

Patent Cooperation Treaty (PCT) Working Group

**Eighth Session
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REVIEW OF THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

Document prepared by the International Bureau

1. The PCT Assembly (“the Assembly”), at its thirty-sixth session held in September/October 2007, amended the PCT Regulations to introduce a supplementary international search system. These amendments entered into force on January 1, 2009 (document PCT/A/36/13).
2. At its forty-third session in October 2012, the Assembly reviewed the supplementary international system. The decision by the Assembly following this review is set out in paragraph 27 of document PCT/A/43/7 as follows:
 - “27. The Assembly, having reviewed the supplementary international search system three years after the date of entry into force of the system, decided:
 - (a) to invite the International Bureau to continue to closely monitor the system for a period of another three years, and to continue to report to the Meeting of International Authorities and the Working Group on how the system is developing;
 - (b) to invite the International Bureau, International Authorities and national Offices and user groups to increase their efforts to raise awareness of and promote the service to users of the PCT system;
 - (c) to invite the International Authorities which offer supplementary international searches to consider reviewing the scope of their services provided under the system and consequently the levels of fees charged for the services provided, which should be reasonable; and to invite Authorities which currently do not offer the service to reconsider whether to offer the service in the near future;

(d) to review the system again in 2015, taking into account further developments until then, notably in relation to efforts to move towards collaborative search and examination models and in relation to efforts to improve the quality of the “main” international search.”

3. To provide an update on the supplementary search system and to gather information and feedback on the system to prepare the review decided by the Assembly in paragraph 27(d) of document PCT/A/43/7, the International Bureau sent Circular C. PCT 1429, dated October 23, 2014, to Offices in their various capacities (receiving Office, International Searching and Preliminary Examining Authority and/or designated/elected Office), and certain intergovernmental and non-governmental organizations representing users of the PCT system. Applicants who had requested a supplementary international search in the past were also sent the Circular to invite their feedback. For ease of reference, the Circular will be made available to the Working Group in the form of a non-paper; it is also available from the WIPO web site at <http://www.wipo.int/pct/en/circulars/2014/index.html>.

RESPONSES RECEIVED TO CIRCULAR C. PCT 1429

4. The International Bureau received 39 responses to Circular C. PCT 1429; 12 of these were from International Searching and Preliminary Examining Authorities (four from Authorities offering supplementary international search, and eight from Authorities not offering supplementary international search); 21 of these were from other IP Offices and six were from user groups or applicants.

EXPERIENCES OF THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

International Authorities Offering Supplementary International Search

5. Authorities commented that requests came from a limited number of applicants, who generally had been using the system for several years. It could therefore be assumed that these applicants were satisfied with the system. Almost all of the requests for supplementary international search had been made in English. To the extent that the International Authority concerned offered different types of supplementary international searches, most supplementary international searches had been requested in local documentation only; for example, one applicant consistently requested supplementary international search to cover Russian language documents. Other reasons for requesting supplementary international search were to cover claims that had not been searched in the “main” international search, due to lack of unity of invention or the examiner making a declaration under Article 17(2)(a) for claims that the main International Searching Authority was not required to search. One Authority suggested that a closer analysis of its supplementary international search reports had shown that they had been used as a basis for deciding on national/regional phase entry, since in many cases the applicant had decided not to enter the national/regional phase after a negative supplementary international search report.

6. All International Authorities reported that they took the “main” international search report into account when carrying out the supplementary international search, provided it was available to them. In practice, this would mean the examiner would look at the extent of the earlier search and the documents found before deciding how to perform the supplementary search, bearing in mind the interest of the applicant to have a search different from the “main” international search rather than citing the same documents as the international search report. One Authority reported that it had always found further documents. For this Authority, in some cases the finding on patentability was different for all claims, particularly when the “main” international search had found only ‘A’ documents but the supplementary international search had found ‘X’ and/or ‘Y’ documents, and in many cases there had been a negative finding on patentability for the independent claims, but views had not been the same on the patentability of the dependent claims. One other Authority reported that for the small number of supplementary international searches it had performed, the overall findings had been similar to those of the

“main” international searches, but it cited documents different from the “main” international search to give additional information to the applicant. A further Authority stated that, in most cases, it had ended up with results different from the “main” international search, and that most of the relevant citations it had found during supplementary international search had been documents in its national language.

7. In general, International Authorities offering supplementary international search believed that the service was useful for applicants in certain circumstances, such as where claims had not been searched by the “main” International Searching Authority, where applicants had the wish to search document collections in certain languages, or where applicants sought further information before entering the national phase.

International Authorities not Offering Supplementary International Search

8. None of the International Authorities that do not offer supplementary international search indicated an intention to provide this possibility to applicants in the near future, citing workload concerns and the low level of interest from applicants. International Authorities in English-speaking countries also pointed out that users had shown an interest in supplementary searches covering documentation in additional languages mostly falling outside the PCT minimum documentation, which these International Authorities did not possess or have access to.

9. One Authority believed that the focus should be on improving the quality of the “main” international search and stated that it could therefore not support supplementary international search aimed at adding to the search results from other International Searching Authorities to overcome the diversity of languages of prior art documents. Instead, each International Searching Authority needed to have the capacity to search foreign language documents across the minimum documentation.

Designated/Elected Offices

10. Most designated or elected Offices which responded to the questionnaire did not have any experience with international applications entering the national phase for which a supplementary international search report had been established. Those Offices which had examined applications with a supplementary international search report in the national phase stated that the low number of such cases had made it difficult to draw any conclusions on the usefulness of the supplementary international search report to designated/elected Offices.

11. One Office reported that of the international applications in respect of which a supplementary international search report had been established and which had entered the national phase, only very few prior art documents cited in the supplementary international search report which had not been cited in the “main” international search report had been used as the basis for the first Office action during national phase processing. That Office stated further that, in some cases, the difficulty of using prior art documents which had been cited in the supplementary international search report in national Office actions might stem from the fact that much of the prior art cited in the supplementary international search report was not in English (unlike is the case in the “main” international search report, which often will list an English language equivalent in the patent family).

12. However, in general, the supplementary international search report was perceived to be helpful, as it provided information to help the applicant to decide whether to proceed to the national phase, and the supplementary international search could simplify and accelerate national phase processing. For example, at the European Patent Office, which issues a written opinion together with its supplementary international search reports, the applicant was required to reply to that written opinion on entry to the European regional phase, but the application would not be subject to a supplementary European search fee.

Users of Supplementary International Search

13. Users who had requested supplementary international search in the past stated that they had found the service useful and would use it again. One user stated that he would have appreciated receiving a full written opinion to accompany the supplementary international search report.

REASONS FOR LOW USE OF SUPPLEMENTARY INTERNATIONAL SEARCH

14. In general, the “main” international search report and written opinion of the International Searching Authority were recognized as being of high quality and sufficient for the applicant in most cases. Responses indicated that supplementary international search was unattractive to applicants due to high fees and complexity of the service. Another regularly cited reason for the low use was that neither the Japan Patent Office nor the Korean Intellectual Property Office or the State Intellectual Property of the People’s Republic of China offered supplementary international search.

15. Opinions differed on whether applicants were sufficiently aware of supplementary international search. Some responses stated that lack of awareness was a reason for the low uptake of supplementary international search and encouraged further awareness raising activity, whereas others stated that, while applicants were sufficiently aware of supplementary international search, most did not believe a supplementary international search would provide significant added value.

16. A number of Offices and users commented on the range of languages accepted for an application requesting supplementary international search. To date, almost all supplementary international search requests have been performed on international applications in English. However, responses indicated that offering more languages for supplementary international search would make it more attractive and reduce the need to translate an international application for supplementary international search.

17. A few Offices considered that the timing of supplementary international search in the international phase contributed to the low uptake from applicants and it did not defer costs to the applicant. A supplementary international search request had to be filed before 19 months priority date, regardless of whether the “main” international search report was available. In addition, the supplementary international search report had to be established within 28 months of the priority date. A supplementary international search report therefore did not provide additional information to the applicant to decide on whether to withdraw an application before international publication. Moreover, some responses indicated that international preliminary examination was a preferable option to supplementary international search, given that the applicant could amend the claims during the international preliminary examination. Finally, some Offices pointed out that an applicant might not see the need to obtain a supplementary international search report if designated Offices performed their own search on an application entering the national phase.

SUGGESTED IMPROVEMENTS TO THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

18. Two possible changes to supplementary international search were suggested in the responses that would require amendments to the PCT Regulations:

- (a) One International Authority reported that some users had asked for supplementary international search to be based on an amended set of claims, but added that this would increase the burden on the Authority specified for supplementary search, which would be required to check the amendments.

(b) One Office suggested allowing another six months for an applicant to request supplementary international search; this would move the deadline for requesting supplementary international search to 25 months. Another Office suggested the opposite, with the time limits for the applicant to request supplementary international search and for the Authority to establish the supplementary international search report being brought forward.

19. Some responses requested more International Authorities to offer supplementary international search.

20. One International Authority offered a detailed written opinion with the supplementary international search report which was prepared to the same standard as written opinion by the "main" International Searching Authority. This Authority suggested that other Supplementary International Searching Authorities should also provide this benefit.

21. Some responses from Offices and user groups suggested that the fees set by International Authorities for supplementary international search should be lower.

22. A number of suggestions were made relating to the handling of applications with a supplementary international search report in the national phase which could make supplementary international search more attractive. For example, designated/elected Offices could reduce fees, offer accelerated processing and give broader recognition to the search results during the international phase for applications with a supplementary international search report.

CONSIDERATION BY THE WORKING GROUP

23. The uptake of supplementary international search has remained very low. However, the number of requests for supplementary international search has increased in each of the last three years since the last review of the system, with 46 requests received in 2012, 67 in 2013 and 102 in 2014. Experiences of those requesting supplementary international search and International Authorities providing this service were largely positive.

24. The replies to the questionnaire suggest a number of reasons for the low interest in the supplementary international search, notably the requirement to translate an international application if it is not in one of the languages offered by International Authorities for supplementary international search, the level of fees, the lack of an International Authority working in one of the Asian languages offering the service, and possible lack of awareness of among applicants. Since the previous review in 2012, no International Authority has begun offering supplementary international search, and only one Supplementary International Searching Authority has introduced a cheaper service focused on documentation in its national languages.

25. None of the responses to the questionnaire suggested that supplementary international search should be discontinued. Certain applicants continue to request supplementary international search and those International Authorities offering supplementary international search have indicated that the costs of providing supplementary international search are minimal compared to the set-up costs. From the perspective of International Authorities offering supplementary international search, it may therefore not make sense financially to stop the service at this stage.

26. As to a possible way forward, the Working Group may wish to consider the proposals submitted in reply to the questionnaire as to how to improve the supplementary international search system. In terms of amending the legal framework, one suggestion was to allow a supplementary international search to be based on claims amended under Article 19. However, providing for this possibility would require the Supplementary International Searching Authority

to check the amendments. Furthermore, since July 1, 2014, all International Preliminary Examining Authorities are required to conduct a “top-up” search under new Rule 66.1 *ter*, which provides the possibility of some further searching in the international phase on amended claims.

27. The Working Group may further wish to consider further initiatives to improve the attractiveness of the supplementary international search system without amending the legal framework, whether undertaken by Offices acting in their capacity as an International Searching and Preliminary Examining Authority or as a designated/elected Office, or by the International Bureau. Other than continuing to raise awareness to the system, the responses to the questionnaire show interest for more Authorities to offer supplementary international search, particularly in certain languages. The service may also be more attractive if designated/elected Offices provided benefits for the applicant in the processing of applications with a supplementary international search report. Better timeliness of issuing the “main” international search report would also mean fewer applicants would be required to decide on supplementary international search without the “main” international search results.

28. Since the previous review of the supplementary international search system, the European Patent Office, the Korean Intellectual Property Office and the United States Patent and Trademark Office concluded, in October 2012, a second pilot project on collaborative search and examination. The results of this pilot project were presented to the Working Group at its sixth session in May 2013 (see document PCT/WG/6/22 Rev.). More recently, the European Patent Office presented a document to the twenty-second session of the Meeting of International Authorities in February 2015, proposing a third pilot project to develop the collaborative search and examination concept (see document PCT/MIA/22/13). The third pilot project is proposed to last about three years. This period would cover the time to set up the infrastructure to run the pilot, to register users, and then to follow applications in the pilot in the international phase and national/regional phase. At the earliest, the pilot would conclude in the second half of 2018, after which an evaluation of the pilot would need to be conducted.

29. Alternatively, rather than starting a discussion on whether to modify or discontinue the supplementary international search system, and taking into account this third pilot project, the Working Group may wish to consider to continue monitoring the system in the coming years and recommend that the Assembly should perform a further review of the supplementary international search system and its further development or possible discontinuation only after the third pilot project on collaborative search and examination. In view of the timescale of the proposed third collaborative search and examination pilot project, an appropriate point for a further review of the supplementary international search system would be about five years from now.

CONSIDERATION BY THE MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT

30. The Meeting of International Authorities under the PCT (PCT/MIA) discussed the supplementary international search system at its twenty-second session, held in Tokyo from February 4 to 6, 2015. These discussions are summarized in the Summary by the Chair (paragraphs 44 to 46 of document PCT/MIA/22/22, reproduced in the Annex to document PCT/WG/8/2), notably paragraph 46, as follows:

“46. Despite the low use of the supplementary international search service, there were no clear views expressed on discontinuing the service at this stage. The ongoing costs of providing the service at a Supplementary International Searching Authority were minimal compared to necessary investment to begin offering supplementary international search. Those Authorities expressing a view on the suggested five year review period were favorable to this idea, but there were differences in opinion on the correlation between supplementary international search and a possible collaborative search and examination model in the PCT.”

POSSIBLE RECOMMENDATION TO THE PCT UNION ASSEMBLY

31. Should the Working Group consider it appropriate to continue monitoring the system in the coming years and recommend that the Assembly should perform a further review of the supplementary international search system and its further development or possible discontinuation only after the third pilot project on collaborative search and examination, as set out in paragraph 29, above, it may wish to consider recommending to the Assembly to adopt the following decision:

“The PCT Assembly, having reviewed the supplementary international search system three years after the date of entry into force of the system and again in 2015, decided:

“(a) to invite the International Bureau to continue to closely monitor the system for a period of a further five years, and to continue to report to the Meeting of International Authorities and the Working Group on how the system is developing;

“(b) to invite the International Bureau, International Authorities and national Offices and user groups to continue their efforts to raise awareness of and promote the service to users of the PCT system;

“(c) to invite the International Authorities which offer supplementary international searches to consider reviewing the scope of their services provided under the system and consequently the levels of fees charged for the services provided, which should be reasonable; and to invite Authorities which currently do not offer the service to reconsider whether to offer the service in the near future;

“(d) to review the system again in 2020, taking into account further developments until then, notably in relation to efforts to move towards collaborative search and examination models and in relation to efforts to improve the quality of the “main” international search.”

32. *The Working Group is invited:*

(i) to comment on the issues raised in this document, and

(ii) to consider the draft recommendation to the Assembly set out in paragraph 31, above.

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