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The International Bureau of the World Intellectual Property Organization
./. (WIPO) presents its compliments and has the honor to transmit herewith the
report (document PCT/R/WG/9/8), adopted by the Working Group, for the ninth
session of the *Working Group on Reform of the Patent Cooperation Treaty*
(*PCT*), which was held in Geneva from April 23 to 27, 2007.

The working documents are also available on WIPO's Web site
(see <http://www.wipo.int/pct/en/meetings>).

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**WORKING GROUP ON REFORM
OF THE PATENT COOPERATION TREATY (PCT)**

**Ninth Session
Geneva, April 23 to 27, 2007**

REPORT

adopted by the Working Group

INTRODUCTION

1. The Working Group on Reform of the Patent Cooperation Treaty (PCT) held its ninth session in Geneva from April 23 to 26, 2007.
2. The following members of the Working Group were represented at the session:
(i) the following Member States of the International Patent Cooperation Union (PCT Union):
Algeria, Australia, Austria, Barbados, Belarus, Belgium, Brazil, Canada, China, Côte d'Ivoire, Croatia, Czech Republic, Denmark, Ecuador, Egypt, El Salvador, Finland, France, Gabon, Georgia, Germany, Greece, Hungary, Indonesia, Ireland, Israel, Italy, Japan, Kenya, Latvia, Mexico, Moldova, Mongolia, Morocco, Namibia, Netherlands, Nigeria, Norway, Oman, Philippines, Poland, Portugal, Republic of Korea, Romania, Russian Federation, Serbia, Singapore, Slovakia, Slovenia, South Africa, Spain, Sudan, Sweden, Switzerland, Trinidad and Tobago, Turkey, Uganda, Ukraine, United Kingdom, United States of America; (ii) the European Patent Office (EPO).
3. The following Member States of the International Union for the Protection of Industrial Property (Paris Union) participated in the session as observers: Argentina, Bangladesh, Chile, Islamic Republic of Iran, Rwanda.

4. The following intergovernmental organizations were represented by observers: African Intellectual Property Organization (OAPI), African Regional Intellectual Property Organization (ARIPO), African Union (AU), Economic Community of West African States (ECOWAS), Eurasian Patent Organization (EAPO), European Community, World Trade Organization (WTO).

5. The following international non-governmental organizations were represented by observers: Asian Patent Attorneys Association (APAA), Centre for International Industrial Property Studies (CEIPI), European Law Students' Association (ELSA International), International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP), International Association for the Protection of Intellectual Property (AIPPI), International Federation of Industrial Property Attorneys (FICPI), Third World Network (TWN), Union of European Practitioners in Industrial Property (UNION).

6. The following national non-governmental organizations were represented by observers: American Intellectual Property Law Association (AIPLA), German Association for Industrial Property and Copyright (GRUR), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA).

7. The list of participants is contained in Annex I.

OPENING OF THE SESSION

8. Mr. Francis Gurry, Deputy Director General of WIPO, on behalf of the Director General, opened the session and welcomed the participants. Mr. Claus Matthes (WIPO) acted as Secretary to the Working Group.

ELECTION OF A CHAIR AND TWO VICE-CHAIRS

9. The Working Group unanimously elected Mr. Alan Troicuk (Canada) as Chair for the session, and Ms. Isabel Chng Mui Lin (Singapore) and Mr. Gennady Negulyaev (Russian Federation) as Vice-Chairs.

ADOPTION OF THE AGENDA

10. Discussions were based on the draft agenda contained in document PCT/R/WG/9/1¹.

11. The Chair noted that the matters raised in documents PCT/R/WG/9/6 and 7 were not expressly mentioned in the draft agenda and should therefore, if the Working Group agreed, be included as sub-items under item 4 (consideration of proposals for reform of the PCT²).

¹ This and other working documents for the session are available on WIPO's website at http://www.wipo.int/meetings/en/details.jsp?meeting_id=12542.

² References in this document to "Articles" and "Rules" are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT ("the Regulations"), or to such provisions as proposed to be amended or added, as the case may be. References to "national laws", "national applications", "the national phase", etc., include reference to regional laws, regional applications, the regional phase, etc. References to an "Authority" or "International Authority" are to an International Searching Authority and/or International Preliminary Examining Authority, as the case requires. References to "the Assembly" are to the International Patent Cooperation Union (PCT Union) Assembly.

12. The Delegation of Switzerland stated that the present session of the Working Group was expected to bring reform of the PCT to a formal conclusion. A number of major proposals had already been agreed upon and some remaining proposals awaited a decision at the present session, which would presumably be the last session of the Working Group, at least for some time to come.

13. The Delegation noted that item 4(d) of the draft agenda concerned its proposals concerning the declaration of the source of genetic resources and traditional knowledge in patent applications. The Delegation had submitted its proposals not as a protagonist but rather in order to be supportive of the international debate and because of its interest in achieving balanced patent protection for inventions in the field of biotechnology. The Delegation continued to consider that discussions on disclosure requirements were important and that its proposals offered an excellent way forward, but believed that the conclusion of PCT reform process should not be delayed by continued discussions on the Delegation's proposals and that the Working Group should not hold further meetings solely for the purpose of discussing those proposals. Accordingly, the Delegation proposed the omission of item 4(d) from the agenda of this session.

14. The Delegation emphasized that the proposed omission did not imply that it wished to withdraw its proposals altogether; rather, they should be considered as remaining on the table for future discussion. It recalled that WIPO's Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC) had agreed to review current issues relating to genetic resources at its next session, and the question of disclosure requirements was expressly mentioned in the IGC's decision on future work. The Delegation would, as it had done in the past, actively contribute to discussions in the IGC.

15. The Delegation of Brazil, supporting the statement made by the Delegation of Switzerland, stated that it agreed with suspending consideration of the item at this session. At the adoption of this report, the Delegation of Brazil clarified that it agreed with the omission of item 4(d) from the agenda, as proposed by the Delegation of Switzerland, in order to avoid duplication with ongoing work on the same subject matter in other fora, namely, the Convention on Biological Diversity (CBD), the Doha Development Round and the WTO TRIPS Council.

16. The Working Group adopted as its agenda the draft appearing in document PCT/R/WG/9/1, subject to the omission of item 4(d) (declaration of the source of genetic resources and traditional knowledge in patent applications: proposals by Switzerland) and to the addition of the two further matters covered in documents PCT/R/WG/9/6 and 7 as, respectively, item 4(d) (proposed amendment of Rules 29.1, 48.2(c) and 90*bis*.1) and item 4(e) (proposed amendment of Rule 26*bis*.3(d)).

CONSIDERATION OF PROPOSALS FOR REFORM OF THE PCT

SUPPLEMENTARY INTERNATIONAL SEARCHES

17. Discussions were based on documents PCT/R/WG/9/2 and 2 Corr., taking note also of informal papers made available before or during the session by the Delegations of Japan,

Spain and the United States of America, and by the Representatives of the EPO and EPI (see the PCT reform electronic forum³ for those papers).

18. The Delegation of Japan noted that it had recently posted on the PCT reform electronic forum an informal paper (reproduced in Annex II; see paragraph 24, below) setting out its views on the proposed supplementary international search system. The Delegation stated that its position reflected its desire for sound developments in the PCT system and for an increase in benefits for users. The Delegation wished to clarify that its opposition to the concept of the proposed system was based on four main reasons: (a) supplementary international search in the context of the objectives of international search; (b) the responsibilities and the discretions of an International Searching Authority; (c) the decentralized system of International Searching Authorities; and (d) discrimination in terms of national language. The Delegation further explained its position as outlined in the following paragraphs.

(a) First, in the context of the objectives of an international search, the Delegation explained that no differences could be found between an international search report and a national or regional search report in terms of (1) the functions they perform and (2) the contents that could be expected. Therefore, no good reason could be found to institutionalize in the existing PCT scheme a new type of international search that goes beyond the existing national or regional search.

(b) Second, from the viewpoint of the responsibilities and the discretions of an International Searching Authority, the Delegation believed that it was the responsibility of each Authority to conduct a search to the extent that the Authority considered appropriate. If an Authority considered itself to lack the ability to search sufficiently for documents in a specific language, the Authority could outsource a part of the search to an outside search organization, on the condition that the Authority would bear full responsibility for the final result of the search as represented by the international search report. Under the current PCT system, the decision to outsource a part of the search was left to the discretion of the Authority.

(c) The third reason came from consideration of the decentralized system of International Searching Authorities. In a collaborative system that would, in effect, require two or more Authorities to work on a single international search (that is, single in the functional sense, if not physically single), an individual Authority's responsibility for the production of an international search report would become unclear. This would result in a system in which no International Searching Authority would bear responsibility or clear accountability for collaborative work results. Rather, a decentralized system in which all Authorities had clear responsibility and accountability and would compete with each other to offer users a better and more user-friendly service was desirable.

(d) Fourth, the proposed supplementary international search would lead to discrimination in terms of national language. It would, by its nature, result in a systematic shift of burden, which otherwise would be equally borne by all International Searching Authorities, to a specific Authority on the sole ground that the Authority had a specific procedural language (normally, its national language). This amounted to unfair treatment of an International Searching Authority based on its national language.

³ See WIPO's website at <http://www.wipo.int/pct/reform/en>.

19. The Delegation of Japan thus also remained opposed to the specific proposals for a supplementary international search system as described in document PCT/R/WG/9/2. First, the Delegation believed that there was a lack of fact-based analysis. Rather, there should be a quantitative analysis of the alleged problems with the existing scheme of the PCT as well as an identification of the actual scope and nature of the needs of users. Otherwise, one could not evaluate whether the benefits of the proposed supplementary international search system would exceed the cost of institutionalizing the supplementary international search within the PCT framework. Introducing a new system into the PCT scheme without such a fact-based analysis could result in a mere waste of the PCT budget which could otherwise be allocated to other programs.

20. Second, the Delegation expressed several other specific concerns about the proposals in document PCT/R/WG/9/2, as follows: (1) the ambiguous legal ground of the supplementary international search report under the PCT; (2) the lack of quality assurance of the supplementary international search report; (3) the lowering of morale for the quality of the international search report; (4) discrepancies in contents as between an international search report and a supplementary international search report; and (5) the inefficient usage of search resources worldwide.

21. Therefore, the Delegation believed that the proposed supplementary international search system was neither the only solution nor the appropriate solution. The difficulties of conducting prior art searches of documentation written in specific languages could be better solved by other measures. There were several possible alternatives to supplementary international search, including the following: (1) improvement in the search environments of International Searching Authorities; (2) entrustment of international search to other organizations; and (3) early entry into the national phase. The Delegation believed that the legitimate needs of users should be identified by conducting a fact-based analysis of quantitative data and, if necessary, there should be discussions of other alternatives to supplementary international search, including those just mentioned.

22. The Delegation noted that it had received some questions and comments relating to its paper from certain other Delegations, both formally and informally. The Delegation believed that responses to most of those questions and comments were already reflected in its paper, but the Delegation wished to briefly respond to them, as set out in the following paragraphs.

(a) The Delegation of Japan noted that an informal comment from a Delegation which was a proponent of the proposed supplementary international search system, and which was also an International Searching Authority, had stated that the Delegation of Japan's argument failed to recognize the fact that most applicants were restricted in their options with regard to the primary International Searching Authority, and that if they must use an International Searching Authority which would not or could not perform such an additional voluntary service, then their only current option was to hire a private contractor to perform the search. If so, the search results were not available to the original International Searching Authority or other Offices. The Delegation of Japan noted, however, that the other Delegation admitted that an International Searching Authority could outsource searching in an additional language, and also that the supplementary international search would primarily be conducted on the basis of the expressed desires of users in that member country. Therefore, the Delegation of Japan believed that the other Delegation could outsource a part of its search to an outside search organization and provide a voluntary service to its users if it recognized the serious desires of its users. Of course, as emphasized in section I-2 of the Delegation of Japan's paper, when an International Searching Authority outsourced a part of a search, it

should take full responsibility for the final result represented by the international search report as a whole. In doing so, the search results would be stated in a single international search report and made available not only to the original International Searching Authority but to all other Offices.

(b) The Delegation of Japan noted that the same other Delegation had made a comment about section I-3 of the Delegation of Japan's paper to the effect that the primary International Searching Authority would have no knowledge as to whether a supplementary search was being performed on a given application, and as such would have no basis for not fulfilling its responsibility as an International Searching Authority. The primary International Searching Authority, regardless of whether a supplementary search was requested, would still have to satisfy the requirements for international search as set forth in the Treaty, Regulations and Guidelines. The Delegation of Japan insisted that each International Searching Authority should carry out an international search for all prior art documents, regardless of the language of the documents, to the extent considered appropriate for providing the information necessary to determine the novelty or inventive step in light of the objectives of the international search. The Delegation of Japan also expressed concern about the lowering of morale of an Authority wishing to prepare high quality international search reports. If the Japan Patent Office as an International Searching Authority, for example, were committed to acting as an Authority responsible for conducting supplementary international searches of Japanese patent documents, there would be a large possibility that the sense of responsibility of other International Searching Authorities having procedural languages other than Japanese would be undermined, noting that it is stipulated in PCT Article 15(4) that an International Searching Authority "shall endeavor to discover as much of the relevant prior art [which would include Japanese patent documents] as its facilities permit". Such a possible lowering of the morale of an International Searching Authority could give rise to the risk of lower quality international search reports being prepared, especially regarding the search of documents in a procedural language of an Authority conducting supplementary international searches.

(c) The Delegation of Japan noted that the same other Delegation had stated that there are specific desires of users for the supplementary international search system; however, that other Delegation had failed to provide the quantitative data which the Delegation of Japan believed should be provided (see paragraph 19, above).

(d) With regard to ambiguous legal ground, the Delegation of Japan noted that the same other Delegation had stated that there was nothing in the Treaty that would preclude the addition of supplementary international search to the PCT system. The Delegation of Japan wished to point out that the supplementary international search report, unlike the international search report which is expressly mandated in the Treaty, is not clearly grounded in the Treaty language, even though the administration of the supplementary international search system would consume substantial financial resources.

(e) The Delegation of Japan noted that the same other Delegation had stated that it would seem that the proposed supplementary international search system was largely revenue neutral. However, there was no quantitative analysis of the scope and nature of the need. The Delegation of Japan was concerned that the proposed supplementary international search could result in a mere waste of the PCT budget which could otherwise be allocated for other programs.

(f) The Delegation of Japan noted that the same other Delegation had stated that it would seem the argument made by the Delegation of Japan in the last paragraph of section II-2 of its paper was contrary to the Delegation of Japan's earlier stated concern with respect to the quality of the supplementary search, which seemed to suggest allowing Offices that had not met the stringent requirements for becoming an International Searching Authority to perform the supplementary search. The Delegation of Japan wished to point out that there would be national Offices which were not International Searching Authorities but which still had adequate search capability that might be equal to International Searching Authorities in a specific language, in specific technical fields, etc. As far as the International Searching Authority took full responsibility for the final result of an international search, the Authority could entrust a part of the international search to such a national office.

(g) With regard to the early entry into national phase, the Delegation of Japan noted that the same other Delegation had pointed out that the Delegation of Japan's suggestion would not lead to communication of the search result in an efficient manner to other Offices, and that such a practice was contrary to the intention behind the supplementary international search system, which was to prevent unnecessary national stage entries and fees. In response to this comment, the Delegation of Japan stated that, in the case of the Japan Patent Office, any designated Office registered with that Office can access the Office actions issued by it over the Internet in an efficient manner, and also that it was useful for users to prevent unnecessary national stage entries.

(h) With regard to an informal paper that the EPI had posted on the PCT reform electronic forum, the Delegation of Japan was not sure whether the EPI had taken the Delegation's views into account. Most of the comments were responded to in the Delegation's paper. With regard to the "Patent Prosecution Highway", the Delegation wished to point out that PCT applications were also covered by the existing Patent Prosecution Highway scheme, for example, between Japan and the Republic of Korea. Japan and the United Kingdom would also commence a Patent Prosecution Highway pilot project in July 2007 which would also cover PCT applications. In addition, in Japan, there was no difference between a PCT search plus a written opinion as distinct from a national search plus a written opinion, understood in the light of the quality and scope as explained in the Delegation's paper.

23. In conclusion, the Delegation of Japan reiterated that it was opposed to the proposal to institutionalize supplementary international searches within the PCT framework. The Delegation was not supportive of the supplementary international search proposal being sent to the PCT Union Assembly. The Delegation also did not support any hasty drafting of text changes to the PCT, PCT Regulations, or PCT Guidelines which would presuppose the introduction of the supplementary international search system. Rather, the Delegation wished to see Member States first conduct a fact-based analysis of the scope and nature of the needs of users, as well as a quantitative analysis of those needs, and then, if necessary, establish an appropriate forum to discuss, in a comprehensive manner, all possible alternatives including those explained by the Delegation.

24. The Delegation further requested that its paper be included as an Annex to the Working Group's report (see Annex II).

25. The Delegation of Spain summarized its views with regard to the proposed supplementary international search system, as set out in a paper that it had recently posted on the PCT reform electronic forum. The Delegation noted that the Spanish Patent and

Trademark Office held an appointment as an International Searching Authority. Its position had been explained previously in the Working Group and in the Meeting of International Authorities under the PCT.

26. First, the Delegation believed that introduction of the proposed new system would go against the philosophy of the PCT, which essentially was based on the carrying out of a single search on the basis of the PCT minimum documentation and according to guidelines for international search that were common to all International Searching Authorities. The Delegation noted that introducing the proposed new system would not result in comprehensive searches, because to achieve that would require several supplementary searches having regard to differences in both language and technical field. It was therefore perfectly normal to accept that any international search was necessarily incomplete, since there might be technical fields or languages that were not covered by any Authority. The Delegation therefore believed that the aims outlined in the proposal would not be achieved.

27. The Delegation further stated that there were intrinsic issues relating to the current structure of the Treaty. It believed that the new system would, to some extent, represent a departure from the international phase. The establishment of supplementary searches in the present structure would be more a matter for the national phase, where the search is carried out on the basis of the national Office's own documentation.

28. Furthermore, as had been mentioned on previous occasions, the Delegation was concerned about the workload implications for the International Searching Authorities in carrying out the proposed new supplementary searches. The Delegation noted that most of the Authorities already found it difficult to comply with the timeframes set forth in the Regulations.

29. Another issue of concern to the Delegation related to the possibility that the new system would result not so much in supplementary searches but rather contradictory search results. The Delegation believed that this was a serious matter, since it would create a degree of insecurity among applicants. It was necessary to take into account that the system must be generally acceptable to all. In addition, the Delegation believed that the proposed new system would cause applicants to incur additional costs, again going against the philosophy of the PCT. This would be damaging particularly to small and medium sized enterprises and independent inventors.

30. The Delegation believed that improvements in the international search system would best be obtained by extending the PCT minimum documentation, enhancing the tools for carrying out international searches, increasing the efficiency of the PCT Guidelines for International Search and Preliminary Examination, stressing those cooperation issues which were established by the Treaty, and strengthening the quality framework set out in Chapter 21 of those Guidelines.

31. The Delegation of China noted that its standpoint on the proposal concerning supplementary international search had been clearly and consistently stated in the sessions of the Working Group as well as those of the Meeting of International Authorities under the PCT. The Delegation had repeatedly emphasized that the supplementary search should be truly supplementary in nature. The primary purpose of supplementary search should be to overcome the insufficiency of the normal international search caused, for example, by language obstacles. If the supplementary search departed from that purpose, there would be resulting disadvantages, namely, increasing the complexity of the system, reducing the

efficiency of the international search, causing duplication of work and waste of resources, and putting more burden on both Authorities and applicants; those disadvantages would surpass the possible advantages that could be expected from the system.

32. The Delegation suggested that the following changes to the text of the proposed amendments of the Regulations should be made in order to ensure that the proposed search would be truly supplementary in nature:

(a) First, the wording of Rules 45*bis*.4(e) and 45*bis*.5(a) should be changed to provide clearly that the request for supplementary search would be transmitted by the International Bureau to the relevant Authority only after the main international search report and the written opinion had been received by International Bureau, and that the supplementary search would be started by that Authority only after the main international search report and the written opinion have been received by it. The Delegation was aware that in practice some international search reports were not transmitted to the International Bureau in a timely fashion. However, the Delegation did not believe that establishing the mechanism of supplementary search to overcome that problem was a sound approach. It was the responsibility of the International Bureau to encourage and require all of the International Authorities to finish their work within the time limits prescribed by the Treaty and the Regulations, which was important for the normal operation of the PCT system.

(b) Second, the Delegation believed that the proposed text should emphasize that the supplementary search report should not repeat the contents of the main international search report. To this end, the Delegation suggested changing the wording of Rule 45*bis*.7(c) by replacing the words “the supplementary international search report *need* not contain the citation of any document cited in the international search report” with the words “the supplementary international search report *should* not contain the citation of any document cited in the international search report”.

33. The Delegation of Serbia emphasized that it was in principle against the institutionalization of the supplementary international search in the PCT framework. There were several reasons for this position and, summed up, they would be the same as those expressed by the Delegations of Japan and Spain. The Delegation reiterated that the philosophy of the PCT was based on the carrying out of a single search, and institutionalizing supplementary searches would go against that philosophy, and would also give rise to a kind of legal uncertainty as emphasized by the Delegation of Spain. The Delegation also emphasized, however, that, if there was a consensus to accept such institutionalization of supplementary searches in the PCT framework, the Delegation would not oppose it and would give constructive comments on the proposal set out in document PCT/R/WG/9/2.

34. The Delegation of Germany stated that it had taken note of the fact that there was some support among the International Searching Authorities for introducing supplementary international searches into the PCT system. As the German Patent Office is not an International Searching Authority, it would not be directly affected by such an amendment. The Delegation shared the desire of other delegations to further improve the results of searches in the international phase. It was important for the applicant to know in the international phase whether the invention was patentable in order to avoid unnecessary additional costs when entering the national phase.

35. However, the Delegation saw some relevance in the arguments raised against the introduction of supplementary international searches into the PCT system by amending the Regulations. Its major concern was that there was no basis for introducing additional searches in the existing PCT system. According to its wording and its rationale, the PCT only provided for one international search. That search should be of high quality and fulfil its objective of discovering relevant prior art at an early stage in the international phase. In order to introduce a supplementary international search into the PCT system, it would therefore, in the Delegation's view, be necessary to change the relevant provisions of the PCT itself.

36. In addition, the Delegation believed that the primary concern should be to improve the quality of the main international search before considering alternative approaches aimed at improving the outcome of searching activities in the international phase.

37. The Delegation of the United States of America stated that it appreciated the continued efforts of the International Bureau in advancing discussions on this matter. It continued to view the proposal as having a great deal of merit. It was particularly of benefit to applicants and has been strongly desired by users in the United States of America. It would also serve to improve cooperation among the International Authorities, something that was important as the PCT looked to the future.

38. At past sessions of the Meeting of International Authorities under the PCT and the Working Group, the Delegation had expressed a clear preference for a supplementary search system which was purely sequential in nature. Its preference for a sequential system was based on the fact that such a system would be in line with the goals of PCT reform and would simplify the structure of the Regulations while creating a reformed system which reduced the workload on Offices, promoted work sharing and mutual exploitation, and provided for a more beneficial work product for users of the PCT system. In contrast, other Authorities had argued for a system which allowed for concurrent supplementary searches, primarily out of concern that there should be adequate time for the Authority concerned to carry out a proper supplementary search. The Delegation believed that the present proposal struck a reasonable balance between those two positions by establishing a system which allowed sufficient time for the primary Authority to complete the main international search and for applicants to review the main search report and make decisions on requesting supplementary searches, while at the same time providing an adequate period for Authorities in which to prepare supplementary search reports. As such, the Delegation continued to support the concept of a supplementary international search.

39. The Delegation recognized that certain Offices had objections in principle to the proposal as complicating the PCT system overall. However, the Delegation urged those Offices not to block advancement of the matter in view of the fact that the establishment of a supplementary search system was highly desired by applicants, that it would substantially improve the quality of the international phase work product, and that the system as proposed was entirely optional on the part of both applicants and Authorities. It would be exceedingly disappointing for the Working Group's discussions to come this far on such a highly desired proposal and not to conclude with some sort of tangible results. The Delegation noted that an informal paper prepared by it was being made available to the Working Group.

40. The Delegation of Israel stated that, generally speaking, a single search was insufficient to reveal all prior art relevant to a particular invention. Therefore, the PCT system should attempt to locate as much prior art as possible in the international phase without duplication

of search efforts. It was very important for applicants to know as much as possible about relevant prior art before entering the national phase so as to enable more accurate drafting of amendments to the claims. In other words, additional searches would add value for all applicants.

41. On the other hand, the Delegation believed that the establishment of supplementary international search reports would also provide a great benefit for national Offices. Strengthening the international phase by providing a further option of supplementary international searches would result in reduction of the workload of designated and elected Offices (such as, for example, the Israel Patent Office) by allowing the results of the additional search to be used to a greater extent. Establishing the supplementary international search would considerably increase the confidence of more and more designated Offices in using international search results in the national phase.

42. The Delegation stated that those were the main reasons for its strong support for the provision of optional supplementary international searches. The Delegation also believed that the supplementary international search system should be flexible, simple and optional for all applicants, as outlined in the following paragraphs.

(a) Taking into consideration the fact that certain Authorities were facing difficulty in meeting the present deadline for establishing international search reports before the publication deadline, flexibility in the time limit for establishing supplementary international search reports would be necessary. The time limit for establishing the supplementary international search report should probably be 28 months from the priority date. The new procedure should not effect the timeliness of the international phase in order to avoid further complication of the whole PCT system.

(b) It should be possible for the applicant to choose any International Searching Authority.

(c) If the applicant decided to file the request for the supplementary international search, the request should be filed at the International Bureau, as proposed.

(d) The scope and contents of the supplementary international search should be similar to the present search under Chapter I of the Treaty.

(e) Fees associated with the proposed supplementary international search should be a matter of serious concern, particularly for inventors (individual applicants). It should also be taken into consideration that the introduction of supplementary international search procedure would add new burdens on the International Bureau which would have to prepare translations for the "WO" publication if it were to be established at this stage.

(f) Supplementary international search reports should be available for national Offices and third parties on WIPO's PatentScope website.

(g) As to the relationship between supplementary international search and international preliminary examination, an Authority should not carry out a supplementary search if it has received a demand for international preliminary examination.

43. The Representative of the EPO stated that, when the Working Group started discussing this proposal in 2004, the principal aim was to develop something which would benefit users primarily. There were other objectives in the PCT reform exercise, namely, improving efficiency, helping the International Authorities with their workload, etc., but specifically on this proposal, the objective was to help users with a very specific problem. As users said, and as was borne out by Authorities and Delegations, users were, in practice, often surprised by citations of new prior art on entry into the national phase. Those citations would have been discovered during the international phase if the international search report had been truly comprehensive, but everyone knew that, living in the real world, no international search report could be completely comprehensive.

44. The Representative's understanding was that this proposal would try to address the problem in a very practical and pragmatic way rather than in a philosophical way. All acknowledged that the introduction of a system of supplementary searches into the international phase would amount to a kind of acknowledgement that the international search has been less than perfect, which was not the rationale underlying Article 16. The Representative understood that, but simply stating philosophical positions would not help users deal with their problem. Some of the objections raised represented a failure to address the fundamentals of the proposal. The Representative stated that the proposal did not suggest that any International Searching Authority should diminish the quality of its own searches or that they should be anything other than as comprehensive as possible. Rather, the proposal was for something that was truly supplementary or complementary to the international search report. The proposal would not prevent any Authority which so wished from outsourcing part of its activities if it believed that it could not cover all relevant languages.

45. The Representative noted the suggestion that the Working Group should defer further discussion pending the collection of some kind of empirical data in a study designed to show how often it happened that new relevant prior art turned up after entry into the national phase. The Representative believed that such a study would be very difficult to carry out, that it would take an enormous amount of time, and that it was by no means clear that Offices and users would agree as to its usefulness. The best indicator of whether the supplementary international search system would actually be useful or not would be to implement it and see to what extent it was actually used in practice. It was an optional system for both Authorities and applicants. If, over a period of, say, three to five years, applicants made little use of the system, then nothing would have been lost. Such information would be a perfect indicator of whether the project was useful or not. The mere fact that the system had been implemented in the PCT Regulations would not mean it had to continue in perpetuity if experience showed that it was not a useful system. The Representative believed that, in reality, the best way to assess the long term future of the proposal would be to implement it and test its usage in practice.

46. The Representative reiterated its view that the aim of the proposal was to be of benefit to users. Some of the delegations which had taken the floor on the matter had articulated what they believed were the views of users and given reasons why they thought the proposal would not benefit users. The Representative suggested that the representatives of users should themselves inform the Working Group whether they felt the proposal to be a useful one or not.

47. The Delegation of the United Kingdom stated that it shared the view of the Representative of the EPO that the proposal was very much for the benefit of users. It noted that users in the United Kingdom had always highlighted the importance of obtaining as clear

a view as possible of the prior art during the international phase, before having to make costly decisions about whether and where to enter the national phase. With that in mind, the Delegation supported the proposal for supplementary international searches in general terms, viewing it as a practical proposal that would add practical value to the international search and hopefully provide those users who wished to use it with a better end product. The Delegation thanked the Secretariat for the balanced solution that had been achieved to the question of sequential as against concurrent searches. The proposal should hopefully minimize duplication of work while still being workable. The Delegation supported the view just expressed by the Representative of the EPO to the effect that the best means of testing the usefulness of the proposal would be to implement it and see what happened in practice.

48. The Delegation of the Russian Federation confirmed its support of the concept of supplementary international searches. It believed that the concept was in the interests of applicants since it would help to fulfil the main purpose of the PCT, namely, to provide the applicant with as much information as possible during international phase as to the patentability of the invention and thus the likely outcome in the national phase, noting the great expense of proceeding to the national phase. In the Delegation's view, the philosophy of supplementary searches was not contradictory to the philosophy of the PCT in general. The Delegation therefore supported the compromise proposal prepared by the Secretariat, which provided a good basis for discussion and reaching a positive result.

49. The Delegation of Finland expressed its agreement with those delegations that had spoken in favor of the introduction of supplementary international searches. In the Delegation's view, the main reason for the proposal was to strengthen the international phase in order to avoid the occurrence of new citations of prior art in the national phase, and thus to avoid unnecessary costs for the applicant.

50. The Delegation of the Philippines expressed its support for the Secretariat's continuing efforts to improve the quality of international searches for the benefit of patent applicants and other interested parties. It believed that those efforts reflected a collective and significant thrust towards the strengthening of the role of intellectual property in the socioeconomic and cultural development of nations. The Delegation commended the Secretariat for coming up with a more transparent version of the main features of the proposed supplementary search system. It noted that its earlier concerns regarding ambiguity pertaining to the freedom or option of International Searching Authorities to decide whether to provide a supplementary search service and the conditions thereof had now been addressed. In particular, the main features of the proposed supplementary search system had been amended to provide clarification and delineation on the acceptable conditions under which a request for a supplementary search could be denied by an Authority.

51. The Delegation of the Republic of Korea expressed its support for the introduction of a supplementary search system that would enable in practice the undertaking of sequential searches, even though the Delegation agreed with the opposition of certain delegations that believed that the supplementary search system could have some disadvantages or problems, such as in connection with the responsibility of the International Searching Authority, discrimination in terms of national language, legal matters, etc. The Delegation supported the proposal for two main reasons. First, it considered that the main international search was currently subject to limitations in terms of accessing some documents due to language-related problems, etc. Those problems did not seem to be solvable within a few years, and the present proposal represented one possible solution. Second, the proposal could be of benefit

to applicants who wished to obtain more complete search results during the international phase. However, the Delegation also stated that it was important for the Secretariat and all Authorities to make more efforts towards improving the quality of the main international search, in addition to introducing the proposed supplementary search.

52. The Delegation of Canada expressed its support for the proposed supplementary search system in general. While the Canadian Intellectual Property Office as an International Searching Authority Office would not, at least in the short term, be in a position to offer this service, the Delegation would not wish to restrict the ability of any Authority that was prepared to offer the service from doing so, or the ability of applicants to make use of the service. The Delegation had consistently expressed its preference for a sequential system, but viewed the present proposal as a workable compromise, and looked forward to a more detailed discussion of the proposed amendments of the Regulations.

53. The Representative of JPAA, while understanding the object of supplementary international search to some extent, agreed with the opinion of the Delegation of Japan. The most important thing was that each International Searching Authority make every effort to improve the quality of international search reports. From that viewpoint, the supplementary international search was not essential. The Representative also feared that the supplementary international search would result, in practice, in increased fees for obtaining a more correct international search report. The Representative thought it unnecessary to repeat the other reasons given by the Delegation of Japan, since the Delegation's explanation was sufficient. Additionally, regarding the language problem, the Representative noted that the Japan Patent Office had been widely distributing English language abstracts of Japanese patent documents, and the Representative hoped that other national Offices would plan to distribute Japanese language abstracts of patent documents that were in languages other than Japanese. Such steps would gradually reduce the language barrier associated with searching Japanese language documents.

54. The Representative of AIPPI stated that his organization was in favor of the proposal to introduce supplementary international searches. There were in the patent world several linguistic areas, including, for example, one area in which three important languages were used, namely, English, French and German, and other areas in which the languages used include Japanese, Chinese, Korean and Russian. People living in the former area in general could not read documents written in those other languages. Abstracts in Japanese, for instance, were normally not sufficient, because an abstract is just that, an abstract and nothing more. The detailed information that is important for the real examination procedure was often difficult to access. The Representative believed that, by means of the proposed supplementary international search, there would be better access to otherwise inaccessible documents coming from other linguistic areas. This would be a great improvement for PCT applicants designating most countries in the world when it came to entry into the national phase, noting that at present it is very often the case that a big area of prior art which should be taken into consideration is in effect not covered by the international search. The Representative noted that there were some problems associated with the requirement of unity of invention, but suggested that those problems should not arise in the majority of cases and could in any event easily be handled by way of dividing the applications concerned, and hoped that the proposal would proceed.

55. The Representative of ATRIP, also representing CEIPI, noted that those organizations were academic in nature and therefore did not represent PCT users only. The Representative, speaking for himself personally, supported the introduction of the proposed supplementary

international search system as a welcome innovation in the system. It was not clear to the Representative what basis there could be for opposing such a system given that participation in it was optional and that the system would not be legally binding on Authorities that did not participate. The Representative did not share the view of those Delegations that believed that the system proposed was contrary to the philosophy of the PCT, which was set in the 1960s, that is, 40 years ago. Many things had changed since then: needs, practices and the system itself. One of the great merits of the PCT system had been its dynamism and its ability to adapt to the times as necessary. Some of the evolution that had already occurred in the system had been contrary to the original philosophy of the PCT system, for example, the introduction of the written opinion by the International Searching Authority, but that had not prevented the adoption and use of the new procedure. The Representative also noted that, at the outset of the PCT, it was assumed that there would eventually be a single International Searching Authority, as specifically stated in Article 16(2), but over the years there had been a proliferation of International Searching Authorities. That was certainly not a temporary arrangement but rather was probably both irreversible and irresistible, and the system was working well. Few people would say today that the current plethora of International Searching Authorities was against the underlying philosophy of the PCT. The Representative also stated that the argument as to lack of legal basis in the Treaty was also not very convincing, noting that many innovations had been introduced over the years, to the satisfaction of all, although the legal basis was not explicitly clear in the Treaty itself.

56. The Representative of AIPLA expressed satisfaction with the compromise proposal that would avoid certain difficulties that had prevented agreement from being reached previously on the introduction of the supplementary international search system. The Representative found it hard to understand the objections that were now being raised by certain delegations and were a source of disappointment to users. The purpose of introducing supplementary searches was really to address a quality issue, and it was not clear why any delegation would be opposed to patents of higher quality. That result was the main objective of users in supporting the proposal. If a supplementary search did not reveal any more relevant prior art than the main search revealed, applicants would have some assurance that a quality patent would then issue, and that would be equally reassuring for Offices, which wish to uncover the most relevant prior art. On the other hand, if a supplementary search did reveal more relevant prior art, that would be to everyone's advantage: the applicant would have the opportunity to amend the claims during the national stage, and the Office would have the most relevant art before it, so again a quality patent would be more likely to issue from the system. The Representative believed that an analysis by Authorities of the results over time of supplementary searches would probably suggest ways in which the quality of the main search could be improved and areas where there could be more cooperation between Authorities, including more sharing of search results. Given the broad spectrum of likely benefits for all parties, and given the entirely optional nature of the proposal so far as both Authorities and applicants were concerned, it was difficult to see reasons why it should not proceed. The Representative expressed the hope, on behalf of applicants, that delegations would take the opportunity at this, perhaps the last, meeting of the Working Group, to recommend the proposal to the Assembly and to allow applicants to have access to supplementary searches from those Authorities that were willing to provide that service.

57. The Representative of GRUR noted that he had been personally deeply involved in the development of the PCT, having been a participant in the first meeting of the Assembly in 1978, Chairman of the Assembly in 1992, and for some time a member of the International Bureau and responsible for PCT operations. He recalled that the original philosophy as expressed and established in the text of the PCT in 1970 at the Washington Conference was to

have only one International Searching Authority. At that time, it was expected that this would be the International Patent Institute (IIB), which has since been integrated into the EPO. When the Representative joined the International Bureau in 1987, it was somewhat concerned by the lack of acceptance of the PCT by users. In 1987, the number of applications was about 1,000. The Representative noted the amazing success the PCT had since found worldwide. In 1987, there had been four or five International Authorities. There were now 12 and a 13th was approaching. That represented a complete difference compared with the original situation. This was one of the reasons why the Representative considered it reasonable to follow the service-oriented spirit of the PCT. The PCT was offering a service, and the international search was a service to applicants. It was, of course, also a service to society in general, but mainly for users. The Representative noted that there were various articles in the media and the internet and so on, criticizing the reliability of the patent system worldwide, for example those coming from the Open Source community. He considered that it was essential to improve the services offered by International Searching Authorities. As had been pointed out by the Representative of the EPO, no search examiner was perfect, and no search could be comprehensive. There had been cases where patents granted by the EPO had been invalidated in proceedings before the German courts because new prior art had been found. In view of that situation, the Representative wholeheartedly supported the proposal put forward by the International Bureau and hoped that, in spite of the adamant position taken by the Delegation of Japan, a compromise could be found.

58. The Representative of UNION stated that, in principle, knowledge of the prior art was never a disadvantage, either for applicants or for the public. This was also true in practice, and the organization fully supported the proposal to improve the work of the International Searching Authorities and the results of that work. The organization furthermore believed that additional, voluntary supplementary searches offered by the PCT system would be of great advantage to applicants, and consequently the Representative supported the proposal.

59. The Representative of FICPI stated that FICPI had consistently supported the proposal for supplementary searches. Having as much knowledge as possible before starting the national phase was of fundamental importance to users. The Representative could not see why some delegations would oppose a system which was purely optional, a system in which they would not have to take part at all if they did not want to. FICPI was very interested in the availability of supplementary searches and believed that they would also be useful to national Offices because they would bring forward the work which would otherwise be done in the national phase, for instance in Japan. The Representative could see no reason for opposition and strongly supported the introduction of supplementary searches.

60. The Representative of APAA stated that his organization was interested in the supplementary search system, but was concerned that even the existing International Searching Authorities had a split view on the matter. The Representative considered that, as long as the Authorities lacked consensus on the matter, good search results could not be expected. The Representative considered that it was necessary to obtain consensus among International Authorities before taking the matter up in broader PCT bodies.

61. The Delegation of Australia noted that it had not initially been in favor of this proposal. A number of years ago, it had raised a number of concerns on matters of principle which were reflected to some extent in the comments made by the Delegation of Japan and others in this session of the Working Group. However, the Delegation noted the comment made by the Representative of the EPO. Realistically, searches were not perfect, and supplementary

searches or rework were in practice occurring in the national phase. The negative aspects of this were borne by users, and the Delegation believed that this was why so many user groups had expressed their support for the proposal. The Delegation did not oppose the proposal and would support the compromise position reflected in document PCT/R/WG/9/2.

62. The Delegation considered that it was necessary to consider where to go from this point. The proposal could be a step forward for the international system. It would encourage better quality searches. There would be an opportunity for Authorities to increase their level of cooperation in terms of understanding why there may be differences in search outcomes and working as a group with an objective of producing a good quality single search in the international phase, utilizing and building on the expertise of the various Authorities. The Delegation looked forward to working on such matters in the Meeting of International Authorities under the PCT.

63. The Delegation of the United States of America pointed out that most applicants were restricted in their options with regard to the primary International Searching Authority and, in the absence of the possible system which was under discussion, had no option for obtaining expert searches in other languages if they were restricted to that Authority. The Delegation stated that quality was extremely important and felt that a supplementary search would inherently raise the quality level of a particular main search. This had been borne out by preliminary results which had been seen in the pilot Patent Prosecution Highway program conducted by the Trilateral Offices, where searches from another Office had been found very valuable. There were already International Searching Authorities with quality assurance systems and multiple language skills, and the Delegation felt that use should be made of those features. It appeared to the Delegation that users and Contracting States, by a large majority, were in favor of a supplementary search system and felt that it was not necessary to perform a detailed study merely to reconfirm what had already been heard in the meeting. Finally, since the system was totally optional for both applicants and Offices, the Delegation could not see how anyone could reasonably object to it.

64. The Delegation of Sweden fully supported the proposal for supplementary international searches as set out in document PCT/R/WG/9/2 and agreed with the Representative of the EPO that it was best to test the system by implementing it and letting applicants decide how useful it was.

65. The Delegation of the Netherlands strongly supported the idea behind the supplementary international search proposal. Although the Delegation strongly preferred a system relying on sequential searches, it considered the compromise proposal of the International Bureau to be acceptable.

66. The Delegation of Austria recalled that it had supported this proposal from the outset, and it still supported it.

67. The Delegation of Denmark supported the proposal and especially the very practical views stated by the Representative of the EPO.

68. The Delegation of Norway supported the proposal.

69. The Delegation of Japan stated that it had carefully listened to the comments which had been made by the various delegations and representatives. The Delegation believed that most of the questions and comments were already answered in its paper (see Annex II), but wished

to briefly respond to them. Referring to item II-1 of its paper (lack of fact-based analysis), the Delegation believed that, if user needs for supplementary international searches did indeed exist, they might be limited to the needs of specific industries in specific countries with respect to specific documentation in specific languages in a specific technical field, etc. If that were the case, the Delegation felt that such needs might be more appropriately met by other means, such as bilateral arrangements, in which case there seemed to be no reason to justify the institutionalization of supplementary international searches in the multilateral framework of the PCT. In addition, the Delegation questioned whether the proposed supplementary international search system could equally benefit all types of users, including universities, small and medium-sized enterprises, individuals and other applicants who did not have sufficient funds. It was not a fair system with equal treatment for all applicants.

70. Regarding the prior art search and quality, the Delegation referred to item I-4 (discrimination in terms of national language). For prior art search purposes, on the other hand, each International Searching Authority was required to carry out a search of the PCT minimum documentation irrespective of the language of the documents. This was because the novelty and inventive step criteria needed to be considered in relation to prior art documents which had been published anywhere in the world, regardless of the place of publication, and because the value of relevant prior art documents relied solely on the technical content of such documents, not on the language in which they were written. Consequently, the Delegation believed that the International Searching Authority should carry out an international search for all prior art documents, irrespective of the language used in those documents, to the extent considered appropriate for providing the information necessary to assessing novelty and inventive step in the light of the objectives of the international search. The Delegation noted that, for example, the Japan Patent Office as an International Searching Authority carried out searches of non-Japanese prior art documents where necessary. In the same manner, another Authority whose procedural language was not Japanese should search Japanese language prior art documents if that was deemed necessary for establishing an adequate international search report. The Delegation considered that the other questions raised were also covered in its paper and urged careful consideration of it.

71. The Delegation of Singapore saw the benefits of the proposal for supplementary international searches as set out in document PCT/R/WG/9/2 and could support the proposal. In addition, the Delegation wished to remind the Working Group that there was also a need to ensure that the quality of the main international search report, which was the primary document, should be improved if it did not currently offer sufficient quality, and suggested that the Meeting of International Authorities under the PCT review this quality issue.

72. The Delegation of Serbia referred to the statement of the Representative of AIPPI and in particular the point that, for those who do not speak Russian, Korean, Japanese or Chinese, there was a problem in obtaining prior art citations. The Delegation queried the cost of obtaining supplementary search reports from all of those Offices, which would be necessary in order for English- or French-speaking applicants to obtain a full knowledge of the prior art. It was necessary to bear in mind just how many supplementary searches would really be needed to obtain a full and comprehensive knowledge of the prior art. Since it was hardly realistic to expect that such searches would be performed free of charge, the Delegation queried who would be able to afford them. It asked whether the system would only confer an advantage on very rich companies who were able to obtain this information even now through national and commercial searches.

73. The Representative of UNION stated that it fully supported the proposal of the Delegation of Japan to improve the quality of the main international search. However, the proposal under discussion offered additional possibilities for even further improvements of the quality of searches. In addition, the financial situation had been mentioned. The Representative noted that the Delegation of Japan had referred to the proposal as unfair. On the contrary, the Representative considered that what would be unfair for small and medium-sized enterprises and universities, which were frequently represented by UNION members, would be to receive an international search report which looked good on its face, only to file national phase applications in 10 or 15 countries worldwide and then to receive rejections in those countries because the international search report had not been as good as it could or should have been.

74. The Representative of ARIPO supported the proposal in document PCT/R/WG/9/2.

75. The Delegation of Sudan supported the proposal by the Delegation of Japan for an analysis to be made.

76. While noting the general opposition of certain delegations to the proposal as a whole, the Working Group proceeded to a detailed review of the text of the proposals. The Delegation of Japan stated that it did not support any hasty drafting of the text of the proposals which presupposed the supplementary international search. It also stated that, even if any discussion was held in the meeting for drafting the text, it should not prejudge Japan's stance on the proposal. Other delegations were satisfied with the text subject to the comments and clarifications set out in the following paragraphs. The Secretariat would take them into account in the event that a revised text was to be prepared.

Unity of Invention

77. It was agreed that a slightly different approach should be taken to the issue of unity of invention, resulting in further changes to Rules 45*bis*.1(d), 45*bis*.5(b) and Rule 45*bis*.6 as follows.

(a) At the time of making the request for supplementary search, where the International Searching Authority had found a lack of unity, it should be possible for the applicant to specify which of the multiple inventions identified by the International Searching Authority (other than the one first mentioned in the claims) the applicant wished to be searched by the Authority specified for supplementary search.

(b) Noting that there would be no opportunity to pay additional fees for the search of additional inventions where the Authority specified for supplementary search found a lack of unity, the Authority would establish the supplementary search report on the invention first mentioned in the claims and send it to the applicant, together with its own finding of lack of unity and reasons for its opinion. This would avoid the need to establish and send a report at a later stage, unless the applicant requested a review of the Authority's opinion and it was found that the opinion was at least partially unjustified.

(c) Where the Authority specified for supplementary search limited the scope of the supplementary international search to an invention specified by the applicant as described in paragraph (a), above, the Authority would still be able to make a further finding of lack of unity based on the claims on which it was performing the search, in which case it would perform the search on the invention first mentioned in the relevant claims.

78. It was observed that, theoretically, undesirable effects were possible if several supplementary searches were begun and completed independently before the establishment of a very late international search report and if the different Authorities took different views on the question of unity of invention. However, it was observed that this should only happen in the most extreme of cases, and there did not seem to be a simple way of avoiding it. It was suggested that, in the event that such occurrences were found to occur in reality, the issue could be taken up by the Meeting of International Authorities under the PCT.

Rule 45bis.1

79. It was observed that, while Rules 45bis.1(a) and (b), when read together, implied that separate requests should be made in respect of supplementary international searches to be carried out by different Authorities, this would not preclude multiple requests from being made using the same Form.

80. It was noted that, in the French text of document PCT/R/WG/9/2 only, the words “*Cette demande*” in the last sentence of Rule 45bis.1(a) should be replaced with the words “*De telles demandes*” so as to align the French text with the English text of that document.

81. It was agreed that the words “and is a language of publication” should be deleted at the end of Rule 45bis.1(c)(i), noting that, unlike in the case of translations under Rules 12.3 and 12.4, there was no need to furnish a translation of the international application into a language of publication and that, for the purposes of supplementary international search, a translation into a language accepted by the Authority specified for supplementary search was sufficient.

82. It was noted that the furnishing, for the purposes of the supplementary international search, of a sequence listing in electronic form should not be a mandatory requirement for a request for supplementary international search to be considered valid. Where such a sequence listing in electronic form was not furnished together with the request for supplementary international search, the Authority specified for supplementary search could invite the applicant to furnish such listing to it under Rule 13ter.1, which applied *mutatis mutandis* by virtue of Rule 45bis.5(c). In this context, it was also noted that the late furnishing fee under Rule 13ter.1(c) would provide a sufficient incentive for applicants to furnish such listings together with the request for supplementary international search. Consequently, Rule 45bis.1(c)(ii) should be redrafted to read as follows (with consequential amendments to Rules 45bis.4(a) and (e), noted below):

“(ii) preferably, a copy of a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions, if required by the Authority specified for supplementary search.”

83. Noting the procedure agreed upon for specifying which invention should be searched in the case of a finding of lack of unity by the International Searching Authority (see paragraph 77(a), above), Rule 45bis.1(d) should be redrafted to read as follows:

“(d) Where the International Searching Authority has found that the international application does not comply with the requirement of unity of invention, the supplementary search request may contain an indication of the wish of the applicant to

limit the supplementary international search to one of the inventions as identified by the International Searching Authority, other than the main invention referred to in Article 17(3)(a).”

84. In Rule 45bis.1(e)(ii), the words “International Searching Authority requested to carry out the supplementary international search” should be replaced by the words “Authority specified for supplementary search”, noting the definition under Rule 45bis.1(b)(ii).

Rule 45bis.2

85. In Rule 45bis.2(d), the reference to Rule 45bis.4(d) should be to Rule 45bis.4(e).

Rule 45bis.3

86. In Rule 45bis.3(d), the reference to Rule 45bis.4(d) should be to Rule 45bis.4(e).

87. In Rule 45bis.3(e), the words “after the documents referred to in Rule 45bis.4(d)(i) to (iv) have been transmitted to that Authority” should be replaced by “before it has started the supplementary international search in accordance with Rule 45bis.5(a)”, in order to allow a proper opportunity for refunds to be given, in appropriate cases, up to the point where the search is commenced.

Rule 45bis.4 and 45bis.5

88. In response to a proposal by one delegation for a change to Rule 45bis.4(e) and also Rule 45bis.5(a) and (b) so as always to require that the main international search report be available before the supplementary international search could commence, it was observed that those Rules were key to the compromise found and the balance which was sought between:

(i) the desire to maintain, so far as reasonably possible, a sequential search system, under which supplementary searches were conducted taking into account the results of the main search which had been carried out earlier; and

(ii) ensuring that, in cases where the main international search was established late, the Authority specified for supplementary search was still able to deliver a supplementary search report in time to be useful to the applicant.

89. In this context, it was agreed that everything possible should be done to ensure that the main search was conducted on time, so that the possibility of a concurrent search would occur only in exceptional cases.

90. It was also observed, noting that at present too many (main) international search reports were late, that International Searching Authorities could, in several ways, limit the risk of being obliged to perform a longer, fuller and costlier search than would otherwise be required. For example: their agreements with the International Bureau could carefully specify (under Rule 45bis.5(e)) the scope of service which they would provide; their fees could be adjusted over time to reflect actual costs; and they could consider charging higher fees while providing for refunds to be given if the main search was already available. It was also noted that the project which was under way to make available the search strategies used by the International Searching Authority might assist in reducing unnecessary database search fees.

91. Consequential on the change to Rule 45bis.1(c)(ii) (see paragraph 82, above), the references in Rules 45bis.4(a) and (e) to Rule 45bis.1(c) should be limited to Rule 45bis.1(c)(i). In addition, the reference in Rule 45bis.4(e)(iii) to Rule 45bis.1(d)(ii) should be to Rule 45bis.1(c)(ii).
92. The French version of Rule 45bis.4(c), which *permits* a late payment fee (“*peut être soumis*”), should be aligned with the English version, which *requires* (“shall be subject to”) a late payment fee.
93. It was observed that the wording of Rule 45bis.4(c), providing for the payment of a late payment fee, was different from the wording of existing Rule 16bis.2, but it was agreed that there was no need to align the wording of the two Rules, noting the complexity that this would add to Rule 45bis.4(c).
94. In response to a suggestion that Rule 45bis.4(d) should make special provision for the case where a single payment was made in respect of multiple requests for supplementary search but the amount was insufficient to cover in full the fees due for all of the requests, it was agreed that the matter should be dealt with in the Administrative Instructions.
95. Rule 45bis.4(e)(vii) should be redrafted as follows:
- “(vii) any protest by the applicant under Rule 40.2(c) and the decision thereon by the review body constituted in the framework of the International Searching Authority.”
96. It was observed that this redraft of Rule 45bis.4(e)(vii) would require a modification of the Administrative Instructions to require International Searching Authorities to send copies of protests and decisions thereon to the International Bureau so that they could be forwarded, where required, to Authorities specified for supplementary search.

Rule 45bis.5

97. In Rule 45bis.5(b), the words “taking due account of” rather than “giving full consideration to” should be used, noting that those words would be more consistent with the terminology used elsewhere in the Regulations. Furthermore, in order to give effect to the limitation of the scope of the supplementary search in the case of a finding by the International Searching Authority of lack of unity of invention, as described in paragraph 77(a), above, the following additional sentence should be added at the end of Rule 45bis.5(b):
- “Where the supplementary search request contains an indication under Rule 45bis.1(d), the supplementary international search may be limited to the invention specified by the applicant under Rule 45bis.1(d) and those parts of the international application which relate to that invention.”
98. In response to a query as to whether it was necessary or appropriate for an Authority specified for supplementary search to take account of the written opinion of the International Searching Authority as well as of the international search report, one Delegation noted that such written opinions could provide valuable insights into the reasons for which the International Searching Authority considered a document to be relevant.

99. It was agreed that, in order to assist Authorities specified for supplementary search to understand written opinions by the (main) International Searching Authority, the Regulations should be further amended to include a provision, along the lines of existing Rule 62*bis*.1(a), so as to permit an Authority specified for supplementary search to request the International Bureau to provide a translation into English of a written opinion of the International Searching Authority if it was established in a language not accepted by the Authority specified for supplementary search.

100. The word “report” should be deleted from the end of Rule 45*bis*.5(d), noting that an international search report would usually at least mention claims which had not been the subject of the international search.

101. In order to give the Authority specified for supplementary search the flexibility to decide not to establish a supplementary international search report where the International Searching Authority made a declaration under Article 17(2)(a) and no main international search report had been established (even though the Authority specified for supplementary search might otherwise have searched the relevant claims), a new paragraph (e) should be added as follows (and existing paragraphs (e) and (f) renumbered accordingly):

“(e) Where the International Searching Authority has made the declaration referred to in Article 17(2)(a) and that declaration is available to the Authority specified for supplementary search before it starts the search under paragraph (a), that Authority may decide not to establish a supplementary international search report, in which case it shall so declare and promptly notify the applicant and the International Bureau accordingly.”

Rule 45bis.6

102. Noting the procedures agreed upon for establishing supplementary international search reports as set out in paragraphs 77(a) and (c), above, Rule 45*bis*.6 should be redrafted to read as follows:

“(a) If the Authority specified for supplementary search finds that the international application does not comply with the requirement of unity of invention, it shall:

“(i) establish the supplementary international search report on those parts of the international application which relate to the invention first mentioned in the claims (“main invention”);

“(ii) notify the applicant of its opinion that the international application does not comply with the requirement of unity of invention and specify the reasons for that opinion; and

“(iii) inform the applicant of the possibility of requesting, within the time limit referred to in paragraph (c), a review of the opinion.

“(b) In considering whether the international application complies with the requirement of unity of invention, the Authority shall take due account of any documents received by it under Rule 45*bis*.4(e)(vi) and (vii) before it starts the supplementary international search.

“(c) The applicant may, within one month from the date of the notification under paragraph (a), request the Authority to review the opinion referred to in paragraph (a). The request for review may be subjected by the Authority to the payment to it, for its own benefit, of a review fee whose amount shall be fixed by it.

“(d) If the applicant, within the time limit under paragraph (c), requests a review of the opinion by the Authority and pays any required review fee, the opinion shall be reviewed by the Authority. The review shall not be carried out only by the person who made the decision which is the subject of the review. Where the Authority:

“(i) finds that the opinion was entirely justified, it shall notify the applicant accordingly;

“(ii) finds that the opinion was partially unjustified but still considers that the international application does not comply with the requirement of unity of invention, it shall notify the applicant accordingly and, where necessary, proceed as provided for in paragraph (a)(i);

“(iii) finds that the opinion was entirely unjustified, it shall notify the applicant accordingly, establish the supplementary international search report on all parts of the international application and refund the review fee to the applicant.

“(e) On the request of the applicant, the text of both the request for review and the decision thereon shall be communicated to the designated Offices together with the supplementary international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under Article 22.

“(f) Paragraphs (a) to (e) shall apply *mutatis mutandis* where the Authority specified for supplementary search decides to limit the supplementary international search in accordance with the second sentence of Rule 45bis.5(b), provided that any reference in the said paragraphs to the “international application” shall be construed as a reference to those parts of the international application which relate to the invention specified by the applicant under Rule 45bis.1(d).”

103. It was explained that Rule 45bis.6(f) related to the case set out in paragraph 77(c), above, where the applicant had requested the Authority specified for supplementary search to limit the search to one of the multiple inventions identified by the International Searching Authority (other than the one first mentioned in the claims). In that case, the Authority specified for supplementary search should still assess whether that part of the international application to which the supplementary search was limited does in fact relate to a single invention and, if not, limit the supplementary search to the invention first mentioned within the relevant claims. Subsequently, the same procedure as in the usual case would apply with respect to establishing the report and permitting a review of the opinion by the Authority.

Rule 45bis.7

104. Consequential to the addition under Rule 45bis.5(e) of a second type of declaration of non-establishment of supplementary international search report (see paragraph 101, above), Rule 45bis.7(a) should be redrafted to read as follows:

“(a) The Authority specified for supplementary search shall, within 28 months from the priority date, establish the supplementary international search report, or make the declaration referred to in Article 17(2) as applicable by virtue of Rule 45bis.5(c) or the declaration under Rule 45bis.5(e) that no supplementary international search report will be established.”

105. Consequential on the removal of the restriction that translations for the purpose of supplementary international search should be provided in a language of publication, a new Rule 45bis.7(b) should be added to provide that supplementary international search reports and declarations of non-establishment of such reports should be established in a language of publication, as follows (with existing paragraphs (b) to (d) renumbered accordingly):

“(b) Every supplementary international search report, any declaration under Article 17(2)(a) as applicable by virtue of Rule 45bis.5(c) and any declaration under Rule 45bis.5(e) shall be in a language of publication.”

106. Consequential on the addition of new Rule 45bis.7(b), noted above, and to correct references and improve drafting, Rule 45bis.7(c) (as renumbered) should be redrafted to read as follows:

“(c) For the purposes of establishing the supplementary international search report, Rules 43.1, 43.2, 43.5, 43.6, 43.6bis, 43.8 and 43.10 shall, subject to paragraphs (d) and (e), apply *mutatis mutandis*. Rule 43.9 shall apply *mutatis mutandis*, except that the references therein to Rules 43.3, 43.7 and 44.2 shall be considered non-existent. Article 20(3) and Rule 44.3 shall apply *mutatis mutandis*.

107. Noting that a supplementary international search report would not be accompanied by a written opinion, it was felt that the report should be permitted to contain explanations with regard to the scope of the supplementary international search, for example, in a case where a full search was not possible due to the complexity of claims, or where assumptions needed to be made in deciding on the appropriate scope of search because the main international search report had not yet been established. Consequently, Rule 45bis.7(d) should be redrafted to read as follows:

“(d) The supplementary international search report may contain explanations:

“(i) with regard to the citations of the documents considered to be relevant;

“(ii) with regard to the scope of the supplementary international search.”

Rule 45bis.9

108. It was agreed that, in Rule 45bis.9(c), the words “in particular” should be replaced by “for example”.

Schedule of Fees

109. In order to better group Chapter I and Chapter II fees, the supplementary search handling fee should be inserted as item 2, rather than as item 3, and present item 2 should be renumbered as item 3.

110. Item 5 should be amended to make clear that the 75% fee reduction should apply to the supplementary search handling fee as well as to the handling fee (under Chapter II).

Scope of Search

111. It was suggested that, in the event that Regulations relating to supplementary international search were to be adopted by the Assembly, an understanding should also be adopted to the effect that the introduction of supplementary international searches would in no way reduce the obligation of International Searching Authorities to search the entire minimum documentation in all languages as required by the Regulations. Otherwise, the system would risk becoming a mere shifting of burden instead of representing a real increase in quality. It was observed that machine translation systems, particularly for Japanese and Korean language documents, were giving increased access to the full text of patent literature for those without a knowledge of those languages.

Conclusions

112. The Chair noted that agreement had been reached on the text of what would be appropriate amendments of the Regulations for the introduction of a supplementary international search system, subject to the comments and clarifications appearing in paragraphs 77 to 111, above, and to possible further drafting changes to be made by the Secretariat. The Chair concluded that the Working Group would send a factual report to the Assembly and that this factual report would contain a copy of the text of the proposed amendments to the Regulations as approved by the meeting.

113. The Delegations of Japan and Spain stated strongly that they could not join a consensus to send the proposal a supplementary international search system which had been discussed to the Assembly for adoption. The Delegation of Serbia wished it to be recorded that it abstained on the matter.

114. The Delegation of the United States of America and the Representative of the EPO proposed that the Assembly be invited to consider whether it wished to take action on the proposal in view of the large majority in the Working Group expressing support. The Delegation of Japan opposed this proposal.

115. On the issue of supplementary international search, the Working Group agreed to invite the Assembly at its next session, in September–October 2007, to take note of the contents of this report.

116. It was observed that this would mean that the Assembly would not take any action on the proposal unless there was a specific proposal from a Contracting State to do so.

INTERNATIONAL SEARCH: USE OF RESULTS OF EARLIER SEARCH BY OFFICE OTHER THAN OFFICE ACTING AS INTERNATIONAL SEARCHING AUTHORITY

117. Discussions were based on document PCT/R/WG/9/3.

118. The Delegation of Germany stated that, while it would in principle support the proposals to amend the Regulations to allow for national searches to be taken into account by the International Searching Authority in establishing the international search report, it felt that it was premature to submit those proposals to the Assembly for consideration at its next

session in September-October 2007. Noting the ongoing pilot project run by the European Patent Office, in the context of the establishment of the European Patent Network, on the utilization of earlier searches carried out by Member States of the European Patent Organization, the Delegation expressed the view that the results of that project, once completed, should first be analyzed before institutionalizing the use of earlier national search results in the PCT system. In this context, the Delegation also noted the lack of harmonization of substantive patent laws and reiterated its general opposition to any proposals which might result in the factual recognition of the results of searches carried out by an Office other than the International Searching Authority.

119. The Representative of the EPO stated that it would not be possible to implement the new practice in the European Patent Office before the result of the Utilization Pilot Project and the corresponding teaching had been analyzed.

120. While several delegations expressed their sympathy for the concerns expressed by the Delegation of Germany, stressing, in particular, the importance of the experience to be gained from the European Patent Office's utilization pilot project, all other delegations and representatives of users that took the floor on this matter expressed their support for the proposals and submission to the Assembly for consideration at its next session, noting, in particular, the optional nature of the proposals for both applicants and International Searching Authorities.

121. The Working Group approved the proposed amendments of the Regulations set out in the Annex to document PCT/R/WG/9/3 with a view to their submission to the Assembly for consideration at its next session, in September-October 2007, subject to the comments and clarifications appearing in the following paragraphs and to possible further drafting changes to be made by the Secretariat.

122. It was noted that the proposal would not, in effect, change the present practice in relation to taking into account searches which an International Searching Authority had itself carried out in some capacity, and that the new practice whereby an Authority could take into account the results of a search conducted by another Office was optional. Authorities were therefore free to decide whether and when to adopt the new practice, and there seemed to be no special need to allow a lengthy period before entry into force of the amendments of the Regulations.

Rule 4.1(b)(ii)

123. It was agreed that the reference in Rule 4.1(b)(ii) to "Rule 12bis.1" should be to "Rule 12bis.1(b) and (d)".

124. It was noted that the reference to "other search" was intended to include any national or regional search as referred to in Rule 4.12. The fact that some Offices chose to outsource searches did not affect the position, since each Office is responsible for its searches, whether they were performed in-house or outsourced. The Secretariat would consider whether some clarification in the wording of the Rule would be desirable.

Rule 4.12

125. It was agreed that Rule 4.12 should be reworded as follows:

“If the applicant wishes the International Searching Authority to take into account, in carrying out the international search, the results of an earlier search carried out by the same or another International Searching Authority or by a national Office, the request shall so indicate and shall specify the Authority or Office concerned and the application in respect of which the earlier search was carried out.”

126. The title of Rule 4.12 should be redrafted accordingly.

127. One delegation asked whether the reference to an earlier search in Rule 4.12 would include searches that had been outsourced by national Offices, or foreign searches that applicants relied on and were permitted to do so by national Offices. The Secretariat explained that the reference in Rule 4.12 would include such searches.

Rule 12bis.1

128. It was agreed that Rule 12bis.1(a)(i) should be redrafted to clarify that the furnishing of copies of documents cited in a search report were not routinely required to be submitted. It was noted, however, that an International Searching Authority was free, in a particular case, to invite the applicant to furnish a copy of a cited relevant document where that document was not available to it. Moreover, it was agreed that the provision should be redrafted to ensure that it provided for the furnishing of the results of the earlier search in whatever form they were presented by the Office which conducted it, for example, in the form of a search report, a listing of cited prior art, an examination report or in some other form. The introductory text of Rule 12bis.1(a) might also require redrafting, consequential on those changes.

129. It was agreed that Rule 12bis.1(a)(ii) and (iii) should be redrafted so as to leave it to the discretion of the International Searching Authority (as a “may” provision) to decide whether it wished to invite the applicant to furnish to it a copy of the earlier application concerned and a translation of the results of the earlier search. Furthermore, it was agreed that provision should be made for the Authority to invite the applicant to furnish a translation of the earlier application, or of the claims in that application, where the Authority felt that such a translation was needed. It was further agreed that the detailed conditions for “taking into account” of the results of an earlier search by the International Searching Authorities should be discussed by the Meeting of International Authorities under the PCT.

130. In this context, it was also agreed that the Regulations should be amended to permit the inclusion in the request of a checkbox enabling the applicant to indicate that the earlier application was substantially the same as the subsequently filed international application, thereby possibly avoiding the need for the International Searching Authority to require the furnishing of a copy of the earlier application. The checkbox should also accommodate the case where the international application was a translation of the earlier application and thus the same in substance, albeit in another language.

131. It was agreed that the Secretariat should review the drafting of Rule 12bis.1(b), consequential on the changes made Rule 12bis.1(a)(ii) and (iii), to see whether the reference in the former to “paragraph (a)(i) and (ii)” was still appropriate. The Secretariat should also study the possible need for further amendments of paragraphs (b) and (c), for example, to ensure that no copy of the earlier application should be required where the earlier application concerned was already available to the International Searching Authority in the form of the priority document, noting in particular the applicant’s obligations in this connection under Rule 17.

Rule 16

132. There was no support for the proposal by one delegation, except by one other delegation, to further amend Rule 16.3 to specifically permit International Searching Authorities to specify those Offices whose earlier national searches it would generally take into account in establishing the international search report, and for the International Bureau to publish that list of Offices as specified by the Authority.

133. The Representative of the EPO stated that, in the EPO's view, Rule 16.3 should be reworded so that it would read "that Authority *may* refund the search fee paid ..." instead of "that Authority *shall* refund the search fee paid...". The current wording with "shall" would give the impression that, as soon as the applicant provided earlier search results and the Authority made some use of them, for example, for assessing their usefulness, the applicant would be automatically entitled to get a refund, irrespective of the actual usefulness of those earlier search results.

Rules 4.12, 12bis.1, 16.3 and 41.1

134. After some discussion, it was agreed that, throughout the proposed amendments of the Regulations, the term "take into account" (the results of an earlier search) should be retained and not replaced by another term such as "use", "consider", or "base ... on". The term "take into account" was to be understood as meaning that the International Searching Authority found the results of the earlier search useful and beneficial for the purposes of establishing the international search report, as distinct from merely reading, studying or considering the results of the earlier search.

PUBLICATION OF INTERNATIONAL APPLICATIONS IN MULTIPLE LANGUAGES

135. Discussions were based on document PCT/R/WG/9/4.

136. The Chair noted that the divergences in opinion which had resulted in the proposed amendments on this subject not being submitted to the Assembly for consideration in September-October 2006, appeared to remain (see document PCT/R/WG/8/3, paragraphs 19 to 34 of document PCT/R/WG/8/9, and paragraph 5 of document PCT/R/WG/9/4).

137. The Delegation of China stated that it would like to take the opportunity to clarify its standpoints on the issue of the publication of international applications in multiple languages.

138. First, the Delegation understood fully the desire of some member States for the proposal concerning the publication of international applications in multiple languages, and the Delegation did not oppose the proposal.

139. Second, the Delegation stated that, in addition to the publication itself, the proposal of the International Bureau had also set forth the effects of publication in multiple languages, including the establishment of provisional protection under national law, and the acceptance of a published translation for the purposes of national phase processing. However, those effects were not in tune with the requirements of the current provisions of Chinese law. As a result, China was not fully prepared to implement the recommended amendments. For this reason, the Delegation needed a reservation clause provided in the proposed text. The Delegation believed that this requirement was quite normal and reasonable.

140. Third, the Delegation further stated that a proposal had been improvised at the previous session of the Working Group to link the formal bringing into effect of the recommended amendments with the universal withdrawal of member States' reservations. That meant that an across-the-board acceptance, without any reservation among member States, would become a precondition for the implementation of the publication of international applications in multiple languages. Such an approach had scant legal basis in the Treaty and the Regulations. The Delegation could not recall a similar approach having been taken in previous sessions. China was not in a position to give a clear commitment as to when an amendment to its domestic law would be concluded.

141. The Delegation noted that, for the above-mentioned reasons, the Commissioner of China's State Intellectual Property Office had sent a letter to the International Bureau within the time limit prescribed by the report of the previous session of the Working Group (see paragraph 29(b) of document PCT/R/WG/8/9, reproduced in paragraph 2 of document PCT/R/WG/9/4). That letter had clarified the standpoints of China, and emphasized that China had always been respectful of the positions of other member States and had never tried to impose its positions on others in the whole course of the PCT reform process. It was the hope of the Commissioner that other member States could understand the position of China.

142. Finally, the Delegation expressed the wish that the present statement be included in the report of the session.

143. The Working Group agreed to invite the Assembly at its next session, in September-October 2007, to note, with respect to the proposals concerning publication of international applications in multiple languages:

(i) that the Working Group had agreed at its eighth session on the text of an appropriate set of proposed amendments to the Regulations;

(ii) that at the ninth session of the Working Group there continued to remain a divergence of opinion among its members as to how to proceed with that text.

PROPOSED AMENDMENT OF RULES 29.1, 48.2(c) AND 90*bis*.1

144. Discussions were based on document PCT/R/WG/9/6.

Rule 29.1

145. One delegation suggested that the words "technical preparations for international publication" in Rule 29.1(v) should be replaced, in the interests of transparency and clarity, with a concrete time limit expressed as a specified number of days (for example, 15 days) before the date of international publication. The Secretariat explained that the same wording as that proposed in Rule 29.1(v) was used in a number of other provisions throughout the Regulations, and suggested that it might be preferable to maintain it here in order to retain flexibility. For example, now that electronic processing and publication of international applications were a reality, the present time limit of 15 days might, in the not too distant future, be able to be further shortened, to the benefit of applicants.

146. In response to a query by one delegation as to the relationship between, on the one hand, Rules 12.3 and 12.4 and, on the other, Rule 29.1, the Secretariat explained that, where the applicant failed to furnish any translation required under Rule 12.3 or 12.4 within the applicable time limit, the receiving Office would eventually, under Rule 29.1, declare the international application to be considered withdrawn.

147. The Working Group approved the proposed amendments of Rule 29.1 set out in the Annex to document PCT/R/WG/9/6 with a view to their submission to the Assembly for consideration at its next session, in September-October 2007, subject to possible further drafting changes to be made by the Secretariat.

Rule 48.2(c)

148. Noting that existing Rule 48.2(c) appeared to give the International Bureau sufficient flexibility with regard to the possible inclusion of the abstract and a figure on the front page of published international applications in respect of which, following a declaration by the International Searching Authority under Article 17(2)(a), no international search report had been established, the Secretariat withdrew its proposal for amendment of Rule 48.2(c).

Rule 90bis.1

149. Several delegations opposed the proposed amendment of Rule 90bis.1, noting in particular the wish of applicants to be able to withdraw the international application before the same Office with which it was filed (the receiving Office) rather than exclusively before the International Bureau. Moreover, concerns were raised as to whether the International Bureau's records would always be sufficiently up-to-date to enable it to carry out the necessary checks, for example, as to compliance with signature requirements, although it was observed that this would already be an issue under the existing text of the Rule. Generally, it was felt that the problem at hand was more a problem of how to increase the awareness of applicants and how to improve communication and cooperation between receiving Offices and the International Bureau rather than a legal problem which should be addressed by amending the Regulations.

150. Several other delegations supported the proposals, noting the considerable risk that applicants take in submitting withdrawals (particularly at the last minute) to the receiving Office, noting that such withdrawals, although legally effective, could not have the desired practical effect of preventing international publication of the (withdrawn) application unless the notice of withdrawal was transmitted by the receiving Office to the International Bureau prior to completion of technical preparations for international publication.

151. Several delegations suggested possible alternatives to the proposed amendment of Rule 90bis.1, including a proposal that withdrawals be required to be submitted both to the International Bureau and (as a copy) to the receiving Office, or to provide that a withdrawal would only be effective once received by the International Bureau but that it could still be addressed, at the option of the applicant, to either the receiving Office (which would subsequently transmit it to the International Bureau) or directly to the International Bureau.

152. After some discussion, and noting the concerns expressed by several representatives of users as to the practicability of some of the suggested alternatives, the Working Group agreed that Rule 90bis.1 should not be amended at this stage.

PROPOSED AMENDMENT OF RULE 26*bis*.3(d)

153. Discussions were based on document PCT/R/WG/9/7.

154. A number of delegations expressed sympathy for the problem that the strict time limit for the payment of fees under current Rule 26*bis*.3(d) might provide for some applicants. However, there was concern that an open-ended discretion to extend the time limit for payment of the relevant fee might result in decisions on a request for restoration of the right of priority being made at a very late stage.

155. It was noted that the decision by the receiving Office on a request for restoration of the right of priority did not affect the processing of an international application in the international phase, in particular with regard to the calculation of time limits for national phase entry, of the relevant dates for the purposes of prior art in the international search and preliminary examination, or of the date of international publication. However, it was noted that designated and elected Offices and third parties had an interest in decisions as to restoration of the priority right being known as soon as possible, preferably as part of the international publication of the application concerned. Noting these concerns, after some discussion, it was agreed that any extension of the time limit under Rule 26*bis*.3(d) granted by the receiving Office should not go beyond an additional time limit of two months from the expiration of the time limit under Rule 26*bis*.3(e), which would normally be 14 months from the priority date.

156. The Working Group approved the proposed amendment of Rule 26*bis*.3(d) set out in the Annex to document PCT/R/WG/9/6, subject to a limitation of the extension to a maximum of two months from the expiration of the time limit under Rule 26*bis*.3(e), and invited the Secretariat to draft an appropriate revised text for submission to the Assembly for consideration at its next session, in September-October 2007.

157. In response to a question from a delegation, the Secretariat stated that it considered that Rule 26*bis*.3(d) provided sufficient flexibility to a receiving Office to allow it to subject any extension of the time limit under that Rule to the payment of a late payment fee and that it felt that it would not be desirable to include complex provisions to this effect in the Regulations, unless a definite need was identified. Further, the delegation noted that this amendment, if approved, would mean that different receiving Offices could adopt different practices on whether extension of the time limit would be provided as well as different practices on whether late payment fees would be imposed. Hence, for the benefit of users, the delegation suggested that it would be a good idea for the International Bureau to collect and publish information in this regard.

158. The Secretariat observed that, in response to a request from the International Bureau (see Circular C. PCT 1093), many receiving Offices had provided details of their requirements and procedures in relation to requests for restoration of the right of priority. Any additional information on the subject would be welcome so that the International Bureau could publish information that is as complete and accurate as possible.

OTHER MATTERS

159. The Secretariat informed the Working Group that, in response to the invitation at the previous session of the Working Group for submission of proposals related to the physical requirements of international applications, one such proposal had been submitted by the

Delegation of the Russian Federation and had been made available before the session as an informal paper and posted on the PCT reform electronic forum⁴. It was observed that the work of the task force which had been set up at the time was currently suspended, pending developments in relation to work in the Standing Committee on Information Technologies Standards and Documentation Working Group on use of photographs and color drawings. The Secretariat stated that the International Bureau was also reviewing the physical requirements with a view to ensuring effective publication of international applications using its recently implemented systems, as well as those in receiving Offices which perform scanning of international applications themselves, and was likely to wish to propose changes to Rule 11 in the near future.

160. The Working Group agreed that the task force on physical requirements of international applications should be reactivated at an appropriate time, preferably when any proposals by the International Bureau were ready to be submitted to it, and that it should consider the proposals which have already been received as well as any others which may be made in the meantime.

FURTHER WORK

161. The Working Group noted that the Secretariat would prepare revised draft texts of proposed amendments of the Regulations concerning the various topics discussed during the session, taking into account the conclusions of the Working Group and comments and clarifications as set out above. The revised drafts would be posted on the PCT reform electronic forum to inform and seek comments from Working Group participants, with a view to preparing final texts that would be suitable, where the Working Group had so agreed, for submission to the Assembly for adoption.

162. The Secretariat noted that, with the close of the present session, there would be no PCT reform related items remaining on the agenda of the Working Group, and that the present session of the Working Group would thus be the last in the present reform exercise. It observed that there would be an ongoing need for minor changes to the Regulations of various types, for example, the proposals relating to the physical requirements of international applications referred to in paragraph 159, above. However, those proposals would generally be on a smaller scale and different in nature compared with the proposals which the Working Group had been established to address. Sometimes, it would be possible for such proposals to be submitted directly to the Assembly. It would also remain possible to convene an *ad hoc* advisory body when needed to address any particular such item.

163. The Working Group agreed that the present report should be submitted to the Assembly for consideration at its next session, in September-October 2007, to inform it of the progress that had been made on the matters referred to the Working Group by the Assembly at its previous session, in September-October 2006 (see document PCT/A/35/7, paragraph 6).

⁴ See WIPO's website at <http://www.wipo.int/pct/reform/en>.

164. The Working Group further agreed to recommend to the Assembly that it formally declare that the work of both the Committee on Reform of the PCT and the Working Group has been completed and that the mandate of both bodies, which were established by the Assembly at its 29th session in 2000 and at its 30th session in 2001, respectively, has come to an end.

165. The Working Group unanimously adopted this report on April 26, 2007.

[Annexes follow]

ANNEXE I/ANNEX I

LISTE DES PARTICIPANTS/
LIST OF PARTICIPANTS

I. MEMBRES/MEMBERS

(dans l'ordre alphabétique des noms français des États/
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[L'annexe II suit/
Annex II follows]

ANNEX II

PAPER CONTAINING JAPAN'S VIEW ON THE PROPOSED
"SUPPLEMENTARY INTERNATIONAL SEARCH"

I. JAPAN'S BASIC STANCE ON SUPPLEMENTARY INTERNATIONAL SEARCH
(SIS)

Japan is opposed to the concept of the Supplementary International Search (SIS) for the following reasons.

1. SIS IN THE CONTEXT OF OBJECTIVES OF INTERNATIONAL SEARCH (IS)

No difference can be found between an ISR and a national/regional search report in terms of the functions they perform as well as the contents that can be expected. Therefore, no good reason can be found to institutionalize in the existing PCT scheme the new type of international search that goes beyond the existing national/regional search.

The objectives of an International Search Report (ISR) are considered to be as follows:

- (1) To provide an applicant with information for making a decision about whether it is worth proceeding further with the international application;
- (2) To increase the predictability of patentability and reduce the burden of surveillance on the part of a third party;
- (3) To allow Designated Offices to more easily carry out national/regional searches using the results of international searches; and
- (4) To reduce the number of potentially unpatentable applications filed in countries having no sufficient examination capability or pre-grant examination system.

These objectives of ISR are similar to the objectives of national/regional prior-art searches to be conducted by the National Offices (NO). For instance, prior-art search reports for national/regional applications are supposed to provide applicants and third parties with the useful information implied in the aforementioned objectives (1) and (2). From the standpoint of the countries that wish to make use of the search results obtained in other countries/regions for corresponding foreign applications, such search results are expected to play the roles mentioned in aforementioned objectives (3) and (4).

As described above, no difference can be found between an ISR and a national/regional search report (at least the one prepared by a NO which is qualified as an ISA) in terms of their functions as well as their contents. As a national office, an ISA is considered to have the capability of conducting adequate national/regional searches to the extent necessary and sufficient, including the capability of conducting searches of prior-art documents written in specific languages for PCT minimum documents. Therefore, an ISA would be able to satisfy the necessary and sufficient condition for preparation of an ISR, if the ISA does what it usually does in its national/regional searches.

No difference can be found between an ISR and a national/regional search report (prepared by a NO which is qualified as an ISA) in terms of their functions and their contents.

Therefore, no good reason can be found for the SIS proposal which is intended to institutionalize in the existing PCT scheme the new type of international search that goes beyond the national/regional search. If an ISA wishes to conduct an international search surpassing the extent of its national/regional search (e.g., an international search for a document in a specific language which is not covered by its national/regional search), that kind of search should be considered an additional service to be voluntarily provided by that ISA, but it should not be institutionalized in the PCT system.

2. RESPONSIBILITIES AND DISCRETIONS OF ISA

It is the responsibility of an ISA to conduct a search to the extent it considers appropriate. If an ISA considers it lacks sufficient ability to search for documents in a specific language, the ISA may outsource a part of the search to an outside search organization to conduct a search for documents written in such a specific language on the condition that the ISA bears full responsibility for the final result of the ISR. Under the current PCT system, the decision to outsource a part of the search has been left to the discretion of an ISA.

Article 15(4) of the PCT stipulates that “the International Searching Authority...shall endeavor to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the Regulations.” It is not Japan’s position to give an excessively broad interpretation to this provision, so that the provision is interpreted as meaning that ISAs are, in every case, responsible for conducting searches for every prior art document written in any of the specific languages required for the PCT minimum documents. On the contrary, we believe that, in light of the objectives listed in (1)-(4) of point 1, it is sufficient for a national office acting as an ISA to conduct an international search in the same manner and to the same extent that it conducts a national/regional search.

Taking into account this provision on the duties of an ISA for international searches, however, it seems to be the responsibility of an ISA to conduct a search for the scope of documents to the extent it considers appropriate, including a search for prior-art documents written in a specific language.

The way to fulfill such responsibilities of an ISA should be determined by each ISA at its discretion. If an ISA considers that it lacks the ability to sufficiently search for documents in a specific language, the ISA may outsource a part of the search to an outside search organization having the ability to conduct a sufficient, detailed search for documents written in such a specific language, and thereby supplement the search of the ISA on the condition that the ISA bears full responsibility for the final result of the ISR as a whole.

Thus, it should be the responsibility of the ISA to take the necessary measures to fulfill the responsibilities of an ISA outlined in the corresponding provision. It is our understanding that under the current PCT system, ISAs are already permitted to outsource a part of their search for supplementary purposes, and the decision of an ISA to outsource a part of its search has been left to the discretion of each ISA. No good reason can be found why such supplementary searches must be institutionalized in the PCT.

It should be added that for the JPO to be an outside search organization seems to exceed the scope of the role expected and permitted of a governmental organization.

3. DE-CENTRALIZED SYSTEM OF ISAS

In a system that allows two or more ISAs to work on a single international search (if not single physically but functionally), an individual ISA's responsibility for the production of an ISR would become unclear and result in an irresponsible system in which no one has sense of responsibility for their collaborative work results. Instead, a de-centralized system in which all ISAs have clear responsibility and compete with each other to offer users better and more user-friendly service is desirable.

The concept of SIS can be viewed as an attempt to unify ISAs in a sense that multiple ISAs can collaboratively conduct a "single international search" (if not single physically but functionally) for a single international application. In fact, Article 16(2) of the PCT mentions, "pending the establishment of a single International Searching Authority," and thereby suggests that the ultimate objective of this provision might be the integration of ISAs.

With the rapid progress of information technology, however, we are now in a situation where searchers/examiners can access the same database from anywhere in the world. This is a development which nobody could have foreseen at the time when the PCT was established; i.e., at a time when prior-art documents were in a form of paper collection. Under the current circumstances, a de-centralized system consisting of multiple ISAs can be regarded as more suitable for effectively utilizing the search resources in various parts of the world than a centralized system with "a single world-ISA." There currently exist 12 separate and independent ISAs, and the number of the ISAs is and will be increasing. Such a situation can no longer be regarded as a transitional stage toward centralization. Instead, we are moving toward de-centralization.

In order to make such a de-centralized system work more effectively and efficiently, however, all ISAs should be held responsible for the ISRs which they produce and display capability equivalent to other ISAs. If these conditions are not satisfied, an ISA/NO will be unable to rely on an ISR prepared by another ISA.

In light of the above, the JPO cannot shake off the doubt that, in a system that allows two or more ISAs to work on a single international search (if not single physically but functionally), an individual ISA's responsibility for the production of an ISR becomes unclear, and the result would be an irresponsible system in which no one has a sense of responsibility for their collaborative work results. Instead, a de-centralized system in which all ISAs having a clear responsibility compete with each other for better and more user-friendly service is desirable.

4. DISCRIMINATION IN TERMS OF NATIONAL LANGUAGE

The SIS would, by its nature, result in a systematic shift of burden, which otherwise would be equally borne by all ISAs, to a specific ISA on the sole ground that such a specific ISA has a specific procedural language (normally its national language). This is equivalent to unfair treatment of such an ISA (i.e., a Member State) based on its national language.

Under the current practice, the jurisdiction or competence of a Receiving Office (RO) is determined, taking into account the procedural language of the RO as a NO (PCT Rule 19). Similarly, the jurisdiction or competence of an ISA is determined, taking into account the procedural language of the ISA as a NO (PCT Article 1(2) and Rule 35). Accordingly, the

procedures before an RO/ISA have to be conducted in the pre-determined procedural languages. This is done for the benefit of applicants as well as in consideration of the capability/burden of the ROs/ISAs.

For prior-art search purposes, on the other hand, each ISA is required to carry out a search for PCT minimum documents irrespective of the language of the documents. This is because the novelty/inventive step criteria in an international search must be examined over the prior-art documents which have been published anywhere in the world (i.e., regardless of the place of publication) and because the value of relevant prior-art documents relies solely on the technological contents described in such documents but not on the language used in the documents.

Therefore, each ISA should carry out an international search for all prior-art documents regardless of the language used for the documents, to the extent considered appropriate for providing the information necessary to determine the novelty/inventive step in light of the objectives listed in (1) - (4) of point 1 above. In fact, the JPO as an ISA conducts searches for non-Japanese prior-art documents if deemed necessary for preparing an adequate ISR. In the same manner, another ISA whose procedural language is non-Japanese should conduct searches for Japanese-language prior-art documents in an international search if deemed necessary for preparing an adequate ISR.

In contrast to the above analysis, the SIS, even if it is on an optional basis, is designed to institutionalize in the PCT the wrong concept to transfer the burden of search for prior-art documents in a specific language (e.g., Japanese or other non-English languages) from an ISA having a procedural language different from such a specific language to another ISA having such a specific procedural language.

The burden of conducting an international search for prior-art documents in a specific language (e.g., Japanese or other non-English languages) should be equally borne by all ISAs to the extent necessary to prepare an adequate ISR. Therefore, it is not appropriate to institutionalize a system, even if it is optional, which would result in placing additional burden on a specific ISA having a specific procedural language. The proposed SIS is, by its nature, intended to justify the systematic shift of the burden, which otherwise should be equally borne by all ISAs, to a specific ISA on the sole ground that such a specific ISA has a specific procedural language (normally its national language). This is equivalent to unfair treatment of such an ISA (i.e., a Member State) in terms of its national language. This argument is not limited to Japan, but in any country, only few legislators/politicians would agree with the attempt to institutionalize in an international treaty such an unfair treatment in terms of its national language.

II. ADDITIONAL OBSERVATIONS ON THE DOCUMENT PCT/R/WG/9/2

Based on the basic position indicated in I above, Japan remains opposed to the specific proposal on SIS described in the document PCT/R/WG/9/2 of the PCT Reform Working Group. Additional observations regarding the specific proposal are listed below.

1. LACK OF FACT-BASED ANALYSIS

There should be a quantitative analysis of the alleged problem arising in the existing scheme of the PCT as well as an identification of the actual scope and nature of the needs of the users. Otherwise, one cannot evaluate whether the benefit of the proposed SIS exceeds

the cost of institutionalizing the SIS within the PCT framework. Introducing a new system into the PCT scheme without such a fact-based analysis could result in a mere waste of the PCT budget which could otherwise be allocated to other programs.

In the third paragraph on page 10 of the document PCT/R/WG/9/2, it is stated that, as a supporting reason of institutionalizing the SIS, “eight Authorities supported the proposals for a supplementary international search system..., reiterating the strong desire of users for the introduction of such a system.” However, it is still unclear to us what the “strong desire” means because no in-depth analysis has been conducted to capture the actual needs.

In this relation, the document 9/2 (Page 5, second paragraph) also states, “A number of representatives of users urged the introduction of a system of supplementary international searches as soon as possible. Applicants had different needs and there were different views on what would be the ideal system. Sometimes applicants wanted as much information as possible as soon as possible. In other cases, additional searches would only be requested where a particular need was seen.”

These statements indicate that the needs, if they exist, might be limited to the needs of specific industries of specific countries with respect to the specific documentation in specific languages in a specific technical field, etc. If this is the case, such needs might be more appropriately taken care of by other means, such as bilateral arrangements. Thus, there seems to be no reason to justify the institutionalization of the SIS in the multilateral framework of the PCT. In addition, it is not clear whether the proposed SIS can equally benefit all types of users including universities, SMEs, individuals or applicants who do not have sufficient funds.

The same paragraph of the document also states, “The greatest costs and duplications occurred when new prior art was discovered in the national phase, resulting in multiple examinations raising unexpected objections.”

However, Japan has not seen any quantitative analysis showing how frequently a new prior art is discovered in the national phase which is more appropriate than the prior art cited in the ISR nor any quantitative analysis showing how seriously it affects the applicants. In this regard, it is necessary not only to identify the scope and nature of the actual user needs but also to conduct a quantitative analysis of the alleged problem.

Even between two corresponding non-PCT applications via the Paris route, a new prior art which has not been cited by one National Office can be found in the subsequent search by another National Office. Despite this, Japan has not heard of any strong needs for an attempt to establish a universal system where a National Office is requested to carry out an additional different search other than the normal national/regional search solely for a foreign application filed via the Paris route. If an NO carries out an adequate national/regional search under normal procedures, the NO should not be required to provide any additional search other than the normal national/regional search.

To summarize, we are not convinced that the benefit of the proposed SIS exceeds the cost of institutionalizing the SIS within the PCT framework because the scope and nature of the need has not been identified with a quantitative analysis. On the contrary, Japan has a concern that the proposed SIS could result in a mere waste of the PCT budget which could otherwise be allocated for other programs.

2. OTHER PROBLEMS OF THE SIS PROPOSAL IN PCT/R/WG/9/2

There are concerns over the specific SIS proposal in PCT/R/WG/9/2 in terms of (1) ambiguous legal ground of the SISR under the PCT, (2) lack of quality assurance of the SISR, (3) lowering morale for the quality of the ISR, (4) discrepancies in contents between ISR and SISR, and (5) inefficient usage of search resources worldwide.

The mechanism of the SIS proposed in the document PCT/R/WG/9/2 is that, after the issuance of a primary international search report (which is supposed to be the same as the normal ISR) by the ISA, the Supplemental International Searching Authority (SISA) carries out a supplementary international search which covers at least the documentation previously agreed upon with the IB while taking due account of the primary search report and issues a Supplementary International Search Report (SISR) under the SISA's own responsibility which is transmitted to the applicant afterwards.

The first problem to be pointed out is that the legal ground of the SISR under the PCT is ambiguous. Unlike the ISR, which is clearly mandated in the Treaty language of the PCT, the SISR which is separate from the ISR is not clearly grounded by the Treaty language. If the SIS is institutionalized in the PCT, its administration would consume substantial financial resources. Therefore, the SIS should be clearly grounded in the Treaty language of the PCT.

Secondly, there is a concern about the quality of the SISR. Since Article 15(4) of the PCT does not apply to the SIS, the quality of the SIS is not ensured by the PCT. Due to such a concern, an applicant and a Designated Office might not regard the SISR in the same manner as the ISR in terms of quality and reliability.

Thirdly, there is a concern about the lowered morale for high quality ISR, as well. If the JPO, for example, were committed to act as an SISA to conduct a supplementary search for Japanese patent documents, there would be a large possibility that the sense of responsibility of other ISAs having non-Japanese procedural languages would be undermined, which is stipulated in Article 15(4) that an "ISA shall endeavor to discover as much of the relevant prior art (including Japanese patent documents) as its facilities permit." Such possible lowering of morale of the ISA can give rise to the risk of a lower search quality of ISR, especially regarding the search of documents in the SISA language.

Fourthly, there is a concern about the discrepancies between ISR and SISR in terms of their contents. Because an ISR and a SISR are prepared and issued separately, the contents of the ISR can be inconsistent with that of the SISR. Yet, the document PCT/R/WG/9/2 does not refer to any procedure by which the ISA coordinates with the SISA to determine which result is more appropriate. Therefore, applicants and Designated Offices using the SISR would become confused over which search report is more reliable when the ISR and SISR contain contradictory prior art citations. (For instance, when two documents are the same in view of technological contents but different in languages, one can be cited with category X in the ISR, and another can be cited with category A in the SISR.)

Fifthly, there is a concern about the inefficient use of resources for search worldwide. According to the PCT/R/WG/9/2, the SIS system is to be implemented only among ISAs and cannot make use of the capacities of other NOs, which are non-ISAs but still have adequate search capability. Therefore, the specific proposal is not adequate from the perspective of the effective and efficient utilization of such search resources of non-ISAs, which is desirable for coping with ever-increasing patent applications all over the world.

III. OTHER ALTERNATIVES TO BE EXAMINED

The SIS is neither the only solution nor the appropriate solution. A problem of the difficulties in prior-art searches for documentation written in specific languages could be better solved by other measures, such as (i) improvement in search environments of ISA, (ii) entrustment of international search to other organizations, and (iii) early entry into national phase. After identifying legitimate needs of users by conducting a fact-based analysis with quantitative data, we should carry out discussions on the other alternatives including the above.

As stated in II.1 above, Japan views the current discussion as lacking a fact-based analysis on the problems and needs of users, the result of which might justify the SIS. Even if such a fact-based analysis reveals that there exist problems to be solved, however, Japan is of the view that the SIS is neither the only solution nor the appropriate solution.

If the promoters of the SIS were proposing the SIS as a solution to address a problem of the difficulties in prior-art searches for documentation written in specific languages (Paragraph 4 of PCT/MIA14/7), such a problem could be better solved by the following measures (i) to (iii) among others.

The following alternatives have not been discussed at the meeting of the PCT Reform Working Group nor other relevant meetings. Therefore, after conducting the fact-based analysis of the actual user needs with quantitative data and identifying legitimate needs, an adequate time should be taken to carry out a practical, empirical and logical discussion about appropriate alternatives for addressing the legitimate needs of the users.

(i) Improvement in search environments of ISA

While the ISAs should make due efforts to improve their search abilities on one hand, the ISAs could take collaborative measures for improving search environments so as to enable other ISAs/NOs to more easily search patent documentation. More specifically, it would be useful for ISAs/NOs, which issue patent documentation in certain languages, to provide a translation service which will help other ISAs/NOs to search patent documentation originally issued in such languages. In this regard, Japan has been widely distributing Patent Abstracts of Japan, which is a collection of English-version abstracts of Japanese patent documents, and electronically publishing the specifications of Japanese patent documents on the Industrial Property Digital Library (IPDL) with a machine translation function attached to it.

(ii) Entrustment of international search (Entrusted International Search system)

It is our understanding that an entrustment of international search to other bodies can be done at the discretion of an ISA under the current framework of the PCT. However, another possibility is the addition of some provisions to the PCT Regulations or the formulation of another kind of rule for the purpose of confirmation and clarification that a part of an international search can be entrusted to another NO or another organization as long as the ISA takes the full responsibility for the final results of the international search.

While it is of a provisional nature, the concept of the “Entrusted International Search” (EIS) which could be prescribed in the Rule is shown in the Appendix to this document in order for members to easily understand the concept. As stated in the Appendix, as far as the ISA

takes full responsibility for the final result of an international search, the ISA may entrust a part of the international search to a NO (which is not necessarily an ISA) with adequate search ability.

The concept of the EIS is consistent with the points 1 to 4 in I. above. The EIS would provide an ISR which would be reinforced by entrustment but not exceed the expected role of an ISR. The EIS would undermine neither the responsibility of the ISA nor the discretion of the ISA. The EIS would work under the current de-centralized system. The EIS would not result in discrimination in terms of language.

The EIS can also avoid the problems (1) to (5) indicated in II.2 above. The EIS is related to an ISR and clearly based on the PCT. The quality of entrusted search could be assured by the ISA. Since the ISA has the final responsibility for the ISR, the quality of the ISR can be assured, as well. Unlike the SIS, the EIS would not cause the problem of contradiction between an ISR and an SISR. The EIS could effectively utilize resources all over the world and not be limited to ISAs but include non-ISA NO and other organizations.

(iii) Early entry into national phase

It is always free for an applicant, who has received an ISR, to ask a commercial search organization for an additional search which covers prior-art documents written in a specific language, if the applicant considers that the ISR is insufficient in terms of prior-art documents in the specific language.

Apart from this, an applicant could also obtain an additional search/examination from a DO which is well-qualified to conduct a search for documents in a specific language, if the applicant enters into a national phase of that particular DO. Because an applicant may request earlier national entry under the Article 23(2) of the PCT, the applicant could ask for such national/regional search/examination immediately after the applicant receives the ISR if the applicant deems that the ISR is insufficient in terms of specific language.

As regards public accessibility to the office action in the national phase, in the case of the JPO, for example, any DO registered with the JPO can access the office actions issued by the JPO over the Internet.

IV. CONCLUSION

Japan is opposed to the proposal to institutionalize the SIS within the PCT framework. Japan is not supportive of the SIS proposal being sent to the PCT Union General Assembly.

Japan does not support any hasty drafting of text changes to the PCT, PCT Regulations, or the PCT Guidelines which presuppose the SIS.

Instead, Japan desires to see Member States first conduct a fact-based analysis of the scope and nature of the needs of users as well as a quantitative analysis of the needs, and then, if necessary, form an appropriate forum to discuss all the possible alternatives including those indicated above in a comprehensive manner.

[Appendix to Annex II follows]

APPENDIX

ENTRUSTED INTERNATIONAL SEARCH (EIS)

- (a) Where it is considered necessary for fulfilling the obligations listed Articles 15(4) and 16(1) or considered indispensable for conducting an international search in a more efficient manner, an ISA may entrust any part of the work involved in conducting an international search (hereinafter referred to as “Entrusted International Search (EIS)”) to a national Office or another entity (hereinafter referred to as “Entrusted Party”).
- (b) If the following conditions are met, an EIS should not be regarded as a violation of any part of Article 15(4) which states that “an ISA shall endeavor to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the Regulation” and Article 16(1) which states that “an international search shall be carried out by an ISA.”
- The ISA takes appropriate measures to ensure that either the ISA itself or the Entrusted Party consult the documentation specified in the Regulation in a manner as provided in Article 15(4).
 - Not all of the work necessary for conducting an international search but only a part of the work is entrusted to an Entrusted Party by the ISA.
 - The ISA takes full responsibility for the final results of the international search.
- (c) If the following conditions are met, an EIS should not be regarded as a violation of any part of Article 30(1) which states that “an ISA shall not allow access by any person or authority to the international application before the international publication.”
- The ISA and the Entrusted Party can be regarded as a single searching authority in terms of function and collaborative effort in jointly conducting an international search, if not in terms of their legal status or physical status.
 - The ISA and the Entrusted Party jointly take all necessary measures to ensure the confidentiality of an international application as provided in Article 30(1).
- (d) EIS shall not be used so as for an ISA to carry out a search which goes beyond the extent that is required under the PCT, Regulation and the Guidelines. An entrustment for conducting such an extensive search should be regarded as outside of the framework of the PCT, and should be done on the volition of the ISA.
- (e) The EIS shall not be used as a disguised and systematic means of discrimination against any ISA or national Office, including linguistic discrimination, nor as an unwarranted and systematic means of increasing the burden on any ISA or national Office. In this respect, any national Office or ISA should be free to choose whether to be an Entrusted Party. In addition, the work which can be entrusted to an Entrusted Party by an ISA should not be limited to a search for prior-art documentation in a specific language. Instead, an ISA should be permitted to entrust to an Entrusted Party any part of the work involved in conducting an international search.

[End of Annex II and of document]