

# **PCT Supplementary International Search Service**

**(PCT Rule 45bis  
applicable from January 1, 2009)**

*Encouraging creativity and innovation*



**WORLD  
INTELLECTUAL  
PROPERTY  
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# Objectives

- To reply to PCT applicants' concerns about new prior art being found once they have already incurred significant costs and entered national phase
- To reduce this risk by introducing optional supplementary searches in the PCT international phase
- To expand the scope of search in the international phase taking into account the growing linguistic diversity in prior art

# Main Features

- An optional service for applicants,
  - it is currently offered by three Authorities: SE, RU and XN
  - more Authorities, including at least AT, EP and FI, are expected to offer the service in 2009-2010
- An applicant can request supplementary search by any Authority offering this service, except the one responsible for main international search
- Each Authority determines the scope and fees for its supplementary search
- Supplementary international search (SIS) covers only one invention – there is no option for paying additional fees

# Deciding When to Use the Service

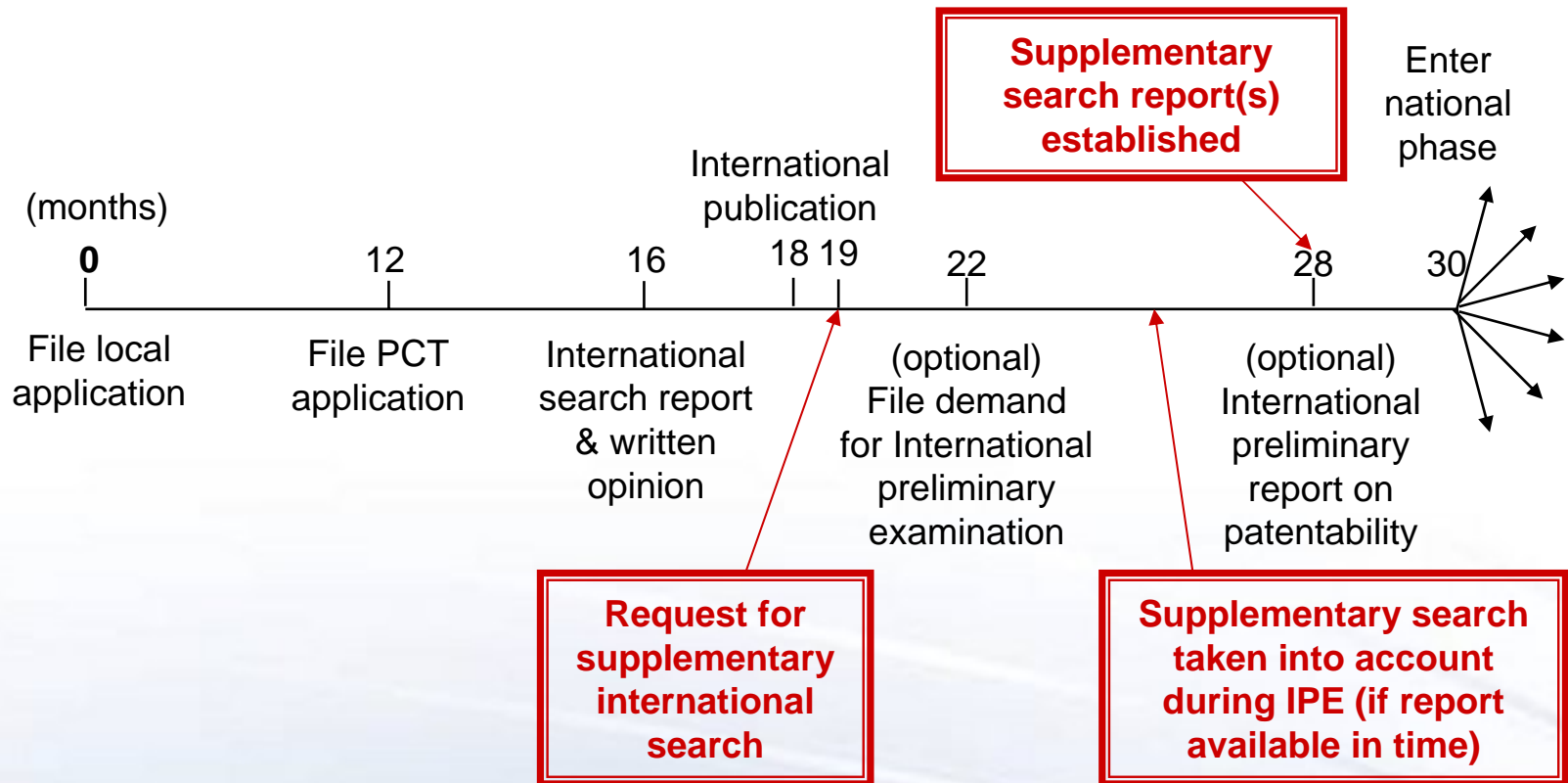
- The main international search report is intended to be of a high quality, sufficient for normal purposes
- Consequently, this service need not be used for every international application, but to give extra information in some cases where the applicant believes that this additional expense in the international phase will be worthwhile
- Before requesting supplementary search, applicants should consider:
  - the main international search report
  - the commercial value of particular application
  - the number of disclosures relevant to the particular technical field which are known to be made in languages that are not a speciality of the main ISA

# Timing and Fees

- The supplementary search request must be filed with the **International Bureau** within 19 months from the priority date
- Fees must be paid **in Swiss francs within 1 month** of filing the request:
  - supplementary search fee\*
  - supplementary search handling fee\*
- The Authority begins SIS on receipt of the request and international search report (ISR), or 22 months from the priority date, at latest, if the main ISR is late
- The SIS Report is established by 28 months from the priority date

*\*(see PCT Applicant's Guide, Annex SISA(RU),(SE),(XN)*

# SIS in the PCT System



# Supplementary Search Request (1)

- The request must be filed using the supplementary search request Form PCT/IB/375, specifying
  - which Authority is to carry out the supplementary search
  - (in certain circumstances - see Unity of Invention) which claims are to be searched
- The request may need to be accompanied by:
  - a translation of the international application into a language accepted by the Authority
  - any sequence listing in electronic format\*

\* (see *PCT Applicant's Guide*, Annex SISA(RU),(SE),(XN))

# Supplementary Search Request (2)

- There is no requirement that an agent be appointed to represent the applicant before the Authority specified for supplementary international search; applicants may, however, appoint an agent if they so wish
- A late payment fee may also apply if fees are not paid within one month and the IB issues an invitation to pay fees (Form PCT/IB/377)
- The request is considered withdrawn if the fees for supplementary search are not paid



# Unity of Invention

- Only one invention is searched – there is no option of paying additional fees for additional inventions
- Usually the first claimed invention is searched, but if the main ISA has found lack of unity of invention, the applicant may request supplementary search to focus on an invention other than the first
  - note that the Authority is not (usually) obliged to search inventions which have not been searched by the main ISA
- The Authority is not obliged to follow the views of the main ISA on unity of invention
  - a review procedure is available which is similar to the “protest” procedure for the main search

# Scope of Search (1)

- Supplementary search is carried out on the claims as filed, usually on the first claimed invention (Article 19 and 34 amendments are not taken into account)
- The Authority is not required to search:
  - subject matter which it would not normally search in accordance with Article 17(2)
  - claims which have not been searched by the main ISA
  - any international application which is subject to a limitation set out in the Agreement between WIPO and the Authority\* defining the scope of their service

\* (see [www.wipo.int/pct/en/access/isa\\_ipea\\_agreements.html](http://www.wipo.int/pct/en/access/isa_ipea_agreements.html))

# Scope of Search (2)

- The range of prior art to be searched is determined by the Authority
  - the search may be either a new search which takes into account all PCT minimum documentation as well as documents held in other languages by that Authority or
  - the search may be a complement to the main search, typically including a subset of language-related documentation held by that Authority

# Specific Services Available January 2009

- ISA/SE: supplementary search service
  - Includes at least the PCT minimum documentation, as well as documents in Swedish, Danish, Finnish and Norwegian held by the Authority.
- ISA/RU: two supplementary search service options
  - The first includes Russian-language documentation and certain other patent documentation of the former Soviet Union and CIS States
  - The second is only available for applications where the main ISA has made an Article 17(2)(a) declaration because of subject matter referred to in Rule 39.1(iv) (methods of treatment): Includes at least the PCT minimum documentation, plus the above
- ISA/XN: supplementary search service
  - Includes at least the PCT minimum documentation, as well as documents in Danish, Icelandic, Norwegian and Swedish held by the Authority.

# Supplementary International Search Report

- The supplementary international search report (Form PCT/SISA/501) is very similar to the ISR, but:
  - it does not contain the classification of the international application or comments on the title and abstract
  - it need not contain citations of documents contained in the ISR unless cited in conjunction with a new reference not cited in the ISR
  - it may contain explanations regarding:
    - citations that are considered relevant (these are more detailed than references in the ISR)
    - the scope of the SIS (particularly where the ISR is late and assumptions have been made on the likely scope of main search)
- No written opinion is issued with the supplementary international search report

# Refunds When No Search Is Carried Out

- If the Authority commences work, but no search is carried out for reasons equivalent to those available for the main international search (that is, subject matter, lack of clarity or lack of sequence listing in electronic format) or because the main ISA has made an Article 17(2)(a) declaration:
  - the supplementary search fee will not be refunded
- If the Authority commences work but no search is carried out because of limitations specific to the scope of the service offered by the Authority, the supplementary search request is considered not to have been submitted and:
  - the supplementary search fee will be refunded

# Further Processing of Report

- The supplementary international search report is transmitted to the applicant and to the IB
- The IB makes the report publicly available (if the international application has been published)
- If the report is not in English, it will be translated into English by the IB
- The IB sends the report and translations, where appropriate, to the IPEA and designated Offices

# Entry into the National Phase

- On the basis of the international search report and supplementary international search report(s) the applicant is in a better position to evaluate, with reasonable accuracy, the chances of successfully prosecuting a patent in the national phase and, consequently, whether the expense of translation and national phase entry is justified
- Designated Offices can have greater confidence in the results of the international phase - reducing the need for further national searches



# Transitional Arrangements

- The service does **not** require the international application to have been filed after 1 January 2009
  - Rather, the requirement is that the time limit for requesting supplementary international search (19 months from priority date) must not have expired by that date
  - Consequently, supplementary international search can be requested for any international application with priority date **on or after 1 June 2007**
- Similarly, when a new Authority offers the service, a request for supplementary search by that Authority can be made as long as **on the date of the supplementary search request** the Authority is offering the service and the time limit has not expired