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PCT/MIA/VI/4  
ORIGINAL: English  
DATE: December 20, 1996

**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)**

**MEETING OF INTERNATIONAL AUTHORITIES  
UNDER THE PCT**

**Sixth Session  
Canberra, February 17 to 21, 1997**

CONFIDENTIAL NATURE OF THE INTERNATIONAL PRELIMINARY EXAMINATION

*Document prepared by the International Bureau*

1. Certain interested circles, as well as individuals interested in particular international applications, have expressed concern over the inability of third parties to gain access to the contents of the international preliminary examination file under Chapter II of the PCT, given the wording of PCT Article 38(1) and the interpretation of that Article agreed upon by the Meeting at its fourth session (held in Geneva from June 27 to July 1, 1994).

2. For example, the report of the 39th meeting of the Council of the Institute of Professional Representatives before the European Patent Office (EPI) on October 16, 1995, stated (*EPI Information*, volume 4/1995, page 131):

“EPI will ask the EPO President to make use of the possibility in Art. 38(1) PCT to ask for copies of the complete PCT file once the international preliminary examination report has been established and to place at least the written opinions and responses of the applicant during the procedure before the International Preliminary Examining Authority in the European file.”

3. On the other hand, in a letter to the editor of *EPI Information* (volume 4/1995, page 148), a PCT user stated (translation from the original German):

“Recently, opinions have arisen in favor of file inspection concerning the [international preliminary] examination procedure. Against this, the author is

concerned that laying open the procedure between examiner and applicant will lead to a deterioration in the informal character [of the examination]. The speed of the international preliminary examination would thereby be reduced, the effort for attorneys' written communications, etc., increased, which would lead to an overall decrease in efficiency."

4. The Standing Advisory Committee before the European Patent Office (SACEPO) discussed the issue in July 1996, recommending discussion by the competent PCT Authorities in order to analyze all relevant implications of any proposed change of policy. The issue of access to the international preliminary examination file was also discussed by the PCT Issues Special Committee of the American Intellectual Property Law Association (AIPLA) in October 1996.

5. It is recalled that, at its fourth session, the Meeting took the view that the exception provided for in PCT Article 38(1) should be interpreted as limiting access to the file of the international preliminary examination to the elected Offices themselves, that is, as not permitting access, even via elected Offices, to third parties (see document PCT/MIA/IV/14, paragraph 74):

*"Third party access to the file of the international preliminary examination.* In response to an inquiry by the European Patent Office, the Meeting agreed with the view of the International Bureau that the exception in Article 38 allowing access to the file of the international preliminary examination by elected Offices should be interpreted as limiting that access to the elected Offices themselves (that is, as not permitting access, even via the elected Offices, to third parties). Consistent with this interpretation, elected Offices whose national law made application files publicly accessible would be required to remove the international preliminary examination file when allowing such access. Only the international preliminary examination report would become part of the file of the elected Office and would be subject to public inspection to the same extent as the rest of that file."

6. It is further recalled that the Notes contained in the Records of the Washington Diplomatic Conference on the Patent Cooperation Treaty, 1970, state, at page 50, concerning PCT Article 38:

"The combined effect of paragraphs (1) and (2) is that information concerning the international preliminary examination will be given *only to an elected Office* ...

"It is to be noted that neither the International Preliminary Examining Authority nor the International Bureau will give any information concerning the file to anyone other than the elected Offices at any time and that no information will be published either."

7. Different viewpoints as to possible access to the international preliminary examination file may be expected to be found in elected Offices and third parties. Elected Offices have to decide whether or not to grant a patent and may, in doing so, wish to have access to the file of the international preliminary examination. On the other hand, third parties wishing to decide whether to challenge a granted patent may wish to have access to the file not only to understand

better the basis on which the elected Office granted the patent but also to find out what the applicant asserted or admitted (on technical, scientific or other matters) in order to obtain the patent.

8. It is noted that the international preliminary examination report issued by the International Preliminary Examining Authority (IPEA) is, by its very nature, preliminary and non-binding on elected Offices. A given elected Office's decision as to the grant of a patent may be based on claims which have been further amended in the national phase (see PCT Article 41), that is, on claims different from those on which the international preliminary examination report was based.

9. From the viewpoint of applicants, it would be difficult to reconcile the preliminary and advisory nature of the international preliminary examination with the inspection of the file by third parties interested in finding material which could be used against the applicant or, subsequently, the patentee. In this context, documents which are always obtainable at present under the PCT include any amendments to the claims under PCT Article 19 (together with any statement relating thereto), which are published as part of the PCT pamphlet, and priority documents, copies of which are available from the International Bureau under PCT Rule 17.2(c). Moreover, the international preliminary examination report itself is obtainable from the file of certain elected Offices.

10. The examiner in any elected Office may, in the course of preparing reports or office actions, restate or summarize opinions derived from the international preliminary examination file, noting that the file is available, in principle, to all elected Offices. Moreover, particular kinds of material from that file are, in the case of some elected Offices and in certain circumstances, included in the elected Office's file with the applicant's authorization (for example, test results previously furnished by the applicant to the European Patent Office as IPEA are included in the file of that Office as an elected Office by means of a pre-checked box in the form provided by the European Patent Office which may be used by applicants entering the national phase).

11. On the other hand, an international application which enters the national phase before an elected Office with a positive international preliminary examination may proceed to grant without further substantive examination. In such a case, where the Office concerned allows inspection of files for national applications, this has been said by some proponents of greater access to lead to two kinds of granted patents: those for which the examination file cannot be inspected by third parties (that is, international applications upon which a positive international preliminary examination report has been established); and those for which the examination file is open to inspection (all other applications). This is particularly the case for an elected Office where the international preliminary examination report was established by that same Office as IPEA.

*12. The Meeting is invited to consider whether a new approach is needed towards the confidentiality of the file of the international preliminary examination, and if so, whether, and along what lines, amendments would be needed to the PCT Regulations.*

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