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September 3, 2008

Madam,
Sir,

This Circular is addressed to your Office in its capacity as an International Searching Authority under the Patent Cooperation Treaty (PCT). It concerns your Office's intentions with respect to offering the service of supplementary international search under the PCT.

It is recalled that the PCT Assembly, at its 36th session, held from September 24 to October 3, 2007, adopted amendments of the PCT Regulations permitting International Searching Authorities to offer the service of supplementary international search from January 1, 2009.

At the 15th session of the Meeting of International Authorities Under the PCT, held from April 7 to 9, 2008, the International Authorities represented at the meeting indicated their intentions with respect to offering the service of supplementary international search as follows (many of the statements of intention were very provisional; the nuances and reasons are not reproduced here but can be seen in paragraph 46 of document PCT/MIA/15/13):

(a) *intention to offer supplementary international search as of January 1, 2009, or shortly thereafter:* Austrian Patent Office, Federal Service for Intellectual Property of the Russian Federation, Nordic Patent Institute, Swedish Patent and Registration Office;

(b) *intention to offer supplementary international search as of January 1, 2010:* European Patent Office, National Board of Patents and Registration of Finland;

/...

(c) *generally positive towards the idea of offering supplementary international search but not yet in a position to suggest even tentative timing (almost certainly not during 2009):* Brazilian National Institute of Industrial Property, Canadian Intellectual Property Office, IP Australia, Korean Intellectual Property Office, State Intellectual Property Office of the People's Republic of China;

(d) *unlikely to offer supplementary international search in the foreseeable future:* Japan Patent Office, Spanish Patent and Trademark Office, United States Patent and Trademark Office.

In order to assist the International Bureau's planning, it would be appreciated if each International Authority could confirm its intentions with regard to offering the service of supplementary international search as soon as possible – if at all possible by *Friday, September 19, 2008*, to enable the International Bureau to inform the PCT Assembly at its upcoming session in Geneva from September 23 to 30, 2008, accordingly.

For those Authorities which intend to offer the service, it is recalled that, prior to commencing with that service, it will be necessary to amend the Agreements under PCT Article 16(3)(b) between the International Bureau and each relevant International Authority. It is further recalled that the PCT Assembly approved such amendments in the following form (see paragraphs 7 to 12 of document PCT/A/36/7 and paragraphs 139 and 153 of document PCT/A/36/13):

(i) the insertion of a new Article 3(4), as follows:

“(4) The Authority shall conduct supplementary international searches in accordance with Rule 45*bis*, covering at least the documentation referred to in Annex E to this agreement, subject to any limitations and conditions set out in that Annex.”

(ii) the addition of a new item (iv) of Article 11(3), as follows:

“(iv) amend the indications and information concerning supplementary international searches contained in Annex E to this Agreement.”

(iii) the addition of a corresponding new Annex E with a title similar to “Supplementary International Search: Documentation Covered; Limitations and Conditions”, depending on the required contents of the Annex (documentation covered is required by Rule 45*bis*.5(f); limitations and conditions are optional according to Rule 45*bis*.9(a)).

In addition, it will be necessary to amend Annex C of each Agreement to include details of the fees which will be charged by the Authority for supplementary search under Rule 45*bis*.3(a) and the extent to which that fee would be refunded under Rule 45*bis*.3(e) in the event that a supplementary search request is considered not to have been made. Authority for such an amendment is not required from the PCT Assembly: the power to make this type of amendment without further approval by the Assembly already exists in Article 11(3) of each Agreement.

Note that it will not be necessary to sign entirely new Agreements (though this can be done if an Authority prefers): these amendments can be made by an exchange of letters between the Director General of WIPO and a person authorized to act for the relevant International Authority.

Those Authorities which intend to offer the service of supplementary international search as from January 1, 2009, or indeed from any time in the first half of 2009, are invited to begin, *as soon as possible*, discussions with the International Bureau on the necessary amendments of the applicable Agreement and the appropriate content of the Annexes to the amended Agreement. Information on both matters should preferably be sent by e-mail to pct.mia@wipo.int. Mr. Michael Richardson (Head, Institutional Relations Section, PCT International Cooperation Division; tel: +41 22 338 9171; e-mail: michael.richardson@wipo.int) will be pleased to answer any further questions which you may have in this context.

Yours sincerely,



Francis Gurry
Deputy Director General