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INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PATENT COOPERATION TREATY (PCT)

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MEANS OF TRANSMITTAL OF INTERNATIONAL REPORTS

Document prepared by the Secretariat

SUMMARY

1. International Authorities are invited to comment on whether they might offer a service of transmitting international search reports, international preliminary reports on patentability and related communications to the applicant by fax or e-mail in addition to paper mailings.

BACKGROUND

2. One of the problems concerning the use of the PCT frequently reported by applicants from a variety of countries is that there is not an adequate amount of time, upon (late) receipt of the international search report, to evaluate the report and proceed to file a demand for international preliminary examination or to enter into the national/regional phase. The same problem also occurs following (late) receipt of the international preliminary report on patentability under Chapter II of the PCT.

3. Apart from the issue of whether the reports have been established in accordance with the time limits under the Treaty, a large factor is that these reports are sent by ordinary mail service. This can result in very long delays for reports which are sent to a country other than the one where the International Authority is based. Applicants and their representatives from a variety of countries, mainly in Africa, Asia, Latin America and the Caribbean, have therefore requested that documents should be made available by fax or e-mail.

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4. It has been possible for quite some time to indicate an e-mail address in the request Form submitted through PCT-EASY or by way of a fully electronic filing. However, in view of technical and legal concerns (such as concerns that Internet e-mail is not regarded as secure and that it does not guarantee delivery of the message and any attached document), these e-mail addresses have so far only been used for fast informal communications, in a similar manner to telephone calls.

5. Today, reliability of Internet e-mail has improved significantly, such that there is no greater chance of failure to deliver to the intended server than of loss of mail in the conventional postal service. The main risks now relate to un-notified changes of e-mail address and failures which are due to the destination server receiving the message but then incorrectly identifying a message as spam and not delivering it to the user.

6. Moreover, whereas an international application itself usually contains very commercially sensitive information, forms sent by the International Bureau and other authorities with responsibilities under the PCT are usually much less confidential. While search and examination reports may allow a third party to identify the general nature of an application, they would not usually disclose the critical technical details. Given the variable routing of Internet e-mail, this is unlikely to result in a significant opportunity for industrial espionage in comparison to other possibilities.

7. For these reasons, the International Bureau is now prepared to deliver forms to the applicant or agent by e-mail in addition to the normal paper mailing, provided that the applicant is willing to accept the small risks involved and specifically requests such an approach to be taken. At the moment, the service is only to be offered in addition to, but not (yet) as a complete alternative to, paper notifications, though this possibility may be offered in the future if the service is found to be sufficiently reliable in practice.

8. In order to allow applicants to make use of this service, the International Bureau proposed, in Circular C. PCT 1132 dated February 21, 2008, to modify the request Form to include a space for an e-mail address for the first applicant and agent, accompanied by a checkbox to indicate an authorization as follows:

“E-mail authorization: Marking this check-box authorizes the International Bureau (also in its functions as receiving Office) to use the e-mail address indicated in this Box to send advance copies of notifications issued in respect of this international application. (See also the Notes to Boxes II and III.)”

9. The draft Notes to Boxes II and III are set out as follows (following preliminary feedback, it is likely that these notes will be expanded slightly to include a warning on the potential security issues for which the applicant would be assuming responsibility):

“Telephone, Facsimile Numbers and/or E-mail Addresses should be indicated for the person named in Box No. II in order to allow rapid communication with the applicant (see Rule 4.4(c)). Any telephone or facsimile number should include the applicable country and area codes. A single e-mail address only should be indicated in this field. Unless the associated checkbox is selected, any email address supplied will be used only for the types of communication which might be made by telephone. If the associated checkbox is selected, the International Bureau and the International Bureau in its function as receiving Office will send advance copies of communications in respect of the international application to the applicant, avoiding processing or postal delays. Any such email communications will always be followed by the official notification on paper. Only that paper copy is considered the legal copy of the notification and only the date of mailing of that paper copy will commence any time limit within the meaning of Rule 80.

“Note that it is the applicant’s responsibility to keep any email address details up to date and to ensure that incoming emails are not blocked for any reasons on the recipient’s side. Changes to the address indicated in the request should be requested to be recorded, preferably directly at the International Bureau, under Rule 92*bis*. Where the e-mail authorization is given both in respect of the applicant and in respect of an agent or common representative, the International Bureau will send email communications only to the appointed agent or common representative.”

10. Applicants or agents may alternatively write to the International Bureau at a later stage to state or change their preferred mode of delivery. The International Bureau’s fees will be the same, irrespective of which delivery option is selected.

ISSUES

11. Noting the International Bureau’s intentions and the requests referred to in paragraph 3, above, individual International Authorities may wish to consider offering a service similar to the one outlined in paragraphs 8 to 10, above, whereby international search reports, written opinions, international preliminary reports on patentability and related communications are transmitted to the applicant by e-mail or fax, in addition to the sending of the paper copy of the document concerned. As in the case of notifications sent by e-mail by the International Bureau, only the paper copy would be considered the legal copy of the document concerned and only the date of mailing of that paper copy would commence any time limit within the meaning of Rule 80 (such as, for example, the time limit for the submission of amendments to the claims under Article 19).

12. If such a service is considered desirable, International Authorities will need to consider whether an entry in the request Form of the sort set out under paragraph 8, above, would (suitably adjusted) meet their requirements. In this case, arrangements would need to be made to ensure that changes to e-mail addresses were notified to International Authorities, just as changes to the normal address for service are notified under PCT Rule 92*bis*.

13. If a fax version of the service was to be offered, a similar addition might be needed to the fax number box on the form.

14. One significant difference between communications from an International Authority and the ones from the International Bureau is that international search reports and international preliminary reports on patentability (Chapter II) are commonly accompanied by annexed documents, sometimes large or numerous, such as copies of cited documents or copies of amended sheets. These may in some cases be impractical to send by e-mail, whether because of the additional work involved in ensuring the documents are all attached correctly, because of the large file size involved, or because of copyright issues in digitizing and sending non-patent literature. It may still be worth considering a service offering electronic delivery of the report itself, with any annexed documents being sent on by conventional mail with the paper version of the report.

15. If any International Authority wished to offer such a service, its options and conditions would be published in the PCT Gazette and Applicant's Guide, together with any other information which may be considered useful, such as the file formats which would be sent.

16. The Meeting is invited to discuss whether any Authority may wish to offer e-mail or fax services for delivery of reports and forms to applicants and, if so, what changes to forms and procedures need to be agreed on in order to make such a service effective.

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