

C. PCT 1347

June 22, 2012

Madam,
Sir,

In accordance with Rule 89.2(a) of the Regulations under the Patent Cooperation Treaty (PCT), modifications to the Administrative Instructions (AIs) under the PCT and the PCT International Search and Preliminary Examination Guidelines (ISPEGLs) relating to the introduction of a Third Party Observation System are hereby promulgated with effect from July 1, 2012.

This follows consultations under Rule 89.2(b) of the Regulations under the PCT with your Office in its capacity as RO, ISA, IPEA and/or designated/elected Office (DO/EO), and also with certain intergovernmental and non-governmental organizations. The modifications are as proposed in Circular PCT 1338, dated May 2, 2012, except where further changes have been made as a result of consultation, as indicated below (editorial and minor drafting changes are not specifically mentioned).

Modifications of the Administrative Instructions under the PCT (AIs)

In respect of Sections 801 and 802 of the AIs, the modifications are as proposed by Circular PCT 1338. As a result of consultation, a clarification has been added to Section 803(a) that the International Bureau should make any third party observations promptly available for public inspection, which, in practice, will mean that they will be available on PATENTSCOPE the day after the International Bureau checks that the observation appears to meet the requirements of Section 802(a). Similar language has been added to Section 804(b) in respect of comments by the applicant in response to any third party observations. Given that a third party observation can only be made in respect of a published international application, there is no need to specify that the observations will be kept confidential prior to the international publication date. Furthermore, a reference to Rule 93bis was added to Section 805(b) for clarification.

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A few responses to the consultation suggested substantive modifications to the service, which had been announced to and approved by the PCT Working Group, aimed at reducing possible burdens for third parties, applicants or Offices. While these suggestions have not been incorporated at this time, the International Bureau will monitor the underlying issues in the use of the system, as well as any comments which may be received from user groups or individuals attempting to use the system, and will propose amendments if there appear to be real difficulties in practice.

Modifications of the International Search and Preliminary Examination Guidelines (ISPEGLs)

As a result of consultation, proposed paragraph 15.47.1 has been moved from the section concerning “Field of Search” to be paragraph 15.63.1 in the section concerning “Evaluating the Prior Art – Selection of Citations”. Furthermore, both that paragraph and paragraph 17.66.1 have been modified to take into account the fact that the exact time in the process when it will become difficult for the examiner to take an observation into account, without reopening work already done, will depend on the methods of working within the particular Authority, (as well as to clarify that examiners would not necessarily be expected to order copies of documents where copies had not been uploaded, but only to consider them if they were immediately available (such as most patent documents, viewable simply by typing in the number to systems available at the examiner’s desk)). These paragraphs have further been modified to clarify that citations should (where possible) be considered as if they had been found in the international search, rather than as if they were part of the field of search. An additional sentence has also been added to paragraph 17.66.1, suggesting that the examiner may include a statement that certain third party observations have been taken into account, but this has been left at the discretion of the examiner, pending further discussions of best practice in this area.

Proposed paragraph 16.51.1 has been modified to indicate the preferred place for indicating that a document cited in an international search report came from a third party observation; if it would not otherwise be found in the indicated fields of search.

It was observed in the consultation that paragraphs 15.63.1 and 16.51.1 should not normally be relevant to a standard international search report, since the deadline for establishing the report should normally expire before the international publication date. Nevertheless, these paragraphs are included to take into account the fact that, in reality, some international search reports are established after the international publication date and, that such procedures are also relevant, *mutatis mutandis*, to amended international search reports (paragraph 15.69 of the ISPEGLs).

A number of proposals were made for additional modifications, which will be circulated for further consideration by International Authorities before promulgating any additional Guidelines which may be considered desirable.

Availability of the Third Party Observation System

The Third Party Observations System is scheduled to be available through WIPO’s website as of July 2, 2012, either by means of a link from the PATENTSCOPE entries for eligible international applications, or by entering a publication number directly when logged into ePCT public services.

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Availability of Modified Administrative Instructions and ISPEGLs

The consolidated text of the AIs (containing the modifications referred to herein) is available from the WIPO website under *PCT Administrative Instructions (as in force from July 1, 2012)* at: www.wipo.int/pct/en/texts/. This includes the modifications which were promulgated on March 16, 2012 in Circular C. PCT 1336, also with effect from July 1, 2012.

The modified paragraphs of the ISPEGLs (as in force from July 1, 2012) are available from the WIPO website at www.wipo.int/pct/en/texts/gdlines.html. A consolidated text of the ISPEGLs will be made available on the WIPO website in due course.

Offices which need marked-up copies and/or electronic files of the AIs or ISPEGLs should contact the PCT Legal Division at the following e-mail address: pct.legal@wipo.int.

Yours sincerely,



James Pooley
Deputy Director General