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IMPROVING THE QUALITY OF INTERNATIONAL SEARCHES

Document prepared by the International Bureau

BACKGROUND

1. At its fourth and fifth sessions, the Working Group gave preliminary consideration to options for future development of international search and examination (see documents PCT/R/WG/4/7 and PCT/R/WG/5/9 and the summaries by the Chair in document PCT/R/WG/4/14, paragraphs 82 to 91 and document PCT/R/WG/5/13, paragraphs 112 to 127). Most delegations considered that the effects of the new enhanced international search and preliminary examination system should be assessed before considering further fundamental changes to the international search and examination system. However, a number of delegations expressed an interest in exploring possible measures which might improve the quality and usefulness of international search and examination reports separately from the question of what effect those reports might have.

2. If national Offices are to make effective use of international search and preliminary examination reports, the quality and completeness of reports and the degree of confidence which can be placed in them are important issues. It is also necessary that it be feasible for the International Authorities to establish such reports within the required timescale (in line with the needs of both applicants and third parties), with high quality and at a reasonable cost.

3. This document considers the possibility of introducing further features into the search procedure under the PCT, to permit a more complete retrieval of relevant prior art during the international phase. As a consequence, written opinions and international preliminary reports on patentability prepared by International Authorities would become more effective, since they would have additional prior art on which to assess whether claimed inventions appear to be novel and to involve an inventive step.

SUPPLEMENTARY SEARCHES BY OTHER INTERNATIONAL SEARCHING AUTHORITIES

Policy Benefits of Increased Searching

4. The Committee on Reform of the PCT (“the Committee”), at its first session, considered the possibility of allowing applicants the option of requesting international searches by more than one International Searching Authority (see document PCT/R/1/26, paragraphs 109 to 146). At that time, a number of States considered that such searches (“supplementary international searches”) would add considerable value to the international procedure for applicants, national Offices and third parties alike. From the Member States’ point of view, it is clear that proper consideration of a wider range prior art must be beneficial to the extent that it reduces the risk of granting patents which are invalid because of disclosures which might not have been considered by the main International Searching Authority. This may be of particular concern in the case of inventions in fields which are not currently well documented by patent publications or other matter which falls within the PCT minimum documentation.

5. On the other hand, it is also necessary to consider whether the degree to which the search may be improved is proportionate to the expense and effort which would be involved. Concern was expressed by some States, during the above-mentioned first session of the Committee, at possible unnecessary duplication of work, particularly in view of the workload difficulties of some Authorities. However, it was noted that supplementary international searches could be complementary, rather than duplicative. For example, it may sometimes be desirable for international searches performed by the European Patent Office or the United States Patent and Trademark Office to be supplemented by a supplementary international search performed by the Japan Patent Office, the Russian Agency for Patents and Trademarks or the Spanish Patent and Trademark Office, respectively, of their Japanese, Russian or Spanish language collections, since most Authorities are required to search patent documents in these languages only if English language abstracts are available, and they would generally use primarily such abstracts for search purposes, rather than the original documents. Furthermore these Authorities may have access to non-patent documents which might be overlooked by the primary International Searching Authority because they were not in, or accompanied by an abstract in, an official language of that Authority.

6. The Annex contains a preliminary draft of possible amendments of the Regulations, designed to illustrate how a system of supplementary international searches might be implemented.

Possible System as Seen by Applicant

7. From the point of view of the applicant, this system would involve simply:

(a) in the request, choosing the primary International Searching Authority (if more than one is competent) and specifying any further Authorities from which supplementary international searches are desired;

(b) paying the appropriate fees and furnishing any translations of the international application necessary for the Authorities to conduct the international search or supplementary international searches;

(c) if the primary International Searching Authority finds that unity of invention is lacking, paying any additional fees requested (assuming it is desired that the additional inventions be searched).

8. The international search report and written opinion would be transmitted to the applicant at the same time as at present, followed later by the supplementary international search reports and, if new prior art is found, written opinions. It is assumed in this draft proposal that most applicants would prefer to receive the results of each search as soon as it becomes available, rather than waiting several months beyond the current time (and almost always until after international publication) to receive all the search results together in a single document.

Possible System in Greater Detail, Including Actions Transparent to Applicants

9. In more detail, explaining the actions of each of the authorities and individuals concerned, the system would involve the following actions and features:

– *Authorities Prepared to Provide Supplementary International Searches*

(a) Each International Searching Authority which is prepared to provide supplementary international searches (a “participating” Authority) notifies the International Bureau to that effect, including notification of any limitations on the circumstances in which it is prepared to carry out such supplementary international searches, beyond that of the subject matter which the Authority is not required to search under Rule 39.1 (for example due to a temporary limited capacity to carry out such supplementary international searches in certain fields of technology).

– *Request, Fees and Translations*

(b) The applicant includes, in the request under Rule 4, a request that one or more supplementary international searches be carried out, and indicates the participating Authority or Authorities from which such searches are desired.

(c) The request for one or more supplementary international searches is subject to a an additional component in the international filing fee (to cover publication and translation costs; this would be set out in the Schedule of Fees and is not included in this draft proposal) and to a supplementary search fee for the benefit of each participating Authority concerned.

(d) The receiving Office checks whether any translation is required by a particular International Searching Authority and, if necessary, invites the applicant to furnish one. It then transmits the request (which includes the request for supplementary international search) to each participating Authority concerned, together with a copy (or translation) of the international application.

– *Establishing, Transmitting and Publishing the Supplementary International Searches*

(e) The International Bureau transmits the international search report and written opinion of the primary International Searching Authority, as soon as they have been established, to each participating Authority concerned.

(f) The participating Authorities concerned each establish a supplementary international search report within three months of receipt of the last of the necessary documents from the receiving Office and International Bureau. This will typically be around 19 months after the priority date: too late to be published in or with the pamphlet, but in time to permit consideration by the applicant of the results, and to file amendments under Article 34 (if a demand for international preliminary examination is made) following such consideration, before any international preliminary examination commences. Any supplementary international search reports which are available in time for international publication are included in the pamphlet; the others are published together as a further document once all are available.

(g) The participating Authority is not required to establish a supplementary international search in respect of subject matter for which it is not required to establish international searches under Article 17(2).

(h) The primary purpose of the supplementary international search is to find documents in languages in which the Authority concerned has a particular skill and which might not have been consulted by the primary International Searching Authority. As a result, the supplementary international search usually covers only documents in the collection of the Authority concerned which are in an official language of that Authority and do not form part of the minimum documentation (since the latter material should already have been considered by the primary International Searching Authority). The main exception to this would be that the supplementary international search covers those parts of the minimum documentation which are in an official language of the Authority concerned where it is likely that the primary International Searching Authority will have searched those parts on the basis of English-language abstracts only (as would be common for Japanese, Russian and Spanish language documents, for example; see paragraph 5 and the comment under proposed Rule 45bis.4(b)).

(i) To avoid uncertainty from conflicting views from two Authorities at the same stage, the supplementary report does not re-cite any document which has been cited by the primary International Searching Authority (including apparently “equivalent” patent publications, unless relevant further disclosure is found in such a family member).

– *Unity of Invention*

(j) To avoid complication and uncertainty, each participating Authority concerned accepts the opinion of the primary International Searching Authority concerning unity of

invention (see also paragraph 10, below): where the primary International Searching Authority finds unity of invention, the supplementary international search covers all claims (subject to other limitations, such as those in respect of subject matter); where a lack of unity is found, the supplementary international search is established only on the first invention identified unless additional fees are paid before the supplementary international search is commenced.

– *Supplementary Written Opinions*

(k) If, but only if, the participating Authority concerned discovers further relevant documents, it also establishes a supplementary written opinion, covering only the question of novelty and inventive step in relation to those further documents (in combination with documents already cited in the international search report if necessary). Like the supplementary international search report not re-citing documents from the primary international search report (see item (i), above), this avoids duplication and the uncertainty which would be caused if differing opinions on the same subjects were provided both at the same stage. This supplementary written opinion is appended to the written opinion of the primary International Searching Authority before that opinion is either considered by the International Preliminary Examining Authority during international preliminary examination or else used by the International Bureau in establishing the contents of the international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty).

– *Effect on International Preliminary Examination*

(l) The time limit for making the demand under Rule 54*bis*.1(a) (if desired), and hence for starting international preliminary examination under Rule 69.1(a) (unless the applicant requests an earlier start), is not less than one month from the date of transmittal to the applicant of a copy of the supplementary international search report and of any supplementary written opinion by the participating Authority.

(m) Where a supplementary international search discovers prior art which was not included in the international search report, it is not necessary, merely because of that, for the International Preliminary Examining Authority to issue a written opinion before establishing the international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty) since the relevance of that prior art will have been indicated in a supplementary written opinion.

International Applications Where Lack of Unity of Invention is Found

10. With regard to international applications where a lack of unity of invention is found, it seems essential that the primary International Searching Authority's opinion on unity of invention be accepted for the purposes of the supplementary international searches; a system where each participating Authority concerned reviewed the matter while still at the search stage would be untenable. Where the primary International Searching Authority invited the applicant to pay additional fees under Rule 40 for the search of one or more additional inventions, it would also invite the applicant to pay equivalent fees to any participating Authorities concerned, who would conduct their supplementary international searches to the extent that fees had been paid prior to the commencement of the supplementary international search, as described in paragraph 9(j), above.

UPDATING THE SEARCH DURING INTERNATIONAL PRELIMINARY EXAMINATION

11. Another reason that the international search may not be complete is because of the time at which it is performed. The international search typically takes place around 15 months from the priority date of the international application. If the 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 written disclosures made available to the public before the "relevant date" may be considered for this purpose. However, in most Contracting 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 fast-moving technologies.

12. Rules 33, 64.3 and 70.10 make some provision for such documents to be covered by the international search and to be reported in the international preliminary report on patentability. However, at the time when the international search is performed, these documents may not yet have been published, or for other reasons might not have become available in the International Authority's search collection. If the search were updated later on, during any international preliminary examination which may be carried out, to discover documents which may not have been available to the International Searching Authority at the time of the international search, it might eliminate the need for an equivalent 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. This would make the international preliminary report on patentability by the International Preliminary Examining Authority more useful for both applicants and elected Offices, especially Offices without the capacity to perform such checks themselves.

13. Draft Rule 66.1^{ter}, shown in the Annex, illustrates how searches might be updated within the international phase by the International Preliminary Examining Authority while conducting the international preliminary examination.

14. This aspect of the system would not require any new actions on behalf of the applicant. According to this draft rule, the international search would be updated by the International Preliminary Examining Authority for every international application for which international preliminary examination is demanded. By this stage, all relevant documents would usually be in the search documentation available to the International Preliminary Examining Authority, so that it should not be necessary for elected Offices to repeat this process in the national phase, at least to the extent that patent documents relevant to a Contracting State (or equivalents from the patent family) are held by that Authority.

15. The Working Group is invited to consider the proposals contained in the Annex to this document.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹

SUPPLEMENTARY INTERNATIONAL SEARCHES

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

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Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) and (b) [No change]

(c) The request may contain:

(i) and (ii) [No change]

(iii) declarations as provided in Rule 4.17_a.

(iv) a request for restoration of the right of priority.

[COMMENT: Item (iv) would be included only if the proposals in document PCT/R/WG/6/1, relating to restoration of the right of priority, proceed at the same time as the present amendments.]

(v) a request for one or more supplementary international searches as provided in

Rule 45bis.1.

4.2 to 4.18 [No change]

Rule 11

Physical Requirements of the International Application

11.1 *Number of Copies*

(a) [No change]

(b) Any receiving Office may require that the international application and any of the documents referred to in the check list (Rule 3.3(a)(ii)), except the receipt for the fees paid or the check for the payment of the fees, be filed in two or three copies. Any receiving Office may further require that an additional copy of the international application be filed for each International Searching Authority from which a supplementary international search is requested under Rule 45bis.1. In ~~that~~ those cases, the receiving Office shall be responsible for verifying the identity of the second and ~~the third~~ any further copies with the record copy.

11.2 to 11.14 [No change]

Rule 12

**Language of the International Application
and Translation for the Purposes of International Search
and International Publication**

12.1 to 12.3 [No change]

12.3bis Translation for the Purposes of Supplementary International Search Under Rule 45bis

(a) Where the language in which the international application is filed or any translation furnished under Rule 12.3(a) or 12.4(a) is not a language accepted by an International Searching Authority that is to carry out a supplementary international search under Rule 45bis, the applicant shall furnish to the receiving Office a translation of the international application into a language which is accepted by that Authority, prior to the expiration of whichever of the following period expires later:

(i) three months from the date of receipt of the international application by the receiving Office; or

(ii) nine months from the priority date.

[Rule 12.3bis(a), continued]

[COMMENT: The translation for supplementary international search is not needed as early as that for the international search (which must be furnished within one month from the date of receipt of the international application by the receiving Office), but should be available to the Authority concerned by the time that the international search report would normally be established under Rule 42.1, so that the supplementary international search can be started promptly, especially in the case where the full priority 12 months has been used and international publication is imminent.]

(b) Paragraph (a) shall not apply to the request nor to any sequence listing part of the description.

[COMMENT: Modeled on Rule 12.3(b).]

(c) Where, by the time the receiving Office sends to the applicant the notification under Rule 20.5(c), the applicant has not furnished a translation required under paragraph (a), the receiving Office shall, preferably together with that notification, invite the applicant:

(i) to furnish the required translation within the time limit under paragraph (a);

(ii) in the event that the required translation is not furnished within the time limit under paragraph (a), to furnish it and to pay, where applicable, the late furnishing fee referred to in paragraph (e), within one month from the date of the invitation or four months from the date of receipt of the international application by the receiving Office, whichever expires later.

[COMMENT: Modeled on Rule 12.3(c)]

[Rule 12.3bis, continued]

(d) Where the receiving Office has sent to the applicant an invitation under paragraph (c) and the applicant has not, within the applicable time limit under paragraph (c)(ii), furnished the required translation and paid any required late furnishing fee, the request for supplementary international search shall be considered withdrawn and the receiving Office shall so declare. Any translation and any payment received by the receiving Office before that Office makes the declaration under the previous sentence shall be considered to have been received before the expiration of that time limit.

[COMMENT: Modeled on Rule 12.3(d).]

(e) The furnishing of one or more translations after the expiration of the time limit under paragraph (a) may be subjected by the receiving Office to the payment to it, for its own benefit, of one late furnishing fee equal to 25% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

[COMMENT: Modeled on Rule 12.3(e). The procedures for checking receipt of translations and accepting late payments are closely modeled on those for the translation for the purposes of international search under Rule 12.3. In line with the proposals in respect of late furnishing fees for different formats of sequence listings (See PCT/R/WG/6/2), it seems appropriate to require only one (if any) fee where several translations for the purposes of supplementary international search are furnished late. However, given the very different time limits under Rules 12.3(a) and 12.3bis(a), the furnishing of translations for the international search and any supplementary international searches should be considered separate procedures within the receiving Office and this late furnishing fee may therefore be required in addition to any late furnishing fee in respect of a translation for the purposes of the primary international search.]

12.4 [No change]

Rule 16

The Search Fee

16.1 [No change]

16.1bis Supplementary Search Fee

(a) Each International Searching Authority which notifies the International Bureau under Rule 45bis.8 that it is prepared to carry out supplementary international searches may require that the applicant pay a fee (“supplementary search fee”) for its own benefit for carrying out the supplementary international search and the other tasks specified under Rule 45bis.

[COMMENT: Modeled on Rule 16.1(a).]

(b) Rules 16.1(b) to (f) shall apply to the supplementary search fee *mutatis mutandis*.

16.2 *Refund*

(a) The receiving Office shall refund the search fee and any supplementary search fees to the applicant:

[Rule 16.2(a), continued]

- (i) if the determination under Article 11(1) is negative,
- (ii) if, before the transmittal of the search copy to the International Searching Authority, the international application is withdrawn or considered withdrawn, or
- (iii) if, due to prescriptions concerning national security, the international application is not treated as such.

(b) Any supplementary search fees paid shall also be refunded if, before the transmittal of the record copy to the International Bureau, the corresponding request for supplementary international search is withdrawn or considered not to have been made.

16.3 *Partial Refund*

Where the international application claims the priority of an earlier international application which has been the subject of an international search or supplementary international search by the same International Searching Authority, that Authority shall refund the search fee or supplementary search fee paid in connection with the later international application to the extent and under the conditions provided for in the agreement under Article 16(3)(b), if the international search report or supplementary international search report on the later international application could wholly or partly be based on the results of the international search effected on the earlier international application.

[Rule 16.3, continued]

[COMMENT: The agreement would make clear that the refunds would be available only to the extent that the search conducted on the earlier international application had the appropriate scope. Little or no discount would be expected on a new full international search in the event that the International Searching Authority had previously carried out only a supplementary international search, which would have considered a narrower range of prior art.]

Rule 16bis

Extension of Time Limits for Payment of Fees

16bis.1 Invitation by the Receiving Office

(a) Where, by the time they are due under Rules 14.1(c), 15.4, ~~and~~ 16.1(f), and 16.1bis, the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the transmittal fee, the international filing fee, ~~and~~ the search fee, and any supplementary search fees, the receiving Office shall, subject to paragraph (d), invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16bis.2, within a time limit of one month from the date of the invitation.

[COMMENT: The reference to paragraph (d) is a clarification unrelated to the issue of supplementary international searches, explained in document PCT/R/WG/6/5.]

(b) [Remains deleted]

(c) Where the receiving Office has sent to the applicant an invitation under paragraph (a) and the applicant has not, within the time limit referred to in that paragraph, paid in full the amount due, including, where applicable, the late payment fee under Rule 16bis.2, the receiving Office shall, subject to paragraphs (c-bis) and (e) ~~(d)~~:

(i) make the applicable declaration under Article 14(3), and

[Rule 16bis.1(c), continued]

(ii) proceed as provided in Rule 29.

(c-bis) In the case referred to in paragraph (c) and subject to paragraph (e), if the insufficiency in the amount paid relates only to a supplementary search fee, the request for supplementary international search for which the fee has not been paid shall be considered not to have been made and the receiving Office shall so declare.

(d) Any payment received by the receiving Office before that Office sends the invitation under paragraph (a) shall be considered to have been received before the expiration of the time limit under Rule 14.1(c), 15.4, ~~or~~ 16.1(f) or 16.1bis, as the case may be.

(e) Any payment received by the receiving Office before that Office makes the applicable declaration under Article 14(3) or paragraph (c-bis) shall be considered to have been received before the expiration of the time limit referred to in paragraph (a).

16bis.2 [No change]

[COMMENT: To avoid complicating the procedure before the receiving Office, payment, including late payment, of supplementary search fees is subject to the same timetable as the payment of the international search fee. However, failure to pay in full the fees relating to the supplementary international search results only in the request for supplementary international search being considered withdrawn, not the international application itself. The proposed amendment of “(d)” to “(e)” in Rule 16bis.1(c) is to correct an existing error (see document PCT/R/WG/6/5).]

Rule 40

Lack of Unity of Invention (International Search)

40.1 *Invitation to Pay*

(a) The invitation to pay additional fees provided for in Article 17(3)(a) shall specify the reasons for which the international application is not considered as complying with the requirement of unity of invention and shall indicate the amount to be paid.

(b) Where the request includes a request under Rule 45bis.1 that a supplementary international search be carried out by one or more International Searching Authorities, the invitation to pay additional fees shall also include an invitation to pay additional fees in respect of each supplementary international search and shall indicate the number of additional fees which are to be paid if the supplementary international searches are to be established in respect of the parts of the international application which do not relate to the invention first mentioned in the claims.

40.2 *Additional Fees*

(a) [No change] The amount of the additional fee due for searching under Article 17(3)(a) shall be determined by the competent International Searching Authority.

(b) [No change] The additional fee due for searching under Article 17(3)(a) shall be payable direct to the International Searching Authority.

[Rule 40.2, continued]

(b-bis) Paragraphs (a) and (b) shall apply *mutatis mutandis* to additional fees payable in respect of supplementary international searches to be performed under Rule 45bis by an International Searching Authority that has notified the International Bureau that it will carry out such supplementary international searches.

[COMMENT: Each International Searching Authority which has notified the International Bureau under Rule 45bis.1(b) that it will carry out supplementary international searches sets the level of additional fees which would be payable in respect of extending such supplementary searches to inventions beyond the first one. The additional fees are payable directly to each International Searching Authority concerned.]

(c) Any applicant may pay the additional fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive. Such protest shall be examined by a three-member board or other special instance of the International Searching Authority or any competent higher authority, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fee. The result of such examination shall be transmitted to any International Searching Authority from which a supplementary international search has been requested under Rule 45bis.1, which shall refund, to the appropriate extent, any additional fees paid to it. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the designated Offices together with the international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under Article 22.

[Rule 40.2, continued]

(d) and (e) [No change]

40.3 *Time Limits*

(a) The time limit provided for in Article 17(3)(a) shall be fixed, in each case, according to the circumstances of the case, by the International Searching Authority; it shall not be shorter than 15 or 30 days, respectively, depending on whether the applicant's address is in the same country as or in a different country from that in which the International Searching Authority is located, and it shall not be longer than 45 days, from the date of the invitation.

(b) The time limit for paying any additional search fees in respect of a supplementary international search requested under Rule 45bis shall be one month from the date of transmittal to the applicant of the international search report. Any payment received by the International Searching Authority which is to carry out the supplementary international search before that Authority begins the supplementary international search shall be considered to have been received before the expiration of that time limit.

[COMMENT: It is not necessary for the applicant to pay the additional fees in respect of supplementary international searches until they are due to be started (see draft Rule 45bis.3(c)).]

Rule 45bis

Supplementary International Searches

45bis.1 Request for Supplementary International Searches

The request may include a request that a supplementary international search be carried out by one or more International Searching Authorities specified in the request for supplementary international search, other than the International Searching Authority which is to carry out the international search under Article 16(1), having notified the International Bureau under Rule 45bis.8 that it will carry out such searches.

[COMMENT: It is only possible to request a supplementary international search from an International Searching Authority which has notified the International Bureau that it will carry out such supplementary international searches.]

45bis.2 Transmittal of the Supplementary Search Copy, Translation, Sequence Listing and International Search Report

(a) One copy of the international application (“supplementary search copy”) shall be transmitted to each Authority carrying out a supplementary international search. Rules 23 and 25 shall apply *mutatis mutandis* except that references to Rule 12.3(a) shall be read as references to Rule 12.3bis(a).

[COMMENT: Modeled on Article 12(1). As with the normal search copy, the receiving Office transmits along with the request either the description, claims, drawings and abstract as filed, or else the translation furnished for the purposes of the supplementary international search. The International Searching Authority acknowledges receipt of the supplementary search copy. Note that the request part of the international application contains the request for supplementary international search.]

[Rule 45bis.2, continued]

(b) The International Bureau shall, upon receipt of the international search report or declaration under Article 17(2)(a) and of the written opinion from the International Searching Authority, transmit that report or declaration and written opinion to each Authority carrying out a supplementary international search.

45bis.3 Commencement of Supplementary International Search

(a) Subject to paragraphs (b) and (c), the Authority carrying out a supplementary international search shall commence that search promptly on receipt of the last of the documents specified in Rule 45bis.2.

(b) If the Authority carrying out a supplementary international search finds that the international application is subject to a limitation notified under Rule 45bis.8, it may declare the request for supplementary international search withdrawn and promptly:

(i) notify the applicant and the International Bureau accordingly; and

(ii) refund the supplementary search fee, including any additional fees which may have been paid in response to an invitation under Rule 40.1(b).

[Rule 45bis.3(b), continued]

[COMMENT: The applicant's right to a refund under this paragraph extends only to the case where the supplementary international search is not made because of a restriction of which the International Bureau has been notified under Rule 45bis.8 and not because of a declaration equivalent to that under Article 17(2) (see also proposed Rule 45bis.4(c), below). The Authority concerned, rather than the International Bureau, makes this declaration since a determination as to whether or not the subject matter to be searched falls within the limitation is not a matter for the International Bureau. Also, by this stage it is in any case necessary for the International Searching Authority to make the necessary refund since the fees will have been transmitted by the receiving Office (Rule 16.2, above, provides for the refund of supplementary search fees by the receiving Office where the international application or the request for supplementary international search is withdrawn or considered not to have been made before the record copy is transmitted to the International Bureau).]

(c) Where the International Searching Authority has issued an invitation to pay additional fees under Article 17(3), the Authority carrying out a supplementary international search shall not begin the supplementary international search before the earlier of:

(i) one month from the date of transmittal to the applicant of the international search report, or

(ii) the date on which it receives one or more additional fees in response to the invitation under Rule 40.1(b)

unless the applicant indicates that no additional fees will be paid and requests an earlier start.

[COMMENT: The supplementary international search does not begin until the applicant has had an opportunity to file any additional fees in respect of the supplementary international search.]

[Rule 45bis, continued]

45bis.4 Supplementary International Search

(a) Subject to paragraphs (b) to (d), the Authority carrying out a supplementary international search shall endeavor to discover as much of the relevant prior art, further to that discovered in the international search, as its facilities permit. Rule 33 shall apply *mutatis mutandis*.

[COMMENT: Modeled in part on Article 15(4).]

(b) The Authority carrying out a supplementary international search shall not be required to consult the minimum documentation specified under Rule 34.

[COMMENT: The primary purpose of the supplementary international search is to find documents in languages in which the Authority concerned has a particular skill, which the International Searching Authority is not likely to have consulted. Consequently, the minimum documentation does not need to form a part of the supplementary international search, except for those parts which are in an official language of the Authority concerned, where it is likely that the International Searching Authority would have searched those parts on the basis of abstracts only (as would be common for Japanese and Russian language collections, for example). Further guidance on the appropriate extent of the supplementary international search would be set out in the International Search and Preliminary Examination Guidelines.]

(c) For the purposes of the supplementary international search, Article 17(2) and Rules 13^{ter}.1 and 39 shall apply *mutatis mutandis*.

[Rule 45bis.4(c), continued]

[COMMENT: The Authority is not required to conduct a supplementary international search in respect of subject matter or unclear applications for which it would not be required to conduct an international search. It may also request sequence listings in an appropriate electronic format if necessary.]

(d) If the International Searching Authority considered that the international application does not comply with the requirement of unity of invention under Rule 13, the Authority carrying out a supplementary international search shall establish the supplementary international search report on those parts of the international application which relate to the invention first mentioned in the claims as identified by the International Searching Authority (“main invention”) and on any parts of the international application in respect of which additional supplementary search fees have been paid in response to an invitation under Rule 40.1(b).

45bis.5 Supplementary International Search Report

(a) The Authority carrying out a supplementary international search shall establish a supplementary international search report or make a declaration under Rule 45bis.4(c) that no supplementary international search report will be established, within 3 months of receipt of the supplementary search copy from the International Bureau.

[COMMENT: Modeled in part on Rule 42.1]

(b) For the purposes of establishing the supplementary international search report, Rule 43 shall apply *mutatis mutandis*, subject to paragraph (c).

[Rule 45bis.5, continued]

(c) The supplementary international search report shall not contain the citation of any document which was cited in the international search report, unless that document is considered relevant to the question whether the claimed invention involves an inventive step having regard also to one or more other documents which were discovered during the supplementary international search and which were not cited in the international search report.

[COMMENT: The supplementary international search report should not merely duplicate citations which appeared in the international search report; the International Search and Preliminary Examination Guidelines would it make clear that this extends to “equivalent” patent publications, unless there is found to be a material difference between the family members. Furthermore it is not desirable for the Authority concerned to take a different view to the International Searching Authority in a report which is part of the international search process. Further assessment of the prior art already cited is the responsibility of the International Preliminary Examining Authority.]

45bis.6 Supplementary Written Opinion

(a) If the supplementary international search report contains the citations of one or more documents considered to be relevant prior art under Rule 64, the Authority carrying out the supplementary international search shall, at the same time as it establishes the supplementary international search report, establish a supplementary written opinion as to whether, in the light of the prior art disclosed in those documents, the claimed invention appears to be novel and involve an inventive step.

[COMMENT: There seems little purpose in establishing a supplementary written opinion if no new citations are found. The Form covering the transmittal of the supplementary international search report would indicate whether or not a supplementary written opinion had been established.]

[Rule 45bis.6, continued]

(b) For the purposes of establishing the supplementary written opinion, [Articles 33(2) to (5), 35(2) and 35(3) and Rules 43.4, 64, 65, 66.1(e), 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.6 to 70.10, 70.14 and 70.15(a)] shall apply *mutatis mutandis*.

[COMMENT: The Articles and Rules listed within the square brackets are a subset of those referred to in Rule 43*bis*, dealing with the questions of novelty, inventive step, how to report on claims which are not searched and examined, and format and language of report. The list of provisions which should apply *mutatis mutandis* would, of course, need to be carefully reviewed depending on the requirements of any system of supplementary international search which was adopted.]

45bis.7 Transmittal and Effect of the Supplementary International Search Report, Written Opinion, etc.

(a) The Authority carrying out the supplementary international search shall, on the same day, transmit one copy of the supplementary international search report under Rule 45bis.5(a), and any supplementary written opinion under Rule 45bis.6, or of the declaration under Rule 45bis.4(c) that the Authority carrying out the supplementary international search considers that a situation referred to under Article 17(2)(a) exists, to the International Bureau and one copy to the applicant.

[COMMENT: Modeled in part on Rule 44.1.]

[Rule 45bis.7, continued]

(b) Except where the context indicates otherwise, the supplementary international search report and any supplementary written opinion shall be treated in the same way as the international search report and the written opinion established by the International Searching Authority respectively, and the same rules shall apply.

[COMMENT: The supplementary international search reports and supplementary written opinions are forwarded to the International Preliminary Examining Authority for use together with the primary international search report and written opinion of the International Searching Authority. Alternatively, if no demand is filed, the supplementary written opinions are incorporated into the international preliminary report on patentability (Chapter I of the PCT) when this is established by the International Bureau under Rule 44bis.]

(c) The establishment of a supplementary international search report shall not, subject to Rule 54bis.1(a)(ii), affect the date on which the international search report is considered to have been established or transmitted to the applicant, in particular for the purpose of time limits.

[COMMENT: While it seems appropriate to extend the period for filing a demand until after all supplementary international search reports and written opinions have been established, this is not the same as the establishment of the primary international search report and written opinion and does not appear to justify extending the time limit until three months after the last of the supplementary reports and opinions have been transmitted – see Rule 54bis.1.]

[Rule 45bis, continued]

45bis.8 International Searching Authorities Competent for Supplementary International Search

Each International Searching Authority which is prepared to carry out supplementary international searches shall notify the International Bureau accordingly. Any such notification may set out limitations on the applications or subject matter for which such searches will be carried out, beyond those which would apply under Article 17(2) to an international search. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: Authorities may limit the availability of such supplementary international searches to particular fields of technology, for example to exclude fields for which an Authority may not have sufficient capacity at the time, or where an Authority wished to specialize in fields of technology in which it has a particular expertise. The notification could be amended at a later stage to introduce or remove such limitations as necessary.]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (iv) [No change]

(v) subject to paragraph (g), the international search report or the declaration under Article 17(2)(a) and any supplementary international search reports; the publication of the international search report in the pamphlet shall, however, not be required to include the part of the international search report or the part of any supplementary international search reports which contains only matter referred to in Rule 43 already appearing on the front page of the pamphlet,

(vi) to (x) [No change]

(b) to (f) [No change]

[Rule 48.2, continued]

(g) If, at the time of the completion of the technical preparations for international publication, the international search report [or any supplementary international search report](#) is not yet available (for example, because of publication on the request of the applicant as provided in Articles 21(2)(b) and 64(3)(c)(i)), the pamphlet shall contain, in place of the international search report [or the supplementary international search report concerned](#), an indication to the effect that that report was not available and that either the pamphlet (then also including the international search report) will be republished or the international search report [or the supplementary international search report](#) (when it becomes available) will be separately published.

[COMMENT: the Administrative Instructions would make clear that a late international search report should be published as soon as it becomes available, but that where several supplementary international search reports are not available at the time of completion of technical preparations for international publication, these should all be published together once all are available.]

(h) to (i) [No change]

48.3 to 48.6 [No change]

[COMMENT: Current Rule 48.4 provides for a special publication fee where the applicant requests publication under Articles 21(2)(b) and 64(3)(c)(i) and the international search report or declaration referred to in Article 17(2)(a) is not yet available. Since the supplementary international search reports will frequently not be available in time for international publication, the additional component of the international filing fee (see paragraph 9(c) of the Introduction to this document) will take into account the cost of separate publication and consequently there is no need to also collect the special publication fee only because a supplementary international search report is not available.]

Rule 54bis

Time Limit for Making a Demand

54bis.1 Time Limit for Making a Demand

(a) A demand may be made at any time prior to the expiration of whichever of the following periods expires ~~later~~ the latest:

(i) three months from the date of transmittal to the applicant of the international search report and the written opinion established under Rule 43bis.1, or of the declaration referred to in Article 17(2)(a); ~~or~~

(ii) where a supplementary international search has been requested under Rule 45bis.1(a), one month from the date of transmittal to the applicant of the, or if more than one, the last, such supplementary international search report and supplementary written opinion (if any), established under Rule 45bis.5 and 45bis.6, or of a declaration under Rule 45bis.4(c) that the Authority carrying out the supplementary international search considers that a situation referred to under Article 17(2)(a) exists; or

(iii) 22 months from the priority date.

(b) [No change]

Rule 66

**Procedure Before the
International Preliminary Examining Authority**

66.1 [No change]

66.1bis *Written Opinion of the International Searching Authority*

(a) [No change] Subject to paragraph (b), the written opinion established by the International Searching Authority under Rule 43bis.1 shall be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a).

(b) An International Preliminary Examining Authority may notify the International Bureau that paragraph (a) [and Rule 45bis.7\(b\)](#) shall not apply to the procedure before it in respect of written opinions established under Rule 43bis.1 and [Rule 45bis.6](#) by the International Searching Authority or Authorities specified in the notification, provided that such a notification shall not apply to cases where the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority. the International Bureau shall promptly publish any such notification in the Gazette.

[COMMENT: Where a supplementary written opinion concerning a new relevant document has been established by an International Searching Authority whose main written opinion would be considered to be the first written opinion of the International Preliminary Examining Authority, it is not necessary for the International Preliminary Examining Authority to establish a further written opinion simply because that document was not included in the main written opinion.]

[Rule 66.1, continued]

(c) and (d) [No change]

66.1ter Updating the Search

The International Preliminary Examining Authority shall endeavor to discover as much of the relevant prior art as its facilities permit which it considers may not yet have been available to the International Searching Authority at the time that the international search report was established. Rule 33 shall apply *mutatis mutandis*.

[COMMENT: New Rule modeled in part on Article 15(4).]

66.2 to 66.9 [No change]

[End of Annex and of document]