

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

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IMPROVEMENTS IN THE THIRD PARTY OBSERVATION SYSTEM - ANALYSIS OF AN OBSERVATION

Document submitted by the National Institute of Industrial Property of Brazil

SUMMARY

1. This document proposes providing the possibility for an applicant or a person submitting a third-party observation to request the International Searching Authority or International Preliminary Examining Authority to provide an analysis of a document submitted under the third-party observations system.

INTRODUCTION

2. Currently, most documents are submitted shortly before the deadline established in the third-party observations system (28 months from the priority date). This prevents the International Preliminary Examining Authority from taking into account the observations for international preliminary examination. Furthermore, if the applicant receives a favorable international search report and written opinion about novelty and inventive step of an international application, it is likely that a demand under Chapter II will not be made so a relevant observation submitted during the international phase will not be analyzed until the application enters the national phase.

3. Considering that one of the main features of the PCT System is to provide information regarding the prior art that allows the applicant to decide whether it is worth pursuing the international application in the national phase, the documents presented in the third-party observations system could be taken into consideration more efficiently in the international phase.

4. The proposal aims to change the time limit for submitting third party observations from 28 months to 24 months from the priority date and to enable the request for analysis of a document submitted under the third-party observations system regarding an international application. With the period for submitting third party observations expiring four months earlier, an applicant would have the opportunity to request a technical opinion within the proposed time frame.

5. The request may be made by the applicant or by the person responsible for the submitted document, directly to the International Searching Authority responsible for international search under Chapter I or, if a demand under Chapter II has been made, to the International Preliminary Examining Authority. This analysis would support the applicants in their decisions, provide designated/elected Offices with a more complete analysis of the prior art, and a third party would have a better indication of the relevance of the observation.

BACKGROUND

6. The third-party observation system under PCT was made available with effect from July 2012. The main features to submit observations are:

- (a) Time limit of 28 months from the priority date, but after international publication;
- (b) Documents must be relevant to novelty and/or inventive step;
- (c) Anonymous submission is allowed;
- (d) Each observation may upload a maximum of 10 pieces of prior art with 5,000 characters per cited document on the “brief explanation of relevance”.

7. Since the second session of the PCT Working Group in 2009¹, the third-party observation system has been pointed out as a concrete proposal to improve the quality of international reports and to allow more efficient processing in the national phase.

8. At the eleventh session of the PCT Working Group in 2018², the International Bureau presented information that allowed a comprehensive analysis of the system in the first five years:

- The number of observations per month is increasing and the system is being used sufficiently;
- Most documents cited in the third-party observation system are patent documents (63.7 per cent); periodical articles are the second in the documents submitted;
- A large number of observations are submitted later than two months before the time limit (28th month from the priority date);
- Only 4.5 per cent of applications with observations received a response from the applicant.

9. For international applications where the 28-month period from the priority date to submit third party observations expired in 2024, 458 third party observations were received across 435 international applications. 40 per cent (184 observations) were received within 24 months from the priority date. 37 per cent (168 observations) were not received until the final two weeks before the deadline. Only eight comments from applicants were received in response to these observations. The applicant demanded international preliminary examination on 30 of

¹ Document PCT/WG/2/3.

² Document PCT/WG/11/11.

these applications (6.5 per cent of the applications where an observation had been submitted, compared to about 3 per cent across all international applications), of which nine demands were received after the first third party observation on the application. Among the 100 international applications where an observation was received at least two weeks before 22 months from the priority date (giving an opportunity for making a demand within the time limit under Rule 54*bis*.1(a)(ii), which applies in most cases), the applicant submitted a demand in 10 cases (10 per cent). Of these cases, eight demands were submitted after a third-party observation and two applications only received observations after the demand had been made.

CONTENTS OF THE PROPOSAL

10. The aim of the proposal is to ensure a more effective performance of the third-party observations system during the international phase and improve the quality of the reports by providing applicants or third parties with the possibility of requesting a technical opinion about a document presented. Thus, the system offers not only the opportunity to submit a prior art document that was not identified in the international search report, but also to obtain a technical opinion about it.

FEATURES OF THE PROPOSAL

11. The proposal contains the following features:

- Time limit of 24 months, instead of 28 months, from the priority date for submitting third party observations;
- The request for a technical opinion may be made at any time prior to the expiration of 26 months from the priority date to cause an analysis of a third-party observation document to be carried out by the International Searching Authority responsible for the international search under Chapter I of the application;
- If there is a Chapter II demand, the applicant may include a request for analysis of the third-party observation to be carried out by the International Preliminary Examining Authority;

12. If the observation is submitted anonymously, a request for analysis may be made and the International Authority, as well as the International Bureau, must commit to maintaining anonymity when the result of the analysis is released. It is important to highlight that only patent documents cited in the third-party observation that were filed before the priority date will be analyzed, or if there is no priority claim, before the international filing date, and non-patent literature disclosures must have been made available to the public before the priority date or international filing date, as applicable (Rule 33.1(a) and (c), and Rule 64.3).

MAKING A REQUEST FOR ANALYSIS AND FEES

13. For making a request for an analysis of an observation, the following is proposed:

- A request for analysis of a third-party observation made on an international application shall be submitted directly:
 - o (i) to the International Searching Authority responsible for international search under Chapter I, by the applicant or the person submitting a third-party observation, or;
 - o (ii) if a Chapter II demand has been made, to the International Preliminary Examining Authority, by the applicant.
- Each request for analysis shall refer to only one observation.

- The request for analysis shall be subject to payment of two fees, one to cover the costs of the International Bureau – “handling fee”, and another to cover the costs of the International Authority – “analysis fee”.
- It is up to each Authority to require that the applicant pays a fee (analysis fee) for carrying out such analysis.
- The Authority may set out limitations and conditions of the service in its agreement with the International Bureau. For example, it may limit itself to a maximum number of analyses per applicant or a maximum number of analyses per year.

REGARDING THE INTERNATIONAL AUTHORITY

14. Considering that the third-party observation system is a pilot project, it is up to each International Authority to decide whether to participate in this proposal or not.

15. The time limit for establishing the report of the analysis is 28 months from the priority date.

BENEFITS OF THE ANALYSIS OF OBSERVATIONS

16. The proposal to provide for analysis of third-party observations has the following benefits:

- When there is a relevant observation related to an international application, the applicant does not need to wait until the national phase to know whether the observation is relevant or not if the applicant does not intend to make a demand under Chapter II.
- As the third-party observation system is important to quality in the PCT, this analysis could make it more effective to the applicant in the international phase.
- An analysis could result in greater quality and more comprehensive reports in the international phase.
- The analysis could help the applicant decide whether it is worth pursuing the international application in the national phase in different States.

17. The Meeting is invited to comment on the proposal in the document.

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