

Patent Cooperation Treaty (PCT) Working Group

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TRANSMITTAL BY THE RECEIVING OFFICE OF EARLIER SEARCH AND/OR
CLASSIFICATION RESULTS TO THE INTERNATIONAL SEARCHING AUTHORITY

Document prepared by the International Bureau

SUMMARY

1. The present document sets out proposed amendments to Rule 23*bis*.2, with a view to further clarifying the relationship between, on the one hand, Rule 23*bis*.2(a) and, on the other hand, Article 30(2)(a) as applicable by virtue of Article 30(3), and Rule 94.1*bis*.

BACKGROUND

2. The PCT Assembly, at its forty-seventh session held from October 5 to 14, 2015, adopted, *inter alia*, amendments to the PCT Regulations to require the receiving Office to provide to the competent International Searching Authority the results of any earlier search and/or classification carried out by that Office in its capacity as a national Office on any earlier application(s) forming the basis of priority claim(s) for the international application (Rules 12*bis*, 23*bis* and 41). It further decided that those amendments shall enter into force on July 1, 2017, and shall apply to any international application whose international filing date is on or after July 1, 2017 (see paragraphs 18 to 20 and Annex II of document PCT/A/47/9).

3. Following the adoption of those amendments to the PCT Regulations, it was brought to the attention of the International Bureau that there might be a conflict between, on the one hand, new Rule 23*bis*.2(a) and, on the other hand, Article 30(2)(a) as applicable by virtue of Article 30(3) and new Rule 94.1*bis*.

4. In general, new Rule 23*bis*.2(a) requires the receiving Office, where the international application claims the priority of one or more earlier applications filed with the same Office as that which is acting as the receiving Office and that Office has carried out an earlier search in respect of such an earlier application or has classified such earlier application, to transmit to the International Searching Authority copies of the results of any such earlier search and of any such earlier classification effected by the Office, if already available.

5. However, where:

- (a) the “earlier application” under Rule 23*bis*.2(a) was an international application; and
- (b) the receiving Office with which that earlier international application was filed was also the International Searching Authority in respect of that earlier international application and has classified and searched that earlier international application; and
- (c) where a different Office is acting as the International Searching Authority for the later filed international application;

Article 30(2)(a)(i) as applicable by virtue of Article 30(3) and new Rule 94.1*bis* would appear to prevent the receiving Office from transmitting copies of the results of any earlier search and of any earlier classification to the International Searching Authority for the later filed international application (unless, of course, the applicant would request or authorize such transmittal by the receiving Office).

6. Article 30(2)(a) (applicable to the receiving Office by virtue of Article 30(3)) provides that the receiving Office shall not provide access to the international application by third parties, unless requested or authorized by the applicant, before the earliest of the following dates: (i) the date of the international publication of the international application; (ii) the date of receipt of the communication of the international application under Article 20; and (iii) the date of the receipt of a copy of the international application under Article 22. While the dates set out in Article 30(2)(a)(ii) and (iii) are not relevant to receiving Offices, the date set out in Article 30(2)(a)(i) clearly is, preventing a receiving Office, in the case referred to in paragraph 5, above, from transmitting copies of the results of any earlier search and any earlier classification before the date of international publication of the earlier international application.

7. Similarly, Rule 94.1*bis* (as adopted by the Assembly at its forty-seventh session held from October 5 to 14, 2015) states that that the receiving Office may provide access to any document in its file to any person, but not before the international publication of the international application. Again, this provision is clearly relevant, preventing a receiving Office, in the case referred to in paragraph 5, above, from transmitting copies of the results of any earlier search and any earlier classification before the date of international publication of the earlier international application.

PROPOSAL

8. So as to address this apparent conflict between, on the one hand, Rule 23*bis*.2(a) and, on the other hand, Article 30(2)(a) as applicable by virtue of Article 30(3) and Rule 94.1(*bis*), it is proposed to further amend Rule 23*bis*.2(a) by providing that the requirement for the receiving Office to transmit to the International Searching Authority copies of the results of any earlier search and any earlier classification shall be “subject to Article 30(2)(a) as applicable by virtue of Article 30(3)”.

9. This would ensure that, in the rare case described in paragraph 5, above, the receiving Office would not transmit any earlier search and classification results to the International Searching Authority before the date of international publication of the earlier international application (unless, of course, the applicant would request or authorize such transmittal by the receiving Office). In practice (to be clarified in the Receiving Office Guidelines, together with a

clear explanation that the language “subject to Article 30(2)(a) as applicable by virtue of Article 30(3)” in Rule 23*bis*.2(a) covers the rare case described in paragraph 5, above), this would in most cases mean that the receiving Office would not transmit any such earlier search and classification results to the International Searching Authority at all since, by the time of international publication of the earlier international application, the international search report for the later international application will already have been established in most cases.

10. There does not appear the need to further amend Rule 23*bis*.2(a) by adding a proviso also with regard to Rule 94.1*bis* (“subject to Rule 94.1*bis*”), noting that the date set out in Rule 94.1*bis* as of when the receiving Office is allowed to give access to the file held by it (and thus is allowed to share its earlier search and classification results with the International Searching Authority) is the same as that set out in Article 30(2)(a)(i) (namely, the date of international publication of the earlier international application). Thus, the addition in Rule 23*bis*.2(a) of a proviso with regard to Article 30(2)(a)(i) appears sufficient.

ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

11. The PCT Assembly, at its forty-seventh session held from October 5 to 14, 2015, decided that new Rule 23*bis* shall enter into force on July 1, 2017, and shall apply to any international application whose international filing date is on or after July 1, 2017.

12. It is proposed that the same entry into force provision should apply to the further proposed amendment of Rule 23*bis* set out in the Annex to this document, thus ensuring that the “corrected” (that is, the further amended) version of new Rule 23*bis* will enter into force on that date.

DISCUSSION AT THE TWENTY-THIRD SESSION OF THE MEETING OF AUTHORITIES UNDER THE PCT

13. The above proposal to further amend Rule 23*bis* was discussed by the Meeting of International Authorities, at its twenty-third session, held in Santiago, Chile from January 20 to 22, 2016 (see document PCT/MIA/23/3). The Summary by the Chair of the meeting summarizes the discussions held as follows (see paragraphs 38 to 43 of document PCT/MIA/23/14, reproduced in the Annex to document PCT/WG/9/2):

“38. Discussions were based on document PCT/MIA/23/3.

“39. Authorities expressed support for the proposed amendments to the PCT Regulations set out in the document, noting that it would appropriately address the apparent conflict between, on the one hand, Rule 23*bis*.2(a) and, on the other hand, Article 30(2)(a) as applicable by virtue of Article 30(3) and Rule 94.1*bis*, and thus provide further clarity to receiving Offices. Several Authorities pointed to the need to provide further guidance on the issue in the Receiving Office Guidelines.

“40. Several Authorities stated their intention to notify the International Bureau of the incompatibility of Rule 23*bis* with their national laws, irrespective of the further proposed amendment to Rule 23 as proposed in the document.

“41. Following queries by several Authorities, the International Bureau stated that it would be happy to further consider the suggestion to modify the existing request form with a view to possibly adding a check box which would allow the applicant to indicate his authorization to the transmittal by the receiving Office to the International Searching Authority of earlier search and classification results.

“42. Following a query by one Authority on whether the transmittal of results of earlier searches and/or classifications between Offices using eSearchCopy may be transmitted separately from the search copies, the International Bureau stated that it will provide guidance for the procedure to be followed by receiving Offices.

“43. The Meeting noted the contents of document PCT/MIA/23/3 and welcomed the International Bureau’s intention to submit the proposed amendments to the PCT Regulations to the PCT Working Group for consideration.”

14. Following the discussions at the Meeting of International Authorities, the International Bureau presents the proposal to further amend Rule 23*bis* to the Working Group for consideration.

15. The Working Group is invited to comment on the proposed amendments to the PCT Regulations set out in the Annex to this document.

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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

Rule 23bis

Transmittal of Documents Relating to Earlier Search or Classification

23bis.1 [No change] *Transmittal of Documents Relating to Earlier Search in Case of Request under Rule 4.12*

(a) The receiving Office shall transmit to the International Searching Authority, together with the search copy, any copy referred to in Rule 12bis.1(a) related to an earlier search in respect of which the applicant has made a request under Rule 4.12, provided that any such copy:

- (i) has been submitted by the applicant to the receiving Office together with the international application;
- (ii) has been requested by the applicant to be prepared and transmitted by the receiving Office to that Authority; or
- (iii) is available to the receiving Office in a form and manner acceptable to it, for example, from a digital library, in accordance with Rule 12bis.1(d).

(b) If it is not included in the copy of the results of the earlier search referred to in Rule 12bis.1(a), the receiving Office shall also transmit to the International Searching Authority, together with the search copy, a copy of the results of any earlier classification effected by that Office, if already available.

23bis.2 Transmittal of Documents Relating to Earlier Search or Classification for the Purposes of Rule 41.2

(a) For the purposes of Rule 41.2, where the international application claims the priority of one or more earlier applications filed with the same Office as that which is acting as the receiving Office and that Office has carried out an earlier search in respect of such an earlier application or has classified such earlier application, the receiving Office shall, subject to [Article 30\(2\)\(a\) as applicable by virtue of Article 30\(3\) and](#) paragraphs (b), (d) and (e), transmit to the International Searching Authority, together with the search copy, a copy of the results of any such earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are available to the Office, and a copy of the results of any such earlier classification effected by the Office, if already available. The receiving Office may, [subject to Article 30\(2\)\(a\) as applicable by virtue of Article 30\(3\)](#), also transmit to the International Searching Authority any further documents relating to such an earlier search which it considers useful to that Authority for the purposes of carrying out the international search.

(b) [No change] Notwithstanding paragraph (a), a receiving Office may notify the International Bureau by April 14, 2016 that it may, on request of the applicant submitted together with the international application, decide not to transmit the results of an earlier search to the International Searching Authority. The International Bureau shall publish any notification under this provision in the Gazette.

(c) [No change] At the option of the receiving Office, paragraph (a) shall apply *mutatis mutandis* where the international application claims the priority of one or more earlier applications filed with an Office different from the one which is acting as the receiving Office and that Office has carried out an earlier search in respect of such an earlier application or has classified such earlier application, and the results of any such earlier search or classification are available to the receiving Office in a form and manner acceptable to it, for example, from a digital library.

[Rule 23bis.2, continued]

(d) [No change] Paragraphs (a) and (c) shall not apply where the earlier search was carried out by the same International Searching Authority or by the same Office as that which is acting as the International Searching Authority, or where the receiving Office is aware that a copy of the earlier search or classification results is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library.

(e) [No change] To the extent that, on October 14, 2015, the transmission of the copies referred to in paragraph (a), or the transmission of such copies in a particular form, such as those referred to in paragraph (a), without the authorization by the applicant is not compatible with the national law applied by the receiving Office, that paragraph shall not apply to the transmission of such copies, or to the transmission of such copies in the particular form concerned, in respect of any international application filed with that receiving Office for as long as such transmission without the authorization by the applicant continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 14, 2016. The information received shall be promptly published by the International Bureau in the Gazette.

Rule 94
Access to Files

94.1 [No change]

94.1 *bis* [No change] *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 may 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(l) or from public access in accordance with Rule 94.1(d) or (e).

94.1 *ter* to 94.2 [No change]

[End of Annex and of document]