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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

(ADDENDUM 1)

Document compiled by the International Bureau

The Annexes to this document contain the reports which have been submitted by the United Kingdom Patent Office (Annex E) and the European Patent Office (Annex F) which were received after the publication of document PCT/MIA/I/2.

[Annexes E and F follow]

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Date 15 November 1989

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Dear Dr Bogsch

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT

As requested in your circular of 4 September I forward herewith a report on the practice and experience of the UK Patent Office as a Preliminary Examining Authority under Chapter II of the PCT.

We have no comments on the provisional agenda for the meeting 15 to 19 January, 1990.

Yours sincerely



P L EGGINGTON
Superintending Examiner

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT

Report by UK Patent Office on practice and experience as International Preliminary Examination Authority (IPEA).

1. Practice. The following procedure has been adopted.
 - 1.1 From the outset there has always been a nominated officer (Principal Examiner grade) who has been in overall charge of International Preliminary Examination (IPE) work. He is responsible for
 - (a) allocation of the examination work
 - (b) advising on procedure
 - (c) ensuring time limits are met
 - (d) ensuring forms are properly completed.
 - 1.2 Receipt and despatch of all documents is effected by an 'International Unit' which is also responsible for all formalities matters.
 - 1.3 International Unit is responsible for preparing an internal file for use by the examiner which consists at least of a copy of the specification with the International Search Report as supplied by the International Bureau, a copy of the Demand and a copy of any amendments proposed, whether filed under Article 19 through the International Bureau or filed direct together with the Demand. Written opinions, replies, amendments and the final report are added as the case progresses.
 - 1.4 Technical examination is carried out, whenever practical, by the examiner who would deal with the relevant subject matter under national procedures.
 - 1.5 Examination is carried out on the basis of

the procedure is adopted on an informal basis and the decision of the senior official is incorporated into the IPE report unless the applicant offers further amendments as a result of the decision.

Experience

2.

2.1 Due to the many similarities between the WIPO Guidelines for IPE (PCT/INF/6) and UK national Manual of Patent Practice, problems in examination are relatively few. Such problems as occur mostly arise from the separation of search from examination and in particular from occasional differences in approach on unity of invention between the International Searching Authority (ISA) and ourselves.

2.2 When the ISA and ourselves agree on a question of plurality of invention there are two basic possibilities:-

(a) the applicant has paid an additional search fee or fees in accordance with Rule 40. Problems will only arise if the additional fee is paid under protest in which case we will not have the benefit of the result of that protest. We as IPEA normally issue a request for a further fee for examination under Rule 68. In theory the only recourse open to the applicant is to pay this fee under protest; however if the applicant informs us that the additional search fee was refunded we would normally withdraw the invitation to pay an additional fee. In any event time has been wasted;

(b) no additional fee has been paid in which case we as IPEA must issue an invitation to pay an additional fee or restrict the claims (Form PCT/IPEA/405). This seems to be a waste of time.

shortened guidelines prepared within the UK Patent Office which cover all common differences between the PCT procedures and our own national procedures - these are relatively few in number. The examiner is encouraged to consult the officer in charge when in any doubt.

1.6 Until recently because of the relatively small numbers of examinations involved it was found most efficient to have the examiner prepare a suitable report which was then transferred onto the correct form by a small group of staff who also organised the typing of the forms. Now the flow of work has increased to the point where it is now considered more efficient for the individual examiner to arrange for the completion and typing of the forms as well as performing the actual examination.

1.7 A diary is maintained and all cases on which a written opinion issues are automatically recalled if there is no response in the time limit set with some allowance for possible delays. In such cases the IPE report issues based on the written opinion.

1.8 Because of the restricted time available examiners are encouraged to use the telephone or have interviews with the applicant or his agent rather than issue second or further written opinions.

1.9 In the UK national system if the examiner and applicant are unable to agree the dispute is resolved by reference to a senior official (usually a Principal Examiner) who hears both sides and then issues a decision. Although there is no provision for such a system within the PCT

If the applicant at this stage chooses to pay the additional examination fee he must also pay an additional search fee (examination cannot be effected if no search has been made); however since he did not comply with the invitation from the ISA in the time limit sent by them the ISA is under no obligation to do a search and probably could not do so in the time available and still leave time for examination. (Fortunately no one has ever paid an additional fee at this stage). It is not practical at this stage to offer an option of paying an additional fee and Rule 68 appears to be flawed in allowing as the only options available to the IPEA

(i) examining the whole application (Rule 68.1 - not possible if search is incomplete).
(ii) issuing an invitation including the possibility of paying an additional fee (Rule 6.8.2 - not possible if the applicant failed to comply with an invitation to pay an additional fee under Rule 40 within the time limit set).

2.3 If the ISA and IPEA disagree on unity of invention again there are two possibilities:-
(a) the ISA considered there was unity and has ostensibly searched all claims, whereas the IPEA considers there is plurality of invention. The IPEA can proceed under Rule 68.1 which we always do. A problem can arise however if the second invention has possibly not been searched, e.g if it is covered by a single claim perhaps not noticed by the ISA. The examiner may form the opinion that the search is deficient either because a search has not been made in the relevant IPC class or because the search has revealed no relevant prior art when the examiner considers it should have. The only recourse available to the examiner is to add a warning to

his report that he considers the search may not have been complete;
(b) the ISA has objected to plurality when the IPEA considers unity exists. If the requisite additional search fee was paid the examiner can proceed with a normal examination but if no additional fee was paid and the search was incomplete the examiner can only examine the searched inventions. This situation is not covered by the Rules or the Guidelines. The approach we take is to provide a "complete" report but add a rider to the effect that the examination of claims ... (the second, unsearched invention) is incomplete since no search has been made in respect of these claims.

It may also be noted that the ISA in completing section VI of PCT/ISA/210 does not always give full details but refers to the information on Form PCT/ISA/206. Since this form is not available to the IPEA insufficient information is provided.

2.4 Because of the limited time available we take the view that if an invitation to pay further fees or restrict the claims (Form PCT/IPEA/405) is issued when plurality of invention is considered to exist, a written opinion should issue at the same time covering the parts which the examiner is able to examine. It would probably be of assistance if this form could be incorporated in the written opinion form e.g as a removable sheet(s) if only to avoid continually having to insert bibliographic details.

2.5 Other problems occur due to deficiencies in the Forms which are required to be used.

- 2.5.1 Form PCT/IPEA/408 (Written Opinion) simply does not have sufficient space. The Administrative Instructions appear to allow virtually unlimited scope on the use of these forms and the approach we have taken is to present the main report as an addendum while inserting the words "See separate sheet" in the appropriate boxes on the form itself. We also include on the addendum instructions on how amendments should be presented and a warning that if no reply is received the IPE report, based on the written opinion, will issue automatically.
- 2.5.2 This approach helps with the other main deficiency of the form which is that it is differently arranged from the IPE Report Form PCT/IPEA/409. We are able to arrange the addendum to the written opinion form so that it can be translated directly into the IPE report if there is no reply to the written opinion (this happens in 35% of cases). It would however be much more efficient if the two forms could be brought into much closer alignment so that the same objections have a place, as far as possible the same place, on each form.
- 2.5.3 We would like to move towards the use of a word processing package for production of the forms. Although a package has been put together we do not at present feel able to adopt it (a) because the possibility appears to be ruled out by the Administrative Instructions in the case of Form 409 (Section 102(b); Section 102(c)(ii) specifically excludes the IPE report form) and (b) because of the constraints of the differing layout of Form 408 which do not allow the Form 409 to be completed by translation from Form 408.
- 2.5.4 It would be helpful, particularly for the purpose of drafting instructions, if each section of the forms could be clearly numbered, with letters for identifying sub-sections.
- 2.5.5 It would be helpful if the written opinion could be more prominently marked "WRITTEN OPINION" together with a space - again prominent - indicating "REPLY DUE BY ...". A space for indicating the final date for completion of the IPE report in accordance with Rule 69(a) would be of assistance.
- 2.5.6 Other specific deficiencies in Form 408 are -
lack of provision for ~~identifying amendments made~~ ~~(cf. Form 409, Basis of Report)~~, ~~lack of provision~~ for identifying plurality of invention (especially in cases treated under Rule 68.1 when Form 405 is not used), lack of provision for identifying patents excluded from consideration by Rule 64.3 and to be referred to in the IPE report as provided for in Rule 70.9.
~~Instructions on how amendments should be made ought to be included.~~
- 2.5.7 Deficiencies in Form 409 include - lack of provision for reference to amendments made under Article 19, lack of suitable continuation sheets; it would also be logical if the classification (IPC) data were included with other bibliographic details. There is no provision for explanation of plurality at item 3(a). Although this information has been conveyed to the applicant in Form 405 it is not thereby made available to elected offices. The explanation required at (b) should precede both (a) and (b) and apply to both. At present we complete section (b) when section (a) is completed but delete the words "No

invitation has been issued".

2.6 To assist agents and applicants we now issue the IPE report (Form 409) printed on white paper to distinguish it from the blue written opinion (Form 408). It has only recently come to our attention that this is permissible.

2.7 IPE work has expanded considerably in recent years, 112 examinations were carried out in 1986, 159 in 1987 (42% increase) 378 in 1988 (138% increase) and an estimated 570 in 1989 (50% increase). At the present rate of filing of Demands this could rise to 1000 in 1990.

In approximately 12% of cases the IPE report issues at the first action. In just over 70% of cases one written opinion issues and half of these (i.e 35%) attract no reply and the IPE report issues automatically based on the first written opinion. Examiners are discouraged from issuing further written opinions and in only 15% of cases did two or more written opinions issue.

[Annex F follows]

European Patent Office
January 1990

European Patent Office

Office européen
des brevets

European Patent
Office

Europäisches
Patentamt

General observations
on the EPO's work as
ISA and IPEA



I. The EPO as ISA

The EPO acts as an International Searching Authority for more than 20 receiving Offices, including all the receiving Offices of the EPC Contracting States, the USA, Japan and, as from 1 January 1990, Canada.

The Annex contains some statistics on the EPO's ISA work in 1988 and 1989.

A few suggestions designed to improve the general functioning of the ISAs are set out below.

1. Co-operation between the various ISAs might be improved with a view to greater standardisation of the citation categories in the international search report.

Such harmonisation would be beneficial

- to the applicant, by making it easier for him to judge the importance of citations in the report and thus helping him to take the necessary decisions at the end of PCT phase 1;
- to the EPO when carrying out supplementary searches during the regional phase (Article 157(3) EPC) since these require a swift assessment of international search reports drawn up by other ISAs.

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Zeichen 57.8.10/11
Reference
Datum 11 Jan. 1990
Date

Mr. A. Schäfers
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World Intellectual
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Subject: Meeting of International Authorities under the PCT
Geneva, 15 to 19 January 1990

Dear Mr. Schäfers,

I refer to the WIPO Circular C. 360 dated 4 September 1989.

I have pleasure in enclosing the EPO report concerning our practice and experience with the Office activity as an ISA and IPEA. We felt it useful to give also a few comments on the impact of the international preliminary examination report on the regional phase when the EPO acts as an elected Office.

Yours sincerely,


Dr. U. Schatz
Principal Director
International Affairs

.../...

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Initially the EPO itself had some problems with standardising the citation categories used in European search reports, because of the terseness of the definitions given in the European Search Guidelines. However, a training programme for examiners based on internal instructions has now brought about a satisfactory situation.

2. When acting as an ISA the EPO sometimes has difficulty in obtaining quickly a copy of the documents cited in the international application in order to verify their content; this holds up the search.

It is suggested that applicants be recommended to forward a copy of any non-patent literature cited in their applications as a matter of course. A similar procedure is being considered for European patent applications filed direct.

3. The number of claims in PCT applications, especially in chemistry, is much higher than in European applications filed direct. Searching PCT applications thus involves much more work.

It is therefore suggested that consideration be given to establishing a legal basis for ISAs to charge, as part of the search fee, for each claim in excess of a minimum number.

4. As regards the application of Rule 16bis it has been the EPO's experience that, in many cases where the applicant does not in the end pay the search fee, the search has already been carried out because the ISA was informed late by the receiving Office.

.../...

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Furthermore, application of this Rule causes considerable administrative work for the ISA.

The EPO suggests exploring ways of simplifying the Rule 16bis procedure.

5. File handling procedures have been automated at the International Bureau and at a number of ISAs (including the EPO).

One way of streamlining these procedures would be to allow mutual access to computerised files; this would, in particular, prevent the capturing of bibliographic data relating to international applications being duplicated by the International Bureau and the respective ISA.

It would be necessary beforehand to consider how the confidentiality of computerised data could be safeguarded.

II. THE EPO AS IDEA

1. A tremendous increase of demands for international preliminary examination received by the EPO has taken place in the last three years. Departing from 522, received in 1987, the number of demands raised to 1488 (+ 41%) in 1988 and to 2470 (+ 60% compared with the preceding year) in 1989.

2. While no major problems are in general noted it nevertheless still appears as if some Applicants are not fully informed about the specific procedural aspects of PCT. The resulting problems combined with the rather short time available for the preliminary examination sometimes have the consequence that the substantive examination cannot be efficiently carried out. It would therefore seem appropriate if Applicants could be provided with additional information relating to potential error sources.

.../...

3. Listed below are some specific areas where a reduced error rate would immediately lead to substantial time savings and thus to more reliable examination reports.

i) Some Applicants are apparently not fully aware of where and when to file different documents (i.e. demands, authorizations, later elections, amendments).

ii) The use of old versions of the demand form PCT/IPEA/401 leads to unnecessary problems and delays.

Box IV relating to amendments in the international application is often incorrectly used.

iii) The meaning of examination fee and handling fee is not always clear.

iv) Lately we have also more frequently experienced that interviews are requested even before the first written opinion has been issued.

Such practice is in general useless and leads to waste of time for the examiners; advanced interviews are in principle not practiced either in the EP-procedures.

v) American type claims are more time consuming (not only for IPEA but also for ISA as it has been pointed out under Chapter I) and should preferably be avoided.

vi) Medical use-type claims. Compared with the EPO-Guidelines, the current PCT-Guidelines do not explicitly deal with this type of claims. Due to the specific EPO practice claims of this type have to be

.../...

given a special wording to allow a meaningful opinion on novelty, inventive step and industrial applicability (cf. also the EPO observation to the Guidelines in document PCT/MIA/I/4, page 14, point 2.5, Annex 2); Applicants should be better informed of that practice with a view to filing properly amended claims together with the Demand.

III. EXPERIENCE OF THE EPO AS ELECTED OFFICE WITH INTERNATIONAL PRELIMINARY EXAMINATION REPORTS

i) When the EPO was also IPEA

In cases like these the opinion expressed in the IPER (PCT/IPEA/409) is in general followed in the corresponding Euro-PCT case. Since the same Examiner is, as a rule, involved in the international (PCT) as well as the European (Euro-PCT) application, this procedure does not give rise to any specific problems.

ii) When the EPO was not IPEA

In cases of this kind, it can happen that a different result might be reached in the Euro-PCT case than in the IPER.

One difficulty, considering the opinion in the IPER, follows from the fact that it is not always possible to realize how and why a specific opinion was reached by the IPER. The reason for this is that the extent and completeness of the IPER varies significantly depending on the IPEA. Thus the IPER often does not give a reasoned statement on the major points in the international examination, namely, novelty and

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PCT APPLICATIONS FOR WHICH THE EPO ACTS AS
PCT SEARCH AUTHORITY

Y E A R 1 9 8 9 (Cumulative totals)

RECEIVING OFFICES	07	08	09	10	11	12
EP	923	1 039	1 157	1 258	1 389	1 558
AT	64	71	83	90	100	120
BE	37	41	46	49	50	52
CH	142	155	176	187	212	220
DE	490	568	613	682	739	793
FR	392	469	513	577	627	704
GB	846	996	1 155	1 292	1 429	1 514
IT	55	65	66	74	77	83
NL	60	68	69	83	84	97
OTHERS	13	14	16	16	18	21
JP	27	31	36	40	44	46
US	1 116	1 262	1 394	1 586	1 724	1 868
CUM. TOT:	4 163	4 774	5 324	5 934	6 493	7 076
1988	3 460	3 921	4 394	4 858	5 405	5 901
1989/1988 %	+ 20.3	+ 21.8	+ 21.2	+ 22.1	+ 20.1	+ 19.9

inventive step. In such cases, no mentioning is made of the nearest prior art and how the examined claims differ therefrom. It is not possible to assess therefore why a conclusion was reached by the IPEA unless the EPO were to request access to the previous written opinions in such cases.

iii) To increase the value of the IPER for the elected offices, it therefore seems appropriate if more uniform rules and criteria were used by the different IPEAs when drafting the IPER.