

Patent Cooperation Treaty (PCT) Working Group

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PROPOSAL WITH RESPECT TO THE AVAILABILITY OF THE FILE HELD BY THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

Document prepared by the Intellectual Property Office of Singapore

SUMMARY

1. This document contains proposals to require the International Preliminary Examining Authority (IPEA) to copy certain documents contained in the file held by the IPEA to the International Bureau. This would allow easier access to such documents for examiners in elected Offices. In addition, the International Bureau would make the documents available to the public on behalf of the elected Office, providing greater transparency of the international preliminary examination (IPE) process.

BACKGROUND

2. Transparency within the PCT processes has become more pertinent, with greater emphasis on the promotion of linkage between the international phase and the national phase for improving predictability of patent acquisition for users and eliminating unnecessary duplication of work by national/regional Offices. In line with this, the PCT Assembly:

(a) at its twenty-fourth session in 1997, decided to add Rule 94.3 to introduce the possibility for elected Offices to allow access to the file of an international application by third parties, including any document related to international preliminary examination, to the same extent as national law applicable to the elected Office with regard to a national application would, but not before international publication;

(b) at its thirty-first session in 2002, decided to add Rule 94.1(c), allowing the International Bureau to make available copies of the international preliminary examination report on behalf of elected Offices, with effect from January 1, 2004; and

(c) at its forty-fourth session in 2013, decided to delete Rule 44*ter* and to amend Rule 94.1(b) to make the written opinion of the International Searching Authority available from the date of international publication, with effect from July 1, 2014.

3. Consequently, at present, the IPEA transmits a copy of the international preliminary examination report (IPER) and the prescribed annexes, which usually only include the latest set of amendments and the accompanying letter as required under Rule 66.8, or containing arguments submitted under Rule 66.3, to the applicant and to the International Bureau under Article 36 and Rule 71. Following that, the International Bureau effects the communication of the IPER and the prescribed annexes to each elected Office under Article 36 and Rule 73 by publishing those documents online on PATENTSCOPE. The written opinion of the International Searching Authority, which usually also acts as the first written opinion of the International Preliminary Examining Authority in accordance with Rule 66.1*bis*, is also made available on PATENTSCOPE. However, any other written opinions of the IPEA, previous sets of amendments and letters containing arguments and explanations, submitted by the applicant before the establishment of the IPER, are not made available online, save where this is done by an elected Office via its own website, in accordance with Rules 94.2(c) and 94.3, following the establishment of the IPER. Such arrangements are currently normally limited to the case where an elected Office makes available documents that it itself has established in its role as the IPEA.

4. Since only the latest set of amendments and/or the letter is annexed to the IPER, it is often unclear to the examiners of elected Offices what amendments and/or arguments have been considered by the IPEA prior to the establishment of the IPER. That information could be useful for these examiners, especially when the amendments annexed to the IPER only address minor issues when the applicant put forward substantive amendments and arguments to overcome objections raised in a previous written opinion.

5. In view of the steady growth in the number of international applications, of which about 5 to 6 per cent are subject to IPE, it seems to be desirable to make the written opinions of the IPEA, as well as the amendments and the letters, available online on PATENTSCOPE, together with the IPER. The Intellectual Property Office of Singapore, which acts as both an International Preliminary Examining Authority and as an elected Office, considers that this would enable the full IPE results to be easily accessible on a single platform and thereby enable examiners of elected Offices to have a comprehensive understanding of the IPE results.

LEGAL ISSUES CONCERNING THE AVAILABILITY OF DOCUMENTS FROM THE FILE OF THE INTERNATIONAL PRELIMINARY EXAMINATION

6. The confidential nature of IPE, in accordance with the interpretation of Article 38(1), was discussed at the sixth session of the Meeting of the International Authorities in 1997 (see paragraphs 55 to 61 of document PCT/MIA/VI/16). The text of Article 38(1) is 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.

7. The Meeting considered practical issues faced by the examiners in the national phase, as well as the conflict between, on the one hand, access to the IPE file by third parties and, on the other hand, the preliminary, non-binding and advisory nature of the IPE. The Meeting agreed that a new approach would be needed towards the confidentiality of the file of the IPE and that a

more liberal interpretation of Article 38(1) would be desirable. Consequently (paragraph 59 of document PCT/MIA/VI/16):

“The Meeting agreed that the exception provided for in Article 38(1) allowing access to the file of the international preliminary examination by elected Offices should not be interpreted as limiting that access to the elected Offices themselves. Consistent with this interpretation, elected Offices whose national law made application files publicly accessible should no longer be required to remove the international preliminary examination file when allowing such access. Not only the international preliminary examination report but also the remainder of the international preliminary examination file, if available at the elected Office, should become part of the file of that Office and should be subject to public inspection to the same extent as the rest of that file.”

8. Following the above interpretation, and with further discussions in the Working Group on Reform of the PCT and the PCT Working Group, the PCT Assembly added the Rules referred to in paragraph 2, above. These made clear the right of elected Offices to make parts of the file of the IPE available to the public after the IPER had been established and gradually extended the practical availability of the IPER, as well as the written opinion of the International Searching Authority.

PROPOSALS TO AMEND RULES 71.1 AND 94.1(C) AND THE ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

9. For the benefit of examiners in elected Offices and of the general public, it is proposed that at least the written opinions of the IPEA as well as the amendments and/or the letters should become available to the public on PATENTSCOPE after the IPER has been established.

10. Primarily for the benefit of applicants, it is proposed that other PCT Chapter II forms inviting applicants to take further actions (for example, Form PCT/IPEA/405, inviting applicants to restrict or pay additional fees) would also be considered for transmission to the International Bureau (this would involve further changes to the Administrative Instructions, beyond the main proposals set out in Annex II, which might also deal with equivalent forms in the Chapter I procedure). These would then be immediately available to applicants through ePCT, avoiding delays in transmission by mail. It is proposed that these documents would also be made available on PATENTSCOPE after the IPER had been established. The number of documents involved would be relatively small, but the benefits to applicants otherwise receiving documents by surface mail from a distant country would be considerable.

11. To that end, it is proposed that:

- (a) Rule 71.1 be amended to provide a basis for requiring IPEAs to transmit additional documents to the International Bureau;
- (b) Rule 94.1(c) be amended to allow the International Bureau to make documents contained in the file held by the IPEA available on behalf of an elected Office which so requests, to the extent that the documents are provided to the International Bureau;
- (c) Section 602 of the Administrative Instructions under the PCT be modified to require the IPEA to copy written opinions and applicant letters to the International Bureau; and
- (d) consideration be given, if the main proposal is accepted, also to modifying a number of IPEA Forms and, where necessary, the associated sections of Part 6 of the Administrative Instructions to require their transmission to the International Bureau, allowing other key parts of the file of the IPE to be made available to applicants and the general public.

12. Annex I sets out the amendments to the Regulations under the PCT proposed in paragraphs 11(a) and (b), above. Annex II sets out the modifications to the Administrative Instructions proposed in paragraph 11(c), above.

13. As the IPEAs are currently using electronic means to transmit documents to the International Bureau, it is hoped that the administrative burden in making copies available to the will be negligible.

FURTHER WORK

14. The arrangements proposed in the Annexes to this document could form a first step towards further improvements in the access to information concerning international preliminary examination. Notably, the Working Group might wish to consider whether to invite the Meeting of International Authorities to review the possibility of ceasing to include amendments, rectifications and letters as annexes to the IPER, since they could be more conveniently displayed as separate documents. Moreover, in combination with work to move towards full text publication of application bodies, the amendments and rectifications might be displayed also as complete new application bodies, marked up appropriately to display the differences from the application as filed, eliminating the need for elected Offices to combine the amendments annexed to the IPER with the international application as published.

15. The Working Group is invited to:

(i) consider the proposed amendments to the PCT Regulations and modifications to the Administrative Instructions contained in the Annexes to this document; and

(ii) comment on the further work discussed in paragraph 14 of the document.

[Annexes follow]

ANNEX I

PROPOSED AMENDMENTS TO THE PCT REGULATIONS ¹

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 71
Transmittal of the
International Preliminary Examination Report
and Related Documents

71.1 *Recipients*

[\(a\)](#) The International Preliminary Examining Authority shall, on the same day, transmit one copy of the international preliminary examination report and its annexes, if any, to the International Bureau, and one copy to the applicant.

[\(b\) The International Preliminary Examining Authority shall transmit copies of other documents from the file of the international preliminary examination to the International Bureau in accordance with the Administrative Instructions.](#)

[COMMENT: New paragraph (b) provides a clear basis for the proposed modifications to Section 602, as well as for Administrative Instructions covering the transmission of other documents in future, such as invitations to pay additional fees.]

71.2 *Copies of Cited Documents*

(a) to (d) [No change]

Rule 94

Access to Files

94.1 *Access to the File Held by the International Bureau*

(a) *[No change]*

(b) *[No change]* The International Bureau shall, at the request of any person but not before the international publication of the international application and subject to Article 38 and paragraphs (d) to (g), furnish copies of any document contained in its file. The furnishing of copies may be subject to reimbursement of the costs of the service.

(c) The International Bureau shall, if so requested by an elected Office, but not before the international preliminary examination report has been established, furnish on behalf of that Office copies ~~of the international preliminary examination report~~ under paragraph (b) ~~on behalf of that Office~~ of any document transmitted to it under Rule 71.1(a) or (b) by the International Preliminary Examining Authority. The International Bureau shall promptly publish details of any such request in the Gazette.

[COMMENT: The reference to the establishment of the international preliminary examination report is for consistency with Article 38(1), noting that the extension of the Rule would mean that it would apply to documents transmitted to the International Bureau before the establishment of that report.]

(d) to (g) *[No change]*

94.1 bis to 94.3 *[No change]*

[Annex II follows]

ANNEX II

PROPOSED AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS UNDER THE
PATENT COOPERATION TREATY ²

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Section 602 Processing of Amendments by the International Preliminary Examining
Authority 2

² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Section 602

Processing of Amendments by the International Preliminary Examining Authority

(a) The International Preliminary Examining Authority shall:

(i) to (iv) [No change]

(v) [no change] annex to the copy of the international preliminary examination report which is transmitted to the International Bureau any replacement sheet and letter as provided for under Rule 70.16;

(vi) [no change] annex to the copy of the international preliminary examination report which is transmitted to the applicant a copy of each replacement sheet and letter as provided for under Rule 70.16;

[COMMENT: As noted in paragraph 14 of the main body of this document, a later stage of improvement might be to cease annexing the amendments and letters to the international preliminary examination report, noting that the amendments to the Regulations proposed in Annex I would in future allow those documents to be made available in a more convenient format, with less work for the International Preliminary Examining Authority.]

(vii) if a written opinion is to be established, transmit to the International Bureau, a copy of the written opinion of the International Preliminary Examining Authority together with a copy of each replacement sheet and accompanying letter required under Rule 66.8 or containing arguments submitted under Rule 66.3.

(b) to (d) [No change]

[End of Annex II and of document]