



Statement of the Union of European Practitioners in Intellectual Property (“UNION”) concerning the proposed introduction of a Supplementary International Search system (PCT/R/WG/9/8).

UNION, an organization of European practitioners in all fields of Intellectual Property including users of the PCT system both in the free profession and in the industry, has been closely following the PCT reform discussions, and was also represented by a delegate at the 9th session of the Working Group on the Reform of the PCT.

PCT/R/WG/9 Paper No. 8 contains a preliminary draft of what would be appropriate amendments of the Regulations for the introduction of a supplementary international search system, to be annexed to the factual report to be submitted to the PCT Union Assembly. However, at the 9th session of the Working Group no consensus was found as to recommending the proposal for adoption.

UNION supports the draft amended Regulations for the introduction of a Supplementary International Search system.

UNION cannot agree on the opposed arguments raised by the Japanese Delegation in the frame of the Working Group.

As practitioners, the members of UNION are confronted every day with the fact that searches are different in quality and content depending on the searching Authority. The main, but not only, reason for this difference is the language in which the search is carried out: it is evident that an examiner who has neither e.g. Japanese, Korean or Chinese language skills nor adequate search tools in those languages will never be able to search, respectively, Japanese, Korean or Chinese prior art in a reliable manner. For the time being, and perhaps for many years to come, automatic translation tools are not adequate to allow a full comprehension of a disclosure, let alone to base a reliable search thereon. As a consequence, a search on the very same invention by different searching Authorities (say, e.g., the EPO and the JPO) usually results in completely different search reports.

When PCT applicants file national or regional phases in countries/regions other than that of the ISA, these differences in quality and content affect applicants negatively,

because they may end up with completely different search results in the national/regional phase compared to the international search results produced by the ISA. The practical economic impact of this situation is evident: considering that new prior art can be found only after the applicant has filed the national/regional phases, which is the most expensive step in prosecution, and the applicant may be put in the awkward position of having to abandon the application after considerable expenses have already been made. This is detrimental to all applicants, but in particular SMEs that cannot afford to waste funds in non-valuable IP rights.

This situation is contrary to the gist and purpose of the whole PCT system, which should allow an applicant to decide whether to file national/regional phase applications based on reliable grounds that the PCT system should be able to provide during the international phase.

The Japanese Delegation correctly called for better and more complete ISRs. They proposed an improvement of the work of the ISAs. UNION supports this call; however, UNION strongly believes that a "general improvement" of ISRs is a very difficult and eventually "academic" task. What applicants however need is a practical and quick improvement of the present, non-optimal situation.

UNION believes that the introduction of a mechanism for Supplementary International Searches on a voluntary basis would be a practical and quick solution to the current problems. For applicants that have a global approach to IP, it would be much more desirable to request a second or third International Search in the International Phase than to file national/regional phase applications based on incomplete ISRs and learn about the real prior art problems of their application only at a late stage of national/regional phase.

It is to be noted – as it was already pointed out during the discussions – that a supplementary Search system would not increase the workload of national and regional Offices. More probably, the opposite will be true: no applicant will generally request a Supplementary Search in a country where he has no intention to file the national phase: therefore, the only effect, as far as the Supplementary Searching Authority is concerned, is that the search in that country is brought forward by some months. For all the others national/regional Offices where the international application could be eventually prosecuted, more complete search results will be available and, if the supplementary search results are discouraging, no search work at all will be required.

For these reasons,

UNION

- 1) believes that the introduction of a Supplementary Search system as proposed, which would be available to applicants on a voluntary basis, would bring about a quick and practical improvement to the PCT system, with considerable advantages to applicants (particularly SMEs) and no disadvantage to national and regional Offices;
- 2) requests that this proposal is not stopped because of an extremely limited number of national delegations and representatives of users that are opposed, a vast consensus being present among the remaining delegations and representatives of users;
- 3) invites the PCT Union Members to take an active role so that the PCT Union Assembly considers the proposal;
- 4) hopes and counsels that the PCT Union Assembly adopts the proposed Supplementary International Search system;
- 5) hopes and requests that the European Patent Office, the USPTO and the Japanese Patent Office at least participate as ISAs in such a Supplementary International Search system;
- 6) emphasizes that the adoption of this proposal should not be considered as an alternative to a general improvement of the quality of the work of ISAs and other measures aimed at reducing duplication of work.

Submitted by Philippe OVERATH, Secretary General of UNION

On behalf of the UNION Bureau

A handwritten signature in blue ink, appearing to read 'Overath', with a large, stylized flourish underneath.

Date 08 June 2007