

# WIPO



**PCT/R/WG/1/3 Add.1**  
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**DATE:** October 31, 2001

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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

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

**WORKING GROUP ON REFORM OF THE PATENT**  
**COOPERATION TREATY (PCT)**

**First Session**  
**Geneva, November 12 to 16, 2001**

UNITED STATES PROPOSAL FOR IMPLEMENTATION OF PROPOSALS (6), (7), & (9)  
OF THE PROPOSALS OF THE UNITED STATES FOR PCT REFORM (PCT/R/1/2)

ADDENDUM: SAMPLE EXPANDED INTERNATIONAL SEARCH REPORT

*Proposals submitted by the United States of America*

This document contains an addendum to the proposals of the United States of America set out in document PCT/R/WG/1/3. The Annexes to this document contain a sample expanded international search report (EISR) (Annex II) together with a draft notification form which would be sent together with the EISR (Annex I). The sample is intended to provide a framework for formatting only; the content thereof is not to be controlling in any way.

[Annex I follows]

## ANNEX I

## DRAFT NOTIFICATION FORM

## PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING and  
PRELIMINARY EXAMINING AUTHORITY

To:	<h1 style="margin: 0;">PCT</h1> <p style="margin: 0;">NOTIFICATION OF TRANSMITTAL OF THE EXPANDED INTERNATIONAL SEARCH REPORT</p> <p style="margin: 0;">(PCT Rule XXX)</p>
	Date of mailing <i>(day/month/year)</i>
Applicant's or agent's file reference	<b>FURTHER ACTION AND REPLY DUE</b> See paragraphs 1 and 4 below
International application No.	International filing date <i>(day/month/year)</i>
Applicant	

1.  The applicant is hereby notified that the expanded international search report has been established and is transmitted herewith.

**Filing of amendments and statement under Article 19:**  
The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):

**When?** The time limit for filing such amendments is normally two months from the date of transmittal of the expanded international search report; however, for more details, see the notes on the accompanying sheet.

**Where?** Directly to the International Bureau of WIPO  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland  
Facsimile No.: (41-22) 740.14.35

**For more detailed instructions**, see the notes on the accompanying sheet.

2.  The applicant is hereby notified that no expanded international search report will be established and that the declaration under Article 17(2)(a) to that effect is transmitted herewith.

3.  **With regard to the protest** against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:

the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.

no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. **Further action(s):** The applicant is reminded of the following:

Within **30 months** from the priority date, the applicant must perform the prescribed acts for entry into the national phase before all designated Offices.

Address only: Assistant Commissioner for Patents Box PCT Washington, DC 20231 Facsimile No. (703) 305-3230	Authorized officer   Telephone No.
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## ANNEX II

**[SAMPLE] EXPANDED INTERNATIONAL SEARCH REPORT (EISR)**  
(PCT Article 18 and Rules 43 and 44) – Form PCT/ISPEA/ZZZ)

**FOR FURTHER ACTION** See Notification of Transmittal of EISR (Form PCT/ISPEA/YYYY).

Applicant's or agent's file reference: AGGR/01/94

International application No: PCT/US94/98989

International filing date: 01 April 1994 (01/04/1994)

Priority date: 02 April 1993 (02/04/1993)

International Patent Classification (IPC) or national classification and IPC: 606/185  
B63H 25/02

Applicant: Heath Robinson

Title: SURGICAL KNIFE

This EISR has been prepared by the International Searching and Preliminary Examining Authority (ISPEA) and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

It may also be accompanied by a copy of each prior art document cited in this report.

**(1) Priority**

Not applicable.

**(2) Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

The question whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable has not been examined in respect of claims Nos. 1, 2 because:

The subject-matter of claims 1, 2 does not require an international search with respect to industrial applicability as it is directed to a scientific theory. (Article 17(2)(a)(i), Rule 39.1(i)).

**(3) Lack of unity of invention**

This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is not complied with for the following reasons:

- (i) Claims 3-8 relate to a surgical knife.
- (ii) Claims 9, 10 relate to a method of sharpening knives and are not restricted to the type of knife claimed in Claim 3.

Consequently, the parts of the international application relating to claims 3 - 8 were the subject of international search in establishing this report.

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

Novelty (N): Claim(s) 4, 5, 6-8, 9-10  
Yes  
Claim(s) 3  
No

Inventive Step (IS): Claim(s) 5, 6-8, 9-10  
Yes  
Claim(s) 3, 4  
No

Industrial Applicability (IA): Claims 3-10  
Yes

A surgical knife for use in making incisions is disclosed in JP-B-50-14535 (hereinafter referred to as document 1) comprising the following features:

A releasable handle, a profiled grip and a serrated blade - see column 1, lines 20-55 and Figures 2,3.

A quartz blade - see column 3, lines 70-110 and Figure 4.

The subject-matter of Claim 3 does not therefore meet the requirements of Article 33 (2) of the PCT.

The additional features of Claim 4 are already known from GB-A-392,415 (document 2). Moreover the reasons why those features are used in the knife disclosed in that document are identical to the present application. The adoption of these features in the knife disclosed in document 1 is therefore obvious for the skilled man. The subject-matter of Claim 4 is accordingly lacking inventive step contrary to Article 33(3) PCT.

None of the available prior art discloses the features claimed in Claim 5. Moreover, these features achieve the result of achieving a more precise incision than was hitherto possible using existing knives.

The subject-matter of Claim 5 in combination with that of Claim 3 would therefore appear to meet the requirements of Articles 33(2) and 33(3) PCT.

Claims 6-8 contain modifications of the inventive idea embodied in the combination of Claims 3 and 5 and also meet the requirements of Articles 33(2) and 33(3) PCT.

The method of sharpening knives claimed in Claim 9 is based on GB-A-2,174,500 as nearest prior art. Compared with this known method the angle of the grinding wheel is controlled between limits by a

control unit which measures various parameters during the grinding operation. No prior art document gives a lead to these features: Claim 10 contains a minor modification of the inventive idea of Claim 9.

The "Surgical instruments" text is cited to illustrate surgical knives which are similar to the implement disclosed in the present application. See especially paras 146 to 148.

The IBM reference and the Machine Design reference are cited to show machining of silicon substrates and silicon surgical blades. While they cannot be considered to be prior art against the claimed invention, nevertheless they show manufacturing techniques relevant to the manufacture of surgical blades of the type disclosed herein.

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**(5) Certain documents cited**

Document US-A-4,322,752, filed on 07/10/92, published on 06/07/93 with a claimed priority date of 08/11/91 (validity not checked) does not constitute prior art within the meaning of Rule 64.1(b) PCT, but appears to disclose all the features of claims 3-6.

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**CLASSIFICATION OF SUBJECT MATTER:**

(51) IPC<sup>5</sup>: B63H 25/02, B63H 25/04

**(58) FIELDS SEARCHED**

**Minimum documentation searched:**

**US Cl.** 606/185; 606/167

**IPC<sup>5</sup>:** B63H 25/02, B63H 25/04

**(6) Certain defects in the international application**

The drawings are objected to under PCT Rule 66.2(a)(iii) as containing the following defect(s) in the form or content thereof: Figure 4 is missing the reference numerals referred to on sheet 4 of the description.

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**(7) Certain observations on the international application**

The description is objected to under PCT Rule 66.2(a)(v) as lacking clarity under PCT Article 5 because it fails to adequately enable practice of the claimed invention because the description fails to state how to fabricate the knife from silicon.

Claim 2 is objected to under PCT Rule 66.2(a)(v) as lacking clarity under PCT Article 6 because the claim 2 indefinite for the following reason(s): There is no antecedent basis in the previous claim for the sliding slot.

**Databases searched:**

- LEX PAT "surgical knife" in abstracts
- CAS ONLINE "silicon substrates" in abstracts

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**DOCUMENTS CONSIDERED TO BE RELEVANT**

(Citation, any relevant passage (\*))

- (1) JP 50-14535 B (NCR CORPORATION)  
28 May 1975 (28.05.1975)
- (2) GB 392,415 A (JONES) 18 May 1933  
(18.05.1933)
- (3) GB 2, 174,500 A (STC) 5 November 1986  
(05.11.1986)
- (4) H. WALTER, "Surgical instruments," Volume 2,  
published 1974, by Sweet and Maxwell (London).  
\* pages 138 to 192.\*
- (5) IBM Technical Disclosure Bulletin, Volume 17,  
No. 6, October 1975 (Armonk, New York), J.P.  
Green, "Fabrication of Silicon Substrates."
- (6) Machine Design, Volume 62, No. 23, issued 08  
November 1990 (08.11.90) (Cleveland, Ohio),  
USA, D.I. Shetulov, "Micromachined Silicon  
Surgical Tool."
- (7) US 4,322,752 A (BIXTY) 07 October 1982  
(07.10.1982)

**Patent family information**

- **US 4 322 752 A:**

WO	8102084	A	23.07.1981
EP	0043828	A,B	20.01.1982
CA	1157145	A	15.11.1983

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**ISPEA** U.S. Patent and Trademark Office  
Commissioner of Patents  
Box PCT  
Washington, DC 20231  
Tel: 703 308 9999  
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**Examiner:** Pool, George S.

EISR completed: 30 November 1994  
EISR mailed: 8 December 1994

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**\*\* End of the EISR \*\***