

C. PCT 1504

March 3, 2017

Madam,  
Sir,

*Transmittal of Documents Relating to Earlier Search or Classification*

This Circular is addressed to your Office in its capacity as a receiving Office and/or International Searching Authority (ISA) under the Patent Cooperation Treaty (PCT).

This Circular concerns the technical requirements to enable the implementation of the transmittal of documents relating to earlier search or classification, following the adoption by the PCT Assembly, in October 2015, of amendments to PCT Rule 23*bis* that will enter into force on July 1, 2017. A separate PCT Circular proposing changes to certain PCT Forms, the Administrative Instructions under the PCT, the Receiving Office Guidelines and the International Search and Preliminary Examination Guidelines has recently been sent as PCT Circular C.PCT 1498.

*Documents and Data Concerned*

At present, receiving Offices are required to forward to the ISA copies of search reports relating to earlier applications where the applicant has requested the ISA under PCT Rule 4.12 to take a search on that earlier application into account. Under new PCT Rule 23*bis*, receiving Offices will be required to forward one or more of the following types of document or data, irrespective of whether the applicant has requested an earlier search to be taken into account:

(i) a copy of any search results relating to earlier applications where the applicant has requested the ISA under PCT Rule 4.12 to take a search on that earlier application into account under PCT Rule 23*bis*.1;

(ii) a copy of any search results related to an earlier application from which the international application claims priority under PCT Rule 23bis.2; and,

(iii) a copy of the results of any earlier classification effected by that Office under PCT Rule 23bis.2.

In most cases, any classification which has been made by an Office which has conducted an earlier search will appear in the search results. Consequently, if a search results document is transmitted, it will not normally be necessary to transmit a classification document. However, a classification document may be appropriate in any of the following circumstances:

(i) the Office with which the earlier application was filed has classified the application but has not yet completed a search;

(ii) the Office with which the earlier application was filed has searched the application, but is not permitted to release the results of the search;

(iii) the Office with which the earlier application was filed does not include classification information in its search reports; or,

(iv) the results of the earlier search are available only in an image-based format and consequently cannot be automatically read by the ISA, but the classification information can readily be put into a machine-readable format.

#### *Offices Which Transmit Search Copies Directly to the ISA*

Where the receiving Office transmits search copies electronically directly to the ISA, the standards by which the documents are sent will need to be agreed bilaterally.

It is not required that receiving Offices which transmit search copies directly to the ISA (including the case where the same Office acts as both receiving Office and ISA) send copies of the earlier search and classification documents to the International Bureau.

#### *Offices Which Transmit Search Copies Using the eSearchCopy System*

Where the receiving Office transmits search copies to the ISA via the International Bureau's eSearchCopy system it will be necessary to send, in addition to those documents already being sent, the additional documents relating to an earlier search or classification of the priority application(s) under PCT Rule 23bis.2 to the International Bureau. Because the eSearchCopy system automatically forwards all documents relating to earlier search or classification that have been received from receiving Offices, receiving Offices should ensure not to transmit any documents relating to earlier search or classification to the International Bureau in cases where, under PCT Rule 23bis.2, such documents relating to earlier search or classification must not be sent to the ISA.

The International Bureau will modify the ePCT browser-based portal for Offices, the PCT-EDI batch system for transmission of documents and the eSearchCopy system in order to support the necessary document transfers. The following arrangements are proposed.

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### *Update to the Browser-Based ePCT Portal*

The International Bureau will modify the browser-based portal to allow uploading of the necessary documents relating to earlier search or classification in PDF format. If any relevant Office produces XML-based search reports or earlier classifications, the International Bureau is willing also to modify the system to allow these to be uploaded. It is envisaged that a text box for entering IPC codes directly will also be provided, though this may not be available immediately on July 1, 2017.

### *Transmission of Documents using PCT-EDI*

The International Bureau has modified the “Minimal Specifications for the Transmittal of Documents to the International Bureau”, version 4.5, to include the document type codes necessary:

- for transmission of search reports transmitted under PCT Rule 23*bis*.1 (requested by the applicant under PCT Rule 4.12), the same code, “resr”, be used as for search reports presently transmitted under Rule 4.12 (“resr” – results of earlier search - no change);
- for transmission of search reports transmitted under PCT Rule 23*bis*.2, new code “resp” should be used – the document may be in PDF or WAD format (“resp” – results of earlier search of priority application);
- for transmission of written opinions transmitted under PCT Rule 23*bis*.2, new code “oesp” should be used – the document may be in PDF or WAD format (“oesp” – written opinion of earlier search priority application);
- for transmission of annexes, such as patent family or search strategy, to reports transmitted under PCT Rule 23*bis*.2, new code “aesp” should be used – the document may be in PDF or WAD format (“aesp” – annex to earlier search of priority application);
- for transmission of page image-based documents containing classification information for the priority application other than as part of a search report, new code “cesp” should be used – the document may be in PDF or WAD format (“cesp” – classification of earlier search of priority application); and,
- for transmission of machine-readable files containing classification codes other than as part of the search report, new codes “xesp” should be used – the document should be in WAD format, containing files compliant with the search-report XML DTD, with all elements empty except the mandatory bibliographic information and the classification elements (“xesp” – XML classification of earlier search of priority application).

In each of these cases, the package containing the document should be coded with the number of the earlier application in accordance with the revised Minimal Specifications for the Transmittal of Documents to the International Bureau, version 4.5. The draft specification and sample package files are available from the WIPO website at the following address:

[http://www.wipo.int/patentscope/en/pct-edi/earlier\\_search.html](http://www.wipo.int/patentscope/en/pct-edi/earlier_search.html)

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*Format of Search Reports*

The above proposals have been based on the expectation that the majority of documents relating to earlier search or classification will, for now, only be made available in the form of page image-based documents representing a search report or similar document. Eventually, it is hoped that Offices will move towards transmission of XML-based search results. Any Office already able to transmit national search information in XML-based format is invited to contact the International Bureau to discuss next steps in this area.

*Availability of the Earlier Search and Classification Results*

The International Bureau will transmit to participating ISAs these additional page-based documents as part of the regular eSearchCopy transmissions, indexed as document types "resr" (as at present), "resp", "oesp", "aesp", and/or "cesp" or "xesp". At least initially, the documents will be forwarded exactly as received, without any further processing to make the information consistent between receiving Offices. The documents will also be made available in the browser-based ePCT for Offices.

*Request to Receiving Offices that use the "eSearchCopy" System*

The International Bureau requests that, as far as possible, receiving Offices that use the "eSearchCopy" system ensure that the documents relating to earlier search or classification are uploaded to the International Bureau at the same time as the record copy in order to ensure that the information is immediately available to the ISA with the search copy, rather than being sent in a later transmission when it may be too late to be useful.

*Responses to this Circular*

At this stage, the International Bureau invites your Office to provide comments on the above proposals for transmission of information required from July 1, 2017, in accordance with new PCT Rule 23bis. Responses should be sent, preferably by e mail, to Mr. Peter Waring, Head, Technical Cooperation Section, PCT International Cooperation Division, e-mail: [pcticd@wipo.int](mailto:pcticd@wipo.int); fax: (+4122) 338 7160, by April 3, 2017.

Yours sincerely,



John Sandage  
Deputy Director General