

C. PCT 1338

May 2, 2012

Madam,  
Sir,

*Proposed modifications to the Administrative Instructions under the PCT and to the PCT International Search and Preliminary Examination Guidelines related to the introduction of a Third Party Observation System*

This Circular is addressed to your Office in its capacity as International Searching Authority (ISA), International Preliminary Examining Authority (IPEA) and/or designated or elected Office under the Patent Cooperation Treaty (PCT) for the purpose of consultation under PCT Rule 89.2(b) on proposed modifications to the Administrative Instructions under the PCT (AIs) and the PCT International Search and Preliminary Examination Guidelines (Guidelines). It is also addressed to certain non-governmental organizations representing users of the PCT system.

The proposed modifications relate to the introduction of a PCT third party observation system which is under development in accordance with the framework agreed by the PCT Working Group at its fourth session (see document PCT/WG/4/7 and paragraphs 122 to 142 of document PCT/WG/4/17).

A proposed new Part 8 of the AIs and associated explanations in the form of comments are set out in Annex I to this Circular. Proposed modifications to the Guidelines are set out in Annex II. It is provisionally intended to bring these modifications into force on July 1, 2012, at the same time as the proposed modifications which were the subject of consultation in Circular C. PCT 1327.

/...



PART 8  
INSTRUCTIONS RELATING TO OBSERVATIONS BY THIRD PARTIES

**Section 801**  
**Third Party Observation System**

(a) The International Bureau shall provide an electronic system for third parties to make observations referring to prior art which they believe to be relevant to the question of whether the invention claimed in the international application is new and/or involves an inventive step (“third party observation system”).

(b) The third party observation system:

(i) shall provide a third party with the option to remain anonymous;

(ii) shall allow observations to include a brief explanation of the relevance of each prior art document referred to in the observation and to include a copy of the prior art document;

(iii) may limit the number of prior art documents which may be referred to in one observation; and

[COMMENT: The maximum number of prior art documents would initially be 10. It is proposed to leave the exact number to the discretion of the International Bureau, to be modified if necessary depending on experience gained with the system.]

(iv) may limit the number of observations permitted to be made in relation to one international application, per third party and in total.

[COMMENT: The maximum number of observations would initially be 10. It is proposed to leave the exact number to the discretion of the International Bureau, to be modified if necessary depending on experience gained with the system.]

(c) The International Bureau shall take technical steps to prevent abuse of the third party observation system.

[COMMENT: The initial measures would involve requiring login with a validated WIPO account, which itself contains certain measures to combat abuse by automated systems, and to ban accounts which had been used for submitting observations which were clearly an abuse of the system. In addition, all purported observations would be checked by the International Bureau before being processed as observations. Further measures would be introduced as required, depending on how the system was used in practice.]

(d) The International Bureau may temporarily or indefinitely suspend the use of the third party observation system if it considers it necessary to do so.

**Section 802**  
**Filing of a Third Party Observation**

(a) An observation by a third party made in relation to an international application shall:

(i) be submitted to the International Bureau through the third party observation system as provided in Section 801;

- (ii) be submitted between the date of international publication and 28 months from the priority date of the international application indicated;
- (iii) be in a language of publication, with the exception that copies of submitted prior art documents may be in any language;
- (iv) relate to the international application indicated;
- (v) refer to prior art;
- (vi) be free of viruses or other forms of malicious logic;
- (vii) be free of comments or other matter not relevant to the question of novelty or inventive step of the invention claimed in the international application; and
- (viii) be free of comments or other matter which are an abuse of the third party observation system.

[COMMENT: The International Bureau would not make any substantive judgment on the quality of observations. The above measures are intended simply to allow the elimination of observations which are obviously abusive or which have clearly been directed to the wrong file. The system would also have technical measures to reduce the risk of directing observations to the wrong file, including showing bibliographic information and requiring the third party to provide the filing date in addition to the publication number, unless coming from a source which provides these automatically, such as a link from PATENTSCOPE.]

(b) Any purported observation by a third party which, in the view of the International Bureau, appears not to be in compliance with paragraph (a) shall not be treated as a third party observation. The International Bureau shall inform the third party accordingly, unless the purported observation appears to be a clear attempt at abuse of the system. The purported observation shall not be open to public inspection and shall not be communicated to the applicant, any International Authority or any designated Office.

### **Section 803 Availability of an Observation and Related Information**

(a) Any third party observation shall be open to public inspection, with the exception that copies of prior art documents uploaded through the system shall be made available only to the applicant, competent International Authorities and designated Offices.

[COMMENT: There is no need to provide any particular limitation on the above statement since the system will only be available for use with international applications which have been published.]

(b) Where the third party requests the International Bureau to remain anonymous as provided in Section 801(b), the International Bureau shall not reveal any details of the third party to the public, the applicant, any International Authority or any designated Office.

### **Section 804 Notification of Receipt of an Observation to the Applicant and Comments by the Applicant in Response to an Observation**

(a) The International Bureau shall notify the applicant when the first third party observation is received in relation to an international application. If further observations are received, the International Bureau shall notify the applicant of the receipt of all further observations promptly after the expiration of 28 months from the priority date.

[COMMENT: The ePCT system will offer the opportunity for applicants to receive immediate notification of second and subsequent observations, but it does not appear appropriate to routinely send such notifications in all cases given that this could result in significant costs for applicants, who might wish to respond to all observations simultaneously after 28 months from the priority date, if at all.]

(b) The applicant may, within 30 months from the priority date, submit comments in response to any third party observation which has been received. The comments shall be submitted in English, French or the language of publication of the international application, at the choice of the applicant.

[COMMENT: As with the informal response to written opinions of the International Searching Authority, it is proposed that this response would not normally be translated by the International Bureau. It would nevertheless be open to any designated Office which was not able to understand the comments, or was not convinced by the comments, to request a further response as part of the national phase processing in an official language of the designated Office.]

**Section 805**  
**Communication of Observations and Comments**  
**to International Authorities and Designated Offices**

(a) The International Bureau shall communicate any third party observation and any comment by the applicant promptly to the International Searching Authority specified to carry out the international search, the International Searching Authority specified to carry out the supplementary international search and the International Preliminary Examining Authority specified to carry out the international preliminary examination, unless the international search report, the supplementary international search report or the international preliminary examination report, respectively, has already been received by the International Bureau.

(b) Promptly after the expiration of 30 months from the priority date, the International Bureau shall communicate any third party observation and any comment by the applicant to all designated Offices. The designated Offices shall not be obliged to take either the observations or any comments into account during national processing.

[COMMENT: This communication is in the sense of Rule 93*bis*.1 and would be undertaken either on specific request for an international application or else in response to a generic request to receive this class of documents. For applications which enter the national phase prior to 30 months from the priority date, any information which had been received up to that point would be available either from PATENTSCOPE or by making a specific request, for example using PADOS.]

[Annex II follows]

*Proposed modified paragraphs of the  
PCT International Search and Preliminary Examination Guidelines*

[COMMENT: The intent of all of these guidelines is that examiners at an International Authority should consider observations which reach them before a final report is established, provided that the document is included or it is practical to obtain it. There is, however, no need to comment on whether or not observations have been considered or whether or not prior art referred to in an observation is considered sufficiently relevant to cite.]

**PART IV  
THE INTERNATIONAL SEARCH**

**Chapter 15  
The International Search**

...

**Field of Search**

...

15.47.1 If the International Bureau transmits a third party observation to the International Searching Authority prior to the establishment of the international search report, any prior art referred to in the observation should be considered as if it were part of the field of search, provided that either a copy of the prior art is included or it is reasonably practical to obtain it. The examiner need only refer to the prior art listed in the observation if it is considered relevant for inclusion in the international search report.

...

**Chapter 16  
International Search Report**

...

**Filling Out the International Search Report (Form PCT/ISA/210)**

...

*Documentation Searched Other Than Minimum Documentation*

16.51.1 Where the examiner chooses to cite a document listed in a third party observation which would not have been found in the documentation searched, he may indicate "Third party observation submitted [Date]".

...

**PART V**  
**WRITTEN OPINION/INTERNATIONAL PRELIMINARY EXAMINATION REPORT**

**Chapter 17**  
**Content of Written Opinions and the International Preliminary Examination Report**

...

**Other Considerations**

*Additional Documents Taken Into Consideration in Certain Cases*

...

17.66.1 If the International Bureau transmits a third party observation to the International Preliminary Examining Authority prior to the establishment of the international preliminary examination report, any prior art referred to in the observation should be considered as if it were part of the field of search, provided that either a copy of the prior art is included or it is reasonably practical to obtain it. The examiner is not required to comment on a document referred to in a third party observation unless he considers it appropriate to cite it.

[End of Annex II and of Circular]