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WORLD INTELLECTUAL PROPERTY ORGANIZATION
UNITED INTERNATIONAL BUREAUX FOR THE PROTECTION OF INTELLECTUAL PROPERTY
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PATENT COOPERATION TREATY

INTERIM COMMITTEE FOR TECHNICAL COOPERATION

STANDING SUBCOMMITTEE

Third Session, Geneva, October 2 to 5, 1972

ADDENDUM TO DOCUMENT PCT/TCO/SS/III/12

prepared by the International Bureau

1. Document PCT/TCO/SS/III/12 contains, in addition to a report submitted by the Patent Office of Germany (Federal Republic) on its experience in performing "isolated searches" similar to the expected PCT searches, a reference to a report of the same nature which the International Patent Institute (IIB) will later submit.
2. Annexed to this document is the report submitted by the IIB concerning its experience in performing "isolated searches."

/Annex follows/



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Réf.: VW/45/vn

PCT/TCO/SS/I/17

Mr. G.H.C. BODENHAUSEN,
Director General of the World Intellectual
Property Organization,
32, Chemin des Colombettes
1211 GENEVE 20 - Suisse.

LA HAYE, le 28 juillet 1972.
97, Nieuwe Parklaan

Dear Mr. Bodenhausen,

Enclosed I am sending you the I.I.B.--report
on isolated searches.

Yours faithfully,



(P. van Waasbergen)

Encl.

ISOLATED SEARCHES

1. The report of the first session of the Standing Subcommittee of the PCT Interim Committee for Technical Cooperation says in paragraphs 56 and 57 of document PCT/TCO/SS/I/17 the following:

56. The Standing Subcommittee noted with appreciation the offer of the German Patent Office to make a report on its experience in performing "isolated searches", similar to the expected PCT searches, and invited the International Bureau to circulate that report to the prospective PCT Authorities.

57. The I.I.B. also agreed to make a report on its experience with "isolated searches", it being understood that the I.I.B. report would also cover such searches made for the Netherlands Patent Office and would be established after the report of the German Patent Office was available.

The present document reports on the I.I.B. experiences with "isolated searches".

2. Definition

In this report an isolated search is defined as a search:

- a. ordered by a patent office;
- b. referring to a filed patent application;
- c. intended to find documents of importance for judging novelty and inventive activity;
- d. leading to a report which does not express an opinion.

Under this definition fall the searches carried out by the I.I.B. on behalf of the French and Netherlands Patent Offices. The present report refers to these two categories of searches.

3. The present report does not refer to PCT searches as the I.I.B. has up till now no experiences with such searches. It is believed, however, that the character of the I.I.B. searches as carried out on behalf of the French and Netherlands Patent Offices corresponds to a high degree with that of PCT searches so that conclusions may be drawn.

The reason that the searches carried out on behalf of the Swiss Patent Office have not been taken into account, is that up till now the reports concerning these searches differ essentially from those required for the future PCT system. It is however very probable that a standardisation will be decided so that the search reports concerning the searches for the French, Netherlands and Swiss Patent Offices will all have substantially the same form.

4. Search principles for French applications (only the most important are mentioned).

a. The searches have to reveal the documents which might affect the novelty and the inventive step of the invention, disclosed in the application. Those documents form the state of the art. The state of the art comprises:

"all that has been made accessible to the public by a written description (or orally) before the day of filing of the patent application (or of the application filed in another country and of which the priority has been claimed)."

b. Interferences are not mentioned.

c. The search shall take into consideration all the documents published before the filing date in France.

d. The search may not be stopped when a pertinent document published between the filing date and the date(s) of claimed priority has been revealed
(ies)

e. If the text of the claims is not in accordance to the description the examination is carried out on the basis of the claims and in a letter adressed to the French Patent Office the points on which there is no accordance are set forth.

5. Search principles for Netherlands applications (only the most important are mentioned).

a. A commented documentation has to be furnished, concerning the state of the art on the basis of which the reader may form his opinion on the pretended exclusive rights concerning the application which may be considered valuable.

b. The search has to be carried out as exhaustively as reasonably possible.

c. If the examiner considers the probability of revealing an anticipation or another publication which might be important for the state of the art in certain time periods or in certain subdivisions of the classification or in certain periodicals not in proportion to the time required, he may omit this part of the search.

d. In principle, all material of the application must be included in the search, and not only the matter contained in the claims. A search on the formal novelty of the subject matter contained in the claims is not sufficient. The litterature concerning the so called technological background of the application also has to be indicated.

- e. In case of non-unity of invention the search may be limited.
- f. The search is carried out up to the application date.
- g. The search is directed on the principal subject matter of the application which as a rule will be the subject matter of claim 1.
- h. If the documents revealed are of such importance that the claim referring to the principal subject matter and any following claims which are inseparable from this claim, have no chance of being considered patentable even after a rewording, then the search is directed successively to the subject matter of the remaining claims, starting with the lowest numbered claim which in its original wording forms unity with claim one. The content of this claim is now considered as the new principal subject matter and if this has for similar reasons little chance of being patentable, the above-mentioned procedure is repeated.
- i. If there seem to be no objections (formal objections not taken into consideration) to the principal subject matter or the new principal subject matter or a part of it, no supplementary search will be carried out on the subject matter of the following claims which form unity of invention with the main claim which is considered acceptable or with the part of it considered acceptable. However literature found during the principal search which is considered pertinent for the claims other than those referring to the principal subject matter is also to be cited.
- j. The report must make it clear which claims if any have not been searched.
- k. The subdivisions of the classification system which have to be consulted are not prescribed. In principle, in the first instance the subdivision(s) in which the application has been classified will be taken into consideration.
- l. In principle, the search has to include the literature published over many years, especially when the application refers to a technology which has been developing for a long time.

6. The Hague Treaty of 1961

It seems useful to draw the attention to the protocol of the revised Hague Treaty which states in paragraph 1:

"Pour la recherche visée à l'article 3 de l'Accord les documents mentionnés dans l'annexe au présent Protocole constituent le minimum de la documentation à consulter. Sont pris en considération les documents contenus dans les subdivisions de la classification en usage à l'Institut auxquelles appartient par sa nature l'invention soumise à l'examen et les documents contenus dans les subdivisions apparentées."

It is clear that the above mentioned search principles for the French and Netherlands applications are in accordance with this paragraph.

However this stipulation based on the desire to have the I.I.B. furnish the best searches possible, leads to searches which comprise many subdivisions of the classification. As in this field the law of diminishing returns is very important (about 80 % of the important literature is discovered in 50 % of the time of the search), this question is at present being reconsidered. As adhering states have the right to ask for a more limited search, it is probable that limitations will be adopted.

7. The search reports in general.

- a. The search reports for the two above mentioned countries do not have the same form. The Council of the I.I.B. has, however, already taken decisions with a view to standardising the reports for the different countries, which will probably be in force in the autumn of 1972. The Standardised report corresponds essentially to the present French search report.
- b. The search reports are objective. They mention the documents and their content, but do not give any opinion as to whether the subject matter is novel or not, is obvious or not etc. The reports only indicate the material on which later a judgment may be based.
- c. Not all the documents revealed by a search are mentioned in the search report. The general rule is that a document is added to the report when it contains information not contained in a document already cited.
- d. The I.I.B. is of opinion that giving a short analysis of the interesting part(s) of a cited document is very important not only for the reader of the report but also for the I.I.B. examiner himself. Writing a short analysis obliges him to consider very carefully whether a document is really important.

8. The search report for the French applications

The search report does not mention whether a document is cited with respect to novelty or obviousness. No "background documents" are to be mentioned.

The search report mentions:

- a. Number of application in France.
- b. Date of the search
- c. Of each cited document:
 - 1. bibliographic data
 - 2. indication of pages and/or lines and/or figures considered important
 - 3. a short analysis of what is revealed by these pages and/or lines and/or figures
 - 4. the claims for which they are considered important.
- d. Documents published between priority date and filing date are mentioned separately.

The search report concerning a French application may moreover be accompanied by an annexe mentioning documents not having a direct influence on the patentability of the application, but for some reason being of interest for the applicant. The annexe gives only bibliographic data of these documents without any indication of pages, lines or figures and without any analysis. These annexed documents are documents revealed during the normal search. No supplementary search is performed.

9. The search report for the Netherlands applications

- a. The report must cite the documents and comment upon them
- b. The report must cite the literature from which the background which is nearest to the application can be derived.
- c. The report shall be as short as possible and cite no more documents than necessary.
- d. Interfering patents or applications are to be mentioned.
- e. The number of pages of a cited patent has to be indicated.
- f. If a cited publication emanates from the applicant, this fact must be mentioned.
- g. Documents published between priority date and filing date are mentioned separately.
- h. The search report must indicate which claims (if any) have not been examined.

10. Results of the searches.

In the following table the figures given are the averages per application. The columns C, EP and M refer to the divisions Chemistry, Electricity-Physics and Mechanical Engineering etc. F means search on a French application and NL means search on a Netherlands application.

	<u>C</u>	<u>EP</u>	<u>M</u>	total
Number of subdivisions consulted	4,4	5,6	6,5	5,5
Number of documents cited F	2,25	3,52	3,36	2,79
Number of documents cited NL	3,38	3,75	3,95	3,60
% NPL cited	6,5	15,4	1,3	7,8

11. Remarks concerning the table.

- a. The differences between the figures concerning French and Netherlands applications are considerable. A number of reasons may be cited e.g.:
 - 1. The search principles and the reports are not entirely the same.
 - 2. The fields covered by the two categories of applications are not yet identical.
 - 3. A higher proportion of the Netherlands applications are based on a conventional priority and therefore form more of a "selection".
- b. In the field of electricity and physics the number of cited documents is rather high and the proportion of NPL is very high.
- c. The numbers of documents mentioned in the table are the numbers of documents cited. The examiner in carrying out his search finds a number of documents which necessitate fuller study. Only some of these documents are cited in the report.
- d. The number of subdivisions consulted may vary considerably. In some studies referring to other samples, figures 4,96 and 5,30 were found. It was confirmed by these studies that the number of documents found per subdivision was considerably higher for the main subdivisions, i.e. the subdivisions in which the application was classified itself than for the other subdivisions consulted. The proportion as a rule was in the order of 2,5 : 1. Moreover, this proportion for the cited documents was as a rule in the order of 4 : 1. So the main subdivisions are far more profitable than the other subdivisions. It should not be forgotten, however, that the most important documents are sometimes found in the other subdivisions.

12. Personnel

Examiners belong to two categories. The first needs a completed course of study of technology or science at a university or equivalent, the second one a lower grade. Promotion from the second category to the first one is possible. The I.I.B. does not require that candidates have practical experience.

Immediately after taking up office they follow an introductory course of some days. The real training up till now lies in the hands of the group chiefs. Plans have been developed for a more concentrated training by courses.

As the I.I.B. is young compared to the national Patent Offices and since a big expansion took place only a few years ago, the examiners of the I.I.B. are on the average very young. This point is very important for their productivity.

13. Documentation used for the searches

A. Systematically classified patents and patent applications of the following countries:

Belgium	since 1926
France	" 1902
Germany (Fed.Rep)	" 1877
Great Britain	" 1909
Luxemburg	" 1946
Netherlands	" 1912
Switzerland	" 1940
United States	" 1920

Moreover collections of abstracts of some countries are used.

B. Non-patent literature.

More details are given about NPL literature in the reply to WIPO document PCT/TCO/SS/1/17.

C. Classification system

About one seventh of the documentation is arranged according to the International Classification, the other part according to the "Indeling der Techniek" (Classification of the Netherlands Patent Office).

∟End of document∟