

Patent Cooperation Treaty (PCT) Working Group

**Fourth Session
June 6 to 10, 2011, Geneva**

Supplementary International Search

Document prepared by the International Bureau

SUMMARY

1. In accordance with the decision taken by the Assembly in 2007 in the context of establishing the supplementary international search system, the International Bureau shall report to the Meeting of International Authorities under the PCT and to the Assembly on the financial and operational situation of the supplementary international search system. This document sets out the issues on which the International Bureau intends to report to the Assembly at its 2011 session. A general review of the system by the Assembly will take place in 2012, three years after the date of entry into force of the system, as has been requested by the Assembly in 2007.

INTRODUCTION

2. The PCT Union Assembly, at its thirty-sixth (16th ordinary) session in September/October 2007, adopted amendments to the PCT Regulations providing for a supplementary international search system. These amendments entered into force on January 1, 2009.
3. Along with adopting these amendments, the Assembly adopted two decisions in relation to reporting on and reviewing the supplementary international search system. These decisions are set out in paragraph 153 of the report of the Assembly (document PCT/A/36/13), reproduced below:

“The Assembly ...

“(vi) decided that the International Bureau shall report to the Meeting of International Authorities under the PCT and to the Assembly on the financial and operational situation of the supplementary international search system; and

“(vii) decided that the Assembly shall review the supplementary international search system three years after the date of entry into force of the system.”

4. In accordance with the first of the decisions by the Assembly referred to above, the purpose of this document is to inform the Working Group on the issues with regard to the current situation of the supplementary international search system on which the International Bureau intends to report to the Assembly at its September/October 2011 session. A review of the supplementary international search system by the Assembly, in accordance with the second of the decisions by the Assembly referred to above, will take place in 2012, three years after the date of entry into force of the system.

OPERATIONAL SITUATION

International Authorities offering supplementary international search

5. To date, six International Authorities offer supplementary international searches. The Federal Service for Intellectual Property, Patents and Trademarks of the Russian Federation (ROSPATENT; SISA/RU), the Nordic Patent Institute (SISA/XN) and the Swedish Patent and Registration Office (SISA/SE) have offered supplementary international searches since the entry into force of the system on January 1, 2009. The National Board of Patents and Registration of Finland (SISA/FI) became a Supplementary International Searching Authority on January 1, 2010, followed by the European Patent Office (SISA/EP) and the Austrian Patent Office (SISA/AT), which began offering the service on July 1, 2010, and August 1, 2010, respectively.

Languages accepted for supplementary international search

6. All six International Authorities which offer supplementary international searches accept international applications which are filed in, or have been translated into, English. Other languages accepted for supplementary international search include: Danish (SISA/SE and SISA/XN); Finnish (SISA/FI); French (SISA/EP and SISA/AT); German (SISA/EP and SISA/AT); Icelandic (SISA/XN); Norwegian (SISA/SE and SISA/XN); Swedish (SISA/SE, SISA/FI and SISA/XN) and Russian (SISA/RU).

Documentation covered by Supplementary International Search

7. The documentation covered by the supplementary international search varies between International Authorities. For some International Authorities, a supplementary international search can be limited to documentation in specific languages where examiners at the Supplementary International Searching Authority have particular language capabilities and expertise. For example, SISA/RU offers a supplementary international search in patent document collections in Russian from countries of the former Soviet Union. SISA/AT offers a supplementary international search covering only documents published in German. In addition, both also offer a supplementary international search covering the PCT minimum documentation in certain instances, either by applicant choice according to the level of fee paid, or else in cases where the main International Searching Authority has issued a declaration that no international search will be performed for certain reasons. By contrast, all other Supplementary International Searching Authorities always perform a complete

new search equivalent to the main international search, covering at least the entire PCT minimum documentation as well as whatever further documentation in local or other languages would also usually be searched.

Fees charged for Supplementary International Search

8. Relative to the international search fees, SISA/RU charges a supplementary international search fee equivalent to approximately 70% of fee it charges for the “main” international search, except for searches related to methods of treatment where a declaration from the International Searching Authority has been made under Article 17(2)(a). SISA/AT provides three levels of fees between 50 and 100% of the fee it charges for the “main” international search, depending on the documentation covered. All other Authorities, all of which always search the entire PCT minimum documentation for the supplementary international search, charge the same amount of fees for supplementary searches as they do for the “main” international searches.

Demand for Supplementary International Search

9. Demand from applicants for supplementary international searches is very low. In 2009, the first year in which the service was offered, 24 supplementary international searches were requested. Provisional figures for 2010 show an increase to 41 requests. 57 of the requests for supplementary international searches made in 2009 and 2010 were made to SISA/RU. The top four applicants requesting supplementary international searches accounted for more than 80% of all requests.
10. In view of the limited number of requests for supplementary international search, it is difficult to draw conclusions on the motivations of applicants for requesting this service. A preliminary analysis of the requests received in 2009 and 2010 appears to suggest that many requests for supplementary international search were made irrespective of negative search results in the “main” international search report (more than 80% of supplementary search requests were made following receipt of a “main” international search report containing X and/or Y citations, or even before the receipt of the international search report). By comparison, only a few supplementary search requests were made following a declaration under Article 17(2) of the PCT by the “main” International Searching Authority that no search report will be established.
11. Given these statistics, and considering the distribution of requests between International Authorities referred to above, it would appear that supplementary searches are usually requested in order to cover patent document collections beyond the minimum documentation which has been searched during the “main” international search, rather than (as one could perhaps expect) to have a full second search by a different International Authority, in addition to the “main” search, where no relevant documents were found in the “main” international search.

User feedback

12. At the 2010 PCT/MIA meeting held in Brazil, International Authorities discussed possible reasons for the low uptake by applicants of supplementary international searches and concluded that “user feedback suggested that the service was seen as being too expensive, that too few Offices with a wider range of languages offer the service to make it really attractive to users, and that the launch of the service has not been enough publicized” (see paragraph 37 of the report of the session, document PCT/MIA/17/12). This conclusion broadly corresponds with user feedback received by the International Bureau and appears to be confirmed by the statistics showing that a majority of requests for supplementary international searches were made to the Authority which offers the

service for a fee considerably lower than the fee it charges for a “main” international search and which carries out the supplementary search in documentation in a language not part of the minimum documentation.

FINANCIAL SITUATION

13. At the International Bureau, the relatively low demand for supplementary international searches resulted in minimal day-to-day running costs with handling requests. Costs would only rise significantly in the event of a sharp increase in requests, where further investment in training of staff would be necessary. Concerning expenditure incurred to establish 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 search fee to the relevant International Authority.

DISCUSSIONS AT THE EIGHTEENTH MEETING OF INTERNATIONAL AUTHORITIES

14. In accordance with the decision taken by the Assembly in 2007 referred to in paragraph 3, above, the International Bureau reported on the financial and operational situation of the supplementary international search system to the eighteenth Meeting of International Authorities, held in Moscow from March 15 to 17, 2011. The discussions of the Meeting of International Authorities are outlined in document PCT/MIA/18/16, paragraphs 69 to 74, reproduced in the following paragraphs:

“69. Discussions were based on document PCT/MIA/18/10.

“70. Several Authorities which took the floor on the matter expressed their disappointment on the low uptake of the system by users, noting the economic downturn in 2008 and 2009 as one possible contributing factor, in addition to the possible reasons stated in the document.

“71. One Authority stated that it offered supplementary international searches for a fee set at about 70% of the fee it charged for the main search and, as a result, had attracted the vast majority of requests for supplementary searches filed to date, and wondered whether there was a need for a review of the level of fees set by other Authorities offering the service. In this context, the Authority noted that it had received a substantial number of requests for supplementary searches in cases where the main international search report had not been received by it, forcing it to carry out a full second search for a reduced supplementary search fee; to address this issue, it was considering to change its fee structure so as to allow it to charge a supplementary search fee identical to the fee it charged for the main search where the main international search report was not available to it when it commenced the supplementary search.

“72. One Authority, noting that the very low uptake made it impossible to draw meaningful conclusions as to the reasons why applicants opted or did not opt for the service, suggested that the International Bureau should carry out a survey to obtain detailed feedback from the user community, and indicated that it would do the same with its own user community.

“73. One Authority expressed the view that one of the main reasons for the low uptake of the supplementary search system was that the system did not address the real needs of applicants. It only added additional complexity and costs for applicants who, in any case, noting the non-binding nature of the international work products, had to face search and examination by designated Offices during national phase

processing. It expressed the view that the system was not consistent with the PCT philosophy which foresaw only one high quality search by one Authority and a national phase procedure to supplement the international search by focusing on national documents which did not form part of the PCT minimum documentation. The introduction of that system in effect meant that national phase procedures had been advanced, causing the whole system to become more complicated and burdensome for applicants. The system further added to the workload of Authorities, bore the risk of duplication of work and contributed to legal uncertainty where the main search and the supplementary search produced contradictory results. Noting the level of fees, the Authority expressed the view that the system was accessible to big applicants only, but not to small and medium size enterprises and individual inventors, which was one of the main reasons for the low uptake of the system. From its point of view, there was a need to review the entire system, focusing on improving the usefulness of the international search and preliminary examination for all stakeholders, with just one search carried out as complete as possible and to the highest possible quality standard.

“74. In response to the invitation by the Secretariat to those Authorities which to date did not offer supplementary international searches to indicate possible future plans to do so, the representatives from both IP Australia and the United States Patent and Trademark Office indicated that, while they fully supported the system, they had at this point no plans to offer the service in the near future.”

FUTURE DEVELOPMENT OF THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

15. There clearly is vast room for improvement of the supplementary international search system. The low uptake by applicants and feedback received suggests that the current mix of languages offered and fees charged by the Authorities offering the supplementary search service are not attractive enough for applicants to use the service. Lack of awareness may also still play a role. The International Bureau intends to advertise the service further through the PCT Newsletter and seminars. Suggestions would be welcome, notably from those Authorities which already offer the service, on other ways of making the service known to as wide a range of applicants as possible so that they can take an informed decision on its use and, more generally, on ways of improving the overall attractiveness of the system. It would appear to be useful to first focus on improving the awareness by applicants and the attractiveness of the system before evaluating whether the general idea behind the introduction of the system was a good one and whether the framework of the implementation, in general terms, is the most appropriate one.
16. As stated above, the International Bureau will, as requested by the Assembly, carry out a more detailed review of the supplementary international search system and present its findings for discussion by the Assembly at its 2012 session.

17. *The Working Group is invited to comment on the issues raised in this document.*

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