

C.PCT 1329

December 15, 2011

Madam,
Sir,

Review of the Supplementary International Search System

1. This Circular is addressed to your Office in its capacity as a receiving Office, International Searching Authority, International Preliminary Examining Authority and/or designated or elected Office under the Patent Cooperation Treaty (PCT). It is also addressed to certain intergovernmental and non-governmental organizations representing users of the PCT system.

2. It is recalled that the PCT Assembly, at its 36th session, held from September 24 to October 3, 2007, amended the PCT Regulations so as to introduce a supplementary international search system to the PCT. These amendments entered into force on January 1, 2009 (document PCT/A/36/13).

3. Along with adopting these amendments, the Assembly further adopted two decisions in relation to reporting on and reviewing the supplementary international search system. These decisions are set out in paragraph 153 of the report of the Assembly (document PCT/A/36/13), reproduced below:

“153. The Assembly

[...]

“(vi) decided that the International Bureau shall report to the Meeting of International Authorities under the PCT and to the Assembly on the financial and operational situation of the supplementary international search system; and

“(vii) decided that the Assembly shall review the supplementary international search system three years after the date of entry into force of the system.”

/...

4. In accordance with the decision by the PCT Assembly set out in paragraph 153(vi) of document PCT/A/36/13, reproduced in paragraph 3, above, the International Bureau reported on the financial and operational situation of the supplementary international search system at the most recent sessions of the PCT Meeting of International Authorities (held in March 2011) (document PCT/MIA/18/10) and of the PCT Working Group (held in June 2011) (document PCT/WG/4/11). The discussions at both meetings are detailed in the reports of the sessions (document PCT/MIA/18/16, paragraphs 69 to 74, and document PCT/WG/4/17, paragraphs 248 to 256, respectively). The PCT Assembly at its 42nd session, held from September 26 to October 5, 2011, also took note of the report presented previously to the Working Group (document PCT/A/42/4 Prov.). An update of the report on the financial and operational situation of the supplementary international search system (as at November 2011) is contained in Annex I to this Circular.

5. In accordance with the decision by the PCT Assembly set out in paragraph 153(vi) of document PCT/A/36/13, reproduced in paragraph 3, above, the primary purpose of this Circular is to gather further information and feedback on the functioning of the PCT supplementary international search system from both Offices in their various PCT capacities (as a receiving Office, International Searching Authority, International Preliminary Examining Authority and/or and designated or elected Office) as well as from organizations representing users of the PCT system. The preliminary findings will be presented for further discussion at the next session of the Meeting of the International Authorities under the PCT (to be held in February 2012). The feedback received in response to the Circular and the next Meeting of the International Authorities under the PCT will be used as input into the review of the supplementary international search system to be presented at the next session of the PCT Working Group (to be held in May 2012) and to the PCT Assembly at its 2012 session.

6. You are kindly requested to complete the Questionnaire attached in Annex II to this Circular and to return it to the International Bureau, or to submit any other comments you may have on the issues raised in the Questionnaire, by *January 31, 2012*, preferably by e-mail sent to my colleague Mr. Claus Matthes, Director, PCT Business Development Division (*claus.matthes@wipo.int*; fax: (+41-22) 338 7150; tel.: (+41-22) 338 9809). Responses to this Questionnaire may be submitted in any of the 6 official languages of the United Nations (Arabic, Chinese, English, French, Russian and Spanish).

7. In general, any response received in reply to this Circular will be presented in the report to be submitted to the PCT Assembly only in an anonymous fashion; individual responses from Offices or user organizations will not be attributed without the specific prior permission of the relevant Office or organization.

Yours sincerely,



James Pooley
Deputy Director General

Enclosures: Annex I – Update on the supplementary international search system
Annex II – Questionnaire

UPDATE ON THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

This Annex provides an update to the report on the supplementary international search system presented to the fourth session of the PCT Working Group (document PCT/WG/4/11).

International Authorities offering supplementary international search

To date, six International Authorities offer supplementary international searches. The Federal Service for Intellectual Property, Patents and Trademarks of the Russian Federation (ROSPATENT; SISA/RU), the Nordic Patent Institute (SISA/XN) and the Swedish Patent and Registration Office (SISA/SE) have offered supplementary international searches since the entry into force of the system on January 1, 2009. The National Board of Patents and Registration of Finland (SISA/FI) became a Supplementary International Searching Authority on January 1, 2010, followed by the European Patent Office (SISA/EP) and the Austrian Patent Office (SISA/AT), which began offering the service on July 1, 2010, and August 1, 2010, respectively.

Languages accepted for supplementary international search

All six International Authorities which offer supplementary international searches accept international applications which are filed in, or have been translated into, English. Other languages accepted for supplementary international search include: Danish (SISA/SE and SISA/XN); Finnish (SISA/FI); French (SISA/EP and SISA/AT); German (SISA/EP and SISA/AT); Icelandic (SISA/XN); Norwegian (SISA/SE and SISA/XN); Swedish (SISA/SE, SISA/FI and SISA/XN) and Russian (SISA/RU).

Documentation covered by Supplementary International Search

The documentation covered by the supplementary international search varies between International Authorities. For some International Authorities, a supplementary international search can be limited to documentation in specific languages where examiners at the Supplementary International Searching Authority have particular language capabilities and expertise. For example, SISA/RU offers a supplementary international search in patent document collections in Russian from countries of the former Soviet Union. SISA/AT offers a supplementary international search of only the German documentation or of only the European and North American documentation. In addition, both also offer a supplementary international search covering the PCT minimum documentation in certain instances, either by applicant choice according to the level of fee paid (SISA/AT), or else in cases where the "main" International Searching Authority has issued a declaration under PCT Article 17(2)(a) that no international search report will be established (SISA/RU).

All other Supplementary International Searching Authorities always perform a complete new search equivalent to the "main" international search, covering at least the entire PCT minimum documentation as well as whatever further documentation in local or other languages would also usually be searched.

Fees charged for Supplementary International Search

Relative to the international search fees, SISA/RU charges a supplementary international search fee equivalent to approximately 70% of fee it charges for the “main” international search, except for searches related to methods of treatment where a declaration from the International Searching Authority has been made under Article 17(2)(a). SISA/AT provides three levels of fees between 50 and 95% of the fee it charges for the “main” international search, depending on the documentation covered (German documentation only, European and North American documentation only, PCT minimum documentation). All other Authorities, all of which always search (at least) the entire PCT minimum documentation for the supplementary international search, charge the same amount of fees for supplementary searches as they do for the “main” international searches.

Demand for Supplementary International Search

Demand from applicants for supplementary international searches is still very low. In 2009, the first year in which the service was offered, 24 supplementary international searches were requested. In 2010, 41 international searches were requested. Provisional figures, as at the end of November 2011, show that 33 requests have been filed so far in 2011.

Almost all requests for supplementary international searches made to International Authorities (except to SISA/EP) had the European Patent Office as the “main” International Searching Authority. 80 of the 98 requests for supplementary international searches made were made to SISA/RU. The top four applicants requesting supplementary international searches accounted for more than 80% of all requests.

An analysis of the requests submitted in 2011 confirms the trend shown in 2009 and 2010. Most requests were made following receipt of a “main” international search report containing X or Y citations; a few requests were made even before the international search report was received. Some requests followed a finding by the International Searching Authority that the international application lacked unity of invention and the applicant requested the supplementary international search in respect of the inventions not searched during the “main” international search. In some cases, the request for supplementary international search was followed by a demand for international preliminary examination containing amendments of the international application.

Further Development of the Supplementary International Search System

As indicated in paragraphs 15 and 16 of document PCT/WG/4/11, the International Bureau has undertaken further activities to raise awareness of the supplementary international search system, including webinars and seminars given by the International Bureau to users of the PCT system, and a specific practical advice on the use of supplementary international search in the April 2011 edition of the PCT Newsletter.

[Annex II follows]

QUESTIONNAIRE

THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

Part A: Questions for International Authorities Offering Supplementary International Searches

- A1. If your Office in its capacity as an International Authority offers supplementary international searches, what are your main experiences with the system?
- A2. If your Office offers different types of supplementary international searches, in which ones were applicants most interested?
- A3. If your Office accepts several languages for supplementary international searches, in which languages were most supplementary international searches carried out?
- A4. Were there, in your opinion, specific reasons for applicants to request supplementary international searches at your Office (interest in specific documentation or subject matter, interest in another full search)?
- A5. Did your Office carry out supplementary international searches in cases where the “main” International Searching Authority had issued a declaration under PCT Article 17(2)(a) that no international search report will be established? If so, to which subject matter did the international application relate?
- A6. When carrying out supplementary international searches, did your Office take the international search report in account? If so, to which extent? If not, why not? Please elaborate.
- A7. Were the findings in the supplementary international search reports different from those in the “main” international search reports?
- A8. If documents found during the supplementary international searches were different from those found during the “main” international search, please elaborate on possible reasons. For example, were other documents found because the supplementary international search was carried out in documentation in specific languages or in documentation other than the minimum documentation? Or was the supplementary international search essentially the same as the “main” international search, but different parameters were used, such as different classification symbols?
- A9. In which cases did your Office find the supplementary international search particularly useful for applicants (in addition to the “main” international search)?

Part B: Questions for International Authorities Currently not Offering Supplementary International Searches

B1. What are the main reasons for your Office not offering supplementary international searches?

B2. Does your Office intend to offer supplementary international search in the near future? If so, please further explain the supplementary international search service your Office intends to offer.

Part C: Questions for all Offices

C1. Does your Office in its capacity as a designated Office have any experiences with international applications entering the national phase in respect of which a supplementary international search report had been established? If so, what are your main experiences with the system?

C2. What, in your view, are the main reasons for the low uptake of supplementary international search system?

C3. Do you have any further suggestions on how the awareness of the supplementary international search service among applicants could be improved?

C4. Do you have any suggestions what should be changed so that the supplementary international search system better meets users' needs?

C5. Do you have any further suggestions on ways of improving the overall attractiveness of the system for PCT applicants?

Part D: Questions for Users of the PCT System

D1. Are you aware of the supplementary international search system and have you considered using it?

D2. If you have used the supplementary international search system, what are your main experiences with that system?

D3. If you have used the supplementary international search system, would you consider using it again? If so, please specify the circumstances in which you would consider requesting supplementary international search again. If not, please specify the reasons why not.

D4. If you have not yet used the supplementary international search system, what are the main reasons for not doing so?

D5. Would you consider requesting supplementary international searches if specific Offices, which do not yet offer supplementary international search, would offer this service? If so, could you specify why this would make the supplementary international search service more attractive for you?

D6. Are you interested in supplementary international searches being carried out in specific other languages (at present, the International Authorities offering supplementary international search currently offer the service for international application filed in, or translated into, English, French, German, Danish, Finnish, Swedish, Icelandic, Norwegian and Russian)?

D7. Are you interested in supplementary international searches being carried out in specific subject matter? If so, please specify.

D8. What, in your view, are the main reasons for the low uptake of the supplementary international search system (such as lack of awareness, detailed knowledge, costs of the service, documentation covered in the "main" international search report sufficient not to warrant a further search)?

D9. Do you have any suggestions on how the awareness of the supplementary international search service among users could be improved?

D10. Do you have any suggestions what should be changed so that the supplementary international search system better meets user's needs?

D11. Do you have suggestions for alternative ways in which the objective of increasing the scope of prior art searched effectively during the international phase could be achieved more effectively?

D12. Do you have any further suggestions on ways of improving the overall attractiveness of the system for PCT applicants?

[End of Annex II and of Circular]