

WIPO



PCT/TCO/SS/III/7
ENGLISH ONLY
DATE: June 30, 1972

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 5, 1972

PROGRESS REPORT ON MINIMUM DOCUMENTATION:
FIRST LIST OF NON-PATENT LITERATURE

prepared by the International Bureau

1. At the first session of the Standing Subcommittee of the PCT Interim Committee for Technical Cooperation (hereinafter referred to as "the Standing Subcommittee"), the International Bureau having as a long-range objective the establishment of the list of items of non-patent literature to be included in the PCT minimum documentation under Rule 34.1(b)(iii), reported on a survey of periodicals of non-patent literature used in several national Offices, and submitted an attempted "first list" of periodicals (see document PCT/TCO/SS/I/3, paragraph 5, and Annex to it).
2. During consideration of the document the Standing Subcommittee discussed the questions of what the term "systematically used" should mean in regard to the use of non-patent literature and what the criteria for selection of periodicals should be. In view of the differences of opinion about these subjects, the International Bureau was charged with the task of drafting a questionnaire on the basis of information it would gather from the prospective PCT Authorities on the principal methods by which such Authorities select non-patent literature for examiners and channel it to them, and by which such literature is kept for recall when needed. The draft questionnaire, before being addressed to the members of the Standing Subcommittee, was to be either cleared by the members or submitted for approval to the Standing Subcommittee.
3. With a letter dated March 20, 1972, the Patent Office of Germany (Federal Republic) made a proposal for a new procedure for the selection of non-patent literature for the purposes of the establishment of the draft "first list" under Rule 34.1(b)(iii). The International Bureau distributed that proposal under cover of Circular No. 1421 on April 11, 1972 (see Annex I).
4. The majority of the Offices which are members of the Standing Subcommittee have reacted positively to the proposal of the Patent Office of Germany (Federal Republic). This fact as well as an invitation to comply with the approved new procedure was communicated to all members of the Standing Subcommittee in Circular No. 1452 dated June 1, 1972.
5. The answers which will be received from the prospective PCT Authorities under the new procedure will be reported on in a supplement to this progress report.
6. The Standing Subcommittee is invited to note and, if it so desires, to comment upon the actions taken.

/Annexes I and II follow/

ORGANISATION MONDIALE DE LA
PROPRIÉTÉ INTELLECTUELLE

Bureaux Internationaux réunis
pour la protection de la
propriété intellectuelle (BIRPI)



WORLD INTELLECTUAL
PROPERTY ORGANIZATION

United International Bureaux
for the Protection of Intellectual
Property (BIRPI)

Circular No. 1421

PCT 21

April 11, 1972

Dear Sir,

I have the honor to communicate to you the proposal of the Patent Office of Germany (Federal Republic) concerning the procedure for establishing the first list of non-patent literature provided for in Rule 34.1(b)(iii) of the PCT Regulations ("Minimum Documentation").

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A copy of the letter containing the proposal is enclosed herewith.

The International Bureau for its part would see no objection to the substitution of the inquiry referred to in the proposal for the somewhat complex procedure envisaged earlier by the Subcommittee (see paragraph 23 of document PCT/TCO/SS/I/17), especially since the proposed substitution seems to promise to achieve the ultimate aim, which is the draft list, and not merely provide an intermediate step in the form of a questionnaire.

I should appreciate it if you would let me know, preferably within a month, if you do not agree to the above proposal.

Sincerely yours,

G.H.C. Bodenhausen
Director General

DER PRÄSIDENT
DES DEUTSCHEN PATENTAMTS

8000 MÜNCHEN 2, den March 20, 1972

Zweibrückenstraße 12
Fernruf 21 951, Fernschreiber 05-235 34
Fernrufdurchwahl über 2195 Hausruf 3972
Zentr.-Abt. 9330/10 H5
Bd I 39/72
Bitte in der Antwort das vorstehende Geschäftszeichen angeben

Mr. G.H.C. Bodenhausen
Director General
World Intellectual
Property Organization
32, Chemin des Colombettes
CH- Genève
Schweiz

Ref.: Document PCT/TCO/SS/I/17 - paragraph 24.

Dear Mr. Bodenhausen,

With reference to document PCT/TCO/SS/I/17 paragraph 24 - questionnaire concerning the selection of non-patent literature for minimum documentation - I would like to inform you that I have again examined document PCT/TCO/SS/I/15 at length.

Thereby I have come to the conclusion that the further procedure could be much more advanced if on the basis of the document PCT/TCO/SS/I/15 annexes 1 and 2 the questionnaire could be dropped. Instead of this questionnaire I propose an inquiry made among the members of the Standing Subcommittee of the Interim Committee on Technical Cooperation, containing the following three questions :

1. Which serial numbers of primary publications, according to document PCT/TCO/SS/I/3 Annex, are to be included in the minimum documentation ?

2. Which serial numbers of secondary publications, according to document PCT/TCO/SS/I/3 Annex, are to be included in the minimum documentation ?
3. Which of the additional titles of periodicals not mentioned in document PCT/TCO/SS/I/3 are to be included in the minimum documentation ?

As a basis for the answering of the questions I consider the term "systematically used" as explained in my letter of November 11, 1971 (document PCT/TCO/SS/I/12 pages 3 and 4).

Sincerely yours


Haertel

[Annex II follows]



Circular No. 1452

PCT 21

June 1, 1972

Dear Sir,

I have the honor to inform you that the majority of the Offices which are members of the Standing Subcommittee of the PCT Interim Committee for Technical Cooperation have reacted positively to the proposal of the Patent Office of Germany (Federal Republic), communicated to you with Circular No. 1421/PCT 21 of April 11, 1972. Copies of the replies received are enclosed herewith as an Annex.

Consequently, I would appreciate it if you could undertake the necessary steps so that the answers of your Office to the following two questions would reach us, preferably by August 1, 1972:

1. Which primary publications and which secondary publications, identified in document PCT/TCO/SS/I/3 Annex, should be considered for inclusion in the minimum documentation?
2. Which periodicals, if any, not indicated in document PCT/TCO/SS/I/3 Annex should be considered for inclusion in the minimum documentation?

For your convenience, a copy of document PCT/TCO/SS/I/3 Annex is enclosed herewith, so that you may use it for answering question No. 1 by simply referring to the serial numbers indicated in the said document.

Sincerely yours,



Pfanner
Senior Counsellor
Head of the
Industrial Property Division



INSTITUT INTERNATIONAL DES BREVETS

BOÎTE POSTALE 5021 - LA HAYE (PAYS-BAS)

Annex to Circular 1452 PCT 21

TELEPHONES:
SIEGE: (070)
SERVICE TECHNIQUE: (070) 24 54 77
ADRESSE TELEGRAPHIQUE:
BREV/PATENT
TELEX No. 31.651

Mr. G.H.C. BODENHAUSEN, Director General
B.I.R.P.I.
32, chemin des Colombettes
1211 GENEVE
L20 Suisse

LA HAYE, le May 24, 1972.
97, Nieuwe Parklaan

Your circular: 1421/PCT21

Our ref.: VW/28/mjs

Dear Mr. Bodenhausen,

With your circular 1421 - PCT 21 of April 11, 1972 you sent us copy of a letter by Mr. Haertel dated March 20, 1972 and asked us for a reply if we did not agree to Mr. Haertel's proposal.

In principle we agree to this proposal, as we consider it a much better solution than those contained in the two annexes to document P.C.T./TCO/SS/I/15. Therefore a reply would not be necessary.

The reason that we nevertheless come back to this question is that we would like to propose two small amendments viz.:

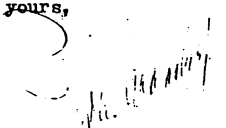
- concerning points 1 and 2:

It would be useful to invite the offices to indicate which publications they do not know or have insufficient experience with.

- concerning point 3:

distinguish in the same way as in points 1 and 2 between primary and secondary publications.

Sincerely yours,


P. van Waasbergen
Technical Director

Octroiraad

Willem Witsenplein 6 Telefoon (070) - 264001
's-Gravenhage Postrekening 17300

uw brief van uw nummer ons nummer bijlagen
11-4-1972 1421 PCT 21 S 72/199

datum May 18, 1972

onderwerp Minimum documentation NPL

Mr. G.H.C. Bodenhausen,
Director-General of the World Intellectual
Property Organization,
32, chemin des Colombettes,
1211 Geneva.20.

Dear Director-General,

In response to your circular 1421 of April 11, 1972 I can inform you that I am not in favour of the simplified procedure proposed by the German Patent Office for establishing a list of periodicals to be included in the minimum documentation for the PCT search authorities for the following reasons.

The German proposal fully relies upon the acceptability of the definition of "systematically used" as contained in the letter from the German Patent Office of November 11, 1971 (document PCT/TCO/SS/I/12 pages 3 and 4) i.e. "periodicals from which, according to the practice of the examining offices, essays and commentaries are copied regularly in order to be included into the search file of the examiner, as well as secondary publications which are automatically added to the search file".

In my recollection it was especially the strong connection in this definition with the examiners search file, implying a method of search and recall of NPL that is practically identical to the method of search and recall used for patent literature, which made the subcommittee in its December 1971 session wonder whether this definition is satisfactory. In fact several alternative methods of search and retrieval were mentioned which at least in the opinion of certain members should also come under the qualification "systematically used". For this reason the Standing Subcommittee decided that it would be desirable first to establish which various methods of search and retrieval are used in the prospective search authorities, after which it could be decided which of these methods could be qualified as "systematic use" so that a definition of that term could be established.

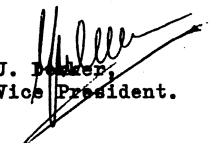
Once that has been done, the simple procedure suggested by the German office is to be preferred over the elaborate questionnaire of Annex 1 of PCT/TCO/SS/I/15.

It appears to me therefore that an intermediate investigation as indicated in the first eight lines, paragraph 23 of PCT/TCO/SS/I/17

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is indispensable; to a certain extent this investigation could make use of some of the questions contain^{ed} in the German proposal of Annex 2 of PCT/TCO/SS/I/15, especially questions 1, 2, 3, 5 of that annex.

Yours sincerely,


J. Dörken,
Vice President.

Mr. G H C Bodenhausen
Director General
WIPO
32, Chemin des Colombettes
Genève
Schweiz

Dear Mr. Bodenhausen,

With reference to your letter C. 1421 of April 11, 1972, concerning the procedure for establishing the list of non-patent literature provided for in Rule 34 of the PCT Regulations ("Minimum Documentation"), we have the honor to inform you that the Swedish Patent Office approves the inquiry referred to in the proposal of the Patent Office of the Federal Republic of Germany.

In this context we want to emphasize that some caution should be exercised when establishing the list of non-patent literature, in order to avoid a too comprehensive list. According to our experience, patent documents constitute an outstanding material for searching, having a lay-out especially suited for that purpose. Apart from this material certain non-patent literature is of great value when carrying out the novelty search, in particular standard works like Chemical Abstracts, Gmelin and Beilstein in the chemical field, but also some other publications.


However, it is a known fact that, apart from the kind of publications just mentioned, there exists in the search files of the Prospecting Searching Authorities non-patent literature which in the course of years have been included in the files

for its possible value as search material, and for this reason is "systematically used" together with the patent documents, but in reality enriches this documentation to a very limited degree if at all. Such publications should not be included in the minimum documentation.

It is our sincere expectation that, when considering what publications should be included in the minimum documentation, the Prospective Authorities should carefully examine the value of each publication with regard to its true status as carrier of such information that can not be found in the patent documentation.

We would therefore appreciate if WIPO, along with the inquiry, would express a recommendation to that effect which would serve the purpose of limiting the minimum documentation to what is adequately needed and practicable to handle in the search.

Sincerely yours


Göran Borggård
Director General

GW



Our reference: IPCD 40329
Your reference: PCT 21

PCT/TCO/SS/III/7
Annex II
page 7
THE PATENT OFFICE
25 Southampton Buildings, LONDON W.C.2A 1AY
Telegrams: Patoff London W.C.2
Telephone: 01-405 8721, ext. 215

3 May 1972

Professor G. H. C. Bodenhausen
Director General
WIPO
32 chemin des Colombettes
1211 GENEVE 20
Switzerland

Dear Director General

I have pleasure in informing you that the United Kingdom agrees to the proposal of the Patent Office of Germany (Federal Republic) which was communicated by you under cover of WIPO Circular No. 1421.

Yours sincerely



D. G. Gay
Superintending Examiner

Wien, May 4, 1972

GR 455/72

Mr.

G.H.C. Bodenhausen
Director General
World Intellectual
Property Organisation
G e n è v a

Ref. Circular Nr. 1421 PCT 21

Dear Sir,

I have the honor to inform you that the Austrian
Ministry of Commerce and Industry, Industrial Property
Section, has no objections to the proposal of the German
Patent Office to substitute the inquiry elaborated by the
Subcommittee by the three questions contained in the letter
of the German Patent Office annexed to Circular Nr. 1421
PCT 21.

Sincerely Yours,



(Schebesta)

⊕
22376 ompi ch
7248 kompodi su

dear mr bodenhausen referring to your circular 1421 ,pct 21,
i have the honor to inform you that the committee for inventions
and discoveries at the council of ministers of the ussr has no
objections agains new questitnnaire proposed by the patent office
of germany (federal republic) because by means of a simplified
procedure it would help to establish the first list of non-
patent literature sincerely artemiev 16..72 mos

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22376 ompi ch
7248 kompodi su



**U.S. DEPARTMENT OF COMMERCE
Patent Office**

Address Only: COMMISSIONER OF PATENTS
Washington, D.C. 20231

April 28, 1972

Professor G. H. C. Bodenhausen
Director General
World Intellectual Property Organization
32 Chemin des Colombettes
Geneva, Switzerland

Dear Professor Bodenhausen:

With regard to Circular No. 1421, it appears to us that the proposal of Dr. Haertel will achieve the objective of the TCO/SS in a simpler and probably more expeditious manner than the procedure agreed upon during the first session of TCO/SS.

We therefore, have no objection to the International Bureau following this substitute procedure.

Sincerely,

Richard A. Wahl
Richard A. Wahl
Acting Commissioner

/End of document/