

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

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

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

**Fourteenth Session
Geneva, February 5 to 7, 2007**

INTERNATIONAL SEARCH:
USE OF RESULTS OF EARLIER NATIONAL SEARCH

Document prepared by the Secretariat

SUMMARY

1. The Meeting is invited to discuss whether it would be desirable to amend the PCT Regulations so as to permit the applicant to request that the international search report be based on the results of an earlier search carried out by an Office other than that acting as the International Searching Authority, thereby extending the present possibility where an earlier search was carried out by the same Office.

BACKGROUND

2. At present, Rule 4.11 permits the applicant to request the International Searching Authority to base the international search report wholly or in part on the results of an earlier international or international-type search, or else on a search of another form (usually a national search) which had been carried out by the national Office or intergovernmental organization which is the International Searching Authority competent for the international application concerned, in which case the applicant may be eligible for a reduction in the international search fee under the conditions laid out in Rules 16.3 (earlier international search) and 41.1 (earlier international-type or national search). The making of such a request is provided for in Box No. VII of the Request Form PCT/RO/101 (extract below).

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Extract from Form PCT/RO/101 (Request)

Box No. VII INTERNATIONAL SEARCHING AUTHORITY		
Choice of International Searching Authority (ISA) (<i>if two or more International Searching Authorities are competent to carry out the international search, indicate the Authority chosen; the two-letter code may be used</i>):		
ISA /		
Request to use results of earlier search; reference to that search (<i>if an earlier search has been carried out by or requested from the International Searching Authority</i>):		
Date (<i>day/month/year</i>)	Number	Country (<i>for regional Office</i>)

3. In 2005, of the approximately 127,000 international applications that were the subject of international search, more than 50,000 claimed the priority of an earlier application filed with a national (or regional) Office different from the International Searching Authority that was to undertake the international search. In many of these cases, a national (or regional) search would be undertaken on the earlier application, and the applicant may even have received the search report before filing the international application. However, at present, the PCT Regulations do not provide for the applicant to request the International Searching Authority to take into account an earlier search performed by another Office different from that Authority.

SUBMISSION AND USE OF RESULTS OF EARLIER SEARCH

4. The International Bureau is, in line with paragraphs 26 and 27 of document PCT/A/35/5, considering submitting to the Working Group on Reform of the PCT a proposal to amend the PCT Regulations to extend the operation of Rules 4.11, 16.3 and 41.1 so as to permit applicants to request that the international search report be based on one or more searches performed by an Office other than the International Searching Authority that is to undertake the international search.

5. Noting that, in almost all cases, the earlier search would have been performed on an application which had not been published, the applicant would be required to provide a (simple) copy of the earlier search report to the International Searching Authority, probably via the receiving Office by furnishing it together with the request, or else authorize access to the record if suitable arrangements were in place between the relevant Offices. It is not envisaged that the applicant would be required to provide translations of the search report or copies of cited documents.

6. As is the case at present for basing the international search on an earlier search carried out by the same Office, it is envisaged that any refunds of the international search fee would be at the discretion of the International Searching Authority, depending on whether the earlier search was useful and under the conditions set out in the agreement between the Authority and the International Bureau.

7. The Meeting is invited to comment on the proposals outlined in this document.

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