



C. PCT 1198

December 18, 2009

Madam,  
Sir,

In accordance with Rule 89.2(a) of the Regulations under the Patent Cooperation Treaty (PCT), modifications to the Administrative Instructions (AIs) under the PCT and the Request Form (Form PCT/RO/101) are hereby promulgated with effect from January 1, 2010.

This follows consultation under Rule 89.2(b) of the Regulations under the PCT with your Office in its capacity as receiving Office (RO), International Searching Authority (ISA), International Preliminary Examining Authority (IPEA) and/or designated/elected Office (DO/EO), and also with certain non-governmental organizations. The modifications are as proposed by PCT Circular C. PCT 1195, dated November 5, 2009, except where further changes have been made as a result of consultation, as indicated below (editorial and minor drafting changes are not specifically mentioned).

*Modifications to the AIs under the PCT*

Section 715 and 716 are promulgated as proposed by Circular C. PCT 1195 and as a result of consultation. Following a comment by an Office, the language of Section 716(a)(ii) was modified to improve the clarity of the paragraph. Furthermore, following comments by Offices, it was clarified in Section 716(b) that the time limit to furnish the priority document should never be shorter than the time limit specified in Rule 17.1(a).

*Modifications to the Request Form*

*Form PCT/RO/101* is modified as proposed by Circular C. PCT 1195 and as a result of consultation. New item 4 has been introduced into the supplemental sheet to allow applicants to indicate an application number where that number is different from the number of the earlier application indicated in Box No. VI and

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where that number is used to identify a priority document in respect of which the International Bureau or the receiving Office is requested to obtain a copy from a digital library. Furthermore, the language of Box No. VI has been improved and a reference added to new item 4 of the supplemental sheet. In the Notes to the Request Form it was clarified that in cases where the applicant has requested Offices to issue notifications only in electronic form, the date of mailing indicated in the electronic copy of the notification sent by e-mail will commence any time limit within the meaning of Rule 80.

#### *Availability of digital libraries to the IB*

The International Bureau (IB) hereby invites all Offices to provide the IB with access to any digital library under its control which holds patent applications and which could form the basis of a priority claim in a subsequent international application. This can be done either by providing PCT-specific access to digital libraries to the IB or by making such libraries available through the WIPO Digital Access Service for Priority Documents. It may be advantageous for your Office to make both arrangements. The advantage of also giving access to the IB, specifically for PCT purposes, would be that your Office could permit access to its digital library for such purposes with fewer access controls than are required for the Digital Access Service, allowing, with immediate effect, a greater body of prior applications to become accessible to the IB without additional burdens on the applicant.

Whether specifically for the purposes of the PCT or for the purposes of the Digital Access Service, the IB will seek to establish connections to your digital library as soon as possible. Once it is satisfied that the access to such digital libraries is functioning properly from a technical perspective, the IB will make any necessary declaration, pursuant to Section 715(a)(i), that it is prepared to obtain priority documents from that digital library, or else assist you in the completion of the required notifications in relation to the functioning of the Digital Access Service.

#### *Procedural guidance to ROs for Rule 17.1(b-bis) requests*

Where the RO receives a request under Rule 17.1(b-bis) to obtain a priority document from a digital library but the priority document cannot be retrieved for technical reasons or is not in fact available to the RO from any digital library to which it has access, pursuant to new Section 716(b) and 716(c), the RO is required to inform the applicant accordingly. Instead of creating a specific PCT Form for such cases, the IB would propose that the RO issues Form PCT/RO/132 instead using the following or similar standard text:

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For a Section 716(b) scenario

“The applicant has requested the receiving Office to obtain a certified copy of the earlier application(s), *[item(s) 1, 2, 3 etc..]* *[all items]* indicated in Box VI of the Request Form, from a digital library, and to transmit *[it]* *[them]* to the International Bureau, as provided under Rule 17.1(b-*bis*)(i). Even though the document(s) in questions should in principle be available to the receiving Office from a digital library, all attempts to obtain the priority document(s) concerned from the digital libraries accessible to the receiving Office have failed.

The applicant is therefore invited to furnish the priority document(s) concerned to the receiving Office, or to ensure that the document(s) is (are) made available to it from a digital library, within a time limit of *[not less than two months]* from the date of this notification.

Where the priority document(s) is (are) furnished or become(s) available to the Office within the time limit indicated above, the requirements of Rule 17.1(b-*bis*) shall be considered to have been met. If the priority document(s) is (are) not furnished or do(es) not become available within the above time limit, the request that the document(s) be obtained from a digital library shall be considered not to have been made.”

*For a Section 716(c) scenario*

“The applicant has requested the receiving Office to obtain a certified copy of the earlier application(s), *[item(s) 1, 2, 3 etc..]* *[all items]* indicated in Box VI of the Request Form, from a digital library, and to transmit *[it]* *[them]* to the International Bureau, as provided under Rule 17.1(b-*bis*)(i). However, the request from the applicant does not comply with (all of) the requirements of Rule 17.1(b-*bis*) and Section 716(a) or the priority document concerned is not considered to be available to this receiving Office from any of the digital libraries accessible to this receiving Office. The applicant is therefore requested to submit the priority document concerned, in accordance with PCT Rule 17.1(a), to the receiving Office or the International Bureau.”

If it is felt by Offices that a particular form would be more convenient to help receiving Offices deal with such cases, the International Bureau would be pleased to propose such a form in the future.

*Updates of the PCT-SAFE software*

Please note that the modifications to the Request Form will not be reflected in the PCT-SAFE software as of January 1, 2010 but will be incorporated into the software as soon as possible thereafter. It is recalled that the request to the receiving Office or the International Bureau under new Section 716 to obtain a

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priority document from a digital library does not have to be made in the Request Form but can be requested in a separate document which could be submitted together with the international application in electronic form. Similarly, an authorization to send notifications by e-mail only can also be requested separately from the request Form under PCT Rule 92*bis*.

*Availability of the AIs and Forms*

The consolidated text of the AIs (containing the modifications referred to herein) is available from the WIPO website under “PCT Administrative Instructions (as in force from January 1, 2010)” at: [www.wipo.int/pct/en/texts/](http://www.wipo.int/pct/en/texts/).

The modified Request Form is available from PATENTSCOPE® under “Forms in force as from January 1, 2010” at: [www.wipo.int/pct/en/forms/](http://www.wipo.int/pct/en/forms/).

Offices which need marked-up copies and/or electronic files of the Request Form or AIs should contact the PCT Legal Division at: [pct.legal@wipo.int](mailto:pct.legal@wipo.int).

Yours sincerely,



Francis Gurry  
Director General