

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 International Bureau

SUMMARY

1. It is recommended that International Authorities update their entries in the PCT Applicant's Guide to ensure that it is clear how applicants and designated Offices are able to obtain copies of cited documents.
2. The International Bureau invites International Authorities to routinely transmit copies of cited non-patent literature to the International Bureau, so that copies can be held securely and made available when required by the Treaty in a single, centralized manner independent of which International Searching or Preliminary Examining Authority (ISA or IPEA) cited a document.

ISSUE

3. Most patent documents are easily available to applicants and designated Offices. In document PCT/MIA/24/8, the Korean Intellectual Property Office (KIPO) points out that, while many cited non-patent literature documents can also be retrieved easily, at least by designated Offices, some non-patent literature documents are very difficult for applicants and designated Offices to obtain.

4. Under PCT Articles 20(3) and 36(4), as well as Rules 44.3 and 71.2, International Searching and Preliminary Examining Authorities are required to send copies of documents cited in the international search report or first cited in the international preliminary examination report to the applicant or to any designated Office on request and potentially on payment of a fee. Some International Authorities routinely send copies to the applicant as part of their service. However, KIPO in its role as designated Office had found that it was not easily able to determine how to obtain such copies from all International Authorities and requested that this be clarified.

INFORMATION IN THE APPLICANT'S GUIDE

5. It is important that applicants and designated Offices are able to find out how to obtain copies of cited documents easily, irrespective of which International Authority first cited them. The PCT Applicant's Guide at present provides the following information:

- (a) Paragraph 7.026 (referring to Article 20(3) and Rule 44.3) gives general information on the ability to obtain copies from the ISA. Paragraph 10.082 gives similar information for the case where a citation made by the IPEA which was not in the international search report.
- (b) Annex B of the Applicant's Guide gives contact information for each ISA and IPEA.
- (c) Annex D of the Applicant's Guide indicates the fees payable to each ISA for providing copies of documents, matching the fees which appear in the Agreements between the International Bureau and each International Authority. Annex E does the same for each IPEA.

6. ISAs and IPEAs should ensure that their information is as complete and accurate as possible. All Authorities are invited to review their Annexes and ensure that they are complete, particularly with regard to the information necessary to obtain copies of cited documents. If there are different contact points or online services which should be used for special services, such as requesting copies of cited documents, this should be made clear, as should the costs and means for making any necessary payments.

7. The International Bureau would be happy to review the layout of the Annexes to make sure that the information is as easy to use as possible. This might include repeating ISA contact information in Annex D so that it is not necessary to look in two different annexes and ensuring that any different contact points for special services, such as ordering citations, are made clear.

CENTRALIZED SERVICE FOR ACCESS TO DOCUMENTS

8. The International Bureau already offers a secure service which allows International Authorities to upload copies of cited documents to the International Bureau's systems, either through the ePCT browser-based services or, preferably, by automated batch upload using PCT-EDI.

9. For copyright reasons, these documents are not made available to the public but are available only to applicants and designated Offices through the secure ePCT browser-based services; it is expected that secure web services will be made available in the near future, allowing fully automated requests for documents.

10. At present, no International Authority routinely uses this option and the citations available through this service are almost entirely those which are uploaded together with third party observations. However, if Authorities were to transmit copies of non-patent literature documents to the International Bureau together with the international search report, this would quickly become a valuable service for applicants and designated Offices, avoiding the need to

look up a different service in respect of each ISA from which copies of citations were required and waiting for manual retrieval and paper copies to be delivered.

11. It is not suggested that ISAs and IPEAs should transmit copies of patent documents since these are usually very easily obtained. It should be noted that, in 2017, the International Bureau intends to offer a service linking to cited patent documents for easy retrieval in the case of international applications where the international search report is established in XML format, so that this process can be readily automated.

12. *The Meeting is invited:*

(i) to note the request for International Authorities to ensure that the information in the Applicant's Guide concerning their services is complete;

(ii) to note that the International Bureau already offers a secure, centralized service for making copies of citations available to applicants and designated Offices; and

(iii) to discuss options for improving information and services concerning access to cited documents.

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