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INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PATENT COOPERATION TREATY (PCT)

Sixteenth Session
Seoul, March 16 to 18, 2009

SUPPLEMENTARY INTERNATIONAL SEARCH:
LIMITATIONS UNDER RULE 45BIS.9

Document prepared by the International Bureau

SUMMARY

1. International Authorities are invited to consider whether Rule 45bis.9 can and should be interpreted in a way that would allow International Searching Authorities offering the service of supplementary international searches to make a limitation as to the claims which are searched, as distinct from a limitation as to overall competence to carry out a supplementary international search at all, and whether there is a need to amend the PCT Regulations to clarify this matter or whether an agreed understanding by the Assembly as to the interpretation of Rule 45bis.9 would suffice.

BACKGROUND

2. By way of Circular C.PCT 1155, dated November 13, 2008, the International Bureau invited International Searching Authorities to comment on proposed modifications to the PCT International Search and Preliminary Examination Guidelines, consequential on amendments of the Regulations under the PCT introducing the supplementary international search system.

3. In particular, Authorities were invited to comment on the proposed deletion of the following provision previously proposed to be added as new item (iii) of paragraph 15*bis*.13 of the Guidelines:

“The supplementary search may exclude: ... (iii) any claims which are excluded by a limitation or condition specified in the part of the agreement between the International Bureau and the International Authority stating the scope of its service.”

4. As outlined in Circular C.PCT 1155, the proposal to delete the previously proposed item (iii) of paragraph 15*bis*.13 was based on the consideration that the natural reading of Rules 45*bis*.5(g) and 45*bis*.9(a) was such that the limitations referred to in Rule 45*bis*.9 must be matters of competence for search in general, rather than in the extent of a supplementary international search. It appeared to the International Bureau that an Authority could make a general limitation under Rule 45*bis*.9(a) to the effect that it will not be competent if the claimed invention relates to certain subject matter, but that an Authority could not make a more specific limitation to the effect that it will be competent to perform a supplementary international search but that the extent of that search will be limited so that the search will extend to claims which relate to acceptable subject matter but not to those claims relating to specified unacceptable subject matter. Similarly, an Authority could make a general limitation to the effect that it would not be competent if the international application contained more than a certain number of claims (say, more than 50 claims), but not a more specific limitation to the effect that it will be competent to perform a supplementary international search for an international application which contains more than 50 claims but that the extent of that search will be limited so that the search will extend to the first 50 claims only.

5. International Authorities were particularly invited to comment on this interpretation of limitations under Rule 45*bis*.9 as well as, if this interpretation was considered to be correct, whether Authorities saw the need to amend the PCT Regulations so as to allow an Authority to make a limitation as to the claims which are searched, as distinct from a limitation as to overall competence to carry out a supplementary international search at all.

6. In response to Circular C.PCT 1155, four Authorities commented on this issue. Three Authorities (all of which either already offer the service of supplementary international searches or are committed to offer that service in the near future) expressed the view that Authorities should have complete freedom and flexibility to define any limitations under Rule 45*bis*.9 and stated that they did not agree with the suggested interpretation of limitations under Rule 45*bis*.9; one of them suggested that, if needed, the Regulations should be amended accordingly to clarify the issue. One of those Authorities commented as follows:

“We consider SIS [supplementary international searches] as a kind of service to applicants rather than solely a statutory task. Our approach to SIS is therefore that the procedures should be as flexible and user friendly as possible.

“For instance, if an Authority has made a limitation on the number of claims and a request contains a higher number of claims, we would prefer the implication to be that the request is accepted and that the Authority will search only a number of claims up to the limit it has set.

“Similarly, if an Authority were to limit its SIS to certain technical areas, a request that contains claims outside these technical areas should be accepted provided it also contains claims within the accepted areas. It is understood, of course, that the search would only comprise the claims within the accepted technical areas.

“We do not find any provisions in the Treaty or the Regulations that explicitly prevent such flexible interpretation of the SIS. Actually, Rule 45bis.5(c), by referring to Article 17(2)(b) which in itself contains a flexible administration of the search procedure, supports our interpretation. In our view, therefore, there is a presumption for a flexible administration of SIS as exemplified above unless the Agreement between the individual Authority and WIPO specifically limits this.

“Such flexibility would obviously be in the interest of users. Furthermore, we do not believe that this will cause serious administrative problems. On the contrary, in the second example above it might be difficult for the International Bureau to decide whether a request contains claims outside the accepted areas. Still further, we do not see any complications when the application proceeds to the national or regional phase, provided, of course, that the Authority indicates clearly which claims it has searched and the reasons for any limitations in the search.

“We would therefore definitely prefer if the existing legal provisions in the PCT could be interpreted in line with the more flexible approach explained above.”

7. On the other hand, one other Authority commented that it agreed with the suggested interpretation of Rule 45bis.9 and that it did not see the need for any amendment to the Regulations.

POSSIBLE AGREED INTERPRETATION OF LIMITATIONS UNDER RULE 45BIS.9

8. In view of the comments received, International Authorities may wish to consider whether the interpretation of limitations under Rule 45bis.9 as proposed in Circular C.PCT 1155 should be upheld and whether the previously proposed item (iii) of paragraph 15bis.13 should indeed be deleted. Should it be agreed not to uphold that interpretation of limitations under Rule 45bis.9, International Authorities may also wish to consider whether there is a need to clarify the matter before including the previously proposed item (iii) of paragraph 15bis.13 in the Guidelines, either:

(i) by an agreed “understanding” by the Assembly on the interpretation of limitations under Rule 45bis.9; or

(ii) by way of an amendment to Rule 45bis.9.

9. *The Meeting is invited to comment on the issues raised in this document.*

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