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**SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM:
PROPOSED MODIFICATION OF TIME LIMITS FIXED IN
THE PATENT COOPERATION TREATY (PCT) AND
PROPOSED AMENDMENTS OF THE PCT REGULATIONS**

Document prepared by the International Bureau

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INTRODUCTION

1. PCT applicants have an essential interest in knowing, with a high degree of certainty, before entering the national phase and incurring substantial expenses for translations, official and professional fees, whether there is any prior art which may prevent them from obtaining patents for the invention claimed in their international applications. Making the search results attained during the international phase of the PCT as reliable as possible for the purposes of the national phase is therefore highly desirable if the PCT is to achieve its aim of simplifying and rendering more economical the obtaining of patent protection in several countries.

2. After consultations with users of the PCT system, it appears that the international search report established by one International Searching Authority under the present system is often not regarded by the national Offices as sufficient and conclusive in the national phase (including the regional phase before regional Offices). The limited confidence in international search reports by some Offices is manifested by the fact that they frequently do not rely on such reports, or rely on them only to a limited extent, in the national phase. One reason may be that each International Searching Authority cites primarily its own documents, generally citing foreign documents only to the extent that they are in the language or languages with which its examiners are most familiar. Another reason may be that the various International Searching Authorities do not use the same methods of searching. Although all International Searching Authorities possess the PCT minimum documentation, such documentation is arranged according to different classifications and takes into consideration the working language(s) of the examiners.

3. For the above-mentioned reasons, PCT users have expressed their interest in having the option to obtain a second search report to be established by an International Searching Authority different from the International Searching Authority which carries out the mandatory international search,¹ while keeping the possibility of using the international preliminary examination procedure under Chapter II of the PCT.

4. Other groups of PCT users, who generally use the PCT as a strategic tool for filing foreign applications, mainly for gaining time before entering the national phase, have expressed their interest in having available a less expensive means to achieve this objective

¹ It is interesting to note that, even today, it is *de facto* possible, under certain circumstances, to obtain search results from two International Searching Authorities, albeit that one of the two searches is made by an Office not in its capacity as International Searching Authority but in its capacity as national (or regional) Office. This flows from the possibility for applicants from certain countries, whose national (or regional) Office acts as International Searching Authority under the PCT, first to file a national (or regional) application with their home Office and then to file a corresponding international application (claiming priority of the national or regional application), specifying an Office other than the home Office as International Searching Authority. For example, an applicant who first files a national application with the United States Patent and Trademark Office (USPTO) can then file with that Office as PCT receiving Office (or with the International Bureau as PCT receiving Office) an international application (claiming priority from that earlier application) in which the European Patent Office is specified as International Searching Authority. 41.5% of all international applications filed with the USPTO as receiving Office in 1995 took advantage of the possibility just described. The fact that such a sizable proportion of applicants presently takes advantage of this possibility suggests that a supplementary international search system available to all PCT applicants would significantly increase the attractiveness of the PCT.

than the present international preliminary examination procedure. These groups are mainly interested in gaining time for their decision whether, and if so where, to enter the national phase by extending the international phase until 30 months from the priority date. Such applicants may be less interested in international preliminary examination, which is cost-intensive and requires active participation by the applicant, than in obtaining more complete information about the relevant prior art, which requires less effort and expense.

5. It is therefore proposed to supplement the PCT procedure by providing the possibility for applicants to request a supplementary international search report from an International Searching Authority different from the one that carries out the usual international search that is required by Article 15 to be carried out on every international application.² Such a request for a supplementary international search, which would have to be made within 19 months from the priority date, would have the effect that the time limit for entering the national phase would be postponed to 30 months from the priority date, even if a demand for international preliminary examination under Chapter II has not been filed. The possibility of requesting a supplementary international search would exist independently of the possibility of using the international preliminary examination system under Chapter II; in other words, a supplementary international search could be requested instead of or in addition to international preliminary examination. The procedure for carrying out a supplementary international search and for preparing the supplementary international search report would correspond, in general, to the present provisions relating to the mandatory international search, which would continue to be carried out as at present.

6. The supplementary international search system can be introduced without a revision of the PCT by a diplomatic conference. The only required change to the Treaty itself concerns the time limit for entering the national phase, which is provided for in Article 22.³ That time limit may, however, be modified, pursuant to Article 47, by a decision of the PCT Assembly. Other procedural details for the supplementary international search system can be provided for by amending the Regulations. Such amendments may likewise, pursuant to Article 58(2), be made by the Assembly.

7. The text of the modification of Article 22 and of the amendments to the Regulations which are proposed by the International Bureau, together with explanations, are set out in this document.

OUTLINE OF THE PROPOSED SYSTEM FOR SUPPLEMENTARY INTERNATIONAL SEARCH

8. The main features of the proposed new supplementary international search system and its advantages are summarized in the following paragraphs.

² In order to distinguish the international search required to be carried out under Article 15 from the supplementary international search, which is optional, the former is hereinafter referred to as “mandatory.”

³ References in this document to “Articles” and “Rules” are, respectively, to those of the Patent Cooperation Treaty (PCT) and of the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be.

9. *Requesting a supplementary international search.* All PCT applicants would have access to the supplementary international search system. A request for a supplementary international search could either be made in the request part of the international application itself, which is filed with the receiving Office, or be submitted separately from the international application to the International Bureau. In many cases, the applicant would, as under the international preliminary examination procedure under Chapter II, wish to receive the mandatory international search report before deciding whether it would be worthwhile requesting a supplementary international search and/or filing a demand for international preliminary examination. Provided that a request for a supplementary international search and/or a demand for international preliminary examination was filed within 19 months from the priority date, entry into the national phase would be postponed until 30 months from the priority date. However, at the option of the applicant, a request for supplementary international search could be made, at the time of filing the international application, in the request part of the international application itself (which is, of course, filed with the receiving Office); that is, without waiting for the receipt of the mandatory international search report.

10. *Copy and translation for supplementary international search.* The International Bureau would transmit to the International Searching Authority chosen by the applicant for making a supplementary international search a copy of the international application, together with a copy of any amendment to the claims the applicant may have filed under Article 19 before the transmittal. The possibility of amending the claims under Article 19 upon receipt of the international search report and then requesting a supplementary international search which would be carried out on the basis of the amended claims would be of great interest for applicants in certain cases.

11. For the case where the international application is not in a language in which the International Searching Authority chosen by the applicant for making a supplementary international search is prepared to carry out searches, it is proposed that the applicant would have to furnish a translation of the international application, including any amendments made under Article 19, into a language accepted by the International Searching Authority concerned. Failure to furnish that translation within the applicable time limit would result in an invitation to furnish the required translation. If the applicant did not comply with that invitation within one month, the request for a supplementary international search would be considered not to have been made.

12. *Fees for supplementary international search.* A fee for the benefit of the International Searching Authority ("supplementary search fee") and a fee for the benefit of the International Bureau ("processing fee") would have to be paid by the applicant to the International Bureau. Failure to pay within the applicable time limit would result in an invitation to pay any missing amount and, eventually, if the applicant did not comply with that invitation within one month, in the request for a supplementary international search being considered not to have been made. The supplementary search fee would cover the carrying out of the supplementary international search, the establishment of the supplementary international search report and its transmittal to the applicant and to the International Bureau. The processing fee would cover administrative handling by the International Bureau, in particular for processing the request, transmittal of copies and translations for supplementary international search, collection of fees, sending of invitations, publication of the supplementary international search report and its communication to the designated and elected Offices.

13. *Defects in the request for a supplementary international search.* Any defects in the request for a supplementary international search, such as (in the case of a request submitted separately from the international application itself) failure to identify the international application to which it relates or failure to indicate the International Searching Authority which the applicant wishes to carry out supplementary international search, would be correctable.
14. *Notification of the request for a supplementary international search.* Each designated Office would be notified by the International Bureau of the receipt of the request for a supplementary international search, normally together with the communication of a copy of the international application, and a corresponding notice would be published in the PCT Gazette promptly after the request was submitted, but not before the international publication of the international application.
15. *Procedure for carrying out the supplementary international search and for preparing the supplementary international search report.* The procedure for carrying out the supplementary international search and for preparing the supplementary international search report would generally be governed by the provisions relating to mandatory international search (including, for example, provisions relating to relevant prior art, subject matter not required to be searched, lack of unity of invention, and form and content of the search report). The few provisions relating to mandatory international search which are inappropriate to the supplementary international search would be excluded, such as provisions relating to international-type search, missing or defective titles and abstracts, the competent International Searching Authority, reviewing compliance with formalities requirements, the time limit for establishing the mandatory international search report and the rectification of obvious errors.
16. *Time limits under the supplementary international search system.* The proposed time limit for requesting a supplementary international search would be such as to permit the applicant, if he so wished, first to receive and evaluate the mandatory international search report and to decide then whether to request a supplementary international search (and to pay the necessary fees and furnish any required translation), or to file a demand for international preliminary examination, or to do both. To enable such evaluation, a time limit allowing, in general, at least one month after the issuance of the mandatory international search report would be sufficient. In the interests of certainty and in order to avoid confusion (noting that the making of a request for a supplementary international search would postpone the entry into the national phase in the same way as the filing of a demand for international preliminary examination), it is proposed to require that a request for a supplementary international search be made before the expiration of 19 months from the priority date. Requests for a supplementary international search received after that date would be considered not to have been made. (The applicant would also, as explained above, have the option of making the request for a supplementary international search in the request part of the international application itself.)
17. It is proposed that the International Searching Authority be encouraged to establish the supplementary international search report as soon as possible. However, the time limit by which an International Searching Authority would be required, at the latest, to prepare the supplementary international search report is proposed to be fixed at 28 months from the priority date. That would enable the applicant to take advantage of the results of the supplementary international search when deciding how to proceed further with the international application, similarly to the situation where a demand for international preliminary examination has been filed.

18. *Communication and publication of the supplementary international search report.* The applicant and the International Bureau would each receive a copy of the supplementary international search report. The International Bureau would then communicate that report to each designated Office. The international application would be published by the International Bureau, as at present, 18 months from the priority date, together with the mandatory international search report and, in those (probably rare) cases where the supplementary international search report was already available at that time, together with that report. In all other cases, the supplementary international search report would be published after the publication of the international application, as soon as it became available.

19. *Receiving Office functions.* Receiving Offices would not have to take on additional functions. The International Bureau would be responsible for the procedural aspects of administering the supplementary international search system, irrespective of where and in which way the request for a supplementary international search was submitted. In the majority of cases, it is expected that the applicant would submit the request for a supplementary international search direct to the International Bureau, and the receiving Office would not be involved in the procedure at all. Where the request for a supplementary international search is made in the request part of the international application filed with the receiving Office, no additional work would have to be carried out by that Office. It would simply proceed as it does under the present arrangements and transmit the record copy, including the request for a supplementary international search contained therein, to the International Bureau.

20. *Participation in supplementary international search system optional for International Searching Authorities.* It would be highly desirable that all International Searching Authorities accept to perform supplementary international searches under the supplementary international search system. In contrast to the present system for mandatory international search, under which the receiving Office specifies (a) competent International Searching Authority(ies) in accordance with the applicable agreements under which the Authorities act,⁴

⁴ Under the present system for mandatory international search, the competence of an International Searching Authority to search an international application depends: (a) on whether the Authority, under its agreement with the International Bureau, is prepared to act for international applications filed with the receiving Office of or acting for the State of which the applicant is a national or resident, and on the language in which the international application is filed; and (b) on its specification as a competent International Searching Authority by the receiving Office which received the international application concerned. There are at present two International Searching Authorities (the European Patent Office and the Russian Patent Office) which are ready and able to act as International Searching Authorities for international applications filed by nationals and residents of any Contracting State, and which could thus be specified as a competent International Searching Authority by any receiving Office, subject to language requirements. Other International Searching Authorities are prepared to act only for international applications filed by nationals and residents of certain Contracting States, such as developing countries or countries listed in the agreement with the International Bureau. Note that the capacity of the Austrian Patent Office, the Spanish Patent and Trademark Office and the Swedish Patent Office to act as International Searching Authorities is subject to restrictions deriving from the Protocol on Centralisation under the European Patent Convention.

it is proposed that applicants should have the option of obtaining a supplementary international search from any of the existing International Searching Authorities, irrespective of whether they are competent to carry out the mandatory international search in respect of the international application concerned. *However, participation in the supplementary search system would not be obligatory for any International Searching Authority.* Any International Searching Authority would have the option not to participate in the supplementary international search system as a whole or to participate only in part, that is, to act only for applicants from Contracting States specified by the Authority. The proposed new arrangement would not require any amendment of the present agreements between the International Searching Authorities and the International Bureau in relation to their carrying out the mandatory international search, since competence for carrying out supplementary international search would depend directly on the Regulations rather than on the provisions of the agreements. The work of an International Searching Authority involved in establishing a supplementary international search report would be less than for the mandatory international search report, since the international application would normally already have been classified and no final texts of the title and the abstract would have to be established. Moreover, the International Searching Authority carrying out the supplementary international search would receive from the International Bureau, where already available, a copy of the mandatory international search report. In addition, the proposed time limit available for the International Searching Authority for establishing the supplementary international search report (28 months from the priority date) would be such as to allow the International Searching Authorities to establish the supplementary international search report without undue time constraints.

ADVANTAGES OF THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

21. The supplementary international search system, by providing the applicant with the opportunity to obtain a second report containing the results of a search undertaken by a second International Searching Authority, would be of great value to applicants in deciding whether it is worthwhile to proceed with the international application into the national phase. With a second search report at hand, the applicant would be in a better position to assess the likely outcome of the application before the various national and regional designated/elected Offices than if he had only one—the mandatory—international search report. The citations of prior art contained in the two search reports established by different International Searching Authorities, would, when considered together, be more comprehensive than those contained in the mandatory international search report. The two reports would supplement and complement each other, particularly in view of the differences in practice among the individual International Searching Authorities and in the languages used by them. Greater reliance would be placed on the more comprehensive search results so obtained during the international phase of the PCT procedure, by both the applicant and the designated Offices. The chance that the applicant would meet with unexpected citations freshly raised during the procedure before the designated Offices would be substantially reduced. In addition to having a better basis for making decisions about entering the national phase, the applicant would be likely to encounter fewer unexpected objections during any examination in the national phase.

22. Corresponding advantages would also result for the designated Offices, in cases where a supplementary international search was available in addition to the mandatory international search report, when making a decision whether to grant a patent. The fuller information available in the two search reports, taken together, would be more comprehensive and reliable, if not practically conclusive, for both applicants and designated Offices.

23. Moreover, the supplementary international search system would provide applicants mainly interested in delaying the start of national processing of applications with an alternative tool for gaining time before entering the national phase. The time to be gained would be the same as under the international preliminary examination procedure of Chapter II. In other words, a request for a supplementary international search would have the same effect as a demand for international preliminary examination in the sense that entry into the national phase would be postponed until 30 months from the priority date. It would, however, not be as costly as the Chapter II procedure and would not require the active participation of the applicant in making responses to written opinions issued by the examiner. It is important to note that applicants asking for supplementary international search would still have the possibility of using the international preliminary examination procedure under Chapter II.

CHANGES NEEDED TO THE PCT AND REGULATIONS

24. The time limit under Article 22 can, pursuant to Article 47(2), be modified by a decision of the Contracting States through a unanimous decision of the PCT Assembly.

25. Other procedural details of the supplementary international search system can be provided for by way of amendment of the Regulations, including the addition of a number of new Rules, which can be done by the Assembly with a three-fourths majority vote (see Article 58(2)(b)).

26. The text of the proposed modification of Article 22 and of the proposed amendments of the Regulations appears on the odd-numbered pages of the Annex to the present document, and the corresponding explanations appear on the opposite even-numbered pages. In the text itself, what is new as compared to the present text is indicated by underlining and deleted text is struck through.

27. The Committee is invited to consider, and express its advice on, the proposed modifications of Article 22 and the proposed amendments of the Regulations contained in the Annex to the present document.

[Annex follows]

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ANNEX

PROPOSED MODIFICATION OF TIME LIMITS FIXED IN PCT ARTICLE 22 AND
PROPOSED AMENDMENTS OF THE REGULATIONS UNDER THE PCT
TOGETHER WITH EXPLANATIONS

EXPLANATION OF THE PROPOSED MODIFICATION
OF TIME LIMITS FIXED IN PCT ARTICLE 22

Ad Article 22(1) and (2)

1. Article 22 presently provides that the acts necessary to enter the national phase (under Chapter I) of processing before designated Offices must be performed not later than at the expiration of 20 months from the priority date of the international application concerned. Article 39(1)(a) provides for the acts necessary to enter the national phase (under Chapter II) to be delayed until the expiration of 30 months from the priority date in relation to any designated State which has been elected for the purposes of international preliminary examination prior to the expiration of the 19th month from the priority date.

2. It is proposed to modify the time limit fixed in Article 22(1), first sentence, so that the time limit for performing the acts necessary to enter the national phase of processing before designated Offices (under Chapter I) will, similarly to that in Article 39(1)(a), be 30 months from the priority date if the applicant has, prior to the expiration of the 19th month from the priority date, made a request for a supplementary international search as provided in the Regulations. Consequential amendments are made to the time limits fixed by Article 22(1), second sentence, and Article 22(2).

PROPOSED MODIFICATION OF TIME LIMITS FIXED IN PCT ARTICLE 22

Article 22

Copy, Translation, and Fee, to Designated Offices

(1) The applicant shall furnish a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each designated Office not later than at the expiration of 20 months from the priority date or, if the applicant has, prior to the expiration of the 19th month from the priority date, made a request for a supplementary international search as provided in the Regulations, not later than at the expiration of 30 months from the priority date. Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national application, the applicant shall, unless they were contained in the request, furnish the said indications to the national Office of or acting for the State not later than at the expiration of ~~20 months from the priority date~~ the time limit applicable under the preceding sentence.

(2) Where the International Searching Authority makes a declaration, under Article 17(2)(a), that no international search report will be established, the time limit for performing the acts referred to in paragraph (1) of this Article shall be the ~~same as that provided for in~~ time limit applicable under paragraph (1).

(3) [No change]

EXPLANATION OF THE PROPOSED AMENDMENTS
OF THE REGULATIONS UNDER THE PCT

Ad Rule 4.1(c)(iii)

1. Proposed new Rule 4.1(c)(iii) provides that the request part of the international application may contain a request that the international application be the subject of a supplementary international search. The other Rules concerning supplementary international search (including the request for such a search) are contained in proposed new Part G of the Regulations which appears on the following pages.

PROPOSED AMENDMENTS OF THE REGULATIONS UNDER THE PCT

Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) and (b) [No change]

(c) The request may contain:

(i) [No change]

(ii) a request to the receiving Office to transmit the priority document to the International Bureau where the application whose priority is claimed was filed with the national Office or intergovernmental authority which is the receiving Office,

(iii) a request that the international application be the subject of a supplementary international search.

(d) [No change]

4.2 to 4.17 [No change]

Ad Rule 97.1

1. Proposed Rule 97.1 makes general provisions for the procedures relating to supplementary search. Rule 97.1(a) makes it clear that a supplementary international search may be requested even when a demand for international preliminary examination is made. The time limit for performing the acts necessary to enter the national phase of processing will be 30 months from the priority date where an applicant makes either a request for a supplementary international search or a demand for international preliminary examination or both such a request and a demand, before the expiration of the 19th month from the priority date. A request for a supplementary international search filed after that time limit will be considered not to have been made, with the consequence that the 20-month time limit for entering the national phase will apply unless a demand for international preliminary examination was made before the expiration of the 19th month from the priority date.

2. Rule 97.1(b) provides generally that the procedures relating to supplementary international search shall be the same as those relating to the mandatory international search. Those procedures include, for example, the carrying out of the search and the establishment, communication and publication of the search report. Procedures relating to the mandatory international search are regulated in the Treaty, the Regulations and the agreements between the various International Searching Authorities and the International Bureau.

PART G [New]

Rules Concerning Supplementary International Search

Rule 97

General Provisions

97.1 General Provisions

(a) The applicant may, prior to the expiration of the 19th month from the priority date, request that his international application be the subject of a supplementary international search referred to in Article 22. Such a request may be made irrespective of whether the applicant makes a demand for international preliminary examination under Article 31(1). Where such a request is received after the expiration of the 19th month from the priority date, it shall be considered not to have been made, and the International Bureau shall notify the applicant accordingly.

(b) The procedures relating to supplementary international search, including the carrying out of the supplementary international search and the establishment, communication and publication of the supplementary international search report, shall, unless otherwise provided, be governed *mutatis mutandis* by the provisions relating to international search contained in the Treaty, these Regulations and the applicable agreement referred to in Article 16(3)(b).

3. Rule 97.1(c) excludes the operation of certain provisions relating to the mandatory international search which are inappropriate to the supplementary international search, such as the provisions relating to the mandatory nature of the search (Article 15(1)), international-type searches (Article 15(5)), the time limit for amending the claims before the International Bureau (Article 19 and Rule 46.1), reviewing compliance with formalities requirements (Rule 29.3), missing or defective titles or abstracts (Rules 37 and 38), the approval of the title and abstract (Rule 44.2), and the rectification of obvious errors (Rule 91.1). In addition, it also excludes certain provisions relating to the mandatory international search which would be inapplicable in view of the express provisions relating to supplementary international search proposed in this document; the provisions excluded include those relating to the competent International Searching Authority (Rule 35) and the choice of that Authority (Rules 4.1(b)(vi) and 4.14^{bis}), the translation of the international application required for mandatory international search (Rule 12), the search fee payable in respect of the mandatory international search (Rule 16.1), the preparation and transmittal of the search copy to the International Searching Authority (Rules 21.1 and 23.1), and the time limit for establishing, and the language of, the mandatory international search report (Rules 42 and 43.4).

4. Rule 97.1(d) provides that supplementary international searches are to be carried out by the International Searching Authorities and makes provision for the competence of such Authorities. Any International Searching Authority (other than that which carries out the mandatory international search) will be competent for carrying out a supplementary international search on an international application, even if it would not be competent for carrying out the mandatory international search in respect of that application, unless the Authority informs the International Bureau that it is not prepared to carry out supplementary international searches or that it is prepared to carry out supplementary international searches only in respect of international applications filed by residents or nationals of specified Contracting States.

[Rule 97.1, continued]

(c) Articles 15(1) and (5), 16(2), 17(2)(a) and (3)(b), and 19, and Rules 4.1(b)(vi), 4.14^{bis}, 8.2, 9.2, 12, 16.1, 21.1, 23.1, 24.2, 29.3, 35, 37, 38, 42, 43.3, 43.4, 44.2, 46.1, 48.3(b), 48.4, and 91.1(e) and (g)(i) shall not apply in relation to supplementary international search.

(d) Any supplementary international search shall be carried out by an International Searching Authority other than the International Searching Authority which carries out the international search in respect of the international application concerned. Each International Searching Authority shall be competent for carrying out a supplementary international search in respect of any international application, even if it is not competent under Article 16(2) for carrying out the international search in respect of that application, unless it has informed the International Bureau that it is not prepared to carry out supplementary international searches or that it is prepared to carry out supplementary international searches only in respect of international applications filed by residents or nationals of specified Contracting States.

Ad Rule 97.2

1. Proposed Rule 97.2 provides that the supplementary international search will be based on the international application as filed together with any amendments under Article 19 which the International Bureau transmits to the International Searching Authority concerned under Rule 102.1(i) or (ii) (that is, if such amendments have already been made or, subject to Rule 99.1(c), if a translation of such amendments is furnished under Rule 99.1).

97.2 Basis of Supplementary International Search

The supplementary international search shall be based on the international application as filed, taking into account, subject to Rule 99.1(c), any amendments under Article 19 which are transmitted to the International Searching Authority under Rule 102.1(i) or (ii).

Ad Rule 98.1

1. Proposed Rule 98.1 gives the applicant two occasions for making a request for a supplementary international search. The first occasion is to make the request in the request part of the international application itself (see also proposed Rule 4.1(c)(iii)); that is, the request for a supplementary international search may be made at the time of filing the international. The second occasion consists in the applicant's submitting a separate request for a supplementary international search; such a "separately submitted request" is to be submitted to the International Bureau (not to the receiving Office or the International Searching Authority concerned).

Ad Rule 98.2

1. Proposed Rule 98.2 establishes the requirements for the contents and language of a request for a supplementary international search. The use of a particular form for separately submitted requests is not required, but it is intended that an optional form for use by applicants will be established. The applicant will have the option of filing a separately submitted request for a supplementary international search in any of the languages of publication referred to in Rule 48.3 (although it might be expected that most applicants would file the request for a supplementary international search in the same language as that of the request part of the international application).

Rule 98

The Request for a Supplementary International Search

98.1 How to Make the Request for a Supplementary International Search

A request for a supplementary international search may be made in the international application as provided for in Rule 4.1(c)(iii) or in a request submitted separately from the international application (“separately submitted request”) to the International Bureau.

98.2 Contents and Language of the Request for a Supplementary International Search

(a) The request for a supplementary international search shall indicate the International Searching Authority, among the International Searching Authorities competent under Rule 97.1(d), which the applicant wishes to carry out the supplementary international search.

(b) A separately submitted request for a supplementary international search shall identify the international application to which it relates.

(c) A separately submitted request for a supplementary international search shall, at the option of the applicant, be in any language of publication referred to in Rule 48.3.

Ad Rule 99.1

1. Proposed Rule 99.1(a) requires the applicant to furnish a translation of an international application where the international application is neither filed nor published in a language accepted by the International Searching Authority which is to carry out the supplementary international search. The time limit for filing a translation is 18 months from the priority date or, in the case of a separately submitted request received later than 17 months from the priority date, one month from the date of receipt of that request. Where the translation is not furnished within the applicable time limit, the International Bureau will invite the applicant to furnish a translation (Rule 99.1(b)). Non-compliance with that invitation will result in the request for a supplementary international search being considered not to have been made (Rule 99.1(c)).

2. The translation should include the translation of any amendments which have been made under Article 19 (Rule 99.1(a)). However, if the translation of any such amendments is not furnished, but the translation of the claims as originally filed is furnished, the supplementary international search will still be undertaken but without taking the amendments under Article 19 into account (Rule 99.1(c), second sentence).

Rule 99

Translation for the Purposes of Supplementary International Search

99.1 Translation of International Application and Amendments under Article 19

(a) Where the international application is neither filed nor published in a language accepted by the International Searching Authority which is to carry out the supplementary international search, the applicant shall furnish to the International Bureau a translation of the international application, including any amendments under Article 19, into a language accepted by that Authority. That translation shall be furnished

(i) within 18 months from the priority date or,

(ii) in the case of a separately submitted request for a supplementary international search received later than 17 months from the priority date, within one month from the date of receipt of that request.

(b) If the translation is not furnished within the applicable time limit under paragraph (a), the International Bureau shall invite the applicant to furnish it within one month from the date of the invitation.

(c) If the applicant does not, within the time limit under paragraph (b), furnish any required translation of the international application, the request for a supplementary international search shall be considered not to have been made and the International Bureau shall notify the applicant accordingly. If the applicant does not, within that time limit, furnish any required translation of amendments under Article 19, but furnishes a translation of the claims as originally filed, the amendments shall not be taken into account for the purposes of the supplementary international search.

Ad Rule 100.1

1. Proposed Rule 100.1 provides for two fees to be paid in respect of a request for a supplementary international search; namely, a “supplementary search fee” (for the benefit of the International Searching Authority) and a “processing fee” (for the benefit of the International Bureau).

Ad Rule 100.2

1. Proposed Rule 100.2 sets time limits, which are the same as those which apply to the filing of a translation (see Rule 99.1(a)), for paying the fees payable for requesting a supplementary international search. The International Bureau will, of course, transfer to the International Searching Authorities concerned moneys paid to it in respect of supplementary search fees, in the same way as receiving Offices transfer to those Authorities moneys paid to those Offices in respect of fees for the mandatory international search.

Rule 100

Fees for Supplementary International Search

100.1 Supplementary Search Fee and Processing Fee

Each request for a supplementary international search shall be subject to the payment of a fee for the benefit of the International Searching Authority (“supplementary search fee”) and a fee for the benefit of the International Bureau (“processing fee”).

100.2 Time and Mode of Payment

The supplementary search fee and the processing fee shall be paid to the International Bureau, in a currency prescribed by it,

(i) within 18 months from the priority date or,

(ii) in the case of a separately submitted request for a supplementary international search received later than 17 months from the priority date, within one month from the date of receipt of that request.

Ad Rule 100.3

1. Proposed Rule 100.3 seems to be self-explanatory.

Ad Rule 100.4

1. By virtue of proposed Rule 100.4, which seems to be self-explanatory, an applicant will not suffer adverse consequences from failure to pay the fees due in respect of a request for a supplementary international search without first being invited to pay any unpaid fees which are overdue.

100.3 Amount

(a) The amount of the supplementary search fee shall be fixed by each International Searching Authority. Equivalent amounts in the currency or currencies accepted by the International Bureau shall be established by the Director General after consultation with each International Searching Authority concerned.

(b) The amount of the processing fee is as set out in the Schedule of Fees. Equivalent amounts in other currencies may be fixed by the Director General.

100.4 Failure to Pay

(a) If the fees referred to in Rule 100.1 are not paid within the time limit under Rule 100.2, the International Bureau shall invite the applicant to pay any missing amount within one month from the date of the invitation.

(b) If the applicant does not, within the time limit under paragraph (a), pay the amount due, the request for a supplementary international search shall be considered not to have been made, and the International Bureau shall notify the applicant accordingly.

Ad Rule 101.1

1. By virtue of proposed Rule 101.1, which seems to be self-explanatory, an applicant will not suffer adverse consequences from failure to comply with formality requirements in relation to a request for a supplementary international search (concerning the contents and language of that request) without first being invited to correct the defects.

Rule 101

Defects in the Request for a Supplementary International Search

101.1 Defects in the Request for a Supplementary International Search

(a) If the request for a supplementary international search does not comply with the requirements of Rule 98.2, the International Bureau shall invite the applicant to correct the defects within one month from the date of the invitation. That time limit may be extended at any time before a notification is sent under paragraph (b).

(b) If the applicant does not correct the defects within the time limit under paragraph (a), the request for a supplementary international search shall be considered not to have been made and the International Bureau shall notify the applicant accordingly.

Ad Rule 102.1

1. Under proposed Rule 102.1, which seems to be self-explanatory, it would be the International Bureau (and not the receiving Office) which would be responsible for preparing and transmitting to the International Searching Authority carrying out a supplementary international search the necessary copy of the international application or the translation thereof.

Rule 102

Transmittal of Copies

102.1 Transmittal of Copies to the International Searching Authority

The International Bureau shall, after it has received the record copy of the international application containing a request for a supplementary international search, or a separately submitted request for a supplementary international search, and any translation required under Rule 99.1, and after the fees referred to in Rule 100.1 have been paid, promptly notify the International Searching Authority concerned and transmit to it

(i) a copy of the international application, including a copy of any amendments which have already been made under Article 19, or,

(ii) where applicable, the translation furnished under Rule 99.1.

Ad Rule 103.1

1. Proposed Rule 103.1 seems to be self-explanatory.

Ad Rule 103.2

1. By virtue of proposed Rule 103.2, which seems to be self-explanatory, designated Offices would be informed of the making of a request for a supplementary international search so as to be in a position to know what is the applicable time limit by which the international application concerned must enter the national phase of processing (see Article 22 as proposed to be modified).

Ad Rule 103.3

1. Proposed Rule 103.3 seems to be self-explanatory.

Rule 103

Notification of the Request for a Supplementary International Search

103.1 Notification to the Applicant

The International Bureau shall indicate the date of receipt on a separately submitted request for a supplementary international search and shall promptly inform the applicant of that date.

103.2 Notification to the Designated Offices

The International Bureau shall notify each designated Office, together with the communication provided for in Article 20, that a request for a supplementary international search was made. Where the request for a supplementary international search is received by the International Bureau after such communication, the notification shall be sent promptly after that receipt.

103.3 Publication in the Gazette

The International Bureau shall publish in the Gazette a notice of the fact that a request for a supplementary international search was made. Such notice shall be published promptly after receipt of that request by the International Bureau but not before the international publication of the international application.

Ad Rule 104.1

1. Proposed Rule 104.1 gives the International Searching Authority carrying out a supplementary international search a choice, as set out in the Rule, as to the language in which the supplementary international search report is to be established.

Ad Rule 104.2

1. Proposed Rule 104.2 requires that the supplementary international search report be established as soon as possible but, in any event, before the expiration of 28 months from the priority date (that is, the same time limit which applies to the establishment of an international preliminary examination report). This time limit is, of course, later than the time limit for establishing the mandatory international search report, but International Searching Authorities are encouraged to establish supplementary international search reports as soon as possible so as to give the applicant the maximum opportunity to benefit from having both reports when making decisions as to how to proceed with the international application.

Ad Rule 104.3

1. Proposed Rule 104.3 makes provision for the supplementary international search report to include reference to the fact that any of the situations referred to in Article 17(2)(a) exist: namely, that the international application relates to a subject matter which the International Searching Authority is not required to search and decides not to search, or that the descriptions, claims or drawings fail to comply with the prescribed requirements to the extent that a meaningful search could not be carried out.

Rule 104

The Supplementary International Search Report

104.1 Language of the Supplementary International Search Report

The supplementary international search report shall, at the option of the International Searching Authority concerned, be in English or in the language in which the international application to which it relates is published or, if a translation was furnished under Rule 99.1, in the language of that translation.

104.2 Time Limit for the Supplementary International Search

The supplementary international search report shall be established as soon as possible but in any event before the expiration of 28 months from the priority date.

104.3 Procedure Where No Supplementary International Search Can Be Carried out

If any of the situations referred to in Article 17(2)(a) is found to exist in connection with the international application as a whole or in connection with certain claims only, the supplementary international search report shall so indicate and explain the reasons therefor.

Ad Rule 105.1

1. Proposed Rule 105.1 provides that, where a request for a supplementary international search is withdrawn, that request will be considered not to have been made, with the result that the time limit for entering the national phase of processing under Article 22 as proposed to be modified would be 20 months from the priority date rather than 30 months (unless a demand for international preliminary examination was filed before the expiration of the 19th month from the priority date). However, withdrawal will have no effect in any designated or elected Office where the processing or examination of the international application has already started under Article 23(2) or 40(2).

Rule 105

Withdrawal of the Request for a Supplementary International Search

105.1 Effect of Withdrawal of the Request for a Supplementary International Search

(a) Where the request for a supplementary international search is withdrawn, the request shall be considered not to have been made.

(b) Withdrawal of the request for a supplementary international search shall have no effect in any designated or elected Office where the processing or examination of the international application has already started under Article 23(2) or 40(2).

Ad Schedule of Fees

1. Proposed new item 5 in the Schedule of Fees fixes the amount of the processing fee (see Rule 100.3(b)) at 233 Swiss francs, that is, the same amount as is fixed for the handling fee payable in respect of making a demand for international preliminary examination.

SCHEDULE OF FEES

Fees	Amounts
1. Basic Fee: (Rule 15.2(a))	
(a) if the international application contains not more than 30 sheets	762 Swiss francs
(b) if the international application contains more than 30 sheets	762 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	
(a) for designations made under Rule 4.9(a)	185 Swiss francs per designation, provided that any designation made under Rule 4.9(a) in ex- cess of 11 shall not require the payment of a designation fee
(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)	185 Swiss francs per designation
3. Confirmation Fee: (Rule 15.5(a))	50% of the sum of the designation fees payable under item 2(b)
4. Handling Fee: (Rule 57.2(a))	233 Swiss francs
5. <u>Processing Fee:</u> (<u>Rule 100.3(b)</u>)	<u>233 Swiss francs</u>

All fees are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.