

WIPO



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

ASSEMBLY

Thirty-Sixth (16th Ordinary) Session
Geneva, September 24 to October 3, 2007

SUPPLEMENTARY INTERNATIONAL SEARCH:
PROPOSED AMENDMENTS OF THE PCT REGULATIONS

Proposal submitted by France

PROPOSAL

1. The following proposal, received by the Director General from the Delegation of France on August 6, 2007, relates to the proposed supplementary international search system in relation to which the text of possible appropriate amendments of the Regulations under the Patent Cooperation Treaty (PCT)¹ is set out in Annex II of document PCT/A/36/1:

¹ References in this document to “Articles” are to those of the Patent Cooperation Treaty (PCT) or to those of the agreements with International Authorities under PCT Articles 16(3)(b) and 32(3), and references to “Rules” are to those of the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be.

“INPI
NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY

THE DIRECTOR GENERAL

“Paris, August 6, 2007

“Mr. Kamil Idris
Director General
WIPO
34, chemin des Colombettes
P.O. Box 18
CH-1211 Geneva 20

“Subject: Proposed amendment of the Regulations under the Patent Cooperation Treaty in order to introduce a supplementary international search system

“Dear Director General,

“During the last session (9th session, April 23-26, 2007), the Working Group on Reform of the Patent Cooperation Treaty conducted a detailed examination of the text of a proposal relating to a supplementary international search system, discussed since 2004, and contained in document PCT/R/WG/9/2 and 2 Corr. During the meeting, the Chairman concluded that an agreement had been reached on the text of the amendments that should be made to the Regulations with a view to introducing this system, subject to the observations and clarifications expressed during the meeting and possible amendments of form to be made by the Secretariat.

“However, the Working Group did not reach a consensus concerning the forwarding, for adoption, of this proposal to the PCT Union Assembly, as two delegations opposed it.

“The Chairman concluded that the Working Group would send to the Assembly a detailed report containing a copy of the text of the proposed amendments to be made to the Regulations, approved by the participants in the meeting. The Assembly is invited only to note the content of the report of the session (document PCT/R/WG/9/8, a report reproduced in Annex I of the document submitted to the Assembly, PCT/A/36/1). As a result of this situation, the Assembly will not take a decision on the proposal, unless an explicit request from a Contracting State invites it to do so.

“In view of this information, I wish to express to you, Director General, France’s desire to invite the Assembly to examine the proposal relating to a supplementary international search system, and to adopt the text of the amendments to the Regulations contained in Annex II of document PCT/A/36/1. France also invites the Assembly to take all the measures necessary to implement these amendments.

“I wish to specify to you the reasons which lead France to open the debate on this proposal within the PCT Union Assembly.

“Firstly, in general terms it is important to reaffirm the principle according to which the international search must allow the fullest possible prior art to be disclosed. The proposal by the International Bureau allows applicants to request, during the international phase of the PCT application, additional international searches. The proposal is therefore in the interest of users, allowing them to have a clearer vision of the prior art during the international phase. It has, moreover, been supported by the vast majority of the users’ groups during the last Working Group session.

“The interest in this proposal is to introduce an optional system, both for applicants, for which this would be a supplementary service offered by the PCT, and for international authorities which can choose not to join the system.

“The system also provides a certain flexibility for International Authorities in the implementation of supplementary international searches, as a result of which the organization of their in-house work would not be modified.

“In conclusion, this proposal provides a practical and pragmatic response to an expectation on the part of users, while retaining a certain flexibility for International Authorities.

“For all these reasons, I wish you, Director General, to bring to the attention of the other delegations France’s request, and for you to take the measures necessary for this proposal to be inserted, for adoption, in the agenda of the PCT Union Assembly and to be the subject of discussion during the Assembly.

“Yours faithfully,

[signed]

“Benoît BATTISTELLI”

2. If the Assembly decides to adopt the amendments of the Regulations as proposed by the Delegation of France, it would be necessary to take decisions with regard to the entry into force of those amendments and also to agree upon consequential changes to the agreements under Article 16(3)(b) between the International Bureau and those International Searching Authorities which are prepared to carry out supplementary international searches. Draft texts relating to those matters, prepared by the International Bureau, are set out in the following paragraphs.

CONSEQUENTIAL MATTERS: ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

3. If amendments of the PCT Regulations relating to the introduction of a supplementary international search system were to be adopted by the Assembly as proposed by the Delegation of France, time would be required by those International Searching Authorities that are prepared to carry out supplementary international searches and by the International Bureau to implement the necessary changes, in particular to the procedural and legal framework and to related IT systems. For this purpose, it would be appropriate to allow for about 15 months to elapse from the adoption of the amendments.
4. As to transitional arrangements, it would be appropriate for the amendments to apply not only to international applications filed after the date of entry into force but also to pending applications for which it would still be practicable, having regard to the time limits involved, for a supplementary search request to be requested and carried out.
5. The following draft decision in relation to entry into force and transitional arrangements would thus be proposed for consideration by the Assembly in the event that it decided to adopt amendments of the Regulations as proposed by the Delegation of France:

“The amendments of the Regulations under the PCT set out in Annex II of document PCT/A/36/1 shall enter into force on January 1, 2009, and shall apply:

- (i) to international applications whose international filing date is on or after January 1, 2009; and
- (ii) to any international application whose international filing date is before January 1, 2009, and in respect of which the time limit for making a supplementary search request under new Rule 45*bis*.1(a) expires on or after January 1, 2009.”

6. It is to be noted, of course, that in any event supplementary international searches will not be available in practice until such time as at least one International Searching Authority is prepared to offer that service.

CONSEQUENTIAL MATTERS: AGREEMENTS UNDER PCT ARTICLE 16(3)(b)

7. The existing agreements under PCT Article 16(3)(b) between the International Bureau and International Authorities are due for renewal and proposed texts are set out in document PCT/A/36/4. If amendments of the Regulations relating to the introduction of a supplementary international search system were to be adopted by the Assembly as proposed by the Delegation of France, certain further provisions would be needed in the agreements with those Authorities that wished to offer supplementary international searches, and it would therefore be appropriate for the Assembly to approve the inclusion of such further provisions at the same time as adopting the amendments of the Regulations.
8. The changes which would be needed relate to the following provisions of the amended Regulations:
 - (i) Rules 45*bis*.1(e)(ii) and 45*bis*.9(a) providing for the inclusion in the applicable agreement of a statement that the Authority concerned is prepared to carry out supplementary international searches (see also item (iii), below);

(ii) Rule 45bis.5(f) providing for the applicable agreement to indicate the documentation covered in supplementary international searches by the Authority;

(iii) Rules 45bis.5(g) and 45bis.9(a) and (c) relating to limitations and conditions, set out in the applicable agreement, as to the competence of the Authority to carry out supplementary international searches.

9. The agreements would also need to take account of Rules 45bis.3(a) and (e) and 45bis.6(c) which would provide, respectively, for the charging of a supplementary search fee, for refunds of the supplementary search fee in certain circumstances, and for the charging of a review fee in certain circumstances. No change to the texts proposed in document PCT/A/36/4 would be needed for this purpose, however, since fee-related matters are already sufficiently covered in each of the draft agreements; specifically, proposed Article 5(1) and (2) of the draft agreements provide for such matters to be included in Annex C thereof, and Annex C can be amended by notification of the Authority concerned under the proposed text of Article 11(3)(ii).

10. A further provision in Rule 45bis.4(f) would entitle an Authority offering supplementary international searches to require the International Bureau to provide translations in certain cases of the written opinion established by the International Searching Authority during the main international search. No express provisions appears to be needed in the agreements in relation to that matter, which would be dealt with like other such requirements by way of information published in the PCT Applicant's Guide.

11. The following new provisions would thus, in the event that the Assembly decided to adopt amendments of the Regulations as proposed by the Delegation of France, be proposed for inclusion in the agreement with any Authority which notifies the Director General that it is prepared to carry out supplementary international searches:

(i) as a new paragraph to be added to Article 11 of the applicable agreement:

“(4) The Authority shall conduct supplementary international searches in accordance with Rule 45bis, covering at least the documentation referred to in Annex E to this agreement, subject to any limitations and conditions set out in that Annex.”

(ii) as a new item to be added to Article 11(3) of the applicable agreement:

“(iv) amend the indications and information concerning supplementary international searches contained in Annex E to this Agreement.”

(iii) as a new Annex to be added to the applicable agreement:

“Annex E
“Supplementary International Search:
Documentation Covered; Limitations and Conditions”

“[the relevant indications and information to be included in Annex E to be provided by the Authority concerned]”

12. The effective date of the changes referred to in the preceding paragraph could not, of course be before the entry into force of the amendments of the Regulations, and would be left as a matter for the Authority concerned and the Director General to agree upon.

13. The Assembly is invited to decide whether to adopt the proposed amendments of the PCT Regulations set out in Annex II of document PCT/A/36/1 relating to the introduction of the supplementary international search system, as proposed by the Delegation of France.

14. In the event that the Assembly decides to adopt those amendments, it is further invited:

(i) to adopt the draft decision proposed in paragraph 5 of the present document concerning entry into force and transitional arrangements;

(ii) to note that supplementary international searches will not be available in practice until such time as at least one International Searching Authority is prepared to offer that service;

(iii) to approve the inclusion in the applicable agreement under PCT Article 16(3), where an International Searching Authority notifies the Director General that it is prepared to carry out supplementary international searches, of the provisions set out in paragraph 11 of the present document with effect from a date to be agreed upon by the Authority and the Director General.

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