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Le Bureau international de l'Organisation Mondiale de la Propriété Intellectuelle (OMPI) présente ses compliments et a l'honneur de transmettre ./ ci-joint les documents PCT/R/WG/8/2, 2 Add.1, 3, 4 et 5 (en version anglaise), élaborés en vue de la huitième session du *Groupe de travail sur la réforme du Traité de coopération en matière de brevets (PCT)*, qui se tiendra à Genève du 8 au 12 mai 2006. La version française des documents PCT/R/WG/8/2, 2 Add.1, 3, 4 et 5 suivra.

Les documents de travail sont aussi disponibles sur le site Internet de l'OMPI (voir <http://www.wipo.int/pct/fr/meetings>).

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

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

Eighth Session
Geneva, May 8 to 12, 2006

AMENDMENTS ADOPTED BY THE ASSEMBLY
ON OCTOBER 5, 2005, WITH EFFECT FROM APRIL 1, 2007:
CLARIFICATIONS AND CONSEQUENTIAL AMENDMENTS

Document prepared by the International Bureau

1. The Annex to this document contains proposals to further amend Rules 20.8, 55.2 and 91.3 as adopted by the PCT Assembly on October 5, 2005, and due to enter into force on April 1, 2007 (see document PCT/A/34/6, Annex II). The proposals are in the nature of clarifications and consequential amendments further to the amendments already adopted. 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

AMENDMENTS ADOPTED BY THE ASSEMBLY
ON OCTOBER 5, 2005, WITH EFFECT FROM APRIL 1, 2007:
CLARIFICATIONS AND CONSEQUENTIAL AMENDMENTS

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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 20²

International Filing Date

20.1 to 20.7 [No change]

20.8 *Incompatibility With National Laws*

(a) [No change] If, on October 5, 2005, any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 are not compatible with the national law applied by the receiving Office, the Rules concerned shall not apply to an international application filed with that receiving Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

(a-bis) Where a missing element or part cannot be incorporated by reference in the international application under Rules 4.18 and 20.6 because of the operation of paragraph (a) of this Rule, the receiving Office shall proceed as provided for in Rule 20.3(b)(i), 20.5(b) or 20.5(c), as the case may be.

[COMMENT: It is proposed to add a new paragraph (a-bis) to Rule 20.8 so as to clarify the procedure to be followed by a receiving Office which has notified the International Bureau of the incompatibility of any of the Rules referred to in paragraph (a) with the national law applied by that Office.]

² The proposed amendments are shown relative to the text of Rule 20 as adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

[Rule 20.8, continued]

(b) [No change] If, on October 5, 2005, any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 are not compatible with the national law applied by the designated Office, the Rules concerned shall not apply in respect of that Office in relation to an international application in respect of which the acts referred to in Article 22 have been performed before that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

(c) Where an element or part is considered to have been incorporated by reference in the international application by virtue of a finding of the receiving Office under Rule 20.6(b), but that incorporation by reference does not apply to the international application for the purposes of the procedure before a designated Office because of the operation of paragraph (b) of this Rule, the designated Office shall treat the application as if the international filing date had been accorded under Rule 20.3(b)(i) or 20.5(b), or corrected under Rule 20.5(c), as the case may be, provided that Rule 82ter.1(c) and (d) shall apply *mutatis mutandis*.

[COMMENT: It is proposed to add a new paragraph (c) to Rule 20.8 so as to clarify the procedure to be followed by a designated Office which has notified the International Bureau of the incompatibility of any of the Rules referred to in paragraph (b) with the national law applied by that Office.]

Rule 55³

Languages (International Preliminary Examination)

55.1 [No change]

55.2 *Translation of International Application*

(a) [No change]

(a-*bis*) A translation of the international application into a language referred to in paragraph (a) shall include any element referred to in Article 11(1)(iii)(d) or (e) furnished by the applicant under Rule 20.3(b) or 20.6(a) and any part of the description, claims or drawings furnished by the applicant under Rule 20.5(b) or 20.6(a) which is considered to have been contained in the international application under Rule 20.6(b).

[COMMENT: It is proposed to further amend Rule 55.2(a-*bis*) so as to clarify that the translation furnished by the applicant under Rule 55.2(a) should only include those missing elements or parts furnished by the applicant under Rule 20.3(b) or 20.6(a), or furnished under Rule 20.5(b) or 20.6(a), which, under Rule 20.6(b), are considered to have been contained in the international application on the date on which one or more elements referred to in Article 11(1)(ii) were first received by the receiving Office.]

(b) to (d) [No change]

55.3 [No change]

³ The proposed amendments are shown relative to the text of Rule 55 as adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

Rule 91⁴

**Rectification of Obvious Mistakes in the
International Application and Other Documents**

91.1 and 91.2 [No change]

91.3 *Authorization and Effect of Rectifications*

(a) to (e) [No change]

(f) A designated Office may disregard a rectification that was authorized under Rule 91.1 only if it finds that it would not have authorized the rectification under Rule 91.1 if it had been the competent authority, provided that no designated Office shall disregard any rectification that was authorized under Rule 91.1 without giving the applicant the opportunity to make observations, within a time limit which shall be reasonable under the circumstances, on the Office's intention to disregard the rectification.

[COMMENT: It is proposed to amend paragraph (f) so as to ensure that the applicant has an opportunity to react to the intention of the designated Office to disregard the rectification that was authorized under Rule 91.1. The wording of the proposed amendment is modeled on Rule 26bis.3(g) as adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.]

[End of Annex and of document]

⁴ The proposed amendments are shown relative to the text of Rule 91 as adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

WIPO



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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)

Eighth Session
Geneva, May 8 to 12, 2006

FURTHER CLARIFICATIONS AND CONSEQUENTIAL AMENDMENTS:
AMENDMENT OF RULE 54*bis*.1

Document prepared by the International Bureau

1. On October 5, 2004, with effect from April 1, 2005, the Assembly adopted amendments of Rules 43*bis*.1, 44.1 and 69.1 so as to clarify that a written opinion under Rule 43*bis*.1 is to be established by the International Searching Authority even in the case that no international search report is established in accordance with Article 17(2)(a) (that is, where the International Searching Authority declares that no international search report will be established) (see documents PCT/A/33/2 and 7).
2. It is proposed to make a consequential amendment of Rule 54*bis*.1(a)(i) accordingly.
3. *The Working Group is invited to consider the proposals contained in the Annex.*

[Annex follows]

E

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹

FURTHER CLARIFICATIONS AND CONSEQUENTIAL AMENDMENTS:
AMENDMENT OF RULE 54*bis*.1

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 54bis

Time Limit for Making a Demand

54bis.1 *Time Limit for Making a Demand*

(a) A demand may be made at any time prior to the expiration of whichever of the following periods expires later:

(i) three months from the date of transmittal to the applicant of the international search report [or the declaration referred to in Article 17\(2\)\(a\)](#), and [of](#) the written opinion established under Rule 43bis.1, ~~or of the declaration referred to in Article 17(2)(a)~~; or

(ii) 22 months from the priority date.

[COMMENT: See paragraphs 1 and 2 in the main body of this document.]

(b) [No change]

[End of Annex and of document]

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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Geneva, May 8 to 12, 2006

PUBLICATION OF INTERNATIONAL APPLICATIONS
IN MULTIPLE LANGUAGES

Document prepared by the International Bureau

SUMMARY

1. This document contains further revised proposals for amendment of the Regulations under the PCT¹ to provide for the publication of international applications in multiple languages. Applicants would have the option of submitting translations into languages other than the usual language of publication for publication by the International Bureau. This possibility would be useful for applicants wishing to ensure the prior art effect of their applications and/or to establish a basis for provisional protection in designated States whose national laws provide that such effect or protection is dependent on publication in a particular language.

¹ References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (where applicable, as amended by the Assembly in October 2005 with effect from April 1, 2006 or April 1, 2007, respectively) (“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.

2. Earlier proposals, discussed at the seventh session of the Working Group, have been revised taking into account the discussions, and the agreement reached, at that session. The main differences in comparison with the proposals considered at the seventh session concern the following:

(i) the proposals have been further revised to take account of the amendments of the Regulations adopted by the Assembly in October 2005 with effect from April 1, 2006 and April 1, 2007, respectively, in particular, those relating to missing elements and parts of the international application, and to the rectification of obvious mistakes (see document PCT/A/34/6);

(ii) provisions have been added which would allow Contracting States to opt out, for a limited period, of the system of publication in multiple languages, as further explained in paragraphs 15 and 16, below;

(iii) further proposed language-related amendments of the Regulations are proposed which are not directly related to the proposed amendments concerning international publication in multiple languages but which appear to be necessary even if the latter do not proceed, as further explained in paragraph 17, below.

BACKGROUND

3. During its third session, the Working Group discussed a proposal for deletion of Article 64(4) (allowing for a reservation to be made by certain Contracting States concerning the prior art effect of international applications), based on document PCT/R/WG/3/1, Annex II, item 28. The Working Group agreed that further consideration of this matter should be deferred until progress had been made in discussions of prior art issues by the Standing Committee for the Law of Patents (SCP). As a related matter, the Working Group agreed, however, that the International Bureau should look into the possibility of amending Rule 48 (“International Publication”) so as to provide for the electronic publication by the International Bureau of translations, furnished by the applicant, of the international application (see the summary of the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraphs 78 to 82).

4. For the fourth session of the Working Group, the International Bureau prepared a proposal to amend Rule 48 so as to require the International Bureau, on request by the applicant, to publish, together with the international application, any translation of the international application furnished by the applicant or, where the international application was filed in a language which was not a language of publication, the international application in the language in which it was filed (see Annex III of document PCT/R/WG/4/4). However, having regard to the time available for discussion during the fourth and fifth sessions, discussions on this proposal were deferred until the sixth session of the Working Group.

5. Proposals for amendment of the Regulations concerning the publication of international applications in multiple languages were discussed at the sixth and seventh session of the Working Group. The discussions at the seventh session are outlined in document PCT/R/WG/7/13, paragraphs 108 to 117, reproduced in the following paragraphs:

“PUBLICATION OF INTERNATIONAL APPLICATIONS IN MULTIPLE LANGUAGES

“108. Discussions were based on document PCT/R/WG/7/4.

“General Comments

“109. One delegation noted that the proposed amendments were not compatible with its applicable national law under which, as was permitted by Article 29(2), provisional protection in respect of an international application published in a language different from the language in which publications under its national law were effected was only effective from the date of the publication by its Office of a translation of the international application into its national language of publication. The delegation suggested that international publication of an international application in an additional language, other than the “normal” language of publication, should not have to give rise to the same provisional protection as publication of the application in the “normal” language of publication, and that the proposed draft Regulations be further amended by adding a provision which would expressly allow a designated State to provide in its applicable national law that an international application published in an additional language would enjoy provisional protection in the designated State concerned only after performance of certain acts before the designated Office concerned, such as the furnishing of a (further) translation to the Office, similarly to the provisions of Article 29(2). See also paragraph 114, below, in the particular context of proposed amended Rule 49.2.

“110. One delegation noted that Article 21(4) referred to “the language” (in the singular) of international publication.

“111. The Secretariat explained that, in its view, under the proposed amendments, the publication of the international application in an additional language would constitute an integral part of the international publication of the international application under Article 21 and that, therefore, the effects of that publication would, under the proposals in document PCT/R/WG/7/4, be the same as the effects of international publication in the “normal” language of publication, namely, so far as Article 29(1) was concerned, the same as those which the national law of the designated State provided for the compulsory national publication of unexamined national applications. The Secretariat suggested that revised proposals could include a provision concerning the effects of international publication of an international application in an additional language as outlined in paragraph 109.

“Rule 12.5

“112. A representative of users suggested that the 17-month time limit for requesting publication in an additional language under proposed Rule 12.5(f) should be extended to allow sufficient time for applicants to consider the international search report before deciding whether or not to request international publication of the international application in an additional language.

“Rule 48

“113. In response to a suggestion by one delegation, the Secretariat noted that a revised draft would include a provision to the effect that the front page of the published international application would indicate all languages (the “normal” publication language as well as any other additional language of publication) in which the international application was published under Rule 48.3.

“Rule 49.2

“114. Several delegations opposed the proposed amendment of Rule 49.2(a) under which a designated Office would not be permitted, for the purposes of entry into the national phase under Article 22, to require a translation into an official language of that Office where the international application was published in an additional language under Rule 48.3(b-bis) which was the same as that official language. However, the proposed amendment was supported by several other delegations and representatives of users who considered that furnishing a further translation of the international application in the official language, in addition to the international application having been published in that language under Rule 48.3(b-bis), served no useful purpose and therefore imposed an unnecessary burden on applicants.

“115. A suggestion by a representative of users that designated Offices should not be permitted to require a translation of the request (as provided for in Rules 49.5(a)(i) and 49.2(b) as proposed to be amended) was opposed by one delegation and did not find the support of the Working Group.

“Further Consideration by the Working Group

“116. The Working Group concluded that, in view of the comments and suggestions made, the proposals set out in the Annex to document PCT/R/WG/7/4 should not be submitted to the PCT Assembly in September-October 2005, and invited the Secretariat to prepare revised proposals, for consideration at its next session, taking into account the comments and suggestions set out above.

“117. Several representatives of users expressed their disappointment about the ensuing delay in entry into force of provisions relating to publication of international applications in multiple languages, noting the importance of such provisions for the user community.”

6. The Annex to the present document contains further revised proposals, taking account of the suggestions made by delegations and representatives of users at the seventh session (see document PCT/R/WG/7/13, paragraphs 108 to 117, reproduced in paragraph 5, above). The main features of the proposals as revised are outlined in the following paragraphs.

INTERNATIONAL PUBLICATION IN MULTIPLE LANGUAGES

7. International publication and communication to designated Offices of the international application in more than one language would be beneficial for the establishment or protection of certain rights of the applicant under the national law of designated States. This will be the case, first, in designated States where the prior art effect of an international application is, in accordance with Article 64(4), dependent on the international publication of the international

application in a language accepted by the Office of the designated State concerned. Second, there are designated States where provisional protection of an international application is, in accordance with Article 29, dependent on the publication or availability of the international application in a language in which publications under the national law of the designated State concerned are effected.

8. It is thus proposed to amend the PCT Regulations so as to allow for the international publication of translations of the international application in one or more languages beyond that in which the international publication presently takes place under Rule 48.3(a) or (b).

9. Under the Regulations as proposed to be amended, the applicant may request, within a time limit of 17 months from the priority date, that the international application be published, in addition to the “usual” language in which the international application is published under Rule 48.3(a) or (b), in one or more additional languages, the translations being supplied by the applicant.

10. Where the international application was filed in a language different from the language in which it will be published under Rule 48.3(b) and the applicant requests publication in that language of filing, the international application would be published in both the language of publication referred to in Rule 48.3(b) and in the language in which it was filed. The applicant may also request publication in an additional language which was not the language of filing, in which case the applicant would have to furnish a translation of the international application into the additional language and the international application would then be published in both the language of publication referred to in Rule 48.3(a) or (b) and the additional language.

11. For the purposes of international publication in an additional language, the applicant would have to pay a special fee. The translation into an additional language would have to contain the following elements (unless such element had already been furnished in that language):

(i) the international application itself (that is, the description, including the title of the invention, where applicable, as established by the International Searching Authority under Rule 37; the claim or claims; any text matter in the drawings; and the abstract, where applicable, as established by the International Searching Authority under Rule 38);

(ii) any amendment under Article 19 and any statement filed under Article 19(1);

(iii) any rectification of an obvious mistake referred to in Rule 91.1(b)(ii) or (iii) (that is, any rectification of a mistake in any part of the international application other than the request); and

(iv) any indications in relation to deposited biological material referred to in Rule 13*bis*.4 furnished separately from the description.

12. International publication in the additional language would not take place where the applicant did not, within the applicable time limit, pay the special fee for publication and furnish the required translation(s).

13. As indicated above, in general, the time limit for requesting publication in the additional language, for the payment of the special fee for publication, and for the furnishing of the required translations, would be 17 months from the priority date. It is to be noted, however, that the time limit for making amendments under Article 19 (and for filing the statement under Article 19(1)) may, in certain circumstances, under Rule 46.1, expire after the expiration of that 17-month time limit, and even after international publication of the international application concerned. Furthermore, where the International Searching Authority has established the title and/or the abstract under Rules 37 and 38, respectively, the applicant may need further time to translate those elements into the additional language. It is thus proposed that any translation into the additional language of an amendment under Article 19 or statement under Article 19(1), or of the title and the abstract as established by the International Searching Authority, may be filed within two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority, or 17 months from the priority date, whichever time limit expires later. If such a translation is furnished after completion of technical preparations for international publication of the international application in the additional language but within that time limit, the international application would be republished in the additional language.

14. As mentioned above, the applicant would be allowed to request publication of the international application in any additional language. The International Bureau would not, however, be able to establish, for the purposes of international publication, a standardized front page of the published international application in a language not being one of the languages of publication referred to in Rule 48.3(a). It is thus proposed that, where the additional language is not one of the languages of publication referred to in Rule 48.3(a), the front page relating to such international application would always be published in both English and French. The data contained on the front page is always available at the International Bureau in both those languages, since the Gazette in electronic form, which contains the same data elements as the front page, is published in both English and French. Where the additional language is one of the languages of publication referred to in Rule 48.3(a), the front page relating to such international application would, of course, be published in that language of publication.

15. At present, where the international application is (filed or published) in an official language of the designated Office, that Office is not entitled to require the applicant to furnish to it, upon national phase entry, with a (further) translation, noting that that Office will, upon request, receive a copy of the international application in that official language from the International Bureau under Article 20, Rule 47.3(a) or (b) and Rule 93*bis*. In the context of introducing publication in multiple languages, it is proposed to amend Rule 49.2(a) to provide that the same should apply where the international application is published in an additional language under proposed new Rule 48.3(b-*bis*).

16. However, in order to permit Contracting States which, for a transitional period, wish to maintain existing practices with regard to the furnishing of translations upon national phase entry, it is proposed to provide such States with the possibility to opt out, for a limited period of time (at the most, 5 years from the date of entry into force of amended Rule 49.2), of the system of publication in multiple languages, in which case: (i) such a State could continue to require, upon national phase entry, the furnishing of a translation of the international application even where that application has been published in an additional language which is the same as the, or one of the, official languages of that State; and (ii) an applicant from that

State would not be entitled to request publication of an international application in any additional language and thus would not benefit from the additional features ensuing from such publication, that is, prior art effect of applications and/or provisional protection in designated States whose national laws provide that such effect or protection is dependent on publication of a translation (see proposed new Rules 12.5(a) and (h), and 49.2(c)).

OTHER PROPOSED AMENDMENTS

17. This document also contains certain proposed amendments which are not directly related to the proposed amendments concerning international publication in multiple languages but which would appear necessary even if the latter were not agreed upon. In particular, it is proposed:

(i) to add a new Rule 12.1*ter* to fill a gap in the present Regulations which do not provide for the language in which indications related to deposited biological material furnished under Rule 13*bis*.4 separately from the description are to be filed;

(ii) to amend Rule 12.2(c) to fill a gap by adding a reference to a translation furnished under Rule 12.4;

(iii) to amend Rules 12.2(c) and 55.2 to clarify that the check for, and the correction of, defects under Rule 11 in translations furnished under Rule 55.2(a) for the purposes of international preliminary examination is carried out by the International Preliminary Examining Authority;

(iv) to amend Rule 43.4 so as fill an apparent gap in the present Regulations under which the International Searching Authority may, in certain circumstances, be required to establish the international search report in a language not accepted by that Authority; and

(v) to amend Rule 48.3(c) to clarify that, where the international application is published in a language other than English, the translation required for such international publication shall be prepared under the responsibility of the International Bureau only if it is not furnished by the applicant under Rule 12.3 or proposed new Rule 12.5.

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

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²

PUBLICATION OF INTERNATIONAL APPLICATIONS IN MULTIPLE LANGUAGES

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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.

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Rule 12³

**Language of the International Application
and Translations ~~Translation~~ for the Purposes of International Search
and International Publication**

12.1 *Languages Accepted for the Filing of International Applications*

(a) [No change]

(b) Each receiving Office shall, for the filing of international applications, accept at least one language which is both:

(i) [No change] a language accepted by the International Searching Authority, or, if applicable, by at least one of the International Searching Authorities, competent for the international searching of international applications filed with that receiving Office, and

(ii) a language of publication [referred to in Rule 48.3\(a\)](#).

(c) Notwithstanding paragraph (a), the request shall be filed in any language of publication [referred to in Rule 48.3\(a\)](#) which the receiving Office accepts for the purposes of this paragraph.

(d) [No change]

³ The proposed amendments are shown relative to the text of Rule 12 as adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

[Rule 12.1(d), continued]

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

12.1*bis* [No change]

12.1*ter* Language of Indications Furnished Under Rule 13*bis*.4

Any indication in relation to deposited biological material furnished under Rule 13*bis*.4 shall be in the language in which the international application is filed, provided that, where a translation of the international application is required under Rule 12.3(a) or 12.4(a), any such indication shall be furnished in both the language in which the application is filed and the language of that translation.

[COMMENT: It is proposed to add new Rule 12.1*ter* so as to fill an apparent gap in the present Regulations which do not provide for the language in which indications related to deposited biological material furnished under Rule 13*bis*.4 separately from the description are to be furnished. Note that this proposed amendment is not directly related to the proposed amendments concerning international publication in multiple languages and, if agreed upon, should be presented to the Assembly for adoption even if the proposed amendments concerning international publication in multiple languages are not agreed upon.]

12.2 *Language of Changes in the International Application*

(a) [No change] Any amendment of the international application shall, subject to Rules 46.3, 55.3 and 66.9, be in the language in which the application is filed.

[Rule 12.2, continued]

(b) Any rectification under Rule 91.1 of an obvious mistake in the international application shall be in the language in which the application is filed, provided that:

(i) where a translation of the international application is required under Rule 12.3(a), 12.4(a) or 55.2(a), a rectification ~~rectifications~~ referred to in Rule 91.1(b)(ii) or ~~and~~ (iii) shall be furnished ~~filed~~ in both the language of the application and the language of that translation;

(ii) where a request under Rule 12.5(a) has been made that the international application be published, or where the international application has been published, in an additional language under Rule 48.3(b-bis), a rectification referred to in Rule 91.1(b)(ii) or (iii) shall also be furnished in that additional language, unless already furnished in that additional language under item (i) of this paragraph;

[COMMENT: The proposed addition of item (ii) is consequential on the proposed addition of new Rule 48.3(b-bis) (see below).]

(iii) where a translation of the request is required under Rule 26.3ter(c), a rectification ~~rectifications~~ referred to in Rule 91.1(b)(i) need only be furnished ~~filed~~ in the language of that translation.

[Rule 12.2, continued]

(c) Any correction under Rule 26 of a defect in the international application shall be in the language in which the international application is filed. Any correction under Rule 26 of a defect in a translation of the international application furnished under Rule 12.3 or [12.4](#), [any correction under Rule 12.5\(f\) of a defect in a translation furnished under Rule 12.5\(b\)](#), [any correction under Rule 55.2\(c\) of a defect in a translation furnished under Rule 55.2\(a\)](#), or [any correction of a defect](#) in a translation of the request furnished under Rule 26.3^{ter}(c), shall be in the language of the translation.

[COMMENT: Rule 12.2(c) as worded at present would appear to incorrectly imply that the check for, and correction of, defects under Rule 11 in a translation furnished under Rule 55.2(a) is made “under Rule 26” and thus by the receiving Office rather than by the competent International Preliminary Examining Authority to which such a translation is to be furnished. It is therefore proposed to amend paragraph (c) so as to clarify that a correction of a translation furnished under Rule 55.2(a) is done “under Rule 55.2(c)” and thus by the International Preliminary Examining Authority (see also Rule 55.2 as proposed to be amended, below). Furthermore, it is proposed to amend Rule 12.2(c) by adding a reference to a translation furnished under Rule 12.4, noting that it would appear that the addition of such reference was overlooked when Rule 12.4 was added to the Regulations. Note that these proposed amendments are not directly related to the proposed amendments concerning international publication in multiple languages and, if agreed upon, should be presented to the Assembly for adoption even if the proposed amendments concerning international publication in multiple languages are not agreed upon. It is further proposed to amend paragraph (c) to add a reference to a translation furnished under proposed new Rule 12.5, consequential on the proposed addition of that new Rule.]

12.3 *Translation for the Purposes of International Search*

(a) Where the language in which the international application is filed is not accepted by the International Searching Authority that is to carry out the international search, the applicant shall, within one month from the date of receipt of the international application by the receiving Office, furnish to that Office a translation of the international application into a language which is all of the following:

(i) [No change]

(ii) a language of publication [referred to in Rule 48.3\(a\)](#), and

(iii) a language accepted by the receiving Office under Rule 12.1(a), unless the international application is filed in a language of publication [referred to in Rule 48.3\(a\)](#).

(b) to (e) [No change]

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) and the proposed addition of new Rule 48.3(b-*bis*) (see below).]

12.4 *Translation for the Purposes of International Publication*

(a) Where the language in which the international application is filed is not a language of publication [referred to in Rule 48.3\(a\)](#) and no translation is required under Rule 12.3(a), the applicant shall, within 14 months from the priority date, furnish to the receiving Office a translation of the international application into any language of publication [referred to in Rule 48.3\(a\)](#) which the receiving Office accepts for the purposes of this paragraph.

(b) to (e) [No change]

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) and the proposed addition of new Rule 48.3(b-*bis*) (see below).]

12.5 *Translation for the Purposes of International Publication in Additional Language*

(a) Subject to paragraph (h), the applicant may, within the applicable time limit under paragraph (g), make a request to the International Bureau that the international application be published, in addition to the language in which it is to be published under Rule 48.3(a) or (b), in an additional language under Rule 48.3(b-*bis*). Such requests may be made irrespective of more than one additional language in relation to the same international application.

[COMMENT: See paragraphs 7 to 10 in the main body of this document.]

[Rule 12.5, continued]

(b) A request under paragraph (a) shall be accompanied by a special publication fee, the amount of which shall be fixed in the Administrative Instructions, and by a translation into the additional language of publication of:

(i) the international application, unless it was filed in the additional language or a translation into the additional language has already been furnished under Rule 12.3;

[COMMENT: With regard to the contents of the translation of the international application under paragraph (b)(i), see paragraph (c), below.]

(ii) any amendment under Article 19 and any statement under Article 19(1);

(iii) any rectification of an obvious mistake referred to in Rule 91.1(b)(ii) or (iii), unless such rectification has already been furnished in the additional language under Rule 12.2(b)(i) or (ii);

(iv) any indication in relation to deposited biological material referred to in Rule 13bis.4, unless such indication has already been furnished in the additional language under Rule 12.1bis.

[COMMENT: With regard to the consequences of non-compliance with the requirements of Rule 12.5(a) and (b) (for example, non-payment of fees, missing translations, etc., see Rule 48.3(b-*bis*) and (b-*ter*), below).]

[Rule 12.5(b), continued]

(c) For the purposes of paragraph (b)(i), the translation of the international application shall contain:

(i) the description (other than any sequence listing part of the description), including, where applicable, the title established by the International Searching Authority under Rule 37.2;

[COMMENT: Note that the title prepared by the applicant is part of the description (see Rule 5.1(a)) and would thus be included in the translation of the description into the additional language.]

(ii) the claim or claims;

(iii) any text matter in the drawings;

(iv) any part of the description, claims or drawings which is considered to have been contained in the international application under Rule 20.6(b); and

(v) the abstract as filed by the applicant or, where applicable, as established by the International Searching Authority under Rule 38.2.

[Rule 12.5, continued]

(d) The translation of any text matter in the drawings referred to in paragraph (c)(iii) shall be furnished either in the form of a copy of the original drawing with the translation pasted on the original text matter or in the form of a drawing executed anew.

[COMMENT: Proposed new paragraph (d) is modeled on present Rule 49.5(d).]

(e) Where a request under paragraph (a) is not accompanied by the special publication fee or a translation required under paragraph (b), the International Bureau shall invite the applicant to pay that fee or to furnish that translation, as the case may be, within the applicable time limit under paragraph (g).

[COMMENT: With regard to the consequences where the applicant does not comply with the invitation within the applicable time limit, see Rule 48.3(b-*bis*), below).

(f) The International Bureau shall check any translation furnished in accordance with paragraph (b) for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication, and shall invite the applicant to correct any defect within the time limit under paragraph (g).

[COMMENT: With regard to the consequences where the applicant does not comply with the invitation within the applicable time limit, see Rule 48.3(b-*bis*), below).]

[Rule 12.5, continued]

(g) The time limit referred to in paragraphs (a), (e) and (f) shall be 17 months from the priority date, provided that:

[COMMENT: In general, it is proposed that any request for the publication of the international application in an additional language (see proposed new Rule 12.5, above) and any translation into such a language would have to be furnished within 17 months from the priority date, noting that sufficient time is needed by the International Bureau in order to prepare international publication in the additional language. It is not proposed, as had been suggested by a representative of users at the seventh session (see the summary of the seventh session by the Chair, document PCT/R/WG/7/13, paragraph 112), to provide for an even longer time limit than 17 months from the priority date for the furnishing of the translation, noting that, in order to have the intended effects concerning prior art and provisional protection, publication of the international application in the additional language has to be part of the “international publication” under Article 21 and thus has to take place promptly after the expiration of 18 months from the priority date.]

(i) the time limit referred to in paragraph (e) for the furnishing of a translation of the title or the abstract established by the International Searching Authority under Rule 37.2 and 38.2, respectively, as required under paragraphs (b)(i) and (c), or of an amendment under Article 19 and a statement under Article 19(1) as required under paragraph (b)(ii), and the time limit referred to in paragraph (f) for the furnishing of any correction of such translation, shall be two months from the date of transmittal of the international search report to the International Bureau and the applicant by the International Searching Authority or 17 months from the priority date, whichever time limit expires later;

[COMMENT: See paragraph 13 in the main body of this document.]

[Rule 12.5(g), continued]

(ii) any translation of a rectification of an obvious mistake required under paragraph (b)(iii), and any correction of such translation referred to in paragraph (f), furnished after the expiration of 17 months from the priority date shall be considered to have been received on the last day of that time limit if it reaches the International Bureau before the technical preparations for international publication have been completed;

[COMMENT: As regards the translation of any rectification of an obvious mistake, it is proposed to, in effect, extend the 17-month time limit up to the point of completion of technical preparations for international publication, noting that, under Rule 91 as adopted by the Assembly on October 5, 2005, with effect from April 1, 2007, the applicant may request rectification of an obvious mistake until the expiration of 26 months from the priority date, that is, beyond the 17-month time limit for requesting publication in an additional language. Where the application is to be or has been published in an additional language under Rule 48.3(b-*bis*) and a request for rectification of an obvious mistake is received only after completion of technical preparations for international publication, the statement reflecting all rectifications, together with the sheets containing the rectifications, or the replacement sheets and the letter furnished under Rule 91.2, as the case may be, to be published under Rule 48.2(i) would be published in both the language of the application and the additional language (see Rule 48.2(i) as proposed to be amended, below).]

(iii) where the applicant makes a request for early publication under Article 21(2)(b), any request under paragraph (a), any translation under paragraph (b) or any correction under paragraph (f) submitted, or any fee under paragraph (b) paid, after the technical preparations for international publication have been completed shall be considered as not having been submitted or paid in time.

[Rule 12.5(g)(iii), continued]

[COMMENT: Where the applicant has requested early publication of the international application, all acts required for the international publication of the international application in the additional language must have been performed by the applicant before the completion of technical preparations for international publication; otherwise, the international application will not be published in the additional language.]

(h) Where a designated Office has sent a notification to the International Bureau under Rule 49.2(c), an applicant who is a resident or national of the Contracting State for which that Office acts shall not be entitled, for as long as that notification is still in force, if the international application was filed in an official language of that designated Office either with the receiving Office of or acting for that Contracting State or with the International Bureau as receiving Office, to make a request under paragraph (a) that the international application be published in an additional language under Rule 48.3(b-bis). If there are two or more applicants, the first sentence of this paragraph shall apply if any of them is a resident or national of that Contracting State.

[COMMENT: See paragraphs 15 and 16 in the main body of this document.]

Rule 26⁴

**Checking by, and Correcting Before, the Receiving Office
of Certain Elements of the International Application**

26.1 to 26.2*bis* [No change]

26.3 *Checking of Physical Requirements Under Article 14(1)(a)(v)*

(a) Where the international application is filed in a language of publication [referred to in Rule 48.3\(a\)](#), the receiving Office shall check:

(i) and (ii) [No change]

(b) Where the international application is filed in a language which is not a language of publication [referred to in Rule 48.3\(a\)](#), the receiving Office shall check:

(i) and (ii) [No change]

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

26.3*bis* [No change]

⁴ The proposed amendments are shown relative to the text of Rule 26 as adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

26.3ter *Invitation to Correct Defects Under Article 3(4)(i)*

(a) Where the abstract or any text matter of the drawings is filed in a language which is different from the language of the description and the claims, the receiving Office shall, unless

(i) [No change]

(ii) the abstract or the text matter of the drawings is in the language in which the international application is to be published [under Rule 48.3\(a\) or \(b\)](#),

invite the applicant to furnish a translation of the abstract or the text matter of the drawings into the language in which the international application is to be published [under Rule 48.3\(a\) or \(b\)](#). Rules 26.1, 26.2, 26.3, 26.3bis, 26.5 and 29.1 shall apply *mutatis mutandis*.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

(b) and (c) [No change]

26.4 and 26.5 [No change]

Rule 37

Missing or Defective Title

37.1 [No change]

37.2 *Establishment of Title*

If the international application does not contain a title and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish a title, or if the said Authority finds that the title does not comply with Rule 4.3, it shall itself establish a title. Such title shall be established in the language in which the international application is to be published [under Rule 48.3\(a\) or \(b\)](#), or, if a translation into another language was transmitted under Rule 23.1(b) and the International Searching Authority so wishes, in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

Rule 38⁵

Missing or Defective Abstract

38.1 [No change]

38.2 *Establishment of Abstract*

If the international application does not contain an abstract and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish an abstract, or if the said Authority finds that the abstract does not comply with Rule 8, it shall itself establish an abstract. Such abstract shall be established in the language in which the international application is to be published [under Rule 48.3\(a\) or \(b\)](#) or, if a translation into another language was transmitted under Rule 23.1(b) and the International Searching Authority so wishes, in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

38.3 [No change]

⁵ The proposed amendments are shown relative to the text of Rule 38 as adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

Rule 43⁶

The International Search Report

43.1 to 43.3 [No change]

43.4 *Language*

Every international search report and any declaration made under Article 17(2)(a) shall be in the language in which the international application to which it relates is to be published under Rule 48.3(a) or (b), provided that: ~~or~~,

(i) if a translation of the international application into another language was transmitted under Rule 23.1(b) and the International Searching Authority so wishes, the international search report and any declaration made under Article 17(2)(a) may be in the language of that translation;

(ii) if the international application is to be published in the language of a translation furnished under Rule 12.4 which is not accepted by the International Searching Authority and that Authority so wishes, the international search report and any declaration made under Article 17(2)(a) may be in a language which is both a language accepted by that Authority and a language of publication referred to in Rule 48.3(a).

⁶ The proposed amendments are shown relative to the text of Rule 43 as adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

[Rule 43.4, continued]

[COMMENT: It is proposed to amend Rule 43.4 so as fill an apparent gap in the present Regulations under which the International Searching Authority may, in certain circumstances, be required to establish the international search report in a language not accepted by that Authority: under present Rule 43.4, where the Authority conducts the search on the basis of the international application in the language as filed which is not a language of publication and the applicant furnishes, for the purposes of international publication, a translation of the application into a language of publication which is not, however, accepted by that Authority, the Authority is nevertheless required to establish the international search report in that language. It is thus proposed to amend Rule 43.4 to permit the International Searching Authority to establish the international search report in a language which is both accepted by that Authority and a language of publication referred to in Rule 48.3(a). Other proposed amendments are consequential on the proposed amendments of Rule 48.3(a) and (b) (see below).]

43.5 to 43.10 [No change]

Rule 46

Amendment of Claims Before the International Bureau

46.1 and 46.2 [No change]

46.3 *Language of Amendments*

~~Any~~ ~~If the international application has been filed in a language other than the language in which it is published, any~~ amendment made under Article 19 shall be in the language in which the international application is published under Rule 48.3(a) or (b) of publication.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

46.4 *Statement*

(a) The statement referred to in Article 19(1) shall be in the language in which the international application is published under Rule 48.3(a) or (b). ~~The statement and~~ shall not exceed 500 words if in the English language or if translated into that language and. ~~The statement~~ shall be identified as such by a heading, preferably by using the words “Statement under Article 19(1)” or their equivalent in the language of the statement.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see below).]

(b) [No change]

46.5 [No change]

Rule 47⁷

Communication to Designated Offices

47.1 and 47.2 [No change]

47.3 *Languages*

(a) The international application communicated under Article 20 shall be in the language in which it is published under Rule 48.3(a) or (b) and, where applicable, in each additional language in which it is published under Rule 48.3(b-bis).

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) and the proposed addition of new Rule 48.3(b-bis) (see below). Note that, in accordance with Rule 93bis.1 (“communication on request”), the communication of any document by the International Bureau to a designated Office will only be effected on request by that Office, so that any designated Office would be free to waive the receipt of the published international application under Article 20 altogether, or to request to receive the published international application in all publication languages, or to specify the publication languages in which it wishes to receive the published international application.]

(b) Where the ~~language in which the~~ international application is not published under Rule 48.3(a) or (b-bis) in ~~is different from~~ the language in which it was filed, the International Bureau shall furnish to any designated Office, ~~upon the request of that Office,~~ a copy of that application in the language in which it was filed.

[COMMENT: Rule 48.3(b) is not referred to since, under that Rule, an international application is always published in a language of a translation furnished under Rule 12.3 or 12.4 which is different from the language in which the application was filed.]

⁷ The proposed amendments are shown relative to the text of Rule 47 as adopted by the Assembly on October 5, 2005, with effect from April 1, 2006.

[Rule 47.3(b), continued]

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) and the proposed addition of new Rule 48.3(b-*bis*) (see below) and, as far as the proposed deletion of the text “upon request of that Office” is concerned, on the entry into force, with effect from January 1, 2004, of Rule 93*bis*.1 (“communication on request”), pursuant to which the communication of any document by the International Bureau to a designated Office will only be effected on request by that Office.]

47.4 [No change]

Rule 48⁸

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] data taken from the request sheet and such other data as are prescribed by the Administrative Instructions;

[COMMENT: The Administrative Instructions would have to be modified to provide that the front page shall include information as to the language or languages in which the international application is published under Rule 48.3(a) or (b) and, where applicable, Rule 48.3(b-*bis*).]

(ii) to (viii) [No change]

(c) to (h) [No change]

⁸ The proposed amendments are shown relative to the text of Rule 48 as adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

[Rule 48.2, continued]

(i) If the authorization of a rectification of an obvious mistake in the international application referred to in Rule 91.1 is received by or, where applicable, given by the International Bureau after completion of the technical preparations for international publication, a statement reflecting all the rectifications shall be published, together with the sheets containing the rectifications, or the replacement sheets and the letter furnished under Rule 91.2, as the case may be, and the front page shall be republished. Where the international application is to be or has been published in an additional language under Rule 48.3(b-bis), the said statement and sheets, or the said replacement sheets and letter, shall also be published in that additional language.

[COMMENT: The proposed amendments are consequential on the proposed addition of new Rule 48.3(b-bis).]

(j) and (k) [No change]

(l) Where the international application is published in an additional language under Rule 48.3(b-bis), the published international application shall include:

(i) if the additional language is one of the languages referred to in Rule 48.3(a), the front page referred to in paragraph (a)(i) in that additional language;

[COMMENT: Where the additional language is one of the languages referred to in Rule 48.3(a), the front page would include the abstract.]

[Rule 48.2(l), continued]

(ii) if the additional language is not one of the languages referred to in Rule 48.3(a), the front page referred to in paragraph (a)(i) in English and in French, and the abstract, as referred to in Rule 12.5(c)(v), in the additional language;

[COMMENT: Where the additional language is not one of the languages referred to in Rule 48.3(a), the front page, including the abstract, would be published in English and French. Furthermore, the publication of the international application would contain the abstract in the additional language.]

(iii) the description (other than any sequence listing part of the description), the claims, the drawings (if any), the request referred to in paragraph (a)(vi) of this Rule and the data referred to in paragraph (a)(viii) of this Rule, in the additional language;

(iv) if available at the time of the completion of the technical preparations for international publication, the claims and the statement referred to in paragraph (f) of this Rule, in the additional language.

[Rule 48.2, continued]

(m) Where the international application is published in an additional language under Rule 48.3(b-bis) and, at the time of the completion of the technical preparations for international publication, the time limit under Rule 12.5(g) for the furnishing of a translation of the title or the abstract established by the International Searching Authority, of a translation of an amendment under Article 19 and of a statement under Article 19(1), or of any correction of such translation under Rule 12.5(f), has not expired, the front page shall refer to that fact and indicate that, promptly after receipt by the International Bureau of any such translation within the time limit under Rule 12.5(g), any such translation will be published together with a revised front page.

[COMMENT: See paragraph 13 in the main body of this document.]

48.3 *Languages of Publication*

(a) If the international application is filed in Arabic, Chinese, English, French, German, Japanese, Russian or Spanish (“languages of publication”), that application shall be published in the language in which it was filed.

(b) If the international application is not filed in a language of publication referred to in paragraph (a) and a translation into a language of publication has been furnished under Rule 12.3 or 12.4, that application shall be published in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed addition of new Rule 48.3(b-bis) (see below).]

[Rule 48.3, continued]

(b-bis) Where the applicant makes a request in accordance with Rule 12.5 for publication of the international application in an additional language, the international application shall be published in that language (“additional language of publication”) in addition to the language in which the international application is published under paragraph (a) or (b).

[COMMENT: Where the applicant has made a request for the publication of the application in an additional language but has not met all the requirements of Rule 12.5 (for example, the special fee has not been paid in full, or required elements are missing from the translation, or the translation does not comply with the physical requirements referred to in Rule 11 to the extent necessary for the purpose of reasonably uniform publication), the international application would not be published in the additional language.]

(c) If the international application is published under paragraph (a) or (b) in a language other than English, the international search report to the extent that it is published under Rule 48.2(a)(v), or the declaration referred to in Article 17(2)(a), the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations, if not furnished by the applicant under Rule 12.3 or 12.5, shall be prepared under the responsibility of the International Bureau.

[COMMENT: The proposed amendments of the first sentence of paragraph (c) are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above). The proposed addition of a reference to Rule 12.3 in the last sentence of paragraph (c) would fill an apparent gap in the present text of paragraph (c); note that this addition is not directly related to the proposed amendments concerning international publication in multiple languages and, if agreed upon, should be presented to the Assembly for adoption even if the proposed amendments concerning international publication in multiple languages are not agreed upon. Otherwise, the proposed amendment of the last sentence is consequential on the proposed addition of Rule 12.5.]

48.4 to 48.6 [No change]

Rule 49

Copy, Translation and Fee Under Article 22

49.1 [No change]

49.2 *Languages*

(a) The language into which translation may be required must be an official language of the designated Office, ~~;~~ provided that no translation may be required:

(i) if the international application was filed in such a language or, if ~~if~~ there are several ~~of~~ such languages, ~~no translation may be required if the international application is~~ in one of them; ~~or~~

(ii) if the international application was published under Rule 48.3(a) or (b) in such a language or, if there are several such languages, in one of them;

(iii) if the international application was published under Rule 48.3(b-bis) in such a language or, if there are several such languages, in one of them.

If there are several official languages and a translation must be furnished, the applicant may choose any of those languages.

[Rule 49.2(a), continued]

[COMMENT: See paragraph 15 in the main body of this document.]

(b) Notwithstanding ~~the foregoing provisions of this~~ paragraph (a);

(i) if there are several official languages but the national law prescribes the use of one such language for foreigners, a translation into that language may be required;

(ii) if no translation of the international application may be required under paragraph (a), the designated Office may nevertheless require a translation of the request as referred to in Rule 49.5(a)(i), in which case Rule 49.5(b) shall apply *mutatis mutandis*.

[COMMENT: The proposed addition of new item (ii) is consequential on the proposed amendment of paragraph (a) (see above): where no translation of the international application may be required by a designated Office under paragraph (a), that Office should still be entitled to request the furnishing of a translation of the request (see Rule 49.5(a)(i)), noting that a copy of the request would not be included in the copy of the international application communicated to the designated Office (in the official language of the designated Office) under Article 20, Rule 47.3(a) or (b), and Rule 93*bis*. Rule 49.5(b), which is referred to in proposed new item (ii) of paragraph (b), deals with details concerning the furnishing of a translation of the request.]

[Rule 49.2, continued]

(c) Paragraph (a)(iii) shall not apply in respect of the processing by a designated Office of international applications whose international filing date falls in the relevant period where that Office has, in a notification sent to the International Bureau by *[three months from the date of adoption of these modifications by the PCT Assembly]*, declared that that paragraph shall not be applicable. The relevant period shall start on *[date of entry into force of paragraph (c)]* and end on *[five years after that date]* or on such earlier date as may be specified by the designated Office in that notification or in a subsequent notification sent to the International Bureau. The International Bureau shall promptly publish in the Gazette information on any notification sent to it under this paragraph.

[COMMENT: See paragraph 16 in the main body of this document and Rule 12.5(a) and (h), above.]

49.3 to 49.6 [No change]

Rule 55⁹

Languages (International Preliminary Examination)

55.1 *Language of Demand*

The demand shall be in the language in which the international application is published under Rule 48.3(a) or (b) ~~of the international application or, if the international application has been filed in a language other than the language in which it is published, in the language of publication~~. However, if a translation of the international application is required under Rule 55.2, the demand shall be in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above).]

55.2 *Translation of International Application*

(a) Where ~~neither the language in which~~ the international application is neither filed nor ~~the language in which the international application is~~ published under Rule 48.3(a), (b) or (b-bis) in a language ~~is~~ accepted by the International Preliminary Examining Authority that is to carry out the international preliminary examination, the applicant shall, subject to paragraph (b), furnish with the demand a translation of the international application into a language which is both:

⁹ The proposed amendments are shown relative to the text of Rule 55 as adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

[Rule 55.2(a), continued]

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) and the proposed addition of new Rule 48.3(b-*bis*) (see above).]

- (i) [No change] a language accepted by that Authority, and
- (ii) a language of publication [referred to in Rule 48.3\(a\)](#).

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above).]

(a-*bis*) A translation of the international application into a language referred to in paragraph (a) shall include any element referred to in Article 11(1)(iii)(d) or (e) furnished by the applicant under Rule 20.3(b) or 20.6(a) and any part of the description, claims or drawings furnished by the applicant under Rule 20.5(b) or 20.6(a) [which is considered to have been contained in the international application under Rule 20.6\(b\)](#).

[COMMENT: The proposed amendment of Rule 55.2(a-*bis*) as adopted by the Assembly in October 2005 with effect from April 1, 2007, is as proposed in document PCT/R/WG/8/XX (clarifications and consequential amendments).]

[\(a-*ter*\) The International Preliminary Examining Authority shall check any translation furnished under paragraph \(a\) for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purposes of the international preliminary examination.](#)

[Rule 55.2(a-ter), continued]

[COMMENT: See Rule 12.2(c) as proposed to be amended, above. It is proposed to add a new paragraph (a-ter) to Rule 55.2 so as to expressly provide for the International Preliminary Examining Authority to carry out the Rule 11 check but only to the extent that compliance with Rule 11 is necessary for the purposes of international preliminary examination. Furthermore, it is proposed to amend paragraph (c) (see below) so as to expressly provide for that Authority to invite the applicant to correct any defect. Note that the proposed addition of new paragraph (a-bis) and the proposed amendments to paragraph (c) are not directly related to the proposed amendments concerning international publication in multiple languages and, if agreed upon, should be presented to the Assembly for adoption even if the proposed amendments concerning international publication in multiple languages are not agreed upon.]

(b) [No change]

(c) If a requirement ~~the requirements~~ referred to in ~~of~~ paragraphs (a), ~~and~~ (a-bis) and (a-ter) is ~~are~~ not complied with and paragraph (b) does not apply, the International Preliminary Examining Authority shall invite the applicant to furnish the required translation or the required correction, as the case may be, within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

[COMMENT: See comment on proposed new paragraph (a-ter), above.]

(d) If the applicant complies with the invitation within the time limit under paragraph (c), the said requirement ~~requirements~~ shall be considered to have been complied with. If the applicant fails to do so, the demand shall be considered not to have been submitted and the International Preliminary Examining Authority shall so declare.

[Rule 55.2(d), continued]

[COMMENT: The proposed amendment of paragraph (d) is consequential on the proposed amendment of paragraph (c).]

55.3 [No change]

Rule 66¹⁰

**Procedure Before the
International Preliminary Examining Authority**

66.1 to 66.8 [No change]

66.9 *Language of Amendments*

(a) Subject to paragraphs (b) and (c), ~~if the international application has been filed in a language other than the language in which it is published,~~ any amendment, as well as any letter referred to in Rule 66.8, shall be submitted in the language in which the international application is published under Rule 48.3(a) or (b) of publication.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above).]

(b) to (d) [No change]

¹⁰ The proposed amendments are shown relative to the text of Rule 66 as adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

Rule 70¹¹

**International Preliminary Report on Patentability by
the International Preliminary Examining Authority
(International Preliminary Examination Report)**

70.1 to 70.16 [No change]

70.17 *Languages of the Report and the Annexes*

The report and any annex shall be in the language in which the international application to which they relate is published [under Rule 48.3\(a\) or \(b\)](#), or, if the international preliminary examination is carried out, pursuant to Rule 55.2, on the basis of a translation of the international application, in the language of that translation.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above).]

¹¹ The proposed amendments are shown relative to the text of Rule 70 as adopted by the Assembly on October 5, 2005, with effect from April 1, 2007.

Rule 74

**Translations of Annexes of the International
Preliminary Examination Report and Transmittal Thereof**

74.1 *Contents of Translation and Time Limit for Transmittal Thereof*

(a) [No change]

(b) Where the furnishing under Article 39(1) of a translation of the international application is not required by the elected Office, that Office may require the applicant to furnish, within the time limit applicable under that Article, a translation into the language in which the international application was published [under Rule 48.3\(a\) or \(b\)](#) of any replacement sheet referred to in Rule 70.16 which is annexed to the international preliminary examination report and is not in that language.

[COMMENT: The proposed amendments are consequential on the proposed amendment of Rule 48.3(a) and (b) (see above).]

Rule 76

Translation of Priority Document;

Application of Certain Rules to Procedures before Elected Offices

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 [No change]

76.5 *Application of Certain Rules to Procedures before Elected Offices*

Rules [12.5\(h\)](#), 13^{ter}.3, 22.1(g), 47.1, 49, 49^{bis} and 51^{bis} shall apply, provided that:

[COMMENT: By virtue of Rule 76.5 as proposed to be amended, proposed new Rule 12.5(h) (see above) would also apply to elected Offices.]

(i) [No change] any reference in the said Rules to the designated Office or to the designated State shall be construed as a reference to the elected Office or to the elected State, respectively;

(ii) to (v) [No change]

[End of Annex and of document]

WIPO



PCT/R/WG/8/4

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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)

Eighth Session
Geneva, May 8 to 12, 2006

SUPPLEMENTARY INTERNATIONAL SEARCHES

Document prepared by the International Bureau

SUMMARY

1. Two alternative proposals are presented for a system of supplementary searches within the PCT by International Authorities in addition to the one carrying out the main search. In the alternative in Annex I (“Alternative I”), supplementary searches are provided only after the main search has been carried out (“sequential supplementary search”) and take the results of that search into account in determining the scope of the supplementary search. In the alternative in Annex II (“Alternative II”), Authorities may offer sequential supplementary searches in a similar way, or alternatively carry out supplementary searches at the same time as the main search (“concurrent supplementary search”).
2. The main features of the proposals are set out in paragraphs 4 to 8. The background and reasoning behind the proposals are explained in greater detail in paragraphs 9 to 45.

TERMINOLOGY

3. In this document, the following abbreviated expressions are used to describe different search services and roles:

main search: the international search conducted on an international application under Article 15;

main Authority: the International Searching Authority which conducts the main search;

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

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

PROPOSALS

4. Annexes I and II contain alternative sets of draft amendments to the PCT Regulations allowing for a system of supplementary international searches. As noted above, Alternative I provides for a system of sequential searches; Alternative II provides for either concurrent or sequential searches, at the choice of the applicant to the extent that a particular Authority might offer a choice.

5. Each alternative includes the following common main features:

(a) Authorities are free to decide whether to provide a supplementary search service and, if so, under what conditions.

(b) Applicants are 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.

(c) A supplementary search fee (for the benefit of the Authority) and supplementary search handling fee (for the benefit of the International Bureau) must be paid within one month from the date on which the request is submitted.

(d) The International Bureau sends a copy of the international application and any other required documents to each Authority which is to conduct a supplementary search.

(e) Each supplementary Authority issues a supplementary search report. No written opinion is established under the supplementary search system, but the indications of relevant passages in the search report should be sufficient to make clear the relevance of the citation, bearing in mind that many citations will be in languages not well understood by the applicant or the Authority likely to act as International Preliminary Examining Authority if a demand is submitted.

(f) Supplementary search reports established during the Chapter I procedure are 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 the main international search report.

However, supplementary searches performed during international preliminary examination, would be reported only as part of the written opinions and international preliminary examination report, the availability of which are governed by Article 38 and Rule 94—see paragraphs 43 to 45, below. Furthermore, each supplementary search report which has been established is automatically communicated to designated and elected Offices whenever the international search report is requested.

(g) Translations of supplementary search reports are prepared by the International Bureau in the same cases as for the main international search report, that is, an English translation will be prepared of those reports which are not established in English.

6. Both alternatives also include the possibility of supplementary searches being conducted at the same time as international preliminary examination, where the International Preliminary Examining Authority is not the same Office as the one which acted as International Searching Authority (see paragraphs 43 to 45, below).

7. The main differences between the two alternatives, other than whether the supplementary Authority necessarily waits until the main international search report has been established, are as follows:

(a) *Sequential searches only*: The request is made to the International Bureau after the main international search report has been established, within the same deadline as applies for demanding international preliminary examination. The applicant is only permitted to request searches of inventions for which a main international search report has been established. The supplementary Authority accepts the opinion of the main Authority regarding unity of invention (see paragraph 40, below) and the International Bureau collects the necessary number of additional fees before any supplementary search is begun, so that intervening correspondence with the applicant would delay establishment of the supplementary search report only in very rare cases. The supplementary search report only cites documents included in the main report to the extent that this is necessary for the indication of inventive step issues in relation to newly found citations.

(b) *Concurrent and sequential searches*: The request is made directly to the supplementary Authority within a deadline which is dependent on whether search requested is sequential or concurrent. The Authority requests the necessary documents from the International Bureau. Sequential searches otherwise follow effectively the same procedures as those under Alternative I. For concurrent searches, the supplementary Authority makes its own determination of unity of invention and requests any additional fees which are required as a result (and handles protests if it is decided to permit these—see paragraph 39, below); the supplementary search report may duplicate what appears in the main international search report and may cover inventions which are not made the subject of the main international search.

8. The matter was also discussed at the twelfth session of the Meeting of International Authorities Under the PCT (see paragraph 14, below). In the document presented to the 12th session of the Meeting of International Authorities (document PCT/MIA/12/2), it was suggested that, if both concurrent and sequential searches were permitted, they should be subject to the same rules and procedures. However, many Authorities felt that the different timing pointed to different approaches being needed to some matters. The draft Rules in Annex II therefore include a number of alternatives depending on the type of search, as

indicated above. While increasing slightly the complexity of the drafting, it has been attempted to minimize the complication which would be apparent to an applicant wishing to use the system while allowing the Authorities to use the information available to them to implement effectively whichever of the services they may offer.

BACKGROUND

9. According to Article 15,¹ the objective of the international search is “to discover relevant prior art”. In principle, prior art for the purposes of the PCT is a concept independent of place or language of disclosure: the International Searching Authority “shall endeavor to discover as much of the relevant prior art as its facilities permit” in order that the international search report be of maximum use to the applicant and designated Offices for determining whether the international application meets the requirements of novelty and inventive step according to any particular national law. Ideally, the scope and quality of the international search should be such that no designated or elected Office needs to repeat the search in the national phase. The considerations at that time should be limited to whether the citations are relevant to the particular definitions of novelty and inventive step which apply under the relevant national law.

10. However, it remains the case that no Office in the world is capable of thoroughly searching disclosures written in all languages, even if it has access to them in its search databases. Quite naturally, the majority of citations made by any International Searching Authority are in one of the languages in which the examiners in that Authority have particular proficiency. To a large extent, this reflects the fact that many technical disclosures have equivalents in other languages: either a direct equivalent in the form of another member of a patent family, or a translation of a book or paper, or else aspects of a particular technology may simply be described in many different places and the selection of one disclosure over another is a matter of convenience for the examiner, which makes no difference to the quality of the search. Nevertheless, the most relevant prior art for a particular invention will sometimes be in a language in which the main Authority is not specialized and, even if the main Authority has access to the document, it is likely to be considered only on the basis of an abstract and drawings, leaving a significant risk that its relevance will not be fully appreciated. Potentially of particularly high risk is the case where technology is being developed from earlier work which was unique to one region and all the relevant prior art may be in a language (and from a source) which would not normally be considered by an Authority which is competent for conducting the main search on international applications filed in a different region.

11. Even within the PCT minimum documentation, any International Searching Authority whose official languages do not include Japanese, Korean, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan, the Republic of Korea, the Russian Federation and the former Soviet Union, and those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available.

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.

At the start of 2003, of the 24.6 million patent documents which formed part of the minimum documentation, 8.7 million were in Japanese and 1.7 million were in Russian and would be searched by many Authorities only on the basis of an English language abstract, or else not at all.

12. Aside from the question of languages of documents, all of the International Searching Authorities have access to different bodies of information beyond what is set out in the PCT minimum documentation. Some Authorities may have access to specialized collections in particular fields of technology which are not available elsewhere.

13. There has been considerable support 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. The Working Group's discussions at its most previous session (see document PCT/R/WG/7/13, paragraphs 71 to 92) are outlined in the following paragraphs:

“IMPROVING THE QUALITY OF INTERNATIONAL SEARCHES

“71. Discussions were based on document PCT/R/WG/7/7.

“72. There was widespread support from both delegations and representatives of users for the principle of allowing supplementary international searches to be conducted on international applications, noting that early identification of as much relevant prior art as possible was useful for applicants, designated and elected Offices and third parties alike. There was, however, a significant variation in views concerning the aims and the most appropriate procedures for such searches.

“73. The Working Group strongly supported further development of the proposals relating to supplementary international searches and invited the Secretariat to prepare revised proposals for consideration at its next session, taking into account the comments and suggestions set out in the following paragraphs.

“74. There was interest from users in the possibility of international searches being updated towards the end of the international phase, to take into account relevant prior art which had not been available to the International Searching Authority when the international search report was established. Furthermore, it was noted that some International Preliminary Examining Authorities sometimes conducted such searches as part of the international preliminary examination. However, a number of delegations saw difficulties in introducing such searches as a mandatory part of international preliminary examination, noting that the mandatory nature of the proposal might conflict with Article 33(6), and that it might be difficult to achieve reliable results where the International Searching Authority and the International Preliminary Examining Authority were not the same Office. Furthermore, if this service was offered only as part of international preliminary examination, applicants might be encouraged to file demands for international applications where the full examination was not in fact desired. In the light of these concerns, the Working Group agreed not to continue discussion of this aspect of the proposals.

“General

“75. Many delegations emphasized the need for the supplementary international search system to be as simple and flexible as possible, and this to be kept in mind for future revision of the proposals.

“76. A number of delegations expressed concern that the introduction of supplementary international searches should not be permitted to adversely affect the delivery of existing services, including the main international search. The Delegation of Japan, for example, indicated that the Japan Patent Office would not be able to offer a supplementary international search service, at least at the outset, due to workload issues. Other delegations and representatives of users believed that a well-designed system need not increase the workloads of International Authorities and could, taking efficiencies in the national phase into account, reduce workload burdens overall. Some representatives of users pointed out that many applicants already filed national applications in parallel with international applications in order to gain the benefits of multiple searches, and that efficiencies could be gained for both Offices and applicants by allowing for multiple searches under the PCT. It was also emphasized that it was desirable to pursue measures for improving the quality of the main international search in addition to offering supplementary international searches.

“77. Several delegations noted that it was essential that supplementary international searches be optional for the applicant and emphasized that International Authorities should be able to determine the extent, if any, to which they would offer such searches. One delegation stressed, however, that it would only make sense to pursue the proposal if a substantial number of Authorities would be prepared to participate.

“78. One delegation suggested that it might be useful to allow third parties to request supplementary international searches to be performed on an international application. A representative of users indicated that such a feature would be of interest, but that it would be necessary to ensure that such requests could be filed anonymously.

“Purpose of the Supplementary International Search

“79. A majority of delegations considered that the primary purpose of a supplementary search should be to discover relevant prior art in languages which were a specialization of the Authority carrying out the supplementary international search (“supplementary Authority”) but not of the Authority that carried out the international search proper (“main Authority”), though some delegations felt that this was not appropriately reflected in the language of Rule 45*bis*.7. It was suggested by one delegation that the specialized languages which the supplementary Authority offered should be defined in the agreements between the Authorities and the International Bureau. The representative of the EPO expressed the view that supplementary Authorities should be free to determine the scope of the supplementary international search themselves.

“80. One delegation indicated that it was necessary to be clear as to why it was desired to offer a supplementary international search system, noting that it was impossible to guarantee that all relevant prior art could be found and that any search was necessarily a compromise between completeness and cost. The delegation considered that the PCT should not offer the type of commercial search which might be conducted by defendants

in infringement actions. Such broad searches could not be justified routinely. Rather, the supplementary search should aim to address the needs of applicants wishing not to be surprised by new citations found by designated Offices in the national phase and of Offices which did not presently recognize the international search as being sufficient for national phase processing.

“81. A considerable number of delegations noted the importance of minimizing unnecessary duplication of work, but many felt that the appropriate extent of a supplementary international search beyond what was essential to achieve the primary purpose should be determined by the supplementary Authority itself.

“82. Some delegations and representatives of users considered that the purpose of the supplementary international search should not be defined by the Regulations at all. Instead, each supplementary Authority could indicate the service which it was prepared to offer and allow applicants to decide whether this service was of interest to them. This would allow Authorities to offer different services, for example, specializing in certain technical areas where their search collections extended significantly beyond the PCT minimum documentation, rather than in particular languages. One delegation suggested that it might also be desirable to consider matters of competence of Authorities more generally so as to give the applicant the maximum choice in determining the extent of the international search appropriate to the international application concerned. One representative of users suggested that the scope of the supplementary international search should be determined by the supplementary Authority according to what further search it would normally perform on the international application if it had received it in its role as a designated Office in the national phase.

“Body to Which Request for Supplementary International Search Is Submitted

“83. The Working Group reaffirmed that requests for supplementary international searches should not be submitted to the receiving Office. A majority of delegations considered that the International Bureau seemed the most appropriate body to receive the request for supplementary international search, though it was noted that there were some advantages in making the request directly to the supplementary Authority, particularly if only a single supplementary international search was sought.

“84. One delegation suggested that, if the requests were not to be submitted only to the supplementary Authority, they should be able to be submitted to either the supplementary Authority or the International Bureau, at the choice of the applicant. A majority of delegations were opposed to such an idea, noting that it would add complexity and confusion to the system.

“Contents of the Supplementary International Search Report

“85. The Working Group agreed that the supplementary international search report should not include a written opinion but should list citations in a manner similar to an international search report, also including comments sufficient to make their relevance clear. One delegation suggested that it should not be necessary to list family members of the cited documents.

“Time of Requesting and Performing the Supplementary International Search

“86. Many delegations considered that supplementary international searches should only be able to be requested and performed after the transmittal of the main international search report, since otherwise there was a risk of duplication, inconsistency and unnecessary work, noting that there might be little value in a supplementary search where the main search showed that an invention was not new.

“87. Other delegations considered that there should be an option for Authorities to offer supplementary international searches concurrently with the main search. While some delegations were concerned that different approaches among Authorities might cause complications to the system and confusion for applicants, other delegations considered that such difficulties would be limited and that a flexible system might allow participation in the system by some Authorities which otherwise would not be in a position to deliver searches within the very short deadlines inherent in a system providing for sequential searches. One representative of users stated that minor complications would be worthwhile if the result was a wider range of participating Authorities, since new prior art being found in the national phase was a much more significant problem for applicants. It was also pointed out that the availability of services in different ways from different Authorities might offer, as the preferences of users became clear through the choices they expressed, some practical insight into the needs of users.

“88. The Working Group agreed that the Secretariat should, in revising the proposals, consider the issues involved in providing main and supplementary searches sequentially, concurrently or both.

“89. The Working Group agreed that an outer time limit for requesting a supplementary international search was appropriate to avoid prolongation of the international phase, though it was noted that exactly what the limit should be would depend on when the supplementary international search was to be performed and whether it could be requested alone, in conjunction with international preliminary examination, or in either way.

“Claims to Be Searched (Unity, Clarity, Subject Matter, etc.)

“90. The Working Group agreed that consideration of the proposals, as regards claims to be searched, should continue as provided in document PCT/R/WG/7/7, at least in respect of the case where the main and supplementary international searches were performed sequentially. Some representatives of users indicated that it would be desirable to allow supplementary international searches even on claims which had not been the subject of the main international search, provided that the applicant paid the appropriate fees.

“Fees and Documents to Be Provided by the Applicant

“91. One delegation suggested that, assuming that the International Bureau was the body to which fees relating to the supplementary international search were to be paid, it might be more efficient for the International Bureau to refund fees where the supplementary Authority did not conduct a supplementary international search because of a limitation on the subject matter on which it had agreed to conduct such searches.

“Availability and Translations of the Supplementary International Search Report

“92. One delegation suggested that it should be clarified that designated Offices and third parties should be able to obtain status information indicating whether a supplementary international search had been requested for a particular international application.”

14. The matter was also discussed at the twelfth session of the Meeting of International Authorities Under the PCT (see document PCT/MIA/12/2). The Meeting’s discussion of the proposals (see document PCT/MIA/12/10, paragraphs 20 to 26) is outlined in the following paragraphs:

“Supplementary International Searches

“20. Discussions were based on document PCT/MIA/12/2.

“21. A number of Authorities expressed support for the principle of permitting supplementary searches to be carried out under the PCT. Two Authorities noted that an intended benefit of the PCT was the ability to rely on a single central search, and believed that if the quality of the main international search was not considered adequate to be relied on in the national phase, this was a matter which should be addressed at source rather than by providing for the conduct of multiple or supplementary searches. Nevertheless, these Authorities were prepared to consider a system of suitably focussed supplementary searches.

“22. A majority of Authorities considered that supplementary searches should only be carried out after the main international search report had been established. They felt that such sequential searches would provide a more simple and less confusing system than if searches could also be performed concurrently. The supplementary Authority could use the contents of the international search report to avoid the need to reconsider the question of unity of invention and to target more accurately the range of prior art which might not have been covered in the main search, instead of duplicating it. Some Authorities considered that sequential searches would be beneficial in avoiding conflicting reports being given to the applicant by different Authorities. It was also suggested that if multiple Authorities could be requested to perform searches of equivalent scope, it might reduce confidence in the system since it created an expectation of differences in results. Concern was also expressed that offering directly equivalent searches might increase workloads and delays within Authorities due to Authorities spending additional time, out of proportion to the resulting improved quality of search, on search reports which would be directly compared with reports from other Authorities. If applicants wanted multiple complete searches at an early stage in order to be more certain as to the likely outcome in the national phase, this was possible in other ways, such as by seeking commercial searches or by use of the direct Paris Convention filing route.

“23. Two Authorities supported a system where Authorities could establish supplementary search reports concurrently with the main international search report. One of these Authorities indicated that it was unlikely to offer supplementary searches other than concurrently with the main report. It considered that, even if the system were slightly more complicated than one where only sequential searches were possible, this

might be desirable if it permitted greater participation by Authorities and delivered more complete search results to applicants at an earlier stage. A third Authority stated that it could support a system of sequential searches but preferred one permitting both concurrent and sequential searches.

“24. Some Authorities considered that the supplementary Authority should have greater flexibility to determine the scope of search to be performed than was implied by the proposals. One Authority in particular indicated that supplementary searches which it performed should have the same scope as if it were carrying out the main international search. It considered that a broad scope of supplementary search would not lead to duplication of work. Rather, work which would in any case have been done later, in the national phase, by the same Office in its capacity as a designated Office would be brought forward into the international phase, so that the search results would be available to the applicant earlier than otherwise. As to the possibility of differences of opinion occurring in reports by multiple Authorities, this would occur anyway in the form of differences between designated Offices in the national phase. It was likely that supplementary searches targeted at particular languages would not be any cheaper or less time-consuming for International Searching Authorities than complete searches and might not meet the aim of the overall search results being accepted by designated Offices without further searching in the national phase.

“25. The Meeting supported the general principle of permitting supplementary searches to be carried out under the PCT and agreed that amendments should be further developed by the Secretariat for submission to the Working Group on Reform of the PCT.

“26. The Chair noted that, since the Meeting was not in agreement as to the desirable timing and scope of supplementary searches, the proposals to be made by the Secretariat to the Working Group on Reform of the PCT would need to include options for both (i) sequential searches only and (ii) both sequential and concurrent searches. If possible, a draft would be made available on the PCT Reform electronic forum seeking informal comments prior to a final document being submitted to the Working Group.

“27. The following more specific comments were made on the draft Rules in Annexes I and II to document PCT/MIA/12/2. Some of the comments in relation to Rules in Annex I apply equally to equivalent Rules in Annex II.

“– *Proposals in Annex I: Sequential Searches Only*

“28. *Rule 45bis.2*: Consideration should be given to checks being carried out by the International Bureau, rather than the supplementary Authority, as to whether any limitation on numbers of supplementary searches to be conducted by a particular Authority had been exceeded.

“29. *Rule 45bis.4(f)(ii)*: The reference to Rule 49bis.9(b) should be deleted since refunds in that case would be given by the supplementary Authority, not the International Bureau.

“30. *Rule 45bis.7*: A number of Authorities considered that the suggested objective of supplementary international search was too restrictive and a more open objective (possibly as provided in the equivalent provision in Annex II) would afford individual Authorities more scope to determine what was appropriate.

“31. *Rule 45bis.12*: Consideration should be given to including an express provision to the effect that the supplementary search report would be made available to the public by the International Authority.

“32. *Rule 45bis.13*: Consideration should be given to whether the matters related to supplementary searches should be covered in the agreements between Authorities and the International Bureau, rather than by providing for notifications outside the agreements. It should also be clarified whether limitations on the supplementary searches to be performed by an International Authority were permitted on the basis of factors other than the number of searches which an Authority was prepared to carry out or the subject matter which an Authority was prepared to search.

“33. *Rule 53.2(a-bis)*: The reference to Rule 44bis.13 should be to Rule 45bis.13.

“34. *Rule 58.3(b)(i)*: It is not clear whether the term ‘associated’ would apply to a request for supplementary search which had been furnished other than with the demand. More broadly, consideration should be given to whether it should be possible to submit separately a request for supplementary search and a demand for international preliminary examination to be undertaken by the same Authority. This would be an even more significant issue in the system proposed in Annex II, where it would be more likely that a demand could be filed after a supplementary search had already been requested.

“35. *Rule 68*: Consideration needs to be given to the extent to which it should be possible to demand international preliminary examination and request supplementary search by the International Preliminary Examining Authority in respect of different inventions.

“– *Proposals in Annex II: Concurrent and Sequential Searches*

“36. Some Authorities suggested that if both concurrent and sequential searches were permitted, it was desirable for the Rules and procedures to be the same for either type of search as far as possible, although total equivalence might not be achievable.

“37. *Rule 4.1*: One Authority pointed out that the possibility of including a request for supplementary international search in the request under Article 3(2) would increase the workload of receiving Offices, since it would involve processing accompanying translations (for example, scanning the pages and making at least a cursory check of whether this corresponded to what was stated in the request to be included) and possibly also fees, and it would therefore be preferable if requests for supplementary search could be made only to the International Bureau. On the other hand it was noted that, since there is inevitably a delay in notifying the international application number to the applicant, it might be difficult to submit a complete and timely request for supplementary search to the International Bureau in cases where the Authority had specified a very short time limit for making such requests (for example, 13 months from the priority date, as one Authority had stated would be likely in its case).

“38. *Rule 45bis.1(a)*: Some Authorities noted again their view that it should only be possible to request supplementary searches after the main international search report had been established.

“39. *Rule 45bis.1(b)*: One Authority considered that the possibility for the supplementary Authority to specify its own time limit would add to the complexity of the proposed system. Another Authority responded that, in practice, an applicant would only need to be aware of two limits: a very short one (for example, expiring 13 months from the priority date) for those Authorities which performed only concurrent searches, and the generally prescribed time limit for all other Authorities.

“40. *Rule 45bis.1(c-bis)*: One Authority considered that providing for the applicant to make an indication relating to a possible future finding of lack of unity of invention, prior to consideration of the matter by the supplementary Authority, further demonstrated the complications of a system allowing for concurrent searches. Another Authority stated that the Rule should be expressed to more clearly relate to a possible subsequent finding of lack of unity by the supplementary Authority and set out the effect of the indication.

“41. *Rule 45bis.1(d)(ii)*: The words ‘has been required’ may not properly distinguish from the words ‘was required’, as used in the equivalent provision of Annex I, to make it clear that this provision only applies in the case where the main Authority has already required the applicant to provide a sequence listing in electronic form.

“42. *Rule 45bis.6(b)*: For clarity, the word ‘supplementary’ should be inserted before ‘report’ in the last line.

“43. *Rule 45bis.7*: One Authority which considered that the scope of a supplementary search should be the same as that for a main search believed that it was not appropriate to express the objective of a supplementary search as being to find prior art ‘complementary’ to that which has been found, or is likely to be found, by the main Authority.

“44. *Rule 45bis.8*: One Authority expressed concern about the lack of a provision equivalent to paragraph (c) in the equivalent Rule in Annex I, permitting a supplementary Authority to decide not to perform a supplementary search of a claim which had not been the subject of search by the main Authority. It considered that an Authority which performed sequential searches, targeted at limited subject matter, would set an accordingly reduced fee, but in the absence of such a provision would be faced with the choice of either performing a complete search of the invention or else producing a report of doubtful quality.

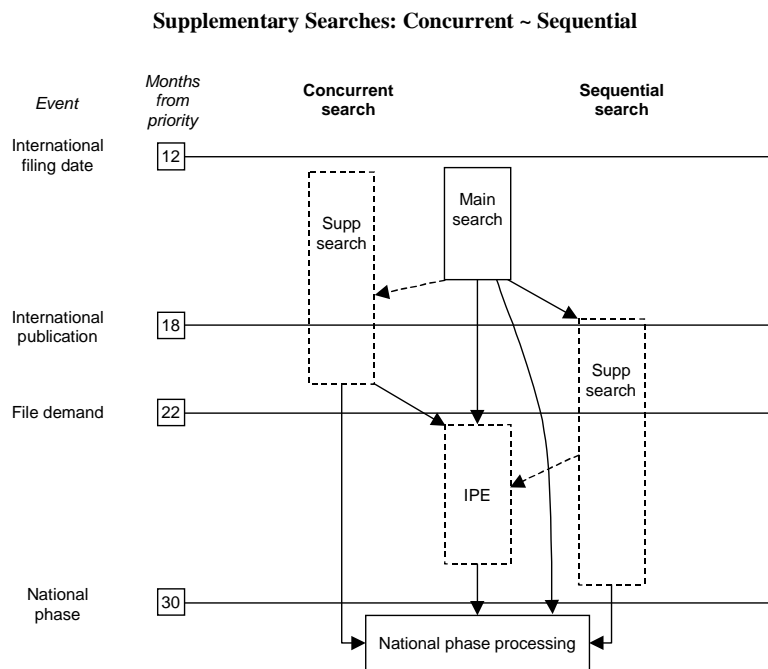
“45. *Rule 45bis.10*: One Authority considered that it was undesirable to provide for a protest procedure for cases where the supplementary Authority requested payment of additional fees for search of additional inventions. Another Authority believed that a protest system, though an exceptional case under the PCT, was a necessary exception. However, the latter Authority was concerned that, under the system proposed under this Rule, an applicant could be faced with several different findings on lack of unity from different Authorities at around the same time, each with different procedures and time limits for response. Another Authority considered that the approach taken in Annex I should apply to Authorities which conducted sequential searches.”

15. Comments were also invited on the document presented to the Meeting of International Authorities from any interested parties, using the Working Group’s electronic forum. The proposals in this document take into account the comments by the Working Group, the Meeting of International Authorities, and the responses to that invitation.

CONCURRENT AND SEQUENTIAL SEARCHES

16. At the seventh session of the Working Group, there was no consensus on whether supplementary searches should be offered only after the main international search had been established (“sequential searches”) or whether such searches could, or should, be performed at the same time as the main international search (“concurrent searches”). The Working Group agreed that the Secretariat should, in revising the proposals, consider the issues involved in providing main and supplementary searches sequentially, concurrently or both (see paragraphs 86 to 88 of document PCT/R/WG/7/13, reproduced above). Some of the main conclusions are set out in the following paragraphs.

17. The diagram below shows the typical availability of information with concurrent and sequential searches (the solid arrows show when reports from one stage would usually be available to another stage; the dotted arrows show when reports would sometimes be available to another stage).



Sequential Searches

18. *Pros:* Sequential searches have the potential to reduce duplicative and unnecessary work and to permit a better assessment of inventive step than concurrent searches. If the supplementary search is started after the main international search report is available:

(a) The scope of the main search can be determined more reliably, allowing the supplementary search to concentrate on different search material to provide a complementary service rather than a duplicative one—while a supplementary Authority might often be able to

make reasonable assumptions concerning languages of specialization of the main Authority (see paragraph 19(c), below), the details of the online databases consulted may be of particular significance (noting that some commercial databases are very expensive to search and Authorities may benefit considerably from avoiding duplication of search in these).

(b) The main Authority's view on unity of invention could be taken as defining the inventions for the purpose of determining the claims to be searched and the need for any additional fees, avoiding delays and costs due to the need for each Authority to examine the question of unity, invite the payment of any additional fees and deal with protests (see paragraph 40, below).

(c) The applicant will, after the establishment of the international search report, be better able to assess which inventions were worth requesting supplementary searches for, avoiding the extra work and cost of additional searching of inventions which have either already been shown not to be new, or else have by that time been decided to be of insufficient commercial value.

(d) The supplementary Authority will be able to assess the relevance of potential citations to the inventive step of the invention in the light of the more complete set of prior art revealed by both the main and supplementary searches, rather than only according to that found in the supplementary search.

19. *Cons:* On the other hand, there are some difficulties with sequential searching, or factors which would reduce its apparent advantages:

(a) If supplementary searches are only commenced after the main search report is available, they will usually be completed later than if they had been begun at an earlier stage; this might often mean that the supplementary search report would not be available for use in any international preliminary examination and occasionally, where the main international search report was established particularly late, could leave a supplementary Authority with little time to establish a supplementary international search report before the end of the international phase.

(b) For some parts of an online search, it may not be much cheaper or easier to exclude documents from the supplementary search which are likely to have been considered by the main Authority (for example because they form part of the PCT minimum documentation) than to include them since active steps would need to be taken to define the relevant material and exclude it.

(c) The international search report at present only indicates languages of documents considered to the extent that this can be inferred from the entries on the form indicating the documentation and databases searched and the citations found (and it may be difficult and potentially misleading to make any detailed statement on language in view of the normal methods of online search)—the supplementary Authority would usually make assumptions about language on the basis of the languages in which the main Authority is known to specialize; such an assumption could be made just as easily before the international search report is established as afterwards.

20. Irrespective of the limitations noted in paragraph 19(b) and (c), above, sequential searches could certainly reduce unnecessary duplication in a supplementary search system by eliminating some searches entirely where the results of the main international search (or other events which have occurred in the meantime) mean that the applicant can see that a supplementary search would serve no useful purpose.

21. A possible system is set out in Annex I, wherein supplementary searches are offered sequentially following the main search.

Concurrent Searches

22. *Pros:* The main benefit of concurrent searches is, clearly, the possibility of delivering the supplementary search report more quickly (or allowing the Authority a greater time to establish it within the same final time limit).

23. *Cons:* The main difficulties all stem from the fact that, if the main search report has not yet been established, it is impossible for any of the parties to know the scope of the main search or to use the information within it to improve either the quality of the supplementary search or the efficiency of the procedures:

(a) It is difficult for an examiner to make an accurate judgement of the relevance of a piece of prior art to the inventive step of the international application if he is not aware of as broad a range of other relevant prior art as possible; if the supplementary search deliberately excludes (for example) the PCT minimum documentation on the grounds that it should be fully considered by the main Authority, but the results of the main search are not yet available, the supplementary examiner may not recognize the relevance of a document, leading it either to be cited as category "A" instead of "Y", or else not to be cited at all².

(b) Similarly, due to a less complete knowledge of the prior art, the assessment of unity of invention *a posteriori*³ by a supplementary Authority may be limited (though since the Authority's comments on unity would not be expected to be considered by designated and elected Offices, this would only be of any detriment to the Authority itself, as it would result in fewer additional fees than otherwise being requested for search of additional inventions).

(c) There would be no possibility of relying on the views of the main Authority with respect to unity, meaning that delays and administrative costs would need to be incurred in making the assessment, requesting additional fees and considering any protests.

(d) The applicant would need to decide whether to request supplementary searches without knowledge of the content of the international search report, leading to some supplementary searches being made which are of no value to the applicant at all.

² Category "A": Document defining the general state of the art which is not considered to be of particular relevance.

Category "Y": The claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art. (*WIPO Standard ST.14*)

³ That is, a lack of unity of invention which only becomes apparent after taking the prior art into account.

24. The issues in paragraph 23(a) and (b) might result either in concurrent searches being of lower quality than sequential searches, or else in the Authority feeling the need to cover documentation which would also be considered in the main search, leading away from the concept of being a complement to the main search and towards being a second complete search. The issues in paragraph 23(c) and (d) would not affect the quality of the result, but would represent avoidable complications and inefficiencies in the system.

25. In view of these considerations, no proposals are presented wherein supplementary searches are offered *only* concurrently with the main search.

Both Concurrent and Sequential Searches

26. Different applicants will, of course, have different priorities in what they seek from a supplementary search system. Sometimes an applicant may want to know as much as possible about the prior art as early as possible (commercial searches are available for this purpose, but do not automatically get recognized by national Offices later to assist processing). At other times, the applicant may wish to consider use of supplementary searches depending on the results of the main search and any other commercial factors which may become apparent between the international filing date and any deadline which applies for requesting supplementary search.

27. Different Authorities, too, will have different concerns, particularly with regard to workflow. Some Authorities might be capable of delivering supplementary search reports within the international phase even if they were requested later than is currently permitted for demanding international preliminary examination (see paragraph 51 of document PCT/MIA/11/14). However, others consider that an earlier time limit would be necessary. The latter Authorities indicate that they might be unable to participate unless the time limit for requesting a supplementary search is very early on, before the time at which most international search reports are currently established.

28. One approach to this might be to offer a system where applicants were permitted to request supplementary search over a wide range of times with the deadline for requesting the supplementary search dependent on whether a concurrent or sequential search was requested, which in turn might be dependent on what forms of search were offered by a particular Authority.

29. The advantages and disadvantages of a system offering both concurrent and sequential searches would depend strongly on the details of the implementation. The main risks are:

(a) overcomplication if many different time limits exist for requesting supplementary search by different Authorities, or if different rules apply depending on whether the supplementary search is conducted before or after the main international search report has been established; and

(b) loss of the advantages of sequential searching if the supplementary Authority does not take sufficiently into account the main international search report whenever it has been established prior to the supplementary search being conducted.

30. A possible system is set out in Annex II, wherein supplementary searches may be requested either concurrently or sequentially. Two time limits are set: an early one for requesting concurrent search and a later one for requesting sequential search.

OTHER ISSUES

Body to Which Request for Supplementary International Search Is Submitted

31. At the seventh session of the Working Group (see paragraphs 83 and 84 of document PCT/R/WG/7/13, reproduced above), at which the proposal under consideration was for a system permitting sequential searches only, a majority of delegations considered that the International Bureau seemed the most appropriate body to receive the request for supplementary international search, though it was noted that there were some advantages in making the request directly to the supplementary Authority, particularly if only a single supplementary international search was sought. A majority of delegations were opposed to giving the applicant the choice of submitting the request to either the International Bureau or the supplementary Authority, noting that it would add complexity and confusion to the system.

32. Some large receiving Offices have indicated that they would be reluctant to permit requests for supplementary search to be included in the request under Article 4 because of the burden of handling translations (which might need to be scanned) and possibly fees, even if the request was simply to be passed on, without checking by the receiving Office, to the International Bureau.

33. After further consideration of the ways in which the applicant could be given a choice, Alternative I, where only sequential supplementary searches are permitted, retains the requirement that the request for supplementary search be made to the International Bureau (except in the particular case when the supplementary search is to be carried out as part of an international preliminary examination—see paragraphs 43 to 45, below). This approach minimizes:

(a) the number of currencies in which the fees need be set, since it would not be necessary to set the supplementary search handling fee in currencies other than those used by the International Bureau; and

(b) the number of administrative actions which need to take place, since the International Bureau can pass all the necessary documentation directly to the supplementary Authority, rather than the Authority having to request the information and then wait for a response; it would also permit a request for several supplementary searches to be processed in a single action instead of individually by different Authorities.

34. Alternative II, where both sequential and concurrent supplementary searches are permitted, provides for the requests being made directly to the supplementary Authority, since the fact that requests need to be made at different times and with different contents depending on the Authority concerned means that it is less likely that requests for several different supplementary searches could be handled simultaneously. Furthermore, if the criteria which need to be checked (such as timing of the request or the translations which are required) are dependent on the Authority involved, there is less risk of error if those checks are carried out by the relevant Authority, which need concern itself only with the criteria which it applies itself.

Scope of Supplementary Search

35. The discussions so far have not achieved a consensus on the appropriate scope of a supplementary search. Many delegations consider that such searches should be limited to documents which are likely not to have been part of the material searched by the main Authority, for example because of the difficulty in searching in certain languages, so that the supplementary search is a complement to the main search with a minimum of duplication.

36. On the other hand, some Authorities point out that to exclude specific documentation from an online search would take an active step by the examiner and as a result it often may not be significantly quicker or cheaper to perform a limited search than a complete one. If the Office performing that limited search then considered that it was still necessary to perform a more complete search in the national phase, there might be a greater duplication of work than would result from performing a supplementary search of wide scope.

37. In view of these differences of opinion, it is proposed that each Authority which offers supplementary searches should define the scope of the search which it will provide in its agreement with the International Bureau. These agreements are published in the PCT Gazette and the relevant information would also appear elsewhere, such as in the PCT Applicant's Guide. Applicants would then be able to decide whether the service offered by a particular Authority would be of benefit to them in any particular case.

Unity of Invention

38. Representatives of users have indicated that, where the international application is found to lack unity of invention, a supplementary search should not be limited to simply the first invention claimed, but rather that the applicant should be able to specify which claims should be searched and pay the appropriate fees (see, for example, paragraph 79 of document PCT/R/WG/6/12). The possible ways in which such a system could be implemented depend on whether supplementary searches are carried out concurrently with the main search or sequentially (or both).

39. If the main and supplementary searches are carried out concurrently, there would be no alternative but for the supplementary Authority to make its own assessment of unity of invention and request any additional fees. Options are provided (see Rule 45*bis*.8(a) in Annex II) to either include or not include a protest procedure for this function. While it might seem fair to permit a form of appeal against a request for additional fees, it is noted that the protest procedure is an exception within the PCT and that failure to obtain a supplementary search report on some inventions would not risk the possible consequence that those inventions might be considered withdrawn in some States unless a special fee is paid (see Article 17(3)(b)), which applies only to the main search.

40. For sequential searches, it is proposed (in both alternatives) that the supplementary search would rely on the view of the main Authority expressed in the main search report (together with any later results of a protest). This would not imply that the Authority would necessarily agree with that view later on in its possible role as an International Preliminary Examining Authority or as a designated or elected Office, but this would offer an administrative convenience, avoiding the delays of requesting additional fees and the cost and burden of any separate protest procedure.

Claims Covered by Main and Supplementary International Search Reports

41. In the concurrent searches available under Alternative II, it would not be possible to limit the supplementary search to claims covered by the main international search report (since the supplementary Authority would not know what action the main Authority would take). This means that the supplementary search may cover claims on which no main international search report is established, whether because of issues of unity of invention or because of differences in the subject matter which certain International Searching Authorities under Rule 39 are not required to search.

42. The results of a supplementary international search where a main international search had not been conducted would need to be treated with caution: if the supplementary search was limited in scope (for instance only to documents in certain languages), it would not be as near a complete review of the relevant prior art as a normal international search. Applicants should be aware of the limitations of any supplementary searches. International Preliminary Examining Authorities (or designated and elected Offices) considering a supplementary search report on claims not covered by a main international search report would need to decide on the merits of the case whether an opinion on novelty, inventive step and industrial applicability could be fully established, should not be established, or could be partially established including a caution that it is based on the results of a supplementary search which was intended to complement a main search report which was not in fact established.

Supplementary Search by the International Preliminary Examining Authority

43. The proposals make provision for supplementary searches to be performed by the International Preliminary Examining Authority. Clearly this would in general need to be requested as part of the demand and would have to be subject to the same time limit as the filing of the demand (it could be envisaged that a demand which had already been filed could be "corrected" to include a request for supplementary international search, though this possibility is not specifically provided for in the draft rules). Performing supplementary searches at the same time as international preliminary examination would be efficient in that an examiner would only need to consider the international application once to address both purposes, though it would only be practical in limited circumstances because the option would only be available if the desired Authority was a competent International Preliminary Examining Authority for the international application (which would be a major restriction for those applicants for whom the choice of Authorities is limited);

44. The procedures for supplementary search at the time of international preliminary examination would differ from those for supplementary searches carried out on their own in two main respects:

(a) Since the international preliminary examination takes place on the basis of any amendments to the international application which have been filed under Article 19 or 34, the supplementary search should be carried out on the same basis.

(b) Rather than establishing a separate supplementary international search report, the results would be noted on the citations pages of the international preliminary examination report in the same way that is currently done for documents where the examiner makes a new citation at that stage; as such, the availability of the search results to third parties would be subject to the rules which apply to the international preliminary examination report.

45. The proposed rules would permit different conditions to be made in the agreements between an International Authority and the International Bureau in respect of the Authority conducting supplementary searches together with international preliminary examination compared to those which applied to supplementary searches conducted as a separate service. Nevertheless, in order that the system be kept as simple as possible, it is hoped that Authorities would provide the service in both forms with equivalent scopes.

46. The Working Group is invited to consider the proposals and issues contained in this document

[Annex I follows]

ANNEX I

DRAFT AMENDMENTS OF THE PCT REGULATIONS:⁴ALTERNATIVE I:
SEQUENTIAL SEARCHES ONLY

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⁴ 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 Request for Supplementary International Search

(a) The applicant may, after having received the international search report and within the time limit referred to in paragraph (b), request the International Bureau that a supplementary international search be carried out by one or more Authorities, other than the Authority which carried out the international search under Article 16(1), which have agreed to perform such searches (“Supplementary International Searching Authorities”).

[COMMENT: In this proposal, a supplementary search can only be requested after having received the international search report—if a declaration is made under Article 17(2)(a) by the main Authority, a subsequent request for supplementary search would be treated as not having been made.]

(b) The time limit referred to in paragraph (a) shall be whichever of the following expires later:

- (i) three months from the date of transmittal to the applicant of the international search report and the written opinion established under Rule 43bis.1; or
- (ii) 22 months from the priority date.

[COMMENT: The proposal in Annex II provides for an earlier time limit for requesting concurrent supplementary searches. In this proposal, which allows only sequential supplementary searches, an earlier time limit should not be necessary, noting that there should rarely, if ever, be any delay to the establishment of the supplementary search report caused by the need for the Authority to contact the applicant.]

[Rule 45bis.1, continued]

(c) A request under paragraph (a) shall contain:

(i) indications concerning the international application to which it relates, comprising the name and address of the applicant and the agent if there is an agent, the title of the invention, the international filing date and the international application number;

(ii) an indication of which Authorities are requested to carry out a supplementary international search;

(iii) where the international application was filed in a language which is not accepted by an Authority which is requested to carry out a supplementary international search, an indication of whether any translation which has been furnished to the receiving Office under Rule 12.3 or 12.4 is to form the basis of the supplementary international search to be carried out by that Authority; and

(iv) where the International Searching Authority considers that the international application does not comply with the requirement of unity of invention, an indication of which of the inventions in respect of which the international search report was established are to be the subject of the supplementary international search.

[COMMENT: The applicant would be permitted to choose any of the inventions to be the subject of the supplementary international search, as long as that invention had been searched by the International Searching Authority. The main invention would not necessarily need to be included.]

[Rule 45bis.1, continued]

(d) A request under paragraph (a) shall, where applicable, also be accompanied by:

(i) any translation of the international application required under Rule 45bis.4;

(ii) a copy of any sequence listing in electronic form complying with the standard provided for in the Administrative Instructions which was required by the International Searching Authority under Rule 13ter.1(a).

[COMMENT: At present, the International Searching Authority does not forward a copy of sequence listings provided for the purpose of international search to the International Bureau, since they do not form part of the international application and are not published. An alternative possibility would be for such listings to be sent by the International Searching Authority to the International Bureau automatically with the international search report, so that the applicant would not be required to furnish further copies for any supplementary searches.]

(e) The fees payable under Rules 45bis.2 and 45bis.3 shall be paid to the International Bureau within one month from the date of receipt of the request for supplementary international search. The amount payable shall be the amount applicable on the date of payment.

45bis.2 Supplementary Search Handling Fee

(a) A request for a supplementary international search filed with the International Bureau under Rule 45bis.1(a) shall be subject to the payment of a fee for the benefit of the International Bureau (“supplementary search handling fee”). The amount of the supplementary search handling fee is as set out in the Schedule of Fees. The International Bureau shall refund to the applicant any supplementary search handling fee paid if:

(i) the request for a supplementary international search is withdrawn before the supplementary search copy is sent to the Authority carrying out the supplementary international search; or

(ii) the request for a supplementary international search is considered, under Rule 45bis.5(c), not to have been made.

[COMMENT: The amount of this fee would be set to cover the cost of processing the request and results, including checking the request, forwarding the necessary documents to the International Searching Authority carrying out the supplementary international search, making any necessary translations and making the results available to Offices and the public.]

(b) The amount of the said fees in any currency prescribed by the International Bureau, other than the currency in which the fee is set in the Schedule of Fees, shall be established by the Director General. The amounts so established shall be the equivalents, in round figures, of the amount set in the Schedule of Fees. They shall be published in the Gazette.

45bis.3 Supplementary Search Fee; Additional Supplementary Search Fee

(a) Each Supplementary International Searching Authority may require that the applicant pay a fee (“supplementary search fee”) for its own benefit for carrying out a supplementary international search and an additional fee (“additional supplementary search fee”) for carrying out searches on any invention beyond the first one searched.

[COMMENT: The “first” invention means the first which is to be the subject of a supplementary international search, not necessarily the “first mentioned in the claims” as is specified for the main international search under Article 17(3)(a).]

(b) The supplementary search fee and any additional supplementary search fee shall be collected by the International Bureau. Rule 16(b) to (e) shall apply *mutatis mutandis*.

(c) The International Bureau shall refund the supplementary search fee and any additional supplementary search fee to the applicant if:

(i) the request for a supplementary international search is withdrawn before the supplementary search copy is sent to the Authority carrying out the supplementary international search; or

(ii) the request for a supplementary international search is considered, under Rule 45bis.5(c), not to have been made.

[Rule 45bis.3, continued]

(d) To the extent that the International Searching Authority finds a protest of the applicant under Rule 40.2(c) justified, the Authority carrying out the supplementary international search shall totally or partially refund any additional supplementary search fee paid by the applicant.

[COMMENT: Draft Rule 45bis.3 is modeled on Rule 16. The currencies currently prescribed by the International Bureau in its role as a receiving Office in respect of the collection of search fees are the Swiss franc, the Euro and the US dollar. While refunds of fees would be carried out by the International Bureau under paragraph (f) when the request for supplementary international search is withdrawn or considered withdrawn, refunds under paragraph (g) following a successful protest would require consideration by the Authority carrying out the supplementary international search of the extent to which the refund was appropriate. The Administrative Instructions would need to be modified so as to indicate that the International Bureau must forward the results of any protest to all Authorities carrying out a supplementary international search.]

45bis.4 Translation for Supplementary International Search

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 carrying out the supplementary international search, the request for a supplementary international search shall be accompanied by a translation of the international application into a language which is accepted by that Authority and is a language of publication.

[COMMENT: Modeled on Rule 12.3. For simplicity of processing, the translation would need to be filed at the same time as the request for the supplementary international search. This does not appear to be an unreasonable burden since the time limit will inevitably be several months after the international filing date, allowing more time to prepare the translation than is permitted for the translation for the purposes of the main international search.]

45bis.5 Acknowledgement of Receipt and Checking of Request for Supplementary

International Search

(a) The International Bureau shall promptly acknowledge receipt of a request for supplementary international search. Where the International Bureau finds that any of the indications required under Rule 45bis.1(c) or any elements required under Rule 45bis.1(d) are missing, it shall invite the applicant to furnish the indications or elements within one month from the date of the invitation.

(b) Where, by the time they are due under Rule 45bis.1(e), the International Bureau finds that the fees under Rules 45bis.2 and 45bis.3 have not been paid in full, the International Bureau shall invite the applicant to pay to it the amount required to cover those fees within a time limit of one month from the date of the invitation.

[COMMENT: It is not envisaged that applicants would often use this provision deliberately to extend the period for payment of fees or the provision of translations because of the risk that the supplementary search report would not be established in time for use in making decisions on whether to enter the national (or regional) phase. Consequently, although making and following up the invitation would significantly add to the work required of the International Bureau in any particular case, it is not proposed at this time to include a late payment fee. This would need to be reviewed if significant numbers of invitations needed to be issued.]

(c) If the applicant does not, before the expiration of the time limit under paragraph (a), furnish the required indications or elements or does not, before the expiration of the time limit under paragraph (b), pay the amount in full of the fees due, the request for supplementary international search shall, subject to paragraph (d), be considered as if it had not been made and the International Bureau shall inform the applicant accordingly.

[Rule 45bis.5, continued]

(d) Where a request has been made for the search of additional inventions but insufficient additional supplementary fees have been paid, the request shall be considered to be a request for supplementary international search on as many of the inventions as required fees have been paid. The Administrative Instructions shall determine which of the inventions shall be the subject of the supplementary international search.

[COMMENT: The Administrative Instructions would require that where the inventions to be searched had been listed, the supplementary international searches would be performed on the appropriate number of inventions in the order in which they were listed. Where they were not listed, the search would normally be performed in the order in which the inventions appeared in the claims, but would leave some scope for discretion (for example, ignoring inventions which would not be subject to supplementary international search in accordance with Rule 45bis.7(b) on grounds of their subject matter).]

(e) On finding that the requirements under Rules 45bis.1(c), (d) and (e) have been complied with, the International Bureau shall promptly transmit to each Authority which is to carry out a supplementary international search one copy of each of the following:

(i) the request for a supplementary international search;

(ii) the international application;

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

(iv) any translation furnished by the applicant under Rule 12.3, 12.4 or 45bis.4 which is to be used as the basis of the supplementary international search;

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

(v) the international search report; and

(vi) the written opinion established under Rule 43bis.1.

[COMMENT: It would not normally be necessary for the supplementary Authority to consider the written opinion, but it might occasionally be useful in determining whether the main Authority had considered the full text of a cited document or only an abstract.]

45bis.6 Start of Supplementary International Search

(a) Subject to paragraph (b), the Authority carrying out a supplementary international search shall start that search promptly on receipt of the documents specified in Rule 45bis.5(e).

(b) If the Authority requested to carry out a supplementary international search finds that such search would be excluded by a limitation made in accordance with Rule 45bis.11(b), the request for supplementary international search shall be considered not to have been made and the Authority shall promptly notify the applicant and the International Bureau accordingly. The Authority shall refund to the applicant the supplementary search fee and any additional supplementary search fees which have been paid under Rule 45bis.3.

[COMMENT: The applicant's right to a refund under this paragraph would extend only to the case where the supplementary international search is not made because of a restriction made in accordance with proposed Rule 45bis.11(b) and not because of a declaration equivalent to that under Article 17(2)(a).]

45bis.7 Basis and Scope of the Supplementary International Search

(a) The supplementary international search shall be carried out on the basis of the international application as filed or of a translation thereof indicated under Rule 45bis.1(c)(iii) or accompanying the request for supplementary international search under Rule 45bis.4.

[COMMENT: Under this proposal the supplementary international search cannot begin before the main international search report has been transmitted. Consequently, it would always be possible for the applicant to file amendments under Article 19 before the supplementary international search commenced. However, if such amendments were to be taken into account the main and supplementary international search reports would be more difficult to read together and in some cases it would be difficult to know how to supplement, rather than restart, the international search.]

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

[COMMENT: The Authority would not be required to carry out a supplementary international search in respect of subject matter or unclear applications for which it would not be required to carry out an international search. It should also be able to request sequence listings in an appropriate electronic form if necessary.]

(c) The Authority carrying out a supplementary international search shall not be required to establish a supplementary international search report in respect of any claim for which no international search report was established.

(d) The supplementary international search shall cover at least the documentation indicated in the agreement between the Supplementary International Searching Authority and the International Bureau in accordance with Rule 45bis.11(a).

[COMMENT: See paragraphs 35 to 37 of the main body of this document.]

45bis.8 Unity of Invention

(a) The Supplementary International Searching Authority shall carry out a search on those inventions, as identified by the International Searching Authority, which have been indicated in the request under Rule 45bis.1(c)(iv), provided that the International Searching Authority has established an international search report and the necessary fees have been paid. If no indication is given in the request, the search shall be carried out on the first invention identified by the International Searching Authority.

(b) To the extent that the International Searching Authority finds a protest of the applicant under Rule 40.2(c) justified, the Supplementary International Searching Authority shall totally or partially refund any relevant additional supplementary search fee paid by the applicant in accordance with Rule 45bis.3.

[COMMENT: See Rule 45bis.5(d) for how the request is treated in the event that not all the additional supplementary search fees are paid.]

45bis.9 Supplementary International Search Report

(a) The Authority carrying out a supplementary international search shall establish a supplementary international search report, or make a declaration pursuant to Rule 45bis.7(b) or (c) that no supplementary international search report will be established, within three months from the receipt of the request for supplementary international search by the Authority from the International Bureau or 22 months from the priority date, whichever is later.

[COMMENT: Modeled in part on Rule 42.1.]

[Rule 45bis.9, continued]

(b) For the purposes of establishing the supplementary international search report, Rules 43.1, 43.2 and 43.4 to 43.10 shall, subject to paragraph (c), apply *mutatis mutandis*. Article 20(3) and Rule 44.3 shall apply *mutatis mutandis*.

[COMMENT: 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 and that it would only include the newly found citations (except where a previously found document is considered relevant to inventive step in combination with a newly found document; see paragraph (c), below). The 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. The same requirement to send copies of the citations on request to the applicant or to a designated Office would apply as for the main international search.]

(c) The supplementary international search report shall not contain the citation of any document which was cited in the international search report, except to the extent that the document is considered relevant to the question whether the claimed invention involves an inventive step having regard also to one or more other documents which were discovered during the supplementary international search and which were not cited in the international search report.

[COMMENT: The supplementary international search report should not merely duplicate citations which appeared in the international search report; the International Search and Preliminary Examination Guidelines would make it clear that this extends to “equivalent” patent publications, unless there is found to be a material difference between the family members. Furthermore, it might lead to uncertainty if the Authority concerned took a different view to the International Searching Authority in a report which is part of the international search process. However, where it is apparent that a document has been cited merely on the basis of an abstract and the Authority conducting the supplementary international search finds that the relevance of the document was incorrect based on a consequential misunderstanding of its contents, the PCT International Search and Preliminary Examination Guidelines would make clear that the entry in the international search report should be regarded as a citation of the abstract and that it is acceptable in this case to cite the original document in the supplementary international search report.]

45bis.10 Transmittal and Effect of the Supplementary International Search Report

(a) The Authority carrying out the supplementary international search shall, on the same day, transmit one copy of the supplementary international search report, or a declaration that no supplementary international search report shall be established because a situation referred to under Rule 45bis.7(b) or (c) exists, 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.

[COMMENT: The supplementary international search report would, where necessary, be translated into English and be communicated automatically to any Office requesting a copy of the main international search report. The Administrative Instructions would make clear that, unless the international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty) had already been established and transmitted to the International Bureau, the supplementary international search report would always be forwarded to the International Preliminary Examining Authority so that it could be taken into account, if possible, even though international preliminary examination might already have begun. Public access to the supplementary international search report would be permitted under existing Rule 94.1(b) at any time after publication of the international application. Although it is not proposed to make a formal republication of the pamphlet to include the supplementary international search report, the online file inspection system would be arranged so that a person viewing the pamphlet would be aware of any supplementary report and could view it together with the main 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.

[Rule 45bis.10, continued]

[COMMENT: Modeled on Rule 66.4*bis*. The International Preliminary Search and Examination Guidelines would make clear that the International Preliminary Examining Authority should take the supplementary international search and written opinion into account whenever possible, but should not delay the start of international preliminary examination to wait for them.]

45bis.11 *International Searching Authorities Prepared to Carry Out Supplementary*

International Search

(a) If an International Searching Authority is prepared to carry out supplementary international searches, the documentation to be included in a supplementary international search and the conditions under which the Authority shall act as a Supplementary International Searching Authority shall be set out in the agreement under Article 16(3)(a) between the Office or organization and the International Bureau.

(b) The conditions in paragraph (a) may include limitations as to the subject matter for which such searches will be carried out, beyond those which would apply under Article 17(2) to an international search, or to the total number of supplementary international searches which will be performed in a given period.

[COMMENT: Authorities 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. The notification could be amended at a later stage to introduce or remove such limitations as necessary.]

Rule 53

The Demand

53.1 [No change]

53.2 Mandatory and Optional Contents; Signature

[COMMENT: It is proposed to amend the heading to match that of Rule 4.1 since, with the introduction of optional contents, the subjects of the Rules would be equivalent.]

(a) [No change]

(a-bis) The demand may contain a request that the International Preliminary Examining Authority carry out a supplementary international search, provided that the national Office which is acting as International Preliminary Examining Authority is not the same as that which acted as International Searching Authority and has agreed to carry out such searches.

(a-ter) Where, at the time that the demand is made, a request for supplementary international search under Rule 45bis.1 has been made to the Office which is acting as International Preliminary Examining Authority but no supplementary international search report has been established by that Office, that Authority may treat the request as having been made under paragraph (a-bis).

[COMMENT: This would allow the Authority to avoid the complication of dealing separately with the processes of supplementary search and international preliminary examination, noting that the amendments which would be included in the international preliminary examination would not be taken into account for the purposes of a separate search.]

[Rule 53.2, continued]

(b) [No change]

53.3 to 53.9 [No change]

Rule 58

The Preliminary Examination and Supplementary Search Fees **Fee**

58.1 *Right to Ask for a Fee*

(a) [No change] Each International Preliminary Examining Authority may require that the applicant pay a fee (“preliminary examination fee”) for its own benefit for carrying out the international preliminary examination and for performing all other tasks entrusted to International Preliminary Examining Authorities under the Treaty and these Regulations.

(a-bis) Each International Preliminary Examining Authority which has agreed to carry out supplementary searches may require that the applicant pay a fee (“supplementary search fee”) for its own benefit for carrying out the supplementary search.

[COMMENT: Fees for supplementary international searches of additional inventions are provided for in the proposed amendments to Rule 68, together with fees for examination of additional inventions.]

(b) The amount of ~~the~~ any preliminary examination fee, ~~if any,~~ and any supplementary search fee shall be fixed by the International Preliminary Examining Authority. As to the time limit for payment of the preliminary examination and supplementary search fees and the amount payable, the provisions of Rule 57.3 relating to the handling fee shall apply *mutatis mutandis*.

[Rule 58.1, continued]

(c) The preliminary examination fee and any supplementary search fee shall be payable directly to the International Preliminary Examining Authority. Where that Authority is a national Office, it shall be payable in the currency prescribed by that Office, and where the Authority is an intergovernmental organization, it shall be payable in the currency of the State in which the intergovernmental organization is located or in any other currency which is freely convertible into the currency of the said State.

58.2 [Remains deleted]

58.3 *Refund*

(a) The International Preliminary Examining Authorities shall inform the International Bureau of the extent, if any, to which, and the conditions, if any, under which, they will refund any amount paid as a preliminary examination fee where the demand is considered as if it had not been submitted, and the International Bureau shall promptly publish such information.

(b) The International Preliminary Examining Authority shall refund to the applicant any supplementary search fee and any additional supplementary search fees paid to it if:

(i) the demand or the associated request for a supplementary international search is withdrawn or considered not to have been submitted before the supplementary international search has been started; or

[Rule 58.3(b), continued]

(ii) the request for a supplementary international search is considered, under Rules 45bis.5(b) and 66.1ter, not to have been made.

Rule 66

**Procedure Before the
International Preliminary Examining Authority**

66.1 *Basis of the International Preliminary Examination*

(a) [No change] Subject to paragraphs (b) to (d), the international preliminary examination shall be based on the international application as filed.

(b) [No change] The applicant may submit amendments under Article 34 at the time of filing the demand or, subject to Rule 66.4*bis*, until the international preliminary examination report is established.

(c) [No change] Any amendments under Article 19 made before the demand was filed shall be taken into account for the purposes of the international preliminary examination unless superseded, or considered as reversed, by an amendment under Article 34.

(d) [No change] Any amendments under Article 19 made after the demand was filed and any amendments under Article 34 submitted to the International Preliminary Examining Authority shall, subject to Rule 66.4*bis*, be taken into account for the purposes of the international preliminary examination.

(e) [No change] Claims relating to inventions in respect of which no international search report has been established need not be the subject of international preliminary examination.

[Rule 66.1, continued]

(f) Paragraphs (a) to (e) shall apply *mutatis mutandis* to any supplementary international search carried out at the same time as the international preliminary examination.

66.1*bis* [No change]

66.1*ter* *Supplementary International Search by the International Preliminary Examining Authority*

For the purposes of supplementary international searches by the International Preliminary Examining Authority, Rules 45*bis*.5(c) and 45*bis*.11 shall apply *mutatis mutandis*.

[COMMENT: Supplementary international searches by the International Preliminary Examining Authority would be subject to the same possibility for limitations, such as in respect of subject matter for which the service is made available, as any other supplementary search. There would not be a formal supplementary search report. Rather, the results would be cited in the international preliminary report on patentability, in the same way as is currently done for documents which are considered relevant but were not cited in the international search report (see Rule 70.7). The Administrative Instructions would require that the report should indicate that a supplementary international search had been conducted together with the international preliminary examination.]

66.2 to 66.9 [No change]

Rule 68

Lack of Unity of Invention
(International Preliminary Examination)

68.1 [No change]

68.2 *Invitation to Restrict or Pay*

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees, the invitation shall:

(i) to (iii) [No change]

(iv) indicate the amount of the required additional preliminary examination fees to be paid in case the applicant so chooses;

(v) where the applicant has requested a supplementary international search and any additional invention has been the subject of an international search, indicate the amount of the required additional supplementary search fees to be paid if a supplementary international search is to be carried out in respect of each such additional invention; and

[Rule 68.2, continued]

(vi) ~~(v)~~ invite the applicant to pay, where applicable, the protest fee referred to in Rule 68.3(c) within one month from the date of the invitation, and indicate the amount to be paid.

68.3 *Additional Fees*

(a) The amount of the additional fees due for international preliminary examination under Article 34(3)(a) and, where the International Preliminary Examining Authority has indicated that it is prepared to carry out supplementary international searches, for supplementary international search of any additional invention shall be determined by the competent International Preliminary Examining Authority.

(b) The additional fees due for international preliminary examination under Article 34(3)(a) and any supplementary international search shall be payable direct to the International Preliminary Examining Authority.

(c) to (e) [No change]

68.4 and 68.5 [No change]

Schedule of Fees

[COMMENT: The Schedule of Fees would require amendment to include a supplementary search handling fee, whose level would be set to cover the cost of preparation, transmission, translation and making available of documents relevant to the supplementary international search during the Chapter I procedure. For supplementary international searches performed as part of the Chapter II procedure, no such fee would be necessary since no significant additional work for the International Bureau would be involved over and above that for which the handling fee under Rule 57 is levied.]

[Annex II follows]

ANNEX II

DRAFT AMENDMENTS OF THE PCT REGULATIONS: ⁵ALTERNATIVE II:
CONCURRENT AND SEQUENTIAL SEARCHES

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⁵ 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 Request for Supplementary International Search

(a) The applicant may, within the relevant time limit referred to in paragraph (b), request any Authority, other than the International Searching Authority responsible for the international search under Article 16(1), to carry out a supplementary international search of either of the following types:

- (i) a supplementary international search independent of the search under Article 16(1) (“concurrent supplementary search”); or
- (ii) a supplementary international search taking into account the results of the search under Article 16(1) (“sequential supplementary search”);

provided that the Authority in question has agreed to perform searches of the relevant type (“Supplementary International Searching Authority”).

[COMMENT: This proposal provides for requests to be made directly to the supplementary Authority. Although there is no specific restriction that requests for sequential supplementary search be made only after the main search report has been issued, it would be in the applicant’s interests to wait since the supplementary Authority would not issue any invitation to pay additional fees in respect of additional inventions found by the International Searching Authority before issuing a supplementary search report.]

[Rule 45bis.1, continued]

(b) The time limit referred to in paragraph (a) shall be:

(i) with respect to requests for concurrent supplementary search, one month from the date of notification to the applicant by the receiving Office of the international application number and the international filing date;

(ii) in the case of a request for sequential supplementary search, three months from the date of transmittal to the applicant of the international search report and the written opinion established under Rule 43bis.1 or 22 months from the priority date, whichever expires later.

[COMMENT: See paragraphs 27 and 28 of the main body.]

(c) A request for concurrent supplementary search submitted to an Authority which has agreed only to carry out sequential supplementary searches shall be considered to be a request for sequential supplementary search, and *vice versa*.

[Rule 45bis.1, continued]

(d) A request under paragraph (a) shall contain:

(i) indications concerning the international application to which it relates, comprising the name and address of the applicant and the agent if there is an agent, the title of the invention, the international filing date and the international application number; and

[COMMENT: The time limit in paragraph (b) is set so that it would always be possible to provide the international application number, even for concurrent supplementary searches.]

(ii) where the international application was filed in a language which is not accepted by the Authority which is to carry out a supplementary international search, an indication of whether any translation which has been furnished to the receiving Office under Rule 12.3 or 12.4 is to form the basis of the supplementary international search to be carried out by that Authority.

[COMMENT: The time limit for furnishing a translation under Rule 12.4 would normally be significantly later than the time limit for requesting a concurrent supplementary search. It would only be permitted to indicate that such a translation was to be relied on where it had already been furnished to the receiving Office at the time that the request for supplementary search was made.]

[Rule 45bis.1, continued]

(e) In the case of a request for sequential supplementary search, where the International Searching Authority considers that the international application does not comply with the requirement of unity of invention, the request may include an indication of which of the inventions in respect of which the international search report was established are to be the subject of the supplementary international search.

[COMMENT: In a sequential supplementary search, the supplementary Authority would follow the opinion of the main Authority and would begin the supplementary search immediately on the basis of the number of fees which had been paid without interrupting the process with a request to pay additional fees.]

(f) A request under paragraph (a) shall, where applicable, be accompanied by:

(i) any translation of the international application required under Rule 45bis.4;

(ii) a copy of any sequence listing in electronic form complying with the standard provided for in the Administrative Instructions which was required by the International Searching Authority under Rule 13ter.1(a).

[COMMENT: If the main Authority invites such a sequence listing, it is likely that a supplementary Authority will do so also. Consequently it would be more efficient both for the applicant and the Authority if the listing is included with the request for supplementary international search.]

45bis.2 Supplementary Search Handling Fee

(a) Each request for supplementary international search shall be subject to the payment of a fee for the benefit of the International Bureau (“supplementary search handling fee”) to be collected by the Supplementary International Searching Authority. Rule 57.2 shall apply mutatis mutandis. The amount payable shall be the amount applicable on the date of payment.

[COMMENT: The amount of this fee would be set to cover the cost of processing the request and results, including checking the request, forwarding the necessary documents to the International Searching Authority carrying out the supplementary international search, making any necessary translations and making the results available to Offices and the public.]

(b) The Supplementary International Searching Authority shall refund the supplementary search handling fee to the applicant:

(i) if the request for supplementary international search is withdrawn before that request has been sent by the Authority to the International Bureau; or

(ii) if the request for supplementary international search is considered, under Rule 5(d), not to have been made.

[COMMENT: Modeled on Rule 57.6.]

45bis.3 Supplementary Search Fee; Additional Supplementary Search Fee

(a) Each Supplementary International Searching Authority may require that the applicant pay a fee (“supplementary search fee”) for its own benefit for carrying out the supplementary international search and an additional fee (“additional supplementary search fee”) for carrying out searches on any invention beyond the first one searched. An Authority which has agreed to carry out both concurrent and sequential supplementary searches may set different fees for the two types of search. The fees shall be payable direct to the Supplementary International Searching Authority.

[COMMENT: If an Authority decides to offer the choice of either concurrent or sequential searches to an applicant, different fees may be charged, to reflect the different amounts of work which might be involved.]

(b) The supplementary search fee shall be paid within one month from the date of the request for supplementary international search. The amount payable shall be the amount applicable on the date of payment.

(c) In the case of a request for sequential supplementary search, the supplementary search fee shall be accompanied by an additional supplementary search fee for each invention beyond the first one requested under Rule 45bis.1(e) to be the subject of supplementary international search.

[COMMENT: In the case of concurrent supplementary search, the supplementary Authority has to form its own opinion on unity of invention and request additional fees at a later stage; see draft Rule 45bis.8(a)]

45bis.4 Translation for Supplementary International Search

Where neither the language in which the international application was filed nor the language in which a translation (if any) has been furnished under Rule 12.3 or 12.4 is accepted by the Supplementary International Searching Authority, the request for a supplementary international search shall be accompanied by a translation of the international application into a language which is accepted by that Authority and is a language of publication.

45bis.5 Acknowledgement of Receipt and Checking of Request for Supplementary International Search

(a) On receipt of a request under Rule 45bis.1(a), the Supplementary International Searching Authority shall promptly notify the applicant of receipt and send a copy of that request to the International Bureau.

[COMMENT: It is desirable to acknowledge receipt of the request immediately since it will often not be possible to check whether the request is valid without a copy of the international application (in the event that the Authority has placed restrictions on the technologies for which the service is provided) or an translation which it is indicated should be used and, in the case of sequential search, without a copy of the international search report (to show whether there has been a finding of lack of unity of invention).]

(b) The International Bureau shall promptly send the Supplementary International Searching Authority one copy of each of the following:

(i) the international application (“supplementary search copy”);

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

(ii) any translation furnished by the applicant under Rule 12.3 or 12.4 which is to be used as the basis of the supplementary international search;

[COMMENT: If a translation under Rule 12.4 had been indicated, but this had not in fact been received by the International Bureau from the receiving Office (within a reasonable period allowing for delays in transmission), this would be notified to the supplementary Authority, which would then require a translation under Rule 45bis.4 to correct the defect in the request for supplementary international search.]

(iii) if available, the international search report or declaration referred to in Article 17(2)(a) and the written opinion established under Rule 43bis.1;

[COMMENT: Although a concurrent supplementary search is said to be independent of the main search, it is proposed that a copy of the search report should be sent to the supplementary Authority in the rare event that it is already available before a request for concurrent supplementary search is made.]

(iv) if available, a copy of any protest and decision thereon made by the applicant to the International Searching Authority.

[COMMENT: Similarly, although an Authority carrying out a concurrent supplementary search would assess unity of invention independently, it may be useful for that Authority to see any additional arguments made by the applicant in the event that these are already available.]

[Rule 45bis.5, continued]

(c) In the case of a request for sequential supplementary search, if any item listed in paragraph (b)(iii) or (iv) is not available to the International Bureau at the time that the supplementary search copy is transmitted under paragraph (b), that item shall be transmitted to the Authority as soon as it becomes available, if this occurs prior to the transmittal of the supplementary international search report by the Authority or, in the case of item (iv), at any time.

(d) Where the Supplementary International Searching Authority finds that the supplementary international search would be excluded by a limitation made in accordance with Rule 45bis.11, the request for supplementary international search shall be considered not to have been made and the Authority shall promptly notify the applicant accordingly. The Authority shall refund to the applicant the supplementary search fee and any additional supplementary search fees which have been paid under Rule 45bis.3.

[COMMENT: The supplementary search handling fee would also be refunded in this case (see draft Rule 45bis.2(b)(ii)).]

(e) Where the Supplementary International Searching Authority finds that any of the indications required under Rule 45bis.1(d) or (e) or any elements required under Rule 45bis.1(f) are missing, it shall invite the applicant to furnish the indications or elements within one month from the date of the invitation.

[Rule 45bis.5, continued]

(f) Where, by the time they are due, the Authority finds that the fees under Rules 45bis.2 or 45bis.3 have not been paid in full, the Authority shall invite the applicant to pay to it the amount required to cover those fees within a time limit of one month from the date of the invitation.

(g) If the applicant does not, before the expiration of the time limit under paragraph (e), submit the required indications or elements or does not, before the expiration of the time limit under paragraph (f), pay the amount in full of the fees due, the request for supplementary international search shall, subject to paragraph (h), be considered not to have been made and the Authority shall inform the applicant accordingly.

(h) In the case of a request for sequential supplementary search, where a request has been made for the search of additional inventions but insufficient additional supplementary fees have been paid, the request shall be considered to be a request for supplementary international search on as many of the inventions as required fees have been paid. The Administrative Instructions shall determine which of the inventions shall be the subject of the supplementary international search.

45bis.6 Start of Supplementary International Search

On finding that the requirements under Rules 45bis.1(d), (e) and (f) have been complied with, the Supplementary International Searching Authority shall start that search promptly, provided that at least the following documents have been received from the International Bureau:

(i) in the case of a request for concurrent supplementary search, the documents specified in items (i) and (ii) of Rule 45bis.5(b).

(ii) in the case of a request for sequential supplementary search, the documents specified in items (i) to (iii) of Rule 45bis.5(b).

[COMMENT: Concurrent search requires only a copy of the international application and any translation. Sequential search requires also a copy of the international search report.]

45bis.7 Basis and Scope of the Supplementary International Search

(a) The supplementary international search shall be carried out on the basis of the international application as filed, or of a translation thereof indicated under Rule 45bis.1(d)(ii) or accompanying the request for supplementary international search under Rule 45bis.4.

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

[Rule 45bis.7(b), continued]

[COMMENT: The Authority would not be required to carry out a supplementary international search in respect of subject matter or unclear applications for which it would not be required to carry out an international search. It should also be able to request sequence listings in an appropriate electronic form if necessary.]

(c) In the case of a sequential supplementary international search, the Supplementary International Searching Authority shall not be required to establish a supplementary international search report in respect of any claim for which no international search report was established.

(d) The supplementary international search shall cover at least the documentation indicated in the agreement between the Supplementary International Searching Authority and the International Bureau in accordance with Rule 45bis.11.

[COMMENT: See paragraphs 35 to 37 of the main body of this document.]

45bis.8 Unity of Invention

(a) In the case of a concurrent supplementary search, if the Supplementary International Searching Authority considers that the international application does not comply with the requirement of unity of invention, Article 17(3)(a) and [Rule 40][Rule 40.1(i) and (ii)] shall apply *mutatis mutandis*.

[Rule 45bis.8(a), continued]

[COMMENT: Under this proposal, the supplementary Authority would make its own assessment of unity of invention and request any additional supplementary search fees in the same way as is done for the main international search, including the possibility of a payment being made under protest. The first option in square brackets represents the possibility of a protest procedure being included, equivalent to that which applies for the main international search. The second option would not permit a protest procedure. See paragraph 39 of the main body of the document.]

(b) In the case of a sequential supplementary search, the Supplementary International Searching Authority shall carry out a search on those inventions, as identified by the International Searching Authority, which have been indicated in the request under Rule 45bis.1(e), provided that the International Searching Authority has established an international search report and the necessary fees have been paid. If no indication is given in the request, the search shall be carried out on the first invention identified by the International Searching Authority. To the extent that the International Searching Authority finds a protest of the applicant under Rule 40.2(c) justified, the Supplementary International Searching Authority shall totally or partially refund any relevant additional supplementary search fee paid by the applicant in accordance with Rule 45bis.3(c).

45bis.9 Supplementary International Search Report

(a) The Authority carrying out a supplementary international search shall establish a supplementary international search report, or make a declaration pursuant to Rule 45bis.7(b) or (c) that no supplementary international search report will be established, within three months from the receipt of the request under Rule 45bis.1(a) or 22 months from the priority date, whichever is later.

[Rule 45bis.9(a), continued]

[COMMENT: A longer time limit would be permitted for the establishment of a supplementary search report than for the main international search, but it would be desirable for the report to be available, where possible, in time for any international preliminary examination.]

(b) For the purposes of establishing the supplementary international search report,

Rules 43.1, 43.2 and 43.4 to 43.10 shall, subject to paragraph (c), apply *mutatis mutandis*.

Article 20(3) and Rule 44.3 shall apply *mutatis mutandis*.

[COMMENT: 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 and that it would only include the newly found citations (except where a previously found document is considered relevant to inventive step in combination with a newly found document; see paragraph (c), below). The 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. The same requirement to send copies of the citations on request to the applicant or to a designated Office would apply as for the main international search.]

(c) In the case of a sequential supplementary search, the supplementary international search report shall not contain the citation of any document which was cited in the international search report, except to the extent that the document is considered relevant to the question whether the claimed invention involves an inventive step having regard also to one or more other documents which were discovered during the supplementary international search and which were not cited in the international search report.

45bis.10 Transmittal and Effect of the Supplementary International Search Report

(a) The Authority carrying out the supplementary international search shall, on the same day, transmit one copy of the supplementary international search report, or a declaration that no supplementary international search report shall be established because a situation referred to under Rule 45bis.7(b) or (c) exists, 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.

[COMMENT: See equivalent comment in Annex I.]

(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.

[COMMENT: See equivalent comment in Annex I.]

45bis.11 International Searching Authorities Prepared to Carry Out Supplementary

International Search

(a) The types of supplementary international search, if any, which will be performed, the documentation to be included in a supplementary international search and the conditions under which an International Searching Authority shall act as a Supplementary International Searching Authority shall be set out in the agreement under Article 16(3)(a) between the Office or organization and the International Bureau.

(b) The conditions in paragraph (a) may include limitations as to the subject matter for which such searches will be carried out, beyond those which would apply under Article 17(2) to an international search, or to the total number of supplementary international searches which will be performed in a given period.

Rules 53, 58, 66, 68; Schedule of Fees

[As in the proposals in Annex I]

[End of Annex II and of document]

WIPO



PCT/R/WG/8/5

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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)

Eighth Session
Geneva, May 8 to 12, 2006

MINIMUM REQUIREMENTS FOR INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES

Document prepared by the International Bureau

1. The Meeting of International Authorities under the PCT (PCT/MIA) held its twelfth session in Geneva from December 12 to 14, 2005. In the context of its discussions on the common quality framework for international search and preliminary examination, PCT/MIA discussed a proposal to amend Rule 36¹ to add a reference to the standards for quality set forth in Chapter 21 of the PCT International Search and Preliminary Examination Guidelines to the list of minimum requirements referred to in Article 16(3)(c) which any Office or organization must satisfy before it can be appointed and must continue to satisfy while it remains appointed as International Searching Authority.
2. The discussions at the twelfth session of PCT/MIA are outlined in document PCT/MIA/12/10, paragraphs 17 to 19, reproduced in the following paragraphs:

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”, “the national phase”, etc., include reference to regional laws, the regional phase, etc.

“17. The United States Patent and Trademark Office suggested to the Meeting that a proposal be developed for the amendment of Rule 36.1 by adding a new item (v) to the effect that, in order to satisfy the minimum requirements under Article 16(3)(c), “an Office or organization [seeking or holding appointment as an International Searching Authority] must adhere to the standards for ‘A Common Quality Framework for International Search and Preliminary Examination’ as set forth in Chapter 21 of the PCT International Search and Preliminary Examination Guidelines”. The Office believed that such an amendment would attach proper importance to the quality of international search and preliminary examination, thereby building confidence in the PCT system among Contracting States and encouraging Offices to rely on the results of the work of the International Authorities. The amendment would more clearly commit Authorities to the quality standards set out in Chapter 21 and would send a clear signal as to that commitment.

“18. Several Authorities indicated their support for a proposal along the lines suggested by the United States Patent and Trademark Office, some noting that further work on the detailed drafting of the proposed amendment would be needed. For example, one Authority suggested that it may not be appropriate to refer to “standards” in this context. Another Authority suggested that a more general reference to the Guidelines, mentioning the relevant particular requirements (resources, administrative procedures, feedback and communication channels), would be more appropriate in the Regulations.

“19. The Meeting agreed that a proposal along the lines of that set out in paragraph 17 should be further developed with a view to its submission by the Secretariat to the next session of the Working Group on Reform of the PCT, expected to be held in May 2006, and thence to the PCT Assembly for consideration at its next session, expected in autumn 2006. Interested Authorities were invited to make suggestions as to the drafting via the PCT/MIA electronic forum.”

3. The Annex to this document contains proposals to amend Rule 36 (“Minimum Requirements for International Searching Authorities”) and Rule 63 (“Minimum Requirements for International Preliminary Examining Authorities”) accordingly.

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

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²

MINIMUM REQUIREMENTS FOR INTERNATIONAL SEARCHING
AND PRELIMINARY EXAMINING AUTHORITIES

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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 36

Minimum Requirements for International Searching Authorities

36.1 *Definition of Minimum Requirements*

The minimum requirements referred to in Article 16(3)(c) shall be the following:

(i) to (iii) [No change]

(iv) [that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international search;](#)

[COMMENT: The common rules of international search must be applied and observed by all International Searching Authorities; see Article 16(3)(b); the agreements with the International Bureau, as approved by the PCT Assembly, under which all Authorities operate; and the PCT International Search and Preliminary Examination Guidelines, which form part of those common rules, and particularly Chapter 21 thereof which sets forth a Common Quality Framework for International Search and Preliminary Examination.]

(v) [that Office or organization must hold an appointment as an International Preliminary Examining Authority.](#)

Rule 63

Minimum Requirements for International Preliminary Examining Authorities

63.1 *Definition of Minimum Requirements*

The minimum requirements referred to in Article 32(3) shall be the following:

(i) to (iii) [No change]

(iv) that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international preliminary examination;

[COMMENT: The common rules of international preliminary examination must be applied and observed by all International Preliminary Examining Authorities; see Article 16(3)(b); the agreements with the International Bureau, as approved by the PCT Assembly, under which all Authorities operate; and the PCT International Search and Preliminary Examination Guidelines, which form part of those common rules, and particularly Chapter 21 thereof which sets forth a Common Quality Framework for International Search and Preliminary Examination.]

(v) that Office or organization must hold an appointment as an International Searching Authority.

[End of Annex and of document]