

WIPO



PCT/MIA/I/2

ORIGINAL: English

DATE: December 13, 1989

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

**MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PCT**

**First Session
Geneva, January 15 to 19, 1990**

CONSIDERATION OF REPORTS BY THE INTERNATIONAL AUTHORITIES
CONCERNING THEIR PRACTICE AND EXPERIENCE AS
INTERNATIONAL SEARCHING AND/OR
PRELIMINARY EXAMINING AUTHORITIES

Document compiled by the International Bureau

1. With Circular C. 360, dated September 4, 1989, the offices which act as International Searching Authorities and/or International Preliminary Examining Authorities under the Patent Cooperation Treaty (PCT) have been invited to prepare a report concerning their practice and experience as such Authorities for consideration at the Meeting of International Authorities under the PCT.
2. The Annexes to this document contain the reports which have been submitted by the Australian Patent Office (Annex A), the Austrian Patent Office (Annex B), the Japanese Patent Office (Annex C) and the Swedish Patent Office (Annex D). Should further reports be received after the publication of this document, they will be distributed at the meeting.

[Annexes follow]



FROM THE
COMMISSIONER OF PATENTS

PATENT OFFICE, PHILLIP OFFICES
CANBERRA, A.C.T. 2606
TEL. 63 2000

5th December 1989

Dr. Arpad Bogsch
Director General
WIPO
34 chemin des Colombettes
1211 Geneva 20
SWITZERLAND

Dear Dr. Bogsch,

The International Searching and Preliminary Examining Authorities have been invited to provide reports on their experiences (Circular C360 PCT/211 dated 4 September 1989).

It is understood that the main purpose of these reports is to contribute to a discussion of problems that have been noted in the operation of the PCT system or improvements that could be made to it.

Annex I to this document contains material that the Australian Patent Office wishes to contribute in that context. Matters already covered in documents PCT/MIA/I/4 and /6 have been excluded from this material.

Annex II to this document is directed to providing information of the kind provided for the PCT International Meeting held in Tokyo from 25 to 29 May, 1981.

Yours sincerely,

P.A. Smith

Annex I

SUGGESTIONS FOR CONSIDERATION.

Item 1. PRIORITY DOCUMENTS UNDER THE PCT

1. One aspect of processing an international application which remains cumbersome for the applicant and the International Bureau (IB) is the provision of copies of priority documents by the IB, and of translations thereof by the applicant at national phase entry. It is arguable that, since there are relatively few applications in which a citation arises which was published between priority date and filing date, in most instances it is not necessary to determine the priority date prior to grant, and therefore the priority document (and its translation) should not be required for national processing.

2. On this basis it is suggested that the ISA and IPEA could contribute to identifying the real needs as in the following proposal. This proposal is intended to promote discussion of the issue, and it is not suggested that it could necessarily be implemented without difficulty.

3. It is suggested that, as part of the search report, the searcher includes a statement as to whether priority date consideration is or is not relevant to any document cited in the international search report. This could be done without inspecting the priority document since all that is required is identification of a citation published after the priority date but before the filing date.

Where it is relevant, the IB would send a copy of the priority document to the designated Offices as at present, and the applicant would still be required to provide a translation.

Where it is not relevant, the IB would supply a copy of the priority document only upon request by any designated Office during national processing, and the applicant would not be required to supply a translation unless specifically requested during national processing.

4. It is also suggested that, where the application is subject to international preliminary examination, the examiner could be required to include in the international preliminary examination report either or both of the following:

- a) a statement as to whether priority date consideration is or is not relevant to any document cited in the international

examination report.

Where it is relevant, the IB would send a copy of the priority document to the elected Offices (if it had not already done so), and the applicant would still be required to provide a translation.

Where it is not relevant, the IB would supply of a copy of the priority document only upon request by an elected Office during national processing, and the applicant would not be required to supply a translation unless specifically requested during national processing.

b) express an opinion on the validity of the priority claim with respect to the claims upon which the report is established.

Where the priority claim is valid, it would not be necessary for either a copy of the priority document or a translation to be filed unless specifically requested during national processing.

Where the priority claim is not valid, the IB would send a copy of the priority document to the elected Offices (if it had not already done so), and the applicant would still be required to provide a translation.

Item 2: UNIFORMITY OF SEARCH STANDARDS

5. One of the fundamental tenets of the PCT system is that it provides the applicant and others with a search report based on specified minimum documentation and from which the likely outcome of national processing in any designated state can be determined. There are, however, a number of searching authorities, and although all of these have regard to the minimum documentation in conducting a search, the actual documentation searched varies from one authority to another because of the availability of different facilities [Art 15(4)] or for language reasons [Rule 34(e)]. It is evident to any user that a given search report will be treated differently during processing by the various national offices, some requiring another search to be undertaken (often incurring additional expense to the applicant), and others not requiring any further search.

6. Although the desirability of a uniform and high standard of search is manifest, the PCT system does not provide any mechanism whereby these aspects can be ascertained and furthered.

7. It is suggested that each national office be invited to communicate to the relevant search authority, preferably informally, any useful experiences revealed during national processing of the particular international application. This would enable the searching authority to monitor, and thus further develop, its own search standard. It would be envisaged that

useful experiences would only encompass, for example, the discovery of a significant document not included in the search report but exclude documents which are merely of equivalent merit or significant only because of particular national law. The communication need be no more than, for example, a copy of the national search report.

Item 3: REFUND OF THE INTERNATIONAL FEE IN CERTAIN CASES

8. In document PCT/MIA/I/6 consideration is given to refund of the handling fee in certain cases. It would seem desirable to consider as well the desirability of a comparable refund of the international fee in certain cases. Under Rule 15.6 the international fee is refundable where the Article 11 determination is negative and in no other case. On occasions it has been found that the applicant wishes to withdraw the application shortly after filing, and to refile the application with a redrafted specification and/or claims. Such withdrawal has been desired even before or shortly after the record copy has been transmitted to the International Bureau. It appears to be not quite justified for the International Bureau to keep the international fee paid by the applicant who withdraws the application promptly after filing. In such cases there is in fact no or very little processing by the International Bureau, and it would appear justified to refund the fee. This is particularly apparent where another applicant chooses not to pay the international fee until after filing of the application, (as is permitted under Rule 15.4), and who has the option to subsequently withdraw the application without ever paying the fee. The availability of a refund would also encourage any applicant who has lost interest in an application at an early stage to withdraw it rather than allow processing of it to proceed and for it to be subsequently considered withdrawn (for example under Rule 29). It is added that the Australian Searching Authority allows a full refund of the search fee in such cases.

9. It is suggested (on a parity with what is proposed in para 29 of document PCT/MIA/I/6) that Rule 15.6 be amended by allowing a refund of the international fee in cases where the fee has been paid but the application is withdrawn before the international fee is transferred by the receiving Office to the International Bureau.

Item 4: NON-PATENT LITERATURE

10. It is considered that the present list of non-patent literature includes many items which do not yield a significant number of citations in the search process. Likewise, it may be that some International Searching Authorities include other unlisted items in the search because they yield valuable citations, but which may not be listed because the number of items already included in the list already appears excessive.

11. It is suggested to address this issue as follows :-

For a period of 12 months, each ISA will include the PCT list number in international search reports as part of the citation information for each non-patent literature citation.

The International Bureau will collect statistical information from these reports on the incidence of citations from particular items, and prepare a report as a basis for revision of the current list.

12. It may also be that some currently listed items do not require individual listing since they are adequately included by Chemical Abstracts. In order to distinguish this source of citations, it is suggested that any citation resulting from a search of Chemical Abstracts be so indicated even where the item is itself included in the minimum listing.

Item 5: INTERNATIONAL SEARCH REPORT

a) Multiple Categories

13. The manner of indicating categories of cited documents is not sufficiently explicit where a cited document is allocated more than one category. It is often difficult for a reader of the search report to associate the category, the claims, and the particular parts of the document for each category indicated.

14. It is suggested that the report would be more informative and useful to any reader including the applicant, national offices, and the public generally if this difficulty could be overcome.

15. It is suggested that Part 5 of the Administrative Instructions specify that where more than one category is indicated for a cited document, then each category, the relevant claims, and the relevant passage be separately indicated in the report. This would be assisted by the rearrangement of Box III of the international search report form to place the category column adjacent to the relevant claim column.

16. Some examples of how this could be achieved are given at Appendixes 1 and 2.

b) Multiple "Y" Category combinations

17. The manner of indicating multiple groups of "Y" category cited documents is not sufficiently explicit. Where several cited documents are to be grouped in category "Y", it is often difficult for a reader of the search report to determine whether the cited documents form a single group or several groups.

18. It is suggested that Section 505(c) of the Administrative Instructions be altered to require that, where there is more than one combination of documents, the particular combinations be identified by the use of a numeric qualifier with the "Y" indication. By way of explanation, category "Y1" would be indicated for each document in the first combination, "Y2" for each document in the second, etc.

19. In conjunction with the proposal in para 15 above, the usefulness of the search report would be enhanced greatly since the relationship of categories, documents, and claims would be readily apparent to any reader. It follows that each numeric combination or grouping of documents could relate to a single set of claims only.

c) Single "Y" Category Documents

20. It is observable that search reports occasionally include a single cited document indicated as category "Y". Since category "Y", as defined in Section 505(c), requires that there be at least two documents in combination, the reader is unable to determine easily whether other documents exist but have not been included in the report (eg typographic error) or whether "X" category should have been indicated.

21. It is suggested that perhaps an explanatory footnote could be added to Section 505(c) to minimise this difficulty - for example "Note: "Y" category cannot be indicated for one document alone."

d) Rule 43.5(e)

22. During national processing it frequently occurs that a document cited in an international search report requires considerable perusal to identify relevant or particularly relevant passages therein. It is assumed that this arises either because the requirements of Rule 43.5(e) have been overlooked during preparation of the international search reports, or because the present wording of that rule appears to exclude any identification where the whole document is relevant (or particularly relevant).

23. However, it may be that this is not the whole story and what is needed is an instruction to identify passages that are of particular importance even where the whole document may be considered to be relevant or particularly relevant. Rule 43.5(e) seems to get close to this idea but, because it is couched in terms of whether part "only" is relevant or particularly relevant, does not really provide an adequate solution.

24. Also, on looking at the whole of Rule 43.5, it would seem that certain parts would best be dealt with in the Administrative Instructions. The essential provisions to include in the

Regulations appear to be found in Rule 43.5 (a), (b), and (c). In this case, Rule 43.5 (c) would be better placed as a second sentence to Rule 43.5(a) and Rule 43.5(b) enlarged to embrace all the kinds of matters that may be dealt with in the Administrative Instructions (ie matters covered by Sections 503, 507, and Rule 43.5(d) and (e) (as explained in paragraph 27 above)).

25. It is suggested that Rule 43.5 and the Administrative Instructions be amended to give effect to these ideas.

e) Family members

26. The usefulness of search reports was greatly enhanced by the inclusion of family member information as provided under Section 507(g) of the Administrative Instructions. However, it is observable that many reports are being established without inclusion of this family information. In view of the ready availability to International Searching Authorities of computerised patent family information, it would seem feasible to include this information in all instances.

27. It is suggested that the words "whenever feasible" be deleted from Section 507(g). If it necessary to do so, an additional paragraph could be added to Rule 43.5 to specify this requirement.

f) Truncated Search

28. On occasions it has been considered that documents have been found clearly demonstrating lack of novelty in the entire subject matter of the claimed invention. In these instances it is appropriate to discontinue the search, and this is supported by the current Guidelines for International Search (document PCT/INT/5 - see Chapter IV, para 2.8). However, there is no method available to indicate to any reader of the report (including the applicant, national offices, and the public) that the search was truncated in some way. Indeed, Rule 43.9 appears to preclude the provision of such information in the report.

29. It is suggested that Rule 43.5(e) be amended to provide that, where a particular classification field has not been exhaustively searched, the extent to which it has been searched (eg time period, country coverage) shall be indicated in the report.

g) Non-Classification Search

30. In some technology areas, advances in mechanised searching and/or limitations of classification based searching has provided opportunities in which neither international nor national classification provides the most efficient or effective search. For example, databases such as "WPI" and "DARC" (on Questel) and

"CAS Online" (on STN) can provide a most effective search for chemical compounds by structure eg Markush claims. Again, for example, searches for genetic sequences and/or peptides can be very effective using databases such as "Genbank", "EMBL", or "NBRF" but almost impossible using a classification scheme. The use of such databases (or at least the reporting thereof) appears not to be catered for by Rule 43.6, which allows only classification based search fields to be reported, and by Rule 43.9. It is considered that the search report should clearly state as precisely as is practical the nature of the search undertaken whatever it may have been.

31. Similarly, where a classification field is searched but is qualified by the use of keywords, it is arguable that Rule 43.9 precludes the provision of the keyword information in the search report.

32. It is suggested that Rule 43.6 be amended so that the reader is adequately informed of the nature of the search actually undertaken, whether it be in terms of classification fields or otherwise.

Item 6: INTERNATIONAL PRELIMINARY EXAMINATION REPORT

33. Rule 64.3 provides that certain patent documents published after the relevant date (filing or valid priority date) shall not be considered part of the prior art. However, such documents are to be mentioned in the report.

34. This practice is endorsed since it draws the attention of the applicant and the elected Offices to these documents during national processing, where for example the right to claim priority may become invalid.

35. It is suggested that non-patent documents published after the priority date but before the filing date could be equally relevant in national processing, and thus should also be mentioned in the report.

36. It is suggested that Rule 64.3 be amended to require that the international preliminary examination report shall also call attention to any published non-patent document which was published after the relevant date referred to in Rule 64.1 but before the international filing date, provided that the document would constitute prior art had it been published prior to that relevant date. It goes without saying that the document should not be considered part of the prior art for the purposes of Article 33.

Appendix I

INTERNATIONAL SEARCH REPORT

International Application No. PCT/US89/01220

I. CLASSIFICATION OF SUBJECT MATTER (If several classification symbols apply, indicate all.)
According to International Patent Classification (IPC) or to both National Classification and IPC
IPC (4) GO1R 29/12
US CL 324/96

II. FIELDS SEARCHED
Classification System: U.S. 324/96, 77K, 158R; 250/216, 225
Classification Symbols: 324/96, 77K, 158R; 250/216, 225
Minimum Documentation Searched: 324/96, 77K, 158R; 250/216, 225
Documentation Searched other than Minimum Documentation to the Extent that such Documents are Included in the Fields Searched:

III. DOCUMENTS CONSIDERED TO BE RELEVANT*
Citation of Document, with indication, where appropriate, of the relevant passages or Category¹ Relevant to Claim No. ²

U.S., A, 3,581,202 (PELENC) 25 May 1971	Y	1, 4-8, 11, 14-18
U.S., A, 3,675,125 (JAECKLIN) 04 July 1972	Y	1, 4-8, 11, 14-18
U.S., A, 4,618,819 (NOUROU) 21 October 1988	Y	2-3, 12-13
GB, B, 1570802 (ROGERS) 09 July 1980	Y	9-10, 19-20

* Special categories of cited documents: "A" - document defining the art which is not prior art for the purposes of the invention; "B" - document published after the international filing date or priority date and not in conflict with the application but which may be relevant to the invention; "C" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "D" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "E" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "F" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "G" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "H" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "I" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "J" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "K" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "L" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "M" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "N" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "O" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "P" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "Q" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "R" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "S" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "T" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "U" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "V" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "W" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "X" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "Y" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "Z" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention.

IV. CERTIFICATION
Date of the Actual Completion of the International Search: 03 May 1989
Date of Mailing of this International Search Report: 07 JUL 1989
International Searching Authority: ISN/US
Signature of Authorized Officer: Edward F. Urban
Signature of Authority Officer: Edward F. Urban

Appendix II

INTERNATIONAL SEARCH REPORT

International Application No. PCT/AU 87/00279

I. CLASSIFICATION OF SUBJECT MATTER (If several classification symbols apply, indicate all.)
According to International Patent Classification (IPC) or to both National Classification and IPC
Int. Cl. 4 G01M 3/02, 3/00

II. FIELDS SEARCHED
Classification System: IPC
Classification Symbols: G01M 3/02, 3/00, 3/04, 3/26
Minimum Documentation Searched: G01M 3/02, 3/00, 3/04, 3/26
Documentation Searched other than Minimum Documentation to the Extent that such Documents are Included in the Fields Searched:

III. DOCUMENTS CONSIDERED TO BE RELEVANT*
Citation of Document, with indication, where appropriate, of the relevant passages or Category¹ Relevant to Claim No. ²

X, Y (1-4)	US, A, 4342221 (SILVEY) 3 August 1982 (03.08.82)
X, Y (1-4)	US, A, 4489594 (SMITH) 25 December 1984 (25.12.84)
Y (2-4)	US, A, 4171636 (BERGERON) 23 October 1979 (23.10.79)
Y (2-4)	FR, A, 2294-326 (BAUDRAND A) 9 July 1976 (09.07.76)
A	US, A, 3360984 (SALISBURY) 2 January 1968 (02.01.68)

* Special categories of cited documents: "A" - document defining the art which is not prior art for the purposes of the invention; "B" - document published after the international filing date or priority date and not in conflict with the application but which may be relevant to the invention; "C" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "D" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "E" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "F" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "G" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "H" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "I" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "J" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "K" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "L" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "M" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "N" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "O" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "P" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "Q" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "R" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "S" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "T" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "U" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "V" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "W" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "X" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "Y" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention; "Z" - document published on or after the international filing date and not in conflict with the application but which may be relevant to the invention.

IV. CERTIFICATION
Date of the Actual Completion of the International Search: 1 December 1987 (01.12.87)
Date of Mailing of this International Search Report: 07.12.87
International Searching Authority: Australian Patent Office
Signature of Authorized Officer: R. Hallett
Signature of Authority Officer: R. HALLETT

Annex II
Number of International Applications Filed

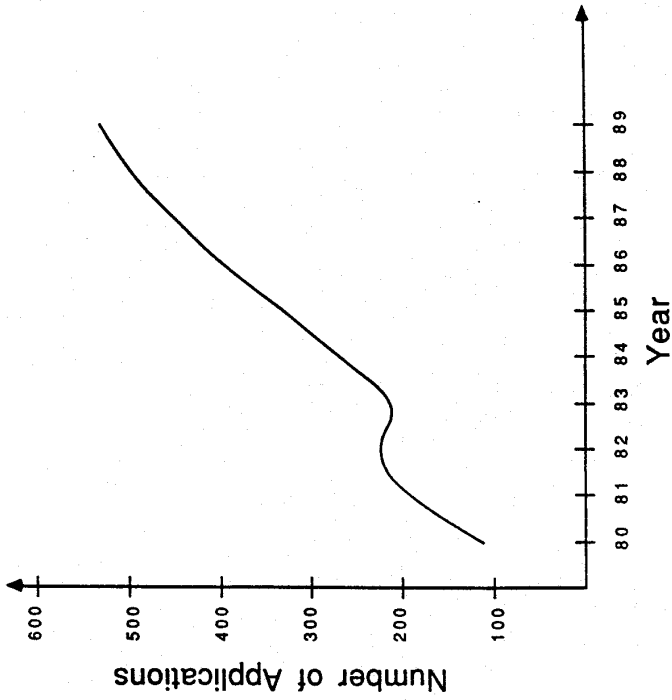


Figure 1

Table 1

Year	1980	1981	1982	1983	1984	1985	1986	1987	1988	1989
No.	111	195	225	199	272	327	396	448	504	531

Number of International Applications per IPC Section

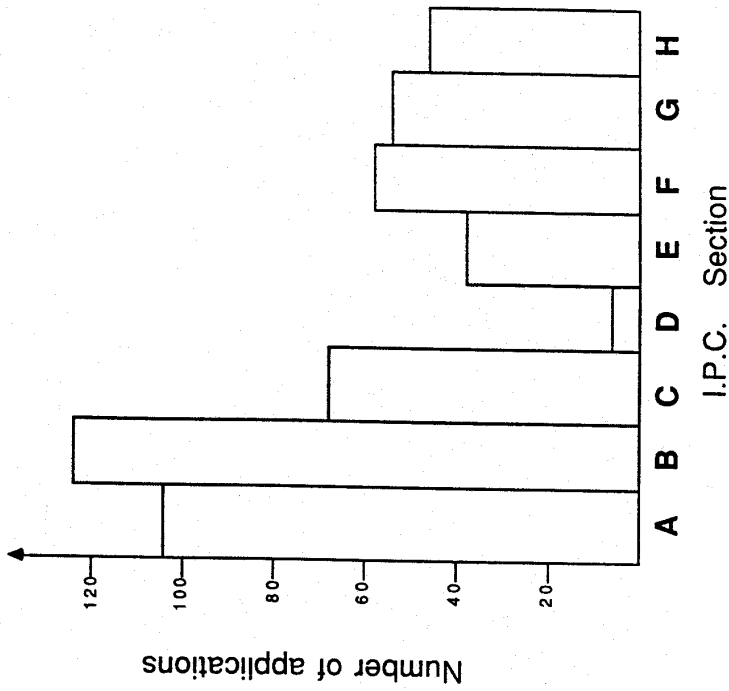


Figure 2

The Regulations under the PCT were amended several times in the early to mid-eighties and, as a result of these amendments the number of international applications has increased. In the financial year 1988-89 the number of international applications reached a peak of 558 applications.

Figure 2 illustrates the number of applications according to IPC section. It can be seen that Section B receives the most IA's followed by Section A. Section D being the least active.

Age of Documents cited by Australia
as a
P.C.T. International Searching Authority.

Table 3

Year of Publication of Cited Document	Number of Patent Documents	% (Actual)	% (Cumulative)
1980-1989	1717	47.8	47.8
1970-1979	919	25.6	73.4
1960-1969	400	11.1	84.5
1950-1959	197	5.5	90.0
1940-1949	110	3.1	93.1
1930-1939	128	3.5	96.6
1920-1929	122	3.4	100.0
Total	3593		

A total of 500 I.S.R's were analysed yielding 3,593 citations. From table 3 it can be seen that less than 7% of citations occur before 1940. It can also be seen that nearly 50% of the citations occur in the decade 1980-89.

Number of Demands Filed

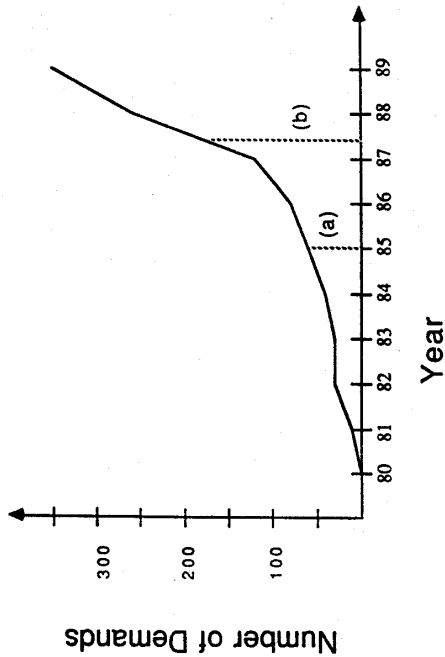


Figure 3

(a) extending time under Chapter II to 30 months.

(b) U.S. entered into Chapter II.

Table 2

Year	1980	1981	1982	1983	1984	1985	1986	1987	1988	1989 (est)
No.	2	12	27	25	33	61	84	117	262	355

When Australia commenced processing I.P.E. demands the numbers were quite small, but in more recent years the number has dramatically increased. In the financial year 1988-89 Australia, as a receiving office processed 261 I.P.E. demands.

Age of Patent Documents by I.P.C. Section

Table 4

I.P.C.	Sample size	Year of Publication									
		1920	1930	1940	1950	1960	1970	1980			
A	105	1.9%	4.0%	2.8%	6.1%	12.4%	27.3%	45.5%			
		100.0%	98.1%	94.1%	91.3%	85.2%	72.8%	45.5%			
B	123	5.7%	4.7%	4.1%	6.6%	12.1%	24.9%	41.9%			
		100.0%	94.3%	89.6%	85.5%	78.9%	66.8%	41.9%			
C	69	1.7%	2.2%	0.4%	3.6%	6.7%	21.6%	63.8%			
		100.0%	98.3%	96.1%	95.7%	92.1%	85.4%	63.8%			
D	5	12.8%	2.6%	2.6%	17.9%	23.1%	15.4%	25.6%			
		100.0%	87.2%	84.6%	82.0%	64.1%	41.0%	25.6%			
E	38	3.6%	3.6%	5.7%	7.8%	15.0%	23.7%	40.6%			
		100.0%	96.4%	92.8%	87.1%	79.3%	64.3%	40.6%			
F	58	5.4%	3.9%	4.9%	4.7%	13.1%	25.4%	42.6%			
		100.0%	94.6%	90.7%	85.8%	81.1%	68.0%	42.6%			
G	55	1.9%	2.6%	1.3%	4.5%	10.1%	30.4%	49.2%			
		100.0%	98.1%	95.5%	94.2%	89.7%	79.6%	49.2%			
H	47	0.3%	1.4%	2.4%	2.0%	6.4%	27.7%	59.8%			
		100.0%	99.7%	98.3%	95.9%	93.9%	87.5%	59.8%			

Age Distribution of Patent Documents Cited by Australia

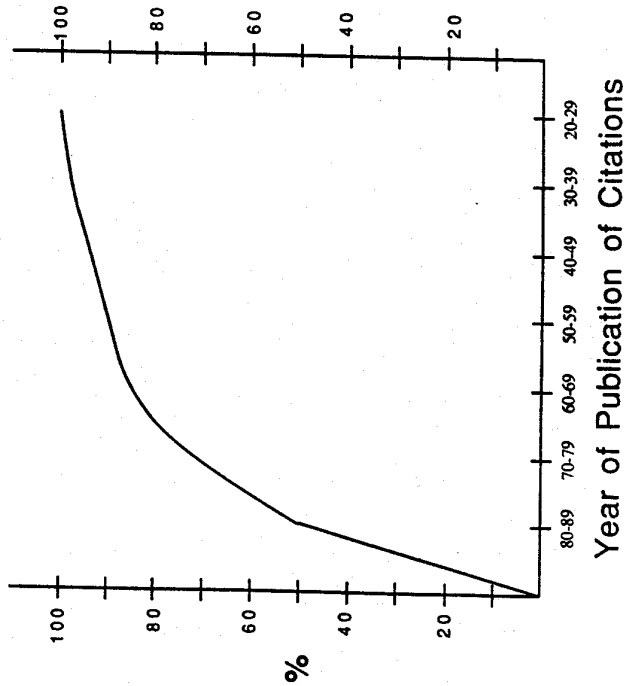


Figure 4

**Documents cited by Australia as an I.S.A.
broken down by Publishing Country**

Table 5

Publishing Country	Number of Patent Documents	(%)
US	1250	36.6%
GB	431	12.6%
DE	211	6.2%
FR	169	4.9%
EP	160	4.7%
WO	98	2.9%
SU	59	1.7%
CH	32	0.9%
OTHER	188	5.5%
AU	814	23.8%

If the age of patent documents is analysed by IPC section, it becomes apparent that certain technologies recover their citations from different periods of time.

For Example Section H (Electricity) recovers 93.9% of citations from the period 1960-89 and Section C (Chemistry) recovers 92.1% of citations from the same period.

However Section B (Performing Operations and Transporting) recovers a similar amount (94.3%) over the period 1930-89, similarly Section F (Lighting, Heating, Weapons and Blasting) recovers (94.6%) over the same period.

The results from Section D (Textiles and Paper) were from a small sample which were not sufficient to offer suitable comments.

Table 5 illustrates the documents cited by Australia according to publishing country. It is apparent that US gives rise to the most citations (36.6%) followed by Australia (23.8%).

Comparison between the Number of Patent and Non-Patent Citations

Table 6

Citation Category	Frequency of use/ISR	(%) of use
X	3.50	48.6%
Y	1.81	25.2%
A	2.71	37.6%
P	0.35	4.9%
OTHER	0.03	0.5%
TOTAL	7.21	

Table 6 illustrates the usage of citations categories. The total number of citations per ISR averages out at 7.21. The most frequently used citation category was "X" at (48.5%) followed by "A" at (37.6%) and "Y" at (25.2%). The "P" category was used infrequently at (4.9%), and the only other categories used were "D", "E" and "T" but these were insignificant.

Table 7
Number of I.S.R.'s =500

Patent Citations(A)	Non-Patent Citations(B)	Ratio B/A (%)	Patent Citations per I.S.R.	Non-Patent Citations per I.S.R.
3412	193	5.7%	6.824	0.386

Table 7 illustrates the number of patent and non-patent citations in a sample of 500 ISR's. On average the ratio of patent to non-patent citations was 5.7%.

The number of non-patent citations per ISR averaged out at 0.386 compared to the total number of citations per ISR which was 7.21.

PRÄSIDENT DES
ÖSTERREICHISCHEN PATENTAMTES
HOFRAI DR. JOSEF FICHTE
A-1014 WIEN, KOHLMARKT 8-10
TEL. 0222 / 534 24
97.200/7-GR/89

Vienna, November 27, 1989

-2-

Mr. Arpad BÖGSCH
Director General
World Intellectual Property
Organization (WIPO)

34, chemin des Colombettes
CH-1211 Genève 20

As far as paragraph 6 of the provisional agenda is concerned we are looking forward with interest to the considerations in view of amendments of certain provisions of the PCT Regulations concerning Chapter II of the PCT during the provided meeting in Geneva, January 15 to 19, 1990. Prospective comments of the Austrian Patent Office will be presented at this meeting.

Referring to paragraph 7 of the Provisional agenda we do not have any specific proposal, but we support every revision that leads to a simple understanding of PCT-forms.

Re.:

Circular C. 360 PCT 211

Encl.

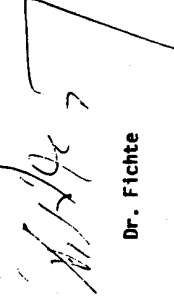
Dear Mr. Director General,

I have the honor to announce to you our participation at the Meeting of International Authorities, held at Geneva from January 15 to 19, 1990. I would like to inform you, that we generally agree with the Provisional agenda (document PCT/MIA/I/1).

As far as paragraph 3 of the Provisional agenda is concerned, we have the honor to present to you our report; please find enclosed our relevant paper.

With reference to the Revision of the International Search Guidelines (paragraph 4 of the Provisional agenda) and the Revision of the International Preliminary Examination Guidelines (paragraph 5 of the Provisional agenda) we refer to your comments, which we have already put forward to the International Bureau (published in document PCT/MIA/I/4). At the moment we do not have any further comments.

Sincerely yours,



Dr. Fichte

In case of a request for International Preliminary Examination at the Austrian Patent Office there is provided for a similar procedure. After the formal examination carried out by the authorized officer, the notification of receipt (Form IPEA/409) is mailed and the bibliographic data are registered. Then the file is transferred to the competent examiner. Within a time limit of 27 months after the date of priority the examination report will be finished, and signed by the authorized officer this request will be mailed to the applicant and the International Bureau.

As mentioned above the Austrian Patent Office acts only for few receiving offices as International Searching Authority and as International Preliminary Examining Authority. Although the number of international searches and examinations carried out by the Austrian Patent Office is increasing (see fig. 1), the absolute number is relatively low. As an example, in the year 1988 117 searches have been received by the Austrian Patent Office. This is approximately one percent of all international searches. More than 75 % of all international searches received by the Austrian Patent Office during the last 6 years (1983 to 1989) originate from Hungary (see fig. 2). The searches were distributed over all technical fields, especially nearly 50 % of the searches dealt with mechanical subjects (see fig. 3).

In the years 1985 to 1988 only 36 requests for an International Preliminary Examination have reached the office, from which 14 have been received in 1988.

The Austrian Patent Office
as
International Searching Authority
and
International Preliminary Examining Authority.

The Austrian Patent Office is one of 7 International Searching Authorities and one of 8 International Preliminary Examining Authorities under the Patent Cooperation Treaty. This office acts as International Searching Authority for applications deposited at the receiving offices of Brazil (BR), Hungary (HU), Republic of Korea (KR) and Romania (RO), as well as for applications deposited at the International Bureau of the World Intellectual Property Organization for all member states of the Organisation Africaine de la Propriété Intellectuelle (OAPI) and Barbados. The Austrian Patent Office may also act as competent International Preliminary Examining Authority for the above mentioned receiving offices with the exception of the Republic of Korea (KR), which has not signed the Chapter II of the Patent Cooperation Treaty.

When an international application is received by the Austrian Patent Office, in which this office is specified as International Searching Authority, the application is classified in accordance with the IPC, followed by a formal examination by an authorized officer. Then a notification of the receipt (Form ISA/202) of the search copy and, if necessary, invitations to correct certain defects are transmitted to the applicant. After the registration of the bibliographic data the application is passed on to the officer being competent for the relevant subclass. Within a time limit of two months the search will be carried out by the examiner. The finalized search report is then mailed to the applicant and to the International Bureau.

Fig. 2: Percentage of Searches carried out for the different Receiving Offices (from 1983 to 1988)

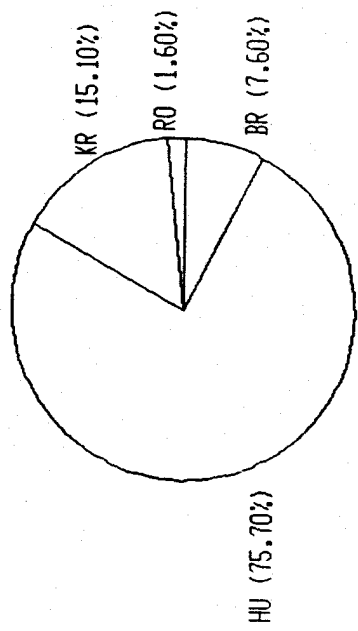
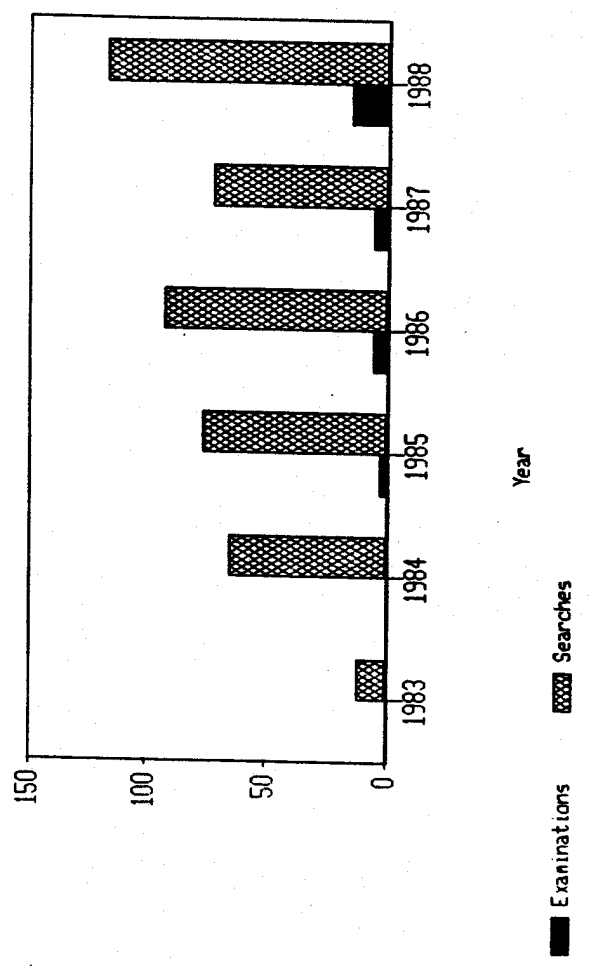
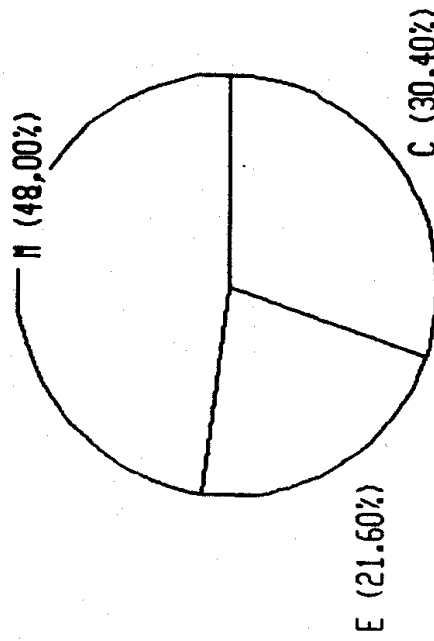


Fig. 1: Number of International Searches and Examinations



**Fig. 3: Technical Fields of the Searches
(from 1983 to 1988)**



Field

[Annex C follows]



THE PATENT OFFICE
JAPANESE GOVERNMENT

Address: 4-3, Kasumigaeski 3-chome
Chiyoda-ku, Tokyo, Japan
Telephone: 03-501-6803
Telex: JAPOIA J3788

4 December 1989

Dr. A. Bogsch

Director General
WIPO

Dear Dr. A. Bogsch

Enclosed is a report on JPO activity regarding the item 3 of agenda for PCT meeting (WIPO circular C. 360 PCT211) which will be held on January 15, 1990.

We hope the report will serve to help you in the meeting.
We do hope the success of meeting and the meeting will play an active role in enhancing development of PCT field in future.

Yours Sincerely

K. Yamaura

Director General
First Examination
Department JPO

1. Outline of the Japanese Patent Office

a. Application

The number of applications filed with the Japanese Patent Office in 1988 was 340,000 for Patent, 170,000 for Utility Model, 50,000 for Design and 170,000 for Trademark, amounted to 740,000 in all before the four laws. In particular, the number of applications for patent and utility model shows a marked increase (from 350,000 in 1978 to 510,000 in 1988), which now accounts for more than 40 percent of all applications in the world.

b. Period required for procedure, pendency and examination
In 1988, the Japanese Patent Office examined 110,000 patent applications, 100,000 utility model applications, 50,000 design and 160,000 trademark applications.

The number of pending applications decreased remarkably in 1988 in the fields of patent and utility model particularly, as it dealt with 200,000 cases as against 170,000 applied for examination in the same year.

Period required for examination as of the end 1988 is about three years for patent and utility model, about two years for design and trademark.

c. Procedure expediting measures

In order to shorten the time required for examination, the Japanese Patent Office is mainly taking the following steps.

1) Increase of examiners

In the midst of the rigorous administrative and fiscal reform, the Japanese Patent Office succeeded in increasing substantially the staff of patent and utility model examiners (853 examiners in 1987 to 883 in 1988).

It intends to continue making its efforts to increase the staff.

2) Promotion of the Paperless program

The Japanese Patent Office is under construction of the Paperless system at a cost of some ¥140 billion in total on a ten-year scheme from 1984 to 1993. Applications for industrial property right, their acceptance and examination work, which so far carried out by paper, will be handled in principle by computer. In addition, industrial property right information service will be provided through computer. The system will no doubt improve these services remarkably.

It is expected to start accepting electronic application (through online or by flexible disc) by the fall of 1990.

3) "From Quantity to Quality" control

The number of applications filed in Japan, is extremely large in comparison with those of other countries.

Further, about one half of them are rejected due to insufficient search before filing or because they concern inventions which are obsolete and lacking in novelty. Examination is delayed because of the large number of such applications, preventing swift grant of patents to truly useful inventions: also due to the publication of huge quantity of unexamined patent applications, effective use of patent information is obstructed. As the result, there has been great loss from the viewpoint of national economy.

To resolve such situation, the Patent Office has, requested the cooperation of applicants including private enterprises for the purpose of transition from quantity to quality of applications filed and those for which examination is requested.

2. PCT application in Japan

Japan began to accept PCT applications in Japan in October 1978. After Japan affiliated with the PCT system 11 years ago, the number of PCT applications filed has steadily increased, topping 1,000 applications for the first time in 1987, the year marking the 10th anniversary of the affiliation.

The figure represents the largest number of applications filed in terms of breakdown by the receiving office, with Japan ranking next to the United States.

On reviewing the past PCT system developments in Japan, expectations had been created with respect to the filing of a considerable number of PCT applications in view of the favorable reception by businesses, lawyers, etc., prior to and early days of affiliation.

Against the high expectations of WIPO for Japan as a "patent superpower" capturing a massive 40 percent share of the worldwide patent applications field, the actual results were much lower than the earlier outlook which prevailed before the system implementation.

This is ascribed to the unfamiliarity of the applicants with the details of the PCT application system and to their hesitation stemming from viewing the system as complex and awkward to operate.

As a result, Japanese applicants appear to have continuously filed their international applications based on the Paris Priority they have long been accustomed to in quest of safeguarding application.

To promote the publicity of the PCT application system, the Japan Patent Office (JPO) has been hosting seminars on PCT application, especially for businesses, patent attorneys, etc., on a nationwide scale since its affiliation in 1978 to familiarize applications with the PCT filing procedures.

To date, seminars have been held as often as 32 times, attended by an aggregate audience of 11,000.

Also, the JPO, after obtaining the endorsement of WIPO, modified the PCT filing procedures in favor of permitting applicants to file their applications using facsimile communication, beginning in January 1985.

In addition, the JPO began to accept international applications written in English, though not an official language of the JPO, from October of the same year onwards. Concurrently with asking the EPO to act as a The Competent International Searching Authority (The Competent International Preliminary Examining Authority), the JPO has been serving as a The Competent International Searching Authority (The Competent International Preliminary Examining Authority) of the KR.

The JPO hosted a special lecture meeting in commemoration of its 10th anniversary of its affiliation with the PCT for the purpose of promoting public interest in the PCT system. Thanks to the favorable cooperation of WIPO, we were able to invite Mr. F. CURCHOD, Director of the Office of the Director General of WIPO, to address the lecture meeting on the topic of "PCT, Future and Present."

Also, Mr. Inaba, President of Fanuc, Inc., Japan and Mr. W.S. Thompson, Director of Patent Affairs Division, Caterpillar, Inc. of the United States, addressed the lecture meeting on the subjects of "Technology and Management" and "PCT and Corporate Strategy."

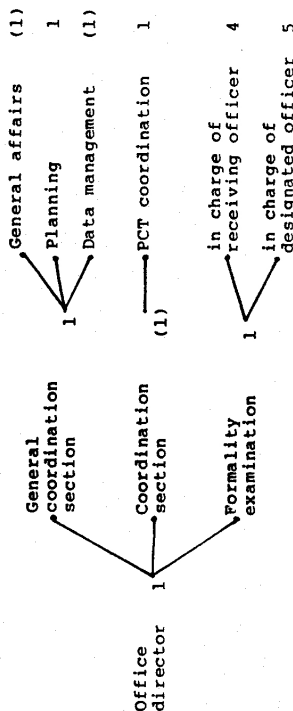
Their lectures appeared to have led the audience, including 220 attendees from businesses, to better recognition of the PCT system.

3. PCT Affairs Office

The PCT Affairs Office is staffed with 14 officers including a office director.

Of these, nine staff specialists for formalities examination are undertaking the affairs with respect to international application. The office (171.1 m²) is located on the 5th floor of the JPO building, where applications are accepted over the counter and where counsellors' booths are also installed.

Organization



Note: Figures in parentheses represent the number of officers assuming another post concurrently with the current position.

The receiving office is carrying out PCT research and examination on international applications. ISR and IPER preparation schedules are all computer-controlled and JPO examiners work out ISR and IPER in accordance with this schedule. Search copies covering ISA and IPEA are controlled by the managing officer for PCT search and examination. Documentation delivered from ISA and IPEA, notices received from applicants, etc., are channeled through the receiving office without exception. When reports are compiled after completion of searches, a file wrapper for search copies is paired with that for the receiving office for storage.

- a. Receiving Office's services
- Of the international applications filed, those filed over the counter accounts for 83.4% those filed by mail, 12.1% and those filed by facsimile, 4.5%.
- In Japan, 90 percent of PCT applications are filed based on the Paris Priority. Accordingly, since submission of original records to the WIPO is time constrained, formality checking has been conducted over the counter and telephone amendment services are offered to expedite acceptance of these applications. Normally, this procedure is completed within two weeks and invitation to correct are issued to about 40 percent of the applicants.
- In case the handling fee remains unpaid due to the carelessness of an applicant and a given application is viewed as if it were withdrawn, JPO alerts the applicant to such delinquency by telephone, etc. Any international applications received by the JPO are in principle examined on the day they are accepted.
- b. Designated Office Services
- The United States designation accounts for some 40 percent of total international applications which designate Japan as a designated country. European countries rank next to the United States in this respect. Designated international applications are input into computer at the time a WIPO designation notice is served and are stored in file by application as a file wrapper. Concurrently, a domestic application number is assigned and then, all WIPO-supplied notices, documents communicated under Article 20 and priority documentation are entered in the computer and consolidated with previous file entries.

4. Search and Examination practice of the Japanese Patent Office as the International Searching and Preliminary Examining Authority.

a. The Organizational Structure of Examination Department

At present, there are about 850 examiners in the JPO, who examine the applications for patent and utility model including international applications.

Examination Department consists of 4 examination departments.

Applications in the machinery field are examined by the Third Examination Department.

Applications in the chemical field are examined by the Fourth Examination Department.

Applications in the electric field are examined by the Fifth Examination Department.

Applications in other fields including complex technological fields are examined by the Second Examination Department.

Furthermore, each Department is broken down into technical sections and for performing substantial examination, examiners are grouped into divisions each of which is supervised by Division Director. And there is the Department of Appeals and Trials, a higher body of the Examination Departments.

The international search and international preliminary examination are carried out by the examiner in charge of the technical field to which an international application belongs.

A formality examination is started in accordance with the formality examination commencement list after translation of each application is submitted. An international application for which a formality examination has been completed is placed under domestic public disclosure based on the translation and then under publication of a published Searched Patent applications. Thereafter, such an application is treated as an ordinary domestic application and examined as such. Though formality examination by a designated office slightly differs from the PCT requirements, this formality examination is conducted based on the same standard as that for the ordinary domestic law. International applications are viewed as if they were withdrawn due to non-submission of an accompanying translation for the period of 20 to 30 months after original applications have been filed, before steps are taken for withdrawal.

< Reference >

Statistics (calendar year 1988)

International applications: 1,346 applications

Average number of Countries Designated per Application: 9.1 "

Demand for International preliminary examination: 160 "

As to the furnishing of a copy of the international application and a translation thereof: 3,658 "

Number of times Designated on Applications Received by Other PCT Offices: 9,549 "

b. Search and Examination Procedure

(1) File Wrapper

In JPO, all application documents are put into the file wrapper. The International Patent Classification, the name of the examiner in charge, the history of examination, etc. are written on the file wrapper.

A search copy of an international application is also put into a file wrapper. The same file wrapper is used through the international search and international preliminary examination, and, all the original copies of the papers submitted by the applicant and notifications sent to the applicant are put into the file wrapper.

(2) A managing officer for PCT search and examination

In order to execute the operation of international search and preliminary examination smoothly and promptly, there is a managing officer for PCT search and examination in each division. The managing officer has the following main jobs.

(a) Designation of an examiner in charge of an international application

An examiner in charge is designated, considering the technical field of the international application and the proportion of the amount of each examiner's work.

The international preliminary examination of an international application is carried out in principle by the examiner who established the ISR of that international application.

(b) Management of prosecution so that ISR and IPER may be established without delay

An examiner in charge executes the work for establishing ISR and IPER according to the schedule table. The schedule table is kept by the examiner in charge and also by the managing officer.

(c) Centralized Management of file wrappers of international applications

All file wrappers of international applications are kept in a locker of each division.

(d) Review of a paper that an examiner establishes

All papers that an examiner establishes are handed over to and reviewed by the managing officer and, then submitted to Division Director.

c. The International Search

(1) The main procedures to establish the international search report in the JPO are as follows;

(a) Designation of an examiner in charge

(b) Consideration of whether there is any reason for which the international search report is not established with respect to all claims

(c) Consideration of whether the requirement of unity of invention is complied with

(d) Consideration of whether an abstract of the international

application has deficiency

3

- (e) Consideration of whether a title of invention is appropriate
- (f) Prior art search
- (g) Establishing the international search report

(c) Protest against additional fee, and the decision thereon
(Rule 40.2(c)) 0

(2) The number of international applications for which the JPO is declared to be competent as the ISA and the number of international search reports established by the JPO are as follows:

(d) Invitation to comment on the abstract established by ISA
(Rule 38.2(a)) 191

year	Number of applications (approximate)	Number of ISR established (approximate)
1985	730	550
1986	640	650
1987	940	880
1988	1290	1250

(e) Invitation to present a request for rectification of obvious error (Rule 91.1(d)) 26

(f) Notification of authorization or refusal of rectification
(Rule 91.1(f)) 49

(4) Prior Art Search

The JPO has the minimum documentation as defined in Rule 34. The international search is carried out in the same way as the search in the examination of domestic applications.

When the technical field to be searched should be extended to other fields than the technical field of which an examiner is in charge, he may request another examiner who is in charge of that other fields to search prior art documents.

(a) Notification of the decision that no international search report is established (Article 17(2)(a))

2

(5) International Search Report

According to the survey in 1988, the number of ISR established by the JPO in the fiscal year 1987 are 995 and the average number of cited documents are 3.4. The ratio of Japanese documents including those which have patent family in other language, is 95.4%. The ratio of categories assigned is as

(b) Invitation to pay additional fees for lack of unity of invention (Article 17 (3)(a), Rule 40.1)

14

15

follows:		(approximate)	(approximate)
		1985	20
X reference	20.2%	1986	40
Y reference	43.1%	1987	40
A reference	32.4%	1988	150
			10
			20
			30
			90

(3) 93 international preliminary examining reports were established by the JPO in 1988. The following shows the number of invitations, notifications, written opinions or responses which were sent to or submitted by the applicant during the stage of international preliminary examination in 1988.

- (a) Invitation to restrict the claims or to pay additional fees for lack of unity of invention (Article 34(3)(a), Rule 68.2) 1
- (b) Protest against additional fee and notification of decision thereon (Rule 68.3(c)) 0
- (c) Invitation to present a request for rectification of obvious error (Rule 91.1(d)) 1
- (d) Notification of authorization or refusal of rectification (Rule 91.1(f)) 4
- (e) Invitation to furnish a translation in Japanese of the application whose priority is claimed (Rule 66.7(b)) 0
- (f) Written opinions and additional written opinions of IPEA (Rule 66.2.66.4(a)) 97
- (g) Responses from the applicant (Rule 66.3) 49

d. The International Preliminary Examination

(1) The procedures to establish the international preliminary examination report in the JPO are as follows:

- (a) Designation of an examiner in charge
 - (b) Consideration of amendment
 - (c) Consideration of whether the requirement of unity of invention is complied with
 - (d) Consideration of whether a written opinion should be established
 - (e) Establishment of written opinion
 - (f) Consideration of written response and amendment
 - (g) Establishment of international preliminary examination report
- (2) The number of the demands for international preliminary examination for JPO as the International Preliminary Examining Authority, and the number of international preliminary examination reports established by the JPO are as follows:

Number of demands Number of reports established

e. Usefulness of International Search Report

(1) The following table is a summary of answers of 27 Japanese examiners on the question of whether international search reports are helpful in the examination.

Extremely helpful	23%
Very helpful	47%
Of some help	27%
Not at all helpful	3%

(2) However, Japanese examiners make an additional search in most cases in the examination at the national stage of international applications in which Japan is designated. The documentation to be additionally searched includes Japanese Patent documents. Japanese Patent documents are often additionally cited in rejecting international applications.

f. Problems in Amendments under Article 19 and Article 34

According to Rule 46.5, for amendments under Article 19, it is not necessary to submit all sheets of claims, but necessary to submit a replacement sheet for the claims which differs from the sheet originally filed. The applicant shall be also required to submit the letter accompanying the replacement sheets which shall draw attention to the differences between the replaced sheets and the replacement sheets. To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be

communicated in a letter.

In the case of an application made in a language other than Japanese, the applicant thereof shall submit to the JPO a Japanese translation of the application. According to Rule 49.5(a)(ii), it is necessary to submit the translation containing both the claims as filed and the claims as amended if the claims have been amended under Article 19. However, it is not required to submit the translation of the letter referred to in Rule 46.5.

The same may be said of amendments under Article 34. Only the translation containing both claims as filed and the claims as amended will be submitted. The translation of the letter is not required to be submitted.

Therefore, there occurs the cases where the contents of amendments are unclear from the translation itself. When an applicant submits a replacement sheet describing claim 1 for the application containing a plurality of claims as filed, it cannot be determined from the translation itself whether the other claims are canceled or not.

When an applicant amends the application containing a plurality of claims as filed to cancel a part of claims, the contents of amendments also cannot be known from the translation of the application.

According to the JPO practice of national-stage examination of an international application filed in other language than Japanese, the determination of whether amendments made Article 19

or Article 34 exist or not, and the determination of what portion of claims is amended are made by means of referring to a pamphlet of international publication or an international preliminary examination report in a case where the international preliminary examination has been demanded.

The examiner has to have tremendous burden as mentioned above in order to determine the amendments under Article 19 or Article 34. Some measure should be taken so that the member state may conduct easily and smoothly a national-stage examination based upon the translation of the application.

[Annex D follows]



Box 5055, 102 42 STOCKHOLM.
Telefon: vt 08-782 25 00.


PATENT- OCH
REGISTRERINGSVERKET

November 29, 1989

Dr A. Bogsch
Director General
WIPO
34, chemin des Colombettes
1211 GENEVE 20

In response to WIPO circular No. c.360/PCT 211 of
September 4, 1989 concerning practice and experience of
our Office as International Searching and Preliminary
Examining Authority we have the pleasure to enclose a
brief report.

Yours sincerely,


Lars Björklund
Deputy Director General

Vaktstället 136
Postgörs. 136 64-4.

Tele: 17978 PATOREG-S.
Telegram: PATOREG, Stockholm.



Box 5055, 102 42 STOCKHOLM.
Telefon: vt 08-782 25 00.

PATENT- OCH
REGISTRERINGSVERKET

November 29, 1989

REPORT OF THE SWEDISH PATENT OFFICE ON THE PRACTICE AND
EXPERIENCE AS AN INTERNATIONAL SEARCHING AND AN
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY WITHIN THE
PATENT COOPERATION TREATY

G E N E R A L R E M A R K S

1. The Swedish Patent Office (SPO) has fulfilled its role as an ISA and an IPEA since the start of the PCT system. The SPO is acting as ISA and IPEA mainly in PCT-applications filed in the Danish, the Finnish, the Norwegian and the Swedish Patent Offices.
 2. The industry in Sweden has declared in a hearing, a couple of years ago, that it is essential to have an ISA and an IPEA equipped to search also the patent documentation and non-patent literature from the four nordic countries. A further essential point was that the national official language could be used when filing a PCT-application and in both written and oral communications. These declarations apply even more to the requests of an international type search (ITS) in national patent applications.
 3. The SPO has since the start drawn up approximately 9.000 PCT search reports, 2.200 preliminary examining reports and 3.600 ITS search reports.
 4. Several problems arise when a national patent office shall act also as an ISA and/or an IPEA. A new type of "legislation" (PCT Articles, Rules, Guidelines and Administrative Instructions) must be used by the examiners. A practice must be developed to fit this "legislation". New administrative routines must be created. Moreover an ISA must also have in its possession at least a prescribed minimum documentation, properly arranged for search purpose, which often means an increased documentation in comparison to what is normal for a national office.
- Our experiences as an ISA and an IPEA are that the aforementioned problems can be solved if the Government is backing the office in giving the necessary resources.

Vaktstället 136
Postgörs. 136 64-4.

Tele: 17978 PATOREG-S.
Telegram: PATOREG, Stockholm.

T R A I N I N G

5. It is a vital interest of an ISA and an IPEA to have examiners with sufficient technical and linguistic qualifications to carry out an international search and examination. Our experience in this field is that there must be a regular training particularly in languages.

6. PCT Rule 36.1(i) states that an ISA must have at least 100 employees with sufficient technical qualifications to carry out searches. In our opinion this means, in addition to p.5 above, that the examiners must be familiar with the search utilities.

The SPO has arranged the search documentation, in principle, according to the International Patent Classification. However, for the US-collection the US-classification is used. Training in using these classification systems is an ongoing project.

New technologies have been and are being developed in the field of information retrieval. There are frequently new files and new parts in the search languages at the commercial databases. At the moment we put a high priority on training in using the information in commercial databases.

S E A R C H D O C U M E N T A T I O N

7. PCT Rule 34 defines the minimum documentation for an ISA. The SPO has in addition to the PCT minimum documentation in classified order patent documents from Denmark, Finland, Norway and Sweden in order to give a better service to the applicants, see p.2. Furthermore, our Classified file contains patent documents from before the year 1920 for several of the countries involved.

U N I T Y O F I N V E N T I O N

8. The SPO employs two types of routines for cases, which deal with unity of invention in connection with the search. The first type is described in PCT Guidelines for international search, PCT/INT/S, Chapter VII.2. The main point is that the ISA will inform the applicant of the lack of unity of invention by a communication preceding the issue of the international search report.

The second type is the routine of the EPO. The main point here is to give the applicant a search report based on the invention first mentioned in the claims together with the invitation to pay additional search fees.

The first routine results in

- i) more planning-time for the examiner.
- ii) that a search report on all inventions, which are paid for, more reliably can be published in time, and
- iii) an opportunity for the applicant to give up the search for the first invention mentioned in the claims in exchange for another invention stated in the claims.

The second routine results in

- i) higher stress on the examiner,
- ii) the applicant gets a search report before he has to decide on payment for additional search
- iii) more often a corrected version of the search report

9. In the examining procedure SPO does not invite the applicant to restrict the claims or to pay additional fees where the examiner finds that the requirement of unity of invention is not complied with.

T R A N S L A T I O N S

10. SPO as an ISA accepts international patent applications filed in Swedish, Danish, Finnish and Norwegian in addition to English. This implies, that translations to English to be published in the pamphlet shall be prepared under the responsibility of the ISA, PCT Rule 48.3(b).

The practice is that when receiving the application we ask the applicant if he wishes to do the translation himself. If he chooses to translate the international application himself, we inform him that the translation must be furnished to us at the latest five weeks after the receiving of the search report.

Some of the problems relating to this issue are:

- i) the applicant has a short time assigned between the receipt of the search report and the sending of the translation.
- ii) in connection with holidays of greater length there will be a shorter time period for the applicant
- iii) sometimes the applicant has problems to set up the translation
- iv) sometimes, when the SPO is requested to take care of the translation, it is difficult to get compensation for the costs.

End of document

[End of document]