paper for the purposes of meeting time limits. In this regard, the European Patent Office also considered whether a system needed to be established for the issuance of priority documents for applications with color drawings filed on paper without loss of content of disclosure. In addition, it would also be useful that color drawings filed on paper could be accessed by the Offices without loss of content of disclosure. The European Patent Office therefore believed these aspects could be further assessed. As to the legal basis, Rule 11 required drawings to be presented in black and white, so amendments to the Administrative Instructions and Receiving Office Guidelines did not appear to be sufficient.

238. The Delegation of the United States of America agreed that providing for the possibility for applicants to file international applications with color drawings was overdue. Like the European Patent Office, the United States Patent and Trademark Office accepted color drawings but did not process them “end to end”. The Delegation also supported the request of the European Patent Office for a list of Offices that could support color in patent applications. The Delegation nevertheless had concerns about the proposal to process applications with color drawings when filed in XML format. First, for designated Offices that did not accept color drawings, there could be a lack of legal certainty as to which version of the drawings formed the basis of the national application. Additionally, some applicants could use color to their detriment in that the black and white rendering that would form the basis of the application in many national Offices could be of poor quality with the risk of loss of disclosure. With respect to technical issues at the United States Patent and Trademark Office (USPTO), the provision of the search copy in PDF containing color images was problematic for existing IT systems, with a black and white TIFF image package being required, as contemplated in paragraph 7(f) of the document. Moreover, the USPTO had plans to be able to receive eSearchCopy packages from the International Bureau, which hoped it could implement in 2017. However, if the XML process were adopted, this would further delay the implementation to receive eSearchCopy packages. With regard to the USPTO in its capacity as a designated Office, current IT systems would likewise need a black and white TIFF package. With this in mind, the Delegation preferred the interim solution as described in paragraphs 13 to 15 of the document. However, applicants could still use color

in applications to their detriment under this solution since a black and white rendering would form the basis of the application in many national Offices. This could therefore affect the disclosure in applications, raising legal questions on which form of the drawings were the basis of those applications. Returning to the suggestion of the European Patent Office to compile a list of Offices that could support color in patent applications, this could be important as this might identify a “tipping point” when a full amendment of Rule 11 could become practicable. The Delegation concluded by indicating that current efforts to modernize IT and e-commerce systems at the United States Patent and Trademark Office could provide a different answer in 2017 or 2018 to some of the technical issues that the Delegation had raised.

239. The Delegation of Japan stated that it was necessary to study the legal and practical impacts of the proposal, for example, transmission to the national phase, before allowing the possibility to file color drawings in international applications. At the Japan Patent Office, color drawings were not acceptable in domestic and international patent applications, and acceptance in the PCT System could require revision to national law, which would take time. Moreover, the proposal in the document only related to electronic filings, and the Delegation stated that it was necessary to study the possibility of applying the same principle to paper filings in the near future. Therefore, the Delegation was not able to agree to the proposal in the document at this stage.

240. The Delegation of Australia informed the Working Group that IP Australia, in its capacity as a receiving Office, would be able to accept color drawings if permitted by the PCT Regulations. IP Australia was also interested in participating in a solution to provide for color drawings in the PCT, as many of its applicants had expressed frustration of not being able to submit color drawings in the PCT System to help depict their inventions accurately. The Delegation supported the interim solution, which it believed was a sensible way forward, particularly the transitional measure outlined in paragraph 13 of the document that would result in color drawings being made available on PATENTSCOPE. Finally, the Delegation supported the proposal by the European Patent Office to compile a list of Offices supporting color drawings.

241. The Delegation of China informed the Working Group that an internal user survey at the State Intellectual Property Office of the People’s Republic of China had shown that applicants from some industries, such as those in the biological and pharmaceutical fields, wanted color drawings to be accepted in the PCT System. However, processing of international applications in color in the international phase depended on whether internal systems at receiving Offices, International Authorities and the International Bureau could technically support color drawings, which required time and resources to develop and update these systems. In order to ensure color drawings could be processed properly in the international phase, the Delegation suggested that there should not be a uniform deadline for all International Authorities to be able to conduct an international search on an application containing color drawings. Meanwhile, applicants needed to be appropriately informed of the possible risks in the national phase of certain countries to applications filed with color drawings.

242. The Delegation of Spain informed the Working Group that patent law in Spain would be amended as of April 1, 2017, to allow for the submission of color drawings within a year. The issue of format of the color drawings was less of a concern; both PDF and XML were acceptable. With regard to format, the Spanish Patent and Trademark Office received more than 50,000 trademark applications per year, where color drawings were allowed in various formats, with few difficulties being encountered.

243. The Delegation of the Republic of Korea explained that the Korean Intellectual Property Office (KIPO) accepted color drawings in national patent applications, which could be as part of an XML text file with the color image in JPEG format. Examiners at KIPO had found color images an effective way to describe and understand the invention, and the Delegation therefore hoped that the processing of color drawings would be possible soon in the PCT. In terms of the

interim solution set out in paragraphs 11 to 15, the Delegation pointed out that errors could also occur during the filing of color drawings as well as the conversion in the ePCT system.

Therefore, when an applicant insisted that there had been an error in the conversion to black and white, for example, in the search copy or at international publication, it could be difficult to verify that the error occurred in the conversion without reverting to the receiving Office to check the originally filed color drawings. It was therefore desirable for the ePCT system to make an automatic check on whether there were errors in the conversion.

244. The Delegation of Chile supported the efforts to allow color drawings to be processed in the PCT and welcomed the interim solution to convert color images to black and white with a notice placed on the front page to indicate that there were original images filed in color or greyscale that could be downloaded from PATENTSCOPE.

245. The Delegation of Colombia stated that users of the industrial property system were asking for Offices to find solutions for processing of color drawings, and agreed with other delegations that color drawings provided detail that was necessary to illustrate inventions in some technical fields. The Delegation added that it was necessary to find a solution for color drawings for XML and PDF filings. The Superintendencia de Industria y Comercio in Colombia was already able to accept requests or applications with color drawings, as it processed applications for trademarks and industrial designs as well as patents.

246. The Delegation of Canada explained that, due to a review of internal processing systems, the Canadian Intellectual Property Office (CIPO) was not able to commit to the proposed solution of accepting XML applications with color drawings. However, like the European Patent Office and the United States Patent and Trademark Office, color drawings could be accepted at CIPO but not processed “end to end”. For processing of international applications in XML format, it was necessary at CIPO to follow a manual process which could be problematic if large number of international applications in this format were filed due to the possibility to include color drawings. Moreover, there was no near-term fix to automate the process. The Delegation nevertheless acknowledged the importance of color drawings in some technological areas and CIPO would endeavor to make improvements to internal processing systems in the future to be able support the processing of color drawings and other technical improvements in the PCT.

247. The Delegation of the United Kingdom explained that the Intellectual Property Office of the United Kingdom (UKIPO) accepted patent applications in color but did not process color from “end to end”. The UKIPO was overhauling its digital services, which included updating IT systems to allow processing and publication of applications in color, but this work was likely to take several years. In the meantime, in its role as a designated Office, the UKIPO would require black and white versions of published WIPO specifications. In its role as a receiving Office, the UKIPO could accept color drawings, including XML format, which it could forward to the International Bureau, as proposed in paragraph 7 of the document. However, given that many more color applications could be received if the proposal were adopted, the UKIPO would need to perform further testing to confirm the feasibility of transferring these files to the International Bureau in bulk as part of its regular batch transfers. In conclusion, the Delegation stated that it could support the interim proposal.

248. The Delegation of Portugal stated that the Portuguese Institute of Industrial Property had supported color drawings in its national applications since 2014, which needed to be in PDF format. The Delegation also agreed with the suggestion by the European Patent Office for the International Bureau to compile a list of countries that accepted color drawings in patent applications.

249. The Delegation of Denmark supported the introduction of color drawings into the PCT System, which was supported by users in Denmark. The Danish Patent and Trademark Office (DKPTO) had been able to process color drawings in national patent applications for some time, which could be received in several different formats, with the majority filed electronically through

the eOLF system provided by the European Patent Office or the web based online filing system at the DKPTO. As such, the DKPTO did not foresee a technical problem with accepting the procedure and requirements in paragraph 7 of the document in its capacity as a designated Office, but it indicated that applicants primarily filed in PDF format, with the XML format being considerably less popular. If color drawings were only allowed in XML format, the use of color drawings could be limited, at least until ePCT was more widely used. The Delegation also indicated that it could support the interim solution proposed in the document.

250. The Representative of the Japan Patent Attorneys Association (JPAA) expressed a preference that a system for allowing color drawings could also accept PDF format since XML filings were not the majority. By the International Bureau providing a facility to convert applications filed in a DOCX format automatically to XML, the Representative asked the Secretariat whether this facility was expected to encourage a large proportion of applicants to file in XML format. Color drawings facilitated the understanding of inventions and if applications with color drawings became the majority and there were no other technical problems, it could be possible that most designated States could accept color drawings.

251. The Representative of the Japan Intellectual Property Association (JIPA) hoped that color drawings could be permitted in international applications, which could enhance the representation and improve the understanding of inventions. As an example, in technical fields such as image compression technology or video compression technology, technical discussion often took place based on color images, which provided useful information to understand the technical effect of the invention correctly and distinguish the invention from the prior art. As another example, in the mechanical field, color images could depict naturally-shaped three dimensional objects better than a black and white image and therefore reduce the risk of misunderstanding the object and facilitate the comprehension of the invention. The Representative therefore expressed some concern about the automated conversion of color drawings into black and white. If a deficiency were generated during the conversion, JIPA believed that it should be permitted to base the application on the color at the time of international filing, whether in the international phase or the national phase.

252. The Secretariat stated that it was encouraged by the number of Offices that were able to accept color drawings in patent applications, which appeared to be an increase on the situation a few years ago and agreed with the European Patent Office that it could be useful to compile and make available a list of such Offices. In compiling this information, the International Bureau could also ask Offices about any technical work that was underway to provide for color drawings, along with expectations of when color drawings could be processed by an Office. With regard to the main proposal in the document, the Secretariat considered that there was support in principle, but many details needed to be looked into, which might require modifications to the proposal both in terms of the technical content and the implementation date. However, it was important that modifications to IT systems at individual Offices were heading in the same direction to reach a position when color drawings could be widely accepted. The Secretariat therefore considered it important to restart technical discussions on color drawings to ensure that issues could be addressed. However, at this stage, it was important to be clear on whether delegations could accept the interim solution with the transitional measures proposed in paragraphs 11 to 15 of the document. The Secretariat recognized the support for this idea as means of dealing with applications in the interim, but it was important to look into the legal issues that had been raised, both as to the issues of legal certainty for applications that were filed in color and converted to black and white, and in terms of treating paper applications. These issues were not new. Applicants already filed in color on paper, PDF and XML, and some XML systems already checked to allow only black and white formats. However, this could result in poor quality conversions when a greyscale drawing was turned into pure black and white, and for the purposes of conversion, black and white photographs were handled like color photographs. The transitional provisions being proposed could assist to tackle these issues. As color drawings were a formalities defect under Rule 11, an applicant filing color drawings should have the opportunity to correct the defect before any

designated Office or for the purposes of international publication, if necessary, when the conversion had been unsatisfactory. But the problem of an applicant being able to make such a correction by trying to depict information from a color drawing using only black and white successfully without adding subject matter already existed, and by providing designated Offices with access to the originally filed color drawings could assist in determining whether a valid amendment was possible under national law. The International Bureau therefore wished to proceed with the transitional measures in the interim solution as it would provide designated Offices and the public with useful information on the originally filed color drawings. In relation to the question from the European Patent Office about color drawings on paper, it could be possible to consider having a check box in the paper version of the request form to indicate that the application needed to be scanned in color, even if it would be time consuming to divert applications to a different process. In terms of legal provisions, as the main technical proposal would not be implemented before 2018, this provided time to consider if any amendments to the PCT Regulations were necessary at the next session of the Working Group. Finally, in response to the question from the Representative of the Japan Patent Attorneys Association (JPAA) on the conversion of files in ePCT from a DOCX format to an XML format, the International Bureau hoped that the system would, in time, encourage a large proportion of applicants to file in XML. There were legal issues to address, but the most important factor was trust in the system by applicants. The International Bureau therefore encouraged users to look at the conversion tools in the ePCT demo environment, test the system and provide feedback on the conversion process.

253. The Delegation of Austria stated that it did not have objections to proceeding as suggested by the International Bureau.

254. The Delegation of European Patent Office stated that it was necessary to perform a technical analysis before implementing the interim solution, so it was therefore unable to commit to this approach during the session. In particular, the European Patent Office needed to consider the handling of color drawings on paper.

255. The Working Group agreed that the International Bureau should issue one or more PCT Circulars for consultation on:

- (a) the technical, legal and administrative issues involved in beginning the interim solution set out in paragraphs 11 to 15 of document PCT/WG/9/19;
- (b) the technical and legal issues involved in ensuring that Offices are able to work effectively towards implementing full processing of international applications with color drawings, at least for the international phase and at least when filed in XML format;
- (c) understanding the legal and administrative issues which may apply to the responsibilities of the receiving Office, priority documents, subsequently-filed documents, documents filed on paper or in formats other than XML, and to the relationship of these issues with the Patent Law Treaty; and
- (d) finding out which Offices accepted color drawings at present in their various capacities (receiving Office, International Authority or designated Office) or were conducting work towards being able to do so in the future.

NUMBER OF WORDS IN ABSTRACTS AND FRONT PAGE DRAWINGS

256. Discussions were based on document PCT/WG/9/16.

257. The Secretariat explained that, while the International Bureau had been working on metrics, it had been noticed that there were a high number of international applications with abstracts that were much longer than the recommended maximum of 150 words set out in

Rule 8.1(b) and/or with drawings containing large volumes of text. There had also been significant number of abstracts with fewer than the recommended minimum of 50 words, and some cases with very short abstracts of about five words, where it could be questionable whether the abstract conveyed a clear understanding of the invention. One issue with long abstracts was the financial impact on the International Bureau. Translation work was outsourced, with contracts based on abstracts generally not exceeding 150 words, so longer abstracts resulted in higher charges than expected. While the International Bureau could budget for higher costs in the future, there remained the fundamental question of whether the abstract and text on the front page drawing as filed by the applicant or revised by the International Searching Authority served their intended purpose as indicated in the Regulations. Paragraph 23 of the document sought the views from Offices and user groups on various questions, which could assist in whether the International Bureau should take steps to attempt to keep abstracts and drawings within the Rules, or whether the Regulations or processes at the International Bureau needed to be changed. For example, the recommended range for the length of abstracts was based on the length in English either as filed or translated. As this made it difficult for an applicant to assess whether an abstract filed in one of the Asian publication languages fell within this range, it might therefore be appropriate to improve guidelines for writing abstracts in languages other than English to provide a useful abstract when published.

258. The Delegation of the United States of America stated that it sympathized with the issues concerning the resources needed to process and translate long abstracts and drawings containing large amounts of text, and agreed with the comments in paragraphs 17 and 18 of the document that abstracts that were either too short or too long were not always useful with respect to their intended purpose of serving as a scanning tool for examiners to ascertain quickly the subject matter of an application. As the International Bureau intended to have a more detailed discussion at the next session of the Meeting of International Authorities, the Delegation reserved the bulk of its comments to this later discussion. However, the Delegation had two initial comments. First, the ultimate responsibility to establish the abstract and select the figure for the front page of the application lay with the International Searching Authority. Authorities could therefore make more effort to emphasize to employees the importance of not merely accepting the abstract or front page drawing as submitted by the applicant, but rather establish abstracts of appropriate length so as to serve their intended purpose, as well as selecting a front page figure that did not contain a large amount of text but nevertheless illustrated the invention. Second, in view of the implications from paragraph 9 of the document and comments made by the Secretariat, a recurrent issue with abstracts was length of abstracts when not filed in English. In this regard, the Delegation agreed that more details were needed in the International Search and Preliminary Examining Guidelines on word limits in languages other than English for the translation into English to be approximately equal to the range of 50 to 150 words in English, and this information should be drawn to the attention of applicants. Finally, the Delegation asked whether the references in the document to the text in the front page figure not being searchable referred to just the original text, or also the translation provided by the International Bureau.

259. The Delegation of the Republic of Korea stated that, when an abstract was filed in Korean, it was difficult to estimate the likely word count of the English translation, adding that the two languages had a very different sentence structure. A formalities examiner at the Korean Intellectual Property Office (KIPO) acting in its capacity as a receiving Office could inform the applicant of Rule 8.1(b) relating to the number of words in English. But it was for the search examiner at KIPO, acting in its capacity as an International Searching Authority, to verify and make any revisions to ensure that the abstract in Korean summarized adequately the description, claims and drawings to enable a clear understanding of the technical problems by a person skilled in the art. However, it was not the responsibility of the International Searching Authority to consider the translation into English. The Delegation therefore echoed the suggestion of the Delegation of the United States of America to have more guidance on the length of abstracts in other languages to ensure appropriate disclosure of the invention.

260. The Delegation of Australia stated that there were many helpful questions and suggestions in paragraphs 23 to 25 of the document, which the Delegation would endeavor to respond to at a later date. However, in relation to the question in paragraph 23(d), the Delegation pointed out that abstracts were used very differently when searching nowadays compared to the time when the PCT Regulations were written. Online search tools allowed for searching keywords across the text of the full specification, and the greater prevalence of machine based translation had allowed Offices to access citations, regardless of their native language. While abstracts were a relevant part of the published pamphlet and some Offices used them more prominently, IP Australia believed that the Working Group could consider the real effects that abstracts had on searching and whether improvements and efficiencies could be gained.

261. The Delegation of Austria commented that the Austrian Patent Office, in its capacity as a receiving Office, sometimes received applications in German where the drawings included written text in English. This text was requested to be translated into German, but was later translated back to English by the International Bureau for the front page figure. The Delegation therefore asked whether a more pragmatic approach could be to accept text in English in some cases for drawings of an application not filed in this language, noting that the it would usually be sufficient for a skilled person to understand a flow chart if the text were left in English.

262. The Delegation of Israel addressed the efforts that could be made to encourage applicants to file better quality abstracts and drawings with a minimum of text, as raised in paragraph 23(f) of the document. The Israel Patent Office supported the idea of limiting the number of words in abstracts, which could be achieved by amending the word “preferably” in Rule 8.1(b) to a stronger term such as “shall” and include limits for filing languages other than English. This Rule could then act as a basis for the receiving Office to invite the applicant to shorten the abstract. The International Bureau could also be able to postpone any translation until the applicant or the International Searching Authority had provided an abstract within the permitted word count, thereby saving double translation work. Regarding the figure to accompany the abstract, the choice from the applicant could be limited to figures that contained a maximum number of words, or otherwise the International Searching Authority would choose a different figure within the limit at its discretion. The Delegation also suggested discouraging the use of flow charts as the front page drawing since these were often not useful figures for elaborating or understanding the abstract.

263. The Delegation of Japan stated that it understood the concerns that had been raised in the document and stressed that applicants needed to be asked for their opinions as the main users of abstracts of international publications. As regards paragraph 25 of the document, the Delegation thought it should be possible to develop guidelines for drafting abstracts in languages of publication other than English, but hoped that any guidelines created were not overly strict on the number of words for applicants not using English.

264. The Delegation of China agreed that the English translation of the abstract and the text on the front page drawing could assist in effective search, which needed to be regulated. However, for the purpose of effective publication and providing an important source for searching, any rules on the abstracts and the drawings should take other factors into consideration, such as cost, quality, availability for search and the readability for patent examiners and the public. The statistics in the document showed that longer abstracts and drawings with larger volumes of text added to the costs of translation. However, there was no direct evidence to prove the correlation between the number of words in abstracts and high quality, and it was necessary to consider the different characters used in the various publication languages. With computer search systems, a clear and complete abstract with searchable text and an appropriate figure to accompany the abstracts would improve the effectiveness of search and quality of work products in the international phase. Moreover, inventions of different technical fields might have different requirements on the abstract and the drawings in terms of clearly and completely describing the subject matter of invention. At this stage, the standard for

evaluating the quality of the abstract and necessity of the text in drawings was not particularly clear. Moreover, it was necessary to be aware of the needs of applicants concerning the format of the abstract and drawings. The Delegation therefore suggested that the measures proposed in the document could be based on further research and analysis as well as usability.

265. The Delegation of Canada appreciated the work of the International Bureau to monitor the costs of the work for which it was responsible under the PCT and to take action in areas with negative impact on resources. The Delegation had numerous thoughts on the content and quality of abstracts and front page drawings and suggested that the detailed comments from both Offices and applicants on the issues raised in the document could be collected through a Circular in time for the 2017 Meeting of International Authorities. The Delegation also agreed with the comments made by the Delegation of Australia on paragraph 23(d) of the document.

266. The Delegation of the Russian Federation recognized the problems identified by the International Bureau in the preparation of abstracts and the resources required for their translation and believed it would be worthwhile to reconsider or amend the guidelines for preparing abstracts. In this process, it was important to take into account that the length of an abstract needed to summarize a technical disclosure varied between technical fields, and that the number of words in the English translation of some languages would be greater than the original language. For example, unlike English, in Russian there was no need indicate an article or auxiliary word, and in German, composite nouns could be expressed in one word only, but would translate into several words in English. However, it would be a very strict requirement if applicants were required to prepare the English abstract themselves.

267. The Delegation of France agreed that the issue of abstracts and front page drawings was of interest to all Offices and users and therefore supported the suggestion made by the Delegation of Canada to issue a Circular to collect feedback in preparation for the discussion at the Meeting of International Authorities.

268. The Delegation of Denmark stated that it understood the practical problems and additional costs for translating lengthy abstracts in the document and suggested that applicants and Offices could pay more attention to the drafting of abstracts to ensure compliance with the PCT Regulations. National legislation in Denmark did not invite a thorough review of abstracts and at the Danish Patent and Trademark Office, examiners seldom scrutinized abstracts of applications in great detail. In relation to paragraph 23(d) of the document, the Delegation agreed with the comments made by the Delegation of Australia and supported by the Delegation of Canada that searches were primarily based on full text online databases where the purpose of the abstract was less clear compared to paper searches through documents. With regard to the remainder of the questions raised the document, the Delegation was willing to respond in detail through a Circular.

269. The Delegation of the European Patent Office referred to the purpose of the abstract, which should provide a summary of the technical information about the disclosure as contained in the description, claims and drawings. In some cases, a short abstract of less than 50 words could properly reflect an invention, whereas in other cases an abstract longer than 150 words might be required. For certain applications, it could therefore be justifiable to deviate from the preferred length specified in Rule 8. Furthermore, an abstract that was too short could be more problematic than one that was too long since the former might not cover all aspects of the invention, whereas the relevant information could be identified in the latter using highlighter functions in an online search tool. In this regard, the Delegation agreed with the comments made by the Delegation of Australia about the use of abstracts for searching and browsing referred to paragraph 23(d) of the document in view of examiners using electronic tools for searching documents much more than paper. Finally, the Delegation agreed that it could be useful to develop guidelines providing recommendations relevant to the drafting of abstracts in languages other than English, as suggested in paragraph 25 of the document.

270. The Delegation of Chile agreed with the International Bureau with regard to raising the issue of abstract and text in front page drawings at the next Meeting of International Authorities, given the responsibility of International Searching Authorities under Rule 38 to ensure the content is in compliance with the Regulations. It was also necessary to ensure that the published abstract facilitated the transfer of technologies by being accessible to all users of the patent system.

271. The Delegation of Colombia agreed with the Delegations of Denmark and the European Patent Office in terms of the decreasing importance of the abstract for prior art searching by examiners, third parties and other stakeholders, given the greater use of electronic search tools and increasing availability of the full text of documents in searchable format. Examiners at the Superintendencia de Industria y Comercio in Colombia did not draft abstracts, but used text from the applicant that best summarized the invention. The Delegation therefore supported taking the issue forward and considering a potential modification of the Regulations.

272. The Delegation of Spain agreed with many of the previous interventions, but stressed that International Authorities should make more effort to review the quality of abstracts with regard to the recommended number of words. While searchers often used the full text for searching, abstracts nevertheless played an important role in search tools used by examiners such as EPOQUE-Net and publicly available databases such as Espacenet, where the abstract would be the first text of the document looked at by the person performing a prior art search. The abstract therefore continued to be valuable and it was important for the International Bureau to look to improve their quality and control the number of words. While the Spanish Patent and Trademark Office did not revise all abstracts provided by applicants, examiners would make changes where the abstract was not appropriate. It was therefore important that International Searching Authorities were rigorous in reviewing abstracts to ensure they served their intended purpose.

273. The Delegation of the United Kingdom responded to the comments made by the Delegations of Australia, Denmark, the European Patent Office and Colombia about the decreasing usefulness of abstracts in light of more full text electronic searching. At the Intellectual Property Office in the United Kingdom, examiners relied on abstracts as the primary source of information, which was complemented by full text searching where deemed appropriate. Full text searching was therefore not used in place of searching abstracts in the appropriate technical field. The Delegation therefore underlined the importance of high quality abstracts and supported efforts to maintain and improve their quality. The Delegation also agreed that the International Bureau could issue a Circular to invite Offices and users to submit comments to be able to collect the full range of information from Contracting States before taking decisions on further action in this area.

274. The Representative of the Asociación de Agentes Españoles Autorizados ante Organizaciones Internacionales de la Propiedad Industrial (AGESORPI) agreed with the comments made by the Delegation of Spain. While powerful search tools were available to professional searchers such as examiners and patent professionals, it was necessary to distinguish professional searchers from users of the system who did not have access to search engines. Instead, users generally searched free databases on the Internet where only a PDF document was usually available with the front page providing the abstract. In this sense, the useful information from the abstract would be the first impression a user would have of a patent application, so the abstract was still an important part of the document.

275. The Secretariat, in response to the question raised by the Delegation of the United States of America about the format of the text in the front page figure, confirmed that the text in figures accompanying the abstract was currently made available only in image format and not in searchable form, both in the original language and any translation.

276. The Working Group agreed that the International Bureau should issue a Circular inviting more detailed feedback on the issues set out in paragraph 23 of document PCT/WG/9/16, especially from designated Offices and representatives of applicants and patent information users, to help inform discussions to take place at the next session of the Meeting of International Authorities.

POSSIBLE IMPROVEMENTS TO THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

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

278. The Secretariat explained that the document followed up the request made at the eighth session of the Working Group for the International Bureau to present a document to discuss possible improvements to the supplementary international search system. The document proposed amendments to the Regulations in two ways: first, to extend the deadline for requesting a supplementary international search from 19 to 22 months from the priority date, and second, to provide the option for the Authority specified for supplementary search to issue a written opinion with all its supplementary international search reports. The first of these proposals would allow an extra 3 to 4 per cent of applicants to have the benefit of receiving an international search report before reaching the deadline for requesting supplementary international search, leaving only 2 to 3 per cent of applicants without the international search report before the new deadline for requesting supplementary international search. This proposal had received general support at the twenty-third session of the Meeting of International Authorities in January 2016. The second of these proposals, to allow the option for an Authority to establish a written opinion with a supplementary international search report, had its benefits and disadvantages. It would add a further layer of complexity to a rarely-used system with less than 100 requests per year. On the other hand, it would allow a positive written opinion from a supplementary international search to form the basis of a request in PCT Patent Prosecution Highway in cases where the supplementary international search had covered the full PCT minimum documentation. To facilitate consideration of the second proposal, the Annex included how it could be implemented in the Regulations. The proposed changes would require an Authority to decide whether it wished to use the option, and if it did, it would be required to issue a written opinion with all supplementary international search reports, for example, by specifying this in the operational agreement between the Authority and the International Bureau. Therefore, the applicant, when specifying an Authority for supplementary international search, would have the certainty of knowing whether the Authority would establish a written opinion. The provisions also included how the written opinion would be treated in the remainder of the international phase, whether or not a demand had been filed for international preliminary examination. Finally, another idea discussed at the Meeting of International Authorities in January was the possibility to request a supplementary international search on amended claims. However, in view of the practical difficulties referred to in the document and the concerns expressed at the Meeting of International Authorities, this idea had not been proposed in the document.

279. The Delegation of the European Patent Office stated that of the options explored at the Meeting of International Authorities, the two proposals in the document were those that appeared might be acceptable to the majority of International Authorities. Both proposals would bring an additional service and flexibility for users of the supplementary international search system. Extending the deadline for requesting supplementary international search to 22 months from the priority date would align the deadline with that for filing a demand for international preliminary examination, which would appear more of a simplification rather than a complication to the PCT System, as well as providing applicants three extra months to decide on whether request a supplementary search. While the time for performing the supplementary search would be reduced from nine to six months, this would not create problems at the European Patent Office, as examiners currently started the supplementary international search after 22 months from the priority date. In relation to the second proposal to allow the option of issuing a written opinion, the Delegation questioned the view expressed in the document that

this would add a degree of complexity to the supplementary international search system, and believed it appropriate to provide this option. The Delegation referred to the current options available in Rule 45*bis*.7(e) to allow for an Authority to provide explanations with regard to the citations of the documents considered to be relevant. When the European Patent Office provided these explanations, the work was performed in the same way as preparing a written opinion, with the product having identical content to the written opinion. However, the explanations unfortunately did not have the status as a written opinion. It was therefore a pity that an applicant was consequently not able to use the explanations in the same way as a written opinion to facilitate use and treatment of an application in the national phase by designated Offices. In conclusion, the Delegation supported both proposals, which provided improvements for users of the supplementary international search system, particularly as the system was currently little used and the proposals could increase uptake of supplementary international search in the future.

280. The Delegation of the United States of America stated that it had no objection to the proposal to modify Rule 45*bis* to extend the deadline for filing a request for supplementary international search. However, following further consideration since the Meeting of International Authorities, the Delegation had some concerns with the proposal to amend this Rule to provide for a written opinion in the supplementary international search procedure. While the written opinion had been made optional to the Authority offering supplementary international search, thereby allaying specific concerns that had been raised during the Meeting of International Authorities, the Delegation shared the concerns raised in paragraph 15 of the document concerning the usability of a written opinion for Patent Prosecution Highway (PPH) purposes where the full PCT minimum documentation had not been searched. In these cases, it would not be proper to issue a positive written opinion given the limited scope of the prior art search. Therefore, the Delegation was of the view that the proposed amendments related to providing for a written opinion with a supplementary international search report should not be adopted at this time. If the purpose of the proposal was to provide information to the applicant and designated Offices as to how the art was being applied by the Authority performing the supplementary search, then the existing option to include explanations with regard to the citations in the supplementary international search report was sufficient to address this goal. But if the purpose was to provide for a vehicle to leverage entry into the PPH system, then further consideration of the ramifications and the way it could be implemented were necessary before adopting any rule changes.

281. The Delegation of Canada agreed with all the comments made by the Delegation of the United States of America. The most important consideration to bear in mind regarding modifications to the supplementary international search system should be to respond to the needs of applicants, as iterated in six of the 39 responses to Circular C. PCT 1429 that indicated that supplementary international search was unattractive to applicants due to the high fees and complexity of the service. However, none of the proposed changes addressed fees charged by Authorities for supplementary international search and arguably the complexity of the service might only increase if the proposed changes were implemented. In 2015, approximately 97 per cent of supplementary international searches appeared to have been conducted on the full PCT minimum documentation. It was therefore difficult to see how the system was being used as intended, namely, to supplement the search by the International Searching Authority. The Delegation suggested that the best way forward when considering reforms to the supplementary international search system should therefore be to find ways to reduce user costs and increase the number of Authorities offering the supplementary searches other than across the entire PCT minimum documentation, such as specific languages or databases or collections of subject matter. The Delegation agreed with the assessment in paragraph 15 of the document that formal introduction of a written opinion could further contribute to a move away from a truly supplementary search to become, in essence, a full second international search. Regarding the proposal to extend the deadline to request a supplementary international search, the Delegation supported the amendment to 22 months from the priority date as balancing the need for the international search report and written

opinion to be available to the applicant before expiry of the deadline to request supplementary international search, and the providing adequate time to Authorities to perform the supplementary search.

282. The Delegation of the Russian Federation supported the proposal to change the deadline from 19 to 22 months from the priority date, which had clear advantages, as stated in the document. The Delegation was more hesitant about the proposal to include a written opinion with the supplementary international search report. The Federal Service for Intellectual Property, Patents and Trademarks (Rospatent) offered a supplementary international search across the PCT minimum documentation in cases where the “main” international search had not been possible due to the application relating to a method of treatment by surgery or therapy, as well as diagnostic methods, and in these cases, it prepared a written opinion. But in other cases, Rospatent performed a more limited search and the Delegation agreed that a written opinion in these situations was not advisable, despite the flexibility in the proposal to make the written opinion optional. It was therefore better not to provide for the possibility of a written opinion, which may attract little interest from Authorities offering supplementary international search.

283. The Delegation of Israel supported the proposal to postpone the deadline for requesting supplementary international search to 22 months from the priority date and agreed with the comments made by the Delegation of the United States of America with regard to providing for a written opinion with the supplementary international search report.

284. The Delegation of Brazil supported the extension of the deadline for requesting supplementary international search to 22 months, as this would be useful to offer the option of requesting the supplementary search to an extra 3 to 4 per cent of users with the benefit of having received the “main” international search report and written opinion. With regard to providing a written opinion with the supplementary international search report, the Delegation echoed the concerns expressed by preceding delegations. Furthermore, a written opinion could pose a problem to International Authorities interested in offering supplementary international search. It was also important to keep in mind the original goal of supplementary search to expand the search to documents beyond the PCT minimum documentation, in contrast to a full second international search which could lead to conflicting reports between the “main” International Searching Authority and the Authority specified for supplementary search. The Delegation therefore was not able to support the proposal to provide a written opinion at this stage.

285. The Delegation of the Republic of Korea stated that moving the deadline for requesting supplementary international search to correspond to the deadline for filing a demand for international preliminary examination might lead to “intermingling” between supplementary international search and international preliminary examination, particularly if further modifications were made to supplementary international search at a later date, such as allowing a supplementary search on the basis of amended claims. There were also no provisions in the Regulations or International Search and Preliminary Examination Guidelines stating that supplementary international search should be performed focusing on prior art in particular languages. The Delegation therefore considered that it was necessary to discuss the relationship between supplementary international search and international preliminary examination prior to extending the deadline for requesting supplementary international search.

286. The Delegation of the United Kingdom agreed with the proposal to extend the deadline for requesting supplementary international search to 22 months, and shared the concerns expressed by the Delegation of the United States of America regarding the introduction of a written opinion with supplementary international search. However, the Delegation believed that the improvements discussed in the document would do little to increase the uptake of the supplementary international search service among applicants in the United Kingdom, where users made very little use of this possibility and had indicated that it would be a more attractive

option if the service were offered by more International Authorities, including the IP5 Offices. The Delegation therefore expressed interest in knowing if further International Authorities intended to offer the service in future.

287. The Delegation of China supported the proposals to improve the supplementary international search system. The State Intellectual Property Office of the People's Republic of China (SIPO) had been following the developments of supplementary international search and appreciated the efforts made by the International Bureau and International Authorities which offered the service. If necessary, SIPO was willing to collect views and suggestions from applicants and continue to promote the service to users in China.

288. The Secretariat, in response to the comments made the Delegation of the Republic of Korea about the information about the languages of prior art searching in supplementary international search, confirmed that it would be happy to review the information made available by the International Bureau on the different options available to applicants when requesting a supplementary international search, including information contained in the PCT International Search and Preliminary Examination Guidelines.

289. The Working Group approved the proposed amendments to Rule 45*bis*.1 of the Regulations, as set out in the Annex to document PCT/WG/9/6, with a view to their submission to the Assembly for consideration at its next session in October 2016, subject to possible further drafting changes to be made by the Secretariat. There was no agreement on the introduction of proposed new Rule 45*bis*.7*bis* or the proposed amendments to Rules 45*bis*.8, 45*bis*.9 and 90*bis*.3*bis* set out in the Annex to document PCT/WG/9/6.

CORRECTION OF THE INTERNATIONAL APPLICATION IN CASE OF “ERRONEOUSLY” FILED ELEMENTS AND PARTS

290. Discussions were based on document PCT/WG/9/13.

291. The Secretariat recalled that the interpretation of the PCT provisions dealing with incorporation by reference of missing parts of an application had been discussed in previous sessions of the Working Group, but there had been no agreement concerning the incorporation of an entire element of the international application by reference where such element was already contained in the application as filed. For example, if the applicant filed an international application with the wrong set of claims, but the priority application contained the correct set of claims, there were different practices on whether the correct claims could be incorporated by reference as a missing part. Some Offices had argued that the element was not missing at the original filing so the correct claims could not be incorporated, while other Offices have allowed the incorporation, resulting in two sets of claims. At last year's session of the Working Group, the Secretariat had been requested to prepare a working document containing a draft provision to allow the applicant, in very limited and exceptional cases, to replace the wrongly filed claims and/or description of the application as filed with the equivalent correct version of the claims and/or description as contained in the priority document. This provision was set out in the Annex to the document. First, it was proposed to amend Rule 20.5(a) to clarify that the existing missing parts provisions were intended to apply only to cases where part of the description, claims and/or drawings were truly missing from the application as filed, but not in the case where the entire element or part of the application had been erroneously filed. Second, a new Rule 20.5*bis* was proposed, under which the applicant could request the removal of an erroneously-filed element or part from the application and confirm the incorporation by reference of the equivalent correct element or part as contained in the earlier priority application. Before looking at the drafting language, the Secretariat suggested that the Working Group first consider whether there was indeed consensus on this new approach to address the issue, taking into account factors such as the service provided to applicants, the processing required by Offices, expectations by third parties, but also, in particular, the relationship of such a new correction mechanism to other existing remedies already available, notably the correction of obvious errors

under Rule 91, where similar issues were involved but the requirements allowing such correction were different from those in the draft proposal. Moreover, it was important for Member States to consider whether it would be likely that such a new approach would be acceptable and recognized under applicable national laws if there were agreement to amend the PCT along the lines proposed in the document. If many Contracting States filed reservations due to incompatibility with national law, then little would be gained by adopting the draft proposals. Another issue was the relationship between the proposed approach and the Patent Law Treaty (PLT), which did not apply directly to an international application, but would be relevant after the application had entered the national phase in Contracting States that were Contracting Parties to the PLT. For these States, one issue was whether the approach would be in line with PLT Article 2.1, which allowed a Contracting Party to provide for requirements which from the viewpoint of applicants are more favorable than the requirements referred to in the PCT, but not those related to the filing date. Another question relating to the PLT was whether the provision related to form and contents of the application, in which case it would become binding on all PLT Contracting Parties, because under Article 6, provided the PLT Assembly so decided under Article 16, such a provision may become binding on PLT Contracting Parties if it was indeed considered to relate to form and contents of the application. While these issues would need to be decided by Contracting Parties of the PLT, these were important questions for PCT Contracting States that were also party to the PLT.

292. The Delegation of the European Patent Office (EPO) supported the proposal to amend Rule 20.5 to clarify that Rule only applied to truly missing parts. However, while the European Patent Office understood the logic behind the proposed Rule 20.5*bis*, namely, ensuring that applicants who intended something else to be submitted as the specification to replace the specification as filed, it had serious concerns with the compatibility of the provision with the Patent Law Treaty (PLT). PLT Article 2(1) provided that a PLT Contracting Party shall be free to provide for requirements which, from the viewpoint of the applicant and owners, are more favorable than the requirements referred to in the PLT and the Regulations, other than the filing date requirements under PLT Article 5. PLT Article 5, specifying the filing date requirements, and notably PLT Article 5(6), dealing with incorporation by reference of missing parts, were thus binding on PLT Contracting Parties. In other words, PLT Contracting Parties were not free to create additional and more far-reaching possibilities to amend the scope of disclosure without changing the filing date. The European Patent Convention (EPC) had been drafted accordingly, with EPC Rule 56 largely corresponding to PLT Article 5(6). Jurisprudence by the EPO's Board of Appeal in case J 27/10 had confirmed that EPC Rule 56 did not allow for an interpretation that a part or all of the description as originally filed could be amended, replaced or deleted. Moreover, one of the objectives of the PCT Reform process between 2001 and 2007 was to align the PCT as much as possible to the PLT, as was done by introducing the provisions on incorporation by reference of missing parts and the restoration of priority rights. The Delegation therefore believed that the matter needed to be carefully assessed, perhaps on the basis of consultations, for example, by way of a questionnaire, with PLT Contracting Parties, so as to avoid widening the gap between the practice to be applied in the international phase and the practice in the national phase among the various Offices. Even if that assessment concluded that there was no contradiction with the PLT, proposed new Rule 20.5(b) required further amendment so as to provide that any erroneously filed element or part removed from the application be kept on file and be made available for public file inspection.

293. The Delegation of the Philippines stated that the Intellectual Property Office of the Philippines agreed with the proposed amendments to the Regulations in the document to allow for the correction of erroneously filed elements, since the intention was the same as that of the incorporation by reference of missing parts. Both procedures corrected the international application based on the elements already contained in the priority application, correcting erroneously-filed elements and parts by removing and/or replacing them, with the result being the same as the priority application. The procedure of incorporation by reference of entire elements followed the current practice at the Intellectual Property Office of the Philippines.

294. The Delegation of the United States of America stated that it continued to hold the strong view that, where the international application contained an erroneously filed set of claims and/or an erroneously filed description but the applicant nevertheless requested the incorporation by reference of all of the claims and/or all of the description contained in the priority application as a "missing part", such incorporation by reference was clearly covered not only by the spirit and intent but also by the wording of the current Regulations. This was an applicant-friendly provision, allowing for the correction of errors that could have devastating consequences otherwise. As such, the Delegation supported the aim of the proposal. However, in the view of the Delegation, there was no need to amend the Regulations since the current provisions already provided for the incorporation of a correct element or part as a "missing" element or part, as was clear from the discussion at the first session of the Working Group when the provisions were being drafted and approved (see paragraphs 126 and 127 of the report of the session, document PCT/WG/1/16). While the Delegation did not consider there was a need to amend the Regulations, it supported the proposals if this would achieve the aim of allowing more applicants to incorporate from the priority document a correct element as a "missing" element or part. Furthermore, the Delegation was of the view that, pursuant to PLT Article 3(1)(b), the application of the PLT to international applications was subject to the provisions of the PCT, and the provisions of the PCT should prevail. PLT Article 3(1)(b) explicitly stated that "subject to the provisions of the Patent Cooperation Treaty, the provisions of this Treaty and Regulations shall apply to international applications, for patents for invention and for patents of addition, under the Patent Cooperation Treaty: (i) in respect of the time limits applicable under Articles 22 and 39(1) of the Patent Cooperation Treaty ...; (ii) in respect of any procedure commenced on or after the date on which processing or examination of the international application may start under Article 23 or 40 of that Treaty". In the view of the Delegation, the PLT did not control the matter under discussion. The Delegation concluded by hoping that an agreement could be reached on the issues so that applicants could finally be provided with the necessary remedy for correction of this type of error.

295. The Delegation of Japan supported the proposal in the document, which would streamline different operations for the benefit of users. Under the current practice, erroneously-filed elements remained a part of the application, and it was therefore useful to be able to exclude these elements from the scope of examination. With regard to the option for the International Searching Authority to charge additional fees as discussed in paragraph 15 of the document, the Delegation supported this possibility if the International Searching Authority itself could determine the amount based on the additional workload.

296. The Delegation of China stated that, to a certain extent, it was reasonable to allow applicants to replace an erroneously filed element or part of the international application with the equivalent corrected versions in the earlier application, and the proposal provided a legal basis for this practice. However, in the understanding of the Delegation, under the proposed amendments, it was still not allowed to replace the complete claims and description which otherwise would affect the application and procedure of international search. In the practice at the State Intellectual Property Office of the People's Republic of China (SIPO) in its capacity as a receiving Office, it was not allowed to incorporate a complete set of claims and/or description. The Delegation believed that the proposals could make replacing a wrongly filed set of claims and/or a description straightforward, which could make the provision open to abuse. Therefore, the Delegation proposed that it should be clarified not to allow the replacement of the entire claims and description in the Regulations, even in the situation of erroneous filing. Meanwhile, in view of the divergent practices, it could be acceptable to revise the Receiving Office Guidelines to clarify the situation for the benefit of applicants.

297. The Representative of the Asian Patent Attorneys Association (APAA) supported the spirit and intent of the proposal, which provided the opportunity for applicants to correct filing errors arising from either missing parts or erroneously filed parts.

298. The Delegation of Canada supported the documentation of divergent practices of receiving and designated Offices regarding incorporation by reference of missing parts, which would achieve greater legal certainty for applicants and Offices. Where practices in the international phase differed from national practices, clarity and relief could be brought to applicants on this issue without the need for national laws to align perfectly with the PCT. The Delegation therefore supported the amendments to Rule 20 and the addition of Rule 20.5*bis*. As more applications were being filed electronically, Offices needed to recognize that new types of errors, such as attaching the incorrect file, could occur. This was not provided for in the Regulations, unless the error was noticed before the expiration of the priority period where the applicant could file a new application with the correct elements or parts. Yet, from a policy perspective, the Delegation believed that it made sense to provide a mechanism where applicants could obtain relief in these exceptional circumstances. Moreover, Rule 91 did not allow for rectification when the error was an omission of one or more of the entire elements of the international application. The proposed amendments also appeared to overcome concerns that had been raised in previous sessions of the Working Group.

299. The Representative of Institute of Professional Representatives Before the European Patent Office (EPI) stated that the proposal in the document offered a balanced solution that satisfactorily addressed the issue of erroneously filed documents. While cases with erroneously filed documents were rare, they were important. The Representative hoped that if the proposals were adopted, designated and elected Offices did not challenge the replacement of the erroneously filed documents in the national phase.

300. The Delegation of Australia referred to the possibility of incorporating by reference a whole set of missing drawings under Rule 20.5(a), but a similar provision did not exist for an entire description or set of claims. It therefore appeared that the main policy issue was whether a total replacement of an errantly filed description or set of claims could be replaced by incorporation by reference. In this regard, it could be useful to consider the reasons why the provisions for incorporating drawings were different from those for the description and claims. As a designated or elected Office, IP Australia accepted an incorporation that had been allowed in the international phase, and therefore found it difficult that a particular application would be dealt with differently, depending on the receiving Office. The Delegation concluded by showing willingness to accept consensus from Contracting States in this area, which could provide some certainty and a singular practice which all Offices could rely upon.

301. The Representative of the Japan Patent Attorneys Association (JPAA) supported the proposal. By allowing an International Searching Authority to charge an additional fee if the request to replace an erroneously filed element or part was received after it had already begun to draw up the international search report, this provided a balanced solution between being user-friendly yet also being an effective procedure.

302. The Representative of the International Federation of Intellectual Property Attorneys (FICPI) aligned itself with the views that had been expressed by the Delegation of the United States of America and those of the Asian Patent Attorneys Association (APAA) and the Institute of Professional Representatives Before the European Patent Office (EPI) in support of the proposal to allow applicants to correct erroneously filed elements and parts.

303. The Delegation of Republic of Korea stated that, where an applicant insisted that an element or part had been erroneously filed, it could be difficult for an Office to determine whether this was indeed the case. In some cases, it was already difficult to determine an obvious mistake in a request for rectification of an obvious mistake under Rule 91. The existing Rule 20.5 covered mistakes from the applicant, and the Delegation believed that better information on these provisions could guide the applicant within the current legal framework.

304. The Delegation of the United Kingdom supported the spirit of the proposal, but asked the International Bureau to clarify a few points. First, the Delegation asked for clarification on the

effect of the provisions on Offices that were Contracting Parties to the Patent Law Treaty (PLT). In this regard, the Delegation understood that the International Bureau considered that the proposed provisions would not fall within PLT Article 6.1, and therefore PLT Member States would not be obliged to apply those provisions should they come into force to their national or regional applications. Second, turning to the implications of the proposal for the Intellectual Property Office of the United Kingdom, current practice did not provide for applicants to delete incorrect pages of the application as proposed. If the amendments were to come into force, the Intellectual Property Office of the United Kingdom would therefore need to file a notification of incompatibility as both a receiving Office and designated/elected Office. However, as national law in the United Kingdom allowed applicants to incorporate additional pages into the specification from the priority document where parts of the application were missing, the Delegation could interpret the provisions as including the situation where incorrect parts or elements had been filed by mistake, but the erroneously filed pages would have to remain in the application and could only be deleted at a later stage by the applicant filing an amendment. The Delegation therefore suggested that the removal of the incorrectly-filed pages could be deleted from the proposal to allow for Offices to incorporate the new pages, but with the erroneously filed pages remaining in the application and being published with the international application.

305. The Representative of Asociación de Agentes Españoles Autorizados ante Organizaciones Internacionales de la Propiedad Industrial (AGESORPI) stated that it while it was clear that individual pages were a missing part, it was difficult to determine this question if a few claims were missing. Similarly, an Office needed to perform an analysis to determine whether an error should be corrected, which may in some cases need to be determined by the courts. For this reason, it was important that changes were transparent to third parties, with the application being published exactly as filed, with any changes made at a later stage being clear from the published document.

306. The Representative of the Asian Patent Attorneys Association (APAA) submitted a statement from the American Intellectual Property Law Association (AIPLA), whose representative was unable to attend the session. AIPLA considered that the practice at the European Patent Office was unduly harsh and somewhat illogical – if a part were missing, it could be provided, but in the event of an error, no correction could be made. While the PCT was intended to be a procedural treaty whose provisions simply enabled cross-utilization of filing dates and permitted applicants to defer multiple national filings as commercialization proceeded, the PCT did not exist in a vacuum. There was a fair argument (consistent with portions of the position of the European Patent Office) that notwithstanding the desires of AIPLA and national practice in the United States of America, the Patent Law Treaty (PLT), which was a substantive treaty, might prohibit amendment of erroneously filed parts. PLT Article 2 expressly prohibited modification of PLT Article 5, including Article 5(4). While this issue of erroneously filed parts could be clarified by regulation approved by the Assembly, AIPLA recognized that that might not be a feasible solution if a party seeking to invalidate a patent asserted that regulation could not trump the specifics of the law. Put directly, it might be years, including years of uncertainty, before courts in a certain jurisdiction would have established the legal feasibility of a substitution of a missing part. Although it would not entirely alleviate the problem, one solution could be to encourage national Offices to have technical devices to confirm that a specification, claims and abstract had been submitted, and without them to not permit a filing, and further to have a second level of inquiry whereby the applicant had to confirm that the applicant had submitted the “correct” specification. Secondly, national Offices could be encouraged to adopt in their own law a flexible standard for substitution of erroneous parts. An alternative under the existing regime of law and regulation with respect to PCT and PLT was to use the restoration of priority mechanism. The restoration of priority standard had a high standard “in spite of due care” at the European Patent Office, but at least it offered the relative certainty of comfort in a national or regional phase, rather than what might be an illusory accommodation at the PCT filing stage. Correction by inclusion of applications specifically incorporated by reference in the “initial” filing was freely allowed in the United States of America, but in the understanding of the AIPLA, was not the European Patent Office practice.

PLT Article 5(7) allowed such correction. Proposed Rule 20.6 would allow this and AIPLA advocated its implementation. From the proposal, it was not clear if there had been an opportunity for the International Bureau and the delegations to take into account the effect of the Patent Law Treaty, and AIPLA reluctantly believed that allowing missing parts might contradict the terms of the Patent Law Treaty. AIPLA respectfully recognized that if applicants could substitute erroneous parts, the question emerged of “by when and how many times a correction.” In the interest of maintaining workflow at the International Bureau and International Searching Authorities, introduction of a later edition of an intended application would make it very hard to achieve the Treaty’s objectives of prompt action by an International Searching Authority. AIPLA believed that Rule 20.5(a)(i) and a regulation allowing correction of applications incorporated by reference in the original application or priority applications in the spirit of Rule 20.6 should be implemented. However, AIPLA believed that present implementation of the proposed regulations dealing with erroneous parts in Rules 20.5(a)(ii) and 20.5*bis* was probably premature. For now, AIPLA believed there should be a sense to provide a) technical solutions to minimize error, b) encouragement of nation States to have a flexible standard for substitution of erroneous parts, and c) that the restoration of priority provisions were the proper vehicle to deal with erroneously filed parts.

307. The Secretariat, in response to the comments by the Delegation of Australia, stated that the issue of incorporation by reference of missing description or claims elements was provided for in Rule 20.3. Drawings were different from the description and claims since it was not necessary to file drawings to be accorded a filing date. With regard to the Patent Law Treaty (PLT), the authority to interpret the provisions lay with PLT Contracting Parties. Bearing this in mind, in the opinion of the International Bureau, the filing date requirements were dealt with in PLT Article 5(6), and Article 2(1) did not allow Contracting Parties to provide for more favorable provisions from the viewpoint of applicants and owners than those in Article 5. However, the proposal included two elements. The first element related to the provisions which allowed the applicant to incorporate by reference something which had been missing at the outset, although it was referred to as being erroneously filed, since the intention was to file a different element from what had been filed. If a set of claims had been filed but the intention was to file a different set, several Member States interpreted the intended set of claims to be missing. These Member States therefore allowed the incorporation of erroneously filed parts, with those States that were Contracting Parties of the PLT interpreting the PLT provisions to allow such incorporation of erroneously filed parts. The second element would be to allow the applicant to remove the erroneously filed part and replace it with the correct part. This was not covered by the PLT, which allowed a missing part to be added, but did not deal with removing any part of the application, which under most national laws could only be done by amendment. But amendment of the description was not possible under Chapter I of the PCT, so what was provided for would allow the applicant to “correct” the application, but this was not a PLT issue. The Delegation of the European Patent Office had suggested sending a questionnaire to PLT Contracting Parties dealing with the relevant provisions of this Treaty, but the Secretariat considered this could result in differing interpretations, and the question of interpretation would be a matter for the PLT membership as a whole. And while the Secretariat agreed with the Delegation of the United States of America that the PCT was not bound by the PLT, the provisions in the PCT had a direct effect on PLT Contracting Parties, which put them in a difficult position when there were inconsistencies between the PCT and PLT. While there was no agreement on missing parts, applicants faced different decisions being made between the international and national phases of the PCT, depending on the Office handling the case. It was therefore not clear how best to proceed on how to incorporate a missing part where there was an erroneously-filed part at the filing date.

308. The Delegation of the United States of America suggested that the International Bureau could look further into the requirements of the Patent Law Treaty.

309. The Working Group requested the Secretariat to carry out an assessment of the PLT related issues, for consideration by the Working Group at its next session.

SAME DAY PRIORITY CLAIMS

310. Discussions were based on document PCT/WG/9/3.

311. The Secretariat introduced the document by explaining that, in the context of discussions on incorporation by reference of missing parts, the question had arisen whether a priority claim based on an earlier application with the same filing date as the international application was a valid claim under the Paris Convention and thus under the PCT. This question had arisen in the context of applicants filing an international application claiming priority from a national application filed on the same day in order to have the possibility to incorporate by reference a part of the national application if it were missing from the international application. At the eighth session, the Working Group had discussed four possible options in document PCT/WG/8/5 to deal with the different interpretations of the Paris Convention by Offices of PCT Member States without reaching a consensus. The Working Group had asked the Secretariat to prepare a proposed amendment to the Regulations to expressly require receiving Offices not to cancel same day priority claims so as to prepare the ground for decisions on the matter to be taken by designated Offices in the national phase. The Annex to the document set out this proposal. Under the proposal, a same day priority claim would not be cancelled by a receiving Office and would remain in the application to serve as a possible basis for incorporation by reference. Each Office would then be able to decide on whether or not to recognize such same day priority claims based on its interpretation of the Paris Convention under national law. The Secretariat also clarified that, where paragraph 11(a) of the document referred to 200 international applications being filed in 2013 with same day priority claims, this figure included only applications where there were no other priority claims. If international applications with both same day and other priority claims were counted, this figure would be more than 1,600 applications, amounting to close to 1 per cent of all international applications. While this figure was more significant, it was important to bear in mind the consequences for designated Offices that did not accept same day priority claims. Under the proposal, the international search report would take a same day priority claim into account and any incorporation by reference, but the report would lose value for these designated Offices. The Secretariat concluded by underlining that it was important for the PCT membership to be in agreement if the proposal were accepted, as there would little value should many designated Offices submit a declaration of incompatibility with national law.

312. The Delegation of the United States of America reminded the Working Group that the United States Patent and Trademark Office, in its capacity as a receiving Office, had not objected to same day priority claims in the international phase since 2007 when the requirement that a priority claim be declared void if the international application was not filed within a one year of the priority claim was removed from the Regulations. The Delegation supported the proposal to provide that same day priority claims should not be declared void, especially as the United States Patent and Trademark Office accepted such priority claims both as a designated Office and in direct filings. The Delegation viewed this change as being substantially the same as the practice of not objecting to a priority claim between 12 and 14 months from the priority date, leaving those claims to be considered in the national phase in accordance with the national laws of the designated Office concerning reinstatement of priority.

313. The Delegation of the European Patent Office reiterated the position that the European Patent Office (EPO) followed a literal interpretation of Article 4(C)(2) of the Paris Convention, according to which the day of filing was not included in the priority period. Same day priority claims were therefore not allowed. According to Article 8(1), the priority claim had to contain a declaration claiming priority of one or more earlier applications, and the minimum time period was one day. Thus under the PCT, an earlier application had to be filed at least one day before the international application claiming priority from the earlier application. Likewise, Rule 2.4 defined the priority period as meaning the period of 12 months from the filing date whose priority was being claimed, not including the day of filing in the period. Article 87(1) of the European Patent Convention also defined the priority period as being 12 months from the date of filing of the first application, and therefore same day priority claims and missing elements incorporated

by reference on that basis were not considered as valid by the EPO acting in its capacity as a designated Office. Moreover, the proposed amendment would increase the number of cases at the EPO where either the international filing date had to be changed or the element that the applicant intended to incorporate by reference being ignored. These changes also reduced the value of the international search reports and with possible serious consequences for applicants. This conclusion was supported in paragraph 11(b) of the document, which acknowledged that the practical result of such a rule change would be to make the national phase procedure for applications claiming same day priority and requesting the incorporation by reference based on such a priority claim more complex for most designated Offices. At present, it appeared that the majority of designated Offices did not allow for such same day priority claims, and thus for incorporation by reference based on such priority claims. Furthermore, if the priority claim were declared invalid at the later stage, then obviously an incorporation based on the priority claim would also be invalid, since invalidity would be declared for all kind of purposes. Therefore, the Delegation recommended that the *status quo* should be maintained by further clarification of the various practices in the Receiving Office Guidelines, where the European Patent Office would be willing to contribute to the revision.

314. The Delegation of Israel stated that the Israel Patent Office had never encountered the situation where one application had claimed priority from an application filed earlier on the same day. However, the Delegation supported the proposed amendments set out in the Annex to the document to provide that same day priority claims should not be considered to be defects for the purposes of PCT international phase procedures, leaving each designated Office to decide under the national law applied by the Office whether to allow the same day priority claim.

315. The Delegation of the Philippines stated that it was amenable to the proposed amendment so that a priority date which was the same as the international filing date would not be a defect in the international phase, and that the designated Office would have to decide whether to allow the same day priority claim. This would enable a priority application with the same filing date as the international application to be used as the basis for incorporation by reference of missing parts or elements, which was in line with practice at the Intellectual Property Office of the Philippines.

316. The Delegation of China stated that the proposal would not eliminate legal uncertainty, which could have damaging consequences to the applicant. When the priority application was filed on the same date as the international application, it would be difficult to judge which of the two applications was filed earlier than the other. This could result in situations where the contents of a later filed application could be incorporated by reference into the earlier filed application, which was not in conformity with the purpose of priority rights in the Paris Convention or the system for incorporation by reference. As the document pointed out in paragraph 11, most designated Offices did not allow same day priority claims, and the proposed amendment would add complexity to procedures and affect the use of international search reports by these Offices. In view of these difficulties, the Delegation suggested that the Paris Union Assembly should be invited to give guidance on the matter with a view to aligning the differing practices of Paris Convention Member States, in the interest of applicants.

317. There was no agreement on the proposed amendments to the PCT Regulations set out in the Annex to document PCT/WG/9/3 or on further work related to this issue.

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

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

319. The Secretariat explained that the document proposed to amend Rule 23*bis*.2, which had been adopted by the Assembly in 2015, to enter into force on July 1, 2017. This Rule related to the transmission by the receiving Office of earlier search and classification results to the International Searching Authority. Following the adoption, it was brought to the attention of the

International Bureau that there might be a conflict between Rule 23*bis*.2(a) and Article 30(2)(a), as applicable by virtue of Article 30(3), and Rule 94.1*bis*, which was explained in paragraphs 5 to 7 of the document. The proposed amendments in the Annex to the document intended to address this apparent conflict in cases where Article 30(2)(a) would prevent a receiving Office from transmitting information. It was proposed that these amendments should enter into force on July 1, 2017, to ensure that a “corrected” version of Rule 23*bis* would apply from this date and it would be clear when a receiving Office would be obliged to transmit search and classification results to the International Searching Authority.

320. The Delegation of Israel supported the general idea of work sharing and collaboration between Offices, but national legislation in Israel did not provide the possibility to send search and classification information on unpublished patent applications to the International Searching Authority without the consent of the applicant; under Article 168 of Israeli patent law, all documents relating to a patent application were confidential until publication. Therefore, Israel had already notified the International Bureau of the incompatibility of Rule 23*bis* with its national law.

321. The Delegation of the United States of America supported the amendments in the document. With regard to implementation from July 1, 2017, the United States of America had filed a notice of incompatibility with its national law. However, the Delegation suggested that a mechanism could be provided in the PCT Request Form to enable applicants to authorize the transmission of search and classification information.

322. The Delegation of Japan supported the proposal in the document to ensure consistency between Rule 23*bis*.2 with Article 30.

323. The Delegation of Canada supported the proposed amendments in the document to resolve the apparent conflict between Rule 23*bis* and Article 30(2)(a), as applicable by virtue of Article 30(3) and Rule 94.1*bis*.

324. The Delegation of the European Patent Office supported the proposed amendments. As the PCT was a work sharing treaty and Rule 23*bis* aimed to facilitate cooperation between the receiving Offices and International Searching Authorities, the Delegation encouraged all Offices which had notified the International Bureau of incompatibilities of the provisions with their respective national law to study possibilities to align their laws to be able to withdraw these notices in the near future.

325. The Secretariat, in response to the suggestion from the Delegation of the United States of America, agreed to look into the possibility of a check box on the PCT Request Form and consider the wording, such as whether the authorization from the applicant should be “opt-in” or “opt-out”.

326. The Working Group approved the proposed amendments to Rule 23*bis*.2 as set out in the Annex to document PCT/WG/9/5 with a view to their submission to the Assembly for consideration at its next session in October 2016.

DELETION OF “INCOMPATIBILITY PROVISIONS” IN THE PCT REGULATIONS

327. Discussions were based on document PCT/WG/9/12.

328. The Secretariat introduced the document, which proposed to delete two “incompatibility provisions” from the Regulations, namely Rules 4.10(d) and 51*bis*.1(f). The final notifications of incompatibility under those Rules had been withdrawn in December 2007 and November 2013, respectively. As these provisions were no longer applicable, it was therefore proposed that they should be deleted.

329. The Working Group approved the proposed amendments to Rules 4.10 and 51**bis**.1 of the Regulations, as set out in the Annex to document PCT/WG/9/12 with a view to their submission to the Assembly for consideration at its next session in October 2016.

OTHER MATTERS

330. The Working Group agreed to recommend to the Assembly that, subject to the availability of sufficient funds, one session of the Working Group should be convened between the October 2016 and September/October 2017 sessions of the Assembly, and that the same financial assistance that was made available to enable attendance of certain delegations at this session should be made available at the next session.

331. The International Bureau indicated that the tenth session of the Working Group was tentatively scheduled to be held in Geneva in May/June 2017.

SUMMARY BY THE CHAIR

332. The Working Group noted the contents of the Summary by the Chair in document PCT/WG/9/27 and that the official record would be contained in the report of the session.

CLOSING OF THE SESSION

333. Mr. John Sandage, Deputy Director General of WIPO, on behalf of the Secretariat, thanked the delegations for conducting themselves in a workmanlike manner, showing perseverance on many complex topics, and providing guidance on the different items of work to be taken forward.

334. The Chair closed the session on May 20, 2016.

335. The Working Group adopted this report by correspondence.

[Annex follows]

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