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The International Bureau of the World Intellectual Property Organization (WIPO) presents its compliments and has the honor to transmit herewith ./ documents PCT/R/WG/7/7, 10 and 11, prepared for the seventh session of the *Working Group on Reform of the Patent Cooperation Treaty (PCT)*, which will be held in Geneva from May 25 to 31, 2005.

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Enclosures: documents PCT/R/WG/7/7, 10 and 11

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**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**WORKING GROUP ON REF ORMOFTHEPATENT
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**Seventh Session
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IMPROVING THE QUALITY OF INTERNATIONAL SEARCHES

Document prepared by the International Bureau

SUMMARY

1. Proposals and options are presented for a system of supplementary searches within the PCT, whereby an applicant would have the option to request searches to be performed by International Authorities, other than the International Searching Authority that performs the "main" international search, for prior art in languages which might not be properly considered by that main Authority. The proposals seek to find the most appropriate balance of service and convenience to the applicant, efficiency of processing for the International Authorities involved, and usefulness to the designated and elected Offices and third parties interested in the results of the supplementary search. Each International Authority would be free to decide whether or not to participate in the proposed system of supplementary searches.
2. The proposals also include an addition to the international preliminary examination process, whereby the International Preliminary Examining Authority would update the original international search to take into account documents which had only become available after that search had been carried out (mainly earlier patent applications which had not been published at the time, but also other documents which had been delayed in reaching the search databases used by the International Searching Authority for various reasons).

BACKGROUND

3. According to Article 15,¹ the objective of the international search is “to discover relevant prior art”. In principle, prior art for the purposes of the PCT is a concept independent of place or language of disclosure: the International Searching Authority “shall endeavor to discover as much of the relevant prior art as its facilities permit” in order that the international search report be of maximum use to the applicant and designated Offices for determining whether the international application meets the requirements of novelty and inventive step according to any particular national law. Ideally, the scope and quality of the international search should be such that no designated or elected Offices should need to repeat the search the national or regional phase. The considerations at that time should be limited to whether the citations are relevant to the particular definitions of novelty and inventive step which apply under the relevant national or regional law. hin

4. However, it remains the case that no Office in the world is capable of thoroughly searching disclosures written in all languages, even if it has access to the minimum search databases. Quite naturally, the majority of citations made by any International Searching Authority are in one of the languages in which the examiners in that Authority have particular proficiency. To a large extent, this reflects the fact that many technical disclosures have equivalents in other languages: either directly equivalent in the form of another member of a patent family or a translation of a book or paper, or else aspects of a particular technology may simply be described in many different places and the selection of one disclosure over another is a matter of convenience for the examiner, which makes no difference to the quality of the search. Nevertheless, the most relevant prior art for a particular invention will sometimes be in a language in which the International Searching Authority is not specialized and, even if the Authority has access to the document, it is likely to be considered only on the basis of an abstract and drawings, leaving a significant risk that its relevance will not be fully appreciated. Potentially of particularly high risk is the case where technology is being developed from earlier work which was unique to one region and all the relevant prior art may be in a language (and from a source) which would not normally be considered by an International Searching Authority which is competent for searching international applications filed in a different region.

5. Even within the PCT minimum documentation, any International Searching Authority whose official languages do not include Japanese, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan, the Russian Federation and the former Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. At the start of 2003, of the 24.6 million patent documents which formed part of the minimum documentation, 8.7 million were in Japanese and 1.7 million were in Russian and would be searched by many Authorities only on the basis of an English language abstract, or else not at all.

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.

6. In addition, at the time that the international search is performed, some relevant documents may not yet have reached these search databases. This is most common for patent applications which have a priority date earlier than the filing date of the international application but which had not yet been published at that time (these are not strictly "relevant prior art" under the PCT but are required to be indicated, where found, in international search and preliminary examination reports, since they may constitute prior art under the national law of many Contracting States). Documents published shortly before the filing date of the international application may also be missed because, except for those documents which were published by the International Authority in its capacity as a national or regional Office, there will usually be a delay between publication and classification (where applicable) and loading into the search databases. For this reason, even those designated and deleted Offices which usually rely on the international search for the most part will conduct a "top-up" or "updating" search of their own, limited to recently published prior art.

7. At the sixth session of the Working Group, there was strong support from both delegations and representatives of users for the principle of allowing further searching to be carried out within the international phase. It is a benefit to applicants, Offices and third parties alike to identify all the most relevant prior art at the earliest possible stages so that patent applications can be amended (or, if appropriate, abandoned) in the most cost-effective way and so that fewer invalid patents are granted.

PROPOSALS AND OPTIONS FOR SUPPLEMENTARY INTERNATIONAL SEARCHES

8. This paper describes the main elements of a possible system, together with a number of alternative options which would be possible. The Annex contains draft amendments to the PCT Regulations, showing how such a system might be implemented. The main features proposed are as follows:

(a) Any supplementary international search should avoid duplication of the main international search. The primary purpose would be to find relevant prior art in languages which are specializations of the supplementary Authority, ² though participating Authorities could offer a broader search if they felt it appropriate, for example, including specialized databases used by that Authority which do not form part of the PCT minimum documentation and which might include disclosures in any language (see paragraphs 10 to 16, below, and draft Rule 45bis.7).

(b) International Searching Authorities would be free to decide whether (or to what extent) they would provide supplementary international searches in addition to main international searches (see draft Rule 45bis.13). It is expected that Authorities would only offer supplementary searches if this could be done without affecting the timeliness and quality of their delivery of main international searches.

² In the body of this document and comments on the draft rules in the Annex, an Authority which is requested to perform a supplementary search on an international application is referred to as a "supplementary Authority" and the Authority which is to conduct the main international search is referred to as the "main Authority".

(c) The applicant would be free to choose which, if any, of the International Searching Authorities which agree to provide such a service should perform a supplementary international search (see especially draft Rule 45bis.1).

(d) The applicant would pay a supplementary fee for each supplementary search and, if necessary, provide a translation of the international application into a language accepted by each Authority from which a supplementary search is requested (see draft Rules 45bis.1 to 45bis.5).

(e) The request for supplementary search would (except where it is to be carried out in conjunction with international preliminary examination) be made to the International Bureau so as to minimize the number of processing steps involved (see paragraphs 17 to 20, below).

(f) The supplementary search report would merely indicate any new documents found, together with whatever comments may be necessary to ensure that the reader can understand their relevance, bearing in mind that the reader may not be a specialist in the language of the document. It would not include a written opinion of the type which accompanies the main international search (though the supplementary search might be conducted at the same time as international preliminary examination, which would, of course, require a written opinion or international preliminary report on patentability to be drawn up) (see paragraphs 21 and 22, below, and draft Rule 45bis.11).

(g) If there is lack of unity of invention, the applicant would be able to choose which inventions are researched (paying additional fees for each invention beyond the first one searched, as with a normal international search). This choice would, however, be limited to claims which have already been the subject of a search by the main Authority (and similarly, supplementary searches would not be carried out on claims which had been excluded from the main international search for other reasons, such as clarity or because of their subject matter) (see paragraphs 32 to 39, below, and draft Rules 45bis.8 and 45bis.10).

(h) To reduce difficulties associated with unity of invention and the appropriate scope of the supplementary search, and to make the supplementary search report easier to use in conjunction with the main search reports, the supplementary international searches would be carried out on the claims in the international application as filed, not taking into account amendments which may have been filed in the meantime (see paragraph 40 and draft Rule 45bis.8).

(i) The applicant would only be able to request a supplementary international search after the international search report has been established, when it is possible to determine what the appropriate fees should be and to specify which claims should be the subject of the supplementary search. To avoid increasing the number of different time limits within the system, the time limit for requesting a supplementary international search would be the same as that for demanding international preliminary examination (see paragraphs 23 to 31, below).

(j) The result of the supplementary search would be made available to the public as soon as possible after the supplementary international search report has been established, provided that the international application has been published (see paragraphs 45 to 47, below).

9. Further details of and reasoning for these proposals are set out below.

A. Purpose of the Supplementary International Search

10. At the sixth session of the Working Group (see paragraph 72 of the summary by the Chair (document PCT/R/WG/6/12)), delegation emphasized that a supplementary search should be a true complement to, rather than a duplication of, the main search. There was support for the principle that the supplementary search should be oriented primarily to finding disclosures in languages which were a specialization of the supplementary Authority but not of the main Authority. One delegation felt that a wider approach would be appropriate, taking into account that certain Authorities may have expertise in finding disclosures in particular areas outside the minimum documentation, in order to fill gaps which might exist in the main search.

– *Language Specializations*

11. It is proposed that the “primary purpose” of a supplementary international search should be to find prior art in a language which is a specialization of the Authority carrying out the supplementary international search but which may not have been fully considered by the main Authority.

12. The supplementary international search would not, in general, need to include the PCT minimum documentation, since it should be assumed that this has been adequately covered by the main Authority. However, the supplementary search should include patent documents in a language of specialization of the supplementary Authority where it is likely that the main Authority either only considers such documents on the basis of an English language abstract or else not at all (since most Authorities are only required to include patent documents in the Japanese, Russian or Spanish languages in their search documentation if an English language abstract exists).

13. Given the difficulty in defining languages which are a specialization of an Authority in a Rule, together with the number of possibilities which would exist in combinations of all Authorities as main and (where the service was offered) supplementary Authorities, it is suggested that the primary purpose of the supplementary international search need not be stated in greater detail than is set out in draft Rule 45bis.7. The languages of specialization could be specified by the Authorities concerned in an Agreement with the International Bureau and further recommendations could be included in the PCT International Search and Preliminary Examination Guidelines.

– *Further Extent of Search*

14. While the primary purpose (that is, related to language) indicates what would be expected as a minimum of a supplementary international search, it is necessary to consider whether the full extent should be regulated. The Authorities all have access to search documentation in paper or electronic forms significantly beyond that specified in the PCT minimum documentation. The scope of this additional documentation varies between Authorities and may extend to documents other than those in the languages of specialization of the particular Authority.

15. During discussions at the eleventh session of the Meeting of International Authorities Under the PCT in February 2005, some Authorities pointed out that a wider search by a supplementary Authority, if permitted, might become an expectation of applicants and lead to duplication of the main international search with consequent increases in the cost of providing the service and the workload of the participating Authorities. Other Authorities felt that it would be desirable for Authorities to search as widely as they were prepared to do without unduly increasing the cost to the applicant.

16. It is proposed in this document that the maximum extent of a supplementary international search should not be regulated by the Rules, but rather that the PCT International Search and Preliminary Examination Guidelines should emphasize the desirability of minimizing duplication of work already done by the main International Searching Authority. Participating Authorities would be free to indicate (in the PCT Applicant's Guide, on their websites, etc.) the extent of the supplementary international search which the applicant could expect and applicants could decide on that basis whether they wished to use the service.

B. Body to Which Request for Supplementary International Search is Submitted

17. At the sixth session of the Working Group, a number of receiving Offices indicated that they would not wish to handle the translations and fees which would be involved in a system of supplementary searches. The alternative options would be for the requests to be received either by the International Bureau or by the individual International Authorities which offered the service. It is proposed in this document that the requests should be made through the International Bureau, except where the supplementary search is to be performed together with the international preliminary examination (see paragraph 20, below).

18. Making the request for supplementary international search to the International Bureau has several advantages over applying directly to the relevant International Authority:

- (a) only a single request would be required, to a single location, with the fees paid together in a single currency, irrespective of the number of Authorities from which a supplementary search was requested;
- (b) many of the frequent users of the service will already have current accounts with the International Bureau, which could be used for the efficient payment of fees without the need to make equivalent arrangements with several other Offices;
- (c) the Authority which is to carry out the supplementary search could begin work on the search immediately on its receipt of the request, since the International Bureau would not forward it until the fee had been paid and all the required elements were available; if the request was received directly by the Authority, an intervening step would be required of requesting the International Bureau to send a copy of the international application and, in some cases, translations which had been furnished by the applicant under Rule 12.3 or 12.4 for the purposes of international search or international publication; and
- (d) the status information which could be offered to third parties about particular international applications (after their international publication) would be more up to date and reliable if the International Bureau was the original recipient of all such requests.

19. The main advantage of the alternative possibility of making the request directly to the supplementary Authority would be that it would mirror the arrangements for demanding international preliminary examination. However, regular users of the system would quickly learn the correct place to send the request. Occasional users of the system are likely to know the address of the International Bureau and the Authority which would act as International Preliminary Examining Authority but would usually need to look up the addresses of other Authorities. Consequently, the advantages of reduced processing for both applicant and supplementary Authority would seem to outweigh the benefits of that element of consistency.

– *Filing a Request for Supplementary Search by the International Preliminary Examining Authority*

20. Irrespective of whether requests for supplementary search as a separate service are to be submitted to the International Bureau or directly to the Authority which is to carry out the supplementary international search, any request for supplementary international search to be carried out by the International Preliminary Examining Authority at the same time as an international preliminary examination (see paragraph 31, below) should be made, with the demand, directly to that Authority.

C. Contents of the Report

21. At the sixth session of the Working Group (see paragraph 80 of the summary by the Chair (document PCT/R/WG/6/12)), one delegation expressed the view that the supplementary search should not involve the preparation of a written opinion by the supplementary search examiner. However, other delegations and representatives of users believed that an explanation of the relevance of citations discovered in the supplementary search would be necessary, particularly since it was likely that those citations would be in a language which would not be well understood by the applicant, the International Preliminary Examining Authority (where applicable) and some designated Offices.

22. It is proposed that the supplementary search report should not include a "full" written opinion by the supplementary search examiner but should include, as part of the citation of the document, a brief explanation of the relevance of the cited documents to the novelty and inventive step of the claimed invention. It should not propose any classification of the international application or any revisions to the abstract or title or include comments on matters, other than novelty and inventive step, which would be included in the written opinion of the main Authority.

D. Time of Requesting and Performing the Supplementary International Search

23. At the sixth session of the Working Group (see paragraph 75 of the summary by the Chair (document PCT/R/WG/6/12)), many delegations and representatives of users felt that it would be preferable not to insist that applicants request supplementary searches at the time of filing but rather to enable them to be requested after the results of the main search were available, for example, within one month of the establishment of the main search report. On the other hand, it was emphasized that the supplementary search procedures should fit in with the time limits for demanding international preliminary examination and for establishing the international preliminary report on patentability (whether under Chapter I or Chapter II), and that the new procedures should not have the effect of extending the international phase.

24. It is now proposed that requests for supplementary international search should be requested *only* after the international search report has been transmitted. This would mean that:

(a) the applicant would already know what fees sought to be paid in respect of any additional inventions which existed in the view of the main Authority (see also paragraph 35, below);

(b) the applicant would also be in a better position to judge which, if any, claims justified the expense of further searching (there is no point in requesting a supplementary search of inventions which have already been shown not to be novel); and

(c) the International Bureau would immediately be able to determine whether all the required indications, fees and documents had been sent before forwarding the request to the supplementary Authority with all the documents necessary to begin the supplementary international search, rather than having to recall the case later when the requirements are known and can be checked.

25. To minimize the risk of supplementary international search reports being established after the end of the international phase, it is proposed that there would be a time limit within which any request for supplementary international search should be made. In order to avoid unnecessary confusion by adding an entirely new time limit into the PCT system, it is proposed that this would be the same as the limit which applies for making a demand for international preliminary examination. In practice, it is envisaged that applicants wishing to request supplementary international searches will usually do so before the end of this time limit in order to make sure that the results are available in time to be useful, particularly if it is intended to demand international preliminary examination.

Possible Alternative Timetables

– Earlier Request for Supplementary International Search

26. The proposals outlined in this document are based on the premise that a supplementary international search should be a complement to the main international search and that duplication of work and inconsistencies in approach should be minimized. Consequently, the supplementary search is not to be started until after the international search report has been transmitted, so that the supplementary Authority can see the extent of the main international search and the need for further consideration of unity of invention is at least minimized (see paragraphs 32 to 37, below).

27. It would be possible, within this general concept, to allow a request for supplementary international search to be made before the main international search report was transmitted, but the present proposals do not make provision for this since the International Bureau would be required to acknowledge receipt of the request and then wait until a later stage to determine whether the request included all the indications, fees and documents necessary for the supplementary Authority to begin its search. Furthermore, it would lead to a significant increase in the number of defective requests for supplementary international search (in particular, all requests which were submitted prior to a finding of lack of unity by the main

Authority would be defective) and the number of requests for supplementary international searches which would be of little value because of the relevance of the prior art which was subsequently found by the main Authority.

– *Supplementary Search Concurrent With Main Search*

28. While waiting for the result of the main search before beginning any supplementary searches would avoid duplication and inconsistency, the proposed system would be slow in delivering supplementary search reports. Even where the main international search report was established within the period specified in Rule 42 (three months from receipt of the search copy by the main Authority, or in nine months from the priority date, whichever expires later), the applicant would rarely receive the supplementary search report before the international application was published. Indeed, given the number of international applications where the main international search is presently established very late, it is possible that there would be a significant number of cases where it was difficult to establish a supplementary search report before entry into the national phase. Nevertheless, it is not proposed that supplementary international searches should be carried out concurrently with the main international search in view of the duplication of work which would be involved and the consequent effects on costs and workloads.

– *Supplementary Search Only as Alternative to International Preliminary Examination*

29. At the sixth session of the Working Group, one delegation suggested that applicants should only be able to request supplementary searches as an alternative to demanding international preliminary examination, so that both procedures would not be available in a particular case (see paragraph 76 of document PCT/R/WG/6/12). After further consideration, it is not proposed to follow this suggestion since it seems probable that applicants who are interested in supplementary searches in the international phase would be more likely, on average, also to want to demand international preliminary examination in order that any appropriate amendments could be made to the description of the international application under Article 34 as well as to the claims under Article 19.

– *Supplementary Search Only Together With International Preliminary Examination*

30. At the sixth session of the Working Group, one representative of users suggested that supplementary searches should be made available only as part of the international preliminary examination procedure, which would need to be carried out by a different Office from that which had conducted the main international search (see paragraph 76 of the summary by the Chair (document PCT/R/WG/6/12)). It is noted that this would require receiving Offices and International Authorities to review the conditions under which a particular Authority is competent to act as International Preliminary Examining Authority. Moreover, this would limit the applicant to a single supplementary search and also mean that it would not be possible both to obtain a supplementary search and also to have the main international search and the international preliminary examination conducted by the same Authority, which might be desired by some applicants.

31. It is, however, proposed that the applicant should be permitted to request a supplementary search to be carried out as part of any international preliminary examination (as long as the International Preliminary Examining Authority was a different Office to the

International Searching Authority and offered the service) but that this should be an option in addition to, rather than instead of, a supplementary search as a separate service outside of the international preliminary examination procedure.

E. Claims to Be Searched (Unity, Clarity, Subject Matter, etc.)

– *Unity of Invention*

32. Cases of lack of unity of invention can cause a significant delay and additional work in the establishment of a final international search report because of the need to request additional fees and wait for the applicant's response, which may include a protest to be examined. One of the main reasons for the proposal that supplementary searches should only be performed after the transmittal of the international search report is to avoid the work (and confusion) involved in several Authorities considering this issue in parallel.

33. At the sixth session of the Working Group (see paragraph 79 of the summary by the Chair (document PCT/R/WG/6/12)), a number of delegations felt that, to avoid complexity, the question of unity of inventions should not be dealt with in a way which merely mirrored that applicable to the main search. One possibility was that supplementary searches, particularly if requested at the time of filing the international application, might have to be limited to the invention first mentioned in the claims. Some delegations and representatives of users indicated, however, that it was desirable to allow applicants to specify which claims should be the subject of supplementary search (from among those claims which had been the subject of the main search), noting that a more complete search in the international phase of all the inventions which it is desired to pursue would enable suitable amendments to be made before entering the national phase, avoiding the need to pursue amendments separately before a number of different designated Offices.

34. It is proposed that, in the case of a lack of unity of invention, the applicants should be permitted to choose, from among the claims which had been the subject of the main search, which invention should be the subject of the supplementary search, subject to payment of any additional fees, since it is a service which is apparently desired and may, in practice, not involve any greater degree of complication than would arise anyway.

35. The invention to be the subject of the supplementary search (and any additional fees which require to be paid) should, in general, be defined in terms of the inventions set out in the international search report (or covered in the result of any protest which has been transmitted to the applicant and the International Bureau prior to the date of filing the request for supplementary search). It is largely for this reason that it is proposed that the request for supplementary international search would not be made until the main international search report had been transmitted, together with the observations of the International Searching Authority concerning unity of invention (noting that a decision might still be pending concerning any protest on the payment of additional fees).

36. Where the results of a protest which was at least partially successful were retransmitted to the applicant and the International Bureau after a request has been made for supplementary international search, the results would be forwarded to the supplementary Authority, which would make any necessary arrangements for repayment of additional fees which were found to be unnecessary.

37. At the eleventh session of the Meeting of International Authorities Under the PCT, it was indicated that, while accepting the view of the main Authority concerning unity of invention seemed to be the simplest solution, Authorities may not be able to accept a system where they were unable to require further fees if they identified a lack of unity of invention beyond any which had been recognized by the main Authority. Such a finding may be quite common *a posteriori* where new prior art was found which was relevant to the common matter of the claims, but could also arise *a priori*. Consequently this possibility is allowed for in draft Rule 45bis.10(b).

– *Certain Subject Matter; Lack of Clarity*

38. Where an application contains subject matter listed under Rule 39 which an Authority is not required to search, or the description, claims or drawings fail to comply with the prescribed requirements to the extent that no meaningful search is possible, the supplementary Authority should not be required to carry out a supplementary search to the extent that it would have made a declaration or indication under Article 17(2)(a) or (b) if it had been carrying out the main international search.

39. Furthermore, since this service is intended to be a complement to the main international search rather than an alternative, the supplementary search service would not be available in respect of any claims which were the subject of a declaration or indication under Article 17(2)(a) or (b) by the main Authority, even if the supplementary Authority would itself have searched those claims if it had been the main Authority.

– *Amendments*

40. Since, as proposed, the supplementary international search would only be conducted after the international search report had been transmitted, it would always be possible for the applicant to submit amendments to the claims under Article 19 before the supplementary search was carried out. However, it is proposed that any supplementary search should be made on the basis of the claims as originally filed in order to make it easier to read the main and supplementary international search reports together and to avoid uncertainty over whether amended claims had been part of the original search and the extent of any remaining lack of unity of invention.

41. An exception to the cases set out in paragraph 40, above, would be where the supplementary search was to be carried out by the International Preliminary Examining Authority. In that case the supplementary search would be carried out on the amended claims, since the Authority is already required to consider the unity of invention of the amended claims and to work out whether the international search embraced the amended claims. The need to read the results of the supplementary international search in combination with the main international search report would be reduced since the information which was still relevant to the amended claims could all be found together in the international preliminary report on patentability under Chapter II.

F. Fees and Documents to Be Provided by the Applicant

42. The International Bureau would already have in its files certain documentation which would need to be sent to the Authority which was to carry out the supplementary international search, including:

- (a) a copy of the international application;
- (b) a copy of any translation which had already been furnished under Rule 12.3 or 12.4 which was to be used for the purpose of the supplementary international search; and
- (c) a copy of the search report and written opinion established by the main International Searching Authority.

43. In many cases, this would be sufficient for the Authority to begin the supplementary international search. However, in some cases, it would be necessary for the applicant also to supply:

- (a) a translation of the international application into a language accepted by the supplementary Authority where neither the international application nor a translation provided for publication or international search was in such a language; or
- (b) a copy of a sequence listing in accordance with the standard provided for in Annex C of the Administrative Instructions where such copy had not been provided as part of the international application as filed and was consequently requested by the International Searching Authority (not that listings provided to the International Searching Authority for the purpose of the international search are not currently required to be transmitted to the International Bureau, though this might change in the future).

44. The request for supplementary international search would not be forwarded to the relevant supplementary Authority until the appropriate fees had also been paid. This would involve a fee for the benefit of the Authority which was to carry out the supplementary international search (including additional fees where more than one invention was to be the subject of the supplementary search) and a fee for the benefit of the International Bureau to cover the cost of the actions which it is required to undertake, including checking and transmission of documents and translation and making available of the supplementary search report.

G. Availability and Translation of the Supplementary International Search Report

45. The supplementary search report would be of relevance not only to the applicant but also to the International Preliminary Examining Authority, designated and elected Offices and third parties. Consequently, it is recommended that it should be made available to the public as soon as possible after it is established (provided that the international application has been published) and that, if it is established in a language other than English, a translation into English should be prepared by the International Bureau.

46. However, it would not appear to be justified to publish the supplementary international search report in the same way as is currently done for the main international search report, since this would result in a "republication" of almost every international application for which a supplementary search was requested, which would be very expensive and impractical under

the current publications system. It is therefore suggested that the International Bureau should make the supplementary search reports publicly available in an appropriate electronic form, which would be immediately obvious to third parties consulting the electronic publication of the main international search report. Paper copies would, of course, be available on request.

47. Where at present a copy of an international search report is communicated to an Office, the communication should automatically include a copy of any supplementary international search report which had been established by that time. Furthermore, where international preliminary examination has been demanded, copies of supplementary international search reports should be systematically communicated to the International Preliminary Examining Authority even if they are established only after international preliminary examination had begun. The International Preliminary Examining Authority should take such supplementary search reports into account if possible, but the examination should not be delayed to wait for such reports.

OTHER ISSUES

48. At the sixth session of the Working Group, a number of delegations were concerned about the high costs for applicants which would be involved in obtaining supplementary international searches and that this would affect individual applicants particularly badly.

49. It is to be hoped that the improved quality of the overall international search which could be achieved by such a system would encourage designated and elected Offices to rely more completely on the international search and to make appropriate reductions in their national fees, especially where a supplementary search had been carried out by the Office concerned in its role as an International Searching Authority, but not limited to that case.

50. It is envisaged that the International Bureau's portion of the fee would be either reduced or waived entirely for those applicants who qualify for the reduction in the international filing fee under item 4 of the Schedule of Fees (natural persons nationals of and resident in a State whose per capita income is below 3,000 United States dollars, and any applicant from a least developed country). Some Authorities at present also offer reductions in the main international search fee to such applicants and it is to be hoped that any such reductions would similarly apply to supplementary international searches, where available from such Authorities.

51. Clearly, the success of any system of supplementary international search would depend on there being a real advantage to the applicant in using it. The further fees which would be payable in the international phase would need to be justified by the ability to perfect the application at an earlier stage, with consequent reduced costs and increased certainty in the national phase.

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

[Annex follows]

ANNEX

ILLUSTRATED DRAFT AMENDMENTS OF THE PCT REGULATIONS: ³

SUPPLEMENTARY AND UPDATE SEARCHES

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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.

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Rule45 bis

Supplementary International Searches

45bis.1 Request for Supplementary International Search

(a) The applicant may, after having received the international search report and within the time limit referred to in paragraph (b), request the International Bureau that a supplementary international search be carried out by one or more Authorities, other than the International Searching Authority which carried out the international search under Article 16(1), which have notified the International Bureau under Rule 45 bis.13 that they are prepared to carry out such searches.

[COMMENT: If a declaration is made under Article 17(2)(a) that no international search report will be established, there will be no possibility of requesting a supplementary international search. Any such request received would be invalid and would be treated as not having been made.]

(b) The time limit referred to in paragraph (a) shall be whichever of the following periods expires later:

(i) three months from the date of transmittal to the applicant of the international search report and the written opinion established under Rule 43 bis.1; or

(ii) 22 months from the priority date.

[Rule 45bis.1(b), continued]

[COMMENT: This is the same time limit as applies for demanding international preliminary examination. Clearly, if the applicant also wishes to demand international preliminary examination he will need to make any requests for supplementary international search well in advance of this deadline if the results are to be taken into account.]

(c) A request under paragraph (a) shall contain:

(i) indications concerning the international application to which it relates, comprising the name and address of the applicant, the title of the invention, the international filing date and the international application number;

(ii) an indication of which Authorities are requested to carry out a supplementary international search;

(iii) where the international application was filed in a language which is not accepted by an Authority which is to carry out a supplementary international search, an indication of whether any translation furnished under Rule 12.3 or 12.4 is to form the basis of the supplementary international search to be carried out by that Authority; and

(iv) where the International Searching Authority considers that the international application does not comply with the requirement of unity of invention, an indication of which of the inventions in respect of which the international search report was established are to be the subject of the supplementary international search.

[Rule 45bis.1(c), continued]

[COMMENT: The applicant would be permitted to choose any of the invention to be the subject of the supplementary international search, as long as that invention had been searched by the International Searching Authority. The main invention would not necessarily need to be included.]

(d) A request under paragraph (a) shall also be accompanied by:

(i) any translation of the international application required under Rule 45bis.5;

(ii) any sequence listing in electronic form complying with the standard provided for in the Administrative Instructions which was required by the International Searching Authority under Rule 13ter.1(a);

[COMMENT: At present, the International Searching Authority does not forward a copy of sequence listings provided for the purpose of international search to the International Bureau, since they do not form part of the international application and are not published. An alternative possibility would be for such listings to be sent by the International Searching Authority to the International Bureau automatically with the international search report, so that the applicant would not be required to furnish further copies for any supplementary searches.]

(e) The fees payable under Rules 45bis.3 and 45bis.4 shall be paid to the International Bureau within one month from the date of receipt of the request for supplementary international search. The amount payable shall be the amount applicable on that date of receipt.

45bis.2 Acknowledgement and Checking of the Request for Supplementary International

Search

(a) The International Bureau shall promptly acknowledge receipt of a request for supplementary international search. Where the International Bureau finds that any of the indications required under Rule 45 bis.1(c) or any elements required under Rule 45bis.1(d) are missing, it shall invite the applicant to furnish the indications or elements within one month from the date of the invitation.

(b) Where, by the time they are due under Rule 45bis.1(e), the International Bureau finds that the fees under Rules 45bis.3 and 45 bis.4 have not been paid in full, the International Bureau shall invite the applicant to pay to it the amount required to cover those fees within a time limit of one month from the date of the invitation.

[COMMENT: It is not envisaged that applicants would often use this provision deliberately to extend the period for payment of fees or the provision of translations because of the risk that the supplementary search report would not be established in time for use in making decisions on whether to enter the national (or regional) phase. Consequently, although making and following up the invitation would significantly add to the work required of the International Bureau in any particular case, it is not proposed at this time to include a late payment fee. This would need to be reviewed if significant numbers of invitations needed to be issued.]

(c) If the applicant does not, before the expiration of the time limit under Rule 45bis.2(a), submit the required indications or elements or does not, before the expiration of the time limit under Rule 45bis.2(b), pay the amount in full of the fees due, the request for supplementary international search shall, subject to paragraph (d), be considered as if it had not been made and the International Bureau shall inform the applicant accordingly.

[Rule 45bis.2, continued]

(d) Where the International Searching Authority considered that the international application does not comply with the unity of invention requirements under Rule 13 but the applicant does not, before the expiration of the time limit under Rule 45bis.2(b), pay the amount in full of all additional supplementary search fees due, the request shall be considered to be a request for supplementary international search on as many of the inventions as required fees have been paid. The Administrative Instructions shall determine which of the inventions shall be the subject of the supplementary international search.

[COMMENT: The Administrative Instructions would require that where the invention to be searched had been listed, the supplementary international searches would be performed on the appropriate number of inventions in the order in which they were listed. Where they were not listed, this search would normally be performed in the order in which the inventions appeared in the claims, but would leave some scope for discretion (for example, ignoring inventions which would not be subject to supplementary international search in accordance with Rule 45bis.8(b) on grounds of their subject matter).]

45bis.3 Supplementary Search Handling Fee

A request for a supplementary international search filed with the International Bureau under Rule 45bis.1(a) shall be subject to the payment of a fee for the benefit of the International Bureau ("supplementary search handling fee"). The amount of the supplementary search handling fee is as set out in the Schedule of Fees. The International Bureau shall refund to the applicant any supplementary search handling fee paid if:

[Rule 45bis.3, continued]

(i) the request for a supplementary international search is withdrawn before the supplementary search copy is sent to the Authority carrying out the supplementary international search; or

(ii) the request for a supplementary international search is considered, under Rule 45bis.2(c), not to have been made.

[COMMENT: The amount of this fee would be set to cover the cost of processing the request and results, including checking the request, forwarding the necessary documents to the International Searching Authority carrying out the supplementary international search, making any necessary translations and making the results available to Offices and the public.]

45bis.4 Supplementary Search Fee; Additional Supplementary Search Fee

(a) An International Searching Authority which has notified the International Bureau under Rule 45 bis.13 that it is prepared to carry out supplementary international searches may require that the applicant:

(i) pay a fee (“supplementary search fee”) for its own benefit for carrying out a supplementary international search;

[Rule 45bis.4(a), continued]

(ii) pay an additional fee (“additional supplementary search fee”) for its own benefit for carrying out a supplementary international search in respect of any invention, beyond the first, which is to be the subject of a supplementary international search in accordance with Rule 45bis.10.

[COMMENT: The “first” invention means the first which is to be the subject of a supplementary international search, not necessarily the “first mentioned in the claims” as is specified for the main international search under Article 17(3)(a).]

(b) The supplementary search fee and any additional supplementary search fees shall be collected by the International Bureau. The said fees shall be payable in the currency or one of the currencies prescribed by that Bureau (“prescribed currency”), it being understood that, if the prescribed currency is not that, or one of those, in which the International Searching Authority has fixed the said fees (“fixed currency”), they shall, when transferred by the International Bureau to the International Searching Authority, be freely convertible into the currency of the State in which the International Searching Authority has its headquarters (“headquarters currency”). The amount of the said fees in any prescribed currency, other than the fixed currency, shall be established by the Director General after consultation with the Authority which has fixed the said fees. The amounts so established shall be the equivalents, in round figures, of the amount established by the International Searching Authority in the headquarters currency. They shall be published in the Gazette.

[Rule 45bis.4, continued]

(c) Where the amount of the supplementary search fee and the additional supplementary search fee in the headquarters currency is changed, the corresponding amounts in the prescribed currencies, other than the fixed currency or currencies, shall be applied from the same date as the changed amount in the headquarters currency.

(d) Where the exchange rate between the headquarters currency and any prescribed currency, other than the fixed currency or currencies, becomes different from the exchange rate last applied, the Director General shall establish the new amount in the said prescribed currency according to directives given by the Assembly. The newly established amount shall become applicable two months after its publication in the Gazette, provided that any Authority referred to in the third sentence of paragraph (b) and the Director General may agree on a date falling during the said two month period, in which case the said amount shall become applicable for that Authority from that date.

(e) Where, in respect of the payment of the supplementary search fee or the additional supplementary search fee in a prescribed currency, other than the fixed currency or currencies, the amount actually received by the International Searching Authority in the headquarters currency is less than that fixed by it, the difference will be paid to the International Searching Authority by the International Bureau, whereas, if the amount actually received is more, the difference will belong to the International Bureau.

[Rule 45bis.4, continued]

(f) The International Bureau shall refund the supplementary search fee and any additional supplementary search fee to the applicant if:

(i) the request for a supplementary international search is withdrawn before the supplementary search copy is sent to the Authority carrying out the supplementary international search; or

(ii) the request for a supplementary international search is considered, under Rule 45bis.2(c) or 45bis.9(b), not to have been made.

(g) To the extent that the International Searching Authority finds a protest of the applicant under Rule 40.2(c) justified, the Authority carrying out the supplementary international search shall totally or partially refund any additional supplementary search fee paid by the applicant in accordance with Rule 45bis.4(a)(ii).

[COMMENT: Draft Rule 45bis.4 is modeled on Rule 16. The currencies currently prescribed by the International Bureau units role as a receiving Office in respect of the collection of search fees are the Swiss franc, the euro and the US dollar. While refunds of fees would be carried out by the International Bureau under paragraph (f) when the request for supplementary international search is withdrawn or considered withdrawn, refunds under paragraph (g) following a successful protest would require consideration by the Authority carrying out the supplementary international search of the extent to which the refund was appropriate. The Administrative Instructions would need to be modified so as to indicate that the International Bureau must forward the results of any protest to all Authorities carrying out a supplementary international search.]

45bis.5 Translation for Supplementary International Search

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 carrying out the supplementary international search, the request for a supplementary international search shall be accompanied by a translation of the international application into a language which is accepted by that Authority and is a language of publication.

[COMMENT: Modeled on Rule 12.3. For simplicity of processing, the translation would need to be filed at the same time as the request for the supplementary international search. This does not appear to be an unreasonable burden since the time limit will inevitably be several months after the international filing date, allowing more time to prepare the translation than is permitted for the translation for the purposes of the main international search. Note that Rule 45bis.5 would have to be further amended should the amendments of the Regulations concerning publication of international applications in multiple languages (see document PCT/R/WG/7/4) be adopted.]

45bis.6 Transmittal of the Supplementary Search Copy, International Search Report etc.

On finding that the requirements under Rules 45 bis.1(c), (d) and (e) have been complied with, the International Bureau shall promptly transmit to each Authority which is to carry out a supplementary international search one copy of each of the following:

(i) the request for a supplementary international search;

(ii) the international application (“supplementary search copy”);

[Rule 45bis.6, continued]

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

(iv) any translation furnished by the applicant under Rule 12.3, 12.4 or 45bis.5
which is to be used as the basis of the supplementary international search;

(v) the international search report; and

(vi) the written opinion established under Rule 43 bis.1.

[COMMENT: It would not normally be necessary for the supplementary Authority to consider the written opinion, but it might occasionally be useful in determining whether the main Authority had considered the full text of a cited document or only an abstract.]

45bis.7 Objective of Supplementary International Search

The objective of the supplementary international search is to discover relevant prior art,
further to that discovered in the international search, by extending the international search to
cover documents which may not have been considered fully by the International Searching
Authority during the international search, particularly those in languages of specialization of
the Authority carrying out the supplementary international search.

[Rule 45bis.7, continued]

[COMMENT: In most cases it would not be necessary for the supplementary Authority to consult the PCT minimum documentation except to the extent that some documents are either not required to be included in the documentation of some Authorities since no English language abstract is available, or that the document might only have been considered on the basis of such an abstract and not in full. The extent to which the applicant could expect a supplementary international search to be carried out beyond languages of specialization would be set out in the International Search and Preliminary Examination Guidelines to the extent that participating Authorities agreed. Authorities which would normally conduct a broader supplementary search than was set out under this Rule and any associated guidelines could indicate their policy in the Applicant's Guide to help applicant to decide whether to use the service.]

45bis.8 Basis of the Supplementary International Search

(a) The supplementary international search shall be carried out on the basis of the international application as filed or of a translation thereof indicated under Rule 45bis.1(c)(iii) or accompanying the request for supplementary international search under Rule 45bis.5.

[COMMENT: The supplementary international search cannot begin before the main international search report has been transmitted. Consequently, it would always be possible for the applicant to file amendments under Article 19 before the supplementary international search commenced. However, if such amendments were to be taken into account the main and supplementary international search reports would be more difficult to read together and in some cases it would be difficult to know how to supplement, rather than restart, the international search.]

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

[Rule 45bis.8(b), continued]

[COMMENT: The Authority would not be required to carry out a supplementary international search in respect of subject matter or unclear applications for which it would not be required to carry out an international search. It should also be able to request sequence listings in an appropriate electronic form if necessary (though this should rarely be required since the applicant would be required to submit any sequence listings in electronic form which had been required by the International Searching Authority along with the request for supplementary international search).]

(c) The Authority carrying out a supplementary international search shall not be required to establish a supplementary international search report in respect of any claim for which no international search report was established.

45bis.9 Start of Supplementary International Search

(a) Subject to paragraph (b), the Authority carrying out a supplementary international search shall start that search promptly on receipt of the documents specified in Rule 45bis.6.

(b) If the Authority requested to carry out a supplementary international search finds that such search would be excluded by a limitation notified under Rule 45bis.13, the request for supplementary international search shall be considered not to have been made and the Authority shall promptly notify the applicant and the International Bureau accordingly. The Authority shall refund to the applicant the supplementary search fee and any additional supplementary search fees which have been paid under Rule 45bis.4(b).

[COMMENT: The applicant's right to a refund under this paragraph would extend only to the case where the supplementary international search is not made because of a restriction of which the International Bureau had been notified under proposed Rule 45bis.13 and not because of a declaration equivalent to that under Article 17(2)(a).]

45bis.10 Unity of Invention

(a) If the international search report contains indications to the effect that the international application does not comply with the requirement of unity of invention under Rule 13, the Authority carrying out a supplementary international search shall establish the supplementary international search report on those claims relating to the inventions indicated by the applicant under Rule 45bis.1(c)(iv), provided that those claims were the subject of international search.

[COMMENT: See Rule 45bis.2(d) for how the request is treated in the event that not all the additional supplementary search fees are paid.]

(b) If the Authority conducting a supplementary international search considers that the international application fails to comply with the requirement of unity of invention as set forth in Rule 13 to an extent greater than that indicated in the international search report, it may invite the applicant to pay further additional supplementary search fees in accordance with Rule 45bis.4(a)(ii). Rule 40.2 shall apply *mutatis mutandis*.

45bis.11 Supplementary International Search Report

(a) The Authority carrying out a supplementary international search shall establish a supplementary international search report, or make a declaration pursuant to Rule 45bis.8(b) or (c) that no supplementary international search report will be established, within three months from the receipt of the request for supplementary international search by the Authority from the International Bureau.

[Rule 45bis.11, continued]

[COMMENT: Modeled in part on Rule 42.1]

(b) For the purposes of establishing the supplementary international search report, Rules 43.1, 43.2 and 43.4 to 43.10 shall, subject to paragraph (c), apply *mutatis mutandis*. Article 20(3) and Rule 44.3 shall apply *mutatis mutandis*.

[COMMENT: 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 and that it would only include the newly found citations (except where a previously found document is considered relevant to an inventive step in combination with a newly found document; see paragraph (c), below). The 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. The same requirement to send copies of the citations on request to the applicant or to a designated Office would apply as for the main international search.]

(c) The supplementary international search report shall not contain the citation of any document which was cited in the international search report, except to the extent that the document is considered relevant to the question whether the claimed invention involves an inventive step having regard also to one or more other documents which were discovered during the supplementary international search and which were not cited in the international search report.

[COMMENT: The supplementary international search reports should not merely duplicate citations which appeared in the international search report; the International Search and Preliminary Examination Guidelines would make it clear that this extends to "equivalent" patent publications, unless there is found to be a material difference between the family members. Furthermore, it is not desirable for the Authority concerned to take a different view to the International Searching Authority in a report which is part of the international search process. However, where it is apparent that a document has been cited merely on the basis of an abstract and the Authority conducting the supplementary international search finds that

[Rule 45bis.11(c), continued]

the relevance of the document was incorrect based on a consequential misunderstanding of its contents, the PCT International Search and Preliminary Examination Guidelines would make clear that the entry in the international search report should be regarded as a citation of the abstract and that it is acceptable in this case to cite the original document in the supplementary international search report.]

(d) If the supplementary international search report contains the citation of one or more documents considered to be relevant prior art under Rule 64.1, the Authority carrying out the supplementary international search shall include in the supplementary international search reports such indications as may be required to make clear the reasons for which each document appears to be relevant to the novelty or inventive step of the claimed invention.

45bis.12 Transmittal and Effect of the Supplementary International Search Report

(a) The Authority carrying out the supplementary international search shall, on the same day, transmit one copy of the supplementary international search report, or a declaration that no supplementary international search report shall be established because a situation referred to under Rule 45bis.8(b) or (c) exists, 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.

[Rule 45bis.12(b), continued]

[COMMENT: The supplementary international search report would, where necessary, be translated into English and be communicated automatically to any Office requesting a copy of the main international search report. The Administrative Instructions would make clear that, unless the international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty) had already been established and transmitted to the International Bureau, the supplementary international search report would always be forwarded to the International Preliminary Examining Authority so that it could be taken into account, if possible, even though international preliminary examination might already have begun. Public access to the supplementary international search report would be permitted to the supplementary international search report under existing Rule 94.1(b) at any time after publication of the international application. Although it is not proposed to make a formal republication of the pamphlet to include the supplementary international search report, the online file inspection system would be arranged so that a person viewing the pamphlet would be aware of any supplementary report and could view it together with the main 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.

[COMMENT: Modeled on Rule 66.4bis. The International Preliminary Search and Examination Guidelines would make clear that the International Preliminary Examining Authority should take the supplementary international search and written opinion into account whenever possible, but should not delay the start of international preliminary examination to wait for them.]

45bis.13 International Searching Authorities Competent for Supplementary International

Search

Each International Searching Authority which is prepared to carry out supplementary international searches shall notify the International Bureau accordingly. Any such notification may set out limitations as to the subject matter for which such searches will be carried out, beyond those which would apply under Article 17(2) to an international search, or to the total number of supplementary international searches which will be performed in a given period. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: Authorities 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. The notification could be amended at a later stage to introduce or remove such limitations as necessary.]

Rule 53

The Demand

53.1 [Nochange]

53.2 Mandatory and Optional Contents ; Signature

(a) [Nochange]

(a-bis) The demand may contain a request that the International Preliminary Examining Authority carry out a supplementary international search, provided that the national Office or intergovernmental organization which is acting as International Preliminary Examining Authority is not the same as that which acted as International Searching Authority and has notified the International Bureau under Rules 44bis.13 and 66.1ter that it is prepared to carry out such searches .

(b) [Nochange]

53.3 to 53.9 [Nochange]

Rule 58

The Preliminary Examination and Supplementary Search Fees **Fee**

58.1 *Right to Ask for a Fee*

(a) [No change] Each International Preliminary Examining Authority may require that the applicant pay a fee (“preliminary examination fee”) for its own benefit for carrying out the international preliminary examination and for performing all other tasks entrusted to International Preliminary Examining Authorities under the Treaty and these Regulations.

(a-bis) Each International Preliminary Examining Authority which has notified the International Bureau under Rules 45bis.13 and 66.1ter that it is prepared to carry out supplementary searches may require that the applicant pay a fee (“supplementary search fee”) for its own benefit for carrying out the supplementary search .

[COMMENT: Fees for supplementary international searches of additional inventions are provided for in the proposed amendments to Rule 68, together with fees for examination of additional inventions.]

(b) The amount of ~~the~~ any preliminary examination fee ~~if any, —~~ and any supplementary search fee shall be fixed by the International Preliminary Examining Authority. As to the time limit for payment of the preliminary examination and supplementary search fee s and the amount payable, the provisions of Rule 57.3 relating to the and ling fees shall apply *mutatis mutandis*.

[Rule 58.1, continued]

(c) The preliminary examination fee and any supplementary search fee shall be payable directly to the International Preliminary Examining Authority. Where that Authority is a national Office, it shall be payable in the currency prescribed by that Office, and where the Authority is an intergovernmental organization, it shall be payable in the currency of the State in which the intergovernmental organization is located or in any other currency which is freely convertible into the currency of the said State.

58.2 [Remains deleted]

58.3 *Refund*

(a) The International Preliminary Examining Authorities shall inform the International Bureau of the extent, if any, to which, and the conditions, if any, under which, they will refund any amount paid as a preliminary examination fee where the demand is considered as if it had not been submitted, and the International Bureau shall promptly publish such information.

(b) The International Preliminary Examining Authority shall refund to the applicant any supplementary search fee and any additional supplementary search fees paid to it if:

(i) the demand or the associated request for a supplementary international search is withdrawn or considered not to have been submitted before the supplementary international search has been started; or

[Rule 58.3(b), continued]

(ii) therequestforasupplementaryinternationalsearchisconsidered,under
Rules 45bis.9(b)and 66.1ter,nottohavebeenmade.

Rule 66

Procedure Before the

International Preliminary Examining Authority

66.1 *Basis of the International Preliminary Examination*

(a) [No change] Subject to paragraphs (b) to (d), the international preliminary examination shall be based on the international application as filed.

(b) [No change] The applicant may submit amendments under Article 34 at the time of filing the demand or, subject to Rule 66.4bis, until the international preliminary examination report is established.

(c) [No change] Any amendments under Article 19 made before the demand was filed shall be taken into account for the purposes of the international preliminary examination unless superseded, or considered as reversed, by an amendment under Article 34.

(d) [No change] Any amendments under Article 19 made after the demand was filed and any amendments under Article 34 submitted to the International Preliminary Examining Authority shall, subject to Rule 66.4bis, be taken into account for the purposes of the international preliminary examination.

(e) [No change] Claims relating to inventions in respect of which no international search report has been established need not be the subject of international preliminary examination.

[Rule 66.1, continued]

(f) Paragraphs (a) to (e) shall apply *mutatis mutandis* to any supplementary international search carried out at the same time as the international preliminary examination.

66.1bis [No change]

66.1ter *Supplementary International Search by the International Preliminary Examining*

Authority

For the purposes of supplementary international searches by the International Preliminary Examining Authority, Rules 45bis.7, 45bis.9(b) and 45 bis.13 shall apply *mutatis mutandis*.

[COMMENT: Supplementary international searches by the International Preliminary Examining Authority would have the same objective as those by International Searching Authorities and be subject to the same possibility for limitations, such as in respect of subject matter for which the service is made available. There would not be a formal supplementary search report. Rather, the results would be cited in the international preliminary report on patentability, in the same way as is currently done for documents which are considered relevant but were not cited in the international search report (see Rule 70.7). The Administrative Instructions would require that the reports should indicate that a supplementary international search had been conducted together with the international preliminary examination.]

66.1quater Updating theInternationalSearch

TheInternationalPreliminaryExaminingAuthorityshallendeavortodiscoverasmuch
oftherelevantpriorartasitsfacilitiespermitwhichitconsidersmaynotyethavebeen
availabletotheInternationalSearchingAuthority atthetimethattheinternationalsearch
reportwaseestablished.Rule 33shallapply *mutatismutandis*.

[COMMENT:Itisproposedthattheupdatingoftheinternationalsearchwouldbedonefor
allapplicationswhereinternationalpreliminaryexaminationwasdemanded.Thisdiffers
fromtheproposedoptionalsupplementaryinternationalsearchinthatitextendstheoriginal
searchtofinddocumentswhichwerenotincludedintheinternationalsearchreportbecause
theywerenotavailabletothesearchcollectionatthattime(mainlyearlierpatentapplications
whichwereonlypublishedaftertheinternationalsearch)ratherthandocumentswhichhad
beenpublishedbutwouldnothavebeenfullyconsideredbyanotherAuthority(mainly
becauseoflanguageissues) .]

66.2to66.9 [Nochange]

Rule 68

Lack of Unity of Invention
(International Preliminary Examination)

68.1 [No change]

68.2 *Invitation to Restrict or Pay*

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at this option, to restrict the claims or to pay additional fees, the invitations shall:

(i) to (iii) [No change]

(iv) indicate the amount of the required additional preliminary examination fees to be paid in case the applicant so chooses;

(v) where the applicant has requested a supplementary international search and any additional invention has been the subject of an international search, indicate the amount of the required additional supplementary search fees to be paid if a supplementary international search is to be carried out in respect of each such additional invention; _____ and

[Rule 68.2, continued]

(vi) ~~(v)~~ invite the applicant to pay, where applicable, the protest fee referred to in Rule 68.3(c) within one month from the date of the invitation, and indicate the amount to be paid.

68.3 *Additional Fees*

(a) The amount of the additional fees due for international preliminary examination under Article 34(3)(a) and, where the International Preliminary Examining Authority has indicated that it is prepared to carry out supplementary international searches, for supplementary international search of any additional invention shall be determined by the competent International Preliminary Examining Authority.

(b) The additional fees due for international preliminary examination under Article 34(3)(a) and any supplementary international search shall be payable direct to the International Preliminary Examining Authority.

(c) to (e) [No change]

68.4 and 68.5 [No change]

Schedule of Fees

[COMMENT: The Schedule of Fees would require amendment to include as supplementary search handling fee, whose level would be set to cover the cost of preparation, transmission and publication of documents relevant to the supplementary international search during the Chapter I procedure. For supplementary international searches performed as part of the Chapter II procedure, no such fee would be necessary since no significant additional work for the International Bureau would be involved over and above that for which the handling fee under Rule 57 is levied.]

[End of Annex and of document]

WIPO



PCT/R/WG/7/10

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WORKING GROUP ON REFORM OF THE PATENT COOPERATION TREATY (PCT)

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ADDITION OF ARABIC AS A LANGUAGE OF PUBLICATION

Document prepared by the International Bureau

SUMMARY

1. This document contains proposals for amendment of the Regulations¹ so as to add Arabic to the list of languages referred to in Rule 48.3(a) in which international applications may be published.

ADDITION OF ARABIC AS A LANGUAGE OF PUBLICATION

Proposed Amendment of Rule 48.3

2. Present Rule 48.3(a) lists the languages in which international applications may be published (“languages of publication”): Chinese, English, French, German, Japanese, Russian and Spanish.

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.

3. Under Rule 48, an international application filed in one of those languages is published in the language in which it was filed. An international application which is not filed in a language of publication is published as a translation of the international application furnished by the applicant into a language of publication (that translation may also be used for the purposes of the international search).

4. At the request of the Government of Egypt, it is proposed to add Arabic to the list of languages of publication referred to in Rule 48.3(a), which would mean that an international application filed in Arabic would be published in that language. It is recalled that Arabic is one of the six official languages of the United Nations.

5. The addition of Arabic as a language of publication would also have a bearing on several other language related questions, as outlined in the following paragraphs. However, no change would be needed to the Rules concerned.

Filing of International Applications (Rule 12.1(a) and (b))

6. Receiving Offices may at present accept any language, including Arabic, for the filing of international applications. If Arabic is added as a language of publication, as at present and for as long as no International Searching Authority accepts Arabic for the purposes of the international search, each receiving Office which accepts the filing of international applications in Arabic would continue to be required also to accept the filing of international applications in at least one language which is both a language of publication and a language accepted by the International Searching Authority, or, if applicable, by at least one of the International Searching Authorities, competent for the international searching of international applications filed with that receiving Office.

Filing of the Request (Rule 12.1(c))

7. If Arabic is added as a language of publication, any receiving Office would be free to decide to accept Arabic for the filing of the request, in which case the request form would be made available in that language and applicants could file the request in Arabic with such a receiving Office.

Translation for the Purposes of International Search (Rule 12.3)

8. If Arabic is added as a language of publication, as at present and for as long as no International Searching Authority accepts Arabic for the purposes of the international search, an applicant who files an international application in Arabic would continue to be required to furnish to the receiving Office a translation of the international application into a language which is both a language accepted by the competent International Searching Authority that is to carry out the international search and a language of publication. Notwithstanding the fact that such a translation would be required, the international application filed in Arabic would be published in Arabic.

International Search Report and Written Opinion of the International Searching Authority; International Preliminary Report on Patentability (Chapter I) (Rules 43.4, 43bis.1(b) and 44bis.1)

9. If Arabic is added as a language of publication, for as long as no International Searching Authority accepts Arabic for the purposes of the international search and thus a translation of an international application filed in Arabic is required under Rule 12.3(a) for the purposes of the international search, the international search report and the written opinion of the International Searching Authority would be either in Arabic or, if the International Searching Authority so wishes, in the language of the translation furnished by the applicant under Rule 12.3(a), and the international preliminary report on patentability (Chapter I) would be in the language of the written opinion.

Filing of the Demand (Rule 55.1)

10. If Arabic is added as a language of publication, for as long as no International Preliminary Examination Authority accepts Arabic for the purposes of the international preliminary examination and thus a translation of an international application filed in Arabic is required under Rule 55.2 for the purposes of the international preliminary examination (see below), the demand would have to be in the language of the translation furnished under that Rule.

Translation for the Purposes of International Preliminary Examination (Rule 55.2)

11. If Arabic is added as a language of publication, for as long as no International Preliminary Examination Authority accepts Arabic for the purposes of the international preliminary examination, a translation of an international application filed in Arabic would be required under Rule 55.2 into a language which is both accepted by the International Preliminary Examining Authority that is to carry out the international preliminary examination and a language of publication, unless such a translation has already been furnished to that Authority in its capacity as an International Searching Authority (see paragraph 6, above).

International Preliminary Report on Patentability (Chapter II) (Rule 70.17)

12. If Arabic is added as a language of publication, for as long as no International Preliminary Examination Authority accepts Arabic for the purposes of the international preliminary examination and thus a translation of an international application filed in Arabic is required under Rule 55.2 for the purposes of the international preliminary examination into a language which is both accepted by the International Preliminary Examining Authority that is to carry out the international preliminary examination and a language of publication (see above), the international preliminary report on patentability (Chapter II) would be in the language of that translation.

Changes in the International Application

13. *Amendments under Article 19.* If Arabic is added as a language of publication, where an international application is filed in Arabic, amendments under Article 19 would have to be filed in that language (see Rule 12.2(a)).

14. *Amendments under Article 34.* If Arabic is added as a language of publication, for as long as no International Preliminary Examination Authority accepts Arabic for the purposes of the international preliminary examination and thus a translation of an international application filed in Arabic is required under Rule 55.2 for the purposes of the international preliminary examination (see above), a translation of any amendments under Article 34 would have to be furnished into the language of that translation (that is, into a language which is both accepted by the International Preliminary Examining Authority that is to carry out the international preliminary examination and a language of publication).

15. *Rectification of obvious errors.* If Arabic is added as a language of publication, for as long as no International Searching Authority accepts Arabic for the purposes of the international search and no International Preliminary Examination Authority accepts Arabic for the purposes of the international preliminary examination, any rectification of an obvious error referred to in Rule 91.1(e)(ii) and (iii) would have to be filed in both Arabic (the language of filing of the international application) and, depending on the authority competent to authorize the rectification of the obvious error, in the language of the translation furnished under Rule 12.3(a) or 55.2(a).

Impact on Publication Process at the International Bureau

16. It is expected that the International Bureau could absorb the additional work related to the publication of international applications in Arabic without undue difficulty.

17. The Working Group is invited to consider the proposals contained in the Annex to this document.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²

ADDITION OF ARABIC AS A LANGUAGE OF PUBLICATION

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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 48

International Publication

48.1 and 48.2 [No change]

48.3 *Languages of Publication*

(a) If the international application is filed in [Arabic](#), Chinese, English, French, German, Japanese, Russian or Spanish (“languages of publication”), that application shall be published in the language in which it was filed.

(b) [No change] If the international application is not filed in a language of publication and a translation into a language of publication has been furnished under Rule 12.3 or 12.4, that application shall be published in the language of that translation.

(c) [No change] If the international application is published in a language other than English, the international search report to the extent that it is published under Rule 48.2(a)(v), or the declaration referred to in Article 17(2)(a), the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations shall be prepared under the responsibility of the International Bureau.

48.4 to 48.6 [No change]

[COMMENT: Note that Rule 48 is proposed to be further amended in the context of proposed amendments of the Regulations relating to missing elements and parts of the international application (see document PCT/R/WG/7/2), the restoration of the right of priority (see document PCT/R/WG/7/3), the rectification of obvious mistakes (see document PCT/R/WG/7/6) and relating to international publication and the PCT Gazette in electronic form (see document PCT/R/WG/7/8).]

[End of Annex and of document]

WIPO



PCT/R/WG/7/11

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Seventh Session
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PCT MINIMUM DOCUMENTATION:
ADDITION OF PATENT DOCUMENTS
OF THE REPUBLIC OF KOREA

Proposal by the Republic of Korea

SUMMARY

1. The Republic of Korea intends to propose to the PCT Assembly in September-October 2005 that Rule 34 be amended so as to include patent documents of the Republic of Korea in the PCT minimum documentation used in carrying out international searches. The Meeting of International Authorities Under the PCT has supported this proposal and has requested a task force to report on when the International Searching Authorities could be ready for this to be brought into force. The Working Group is invited to comment on the proposal.

BACKGROUND

2. The Korean Intellectual Property Office is among the top 10 in the world in terms of the number of patent applications received, both as a national Office and as a receiving Office under the PCT. An ever-increasing number of first patent filings are made with the Office, particularly in the fields of information technology and biotechnology, making Korean patent documents a particularly important source of technical information throughout the world.

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This is shown by the rapidly increasing use of the free Internet-based Korean patent document search service (KIPRIS¹) by users from outside the Republic of Korea.

3. The Korean Intellectual Property Office also acts as an International Searching and Preliminary Examining Authority and is aware of what data is necessary for patent documents of the Republic of Korea to be used as an effective search tool. All of these documents are available in electronic format (either image or full-text). English language abstracts of patents and published patent applications are available from 1979 onwards in searchable SGML format. The number and types of these documents are as follows:

<i>Type</i>	<i>Coverage</i>	<i>Format</i>	<i>Number of documents</i>
Granted patents	1948 to 1998	Image	456,000
	1979 to the present	SGML	144,000
Published patent applications	1983 to 1998	Image	412,000
	1983 to the present	SGML	1,058,000
English language abstracts	1979 to the present	SGML	550,000

4. All of the PCT International Authorities and many other national Offices have received CD-ROMs containing English language abstracts of patent documents of the Republic of Korea published since 1979. Some have also received CD ROMs containing the patent documents themselves. The Korean Intellectual Property Office and other International Authorities are currently discussing technical arrangements for ensuring suitable access to and updating of this documentation in electronic form to ensure that the information can be accessed efficiently as part of an international search, with a view to allowing all the Authorities to be ready to search Korean patent documents efficiently not later than January 1, 2006.

5. At its eleventh session in February 2005, the Meeting of International Authorities expressed its support for the proposal that patent documents from the Republic of Korea be included in the PCT minimum documentation. It requested a task force to report, by July 1, 2005, on when all the Authorities could be expected to be ready to efficiently search this documentation (see paragraph 22 of document PCT/MIA/11/14).

6. It is intended that this proposal be put to the Committee for Technical Cooperation for its opinion under PCT Article 56(3) and subsequently to the PCT Assembly, at its 34th session in September-October 2005, for a decision to amend Rule 34 with effect from a date to be recommended by the task force referred to in paragraph 5, above.

PROPOSAL

7. The Annex contains draft amendments to PCT Rule 34, which would include in the PCT minimum documentation patent documents published by the Korean Intellectual Property Office. The documents would include patents and published applications for patents and English language abstracts of patents or published patent applications, but not utility models.

¹ The service is available at <http://eng.kipris.or.kr>.

8. Equivalent to the current arrangements for patent documents in Japanese, Russian and Spanish which form part of the PCT minimum documentation, International Authorities for which Korean is not an official language would not be required to include patent documents of the Republic of Korean in their search collections unless an English language abstract was available. The practical result of this would be that the International Authorities, other than the Korean Intellectual Property Office, would only be required to include those documents published from 1979 onwards.

9. The Working Group is invited to comment on the proposals contained in the Annex to this document.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²

MINIMUM DOCUMENTATION:
PATENT DOCUMENTS OF THE REPUBLIC OF KOREA

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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 34

Minimum Documentation

34.1 *Definition*

(a) [No change] The definitions contained in Article 2(i) and (ii) shall not apply for the purposes of this Rule.

[COMMENT: In this rule, “patent” does not include types of protection for inventions other than patents, and “application” does not include applications for such other types of protection. Consequently, the proposals below do not extend to the utility models of the Republic of Korea.]

(b) [No change] The documentation referred to in Article 15(4) (“minimum documentation”) shall consist of:

(i) [No change] the “national patent documents” as specified in paragraph (c),

(ii) and (iii) [No change]

(c) [No change] Subject to paragraphs (d) and (e), the “national patent documents” shall be the following:

[Rule 34.1(c), continued]

- (i) [No change] the patents issued in and after 1920 by France, the former *Reichspatentamt* of Germany, Japan, the former Soviet Union, Switzerland (in the French and German languages only), the United Kingdom, and the United States of America,

- (ii) the patents issued by the Federal Republic of Germany, [the Republic of Korea](#) and the Russian Federation,

[COMMENT: The States whose patent documents are specifically listed as being included in the PCT minimum documentation are divided into two categories. Those which existed in 1920 are listed under paragraph (c)(i) and their patent documentation from that year onwards is included (subject to the provisos in paragraphs (d) and (e), below). States established after 1920 are listed in paragraph (c)(ii) and all patents from these States from the date of their creation form part of the PCT minimum documentation (subject to the same provisos).]

- (iii) [No change] the patent applications, if any, published in and after 1920 in the countries referred to in items (i) and (ii),

[COMMENT: Similarly, all the published applications for patents from States listed in paragraph (c)(ii) form part of the PCT minimum documentation, subject to the provisos in paragraphs (d), (e) and (f), below. The limitation by date is, of course, only relevant to the States listed in paragraph (c)(i).]

- (iv) to (vi) [No change]

[Rule 34, continued]

(d) [No change] Where an application is republished once (for example, an *Offenlegungsschrift* as an *Auslegeschrift*) or more than once, no International Searching Authority shall be obliged to keep all versions in its documentation; consequently, each such Authority shall be entitled not to keep more than one version. Furthermore, where an application is granted and is issued in the form of a patent or a utility certificate (France), no International Searching Authority shall be obliged to keep both the application and the patent or utility certificate (France) in its documentation; consequently, each such Authority shall be entitled to keep either the application only or the patent or utility certificate (France) only.

[COMMENT: As with other patent documents, the International Authorities would not be obliged to keep both a published application and a patent granted on the basis of that application in the Republic of Korea in their documentation.]

[Rule 34, continued]

(e) Any International Searching Authority whose official language, or one of whose official languages, is not Japanese, [Korean](#), Russian or Spanish is entitled not to include in its documentation those patent documents of Japan, [the Republic of Korea](#), the Russian Federation and the former Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than six months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

[COMMENT: International Authorities, other than the Korean Intellectual Property Office, would not be required to include patent documents from the Republic of Korea prior to 1979 in their documentation, since English abstracts are only available from that year onwards.]

(f) [No change] For the purposes of this Rule, applications which have only been laid open for public inspection are not considered published applications.

[COMMENT: Paragraph (f) is not relevant to patent documents from the Republic of Korea.]

[End of Annex and of document]