

Patent Cooperation Treaty (PCT) Working Group

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POSSIBLE IMPROVEMENTS TO THE SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

Document prepared by the International Bureau

SUMMARY

1. This document discusses possible improvements to the supplementary international search system in response to a request made by the Working Group at its eighth session in 2015. In particular, it proposes the following amendments to the PCT Regulations on supplementary international search:

- 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.

INTRODUCTION

2. The Working Group, at its eighth session in May 2015, discussed a document (document PCT/WG/8/6) to prepare the review of the supplementary international search system by the PCT Assembly at its forty-seventh session in October 2015. These discussions are summarized in paragraphs 84 to 90 of the Summary by the Chair (document PCT/WG/8/25); paragraphs 239 to 251 of the report (document PCT/WG/8/26) give details of all of the interventions.

3. This document responds to an invitation by the Working Group last year to present a document to its next session to discuss possible improvements to the supplementary international system (see paragraph 250 of document PCT/WG/8/26).

DISCUSSION BY THE MEETING OF INTERNATIONAL AUTHORITIES

4. In preparation of the discussions by the Working Group at its present session, the Meeting of International Authorities, at its twenty-third session held in January 2016, discussed three possible changes to the supplementary international search system, based on document PCT/MIA/23/4, namely:

- permitting a supplementary international search to be based on claims amended under Article 19;
- moving the deadline for requesting supplementary international search to a later point in time; and
- introducing a written opinion to the supplementary international search system.

5. The discussion of these changes by the Meeting of International Authorities is outlined in paragraphs 52 to 58 of the Summary by the Chair (see document PCT/MIA/23/14, reproduced in the Annex to document PCT/WG/9/2). In particular, paragraphs 53 to 55, reproduced below, summarize the comments on the three proposed changes set out in paragraph 4, above:

“53. Authorities supported changing the deadline for requesting supplementary international search from 19 to 22 months from the priority date, which would correspond to the deadline for filing a demand for international preliminary examination.

“54. Some Authorities expressed concerns about allowing the possibility to request a supplementary international search on amended claims. These concerns included that such a supplementary search would be contrary to the original intention to limit supplementary search to national collections or documents in particular languages, that possible amended subject matter should be searched already as required under paragraph 15.25 of the International Search and Preliminary Examination Guidelines, and the limited additional value that this would provide compared to Chapter II.

“55. Some Authorities stated that if a written opinion were introduced as part of supplementary international search, this should be left to the discretion of the Authority providing the supplementary search. In this regard, concerns were also expressed that a mandatory written opinion could deter other Authorities from offering supplementary international search. Some of these Authorities also commented that Authorities offering a written opinion might raise the fees for supplementary international search to cover the extra work of providing the opinion. One Authority, however, did indicate it could be favorable to an amendment to Rule 45*bis*.7(e)(i) to make it mandatory to include explanations with regard to the citations of documents considered to be relevant. Another Authority expressed regret that the opinion it already offered with the supplementary international search report was provided to the same standard as a written opinion accompanying the “main” international search, but could not form the basis of a request under the Patent Prosecution Highway (PPH). That Authority therefore suggested that, at the option of the Authority offering SIS, such opinion should be considered as having the same status as any other written opinion under Chapter I or II.”

POSSIBLE IMPROVEMENTS

SUPPLEMENTARY INTERNATIONAL SEARCH BASED ON AMENDED CLAIMS

6. Paragraphs 7 to 21 of document PCT/MIA/23/4 analyze the possibility to allow a supplementary international search to be based on amended claims. This analysis shows that it would be difficult to envisage how a search on amended claims would supplement the main international search rather than “restart” the international search.

7. A “restarted” international search on the basis of amended claims would not obviously fit into the current legal framework on supplementary international search and would present various problems:

- a “restarted” international search would not be a variant within the supplementary international search system but rather introduce a new element (in essence, a second search on a different set of claims) to the international search;
- it is not clear how a “restarted” international search would add additional value to the applicant compared to the Chapter II procedure;
- the Authority selected for a “restarted” international search would be required to determine if matter beyond the disclosure of the international application as originally filed had been added to the amended claims; if that were the case, the applicant would have no possibility to remedy this during the Chapter I procedure with a view to continuing the “restarted” international search, and instead would have to file a demand under Chapter II to remove the added matter in the international phase;
- it would be difficult to define the scope of amended claims that would be the subject of a “restarted” international search;
- the current legal framework determining competency of International Searching Authorities to carry out supplementary searches may not work in respect of “restarted” international searches; in particular, excluding the main International Searching Authority from carrying out a “restarted” international search would reduce the role of the main international search to a mere “preliminary” international search; and
- the potential for overlap of search documentation and duplication of work by different International Searching Authorities increases.

8. In light of the above conclusions and the concerns, the International Bureau considers it not appropriate to propose to provide for the possibility to request supplementary international search on claims amended under Article 19.

DEADLINE FOR REQUESTING SUPPLEMENTARY INTERNATIONAL SEARCH

9. With regard to the proposal to amend the Regulations so as to postpone the deadline for requesting supplementary international search to 21 or 22 months from the priority date, the main factors would appear to be the following (see also paragraphs 22 to 31 of document PCT/MIA/23/4):

- an extra 3 or 4 per cent of international applications (based on the most recent figures) would have the international search report before the applicant was required to decide on whether to file a request for supplementary international search, leaving only 2 or 3 per cent of applications without an international search report before the new 22 month deadline for requesting supplementary international search;

- a new 22 month deadline for requesting supplementary international search would result in fewer supplementary international search reports being available before the deadline for filing a demand for international preliminary examination; and
- the time available to the Authority to perform the supplementary international search would be reduced; this would increase the impact of processing delays arising from formal requirements not being met, the fees not being paid at the time of filing the request, or the applicant requesting a review on non-compliance with unity of invention determined by the Authority.

10. Given the support by International Authorities to move the deadline for requesting supplementary international search from 19 to 22 months from the priority date to correspond to the deadline for filing a demand for international preliminary examination, a proposal to this effect is set out in the Annex to the present document. Under the proposal, where the International Bureau transmits the supplementary search request and other documents listed in Rule 45*bis*.4(e) after the expiration of 22 months from the priority date as a result of a supplementary international search request being made close to the new proposed deadline, under Rule 45*bis*.5(a), the Authority would start the supplementary international search immediately following receipt of these documents. In these situations, it should be noted that the International Bureau should have received the international search report and written opinion from the “main” International Searching Authority to be able to transmit these documents to the Authority specified for supplementary search at the same time as the request.

ISSUANCE OF A WRITTEN OPINION WITH THE SUPPLEMENTARY INTERNATIONAL SEARCH REPORT

11. With regard to the proposal to amend the Regulations so as to require or permit the Authorities offering supplementary search to issue a written opinion together with the supplementary international search report, there is no need to change the Regulations for more Authorities to provide further explanations in the supplementary international search report to the standard of the written opinion of the International Searching Authority (see paragraphs 32 to 45 of document PCT/MIA/23/4). However, if the regulatory framework were amended to provide further information together with the supplementary international search report, the two main options would be:

- to amend Rule 45*bis*.7(e) to make it mandatory to include explanations of the documents cited in the supplementary international search report that were considered to be relevant; or
- to introduce a written opinion to the supplementary international search report; in this case, in addition to determining the content of the opinion, it would need to be decided under what situations the written opinion should be mandatory, or whether it should be left to each Authority to specify when it would issue the written opinion.

12. At the Meeting of International Authorities, there was no support for requiring the Authorities offering supplementary search to always issue a written opinion with the supplementary international search report. However, one Authority indicated that it could be favorable to an amendment to Rule 45*bis*.7(e) to make it mandatory to include explanations with regard to the citations of documents considered to be relevant. It was also suggested that Authorities should be given the option of offering a written opinion together with supplementary international search report (see paragraph 5, above).

13. In order to provide flexibility to Authorities offering supplementary search, the International Bureau proposes not to amend Rule 45*bis*.7(e) to make it mandatory to include explanations on the relevance of documents cited in the supplementary international search report. However, as these explanations would appear to be useful to applicants and third parties, their inclusion is strongly encouraged.

14. With regard to the proposal to provide the option to an Authority to establish a written opinion with a supplementary international search report, while the addition of such an option might add a potentially useful feature to the supplementary international search system, it would also add another layer of complexity to the system. Authorities already offer differing services for supplementary international search; these differences will only increase by introducing a further option.

15. Moreover, one of the advantages of adding such an option would be the possibility for designated Offices to accept a positive written opinion established during the supplementary international search as the basis of a request under the PCT-Patent Prosecution Highway (PCT-PPH). Yet this would appear appropriate only if the supplementary international search had covered the full PCT minimum documentation. It could thus further contribute to a move away from a truly supplementary international search to, in essence, a full second international search. It might also result in “cherry picking”, for the purposes of PCT-PPH, by applicants who had received two differing reports, one by the main International Searching Authority and one by the Authority specified for supplementary search.

16. The Working Group may thus wish to consider whether to provide for such an option in the Regulations. To facilitate the discussions, the Annex sets out proposed new Rules 45*bis.7bis* and 45*bis.8(b-bis)*. Under proposed new Rule 45*bis.7bis*, any Authority wishing to issue this written opinion would have to include a provision to this effect in its agreement with the International Bureau under Article 16(3)(b). To provide certainty to applicants, the Authority choosing to include this provision would be required to issue a written opinion for all its supplementary international searches. The written opinion would be drawn up in a similar way to a written opinion by the (main) International Searching Authority and would be transmitted to the International Bureau together with the supplementary international search report or declaration that no supplementary international report will be established. However, there would be no requirement to repeat the classification of the (main) International Searching Authority in the written opinion, as this is not part of the supplementary international search report.

17. Where no request for international preliminary examination is received, under new Rule 45*bis.8(b-bis)*, the International Bureau would communicate the written opinion to the designated Office after the expiration of 30 months from the priority date, unless a request for early national phase entry was made by the applicant. The written opinion would be translated into English and the applicant would have the opportunity to make written observations as to the correctness of the translation, as is the case in respect of international preliminary reports on patentability (Chapter I).

18. Where a request for international preliminary examination has been received, the International Bureau would transmit the written opinion to the International Preliminary Examining Authority; a new Section to that effect could be added to the Administrative Instructions, similar to Section 420(b) in respect of the supplementary international search report. The written opinion, under new Rule 45*bis.8(b-ter)*, would then be taken into account by the International Preliminary Examining Authority in preparing any written opinion or the international preliminary report on patentability (Chapter II), unless it had already begun to draw up that opinion or report.

19. The Working Group is invited to comment on the proposed amendments to the PCT Regulations set out in the Annex to this document.

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 45bis

Supplementary International Searches

45bis.1 *Supplementary Search Request*

(a) The applicant may, at any time prior to the expiration of ~~19~~ 22 months from the priority date, request that a supplementary international search be carried out in respect of the international application by an International Searching Authority that is competent to do so under Rule 45bis.9. Such requests may be made in respect of more than one such Authority.

(b) to (e) [No change]

45bis.2 to 4 [No change]

45bis.5 [No change] *Start, Basis and Scope of Supplementary International Search*

(a) [No change] The Authority specified for supplementary search shall start the supplementary international search promptly after receipt of the documents specified in Rule 45bis.4(e)(i) to (iv), provided that the Authority may, at its option, delay the start of the search until it has also received the documents specified in Rule 45bis.4(e)(v) or until the expiration of 22 months from the priority date, whichever occurs first.

(b) to (h) [No change]

45bis.6 and 7 [No change]

45bis.7bis Written Opinion of the Authority specified for Supplementary Search

(a) If so stated in the applicable agreement under Article 16(3)(b), the Authority specified for supplementary search shall, at the same time as it establishes the supplementary international search report or makes the declaration referred to in Article 17(2)(a) as applicable by virtue of Rule 45bis.5(c) that no supplementary international search report will be established, establish a written opinion as to:

(i) whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable;

(ii) whether the international application complies with the requirements of the Treaty and these Regulations in so far as checked by the Authority specified for supplementary search.

The written opinion shall also be accompanied by such other observations as these Regulations provide for.

(b) For the purposes of establishing the written opinion, Articles 33(2) to (6) and 35(2) and (3) and Rules 43.4, 43.6bis, 64, 65, 66.1(e), 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.6 to 70.10, 70.12, 70.14 and 70.15(a) shall apply *mutatis mutandis*.

45bis.8 Transmittal and Effect of the Supplementary International Search Report and Written Opinion of the Authority specified for Supplementary Search

(a) The Authority specified for supplementary search shall, on the same day, transmit

(i) one copy of the supplementary international search report or the declaration that no supplementary international search report shall be established, as applicable, and

[Rule 45bis.8(a), continued]

(ii) if applicable, one copy of the written opinion established under Rule 45bis.7bis,

to the International Bureau and one copy to the applicant.

(b) [No change] Subject to paragraph (c), Article 20(1) and Rules 45.1, 47.1(d) and 70.7(a) shall apply as if the supplementary international search report were part of the international search report.

(b-bis) Unless an international preliminary examination report has been or is to be established, Rules 44bis.2 to 44bis.4 shall apply to the written opinion established under Rule 45bis.7bis mutatis mutandis.

(b-ter) Where an international preliminary examination report is to be established, subject to paragraph (c), Rules 62bis and 66.1bis(d) shall apply to the written opinion established under Rule 45bis.7bis mutatis mutandis.

(c) A supplementary international search report or written opinion established under Rule 45bis.7bis need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if it is received by that Authority after it has begun to draw up that opinion or report.

45bis.9 International Searching Authorities Competent to Carry Out Supplementary International Search

(a) [No change] An International Searching Authority shall be competent to carry out supplementary international searches if its preparedness to do so is stated in the applicable agreement under Article 16(3)(b), subject to any limitations and conditions set out in that agreement.

[Rule 45bis.9, continued]

(a-bis) Any International Searching Authority competent to carry out supplementary international searches may, in the applicable agreement under Article 16(3)(b), state that it will establish a written opinion under Rule 45bis.7bis at the same time as the supplementary international search report or the declaration referred to in Article 17(2)(a) that no supplementary international search report will be established.

(b) and (c) [No change]

Rule 90bis

Withdrawals

90bis.1 to 3 *[No change]*

90bis.3bis *Withdrawal of Supplementary Search Request*

(a) The applicant may withdraw a supplementary search request at any time prior to the date of transmittal to the applicant and to the International Bureau, under Rule 45bis.8(a), of the supplementary international search report or the declaration that no such report will be established and, if applicable, the written opinion established under Rule 45bis.7bis.

(b) Withdrawal shall be effective on receipt, within the time limit under paragraph (a), of a notice addressed by the applicant, at his option, to the Authority specified for supplementary search or to the International Bureau, provided that, where the notice does not reach the Authority specified for supplementary search in sufficient time to prevent the transmittal of the report or declaration and written opinion referred to in paragraph (a), the communication of that report or declaration under Article 20(1), as applicable by virtue of Rule 45bis.8(b), and the communication of that written opinion under Rule 44bis.2, as applicable by virtue of Rule 45bis.8(b-bis), shall nevertheless be effected.

90bis.4 to 7 *[No change]*

[End of Annex and of document]