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SUPPLEMENTARY INTERNATIONAL SEARCHES

Document prepared by the International Bureau

SUMMARY

1. Two alternative proposals are presented for a system of supplementary searches within the PCT by International Authorities in addition to the one carrying out the main search. In the alternative in Annex I (“Alternative I”), supplementary searches are provided only after the main search has been carried out (“sequential supplementary search”) and take the results of that search into account in determining the scope of the supplementary search. In the alternative in Annex II (“Alternative II”), Authorities may offer sequential supplementary searches in a similar way, or alternatively carry out supplementary searches at the same time as the main search (“concurrent supplementary search”).

2. The main features of the proposals are set out in paragraphs 4 to 8. The background and reasoning behind the proposals are explained in greater detail in paragraphs 9 to 45.

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TERMINOLOGY

3. In this document, the following abbreviated expressions are used to describe different search services and roles:

main search: the international search conducted on an international application under Article 15;

main Authority: the International Searching Authority which conducts the main search;

supplementary search: a search carried out on an international application by an International Searching Authority other than the one which conducts the main search;

supplementary Authority: an Authority which is requested to perform a supplementary search on a particular international application.

PROPOSALS

4. Annexes I and II contain alternative sets of draft amendments to the PCT Regulations allowing for a system of supplementary international searches. As noted above, Alternative I provides for a system of sequential searches; Alternative II provides for either concurrent or sequential searches, at the choice of the applicant to the extent that a particular Authority might offer a choice.

5. Each alternative includes the following common main features:

(a) Authorities are free to decide whether to provide a supplementary search service and, if so, under what conditions.

(b) Applicants are free to request supplementary searches from all, some, or none of the Authorities which offer supplementary searches, other than the main Authority for their application.

(c) A supplementary search fee (for the benefit of the Authority) and supplementary search handling fee (for the benefit of the International Bureau) must be paid within one month from the date on which the request is submitted.

(d) The International Bureau sends a copy of the international application and any other required documents to each Authority which is to conduct a supplementary search.

(e) Each supplementary Authority issues a supplementary search report. No written opinion is established under the supplementary search system, but the indications of relevant passages in the search report should be sufficient to make clear the relevance of the citation, bearing in mind that many citations will be in languages not well understood by the applicant or the Authority likely to act as International Preliminary Examining Authority if a demand is submitted.

(f) Supplementary search reports established during the Chapter I procedure are made available electronically to the public as soon as possible after they are received by the International Bureau (provided that the international application has been published) in such a manner that they can be viewed by any person seeking the main international search report.

However, supplementary searches performed during international preliminary examination, would be reported only as part of the written opinions and international preliminary examination report, the availability of which are governed by Article 38 and Rule 94—see paragraphs 43 to 45, below. Furthermore, each supplementary search report which has been established is automatically communicated to designated and elected Offices whenever the international search report is requested.

(g) Translations of supplementary search reports are prepared by the International Bureau in the same cases as for the main international search report, that is, an English translation will be prepared of those reports which are not established in English.

6. Both alternatives also include the possibility of supplementary searches being conducted at the same time as international preliminary examination, where the International Preliminary Examining Authority is not the same Office as the one which acted as International Searching Authority (see paragraphs 43 to 45, below).

7. The main differences between the two alternatives, other than whether the supplementary Authority necessarily waits until the main international search report has been established, are as follows:

(a) *Sequential searches only*: The request is made to the International Bureau after the main international search report has been established, within the same deadline as applies for demanding international preliminary examination. The applicant is only permitted to request searches of inventions for which a main international search report has been established. The supplementary Authority accepts the opinion of the main Authority regarding unity of invention (see paragraph 40, below) and the International Bureau collects the necessary number of additional fees before any supplementary search is begun, so that intervening correspondence with the applicant would delay establishment of the supplementary search report only in very rare cases. The supplementary search report only cites documents included in the main report to the extent that this is necessary for the indication of inventive step issues in relation to newly found citations.

(b) *Concurrent and sequential searches*: The request is made directly to the supplementary Authority within a deadline which is dependent on whether search requested is sequential or concurrent. The Authority requests the necessary documents from the International Bureau. Sequential searches otherwise follow effectively the same procedures as those under Alternative I. For concurrent searches, the supplementary Authority makes its own determination of unity of invention and requests any additional fees which are required as a result (and handles protests if it is decided to permit these—see paragraph 39, below); the supplementary search report may duplicate what appears in the main international search report and may cover inventions which are not made the subject of the main international search.

8. The matter was also discussed at the twelfth session of the Meeting of International Authorities Under the PCT (see paragraph 14, below). In the document presented to the 12th session of the Meeting of International Authorities (document PCT/MIA/12/2), it was suggested that, if both concurrent and sequential searches were permitted, they should be subject to the same rules and procedures. However, many Authorities felt that the different timing pointed to different approaches being needed to some matters. The draft Rules in Annex II therefore include a number of alternatives depending on the type of search, as

indicated above. While increasing slightly the complexity of the drafting, it has been attempted to minimize the complication which would be apparent to an applicant wishing to use the system while allowing the Authorities to use the information available to them to implement effectively whichever of the services they may offer.

BACKGROUND

9. According to Article 15,¹ the objective of the international search is “to discover relevant prior art”. In principle, prior art for the purposes of the PCT is a concept independent of place or language of disclosure: the International Searching Authority “shall endeavor to discover as much of the relevant prior art as its facilities permit” in order that the international search report be of maximum use to the applicant and designated Offices for determining whether the international application meets the requirements of novelty and inventive step according to any particular national law. Ideally, the scope and quality of the international search should be such that no designated or elected Office needs to repeat the search in the national phase. The considerations at that time should be limited to whether the citations are relevant to the particular definitions of novelty and inventive step which apply under the relevant national law.

10. However, it remains the case that no Office in the world is capable of thoroughly searching disclosures written in all languages, even if it has access to them in its search databases. Quite naturally, the majority of citations made by any International Searching Authority are in one of the languages in which the examiners in that Authority have particular proficiency. To a large extent, this reflects the fact that many technical disclosures have equivalents in other languages: either a direct equivalent in the form of another member of a patent family, or a translation of a book or paper, or else aspects of a particular technology may simply be described in many different places and the selection of one disclosure over another is a matter of convenience for the examiner, which makes no difference to the quality of the search. Nevertheless, the most relevant prior art for a particular invention will sometimes be in a language in which the main Authority is not specialized and, even if the main Authority has access to the document, it is likely to be considered only on the basis of an abstract and drawings, leaving a significant risk that its relevance will not be fully appreciated. Potentially of particularly high risk is the case where technology is being developed from earlier work which was unique to one region and all the relevant prior art may be in a language (and from a source) which would not normally be considered by an Authority which is competent for conducting the main search on international applications filed in a different region.

11. Even within the PCT minimum documentation, any International Searching Authority whose official languages do not include Japanese, Korean, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan, the Republic of Korea, the Russian Federation and the former Soviet Union, and those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available.

¹ 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.

At the start of 2003, of the 24.6 million patent documents which formed part of the minimum documentation, 8.7 million were in Japanese and 1.7 million were in Russian and would be searched by many Authorities only on the basis of an English language abstract, or else not at all.

12. Aside from the question of languages of documents, all of the International Searching Authorities have access to different bodies of information beyond what is set out in the PCT minimum documentation. Some Authorities may have access to specialized collections in particular fields of technology which are not available elsewhere.

13. There has been considerable support for the principle of allowing optional supplementary searches of international applications during the international phase in order to find additional relevant prior art at an early stage. The Working Group's discussions at its most previous session (see document PCT/R/WG/7/13, paragraphs 71 to 92) are outlined in the following paragraphs:

“IMPROVING THE QUALITY OF INTERNATIONAL SEARCHES

“71. Discussions were based on document PCT/R/WG/7/7.

“72. There was widespread support from both delegations and representatives of users for the principle of allowing supplementary international searches to be conducted on international applications, noting that early identification of as much relevant prior art as possible was useful for applicants, designated and elected Offices and third parties alike. There was, however, a significant variation in views concerning the aims and the most appropriate procedures for such searches.

“73. The Working Group strongly supported further development of the proposals relating to supplementary international searches and invited the Secretariat to prepare revised proposals for consideration at its next session, taking into account the comments and suggestions set out in the following paragraphs.

“74. There was interest from users in the possibility of international searches being updated towards the end of the international phase, to take into account relevant prior art which had not been available to the International Searching Authority when the international search report was established. Furthermore, it was noted that some International Preliminary Examining Authorities sometimes conducted such searches as part of the international preliminary examination. However, a number of delegations saw difficulties in introducing such searches as a mandatory part of international preliminary examination, noting that the mandatory nature of the proposal might conflict with Article 33(6), and that it might be difficult to achieve reliable results where the International Searching Authority and the International Preliminary Examining Authority were not the same Office. Furthermore, if this service was offered only as part of international preliminary examination, applicants might be encouraged to file demands for international applications where the full examination was not in fact desired. In the light of these concerns, the Working Group agreed not to continue discussion of this aspect of the proposals.

“General

“75. Many delegations emphasized the need for the supplementary international search system to be as simple and flexible as possible, and this to be kept in mind for future revision of the proposals.

“76. A number of delegations expressed concern that the introduction of supplementary international searches should not be permitted to adversely affect the delivery of existing services, including the main international search. The Delegation of Japan, for example, indicated that the Japan Patent Office would not be able to offer a supplementary international search service, at least at the outset, due to workload issues. Other delegations and representatives of users believed that a well-designed system need not increase the workloads of International Authorities and could, taking efficiencies in the national phase into account, reduce workload burdens overall. Some representatives of users pointed out that many applicants already filed national applications in parallel with international applications in order to gain the benefits of multiple searches, and that efficiencies could be gained for both Offices and applicants by allowing for multiple searches under the PCT. It was also emphasized that it was desirable to pursue measures for improving the quality of the main international search in addition to offering supplementary international searches.

“77. Several delegations noted that it was essential that supplementary international searches be optional for the applicant and emphasized that International Authorities should be able to determine the extent, if any, to which they would offer such searches. One delegation stressed, however, that it would only make sense to pursue the proposal if a substantial number of Authorities would be prepared to participate.

“78. One delegation suggested that it might be useful to allow third parties to request supplementary international searches to be performed on an international application. A representative of users indicated that such a feature would be of interest, but that it would be necessary to ensure that such requests could be filed anonymously.

“Purpose of the Supplementary International Search

“79. A majority of delegations considered that the primary purpose of a supplementary search should be to discover relevant prior art in languages which were a specialization of the Authority carrying out the supplementary international search (“supplementary Authority”) but not of the Authority that carried out the international search proper (“main Authority”), though some delegations felt that this was not appropriately reflected in the language of Rule 45*bis*.7. It was suggested by one delegation that the specialized languages which the supplementary Authority offered should be defined in the agreements between the Authorities and the International Bureau. The representative of the EPO expressed the view that supplementary Authorities should be free to determine the scope of the supplementary international search themselves.

“80. One delegation indicated that it was necessary to be clear as to why it was desired to offer a supplementary international search system, noting that it was impossible to guarantee that all relevant prior art could be found and that any search was necessarily a compromise between completeness and cost. The delegation considered that the PCT should not offer the type of commercial search which might be conducted by defendants

in infringement actions. Such broad searches could not be justified routinely. Rather, the supplementary search should aim to address the needs of applicants wishing not to be surprised by new citations found by designated Offices in the national phase and of Offices which did not presently recognize the international search as being sufficient for national phase processing.

“81. A considerable number of delegations noted the importance of minimizing unnecessary duplication of work, but many felt that the appropriate extent of a supplementary international search beyond what was essential to achieve the primary purpose should be determined by the supplementary Authority itself.

“82. Some delegations and representatives of users considered that the purpose of the supplementary international search should not be defined by the Regulations at all. Instead, each supplementary Authority could indicate the service which it was prepared to offer and allow applicants to decide whether this service was of interest to them. This would allow Authorities to offer different services, for example, specializing in certain technical areas where their search collections extended significantly beyond the PCT minimum documentation, rather than in particular languages. One delegation suggested that it might also be desirable to consider matters of competence of Authorities more generally so as to give the applicant the maximum choice in determining the extent of the international search appropriate to the international application concerned. One representative of users suggested that the scope of the supplementary international search should be determined by the supplementary Authority according to what further search it would normally perform on the international application if it had received it in its role as a designated Office in the national phase.

“Body to Which Request for Supplementary International Search Is Submitted

“83. The Working Group reaffirmed that requests for supplementary international searches should not be submitted to the receiving Office. A majority of delegations considered that the International Bureau seemed the most appropriate body to receive the request for supplementary international search, though it was noted that there were some advantages in making the request directly to the supplementary Authority, particularly if only a single supplementary international search was sought.

“84. One delegation suggested that, if the requests were not to be submitted only to the supplementary Authority, they should be able to be submitted to either the supplementary Authority or the International Bureau, at the choice of the applicant. A majority of delegations were opposed to such an idea, noting that it would add complexity and confusion to the system.

“Contents of the Supplementary International Search Report

“85. The Working Group agreed that the supplementary international search report should not include a written opinion but should list citations in a manner similar to an international search report, also including comments sufficient to make their relevance clear. One delegation suggested that it should not be necessary to list family members of the cited documents.

“Time of Requesting and Performing the Supplementary International Search

“86. Many delegations considered that supplementary international searches should only be able to be requested and performed after the transmittal of the main international search report, since otherwise there was a risk of duplication, inconsistency and unnecessary work, noting that there might be little value in a supplementary search where the main search showed that an invention was not new.

“87. Other delegations considered that there should be an option for Authorities to offer supplementary international searches concurrently with the main search. While some delegations were concerned that different approaches among Authorities might cause complications to the system and confusion for applicants, other delegations considered that such difficulties would be limited and that a flexible system might allow participation in the system by some Authorities which otherwise would not be in a position to deliver searches within the very short deadlines inherent in a system providing for sequential searches. One representative of users stated that minor complications would be worthwhile if the result was a wider range of participating Authorities, since new prior art being found in the national phase was a much more significant problem for applicants. It was also pointed out that the availability of services in different ways from different Authorities might offer, as the preferences of users became clear through the choices they expressed, some practical insight into the needs of users.

“88. The Working Group agreed that the Secretariat should, in revising the proposals, consider the issues involved in providing main and supplementary searches sequentially, concurrently or both.

“89. The Working Group agreed that an outer time limit for requesting a supplementary international search was appropriate to avoid prolongation of the international phase, though it was noted that exactly what the limit should be would depend on when the supplementary international search was to be performed and whether it could be requested alone, in conjunction with international preliminary examination, or in either way.

“Claims to Be Searched (Unity, Clarity, Subject Matter, etc.)

“90. The Working Group agreed that consideration of the proposals, as regards claims to be searched, should continue as provided in document PCT/R/WG/7/7, at least in respect of the case where the main and supplementary international searches were performed sequentially. Some representatives of users indicated that it would be desirable to allow supplementary international searches even on claims which had not been the subject of the main international search, provided that the applicant paid the appropriate fees.

“Fees and Documents to Be Provided by the Applicant

“91. One delegation suggested that, assuming that the International Bureau was the body to which fees relating to the supplementary international search were to be paid, it might be more efficient for the International Bureau to refund fees where the supplementary Authority did not conduct a supplementary international search because of a limitation on the subject matter on which it had agreed to conduct such searches.

“Availability and Translations of the Supplementary International Search Report

“92. One delegation suggested that it should be clarified that designated Offices and third parties should be able to obtain status information indicating whether a supplementary international search had been requested for a particular international application.”

14. The matter was also discussed at the twelfth session of the Meeting of International Authorities Under the PCT (see document PCT/MIA/12/2). The Meeting’s discussion of the proposals (see document PCT/MIA/12/10, paragraphs 20 to 26) is outlined in the following paragraphs:

“Supplementary International Searches

“20. Discussions were based on document PCT/MIA/12/2.

“21. A number of Authorities expressed support for the principle of permitting supplementary searches to be carried out under the PCT. Two Authorities noted that an intended benefit of the PCT was the ability to rely on a single central search, and believed that if the quality of the main international search was not considered adequate to be relied on in the national phase, this was a matter which should be addressed at source rather than by providing for the conduct of multiple or supplementary searches. Nevertheless, these Authorities were prepared to consider a system of suitably focussed supplementary searches.

“22. A majority of Authorities considered that supplementary searches should only be carried out after the main international search report had been established. They felt that such sequential searches would provide a more simple and less confusing system than if searches could also be performed concurrently. The supplementary Authority could use the contents of the international search report to avoid the need to reconsider the question of unity of invention and to target more accurately the range of prior art which might not have been covered in the main search, instead of duplicating it. Some Authorities considered that sequential searches would be beneficial in avoiding conflicting reports being given to the applicant by different Authorities. It was also suggested that if multiple Authorities could be requested to perform searches of equivalent scope, it might reduce confidence in the system since it created an expectation of differences in results. Concern was also expressed that offering directly equivalent searches might increase workloads and delays within Authorities due to Authorities spending additional time, out of proportion to the resulting improved quality of search, on search reports which would be directly compared with reports from other Authorities. If applicants wanted multiple complete searches at an early stage in order to be more certain as to the likely outcome in the national phase, this was possible in other ways, such as by seeking commercial searches or by use of the direct Paris Convention filing route.

“23. Two Authorities supported a system where Authorities could establish supplementary search reports concurrently with the main international search report. One of these Authorities indicated that it was unlikely to offer supplementary searches other than concurrently with the main report. It considered that, even if the system were slightly more complicated than one where only sequential searches were possible, this

might be desirable if it permitted greater participation by Authorities and delivered more complete search results to applicants at an earlier stage. A third Authority stated that it could support a system of sequential searches but preferred one permitting both concurrent and sequential searches.

“24. Some Authorities considered that the supplementary Authority should have greater flexibility to determine the scope of search to be performed than was implied by the proposals. One Authority in particular indicated that supplementary searches which it performed should have the same scope as if it were carrying out the main international search. It considered that a broad scope of supplementary search would not lead to duplication of work. Rather, work which would in any case have been done later, in the national phase, by the same Office in its capacity as a designated Office would be brought forward into the international phase, so that the search results would be available to the applicant earlier than otherwise. As to the possibility of differences of opinion occurring in reports by multiple Authorities, this would occur anyway in the form of differences between designated Offices in the national phase. It was likely that supplementary searches targeted at particular languages would not be any cheaper or less time-consuming for International Searching Authorities than complete searches and might not meet the aim of the overall search results being accepted by designated Offices without further searching in the national phase.

“25. The Meeting supported the general principle of permitting supplementary searches to be carried out under the PCT and agreed that amendments should be further developed by the Secretariat for submission to the Working Group on Reform of the PCT.

“26. The Chair noted that, since the Meeting was not in agreement as to the desirable timing and scope of supplementary searches, the proposals to be made by the Secretariat to the Working Group on Reform of the PCT would need to include options for both (i) sequential searches only and (ii) both sequential and concurrent searches. If possible, a draft would be made available on the PCT Reform electronic forum seeking informal comments prior to a final document being submitted to the Working Group.

“27. The following more specific comments were made on the draft Rules in Annexes I and II to document PCT/MIA/12/2. Some of the comments in relation to Rules in Annex I apply equally to equivalent Rules in Annex II.

“– *Proposals in Annex I: Sequential Searches Only*

“28. *Rule 45bis.2*: Consideration should be given to checks being carried out by the International Bureau, rather than the supplementary Authority, as to whether any limitation on numbers of supplementary searches to be conducted by a particular Authority had been exceeded.

“29. *Rule 45bis.4(f)(ii)*: The reference to Rule 49bis.9(b) should be deleted since refunds in that case would be given by the supplementary Authority, not the International Bureau.

“30. *Rule 45bis.7*: A number of Authorities considered that the suggested objective of supplementary international search was too restrictive and a more open objective (possibly as provided in the equivalent provision in Annex II) would afford individual Authorities more scope to determine what was appropriate.

“31. *Rule 45bis.12*: Consideration should be given to including an express provision to the effect that the supplementary search report would be made available to the public by the International Authority.

“32. *Rule 45bis.13*: Consideration should be given to whether the matters related to supplementary searches should be covered in the agreements between Authorities and the International Bureau, rather than by providing for notifications outside the agreements. It should also be clarified whether limitations on the supplementary searches to be performed by an International Authority were permitted on the basis of factors other than the number of searches which an Authority was prepared to carry out or the subject matter which an Authority was prepared to search.

“33. *Rule 53.2(a-bis)*: The reference to Rule 44bis.13 should be to Rule 45bis.13.

“34. *Rule 58.3(b)(i)*: It is not clear whether the term ‘associated’ would apply to a request for supplementary search which had been furnished other than with the demand. More broadly, consideration should be given to whether it should be possible to submit separately a request for supplementary search and a demand for international preliminary examination to be undertaken by the same Authority. This would be an even more significant issue in the system proposed in Annex II, where it would be more likely that a demand could be filed after a supplementary search had already been requested.

“35. *Rule 68*: Consideration needs to be given to the extent to which it should be possible to demand international preliminary examination and request supplementary search by the International Preliminary Examining Authority in respect of different inventions.

“– *Proposals in Annex II: Concurrent and Sequential Searches*

“36. Some Authorities suggested that if both concurrent and sequential searches were permitted, it was desirable for the Rules and procedures to be the same for either type of search as far as possible, although total equivalence might not be achievable.

“37. *Rule 4.1*: One Authority pointed out that the possibility of including a request for supplementary international search in the request under Article 3(2) would increase the workload of receiving Offices, since it would involve processing accompanying translations (for example, scanning the pages and making at least a cursory check of whether this corresponded to what was stated in the request to be included) and possibly also fees, and it would therefore be preferable if requests for supplementary search could be made only to the International Bureau. On the other hand it was noted that, since there is inevitably a delay in notifying the international application number to the applicant, it might be difficult to submit a complete and timely request for supplementary search to the International Bureau in cases where the Authority had specified a very short time limit for making such requests (for example, 13 months from the priority date, as one Authority had stated would be likely in its case).

“38. *Rule 45bis.1(a)*: Some Authorities noted again their view that it should only be possible to request supplementary searches after the main international search report had been established.

“39. *Rule 45bis.1(b)*: One Authority considered that the possibility for the supplementary Authority to specify its own time limit would add to the complexity of the proposed system. Another Authority responded that, in practice, an applicant would only need to be aware of two limits: a very short one (for example, expiring 13 months from the priority date) for those Authorities which performed only concurrent searches, and the generally prescribed time limit for all other Authorities.

“40. *Rule 45bis.1(c-bis)*: One Authority considered that providing for the applicant to make an indication relating to a possible future finding of lack of unity of invention, prior to consideration of the matter by the supplementary Authority, further demonstrated the complications of a system allowing for concurrent searches. Another Authority stated that the Rule should be expressed to more clearly relate to a possible subsequent finding of lack of unity by the supplementary Authority and set out the effect of the indication.

“41. *Rule 45bis.1(d)(ii)*: The words ‘has been required’ may not properly distinguish from the words ‘was required’, as used in the equivalent provision of Annex I, to make it clear that this provision only applies in the case where the main Authority has already required the applicant to provide a sequence listing in electronic form.

“42. *Rule 45bis.6(b)*: For clarity, the word ‘supplementary’ should be inserted before ‘report’ in the last line.

“43. *Rule 45bis.7*: One Authority which considered that the scope of a supplementary search should be the same as that for a main search believed that it was not appropriate to express the objective of a supplementary search as being to find prior art ‘complementary’ to that which has been found, or is likely to be found, by the main Authority.

“44. *Rule 45bis.8*: One Authority expressed concern about the lack of a provision equivalent to paragraph (c) in the equivalent Rule in Annex I, permitting a supplementary Authority to decide not to perform a supplementary search of a claim which had not been the subject of search by the main Authority. It considered that an Authority which performed sequential searches, targeted at limited subject matter, would set an accordingly reduced fee, but in the absence of such a provision would be faced with the choice of either performing a complete search of the invention or else producing a report of doubtful quality.

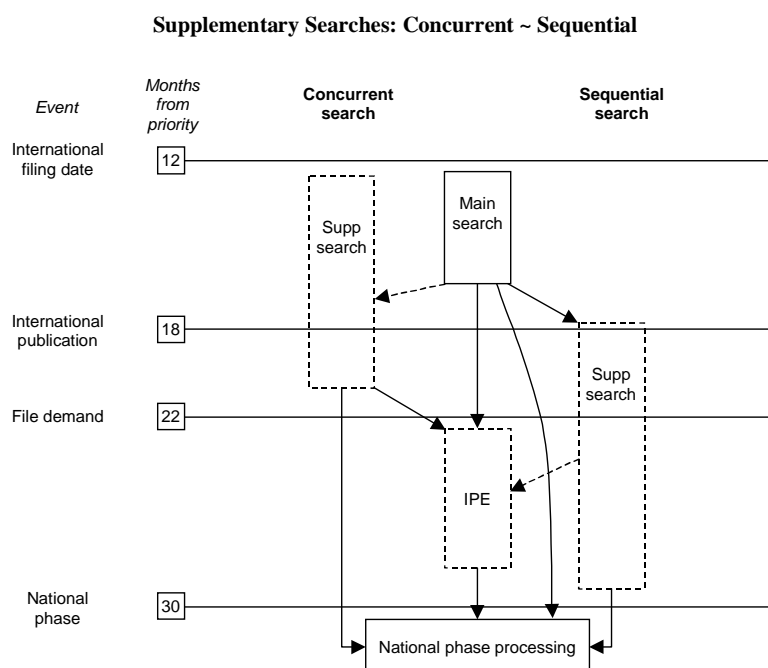
“45. *Rule 45bis.10*: One Authority considered that it was undesirable to provide for a protest procedure for cases where the supplementary Authority requested payment of additional fees for search of additional inventions. Another Authority believed that a protest system, though an exceptional case under the PCT, was a necessary exception. However, the latter Authority was concerned that, under the system proposed under this Rule, an applicant could be faced with several different findings on lack of unity from different Authorities at around the same time, each with different procedures and time limits for response. Another Authority considered that the approach taken in Annex I should apply to Authorities which conducted sequential searches.”

15. Comments were also invited on the document presented to the Meeting of International Authorities from any interested parties, using the Working Group’s electronic forum. The proposals in this document take into account the comments by the Working Group, the Meeting of International Authorities, and the responses to that invitation.

CONCURRENT AND SEQUENTIAL SEARCHES

16. At the seventh session of the Working Group, there was no consensus on whether supplementary searches should be offered only after the main international search had been established (“sequential searches”) or whether such searches could, or should, be performed at the same time as the main international search (“concurrent searches”). The Working Group agreed that the Secretariat should, in revising the proposals, consider the issues involved in providing main and supplementary searches sequentially, concurrently or both (see paragraphs 86 to 88 of document PCT/R/WG/7/13, reproduced above). Some of the main conclusions are set out in the following paragraphs.

17. The diagram below shows the typical availability of information with concurrent and sequential searches (the solid arrows show when reports from one stage would usually be available to another stage; the dotted arrows show when reports would sometimes be available to another stage).



Sequential Searches

18. *Pros:* Sequential searches have the potential to reduce duplicative and unnecessary work and to permit a better assessment of inventive step than concurrent searches. If the supplementary search is started after the main international search report is available:

- (a) The scope of the main search can be determined more reliably, allowing the supplementary search to concentrate on different search material to provide a complementary service rather than a duplicative one—while a supplementary Authority might often be able to

make reasonable assumptions concerning languages of specialization of the main Authority (see paragraph 19(c), below), the details of the online databases consulted may be of particular significance (noting that some commercial databases are very expensive to search and Authorities may benefit considerably from avoiding duplication of search in these).

(b) The main Authority's view on unity of invention could be taken as defining the inventions for the purpose of determining the claims to be searched and the need for any additional fees, avoiding delays and costs due to the need for each Authority to examine the question of unity, invite the payment of any additional fees and deal with protests (see paragraph 40, below).

(c) The applicant will, after the establishment of the international search report, be better able to assess which inventions were worth requesting supplementary searches for, avoiding the extra work and cost of additional searching of inventions which have either already been shown not to be new, or else have by that time been decided to be of insufficient commercial value.

(d) The supplementary Authority will be able to assess the relevance of potential citations to the inventive step of the invention in the light of the more complete set of prior art revealed by both the main and supplementary searches, rather than only according to that found in the supplementary search.

19. *Cons:* On the other hand, there are some difficulties with sequential searching, or factors which would reduce its apparent advantages:

(a) If supplementary searches are only commenced after the main search report is available, they will usually be completed later than if they had been begun at an earlier stage; this might often mean that the supplementary search report would not be available for use in any international preliminary examination and occasionally, where the main international search report was established particularly late, could leave a supplementary Authority with little time to establish a supplementary international search report before the end of the international phase.

(b) For some parts of an online search, it may not be much cheaper or easier to exclude documents from the supplementary search which are likely to have been considered by the main Authority (for example because they form part of the PCT minimum documentation) than to include them since active steps would need to be taken to define the relevant material and exclude it.

(c) The international search report at present only indicates languages of documents considered to the extent that this can be inferred from the entries on the form indicating the documentation and databases searched and the citations found (and it may be difficult and potentially misleading to make any detailed statement on language in view of the normal methods of online search)—the supplementary Authority would usually make assumptions about language on the basis of the languages in which the main Authority is known to specialize; such an assumption could be made just as easily before the international search report is established as afterwards.

20. Irrespective of the limitations noted in paragraph 19(b) and (c), above, sequential searches could certainly reduce unnecessary duplication in a supplementary search system by eliminating some searches entirely where the results of the main international search (or other events which have occurred in the meantime) mean that the applicant can see that a supplementary search would serve no useful purpose.

21. A possible system is set out in Annex I, wherein supplementary searches are offered sequentially following the main search.

Concurrent Searches

22. *Pros:* The main benefit of concurrent searches is, clearly, the possibility of delivering the supplementary search report more quickly (or allowing the Authority a greater time to establish it within the same final time limit).

23. *Cons:* The main difficulties all stem from the fact that, if the main search report has not yet been established, it is impossible for any of the parties to know the scope of the main search or to use the information within it to improve either the quality of the supplementary search or the efficiency of the procedures:

(a) It is difficult for an examiner to make an accurate judgement of the relevance of a piece of prior art to the inventive step of the international application if he is not aware of as broad a range of other relevant prior art as possible; if the supplementary search deliberately excludes (for example) the PCT minimum documentation on the grounds that it should be fully considered by the main Authority, but the results of the main search are not yet available, the supplementary examiner may not recognize the relevance of a document, leading it either to be cited as category "A" instead of "Y", or else not to be cited at all².

(b) Similarly, due to a less complete knowledge of the prior art, the assessment of unity of invention *a posteriori*³ by a supplementary Authority may be limited (though since the Authority's comments on unity would not be expected to be considered by designated and elected Offices, this would only be of any detriment to the Authority itself, as it would result in fewer additional fees than otherwise being requested for search of additional inventions).

(c) There would be no possibility of relying on the views of the main Authority with respect to unity, meaning that delays and administrative costs would need to be incurred in making the assessment, requesting additional fees and considering any protests.

(d) The applicant would need to decide whether to request supplementary searches without knowledge of the content of the international search report, leading to some supplementary searches being made which are of no value to the applicant at all.

² Category "A": Document defining the general state of the art which is not considered to be of particular relevance.

Category "Y": The 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. (*WIPO Standard ST.14*)

³ That is, a lack of unity of invention which only becomes apparent after taking the prior art into account.

24. The issues in paragraph 23(a) and (b) might result either in concurrent searches being of lower quality than sequential searches, or else in the Authority feeling the need to cover documentation which would also be considered in the main search, leading away from the concept of being a complement to the main search and towards being a second complete search. The issues in paragraph 23(c) and (d) would not affect the quality of the result, but would represent avoidable complications and inefficiencies in the system.

25. In view of these considerations, no proposals are presented wherein supplementary searches are offered *only* concurrently with the main search.

Both Concurrent and Sequential Searches

26. Different applicants will, of course, have different priorities in what they seek from a supplementary search system. Sometimes an applicant may want to know as much as possible about the prior art as early as possible (commercial searches are available for this purpose, but do not automatically get recognized by national Offices later to assist processing). At other times, the applicant may wish to consider use of supplementary searches depending on the results of the main search and any other commercial factors which may become apparent between the international filing date and any deadline which applies for requesting supplementary search.

27. Different Authorities, too, will have different concerns, particularly with regard to workflow. Some Authorities might be capable of delivering supplementary search reports within the international phase even if they were requested later than is currently permitted for demanding international preliminary examination (see paragraph 51 of document PCT/MIA/11/14). However, others consider that an earlier time limit would be necessary. The latter Authorities indicate that they might be unable to participate unless the time limit for requesting a supplementary search is very early on, before the time at which most international search reports are currently established.

28. One approach to this might be to offer a system where applicants were permitted to request supplementary search over a wide range of times with the deadline for requesting the supplementary search dependent on whether a concurrent or sequential search was requested, which in turn might be dependent on what forms of search were offered by a particular Authority.

29. The advantages and disadvantages of a system offering both concurrent and sequential searches would depend strongly on the details of the implementation. The main risks are:

(a) overcomplication if many different time limits exist for requesting supplementary search by different Authorities, or if different rules apply depending on whether the supplementary search is conducted before or after the main international search report has been established; and

(b) loss of the advantages of sequential searching if the supplementary Authority does not take sufficiently into account the main international search report whenever it has been established prior to the supplementary search being conducted.

30. A possible system is set out in Annex II, wherein supplementary searches may be requested either concurrently or sequentially. Two time limits are set: an early one for requesting concurrent search and a later one for requesting sequential search.

OTHER ISSUES

Body to Which Request for Supplementary International Search Is Submitted

31. At the seventh session of the Working Group (see paragraphs 83 and 84 of document PCT/R/WG/7/13, reproduced above), at which the proposal under consideration was for a system permitting sequential searches only, a majority of delegations considered that the International Bureau seemed the most appropriate body to receive the request for supplementary international search, though it was noted that there were some advantages in making the request directly to the supplementary Authority, particularly if only a single supplementary international search was sought. A majority of delegations were opposed to giving the applicant the choice of submitting the request to either the International Bureau or the supplementary Authority, noting that it would add complexity and confusion to the system.

32. Some large receiving Offices have indicated that they would be reluctant to permit requests for supplementary search to be included in the request under Article 4 because of the burden of handling translations (which might need to be scanned) and possibly fees, even if the request was simply to be passed on, without checking by the receiving Office, to the International Bureau.

33. After further consideration of the ways in which the applicant could be given a choice, Alternative I, where only sequential supplementary searches are permitted, retains the requirement that the request for supplementary search be made to the International Bureau (except in the particular case when the supplementary search is to be carried out as part of an international preliminary examination—see paragraphs 43 to 45, below). This approach minimizes:

(a) the number of currencies in which the fees need be set, since it would not be necessary to set the supplementary search handling fee in currencies other than those used by the International Bureau; and

(b) the number of administrative actions which need to take place, since the International Bureau can pass all the necessary documentation directly to the supplementary Authority, rather than the Authority having to request the information and then wait for a response; it would also permit a request for several supplementary searches to be processed in a single action instead of individually by different Authorities.

34. Alternative II, where both sequential and concurrent supplementary searches are permitted, provides for the requests being made directly to the supplementary Authority, since the fact that requests need to be made at different times and with different contents depending on the Authority concerned means that it is less likely that requests for several different supplementary searches could be handled simultaneously. Furthermore, if the criteria which need to be checked (such as timing of the request or the translations which are required) are dependent on the Authority involved, there is less risk of error if those checks are carried out by the relevant Authority, which need concern itself only with the criteria which it applies itself.

Scope of Supplementary Search

35. The discussions so far have not achieved a consensus on the appropriate scope of a supplementary search. Many delegations consider that such searches should be limited to documents which are likely not to have been part of the material searched by the main Authority, for example because of the difficulty in searching in certain languages, so that the supplementary search is a complement to the main search with a minimum of duplication.

36. On the other hand, some Authorities point out that to exclude specific documentation from an online search would take an active step by the examiner and as a result it often may not be significantly quicker or cheaper to perform a limited search than a complete one. If the Office performing that limited search then considered that it was still necessary to perform a more complete search in the national phase, there might be a greater duplication of work than would result from performing a supplementary search of wide scope.

37. In view of these differences of opinion, it is proposed that each Authority which offers supplementary searches should define the scope of the search which it will provide in its agreement with the International Bureau. These agreements are published in the PCT Gazette and the relevant information would also appear elsewhere, such as in the PCT Applicant's Guide. Applicants would then be able to decide whether the service offered by a particular Authority would be of benefit to them in any particular case.

Unity of Invention

38. Representatives of users have indicated that, where the international application is found to lack unity of invention, a supplementary search should not be limited to simply the first invention claimed, but rather that the applicant should be able to specify which claims should be searched and pay the appropriate fees (see, for example, paragraph 79 of document PCT/R/WG/6/12). The possible ways in which such a system could be implemented depend on whether supplementary searches are carried out concurrently with the main search or sequentially (or both).

39. If the main and supplementary searches are carried out concurrently, there would be no alternative but for the supplementary Authority to make its own assessment of unity of invention and request any additional fees. Options are provided (see Rule 45*bis*.8(a) in Annex II) to either include or not include a protest procedure for this function. While it might seem fair to permit a form of appeal against a request for additional fees, it is noted that the protest procedure is an exception within the PCT and that failure to obtain a supplementary search report on some inventions would not risk the possible consequence that those inventions might be considered withdrawn in some States unless a special fee is paid (see Article 17(3)(b)), which applies only to the main search.

40. For sequential searches, it is proposed (in both alternatives) that the supplementary search would rely on the view of the main Authority expressed in the main search report (together with any later results of a protest). This would not imply that the Authority would necessarily agree with that view later on in its possible role as an International Preliminary Examining Authority or as a designated or elected Office, but this would offer an administrative convenience, avoiding the delays of requesting additional fees and the cost and burden of any separate protest procedure.

Claims Covered by Main and Supplementary International Search Reports

41. In the concurrent searches available under Alternative II, it would not be possible to limit the supplementary search to claims covered by the main international search report (since the supplementary Authority would not know what action the main Authority would take). This means that the supplementary search may cover claims on which no main international search report is established, whether because of issues of unity of invention or because of differences in the subject matter which certain International Searching Authorities under Rule 39 are not required to search.

42. The results of a supplementary international search where a main international search had not been conducted would need to be treated with caution: if the supplementary search was limited in scope (for instance only to documents in certain languages), it would not be as near a complete review of the relevant prior art as a normal international search. Applicants should be aware of the limitations of any supplementary searches. International Preliminary Examining Authorities (or designated and elected Offices) considering a supplementary search report on claims not covered by a main international search report would need to decide on the merits of the case whether an opinion on novelty, inventive step and industrial applicability could be fully established, should not be established, or could be partially established including a caution that it is based on the results of a supplementary search which was intended to complement a main search report which was not in fact established.

Supplementary Search by the International Preliminary Examining Authority

43. The proposals make provision for supplementary searches to be performed by the International Preliminary Examining Authority. Clearly this would in general need to be requested as part of the demand and would have to be subject to the same time limit as the filing of the demand (it could be envisaged that a demand which had already been filed could be “corrected” to include a request for supplementary international search, though this possibility is not specifically provided for in the draft rules). Performing supplementary searches at the same time as international preliminary examination would be efficient in that an examiner would only need to consider the international application once to address both purposes, though it would only be practical in limited circumstances because the option would only be available if the desired Authority was a competent International Preliminary Examining Authority for the international application (which would be a major restriction for those applicants for whom the choice of Authorities is limited);

44. The procedures for supplementary search at the time of international preliminary examination would differ from those for supplementary searches carried out on their own in two main respects:

(a) Since the international preliminary examination takes place on the basis of any amendments to the international application which have been filed under Article 19 or 34, the supplementary search should be carried out on the same basis.

(b) Rather than establishing a separate supplementary international search report, the results would be noted on the citations pages of the international preliminary examination report in the same way that is currently done for documents where the examiner makes a new citation at that stage; as such, the availability of the search results to third parties would be subject to the rules which apply to the international preliminary examination report.

45. The proposed rules would permit different conditions to be made in the agreements between an International Authority and the International Bureau in respect of the Authority conducting supplementary searches together with international preliminary examination compared to those which applied to supplementary searches conducted as a separate service. Nevertheless, in order that the system be kept as simple as possible, it is hoped that Authorities would provide the service in both forms with equivalent scopes.

46. The Working Group is invited to consider the proposals and issues contained in this document

[Annex I follows]

ANNEX I

DRAFT AMENDMENTS OF THE PCT REGULATIONS:⁴ALTERNATIVE I:
SEQUENTIAL SEARCHES ONLY

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⁴ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 45bis

Supplementary International Searches

45bis.1 Request for Supplementary International Search

(a) The applicant may, after having received the international search report and within the time limit referred to in paragraph (b), request the International Bureau that a supplementary international search be carried out by one or more Authorities, other than the Authority which carried out the international search under Article 16(1), which have agreed to perform such searches (“Supplementary International Searching Authorities”).

[COMMENT: In this proposal, a supplementary search can only be requested after having received the international search report—if a declaration is made under Article 17(2)(a) by the main Authority, a subsequent request for supplementary search would be treated as not having been made.]

(b) The time limit referred to in paragraph (a) shall be whichever of the following expires later:

- (i) three months from the date of transmittal to the applicant of the international search report and the written opinion established under Rule 43bis.1; or
- (ii) 22 months from the priority date.

[COMMENT: The proposal in Annex II provides for an earlier time limit for requesting concurrent supplementary searches. In this proposal, which allows only sequential supplementary searches, an earlier time limit should not be necessary, noting that there should rarely, if ever, be any delay to the establishment of the supplementary search report caused by the need for the Authority to contact the applicant.]

[Rule 45bis.1, continued]

(c) A request under paragraph (a) shall contain:

(i) indications concerning the international application to which it relates, comprising the name and address of the applicant and the agent if there is an agent, the title of the invention, the international filing date and the international application number;

(ii) an indication of which Authorities are requested to carry out a supplementary international search;

(iii) where the international application was filed in a language which is not accepted by an Authority which is requested to carry out a supplementary international search, an indication of whether any translation which has been furnished to the receiving Office under Rule 12.3 or 12.4 is to form the basis of the supplementary international search to be carried out by that Authority; and

(iv) where the International Searching Authority considers that the international application does not comply with the requirement of unity of invention, an indication of which of the inventions in respect of which the international search report was established are to be the subject of the supplementary international search.

[COMMENT: The applicant would be permitted to choose any of the inventions to be the subject of the supplementary international search, as long as that invention had been searched by the International Searching Authority. The main invention would not necessarily need to be included.]

[Rule 45bis.1, continued]

(d) A request under paragraph (a) shall, where applicable, also be accompanied by:

(i) any translation of the international application required under Rule 45bis.4;

(ii) a copy of any sequence listing in electronic form complying with the standard provided for in the Administrative Instructions which was required by the International Searching Authority under Rule 13ter.1(a).

[COMMENT: At present, the International Searching Authority does not forward a copy of sequence listings provided for the purpose of international search to the International Bureau, since they do not form part of the international application and are not published. An alternative possibility would be for such listings to be sent by the International Searching Authority to the International Bureau automatically with the international search report, so that the applicant would not be required to furnish further copies for any supplementary searches.]

(e) The fees payable under Rules 45bis.2 and 45bis.3 shall be paid to the International Bureau within one month from the date of receipt of the request for supplementary international search. The amount payable shall be the amount applicable on the date of payment.

45bis.2 Supplementary Search Handling Fee

(a) A request for a supplementary international search filed with the International Bureau under Rule 45bis.1(a) shall be subject to the payment of a fee for the benefit of the International Bureau (“supplementary search handling fee”). The amount of the supplementary search handling fee is as set out in the Schedule of Fees. The International Bureau shall refund to the applicant any supplementary search handling fee paid if:

(i) the request for a supplementary international search is withdrawn before the supplementary search copy is sent to the Authority carrying out the supplementary international search; or

(ii) the request for a supplementary international search is considered, under Rule 45bis.5(c), not to have been made.

[COMMENT: The amount of this fee would be set to cover the cost of processing the request and results, including checking the request, forwarding the necessary documents to the International Searching Authority carrying out the supplementary international search, making any necessary translations and making the results available to Offices and the public.]

(b) The amount of the said fees in any currency prescribed by the International Bureau, other than the currency in which the fee is set in the Schedule of Fees, shall be established by the Director General. The amounts so established shall be the equivalents, in round figures, of the amount set in the Schedule of Fees. They shall be published in the Gazette.

45bis.3 Supplementary Search Fee; Additional Supplementary Search Fee

(a) Each Supplementary International Searching Authority may require that the applicant pay a fee (“supplementary search fee”) for its own benefit for carrying out a supplementary international search and an additional fee (“additional supplementary search fee”) for carrying out searches on any invention beyond the first one searched.

[COMMENT: The “first” invention means the first which is to be the subject of a supplementary international search, not necessarily the “first mentioned in the claims” as is specified for the main international search under Article 17(3)(a).]

(b) The supplementary search fee and any additional supplementary search fee shall be collected by the International Bureau. Rule 16(b) to (e) shall apply *mutatis mutandis*.

(c) The International Bureau shall refund the supplementary search fee and any additional supplementary search fee to the applicant if:

(i) the request for a supplementary international search is withdrawn before the supplementary search copy is sent to the Authority carrying out the supplementary international search; or

(ii) the request for a supplementary international search is considered, under Rule 45bis.5(c), not to have been made.

[Rule 45bis.3, continued]

(d) To the extent that the International Searching Authority finds a protest of the applicant under Rule 40.2(c) justified, the Authority carrying out the supplementary international search shall totally or partially refund any additional supplementary search fee paid by the applicant.

[COMMENT: Draft Rule 45bis.3 is modeled on Rule 16. The currencies currently prescribed by the International Bureau in its role as a receiving Office in respect of the collection of search fees are the Swiss franc, the Euro and the US dollar. While refunds of fees would be carried out by the International Bureau under paragraph (f) when the request for supplementary international search is withdrawn or considered withdrawn, refunds under paragraph (g) following a successful protest would require consideration by the Authority carrying out the supplementary international search of the extent to which the refund was appropriate. The Administrative Instructions would need to be modified so as to indicate that the International Bureau must forward the results of any protest to all Authorities carrying out a supplementary international search.]

45bis.4 Translation for Supplementary International Search

Where neither the language in which the international application was filed nor that in which a translation (if any) has been furnished under Rule 12.3 or 12.4 is accepted by the Authority carrying out the supplementary international search, the request for a supplementary international search shall be accompanied by a translation of the international application into a language which is accepted by that Authority and is a language of publication.

[COMMENT: Modeled on Rule 12.3. For simplicity of processing, the translation would need to be filed at the same time as the request for the supplementary international search. This does not appear to be an unreasonable burden since the time limit will inevitably be several months after the international filing date, allowing more time to prepare the translation than is permitted for the translation for the purposes of the main international search.]

45bis.5 Acknowledgement of Receipt and Checking of Request for Supplementary

International Search

(a) The International Bureau shall promptly acknowledge receipt of a request for supplementary international search. Where the International Bureau finds that any of the indications required under Rule 45bis.1(c) or any elements required under Rule 45bis.1(d) are missing, it shall invite the applicant to furnish the indications or elements within one month from the date of the invitation.

(b) Where, by the time they are due under Rule 45bis.1(e), the International Bureau finds that the fees under Rules 45bis.2 and 45bis.3 have not been paid in full, the International Bureau shall invite the applicant to pay to it the amount required to cover those fees within a time limit of one month from the date of the invitation.

[COMMENT: It is not envisaged that applicants would often use this provision deliberately to extend the period for payment of fees or the provision of translations because of the risk that the supplementary search report would not be established in time for use in making decisions on whether to enter the national (or regional) phase. Consequently, although making and following up the invitation would significantly add to the work required of the International Bureau in any particular case, it is not proposed at this time to include a late payment fee. This would need to be reviewed if significant numbers of invitations needed to be issued.]

(c) If the applicant does not, before the expiration of the time limit under paragraph (a), furnish the required indications or elements or does not, before the expiration of the time limit under paragraph (b), pay the amount in full of the fees due, the request for supplementary international search shall, subject to paragraph (d), be considered as if it had not been made and the International Bureau shall inform the applicant accordingly.

[Rule 45bis.5, continued]

(d) Where a request has been made for the search of additional inventions but insufficient additional supplementary fees have been paid, the request shall be considered to be a request for supplementary international search on as many of the inventions as required fees have been paid. The Administrative Instructions shall determine which of the inventions shall be the subject of the supplementary international search.

[COMMENT: The Administrative Instructions would require that where the inventions to be searched had been listed, the supplementary international searches would be performed on the appropriate number of inventions in the order in which they were listed. Where they were not listed, the search would normally be performed in the order in which the inventions appeared in the claims, but would leave some scope for discretion (for example, ignoring inventions which would not be subject to supplementary international search in accordance with Rule 45bis.7(b) on grounds of their subject matter).]

(e) On finding that the requirements under Rules 45bis.1(c), (d) and (e) have been complied with, the International Bureau shall promptly transmit to each Authority which is to carry out a supplementary international search one copy of each of the following:

(i) the request for a supplementary international search;

(ii) the international application;

(iii) any sequence listing furnished under Rule 45bis.1(d)(ii);

(iv) any translation furnished by the applicant under Rule 12.3, 12.4 or 45bis.4 which is to be used as the basis of the supplementary international search;

[Rule 45bis.5(e), continued]

(v) the international search report; and

(vi) the written opinion established under Rule 43bis.1.

[COMMENT: It would not normally be necessary for the supplementary Authority to consider the written opinion, but it might occasionally be useful in determining whether the main Authority had considered the full text of a cited document or only an abstract.]

45bis.6 Start of Supplementary International Search

(a) Subject to paragraph (b), the Authority carrying out a supplementary international search shall start that search promptly on receipt of the documents specified in Rule 45bis.5(e).

(b) If the Authority requested to carry out a supplementary international search finds that such search would be excluded by a limitation made in accordance with Rule 45bis.11(b), the request for supplementary international search shall be considered not to have been made and the Authority shall promptly notify the applicant and the International Bureau accordingly. The Authority shall refund to the applicant the supplementary search fee and any additional supplementary search fees which have been paid under Rule 45bis.3.

[COMMENT: The applicant's right to a refund under this paragraph would extend only to the case where the supplementary international search is not made because of a restriction made in accordance with proposed Rule 45bis.11(b) and not because of a declaration equivalent to that under Article 17(2)(a).]

45bis.7 Basis and Scope of the Supplementary International Search

(a) The supplementary international search shall be carried out on the basis of the international application as filed or of a translation thereof indicated under Rule 45bis.1(c)(iii) or accompanying the request for supplementary international search under Rule 45bis.4.

[COMMENT: Under this proposal the supplementary international search cannot begin before the main international search report has been transmitted. Consequently, it would always be possible for the applicant to file amendments under Article 19 before the supplementary international search commenced. However, if such amendments were to be taken into account the main and supplementary international search reports would be more difficult to read together and in some cases it would be difficult to know how to supplement, rather than restart, the international search.]

(b) For the purposes of the supplementary international search, Article 17(2) and Rules 13ter.1, 33 and 39 shall apply *mutatis mutandis*.

[COMMENT: The Authority would not be required to carry out a supplementary international search in respect of subject matter or unclear applications for which it would not be required to carry out an international search. It should also be able to request sequence listings in an appropriate electronic form if necessary.]

(c) The Authority carrying out a supplementary international search shall not be required to establish a supplementary international search report in respect of any claim for which no international search report was established.

(d) The supplementary international search shall cover at least the documentation indicated in the agreement between the Supplementary International Searching Authority and the International Bureau in accordance with Rule 45bis.11(a).

[COMMENT: See paragraphs 35 to 37 of the main body of this document.]

45bis.8 Unity of Invention

(a) The Supplementary International Searching Authority shall carry out a search on those inventions, as identified by the International Searching Authority, which have been indicated in the request under Rule 45bis.1(c)(iv), provided that the International Searching Authority has established an international search report and the necessary fees have been paid. If no indication is given in the request, the search shall be carried out on the first invention identified by the International Searching Authority.

(b) To the extent that the International Searching Authority finds a protest of the applicant under Rule 40.2(c) justified, the Supplementary International Searching Authority shall totally or partially refund any relevant additional supplementary search fee paid by the applicant in accordance with Rule 45bis.3.

[COMMENT: See Rule 45bis.5(d) for how the request is treated in the event that not all the additional supplementary search fees are paid.]

45bis.9 Supplementary International Search Report

(a) The Authority carrying out a supplementary international search shall establish a supplementary international search report, or make a declaration pursuant to Rule 45bis.7(b) or (c) that no supplementary international search report will be established, within three months from the receipt of the request for supplementary international search by the Authority from the International Bureau or 22 months from the priority date, whichever is later.

[COMMENT: Modeled in part on Rule 42.1.]

[Rule 45bis.9, continued]

(b) For the purposes of establishing the supplementary international search report, Rules 43.1, 43.2 and 43.4 to 43.10 shall, subject to paragraph (c), apply *mutatis mutandis*. Article 20(3) and Rule 44.3 shall apply *mutatis mutandis*.

[COMMENT: The supplementary international search report would take the same form as a normal international search report, except that it would not require the Authority to reconsider and list the classification and that it would only include the newly found citations (except where a previously found document is considered relevant to inventive step in combination with a newly found document; see paragraph (c), below). The report would be established in the language of publication of the international application or in the language of any translation on which the search was based, at the choice of the Authority. The same requirement to send copies of the citations on request to the applicant or to a designated Office would apply as for the main international search.]

(c) The supplementary international search report shall not contain the citation of any document which was cited in the international search report, except to the extent that the document is considered relevant to the question whether the claimed invention involves an inventive step having regard also to one or more other documents which were discovered during the supplementary international search and which were not cited in the international search report.

[COMMENT: The supplementary international search report should not merely duplicate citations which appeared in the international search report; the International Search and Preliminary Examination Guidelines would make it clear that this extends to “equivalent” patent publications, unless there is found to be a material difference between the family members. Furthermore, it might lead to uncertainty if the Authority concerned took a different view to the International Searching Authority in a report which is part of the international search process. However, where it is apparent that a document has been cited merely on the basis of an abstract and the Authority conducting the supplementary international search finds that the relevance of the document was incorrect based on a consequential misunderstanding of its contents, the PCT International Search and Preliminary Examination Guidelines would make clear that the entry in the international search report should be regarded as a citation of the abstract and that it is acceptable in this case to cite the original document in the supplementary international search report.]

45bis.10 Transmittal and Effect of the Supplementary International Search Report

(a) The Authority carrying out the supplementary international search shall, on the same day, transmit one copy of the supplementary international search report, or a declaration that no supplementary international search report shall be established because a situation referred to under Rule 45bis.7(b) or (c) exists, to the International Bureau and one copy to the applicant.

(b) Subject to paragraph (c), Article 20(1) and Rules 45.1, 47.1(d) and 70.7(a) shall apply as if the supplementary international search report were part of the international search report.

[COMMENT: The supplementary international search report would, where necessary, be translated into English and be communicated automatically to any Office requesting a copy of the main international search report. The Administrative Instructions would make clear that, unless the international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty) had already been established and transmitted to the International Bureau, the supplementary international search report would always be forwarded to the International Preliminary Examining Authority so that it could be taken into account, if possible, even though international preliminary examination might already have begun. Public access to the supplementary international search report would be permitted under existing Rule 94.1(b) at any time after publication of the international application. Although it is not proposed to make a formal republication of the pamphlet to include the supplementary international search report, the online file inspection system would be arranged so that a person viewing the pamphlet would be aware of any supplementary report and could view it together with the main report.]

(c) A supplementary international search report need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if it is received by that Authority after it has begun to draw up that opinion or report.

[Rule 45bis.10, continued]

[COMMENT: Modeled on Rule 66.4*bis*. The International Preliminary Search and Examination Guidelines would make clear that the International Preliminary Examining Authority should take the supplementary international search and written opinion into account whenever possible, but should not delay the start of international preliminary examination to wait for them.]

45bis.11 *International Searching Authorities Prepared to Carry Out Supplementary*

International Search

(a) If an International Searching Authority is prepared to carry out supplementary international searches, the documentation to be included in a supplementary international search and the conditions under which the Authority shall act as a Supplementary International Searching Authority shall be set out in the agreement under Article 16(3)(a) between the Office or organization and the International Bureau.

(b) The conditions in paragraph (a) may include limitations as to the subject matter for which such searches will be carried out, beyond those which would apply under Article 17(2) to an international search, or to the total number of supplementary international searches which will be performed in a given period.

[COMMENT: Authorities would be able to limit the availability of such supplementary international searches to particular fields of technology, for example to exclude fields for which an Authority may not have sufficient capacity at the time, or where an Authority wished to specialize in fields of technology in which it has a particular expertise. The notification could be amended at a later stage to introduce or remove such limitations as necessary.]

Rule 53

The Demand

53.1 [No change]

53.2 Mandatory and Optional Contents; Signature

[COMMENT: It is proposed to amend the heading to match that of Rule 4.1 since, with the introduction of optional contents, the subjects of the Rules would be equivalent.]

(a) [No change]

(a-bis) The demand may contain a request that the International Preliminary Examining Authority carry out a supplementary international search, provided that the national Office which is acting as International Preliminary Examining Authority is not the same as that which acted as International Searching Authority and has agreed to carry out such searches.

(a-ter) Where, at the time that the demand is made, a request for supplementary international search under Rule 45bis.1 has been made to the Office which is acting as International Preliminary Examining Authority but no supplementary international search report has been established by that Office, that Authority may treat the request as having been made under paragraph (a-bis).

[COMMENT: This would allow the Authority to avoid the complication of dealing separately with the processes of supplementary search and international preliminary examination, noting that the amendments which would be included in the international preliminary examination would not be taken into account for the purposes of a separate search.]

[Rule 53.2, continued]

(b) [No change]

53.3 to 53.9 [No change]

Rule 58

The Preliminary Examination and Supplementary Search Fees **Fee**

58.1 *Right to Ask for a Fee*

(a) [No change] Each International Preliminary Examining Authority may require that the applicant pay a fee (“preliminary examination fee”) for its own benefit for carrying out the international preliminary examination and for performing all other tasks entrusted to International Preliminary Examining Authorities under the Treaty and these Regulations.

(a-bis) Each International Preliminary Examining Authority which has agreed to carry out supplementary searches may require that the applicant pay a fee (“supplementary search fee”) for its own benefit for carrying out the supplementary search.

[COMMENT: Fees for supplementary international searches of additional inventions are provided for in the proposed amendments to Rule 68, together with fees for examination of additional inventions.]

(b) The amount of ~~the~~ any preliminary examination fee, ~~if any,~~ and any supplementary search fee shall be fixed by the International Preliminary Examining Authority. As to the time limit for payment of the preliminary examination and supplementary search fees and the amount payable, the provisions of Rule 57.3 relating to the handling fee shall apply *mutatis mutandis*.

[Rule 58.1, continued]

(c) The preliminary examination fee and any supplementary search fee shall be payable directly to the International Preliminary Examining Authority. Where that Authority is a national Office, it shall be payable in the currency prescribed by that Office, and where the Authority is an intergovernmental organization, it shall be payable in the currency of the State in which the intergovernmental organization is located or in any other currency which is freely convertible into the currency of the said State.

58.2 [Remains deleted]

58.3 *Refund*

(a) The International Preliminary Examining Authorities shall inform the International Bureau of the extent, if any, to which, and the conditions, if any, under which, they will refund any amount paid as a preliminary examination fee where the demand is considered as if it had not been submitted, and the International Bureau shall promptly publish such information.

(b) The International Preliminary Examining Authority shall refund to the applicant any supplementary search fee and any additional supplementary search fees paid to it if:

(i) the demand or the associated request for a supplementary international search is withdrawn or considered not to have been submitted before the supplementary international search has been started; or

[Rule 58.3(b), continued]

(ii) the request for a supplementary international search is considered, under Rules 45bis.5(b) and 66.1ter, not to have been made.

Rule 66

**Procedure Before the
International Preliminary Examining Authority**

66.1 Basis of the International Preliminary Examination

(a) [No change] Subject to paragraphs (b) to (d), the international preliminary examination shall be based on the international application as filed.

(b) [No change] The applicant may submit amendments under Article 34 at the time of filing the demand or, subject to Rule 66.4*bis*, until the international preliminary examination report is established.

(c) [No change] Any amendments under Article 19 made before the demand was filed shall be taken into account for the purposes of the international preliminary examination unless superseded, or considered as reversed, by an amendment under Article 34.

(d) [No change] Any amendments under Article 19 made after the demand was filed and any amendments under Article 34 submitted to the International Preliminary Examining Authority shall, subject to Rule 66.4*bis*, be taken into account for the purposes of the international preliminary examination.

(e) [No change] Claims relating to inventions in respect of which no international search report has been established need not be the subject of international preliminary examination.

[Rule 66.1, continued]

(f) Paragraphs (a) to (e) shall apply *mutatis mutandis* to any supplementary international search carried out at the same time as the international preliminary examination.

66.1*bis* [No change]

66.1*ter* *Supplementary International Search by the International Preliminary Examining Authority*

For the purposes of supplementary international searches by the International Preliminary Examining Authority, Rules 45*bis*.5(c) and 45*bis*.11 shall apply *mutatis mutandis*.

[COMMENT: Supplementary international searches by the International Preliminary Examining Authority would be subject to the same possibility for limitations, such as in respect of subject matter for which the service is made available, as any other supplementary search. There would not be a formal supplementary search report. Rather, the results would be cited in the international preliminary report on patentability, in the same way as is currently done for documents which are considered relevant but were not cited in the international search report (see Rule 70.7). The Administrative Instructions would require that the report should indicate that a supplementary international search had been conducted together with the international preliminary examination.]

66.2 to 66.9 [No change]

Rule 68

Lack of Unity of Invention

(International Preliminary Examination)

68.1 [No change]

68.2 *Invitation to Restrict or Pay*

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees, the invitation shall:

(i) to (iii) [No change]

(iv) indicate the amount of the required additional preliminary examination fees to be paid in case the applicant so chooses;

(v) where the applicant has requested a supplementary international search and any additional invention has been the subject of an international search, indicate the amount of the required additional supplementary search fees to be paid if a supplementary international search is to be carried out in respect of each such additional invention; and

[Rule 68.2, continued]

(vi) ~~(v)~~ invite the applicant to pay, where applicable, the protest fee referred to in Rule 68.3(c) within one month from the date of the invitation, and indicate the amount to be paid.

68.3 *Additional Fees*

(a) The amount of the additional fees due for international preliminary examination under Article 34(3)(a) and, where the International Preliminary Examining Authority has indicated that it is prepared to carry out supplementary international searches, for supplementary international search of any additional invention shall be determined by the competent International Preliminary Examining Authority.

(b) The additional fees due for international preliminary examination under Article 34(3)(a) and any supplementary international search shall be payable direct to the International Preliminary Examining Authority.

(c) to (e) [No change]

68.4 and 68.5 [No change]

Schedule of Fees

[COMMENT: The Schedule of Fees would require amendment to include a supplementary search handling fee, whose level would be set to cover the cost of preparation, transmission, translation and making available of documents relevant to the supplementary international search during the Chapter I procedure. For supplementary international searches performed as part of the Chapter II procedure, no such fee would be necessary since no significant additional work for the International Bureau would be involved over and above that for which the handling fee under Rule 57 is levied.]

[Annex II follows]

ANNEX II

DRAFT AMENDMENTS OF THE PCT REGULATIONS: ⁵

ALTERNATIVE II:
CONCURRENT AND SEQUENTIAL SEARCHES

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⁵ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 45bis

Supplementary International Searches

45bis.1 Request for Supplementary International Search

(a) The applicant may, within the relevant time limit referred to in paragraph (b), request any Authority, other than the International Searching Authority responsible for the international search under Article 16(1), to carry out a supplementary international search of either of the following types:

- (i) a supplementary international search independent of the search under Article 16(1) (“concurrent supplementary search”); or
- (ii) a supplementary international search taking into account the results of the search under Article 16(1) (“sequential supplementary search”);

provided that the Authority in question has agreed to perform searches of the relevant type (“Supplementary International Searching Authority”).

[COMMENT: This proposal provides for requests to be made directly to the supplementary Authority. Although there is no specific restriction that requests for sequential supplementary search be made only after the main search report has been issued, it would be in the applicant’s interests to wait since the supplementary Authority would not issue any invitation to pay additional fees in respect of additional inventions found by the International Searching Authority before issuing a supplementary search report.]

[Rule 45bis.1, continued]

(b) The time limit referred to in paragraph (a) shall be:

(i) with respect to requests for concurrent supplementary search, one month from the date of notification to the applicant by the receiving Office of the international application number and the international filing date;

(ii) in the case of a request for sequential supplementary search, three months from the date of transmittal to the applicant of the international search report and the written opinion established under Rule 43bis.1 or 22 months from the priority date, whichever expires later.

[COMMENT: See paragraphs 27 and 28 of the main body.]

(c) A request for concurrent supplementary search submitted to an Authority which has agreed only to carry out sequential supplementary searches shall be considered to be a request for sequential supplementary search, and *vice versa*.

[Rule 45bis.1, continued]

(d) A request under paragraph (a) shall contain:

(i) indications concerning the international application to which it relates, comprising the name and address of the applicant and the agent if there is an agent, the title of the invention, the international filing date and the international application number; and

[COMMENT: The time limit in paragraph (b) is set so that it would always be possible to provide the international application number, even for concurrent supplementary searches.]

(ii) where the international application was filed in a language which is not accepted by the Authority which is to carry out a supplementary international search, an indication of whether any translation which has been furnished to the receiving Office under Rule 12.3 or 12.4 is to form the basis of the supplementary international search to be carried out by that Authority.

[COMMENT: The time limit for furnishing a translation under Rule 12.4 would normally be significantly later than the time limit for requesting a concurrent supplementary search. It would only be permitted to indicate that such a translation was to be relied on where it had already been furnished to the receiving Office at the time that the request for supplementary search was made.]

[Rule 45bis.1, continued]

(e) In the case of a request for sequential supplementary search, where the International Searching Authority considers that the international application does not comply with the requirement of unity of invention, the request may include an indication of which of the inventions in respect of which the international search report was established are to be the subject of the supplementary international search.

[COMMENT: In a sequential supplementary search, the supplementary Authority would follow the opinion of the main Authority and would begin the supplementary search immediately on the basis of the number of fees which had been paid without interrupting the process with a request to pay additional fees.]

(f) A request under paragraph (a) shall, where applicable, be accompanied by:

(i) any translation of the international application required under Rule 45bis.4;

(ii) a copy of any sequence listing in electronic form complying with the standard provided for in the Administrative Instructions which was required by the International Searching Authority under Rule 13ter.1(a).

[COMMENT: If the main Authority invites such a sequence listing, it is likely that a supplementary Authority will do so also. Consequently it would be more efficient both for the applicant and the Authority if the listing is included with the request for supplementary international search.]

45bis.2 Supplementary Search Handling Fee

(a) Each request for supplementary international search shall be subject to the payment of a fee for the benefit of the International Bureau (“supplementary search handling fee”) to be collected by the Supplementary International Searching Authority. Rule 57.2 shall apply mutatis mutandis. The amount payable shall be the amount applicable on the date of payment.

[COMMENT: The amount of this fee would be set to cover the cost of processing the request and results, including checking the request, forwarding the necessary documents to the International Searching Authority carrying out the supplementary international search, making any necessary translations and making the results available to Offices and the public.]

(b) The Supplementary International Searching Authority shall refund the supplementary search handling fee to the applicant:

(i) if the request for supplementary international search is withdrawn before that request has been sent by the Authority to the International Bureau; or

(ii) if the request for supplementary international search is considered, under Rule 5(d), not to have been made.

[COMMENT: Modeled on Rule 57.6.]

45bis.3 Supplementary Search Fee; Additional Supplementary Search Fee

(a) Each Supplementary International Searching Authority may require that the applicant pay a fee (“supplementary search fee”) for its own benefit for carrying out the supplementary international search and an additional fee (“additional supplementary search fee”) for carrying out searches on any invention beyond the first one searched. An Authority which has agreed to carry out both concurrent and sequential supplementary searches may set different fees for the two types of search. The fees shall be payable direct to the Supplementary International Searching Authority.

[COMMENT: If an Authority decides to offer the choice of either concurrent or sequential searches to an applicant, different fees may be charged, to reflect the different amounts of work which might be involved.]

(b) The supplementary search fee shall be paid within one month from the date of the request for supplementary international search. The amount payable shall be the amount applicable on the date of payment.

(c) In the case of a request for sequential supplementary search, the supplementary search fee shall be accompanied by an additional supplementary search fee for each invention beyond the first one requested under Rule 45bis.1(e) to be the subject of supplementary international search.

[COMMENT: In the case of concurrent supplementary search, the supplementary Authority has to form its own opinion on unity of invention and request additional fees at a later stage; see draft Rule 45bis.8(a)]

45bis.4 Translation for Supplementary International Search

Where neither the language in which the international application was filed nor the language in which a translation (if any) has been furnished under Rule 12.3 or 12.4 is accepted by the Supplementary International Searching Authority, the request for a supplementary international search shall be accompanied by a translation of the international application into a language which is accepted by that Authority and is a language of publication.

45bis.5 Acknowledgement of Receipt and Checking of Request for Supplementary International Search

(a) On receipt of a request under Rule 45bis.1(a), the Supplementary International Searching Authority shall promptly notify the applicant of receipt and send a copy of that request to the International Bureau.

[COMMENT: It is desirable to acknowledge receipt of the request immediately since it will often not be possible to check whether the request is valid without a copy of the international application (in the event that the Authority has placed restrictions on the technologies for which the service is provided) or an translation which it is indicated should be used and, in the case of sequential search, without a copy of the international search report (to show whether there has been a finding of lack of unity of invention).]

(b) The International Bureau shall promptly send the Supplementary International Searching Authority one copy of each of the following:

(i) the international application (“supplementary search copy”);

[Rule 45bis.5(b), continued]

(ii) any translation furnished by the applicant under Rule 12.3 or 12.4 which is to be used as the basis of the supplementary international search;

[COMMENT: If a translation under Rule 12.4 had been indicated, but this had not in fact been received by the International Bureau from the receiving Office (within a reasonable period allowing for delays in transmission), this would be notified to the supplementary Authority, which would then require a translation under Rule 45bis.4 to correct the defect in the request for supplementary international search.]

(iii) if available, the international search report or declaration referred to in Article 17(2)(a) and the written opinion established under Rule 43bis.1;

[COMMENT: Although a concurrent supplementary search is said to be independent of the main search, it is proposed that a copy of the search report should be sent to the supplementary Authority in the rare event that it is already available before a request for concurrent supplementary search is made.]

(iv) if available, a copy of any protest and decision thereon made by the applicant to the International Searching Authority.

[COMMENT: Similarly, although an Authority carrying out a concurrent supplementary search would assess unity of invention independently, it may be useful for that Authority to see any additional arguments made by the applicant in the event that these are already available.]

[Rule 45bis.5, continued]

(c) In the case of a request for sequential supplementary search, if any item listed in paragraph (b)(iii) or (iv) is not available to the International Bureau at the time that the supplementary search copy is transmitted under paragraph (b), that item shall be transmitted to the Authority as soon as it becomes available, if this occurs prior to the transmittal of the supplementary international search report by the Authority or, in the case of item (iv), at any time.

(d) Where the Supplementary International Searching Authority finds that the supplementary international search would be excluded by a limitation made in accordance with Rule 45bis.11, the request for supplementary international search shall be considered not to have been made and the Authority shall promptly notify the applicant accordingly. The Authority shall refund to the applicant the supplementary search fee and any additional supplementary search fees which have been paid under Rule 45bis.3.

[COMMENT: The supplementary search handling fee would also be refunded in this case (see draft Rule 45bis.2(b)(ii)).]

(e) Where the Supplementary International Searching Authority finds that any of the indications required under Rule 45bis.1(d) or (e) or any elements required under Rule 45bis.1(f) are missing, it shall invite the applicant to furnish the indications or elements within one month from the date of the invitation.

[Rule 45bis.5, continued]

(f) Where, by the time they are due, the Authority finds that the fees under Rules 45bis.2 or 45bis.3 have not been paid in full, the Authority shall invite the applicant to pay to it the amount required to cover those fees within a time limit of one month from the date of the invitation.

(g) If the applicant does not, before the expiration of the time limit under paragraph (e), submit the required indications or elements or does not, before the expiration of the time limit under paragraph (f), pay the amount in full of the fees due, the request for supplementary international search shall, subject to paragraph (h), be considered not to have been made and the Authority shall inform the applicant accordingly.

(h) In the case of a request for sequential supplementary search, where a request has been made for the search of additional inventions but insufficient additional supplementary fees have been paid, the request shall be considered to be a request for supplementary international search on as many of the inventions as required fees have been paid. The Administrative Instructions shall determine which of the inventions shall be the subject of the supplementary international search.

45bis.6 Start of Supplementary International Search

On finding that the requirements under Rules 45bis.1(d), (e) and (f) have been complied with, the Supplementary International Searching Authority shall start that search promptly, provided that at least the following documents have been received from the International Bureau:

(i) in the case of a request for concurrent supplementary search, the documents specified in items (i) and (ii) of Rule 45bis.5(b).

(ii) in the case of a request for sequential supplementary search, the documents specified in items (i) to (iii) of Rule 45bis.5(b).

[COMMENT: Concurrent search requires only a copy of the international application and any translation. Sequential search requires also a copy of the international search report.]

45bis.7 Basis and Scope of the Supplementary International Search

(a) The supplementary international search shall be carried out on the basis of the international application as filed, or of a translation thereof indicated under Rule 45bis.1(d)(ii) or accompanying the request for supplementary international search under Rule 45bis.4.

(b) For the purposes of the supplementary international search, Article 17(2) and Rules 13ter.1, 33 and 39 shall apply *mutatis mutandis*.

[Rule 45bis.7(b), continued]

[COMMENT: The Authority would not be required to carry out a supplementary international search in respect of subject matter or unclear applications for which it would not be required to carry out an international search. It should also be able to request sequence listings in an appropriate electronic form if necessary.]

(c) In the case of a sequential supplementary international search, the Supplementary International Searching Authority shall not be required to establish a supplementary international search report in respect of any claim for which no international search report was established.

(d) The supplementary international search shall cover at least the documentation indicated in the agreement between the Supplementary International Searching Authority and the International Bureau in accordance with Rule 45bis.11.

[COMMENT: See paragraphs 35 to 37 of the main body of this document.]

45bis.8 Unity of Invention

(a) In the case of a concurrent supplementary search, if the Supplementary International Searching Authority considers that the international application does not comply with the requirement of unity of invention, Article 17(3)(a) and [Rule 40][Rule 40.1(i) and (ii)] shall apply *mutatis mutandis*.

[Rule 45bis.8(a), continued]

[COMMENT: Under this proposal, the supplementary Authority would make its own assessment of unity of invention and request any additional supplementary search fees in the same way as is done for the main international search, including the possibility of a payment being made under protest. The first option in square brackets represents the possibility of a protest procedure being included, equivalent to that which applies for the main international search. The second option would not permit a protest procedure. See paragraph 39 of the main body of the document.]

(b) In the case of a sequential supplementary search, the Supplementary International Searching Authority shall carry out a search on those inventions, as identified by the International Searching Authority, which have been indicated in the request under Rule 45bis.1(e), provided that the International Searching Authority has established an international search report and the necessary fees have been paid. If no indication is given in the request, the search shall be carried out on the first invention identified by the International Searching Authority. To the extent that the International Searching Authority finds a protest of the applicant under Rule 40.2(c) justified, the Supplementary International Searching Authority shall totally or partially refund any relevant additional supplementary search fee paid by the applicant in accordance with Rule 45bis.3(c).

45bis.9 Supplementary International Search Report

(a) The Authority carrying out a supplementary international search shall establish a supplementary international search report, or make a declaration pursuant to Rule 45bis.7(b) or (c) that no supplementary international search report will be established, within three months from the receipt of the request under Rule 45bis.1(a) or 22 months from the priority date, whichever is later.

[Rule 45bis.9(a), continued]

[COMMENT: A longer time limit would be permitted for the establishment of a supplementary search report than for the main international search, but it would be desirable for the report to be available, where possible, in time for any international preliminary examination.]

(b) For the purposes of establishing the supplementary international search report,

Rules 43.1, 43.2 and 43.4 to 43.10 shall, subject to paragraph (c), apply *mutatis mutandis*.

Article 20(3) and Rule 44.3 shall apply *mutatis mutandis*.

[COMMENT: The supplementary international search report would take the same form as a normal international search report, except that it would not require the Authority to reconsider and list the classification and that it would only include the newly found citations (except where a previously found document is considered relevant to inventive step in combination with a newly found document; see paragraph (c), below). The report would be established in the language of publication of the international application or in the language of any translation on which the search was based, at the choice of the Authority. The same requirement to send copies of the citations on request to the applicant or to a designated Office would apply as for the main international search.]

(c) In the case of a sequential supplementary search, the supplementary international search report shall not contain the citation of any document which was cited in the international search report, except to the extent that the document is considered relevant to the question whether the claimed invention involves an inventive step having regard also to one or more other documents which were discovered during the supplementary international search and which were not cited in the international search report.

45bis.10 Transmittal and Effect of the Supplementary International Search Report

(a) The Authority carrying out the supplementary international search shall, on the same day, transmit one copy of the supplementary international search report, or a declaration that no supplementary international search report shall be established because a situation referred to under Rule 45bis.7(b) or (c) exists, to the International Bureau and one copy to the applicant.

(b) Subject to paragraph (c), Article 20(1) and Rules 45.1, 47.1(d) and 70.7(a) shall apply as if the supplementary international search report were part of the international search report.

[COMMENT: See equivalent comment in Annex I.]

(c) A supplementary international search report need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if it is received by that Authority after it has begun to draw up that opinion or report.

[COMMENT: See equivalent comment in Annex I.]

45bis.11 International Searching Authorities Prepared to Carry Out Supplementary

International Search

(a) The types of supplementary international search, if any, which will be performed, the documentation to be included in a supplementary international search and the conditions under which an International Searching Authority shall act as a Supplementary International Searching Authority shall be set out in the agreement under Article 16(3)(a) between the Office or organization and the International Bureau.

(b) The conditions in paragraph (a) may include limitations as to the subject matter for which such searches will be carried out, beyond those which would apply under Article 17(2) to an international search, or to the total number of supplementary international searches which will be performed in a given period.

Rules 53, 58, 66, 68; Schedule of Fees

[As in the proposals in Annex I]

[End of Annex II and of document]