

Patent Cooperation Treaty (PCT) Working Group

Twelfth Session
Geneva, June 11 to 14, 2019

SUMMARY BY THE CHAIR

AGENDA ITEM 1: OPENING OF THE SESSION

1. Mr. Claus Matthes, Senior Director, PCT Legal and International Affairs Department, Patents and Technology Sector, opened the session and welcomed the participants on behalf of the Director General of WIPO. Mr. Michael Richardson (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. Victor Portelli (Australia) as Chair and Mr. Reza Dehghani (Islamic Republic of Iran) as Vice-Chair for the session.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

3. The Working Group adopted the revised draft agenda as proposed in document PCT/WG/12/1 Prov. 2.

AGENDA ITEM 4: PCT STATISTICS

4. The Working Group noted a presentation by the International Bureau on the most recent PCT statistics¹.

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

5. Discussions were based on document PCT/WG/12/2.

¹ The presentation is available on the WIPO website at:
https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=438415.

6. The Delegation of the United Kingdom welcomed the continuing discussions by the Quality Subgroup of the Meeting of International Authorities; as an effective way of raising quality, Offices needed to share information and best practices in quality management. While IT constraints prevented the United Kingdom Intellectual Property Office (UKIPO) from sharing its search strategies, the Delegation recognized the importance of this practice, and was keen to participate in any future survey on this matter. Moreover, the Delegation believed that the opportunity for national Offices to provide feedback on work in the international phase was key to raising quality. In this regard, the UKIPO had started a small-scale pilot with IP Australia and the Canadian Intellectual Property Office to provide feedback as a designated Office on international search reports, and it invited other International Searching Authorities to participate in the pilot. The Delegation planned to report on the result of the pilot to future sessions of the Working Group.

7. The Working Group noted the report of the twenty-sixth session of the Meeting of International Authorities, based on the Summary by the Chair of that session contained in document PCT/MIA/26/13 and reproduced in the Annex to document PCT/WG/12/2.

AGENDA ITEM 6: PCT ONLINE SERVICES

8. Discussions were based on document PCT/WG/12/10.

9. All delegations that took the floor expressed appreciation for the functionality for applicants and Offices made available by the International Bureau through its various online services, including ePCT, eSearchCopy, DAS and CASE.

10. Delegations broadly supported the long term goals and next steps for further development proposed in the document. Towards this end, effective communication and coordination was needed between Offices and the International Bureau to ensure that Offices were able to take advantage of new developments and to ensure compatibility between the International Bureau's services and national systems, taking into account national laws and user interests.

11. Many delegations observed that the use of ePCT for Offices and applicants enabled increased productivity and cost savings. Some delegations reported that, by the end of last year, significant numbers of international applications had been filed and demands for international preliminary examination submitted through ePCT at their Offices. Access to filing was improved by the recent enhancements made to the collaboration mechanisms, allowing signatures to be added by parties who did not have WIPO accounts. User representatives emphasized that reliable access to online services and suitable safeguards in the event of failures were particularly important for applicants.

12. One delegation advised that it would be encouraging applicants to move away from PCT-SAFE in favor of ePCT, aiming to decommission PCT-SAFE ahead of WIPO's timetable. Another delegation noted that it was currently in the process of reviewing its receiving Office functions, giving due consideration to ePCT and eSearchCopy implementation during the forthcoming year. One delegation noted that, working with the International Bureau, it had connected ePCT to its internal application system in January 2019 and subsequently the rate of ePCT filing had increased and was expected to rise further. Another delegation, noting the reception of 90 per cent of its filings via its local e-filing system, expressed its interest in implementing a similar arrangement with its local e-filing system to enhance consistency and reduce maintenance costs.

13. Two delegations raised concerns in relation to the proposed future decommissioning of PCT-SAFE, with one delegation mentioning that about 65 per cent of international applications received by that receiving Office were filed using the PCT-SAFE software and, consequently, requested that PCT-SAFE continued to be supported.

14. Several delegations emphasized the importance of improving the services for creating search and examination reports in the ePCT system in order to allow smaller Authorities to deliver XML search reports. One delegation reported on the work of its IP Office, in its capacity as an International Searching Authority, to assist the International Bureau in addressing the required improvements, such as automatically importing family data into the report. Delegations further observed that ePCT enabled applicants to send documents and data electronically to Offices and that it was now necessary to consider allowing documents to be sent to applicants electronically without sending paper copies in parallel.

15. Delegations noted the importance of other issues concerning XML data, PCT forms and structured citation information. Such data was important to ensuring the quality and consistency of the data made available to processing and search systems, as well as to training artificial intelligence systems. One delegation requested the making available of a guide as to how to create XML forms and reports outside of the ePCT system. Several delegations noted the importance of DOCX filing as a means of encouraging the filing and processing of full text application bodies. One delegation expressed concern at the number of different DOCX converters under development. This could lead to divergent results and uncertainty for applicants and Offices; the delegation suggested that it would be desirable to develop a single DOCX converter for use by all Offices. One delegation also queried whether there were plans for revising Annex F to allow for the use of XML according to WIPO Standard ST.96, noting that WIPO Standard ST.36, on which Annex F was currently based, had not been significantly developed for some years.

16. In respect of the Digital Access Service for priority documents (DAS), many delegations welcomed the increasing number of Offices participating in the DAS system. For example, India, Israel, Portugal and the European Patent Office had joined DAS the previous year and Canada was intending to become at least an accessing Office once the PLT had been implemented, which was expected to happen later in 2019. Several delegations encouraged all Offices to migrate to DAS for the electronic, paperless sharing of priority documents.

17. Similarly, delegations encouraged further Offices to use the WIPO CASE system, at least as providing Offices, so as to make available as much information as possible for search and examination purposes. Several delegations also encouraged the sharing of text based reports through the CASE system to enrich the data available through the system. A number of delegations indicated that their Offices had either recently joined WIPO CASE or intended to do so in the near future.

18. Many delegations supported the use of the eSearchCopy system and encouraged the remaining Offices to participate in this system, noting that the system offered Offices benefits in their roles both as receiving Offices and International Searching Authorities, and that it offered applicants benefits in reducing delays. It was also noted that the transition to the service from paper had generally been found to work smoothly. Furthermore, the representative of the European Patent Office stated its intention to complete the migration of all receiving Offices for which it was competent to act as an International Searching Authority to the eSearchCopy system by the end of 2020.

19. Several delegations mentioned that they were particularly interested in progressing work on machine-to-machine real-time interactions as a priority, particularly in support of paperless and timelier document delivery between Offices and to applicants. Other priorities particularly highlighted included the publication of color drawings, development of tools for working with sequence listings and assisting national phase entry.

20. The Chair observed that the Secretariat had taken note of specific issues to address with individual delegations. The tools that the International Bureau had provided had stimulated use and thought by Offices and applicants. As the expectations of users continued to rise, further development would need to be undertaken to continue to match those expectations.

21. The Working Group noted the contents of document PCT/WG/12/10.

AGENDA ITEM 7: ELECTRONIC COMMUNICATION BETWEEN OFFICES AND APPLICANTS IN THE PCT

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

23. One delegation expressed strong support for work towards using ePCT notifications as an official means for communicating documents from Offices, which would reduce costs, address issues of delays in delivery of surface mail and permit traceability, noting that it would be possible to register successful receipt of documents. Integration with patent management systems using web services would be an important step in making this practical.

24. The Working Group noted the continued concerns of user representatives over the withdrawal of the fax service for the PCT. While the limitations of fax over IP were recognized, it still provided the possibility of transmitting documents to the International Bureau when computer systems accessed via the Internet had failed and was a technology still found everywhere. Two delegations noted their support for moving away from fax and that use of fax in their Offices had recently been stopped or significantly reduced in permitted scope.

25. The Chair observed that it was necessary to minimize complexity of integrated systems. The use of fax was declining sharply – in many offices, the fax machine was largely forgotten and not used or checked regularly. Maintaining additional services for extremely limited use might cause additional confusion and expense for limited benefit, particularly in view of the fact that much of the main perceived benefit was illusory if the services were, in practice, delivered through the Internet.

26. The Working Group noted that the International Bureau would continue to consult Offices and user groups on the issues set out in document PCT/WG/12/23.

AGENDA ITEM 8: INTERNATIONAL APPLICATIONS LINKED TO UNITED NATIONS SECURITY COUNCIL SANCTIONS

27. Discussions were based on document PCT/WG/12/7.

28. The Delegation of the Democratic People's Republic of Korea (DPRK) stated that it wished to reiterate its position and to remind the Working Group that the DPRK had been rejecting the UN Security Council Resolutions against the DPRK, which had neither legal ground, nor impartiality. The Delegation stated that voices to stop the brutal UN sanctions against the DPRK were now ever increasing among many other countries of the world. Patents were not themselves materials nor services; rather, they were solely intended to protect the intellectual property of human beings. From this perspective, the Delegation insisted that any recommendation of the UN Panel of Experts should not cause a negative impact on the mandate of WIPO for an effective international IP system.

29. The Working Group noted the contents of document PCT/WG/12/7.

AGENDA ITEM 9: NETTING

(A) PROGRESS REPORT: PILOT ON NETTING OF PCT FEES

30. Discussions were based on document PCT/WG/12/19.

31. The International Bureau, in introducing the document, noted that both the survey of Offices and the audit report referred to in the document had been positive, identifying benefits of the pilot for both national Offices and the International Bureau. The International Bureau was looking at options to further improve the arrangements and to find ways of allowing Offices currently unable to participate in the pilot to do so in the future.

32. All delegations that took the floor supported the principle of the pilot. Those delegations whose IP Offices were participating in netting were satisfied with the improved processes. Other delegations stated that their IP Offices hoped to participate in the future if certain barriers could be overcome. One delegation whose IP Office acted as an International Searching Authority noted the simplification of work flows and hoped that soon all the receiving Offices for which it acted would be able to make transfers in this way, allowing it to maximize the benefits by eliminating different parallel fee transfer arrangements.

33. The International Bureau considered that netting of fees would provide optimum benefits for many Offices as well as for the International Bureau. However, it was recognized that this was not possible for all Offices, and participation in the fee transfer process was possible without netting of fees. The proposed change in terminology from "Netting System" to "Fee Transfer Service" would help to clarify this. The International Bureau would make efforts to engage with national Offices to find solutions to problems with participation, to ensure that training needs were met, and to assist in setting up IT services correctly, including the creation of appropriate XML files.

34. The Working Group noted the contents of document PCT/WG/12/19.

(B) TRANSFER OF PCT FEES: PROPOSALS TO AMEND THE PCT REGULATIONS AND ADMINISTRATIVE INSTRUCTIONS

35. Discussions were based on document PCT/WG/12/20.

36. Delegations agreed with the principle of the proposed amendments to the Regulations, noting the importance of having a clear legal basis for the arrangements while retaining flexibility to make future improvements through further modifications to the Administrative Instructions as needed. Several delegations noted that it would take time to adapt their IT systems and finance processes to meet possible new notification requirements.

37. One delegation noted that it would be important for collecting Offices to notify the International Bureau as well as beneficiary Offices of the payment of individual fees. Noting the need to ensure that the burdens on Offices were kept to a minimum and to allow the form of the notifications to be made appropriate to the particular fees concerned, the International Bureau proposed to delete the words "to the beneficiary Office" from the text of proposed new Rule 96.2(b). The form and recipients of the notifications would be set out in the Administrative Instructions, seeking to avoid the need to set up new notification processes in the short term, while pointing the way to improved data exchange for the future.

38. The same delegation also suggested deletion of the second sentence of proposed new Rule 96.2(b), noting that Rule 42, setting the time limit for international search, already implied that the International Searching Authority had to start the international search immediately upon receipt of the search copy. While acknowledging that this was the case, the International Bureau preferred to retain this sentence to make clear that beneficiary Offices were obliged to take notification of receipt of a payment by a collecting Office as equivalent to having actually received the fee. It should be explicit that Offices should not wait until transfer of a fee had occurred to begin associated work, such as the international search.

39. The International Bureau indicated that it would consult further on the proposed Administrative Instructions set out in Annex II to document PCT/WG/12/20 through PCT Circulars and bilateral discussions of issues specific to individual Offices, with a view to bringing the new provisions into force on July 1, 2020. National Offices that had technical, legal or administrative difficulties with participating in the new arrangements were strongly encouraged to provide specific details of the problems so that the International Bureau could seek solutions, whether through further modifications to the Administrative Instructions or by otherwise adapting the technical and financial procedures.

40. The Working Group approved the proposed amendments to Rules 15, 16, 57 and 96 of the Regulations, as set out in Annex I to document PCT/WG/12/20, with a view to their submission to the Assembly for consideration at its next session in September-October 2019, subject to the modification to proposed new Rule 96.2(b) as set out in paragraph 37, above and possible further drafting changes to be made by the Secretariat.

AGENDA ITEM 10: FEE REDUCTIONS FOR UNIVERSITY APPLICANTS

(A) FEEDBACK TO CIRCULAR C. PCT 1554

41. Discussions were based on document PCT/WG/12/3.

42. The Delegation of Germany, speaking on behalf of Group B, supported by a number of delegations, indicated that several Member States continued to have concerns regarding the introduction of fee reductions for universities. Issues of concern included how fairly the measures were targeted, the administration costs and burdens for the International Bureau and receiving Offices, and the issues of protecting against abuses. Other measures might be more appropriate for encouraging the use of the patent system by universities, such as expansion of the *pro bono* Inventor Assistance Program to universities in order to reduce the largest financial expense faced by applicants in the patent process, that is, patent practitioner costs.

43. Two delegations indicated that they considered it more appropriate to seek across-the-board fee reductions, reflecting the fact that existing applicants had all contributed to the budget surplus of WIPO and that, consequently, all should benefit from it. A single fee structure worked well and it was not desirable to complicate it by creating differences for certain groups of applicants. There had been suggestions of special treatment for small and medium-sized entities – it was not clear why universities should be supported but not other groups, particularly when studies showed that the rates of applications were affected less by levels of fee than by other factors. Measures to assist universities should cover the whole of the research and development phase and ensure effective communication between universities and industry. The cost-benefit ratio of the proposal was considered too high.

44. The Delegation of Brazil, supported by the delegations speaking on behalf of the Asia and Pacific Group (APG), the Group of Latin American and Caribbean Countries (GRULAC) and the African Group and several other individual delegations, reiterated that economic studies had found that universities had a positive role in productivity. The knowledge generated by universities enhanced industrial output, with a strong and positive effect on innovation across the economy. This was particularly so in the field of pharmaceuticals, underlying the fact that universities were significant sources of scientific and technical knowledge that could be harnessed for innovation, the main purpose of WIPO. A variety of countries, including ones expressing concern about the present proposal, had adopted national measures offering fee reductions to universities. Despite these efforts, universities filed only 5.4 per cent of international applications according to the 2019 PCT Yearly Review. Cost had been identified as the main burden in a study entitled “Patent Costs and Impact on Innovation”, published by the European Commission, looking at universities in a variety of developed countries. If that was the case for those developed countries, it would certainly be so in countries with more

limited resources. Member States had been discussing a PCT fee policy to stimulate filings by universities since the second session of the Working Group in 2009, at which session they had “agreed on the importance of fee reductions and capacity building measures, including in patent drafting and filing, and agreed that the relevant PCT bodies should prepare proposals, including fee reductions and capacity building measures, to increase access to the PCT for independent inventors and/or natural persons, small and medium-sized enterprises and universities and research institutions, in particular from developing and least developed countries” (paragraph 97 of document PCT/WG/2/14). In the third session of the Working Group, the International Bureau had stated “An international application gives time before the greater costs need to be paid and may give assistance in finding such partners. Consequently, while a relatively small part of the total cost, accessibility to this stage of the patent procedure may be particularly important for some innovators.” (paragraph 188 of document PCT/WG/3/2). At the workshop held during the eleventh session of the Working Group, a representative from the University of Copenhagen had indicated that the 30 month period offered by the PCT was used to look for companies interested in obtaining licenses and that a PCT application had the effect of spreading the news of an invention, disseminating knowledge about the technology and helping to find a potential licensee. If none were found, the application would be abandoned. This illustrated that the budget of universities was limited and that the PCT was used in a manner different from other applicants. This was also shown by the study by WIPO’s Chief Economist in 2014. The responses to Circular C. PCT 1515 showed that many countries had consulted universities and received feedback, stating that filing fees were seen as a barrier to entry to the system. In document PCT/WG/11/18 Rev., Brazil had proposed a 50 per cent reduction for universities in developing countries and 25 per cent for those located in developed countries, but the Delegation emphasized that it was flexible on the amount to be granted to universities from developed countries. The cost of this was estimated to be just 0.4 per cent of PCT fee income and should be seen as “resources well allocated”, rather than foregone income. Furthermore, the Program and Budget Committee had again agreed last month to include an indicator measuring the number of PCT applications filed by universities from developing countries, showing that WIPO Member States recognized the necessity of policies addressing the issue of PCT filings from developing countries. The Delegation considered that the proposal was fully in line with WIPO’s mission to encourage creativity through the protection of intellectual property around the world, as stipulated in the WIPO Convention.

45. One delegation indicated that it had had a national policy waiving all fees for public universities, but this had not given the desired results, with a large increase in filings that was not reflected in patent grants or use. A better alternative had been a 50 per cent reduction, extended to 100 per cent when the university could show that it was actually using the patent. The delegation’s Office, acting as an International Searching Authority, offered a 75 per cent fee reduction to all applicants from developing countries. The proposal was in line with its current national policy and the delegation hoped that it could be expanded to all countries, irrespective of their levels of development.

46. Several delegations expressed the view that the consultation had identified various practical issues that needed to be addressed and for which solutions needed to be found. IT solutions would be important to ensure that the proposal could be implemented smoothly.

47. A number of delegations questioned whether the proposal would actually provide the desired results, but one delegation nevertheless observed that, without trying, it would be difficult to answer that question; several of these delegations indicated that they would not block consensus if there was general agreement on the principles and the technical issues were suitably addressed. The sunset clause and proper evaluation were considered very important if a reduction were to be approved.

48. In response to concerns expressed by a representative of users, the Chair emphasized that there was no suggestion that fees for other users would be raised as a result of implementing reductions for universities.

49. The Delegation of Brazil responded to various of the concerns, reiterating the importance given to the proposal by many PCT Contracting States and potential Contracting States, highlighting again the particular relevance of universities in the ecosystem of innovation and of taking action that could be achieved in the context of the PCT system.

50. The Working Group noted the contents of document PCT/WG/12/3.

(B) OPTIONS FOR IMPLEMENTATION

51. Discussions were based on document PCT/WG/12/21.

52. Most delegations that took the floor agreed that the list of universities from the World Higher Education Database would be appropriate to form the basis of eligibility for any fee reduction that might be implemented. In response to concerns over the requirement for four year courses to be accepted onto the list and the time that would be taken to add a university to the list before it could benefit from fee reductions, it was recalled that the International Association of Universities would add universities to the list outside of the normal review cycle and that it was not a requirement that all degree courses offered by a particular university be a minimum of four years. It was suggested that Member States might be given an option of supplementing the lists.

53. Most delegations indicated that they could agree to the provisions concerning eligibility for fee reductions in the event of multiple applicants, though some delegations indicated that they would prefer a more liberal approach under which entitlement to a reduction could be established if any applicant were eligible; others considered that the provisions were too liberal in the case of researcher co-applicants who were not themselves entitled to fee reductions.

54. The seven year period for the sunset clause was generally considered appropriate in view of the requirements of evaluating the effect of any agreed reduction.

55. In response to a comment from one delegation, the International Bureau observed that the proposed item 8 of the draft revised Schedule of Fees, indicating the time at which eligibility needed to be established for different types of fee reduction, was not specific to the question of fee reductions for universities, but a clarification of what the scope of existing reductions was intended to be. The different provisions that related to the dates of receipt of the request for supplementary international search and of the demand for international preliminary examination reflected small numbers of relatively low level fees. These provisions could be removed, making the relevant date the international filing date, if Member States so wished.

56. Several delegations emphasized that the main concern in relation to the options presented was the fundamental question of whether a fee reduction was appropriate, as discussed under the preceding sub-item of the agenda. Furthermore, the burdens for receiving Offices in checking for eligibility and following up problems might be greater than had been suggested by the International Bureau, leading to extra work and costs rising to more than were covered by the existing transmittal fees. Tracking applications filed by universities in different names and determining eligibility and the relevant fee reduction category might not be easy. The costs of these issues should be better assessed. One delegation suggested that additional sanctions might be appropriate in the case of deliberate abuse, though others considered that the required declarations and the nature of university applicants made this eventuality unlikely.

57. In addition, some delegations raised concerns that reducing fees might lead to the filing of more international applications of low quality. Others indicated that, while it was clear that some patent applications of low quality entered the system, it was not likely that the proposed fee reductions would add to the problem. On the contrary, allowing easier access to a route that included the establishment of a high quality international search report and written opinion would help in improving the quality of applications.

58. In response to concerns raised over the equity of the levels and limits of the proposed fee reductions for different universities, the Delegation of Brazil observed that the suggested ceilings had been introduced to address concerns over the potential total costs, where the effect of a high ceiling would be significantly greater if applied to applications from universities from developed countries, where many universities already filed large numbers of international applications.

59. It was noted that, while implementing and using the system might be relatively simple for applicants and Offices using ePCT, this might not be the case for others. Modifying IT systems and receiving Office processes, including the relationship with financial systems, could be expensive and time-consuming. The possibility of allowing the reductions only for applications filed at the receiving Office of the International Bureau was mentioned, but it was observed that this would break the link with local services and not be user-friendly.

60. The Delegation of Brazil responded to various of the comments, noting that further technical improvements could be considered to address some of the issues, and that many of the features of its proposal that featured in the options presented by the International Bureau had not been part of the original proposal, but had been included to address the concerns of certain Member States. The Delegation agreed that schemes such as the Inventor Assistance Program were useful, but the presentation of that program earlier in the session had recognized that international filing fees remained an issue as well as attorney costs and national capacities. This proposal was an effort to take useful steps in the context of the PCT.

61. Building on a comment by one delegation, the Chair proposed consideration of a refund mechanism, whereby universities would pay the full international filing fee at the time of filing, but be able to claim a refund from the International Bureau of 50 per cent of the fee for up to five international applications per year at the end of the year, irrespective of the country in which the university was based. This gained some interest, noting in particular that it offered equal treatment to all universities and would remove the administrative burdens from receiving Offices. However, many delegations pointed out that it was significantly less beneficial for universities, especially for public universities in some countries where finances were handled by a central body. Universities would be required to pay the full amount of the fee initially and, even if the PCT refund process could be made efficient, there would be difficulties, delays and costs in reallocating the refunded amount to the appropriate parts of the university, meaning that the practical effect of the refund would be greatly reduced. This might be further exacerbated by bank fees, exchange rate issues and accounting problems if the refund was not made in the same accounting year as the original fee payment. In addition, some delegations considered that equal treatment of universities from both developing and developed countries did not automatically also mean fair treatment of all universities. Furthermore, several delegations noted that the Chair's proposal deviated substantially from the original proposal by Brazil and was, in essence, a new proposal on which they could not position themselves without first consulting with capitals.

62. The Working Group recognized that document PCT/WG/12/21 had been a positive step forward that had enabled progress in the consideration of a possible fee reduction to increase access to the PCT by universities. However, the Chair concluded that there was no consensus for either the options set out in document PCT/WG/12/21 or the alternative that had been proposed by the Chair. It would remain open for the Delegation of Brazil or any other member of the Working Group to bring further proposals to the next session.

AGENDA ITEM 11: CRITERIA FOR FEE REDUCTIONS TO CERTAIN APPLICANTS FROM CERTAIN COUNTRIES, NOTABLY DEVELOPING AND LEAST DEVELOPED COUNTRIES

63. Discussions were based on document PCT/WG/12/11.

64. All delegations that took the floor supported the proposal to maintain the criteria under item 5 of the Schedule of Fees and to review the criteria again in five years' time. One delegation noted that in the current review cycle, based on the growth in their economies, four countries had moved upwards in the categories of the PCT Schedule of Fees, two from the level described in item 5(a) and two from the level described in item 5(b), and suggested that the patent system had played some part in these developments.

65. Several delegations commented that the figures presented showed the importance of reductions to natural persons resident in beneficiary countries, observing the reductions in filing volumes in countries where the reductions were no longer available. It was suggested that this demonstrated that targeted fee reductions were effective. A delegation representing a country whose residents had become eligible for the fee reductions in 2015 similarly considered that the reductions had positively stimulated applicant behavior in its case. Another delegation, on the other hand, observed that the variations in effects between different countries showed that filing behaviors were also affected strongly by factors other than fee reductions.

66. One delegation expressed satisfaction that the document explained that the measures previously adopted to clarify the eligibility of applicants for fee reductions had been effective.

67. In response to a query concerning the fact that the United Nations no longer directly published constant 2004 United States dollar values for gross domestic product, the International Bureau indicated that it would prefer not to amend the Schedule of Fees, since the concept had been agreed and adjustment figures continued to be published that made it straightforward to calculate the required values.

68. In relation to a query concerning the term "developing countries" in the title of the document, the International Bureau observed that this term had been used for several years while the Working Group had considered a proposal to review the criteria for fee reductions. While the proposal had been generally aimed at "developing countries", the International Bureau acknowledged that there was no single United Nations definition of a "developing country" and that the criteria for fee reductions under item 5(a) were decided by PCT Member States.

69. The Working Group agreed to recommend to the Assembly that the criteria under Item 5 of the PCT Schedule of Fees be maintained, and that the Assembly should review the criteria again in five years' time.

AGENDA ITEM 12: COORDINATION OF TECHNICAL ASSISTANCE UNDER THE PCT

70. Discussions were based on document PCT/WG/12/22.

71. Delegations that took the floor appreciated the information on technical assistance in the document and acknowledged the contribution of the PCT in terms of technical assistance for developing countries.

72. Several delegations noted that technical assistance stemmed from the original mandate of WIPO, which included the promotion of intellectual property in the world through cooperation among States. Technical Assistance was an important tool to enable use of intellectual property towards development, and to increase the technical capabilities of national and regional patent Offices of PCT Contracting States. In the PCT, technical assistance was the subject of Article 51, which set out the establishment of a Committee for Technical Assistance. In line with Recommendation 1 of the WIPO Development Agenda, technical assistance needed to be development-oriented, demand-driven and transparent, taking into account the priorities and special needs of developing countries. In this regard, WIPO technical assistance programs and projects played a significant role in implementation of the Development Agenda Recommendations, in the development of country plans and in improving the functions of IP Offices.

73. The Working Group noted the contents of document PCT/WG/12/22.

AGENDA ITEM 13: INVENTOR ASSISTANCE PROGRAM

74. Discussions were based on document PCT/WG/12/4 and a presentation on the Inventor Assistance Program (IAP) by the International Bureau².

75. One delegation reported on its national “patent *pro bono*” program, which, like the IAP, provided patent filing and prosecution services free-of-charge and financially supported under-resourced inventors and small businesses in securing patent protection.

76. In reply to a query by the same delegation, the International Bureau confirmed that the IAP, similar to the “patent *pro bono*” program, was aimed at “matching” inventors with local patent attorneys to assist in the drafting and prosecution of the first national filing. If the application later resulted in the filing of a PCT application and national phase entries before the United States Patent Office or the European Patent Office, that local attorney would be “matched” with a *pro bono* patent attorney to assist in the prosecution of the application before those designated Offices. In this context, the representative of a user group emphasized the importance of “pairing” the local patent attorney as early as possible with the *pro bono* attorney, ideally already in the early stages of drafting the application, so that the local attorney could learn and benefit as early as possible from the drafting skills of the *pro bono* attorney.

77. The representative of the Institute of Professional Representatives before the European Patent Office (epi) noted that, to date, members of the epi had assisted in respect of two applications seeking patent protection in Europe. Furthermore, the epi actively encouraged European patent attorneys to participate in the IAP by assisting applicants who sought patent protection in Europe.

78. The Delegation of Colombia stated that Colombia had been one of the first participants in the IAP, which in its view had been extremely successful, resulting in the grant of five patents.

79. In reply to a query about the procedures to be followed by countries wishing to join the IAP, the International Bureau provided further details of the requirements and commitments. There were at present seven requests by Member States under review; the resources available to the International Bureau at present only allowed the implementation of the IAP in two or three countries per year, but additional resources could be made available should the demand for participation increase strongly.

80. The Working Group noted the contents of document PCT/WG/12/4.

² The presentation is available on the WIPO website at:
https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=438415.

AGENDA ITEM 14: TRAINING OF EXAMINERS

(A) SURVEY ON PATENT EXAMINER TRAINING

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

82. Delegations that took the floor supported the proposal for the International Bureau to carry out a one-time survey on policies of IP Offices with regard to e-learning resources, and for the International Bureau to carry out future surveys on patent examiner training carried out or received by IP Offices every two years.

83. Some delegations reported on training activities that their IP Offices had delivered as a donor Office, or benefitted from as a recipient Office. Specifically, one delegation reported on the use of e-learning for in-house training of patent examiners at its IP Office, and was willing to provide further information on its e-learning resources. Another delegation reported on examiner training provided by its Global Intellectual Property Academy. Two delegations gave information on examiner training activities supported by Funds-in-Trust that it had set up with WIPO. A further delegation acknowledged the support that donor Offices had provided for capacity building programs for its substantive patent examiners.

84. The Working Group:

(a) noted the contents of document PCT/WG/12/6;

(b) approved the proposal that the International Bureau should carry out a one-time survey on policies of IP Offices with regard to e-learning resources, as set out in paragraph 23 of document PCT/WG/12/6; and

(c) approved the proposal that the International Bureau should conduct future surveys on patent examiner training biennially, with the next survey taking place in 2021 to report on activities in 2019 and 2020, as set out in paragraph 28 of document PCT/WG/12/6.

(B) COORDINATION OF PATENT EXAMINER TRAINING

85. Discussions were based on document PCT/WG/12/5.

86. The Delegation of the Philippines provided an update on its cooperation with the International Bureau in developing a custom site of the Learning Management System (LMS) at the Intellectual Property Office of the Philippines (IPOP HL). Having successfully installed a local web-based Moodle site and integrated some e-learning content, IPOP HL would be configuring functionalities and plug-ins to develop this content further towards supporting management of competency-based training of its patent examiners. The LMS tool would complement the training infrastructure developed under the Regional Patent Examiner Training (RPET) program organized by IP Australia. The Delegation stated that it would be willing to share its experiences with improving the coordination of patent examiner training to other medium and small IP Offices that were willing to embark on a similar endeavor, and could provide access to its web-based site by such interested Offices on request.

87. Delegations that took the floor appreciated the progress on developing a competency framework for substantive patent examiners and a learning management system. One delegation stated that the framework and learning management system could help coordinate training from different sources, reduce duplication and provide a source that a donor Office could use to determine the needs of an Office when delivering training.

88. The Working Group noted the contents of document PCT/WG/12/5.

AGENDA ITEM 15: SAFEGUARDS IN CASE OF OUTAGES AFFECTING OFFICES

89. Discussions were based on document PCT/WG/12/17.

90. The representative of the European Patent Office, in introducing the document, emphasized the importance of allowing Offices to offer applicants a safeguard in the event of electronic systems being unavailable that could be applied without a heavy procedure with uncertain outcomes. The proposals generally mirrored those in Rule 82*quater*.1. To address various concerns that had been addressed informally to the European Patent Office prior to the session, the representative suggested that the second sentence of its proposed Rule 82*quater*.2(a) could be deleted, if necessary, and the issues addressed elsewhere, such as in the Receiving Office Guidelines. Furthermore, improvements were suggested for clarity of the first sentence, so that (if the second sentence were indeed deleted) the proposed paragraph would read:

“(a) Any national Office or intergovernmental organization may provide that, where a time limit fixed in the Regulations for performing an action before that Office or organization is not met due to the unavailability of any of the permitted electronic means of communication at that Office or organization, delay in meeting that time limit shall be excused, provided that the respective action was performed on the next working day on which the said electronic means of communication were available. The Office or organization concerned shall publish information on any such unavailability including the period of the unavailability, and notify the International Bureau accordingly.”

91. The representative noted that the proposal related only to failures in electronic services and not to paper transmissions. Furthermore, it would allow an Office to trigger the relevant provisions even if only one of several possible services was unavailable, or if an action was permitted to be taken before the International Bureau as well as before a receiving Office. In this respect, it was not always practical for an applicant to change to a different mode or destination for the transmission of a document at short notice. The period for declaring an outage would be left to the judgement of the Office according to its own criteria.

92. Delegations and representatives of user groups that took the floor generally expressed support for the proposal, noting that applicants may sometimes have no effective way of dealing with the consequence of an outage, especially after the Office had closed and technical support staff were unavailable. One delegation noted that its three concerns had been addressed in the introductory remarks from the representative of the European Patent Office. First, the proposal was a “may” provision, which did not impose an obligation on Offices to proceed in a particular manner and allowed each Office to determine what would constitute an outage under its own legal framework. Second, that the sentence containing references to “scheduled maintenance” could be deleted. Third, that introduction had touched on the question of whether an applicant would be able to benefit from this safeguard in the case where a document could have been submitted to either the local receiving Office or to the International Bureau – the delegation did not have strong views on what the answer to this question should be, but it was essential that the answer was clear. Several other delegations confirmed that they considered it important that the provision should not be mandatory for Offices to implement.

93. One delegation noted that it would be essential for the notification and publication of information concerning outages to be prompt in order to avoid loss of rights by applicants in relation to events occurring shortly before national phase entry.

94. The Chair confirmed his understanding that the proposed new Rule 82*quater*.2 made implementation optional for Offices, that it permitted Offices to offer relief in cases where only one of several electronic means of communication was unavailable and where a document was permitted to be furnished either to the receiving Office or to the International Bureau.

Furthermore, Offices would determine, using their own criteria, whether a relevant outage had been considered to take place.

95. The Working Group approved proposed new Rule 82*quater*.2 of the Regulations, as set out in the Annex to document PCT/WG/12/17 and modified under paragraph 90, above, for submission to the Assembly for consideration at its next session in September-October 2019.

AGENDA ITEM 16: PROPOSAL TO PROVIDE FOR CORRECTION OR ADDITION OF INDICATIONS UNDER RULE 4.11

96. Discussions were based on document PCT/WG/12/8.

97. All delegations that took the floor supported proposed new Rule 26*quater* to provide a legal basis for the correction or addition of indications provided for in Rule 4.11(a)(i) and (ii).

98. One delegation provided further modifications to proposed new Section 419*bis* of the Administrative Instructions to deal with the processing of corrections or additions under the Rule 26*quater*, which the International Bureau would take into account when consulting on the implementation of the provisions by way of a PCT Circular.

99. The Working Group approved the proposed addition of Rule 26*quater* of the Regulations, as set out in Annex I to document PCT/WG/12/8, with a view to its submission to the Assembly for consideration at its next session in September-October 2019.

AGENDA ITEM 17: ERRONEOUSLY FILED ELEMENTS AND PARTS OF THE INTERNATIONAL APPLICATION

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

101. One delegation stated that it continued to be of the view that the incorporation by reference of correct elements or parts was within the spirit and intent of the current provisions governing the incorporation by reference of missing parts. While this delegation believed that the proposed new Rules were complex and could be avoided by an amendment to Rule 4.18 clarifying the scope of the current provisions dealing with incorporation by reference, it could support the proposals, provided certain issues were satisfactorily addressed.

102. All other delegations and representatives of user groups that took the floor supported the proposals in general, subject to further clarifications with regard to a number of drafting issues. Many felt that the proposals, while complex, provided a balanced solution, with a clear distinction between, on the one hand, provisions applicable to “truly” missing parts and, on the other, provisions applicable to erroneously filed elements and parts. A number of delegations, while supporting the proposals in principle, indicated that they would need to submit notifications of incompatibility of the new provisions with the applicable national law, both as receiving Offices and designated or elected Offices.

103. In response to a query, the International Bureau clarified that, in a case where (i) a correct element had been incorporated by reference, (ii) an erroneous part had been deleted in an Article 34 amendment, and (iii) the international application had entered the national phase before a designated Office that had submitted a notification of incompatibility, the designated Office would treat the application, with the correct element or part included in the application, in accordance with proposed new Rule 20.5*bis*(b) or (c), as if the international filing date had been accorded on, or corrected to, the date on which the correct element or part had been received by the receiving Office. This would also be the case where no Article 34 amendment had been made.

104. In response to a query, the International Bureau clarified that any erroneously filed element or part removed from the international application under Rule 20.5*bis*(b) or (c) would nevertheless remain in the file of the international application held by the International Bureau.

105. In response to concerns raised by several delegations as to the ability of the receiving Office to establish whether an element or a part of the application had been filed erroneously, the International Bureau clarified that there was no expectation that the receiving Office would actively check for such erroneously filed elements or parts; the only obligation on the receiving Office was to invite the applicant to furnish the required correction should it, in the normal process of determining whether papers purporting to be an international application fulfilled the requirements of Article 11(1), notice what appeared to be an erroneously filed element or part.

106. In response to concerns raised by a number of representatives of user groups as to the impact of notifications of incompatibility submitted by Offices in their capacities as both receiving Offices and designated Offices, the International Bureau clarified that:

- (a) as far as receiving Offices were concerned, it had been proposed to ensure, by way of an Understanding to be adopted by the Assembly, that all applications which had been filed with a receiving Office which had submitted such a notification would be forwarded to the International Bureau as a receiving Office under Rule 19.4(a)(iii), which would apply the provisions concerning the incorporation by reference of correct elements or parts; and
- (b) as far as notifications of incompatibility by designated Offices were concerned, the fact that such notifications had been submitted would be widely publicized by the International Bureau so as to ensure that applicants were fully aware of which designated Offices would accept the incorporation by reference of correct elements or parts for national phase processing and which would not.

107. One delegation stated that it had specific concerns with regard to a number of proposed new Rules or proposed amendments of existing Rules; in particular:

- (a) The delegation questioned whether, where a correct element (say, a correct set of claims) had been incorporated by reference and the erroneously filed element (say, an erroneously filed set of claims) remained in the application, Article 15 permitted an International Searching Authority to carry out a search only on the basis of the correct element (the correct set of claims), without taking into account the erroneously filed element (the erroneously filed set of claims), noting that Article 15(3) provided that the international search had to be made “on the basis of the claims, with due regard to the description and the drawings, if any” and that none of the exceptions provided for under Article 17(2)(a) and (b), allowing for no search report to be established, appeared applicable. Such a case was not comparable to the case of a rectification of an obvious mistake (say, in the claims), which did not need to be taken into account by the International Searching Authority if it had been authorized by it or notified to it only after it had begun to draw up the search report; in that case, all of the claims (albeit containing an obvious mistake) still formed the basis of the search.
- (b) The delegation further noted that clear guidance would be required, in the Administrative Instructions or the Receiving Office Guidelines, on the processing of applications in respect of which several errors were to be corrected in different ways.
- (c) Finally, the delegation suggested to consider further amending proposed new Rule 20.5*bis* so as to provide for the automatic removal from the application of the correct elements or part for the purposes of national phase processing before an Office which had submitted a notification of incompatibility of the provisions governing the incorporation by reference of correct elements or parts, rather than, as has been suggested in a Comment

on Rule 20.5*bis*(d) set out in the Annex to document PCT/WG/12/9, requiring the applicant to amend the application so as to remove the correct elements or part from the application. Similarly, it would appear preferable to consider further amending Rule 20.8(a-*ter*) so as to provide that any request for the incorporation by reference of a correct element or part furnished to a receiving Office which had submitted a notification of incompatibility would be considered to be a request to transmit the application to the International Bureau as receiving Office under Rule 19.4, rather than requiring the applicant to make a separate request to the receiving Office to that effect.

108. Following informal consultations, discussions continued on the basis of additional proposals for amendments to the PCT Regulations prepared by the International Bureau, taking into account the discussions by the Working Group up to that point.

109. The Working Group approved:

(a) the proposed amendments to Rules 4.18, 12.1*bis* and 20.5(a) and (b), proposed new Rule 20.5*bis*, the proposed amendments to Rules 20.6(c), 20.7, 20.8, 55 and 76 as set out in Annex I to document PCT/WG/12/9;

(b) proposed new Rule 40*bis* and the proposed amendments to Rules 48.2(b), 51*bis*.1(a) and (e), and 82*ter*.1 as set out in the Annex to this Summary by the Chair;

with a view to their submission to the Assembly for consideration at its next session in September-October 2019.

110. With regard to the issue raised by one delegation as set out in paragraph 107(a), above, the Working Group agreed to recommend that the Assembly adopt an Understanding to the effect that "Article 15 should be interpreted such that the International Searching Authority, in the case of incorporation by reference of a correct element or part under Rule 20*bis*.5(d), would only be required to carry out the international search on the basis of international application ("the claims, with due regard to the description and the drawings, if any") including the correct element or part incorporated by reference, and did not need to take into account any erroneously filed element or part which, pursuant to Rule 20.5*bis*(d), remained in the application. Likewise that Article 15 should be interpreted as allowing the search to be based on only the incorrect claims if the fee under new Rule 40*bis* had not been paid".

AGENDA ITEM 18: PROPOSAL WITH RESPECT TO THE AVAILABILITY OF THE FILE HELD BY THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

111. Discussions were based on document PCT/WG/12/12.

112. Delegations that took the floor supported the proposal in principle, highlighting the importance of transparency of processing to applicants, elected Offices and third parties alike. Delegations also agreed that International Authorities should undertake the further work discussed in paragraph 14 of the document.

113. Some delegations representing countries whose IP Offices acted as International Preliminary Examining Authorities indicated that the proposal would require changes to their IT systems and electronic transmission means in order to send the additional documents to the International Bureau, which would take time to implement if manual work and postage of paper documents was to be avoided. It would be necessary to give careful consideration to how the changes should be brought into force.

114. In response to a suggestion from the representative of the European Patent Office to provide hyperlinks to the additional documents held in the European Patent Register, the International Bureau indicated that the link between WIPO CASE and One Portal Dossier could allow retrieval of the documents to make them available through PATENTSCOPE. This would be a useful arrangement, but further work would be needed to ensure that all issues were addressed effectively so as to obtain the relevant document from all International Preliminary Examining Authorities.

115. In response to a question from one delegation and two representatives of user groups, the International Bureau clarified that the proposal would not require applicants to provide translations of the additional documents that the International Preliminary Examining Authority would make available under the proposal.

116. The Working Group:

(a) approved the proposed amendments to Rules 71 and 94 of the Regulations, as set out in Annex I to document PCT/WG/12/12, with a view to their submission to the Assembly for consideration at its next session in September/October 2019;

(b) noted that the International Bureau would consult on further modifications to the proposed Administrative Instructions, so as to make transmission of the relevant documents initially optional for International Authorities, with the intention of making the provisions mandatory after a period sufficient to allow all International Preliminary Examining Authorities to make the required technical changes needed for their transmission; and

(c) invited the Meeting of International Authorities to undertake the further work outlined in paragraph 14 of document PCT/WG/12/12.

AGENDA ITEM 19: APPOINTMENT AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY (ISA/IPEA) AND DECLARATION BY RECEIVING OFFICES AS COMPETENT ISA/IPEA

117. Discussions were based on document PCT/WG/12/18.

118. One delegation, speaking on behalf of a regional group, expressed the hope that the Working Group could reach a positive decision on the proposal soon, and indicated its willingness to support a consensus that might emerge.

119. Delegations indicated that implementation of the proposal would require amendment to the Regulations, notably Rule 35, which provided for the receiving Office to specify one or more competent International Searching Authorities for applications filed with it. It was also necessary to revise the agreements International Authorities had with the International Bureau under Articles 16(3)(b) and 32(3). Authorities might also need to renegotiate bilateral agreements with receiving Offices that had specified them as competent. One delegation pointed out that an applicant could request a supplementary international search if the applicant wished to have the application searched by an Authority that was not a competent Authority for the receiving Office with which the application had been filed.

120. Delegations representing countries with IP Offices that acted as International Authorities highlighted technical and practical challenges with implementing the proposal at their Offices, such as the language knowledge of examiners, predictability and management of workload to meet time limits under the Regulations, changes to IT systems, setting up infrastructure for information exchange with new receiving Offices, and acting in a different time zone from the receiving Office. Some of these delegations proposed that the Meeting of International

Authorities could consider how to tackle these challenges. One of these delegations suggested that a pilot project could study the practicalities of the proposal.

121. Several delegations highlighted the impact of the proposal on receiving Offices. Widening the choice of International Authority could increase processing costs that might lead to higher transmittal fees. Moreover, the initial proposal to limit a free choice of the International Authority to international applications filed with the International Bureau as receiving Office could significantly increase workload for the International Bureau.

122. Several delegations emphasized the need to consider how the proposals would benefit applicants, and to consult with users to ascertain whether they wished to have more choice of competent International Authorities. One delegation representing a country with an IP Office that acted as an International Authority underlined the benefits of the service that the Authority provided for its local stakeholders, including assistance to attorneys and awareness raising activities.

123. One delegation pointed out that competition on price between International Authorities could be detrimental to the quality of international work products. In response, the Delegation of India referred to the requirements under Rules 36 and 63 for an Office to be appointed as an International Authority, including having a quality management system in place, which the Committee for Technical Cooperation would consider when providing its advice to the Assembly on appointment as an International Searching and Preliminary Examining Authority.

124. Delegations representing Contracting States of the European Patent Convention (EPC) stated that their IP Offices had obligations under the EPC Protocol on Centralisation. Revision of the Protocol would require a diplomatic conference of EPC Contracting States.

125. Some delegations stated opposition to giving an advantage to applicants that filed international applications with the International Bureau in its capacity as a receiving Office should the free choice of International Authority be limited to applications filed with the International Bureau, as suggested in the proposal by India. One delegation further referred to the principle that each Contracting State should have the right to specify the competent ISAs for its nationals and residents, as recognized in Rule 35.3. This delegation stated that the PCT Union had accepted this principle when the Assembly had adopted the provisions to enable the International Bureau to act as a receiving Office in 1993, and that it was its understanding that the principle still applied today.

126. Several representatives of user groups supported the general idea of the proposal to provide the applicant with more choice of International Authorities, noting that a free choice of an Authority would be fairer to applicants than a choice that depended on the receiving Office selecting the competent Authority. However, those representatives of user groups also acknowledged the legal constraints and technical difficulties of implementing the proposal, and the need to guarantee high quality international searches under a system with more applicant choice. One of these representatives acknowledged that the pilot project suggested by one delegation could offer a way to transition to a new system.

127. The Working Group invited the Delegation of India to prepare a document for discussion at the twenty-seventh session of the Meeting of International Authorities, taking into account the comments made by delegations at the present session of the Working Group and any further consultations on the proposal with delegations, notably those representing IP Offices which acted as International Searching and Preliminary Examining Authorities.

AGENDA ITEM 20: SEQUENCE LISTINGS

(A) SEQUENCE LISTINGS TASK FORCE: STATUS REPORT

128. Discussions were based on document PCT/WG/12/14.

129. The representative of the European Patent Office, in introducing the document, outlined the progress that had been made in preparation for the start of use of WIPO Standard ST.26 on January 1, 2022, noting especially the proof of concept version of *WIPO Sequence* that was available for comment and that *WIPO Sequence Validator* would be ready for testing by Offices soon. Various issues were under consideration by the task force with a view to a revision of the Standard to be considered by the Committee for WIPO Standards in July 2019.

130. One delegation welcomed the work done and clarified that the tools needed to ensure that certain machine-detectable defects would be identified reliably and that other potential issues requiring human intervention be brought to the attention of an expert for consideration.

131. The Working Group noted the contents of document PCT/WG/12/14.

(B) IMPLEMENTATION OF WIPO STANDARD ST.26

132. Discussions were based on document PCT/WG/12/13.

133. Several delegations considered that the draft proposals set out in the document represented a good start for discussions. While there were many detailed issues to consider, delegations indicated that they would focus on the main points and provide more detailed feedback to the International Bureau after the session.

134. In response to a question concerning the compatibility of proposed Rule 20.1(c) with Rule 12.1(a), the International Bureau pointed out that it was not proposed to amend Rule 20.1(c); rather, that Rule remained unchanged and had served as the basis for exempting the sequence listing from the language requirements under Article 11(1) and Rule 12.1(a) for many years.

135. One delegation suggested that the provisions on entry into force should be further considered, allowing the possibility of the use of the new standard for any sequence listings newly submitted on or after January 1, 2022, even if this was in respect of an international application to which the previous standard would otherwise apply.

136. The Delegation of Canada indicated that the fact that a sequence listing file could not validly contain non-Latin or accented characters, preventing the effective use of languages other than English, had raised, in Canada, a constitutional issue over the equal treatment of languages. The International Bureau observed that the Working Group was not the forum for discussion of the Standard *per se*. That needed to be addressed in the Committee on WIPO Standards (CWS), where the Standard had been adopted, following extensive discussions over several years of work, including on the question of the limited character sets. The Working Group was only able to recommend whether to continue to implement the Standard and, if so, how listings containing defects according to the Standard should be handled and whether it was possible to identify technical solutions to mitigate the problems. The delegation indicated that it would raise the issue in the forthcoming session of the CWS and would look for options, such as allowing the non-compliant sequence listing to proceed for the purpose of the main processing, but requesting a translated version for the benefit of search databases.

137. Another delegation indicated that it also had concerns with regard to the proposed mandatory requirement for designated Offices to accept English for any free text contained in a sequence listing.

138. One delegation raised concerns at the prospect of the return of “mixed-mode filings” where a paper application body was accompanied by a sequence listing in electronic form. The abolition of this possibility had been a significant achievement and it was not desirable to have it return. The International Bureau observed that, since it was not possible to create an ST.26 sequence listing in paper format, a return to mixed-mode filings appeared inevitable, unless applicants were to be explicitly precluded from using paper in the case of applications containing sequence listings. However, mixed-mode filings were clearly not to be encouraged and it was to be hoped that electronic systems were now sufficiently attractive and well used that no applicant would willingly choose to use a mixed-mode approach in any normal circumstances.

139. The International Bureau observed that it was essential that the discussions of issues in different bodies were effectively coordinated and that legal and technical discussions did not take different directions. It was important that new Rules and Administrative Instructions be ready for approval in 2020 if the target implementation date of January 1, 2022 was to be met. To this end, it was likely that the International Bureau would both issue PCT Circulars concerning the proposals, and increase its efforts to involve all interested parties effectively in consultations across the various relevant fora.

140. The Working Group invited the International Bureau to continue its consultations on the issues raised in document PCT/WG/12/13.

AGENDA ITEM 21: PCT MINIMUM DOCUMENTATION: STATUS REPORT

141. Discussions were based on document PCT/WG/12/16.

142. The representative of the European Patent Office, as leader of the PCT Minimum Documentation Task Force, informed the Working Group that discussions on Objective A, namely the revision of the inventory of patent collections belonging to the PCT minimum documentation and the coverage of utility model collections had been concluded, and the updated inventory was being readied for publication, in the coming months, by the International Bureau. Furthermore, significant progress had been made on Objectives B and C relating to the inclusion of patent collections and technical requirements for making them available. The work aimed to ensure the inclusion of the collections of all International Authorities, irrespective of their official languages. Other Offices' patent collections could also be included if they met the criteria. A grandfather clause might be considered while identifying and filling gaps in digital collections. The question of inclusion of utility models in addition to the French utility models was another key issue. The next stages of work would aim to provide documents for discussion by the Meeting of International Authorities in 2020.

143. The Delegation of the United States of America, as the leader of the Task Force Objective D, observed that the face-to-face discussions amongst the working level IT experts and patent documentation experts had made concrete progress on understanding and refocusing on the goals, particularly in respect of assessing document content rather than considering accessibility of non-patent literature prior art.

144. All delegations taking the floor underlined the importance of the work of the PCT Minimum Documentation Task Force. One delegation and a representative of a user group offered their support for the inclusion of utility models in the PCT minimum documentation.

145. The Working Group noted the contents of document PCT/WG/12/16.

AGENDA ITEM 22: PCT COLLABORATIVE SEARCH AND EXAMINATION: STATUS REPORT

146. Discussions were based on document PCT/WG/12/15.

147. The representative of the European Patent Office informed the Working Group that the IP5 Offices had successfully launched the operational phase of the PCT Collaborative Search and Examination (CS&E) pilot on July 1, 2018. The representative observed that the first year of the planned three years of operation of the pilot had passed successfully, with almost 250 applications being accepted, initially in English only and later, with the pilot having been extended, also in Chinese, German and Japanese. A further extension to accept applications in Korean was expected in the second year of operation, during which the acceptance of a further 250 applications would meet the initial objective of a total of 500 applications to be accepted into the pilot. The third year of the pilot would be dedicated to evaluation and assessment.

148. In response to a request by one representative of a user group for detailed information on the results gained from the applications already processed under the pilot, the representative of the European Patent Office noted that it was too early to assess the impact regarding workload and benefits, as applications were yet to enter into the national and/or regional phases before participating Offices.

149. Delegations representing Offices participating in the pilot confirmed their full continued support for the pilot. A great deal had already been learnt during the operational phase of the pilot, including in relation to the preparation and use of peer review documents, timeliness of peer reviews and workload information.

150. Several representatives of user groups welcomed the progress of the CS&E pilot project and emphasized the high level of interest amongst users in the pilot, notably with regard to the expected quality of CS&E reports, the associated costs and the resultant benefits in national phase processing of applications. In response to a comment from a representative of a user group that applicants should be able to identify the extent to which use had been made by the main examiner of the peer contributions, the representative of the European Patent Office pointed out that the peer contributions were made available to applicants in ePCT and published on PATENTSCOPE to permit such evaluation.

151. The Working Group noted the contents of document PCT/WG/12/15.

AGENDA ITEM 23: OTHER MATTERS

152. 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 September/October 2019 and September/October 2020 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.

153. The International Bureau indicated that the thirteenth session of the Working Group was tentatively scheduled to be held in Geneva in May/June 2020.

AGENDA ITEM 24: SUMMARY BY THE CHAIR

154. 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 25: CLOSING OF THE SESSION

155. The Chair closed the session on June 14, 2019.

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS
REFERRED TO IN PARAGRAPH 109(a)

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Rule 40bis

Additional Fees in Case of Missing Parts or Correct Elements and Parts
Included in the International Application or Considered to Have Been Contained in the
International Application

40bis.1 Invitation to Pay Additional Fees

The International Searching Authority may invite the applicant to pay additional fees
where the fact that a missing part or a correct element or part:

(i) is included in the international application under Rule 20.5(c) or Rule 20.5bis(c),
respectively; or

(ii) is considered, under Rule 20.5(d) or Rule 20.5bis(d), respectively, to have been
contained in the international application on the date on which one or more
elements referred to in Article 11(1)(iii) were first received by the receiving Office;

is notified to that Authority only after it has begun to draw up the international search report.

The invitation shall invite the applicant to pay the additional fees within one month from the
date of the invitation and indicate the amount of those fees to be paid. The amount of the
additional fees shall be determined by the International Searching Authority but shall not
exceed the search fee; the additional fees shall be payable directly to that Authority.

Provided any such additional fees have been paid within the prescribed time limit, the
International Searching Authority shall establish the international search report on the
international application including any such missing part or any such correct element or part.

Rule 48
International Publication

48.1 [No Change]

48.2 *Contents*

(a) [No change]

(b) Subject to paragraph (c), the front page shall include:

(i) to (iv) [No change]

(v) where the international filing date has been accorded by the receiving Office under Rule 20.3(b)(ii), ~~or~~ 20.5(d) or 20.5bis(d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part, an indication to that effect, together with an indication as to whether the applicant, for the purposes of Rule 20.6(a)(ii), relied on compliance with Rule 17.1(a), (b) or (b-bis) in relation to the priority document or on a separately submitted copy of the earlier application concerned;

(vi) [No change]

(vii) where applicable, an indication that the published international application contains information concerning a request under Rule 26bis.3 for restoration of the right of priority and the decision of the receiving Office upon such request;

(viii) where applicable, an indication that an erroneously filed element or part has been removed from the international application in accordance with Rule 20.5bis(b) or (c).

(c) to (n) [No change]

48.3 to 48.6 [No Change]

Rule 51bis

Certain National Requirements Allowed under Article 27

51bis.1 Certain National Requirements Allowed

(a) Subject to Rule 51bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

(i) to (vi) [No change]

(vii) any missing indication required under Rule 4.5(a)(ii) and (iii) in respect of any applicant for the designated State:

(viii) in the cases referred to in Rule 82ter.1, a translation of any erroneously filed element or part removed from the international application in accordance with Rule 20.5bis(b) or (c).

(b) to (d) [No change]

(e) The national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish a translation of the priority document, provided that such a translation may only be required:

(i) [No change]

(ii) where the international filing date has been accorded by the receiving Office under Rule 20.3(b)(ii), ~~or~~ 20.5(d) or 20.5bis(d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part, for the purposes of determining under Rule 82ter.1(b) whether that element or part is completely contained in the priority document concerned, in which case the national law applicable by the designated Office may also require the applicant to furnish, in the case of a part of the description, claims or drawings, an indication as to where that part is contained in the translation of the priority document.

[Rule 51bis, continued]

51bis.2 and 51bis.3 [No Change]

Rule 82ter
Rectification of Errors Made
by the Receiving Office or by the International Bureau

82ter.1 Errors Concerning the International Filing Date and the Priority Claim

(a) [No change]

(b) Where the international filing date has been accorded by the receiving Office under Rule 20.3(b)(ii), ~~or~~ 20.5(d) or 20.5bis(d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part but the designated or elected Office finds that:

- (i) the applicant has not complied with Rule 17.1(a), (b) or (b-bis) in relation to the priority document;
- (ii) a requirement under Rule 4.18, 20.6(a)(i) or 51bis.1(e)(ii) has not been complied with; or
- (iii) the element or part is not completely contained in the priority document concerned;

the designated or elected Office may, subject to paragraph (c), treat the international application as if the international filing date had been accorded under Rule 20.3(b)(i), ~~or~~ 20.5(b) or 20.5bis(b), or corrected under Rule 20.5(c) or 20.5bis(c), as applicable, provided that Rule 17.1(c) shall apply *mutatis mutandis*.

(c) The designated or elected Office shall not treat the international application under paragraph (b) as if the international filing date had been accorded under Rule 20.3(b)(i), ~~or~~ 20.5(b) or 20.5bis(b), or corrected under Rule 20.5(c) or 20.5bis(c), without giving the applicant the opportunity to make observations on the intended treatment, or to make a request under paragraph (d), within a time limit which shall be reasonable under the circumstances.

[Rule 82ter.1, continued]

(d) Where the designated or elected Office, in accordance with paragraph (c), has notified the applicant that it intends to treat the international application as if the international filing date had been corrected under Rule 20.5(c) [or 20.5bis\(c\)](#), the applicant may, in a notice submitted to that Office within the time limit referred to in paragraph (c), request that the missing part concerned, [or the correct element or part concerned](#), be disregarded for the purposes of national processing before that Office, in which case that [missing](#) part, [or that correct element or part](#), shall be considered not to have been furnished and that Office shall not treat the international application as if the international filing date had been corrected.

[End of Annex and of document]