

## **Patent Cooperation Treaty (PCT) Working Group**

**Seventh Session  
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**TRANSMITTAL BY THE RECEIVING OFFICE OF EARLIER SEARCH AND/OR  
CLASSIFICATION RESULTS TO THE INTERNATIONAL SEARCHING AUTHORITY**

*Document submitted by the Republic of Korea and the European Patent Office*

### **SUMMARY**

1. It is proposed that, where available and applicable under the national law, the receiving Office should provide to the competent International Searching Authority results of search and/or classification it performed as national Office on earlier application(s) forming the basis of priority claim(s) for the international application.

### **BACKGROUND**

2. As many national Offices are striving to reduce the examination pendency period, it is expected that the period in many offices will fall below 10 or 11 months in the near future. Since a typical international search under the Patent Cooperation Treaty (PCT) is to be completed within 16 months from the priority date, a growing number of international applications with earlier search results in respect of their family application(s) will become available at the time of PCT international search in future. Sometimes, national search reports are accompanied by written opinions which might also be of interest for the International Searching Authority.

3. Finally, it is also noted that international applications whose family applications have been assigned classification codes by the national Office prior to international search are now also becoming commonplace.

4. However, in the current procedure under the PCT, there is no official arrangement for transmitting these search or classification results to the International Searching Authority. In many cases, the Office of first filing and thus the national Office which conducts search and/or classification prior to the international search is likely to be the same as the receiving Office. In a few cases however, the Office which produced the search and/or classification results might be different from the receiving Office; yet those earlier search and/or classification results would be of benefit for the International Searching Authority. If applicable under the national law, i.e. if it is at all possible for the receiving Office to further transmit such search and classification results to another Office, such results could be transmitted to the International Searching Authority.

## PROPOSAL

5. It is proposed to introduce a new Rule 23*bis*, as set out in the Annex to this document, to establish a system under which the receiving Office is required to submit to the competent International Searching Authority the search results and/or classification results of the family application whenever these are available at the time of transmitting the search copy to the International Searching Authority, provided that this transmittal is not in conflict with the applicable national law of the receiving Office (in particular confidentiality provisions).

6. In view of the discrepancy between national laws on confidentiality of information relating to applications before publication, it is proposed to provide flexibility regarding the precise nature of the information that is to be included in the transmitted search results. However, for the proposed system to serve its purpose, the list of prior art documents found, either with or without codes assigned according to WIPO Standard ST.14, should, if available to the receiving Office, always be transmitted to the competent International Searching Authority.

7. Those shared search and/or classification results would contribute to reducing workload at the International Searching Authorities by further improving consistency between the international search report and examination results at the national phase and potentially the quality of international search reports. Also, by making the search process more efficient, this new feature would support efforts from International Searching Authorities to better meet PCT time limits under Rule 42 PCT and the general goal of ensuring A1 publications. This measure would thus benefit both the Offices and the users of the system.

## FURTHER CONSIDERATIONS

8. Where the national law of the receiving Office allows this information to be made available to the International Searching Authority before publication only in cases where the applicant consents and this consent is given, this would then be considered not to be excluded by national law and so the receiving Office would be bound by the requirements of Rule 23*bis*.1(a) and (b). In the absence of consent required by the receiving Office, Rule 23*bis*.1(a) and (b) would not be binding on the receiving Office and no transmittal would occur. Consent would be implicit in cases where the applicant makes a request under Rule 4.12. The Receiving Office Guidelines could be adapted to clarify this. Furthermore, the Request form could be adapted in order to allow the applicant to give such consent where required (in section VII).

9. Earlier search results and classification results are only of use to the International Searching Authority if they are made available prior to the beginning of the search performed by the Authority. Consequently, if there is no priority claim in the application or if an incorrect priority claim cannot be identified and corrected *ex officio* by the receiving Office in accordance with Receiving Office Guidelines paragraph 168, then the obligation to provide the search results and/or classification results in respect of the priority claim affected should lapse from the date when the search copy is transmitted to the competent International Searching Authority according to Rule 23.1, because the priority application is either unknown or cannot be

identified and as such, the search results and classification results are not available to the receiving Office as required by Rule 23*bis*.1(a) and (b). This situation should be clarified in the receiving Office Guidelines.

10. Earlier search results and classification results are of use to the International Searching Authority even where the priority claim in question is withdrawn under Rule 90*bis*.3. Furthermore, since the withdrawal of the priority may be filed before the International Bureau, the simplest and most effective procedure is to require the receiving Office to transmit the search results and classification results under proposed Rule 23*bis* also in respect of a withdrawn priority claim. This situation should be clarified in the Receiving Office Guidelines.

*11. The Working Group is invited to consider the proposal set out in the Annex to this document.*

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS

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## **Rule 23bis**

### **Transmittal of Earlier Search and Classification Results**

#### **23bis.1 Procedure**

(a) Subject to paragraph (c), where not excluded under its national law and where available at the time of transmittal of the search copy under Rule 23.1(a) or (b), the receiving Office shall transmit to the competent International Searching Authority, together with the search copy, the search results and/or classification results already prepared by that Office on one or more earlier applications on which a priority claim for the international application is based.

(b) Subject to paragraph (c), where not excluded under its national law, paragraph (a) shall apply to the receiving Office with respect to search results and/or classification results which have not been prepared by the receiving Office but which are at the disposal of that Office.

(c) Paragraphs (a) and (b) shall not apply where the office acting as the International Searching Authority prepared the search results and/or classification results for the application the priority of which is claimed.

#### **23bis.2 Contents of Transmitted Search Results**

The receiving Office may decide what information further to the list of prior art documents found through the earlier search should be provided in the search results transmitted under Rule 23bis.1(a).

[End of Annex and of document]