

Patent Cooperation Treaty (PCT) Working Group

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MANDATORY TOP-UP SEARCHES

Document submitted by the United Kingdom and the United States of America

SUMMARY

1. The present document contains a proposal to amend the PCT Regulations and Administrative Instructions to make top-up searches a mandatory part of the Chapter II examination process.

BACKGROUND

2. The original "Draft Roadmap for the Development of the PCT" (Annex I to document PCT/WG/2/3) included as one of its milestones the proposal that "international preliminary examination includes 'top-up' searches during Chapter II to find 'secret prior art' by July 2011." While this Roadmap milestone received significant support in both the Meeting of International Authorities and the PCT Working Group, to date it still has not been adopted as a mandatory element of the Chapter II process. "Top-up" searches are already performed by many International Authorities and are seen as a useful part of examination in order to provide the most complete international stage work product and to reduce subsequent duplication by national Offices. The adoption of this proposal by all International Authorities would increase the quality and the reusability of the Chapter II work product. As such, it is proposed that "top-up" searches should be made a mandatory part of the Chapter II examination process.

3. The introduction of a mandatory top-up search as part of the international phase to uncover any prior art not available at the time of the international search, particularly "secret" prior art (i.e. patent applications published on or after the priority date of the international application, but having an earlier priority date), would have significant benefits for both Offices and applicants.

4. Bringing such documents to the applicant's attention in the international phase would give the applicant an opportunity to amend the application during the international phase to overcome any new prior art. This would increase the likelihood of the application meeting the requirements for novelty and inventive step before it enters the national phase, and potentially lead to a quicker grant of a patent. It would also reduce work for national Offices and provide cost savings for the applicant in the national phase.

5. Furthermore, the completion of a top-up search in the international phase would increase the quality of the international phase work product by making it more complete. This would make the work product more useful to national Offices, thereby reducing duplication of work by reducing or eliminating the need for further top-up searching in the national phase.

INTRODUCTION OF MANDATORY TOP-UP SEARCHES INTO THE PCT

6. At the fifth session of the PCT Working Group, held in Geneva from May 29 to June 1, 2012, the United Kingdom and the United States of America presented a joint proposal entitled "PCT 20/20", containing twelve proposals for further improvement of the PCT system (document PCT/WG/5/18). The proposals received varying levels of support by the Working Group (see the Summary by the Chair of the fifth session, document PCT/WG/5/21, paragraphs 27 to 29). However, many delegations felt that they could provide only preliminary views on the proposals and noted that more time was needed to carefully study the proposals, to consult with user groups, and to consider the possible impact on respective national laws and practices. Following the discussions, the Delegations of the United Kingdom and of the United States of America agreed to further elaborate on the proposals and to provide more details on how to take the proposals forward, for discussion at the next session of the Working Group.

7. The joint PCT 20/20 proposals included a specific proposal for "mandatory top-up searches". The proposal for mandatory top-up searches has also been the subject of further separate papers from the United Kingdom (PCT/WG/5/11) and the United States of America (PCT/WG/5/11 Add). The European Patent Office (EPO) has also put forward a paper which includes a related proposal for the inclusion of optional top-up searches in Chapter II (PCT/WG/5/20).

8. Taking into account the discussions and the comments received during the fifth session of the Working Group, the United Kingdom and the United States of America prepared revised versions of the original proposals for further improvement of the PCT system. Those revised and expanded proposals were communicated by the International Bureau, by way of a Circular (Circular C. PCT 1364, dated December 20, 2012, Annex I), to Offices of all PCT Contracting States in their capacity as a receiving Office, an International Searching and Preliminary Examining Authority and/or a designated and elected Office under the PCT, to Geneva-based missions and foreign ministries of PCT Contracting States and of States that are invited to attend meetings of the PCT Working Group as observers, as well as to certain organizations that are invited to attend meetings of the PCT Working Group as observers. The Circular invited recipients to review and further comment on those revised proposals and, in particular, to consult with user groups on those proposals and to consider the possible impact of those proposals, if adopted, on respective national laws and practices.

9. The revised and expanded PCT 20/20 proposals contained in Circular C. PCT 1364 included a specific proposal to amend PCT Rule 66 to require the International Preliminary Examining Authority to perform a top-up search to identify any additional prior art that has been published or has become available since the international search report was established.

10. To date, 31 responses to the Circular have been received, including comments from 24 national and regional offices and 7 user groups. These responses confirmed that there was substantial support for this proposal among both Offices and users.

11. Furthermore, the expanded proposals were discussed at the twentieth session of the Meeting of International Authorities under the Patent Cooperation Treaty (PCT/MIA), held in Munich from February 6 to 8, 2013. A summary of those discussions is set forth in paragraphs 52 to 102 of the Annex to Document PCT/WG/6/3 (MIA report). In particular, paragraphs 76-78 of the MIA report confirm that International Authorities agreed that it would frequently be desirable for a top-up search to be completed as part of international preliminary examination.

12. It is noted that there were also some concerns raised in relation to this proposal at the MIA and in the responses to the Circular. Some Offices/users felt that the decision of whether to conduct a top-up search should be at the discretion of the particular International Authority. There were also some concerns about whether fees would increase if a top-up search were introduced, and whether it would lead to increased workloads. Some respondents also commented that the scope of any top-up search should be limited to only cover subject matter already searched under Chapter I.

PROPOSAL

13. Annexes I, II and III of this document contain specific proposals to amend the PCT Regulations, Administrative Instructions and International Search and Preliminary Examination Guidelines to make top-up searches a mandatory part of the Chapter II examination process. The proposals contained in the Annexes, and the additional explanations below, address the concerns of International Authorities as expressed at the MIA, as well as those expressed in the responses to Circular C. PCT 1364.

14. Annex I contains proposed amendments to PCT Rule 66 to require the International Preliminary Examining Authority to perform a top-up search prior to the establishment of the written opinion or the international preliminary examination report to identify any additional prior art that has been published or become available since the international search report was established. The proposed amended Rule includes a provision allowing the International Preliminary Examining Authority to decide not to perform such a top-up search if it considers that it would serve no useful purpose at that stage. This provision provides a level of flexibility to the proposal, and is included to address concerns from some respondents that a top-up search may not be practical in all circumstances. Guidance on situations in which this provision might be utilized by an International Authority may be provided in the PCT International Search and Preliminary Examination (ISPE) Guidelines.

15. The proposed amended Rule in Annex I also includes an additional notice of incompatibility, which is intended to address any concerns that this proposal could not be implemented immediately in light of the national law applied by an International Authority. This provision would provide a significant additional level of flexibility to the proposal.

16. Annex II of this document contains proposed amendments to the Administrative Instructions to prescribe the nature of top-up searches.

17. In relation to concerns that the introduction of mandatory top-up searching could lead to increased fees or workloads, attention is drawn to the fact that some International Authorities already perform top-up searches for international applications undergoing international preliminary examination in order to provide the most complete international stage work product. These Authorities have not encountered particular problems with workloads relating to their completion of top-up searches, and have not found it necessary to introduce specific fee increases for top-up searches. Furthermore, as noted in paragraph 78 of the MIA report discussed above, international preliminary examination is only undertaken by applicants who have a real wish to eliminate defects in their international applications before entering the national phase. The inclusion of a top-up search as part of this process would help to ensure that such defects are eliminated, and would ultimately be likely to reduce the work burden on Offices in the national phase.

18. The inclusion of a notice of incompatibility in the Rules should also help to address any concerns expressed with regard to workload by providing Authorities with the ability to delay modification of their procedures until such time as they feel they could adequately meet demand.

19. *The Working Group is invited consider the proposals contained in the Annexes to this document.*

[Annexes follow]

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 66

Procedure Before the International Preliminary Examining Authority

66.1 and 66.1.bis [No Change]

66.1ter Top-up Searches

(a) Subject to paragraph (b) below, the International Preliminary Examining Authority shall perform a top-up search as prescribed by the Administrative Instructions 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.

(b) If the International Preliminary Examining Authority considers that a top-up search prior to the establishment of the written opinion or the international preliminary examination report would serve no useful purpose, that Authority may decide not to perform a top-up search at that stage.

(c) If, on [...], paragraph (a) is not compatible with the national law applied by the International Preliminary Examining Authority those paragraphs shall not apply in respect of that Authority for as long as they continue not to be compatible with that law, provided that the said Authority informs the International Bureau accordingly by [...]. The information received shall be promptly published by the International Bureau in the Gazette.

[Rule 66, continued]

66.2 and 66.3 [No change]

66.4 Additional opportunity for Submitting Amendments or Arguments

(a) If the International Preliminary Examining Authority wishes to issue one or more additional written opinions, it may do so, and Rules [66.1ter](#), 66.2 and 66.3 shall apply.

(b) [No change]

66.4bis to 66.8 [No change]

[Annex II follows]

PROPOSED AMENDMENTS TO THE ADMINISTRATIVE INSTRUCTIONS²

PART 6

**INSTRUCTIONS RELATING TO THE
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY**

Section 618

Top-up search

Any top-up search performed by the International Preliminary Examining Authority under Rule 66.1~~er~~ shall be limited to identifying 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.

[Annex III follows]

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.

PROPOSED AMENDMENTS TO THE
PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES³

CHAPTER 19

**EXAMINATION PROCEDURE BEFORE
THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY**

Top-up search

19.12.01 In accordance with PCT Rule 66.1~~ter~~, the International Preliminary Examining Authority shall, during the preliminary examination process, update the search performed by the International Searching Authority during Chapter I by performing a top-up search to uncover any prior art not available at the time of the international search, particularly “secret” prior art, i.e. patent applications published on or after the priority date of the international application, but having an earlier filing or priority date.

19.12.02 In general, such a top-up search shall not extend beyond the subject matter searched by the International Searching Authority. However, the final determination as to the exact scope of the top-up search shall be left to the examiner.

19.12.03 A top-up search should be performed in all applications undergoing Chapter II examination, except where the examiner considers that performing a top-up search would serve no useful purpose. The instances in which a top-up search is not performed should be very limited and restricted primarily to situations where, for example, the international search report identified multiple novelty defeating references and the applicant has not filed an amendment to the claims.

[End of Annex III and of document]

³ 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.