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SUMMARY

The Working Group agreed to forward two sets of proposed amendments to the PCT Regulations to the PCT Assembly for approval at its session in September–October 2013:

- PCT Rules 66 and 70 would be amended to require International Preliminary Examining Authorities to conduct “**top up searches**” as part of international preliminary examination. The top up search would seek to identify relevant documents (especially, but not limited to, earlier patent publications) which had become available to search databases since the international search report was established.
- PCT Rule 44^{TER} would be deleted and PCT Rule 94 amended to make **written opinions** of the International Searching Authority (ISA) **available** to the public via PATENTSCOPE **from the international publication date**.

The following proposals to amend the PCT Regulations or to modify the Receiving Office Guidelines or International Search and Preliminary Examination Guidelines were considered by the Working Group, but will require further discussions at future meetings:

- to require a response in the national phase to negative comments in an international preliminary report on patentability;
- to integrate the Patent Prosecution Highway into the PCT;
- to require ISAs to make available search strategies, documenting the process of the international search;
- to clarify procedures concerning incorporation by reference of missing parts in certain cases; and
- to change the time limits for establishing international search reports.

The Working Group discussed various general papers concerning matters which may be the subject of future proposals:

- PCT KAIZEN from Japan, advocating a holistic approach to PCT,
- EXPANDED PCT 20/20 PROPOSALS, covering a variety of subjects identified by the United Kingdom and the United States of America and
- a proposal by Brazil to investigate whether national Offices could require applicants to use Chapter II international preliminary examination in certain circumstances.



The Working Group also discussed papers on PCT Fee Reductions, Coordination of Technical Assistance under the PCT and Appointment of International Authorities and invited the International Bureau to make further investigations and possible proposals in these areas for future discussion.

In addition, reports concerning the following matters were noted:

- PCT Statistics (see the [PCT Yearly Review 2013](#));
- [ePCT](#);
- the Meeting of International Authorities under the PCT;
- national practices relating to restoration of the right of priority;
- supplementary international search;
- the pilot project on collaborative search and examination;
- third party observations;
- the development of a new PCT sequence listing standard; and
- updating the patents part of the PCT minimum.

The Summary by the Chair is available from the same page as the working documents on the WIPO website at: www.wipo.int/meetings/en/details.jsp?meeting_code=pct/wg/6



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REPORT

The meeting started at 10:20 on May 21, 2013.

An estimated 50 % of the delegations were present. Many of the delegations of the developing and least developed countries were missing. This was presumably due to the fact that these countries are usually represented by their permanent missions in Geneva and there was a UN meeting concerning humanitarian issues taking place at the same time in Geneva.

The papers of the meeting are publicly available in the internet on the WIPO page www.wipo.int/meetings/en/details.jsp?meeting_id=28622.

AGENDA ITEM 1 OPENING OF THE SESSION

The meeting started with a welcome note by the President of WIPO, Mr. Francis Gurry. **Brunei Darussalam** and **Saudi Arabia** were welcomed as new members; **Egypt** was welcomed as a new International Authority.

The welcome note was focused on three issues: Fees, statistics and ePCT.

As to fees, it was pointed out that the PCT is crucial to the funding of WIPO. Thus, fee reductions are a sensitive issue both politically and financially. On the table is a proposal for extending fee reductions to a certain class of applicants (SMEs, universities). The overall impact of this proposal on the applicants will be less than 1%. The major element in the costs for international patenting is lawyer and attorney fees. The second major element is translation, office fees only ranking third place. The office fees at the national or regional level are considerably more expensive. Fee reductions for specific countries are an equally important and sensitive subject.

Some numbers from the PCT statistics were given (see Agenda Item 4). Of 500.000 national phase entries, 4,500 made use of the bilateral PCT PPH agreements (see Agenda Item 10). Further, 55 % of all applications coming as foreign applications into the various countries enter through the PCT system.

Finally ePCT was pointed out as an important development of PCT administration. Currently, there are more than 6000 users. It is considered a very useful tool for minimizing processing delays and errors in the communication with both users and offices (see Agenda Item 5).

AGENDA ITEM 2 ELECTION OF A CHAIR AND TWO VICE_CHAIRS

Belgium suggested that the meeting is chaired by **Australia**. **Brazil** seconded the proposal.

Mr. **Victor Portelli** of Australia, General Manager, Patents and Plant Breeder's Rights Group, IP Australia, was elected as **Chair**. Vice-Chairs were not elected. The Chair provided a short introduction of himself.

AGENDA ITEM 3 ADOPTION OF THE AGENDA (PCT/WG/6/1 REV.)

The Agenda was accepted.



The **Secretariat** added some remarks to Agenda Item 27 (SUMMARY BY THE CHAIR) with regard to the reporting of the meeting. In the last meeting, a full (verbatim) transcription was supplied and translated into French. Given that it is intended to switch to the six-language regime of the UN within the next few sessions, this approach should be abandoned. It is suggested instead that, in addition to the summary by the Chair, a full report and a summary report are prepared by the Secretariat, which are then translated. Further, an informal document is prepared in English containing a verbatim transcript of the meeting, which will not be translated. It is suggested to apply this scheme already at this meeting.

The meeting hours will be from 10 am to 1 pm and from 3 pm to 6 pm; coffee breaks will be handled flexibly. Announcement is made of a presentation concerning an introduction to the PLT during the lunch break on May 21.

The **Chair** then made an invitation for opening statements. No opening statements were made.

AGENDA ITEM 4 PCT STATISTICS

The **International Bureau** provided a summary of the PCT 2013 yearly review. Copies are available on WIPO's website (www.wipo.int/ipstats/en/statistics/pct/). Some key figures from the summary:

- The PCT International Filings hit a record year with a 6.6 % increase compared to 2011 and a total of approx. 195,000 applications.
- The growth rate has been declining recently and, most likely, will continue to do so. A growth rate of about 3 to 4 % is currently being forecast. **Japan, Korea, China** and the **Netherlands** had the highest growth rates (above 10%) in 2012.
- The top three fields, in which PCT filings were made, were all in the electrical engineering sector, namely Electrical Machinery, Digital Communications and Computer Technology. Medical Technology was another big field.
- Less than 10 % of the filings are made on paper.
- Half of the filings are made in **English**, a fifth in **Japanese**, less than 10 % in **German** and **Chinese**.
- 55 % of foreign filings worldwide are national phase entries of a PCT application.
- Most national phase entries are made from applicants residing in the **United States of America** (approx. 145,000), in Japan (approx 96,000), in Germany (approx 58,000), China takes (13k) 8th place with being the applicant's seat in approx. 13,000 national phase entries.
- The top offices in which national phase entries are filed are the USPTO (approx. 98,000), the EPO (approx. 80,000), China (approx. 64,000), JP (approx. 52,000), Korea (approx. 31,000), and India (approx. 28,000).
- The average time for completion of the International Search Report (ISR) is 16.2 months from the priority date, 69 % of the ISRs are received within 16 months.
- In 2012, 46 requests for Supplementary Search were made, 21 to the EPO and 16 to ROSPATENT, the Russian patent office.



- 2012 is the first year since the 30+ months term became independent of a Chapter II request with an increase in requests for International Preliminary Examination.
- There were 4.600 PPH requests for PCT applications in 2012, more than half of the PPH requests were made before the USPTO.

El Salvador requested that the PCT statistics be provided also in Spanish.

AGENDA ITEM 5 EPCT (PCT/WG/6/2)

The paper was summarized by the **International Bureau**.

The ePCT system aims to provide the following services and properties:

- a single platform for filing and managing PCT applications,
- a distributed system which does not need to reside at WIPO,
- real-time interaction with offices, providing real electronic data and not their paper-equivalent transcription and elimination of surface-mail transmissions, thus improving timeliness in the restrained time regime of the international phase,
- a high level of security as application data are handled prior to publishing,
- the same service levels for all member states,
- error reduction by providing immediate feedback of any action performed with the ePCT system,
- increasing efficiencies for Offices and applicants,
- providing better information for applicants, offices and third parties.

This is achieved in that the ePCT system offers the following capabilities to the **applicants**:

- documents may be searched, viewed, and uploaded to the International Bureau,
- bibliographic data may be inspected,
- a timeline with due dates and a file history is presented,
- processing requirements (“actions”) may be directly specified, e.g. change of address or ownership, online request for international examination,
- custom notifications by digitally signed emails,
- patent portfolios can be managed,
- control and assignment of access restrictions to the files to be able to work collaboratively on a single file, even allowing to define sub-authorisations,
- allowing validations and feedback (e.g. detect color in drawings),
- preview on how the submitted documents will be published,
- collaborative process, several people may work on one filing.

Further, ePCT is designed as a tool for the **offices** by



- allowing role-based access by RO, ISA, IPEA and allowing only the competent office to see the application,
- allowing searches (at the moment there only simple searches are possible due to data volume that needs to be accessed by offices),
- allowing the communication between offices and the transmission of documents,
- allowing the triggering of “actions” directly in the ePCT system,
- providing forms that are prefilled with bibliographic data (currently in a preliminary stage),
- allowing web filing (pilot phase),
- providing a web-based system directly from IB data base (no expensive IT infrastructure needed for the offices),

The next improvements of the ePCT system will be directed to

- providing an address book,
- going live for all users,
- allowing a direct data exchange with ROs hosting “Annex F” servers,
- allowing filing with other ROs via IB hosting,
- improving the bi-directionality between the offices and the IB with regard to notifications, the aim being to provide full RO services,
- providing more languages (currently English only),
- improving web services by automated access to the functions,
- providing directly usable data,
- centralized fee payments.

It was noted that the system will only work if the majority of offices is fully accessible. This will indeed be vital for the system to be truly useful. Access to the ePCT system is currently possible via <http://pct.wipo.int/ePCT> or <http://pctdemo.wipo.int/ePCT>.

Korea commented that the ePCT system is intended to be used by applicants all over the world and thus urges provision of as many languages as possible, as quickly as possible.

Australia regarded itself as a top-user of ePCT and looks forward to further development. It would welcome information on which offices currently use ePCT.

El Salvador welcomed the initiative as RO of a developing country and would like reference to the collaborating offices in order to access their experience. It was pointed out that the electronic capabilities of ROs are important and it is questioned as to what type of capacity is necessary.

The **International Bureau** responded that the current pilot is a fully working system. It is a pilot only in the sense that languages are not yet fully available and there is not yet total confidence that the current level of services is appropriate for day-to-day work, even though the down-time is down to only minutes in recent months. There are a number of pilot offices also in developing countries, at least one using the system on a day-to-day basis. All that is needed for a RO to use ePCT is a web browser, an internet connection and a scanner. All the “difficult” software is hosted by WIPO.



Currently, documents are received via ePCT by **Australia, Brazil, Canada, China, Denmark, Germany, the European Patent Office, Algeria, Ukraine, Azerbaijan** etc. as participating countries.

Israel tested ePCT and started to use it. An explanation of features from the view of International Authority was given. Israel strongly supports the ePCT.

Japan asked to proceed with the development and to focus on compatibility with existing systems e.g. with regard to the character base. Japan wants to use the system without change to existing systems.

China is looking forward to a full implementation and continues to study the effects on offices and users. It is hoped that a Chinese interface will be available soon.

The **USA** mentioned the Global Dossier which is part of the 20/20 of the USA and the United Kingdom and to Japan's Kaizen paper. There are concerns regarding the collection of fees, as an improper withdrawal may result if payments are not transferred in time. The USPTO uses ePCT.

The **EPO** has begun a pilot project of web online-filings for PCT.

AGENDA ITEM 6

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT. REPORT ON THE TWENTIETH SESSION (PCT/WG/6/3)

A summary was presented by the **International Bureau** to inform the member countries. Many agenda items of the Meeting of International Authorities (MIA) are also on this meeting's agenda. The MIA focused on the issue of quality (cf. ANNEX II of PCT/WG/6/3). One agenda item of the PCT Assembly will also be concerned with quality. The report on quality metrics and the characteristics of the ISR, which was initiated by the trilateral offices, and Circular C. PCT 1360 were mentioned. The IB has extended this study to all member states. At the MIA, the EPO proposed to produce a metrics framework, which will allow evaluation of the system and the work of offices in their various roles. The study of the Swedish Office on the usefulness of the ISR for the national phase was presented as a first pilot on a very small scale. It was suggested to use the ePCT system for this kind of study.

Brazil asked for more detailed information on the MIA in the PCT working group meetings, as the PCT working group is the ideal forum for the improvement of the PCT system. Brazil further pointed out that the PCT stipulates that meetings should be held in Geneva (whereas the MIA was in Munich).

AGENDA ITEM 7

PCT KAIZEN (FROM PARTIAL TO TOTAL OPTIMIZATION) (PCT/WG/6/14)

Japan presented a summary of the paper. According to PCT Kaizen, a corporate management approach should be assumed. PCT is the global IP infrastructure and important issues need to be solved as, for example, the work product of the International Phase is not efficiently used and a more user-friendly system is needed. The PCT Kaizen proposal will not immediately affect articles or rules of the PCT. Up to now, only a partial optimization of the PCT has taken place, where single steps have been optimized individually, but not with a holistic view. Five specific items are central to the PCT Kaizen approach:

- (1) Improving quality of search/examination at the international phase,
- (2) Promoting linkage between the international phase and the national phase,



- (3) Refining collaborative search and examination,
- (4) Creating intelligence (i.e. a set of theories, methodologies, processes and activities to transform factual data into meaningful intelligence),
- (5) Creating an IT infrastructure that is conducive to PCT Kaizen (Development of the Global Dossier).

The **Chair** asks to comment on these proposals separately. First, comments are invited on the item concerning the improvement of quality.

The **EPO** welcomed the efforts of the JPTO. The EPO has developed a PCT metrics framework on statistical data. This should provide information on how the PCT works and should allow definition of weaknesses. However, the availability of the data that are needed for this framework must be investigated. Further, identification of where the data collection needs to be improved. The EPO collaborates with the JPTO.

India looks forward to further discussion.

EL Salvador shares the KAIZEN philosophy. The national Office is certified according to ISO 9000.

Israel pointed out that feedback from designated offices would improve the system.

The **USA** referred to the 20/20 proposals. Some of the proposals there will lead to an optimization as Japan wishes. It was questioned whether the national offices need to change their procedures in order to implement PCT Kaizen. As PCT Kaizen appears to be a very abstract idea, it was asked whether there are more concrete steps to be presented.

China looks forward to collaborate with Japan. Any feedback from the national phases should not be mandatory.

The **United Kingdom** is looking forward to further work.

Austria suggested that the office of first filing should be integrated into the Kaizen framework so as to also provide feedback as it may profit from such feedback. The feedback should not be given on a mandatory but on an optional basis.

Korea stated that the national phase should be fed back to international phase and that a methodology for analyzing the feedback should be developed and studied. Users should be able to give opinions on the ISRs. Creating an eForum towards this end was suggested.

Australia stated that any feedback should be detailed and structured so that systemic issues might be recognized.

Brazil pointed out that any linkage between the national and the international phase should be a discretionary decision of the respective national office as otherwise, the autonomy and authority of the national offices is encroached. No big gain is seen over the existing PATENTSCOPE system.

JIPA considered that an effective quality control program needs data, and that these data should be available to users. PCT Kaizen will lead to a more effective use of international work products.

JPAA is in strong support of PCT Kaizen.

TWN is afraid that PCT Kaizen will lead to a harmonization of substantive law.

AIPLA observed that PCT initially was a formal procedure and that PCT Kaizen may lead to more profound implications.



The **Chair** summarizes: Most delegations welcome the efforts of JPTO. Any work sharing will be to the betterment of the PCT. Some delegations require information regarding what is to be done concretely. The fears of other delegations that substantial law is affected are not shared by the Chair, as it is only about information sharing. Thus, national autonomy is not abrogated. Finally, concerns were voiced that access to other offices' work product by the ISA or IPEA may be considered as an inappropriate action under the PCT.

The Chair then invited comments on the linkage of the international and national phases.

Brazil stated that the linkage should not be mandatory, but the discretionary decision of the national offices. Further discussion is needed for implementing this proposal.

Mexico mentioned that Mexican law allows, on a discretionary basis, the consideration of substantial examination of a foreign country. This has a beneficial effect on the examination quality.

Israel supported the adoption of an easy-to-understand language in the international work products.

The **Chair** then invited comment on the remaining items of PCT Kaizen.

Brazil is afraid that the Global Dossier would encroach on the national offices' autonomy. There should be no mandatory requirement that the offices participate in collaborative search. No necessity is seen for another tool as PATENTSCOPE is already available as a tool.

The **USA** supports proposal 3 of Kaizen and agrees with the last sentence of paragraph 5 of Annex III.

Australia is in support of the Global Dossier. Synergies between existing systems are noted. An open architecture is welcomed.

The **Chair** asked Japan how it is intended to move forward.

Japan responded that a mandatory implementation is not considered. At a future session a more concrete proposal will be provided.

The **Chair** points to the MIA, which might also be a platform for presenting PCT Kaizen.

Japan assured that it will take comments and proposals and that it will present further details at the PCT Working Group meeting or at the MIA.

AGENDA ITEM 8

DISCUSSION OF EXPANDED PCT 20/20 PROPOSALS (PCT/WG/6/15)

A short summary was presented by the **United Kingdom**. Reference was made to responses to Circular C. PCT 1364 and to the discussions at MIA (cf. PCT/WG/6/3 Annex, ITEM 13). At this stage comments on all the proposals are invited. The following items of the 20/20 proposals were not a separate Agenda Item of the Working Group Session:

- self-service changes (Rule 92^{bis}, priority claims);
- limited chapter I amendments;
- simplified withdrawal;
- standardizing fee reductions for national stage applications;
- integrate national/international phases, use a national first action on the merits for pct search report, require response to negative comments at the national phase; and



- development and implementation of the Global Dossier and incorporation of said system into the PCT.

Brazil asked the UK delegation to present at least parts of the document, as there are many proposals included.

The **United Kingdom** responded that it does not intend to go through the items as they are included in the further Agenda Items.

Mexico commented on the reduction of fees. Mexico already adopts a 50% reduction for certain applicants. Applying another 50 % on this rate would be too much.

The **EPO** considered the item “Limited Chapter I Amendments”. In the MIA report, concerns were raised with respect to claim renumbering. Substantive issues should be dealt with in Chapter II, not by the formalities examiners under Chapter I, or the national examiners. The same is true for the replacement of missing parts. The PCT system needs improvement by integration of national and international phases. Towards this end, the concept should be further pursued that the work done by the ISA acting as national office is mandatory in the international phase.

The **USA** responded that an improved integration of the national phases and the international phase is envisaged by re-using the search that has been done before on family member. The concerns with regard to the replacement of missing parts will be taken to the next MIA. The proposal, that the national phase is deemed to be entered at the office which acted as ISA, is delayed.

South Africa asked what constitutes a replacement of a whole description and of the claims, and how this may happen.

The **USA** explained that due to electronic errors, applicants file different claims, and it will be discussed in more detail in a paper by the EPO later in the meeting (see PCT/WG/6/20).

India is concerned that Rules will have to be changed. As to the Item “Formal Integration of the Patent Prosecution Highway into the PCT”, it is the objective of the PCT to ease the filing and not to ease granting at national level. Quality, the reduction of workload, the reduction of backlog and the reduction of duplicate work are not aims of the PCT. In any event, further discussion is needed. A revised document is expected in the next session and the integration of the 20/20 proposals with PCT Kaizen is suggested, as they concern similar matter.

Brazil is of the opinion that replaced items should be transmitted so that offices can better evaluate whether a replacement adds new matter.

Sri Lanka stated that the proposal will need more time.

AGENDA ITEM 9 MANDATORY RESPONSE TO NEGATIVE COMMENTS IN THE NATIONAL PHASE (PCT/WG/6/16)

The **USA provided a** Summary of the paper. The unilateral implementation of Rule 161/162 EPC by the EPO is pointed out. The proposal aims to anchor a system like that in the PCT. Amendments were proposed to Rules 51^{ter}.1 and 76^{bis}.1. According to this proposal, a negative statement according to any of Art. 33 (2), (3) or (4) would require the applicant to submit a response to overcome the objections, either by an amendment or a substantive argument. Failure to submit a response may result in the imposing of an appropriate sanction as determined by the DO after invitation and setting a time limit.



Korea fully supports the proposal. It was questioned whether the applicant should be given an opportunity to respond to an objection if the applicant did not amend the application upon national phase entry.

The **USA** and the **Chair** responded that applicants should be given the opportunity to set objected issues right as a matter of principal fairness.

Sweden announced that the proposal is supported completely.

Canada indicated that the incorporation into national law will require time and that an incompatibility notice will be required. It should be discussed whether sanctions such as fees are appropriate.

The **Chair** noted that the proposal be kept quite general to allow as much as lateral movement as possible.

Germany is skeptical about the sanction part as sovereignty of the national offices should not be touched. The national law should provide for such sanctions.

Singapore is generally supportive. However, under Singaporean law many options exist for an applicant, such as not to request any examination. To allow cases like that in the national phase, a response to objections in the international phase should not be mandatory.

South Africa noted that as a non-examining country, it is not in a position to make a response mandatory.

The **EPO** supports the proposal in principle, as it strengthens the PCT work product. However, the EPO stresses that it acknowledges a mandatory response only for its own work product. For an ISR done by another office, the EPO carries out new supplementary search. In such a case, the applicant would have to reply twice. Further, the EPO also addresses clarity and formality issues, whereas the proposed new Rules concern only novelty, inventive step and applicability. The proposed new Rules require “amendments”, but amendments alone may not be enough to convince an examiner. The term “error in the objections” in the proposed new Rules is opposed, as it may only be different views by the applicant and the office, but not an error. All in all, how it is done should be left to the national law.

China would have to amend the national law. Therefore, a more flexible wording is preferred. A reply should not be mandatory.

Denmark observed that users in Denmark are divided upon this issue. An adequate time limit is necessary, such as 6 months. It is further noted that different countries have different practices and different rules.

Japan pointed out the PCT Kaizen proposal also promotes linkage between the international and national phases. A mandatory response is one way towards such integration. A sufficient exchange of information between the users and the offices is also necessary. The PCT working group should ask the IB to implement an eForum for members.

Switzerland and **Chile** share the reservations of Germany and the EPO.

According to **JPIA**, it is too early to implement such measures.

EPI also disagrees with the proposal.

JPAA notes that negative comments of one ISA may not be relevant for another national office.



FICPI welcomes an integration of the international search and/or examination in the national phases. FICPI believes, however, that this will only be of benefit to the quality of the patent system if such integration is introduced once a top-up and a collaborative search have been established in the international phase. Currently, the patent quality and the legal certainty with regard to the validity of a patent family member is derived not only from the search and examination in the international phase, but also in considerable part by the independent (albeit often overlapping and duplicate) search and examination work of the national offices which is available to the public. FICPI would consider it a regression of the existing quality in the patent system if, due to an early integration of the national and international phases, reliance on the work product of the international phase in its present form (i.e. without top-up and collaborative searches) becomes mandatory and replaces the often complementing work of the individual national offices. Finally, the relationship between the required response to the objections in the international work product and the right of the applicant to change the claims upon entry into the national phase is unclear.

TWN sees the proposal as a burden on the applicants, with benefits only for the offices. It is further against the general principle that the international phase is not-binding for the national phases.

AIPLA gives consideration to SMEs which do not have the sources to respond. Further, the international phase cannot be used to its full extent because the responses in the national phases need to be prepared upon entry. The view of Germany is supported.

The **USA** indicated that the proposal will not be pursued further at this session. Concerns that addressed paragraph 4 subparagraph (b) could be considered by making the response optional to the offices. The offices are invited to consult with the users.

AGENDA ITEM 10

FORMAL INTEGRATION OF THE PATENT PROSECUTION HIGHWAY INTO THE PCT (PCT/WG/6/17)

The **USA** provided a summary of the paper. It was told that this proposal was supported at the MIA. The incompatibility clause in the proposed new Rules was emphasized. The proposal included amendments to Rules 52^{bis} and 78^{bis}, and to the Administrative Instructions. Any application which contains or is amended to contain prior to the start of processing only claims which sufficiently correspond to claims which were indicated as meeting the criteria of PCT Art. 33 (2) to (4) in the WO-ISA shall, at the request of the applicant, receive expedited processing and examination. An incompatibility clause is also provided in the draft rules. In the AI, a definition of “sufficiently correspond” and optional further requirements at the national level are given, such as payment of a fee, are given.

Brazil referred to the development agenda and that a diversity of offices and legal frameworks has to be considered. The comparative benefits should be considered regarding resident and non-resident applicants. It must also be considered to what extent a PPH implemented in the PCT Rules would influence examination at the national offices.

India sees the proposal as an attempt to harmonize examination at national level. This approach may reduce the pendency but not the quality of patent applications. Any Rule change should not be made in a hurry.

Canada noted that 80 % of its national applications originate from PCT. It is feared that the proposal will lead to work overload. Thus, an office should be able to suspend the PPH temporarily if the workload is too high.



Japan has implemented the PPH with a lot of offices and supports the proposal.

The **EPO** supports the proposal in principle. Applicants may benefit from being treated equally before the various offices. EPO points out that it also allows accelerated examination independent of other offices' work product under the PACE program. An effect on the workload is not seen, as only 5 % of the applications would be affected. Rather, the offices may reduce their workload, as the PCT work product may be reused. The proposal allows for an opt-out and thus grants sufficient flexibility. A reference is made to the ongoing PPH working group. Finally, the proposed new Rules should only define minimum requirements and not restrict offices.

Australia supports a plurilateral system. In the proposed new Rules, it is questioned what is meant by "prior to the start of processing" as this may not be a well-defined point in time. It is further questioned, whether the administrative instructions have an effect on the national level. Also, work load concerns were voiced.

Switzerland noted that it does not look at inventive step, which would lead to incompatibility. Thus, a reservation will have to be made.

Korea is concerned about the structure of the proposed new Rules. Different criteria should be handled in different Rules. The acceleration of the proceedings should be placed in the Administrative Instructions.

Israel is, in general, supportive. It is suggested to add to the Administrative Instructions that an ISR or a supplementary SR is not enough to be eligible for acceleration.

South Africa said that it is in the same position as Switzerland.

Brazil is concerned that a change to the Rules would not suffice. The amendments will affect substantially the work of the national offices. A diplomatic conference would be necessary as laid out in Art. 60.

JIPA supports the proposal as costs are reduced.

The **USA** addresses some of the concerns. The sovereignty of the national offices will not be affected. The PPH is a bargain between the applicant and a participating office that narrower and fewer claims will advance examination. The work load concerns expressed by some offices are noted. The notice of incompatibility is already included in the proposed new claims. The expression "at the start of processing" is supposed to designate the time before the national office has started search and examination. The expedited processing is mentioned in the Rules, because they can be changed more quickly. Finally, the proposed new Administrative Instructions already state which documents need to be supplied to be eligible for accelerating.

The **Secretariat** responded to the question whether a Diplomatic Conference will be necessary. Here, no answer can be given, as it is up to the member states as to whether they see any need for a more fundamental change. If such a need is seen then there would be a Diplomatic Conference. It was further pointed out that one of the basic ideas of PPH goes back to the origins of PCT to give offices the possibility to have a head start by using the international work products. It was further remarked that the PPH is only about acceleration. How the expedited procedure is done nationally is subject to national law.

Brazil observed that the discussion should also consider development agenda. WIPO is member driven and a thorough debate is needed regarding what the proposed change would mean to the PCT system.



APAA voiced general support for the proposal. It is suggested to change the wording of the proposed new Rules to “prior to start processing and/or start of examination”. Expedited processing and expedited examination should probably be addressed separately.

TWN stated that the run for efficiency undermines patent quality. With the proposed amendment, a separate plurilateral framework (PPH) would be integrated into a multilateral agreement.

EPI supports integration. As a result, the use of Chapter II may rise. It is noted that the PCT products should be of the highest possible quality for the PPH system. If there is no agreement for fees, it should be made sure that the PPH system will not discriminate against SMEs or universities.

AIPLA suggests making the PPH optional at the discretion of the national offices. It is further noted the PPH should have an enormous benefit on developing countries.

Canada stated that some national provisions need to be considered in the Administrative Instructions.

According to **Brazil**'s understanding the PPH cannot be brought to the PCT. Only 20 countries have joined the PPH, whereas more than 100 countries are members of the PCT. This is not a member driven approach.

The **Chair** points to a meeting in Tokyo regarding the PPH. It is suggested that the developing countries are informed as to what the PPH is about before any decision is made regarding whether to include the PPH into the PCT.

Japan gave a short survey of the PPH system mainly by pointing to information in the internet and by providing an outlook of the PPH meeting. The results of the PPH meeting will be available on JPO's website.

The **USA** and the **United Kingdom** will bring forward revised proposals and further information at the next session of the PCT Working Group.

AGENDA ITEM 11 MANDATORY TOP-UP SEARCHES (PCT/WG/6/18)

The paper was introduced by the **United Kingdom**. The paper includes amendments to Rule 66, as well as to the AI and to the PCT International Search and Preliminary Examination Guidelines, including an incompatibility clause and the possibility that the IPEA issues one or more additional written opinions.

Australia voiced support for mandatory top-up searches. A change to proposed amended Rule 66.4 was suggested, as the current wording seems to imply that more than one top-up search should be performed at the international stage.

Israel is in favor of a flexible approach. The ISA should decide on the scope of the top-up search. In general, an increase of quality may be expected.

Canada also supports a top-up search in Chapter II. Such a search is currently implemented at the CIPO. A top-up search should be mandatory if there are no X or Y documents, and optional at the discretion of the examiner if X and Y documents are cited.

Germany expresses support.

France noted that users who have been questioned, support the proposal.



Norway and **Sweden** voiced support.

The **EPO** generally supports the concept of top-up searches as it increases quality. The proposed Rule changes allow enough flexibility. However, in proposed new Rule 66.1^{ter} (a) the expressions “no useful purpose” and “relevant under Rule 64” are unclear. Also prior art other than relevant under Rule 64 may come up in a top-up search. In proposed new Rule 66.1^{ter} (b) the expression “at that stage” is not clear and alternative wording is proposed. Definitions of these terms should be given in the Guidelines. If a Supplementary Search is done, a top-up search may not be necessary. It is noted that the Administrative Instructions only repeat the Rules with a small change. The expression “secret prior art” in the Guidelines may not be a technical term. Further, with regard to the Guidelines, new section 19.12.02 raises questions with regard to the subject-matter to be searched. In new section 19.12.03, it is not clear whether a top-up search should not be carried out only in the cases mentioned. It should be determined whether the reasons why no top-up search has been performed, be indicated on ISA, IPER

NPI supported a mandatory top-up search, not limited to intermediate prior art.

Japan stated that further clarification is needed in the wording. It may be difficult for examiners to decide whether top-up searches are necessary.

China is of the opinion that top-up searches make the search more complete. However, it is better to add them as an optional service.

The **United Kingdom** commented that the proposed change to Rule 66.4 should not imply that more than one top-up search should be done. The United Kingdom sees significant support for the proposal. Thus, the discussion should focus on this specific rule change.

As to the NGOs, **EPI** is supportive of the proposal.

JPAA is concerned about fee increases and timeliness issues.

AIPLA strongly supports the idea, but voiced cautiousness with regard to fee increases.

The **Chair** sees strong support for this proposal so an acceptable set of words should be arrived at for submission to the Assembly. The Secretariat should help the United Kingdom to draft and submit a proposal to the member states.

According to the **Secretariat** the proposal may be submitted at this or next year’s assembly.

Upon a suggestion by the **United Kingdom**, supported by the **USA**, it was decided to attempt a drafting of the new Rules and Guidelines during this session.

Later during the meeting, Paper 4 was circulated containing amended draft Rules. In Rule 66.4 the reference to Rule 66.1^{ter} is to be deleted.

EPO stated that it can support the draft Rule. However, the Guidelines will be needed to provide guidance on what is to be considered “no useful purpose”.

The **NPI** shares the view of EPO.

The **United Kingdom** gave full support of the draft.

Japan saw no principle problems with the draft. Three comments were made: With regard to Rule 66.1^{ter}, more time is needed to study its effects because of a possible incompatibility. The modifications to Rule 70.2 may require a change in the forms. If that is the case, the JPO will need more time. Finally, the Guidelines, Administrative Instructions and so on need to be discussed.



The **Secretariat** responded to Japan. In the past, if there was agreement on the principle, the Delegations were given time to check with their home authorities. The final draft and proposals for additional items as well as entry into force will be put on the website and a short term will be given to provide feedback.

Brazil asked to clarify the procedure before the Assembly.

The **Secretariat** suggested to record in the Summary by the Chair and/or in the Secretariat's more detailed draft report of the meeting that there is an agreement to submit to the Assembly the Rules subject to subsequent draft changes and feedback from the offices. If major issues come up, the draft will not be submitted to the Assembly.

The **Chair** summarizes that there is a consensus for the draft wording with amended wording to Rule 66.4. Given this agreement in principle, a final draft will be issued to member states for confirmation with recommendations for a transitional regime.

AGENDA ITEM 12

MANDATORY RECORDATION OF SEARCH STRATEGIES (PCT/WG/6/19)

The **United Kingdom** summarized the paper. An amendment of the PCT International Search and Preliminary Examination Guidelines was suggested which would make the Search Strategy more mandatory than the current formulation.

Japan stated that the recordation of search strategies contributes to the enhancement of quality. The proposal, however, is not supported as the recordation is mandatory and premature. Not all International Authorities are ready to record search strategies. Further discussions on the recordation format are necessary.

Canada voiced strong support. CIPO examiners are already required to record search strategies. It is currently being evaluated how this information can be made available to PATENTSCOPE

Australia is also in support of the proposal. An increased transparency will increase confidence and quality. It was noted that Australia issues "search information statements" which contain information on the search strategy. which is published on PATENTSCOPE. Australia supports a publication of the search strategy even before a common format is agreed upon.

Israel gives full support to the proposal. The search strategy should be published. Israel has already begun sending information on search strategy.

China sees a necessity to define minimum requirements and a uniform format before making a recordation of search strategy mandatory. The quality enhancement is acknowledged.

Russia voiced support in principle. Presently a pilot project has started by ROSPATENT. As yet, there is no feedback on usefulness from the public. Russia feels embarrassed by the character requirements. It was also noted that there is a difference between search history and search strategy. A search history contains dead-end roads and much data. It may be confusing to the public. Thus, only successful search queries should be maintained. Russia uses various databases which all have different history formats. Thus, examiners should refine history for the public, which, however, would be an additional workload. The query language should be unified so that recorded searches can be duplicated. Offices should be given time to prepare internally. At the moment, the system should stay voluntary.



Finland is in support of the proposal. A standard format can be agreed upon later. Finland started to provide search information strategy this April.

El Salvador shares the aims of the proposal. The mandatory nature of search recordation is, however, questioned. An Initial period should be used for learning.

Chile signaled overall agreement. A common scheme is to be devised to share this information. It is noted that a transfer of know-how on searches is involved.

South Africa is in strong support. No standardized result is needed, the mere result will be useful.

Norway is in general supportive.

The **EPO** is currently assessing how to share search strategies in the future. This will, however not entail “complete” information. For the recordation to be useful, a definition of a complete and common format is needed and yet to be determined is what information is needed. Thus, the recordation of search strategies should not yet be mandatory. It was noted that the MIA and the quality group recognized further work. Consistency in relation to the recordation and the information is needed. All in all, further discussion at the MIA is needed.

Denmark is in support of the proposal.

JIPA noted that availability of the search strategies may strengthen the search capabilities of the users.

AIPLA suggested that the Secretariat should work on a common format.

The **Chair** responded that the MIA and the quality group are the addressees for working out a common format.

The **Secretariat** clarified that it has more of a supporting than a leading role. There seems to be a great deal of desire to share as much information as possible. One additional technical option was pointed out: Currently, a “search strategy document code” if received will be automatically published on PATENTSCOPE. Probably a second document code should be provided for documents that will not be published. Such a document will be communicated to the applicant and to the national offices, but not be published. Offices can then simply switch to the other code when they want their search information to be published.

The **Chair** stated that according to the MIA no common format is needed as the information can be read and understood.

The **United Kingdom** elaborated on the next steps that a change to the guidelines now would be very beneficial. The wording should be changed to make recordation not mandatory. Feedback is desired on how a change to the guidelines with flexible wording is received.

The **EPO** commented on the MIA discussion. The EPO has perceived that the MIA did not conclude that common format is not needed. Rather, a mandate was given to the quality group to look deeper into this matter. This view is shared by the **EPO**. Further, the Guidelines already allow for the flexibility asked by the United Kingdom.

The **USA** indicated that, to agree on a common format, a sharing of information should start. Other offices are encouraged to publish or post search strategy so that the MIA can be addressed fully at the next meeting.

Japan agrees with the EPO. The proposal should be discussed at the MIA and quality subgroup.



AGENDA ITEM 13
PCT FEE REDUCTION (PCT/WG/6/10)

The **International Bureau** proposed to split the discussion into two parts, the SME (and universities and NGOs) fee reduction on one hand and the fee reduction for developing and least developed countries on the other. The discussion should further be split into

- rationale and potential,
- impact on PCT and WIPO income,
- eligibility criteria and,
- if there is agreement on the introduction of a fee reduction, implementation issues.

In the last Working Group session, the International Bureau was asked to prepare a discussion paper. In the summary of the paper it was mentioned that according to an OECD study 99 % of all firms, 2/3 of employment and 1/3 of generated value are SMEs, in the PCT top 15 countries of origin this figure is even higher than 99 %. Engagement of SMEs in the patent system is lower compared to large enterprises. Studies suggest that on average SMEs innovate less than larger enterprises. Although SMEs are associated with economic growth, it is not certain that they are the cause of economic growth. The relationship between fees and filing volume appears to be inelastic, i.e. a 10 % fee increase leads to (far) less than a 10 % filing volume decrease. Thus, fee reductions need to be significant to have an economic impact. It is not clear whether this general relationship also holds for SMEs and for PCT applications. It may be questioned whether it is the SMEs and not start-up companies that should be targeted for support, as patents play an important role for these firms. If SMEs should be supported, a PCT fee reduction may not necessarily be the best instrument, as its impact will be limited. Moreover, a definition is needed as to what constitutes a SME, the definitions vary from country to country. In the PCT system, a central definition or national definitions may be applied. To achieve income neutrality, other fee reductions such as for electronic filing need to be abolished.

Belgium for **Group B** welcomes efforts to make the PCT more accessible. A pragmatic approach is favored. Certainly, the fee matters, but it has a limited policy effect. Any fee reduction should be income neutral. The eligibility for fee reductions is hard to determine.

Barbados is supportive of the idea, also with regard to the fee for filing in electronic form. The eligibility criteria have to be developed.

El Salvador wanted to know the extent to which this would affect the institutions in question.

The **Secretariat** responded that no estimates are available on how changes in the fees will affect the filing behavior in the PCT system. The PCT fees have been very stable in the past, so there are only scarce data.

Korea fully supports group B.

Algeria spoke for the **African group**. A fee decrease would lead to a more balanced and more inclusive PCT system. A dual approach should be taken, comprising both technical assistance and fees. Over 100 member states are developing or constitute least developed countries. The fee reduction will be important for developing key players in this group. Algeria hopes for a deep discussion.



Chile regards fee reductions as an important issue and endorses an approach to motivate universities and SMEs to use the PCT. At this time, there appears to be no background information for full analysis of the issue fully and for determining its impact. Thus, the issue should be further pursued to clarify these issues.

India supports Algeria and El Salvador and encourages more input from the Secretariat for a clearer picture.

Japan considered that the effects of PCT fee reduction on non-SMEs should also be taken into account and the impact should be studied. The PCT fee reduction should affect only the international filing fee, other fees should be determined by the offices.

Brazil supports India and the African group. More information was requested

The **Secretariat (Chief Economist of WIPO)** elaborated that the “fee elasticity” is the important parameter as it assesses the effect of a fee change – a low estimate for the fee elasticity indicates a policy instrument with limited impact. The fee elasticity also allows for estimation of the financial impact of a fee change. Although some data are available, there are methodological issues: There are different fee elasticities for different types of applicants. Research institutes and universities can be recognized in the data, for these entities reasonable estimates may be obtained. SMEs are, however, hardly recognizable. A definition for SMEs via yearly filing numbers is subjective and not exact. Rather, data would be needed from offices which can identify SMEs.

The **Chair** asked whether WIPO should do a study on fee elasticity on universities and research institutes.

Algeria responded that a larger picture is wanted of the whole patent system to assess costs. The financial capabilities of SMEs in developing countries and the costs of a (PCT) patent should be compared.

The **Secretariat** pointed out that this is not possible with the information available from WIPO. Such a study would require much greater effort and resources, an evaluation of companies and costs. It is, in principle, doable, but needs much more time and effort.

Belgium remarked that the study will be discussed in a Group B meeting during this Working Group session.

The **Secretariat** then introduced the second part of the paper relating to fee reductions for developing and least developed countries. It is noted that there is divergence in the member states as to which criteria to apply. An innovation-based criterion, an income-based criterion or a country-size related criterion, or a mix of these criteria may be used.

Barbados is supportive of taking this matter forward with a mix of criteria.

Korea stated that there should be no impact on WIPO income. A multi-step deduction rate should be contemplated, depending on how many criteria are met by a particular country.

The **USA** is supportive of the idea to encourage innovation in low-income states. Access should be restricted however and no additional burden should be put on WIPO. There should be a periodic review of whether fee reduction criteria still apply.

India requested to maintain the document for the next session of the Working Group to establish an opinion.

Algeria stated that a clear answer is complicated as the patent system is complex and requires complex answers. The developing countries and the least developed countries would most need the



fee reduction. It is questioned whether the debate aims to amend the PCT, which is wanted by **Group Africa** to allow access, or to discuss the issue generally.

El Salvador saw itself in line with Barbados. The document should be discussed at a subsequent meeting to be able to provide national offices with more information.

Brazil remarked that the debate still needs more information to determine the problem that is to be solved. If the PCT should be made more inclusive, then new norms should be drafted. For this, the size of the country may not be important. Brazil seconds statements requiring further discussions of this subject.

Korea encouraged the WIPO to increase cost efficiency and customer service in view of the discussion on fee reductions.

The **Chair** summarized that the way forward is not clear. The item will be brought back to the Working Group at the next meeting in the hope of more information and more input from the member states. The member states are encouraged to work together with the Secretariat so that a more substantial paper can be established.

Later in the session, the agenda item was reopened.

Belgium demanded for Group B that the IB prepare a document on what is considered a SME in the various member states. Further, the mechanisms already in place in the member states should be described. The Chief Economists should provide data on fee elasticity. The fee reductions for developing and least developed countries and the mixture of criteria should be further discussed. If there is agreement on the criteria, thresholds need to be discussed. A paper by the IB is suggested on the effects on the combination of an income and innovation criterion.

Brazil welcomes the proposed “closed” study instead of the “open” never-ending studies conducted in the past. It also welcomes the study on parameters that allow to define an SME.

China supports further studies on this subject and looks forward to the discussion at the next meeting.

The **USA** is in support of Group B. Fee reductions are a part of the 20/20 proposal. The USA has unilaterally introduced a three-tier fee reduction system with regard to their international fees.

AIPLA points to its non-paper in favor of SME fee reductions, which was drafted and distributed during the session.

AGENDA ITEM 14

COORDINATION OF TECHNICAL ASSISTANCE UNDER THE PCT (PCT/WG/6/11)

The **International Bureau** summarized the paper. At the fifth session of the Working Group it was agreed that reports on technical assistance projects relating to the PCT should be included as a regular Agenda Item.

Brazil is satisfied that the Secretariat sees the important role of those activities in developing patent systems, but more activities are requested. The Working Group should not rely on other WIPO bodies to provide technical assistance relating to the PCT.

Belgium noted that no specific PCT-related assistance to the Working Group needs to be branched off from WIPO’s general assistance bodies.



Algeria stated that the **African group** is satisfied with providing the report. Yet some issues need clarification from the Secretariat. For example, reference is made in the paper to the standards committee CWS (para. 13). It was asked what the relation of this committee is to the PCT. Moreover, CDIP¹ and PCT have different members.

The **Secretariat** responded by pointing out that CWS provides training courses on the IPC. The assistance according to Art. 51 goes beyond the PCT into establishing a patent system in general. There was a decision by the member states in the last meeting noting similarities between projects carried out by the various WIPO bodies.

India would welcome forward movement within this group. It is noted that some areas may be left by other WIPO bodies in their assistance that need to be covered by this working group.

Australia described its training projects with 8 trainees from offices from developing countries, which started this April.

Belgium commented that it has a body discussing national development activities.

Algeria asked what means are available to have the report considered by CDIP.

The **Chair** responded that member states would have to agree to send the report to CDIP. He questioned the Working Group as to whether the report is to be sent to CDIP and to what purpose.

Belgium remarked that it is not necessary to send the work to CDIP, as this would create duplicate work.

Switzerland noted that the CDIP committee already has documents for technical assistance. There is a risk of redundant discussions within CDIP.

Brazil wants to make the Working Group more inclusive and to have participants from developing countries.

India voiced the desire for PCT-relevant issues to be discussed here in this Working Group, or the report should be sent to CDIP, in order not to have two separate discussions.

Algeria stated that Group B suggested that discussions in CDIP are awaited until further discussion is made here in the Working Group. For this discussion, the report should be sent to CDIP.

Belgium responded for group B that in CDIP the documents are already on the table. The member states are free to come up with this topic at CDIP. There is no need for this document to be sent to CDIP.

Brazil suggested that CDIP should take note of the efforts that are made in the Working Group.

The **Chair** noted that there is no consensus. The member states are now aware of this document and can bring the issues to discussion in CDIP. Given that no consensus has been reached, the document should be kept as it is.

¹CDIP: Committee on Development and Intellectual Property. The mandate of the CDIP, as established by the General Assembly (document [A/43/16](#), page 135), is to develop a work-program for implementation of the 45 adopted recommendations; monitor, assess, discuss and report on the implementation of all recommendations adopted, and for that purpose it shall coordinate with relevant WIPO bodies; and discuss IP and development related issues as agreed by the Committee, as well as those decided by the General Assembly.



AGENDA ITEM 15
APPOINTMENT OF INTERNATIONAL AUTHORITIES (PCT/WG/6/4)

The **International Bureau** provided a summary of the paper. Most of the provisions for International Authorities (IA) were drafted in the 1970s. Thus, consideration should be given as to whether these provisions still reflect what is necessary to ensure high quality..

Russia acknowledged that the provisions are not up to date and that a review is needed. Further, a review is also needed of the provisions for the appointment of an IA. The Working Group should ask the Assembly to task the International Bureau for a review of the provisions, which then should be presented to the MIA. However, existing Authorities should not be affected. No new IA should be appointed until new provisions are in place.

Korea supports Russia. The MIA should act as an advisory body to CTC².

The **USA** shares the concerns regarding whether the criteria for appointment of an IA are still adequate. The number of filings, the technical means and the body of prior art have changed considerably since the provisions were made. The IB together with the MIA should work out a proposal as suggested by RU.

The **EPO** supports Russia fully as well as Korea and the USA. An update is necessary as regards what agencies need to respond to the requirements of users and Designated States.

Japan is of the opinion that first a review is necessary as to whether current provisions should be reviewed. Then, new and obsolete requirements should be defined. The scope of opportunity should not be narrowed for offices to become an IA.

Canada considers a minimum personnel requirement as important. The guidelines should reflect what is truly necessary for search and examination. The service should be accessible to users of different languages and in different locations. Every member state office qualifies as an IA.

Switzerland supports Russia.

Hungary pointed out that there might be offices that are preparing to apply as an IA. Staying the appointment until new provisions are made seems unfair. Russia's proposal is not supported because of this limitation.

Australia noted that a careful study should be made before current provisions are redone.

Norway and **Denmark** point out that there should be no limitation on appointing new IAs until new rules are in place.

Hungary supports Norway.

Chile suggested starting with requirements that have already been established in order to know what the problems are with the rules currently in place.

France is in support of Russia's proposal.

Brazil supports a revision. However, there should be no evaluation of authorities that are already appointed. The criteria that guarantee better quality need to be discussed in the PCT Working Group.

AIPLA noted that a proliferation of authorities may result in important issues, such as mandatory top-up searches, not being implemented if the IAs are not in a position to provide such services.

²CTC: Committee for Technical Cooperation.



The **Chair** did not see significant consensus for holding the appointment of new IAs. However, a very strong will to review the requirements was noted. There appeared general consensus that a review should be guided by the IB on a scientific basis. The results are to be presented at this forum. No consensus seemed to be reached with regard to grandfathering of existing IAs.

The **USA** commented that no delegation spoke against grandfathering.

The **Secretariat** remarked that there is consensus for a revision to be made with IB in the lead. Therefore, the working group should ask the Assembly to mandate the IB. The Secretariat fears that a two-class system would ensue when existing appointments are renewed. It is questioned whether existing IAs upon renewal should be judged according to the old or new rules. This should be decided by the member states and the MIA. The study should not be entered into with a bias with respect to grandfathering.

AGENDA ITEM 16

CLARIFYING THE PROCEDURE REGARDING THE INCORPORATION BY REFERENCE OF MISSING PARTS (PCT/WG/6/20)

The **EPO** presented a summary of the paper. It was pointed out that some offices apply Section 205F of the Receiving Office Guidelines to allow two complete sets of descriptions and claims to be filed. Besides legal uncertainty for the users, this also creates a burden on the ISA. There were cases where an ISR was already finalized when the RO transmitted replaced parts of the application. This then required a new international search based on the replaced parts. It was further pointed out that the Board of Appeals has a very strict approach as regards both added matter and the definition of the same invention for the priority claim. Thus, this “flexibility” may lead to a rejection or withdrawal of the European Patent Application or Patent. The proposal includes amendments to the PCT RO Guidelines aimed at a more consistent and stricter approach.

The **USA** sympathizes with the situation. The USA disagrees that the PCT prohibits filing a second claim set or a second description. This has already been decided by the Working Group. This view is further supported by the language in the RO Guidelines. It is noted that inadequate treatment of the applicants may result. An applicant not relying on incorporation by reference – but filing the traditional way - would be penalized as a wrong description cannot be remedied in a traditional filing. In any case, the later-submitted elements would be the ones to search and examine. It is suggested that the matter is moved to the IB to work with the two offices towards a solution which should then be presented to the Working Group.

Switzerland endorses the view of the EPO. A full replacement of the documents in the original PCT request does not seem justified.

Japan shares the concerns of the EPO. The proposal should be considered together with the 20/20 Proposal regarding Limited Chapter I Amendments. It is considered that an amendment of the guidelines is not sufficient. Any decision of the RO should be at their discretion.

The **United Kingdom** stated that the Rules allow for incorporation by reference of more than one element. The interpretation of the rules should be made more certain. The United Kingdom could not agree to abolish the rule that more than one element may be incorporated by reference.

China supports the EPO proposal.

Canada supports the view of the UK and the USA.



AIPLA supports the US view.

Russia asked for particular examples of such deviations. This would also be interesting for other offices as it never encountered the problem underlying this proposal.

The **Secretariat** provided information on the concrete problem.

The Working Group invited the Delegations of the USA and of the EPO to work together with the IB on a revised proposal to be submitted to the next session of the Working Group.

AGENDA ITEM 17 IMPROVING THE TIMELINESS TO ISSUE AND PUBLISH INTERNATIONAL SEARCH REPORTS (PCT/WG/6/21)

The **EPO** summarized the paper. The proposal addresses the following problem: If the EPO receives a search copy shortly before publication date, the EPO must still meet the deadline even though the search will not be published. In 2011, the average time for transmitting ISRs to the IB was 16.4 months from the priority date. In 2012, 69 % of the ISRs were received within 17 months from the priority date. 89 % of the ISRs were established by the EPO within 17 months, 93 % when the EPO was RO. To avoid unnecessary A2 and A3 publications, it is suggested to increase the time limit under Rule 42.1 to establish the ISR for applications claiming priority to 17 months.

Australia remarked that an extension of the time limit may not be as efficient as a timely transmission of the search copy.

Japan wants to further the discussion. There is concern that an extended timeline will lead to delay in the publication of the search. A user consultation is needed, and a careful discussion of the time limits with consideration to fairness towards the users. The impacts should be studied and the reasons why the time limit could not be satisfied should be investigated, otherwise a wrong time limit would be established.

The **USA** stated that it has increased performance so that 90 % of the ISRs are now timely. The EPO proposal is not opposed. There were concerns at the MIA as to whether the time between a 17-months time limit and the 18-months publication date is sufficient for the publication. The IB should comment on this.

Korea is also concerned with regard to whether the remaining time is sufficient for publication.

China remarked that the key for the timeliness of a publication is that the RO and the ISA strictly adhere to PCT regulations. The new 17-month time limit is close to publication and puts some pressure on the publication. Therefore, the proposal is not supported.

Germany supports the EPO.

The **Secretariat** stated that the IB has concerns with moving from 16 months to 17 months because of internal procedure and from the applicant's perspective. This would generate pressure on operational staff to timely publish the application. A large portion of reports are received in time, so the new time-limit would be applicable to only few applications. It is further noted that the applicants may not have sufficient time to decide on a withdrawal of an application in view of the ISR. The IB may have some suggestions on how to create more flexible rules without changing the time-limit. The ePCT system may be of help in ensuring timeliness.

EPI stated that the proposal would leave no time for a withdrawal, or to decide on a Chapter II demand.



JIPA said that theoretically this may be a more flexible approach. However, applicants may not have sufficient time to decide on a withdrawal. The Rule change should not force applicants to change their practice.

The **EPO** sees support that the ISR is published with the application and available early. If no consensus is reached for a Rule change, the EPO would nonetheless work on this project and talk with the ROs to ensure timeliness. The ROs are encouraged to transmit search copies to the ISA as early as possible. The IB should assess ways on how this may be achieved.

The **Chair** noted that there is no consensus on a Rule change, but a consensus that the search report is available early. There is further consensus that the interaction between the ROs and ISAs should be improved.

AGENDA ITEM 18

AVAILABILITY OF WRITTEN OPINION BY THE INTERNATIONAL SEARCHING AUTHORITY AS OF THE DATE OF INTERNATIONAL PUBLICATION (PCT/WG/6/13)

The **International Bureau** presented a summary of the paper. It was proposed to delete Rule 44^{ter} as this would be compatible with Art. 38, provide the best results for third parties with no detrimental effect to applicants, and could be implemented very quickly. This would mean that the EO-ISA would be made available promptly following international publication for all international applications where a WO-ISA had been established.

The **USA** noted that the availability of the WO-ISA as of the publication date is part of the PCT 20/20 proposals. Support from user groups in the USA is reported. During the MIA, hopes for fast progress with respect to this item were voiced. The WO-ISA should always be published and Rule 44^{ter} should be deleted.

The **United Kingdom** assisted in the WO-ISA being made available to the public in all cases.

Israel is also in favor of deletion of Rule 44^{ter}.

Sweden, Canada, Finland, Germany, Australia and **Japan** all support this proposal.

The **Chair** noted that Rule 44^{ter} should be deleted. Later during the meeting, the Chair and the Secretariat pointed out that there is a further reference to Rule 44.1^{ter} in Rule 94.1. This reference should be deleted.

The **member states** consented to this deletion.

AGENDA ITEM 19

RESTORATION OF THE RIGHT OF PRIORITY (PCT/WG/6/12)

The paper was summarized by the **International Bureau**, which was asked in the previous Working Group meeting to review the practices of the Designated Offices with regard to the restoration of the right of priority during the international phase. A questionnaire was sent to all DOs. Currently, 19 notices of incompatibility, 8 of the top 10 DOs still have a notice of incompatibility. The DOs are invited to review their national law. In Circular C. PCT 1372, draft modifications to the PCT Receiving Office Guidelines to provide further guidance on the interpretation of the “due care” and “unintentional” criteria have been proposed.



The **USA** stated that with a recent passage of PLT implementing legislation, the notice of incompatibility is expected to be withdrawn in the foreseeable future.

Sweden fully supports the recommendations of the International Bureau.

Japan is also supportive and indicated that it may drop its notice of incompatibility in the future.

Israel also voiced support and favors clear guidelines to ROs

The **EPO** supports an initiative to invite offices to withdraw notices of incompatibility.

Switzerland endorses the efforts of the International Bureau.

EL Salvador agrees with the recommendations.

Spain announced its withdrawal of the notice of incompatibility in the near future.

China maintains the notice of incompatibility but supports giving clear guidelines to ROs.

Mexico also maintains its notice of incompatibility. In light of the results in this document, the Delegation will endeavor to transmit the results of the IB study to the authorities so that a withdrawal is considered.

AAPA offers assistance with regard to the interpretation of “due care” and “unintentionality”.

AIPLA asked about the status of the draft guidelines in Circular C. PCT 1372 .

The **International Bureau** responded that recommendations will come soon.

AGENDA ITEM 20 SUPPLEMENTARY INTERNATIONAL SEARCH (PCT/WG/6/5)

The **International Bureau** summarized the paper. It was mentioned that since May, the Nordic Patent Institute offers a Supplementary Search focused on documents in a Scandinavian language. Since initiation of the program, the grand total of requests for Supplementary Search is 169. The International Bureau continues its efforts to raise the awareness of the users.

The **EPO** declared that it is very supportive of the system. It has no intention to change the scope of the search. The low numbers are due to a lack of awareness among users. The main feedback from the users indicates that it is vital that the three big Asian offices join.

The **NPI** is of the opinion that the low outcome of the Supplementary Search is due to a lack of awareness of the users. NPI offers a search in Scandinavian languages at 1/3 of the price of a regular search.

The **USA** stated that it supported the initial establishment. The clear lack of usage is disappointing. The USPTO has started projects to increase user awareness.

The **United Kingdom** supports the Supplementary Search System and also any expansion of it.

Israel pointed out that the low outcome may be a result of the Supplementary Search being too expensive. The Supplementary Search should focus on deficiencies and not replicate the basic search. Currently, there is no option for Asian languages. Israel is supportive of the system, but will not offer the service itself.

China continues further monitoring and further reviewing of the system. China may offer the service in the near future.



Japan wants to create awareness using seminars. It is further noted that any change of form letters will take a certain period of time. It is desirable to discuss the inclusion of standardized text if the Supplementary Search is to be upheld.

Russia suggested applying a PPH for applications for which a Supplementary Search was requested. Any standardized text should be prepared centrally, e.g. by the IB, and presented to the MIA or to the Assembly.

Korea is in general supportive of Supplementary Searches; however, the KIPO has no intention of offering Supplementary Search services.

Australia said it is not offering Supplementary Search services.

FICPI remarked that the low success rate may not only be due to a lack of awareness. It is ingrained in the patent system that any search that goes beyond what is required is paid for by competitors when looking at third party observations, opposition and nullity or cancellation proceedings.

JIPA pointed out that the users decide upon quantitative criteria and weigh the costs against the benefits.

AGENDA ITEM 21 EVALUATION REPORT ON THE COLLABORATIVE SEARCH AND EXAMINATION (CS&E) SECOND PILOT PROJECT (PCT/WG/6/22)

The **EPO** presented a summary of the paper. The pilot project seems to be well received by the examiners. A lot of the current evaluation is drawn from their subjective opinions. As a quantitative measure, more X and Y documents have been drawn up. Trust between the Examiners was built and the examination result was felt to have been improved.

Korea stated that it participates in the Collaborative Search and Examination project. In the course of this project, eight examiners handled 137 applications. It was deemed that the results in 90 % of these cases have been improved.

The **USA** gave its feedback which was missing in the paper PCT/WG/6/22. It was indicated that costs would not be likely to be increased because of time savings in the national phase. It was further remarked that the distribution of unpublished papers beyond the ISA needs the consent of the user. In most pilot cases, additional X and Y references were found.

Japan continues to watch the process and anticipates a user-driven third user pilot. Some disadvantages with regard to fees and timeliness are envisaged. The PCT Kaizen system would allow identification of the elements that should be further strengthened.

China acknowledges the pilot project and hopes that the participating offices will provide more information.

El Salvador considers the Collaborative Search and Examination very useful in terms of quality.

JIPAA requested that the quantitative data should be openly accessible to users. To analyze the effects of the Collaborative Search and Examination, quantitative measures need to be provided and evaluated.

FICPI stated the Collaborative Search and Examination is strongly supported as it is felt that it will be the most efficient step towards increasing efficiency. However, the fees will be crucial for success. Given the positive effects in the national phases, the system could be cost-neutral if the costs of both



the international and national phases are considered. There must be clear benefits if the Collaborative Search is offered as an optional service as otherwise it will be as “successful” as the Supplementary Search. Finally, there are issues that need to be resolved such as translations e.g. if a document in a non-official language of the ISA is considered as relevant prior art and that an evaluation of documents is made by examiners in offices under foreign jurisdictions and case law, where even the representative may not be allowed to act. Any result of a Collaborative Search will be a strong document, which will better be noted by applicants and interested users. Therefore, it will not matter whether the result of the Collaborative Search and Examination will have a binding effect in the international or national phases as long as it is publicly accessible.

APAA and **AIPLA** are also in favor. Concerns were voiced with regard to the handling of data prior to publishing, with regard to fees. Better quantitative data will be needed.

The **EPO** stated that quantitative data are still in the evaluation phase as the results from the national phases have to be awaited for the pilot cases. It is thus too early to evaluate synergetic effects. The transfer of unpublished documents to non-ISA or non-IPEA offices should not be problematic if the users are able to explicitly opt in.

AGENDA ITEM 22 THIRD PARTY OBSERVATIONS (PCT/WG/6/6)

The **International Bureau** summarized the contents of the paper. User feedback was positive. Most users, however, noted that the restriction to 500 words for the “brief explanation of relevance” is insufficient. A preview function has been added to allow the third parties to see how their observations will appear after submission. The IB wishes to propose a system which encourages Patent Offices to make as much of their patent document collection available as possible in formats which allow the technical information to be searched and read in as many languages as possible. This would best be achieved by allowing an automatic right for Offices to have their patent documents included in the minimum documentation.

The **EPO** commented that the system seems to work fine, but there are problems with translations. In some cases, the EPO invited the third party to file translations of their third-party observation in the international phase. The limitation to 500 words seems justified. However an extension to issues beyond novelty and inventive step should be envisaged.

The **USA** continues to monitor the system and will provide information from the national phase.

Australia has not yet the capacity to receive third party observations other than through PATENTSCOPE. It has just received the first observation of a third party.

China encourages the public to make use of the system.

Chile regards this as a relevant issue. The system should be distributed so that information can be received in the national phase.

El Salvador welcomes the initiative, which will be very useful.

The **Chair** asked the Secretariat what happens to an observation that does not relate to novelty and inventive step.

The **Secretariat** responded that if an observation is rejected, an email is sent back to the observer that the observation is rejected and a reason for the rejection is given. The observation is treated as if it never existed.



JIPA noted that the effect in the various jurisdictions is not clear. Results of a survey on the effects in the national phase should be provided on the web site.

The **Secretariat** stated that the problem of the DOs having limited access to an observation filed in the international phase will be addressed. Documents will be available to DOs through the WIPO CAE (Centralized Access to Search and Examination) System. The system will be made more active. Third party observations are also considered on/from the ePCT platform.

The **Chair**, in its function as head of the ISA section of IP Australia noted that the observations should best be available to an examiner at an early stage.

AGENDA ITEM 23 PCT SEQUENCE LISTING STANDARD (PCT/WG/6/7)

The **EPO** summarized the paper as Task Force Leader of the Committee on WIPO Standards (CWS). The draft of the new standard is expected to be finalized in summer 2013 ready for adoption by the CWS.

The **USA** confirmed this timeline.

Japan stated that the suggested roadmap is supported.

AGENDA ITEM 24 PCT MINIMUM DOCUMENTATION (PCT/WG/6/9)

The **International Bureau** summarized the contents of the paper.

The **Chair** points out the three questions under paragraph 13 of the paper and invited comments on these questions.

The **EPO** points out that written input has been submitted to the task force with regard to these questions.

Korea was of the opinion that the PCT Minimum Documentation should be expanded and that machine translation services should be considered. The IB is encouraged to further study this issue. As a standard for the documentation, not only ST.36, as stated in the paper, but also ST.69 should be allowed for the documentation. Finally, the collections should be regularly updated.

The **USA** stated that these questions have already been taken into account. Sometimes an expansion is not efficient as some collections are duplicated. Also, ST.69, and not only ST36, should be mentioned.

According to **China**, the scope of documentation should be clear after expansion.

El Salvador asks that the task force continues working on these issues. At the next meeting of the task force, more information on decision-making is requested. Further, more consideration should be given to costs and cost effectiveness.

AGENDA ITEM 25 REVISION OF WIPO STANDARD ST. 14 (PCT/WG/6/21)

The contents of the paper were summarized by the **International Bureau**.



The **Chair** mentioned that no discussion is needed. Comments should be made in the light of the questions put forward to the Committee on WIPO Standards (CWS), paragraph 23 (a) to (i) of PCT/WG/6/8 ANNEX.

The **USA** agreed that the new standard will decrease confusion. However, a clear transition will be necessary, after which category X is no longer used and before which categories N and I are not yet used. A simultaneous use of the categories X, N and I may be confusing and may lead to inconsistencies among the authorities. Further, the **USA** supports the option that the citation categories E and O are to be used in conjunction with the other codes, as E and O are not indicative of relevance. Towards this aim, the **USA** have suggested in the CWS rephrasing paragraph 11 (a) of the ANNEX.

Canada supported discontinuing the use of category X. Citation categories E and O should be combined with other citation categories.

Japan was of the opinion that before discussing a transition period, it should be determined whether the suggestion is acceptable to the offices. There is some merit, however, in a transitional period which should be as short as possible. **Japan** also agrees that there might be no transition period.

The **EPO** was in support of **Japan**. The category X has some merits: if there are many claims, it may be a burden to the Examiner to split up the individual claims into the N or I category. The **EPO** was further surprised regarding how the status of the CWS task force is interpreted and asks for clarification by the Secretariat.

Australia supported Canada and the USA in that a clean transition period is needed, rather than maintaining a mixture.

AIPLA supported the position of US.

The **Secretariat** responded to EPO's question regarding the state of the discussion in the task force of CWS

AGENDA ITEM 26 OTHER MATTERS

PCT/WG/6/Paper No. 3 – PROMOTING THE USE OF CHAPTER II OF PCT TO IMPROVE PATENT QUALITY –, which was submitted as a Discussion Paper by **Brazil**.

In this paper, **Brazil** suggested boosting a more frequent use of Chapter II by granting Designated Offices the right to request from applicants the submission of an IPRP as a condition for entering the national phase. More specifically, the following cases should allow a Designated Office to require the submission of an IPRP as a condition for entering the national phase:

- a) when all of the claims in the international application do not appear to satisfy the patentability criteria according to the Written Opinion;
- b) when part of the claims do not appear to satisfy the patentability criteria and such claims are not withdrawn by applicants;
- c) when the applicant files amendments under Article 19 or in the national phase entry; and
- d) when there is a suggestion by the ISA/IPEA to amend the claims and such amendments are not carried out by the applicant.



Brazil suggested that the IB should prepare a legal opinion regarding the necessity of amending pertinent PCT provisions.

The **USA** responded to that proposal that the PPH system already considers economical reasons and that only the applicant may request Chapter II proceedings. The current state whereby Chapter II is not mandatory anymore was created to reduce the burden on applicants and offices. Moreover, many of the items put forth by Brazil are reflected by the 20/20 proposal. Improvements to the systems should rather be made by incentives for the applicants, such as speed and fees. Finally, it was questioned as to whether indeed only moderate adoptions of PCT will be necessary to implement **Brazil's** suggestions.

Chile requested more time to study the proposal. It is feared, however, that the proposed changes may overload the system. The topic needs to be discussed in depth during the next Working Group meeting.

AIPLA did not support **Brazil's** proposal. Likewise, **APAA** disagreed with the proposal to give national offices the right to request International Preliminary Examination; the limited use of Chapter II by applicants shows that it is not attractive.

Japan noted that the proposal is interesting and that there was not enough time to consider any details. It is hoped that detailed discussions will be possible at the next Working Group meeting.

The **Secretariat** pointed out that the PCT Roadmap already makes recommendations related to efforts to make the use of Chapter II more attractive and that the proposal by Brazil should be seen in that light. 10 years ago, there was a strong incentive for using Chapter II because an additional 10 months could be gained in the international phase. In the current regime, chapter II should be made more attractive. However, the Secretariat had doubts whether the IPRP can be made a condition for national phase on the PCT level. A particular country, however, may require, in its national provisions, an IPRP for entry into national phase.

Brazil noted that there is agreement that chapter II should be used more frequently. As to the necessary changes to the PCT to implement the proposal, a legal opinion from the IB is requested.

The **Chair** noted the willingness of the Secretariat to discuss and bring forward a new paper.

AGENDA ITEM 27 SUMMARY BY THE CHAIR

The Summary provided by the Chair in an already revised version as PCT/WG/6/23 PROV. 1 was proposed. Major discussions evolved around AGENDA ITEMS 3, 8, 10, 13 and 26.

It was decided that the Secretariat provide a full report of/on the meeting in both English and French.

Brazil repeated its motion to improve the quality of the MIA report for the working group (AGENDA ITEM 6).

More interesting to us, there was a discussion in relation to paragraph 22 of AGENDA ITEM 8 (REQUIRE RESPONSE TO NEGATIVE COMMENTS AT THE NATIONAL PHASE) between the **EPO** on one hand and the **USPTO/UK** on the other. The EPO required a clarification that the 20/20 proposal was amended as compared to its previous version (as in Circular C. PCT 1360).

With regard to AGENDA ITEM 13, it was discussed whether the Summary of the Chair truly reflected the intent and scope of the study, which will be conducted by the WIPO's chief economist concerning



the fee elasticity with regard to SMEs, universities and developing as well as least-developed countries.

AGENDA ITEM 28
CLOSING OF THE SESSION

The Chair closed Working Group session 6.

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