



Date: 15 August 2008	Ref. : EXCO/IT08/CET/1305
Subject: Report on the Meeting of the PCT Working Group	Meeting date : 05-08 October 2008
	Meeting : ExCo in Florence, Italia
Drawn up by: Gustavo Barbosa, Reporter of CET3	Purpose: For information

Delegations of the PCT member-countries and several user groups met in Geneva to discuss changes to the PCT regulations, some of which would be submitted to the PCT assembly that would occur in September/October 2008. The topics discussed were the following:

Proposals by Israel (PCT/WG/1/2)

It was proposed allowing applicants to delay the beginning of the national phases by up to six additional months whenever the ISR was not timely completed. This was rejected by the Working Group. It was decided that the MIA should study the causes of the ever more frequent delays, in order to improve the timeliness of the searches. Your observer suggested, as an option, postponing the obligation to present a translation, as this is most often the costliest item in a filing. A second proposal by Israel was having a standard form for national phase entry. It was decided that the IB would further study the matter.

Enhancing the Value of the International Search and Preliminary Examination (PCT/WG/1/3)

The IB used this paper to probe the attendants' opinions on the possible causes for the recent trend of providing alternatives to the PCT. It would seem that the problem was not in the Treaty itself, but on the way it was being used. The paper was complex, touching upon many different issues, such as content of the ISR and of the IPRP, trust in reports prepared by other Offices, decrease in the number of demands, and the possibility of processing the international and national phases in parallel by those national offices that were also IAs. Most stressed the importance of a high-quality search, whilst some noted that the national searches were necessarily better, because their result was binding. Commenting on the decline in the quantity of demands, your observer noted that the lack of certainty of a dialogue in Chapter II seemed to be one of the causes.

Filing and Processing of Sequence and Computer Listings (PCT/WG/1/2 and 4)

The IB proposed eliminating the mixed-mode filing of sequence listings, which many presented first in PDF format and later, just for the search, in text format. The IB proposed creating incentives for the uniform adoption of the ST.25 format (searchable

text). This was adopted. However, Israel's proposal of electronically filing computers listings was rejected.

Physical Requirements of the International application (PCT/WG/1/2 and 5)

The main intent of this proposal was optimizing the processing of applications filed on paper, which were being scanned and going through an OCR process, so as allow their texts to be added to digital databases. It was decided that a set of recommendations would be submitted to the ST.22 task force dealing with the matter. The SCIT (Standard Committee on Information Technologies) would be invited to further study standards related to color images in patent and trademark applications. For the last, it was noted that the Receiving Office Guidelines should better specify which of requirements set out in Rule 11 should be actually enforced, for being important for the international processing of the applications.

Criteria for Adding Languages of Publication (PCT/WG/1/6)

The IB was working on a draft Common Understanding, to be submitted to the Assembly, in which criteria for the addition of further publication languages would be defined. The suggested criteria were: the acceptance of the language in question by at least one ISA, the number of first-filing applications filed in that language, the availability of machine translation from the particular language into English, and the possibility of adding texts in that language to a public free-access database.

Supplementary International Searches - Consequential Amendments (PCT/WG/1/7)

The Supplementary International Search system will most probably become operational in January 2009. Initially, Austria, Nordic Patent Institute and Russia will offer the service. The EPO plans to join them in January 2010. Sweden and Australia are also considering the possibility. Amendments to the regulations were

approved and will be submitted to the Assembly. Relevant changes concern: refunding of the search fee after the withdrawal of the application, allowing the SISA to be the recipient of the statement explaining the lack of signature of one of the applicants, and clarifying that the withdrawal of a SIS request should not affect the entire processing of the international application.

Transmittal of the International Application, Translations and Related Documents (PCT/WG/1/8)

The IB proposed offering an additional service to the international authorities. The search copies, normally sent on paper to the ISAs by the ROs, will be transmitted electronically through the EDI (Electronic Data Interchange) links maintained between the IB and the ISAs. This will avoid the delays that have been causing the international applications to be first published without classification.

Missing Elements and Parts (PCT/WG/1/9)

It was proposed amending the regulations so as to require that any priority document, in order to possibly have its matter incorporated by reference in an application, should be fully identified at the time of filing. It was also suggested amending Rule 20.6 so as to give a further opportunity for rectifying inconsistencies in the document to be incorporated by reference. Both proposals were remanded to the IB for further consideration. It was agreed that the Receiving Office Guidelines would be amended so as to clarify the procedures under Rule 4.18 and 20.6, particularly in those cases in which incorporation by reference would result in the duplicity of elements (description, set of claims or drawings) in an application.

Rectification of Obvious Mistakes - PCT/WG/1/10

The US proposed allowing the data contained in the request to be used to correct information about the claimed priority, as appearing in the description. The proposal was rejected.

Processing Under Article 14(4) - PCT/WG/1/11

There seemed to be an inconsistency between the regulations and Article 14(4). In those cases in which the RO erred when assigning a filing date, because not all elements of the application had actually been present at the time of filing, and the mistake was identified within 4 months from the filing, Article 14 (4) would not allow an invitation to correct to be sent. It was then agreed the Rule 29.4 would be amended so as to allow the RO to issue a notification to the applicant, giving him 2 months to submit arguments, before declaring the application as withdrawn..

Treatment of Extraneous Matter (PCT/WG/1/12)

The US had noted that some applications contained matter that could not be considered as a clear part of the application. Such matter could

consist, for instance, of manuals, computer listings, etc. It was approved that the Receiving Office Guidelines should be amended so as to instruct the Offices to request clarification from the applicant, and to disregard the matter in question whenever no explanation was given.

Amendment of Claims (PCT WG/1/13)

The Working Group approved amendments to Rules 46.5 and 66.8 which will be submitted to the Assembly. After the implementation of the changes applicants will be required to submit a complete set of claims, whenever amending one or more of the claims. The amendments shall be accompanied by a letter indicating each of the changed claims and the differences between the original version and the new one..

Claims Fees (PCT/WG/1/14)

The concept of claims fees in the PCT found ample support among the delegations. Accordingly, the EPO was invited to present a detailed proposal, which shall be probably presented in a future meeting of the Working Group.

Headings in PCT Applications - PCT/WG/1/15

The proposal, presented jointly by Japan, United States and the EPO, was aimed at introducing in the PCT the section headings for applications that were defined in the Common Application Format (CAF) that had been developed by those offices. However, a package of changes to the Administrative Instructions would be the subject of consultations that would take place in the near future, and these would consider, among others, the CAF-related amendments.

Further Work

After being revised by the IB, the draft amendments to the regulations that were to be submitted to the Assembly would be posted in the Working Group's electronic forum. Delegations and observers were invited to present comments. It would be suggested to the Assembly that, if necessary, another meeting of the Working Group should happen between September 2008 and September 2009.

[End of document]