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The International Bureau of the World Intellectual Property Organization (WIPO) presents its compliments and has the honor to transmit herewith ./ documents PCT/R/WG/9/2, 3, 4, 5 and 6, prepared for the ninth session of the *Working Group on Reform of the Patent Cooperation Treaty (PCT)*, which will be 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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Enclosures: documents PCT/R/WG/9/2, 3, 4, 5 and 6

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INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

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

Ninth Session
Geneva, April 23 to 27, 2007

SUPPLEMENTARY INTERNATIONAL SEARCHES

Document prepared by the Secretariat

SUMMARY

1. Proposals are presented for a system of supplementary international searches within the PCT¹, whereby an applicant would have the option to request, in addition to the “main” international search, one or more supplementary searches to be carried out by International Authorities, other than the International Searching Authority that carries out the main international search. The proposals seek to establish a flexible system for supplementary international searches, aimed at encouraging the use of the results of the main international search in assessing the extent of the supplementary search which is required, but not preventing the International Authority carrying out the supplementary international search from beginning its search where the main international search report is established late, thereby avoiding difficulties in timing and workflow.

¹ 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.

TERMINOLOGY

2. In the main body of this document, the following abbreviated expressions are used to describe different search services and roles:

main search: the international search carried out under Article 15;

main Authority: the International Searching Authority which carries out the main international search;

supplementary search: a supplementary international search carried out by an International Searching Authority other than the one which carries out the main international search;

supplementary Authority: an Authority which is requested to carry out a supplementary international search on a particular international application.

BACKGROUND

3. Proposals for the introduction of a system of supplementary searches within the PCT, whereby an applicant would have the option to request, in addition to the main search, supplementary searches to be carried out by International Authorities, other than the International Searching Authority that carries out the main international search, were discussed by the Working Group on the Reform of the PCT (“the Working Group”) at its sixth, seventh and eighth sessions (see documents PCT/R/WG/6/9 and 12 (paragraphs 68 to 81); PCT/R/WG/7/7 and 13 (paragraphs 71 to 92); and PCT/R/WG/8/4 and 9 (paragraphs 35 to 64)), and by the Meeting of International Authorities Under the PCT (PCT/MIA) at its eleventh, twelfth, thirteenth and fourteenth session (see documents PCT/MIA/11/4 and 14 (paragraphs 42 to 55); PCT/MIA/12/2 and 10 (paragraphs 20 to 45); PCT/MIA/13/4 and 8 (paragraphs 26 to 33); and PCT/MIA/14/7 and 8 (paragraphs 42 to 53)).

4. There has been considerable support at the sessions of the Working Group and PCT/MIA for the principle of allowing optional supplementary searches of international applications during the international phase in order to find additional relevant prior art at an early stage, although there has been no consensus among all delegations and Authorities as to the general desirability of introducing a supplementary international search system into the PCT.

5. The discussions of the Working Group at its most recent session (see document PCT/R/WG/8/9, paragraphs 35 to 64) are outlined in the following paragraphs:

“SUPPLEMENTARY INTERNATIONAL SEARCHES

“35. Discussions were based on document PCT/R/WG/8/4.

“*General*

“36. A number of delegations emphasized that the international search was a central feature of the PCT system of great importance to national Offices, applicants and third

parties, and stated that the proposed introduction of supplementary international searches should not be seen as an alternative to ensuring the quality and timing of the main international search.

“37. A few delegations were opposed to the introduction of a system of supplementary international searches.

“38. One delegation considered that the proposal would result in more complication and reduction in legal certainty than would be justified by the benefit.

“39. Another delegation considered that the proposal would result in duplication of work and an increase in workload and that ways should be sought to encourage acceptance of the results of the main search undertaken by a single International Searching Authority. In connection with language-related aspects of the proposals, the delegation made the observation that the Japan Patent Office now provided machine translation of all Japanese patent applications into English to facilitate searching. Furthermore, it suggested that in case of difficulties with documents in particular languages, International Authorities might partially outsource searches to other bodies with the necessary linguistic skills. However, a further delegation observed that translations were not available for all documents and that there were legal difficulties involved in outsourcing, for example, relating to the confidentiality of international applications.

“40. Another delegation, while considering a system of supplementary searches to be a good idea in principle, was concerned at the effect on the current workload of the International Authorities and on the timeliness and quality of search reports and international preliminary reports on patentability. This could add further strain to the current problem before some International Authorities and would be of concern to all those who relied on those reports. Consequently, the delegation considered that it was not an appropriate time to introduce such a system. Instead, the delegation felt that the Working Group should focus first on quality and having one good international search report for now.

“41. One representative of an intergovernmental organization suggested that search services for applicants would be better provided by the private sector than by introducing further complications in the PCT system itself.

“42. On the other hand, while many delegations sympathized with the desire for a single comprehensive search in principle, a large majority of delegations agreed that there was a practical difficulty in providing such a search. In view of the importance to users of an opportunity to gain a better knowledge of the prior art during the international phase, before it was necessary to make decisions and incur substantial costs associated with entry into the national phase, they considered that some form of system of supplementary international search was appropriate. Certain delegations representing smaller Offices indicated that the additional information from supplementary searches would increase the confidence of such Offices as designated Offices in the completeness of the search and thus foster greater acceptance of the results of the international phase. It was observed that the system would be optional for International Authorities as well as applicants, and so need not affect the workloads of Authorities suffering from large backlogs of work.

“43. Amongst the delegations supporting a system of supplementary international searches, it was common ground that the system should allow for “sequential” supplementary searches, whereby the applicant could request an Authority to perform a search which took into account, at least to some extent, the results of the main international search which would already have been established. However, some delegations considered that sequential searches should be the only option permitted, whereas others considered that Authorities should have the option of offering “concurrent” supplementary searches to be performed before the main international search had been established, as an alternative to or in addition to sequential searches.

“44. In favor of sequential supplementary searches, some delegations suggested that these involved less complicated processes than concurrent searches and minimized the duplication of work in processing requests for them and in performing the searches. Furthermore, the fact that the main international search could be taken into account could promote work sharing and reduce the risk of conflicting reports on novelty, inventive step and unity of invention. The fact that the applicant would be able to see the main international search report before requesting a supplementary search would mean that supplementary searches would not be requested when the main international search report showed the claims to lack novelty or inventive step. It would be possible to focus the search on overcoming possible deficiencies in the main international search rather than repeating a search of material that had already been adequately considered. It was hoped that this might reduce the cost of supplementary searches compared to a more complete search. The knowledge of the prior art listed in the main international search report would minimize the risk that both the main and the supplementary search reports would list documents as category “A” (documents defining the general state of the art which are not considered to be of particular relevance) whereas if viewed together they might be seen to be category “Y” documents (documents relevant to inventive step when combined with one or more other such documents). While the relevance of the category “A” documents might later be discovered by large Offices conducting a thorough examination, this might well be missed by small and medium-sized Offices which relied more heavily on the international search reports.

“45. The main disadvantages of sequential searches were felt to be the reduced amount of time available to Authorities for establishing the supplementary search report compared to concurrent searches, and the risk that supplementary search reports might only be available very late indeed if, as was frequently the case at the present, the main international search report itself was delayed.

“46. In favor of concurrent supplementary searches, it was argued that the time pressures on Authorities would be significantly less than in sequential searches, potentially permitting more Authorities to participate if concurrent searches were an option. Furthermore, the supplementary search report would be available in time to be taken into account in deciding whether or not to make a demand for international preliminary examination. With respect to concerns about conflicts between reports from Authorities, it was observed that such conflicts would occur in any case during the national phase, and that it was better for the applicant to be aware of potential difficulties and alternative viewpoints at an earlier stage before the costs of national phase entry had been incurred. Furthermore, since it was only proposed that a system of concurrent searches be introduced as part of a system which also permitted sequential searches, it would provide additional options to applicants, who could tailor their choices to their particular application strategy.

“47. With respect to the patent claims for which supplementary international searches could be requested, one delegation suggested that it might be desirable if the Authority performing a supplementary search could provide a full search of claims which had not been searched by the main Authority, for example because the subject matter was excluded by the main Authority but not by the supplementary Authority.

“48. 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. Nevertheless, it was stated that the greatest costs and duplications occurred when new prior art was discovered in the national phase, resulting in multiple examinations raising unexpected objections. It was not seen as a duplication of work to request a search from a second Authority during the international phase if a corresponding search would in any case be carried out during the national phase, when the results would be of less benefit to the applicant. How matters of unity of invention were dealt with in respect of supplementary searches was seen by users as less of a concern. It was suggested that applicants might be permitted to request the targeting of particular supplementary searches towards particular matters, for example, on documents in a specified language. It was also suggested that Authorities performing supplementary searches might all be made aware of all the supplementary searches which had been requested, so that a collaborative search might be effected. Greater benefits were also seen for third parties if prior art was identified in the international phase.

“49. The Working Group agreed that the proposals relating to supplementary international searches be further developed and invited the Secretariat to prepare revised proposals for consideration at its next session, taking into account the discussion at the present session and particularly the comments and suggestions set out in the following paragraphs, as well as any further factors which may come to its attention in the meantime. Delegations and representatives were invited to make further observations and suggestions via the PCT reform electronic forum.

“50. In response to a question from a delegation, the Secretariat stated that, as presently drafted, the proposals would not allow applicants an additional opportunity to file amendments to the claims under Article 19 following the establishment of a supplementary international search report.

“51. One delegation emphasized the importance of making information concerning any supplementary searches easily available, including through the PatentScope website and on the International Application Status Form (Form PCT/IB/399).

“Detailed Comments and Suggestions

“– *Annex I of Document PCT/R/WG/8/4*

“52. The International Bureau indicated a number of minor changes that should be made to the proposals, including:

- (a) clarification in *Rule 45bis.5* of the result of a request for supplementary search being made outside of the permitted time or not indicating a participating Authority;
- (b) provision in *Rule 45bis.5(d)* for the case where the applicant did not provide sufficient supplementary search fees for the number of Authorities from which supplementary search had been requested, in addition to the case of insufficient additional supplementary search fees in cases of lack of unity of invention;
- (c) provision in *Rule 45bis.6* for the case where some, but not all, of the claims were excluded from supplementary search by a limitation made under *Rule 45bis.11(b)*;
- (d) the drafting in *Rule 45bis.10(b)* regarding how the supplementary international search report would be treated compared to a normal international search report.

“53. A number of delegations observed that the proposed *time limits for requesting and performing sequential supplementary searches* were based on the assumption that the main international search report would be established within, or at least close to the time limit set out in Rule 42, which was frequently not the case. Other delegations and representatives of users stated their hope that the large proportion of late international searches would be a temporary situation and considered that it was undesirable to complicate the proposal in response, though the latest statistics clearly indicated that the incidence of late international search reports had in some cases been rising in recent years, rather than declining. One delegation considered that the proposed time limits seemed a fair balance in any case since Rule 42 allowed (in most cases) three months for the establishment of a complete international search report, so this ought to be sufficient for a supplementary search which might be of reduced scope.

“54. Several representatives of users reiterated that, usually, the most important issue would be to receive the supplementary international search report in time to make decisions relating to entry into the national phase, for example, by around 26 months from the priority date. It was less important to receive the information before the time limit for demanding international preliminary examination. As a result, a number of delegations considered that it might be appropriate to review the proposed time limit for establishing a supplementary international search, which could be as late as 28 months from the priority date. A representative of users also suggested that if Authorities were not capable of providing a supplementary search report within a time limit useful to applicants, the service would simply not be requested.

“55. In response to a query from a delegation, the Secretariat confirmed that, under the proposal in Annex I of document PCT/R/WG/8/4 (and similarly for sequential searches under the proposal in Annex II), a *protest* before the main International Searching Authority might result in a need for the supplementary Authority to refund fees to the applicant even if it had already started the supplementary search.

“56. One delegation considered that, despite any administrative convenience, it would be strange for an Authority to follow the opinion of another Authority concerning *unity of invention* for the purpose of supplementary search, only to take a different view at a later stage, for example as a designated Office. The delegation considered that each

Authority should be permitted to examine the matter of unity of invention independently and should not be bound by any decision which it would not have made itself.

“57. It was observed that there was a contradiction between *Rules 45bis.5(d)* and *45bis.8(a)* with regard to how it should be decided which inventions should be searched in certain cases.

“58. One delegation considered that a supplementary search report would be more useful if it was not limited as proposed in *Rule 45bis.9(c)* so as to preclude, in most cases, the inclusion of documents which had been cited in the main international search report. It was observed that the supplementary Authority would in any case need to consider the documents cited by the main Authority in order to determine their relevance to inventive step and so it would not be a considerable burden to the examiner to cite the document fully if a further relevant, or even more relevant, passage was found or a different interpretation was given to the document.

“59. One representative of users expressed the hope that *fees* would not be set in such a manner that the cost of supplementary searches would be carried by applicants who did not choose to use the service.

“60. It was observed that several of the observations in paragraphs 52 to 59, above, were also applicable to equivalent provisions in Annex II of document PCT/R/WG/8/4.

“– *Annex II of Document PCT/R/WG/8/4*

“61. Further drafting changes set out in the report of the 13th session of the Meeting of International Authorities under the PCT should also be taken into account (see document PCT/MIA/13/8, paragraph 33(f) to (i)).

“62. One delegation recognized the reasons for which it had been proposed that requests under the proposals in Annex II of document PCT/R/WG/8/4 should be made to the individual supplementary Authorities, but considered that this emphasized the disadvantages of concurrent searches, since it would remove the benefit of the PCT system where, in general, requests and fees for a particular action could be provided by an applicant once, to a single point. To make requests to different Authorities would require more requests to be made, payments to be made in multiple currencies, and the requests to be checked for defects by each Authority, with different times for response. The International Bureau would also need to deal with requests for documents individually from different Authorities instead of preparing all the documents at the same time. As a consequence, a number of delegations considered that it might also be appropriate for requests to be made to the International Bureau in the proposals in Annex II. One delegation suggested that requests for concurrent search could be included in the request and requests for sequential searches be made to the International Bureau, though it was observed that a number of receiving Offices had previously indicated that they would not wish to handle requests for supplementary search.

“63. In relation to *Rule 45bis.8(a)*, two delegations considered that a protest procedure in relation to any assessment of unity of invention by a Supplementary International Searching Authority would be a necessary safeguard, while one considered that it would be unnecessary.

“64. In relation to *Rule 45bis.9(a)*, two delegations were concerned that the same time limit had been proposed for the establishment of concurrent searches as for sequential searches. It was observed that one of the main perceived benefits of concurrent searches was that the supplementary search report could be received quickly, but this provision would permit that advantage to be lost. In order to ensure that applicants obtained this advantage, one delegation proposed that the time limit for establishment of a supplementary international search report be the same as the time limit under Rule 42.1 for establishment of the primary international search report.”

6. Informal discussions since the eighth session of the Working Group have concentrated primarily on the timing of the supplementary search and the use of the results of the earlier main search, with a view to addressing the divergence of opinion outlined in document PCT/R/WG/8/13, paragraphs 35 to 64 (reproduced in paragraph 5, above).

7. The proposals were further discussed at the fourteenth session of the Meeting of International Authorities Under the PCT, at which the Secretariat also informed the Meeting of the results of the informal discussions undertaken by it. The Meeting’s discussion of the proposals (see document PCT/MIA/14/8, paragraphs 42 to 52) is outlined in the following paragraphs:

“Supplementary International Searches

“42. Discussions were based on document PCT/MIA/14/7.

“43. In introducing the matter, the Secretariat informed the Meeting of the results of further informal discussions undertaken with the European Patent Office and the United States Patent and Trademark Office, seeking to address the divergence of opinion outlined in paragraphs 10 and 12 of document PCT/MIA/14/7. Following those discussions, the Secretariat proposed to address some of the issues outlined in those paragraphs as follows:

“(i) *time limit for filing a request for supplementary international search (see document PCT/MIA/14/7, paragraph 12(d))*: applicants should be free to file a request for supplementary search with the International Bureau at any time after the filing of an international application but not later than 19 months from the priority date; any such request should not be forwarded by the International Bureau to the International Searching Authority requested to carry out the supplementary search before the expiration of 17 months from the priority date, unless the main international search report had been received by the International Bureau before the expiration of that time limit; consequently the supplementary search would always be a “sequential” one, allowing it to take into account the main international search report, except in cases where that report was established significantly late;

“(ii) *determination of unity of invention*: the supplementary Authority should be free to make its own determination of unity of invention; should that Authority find non-unity, it should only be required to search the “main” invention, to be identified (similar to today’s Chapter II procedure) by that Authority or the applicant (in cases of doubt, the invention first mentioned in the claims would be considered to be the main invention); applicants should have the opportunity to request a review of any non-unity

finding by the supplementary Authority, for example, by an internal review body of that Authority, but such a finding should not be subject to a full-fledged protest procedure as in the case of the main search;

“(iii) *relationship between supplementary international search and international preliminary examination*: each supplementary Authority should be free to specify in its agreement with the International Bureau that it would not carry out a supplementary search where it had received, in respect of a particular international application, a demand for international preliminary examination; further consideration should be given to the question of whether the filing of a request for supplementary search should more generally be considered a renunciation (“waiver”) by the applicant of the right to file a demand for international preliminary examination with *any* International Preliminary Examining Authority.

“43. As on previous occasions, there remained no consensus among Authorities as to the desirability of introducing a supplementary international search system into the PCT.

“44. The general idea of introducing a supplementary international search system was opposed by two Authorities. The Japan Patent Office noted that the objectives of a supplementary search would be similar to those of a national prior art search conducted by a national Office which also acted as an International Searching Authority, and that no difference could be found between an international search report and a national search report in terms of the functions of those reports as well as their contents. Thus, in its view, no good reason could be found to institutionalize in the PCT system a new type of international search which would go beyond the national search. Rather, if an International Searching Authority wished to conduct an international search beyond the extent of a national search (for example, if it wished to carry out a prior art search in documents which are in a different language than that covered by its national search), it should consider offering such a search as an additional service, and possibly outsource that work if there was a need to bring in language specialization not available within the Authority. Furthermore, the Japan Patent Office expressed its concern that a supplementary search system, with more than one Authority establishing an international search report, would make the individual Authority’s responsibility for the establishment of the international search report unclear, and stated that it preferred a decentralized system under which Authorities would compete with each other to provide better and more user-friendly services. The Office also voiced its concern about the discrimination of specific languages, such as, for example, Japanese, noting that the burden of carrying out searches in documents in such a language would be shifted to the Authority which had such language as its main working language, and stated that it could not accept such a shift. The statement made by the Japan Patent Office is set out in full in Annex II [of document PCT/MIA/14/8].

“45. The Spanish Patent and Trademark Office stated that, in its view, the proposed supplementary search system would be contrary to the philosophy of the PCT system, whose goal was to have a single search of high quality, and would be tantamount to recognizing the insufficiency of the present (main) international search. It expressed its concerns about the complexity added to the system, the duplication of work, and the effect and consequences for applicants and national Offices if the main and the supplementary search reports contained different or even contradictory prior art citations.

“46. IP Australia stated its support in principle for the concept of a single authoritative report and expressed some sympathy for the arguments put forward by those Authorities which opposed the introduction of the new system. However, it stated that it would not oppose the introduction of a supplementary search system, recognizing that such a system could assist in addressing language-related problems of the current international search. With respect to the detail of the proposals, it welcomed the progress towards ensuring that the system used sequential searching as far as practical, but stated that it would also support a time limit of 22 months from the priority date for requesting a supplementary search.

“47. The State Intellectual Property Office of the People’s Republic of China stated that it would not oppose the principle of permitting supplementary searches to be carried out in order to improve the quality of international searches. It emphasized, however, that the primary purpose of the supplementary search should be to overcome the language-related insufficiencies of the main international search. If the supplementary search went beyond this primary purpose, the disadvantages caused by the supplementary search system, such as 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, etc., would surpass the possible advantages to be obtained from such system. It was for those reasons that it strongly opposed the introduction of a concurrent supplementary search system. Furthermore, the State Intellectual Property Office of the People’s Republic of China reiterated that the main approach to improving the quality of international searches should be to improve the quality of the main search and to rely on utilizing the existing international search mechanism to the largest extent. The International Bureau should thus focus all of its efforts on measures to achieve this goal, such as establishing stricter and clearer standards and rules for international search, and encouraging all Authorities to communicate more frequently and efficiently on how to improve the quality of the main search, rather than pinning its hopes on a system of supplementary searches. It expressed the view that, in any case, the proposed supplementary search system should and could only be a supplementary means and should in no case materially change the existing international search system.

“48. Eight Authorities supported the proposals for a supplementary international search system, reiterating the strong desire of users for the introduction of such a system, and noting the aim of improving the basis on which applicants could make the decision whether to proceed with the application into the national phase such system and the aim of avoiding new and surprising citations of prior art in the national phase. While the Authorities were not in a position to express views on the specifics of the new proposals, they welcomed the progress made towards reaching agreement noted in paragraph 43, above.

“49. Some of those Authorities emphasized that the system was intended to be used only where the applicant saw a specific need. It was likely that applicants would only request a supplementary search from an Authority in cases where there was a strong intention to enter the national phase in the country whose Office acted as that Authority. If an Authority carried out a search in the international phase which in any case would have been done by the same Office in the national phase, work was simply being brought forward in time. Furthermore, the fact that this work was done in the international phase might save much work by other designated Offices in the national phase.

“50. The European Patent Office further stated that it did not consider that the proposals for a supplementary search system reduced the scope for introducing competition between International Searching Authorities. In addition, the supplementary search proposal had no bearing on the question of outsourcing of work if an Authority felt that this was a good method of addressing language issues, but rather provided an alternative route for addressing a real current problem.

“51. The Federal Service for Intellectual Property of the Russian Federation expressed concern at the idea that perceived language deficiencies should be addressed by outsourcing part of the search. While this might be an option for some Authorities, issues of confidentiality were involved and in some States the Office might be the only body competent to act in matters of search.

“52. The Meeting noted the intention of the Secretariat to post draft proposed amendments of the Regulations relating to supplementary international searches on the PCT/MIA electronic forum for comments by Authorities, and to subsequently submit those proposals, taking into account any comments received, to the Working Group on Reform of the PCT for consideration at its ninth session, to be held in April 2007.”

8. Revised proposals for amendment of the Regulations relating to a system of supplementary international searches, taking into account the suggestions made at the eighth session of the Working Group (see document PCT/R/WG/8/13, paragraphs 35 to 64, reproduced in paragraph 5, above), the results of the informal discussions undertaken by the Secretariat referred to in paragraph 7, above, the discussions at the fourteenth session of the PCT/MIA (see document PCT/MIA/14/8, paragraphs 42 to 52, reproduced in paragraph 7, above), and comments received on preliminary draft amendments of the Regulations relating to supplementary international searches posted on the PCT/MIA electronic forum for comments by Authorities (see document PCT/MIA/14/8, paragraph 52, reproduced in paragraph 7, above), have been prepared by the Secretariat accordingly. The further revised proposals are contained in the Annex to this document.

PROPOSALS FOR AMENDMENT OF THE REGULATIONS

9. The main features of the proposed supplementary search system are as follows:

(a) International Searching Authorities would be free to decide whether to provide a supplementary search service and, if so, under what conditions, to be set out in the Agreement under Article 16(3) between the International Bureau and the Authority concerned. In that Agreement, each Authority would be able to limit the availability of such supplementary international searches to particular fields of technology, for example to exclude fields for which an Authority may not have sufficient capacity at the time, or where an Authority wished to specialize in fields of technology in which it has a particular expertise.

(b) In the Agreement, each International Searching Authority would also be free to specify that it would not carry out a supplementary search where the Authority, in its capacity as International Preliminary Examining Authority, had received, in respect of the international application concerned, a demand for international preliminary examination or, at the option of the Authority, where such demand had been received by any other competent International Preliminary Examining Authority. Furthermore, in the Agreement, each Authority in its capacity as International Preliminary Examining Authority would also be free to specify that

it would not carry out international preliminary examination where the Authority itself, in its capacity as an International Searching Authority, had been requested to carry out a supplementary search in respect of the international application concerned, or, at the option of the Authority, where any other competent International Searching Authority had been requested to carry out such supplementary search.

(c) Applicants would be free to request supplementary searches from all, some, or none of the Authorities which offer supplementary searches, other than the main Authority for their application.

(d) Requests for supplementary international search would have to be submitted to the International Bureau prior to the expiration of 19 months from the priority date, highlighting the “sequential” and “supplementary” nature of the system, noting that, in the majority of cases, the main search report by the main Authority is available before 19 months from the priority date and thus before the supplementary search by the supplementary Authority commences.

(e) A supplementary search fee (for the benefit of the supplementary Authority) and a supplementary search handling fee (for the benefit of the International Bureau) would have to be paid within one month from the date of receipt by the International Bureau of the request for supplementary search. Applicants would be required to pay a late payment fee where the supplementary search handling fee and the supplementary search fee are not paid within the one-month time limit.

(f) The International Bureau would transmit a supplementary search copy of the international application and any other required documents to each supplementary Authority, including, in particular, a copy of the main search report and of the written opinion established by the main Authority, once these have been transmitted to the International Bureau. The request and those documents would be transmitted to the supplementary Authority not before the expiration of 17 months from the priority date, unless the main international search report had been received by the International Bureau before the expiration of that time limit. Consequently, the supplementary search would, in the vast majority of cases, be a “sequential” one, allowing it to take into account the main international search report, except in cases where that report was established significantly late.

(g) Supplementary search would start once the supplementary Authority is in possession of a copy of each of the following: the request for supplementary search, the international application and any required translation thereof, and any required sequence listing in electronic form. At the option of the Authority requested to carry out the supplementary search, the Authority could also decide not to commence with the supplementary search before the receipt of the main search report or the expiration of 22 months from the priority date, whichever occurred first, again highlighting the “sequential” and “supplementary” nature of the system.

(h) Supplementary search would be carried out on the basis of the international application as filed (or of a translation thereof), taking due account of the main search report and the written opinion established by the main Authority under Rule 43*bis*.1, if transmitted to the supplementary Authority before it starts the supplementary search. Any supplementary Authority would be free to exclude from the supplementary search any claims which were not the subject of the international search report where the international search report is available to the Authority before it starts the supplementary search.

(i) The Authority requested to carry out supplementary search would be free to make its own determination of unity of invention. Should that Authority find non-unity, it would only be required to search the “main” invention, to be identified (similar to today’s Chapter II procedure) by the applicant or, where the applicant failed to do so, by the Authority (in cases of doubt, the invention first mentioned in the claims would be considered to be the main invention for the purposes of supplementary search). Applicants would have the opportunity to request a review of any non-unity finding by the supplementary Authority but such a finding would not be subject to a full-fledged protest procedure as in the case of the main search.

(j) Each supplementary Authority would issue a supplementary international search report. While no written opinion would be established under the supplementary search system, the supplementary international search report could contain explanations with regard to the citations of the documents considered to be relevant, bearing in mind that many citations would be in languages not well understood by the applicant and many designated Offices.

(k) The supplementary international search report would take the same form as a normal international search report, except that it would not require the Authority to reconsider and list the classification. It is proposed to not limit re-citation of documents which appear in the main search report limited to the case where the re-citation is necessary for the indication of inventive step issues in relation to the combination of that document with newly found citations but rather to leave it to the discretion for the examiner to include further information which he considers to be relevant in respect of a citation which he considers may have greater relevance than would be realized from the main international search report.

(l) The supplementary search report would be established in the language of publication of the international application or in the language of any translation on which the search was based, at the choice of the Authority. Supplementary search reports would be made available electronically to the public as soon as possible after they are received by the International Bureau (provided that the international application has been published) in such a manner that they can be viewed by any person seeking access to the main search report. Furthermore, each supplementary search report would automatically be communicated to designated and elected Offices whenever the main search report is requested by such Office.

(m) Translations of supplementary international search reports into English would, as for the main international search report, be prepared by the International Bureau where the report was not established in that language.

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

[Annex follows]

ANNEX

DRAFT AMENDMENTS OF THE PCT REGULATIONS:²

SUPPLEMENTARY INTERNATIONAL SEARCHES

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² 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 Supplementary Search Request

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

(b) A request under paragraph (a) (“supplementary search request”) shall be submitted to the International Bureau and shall indicate:

(i) the name and address of the applicant and of the agent (if any), the title of the invention, the international filing date and the international application number;

(ii) the International Searching Authority that is requested to carry out the supplementary international search (“Authority specified for supplementary search”); and

(iii) where the international application was filed in a language which is not accepted by that Authority, whether any translation furnished to the receiving Office under Rule 12.3 or 12.4 is to form the basis of the supplementary international search.

[Rule 45bis.1, continued]

(c) The supplementary search request shall, where applicable, be accompanied by:

(i) where neither the language in which the international application was filed nor that in which a translation (if any) has been furnished under Rule 12.3 or 12.4 is accepted by the Authority specified for supplementary search, a translation of the international application into a language which is accepted by that Authority and is a language of publication;

(ii) a copy of a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions, if required, under the provisions of Rule 13ter.1(a) as applicable by virtue of Rule 45bis.5(c), by the Authority specified for supplementary search.

(d) The supplementary search request may contain an indication of what the applicant would identify as the main invention as referred to in Rule 45bis.6(d) in the event that the Authority specified for supplementary search later makes a finding of lack of unity of invention under Rule 45bis.6(a).

(e) The supplementary search request shall be considered not to have been submitted, and the International Bureau shall so declare:

(i) if it is received after the expiration of the time limit referred to in paragraph (a); or

(ii) if the International Searching Authority requested to carry out the supplementary international search has not stated, in the applicable agreement under Article 16(3)(b), its preparedness to carry out such searches or is not competent to do so under Rule 45bis.9(b).

45bis.2 Supplementary Search Handling Fee

(a) The supplementary search request shall be subject to the payment of a fee for the benefit of the International Bureau (“supplementary search handling fee”) as set out in the Schedule of Fees.

(b) The supplementary search handling fee shall be paid in the currency in which the fee is set in the Schedule of Fees or in any other currency prescribed by the International Bureau. The amount in such other currency shall be the equivalent, in round figures, as established by the International Bureau, of the amount as set in the Schedule of Fees, and shall be published in the Gazette.

(c) The supplementary search handling fee shall be paid to the International Bureau within one month from the date of receipt of the supplementary search request. The amount payable shall be the amount applicable on the date of payment.

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

45bis.3 Supplementary Search Fee

(a) Each International Searching Authority carrying out supplementary international searches may require that the applicant pay a fee (“supplementary search fee”) for its own benefit for carrying out such a search.

(b) The supplementary search fee shall be collected by the International Bureau. Rules 16.1(b) to (e) shall apply *mutatis mutandis*.

(c) As to the time limit for payment of the supplementary search fee and the amount payable, the provisions of Rule 45bis.2(c) shall apply *mutatis mutandis*.

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

(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, after the documents referred to in Rule 45bis.4(d)(i) to (iv) have been transmitted to that Authority, the supplementary search request is considered not to have been submitted.

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

(a) Promptly after receipt of a supplementary search request, the International Bureau shall check whether it complies with the requirements of Rule 45bis.1(b) and (c) and shall invite the applicant to correct any defects within a time limit of one month from the date of the invitation.

(b) Where, by the time they are due under Rules 45bis.2(c) and 45bis.3(c), the International Bureau finds that the supplementary search handling fee and the supplementary search fee have not been paid in full, it shall invite the applicant to pay to it the amount required to cover those fees, together with the late payment fee under paragraph (c), within a time limit of one month from the date of the invitation.

(c) The payment of fees in response to an invitation under paragraph (b) shall be subject to the payment to the International Bureau, for its own benefit, of a late payment fee whose amount shall be 50% of the supplementary search handling fee.

(d) 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.

[Rule 45bis.4, continued]

(e) On finding that the requirements of Rule 45bis.1(b) and (c), 45bis.2(c) and 45bis.3(c) have been complied with, the International Bureau shall promptly, but not before the date of receipt by it of the international search report or the expiration of 17 months from the priority date, whichever occurs first, transmit to the Authority specified for supplementary search a copy of each of the following:

(i) the supplementary search request;

(ii) the international application;

(iii) any sequence listing furnished under Rule 45bis.1(d)(ii); and

(iv) any translation furnished under Rule 12.3, 12.4 or 45bis.1(c)(i) which is to be used as the basis of the supplementary international search;

and, at the same time, or promptly after their later receipt by the International Bureau:

(v) the international search report and the written opinion established under Rule 43bis.1;

(vi) any invitation by the International Searching Authority to pay additional fees referred to in Article 17(3)(a); and

(vii) the decision on any protest by the applicant under Rule 40.2(c).

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

(a) The Authority specified for supplementary search shall start the supplementary international search promptly after receipt of the documents specified in Rule 45bis.4(e)(i) to (iv), provided that the Authority may, at its option, delay the start of the search until it has also received the documents specified in Rule 45bis.4(e)(v) or until the expiration of 22 months from the priority date, whichever occurs first.

(b) 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] [giving full consideration to] 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.

(c) For the purposes of the supplementary international search, Article 17(2) and Rules 13ter.1, 33 and 39 shall apply *mutatis mutandis*.

(d) Where the international search report is available to the Authority specified for supplementary search before it starts the search under paragraph (a), that Authority may exclude from the supplementary search any claims which were not the subject of the international search report.

(e) The supplementary international search shall cover at least the documentation indicated for this purpose in the applicable agreement under Article 16(3)(b).

[Rule 45bis.5, continued]

(f) If the Authority specified for supplementary search finds that carrying out the search is excluded by a limitation or condition referred to in Rule 45bis.9(a), 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.

45bis.6 Unity of Invention

(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 notify the applicant of its opinion and:

(i) specify the reasons for that opinion;

(ii) identify which invention the Authority considers to be the main invention as referred to in Rule 45bis.6(d), having due regard to any indication by the applicant under Rule 45bis.1(d), and giving the applicant an opportunity to identify, within the time limit referred to in paragraph (c), a different invention as the main invention; 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 45bis.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):

(i) identify a different invention as the main invention as referred to in Rule 45bis.6(d);

[Rule 45bis.6(c), continued]

(ii) 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) Subject to any review under paragraph (e) and Rule 45bis.5(d), the Authority shall establish the supplementary international search report on those parts of the international application which relate to the main invention as identified by the applicant or, in the absence of such identification, by the Authority, and shall indicate the relevant facts in the report. In case of doubt as to which invention is the main invention for the purposes of this paragraph, the invention first mentioned in the claims shall be considered the main invention.

(e) 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. Where the Authority:

(i) finds that the opinion was entirely justified, or 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 proceed as provided for in paragraph (c);

(ii) 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.

[Rule 45bis.6, continued]

(f) 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.

45bis.7 Supplementary International Search Report

(a) The Authority specified for supplementary search shall, within 28 months from the priority date, establish the supplementary international search report or make a declaration under the provisions of Article 17(2) and Rule 39 as applicable by virtue of Rule 45bis.5(c) that no supplementary international search report will be established.

(b) For the purposes of establishing the supplementary international search report, Rules 43.1, 43.2, 43.4 to 43.6, 43.8 and 43.10 shall, subject to paragraphs (c) and (d), apply *mutatis mutandis*. Rule 43.9 shall *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*.

(c) The supplementary international search report need not contain the citation of any document cited in the international search report, except where the document needs to be cited in conjunction with other documents that were not cited in the international search report.

(d) The supplementary international search report may contain explanations with regard to the citations of the documents considered to be relevant.

45bis.8 Transmittal and Effect of the Supplementary International Search Report

(a) The Authority specified for supplementary search shall, on the same day, transmit one copy of the supplementary international search report or the declaration that no supplementary international search report shall be established, as applicable, to the International Bureau and one copy to the applicant.

(b) Subject to paragraph (c), Article 20(1) and Rules 45.1, 47.1(d) and 70.7(a) shall apply as if the supplementary international search report were part of the international search report.

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

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

International Search

(a) 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) 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.

(c) The limitations referred to in paragraph (a) may, in particular, include limitations 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 limitations as to the total number of supplementary international searches which will be carried out in a given period.

SCHEDULE OF FEES

Fees	Amounts
1. International filing fee: (Rule 15.2)	1,400 Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets
2. Handling fee: (Rule 57.2)	200 Swiss francs
3. Supplementary search handling fee: (Rule 45bis.2)	200 Swiss francs

Reductions

~~4.3.~~ The international filing fee is reduced by the following amount if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed:

- (a) on paper together with a copy thereof in electronic form: 100 Swiss francs
- (b) in electronic form where the text of the description, claims and abstract is not in character coded format: 200 Swiss francs
- (c) in electronic form where the text of the description, claims and abstract is in character coded format: 300 Swiss francs

~~5.4.~~ The international filing fee (where applicable, as reduced under item ~~4.3~~) and the handling fee are reduced by 75% if the international application is filed by:

- (a) an applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); or
- (b) an applicant, whether a natural person or not, who is a national of and resides in a State that is classed as a least developed country by the United Nations;

provided that, if there are several applicants, each must satisfy the criteria set out in either sub-item (a) or (b).

[End of Annex and of document]

WIPO



PCT/R/WG/9/3

ORIGINAL: English

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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

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

Document prepared by the Secretariat

SUMMARY

1. This document contains proposals for amendment of the PCT Regulations¹ to permit the applicant to request the International Searching Authority to take into account, in carrying out the international search, not only, as at present, the results of an earlier search carried out by that Authority but also the results of an earlier search carried out by another International Searching Authority or any national Office.

¹ 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”, “national Offices”, etc., include reference to regional laws, regional applications, regional Offices, etc.

BACKGROUND

2. At present, Rule 4.11 permits the applicant to request the International Searching Authority to base the international search report wholly or in part on the results of an earlier international or international-type search, or else on a search of another form (usually a national search) which had been carried out by the national Office or intergovernmental organization which is the International Searching Authority competent for the international application concerned, in which case the applicant may be eligible for a reduction in the international search fee under the conditions laid out in Rules 16.3 (earlier international search) and 41.1 (earlier international-type or national search). The making of such a request is provided for in Box No. VII of the Request Form PCT/RO/101 (extract below).

Extract from Form PCT/RO/101 (Request)

Box No. VII INTERNATIONAL SEARCHING AUTHORITY		
<small>Choice of International Searching Authority (ISA) (if two or more International Searching Authorities are competent to carry out the international search, indicate the Authority chosen; the two-letter code may be used):</small>		
ISA /		
<small>Request to use results of earlier search; reference to that search (if an earlier search has been carried out by or requested from the International Searching Authority):</small>		
<small>Date (day/month/year)</small>	<small>Number</small>	<small>Country (or regional Office)</small>

3. In 2005, of the approximately 127,000 international applications that were the subject of international search, more than 50,000 claimed the priority of an earlier application filed with a national Office different from the International Searching Authority that was to undertake the international search. In many of these cases, a national search would be undertaken on the earlier application, and the applicant may even have received the search report before filing the international application. However, at present, the Regulations do not provide for the applicant to request the International Searching Authority to take into account an earlier search performed by an Office other than that which is acting as the International Searching Authority in respect of the international application concerned.

4. As indicated in paragraphs 26 and 27 of document PCT/A/35/5, noted by the PCT Union Assembly at its last session in September/October 2006, it may be desirable to amend the Regulations so as to permit the applicant to request the International Searching Authority to take into account, in carrying out the international search, not only, as at present, the results of an earlier search carried out by the same Office which is acting as the International Searching Authority but also the results of an earlier search carried out by another International Searching Authority or by any national Office.

5. A proposal to amend the Regulations accordingly was discussed at the 14th session of the Meeting of International Authorities Under the PCT (PCT/MIA). The Meeting's discussion of the proposal (see document PCT/MIA/14/8, paragraphs 37 to 41) is outlined in the following paragraphs:

“International Search: Use of Results of Earlier National Search

“37. Discussions were based on document PCT/MIA/14/5.

“38. One Authority opposed the proposal to amend the PCT Regulations to permit applicants to request that the international search report be based on one or more searches performed by an Office other than the International Searching Authority that is to undertake the international search. The Authority noted the lack of a quality control system for search reports established by national Offices other than those which act as International Searching Authorities and, consequential thereto, the difficulties in establishing the appropriate fee reductions to be granted to applicants. It also suggested that, should the proposals proceed, provisions should be included to require the applicant to provide a translation of any earlier search report into a language accepted by the International Searching Authority that is to undertake the international search.

“39. All other Authorities which took the floor on this matter supported the proposal, provided that the proposed amendments to the Regulations to be submitted to the Working Group on Reform of the PCT left it to each Authority to decide, if so requested by the applicant, whether and to which extent to use the results of any earlier search, and whether and to which extent to refund the international search fee to the applicant. The Chair stated that the proposal would distinguish between earlier searches by the same Authority and earlier searches by another Office.

“40. As to the timing of a request by the applicant that the international search be based on the results of an earlier national search, one Authority expressed the view that such request should be made upon filing of the application. As to whether it should be a requirement that such request could be made only in respect of the results of earlier searches on applications the priority of which is claimed in the international application, one Authority expressed the view that it would be sufficient to require that the earlier search was carried out in respect of a “corresponding” application.

“41. The Meeting noted the intention of the Secretariat to post draft proposed amendments of the Regulations relating to the use of the results of earlier national searches on the PCT/MIA electronic forum for comments by Authorities, and to subsequently submit those proposals, taking into account any comments received, to the Working Group on Reform of the PCT for consideration at its ninth session, to be held in April 2007.”

6. As indicated in paragraph 41 of document PCT/MIA/14/8, reproduced in paragraph 5, above, the Secretariat posted draft proposed amendments of the Regulations relating to the use of the results of earlier national searches on the PCT/MIA electronic forum for comments by Authorities. The Annex to the present document contains further revised proposals, taking into account comments received. Explanations are set out in the Annex in comments relating to the provisions concerned.

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

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²INTERNATIONAL SEARCH:
USE OF RESULTS OF EARLIER SEARCH BY OFFICE OTHER THAN OFFICE
ACTING AS INTERNATIONAL SEARCHING AUTHORITY

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² 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 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) [No change]

(b) The request shall, where applicable, contain:

(i) [No change]

(ii) indications as provided in Rules 4.12 and 12bis.1 relating to an ~~a reference to~~
~~any~~ earlier international, international-type or other search,

[COMMENT: It is proposed to amend Rule 4.1(b)(ii) to provide for the inclusion in the request form of indications concerning a request to the International Searching Authority to take into account the results of an earlier search (see Rule 4.12 as proposed to be amended, below) and any request to the receiving Office to obtain a copy of the results of the earlier search and of the earlier application (see proposed new Rule 12bis.1(b), below), and any indication that such copies are available from a digital library (see Rule 12bis.1(d), below).]

(iii) and (iv) [No change]

(c) and (d) [No change]

4.2 to 4.10 [No change]

4.11 Reference to ~~Earlier Search~~, Continuation or Continuation-in-Part, or Parent Application or Grant

(a) If:

~~(i) [Deleted] an international or international-type search has been requested on an application under Article 15(5);~~

~~(ii) [Deleted] the applicant wishes the International Searching Authority to base the international search report wholly or in part on the results of a search, other than an international, or international-type search, made by the national Office or intergovernmental organization which is the International Searching Authority competent for the international application;~~

(i) ~~(iii)~~ the applicant intends to make an indication under Rule 49*bis*.1(a) or (b) of the wish that the international application be treated, in any designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition; or

(ii) ~~(iv)~~ the applicant intends to make an indication under Rule 49*bis*.1(d) of the wish that the international application be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application;

the request shall so indicate and shall, ~~as the case may be, identify the application in respect of which the earlier search was made or otherwise identify the search, or~~ indicate the relevant parent application or parent patent or other parent grant.

[Rule 4.1, continued]

(b) The inclusion in the request of an indication under paragraph (a)(i) or (ii) ~~(a)(iii)~~
~~or (iv)~~ shall have no effect on the operation of Rule 4.9.

[COMMENT: It is proposed to amend Rule 4.11 by deleting all references to earlier searches and to instead deal with the request by the applicant to the International Searching Authority to take into account the results of an earlier search in Rule 4.12 as proposed to be amended (see below).]

4.12 Request to Take Results of Earlier Search into Account ~~{Deleted}~~

The applicant may request 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, in which case 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.

[COMMENT: See the Comment on Rule 4.11 as proposed to be amended, above. Under Rule 4.12 as proposed to be amended, applicants would be permitted to request the International Searching Authority to take into account not only, as at present, the results of an earlier search carried out by the same Office which is acting as the International Searching Authority but also the results of an earlier search carried out by another International Searching Authority or by a national Office.]

4.13 and 4.14 *[Remain deleted]*

4.14*bis* to 4.18 [No change]

Rule 12bis

**Copy of Results of Earlier Search
and of Earlier Application; Translation**

12bis.1 Copy of Results of Earlier Search and of Earlier Application; Translation

(a) Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search, the applicant shall, subject to paragraphs (b) to (d), submit to the receiving Office, together with the international application:

(i) a copy of the results of the earlier search;

(ii) a copy of the earlier application concerned;

[COMMENT: The Working Group may wish to consider whether the applicant should, in all cases, be required to submit a copy of the earlier application, or whether the applicant should be required to submit such copy only upon invitation by the International Searching Authority where that Authority considers such copy necessary to determine the usefulness of the results of the earlier search. The Working Group may also wish to consider whether the applicant should be required to furnish a translation of the earlier application where that application is not in a language accepted by the International Searching Authority.]

(iii) if the language in which the results of the earlier search were established is not accepted by the International Searching Authority, a translation of those results into a language which is accepted by that Authority.

[COMMENT: The Administrative Instructions would have to be modified to require the receiving Office to transmit those copies and any translation to the International Searching Authority together with the search copy.]

[Rule 12bis.1, continued]

(b) Where the earlier search was carried out by the same Office as that which is acting as the receiving Office, the applicant may, instead of submitting the copies referred to in paragraph (a)(i) and (ii), request the receiving Office to prepare and transmit them to the International Searching Authority. Such request shall be made in the request and may be subjected by the receiving Office to the payment of a fee.

[COMMENT: The text of paragraph (b) is modeled in part on Rule 17.1(b).]

(c) Where the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, no copy or translation referred to in paragraph (a) shall be required to be submitted under paragraph (a).

(d) Where a copy or translation referred to in paragraph (a) is, in accordance with the Administrative Instructions, available to the International Searching Authority from a digital library and the applicant so indicates in the request, that copy or translation shall not be required to be submitted under paragraph (a).

[COMMENT: The Administrative Instructions would have to be modified to set out details concerning access to digital libraries.]

Rule 16

The Search Fee

16.1 and 16.2 [No change]

16.3 *Partial Refund*

Where the International Searching Authority takes into account, under Rule 41.1, the results of an earlier search in carrying out the international search, ~~Where the international application claims the priority of an earlier international application which has been the subject of an international search by the same International Searching Authority,~~ that Authority shall refund the search fee paid in connection with the ~~later~~ international application to the extent and under the conditions provided for in the agreement under Article 16(3)(b), ~~if the international search report on the later international application could wholly or partly be based on the results of the international search effected on the earlier international application.~~

[COMMENT: See Rule 41.1 as proposed to be amended, below: on the one hand, where the earlier search has been carried out by the same Office which is acting as the International Searching Authority, the International Searching Authority would be required, as at present, “to the extent possible”, to take the results of that earlier search into account; on the other hand, where the earlier search has been carried out another Office, it would be left to the discretion of the International Searching Authority whether to take into the results of any such earlier search into account. Where the Authority, under Rule 41.1, takes the results of the earlier search into account, the decision whether or not to grant a reduction of the international search fee and, if so, the decision as to the amount of any such reduction, would also be left entirely to the discretion of the International Searching Authority (“... shall, to the extent and under the conditions provided for in the agreement under Article 16(3)(b), refund the search fee ...”).]

Rule 41

Taking into Account of Results of Earlier Search ~~Other than International Search~~

41.1 ~~Obligation to Use~~ Taking into Account of Results of Earlier Search; ~~Refund of Fee~~

Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search and has complied with Rule 12bis.1 and:

(i) the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, the International Searching Authority shall, to the extent possible, take those results into account in carrying out the international search;

(ii) the earlier search was carried out by another International Searching Authority, or by an Office other than that which is acting as the International Searching Authority, the International Searching Authority may take those results into account in carrying out the international search.

~~If reference has been made in the request, in the form provided for in Rule 4.11, to an international-type search carried out under the conditions set out in Article 15(5) or to a search other than an international or international-type search, the International Searching Authority shall, to the extent possible, use the results of the said search in establishing the international search report on the international application. The International Searching Authority shall refund the search fee, to the extent and under the conditions provided for in~~

[Rule 41.1, continued]

~~the agreement under Article 16(3)(b) or in a communication addressed to and published in the Gazette by the International Bureau, if the international search report could wholly or partly be based on the results of the said search.~~

[COMMENT: See the comment on Rule 16.3 as proposed to be amended, above. Under that Rule, it would be left to the discretion of the International Searching Authority whether or not to grant any reduction of the international search fee if it does take an earlier search into account (“... shall, to the extent and under the conditions provided for in the agreement under Article 16(3)(b), refund the search fee ...”).]

[End of Annex and of document]

WIPO



PCT/R/WG/9/4

ORIGINAL: English

DATE: March 7, 2007

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

PUBLICATION OF INTERNATIONAL APPLICATIONS
IN MULTIPLE LANGUAGES

Document prepared by the Secretariat

SUMMARY

1. Following an objection by one delegation, proposals for amendment of the Regulations concerning publication of international applications in multiple languages were not submitted to the PCT Union Assembly in 2006. The Working Group is invited to discuss how it may wish to proceed with regard to those proposals.

BACKGROUND

2. Proposals for amendment of the PCT Regulations concerning publication of international applications in multiple languages (see document PCT/R/WG/8/3) were considered by the Working Group during its eighth session, held in May 2006. Noting the importance of the proposals for Offices and users of the PCT system but also the divergence of opinion among its members as outlined in document PCT/R/WG/8/9, paragraphs 22 to 28, the Working Group (see document PCT/R/WG/8/9, paragraph 29):

E

“(a) approved the proposed amendments of the Regulations set out in the Annex to document PCT/R/WG/8/3, subject to the omission of certain proposed amendments, and to other changes, comments and clarifications, and to possible further drafting changes to be made by the Secretariat (document PCT/R/WG/8/9, paragraphs 29(a) and 32);

“(b) agreed that the proposed amendments should, provided that no delegation sends to the Secretariat a communication expressing the contrary view within two months from the date of adoption of the report of the eighth session of the Working Group, be submitted to the Assembly for consideration at its next session, in September-October 2006;

“(c) agreed to recommend to the Assembly that, in adopting the amendments, it adopt decisions to the following effect concerning entry into force and transitional arrangements:

“(i) any designated Office may, within three months from the adoption of the amendments, notify the International Bureau of the incompatibility of any of the Rules concerned with the national law applied by that Office;

“(ii) the amendments should enter into force allowing a sufficient interval after their adoption to enable convenient implementation, except if there are any notifications referred to in item (i), in which case the amendments should enter into force only after all such notifications have been withdrawn;

“(iii) if the amendments have not entered into force within five years from the date on which they are adopted, the Secretariat should resubmit the matter to the Assembly for review and further consideration.”

3. The Working Group (see document PCT/R/WG/8/9, paragraph 31) also agreed:

“that, if any delegation sends the Secretariat a communication referred to in paragraph 29(b) [of document PCT/R/WG/8/9], above [reproduced in paragraph 1(b), above], the matter should not be submitted to the Assembly in 2006 but rather that revised proposals should be prepared by the Secretariat, subject to further discussion via the PCT reform electronic forum, and submitted to the Working Group for consideration at its next session.”

4. In the event, the Secretariat received such a communication from one delegation. Consequently, the proposed amendments of the Regulations relating to publication of international applications in multiple languages, as referred to in paragraph 2, above, were not submitted to the Assembly in 2006.

RECENT DEVELOPMENTS

5. Following the 2006 session of the PCT Union Assembly, the Secretariat has had informal discussions with certain members of the Working Group with a view to addressing the divergence of opinion outlined in document PCT/R/WG/8/9, paragraphs 22 to 28. To date, however, those discussions have not been fruitful, and it appears that the divergence of opinion continues to exist.

6. *The Working Group is invited to discuss how it may wish to proceed with regard to the proposed amendments of the PCT Regulations relating to publication of international applications in multiple languages.*

WIPO



PCT/R/WG/9/5

ORIGINAL: English

DATE: March 7, 2007

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

DECLARATION OF THE SOURCE OF GENETIC RESOURCES
AND TRADITIONAL KNOWLEDGE IN PATENT APPLICATIONS

Proposals submitted by Switzerland

OVERVIEW

1. Switzerland submitted its proposals regarding the declaration of the source of genetic resources and traditional knowledge in patent applications to the WIPO Working Group on Reform of the Patent Cooperation Treaty (PCT) in May 2003¹.
2. In summary, Switzerland proposes to amend the Regulations under the PCT (PCT Regulations) to explicitly enable the national patent legislation to require the declaration of the source of genetic resources and traditional knowledge in patent applications, if the invention is directly based on such resources or knowledge (see the proposed new Rule 51*bis*.1(g)). Furthermore, Switzerland proposes to afford patent applicants the possibility of satisfying this requirement at the time of filing an international patent application or later during the international phase (see the proposed new Rule 4.17(vi)). Under present Rule 48.2(a)(x), such declaration of the source would be included in the international publication of the international application concerned.

¹ See WIPO document PCT/R/WG/4/13 and, with identical contents, PCT/R/WG/5/11/Rev. (available at <http://www.wipo.int/edocs/mdocs/pct/en/pct_r_wg_5/pct_r_wg_5_11_rev.doc>)

3. In order to advance the discussions on its proposals, Switzerland presented two further submissions to the WIPO Working Group on PCT Reform in April 2004 and April 2005, respectively, containing more detailed explanations on its proposals². These submissions address the use of terms, the concept of the “source” of genetic resources and traditional knowledge, the scope of the obligation to declare this source in patent applications, the possible legal sanctions for failure to declare the source or for wrongful declaration of the source, and its optional *vs.* mandatory introduction at the national level.

4. For information purposes, Switzerland presented its proposals to the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC)³, to the WIPO Ad hoc Intergovernmental Meeting on Genetic Resources and Disclosure Requirements held June 3, 2005⁴, to the WTO TRIPS Council⁵, and to the 3rd and 4th sessions of the Ad Hoc Open-Ended Working Group on Access and Benefit Sharing of the Convention on Biological Diversity (CBD)⁶.

5. The Working Group on Reform of the PCT agreed at its eighth session (May 8 to 12, 2006) to recommend to the Assembly of the International Patent Cooperation Union that one session of the Working Group should be convened between the September 2006 and September 2007 sessions of the Assembly, in order for the Working Group to consider proposals for reform of the PCT, including the declaration of the source of genetic resources and traditional knowledge in patent applications.⁷ The thirty-fifth session of the Assembly of the International Patent Cooperation Union (September 25 to October 3, 2006) “unanimously approved the proposals concerning the work program in connection with reform of the PCT to be undertaken between the September 2006 and September 2007 sessions of the Assembly”⁸.

6. The present document is intended to serve as the basis for the discussions of the ninth session of the Working Group on Reform of the PCT (April 23 to 27, 2007) on the proposals by Switzerland on the declaration of the source. The document summarizes these proposals, and contains in Annex 1 the proposed amendments of the PCT Regulations and in Annex 2 the documents submitted by Switzerland on its proposals.

² See WIPO documents PCT/R/WG/6/11 (available at <http://www.wipo.int/edocs/mdocs/pct/en/pct_r_wg_6/pct_r_wg_6_11.doc>) and PCT/R/WG/7/9 (available at

<http://www.wipo.int/edocs/mdocs/pct/en/pct_r_wg_7/pct_r_wg_7_9.doc>).

³ See WIPO document WIPO/GRTKF/IC/7/INF/5 (available at <www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_7/wipo_grtkf_ic_7_inf_5.pdf>).

⁴ See WIPO document WIPO/IP/GR/05/INF/4 (available at <www.wipo.int/edocs/mdocs/tk/en/wipo_ip_gr_05/wipo_ip_gr_05_inf_4.doc>).

⁵ See WTO documents IP/C/W/400/Rev.1 (available at <www.ige.ch/E/jurinfo/documents/IP-C-W-400.pdf>), IP/C/W/423 (available at <<http://docsonline.wto.org/DDFDocuments/t/IP/C/W423.doc>>), and IP/C/W/433 (available at <www.ige.ch/E/jurinfo/documents/j110114e.pdf>).

⁶ See CBD documents UNEP/CBD/WG-ABS/3/INF/7 (available at <www.biodiv.org/doc/meetings/abs/abswg-03/information/abswg-03-inf-07-en.pdf>), and UNEP/CBD/WG-ABS/4/INF/12 (available at <www.biodiv.org/doc/meetings/abs/abswg-04/information/abswg-04-inf-12-en.doc>).

⁷ See paragraphs 10 to 13, 81 and 90 of document PCT/R/WG/8/9 (available at <www.wipo.int/edocs/mdocs/pct/en/pct_r_wg_8/pct_r_wg_8_9.pdf>).

⁸ See paragraph 6(i) of document PCT/A/35/7 (available at <www.wipo.int/edocs/mdocs/pct/en/pct_a_35/pct_a_35_7.pdf>).

7. The present document has been modified to reflect the mentioned decisions of the eighth session of the Working Group on Reform of the PCT and of the thirty-fifth session of the Assembly of the International Patent Cooperation Union with regard to further work on the declaration of the source of genetic resources and traditional knowledge in patent applications. The contents of the present document are thus largely identical to the contents of document PCT/R/WG/8/7. The proposals by Switzerland themselves have not been changed.

BACKGROUND

8. In the context of access to genetic resources and the related traditional knowledge and the sharing of the commercial and other benefits arising from their use, numerous issues arise. Several international instruments have been concluded to date addressing these issues, including, in particular, the Convention on Biological Diversity (CBD), the Bonn Guidelines, and the International Treaty of the Food and Agriculture Organization (FAO). Moreover, in the context of the CBD, it was decided to elaborate and negotiate an International Regime on Access and Benefit Sharing.

9. In the context of access and benefit sharing, measures under patent law are also being discussed at the international and national level, including in particular requirements for patent applicants to disclose certain information in patent applications. These measures are, among others, seen as increasing transparency in access and benefit sharing, intended to prevent “bad” patents, ensuring the sharing of the benefits arising from the use of genetic resources and the related traditional knowledge, and as allowing the providers of genetic resources and traditional knowledge, in particular developing countries and indigenous and local communities, to more fully benefit from the patent system.

10. Switzerland, not a demandeur with regard to such measures, submitted its proposals on the disclosure of the source to be supportive of the process and because it is interested in a balanced patent protection for biotechnological inventions. The proposed disclosure requirement is intended as a measure under patent law which will increase transparency in access and benefit sharing.

11. In the view of Switzerland, it is crucial to keep in mind that patent-related measures by themselves will not be sufficient to resolve all issues arising in the context of access and benefit sharing. They are only one element, among others, that are to be integrated in a more global approach that would fully address the issues related to access and benefit sharing. Additional measures are to be introduced outside of the patent system in other fields of law. Moreover, it is important to implement the CBD, the Bonn Guidelines and the International Treaty at the national level, and to introduce the necessary administrative procedures relative to access and benefit sharing, and to designate the competent national authorities.

12. In the view of Switzerland, retaining the high quality of patents requires, among others, the observance of the applicable patentability criteria and the proper examination of patent applications. In the past, several cases became public where patents were granted for inventions that were based on or used traditional knowledge and that did not meet the criteria of novelty and/or inventive step. Generally, the granting of such “bad” patents can be explained by the lack of the accessibility of prior art regarding this knowledge by patent authorities. Often, traditional knowledge is only transmitted orally and is therefore not documented in a written form; oral information, however, may not be accessible at all by

these authorities. Or, if it is documented in writing, it may be so in languages that these authorities are not familiar with. Therefore, even if these authorities try their best, they may not be able to access prior art regarding traditional knowledge for reasons beyond their control.

13. One way to substantially improve this situation is the collection of traditional knowledge in databases. Patent authorities could search these databases when dealing with patent applications raising questions regarding traditional knowledge as an element of prior art. Various governments, indigenous and local communities and non-governmental organizations (NGOs) have become active in the establishment of such databases at the local, regional and national levels. The number of such databases can be expected to further increase in the future. These databases are likely to have differing structures and to store traditional knowledge in different forms and formats. Great variability of the structure and contents of these databases, however, will seriously hinder the efficient access of patent authorities to these databases and the effective search for prior art. To avoid these problems, at least a minimum harmonization of the structure and contents of these databases should be achieved. This would also allow to make the local, regional or national databases available through an international gateway for traditional knowledge to be administered by WIPO, as was proposed by Switzerland in the TRIPS Council⁹.

14. Disclosing the source of genetic resources and traditional knowledge in patent applications would assist patent examiners and judges in the establishment of prior art with regard to inventions that somehow relate to these resources or this knowledge. In particular, it may facilitate the establishment of prior public use as well as the finding of lack of novelty or inventive step. This applies in particular to prior art regarding traditional knowledge, as disclosing the source would simplify searching the databases on traditional knowledge.

SUMMARY OF THE PROPOSALS

Policy Objectives

15. In the view of Switzerland, the proposed disclosure of the source allows to achieve four policy objectives: These concern transparency, traceability, technical prior art and mutual trust (in short, “the four T’s”):

(a) *Transparency*: With a requirement in national and international patent applications to disclose the source, the patent system would increase transparency in access and benefit sharing with regard to genetic resources and traditional knowledge.

(b) *Traceability*: Disclosing the source in patent applications would allow the providers of genetic resources and traditional knowledge to keep track of the use of their resources or knowledge in research and development resulting in patentable inventions.

⁹ See documents IP/C/W/284 (available at <www.ige.ch/E/jurinfo/documents/IP_C-W-284.pdf>), paragraphs 16-19, and IP/C/W/400/Rev.1 (available at <www.ige.ch/E/jurinfo/documents/IP-C-W-400.pdf>), paragraphs 30-32.

(c) *Technical prior art*: Disclosing the source of genetic resources and traditional knowledge in patent applications would assist patent examiners and judges in the establishment of prior art with regard to inventions that somehow relate to these resources or this knowledge. This applies in particular to prior art regarding traditional knowledge, as disclosing the source would simplify searching the databases on traditional knowledge that are increasingly being established at the local, regional and national level.

(d) *Mutual Trust*: The disclosure of the source would increase mutual trust among the various stakeholders involved in access and benefit sharing, including among developing and developed countries, indigenous and local communities, private companies and research institutions. All of these stakeholders may be providers and/or users of genetic resources and traditional knowledge. Accordingly, disclosing the source would build mutual trust in the North – South – relationship. Moreover, it would strengthen the mutual supportiveness between the access and benefit sharing system and the patent system.

Amendment of the Patent Cooperation Treaty and the Patent Law Treaty

16. Switzerland proposes to amend the PCT Regulations to explicitly enable the Contracting Parties of the PCT to require patent applicants, upon or after entry of the international application into the national phase of the PCT procedure, to declare the source of genetic resources and/or traditional knowledge, if an invention is directly based on such resource or knowledge. Furthermore, Switzerland proposes to afford applicants the possibility of satisfying this requirement at the time of filing an international patent application or later during the international phase. Under present Rule 48.2(a)(x), such declaration of the source would be included in the international publication of the international application concerned. In case an international patent application does not contain the required declaration, national law may foresee that in the national phase the application is not processed any further until the patent applicant has furnished the required declaration.

17. Based on the reference to the PCT contained in Article 6.1 of WIPO's Patent Law Treaty (PLT), the proposed amendment to the PCT would also apply to the PLT. Accordingly, the Contracting Parties of the PLT would also explicitly be enabled to require in their national patent laws that patent applicants declare the source of genetic resources and/or traditional knowledge in national patent applications.

Use of Terms

18. The Swiss proposals use the terms “genetic resources” and “traditional knowledge related to genetic resources” to ensure consistency with the CBD, the Bonn Guidelines on Access to Genetic Resources and Fair and Equitable Sharing of the Benefits Arising Out of Their Utilization (Bonn Guidelines), and the International Treaty on Plant Genetic Resources for Food and Agriculture (International Treaty) of the Food and Agriculture Organization (FAO). As a measure under patent law, the focus is on traditional knowledge that can give rise to a technical invention.

Concept of the “Source” of Genetic Resources and Traditional Knowledge

19. Switzerland proposes to require patent applicants to declare the “source” of genetic resources and traditional knowledge. The term “source” should be understood in its broadest sense possible. This is because according to the international instrument referred to above, a multitude of entities may be involved in access and benefit sharing.

20. In the foreground to be declared as the source is the entity competent (1) to grant access to genetic resources and/or traditional knowledge or (2) to participate in the sharing of the benefits arising out of their utilization.

21. Depending on the genetic resource or traditional knowledge in question, one can distinguish:

(a) *Primary* sources, including in particular Contracting Parties providing genetic resources¹⁰, the Multilateral System of FAO’s International Treaty¹¹, indigenous and local communities¹²; and

(b) *secondary* sources, including in particular *ex situ* collections and scientific literature.

22. Accordingly, there is a “cascade” of possible primary and secondary sources: Patent applicants must declare the primary source to fulfill the requirement, if they have information about this primary source at hand, whereas a secondary source may only be declared if patent applicants have no information at hand about the primary source. Accordingly, if, for example, the patent applicant knows that the source of a genetic resource is the Contracting Party providing this resource, this Contracting Party must be disclosed as the source; in contrast, if the patent applicant received the genetic resource from a botanical garden, but does not know the Contracting Party providing the genetic resource, the botanical garden must be disclosed as the source.

Scope of the Obligation to Declare the Source

23. With regard to genetic resources, the proposed new Rule 51*bis*.1(g)(i) of the PCT Regulations makes clear that

(a) the invention must make immediate use of the genetic resource, that is, depend on the specific properties of this resource; and

(b) the inventor must have had physical access to this resource, that is, its possession or at least contact which is sufficient enough to identify the properties of the genetic resource relevant for the invention.

¹⁰ See Articles 15, 16 and 19 CBD.

¹¹ See Articles 10-13 FAO International Treaty.

¹² See Article 8(j) CBD.

24. With regard to traditional knowledge, the proposed new Rule 51*bis*.1(g)(ii) of the PCT Regulations makes clear that the inventor must know that the invention is directly based on such knowledge, that is, the inventor must consciously derive the invention from this knowledge.

Optional vs. Mandatory Introduction of the Requirement at the National Level

25. Switzerland proposes to amend the PCT Regulations to explicitly enable the national patent legislation to require the declaration of the source of genetic resources and traditional knowledge in patent applications. The proposals thus leave it up to the national legislator to decide whether such a requirement is to be introduced in the national patent legislation.

26. The optional approach by Switzerland intends to offer four main advantages:

(a) At present, greatly divergent views exist on transparency measures, and the ongoing discussions have not brought any final results. Much faster progress, however, can be expected from an optional approach as is proposed by Switzerland, than can be expected from any mandatory approach.

(b) An optional introduction of the disclosure requirement would enable those States interested in introducing such a requirement to do so. Additionally, it would allow the national governments and the international community to gain experience with the disclosure requirement, without prejudice to further international efforts.

(c) The proposed establishment of the list of competent government agencies described below, and the inclusion of the declaration of the source in the publication of the patent application, would bring almost identical results as a mandatory approach. It is important to note that Switzerland¹³ and most European countries plan to introduce a disclosure requirement in their national patent laws. This would create the critical mass to render the proposed disclosure of the source an effective measure.

(d) The approach proposed by Switzerland would not oblige developing countries, especially the least developed countries, to introduce the disclosure requirement in their national laws. Indeed, these countries might face difficulties with such a requirement, since their authorities are likely to lack the necessary legal and technical capacities to apply such an obligation. Moreover, most biotechnology patents are applied for in developed countries. Introducing such a requirement would thus generally bring little advantages to these countries, but would burden them with an additional international obligation. In contrast, a mandatory approach would oblige all countries to introduce such a requirement in their national patent laws.

¹³ For more information on the draft for a revised Swiss Patent Law with regard to the declaration of the source of genetic resources and traditional knowledge in patent applications, see generally <www.ige.ch/E/jurinfo/j100.shtm> and <www.ige.ch/E/jurinfo/documents/j10017e.pdf> in particular.

27. It is crucial to keep in mind that once the disclosure requirement as proposed by Switzerland is implemented at the national level, it is mandatory for patent applicants to disclose the source in patent applications. Failure to disclose or wrongful disclosure would carry the severe sanctions outlined below. In this regard, the Swiss proposals are of a mandatory and not of a voluntary nature.

Sanctions

28. In the view of Switzerland, the sanctions currently allowed for under the PCT and the PLT should apply to failure to declare the source or wrongful declaration of the source of genetic resources and traditional knowledge in patent applications.

29. Accordingly, if the national law applicable by the designated Office requires the declaration of the source of genetic resources and traditional knowledge, the proposed amended Rule 51bis.3(a) of the PCT Regulations requires the designated Office to invite the applicant, at the beginning of the national phase, to comply with this requirement within a time limit which shall not be less than two months from the date of the invitation. If the patent applicant does not comply with this invitation within the set time limit, the designated Office may refuse the application or consider it withdrawn on the grounds of this non-compliance. If, however, the applicant submitted with the international application or later during the international phase the proposed declaration containing standardized wording relating to the declaration of the source, the designated Office must according to the proposed new Rule 51bis.2(d) accept this declaration and may not require any further document or evidence relating to the source declared, unless it may reasonably doubt the veracity of the declaration concerned.

30. Furthermore, if it is discovered after the granting of a patent that the applicant failed to declare the source or submitted false information, such failure to comply with the requirement may not be a ground for revocation or invalidation of the granted patent, except in the case of fraudulent intention (Article 10 PLT). However, other sanctions provided for in national law, including criminal sanctions such as fines, may be imposed.

Establishment of a List of Government Agencies Competent to Receive Information on Declaration of Source

31. The proposed transparency measure could be further strengthened by establishing a list of government agencies competent to receive information about patent applications containing a declaration of the source of genetic resources and/or traditional knowledge. For easy reference, this list should be made accessible on the Internet. Patent offices receiving patent applications containing such declaration could inform the competent government agency that the respective State is declared as the source. This information could be provided in a standardized letter sent to the competent government agency. Switzerland therefore invited WIPO, in close collaboration with the CBD, to further consider the possible establishment of such a list of competent government agencies.

CONCLUSIONS

32. In the view of Switzerland, the proposed amendments to the PCT present one simple and practical solution to the issues arising in the context of access to genetic resources and traditional knowledge and the fair and equitable sharing of the benefits arising out of their utilization. These amendments could be introduced in a timely manner and would not require extensive changes to the provisions of relevant international agreements.

33. Disclosing the source can be seen as the “entering point” of the access and benefit sharing in the patent system. In this way, disclosing the source would help to build mutual trust in the North – South – relationship. Moreover, it would strengthen the mutual supportiveness between the access and benefit sharing system and the patent system.

34. The proposed declaration of the source of genetic resources and traditional knowledge in patent applications would allow States that are party to a contract on access and benefit sharing to verify whether the other contracting party is complying with its obligations arising under that contract. This transparency measure would not only assist in and simplify the enforcement of these obligations, but would also allow to verify whether prior informed consent (PIC) of the country providing the genetic resources has been obtained and whether provisions have been made for fair and equitable benefit sharing.

35. The proposals made by Switzerland would thus enable the Contracting Parties of relevant international agreements, including the CBD, the International Treaty of FAO, the PCT, the PLT and the TRIPS Agreement, to fulfill their respective obligations. This applies in particular to Articles 8(j), 15.4, 15.5, 15.7 and 16.5 of the CBD. Furthermore, the Swiss proposals would enable the Contracting Parties of the CBD to implement the provisions of the Bonn Guidelines, in particular their paragraph 16(d), as well as several of the decisions adopted by the Conference of the Parties of the CBD. And finally, the possibility to require the declaration of the source would also support the determination of prior art with regard to traditional knowledge, as it would simplify searching the databases on traditional knowledge that are increasingly being established at the local, regional and national level.

36. The Working Group is invited to consider the proposals contained in Annex I.

[Annexes follow]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹DECLARATION OF THE SOURCE OF GENETIC RESOURCES
AND TRADITIONAL KNOWLEDGE IN PATENT APPLICATIONS

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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 4

The Request (Contents)

4.1 to 4.16 [No change]

4.17 *Declarations Relating to National Requirements Referred to in Rule 51bis.1(a)(i) to (v) and Rule 51bis.1(g)*

The request may, for the purposes of the national law applicable in one or more designated States, contain one or more of the following declarations, worded as prescribed by the Administrative Instructions:

(i) to (iv) [No change]

(v) a declaration as to non-prejudicial disclosures or exceptions to lack of novelty, as referred to in Rule 51bis.1(a)(v);

(vi) a declaration as to the source of a specific genetic resource and/or traditional knowledge related to genetic resources, as referred to in Rule 51bis.1(g).

4.18 and 4.19 [No change]

Rule 26ter

Correction or Addition of Declarations under Rule 4.17

26ter.1 Correction or Addition of Declarations

[No change] The applicant may correct or add to the request any declaration referred to in Rule 4.17 by a notice submitted to the International Bureau within a time limit of 16 months from the priority date, provided that any notice which is received by the International Bureau after the expiration of that time limit shall be considered to have been received on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

26ter.2 Processing of Declarations

(a) Where the receiving Office or the International Bureau finds that any declaration referred to in [Rule 4.17\(i\) to \(v\)](#) ~~Rule 4.17~~ is not worded as required or, in the case of the declaration of inventorship referred to in Rule 4.17(iv), is not signed as required, the receiving Office or the International Bureau, as the case may be, may invite the applicant to correct the declaration within a time limit of 16 months from the priority date.

(b) [No change] Where the International Bureau receives any declaration or correction under Rule 26ter.1 after the expiration of the time limit under Rule 26ter.1, the International Bureau shall notify the applicant accordingly and shall proceed as provided for in the Administrative Instructions.

Rule 48

International Publication

48.1 [No change]

48.2 [No change] *Contents*

(a) [No change] The publication of the international application shall contain:

(i) to (ix) [No change]

(x) [No change] any declaration referred to in Rule 4.17, and any correction thereof under Rule 26*ter*.1, which was received by the International Bureau before the expiration of the time limit under Rule 26*ter*.1;

(xi) [No change]

(b) to (k) [No change]

48.3 to 48.6 [No change]

Rule 51bis

Certain National Requirements Allowed Under Article 27

51bis.1 Certain National Requirements Allowed

(a) to (f) [No change]

(g) Subject to Rule 51bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish:

(i) a declaration as to the source of a specific genetic resource to which the inventor has had access, if the invention is directly based on such a resource;

(ii) a declaration as to the source of traditional knowledge related to genetic resources, if the inventor knows that the invention is directly based on such knowledge;

(iii) a declaration that the source referred to in (i) or (ii) is unknown to the inventor or applicant, if this is the case.

51bis.2 Circumstances in Which Documents or Evidence May Not Be Required

(a) to (c) [No change]

(d) Where the applicable national law requires the applicant to furnish a declaration as to the source (Rule 51bis.1(g)), the designated Office shall not, unless it may reasonably doubt the veracity of the declaration concerned, require any document or evidence:

(i) relating to the source of a specific genetic resource (Rule 51bis.1(g)(i) and (iii)) if, in accordance with Rule 4.17(vi), such declaration is contained in the request or is submitted directly to the designated Office;

(ii) relating to the source of traditional knowledge related to genetic resources, (Rule 51bis.1(g)(ii) and (iii)) if, in accordance with Rule 4.17(vi), such declaration is contained in the request or is submitted directly to the designated Office.

51bis.3 Opportunity to Comply with National Requirements

(a) Where any of the requirements referred to in Rule 51bis.1(a)(i) to (iv), ~~and~~ (c) to (e), and (g), or any other requirement of the national law applicable by the designated Office which that Office may apply in accordance with Article 27(1) or (2), is not already fulfilled during the same period within which the requirements under if Article 22 must be complied with, the designated Office shall invite the applicant to comply with the requirement within a time limit which shall not be less than two months from the date of the invitation. Each designated Office may require that the applicant pay a fee for complying with national requirements in response to the invitation.

(b) and (c) [No change]

[Annex II follows]

ANNEX II

DOCUMENTS BY SWITZERLAND ON ITS PROPOSALS

With regard to its proposals, Switzerland submitted the following documents to WIPO:¹

1. English: Proposals by Switzerland Regarding the Declaration of the Source of Genetic Resources and Traditional Knowledge in Patent Applications, WIPO documents PCT/R/WG/4/13 and, with identical contents, PCT/R/WG/5/11 Rev.
<http://www.wipo.int/edocs/mdocs/pct/en/pct_r_wg_5/pct_r_wg_5_11_rev.pdf>

Français: Propositions de la Suisse en ce qui concerne la déclaration de la source des ressources génétiques et des savoirs traditionnels dans les demandes de brevet, OMPI document PCT/R/WG/5/11

<http://www.wipo.int/edocs/mdocs/pct/fr/pct_r_wg_5/pct_r_wg_5_11.pdf>

Español: Propuestas de suiza relativas a la declaración de la fuente de los recursos genéticos y los conocimientos tradicionales en las solicitudes de patentes, anexo al documento OMC IP/C/W/400/Rev.1 (pagina 16ff)

<<http://docsonline.wto.org/DDFDocuments/v/IP/C/W400R1.doc>>

2. English: Additional Comments by Switzerland on Its Proposals Regarding the Declaration of the Source of Genetic Resources and Traditional Knowledge in Patent Applications, WIPO document PCT/R/WG/6/11
<http://www.wipo.int/edocs/mdocs/pct/en/pct_r_wg_6/pct_r_wg_6_11.pdf>

Français: Observations supplémentaires de la Suisse portant sur les propositions concernant la déclaration de la source des ressources génétiques et des savoirs traditionnels dans les demandes de brevet, document OMPI PCT/R/WG/6/11

<http://www.wipo.int/edocs/mdocs/pct/fr/pct_r_wg_6/pct_r_wg_6_11.pdf>

Español: Observaciones adicionales de Suiza sobre sus propuestas presentadas a la OMPI en relación con la declaración de la fuente de los recursos genéticos y los conocimientos tradicionales en las solicitudes de patentes, documento

OMC IP/C/W/423

<<http://docsonline.wto.org/DDFDocuments/v/IP/C/W423.doc>>

¹ Switzerland presented the three submissions on its proposals to the Working Group on PCT Reform. For information purposes, it presented these submissions to the WTO's TRIPS Council and WIPO's IGC. Documents of the Working Group on PCT Reform are available in English and French only, whereas documents of the TRIPS Council are additionally available in Spanish. Accordingly, the list of documents to follow refers to documents of WIPO and the WTO in order to provide access to the submissions in English, French and Spanish. All documents referred to, however, have identical contents.

3. English: Further Observations by Switzerland on Its Proposals Regarding the Declaration of the Source of Genetic Resources and Traditional Knowledge in Patent Applications, WIPO document PCT/R/WG/7/9
<http://www.wipo.int/edocs/mdocs/pct/en/pct_r_wg_7/pct_r_wg_7_9.doc>

Français: Observations supplémentaires de la Suisse portant sur les propositions concernant la déclaration de la source des ressources génétiques et des savoirs traditionnels dans les demandes de brevet, document OMPI PCT/R/WG/7/9
<http://www.wipo.int/edocs/mdocs/pct/fr/pct_r_wg_7/pct_r_wg_7_9.doc>

Español: Nuevas observaciones de Suiza sobre sus propuestas relativas a la declaración de la fuente de los recursos genéticos y los conocimientos tradicionales en las solicitudes de patentes, documento OMC IP/C/W/433
<<http://docsonline.wto.org/DDFDocuments/v/IP/C/W433.doc>>

[End of Annex II and of document]

WIPO



PCT/R/WG/9/6

ORIGINAL: English

DATE: March 7, 2007

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

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

Document prepared by the Secretariat

1. The Annex to this document contains proposals to amend Rules 29.1, 48.2(c) and 90*bis*.1. Explanations are set out in the Annex in Comments relating to the provisions concerned.

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

[Annex follows]

E

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹

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

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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 29**International Applications Considered Withdrawn***29.1 Finding by Receiving Office*

If the receiving Office declares, under Article 14(1)(b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3)(a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1)), or under Rule 12.3(d) or 12.4(d) (failure to furnish a required translation or, where applicable, to pay a late furnishing fee), or under Rule 92.4(g)(i) (failure to furnish the original of a document), that the international application is considered withdrawn:

(i) [No change] the receiving Office shall transmit the record copy (unless already transmitted), and any correction offered by the applicant, to the International Bureau;

(ii) [No change] the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration, and the International Bureau shall in turn notify each designated Office which has already been notified of its designation;

(iii) [No change] the receiving Office shall not transmit the search copy as provided in Rule 23, or, if such copy has already been transmitted, it shall notify the International Searching Authority of the said declaration;

(iv) the International Bureau shall not be required to notify the applicant of the receipt of the record copy;

[Rule 29.1, continued]

(v) no international publication of the international application shall be effected if the notification of the said declaration transmitted by the receiving Office reaches the International Bureau before the technical preparations for international publication have been completed.

[COMMENT: In the past, there have been a substantial number of cases where applicants, rather than expressly withdrawing the international application under Rule 90*bis*.1 prior to publication, relied on Rule 29.1 to have the international application “considered withdrawn” by the receiving Office for failure to pay the required fees, disregarding the substantial risk that, where the declaration by the receiving Office that the application is considered withdrawn reaches the International Bureau only after completion of technical preparations for international publication, the international application will be published, despite the fact that it is considered withdrawn. It is proposed to amend Rule 29.1, along the lines of Rule 90*bis*.1(c) (applicable in the case of an express withdrawal of the international application), to highlight this risk and to remind applicants that international publication can only be reliably prevented by way of an express withdrawal under Rule 90*bis*.1 received by the International Bureau prior to completion of technical preparations for international publication.]

29.2 *[Remains deleted]*

29.3 and 29.4 [No change]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) [No change]

(b) Subject to paragraph (c), the front page shall include:

(i) [No change]

(ii) [No change] a figure or figures where the international application contains drawings, unless Rule 8.2(b) applies;

(iii) [No change] the abstract; if the abstract is both in English and in another language, the English text shall appear first;

(iv) to (viii) [No change]

(c) Where a declaration under Article 17(2)(a) has issued, the front page shall ~~conspicuously~~ refer to that fact and ~~need~~ include any figure or figures suggested by the applicant under Rule 3.3(a)(iii) neither a drawing and, if contained in the international application, the ~~nor an~~ abstract.

[COMMENT: Where the International Searching Authority has declared, under Article 17(2)(a), that no international search report will be established (for one of the reasons outlined in Article 17(2)(a)(i) or (ii)), practice of the International Bureau so far has been, in accordance with present Rule 48.2(c), not to include, on the front page of the published international application, any drawing or the abstract. So as to facilitate access to the technical information contained in such a published international application, it is proposed to change the current practice and to include any figure or figures suggested by the applicant under Rule 3.3(a)(iii) and the abstract (if contained in the international application) on the front page of such international application.]

[Rule 48.2, continued]

(d) to (k) [No change]

48.3 to 48.6 [No change]

Rule 90bis

Withdrawals

90bis.1 Withdrawal of the International Application

(a) [No change] The applicant may withdraw the international application at any time prior to the expiration of 30 months from the priority date.

(b) Withdrawal shall be effective on receipt of a notice addressed by the applicant, ~~at his option,~~ to the International Bureau, ~~to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.~~

(c) No international publication of the international application shall be effected if the notice of withdrawal sent by the applicant ~~or transmitted by the receiving Office or the International Preliminary Examining Authority~~ reaches the International Bureau before the technical preparations for international publication have been completed.

[COMMENT: In the past, there have been a substantial number of cases where applicants, wishing (often at the “last minute”) to withdraw their international application prior to international publication and with the clear intention to prevent publication, relied on Rule 90bis.1(b) and addressed the notice of withdrawal of the international application to the receiving Office (instead of the International Bureau). In such a case, international publication is only prevented if the notice of withdrawal transmitted by the receiving Office to the International Bureau is received by that Bureau before the technical preparations for international publication have been completed (see Rule 90bis.1(c)). If received after completion of those technical preparations, the international application is published by the International Bureau, despite the fact that it has been validly withdrawn by the applicant. In other words, in particular in cases of “last minute” withdrawals, applicants run a considerable risk that such withdrawals addressed to the receiving Office, although effective, will not prevent international publication of the application concerned. Against this background, the Working Group may wish to consider whether Rule 90bis.1 should be amended so as to require the applicant to address a notice of withdrawal of the international application to the International Bureau only and to no longer allow the applicant to address such notice, at the

[Rule 90bis.1, continued]

applicant's option, to the receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority. While such an amendment would most likely not result in all withdrawals of applications being received by the International Bureau in time to prevent international publication, it may increase, over time, the applicants' awareness of the issue and thus result in fewer international applications being published despite the fact that they had been withdrawn by the applicant.]

90bis.2 to 90bis.7 [No change]

[End of Annex and of document]