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INTERNATIONAL PATENT COOPERATION UNION
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WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

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OPTIONS FOR FUTURE DEVELOPMENT OF
INTERNATIONAL SEARCH AND EXAMINATION

Document prepared by the International Bureau

BACKGROUND

1. At its third session, the Working Group reviewed proposals for reform which had already been submitted to the Committee on Reform of the PCT ("the Committee") or to the Working Group but not yet considered in detail, and agreed on the priority of those proposals, with a view to their inclusion in the work program of the Working Group. Among the proposals reviewed by the Working Group were proposals related to international search and preliminary examination (see the Summary by the Chair, document PCT/WG/3/5, paragraphs 87 to 94). The Working Group agreed that the International Bureau should prepare, for discussion at its next session, an options paper on possible future development of the international search and examination system, including options whereby designated Offices, particularly smaller designated Offices, could derive great benefit from the results of the international phase.

2. This document outlines possible options for the future development of international search and examination. The Working Group is invited to discuss the options with a view to identifying possible features of the future PCT search and examination system as starting points for further consideration by the Working Group.

REFORM OF INTERNATIONAL SEARCH AND EXAMINATION SYSTEMS

3. So far, discussions in the Committee and the Working Group, including discussions on a possible future PCT search and examination system, have focused on changes which could be made through amendments to the Regulations rather than a revision of the Treaty itself. The result was the enhanced international search and preliminary examination system that was adopted by the PCT Assembly at its 31st (18th extraordinary) session, held from September 23 to October 1, 2002 (see document PCT/A/31/10, paragraphs 45 to 48 and Annex V), which will be implemented from January 1, 2004.

4. Certain features of the recently adopted changes reflect the existing provisions of the Treaty concerning international search and examination. Different approaches would be available if an entirely new system were to be created without constraint by those present limitations, for example:¹

(i) the Treaty is based on a distinct separation between the compulsory international search procedure (under Chapter I of the Treaty) and the optional (both for applicants and for Contracting States) international preliminary examination procedure (under Chapter II); however, the recently adopted enhanced international search and preliminary examination system provides (with effect from January 1, 2004) for the compulsory establishment of a written opinion by the International Searching Authority which is equivalent, in effect, to the first written opinion of the International Preliminary Examining Authority;

(ii) the Treaty limits the scope of the international preliminary examination report (see Article 35(2)) in a way which, while not entirely precluding comments on certain matters that may be applicable in some States but not others, reduces the possibility of establishing a report which caters for different needs; it also does not envisage procedures which might be used by an Authority which wished to perform national examination on the application simultaneously with international preliminary examination.

5. In view of these and other limitations presently imposed by the Treaty, the enhanced international search and preliminary examination system as adopted by the Assembly represents a good balance of different interests for the present, without amending the Treaty itself. Of particular note is that it provides a reasoned opinion on novelty, in inventive step and other matters for almost all international applications, which is useful for designated Offices, particularly smaller Offices and Offices with no capacity for search and examination, especially in developing countries. However, while some significant further changes might be achieved through amendment of the Regulations only, it seems likely that any further fundamental changes could be achieved only through a revision of the Treaty itself.

¹ References in this document to "Articles" and "Rules" are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT ("the Regulations"), or to such provisions as proposed to be amended or added, as the case may be. References to "Chapter I" and "Chapter II" are to those of the PCT. References to "national laws," "national applications," "the national phase," etc., include reference to regional laws, regional applications, the regional phase, etc. References to "PLT Articles" and "PLT Rules" are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT.

POSSIBLE FEATURES OF A FUTURE INTERNATIONAL SEARCH AND EXAMINATION SYSTEM

6. While this document looks at possible features of a future system for international search and examination under the PCT, it must be remembered that the PCT operates in the more general context of the international patent system as a whole, and that there are inevitably more general implications in that broader context when fundamental changes to the PCT system are being considered. For example, some of the objectives of reform of the PCT formulated by the Committee were:

(i) “reduction of costs for applicants, bearing in mind the differing needs of applicants in industrialized and developing countries, including individual inventors and small and medium-sized enterprises as well as larger corporate applicants;”

(ii) “avoiding unnecessary duplication in the work carried out by PCT Authorities and by national and regional industrial property Offices;” and

(iii) “ensuring that the system works to the advantage of all Offices, irrespective of their size”

(see document PCT/R/1/26, paragraphs 66(ii), (iv) and (v) respectively). The desire by some Offices to bring together, so far as possible, the international and national processing of an application provides another example. It is particularly important to consider how the international system will work in harmony with, and to the benefit of, the systems in developing countries and States with non-examining Offices. For these States, the international system should be able to produce search and examination reports which are of maximum benefit at a national level, reducing the likelihood of invalid patents being granted, including in the case of registration systems.

7. Many of the possible options for change to the international search and examination system would appear to require revision of the Treaty or the addition of optional protocols to it (see document PCT/R/WG/3/3 which outlines options for a possible revision of the Treaty itself). Amendments or protocols to the Treaty which add features which are optional and purely complementary to the existing system could be implemented relatively quickly since they would not need to be ratified by all States before they came into force, but only by those States which wished to be bound by them. However, it is unlikely that changes of this sort could be used to change the way international search and examination itself is conducted, since this would almost inevitably result in a need for Authorities to draw up reports or opinions according to different standards for use in the various Contracting States, depending on whether or not they had ratified a particular protocol, and might require the applicant to formulate alternative versions of the international application, neither of which would be practical.

INTERESTS TO BE CONSIDERED

8. In order to be effective, the system must meet the needs of a number of different stakeholders. Though these have different interests, this does not always mean that their wishes for aspects of the system conflict; while some of their interests have to be balanced against one another, others are complementary:

(i) *inventors and applicants*: want the PCT system to be cheap and flexible enough to meet different wishes regarding timing and quality; some wish to use the international system primarily to delay the cost of entry into the national phase; others wish to take the maximum possible advantage of search (in particular) and examination, ensuring that the application has a high presumption of validity in the forum in which it enters the national phase;

(ii) *national Offices (in their role as designated or elected Offices) and administrations*: generally want the PCT system to deliver timely reports of high quality and relevance to the national phase, particularly in the case of smaller Offices and Offices with no capacity for search and examination, especially in developing countries;

(iii) *third parties, including consumers and competitors*: want the PCT system to be fast; reliable, with the end result having the maximum possible legal certainty in all Contracting States; and transparent, giving as much information as possible about the processing, such as through publication of the international application and the availability of the reports of the Authorities;

(iv) *administrators of the international system (particularly receiving Offices, International Authorities and the International Bureau)*: want a PCT system where it is realistic for them to provide the defined service in all respects of function, quality and timing within their financial and manpower limits.

9. When an amendment of the Treaty itself is considered, the new system, as a whole, needs to provide sufficient benefits for all stakeholders to justify the considerable upheaval involved. Search and examination lie at the very heart of the international patents system, both during the international phase of the PCT and during the national phase grant procedure. While it is likely that many aspects of the current system would be retained, it is appropriate to consider objectively which parts of the current system are essential, what might be done more efficiently, and what could be omitted altogether in a system being designed from a new and broader international perspective. The system should also allow flexibility in processing, leaving as much detail as possible to the Regulations, Administrative Instructions or to guidelines, recognizing that the needs of the system in another 25 years' time may not be the same as those today.

THE ESSENTIALS OF A NATIONAL OPTION FOR INTERNATIONAL SEARCH AND EXAMINATION

10. The fundamental nature of patent search and examination, including international search and examination under the PCT, is well established and widely accepted, and is unlikely to change: an examiner attempts by a search to discover the prior art which is most relevant to a claimed invention and, using the results of the search, determines whether the application meets defined standards in respect of novelty, inventive step and other matters. However, within this broad scope, there is room for consideration of most of the details concerning when, whether, where, how, and according to what criteria, search and examinations should be carried out on an international application. In addition, the effect of any search and examination should be considered with respect to the future life of the patent application, both internationally and under the different national systems in which it may have effect, including those in developing countries and States without examining Offices. Some of these aspects are further explored in the following paragraphs.

THE RESULT OF SEARCH AND EXAMINATION

11. The present system provides for the establishment of a mandatory international search report, typically around 16 months from the priority date, and an optional international preliminary examination report, typically around 28 months from the priority date.
12. The objective of the international search is to discover relevant prior art. As a principle, the only question which need be asked for this is whether the definition of “relevant prior art” is appropriate to the needs of any international examination and, in turn, of the national and regional systems under which patents may eventually be granted. Of course, in attempting to achieve the objective, practical matters such as timing of the search, the documentation considered and the methodology of the search need to be considered; some of these issues are raised below.
13. The international preliminary examination report always contains an opinion on novelty, inventive step and industrial applicability, as defined in the Treaty, and, depending on the practice of the Authority concerned, may contain an opinion on a range of other matters including defects in form or contents, whether amendments go beyond the disclosure in the application as filed, clarity of the description, claims and drawings, and whether the claims are fully supported by the description.
14. The objective of the international preliminary examination is expressly to formulate a “preliminary and non-binding” opinion on the criteria of novelty, inventive step and industrial applicability. The Treaty also makes it expressly clear that Contracting States have freedom to apply additional or different criteria when deciding whether an invention is patentable or not (Article 33(5)), that the international preliminary examination report is not to contain any statement on the question whether the invention is or seem to be patentable or unpatentable under any national law (Article 35(2), and, more generally, that nothing in the Treaty is intended to limit the freedom of Contracting States to prescribe their own criteria in respect of substantive conditions of patentability (Article 27(5)).
15. That being said, the PCT criteria in fact differ little from the criteria for patentability applicable to patent applications and patents under national and regional patent laws, and according to which examination reports are prepared by those Offices which conduct substantive examination applications. It needs to be recognized, of course, that there are differences among substantive patent laws as to the meaning and application of those criteria, but it must equally be acknowledged that there is also a great degree of commonality (even without any further harmonization that may come as a result of the ongoing discussion of a draft Substantive Patent Law Treaty by WIPO’s Standing Committee on the Law of Patents).
16. The terms “preliminary” and “non-binding” used in the PCT to describe the international preliminary examination procedure are closely related but nevertheless distinct from one another. “Non-binding” means that States are free to accept or reject the result of the examination. The term “preliminary,” on the other hand, suggests that there may be further work left to do before a complete view on patentability can be taken. It is possible that the non-binding nature of the procedure could be maintained while at the same time enhancing the possibilities for an applicant to obtain an opinion which is “more final” (or at least “less preliminary”) in the sense that there could be greater opportunities for obtaining a fully positive report before entering the national phase of processing.

17. Most applicants using the international patents system would like to see a positive international search and examination report be followed by international grant, whether as a true international grant or as national grants following more or less automatically from such a report – that is that both the preliminary and then on – binding natures of the international examination would be reduced. However, there are significant political and practical difficulties which would need to be overcome for this to happen, other than by the more widespread acceptance by national Offices unilaterally that a positive international examination report will normally mean that an application is in order for national grant. Some of the wishes and challenges are set out in greater detail in paragraphs 187 to 199 of document A/37/6 (“WIPO Patent Agenda: Options for Development of the International Patent System”). For the purposes of this document, it is merely necessary to note the general points set out in the following paragraphs.

18. Substantive patent laws are not fully harmonized and it is neither practical nor desirable for an international system to cater specifically for each individual national law. Consequently, it might be considered that any international examination will inevitably be “preliminary,” unless the national definition of patentability happens to coincide exactly with the standards applied to international examination. However, in practice, as pointed out above, the variation in laws in most respects, including novelty and inventive step, are small. Furthermore, it may be possible to allow international examination reports to make comments on a strictly limited range of options within less harmonized matters which are particularly likely to affect national laws which are not presently commented on (see Article 35(2) and Rules 66.2 and 70.12, as well as paragraph 31, below); for example, whether claims relate to surgical methods, plants or animals (in the case that the Authority carries out search and examination in relation to such matter – otherwise the matter is in any case explained as the reason for which search or examination has not been carried out). This could make an international examination report more useful, particularly to States which apply these types of exclusions. While this would, of course, make international examinations slightly more complex, it could eliminate the need for separate subsequent consideration in many States, provided that any claims which failed to meet criteria relevant under their particular law were abandoned before grant in the State concerned.

Granting national patents

19. Even if the examination can be improved so that it is less preliminary in nature, it is likely to be essential for the foreseeable future that it remain, in general, non – binding, leaving the decision on whether or not to grant a patent to the national Office of each State. On the other hand, it would remain open to States to make the system more efficient by choosing to accept the results of international examination. This could be done informally simply by unilaterally deciding to grant patents on the basis of a positive international examination report (or one which reported only potential defects which are not in fact relevant to the law of that State). Alternatively, an optional chapter or protocol could be added to the Treaty, providing a formal agreement to the same effect. Some of the possibilities are set out below.

20. One possibility is simply the formalization of the process, which is already common in many States, whereby a positive international examination report would result in automatic grant in participating States, subject to completing formalities such as payment of fees and provision of any necessary translation. Alternatively, as systems similar in some way to that

under the Madrid Protocol² could be used, where in an application which was found to meet the appropriate criteria would be the subject of an international grant, which had an equivalent effect to grant in a participating national Office, subject to the right of each State to subsequently cancel the grant within a certain period if it was found to fail to meet the relevant national criteria (in addition, of course, to forms of proceedings for revocation after grant which might apply to conventional domestic patents).

21. In either case, if the international examination report was enhanced to include a statement of whether the subject matter of the application related to any of the areas where conditions of patentability commonly differ significantly (for example surgical methods, plants or animals), each State could make reservations in respect of such subject matter, so that applications where such matter had been noted in the examination report would not be subject to the automatic or central grant procedure in respect of that State.

22. Such a system could be of particular benefit to smaller Offices, including those in developing countries. This would allow them to implement a system where fewer patents would be granted which failed to meet the national criteria for patentability and, where appropriate, allow them to focus the resources of their national Office on the limited number of applications where the report indicated that a condition which is relevant to the national law may exist.

23. If a formal system of recognition were adopted, it might also be appropriate to consider the introduction of an international opposition system, which again might be possible through the use of protocols. This possibility is not discussed in detail, but some of the advantages would be similar to those considered above in respect of international examination at a later stage of granted patents (see paragraphs 40 to 43, below).

ACTIONS PERFORMED AS PART OF SEARCH AND EXAMINATION

24. As noted above, changes could be introduced to make the results of international search and examination more useful. Some such options are considered below. While it appears that these could, at least in part, be implemented by amendments to the Regulations under the existing Treaty, it is, at present, not intended to introduce proposals for amendments only of the Regulations, in particular in view of the facts that they would introduce extra work for International Authorities, which the Committee on Reform of the PCT considered inappropriate at the present time and noting that their benefits may be achieved most effectively only in cooperation with other enhancements, which would require amendments, or a protocol, to the Treaty.

Multiple searches; additional examination

25. The Committee on Reform of the PCT, in its first meeting, considered the question of allowing applicants the option of requesting searches by several International Authorities (see document PCT/R/1/26, paragraphs 109 to 146). While there was some support, the general conclusion was that this was undesirable duplication of work and inappropriate, at least while some International Searching Authorities had difficulties with existing workloads. For the moment, it would be better to concentrate on improving the search tools available and

² Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

promoting consistency. It was noted that applicants were at liberty to commission further searches outside of the PCT system if they wished.

26. However, considering the longer term, a number of States pointed out that systems could be arranged where additional searches clearly added value. For example, it may sometimes be desirable for searches performed by the European Patent Office or the United States Patent and Trademark Office to be supplemented by a “complementary search” performed by the Japan Patent Office or Rospatent of their Japanese or Russian language collections, respectively. If such a system were introduced, it might also be desirable for an Authority performing such an additional search to include an opinion on how any new documents found, which did not have equivalents in the main search report, affected the novelty or inventive step of the application. Such an opinion might then be annexed to the opinion produced by the main Authority, without the difficulty of the confusion which would be caused by a complete new opinion. It is likely that such additional searches and written opinions could be provided for by means of amendments to the Regulations under the existing Treaty.

“Top-up” searches

27. As pointed out above, international search at present typically takes place around 15 months from the priority date of the application. As long as the international application’s priority date is valid, this is usually adequate for determining novelty and inventive step in relation to the prior art defined by Rule 64.1, since only material published before the “relevant date” may be considered. However, in most States, patent documents published after that date may also be relevant to novelty and/or inventive step if they have an earlier priority date. This can be extremely important in many fast-moving technologies.

28. Rules 33, 64.3 and 70.10 make some allowance for inclusion of such documents within the reports. However, at the time that international search is performed, these documents may not yet have been published, or else might otherwise not have become available to the International Authority. A “top-up” search at a later stage in the international phase may eliminate the need for this check to be made by individual States and allow relevant documents to be brought to the attention of applicants at a point where appropriate amendments can still be made and examined centrally, if so desired, making the international preliminary report on patentability more useful for both applicants and Offices of elected States, particularly non-examining Offices. Performing the entire search at this stage would of course eliminate this extra step. However, it should be noted that this would also delay the start of examination; furthermore, many users of the system value these search reports being available before international publication for the applicant and being part of the international publication for informing third parties (see paragraph 36). The increasing use of electronic publication means that associating searches (whether original searches or top-up searches) with international publications which occurred earlier will, however, become easier in the future.

29. It is likely that top-up searches could also be introduced as a part of the international preliminary examination procedure by means of amendments to the Regulations under the existing Treaty. This would need to be accompanied by a review of the “other observations” which may accompany the international preliminary examination report according to the regulations made under Article 35(2).

Scope of examination reports

30. The primary function of the international preliminary examination report is to provide an opinion on novelty, inventive step and industrial applicability, as defined by the Treaty. While the tests for these requirements differ slightly around the world, in practice, it would appear that there is very little difference in the outcomes of these tests in any particular case. On the other hand, there are other areas where the differing tests, although relevant only to a small minority of patent applications, have very significant differences with regard to patentability in different States. Examples of this include patents for surgical methods, plants or animals and views on what constitute technology.

31. Clearly, greater harmonization of national patent laws would make it easier for the PCT to provide examination reports which were closely aligned with national requirements. However, in the meantime, without going into the individual laws of each State, it may be desirable for international examination reports to comment on such aspects where practice varies. At present, Rules 39 and 67 set out certain subject matter which International Authorities are not obliged to search or examine, which cover most, if not all, of the relevant areas. Where the Authority chooses not to perform a search or examination, this will be explained. However, in the case that a search or examination is carried out, there may be no indication in the international preliminary report on patentability that the application may be considered to contain such subject matter. A readily identifiable indication that the patent does not relate to potentially excluded matter need not be a great burden for the International Preliminary Examining Authority and may give States greater confidence in using the results of the international examination directly, or, where appropriate, in identifying those cases where greater scrutiny of the application in accordance with the relevant national law is likely to be necessary. This would clearly be beneficial to States where such limitations exist and which have non-examining Offices, and could also be used to reduce the burden on examining Offices. Such a change may be possible simply by amending the Regulations (primarily Rules 66 and 70).

TIMING OF SEARCH AND EXAMINATION

32. The timing of search and examination is not a fundamental principle of patent law but is fixed according to a balance of interests that need to be viewed in the light of the conditions of the time. Consequently, it would be desirable for a revised Treaty to merely establish the fundamental criteria that an international patent application is expected to meet, leaving the Regulations to determine the timing and the extent to which these conditions must be tested during the international processing of the application.

33. The amendments adopted by the Assembly in 2002 recognize that it is significantly more efficient to perform the first examination of a patent application at the same time that it is searched. It is unlikely that changes in methods of working will change that conclusion in the future. However, questions of timing, with regard to both the start of the process and whether search and examination are performed together, or whether they are essential in all cases, need to take several further issues into account, as outlined in the following paragraphs.

Does every patent application need to be searched and examined?

34. At present, an international search is carried out on every international application and, under the enhanced international search and preliminary examination system, a first examination report will also, in effect, be carried out on every application. However, by no means all patent applications have significant commercial value, and for those which are commercially unimportant to patentees and third parties, a great deal of work is therefore performed in ensuring that patents are valid covering inventions which no competitor would in any case wish to exploit. Some States have patent systems where unexamined rights are registered, requiring examination only when it is desired to enforce the rights or on request by a third party who wants to be certain of the scope of those rights.

35. The PCT needs to offer an efficient route of access to patent systems in all of the Contracting States, taking into account the different forms which exist. At the moment, the requirement of full search and examination in all cases for a significant number of States suggests that as much of this work as possible ought to be done in the international phase to avoid duplication. However, as part of a wider review of patent procedures in coming years, States may wish to consider the degree to which full search and/or examination of every patent application is essential prior to grant. Without reviewing in this paper the questions concerning balancing efficient processing and certainty for both applicants and third parties, which would affect the outcome of any such national review, it may be prudent to create a framework which could be adjusted to provide the international system which overall best suits the national frameworks into which it feeds, whatever these may be at the time.

Importance of early search

36. Users stress that, for international applications which are likely to be commercially valuable, it is particularly important, both from the point of view of applicants and third parties, to ensure that a high quality international search report is established before international publication and that timely issuance of the international search report should not be delayed by other processing requirements.

Should (full) international examination be compulsory?

37. A significant proportion of users at present do not wish to pursue international examination and have called for this part of the PCT procedure to remain optional, rather than tying the examination even more closely to international search. It may be observed that the recently adopted amendments to the system effectively make at least the early stages of international examination compulsory. On the other hand, many States, particularly developing countries and those without (national or regional) examining Offices, wish to see full international examination of a large proportion of, or even of all, international applications. It would seem most appropriate to overcome this apparent conflict of interests by seeking to strengthen the international phase, including international examination, rather than weakening it, such that States would be more likely to accept the results of the international procedure without further unnecessary examination in the national phase; use of the PCT system with a strengthened international phase would thus become the most efficient and desirable way for applicants to gain rights internationally.

Overall timescale of international phase

38. The amount of time which the international applications spend in the international phase before having to be converted into national applications is, again, a balance of interests. One of the major benefits of the system to applicants is that it provides a significantly longer period than the Paris Convention route to consider the importance of the invention (having regard to its novelty and inventive step, possible further developments and other matters of commercial viability) before committing to the time and expense of preparing national applications. It is also necessary to consider how long is required to perform effectively any international search and examination. Against this is the desire of third parties to know at the earliest opportunity what the scope of protection will be and in which States protection will exist.

39. Given that, in many States, further national examination must take place before any patent is granted, this final point suggests that it would be difficult to justify any significant further extension of the international phase in its current form. However, this might change if improvements to the international examination were introduced such that the time involved in national processing could be reduced, or even perhaps in some cases eliminated, with national patents being granted with little or no extranational examination, as is described in paragraph 19, above. If the international phase were to be extended to achieve such a purpose, it might lead overall to earlier certainty in the scope of rights granted around the world following from the international application.

The possibility of international (re-)examination during the national phase

40. States may also wish to consider whether, and if so in which cases, the Treaty should allow for international examination at a later stage, following national phase entry, for example, following the discovery of prior art which was not found during the international search. It is likely that this would be an optional service, in the sense that it would remain up to individual States to decide whether to use the service and what recognition, if any, should be given to the results of such a later examination.

41. International examination of granted patents, or of applications in respect of which national processing had already begun, would mean the end of the current arrangement where the international and national phases are, at least for the vast majority of international applications, relatively distinct. Properly implemented and used, this could have significant advantages for patentees and third parties alike, allowing reassessment of patents in the light of previously undiscovered prior art, and the opportunity to make appropriate amendments centrally, thereby avoiding expensive litigation.

42. Furthermore, such a system could be of particular value to developing countries and small Offices which may not have the capacity to make such assessments and could be a significant aid to national courts in providing a neutral opinion as to validity when cases do go to court. On the other hand, it would imply a significant change of approach in States where, under the present system, significant examination is commonly undertaken during the national phase, requiring applications to be brought into a form different from that of the international application which has been the subject of a positive international preliminary examination report before a patent is granted. Careful study would be required to determine whether and, if so, how national and international systems could work effectively in parallel. Other complicating factors would also need to be considered, such as that the patents in different

States may have been assigned to different people, whomay have different views on the need for re-examination, or the appropriate way in which to overcome any difficulties which were raised.

43. International examination at a later stage need not necessarily be limited to applications which had begun as international applications. In the same way that Article 15(5) at present allows for the possibility of an "international -type search" the provisions might be extended to allow international -type examination of national patents. This would allow uniform treatment of patents in States with non -examining Offices, irrespective of whether applications had been made by the national or international route.

Means of effecting changes in timing and optional nature

44. At present, the Treaty makes it clear that, subject to very limited exceptions, an international search is mandatory for all international applications and that full international preliminary examination takes place only at the demand of the applicant. Any change to this would require an amendment to the Treaty. On the other hand, the timing of international search and, where a demand is made, international preliminary examination are set out in the Regulations and could easily be amended, within the limits imposed by the requirements of the Treaty.

45. In the case of introducing international (re -) examination at a later stage, this could be done in two ways. It could be the subject of an amendment to the Treaty. Alternatively, since, as noted above, it would necessarily be an optional process, which need not have effect in all Contracting States, it could be the subject of an optional protocol, to be ratified by those States which wished to use the results. In either case, an amendment would also be required to the agreement between the International Bureau and at least one International Authority prepared to carry out such new work.

QUALITY AND CONSISTENCY OF INTERNATIONAL SEARCH AND EXAMINATION

46. Consideration will also need to be given to whether any revision of the Treaty would need to update provisions concerning the quality and consistency of international search and examination under the PCT system, such as allowing for ensuring the application of common standards and development or use of common tools and databases for search. However, this paper does not address these issues in detail, pending the outcome of current related initiatives, such as the work of the PCT quality framework "virtual" task force and the consideration by the Meeting of International Authorities under the PCT of the minimum documentation requirements and new draft International Search and Preliminary Examination Guidelines.

EXAMPLES OF POSSIBLE SYSTEMS

47. The Annex to this document sets out a number of simple examples of possible systems, illustrating different ways of approaching some of the issues outlined in this document. Each example assumes that applications will be published 18 months from the priority date which, of course, might itself be reviewed as part of the creation of any revised system. All examples consider a "typical" application, based on a priority application 12 months before the filing date and not taking into account complications such as divisional applications. Such other

factors would, of course, need to be addressed in tandem with any detailed proposals for revision of the search and examinations system.

48. The Working Group is invited to consider and discuss options for the future development of the international search and examinations system, having due regard to the matters raised in this document.

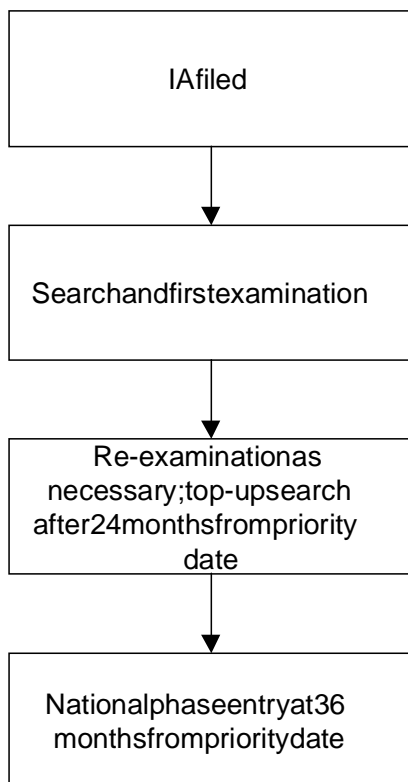
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ANNEX

EXAMPLES OF POSSIBLE SYSTEMS

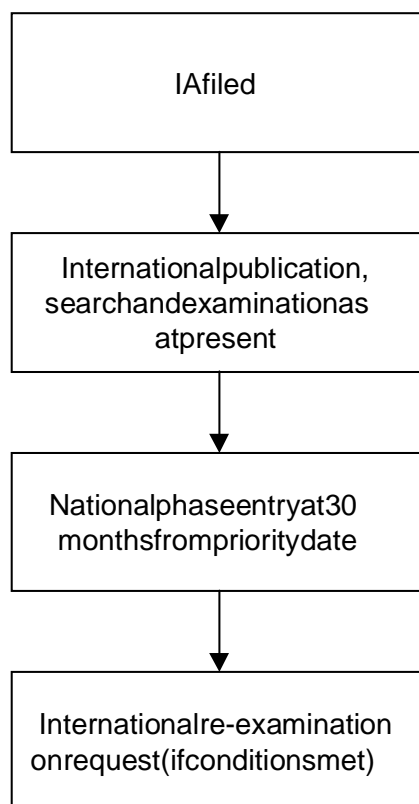
EXAMPLE A

SYSTEM WITH TOP-UP SEARCHES AND FURTHER EXAMINATION



1. This example shows a system with an international phase extended by six months. This time would be used to permit further search and examination actions during the international phase, including a top-up search (see paragraphs 27 to 29 of the main document). The examination report might also be broadened to include specific statements of whether or not any of the subject matter relates to matters where national laws significantly vary, for example, whether the claim in invention is a surgical method or a plant (see paragraphs 30 to 31 of the main document).

EXAMPLE B
SYSTEM ALLOWING POST-GRANT RE-EXAMINATION

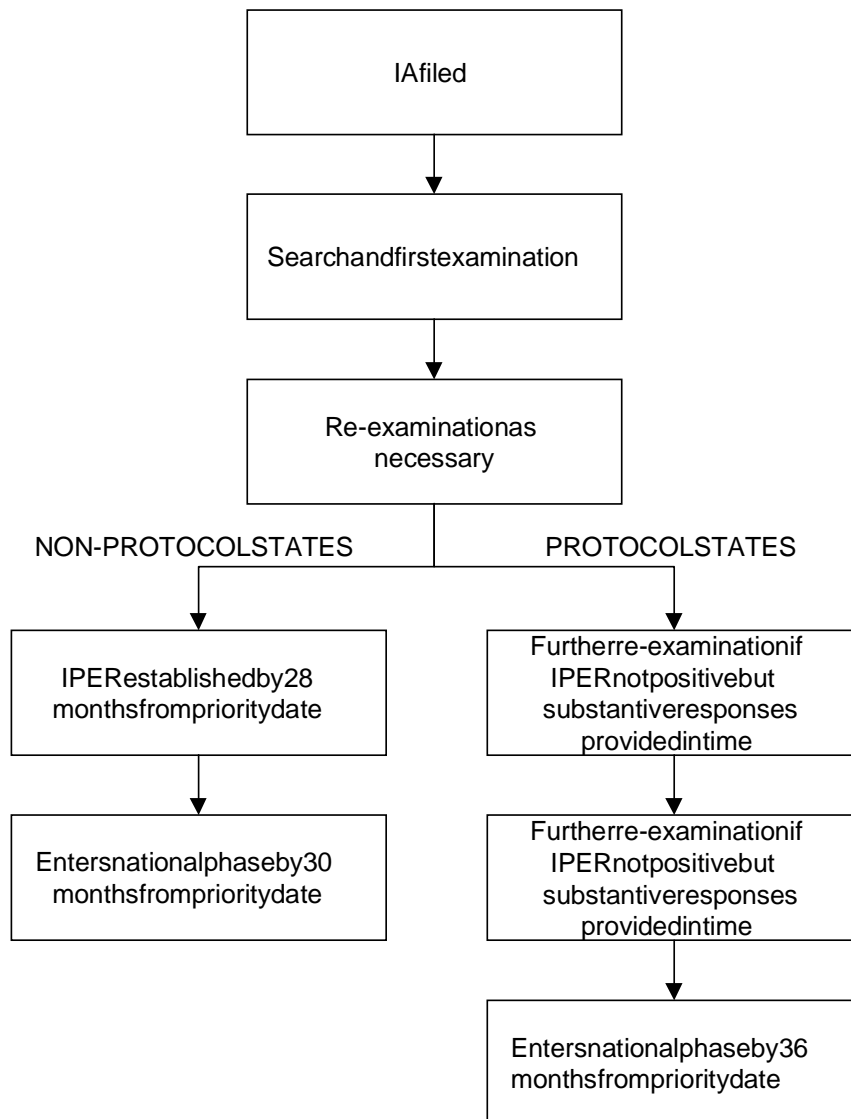


1. In this example, the timing and content of the international phase is similar to that at present, but the system allows for international examination to be requested later on international applications for which patents may already have been granted in certain cases, for example where new prior art has been found which may affect the novelty or inventive step of the invention (see paragraph 41 of the main document). It would be necessary to allow such requests even after the patent has lapsed where infringement proceedings are still possible.

2. Several possibilities could be envisaged with respect to how the re-examination is requested. This might only be permitted at the request of a Contracting State, or else it might also be permitted at the direct request of the owner of the patent, or even of a third party.

3. The patentee would be permitted to file amendments, following a similar process to pre-grant examination, but with additional rules ensuring that amendments were not permitted to extend the scope of protection, and possibly with more stringent time limits for response. As with current international preliminary examination reports, Member States would take such a report into account for the purposes of national invalidity or amendment proceedings, but need not be bound by it.

EXAMPLE C
SYSTEM WITH OPTIONAL FURTHER EXAMINATION



1. In this example, a protocol is added to the existing Treaty, allowing for further processing in the international phase. If the international preliminary examination is being carried out by an Authority which so permits, the applicant can request further examination, allowing a limited extra period within which to conduct further rounds of amendment or argument, with a view to the application being brought into a state which would achieve a positive international preliminary examination report. If this is not complete within 28 months from the priority date, an international preliminary examination report is established automatically on the basis of the latest written opinion for the purpose of the States which are not party to the protocol. However, the international application will not yet enter the national phase in those States which have ratified the protocol.

2. Once the international application meets the requirements of novelty, inventive step and industrial applicability as defined in the Regulations, a final international examination report is issued, if necessary endorsed with comments, noting the existence of certain subject matter

where conditions of patentability vary considerably around the world (see paragraphs 30 and 31 of the main document). This will normally result in a patent being granted without further examination in any of the States party to the protocol.

3. If the application still does not meet the requirements of novelty, inventive step and industrial applicability within 34 months from the priority date, a final report similar to the international preliminary examination report will be established and the international application will enter the national phase as usual. In order to prevent this process from being abused by simply buying time before entry to the national phase, the final report and national phase would be triggered earlier in the event of the applicant failing to provide a substantive response to a written opinion within the specified time. al

[End of Annex and of document]