



Amendments to the PCT regulations – July 2014

Amended Regulations under the Patent Cooperation Treaty (PCT) came into force on 1 July 2014. This article summarises the key changes that have been implemented.

1. Mandatory top-up searches as part of International Preliminary Examination (Rules 66 & 70)

- Previously, regional or national Patent Offices, when examining ex-PCT applications, would sometimes carry out a “top-up” search to find any prior art not published at the time of the International Search (IS), or where the IS was not considered to be sufficient.

What has changed?

- In an attempt to improve the quality of the International procedure, each International Preliminary Examination Authority (IPEA) will now be required to perform a top-up search during International Preliminary Examination (IPE), should IPE have been requested.
- It is important to note that IPE remains an optional examination procedure during the International phase; a top-up search will not be undertaken where no IPE is requested.
- Exceptions will apply – for example, where the IPEA considers that a top-up search would serve no useful purpose or where the claims of the patent application relate to subject matter not searched by the IPEA.
- The changes will apply to any International applications for which a demand for IPE is filed on or after 1 July 2014.

- Applicants can now amend their application during the International phase to overcome new cited prior art (i.e. prior art not cited in the first IS), potentially leading to cost savings and quicker grant in the regional or national phase.

2. Making the Written Opinion by the International Searching Authority publicly available from the date of international publication (Rules 44ter & 94)

- The Written Opinion of the International Searching Authority (ISA) was previously not made publicly available before 30 months from the priority date of the application.
- The application documents and the International Search Report (ISR) were made available at 18 months from the priority date i.e. from the international publication date.

What has changed?

- The Written Opinion will now be made publicly available from 18 months from the priority date.
- The Written Opinion of the ISA and any comments will be made available on the International PATENTSCOPE search system in their original language from the international publication date.

■ The International Preliminary Report on Patentability (IPRP) and any translations will continue to be made available from 30 months from the priority date.

■ These changes will apply to all international applications filed on or after 1 July 2014.

3. Modifications to PCT Forms

What has changed?

Modifications have been made to the following PCT forms:

■ PCT/ISA/220 (Notification of Transmittal of the International Search Report and the Written Opinion of the International Searching Authority, or the Declaration).

■ This form has been modified to include a reminder about the time limit and procedures for requesting Supplementary International Search.

■ PCT/IPEA/409 (International Preliminary Report on Patentability (Chapter II of the Patent Cooperation Treaty)).

■ This form has been amended to introduce in Box No. I (item 6) a new item which allows the IPEA to indicate a) the date on which a top-up search was carried out b) whether additional relevant documents have been discovered, or c) to state that no top-up search was carried out because it would serve no useful purpose.

The modified forms, in PDF format, are available to [download here](#).

For further information or advice concerning any of the changes discussed in this article, please contact your usual A.A. Thornton & Co. adviser.

Contact

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