

Patent Cooperation Treaty (PCT) Working Group

Ninth Session
Geneva, May 17 to 20, 2016

SUMMARY BY THE CHAIR

AGENDA ITEM 1: OPENING OF THE SESSION

1. Mr. Francis Gurry, Director General of WIPO, opened the session and welcomed the participants. Mr. Claus Matthes (WIPO) acted as Secretary to the Working Group.

AGENDA ITEM 2: ELECTION OF A CHAIR AND TWO VICE CHAIRS

2. The Working Group unanimously elected 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.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

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

AGENDA ITEM 4: PCT STATISTICS

4. 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.

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/pmhindex.htm?tab=pct>.

**AGENDA ITEM 5: MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT:
REPORT ON THE TWENTY-THIRD SESSION**

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

6. One delegation 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.

7. 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.

AGENDA ITEM 6: PCT ONLINE SERVICES

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

9. All delegations which took the floor expressed their appreciation for the work done on improving the online services made available by the International Bureau. Offices were using ePCT, WIPO CASE, IPAS and DAS in various combinations, depending on their particular requirements, in addition to the PCT-EDI batch services and national IT systems. Several delegations stated that their Offices intended to join WIPO CASE or DAS in the near future. There was interest in web services as a complement to the existing browser and batch services. An increasing number of Offices were using eSearchCopy. As a result of these factors, it was important to ensure that there was full compatibility between different systems and that ePCT properly recognized and validated the particular different requirements of national Offices.

10. Offices broadly supported the direction for future work proposed by the International Bureau. Several Offices emphasized the importance of increased use of XML, especially for international search reports and written opinions, as well as translations of reports and opinions. Other priorities expressed included additional management reports, "push" of management reports, facilities to pay fees at the time of filing to receiving Offices other than the International Bureau, improved PDF editing and improvements to the formats of priority documents and demands.

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

**AGENDA ITEM 7: STATUS REPORT ON ESEARCHCOPY PILOT AT THE EUROPEAN
PATENT OFFICE**

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

13. The Delegation of the European Patent Office introduced the report, noting 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 pilot was conducted with a suitable range of Offices to verify the requirements and test the benefits across all types of receiving Offices. 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.

14. Two delegations noted the benefits of eSearchCopy and stated that they looked forward to its wider use.

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

AGENDA ITEM 8: EFFECTIVE WORK SHARING BEYOND INTERNATIONAL REPORTS: UTILIZATION OF WIPO CASE

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

17. All delegations which took the floor and which represented Member States whose Offices already had joined WIPO CASE as accessing and/or providing Offices expressed their strong support for WIPO CASE and noted its potential as the global platform to provide access to search and examination information regarding national and international applications and thus facilitate work sharing between Offices. These delegations strongly encouraged other Member States to join the system and encouraged the International Bureau to promote further participation in the system. Several delegations representing Member States whose Offices had not yet joined WIPO CASE, or whose Offices had not joined WIPO CASE as both an accessing and providing Office, stated their intention to do so in the near future. Several representatives of user groups also stated their full support for the WIPO CASE system and expressed the hope that more Offices would join in the near future and that availability of documents and information in the WIPO CASE system could replace current obligations on applicants to provide such information to accessing Offices.

18. Several delegations emphasized the benefits of the existing link to the IP5's One Portal Dossier (OPD) system, with one delegation expressing the hope that there would be additional coordination between both systems in the future. Several delegations stated that their Offices had authorized public access to their dossier information via WIPO CASE and urged other Offices to do the same. One delegation, however, noted that this was a matter to be determined by the national law of the Office concerned governing the issue of confidentiality. In response to a question from one delegation, the Secretariat 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. One delegation expressed the hope that it would be possible to add access to non-patent literature cited in search and examination reports in the near future.

19. One 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, this 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.

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

AGENDA ITEM 9: ePCT NATIONAL PHASE ENTRY

21. Discussions were based on document PCT/WG/9/24.
22. 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.
23. While noting that many legal, fee payment and technical issues remained to be addressed, most delegations which took the floor broadly supported the general approach of the “proof of concept” system and expressed their interest in further reviewing the system with a view towards providing feedback on its functionalities. Several user groups noted the potential benefits in certain cases of reducing the need for transcription of bibliographic data, but expressed doubt that the proposed arrangement would be appropriate to the real needs of collaboration between agents on substantive issues of translations or national phase requirements specific to individual designated Offices.
24. 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 timetable for a possible move to a pilot system.

AGENDA ITEM 10: PCT USER SURVEY

25. Discussions were based on document PCT/WG/9/11.
26. All delegations which took the floor welcomed the survey and commended the International Bureau for the high level of user satisfaction, which had increased across all areas from the previous survey conducted in 2009. Delegations thanked the International Bureau for sharing with them the individual feedback from users on the PCT services provided by their individual Offices.
27. One delegation expressed an interest in receiving the feedback in relation to the services provided by the International Searching Authorities and International Preliminary Examining Authorities that were competent for applications filed at its receiving Office.
28. In response to a request from one delegation about providing further details beyond the Executive Summary provided in Annex I to the document, the International Bureau explained that the Executive Summary set out in document PCT/WG/9/11 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 allow it to be presented to Member States.
29. The Working Group noted the results of the PCT Survey 2015 set out in Annex I to document PCT/WG/9/11.

AGENDA ITEM 11: PCT FEE INCOME: PROGRESS REPORT ON ANALYSIS OF POSSIBLE MEASURES TO REDUCE EXPOSURE TO MOVEMENTS IN CURRENCY EXCHANGE RATES

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

31. The Secretariat presented an update on the possible implementation of a hedging strategy for PCT fee income³. 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.

32. 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.

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

AGENDA ITEM 12: 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

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

35. In introducing the document, the Delegation of Brazil stated that, prior to the current session of the Working Group, it had consulted informally with a number of interested delegations, many of which had given general support for the proposal set out in the document. Others had expressed concerns about the financial sustainability and the need for income neutrality. In response to those concerns, the delegation referred to the fact that the proposal would have a budgetary impact of about 2 million Swiss francs in the 2016/17 biennium. This impact was minimal compared to the financial impact of the existing e-filing fee reductions, which mainly benefitted applicants from developed countries and amounted to more than 98 million Swiss francs in the biennium, and the existing fee reductions for applications filed by applicants from certain, mainly developing countries, which amounted to almost 19 million Swiss francs in the biennium. The Delegation mentioned that increases in efficiency, such as proposed under agenda item 13, could compensate for losses in income.

36. The Delegation of Brazil further stated that a further concern which had been raised during the informal discussions had been that North-South cooperation between universities would not benefit from the proposed fee reduction. In that regard, the Delegation expressed the view that, in its understanding, an international application which was the result of such cooperation between a university from a country not benefitting for the fee reduction and a university from a country benefitting from the fee reduction should benefit from the envisaged fee reductions if filed by both universities as co-applicants. The proposal would further benefit global partnerships aimed at addressing public health issues, such as in the case of the fight against the Zika virus, and would support initiatives aimed at fostering collaboration, such as WIPO Re:Search.

37. Several delegations, including one speaking on behalf of a regional Group, expressed support for the proposal, noting that it was aimed at stimulating creativity and technological innovation, and at making the PCT System more accessible to many applicants who otherwise would be prevented, because of high entry costs, from participating in the international patent system. The study on PCT fee elasticity discussed by the Working Group at its eighth session had clearly shown that universities and public research institutions from developing and least developed countries were more price sensitive than those from developed countries, which justified a tiered approach such as the one proposed by Brazil. Several of those delegations

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.

pointed to positive experiences with fee reductions granted to universities and public research institutions under their national patent systems, which had led to considerable increase in filings at the national level.

38. Several other delegations expressed concerns about the proposal. PCT fee reductions had to be balanced, taking into account the impact they had on PCT fee income and thus the budget of the entire Organization. Some delegations stated that any new fee discounts should not result in increased fees for other applicants. While in the past biennium, the Organization had indeed generated a healthy surplus, there was no guarantee of any such surpluses in future biennia, whereas the proposed fee reductions would reduce PCT fee income for years to come. In general, any policy on fee reductions for universities and public research institutions had to achieve real and not only theoretical incentives to stimulate research and innovation and should not only benefit a subset but rather all PCT Member States. Doubts were expressed as to whether the proposed fee reductions would indeed translate into commercial returns and whether PCT fee levels are the main impediment to filing applications, these being a small part of the overall cost of international patent protection; focus should be on the quality of patent applications rather than the number of applications filed. Many aspects of the proposal required further clarification, including the relationship of the proposal to the existing fee reductions for all applicants, including universities and public research institutions, from least developed countries, and the question as to what constituted a university and a public research institution, which could result in difficulties in administering such fee reductions similar to those which were the subject of the discussions by the Working Group under agenda item 13 (document PCT/WG/9/10). Moreover, the estimated number of only 139 additional filings by universities and public research institutions from benefitting countries per year to be stimulated by the proposed fee reduction 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. One delegation stated that it would require solid and convincing arguments in order to consider any further expansion of targeted fee reductions under the PCT. Some delegations stated that these fee discounts should apply to all countries.

39. Several delegations, while recognizing the concerns which had been expressed and the need for further clarification of a number of issues related to the proposal, expressed their general sympathy for the proposal put forward by Brazil and suggested possible ways to address some of the concerns raised, such as granting fee reductions to universities and public research institutions from all Member States but introducing different tiers of reductions.

40. In response to the concerns raised by some delegations, the Delegation of Brazil stated that the overall impact on the budget would be a mere 0.2 per cent of WIPO's total income in the biennium. 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. With regard to the suggestion to grant fee reductions to universities and public research institutions from all Member States, which had attracted support by a number of delegations, the Delegation stated that it was open to discussions and analysis of the effects and balances.

41. In response to queries from several delegations, the Chief Economist 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.

42. 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 41, above.

43. 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.

44. One delegation expressed concerns as to a very low reduction 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. It 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.

45. Another delegation 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.

AGENDA ITEM 13: FEE REDUCTIONS FOR CERTAIN APPLICANTS FROM CERTAIN COUNTRIES, NOTABLY DEVELOPING AND LEAST DEVELOPED COUNTRIES

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

47. Several delegations considered that it was necessary to avoid an excessive response to the issue at hand which damaged the interests of legitimate beneficiaries of the fee reduction. The fact that many fee reductions had been voluntarily repaid demonstrated that there was genuine uncertainty over the intended scope of the reduction. Furthermore, there were many legitimate cases where assignment of an international application from an individual to a legal entity might occur and it was not appropriate to penalize such users. As such, it was necessary to further clarify that the date on which the criteria for eligibility should apply was the international filing date and that changes in status which occurred after that time should not be relevant.

48. Furthermore, several delegations considered that it was not appropriate at this time to charge a special fee in the case of a change of applicant during the international phase to a person or entity not eligible for the reduction. This would impose a barrier to proper, normal use of the system and potentially transfer excessive work related to the change of applicant to designated Offices which could have been centralized during the international phase. Rather, at least for now, cases of possible inappropriate claims for reductions should continue to be dealt with on an *ad hoc* basis and the situation monitored to see whether further action was really necessary in the future.

49. One delegation 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.

50. In response to the suggestion by one delegation 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.

51. In response to a query from one delegation, 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. It was not possible to be certain of the numbers of applications involved, 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 a further query, the Secretariat confirmed that it was not intended that the receiving Office would be expected to make any routine checks on the eligibility of applicants when the reductions were claimed.

52. In response to a query from one delegation, the Secretariat clarified that the proposed amendments would not change the legal basis for the International Bureau to contact applicants who are 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. Instead, the main focus of the proposed amendments to the Schedule of Fees would be to raise awareness that only natural persons who, at the time of filing, were the only beneficial owners of the international application were entitled to the fee reduction.

53. All delegations which took 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.

54. One delegation expressed the view that, as the Working Group had not reached agreement on the proposed amendment of Rule 92*bis*, a decision on the proposed amendments to the Schedule of Fees should be postponed in order to allow for a further revision of the proposals taking into account concrete measures taken by Member States and the International Bureau to address the issues raised in the document. It requested 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.

55. The Working Group invited the Secretariat to provide the additional information set out in paragraph 54, above, for consideration by the Working Group at its next session.

AGENDA ITEM 14: COORDINATION OF TECHNICAL ASSISTANCE UNDER THE PCT

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

57. The Secretariat informed the Working Group of the discussions of the External Review of WIPO Technical Assistance in the Area of Cooperation for Development (document CDIP/8/INF/1) that took place at the seventeenth session of the Committee on Development of Intellectual Property in April 2016, as outlined in the Summary by the Chair to that session.

58. 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 African countries. 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.

59. 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.

60. 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.

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

AGENDA ITEM 15: TRAINING OF EXAMINERS

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

63. Delegations which took the floor broadly supported the proposals aimed at improving transparency in terms of “supply” and “demand” of substantive examiner training and at exploring options for greater coordination of training between Offices, noting that Offices would need to retain some flexibility for national Offices to set up activities according to specific priorities set by the Office and the availability of resources. One delegation emphasized that the reporting to the International Bureau on training activities provided should be limited to those offered to other Offices.

64. Several delegations believed that developing competency models and learning management systems were matters to be left solely to the recipient Office, rather than for the International Bureau to monitor and coordinate. However, a number of other delegations expressed interest in the possible benefits of such systems, and it was emphasized that the proposal at present was to gather further information on options, which would serve as a basis for discussion by the Working Group at its next session, rather than to commit the International Bureau to the development and implementation of systems.

65. Several delegations expressed significant interest in further investigating the possibilities to provide and fund additional activities, such as through Funds-in-Trust. However, some delegations which already funded such activities through Funds-in-Trust emphasized the need to use the funds effectively and improve coordination of examiner training rather than expanding existing Funds-in-Trust or setting up new Funds-in-Trust.

66. Several delegations expressed appreciation for the examiner training and other assistance that their Offices had received from other Offices and from the International Bureau. Examples cited included participation in the Regional Patent Examiner Training (RPET) Program organized by IP Australia, and cooperation activities supported by Funds-in-Trust. Several delegations provided examples of different ways in which their Offices had offered examiner training as donor Offices and expressed willingness to provide further training, depending on the availability of resources.

67. 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.

AGENDA ITEM 16: EXTENSION OF APPOINTMENT OF INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES

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

69. All delegations which took the floor expressed support for the proposed process and timeline for the extension of the appointment of existing International Authorities as set out in the document. One delegation stressed the need for a thorough and transparent process, with the documentation to be submitted by each Authority seeking reappointment to include sufficient details of how the Authority continued to meet the criteria for appointment. Another delegation suggested that the process should not result in unnecessary workload for existing Authorities. 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; Authorities should thus simply be required to refer to their most recent reports.

70. Several delegations expressed a concern with regard to the suggestion by one International Authority made during the Meeting of International Authorities to introduce a peer review process under which the documentation submitted by one Authority was reviewed by one or more other Authorities to verify compliance with the minimum documentation requirements under Rule 36.1(ii).

71. Several delegations stated their support for the introduction of a standard application form for the appointment of new Authorities as well as the reappointment of existing Authorities. It was noted, however, 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.

72. 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.

AGENDA ITEM 17: COLLABORATIVE SEARCH AND EXAMINATION – THIRD PILOT

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

74. The Delegation of the European Patent Office updated the Working Group on the third collaborative search and examination pilot. The third pilot would be applicant-driven and it was expected that at least 100 applications from each participating Office would be treated. 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.

75. Delegations who took the floor supported the collaborative search and examination pilot and highlighted the benefits it could provide in improving the quality of patent search and examination and avoiding duplication of work. One delegation showed interest in taking part in the third pilot and also pointed out the concerns on the fee, language and selection rights of the Authorities in the third pilot. User groups also supported the concept of collaboration by building on the work of other examiners and the proposed pilot, and expressed hope that any future collaborative model could be provided at an affordable price for users.

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

AGENDA ITEM 18: PCT DIRECT AT THE EUROPEAN PATENT OFFICE: STATUS REPORT

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

78. The Delegation of Israel reported on its own positive experience with the service it offered to applicants who used the Israel Patent Office as an International Searching Authority where the international application claimed the priority of an earlier application already searched by the Israel Patent Office, which was very similar to the PCT Direct service offered by the European Patent Office.

79. 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.

80. In response to a question by one delegation, 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.

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

AGENDA ITEM 19: SPECIFYING NATIONAL CLASSIFICATION ON THE FRONT PAGE OF PUBLISHED INTERNATIONAL APPLICATIONS

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

83. Several delegations which took the floor supported the principle of the proposal to include classifications other than the International Patent Classification (IPC) on the front page of published international applications, noting that, while referring to "national classification", it in fact related primarily to the Common Patent Classification (CPC), which was used by many of the Offices which acted as International Searching Authorities as well as many designated Offices. One delegation mentioned that according to the PCT Administrative Instructions, such information could already be provided in the international search report and made available to examiners and the public. Another delegation suggested that the inclusion on the front page of

the published international application of information related to truly national classification systems, which were not used by multiple Offices, would be of limited value and that such information should thus probably appear only in the international search report.

84. It was recognized that, for the proposal to be implemented in practice, various details needed to be resolved. Quality of classification was essential. Several delegations suggested that applying classifications other than the IPC should not be made compulsory or that International Searching Authorities should only apply classifications such as the CPC if they used it as their national classification system and were therefore experienced in its use. The classification terms should also be properly validated. Classifications were only useful if they could be understood by users, so it was important that any classification schemes involved were easily available, preferably in a range of languages but at least in English. 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 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. For an effective implementation, the XML of international search reports should also be updated.

85. 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.

AGENDA ITEM 20: PCT MINIMUM DOCUMENTATION: STATUS REPORT

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

87. 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.

AGENDA ITEM 21: PCT SEQUENCE LISTING STANDARD

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

89. 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.

90. All delegations which took the floor welcomed the formal adoption of ST.26 by the CWS and supported the roadmap proposed by the Task Force leader for making the transition from ST.25 to ST.26. Delegations also acknowledged that sufficient time would be needed to prepare IT systems to implement ST.26. One delegation added that, due to competition for limited resources at its IP Office, it could not make a firm commitment to the timing of the transition at this stage.

91. One delegation stressed the need for a coordinated effort to achieve a smooth transition to ST.26 and that any technical solution implemented should be compatible across IP Offices. 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.

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

AGENDA ITEM 22: REVISION OF WIPO STANDARD ST.14

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

94. The Secretariat informed the Working Group that a revised WIPO Standard ST.14 had been adopted by the reconvened fourth session of the Committee on WIPO Standards (CWS) in March 2015 and referred to paragraphs 11 to 14 of the Summary by the Chair of the session (document CWS/4BIS/15 Rev.) which described the amendments made to the draft ST.14 in the Annex to document CWS/4BIS/3 during the adoption by the CWS. 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.

95. All delegations which took the floor welcomed the adoption of the revised ST.14 by the CWS. One delegation expressed satisfaction with the selection of option (b) in paragraph 9 of document CWS/4BIS/3, the amendments made to paragraph 16 of the draft Standard that had been made by the CWS, and the decision by the CWS not to revise the definition of category "P" as explained in paragraph 11 of document CWS/4BIS/3.

96. In response to a question from one delegation about the implementation of the revised ST.14 in the PCT, the Secretariat 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.

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

AGENDA ITEM 23: COLOR DRAWINGS

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

99. All delegations which took the floor affirmed the importance of working towards effective handling of color drawings, which were important for effective disclosure of inventions in certain cases, especially in the biological and pharmaceutical fields.

100. All delegations which took the floor agreed in principle with the approach to processing set out in paragraphs 7 to 9 of the document, but a number of delegations expressed concern about the scope and timing of the work to be done, as indicated below.

101. Several delegations representing Offices which act as International Searching Authorities indicated that they were not yet able to process documents with color drawings "end to end" or to commit to a specific timetable for doing so. Prioritizing this work might delay other work for some Offices, such as the implementation of eSearchCopy. Some Offices had manual processes which were used to handle color drawings but, in practice, these would not be sufficient if the new arrangements were to attract any significant number of applications with color drawings. One delegation suggested that it might not be practical to implement the system at the same time for all International Searching Authorities.

102. Packages of black and white TIFF images would be required for processing at some designated Offices for some time, but careful consideration would need to be given to the technical implementation and legal status of such conversions.

103. Several delegations considered that it was important that effective arrangements also be found for handling color drawings filed in PDF format or on paper. PDF was currently the dominant filing format and applicants expected it to be supported. The International Bureau observed that the interim solution set out in paragraphs 11 to 15 of the document would go some way towards handling the PDF cases until a full solution could be found. Furthermore, the same approach could, in principle, be applied to international applications filed on paper. The International Bureau could therefore investigate what would be required to add a checkbox to the paper-based Forms to indicate a need to scan drawings in color.

104. A number of delegations raised certain legal issues which should be investigated. These included matters related to the Patent Law Treaty. Specifically, if color drawings could be filed on paper, it was important that this should not risk a loss of filing date or of a date of submission significant to meeting a time limit. In these cases, there should be effective access to the original document for Offices concerned. It would also be necessary to handle priority documents containing color drawings. The relationship of accepting color drawings with Rule 11, which expressly required black and white drawings, also required clarification. The International Bureau observed that the main technical proposal could not be implemented before 2018. This provided time to discuss any necessary amendments to the PCT Regulations at the next session of the Working Group; nevertheless, it was important to identify the full extent of the required technical work as soon as possible.

105. In response to concerns that the proposals risked encouraging applicants to file color drawings to their own detriment in cases where designated Offices still required black and white drawings, the International Bureau observed that such filings existed today. While the proposed work might increase the volumes concerned and it was necessary to mitigate the risks where possible, work on providing a solution for filing of color drawings needed to move forward.

106. A significant number of delegations indicated that their Offices were already fully capable of receiving and processing patent applications in color, both from a technical and legal perspective, and in some cases, in a variety of formats (paper, PDF and different image file formats associated with XML applications).

107. Several delegations stated that it would be useful to conduct a survey of which Offices were able to accept color drawings and to keep that list up to date. This might identify a “tipping point” when a full amendment of Rule 11 could become practicable.

108. In response to a question from a representative of users, the International Bureau stated that it hoped that the system for .DOCX upload and conversion would, in time, encourage a large proportion of applicants to file in XML format. There were legal issues to address, but the most important factor was trust of the system by applicants. The International Bureau would strongly welcome feedback on the conversion process, notably from users.

109. 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.

AGENDA ITEM 24: NUMBER OF WORDS IN ABSTRACTS AND FRONT PAGE DRAWINGS

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

111. Several delegations representing Offices which acted as International Searching Authorities stated that the content and quality of the abstract and the selection of the accompanying figure were ultimately the responsibility of the International Searching Authority and that it was necessary for the Authorities to ensure that they met the appropriate standards and, where possible, to select drawings without too much text.

112. Several delegations confirmed that there were significant difficulties for applicants and Offices in judging whether the length of abstracts established in languages other than English fell within the guideline set out in Rule 8.1(b) and suggested that improved guidance on this subject would be useful. One delegation pointed out that there was no direct evidence to prove the connection between the number of words in abstracts and high quality as well as the different characters of different languages should be considered. Delegations recalled that it was important to remember that “50 to 150 words” was only a guideline and that in some cases shorter or longer abstracts could be appropriate and of high quality. On the other hand, one delegation suggested that a strict limit might be enforced by receiving Offices, requiring the applicant to correct the abstract if falling outside a range established for each language. However another delegation stated that such a restrictive approach would not be desirable.

113. Many delegations noted that methods of searching had changed considerably since Rule 8 had been written. Several delegations indicated that their Offices relied mainly on full text searching using text highlighting functions and machine translations, with limited use of abstracts prepared for search purposes. Nevertheless, other Offices and some patent information users relied heavily on abstracts for searching, noting that search facilities freely available to many users were less sophisticated than tools used by search examiners or other professional searchers. It was therefore important to understand the needs of all users of the abstract and accompanying drawing in order to determine suitable content and quality.

114. One delegation suggested that a more relaxed approach might be appropriate for translation of text in drawings in some cases. For example, at present, applications filed in German sometimes included drawings with text in English, which the receiving Office requested to be replaced with translations into German and the International Bureau might translate one of the figures back into English. Perhaps, in some cases, the English language technical terms in the figures might be appropriate for all languages.

115. In response to a query from one delegation, the International Bureau 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.

116. 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.

AGENDA ITEM 25: POSSIBLE IMPROVEMENTS TO THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

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

118. Several delegations expressed support for extending the deadline for a supplementary international search request from 19 to 22 months from the priority date.

119. One delegation 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. In response to a query by that delegation, the Secretariat 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.

120. Several delegations expressed concerns about providing an option to issue a written opinion with the supplementary international search report, as this would add further complexity to the system. In relation to the use of such a written opinion as the basis of a request under the Patent Prosecution Highway (PPH), delegations highlighted the problems in cases where the supplementary search had not covered the entire PCT minimum documentation but had been limited to certain prior art documents in certain languages only. Delegations further pointed to the existing option for International Searching Authorities to include written explanations of the documents cited in the supplementary international search report under Rule 45*bis*.7(e).

121. One delegation supported providing the option for an Authority to issue a written opinion with all its supplementary international search reports, while noting that the proposal was to make this service optional, at the choice of each Authority offering supplementary international search. Its Office already offered written explanations with a supplementary international search report, which was provided to the same standard as a written opinion accompanying the “main” international search and thus covered the entire PCT minimum documentation. The proposed amendments would therefore provide a legal status to this opinion, for any purpose, such as for example to request PPH effect, which would allow it to be processed in the same way by a designated Office as the written opinion accompanying the “main” international search.

122. While agreeing with the proposal to extend the deadline for requesting supplementary international search, several delegations questioned whether this would increase the uptake of supplementary international search. These delegations suggested other improvements that could be made to make the system more attractive to users, such as more International Authorities offering supplementary international search, providing further options to request a search beyond the PCT minimum documentation covering specific languages, collections or databases, and reducing the costs for users.

123. 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.

AGENDA ITEM 26: CORRECTION OF THE INTERNATIONAL APPLICATION IN CASE OF “ERRONEOUSLY” FILED ELEMENTS AND PARTS

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

125. The Delegation of the European Patent Office (EPO) stated that, while it supported the proposal to amend Rule 20.5 to clarify that Rule only applied to truly missing parts, it had serious concerns as to the compatibility of proposed new Rule 20.5(*bis*) 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. Those Parties were thus 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 had confirmed that EPC Rule 56 did not allow for an interpretation that parts or all of the description as originally filed could be amended, replaced or deleted. The Delegation therefore believed that the matter should 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.

126. Several other delegations supported the proposal in general, noting that, as far as the incorporation by reference of any “correct” element or part contained in the priority application was concerned, it was in line with the generally accepted principle of incorporation by reference of missing elements or parts, without adding new subject matter beyond the scope of the international application as filed, as provided for in both the PCT and the PLT. The proposed new approach would be a reasonable and applicant-friendly way to allow applicants to correct errors made when filing the application, notably when e-filing, where it was easy to attach wrong elements or wrong parts of an application.

127. One delegation, while fully supporting the aim of the proposal, stated that, in its view, there was no need to amend the Regulations since the current provisions clearly provided for the incorporation of a correct element or part as a “missing” element or part, as was clear from the records of the meeting which had drafted the current provisions. The Delegation further 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 that thus the PLT did not control the matter under discussion.

128. Several delegations, while generally supporting the aim of the proposal, expressed concerns about possible abuse of the new provision, which should only apply in limited and exceptional cases. Concerns were also expressed and further clarification sought as to the relationship with the existing procedures allowing for the rectification of obvious mistakes under Rule 91. One 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. One delegation suggested that further clarification should be provided by the Secretariat as to the effect of the proposed new provisions on Offices of PLT Contracting Parties under Article 6(1) of the PLT.

129. Several representatives of users stated that they strongly supported the proposal, noting that it was a user friendly and effective procedure.

130. 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.

AGENDA ITEM 27: SAME DAY PRIORITY CLAIMS

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

132. Several delegations supported the proposal set out in the document, noting that it was of a similar nature to the existing PCT provisions dealing with the restoration of the right of priority, under which receiving Offices were required to not consider any priority claim void only because the international application has an international filing date which is later than the date on which the priority period expired but within two months from that date.

133. Several other delegations stated that recognizing same day priority claims was not in conformity with the Paris Convention, notably, *inter alia*, in view of the wording of Paris Convention Article 4(C)(2) and PCT Rule 2.4, which both provided that the day of filing shall not be included in the priority period. As had been recognized in paragraph 11(b) of the document, the proposed amendment of the Regulations would make the national phase procedure more complicated in most designated Offices for applications including same day priority claims and requesting incorporation by reference of missing elements or parts based on such priority claims, since most designated Offices did not recognize such priority claims. Efforts should thus focus on modifying the Receiving Office Guidelines and the PCT Applicant's Guide to clarify the differing practice applied by receiving Offices and designated Offices. One 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.

134. 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.

AGENDA ITEM 28: TRANSMITTAL BY THE RECEIVING OFFICE OF EARLIER SEARCH AND/OR CLASSIFICATION RESULTS TO THE INTERNATIONAL SEARCHING AUTHORITY

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

136. All delegations which took the floor supported the proposal set out in the document.

137. Several delegations stated that they had submitted notifications of incompatibility under Rule 23*bis*.2(e) to the International Bureau. In response to these statements, one delegation recalled that the aim of new Rule 23*bis* was to facilitate work sharing among Offices and expressed the hope that those notifications of incompatibility could be withdrawn in the near future.

138. 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.

AGENDA ITEM 29: DELETION OF "INCOMPATIBILITY PROVISIONS" IN THE PCT REGULATIONS

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

140. 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.

AGENDA ITEM 30: OTHER MATTERS

141. 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.

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

AGENDA ITEM 31: SUMMARY BY THE CHAIR

143. The Working Group noted that the present document was a summary established under the responsibility of the Chair and that the official record would be contained in the report of the session.

AGENDA ITEM 32: CLOSING OF THE SESSION

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

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