

Patent Cooperation Treaty (PCT) Working Group

Fifth Session
Geneva, May 29 to June 1, 2012

AVAILABILITY OF WRITTEN OPINION BY THE INTERNATIONAL SEARCHING AUTHORITY AS OF THE DATE OF INTERNATIONAL PUBLICATION

Document submitted by the United Kingdom

SUMMARY

1. The Annex contains a proposal by the United Kingdom to amend Rules 44~~ter~~ and 48.2 of the PCT Regulations to make the written opinion of the International Searching Authority publicly available from the date of international publication.
2. Currently, Rule 44~~ter~~ prevents the written opinion from being accessed by any person or authority before 30 months from the priority date without authorisation from the applicant. The proposed changes would enable national offices and third parties to view the content of the written opinion at an earlier stage, before the application enters the national phase.

BACKGROUND

3. Under the PCT, the written opinion of the International Searching Authority and any documents relating to international preliminary examination (e.g. amendments and the international preliminary examination report itself) are not made available until 30 months from the priority date. This means that these documents are not available to view on PATENTSCOPE until the national phase begins. In this respect, the PCT differs from many national patent systems that make such documents publicly available at 18 months from the priority date, when the application is published.

4. UK users have indicated they would be in favor of bringing the PCT into line with the majority of national patent systems by making the written opinion and documents relating to international preliminary examination publicly available before 30 months. Making these documents available at an earlier stage would also benefit national offices by enabling them to utilize the international work products in processing equivalent national applications without having to get express consent from the applicant.

CURRENT SITUATION

5. Article 38(1) prevents the International Bureau and the International Preliminary Examining Authority from allowing access to the file of the international preliminary examination by any person or authority at any time, except by the elected Offices once the international preliminary examination report has been established. It follows that there is little scope for making documents relating to international preliminary examination publicly available in the international phase without amendment of the Treaty itself.

6. However, the restrictions on access to the written opinion of the International Searching Authority before 30 months are set out by the Regulations under the PCT, specifically by Rule 44*ter*. It would therefore be possible to relax the restrictions on publication of the written opinion by a simple amendment of the Regulations.

PROPOSED AMENDMENTS

7. It is proposed to delete Rule 44*ter* in its entirety to remove the restrictions on making the written opinion of the International Searching Authority available to the public. The deletion would also have the effect of making any translations of the written opinion and any written observations on those translations available before 30 months.

8. Amendments to Rule 48.2 are also proposed to enable the written opinion to be included in the international publication of the application.

9. *The Working Group is invited to consider the proposed amendments to the Regulations contained in the Annex to this document.*

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

Rule 44ter [Deleted]

**~~Confidential Nature of Written Opinion,
Report, Translation and Observations~~**

~~44ter.1 Confidential Nature~~

~~— (a) The International Bureau and the International Searching Authority shall not, unless requested or authorized by the applicant, allow access by any person or authority before the expiration of 30 months from the priority date:~~

~~— (i) to the written opinion established under Rule 43bis.1, to any translation thereof prepared under Rule 44bis.3(d) or to any written observations on such translation sent by the applicant under Rule 44bis.4;~~

~~— (ii) if a report is issued under Rule 44bis.1, to that report, to any translation of it prepared under Rule 44bis.3(b) or to any written observations on that translation sent by the applicant under Rule 44bis.4.~~

~~— (b) For the purposes of paragraph (a), the term “access” covers any means by which third parties may acquire cognizance, including individual communication and general publication.~~

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

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The publication of the international application shall contain:

(i) to (v) [No change]

(vi) subject to paragraph (g), the written opinion of the International Searching Authority established under Rule 43bis.1;

(vii)~~(vi)~~ any statement filed under Article 19(1), unless the International Bureau finds that the statement does not comply with the provisions of Rule 46.4;

(viii)~~(vii)~~ where the request for publication under Rule 91.3(d) was received by the International Bureau before the completion of the technical preparations for international publication, any request for rectification of an obvious mistake, any reasons and any comments referred to in Rule 91.3(d);

(ix)~~(viii)~~ the indications in relation to deposited biological material furnished under Rule 13*bis* separately from the description, together with an indication of the date on which the International Bureau received such indications;

(x)~~(ix)~~ any information concerning a priority claim referred to in Rule 26*bis*.2(d);

(xi)~~(x)~~ any declaration referred to in Rule 4.17, and any correction thereof under Rule 26*ter*.1, which was received by the International Bureau before the expiration of the time limit under Rule 26*ter*.1;

(xii)~~(xi)~~ any information concerning a request under Rule 26*bis*.3 for restoration of the right of priority and the decision of the receiving Office upon such request, including information as to the criterion for restoration upon which the decision was based.

[Rule 48.2, continued]

(b) to (f) [No change]

(g) If, at the time of the completion of the technical preparations for international publication, the international search report and the written opinion by the International Searching Authority are ~~is~~-not yet available, the front page shall contain an indication to the effect that those reports were ~~that report was~~ not available and that the international search report and the written opinion (when they become ~~it becomes~~ available) will be separately published together with a revised front page.

(h) to (k) [No change]

48.3 to 48.6 [No Change]

[End of Annex and of document]