

## Supplementary International Search

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The Patent Cooperation Treaty (PCT) allows a patent applicant to file a patent application, the subject matter of which is searched, and optionally examined, before any entry into the national stage in any country that is a party to the treaty. This allows an applicant to complete several of the processes that patent applications must traverse that are common to all countries for one fee. Thus, when the patent application enters the national stage, the applicant will have already reviewed references that were developed through the patent search performed by a PCT searching office.

There are several searching offices available to a PCT applicant when the PCT application is filed in the U.S. Patent and Trademark Office as PCT Receiving Office, one of which is the U.S. International Searching Authority (ISA/US). If the search is done in the ISA/US, any uniformity between the ISA/US and the U.S. Patent and Trademark Office (USPTO) examining corps can work to the advantage of the applicant because the references developed in the PCT search could be one and the same with the references ultimately cited against the patent application in the U.S. national phase. Even if the ISA/US is not the selected searching office, the applicant can still gain an advantage by having reviewed references and perhaps amended claims before entering the national stage. Some international searching authorities offer advantages such as lower fees and more comprehensive search results relative to other searching authorities.

Applicants also have the opportunity, during the PCT process, to amend their claims or add claims and have their amended and added claims examined. Depending on the authority performing the examination, and depending on the substance of any claim amendments, it is possible that further

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searching will be conducted based on the claim additions and amendments. Thus, a set of claims that could withstand national phase examinations could emerge from the PCT process. Conversely, so-called "knock out" art prior art emerging from the main or supplemental search warns a patent applicant to forego expensive national phase entries or to make such entries with appropriately limited claims.

According to PCT Rule 45bis ([http://www.wipo.int/pct/en/texts/rules/r45bis.htm# 45bis 1](http://www.wipo.int/pct/en/texts/rules/r45bis.htm#45bis_1)), any PCT application that has not reached its 19-month milestone as of January 1, 2009, is eligible for one or more supplementary searches on the original set of claims only, not claims that have been amended during the PCT process. If the applicant chooses to have a supplementary search performed, a new searching authority

must be chosen, thus guaranteeing a new examiner and a new look at the application, again, before it enters the national phase in any country. The supplementary search is currently offered by three authorities – Sweden, the Russia Federation, and Nordic Patent Institute -- with three other authorities – Austria, the European Patent Office, and Finland -- expected to offer the service in 2009-2010. A supplementary search request must be filed within 19 months from the priority date of the application (unless the main search is delayed in which case the request can be later than 19 months out but no later than 22 months), and fees must be paid within one month of the filing request. The search is begun, at the latest, 22 months from the priority date, and is completed 28 months from the priority date, i.e. before the 30-31 month various deadlines by which applicant must decide if and where to file national stage entries .

There are no reduced fees for the second search, and the different receiving offices charge different amounts for performing a search. If the initial search authority determines that there are multiple inventions claimed, only one invention is searched in the supplementary search, and, in this case, claims to be searched must be chosen. The supplemental searching authority can be requested to search the invention that was not searched by the initial searching authority. The supplemental searching authority may either search PCT minimum documentation and documents held in other languages by the searching authority (Sweden, Russia, or the Nordic Patent Institute), or complement the initial search by searching language-related documentation held by that searching authority (Russia). No written opinion is issued with the supplementary

search report, but explanations regarding citations that are considered relevant and the scope of the search may be included. No search is conducted, and no refund of fees is granted, if there is a lack of clarity, lack of sequence listing in electronic format, incorrect subject matter, or the initial searching authority has made an Article 17(2)(a) declaration. No search is conducted, but fees are refunded, if there are limitations specific to the scope of the service offered by the searching authority.

One advantage of the supplementary search is that the new searching authority can be chosen such that the examiners are native speakers of the language in which there is expected to be prior art for the invention being searched. Depending on the search authority chosen, a translation may have to be provided.

Some representative fees for the supplementary search described herein, as of January 1, 2009, and subject to change over time are as follows. Russian Federation: \$350-\$500 USD, Swedish Patent and Registration Office and Nordic Patent Institute: \$2,440 USD. Each supplementary search incurs a processing fee of about \$180 USD. These are in addition to counsel fees for managing the process and analyzing and reporting the impact of the references on the invention's prospects.

In summary, a supplementary search can be useful if the technology references are mainly found in the native language of the supplemental searching authority, if there are multiple inventions, or if a search from a different examiner is desired. The modest upfront investment in supplemental searching can pay large dividends when proceeding (or not proceeding) to more expensive steps of the national phase with a more complete perspective on state of the art.

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