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POSSIBLE IMPROVEMENTS TO THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

Document prepared by the International Bureau

SUMMARY

1. This document discusses three possible changes to the supplementary international search system:

- the possibility of a supplementary international search based on amended claims;
- changing the deadline for requesting supplementary international search; and
- introducing a written opinion to supplementary international search.

2. International Authorities are invited to comment on the changes, which the International Bureau will take into account in the preparation of a working document for the PCT Working Group.

INTRODUCTION

3. The PCT Working Group, at its eighth session in May 2015, discussed a document (document PCT/WG/8/6) to prepare the review of the supplementary international search system by the PCT Assembly at its forty-seventh session in October 2015. Paragraphs 18 to 22 of that document, reproduced below, describe possible improvements to the supplementary international search system suggested, in response to Circular C. PCT 1429, dated October 23, 2014, by Offices, PCT user groups and applicants who had requested a supplementary international search in the past:

“18. Two possible changes to supplementary international search were suggested in the responses that would require amendments to the PCT Regulations:

(a) One International Authority reported that some users had asked for supplementary international search to be based on an amended set of claims, but added that this would increase the burden on the Authority specified for supplementary search, which would be required to check the amendments.

(b) One Office suggested allowing another six months for an applicant to request supplementary international search; this would move the deadline for requesting supplementary international search to 25 months. Another Office suggested the opposite, with the time limits for the applicant to request supplementary international search and for the Authority to establish the supplementary international search report being brought forward.

“19. Some responses requested more International Authorities to offer supplementary international search.

“20. One International Authority offered a detailed written opinion with the supplementary international search report which was prepared to the same standard as written opinion by the "main" International Searching Authority. This Authority suggested that other Supplementary International Searching Authorities should also provide this benefit.

“21. Some responses from Offices and user groups suggested that the fees set by International Authorities for supplementary international search should be lower.

“22. A number of suggestions were made relating to the handling of applications with a supplementary international search report in the national phase which could make supplementary international search more attractive. For example, designated/elected Offices could reduce fees, offer accelerated processing and give broader recognition to the search results during the international phase for applications with a supplementary international search report.”

4. The discussions by the Working Group at its eighth session on this matter are summarized in paragraphs 84 to 90 of the Summary by the Chair of the session (document PCT/WG/8/25); paragraphs 239 to 251 of the report of the session (document PCT/WG/8/26) give full details of all of the interventions.

5. Paragraphs 87 to 89 of the Summary by the Chair summarize the comments from delegations and user groups on suggested possible improvements to the supplementary international search system, and the decision adopted by the PCT Working Group on this matter, as follows:

“87. Several delegations expressed support for further consideration of the improvements to the supplementary international search system suggested in the document. In particular, some delegations stated that they could support providing for the possibility for an applicant to request a supplementary international search on the basis of amended claims filed under Article 19, and changing the deadline for filing a supplementary search request to 22 months from the priority date to correspond to the deadline for filing a demand for international preliminary examination.

“88. Representatives of user groups gave reasons for the low use of supplementary international search, such as the cost, limited choice of International Searching Authorities and languages available for a supplementary international search, sometimes needing to file a request for supplementary international search before receiving the main international search report, and the possibility of obtaining a further search through early national phase entry.

“89. The Working Group invited the International Bureau to present a document to the next session of the Working Group to discuss possible improvements to the supplementary international search system.”

6. This document explores the possible improvements to the supplementary international search system suggested in paragraphs 18 and 20 of document PCT/WG/8/8, reproduced in paragraph 3, above, namely:

- the possibility of permitting a supplementary international search to be based on claims amended under Article 19;
- the possibility of moving the deadline for requesting supplementary international search to a later point in time; and
- the possibility of introducing a written opinion to the supplementary international search system.

POSSIBLE IMPROVEMENTS

SUPPLEMENTARY INTERNATIONAL SEARCH BASED ON AMENDED CLAIMS

Background

7. During the discussions by the Working Group on Reform of the PCT leading to the establishment of the supplementary international search system, it was left to each Authority to decide whether the scope of the supplementary search it performed should be a full new search or a search limited to documentation in languages in which the Authority performing the supplementary search was specialized (see paragraphs 35 to 37 of document PCT/R/WG/8/4). However, it was generally agreed that the supplementary search was expected to supplement the main search and to take into account the results of the earlier search and that the main and supplementary international search reports needed to be read together.

8. To this end, it was proposed that the supplementary international search should always be carried out on the basis of the international application as filed, or a translation thereof. The rationale for this was set out in a comment to draft Rule 45bis.8 set out in document PCT/R/WG/7/7 (which corresponds to the adopted Rule 45bis.5(b)) as follows:

“... it would always be possible [*in the context of the draft proposal, which allowed requests for supplementary international search only after the main international search report had been established*] 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.”

9. Thus, the supplementary search system was introduced without the opportunity for the applicant to request the Authority carrying out the supplementary search to base that search on the claims as amended under Article 19. Under the current supplementary search system, the only opportunity for the applicant to request the Authority to base the supplementary search on a “version” of the international application different from the one “as filed” exists under current Rule 45bis.1(d), which provides that, where “the International Searching Authority has found that the international application does not comply with the requirement of unity of invention, the supplementary search request may contain an indication of the wish of the applicant to restrict the supplementary international search to one of the inventions as identified by the International Searching Authority other than the main invention referred to in Article 17(3)(a).” Accordingly,

Rule 45bis.5(b) permits the applicant to restrict the supplementary international search to the invention specified by the applicant under Rule 45bis.1(d) and those parts of the international application which relate to that invention.

Issues

10. A significant number of supplementary searches are carried out in the entire PCT minimum documentation (see Annex I to Circular C. PCT 1429 for details of documentation searched by Authorities in supplementary international search). In these cases, there may be reasons other than unity of invention which might make it desirable to have a supplementary international search performed on different claims from those originally filed. For example, amended claims filed by the applicant under Article 19 are likely to be closer to the protection that the applicant will seek in the national phase. However, it has to be recognized, for reasons outlined in the following paragraphs, that such a search based on claims amended under Article 19 would be an entirely different type of search than that envisaged under the present supplementary international search system.

“Restarting” the International Search

11. As explained in paragraph 8, above, with regard to an international search carried out on the basis of amended claims rather than on the basis of the application as filed, it would appear difficult to envisage how such a search would supplement the main international search rather than “restart” the international search altogether, in particular, where the amended claims are not only a narrowing of the claims originally searched. A “restarted” international search would appear to be not a variant within the supplementary international search system but rather introduce a new element (in essence, a second search on a different set of claims) to the international search. Since it would be impossible for a “restarted” search to be complete without searching the entire PCT minimum documentation, the complementary nature of supplementary international search would disappear. This would be contrary to one of main original intentions of supplementary international search, namely, to complement the main international search, in particular by further searching limited to national document collections in particular languages in which examiners at the Authority performing the supplementary search would be proficient (see paragraph 5 of document PCT/R/WG/6/9).

12. In the following paragraphs, the present document first discusses the value of introducing such a new element to the international search and its relationship to international preliminary examination under Chapter II. The document then explores a number of more practical difficulties of a “restarted” international search, such as the timing of the “restarted search”, the issue of additional subject matter, the issue of scope of amended claims and the choice of International Searching Authority to perform a “restarted” international search. All these difficulties raise questions on how such a “restarted” international search could exist alongside the present supplementary international search system and the international preliminary examination procedure under Chapter II.

“Restarted” International Search vs International Preliminary Examination

13. Any benefits of giving the applicant the opportunity to request international search on the basis of amended claims would need to be considered in light of the possibilities offered to the applicant by opting for the international preliminary examination procedure under Chapter II. International preliminary examination provides greater possibility for the amendment of an international application. Whereas Article 19 limits amendment to one opportunity to amend the claims after the international search report is issued, Article 34(2)(b) allows more than one opportunity and permits amendment to the description and drawings as well as the claims. Moreover, Article 66.1ter requires the International Preliminary Examining Authority to conduct a top-up search to discover any relevant documents published since the international search. Faced with a choice between the two, in view of the greater flexibilities provided under Chapter II and the very low uptake of supplementary international search, international preliminary examination is likely to remain the preferred option for applicants.

Amendments beyond the Disclosure in the International Application as Filed

14. As stated in Article 19(2), any amendment of the claims shall not go beyond the disclosure in the international application as filed. If the applicant wished a “restarted” international search to be performed on claims amended under Article 19, the Authority specified for supplementary search would be required to determine this matter. The Authority would also need to have the possibility to exclude any claims with additional subject matter from the supplementary search. Alongside this, it would appear reasonable to have provisions to allow an applicant to file arguments or even a protest against the determination of additional subject matter to request the Authority to review the decision. However, although the applicant can request a review of a decision on the opinion of the International Searching Authority on lack of unity of invention, at present, the Chapter I procedure does not allow for dialogue between the applicant and the International Searching Authority. Moreover, given that Article 19 provides for only one opportunity to amend the claims, the applicant would have no possibility to even remove any additional subject matter from the claims and have an international search performed on the claims as so further amended.

15. The only option an applicant would have to further amend claims which had already been amended under Article 19 during the international phase would be to file a demand for international preliminary examination under Chapter II. The time limit for filing a demand in Rule 54*bis* is the later of three months from the date of transmittal of the international search report or the Article 17(2)(a) declaration, and 22 months from the priority date. So, for the applicant to be aware of claims that had gone beyond the disclosure in the international application as filed and remedy the problem in the international phase by way of filing a demand for international preliminary examination, the applicant would need to have received the determination of additional matter before this deadline.

Scope of Amended Claims for Supplementary International Search

16. A further issue to be considered which demonstrates that a “restarted” international search on the basis of amended claims would not obviously fit into the current legal framework on supplementary international search would be the issue of the scope of any claims amended under Article 19. Under the current legal framework governing supplementary international search, Rule 45*bis*.5(d) allows an Authority to exclude any claims from supplementary international search that were not the subject of the international search. That provision, read literally, would cover any claim amended under Article 19. That Rule would thus need to be amended to make clear that the claims which may be excluded from a “restarted” international search would be those which had not been covered by the substance of the main international search. Amended claims which narrowed the scope of claims searched during the main international search would, however, be acceptable. By contrast, claims with additional subject matter would, of course, have to remain excluded from the supplementary international search. A more difficult question to resolve, however, would be whether claims that did not add subject matter but went beyond the scope of those that had been the subject of the main international search would be permitted to be the subject of a “restarted” international search, an issue closely linked to the question of whether the further search would be supplementing or restarting the main international search.

Choice of International Searching Authority

17. A further issue to be considered which demonstrates that a “restarted” international search on the basis of amended claims would not obviously fit into the current legal framework on supplementary international search would be the issue of choice of the International Searching Authority competent to carry out a “restarted” search. Under the current supplementary international search system, applicants may select any International Searching Authority that offers supplementary international search to perform the supplementary search on an international application, except for the International Searching Authority that has carried out the main international search, unless certain limitations apply to the Authority offering supplementary international search. The choice for the applicant of an International Searching

Authority is often wider than that for the main international search, in respect of which the receiving Office must specify one or more competent International Searching Authorities (many receiving Offices have only specified one). Furthermore, under the current supplementary search system, the applicant may request a supplementary international search to be carried out by several International Searching Authorities.

18. It would appear difficult to fit a “restarted” international search into that framework governing supplementary international search. There would be no limitation on the International Searching Authority competent to carry out a “restarted” international search, so applicants could choose to have a restarted search carried out by any International Searching Authority offering supplementary search irrespective of the Authority or Authorities specified as competent by the receiving Office, with the effective role of the main International Searching Authority being limited to a “preliminary” international search. In addition, the main International Searching Authority would be excluded from performing the “restarted” international search, which would not appear appropriate, as that would be the Authority already familiar with the international application and thus most competent to also carry out a “restarted” search of the application on the basis of claims amended under Article 19.

19. A further problem associated with the choice of International Searching Authority for a “restarted” international search would be duplication of work. Under the current legal framework governing supplementary search, the applicant may request more than one supplementary international search on an international application, allowing supplementary searches to be performed by different International Authorities covering their respective document collections in their national languages; in this case of truly supplementary international searches, overlap in the documentation searched by each Supplementary International Searching Authority is unlikely. But if an applicant requests a “restarted” international search on the basis of claims amended under Article 19, only a search of the full PCT minimum documentation would be complete; in that case, allowing for a “restarted” international search to be carried out by more than one International Searching Authority would be obvious duplication of work.

20. Duplication would also occur if the applicant had the possibility to request a “restarted” international search from one International Searching Authority while, at the same time, also requesting a “normal” supplementary international search from another Authority based on the claims as originally filed, for example, limiting the “normal” supplementary international search to national document collections. If a “restarted” international search were to be introduced, consideration would have to be given to the question whether the applicant should be allowed to also request a “normal” supplementary search based on the claims as originally filed.

Conclusion

21. A “restarted” international search on the basis of amended claims would not obviously fit into the current legal framework on supplementary international search and would present a number of problems:

- a “restarted” international search would appear to be not a variant within the supplementary international search system but rather introduce a new element (in essence, a second search on a different set of claims) to the international search;
- it is not clear how a “restarted” international search would add additional value to the applicant compared to the Chapter II procedure;
- the Authority selected for a “restarted” international search would be required to determine if matter beyond the disclosure of the international application as originally filed had been added to the amended claims; if that were the case, the applicant would have no possibility to remedy this during the Chapter I procedure with a view to continuing the “restarted” international search, and instead would have to file a demand under Chapter II to remove the added matter in the international phase;

- it would be difficult to define the scope of amended claims that would be the subject of a “restarted” international search;
- the current legal framework determining competency of International Searching Authorities to carry out supplementary searches may not work in respect of “restarted” international searches; in particular, excluding the main International Searching Authority from carrying out a “restarted” international search would reduce the role of the main international search to a mere “preliminary” international search; and
- the potential for overlap of search documentation and duplication of work by different International Searching Authorities increases.

DEADLINE FOR REQUESTING SUPPLEMENTARY INTERNATIONAL SEARCH

Background

22. Under Rule 45*bis*.1, supplementary international search can be requested at any time up to 19 months from the priority date. Any such request will not, however, be forwarded by the International Bureau to the Authority specified for supplementary search until the end of 17 months from the priority date or receipt of the main international search report, whichever occurs earlier. The deadline for establishing the supplementary international search report or making the declaration that no supplementary search report will be established is 28 months from the priority date, as specified by Rule 45*bis*.7(a).

23. The time frame of the supplementary search was agreed to take into account two main factors, as discussed at the fourteenth session of the Meeting of International Authorities in 2007. First, it was necessary to allow enough time for the Authority to perform the supplementary international search and for the result to be useful, including in the case where international preliminary examination is demanded. Second, it was important to avoid duplication of work. The time limits were therefore set so that the main international search report would be available before supplementary international search except when this report was established significantly late (see paragraph 12(d) of document PCT/MIA/14/7 and paragraph 43(i) of document PCT/MIA/14/8).

24. Given the low use of supplementary international searches and the minimal impact such searches have on the timeliness in the delivery of other work products by an Authority, the concerns expressed about workflow management during the discussions in 2007 on the deadlines in the supplementary international search system now appear less relevant. Consequently, a proposal has been made to move the deadline for requesting supplementary international search to 22 months from the priority date, in line with the deadline for filing a demand for international preliminary examination (see paragraph 4, above).

Issues

Timing of International Search Reports and Requests for Supplementary International Search

25. A key indicator of the potential benefits for the applicant of postponing the deadline for requesting supplementary international search is the timeliness of the main international search report, as this provides information on whether a supplementary search would be useful.

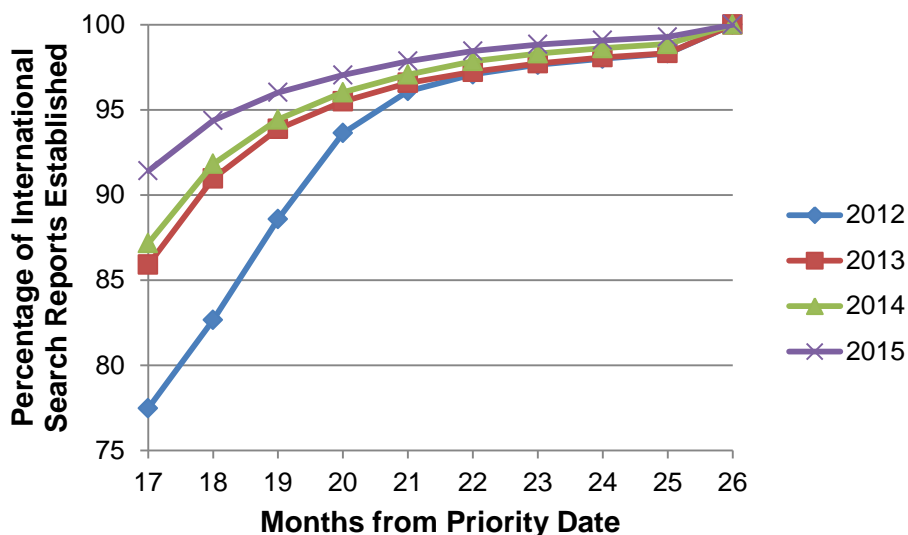


Figure 1: Percentage of International Search Reports Established by Time from Priority Date of International Application by Year

26. Figure 1 shows how many international search reports were established within how many months from the priority date. Overall, timeliness has improved significantly in recent years, but there remain a significant number of international applications where the international search report is not available in time to take decisions, according to the current deadlines, as to whether to request a supplementary international search. From January to end October 2015, about 94 per cent of reports have been issued within 18 months from the priority date (up from about 91 per cent in 2014), leaving the applicant one month to file a supplementary international search request. Since 2013, between 96 and 97 per cent of international search reports have been issued by 20 months from the priority date, with this figure rising by about a further percentage point at 21 months from the priority date.

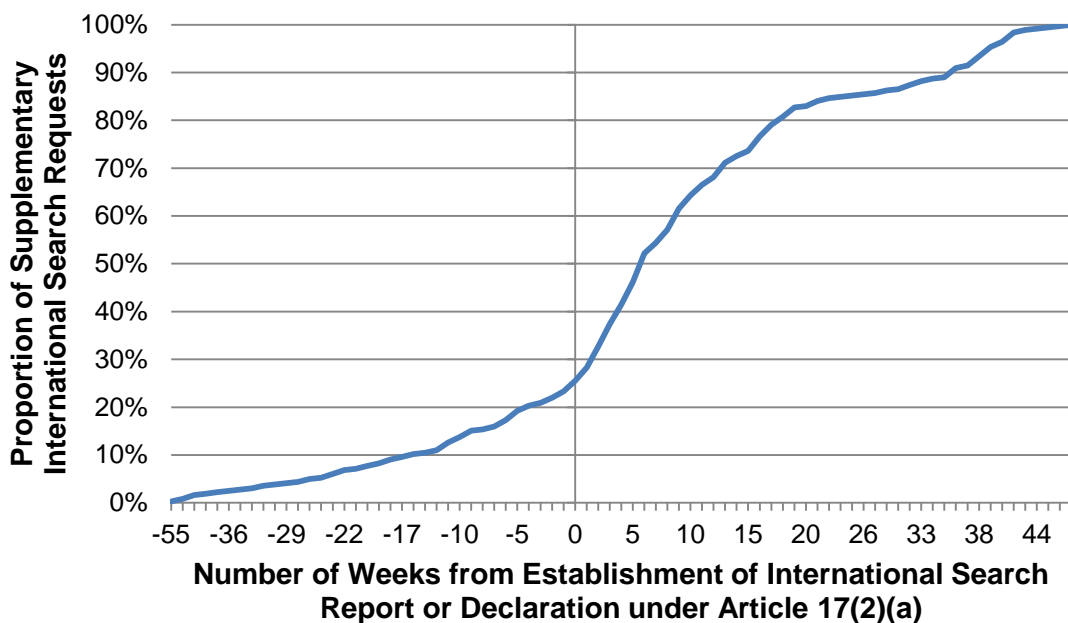


Figure 2: Proportion of Supplementary International Search Requests Filed compared to Date of Establishment of the International Search Report or Declaration under Article 17(2)(a)

27. Moving the deadline for requesting supplementary international search to 21 or 22 months from the priority date would allow more applicants to be able to consider the main international search report before this deadline; beyond these dates, Figure 1 shows the benefits to applicants of further postponing the deadline for filing a supplementary international search request to be less apparent. Figure 2 shows that, since supplementary international search was introduced, 25 per cent of supplementary international search requests have been received before establishment of the international search report, and a further 25 per cent have been received within six weeks afterwards. A supplementary international search request deadline at 21 or 22 months from the priority date could therefore increase uptake of the supplementary search system by applicants.

28. One factor in postponing the deadline for filing a supplementary international search request is the proximity to the 22 month deadline under Rule 54*bis*.1 for filing a demand for international preliminary examination. A later supplementary search request decreases the likelihood that the supplementary international search report would be available in time to be taken into account during international preliminary examination though, in practice, demands are only received for around 10 per cent of international applications for which supplementary international search is requested.

29. Another issue is the timescale to perform the supplementary international search. A 22 month deadline for requesting the search would leave six months to establish the supplementary international search report, but this could be shorter if the International Bureau needs to invite the applicant to comply with unmet formal requirements and/or pay any outstanding fees within a further month before transmission to the Authority specified for supplementary search.

30. A further consideration on the deadline of a supplementary international search request is the rare event of an applicant requesting a review of an opinion on non-compliance with unity of invention under Rule 45*bis*.6. The applicant has one month to request a review which, if successful, would require the supplementary international search report to be established for all parts of the invention within the 28 month time limit under Rule 45*bis*.7(a).

Conclusion

31. It appears that the main factors to consider in postponing the deadline for requesting supplementary international search to 21 or 22 months from the priority date are the following:

- an extra 3 or 4 per cent of international applications (based on the most recent figures) would have the international search report before the applicant was required to decide on whether to file a request for supplementary international search, leaving only 2 or 3 per cent of applications without an international search report before the new 22 month deadline for requesting supplementary international search;
- a new 22 month deadline for requesting supplementary international search would result in fewer supplementary international search reports being available before the deadline for filing a demand for international preliminary examination; and
- the time available to the Authority to perform the supplementary international search would be reduced; this would increase the impact of processing delays arising from formal requirements not being met, the fees not being paid at the time of filing the request, or the applicant requesting a review on non-compliance with unity of invention determined by the Authority.

ISSUANCE OF A WRITTEN OPINION WITH THE SUPPLEMENTARY INTERNATIONAL SEARCH REPORT

Background

32. The possibility of issuing a written opinion with the supplementary international search report was discussed by the Working Group on Reform of the PCT at its sixth session in 2004. The supplementary written opinion proposed would have been issued only if further relevant documents had been discovered during the supplementary search. Like the supplementary international search report proposed at the time, the supplementary written opinion would not have cited documents from the main international search report unless they were relevant in combination with a new document uncovered during the supplementary search. The supplementary written opinion discussed at the time was therefore intended to avoid duplication and uncertainty if differing opinions were provided between the main and supplementary international search (see paragraph 3(k) of document PCT/R/WG/9). The discussions of this proposal are summarized in paragraph 80 of document PCT/R/WG/6/12:

“80. One delegation expressed the view that that the supplementary search should not involve the preparation of a written opinion by the search examiner. However, other delegations and representatives of users believed that an explanation of the relevance of citations discovered in the supplementary search would be necessary, particularly since it was likely that those citations would be in a language which would not be well understood by the applicant, the International Preliminary Examining Authority and some designated Offices.”

33. As a compromise, the revised proposal submitted to the seventh session of the Working Group on Reform of the PCT in 2005 did not include a “full” written opinion by the supplementary search examiner, but required the supplementary search examiner to include, as part of the citation of a document, a brief explanation of the relevance of the cited document to the novelty and inventive step of the claimed invention. This brief explanation would not propose any classification of the international application, any revisions to the abstract or title or include comments on matters other than novelty and inventive step, which would be included in the written opinion of the main International Searching Authority (see document PCT/R/WG/7/7). Paragraph 85 of document PCT/R/WG/7/13 summarizes the outcome of discussions on this matter at the session:

“85. The Working Group agreed that the supplementary international search report should not include a written opinion but should list citations in a manner similar to an international search report, also including comments sufficient to make their relevance clear. One delegation suggested that it should not be necessary to list family members of the cited documents.”

34. The subsequent proposals, submitted to the eighth and ninth sessions of the Working Group on Reform of the PCT in 2006 and 2007, omitted any written opinion by the supplementary search examiner, but noted that any explanations with regard to the citations of the documents considered to be relevant should make sufficiently clear their relevance, bearing in mind that many citations would be in languages not well understood by the applicant and many designated Offices (see paragraphs 5(e) of document PCT/R/WG/8/4 and 9(k) of document PCT/R/WG/9/2). At the ninth session, noting that the supplementary international search report would not be accompanied by a written opinion, it was felt that the report should be permitted to contain explanations with regard to the scope of the supplementary international search, for example, in a case where full search was not possible due to the complexity of claims, or where assumptions needed to be made in deciding on the appropriate scope of search because the main international search had not yet been established (see paragraph 107 of document PCT/R/WG/9/8). Rule 45*bis*.7(e) as adopted and currently in force therefore states the following:

“45bis.7 Supplementary International Search Report

...

(e) The supplementary international search report may contain explanations:

- (i) with regard to the citations of the documents considered to be relevant;
- (ii) with regard to the scope of the supplementary international search.”

Issues

35. As indicated in the responses to Circular C. PCT 1429, discussed in paragraph 3, above, one International Authority offers a detailed written opinion with the supplementary international search report which is prepared to the same standard as the written opinion by the “main” International Searching Authority. This Authority has suggested that other Authorities offering supplementary international search provide the same benefit to applicants.

36. It is to be noted that, under the present legal framework, any Authority is welcome to provide its explanations under Rule 45bis.7 to the same standard and in the same style as it would make comments in the equivalent sections of the “main” written opinion of the International Searching Authority. There is thus no need to change the Regulations. Furthermore, the International Bureau does not review the explanations to exclude any comments which the Authority may have provided informally on other issues, beyond what is covered by a “normal” written opinion.

37. It would, however, of course be possible to amend the regulatory framework with a view to improving the work products of supplementary international search, as further outlined in the following paragraphs.

Amendment of Rule 45bis.7(e)

38. Short of introducing a written opinion to the supplementary international search system, one option would be to amend Rule 45bis.7(e) to make it mandatory to include in the supplementary international search report explanations with regard to the citations of the documents considered to be relevant (see subparagraph (i) of that Rule). The requirement under subparagraph (ii) of that Rule to include in the supplementary search report explanations with regard to the scope of the supplementary international search should, however, remain optional, as such requirement would not apply to all supplementary searches (see paragraph 34, above).

Introducing a Written Opinion to the Supplementary International Search Report

39. A second option to improve supplementary international search could be to require a written opinion to be issued at the same time as the supplementary international search report.

40. In view of the potential duplication of work of a second written opinion, as highlighted during the discussions leading to the introduction of the supplementary international search system (see paragraph 32, above), if a written opinion were obligatory, it would be necessary to decide on the contents of that (second) opinion. For example, the opinion could omit defects on the form and contents of the application (Box VII of Form PCT/ISA/237) and observations on clarity and support (Box VIII of Form PCT/ISA/237), except if these matters were not considered during the main international search, for example, when the main International Searching Authority has issued a declaration under Article 17(2)(a) and no international search report had been established.

41. It would also be necessary to determine whether the written opinion accompanying the supplementary international search report should be required in all circumstances, or only where new relevant prior art was found, as envisaged during the discussions by the Working Group on Reform of the PCT. Only requiring a written opinion when the supplementary international search report includes at least one new X or Y citation would avoid duplication and minimize inconsistencies where the main and supplementary International Searching Authority have different opinions on novelty and inventive step on the same cited documents. This would not, however, allow an Authority to issue a written opinion during supplementary international search if all claims were considered to be patentable, as the supplementary international search would not uncover any new X or Y citations.

42. A further factor to consider in determining the circumstances under which a written opinion should be issued with the supplementary international search report is the possible role of supplementary international search in the Patent Prosecution Highway (PPH). Under PCT-PPH, an applicant can file a PPH request based on the (main) written opinion of the International Searching Authority or based on the international preliminary examination report, but not on the international search report alone. At present, the work products of the Supplementary International Searching Authority cannot therefore form the basis of a PPH request. If a written opinion were introduced into supplementary international search, only permitting the opinion to be issued when new relevant documents were found would restrict the use of supplementary international search work products in the PPH.

43. On the other hand, an Authority performing a supplementary search on a limited set of document collections within the PCT minimum documentation would have difficulty in establishing a written opinion as to novelty and inventive step if the international search report from the main International Searching Authority is not yet available. In addition to the potential duplication of work by the main International Searching Authority, requiring a written opinion with the supplementary international search report would not be appropriate in this situation.

44. As an alternative to an obligatory written opinion for all supplementary searches or only when new relevant documents are found, one possibility could be to provide the option for an Authority to issue a written opinion with the supplementary international search report. The situations where an Authority will issue the written opinion with the supplementary international search report could then be defined in the agreement that the Authority has with the International Bureau in relation to its functioning as an International Searching and Preliminary Examining Authority, as is done with regard to the scope of the supplementary international search. For example, an Authority limiting a supplementary international search to document collections in certain languages could exclude the written opinion from supplementary international search.

Conclusion

45. There is no need to change the Regulations for more Authorities to provide further explanations in the supplementary international search report to the standard of the written opinion of the International Searching Authority. However, if the regulatory framework were amended to provide further information with the supplementary international search, the two main options would be:

- to amend Rule 45bis.7(e) to make it mandatory to include explanations on the documents cited in the supplementary international search report that were considered to be relevant; or
- to introduce a written opinion to the supplementary international search report; in this case, in addition to determining the content of the opinion, it would need to be decided under what situations issue of the written opinion should be mandatory, or whether it should be left to each Authority to specify when it would issue the written opinion.

46. *The Meeting is invited to comment on the proposals discussed in the present document.*

[End of document]