

## **OFFICIAL NOTICES (PCT GAZETTE)**

**20 October 2016**

**Notices and Information of a General Character**

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*[Extract]*

### **TRANSMITTAL OF DOCUMENTS RELATING TO EARLIER SEARCH OR CLASSIFICATION: NOTIFICATION BY RECEIVING OFFICES OF INCOMPATIBILITY UNDER PCT RULE *23bis.2(b)***

During its forty-seventh (20<sup>th</sup> ordinary) session, held in Geneva from 5 to 14 October 2015, the Assembly of the International Patent Cooperation Union (PCT Union) unanimously adopted, among others, new Rule *23bis* of the PCT Regulations concerning the transmittal of documents relating to earlier search or classification. New Rule *23bis* will enter into force on 1 July 2017.

New Rule *23bis.2(b)* states: “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.”

The Offices (in their capacity as receiving Offices) of the following States have notified the International Bureau of such incompatibility:

**DE     Germany**

**FI     Finland**

**SE     Sweden**

**TRANSMITTAL OF DOCUMENTS RELATING TO EARLIER SEARCH OR CLASSIFICATION: NOTIFICATION BY RECEIVING OFFICES OF INCOMPATIBILITY UNDER PCT RULE 23bis.2(e)**

During its forty-seventh (20<sup>th</sup> ordinary) session, held in Geneva from 5 to 14 October 2015, the Assembly of the International Patent Cooperation Union (PCT Union) unanimously adopted, among others, new Rule 23bis of the PCT Regulations concerning the transmittal of documents relating to earlier search or classification. New Rule 23bis will enter into force on 1 July 2017.

New Rule 23bis.2(e) states: “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.”

The Offices (in their capacity as receiving Offices) of the following States have notified the International Bureau of such incompatibility and of the extent to which it applies:

**AU Australia**

To the extent that the patent application, document or information is not open for public inspection (as defined in Section 55 of the Australian Patents Act 1990). The Commissioner must not disclose the patent application, document or information without the consent of the applicant.

**CH Switzerland**

To the extent that before publication of the patent application or before the grant of the patent, if the latter occurs first, the following persons are entitled to consult the file, the applicant and his agent, persons who are able to prove that the applicant is accusing them of violating the rights arising from his patent application, or is warning them against such violation, third parties who are able to prove that the applicant or his agent agrees to such consultation.

**CZ Czechia**

To the extent that the patent application has not yet been published.

**FI Finland**

To the extent that the national law of Finland does not permit the transmission of information relating to unpublished applications.

**HU Hungary**

To the extent that prior to publication of the patent application, only the applicant, his representative, the expert, or the body called upon to give an expert opinion, furthermore – if it is necessary for performing their tasks prescribed in Act XXXIII of 1995 on the Protection of Inventions by Patents – the court, the prosecutor or the investigation authority may inspect the files. The inventor may inspect the files even if he is not the applicant. After publication – and subject to the following text – anyone may inspect the files of the patent application. Apart from the cases laid down in the Public Administration Procedures Act, the following shall be excluded from inspection even after publication. Documents used for the preparation of decisions and expert opinions that were not communicated to the parties. Documents indicating the identity of the inventor if the inventor has requested that publication of his name be disregarded. Personal data not indicated in the Patent Register and not communicated in giving official information, unless the persons concerned explicitly approved the inspection thereof or a third person is allowed access to documents containing personal data pursuant to the provisions of the Public Administration Procedures Act.

**IL Israel**

To the extent that under the national law of Israel all documents relating to a patent application are confidential until it is published.

**JP Japan**

To the extent that under the national law of Japan, the Japan Patent Office is not allowed to provide to third parties the documents pertaining to examination, among others, of any patent application without authorization by the applicant, until the application is either registered or published (Article 186(1)(i) of Japanese Patent Act).

**NO Norway**

To the extent that, unless requested by the applicant, the Office may not publish (or transmit) documents (e.g.: the patent application as filed) before the date on which the patent was granted, or 18 months have passed from the national filing date or, if priority is claimed, the priority date. With regard to any documents other than the patent application as filed (e.g.: search copy, search report, prior art listing, examination report, etc.), such documents are considered as internal case documents, and, subject to Section 14 of the Norwegian Publicity Act (Law 19.05.2006 No.16) are exempted from public access. These documents are therefore, in accordance with Section 22 of the Norwegian Patents Act, not made available to the public.

**SE Sweden**

To the extent that such copies are not yet open to the public, or, the sending of such copies is not expressly allowed through an agreement concerning exchange of search results with a patent Office abroad and in which the patent Office abroad binds itself not to make the search results open to the public.

**SG Singapore**

To the extent that under Section 108(2) of the Singapore Patents Act, documents or information relating to an unpublished application cannot be published or communicated to any person by the Registrar of the Intellectual Property Office of Singapore without authorization from the applicant.

**US United States of America**

To the extent that the national law of the United States of America (35 USC 122 and 37 CFR 1.14), require that patent applications that have not been published must be kept in confidence unless specifically authorized by the applicant. As such, absent such specific authorization, the United States Patent and Trademark Office (acting in its capacity as receiving Office under the PCT), is unable to transmit the documents and information provided for in PCT Rule 23*bis*.2(a).

*[End of Extract]*