

Meeting of International Authorities under the Patent Cooperation Treaty (PCT) Working Group

Eighteenth Session
March 15 to 17, 2011, Moscow

Third Party Observations System

Document prepared by the International Bureau

SUMMARY

1. At its third session, held in Geneva in June 2010, the PCT Working Group endorsed a series of recommendations to improve the functioning of the PCT system, based on a study prepared by the International Bureau (document PCT/WG/3/2) and related submissions from certain Member States (documents PCT/WG/3/5 and PCT/WG/3/13). The recommendations endorsed by the Working Group cover a variety of actions which should be undertaken by the International Bureau, applicants, Contracting States and national Offices (acting in both their national and international capacities) to make the PCT system more effective both for processing patent applications and for supporting technology transfer and technical assistance for developing countries.
2. To follow up on the recommendation endorsed by the Working Group that the International Bureau should begin the development of a PCT Third Party Observation System (see document PCT/WG/3/14 Rev., paragraphs 87, 91 and 138 to 151), the International Bureau has prepared a Circular (C. PCT 1288), inviting comments on proposals as to the details of how the International Bureau intends to implement a Third Party Observation System under the PCT. At the time of drafting of the present document, that Circular was about to be mailed to Offices in their various PCT capacities, as well as to Geneva-based missions and foreign ministries of PCT Contracting States and of States that are invited to attend meetings of the PCT Working Group as observers, and to certain organizations that are invited to attend meetings of the PCT Working Group as observers.

3. Circular C. PCT 1288 is reproduced in the Annex to this document. Although each International Authority is invited to respond to the Circular and to comment on the proposals set out therein, the International Bureau considers that it would be useful for the International Authorities to also discuss and comment on those proposals during the present session, together with proposals relating to quality feedback, which the International Bureau intends to issue as a further document.

4. *The Meeting is invited to comment on the proposals set out in the Circular reproduced in the Annex to this document.*

[Annex follows]

ANNEX

DEVELOPMENT OF A PCT THIRD PARTY OBSERVATION SYSTEM

(reproduced from Circular C.PCT 1288)

Madam,
Sir,

Development of a PCT Third Party Observation System

1. This Circular is addressed to your Office in its capacity as a receiving Office, International Searching Authority, International Preliminary Examining Authority and/or designated/elected Office under the Patent Cooperation Treaty (PCT). It is also being sent to Geneva-based missions and foreign ministries of PCT Contracting States and of States that are invited to attend meetings of the PCT Working Group as observers, as well as to certain organizations that are invited to attend meetings of the PCT Working Group as observers.
2. At its third session, held in Geneva from June 14 to 18, 2010, the PCT Working Group endorsed a series of recommendations to improve the functioning of the PCT system, based on a study prepared by the International Bureau (document PCT/WG/3/2) and related submissions from certain Member States (documents PCT/WG/3/5 and PCT/WG/3/13). The Working Group's discussions are outlined in the report of the session (document PCT/WG/3/14 Rev., paragraphs 14 to 137). The recommendations endorsed by the Working Group cover a variety of actions which should be undertaken by the International Bureau, applicants, Contracting States and national Offices (acting in both their national and international capacities) to make the PCT system more effective both for processing patent applications and for supporting technology transfer and technical assistance for developing countries.
3. The purpose of the present Circular is to follow up on the recommendation endorsed by the Working Group that the International Bureau should begin the development of a PCT Third Party Observation System (see document PCT/WG/3/14 Rev., paragraphs 87, 91 and 138 to 151).
4. Annex I to this Circular contains proposals as to the details of how the International Bureau intends to implement a Third Party Observation System under the PCT, including sample screens of web-forms to be filled-in by the third party making the observation. The proposals take into account the comments made by delegations during the third session of the PCT Working Group, as set out in document PCT/WG/3/14 Rev., paragraphs 138 to 151.
5. As explained by the International Bureau during the discussions in the third session of the Working Group (see document PCT/WG/3/14 Rev., paragraph 151), the approach which the International Bureau intends to take in implementing the Third Party Observations System is that the system as proposed in Annex I should be seen as a pilot project whose details are subject to review as experience is gained. Work will begin with the cases where the Working Group agreed that that the system should apply, and which should provide the

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easiest and fastest solution to implement. However, the system will be developed in a way which will make it easy to change any of the features should such change, in light of the experience gained, be desirable. This might include changes to the specific timing, the details of the contents or the way the system can be integrated with other IT systems in order to make use of the system more attractive or the results more effective. This might also include further integration of systems provided by the International Bureau, by national Offices or other projects, such as the various national "Peer to Patent" schemes. Any such changes would, of course, be subject to appropriate further consultations and agreement by Member States.

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6. Annex II to this Circular contains a preliminary draft of proposed modifications to the PCT Administrative Instructions intended to provide the legal framework for the proposed system. Please note that those proposed preliminary draft modifications are sent for information only; a formal consultation procedure on those proposed modifications will follow once the final form of the system has been decided.
7. Comments on the proposals set out in the Annexes to this Circular are invited by all recipients of this Circular. The International Bureau would appreciate receiving any comments by 31. March 2011, sent to Mr. Claus Matthes, Director, PCT Business Development Division (e-mail: claus.matthes@wipo.int, fax: +41-22-338 7150).
8. Any comments received within the above time limit will be taken into account in the further development of the system. The proposals will also be discussed during the upcoming meeting of the PCT International Authorities, scheduled to take place in March 2011. The International Bureau will report on the status of the development work at the next session of the PCT Working Group, tentatively scheduled to take place from June 6 to 10, 2011.

Yours sincerely,

Francis Gurry
Director General

Enclosures: Annex I – Proposed main features of a PCT Third Party Observation System
Annex II – Preliminary draft proposed modifications of the PCT Administrative Instructions

ANNEX I [to Circular C.PCT 1288]
PROPOSED MAIN FEATURES OF A
THIRD PARTY OBSERVATIONS SYSTEM UNDER THE PCT

General Principles

1. In accordance with the approach agreed in the PCT Working Group, the proposed system will:
 - (i) be a mainly web-based system by which the third party would enter the observations using web-forms; in addition, third parties would continue to have the option of submitting observations by way of a simple submission on paper (letter or filled-in standardized form);
 - (ii) at least initially be limited to the indication of prior art which the third party considers to be relevant in respect of novelty and inventive step of the claimed invention;
 - (iii) be eventually available in all 10 PCT publication languages, assuming the usage of the system by third parties evolves as expected (however, the prototype will be available in English only);
 - (iv) be free of charge to the third party submitting the observations;
 - (v) if the third party so wishes, allow for the submission of observations without disclosing the third party's identity to the applicant or the public;
 - (vi) accept submissions of observations as from the date of publication of the international application concerned until the expiration of 28 months from the priority date;
 - (vii) be supported by specific provisions set out in the PCT Administrative Instructions as well as the PCT International Search and Examination Guidelines, specifying details, such as the time limits within which observations may be submitted and the status of any observations submitted.

Access to the Web-based Third Party Observations System

2. A third party will have the option to submit observations on any published international application to the International Bureau via a new web-tool integrated into Patentscope® which will allow any third party to submit observations, using web-forms, on any published international application. The new web-tool to submit observations may be accessed either via the "PCT Service Center" on Patentscope® or via the "Search International and National Patent Collections" database search tool on Patentscope®, as further explained in the following paragraphs.
3. Where a third party wishes to access the Third Party Observations System's webpage via the PCT Service Center on Patentscope®, the third party will have to click on a new link entitled "Submit observations on an international application" which will be integrated into the PCT Service Center webpage, as shown in figure 1, below.

WIPO IP SERVICES

WORLD INTELLECTUAL PROPERTY ORGANIZATION

Home > IP Services > PATENTSCOPE® > PCT Service Center

PATENTSCOPE®

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E-NEWSLETTERS

Subscription

PCT Service Center

- [Online Document Upload](#) - A simple and safe digital solution for submitting quickly and efficiently to the International Bureau (IB) and to the receiving Office of the International Bureau (RO/IB) post-filing electronic documents.
- [PCT E-Payment](#) - This service can only be used to pay fees by credit card as notified by WIPO by e-mail regarding international applications filed under the PCT.
- [Submit observations on an international application](#) - This allows third parties to submit observations (up to 28 months from the priority date) including publications which show that the claimed invention is either not new or is not inventive. Designated and elected Offices can also use this service to give broader feedback to the International Authority at any time.


SHORTCUTS

- ▶ [Why use this service?](#)
- ▶ [User guide for the upload of electronic documents](#)
- ▶ [User guide for E-Payment](#)
- ▶ [User guide for submission of third party observations](#)
- ▶ [System information](#)

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Figure 1: Access to the “Submit Observations” web-page via the PCT Service Center on PATENTSCOPE®

4. Alternatively, where a third party has accessed the international application in respect of which observations are to be submitted via the “Search International and National Patent Collections” database on PATENTSCOPE®, the third party can submit observations on that international application by simply clicking on a new ‘Submit Observation’ tab (see figure 2, below).



PATENTSCOPE
Search International and National Patent Collections

deutsch | français | 日本語 | português | 中文 |



Search
Browse
Options
News
Help

Home > IP Services > PATENTSCOPE > Database Search

1. (WO2011000001) TITLE OF INVENTION

PCT Biblio. Data
Description
Claims
National Phase
Notices
Documents

International Application Status			
Date	Title	View	Download
06.01.2011	International Application Status Report	HTML , PDF	PDF , XML

Published International Application			
Date	Title	View	Download
06.01.2011	Initial Publication with ISR (A1 06/2011)	HTML , PDF (102p.)	PDF (102p.) , ZIP(X)ML + TIFFs

Related Documents on file at the International Bureau			
Date	Title	View	Download
06.01.2011	Application Body as Filed	PDF (100p.)	PDF (100p.) , ZIP(X)ML + TIFFs
06.01.2011	Request form (RO/101)	PDF (4p.)	PDF (4p.) , ZIP(X)ML + TIFFs
06.01.2011	Cover Letter	PDF (2p.)	PDF (2p.) , ZIP(X)ML + TIFFs
06.01.2011	Validation Log	PDF (1p.)	PDF (1p.) , ZIP(X)ML + TIFFs
06.01.2011	Notification of the International Application Number and of the International Filing Date (RO/105)	PDF (1p.)	PDF (1p.) , ZIP(X)ML + TIFFs
06.01.2011	Notification of Receipt of Search Copy (ISA/202)	PDF (1p.)	PDF (1p.) , ZIP(X)ML + TIFFs
06.01.2011	Invitation to Correct Defects in the International Application (RO/106)	PDF (2p.)	PDF (2p.) , ZIP(X)ML + TIFFs
06.01.2011	Notification of receipt of record copy (IB/301)	PDF (1p.)	PDF (1p.) , ZIP(X)ML + TIFFs
06.01.2011	Notification of transmittal of the international search report and the written opinion of the international searching authority, or the declaration (ISA/220)	PDF (1p.)	PDF (1p.) , ZIP(X)ML + TIFFs
06.01.2011	International Search Report	PDF (4p.)	PDF (4p.) , ZIP(X)ML + TIFFs
06.01.2011	Replacement, Substitute sheets under rule 26	PDF (10p.)	PDF (10p.) , ZIP(X)ML + TIFFs
06.01.2011	Power of Attorney	PDF (5p.)	PDF (5p.) , ZIP(X)ML + TIFFs
06.01.2011	Notification Concerning Availability of Publication of the International Application (IB/311)	PDF (1p.)	PDF (1p.) , ZIP(X)ML + TIFFs

Third Party Observations			
Date	Title	View	Download
13.01.2011	Third party observation by J. Smith	HTML , PDF (2p.)	PDF (2p.) , XML
17.01.2011	Third party observation, name withheld	HTML , PDF (2p.)	PDF (1p.) , XML
25.01.2011	Response by applicant to third party observations	PDF (2p.)	PDF (2p.) , ZIP(X)ML + TIFFs

Submit observation

Figure 2: Access to the Third Party Observations System via the “Search International and National Patent Collections” Database Search Tool on PATENTSCOPE®

Log-in Into the Third Party Observations System

5. After clicking on the 'submit observations' button on either the "PCT Service Center" webpage or the "Search International and National Patent Collections" database search tool on PATENTSCOPE[®], the third party will be taken to a new "Log-in" webpage, shown in figure 3, below. Where a third party accesses the Third Party Observations System via the PATENTSCOPE[®] view of a particular international application, the system will automatically fill-in the international application number and the international filing date on the log-in webpage. Where a third party chooses to access the PCT Third Party Observations System via the "PCT Service Center" on PATENTSCOPE[®] (and not via the individual application published on PATENTSCOPE[®]), the third party will be required to indicate at least the international application number or international publication number and the international filing date of the international application concerned (see figure 3, below).
6. The system will require third parties to identify themselves in order to submit observations by providing some basic bibliographic data, such as name, the company or person he or she represents (if any), country of residence and e-mail address. A third party can do so either by logging in as a registered user (in which case the system would fill in the required bibliographic data) or by entering the bibliographic data whenever a new observation is to be submitted. In the latter case, the system will also require the third party to complete the "captcha test" so as to ensure that the web-form is not filled-in by a computer (see figure 3, below).
7. As indicated above, third party observations may be submitted without disclosing the third party's identity to the applicant or the public (see the summary of the discussions during the third session of the Working Group set out in document PCT/WG/3/14 Rev., paragraph 144). Consequently, the bibliographic data given by the third party as set out in paragraph 6, above, will not be disclosed to the applicant or the public, if the third party so requests (by way of ticking a box, see figures 3, 4 and 5 below).

Third Party Observations

Please indicate the international application on which you wish to make observations and then either provide some information about yourself or log in using your WIPO account.

International Application

International Application Number or International Publication Number
Accepted formats: PCT/US/2010/001234, US2010/001234, US10/1235
WO 2011/000512

International Filing Date
format dd/mm/yyyy

Please either log in or identify yourself. Your name, country and the person or organization whom you are representing will be shown in the observations unless you select the option below to hide this information. Your e-mail address will not be shown whether you select that option or not.

I do not wish my identity to be shown to the applicant or in the public record of this observation.

Identify Yourself	Log in using WIPO Account
<p>Name <input style="width: 150px;" type="text"/></p> <p>Representing (company or other person) <input style="width: 150px;" type="text"/></p> <p>Country <input style="width: 150px;" type="text" value="Please select"/></p> <p>E-mail <input style="width: 150px;" type="text"/> <small>(e.g. john.smith@mymail.com)</small></p> <p>Confirm E-mail <input style="width: 150px;" type="text"/> <small>(e.g. john.smith@mymail.com)</small></p> <p>Check <div style="border: 1px solid black; padding: 5px; text-align: center; font-size: 24px; margin: 5px 0;">q a y b</div></p> <p>Please enter the text in the image <input style="width: 150px;" type="text"/></p> <p style="text-align: center;"><input type="button" value="Submit"/> <input type="button" value="Reset"/></p>	<p>To log in, enter your User ID and password.</p> <p>User ID: <input style="width: 150px;" type="text"/></p> <p>Password: <input style="width: 150px;" type="password"/></p> <p>Create an account</p> <p>Forgotten user id?</p> <p>Forgotten password?</p> <p style="text-align: right;"><input type="button" value="Login"/> <input type="button" value="Clear"/></p>

Figure 3: Log-in Screen for third parties

Time Limit for Making Observations

8. As indicated above, it is proposed that the web-based Third Party Observation System should accept submissions of observations as from the date of publication of the international application concerned until the expiration of 28 months from the priority date (see the summary of the discussions during the third session of the Working Group set out in document PCT/WG/3/14 Rev., paragraphs 142, 149 and 150). The User Guide of the system will include a recommendation encouraging third parties to submit observations as early as possible in the process since they would be less likely to be taken into account at a later stage, notably by the International Preliminary Examining Authority where Chapter II examination is demanded, but also by designated or elected Offices where the applicant had entered the national phase early. Where a third party attempts to submit observations after the expiration of 28 months from the priority date, the system will automatically generate a message that the time limit for submitting observations to the International Bureau has passed (either on the screen in figure 2 or in response to the indication of an international application number/international publication number with a too early priority date in the relevant box in figure 3), but that third parties may nevertheless submit

observations directly to the designated or elected Offices before which the international application has entered the national phase, provided the submission of such observations is permitted under the applicable national law of the designated/elected Office concerned.

Language of System's Interface and of Submissions

9. As indicated above, it is proposed that the interface of the web-based Third Party Observation System be eventually available in all 10 PCT publication languages (however, the prototype will be available in English only). It will be possible to submit observations in any of those 10 PCT publication languages. Documentary evidence, in particular publications submitted in support of any observation, may be filed in any language. However, no translation will be required and no human translation service will be provided by the International Bureau. The system will be developed so as to include the provision of machine translations in a limited range of languages for the free text area.

Content of Observations

10. Taking into account the discussions during the third session of the Working Group (see document PCT/WG/3/14 Rev., paragraphs 143 and 150), it is proposed that, at least initially, until experience has been gained with the system, observations should be limited to citations and explanations of prior art considered to be relevant to novelty and inventive step of the claimed invention. In this context, and noting the limited moderation of submissions by the International Bureau (see paragraph 18, below), it should be noted that the system will allow for the submission of observations and citations of documents which are not considered prior art for the purposes of PCT Article 15(2) but which provide evidence of earlier use or oral disclosures which might be relevant in some Contracting States, similar to the mentioning of such documents in international search reports under PCT Rule 33.1(b).
11. Notwithstanding the initial limitations set out in the previous paragraph, the system will be developed so as to permit the addition of observations on other issues such as "clarity" or "sufficiency of disclosure" at a later stage, should Member States decide that this is appropriate.
12. The system will give third parties the option to indicate whether the observations submitted relate to the international application as originally filed or as amended under Article 19 (see figures 4 and 5 below). While, in some cases, the application may also have been amended under Article 34, this fact would not be generally known to the public (or, in most cases, the International Bureau) until after the end of the period for filing observations, and consequently, this will not need to be taken into account.

Submission of Observations

13. Based on the earlier identification of the international application in respect of which observations are to be submitted (see paragraph 5, above), the system will automatically fill-in basic bibliographic data relating to the international application concerned, such as the international publication number, the international application number, the publication date, the international filing date, the name of the applicant and the title of the invention.
14. The system will accept the submission of observations through the use of web-forms, which will encourage the submitter to present the relevant information in a structured manner and will allow the system to transform the information provided into different types of output, for the benefit of different users of the information (see paragraph 19, below). The web-forms will include templates for the different types of citations (patent and non-patent literature) and the input of related bibliographic information (based on WIPO

Standard ST.14 and the related XML definitions in WIPO Standard ST.36). Where a cited patent document is available to the system from a database, the system will allow the third party, based on basic bibliographic information indicated by the third party (such as a country code and a publication number), to look up further related bibliographic information and to automatically populate the web-form with that further information. Where a cited non-patent document is available from an online source, a direct web-link to that document can be provided. In addition, the system will provide for separate “free text” areas so as to allow the third party to identify the relevant passages within the citation, to indicate the claims to which those citations are relevant and to include a brief explanation as to the relevance of the citation to the claimed invention.

Third Party Observation

Pub. No.: WO/2009/080000 International Application number : PCT/GB2008/000001
 Publication date: 13 August 2009 International Filing date: 03 January 2008
 Applicant: ABC Company
 Title: An invention

Observations made on the basis of: the international application as originally filed.
 as amended under Article 19.

Language of Observation: English

Novelty and Inventive Step

Add Citation

Type of citation

Patent document

Monograph (eg conference proceedings)

Journal

Book

Database entry

Other online reference

Reference to prior use or oral disclosure

Other

An allegation that a claimed invention is not new or not inventive needs to be supported by a disclosure of the invention or something which would make the invention obvious. Apart from certain special cases relating to earlier patent applications, that disclosure must have taken place before the priority date of the application (or the filing date if there is no valid priority date).

You can make observations including up to 10 cited documents. To assist Offices in finding the relevant documents efficiently, please enter the details using the most relevant template selected from those on the left.

*** Language of Citation**
English

* Country Code	* Publication Number	Document Kind	Look-up based on a country code, publication number and (preferably) document kind code, the system can attempt to look up the remainder of the information
GB	3744403	A1	
* Publication date	Date of filing	Priority date	

(dd/mm/yyyy) (dd/mm/yyyy) (dd/mm/yyyy)

*** Patentee or applicant**

Most relevant passages or drawings

Relevant to claims

Brief explanation of relevance (max 2000 characters)

Upload Copy
If the document is not part of any common online collection, you may upload a copy of it in PDF format.

Add Citation

I do not wish my identity to be shown to the applicant or in the public record of this observation.

Submit

Figure 4: Example of a third party observation citing a patent document

Third Party Observation

Pub. No.: **WO/2009/080000**

International Application number: **PCT/GB2008/000001**

Publication date: **13 August 2009**

International Filing date: **03 January 2008**

Applicant: **ABC Company**

Title: **An invention**

Observations made on the basis of:

- the international application as originally filed.
 as amended under Article 19.

Language of Observation:

English ▾

Novelty and Inventive Step

Add Citation

Type of citation

- Patent document
 Monograph (e.g. conference proceedings)
 Journal
 Book
 Database entry
 Other online reference
 Reference to prior use or oral disclosure
 Other

*An allegation that a claimed invention is not new or not inventive needs to be backed up by a disclosure of the invention or something which would make the invention obvious. Apart from certain special cases relating to earlier patent applications, that disclosure must have taken place before the priority date of the application (or the filing date if there is no valid priority date).
 You can make observations including up to 10 cited documents. To assist Offices in finding the relevant documents efficiently, please enter the details using the most relevant template selected from those on the left.*

Language of Citation

English ▾

Author

Title of article

Title of periodical

Volume, Number

Date of issue

(dd/mm/yyyy)

Pages

ISBNISSN

Most relevant passages or drawings

Relevant to claims

Brief explanation of relevance (max 2000 characters)

Web link or upload of copy

Upload Copy

Citations may be uploaded in PDF format. Please only upload citations if you have the right to do so and to permit us to send a copy to the applicant and to any designated/elected Office which requests it.

Add Citation

I do not wish my identity to be shown to the applicant or in the public record of this observation.

Submit

Figure 5: Example of a third party observation citing a non-patent document

15. The system will allow third parties to upload referenced documents via the service in PDF format. It should be noted that, in order to avoid the risk of copyright infringement, notably in respect of non-patent literature, such documents uploaded by third parties will not be made available to the public via PATENTSCOPE[®]. Uploaded documents will only be made available to the applicant concerned and to the International Authorities and designated/elected Offices. When a third party uploads a document, the third party will be asked to only upload documents if he or she is authorized to do so and to allow the International Bureau to transmit a copy of it to the applicant, International Authorities and designated and elected Offices.

Technical Measures to Prevent Abuse of the System

16. The International Bureau will put in place technical measures designed to reduce the risk of abuse of the system. The number of citations in a single observation by a third party will be limited to 10 and the free text area will permit a maximum of characters per cited document, such as 2000 characters for submissions using the Latin alphabet (different values could be assigned dependent on the language used to allow approximately the same amount of information to be included in each case). In addition, multiple or automated observations by the same person will be reduced by technical measures, only allowing one observation to be submitted per international application for each account or e-mail address, as well as the use of "captcha" images before the submission form is shown (to reduce automated attacks on the system), measures against multiple submissions in quick succession from the same IP address, and other typical bulletin-board arrangements used to identify submission of "spam" messages.

Submission of Observations on Paper

17. Third parties will also have the option to submit any observations on paper. The International Bureau will develop a paper form with content along the lines of the web-forms outlined above so as to encourage the information to be provided in the desired structure. The International Bureau will scan such observations and feed them into the system. However, in the event of mass campaigns, the International Bureau will reserve the right not to scan all submissions but only a representative sample. Documents attached by third parties will not be made available to the public via PATENTSCOPE[®] but will be made available to the applicant, International Authorities and designated/elected Offices which require them (see also paragraph 15, above).

Moderation of Third Party Observations by the International Bureau

18. The International Bureau will moderate all observations submitted by third parties before making them publicly available or communicating them to the applicant, International Authorities and designated/elected Offices to ensure that they are not spam and that their content is not disparaging, offensive or obviously irrelevant or unnecessary under the circumstances (equivalent to PCT Rule 9.1). The degree of scrutiny will be reviewed over time, depending on the degree to which problems occur in real use of the system.

Making Third Party Observations Publicly Available on PATENTSCOPE[®]

19. All observations submitted by third parties in respect of a published international application will be made publicly available on PATENTSCOPE[®], and will thus be easily available to the applicant, International Authorities and designated/elected Offices as well as the general public. PATENTSCOPE[®] will allow access to all observations submitted and will provide direct links to cited documents (but not to any documents uploaded by the third

party, see paragraph 15, above). It will be possible to download any observations in several different formats, including:

- a PDF or similar pure text view of all the collected observations for easy reading;
- an HTML view, including hypertext links to the relevant documents to the extent that these can be automatically generated by PATENTSCOPE[®] (likely initially to be limited to those patent documents included in at least one of the major free patent databases);
- an XML version of the complete observations, marked up as far as possible using the same elements as are used in the international standards for XML search reports and written opinions, to allow easy integration of the citation data into lists of citations made by Offices;
- a list of only the cited documents, for use in Offices whose third party observation systems do not permit commentary on the relevance of the documents.

Acknowledgement of Receipt of Submission for Third Party

20. A third party who has submitted any observations, be it using the web-based system or on paper, will not be sent an acknowledgment of receipt, except that there will be a confirmation screen as part of the online system. Neither International Authorities nor national Offices are obliged to inform third parties whether their comments were taken into account.

Notification of Receipt of Observations to the Applicant; Response by the Applicant

21. The International Bureau will notify the applicant at least twice of any observations submitted. There will be one notification shortly after receipt of the first observation and another one after the expiration of 28 months from the priority date. In addition, where further observations were received, applicants who provided an email address will be informed by means of an automatically generated e-mail that these observations are available on PATENTSCOPE[®]. Where no e-mail address was provided, the International Bureau will inform the applicant with the first notification, that, if further observations are made, these observations will be made publicly available on PATENTSCOPE[®] and that it is the applicant's responsibility to monitor his or her international application in that respect.
22. Applicants will have the right to respond to any observations made but will not be obliged to do so. Any response may be submitted by sending a letter to the International Bureau or by uploading such a letter through the PCT Service Center. Any response submitted by the applicant will be made publicly available on PATENTSCOPE[®] under the newly integrated heading "Third Party Observations" (see figure 2, above). Applicants will be strongly encouraged to submit any response as early as possible in the procedure to ensure that it will be taken into account by the International Preliminary Examining Authority during Chapter II procedures and by designated and elected Offices during national phase procedures. Where a response is submitted after the expiration of 30 months from the priority date, the applicant will be informed that the time limit to submit has passed and that the response should be sent directly to the designated or elected Offices where the application has or will enter the national phase, where this is permitted by the relevant national law.

Notification of Receipt of Observations and Responses by the Applicant to International Authorities and designated/elected Offices

23. The International Bureau will notify International Authorities and designated/elected Offices by means of an automatically generated form or data feed of any observations made by third parties and of any responses sent by applicants, drawing their attention to the fact that such observations as well as applicants' responses are available on PATENTSCOPE[®] (see figure 2, above). The system will also permit automated retrieval of the observations and the responses by the International Authorities and designated/elected Offices. Documents uploaded by third parties will not be made available to the public via PATENTSCOPE[®] but will be made available to the applicant, International Authorities and designated/elected Offices which require them (see paragraph 15, above).

Proposed Legal Framework of the System

24. As indicated above, it is proposed that the new PCT Third Party Observation System be supported by specific provisions set out in the PCT Administrative Instructions as well as the PCT International Search and Examination Guidelines, setting out specifying details, notably, the time limits within which observations may be submitted and the status of any observations submitted. In particular, the provisions will clarify that neither the International Searching and Preliminary Examining Authorities nor designated or elected Offices will be under any obligation to take into account any observations submitted by third parties, and that it will be up to each International Authority and each designated or elected Office to decide whether to review any observations submitted by a third party, and whether and if so, to which extent to take them into account, in accordance with individual national laws, practices and policies of the Authority or Office concerned. Annex II to this Circular sets out a preliminary draft of possible provisions to be included in the Administrative Instructions and the International Search and Examination Guidelines. Note that a formal consultation procedure on those proposed modifications will follow in due course.

SIMILARITIES WITH THE QUALITY FEEDBACK SYSTEM

25. At its third session, the PCT Working Group also recommended that the International Bureau develop a quality feedback system which allows effective quality feedback from designated/elected Offices to International Authorities (see document PCT/WG/3/14 Rev., paragraphs 152 to 157).
26. The Working Group's discussions with regard to the similarities of both systems are set out in document PCT/WG/3/14 Rev., paragraph 153, as reproduced in the following paragraph:
- "153. In introducing the document, the Secretariat recalled the close links which were seen with the third party observation system which had just been discussed and other projects for sharing search and examination information between Offices. The Secretariat emphasized the importance of all such systems working together effectively and indicated that it believed that the cost of developing this system should be minimal since most of the services could be shared with those being developed for the third party observation system."

27. The International Bureau proposes that designated/elected Offices should be able to use the above arrangements to give feedback to the International Authorities at any time (without the 28 month limit which applies to third parties). The details of how this aspect of the system should be presented will be further discussed with the International Authorities, but it is envisaged that if a user is logged in as an account holder which is authorized to act as a representative of a designated/elected Office (or the system otherwise confirms that the response is from a designated/elected Office rather than a member of the public), the system will allow the above screens to be used at any time and comments on new citations will be made available to the public in exactly the same way as a third party observation, save that the origin of the comment will be noted as being the relevant designated/elected Office. In addition, further screens would be available, permitting feedback of a more general nature to be included. Any new cited documents entered in this way would be made available in the same form as for a normal third party observation, but the additional information would probably be actively notified only to the quality department of the relevant International Authority, but not to the applicant or other Offices.

[Annex II (to *Circular C.PCT 1288*) follows]

ANNEX II [to Circular C.PCT 1288]

PROPOSED MODIFICATIONS TO THE
ADMINISTRATIVE INSTRUCTIONS
UNDER THE PATENT COOPERATION TREATY¹

Section 116

Filing of Third Party Observations; Responses by Applicant

(a) From the date of the international publication of an international application until the expiration of 28 months from the priority date of the international application, any person may submit observations (“third party observations”) to the International Bureau concerning the question whether the invention claimed in the international application is novel and/or involves an inventive step.

(b) Third party observations shall be submitted in writing and in a language of publication referred to in Rule 48.3(a). They may be submitted either in electronic form, preferably using the system provided for that purpose by the International Bureau, or on paper, preferably using Form PCT/IB/3xx.

(c) Third party observations made under this section shall preferably include a brief explanation as to the relevance of the observations to the claimed invention and may be accompanied by a copy of any publication referred to in the observations.

(d) The applicant may, at any time prior to the expiration of 30 months from the priority date, respond to any third party observations submitted under this section but shall not be required to do so. Responses shall be submitted in writing and in a language of publication referred to in Rule 48.3(a).

¹ Please note that the proposed preliminary draft modifications are sent for information only; a formal consultation procedure on the proposed modifications will follow once the final form of the Third Party Observations System has been decided.

Section 117

Status of Third Party Observations

Any third party observations submitted under Section 116 shall not require any action by the International Searching Authority, the International Preliminary Examining Authority or any designated or elected Office, nor limit the freedom of any such Authority or Office, or the freedom of any Contracting State to determine its laws, practices and policies in relation to whether and to what extent observations from a third party are to be taken into account.

Section 437

Communication of Third Party Observations and Responses by the Applicant

(a) Where third party observations are received in accordance with Section 116(a) and (b), or where any responses by the applicant are received in accordance with Section 116(d), the International Bureau shall, subject to paragraphs (c) and (d), notify the following International Authorities and Offices:

(i) the International Searching Authority, if the observations or responses are received prior to receipt by the International Bureau of the international search report or declaration that no international search report will be established;

(ii) any International Searching Authority requested to carry out a supplementary international search, if the observations or responses are received prior to receipt by the International Bureau of the supplementary international search report or declaration that no supplementary international search report will be established;

(iii) the International Preliminary Examining Authority, if the observations or responses are received prior to receipt by the International Bureau of the international preliminary examination report;

(iv) the designated and elected Offices.

[Section 437, continued]

(b) The applicant shall, subject to paragraphs (c) and (d), be notified of any third party observations received in accordance with Section 116(a), provided that, where the applicant has not provided an e-mail address to which notifications by the International Bureau in respect of the international application are to be sent, such notifications shall only be sent twice, namely, upon receipt of the first third party observations and following the expiration of the time limit specified in Section 116(a).

(c) The International Bureau shall not be required to notify the Authorities and Offices referred to in paragraph (a) of any third party observations and of any responses by the applicant nor shall it be required to notify the applicant of any observations which, in the opinion of the International Bureau, contain:

(i) expressions or drawings that are contrary to morality or public order;

(ii) statements which are clearly not relevant to the novelty or inventive step of the invention claimed in the international application, including statements disparaging the products or processes of any person, or the merits or validity of any other application or patent; or

(iii) any statement or other matter that is obviously irrelevant or unnecessary under the circumstances.

(d) Where a large number of third party observations are received by the International Bureau in accordance with Section 116(a) and (b) which, in the view of the International Bureau, are of a similar or identical nature, the International Bureau may, at its discretion, place only a representative sample of those observations on the file of the international application, accompanied by an indication that additional observations of a similar or identical nature were received but have not been put on the file and proceed with regard to those observations which have been put on file as provided in paragraph (a).

[End of Annex and of document]