

WIPO



PCT/R/2/2

ORIGINAL: English

DATE: May 31, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**COMMITTEE ON REFORM
OF THE PATENT COOPERATION TREATY (PCT)**

**Second Session
Geneva, July 1 to 5, 2002**

**RESULTS OF THE WORK OF THE WORKING GROUP ON
REFORM OF THE PATENT COOPERATION TREATY (PCT)**

Memorandum prepared by the Director General

1. The Assembly of the International Patent Cooperation Union (PCT Union), at its thirtieth (13th ordinary) session held in Geneva from September 24 to October 3, 2001, considered the report of the first session of the Committee contained in document PCT/R/1/26.
2. In its report, the Committee agreed that reform of the Patent Cooperation Treaty (PCT) should be based on a number of general objectives set out in paragraph 66 of the report. In addition, the Committee agreed on recommendations to the Assembly concerning the establishment of a working group (see paragraphs 67 and 68 of the report), and concerning the referral to the working group, for its consideration and advice, of a number of matters (see paragraphs 60 to 75 of the report).
3. The Committee also agreed on recommendations to the Assembly concerning the work program of the Committee and the working group between the September 2001 and September 2002 sessions of the Assembly (see paragraph 205 of the report):

“The Committee agreed to recommend to the Assembly that between the September 2001 and September 2002 sessions of the PCT Assembly, there should be

E

three meetings devoted to the reform of the PCT: two meetings of a working group that would report to this Committee, and the second session of the Committee itself. The working group should meet once before the end of 2001 and once in March or April 2002. The working group should consider the matters set out in paragraphs 69 to 75, above, in the light of the general objectives set out in paragraph 66, above, on the basis of drafts to be prepared by the International Bureau. The results of the work of the working group would be submitted to the second session of the Committee. The objective would be to have a first set of Rule changes adopted by the Assembly in September 2002, in coordination with the preparation of further changes, including changes to the Treaty itself. Further discussion, including discussion of longer-term proposals, would take place after September 2002.”

4. The Assembly (see document PCT/A/30/7, paragraph 23):

“(i) took note of the report of the first session of the Committee on Reform of the PCT contained in document PCT/R/1/26, and

“(ii) unanimously approved the Committee’s recommendations concerning the establishment of a working group, the matters to be referred to the working group, and the work program of the Committee and the working group between the September 2001 and September 2002 sessions of the Assembly, as set out, respectively, in paragraphs 67 and 68, 69 to 75, and 205 of the Committee’s report.”

5. Pursuant to the Assembly’s decision, the Director General convened the first session of the Working Group on Reform of the PCT, which was held in Geneva from November 12 to 16, 2001, and the second session of the Working Group was held in Geneva from April 29 to May 3, 2002. The proceedings at the Working Group’s sessions were informal, and there were no formal reports. Summaries of the sessions were prepared by the Chair, taking into account comments made by delegations on the draft versions, and are contained in documents PCT/R/WG/1/9 and PCT/R/WG/2/12, respectively, the latter being reproduced in the Annex to this document.

6. The Working Group considered proposals, as recommended by the Committee and decided by the Assembly, relating to improved coordination of international search and international preliminary examination and the time limit for entering the national phase, the concept and operation of the designation system, and changes related to the Patent Law Treaty (PLT), and certain proposals for general simplification and streamlining of PCT procedures. A summary of the discussions of the proposals at the second session appears in paragraphs 5 to 58 of document PCT/R/WG/2/12.

7. The summary of the second session of the Working Group records that (see document PCT/R/WG/2/12, paragraph 60):

“It was agreed that revised proposals on the matters mentioned in paragraphs 5 to 58, above, would be prepared by the International Bureau, taking into account the discussion and conclusions reflected in this Summary and other points of detail noted by the Secretariat, for consideration by the Committee on Reform of the PCT at its second session which was tentatively scheduled for July 1 to 5, 2002. Draft proposals would, where appropriate, be made available for comment on the PCT reform electronic forum in advance of their issuance as formal documents.”

and that (see document PCT/R/WG/2/12, paragraph 63):

“The Working Group agreed that this Summary and the revised proposals referred to in paragraph 60, above, representing the results of the work of the Working Group, should be submitted to the Committee on Reform of the PCT for consideration at its second session in July 2002.”

8. The Committee is invited to consider the results to date of the work of the Working Group on Reform of the PCT represented in document PCT/R/WG/2/12 and reproduced in the Annex to this document, together with the revised proposals contained in the other documents before the Committee.

[Annex follows]

ANNEX

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Second Session

Geneva, April 29 to May 3, 2002

SUMMARY OF THE SESSION

prepared by the Chair

(WIPO document PCT/R/WG/2/12)

INTRODUCTION

1. The session was opened by Mr. Francis Gurry, Assistant Director General, who welcomed the delegates on behalf of the Director General. Mr. Philip Thomas (WIPO) acted as Chair of the session and Mr. Claus Matthes (WIPO) as Secretary. The list of participants is contained in document PCT/R/WG/2/INF/1.

2. The matters for discussion at the session were the following, as recommended by the Committee on Reform of the Patent Cooperation Treaty (PCT) (“the Committee”) at its 1st session in May 2001 and agreed by the Assembly of the PCT Union (“the Assembly”) at its 30th (13th ordinary) session in September-October 2001 (see document PCT/R/1/26, paragraphs 69 to 75, and document PCT/A/30/7, paragraphs 15 to 22):¹

(i) the concept and operation of the designation system;

(ii) improved coordination of international search and international preliminary examination and the time limit for entering the national phase;

(iii) conform filing date requirements to those in the Patent Law Treaty (PLT), conform “missing part”-type requirements to PLT procedure, and other PLT-consistent changes;

(iv) (possibly) other proposals for general simplification and streamlining of PCT procedures.

3. The Working Group took into account the results of its 1st session as set out in the Summary of the Session prepared by the Chair and set out in document PCT/R/WG/1/9.² The documents before the Working Group at its 2nd session are listed in the Annex.^{3,*}

4. The session’s proceedings were informal. All five days of the session were devoted to discussions, and there was no formal report. This summary sets out the Chair’s view of the status of the matters discussed by the Working Group, noting areas where agreement has been

¹ See WIPO’s Web site at http://www.wipo.int/pct/en/reform/index_1.htm (for the Committee) and http://www.wipo.int/eng/document/govbody/wo_pct/index_30.htm (for the Assembly).

² See WIPO’s Web site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

³ The working documents for the 2nd session are available on WIPO’s Web site at http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

* The Annex to document PCT/R/WG/2/12 is reproduced as the Appendix to the present document.

reached and identifying what future work needs to be undertaken. Particular interventions are not recorded.

THE CONCEPT AND OPERATION OF THE DESIGNATION SYSTEM⁴

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

Automatic indication of all designations possible under the PCT

6. The International Bureau indicated that paragraph 5(e) of document PCT/R/WG/2/2 was not intended to suggest that Article 27(5) was exhaustive on the question of prior art effect, but rather that it must be read giving proper effect to Articles 11(3) and 64(4).

7. The proposals contained in document PCT/R/WG/2/2, Annex I, were generally agreed, subject to the matters raised in the following paragraphs.

8. In connection with proposed amended Rule 4:

(i) provision should be made for the mention in the request of details of a parent application where a patent of addition, etc., is sought, similarly to Rule 4.1(b)(iii) dealing with parents of a continuation or continuation-in-part of an earlier application, on the understanding that the absence of such an indication could be corrected by the applicant in the national phase; Rule 4.13 should also be reviewed in this connection;

(ii) the wording of Rule 4.9(a)(i) should make it expressly clear that it is only possible to designate States which are Contracting States at the filing date of the application;

(iii) the wording of Rule 4.9(a)(ii) and (iii) should be revised to provide that the filing of the request “constitute” the desired effect rather than “have the effect of the wish of the applicant”;

(iv) the terminology used in Rule 4.9(b) (“prior to the time of performing the acts ...” and that used in Rule 49*bis*.1 (“within the time limit applicable ...”) should desirably be aligned;

(v) the wording of Rule 4.9(c) should be revised to make it clear what was the nature of the circumstances in which it would operate (that is, in cases of “self-designation” as explained in document paragraph 12(iv) of PCT/R/WG/1/9), having regard to the provisions of the national laws affected (that is, to those of Germany, Japan and the Republic of Korea), noting that “incompatibility” did not correctly describe those circumstances;

⁴ References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be (the current texts are available on WIPO’s Web site at http://www.wipo.int/pct/en/access/legal_text.htm. References to “national laws,” “the national phase,” etc., include reference to regional laws, the regional phase, etc. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT (the texts are available as document PT/DC/47 on WIPO’s Web site at http://www.wipo.int/eng/document/pt_dc/index.htm).

(vi) the request form should contain a box which would enable applicants to make exclusions of designations under Rule 4.9(c) during the transitional period during which that Rule would operate;

(vii) Rule 4.9(d) should be deleted as being unnecessary having regard to the limited and transitional nature of Rule 4.9(c).

9. It was agreed that the present requirements in respect of indications and signature under Rules 4.5 and 4.15 should be retained. However, in order to avoid the international application being considered withdrawn under Article 14(1) for failure to provide such signature and the indications required under Rule 4.5(a) to (c) in respect of all of two or more applicants, two safeguards for applicants should be added.

10. The first safeguard would provide that, for the purposes of Article 14(1)(a)(i), it would be sufficient that the request be signed by at least one applicant. The second safeguard would provide that, for the purposes of Article 14(1)(a)(ii), it would be sufficient that indications required under Rule 4.5(a) to (c) be provided in respect of at least one applicant who is entitled according to Rule 19 to file the international application with the receiving Office concerned.

11. It was also agreed that, consequential to those changes, provision should be made in Rule 51*bis*.1 to permit designated Offices to require, in the national phase, the signature and required indications in respect of all applicants where those had not been provided in the international phase. In addition, to enable the receiving Office to contact a common representative appointed, or considered, under Rule 90.2, such representative should have provided the indications required under Rule 4.5(a) to (c).

12. It was further agreed that safeguards for applicants corresponding to those provided in relation to the request should be also added in relation to the signature, and to the indications in respect of the applicant, required in the demand.

13. While most delegations favored the simplicity of an automatic and all-inclusive designation, the Delegation of Germany drew attention to the wording of certain Articles of the Treaty which contemplate the possibility that the applicant may (for example) designate only one Contracting State (see Article 4) or choose only one form of protection (see Article 43). It was agreed that further consideration should be given to the question whether such possibilities needed to be specifically enabled by procedures available under the Regulations. In the event that they did need to be enabled, while recognizing that they might not be of great practical significance, one possibility might be the withdrawal of designations on the same day as the application was filed and to provide that such a withdrawal be considered as the exclusion of the designations concerned.

14. It was noted that, when an automatic and all-inclusive designation system had been adopted, future contractual arrangements between applicants and others would need to take that fact into account.

15. It was noted that further consequential amendments would be needed to Rule 32.2(b) and (c).

16. In connection with proposed Rule 49*bis*:

(i) in Rule 49*bis*.1(a) and (b), the reference to “Article 22(1) and 39(1)(a)” should be simply to “Article 22,” noting that Rule 76.5 made the provisions applicable to Chapter II;

(ii) in Rule 49*bis*.2, the words “a further time which shall be reasonable under the circumstances” should be replaced by “at least two months from [the time of entering the national phase]” (the wording of the latter to be aligned with that in Rules 4.9(b) and 49*bis*.1; see paragraph 8(iv), above).

17. It was agreed that Rule 76.6 no longer had any effect and should be deleted, since all transitional reservations made under that provision had since been withdrawn.

Automatic indication of all elections possible under the PCT

18. The proposals contained in document PCT/R/WG/2/2, Annex II, were generally agreed, subject to the matters raised in the following paragraphs.

19. Considering that there is no longer a need for a specific regulation for the concept of “later election”, it was agreed that Rule 56 should be deleted. Consequential amendment of other Rules (such as Rule 61.2) would then also be needed.

“Flat” international filing fee

20. The proposals contained in document PCT/R/WG/2/2, Annex III, were generally agreed, subject to the matters raised in the following paragraphs.

21. It was agreed that further consideration should be given to the basis for calculation of the late payment fee contemplated in Rule 16*bis*.2(b), depending on the amount which might be fixed for the new flat international filing fee (see Schedule of fees, item 1).

22. It was agreed that item 1 of the Schedule of Fees should refer to “each sheet of the international application.”

“Communication on request” system

23. The proposals contained in document PCT/R/WG/2/2, Annex IV, were generally agreed, subject to the matters raised in the following paragraphs.

24. It was agreed that Rule 47 as proposed to be amended and proposed new Rule 93*bis* should be revised to reflect the fact that those Rules would have to operate in relation to every Article 20 communication of a copy of the international application to a designated Office, no matter how that communication was effected, be it on the basis of a standing order for systematic communication of all or a certain class of documents or on the basis of a particular order for the communication of specified documents, be it on paper, in electronic form, by physical means (mailing) or by electronic means. Different considerations applied and could lead to different approaches, noting, in particular, the possibility of effecting communications by electronic means via a central data source (“intellectual property digital library” (IPDL)) from which Offices would be able to “pull” documents rather than have them “pushed” to Offices by the International Bureau.

25. It was agreed that further consideration should be given to the nature of the act of “communication,” the operation of Article 22(1), the safeguard afforded to applicants by the last sentence of present Rule 47.1(c), against the background of the proposed communication on request system, the possibilities available for Offices to make either particular orders for the communication of particular documents or standing orders for the communication of all or a certain class of documents, and the use of the term “IPDL” in the context of communication by electronic means.

CHANGES RELATED TO THE PLT: LANGUAGE OF THE INTERNATIONAL APPLICATION AND TRANSLATIONS

26. Discussions were based on documents PCT/R/WG/2/5 and 5 Add.1.

Alignment with language-related filing date requirements of the PLT

27. It was agreed that no change was needed to the existing PCT Regulations in order to give effect to the language-related filing date requirements of the PLT, noting that PCT Rule 19.4(a)(ii) already provided for transmission to the International Bureau as receiving Office, without loss of filing date, of an international application which was not in a language accepted by the receiving Office with which it was filed, and noting that the International Bureau accepted any language for the purposes of filing of international applications. The PCT was thus already “PLT-compliant” in relation to language-related filing date requirements.

Translation of international application for the purposes of international publication

28. The proposals contained in the Annex to document PCT/R/WG/2/5 were agreed, subject to the further modifications proposed in document PCT/R/WG/2/5 Add.1, subject to the matters raised in the following paragraphs.

29. It was agreed that further consideration should be given to the basis for calculation of the late furnishing fee contemplated in Rules 12.3(e) and 12.4(e), depending on the amount which might be fixed for the proposed new “flat” international filing fee under item 1 of the Schedule of Fees (see paragraphs 20 to 22, above).

30. It was noted that the combined effect of the existing provisions of PCT Rules 12.1(c), 12.3(b) and 26.3^{ter}(c), and proposed new Rule 12.4(b), is such as to prevent a receiving Office from requiring a translation of the request if it is filed in any language of publication under the PCT, even if that language is not accepted by the receiving Office. Consideration should be given to further amendments which would enable the receiving Office to require a translation of the request into a language which is both a language of publication and a language accepted by the receiving Office.

IMPROVED COORDINATION OF INTERNATIONAL SEARCH AND INTERNATIONAL PRELIMINARY EXAMINATION AND THE TIME LIMIT FOR ENTERING THE NATIONAL PHASE: EXPANDED INTERNATIONAL SEARCH SYSTEM

31. Discussions were based on documents PCT/R/WG/2/1, 1 Add.1, 9, 9 Corr., 10 and 11, particularly focusing on document PCT/R/WG/2/9, submitted by the United States of America, which proposed a simplified approach.

32. It was agreed that the proposed amendments of the Regulations set out in the documents should be further revised, taking into account the matters mentioned in the following paragraphs:

33. While a more extensive combination of the international search and international preliminary examination procedures would be considered in the context of long-term reform of the PCT, the separate procedures under Chapters I and II of the Treaty would be retained in the context of amending the Regulations to introduce the proposed expanded international search (EIS) system. The international preliminary examination procedure under Chapter II should continue to be initiated by the filing of a demand. The existing possibility for International Searching Authorities (ISAs) and International Preliminary Examining Authorities (IPEAs) to combine the procedures under Rule 69.1(b) would be retained.

34. Since all ISAs would be responsible for preparing international search opinions (ISOs) which were analogous in their content to international preliminary examination reports (IPERs), the Regulations should ensure that the qualifications for appointment of an ISA include all of those which apply for appointment of an IPEA.

35. If the applicant did not file a demand for international preliminary examination, the ISO would be re-issued as a report as part of the Chapter I procedure. The title of the report remained to be decided. Possibilities mentioned (but not agreed) during the session included: "international preliminary examination report" used in such a way as to distinguish the reports under Chapters I and II, "international initial examination report," "international search examination report," "international report on patentability" and "international advisory report." Further suggestions would be welcomed by the Secretariat.

36. Under the Chapter I procedure, the ISO would remain confidential until the report mentioned in the previous paragraph was communicated to designated Offices by the International Bureau, with the international application, 30 months from the priority date, unless the applicant expressly requested early entry into the national phase under Article 23(2) before a designated Office, in which case the report would be transmitted to that Office. The communication of international applications at the expiration of the applicable time limit under Article 22 to designated Offices of States which had made transitional reservations in connection with the modified time limit under that Article would not include the report, but the report would be sent to such Offices at the same time it was sent to Offices which had not made reservations. Once the report had been communicated, it would also be made publicly available by the International Bureau.

37. No special provisions would be included in the Regulations for the applicant to comment on the ISO. Under the Chapter I procedure, the applicant could, however, submit comments on an informal basis to the International Bureau. Such informal comments would be sent to designated Offices by the International Bureau and made publicly available, as would be the report resulting from the ISO. Designated Offices would be free to require a translation of such comments. Under the Chapter II procedure, any response to the ISO would need to be submitted to the IPEA under Article 34 as part of the international preliminary examination procedure.

38. It was not necessary to require that the same Office act as both ISA and IPEA, noting that any IPEA could, under the existing system, restrict its competence to applications in

respect of which the international search had been carried out by the same Office acting as ISA.

39. In accordance with the view of the majority of those delegations which expressed views on the matter, the ISO would, for the purposes of the international preliminary examination procedure, be considered to be the first written opinion in that procedure, on the understanding that this did not imply that the IPEA would be bound by the conclusions contained in the ISO. However, any IPEA would be entitled to inform the International Bureau that ISOs which had not been prepared by the same Office in the capacity of ISA would not be considered to be first written opinion in relation to the procedure before that IPEA; such an IPEA would then have to issue a first written opinion after receiving the demand, although that opinion could, of course, incorporate part or all of the content of the ISO.

40. The time limit for submitting a demand for international preliminary examination would be three months after the issuance of the ISO or 22 months from the priority date, whichever was later, and the time limit for paying the necessary fees would need to be adjusted accordingly. During the period during which transitional reservations of certain Contracting States concerning the recently modified time limit under Article 22 were still in force, the demand would have to be filed within 19 months from the priority date if the applicant wished to have 30 months in which to enter the national phase in those countries.

41. Any arguments and/or amendments in response to the ISO would also have to be submitted within three months after the issuance of the ISO or 22 months from the priority date, whichever was later, if they were to be taken into account by the IPEA, failing which the IPEA would be free to proceed straight to the issuance of the IPER, without issuing any further notification to the applicant. That time limit would apply even where the demand had been filed earlier.

42. Several non-governmental organizations representing users of the PCT system proposed that the applicant should be guaranteed a second written opinion after filing a demand (that is, in addition to the ISO which was considered to be the first written opinion). That proposal did not find support among delegations, but it was noted that the International Preliminary Examination Guidelines, which the IPEAs were obliged to apply and observe, provide for the issuance of a further opinion where the applicant made a serious attempt to respond to a (first) written opinion.

43. The ISO (or an accompanying form) should outline to the applicant the available options and consequences in terms of filing a demand, particularly if the same Office were not to act as both ISA and IPEA (see paragraph 39, above), time limits, responding to the matters raised in the ISO under Chapter I (by way of submitting informal comments) or Chapter II (by way of filing a demand and Article 34 arguments or amendments), etc.

44. No change would be proposed, at least for the time being, to the time limit for the preparation of the international search report (ISR). The Delegation of the United States of America urged consideration of a relaxed time limit for the preparation of the ISR.

45. The EIS system needed to operate simply and safely during the period during which transitional reservations of certain Contracting States concerning the recently modified time limit under Article 22 were still in force, as well as in the future.

46. Provision would be made for the International Bureau to make reports resulting under Chapter I from the ISO publicly available, together with any informal comments received, and to make IPERs publicly available on behalf of elected Offices which so request.

47. The scope of the relevant prior art to be considered in the preparation of both the ISR and the ISO, and the basis on which prior art was cited, including the date to which the search should be carried out, would correspond to the international preliminary examination procedure.

48. If for any reason the applicant filed a demand but the international application or the demand was subsequently withdrawn with the result that an IPER was not issued, the report resulting from the ISO would be available to the elected Offices. That is, either an IPER or the report resulting from the ISO would always be available to Offices in the national phase.

49. A number of drafting points were noted by the Secretariat and would be taken into account in the preparation of revised proposals.

CHANGES RELATED TO THE PLT: MISSED TIME LIMIT FOR ENTERING THE NATIONAL PHASE

50. Discussions were based on document PCT/R/WG/2/4.

51. Although the contents of document PCT/R/WG/2/4 could not, in the time available, be discussed in detail, the majority of the delegations which expressed their views agreed with the general approach outlined in the document, and it was agreed that the proposals should be submitted to the next session of the Committee. The revised proposals would envisage the possibility that national laws could make provisions concerning the prior rights of third parties and the right of third parties to intervene.

52. The Delegation of Japan expressed its concern about the proposed inclusion in the PCT Regulations of provisions having a similar effect to PLT Article 12 and PLT Rule 13(2). The Delegation believed that the PCT should not duplicate provisions which already are included in the PLT, noting that PLT Article 12 and PLT Rule 13(2) expressly applied to the time limits under PCT Articles 22 and 39(1) (see Note 3.08 on PLT Article 3(1)(b)). The Delegation also believed that the proposals dealt with substantive matters which should be left to national law to decide. The Delegation also believed that the proposal would cause severe practical problems for designated Offices because of the delays in national processing which would result.

CHANGES RELATED TO THE PLT: RIGHT OF PRIORITY AND PRIORITY CLAIMS

53. Discussions were based on document PCT/R/WG/2/3.

54. Although the contents of document PCT/R/WG/2/3 could not, in the time available, be discussed in detail, there was general support for proposed new Rule 26*bis*.3 relating to restoration of priority claims. Revised proposals should take into account the following considerations:

(i) the substantive validity of a priority claim in terms of the Paris Convention would remain a matter for national law;

(ii) national law could make provisions concerning the prior rights of third parties and the right of third parties to intervene;

(iii) the need for information concerning the fact that a priority claim had been restored to be communicated to designated Offices, for example, by the inclusion of indications on the front page of the published application (PCT pamphlet);

(iv) consideration should be given to reducing or eliminating the ability of a designated Office to review a decision of the receiving Office to restore or refuse to restore a priority claim (see Rule 26*bis*.3(h)).

55. It was agreed that proposed amended Rules 17.1 and 66.7, relating to the possibility, in line with the PLT, that priority documents may be available, in the future, from digital libraries, should proceed together with the proposed amendment of Rule 47.1 and related provisions (see paragraphs 24 and 25, above). Proposed amended Rules 26*bis*.1 and 26*bis*.2 and new Rule 80.8, relating to the correction and addition of priority claims, should similarly also proceed.

56. It was agreed that revised proposals should preferably be submitted to the second session of the Committee, although it was recognized that the time available may not permit the necessary revision of the proposals.

OTHER PROPOSALS FOR GENERAL SIMPLIFICATION AND STREAMLINING OF PCT PROCEDURES

Waiver of requirement for separate power of attorney under Rule 90.4

57. Discussions were based on the proposal to amend Rule 90.4 contained in document PCT/R/WG/2/7, Annex II, and document PCT/R/WG/2/7 Add.1.

58. It was agreed that Rule 90.4 should be amended to provide that any receiving Office, any International Searching Authority, any International Preliminary Examining Authority and the International Bureau may waive the requirement provided in Rule 90.4(b) that a separate power of attorney be submitted to it. It would be for the Office, the Authority or the International Bureau, as the case may be, to decide in what circumstances the requirement would be waived (for example, in cases where the agent concerned was the subject of an indication under Rule 4.7(b)). The Office, the Authority or the International Bureau would be permitted to require a separate power of attorney in particular instances even if it had waived the requirement in general. The signature of the applicant would always have to be required in the case of a withdrawal under Rule 90*bis* or a change in the person of the applicant under Rule 92*bis*.

OTHER MATTERS

59. The Working Group was unable in the time available to consider the following matters upon which proposals had been submitted to it for consideration at the session (see also related comments in documents PCT/R/WG/2/10 and 11):

(i) Changes related to the Patent Law Treaty (PLT):

- Absence of “formal” claims (document PCT/R/WG/2/8);

- Other PLT-related changes (document PCT/R/WG/2/6);

(ii) General simplification and streamlining of PCT procedures: Signature of the international application and related documents (document PCT/R/WG/2/7) (with the exception of the matters mentioned in paragraphs 57 and 58, above).

FUTURE WORK

60. It was agreed that revised proposals on the matters mentioned in paragraphs 5 to 58, above, would be prepared by the International Bureau, taking into account the discussion and conclusions reflected in this Summary and other points of detail noted by the Secretariat, for consideration by the Committee on Reform of the PCT at its second session which was tentatively scheduled for July 1 to 5, 2002. Draft proposals would, where appropriate, be made available for comment on the PCT reform electronic forum⁵ in advance of their issuance as formal documents.

NEXT SESSION

61. The International Bureau indicated that the third session of the Working Group was tentatively scheduled for November 25 to 29, 2002.

CONCLUSION

62. This Summary of the Session was prepared under the responsibility of the Chair, taking into account comments made by delegations on the draft (Prov.) version.

63. The Working Group agreed that this Summary and the revised proposals referred to in paragraph 60, above, representing the results of the work of the Working Group, should be submitted to the Committee on Reform of the PCT for consideration at its second session in July 2002.

[Appendix follows]

⁵ See WIPO's Web site at http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

LIST OF DOCUMENTS¹

- PCT/R/WG/2/1 Improved coordination of international search and international preliminary examination and the time limit for entering the national phase: Expanded international search system
(document prepared by the International Bureau)
- PCT/R/WG/2/1 Add.1 Proposed expanded international search system: EPO response (Addendum to document PCT/R/WG/2/1)
(proposals submitted by the European Patent Office (EPO))
- PCT/R/WG/2/2 The concept and operation of the designation system: Automatic indication of all designations possible under the PCT; Related proposals: Elections; International filing fee; “Communication on request” system
(document prepared by the International Bureau)
- PCT/R/WG/2/3 Changes related to the Patent Law Treaty (PLT): Right of priority and priority claims
(document prepared by the International Bureau)
- PCT/R/WG/2/4 Changes related to the Patent Law Treaty (PLT): Missed time limit for entering the national phase
(document prepared by the International Bureau)
- PCT/R/WG/2/5 Changes related to the Patent Law Treaty (PLT): Language of the international application and translations
(document prepared by the International Bureau)
- PCT/R/WG/2/5 Add.1 Proposed new Rule 12.4 (Addendum to document PCT/R/WG/2/5)
(Proposals submitted by the Republic of Korea)
- PCT/R/WG/2/6 Changes related to the Patent Law Treaty (PLT): Other PLT-related changes
(document prepared by the International Bureau)
- PCT/R/WG/2/7 General simplification and streamlining of PCT procedures: Signature of the international application and related documents
(document prepared by the International Bureau)
- PCT/R/WG/2/7 Add.1 Signature requirements (Addendum to document PCT/R/WG/2/7)
(proposals submitted by Australia)

* The Appendix to the present document reproduces the Annex to document PCT/R/WG/2/12.

¹ The working documents for the session are available on WIPO’s Web site at http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

- PCT/R/WG/2/8 Changes related to the Patent Law Treaty (PLT): Absence of “formal” claims
(document prepared by the International Bureau)
- PCT/R/WG/2/9 Revised U.S. proposal for PCT reform; Counterproposal to document PCT/R/WG/2/1
(proposal submitted by the United States of America)
- PCT/R/WG/2/9 Corr. Revised U.S. proposal for PCT reform; Counterproposal to document PCT/R/WG/2/1: Corrigendum (page 5 of document PCT/R/WG/2/9 – English version only)
(document prepared by the International Bureau)
- PCT/R/WG/2/10 Comments on the papers for the second session of the PCT Reform Working Group
(proposals submitted by the Institute of Professional Representatives before the European Patent Office (EPI))
- PCT/R/WG/2/11 Expanded international search system; Absence of “formal claims”
(proposals submitted by the Intellectual Property Institute of Canada (IPIC))
- PCT/R/WG/2/12 Prov. Draft summary of the session
(prepared by the Chair)

[End of Appendix and of document]