

WIPO



PCT/MIA/12/2

ORIGINAL: English only

DATE: November 25, 2005

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PATENT COOPERATION TREATY (PCT)**

**Twelfth Session
Geneva, December 12 to 16, 2005**

SUPPLEMENTARY INTERNATIONAL SEARCHES

Document prepared by the International Bureau

SUMMARY

1. Proposals and options are presented for a system of supplementary searches within the PCT, whereby an applicant would have the option to request searches to be performed by International Authorities, other than the International Searching Authority that performs the “main” international search, primarily in order to locate prior art in languages which might not be fully considered by that main Authority. The proposals seek to find the most appropriate balance of service and convenience to the applicant, efficiency of processing for the International Authorities involved, and usefulness to the designated and elected Offices and third parties. Each International Authority would be free to decide whether or not to participate in the proposed system of supplementary searches.
2. The Meeting is invited to discuss the proposals with a view to an improved draft being made available for discussion at the eighth session of the Working Group on Reform of the PCT, and to indicate the extent to which different Authorities might be able to offer such services in the medium term.

BACKGROUND

3. According to Article 15,¹ the objective of the international search is “to discover relevant prior art”. In principle, prior art for the purposes of the PCT is a concept independent of place or language of disclosure: the International Searching Authority “shall endeavor to discover as much of the relevant prior art as its facilities permit” in order that the international search report be of maximum use to the applicant and designated Offices for determining whether the international application meets the requirements of novelty and inventive step according to any particular national law. Ideally, the scope and quality of the international search should be such that no designated or elected Office needs to repeat the search in the national or regional phase. The considerations at that time should be limited to whether the citations are relevant to the particular definitions of novelty and inventive step which apply under the relevant national or regional law.

4. However, it remains the case that no Office in the world is capable of thoroughly searching disclosures written in all languages, even if it has access to them in its search databases. Quite naturally, the majority of citations made by any International Searching Authority are in one of the languages in which the examiners in that Authority have particular proficiency. To a large extent, this reflects the fact that many technical disclosures have equivalents in other languages: either a direct equivalent in the form of another member of a patent family or a translation of a book or paper, or else aspects of a particular technology may simply be described in many different places and the selection of one disclosure over another is a matter of convenience for the examiner, which makes no difference to the quality of the search. Nevertheless, the most relevant prior art for a particular invention will sometimes be in a language in which the International Searching Authority is not specialized and, even if the Authority has access to the document, it is likely to be considered only on the basis of an abstract and drawings, leaving a significant risk that its relevance will not be fully appreciated. Potentially of particularly high risk is the case where technology is being developed from earlier work which was unique to one region and all the relevant prior art may be in a language (and from a source) which would not normally be considered by an International Searching Authority which is competent for searching international applications filed in a different region.

5. Even within the PCT minimum documentation, any International Searching Authority whose official languages do not include Japanese, Korean, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan, the Republic of Korea, the Russian Federation and the former Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. At the start of 2003, of the 24.6 million patent documents which formed part of the minimum documentation, 8.7 million were in Japanese and 1.7 million were in Russian and would be searched by many Authorities only on the basis of an English language abstract, or else not at all.

6. Aside from the question of languages of documents, all of the International Searching Authorities have access to different bodies of information beyond what is set out in the PCT

¹ References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be. References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc.

minimum documentation. Some Authorities may have access to specialized collections in particular fields of technology which are not available elsewhere.

7. There has been considerable support for the principle of allowing optional supplementary searches of international applications during the international phase in order to find additional relevant prior art at an early stage. The Working Group's discussions at its most recent (seventh) session (see document PCT/R/WG/7/13, paragraphs 71 to 92) are outlined in the following paragraphs:

“IMPROVING THE QUALITY OF INTERNATIONAL SEARCHES

“71. Discussions were based on document PCT/R/WG/7/7.

“72. There was widespread support from both delegations and representatives of users for the principle of allowing supplementary international searches to be conducted on international applications, noting that early identification of as much relevant prior art as possible was useful for applicants, designated and elected Offices and third parties alike. There was, however, a significant variation in views concerning the aims and the most appropriate procedures for such searches.

“73. The Working Group strongly supported further development of the proposals relating to supplementary international searches and invited the Secretariat to prepare revised proposals for consideration at its next session, taking into account the comments and suggestions set out in the following paragraphs.

“74. There was interest from users in the possibility of international searches being updated towards the end of the international phase, to take into account relevant prior art which had not been available to the International Searching Authority when the international search report was established. Furthermore, it was noted that some International Preliminary Examining Authorities sometimes conducted such searches as part of the international preliminary examination. However, a number of delegations saw difficulties in introducing such searches as a mandatory part of international preliminary examination, noting that the mandatory nature of the proposal might conflict with Article 33(6), and that it might be difficult to achieve reliable results where the International Searching Authority and the International Preliminary Examining Authority were not the same Office. Furthermore, if this service was offered only as part of international preliminary examination, applicants might be encouraged to file demands for international applications where the full examination was not in fact desired. In the light of these concerns, the Working Group agreed not to continue discussion of this aspect of the proposals.

“*General*

“75. Many delegations emphasized the need for the supplementary international search system to be as simple and flexible as possible, and this to be kept in mind for future revision of the proposals.

“76. A number of delegations expressed concern that the introduction of supplementary international searches should not be permitted to adversely affect the delivery of existing services, including the main international search. The Delegation of Japan, for example, indicated that the Japan Patent Office would not be able to offer a supplementary international search service, at least at the outset, due to workload issues.

Other delegations and representatives of users believed that a well-designed system need not increase the workloads of International Authorities and could, taking efficiencies in the national phase into account, reduce workload burdens overall. Some representatives of users pointed out that many applicants already filed national applications in parallel with international applications in order to gain the benefits of multiple searches, and that efficiencies could be gained for both Offices and applicants by allowing for multiple searches under the PCT. It was also emphasized that it was desirable to pursue measures for improving the quality of the main international search in addition to offering supplementary international searches.

“77. Several delegations noted that it was essential that supplementary international searches be optional for the applicant and emphasized that International Authorities should be able to determine the extent, if any, to which they would offer such searches. One delegation stressed, however, that it would only make sense to pursue the proposal if a substantial number of Authorities would be prepared to participate.

“78. One delegation suggested that it might be useful to allow third parties to request supplementary international searches to be performed on an international application. A representative of users indicated that such a feature would be of interest, but that it would be necessary to ensure that such requests could be filed anonymously.

“Purpose of the Supplementary International Search

“79. A majority of delegations considered that the primary purpose of a supplementary search should be to discover relevant prior art in languages which were a specialization of the Authority carrying out the supplementary international search (“supplementary Authority”) but not of the Authority that carried out the international search proper (“main Authority”), though some delegations felt that this was not appropriately reflected in the language of Rule 45bis.7. It was suggested by one delegation that the specialized languages which the supplementary Authority offered should be defined in the agreements between the Authorities and the International Bureau. The representative of the EPO expressed the view that supplementary Authorities should be free to determine the scope of the supplementary international search themselves.

“80. One delegation indicated that it was necessary to be clear as to why it was desired to offer a supplementary international search system, noting that it was impossible to guarantee that all relevant prior art could be found and that any search was necessarily a compromise between completeness and cost. The delegation considered that the PCT should not offer the type of commercial search which might be conducted by defendants in infringement actions. Such broad searches could not be justified routinely. Rather, the supplementary search should aim to address the needs of applicants wishing not to be surprised by new citations found by designated Offices in the national phase and of Offices which did not presently recognize the international search as being sufficient for national phase processing.

“81. A considerable number of delegations noted the importance of minimizing unnecessary duplication of work, but many felt that the appropriate extent of a supplementary international search beyond what was essential to achieve the primary purpose should be determined by the supplementary Authority itself.

“82. Some delegations and representatives of users considered that the purpose of the supplementary international search should not be defined by the Regulations at all. Instead, each supplementary Authority could indicate the service which it was prepared

to offer and allow applicants to decide whether this service was of interest to them. This would allow Authorities to offer different services, for example, specializing in certain technical areas where their search collections extended significantly beyond the PCT minimum documentation, rather than in particular languages. One delegation suggested that it might also be desirable to consider matters of competence of Authorities more generally so as to give the applicant the maximum choice in determining the extent of the international search appropriate to the international application concerned. One representative of users suggested that the scope of the supplementary international search should be determined by the supplementary Authority according to what further search it would normally perform on the international application if it had received it in its role as a designated Office in the national phase.

“Body to Which Request for Supplementary International Search Is Submitted

“83. The Working Group reaffirmed that requests for supplementary international searches should not be submitted to the receiving Office. A majority of delegations considered that the International Bureau seemed the most appropriate body to receive the request for supplementary international search, though it was noted that there were some advantages in making the request directly to the supplementary Authority, particularly if only a single supplementary international search was sought.

“84. One delegation suggested that, if the requests were not to be submitted only to the supplementary Authority, they should be able to be submitted to either the supplementary Authority or the International Bureau, at the choice of the applicant. A majority of delegations were opposed to such an idea, noting that it would add complexity and confusion to the system.

“Contents of the Supplementary International Search Report

“85. The Working Group agreed that the supplementary international search report should not include a written opinion but should list citations in a manner similar to an international search report, also including comments sufficient to make their relevance clear. One delegation suggested that it should not be necessary to list family members of the cited documents.

“Time of Requesting and Performing the Supplementary International Search

“86. Many delegations considered that supplementary international searches should only be able to be requested and performed after the transmittal of the main international search report, since otherwise there was a risk of duplication, inconsistency and unnecessary work, noting that there might be little value in a supplementary search where the main search showed that an invention was not new.

“87. Other delegations considered that there should be an option for Authorities to offer supplementary international searches concurrently with the main search. While some delegations were concerned that different approaches among Authorities might cause complications to the system and confusion for applicants, other delegations considered that such difficulties would be limited and that a flexible system might allow participation in the system by some Authorities which otherwise would not be in a position to deliver searches within the very short deadlines inherent in a system providing for sequential searches. One representative of users stated that minor complications would be worthwhile if the result was a wider range of participating

Authorities, since new prior art being found in the national phase was a much more significant problem for applicants. It was also pointed out that the availability of services in different ways from different Authorities might offer, as the preferences of users became clear through the choices they expressed, some practical insight into the needs of users.

“88. The Working Group agreed that the Secretariat should, in revising the proposals, consider the issues involved in providing main and supplementary searches sequentially, concurrently or both.

“89. The Working Group agreed that an outer time limit for requesting a supplementary international search was appropriate to avoid prolongation of the international phase, though it was noted that exactly what the limit should be would depend on when the supplementary international search was to be performed and whether it could be requested alone, in conjunction with international preliminary examination, or in either way.

“Claims to Be Searched (Unity, Clarity, Subject Matter, etc.)

“90. The Working Group agreed that consideration of the proposals, as regards claims to be searched, should continue as provided in document PCT/R/WG/7/7, at least in respect of the case where the main and supplementary international searches were performed sequentially. Some representatives of users indicated that it would be desirable to allow supplementary international searches even on claims which had not been the subject of the main international search, provided that the applicant paid the appropriate fees.

“Fees and Documents to Be Provided by the Applicant

“91. One delegation suggested that, assuming that the International Bureau was the body to which fees relating to the supplementary international search were to be paid, it might be more efficient for the International Bureau to refund fees where the supplementary Authority did not conduct a supplementary international search because of a limitation on the subject matter on which it had agreed to conduct such searches.

“Availability and Translations of the Supplementary International Search Report

“92. One delegation suggested that it should be clarified that designated Offices and third parties should be able to obtain status information indicating whether a supplementary international search had been requested for a particular international application.”

TERMINOLOGY

8. In this document, the following abbreviated expressions are used to describe different search services and roles:

main search: the international search conducted on an international application under Article 15;

main Authority: the International Searching Authority which conducts the main search;

supplementary search: a search carried out on an international application by an International Searching Authority other than the one which conducts the main search;

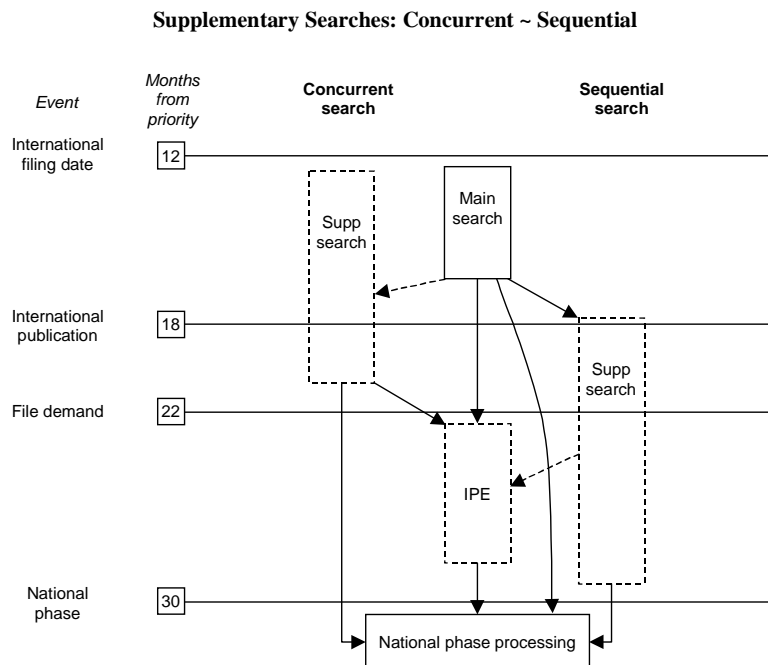
participating Authority: an International Searching Authority which offers the service of providing supplementary searches;

supplementary Authority: a participating Authority which is requested to perform a supplementary search on a particular international application.

CONCURRENT AND SEQUENTIAL SEARCHES

9. At the seventh session of the Working Group, there was no consensus on whether supplementary searches should be offered only after the main international search had been established (“sequential searches”) or whether such searches could, or should, be performed at the same time as the main international search (“concurrent searches”). The Working Group agreed that the Secretariat should, in revising the proposals, consider the issues involved in providing main and supplementary searches sequentially, concurrently or both (see paragraphs 86 to 88 of document PCT/R/WG/7/13, reproduced above). Some of the main conclusions are set out in the following paragraphs.

10. The diagram below shows the typical availability of information with concurrent and sequential searches (the solid arrows show when reports from one stage would usually be available to another stage; the dotted arrows show when reports would sometimes be available to another stage).



Sequential Searches

11. Sequential searches have the potential to reduce duplicative and unnecessary work and to permit a better assessment of inventive step than concurrent searches. If the supplementary search is not begun until the main international search report is available:

(a) the scope of the main search can be determined more reliably, allowing the supplementary search to concentrate on different search material to provide a complementary service rather than a duplicative one—while a supplementary Authority might often be able to make reasonable assumptions concerning languages of specialization of the main Authority (see paragraph 12(c), below), the details of the online databases consulted may be of particular significance (noting that some commercial databases are very expensive to search and Authorities may benefit considerably from avoiding duplication of search in these);

(b) the main Authority's view on unity of invention could be taken as defining the inventions for the purpose of determining the claims to be searched and the need for any additional fees, avoiding delays and costs due to the need for each Authority to examine the question of unity, invite the payment of any additional fees and deal with protests (see paragraphs 36 and 37, below);

(c) the applicant will, after the establishment of the international search report, be better able to assess which inventions were worth requesting supplementary searches for, avoiding the extra work and cost of additional searching of inventions which have either already been shown not to be new, or else have by that time been decided to be of insufficient commercial value; and

(d) the supplementary Authority will be able to assess the relevance of potential citations to the inventive step of the invention in the light of the more complete set of prior art revealed by both the main and supplementary searches, rather than only according to that found in the supplementary search.

12. On the other hand, there are some difficulties with sequential searching, or factors which would reduce its apparent advantages:

(a) if supplementary searches are only commenced after the main search is complete, they will usually be completed later than if they had been begun at an earlier stage; this might often mean that the supplementary search report would not be available for use in any international preliminary examination and occasionally, where the main international search report was established particularly late, could leave a supplementary Authority with little time to establish a supplementary international search report before the end of the international phase;

(b) for some parts of an online search, it may be very little easier and cheaper to exclude documents from the supplementary search which are likely to have been considered by the main Authority (for example because they form part of the PCT minimum documentation) than to include them; and

(c) the international search report at present only indicates languages of documents considered to the extent that this can be inferred from the entries on the form indicating the documentation and databases searched and the citations found (and it may be difficult and potentially misleading to make any detailed statement on language in view of the normal methods of online search)—the supplementary Authority would usually make assumptions about language on the basis of the languages in which the main Authority is known to specialize; such an assumption could be made just as easily before the international search report is established as afterwards.

13. Irrespective of the limitations noted in paragraphs 12(b) and (c), above, sequential searches could certainly reduce unnecessary duplication in a supplementary search system by eliminating some searches entirely where the results of the main international search (or other

events which have occurred in the meantime) mean that the applicant can see that a supplementary search would serve no useful purpose.

14. A possible system is set out in Annex I, wherein supplementary searches are offered sequentially following the main search.

Concurrent Searches

15. The main benefit of concurrent searches is, clearly, the possibility of delivering the supplementary search report more quickly (or allowing the Authority a greater time to establish it within the same final time limit).

16. The main difficulties all stem from the fact that if the main search report has not yet been established, it is impossible for any of the parties to know the scope of the main search or to use the information within it to improve either the quality of the supplementary search or the efficiency of the procedures:

(a) It is difficult for an examiner to make an accurate judgement of the relevance of a piece of prior art to the inventive step of the international application if he is not aware of as broad a range of other relevant prior art as possible; if the supplementary search deliberately excludes (for example) the PCT minimum documentation on the grounds that it should be fully considered by the main Authority, but the results of the main search are not yet available, the supplementary examiner may not recognize the relevance of a document, leading it either to be cited as category A² instead of Y³, or else not to be cited at all.

(b) Similarly, due to a less complete knowledge of the prior art, the assessment of unity of invention *a posteriori* by a supplementary Authority may be limited (though since the Authority's comments on unity would not be expected to be considered by designated and elected Offices, this would only be of any detriment to the Authority itself, as it would result in fewer additional fees than otherwise being requested for search of additional inventions).

(c) There would be no possibility of relying on the views of the main Authority with respect to unity, meaning that delays and administrative costs would need to be incurred in making the assessment, requesting additional fees and considering any protests.

(d) The applicant would need to decide whether to request supplementary searches without knowledge of the content of the international search report, leading to some supplementary searches being made which are of no value to the applicant at all.

17. The issues in paragraphs 16(a) and (b) might result either in concurrent searches being of lower quality than a sequential search, or else in the Authority feeling the need to cover documentation which would also be considered in the main search, leading away from the concept of being a complement to the main search towards being a second complete search. The issues in paragraphs 16(c) and (d) would not affect the quality of the result, but would represent avoidable complications and inefficiencies in the system.

² Category "A": Document defining the general state of the art which is not considered to be of particular relevance. (*WIPO Standard ST.14*)

³ Category "Y": The claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art. (*WIPO Standard ST.14*)

18. In view of these considerations, no proposals are presented wherein supplementary searches are offered only concurrently with the main search.

Both Concurrent and Sequential Searches

19. Applicants may have different priorities in what they seek from a supplementary search system. Sometimes an applicant may want to know as much as possible about the prior art as early as possible (commercial searches are available for this purpose, but do not automatically get recognized by national Offices later to assist processing). At other times, the applicant may wish to consider use of supplementary searches, depending on the results of the main search and any other commercial factors which may become apparent between the international filing date and any deadline which applies for requesting supplementary search.

20. Furthermore, Authorities have different concerns, particularly with regard to workflow. Some Authorities might be capable of delivering supplementary search reports within the international phase even if they were requested later than is currently permitted for demanding international preliminary examination (see paragraph 51 of document PCT/MIA/11/14). However, others consider that an earlier time limit would be necessary, to the extent that they might not be able to participate unless the deadline for requesting supplementary search was earlier than the point at which many international search reports are currently established.

21. One approach to this might be to offer a system where applicants were permitted to request supplementary search over a wide range of times, from the international filing date (rather than the establishment of the main international search report) to a final deadline, such as that which applies for demanding international preliminary examination. If some Authorities were only prepared to offer concurrent searches, it would also be possible to permit individual Authorities to set an earlier deadline for requesting searches from that Authority.

22. The advantages and disadvantages of such a system would depend strongly on the details of the implementation. The main risks are:

(a) overcomplication if many different time limits exist for requesting supplementary search by different Authorities, or if different rules apply depending on whether the supplementary search is conducted before or after the main international search report has been established; and

(b) loss of the advantages of sequential searching if the supplementary Authority does not take sufficiently into account any main international search report which has been established prior to the supplementary search being conducted.

23. A possible system is set out in Annex II, wherein supplementary searches may be requested both concurrently and sequentially with the main search.

PROPOSALS

24. The Annexes contain two alternative sets of draft amendments to the PCT Regulations allowing for a system of supplementary international searches. As noted above, Annex I provides for a system of sequential searches; Annex II provides for either concurrent or sequential searches, at the choice of the applicant, but within limits which might be set by some participating Authorities. The alternatives are presented so that equivalently numbered paragraphs refer to similar subjects in either case.

25. Each alternative includes the following common main features:

- (a) Provision of supplementary searches is optional for Authorities.
- (b) Applicants are free to request supplementary searches from all, some, or none of the Authorities which offer supplementary searches, other than the main Authority for their application.
- (c) The applicant sends a request for supplementary search to the International Bureau.
- (d) A supplementary search fee (for the benefit of the Authority) and supplementary search handling fee (for the benefit of the International Bureau) are paid to the International Bureau, within one month from the date on which the request is submitted (where the request for supplementary search is included in the request under Article 3(2), this is treated as the date on which the International Bureau receives the request from the receiving Office).
- (e) The International Bureau sends a copy of the international application and any other required documents to each Authority which is to conduct a supplementary search. A copy of the main international search report is sent as soon as it is available, provided that (in the case of concurrent searches) the supplementary search report has not already been established by that time.
- (f) Each supplementary Authority issues a supplementary search report. No written opinion is established by the supplementary Authorities, but the indications of relevant passages in the search report should be sufficient to make clear the relevance of the citation, bearing in mind that many citations will be in languages not well understood by the applicant or the Authority likely to act as International Preliminary Examining Authority if a demand is submitted.
- (g) The supplementary search reports are made available electronically to the public as soon as possible after they are received by the International Bureau (provided that the international application has been published) in such a manner that they can be viewed by any person seeking the main international search report (this would not apply to supplementary searches performed during international preliminary examination, which would be reported only as part of the written opinions and international preliminary examination report, the availability of which are governed by Article 38 and Rule 94). Furthermore, each supplementary search report which has been established is automatically communicated to designated and elected Offices whenever the international search report is requested.
- (h) Translations of the supplementary search reports are prepared by the International Bureau in the same cases as for the main international search report.

26. Both alternatives also includes the possibility of supplementary searches being conducted at the same time as international preliminary examination, where the International Preliminary Examining Authority is not the same Office as the one which acted as International Searching Authority (see paragraphs 39 and 40, below).

27. The main differences between the two alternatives, other than whether the supplementary Authority necessarily waits until the main international search report has been established, are as follows:

(a) *Sequential searches only*: The request is made after the main international search report has been established, within the same deadline as applies for demanding international preliminary examination. The applicant is only permitted to request searches of inventions for which a main international search report has been established. The supplementary Authority accepts the opinion of the main Authority regarding unity of invention (see paragraphs 36 and 37, below) and the International Bureau collects the necessary number of additional fees before any supplementary search is begun, so that intervening correspondence with the applicant would delay establishment of the supplementary search report only in very rare cases. The supplementary search report only cites documents included in the main report to the extent that this is necessary for the indication of inventive step issues in relation to newly found citations.

(b) *Concurrent and sequential searches*: The request can be made at any time from the international filing date (as part of the request under Article 3(2)—this is passed to the International Bureau unchecked by the receiving Office, together with any accompanying materials such as translations) until a deadline, which is normally the same as the deadline for demanding international preliminary examination, but individual Authorities may set earlier limits. The supplementary Authority makes its own determination of unity of invention and requests any additional fees which are required as a result and handles any protests. The supplementary search report may duplicate what appears in the main international search report and may cover inventions which were not the subject of the main international search—the same rules apply to supplementary international searches irrespective of whether requested before or after the establishment of the international search report so this may be done deliberately by the applicant if the main Authority makes a declaration referred under Article 17(2)(a) but the applicant believes that the supplementary Authority would search the relevant subject matter.

28. In a system where both concurrent and sequential searches are permitted, it would be possible to allow different Rules to apply depending on whether or not the main international search report had been established prior to making the request for supplementary search. However, this option is not pursued in view of the added complexity which would be involved in the Rules and because it would involve the applicant having to deal with different procedures, most notably with respect to payment of fees, depending on the time that the request for supplementary search was made.

Body to Which Request for Supplementary International Search Is Submitted

29. At the seventh session of the Working Group (see paragraphs 83 and 84 of document PCT/R/WG/7/13, reproduced above) a majority of delegations considered that the International Bureau seemed the most appropriate body to receive the request for supplementary international search, though it was noted that there were some advantages in making the request directly to the supplementary Authority, particularly if only a single supplementary international search was sought. A majority of delegations were opposed to giving the applicant the choice of submitting the request to either the International Bureau or

the supplementary Authority, noting that it would add complexity and confusion to the system.

30. After further consideration of the ways in which the applicant could be given a choice, the proposals retain the requirement that the request for supplementary search be made to the International Bureau (except when the supplementary search is to be carried out as part of an international preliminary examination). The principal reason for retaining this approach is that if requests were permitted to be made to either the International Bureau or directly to the supplementary Authority, the fees would need to be established in many more currencies and reset in the event of exchange rate fluctuations. Furthermore, payments would need to be made for some searches by the International Bureau to the participating Authorities and for other searches by the participating Authorities to the International Bureau, significantly increasing the administrative costs. On the other hand, permitting requests to be made directly to the supplementary Authority would rarely, if ever, provide any added convenience to the applicant.

Scope of Supplementary Search

31. Most of the discussion in previous sessions has been based around the concept of the supplementary search being primarily aimed at considering documents published in languages such that they would either not have been considered by the main Authority, or else would only have been considered on the basis of an abstract. In practice, that is likely to be the main function of such searches. Nevertheless, some Authorities have indicated that their search collections include documents beyond the PCT minimum documentation in a wide range of languages and that many documents might not be considered by the main Authority due to lack of access to the document, rather than because of a lack of understanding of the language. These Authorities have suggested that it might be better for them to define their own service.

32. Two possible approaches are set out in the different versions of Rule 45*bis*.7 (“Objective of Supplementary International Search”) found in Annex I and Annex II. Both give some flexibility to the supplementary Authority to extend the search to documents which might not be considered fully by the main Authority, but the version in Annex I indicates that the main focus is on languages which are a specialization of one Authority but not the other, whereas the version in Annex II is more open-ended. Either one would probably be augmented by further recommendations in the PCT International Search and Preliminary Examination Guidelines. An alternative or additional possibility would be for individual Authorities to publish an indication of the extent of the service which they intended to provide.

33. Some of the considerations to be taken into account in defining the objective or scope of the search include:

(a) Many Offices have clearly indicated their wish that any supplementary search system should be a complement to the main search rather than being duplicative. Language speciality is an area which can be identified relatively easily as extending the scope of documents fully considered in a search.

(b) If supplementary searches are desired by applicants, it may be better for Authorities to offer a service that they are able and willing to provide, rather than to exclude themselves because they do not feel able to offer a very specific service specified by the Regulations. As long as the scope of the Authority’s service is made clear, applicants could

then make a commercial decision about whether it provides good value for money in their particular circumstances.

(c) The primary interests of third parties are taken into consideration by the PCT minimum documentation. This is defined with the intention that *every* international search should be of a high quality and that (given that International Searching Authorities all in fact have access to search documentation beyond this minimum) further searching should not be routinely required to provide a high degree of certainty of the validity of any resulting patent. While no search can provide absolute certainty, the minimum documentation ensures coverage of both information published in patent documents from a wide range of countries and in non-patent literature, most importantly from fields where much of the art is described in documents other than patent applications. If there are fundamental problems in the scope of search afforded by Authorities considering at least the minimum documentation, they ought to be addressed as part of the comprehensive review which is currently being conducted (see paragraphs 9 to 11 of document PCT/MIA/11/14 and document PCT/MIA/12/6).

Unity of Invention

34. Representatives of users have indicated that, where the international application is found to lack unity of invention, a supplementary search should not be limited to simply the first invention claimed, but the applicant should be able to specify which claims should be searched and pay the appropriate fees (see, for example, paragraph 79 of document PCT/R/WG/6/12). The possible ways in which such a system could be implemented depend on whether supplementary searches are carried out concurrently with the main search or sequentially (or both).

35. If the main and supplementary searches are carried out concurrently, there would be no alternative but for the supplementary Authority to make its own assessment of unity of invention and request any additional fees. Such a system would presumably also require a protest procedure parallel to the one for the main search.

36. The same procedure could be followed for sequential searches, but alternatively it would be possible for the supplementary Authority to rely on the view of the main Authority, as set out in the international search report, albeit with the possibility that a protest might still be under consideration. Although some International Authorities have expressed concern about being bound by the views of a different International Authority in such matters, it would be an administratively convenient approach for the applicant, the International Bureau and the supplementary Authority alike since the applicant would be able to state exactly which claims were to be searched and pay the appropriate fee at the time of making the request for supplementary search (on the understanding that if a protest lodged at the main Authority is successful, any unnecessary additional supplementary fees would be refunded automatically).

37. The approach described in paragraph 36, above is followed in the proposals in Annex I. In this way, there would be no further administration or delay at the supplementary Authority related to the request for additional fees or consideration of a protest so that it should be possible to establish a supplementary search report more quickly. In most cases it should still lead to the same number of fees being paid. It should be noted that use of the International Searching Authority's assessment of unity for the purpose of the supplementary search would not mean that the supplementary Authority necessarily agreed with it and would follow it for the purpose of international preliminary examination or national processing.

38. Where both concurrent and sequential searches are permitted, it would be possible to have a system relying on the view of the International Searching Authority if the international search report was established prior to the request for supplementary search being made, but otherwise an independent assessment being made by the supplementary Authority. However, this may lead to unnecessary complication and confusion in the Rules and procedures. Consequently, the proposal in Annex II provides for the independent assessment of unity by the supplementary Authority in all cases. If this option were used, it is envisaged that the International Search and Preliminary Examination Guidelines would make clear that if the main international search report is available, the views of the main Authority on unity should be taken fully into account.

Supplementary Search by the International Preliminary Examining Authority

39. The proposals make provision for supplementary searches to be performed by the International Preliminary Examining Authority. Clearly this would need to be requested as part of the demand and would have to be subject to the same time limits (it could be envisaged that a demand which had already been filed could be “corrected” to include a request for supplementary international search, though this possibility is not specifically provided for in the draft rules). Performing supplementary searches at the same time as international preliminary examination would be efficient in that an examiner would only need to consider the international application once to address both purposes, though it would only be practical in limited circumstances because:

(a) the option would only be available if the desired Authority was a competent International Preliminary Examining Authority for the international application (which is a major restriction given the limited choice of Authorities available to most applicants at present);

(b) it would preclude the possibility of the international preliminary examination being carried out by the same Office which acted as International Searching Authority; and

(c) the applicant might not be interested in international preliminary examination of his application at all.

40. The draft rules permit separate notifications by International Authorities in respect of their willingness and conditions for conducting supplementary searches either as a separate service or together with international preliminary examination. Nevertheless, in order that the system be kept as simple as possible, it is hoped that Authorities would provide the service in both forms under the same conditions.

Claims Covered by Main and Supplementary International Search Reports

41. In the proposals of Annex II, the fact that concurrent searches are possible means that the supplementary search cannot be limited to claims covered by the main international search report (this is true even if the searches in fact take place sequentially since it is proposed that the same rules should apply). This means that the supplementary search may cover claims on which no main international search report is established, whether because of issues of unity of invention or because of differences in the subject matter which certain International Searching Authorities under Rule 39 are not required to search.

42. The results of a supplementary international search where a main international search had not been conducted would need to be treated with caution: this should be expected not to be as near a complete review of the relevant prior art as a normal international search since

the search (being intended as a supplement to a main search, even if this is not in fact carried out) may, for example, exclude most of the PCT minimum documentation from its scope. Applicants should be aware of the limitations of any supplementary searches. International Preliminary Examining Authorities (or designated and elected Offices) considering a supplementary search report on claims not covered by a main international search report would need to decide on the merits of the case whether an opinion on novelty, inventive step and industrial applicability can be fully established, should not be established, or can be partially established but include a caution that it is based on the results of a supplementary search which was intended to complement a main search report which was not established.

PROVISION OF SERVICES

43. The services proposed in this document will only be useful if International Authorities are able to provide supplementary searches covering a sufficient range of material beyond the PCT minimum documentation, within timescales which meet the needs of applicants and at a price which applicants are prepared to pay. It is noted that if the supplementary search fees are set at similar levels to the main international search fees, applicants might reasonably expect a similarly complete search rather than one which is intended as a non-duplicative complement to the main search. It is also highly desirable that the improved coverage provided by the supplementary searches be recognized by greater (preferably complete) reliance on the international search in the national phase, with corresponding reductions in fees and processing time.

44. *The Meeting is invited to:*

(i) consider the proposals and issues contained in this document; and

(ii) discuss when, and to what extent, individual Authorities might be able to offer services under such a system.

[Annex follows]

ANNEX I

DRAFT AMENDMENTS OF THE PCT REGULATIONS:⁴ALTERNATIVE A:
SEQUENTIAL SEARCHES ONLY

TABLE OF CONTENTS

<u>Rule 45bis</u> <u>Supplementary International Searches</u>	3
<u>45bis.1</u> <u>Request for Supplementary International Search</u>	3
<u>45bis.2</u> <u>Acknowledgement and Checking of the Request for Supplementary International Search</u>	7
<u>45bis.3</u> <u>Supplementary Search Handling Fee</u>	8
<u>45bis.4</u> <u>Supplementary Search Fee; Additional Supplementary Search Fee</u>	9
<u>45bis.5</u> <u>Translation for Supplementary International Search</u>	13
<u>45bis.6</u> <u>Transmittal of the Supplementary Search Copy, International Search Report etc.</u>	13
<u>45bis.7</u> <u>Objective of Supplementary International Search</u>	14
<u>45bis.8</u> <u>Basis of the Supplementary International Search</u>	14
<u>45bis.9</u> <u>Start of Supplementary International Search</u>	16
<u>45bis.10</u> <u>Unity of Invention</u>	16
<u>45bis.11</u> <u>Supplementary International Search Report</u>	17
<u>45bis.12</u> <u>Transmittal and Effect of the Supplementary International Search Report</u>	18
<u>45bis.13</u> <u>International Searching Authorities Prepared to Carry Out Supplementary International Search</u>	20
Rule 53 The Demand.....	21
53.1 [No change].....	21
53.2 <u>Mandatory and Optional Contents; Signature</u>	21
53.3 to 53.9 [No change].....	21
Rule 58 The Preliminary Examination <u>and Supplementary Search Fees</u> Fee	22
58.1 <u>Right to Ask for a Fee</u>	22
58.2 [Remains deleted].....	23
58.3 <u>Refund</u>	23
Rule 66 Procedure Before the International Preliminary Examining Authority.....	25
66.1 <u>Basis of the International Preliminary Examination</u>	25
66.1bis [No change].....	26
<u>66.1ter</u> <u>Supplementary International Search by the International Preliminary Examining Authority</u>	26
66.2 to 66.9 [No change].....	26
Rule 68 Lack of Unity of Invention (International Preliminary Examination).....	27
68.1 [No change].....	27
68.2 <u>Invitation to Restrict or Pay</u>	27
68.3 <u>Additional Fees</u>	28

⁴ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

68.4 and 68.5 [No change].....	28
Schedule of Fees.....	29

Rule 45bis

Supplementary International Searches

45bis.1 Request for Supplementary International Search

(a) The applicant may, after having received the international search report and within the time limit referred to in paragraph (b), request the International Bureau that a supplementary international search be carried out by one or more Authorities which have notified the International Bureau under Rule 45bis.13 that they are prepared to carry out such searches (“participating Authority”), other than the International Searching Authority which carried out the international search under Article 16(1).

[COMMENT: In this proposal, a supplementary search can only be requested after having received the international search report—if a declaration is made under Article 17(2)(a) by the main Authority, a subsequent request for supplementary search would be treated as not having been made.]

[Rule 45bis.1, continued]

(b) The time limit referred to in paragraph (a) shall be whichever of the following expires later:

(i) three months from the date of transmittal to the applicant of the international search report and the written opinion established under Rule 43bis.1; or

(ii) 22 months from the priority date.

[COMMENT: The proposal in Annex II allows for the possibility of a participating Authority setting an earlier time limit in case its workflow would not permit the establishment of a supplementary search report within the international phase using these time limits. However, that option is not included in this proposal since there should rarely, if ever, be any delay to the establishment of the supplementary search report caused by the need to contact the applicant (see paragraph 37 of the main body of this document) so the Authority will have more time available for the search itself.]

(c) A request under paragraph (a) shall contain:

(i) indications concerning the international application to which it relates, comprising the name and address of the applicant, the title of the invention, the international filing date and the international application number;

(ii) an indication of which participating Authorities are requested to carry out a supplementary international search;

[Rule 45bis.1(c), continued]

(iii) where the international application was filed in a language which is not accepted by an Authority which is to carry out a supplementary international search, an indication of whether any translation furnished under Rule 12.3 or 12.4 is to form the basis of the supplementary international search to be carried out by that Authority; and

(iv) where the International Searching Authority considers that the international application does not comply with the requirement of unity of invention, an indication of which of the inventions in respect of which the international search report was established are to be the subject of the supplementary international search.

[COMMENT: The applicant would be permitted to choose any of the inventions to be the subject of the supplementary international search, as long as that invention had been searched by the International Searching Authority. The main invention would not necessarily need to be included.]

[Rule 45bis.1, continued]

(d) A request under paragraph (a) shall, where applicable, also be accompanied by:

(i) any translation of the international application required under Rule 45bis.5;

(ii) a copy of any sequence listing in electronic form complying with the standard provided for in the Administrative Instructions which was required by the International Searching Authority under Rule 13ter.1(a).

[COMMENT: At present, the International Searching Authority does not forward a copy of sequence listings provided for the purpose of international search to the International Bureau, since they do not form part of the international application and are not published. An alternative possibility would be for such listings to be sent by the International Searching Authority to the International Bureau automatically with the international search report, so that the applicant would not be required to furnish further copies for any supplementary searches.]

(e) The fees payable under Rules 45bis.3 and 45bis.4 shall be paid to the International Bureau within one month from the date of receipt of the request for supplementary international search. The amount payable shall be the amount applicable on that date of receipt.

45bis.2 Acknowledgement and Checking of the Request for Supplementary International Search

(a) The International Bureau shall promptly acknowledge receipt of a request for supplementary international search. Where the International Bureau finds that any of the indications required under Rule 45bis.1(c) or any elements required under Rule 45bis.1(d) are missing, it shall invite the applicant to furnish the indications or elements within one month from the date of the invitation.

(b) Where, by the time they are due under Rule 45bis.1(e), the International Bureau finds that the fees under Rules 45bis.3 and 45bis.4 have not been paid in full, the International Bureau shall invite the applicant to pay to it the amount required to cover those fees within a time limit of one month from the date of the invitation.

[COMMENT: It is not envisaged that applicants would often use this provision deliberately to extend the period for payment of fees or the provision of translations because of the risk that the supplementary search report would not be established in time for use in making decisions on whether to enter the national (or regional) phase. Consequently, although making and following up the invitation would significantly add to the work required of the International Bureau in any particular case, it is not proposed at this time to include a late payment fee. This would need to be reviewed if significant numbers of invitations needed to be issued.]

(c) If the applicant does not, before the expiration of the time limit under Rule 45bis.2(a), submit the required indications or elements or does not, before the expiration of the time limit under Rule 45bis.2(b), pay the amount in full of the fees due, the request for supplementary international search shall, subject to paragraph (d), be considered as if it had not been made and the International Bureau shall inform the applicant accordingly.

[Rule 45bis.2, continued]

(d) Where the International Searching Authority considered that the international application does not comply with the unity of invention requirements under Rule 13 but the applicant does not, before the expiration of the time limit under Rule 45bis.2(b), pay the amount in full of all additional supplementary search fees relating to inventions indicated under paragraph (a)(iv), the request shall be considered to be a request for supplementary international search on as many of the inventions as required fees have been paid. The Administrative Instructions shall determine which of the inventions shall be the subject of the supplementary international search.

[COMMENT: The Administrative Instructions would require that where the inventions to be searched had been listed, the supplementary international searches would be performed on the appropriate number of inventions in the order in which they were listed. Where they were not listed, the search would normally be performed in the order in which the inventions appeared in the claims, but would leave some scope for discretion (for example, ignoring inventions which would not be subject to supplementary international search in accordance with Rule 45bis.8(b) on grounds of their subject matter).]

45bis.3 Supplementary Search Handling Fee

(a) A request for a supplementary international search filed with the International Bureau under Rule 45bis.1(a) shall be subject to the payment of a fee for the benefit of the International Bureau (“supplementary search handling fee”). The amount of the supplementary search handling fee is as set out in the Schedule of Fees. The International Bureau shall refund to the applicant any supplementary search handling fee paid if:

[Rule 45bis.3(a), continued]

(i) the request for a supplementary international search is withdrawn before the supplementary search copy is sent to the Authority carrying out the supplementary international search; or

(ii) the request for a supplementary international search is considered, under Rule 45bis.2(c), not to have been made.

[COMMENT: The amount of this fee would be set to cover the cost of processing the request and results, including checking the request, forwarding the necessary documents to the International Searching Authority carrying out the supplementary international search, making any necessary translations and making the results available to Offices and the public.]

(b) The amount of the said fees in any currency prescribed by the International Bureau, other than the currency in which the fee is set in the Schedule of Fees, shall be established by the Director General. The amounts so established shall be the equivalents, in round figures, of the amount set in the Schedule of Fees. They shall be published in the Gazette.

45bis.4 Supplementary Search Fee; Additional Supplementary Search Fee

(a) A participating Authority may require that the applicant:

(i) pay a fee (“supplementary search fee”) for its own benefit for carrying out a supplementary international search;

[Rule 45bis.4(a), continued]

(ii) pay an additional fee (“additional supplementary search fee”) for its own benefit for carrying out a supplementary international search in respect of any invention, beyond the first, which is to be the subject of a supplementary international search in accordance with Rule 45bis.10.

[COMMENT: The “first” invention means the first which is to be the subject of a supplementary international search, not necessarily the “first mentioned in the claims” as is specified for the main international search under Article 17(3)(a).]

(b) The supplementary search fee and any additional supplementary search fee shall be collected by the International Bureau. The said fees shall be payable in the currency or one of the currencies prescribed by that Bureau (“prescribed currency”), it being understood that, if the prescribed currency is not that, or one of those, in which the participating Authority has fixed the said fees (“fixed currency”), they shall, when transferred by the International Bureau to the participating Authority, be freely convertible into the currency of the State in which the participating Authority has its headquarters (“headquarters currency”). The amount of the said fees in any prescribed currency, other than the fixed currency, shall be established by the Director General after consultation with the Authority which has fixed the said fees. The amounts so established shall be the equivalents, in round figures, of the amount established by the participating Authority in the headquarters currency. They shall be published in the Gazette.

[Rule 45bis.4, continued]

(c) Where the amount of the supplementary search fee and the additional supplementary search fee in the headquarters currency is changed, the corresponding amounts in the prescribed currencies, other than the fixed currency or currencies, shall be applied from the same date as the changed amount in the headquarters currency.

(d) Where the exchange rate between the headquarters currency and any prescribed currency, other than the fixed currency or currencies, becomes different from the exchange rate last applied, the Director General shall establish the new amount in the said prescribed currency according to directives given by the Assembly. The newly established amount shall become applicable two months after its publication in the Gazette, provided that the Director General may alternatively specify a date falling during the said two-month period, in which case the said amount shall become applicable from that date.

(e) Where, in respect of the payment of the supplementary search fee or the additional supplementary search fee in a prescribed currency, other than the fixed currency or currencies, the amount actually received by the International Searching Authority in the headquarters currency is less than that fixed by it, the difference will be paid to the International Searching Authority by the International Bureau, whereas, if the amount actually received is more, the difference will belong to the International Bureau.

(f) The International Bureau shall refund the supplementary search fee and any additional supplementary search fee to the applicant if:

[Rule 45bis.4(f), continued]

(i) the request for a supplementary international search is withdrawn before the supplementary search copy is sent to the Authority carrying out the supplementary international search; or

(ii) the request for a supplementary international search is considered, under Rule 45bis.2(c) or 45bis.9(b), not to have been made.

(g) To the extent that the International Searching Authority finds a protest of the applicant under Rule 40.2(c) justified, the Authority carrying out the supplementary international search shall totally or partially refund any additional supplementary search fee paid by the applicant in accordance with Rule 45bis.4(a)(ii).

[COMMENT: Draft Rule 45bis.4 is modeled on Rule 16. The currencies currently prescribed by the International Bureau in its role as a receiving Office in respect of the collection of search fees are the Swiss franc, the euro and the US dollar. While refunds of fees would be carried out by the International Bureau under paragraph (f) when the request for supplementary international search is withdrawn or considered withdrawn, refunds under paragraph (g) following a successful protest would require consideration by the Authority carrying out the supplementary international search of the extent to which the refund was appropriate. The Administrative Instructions would need to be modified so as to indicate that the International Bureau must forward the results of any protest to all Authorities carrying out a supplementary international search.]

45bis.5 Translation for Supplementary International Search

Where neither the language in which the international application was filed nor that in which a translation (if any) has been furnished under Rule 12.3 or 12.4 is accepted by the Authority carrying out the supplementary international search, the request for a supplementary international search shall be accompanied by a translation of the international application into a language which is accepted by that Authority and is a language of publication.

[COMMENT: Modeled on Rule 12.3. For simplicity of processing, the translation would need to be filed at the same time as the request for the supplementary international search. This does not appear to be an unreasonable burden since the time limit will inevitably be several months after the international filing date, allowing more time to prepare the translation than is permitted for the translation for the purposes of the main international search. Note that this provision would need adaptation should amendments of the Regulations concerning publication of international applications in multiple languages (see document PCT/R/WG/7/4) be adopted.]

45bis.6 Transmittal of the Supplementary Search Copy, International Search Report etc.

On finding that the requirements under Rules 45bis.1(c), (d) and (e) have been complied with, the International Bureau shall promptly transmit to each Authority which is to carry out a supplementary international search one copy of each of the following:

- (i) the request for a supplementary international search;
- (ii) the international application (“supplementary search copy”);
- (iii) any sequence listing furnished under Rule 45bis.1(d)(ii);

[Rule 45bis.6, continued]

(iv) any translation furnished by the applicant under Rule 12.3, 12.4 or 45bis.5 which is to be used as the basis of the supplementary international search;

(v) the international search report; and

(vi) the written opinion established under Rule 43bis.1.

[COMMENT: It would not normally be necessary for the supplementary Authority to consider the written opinion, but it might occasionally be useful in determining whether the main Authority had considered the full text of a cited document or only an abstract.]

45bis.7 Objective of Supplementary International Search

The objective of the supplementary international search is to discover relevant prior art, further to that discovered in the international search, by extending the international search to cover documents which may not have been considered fully by the International Searching Authority during the international search, particularly those in languages of specialization of the Authority carrying out the supplementary international search which are not languages of specialization of the International Searching Authority.

45bis.8 Basis of the Supplementary International Search

(a) The supplementary international search shall be carried out on the basis of the international application as filed or of a translation thereof indicated under Rule 45bis.1(c)(iii) or accompanying the request for supplementary international search under Rule 45bis.5.

[Rule 45bis.8, continued]

[COMMENT: Under this proposal the supplementary international search cannot begin before the main international search report has been transmitted. Consequently, it would always be possible for the applicant to file amendments under Article 19 before the supplementary international search commenced. However, if such amendments were to be taken into account the main and supplementary international search reports would be more difficult to read together and in some cases it would be difficult to know how to supplement, rather than restart, the international search.]

(b) For the purposes of the supplementary international search, Article 17(2) and Rules 13ter.1, 33 and 39 shall apply *mutatis mutandis*.

[COMMENT: The Authority would not be required to carry out a supplementary international search in respect of subject matter or unclear applications for which it would not be required to carry out an international search. It should also be able to request sequence listings in an appropriate electronic form if necessary (though this should rarely be required since the applicant would be required to submit any sequence listings in electronic form which had been required by the International Searching Authority along with the request for supplementary international search).]

(c) The Authority carrying out a supplementary international search shall not be required to establish a supplementary international search report in respect of any claim for which no international search report was established.

45bis.9 Start of Supplementary International Search

(a) Subject to paragraph (b), the Authority carrying out a supplementary international search shall start that search promptly on receipt of the documents specified in Rule 45bis.6.

(b) If the Authority requested to carry out a supplementary international search finds that such search would be excluded by a limitation notified under Rule 45bis.13, the request for supplementary international search shall be considered not to have been made and the Authority shall promptly notify the applicant and the International Bureau accordingly. The Authority shall refund to the applicant the supplementary search fee and any additional supplementary search fees which have been paid under Rule 45bis.4(b).

[COMMENT: The applicant's right to a refund under this paragraph would extend only to the case where the supplementary international search is not made because of a restriction of which the International Bureau had been notified under proposed Rule 45bis.13 and not because of a declaration equivalent to that under Article 17(2)(a).]

45bis.10 Unity of Invention

If the international search report contains indications to the effect that the international application does not comply with the requirement of unity of invention under Rule 13, the Authority carrying out a supplementary international search shall establish the supplementary international search report on those claims relating to the inventions indicated by the applicant under Rule 45bis.1(c)(iv), provided that those claims were the subject of international search.

[COMMENT: See Rule 45bis.2(d) for how the request is treated in the event that not all the additional supplementary search fees are paid.]

45bis.11 Supplementary International Search Report

(a) The Authority carrying out a supplementary international search shall establish a supplementary international search report, or make a declaration pursuant to Rule 45bis.8(b) or (c) that no supplementary international search report will be established, within three months from the receipt of the request for supplementary international search by the Authority from the International Bureau.

[COMMENT: Modeled in part on Rule 42.1]

(b) For the purposes of establishing the supplementary international search report, Rules 43.1, 43.2 and 43.4 to 43.10 shall, subject to paragraph (c), apply *mutatis mutandis*. Article 20(3) and Rule 44.3 shall apply *mutatis mutandis*.

[COMMENT: The supplementary international search report would take the same form as a normal international search report, except that it would not require the Authority to reconsider and list the classification and that it would only include the newly found citations (except where a previously found document is considered relevant to inventive step in combination with a newly found document; see paragraph (c), below). The report would be established in the language of publication of the international application or in the language of any translation on which the search was based, at the choice of the Authority. The same requirement to send copies of the citations on request to the applicant or to a designated Office would apply as for the main international search.]

[Rule 45bis.11, continued]

(c) The supplementary international search report shall not contain the citation of any document which was cited in the international search report, except to the extent that the document is considered relevant to the question whether the claimed invention involves an inventive step having regard also to one or more other documents which were discovered during the supplementary international search and which were not cited in the international search report.

[COMMENT: The supplementary international search report should not merely duplicate citations which appeared in the international search report; the International Search and Preliminary Examination Guidelines would make it clear that this extends to “equivalent” patent publications, unless there is found to be a material difference between the family members. Furthermore, it might lead to uncertainty if the Authority concerned took a different view to the International Searching Authority in a report which is part of the international search process. However, where it is apparent that a document has been cited merely on the basis of an abstract and the Authority conducting the supplementary international search finds that the relevance of the document was incorrect based on a consequential misunderstanding of its contents, the PCT International Search and Preliminary Examination Guidelines would make clear that the entry in the international search report should be regarded as a citation of the abstract and that it is acceptable in this case to cite the original document in the supplementary international search report.]

45bis.12 Transmittal and Effect of the Supplementary International Search Report

(a) The Authority carrying out the supplementary international search shall, on the same day, transmit one copy of the supplementary international search report, or a declaration that no supplementary international search report shall be established because a situation referred to under Rule 45bis.8(b) or (c) exists, to the International Bureau and one copy to the applicant.

[Rule 45bis.12, continued]

(b) Subject to paragraph (c), Article 20(1) and Rules 45.1, 47.1(d) and 70.7(a) shall apply as if the supplementary international search report were part of the international search report.

[COMMENT: The supplementary international search report would, where necessary, be translated into English and be communicated automatically to any Office requesting a copy of the main international search report. The Administrative Instructions would make clear that, unless the international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty) had already been established and transmitted to the International Bureau, the supplementary international search report would always be forwarded to the International Preliminary Examining Authority so that it could be taken into account, if possible, even though international preliminary examination might already have begun. Public access to the supplementary international search report would be permitted under existing Rule 94.1(b) at any time after publication of the international application. Although it is not proposed to make a formal republication of the pamphlet to include the supplementary international search report, the online file inspection system would be arranged so that a person viewing the pamphlet would be aware of any supplementary report and could view it together with the main report.]

(c) A supplementary international search report need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if it is received by that Authority after it has begun to draw up that opinion or report.

[COMMENT: Modeled on Rule 66.4bis. The International Preliminary Search and Examination Guidelines would make clear that the International Preliminary Examining Authority should take the supplementary international search and written opinion into account whenever possible, but should not delay the start of international preliminary examination to wait for them.]

45bis.13 International Searching Authorities Prepared to Carry Out Supplementary

International Search

Each International Searching Authority which is prepared to carry out supplementary international searches shall notify the International Bureau accordingly. Any such notification may set out limitations as to the subject matter for which such searches will be carried out, beyond those which would apply under Article 17(2) to an international search, or to the total number of supplementary international searches which will be performed in a given period. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: Authorities would be able to limit the availability of such supplementary international searches to particular fields of technology, for example to exclude fields for which an Authority may not have sufficient capacity at the time, or where an Authority wished to specialize in fields of technology in which it has a particular expertise. The notification could be amended at a later stage to introduce or remove such limitations as necessary.]

Rule 53

The Demand

53.1 [No change]

53.2 Mandatory and Optional Contents; Signature

(a) [No change]

(a-bis) The demand may contain a request that the International Preliminary Examining Authority carry out a supplementary international search, provided that the national Office which is acting as International Preliminary Examining Authority is not the same as that which acted as International Searching Authority and has notified the International Bureau under Rules 44bis.13 and 66.1ter that it is prepared to carry out such searches.

(b) [No change]

53.3 to 53.9 [No change]

Rule 58

The Preliminary Examination and Supplementary Search Fees **Fee**

58.1 *Right to Ask for a Fee*

(a) [No change] Each International Preliminary Examining Authority may require that the applicant pay a fee (“preliminary examination fee”) for its own benefit for carrying out the international preliminary examination and for performing all other tasks entrusted to International Preliminary Examining Authorities under the Treaty and these Regulations.

(a-bis) Each International Preliminary Examining Authority which has notified the International Bureau under Rules 45bis.13 and 66.1ter that it is prepared to carry out supplementary searches may require that the applicant pay a fee (“supplementary search fee”) for its own benefit for carrying out the supplementary search.

[COMMENT: Fees for supplementary international searches of additional inventions are provided for in the proposed amendments to Rule 68, together with fees for examination of additional inventions.]

(b) The amount of ~~the~~ any preliminary examination fee, ~~if any,~~ and any supplementary search fee shall be fixed by the International Preliminary Examining Authority. As to the time limit for payment of the preliminary examination and supplementary search fees and the amount payable, the provisions of Rule 57.3 relating to the handling fee shall apply *mutatis mutandis*.

[Rule 58.1, continued]

(c) The preliminary examination fee and any supplementary search fee shall be payable directly to the International Preliminary Examining Authority. Where that Authority is a national Office, it shall be payable in the currency prescribed by that Office, and where the Authority is an intergovernmental organization, it shall be payable in the currency of the State in which the intergovernmental organization is located or in any other currency which is freely convertible into the currency of the said State.

58.2 [Remains deleted]

58.3 *Refund*

(a) The International Preliminary Examining Authorities shall inform the International Bureau of the extent, if any, to which, and the conditions, if any, under which, they will refund any amount paid as a preliminary examination fee where the demand is considered as if it had not been submitted, and the International Bureau shall promptly publish such information.

(b) The International Preliminary Examining Authority shall refund to the applicant any supplementary search fee and any additional supplementary search fees paid to it if:

(i) the demand or the associated request for a supplementary international search is withdrawn or considered not to have been submitted before the supplementary international search has been started; or

[Rule 58.3(b), continued]

(ii) the request for a supplementary international search is considered, under Rules 45bis.9(b) and 66.1ter, not to have been made.

Rule 66

**Procedure Before the
International Preliminary Examining Authority**

66.1 Basis of the International Preliminary Examination

(a) [No change] Subject to paragraphs (b) to (d), the international preliminary examination shall be based on the international application as filed.

(b) [No change] The applicant may submit amendments under Article 34 at the time of filing the demand or, subject to Rule 66.4bis, until the international preliminary examination report is established.

(c) [No change] Any amendments under Article 19 made before the demand was filed shall be taken into account for the purposes of the international preliminary examination unless superseded, or considered as reversed, by an amendment under Article 34.

(d) [No change] Any amendments under Article 19 made after the demand was filed and any amendments under Article 34 submitted to the International Preliminary Examining Authority shall, subject to Rule 66.4bis, be taken into account for the purposes of the international preliminary examination.

(e) [No change] Claims relating to inventions in respect of which no international search report has been established need not be the subject of international preliminary examination.

[Rule 66.1, continued]

(f) Paragraphs (a) to (e) shall apply *mutatis mutandis* to any supplementary international search carried out at the same time as the international preliminary examination.

66.1*bis* [No change]

66.1*ter* *Supplementary International Search by the International Preliminary Examining Authority*

For the purposes of supplementary international searches by the International Preliminary Examining Authority, Rules 45*bis*.7, 45*bis*.9(b) and 45*bis*.13 shall apply *mutatis mutandis*.

[COMMENT: Supplementary international searches by the International Preliminary Examining Authority would have the same objective as those by International Searching Authorities and be subject to the same possibility for limitations, such as in respect of subject matter for which the service is made available. There would not be a formal supplementary search report. Rather, the results would be cited in the international preliminary report on patentability, in the same way as is currently done for documents which are considered relevant but were not cited in the international search report (see Rule 70.7). The Administrative Instructions would require that the report should indicate that a supplementary international search had been conducted together with the international preliminary examination.]

66.2 to 66.9 [No change]

Rule 68

Lack of Unity of Invention
(International Preliminary Examination)

68.1 [No change]

68.2 *Invitation to Restrict or Pay*

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees, the invitation shall:

(i) to (iii) [No change]

(iv) indicate the amount of the required additional preliminary examination fees to be paid in case the applicant so chooses;

(v) where the applicant has requested a supplementary international search and any additional invention has been the subject of an international search, indicate the amount of the required additional supplementary search fees to be paid if a supplementary international search is to be carried out in respect of each such additional invention; and

[Rule 68.2, continued]

[\(vi\)](#) ~~(v)~~ invite the applicant to pay, where applicable, the protest fee referred to in Rule 68.3(c) within one month from the date of the invitation, and indicate the amount to be paid.

68.3 *Additional Fees*

(a) The amount of the additional fees due for international preliminary examination under Article 34(3)(a) [and, where the International Preliminary Examining Authority has indicated that it is prepared to carry out supplementary international searches, for supplementary international search of any additional invention](#) shall be determined by the competent International Preliminary Examining Authority.

(b) The additional fees due for international preliminary examination under Article 34(3)(a) [and any supplementary international search](#) shall be payable direct to the International Preliminary Examining Authority.

(c) to (e) [No change]

68.4 and 68.5 [No change]

Schedule of Fees

[COMMENT: The Schedule of Fees would require amendment to include a supplementary search handling fee, whose level would be set to cover the cost of preparation, transmission, translation and making available of documents relevant to the supplementary international search during the Chapter I procedure. For supplementary international searches performed as part of the Chapter II procedure, no such fee would be necessary since no significant additional work for the International Bureau would be involved over and above that for which the handling fee under Rule 57 is levied.]

[Annex II follows]

ANNEX II

DRAFT AMENDMENTS OF THE PCT REGULATIONS:⁵ALTERNATIVE B:
CONCURRENT AND SEQUENTIAL SEARCHES

TABLE OF CONTENTS

Rule 4 The Request (Contents)	2
4.1 <i>Mandatory and Optional Contents; Signature</i>	2
4.2 to 4.19 [No change]	2
<u>Rule 45bis Supplementary International Searches</u>	3
<u>45bis.1 Request for Supplementary International Search</u>	3
<u>45bis.2 Acknowledgement and Checking of the Request for Supplementary International Search</u>	7
<u>45bis.3 Supplementary Search Handling Fee</u>	7
<u>45bis.4 Supplementary Search Fee; Additional Supplementary Search Fee</u>	8
<u>45bis.5 Translation for Supplementary International Search</u>	10
<u>45bis.6 Transmittal of the Supplementary Search Copy, International Search Report etc.</u>	10
<u>45bis.7 Objective of Supplementary International Search</u>	11
<u>45bis.8 Basis of the Supplementary International Search</u>	11
<u>45bis.9 Start of Supplementary International Search</u>	12
<u>45bis.10 Unity of Invention</u>	12
<u>45bis.11 Supplementary International Search Report</u>	13
<u>45bis.12 Transmittal and Effect of the Supplementary International Search Report</u>	13
<u>45bis.13 International Searching Authorities Prepared to Carry Out Supplementary International Search</u>	13
Rules 53, 58, 66, 68; Schedule of Fees	15

⁵ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 4⁶

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) and (b) [No change]

(c) The request may contain:

(i) to (iv) [No change]

(v) a request for restoration of the right of priority~~;~~²

(vi) a request for supplementary search under Rule 45bis.

4.2 to 4.19 [No change]

⁶ Draft Rule 4 is based on the text of Rule 4 as due to come into force April 1, 2007.

Rule 45bis

Supplementary International Searches

45bis.1 Request for Supplementary International Search

(a) The applicant may, within the time limit referred to in paragraph (b), request the International Bureau that a supplementary international search be carried out by one or more Authorities which have notified the International Bureau under Rule 45bis.13 that they are prepared to carry out such searches (“participating Authority”), other than the International Searching Authority responsible for the international search under Article 16(1).

[COMMENT: The only substantive difference between this and the proposal in Annex I is that the request may be made before the international search report has been established. The use of the term “responsible for” is a consequential difference, merely reflecting the fact that the international search may or may not yet have been established and that the applicant may have selected the International Searching Authority from several Authorities which would have been competent to carry out the main search.]

[Rule 45bis.1, continued]

(b) The time limit referred to in paragraph (a) shall be whichever of the following expires later:

(i) three months from the date of transmittal to the applicant of the international search report and the written opinion established under Rule 43bis.1; or

(ii) 22 months from the priority date;

unless the Authority requested to carry out the supplementary search has specified an earlier time limit under Rule 45bis.13(b)(ii).

[COMMENT: An Authority would be permitted to specify an earlier time limit for requesting supplementary search from that Authority, for example if it is concerned about the effects of late requests on its work flow.]

(c) A request under paragraph (a) shall contain:

(i) unless the request under paragraph (a) is included in the request under Article 3(2), indications concerning the international application to which it relates, comprising the name and address of the applicant, the title of the invention, the international filing date and the international application number;

(ii) an indication of which participating Authorities are requested to carry out a supplementary international search; and

[Rule 45bis.1(c), continued]

(iii) where the international application was filed in a language which is not accepted by an Authority which is to carry out a supplementary international search, an indication of whether any translation furnished under Rule 12.3 or 12.4 is to form the basis of the supplementary international search to be carried out by that Authority.

(c-bis) A request under paragraph (a) may also include an indication of which claims are to be the subject of the supplementary international search in the event that the international application is considered to lack unity of invention.

[COMMENT: Since the main Authority may not have established an international search report showing its view concerning unity of invention, and noting that, under this proposal, the supplementary Authority would not in any case be bound by that view, it will not generally be possible for the request for supplementary international search to make a definitive statement of which claims should be searched. Nevertheless, the applicant should be permitted to make some form of indication in order to avoid automatic further searching of a first invention which either has already been shown not to be new, or else is otherwise no longer considered to be commercially relevant.]

(d) A request under paragraph (a) shall, where applicable, be accompanied by:

(i) any translation of the international application required under Rule 45bis.5;

(ii) a copy of any sequence listing in electronic form complying with the standard provided for in the Administrative Instructions which has been required by the International Searching Authority under Rule 13ter.1(a).

[Rule 45bis.1(d), continued]

[COMMENT: The difference in wording between paragraph (ii), above, and the equivalent provision in Annex I reflects the fact that, in this proposal, the main Authority may not yet have decided whether it needs to request a sequence listing at the time that the request for supplementary search is made.]

(e) The fees payable under Rules 45bis.3 and 45bis.4(a)(i) shall be paid to the International Bureau within one month from the date of receipt of the request for supplementary international search by the International Bureau. The amount payable shall be the amount applicable on that date of receipt.

(f) Where a request under paragraph (a) to the International Bureau is included in the request under Article 3(2), the request under paragraph (a) and any accompanying documents shall be transmitted to the International Bureau by the receiving Office together with the record copy and shall be treated for the purposes of paragraph (e), and Rule 45bis.2 as if it had been received directly by the International Bureau on its date of receipt by that Bureau, provided that the fees payable shall be those applicable on the date of receipt of the international application by the receiving Office.

[COMMENT: It would aid processing of fees by the International Bureau if payments are made only in respect of international applications of which the Bureau is already aware and if the applicant is able to give the international application number at the time of payment. Consequently, where the request for supplementary international search is included in the request under Article 3(2), it would be desirable if the applicant did not need to pay until the receiving Office had transmitted the record copy to the International Bureau and notified the applicant of the international application number. Nevertheless, the applicant should not be liable for any increases in fees over what was payable at the time of requesting the supplementary international search because of delays in transmission of the record copy which are beyond his control.]

45bis.2 Acknowledgement and Checking of the Request for Supplementary International Search

(a) and (b) [As in the proposal in Annex I]

(c) If the applicant does not, before the expiration of the time limit under Rule 45bis.2(a), submit the required indications or elements or does not, before the expiration of the time limit under Rule 45bis.2(b), pay the amount in full of the fees due, the request for supplementary international search shall be considered as if it had not been made and the International Bureau shall inform the applicant accordingly.

[COMMENT: No equivalent to paragraph (d) in Annex I is included, relating to the case where insufficient additional supplementary search fees are paid, because under this proposal these fees would be collected by the supplementary Authority. Paragraph (c) differs from the proposal in Annex I only in the consequential removal of the reference to paragraph (d).]

45bis.3 Supplementary Search Handling Fee

(a) and (b) [As in the proposal in Annex I]

45bis.4 Supplementary Search Fee; Additional Supplementary Search Fee

(a) [As in the proposal in Annex I]

(b) The supplementary search fee shall be collected by the International Bureau. The said fees shall be payable in the currency or one of the currencies prescribed by that Bureau (“prescribed currency”), it being understood that, if the prescribed currency is not that, or one of those, in which the participating Authority has fixed the said fees (“fixed currency”), they shall, when transferred by the International Bureau to the participating Authority, be freely convertible into the currency of the State in which the participating Authority has its headquarters (“headquarters currency”). The amount of the said fees in any prescribed currency, other than the fixed currency, shall be established by the Director General after consultation with the Authority which has fixed the said fees. The amounts so established shall be the equivalents, in round figures, of the amount established by the participating Authority in the headquarters currency. They shall be published in the Gazette.

(c) Where the amount of the supplementary search fee in the headquarters currency is changed, the corresponding amounts in the prescribed currencies, other than the fixed currency or currencies, shall be applied from the same date as the changed amount in the headquarters currency.

(d) Where the exchange rate between the headquarters currency and any prescribed currency, other than the fixed currency or currencies, becomes different from the exchange rate last applied, the Director General shall establish the new amount in the said prescribed currency according to directives given by the Assembly. The newly established amount shall become applicable two months after its publication in the Gazette, provided that the Director

[Rule 45bis.4(d), continued]

General may alternatively specify a date falling during the said two-month period, in which case the said amount shall become applicable from that date.

(e) Where, in respect of the payment of the supplementary search fee in a prescribed currency, other than the fixed currency or currencies, the amount actually received by the International Searching Authority in the headquarters currency is less than that fixed by it, the difference will be paid to the International Searching Authority by the International Bureau, whereas, if the amount actually received is more, the difference will belong to the International Bureau.

(f) The International Bureau shall refund the supplementary search fee to the applicant if:

(i) the request for a supplementary international search is withdrawn before the supplementary search copy is sent to the Authority carrying out the supplementary international search; or

(ii) the request for a supplementary international search is considered, under Rule 45bis.2(c) or 45bis.9(b), not to have been made.

[COMMENT: Paragraphs (b) to (f) differ from the equivalent proposals in Annex I in that they relate only to the supplementary search fee (which is collected by the International Bureau as in the proposal in Annex I) and not to any additional supplementary search fee (which under this proposal is collected by the supplementary Authority—Rule 45bis.10).]

45bis.5 Translation for Supplementary International Search

[As in the proposal in Annex I]

45bis.6 Transmittal of the Supplementary Search Copy, International Search Report etc.

(a) Subject to paragraph (b), on finding that the requirements under Rules 45bis.1(c), (d) and (e) have been complied with, the International Bureau shall promptly transmit to each Authority which is to carry out a supplementary international search one copy of each of the following:

(i) the request for a supplementary international search;

(ii) the international application (“supplementary search copy”);

(iii) any sequence listing furnished under Rule 45bis.1(d)(ii);

(iv) any translation furnished by the applicant under Rule 12.3, 12.4 or 45bis.5 which is to be used as the basis of the supplementary international search;

(v) the international search report; and

(vi) the written opinion established under Rule 43bis.1.

[COMMENT: This differs from the proposal in Annex I by including a reference to an additional paragraph (b), below, which covers the case when the international search report has not yet been established.]

[Rule 45bis.6, continued]

(b) If the international search report and written opinion of the International Searching Authority have not yet been transmitted to the International Bureau at the time that the requirements under Rules 45bis.1(c), (d) and (e) have been complied with, the International Bureau shall promptly upon their receipt transmit a copy of each of these documents to each Authority which is requested to establish a supplementary international search report, unless that report has already been established and transmitted to the International Bureau.

45bis.7 Objective of Supplementary International Search

The objective of the supplementary international search is to discover relevant prior art, complementary to that which has been found, or is likely to be found, by the International Searching Authority.

[COMMENT: This statement of objectives is more open than the one proposed in Annex I. This is mainly to reflect the fact that the scope of the main search may be uncertain at the time that the supplementary search is conducted, but also provides an alternative taking into account that some delegations at the seventh session of the Working Group considered that participating Authorities should be free to determine the scope of the supplementary search for themselves according to the type of service which it was prepared to offer.]

45bis.8 Basis of the Supplementary International Search

(a) and (b) [As in the proposal in Annex I]

[COMMENT: There is no paragraph (c) in this proposal, stating that the supplementary Authority is not required to establish a supplementary international search report in respect of claims which were not searched by the main Authority, because it will frequently not yet be certain which claims will be searched by the main Authority.]

45bis.9 Start of Supplementary International Search

(a) Subject to paragraph (b), the Authority carrying out a supplementary international search shall start that search promptly on receipt of the documents specified in Rule 45bis.6(i) to (iv).

[COMMENT: Although not provided for here, it would alternatively be possible to allow Authorities which wished to ensure a minimum of duplication of work to delay the start of supplementary search until the main international search report had been transmitted to them.]

(b) [As in the proposal in Annex I]

45bis.10 Unity of Invention

Where the Authority carrying out the supplementary search considers that the international application does not comply with the requirement of unity of invention, Article 17(3)(a) and Rule 40 shall apply *mutatis mutandis*.

[COMMENT: Under this proposal, the supplementary Authority would make its own assessment of unity of invention and request any additional supplementary search fees in the same way as is done for the main international search, including the possibility of a payment being made under protest.]

45bis.11 *Supplementary International Search Report*

(a) and (b) [As in the proposal in Annex I]

[COMMENT: There is no paragraph (c) prohibiting duplication of citations between the main search report and the supplementary search report since the main report may not yet be available to the supplementary Authority.]

45bis.12 *Transmittal and Effect of the Supplementary International Search Report*

(a) to (c) [As in the proposal in Annex I]

45bis.13 *International Searching Authorities Prepared to Carry Out Supplementary International Search*

(a) Each International Searching Authority which is prepared to carry out supplementary international searches shall notify the International Bureau accordingly.

(b) A notification under paragraph (a) may:

(i) set out limitations as to the subject matter for which such searches will be carried out, beyond those which would apply under Article 17(2) to an international search, or to the total number of supplementary international searches which will be performed in a given period; or

(ii) specify a time limit for requesting a supplementary international search by the Authority which is earlier than that specified in Rule 45bis.1(b)(i) and (ii).

[Rule 45bis.13, continued]

(c) The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: This differs from the proposal in Annex I by allowing the Authority to specify an earlier time limit than the one which would normally apply under Rule 45bis.1(b).]

Rules 53, 58, 66, 68; Schedule of Fees

[As in the proposals in Annex I]

[End of Annex II and of document]