

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

**Twenty-Seventh Session
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REVIEW OF SUPPLEMENTARY INTERNATIONAL SEARCH SYSTEM

Document prepared by the International Bureau

SUMMARY

1. This document invites International Authorities to provide comments on the supplementary international search system for the PCT Working Group to take into account when preparing the review of the system by the PCT Assembly in September 2020.

BACKGROUND

2. The PCT Assembly (“the Assembly”), at its thirty-sixth session in September/October 2007, amended the PCT Regulations to introduce a supplementary international search system. These amendments entered into force on January 1, 2009 (document PCT/A/36/13).

3. The Assembly reviewed the supplementary international search system at its forty-third session in October 2012 and again at its forty-seventh session in October 2015. The decision by the PCT Assembly after the second review is set out in paragraph 17 of document PCT/A/47/9, as follows:

“17. The Assembly, having reviewed the supplementary international search system three years after the date of entry into force of the system and again in 2015, decided:

“(a) to invite the International Bureau to continue to closely monitor the system for a period of a further five years, and to continue to report to the Meeting of International Authorities and the Working Group on how the system is developing;

"(b) to invite the International Bureau, International Authorities and national Offices and user groups to continue their efforts to raise awareness of and promote the service to users of the PCT System;

"(c) to invite the International Authorities which offer supplementary international searches to consider reviewing the scope of their services provided under the system and consequently the levels of fees charged for the services provided, which should be reasonable; and to invite Authorities which currently do not offer the service to reconsider whether to offer the service in the near future;

"(d) to review the system again in 2020, taking into account further developments until then, notably in relation to developments in collaborative search and examination, and in relation to efforts to improve the quality of the 'main' international search."

4. In preparation for the review by the Assembly later this year, this document provides information on legal developments and use of the supplementary international search system and discusses future options for the system.

LEGAL DEVELOPMENTS

5. In response to an invitation from the PCT Working Group while preparing for the review of the supplementary international search system in 2015, the International Bureau presented a document to the ninth session of the PCT Working Group in May 2016 to discuss possible improvements to the supplementary international search system (document PCT/WG/9/6). This document followed discussions of possible improvements to the system at the twenty-third session of the Meeting of International Authorities in January 2016 (document PCT/MIA/23/4). The document for the Working Group proposed amendments to the PCT Regulations on supplementary international search as follows:

- extending the deadline for requesting supplementary international search from 19 to 22 months from the priority date; and
- providing the option for an Authority specified for supplementary search to issue a written opinion with all its supplementary international search reports.

6. Paragraphs 117 to 123 of the Summary by the Chair of the ninth session of the PCT Working Group summarize discussions of the amendments to the PCT Regulations on supplementary international search proposed in document PCT/WG/9/6. Paragraphs 277 to 289 of the Report of the session, document PCT/WG/9/28, provide a full record of these discussions. While the Working Group approved the proposed amendments to extend the deadline for requesting supplementary international search, there was no agreement to amend the PCT Regulations to provide the option for an Authority specified for supplementary search to issue a written opinion with its supplementary international search reports.

7. The PCT Assembly, at its forty-eighth session in October 2016, subsequently approved the amendments to the PCT Regulations to move the deadline for requesting supplementary international search from 19 to 22 months from the priority date (see document PCT/A/48/3 and paragraphs 21 to 24 of document PCT/A/48/5). These amendments entered into force on July 1, 2017.

REQUESTS FOR SUPPLEMENTARY INTERNATIONAL SEARCH

8. Tables 1 and 2, below, provide details on the use of supplementary international search by applicants since this option became available to applicants in 2009.

SISA Main ISA	AT	EP	FI	RU	SE	SG	TR	UA	XN	XV	Total
AT		2			1						3
AU		1				1					2
CA		18		2				1	1		22
CN		297									297
EG		1									1
EP	12		1	200	8	3	3	2	4	2	235
ES		3									3
IL		1									1
IN	1										1
JP		9									9
KR		18		4	1	3					26
RU		5						4			9
SE				9							9
US		27		3	2						32
XN		1									1
Total	13	383	1	218	12	7	3	7	5	2	651

Table 1: Number of Supplementary International Search Requests by International Searching Authority and Supplementary International Searching Authority (until early November 2019)

SISA	2009	2010	2011	2012	2013	2014	2015	2016	2017	2018	2019	Total
AT			1	2	1	2	2		1	1	3	13
EP		3	7	21	30	60	40	44	40	54	84	383
FI				1								1
RU	23	35	31	19	32	46	22	2	6		2	218
SE	2	2	2		2					3	1	12
SG								1		3	3	7
TR										1	2	3
UA									2	1	4	7
XN		1		2							2	5
XV											2	2
Total	25	41	41	45	65	108	64	47	49	63	103	651

Table 2: Supplementary International Search Requests by Year (2019 showing figures to early November 2019)

9. Overall, the uptake of supplementary international search has been very low, with the maximum number of requests in a single year barely exceeding 100. These numbers are minuscule compared to the number of international search reports established each year, which rose from 157,740 to 242,044 between 2009 and 2018. It is apparent that the amendments to the PCT Regulations adopted in 2016 did not have any significant effect on the level of use.

10. Looking more closely at Table 1, 76 per cent of all supplementary international search requests involve just two combinations:

- (a) ISA/CN and SISA/EP (297 requests; 45.6 per cent); and
- (b) ISA/EP and SISA/RU (200 requests; 30.7 per cent).

In addition, Table 2 shows that most requests in the second of these combinations occurred before 2016 as the Federal Service for Intellectual Property (Rospatent) has only received 10 requests for supplementary international search since this date. Requests to the European Patent Office (EPO) based on applications searched by the China National Intellectual Property

Administration (CNIPA) have therefore dominated supplementary international search activity in recent years.

11. In terms of applicants using supplementary international search, the top 10 users account for more than three quarters (76.7 per cent) of all requests, with the top two users respectively making up 38.7 per cent and 24.1 per cent of all requests. The second of these users was responsible for most requests to Rospatent before 2016 and has not used supplementary international search since this date.

12. In summary, supplementary international search is very little used. Most requests come from a very small number of users using particular ISA and SISA combinations who appear to use supplementary international search as a filing strategy for particular cases. For most of these requests, users selected an SISA that was not a competent ISA for the receiving Office where these international applications were filed.

FUTURE OF SUPPLEMENTARY INTERNATIONAL SEARCH

13. In previous reviews of the supplementary international search system, the International Bureau pointed out that the running costs for handling supplementary international search requests were minimal at the International Bureau. Concerning expenditure to establish the system, the International Bureau was able to build on existing IT systems to process requests and fee payments, benefitting from its existing systems as a receiving Office, notably for the transfer of the supplementary international search fee to the relevant International Authority (see paragraph 33 of document PCT/WG/5/8). More recently, the International Bureau has automatically generated a copy of the international application supplementary international search for transmission to the EPO through PCT-EDI as it does for transmitting search copies through eSearchCopy. The review in 2015 also reported that International Authorities offering supplementary international search had indicated that the costs of providing the service were minimal compared to the set-up costs (see paragraph 25 of document PCT/WG/8/6).

14. Given the minimal operating costs and the use of supplementary international search by certain applicants, the Assembly during the previous reviews had maintained supplementary international search. However, looking ahead to the future development of PCT online services, further efficiency gains will rely on more machine-to-machine transactions, with data passed directly from the source, as discussed in paragraph 5 of document PCT/MIA/27/2. The development of web services to achieve this goal is at a trial stage with a few applicants and Offices performing live tests. In addition, a number of the Authorities offering supplementary international search have requested the browser-based service for Offices to be extended to cover that function more completely.

15. However, future automation of data transfer involving supplementary international search will involve IT development-related costs that would appear disproportionate to the low volume of requests. While ePCT has been designed to be modular and allow easy addition of functionality, adding services related to supplementary international search is more complicated than is the case for receiving Offices or the main roles of international search and international preliminary examination. Whereas for each international application there is exactly one International Searching Authority and zero or one International Preliminary Examining Authority, there can in theory be up to 10 Authorities specified for supplementary search. This means that the database interactions required to interact with such Authorities cannot be directly based on equivalent functions for the main International Searching Authority, but would need significant special development, most of which would likely not even be used by the European Patent Office, which currently conducts around 80 per cent of the supplementary searches.

16. Previous user feedback concerning the low use of supplementary international search has focused largely on the cost and the language specializations of the Authorities willing to offer the service. Given that neither aspect has significantly changed since the previous review, it does not appear useful to consider these subjects again.

17. Consequently, in the view of the International Bureau, there are two options for PCT Contracting States to consider in the review of the supplementary international search system later this year.

(a) The first option would be to maintain supplementary international search and set a date for the Assembly to review the system again. In determining the date for the next review, Contracting States could consider future developments in collaborative search and examination, as well as any changes in the competence of International Searching Authorities, whether through new bilateral arrangements between a receiving Office and International Searching Authority, or following the discussions referred to in document PCT/MIA/27/6. In this regard, the operational phase of the third pilot project involving the IP5 Offices is scheduled to run until June 2021. However, if the Assembly decides on this option, the International Bureau would propose not to plan investment in any additional automation of supplementary international search beyond what was essential to ensure the exchange of supplementary search copies and supplementary search reports.

(b) The second option would be to abolish supplementary international search with effect from a particular date, noting supplementary international search has been operating for more than 10 years with very low interest from users. As discussed in paragraphs 5 to 7, above, the PCT Working Group has considered possible improvements to system since the previous review of supplementary international search in 2015. Extension of the period for requesting supplementary international search, the only change to the legal framework agreed on by the Working Group, has not significantly increased the number of supplementary international search requests. As ceasing supplementary international search would require amendment to the PCT Regulations, if the Assembly decided to recommend this option during the review in 2020, the International Bureau would propose the necessary amendments to the PCT Regulations for adoption at the session of the Assembly in September/October 2021. The likely date for entry into force of the amendments and the end of supplementary international search would therefore be July 1, 2022, giving more than 18 months between the decision by the Assembly and the discontinuation of the service.

CONSIDERATION BY THE MEETING OF INTERNATIONAL AUTHORITIES

18. International Authorities are invited to provide feedback on the supplementary international search system and comment on the issues concerning the future of supplementary international search, outlined in paragraphs 13 to 16, above. The International Bureau will provide a summary of the discussions during this session to all Contracting States in a document for the PCT Working Group as it prepares for the review of supplementary international search by the Assembly in September 2020.

19. The Meeting is invited to comment on the issues related to supplementary international search raised in this document.

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