

C. PCT 1352

September 14, 2012

Madam,
Sir,

1. This Circular is addressed to your Office in its capacity as a designated Office and/or an International Authority under the Patent Cooperation Treaty (PCT). It concerns the means by which Offices may wish to receive copies of third party observations, comments by the applicant on such observations, and copies of close prior art submitted by the applicant.

2. The PCT began to accept third party observations as well as comments by applicants made in response to such third party observations through the ePCT system on July 2, 2012. Pursuant to Section 805 of the PCT Administrative Instructions, such third party observations and related comments by applicants are to be communicated promptly on receipt by the International Bureau to International Authorities which have not yet issued their final reports; in addition, they are also to be communicated, after the expiration of 30 months from the priority date, to all designated Offices. The term “communicated” is to be understood in the context of PCT Rule 93*bis*, under which communication of documents to Offices shall be effected by the International Bureau only on request by the Offices concerned; such a request may be made either in relation to individually specified documents or else in relation to a specified class or classes of documents.

3. In addition to allowing third parties to make observations on an international application and allowing applicants to comment on such third party observations, the ePCT system also allows applicants to upload copies of close prior art. Such copies of close prior art are made available to Offices according to the same rules as third party observations and comments by applicants on such observations.

4. In accordance with PCT Rule 93*bis*, Offices are hereby requested to inform the International Bureau of their preferences in relation to the communication by the International Bureau of third party observations, comments by applicants on such observations and copies of close prior art uploaded by the applicant. The options available are:

- systematic communication over PCT-EDI; or
- no systematic delivery – copies will be sent on paper on specific request only (requests are to be sent to: *pct.doc@wipo.int*).

5. Note that, while third party observations and comments by applicants are publicly available from the PATENTSCOPE web site (or using PATENTSCOPE web services or PADOS, which rely on the same database of published documents), for copyright reasons, any citations uploaded by a third party or by the applicant are not made publicly available but

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can only be retrieved by Offices from the International Bureau by either systematic communication over PCT-EDI or on paper on specific request.

6. From the viewpoint of the International Bureau, the preferred means of communicating observations and copies of cited documents to Offices is through PCT-EDI. Sample batch files, an explanation of the file formats and a link to an updated version of the Minimal Specifications for Electronic PCT Document Exchange (version 3.8 or greater), including new document type codes for third party observations, comments by applicants and copies of close prior art uploaded by applicants can be found on the WIPO website at <http://www.wipo.int/patentscope/en/pct-edi>.

7. It is the hope of the International Bureau that Offices (be it in their capacity as International Authority or designated Office) will use PCT-EDI as the means for systematically receiving all third party observations, comments by applicants and copies of close prior art uploaded by applicants

8. Alternatively, for Offices which cannot use PCT-EDI for document transfer, and in the expectation that weekly volumes of third party observations, comments by applicants and copies of close prior art uploaded by applicants will remain small, the International Bureau is also prepared to provide paper copies upon specific request for individual applications.

9. Note that the International Bureau intends to introduce, in 2013, a secure web services system, similar to PATENTSCOPE web services, which will be able to transmit document types which are not made available on PATENTSCOPE. Similarly, it is intended to extend the ePCT for Offices system, which is currently available for use by Offices in their capacities as receiving Offices and International Authorities, to also offer services for designated Offices. ePCT will then offer a further route for designated Offices to access these documents on individual international applications.

10. Choices of transmission means (systematic communication over PCT-EDI or paper copies on specific request only), as well as any comments and feedback Offices may have, are requested to be submitted to the International Bureau by October 26, 2012, preferably by email to: pct.icd@wipo.int or by fax to: (+41 22) 910 71 50. For any questions you may have, you may also contact Mr. Peter Waring, either via email (peter.waring@wipo.int) or by phone (+41-22-338 8521). Mr. Waring can also offer Offices advice on setting up PCT-EDI communications, if required.

11. If no response is received by October 26, 2012, batches containing third party observations, comments by applicants on such observations and any copies of close prior art uploaded by the applicant will begin to be included routinely in PCT-EDI transmissions to those Offices already receiving documents in the relevant capacity through PCT-EDI from December 1, 2012; for those Offices not receiving documents in the relevant capacity through PCT-EDI paper copies will be provided upon specific request for individual applications. For batches which need to be transmitted before that date, the International Bureau will contact the relevant Office to confirm whether it is prepared to accept the documents in that way or whether an alternative means of transmission should be used in the interim.

Yours sincerely,



James Pooley
Deputy Director General