

WIPO



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PCT/TCO/SS/III/17

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
UNITED INTERNATIONAL BUREAUX FOR THE PROTECTION OF INTELLECTUAL PROPERTY
GENEVA

PATENT COOPERATION TREATY

INTERIM COMMITTEE FOR TECHNICAL COOPERATION

STANDING SUBCOMMITTEE

Third Session, Geneva, October 2 to 9, 1972

ADDENDUM TO DOCUMENT PCT/TCO/SS/III/13

Prepared by the International Bureau

1. Document PCT/TCO/SS/III/13 contains the responses of the Patent Offices of Austria and the Netherlands and the International Patent Institute to Circular Letter No. 1449 which requested information on experiences gained from examiner-exchange programs.

2. Additional responses have since been received from the Patent Offices of the United Kingdom, the United States of America, Sweden, Germany (Federal Republic) and Japan and are annexed to this document (See Annexes A, B, C, D and E respectively).

Summary of the Responses

3. Of the eight responses to Circular Letter No. 1449 received by the International Bureau, six of the prospective PCT authorities (DT, GB, JA, NL, SW, US) were able to relate information on their experiences with personnel exchanges while two (OE, IB) indicated they had no such information to furnish.

4. Advantages of Examiner Exchanges - Examiner exchanges were felt to be, helpful in understanding practices of other offices (GB, JA, NL), instructive or of personal benefit for the examiners involved (DT, US), of great value and much to be learned through such visits (SW), capable of up-grading professional climate and increasing professional awareness and dedication of participants (US), useful in that examiners recommend the best procedures of those they had seen for their national procedures (GB, JA) which, in turn, leads to more uniform procedures among offices qua prospective PCT Examining Authorities (GB).

5. Disadvantages of Examiner Exchanges - Examiner exchanges were felt to be time consuming for the host and the visitor (NL) and tend to present problems where the language of the host's applications, correspondences and instruction materials is not familiar to visitors (NL).

6. Suggestions Offered - While all of the responses acknowledged the usefulness of examiner-exchanges at least in meeting the immediate objectives of the exchanges disclosed, only three of the responses (DT, GB, US) offered any comments or suggestions on the use of examiner-exchanges to meet the objectives of establishing uniform procedures in the different prospective PCT Authorities. Examiner exchanges were felt to be of benefit to prospective PCT Examining Authorities in that exchanges lead to implementation of more

uniform procedures by the participating offices (GB). A suggestion (DT) was made that exchanges of examiners between offices were not, of themselves, suitable for establishing uniform procedures particularly in the searching area and that examiners should;

- A. be first exposed to isolated search techniques through informational visits to the Hague and Berlin where isolated searches are carried out;
- B. carry out test searches at their home offices;
- C. have these test searches evaluated;
- D. have examiner exchanges with the results of the evaluations serving as the basis for discussion.

A third response (US) suggested that precedence should be given to completing the guidelines for minimum documentation before engaging in any inter-office exchange of examiners.

- 7. The Standing Subcommittee is invited to study this document and Annexes along with document PCT/TCO/SS/III/13 and its Annexes.

Annexes A, B, C, D and E follow

GM



THE PATENT OFFICE
25 Southampton Buildings, LONDON W.C.2 & 1AY
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Our reference: IFCD 40329
Your reference: PCT 081.5

Mr. Klaus Pfanner
Senior Counsellor
Head of the Industrial Property Division
WIFO
32 chemin des Colombettes
1211 GENEVE 20
Switzerland

Dear Mr. Pfanner

In response to WIFO Circular No. 1449 I have pleasure in enclosing the observations of the United Kingdom Patent Office on examiner-exchange visits.

Yours sincerely

A handwritten signature in cursive script, appearing to read 'D G Gay'.

D G Gay
Superintending Examiner.

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Annex A

Observations of the United Kingdom Patent Office on Examiner-exchange Visits.

There can be scarcely a major Patent Office in the world which has not been visited by a member of our Examining Staff, but it is assumed that WIPO Circular No. 1449 is seeking information about the benefits of examiner-exchange visits. The Circular requests reports and analyses but it is not proposed to transmit these as the United Kingdom Office regards them as confidential in some respects.

We have, however, the following comments.

Our experience comprises:-

- (A) between the US and UK Patent Offices one examiner from each country for a two month visit in 1967-68;
- (B) between the German (Federal Republic) and UK Patent Offices eight examiners from each country for a four week visit in 1971 and a further eight examiners from each country for a similar visit in 1972.

The exchanges (B) were made in the light of the projected European Patent Office, but exchange (A) has no such immediate objective. Nevertheless, the UK examiner concerned in exchange (A) gained considerable insight into the criteria governing the application of "obviousness" in the host office.

In both cases there were considerable differences in national patent law. Exchanges (B) had additionally to transcend a real language barrier, and for these exchanges language training for the UK examiners was considered to be essential. Each examiner from the U.K. Office attended a six week full-time German language training course. In every case some additional voluntary training had also been undertaken. The result was that our examiners were able to work in German at the German Patent Office, and their individual fluency increased during the stay. It was also noticeable that there was improvement in the English fluency of our German visitors.

The differences in patent law could of course be understood by mere study of existing literature without the complications and expense of exchange programmes. In any case preparatory to the exchanges, the visitors must make such studies, and it is therefore worthwhile questioning the value of the programmes. However with such sophisticated work as patent examination, differences in law, whilst being fundamental, are by no means the whole picture in understanding the ethos of each nation's patent examination. It has thus been an essential intower of each exchange (B) that each visitor spends a high proportion of his time sitting in with the examiner in the host country who deals with a similar technical field to his own. Naturally, differences in the classification systems and the organizations of two offices rarely admit precise identity of technical fields, but provided the host office is briefed on the visitor he can be attached to an examiner having a technical field with which the visitor is really familiar.

In view of the confidential nature of some documents the visitor is likely to see, it has been deemed necessary that he give an undertaking on non-disclosure to his own government prior to the visit. In this way, the host office feels safeguarded against any unfortunate incident infringing inventors' rights.

Thus by adequate language tuition, legal briefing, a written undertaking on confidentiality and a suitable technical matching, the visiting examiner is well prepared to absorb the approach to and nature of the work of his "opposite number".

In order to complete the picture of the German and UK offices our exchange

programmes have included visits to non-technical sections dealing with the processing of patent applications, to the central section specialising in patent classification and searching techniques, and to internal court proceedings. The visits have also included parts of the patent system which may be peculiar to the host country. Thus, in London the visitors attended a sitting of the Patents Appeal Tribunal, and our examiners toured the branch of the German Patent Office in Berlin.

In the light of the projected European Patent Office a considerable expenditure of thought, effort and expense has been put into these exchanges to make them successful. For our part, we feel that the expenditure is fully justified. It has served to increase the understanding and experience of a presently small, but we trust growing, number of potential employees of this multinational organisation who are not only skilled in patent examination but who by dint of their visit have appreciated that in many respects their own national methods are not the only, or even the best, ones. Thus they should have become better potential employees of the European Patent Office, and hence these exchanges are making a sizeable contribution to the successful launching of that body.

At the same time examiner-exchange visits of this nature serve to focus the visitors' attention upon those aspects in which the procedures in the host office differ from their own and lead them to recommend, upon their return, the adoption in their own national procedures of the best of what they have seen and learned. In this way such exchanges can lead to a more uniform procedure in the different patent offices and, moreover, to one which includes the best features of the various national procedures, which would be of benefit to PCT Examining Authorities.

Mr. K. Pfanner
Senior Counsellor
Head of The Industrial Property Division
WIPO
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1211 Genève 20
Schweiz

Dear Mr. Pfanner,

Referring to your circular No. 1449 (PCT 081.5) of May 24, 1972 I have the honour to give you the following information.

On the initiative of Commissioner Brenner in the US Patent Office an agreement was made in 1966 between the US Patent Office and the Swedish Patent Office on a joint study of examination procedures which involved a comparison of the search and examination results on corresponding applications filed in both countries. The purpose was to examine the possibility of exchange of current search results and later examination results on active applications. In connection herewith it was proposed that an examiner - exchange program within the framework of US Foreign Professional Training Program should be carried out by the both Patent Offices. According to the program the visiting examiner should concentrate his attention on the patent law and examining procedures in the visited office. He should also participate in the actual search and examination of a number of applications.

The US Patent Office selected Mr. Alex Mazel, Supervisory Primary Examiner, to visit the Swedish Patent Office during March and April 1968.

During his stay in the Swedish Patent Office Mr. Mazel became very familiar with the organization of the Office, with the new Nordic Patent Law just enacted and with the examining procedures in our office. The report which he made when he had returned and which was available for all examiners through publication in the Patent Office Employee Bulletin, October 1968, gives evidence of that. During his visit we had many fruitful discussions about mutual problems. We also had the opportunity to compare the procedure of

dealing with patent applications at our Offices. Mr. Mazel also held very informative lectures for the director general and other officers at the Swedish Patent Office about the organization of the US Patent Office and about the US Patent Classification System. His visit had as a consequence that the exchange of search results on a continuous basis could be started on active applications without further study.

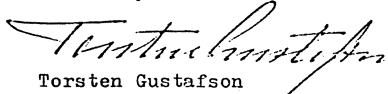
The Swedish Patent Office selected Mr. Folke Erikson, Primary Examiner, to visit the US Patent Office, which visit took place in October-November 1969. He began his training by attending the two weeks Patent Examiner Initial Training program. This course was followed by training in the examining corps during which time he received instructions in all aspects of the examining and prosecution procedures of the US Patent Office. The training also included orientation in US classification system. Mr. Erikson got further a good insight into the organization of the US Patent Office. After his return Mr. Erikson gave the director general and the heads of the staff in the Swedish Patent Office a detailed survey of the organization of US Patent Office and the work in it. He has also published a report in the Swedish Patent Office employee bulletin "Patentverksnytt".

According to our opinion this examiner exchange program has been of extremely great value to the Swedish Patent Office.

Since more than 20 years a close collaboration has exist between the Nordic Patent Offices. We have had annual meetings with professionals from the four patent offices and then discussed common problem in direct connection with the examining procedures. These meetings have alternated between the different offices in order to make it possible for the examiners to study the offices and to be acquainted with other examiners. Without this collaboration it would have been impossible in practice to maintain the uniformity of patent law and procedure presupposed by the enactment in 1968 of the same patent law and the same decrees on patent application in the four countries.

The Swedish Patent Office also wants to emphasize that it has always taken the opportunity for members of its staff to visit and study other patent offices whenever the occasion arises and that in its opinion much is to be learnt from such visits.

Sincerely Yours


Torsten Gustafson

Dr. Klaus Pfanner

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JUL 27 1972

Dr. Klaus Pfanner
Senior Counsellor
Head of the Industrial Property
Division
World Intellectual Property
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32, chemin des Colombettes
1211 Geneva 20, Switzerland

Re: Circular No. 1449

Dear Dr. Pfanner:

Your circular of May 24, 1972, solicited information and commentary relating to the experience of the U. S. Patent Office which were gained from bilateral examiner exchange programs.

Over the last few years, officials of the U. S. Patent Office, not necessarily patent examiners, have been sent to visit foreign patent offices to discuss or investigate specific areas of interest. Similarly, the U. S. Patent Office has been host to industrial property officials who came for consultations or who wished to learn details of particular phases of our operations, such as examination, documentation and computer techniques. Additionally, as you know, we have been receiving officials for orientation here under WIPO's (BIRPI's) program of technical assistance to developing countries.

During 1967 and 1968, the U. S. Patent Office conducted a bilateral exchange program strictly limited to patent examiners which appears to fall squarely within the terms of the inquiry of the circular. This program sought to acquaint patent examiners with the practices of examination and working methods of their international counterparts by in situ observation and study. Motivating this undertaking was the belief that participation in the actual day-to-day

practice of foreign offices would provide insights into the varying philosophies of patentability and an in-depth familiarity with the patent laws and practices of the host countries. It was also anticipated that the increased opportunity for communications and interchange of ideas on the working level would create better understanding among patent offices.

This program was implemented in the U. S. Patent Office by the selection and dispatch of six examiners to the patent offices of Canada, Japan, the Netherlands and the International Patent Institute of the Hague, Sweden, the Federal Republic of Germany, and the United Kingdom. Reciprocal visits to the U. S. Patent Office were made by foreign patent officials. The unstructured assignment of the U. S. Patent Examiners was to investigate all aspects of the operations of the host offices, and to prepare a written report on their experiences and findings prior to resuming their regular duties of patent examining. In many cases, insight into the philosophy of the foreign system was gained by the comparative study of the prosecution of patent applications which were counterparts to those U. S. applications with which the examiners were familiar. These reports are very thorough and cover most phases of the internal procedures, search file organizations, and examiner approach in making the decisions he is called to make under the law of his country.

There were, of course, personal benefits to the participants from this educational experience. The immediate benefits to the office were of an intangible nature which included upgrading the professional climate within the examining corps and an increased professional awareness and dedication of the participants.

It had been an expectation that as a long range benefit to the U. S. Patent Office from this program would be the establishment of a group of employees who could speak with recognized authority on the patent practices, procedures, and operations of specific countries. However, we have found that this desideratum has not been fully achieved, due in large measure to the fact that the return to the daily examining responsibilities precluded the individuals from maintaining and developing their understanding of the patent system which they had studied.

In light of our particular objectives, our past exchange was fruitful. For the direct participants, it was an educational experience, and for the Patent Office it was a source of valuable information and materials now on hand. This evaluation, however, is not directly relevant to the exchange of examiners considered by the Standing Subcommittee of the PCT Interim Committee for Technical Cooperation (document PCT/TCO/SS/I/77, paragraphs 54 and 55, referenced in Circular No. 1449). In scope and intent, these proposed exchanges of examiners would be different in kind from our previous and much more modest undertaking. As we understand, the proposed program contemplates a large scale exchange of examiners between prospective International Searching Authorities under the PCT for a mutual consideration of problems to foster, ultimately, substantive harmonization. For this reason, it should be appreciated that our earlier experience is not directly relevant to a consideration of the possible merits of this new type of exchange. We agree that the Standing Subcommittee (as stated in paragraph 54 of the above document) should give priority to completing guidelines for minimum documentation, a task logically taking precedence over any such inter-office exchange of examiners.

Sincerely,



Robert Gottschalk
Commissioner of Patents

DER PRÄSIDENT
DES DEUTSCHEN PATENTAMTS

8000 MÜNCHEN 2, den August 4, 1972
Zweibrückenstraße 12
Fernruf 21 951, Fernschreiber 05-23534
Fernrufdurchwahl über 2195 Hausruf 3971
Zentr.-Abt. 9330/10 H5 Bd II 1/72

Bitte in der Antwort das vorstehende Geschäftszeichen angeben

- 2 -

Prof. Dr. G.H.C. Bodenhausen
Director General

World Intellectual Property
Organization (WIPO)

32, chemin des Colombettes

CH - 1211 G e n e v e

Schweiz

Re: Examiner-exchange programs - WIPO Circular No 1449
of May 24, 1972

Dear Professor Bodenhausen,

The experiences available at the German Patent Office have been gained from an exchange of examiners between the German and the UK Patent Offices. Both in 1971 and 1972, a group of 8 examiners of the German Patent Office has been at the British Patent Office, and a group of 8 examiners of the British Patent Office at the German Patent Office for a period of four weeks.

The programs were set up so as to be focussed on supplying information mainly on the patent granting procedure of the host country. During the entire period of the visit, each visiting examiner was therefore assigned to an individual corresponding examiner working in the same technical field at the Office visited.

The information was supplied on the basis of existing patent applications which were processed by both the British and the German examiner, the results thereof being subsequently discussed between the two examiners.

The organization of the Office and, in particular, the administrative processing of patent and utility model applications, and the operations performed in the documentation and classification divisions and the library were demonstrated, discussed and commented on in joint sessions held for all the members of the group.

For the period of the visit, the host office had appointed a contact officer, who was at any time at the disposal of the head of the visiting group for discussions required, and who was in charge of supervising the regular course of the program.

The experiences gained from this exchange program are the following:

It proved to be of particular value that an individual corresponding examiner was appointed for the entire period of the visit, one and the same examiner being, thus, at the disposal of the visiting examiner as an interlocutor. This appeared to be an advantage also as far as the processing of the applications was concerned, as the conditions for technical discussions on the subject were identical.

From the second exchange visit it resulted moreover to be advantageous that the corresponding examiner was assisted, during the first few days, by an examiner who had familiarised himself with the visitor's Office during

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a previous visit. Adaptation of the visiting examiners were, thus, advanced to a considerable extent.

As to the processing of the applications, the approach proved to be essentially the same, as both British and German examiners proceed from a linguistic-logical interpretation of the verbal disclosure of technological facts. When processing one and the same application, the German and the British examiners independently criticized the same points. Interpretation of the substance disclosed by prior publications led to the same factual findings. Accepted definitions for determining the conceptual scope of a given technological term are used as an additional argument by both the British and the German examiners.

To summarize it may be stated that the test has shown the possibility of an effective co-operation between German and British examiners. The informational visits have doubtlessly been most instructive for the exchange examiners. A problem yet unsolved is whether, and to what extent, the results achieved should be made available also to those examiners who did not participate in the program. It is a problem of organization, and in my Office we are still working at its solution.

In the course of the exchange program it proved to be useful that the mutual information was mainly supplied by working on applications and by illustration with examples taken from the practice. It appeared to be appropriate to reduce to a necessary minimum lectures and comments on general problems. Direct exchange of views and joint practical work have considerably promoted mutual understanding. Owing to the individual training, it was possible to supply a maximum of information to the examiners.

In spite of the positive result of the exchange of examiners between the British and the German Patent Offices, I do not deem that an exchange of this kind would be suitable as an exchange program in connection with preparing the entry into force of PCT. Within the framework of PCT, considerations must be based on the fact (as may be seen from document PCT/TCO/SS/I/17 § 56 and 57) that experiences in performing "isolated searches" similar to the expected PCT searches have only been gathered at the Berlin Branch Office of the German Patent Office and at the International Patent Institute at The Hague. I therefore believe that the training of examiners within said framework should be organized in a different way. At the outset, informational visits of examiners of the other prospective International Searching Authorities to Berlin or The Hague might be envisaged, in the course of which they could be informed on the practice and experiences relating to the performance of searches and the setting up of search reports.

Subsequent to such informational visits, the examiners might possibly carry out test searches at their home Office. Upon evaluation of said test searches it would be possible to initiate the actual exchange of examiners, and the results of the evaluation might then serve as a basis for discussion among the exchange examiners. With a similar organization of the examiner-exchange program it would be conceivable that each Searching Authority alternately invites groups of examiners consisting each of one or two members of the participating authorities. Said groups of examiners could co-operate with all examiners working in the same technical field at the inviting authority.

Statistical data concerning the exchange program
carried out are not available.

Sincerely yours,


Haertel

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JAPANESE GOVERNMENT

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Mr. K. Pfanner
Senior Counsellor
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Dear Sir:

In reply to Circular No. 1449 dated May 24, 1972, I wish to inform you that we have had the following experience in the exchange of examiners.

The country of exchange: United States

Period: In June and July, 1967, one Japanese patent examiner worked in US Patent Office. And in October and November, 1967, one US patent examiner worked in the Japanese Patent Office.

Content of training: In both Patent Offices, by means of lectures at the Training Course, study on the basic legislation and examining procedures was made, and actual examination of about 10 applications was conducted.

After the return of our examiner from the United States, we studied on the following problems on the basis of his report:

1. Maintenance of jackets containing application papers
2. Organization of examining corps
3. Quality control of examination work
4. Improving efficiency in examination practice

Re-examination of our system and of actual administration of the system was made by referring to actual examples in US Patent Office, and in consequence, some plans for renovation were made and actually implemented.

Yours truly,

Yukio Miyake
President

Y. Miyake

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