

Patent Cooperation Treaty (PCT) Working Group

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REVIEW OF THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

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 is requested to report on the financial and operational situation of the supplementary international search system. Following such reports at both the 2011 and 2012 sessions of the PCT Meeting of International Authorities (PCT/MIA) and at the 2011 session of the Working Group, the present document contains a further update on the financial and operational situation of the supplementary international search system as at the end of February 2012.

2. In accordance with its decision taken in 2007, the PCT Assembly will review the supplementary international search system at its October 2012 session, three years after the date of entry into force of the system. To facilitate the review by the Assembly, the International Bureau intends to prepare a working document for consideration by the Assembly, along the lines of the present document and taking into account the discussions by the Working Group at its present session.

INTRODUCTION

3. The PCT Union Assembly, at its thirty-sixth (16th ordinary) session in September/October 2007, adopted amendments to the Regulations so as to introduce a supplementary international search system to the PCT. These amendments entered into force on January 1, 2009.

4. 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.”

5. In accordance with the first decision by the Assembly referred to in paragraph 4, above, the International Bureau reported on the financial and operational situation of the supplementary international search system at both the 2011 and 2012 sessions of the PCT Meeting of International Authorities (documents PCT/MIA/18/10 and PCT/MIA/19/6) and at the 2011 session of the PCT Working Group (document PCT/WG/4/11). The discussions at those meetings are detailed in the reports of the sessions (document PCT/MIA/18/16, paragraphs 69 to 74; document PCT/MIA/19/14; and document PCT/WG/4/17, paragraphs 248 to 256, respectively). The PCT Assembly at its forty-second (18th ordinary) session, held from September 26 to October 5, 2011, also took note of the report presented to the 2011 session of the Working Group (document PCT/A/42/4).

6. The present document contains a further update on the financial and operational situation of the supplementary international search system as at the end of February 2012.

OPERATIONAL SITUATION

INTERNATIONAL AUTHORITIES OFFERING SUPPLEMENTARY INTERNATIONAL SEARCHES

7. To date, six International Authorities are competent to carry out supplementary international searches (“Supplementary International Searching Authorities” (SISA)). 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 competent to carry out supplementary searches 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

8. 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

9. The documentation covered by the supplementary international search varies across International Authorities. In respect of some Supplementary International Searching Authorities, a supplementary international search can be limited to documentation in specific languages where examiners 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 of only the German documentation or of only the European and North American documentation. In addition, both also offer a supplementary international search covering the entire PCT minimum documentation in certain instances, either by applicant choice according to the level of fee paid (SISA/AT), or else in cases where the “main” International Searching Authority has issued a declaration under PCT Article 17(2)(a) that no international search report will be established (SISA/RU).

10. 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

11. Relative to the “main” international search fees, SISA/RU charges a supplementary international search fee equivalent to approximately 70% of the 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 95% of the fee it charges for the “main” international search, depending on the documentation covered (German documentation only, European and North American documentation only, PCT minimum documentation). All other Authorities, all of which always search (at least) 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

12. Demand from applicants for supplementary international searches has been very low. In 2009, the first year in which the service was offered, 24 supplementary international searches were requested. In each of 2010 and 2011, 41 supplementary international searches were requested. Provisional figures, as at the end of February 2012, show that 13 requests have been filed so far in 2012, 11 of which were filed with the European Patent Office. All together, 119 requests for supplementary international searches were made from January 1, 2009 until the end of February 2012.

13. Almost all requests for supplementary international searches made had the European Patent Office as the “main” International Searching Authority (except, of course, where SISA/EP was requested to carry out the supplementary international search). In the 13 requests received so far in 2012, 10 had either the Korean Intellectual Property Office or the State Intellectual Property Office of the Peoples Republic of China as the “main” International Searching Authority. 89 of the 119 requests for supplementary international searches made were made to the Federal Service for Intellectual Property, Patents and Trademarks of the Russian Federation (ROSPATENT), 21 to the European Patent Office, six to the Swedish Patent and Registration Office, two to the Nordic Patent Institute and one to the Austrian Patent Office. The top four applicants requesting supplementary international searches accounted for almost 80% of all requests.

14. An analysis of the requests shows that most requests were made following receipt of a “main” international search report containing “X” and/or “Y” citations; a few requests were made even before the international search report was received. Some requests followed a finding by the International Searching Authority that the international application lacked unity of invention and the applicant requested the supplementary international search in respect of the inventions not searched during the “main” international search. A few supplementary international 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. In some cases, the request for supplementary international search was followed by a demand for international preliminary examination containing amendments of the international application.

15. Given these statistics, and considering the distribution of requests across International Authorities referred to above, it would appear that supplementary searches are mostly requested in order to cover document collections beyond the minimum documentation already searched during the “main” search, rather than to have a full second search by a different International Authority in addition to the “main” search where that “main” search did not find any relevant documents. In addition, demand for supplementary international search appears to be in respect of International Authorities which offer the service for a fee considerably lower than the fee for the “main” search and which carry out supplementary international searches in documents in a language which does not form part of the minimum documentation or in subject matter which was not searched by the International Searching Authority during the “main” search in accordance with PCT Article 17(2)(a) (specific subject matter which the “main” International Searching Authority is not required to search).

RESPONSES RECEIVED IN REPLY TO CIRCULAR C PCT.1329

16. In December 2011, the International Bureau sent a Questionnaire to patent Offices, user groups and all applicants who had requested supplementary international searches to be carried out up until the end of November 2011. The purpose of the Questionnaire was to gather further information and feedback on the functioning of the PCT supplementary international search system from Offices in their various PCT capacities (as a receiving Office, International Searching Authority, International Preliminary Examining Authority and/or and designated or elected Office) as well as from organizations representing users of the PCT system. Responses were received from 27 Offices, one user group and three applicants who had requested supplementary international search in the past. A summary of the feedback received is set out in the following paragraphs.

FEEDBACK FROM INTERNATIONAL AUTHORITIES OFFERING SUPPLEMENTARY INTERNATIONAL SEARCHES

17. Three International Authorities which offer supplementary international searches responded to the Questionnaire.

18. All requests for supplementary international searches received by those Authorities so far had been made in English. To the extent that the International Authority concerned offered different types of supplementary international searches, most applicants requested a supplementary search in local documentation only and not a full second search in the entire PCT minimum documentation. Two International Authorities carried out supplementary international searches in cases where, due to lack of unity of the invention and non-payment of additional fees, the “main” international search report did not relate to all of the inventions contained in the international application, and supplementary international search was requested for the claims which were not searched during the “main” international search. One International Authority stated that it had received a number of requests for supplementary international search related to international applications where the “main” International Searching Authority had issued a

declaration under PCT Article 17(2)(a) that no international search report would be established (where the international application related to subject matter which the “main” International Searching Authority was not required to search).

19. All International Authorities reported that they took the “main” international search report into account when carrying out the supplementary international search, provided it was available to them in time. One International Authority stated that, while it took the “main” international search report (notably the classification and any citations) into account, it nevertheless always performed a complete second search. Another International Authority stated that it only performed a complete second search if the “main” search did not appear to be complete. One International Authority considered the supplementary international search to be useful for applicants, noting that in many cases it had found additional “X” or “Y” documents (in addition to those cited in the “main” international search report) and in one case new “X” or “Y” documents where the “main” international search report had only contained “A” citations. As to the likely reasons for different findings during the “main” international search and the supplementary international search, one International Authority expressed the view that the examiner carrying out the supplementary international search might be more specialized in the particular technical field. Another International Authority stated that most of the documents which were cited in the supplementary international search report but not in the international search report were citations of documents found in the local patent document collection.

20. One International Authority remarked that, in 30% of all cases, the international search report was established so late that it could not be taken into account for the supplementary international search and that consequently an entire new search had to be carried out. It felt that this was especially inconvenient in cases where the International Authority offered different kinds of supplementary international searches, with different levels of fees, and where the applicant had requested a supplementary search in the national documentation only. Without having received the “main” international search report on time, the International Authority was thus required to conduct a full second search, including in the PCT minimum documentation, without receiving a full fee for such a service.

21. One Authority stated that the late establishment of supplementary international search reports prevented it from using those reports for the establishment of an international preliminary examination report under Chapter II of the Treaty.

22. In general, International Authorities expressed the view that supplementary international searches were useful for applicants, notably in helping them in their decision on whether or not to enter the national phase. It was felt to be especially useful in cases where the “main” International Searching Authority had not carried out the “main” search (in accordance with Article 17(2)(a) and where the “main” International Searching Authority had found lack of unity of the invention and had not searched all of the inventions contained in the international application).

FEEDBACK FROM INTERNATIONAL AUTHORITIES CURRENTLY NOT OFFERING SUPPLEMENTARY INTERNATIONAL SEARCHES

23. Most International Authorities which at present do not offer supplementary international searches indicated workload considerations as the main reason for not offering the service. One International Authority stated that it did not hold any documentation in a particular language not covered by the PCT minimum documentation. Another International Authority indicated that it focused on providing high quality “main” international search and preliminary examination products. Two International Authorities indicated that they did not support the supplementary international search system in general, noting that the focus should be on producing one high quality “main” international search report, for which each Authority should be able to search all documents.

24. Most International Authorities reported that they did not intend to offer supplementary international search in the near future. One International Authority stated that it was currently studying the technical and business related aspects in order to decide on whether to offer supplementary searches in the near future. Another International Authority stated that it might offer the service in the future once it had sufficient control of its workload as a “main” International Searching Authority. One International Authority which at present had not commenced to act as a “main” International Searching Authority stated that it did not exclude the possibility of offering the service in the future.

FEEDBACK FROM DESIGNATED/ELECTED OFFICES

25. Most Offices which responded to the Questionnaire (in their capacity as designated/elected Offices under the PCT) reported that they did not yet have any experience with international applications entering the national phase in respect of which a supplementary international search report had been established. Two Offices responded that they had found the supplementary international search report useful because new documents not cited in the “main” international search report had been found during the supplementary international search. This was especially important where the “main” international search report had only shown “A” citations. One Office responded that the results of the supplementary international search report and of the “main” international search report had shown the same cited prior art documents.

26. Several Offices saw the lack of awareness as well as the high cost and the complexity of the service as the main reasons for the low uptake of the supplementary international search system. Another reason was seen in the high number of late international search reports, noting that applicants had to request supplementary international search prior to the expiration of 19 months from the priority date even if the “main” international search report had not yet been established. Some Offices were of the opinion that the supplementary international search system did not add much value since searches in additional documentation not part of the PCT minimum documentation would in any case be carried out during the national phase, often even without any additional costs for the applicant. Other Offices noted that one of the main reasons for the low uptake was the very limited number of International Authorities offering the system as well as the limited range of languages in which International Authorities currently offered the service, confirmed by the fact that most requests had been for supplementary international searches in documentation in a language not covered by the PCT minimum documentation. Several Offices expected the system to be more widely used if other Authorities, in particular those covering Asian languages or other Authorities belonging to the IP5 group of Offices, would start offering the service. A number of Offices expressed the view that the service should not offer a complete second search at full price, which was a duplicate effort during the international phase, but rather be truly supplementary to the “main” international search and only offer a supplementary search in documentation other than the PCT minimum documentation, at a lower cost. Several Offices also responded that the low uptake of the system demonstrated that the “main” search was adequate and that applicants were satisfied with the results of the “main” search.

27. Other views expressed by Offices included that the use of the supplementary international search system could be improved by raising awareness of the system; by reducing the cost of the service; and by setting fee incentives and offering accelerated prosecution during the national phase of those applications for which a supplementary international search report had been established.

FEEDBACK FROM USERS OF THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

28. The Questionnaire was also sent to several user groups and every applicant who had requested supplementary international search since the service began in 2009. Responses were received from one user group and three applicants. In addition, user feedback was also reported by two Offices which had conducted their own user surveys.

29. All applicants who had requested supplementary international searches in the past responded that they were generally satisfied with the system. They found it to be a reasonably cost-effective system which added value, especially given the increasing diversity of prior art in different languages, completing the “main” search and offering help to applicants in refining their strategies for national phase entry. Applicants also stated that, by and large, they were satisfied with the timeliness of supplementary international search reports.

30. All applicants who responded to the Questionnaire indicated that they would request supplementary international search again. One applicant noted that it had become standard practice for his company to request supplementary international search with one specific International Authority. Another applicant responded that he would continue using the service in cases where the application had to be filed, for reasons of national security clearance, with a particular receiving Office, limiting his choice as to the International Authority competent to carry out the “main” search. Another applicant responded that he would continue using the service in the future in Article 17(2)(a) cases where the “main” International Searching Authority had not established a “main” international search report (where the international application related to subject matter which the “main” International Searching Authority was not required to search), but where a supplementary international search for that subject matter was carried out by a Supplementary International Searching Authority.

31. Several applicants expressed the view that the main reasons for the low uptake of the service were the high costs, the fact that the international search report was often received too late and lack of awareness of the system. Some commented that the system caused additional costs without adding much value and that the supplementary international search system did not contribute to one of the main reasons for applicants to use the system of PCT, namely, to defer costs.

32. In general, applicants responding to the Questionnaire showed a great interest in supplementary international searches being carried out by additional Authorities with expertise in specific languages, especially Asian languages. They commented that supplementary international search reports would be very helpful when deciding whether to enter the national phase in the country for which the Supplementary International Searching Authority acted. Others showed an interest in supplementary international search being offered by all of the IP5 group of Offices. Yet others considered it to be of particular interest if supplementary international searches were to be carried out in respect of subject matter which the “main” International Authority was not required to search in accordance with PCT Article 17(2)(a). Others suggested that the supplementary international search system could be improved by reducing the costs of the service, by establishing the international search report on time and by recognizing the results of the supplementary international search report during the national phase, such as by not conducting another search or by offering reduced fees during the national phase.

FINANCIAL SITUATION

33. 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.

ACTIVITIES TO RAISE AWARENESS

34. Noting that lack of awareness may also still play a role in the low uptake of the supplementary international search system, the International Bureau has undertaken further activities to raise the awareness of PCT users, including webinars and seminars to users of the PCT system, and specific practical advice on the use of supplementary international search in the April 2011 and January 2012 editions of the PCT Newsletter.

CONSIDERATION BY THE WORKING GROUP

35. Clearly, the very low uptake by applicants of the supplementary international search system during the first three years of its existence is disappointing, in particular in view of the strong demand by the user community for the establishment of such a system and the efforts by all, Member States, Offices, user representatives and the International Bureau alike, to put such system in place. The very low uptake—less than 120 requests made in respect of more than 500.000 international applications filed during the three year period from 2009 to 2011—might even give rise to the question as to whether the system should be maintained in its current form.

36. On the other hand, the statistics for the first three years and the feedback received by the International Bureau in reply to its Questionnaire as set out in this document suggest that there are very concrete reasons for the low uptake, notably the very limited mix of languages offered by the Authorities currently carrying out supplementary searches, the level of fees charged by those Authorities as well as a continuing lack of awareness among PCT users. In addition, there are a number of further developments which suggest that it may be too early to “give up” on the eventual acceptance and success of the system. Some Supplementary International Searching Authorities (the services of which may be of particular interest to certain groups of users) have only recently begun to offer their services. Recent statistics of the use of the system in 2012 suggest that, with new Authorities having become available, at least some applicants are starting to use the system (if only for some “test cases”) in a more strategic manner, seeking two full searches by major Authorities before which (in their capacity as designated Offices) they most likely will also enter the national phase. Work sharing arrangements amongst national Offices, such as the Patent Prosecution Highway (PPH), may provide additional incentives for applicants to obtain positive reports from more than one Authority and thus may have an impact on the future use of the system. The system has close parallels with the suggested collaborative search and examination system, which is currently piloted by a number of national Offices in their capacity as International Authorities (see document PCT/WG/5/9); that pilot may result in findings which may also have an impact on the future development of the supplementary international search system. Finally, as the relatively low demand for supplementary international searches has resulted in only minimal day-to-day running costs at the International Bureau, the costs to the International Bureau of maintaining the system are virtually zero.

37. Consequently, rather than commencing a discussion at this point in time on how to modify the present supplementary international search system, it is proposed that the Working Group should recommend to the Assembly to adopt the following decision:

“The PCT Assembly, having reviewed the supplementary international search system three years after the date of entry into force of the system, decided:

“(a) to invite the International Bureau to continue to closely monitor the system for a period of another 3 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 increase their efforts to 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; 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 2015, taking into account further developments until then, notably in relation to efforts to move towards collaborative search and examination models and in relation to efforts to improve the quality of the “main” international search.”

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

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