

PUBLICATION

ePCT Third Party Observations: A New Mechanism for Third Party Submission of Art in Published PCT Applications

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As of July 2, 2012, a new and potentially useful option is available that allows third parties to submit art for consideration in published PCT applications. Third parties can now submit "**observations**" in published PCT applications via the ePCT Public Service System. This procedure is similar to submission of third party observations that was available previously at the European Patent Office (EPO).

According to the World Intellectual Property Organization (WIPO) guidance [document](#), the ePCT third party observations service is designed to permit third parties to submit information that they believe shows that the invention claimed in a published PCT application "is either not new (lacks novelty) or is obvious (lacks inventive step)."

Below are some common questions and answers relating to the submission of third party observations through the ePCT Public Service System:

Q. What is an observation?

A. An observation consists of a list of at least one and a maximum of ten prior art citations, together with a brief indication of how each one is considered to be relevant to the novelty or inventive step of the claimed invention.

Preferably, the observation should be accompanied by a copy of the cited document, which will be made available to the Applicant and Designated Offices, but will not be made publicly available.

Q. When can these observations be made?

A. Observations can be submitted from the international publication date until 28 months from the priority date.

Q. How many observations can be submitted against a published PCT Application?

A person may only make a single observation on any particular published PCT Application. A maximum of ten observations may be submitted in connection with any particular PCT Application.

Q. What happens after submission of an observation?

A. The Applicant is permitted to respond to observations by third parties until 30 months from the priority date, but is not required to do so.

The submitted observations and any responses by the Applicant will be made available to:

1. the Applicant;
2. the International Searching Authority (if the international search report has not yet been received by the International Bureau);

3. the International Preliminary Examining Authority (if applicable and the International Preliminary Report on Patentability has not been received by the International Bureau); and
4. Designated Offices.

Q. Do the Designated Offices have to consider the submitted observation?

A. No, it is up to the individual Designated Offices to decide what use to make of an observation.

Q. How much does it cost to make an observation submission?

A. There is no fee.

Q. Will the PCT Applicant know who submitted the observation?

A. Not necessarily. The third party can choose to keep its identity hidden from the PCT Applicant and the public, but an appropriate box must be checked in the electronic system to do so.

Q. Does the third party submitting the observation have any additional rights to intervene in the prosecution of the PCT Application subsequent to submission?

A. No, the person who submitted the observation does not have any additional right to intervene in the processing of the international application, except what may be possible in the national phase through opposition and similar procedures.

However, the observations (excluding copies of cited documents) and any responses by the Applicant will be made publicly available.

Q. Can Applicants use this new ePCT service as an additional method to provide art for consideration in their own PCT Applications?

A. No, the third party observation service is not for use by the Applicant or his representatives.

However, an equivalent function is provided as an "action" in ePCT private services called "observations on close prior art." This function is available at any time up to 30 months from the priority date, including before international publication, and has no limit on the number of observations which can be made for a particular international application.

Conclusion

Because of the strict time limit on utilizing this new ePCT third party observation service, we recommend that clients be vigilant in monitoring WIPO and U.S. Patent and Trademark Office databases to identify PCT Applications of interest.

If you are interested in evaluating your options for utilizing the new ePCT third party observation service, please contact one of our experienced Patent Attorneys.