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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)

Fifteenth Session
Vienna, April 7 to 9, 2008

USE OF SEARCHES BY OFFICES OTHER THAN THE ONE ACTING AS
INTERNATIONAL SEARCHING AUTHORITY

Document prepared by the Secretariat

SUMMARY

1. The Meeting is invited to note the effect of and actions which may be required from certain new Rules which come into force July 1, 2007, relating to the use of searches conducted by other Offices, and to consider what additional guidelines and collective action may be appropriate to make these Rules increasingly beneficial to applicants and Offices in the future.

BACKGROUND

2. At its 36th session in September–October 2007, the PCT Assembly adopted, with effect from July 1, 2008, a new PCT Rule 12*bis* and amendments to PCT Rules 4.12 (previously Rule 4.11(a)(i) and (ii)), 16.3 and 41, permitting applicants to request the International Searching Authority to take into account the results of an earlier search which has been carried out by an Office other than that which is acting as International Searching Authority, in addition to the existing possibility of basing the search on one which it had itself previously performed.

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3. The relevant new Rules are set out in Annex I for reference.
4. The Assembly also noted (see paragraph 137 of document PCT/A/36/13):
 - (i) in connection with the addition of new Rule 4.12, that an “earlier search” under that Rule includes an earlier search carried out under the responsibility of an Authority or Office which contracts out searches as well as a search carried out by an Authority or Office itself; and
 - (ii) in connection with the addition of new Rules 4.12(ii) and 12*bis*.1(e), that an international application is only considered to be “substantially the same” as the application in respect of which the earlier search was carried out (where applicable, except that the international application is filed in a different language) if both applications are the same in substance, including the inventions described and claimed; any changes may relate only to minor clerical or administrative matters, such as formatting, correction of minor errors, or inclusion or omission of matter not specific to the invention but which is required for applications in some States but not others (for example, details of public funding used in the development of the invention); any International Searching Authority would be free to require the applicant to clarify what the differences were between the international application and the earlier application concerned.
5. New and modified Forms relating to the amended Rules were proposed in Circular C. PCT 1132, dated February 21, 2008. Relevant extracts are reproduced in Annex II.
6. These Rules use a term “take into account”, which was not the subject of any note or understanding by the Assembly, but which was understood by the Working Group on Reform of the PCT as follows (see paragraph 134 of document PCT/R/WG/9/8):

“134. After some discussion, it was agreed that, throughout the proposed amendments of the Regulations, the term “take into account” (the results of an earlier search) should be retained and not replaced by another term such as “use”, “consider”, or “base ... on”. The term “take into account” was to be understood as meaning that the International Searching Authority found the results of the earlier search useful and beneficial for the purposes of establishing the international search report, as distinct from merely reading, studying or considering the results of the earlier search.”
7. The long-term aim of these rules is to promote work-sharing between Offices such that earlier work is taken into account in a manner which reduces the work burden of the International Searching Authority or increases the quality of the international search report which is established. Preferably both objectives should be achieved and the system should never be used to the detriment of quality. However, as was pointed out by several Offices in the Working Group on Reform of the PCT, work-sharing between Offices is still at an early stage. Quality systems and search results vary widely between examining Offices.

8. Various pilot schemes are studying how best to use the results of search and examination work which have been performed elsewhere, including the Utilization Pilot Project in the context of the European Patent Network and various projects led by the Trilateral Offices (European Patent Office, Japan Patent Office and United States Patent and Trademark Office) and it is expected that understanding of how to use reports from different Offices effectively will increase over time. Consequently, the rules were written to allow a large amount of flexibility for International Authorities, so that use of work carried out in other Offices could begin quickly, without tying Authorities down to assumptions on practice which may prove inappropriate in the future.

EFFECTS ON INTERNATIONAL SEARCHING AUTHORITIES

Procedural Issues

9. The applicant has a right under Rule 4.12 to indicate that he wishes the International Searching Authority to take into account an earlier search, irrespective of whether it was carried out by that Office or by another Office. Consequently, receiving Offices are likely to begin to receive copies of earlier search reports or other documents listing prior art cited by other Offices (or requests to provide copies of such documents from the files of the receiving Office), and these will be forwarded to the International Searching Authority together with the search copy. The International Searching Authority may also be requested to retrieve copies of earlier searches from their own files or digital libraries but, for the present, this will usually only be relevant to the existing case where the Authority itself carried out the earlier search.

10. Rule 12*bis* gives the International Searching Authority the right to invite the applicant to furnish other documents, such as a copy of the earlier application or translations of the application or search report. A new Form PCT/ISA/238 was proposed in Annex III to Circular C. PCT 1132 and is reproduced in Annex II. Although not specifically provided for in the Rules, it is likely that some such documents will also be provided by the applicant to the receiving Office at the outset in some cases, particularly if it is apparent that the particular International Searching Authority will require them. It is intended to provide in the Receiving Office Guidelines that such documents should be forwarded to the International Searching Authority with the search copy.

Use of the Earlier Search

11. According to Rule 41.1, the International Searching Authority is only obliged to take into account earlier reports for which it carried out the search itself (whether in its capacity as an International Searching Authority or otherwise). For other reports, it has complete discretion over the extent to which they will be used. However, it will receive search reports from the receiving Office and, as a minimum, it is hoped that the examiner will review the earlier search report to see whether the fields of search and cited documents are relevant and whether they provide inspiration for databases, classification terms or terms of art which may be of use in improving the quality of the international search which is conducted. Whether the results of the search can be taken into account in the sense described under paragraph 6, above, producing a significantly higher quality result or else significantly reducing the amount of searching required without lowering the quality of result, will depend on the policy of the Authority and the extent to which the examiner considers the results useful in the particular circumstances.

12. It is hoped that Authorities will analyse their experiences of the use of searches carried out by other Offices (both under the PCT and during national work-sharing systems) so that future sessions of this Meeting may be able to share experience of how to make use of these details effectively and to consider what might be done to make the system more useful, such as development of common standards in reporting the results of searches, or improved access to search strategies.

13. Draft modifications to the PCT International Search and Examination Guidelines are set out in Annex III.

Fee Issues

14. At present, each agreement between the International Bureau and an International Searching Authority (except for that with the United States Patent and Trademark Office) has a provision in Part II of Annex C indicating what refund is given in the event of the Authority benefiting from an earlier search. In some cases, there are differing amounts stated depending on the extent to which the examiner considers that the Authority has benefited.

15. Most of these refunds are stated in terms of “Where the Authority benefits from an earlier search ...”, without stating that the earlier search had to be one which had been conducted by that Office – such a statement was irrelevant since the applicant was not permitted to request the Authority (in the terms of the Rules prior to amendment) to base the international search on any other type of search. For Authorities whose agreements are set out in this way, the refunds will (to the extent that the search is taken into account) equally apply, irrespective of the Office which carried out the earlier search, with effect from July 1, 2007. If a different approach is intended (for example, to offer larger discounts where the earlier search was carried out by the same Office than where it was carried out by a different Office), it will be necessary to amend the relevant provision in the agreement.

16. On the other hand, the agreements with the European Patent Office, the Spanish Patent and Trademark Office, the National Board of Patents and Registration of Finland, and the Federal Service for Intellectual Property, Patents and Trademarks (Russian Federation) include specific statements that the refunds apply only in the case of searches carried out by those Offices. In these cases, it will be necessary to amend the agreements if it is desired to offer refunds where the Authority takes into account earlier searches conducted by other Offices.

17. Ideally, these provisions in the agreements should be modified to use the terms of the new wording of Rule 16.3, preferably in as consistent a manner as possible between Authorities. Possible examples might include:

“Where the Authority takes into account, under Rule 41.1, the results of an earlier search, 25% or 50% of the search fee shall be refunded, depending on the extent to which the Authority benefits from that earlier search.”

or

“Where the Authority takes into account, under Rule 41.1, the results of an earlier search:

“(i) 50% of the search fee shall be refunded if the earlier search was carried out by the Authority; or

“(ii) 25% of the search fee shall be refunded if the earlier search was carried out by any other Office.”

18. Ideally, any difference between amounts of refund should be appropriate to the differences in benefit which are found, for example because where the Authority conducted the earlier search itself, it has access to fuller records in a format completely familiar to the examiner (who may even be the examiner who conducted the earlier search).

19. In view of the fact that the effect remains clear irrespective of the exact wording, immediate amendment appears only to be necessary if it is desired to change the amount of refund which will apply, or to introduce the ability to offer refunds which would otherwise be excluded for the case of earlier searches conducted by other Offices. Given that in many cases the refunds are stated in terms taken from national legislation which requires approval by a parliament or governing body, it is likely that changes simply to follow the wording of the new Rules will only be worth pursuing in conjunction with substantive changes to the particular International Authority's fees.

20. Where a change is needed to reduce the refund which will be available for taking into account a search which is carried out by another Office, it will be necessary to notify the Director General in accordance with Articles 11(3) and (4) by June 1, 2008 in order for the change to be effective for international applications filed from July 1, 2008. In principle, amendments increasing the refund available could be made at any time before July 1, 2008, though in practice a month's notice is highly desirable so that the changes can be published in the PCT Gazette and Applicant's Guide before coming into force.

21. *The Meeting is invited:*

(i) to note the effects of the new Rules on International Searching Authorities and their agreements with the International Bureau;

(ii) to comment on the draft modifications to the Forms set out in Annex II and the PCT International Search and Examination Guidelines set out in Annex III; and

(iii) to consider whether any further Administrative Instructions, guidelines or development of common approaches may be appropriate.

[Annexes follow]

ANNEX I

RELEVANT NEW AND AMENDED RULES

Rule 4
The Request (Contents)

4.1 to 4.11 [Not relevant]

4.12 *Taking into Account Results of Earlier Search*

If the applicant wishes the International Searching Authority to take into account, in carrying out the international search, the results of an earlier international, international-type or national search carried out by the same or another International Searching Authority or by a national Office (“earlier search”):

(i) the request shall so indicate and shall specify the Authority or Office concerned and the application in respect of which the earlier search was carried out;

(ii) the request may, where applicable, contain a statement to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language.

4.13 to 4.19 [Not relevant]

Rule 12bis
Copy of Results of Earlier Search
and of Earlier Application; Translation

12bis.1 Copy of Results of Earlier Search and of Earlier Application; Translation

(a) Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search carried out by the same or another International Searching Authority or by a national Office, the applicant shall, subject to paragraphs (c) to (f), submit to the receiving Office, together with the international application, a copy of the results of the earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are presented by the Authority or Office concerned.

[Rule 12bis.1, continued]

(b) The International Searching Authority may, subject to paragraphs (c) to (f), invite the applicant to furnish to it, within a time limit which shall be reasonable under the circumstances:

(i) a copy of the earlier application concerned;

(ii) where the earlier application is in a language which is not accepted by the International Searching Authority, a translation of the earlier application into a language which is accepted by that Authority;

(iii) where the results of the earlier search are in a language which is not accepted by the International Searching Authority, a translation of those results into a language which is accepted by that Authority;

(iv) a copy of any document cited in the results of the earlier search.

(c) Where the earlier search was carried out by the same Office as that which is acting as the receiving Office, the applicant may, instead of submitting the copies referred to in paragraphs (a) and (b)(i) and (iv), indicate the wish that the receiving Office prepare and transmit them to the International Searching Authority. Such request shall be made in the request and may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee.

(d) Where the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, no copy or translation referred to in paragraphs (a) and (b) shall be required to be submitted under those paragraphs.

(e) Where the request contains a statement under Rule 4.12(ii) to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language, no copy or translation referred to in paragraphs (b)(i) and (ii) shall be required to be submitted under those paragraphs.

(f) Where a copy or translation referred to in paragraphs (a) and (b) is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library or in the form of the priority document, and the applicant so indicates in the request, no copy or translation shall be required to be submitted under those paragraphs.

Rule 16
The Search Fee

16.1 and 16.2 [Not relevant]

16.3 *Partial Refund*

Where the International Searching Authority takes into account, under Rule 41.1, the results of an earlier search in carrying out the international search, that Authority shall refund the search fee paid in connection with the international application to the extent and under the conditions provided for in the agreement under Article 16(3)(b).

Rule 41
Taking into Account Results of Earlier Search

41.1 *Taking into Account Results of Earlier Search*

Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search and has complied with Rule 12*bis*.1 and:

(i) the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, the International Searching Authority shall, to the extent possible, take those results into account in carrying out the international search;

(ii) the earlier search was carried out by another International Searching Authority, or by an Office other than that which is acting as the International Searching Authority, the International Searching Authority may take those results into account in carrying out the international search.

[Annex II follows]

ANNEX II

EXTRACTS FROM PROPOSED NEW AND MODIFIED FORMS

CONTENTS

PCT/RO/101 (Request)	
Box No. VII (International Searching Authority; Use of Results of Earlier Search)	2
Box No. IX (Checklist; Language of Filing)	3
PCT/ISA/210 (International Search Report)	
Item 1 (Basis of the Report).....	4
Second Sheet [No change] (Fields Searched).....	5
PCT/ISA/238 (Invitation to Furnish Documents in Connection with Earlier Search).....	6

Sheet No. _____

Box No. VII INTERNATIONAL SEARCHING AUTHORITY; USE OF RESULTS OF EARLIER SEARCH		
<p>Choice of International Searching Authority (ISA) (if more than one International Searching Authority is competent to carry out the international search, indicate the Authority chosen; the two-letter code may be used): ISA/</p>		
<p><input type="checkbox"/> Request to use results of earlier search; reference to that search (if one or more earlier searches have been carried out) the ISA indicated above is requested to take into account the results of the earlier search(es) indicated below (See also Notes to Box VII: use of results of more than two earlier searches):</p>		
Date (day/month/year)	Number	Country (or regional Office)
<p><input type="checkbox"/> Statement (Rule 4.12(ii)): this international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, except, where applicable, that it is filed in a different language.</p>		
<p><input type="checkbox"/> Availability of documents: the following documents are available to the ISA in a form and manner acceptable to it and therefore do not need to be submitted by the applicant to the ISA (Rule 12bis 1(f)):</p>		
<p><input type="checkbox"/> a copy of the results of the earlier search,*</p>		
<p><input type="checkbox"/> a copy of the earlier application,</p>		
<p><input type="checkbox"/> a translation of the earlier application into a language which is accepted by the ISA,</p>		
<p><input type="checkbox"/> a translation of the results of the earlier search into a language which is accepted by the ISA,</p>		
<p><input type="checkbox"/> a copy of any document cited in the results of the earlier search (If known, please indicate below which document is available to the ISA):</p>		
<p><input type="checkbox"/> Transmit copy of results of earlier search and other documents (where the earlier search was not carried out by the ISA indicated above but by the same Office as that which is acting as the receiving Office): the receiving Office is requested to prepare and transmit to the ISA (Rule 12bis 1(c)):</p>		
<p><input type="checkbox"/> a copy of the results of the earlier search,*</p>		
<p><input type="checkbox"/> a copy of the earlier application,</p>		
<p><input type="checkbox"/> a copy of any document cited in the results of the earlier search.</p>		
<p>* Where the results of the earlier search are neither available from a digital library nor transmitted by the receiving Office, the applicant is required to submit them to the receiving Office (Rule 12bis 1(a)) (See item 11 in the check-list and also Notes to Box No. VII).</p>		
Date (day/month/year)	Number	Country (or regional Office)
<p><input type="checkbox"/> Statement (Rule 4.12(ii)): this international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, except, where applicable, that it is filed in a different language.</p>		
<p><input type="checkbox"/> Availability of documents: the following documents are available to the ISA in a form and manner acceptable to it and therefore do not need to be submitted by the applicant to the ISA (Rule 12bis 1(f)):</p>		
<p><input type="checkbox"/> a copy of the results of the earlier search,*</p>		
<p><input type="checkbox"/> a copy of the earlier application,</p>		
<p><input type="checkbox"/> a translation of the earlier application into a language which is accepted by the ISA,</p>		
<p><input type="checkbox"/> a translation of the results of the earlier search into a language which is accepted by the ISA,</p>		
<p><input type="checkbox"/> a copy of any document cited in the results of the earlier search (If known, please indicate below which document is available to the ISA):</p>		
<p><input type="checkbox"/> Transmit copy of results of earlier search and other documents (where the earlier search was not carried out by the ISA indicated above but by the same Office as that which is acting as the receiving Office): the receiving Office is requested to prepare and transmit to the ISA (Rule 12bis 1(c)):</p>		
<p><input type="checkbox"/> a copy of the results of the earlier search,*</p>		
<p><input type="checkbox"/> a copy of the earlier application,</p>		
<p><input type="checkbox"/> a copy of any document cited in the results of the earlier search.</p>		
<p>* Where the results of the earlier search are neither available from a digital library nor transmitted by the receiving Office, the applicant is required to submit them to the receiving Office (Rule 12bis 1(a)) (See item 11 in the check-list and also Notes to Box No. VII).</p>		
Box No. VIII DECLARATIONS		
<p>The following declarations are contained in Boxes Nos. VIII (i) to (v) (mark the applicable check-boxes below and indicate in the right column the number of each type of declaration):</p>		Number of declarations
<input type="checkbox"/> Box No. VIII (i)	Declaration as to the identity of the inventor	:
<input type="checkbox"/> Box No. VIII (ii)	Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent	:
<input type="checkbox"/> Box No. VIII (iii)	Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application	:
<input type="checkbox"/> Box No. VIII (iv)	Declaration of inventorship (only for the purposes of the designation of the United States of America)	:
<input type="checkbox"/> Box No. VIII (v)	Declaration as to non-prejudicial disclosures or exceptions to lack of novelty	:

Sheet No.

Box No. IX CHECK LIST; LANGUAGE OF FILING																																																							
<p>This international application contains:</p> <p>(a) on paper, the following number of sheets:</p> <p style="padding-left: 20px;">request (including declaration and supplemental sheets) : _____</p> <p style="padding-left: 20px;">description (excluding sequence listing and/or tables related thereto) : _____</p> <p style="padding-left: 20px;">claims : _____</p> <p style="padding-left: 20px;">abstract : _____</p> <p style="padding-left: 20px;">drawings : _____</p> <p style="padding-left: 20px;">Sub-total number of sheets : _____</p> <p style="padding-left: 20px;">sequence listing : _____</p> <p style="padding-left: 20px;">tables related thereto : _____</p> <p style="padding-left: 20px;"><i>(for both, actual number of sheets if filed on paper, whether or not also filed in electronic form; see (c) below)</i></p> <p style="padding-left: 20px;">Total number of sheets : _____</p> <p>(b) <input type="checkbox"/> only in electronic form (Section 801(a)(i))</p> <p style="padding-left: 20px;">(i) <input type="checkbox"/> sequence listing</p> <p style="padding-left: 20px;">(ii) <input type="checkbox"/> tables related thereto</p> <p>(c) <input type="checkbox"/> also in electronic form (Section 801(a)(ii))</p> <p style="padding-left: 20px;">(i) <input type="checkbox"/> sequence listing</p> <p style="padding-left: 20px;">(ii) <input type="checkbox"/> tables related thereto</p> <p>Type and number of carriers (diskette, CD-ROM, CD-R or other) on which are contained the</p> <p style="padding-left: 20px;"><input type="checkbox"/> sequence listing:</p> <p style="padding-left: 20px;"><input type="checkbox"/> tables related thereto:</p> <p style="padding-left: 20px;"><i>(additional copies to be indicated under items 9(ii) and/or 10(ii), in right column)</i></p>	<p>This international application is accompanied by the following item(s) <i>(mark the applicable check-boxes below and indicate in right column the number of each item)</i>:</p> <table style="width:100%; border-collapse: collapse;"> <tr> <td style="width: 5%;">1. <input type="checkbox"/></td> <td style="width: 85%;">fee calculation sheet</td> <td style="width: 10%; text-align: right;">:</td> </tr> <tr> <td>2. <input type="checkbox"/></td> <td>original separate power of attorney</td> <td style="text-align: right;">:</td> </tr> <tr> <td>3. <input type="checkbox"/></td> <td>original general power of attorney</td> <td style="text-align: right;">:</td> </tr> <tr> <td>4. <input type="checkbox"/></td> <td>copy of general power of attorney; reference number, if any:</td> <td style="text-align: right;">:</td> </tr> <tr> <td>5. <input type="checkbox"/></td> <td>statement explaining lack of signature</td> <td style="text-align: right;">:</td> </tr> <tr> <td>6. <input type="checkbox"/></td> <td>priority document(s) identified in Box No. VI as item(s):</td> <td style="text-align: right;">:</td> </tr> <tr> <td>7. <input type="checkbox"/></td> <td>translation of international application into <i>(language)</i>:</td> <td style="text-align: right;">:</td> </tr> <tr> <td>8. <input type="checkbox"/></td> <td>separate indications concerning deposited microorganism or other biological material</td> <td style="text-align: right;">:</td> </tr> <tr> <td>9. <input type="checkbox"/></td> <td>sequence listing in electronic form <i>(indicate type and number of carriers)</i></td> <td style="text-align: right;">:</td> </tr> <tr> <td style="padding-left: 20px;">(i) <input type="checkbox"/></td> <td>copy submitted for the purposes of international search under Rule 13ter only (and not as part of the international application) :</td> <td style="text-align: right;">:</td> </tr> <tr> <td style="padding-left: 20px;">(ii) <input type="checkbox"/></td> <td><i>(only where check-box (b)(i) or (c)(i) is marked in left column)</i> additional copies including, where applicable, the copy for the purposes of international search under Rule 13ter</td> <td style="text-align: right;">:</td> </tr> <tr> <td style="padding-left: 20px;">(iii) <input type="checkbox"/></td> <td>together with relevant statement as to the identity of the copy or copies with the sequence listing mentioned in left column</td> <td style="text-align: right;">:</td> </tr> <tr> <td>10. <input type="checkbox"/></td> <td>tables in electronic form related to sequence listing <i>(indicate type and number of carriers)</i></td> <td style="text-align: right;">:</td> </tr> <tr> <td style="padding-left: 20px;">(i) <input type="checkbox"/></td> <td>copy submitted for the purposes of international search under Section 802(b-<i>quater</i>) only (and not as part of the international application)</td> <td style="text-align: right;">:</td> </tr> <tr> <td style="padding-left: 20px;">(ii) <input type="checkbox"/></td> <td><i>(only where check-box (b)(ii) or (c)(ii) is marked in left column)</i> additional copies including, where applicable, the copy for the purposes of international search under Section 802(b-<i>quater</i>)</td> <td style="text-align: right;">:</td> </tr> <tr> <td style="padding-left: 20px;">(iii) <input type="checkbox"/></td> <td>together with relevant statement as to the identity of the copy or copies with the tables mentioned in left column</td> <td style="text-align: right;">:</td> </tr> <tr> <td>11. <input type="checkbox"/></td> <td>copy of results of earlier search(es) (Rule 12bis 1(a))</td> <td style="text-align: right;">:</td> </tr> <tr> <td>12. <input type="checkbox"/></td> <td>other <i>(specify)</i>:</td> <td style="text-align: right;">:</td> </tr> </table>	1. <input type="checkbox"/>	fee calculation sheet	:	2. <input type="checkbox"/>	original separate power of attorney	:	3. <input type="checkbox"/>	original general power of attorney	:	4. <input type="checkbox"/>	copy of general power of attorney; reference number, if any:	:	5. <input type="checkbox"/>	statement explaining lack of signature	:	6. <input type="checkbox"/>	priority document(s) identified in Box No. VI as item(s):	:	7. <input type="checkbox"/>	translation of international application into <i>(language)</i> :	:	8. <input type="checkbox"/>	separate indications concerning deposited microorganism or other biological material	:	9. <input type="checkbox"/>	sequence listing in electronic form <i>(indicate type and number of carriers)</i>	:	(i) <input type="checkbox"/>	copy submitted for the purposes of international search under Rule 13ter only (and not as part of the international application) :	:	(ii) <input type="checkbox"/>	<i>(only where check-box (b)(i) or (c)(i) is marked in left column)</i> additional copies including, where applicable, the copy for the purposes of international search under Rule 13ter	:	(iii) <input type="checkbox"/>	together with relevant statement as to the identity of the copy or copies with the sequence listing mentioned in left column	:	10. <input type="checkbox"/>	tables in electronic form related to sequence listing <i>(indicate type and number of carriers)</i>	:	(i) <input type="checkbox"/>	copy submitted for the purposes of international search under Section 802(b- <i>quater</i>) only (and not as part of the international application)	:	(ii) <input type="checkbox"/>	<i>(only where check-box (b)(ii) or (c)(ii) is marked in left column)</i> additional copies including, where applicable, the copy for the purposes of international search under Section 802(b- <i>quater</i>)	:	(iii) <input type="checkbox"/>	together with relevant statement as to the identity of the copy or copies with the tables mentioned in left column	:	11. <input type="checkbox"/>	copy of results of earlier search(es) (Rule 12bis 1(a))	:	12. <input type="checkbox"/>	other <i>(specify)</i> :	:
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(iii) <input type="checkbox"/>	together with relevant statement as to the identity of the copy or copies with the sequence listing mentioned in left column	:																																																					
10. <input type="checkbox"/>	tables in electronic form related to sequence listing <i>(indicate type and number of carriers)</i>	:																																																					
(i) <input type="checkbox"/>	copy submitted for the purposes of international search under Section 802(b- <i>quater</i>) only (and not as part of the international application)	:																																																					
(ii) <input type="checkbox"/>	<i>(only where check-box (b)(ii) or (c)(ii) is marked in left column)</i> additional copies including, where applicable, the copy for the purposes of international search under Section 802(b- <i>quater</i>)	:																																																					
(iii) <input type="checkbox"/>	together with relevant statement as to the identity of the copy or copies with the tables mentioned in left column	:																																																					
11. <input type="checkbox"/>	copy of results of earlier search(es) (Rule 12bis 1(a))	:																																																					
12. <input type="checkbox"/>	other <i>(specify)</i> :	:																																																					
Figure of the drawings which should accompany the abstract:	Language of filing of the international application:																																																						
Box No. X SIGNATURE OF APPLICANT, AGENT OR COMMON REPRESENTATIVE																																																							
<i>Next to each signature, indicate the name of the person signing and the capacity in which the person signs (if such capacity is not obvious from reading the request).</i>																																																							
For receiving Office use only																																																							
1. Date of actual receipt of the purported international application:	2. Drawings: <input type="checkbox"/> received: <input type="checkbox"/> not received:																																																						
3. Corrected date of actual receipt due to later but timely received papers or drawings completing the purported international application:																																																							
4. Date of timely receipt of the required corrections under PCT Article 11(2):																																																							
5. International Searching Authority (if two or more are competent): ISA /																																																							
6. <input type="checkbox"/> Transmittal of search copy delayed until search fee is paid																																																							
For International Bureau use only																																																							
Date of receipt of the record copy by the International Bureau:																																																							

PATENT COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference	FOR FURTHER ACTION	see Form PCT/ISA/220 as well as, where applicable, item 5 below.
International application No.	International filing date (<i>day/month/year</i>)	(Earliest) Priority Date (<i>day/month/year</i>)
Applicant		

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of _____ sheets.

It is also accompanied by a copy of each prior art document cited in this report.

1. **Basis of the report**

a. With regard to the **language**, the international search was carried out on the basis of:

the international application in the language in which it was filed.

a translation of the international application into _____ which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).

b. This international search report has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43.6bis(a)).

c. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, see Box No. I.

d. This Authority, following the applicant's request, has taken into account the results of (an) earlier search(es) (Rules 4.12, 12bis.1 and 41.1)

2. **Certain claims were found unsearchable** (see Box No. II).

3. **Unity of invention is lacking** (see Box No. III).

4. With regard to the **title**,

the text is approved as submitted by the applicant.

the text has been established by this Authority to read as follows:

5. With regard to the **abstract**,

the text is approved as submitted by the applicant.

the text has been established, according to Rule 38.2, by this Authority as it appears in Box No. IV. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. With regard to the **drawings**,

a. the figure of the **drawings** to be published with the abstract is Figure No. _____

as suggested by the applicant.

as selected by this Authority, because the applicant failed to suggest a figure.

as selected by this Authority, because this figure better characterizes the invention.

b. none of the figures is to be published with the abstract.

INTERNATIONAL SEARCH REPORT

International application No.

A. CLASSIFICATION OF SUBJECT MATTER		
According to International Patent Classification (IPC) or to both national classification and IPC		
B. FIELDS SEARCHED		
Minimum documentation searched (classification system followed by classification symbols)		
Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched		
Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)		
C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
<input type="checkbox"/> Further documents are listed in the continuation of Box C. <input type="checkbox"/> See patent family annex.		
* Special categories of cited documents: "A" document defining the general state of the art which is not considered to be of particular relevance "E" earlier application or patent but published on or after the international filing date "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified) "O" document referring to an oral disclosure, use, exhibition or other means "P" document published prior to the international filing date but later than the priority date claimed "T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone "Y" document of particular relevance; 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 "&" document member of the same patent family		
Date of the actual completion of the international search	Date of mailing of the international search report	
Name and mailing address of the ISA/	Authorized officer	
Facsimile No.	Telephone No.	

PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

To:

PCT
INVITATION TO FURNISH
DOCUMENTS IN CONNECTION
WITH EARLIER SEARCH

(PCT Rule 12bis.1(b))

	Date of mailing <i>(day/month/year)</i>
Applicant's or agent's file reference	REPLY DUE within _____ month/days from the above date of mailing
International application No.	International filing date <i>(day/month/year)</i>
Applicant	

1. The applicant has requested, by marking the request form accordingly (see Box No. VII of Form PCT/RO/101), that this International Searching Authority take into account the results of an earlier search carried out by another International Searching Authority or a national Office (Rule 4.12). Moreover, where applicable, even though the applicant had marked certain documents as being available to this International Searching Authority, they are in fact not available in a form and manner acceptable to this Authority.

2. The applicant is hereby **invited**, within the prescribed time limit indicated above, to furnish this Authority with:

- a copy of the earlier application,
- a translation of the earlier application into the following language _____ which is accepted by this Authority,
- a translation of the results of the earlier search into the following language _____ which is accepted by this Authority,
- a copy of all, or certain documents, listed below in 4. *Further observations*, cited in the results of the earlier search.

3. **Failure to comply with this invitation** may result in this Authority not taking into account the results of the earlier search as requested by the applicant in the request form.

4. Further observations (*if necessary*):

Name and mailing address of the ISA/ Facsimile No.	Authorized officer Telephone No.
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ANNEX III

DRAFT MODIFIED GUIDELINES

PART IV
THE INTERNATIONAL SEARCH

Chapter 15
The International Search

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Basis of the Search

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Rules 4.12 and 12bis

15.13.1 The applicant may request the International Searching Authority to take into account the results of an earlier search carried out by that Office or by another Office. In this case, either a copy of the earlier search report (or other document listing cited prior art) will be sent by the receiving Office with the search copy, or else the International Searching Authority will be requested to retrieve a copy for itself where either it prepared the earlier search report itself, or else has access to it in a form and manner acceptable to it, for example from a digital library.

15.13.2 The Authority may additionally invite the applicant (optionally using Form PCT/ISA/238) to furnish the following items within a time limit reasonable under the circumstances, where they have not been transmitted by the receiving Office and are not already available to it from its own records or from a digital library which it is prepared to use for the purpose (and, if necessary, where the applicant has informed the Authority that the document is so available):

- (i) a copy of the earlier application concerned;
- (ii) where the earlier application is in a language which is not accepted by the International Searching Authority, a translation of the earlier application into a language which is accepted by that Authority;
- (iii) where the results of the earlier search are in a language which is not accepted by the International Searching Authority, a translation of those results into a language which is accepted by that Authority;
- (iv) a copy of any document cited in the results of the earlier search.

However, no copy or translation of the earlier application may be required if the applicant indicates in the request that the earlier application is “substantially the same” as the international application. By this, it is meant that the inventions described and claimed are the same and any changes, beyond accurate translation where relevant, relate solely to formatting and correction of minor errors, inclusion or removal of matter not specific to the invention, but which is required in some States (such as details of public funding used in the development of the invention).

[Rules 16.3 and 41.1](#)

[15.13.3](#) Where the earlier search which the applicant requests to be taken into account was carried out by the same Office which is acting as an International Searching Authority, that Authority must, to the extent possible, take the results into account in establishing the international search report. Where the earlier search was conducted by another Office, the Authority may take the results into account. “Taking the results into account” in this context means finding a real benefit in those results to the extent that the earlier search may be considered to stand in place of a part of the international search. In any case, the examiner should consider the fields of search and cited documents in order to determine their relevance and whether they offer assistance in determining appropriate databases, classifications or terms of art in order to improve the quality of the international search.

...

Chapter 16 International Search Report

...

Filling Out the International Search Report (Form PCT/ISA/210)

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Basis of the Report

16.23 If the search has been conducted on the basis of a translation of the international application (see paragraph 15.13), this is indicated in item 1 of the first sheet of the international search report. [This item also includes indications of whether a rectification of an obvious mistake has been taken into account, a reference to any details relating to sequence listings used, and an indication of whether an earlier search has been taken into account \(see also paragraphs 15.13.1 to 15.13.3 and 16.56\).](#)

...

Previous Search

16.56 [No change] Where the international search report is entirely or partly based on a previous search made for an application relating to a similar subject, the previous application number and the relevant search history consulted for this previous search is, where appropriate, identified as having been consulted for the international application in question, except in those instances where the details of an earlier search cannot be ascertained, or whenever it is impractical to record the full details of the earlier search. In the later case, a summary of the earlier search should be included. Where the previous application has been published, this information is recorded in the international search report; if the previous application has not yet been published, the information may be sent to the applicant informally when the international search report is transmitted. See paragraph 16.53.

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[End of Annex III and of document]