

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

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TRANSMITTAL BY THE RECEIVING OFFICE OF EARLIER SEARCH AND/OR
CLASSIFICATION RESULTS TO THE INTERNATIONAL SEARCHING AUTHORITY

Document submitted by the Korean Intellectual Property Office and the European Patent Office

SUMMARY

1. It is proposed that the receiving Office should provide to the competent International Searching Authority the results of any earlier search and/or classification carried out by that Office in its capacity as a national Office on any earlier application(s) forming the basis of priority claim(s) for the international application, provided that the making available of such earlier results is compatible with the national law applied by that Office.

BACKGROUND

2. As many national Offices are striving to reduce the examination pendency period, it is expected that the period will fall below 10 or 11 months in the near future. Since a typical international search under the Patent Cooperation Treaty (PCT) is to be completed within 16 months from the priority date, a growing number of international applications with earlier search results in respect of their family application(s) will become available at the time of international search in the future. Sometimes, national search reports are accompanied by written opinions which might also be of interest for the International Searching Authority. Finally, it is also noted that international applications whose family applications have been assigned classification codes by the national Office prior to international search are now also becoming commonplace.

3. Unfortunately, there is no arrangement for transmitting these search or classification results to the International Searching Authority in the current procedure under the PCT. Generally, the Office of first filing, and thus the national Office which conducts the search and/or classification prior to the international search, is likely to act as receiving Office. Where the Office which produced the search and/or classification results is different from the receiving Office and those earlier search and/or classification results are also available, it would be of benefit for the International Searching Authority too. Unless transmittal of such earlier search and classification results is not compatible with the national law applied by the receiving Office, that is, if it is at all possible for the receiving Office to transmit such search and classification results to another Office, such results should be transmitted to the International Searching Authority.

PROPOSAL

4. Currently, earlier search results may be provided by applicants and form the basis for a request for a refund of the international search fee in accordance with Rules 4.12 and 12*bis*. These search results relate to applications which may or may not be claimed as priority (Rules 16.3 and 41.1). There are also search results relating to applications claimed as priority, where these do not form the basis for a request for refund. The procedure under Rule 12*bis* is applicant driven. It is important to note that the current requirements for the refund under Rule 12*bis* are not proposed to be modified in the present proposal. Rather, current Rule 12*bis* is proposed to be amended only with a view to clarifying which documents relating to any earlier search are to be filed with the receiving Office and which should be filed with the International Searching Authority, if that Authority invited the applicant to do so.

5. A more receiving Office driven solution is currently not provided for in the Regulations. It is proposed to remedy this by introducing new Rules 41.2 and 23*bis*, requiring (“shall” provision) the International Searching Authority, to the extent possible, to take into account the results of any earlier search carried out by it (either in its capacity as an International Authority or as a national Office). Under those new Rules, where such earlier search was carried out by another Office and earlier search and classification results were transmitted to the International Searching Authority by the receiving Office or were otherwise available to that Authority in a form and manner acceptable to it, the new Rules would provide that that Authority may take those results into account when carrying out the international search. This will increase the number of earlier search results available to the International Searching Authorities and thus improve the overall quality and efficiency of the international search.

6. The current system for transmitting such search results to the International Searching Authority under Rule 12*bis*.1(c) suffers from a number of disadvantages for applicants. Firstly, it is not automatic since it requires an explicit request from the applicant and, at some receiving Offices, the payment of an administrative fee. Secondly, it does not provide for the transmittal of all documents which might be required in order to qualify for the refund and which are also of value to the ISA, namely the translations of the search results and the earlier application which may be required by the ISA under Rule 12*bis*.1(b)(ii) and (iii) (the applicant is not able to file any of the documents mentioned in Rule 12*bis*.1(b) at the receiving Office, even where he is in possession of them). As a consequence, the applicant might be invited to provide them directly to the ISA under Rule 12*bis*.1(b) when he could have done this earlier at the receiving Office.

7. For this reason, it is proposed to streamline the system by moving all provisions related to the transmission of documents from Rule 12*bis*.1 and Section 337 of the Administrative instructions to Rule 23*bis*.1, such that all provisions relating to the transmission of documents from the receiving Office to the ISA triggered by requests under Rule 12*bis* are dealt with in one rule. Besides, in new Rule 23*bis*.2, the receiving Office is required to transmit to the competent International Searching Authority the earlier search results and/or classification results whenever these are available at the time of transmitting the search copy to the International

Searching Authority (either because they were provided on filing by the applicant or are otherwise available to the receiving Office before this date). The objective is to increase the number of cases where such results can be transmitted by the receiving Office.

8. In view of the differences in national laws with regard to the making available of information relating to unpublished applications, it is proposed to provide receiving Offices with an “opt out” provision, to the extent that the transmission of copies of earlier search or classification results, or the transmission of such results in a particular form (for example, in the form of an entire search report), without consent by the applicant is not compatible with the national law applied by the receiving Office (see proposed new Rule 23*bis*.2(d)). It is further proposed that consent by the applicant should be considered to have been given unless the applicant indicated in the request, at the time of filing, that such authorization was not given.

9. Those shared search and/or classification results would contribute to reducing the workload at the International Searching Authorities by further improving consistency between the international search report and examination results at the national phase and potentially the quality of international search reports. Also, by making the search process more efficient, this new feature would support efforts from International Searching Authorities to better meet PCT time limits under Rule 42 PCT and the general goal of ensuring A1 publications. This measure would thus benefit both the Offices and the users of the system.

FURTHER CONSIDERATIONS

10. Earlier search results and classification results are of use to the International Searching Authority even where the priority claim in question is withdrawn under Rule 90*bis*.3. Furthermore, since the withdrawal of the priority may be filed before the International Bureau, the simplest and most effective procedure is to require the receiving Office to transmit the search results and classification results under proposed Rule 23*bis* also in respect of a withdrawn priority claim. This situation should be clarified in the Receiving Office Guidelines.

11. The Meeting is invited to consider the proposal set out in the Annex to this document.

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS

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Rule 12bis

Submission by the Applicant of Documents Relating to Earlier Search

~~Copy of Results of Earlier Search and of Earlier Application; Translation~~

12bis.1 Furnishing by the Applicant of Documents Related to Earlier Search in Case of Request Under Rule 4.12 ~~Copy of Results of Earlier Search and of Earlier Application; Translation~~

(a) Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search carried out by the same or another International Searching Authority or by a national Office, the applicant shall, subject to paragraphs (b) to (d) ~~(e) to (f)~~, submit to the receiving Office, together with the international application, a copy of the results of the earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are presented by the Authority or Office concerned.

~~(b) The International Searching Authority may, subject to paragraphs (e) to (f), invite the applicant to furnish to it, within a time limit which shall be reasonable under the circumstances:~~

~~(i) a copy of the earlier application concerned;~~

~~(ii) where the earlier application is in a language which is not accepted by the International Searching Authority, a translation of the earlier application into a language which is accepted by that Authority;~~

~~(iii) where the results of the earlier search are in a language which is not accepted by the International Searching Authority, a translation of those results into a language which is accepted by that Authority;~~

[Rule 12bis.1, continued]

~~(iv) — a copy of any document cited in the results of the earlier search.~~

[COMMENT: The contents of paragraph (b) has been moved to paragraph (a) of proposed new Rule 12bis.2 (see below).]

(b) ~~(e)~~ Where the earlier search was carried out by the same Office as that which is acting as the receiving Office, the applicant may, instead of submitting the copy ~~copies~~ referred to in paragraph (a) ~~paragraphs (a) and (b)(i) and (iv)~~, indicate the wish that the receiving Office prepare and transmit it ~~them~~ to the International Searching Authority. Such request shall be made in the request and may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee.

(c) ~~(d)~~ Where the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, no copy ~~or translation~~ referred to in paragraph (a) ~~paragraphs (a) and (b)~~ shall be required to be submitted under that paragraph ~~those paragraphs~~.

~~(e) — Where the request contains a statement under Rule 4.12(ii) to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language, no copy or translation referred to in paragraphs (b)(i) and (ii) shall be required to be submitted under these paragraphs.~~

[COMMENT: The contents of paragraph (e) has been moved to paragraph (c) of proposed new Rule 12bis.2 (see below).]

[Rule 12bis.1, continued]

(d) ~~(f)~~ Where a copy ~~or translation~~ referred to in paragraph (a) ~~paragraphs (a) and (b)~~ is available to the receiving Office or the International Searching Authority in a form and manner acceptable to it, for example, from a digital library ~~or in the form of the priority document~~, and the applicant so indicates in the request, no copy or translation shall be required to be submitted under that paragraph ~~these paragraphs~~.

12bis.2 Invitation by the International Searching Authority to Furnish Documents Related to Earlier Search in Case of Request Under Rule 4.12

(a) The International Searching Authority may, subject to paragraphs (b) and (c) ~~paragraphs (e) to (f)~~, invite the applicant to furnish to it, within a time limit which shall be reasonable under the circumstances:

(i) a copy of the earlier application concerned;

(ii) where the earlier application is in a language which is not accepted by the International Searching Authority, a translation of the earlier application into a language which is accepted by that Authority;

(iii) where the results of the earlier search are in a language which is not accepted by the International Searching Authority, a translation of those results into a language which is accepted by that Authority;

(iv) a copy of any document cited in the results of the earlier search.

[COMMENT: The contents of proposed new Rule 12bis.2(a) has been moved from present paragraph (b) of Rule 12bis.1 (see above), with minor proposed amendments.]

[Rule 12bis.2, continued]

(b) Where the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, or where a copy or translation referred to in paragraph (a) is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library, or in the form of the priority document, no copy or translation referred to in paragraph (a) shall be required to be submitted under that paragraph.

(c) Where the request contains a statement under Rule 4.12(ii) to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language, no copy or translation referred to in paragraphs (a)(i) and (ii) ~~paragraphs (b)(i) and (ii)~~ shall be required to be submitted under those paragraphs.

[COMMENT: The contents of proposed new Rule 12bis.2(c) has been moved from present paragraph (e) of Rule 12bis.1 (see above), with minor proposed amendments.]

Rule 23bis

Transmittal of Documents Relating to Earlier Search or Classification

23bis.1 Transmittal of Documents Relating to Earlier Search in Case of Request Under

Rule 4.12

(a) The receiving Office shall transmit to the International Searching Authority, together with the search copy, any copy or translation referred to in Rules 12bis.1(a) and 12bis.2(a) related to an earlier search in respect of which the applicant has made a request under Rule 4.12, provided that any such copy or translation:

(i) has been submitted by the applicant to the receiving Office,

(ii) has been requested to be prepared and transmitted by the receiving Office to that Authority, or

(iii) is available to the receiving Office in a form and manner acceptable to it, for example, from a digital library, in accordance with Rules 12bis.1 or 12bis.2, as applicable.

(b) If not included in the copy of the results of the earlier search referred to in Rule 12bis.1(a), the receiving Office shall also transmit to the International Searching Authority, together with the search copy, a copy of the results of any earlier classification effected by that Office, if already available.

23bis.2 Transmittal of Documents Relating to Earlier Search or Classification for the Purposes of Rule 41.2

(a) For the purposes of Rule 41.2, where the international application claims the priority of one or more earlier applications filed with the same Office as that which is acting as the receiving Office and that Office has carried out an earlier search in respect of such an earlier application or has classified such earlier application, the receiving Office shall, subject to paragraphs (b) and (c), transmit to the International Searching Authority, together with the search copy, a copy of the results of any such earlier search results, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are available to the Office, and a copy of the results of any such earlier classification effected by the Office, if already available. The receiving Office may also transmit to the International Searching Authority any further documents relating to such an earlier search which it considers useful to that Authority for the purposes of carrying out the international search.

(b) Paragraph (a) shall apply *mutatis mutandis* where the international application claims the priority of one or more earlier applications filed with an Office different from the one which is acting as the receiving Office and that Office has carried out an earlier search in respect of such an earlier application or has classified such earlier application, and the results of any such earlier search or classification are available to the receiving Office in a form and manner acceptable to it, for example, from a digital library.

(c) Paragraphs (a) and (b) shall not apply where the earlier search was carried out by the same International Searching Authority or by the same Office as that which is acting as the International Searching Authority or where a copy of the earlier search or classification results is available to the International Searching Authority in a form or manner acceptable to it, for example, from a digital library.

[Rule 23bis.2, continued]

(d) To the extent that, on [DATE], the transmission of the copies referred to in paragraphs (a) or (b), or the transmission of such copies in a particular form, such as those referred to in paragraph (a), without the authorization by the applicant is not compatible with the national law applied by the receiving Office, that paragraph shall not apply to the transmission of such copies, or to the transmission of such copies in the particular form concerned, in respect of any international application filed with that receiving Office for as long such transmission without the authorization by the applicant continues not to be compatible with that law, provided that:

(i) the said Office informs the International Bureau accordingly by [DATE]; the Information received shall be promptly published by the International Bureau in the Gazette;

(ii) the authorization shall be considered to have been given by the applicant unless the applicant expressly indicates, in the request, that such authorization is not given.

[COMMENT: This notification provision is proposed to begin with the words “To the extent that...” rather than the more common “If...” to allow receiving Offices the flexibility to pass a limited set of information in cases where that is permitted under national laws, even though it may not be possible to provide the entire search report.]

Rule 41

Taking into Account Results of Earlier Search

41.1 *Taking into Account Results of Earlier Search* [in Case of a Request under Rule 4.12](#)

Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search and has complied with Rule 12*bis*.1 and:

(i) the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, the International Searching Authority shall, to the extent possible, take those results into account in carrying out the international search;

(ii) the earlier search was carried out by another International Searching Authority, or by an Office other than that which is acting as the International Searching Authority, the International Searching Authority may take those results into account in carrying out the international search.

[41.2 Taking into Account Results of Earlier Search in Other Cases](#)

[\(a\) Where the international application claims the priority of one or more earlier applications in respect of which an earlier search has been carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, the International Searching Authority shall, to the extent possible, take the results of any such earlier search into account in carrying out the international search.](#)

(b) Where the receiving Office has transmitted to the International Searching Authority a copy of the results of any earlier search or of any earlier classification under Rule 23bis.2(a) or (b), or where such a copy is available to the International Authority in a form and manner acceptable to it, for example, from a digital library, the International Searching Authority may take those results into account in carrying out the international search.

[End of Annex and of document]