

Report on the Patent Cooperation Treaty Working Group and Assembly 2021

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The Patent Cooperation Treaty (PCT) Working Group held its 14th session from June 14 to 17, 2021, in a hybrid meeting format due to the ongoing pandemic situation. The session saw most people attending virtually while others attended in person. The agenda for the Working Group and the Draft Summary of the meeting, prepared by the World Intellectual Property Organization (WIPO), are available online. Most of the Working Group attendees are representatives of patent offices from member countries and regions of the PCT; other attendees include representatives of observer organizations such as AIPPI, JPAA, AIPLA and observer countries.

Discussed below are some of the key themes and topics that emerged and were discussed. The themes, particularly those such as disruptions, will likely run for some time and will continue to be debated at this year's Working Group meeting, which has not yet been scheduled.

General Disruptions - New Provisions

Covid portal for WIPO updates: https://www.wipo.int/portal/en/news/2020/article_0015.html

Covid policy tracker:

<https://www.wipo.int/covid19-policy-tracker/#/covid19-policy-tracker/ipo-operations>

One of the topics, handling general disruptions, was inspired by the COVID-19 pandemic and sought to address the unprecedented situation by making changes to PCT Rule 82*quater* (Agenda item 6). Rule 82*quater* addresses disruptions due to *force majeure*.

As the pandemic developed, WIPO was key in collating and disseminating information on its Receiving Offices and network. The links above act as the latest information on the situation in patent offices around the world.

The proposed changes to Rule 82*quater* were agreed upon by the Working Group after much discussion and debate. The changes to Rule 82*quater* were adopted and approved by the PCT Assembly meeting October 4-8, 2021, and the changes will come into effect on July 1, 2022.

As Rule 82*quater* addresses disruptions due to *force majeure*, one change to the Rule made was that "epidemic" is now added to the list of causes of *force majeure* in Rule 82*quater*.1(a). WIPO observed that one third of patent offices closed for a period of time due to the pandemic, some offices for longer periods of time than others.

The remainder of the changes to Rule 82*quater* are the addition of new sections 82*quater*.1(d) and 82*quater*.3 set out below.

New subsection 82*quater*.1(d) allows a patent office to waive the requirement for an Applicant to submit evidence for a failure to meet a time limit in certain circumstances of general disruption. To receive the waiver of the evidence requirement from the patent office, the Applicant must submit a statement that the failure to meet the time limit was due to the reason for which the requirement concerning the submission of evidence was waived. Rule 82*quater*.1 *excuses* (delays in meeting) deadlines.

The wording of new subsection Rule 82^{quater}.1(d):

The need for evidence may be waived by the Office, Authority or the International Bureau under the conditions set and published by that Office, Authority or the International Bureau, as the case may be. In such case, the interested party must submit a statement that the failure to meet the time limit was due to the reason for which the Office, Authority or the International Bureau waived the requirement concerning the submission of evidence. The Office or Authority shall notify the International Bureau accordingly.

The entirely new section in Rule 82^{quater}, Rule 82^{quater}.3, permits patent offices and Authorities to *extend* deadlines when that patent office is affected by *force majeure*. The extension of deadlines can last up to two months. Under this Rule, the extension applies to all PCT *regulations*, but not to the 12-month Paris convention priority date, nor to Regional/National Phase entry deadlines. For Rule 82^{quater}.3 to apply, the patent office must be affected by *force majeure*, and extensions under Rule 82^{quater}.3 trigger notification requirements; for example, the affected patent office is required to notify WIPO of non-working days.

The wording of new section Rule 82^{quater}.3:

(a) Any receiving Office, International Searching Authority, Authority specified for supplementary search, International Preliminary Examining Authority or the International Bureau may establish a period of extension such that time limits fixed in the Regulations within which a party has to perform an action before that Office, Authority or International Bureau may be extended when the State in which it is located is experiencing a general disruption caused by an event listed in Rule 82^{quater}.1(a) which affects the operations at the said Office, Authority or International Bureau thereby interfering with the ability of parties to perform actions before that Office, Authority or International Bureau within the time limits fixed in the Regulations. The Office, Authority or the International Bureau shall publish the commencement and the end date of any such period of extension. The period of extension shall not be longer than two months from the date of commencement. The Office or Authority shall notify the International Bureau accordingly.

(b) After establishing a period of extension under paragraph (a), the Office, Authority or the International Bureau concerned may establish additional periods of extension, if necessary under the circumstances. In that case, paragraph (a) applies mutatis mutandis.

(c) The extension of a time limit under paragraph (a) or (b) need not be taken into account by any designated or elected Office if, at the time the information referred to in paragraph (a) or (b) is published, national processing before that Office has started.

The significant rule changes here to add 82^{quater}.1(d) and 82^{quater}.3 illustrate the unprecedented times we have experienced over the last 24 months and provide security and certainty for Applicants and users of the PCT system. These amendments to Rule 82^{quater} aim to allow flexibility within the PCT system should an unforeseen and global situation arise. These changes go into effect on July 1, 2022.

New Sequence Listing Standard

A new standard for filing sequence listings via the PCT has been in the works for some time. The new standard is crucial in many life sciences applications. If a patent application discloses nucleotide and/or amino acid sequences in any of the description, claims and/or figures, then a sequence listing must be provided. The sequence listing forms part of the description and must comply with the requirements of the relevant WIPO standard. The purpose of the listing is to enable the data to be searchable by WIPO member states' patent offices and by publicly searchable databases.

The new standard, ST.26 (previous standard: ST.25), is an XML standard which will bring benefits of a format more closely aligned to the formats used in public databases and able to include characteristics of sequences, to provide more information for searching. ST.25 compliant sequence listings are permitted to be provided on paper or in a .txt based format. Characteristics of sequences are not currently supported by ST.25.

At the PCT Working Group meeting, it was suggested that the standard, originally slated for a January 1, 2022, start, be postponed to July 1, 2022, and the Sequence Listing Working Group adopted this suggestion, so ST.26 will begin on July 1, 2022, for all PCT Applications filed on or after that date. It is important to note that WIPO Standard ST.26 will be an exclusively electronic data format and XML format must be used. It will not be possible to file a sequence listing on paper or in a non-XML electronic format (e.g., images, .pdfs) for the purpose of an international search. There is a new software tool for this, although it is not mandatory to use this tool and others have been developed – WIPO Sequence and WIPO Sequence Validator (https://www.wipo.int/standards/en/sequence/?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery&utm_term).

Discussion of the new sequence listing standard (Agenda item 13) indicated concerns that the software tool needed further work, and that the rule changes being made to accommodate the new sequence listing standard would be approved a very short time prior to institution of the new standard. The short period of time was considered by some to be a disadvantage to Applicants and the postponement to the July 1, 2022, date was agreed.

The Rules in which changes were made for the new sequence listing standard are Rules 5, 12, 13, 19, and 49. The rule changes were approved by the PCT Assembly at their meeting October 4-8, 2021.

Per the November 2021 PCT Newsletter, a new release of WIPO Sequence (version 1.1.0) was launched on 28 October 2021, and contains a set of ST.26 sequence listings for testing purposes, which is available at <https://www.wipo.int/standards/en/sequence/index.html>, and a recording of a webinar in English about WIPO Sequence and the presentation in PDF format are available at https://www.wipo.int/meetings/en/details.jsp?meeting_id=62849.

Proposed Adoption of PPH into the PCT

Another key discussion point was the formal adoption of the Patent Prosecution Highway (PPH) into the PCT (Agenda item 7). The PPH adoption was proposed and discussed but not passed. Formal adoption of the PPH into the PCT would increase work-sharing between patent offices and minimize the need for bilateral PPH agreements. Due to increased interest in sharing of work between patent offices, the proposal was generally supported and received positive input. Suggestions by various patent offices to accommodate concerns included limiting the number of applications by technology area and/or by Applicant, or by number of applications generally. It was noted that, if adopted, the PPH would remain opt-out for each patent office. WIPO has indicated that this proposal will probably be revisited at the next Working Group meeting, so formal adoption of PPH into the PCT may occur in the relatively near future. We should be actively watching for movement and any consensus in this area by the various patent offices.

Collaborative Search and Examination Pilot

The Collaborative Search and Examination Pilot program (Agenda item 15) was discussed. The search and examination phase of the pilot program ended in June 2020, and is undergoing evaluation. Results of the evaluation will determine future action, such as whether to re-institute the program and/or to expand the program to more patent offices.

We note that supplemental search was discussed at length in 2020 and may also be revisited.

Certified copies

The topic of certified copies of earlier PCT applications (Agenda item 8) was an issue that led to a more general discussion of (electronic) certified copies of electronic documents. This in turn led to mention of WIPO's Digital Access Service (DAS), which is primarily used for providing electronic certified copies of priority documents so that paper certified copies are no longer necessary. These priority documents are provided by patent offices that participate in DAS; a list of patent offices that participate in DAS is provided at https://www.wipo.int/das/en/participating_offices/.

There are currently draft amendments for the provisions in the PCT regulations but at present the International Bureau (IB) does not recommend allowing the IB to prepare for the Applicant certified copies of applications for which it did not act as Receiving Office

For this topic, a document prepared in prior to the Working Group meeting (https://www.wipo.int/edocs/mdocs/pct/en/pct_wg_14/pct_wg_14_16.pdf) made several suggestions. Option (iii) in that document, use of a digital library, is at present being considered for a revised proposal at the next Working Group meeting.

PCT Applications in XML

Another future-facing issue discussed at the Working Group meeting was filing of PCT applications in XML format (Agenda item 9). WIPO wants to increase the number of PCT applications filed in XML format. While many patent offices indicated support for this, a number of issues were raised, including whether the Applicant or the patent office should carry out the conversion to XML format, and which XML standard to use. These issues will need to be addressed before filing PCT applications in XML format becomes commonplace.

The above are a set of key highlights and topics that took up a significant amount of time in the main discussion at the PCT Working Group meeting. The Working Group considers many other points and takes direction on topics to look at and investigate from interested parties and national patent office groups. In particular, other topics that were discussed or have been given consideration in recent years include WIPO inventor assistance programs, Continuing Professional Development (CPD) and Examiner training across patent offices, both the provision of in person training and other online/electronic options, International Searching Authority training and provision, fee reductions and other assistance along with broad principles of collaboration across regions and patent offices.

As seen from the above, the PCT system is dynamic, and WIPO as well as the many members (patent offices) continually seek ways to improve the PCT Regulations and processes for both Applicants and the WIPO member states' patent offices.

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