

# WIPO



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OF THE PATENT COOPERATION TREATY (PCT)

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INTERNATIONAL SEARCH:  
USE OF RESULTS OF EARLIER SEARCH BY OFFICE OTHER THAN OFFICE  
ACTING AS INTERNATIONAL SEARCHING AUTHORITY

*Document prepared by the Secretariat*

## SUMMARY

1. This document contains proposals for amendment of the PCT Regulations<sup>1</sup> to permit the applicant to request the International Searching Authority to take into account, in carrying out the international search, not only, as at present, the results of an earlier search carried out by that Authority but also the results of an earlier search carried out by another International Searching Authority or any national Office.

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<sup>1</sup> 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”, “national Offices”, etc., include reference to regional laws, regional applications, regional Offices, etc.

## BACKGROUND

2. At present, Rule 4.11 permits the applicant to request the International Searching Authority to base the international search report wholly or in part on the results of an earlier international or international-type search, or else on a search of another form (usually a national search) which had been carried out by the national Office or intergovernmental organization which is the International Searching Authority competent for the international application concerned, in which case the applicant may be eligible for a reduction in the international search fee under the conditions laid out in Rules 16.3 (earlier international search) and 41.1 (earlier international-type or national search). The making of such a request is provided for in Box No. VII of the Request Form PCT/RO/101 (extract below).

*Extract from Form PCT/RO/101 (Request)*

<b>Box No. VII INTERNATIONAL SEARCHING AUTHORITY</b>		
<b>Choice of International Searching Authority (ISA)</b> <i>(if two or more International Searching Authorities are competent to carry out the international search, indicate the Authority chosen; the two-letter code may be used):</i>		
ISA / .....		
<b>Request to use results of earlier search; reference to that search</b> <i>(if an earlier search has been carried out by or requested from the International Searching Authority):</i>		
Date <i>(day/month/year)</i>	Number	Country <i>(or regional Office)</i>

3. In 2005, of the approximately 127,000 international applications that were the subject of international search, more than 50,000 claimed the priority of an earlier application filed with a national Office different from the International Searching Authority that was to undertake the international search. In many of these cases, a national search would be undertaken on the earlier application, and the applicant may even have received the search report before filing the international application. However, at present, the Regulations do not provide for the applicant to request the International Searching Authority to take into account an earlier search performed by an Office other than that which is acting as the International Searching Authority in respect of the international application concerned.

4. As indicated in paragraphs 26 and 27 of document PCT/A/35/5, noted by the PCT Union Assembly at its last session in September/October 2006, it may be desirable to amend the Regulations so as to permit the applicant to request the International Searching Authority to take into account, in carrying out the international search, not only, as at present, the results of an earlier search carried out by the same Office which is acting as the International Searching Authority but also the results of an earlier search carried out by another International Searching Authority or by any national Office.

5. A proposal to amend the Regulations accordingly was discussed at the 14th session of the Meeting of International Authorities Under the PCT (PCT/MIA). The Meeting's discussion of the proposal (see document PCT/MIA/14/8, paragraphs 37 to 41) is outlined in the following paragraphs:

*“International Search: Use of Results of Earlier National Search*

“37. Discussions were based on document PCT/MIA/14/5.

“38. One Authority opposed the proposal to amend the PCT Regulations to permit applicants to request that the international search report be based on one or more searches performed by an Office other than the International Searching Authority that is to undertake the international search. The Authority noted the lack of a quality control system for search reports established by national Offices other than those which act as International Searching Authorities and, consequential thereto, the difficulties in establishing the appropriate fee reductions to be granted to applicants. It also suggested that, should the proposals proceed, provisions should be included to require the applicant to provide a translation of any earlier search report into a language accepted by the International Searching Authority that is to undertake the international search.

“39. All other Authorities which took the floor on this matter supported the proposal, provided that the proposed amendments to the Regulations to be submitted to the Working Group on Reform of the PCT left it to each Authority to decide, if so requested by the applicant, whether and to which extent to use the results of any earlier search, and whether and to which extent to refund the international search fee to the applicant. The Chair stated that the proposal would distinguish between earlier searches by the same Authority and earlier searches by another Office.

“40. As to the timing of a request by the applicant that the international search be based on the results of an earlier national search, one Authority expressed the view that such request should be made upon filing of the application. As to whether it should be a requirement that such request could be made only in respect of the results of earlier searches on applications the priority of which is claimed in the international application, one Authority expressed the view that it would be sufficient to require that the earlier search was carried out in respect of a “corresponding” application.

“41. The Meeting noted the intention of the Secretariat to post draft proposed amendments of the Regulations relating to the use of the results of earlier national 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.”

6. As indicated in paragraph 41 of document PCT/MIA/14/8, reproduced in paragraph 5, above, the Secretariat posted draft proposed amendments of the Regulations relating to the use of the results of earlier national searches on the PCT/MIA electronic forum for comments by Authorities. The Annex to the present document contains further revised proposals, taking into account comments received. Explanations are set out in the Annex in comments relating to the provisions concerned.

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

[Annex follows]

## ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:<sup>2</sup>INTERNATIONAL SEARCH:  
USE OF RESULTS OF EARLIER SEARCH BY OFFICE OTHER THAN OFFICE  
ACTING AS INTERNATIONAL SEARCHING AUTHORITY

## TABLE OF CONTENTS

Rule 4	The Request (Contents) .....	2
4.1	<i>Mandatory and Optional Contents; Signature</i> .....	2
4.2 to 4.10	[No change] .....	2
4.11	<i>Reference to <del>Earlier Search</del>, Continuation or Continuation-in-Part, or Parent Application or Grant</i> .....	3
4.12	<u><i>Request to Take Results of Earlier Search into Account</i></u> <del>Deleted</del> .....	4
4.13 and 4.14	[Remain deleted] .....	4
4.14bis to 4.18	[No change] .....	4
Rule 12bis	<u>Copy of Results of Earlier Search and of Earlier Application; Translation</u> .....	5
12bis.1	<u>Copy of Results of Earlier Search and of Earlier Application; Translation</u> .....	5
Rule 16	The Search Fee .....	7
16.1 and 16.2	[No change] .....	7
16.3	<i>Partial Refund</i> .....	7
Rule 41	<u>Taking into Account of Results of</u> Earlier Search <del>Other than International Search</del> ..	8
41.1	<del>Obligation to Use</del> <u>Taking into Account of Results of Earlier Search</u> ; <del>Refund of Fee</del> ..	8

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<sup>2</sup> 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 4

### The Request (Contents)

#### 4.1 *Mandatory and Optional Contents; Signature*

(a) [No change]

(b) The request shall, where applicable, contain:

(i) [No change]

(ii) indications as provided in Rules 4.12 and 12bis.1 relating to an ~~a reference to~~  
~~any~~ earlier international, international-type or other search,

[COMMENT: It is proposed to amend Rule 4.1(b)(ii) to provide for the inclusion in the request form of indications concerning a request to the International Searching Authority to take into account the results of an earlier search (see Rule 4.12 as proposed to be amended, below) and any request to the receiving Office to obtain a copy of the results of the earlier search and of the earlier application (see proposed new Rule 12bis.1(b), below), and any indication that such copies are available from a digital library (see Rule 12bis.1(d), below).]

(iii) and (iv) [No change]

(c) and (d) [No change]

4.2 to 4.10 [No change]

4.11 Reference to ~~Earlier Search~~, Continuation or Continuation-in-Part, or Parent Application or Grant

(a) If:

~~(i) [Deleted] an international or international-type search has been requested on an application under Article 15(5);~~

~~(ii) [Deleted] the applicant wishes the International Searching Authority to base the international search report wholly or in part on the results of a search, other than an international, or international-type search, made by the national Office or intergovernmental organization which is the International Searching Authority competent for the international application;~~

(i) ~~(iii)~~ the applicant intends to make an indication under Rule 49*bis*.1(a) or (b) of the wish that the international application be treated, in any designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition; or

(ii) ~~(iv)~~ the applicant intends to make an indication under Rule 49*bis*.1(d) of the wish that the international application be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application;

the request shall so indicate and shall, ~~as the case may be, identify the application in respect of which the earlier search was made or otherwise identify the search, or~~ indicate the relevant parent application or parent patent or other parent grant.

*[Rule 4.1, continued]*

(b) The inclusion in the request of an indication under paragraph (a)(i) or (ii) ~~(a)(iii)~~  
~~or (iv)~~ shall have no effect on the operation of Rule 4.9.

[COMMENT: It is proposed to amend Rule 4.11 by deleting all references to earlier searches and to instead deal with the request by the applicant to the International Searching Authority to take into account the results of an earlier search in Rule 4.12 as proposed to be amended (see below).]

4.12 Request to Take Results of Earlier Search into Account ~~{Deleted}~~

The applicant may request the International Searching Authority to take into account, in carrying out the international search, the results of an earlier search carried out by the same or another International Searching Authority or by a national Office, in which case the request shall so indicate and shall specify the Authority or Office concerned and the application in respect of which the earlier search was carried out.

[COMMENT: See the Comment on Rule 4.11 as proposed to be amended, above. Under Rule 4.12 as proposed to be amended, applicants would be permitted to request the International Searching Authority to take into account not only, as at present, the results of an earlier search carried out by the same Office which is acting as the International Searching Authority but also the results of an earlier search carried out by another International Searching Authority or by a national Office.]

4.13 and 4.14 *[Remain deleted]*

4.14*bis* to 4.18 [No change]

**Rule 12bis**

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

12bis.1 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, the applicant shall, subject to paragraphs (b) to (d), submit to the receiving Office, together with the international application:

(i) a copy of the results of the earlier search;

(ii) a copy of the earlier application concerned;

[COMMENT: The Working Group may wish to consider whether the applicant should, in all cases, be required to submit a copy of the earlier application, or whether the applicant should be required to submit such copy only upon invitation by the International Searching Authority where that Authority considers such copy necessary to determine the usefulness of the results of the earlier search. The Working Group may also wish to consider whether the applicant should be required to furnish a translation of the earlier application where that application is not in a language accepted by the International Searching Authority.]

(iii) if the language in which the results of the earlier search were established is not accepted by the International Searching Authority, a translation of those results into a language which is accepted by that Authority.

[COMMENT: The Administrative Instructions would have to be modified to require the receiving Office to transmit those copies and any translation to the International Searching Authority together with the search copy.]



*[Rule 12bis.1, continued]*

(b) 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 copies referred to in paragraph (a)(i) and (ii), request the receiving Office to prepare and transmit 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 of a fee.

[COMMENT: The text of paragraph (b) is modeled in part on Rule 17.1(b).]

(c) 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) shall be required to be submitted under paragraph (a).

(d) Where a copy or translation referred to in paragraph (a) is, in accordance with the Administrative Instructions, available to the International Searching Authority from a digital library and the applicant so indicates in the request, that copy or translation shall not be required to be submitted under paragraph (a).

[COMMENT: The Administrative Instructions would have to be modified to set out details concerning access to digital libraries.]

## Rule 16

### The Search Fee

16.1 and 16.2 [No change]

#### 16.3 *Partial Refund*

Where the International Searching Authority takes into account, under Rule 41.1, the results of an earlier search in carrying out the international search, ~~Where the international application claims the priority of an earlier international application which has been the subject of an international search by the same International Searching Authority,~~ that Authority shall refund the search fee paid in connection with the ~~later~~ international application to the extent and under the conditions provided for in the agreement under Article 16(3)(b), ~~if the international search report on the later international application could wholly or partly be based on the results of the international search effected on the earlier international application.~~

[COMMENT: See Rule 41.1 as proposed to be amended, below: on the one hand, where the earlier search has been carried out by the same Office which is acting as the International Searching Authority, the International Searching Authority would be required, as at present, “to the extent possible”, to take the results of that earlier search into account; on the other hand, where the earlier search has been carried out another Office, it would be left to the discretion of the International Searching Authority whether to take into the results of any such earlier search into account. Where the Authority, under Rule 41.1, takes the results of the earlier search into account, the decision whether or not to grant a reduction of the international search fee and, if so, the decision as to the amount of any such reduction, would also be left entirely to the discretion of the International Searching Authority (“... shall, to the extent and under the conditions provided for in the agreement under Article 16(3)(b), refund the search fee ...”).]

**Rule 41**

**Taking into Account of Results of Earlier Search ~~Other than International Search~~**

41.1 ~~Obligation to Use~~ Taking into Account of Results of Earlier Search; ~~Refund of Fee~~

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 12bis.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.

~~If reference has been made in the request, in the form provided for in Rule 4.11, to an international-type search carried out under the conditions set out in Article 15(5) or to a search other than an international or international-type search, the International Searching Authority shall, to the extent possible, use the results of the said search in establishing the international search report on the international application. The International Searching Authority shall refund the search fee, to the extent and under the conditions provided for in~~

*[Rule 41.1, continued]*

~~the agreement under Article 16(3)(b) or in a communication addressed to and published in the Gazette by the International Bureau, if the international search report could wholly or partly be based on the results of the said search.~~

[COMMENT: See the comment on Rule 16.3 as proposed to be amended, above. Under that Rule, it would be left to the discretion of the International Searching Authority whether or not to grant any reduction of the international search fee if it does take an earlier search into account (“... shall, to the extent and under the conditions provided for in the agreement under Article 16(3)(b), refund the search fee ...”).]

[End of Annex and of document]