

## **PATENT COOPERATION TREATY (PCT) WORKING GROUP**

### **Third Session Geneva, June 14 to 18, 2010**

#### **THIRD PARTY OBSERVATIONS SYSTEM: COMMENTS ON DOCUMENT PCT/WG/3/6**

*Document submitted by the European Patent Office*

1. The European Patent Office welcomes the proposal of the International Bureau to establish a system for the filing of third party observations under the PCT and wishes to make the following comments on document PCT/WG/3/6.

#### **Legal basis**

2. In paragraph 11 of the document, it is proposed that the new system be developed on an informal basis with no special provisions in the Regulations or Administrative Instructions.
3. The EPO is of the opinion that the lack of a legal basis for submitting third party observations during the international phase may cause legal uncertainty and could have adverse consequences. In line with one of the general principles of PCT reform which was to simplify and clarify the PCT system (paragraph 66, items (i) and (xi) of document PCT/R/1/26, report, 1st session of the Committee on Reform of PCT, 2001), the new system should get a clear status and should not be implemented by not more than information in the PCT Applicant's Guide or the PCT Newsletter, as is, for instance, presently the case with "informal comments" to the written opinion of the International Searching Authority (PCT Newsletter 05/2006).
4. To the extent that a system allowing third party observations may be relevant for the outcome of the procedure in the international phase, the essential features of the system need to be clearly established and form part of the PCT legal system. This concerns for example the question of time limits for filing third party observations and other formal requirements, the applicant's right to be informed of such observations being filed and his opportunities to react.

5. It is pointed out that establishing a legal basis in the PCT Regulations for the filing of third party observations would not hinder the right of any designated or elected Office to determine as it wishes the status of such observations in the national phase in accordance with the applicable national law.
6. It is suggested that a short general provision is provided for in the PCT Regulations comparable to e.g. Rule 89*bis*.1 PCT with respect to electronic filing and referring to the Administrative Instructions for details. Further additional information could be provided in the PCT International Search and Preliminary Examination Guidelines.
7. The role of the International Bureau in the system should be further clarified, in particular as recipient of third party observations and as the responsible authority to make them available to applicants, international authorities in their role as International Preliminary Examination Authority (IPEA) or Authority specified for supplementary international search (SISA), designated/elected Offices and the public at large.

### **Balance of rights**

8. As a further key issue, the proposed system should facilitate the possibility for applicants to comment on third party observations during the international phase. Paragraph 6(e) of the document suggests that the system should not require applicants to respond to third party observations. However, the right of response to such observations and to obtain an opinion during the international phase on these observations is as important. It is, therefore, proposed that more emphasis is put on gearing the possibility to file third party observations with the options of applicants under the present system to respond by filing a demand for international preliminary examination, by filing a request for supplementary international search, or by submitting informal comments to the International Bureau.
9. In this context it is suggested that third parties are to be encouraged to submit their observations as early as possible and in particular within the time limit to make a demand under Rule 54*bis*.1(a) PCT. This could be done by ensuring that, in the case of a Chapter II procedure, the IPEA be informed of any third party observation and should take note of it, even if it does not have to actually comment on it (see paragraph 12 of the document).
10. Also, third parties should preferably submit their observations in the language of publication with a view to facilitate their understanding by the applicant and their processing by the IPEA in case of Chapter II proceedings, and be allowed to file translations in other languages if they so wish.
11. As time is critical for entry into Chapter II, applicants should be informed by the International Bureau immediately upon receipt of any third party observation. A waiting period of one month as envisaged in paragraph 30 of the document is undesirable not only because the applicant might miss the time limit to make a demand but also as a matter of principle international authorities should not be in the possession of documents filed in respect of the application without the applicant being aware of this. Therefore, the applicant, and where applicable the IPEA or SISA are to be informed without delay of any third party observations submitted.
12. The filing of third party observations with the International Bureau after the end of the international phase (30 months) is considered undesirable. After expiry of the 30-months time limit, such observations cannot be forwarded to the applicant any longer as the International Bureau will not necessarily know who this is in the respective national phases. Also here the principle applies that international authorities should not be in the possession of documents filed in respect of the application without the applicant being aware of this. Moreover, such possibility may lead to uncertainty and confusion in the procedures before the designated/elected Offices.

13. Further, in view of the time needed for applicants to respond by filing informal comments and for the International Bureau to inform national Offices of any such observations filed, a stricter time limit of 28 months from the priority date for filing third party observations is considered more appropriate. Here, it should be taken into account that if third party observations are filed shortly before the end of the international phase an applicant will not be able to submit his comments on these observations in due time to the International Bureau for distribution to all designated/elected offices.
14. Finally, transparency should be ensured by making third party observations publicly available even if documents cited in these observations are not available for downloading to reduce the risk of copyright issues.

[End of document]