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

**MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PATENT COOPERATION TREATY (PCT)**

**Tenth Session
Geneva, September 13 to 15, 2004**

**ENHANCED INTERNATIONAL SEARCH AND
PRELIMINARY EXAMINATION SYSTEM:
REVIEW OF EXPERIENCE**

Document prepared by the International Bureau

SUMMARY

1. The Meeting is invited to discuss experiences of the new enhanced international search and preliminary examination system and to make recommendations on how to handle issues which have arisen, including those set out in the Annexes (how to divide between the international search report and the written opinion of the International Searching Authority the reasoning of why some or all of the claims may not have been searched; investigation of priority and availability of priority documents; reissued international search reports and written opinions; and administrative arrangements for making processing by the International Bureau easier).

BACKGROUND

2. In 2002, the PCT Assembly adopted a major package of amendments of the Regulations under the PCT, including the introduction of an “enhanced international search and preliminary examination system” whereby a written opinion is established by the International Searching Authority at the same time as the international search report (or declaration under Article 17(2)) for all international applications filed on or after January 1, 2004 (see document PCT/A/31/10).

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3. Consequential on this change, there were also many modifications to the Administrative Instructions under the PCT, including the Forms which are defined therein, and the PCT International Search Guidelines and PCT International Preliminary Examination Guidelines were replaced by combined PCT International Search and Preliminary Examination Guidelines (“the Guidelines” – see document PCT/GL/ISPE/1).

ISSUES

4. The first written opinions under this new system have now been established. While it will be some time yet before there is experience of all aspects of the new system, as most of these international applications will not enter the national phase and require communication of international preliminary reports on patentability to designated Offices until after July 2005, it would be useful to share experience of the system which has been gained so far by International Authorities and the International Bureau, and for suggestions to be made concerning how the processing of international applications can be made easier, more effective and more consistent.

5. Issues to be raised may include matters where the Regulations, Administrative Instructions, Forms or Guidelines have been found to be difficult to operate, ambiguous or insufficient. Alternatively, they may include observations on matters where errors are commonly found to occur, or simple procedural improvements which might aid efficient processing.

6. The Annexes to this document contain examples of issues which have been raised with or by the International Bureau, on which the Meeting may wish to give an opinion and guidance on how any changes to the system or recommended procedure should be effected. For the stability of the system, the International Bureau considers it desirable that the Regulations and Administrative Instructions should not be changed unless absolutely necessary until fuller experience has been gained of the whole of the new system. Furthermore, due to the limited time available in this session, it is proposed that the Meeting should not consider the detail of any necessary amendments to the Guidelines or other instruments at this stage.

7. *The Meeting is invited to:*

(a) exchange experience on the operation so far of the enhanced international search and preliminary examination system;

(b) formulate proposals for the appropriate handling of issues raised, including those in the Annexes; and

(c) indicate whether a review of the Guidelines, or other instruments, is necessary in the immediate future.

[Annex I follows]

ANNEX I

INTERNATIONAL APPLICATIONS ON WHICH NO SEARCH CAN BE PERFORMED:
CONTENT OF DECLARATION UNDER ARTICLE 17(2) AND WRITTEN OPINION
OF THE INTERNATIONAL SEARCHING AUTHORITY

1. If an international application relates to a subject matter which the International Searching Authority is not required to search (and decides not to search), or if it is not possible to perform any meaningful international search (as may be the case, for example, for some “complex applications”) Article 17(2) requires the International Searching Authority to make a declaration to that effect. A similar indication must also appear in Box No. III of the written opinion of the International Searching Authority (Form PCT/ISA/237).

Presenting the Reasoning

2. Paragraph 15.29 of the Guidelines indicates that the reasons for which no international search is established for some or all of the claims should be set out in Box No. II of the international search report (Form PCT/ISA/210) (if a search report is established only in respect of certain of the claims) or the declaration under Article 17(2) (Form PCT/ISA/203) (if no search is established at all). However, the Guidelines are silent as to the level of detail required. Particularly as regards any declaration under Article 17(2), it may be desirable that the Authorities take a common line with regard to reasoning, indicating that a fully reasoned explanation should be given for no international search being established. Including the full reasons here means that they can be seen when they are published in the pamphlet. The Guidelines go on to state that it will usually be sufficient for the written opinion simply to refer to the explanation in the declaration.

Trivial Non-Excluded Subject Matter

3. A related matter of presentation involves how to deal with cases which are essentially characterized by subject matter which the International Searching Authority is not required to search, but which includes a trivial searchable component. By way of a simple example, the claims might relate to a standard computer characterized by a computer program which does not have any technical effect. It would be possible to conduct a search for the computer, but since it does not have any special technical features in order to allow it to run the program, this could reveal thousands of potential citations.

4. There may be doubt in such cases as to whether such claims should be excluded from the international search altogether, or whether the non-excluded aspect of the claims should be searched (with the potential result mentioned in paragraph 3, above). In either case, there is doubt as to how the issue should be presented in the international search report and in the written opinion.

(a) If the claims were excluded from the international search altogether, the reasoning could be presented in the international search report (if some claims were searched) or the declaration under Article 17(2) (if all claims were excluded), so that the issues would be apparent to a person reading the pamphlet. An explanation might need to be included to the effect that Article 17(2) was being invoked despite the fact that the claims contained searchable matter since the search would be pointless. As a variation on this, where the searchable matter is so trivial that it belongs to general common knowledge, an explanation could be made in Box No. III of the written opinion of the International Searching Authority that the only matter not excluded lacks novelty or inventive step.

(b) Searching the non-excluded aspect of the claims, even though it is trivial, might be viewed as a better service to the applicant, but could be misleading, especially to third parties who would not see the written opinion along with the search report published in the pamphlet, since it would look as if the claims had been searched, even though the characterizing portion might not be addressed by the citations. If this approach were taken, the objection explained in the written opinion ought presumably to be based on the grounds of novelty or of inventive step, with a clear explanation that the remainder of the claim consists of matter excluded from search and examination under Rules 39 and 67.

[Annex II follows]

ANNEX II

INVESTIGATION OF VALIDITY OF PRIORITY AT
THE INTERNATIONAL SEARCH STAGE

BACKGROUND

1. Box No. II of Form PCT/ISA/237 (written opinion of the International Searching Authority) permits comments to be made concerning the priority claims in the international application in the event that prior art has been found in the international search, the relevance of which depends on whether or not the priority claim is valid (see paragraph 6.06 of the Guidelines).
2. While considering drafts of the Forms and Guidelines necessary to implement the new system, the Meeting recognized that, in a large number of cases, it would not be possible for the International Searching Authority to express a view on the validity of the claimed priority since the time limit under Rule 17.1 for furnishing the priority document will usually not have expired at the time that the written opinion of the International Searching Authority is established. There would also not usually be time to request and receive a translation under Rules 43*bis*.1 and 66.7(a) of any priority document which had been furnished, if that were required. The Meeting concluded that in these circumstances the written opinion should be established, stating the assumption that the claimed priority was valid but noting that it had not been possible to confirm this because the priority document (or translation) had not been furnished (see paragraph 74 of document PCT/MIA/8/6).
3. Consequently, the standard text items which appear in Box No. II of Form PCT/ISA/237 are as follows:

- “1. The following document has not yet been furnished:
copy of the earlier application whose priority has been claimed (Rules 43*bis*.1 and 66.7(a)).
translation of the earlier application whose priority has been claimed (Rules 43*bis*.1 and 66.7(b)).
Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date is the claimed priority date.
- “2. This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43*bis*.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.
- “3. Additional observations, if necessary:”

ISSUE

4. At least one of the International Authorities has decided never to request a copy of the priority document from the International Bureau at the international search stage when it is not available from its own files and instead to check the boxes under item 1 in Box No. II of Form PCT/ISA/237 indicating that the priority document has not been furnished. However, the standard texts were not drafted with this approach in mind and if the applicant has already furnished the priority document to the receiving Office or the International Bureau checking these boxes is misleading. In a number of cases the applicant has contacted the International Bureau to find out whether the document which he had furnished had been lost.

OPTIONS

5. This problem should be alleviated in the future by the provision of a digital library for priority documents which can be accessed on demand by the International Authorities. However, in the meantime, there appear to be three main options:

(a) Authorities should always request a copy of the priority document from the International Bureau if the validity of the priority date is a relevant issue and if the Authority does not already have a copy of that document. The relevant Authority is reluctant to do this since it would lead to significant delays and increased costs.

(b) The International Bureau could systematically supply copies of priority documents to the International Searching Authority as soon as they are received from the applicant or receiving Office (except where it is clear that the International Searching Authority would have access to them, because they were filed at that Office). This would be very expensive if done on paper, given the small proportion of applications for which the validity of the priority date is actually a relevant issue.

(c) Box No. II of Form PCT/ISA/237 could be amended so that item 1 allowed for this situation, either explicitly by introducing new options indicating that the document had not been requested, or else by amending the text to indicate that the validity of the priority had not been checked, without specifying the reasons.

[Annex III follows]

ANNEX III

REISSUE OF SEARCH REPORTS AND WRITTEN OPINIONS

1. It is occasionally necessary for an International Searching Authority to reissue an international search report to correct an error after the international search report and written opinion of the International Searching Authority have been transmitted to the applicant. Similarly an error might be found in the written opinion.

2. A number of issues arise from such a step; those under (a), below, are questions which could have arisen under the system prior to January 1, 2004, but that under (b) is specific to the new system.

(a) Various time limits depend on the date of transmittal of the international search report (such as the date by which Article 19 amendments should be filed, or the date by which a demand should be made):

(i) should the date of transmittal of the corrected version of the document be considered as the date of transmittal of the international search report and written opinion of the International Searching Authority for the purposes of further processing of the international application, including calculating time limits?

(ii) should the answer to the above be different, depending on whether the error was a substantive one (an incorrect citation, requiring the applicant to consider the correct citation properly before deciding how to proceed) or a more formal one (such as an incorrect classification or indication of the name of the applicant, which is not relevant to the validity of any patent which might be granted)?

(b) Rule 44.1 requires that the International Searching Authority transmit a copy of the international search report and the written opinion established under Rule 43*bis* to the applicant on the same day. If the error affects only the search report or the written opinion, is it necessary to transmit the document which is unchanged (save possibly for an updated date of transmission) in addition to the one in which the error has been corrected?

[Annex IV follows]

ANNEX IV

TRANSMITTAL OF THE INTERNATIONAL SEARCH REPORT
AND WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

1. In a number of cases, the international search report has not been accompanied by the written opinion when it is transmitted to the International Bureau and the applicant, as required under Rule 44.1. While it is understood that steps have been taken by Authorities to ensure that this does not occur in future, it should be emphasized that it is important that the same mailing date appear on both documents, as the calculation of certain time limits are based on the date of transmittal and the inclusion of different dates may cause uncertainty.
2. For efficient processing by the International Bureau, it would also be helpful if, when mailing these documents, the International Searching Authority could place the written opinion on top of the international search report and attach both documents together physically, preferably either with paper clips or staples.

[End of Annex IV and of document]