

Standing Committee on

Patent Cooperation Treaty - PCT

2016



Date: 12th September 2016

REPORT Standing Committee on

Patent Cooperation Treaty - PCT

Chair: Andrew SIMPSON

Responsible Reporter: John Osha

1) Report on the activities of your Standing Committee during the reporting period

Please provide a general overview of the activities of your Standing Committee over the last 12 months, but please include at least:

a) meetings of the Standing Committee during the reporting period

None in person since the meetin in Rio. The committee is too geographically spread for telephone calls of the entire committee, but numerous e-mail communicacions during the reporting period have focussed the projects for the committee to review.

b) any external representation on behalf of AIPPI by any member of your Standing Committee

Attendance by Gilles Pfend at meetings of the WIPO PCT Working Group in Geneva. Topics included:

- Color Drawings (based on working document PCT/WG/9/19)
- National Phase Entry using Epc (based on working document PCT/WG/9/24)

Summary of meeting

Color Drawings

1. The International Bureau proposed to discuss a revised plan, seeking to offer full color processing in the international phase only for international applications filed in XML format and not those filed as PDF.
2. To provide support for applicants unable to file in XML format, a previous proposal is revisited, to continue to process applications filed in color as PDF documents based on conversion to black and white, but to make reference on the front page to the fact that the application had been filed in color and to make the original document available on PATENTSCOPE for easy reference.
3. The importance of working towards effective handling of color drawings, which were important for effective disclosure of inventions in the biological and pharmaceutical fields, was acknowledged by all the participants .
4. However, several delegations representing National or Regional Offices acting as International Searching Authorities, indicated that they are not yet able to process documents with color drawings "end to end" or to commit to a specific timetable for doing so.
5. The Working Group agreed that the International Bureau should issue one or more PCT

Circulars for consultation on:

- (a) the technical, legal and administrative issues involved in beginning the interim solution set out in paragraphs 11 to 15 of document PCT/WG/9/19;
- (b) the technical and legal issues involved in ensuring that Offices are able to work effectively towards implementing full processing of international applications with color drawings, at least for the international phase and at least when filed in XML format;
- (c) understanding the legal and administrative issues which may apply to the responsibilities of the receiving Office, priority documents, subsequently-filed documents, documents filed on paper or in formats other than XML, and to the relationship of these issues with the Patent Law Treaty; and
- (d) finding out which Offices accepted color drawings at present in their various capacities (receiving Office, International Authority or designated Office) or were conducting work towards being able to do so in the future.

National Phase Entry using ePCT

1. The International Bureau set out a concept for using ePCT to trigger national / regional phase entry. The aim was to provide “a secure, interactive platform to assist cooperation between an instructing agent and a local agent prior to national phase entry, allowing both parties to be confident that the key information was in a mutually satisfactory form before the national phase processing began.

The International Bureau indicated that it “does not see the purpose of this proposal as reducing the professional role of the national agent in respect of national phase entry”.

2. While noting that many legal, fee payment and technical issues remained to be addressed, most delegations which took the floor broadly supported the general approach of the “proof of concept” system and expressed their interest in further reviewing the system with a view towards providing feedback on its functionalities.

3. Several delegations representing international non-governmental organizations, like APAA and Japan Patent Attorney Association expressed their concern with regard to the “alleged” advantages of ePCT national phase entry. They consider that the advantages of said system might be significantly limited due to different languages and different patent laws among PCT contracting parties.

4. The Working Group agreed that the International Bureau should issue a Circular to Offices and user groups providing further information on the “proof of concept” system and clarifying the aspects of the system on which comments were particularly sought. Depending on the feedback given, the International Bureau should then propose any further steps and timetable for a possible move to a pilot system.

Conclusions / observations

See items 4, above

Actions / matters to be considered by the Bureau

AIPPI, respectively the Standing Committee on PCT, should actively participate in the consultation regarding the ePCT the “proof of concept” system.

- c) any contribution by your Standing Committee to any external consultations
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See previous point on WIPO Working Group. Also, the committee is working on a review of the extent to which national patent offices recognize prior work done by the same office during the international phase before the same office as ISA or IEA.

A report on this project is nearly complete, but is missing some significant countries, in part because the committee does not have members in those countries. The committee intends to reach out to contacts in such countries to make the final report more meaningful.

- d) any studies or analyses undertaken or position papers prepared by your Standing Committee, with a brief summary of the outcome(s)
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see above

- e) involvement of your Standing Committee in any other activities of AIPPI, eg Panel Sessions, contribution to Study Guidelines, etc
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None. The PCT is a mature treaty with now incremental changes that do not typically justify such activities. However, the committee is cognisant of opportunities to educate either on fundamental procedure in the PCT or important new developments.

- f) any other relevant activities
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none

- 2) Key issues/developments relevant to the Terms of Reference of your Standing Committee during the reporting period

Please include a short summary of any significant case law, legislative or regulatory developments, or policy initiatives, including their relevance and/or any implications for the work of your Standing Committee or for AIPPI more generally

see above

- 3) Any recommendation for AIPPI involvement/action for the next 12 months

This need not be limited to recommendations for your Standing Committee but can be recommendations for AIPPI more broadly. In each case, please explain why such involvement/action is recommended, by whom it should be undertaken and any relevant time frames. For example, please include:

- a) any recommendation for involvement/action in relation to any upcoming or foreshadowed case law, legislative or regulatory developments, or policy initiatives
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the committee will continue to follow the activities of the WIPO PCT Working Group, but in more detail. Plans are in hand to report on significant issues addressed by the Working Group in more detail, beyond that can be covered by actual attendance at WIPO meetings by committee member(s). Such attendance is very valuable, but is necessarily limited by proximity of members and their available time.

- b) any other recommendation(s) for AIPPI involvement/action
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not responded

- 4) Outline of the work programme of your Standing Committee for the next 12 months

Please set out specific activities and priorities having regard to the matters in 1) - 3) above, including any relevant time frames

see above.

Names and Functions of Committee Members

Chair	Andrew SIMPSON	United States of America
Co Chair(s)	Gianfranco DRAGOTTI	Italy
Secretary	Gilles PFEND	Switzerland
Members	Güler AYYILDIZ	Turkey
	Rafael B. BELTRAN RIVERA	Mexico
	Ana Paula CELIDONIO	Brazil
	Noel COURAGE	Canada
	Loren HULSE	United States
	Cansin KARGA	Turkey
	Nazli KORKUT	Turkey
	Kiyoshi KUZUWA	Japan
	Aurelio Hernandez LEHMANN	Spain
	Yi LU	China
	Dulce M. MIRANDA	Spain
	Santiago ORTUZAR	Chile
	Elisabetta PAPA	Italy
	Gastón RICHELET	Argentina
	Jakub SIELEWIESIUK	Poland
Marco ZARDI	Switzerland	
Zongliang (Stephen) ZOU	China	