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30 January 2012

Dear Mr Matthes

### **Review of the Supplementary International Search System**

We refer to James Pooley's letter of 15 December 2011, reference C.PCT 1329, to which responses were invited by 31 January 2012.

The IP Federation represents numerous patent-intensive UK companies (list attached). Collectively, our members are heavy users of the PCT.

We note that only 33 requests for Supplementary International Search (SIS) had been filed in 2011 by the date of Mr Pooley's letter. The reason why our members have not used the SIS service is simple: though the service is good in principle, the most useful International Authorities (for our members) have not signed up. Our members use the EPO as their ISA, so that the availability of the EPO as a SISA, though commendable, is not of interest to them. The other International Authorities who have signed up (RU, XN, SE, FI, and AT) are not very likely to find prior art which has not already been cited by the EPO, save in the case where the EPO's search strategy was poor. However, if the other IP5 Offices signed up (USPTO, JPO, SIPO, and KIPO), then the SIS would be of much more value to our members. The USPTO, for reasons of history, finds prior art that the EPO does not (and *vice-versa*), and SIPO, JPO, and KIPO are in any case more able to find documents in their own national languages than the EPO and the USPTO.

For many applicants, knowledge, *before* the national and regional phases are due, of the prior art that *all* the IP5 Offices can find would be of great value. With such knowledge, they could -

- avoid work for themselves, and eliminate later work by Patent Offices, by abandoning inventions altogether (*i.e.* by not entering the national/regional phases);
- *enter* the national and regional phases with claims that have been amended to be valid over the prior art of all the IP5 Offices, thereby saving prosecution costs for themselves and reducing the workload of the

Offices in considering amendments that are at present *made during* the national and regional phases;<sup>1</sup> and

- avoid (for instance) commencing litigation on a granted US patent only for the JPO examiner later to find serious prior art that brings the litigation into question.

Therefore, the Federation urges the other IP5 Offices to become SISAs. Even better would be the involvement of all the IP5 Offices in Collaborative Search and Examination, of which the EPO, the USPTO, and KIPO are running a pilot (see our Policy Paper [PP01/12](#), a copy of which has already been sent to WIPO, but of which another copy is attached for your convenience).

We hope that this response is useful to you. Please do not hesitate to contact us if you require further comment.

Yours sincerely

David England  
European Patent Attorney  
Secretary, IP Federation

Enc.: Policy Paper [PP01/12](#)

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<sup>1</sup> An example of inefficiency in the present system is the following. One of our members had used the EPO as ISA for the PCT, and had prosecuted a US(PCT) application to the point where the Examiner was content to allow it. The JPO then cited some relevant prior art against the JP(PCT) application, and our member had to ask the USPTO not to allow the application so that the US Examiner could consider the JPO's prior art. (Had the JPO been a week or so slower in citing the prior art, the applicant would have had to consider post-grant amendment of the US patent.)



## **IP Federation members 2012**

The IP Federation represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. Its membership comprises the innovative and influential companies listed below. Its Council also includes representatives of the CBI, and its meetings are attended by IP specialists from three leading law firms. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

ARM Ltd  
AstraZeneca plc  
Babcock International Ltd  
BAE Systems plc  
BP p.l.c.  
British Telecommunications plc  
British-American Tobacco Co Ltd  
BTG plc  
Caterpillar U.K. Ltd  
Delphi Corp.  
Dyson Technology Ltd  
Eli Lilly & Co Ltd  
ExxonMobil Chemical Europe Inc  
Ford of Europe  
Fujitsu Services Ltd  
GE Healthcare  
GKN plc  
GlaxoSmithKline plc  
Hewlett-Packard Ltd  
IBM UK Ltd  
Infineum UK Ltd  
Merck Sharp & Dohme Ltd  
Microsoft Limited  
Nokia UK Ltd  
Nucletron Ltd  
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