

Supplemental searching and reliance on outside searches

FICPI/AIPLA Colloquium

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Supplemental Searching

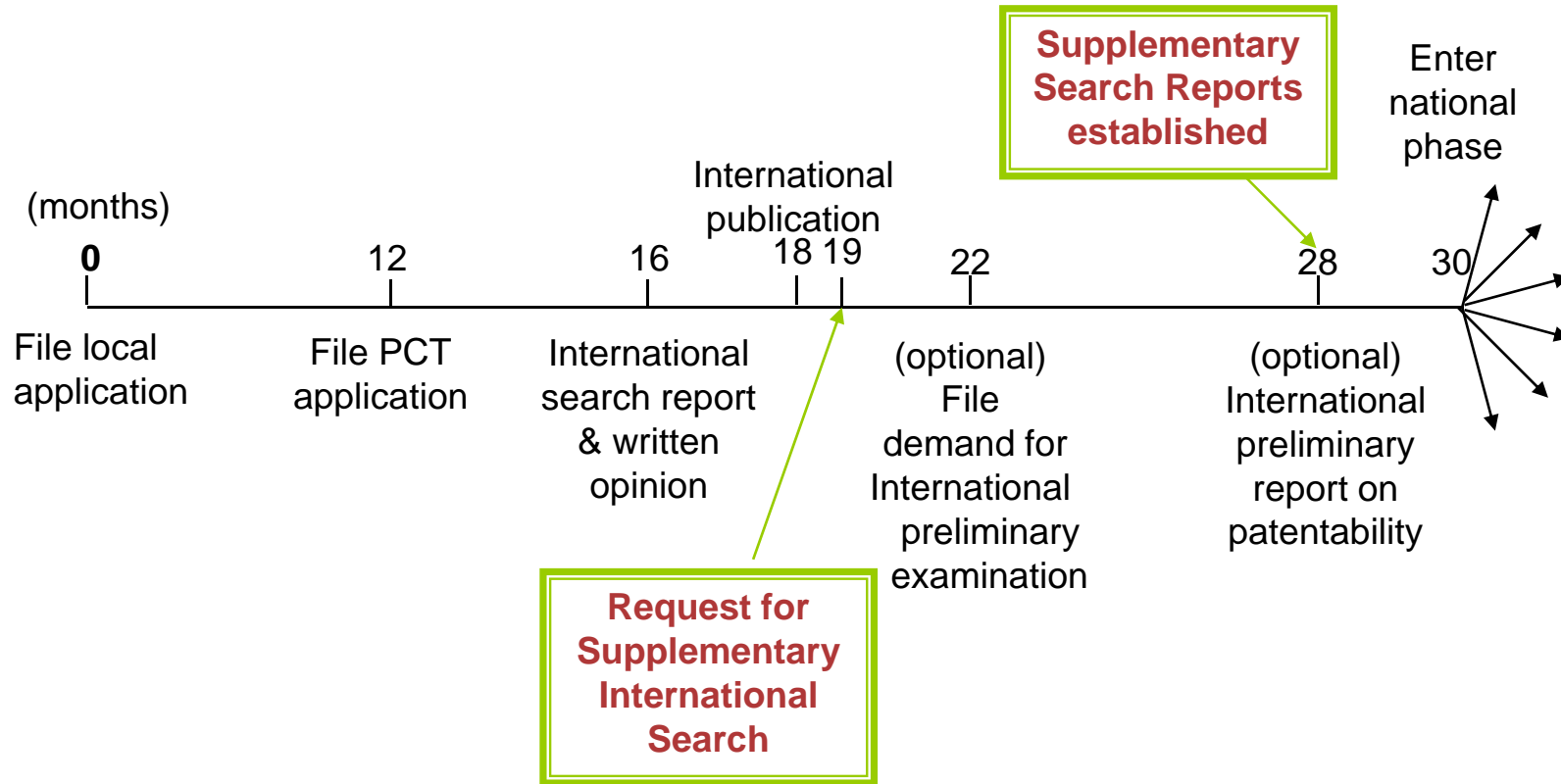
PCT

Other

Supplementary International Search under the PCT (1)

- give applicants option to request one or more supplementary (language-based) searches from participating ISAs in addition to the main PCT search
- help users by reducing risk of new prior art in national phase
- take into account growing linguistic diversity in the prior art
- Available since January 1, 2009 (PCT Rule 45bis)

Supplementary International Search under the PCT (2)



Supplementary International Search: Authorities

- NPI—Jan. 1, 2009
- RU—Jan. 1, 2009
- SE—Jan. 1, 2009—limitation to 1000 Supp. Searches/year
- FI—Jan. 1, 2010
- EPO—July 1, 2010, limited initially to 700 in first year

- AT—planned for 3rd quarter 2010
- AU—under consideration
- BR—Planned for 2011
- CA—no intention to offer in near future
- CN—considering offering in near future but will most likely limit the number of searches
- ES—no intention, but signs of possible reevaluation
- IN—unknown
- JPO—no intention
- KR—does not plan to offer in next few years due to workload
- US—no intention in near future due to workload

Another “PCT” Supplemental Search

- PCT has since the very beginning provided that applicants filing **national** applications could, if the national law so provides, request a competent PCT ISA to undertake an “international-type search” on the national application

Other Supplemental Searches (1)

- Noted with interest that the new USPTO Enhanced Examination Timing Control proposal (3 track examination) states that USPTO is considering offering an applicant the possibility of requesting and pay for a supplemental search from a participating intellectual property granting office.

Other Supplemental Searches (2)

“The USPTO is also considering negotiating with one or more intellectual property granting offices (IPGOs) to provide an optional service for applicants at the USPTO to request that the USPTO obtain from one or more IPGOs a supplemental search report. This supplemental search report will be considered in preparation of the first Office action on the merits by the examiner. An additional search will be conducted by the examiner at the USPTO. This option would be subject to the USPTO negotiating appropriate agreements with one or more IPGOs. The USPTO is also considering providing a short period for applicant to review and make any appropriate amendments or remarks after the supplemental search is transmitted prior to preparing the first action.”

Fed Reg. Notice, June 4, 2010

Reliance on outside searches (1)

- PPH proves that reliance on outside searches can be useful, desirable and assist in reducing unnecessary duplication
- PCT/PPH systems move this further
 - Trilateral PCT/PPH pilot
 - Extension of USPTO/KIPO PPH agreement to include bilateral PCT use
 - UK Office unilateral acceleration based on positive PCT reports

Reliance on outside searches (2)

- Quality will of course be a concern when considering relying on outside searches—which is precisely why quality must be shored up significantly as a collective manner across all offices—and certainly among all PCT ISAs

Collaborative Search

- The need for supplemental searches and reliance on “outside searches” can quite possibly be reduced significantly if we can move to a system where collaborative searches take place
 - the single search that is done via collaboration with other offices gives many of the benefits of supplemental searches
 - the collaborative search is “ours”—not “outside” but benefitting from “outside” resources and expertise
- PCT Roadmap and Pilot project (EP/US/KR)

THANK YOU!