

C. PCT 1319

December 1, 2011

Madam,  
Sir,

In accordance with Rule 89.2(a) of the Regulations under the Patent Cooperation Treaty (PCT), modifications to certain PCT Forms for use by the International Bureau (IB) and the International Preliminary Examining Authority (IPEA), are hereby promulgated with effect from January 1, 2012.

This follows consultations under Rule 89.2(b) of the Regulations under the PCT with your Office in its capacity as Receiving Office (RO), International Searching Authority (ISA), International Preliminary Examining Authority (IPEA) and/or designated/elected Office (DO/EO), and also with certain intergovernmental and non-governmental organizations. The modifications are as proposed by Circular 1305, dated May 17, 2011, in relation to new Form PCT/IB/382 "*Request for indication of availability for licensing purposes*", except for minor editorial changes.

The occasion of this circular is also used to promulgate modifications to the following forms which were not involved in the previous consultation (minor editorial changes): PCT/IB/344 "*Notification of Defects with Regard to Correspondence Submitted by Applicant*" (French version only): correction of the reference to the issuing PCT Authority in the body of the form; PCT/IPEA/407 "*Notification that Demand Considered Not to Have been Submitted*" (French version only): deletion of a redundant PCT Rule reference in the title and PCT/IPEA/440 "*Invitation to Pay Prescribed Fees Together with Late Payment Fee*" (both English and French versions): correction/addition of the issuing PCT Authority.

The International Bureau would like to thank all Offices which submitted comments in relation to the implementation of the proposed new form PCT/IB/382 and, more widely, regarding the implementation of the new licensing service. In the context of launching this new service, the International Bureau has taken into consideration the comments received and has decided to incorporate many of the submitted ideas in informational resources such as the *PCT Applicant's Guide*, PCT seminar materials (in 10 publication languages), and *PCT Newsletter*, (hereafter the "associated documentation") etc., rather than in new form PCT/IB/382 itself, in order to build awareness in the user community about the functioning of this new service and to assist PCT applicants in adopting best practices.

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Concerning a suggestion made to add a disclaimer in the licensing request form (PCT/IB/382), the International Bureau has decided to implement this suggestion in the associated documentation rather than in the form itself, clarifying that this new service only aims at putting PCT applicants and potential licensees in contact with each other.

Concerning a suggestion made to add wording in the body of the licensing request form to remind applicants of the possibility of requesting early international publication in order to benefit from this new service at a very early stage, the International Bureau has decided to mention this possibility in the associated documentation.

./ The Annex to this Circular contains a text describing the way in which the new PCT licensing service will function.

The International Bureau would like to remind all Offices that its intention is to make new Form PCT/IB/382 available in all 10 publication languages (and the modified IPEA forms in the language used by the respective IPEAs) as soon as possible and, thus, would like to rely on the existing collaboration with Offices as regards the translation of these forms.

As a result of the consultation, the International Bureau has taken note that the indication of availability for licensing purposes will not have automatic effect for the purposes of getting fee reductions in the national phase before most designated/elected Offices (including before the Offices the national laws of which already provide for reductions of that kind); nevertheless, the International Bureau would like to reiterate the need to work further on this issue for the benefit of PCT applicants.

#### *Availability of Modified Forms*

The new Form PCT/IB/382 is available from the WIPO website under "Forms in force as from January 1, 2012" at: [www.wipo.int/pct/en/forms/](http://www.wipo.int/pct/en/forms/); in principle, it should not be used before the entry into force of this new service on 1 January 2012.

The other modified forms are available from the WIPO website under their usual position, respectively "*IB – Forms Relating to the International Bureau*" and "*IPEA – Forms Relating to the International Preliminary Authority*" and can be used as from the date of this circular.

Offices which need marked-up copies and/or electronic files of any of the Forms should contact the PCT Legal Division via the following e-mail address: [pct.legal@wipo.int](mailto:pct.legal@wipo.int).

Yours sincerely,



James Pooley  
Deputy Director General

Enclosure: Annex – The new PCT licensing service

## THE NEW PCT LICENSING SERVICE

*Form of the licensing request:* in practice, when submitting their licensing request, applicants will have the choice to either (and preferably) use new dedicated PCT Form PCT/IB/382 or send their licensing request in the form of a letter/general correspondence; the International Bureau will call the applicant's attention to the benefits of using form PCT/IB/382 in the associated documentation.

*Means of submission:* applicants should preferably submit their licensing request via the PCT Online Document Upload Service on PATENTSCOPE, and in the near future using ePCT; the list of document type in PCT Online Document Upload had been updated accordingly to create a new document labeled "*Licensing Availability Request*" under the "*Other*" category; the International Bureau will further elaborate on this particular issue in the associated documentation, including a statement that any licensing request received by surface mail or fax will be processed.

In the context of launching this new licensing service, and since it has always been the direction envisaged by the International Bureau regarding a rapid implementation of the initial iteration of this new service, the licensing request has not been made a part of the request form (PCT/RO/101); nevertheless, applicants interested in filing such licensing request can submit it, using new form PCT/IB/382 or a letter, at the time of filing their international application (especially those filing electronically, e.g. via PCT-SAFE) by attaching the licensing availability request to their application as "*Other*" under "*Accompanying items*" and label it for instance "*Licensing availability request*".

*Timeframe for submission:* at least in the initial iteration of this new service, the request for licensing availability will only be taken into account if filed before the expiration of 30 months from the priority date, i.e. during the international phase only, with the exception of the turn-off procedure below.

*Implementing the licensing indications in PATENTSCOPE:* the processing of the licensing request by the International Bureau will automatically activate the following instances in PATENTSCOPE: simultaneous activation of both (i) the licensing statement (for the given international application) under the "*PCT Bibliographic Data*" tab and (ii) the link between this statement and the content of the licensing request (e.g. form PCT/IB/382 or letter) made available as a separate category under the "*Documents*" tab; the licensing request as a search criterion will be activated as from 1 January 2012, independently from any filing of licensing request.

*Receiving/processing PCT Authority:* the licensing request, whether filed by means of new form PCT/IB/382 or by a letter, must be sent to the International Bureau; in cases where applicants mistakenly send such licensing request to ROs, ISAs, IPEAs, these Authorities are requested to forward them to the International Bureau in a timely fashion (compare paragraph 22 of the PCT Receiving Office Guidelines).

*Multiple requests:* where applicants file multiple requests or want to modify or update the already filed one(s), they will have to ensure their latest submission is always a self-contained document, i.e. a full new set of information comprising the multiple licensing requests if more than one was submitted; the link under the "*PCT Bibliographic tab*" within PATENTSCOPE will always be updated to relate to the data from the latest submission; the "older" submission(s) will be available under the "*Related Documents on file at the International Bureau*" entry under the "*Documents*" tab as part of the file history.

*Reversing requests:* Applicants will be allowed to “turn off” their licensing request(s) at any time. This possibility will be emphasized in the associated documentation. As a result of processing such a removal, the link under “*PCT Bibliographic Data*” tab on PATENTSCOPE and the separate category under the “*Documents*” tab will be deactivated accordingly. The licensing request will remain part of the file history but become available on PATENTSCOPE only under the “*Related Document on file at the International Bureau*” entry under the “*Documents*” tab.

[End of Annex]