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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PCT

Sixth Session
Canberra, February 17 to 21, 1997

POSSIBLE MODIFICATIONS OF THE PCT SEARCH GUIDELINES

*Proposal by the European Patent Office, the Japanese Patent Office
and the United States Patent and Trademark Office*

1. The European Patent Office, the Japanese Patent Office and the United States Patent and Trademark Office (the "Trilateral Offices"), in the course of their trilateral cooperation, have agreed on Common Ground Rules for International Search relating to the determination of the subject of search (claim interpretation for the purpose of searching), the determination of the field of search and the evaluation of documents.
2. The present text of the PCT Search Guidelines is that contained in document PCT/GL/2, dated November 18, 1992, and published as a Special Issue of the *PCT Gazette*, No. 30/1992, on December 10, 1992, as affected by modifications with effect from January 1, 1994, notified by Circular PCT 526, dated December 1, 1993, and published in *PCT Gazette* No. 29/1993 on December 9, 1993.
3. The Annex to this document contains a proposal by the Trilateral Offices for the incorporation of those Common Ground Rules into the PCT Search Guidelines.
4. *The Meeting is invited to consider the proposal of the Trilateral Offices contained in the Annex to this document.*

[Annex follows]

ANNEX



Europäisches
Patentamt
GD 1

European
Patent Office
DG 1

Office européen
des brevets
DG 1

Rijswijk, 18-11-1996.

Mr. Bartels
Director
PCT Department
World Intellectual Property Organisation
34, chemin des Colombettes
CH-2111 Genève
SUISSE

Re. Proposal for the incorporation of the "Common ground rules for International Search" into the "PCT Search Guidelines"

Dear Mr Bartels,

In the framework of projects 8/17, the trilateral Offices (the USPTO, the JPO and the EPO) examined different aspects of the International Search.

The aim of the study was to analyse which steps can be taken in order to obtain a better harmonisation of the search results and their presentation in the search reports.

Two comparative studies were carried out. A number of international applications were searched by examiners of the three Offices. The JPO, as leading Office for this project, analysed the results and drafted detailed reports.

At the same time, the Offices agreed upon a number of common ground rules which should give our examiners more detailed information and guidance for a number of aspects of search (e.g.: categories of citations, claims not supported by the description, types of claims, etc.), in order to come to a more harmonised approach.

Any possible contradiction with the existing PCT guidelines has been avoided.

It was felt however, that the common ground rules could also be of interest for the other users of the PCT system. Therefore, we submit a proposal to include the "Common ground rules for International search" into the "PCT Search Guidelines".

Enclosed is a copy of the common ground rules. In the left margin we indicated the place where certain paragraphs could be inserted in the PCT guidelines.

As you will notice, a number of titles of chapters or paragraphs of the "Common Ground Rules" have been deleted. They do not fit in the current presentation layout of the PCT Guidelines.

Information already present in the existing PCT guidelines has been deleted as well.

We also propose to clarify some aspects of the vocabulary used in the text of the "Common Ground Rules" during the next MIA meeting.

For the Trilateral Offices



André Cardon
Director search
DG1, EPO

~~COMMON GROUND RULES FOR INTERNATIONAL SEARCH TO BE CARRIED OUT UNDER THE PCT~~

~~I. DETERMINATION OF THE SUBJECT OF SEARCH (CLAIM INTERPRETATION FOR THE PURPOSE OF SEARCHING)~~

~~A. GENERAL PRINCIPLES~~

~~1. Claim Interpretation~~

See III, 3.1

See III, 3.2

insert in III, 3.2

~~a. The PCT rule 33.3 (a) provides that "international search shall be made on the basis of the claims, ... with particular emphasis on the inventive concept towards which the claims are directed." This means that the search examiner should specify the subject of search according to the claimed subject matter. Therefore, a document alone which indicates an abstract idea of a claimed invention but fails to disclose all the features set forth in a claim is not enough to negate the patentability of the claimed invention, unless it is shown that the missing feature is so well-known that documentary evidence seems unnecessary. In other words, the subject of search should not be identified based on the description of an invention (e.g., object, work, or effect of an invention) apart from the features set forth in a claim.~~

See III, 3.6

~~b. On the other hand, the search examiner should not unreasonably be limited to the detail of the workings in a claim but try to determine the subject of search based on disclosed features which might reasonably be expected to be claimed by amendment.~~

insert in III 3.3

~~c. The search examiner should construe the terms of the claims broadly. This broad construction must, nevertheless, be consistent with the specification.~~

~~1.1 Types of Claims~~

In evaluating novelty or inventive step, the search examiner should consider which type of the transition phrase the claims have. The subjects to be searched are specified according to the type of transition phrases.

insert between III 3.11 and III 3.12

(1) Closed Type Where a claim is drafted in a Closed Type, the claims cannot be read on products or processes that include structural elements or process steps other than those set forth in the claim.

For example, if a claim recites "A product consisting of A, B and C." in English, it does not read on and is novel over prior art that

Insert between

~~III 3.11 and~~
~~III 3.12~~

discloses a product having A, B, C and D, or any other additional feature or elements.

(2) Open Type

Where a claim is drafted in a Open Type, this type of claims can be read on products or processes that include non-recited structural elements or process steps.

For example, if a claim recites "A product comprising A, B and C." in English, it reads on and lacks novelty over prior art that discloses a product having A, B, C and D, as well as any additional feature or element.

Insert in

~~III 3.14~~

~~1-2. Claims in Two-part Form~~

The claimed invention includes the limitations of the preamble in combination with the limitations in the improvement portion of the claim. In these cases, the preamble is regarded as a claim limitation.

Insert between

~~III 3.11 and~~

~~III 3.12~~

~~1-3. Types of Expression~~

~~a. Functionally Expressed Features
(Functional Limitations)~~

~~1) "Means Plus Function" Claim~~

Product (Apparatus) claims containing the "means plus function" language should be considered to include all means consistent with the specification capable of performing the stated function unless the means are further specified in the claims. If the means are further specified, the claims would be interpreted to include those further specified limitations. For example: A claim recites valve means for restricting the flow of fluid. The claim would be interpreted by the search examiner to include the further specified limitation of a valve means rather than any means for restricting flow of fluid.

Note.

The words "consistent with the specification" means that the limitations are interpreted with due regard to the description and drawings (if any) and with particular emphasis on the inventive concept towards which the claims are directed.

~~b. Process Limitation in Product Claims
(Product-by-process Claims)~~

Where a claim defines a product by its manufacturing process, determination of the subject of search is based on the

product itself rather than the process steps since the claim, as a whole, is directed to a product.

Novelty of the product is denied even if an identical prior art product was made by a different process.

[Example 1] "Protein which is obtained by process P (steps P1, P2, ...)"

If the protein which is obtained by process P is identical to a prior art protein Z which is manufactured by process Q that is different from process P, the claim in example 1 is denied novelty.

In those certain cases where the product can only be defined by the process steps, the examiner would consider the process steps in determining the subject of search.

[Example 2] "A two-layer structured panel which is made by welding together an iron sub-panel and a nickel sub-panel"

The process of "welding" would be considered by the search examiner in determining the subject of search since the process of welding produces physical properties in the end product which are different from process other than welding i.e. the product can only be defined by the process step. The claim is not defined novelty unless an identical two-layer structured panel made by means of welding is shown in the prior art.

Insert
between ^{III.} 3.11
and ^{III.} 3.12

~~c. Product Limitations in Apparatus Claims for Producing a Product~~

Product limitations in apparatus claims are generally given no weight in assessing novelty and inventive step. For example: A claim recites a cutting machine for cutting meat comprising apparatus limitations. The claim language "meat cutting machine for cutting meat" sets forth only the function of the apparatus(i.e., for cutting meat) without any positive structural limitations and would not be given any weight in assessing novelty and inventive step so long as the prior art cutting machine was capable of cutting meat. In this case, one should treat the limitation machine for cutting meat, as if the statement were to be a machine adapted to cut meat. Thus, one would look to the prior art to see whether the cutting machine would be inherently capable of cutting the meat whether the prior art description recited what is being cut or not.

~~d. Apparatus Limitations in Process Claims~~

Apparatus limitations in process claims are taken into account when the apparatus limitations affect the process in a manipulative sense.

~~2. Claim not Supported by the Description~~

See III.3.7

~~If there are well-founded reasons to believe that a broad generic claim is not supported by the description, it would be appropriate to conduct search within the claimed subject matter supported by the description. (International Search Guidelines, III.3.7)~~

Insert in
III.3.7
(end)

However, if a meaningful search for a claim not covered by the description can be carried out without many extensions of the scope of search and much increase in the effort of search, and its scope is not unduly wide, the search should be extended to cover the claimed subject matter that is not supported by the description. For example: A broad Markush grouping of insecticidal agents which includes halogenated hydrocarbons, carbamates and pyrimidine derivatives would not necessitate a search for halogenated hydrocarbons, if no specific halogenated hydrocarbons were disclosed in the description since, as to halogenated hydrocarbons, they are not supported by the description.

~~B. SUBJECT MATTERS EXCLUDED FROM THE SEARCH~~

Insert in
VIII 1.1
(end)

~~4. If the claims are directed to subject matters the search for which PCT and PCT regulations permit to exclude, e.g., a method for treatment of the human body, the search examiner should take either of the following ways:~~

The search examiner conducts the search based on the subject matter which might reasonably be expected to be claimed from the contents of the description and drawing by amendment if the expected amended claims would make a meaningful search possible.

The search examiner conducts the search based on the real claims if the claimed subject matter is considered as statutory subject matter under the patent law in that Office.

~~C. LACK OF CLARITY~~

Insert
between
VIII 2.1 and
VIII 2.2

In this item "Lack of Clarity" of the claim means there are any kind of defects in the claims and the defects cause any difficulty in determining the scope of the claims based on the claimed language only, e.g., obscure, inconsistency, vague, ambiguous expression in the claims. These kinds of defects include not only the cases where the claim languages are not clear even after taking the specification into account but also the cases where the claim languages are not clear by themselves but the scope of the claim becomes clear in light of the specification.

~~4. Where a claim has unclear descriptions, and the technical feature of a claimed invention cannot be identified at all even after taking into account all the contents of the description and drawings and~~

Insert
between
VIII 2.1 and
VIII 2.2

common general knowledge, it is obscure and therefore no international search will be implemented.

2. When the claimed subject matter taken as a whole includes alternatives some of which are clear realisation of the invention as well as other alternatives which are unclear realisation of the invention (partially unclear), the search examiner should search the clear realisation of the invention. With regard to the unclear features, the search examiner should determine the subject of search based on the subject matter which might reasonably be expected to be claimed by amendment taking into account the contents of the description and drawings and the common general knowledge in the relevant technical field and conduct the search based on the determined subject. For example: if the invention relates to a combination of $a + b + c + d$ in which b is obscure no search will be performed. However, if the invention relates to a combination of $a1$ or $a2 + b1$ or $b2$, in which $a2$ is obscure, the combination of $a1 + b1$ and $a1 + b2$ will be searched.

3. It should be noted, however, that a reasonable effort should be made before the search examiner concludes that a part of the claimed subject matter is too unclear to be included in the subject of search.

II. DETERMINATION OF THE FIELD OF SEARCH

A. GENERAL PRINCIPLES

Insert between
IV 2.1 and
IV 2.2

1. The field of search should include analogous fields with respect to claimed inventions which are construed broadly to the extent they are consistent with the description of the specification.

2. For a Jepson claim, or a two-part claim, the search examiner should consider not only the limitations set forth in the body but also those in the preamble in planning the field of search.

B. ANALOGOUS FIELDS

Insert in
IV 2.2
(end)

1. In determining analogous fields into which search should be extended, it would be useful to give consideration to:

a. Fields in which the same or similar structure is expected to be employed in different work or use.

b. Fields to which a generic concept of claimed features pertains.

Insert in
IV 2.2
(end)

c. Art within the field of the inventor's endeavour and reasonably pertinent to the particular problem with which the inventor was involved.

d. Fields relevant to the function or utility inherent in the subject matter covered by the claims, i.e. the field to which the application is most probably applied in addition to the general field of the subject matter would be searched.

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III. EVALUATION OF DOCUMENTS

A. GENERAL PRINCIPLES

1. The category symbol assigned to a cited reference should be based on the real claims as a general rule.

In evaluating cited documents, the search examiner should not read into claims any limitations that are disclosed in the specification but not claimed.

2. When assessing novelty and inventive step, the search examiner should interpret claims giving them the broadest reasonable interpretation consistent with the specification just as stated in the "determination of the subject of search".

3. Claim in Two-part Form

In applying the inventive step standard, if the search examiner was unable to locate a reference of the preamble, and it is understood that from the description in the specification the applicant is considered to have admitted that the features in the preamble were known to public, the search examiner is entitled to consider the features in the preamble to be known. However, since this presumption is rebuttable, the examiner should search and cite documents as far as possible.

4. In the cases where the search examiner makes specific claim interpretations described in "I. DETERMINATION OF THE SUBJECT OF SEARCH", (e.g., type of claims, claims in two-part form, types of expression) the evaluation of references for such claim also follows the claim interpretations mentioned above.

However, special attention should be paid in evaluating the references when assessing the subject matters which may be excluded from the international search:

a. in the Office where such subject matters are considered nonstatutory, the category symbol is assigned based on the subject matter which might reasonably be expected to be claimed by

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amendment, but if possible, the assessment is done based on other real claims, which are statutory and

b. in the Office where such subject matters are statutory, the category symbol is based on the real claim.

B. SYMBOL "X"

1. Evaluation of Novelty

a. A document whose content destroys the novelty of at least one independent claim, and possibly that of one or more claims depending on it is categorised as "X".

b. Where there is a trivial difference - merely in wording, but not essential between the claimed subject matters and those in the reference, category "X" is assigned to the reference.

c. Generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but a specific disclosure does take away the novelty of any generic claim embracing that disclosure. Therefore, where a claimed subject represents a generic concept and a prior art document describes a specific concept within the generic concept, category "X" is assigned to the document.

2. Evaluation of Inventive Step

A document whose content alone calls into question the inventive step of at least one independent claim, and possibly that of one or more claims depending on it would be categorised as "X".

This occurs in the following cases, for example,

1) where a technical feature known in a technical field is applied from its original field to another field and its application therein would have been obvious to a person of ordinary skill in the art.

2) where a difference between the document's content and the claimed subject matter is so well-known that documentary evidence seems unnecessary.

3) where a claimed subject matter relates to a use of a known product, and the use would have been obvious from a known properties of the product.

4) a claimed invention, differs from the known art merely in the use of equivalents that are so well known that the citation of documentary evidence is unnecessary.

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[PCT Preliminary Examination Guidelines, IV 8.8 (A) (ii)]

3. Others

a. Documents assigned "X" category for dependent claims, would also be assigned category "X" for the claims from which it depends.

b. Relevant documents should be assigned category "X" when a claim involves several options and the novelty is destroyed or inventive step is called into question of at least one option, solely by the documents concerned.

C. SYMBOL "Y"

1. General

a. In order to deny patentability based on lack of inventive step, the claimed invention taken as a whole must have been obvious to a person of ordinary skill in the art.

b. There must be some collective teachings in the prior art that would suggest to a person of ordinary skill in the art why the references' teachings are combinable.

The "teaching" would be preferable to describe explicitly in a prior document.

But the "teaching" to combine references need not be explicitly found in the reference. This includes such cases where the prior arts produce the grounds for reasoning that a person skilled in the art could have easily arrived at the claimed invention based on the prior art documents.

c. Inventive step can be called into question by combination of cited documents for example in the following cases;

1) Obvious choice from a number of alternatives which are equivalent.

In a case where a document discloses all the claimed features except for the selection of alternatives, and another document teaches that the two alternatives are equivalent in their work and result, it would have been expected of a person skilled in the art to combine the two documents, which make up the claimed features.

2) A claimed invention consists merely in the juxtaposition or association of known devices or processes functioning in their normal way and not producing any non obvious working interrelationship.

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3) The collective suggestions of the references show recognition and solution of the problem addressed by the applicant as providing a rationale for combining teachings of the references.

2. Evaluation of Dependent Claims

Dependent claims must be read as a whole taking into account and incorporating limitations of the claim from which they depend.

In assessing dependent claims, the following points are to be considered.

a. A combination of "Y" documents should be concerned not only with a dependent claim's characterising portion itself but with its combination with the claim(s) on which it depends.

b. Combination of "Y" documents obviously cannot be used for a dependent claim if the claim(s) on which it depends is/are not also called into question by this combination "Y" documents or by one of them designated "X".

3. Others

a. Category "Y" should not be used for one document only.

b. "Y" category documents relevant to the same claims should be cited in a successive order as much as possible.

c. Relevant documents should be assigned category "Y", when a claim involves several options and the documents can be assigned in two ways, i.e. category "Y" or category "A" according to the contents of the options.

D. SYMBOL "A"

1. Documents Which Covers the Prior Art Portion

"A" is assigned to

a. a document intended to exemplify or delimit the prior art portion of an independent claim more satisfactorily, but there is no located documents which in combination would have called into question the inventive step of a claim and therefore not calling itself the inventive step into question;

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b. a document describing the background art, assumed to be known in the context of the introductory part of the description but not identified by precise citations.

2. Documents Which Covers the Characterising Portion

"A" is assigned to a document concerning the part of the features of a claim's body or characterising portion, but not calling the inventive step into question.

3. Other Type Documents

"A" is also assigned to a document describing the general technological background to the invention.

E. SYMBOL "E"

"E" is used when the document filed before the filing date is published or granted after the application's international filing date.

"E" should always be accompanied by a symbol indicating the relevance of the document ("X", "Y" or "A").

F. SYMBOL "L"

The symbol "L" should be used for citing documents which are not otherwise designated by other symbols such as undated printed publications. The reason for citing the documents should be described next to the citation of the documents.

In the case where undated printed publications are cited, the examiner should point out the close similarity of the subject matter described to applicants claims and should indicate that the publications' dates are being sought.

G. SYMBOL "O"

The symbol "O" is used to designate documents which contain information concerning prior oral disclosure, public use or other prior public knowledge of the invention.

"O" should always be accompanied by a symbol indicating the relevance of the document ("X", "Y", or "A").

H. SYMBOL "P"

The symbol "P" is used to designate documents having a publication or grant date prior to the filing date of the international application but after the priority date of the application.

"P" should always be accompanied by a symbol indicating the relevance of the document ("X", "Y", or "A").

I. SYMBOL "T"

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The symbol "T" is used to designate the documents which may be useful for a better understanding of the invention.

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