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SUPPLEMENTARY INTERNATIONAL SEARCH

Document prepared by the International Bureau

SUMMARY

1. This document contains proposals for amendment of Rule 45*bis* so as to put it beyond doubt that an International Searching Authority which is prepared to offer the service of supplementary international searches may not only set limitations as to the competency of that Authority to carry out supplementary international searches but also limitations as to the scope of supplementary international searches to be carried out by it. The document furthermore contains a number of other minor amendments to Rule 45*bis* to clarify the situations in which the supplementary search handling fee and the supplementary search fee are refunded by the International Bureau where the request for supplementary international search is considered not to have been submitted, and a proposal to amend Rule 96.1.

BACKGROUND

2. By way of Circular C. PCT 1155, dated November 13, 2008, the International Bureau invited International Searching Authorities to comment on proposed modifications to the PCT International Search and Preliminary Examination Guidelines, consequential on amendments of the Regulations under the PCT introducing the supplementary international search system.

3. In particular, Authorities were invited to comment on the proposed deletion of the following provision previously proposed to be added as new item (iii) of paragraph 15*bis*.13 of the Guidelines:

“The supplementary search may exclude: ... (iii) any claims which are excluded by a limitation or condition specified in the part of the agreement between the International Bureau and the International Authority stating the scope of its service.”

4. As outlined in Circular C. PCT 1155, the proposal to delete the previously proposed item (iii) of paragraph 15*bis*.13 was based on the consideration that the natural reading of Rules 45*bis*.5(g) and 45*bis*.9(a) was such that the limitations referred to in Rule 45*bis*.9 must be matters of competence for search in general, rather than in the extent of a supplementary international search. It appeared to the International Bureau that an Authority could make a general limitation under Rule 45*bis*.9(a) to the effect that it would not be competent if the claimed invention related to certain subject matter, or the application included more than 50 claims. On the other hand, an Authority could not make a limitation to the effect that it would be competent to perform a supplementary international search but that the extent of that search would be limited so that the search would only extend to claims which related to acceptable subject matter, or else to the first 50 claims only.

5. International Authorities were particularly invited to comment on this interpretation of limitations under Rule 45*bis*.9 as well as, if this interpretation was considered to be correct, whether Authorities saw the need to amend the PCT Regulations so as to allow an Authority to make a limitation as to the claims which are searched, as distinct from a limitation as to overall competence to carry out a supplementary international search at all.

6. In response to Circular C. PCT 1155, four Authorities commented on this issue. Three Authorities (all of which either already offer the service of supplementary international searches or are committed to offering that service in the near future) expressed the view that Authorities should have complete freedom and flexibility to define any limitations under Rule 45*bis*.9 and stated that they did not agree with the suggested interpretation of limitations under Rule 45*bis*.9; one of them suggested that, if needed, the Regulations should be amended accordingly to clarify the issue. One of those Authorities commented as follows:

“We consider SIS [supplementary international searches] as a kind of service to applicants rather than solely a statutory task. Our approach to SIS is therefore that the procedures should be as flexible and user friendly as possible.

“For instance, if an Authority has made a limitation on the number of claims and a request contains a higher number of claims, we would prefer the implication to be that the request is accepted and that the Authority will search only a number of claims up to the limit it has set.

“Similarly, if an Authority were to limit its SIS to certain technical areas, a request that contains claims outside these technical areas should be accepted provided it also contains claims within the accepted areas. It is understood, of course, that the search would only comprise the claims within the accepted technical areas.

“We do not find any provisions in the Treaty or the Regulations that explicitly prevent such flexible interpretation of the SIS. Actually, Rule 45*bis*.5(c), by referring to Article 17(2)(b) which in itself contains a flexible administration of the search procedure, supports our interpretation. In our view, therefore, there is a presumption for a flexible administration of SIS as exemplified above unless the Agreement between the individual Authority and WIPO specifically limits this.

“Such flexibility would obviously be in the interest of users. Furthermore, we do not believe that this will cause serious administrative problems. On the contrary, in the second example above it might be difficult for the International Bureau to decide whether a request contains claims outside the accepted areas. Still further, we do not see any complications when the application proceeds to the national or regional phase, provided, of course, that the Authority indicates clearly which claims it has searched and the reasons for any limitations in the search.

“We would therefore definitely prefer if the existing legal provisions in the PCT could be interpreted in line with the more flexible approach explained above.”

7. On the other hand, one other Authority commented that it agreed with the suggested interpretation of Rule 45*bis*.9 and that it did not see the need for any amendment to the Regulations.

8. The issue was further considered at the 16th session of the Meeting of International Authorities, held in Seoul, Republic of Korea, from March 16 to 18, 2009, based on document PCT/MIA/16/8, which invited International Authorities to consider whether the interpretation of limitations under Rule 45*bis*.9 as proposed in Circular C.PCT 1155 should be upheld and whether the previously proposed item (iii) of paragraph 15*bis*.13 should indeed be deleted (document PCT/MIA/16/8). International Authorities were also invited, should it be agreed not to uphold that interpretation of limitations under Rule 45*bis*.9, to consider whether there was a need to clarify the matter before including the previously proposed item (iii) of paragraph 15*bis*.13 in the Guidelines, either:

(i) by an agreed “understanding” by the Assembly on the interpretation of limitations under Rule 45*bis*.9; or

(ii) by way of an amendment to Rule 45*bis*.9.

9. The discussions of the Meeting of International Authorities are outlined in document PCT/MIA/16/15, paragraphs 85 to 89, reproduced in the following paragraphs:

**“SUPPLEMENTARY INTERNATIONAL SEARCHES: LIMITATIONS UNDER
RULE 45*bis*.9**

“85. Discussions were based on document PCT/MIA/16/8.

“86. The Meeting agreed that an International Searching Authority offering the service of supplementary international searches should, as a matter of principle, be allowed to adopt a limitation as to the extent of particular supplementary searches to be carried out by it, rather than only a limitation as to its general competence to carry out supplementary searches. The Meeting requested the Secretariat to consider appropriate measures to clarify the issue, including a possible amendment of the Regulations, taking into account the comments and suggestions appearing in the following paragraphs.

“87. One Authority stated that, while it agreed with the Secretariat on the more strict interpretation of Rule 45*bis*.9 as set out in document PCT/MIA/16/8, it had no objection to clarifying the issue by way of an appropriate amendment to the Regulations.

“88. One Authority expressed the view that Rule 45*bis*.5(g), which provided for a supplementary search request to be considered not to have been submitted where the Authority concerned had found that carrying out the search was excluded by a limitation or condition specified in the applicable agreement between the International Bureau and the Authority, should be interpreted as applying only to the case where the Authority was not competent at all to carry out such search and not to the case where the Authority had made a limitation only as to the extent of a supplementary search. The Secretariat expressed some doubts as to such interpretation and stated that it might be preferable to put the matter beyond doubt by amending both Rule 45*bis*.5(g) and 45*bis*.9.

“89. One Authority expressed the view that it was important that Authorities continue to have complete freedom to make limitations as to the subject matter for which they were willing to carry out supplementary international searches so that, as at present, they would be able to exclude certain kinds of subject matter, such as business methods.”

PROPOSED AMENDMENT OF RULE 45*bis*

10. Upon further consideration, and taking into account the discussions of the Meeting of International Authorities at its 16th session, reproduced above, it is proposed to amend Rule 45*bis* so as to put it beyond doubt that an International Searching Authority which is prepared to offer the service of supplementary international searches may not only set limitations as to the competency of that Authority to carry out supplementary international searches but also limitations as to the scope of supplementary international searches to be carried out by it.

11. In this context, a number of other minor amendments to Rule 45*bis* are also proposed to clarify the situations in which the supplementary search handling fee and the supplementary search fee are refunded by the International Bureau where the request for supplementary international search is considered not to have been submitted.

12. In addition, it is proposed to amend Rule 96.1 so as to clarify that the amount of fees referred to in Rule 45*bis* (supplementary search handling fee; supplementary search fee; late payment fee) are to be expressed in Swiss currency and to be set in the Schedule of Fees.

13. Further explanations are set out in the Annex in comments relating to the provisions concerned.

*14. The Working Group is invited to
consider the proposals contained in the Annex.*

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹

SUPPLEMENTARY INTERNATIONAL SEARCH

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 45bis

Supplementary International Searches

45bis.1 [No change]

45bis.2 Supplementary Search Handling Fee

(a) to (c) [No change]

(d) The International Bureau shall refund the supplementary search handling fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or [is](#) considered not to have been submitted [under Rule 45bis.1\(e\)](#).

[COMMENT: It is proposed to amend paragraph (d) so as to clarify the circumstances in which the International Bureau will refund the supplementary search handling fee where the supplementary search request is “considered not to have been submitted”. The supplementary search handling fee will be refunded in the circumstances set out in Rule 45bis.1(e), that is, where the supplementary search request is considered not to have been submitted because it was received after the expiration of the applicable time limit for making such a request, or where the Authority specified for supplementary search is not prepared to carry out such searches or is not competent to do so because it had acted as the main International Searching Authority. However, the supplementary search handling fee will not be refunded in the circumstances set out in Rule 45bis.4(d), that is, where the supplementary search request is considered not to have been submitted because the applicant, despite having been invited to do so, has not furnished a required correction of the request for supplementary search or has not paid the amount in full of the fees due.]

45bis.3 Supplementary Search Fee

(a) to (c) [No change]

[Rule 45bis.3, continued]

(d) The International Bureau shall refund the supplementary search fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or is considered not to have been submitted under Rules 45bis.1(e) or 45bis.4(d).

[COMMENT: It is proposed to amend paragraph (d) so as to clarify the circumstances in which the International Bureau will refund the supplementary search fee where the supplementary search request is “considered not to have been submitted”. Unlike in the case of the supplementary search handling fee (see the comment on Rule 45bis.2(d), above), the supplementary search fee will be refunded by the International Bureau in both the circumstances set out in Rule 45bis.1(e) and the circumstances set out in Rule 45bis.4(d).]

(e) The Authority specified for supplementary search shall, to the extent and under the conditions provided for in the applicable agreement under Article 16(3)(b), refund the supplementary search fee if, before it has started the supplementary international search in accordance with Rule 45bis.5(a), the supplementary search request is considered not to have been submitted under Rule 45bis.5(g).

[COMMENT: Clarification only.]

45bis.4 Checking of Supplementary Search Request; Correction of Defects; Late Payment of Fees; Transmittal to International Searching Authority

(a) to (c) [No change]

[Rule 45bis.4, continued]

(d) [No change] If the applicant does not furnish the required correction or does not pay the amount in full of the fees due, including the late payment fee, before the expiration of the time limit applicable under paragraph (a) or (b), respectively, the supplementary search request shall be considered not to have been submitted and the International Bureau shall so declare and shall inform the applicant accordingly.

(e) and (f) [No change]

45bis.5 Start, Basis and Scope of Supplementary International Search

(a) [No change]

(b) The supplementary international search shall be carried out on the basis of the international application as filed or of a translation referred to in Rule 45bis.1(b)(iii) or 45bis.1(c)(i), taking due account of the international search report and the written opinion established under Rule 43bis.1 where they are available to the Authority specified for supplementary search before it starts the search-provided that:

(i) where ~~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;

[Rule 45bis.5(b), continued]

(ii) where the Authority finds that carrying out the search is affected by a limitation as to the scope of supplementary international searches referred to in Rule 45bis.9(a) and (c), the supplementary international search may be limited accordingly.

[COMMENT: It is proposed to amend Rule 45bis.5(b) so as to take account of the fact that the scope of the supplementary international search may be limited by the Authority (see Rule 45bis.9(c) as proposed to be amended, below).]

(c) to (f) [No change]

(g) If the Authority specified for supplementary search finds that carrying out the search is excluded by a limitation as to the competency to carry out supplementary international searches ~~or condition~~ referred to in Rule 45bis.9(a) and (c), the supplementary search request shall be considered not to have been submitted, and the Authority shall so declare and shall promptly notify the applicant and the International Bureau accordingly.

[COMMENT: It is proposed to amend Rule 45bis.5(g) so as to clarify that paragraph (g) applies only in the case where the Authority is not competent to carry out the supplementary international search due to a limitation as to the competency of that Authority to carry out supplementary international searches, but not in the case where the Authority will carry out a search, albeit a limited one, due to a limitation as to the scope of international searches carried out by that Authority.]

45bis.6 Unity of Invention

(a) to (e) [No change]

[Rule 45bis.6, continued]

(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 [Rule 45bis.5\(i\) or \(ii\)](#) ~~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) [or which relate to the claims and those parts of the international application for which the Authority will carry out a supplementary international search, respectively.](#)

[COMMENT: It is proposed to amend Rule 45bis.6(f) so as to take account of the fact that the scope of the supplementary international search may be limited by the Authority specified for supplementary search (see Rule 45bis.9(c) as proposed to be amended, below).]

45bis.7 and 45bis.8 [No change]

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

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

(b) [No change] The International Searching Authority carrying out the international search under Article 16(1) in respect of an international application shall not be competent to carry out a supplementary international search in respect of that application.

[Rule 45bis.9, continued]

(c) The limitations referred to in paragraph (a) may, for example, include limitations [as to the competency to carry out supplementary international searches, such as a limitation](#) as to the subject matter for which supplementary international searches will be carried out, beyond those which would apply under Article 17(2) to the international search, and [a limitation](#) ~~limitations~~ as to the total number of supplementary international searches which will be carried out in a given period. [The limitations referred to in paragraph \(a\) may also, for example, include limitations as to the scope of supplementary international searches to be carried out, such as a limitation to the effect that the search will not extend to claims which relate to certain subject matter, and a limitation to the effect that the search will not extend to any claim beyond a certain number of claims.](#)

[COMMENT: It is proposed to amend Rule 45bis.9(c) so as to clarify that limitations set out in the applicable agreement between the Authority and the International Bureau may not only include limitations as to the competency to carry out supplementary international searches, but also limitations as to the scope of supplementary international searches to be carried out by that Authority.]

Rule 96

The Schedule of Fees

96.1 *Schedule of Fees Annexed to Regulations*

The amounts of the fees referred to in Rules 15, [45bis](#) and 57 shall be expressed in Swiss currency. They shall be specified in the Schedule of Fees which is annexed to these Regulations and forms an integral part thereof.

[COMMENT: It is proposed to amend Rule 96.1 so as to clarify that the amount of fees referred to in Rule 45bis (supplementary search handling fee; supplementary search fee; late payment fee) are to be expressed in Swiss currency and are to be set in the Schedule of Fees.]

[End of Annex and of document]