

## **Meeting of International Authorities Under the Patent Cooperation Treaty (PCT)**

**Twenty-Fourth Session**  
**Reykjavík, February 8 to 10, 2017**

### **TRANSMITTAL OF THE COPIES OF DOCUMENTS CITED IN INTERNATIONAL SEARCH REPORTS OR INTERNATIONAL PRELIMINARY EXAMINATION REPORTS**

*Document prepared by the Korean Intellectual Property Office*

1. Under the PCT, the international filing date should first be accorded then entry into the national phase is normally delayed to 30 or 31 months after filing an international application. The international search (IS) and the international preliminary examination (IPE) carried out in a period between the international filing date and a national phase entry date allows the applicant to predict eligibility of the application and raise its eligibility through amendments when entering the national phase by taking advantage of the IS and the results of the IPE. In the process, the applicant should review the international search report (ISR) and the citation of the documents attached as annexes to the international preliminary examination report (IPER) as well.
2. As a designated Office (DO) or elected Office (EO), the national Office may review the results of the IS and of the IPE at the beginning of the national phase. In the process, the citation of the documents attached to the reports should be reviewed.
3. The International Searching Authority (ISA) should transmit the ISR or declaration under Article 17(2)(a), along with the written opinion of the ISA (WO/ISA) established in compliance with Rule 44.1 to the applicant. The International Preliminary Examining Authority (IPEA) should send out the IPER and annexes in accordance with the amendments defined under Article 19 or 34 to the applicant. In other words, the documents cited in the ISR and the IPER do not have to be transmitted together with the report to the applicant and the national Office.
4. This is because the applicant and the national Office may generally access the citation in a digital library. However, it is not easy to find some cited documents in an e-library. In addition, certain applicants are unable to access the e-library. This makes it difficult for certain national Offices and applicants to get easy access to certain documents in the digital library.

5. In such cases, Rules 44.3 and 71.2 define that where the applicant or the national Office files a request for a copy of the citation attached to the ISR and the IPER within seven years from the international filing date, the ISA and IPEA should furnish the citation with a post handling fee and copying costs being paid. By taking advantage of this regulation, the applicant and the national Office may better review and utilize the results of the IS and of the IPE.

(a) According to a survey conducted by KIPO, respondents are not aware of an official channel and way to file a request for a copy of a citation in an ISR or IPER, such as through information included in the ISR, the IPER, on the website of the International Authority, or in the PCT Applicant's Guide. In other words, even though the applicant and the national Office want to request the citation according to PCT rules, they could not get a copy of the citation as they did not have access to information on the formal route or applicable requirements to make the request.

(b) As for the citation attached to the ISR, to make the applicant freely access a copy of cited documents – including patent documents and non-patent literature – within six months after the ISR has been issued, KIPO informs the applicant of the URL through which to download cited documents in Form PCT/ISA/220. KIPO also plans to offer a relevant service to enable the applicant or national Office to download the citation attached to the IPER from the second half of 2017. Further, where the applicant or the national Office needs a citation after the six month period has expired, they can make a directly request to KIPO by e-mail.

6. Therefore, KIPO would like to suggest the following:

All International Authorities provide information in the PCT Applicant's Guide on the official route where the applicant and the national Office may file a request for a copy of cited documents in the ISR or in the IPER and the costs concerned.

(a) It is desirable for all International Authorities to guide the aforementioned information in the same manner and to apply the same calculation methods regarding the costs concerned. Further, where cited documents are downloaded electronically, as a post handling fee is not incurred, this should be excluded from the sum.

(b) [Example] A request for the citation

The applicant or a designated or elected Office may file a request for a copy of the citation attached to an ISA or IPEA produced by KIPO via [kipoisa@korea.kr](mailto:kipoisa@korea.kr) and should pay a post handling fee and copying costs.

As filing a request for a search copy, the national Office should verify whether the PCT application has entered the national phase.

(c) [Example] Costs calculation

Sum due = copying costs + a post handling fee (a person to request a search copy should bear all charges of the banks engaged in the transfer of the payment).

(d) However, as it could be incompatible with national law to provide non-patent literature to third parties, not to the applicant, non-patent literature cannot be transmitted. When it comes to certain non-patent literature, such as a catalogue of domestic businesses and an academy brochure not accessible from foreign countries, the ISA or the IPEA may provide ways to access non-patent literature and furnish a search copy for the cited art in support of publically well-known prior art, including a textbook or an encyclopedia.

*7. The Meeting is invited to comment on the proposal outlined in the present document.*

[Annex follows]

PCT REGULATIONS RELATED TO  
TRANSMITTAL OF THE CITED DOCUMENTS

**Rule 44**  
**Transmittal of the International Search Report, Written Opinion, etc.**

*44.1 Copies of Report or Declaration and Written Opinion*

The International Searching Authority shall, on the same day, transmit one copy of the international search report or of the declaration referred to in Article 17(2)(a), and one copy of the written opinion established under Rule 43*bis*.1 to the International Bureau and one copy to the applicant.

*44.2 Title or Abstract*

The international search report shall either state that the International Searching Authority approves the title and the abstract as submitted by the applicant or be accompanied by the text of the title and/or abstract as established by the International Searching Authority under Rules 37 and 38.

*44.3 Copies of Cited Documents*

(a) The request referred to in Article 20(3) may be presented any time during seven years from the international filing date of the international application to which the international search report relates.

(b) The International Searching Authority may require that the party (applicant or designated Office) presenting the request pay to it the cost of preparing and mailing the copies. The level of the cost of preparing copies shall be provided for in the agreements referred to in Article 16(3)(b) between the International Searching Authorities and the International Bureau.

(c) [Deleted]

(d) Any International Searching Authority may perform the obligations referred to in paragraphs (a) and (b) through another agency responsible to it.

**Rule 71**  
**Transmittal of the International Preliminary Examination Report**

*71.1 Recipients*

The International Preliminary Examining Authority shall, on the same day, transmit one copy of the international preliminary examination report and its annexes, if any, to the International Bureau, and one copy to the applicant.

*71.2 Copies of Cited Documents*

(a) The request under Article 36(4) may be presented any time during seven years from the international filing date of the international application to which the report relates.

(b) The International Preliminary Examining Authority may require that the party (applicant or elected Office) presenting the request pay to it the cost of preparing and mailing the copies. The level of the cost of preparing copies shall be provided for in the agreements referred to in Article 32(2) between the International Preliminary Examining Authorities and the International Bureau.

(c) [Deleted]

(d) Any International Preliminary Examining Authority may perform the obligations referred to in paragraphs (a) and (b) through another agency responsible to it.

[End of Annex and of document]