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## INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

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

Fourteenth Session  
Geneva, February 5 to 7, 2007

#### SUPPLEMENTARY INTERNATIONAL SEARCHES

*Document prepared by the Secretariat*

#### SUMMARY

1. A proposal is presented comprising a flexible system for supplementary international searches, aimed at encouraging the use of the results of the main international search in assessing the extent of supplementary search which is required but not preventing the supplementary Authority from beginning its search before the main international search is complete, thereby avoiding difficulties in workflow.

#### TERMINOLOGY

2. In the main body of 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<sup>1</sup>;

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<sup>1</sup> 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.

*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;

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

## BACKGROUND

3. According to Article 15, 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 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 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 main Authority is not specialized and, even if the main 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 Authority which is competent for conducting the main search on 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, and 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 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 at the most previous sessions of the Meeting of International Authorities and the Working Group on the Reform of the PCT (“the Working Group”) 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.

8. The matter was discussed at the thirteenth session of the Meeting of International Authorities Under the PCT. The Meeting’s discussion of the proposals (see document PCT/MIA/13/8, paragraphs 26 to 33) is outlined in the following paragraphs:

*“Supplementary International Searches*

“26. Discussions were based on documents PCT/MIA/13/4 and PCT/R/WG/8/4. Document PCT/R/WG/8/4 set out two main alternatives: alternative I, under which supplementary searches would be available only after completion of the main international search (“sequential only system”), and alternative II, under which supplementary searches could be made available, at the option of each Authority performing such searches, either concurrently with or after completion of the main international search or both (“optional sequential/concurrent system”).

“27. After considerable discussion there remained, as on previous occasions, no consensus among Authorities as to the most desirable or appropriate approach to be taken on the question of supplementary international searches.

“28. The general idea of introducing a supplementary international search system was supported by eight Authorities and opposed by three Authorities. Reasons favoring introduction of the system are set out in document PCT/R/WG/8/4, and some delegations reiterated the strong desire of users for the introduction of such a system. Two of the Authorities opposing introduction stated their concern that the proposed system would represent a move away from the goal of a single search of high quality that could be accepted as sufficient by all designated Offices for the purposes of the national phase. The other felt that introduction would be premature at this stage, and expressed the view that the role of the PCT in the wider patent system was to provide a preliminary opinion which each designated Office could decide to supplement in the national phase by a further search as it found necessary.

“29. Alternative I (sequential only system) was supported by five Authorities, was the only alternative acceptable to two of the Authorities which would prefer that the system not be introduced at all, could be accepted by one Authority which preferred alternative II, and was opposed by three Authorities. Alternative II (optional sequential/concurrent system) was supported by three Authorities, could be accepted by one Authority which preferred alternative I, and was opposed by seven Authorities.

“30. Authorities preferring alternative I to alternative II considered that a sequential system would be simpler and would avoid duplication of work, both in examiner time and in terms of the general administration of the system. A number opposed

alternative II on the basis of their view that duplication of work would, in effect, be institutionalized if that alternative were to be adopted. Some expressed concern that confusion would arise from the inclusion in supplementary international search reports of views on the relevance of documents which differed from those appearing in the main international search report.

“31. Authorities preferring alternative II felt that it would provide more flexibility for each Authority to offer a service best suited to its particular circumstances, thus enabling more Authorities to participate in the system. They considered that the further (concurrent) option available under alternative II would not add significantly to the complexity of the system, but rather believed that more difficulties would arise under alternative I, particularly noting that many main international search reports are established late, which would lead to unacceptable delays in the issuance of sequential supplementary reports. They believed that there would be no more duplication of work or conflict in opinions than occurred at present between international search reports and subsequent national phase reports, but suggested that applicants would benefit from receiving supplementary reports at an earlier stage and crucially, the extremely tight time limit for completing the supplementary international search under alternative I would be avoided.

“32. A number of Authorities stated that progress on this matter would be highly desirable in view of the strong desire of applicant users for such a service.

“33. The following more specific comments were made on the draft Rules in Annexes I and II to document PCT/R/WG/8/4 and would be taken into account by the Secretariat in the event that further revised proposals were to be prepared following the eighth session of the Working Group:

“-- *Annex I*

“(a) *Rule 45bis*: It was observed that the draft Rules did not have the effect stated in paragraph 7(a). In fact, applicants would be permitted to request supplementary search of claims which had not been the subject of a main search for reasons other than a lack of unity of invention, provided that a main search report had been established for at least one claim. One Authority suggested that it would be useful for a supplementary search system to allow a full search to be carried out on claims where, due to subject matter restrictions, the main Authority had not carried out a search but another Authority would be prepared to do so.

“(b) *Rule 45bis.5(d)*: It seems necessary to address the case where the applicant did not provide sufficient supplementary search fees for the number of Authorities from which supplementary search had been requested, in addition to the case of insufficient additional supplementary search fees in cases of lack of unity of invention.

“(c) *Rule 45bis.11(b)*: In relation to a query from one Authority, it was indicated that the types of limitation set out were examples of conditions which could be placed in an agreement between the International Bureau and an Authority prepared to carry out supplementary international searches, rather than an exhaustive list.

“(d) *Rule 68.2(v)*: Further clarification may be desirable that, where supplementary search was carried out by an International Preliminary Examining Authority, the search would be made taking into account any amendments of the claims which were being considered as part of international preliminary examination and that the question of unity of invention in such cases would be governed by Rule 68.

“-- *Annex II*

“(e) *Rule 45bis.1*: One Authority agreed that, in a system where concurrent searches were possible, it seemed appropriate for the requests to be made to the supplementary Authority rather than to the International Bureau, but considered that this emphasized the disadvantages of concurrent searches since it would remove the benefit of the PCT system where, in general, requests and fees for a particular action could be provided by an applicant once, to a single point. To make requests to different Authorities would require more requests to be made, payments to be made in multiple currencies, the need for multiple checking for defects, with different times for response, and the International Bureau needing to deal with requests for document individually for different Authorities instead of preparing all the documents at the same time.

“(f) *Rule 45bis.1(e)*: The word “may” should be replaced by “shall” for situations where the request for supplementary search is made after the establishment of the international search report.

“(g) *Rule 45bis.3(c)*: One Authority considered that the proposals should permit the Authority to request payment of additional fees before the search is begun if insufficient fees had been paid, as would be done by the International Bureau under the proposals in Annex I. Furthermore, it should be clear that payment of the additional fees is mandatory in cases where the request is made after establishment of the international search report.

“(h) *Rule 45bis.8(a)*: One Authority commented that a reference to “Rule 40” was more appropriate than “Rule 40(i) and (ii)”, since the protest procedure was considered an important safeguard for applicants.

“(i) *Rule 45bis.9(a)*: One Authority considered that the period for establishing a supplementary search report should be three months from receipt of the required documents from the International Bureau, rather than three months from receipt of the request from the applicant. It also seemed inappropriate to set the same periods for establishing sequential and concurrent searches since it would permit an Authority to charge a higher fee for a concurrent search and nevertheless wait until after the main search report had been established to conduct the supplementary search.”

9. The discussions of the Working Group at its most recent session (see document PCT/R/WG/8/13, paragraphs 35 to 64) are outlined in the following paragraphs:

#### “SUPPLEMENTARY INTERNATIONAL SEARCHES

“35. Discussions were based on document PCT/R/WG/8/4.

*“General*

“36. A number of delegations emphasized that the international search was a central feature of the PCT system of great importance to national Offices, applicants and third parties, and stated that the proposed introduction of supplementary international searches should not be seen as an alternative to ensuring the quality and timing of the main international search.

“37. A few delegations were opposed to the introduction of a system of supplementary international searches.

“38. One delegation considered that the proposal would result in more complication and reduction in legal certainty than would be justified by the benefit.

“39. Another delegation considered that the proposal would result in duplication of work and an increase in workload and that ways should be sought to encourage acceptance of the results of the main search undertaken by a single International Searching Authority. In connection with language-related aspects of the proposals, the delegation made the observation that the Japan Patent Office now provided machine translation of all Japanese patent applications into English to facilitate searching. Furthermore, it suggested that in case of difficulties with documents in particular languages, International Authorities might partially outsource searches to other bodies with the necessary linguistic skills. However, a further delegation observed that translations were not available for all documents and that there were legal difficulties involved in outsourcing, for example, relating to the confidentiality of international applications.

“40. Another delegation, while considering a system of supplementary searches to be a good idea in principle, was concerned at the effect on the current workload of the International Authorities and on the timeliness and quality of search reports and international preliminary reports on patentability. This could add further strain to the current problem before some International Authorities and would be of concern to all those who relied on those reports. Consequently, the delegation considered that it was not an appropriate time to introduce such a system. Instead, the delegation felt that the Working Group should focus first on quality and having one good international search report for now.

“41. One representative of an intergovernmental organization suggested that search services for applicants would be better provided by the private sector than by introducing further complications in the PCT system itself.

“42. On the other hand, while many delegations sympathized with the desire for a single comprehensive search in principle, a large majority of delegations agreed that there was a practical difficulty in providing such a search. In view of the importance to users of an opportunity to gain a better knowledge of the prior art during the international phase, before it was necessary to make decisions and incur substantial costs associated with entry into the national phase, they considered that some form of system of supplementary international search was appropriate. Certain delegations representing smaller Offices indicated that the additional information from supplementary searches would increase the confidence of such Offices as designated Offices in the completeness of the search and thus foster greater acceptance of the

results of the international phase. It was observed that the system would be optional for International Authorities as well as applicants, and so need not affect the workloads of Authorities suffering from large backlogs of work.

“43. Amongst the delegations supporting a system of supplementary international searches, it was common ground that the system should allow for “sequential” supplementary searches, whereby the applicant could request an Authority to perform a search which took into account, at least to some extent, the results of the main international search which would already have been established. However, some delegations considered that sequential searches should be the only option permitted, whereas others considered that Authorities should have the option of offering “concurrent” supplementary searches to be performed before the main international search had been established, as an alternative to or in addition to sequential searches.

“44. In favor of sequential supplementary searches, some delegations suggested that these involved less complicated processes than concurrent searches and minimized the duplication of work in processing requests for them and in performing the searches. Furthermore, the fact that the main international search could be taken into account could promote work sharing and reduce the risk of conflicting reports on novelty, inventive step and unity of invention. The fact that the applicant would be able to see the main international search report before requesting a supplementary search would mean that supplementary searches would not be requested when the main international search report showed the claims to lack novelty or inventive step. It would be possible to focus the search on overcoming possible deficiencies in the main international search rather than repeating a search of material that had already been adequately considered. It was hoped that this might reduce the cost of supplementary searches compared to a more complete search. The knowledge of the prior art listed in the main international search report would minimize the risk that both the main and the supplementary search reports would list documents as category “A” (documents defining the general state of the art which are not considered to be of particular relevance) whereas if viewed together they might be seen to be category “Y” documents (documents relevant to inventive step when combined with one or more other such documents). While the relevance of the category “A” documents might later be discovered by large Offices conducting a thorough examination, this might well be missed by small and medium-sized Offices which relied more heavily on the international search reports.

“45. The main disadvantages of sequential searches were felt to be the reduced amount of time available to Authorities for establishing the supplementary search report compared to concurrent searches, and the risk that supplementary search reports might only be available very late indeed if, as was frequently the case at the present, the main international search report itself was delayed.

“46. In favor of concurrent supplementary searches, it was argued that the time pressures on Authorities would be significantly less than in sequential searches, potentially permitting more Authorities to participate if concurrent searches were an option. Furthermore, the supplementary search report would be available in time to be taken into account in deciding whether or not to make a demand for international preliminary examination. With respect to concerns about conflicts between reports from Authorities, it was observed that such conflicts would occur in any case during the national phase, and that it was better for the applicant to be aware of potential difficulties and alternative viewpoints at an earlier stage before the costs of national

phase entry had been incurred. Furthermore, since it was only proposed that a system of concurrent searches be introduced as part of a system which also permitted sequential searches, it would provide additional options to applicants, who could tailor their choices to their particular application strategy.

“47. With respect to the patent claims for which supplementary international searches could be requested, one delegation suggested that it might be desirable if the Authority performing a supplementary search could provide a full search of claims which had not been searched by the main Authority, for example because the subject matter was excluded by the main Authority but not by the supplementary Authority.

“48. A number of representatives of users urged the introduction of a system of supplementary international searches as soon as possible. Applicants had different needs and there were different views on what would be the ideal system. Sometimes applicants wanted as much information as possible as soon as possible. In other cases, additional searches would only be requested where a particular need was seen. Nevertheless, it was stated that the greatest costs and duplications occurred when new prior art was discovered in the national phase, resulting in multiple examinations raising unexpected objections. It was not seen as a duplication of work to request a search from a second Authority during the international phase if a corresponding search would in any case be carried out during the national phase, when the results would be of less benefit to the applicant. How matters of unity of invention were dealt with in respect of supplementary searches was seen by users as less of a concern. It was suggested that applicants might be permitted to request the targeting of particular supplementary searches towards particular matters, for example, on documents in a specified language. It was also suggested that Authorities performing supplementary searches might all be made aware of all the supplementary searches which had been requested, so that a collaborative search might be effected. Greater benefits were also seen for third parties if prior art was identified in the international phase.

“49. The Working Group agreed that the proposals relating to supplementary international searches be further developed and invited the Secretariat to prepare revised proposals for consideration at its next session, taking into account the discussion at the present session and particularly the comments and suggestions set out in the following paragraphs, as well as any further factors which may come to its attention in the meantime. Delegations and representatives were invited to make further observations and suggestions via the PCT reform electronic forum.

“50. In response to a question from a delegation, the Secretariat stated that, as presently drafted, the proposals would not allow applicants an additional opportunity to file amendments to the claims under Article 19 following the establishment of a supplementary international search report.

“51. One delegation emphasized the importance of making information concerning any supplementary searches easily available, including through the PatentScope website and on the International Application Status Form (Form PCT/IB/399).



*“Detailed Comments and Suggestions*

*“– Annex I of Document PCT/R/WG/8/4*

“52. The International Bureau indicated a number of minor changes that should be made to the proposals, including:

(a) clarification in *Rule 45bis.5* of the result of a request for supplementary search being made outside of the permitted time or not indicating a participating Authority;

(b) provision in *Rule 45bis.5(d)* for the case where the applicant did not provide sufficient supplementary search fees for the number of Authorities from which supplementary search had been requested, in addition to the case of insufficient additional supplementary search fees in cases of lack of unity of invention;

(c) provision in *Rule 45bis.6* for the case where some, but not all, of the claims were excluded from supplementary search by a limitation made under *Rule 45bis.11(b)*;

(d) the drafting in *Rule 45bis.10(b)* regarding how the supplementary international search report would be treated compared to a normal international search report.

“53. A number of delegations observed that the proposed *time limits for requesting and performing sequential supplementary searches* were based on the assumption that the main international search report would be established within, or at least close to the time limit set out in *Rule 42*, which was frequently not the case. Other delegations and representatives of users stated their hope that the large proportion of late international searches would be a temporary situation and considered that it was undesirable to complicate the proposal in response, though the latest statistics clearly indicated that the incidence of late international search reports had in some cases been rising in recent years, rather than declining. One delegation considered that the proposed time limits seemed a fair balance in any case since *Rule 42* allowed (in most cases) three months for the establishment of a complete international search report, so this ought to be sufficient for a supplementary search which might be of reduced scope.

“54. Several representatives of users reiterated that, usually, the most important issue would be to receive the supplementary international search report in time to make decisions relating to entry into the national phase, for example, by around 26 months from the priority date. It was less important to receive the information before the time limit for demanding international preliminary examination. As a result, a number of delegations considered that it might be appropriate to review the proposed time limit for establishing a supplementary international search, which could be as late as 28 months from the priority date. A representative of users also suggested that if Authorities were not capable of providing a supplementary search report within a time limit useful to applicants, the service would simply not be requested.

“55. In response to a query from a delegation, the Secretariat confirmed that, under the proposal in Annex I of document PCT/R/WG/8/4 (and similarly for sequential searches under the proposal in Annex II), a *protest* before the main International Searching Authority might result in a need for the supplementary Authority to refund fees to the applicant even if it had already started the supplementary search.

“56. One delegation considered that, despite any administrative convenience, it would be strange for an Authority to follow the opinion of another Authority concerning *unity of invention* for the purpose of supplementary search, only to take a different view at a later stage, for example as a designated Office. The delegation considered that each Authority should be permitted to examine the matter of unity of invention independently and should not be bound by any decision which it would not have made itself.

“57. It was observed that there was a contradiction between *Rules 45bis.5(d)* and *45bis.8(a)* with regard to how it should be decided which inventions should be searched in certain cases.

“58. One delegation considered that a supplementary search report would be more useful if it was not limited as proposed in *Rule 45bis.9(c)* so as to preclude, in most cases, the inclusion of documents which had been cited in the main international search report. It was observed that the supplementary Authority would in any case need to consider the documents cited by the main Authority in order to determine their relevance to inventive step and so it would not be a considerable burden to the examiner to cite the document fully if a further relevant, or even more relevant, passage was found or a different interpretation was given to the document.

“59. One representative of users expressed the hope that *fees* would not be set in such a manner that the cost of supplementary searches would be carried by applicants who did not choose to use the service.

“60. It was observed that several of the observations in paragraphs 52 to 59, above, were also applicable to equivalent provisions in Annex II of document PCT/R/WG/8/4.

“– *Annex II of Document PCT/R/WG/8/4*

“61. Further drafting changes set out in the report of the 13th session of the Meeting of International Authorities under the PCT should also be taken into account (see document PCT/MIA/13/8, paragraph 33(f) to (i)).

“62. One delegation recognized the reasons for which it had been proposed that requests under the proposals in Annex II of document PCT/R/WG/8/4 should be made to the individual supplementary Authorities, but considered that this emphasized the disadvantages of concurrent searches, since it would remove the benefit of the PCT system where, in general, requests and fees for a particular action could be provided by an applicant once, to a single point. To make requests to different Authorities would require more requests to be made, payments to be made in multiple currencies, and the requests to be checked for defects by each Authority, with different times for response. The International Bureau would also need to deal with requests for documents individually from different Authorities instead of preparing all the documents at the same time. As a consequence, a number of delegations considered that it might also be

appropriate for requests to be made to the International Bureau in the proposals in Annex II. One delegation suggested that requests for concurrent search could be included in the request and requests for sequential searches be made to the International Bureau, though it was observed that a number of receiving Offices had previously indicated that they would not wish to handle requests for supplementary search.

“63. In relation to *Rule 45bis.8(a)*, two delegations considered that a protest procedure in relation to any assessment of unity of invention by a Supplementary International Searching Authority would be a necessary safeguard, while one considered that it would be unnecessary.

“64. In relation to *Rule 45bis.9(a)*, two delegations were concerned that the same time limit had been proposed for the establishment of concurrent searches as for sequential searches. It was observed that one of the main perceived benefits of concurrent searches was that the supplementary search report could be received quickly, but this provision would permit that advantage to be lost. In order to ensure that applicants obtained this advantage, one delegation proposed that the time limit for establishment of a supplementary international search report be the same as the time limit under Rule 42.1 for establishment of the primary international search report.”

## PROPOSALS

10. Informal discussions since the 8th session of the Working Group have concentrated primarily on timing of the search and use of the results of the earlier search. Significantly, the European Patent Office (as has previously been noted) is concerned that waiting for the main search to be completed before the supplementary search is commenced will frequently mean that the supplementary search would need to be conducted within a relatively short timeframe. In order to ensure an orderly workflow having regard to the other duties of the Office, it considers that a time frame of 10 to 11 months would be required. On the other hand, the United States Patent and Trademark Office (in line with earlier comments by itself and by other Offices and Contracting States) is keen to avoid duplicative work between Offices and would therefore prefer a system where the main search was always established before the supplementary search and taken into account in conducting the supplementary search. Nevertheless, it recognizes that workflow may be a problem in cases where the main search is late and has indicated that it would be prepared to consider a system where it was possible to request and conduct a supplementary search before the main search was complete in some circumstances.

11. The Annex to this document contains proposals for amendments to the PCT Regulations, based on the general principle that the supplementary Authority should take the main search into account as far as possible but without a mandatory requirement to await completion of the main search before the supplementary search begins. Various possible timing options are provided for consideration of the most appropriate balance between applicant convenience, workflow of Authorities and minimizing duplication of work. Furthermore, the proposals leave the question of the definition of the scope of the supplementary search to the agreement between the supplementary Authority and the International Bureau.

12. The main features of the proposed supplementary search system are as follows:

(a) Authorities would be free to decide whether to provide a supplementary search service and, if so, under what conditions, to be set out in the agreement under Article 16(3) between the International Bureau and the Authority concerned. In that agreement, each Authority 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. Each Authority would also be free to specify in the agreement that it would not carry out a supplementary search where it had received, in respect of a particular international application, a demand for international preliminary examination. Where a demand for international preliminary examination is received by the Authority which has been requested to carry out a supplementary search, or where a request for supplementary search is made after a demand for international preliminary examination has been received by the Authority, the request for supplementary search would be considered not to have been made or, where applicable, at the option of the Authority concerned, be considered to be a request for supplementary search to take place as part of the international preliminary examination procedure; see Rule 53.2 as proposed to be amended).

(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 proposal is drafted in terms of the requests for supplementary international search being made through the International Bureau. The Meeting may wish to consider whether this remains appropriate in view of potential differences in handling depending on the requirements of different supplementary Authorities and the need for the applicant to communicate with the supplementary Authority in the case of additional fees, or whether the requests under such a system should rather be made directly to the supplementary Authority.

(d) With regard to the timing of filing a request for supplementary search, the Meeting may wish to consider: (i) whether there should be a specified earliest point in time as of when a request may be made and if so, which point in time that should be; and (ii) what the “outer” time limit for filing a request should be:

– *Should an earliest point in time be specified as of when a request for supplementary search may be made?* Highlighting the “supplementary” nature of the system, the Regulations could be drafted in a way which would ensure that, in the vast majority of cases, the main search report by the main Authority is available before the supplementary search by the supplementary Authority commences. For example, the Regulations could specify that a request for supplementary search may not be made before the expiration of one month after the date of transmittal of the international search report or after the expiration of 17 months from the priority date, whichever expires earlier. Alternatively, the Regulations could be drafted without specifying an earliest point in time as of when a request for supplementary search may be made but instead permit each supplementary Authority to provide that it will not commence with the supplementary search before it has received a copy of the main search report.

– *What should be the “outer” time limit for making a request for supplementary search?* Possible options include: (i) 22 months from the priority date, again highlighting the “supplementary” nature of the system, noting that, in the vast majority of cases, the main search report by the main Authority will be available within 22 months from the priority date and thus before the supplementary search by the supplementary Authority commences; (ii) 17 months from the priority date, putting more emphasis on the time available for the supplementary Authority to carry out the supplementary search rather than on the availability of the main search report. Alternatively, a late outer time limit (say, 22 months from the priority date) could be specified, while at the same time giving each supplementary Authority the freedom to fix a shorter time limit in respect of supplementary searches to be carried out by it.

(e) A supplementary search fee (for the benefit of the supplementary Authority) and a supplementary search handling fee (for the benefit of the International Bureau) must be paid within one month from the date of receipt by the International Bureau of the request for supplementary search.

(f) The International Bureau sends a copy of the international application and any other required documents to each supplementary Authority, including, in particular, a copy of the main search report and of the written opinion established by the main Authority, once these have been transmitted to the International Bureau.

(g) Supplementary search starts once the supplementary Authority is in possession of a copy of each of the following: the request for supplementary search, the international application and any required translation thereof, and any required sequence listing in electronic form. Depending on the question of the timing of filing a request for supplementary search (see paragraph (d), above), the Regulations could also provide that each supplementary Authority may also, at its option, require that a copy of the main search report and the written opinion by the main Authority be in its possession before it will start the supplementary search.

(h) Supplementary search is carried out on the basis of the international application as filed (or of a translation thereof), taking into account the main search report and the written opinion established by the main Authority under Rule 43*bis*.1, if transmitted to the supplementary Authority before it starts the supplementary search.

(i) With regard to the determination of unity of invention, the Meeting may wish to consider whether the supplementary Authority should make its own determination of unity of invention or whether the supplementary Authority should be bound by the views of the main Authority (if available to it when supplementary search is requested or, alternatively, commenced):

– should the Meeting agree that the supplementary Authority be permitted to make its own determination of unity of invention, it is proposed that the supplementary Authority would (similar to the procedure applied by the International Preliminary Examining Authority under Chapter II) request any additional fees which are required as a result of a non-unity finding and handle any protest by the applicant, but would be required to take into account any invitation issued by the main Authority during the main search to pay additional fees referred to in Article 17(3)(a) and any decision by the main Authority on any protest by the applicant under Rule 40.2(c), if transmitted to the supplementary Authority before it starts the

supplementary search; proposed draft amendments of the Regulations implementing this approach are included in the Annex for consideration (see proposed new Rule 45*bis*.8).

– should the Meeting agree that the supplementary Authority be bound by the views of the main Authority, the proposed draft amendments of the Regulations implementing this approach would be along the lines of the proposals contained in Annex II of document PCT/R/WG/8/4 (in particular, proposed new Rule 45*bis*.8); so as to make the draft amendments contained in the Annex to this document not too complex, those proposals have not been included again in that Annex, noting that, as a result of this approach, different arrangements for efficient processing would be required, along the lines of those presented in Annex II of document PCT/R/WG/8/4 (for example, with regard to the question where to file the request for supplementary search and with regard to the question of payment of additional search fees).

(j) Each supplementary Authority issues a supplementary search report. No written opinion is established under the supplementary search system, but the indications of relevant passages in the supplementary 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, the Authority likely to act as International Preliminary Examining Authority if a demand is submitted and many designated Offices.

(k) The Meeting may wish to consider whether the supplementary search report may cover inventions which are not made the subject of the main search.

(l) The Meeting may wish to consider whether re-citation of documents which appear in the main search report should be permitted in any case where the examiner considers that the relevance of the document is not fully stated by the main search report or should be limited to the case where the re-citation is necessary for the indication of inventive step issues in relation to the combination of that document with newly found citations.

(m) Supplementary search reports established during the Chapter I procedure 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 access to the main search report. Furthermore, each supplementary search report is automatically communicated to designated and elected Offices whenever the main search report is requested by such Office.

(n) Translations of supplementary international search reports are prepared by the International Bureau in the same cases as for the main international search report, that is, an English translation will be prepared of those reports which are not established in English.

(o) It is also proposed to provide for 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 the main Searching Authority. Supplementary searches performed during international preliminary examination 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.

13. A number of the detailed issues raised during the thirteenth session of the Meeting of International Authorities and the eighth session of the Working Group (see paragraphs 8 and 9, above) are not addressed in this document but will be considered in the proposals that will be presented to the Working Group, depending on recommendations from the Meeting with regard to the broad direction which is considered appropriate.

*14. The Meeting is invited to consider the proposals and issues contained in this document.*

[Annex follows]

## ANNEX

DRAFT AMENDMENTS OF THE PCT REGULATIONS:<sup>2</sup>

## SUPPLEMENTARY INTERNATIONAL SEARCHES

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<sup>2</sup> 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 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 International Searching Authorities, other than the Authority which carried out the international search under Article 16(1), which have agreed to carry out such supplementary international searches.

(b) A request referred to in paragraph (a) shall be made:

[...]

[COMMENT: see paragraph 12(d) in the main body of this document. The Meeting may wish to consider (i) whether there should be a specified earliest point in time as of when a request may be made and if so, which point in time that should be; and (ii) what the “outer” time limit for filing a request should be.]

(c) A request referred to in paragraph (a) made after the expiration of the time limit under paragraph (b) shall be considered not to have been made.

*[Rule 45bis.1, continued]*

(d) 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 and the agent if there is an agent, the title of the invention, the international filing date and the international application number;

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

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

*[Rule 45bis.1, continued]*

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

(i) any translation of the international application required under Rule 45bis.4;

(ii) a copy of any sequence listing in electronic form complying with the standard provided for in the Administrative Instructions whenever this is required, under Rules 13ter.1(a) and 45bis.7(b), by the Authority carrying out the supplementary international search.

[COMMENT: At present, the (main) 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 main 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.]

(f) The fees payable under Rules 45bis.2 and 45bis.3 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 the date of payment.

45bis.2 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:

(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 Rules 45bis.1(c) or 45bis.5(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 supplementary Authority, 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.3 Supplementary Search Fee

(a) Each Authority carrying out the supplementary international search may require that the applicant pay a fee (“supplementary search fee”) for its own benefit for carrying out a supplementary international search.

[COMMENT: The fees for searches of additional inventions are covered by Rule 45bis.8(a) and would be collected by the supplementary Authority.]

(b) The supplementary search fee shall be collected by the International Bureau.  
Rule 16.1(b) to (e) shall apply *mutatis mutandis*.

(c) 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.5(c) or Rule 45bis.6(b), not to have been made.

*[Rule 45bis.3, continued]*

[COMMENT: Draft Rule 45bis.3 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.]

45bis.4 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. Depending on the particular time limit decided for that request, this should not be an unreasonable burden, noting that, in most cases, 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.]

45bis.5 Acknowledgement of Receipt and Checking of 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(d) or any elements required under Rule 45bis.1(e) 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(f), the International Bureau finds that the fees under Rules 45bis.2 and 45bis.3 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 paragraph (a), furnish the required indications or elements or does not, before the expiration of the time limit under paragraph (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.

*[Rule 45bis.5, continued]*

(d) On finding that the requirements under Rules 45bis.1(d), (e) and (f) 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;

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

(iv) any translation furnished by the applicant under Rule 12.3, 12.4 or 45bis.4 which is to be used as the basis of the supplementary international search;

(v) the international search report and the written opinion established under Rule 43bis.1, once that report and that opinion have been transmitted to the International Bureau; and

[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.]



*[Rule 45bis.5(d), continued]*

(vi) any invitation by the International Searching Authority to pay additional fees referred to in Article 17(3)(a) and any decision on any protest by the applicant under Rule 40.2(c), once that invitation and that decision have been transmitted to the International Bureau.

45bis.6 Start of Supplementary International Search

(a) Subject to paragraph (b), the Authority requested to carry out a supplementary international search shall start that search promptly on receipt of the documents specified in Rule 45bis.5(d)(i) to (iv) and, at the option of that Authority, of the documents specified in Rule 45bis.5(d)(v).

(b) If the Authority requested to carry out a supplementary international search finds that such search would be excluded by a limitation made in accordance with Rule 45bis.11(b), 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.

[COMMENT: With regard to the applicant's right to a refund, see Rule 45bis.3(c)(ii), above.]

45bis.7 Basis and Scope 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 as referred to in Rule 45bis.1(d)(iii) or Rule 45bis.4, [with due regard to][giving full consideration to] the international search report and the written opinion established under Rule 43bis.1 where that report and opinion have been transmitted under Rule 45bis.5(d)(v) to the Authority carrying out the supplementary international search before that Authority starts the supplementary international search.

[COMMENT: In some cases, it would 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.]

(c) The supplementary international search shall cover at least the documentation indicated in the agreement between the Supplementary International Searching Authority and the International Bureau in accordance with Rule 45bis.11(a).

[COMMENT: The definition of the service provided would be left to the individual Authorities and applicants would be able to decide on the basis of this information whether they would find a particular service useful. The relevant information would be published in the PCT Gazette and the Applicant's Guide, as well as in any places decided by the supplementary Authority.]

45bis.8 Unity of Invention

[COMMENT: See paragraph 12(i) in the main body of this document. With regard to the determination of unity of invention, the Meeting may wish to consider whether the supplementary Authority should make its own determination of unity of invention or whether the supplementary Authority should be bound by the views of the main Authority (if available to it when supplementary search is requested or, alternatively, commenced). So as to make the draft amendments contained in this Annex not too complex, proposed draft amendments of the Regulations implementing the latter approach have not been included in this Annex; such amendments would be along the lines of the proposals contained in Annex II of document PCT/R/WG/8/4 (in particular, proposed new Rule 45bis.8), with consequential further changes, along the lines of those presented in Annex II of document PCT/R/WG/8/4, concerning issues such as the question where to file the request for supplementary search and the question of payment of additional search fees.

(a) If the Authority carrying out the supplementary international 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*.

(b) In considering whether the international application complies with the requirement of unity of invention, the Authority carrying out the supplementary international search shall give due regard to any invitation by the International Searching Authority that carried out the international search to pay additional fees referred to in Article 17(3)(a) and to any decision on any protest by the applicant under Rule 40.2(c) transmitted to the Authority carrying out the supplementary international search before that Authority starts the supplementary international search.

[COMMENT: The supplementary Authority would not be bound by any earlier decision, but it is highly desirable that a consistent approach is taken where this can be agreed.]

45bis.9 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.7(b) or (c) that no supplementary international search report will be established, within 28 months from the priority date.

[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.]

(c) The supplementary international search report [need][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.

*[Rule 45bis.9, continued]*

[COMMENT. See paragraph 12(k) in the main body of this document. The Meeting may wish to consider whether the supplementary search report may duplicate what appears in the main search report or whether such re-citations should be permitted but be limited to the case where this is necessary for the indication of inventive step issues in relation to newly found citations. The option of “need” would leave discretion for the examiner to include further information which he considers to be relevant in respect of a citation which he considers may have greater relevance than would be realized from the main international search report.]

45bis.10 *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.7(b) or (c) exists, to the International Bureau and one copy to the applicant.

(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

*[Rule 45bis.10(b), continued]*

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 into account the supplementary international search whenever possible, but should not delay the start of international preliminary examination to wait for them.]

45bis.11 *International Searching Authorities Prepared to Carry Out Supplementary International Search*

(a) If an International Searching Authority is prepared to carry out supplementary international searches, the documentation to be included in a supplementary international search and the conditions under which the Authority shall carry out supplementary international searches shall be set out in the agreement under Article 16(3)(a) between the Office or organization and the International Bureau.

*[Rule 45bis.11, continued]*

(b) The conditions referred to in paragraph (a) may include 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 to the carrying out of a supplementary international search where a demand for international preliminary examination has been submitted to it as the competent International Preliminary Examining Authority for the international application concerned.

[COMMENT: see paragraph 12(a) in the main body of this document. Authorities would be free to decide whether to provide a supplementary search service and, if so, under what conditions, to be set out in the agreement under Article 16(3) between the International Bureau and the Authority concerned. In that agreement, each Authority 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. Each Authority would also be free to specify in the agreement that it would not carry out a supplementary search where it had received, in respect of a particular international application, a demand for international preliminary examination. Were a demand for international preliminary examination is received by the Authority which has been requested to carry out a supplementary search, or where a request for supplementary search is made after a demand for international preliminary examination has been received by the Authority, the request for supplementary search would be considered not to have been made or, where applicable, at the option of the Authority concerned, be considered to be a request for supplementary search to take place as part of the international preliminary examination procedure; see Rule 53.2 as proposed to be amended).]

## Rule 53

### The Demand

53.1 [No change]

53.2 Mandatory and Optional Contents; Signature

[COMMENT: It is proposed to amend the heading to match that of Rule 4.1 since, with the introduction of optional contents, the subjects of the Rules would be equivalent.]

(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 Authority which carried out the international search and has agreed to carry out such searches.

(a-ter) Where, at the time that the demand is made, a request for supplementary international search under Rule 45bis.1 has been made to the Office which is acting as International Preliminary Examining Authority but no supplementary international search report has yet been established by that Office, the request for supplementary international search under Rule 45bis.1 shall be considered as having been made under paragraph (a-bis).

[COMMENT: This would allow the Authority to avoid the complication of dealing separately with the processes of supplementary search and international preliminary examination, noting that the amendments which would be included in the international preliminary examination would not be taken into account for the purposes of a separate search. Authorities which wish to offer the service of supplementary international search or international preliminary examination, but not both for the same application, would be permitted by Rule 45bis.11(b) to make this a condition of supplementary search.]



*[Rule 53.2, continued]*

(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 agreed 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 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.5(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 66.4*bis*, 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 66.4*bis*, 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*.5(c) and 45*bis*.11 shall apply *mutatis mutandis*.

[COMMENT: Supplementary international searches by the International Preliminary Examining Authority would be subject to the same possibility for limitations, such as in respect of subject matter for which the service is made available, as any other supplementary search. 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. Supplementary international searches performed at this stage would take into account any amendments which were under consideration as part of the international preliminary examination in accordance with Rule 66.1.]

66.2 to 66.9 [No change]

## Rule 68

### Lack of Unity of Invention

#### (International Preliminary Examination)

##### 68.1 *No Invitation to Restrict or Pay*

Where the International Preliminary Examining Authority considers ~~finds~~ that the requirement of unity of invention is not complied with and chooses not to invite the applicant to restrict the claims or to pay additional fees, it shall proceed with the international preliminary examination, subject to Article 34(4)(b) and Rule 66.1(e), in respect of the entire international application, but shall indicate, in any written opinion and in the international preliminary examination report, that it considers that the requirement of unity of invention is not fulfilled and it shall specify the reasons therefor.

##### 68.2 *Invitation to Restrict or Pay*

Where the International Preliminary Examining Authority considers ~~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;

*[Rule 68.2, continued]*

(v) where the applicant has requested a supplementary international search, indicate the amount of the required additional supplementary search fees to be paid in case the applicant so chooses; and

(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.

*68.2bis Invitation by International Searching Authority to Pay Additional Fees*

In considering whether the international application complies with the requirement of unity of invention, the International Preliminary Examining Authority shall give due regard to any invitation by the International Searching Authority that carried out the international search or a supplementary international search to pay additional fees referred to in Article 17(3)(a) and to any decision on any protest by the applicant under Rule 40.2(c) transmitted to the International Preliminary Examining Authority before it starts the international preliminary examination.

[COMMENT: This is not a direct consequence of supplementary international search, but is proposed for consistency with draft Rule 45bis.8(b) and good practice, as implied by paragraphs 10.71 to 10.73 of the PCT International Search and Preliminary Examination Guidelines.]



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 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.]

[End of Annex and of document]