

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

Twenty-First Session
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REVISION OF THE PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES

Document submitted by the European Patent Office

BACKGROUND

1. The International Bureau (IB) has prepared a revised draft of the International Search and Preliminary Examination (ISPE) Guidelines (see Circular C. PCT 1371, dated January 31, 2014). For future updates the European Patent Office (EPO) has some suggestions for an improved procedure, as set out in this document.
2. This document also contains some suggestions for amendments to the ISPE Guidelines necessary in view of the rule change related to the mandatory top-up search (see Annex I). Further, some comments and suggestions are made with respect to the modifications to Form PCT/IPEA/409, implementing the top-up search, as suggested by the IB in Circular C. PCT 1400 (see Annex II).

YEARLY REVIEW OF THE ISPE GUIDELINES AND CONSULTATION PROCESS

3. The present revision is the first since 2004. In this very long time frame, a large number of changes to the PCT Regulations and procedures, as well as to forms have taken place, thus making the task of updating the ISPE Guidelines a great challenge, with the risk of not noticing all rule changes and/or amendments to forms having an impact on the Guidelines.
4. The EPO would like to suggest that a more frequent update should take place, preferably on a yearly basis as is the case of the Receiving Office Guidelines.
5. A yearly update would be useful for both Offices and applicants. It would also make such review exercise easier.

GENERAL COMMENTS ON THE CONTENT OF THE ISPE GUIDELINES

6. In many instances the wording of a rule is merely repeated in the ISPE Guidelines without providing more insight as to the practice. Care should be taken that the ISPE Guidelines do not deteriorate over the long term and eventually end up as a mere summary of the Regulations without any added value. Should this concern be shared by other Authorities, the EPO would be ready to make further proposals for improvement to the ISPE Guidelines.

AMENDMENTS TO THE ISPE GUIDELINES TO TAKE INTO ACCOUNT RULE CHANGES IN 2014

7. The PCT Assembly has adopted a number of rule changes (mandatory top-up searches, public availability of the written opinion of the International Searching Authority) in September-October 2013. These rule changes will enter into force in July 2014 and it would appear beneficial to include such changes already in the revised ISPE Guidelines since this draft is likely to be promulgated also in 2014. In that perspective, the EPO has made some preliminary proposals for discussion (see Annex I).

8. *The Meeting is invited to comment on the proposals set out in this document and its Annexes.*

[Annexes follow]

SUGGESTED MODIFICATIONS FOR THE ISPE GUIDELINES CONCERNING THE IMPLEMENTATION OF THE TOP-UP SEARCH IN CHAPTER II

1. To be inserted in 19.12, with respect to the basis for examination:

19.12 The international preliminary examination is carried out in accordance with Article 34 and Rule 66. A written opinion will normally have been established on the application by the International Searching Authority. Usually this is considered as the first written opinion of the International Preliminary Examining Authority (see paragraph 3.18 for the exceptions to this). The examiner performing the international preliminary examination, if he has not already done so during the international search, studies the description, the drawings (if any), and the claims of the international application, including any amendments and observations which may have been filed, **and** the documents describing the prior art as cited in the international search report, [and any further relevant documents found in a top-up search according to Rule 66.1ter](#). He then determines whether a further written opinion (or a first written opinion in the exceptional case where a written opinion of the International Searching Authority has either not been prepared or else is not treated as the first written opinion of the International Preliminary Examining Authority) is required.

2. To be inserted in 19.15, which deals with cases where a further written opinion may be issued:

19.15 Assuming that the written opinion of the International Searching Authority is treated as the first written opinion of the International Preliminary Examining Authority, as noted above no further written opinion need be issued before the international preliminary examination report, even if there are objections outstanding. However, where the applicant has made a credible attempt to overcome or rebut the objections in the written opinion of the International Searching Authority, but failed to satisfy the examiner that all the relevant criteria are met, [or where the International Preliminary Examining Authority has performed a top-up search according to Rule 66.1ter and has found further relevant prior art](#), a further written opinion may, at the discretion of the International Preliminary Examining Authority, be issued if there is sufficient time available to establish the international preliminary examination report prior to expiration of the time period set in Rule 69.2 for establishment of the international preliminary examination report.

3. Moreover, the EPO suggests an insertion in the general procedural part in Chapter 3 of the ISPE Guidelines, in addition to Chapter 19. The EPO proposes that the scope of the top-up search be left at the discretion of each Authority rather than of each examiner. Authorities could leave, if they so wish, such flexibility to each individual examiner.

[Additional Search for further Relevant Documents](#)

[3.21bis The International Preliminary Examining Authority shall perform during Chapter II proceedings a top-up search according to Rule 66.1ter in order to find further relevant documents, in particular intermediate documents, i.e. documents according to Rule 64.3 which have been published after the international search report was established and which could become relevant in subsequent national and/or regional proceedings \(see also paragraphs 19.12.01 to 19.12.06\). It is left to the discretion of the Authority to decide on the scope of such top-up searches.](#)

[Comment: the EPO thinks it is appropriate to leave the discretion to the Authority rather than to each individual examiner, since it is important that each Authority establishes harmonized criteria for their examiners concerning the required scope of the top-up search.]

4. The suggestions below to paragraphs 19.12.01 to 19.12.06 are partly based on the proposal submitted by the United Kingdom and the United States of America at the sixth session of the PCT Working Group. However they have been adapted to the actual wording of the rule and the discussions during the last Working Group. Further consideration has also been given to the different possible scenarios.

5. As to the interpretation of the wording "serves no useful purpose" in the new Rule, it is noted from the discussions in the Working Group that, although there is agreement on the exceptional nature of this provision, each Authority might have different interpretations of this wording. Each Authority should strive at making their policies transparent to applicants and other Offices. It is recommended to revisit this issue once some experience with the new system has been gained.

Top-up search

19.12.01 In accordance with Rule 66.1ter, the International Preliminary Examining Authority shall, during the preliminary examination process, update the search performed by the International Searching Authority by performing a top-up search to uncover any relevant documents not available at the time of the international search, particularly intermediate documents, i.e. patent applications published on or after the filing or, where applicable, the valid priority date of the international application, but having an earlier filing or, where applicable, priority date (Rule 64.3).

19.12.02 Such a top-up search should normally not extend beyond the subject matter searched by the International Searching Authority as set out in Rule 66.1ter.

[Comment: the term "should normally " has been chosen to give some freedom to examiners to extend, in exceptional cases only, the scope of the top-up search. However, this should normally not be the case, since the top-up search should not be a means for the applicant to circumvent the requirement for a main search. In particular, reference is made to the explanations to Rule 66.1ter in Comment 2 of Annex I to document PCT/WG/6/24 indicating that the exceptions listed in Rule 66.1ter are specific cases where "the top-up search should be omitted or limited". Thus, it is clear from the Working Group document that the aim of the Rule was that normally the top-up search should not extend to such subject matter. This also makes sense, since in the cases listed in the Rule there does not exist a main search for the subject matter of certain claims and thus normally Chapter II examination should not be performed on these claims. Further, a top-up search in the sense of Rule 66.1ter, i.e. to find prior art which has recently become available (e.g. intermediate prior art), is not the same as an additional search which might be needed when the applicant amends the claim by adding features from the description.]

19.12.03 A top-up search should be performed in respect of all applications undergoing Chapter II examination, except where the examiner considers that performing a top-up search would serve no useful purpose. The instances in which a top-up search is not performed should be very limited. It is left to each Authority to determine, and give clear guidance to their examiners with respect to, the instances where a top-up search is considered not to serve any useful purpose.

[Comment: it is considered important that each Authority should establish harmonized criteria for their examiners. Leaving it to individual examiners is likely to result in problems and lack of harmonization within Authorities. Since it was clear from the discussions so far that policies differ amongst Authorities, it would not appear possible at this stage to find common criteria and/or examples for examiners that could be set out in the Guidelines. Such examples should preferably be included at a later stage, i.e. after the Authorities have had experience with the new system. In particular, the example provided in the previous paper from the United Kingdom and the United States of America has been removed since there was no consensus in the

Working Group on this example. For example, at the EPO it is mandatory to perform a top-up search irrespective of the number of X documents in the search report and irrespective of whether amendments have been filed. This is because at the EPO the top up search is meant to find further relevant prior art, in particular intermediate documents, which were previously not available.]

19.12.04 In the special case that the application is amended but the basis for the amendments could not be found, and/or there is no letter explaining the basis, and the examiner decides under Rule 70.2(c) or Rule 70.2(c-bis) to establish the report as if the amendments had not been made, the top-up search may be limited to the scope of the claims forming the basis for the report.

19.12.05 In the case of non-unity where there is more than one invention claimed in the documents for which examination under Chapter II is demanded, the examiner will first issue an invitation to pay further examination fees and then perform the top-up search for all inventions for which further examination fees have been paid, provided that any such inventions are not excluded from preliminary examination by the examiner under Rule 66.1(e).

19.12.06 Any relevant documents found during the top-up search will be indicated in the International Preliminary Examination Report in Section V and/or VI, depending on their publication date, and their relevance preferably briefly explained.

[Annex II follows]

SUGGESTED MODIFICATIONS TO FORM PCT/IPEA/409 BASED ON THE PROPOSAL IN CIRCULAR C. PCT 1400

1. The International Bureau has suggested modifications to Form PCT/IPEA/409 (as proposed in Circular C. PCT 1400) to accommodate the new requirement of a top up search in Chapter II as set out in the amended Rules.
2. The EPO has the following comments and suggestions with respect to the proposed amendments to Form PCT/IPEA/409:

Box No. I, Point 6

3. Although we agree in principle to the new items under point 6 relating to whether a top-up search was carried out or not, we would like to propose a modification of the text within brackets in the first of these boxes. This text indicates that "all discovered documents are listed in the Supplemental Box..." However, it would appear that only relevant documents found should be indicated and not "all"; thus we suggest the insertion of the word "relevant".

6.	<input type="checkbox"/>	With regard to top-up searches (Rules 66.1(f) and 70.2(f)):
	<input type="checkbox"/>	A top-up search was carried out by this Authority on _____ (all discovered documents are listed in the Supplemental Box Relating to Top-up Search).
	<input type="checkbox"/>	No top-up search was carried out by this Authority.

Box No. I, Supplemental Box

4. Presently, it is possible for examiners to cite new documents in the international preliminary examining report (PCT/IPEA/409) if needed, e.g. because of amendments or arguments filed by the applicant. Such documents are then mentioned by the examiner, by indication of the publication number, in the supplemental box or separate sheet relating to either Box V or VI depending on the publication date.
5. The EPO suggests that the present practice should be continued also for documents found in a top-up search, since it is well established and easy to understand for both Offices and applicants, and also would not need any IT implementation or examiner training. In particular, it appears advantageous to continue the separation between documents cited under Boxes V or VI depending on publication date.
6. The template proposed in Circular C. PCT 1400 on the other hand, foresees the use of a special supplemental box, amounting to, in principle, a second search report with all the data like category, claims etc. as shown below:

<u>INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY</u>		<u>International application No.</u>
<u>Supplemental Box Relating to Top-up Search</u>		
<u>Continuation of Box No. I, item 6:</u>		
<u>Documents discovered by this Authority during the top-up search</u>		
<u>Category*</u>	<u>Citation of document, with indication, where appropriate, of the relevant passages</u>	<u>Relevant to claim No.</u>

7. For many Offices it will be almost impossible, within the short time frame given for implementation of the new form PCT/IPEA/409 to provide for data corresponding to an international search report format in the international preliminary examination report. Further, to fill in such a template means more work for examiners. Thus, this is also a question of examiner resources which are very limited.

8. It would appear that such a major change of format for citing new documents in Chapter II would necessitate further in depth discussions, also as to the aim of the proposal. Moreover, the time frame for such a change to become mandatory, if at all, would have to be set accordingly.

9. Thus, in order to enable implementation before July 1, 2014, it is suggested to keep the present practice as set out above and start further discussions on the way newly-cited documents in Chapter II are, generally, to be indicated in the international preliminary examination report and transmitted to the International Bureau.

[End of Annex II and of document]