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FURTHER AMENDMENTS TO THE PCT REGULATIONS FOLLOWING THE CHANGES TO THE DEFINITION OF RELEVANT PRIOR ART

Document submitted by the Canadian Intellectual Property Office

SUMMARY

1. This document discusses possible further amendments to the PCT Regulations concerning the use of category “O” documents following the implementation of the changes to the definition of relevant prior art for international search and preliminary examination to enter into force on January 1, 2026. The document also discusses modifications to the Administrative Instructions, PCT Forms and International Search and Preliminary Examination (ISPE) Guidelines that would be necessary if the proposed rule amendments are adopted.

BACKGROUND

2. On January 1, 2026, amendments to Rules 33.1(a), 64.1 and 64.2 will come into force to change the definition of relevant prior art to include non-written disclosures (see document PCT/A/56/2, Annex II, and document PCT/A/55/4, paragraph 32). The International Bureau will consult on modifications to the International Search and Preliminary Examination (ISPE) Guidelines to implement these amendments through a PCT Circular, including the use of category “O” documents.

3. At its thirty-first session on October 16 and 17, 2024, the Meeting discussed the implementation of the changes to the definition of relevant prior art (see document PCT/MIA/31/2). This discussion is summarized in paragraphs 9 to 15 of the Summary by the Chair, document PCT/MIA/31/11. With regard to the agreement to work on possible further amendments to the PCT Regulations concerning the use of category “O” documents in paragraph 15(d) of the Summary, the Canadian Intellectual Property Office (CIPO) has reviewed the PCT Regulations, Administrative Instructions, the Forms annexed to the

Administrative Instructions and the ISPE Guidelines in detail. The analysis from this review is set out below.

PCT REGULATIONS

4. The definitions of relevant prior art for the international search in Rule 33.1(a) and of relevant prior art for the international preliminary examination in Rule 64.1 with effect from January 1, 2026, are as follows:

33.1 Relevant Prior Art for the International Search

(a) For the purposes of Article 15(2), relevant prior art shall consist of everything which has been made available to the public anywhere in the world by **any means** which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step (i.e., that it is or is not obvious), provided that the making available to the public occurred prior to the international filing date.

64.1 Prior Art

(a) For the purposes of Article 33(2) and (3), everything made available to the public anywhere in the world by **any means** shall be considered prior art provided that such making available occurred prior to the relevant date.

5. Rule 33.1(b), which is the basis for including “O” documents in the international search report, has not changed and continues to read:

(b) [No change] When any written disclosure refers to an oral disclosure, use, exhibition, or other means whereby the contents of the written disclosure were made available to the public, and such making available to the public occurred on a date prior to the international filing date, **the international search report shall separately mention that fact and the date on which it occurred if the making available to the public of the written disclosure occurred on a date which is the same as, or later than, the international filing date.**

6. Rule 64.2 refers to non-written disclosures and has removed the part about the non-written disclosure not being considered as part of the prior art with effect January 1, 2026. It also defines the documents indicating an earlier non-written disclosure that shall be included in Box No. VI of the written opinion and intellectual preliminary report on patentability (WO/IPRP):

64.2 Non-Written Disclosures

In cases where the making available to the public occurred by means of an oral disclosure, use, exhibition or other non-written means (**“non-written disclosure”**) **before the relevant date as defined in Rule 64.1(b)** and the date of such non-written disclosure is indicated in a written disclosure which has been made available to the public on a date which is the same as, or later than, the relevant date, the international preliminary examination report shall call attention to such non-written disclosure in the manner provided for in Rule 70.9.

7. Rule 70.9 that provides additional information on how documents referred to by virtue of Rule 64.2 are entered in Box No. VI of WO/IPRP also remains unchanged:

70.9 Non-Written Disclosures

Any non-written disclosure referred to in the report by virtue of Rule 64.2 shall be mentioned by indicating its kind, the date on which the written disclosure referring to the non-written disclosure was made available to the public, and the date on which the non-written disclosure occurred in public.

CONSIDERATIONS

8. Prior to January 1, 2026, non-written disclosures were not considered to be relevant prior art and therefore a written disclosure referring to the non-written disclosure, published before the international filing date (IFD), was required. When a written disclosure referring to the non-written disclosure was published on or after the IFD, it could only be cited as an “O” document as per Rule 33.1(b) and it was not used in Box No. V of the written opinion. Instead, it was entered into Box No. VI for information purposes only (Rules 64.2 and 70.9).

9. With the amendments to Rules 33 and 64, the definition of “prior art” has been expanded to be “**any means** which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step”. Therefore, non-written disclosures are now included in the definition of prior art.

10. However, Rules 33.1(b), 64.2 and 70.9 still include the date restrictions for the “O” documents, and the requirement to mention such a document in the WO/ISA and IPRP for all written disclosures referring to non-written disclosures. Since non-written disclosures are citable on their own right, CIPO views that the Regulations as presently written are no longer relevant and cause confusion.

11. The ISPE Guidelines are currently being modified to change the guidance on the use of the “O” category. The proposed “O” category will now be used to identify disclosures that rely on a later published document that reproduces an earlier disclosure for support and/or content (i.e. ephemeral disclosures). However, the relationship between such a document and its publication date is no longer relevant.

12. Therefore, CIPO proposes that Rules 33.1(b), 64.2 and 70.9 be deleted (see Annex, showing proposed amendments to these Rules as in force from January 1, 2026).

MODIFICATIONS TO LEGAL TEXTS

13. If the deletion of these rules is adopted, the following modifications of other legal texts would be proposed:

PCT FORMS (WRITTEN OPINION AND INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY):

14. Item 2 of Box No. VI of Forms PCT/ISA/237, PCT/IPEA/408 and PCT/IPEA/409 should be deleted.

2. Non-written disclosures (Rules 43*bis*.1 and 70.9)

Kind of non-written disclosure	Date of non-written disclosure (day/month/year)	Date of written disclosure referring to non-written disclosure (day/month/year)
_____	_____	_____

15. No changes will be required for the international search report (PCT/ISA/210) since category “O” will still be used for citations where a document reproduces an earlier disclosure (see paragraphs 16.70 and 11.22 of the ISPE Guidelines).

ISPE GUIDELINES:

16. The International Bureau will consult on proposed changes to the ISPE Guidelines through a PCT Circular to address the change in how non-written disclosures should be cited, and how documents reproducing an earlier disclosure should be cited as “O” documents. However, there are some areas that are specific to Rules 33.1(b), 64.2 and 70.9 which would require deletion from the text in that consultation if these Rules were deleted.

Documents Reproducing an Earlier Disclosure

11.22 Where a document reproduces an oral disclosure (for example, public lecture) or a disclosure from a prior use or sale (for example, display at a public exhibition) that was publicly available before the relevant date of the international application, that document should be cited in the international search report with the date that the earlier disclosure was first made publicly available indicated as the date of publication. For a publication on the Internet of an earlier disclosure, the content is considered to be publicly available as of the date of the earlier disclosure if this can be established, for example, by a written reference to the date that a video or audio of a public event was recorded, or an indication of the date of disclosure within the recording itself. If a date of the earlier disclosure cannot be established, that disclosure should be considered to be publicly available as of the date it was posted on the Internet. The content of the oral disclosure or information regarding a prior use or sale where the established date of disclosure is before the relevant date is part of the prior art for purposes of the opinion on novelty and inventive step under Article 33(2) and (3). Attempting to establish the date of the earlier disclosure will therefore be important if the document was published on or after the relevant date of an international application but the earlier disclosure referred to in the document took place before the relevant date. ~~The written opinion and international preliminary examination report also calls attention to such non-written disclosure in the manner provided for in Rule 70.9.~~

15.05 [Deleted] ~~A non-written disclosure such as an oral disclosure, use, exhibition or other means of disclosure is not relevant prior art for the purposes of the international search unless it is substantiated by a written disclosure made available to the public prior to the international filing date and it is the written disclosure which constitutes the prior art. However, if the date on which the a written disclosure refers to a non-written disclosure such as an oral disclosure, use, exhibition or other means of non-written disclosure, and that written disclosure was made available to the public was on or after the filing date of the international application under consideration, the search report should separately mention that fact and the date on which the written disclosure was available, even though such a written disclosure does not meet the definition of relevant prior art in the international phase, so long as the non-written disclosure was made available to the public on a date prior to the international filing date (see paragraph 11.22) since such a non-written disclosure may be considered to be prior art under national law in the national phase.~~

ADMINISTRATIVE INSTRUCTIONS:

17. With the deletion of Rules 33.1(b), 64.2 and 70.9, Section 507(a) of the Administrative Instructions will require amendment as it currently references Rule 33.1(b), as follows..

507(a) “Where any document cited in the international search report refers to an oral disclosure, use, exhibition, or other means ~~referred to in Rule 33.1(b), the separate indication required by that Rule shall consist of~~ the letter “O” should be placed next to the citation of the document. Category “O” shall be accompanied by one of the categories “X”, “Y” or “A”.

18. *The Meeting is invited to:*

(a) *comment on the proposed amendments to the PCT Regulations set out in the Annex to this document; and*

(b) *comment on the proposed modifications to the legal texts as described in paragraphs 13 to 17, above.*

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 33

Relevant Prior Art for the International Search

33.1 *Relevant Prior Art for the International Search*

(a) [No change] For the purposes of Article 15(2), relevant prior art shall consist of everything which has been made available to the public anywhere in the world by any means which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step (i.e., that it is or is not obvious), provided that the making available to the public occurred prior to the international filing date.

(b) [Deleted] ~~When any written disclosure refers to an oral disclosure, use, exhibition, or other means whereby the contents of the written disclosure were made available to the public, and such making available to the public occurred on a date prior to the international filing date, the international search report shall separately mention that fact and the date on which it occurred if the making available to the public of the written disclosure occurred on a date which is the same as, or later than, the international filing date.~~

(c) [No change] Any published application or any patent whose publication date is the same as, or later than, but whose filing date, or, where applicable, claimed priority date, is earlier than the international filing date of the international application searched, and which would constitute relevant prior art for the purposes of Article 15(2) had it been published prior to the international filing date, shall be specially mentioned in the international search report.

33.2 and 33.3 *[No change]*

Rule 64

Relevant Prior Art for the International Preliminary Examination

64.1 *Prior Art*

(a) [No change] For the purposes of Article 33(2) and (3), everything made available to the public anywhere in the world by any means shall be considered prior art provided that such making available occurred prior to the relevant date.

(b) [No change]

64.2 *[Deleted] Non-Written Disclosures*

~~In cases where the making available to the public occurred by means of an oral disclosure, use, exhibition or other non-written means ("non-written disclosure") before the relevant date as defined in Rule 64.1(b) and the date of such non-written disclosure is indicated in a written disclosure which has been made available to the public on a date which is the same as, or later than, the relevant date, the international preliminary examination report shall call attention to such non-written disclosure in the manner provided for in Rule 70.9.~~

64.3 *[No change]*

Rule 70
International Preliminary Report on Patentability
by the International Preliminary Examining Authority
(International Preliminary Examination Report)

70.1 to 70.8 *[No change]*

70.9 *[Deleted]* ~~Non-Written Disclosures~~

~~Any non-written disclosure referred to in the report by virtue of Rule 64.2 shall be mentioned by indicating its kind, the date on which the written disclosure referring to the non-written disclosure was made available to the public, and the date on which the non-written disclosure occurred in public.~~

70.10 to 70.17 *[No change]*

[End of Annex and of document]