

## Meeting of International Authorities under the Patent Cooperation Treaty (PCT) Working Group

**Eighteenth Session**  
**March 15 to 17, 2011, Moscow**

### Supplementary International Search

*Document prepared by the International Bureau*

#### SUMMARY

1. In accordance with the decision taken by the Assembly in 2007 in the context of establishing the supplementary international search system, this document reports on the financial and operational situation of the system two years after its introduction. A general review of the system by the Assembly, as requested by the Assembly in 2007, will take place in 2012.

#### INTRODUCTION

2. The PCT Union Assembly, at its thirty-sixth (16<sup>th</sup> ordinary) session in September/October 2007, adopted amendments to the PCT Regulations providing for a supplementary international search system. These amendments entered into force on January 1, 2009.
3. Along with adopting these amendments, the Assembly adopted two decisions in relation to reporting on and reviewing the supplementary international search system. These decisions are set out in paragraph 153 of the report of the Assembly (document PCT/A/36/13), reproduced below:

“The Assembly ...

- “(vi) decided that the International Bureau shall report to the Meeting of International Authorities under the PCT and to the Assembly on the financial and operational situation of the supplementary international search system; and

“(vii) decided that the Assembly shall review the supplementary international search system three years after the date of entry into force of the system.”

4. In accordance with the first of the decisions by the Assembly referred to above, the purpose of this document is to report on the current situation of the supplementary international search system. A review of the supplementary international search system by the Assembly, in accordance with the second of the decisions by the Assembly referred to above, will take place in 2012, three years after the date of entry into force of the system.

## **OPERATIONAL SITUATION**

### **International Authorities offering supplementary international search**

5. To date, six International Authorities offer supplementary international searches. The Federal Service for Intellectual Property of the Russian Federation (ROSPATENT; SISA/RU), the Nordic Patent Institute (SISA/XN) and the Swedish Patent and Registration Office (SISA/SE) have offered supplementary international searches since the entry into force of the system on January 1, 2009. The National Board of Patents and Registration of Finland (SISA/FI) became a Supplementary International Searching Authority on January 1, 2010, followed by the European Patent Office (SISA/EP) and the Austrian Patent Office (SISA/AT), which began offering the service on July 1, 2010, and August 1, 2010, respectively.

### **Languages accepted for supplementary international search**

6. All six International Authorities which offer supplementary international searches accept international applications which are filed in, or have been translated into, English. Other languages accepted for supplementary international search include: Danish (SISA/SE and SISA/XN); Finnish (SISA/FI); French (SISA/EP and SISA/AT); German (SISA/EP and SISA/AT); Icelandic (SISA/XN); Norwegian (SISA/SE and SISA/XN); Swedish (SISA/SE, SISA/FI and SISA/XN) and Russian (SISA/RU).

### **Documentation covered by Supplementary International Search**

7. The documentation covered by the supplementary international search varies between International Authorities. For some International Authorities, a supplementary international search can be limited to documentation in specific languages where examiners at the Supplementary International Searching Authority have particular language capabilities and expertise. For example, SISA/RU offers a supplementary international search in patent document collections in Russian from countries of the former Soviet Union. SISA/AT offers a supplementary international search covering only documents published in German. In addition, both also offer a supplementary international search covering the PCT minimum documentation in certain instances, either by applicant choice according to the level of fee paid, or else in cases where the main International Searching Authority has issued a declaration that no international search will be performed for certain reasons. By contrast, all other Supplementary International Searching Authorities always perform a complete new search equivalent to the main international search, covering at least the entire PCT minimum documentation as well as whatever further documentation in local or other languages would also usually be searched.

### **Fees charged for Supplementary International Search**

8. Relative to the international search fees, SISA/RU charges a supplementary international search fee equivalent to approximately 70% of fee it charges for the “main” international search, except for searches related to methods of treatment where a declaration from the International Searching Authority has been made under Article 17(2)(a). SISA/AT provides

three levels of fees between 50 and 100% of the fee it charges for the “main” international search, depending on the documentation covered. All other Authorities, all of which always search the entire PCT minimum documentation for the supplementary international search, charge the same amount of fees for supplementary searches as they do for the “main” international searches.

### **Demand for Supplementary International Search**

9. Demand from applicants for supplementary international searches is very low. In 2009, the first year in which the service was offered, 24 supplementary international searches were requested. Provisional figures for 2010 show an increase to 41 requests. 57 of the requests for supplementary international searches made in 2009 and 2010 were made to SISA/RU. The top four applicants requesting supplementary international searches accounted for more than 80% of all requests.
10. In view of the limited number of requests for supplementary international search, it is difficult to draw conclusions on the motivations of applicants for requesting this service. A preliminary analysis of the requests received in 2009 and 2010 appears to suggest that many requests for supplementary international search were made irrespective of negative search results in the “main” international search report (more than 80% of supplementary search requests were made following receipt of a “main” international search report containing X and/or Y citations, or even before the receipt of the international search report). By comparison, only a few supplementary search requests were made following a declaration under Article 17(2) of the PCT by the “main” International Searching Authority that no search report will be established.
11. Given these statistics, and considering the distribution of requests between International Authorities referred to above, it would appear that supplementary searches are usually requested in order to cover patent document collections beyond the minimum documentation which has been searched during the “main” international search, rather than (as one could perhaps expect) to have a full second search by a different International Authority, in addition to the “main” search, where no relevant documents were found in the “main” international search.

### **User feedback**

12. At the 2010 PCT/MIA meeting held in Brazil, International Authorities discussed possible reasons for the low uptake by applicants of supplementary international searches and concluded that “user feedback suggested that the service was seen as being too expensive, that too few Offices with a wider range of languages offer the service to make it really attractive to users, and that the launch of the service has not been enough publicized” (see paragraph 37 of the report of the session, document PCT/MIA/17/12). This conclusion broadly corresponds with user feedback received by the International Bureau and appears to be confirmed by the statistics showing that a majority of requests for supplementary international searches were made to the Authority which offers the service for a fee considerably lower than the fee it charges for a “main” international search and which carries out the supplementary search in documentation in a language not part of the minimum documentation.

### **FINANCIAL SITUATION**

13. At the International Bureau, the relatively low demand for supplementary international searches resulted in minimal day-to-day running costs with handling requests. Costs would only rise significantly in the event of a sharp increase in requests, where further investment in training of staff would be necessary. Concerning expenditure incurred to

establish the system, the International Bureau was able to build on existing IT systems to process requests and fee payments, benefitting from its existing systems as a receiving Office notably for the transfer of the supplementary search fee to the relevant International Authority.

#### **FUTURE DEVELOPMENT OF THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM**

14. There clearly is vast room for improvement of the supplementary international search system. The low uptake by applicants and feedback received suggests that the current mix of languages offered and fees charged by the Authorities offering the supplementary search service is not attractive enough for applicants to use the service; lack of awareness may also still play a role. The International Bureau intends to advertise the service further through the PCT Newsletter and seminars, but suggestions would be welcome on ways of making the service widely known to as wide a range of applicants as possible so that they can take an informed decision on its use.
15. As stated above, the International Bureau will, as requested by the Assembly, carry out a review of the supplementary international search system and present its findings for discussion by the Assembly at its 2012 session. In the meantime, International Authorities are invited to comment on the issues raised in this document and, to the extent that they do not yet offer supplementary international searches, to provide an update on whether they intend to offer the service in the near future.
16. *The Meeting is invited to comment on the issues raised in this document.*

[End of document]