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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

**MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PCT**

**Fourth Session
Geneva, June 27 to July 1, 1994**

PROPOSALS FOR SAMPLE FILLED-IN FORMS TO BE ANNEXED TO THE
PCT PRELIMINARY EXAMINATION GUIDELINES

Document prepared by the International Bureau

1. The Annex to this document contains proposals provided by the European Patent Office for sample filled-in forms to be annexed to the PCT Preliminary Examination Guidelines (document PCT/GL/3). These filled-in forms are an “Invitation to restrict or pay additional fees” in a case of lack of unity of invention, a subsequent “Written opinion” and finally an “International preliminary examination report,” all for the same theoretical case.
2. It is proposed that these filled-in forms be approved by the International Preliminary Examining Authorities at the fourth session of the Meeting of International Authorities under the PCT. They are submitted herewith for information and comment.

[Annex follows]

ANNEX

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

INVITATION TO RESTRICT OR
PAY ADDITIONAL FEES

(PCT Article 34(3)(a) and Rule 68.2)

To: Ross, Gamble & Partner 25 Woodfield Drive Birmingham ENGLAND		Date of mailing (day/month/year) 19.02.1993
Applicant's or agent's file reference	REPLY OR PAYMENT DUE	within 01 months/ days from the above date of mailing
International application No. PCT/GB 92/55555	International filing date (day/month/year)	22/04/1992
Applicant BRIGGS DENTAL COMPANY		


1. This International Preliminary Examining Authority
 - (i) considers that the international application does not comply with the requirement of unity of invention (Rules 13.1, 13.2 and 13.3) for the reasons indicated in the Annex.
 - (ii) therefore considers that there are 2 (number of) inventions claimed in the international application as indicated in the Annex.
 - (iii) recalls that claims relating to inventions in respect of which no international search report has been established need not be the subject of international preliminary examination (Rule 66.1(e)).

2. Consequently the applicant is hereby invited, within the time limit indicated above, to restrict the claims as suggested under item 3, below, or to pay the amount indicated below:

$$\frac{\text{DEM 3000,-}}{\text{Fee per additional invention}} \times \frac{1}{\text{number of additional inventions}} = \frac{\text{DEM 3000,-}}{\text{total amount of additional fees}}$$

The applicant is informed that, according to Rule 68.3(e), the payment of any additional fee may be made under protest, i.e. a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive.

3. If the applicant opts to restrict the claims, this Authority suggests the restriction possibilities indicated in the Annex, which in its opinion would be in compliance with the requirement of unity of invention.
4. In the absence of any response from the applicant, this Authority will establish the international preliminary examination report on those parts of the international application indicated in the Annex which, in the opinion of this Authority, appear to relate to the main invention.

Name and mailing address of the IPEA/  European Patent Office D-80298 Munich Tel. (+49-89) 2399-0, Tx: 523656 epnu d Fax: (+49-89) 2399-4465	Authorized officer W. Adams Tel. (+49-89) 2399-
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INVITATION TO RESTRICT OR PAY ADDITIONAL FEES

International application No.

PCT/GB 92/55555

1. The separate inventions are: A dental device according to Claim 1 and a dental packaging assembly according to Claim 10.
The common concept linking together the independent Claims 1 and 10 is "a dental appliance". This common concept is not novel, see, for example, document US-A- , col. 1, line 52.
Therefore, the subject-matter of Claims 1 and 10 are not so linked as to form a single general inventive concept (Rule 13 PCT).

2. The Applicant may wish to restrict the claims. If they were restricted to those dealing with either of the above identified inventions, they would then comply with the requirements of unity of invention.
Alternatively, as a full **international** search report has been established, a full preliminary examination may also be conducted, providing that additional preliminary examination fees are paid (Article 34 (3) (a), Rule 68 (2) PCT).

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

WRITTEN OPINION

(PCT Rule 66)

To: Ross, Gamble & Partner 25 Woodfield Drive Birmingham ENGLAND		Date of mailing (day/month/year) 05.05.1993
Applicant's or agent's file reference		REPLY DUE within 3 months XXX days from the above date of mailing
International application No. PCT/GB 92/55555	International filing date (day/month/year) 22.04.1992	Priority date (day/month/year) 02.06.1991
International Patent Classification (IPC) or both national classification and IPC A61C7/12		
Applicant BRIGGS DENTAL COMPANY		

1. This written opinion is the first (first, etc.) drawn by this International Preliminary Examining Authority.

2. This opinion contains indications relating to the following items:

- I Basis of the opinion
- II Priority
- III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV Lack of unity of invention
- V Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI Certain documents cited
- VII Certain defects in the international application
- VIII Certain observations on the international application

3. The applicant is hereby **invited to reply** to this opinion.


When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 02.10.1993

Name and mailing address of the IPEA/  European Patent Office D-80298 Munich Tel. (+49-89) 2399-0, Tx: 523656 epmu d Fax: (+49-89) 2399-4465	Authorized officer W. ADAMS Telephone No. (+49-89) 2399-
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WRITTEN OPINION

International application No.
PCT/GB 92/55555

I. Basis of the opinion

1. This opinion has been drawn on the basis of (*Substitute sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed".*):

- the international application as originally filed.
- the description, pages 1-14, as originally filed,
pages _____, filed with the demand,
pages _____, filed with the letter of _____.
- the claims, Nos. _____, as originally filed,
Nos. _____, as amended under Article 19,
Nos. _____, filed with the demand,
Nos. 1-14, filed with the letter of 06.03.1993.
- the drawings, sheets/fig 1/4-4/4, as originally filed,
sheets/fig _____, filed with the demand,
sheets/fig _____, filed with the letter of _____.

2. The amendments have resulted in the cancellation of:

- the description, pages _____
- the claims, Nos. _____
- the drawings, sheets/fig _____

3. This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

4. Additional observations, if necessary:

WRITTEN OPINION

International application No.

PCT/GB 92/55555

IV. Lack of unity of invention

1. In response to the invitation (Form PCT/IPEA/405) to restrict or pay additional fees the applicant has:

- restricted the claims.
- paid additional fees.
- paid additional fees under protest.
- neither restricted nor paid additional fees.

2. This Authority found that the requirement of unity of invention is not complied with for the following reasons and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees:

3. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this opinion:

- all parts.
- the parts relating to claims Nos. _____

WRITTEN OPINION

International application No.

PCT/GB 92/55555

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	13, 14: No
	Claims	_____
Inventive step (IS)	Claims	10 - 12: No
	Claims	_____
Industrial applicability (IA)	Claims	_____
	Claims	_____

2. Citations and explanations

1. US-A- (D1) discloses all the features of Claims 13 and 14 see figs. 7-9, col. 1, line 40 - col. 2, line 32. Therefore the subject-matter of Claims 13 and 14 is not novel.
2. D1 discloses a dental packaging assembly having all of the features of Claim 10 (see figs. 7-9) except for the feature "the sidewall of each container includes a recess in contact with said edge structure for retaining said container in said opening".
The objective problem to be solved by this distinguishing feature is to locate in a precise manner the container and thereby avoid the possibility of it becoming loose.
GB-A-(D2) however, teaches a dental package assembly in which the same problem is addressed and solved in a similar manner to the distinguishing feature of claim 10 (see page 3, lines 51-67, and Fig. 2, 2a).
It would therefore be obvious for the skilled man, seeking to overcome the objective problem in relation to D1, to adopt the teaching of D2. He would therefore arrive at the subject-matter of claim 10 without exercising inventive activity.
Claim 10 accordingly lacks inventive step (Article 33 (3) PCT).

WRITTEN OPINION

International application No.
PCT/GB 92/55555

Supplemental Box
(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Point V, No. 2, Citations and explanations

3. Claims 11 and 12 define minor modifications of the packaging assembly of Claim 10. These modifications are, however, clearly disclosed in D2 (see page 4, lines 11-25, Figs. 3, 4). These claims also lack inventive step.

WRITTEN OPINION

International application No.
PCT/GB 92/55555

VII. Certain defects in the International application

The following defects in the form or contents of the international application have been noted:

Although the independent Claim 1 is cast in the two part form (Rule 6.3(b)), the features "the device (10) includes a film (48) having a straight section (52), and a curved section (54) spaced from said straight section (52), said straight section (52) including a low adhesion surface in contact with said adhesive (60), and means (50) for securing said curved section (54) to said substrate (42, 142)" are known from D1 (see col. 1, lines 54-62 and fig. 9), and should therefore be transferred from the characterising portion of Claim 1 to the preamble.

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/GB 92/55555	International filing date (day/month/year) 22.04.1992	Priority date (day/month/year) 02.06.1991
International Patent Classification (IPC) or national classification and IPC A61C7/12		
Applicant BRIGGS DENTAL COMPANY		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.


2. This REPORT consists of a total of 7 sheets, including this cover sheet.

This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of 5 sheets.

3. This report contains indications relating to the following items:

- I Basis of the report
- II Priority
- III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV Lack of unity of invention
- V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI Certain documents cited
- VII Certain defects in the international application
- VIII Certain observations on the international application

Date of submission of the demand 12.12.1992	Date of completion of this report 19.09.1993
Name and mailing address of the IPEA/  European Patent Office D-80298 Munich Tel. (+49-89) 2399-0, Tx: 523656 epnu d Fax: (+49-89) 2399-4465	Authorized officer W. ADAMS Telephone No. (+49-89) 2399-

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/GB 92/55555

I. Basis of the report

1. This report has been drawn on the basis of (Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.):

- the international application as originally filed.
- the description, pages 1-14, as originally filed,
pages _____, filed with the demand,
pages _____, filed with the letter of _____,
pages _____, filed with the letter of _____.
- the claims, Nos. _____, as originally filed,
Nos. _____, as amended under Article 19,
Nos. _____, filed with the demand,
Nos. 1-9, filed with the letter of 06.03.1993,
Nos. 10-14, filed with the letter of 01.08.1993.
- the drawings, sheets/fig 3/4, 4/4, as originally filed,
sheets/fig _____, filed with the demand,
sheets/fig 1/4, 2/4, filed with the letter of 01.08.1993,
sheets/fig _____, filed with the letter of _____.

2. The amendments have resulted in the cancellation of:

- the description, pages _____
- the claims, Nos. _____
- the drawings, sheets/fig _____

3. This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

4. Additional observations, if necessary:

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
PCT/GB 92/55555

IV. Lack of unity of invention

1. In response to the invitation to restrict or pay additional fees the applicant has:

- restricted the claims.
 paid additional fees.
 paid additional fees under protest.
 neither restricted nor paid additional fees.

2. This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.

3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is

- complied with.
 not complied with for the following reasons:

1. The separate inventions are: A dental device according to Claim 1; A dental packaging assembly according to Claim 10 and A packaging assembly according to Claim 13.

The common concept linking together the independent Claims 1 and 10 is "a dental appliance". This common concept is not novel, see document US-A-, col. 1, line 52.

Therefore, the subject-matter of Claims 1 and 10 are not so linked as to form a single general inventive concept (Rule 13 PCT).

4. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this report:

- all parts.
 the parts relating to claims Nos. _____

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/GB 92/55555

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	<u>1 - 12</u>	YES
	Claims	<u>13, 14</u>	NO
Inventive step (IS)	Claims	<u>1 - 9</u>	YES
	Claims	<u>10 - 12, 13, 14</u>	NO
Industrial applicability (IA)	Claims	<u>1 - 14</u>	YES
	Claims	<u></u>	NO

2. Citations and explanations

1. The difference between the article of Claim 1 and D1 (see fig. 9, col. 1, lines 54 - 62), is that the "straight section (52) of the flexible film (48) is substantially free of direct connection to said substrate".

The problem solved by this difference is that the film undergoes a peeling motion relative to the adhesive as the appliance is lifted from the substrate, rather than moving in a direction perpendicularly away from the appliance in generally flatwise fashion. The peeling motion facilitates separation of the film from the adhesive and permits the use of adhesives that are less viscous. Securing the curved section of the film to the substrate obviates the need for separate handling of the film, so that the film and substrate can be disposed of together (description p. 3, lines 8-19).

No document of the search report teaches the use of a flexible film which has a straight section secured to the substrate and a curved section in contact with the adhesive of the dental appliance but free of direct connection to said substrate.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/GB 92/55555

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Point V., No. 2, Citations and explanations

Therefore, the article of Claim 1 is novel and involves an inventive step as required by Art. 33 (2) (3) PCT.

2. Claims 2-9 define particular embodiments of the article of Claim 1 and would fulfil the requirements of Art. 33 (2)-(4) PCT in combination with this claim.

3. D1 discloses a dental packaging assembly having all of the features of Claim 10 (see figs. 7-9) except for the feature "the sidewall of each container includes a recess in contact with said edge structure for retaining said container in said opening".

The objective problem to be solved by this distinguishing feature is to locate in a precise manner the container and thereby avoid the possibility of it becoming loose.

GB-A- (D2) however, teaches a dental package assembly in which the same problem is addressed and solved in a similar manner to the distinguishing feature of claim 10 (see page 3, lines 51-67, and Fig. 2, 2a).

It would therefore be obvious for the skilled man, seeking to overcome the objective problem in relation to D1, to adopt the teaching of D2. He would therefore arrive at the subject-matter of claim 10 without exercising inventive activity. Claim 10 accordingly lacks inventive step (Article 33 (3) PCT).

4. Claims 11 and 12 define minor modifications of the packaging assembly of Claim 10. These modifications are, however, clearly disclosed in D2 (see page 4, lines 11-25, Figs. 3, 4). These claims also lack inventive step.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
PCT/GB 92/55555

Supplemental Box
(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Point V., No. 2, Citations and explanations

5. D1 discloses all the features of Claims 13 and 14 see
figs. 7-9, col. 1, line 40 - col. 2, line 32, col. 4,
lines 56-60 (if the cover is in several pieces,
partially connected, there will be a "line of perforations"
as in Claim 13).

Therefore, the subject-matter of the Claims 13 and 14
is not new as required by Art. 33 (2) PCT.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
PCT/GB 92/55555

VII. Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

Although the independent Claim 1 is cast in the two part form (Rule 6.3 (b)), the features "the device (10) includes a film (48) having a straight section (52) and a curved section (54) spaced from said straight section (52), said straight section (52) including a low adhesion surface in contact with said adhesive (60), and means (50) for securing said curved section (54) to said substrate (42, 142)" are known from D1 (see col. 1, lines 54-62 and fig. 9), and should therefore be transferred from the characterising portion of Claim 1 to the preamble.