E

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

PCT/WG/6/13
ORIGINAL: ENGLISH
DATE: APRIL 2, 2013

Patent Cooperation Treaty (PCT)
Working Group

Sixth Session
Geneva, May 21 to 24, 2013

AVAILABILITY OF WRITTEN OPINION BY THE INTERNATIONAL SEARCHING AUTHORITY AS OF THE DATE OF INTERNATIONAL PUBLICATION

Document prepared by the International Bureau

SUMMARY

1. The International Bureau proposes to delete PCT Rule 44*ter* to make the written opinion of the International Searching Authority (WO/ISA) available to the public from the date of international publication.

BACKGROUND

2. In 2012, the Working Group discussed two proposals, one by the United Kingdom (document PCT/WG/5/10) and one by the United States of America (paragraph 8(L) and paragraph 18 of the Annex to document PCT/WG/5/18), to make the WO/ISA available from the date of international publication. The former also suggested to formally include the WO/ISA as part of the international publication.

3. The International Bureau in general supported the idea of making the WO/ISA available (document PCT/WG/5/10 Add.) but was concerned about including the WO/ISA as a part of the formal international publication. Making the WO/ISA available could be done quickly and easily with no ongoing unit cost being incurred. However, including the WO/ISA in the international publication would be very costly, resulting in a significant one-off cost of translating 1 year's worth of written opinions established in languages other than English in addition to those which were already being done, in order to bring the availability of translations forwards from 30 months from the priority date to 18 months from the priority date, and further significant recurring costs, as further explained in document PCT/WG/5/10 Add., paragraphs 8 to 10.

4. At the fifth session of the Working Group, the proposal to make the WO/ISA available at the time of international publication without formally including it in the international publication gained general support from most delegations which took the floor (paragraphs 230 to 255 of document PCT/WG/5/22 Rev.). However, many delegations were unable to take a final position on the subject because they were concerned about possible adverse consequences for applicants and had not had time to consult their national user groups. In addition, some delegations were concerned about whether the proposal was consistent with PCT Article 38 which, subject to certain exceptions, requires the Chapter II file to be kept confidential.

5. To advance the discussions on the issue, both the United Kingdom and the United States of America requested the International Bureau to prepare a revised proposal on this subject, taking into account the discussions at the fifth session of the Working Group, and to present it for discussion at the present session.

LEGAL ISSUES

6. As stated above, at the fifth session of the Working Group, concerns were expressed as to whether the proposal to make the WO/ISA available at the time of international publication was consistent with PCT Article 38(1). The text of the relevant provisions (PCT Article 38(1) and PCT Rules 44*ter* and 66.1*bis*(a)) are set out below for ease of reference.

Article 38
Confidential Nature of the International Preliminary Examination

(1) Neither the International Bureau nor the International Preliminary Examining Authority shall, unless requested or authorized by the applicant, allow access within the meaning, and with the proviso, of Article 30(4) to the file of the international preliminary examination by any person or authority at any time, except by the elected Offices once the international preliminary examination report has been established.

…

Rule 44*ter*
Confidential Nature of Written Opinion, Report, Translation and Observations

44*ter*.1 *Confidential Nature*

(a) The International Bureau and the International Searching Authority shall not, unless requested or authorized by the applicant, allow access by any person or authority before the expiration of 30 months from the priority date:

(i) to the written opinion established under Rule 43*bis*.1, to any translation thereof prepared under Rule 44*bis*.3(d) or to any written observations on such translation sent by the applicant under Rule 44*bis*.4;

(ii) if a report is issued under Rule 44*bis*.1, to that report, to any translation of it prepared under Rule 44*bis*.3(b) or to any written observations on that translation sent by the applicant under Rule 44*bis*.4.

(b) For the purposes of paragraph (a), the term “access” covers any means by which third parties may acquire cognizance, including individual communication and general publication.

Rule 66
Procedure before the
International Preliminary Examining Authority

…

66.1*bis* *Written Opinion of the International Searching Authority*

(a) Subject to paragraph (b), the written opinion established by the International Searching Authority under Rule 43*bis*.1 shall be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a).

…

7. Clearly, at the time when the WO/ISA is established and subsequently transmitted to the International Bureau, it forms part of the file of the International Searching Authority (ISA) and part of the International Bureau's file relating to proceedings which have occurred at the International Searching Authority ("Chapter I file"). Usually, at this time no demand for international preliminary examination will have been made. Consequently, no "file of the international preliminary examination" ("Chapter II file") will exist.

8. The mere likelihood that such a Chapter I document *may*, at some point after it has been established, also become part of the Chapter II file cannot mean that it automatically falls under the coverage of PCT Article 38 and must be kept confidential. Article 38 can only have any effect once a demand has been made and a Chapter II file comes into existence.

9. Even once a demand has in fact been made, it cannot be the case that Article 38 automatically requires a document from the Chapter I file to become confidential simply because it is required as part of international preliminary examination. To argue otherwise would mean that documents such as the international search report and even the international application itself must become confidential because a copy has been placed on the Chapter II file, even though they might already have been not just made available to the public but formally published.

10. The reason that a WO/ISA explicitly becomes part of the Chapter II file is Rule 66.1*bis*(a). This provides a basis for treating the written opinion of the International Searching Authority as a written opinion of the International Preliminary Examining Authority (IPEA), so that it is not necessary for the IPEA to issue a potentially identical written opinion simply to meet the requirements of Rule 66.2 before issuing a negative international preliminary examination report, which would create additional burdens on both IPEAs and applicants, without any benefits resulting.

11. In that situation, although the WO/ISA is given a special role in Chapter II, it comes to the Chapter II file in the same way any other "Chapter I document", such as the international search report or the international application itself, which is required to carry out the international preliminary examination. Its use in Chapter II does not mean that the written opinion becomes *solely* part of that file, and that it is no longer part of the Chapter I file and thus no longer available to the public. Just like the body of the international application and the international search report, the WO/ISA is created as part of the Chapter I process and is an essential part of the International Bureau's Chapter I file which is, save for specific exclusions, open to public inspection from the date of international publication.

12. Article 38 may require confidentiality for the Chapter II file and therefore the specific copy of a WO/ISA which may be contained in that file, but does not require confidentiality for copies on Chapter I files, since these are created as part of a procedure outside of Chapter II. They are created outside of the Chapter II process and lying on the Chapter I file as original documents subject to Article 30 and the Chapter I rules, rather than having been transferred from the Chapter II file in a manner such that they might carry over obligations of confidentiality from their source.

13. The introduction of Rule 44*ter* was a policy choice by Member States, based on the *equivalence* of the WO/ISA to a written opinion of the IPEA and concerns about the possible detrimental effects which publication of the WO/ISA might have on an applicant who had no formal means of response in Chapter I (for a discussion on this matter, see below). However, in the view of the International Bureau, Rule 44*ter* is not a provision which is *required* by Article 38, whether a demand for international preliminary examination is made or not. It could validly be deleted while remaining compatible with the Treaty, should Member States agree to take such a policy decision.

ISSUES FOR APPLICANTS

14. In the discussions leading to the adoption of Rule 44*ter*, concerns were expressed about the legal question of whether publication of the WO/ISA would be compatible with Article 38. However, in the end, it was not necessary to resolve that question since there was agreement to keep the WO/ISA confidential until its publication (where no demand for international preliminary examination is made), in the form of the international preliminary report on patentability (Chapter I), at 30 months from the priority date. The concerns expressed at the time had been mainly related to the fact that the WO/ISA might contain statements detrimental to the patentability of the invention, to which the applicant would not have been able to respond, save by way of informal comments.

15. However, it would seem that, in reality, any damage to the applicant due to the publication of the WO/ISA would be very limited. In fact, in many cases, the publication of the WO/ISA might reduce any damage to the applicant caused by the publication of an apparently negative international search report. In practical terms, the most important detrimental statements will already have been made public in the form of the international search report, which may have indicated that the invention is either not new or else lacks an inventive step because of documents which have been cited as category X or Y. On these issues, the WO/ISA will merely serve to provide a better explanation of why the documents are relevant and may, in many cases, help to show the extent to which it may be possible to overcome the cited documents so as to produce valid claims.

16. The other issues set out in the WO/ISA, such as clarity and unity of invention, will usually be ones which can be overcome by amendment or payment of additional fees and consequently there would be little prejudice to the applicant’s interests in having these visible.

17. In the national systems of many Member States it is already accepted practice to make national examination reports (the equivalent to the WO/ISA) open to public inspection immediately, without waiting for the expiry of the period within which the applicant may respond. This is a useful service to third parties who are interested in determining the likely extent of any patent which might be granted in the future and has not proved an unreasonable burden for applicants. There does not seem to be any reason why making a WO/ISA available should be fundamentally different.

18. Furthermore, the system of having a WO/ISA has now been operational for nearly nine years, with international preliminary reports on patentability (Chapter I) being made available to the public at 30 months from the priority date without any opportunity for formal response being available in the Chapter I process and the system for informal response by the applicant being used only very occasionally. This system does not appear to have caused applicants any burdens and has been useful in ensuring that written opinions are – eventually – available to third parties and designated Offices for all international applications.

19. In summary, the International Bureau thus believes that it is appropriate to review the policy choice on confidentiality which was made at the time when the Rules were adopted concerning the establishment of WO/ISA.

POSSIBLE WAYS FORWARD

20. Three possible approaches have been proposed to this issue:

(a) Make no change.

(b) Make the WO/ISA available to the public once the time limit for making a demand has expired without a demand being made.

(c) Make the WO/ISA available to the public in all cases from the date of international publication.

21. The first approach needs no explanation.

22. The International Bureau would recommend not following the second approach. In addition to the fact that it does not appear to be legally necessary, it would be extremely difficult to administer effectively. Demands are usually made not to the International Bureau but direct to the International Preliminary Examining Authority, which is required to inform the International Bureau, but does not always do so in a timely manner. The International Bureau would need to wait an arbitrary period of time after the expiration of the time limit before making the WO/ISA available and would almost inevitably still encounter cases where a demand was notified after the WO/ISA had already been made available. In such circumstances, the International Bureau would have to decide whether to “un-publish” a document which had already been made available to the public.

23. Furthermore, from the point of view of third parties, most review of international patent applications occurs at the time of international publication and takes into account the material available at the time. If the WO/ISA is not available then, in most cases it will not be consulted at all and there would be little benefit achieved over waiting until the international preliminary report on patentability is made available at 30 months from the priority date.

24. The International Bureau thus recommends taking the third approach and implementing it simply by deletion of Rule 44*ter*. This would have the following advantages:

(a) It would appear to be compatible with Article 38.

(b) It would provide the best results for third parties with no significant detriment to applicants.

(c) It could be implemented very quickly with little development cost and no ongoing costs above those involved in the existing processing procedures.

25. This would mean that the WO/ISA would be made available promptly following international publication for all international applications where a WO/ISA had been established. The only exception to that general rule would be the case where no WO/ISA was established, that is, the case where, in accordance with Rule 69.1(b-*bis*), an Office which acted as both ISA and IPEA decided to begin the Chapter II procedure at the same time as the international search and consequently was not required to establish a WO/ISA but only a written opinion by the IPEA or a Chapter II report. In this case, the written opinion would form part only of the Chapter II file and the Article 38 confidentiality provisions would continue to apply directly.

26. *The Working Group is invited to consider the proposed deletion of PCT Rule 44*ter.

[End of document]