

Patent Cooperation Treaty (PCT) Working Group

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REVIEW OF THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

Document prepared by the International Bureau

This document updates paragraphs 8 to 12 of document PCT/WG/13/4 to include numbers of requests for supplementary international search until the end of August 2020. Paragraph 4 and the draft decisions in paragraphs 21 and 22 of document PCT/WG/13/4 have also been amended as the next session of the PCT Assembly following this session of the Working Group is likely to take place in 2021.

SUMMARY

1. In preparation for a review of the supplementary international search system by the PCT Assembly, this document invites the Working Group to comment on the system and to consider what recommendation to make to the Assembly concerning its future.

BACKGROUND

2. The PCT Assembly (“the Assembly”), at its thirty-sixth session in September/October 2007, amended the PCT Regulations to introduce a supplementary international search system. These amendments entered into force on January 1, 2009 (document PCT/A/36/13).

3. The Assembly reviewed the supplementary international search system at its forty-third session in October 2012 and again at its forty-seventh session in October 2015. After the second review, the Assembly adopted the following decision (see paragraph 17 of document PCT/A/47/9):

“17. The Assembly, having reviewed the supplementary international search system three years after the date of entry into force of the system and again in 2015, decided:

"(a) to invite the International Bureau to continue to closely monitor the system for a period of a further five years, and to continue to report to the Meeting of International Authorities and the Working Group on how the system is developing;

"(b) to invite the International Bureau, International Authorities and national Offices and user groups to continue their efforts to raise awareness of and promote the service to users of the PCT System;

"(c) to invite the International Authorities which offer supplementary international searches to consider reviewing the scope of their services provided under the system and consequently the levels of fees charged for the services provided, which should be reasonable; and to invite Authorities which currently do not offer the service to reconsider whether to offer the service in the near future;

"(d) to review the system again in 2020, taking into account further developments until then, notably in relation to developments in collaborative search and examination, and in relation to efforts to improve the quality of the 'main' international search."

4. In preparation for the review by the Assembly, this document provides information on legal developments and use of the supplementary international search system and discusses future options for the system. Due to the COVID-19 pandemic, this review is likely to take place in 2021 as it is not foreseen to convene an extraordinary session of the Assembly in 2020 after this session of the Working Group. Instead, it has been proposed that the WIPO Assemblies, at their meetings from September 21 to 25, 2020, request the Director General to convene an extraordinary session of the Assembly in the first half of 2021 to cover the PCT System (document A/61/8).

LEGAL DEVELOPMENTS

5. In response to an invitation from the Working Group while preparing for the review of the supplementary international search system in 2015, the International Bureau presented a document to the ninth session of the Working Group in May 2016 (document PCT/WG/9/6) to discuss possible improvements to the supplementary international search system. This document proposed the following amendments to the PCT Regulations:

- extending the deadline for requesting supplementary international search from 19 to 22 months from the priority date; and
- providing the option for an Authority specified for supplementary search to issue a written opinion with all its supplementary international search reports.

6. Paragraphs 117 to 123 of the Summary by the Chair of the ninth session of the Working Group summarize discussions of the amendments proposed in document PCT/WG/9/6. Paragraphs 277 to 289 of the Report of the session, document PCT/WG/9/28, provide a full record of these discussions. While the Working Group approved the proposed amendments to extend the deadline for requesting supplementary international search, there was no agreement to provide the option for an Authority to issue a written opinion with its supplementary international search reports.

7. The PCT Assembly, at its forty-eighth session in October 2016, subsequently approved the amendments to the PCT Regulations to move the deadline for requesting supplementary international search from 19 to 22 months from the priority date (see document PCT/A/48/3 and

paragraphs 21 to 24 of document PCT/A/48/5). These amendments entered into force on July 1, 2017.

REQUESTS FOR SUPPLEMENTARY INTERNATIONAL SEARCH

8. Tables 1 and 2, below, provide details on the use of supplementary international search by applicants since this option became available to applicants in 2009.

SISA Main ISA	AT	EP	FI	RU	SE	SG	TR	UA	XN	XV	Total
AT		2			1						3
AU		1				1					2
CA		19		2				1	1		23
CN		330									330
EG		1									1
EP	13		1	201	9	4	3	2	5	2	240
ES		4									4
IL		1									1
IN	1	1									2
JP		10									10
KR		18		4	1	3					26
RU		7						5			12
SE				9							9
US		27		3	2						32
XN		1									1
Total	14	422	1	219	13	8	3	8	6	2	696

Table 1: Number of Supplementary International Search Requests by International Searching Authority and Supplementary International Searching Authority (until end August 2020)

SISA	2009	2010	2011	2012	2013	2014	2015	2016	2017	2018	2019	2020	Total
AT			1	2	2	2	2		1	1	2	1	14
EP		3	7	21	30	60	40	44	40	54	93	30	422
FI				1									1
RU	23	35	31	19	32	46	22	2	6		2	1	219
SE	2	2	2		2					3	1	1	13
SG								1		3	3	1	8
TR										1	2		3
UA									2	1	4	1	8
XN		1		3							2		6
XV											2		2
Total	25	41	41	46	66	108	64	47	49	63	111	35	696

Table 2: Supplementary International Search Requests by Year (until end August 2020)

9. Overall, the uptake of supplementary international search has been very low, with the maximum number of requests in a single year barely exceeding 100. These numbers are minuscule compared to the number of international search reports established each year, which rose from 157,741 to an estimated 251,825 between 2009 and 2019. The amendments to the PCT Regulations adopted in 2016 did not significantly affect the use of supplementary international search.

10. Table 1 shows that 76.3 per cent of all supplementary international search requests involve two combinations:

- (a) ISA/CN and SISA/EP (330 requests; 47.4 per cent); and

- (b) ISA/EP and SISA/RU (201 requests; 28.9 per cent).

In addition, Table 2 shows that most requests in the second of these combinations occurred before 2016, with the Federal Service for Intellectual Property (Rospatent) only receiving 12 requests since 2016. Requests to the European Patent Office (EPO) based on applications searched by the China National Intellectual Property Administration (CNIPA) have therefore dominated supplementary international search activity in recent years.

11. The top 10 users of supplementary international search account for more than three quarters (75.9 per cent) of all requests, with the two highest users respectively making up 40.4 per cent and 22.6 per cent of all requests. The second of these users was responsible for most requests to Rospatent before 2016 and has not used supplementary international search since.

12. In summary, supplementary international search is very little used. Most requests come from a few users using particular ISA and SISA combinations who appear to use supplementary international search as a filing strategy for a particular set of circumstances. For most of these requests, users selected an SISA that was not a competent ISA for the receiving Office where these international applications were filed.

FUTURE OF SUPPLEMENTARY INTERNATIONAL SEARCH

13. In previous reviews of the supplementary international search system, the International Bureau pointed out the minimal running costs for handling supplementary international search requests at the International Bureau. When establishing the system, the International Bureau was able to build on existing IT systems to process requests and fee payments, benefitting from its existing systems as a receiving Office, notably for the transfer of the supplementary international search fee to the relevant International Authority (see paragraph 33 of document PCT/WG/5/8). More recently, the International Bureau has automatically generated a copy of the international application for supplementary international search for transmission to the EPO through PCT-EDI as it does for transmitting search copies through eSearchCopy. The review in 2015 also reported that International Authorities offering supplementary international search had indicated that the costs of providing the service were minimal compared to the set-up costs (see paragraph 25 of document PCT/WG/8/6).

14. Given the low operating costs and the continued use of supplementary international search by certain applicants, the Assembly during the previous reviews had maintained supplementary international search. However, looking ahead to the future development of PCT online services, further efficiency gains will rely on more machine-to-machine transactions, with data passed directly from the source. The development of web services to achieve this goal is at a trial stage with a few applicants and Offices performing live tests. In addition, a number of the Authorities offering supplementary international search have requested the browser-based service for Offices to be extended to cover that function more completely.

15. However, future automation of data transfer involving supplementary international search will involve IT development-related costs that would appear disproportionate to the low volume of requests. While ePCT has been designed to be modular and allow easy addition of functionality, adding services related to supplementary international search is more complicated than is the case for receiving Offices or the main roles of international search and international preliminary examination. Whereas for each international application there is exactly one International Searching Authority and zero or one International Preliminary Examining Authority, there can in theory be up to 10 Authorities specified for supplementary search. Database interactions required to interact with such Authorities therefore cannot be directly based on equivalent functions for the main International Searching Authority, but would need significant special development, most of which would likely not even be used by the EPO, which currently conducts over 80 per cent of supplementary searches.

16. Previous user feedback concerning the low use of supplementary international search has focused largely on the cost and the language specializations of the Authorities willing to offer the service. Given that neither aspect has significantly changed since the previous review, it does not appear useful to consider these subjects again.

17. Consequently, in the view of the International Bureau, there are two options for PCT Contracting States to consider in the review of the supplementary international search system later this year.

(a) The first option would be to maintain supplementary international search and set arrangements for the Assembly to review the system again. In determining when to perform the next review, Contracting States could consider future developments in international search. A pilot project involving the IP5 Offices for collaborative search and examination is currently under way and will report on a variety of subjects concerning practicality, costs and benefits. In addition, receiving Offices specifying more International Searching Authorities as competent for international applications filed at their Office, as proposed in document PCT/MIA/27/6, may provide applicants with more options for the main international search. However, if the Assembly decides on this option, the International Bureau would propose not to plan investment in any additional automation of supplementary international search beyond what was essential to ensure the exchange of supplementary search copies and supplementary search reports.

(b) The second option would be to abolish supplementary international search, noting supplementary international search has been operating for more than 10 years with very low use by applicants. As discussed in paragraphs 5 to 7, above, the PCT Working Group has considered possible improvements to system since the previous review of supplementary international search in 2015. Extension of the period for requesting supplementary international search, the only change to the legal framework agreed on by the Working Group, has not significantly increased the number of supplementary international search requests. As ceasing supplementary international search would require amendment to the PCT Regulations, if the Assembly decided to recommend this option during the review in 2021, the International Bureau would propose the necessary amendments to the PCT Regulations for adoption at the session of the Assembly in September/October 2022. The likely date for entry into force of the amendments and the end of supplementary international search would therefore be July 1, 2023.

CONSIDERATION BY THE MEETING OF INTERNATIONAL AUTHORITIES

18. The Meeting of International Authorities under the PCT (PCT/MIA) discussed the supplementary international search system at its twenty-seventh session, held in Gattineau on February 6 and 7, 2020. Paragraphs 59 to 63 of the Summary by the Chair (document PCT/MIA/27/16) summarize these discussions, as follows:

“59. Discussions were based on document PCT/MIA/27/5.

“60. Some Authorities expressed support for PCT Contracting States to recommend continuation of supplementary international search for a further period. One of these Authorities provided supplementary international search and pointed out that the IT development costs to provide supplementary international search to applicants was significant and it could be expensive to make the changes to cease supplementary international search. Furthermore, this Authority pointed out the number of requests each year for supplementary international search had doubled since the time period for requesting supplementary international search had been increased to 22 months from the priority date in 2017. Another of these Authorities, while not offering supplementary international search, stated that the abolition of supplementary international search could be considered after the evaluation of the collaborative search and examination pilot. This

Authority also noted that most supplementary international search requests originated from applications that were filed at the receiving Office of the China National Intellectual Property Administration (CNIPA) and added that CNIPA could nominate other International Searching Authorities to be competent for international applications filed at its receiving Office.

“61. Some other Authorities believed that PCT Contracting States should give serious consideration to the option of abolishing supplementary international search, noting among other reasons, the concerns raised by the International Bureau on disproportionate IT development-related costs to maintain the system. One of these Authorities referred to the reasons why users had originally requested the possibility of a requesting a second search during the international phase, such as the desire for a search to cover documents of particular languages understood by examiners at a particular International Searching Authority. However, given the very low uptake supplementary international search, it could indicate that applicants were generally satisfied with the quality of international searches and this had improved since supplementary international search had been introduced, noting that search engines and machine translation facilities for reading documents in other languages had improved in recent years. One of these Authorities reported that it had received two supplementary international search requests in 2019 after a gap of seven years, which had required extensive resources to process in view of the long time interval since the previous supplementary international search.

“62. A further group of Authorities did not have a clear preference on whether to continue supplementary international search. One of these Authorities had received a substantial number of supplementary international search requests from a single applicant that no longer used the service. This Authority nevertheless believed that supplementary international search could be beneficial to an applicant where the application contained subject matter listed in Rule 39 that was searched by some International Searching Authorities, but not by any Authorities that had been nominated to be competent by the receiving Office to carry out the main international search.

“63. The Meeting invited the International Bureau to reflect the comments from International Authorities on supplementary international search in paragraphs 59 to 62, above, in the document on supplementary international search for the Working Group to consider in preparation of the review of supplementary international search by the Assembly in 2020.”

CONSIDERATION BY THE WORKING GROUP

19. In preparation of the review of supplementary international search by the Assembly, the Working Group is invited to comment on the legal developments and use of the supplementary international search system, as set out in paragraphs 5 to 12, above, and the issues relating to the future of the system, as outlined in paragraphs 13 to 18, above. The Working Group is also invited to consider recommending a decision for the Assembly to adopt following the review.

20. If the Working Group considers it appropriate to continue monitoring the supplementary international search system, as discussed in paragraph 17(a), above, the conclusions of any review are likely to be closely linked with the outcome of the collaborative search and examination pilot. While the evaluation of some aspects of the pilot has begun, it will be several years before the outcome in the national phase can be determined of a sufficient proportion of the international applications that have been part of the pilot. Even then, further time will be required to turn any recommendations into concrete proposals. Moreover, as the demand for supplementary international search has always been low, changes that might affect applicant behavior such as new options for International Searching Authorities for applicants could have a sudden and significant impact on the number of supplementary international search requests at

any time. With these different factors, leaving the date for the next review open would avoid the Assembly having to consider an issue that was not yet ready.

21. Should the Working Group decide to recommend the Assembly to continue supplementary international search, it may therefore wish to consider recommending the Assembly to adopt the following decision:

“The PCT Assembly, having reviewed the supplementary international search system in 2012, 2015 and 2021, decided:

- (a) to invite the International Bureau to continue to monitor the system and report to the Meeting of International Authorities and the Working Group on significant developments; and
- (b) to review the system again at a time to be recommended by the International Bureau, or on request by a Contracting State, but no later than 2027.”

22. However, if the Working Group decides to recommend to the Assembly to abolish the supplementary international search system, noting the timescale for amending the PCT Regulations discussed in paragraph 17(b), above, it may wish to consider recommending the Assembly to adopt the following decision:

“The PCT Assembly, having reviewed the supplementary international search system in 2012, 2015 and 2021,

- (a) noted the continued very low uptake in supplementary international search since this possibility became available to applicants in 2009; and
- (b) invited the International Bureau to submit proposals to its session in September/October 2022 to amend the PCT Regulations to remove the option of supplementary international search.”

23. The Working Group is invited:

(i) to comment on the issues related to supplementary international search raised in this document; and

(ii) to consider the draft recommendations to the Assembly, set out in paragraphs 21 and 22, above.

[End of document]