

# אפשרויות חיפוש נוספות בבקשות PCT Additional Search Options for PCT Applications

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**New PCT Rule provides the PCT applicant with the opportunity to request a supplementary international search beyond the main International Search carried out by the International Searching Authority (ISA) for the applicant's patent application. A supplementary search may be of advantage in many cases.**

On January 1, 2009 a new PCT Rule<sup>1</sup> came into force which makes available a new supplementary international search (SIS).

This is a new service intended to cater to the needs of many PCT applicants. It allows applicants to request additional international search(es) beyond that performed by the patent office designated as the International Search Authority (ISA) in the application.

The SIS is offered by three Patent Offices having the right to function as ISA: the Patent Federal Service of the Russian Federation, the Swedish Patent Office and the Nordic Patent Institute<sup>2</sup>.

Additional Patent Offices will likely offer SIS services as of 2010. It should be noted that it is possible to request more than one SIS.

Performance of a main international search and the issuance of an International Search Report (ISR) is an integral part of the PCT process.

תקנה חדשה של אמנת ה-PCT, אשר נכנסה לתוקף ב-1 בינואר 2009, מאפשרת למבקש בקשת PCT, לבקש חיפוש בינלאומי נוסף על החיפוש הבינלאומי העיקרי שמבוצע על ידי רשות החיפוש הרשמית של הבקשה. חיפוש נוסף כזה יכול להיות בעל חשיבות במקרים רבים.

ב-1 בינואר נכנסה לתוקפה תקנה חדשה לתקנות ה-PCT (Rule 45bis) שעניינה אופציה לחיפוש בינלאומי נוסף: SIS-Supplemental International Search. מדובר בשירות חדש, אשר בא לענות על צורך של מבקשי בקשות PCT רבים. הוא מאפשר למבקש לבקש חיפוש נוסף מעבר לזה אשר מבוצע על ידי משרד הפטנטים, אשר מיועד בבקשה כמשרד המחפש הבינלאומי (ISA). בשלב זה ה-SIS ניתן על ידי שלשה משרדי פטנטים: משרד הפטנטים של הפדרציה הרוסית, משרד הפטנטים השוודי ומכון הפטנטים הנורדי<sup>2</sup>. משרדי פטנטים נוספים כנראה יציעו את שירות ה-SIS בשנת 2010. יש להדגיש שניתן להגיש בקשה ליותר מ-SIS אחד.

בהתחשב במשמעות הרבה של מידע אמין על הידע הקודם לעניין החלטות אסטרטגיות הקשורות בבקשה לפטנט ובטכנולוגיה בכלל, ובהתחשב בכך ששום חיפוש, אף לא זה המבוצע על ידי משרד פטנטים שידוע באיכות החיפושים שהוא עורך, כמו משרד הפטנטים האירופי, אינו יכול להיחשב כמושלם, יש לשקול לבקש SIS במקרים מסוימים. במיוחד יש טעם לשקול לבקש חיפוש ממשרד הפטנטים של הפדרציה הרוסית, שכן משרד זה ידוע באיכות החיפושים שהוא מבצע. כמו כן, פטנטים המוגשים רק בשפה הרוסית ותעודות מציא שניתנו בתקופה הסובייטית לא תמיד זמינים לחיפושים שיערכו במקום אחר.

דיון מעט נרחב יותר בעניין מופיע בסיכום באנגלית להלן <

The search is performed by an ISA. Israeli applicants can choose between the following ISAs:

- European Patent Office (EPO); and
- United States Patent and Trademark Office (USPTO)

Given quality and diligence with which the search is performed, the choice made by many (if not most) Israeli applicants is the EPO.

Choosing the EPO has the added advantage in that its search results are acknowledged and that most of the search costs are credited when filing a European application at the EPO, on the basis of the PCT application. An international search is important as it provides the applicant with an independent opinion on patentability and permits the applicant to become better prepared for prosecution in the international and in the subsequent national phase proceedings.

No search, even one conducted at the highest standards, can ever be regarded as complete; this includes the search that is carried by the EPO in its capacity as the ISA (although the searches conducted by the EPO are generally recognized as being of high quality and of broad coverage since searches are performed among documents in several languages including English, German and French). There is thus an added value in requesting an SIS as a good understanding of the art provides a better framework for planning the future patent strategy, including national phase filings and subsequent prosecution of the patent application through to the grant.

Additional searches will reduce the risk that the applicant may be confronted with previously unknown citations during national phase filings. Of particular interest is the SIS that may be provided by the Russian Patent Office. The Russian Patent Office has a very extensive patent library and the searches conducted there are considered to be of high quality.

Moreover, many patent applications that are filed in the Russian language as well as author certificates that were granted during the communist era may not surface in searches conducted by the EPO but may surface in a search conducted by the Russian Patent Office. Thus, an SIS by the Russian Patent Office should be considered in some cases. The Swedish Patent Office is also considered to be a quality searching authority.

Requests for SIS need to be filed at the International Bureau (IB) in Geneva within 19 months from the priority date of the applicant's patent application and require payment of fees depending on the selected Patent Office. Applicants considering requesting SIS should discuss the matter with the patent attorney handling their case.

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<sup>1</sup> Rule 45bis

<sup>2</sup> A patent authority established in 2007 by Denmark, Norway and Iceland.

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