

## **Patent Cooperation Treaty (PCT) Working Group**

**Fifth Session  
Geneva, May 29 to June 1, 2012**

### **TOP-UP SEARCHING: PROPOSAL TO AMEND THE PCT REGULATIONS**

*Document submitted by the United States of America*

1. Document PCT/WG/5/11 is a proposal by the United Kingdom directed toward (i) incorporating a top-up search into the international preliminary examination procedure; and (ii) offering the option of accelerated processing in the international phase for an additional fee.
2. With regard to top-up searches, the issue was presented at the second session of the PCT Working Group by the International Bureau as part of its PCT Roadmap (PCT/WG/2/3, Annex I). Subsequently, the issue has been discussed at further sessions of the PCT Working Group as well as at past sessions of the Meeting of International Authorities. At each of those sessions, the proposal has received wide support, with some International Authorities indicating that it was already part of their Chapter II processing.
3. In addition to Document PCT/WG/5/11, the issue of top-up searches is also discussed in two other documents before the Working Group: the joint United Kingdom United States proposal, *PCT 20/20* (PCT/WG/5/18), and the European Patent Office document *Proposals for Further Improvement of PCT Services and Products* (PCT/WG/5/20).
4. However, in spite of the widespread interest in, and support for, making top-up searches a mandatory aspect of the Chapter II examination process, a specific proposal to amend the regulations so as to implement such a procedure has never been presented for consideration.

5. Therefore, in support of the United Kingdom's renewed call to require the International Preliminary Examining Authorities to perform a top-up search during Chapter II examination, the Annex to this document sets forth a proposal by the United States to amend PCT Rule 66 to require that top-up searches be performed during Chapter II examination.

6. *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 REGULATIONS<sup>1</sup>

TABLE OF CONTENTS

Rule 66 Procedure before the International Preliminary Examining Authority .....	2
66.1 and 66.1bis [No change].....	2
66.1ter Top-up Searches .....	2
66.2 to 66.8 [No change].....	2

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<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

## Rule 66

### Procedure before the International Preliminary Examining Authority

66.1 and 66.1*bis* [No change]

#### 66.1*ter* Top-up Searches

Prior to the establishment of the Written Opinion of the International Preliminary Examining Authority under Rule 66.2 or the International Preliminary Examination Report under Rule 70, the International Preliminary Examining Authority shall perform a top-up search to identify any additional prior art that may be relevant under Rule 64 which has been published or has become available to the said Authority for search subsequent to the date on which the international search report was established.

66.2 to 66.8 [No change]

[End of Annex and of document]