

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

**Twenty-Seventh Session
Gatineau, February 6 and 7, 2020**

PROPOSAL TO TRANSMIT THE ANNEXES TO THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT AS SEPARATE DOCUMENTS

Document prepared by the Intellectual Property Office of Singapore

SUMMARY

1. Document PCT/WG/12/12, presented at the twelfth session of PCT Working Group meeting, proposed to make written opinions of the International Preliminary Examining Authorities (IPEA) as well as the amendments and/or the letters to be available to the public on PATENTSCOPE. Corresponding amendments were approved by the PCT Assembly and will come into force in July 2020. As a next step, the Meeting is invited to review the possibility of ceasing to include amendments, rectifications and letters as annexes of the international preliminary examination report (IPER) in a single document if they could be more conveniently transmitted and used as separate documents.

BACKGROUND

2. In line with the ongoing efforts to promote transparency within the PCT processes and linkage between the international phase and the national phase, the Intellectual Property Office of Singapore put forth the following proposals at the twelfth session of the PCT Working Group (document PCT/WG/12/12):

- (a) Rule 71.1 be amended to insert Rule 71.1(b) for transmitting copies of other documents from the file of the international preliminary examination to provide a basis for requiring IPEAs to transmit additional documents to the International Bureau (see Annex I of document PCT/WG/12/12);

(b) Rule 94.1(c) be amended to allow the International Bureau to make documents contained in the file held by the IPEA available on behalf of an elected Office which so requests, to the extent that the documents are provided to the International Bureau (see Annex I of document PCT/WG/12/12);

(c) Section 602 of the Administrative Instructions under the PCT be modified to require the IPEA to copy written opinions and applicant letters to the International Bureau (see Annex II of document PCT/WG/12/12); and

(d) consideration be given, also to modifying a number of IPEA Forms and, where necessary, the associated sections of Part 6 of the Administrative Instructions to require their transmission to the International Bureau, allowing other key parts of the file of the international preliminary examination to be made available to applicants and the general public.

3. The proposals above were supported by the PCT Working Group at the twelfth session. The proposed amendments to Rule 71 and Rule 94 were adopted by the PCT Assembly at its fifty-first session in September/October 2019, and will enter into force on July 1, 2020 (see Annex V to document PCT/A/51/2 and paragraph 17 of document PCT/A/51/4). Proposals for modifications to the PCT Administrative Instructions will be published shortly in a PCT Circular, taking into account the comments at the PCT Working Group, including offering flexibility on the timing of implementation, where IT systems need to be updated.

4. The requirement for the IPEA to transmit copies of certain documents to the International Bureau for making available to elected Offices and the public forms a first step towards further improvements in the access to information concerning international preliminary examination. Following this development, it is important to ensure that the documents made available are as easy as possible to use by elected Offices and third parties. This document considers the possibility of presenting the amendments, rectifications and letters annexed to the IPEA as separate documents for easier preparation, viewing and manipulation.

LEGAL REQUIREMENTS UNDER ARTICLE 36

5. The ceasing to include amendments, rectifications and letters as annexes to the IPEA in a single document would have to be interpreted with Article 36, which requires the IPEA, together with the prescribed annexes, to be transmitted to the applicant and to the International Bureau. The text of Article 36 is set out below for ease of reference.

Article 36 Transmittal, Translation, and Communication, of the International Preliminary Examination Report

- (1) The international preliminary examination report, together with the prescribed annexes, shall be transmitted to the applicant and to the International Bureau.
- (2)(a) The international preliminary examination report and its annexes shall be translated into the prescribed languages.
 - (b) Any translation of the said report shall be prepared by or under the responsibility of the International Bureau, whereas any translation of the said annexes shall be prepared by the applicant.
- (3)(a) The international preliminary examination report, together with its translation (as prescribed) and its annexes (in the original language), shall be communicated by the International Bureau to each elected Office.

(b) The prescribed translation of the annexes shall be transmitted within the prescribed time limit by the applicant to the elected Offices.

(4) The provisions of Article 20(3) shall apply, *mutatis mutandis*, to copies of any document which is cited in the international preliminary examination report and which was not cited in the international search report.

6. With the amendments to Rules 71 and 94 that come into force in July 2020, it would be possible to ensure the availability to elected Offices and the public of the documents currently annexed to the IPER without formally treating them as annexes. However, their definition as annexes gives them a particular status and makes clear what translations elected Offices may require (see Rule 74). Consequently, it appears desirable not to change the definition of what constitutes an Annex unless there is a strong reason to do so.

7. On the other hand, providing the report and annexes as a single document takes an effort on the part of the IPEA to merge the documents. This merging may result in loss of quality of some of the documents and, in some cases, loss of information. Notably, if the IPER or the amendments are generated in XML format, it is likely that this "full text" information will be lost in the merging of the documents. In many cases, the first action by an elected Office will then be to split the documents again, so that the amendments can be extracted and incorporated into the application body and any letters can more easily be viewed in parallel with the report and amendments.

8. Article 36 does not require the prescribed annexes to be in a single document with the IPER. There is also no clear provision on how the prescribed annexes shall be transmitted and subsequently published. Accordingly, it would be useful to define the way in which the documents of amendments, rectifications and letters should be packaged and published in PATENTSCOPE with the IPER in order to minimize the work for the IPEA and maximize the benefits for elected Offices and third parties.

PROPOSALS

9. In view of the above, the Intellectual Property Office of Singapore proposes that one means could be to transmit the prescribed annexes, which are defined under Rule 70.16, as a separate bundle of individual documents from the IPER. By providing the prescribed annexes as a separate bundle from the IPER, it reduces the administrative burden on the IPEAs from having to organize and include amendments, rectifications and letters as annexes of the IPER in a single document.

10. Specifically, it is proposed that:

(a) when the IPEA transmits the IPER and the prescribed annexes to the International Bureau, the documents exist separately in XML format or PDF format, as the case may be.

(b) the International Bureau introduces new document types for the IPEA to transmit the prescribed annexes through ePCT or PCT-EDI as separate documents.

(c) consideration be given, if the main proposal is accepted, for the appropriate timeline for a trial phase and the actual transmittal of the IPER and the prescribed annexes to be initiated to the International Bureau.

11. These changes would not appear to require any amendments to the PCT Regulations. The main requirements can probably be met by appropriate modifications to the "minspec" requirements for naming of files being transmitted between Offices, accompanied if required by appropriate modifications to the PCT Administrative Instructions.

FURTHER WORK

12. While work at International Authorities may be heading in the right direction, a further question to consider is whether it is going far and fast enough to meet the needs of designated and elected Offices. These Offices are facing increasing workloads and need greater certainty that their national examinations are being properly assisted by a high quality international search reports and written opinions which are consistent and fit for purpose. In addition, specific standards may need greater consideration in order to ensure that Offices and applicants are able to prepare data in a format which can easily be used for later processing. Authorities are therefore invited to identify any other areas where existing cooperation could be intensified or redirected, and consider what new directions for collective action should be explored as part of the review of the PCT System to ensure that the results of international search and preliminary examination are presented effectively.

13. The Meeting is invited to comment on the proposals in this document.

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