

## **Patent Cooperation Treaty (PCT) Working Group**

**Eighth Session  
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### **OMISSION OF CERTAIN INFORMATION FROM PUBLIC ACCESS**

*Document prepared by the International Bureau*

#### **SUMMARY**

1. It is proposed to amend the Regulations so as to provide the International Bureau with the possibility to omit from international publication, and to restrict public access to, sensitive information in certain circumstances. In addition, in order to ensure that any such sensitive information is not made publicly available by the receiving Office, the International Searching Authority or the Authority specified for supplementary search, it is proposed to also restrict access to such information contained in the files held by those Offices or Authorities.
2. It is further proposed to amend the Regulations so as to provide the International Bureau with the possibility to restrict access to its files in respect of documents which were prepared for the International Bureau's internal use only.
3. Finally, it is proposed to amend the Regulations so as to provide the International Bureau with the possibility to suggest to the applicant to correct the international application in cases in which the International Bureau notices that the international application itself contains expressions or drawings contrary to morality or public order, disparaging statements or any matter obviously irrelevant or unnecessary under the circumstances.

## BACKGROUND

4. In the past, the International Bureau has encountered a number of cases in which it received documents in relation to an international application which (accidentally) contained certain sensitive information not required under the PCT and obviously irrelevant to the disclosure of the invention. This included credit card details, bank details, social security numbers, medical certificates or excerpts of docketing calendars containing confidential information regarding the filing of other PCT or national patent, trademark or design applications, submitted in support of a restoration request under Rule 26*bis*; information as to the economic value of a transfer in an assignment document submitted in support of a request for the recording of a change under Rule 92*bis*; or the home address of the inventor, etc. (see document PCT/WG/7/18).

5. Many national laws provide for the possibility to remove certain sensitive information from publication and/or public file inspection (see document PCT/WG/7/18, paragraphs 8 to 14). At present, there is no clear legal basis for the International Bureau or the applicant to prevent such information from becoming publicly available, either by way of international publication or by way of access to the file held by the International Bureau, the receiving Office or an International Authority. The present Regulations only allow for very limited exceptions from making certain documents and data publicly available (see Article 21(6) and Rule 9.2).

6. The International Bureau presented a proposal to address the issue of omission of certain information from public access to the Working Group at its seventh session (see document PCT/WG/7/18). The Working Group supported the proposal in principle; however, some delegations considered the provisions to be too broad in scope and suggested that more specificity and clarity as to which information could be omitted should be provided (see document PCT/WG/7/30, paragraph 416).

## PROPOSALS

### PROPOSED AMENDMENT OF RULE 9.2

7. It is proposed to amend Rule 9.2 to provide the International Bureau and the Authority specified for supplementary search, in addition to the receiving Office and the International Searching Authority, with the possibility to suggest to the applicant to voluntarily correct the international application in the circumstances referred to in Rule 9.1. This proposed Rule change had already been supported by the Working Group at its seventh session (see document PCT/WG/7/30, paragraph 416).

### PROPOSED AMENDMENT OF RULE 48.2

8. It is further proposed to amend Rule 48.2 by adding a new paragraph (l) so as to allow the International Bureau, at the request of the applicant, to omit from publication certain information included in the international application or related documents which are to be published under Rule 48.2.

9. Such omission from publication would be limited to certain sensitive information, for example, medical certificates submitted as evidence in relation to a request for restoration of the right of priority under Rule 26*bis*.3.

10. The question as to which standard should be applied to decide on whether certain sensitive information should be omitted from publication was discussed by the Working Group at its seventh session. During those discussions, one delegation noted that its national requirements for expunging information were more stringent, as it only allowed inadvertently included information which was not material to a determination of patentability and would cause irreparable harm to be expunged. Some other delegations suggested that a balancing test of the different interests could be used (see document PCT/WG/7/30, paragraphs 410 to 416).

11. Upon consideration, the International Bureau proposes not to restrict the standard to only inadvertently submitted information, as this would exclude all documents submitted as evidence for a restoration request made under Rule 26*bis*.3, such as medical certificates, noting that such documents are always intentionally submitted by the applicant, either together with the restoration request or later upon specific request by the receiving Office under Rule 26*bis*.3(f). In addition, the International Bureau notes that most of the information proposed to be omitted, such as credit card details or confidential transfer details in an assignment document, might in fact have been submitted intentionally because applicants often believe that they have to submit this type of information.

12. Rather, the International Bureau proposes to allow the International Bureau to omit from publication certain information which, in the view of the International Bureau, satisfies the following criteria:

- (i) the information is obviously irrelevant to the disclosure of the invention; and
- (ii) publication of such information would prejudice the personal or economic interests of any person;

provided that there is no prevailing public interest to have access to that information.

13. It is noted that it is very exceptional, in the experience of the International Bureau, for a document to contain such sensitive information and thus reasonably even more exceptional for there to be a case in relation to which such information would qualify for omission. It is also noted that the International Bureau would only omit information in cases where it is clear that the requirements are fulfilled.

14. Any request for omission by the applicant would have to be received by the International Bureau prior to the completion of technical preparations for international publication. The applicant would be required to submit replacement sheets as well as a letter explaining the differences between the replaced and the replacement sheets.

15. Where the International Bureau authorizes the omission of such information from publication, the replacement sheet would become part of the document to be published under Rule 48.2. The request to omit from publication certain information, any letter explaining the differences as well as any replaced sheets would become part of the file of the International Bureau but would be excluded from public accessibility (see the proposed amendment to Rule 94.1, below).

16. Similar to the provisions set out in Rule 9.2, it is further proposed to amend Rule 48.2 by adding a new paragraph (m) so as to allow Offices, Authorities and the International Bureau to draw the applicant's attention to the possibility to request the omission of sensitive information.

17. It is also proposed to amend Rule 48.2 by adding a new paragraph (n) which requires the International Bureau to notify Offices and Authorities of any omission from publication if the omitted information is also contained in their files.

#### PROPOSED AMENDMENT OF RULE 94.1

18. Firstly, it is proposed to amend Rule 94.1 by adding a new paragraph (d) so as to enable the International Bureau to withhold access to any information contained in its file which has been omitted from publication under (proposed new) Rule 48.2(l) (see paragraphs 8 to 13, above).

19. Secondly, it is proposed to amend Rule 94.1 by adding a new paragraph (e) so as to enable the International Bureau, upon request of the applicant, not to provide access to any information which, in the opinion of the International Bureau is obviously irrelevant to the disclosure of the invention, public access to which would prejudice the personal or economic interests of a person and in relation to which the interest of that person not to have that information publicly available prevails over the public interest to have access to that information.

20. Thirdly, it is proposed to amend Rule 94.1 by adding a new paragraph (f) which requires the International Bureau to notify Offices and Authorities of any omission from public access if the omitted information is also contained in their files.

21. Fourthly, it is proposed to amend Rule 94.1 by adding a new paragraph (g) so as to enable the International Bureau to exclude documents of a purely internal nature from becoming publicly accessible (for example, file-related e-mail communication within the International Bureau or between the International Bureau and Offices or Authorities). In this context, it is noted that many of the national laws of PCT Member States have similar provisions which restrict access to Office internal documents, and that this amendment would only regularize the International Bureau's current practice, as such internal documents already today are not made available to the public.

#### PROPOSED ADDITION OF NEW RULES 94.1BIS AND TER, PROPOSED AMENDMENT OF RULE 94.2 AND PROPOSED ADDITION OF NEW RULE 92.2BIS

22. Current Rule 94 provides provisions for access to the file held by the International Bureau, the International Preliminary Examining Authority and the elected Office. Access to the file held by the receiving Office, the International Searching Authority, and designated Office are only regulated in Article 30 insofar as none of these Offices or Authorities shall provide access to the file of the international application held by it to third parties before the date of international publication of the application concerned, unless requested or authorized by the applicant.

23. Since there is no provision in Rule 94 which regulates access to the files held by those Offices and Authorities, it is left to the national law applicable by these Offices and Authorities whether or not to provide such access. In order to clarify which Offices and Authorities provide access to their files, it is proposed to amend Rule 94 and include provisions on access to the file held by these Offices and Authorities. This proposal had already been supported by the Working Group at its seventh session (see document PCT/WG/7/30, paragraphs 410 to 416).

24. With regards to access to the files held by the receiving Office and the International Searching Authority, it is proposed that access to the file should be provided to the applicant or any person authorized by the applicant, as is provided by the International Bureau and the International Preliminary Examining Authority under present Rule 94, and that access to the file to any third person may be provided after publication of the international application.

25. With regards to access to the file held by the designated Office, it is proposed to apply the same provisions as currently exist for the elected Office under present Rule 94, as far as they are applicable.

26. In addition, it is proposed to restrict access to the file held by the receiving Office, the International Searching Authority and the Authority specified for supplementary search where the file contains information which has been excluded from international publication under proposed new Rule 48.2(l) or withheld from public access by the International Bureau under proposed new Rule 94.1(e). Any other restrictions regarding the access to the file held by the applicable national law of that Office or Authority would, of course, continue to apply.

*27. The Working Group is invited to consider the proposals set out in the Annex to this document.*

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS<sup>1</sup>

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

## Rule 9

### Expressions, Etc., Not to Be Used

#### 9.1 [No change] Definition

The international application shall not contain:

- (i) expressions or drawings contrary to morality;
- (ii) expressions or drawings contrary to public order;
- (iii) statements disparaging the products or processes of any particular person other than the applicant, or the merits or validity of applications or patents of any such person (mere comparisons with the prior art shall not be considered disparaging *per se*);
- (iv) any statement or other matter obviously irrelevant or unnecessary under the circumstances.

#### 9.2 Noting of Lack of Compliance

The receiving Office, ~~and~~ the International Searching Authority, the Authority specified for supplementary search and the International Bureau may note lack of compliance with the prescriptions of Rule 9.1 and may suggest to the applicant that he voluntarily correct his international application accordingly, in which case the receiving Office, the competent International Searching Authority, the competent Authority specified for supplementary search and the International Bureau, as applicable, shall be informed of the suggestion. ~~If the lack of compliance was noted by the receiving Office, that Office shall inform the competent International Searching Authority and the International Bureau; if the lack of compliance was noted by the International Searching Authority, that Authority shall inform the receiving Office and the International Bureau.~~

9.3 *[No change] Reference to Article 21(6)*

"Disparaging statements," referred to in Article 21(6), shall have the meaning as defined in Rule 9.1(iii).



## Rule 48

### International Publication

48.1 [No change]

48.2 Contents

(a) to (k) [No change]

(l) At the request of the applicant, received by the International Bureau prior to the completion of technical preparations for international publication, the International Bureau shall omit from publication any information, if it finds that:

(i) the information is obviously irrelevant to the disclosure of the invention; and

(ii) publication of such information would prejudice the personal or economic interests of any person;

provided that there is no prevailing public interest to have access to that information. Rule 26.4 shall apply mutatis mutandis as to the manner in which the applicant shall present the information which is the subject of a request made under this paragraph.

(m) Where the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Bureau notes any information meeting the criteria set out under paragraph (l), that Office, Authority or Bureau may suggest to the applicant to request the omission from international publication in accordance with paragraph (l).

*[Rule 48.2, continued]*

(n) Where the International Bureau omitted information from international publication in accordance with paragraph (l) and that information is also contained in the file of the international application held by the receiving Office, the International Searching Authority or the Authority specified for supplementary search, the International Bureau shall promptly notify that Office and Authority accordingly.

48.3 to 48.6 [No change]

## Rule 94

### Access to Files

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

(a) [No change] At the request of the applicant or any person authorized by the applicant, the International Bureau shall furnish, subject to reimbursement of the cost of the service, copies of any document contained in its file.

(b) 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, ~~subject to the reimbursement of the cost of the service,~~ copies of any document contained in its file. [The furnishing of copies may be subject to reimbursement of the cost of the service.](#)

(c) [No change] The International Bureau shall, if so requested by an elected Office, furnish copies of the international preliminary examination report under paragraph (b) on behalf of that Office. The International Bureau shall promptly publish details of any such request in the Gazette.

[\(d\) The International Bureau shall not provide access to any information contained in its file which has been omitted from publication under Rule 48.2\(I\) and to any document contained in its file relating to a request under that Rule.](#)

*[Rule 94.1, continued]*

(e) At the request of the applicant, the International Bureau shall not provide access to any information contained in its file and to any document contained in its file relating to such a request, if it finds that

(i) this information is obviously irrelevant to the disclosure of the invention, and

(ii) public access to such information would prejudice the personal or economic interests of any person;

provided that there is no prevailing public interest to have access to that information. Rule 26.4 shall apply mutatis mutandis as to the manner in which the applicant shall present the information which is the subject of the request made under this paragraph.

(f) Where the International Bureau omitted information from public access in accordance with paragraphs (d) or (e), and that information is also contained in the file of the international application held by the receiving Office, the International Searching Authority or the Authority specified for supplementary search, the International Bureau shall promptly notify that Office and Authority accordingly.

(g) The International Bureau shall not provide access to any document contained in its file which was prepared solely for internal use by the International Bureau.

94.1bis Access to the File Held by the Receiving Office

(a) At the request of the applicant or any person authorized by the applicant, the receiving Office shall provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(b) The receiving Office may, at the request of any person, but not before the international publication of the international application and subject to paragraph (c), provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(c) The receiving Office shall not provide access under paragraph (b) to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication in accordance with Rule 48.2(I) or from public access in accordance with Rule 94.1(d) or (e).

94.1ter Access to the File Held by the International Searching Authority

(a) At the request of the applicant or any person authorized by the applicant, the International Searching Authority shall provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(b) The International Searching Authority may, at the request of any person, but not before the international publication of the international application and subject to paragraph (c), provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

[Rule 94.1ter, continued]

(c) The International Searching Authority shall not provide access under paragraph (b) to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication in accordance with Rule 48.2(I) or from public access in accordance with Rule 94.1(d) or (e).

(d) Paragraphs (a) to (c) shall apply *mutatis mutandis* to the Authority specified for supplementary search.

#### 94.2 Access to the File Held by the International Preliminary Examining Authority

(a) At the request of the applicant or any person authorized by the applicant, ~~or, once the international preliminary examination report has been established, of any elected Office,~~ the International Preliminary Examining Authority shall provide access to any document ~~furnish, subject to reimbursement of the cost of the service, copies of any document~~ contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(b) At the request of any elected Office, but not before the establishment of the international preliminary examination report and subject to paragraph (c), the International Preliminary Examining Authority shall provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(c) The International Preliminary Examining Authority shall not provide access under paragraph (b) to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication in accordance with Rule 48.2(I) or from public access in accordance with Rule 94.1(d) or (e).

94.2bis Access to the File Held by the Designated Office

If the national law applicable by any designated Office allows access by third parties to the file of a national application, that Office may allow access to any documents relating to the international application to the same extent as provided by the national law for access to the file of a national application, but not before the international publication of the international application. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

94.3 *[No change] Access to the File Held by the Elected Office*

If the national law applicable by any elected Office allows access by third parties to the file of a national application, that Office may allow access to any documents relating to the international application, including any document relating to the international preliminary examination, contained in its file, to the same extent as provided by the national law for access to the file of a national application, but not before the international publication of the international application. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

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