

January 2, 2006

Mr. Francis Gurry  
Deputy Director General  
World Intellectual Property Organization  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland

RE: Supplementary International Searches

Dear Francis:

I am writing in response to the invitation to comment in regard to WIPO paper PCT/MIA/12/2 dated November 25, 2005. I wish to express the support of the American Intellectual Property Law Association (AIPLA) for the included proposals that would enable applicants under the Patent Cooperation Treaty (PCT) to optionally obtain supplementary searches, during Chapter I of the international processing phase, from International Authorities other than the Authority that performs the “main” international search.

AIPLA is a national bar association whose nearly 17,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

PCT/MIA/12/2 presents a set of proposals and options for implementing a system of optional supplementary searches within the PCT framework. Applicants would have the option to request one or more searches by International Authorities other than the International Search Authority that performs the main international search, in an effort to locate prior art in languages or technologies that might not otherwise be considered by the main Authority.

The possibility of obtaining supplementary searches has been discussed for some time. At both the sixth and seventh sessions of the Working Group on Patent Reform, strong support was expressed by representatives of users for such a concept. Supplementary searches, carried out during the international phase, would benefit applicants, Offices, and third parties by more completely identifying the most relevant prior art at the earliest time possible. This would permit

applications to be amended or abandoned in a cost-effective manner and would reduce the likelihood that invalid patents will be granted.

No single Office is capable of thoroughly searching and fully considering disclosures written in all languages, and no single Office can specialize in every possible technology. Consequently, there is a greater likelihood that all relevant prior art will be located and that the relevance of such art will be appreciated if more than one International Search Authority performs a search.

In addition, applicants are often faced with art that surfaces for the first time when an international application enters the national phase. Allowing applicants to request additional international searches should reduce or eliminate the need for designated or elected Offices to repeat a search during the national or regional phase. This would be a clear benefit both to applicants and to the national and regional Offices.

The WIPO document discusses the merits of either concurrent, sequential, or a combination of concurrent and sequential searches. AIPLA believes that sequential searches would be most likely to maximize the value of the additional searches at the least cost and with the minimum disruption to international processing. A sequential search would truly be additive to the underlying main search, and would reduce or eliminate duplicative work among search Authorities. The supplementary search, following a main search, could concentrate on only search material that would complement, not duplicate, material already searched. To the extent that an applicant considered the main search, once received, to be sufficiently complete, there would be no need to request and pay for supplementary searches. In addition, it is necessary that supplementary Authorities have available to them the main search, if they are to incrementally improve the quality of the overall search product.

In summary, AIPLA supports, in principle, provisions under the PCT for supplementary searches that would include the following attributes:

- Applicants would be free to commission supplementary searches from as many participating Authorities as the applicant wishes;
- Requests for supplementary searches would be made through the International Bureau;
- Supplementary searches would follow and not be concurrent with the main search;
- Supplementary searches would complement rather than duplicate the main search, focusing primarily on documents that were not or could not be fully considered by the main Authority;
- Fees for supplementary searches would be commensurate with the reduced scope of the searches, i.e., would be substantially less than the primary search fee;
- Supplementary Authorities would focus on the invention that was the subject of the main search to avoid conflicting conclusions regarding unity of invention;
- Supplementary Authorities would prepare a search report but would not develop a full written opinion; and
- Supplementary search reports would be published by making them available to the public on the Internet.

AIPLA understands that the International Bureau is preparing, with guidance from the International Authorities, a set of proposals and draft rules that will be discussed at the eighth session of the Working Group on Reform of the PCT, scheduled to meet during the spring of 2006. To the extent that the views expressed and attributes discussed above are reflected in the discussion draft, AIPLA would be generally receptive to and supportive of such a draft. We will consider commenting on specific proposed rule changes when the discussion draft is released by the International Bureau.

Thank you for the opportunity to comment on this important topic.

Sincerely,

A handwritten signature in black ink that reads "Mike". The signature is written in a cursive, slightly slanted style.

Michael K. Kirk  
Executive Director  
AIPLA