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SUPPLEMENTARY INTERNATIONAL SEARCHES

Document prepared by the Secretariat

SUMMARY

1. Proposals are presented for a system of supplementary international searches within the PCT¹, whereby an applicant would have the option to request, in addition to the “main” international search, one or more supplementary searches to be carried out by International Authorities, other than the International Searching Authority that carries out the main international search. The proposals seek to establish a flexible system for supplementary international searches, aimed at encouraging the use of the results of the main international search in assessing the extent of the supplementary search which is required, but not preventing the International Authority carrying out the supplementary international search from beginning its search where the main international search report is established late, thereby avoiding difficulties in timing and workflow.

¹ References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be. References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc.

TERMINOLOGY

2. In the main body of this document, the following abbreviated expressions are used to describe different search services and roles:

main search: the international search carried out under Article 15;

main Authority: the International Searching Authority which carries out the main international search;

supplementary search: a supplementary international search carried out by an International Searching Authority other than the one which carries out the main international search;

supplementary Authority: an Authority which is requested to carry out a supplementary international search on a particular international application.

BACKGROUND

3. Proposals for the introduction of a system of supplementary searches within the PCT, whereby an applicant would have the option to request, in addition to the main search, supplementary searches to be carried out by International Authorities, other than the International Searching Authority that carries out the main international search, were discussed by the Working Group on the Reform of the PCT (“the Working Group”) at its sixth, seventh and eighth sessions (see documents PCT/R/WG/6/9 and 12 (paragraphs 68 to 81); PCT/R/WG/7/7 and 13 (paragraphs 71 to 92); and PCT/R/WG/8/4 and 9 (paragraphs 35 to 64)), and by the Meeting of International Authorities Under the PCT (PCT/MIA) at its eleventh, twelfth, thirteenth and fourteenth session (see documents PCT/MIA/11/4 and 14 (paragraphs 42 to 55); PCT/MIA/12/2 and 10 (paragraphs 20 to 45); PCT/MIA/13/4 and 8 (paragraphs 26 to 33); and PCT/MIA/14/7 and 8 (paragraphs 42 to 53)).

4. There has been considerable support at the sessions of the Working Group and PCT/MIA for the principle of allowing optional supplementary searches of international applications during the international phase in order to find additional relevant prior art at an early stage, although there has been no consensus among all delegations and Authorities as to the general desirability of introducing a supplementary international search system into the PCT.

5. The discussions of the Working Group at its most recent session (see document PCT/R/WG/8/9, paragraphs 35 to 64) are outlined in the following paragraphs:

“SUPPLEMENTARY INTERNATIONAL SEARCHES

“35. Discussions were based on document PCT/R/WG/8/4.

“*General*

“36. A number of delegations emphasized that the international search was a central feature of the PCT system of great importance to national Offices, applicants and third

parties, and stated that the proposed introduction of supplementary international searches should not be seen as an alternative to ensuring the quality and timing of the main international search.

“37. A few delegations were opposed to the introduction of a system of supplementary international searches.

“38. One delegation considered that the proposal would result in more complication and reduction in legal certainty than would be justified by the benefit.

“39. Another delegation considered that the proposal would result in duplication of work and an increase in workload and that ways should be sought to encourage acceptance of the results of the main search undertaken by a single International Searching Authority. In connection with language-related aspects of the proposals, the delegation made the observation that the Japan Patent Office now provided machine translation of all Japanese patent applications into English to facilitate searching. Furthermore, it suggested that in case of difficulties with documents in particular languages, International Authorities might partially outsource searches to other bodies with the necessary linguistic skills. However, a further delegation observed that translations were not available for all documents and that there were legal difficulties involved in outsourcing, for example, relating to the confidentiality of international applications.

“40. Another delegation, while considering a system of supplementary searches to be a good idea in principle, was concerned at the effect on the current workload of the International Authorities and on the timeliness and quality of search reports and international preliminary reports on patentability. This could add further strain to the current problem before some International Authorities and would be of concern to all those who relied on those reports. Consequently, the delegation considered that it was not an appropriate time to introduce such a system. Instead, the delegation felt that the Working Group should focus first on quality and having one good international search report for now.

“41. One representative of an intergovernmental organization suggested that search services for applicants would be better provided by the private sector than by introducing further complications in the PCT system itself.

“42. On the other hand, while many delegations sympathized with the desire for a single comprehensive search in principle, a large majority of delegations agreed that there was a practical difficulty in providing such a search. In view of the importance to users of an opportunity to gain a better knowledge of the prior art during the international phase, before it was necessary to make decisions and incur substantial costs associated with entry into the national phase, they considered that some form of system of supplementary international search was appropriate. Certain delegations representing smaller Offices indicated that the additional information from supplementary searches would increase the confidence of such Offices as designated Offices in the completeness of the search and thus foster greater acceptance of the results of the international phase. It was observed that the system would be optional for International Authorities as well as applicants, and so need not affect the workloads of Authorities suffering from large backlogs of work.

“43. Amongst the delegations supporting a system of supplementary international searches, it was common ground that the system should allow for “sequential” supplementary searches, whereby the applicant could request an Authority to perform a search which took into account, at least to some extent, the results of the main international search which would already have been established. However, some delegations considered that sequential searches should be the only option permitted, whereas others considered that Authorities should have the option of offering “concurrent” supplementary searches to be performed before the main international search had been established, as an alternative to or in addition to sequential searches.

“44. In favor of sequential supplementary searches, some delegations suggested that these involved less complicated processes than concurrent searches and minimized the duplication of work in processing requests for them and in performing the searches. Furthermore, the fact that the main international search could be taken into account could promote work sharing and reduce the risk of conflicting reports on novelty, inventive step and unity of invention. The fact that the applicant would be able to see the main international search report before requesting a supplementary search would mean that supplementary searches would not be requested when the main international search report showed the claims to lack novelty or inventive step. It would be possible to focus the search on overcoming possible deficiencies in the main international search rather than repeating a search of material that had already been adequately considered. It was hoped that this might reduce the cost of supplementary searches compared to a more complete search. The knowledge of the prior art listed in the main international search report would minimize the risk that both the main and the supplementary search reports would list documents as category “A” (documents defining the general state of the art which are not considered to be of particular relevance) whereas if viewed together they might be seen to be category “Y” documents (documents relevant to inventive step when combined with one or more other such documents). While the relevance of the category “A” documents might later be discovered by large Offices conducting a thorough examination, this might well be missed by small and medium-sized Offices which relied more heavily on the international search reports.

“45. The main disadvantages of sequential searches were felt to be the reduced amount of time available to Authorities for establishing the supplementary search report compared to concurrent searches, and the risk that supplementary search reports might only be available very late indeed if, as was frequently the case at the present, the main international search report itself was delayed.

“46. In favor of concurrent supplementary searches, it was argued that the time pressures on Authorities would be significantly less than in sequential searches, potentially permitting more Authorities to participate if concurrent searches were an option. Furthermore, the supplementary search report would be available in time to be taken into account in deciding whether or not to make a demand for international preliminary examination. With respect to concerns about conflicts between reports from Authorities, it was observed that such conflicts would occur in any case during the national phase, and that it was better for the applicant to be aware of potential difficulties and alternative viewpoints at an earlier stage before the costs of national phase entry had been incurred. Furthermore, since it was only proposed that a system of concurrent searches be introduced as part of a system which also permitted sequential searches, it would provide additional options to applicants, who could tailor their choices to their particular application strategy.

“47. With respect to the patent claims for which supplementary international searches could be requested, one delegation suggested that it might be desirable if the Authority performing a supplementary search could provide a full search of claims which had not been searched by the main Authority, for example because the subject matter was excluded by the main Authority but not by the supplementary Authority.

“48. A number of representatives of users urged the introduction of a system of supplementary international searches as soon as possible. Applicants had different needs and there were different views on what would be the ideal system. Sometimes applicants wanted as much information as possible as soon as possible. In other cases, additional searches would only be requested where a particular need was seen. Nevertheless, it was stated that the greatest costs and duplications occurred when new prior art was discovered in the national phase, resulting in multiple examinations raising unexpected objections. It was not seen as a duplication of work to request a search from a second Authority during the international phase if a corresponding search would in any case be carried out during the national phase, when the results would be of less benefit to the applicant. How matters of unity of invention were dealt with in respect of supplementary searches was seen by users as less of a concern. It was suggested that applicants might be permitted to request the targeting of particular supplementary searches towards particular matters, for example, on documents in a specified language. It was also suggested that Authorities performing supplementary searches might all be made aware of all the supplementary searches which had been requested, so that a collaborative search might be effected. Greater benefits were also seen for third parties if prior art was identified in the international phase.

“49. The Working Group agreed that the proposals relating to supplementary international searches be further developed and invited the Secretariat to prepare revised proposals for consideration at its next session, taking into account the discussion at the present session and particularly the comments and suggestions set out in the following paragraphs, as well as any further factors which may come to its attention in the meantime. Delegations and representatives were invited to make further observations and suggestions via the PCT reform electronic forum.

“50. In response to a question from a delegation, the Secretariat stated that, as presently drafted, the proposals would not allow applicants an additional opportunity to file amendments to the claims under Article 19 following the establishment of a supplementary international search report.

“51. One delegation emphasized the importance of making information concerning any supplementary searches easily available, including through the PatentScope website and on the International Application Status Form (Form PCT/IB/399).

“Detailed Comments and Suggestions

“– *Annex I of Document PCT/R/WG/8/4*

“52. The International Bureau indicated a number of minor changes that should be made to the proposals, including:

- (a) clarification in *Rule 45bis.5* of the result of a request for supplementary search being made outside of the permitted time or not indicating a participating Authority;
- (b) provision in *Rule 45bis.5(d)* for the case where the applicant did not provide sufficient supplementary search fees for the number of Authorities from which supplementary search had been requested, in addition to the case of insufficient additional supplementary search fees in cases of lack of unity of invention;
- (c) provision in *Rule 45bis.6* for the case where some, but not all, of the claims were excluded from supplementary search by a limitation made under *Rule 45bis.11(b)*;
- (d) the drafting in *Rule 45bis.10(b)* regarding how the supplementary international search report would be treated compared to a normal international search report.

“53. A number of delegations observed that the proposed *time limits for requesting and performing sequential supplementary searches* were based on the assumption that the main international search report would be established within, or at least close to the time limit set out in Rule 42, which was frequently not the case. Other delegations and representatives of users stated their hope that the large proportion of late international searches would be a temporary situation and considered that it was undesirable to complicate the proposal in response, though the latest statistics clearly indicated that the incidence of late international search reports had in some cases been rising in recent years, rather than declining. One delegation considered that the proposed time limits seemed a fair balance in any case since Rule 42 allowed (in most cases) three months for the establishment of a complete international search report, so this ought to be sufficient for a supplementary search which might be of reduced scope.

“54. Several representatives of users reiterated that, usually, the most important issue would be to receive the supplementary international search report in time to make decisions relating to entry into the national phase, for example, by around 26 months from the priority date. It was less important to receive the information before the time limit for demanding international preliminary examination. As a result, a number of delegations considered that it might be appropriate to review the proposed time limit for establishing a supplementary international search, which could be as late as 28 months from the priority date. A representative of users also suggested that if Authorities were not capable of providing a supplementary search report within a time limit useful to applicants, the service would simply not be requested.

“55. In response to a query from a delegation, the Secretariat confirmed that, under the proposal in Annex I of document PCT/R/WG/8/4 (and similarly for sequential searches under the proposal in Annex II), a *protest* before the main International Searching Authority might result in a need for the supplementary Authority to refund fees to the applicant even if it had already started the supplementary search.

“56. One delegation considered that, despite any administrative convenience, it would be strange for an Authority to follow the opinion of another Authority concerning *unity of invention* for the purpose of supplementary search, only to take a different view at a later stage, for example as a designated Office. The delegation considered that each

Authority should be permitted to examine the matter of unity of invention independently and should not be bound by any decision which it would not have made itself.

“57. It was observed that there was a contradiction between *Rules 45bis.5(d)* and *45bis.8(a)* with regard to how it should be decided which inventions should be searched in certain cases.

“58. One delegation considered that a supplementary search report would be more useful if it was not limited as proposed in *Rule 45bis.9(c)* so as to preclude, in most cases, the inclusion of documents which had been cited in the main international search report. It was observed that the supplementary Authority would in any case need to consider the documents cited by the main Authority in order to determine their relevance to inventive step and so it would not be a considerable burden to the examiner to cite the document fully if a further relevant, or even more relevant, passage was found or a different interpretation was given to the document.

“59. One representative of users expressed the hope that *fees* would not be set in such a manner that the cost of supplementary searches would be carried by applicants who did not choose to use the service.

“60. It was observed that several of the observations in paragraphs 52 to 59, above, were also applicable to equivalent provisions in Annex II of document PCT/R/WG/8/4.

“– *Annex II of Document PCT/R/WG/8/4*

“61. Further drafting changes set out in the report of the 13th session of the Meeting of International Authorities under the PCT should also be taken into account (see document PCT/MIA/13/8, paragraph 33(f) to (i)).

“62. One delegation recognized the reasons for which it had been proposed that requests under the proposals in Annex II of document PCT/R/WG/8/4 should be made to the individual supplementary Authorities, but considered that this emphasized the disadvantages of concurrent searches, since it would remove the benefit of the PCT system where, in general, requests and fees for a particular action could be provided by an applicant once, to a single point. To make requests to different Authorities would require more requests to be made, payments to be made in multiple currencies, and the requests to be checked for defects by each Authority, with different times for response. The International Bureau would also need to deal with requests for documents individually from different Authorities instead of preparing all the documents at the same time. As a consequence, a number of delegations considered that it might also be appropriate for requests to be made to the International Bureau in the proposals in Annex II. One delegation suggested that requests for concurrent search could be included in the request and requests for sequential searches be made to the International Bureau, though it was observed that a number of receiving Offices had previously indicated that they would not wish to handle requests for supplementary search.

“63. In relation to *Rule 45bis.8(a)*, two delegations considered that a protest procedure in relation to any assessment of unity of invention by a Supplementary International Searching Authority would be a necessary safeguard, while one considered that it would be unnecessary.

“64. In relation to *Rule 45bis.9(a)*, two delegations were concerned that the same time limit had been proposed for the establishment of concurrent searches as for sequential searches. It was observed that one of the main perceived benefits of concurrent searches was that the supplementary search report could be received quickly, but this provision would permit that advantage to be lost. In order to ensure that applicants obtained this advantage, one delegation proposed that the time limit for establishment of a supplementary international search report be the same as the time limit under Rule 42.1 for establishment of the primary international search report.”

6. Informal discussions since the eighth session of the Working Group have concentrated primarily on the timing of the supplementary search and the use of the results of the earlier main search, with a view to addressing the divergence of opinion outlined in document PCT/R/WG/8/13, paragraphs 35 to 64 (reproduced in paragraph 5, above).

7. The proposals were further discussed at the fourteenth session of the Meeting of International Authorities Under the PCT, at which the Secretariat also informed the Meeting of the results of the informal discussions undertaken by it. The Meeting’s discussion of the proposals (see document PCT/MIA/14/8, paragraphs 42 to 52) is outlined in the following paragraphs:

“Supplementary International Searches

“42. Discussions were based on document PCT/MIA/14/7.

“43. In introducing the matter, the Secretariat informed the Meeting of the results of further informal discussions undertaken with the European Patent Office and the United States Patent and Trademark Office, seeking to address the divergence of opinion outlined in paragraphs 10 and 12 of document PCT/MIA/14/7. Following those discussions, the Secretariat proposed to address some of the issues outlined in those paragraphs as follows:

“(i) *time limit for filing a request for supplementary international search (see document PCT/MIA/14/7, paragraph 12(d))*: applicants should be free to file a request for supplementary search with the International Bureau at any time after the filing of an international application but not later than 19 months from the priority date; any such request should not be forwarded by the International Bureau to the International Searching Authority requested to carry out the supplementary search before the expiration of 17 months from the priority date, unless the main international search report had been received by the International Bureau before the expiration of that time limit; consequently the supplementary search would always be a “sequential” one, allowing it to take into account the main international search report, except in cases where that report was established significantly late;

“(ii) *determination of unity of invention*: the supplementary Authority should be free to make its own determination of unity of invention; should that Authority find non-unity, it should only be required to search the “main” invention, to be identified (similar to today’s Chapter II procedure) by that Authority or the applicant (in cases of doubt, the invention first mentioned in the claims would be considered to be the main invention); applicants should have the opportunity to request a review of any non-unity

finding by the supplementary Authority, for example, by an internal review body of that Authority, but such a finding should not be subject to a full-fledged protest procedure as in the case of the main search;

“(iii) *relationship between supplementary international search and international preliminary examination*: each supplementary Authority should be free to specify in its agreement with the International Bureau that it would not carry out a supplementary search where it had received, in respect of a particular international application, a demand for international preliminary examination; further consideration should be given to the question of whether the filing of a request for supplementary search should more generally be considered a renunciation (“waiver”) by the applicant of the right to file a demand for international preliminary examination with *any* International Preliminary Examining Authority.

“43. As on previous occasions, there remained no consensus among Authorities as to the desirability of introducing a supplementary international search system into the PCT.

“44. The general idea of introducing a supplementary international search system was opposed by two Authorities. The Japan Patent Office noted that the objectives of a supplementary search would be similar to those of a national prior art search conducted by a national Office which also acted as an International Searching Authority, and that no difference could be found between an international search report and a national search report in terms of the functions of those reports as well as their contents. Thus, in its view, no good reason could be found to institutionalize in the PCT system a new type of international search which would go beyond the national search. Rather, if an International Searching Authority wished to conduct an international search beyond the extent of a national search (for example, if it wished to carry out a prior art search in documents which are in a different language than that covered by its national search), it should consider offering such a search as an additional service, and possibly outsource that work if there was a need to bring in language specialization not available within the Authority. Furthermore, the Japan Patent Office expressed its concern that a supplementary search system, with more than one Authority establishing an international search report, would make the individual Authority’s responsibility for the establishment of the international search report unclear, and stated that it preferred a decentralized system under which Authorities would compete with each other to provide better and more user-friendly services. The Office also voiced its concern about the discrimination of specific languages, such as, for example, Japanese, noting that the burden of carrying out searches in documents in such a language would be shifted to the Authority which had such language as its main working language, and stated that it could not accept such a shift. The statement made by the Japan Patent Office is set out in full in Annex II [of document PCT/MIA/14/8].

“45. The Spanish Patent and Trademark Office stated that, in its view, the proposed supplementary search system would be contrary to the philosophy of the PCT system, whose goal was to have a single search of high quality, and would be tantamount to recognizing the insufficiency of the present (main) international search. It expressed its concerns about the complexity added to the system, the duplication of work, and the effect and consequences for applicants and national Offices if the main and the supplementary search reports contained different or even contradictory prior art citations.

“46. IP Australia stated its support in principle for the concept of a single authoritative report and expressed some sympathy for the arguments put forward by those Authorities which opposed the introduction of the new system. However, it stated that it would not oppose the introduction of a supplementary search system, recognizing that such a system could assist in addressing language-related problems of the current international search. With respect to the detail of the proposals, it welcomed the progress towards ensuring that the system used sequential searching as far as practical, but stated that it would also support a time limit of 22 months from the priority date for requesting a supplementary search.

“47. The State Intellectual Property Office of the People’s Republic of China stated that it would not oppose the principle of permitting supplementary searches to be carried out in order to improve the quality of international searches. It emphasized, however, that the primary purpose of the supplementary search should be to overcome the language-related insufficiencies of the main international search. If the supplementary search went beyond this primary purpose, the disadvantages caused by the supplementary search system, such as increasing the complexity of the system, reducing the efficiency of the international search, causing duplication of work and waste of resources, and putting more burden on both Authorities and applicants, etc., would surpass the possible advantages to be obtained from such system. It was for those reasons that it strongly opposed the introduction of a concurrent supplementary search system. Furthermore, the State Intellectual Property Office of the People’s Republic of China reiterated that the main approach to improving the quality of international searches should be to improve the quality of the main search and to rely on utilizing the existing international search mechanism to the largest extent. The International Bureau should thus focus all of its efforts on measures to achieve this goal, such as establishing stricter and clearer standards and rules for international search, and encouraging all Authorities to communicate more frequently and efficiently on how to improve the quality of the main search, rather than pinning its hopes on a system of supplementary searches. It expressed the view that, in any case, the proposed supplementary search system should and could only be a supplementary means and should in no case materially change the existing international search system.

“48. Eight Authorities supported the proposals for a supplementary international search system, reiterating the strong desire of users for the introduction of such a system, and noting the aim of improving the basis on which applicants could make the decision whether to proceed with the application into the national phase such system and the aim of avoiding new and surprising citations of prior art in the national phase. While the Authorities were not in a position to express views on the specifics of the new proposals, they welcomed the progress made towards reaching agreement noted in paragraph 43, above.

“49. Some of those Authorities emphasized that the system was intended to be used only where the applicant saw a specific need. It was likely that applicants would only request a supplementary search from an Authority in cases where there was a strong intention to enter the national phase in the country whose Office acted as that Authority. If an Authority carried out a search in the international phase which in any case would have been done by the same Office in the national phase, work was simply being brought forward in time. Furthermore, the fact that this work was done in the international phase might save much work by other designated Offices in the national phase.

“50. The European Patent Office further stated that it did not consider that the proposals for a supplementary search system reduced the scope for introducing competition between International Searching Authorities. In addition, the supplementary search proposal had no bearing on the question of outsourcing of work if an Authority felt that this was a good method of addressing language issues, but rather provided an alternative route for addressing a real current problem.

“51. The Federal Service for Intellectual Property of the Russian Federation expressed concern at the idea that perceived language deficiencies should be addressed by outsourcing part of the search. While this might be an option for some Authorities, issues of confidentiality were involved and in some States the Office might be the only body competent to act in matters of search.

“52. The Meeting noted the intention of the Secretariat to post draft proposed amendments of the Regulations relating to supplementary international searches on the PCT/MIA electronic forum for comments by Authorities, and to subsequently submit those proposals, taking into account any comments received, to the Working Group on Reform of the PCT for consideration at its ninth session, to be held in April 2007.”

8. Revised proposals for amendment of the Regulations relating to a system of supplementary international searches, taking into account the suggestions made at the eighth session of the Working Group (see document PCT/R/WG/8/13, paragraphs 35 to 64, reproduced in paragraph 5, above), the results of the informal discussions undertaken by the Secretariat referred to in paragraph 7, above, the discussions at the fourteenth session of the PCT/MIA (see document PCT/MIA/14/8, paragraphs 42 to 52, reproduced in paragraph 7, above), and comments received on preliminary draft amendments of the Regulations relating to supplementary international searches posted on the PCT/MIA electronic forum for comments by Authorities (see document PCT/MIA/14/8, paragraph 52, reproduced in paragraph 7, above), have been prepared by the Secretariat accordingly. The further revised proposals are contained in the Annex to this document.

PROPOSALS FOR AMENDMENT OF THE REGULATIONS

9. The main features of the proposed supplementary search system are as follows:

(a) International Searching Authorities would be free to decide whether to provide a supplementary search service and, if so, under what conditions, to be set out in the Agreement under Article 16(3) between the International Bureau and the Authority concerned. In that Agreement, each Authority would be able to limit the availability of such supplementary international searches to particular fields of technology, for example to exclude fields for which an Authority may not have sufficient capacity at the time, or where an Authority wished to specialize in fields of technology in which it has a particular expertise.

(b) In the Agreement, each International Searching Authority would also be free to specify that it would not carry out a supplementary search where the Authority, in its capacity as International Preliminary Examining Authority, had received, in respect of the international application concerned, a demand for international preliminary examination or, at the option of the Authority, where such demand had been received by any other competent International Preliminary Examining Authority. Furthermore, in the Agreement, each Authority in its capacity as International Preliminary Examining Authority would also be free to specify that

it would not carry out international preliminary examination where the Authority itself, in its capacity as an International Searching Authority, had been requested to carry out a supplementary search in respect of the international application concerned, or, at the option of the Authority, where any other competent International Searching Authority had been requested to carry out such supplementary search.

(c) Applicants would be free to request supplementary searches from all, some, or none of the Authorities which offer supplementary searches, other than the main Authority for their application.

(d) Requests for supplementary international search would have to be submitted to the International Bureau prior to the expiration of 19 months from the priority date, highlighting the “sequential” and “supplementary” nature of the system, noting that, in the majority of cases, the main search report by the main Authority is available before 19 months from the priority date and thus before the supplementary search by the supplementary Authority commences.

(e) A supplementary search fee (for the benefit of the supplementary Authority) and a supplementary search handling fee (for the benefit of the International Bureau) would have to be paid within one month from the date of receipt by the International Bureau of the request for supplementary search. Applicants would be required to pay a late payment fee where the supplementary search handling fee and the supplementary search fee are not paid within the one-month time limit.

(f) The International Bureau would transmit a supplementary search copy of the international application and any other required documents to each supplementary Authority, including, in particular, a copy of the main search report and of the written opinion established by the main Authority, once these have been transmitted to the International Bureau. The request and those documents would be transmitted to the supplementary Authority not before the expiration of 17 months from the priority date, unless the main international search report had been received by the International Bureau before the expiration of that time limit. Consequently, the supplementary search would, in the vast majority of cases, be a “sequential” one, allowing it to take into account the main international search report, except in cases where that report was established significantly late.

(g) Supplementary search would start once the supplementary Authority is in possession of a copy of each of the following: the request for supplementary search, the international application and any required translation thereof, and any required sequence listing in electronic form. At the option of the Authority requested to carry out the supplementary search, the Authority could also decide not to commence with the supplementary search before the receipt of the main search report or the expiration of 22 months from the priority date, whichever occurred first, again highlighting the “sequential” and “supplementary” nature of the system.

(h) Supplementary search would be carried out on the basis of the international application as filed (or of a translation thereof), taking due account of the main search report and the written opinion established by the main Authority under Rule 43*bis*.1, if transmitted to the supplementary Authority before it starts the supplementary search. Any supplementary Authority would be free to exclude from the supplementary search any claims which were not the subject of the international search report where the international search report is available to the Authority before it starts the supplementary search.

(i) The Authority requested to carry out supplementary search would be free to make its own determination of unity of invention. Should that Authority find non-unity, it would only be required to search the “main” invention, to be identified (similar to today’s Chapter II procedure) by the applicant or, where the applicant failed to do so, by the Authority (in cases of doubt, the invention first mentioned in the claims would be considered to be the main invention for the purposes of supplementary search). Applicants would have the opportunity to request a review of any non-unity finding by the supplementary Authority but such a finding would not be subject to a full-fledged protest procedure as in the case of the main search.

(j) Each supplementary Authority would issue a supplementary international search report. While no written opinion would be established under the supplementary search system, the supplementary international search report could contain explanations with regard to the citations of the documents considered to be relevant, bearing in mind that many citations would be in languages not well understood by the applicant and many designated Offices.

(k) The supplementary international search report would take the same form as a normal international search report, except that it would not require the Authority to reconsider and list the classification. It is proposed to not limit re-citation of documents which appear in the main search report limited to the case where the re-citation is necessary for the indication of inventive step issues in relation to the combination of that document with newly found citations but rather to leave it to the discretion for the examiner to include further information which he considers to be relevant in respect of a citation which he considers may have greater relevance than would be realized from the main international search report.

(l) The supplementary search report would be established in the language of publication of the international application or in the language of any translation on which the search was based, at the choice of the Authority. Supplementary search reports would be made available electronically to the public as soon as possible after they are received by the International Bureau (provided that the international application has been published) in such a manner that they can be viewed by any person seeking access to the main search report. Furthermore, each supplementary search report would automatically be communicated to designated and elected Offices whenever the main search report is requested by such Office.

(m) Translations of supplementary international search reports into English would, as for the main international search report, be prepared by the International Bureau where the report was not established in that language.

10. The Working Group is invited to consider the proposals contained in the Annex.

[Annex follows]

ANNEX

DRAFT AMENDMENTS OF THE PCT REGULATIONS:²

SUPPLEMENTARY INTERNATIONAL SEARCHES

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² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 45bis

Supplementary International Searches

45bis.1 Supplementary Search Request

(a) The applicant may, at any time prior to the expiration of 19 months from the priority date, request that a supplementary international search be carried out in respect of the international application by an International Searching Authority that is competent to do so under Rule 45bis.9. Such requests may be made in respect of more than one such Authority.

(b) A request under paragraph (a) (“supplementary search request”) shall be submitted to the International Bureau and shall indicate:

(i) the name and address of the applicant and of the agent (if any), the title of the invention, the international filing date and the international application number;

(ii) the International Searching Authority that is requested to carry out the supplementary international search (“Authority specified for supplementary search”); and

(iii) where the international application was filed in a language which is not accepted by that Authority, whether any translation furnished to the receiving Office under Rule 12.3 or 12.4 is to form the basis of the supplementary international search.

[Rule 45bis.1, continued]

(c) The supplementary search request shall, where applicable, be accompanied by:

(i) where neither the language in which the international application was filed nor that in which a translation (if any) has been furnished under Rule 12.3 or 12.4 is accepted by the Authority specified for supplementary search, a translation of the international application into a language which is accepted by that Authority and is a language of publication;

(ii) a copy of a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions, if required, under the provisions of Rule 13ter.1(a) as applicable by virtue of Rule 45bis.5(c), by the Authority specified for supplementary search.

(d) The supplementary search request may contain an indication of what the applicant would identify as the main invention as referred to in Rule 45bis.6(d) in the event that the Authority specified for supplementary search later makes a finding of lack of unity of invention under Rule 45bis.6(a).

(e) The supplementary search request shall be considered not to have been submitted, and the International Bureau shall so declare:

(i) if it is received after the expiration of the time limit referred to in paragraph (a); or

(ii) if the International Searching Authority requested to carry out the supplementary international search has not stated, in the applicable agreement under Article 16(3)(b), its preparedness to carry out such searches or is not competent to do so under Rule 45bis.9(b).

45bis.2 Supplementary Search Handling Fee

(a) The supplementary search request shall be subject to the payment of a fee for the benefit of the International Bureau (“supplementary search handling fee”) as set out in the Schedule of Fees.

(b) The supplementary search handling fee shall be paid in the currency in which the fee is set in the Schedule of Fees or in any other currency prescribed by the International Bureau. The amount in such other currency shall be the equivalent, in round figures, as established by the International Bureau, of the amount as set in the Schedule of Fees, and shall be published in the Gazette.

(c) The supplementary search handling fee shall be paid to the International Bureau within one month from the date of receipt of the supplementary search request. The amount payable shall be the amount applicable on the date of payment.

(d) The International Bureau shall refund the supplementary search handling fee to the applicant if, before the documents referred to in Rule 45bis.4(d)(i) to (iv) are transmitted to the Authority specified for supplementary search, the supplementary search request is withdrawn or considered not to have been submitted.

45bis.3 Supplementary Search Fee

(a) Each International Searching Authority carrying out supplementary international searches may require that the applicant pay a fee (“supplementary search fee”) for its own benefit for carrying out such a search.

(b) The supplementary search fee shall be collected by the International Bureau.
Rules 16.1(b) to (e) shall apply *mutatis mutandis*.

(c) As to the time limit for payment of the supplementary search fee and the amount payable, the provisions of Rule 45bis.2(c) shall apply *mutatis mutandis*.

(d) The International Bureau shall refund the supplementary search fee to the applicant if, before the documents referred to in Rule 45bis.4(d)(i) to (iv) are transmitted to the Authority specified for supplementary search, the supplementary search request is withdrawn or considered not to have been submitted.

(e) The Authority specified for supplementary search shall, to the extent and under the conditions provided for in the applicable agreement under Article 16(3)(b), refund the supplementary search fee if, after the documents referred to in Rule 45bis.4(d)(i) to (iv) have been transmitted to that Authority, the supplementary search request is considered not to have been submitted.

45bis.4 Checking of Supplementary Search Request; Correction of Defects; Late Payment of Fees; Transmittal to International Searching Authority

(a) Promptly after receipt of a supplementary search request, the International Bureau shall check whether it complies with the requirements of Rule 45bis.1(b) and (c) and shall invite the applicant to correct any defects within a time limit of one month from the date of the invitation.

(b) Where, by the time they are due under Rules 45bis.2(c) and 45bis.3(c), the International Bureau finds that the supplementary search handling fee and the supplementary search fee have not been paid in full, it shall invite the applicant to pay to it the amount required to cover those fees, together with the late payment fee under paragraph (c), within a time limit of one month from the date of the invitation.

(c) The payment of fees in response to an invitation under paragraph (b) shall be subject to the payment to the International Bureau, for its own benefit, of a late payment fee whose amount shall be 50% of the supplementary search handling fee.

(d) If the applicant does not furnish the required correction or does not pay the amount in full of the fees due, including the late payment fee, before the expiration of the time limit applicable under paragraph (a) or (b), respectively, the supplementary search request shall be considered not to have been submitted and the International Bureau shall so declare and shall inform the applicant accordingly.

[Rule 45bis.4, continued]

(e) On finding that the requirements of Rule 45bis.1(b) and (c), 45bis.2(c) and 45bis.3(c) have been complied with, the International Bureau shall promptly, but not before the date of receipt by it of the international search report or the expiration of 17 months from the priority date, whichever occurs first, transmit to the Authority specified for supplementary search a copy of each of the following:

(i) the supplementary search request;

(ii) the international application;

(iii) any sequence listing furnished under Rule 45bis.1(d)(ii); and

(iv) any translation furnished under Rule 12.3, 12.4 or 45bis.1(c)(i) which is to be used as the basis of the supplementary international search;

and, at the same time, or promptly after their later receipt by the International Bureau:

(v) the international search report and the written opinion established under Rule 43bis.1;

(vi) any invitation by the International Searching Authority to pay additional fees referred to in Article 17(3)(a); and

(vii) the decision on any protest by the applicant under Rule 40.2(c).

45bis.5 Start, Basis and Scope of Supplementary International Search

(a) The Authority specified for supplementary search shall start the supplementary international search promptly after receipt of the documents specified in Rule 45bis.4(e)(i) to (iv), provided that the Authority may, at its option, delay the start of the search until it has also received the documents specified in Rule 45bis.4(e)(v) or until the expiration of 22 months from the priority date, whichever occurs first.

(b) The supplementary international search shall be carried out on the basis of the international application as filed or of a translation referred to in Rule 45bis.1(b)(iii) or 45bis.1(c)(i), [taking due account of] [giving full consideration to] the international search report and the written opinion established under Rule 43bis.1 where they are available to the Authority specified for supplementary search before it starts the search.

(c) For the purposes of the supplementary international search, Article 17(2) and Rules 13ter.1, 33 and 39 shall apply *mutatis mutandis*.

(d) Where the international search report is available to the Authority specified for supplementary search before it starts the search under paragraph (a), that Authority may exclude from the supplementary search any claims which were not the subject of the international search report.

(e) The supplementary international search shall cover at least the documentation indicated for this purpose in the applicable agreement under Article 16(3)(b).

[Rule 45bis.5, continued]

(f) If the Authority specified for supplementary search finds that carrying out the search is excluded by a limitation or condition referred to in Rule 45bis.9(a), the supplementary search request shall be considered not to have been submitted, and the Authority shall so declare and shall promptly notify the applicant and the International Bureau accordingly.

45bis.6 Unity of Invention

(a) If the Authority specified for supplementary search finds that the international application does not comply with the requirement of unity of invention, it shall notify the applicant of its opinion and:

(i) specify the reasons for that opinion;

(ii) identify which invention the Authority considers to be the main invention as referred to in Rule 45bis.6(d), having due regard to any indication by the applicant under Rule 45bis.1(d), and giving the applicant an opportunity to identify, within the time limit referred to in paragraph (c), a different invention as the main invention; and

(iii) inform the applicant of the possibility of requesting, within the time limit referred to in paragraph (c), a review of the opinion.

(b) In considering whether the international application complies with the requirement of unity of invention, the Authority shall take due account of any documents received by it under Rule 45bis.4(e)(vi) and (vii) before it starts the supplementary international search.

(c) The applicant may, within one month from the date of the notification under paragraph (a):

(i) identify a different invention as the main invention as referred to in Rule 45bis.6(d);

[Rule 45bis.6(c), continued]

(ii) request the Authority to review the opinion referred to in paragraph (a); the request for review may be subjected by the Authority to the payment to it, for its own benefit, of a review fee whose amount shall be fixed by it.

(d) Subject to any review under paragraph (e) and Rule 45bis.5(d), the Authority shall establish the supplementary international search report on those parts of the international application which relate to the main invention as identified by the applicant or, in the absence of such identification, by the Authority, and shall indicate the relevant facts in the report. In case of doubt as to which invention is the main invention for the purposes of this paragraph, the invention first mentioned in the claims shall be considered the main invention.

(e) If the applicant, within the time limit under paragraph (c), requests a review of the opinion by the Authority and pays any required review fee, the opinion shall be reviewed by the Authority. Where the Authority:

(i) finds that the opinion was entirely justified, or finds that the opinion was partially unjustified but still considers that the international application does not comply with the requirement of unity of invention, it shall notify the applicant accordingly and proceed as provided for in paragraph (c);

(ii) finds that the opinion was entirely unjustified, it shall notify the applicant accordingly, establish the supplementary international search report on all parts of the international application and refund the review fee to the applicant.

[Rule 45bis.6, continued]

(f) On the request of the applicant, the text of both the request for review and the decision thereon shall be communicated to the designated Offices together with the supplementary international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under Article 22.

45bis.7 Supplementary International Search Report

(a) The Authority specified for supplementary search shall, within 28 months from the priority date, establish the supplementary international search report or make a declaration under the provisions of Article 17(2) and Rule 39 as applicable by virtue of Rule 45bis.5(c) that no supplementary international search report will be established.

(b) For the purposes of establishing the supplementary international search report, Rules 43.1, 43.2, 43.4 to 43.6, 43.8 and 43.10 shall, subject to paragraphs (c) and (d), apply *mutatis mutandis*. Rule 43.9 shall *mutatis mutandis*, except that the references therein to Rules 43.3, 43.7 and 44.2 shall be considered non-existent. Article 20(3) and Rule 44.3 shall apply *mutatis mutandis*.

(c) The supplementary international search report need not contain the citation of any document cited in the international search report, except where the document needs to be cited in conjunction with other documents that were not cited in the international search report.

(d) The supplementary international search report may contain explanations with regard to the citations of the documents considered to be relevant.

45bis.8 Transmittal and Effect of the Supplementary International Search Report

(a) The Authority specified for supplementary search shall, on the same day, transmit one copy of the supplementary international search report or the declaration that no supplementary international search report shall be established, as applicable, to the International Bureau and one copy to the applicant.

(b) Subject to paragraph (c), Article 20(1) and Rules 45.1, 47.1(d) and 70.7(a) shall apply as if the supplementary international search report were part of the international search report.

(c) A supplementary international search report need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if it is received by that Authority after it has begun to draw up that opinion or report.

45bis.9 International Searching Authorities Competent to Carry Out Supplementary

International Search

(a) An International Searching Authority shall be competent to carry out supplementary international searches if its preparedness to do so is stated in the applicable agreement under Article 16(3)(b), subject to any limitations and conditions set out in that agreement.

(b) The International Searching Authority carrying out the international search under Article 16(1) in respect of an international application shall not be competent to carry out a supplementary international search in respect of that application.

(c) The limitations referred to in paragraph (a) may, in particular, include limitations as to the subject matter for which supplementary international searches will be carried out, beyond those which would apply under Article 17(2) to the international search, and limitations as to the total number of supplementary international searches which will be carried out in a given period.

SCHEDULE OF FEES

Fees	Amounts
1. International filing fee: (Rule 15.2)	1,400 Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets
2. Handling fee: (Rule 57.2)	200 Swiss francs
3. Supplementary search handling fee: (Rule 45bis.2)	200 Swiss francs

Reductions

~~4.3.~~ The international filing fee is reduced by the following amount if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed:

- (a) on paper together with a copy thereof in electronic form: 100 Swiss francs
- (b) in electronic form where the text of the description, claims and abstract is not in character coded format: 200 Swiss francs
- (c) in electronic form where the text of the description, claims and abstract is in character coded format: 300 Swiss francs

~~5.4.~~ The international filing fee (where applicable, as reduced under item ~~4.3~~) and the handling fee are reduced by 75% if the international application is filed by:

- (a) an applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); or
- (b) an applicant, whether a natural person or not, who is a national of and resides in a State that is classed as a least developed country by the United Nations;

provided that, if there are several applicants, each must satisfy the criteria set out in either sub-item (a) or (b).

[End of Annex and of document]