

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

### **Working Group**

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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 certain personal or sensitive information contained in its file in circumstances where the public availability of that information would prejudice legitimate personal or economic interests of natural persons or legal entities. In addition, in order to ensure that such personal or 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 file held by that Office or Authority.
2. It is further proposed to amend the Regulations so as to provide the International Bureau with the possibility to restrict access to its file 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 voluntarily correct the international application in cases in which it 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 applicants requested the International Bureau not to make publicly available certain personal or sensitive information which (accidentally) had been included in the international application or related documents. In other cases, the International Bureau itself noted such personal or sensitive information contained in the international application or related documents, or the existence of such information was brought to the attention of the International Bureau by the receiving Office or the International Searching Authority.

5. For example, applicants have submitted sensitive information in support of a request for the restoration of the right of priority under Rule 26*bis*.3 in order to prove that the failure to file the international application within the priority period had occurred in spite of “due care” or was “unintentional”, including medical certificates or excerpts of docketing calendars which contained confidential information regarding the filing of other PCT or national patent applications, trademarks or designs. Furthermore, the International Bureau has received requests for the recording of the change in the person of the applicant under Rule 92*bis*, in support of which the new applicant submitted an assignment document in which he forgot to expunge the agreed economic value of the transfer. Other examples include cases in which the International Bureau has received documents in which the applicant inadvertently included credit card details or a social security number, or in which the applicant accidentally included trade secrets or transfer details in the description of an international application.

6. At present, there is no clear legal basis for the International Bureau 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 present Regulations only allow for very limited exceptions from making certain documents and data publicly available. Article 21(6) provides the International Bureau with the possibility to omit from publication expressions or drawings which, in its opinion, are contrary to morality or public order, or if the international application contains any disparaging statements. PCT Rule 9.2 allows receiving Offices and International Searching Authorities to suggest to the applicant to correct the international application voluntarily if it contains any of the matter listed in Rule 9.1 (expressions or drawings contrary to morality or public order; disparaging statements; obviously irrelevant or unnecessary matter or statements); however, the International Bureau is not mentioned in that Rule.

7. While the provisions of Article 21(6) and Rule 9.2 have, in very few cases, been applied in the past, resulting in the omission from publication of certain expressions and drawings contained in international applications, these provisions are very limited. On the one hand, the correction procedures only relate to the content of the international application but not to other documents or data submitted by an applicant in relation to an international application. On the other hand, they only deal with the case in which the applicant includes certain matter in the international application which an Office or Authority believes should not be in the international application, but not with the case in which the applicant (inadvertently) includes certain unrelated personal or sensitive information in the international application or related documents and later wishes to prevent such information from becoming publicly available.

## PRACTICE AT NATIONAL OR REGIONAL OFFICES

8. Many national laws provide for the possibility to remove certain sensitive information from public file inspection<sup>1</sup> and/or for the omission from publication of certain information contained in the patent application itself.<sup>2</sup> In some cases, national laws also allow for the amendment of the national patent application before publication, thereby giving applicants an opportunity to remove any sensitive information prior to publication. None of these options exist under the current PCT Regulations.

9. While some national laws require a request by the applicant<sup>3</sup>, others allow the Office to remove certain information on its own authority<sup>4</sup> or upon request by a third party<sup>5</sup>.

10. Some national laws provide a list of documents which are *per se* excluded from publication or public file inspection and/or require that, in respect of other documents, a certain standard be met for the exclusion of such documents.<sup>6</sup> At least one Office appears to take the opposite approach and provides a list of documents which may be inspected by third persons (the application documents, related formality documents, notifications and decisions, etc.).<sup>7</sup>

11. The lists of documents excluded *per se* from public file inspection in Offices usually include purely internal documents. In addition, medical certificates, communications relating to file inspection, including the request for exclusion from file inspection, or documents which are subject to a court order that prohibits disclosure of the document or information in the document are often excluded *per se* from public file inspection.<sup>8</sup> A number of national laws provide for the possibility to exclude from public access unintentionally disclosed trade secrets, or the name of the inventor should he wish to remain anonymous.<sup>9</sup>

12. As regards exclusion from publication, some national laws require the applicant to prove that the information to be excluded from publication was unintentionally submitted and that access to that information would cause irreparable harm<sup>10</sup>, while others exclude documents from publication where public order or morality is likely to be injured if such documents were to be published.<sup>11</sup>

13. As regards restriction of public file inspection, some national laws state that documents which include matter which would disparage any person in a way likely to damage him, or the inspection of which would be generally expected to encourage offensive, immoral or anti-social behavior, may not be inspected<sup>12</sup>. At least one national law allows the applicant or a third party to request the Office to remove a document or an entire file containing personal or sensitive information at least from online databases<sup>13</sup>.

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<sup>1</sup> See, for example, the national laws of Australia, Austria, China, Germany, Singapore, Switzerland, United Kingdom, and the European Patent Convention.

<sup>2</sup> See, for example, the national laws of Japan and the United States of America. The European Patent Convention provides for a correction procedure similar to the rectification of an obvious mistake under Rule 91, except that it seems that entire sheets can be removed from the application and be excluded from publication and public file inspection.

<sup>3</sup> See, for example, the national law of the United States of America.

<sup>4</sup> See, for example, the national law of Australia and Singapore.

<sup>5</sup> See, for example, the national law of the United Kingdom.

<sup>6</sup> See, for example, the European Patent Convention.

<sup>7</sup> See, for example, the national law of China.

<sup>8</sup> See, for example, the national law of Australia and the European Patent Convention.

<sup>9</sup> See, for example, the national laws of Austria, China, Germany, Switzerland and the United States of America, and the European Patent Convention.

<sup>10</sup> See, for example, the national law of the United States of America.

<sup>11</sup> See, for example, the national law of Japan and the Republic of Korea.

<sup>12</sup> See, for example, the national law of Singapore and the United Kingdom.

<sup>13</sup> See, for example, the national law of the United Kingdom.

14. Some national laws provide for the exclusion of certain documents from public file inspection for reasons of overriding interests, such as human dignity, personal rights or privacy<sup>14</sup>. Others exclude documents if there are reasonable grounds for believing that they should not be open to public inspection.<sup>15</sup> Yet others restrict public file inspection insofar as inspection may cause damage to the legitimate interests of a party concerned<sup>16</sup>. Under at least one national law documents are exempted from public file inspection at the request of a party if the inspection would be prejudicial to the legitimate personal or economic interests of a natural or legal persons, or on the Office's own authority if the interests of a third person seem to be affected<sup>17</sup>. Regarding the latter, public file inspection is restricted to documents which do not serve the purpose of informing the public about the patent (application).

## PROPOSALS

### PROPOSED AMENDMENT OF RULE 9.2

15. It is proposed to amend Rule 9.2 so as 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 all of the circumstances referred to in Article 21(6) and Rule 9.1, including the case where the applicant had erroneously included in the application any unrelated personal or sensitive information.

### PROPOSED AMENDMENT OF RULE 48.2

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

17. Such omission from publication would be limited to personal or 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, and would be dependent on a finding by the International Bureau that the publication of that information would prejudice the "legitimate personal or economic interests of a natural person or legal entity", a standard which would appear to be in line with most national laws.

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

19. 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 could be excluded from public accessibility (see the proposed amendment to Rule 94.1, below).

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<sup>14</sup> See, for example, the national law of Germany and Switzerland.

<sup>15</sup> See, for example, the national law of Australia and Austria.

<sup>16</sup> See, for example, the national law of China and the European Patent Convention.

<sup>17</sup> See, for example, the European Patent Convention.

#### PROPOSED AMENDMENT OF RULE 94.1

20. 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 16 to 19, above).

21. Secondly, it is proposed to amend Rule 94.1 by adding new paragraph (e) so as to enable the International Bureau, upon request of the applicant or any person authorized by the applicant, to withhold access to any information which, in the opinion of the International Bureau, would prejudice the “legitimate personal or economic interests of a natural person or legal entity”.

22. Thirdly, it is proposed to amend Rule 94.1 by adding a new paragraph (f) 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 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 94.1*BIS* AND *TER*

23. Article 30(3) in conjunction with Article 30(2)(a) provides that no receiving Office shall provide access by third parties to the file of the international application held by it before the date of international publication of the application concerned, unless requested or authorized by the applicant. Since there is, however, no provision equivalent to Rule 94.1 which would require the receiving Office to provide access to the file of the international application held by it after international publication of the application concerned, it is left to the national law applicable by the receiving Office whether or not to provide such access.

24. In order to clarify this present situation, it is proposed to add new Rule 94.1*bis*, providing that receiving Offices *may* provide such access. In addition, it is proposed to restrict access to the file held by the receiving Office where that file contains information which has been excluded from international publication under proposed new Rule 48.2(l) or access to which has been withheld by the International Bureau under proposed new Rule 94.1(e). Any other restrictions regarding the access to the file held by the receiving Office under the applicable national law would, of course, continue to apply.

25. Similarly, it is proposed to add a new Rule 94.1*ter* so as to provide the same clarification with regard to access to the file held by the International Searching Authority and the Authority specified for supplementary search.

26. *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>18</sup>

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<sup>18</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, in the opinion of the International Bureau, publication of such information would prejudice the personal or economic interests of any natural person or legal entity. 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. Where the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Bureau note any such information, that Office, Authority or Bureau may suggest to the applicant to request the omission from publication. Where information is omitted from publication which originally was contained in a document submitted to the receiving Office, the International Searching Authority or the Authority specified for supplementary search, or a copy of such document is otherwise contained in the file of the international application held by that Office or Authority, 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 (f), furnish, subject to the reimbursement of the cost of the service, copies of any document contained in its file.

(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 withhold 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.

(e) At the request of the applicant or any person authorized by the applicant, the International Bureau shall withhold access to any information contained in its file and to any document contained in its file relating to such a request if, in the opinion of the International Bureau, access to such information would prejudice the personal or economic interests of any natural person or legal entity. 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. Where access to

*[Rule 94.1(e), continued]*

such information is withheld and that information was originally contained in a document submitted to the receiving Office, the International Searching Authority or the Authority specified for supplementary search, or a copy of such a document is otherwise contained in the file of that Office or Authority, the International Bureau shall promptly notify that Office and Authority accordingly and transmit a copy of any replacement sheet furnished by the applicant to that Office or Authority.

(f) The International Bureau shall withhold access to any document contained in its file which was prepared solely for internal use by the International Bureau.

94.1 bis 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 withhold 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 that access to the information contained in the file of the International Bureau has been withheld in accordance with Rule 94.1(e).

94.1 *ter* 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 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 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.

(c) The International Searching Authority shall withhold 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 that access to the information contained in the file of the International Bureau has been withheld in accordance with Rule 94.1(e).

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

94.2 [No change] *Access to the File Held by the International Preliminary Examining Authority*

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

[End of Annex and of document]