

WIPO



PCT/WG/2/14

ORIGINAL: English

DATE: July 24, 2009

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

**PATENT COOPERATION TREATY (PCT)
WORKING GROUP**

**Second Session
Geneva, May 4 to 8, 2009**

REPORT

adopted by the Working Group

INTRODUCTION

1. The Patent Cooperation Treaty Working Group held its second session in Geneva from May 4 to 8, 2009.
2. The following members of the Working Group were represented at the session:
(i) the following Member States of the International Patent Cooperation Union (PCT Union): Algeria, Angola, Australia, Austria, Barbados, Bosnia and Herzegovina, Brazil, Canada, Chile, China, Colombia, Congo, Costa Rica, Côte d'Ivoire, Cuba, Czech Republic, Denmark, Dominican Republic, Ecuador, Egypt, El Salvador, Finland, France, Germany, Ghana, Guatemala, Hungary, India, Indonesia, Israel, Italy, Japan, Kazakhstan, Latvia, Lithuania, Malaysia, Mali, Mexico, Morocco, Norway, Papua New Guinea, Peru, Philippines, Poland, Portugal, Republic of Korea, Romania, Russian Federation, Senegal, Singapore, South Africa, Sri Lanka, Sweden, Switzerland, Tunisia, Turkey, Uganda, Ukraine, United Kingdom, United States of America, Zambia, Zimbabwe (62); (ii) the European Patent Office (EPO).
3. The following Member States of the International Union for the Protection of Industrial Property (Paris Union) participated in the session as observers: Argentina, Burundi, Djibouti, Jamaica, Lebanon, Nepal, Thailand (7).

4. The following intergovernmental organizations were represented by observers: African Intellectual Property Organization (OAPI), African Regional Intellectual Property Organization (ARIPO), Eurasian Patent Organization (EAPO), European Community, Nordic Patent Institute (NPI), Patent Office of the Cooperation Council for the Arab States of the Gulf (GCC), South Center, World Trade Organization (WTO) (8).

5. The following international non-governmental organizations were represented by observers: Asian Patent Attorneys Association (APAA), CropLife International, Exchange and Cooperation Center for Latin America (ECCLA), International Association for the Protection of Intellectual Property (AIPPI), International Federation of Industrial Property Attorneys (FICPI), Institute of Professional Representatives Before the European Patent Office (EPI), Knowledge Ecology International (KEI), Third World Network (TWN), Union of European Practitioners in Industrial Property (UNION) (9).

6. The following national non-governmental organizations were represented by observers: American Intellectual Property Law Association (AIPLA), German Association for the Protection of Industrial Property and Copyright (GRUR), Japan Patent Attorneys Association (JPAA), Japan Intellectual Property Association (JIPA), Intellectual Property Institute of Canada (IPIC) (5).

7. The list of participants is contained in the Annex.

OPENING OF THE SESSION

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

ELECTION OF A CHAIR AND TWO VICE-CHAIRS

9. The Working Group unanimously elected Mr. Alan Troicuk (Canada) as Chair for the session, and Mr. Yin Xintian (People's Republic of China) and Mr. Gennady Negulyaev (Russian Federation) as Vice-Chairs.

ADOPTION OF THE AGENDA

10. The Working Group adopted as its agenda the draft contained in document PCT/WG/2/1 Rev. 2¹.

THE FUTURE OF THE PCT: GENERAL COMMENTS

11. Discussions were based on documents PCT/WG/2/3, 8, 11 and 12.

12. At the suggestion of the Chair, the Working Group first considered the general issues set out in document PCT/WG/2/3, prepared by the International Bureau, and then considered proposals made by Japan, the Republic of Korea and the United States Patent and Trademark Office, respectively, set out in documents PCT/WG/2/8 (see paragraphs 69 to 75, below), PCT/WG/2/11 (see paragraphs 76 to 83, below) and PCT/WG/2/12 (see paragraphs 84 to 89,

¹ This and the working documents for the session are available on WIPO's website at http://www.wipo.int/meetings/en/details.jsp?meeting_code=pct/wg/2.

below), before resuming consideration of the overall approach to the general issues addressed by the draft roadmap set out in document PCT/WG/2/3 (see paragraphs 90 to 98, below).

13. The Director General noted that the PCT was the backbone of the international patent system, increasing year by year both in the absolute numbers of applications filed (reaching more than 163,000 in 2008) and the proportion of all international patent filings (now accounting for over 50% of such filings). It was not clear exactly what effect the present global financial crisis might have, but so far the level of use of the PCT remained very high. The PCT represented a procedural web, internationalizing certain processes, but leaving it up to individual States to decide on the actual grant. The PCT procedure allowed applicants, Offices and third parties all to be better informed. It was particularly important for developing countries, which relied to a high degree on reports prepared during the international phase of the procedure. There had been many changes over recent years, including the 5 year process of PCT reform, the number of International Authorities increasing to 15, and the number of languages of publication increasing to 10. An increasingly electronic environment, including e-filing and data exchange between Offices, had resulted in considerable improvements in efficiency. The PCT system made an increasing amount of information available to the world, including full file information for international applications which were now being filed.

14. The Director General observed, however, that despite these improvements, the system was still not working as originally intended. Document PCT/WG/2/3 laid out a diagnosis of the problem, which had been developed through informal consultations with Offices and users and through discussion in the Meeting of International Authorities under the PCT. It set out a roadmap which the International Bureau believed to represent a good way forward to ensure that the principles of the Treaty were upheld and that the work products of the PCT met the needs of applicants, Offices and third parties as international applications entered the national phase.

15. A number of delegations and representatives of users emphasized the importance of the PCT for business and States and recognized the need for action to improve the system to address issues, including excessive backlogs of work in some Offices and the quality of granted patents. They broadly welcomed and supported the principle of the roadmap as a way of organizing work and addressing the critical needs of the PCT system quickly within the existing legal framework, subject to various comments and concerns set out below.

16. There was general consensus that ensuring high quality of PCT work products was essential. These should support rapid resolution of rights and encourage a reduction in duplication of work. However, it was pointed out that duplication could not be eliminated entirely and, as further noted in paragraphs 24 and 34, below, it needed to be made clear what exactly was meant by “duplication” of work, noting particularly that Contracting States were entitled to prescribe their own conditions of patentability. Furthermore, it was observed that a certain degree of deliberate duplication might sometimes be considered desirable by applicants. For example, an applicant might prefer to have two independent searches by different Offices thereby increasing confidence in the overall result. One representative of users observed that in order to achieve practical progress, account might also need be taken of the political reality that some Offices wished to maintain a critical mass of work to maintain themselves as effective examining Offices.

17. Several representatives of users emphasized that unnecessary duplication was expensive and that the cost of such duplication had to be borne by applicants. This was something which the PCT had explicitly aimed to reduce from the outset.

18. Reduction in unnecessary duplication required an increase in quality, in trust between Offices, and in understanding of the ways and extent to which any search (not only international searches) by one Office could be reused by other Offices. It was commented that International Authorities needed to develop confidence not only in their own work but also in that of other International Authorities. One delegation commented that reduction of duplication was a high priority in general, not only within the PCT, for addressing the challenges of large numbers of applications, and that for this reason it also supported other projects with equivalent goals, notably the Patent Prosecution Highway.

19. It was suggested that WIPO should conduct further work on quality and on matters such as machine translation of national search reports in order to facilitate and encourage the use of PCT work products.

20. One delegation expressed the desire that any plan to develop the PCT should include measures to enlarge the scope of the work-sharing through the PCT by attracting applications filed outside the PCT into the PCT system, for example by introducing accelerated PCT procedures and providing various additional options.

21. It was emphasized that the most critical matter was the quality of the international search: this provided the foundation for the subsequent processing of the application. The written opinion under Chapter II was also considered important, but some delegations suggested that work on improvement should first concentrate on the written opinion of the International Searching Authority under Chapter I since this was established in all cases whereas Chapter II reports were only established on about 10% of international applications. One representative of users commented that all international reports would be used to a greater extent if issues had been able to be more fully argued: not only novelty and inventive step, but also other matters such as clarity and support for the claims.

22. It was also suggested that WIPO should develop a policy with regard to small and medium sized enterprises within the PCT.

23. It was observed that the quality and efficiency of search and examination depended also on the quality of the incoming applications, and that applicants also needed to play their part in improving quality.

24. A number of delegations considered that there were some fundamental issues which needed to be clarified before the work program proposed in document PCT/WG/2/3 could proceed. Notably, it was essential to be clear as to the scope of the project: whether this was being conducted within the principles of the existing Treaty, or was moving in the direction of a new one. Furthermore, a number of terms needed appropriate definition, especially “duplication”. It should not be implied that all national search and examination work was undesirable. It was essential to be clear that it was both acceptable and desirable for national Offices to conduct whatever work was considered necessary in order to properly determine whether the specific requirements of their national laws were met by applications. IP protection was not an end in itself but a policy tool which needed to meet the specific needs of States at different levels of development. Consequently there remained a need for different criteria for patentability in different States. Those delegations indicated that some of the

proposals appeared to imply a move towards *de facto* harmonization, and emphasized that they could not support any measures which moved towards increased harmonization of substantive patent law, whether directly or as a result of enforcement of new standards through the effect of free trade agreements. The need for any norm-setting activities to comply with recommendations 15² and 17³ of the WIPO Development Agenda was emphasized. It was also observed that the idea of removing reservations went against the rights under Article 64 to maintain such reservations.

25. The Director General emphasized that the PCT was a procedural Treaty which explicitly stated in Article 27(5) that it should not “be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires.” Articles 27(6), 33(1) and 35(2) reinforced this message, making it clear that any international report was non-binding and was not to contain any statement on the question whether the claimed invention was or seemed to be patentable or unpatentable according to any national law. This flexibility at the national level was an important factor in the success of the Treaty that had allowed it to be adhered to by, at present, 141 Contracting States. It was explicitly stated in document PCT/WG/2/3 that the process envisaged by the International Bureau was to improve the system within that existing framework and not to address matters of substantive patent law harmonization or of a unified “international patent”.

26. Furthermore, the Director General noted that the “reservations” which the International Bureau considered important to address related to incompatibilities which States or Offices had notified in respect of certain procedural matters introduced during the process of PCT Reform, rather than the reservations provided for in Article 64. Nevertheless, there was room to clarify and emphasize these matters within the draft roadmap itself to make the proposed scope of the exercise fully clear.

THE FUTURE OF THE PCT: DRAFT ROADMAP

27. The Working Group continued discussion of document PCT/WG/2/3 by considering the specific topics set out in the roadmap in Annex I to that document.

General Principles (paragraph 1, Annex I of document PCT/WG/2/3)

28. A number of delegations expressed concerns that the draft roadmap might be seen as a move in the direction of issues going beyond the existing legal framework of the Treaty, such as harmonization of substantive patent law, mandatory effects of international reports in the national phase and legal presumptions of validity. While those delegations, like others, recognized the importance of ensuring that the Treaty was properly implemented and

² Development Agenda Recommendation 15: “Norm-setting activities shall be inclusive and member-driven; take into account different levels of development; take into consideration a balance between costs and benefits; be a participatory process, which takes into consideration the interests and priorities of all WIPO Member States and the viewpoints of other stakeholders, including accredited inter-governmental organizations (IGOs) and NGOs; and be in line with the principle of neutrality of the WIPO Secretariat.”

³ Development Agenda Recommendation 17: “In its activities, including norm-setting, WIPO should take into account the flexibilities in international intellectual property agreements, especially those which are of interest to developing countries and LDCs.”

functioned effectively, they emphasized the importance of a step-by-step approach within the existing legal framework.

29. The Secretariat emphasized that a move in the direction of issues going beyond the existing legal framework of the Treaty was not at all the intention of the document. Any compulsory binding effect of international reports, or requirement to set specific standards of substantive patent law, was expressly excluded by the Articles of the Treaty. As was stated in paragraphs 11 and 29 of the document, it was the specific intention of the International Bureau that this process should not address such matters and rather that improvements to the functioning of the PCT should be sought within the scope of the existing legal framework. However, the Secretariat agreed that some of the terminology used in the draft roadmap might be open to different interpretations. The term “high presumption of validity” in particular had not been intended to mean a legal presumption but rather to indicate that the patent application had been through a high quality process to identify relevant prior art and other matters before a patent was granted. The Secretariat consequently proposed the following redrafted text of the general principles as set out in paragraph 1 of Annex I to document PCT/WG/2/3 in order to clarify those matters. It was pointed out that, if acceptable, changes of a similar nature would need to be made throughout Annex I.

“1. Work towards developing the PCT should seek to meet the needs of *all* of the interested parties guided by the following principles:

“(a) an incremental approach should be followed, commencing with efforts to make more effective use of the PCT within its existing legal framework;

“(b) without limiting the freedom of Contracting States to prescribe substantive conditions of patentability and to provide for national and regional Offices to perform functions to that end, duplication of work should be minimized: defects in international applications should be identified and eliminated early (in the international phase, where possible) and Offices should seek to eliminate procedures which encourage or result in unnecessary duplicative processing;

“(c) the system must deliver results (especially search reports, international publications and international preliminary examination reports) which meet the needs of applicants and designated Offices of all types (large and small, examining and non-examining), and which assist Offices in ensuring rapid resolution of rights in the national phase;

“(d) the system must be accessible to applicants of all types from all Contracting States;

“(e) the quality of the work undertaken by International Authorities, especially international search work, should be of a high standard such that it commands confidence and reliance among Offices, applicants and third parties;

“(f) unnecessary actions for Offices and applicants should be eliminated;

“(g) information relating to international applications should be available as freely and efficiently as possible.”

30. The Secretariat also emphasized that the proposals contained in the roadmap were intended to establish a program of study and investigation rather than seeking decisions as to specific actions to be taken, together with an indication of the timeframe within which results should desirably be achieved.

31. Many delegations welcomed this clarification, which offered a useful and balanced way of addressing problems quickly and effectively within the existing legal framework. It was reiterated that the problems of patent examination workload and quality of that examination faced by Offices in a number of both developing and industrialized countries were now such that delay in taking mitigating action would have serious consequences for the effective functioning of the PCT system, with consequent practical and financial effects for both applicants and third parties. It was observed that applications by applicants in certain developing countries made up an increasingly significant number of the affected cases. Representatives of users, especially, expressed their belief that effective and immediate action was essential.

32. Nevertheless, many delegations retained concerns on a variety of matters, as outlined below. Some delegations considered that the nature of those concerns was such that it would be necessary to give further consideration to the proposals and to seek views from stakeholders before they could be presented to the Assembly. Others considered that their concerns could be addressed by appropriate clarifications in the wording of the roadmap.

33. Such clarifications should make it clear, in particular, whether the milestones set out in the roadmap were intended to be mandatory targets or goals for best endeavor. Moreover, the need for, and the wording of, the associated formal resolutions and statements set out in document PCT/WG/2/3, paragraphs 33 to 35, should be reviewed in the light of the concerns raised.

34. A number of delegations expressed concern at the lack of definition of the term “duplication”. This term was defined for one specialized purpose in paragraph 2 of the draft roadmap, but was a key term in the proposed general principles and other places in the roadmap, for which additional matters would need to be considered. It should be recognized, for example, that it was entirely appropriate for a designated Office to conduct a new search in the light of the criteria for novelty and inventive step applicable under its national law relating to the particular kind of subject matter covered in a patent application (noting that Contracting States were free to prescribe such substantive conditions of patentability as they desired), or in order to search databases in languages which would not have been consulted properly in the international search. There might thus be some cases where a certain amount of duplication was actually desirable.

35. The Secretariat explained that the issues listed in paragraph 2 of the draft roadmap were only intended to apply to the specific case where the same Office was acting as both International Searching Authority and designated Office for a particular application. There was no intention that the right of other designated Offices to conduct whatever search they considered necessary should be removed. It agreed that, if a general definition of duplication needed to be included, these issues would need to be addressed and careful consideration would need to be given to what other matters would be relevant.

36. One delegation suggested that the term “unnecessary actions” in paragraph 1(f) of the redrafted text of the general principles as set out in paragraph 1 of Annex I to document PCT/WG/2/3 be further clarified.

37. One delegation stated that the fact that the roadmap consisted mainly of areas for study and discussion rather than proposing specific concrete actions meant that it needed further consideration before being put to the PCT Assembly.

38. One delegation considered that the contents of the roadmap were so closely bound to the related resolution that the two should be completely merged, rather than one being merely annexed to the other.

39. The Director General emphasized that the roadmap was not a completely new proposal, but represented the latest stage of a process which had begun in the PCT Assembly in 2006 with document PCT/A/35/5 entitled “Quality of International Searches”. The process had continued with more concrete identification of specific concerns and challenges in documents titled “Enhancing the Value of International Search and Preliminary Examination under the PCT” that were presented in 2008 to the Meeting of International Authorities (document PCT/MIA/15/2) and the PCT Working Group at its previous session (document PCT/WG/1/3). The essential contents of document PCT/WG/2/3 had been presented as drafts in February 2009 for informal discussion by the Heads of the 20 largest receiving Offices and to representatives of users, and had been published as document PCT/MIA/16/9 for discussion by the Meeting of International Authorities at its recent session in March 2009.

Area of Work: Compliance and Consistency

- *Repetition of search by designated Office which acted as International Searching Authority (paragraph 2, Annex I of document PCT/WG/2/3)*

40. The Delegation of Japan stated that it fully supported the aim of building confidence among Offices in the work carried out by another Office by assuring that a designated Office in the national phase did not repeat work performed by the same Office during the international phase in its capacity as an International Authority, subject to certain specified exceptions, such as those set out in document PCT/WG/2/3, Annex I, paragraph 2. In this context, and with reference to its proposal set out in document PCT/WG/2/8 to encourage parallel processing of applications based on an early national phase entry, which is actually already used (Article 23(2)), before the Office which acts as International Searching Authority, the Delegation, supported by a number of other delegations, proposed that this “area of work” be amended by adding the following milestone to the roadmap: “*Milestone:* For International Search Authorities and International Preliminary Examination Authorities to conduct parallel processing of international application as ISA/IPEA and early national entry application as DO where applicable.” The Delegation also proposed that the last sentence of paragraph 2 of that Annex be amended for the sake of clarity in view of the early-entry option in Article 23(2) by deleting the word “later” so that the question of not repeating the work can cover not only the traditional first search by the International Searching Authority and later work by the designated Office, but also early national phase entry where the work of the designated Office may be conducted earlier or together with the international search.

41. Several delegations stated that they fully supported the objective of eliminating duplication of work within the same Office acting as both International Searching Authority and designated Office in respect of an international application, which was of key importance towards building confidence among Offices in the work carried out by another Office. Some delegations representing Contracting States whose Offices acted as International Authorities stated that they already adhered to the principle that they carry out work, to the greatest extent

possible, only once, during the international phase, and to fully rely on that work during national phase procedures.

42. In this context, two representatives of users, referring to PCT Article 15(4), which required International Authorities to endeavor to discover as much of the relevant prior art as its facilities permitted, stated that there should be no difference between the search carried out by an Office in its capacity as an International Authority and a search carried out by the same Office in its capacity as a national Office; in each case, the Office should strive to carry out the work only once, to the highest possible standard.

43. One delegation representing a Contracting State whose Office acted as an International Authority stated that, while it supported the principle of this aim, it did not see itself in a position to commit to implementing it within a fixed period of time, noting that the Office was undergoing an extensive review of internal procedures which needed to be completed first. It thus indicated that it wished to avail itself of the possibility to declare an exception to the implementation of this aim by January 1, 2010, as set out in the “milestone” set out in document PCT/WG/2/3, Annex I, paragraph 2.

44. One representative of users, supported by one delegation, suggested that the aim of non-repetition of work done by the same Office in different capacities should be broadened to cover not only the case of a national phase entry of an international application before a designated Office which had also acted as the International Searching Authority but also all cases where corresponding applications were pending before the same Office, for example, where, in the United States of America, an applicant used the so-called “by-pass route” to file a continuation or continuation-in-part of a co-pending international application, or where an application claimed the priority of an earlier application filed with the same Office.

45. Several delegations expressed concerns as to the aim of “avoidance of duplication” and the meaning of the term “duplication”, noting that duplication of work, even by the same Office, was sometimes not only useful but even required, beyond the exceptional circumstances set out in document PCT/WG/2/3, Annex I, paragraph 2.

46. One delegation, supported by several other delegations, suggested that the exceptions should be amended to include language along the lines of the proposals by the Secretariat for the amendment of paragraph 1(b) of the “General Principles” part of the roadmap (see paragraph 29, above), clarifying that the aim of avoiding duplication of work would not in any way limit the freedom of Contracting States to prescribe substantive conditions of patentability and to provide for national and regional Offices to perform functions to that end, including carrying out duplicative national searches.

47. Another delegation, supported by several other delegations, stated that, while it was fully committed to the overall objective of making more effective use of the PCT, it had concerns about certain elements of the roadmap which may have an impact on national Offices’ flexibilities with regard to substantive conditions of patentability. The delegation suggested that, rather than rushing ahead with the proposed adoption by the Assembly of a formal resolution and statements by Offices concerning implementation of the roadmap, setting out specific actions and milestones, further studies and investigations should first be undertaken on some of the issues raised in the draft roadmap, such as, for example, whether duplication of work among Offices was indeed one of the reasons for the backlogs of Offices and what could be done to mitigate those backlogs.

48. The Secretariat stated that nothing in the roadmap, and none of the suggested areas of work set out in the roadmap, was intended to limit in any way the flexibilities of Contracting States permitted under the Treaty, such as in Article 27(5) which stated that “[n]othing in the Treaty and the Regulations is intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires” and in Article 33(5), which stated that “[t]he criteria described above [novelty, inventive step, industrial applicability] merely serve the purposes of international preliminary examination. Any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed invention is patentable or not.” It furthermore stated that the intention had not been to generally define the question as to what constituted “duplication” within the international patent system but merely to address the very specific issue of duplication of work by an Office which acted as both an International Authority and as a designated Office under the PCT.

- *Review by Offices of existing notifications of incompatibilities (paragraph 3, Annex I of document PCT/WG/2/3)*

49. Several delegations supported the aim of initiating a review by Offices of existing notifications of incompatibilities as a “good housekeeping exercise” and stated that they had either already commenced (or even completed) such a review or would commence shortly.

50. One delegation, while it generally supported the aim of such an internal review by Offices, noted that not all existing notifications of incompatibilities were, in its view, of a merely procedural nature. Some of those notifications had substantive elements, such as notifications of incompatibilities by Offices with regard to the compliance with PCT provisions concerning the incorporation of missing elements or parts in the international application, which could have an impact on the question as to which filing date an international application should be accorded. It further stated that many of those notifications of incompatibilities were related to provisions which had been added to the PCT Regulations in the context of aligning the PCT requirements with those under the Patent Law Treaty (PLT), but the PLT had not been ratified by the majority of PCT Contracting States; this had resulted in the need for many Contracting States to avail themselves of the possibility to make such notifications.

- *Making international preliminary examination more complete, relevant and useful (paragraphs 4 and 5, Annex I of document PCT/WG/2/3)*

51. The Delegation of Japan stated that, while it supported the general principle that the quality of the work undertaken by International Authorities should be of a high standard such that it commanded confidence and reliance among Offices, applicants and third parties, as set out in paragraph 1(e) of the “General Principles” text as proposed to be amended by the Secretariat, it wished to reiterate its proposal, set out in document PCT/WG/2/8, to focus on the improvement of Chapter I international work products, notably, the international search. The Delegation suggested, supported by several representatives of users, that the title of this aim be amended to refer not only to making the international preliminary examination but also the international search more complete, relevant and useful. In this context, the Delegation referred to its proposal to establish the international search after international publication so as to be able to take into account third party observations and secret prior art, limiting the need to carry out top-up searches as part of the Chapter II procedure to those cases where the applicant had requested the international search report prior to international publication. The Delegation reiterated the gist of its proposal in document PCT/WG/2/8 and

proposed, supported by several representatives of users, that “areas of work” be amended by adding and amending milestones as set out in paragraph 40, above.

52. The Delegation of the Republic of Korea, referring to its proposals appearing in document PCT/WG/2/11, paragraph 12, suggested that this aim should be amended to include its proposal for accelerated search and examination as part of a three-track PCT system.

53. Several delegations and representatives of users expressed their general support for the aim set out in paragraphs 4 and 5 of document PCT/WG/2/3, notably the proposal that International Authorities be required to issue at least one written opinion prior to the issuance of a negative international preliminary report on patentability, at least in cases where the applicant had provided amendments or another form of substantive response to the written opinion by the International Searching Authority. Several delegations representing States whose Offices acted as International Authorities stated that this was already their practice.

54. Several representatives of users suggested that international preliminary examination should not include an additional search to find secret prior art, expressing concern that they would have to demand international preliminary examination and pay an additional fee in order to have secret prior art searched. They suggested that this might instead be achieved by extending the international search to cover secret prior art.

55. One representative of users suggested that international preliminary reports on patentability should always include an opinion as to lack of clarity and support of the claims, and that the roadmap be amended accordingly.

56. Several delegations suggested that, while they generally supported the aim of making international preliminary examination more complete, relevant and useful, further studies and investigations would be needed to fully understand possible implications of the suggested measures, and in this context expressed concerns about the inclusion of the statement, in paragraph 5 of Annex I to document PCT/WG/2/3, that the discussions should take place on how to make examination in the international phase more useful “such that more applications enter the national phase with a positive international preliminary report on patentability *and are likely to be found in order for grant without any further national action*”.

57. One delegation, supported by another delegation, requested the Secretariat to explain how the recommendations agreed upon in the context of the WIPO’s Development Agenda were being implemented in the context of further development of the PCT.

58. In response to a query by one delegation as to whether it was intended that International Authorities be required to respond to third party observations, the Secretariat stated that, while the details of any system allowing for the submission of third party observations were still to be discussed, there had been no intention that such responses be mandatory. In this context, several delegations stated that more discussions were needed on the possible details of such system, including whether the applicant should be entitled to comment on any such third party observations and the possible need for translations of such observations. One delegation stated that it wished to reserve its position on the proposal to set up a system allowing for the submission of third party observations, noting the possible impact on the pre-grant opposition system existing under its national law.

59. In response to a query by one delegation, the Secretariat provided background information on the “Patent Prosecution Highway” (PPH), a work sharing scheme set up

between several pairs of Offices under which an applicant could request accelerated examination in a participating Office of second filing based on the finding by the Office of first filing that a set of claims were allowable or patentable. The Secretariat explained that, at present, PPH work sharing arrangements between Offices were set up outside the PCT framework, so that accelerated examination could not be requested on the basis of international preliminary reports on patentability established under the PCT. This was due in particular to the perceived lack of quality of those reports, even where they were established by Offices acting as International Authorities whose national work products were accepted as a basis for PPH work sharing. The Secretariat noted that work sharing schemes such as PPH proved that work sharing among Offices could work if Offices had confidence in the quality of the work carried out by other Offices, further pointing to the urgent need to make more effective use of the PCT so that it could fulfill the original aim that the PCT be the central work sharing tool of the international patent system.

– *Eliminating Unnecessary Processing (paragraph 6, Annex I of document PCT/WG/2/3)*

60. One delegation suggested that the wording “eliminating unnecessary processing” for Offices and applicants be further clarified.

– *Collaborative International Search and Preliminary Examination (paragraph 7, Annex I of document PCT/WG/2/3)*

61. Several delegations welcomed the proposal for trials of collaborative international search and preliminary examination work as a meaningful step towards improving the quality of the international search which was worth further exploration. It was noted, however, that examiners in each of the participating Authorities would each still need to produce the highest possible quality search. Careful consideration would be needed of how to combine the results of the work effectively to produce a high quality combined search report: a simple mosaic of individual search reports would not be likely to produce the best final product. In this context, one delegation expressed the view that participating Offices should not form a single “virtual” Authority but rather should collaborate as independent individual Authorities. It was apparent that further discussions were needed to further develop the proposal on these and other aspects, such as workload of Authorities, costs for applicants and time limits for the establishment of the search report. Two delegations expressed an interest in participating in the envisaged pilot project.

62. One delegation stated that, while the proposal seemed attractive, it would obviously result in duplication of work by Authorities. There would be difficulties in working together and resolving differences of opinion. The delegation questioned whether a collaborative search could ever work in practice.

63. Other delegations expressed concerns about certain language used in paragraph 7, such as the wording “if an international application is found to meet the requirements of the PCT to the satisfaction of, for example, 3 Offices which meet appropriate international quality requirements for search and examination, *it ought to be safe* for any Office to consider that it would also meet its own examination requirements...”. It was noted that this could be interpreted as compromising existing flexibilities of national Offices to conduct whatever search and examination work they deemed necessary to determine whether the specific requirements of their national laws were met. While it was recognized that international reports were not binding on designated Offices, the language used in paragraph 7 seemed to impose the use of those reports on national Offices during national phase procedures. In this

context, delegations questioned how the participating Authorities were to be selected and whether it was the intention to deviate from the current procedure under which a receiving Office specified the Authorities competent to carry out international searches and preliminary examinations in respect of international applications filed with that Office. There was concern that small Offices might never be among the participating Offices. In general, delegations felt that more time and further studies were needed before the proposal could move ahead.

64. The Secretariat stated that there had been no intention to imply any limitation of the flexibilities of Contracting States permitted under the Treaty to decide the level and type of national search and examination required, and in this context referred to PCT Article 33(5), which stated that “[t]he criteria described above [novelty, inventive step, industrial applicability] merely serve the purposes of international preliminary examination. Any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed invention is patentable or not.” Rather, it had been intended to imply that it could be assumed that the *overall quality of testing the PCT requirements* would be higher under such an arrangement that was typically achieved at present by a single Authority.

– *Fees and Other National Measures (paragraphs 8 to 10, Annex I of document PCT/WG/2/3)*

65. One delegation stated that the level of fees set under the PCT should be reviewed to attract applicants who so far preferred to file applications via the Paris Convention route.

66. Another delegation expressed the view that the criteria for fee reductions for applicants from developing countries should be reexamined with a view to attracting small and medium sized enterprises and universities.

67. One representative of users expressed the view that further studies should be carried out to develop a “PCT lite” system under which applicants would benefit from lower fees where protection in only a few Contracting States was sought.

68. As had been suggested by the Chair (see paragraph 12, above), the Working Group decided to continue its discussions by considering the proposals made by Japan, the Republic of Korea and the United States Patent and Trademark Office, respectively, set out in documents PCT/WG/2/8 (see paragraphs 69 to 75, below), PCT/WG/2/11 (see paragraphs 76 to 83, below) and PCT/WG/2/12 (see paragraphs 84 to 89, below), before resuming consideration of the draft roadmap set out in document PCT/WG/2/3 (see paragraphs 90 to 98, below).

PROPOSALS TO ENHANCE THE QUALITY AND EFFICIENCY OF THE PCT ROUTE

69. Discussions were based on document PCT/WG/2/8, containing proposals by the Delegation of Japan.

70. The Delegation of Japan gave an overview presentation⁴ to the Working Group on its proposal to establish the international search report and the written opinion by the International Searching Authority after international publication, and to encourage parallel processing of applications based on an early national phase entry before the Office which acted as International Searching Authority, as set out in document PCT/WG/2/8. With regard to the former, the Delegation highlighted the importance of being able to cover secret prior art and to take into account observations by third parties submitted after publication, which would greatly enhance the quality of the work products established under Chapter I of the PCT procedure, to the benefit of users and Offices alike. In this context, it expressed the view that resources should be focused on improving those Chapter I work products rather than the international preliminary examination procedure under Chapter II, noting that the latter was used by only about 10% of applicants and that in terms of timing, the former could surely deliver service earlier than the latter, which was quite important for an applicant to analyze prosecution strategy at the earliest stage. In the view of the Delegation, the proposal to encourage parallel processing enhanced the efficiency and reduced duplication within an Office acting as both International Searching Authority and designated Office, in a similar way and in line with the aim, set out in the draft Roadmap in Annex I of document PCT/WG/2/3, not to repeat search work as a national Office where the same Office had already acted as the International Searching Authority.

71. Several delegations expressed general support for the proposal to establish international search report and written opinion by the International Searching Authority after publication, as an important possible means to enhance the quality of Chapter I work products and thus enhancing the confidence of national Offices in the quality of those work products as a basis for work sharing in the national phase. This concept was warmly welcomed by some representatives of users. Some of those delegations expressed the view that establishing the international search report after publication should only be an optional feature of the system, at the choice of applicants and only where the International Searching Authority concerned chose to offer establishment after publication. Other delegations, while generally supportive of the proposal, expressed concerns about having different time limits for the establishment of search reports and written opinions for different applications and stated that the same due date, after publication, should apply to all international applications. Several delegations pointed to the need to have appropriate safeguards in place which would prevent abuses under the proposed third party observation system, such as requiring the payment of a fee for the submission of observations or setting a limit as to the number of observations which may be submitted, and to the need for a careful design of a balanced system so as not to overburden applicants and Offices. A number of delegations expressed the view that implementation of the proposal should not lead to an extension of the overall time limit for national phase entry; the focus of the proposal should be on the enhancement of the quality of Chapter I work products, not on the Chapter II procedure.

72. Other delegations expressed concerns about the proposal, noting that it would constitute a significant change to the current PCT procedure, with publication of the international search report being one of the central features of the system, and would add to the overall complexity of the system. It was observed that the international search report was important for third parties to assist in assessment of whether the application was likely to proceed, or to proceed with amendments, into the national phase. Several delegations noted the impact of the

⁴ The presentation is available from the WIPO website at:
http://www.wipo.int/meetings/en/details.jsp?meeting_code=pct/wg/2.

establishment of the international search report after publication on the workflow in International Searching Authorities and the consequent delay for any supplementary international search and international preliminary examination procedures, which would result in an overall negative impact on the PCT system. Doubts were expressed as to whether it would be possible to cover secret prior art for the benefit of all designated Offices, rather than just the national Office which acted as the International Searching Authority, noting that there were different approaches and definitions as to what constituted secret prior art under the national laws and practices of Offices. Doubts were also expressed with regard to the willingness of third parties to submit observations prior to the establishment and publication of the international search report, in particular where the application was published in a language different from the national language of the third party concerned.

73. Responding to those concerns, the Delegation of Japan referred to paragraph 6 of its proposal in document PCT/WG/2/8 and explained that the timing of the international search report after publication would be predictable and would not necessarily increase complexity. Regarding the impact on other procedures, the Delegation explained that its proposal would not have a significant influence on and could coexist with supplementary international search and international preliminary examination because sufficient time was available under the current procedures. Regarding the search scope of secret prior art, the Delegation explained that the scope of secret prior art, which would be elaborated in the further discussion, could at least cover the national applications of the International Searching Authority and PCT applications. It also noted that secret prior art was already listed as relevant prior art for international search under the current system. Regarding third party observations, the Delegation of Japan explained that means to prevent abuse would need to be studied in the further discussion and observed that an interested third party might be permitted to submit the information based on international publication even prior to the issuance of the international search report.

74. In response to a query by one delegation as to whether the Treaty would permit the establishment of the search report after international publication, the Secretariat explained that, while the Treaty prescribed that international publication had to take place “promptly after the expiration of 18 months from the priority date”, it did not prescribe a time limit for the establishment or the publication of the international search report and left that matter to be determined in the Regulations.

75. With regard to the proposal to encourage parallel processing of applications based on early national phase entry before the Office which acted as International Searching Authority, several delegations stated that, in their view, it was first and foremost a matter for each International Authority to ensure that its internal procedures were designed in a way which ensured efficient processing of all applications pending before it, be they national applications filed with it as an Office of first filing, international applications searched and examined by it in its capacity as an International Authority, or international applications which had entered the national phase before it in its capacity as a designated Office.

THREE TRACK PCT SYSTEM

76. Discussions were based on document PCT/WG/2/11, containing proposals by the Delegation of the Republic of Korea.

77. The Delegation of the Republic of Korea, in introducing its proposals, stated that informal consultations with users had shown that the PCT at present did not meet the needs of

those applicants who sought accelerated search and examination to obtain rapid protection of rights and, as a result, would not use the PCT but rather file via the Paris Convention route and use schemes such as the Patent Prosecution Highway in order to accelerate procedures. So as to encourage use of the PCT, the Delegation's proposal was to offer more options to applicants by way of an optional accelerated PCT procedure under which international search reports and written opinions by the International Searching Authority and, if so wished, international preliminary examination reports, would be available within 12 months from the filing of the international application where that application is filed without claiming the priority of an earlier application, resulting in a "three track" PCT procedure offering either accelerated, normal (present system) or deferred (as in document PCT/WG/2/8) search and examination tracks.

78. There was general agreement that this proposal should be further discussed as part of the development of the draft roadmap. Some delegations noted that the success of the Patent Prosecution Highway showed the demand by some applicants for accelerated examination, which might also be introduced through the PCT. Other delegations supported the principle of providing different options and flexibility for PCT applicants.

79. However, several delegations, while expressing some sympathy for the objectives of the proposal, expressed concerns as to the quality of search and examination reports established under the proposed accelerated examination track, noting the ambitious due dates for the establishment of such reports. Concerns were also raised as to the possibility that the three different search and examination tracks could lead to three different quality levels in the PCT system, with consequential confusion and reduced confidence in reports by national Offices. In this context, one representative of users stated that, whether the procedure followed was accelerated, normal or deferred, it was important that the focus remained on improving the quality of the international search.

80. Several delegations expressed concerns with regard to the fact that, under the accelerated track of the proposal, the international search report would be established many months prior to international publication, thus aggravating the problem of non-coverage of secret prior art. The Delegation of Japan, noting its related proposal in document PCT/WG/2/8, stated that it believed the terminology proposed for the different timelines should be changed so that establishment of the international search report after publication should be considered the "normal examination track" in light of the quality and efficiency of that approach, rather than the present timing. The Delegation of Japan also noted that in its proposal, an indicative timing of 21 to 22 months from the priority date was proposed for the establishment of the international search report, rather than 24 to 26 months, as in the proposal of the Republic of Korea.

81. Some delegations, noting the low uptake by applicants of existing schemes for accelerated processing under national laws, questioned whether there was really sufficient user demand to justify the complexity that would be added to the system. One delegation suggested that applicants who sought rapid protection of rights would possibly opt for early national phase entry rather than choosing an accelerated PCT procedure. One representative of users suggested that applicants generally used the PCT to gain more time before the start of national phase procedures; if applicants wished to obtain fast patent protection, they would prefer filing via the Paris Convention route rather than the PCT. In response to these concerns, the Delegation of the Republic of Korea emphasized that its proposals aimed to contribute to the work-sharing efforts of the PCT by attracting applicants who would currently use the Paris Convention route of filing to use the PCT instead.

82. A number of delegations stated that, in any event, participation in any accelerated procedure should be optional rather than mandatory for International Authorities. If so, one delegation wondered how many Authorities would be prepared to offer such an accelerated procedure.

83. One delegation stated that, rather than offering a three track system as proposed, a possible two track system, under which applicants could choose between accelerated and deferred examination tracks only, should be further explored.

COMPREHENSIVE PROPOSAL FOR PCT REFORM

84. Discussions were based on document PCT/WG/2/12, containing proposals by the Delegation of the United States of America.

85. The Delegation of the United States of America, in introducing its proposals, stated that, differently from the other proposed areas of work set out in the Roadmap, its proposals were to be seen as long term proposals, noting that some of them would require revision of the Treaty itself and not only amendment of the Regulations. The Delegation further stated that it nevertheless hoped that such long term proposals would contribute to finding solutions which helped to overcome the main problem that presently faced the PCT, namely, the reluctance by national Offices to use the international work products as a basis for work sharing in the national phase.

86. A number of delegations stated that, while the focus of the Roadmap should be on means whereby the PCT could be made more effective in the near term without requiring changes to the Treaty itself, they nevertheless supported the idea of looking at the long term perspective and vision, with a view of identifying issues which should be addressed should a fundamental revision of the PCT occur at some stage in the future. Other delegations expressed concerns that looking at such issues now might distract from the focus on issues which could be addressed within the current legal framework.

87. Several delegations, while supportive of some elements of the proposals, raised concerns about the proposed system under which, similar to that under The Hague (1999) Agreement, an international application, having received a positive international report on patentability, would automatically issue as a national patent unless a national Office issued a notification of refusal within a specified period of time. Those delegations noted that such proposals would be ineffective in the absence of substantive patent law harmonization, and emphasized the sovereignty of Member States to prescribe substantive conditions of patentability.

88. Several delegations noted that it would appear that certain features of the proposals, including the proposed combination of international and national phase processing, the proposed collaboration on search and examination, and the proposed allowance for prior art submissions by applicants and third parties, were similar in nature to areas of work set out in the Roadmap and could be addressed in the near term, without requiring changes to the Treaty. If so, they should be included in the Roadmap and further discussed and studied. In this context, preliminary concerns were raised, however, with regard to the proposed collaborative search and examination, noting that such collaboration might result in an inefficient duplication of work and increased costs for applicants, and might overburden Authorities which were already struggling with backlogs. Concerns were also raised with

regard to the proposed extension of the time limit for national phase entry, possibly reducing the attractiveness of the PCT system if not balanced by an overall efficiency gain and an overall reduced time leading up to grant by national Offices.

89. In response to queries by two delegations, the Delegation of the United States of America confirmed that the proposal was to give applicants the choice of selecting the Authorities which would be competent to carry out collaborative search and examination during the international phase. Upon a query by another delegation, the Delegation furthermore stated that the proposed provision for submission of prior art by the applicant was intended as an optional rather than mandatory feature for the applicant.

THE FUTURE OF THE PCT: CONCLUSION

90. As had been suggested by the Chair (see paragraph 12, above), the Working Group continued its discussions by resuming consideration of the draft roadmap set out in document PCT/WG/2/3.

91. In response to questions concerning how the roadmap fitted with the WIPO Development Agenda, notably, recommendations 15 (inclusive, participatory, etc.) and 17 (taking existing flexibilities into account) thereof, the Director General observed, that, in his view, the present process concerning the PCT was not a norm-setting activity. While there was no clear definition of the term “norm-setting activity”, it implied work towards the establishment of a legislative instrument and, while there had been talk of a Treaty revision, the specific proposal currently before the Working Group would not involve such a revision. Some changes to the Regulations might need to be considered, but these would necessarily be compliant with the Treaty. The Director General reiterated that Article 27(5) specifically preserved Contracting States’ right to prescribe substantive conditions of patentability, and the present proposals could thus not provide for substantive patent law harmonization. The spirit of the principles set out in recommendation 15 of the Development Agenda nevertheless needed to apply, and it was important that the process be a participatory one.

92. Other parts of the Development Agenda were also relevant, notably those on technology transfer, and it was noteworthy that the preamble of the PCT included specific provisions on this point. The International Bureau had undertaken a number of new activities in this area in recent years. The more than 1.5 million international applications that had so far been filed had been made available online on WIPO’s PATENTSCOPE[®] website together with a search engine. The site included a service which provided automatically updated technology review searches in selected fields of technology. A digitization program had been commenced in approximately 20 countries to put national patent collections online, and the South African collection would soon become the first to be so available, shortly to be followed by those of 7 other countries. This program would be expanded to include other developing countries which wished to participate.

93. The Director General also recalled that the PCT offered features which were important for all applicants, and especially for individual applicants and small businesses in developing countries, whereby costs and decisions were able to be delayed for an extra 18 months compared to the Paris Convention route for seeking international patent protection. This allowed valuable time for seeking financing and/or licensing deals in order to raise money which could be used for further development, commercialization and the costs of national phase entry. In addition, the International Bureau offered many other services to developing countries, including training.

94. The Meeting agreed that the relevant PCT bodies should continue their work to improve the PCT. The Meeting agreed that the PCT system can and should function more effectively, within the existing legal framework of the Treaty provisions,

- to deliver results which meet the needs of applicants, Offices and third parties in all Contracting States;
- without limiting the freedom of Contracting States to prescribe, interpret and apply substantive conditions of patentability and without seeking substantive patent law harmonization or harmonization of national search and examination procedures.

95. The Meeting agreed that the relevant PCT bodies should discuss ways in which the objective set out in paragraph 94, above, could be achieved,

- taking an incremental approach;
- in a member-driven process, involving broad-based consultations with all stakeholder groups, including regional information workshops;
- taking into account the recommendations contained in the WIPO Development Agenda;
- taking into consideration the topics addressed in the draft roadmap proposed by the International Bureau in document PCT/WG/2/3, subject to the discussions set out in the Working Group's report, taking note of certain concerns expressed by Contracting States, and taking note of any other topics which Contracting States may wish to address in order to achieve the objective set out in paragraph 94.

96. The Meeting agreed that the work set out in paragraph 95, above, should be informed by an in-depth study factoring in, but not limited to, the following elements:

- outlining the background of the need to improve the functioning of the PCT system;
- identifying the existing problems and challenges facing the PCT system;
- analyzing the causes underlying the problems;
- identifying possible options to address the problems;
- evaluating the impact of the proposed options;
- defining and clarifying concepts, such as 'duplication of work', 'unnecessary actions' etc.

The Meeting recommended that this study be prepared and submitted to the Working Group at least two months before the next Working Group meeting.

97. The Meeting agreed on the importance of fee reductions and capacity building measures, including in patent drafting and filing, and agreed that the relevant PCT bodies should prepare proposals, including fee reductions and capacity building measures, to increase access to the PCT for independent inventors and/or natural persons, small and medium sized enterprises and Universities and research institutions, in particular from developing and least developed countries.

98. The Meeting recommended that technical assistance be enhanced for national and regional Offices of developing and least developed countries in order that they may benefit fully from the PCT system, and the Meeting agreed on the importance of facilitating participation by representatives of Offices of developing and least developed countries in the meetings of the PCT Working Group.

ENHANCING THE VALUE OF INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION UNDER THE PCT: MAKING INTERNATIONAL PRELIMINARY EXAMINATION MORE USEFUL

99. Discussions were based on document PCT/WG/2/6.

100. The Chairman observed that many of the issues had, at a general level, been considered in the context of the section “Making International Examination More Complete, Relevant and Useful” in paragraphs 4 and 5 of document PCT/WG/2/3 and those comments (see paragraphs 51 to 59, above) should be taken to apply equally to this document.

FORM OF AMENDMENTS

101. Discussions were based on document PCT/WG/2/9, containing proposals by the European Patent Office.

102. The Working Group approved the proposed amendments of the Regulations set out in the Annex to document PCT/WG/2/9 with a view to their submission to the PCT Assembly for consideration at its next session, in September-October 2009, subject to the comments and clarifications appearing in the following paragraphs and to possible further drafting changes to be made by the Secretariat.

103. The delegation of El Salvador stated that, due to the late publication of document PCT/WG/2/9, it did not have enough time for appropriate consultations and thus had to reserve its position.

104. One delegation noted that a mandatory requirement to indicate the basis for amendment would make the conditions which it had to apply as an International Authority more strict than those which it applied as a national Office and that it would prefer the identification of the basis of the amendments instead to be optional. The representative of the European Patent Office observed that this would mean that it would then be impossible for an International Authority to require this information, which would negate the purpose of the Rule. A more appropriate solution was considered to be to make clear that the International Authority was free not to apply the sanction of establishing its report as if the amendment had not been made. This could be a routine policy, applied in all cases in some Authorities, or else at the discretion of the examiner based on whether the basis was immediately clear without any explanation by the applicant.

105. It was agreed that Rule 70 should be amended so as to clarify that an International Preliminary Examining Authority would be entitled to establish the international preliminary examination report as if an amendment had not been made where the applicant did not comply with the requirement to indicate the basis for the amendment, along the lines of existing Rule 70.2(c) but as a “may” rather than a “shall” provision.

106. One delegation recommended that the International Search and Preliminary Examination Guidelines should be modified to indicate certain cases, such as simple deletion of a claim, where no Authority should apply a sanction if the basis was not indicated. Another delegation recommended that the International Search and Preliminary Examination Guidelines should be modified so as to clarify the procedure to be applied by Examining Authorities where the applicant submitted an amendment very late during the examination procedure so that there was not enough time for the Authority to invite the applicant to furnish any missing indication as to the basis for the amendment.

107. In response to a query by one delegation as to the difference in meaning between “basis for the amendment” and “reasons for the amendment” in Rule 66.8(a) as proposed to be amended, the representative of the European Patent Office explained that the requirement to indicate the basis for the amendment was to be understood as a requirement to indicate where in the application as filed there was support for the proposed amendments, whereas the requirement to explain the reasons for the amendment was to be understood as a requirement to explain why the amendments were made, such as to overcome an objection of lack of novelty.

108. In response to a further query by another delegation as to the time limit within which the applicant was required to furnish the indication of the basis for the amendment, the representative of the European Patent Office stated that such indication was to be filed together with the amendment.

109. In response to a query by a representative of users as to whether the European Patent Office had already adopted a similar provision in respect of direct European patent application, the Delegation of the European Patent Office confirmed that Rule 137(4) of the Implementing Regulations to the European Patent Convention had been amended accordingly and would enter into force on April 1, 2010.

110. One representative of users expressed concerns as to the additional burden on applicants and suggested that Authorities should not routinely require the furnishing of indications as to the basis for the amendment but only as part of the substantive examination procedure if such basis could indeed not be found without substantial effort by the examiner.

ELIGIBILITY CRITERIA FOR REDUCTIONS IN CERTAIN FEES

111. Discussions were based on document PCT/WG/2/4.

112. The Delegation of Barbados stated that the current criterion for a 90% reduction in the international filing fee and the handling fee was based on average *per capita* income. Barbados was one of nine developing countries whose *per capita* income was above the eligibility threshold for a reduction in the PCT fees. It was, however, entitled to a reduction pending a decision of the PCT Assembly on the eligibility criteria for determining the beneficiaries. In the view of the delegation, any criteria to be established should be equitable

and balanced, taking into account the special needs of developing countries, including the small, high income, vulnerable economies such as Barbados.

113. Average *per capita* income had been used as a determinant of eligibility for a PCT fee reduction and had resulted in inequity with respect to economies such as that of Barbados. It had been the basis on which patent holders in Barbados, who faced challenges over and above those in large emerging economies in the manufacture and sale of their inventions, had been denied special and differential treatment at the international level in the form of a reduction in certain PCT fees. These challenges nullified the effect of having a higher *per capita* income.

114. Challenges that patent applicants in Barbados faced included the following: (1) the lack of economies of scale; (2) the high cost of labor; and (3) an insufficiently large local market for the manufacture and sale of their inventions. As a result of these challenges, it was difficult for patent holders to recoup the large costs associated with bringing their inventions to the stage of patentability.

115. In addition to these challenges, there were a number of factors which, when taken together, pointed to the fact that, notwithstanding Barbados' average *per capita* income, Barbados should, like other developing countries, who in other respects stood in a better position than Barbados, be entitled to the 90% fee reduction on a long-term basis, since the challenges which Barbados faces were of a long-term nature. These factors included: (1) Barbados' small percentage of world GDP; (2) its small percentage of world NAMA trade; (3) its vulnerability to external economic and financial shocks; (4) its vulnerability to natural disasters as a small island developing state; (5) the fact that, as a result of the level of Barbados' *per capita* income, Barbados' economies no longer qualified for concessionary financing and consequently had to resort to commercial borrowing to meet critical infrastructure and other developmental needs while at the same time respond to the increasing incidence of natural disasters and other climate change impacts in the regions, as well as pay higher prices for much needed medicines for our people; (6) its very limited natural resources; (7) its small fledgling industries; and (8) the fact that Barbados' relatively high *per capita* GDP was based on vulnerable sectors.

116. For example, the tourism sector, Barbados' main foreign exchange earner, was highly susceptible to airline decisions, international security issues, the changing tastes of tourists and possible pandemics. The existence and operation of the international business sector was largely dependent on decisions taken by major developed countries.

117. Cognizant of the challenges which patent holders and would-be patent holders in Barbados face, the Delegation welcomed the study which the International Bureau presented to the PCT Assembly in September-October 2008 on the eligibility criteria for determining the group of developing and least developed countries whose applicants should benefit from a reduction of PCT fees. Of the nine countries who, but for the 2008 *ad hoc* decision, would not be eligible for a PCT fee reduction, three were small island developing states from the Caribbean with small vulnerable economies.

118. The Delegation stated that it was glad to see that, in its proposals, the International Bureau had not suggested a one-size-fits-all approach but instead, and consistent with the spirit of the development agenda, suggested criteria aimed at, amongst other things, taking into account the needs of small countries.

119. While the Delegation acknowledged that the criteria suggested by the International Bureau would have allowed patent applicants in Barbados to benefit from a fee reduction, it was concerned that, as regards the period of eligibility, such benefits would be short-term when compared with certain large emerging economies where patent applicants are not confronted with the same challenges as applicants from Barbados. The Delegation emphasized that it did not have a difficulty with patent applicants in those large middle income countries benefiting from a fee reduction, but it needed to ensure equity and balance, which could only be done if the period of eligibility for a fee reduction would be the same for nationals of large emerging economies and those of small, high income, vulnerable economies.

120. At present, given the wide gap which existed between the *per capita* income of some large economies and the threshold for high income countries, these large economies were given a permanent carve-out with respect to the reduction of PCT fees while patent applicants in Barbados were given less favorable treatment. They would be constantly under threat of losing their eligibility.

121. The Delegation further stated that during the PCT Assembly in September 2008, Barbados had suggested a criterion based on the percentage of world trade which could be understood as reflective of how few patented technologies Barbados was able to export. The African Group, however, had proposed a criterion which was much simpler and would remove the discrimination which existed for a long time with the use of *per capita* income as a determinant for eligibility for a PCT fee reduction. As seen in paragraph 20 on page 4 of PCT/WG/2/4, that criterion was that the reduction applied to all developing countries, including the nine States to which the reductions had been extended pending review. The Delegation saw merit in this proposal, as *per capita* income was not an accurate indicator of which countries required a stimulus at the international level to encourage innovation. In addition, it had to be borne in mind that, apart from one or two countries in the list of nine which currently benefit under the *ad hoc* decision and which had a comparatively high *per capita* income, filings by individuals had been negligible. To extend the fee reduction to these countries would not result in a loss of significant revenue to WIPO.

122. The Delegation further stated that, according to document PCT/WG/2/4, the Working Group was invited to consider how it wished to proceed with regard to establishing eligibility criteria for determining the group of developing and least developed countries whose applicants should benefit from a reduction of PCT fees.

123. In line with the Delegation's view that patent applicants in small high income economies should be given treatment no less favorable than that which is being given to certain large emerging economies, Barbados wished to suggest that the International Bureau update its study to take on board, amongst other criteria, the criteria suggested by Barbados and the African Group at the September 2008 PCT Assembly and to present the study to the next session of the PCT Working Group for discussion.

124. The Delegation of Singapore stated that, as Singapore had stated during the 45th series of Meetings of the Assemblies of the Member States of WIPO, it had some conceptual concerns with regard to the parameters used in the Secretariats proposal set out in document PCT/A/38/5. The Delegation restated some of those concerns and suggested some ideas to proceed on this issue.

125. First, the proposed income-based and size-based criteria were fairly new concepts. Related to this was that the basis of the size-based criteria benchmarks, “not more than 50% above the threshold/or establishing the high-income category” and “not more than 0.1% of world GDP” was unclear and appeared arbitrary. These benchmarks were based on borrowing concepts and measurements developed in other international organizations for other purposes. Hence, more clarity on the rationale for and formulation of this criteria was fundamental for an informed discussion.

126. Second, earlier discussions highlighted that the overarching objective of the reduction in PCT fees for individuals was to spur innovation. In this regard, Singapore was of the view that the proposal’s focus on economic indicators such as GNI *per capita* and GDP were not definitive in measuring or encouraging innovation. For a more complete picture, Singapore considered that an innovation criterion would be required to complement the Secretariat’s proposed criteria. The Delegation acknowledged that there was no single internationally accepted innovation criterion. Hence, effort should be made to design an innovation criterion founded on sound reasoning and statistical analysis. A rigorous innovation criterion would have to take into account a variety of elements, such as patent counts, PCT resident filings, cross-country variations in patent examination criteria, patent value in the form of licensing revenue flows, and so forth. Singapore believed that fine-tuning the existing proposal to include an innovation criterion would ensure that the reduction in PCT fees served to benefit Members by encouraging innovation, and the increased usage of the PCT system.

127. Third, while some had argued that international fees formed a negligible part of international patenting costs, the reality was that these fees still formed a significant component of the initial cost for individual applicants. To quote the summary record of the Meeting of Heads of Offices contained in Annex II of document PCT/WG/2/3: “Fees were seen as a sensitive but important issue which needed to be addressed carefully and used as a positive policy instrument to make the system more attractive. Several participants noted that the problem of costs was by no means limited to developing countries but to individuals and small and medium sized enterprises (SMEs) everywhere.”

128. With reference to the Director General’s Memorandum on the “Future of the PCT”, Singapore shared the view that the key issue was to “ensure that the international patent system is as accessible as possible to innovators from all States.” In this regard, Singapore supported the idea proposed in the Memorandum on the need for a further review of international fees and consideration of new ways to offer assistance particularly to individuals and small businesses from developing countries. It was with these considerations in mind that Singapore supported an SME policy and proposed that the Secretariat undertake a study exploring a fee reduction criterion for SMEs. The Delegation stated that it considered that the inclusion of a fee reduction criteria targeted at SMEs would help to complete the whole package of eligibility criteria for the reduction of PCT fees. In this regard, Singapore was of the view that a decision on eligibility criteria for fee reductions should be deferred to the next PCT Working Group meeting, pending the outcome of this Secretariat study on an SME criterion. This additional time for consideration would also allow Members to deliberate and explore new and conceptually robust criteria as well as to contemplate other innovative approaches to provide assistance to SMEs.

129. The Working Group agreed to request the Secretariat to carry out the requested studies and to present those studies to the next session of the Working Group.

ESTABLISHMENT OF EQUIVALENT AMOUNTS OF CERTAIN FEES

130. Discussions were based on document PCT/WG/2/2.

131. The Working Group approved the proposed amendments of the Regulations set out in Annex I to document PCT/WG/2/2, the proposed amendments to the Directives of the Assembly set out in Annex II to document PCT/WG/2/2 and the proposed amendments to Article 11 of the Agreements between the International Bureau and Offices in relation to their functioning as International Searching and Preliminary Examining Authorities as set out in Annex III to document PCT/WG/2/2, with a view to their submission to the Assembly for consideration at its next session, in September-October 2009, subject to the comments and clarifications appearing in the following paragraphs and to possible further drafting changes to be made by the Secretariat.

132. The delegation of El Salvador stated that it had not had enough time for appropriate consultations and thus had to reserve its position.

133. In response to a question by one delegation why it was proposed in the document to move much of the content of present PCT Rules 15 and 16 to the Directives, the Secretariat indicated that this was simply a matter of removing the duplication and making both the Rules and the Directives easier to read. The Secretariat pointed out that the Directives were adopted by the Assembly in the same way as the Rules and consequently this did not change the degree of control which the Contracting States maintained over the procedures. The Secretariat agreed that it would be important that the text of the Directives be easier to find than at present and resolved to publish them clearly on the PCT website.

134. It was agreed to further amend Rule 15(2)(c) and (d) as set out in Annex I to document PCT/WG/2/2 as follows:

“(c) Where the prescribed currency is the Swiss franc, the receiving Office shall promptly transfer the said fee to the International Bureau in Swiss francs.

“(d) Where the prescribed currency is a currency other than the Swiss franc and that currency:

“(i) is freely convertible into Swiss francs, the Director General shall establish, for each receiving Office which prescribes such a currency for the payment of the international filing fee, an equivalent amount of that fee in the prescribed currency according to directives given by the Assembly, and the amount in that currency shall promptly be transferred by the receiving Office to the International Bureau;

“(ii) is not freely convertible into Swiss francs, the receiving Office shall be responsible for the conversion of the international filing fee from the prescribed currency into Swiss francs and shall promptly transfer that fee in Swiss francs, in the amount set out in the Schedule of Fees, to the International Bureau. Alternatively, if the receiving Offices so wishes, it may convert the international filing fee from the prescribed currency into euros or US dollars and promptly transfer the equivalent amount of that fee in euros or US dollars, as established by the Director General according to directives given by the Assembly as referred to in item (i), to the International Bureau.”

135. It was agreed to further amend Rule 16.1(d) and (e) as set out in Annex I to document PCT/WG/2/2 as follows:

“(d) Where the prescribed currency is not the fixed currency and that currency:

“(i) is freely convertible into the fixed currency, the Director General shall establish, for each receiving Office which prescribes such a currency for the payment of the search fee, an equivalent amount of that fee in the prescribed currency according to directives given by the Assembly, and the amount in that currency shall promptly be transferred by the receiving Office to the International Searching Authority;

“(ii) is not freely convertible into the fixed currency, the receiving Office shall be responsible for the conversion of the search fee from the prescribed currency into the fixed currency and shall promptly transfer that fee in the fixed currency, in the amount fixed by the International Searching Authority, to the International Searching Authority.”

“(e) Where, in respect of the payment of the search fee in a prescribed currency, other than the fixed currency, the amount actually received under paragraph (d)(i) of this Rule by the International Searching Authority in the prescribed currency is, when converted by it into the fixed currency, less than that fixed by it, the difference will be paid to the International Searching Authority by the International Bureau, whereas, if the amount actually received is more, the difference will belong to the International Bureau.”

136. It was agreed to further amend Rule 57.2(c) and (d) as set out in Annex I to document PCT/WG/2/2 as follows:

“(c) Where the prescribed currency is the Swiss franc, the Authority shall promptly transfer the said fee to the International Bureau in Swiss francs.

(d) Where the prescribed currency is a currency other than the Swiss franc and that currency:

“(i) is freely convertible into Swiss francs, the Director General shall establish, for each Authority which prescribes such a currency for the payment of the handling fee, an equivalent amount of that fee in the prescribed currency according to directives given by the Assembly, and the amount in that currency shall promptly be transferred by the Authority to the International Bureau in the prescribed currency;

“(ii) is not freely convertible into the Swiss franc, the Authority shall be responsible for the conversion of the handling fee from the prescribed currency into Swiss francs and shall promptly transfer that fee in Swiss francs, in the amount set out in the Schedule of Fees, to the International Bureau. Alternatively, if the Authority so wishes, it may convert the handling fee from the prescribed currency into euros or US dollars and promptly transfer the equivalent amount of that fee in euros or US dollars, as established by the Director General according to directives given by the Assembly as referred to in item (i), to the International Bureau.”

137. It was agreed that paragraph 5 of the Directives as set out in Annex II to document PCT/WG/2/2 should be further modified by replacing the words “may ask the Director

General, or the Director General may decide, to newly establish the equivalent amount” with the words “the Director General shall establish the new equivalent amount.”.

138. It was agreed that the Directives as set out in Annex II to document PCT/WG/2/2 should be further modified to clearly cover equivalent amounts for the supplementary search fee. In addition, paragraph 1(ii) of the Directives should not require consultation with the International Searching Authority, the interests of that Authority being sufficiently covered by proposed Rule 16.1(e), in the same way as at present.

139. Some delegations observed that the national processes involved in setting fees meant that it would not always be possible for an International Authority to give the Director General two months notice of changes to its fees. Nevertheless, in view of the importance of ensuring that equivalent amounts were established in time for them to be reflected in the automated systems of affected receiving Offices, it was agreed that the agreements between the International Authorities and the International Bureau should be amended to indicate that 2 months notice should be given as proposed in Annex III to document PCT/WG/2/2, subject to clarifying that where this was not possible, later notice would be permitted with the agreement of the Director General.

140. One delegation suggested that it might be more effective to compare exchange rates just once every calendar month and make any necessary changes on that basis. However, it was agreed that comparing rates over the course of several weeks would reduce the risk of anomalies due to sudden, short-term changes to the rates.

141. In relation to concerns that changes of equivalent amounts might become slightly more frequent, making it difficult for applicants to plan, it was observed that, subject to specific decisions which could be taken in individual cases, the new amounts would only come into force 2 months after being published in the PCT Gazette, giving the same warning of changes as at present.

INTERNATIONAL FORM FOR NATIONAL PHASE ENTRY

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

143. A number of delegations supported the further development of such a form, subject to the need to consider introducing further items, including spaces for the international publication number, the title of the international application in the national language of the State where it is entering the national phase, attachment of indications relating to deposited microorganisms, and a request to issue an invoice for payment by Offices offering this means of payment.

144. One delegation noted that a model international request form had been established in accordance with the Patent Law Treaty and queried whether that form might be adapted for this purpose, or else whether the two forms should be made as compatible as possible.

145. Several other delegations and representatives of users expressed the view that the idea of an international form for national phase entry would not be useful for various reasons, mainly, due to the fact that it might be quite cumbersome for applicants to be certain that they had selected the correct options or met the correct requirements for any particular national Office. It might also be an administrative burden for Offices to process such a form, containing many entries which were of no relevance to their particular national law. On the

other hand, local agents were fully familiar with the use of national forms which contained the specific information required for national phase entry in their country.

146. One delegation queried whether the proposal to require Offices to accept such a form in a PCT language of publication was a restriction which was compatible with PCT Article 27.

147. The Chairman concluded that there was no consensus for further work on this proposal at this time.

PRESENTATION OF REVISIONS TO INTERNATIONAL APPLICATIONS

148. Discussions were based on document PCT/WG/2/7.

149. A number of delegations noted the increasing importance of electronic processing of international applications and affirmed the importance of finding an effective solution to publication of international applications in a manner which provides the necessary information effectively to all of the various users.

150. All delegations which took the floor confirmed that it was important for an examiner to be able to easily identify the parts of the international application which had changed compared to the original version. Noting that many Offices relied on the printed or the PDF version of the international publication for national phase processing, it was essential that this identification be possible within the rendered version as well as from the XML itself. Most delegations considered that it was at least highly desirable for examiners to be able to see whether changes had been made on the basis of the rendering of the individual paragraphs or drawings, rather than on the basis of a separate list of changes. However, some delegations considered that such a list might be useful in addition; one delegation indicated that a separate list might be acceptable as an alternative.

151. Some delegations commented that they could not see any legal difficulties with identifying paragraphs which had been changed by inserting text into that paragraph, but considered that this was not ideal because such text might not clearly stand out and also might cause technical problems in distinguishing it from the text which was genuinely part of the international application.

152. A number of delegations considered that it was important to be able to determine the dates on which the relevant changes had been made in order to facilitate consultation of the correct part of the file to follow up any questions. In addition, information on the type of change would be useful. In relation to the term “nature” of change, one delegation observed that it would be desirable, if possible, to have insertions and deletions marked up, but they would not wish the application body to contain any commentary on the reasons for change.

153. One delegation referred to the comments which it had previously made on this subject in the Meeting of International Authorities (paragraphs 94 to 96 of document PCT/MIA/16/15).

154. A representative of users emphasized the importance which applicants in his country attached to efficient processes for paperless work and hoped for speedy resolution of issues in a way which would allow a consistent approach and format to be used through the international and national phases. For the PCT, this meant that it was important to be able to

furnish Article 19 and 34 amendments in XML format and to have them processed directly in that format by the International Bureau or International Preliminary Examining Authority.

155. The Secretariat stated that the subject matter of document PCT/WG/2/7 would be the subject of further consultations in the near future in the form of a Circular and that at the same time it would be necessary to consult on a number of other related matters concerning the replacement of individual paragraphs or drawings in international applications, particularly those which had been filed in XML format.

SUPPLEMENTARY INTERNATIONAL SEARCH

156. Discussions were based on document PCT/WG/2/10.

157. The Working Group approved the proposed amendments of the Regulations set out in the Annex to document PCT/WG/2/10 with a view to their submission to the Assembly for consideration at its next session, in September-October 2009, subject to the comments and clarifications appearing in the following paragraphs and to possible further drafting changes to be made by the Secretariat.

158. The delegation of El Salvador stated that it had not had enough time for appropriate consultations and thus had to reserve its position.

159. It was agreed to further amend Rules 45bis.1(d), 45bis.5(b), (g) and (h), 45bis.6(f) and 45bis.9(c) as set out in Annex I to document PCT/WG/2/2 as follows:

“45bis.1 Supplementary Search Request

[...]

“(d) Where the International Searching Authority has found that the international application does not comply with the requirement of unity of invention, the supplementary search request may contain an indication of the wish of the applicant to restrict the supplementary international search to one of the inventions as identified by the International Searching Authority other than the main invention referred to in Article 17(3)(a).”

[...]

45bis.5 Start, Basis and Scope of Supplementary International Search

[...]

“(b) The supplementary international search shall be carried out on the basis of the international application as filed or of a translation referred to in Rule 45bis.1(b)(iii) or 45bis.1(c)(i), taking due account of the international search report and the written opinion established under Rule 43bis.1 where they are available to the Authority specified for supplementary search before it starts the search. Where the supplementary search request contains an indication under Rule 45bis.1(d), the supplementary international search may be restricted to the invention specified by the applicant under Rule 45bis.1(d) and those parts of the international application which relate to that invention.”

[...]

“(g) If the Authority specified for supplementary search finds that carrying out the search is entirely excluded by a limitation referred to in Rule 45bis.9(a), the supplementary search request shall be considered not to have been submitted, and the Authority shall so declare and shall promptly notify the applicant and the International Bureau accordingly.

“(h) The Authority specified for supplementary search may, in accordance with a limitation or condition referred to in Rule 45bis.9(a), decide to restrict the search to certain claims only, in which case the supplementary international search report shall so indicate.”

“45bis.6 *Unity of Invention*

[...]

“(f) Paragraphs (a) to (e) shall apply mutatis mutandis where the Authority specified for supplementary search decides to restrict the supplementary international search in accordance with the second sentence of Rule 45bis.5(b) or with Rule 45bis.5(h), provided that any reference in the said paragraphs to the “international application” shall be construed as a reference to those parts of the international application which relate to the invention specified by the applicant under Rule 45bis.1(d) or which relate to the claims and those parts of the international application for which the Authority will carry out a supplementary international search, respectively.”

“45bis.9 *International Searching Authorities Competent to Carry Out Supplementary International Search*

[...]

“(c) The limitations referred to in paragraph (a) may, for example, include limitations as to the subject matter for which supplementary international searches will be carried out, beyond those which would apply under Article 17(2) to the international search, limitations as to the total number of supplementary international searches which will be carried out in a given period, and limitations to the effect that the supplementary international searches will not extend to any claim beyond a certain number of claims.”

160. It was agreed that the Secretariat should review Rule 45bis.5(g) as proposed to be amended to establish whether there might be a need for a further amendment so as to clarify that a refund of fees only needed to be made by the International Authority in the case where no search was carried out because of a limitation made in accordance with Rule 45bis.9 and not in the case where no search was made because of subject matter which was not searched because it pertained to certain subject matter in accordance with Article 17(2) and Rule 39, as they applied under Rule 45bis.5(c). Any such proposed further amendment should also be submitted to the Assembly for adoption at its next session, in September-October 2009.

ENTRY INTO FORCE; TRANSITIONAL ARRANGEMENTS

161. The Working Group agreed that proposals concerning entry into force and transitional arrangements in respect of those amendments of the Regulations, of the

Directives and of Article 11 of the Agreements between the International Bureau and Offices in relation to their functioning as International Searching and Preliminary Examining Authorities which had been approved by the Working Group with a view to their submission to the Assembly for consideration at its next session, in September-October 2009, should be posted by the Secretariat on the Working Group's electronic forum on WIPO's website for comments and suggestions by delegations and representatives, with a view to submitting detailed proposals to the Assembly.

FURTHER WORK

162. The Working Group agreed that the summary by the Chair and the present report should be submitted to the Assembly for consideration at its next session, in September-October 2009, to inform the Assembly of the discussions and decisions that had been made at the present session.

163. The Working Group agreed to recommend to the Assembly that, subject to the availability of sufficient funds:

(i) one session of the Working Group should be convened between the September 2009 and September 2010 sessions of the Assembly; and

(ii) the same financial assistance that had been made available to enable attendance of certain delegations at this session of the Working Group should be made available to enable attendance of certain delegations at that next session.

SUMMARY BY THE CHAIR

164. The Working Group noted a draft summary by the Chair. It was pointed out that two short passages had been accidentally omitted from the agreed text set out in paragraphs 94 to 98, above, and there were a number of typographical errors. A corrected version was subsequently published as document PCT/WG/2/13.

ADOPTION OF THE REPORT OF THE SESSION

165. It was agreed that a draft report of the present session would be circulated for comments and adoption by correspondence subsequent to the meeting.

[Annex follows]

ANNEX

LISTE DES PARTICIPANTS/
LIST OF PARTICIPANTS

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(dans l'ordre alphabétique des noms français des États/
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