

International Patent Cooperation Union (PCT Union)

Assembly

**Forty-Second (18th Ordinary) Session
Geneva, September 26 to October 5, 2011**

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/49/1): 1 to 6, 9 to 22, 27, 34, 44 and 45.
2. The report on the said items, with the exception of item 34, is contained in the General Report (document A/49/18).
3. The report on item 34 is contained in the present document.
4. Ms. Susanne Ås Sivborg (Sweden) was elected Chair of the Assembly; Mr. LI Yuguang (China) and Mr. Rimvydas Naujokas (Lithuania) were elected Vice-Chairs.

PCT WORKING GROUP: REPORT ON THE FOURTH SESSION

5. Discussions were based on document PCT/A/42/1.
6. In introducing the document, the Secretariat pointed out that, since the publication of document PCT/A/42/1, which contained in its Annex I the draft report of the fourth session of the PCT Working Group, the final version of that report had been adopted by Member States by way of correspondence and had been made available on WIPO's website as document PCT/WG/4/17, containing only minor changes compared to the draft version.

7. The Delegation of Brazil stated that it supported multilateral initiatives aimed at improving international search and preliminary examination reports. Such reports, however, had to serve as a reference only and must not be legally binding. The Delegation further stated that it considered that improvements to be made to the PCT system must not interfere with the national patent examination procedures; Member States had to keep their autonomy to reject, either partially or entirely, the results of international search and preliminary examination reports. The Delegation expressed its appreciation for the cooperative spirit that had prevailed in the most recent session of the PCT Working Group, due to the high level of engagement of all delegations. This positive environment had made it possible to reach consensus among delegations on proposed amendments to the PCT Regulations designed to improve the level of services to users of the PCT system.

8. The Delegation of Iran (Islamic Republic of) observed that it was convinced that there were several possibilities to improve the functionality of the PCT system within its legal framework, to the benefit of applicants, Offices and third parties in all Contracting States without limiting the policy space for IP Offices in determining substantive conditions of patentability. It also believed that any reform of the PCT system should amplify the basic aims of the Treaty in the field of procedures for obtaining legal protection for inventions and in the field of the dissemination of technical information and organization of technical assistance, particularly for developing countries. Moreover, since the PCT was a procedural Treaty, the results of its reform should be confined to procedural matters as well and should not lead to the harmonization of national search and examination procedures. The Delegation further stated that it wished to encourage the International Bureau to increase its activities in the field of capacity building for IP Offices by devoting more resources in this respect. It was imperative for the success of the PCT system to explore practical and affordable ways for national Offices to develop their online searching capabilities and access to effective search systems. Furthermore, although a bare minimum of hard and soft infrastructures had to be put in place to undertake national registration, WIPO's assistance in the area of translation of documents pertaining to international applications and matching the reports of International Authorities with domestic substantive legal criteria of patentability was essential. The Delegation further observed that, in the past years, the Islamic Republic of Iran had spared no efforts to put in place the needed infrastructure to implement the PCT. However, special attention from WIPO was required to help the country to overcome the remaining problems. Such provision of technical and legal assistance might assist the Islamic Republic of Iran to deposit its instrument of accession to the PCT in the shortest time possible.

9. The Assembly:

- (i) noted the Summary by the Chair of the fourth session contained in document PCT/WG/4/16 and reproduced in Annex I of document PCT/A/42/1, and the draft report of the fourth session of the PCT Working Group contained in document PCT/WG/4/17 Prov. and reproduced in Annex II of document PCT/A/42/1;
- (ii) noted the report by the International Bureau on the financial and operational situation of the supplementary international search system contained in document PCT/WG/4/11 and reproduced in Annex III of document PCT/A/42/1;
- (iii) approved the recommendation concerning the further work of the PCT Working Group set out in paragraph 6 of document PCT/A/42/1.

PROPOSED AMENDMENTS OF THE PCT REGULATIONS

10. Discussions were based on document PCT/A/42/2.

11. In introducing the document, the Secretariat stated that it wished to draw particular attention to the proposal to amend PCT Rule 34, made at the request of the Government of the People's Republic of China, to add patent documents of China to the PCT minimum documentation to be consulted by the PCT International Authorities in carrying out international searches. This constituted an important change, given that Chinese patent documents now formed a substantial component of the global prior art. The Secretariat further wished to draw attention to the proposal to amend Rule 82 and to add new Rule 82*quater* so as to add a general provision to the PCT Regulations which would offer protection to applicants by excusing delays in meeting PCT time limits when that delay resulted from *force majeure* circumstances, prompted by the recent series of disasters in Japan.

12. The Delegation of Japan stated that it fully supported the recommendation by the PCT Working Group that this Assembly adopt the proposed amendments of the PCT Regulations set out in Annex I to document PCT/A/42/2 and the proposed decisions relating to entry into force and transitional arrangements set out in Annex II to the same document.

13. With regard to the proposal to add a general provision to the PCT Regulations which offered protection to applicants by excusing delays in meeting PCT time limits when that delay resulted from *force majeure* circumstances, the Delegation of Japan further stated that it understood that this measure would be applicable to Japanese applicants who had suffered from the Great East Japan earthquake and the resulting tsunami in Japan. In this context, the Delegation wished to express its deepest appreciation to all Delegations for the heartfelt condolences and support extended immediately after the series of natural disasters, not only by the WIPO Secretariat but also Member States all over the world. Japan had requested countries where Japanese companies filed patent applications to take bail-out measures for earthquake victims, and many of them had reacted by taking such measures, accompanied by warm words of encouragement. The Delegation stated that it wished to extend, on behalf of Japanese applicants and the nation of Japan, its utmost gratitude.

14. With regard to the work program of WIPO's PCT related bodies, such as the PCT Working Group and the PCT Meeting of International Authorities, the Delegation of Japan noted that it expected that those WIPO bodies would continue to consider issues such as measures to enhance the usability of international search and examination reports, amendments to the PCT Regulations such as those set out in document PCT/WG/42/2, and measures by International Authorities to improve quality management systems, and expressed the hope that those considerations would eventually achieve tangible and valuable results.

15. The Delegation of China thanked the International Bureau and all PCT International Authorities as well as PCT Member States for their support to include China's patent documentation into the PCT minimum documentation. As had been stated by the Commissioner of the State Intellectual Property Office of China in his general statement, the inclusion of China's patent documentation in the PCT minimum documentation contributed positively to the future development of the PCT system. In recent years, the number of patent applications from China had grown, which in turn resulted in a rapid increase of patent documentation. By the end of August 2011, the number of documents for patents, utility models and industrial designs had reached a total of 6.65 million documents, which constituted a rate of increase of about 100,000 per year. In the view of the Delegation, the inclusion of Chinese patent documentation would enable patent examiners all over the world to search more complete prior art collections and thereby increase the efficiencies and quality of PCT searches,

contributing to improving global technological innovation, invention creation and the development of the IP system.

16. The Delegation of the Republic of Korea expressed its full support to the proposed amendments of the PCT Regulations set out in document PCT/A/42/2. It fully supported the inclusion of the Chinese patent documentation into the PCT minimum documentation and appreciated the efforts by the State Intellectual Property Office of the People's Republic of China to make Chinese patent documents available for this purpose, noting that the number of patent applications filed in China had rapidly increased and that the Chinese patent documentation had enriched the global prior art. The Delegation therefore fully agreed with the view that Chinese patent documents were important to conduct appropriate prior art searches. The Delegation further stated that it welcomed the proposal for the addition of new PCT Rule 82^{quater} to excuse the delay in meeting time limits in *force majeure* circumstances, noting that the present Regulations were not sufficiently flexible to deal with major natural disasters, such as the disaster in Japan on March 11, 2011. It thus wished to again express its sympathy for the reasons behind the proposal.

17. The Assembly:

- (i) adopted the proposed amendments of the Regulations under the PCT set out in the Annex to this report;
- (ii) decided that the amendments of Rule 17.1(b-bis) set out in the Annex shall enter into force on July 1, 2012, and shall apply to any international application, irrespective of its international filing date, in respect of which the time limit under amended Rule 17.1(b-bis) expires on or after July 1, 2012;
- (iii) decided that the amendments of Rule 20.7(b) set out in the Annex shall enter into force on July 1, 2012, and shall apply to any international application whose international filing date is on or after July 1, 2012;
- (iv) decided that the amendments of Rule 34 set out in the Annex shall enter into force on July 1, 2012, and shall apply to any international application, irrespective of its international filing date, in respect of which an international search is carried out on or after July 1, 2012;
- (v) decided that Rule 82.2 shall be deleted with effect from July 1, 2012, provided that Rule 82.2 shall continue to apply to any international application whose international filing date is before July 1, 2012, and in respect of which the six months time limit for the submission of evidence referred to in Rule 82.1(c) as applicable by virtue of Rule 82.2(b) expires on or after July 1, 2012;
- (vi) decided that new Rule 82^{quater} set out in the Annex shall enter into force on July 1, 2012, and shall apply to any international application, irrespective of its international filing date, in respect of which the six months time limit for the submission of evidence referred to in new Rule 82^{quater}.1(a) expires on or after July 1, 2012.

QUALITY MANAGEMENT SYSTEMS FOR THE PCT INTERNATIONAL AUTHORITIES

18. Discussions were based on document PCT/A/42/3.

19. The Assembly noted the contents of document PCT/A/42/3.

[Annex follows]

AMENDMENTS OF THE PCT REGULATIONS TO ENTER INTO FORCE ON JULY 1, 2012

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Rule 17
The Priority Document

17.1 *Obligation to Submit Copy of Earlier National or International Application*

(a) and (b) [No change]

(b-*bis*) Where the priority document is, in accordance with the Administrative Instructions, made available to the International Bureau from a digital library prior to the date of international publication of the international application, the applicant may, instead of submitting the priority document, request the International Bureau, prior to the date of international publication, to obtain the priority document from such digital library.

(c) and (d) [No change]

17.2 [No change]

Rule 20
International Filing Date

20.1 to 20.6 [No change]

20.7 *Time Limit*

(a) [No change]

(b) Where neither a correction under Article 11(2) nor a notice under Rule 20.6(a) confirming the incorporation by reference of an element referred to in Article 11(1)(iii)(d) or (e) is received by the receiving Office prior to the expiration of the applicable time limit under paragraph (a), any such correction or notice received by that Office after the expiration of that time limit but before it sends a notification to the applicant under Rule 20.4(i) shall be considered to have been received within that time limit.

20.8 [No change]

Rule 34
Minimum Documentation

34.1 *Definition*

(a) and (b) [No change]

(c) Subject to paragraphs (d) and (e), the “national patent documents” shall be the following:

(i) [no change]

(ii) the patents issued by the Federal Republic of Germany, the People’s Republic of China, the Republic of Korea and the Russian Federation,

(iii) to (vi) [no change]

(d) [No change]

(e) Any International Searching Authority whose official language, or one of whose official languages, is not Chinese, Japanese, Korean, Russian or Spanish is entitled not to include in its documentation those patent documents of the People’s Republic of China, Japan, the Republic of Korea, the Russian Federation and the former Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than six months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

(f) [No change]

Rule 82
Irregularities in the Mail Service

82.1 [No change]

82.2 [Deleted]

Rule 82^{quater}
Excuse of Delay in Meeting Time Limits

82^{quater}.1 Excuse of Delay in Meeting Time Limits

(a) Any interested party may offer evidence that a time limit fixed in the Regulations for performing an action before the receiving Office, the International Searching Authority, the Authority specified for supplementary search, the International Preliminary Examining Authority or the International Bureau was not met due to war, revolution, civil disorder, strike, natural calamity or other like reason in the locality where the interested party resides, has his place of business or is staying, and that the relevant action was taken as soon as reasonably possible.

(b) Any such evidence shall be addressed to the Office, Authority or the International Bureau, as the case may be, not later than six months after the expiration of the time limit applicable in the given case. If such circumstances are proven to the satisfaction of the addressee, delay in meeting the time limit shall be excused.

(c) The excuse of a delay need not be taken into account by any designated or elected Office before which the applicant, at the time the decision to excuse the delay is taken, has already performed the acts referred to in Article 22 or Article 39.

[End of Annex and of document]