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

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OPTIONS FOR FUTURE DEVELOPMENT OF  
INTERNATIONAL SEARCH AND EXAMINATION:  
MAKING GREATER USE OF INTERNATIONAL REPORTS

*Document prepared by the International Bureau*

1. This document is being made available provisionally, on WIPO's Internet site, in advance of the formal convening of the fifth session of the Working Group. It is provisional in the sense that the formal convening of the fifth session of the Working Group, as recommended by the Working Group at its fourth session held in May 2003, is subject to approval by the Assembly of the PCT Union. The Assembly is invited, at its 32nd (14th ordinary) session from September 22 to October 1, 2003, held in conjunction with the 39th series of meetings of the Assemblies of the Member States of WIPO, to approve the proposal concerning future work contained in document PCT/A/32/2, paragraph 26(i), "that two sessions of the Working Group should be convened between the September 2003 and September 2004 sessions of the Assembly to consider proposals for reform of the PCT including, in particular, the matters for further consideration identified [in document PCT/A/32/2] above, on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary."

2. Subject to the Assembly's approval, the fifth session of the Working Group will be formally convened and this document will then cease to be provisional in nature.

## BACKGROUND

3. At its fourth session, the Working Group gave preliminary consideration to options for future development of international search and examination (see document PCT/R/WG/4/7). The Chair, in his summary of the session, noted that, in the course of the discussions of document PCT/R/WG/4/7, some delegations had emphasized their view that it would be premature and inappropriate to consider more specific or even general proposals for changing the PCT<sup>1</sup> system in isolation from the resolution of broader issues, but that others had expressed interest in having further discussion of possible optional features of the system. The Chair concluded that document PCT/R/WG/4/7 should remain on the agenda for further discussion at a later session. In addition, the International Bureau would explore options which might be available to States that wished to make greater use of international search and examination, such as through optional protocols to the Treaty, for discussion at the next session of the Working Group. (See the summary of the fourth session of the Working Group by the Chair, document PCT/R/WG/4/14, paragraphs 82 to 91.) This document considers some of those options, without prejudice to other matters covered in document PCT/R/WG/4/7, which the Working Group may wish to consider further at a later stage.

## ASSESSMENT OF VALIDITY OF PATENTS AND PATENT APPLICATIONS

4. An appropriate patent system can offer many benefits to a State, including the encouragement of local innovation as well as the incentive for investment and technology transfer from other States. The features of the most appropriate patent system for any particular State will, of course, depend on its circumstances and wider economic strategy. Consideration needs to be given to many factors, including the means for enforcement of rights and the means by which patents are tested for validity and registered, granted or, if later found to be invalid, revoked. This document considers primarily the means for granting of patents, but also considers some aspects of testing validity at a later stage, with a view to identifying how the PCT system might provide greater benefits to:

(a) States which do not currently have a searching and examining Office, but would like patent applications to be searched and examined prior to grant;

(b) States which have (or are considering setting up) a searching and examining Office, but wish to reduce the amount of search and examination work done which duplicates what is done in other Offices; and

(c) States which do not require routine search and examination of patent applications, but need a system for determining the validity of patents efficiently when required in particular cases.

5. In this respect, it should be emphasized that the term “States” should not limit discussion to the needs of the Offices administering the system, but should include the needs

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<sup>1</sup> 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.

of innovators, investors and a wide range of third parties, including researchers, academics, competing businesses and the community at large.

#### *Some Advantages of Examination Systems*

6. Since patent applications in general need all the technical information to be included from the outset, a patent system requiring all applications to be searched and examined makes little difference to the disclosure aspect of published patent applications, except that more detailed consideration allows more accurate classification so that the information in the document can be retrieved more easily by researchers. However, many States require search and examination of all applications before a patent is granted with the result that both the patent owner and competitors know that there is a high presumption that the rights defined by the claims are valid but that competitors are free to act outside of those boundaries. This relative certainty in the scope of protection may give confidence both to patentees and their (actual and potential) investors, and to competitors wishing to enter the field.

#### *Some Disadvantages of Examination Systems*

7. On the other hand, setting up and maintaining a national Office capable of searching and examining all patent applications is a significant investment for a State in terms of both financial and human resources, the costs of which are generally borne by industry (in the fees payable) and society at large (through the reduction in scientists and engineers available to the creative community). Furthermore, the benefit to local industry of a centralized physical collection of technical documents is gradually being eroded as more of these become available online, the majority of patent documents being available freely using the Internet. In most examining Offices, there is limited (if any) provision for local industry to call upon examiners' skill in retrieving technical information, other than through requesting search of a patent application. Consequently, States, particularly those where there is a shortage of skilled scientists and engineers, would need to consider carefully whether the benefits to the State of a searching and examining Office would justify the cost before setting out to create one and whether other possibilities exist to assist the relevant policy aims. Furthermore, many States in which an examining Office already exists are already considering the extent to which the work done by their examiners is duplicated elsewhere and the extent to which this can be reduced.

#### *Factors Relevant to an International Patent System*

8. Administratively, any international patent system would be most efficient if all States applied harmonized criteria for patentability, since it would be impractical to provide search and examination reports which specifically catered for the different laws of individual States. However, some States consider that their different social and economic needs and level of technological development mean that fully harmonized criteria may not be a desirable goal for the foreseeable future. Nevertheless, it may be possible to focus on areas of common agreement, where the PCT system might make a greater contribution, and to recognize the areas where significant differences may lie, so that cases where such factors may exist can be dealt with more effectively.

*Approaches Not Requiring a Full Searching and Examining Office*

9. Various approaches to some of the issues above have been considered or used by States which do not wish to establish or maintain a full searching and examining Office. These include:

(a) No search or substantive examination may be required at all and a patent may be registered in the form in which the application is made (possibly subject to formalities examination). The validity of individual patents may be considered during proceedings at a later stage before a court or the Office, on application by a third party.

(b) Search and examination reports may be required from a recognized source (most probably a regional Office or the Office of another State, either by bilateral/multilateral arrangement or else in the form of reports under the PCT, following international search and preliminary examination or an international-type search). Such reports may be established either before grant of a patent (so that the report is available for inspection at the Office or as part of a published patent specification, so that third parties may assess for themselves the extent of validity of the claims) or else as a requirement prior to any decision to enforce the patent (so that the alleged infringer and, if necessary, the court are able to assess its validity).

(c) The patent may simply be registered, but with a general requirement of disclosure of grants, refusals or invalidations, together with the relevant reasons, of patents for the same invention in other States, so that third parties may draw conclusions about the validity of the patent based on the degree of similarity of the relevant laws.

(d) A patent may be granted based on the grant of an equivalent patent by an examining Office which is considered to operate under sufficiently similar patent laws, or else on the basis of an international preliminary report on patentability under the PCT.

(e) A patent may be granted following a limited examination, which does not consider novelty and inventive step, but allows an Office to refuse a patent on other grounds, such as for reasons of national security, *ordre public* or morality, or else where the applicant has filed two or more applications for the same invention having the same priority date.

10. In all these cases, the individual State retains the right to decide whether or not a patent should be granted, but chooses in practice not to test for itself routinely whether all the criteria for grant or validity of a patent have been met, instead relying on the search and examination carried out by other Offices or else leaving such matters to be decided only in the event that the validity of the patent is specifically challenged, for example as a defense during infringement proceedings. Many variations are of course possible within these general categories, depending on the matters which are of significant concern to a State. Some selected examples of States offering registration of patents without full search and examination by the national Office are set out below.

11. The fact that the approach in paragraph 9(d), above, is used, where a State wishes routine testing of validity but is prepared to accept the results of examining Offices in at least some other States for this purpose, bears witness to the fact that in fact there is little practical difference in the standards for patentability in most States, except in certain specialized fields (most notably in respect of computer software and business methods and where exclusions exist related to diagnostic, therapeutic and surgical methods for the treatment of humans or

animals or else to plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals).

*Selected Examples of States Offering Registration of Patents Without Full Search and Examination by the National Office*

*Australia:* As an alternative to full local search and examination, the applicant may request “modified examination,” where the application is amended to have the same description and claims as a patent which has been granted in English in a prescribed other country. A local examination is then performed only for limited matters and does not usually include a new search for prior art being made.

*Belize:* The Registrar may require the applicant to give details of the date and number of any application filed in another State relating to the same invention as in the application and may also require copies of any communication concerning the result of search and examination in another State, a copy of any granted patent, a copy of any final decision rejecting an application or a copy of any final decision invalidating a patent.

*France:* Applications are subject to a formalities examination and a search report is established. This is published with the application (including any amendments to the claims). Third parties then have three months to comment on patentability and the applicant may respond. A final report is then drawn up and attached to the registered patent.

*Singapore:* A patent is granted only after search and examination reports have been established, but this may be done in any of the following ways: (i) both search and substantive examination may be requested specifically for the national application (this work is contracted out to cooperating Offices); (ii) a search done under the PCT or on a corresponding application by a prescribed Office, followed by substantive examination specifically for the national application; or (iii) both search and substantive examination reports established under the PCT or on a corresponding application by a prescribed Office. The reports are made available, but the application is only refused by the Office on limited grounds (for example that the publication or exploitation of the invention would be expected to encourage offensive, immoral or anti-social behavior).

*South Africa:* The application is subject to a formalities examination only and then published. Provided that no objections are made within three months, the patent is registered.

*Switzerland:* Applications are subject to a formalities examination and a substantive examination, but no mandatory search is made. The substantive examination does not include determination of novelty and inventive step, but the application may be refused on any other ground of patentability.

*Matters Explored in This Paper*

12. This paper explores some possible ways in which the PCT might be extended to provide a more beneficial service to States currently registering patents without full prior search and examination, as well as to those with examining Offices.

## A. REGISTRATION FOLLOWING INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

13. As noted in paragraph 9(b), above, certain States at present register a patent without requiring amendment to overcome deficiencies as long as it is accompanied by a suitable search and examination report (for example, an international search report and international preliminary report on patentability), allowing interested third parties to assess the extent to which the patent may be valid. Clearly this can be done unilaterally by the State adopting an appropriate law. On the other hand, States with such laws, or interested in this approach, may wish to consider the possibility of formalizing the arrangement, for example, by the adoption of an optional protocol to the PCT concerning the grant of patents in this way.

14. Such a protocol might help stimulate interest in pursuing patents into the national phase in the participating States, both by clarifying to international applicants the type of procedures involved in the national phase for these States and by easing the application process by encouraging common practice with regard to further steps (such as provision of translations and payment of fees) which might be necessary. This could be of benefit, as a tool within a wider commercial policy, in encouraging foreign investment and technology transfer.

## B. ENCOURAGING POSITIVE INTERNATIONAL PRELIMINARY REPORTS ON PATENTABILITY

15. Clearly there would be advantages if patents were only granted when the criteria for validity were, as far as could reasonably be tested, met, even though in many States the time and expense involved in examination of each patent application is not considered justified. As noted above, the standards for patentability are in fact very similar for most States and in practice, if the PCT standards for novelty, inventive step and industrial applicability are met, then, in the great majority of cases, so too will all national standards. Consequently, it would be highly desirable if a greater proportion of international patent applications entered the national phase with a positive international preliminary report on patentability. It is noted that this would also reduce the burden on designated or elected Offices where applications are subject to substantive examination, since they would need to perform significantly less examination of applications during the national phase.

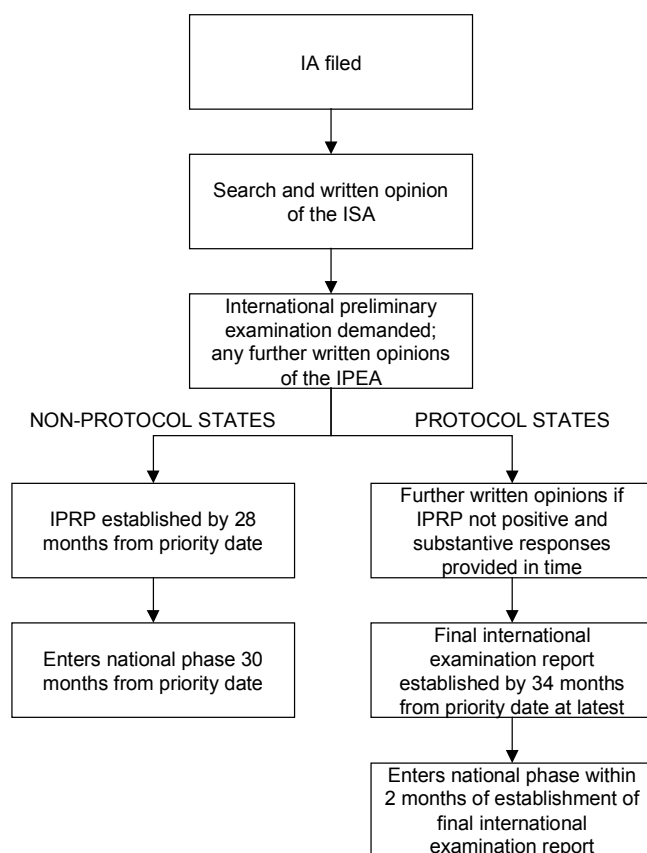
16. To achieve this, it would be necessary for the PCT to offer applicants both the opportunity and the incentive to bring their applications into a state during the international phase such that they are likely to meet the requirements of many if not all designated States during the national phase. One of the difficulties in achieving this, both for applicants and for International Authorities, is the amount of time available in the international phase for submitting and examining amendments. Some States and users have expressed concern at the idea of simply extending the time periods in the international phase since, if the time were not in practice used to bring the international application into a state where a positive international preliminary report on patentability could be issued, this would simply result in delays to grant in the national phase.

17. A flowchart illustrating a possible system with optional further international examination, based on that in Example C in the Annex to document PCT/R/WG/4/7, appears below.

*Protocol Allowing for Optional Further International Examination*

18. In this example, a protocol is added to the existing Treaty, allowing for further processing in the international phase. This would be optional both in respect of States, which would recognize the processing only if (and subject to any possible reservations or options) they adopt the protocol, and in respect of applicants, who would be permitted to request either normal or extended processing. If the international preliminary examination is being carried out by a participating International Authority (the International Authorities would also need to agree to perform this extra work; see also paragraph 46), the applicant can request further examination, allowing a limited extra period within which to conduct further rounds of amendment or argument, with a view to the application being brought into a state which would achieve a positive international preliminary report on patentability. If this is not complete within 28 months from the priority date, an international preliminary report on patentability is established automatically on the basis of the latest written opinion for the use of the States which are not party to the protocol. However, the international application will continue international examination and not yet enter the national phase in those States which have ratified the protocol.

SYSTEM WITH OPTIONAL FURTHER INTERNATIONAL EXAMINATION



19. Various possibilities could be envisaged with regard to the timing and content of a request for further examination. For example:

(a) the request might be required to be made at the same time as the demand for international preliminary examination; this would probably need to be the case if the system also allowed for further processing such as “top-up” searches or additional international searches by another International Authority (see paragraphs 33 to 37, below); or alternatively:

(b) the request might be permitted to be made at any time before the expiration of the time limit under Article 39; the fee for extra processing in this case would be payable only in the case that there was additional work for the International Preliminary Examining Authority, providing a further incentive to bring the international application into compliance with the requirements of novelty, inventive step and industrial applicability at an early stage (noting that a significant proportion of international applications where international preliminary examination is demanded achieve a positive international preliminary report on patentability within the current time limits).

20. Once the international application meets the requirements of novelty, inventive step and industrial applicability as defined in the Regulations, a final international examination report is issued; this might be termed a “prima facie certificate of patentability,” indicating that it has been found to meet standards which will result in it being patentable in many States. The result of this would be that a patent would normally be granted in any of the States party to the protocol simply on the payment of an appropriate fee and the provision of any necessary translation.

21. However, recognizing that variations do exist in the conditions for patentability:

(a) States with examining Offices might make grant provisional on there being no objection from the Office within a certain period (as may be the case for international marks under the Madrid Protocol) and any opposition procedures which may apply; and

(b) States where only limited examination is performed might refuse grant, or make it subject to cancellation by the national Office, if the application is found to relate to subject matter which is not patentable in that State, if the invention is contrary to *ordre public* or morality according to the national standards, or else if a relevant patent publication had been found of earlier priority date but only published after the priority date of the international application (so that it does not constitute prior art under the PCT, but may do so under the relevant national law).

22. The process outlined in paragraph 21(b), above, could be assisted if the international preliminary report on patentability included comments, noting the existence of subject matter where conditions of patentability vary considerably around the world (see paragraphs 11, above, and 38 to 40, below), so that States where the grant of such patents is a significant concern, but in which there is no desire to fully examine all applications, could develop a limited examination capability and focus it effectively on applications which are most likely to be of concern.

23. Even in States where it is desired to retain a pure registration system, membership of the system could provide benefits by encouraging international applicants only to register patents which could be seen to meet the common standards for patentability and for which the prima



facie certificate of patentability might include indications alerting third parties to other conditions which might be relevant to patentability according to the particular national standards.

24. If the application still does not meet the requirements of novelty, inventive step and industrial applicability within, say, 34 months from the priority date, a final report similar to the international preliminary report on patentability will be established and the international application will enter the national phase as usual. In order to prevent this process from being abused by simply buying time before entry to the national phase, the final report and national phase could be triggered earlier in the event of the applicant failing to provide a substantive response to a written opinion within the specified time. Further encouragement to meet the requirements of novelty, inventive step and industrial applicability might be offered by Contracting States by a differential pricing system, whereby the fees due on entry to the national phase would depend on whether the prima facie certificate of patentability has been issued or whether objections remain outstanding in the final report.

25. Such a system could allow Contracting States to reduce the number of invalid patents registered without major investment in developing an examining Office and without reducing the flexibility which they have in determining the conditions for patentability which are appropriate to their particular policy needs.

### C. INTERNATIONAL EXAMINATION AFTER REGISTRATION

26. Another issue which affects, in particular, States without examining Offices is the assessment of the validity of a patent after it has been registered. This might come about in several circumstances, for example (i) as the result of a challenge to the validity of the patent by a third party who has found prior art which may be relevant but was not discovered during any search which was made prior to registration, or (ii) following a desire of a patentee to amend the patent because he has himself become aware of further prior art.

27. The PCT currently allows for “international-type searches” under Article 15(5) on national patent applications. It would be possible to extend this idea to international-type search and examination of registered patents or of proposals for amendments, either on the basis of a new international-type search or else on the basis of whatever prior art is supplied by the person or body requesting the service. Such a report could then form the initial basis of an action for invalidity or amendment before a national Office, providing a faster and cheaper system for resolving disputes than using the courts. Alternatively the report could be used as an expert opinion from a neutral body to assist a court in its deliberations.

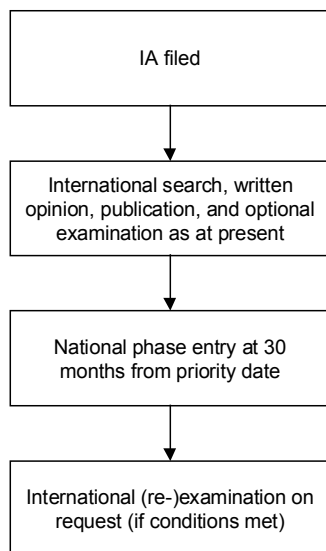
28. A flowchart illustrating a possible system allowing international examination during the national phase, based on that in Example B in the Annex to document PCT/R/WG/4/7, appears below. This system relates to a different issue to those addressed under A and B, above, and could be envisaged running in parallel to either of those systems, rather than necessarily being an alternative to them.

#### *Protocol Allowing for International Examination During the National Phase*

29. This system allows for international examination to be requested during the national phase in respect of international applications (and possibly also national applications), and of granted patents. The grounds for applying for such examination would be limited to certain cases, for example, where new prior art has been found, subsequent to any earlier

international search and examination, which may affect the novelty or inventive step of the invention. It would also be possible to allow for such requests after the patent has lapsed where infringement proceedings are still possible.

SYSTEM ALLOWING INTERNATIONAL EXAMINATION  
DURING THE NATIONAL PHASE



30. Several possibilities could be envisaged with respect to who would be permitted to request such examination and how. As noted in paragraph 26, above, new prior art may have been found either by the patentee (who may wish to amend his patent to exclude subject matter which he is concerned may not be novel or inventive), or else by a third party (who may have been accused of infringing the patent, which he believes to be invalid). In either case, the request for international examination would probably need to be made by the national Office of a State party to the relevant addition to the Treaty, rather than directly by the patentee or a third party. The Office would confirm that the conditions for international examination had been met, for example that there was a current or recently-lapsed patent effective in that State and that it was to be the subject of validity proceedings or a request for amendment.

31. The patentee might, depending on the purpose for which the new examination has been requested, be permitted to file amendments, following a similar process to pre-grant examination, but with additional rules ensuring that amendments were not permitted to extend the scope of protection, and possibly with more stringent time limits for response. As with current international preliminary reports on patentability, Member States would take such a report into account for the purposes of national invalidity or amendment proceedings, but need not be bound by it.

#### D. CONTENT AND TIMING OF INTERNATIONAL REPORTS

32. Significant factors in the use which can be made by national Offices of international search and preliminary examination reports are the extent of the report and the degree of confidence which can be placed on its quality and completeness. The contents of the reports are, for the most part, set by the Regulations and consequently could be amended relatively easily. However, while it would be possible to implement some or all of the measures

described below in isolation, they might introduce extra work for International Authorities, and it is recalled that the Committee considered this inappropriate at the present time. Consequently they are considered here only in the context of how they might improve a system which itself allows processing beyond that which applies under the PCT at present, particularly with respect to that described under heading B, above, but also applicable to some extent to the possible systems considered under headings A and C.

### *Multiple Searches*

33. The Committee, in its first meeting, considered the possibility of allowing applicants the option of requesting searches by several International Authorities (see document PCT/R/1/26, paragraphs 109 to 146). While there was some support, the general conclusion was that this was undesirable duplication of work and inappropriate, at least while some International Searching Authorities had difficulties with existing workloads. However, considering the longer term, a number of States pointed out that additional searches would clearly add value for applicants. For example, it may sometimes be desirable for searches performed by the European Patent Office or the United States Patent and Trademark Office to be supplemented by a “complementary search” performed by the Japan Patent Office or the Russian Agency for Patents and Trademarks of their Japanese or Russian language collections, respectively. The International Authority performing such an additional search might also include an opinion on how any new documents found, which did not have equivalents in the main search report, affected the novelty or inventive step of the application, for the better understanding of the International Authority which conducted the main search.

34. The additional search might be requested at the same time as making a demand with a request for further examination in the system described under heading B, above. Otherwise, in order to ensure that the search could be performed and considered in timely fashion, it would be necessary to request the additional search at the same time as the request for international application.

### *“Top-up” Searches*

35. The international search at present typically takes place around 15 months from the priority date of the application. As long as the international application’s priority date is valid, this is usually adequate for determining novelty and inventive step in relation to the prior art defined by Rule 64.1, since only material published before the “relevant date” may be considered. However, in most States, patent documents published after that date may also be relevant to novelty and/or inventive step if they have an earlier priority date. This can be extremely important in many fast-moving technologies.

36. Rules 33, 64.3 and 70.10 make some allowance for inclusion of such documents within the reports. However, at the time when the international search is performed, these documents may not yet have been published, or else might otherwise not have become available to the International Authority. A “top-up” search at a later stage in the international phase may eliminate the need for this check to be made by individual States and allow relevant documents to be brought to the attention of applicants at a point where appropriate amendments can still be made and examined centrally, if so desired, making the international preliminary report on patentability more useful for both applicants and elected Offices, particularly non-examining Offices.

37. Such a service could be particularly effective as part of a system, such as that described under heading B, above, allowing extended examination in the international phase. This would allow sufficient time in the international phase for the top-up search to be established and increase the utility of the international search and examination for States which had joined a protocol indicating their intention to base the grant of a patent primarily on the basis of the international report.

#### *Scope of Examination Reports*

38. The primary function of the international preliminary report on patentability is to provide an opinion on novelty, inventive step and industrial applicability, as defined by the Treaty. While the tests for these requirements differ slightly around the world, in practice, it would appear that there is very little difference in the outcomes of these tests in any particular case. On the other hand, there are other areas where the differing tests, although relevant only to a small minority of patent applications, have very significant differences with regard to patentability in different States. Examples of this include patents for surgical methods, plants and animals, and views on what constitutes technology.

39. Clearly, greater harmonization of national patent laws would make it easier for the PCT to provide examination reports which are closely aligned with national requirements. However, in the meantime, without going into the individual laws of each State, it may be desirable for international examination reports to comment on such aspects where practice varies. At present, Rules 39 and 67 set out certain subject matter which International Authorities are not obliged to search or examine, which cover most, if not all, of the relevant areas. Where the International Authority chooses not to perform a search or examination it would of course, in the context of the system described under heading B, above, be impossible to achieve a prima facie certificate of patentability (at least in respect of the part of an application to which the non-establishment applied). Similarly in the system described under heading C, no meaningful indication of the novelty or inventive step could be given of a patent being examined after grant. However the report would provide explanations of the reasons for which no report on novelty and inventive step was established, which might be relevant for determining whether the invention would also be excluded under particular national laws (in which case the novelty and inventive step may be academic).

40. On the other hand, where the application might be considered to contain subject matter which falls within Rules 39 and 67, but the International Authority chooses to carry out search or examination, there may at present be no indication in the international preliminary report on patentability of the existence of this matter. A readily identifiable indication that the patent does, or does not, relate to potentially excluded matter need not be a great burden for the International Preliminary Examining Authority and may give States greater confidence in using the results of the international examination directly, or, where appropriate, in identifying those cases where greater scrutiny of the application in accordance with the relevant national law is likely to be necessary prior to granting a patent. This would clearly be beneficial to States where such limitations exist and which have non-examining Offices, and could also be used to reduce the burden on examining Offices.

#### *Deferral of International Search and Examination*

41. If a protocol were widely taken up permitting extended processing in the international phase, it might be beneficial both for applicants and for the workload of the International Authorities to review the times by which international search and examination need to be

requested and completed. For example, at the time of filing the international application the applicant may not yet have determined whether the technology involved is one which he is in fact interested in pursuing.

42. Extending the period within which the international search fee is payable from one month from the date of receipt of the international application to, for example, sixteen months from the priority date might allow applicants to avoid paying fees on applications which will not be pursued and reduce the unnecessary workload of International Authorities. This would have an effect where the international application would be a sort of provisional application, which would not be permitted to proceed beyond the stage of formalities checks until the international search fee had been paid. While this move would mean that the international search report would not be available for the applicant to consider prior to publication or for inclusion in the pamphlet, there would remain ample time for establishment of the international search within the normal international phase. Furthermore, the availability of publications electronically means that it is less difficult than previously for third parties to gain access to international search reports which are established too late to be included with the pamphlet as originally published. Also, even if the start of Chapter II proceedings were slightly delayed, the applicant could rely on achieving a positive international preliminary report on patentability by the end of a phase of extended processing (see under heading B, paragraphs 15 to 25, above), the results of which might still be used by the applicant in national processing even in States which were not party to the protocol, by introducing the equivalent amendments in the national phase.

#### MEANS OF IMPLEMENTATION AND EFFECTS ON OTHERS

43. The options set out under A (see paragraphs 13 and 14, above), B (see paragraphs 15 to 25, above) and C (see paragraphs 26 to 31, above) would require an addition to the Treaty, most probably in the form of a protocol, but need not affect the operation of the existing system insofar as it applies to States which did not wish to join the protocol. However, in the event that further international reports were to be established, they could be made publicly available and consequently could be used, on an informal basis, even by the Offices of States which are not party to the protocol.

44. The additional options set out under D (see paragraphs 32 to 42, above) might be implemented either by amendments of the Regulations, which might affect reports under Chapters I and II of the Treaty, or else as additional Regulations applying only to reports which would be issued under additional protocols. The most appropriate approach would need to be considered carefully, depending on the wishes of States which are not party to the additional protocols and on efficiency considerations for International Authorities.

45. It would be desirable for a sufficiently large number of States to join a system for further international examination (as under B, above) before it came into force that there would be a strong incentive for applicants to use this system, rather than waiting until the national phase to amend their applications. Post-grant examination (as under C, above) on the other hand might commence with a relatively small number of participating States since this would be a service rendered individually to States on request, rather than aiming to replace work which would otherwise have to be duplicated in many States.

46. At least some of the International Authorities would need to accept the additional work involved. A system with further international examination might produce significant volumes of extra work for participating International Authorities, though this would be offset to a large

extent by the corresponding reduction in work required during the national phase. International examination at a later stage, on the other hand, would be expected to involve significantly lower volumes of work, since it would only be done on individual applications where a question of validity had been raised in a participating State rather than on a significant proportion of international applications.

*47. The Working Group is invited to consider the options contained in this document.*

[End of document]