

Patent Cooperation Treaty (PCT) Working Group

Sixth Session
Geneva, May 21 to 24, 2013

SUPPLEMENTARY INTERNATIONAL SEARCH

Document prepared by the International Bureau

1. At its forty-third session, held from October 1 to 9, 2012, the PCT Assembly reviewed, on the basis of a document prepared by the International Bureau (document PCT/A/43/3) the supplementary international search system, three years after the date of entry into force of the system. Details of the discussions by the Assembly are set out in paragraphs 22 to 27 of the report of the session (document PCT/A/43/7). Following the review of the system, the PCT Assembly decided (paragraph 27 of the report):

“(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.”

2. In accordance with the decision by the PCT Assembly, the International Bureau reported on the development of the supplementary international search system to the twentieth session of the Meeting of International Authorities, held in Munich from February 6 to 8, 2013 (document PCT/MIA/20/5). The discussions by the Meeting of International Authorities are outlined in paragraphs 27 to 33 of document PCT/MIA/20/14, reproduced in the Annex to document PCT/WG/6/3.

3. The present document provides an update on the development of the supplementary international search system, in accordance with the decision of the PCT Assembly. In addition, it discusses activities undertaken by the International Bureau to raise awareness of the system and the future scope of supplementary international search services offered by International Authorities.

DEVELOPMENT OF SUPPLEMENTARY INTERNATIONAL SEARCH

4. There are currently six International Authorities competent to carry out supplementary international searches: the Austrian Patent Office, the European Patent Office, the National Board of Patents and Registration of Finland, the Nordic Patent Institute, the Federal Service of the Intellectual Property, Patents and Trademarks of the Russian Federation, and the Swedish Patent and Registration Office. Further information on the languages accepted for international search by these Authorities, the documentation covered by the supplementary international search and the fees charged for supplementary international search can be found in paragraphs 7 to 11 of document PCT/WG/5/8.

5. Demand from applicants for supplementary international searches remains low. In 2009 when the service began, 24 supplementary international search requests were made. The number of requests rose to 41 in 2010 and has remained around this level with 41 requests in 2011 and 44 requests in 2012. Five requests have been made in 2013 up to the end of February. Altogether, 155 requests for supplementary international searches have been made since the system came into operation. Of these requests, 109 were made to the Federal Service of the Intellectual Property, Patents and Trademarks of the Russian Federation, 33 to the European Patent Office, six to the Swedish Patent and Registration Office, three each to the Nordic Patent Institute and the Austrian Patent Office, and one to the National Board of Patents and Registration of Finland. Almost 85 per cent of requests originate from the top five applicants for supplementary international search.

6. In 2012, the European Patent Office received the most requests for supplementary international search with 20 requests in total, followed by the Federal Service of the Intellectual Property, Patents and Trademarks of the Russian Federation with 19 requests, with two each at the Nordic Patent Institute and the Austrian Patent Office, and one at the National Board of Patents and Registration of Finland. An analysis of these requests shows that most requests were made following receipt of a "main" international search report containing "X" or "Y" citations, as occurred in previous years (see paragraph 14 of document PCT/WG/5/8).

7. Almost all requests for supplementary international searches since the launch of the service had the European Patent Office as the "main" International Searching Authority, except where the Supplementary International Searching Authority was the European Patent Office.

8. Of the 33 requests for supplementary international search made to the European Patent Office, 21 related to applications first searched by the State Intellectual Property Office of the People's Republic of China, and five of the 33 requests related to applications first searched by the Korean Intellectual Property Office. A majority of supplementary international search requests were therefore made to a Supplementary International Searching Authority with language skills different from those of the "main" International Searching Authority, resulting in

the international search and supplementary international search together covering documents in a diverse range of languages and thereby extending the scope of search beyond the PCT minimum documentation.

ACTIVITIES TO RAISE AWARENESS

9. The International Bureau continues its efforts to raise awareness of the supplementary international search system by providing information on the service as part of its PCT seminar training program and other user outreach and promotional activities. Information on the supplementary international search system has also been included in PCT Brief, a new PCT resource on the Internet which contains a high-level overview of recent and future developments in the PCT for managers and attorneys as the main target readership, along with hyperlinks to more in-depth information if needed. Additional activities presently under consideration include delivering webinars dedicated to supplementary international search and strengthening cooperation with organizations representing users of the system to jointly reach out to the user community. A further idea which found general interest at the recent Meeting of International Authorities was to include standardized text about supplementary international search on the forms communicating the international search report and written opinion to applicants (see paragraph 30 of document PCT/MIA/20/14).

SCOPE OF SUPPLEMENTARY INTERNATIONAL SEARCH SERVICES OFFERED BY INTERNATIONAL AUTHORITIES

10. As part of the review of the supplementary international search system by the Assembly, the International Bureau sent a Questionnaire annexed to Circular C. PCT 1329 in December 2011 to gather information and feedback on the functioning of the system from Offices in their various PCT capacities as well as from organizations representing users of the PCT system and all applicants who had requested supplementary international search in the past. The feedback from users in relation to future changes to the supplementary international search services is summarized in paragraph 32 of document PCT/WG/5/8:

“32. In general, applicants responding to the Questionnaire showed a great interest in supplementary international searches being carried out by additional Authorities with expertise in specific languages, especially Asian languages. They commented that supplementary international search reports would be very helpful when deciding whether to enter the national phase in the country for which the Supplementary International Searching Authority acted. Others showed an interest in supplementary international search being offered by all of the IP5 group of Offices. Yet others considered it to be of particular interest if supplementary international searches were to be carried out in respect of subject matter which the “main” International Authority was not required to search in accordance with PCT Article 17(2)(a). Others suggested that the supplementary international search system could be improved by reducing the costs of the service, by establishing the international search report on time and by recognizing the results of the supplementary international search report during the national phase, such as by not conducting another search or by offering reduced fees during the national phase.”

11. At the recent Meeting of International Authorities, held in Munich from February 6 to 8, 2013, International Authorities provided an update on their plans, if any, to provide for supplementary international search or review the scope of services currently offered (see paragraphs 31 and 32 of document PCT/MIA/20/14)

12. *The Working Group is invited:*

(i) to note the report on the development of the supplementary international system set out in paragraphs 4 to 8, above;

(ii) to comment on the activities related to raising awareness of and promoting the service to users of the PCT system, as discussed in paragraph 9, above, and provide an update on any awareness-raising and promotional activities undertaken; and

(iii) to comment on the scope of the services offered under the supplementary international search system, as discussed in paragraphs 10 and 11, above.

[End of document]