

Patent Cooperation Treaty (PCT) Working Group

Tenth Session
Geneva, May 8 to 12, 2017

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

Document prepared by the International Bureau

SUMMARY

1. This document proposes to amend a reference in Rule 4.1(b)(ii), consequential to the amendment of Rule 12*bis* adopted by the PCT Assembly in October 2015, and to amend Rule 41.2(b) to correct a reference to a paragraph in Rule 23*bis*.2.

BACKGROUND

2. The PCT Assembly, at its forty-seventh session, held from October 5 to 14, 2015, and at its forty-eighth session, held from October 3 to 11, 2016, adopted, *inter alia*, amendments to the PCT Regulations with regard to the transmittal by the receiving Office of earlier search and/or classification results to the International Searching Authority (see Rules 12*bis*, 23*bis* and 41 in Annex II to document PCT/A/47/9 and Rule 23*bis* in Annex I to document PCT/A/48/5). It further decided that these amendments should enter into force on July 1, 2017, and should apply to any international application whose international filing date is on or after July 1, 2017 (see paragraph 20 of document PCT/A/47/9 and Annex II to document PCT/A/48/5).

3. As part of these amendments, a Rule 41.2 was inserted into the PCT Regulations to set out when the International Searching Authority should take into account the results of an earlier search, other than the case of a request from the applicant to take into account the results of an earlier search under Rule 4.12. It has been brought to the attention of the International Bureau that the reference to Rule 23*bis*.2(b) in Rule 41.2(b), which was intended to refer to the situation where the receiving Office has transmitted, to the International Searching Authority, results of an

earlier search or classification that are available to the receiving Office in a form an manner acceptable to it, for example from a digital library, in fact, refers to an incompatibility provision. This intended reference should be to Rule 23bis.2(c).

4. The International Bureau has also realized that, at the time of amending Rule 12bis, the need for a consequential amendment to Rule 4.1(b)(ii) was overlooked. As part of the amendments adopted by the Assembly at its forty-seventh session in 2015, the indications relating to an earlier search in Rule 12bis.1(c) and (f) were amended to Rule 12bis.1(b) and (d) (see Annex I to document PCT/A/47/4 Rev.). However, a consequential amendment was not made in the reference to these indications in Rule 4.1(b)(ii).

PROPOSAL

5. It is proposed to amend Rule 4.1(b)(ii) to refer to the indications relating to an earlier search in Rule 12bis.1, as amended by the Assembly at its forty-seventh session in 2015 and to enter into force on July 1, 2017. It is also proposed to amend Rule 41.2(b) to correct the reference to Rule 23bis.2(b) to refer instead to Rule 23bis.2(c).

6. The Annex to this document sets out the proposed amendments and also shows the relevant parts of Rule 12bis and 23bis as they come into force on July 1, 2017, for reference. Since the Assembly will only be asked to approve these consequential amendments after the main provisions have already come into force, the Secretariat intends to recommend to the Assembly that these amendments should enter into force on July 1, 2018 and apply to any international application whose international filing date is on or after July 1, 2018.

7. The Working Group is invited to consider the proposed amendments to the Regulations contained in the Annex to this document.

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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¹ 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) a priority claim, or

(ii) indications relating to an earlier search as provided in Rules 4.12(i) and 12bis.1 ~~(e)(b)~~ and ~~(f)(d)~~,

(iii) a reference to a parent application or parent patent,

(iv) an indication of the applicant's choice of competent International Searching Authority.

(c) and (d) [No change]

4.2 to 4.19 [No change]

Rule 12bis

Submission by the Applicant of Documents Relating to Earlier Search

12bis.1 [No change] *Furnishing by the Applicant of Documents Related to Earlier Search in Case of Request under Rule 4.12*

(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), 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) 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 referred to in paragraph (a), indicate the wish that the receiving Office prepare and transmit it 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) 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 referred to in paragraph (a) shall be required to be submitted under that paragraph.

(d) Where a copy referred to in paragraph (a) 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, and the applicant so indicates in the request, no copy shall be required to be submitted under that paragraph.

12bis.2 [No change]

Rule 23bis

Transmittal of Documents Relating to Earlier Search or Classification

23bis.1 [No change]

23bis.2 [No change] *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 Article 30(2)(a) as applicable by virtue of Article 30(3) and paragraphs (b), (d) and (e), transmit to the International Searching Authority, together with the search copy, a copy of the results of any such 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 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, subject to Article 30(2)(a) as applicable by virtue of Article 30(3), 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) Notwithstanding paragraph (a), a receiving Office may notify the International Bureau by April 14, 2016 that it may, on request of the applicant submitted together with the international application, decide not to transmit the results of an earlier search to the International Searching Authority. The International Bureau shall publish any notification under this provision in the Gazette.

[Rule 23bis.2, continued]

(c) At the option of the receiving Office, 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.

(d) Paragraphs (a) and (c) 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 the receiving Office is aware that a copy of the earlier search or classification results is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library.

(e) To the extent that, on October 14, 2015, the transmission of the copies referred to in paragraph (a), 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 as such transmission without the authorization by the applicant continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 14, 2016. The information received shall be promptly published by the International Bureau in the Gazette.

Rule 41

Taking into Account Results of Earlier Search and Classification

41.1 *[No change]*

41.2 *Taking into Account Results of Earlier Search and Classification in Other Cases*

(a) [No change]

(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)~~(c), or where such a copy is available to the International Searching 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]