

WIPO



PCT/MIA/10/6 Add.1

ORIGINAL: English only

DATE: August 11, 2004

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PATENT COOPERATION TREATY (PCT)**

**Tenth Session
Geneva, September 13 to 15, 2004**

**ENHANCED INTERNATIONAL SEARCH AND
PRELIMINARY EXAMINATION SYSTEM:
REPORTING PARTIAL SEARCH AND EXAMINATION**

Document prepared by the International Bureau

SUMMARY

1. Annex I of document PCT/MIA/10/6 sets out issues which must be addressed when the international application cannot be searched in whole or in part. This document presents further issues which may arise when an international search has been conducted and a written opinion has been established for one or more claims, but the scope of the search and opinion does not extend across the full breadth of the claims.

BACKGROUND

2. The PCT International Search and Preliminary Examination Guidelines (“the Guidelines”) recognize that, in certain cases, it may not be possible to perform a search across the full breadth of a claim. Examples of such situations include some “complex” applications where the claim includes too many variations for it to be searched exhaustively; claims characterized solely by the result to be achieved and other cases where the limited range of options disclosed might not make clear how the invention can be worked across the full scope of the claim; and (as set out in an example in Annex I of document PCT/MIA/10/6) cases where the defining feature of a claim relates to subject matter excluded from search and examination, with the remaining technical matter being trivial.

E

3. Paragraphs 9.19 to 9.25 of the Guidelines give guidance on such cases, including the following:

“9.19 There may be exceptional situations where the description, the claims or the drawings fail to comply with the prescribed requirements to such an extent that a meaningful search cannot be carried out, that is, no search at all is possible for a particular claim (see paragraph 9.01). However, in certain situations where the description, the claims, or the drawings can be sufficiently understood, even though a part or parts of the application are not in compliance with the prescribed requirements, a search is performed taking into consideration the non-compliance in determining the extent of the search. In such cases, the written opinion then indicates how the description, claims, or drawings fail to comply with the prescribed requirements. In this indication, it is also noted by the International Searching Authority to what degree that non-compliance with the particular prescribed requirements has been taken into account for the purposes of determining the extent of the search, and this extent is indicated as precisely as possible.”

ISSUES

4. While paragraph 9.19 requires that the extent of the search should be noted, it is not clear exactly how this should be done. Box No. II of Form PCT/ISA/210 (International Search Report) and Box No. III of Form PCT/ISA/237 (Written Opinion of the International Searching Authority) (both reproduced in the Annex to this document) are usually the appropriate places for indicating limitations on the scope of search and examination for reasons other than lack of unity of invention. However, these are drafted only in terms of the case where the indicated claims are not searched at all, rather than a search being carried out which may not cover the entire scope of the indicated claims.

5. Boxes No. V (reasoned statement concerning novelty, inventive step and industrial applicability), VII (defects in form or contents of the international application) or VIII (observations on clarity of the international application and support of the claims by the description) of Form PCT/ISA/237 could be used to explain the extent of the search and the defects which caused the limitation. However, this does not seem consistent with the treatment of other limitations in the international search and may not give due prominence to a significant issue, though it should be recalled that observations relating to clarity, lack of support and inventive step may be intimately associated with the reasoning for the search not covering the full scope of the claim.

6. A second issue is that the advice is not consistent with the principles set out in paragraph 15.29 for the case where no search at all is conducted for some of the claims. There the reasons for the claims not being searched are set out as part of (or instead of) the international search report (and will usually merely be referred to in the written opinion). Setting out the reasoning in the international search report or the declaration under Article 17(2) means that third parties who read the pamphlet are aware of the limitations of the international search report and the reasoning behind them. Reasoning which is set out in the written opinion will usually not become available until 30 months from the priority date and then will not be seen in conjunction with the international search report, which may result in the contents being misleading.

OPTIONS

7. It may be desirable to modify Box No. II of Form PCT/ISA/210 and Box No. III of Form PCT/ISA/237 to provide for an indication that certain claims may not have been searched across their full scope and giving reasons.

8. Alternatively, it may be preferred to give better guidance in the PCT International Search and Preliminary Examination Guidelines as to how to present information concerning the extent of the search in Form PCT/ISA/237, noting that the information in this case would not be as readily accessible to third parties interested in the international search report since it would not be published in the pamphlet.

9. The Meeting is invited to consider the appropriate handling of international applications where an international search is carried out on some or all claims, but does not extend across the full breadth of those claims.

[Annex follows]

ANNEX

EXTRACTS FROM FORMS PCT/ISA/210 (INTERNATIONAL SEARCH REPORT) AND
237 (WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY)

INTERNATIONAL SEARCH REPORT

International application No.

Box No. II Observations where certain claims were found unsearchable (Continuation of item 2 of first sheet)

This international search report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

1. Claims Nos.:
because they relate to subject matter not required to be searched by this Authority, namely:

2. Claims Nos.:
because they relate to parts of the international application that do not comply with the prescribed requirements to such an extent that no meaningful international search can be carried out, specifically:

3. Claims Nos.:
because they are dependent claims and are not drafted in accordance with the second and third sentences of Rule 6.4(a).

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No. _____

Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

- the entire international application
- claims Nos. _____

because:

- the said international application, or the said claims Nos. _____ relate to the following subject matter which does not require an international preliminary examination (*specify*):

- the description, claims or drawings (*indicate particular elements below*) or said claims Nos. _____ are so unclear that no meaningful opinion could be formed (*specify*):

- the claims, or said claims Nos. _____ are so inadequately supported by the description that no meaningful opinion could be formed.

- no international search report has been established for said claims Nos. _____

- the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:

the written form has not been furnished
 does not comply with the standard

the computer readable form has not been furnished
 does not comply with the standard

- the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-*bis* of the Administrative Instructions.

- See Supplemental Box for further details.