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

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

**First Session**

**Geneva, November 12 to 16, 2001**

**IMPROVED COORDINATION OF INTERNATIONAL SEARCH AND  
INTERNATIONAL PRELIMINARY EXAMINATION AND  
THE TIME LIMIT FOR ENTERING THE NATIONAL PHASE**

*Document prepared by the International Bureau*

## BACKGROUND<sup>1</sup>

1. At its first session, the Committee on Reform of the PCT (“the Committee”) based its discussions of the matter of improved coordination of international search and international preliminary examination and the time limit for entering the national phase on document PCT/R/1/2 as well as comments and proposals made in other documents. The Committee recommended to the Assembly of the International Patent Cooperation Union (PCT Union) that the matter should be referred to the Working Group (see document PCT/R/1/26, paragraph 70):<sup>2</sup>

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<sup>1</sup> This and other working documents for the Working Group’s session are available on WIPO’s Internet site at [http://www.wipo.int/pct/en/meetings/reform\\_wg/index\\_1.htm](http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm).

<sup>2</sup> Document PCT/R/1/2 contains proposals made by the United States of America. Many of the other documents which were before the Committee comment on those proposals or contain other proposals. The documents, as well as the Committee’s report, are available on WIPO’s Internet site at [http://www.wipo.int/pct/en/reform/index\\_1.htm](http://www.wipo.int/pct/en/reform/index_1.htm).

“70. Discussions were based on document PCT/R/1/2, Annex, pages 4 and 5, items (6), (7) and (9), as well as comments and proposals made in other documents. The following principles, comments and concerns were expressed by various delegations:

- (i) the reason for having different time limits in Articles 22 and 39(1) was questioned;
- (ii) some applicants request international preliminary examination only in order to “buy” extra time, and in such cases the resources of the International Preliminary Examining Authority are not being used to best advantage;
- (iii) delaying the national phase until 30 months from the priority date in all cases would result in fewer demands for international preliminary examination, thus affording relief to some International Preliminary Examining Authorities which are facing an increasing workload that they can no longer manage;
- (iv) merely delaying the national phase until 30 months from the priority date in all cases could have some adverse consequences, including greater uncertainty for third parties and the fact that a smaller proportion of international applications would be accompanied by an international preliminary examination report, which would lead to delayed and duplicated examinations in the national phase;
- (v) there would be adverse consequences, especially for smaller designated and elected Offices and particularly those in developing countries, if a smaller proportion of international applications entering the national phase were accompanied by international preliminary examination reports;
- (vi) the time limits in Articles 22 and 39(1) could be modified by a unanimous decision of the Assembly; in the longer term, the Articles could be revised to remove or alter the distinction between the international search and international preliminary examination procedures;
- (vii) the possibility of changing time limits under national laws was not favored as an approach, since it is unlikely that all laws would be changed at the same time, leading to a multiplicity of systems and confusion for applicants;
- (viii) greater efficiency and more flexibility would flow from an appropriate degree of amalgamation of the international search and international preliminary examination procedures;
- (ix) a more coordinated approach to international search and international preliminary examination could reduce duplication of work in the International Searching and International Preliminary Examining Authorities;
- (x) the present clear distinction between the Chapter I and II procedures is a central feature of the PCT system which should not be eliminated lightly or in response to temporary problems;
- (xi) confusion and errors often result at present from the inter-relationship between the time limit for filing a demand (19 months from the priority date) and the

time limit for entering the national phase if no demand was filed (20 months from the priority date);

(xii) applicants from developing countries find the present international preliminary examination procedure complicated and expensive;

(xiii) international preliminary examination should not become mandatory; rather, applicants should be given more choice in the procedures available;

(xiv) the option for applicants to request early national phase processing should in any event be retained;

(xv) there may be sound reasons, not constituting abuse, why applicants might wish to “buy” time before deciding whether to enter the national phase – notably, where the international search report or international preliminary examination report is not available before the expiration of the applicable time limit;

(xvi) more flexibility could also be introduced in terms of the time limit for filing a translation when entering the national phase.”

2. Subsequent to the session of the Committee, the Assembly agreed with the Committee’s recommendations.<sup>3</sup>

#### POSSIBLE NEW APPROACH: EXPANDED INTERNATIONAL SEARCH REPORT PLUS OPTIONAL FULL INTERNATIONAL PRELIMINARY EXAMINATION

3. A proposal for a new approach to PCT search and examination was considered by the Committee (see document PCT/R/1/26, paragraph 71):

“71. A proposal made at the meeting by the Delegation of the United States of America found interest among delegations as a possible starting point for priority consideration by the working group, which should prepare options and alternative approaches for later consideration by the Committee. That proposal, with further suggestions made in the discussion, had the following basic features:

(i) an expanded international search report which would contain, in addition to its present contents, a first opinion as to patentability (such as is produced in the first written opinion during the present international preliminary examination procedure);

(ii) that first opinion could be published with or after the international application and the rest of the search report, subject to a possible right of the applicant to first rebut the opinion;

(iii) full international preliminary examination would be undertaken only if the applicant took further, definite, steps to initiate it in reply to the first opinion;

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<sup>3</sup> See WIPO’s Internet site at [http://www.wipo.int/eng/document/govbody/wo\\_pct/index\\_30.htm](http://www.wipo.int/eng/document/govbody/wo_pct/index_30.htm). The Assembly’s report (document PCT/A/30/7) may not be available in final form at the date of this document but is expected to be available shortly thereafter.

(iv) the time limit for entering the national phase would in any event be 30 months from the priority date;

(v) the fee structure for international search and international preliminary examination would require modification accordingly.”

4. See paragraphs 14 to 39, below, for further discussion.

#### MODIFICATIONS OF THE TIME LIMITS FIXED IN ARTICLE 22(1)<sup>4</sup>

5. Subsequent to the first session of the Committee, the Assembly decided to modify the time limit for entering the national phase under Chapter I of the PCT (Article 22(1); see the proposals in documents PCT/A/30/4 and 4 Add., and the Assembly’s report in document PCT/A/30/7<sup>5</sup>). That time limit is presently 20 months from the priority date but will, with effect from April 1, 2002 (subject to transitional arrangements), be changed to 30 months – that is, the same as the time limit which presently applies under Chapter II in cases where the applicant requests international preliminary examination (IPE) by filing a demand within 19 months from the priority date (Article 39(1)(a)).

6. The modification was made in the light of the growth rate in filing of international applications, which has been and continues to be remarkably high. That growth has generated an enormous increase in workload. In particular, the major International Preliminary Examining Authorities (IPEAs) are now starting to have difficulty in fulfilling their obligations to prepare international preliminary examination reports (IPERs) of high quality in a timely fashion. The modification of the time limit is intended, in particular, to avoid a workload crisis for the major IPEAs, while keeping an appropriate balance between the interests of applicants, third parties and Offices.

7. The modifications of the time limits, which will take some time to implement fully, can be seen as representing a first step in streamlining PCT procedures to make better use of resources and provide better service to applicants and Offices. Proposals such as that mentioned in paragraph 3, above, could be implemented relatively quickly – for example, during the transition period that will be necessary before the modified time limits fully enter into force.

#### PRESENT SYSTEM OF PCT SEARCH, EXAMINATION AND NATIONAL PHASE ENTRY

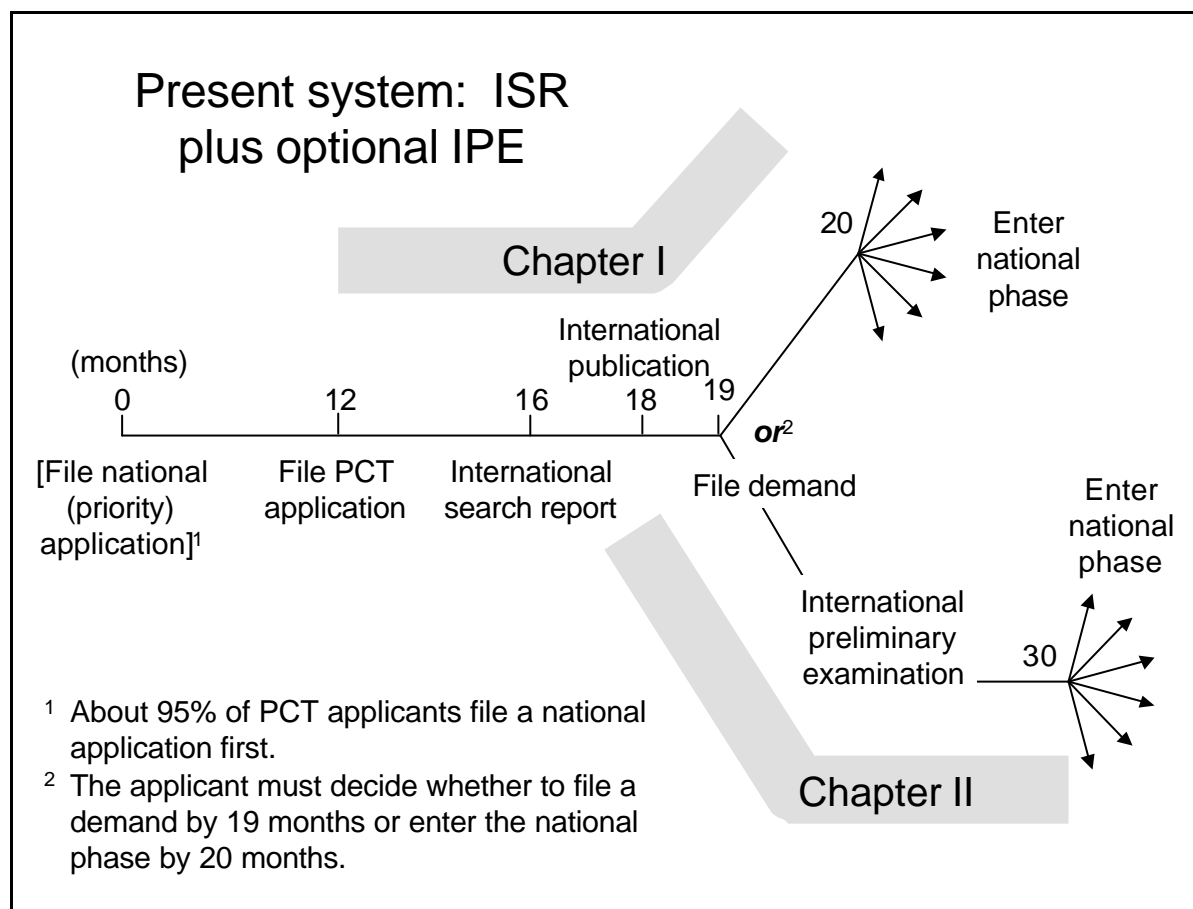
8. The main features of the present system of PCT search, examination and national phase entry are illustrated in Figure 1 and outlined in the following paragraphs. The purpose of the outline is not so much to explain the details of the present system but rather to highlight

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<sup>4</sup> References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO’s Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>. References to “national law,” “national applications,” “national Offices,” etc., include reference to regional law, regional applications, regional Offices, etc.

<sup>5</sup> See footnote 3.

certain features which should be borne in mind in considering how the system might be restructured.



**Figure 1**

### *International search*

9. The international search (IS) procedure is governed primarily by Articles 15 to 18, Rules 33 to 45 and Sections 500 to 516. Important features of the procedure to bear in mind in the present context are the following:

- (i) every PCT application is subjected to an IS (apart from exceptions which arise rarely in practice – Article 17(2) and Rule 39);
- (ii) the IS is undertaken by one of the International Searching Authorities (ISAs) appointed by the Assembly (Article 16 and Rule 36);<sup>6</sup>
- (iii) the ISA must be competent having regard to the receiving Office with which the application was filed – that is, the ISA must be prepared to act for applications

<sup>6</sup> The following Offices hold appointments as ISAs: the Australian Patent Office, the Austrian Patent Office, the Chinese Patent Office, the European Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, the Russian Patent Office, the Spanish Patent and Trademark Office, the Swedish Patent Office and the United States Patent and Trademark Office.

filed with the receiving Office concerned (this matter is specified in the Agreement referred to in item (v), below), and the receiving Office must have specified the ISA as competent (Rule 35);<sup>7</sup>

- (iv) a search fee, fixed by the ISA, is payable in respect of the IS (Articles 3(4)(v) and 14(3) and Rule 16);<sup>8</sup>
- (v) the IS is carried out in accordance with the Treaty, the Regulations and the Agreement between the ISA and the International Bureau (Article 17(1)), and with the “common rules” of international search (Article 16(3)(b)), which include the PCT International Search Guidelines (document PCT/GL/IS/1<sup>9</sup>) in addition to the relevant provisions of the PCT, the Regulations and the Administrative Instructions;
- (vi) the objective of the IS is to discover relevant prior art (Article 15(2) and (4)); the scope of the prior art that is required to be taken into account by the ISA is governed by the PCT (Article 15(4) and Rules 33, 34 and 36); the international search report (ISR) accordingly contains citations of relevant prior art documents and an indication of their relevance; the main part consists of citations of prior art documents considered to be relevant, categorized according to their relevance as “X,” “Y,” “A,” etc.,<sup>10</sup> and an indication of the claims to which the citations are considered to be relevant (see Rule 43.5(a) and (c) and Sections 505, 507 and 508);
- (vii) additional matter beyond citations of prior art is in general excluded from the ISR: “The international search report shall contain no matter other than that specified in Rules 33.1(b) and (c), 43.1 to 43.3, 43.5 to 43.8, and 44.2, and the indication referred to in Article 17(2)(b), provided that the Administrative Instructions may permit the inclusion in the international search report of any additional matter specified in the Administrative Instructions. The international search report shall not contain, and the Administrative Instructions shall not permit the inclusion of, any expressions of opinion, reasoning, arguments, or explanations.” (Rule 43.9);
- (viii) the ISR is required to be issued within three months from the date of receipt of the search copy by the ISA or within nine months from the priority date, whichever expires later; in practice, in an average case where the application is filed at the

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<sup>7</sup> Special provisions apply where the application was filed with the International Bureau as receiving Office (Rule 35.3).

<sup>8</sup> The amount of the search fee varies from 150 to 1,460 Swiss francs (equivalent), depending on the ISA concerned. A reduction may be available where the ISA can use the results of an earlier search or where the applicant qualifies on the basis of nationality and residence in one of certain countries with low per capita national income. (See Annex D of the PCT Applicant’s Guide.)

<sup>9</sup> See WIPO’s Internet site at <http://www.wipo.int/pct/en/gdlines.htm>.

<sup>10</sup> Category “X” applies where a document is such that when taken alone, a claimed invention cannot be considered novel or cannot be considered to involve an inventive step. Category “Y” applies where a document is such that a claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art. Category “A” applies where categories “X” and “Y” do not apply but where a document defines the general state of the art. There are also other categories that are rarely used in practice.

end of the priority year, this means that the ISR must be issued within 16 months from the priority date (see Article 18(1) and Rule 42 read with Rules 22.1(a) and 23.1(a)) – that is, before the international publication (see item (x), below) and before the time limit for entry into the national phase under Chapter I (see paragraph 12(iii), below);

- (ix) the ISR is transmitted by the ISA to the applicant and to the International Bureau (Article 18(2) and Rule 44.1);
- (x) the “pamphlet” of the international application, which is the form in which the application is internationally published under the PCT 18 months after the priority date, includes the ISR as well as the application itself (Article 21(3) and Rule 48.2(a)(v)); in the event that the ISR is not available at the time of international publication, it is published later (Rule 48.2(g));
- (xi) the claims (and only the claims) may be amended during the period of two months from the sending of the ISR or 16 months from the priority date, whichever expires later (Article 19 and Rule 46); this permits the application to be published with claims revised in the light of the ISR with a view to strengthening “provisional protection” in those designated States where it is available (see Article 29);
- (xii) the applicant has to pay additional fees if the ISA finds that the application does not comply with unity of invention requirements; otherwise, the search will be restricted (Article 17(3) and Rule 40).

#### *International preliminary examination*

10. The IPE procedure is governed by Chapter II of the Treaty (Articles 31 to 42 and Rules 53 to 78). Important features of the procedure to bear in mind in the present context are the following:

- (i) the IPE procedure is optional for the applicant (Article 31(1) and (2)(a)); if the applicant chooses to request IPE, there are consequences for the application in both the international phase and the national phase;
- (ii) Contracting States may opt not to be bound by Chapter II (Articles 31(4)(b) and 64(1)), but all present Contracting States are in fact bound;
- (iii) fees are payable in respect of the IPE, for the benefit of the IPEA (preliminary examination fee, fixed by the IPEA) and of the International Bureau (handling fee, fixed in the Schedule of Fees to the Regulations) (Articles 31(5) and Rules 57, 58 and 58*bis*);<sup>11</sup>

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<sup>11</sup> The amount of the handling fee is 233 Swiss francs. The amount of the preliminary examination varies from 150 to 2,380 Swiss francs (equivalent), depending on the IPEA concerned. A reduction may be available depending on which ISA prepared the IS or where the applicant qualifies on the basis of nationality and residence in one of certain countries with low per capita national income. (See Annex E of the PCT Applicant’s Guide.)

- (iv) the IPE is undertaken by one of the IPEAs appointed by the Assembly (Article 32 and Rule 63);<sup>12</sup>
- (v) the IPEA must be competent having regard to the receiving Office with which the application was filed – that is, the IPEA must be prepared to act for applications filed with the receiving Office concerned (this matter is specified in the Agreement referred to in item (vi), below), the receiving Office must have specified the IPEA as competent (Rule 59),<sup>13</sup> and there may also be restrictions based on which ISA carried out the IS on the application (also specified in the Agreement);
- (vi) the IPE is carried out in accordance with the Treaty, the Regulations and the Agreement between the IPEA and the International Bureau (Article 34(1)), and with the “common rules” of international preliminary examination (Article 32(3)) which include the PCT International Preliminary Examination Guidelines (document PCT/GL/IPE/1<sup>14</sup>) in addition to the relevant provisions of the PCT, the Regulations and the Administrative Instructions;
- (vii) the procedure is initiated by the filing of a “demand” for IPE; the demand may theoretically be filed at any time, but it needs to be filed within 19 months from the priority date in order to defer national phase entry from 20 to 30 months from the priority date (see paragraphs 11(ii) and 12(iii), below);
- (viii) in the demand, the applicant “elects” the designated States in which the applicant wishes to use the results of the IPE; most applicants elect all designated States, but States not elected in the demand itself may also be elected later, although this happens rarely in practice (Article 31(4)(a) and Rules 53.2(a)(iv), 53.7 and 56);
- (ix) the applicant has the right to communicate orally and in writing with the IPEA (Article 34(2)(a) and Rule 66.6), and to amend the application, at the beginning of and during the IPE procedure (Article 34(2)(b) and Rules 53.9, 66.1(b) to (d) and 66.5), in particular, in response to the written opinion (see item (x), below);
- (x) at least one “written opinion” is issued before the establishment of the IPER, unless the IPER is positive (Article 34(2)(c)); the applicant has a right of response to the written opinion (Article 34(2)(d) and Rule 66.3);
- (xi) the written opinion must invite the applicant to submit a written reply and fix a time limit for reply (Rule 66.2); additional written opinions will be issued if time permits, particularly if the applicant responds with arguments or amendments (Rules 66.3 and 66.4);

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<sup>12</sup> The Offices appointed as ISAs (see footnote 6) also hold appointments as IPEAs (the Spanish Patent and Trademark Office, already an ISA, was appointed as an IPEA by the Assembly in September-October 2001).

<sup>13</sup> Special provisions apply where the application was filed with the International Bureau as receiving Office (Rule 59.1(b)).

<sup>14</sup> See WIPO’s Internet site at <http://www.wipo.int/pct/en/gdlines.htm>.



- (xii) the result of the IPE procedure is an IPER containing a preliminary and non-binding opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step and to be industrial applicable (Article 33(1) to (4)) – often called “patentability criteria,” although decisions as to patentability are expressly reserved by the PCT to the (designated/elected Offices in) Contracting States (Articles 27(5), 33(5) and 35(2), second sentence);<sup>15</sup>
- (xiii) the written opinion and the IPER may also contain opinions as to other substantive matters in so far as they are checked by the IPEA, such as defects in form or contents, clarity of the claims, description or drawings, and whether the claims are fully supported by the description (Article 34(c)(ii) and Rule 66.2);
- (xiv) the written opinion and the IPER must contain reasons (Article 35(2) and Rules 66.2, 70.6, 70.7, 70.8 and 70.12);
- (xv) the IPE procedure must take the ISR and citations therein into account, as well as other relevant documents (Article 33(6)), but the IPEA is not obliged to come to the same conclusions as the ISA as to the relevance of citations;
- (xvi) the scope of the prior art that is required to be taken into account by the IPEA is governed by the PCT (Article 33(2) and Rules 64, 65 and 70.7);
- (xvii) amendments made during the IPE are, unless superseded by other amendments, annexed to the IPER (Article 36(1) to (3) and Rule 70.16);
- (xviii) the IPER is prepared, in general, within 28 months from the priority date (Article 35(1) and Rule 69.2) – that is, before the time limit for entry into the national phase (see paragraph 12(iii), below);
- (xix) the IPER is transmitted by the IPEA to the applicant and to the International Bureau, which in turn transmits it to the elected Offices, if required with a translation into English prepared by the International Bureau (Article 36(1) to (3) and Rules 71.1 and 72); it is a matter for the applicant to provide any required translation of the annexes to the IPER (containing non-superseded amendments of the application) (Rules 70.16 and 74);
- (xx) the IPE procedure is confidential as between the applicant, the IPEA and the International Bureau, but any elected Office may choose to make the IPER publicly available (and many in practice do so)<sup>16</sup> and may also obtain the file of the IPE from the IPEA and make it publicly available (Article 38 and Rules 94.2 and 94.3); this possibility can be useful for Offices which register patents without any examination as to substance, in which case the IPER may be used for reference by third parties and for use in any subsequent invalidation proceedings;

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<sup>15</sup> Article 35(2), second sentence, states: “The international preliminary examination report shall not contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable according to any national law.”

<sup>16</sup> It is estimated that at least 95% of IPERs presently become publicly available from at least one elected Office.

- (xxi) the applicant may have to pay additional fees if the IPEA finds that the application does not comply with unity of invention requirements (Article 34(3) and Rule 68); otherwise, the examination will be restricted; the IPEA is not bound by the views of the ISA as to unity of invention (see paragraph 9(xii), above).

11. Applicants file demands for IPE for two main reasons:

- (i) the IPE procedure offers applicants the opportunity, before deciding whether to proceed with the application into the national phase, of obtaining an examiner's opinion as to whether the invention meets the requirements of novelty<sup>17</sup>, inventive step (non-obviousness)<sup>18</sup> and industrial applicability<sup>19</sup> and of amending the application to improve it in the light of that opinion;
- (ii) the time limit for entering the national phase is delayed until 30 months from the priority date rather than 20 months from the priority date; some applicants file a demand for IPE merely to "buy time" and are not interested in the results of the procedure.

*The national phase*

12. So far as the national phase before designated and elected Offices is concerned, important features to bear in mind in the present context are the following:

- (i) each designated Office is entitled to receive the ISR as part of the published pamphlet of the international application (see paragraph 9(x), above);
- (ii) the applicant is free to decide not to proceed with the international application into the national phase before any designated or elected Office, because of a negative ISR or IPER or for any other reason;<sup>20</sup> the international application will then be considered withdrawn so far as that Office is concerned (Articles 24(1)(iii) and 39(2));
- (iii) the time limit for national phase entry and the earliest date for commencement of national processing are presently, in general, 20 months from the priority date under Chapter I (Articles 22(1) and 23(1)) or, if the applicant elects the State concerned within 19 months from the priority date, 30 months from the priority

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<sup>17</sup> According to Article 33(2) of the PCT, a claimed invention shall be considered novel if it is not anticipated by the prior art as defined in the Regulations. Rule 64.1(a) establishes that "...everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) shall be considered prior art provided that such making available occurred prior to the relevant date"

<sup>18</sup> According to Article 33(3) of the PCT, a claimed invention shall be considered to involve an inventive step if it is not obvious to a person skilled in the art.

<sup>19</sup> According to Article 33(4) of the PCT, a claimed invention shall be considered industrially applicable if it can be made or used in any kind of industry.

<sup>20</sup> While there is no fully uniform approach to the criteria for patentability under national laws, the ISR and IPER enable the applicant to make a more informed choice as to whether to incur the expense and trouble of entering the national phase before the various designated and elected Offices.

date under Chapter II (Articles 39(1)(a) and 40(1));<sup>21</sup> however, the Assembly has recently decided to modify the time limit under Chapter I to be 30 months from the priority date (see paragraphs 5 and 6, above);

- (iv) each elected Office receives the IPER, with a translation into English if required, and is free to make it available to third parties, together, if it wishes, with the file of the IPE (see paragraph 10(xix) and (xx), above); as mentioned in paragraph 9(x), above, the ISR is published together with the international application;
- (v) each designated Office and elected Office is free as to the extent to which it takes into account the ISR and the IPER, neither of which is binding for the purposes of the national phase procedure, although many Offices, particularly smaller Offices with limited resources, rely on the reports for the purposes of the patent grant procedure.

13. Elected Offices use IPERs for the purposes of processing international applications during the national phase:

- (i) those Offices which conduct substantive examination can use the IPER in determining whether the invention concerned is patentable under national law and hence whether a patent should be granted;
- (ii) those Offices which do not conduct substantive examination can place the IPER on file for reference by third parties and for use in any subsequent invalidation proceedings;
- (iii) an IPER is more likely to be fully positive, and therefore more useful to smaller elected Offices, in particular, if the applicant has a real interest in the IPE procedure and has amended the application to overcome objections raised by the IPEA examiner;
- (iv) if the applicant filed the demand merely to “buy time,” the IPER is more likely to contain negative opinions, since no amendments would have been made to overcome objections; negative IPERs pose problems for smaller Offices to deal with, since there will generally be a need for further examination, prosecution and amendment during the national phase;
- (v) Article 42 prohibits elected Offices from requiring applicants to furnish the results of search and examination in other elected Offices.

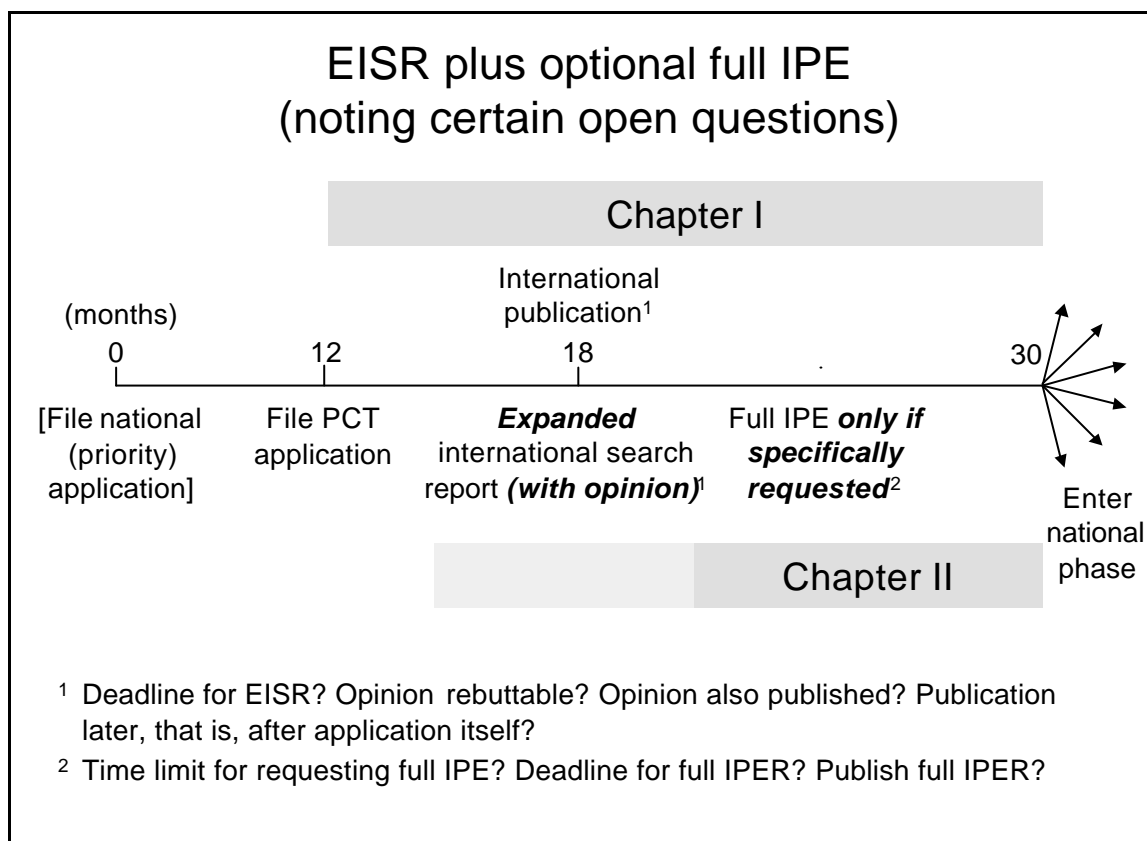
IPERs are therefore very important for smaller elected Offices with limited resources.

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<sup>21</sup> While the time limits provided for in Articles 22(1) and 39(1)(a) are 20 and 30 months, respectively, designated and elected Offices may, under Articles 22(3) and 39(1)(b), fix time limits which expire later, and a number of designated Offices have in fact fixed later time limits. On the other hand, applicants may, if they wish, request any designated or elected Office to commence national processing before the expiration of the applicable time limit (Articles 23(2) and 40(2)).

EXPANDED INTERNATIONAL SEARCH REPORT WITH OPTIONAL FULL INTERNATIONAL PRELIMINARY EXAMINATION

14. The general features of the proposal outlined in paragraph 3, above, for an expanded international search report (EISR) are illustrated in Figure 2, and various implications and options relating to the proposal are further explored in the following paragraphs.



**Figure 2**

*General implications*

15. An expanded international search report (EISR) would be useful to applicants and designated Offices for the purposes of the national phase procedure, whether or not the applicant opted for full IPE following receipt of the EISR. Since the EISR would contain a written opinion in addition to the results of the search, designated Offices would have a stronger basis for making decisions in the national phase than they would at present where the applicant enters the national phase under Chapter I (that is, with an ISR but without an IPER). Elected Offices would in fact receive similar information in an EISR to that which they presently receive in cases where the applicant requests IPE only in order to “buy time.” Moreover, where the applicant does not request full IPE after receiving the EISR, designated Offices would not be subject to any restriction by virtue of Article 42 as to requiring the applicant to furnish the results of the national examination before other Offices, which is not the case at present where the applicant requests IPE only in order to “buy time.”

*Scope of the EISR*

16. The EISR would have the same contents as the present ISR, the main part of which consists of citations of the prior art documents considered to be relevant, categorized according to their relevance as “X,” “Y,” “A,” etc.,<sup>22</sup> and an indication of the claims to which the citations are relevant (see Sections 505, 507 and 508). In addition, the EISR would contain a first opinion as to whether the claims appear to satisfy the criteria of novelty and inventive step (non-obviousness), similarly to the most important contents of the first written opinion issued in the course of the present IPE procedure.

17. The question then arises as to how comprehensive an EISR should be. The present first written opinion covers matters other than novelty and inventive step, for example, industrial applicability, clarity, and support for the claims in the description. Moreover, a written opinion is required to contain explanations and reasons going beyond a mere statement, for example, that the invention lacks novelty or inventive step.

18. The extent of coverage of the EISR is, of course, closely connected with the question of how much additional effort the examiner should make, and how much additional time should be spent, for the establishment of the EISR compared to the present ISR. Any additional effort and time spent on the establishment of the EISR would need to be balanced against the fact that fewer demands for (full) IPE would be expected to be filed than at present.

*Relationship between EIS and IPE procedures and between ISA and IPEA responsibilities*

19. If the EISR were to include a written opinion comparable, at least to a degree, with the first written opinion issued during the present IPE procedure, the existing clear distinctions between the IS and IPE procedures, and between the responsibilities of ISAs and IPEAs, would necessarily become blurred. Under a revision of the Treaty itself to provide for such a new procedure, it would probably make little sense to retain the present distinctions between IS and IPE. In the meantime, however, the existing IS procedure could readily be changed, by amending the Regulations, to provide for a written opinion to be included in the EISR, with consequential adaptations of the full IPE procedure, which would only be commenced, at the applicant's option, after the issuance of the EISR.

20. In order to obtain maximum gain from the efficiencies which introducing the EISR procedure would offer, the relationship between the IS and IPE procedures and the responsibilities of the ISA and the IPEA would undoubtedly need to be adjusted. The greatest efficiency might be expected if the full IPE were to be carried out by the same examiner who has earlier prepared the EISR, implying that the same Office would be responsible as both ISA and IPEA. However, to insist on such an arrangement would deprive applicants of the present possibility, available in some cases, of obtaining the ISR and IPER from different Offices.

21. If, on the other hand, applicants were to be permitted to obtain the EISR and the full IPER from different Offices as ISA and IPEA, should the IPE examiner's freedom to depart from the opinion of the examiner who prepared the EISR be subject to any restriction?

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<sup>22</sup> See footnote 10.

22. Any change to the search and examination system should, of course, be such as to maintain or even increase the quality of the service which applicants presently receive and of the final reports, which are produced for the benefit of applicants, third parties and designated and elected Offices.

23. Another general matter which would need to be addressed is whether participation in the EISR system should involve any element of choice for either applicants or ISAs. For example, should applicants be able to opt for only an ISR in certain circumstances? Will all ISAs be obliged to participate in the EISR system?

#### *Publication of EISR*

24. A decision would need to be made as to whether the written opinion “part” of the EISR should be published. Some applicants may have a concern that publication of an adverse opinion before the applicant has had the opportunity to amend the application would have prejudicial effects during the national phase procedure. Account should be taken of the fact that nearly all IPERs are made publicly available under the existing system (see paragraph 10(xx), above, and footnote 16), although first written opinions are not so widely available. It needs also to be remembered that the presence of “X” and “Y” citations in an ISR could be seen as problematic for an applicant, but it is already accepted that all ISRs are published as a matter of course.

25. It would be possible for the EISR to be produced in two parts, both of which need not be published. For example, it could be decided that the central contents (corresponding to the present ISR) would, as now, be published, but that the opinion would not be published but would be communicated to designated Offices, which would then have the right to publish it during the national phase.

#### *Time limit for establishing and publishing EISR*

26. Depending on the content of the written opinion and thus on the additional effort and time needed for the establishment of the EISR, more time may be needed for the establishment of the EISR than is presently the case for the ISR (generally within 16 months from the priority date – see paragraph 9(viii), above). If more time needs to be allowed for the establishment of the EISR, it may not be available in time for inclusion in the international publication of the international application, in which case the EISR may have to be published later than the international application itself. While this would raise practical difficulties under the present paper-based procedures, those difficulties will be avoided with the advent of fully electronic publication and communication to designated Offices under new systems under development by the International Bureau under the IMPACT Project.

27. The scope of the EISR and the time at which it is published will be of concern not only to applicants and designated Offices but also to third parties, particularly bearing in mind that the time limit for entering the national phase will in future be 30 months whether or not full IPE is requested. Third parties have an interest in knowing whether and in what countries an application is proceeding, and a longer period of uncertainty in this respect needs to be balanced by the fact that useful information, in the form of the EISR, has become available in the meantime.

*Article 19 amendments*

28. Under the current IS procedure, the applicant has the opportunity to amend the claims of the international application within a time limit of two months from the date of receipt of the international search report; any amended claim is published together with the international application or, if the amendment has been made within the time limit but after international publication has taken place, is published separately of the international application (Article 19).<sup>23</sup> This possibility is particularly important for applicants who wish to take advantage of the “provisional protection” available in certain designated States, that is, the right to take action in respect of infringement occurring after the publication of the application but before the grant of a patent. The way in which Article 19 operates would therefore need review if the publication of the EISR were to be significantly delayed.

*Possible right of response to EISR*

29. In the event that the applicant decided to request full IPE after receiving the EISR, there would, of course, be an opportunity to respond during the IPE procedure to the written opinion contained in the EISR. Under the proposed new procedure, however, the applicant is not obliged to request full IPE. Noting that the EISR, including a written opinion, would be available to designated Offices and may be published (see paragraphs 24 and 25, above), the question arises as to whether the applicant should have the opportunity of responding to the EISR. It is difficult, however, to envisage how such a possibility could be introduced while maintaining the streamlining intended by introducing the EISR procedure. It would certainly be contrary to the essence of the proposal to provide for the issuance of a second opinion.

30. If it were to be decided that the applicant should have the opportunity to rebut the EISR prior to publication, should such rebuttal be communicated to all designated Offices (but not to the general public) or should it be published together with the EISR?

*Optional full IPE procedure*

31. Full IPE would be triggered only if the applicant took a definite step to request it. That step could be the filing of a demand for IPE or some other step such as the submission of a response to the EISR (depending on the approach to be taken in connection with a possible right of response to the EISR – see paragraphs 29 and 30, above) and would presumably also require the payment of a fee (see paragraphs 37 to 39, below). Since there would be no incentive for applicants to request full IPE merely to “buy time” before entering the national phase, IPEAs would have more time to focus on those applications for which the applicant has a real interest in the results of the IPE, and thus would be in a better position to maintain or even increase the quality of IPERs.

32. In such cases, elected Offices (and third parties) would retain the advantage of high quality IPERs useful in arriving at a conclusion, during the national phase of processing, as to whether the inventions concerned are patentable. At the same time, IPEAs would be in a better position to respond to the expected future growth in their workload.

33. It should be emphasized that while the inclusion of a first opinion in the EISR would become a mandatory feature of the PCT procedure, the possibility of requesting full IPE

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<sup>23</sup> In practice, about 5% of applicants submit amendments under Article 19.

would remain optional for applicants, but having removed the incentive for applicants to request IPE merely to “buy time” before entering the national phase. This would, in a very real sense, afford more choice to applicants than under the present procedure.

*How should full IPE be initiated?*

34. Formalities associated with the existing IPE procedure are not extensive, but there is potential for reducing them even further. While Article 31(1) provides for the procedure to occur “on the demand” of the applicant, the particulars of the filing of the demand are largely left to the Regulations (Article 31(3)). It would be possible, for example, to eliminate the need for the applicant to use a particular form, although many applicants and Offices prefer the use of forms in order to avoid confusion as to the nature of the procedure being initiated. One possibility might be for the demand to be considered to have been filed whenever the applicant responds to the first opinion contained in the EISR. A “mere” response by the applicant, without amendment or substantial argument, might, however, result in the establishment of the IPER with little difference from the opinion contained in the EISR, apart from the inclusion of opinions on additional matters not covered in the EISR.

*Time limit for establishing IPER*

35. The present time limit for establishing the IPER (28 months from the priority date) is designed to enable the applicant to take the contents of the report into account in deciding whether, and before which elected Offices, to enter the national phase. There is no absolute reason, however, why the IPER need be available before the national phase is commenced. There may be circumstances in which it is more important to the applicant to put the application in order than to receive the IPER before entering the national phase. A change in this respect would, of course, require a review of how amendments made in the course of the IPE should be brought into the national phase. Another possibility would be for an extension, in those circumstances, of the time limit for entering the national phase.

*Should the IPER be published?*

36. As already explained (see paragraph 10(xx), above, and footnote 16), nearly all IPERs are in fact made publicly available by at least one elected Office. The question therefore arises as to whether every IPER ought to be published as a matter of course. The provisions of Article 38 as to the confidentiality of IPERs do not extend to elected Offices, and it would be possible to explore ways of amending the Regulations to institutionalize and centralize the existing practice of many elected Offices whereby IPERs are made publicly available.

*Fees for EIS and IPE procedures*

37. The establishment of an EISR would involve additional workload compared with the present IS procedure. Would the search fees charged by the ISAs need to be raised accordingly? What level of increases could be expected?

38. Depending on the approach taken to publication of EISRs, there may be increased costs for the International Bureau in effecting that publication, although increased automation of publication procedures in the future would diminish considerably the cost of publication in general. If the EISR is not to be included in the normal international publication of the international application but is to be published separately, the additional cost borne by the International Bureau would need to be covered by the international fee.



39. Noting that a written opinion will already have been issued, should any possible increase in the amount of the international search fee be balanced by a decrease in the preliminary examination fee, assuming that less effort and time would be needed for the establishment of the (full) IPER?

*40. The Working Group is invited to consider the issues raised in this document.*

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