

Supplementary PCT searches

Submission on behalf of epi: the Institute of Professional Representatives before the European Patent Office

Dear Sirs,

In view of some recent developments, we believe it to be appropriate to look again at the reasons why this supplementary PCT search proposal is made.

It is a matter of fact that several designated offices believe it to be necessary to carry out a prior art search in the national phase on top of the PCT search in the international phase. This national phase prior art search is done at a stage at which all national phase entry costs have already been made.

So, if at that phase, it appears that the application cannot be granted, all worldwide national phase entry costs have been wasted, and all designated offices have been confronted with additional national phase workload.

Also, if as a result of the national phase prior art search it appears that limitations should be introduced that were not yet necessitated by the PCT search, only one national phase application benefits from this national phase prior art search.

The idea behind the proposal to introduce supplementary PCT searches is that if a search that would otherwise be carried out in the national phase, is now carried out in the international phase, this search would benefit all designated offices and the applicant alike:

- If it appears as a result of the supplementary PCT search that the application is not patentable in a form that is commercially interesting, the national phase will not be entered: the applicant saves a lot of money, and all designated offices benefit from a reduced workload.
- If it appears as a result of the supplementary PCT search that the application should be limited in a manner not yet necessitated by the primary PCT search, the applicant benefits because he gets a stronger patent, all designated offices benefit from the work carried out by the supplementary ISA, and the public worldwide benefits because they are not faced with unduly broad patents.

We would like to stress that a supplementary search does not constitute additional work for the supplementary ISA; as a supplementary PCT search will only be requested if the primary PCT search indicates that it makes sense to proceed with the application, a supplementary PCT search is just the same work done at an earlier stage: the search that would otherwise be done in the national phase is now done in the international phase. As a result, we believe it to be logical that in the national phase, the supplementary ISA now being a designated office does not charge again for the search it already carried out in the international phase.

From the above discussion it is clear that we believe that time-sequential searches make more sense than parallel searches, as with parallel searches the supplementary PCT search is done without being able to benefit from the filter that is constituted by the primary PCT search. Especially for the larger ISAs there is a high likelihood that they will be designated offices if the primary PCT search is positive.

From the above discussion it is also clear that we strongly believe that a PCT search + written opinion should be at least of the same quality and scope as a national search + written opinion, because otherwise costs are made and work is done in a plurality of national phase applications that would more efficiently have been made and done once in the international phase.

We understand that a recent initiative in the field of international cooperation (the “Patent Prosecution Highway”) explicitly excludes application to PCT applications precisely because the participating offices believe that they cannot rely on a PCT search + written opinion to the very same extent as they can rely on a national search + written opinion. This clearly shows that shortcuts in the international phase are counterproductive, as they result in a diminished reliance on the work carried out in the international phase, and thus in more work in a plurality of national phase applications. That being said, we cannot support the PPH initiative precisely because it discriminates against PCT applications: we strongly believe the Patent Cooperation Treaty to be the number one tool for international cooperation in patent matters, and we therefore cannot support initiatives that diminish the benefits or relevance of the PCT.

In view of the above, we invite all offices to investigate with a positive attitude how the PCT system can be improved in such a manner, that work done in a single international phase results in a reduction of work in a plurality of national phase applications.