

APAA AU Day Meeting 2014

Update on PCT Working Group

Seventh Session

Geneva, June 10 to 13, 2014

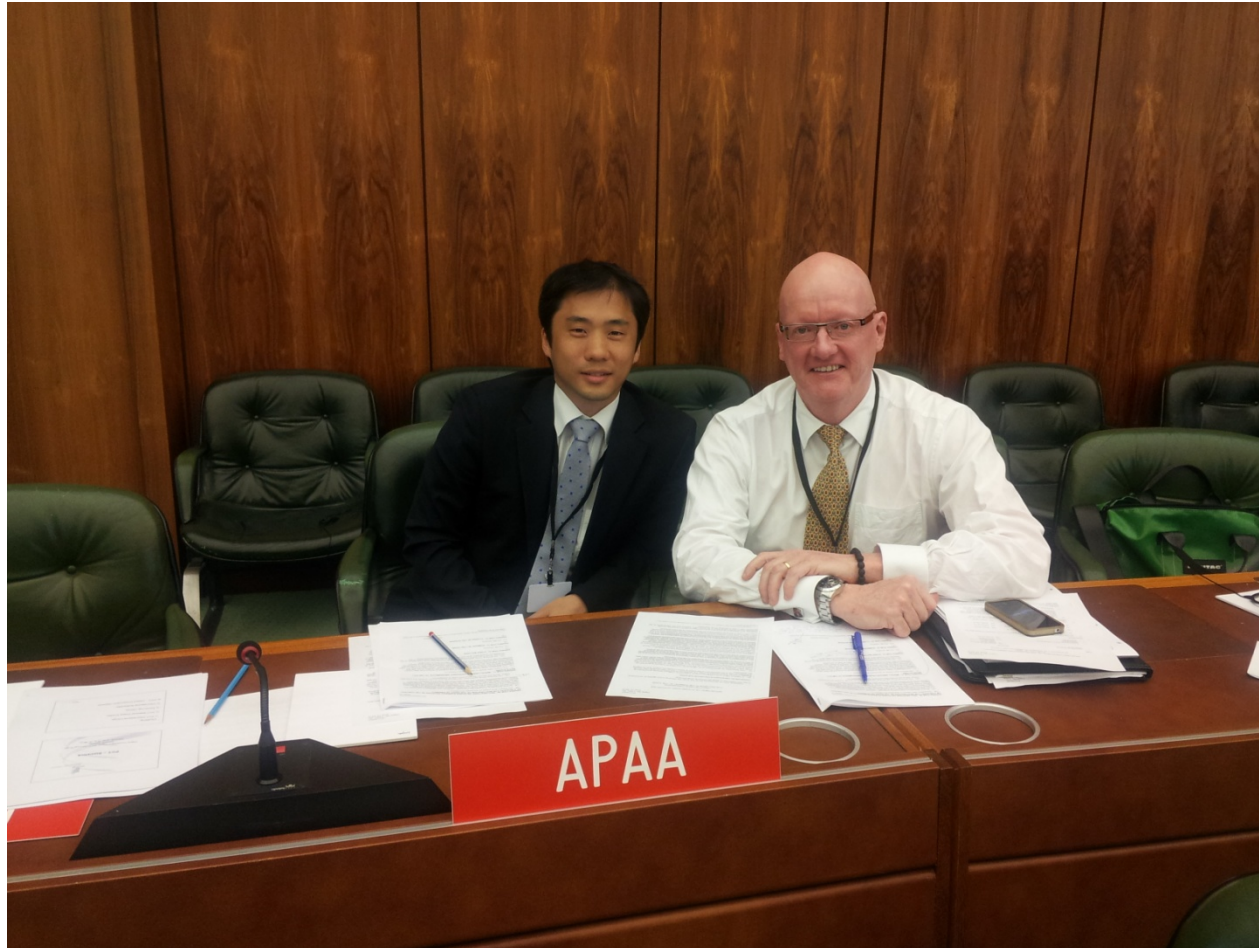
PCT Working Group – 7th Session

- Over 30 Agenda items
- Only 4 days
- Many updates, Papers from IB for Notice
- Significant (or potential) impact papers including
 - National Phase entry via ePCT
 - Right to Practice before IB
 - General Power of Attorney
 - Fee Reductions
 - Procedure for Incorporation of Missing Parts
 - Formal Incorporation of PPH into PCT

Your Representatives

Mincheol Kim (KR)

Paul Harrison (AU)



Formalising PPH in PCT

- Paper submitted by UK and USA
- “at the applicants option, national or Regional Offices expedite NP applications which are presented with only claims indicated as meeting criteria of PCT Article 33(2)-(4) by Isa or IPEA” and thereby effectively “reduce cost of pursuing patent protection through the PCT”
- WG invited to consider and comment on specific amendments to certain rules
- Opposed strongly by Group B led by Brazil
- Questions over whether offices “opt out” or “opt in”
- Benefits not sufficiently defined or proven
- Defacto harmonisation

Fee Reductions

- Interesting political and economic discussion
- Current 90% reduction in fees for applicants in developing countries
- New criteria based on current economic data and innovative
- Opposed by African Group but eventually brought around
- Discussion about fee reductions for Universities, Public or Not for Profit Research Institutes
- Concern about Universities from developed world eg US versus others
- No real agreement other than limitation only to Universities
- Good discussion and Data on Fee Elasticity and effect of Fees on behaviours

NP Entry via ePCT

- International Agent identifies Local Agent and simply ticks the box
- Potential for no involvement of local agent
- Payments must be done separately.
- Paper was a “concept” and not a proposal
- Almost all Offices indicated significant “legal and technical obstacles”
- Some highlighted there should be no negative impact on Patent Agents/Attorneys
- User groups quite vocal in areas of concern
- Further work to be done
- We MUST monitor carefully and engage WIPO closely on this issue

Right to Practice before IB

- Another example of IB cracking egg with sledgehammer
- Agent not competent to act for Applicant before IB
- Extra work for IB in getting replacement signatures etc
- About 750 cases
- Allow any national agent to act before IB
- Unintended consequences not recognised by the IB
- Most offices strongly against proposal
- IP AU suggested could proceed only to correct error and then must use “competent” agent
- Users and offices generally agreed

Minor Issues

- Changing Time Zones
- Requiring copy of Original Power of Attorney
- Colour Drawings (optional)
- Appointment of new ISA's
- Handling of Sensitive information used in Restoration Proceedings
- Clarifying Procedure for Missing Parts
 - US delegation specifically asked for more user support
 - Worthy of further discussion amongst user groups

Recommendations

- Formal submissions within a few weeks on ePCT
- Improve channels of communication within APAA
- Establish commonality of approach within observers (if possible) and develop strategy for most effective communication to WIPO
- Instigate meeting with Country Delegations particularly Group B (US, EP, JP, KR, AU etc) prior to WG
- Maintain wathing brief on ALL WIPO circulars and proposals