

157
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DATE: April 13, 1973

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

PATENT COOPERATION TREATY

INTERIM COMMITTEE FOR TECHNICAL COOPERATION

STANDING SUBCOMMITTEE

(Fourth Session, Geneva, April 25 to 30, 1973)

PROGRESS REPORT ON THE INCLUSION IN THE
PCT MINIMUM DOCUMENTATION OF PATENT DOCUMENTS
FROM COUNTRIES OTHER THAN THOSE SPECIFICALLY
NAMED IN PCT RULE 34

Report by the International Bureau

1. The PCT Interim Committee for Technical Cooperation during its first session in Geneva in February 1971, recommended in its program that the International Bureau of the World Intellectual Property Organization take steps to prepare, in cooperation with the national Offices of interested countries, an inventory of those English, French and German language patent documents, which under PCT Rule 34.1(c)(vi), may be expected to be placed at the disposal of each International Searching Authority.
2. It is recalled that Rule 34.1(c)(vi) provides for the inclusion in the "minimum documentation" of the International Searching Authorities of "such patents issued by, and such patent applications published in, any other country /i.e. other than the countries specifically named in Rule 34.1(c)(i) to (v)/ after 1920 as are in the English, French or German language and in which no priority is claimed, provided that the national Office of the interested country sorts out these documents and places them at the disposal of each International Searching Authority".
3. Accordingly, circular letter C.1220 was addressed to the national Offices of Australia (AU), Austria (OE), Belgium (BE), Canada (CA), Sri Lanka (Ceylon) (CL), India (IN), Ireland (EI), Israel (IL), Luxembourg (LU), Monaco (MC), New Zealand (NZ), Pakistan (PK), Philippines (RP), South Africa (ZA) and to the African and Malagasy Industrial Property Office (OAMPI) (AM) asking each of these Offices whether it was prepared to sort out such patent documents and, if so, from what date, with a view to subsequently placing them at the disposal of each of the International Searching Authorities.
4. Nine responses to Circular letter C.1220 were received (Circular letter C. 1220 and the responses are reproduced in documents PCT/TCO/SS/I/2, Annex J and PCT/TCO/SS/I/9). Six Offices (AU, OE, CA, EI, RP, AM) indicated that they would be willing to sort out their respective documentation. The dates from which the documents would be sorted and the criteria for sorting varied from office to office. (See Annex I table for particulars of answers of any given Office.) Two Offices (LU, NZ) indicated that they do not print patent documents and one Office (PK) indicated that it was unable to sort its patent documents.
5. The Standing Subcommittee of the PCT Interim Committee for Technical Cooperation (hereinafter referred to as "the Standing Subcommittee") in the Report of its third session (see paragraphs 17(iv) and 75 of document PCT/TCO/SS/III/23)

asked the International Bureau to continue its work with respect to the patent documents referred to in Rule 34.1(c)(vi). Accordingly the International Bureau in order to complete the survey solicited responses from the Offices that did not previously reply. Letters were sent to the six Offices (BE, IN, IL, MC, ZA, AM) which had not responded to the Circular letter as well as to the national Office of the German Democratic Republic (DL) in which each was asked to estimate the number of their non-priority claiming patent documents as well as to state, without any commitment, whether their office would want their patent documents included in the PCT minimum documentation and would be willing to sort out and furnish such documents. One Office (OE) which had previously indicated a willingness to sort and furnish its non-priority patent documents was asked to estimate the number of non-priority claiming documents to be found among its patent documents.

6. Five Offices (OE, BE, MC, ZA, AM) responded (see Annex II to this document for these responses). One Office (BE) indicated that it was unable to sort and make copies, one Office (ME) indicated that it would make copies as it would involve no more than several dozen per year, two Offices (OE, AM) indicated the number of the documents involved and one Office (ZA) indicated the number of documents involved and further offered to effect a sorting and compilation of a list.

7. The International Bureau has prepared a table summarizing all responses received to date (see Annex I to this document). Of the Offices responding positively to the letters and offering to sort and furnish their documents, it must be noted that some Offices speak of furnishing non-priority claiming patent documents while others speak of furnishing non-duplicative patent documents. By non-duplicative patent documents these Offices mean a patent document not claiming the earlier priority of another patent document and not serving as the basis of a priority claim in another published patent document. Several of the countries speak of non-duplicative patent documents but do not universally extend their search for duplicates e.g. Ireland looks only to United Kingdom patents and Philippines looks only to United States of America patents for duplicates.

8. It is noted in the Table of Annex I that of the sixteen Offices issuing patent documents in English, French or German language and not presently part of the PCT minimum documentation, nine print the complete specification, three (IL, RP, ZA) print only an abridgment of the invention or one or more claims and four (LU, MC, NZ, CL) do not print any more than the title, as far as disclosure of the invention is concerned. Of these last four Offices not printing their patents however at least two (MC, NZ) make copies of applications available to the public.

9. The total number of copies of patent documents presently committed to be furnished to the PCT International Searching Authorities is approximately 5,900 as of January 1, 1971 with an annual increase of approximately 2,700 documents for each year after that date. It should be noted that this figure may be significantly altered if industrial property offices which have at present either not responded or which are not yet in a position to make commitments, later decide to introduce their documents into the PCT minimum documentation.

10. Of the 16 industrial property offices involved in this study it is probable that a number of them have already made their patent documents available to some prospective International Searching Authorities and need not furnish additional documents to these Offices. It would be of benefit to these 16 offices to know the extent to which their patent documents are already in the search files of such authorities and the extent to which they are continuing to be introduced into the search files. Such information which is not available from previous studies conducted within the PCT or ICIREPAT Committees could be obtained through use of the questionnaire which has been authorized by the Standing Subcommittee to investigate present search techniques as well as prospective search techniques under the PCT.

11. Once the information is obtained the industrial property offices which have already made commitments to contribute documentation can reduce the number of sets of copies they have to commit by the number of sets which have been

transmitted or which are being transmitted to the prospective International Searching Authorities. Furthermore industrial property offices which have not as yet made such commitments or which have said they are unable to make such commitments may be in a better position, in view of a possible lesser demand for their documentation, to make commitments of documentation to the prospective International Searching Authorities not having or not presently receiving their documentation.

12. As an aid to those of the 16 offices contemplating such sorting and listing of their documentation the International Bureau has prepared an analysis (see Annex III. to this document) containing a summary of possible different methods of effecting such a sorting and listing procedure. In addition to a discussion of the manual methods of physically handling the documents, the use of mechanical methods is also discussed as is the use of listings which may possibly already exist. Information on the possible existence and nature of such listings might be obtained by introducing appropriate questions concerning this matter also into the questionnaire on PCT search techniques.

13. The Standing Subcommittee
is invited to comment on the
above progress report.

/Annexes I, II and III follow/

INDUSTRIAL PROPERTY OFFICE	Summary of response to circular letter No. 1220 and/or letter of Nov/Dec 1972			Total documents to be introduced in PCT Minimum Documentation		Note
	Estimate of number of non- priority claiming documents (year)	Will office sort and furnish copies and for what years?	Type of documents to be furnished Number of documents involved	From period 1920- 1970	From period 1971 on/ year	
Australia	95,000-100,000 (1920-1970) 2,100*/year (1971 on)	(1920-1970) unknown (1971 on) yes	<u>non-priority claiming</u> - 2,100*/year	unknown	2,100*/year	prints specification
Austria	65,000 (1920-1972)	under considera- tion	under considera- tion	unknown	unknown	prints specification
Belgium	50,000 (1920-1971)	no	none to be furnished	0	0	prints specification
Canada	85,000 (1948-1971)	yes (1948-1971 on)	<u>non-duplicative</u> 4,400 + 360/year	4,400	360/year	prints specification
German Demo- cratic Rep.	—	no response	—	—	—	prints specification
India	—	no response	—	—	—	prints specification
Ireland	no estimate given	yes (1950-1971)	<u>non-duplicative</u> 300 to 400 + 20*/year	300-400	20*/year	prints specification
Israel	—	no response	—	—	—	prints abridg- ment, does not print specifi- cation
Luxembourg	10,000 (1920-1971)	under consideration	under consideration	0	0	does not print patent documents
Monaco	350* (1957-1971)	Documents already sorted and list available	<u>non-priority claiming</u>	unknown	30*/year	does not print patent documents
New Zealand	—	see Note	see Note	0	0	does not print patent documents
Pakistan	no estimate given	Office is unable to sort documents	—	0	0	prints specification
Philippines	2,200 (1948-1971)	yes (1948-1971)	<u>non-duplicative</u> 1,152 + 170/year	1,152	170*/year	prints abridg- ment, does not print specifi- cation
South Africa	30,039 (1952-1972)	Office will sort 1952-1972 and establish a list	unknown	unknown	unknown	prints claim or claims, does not print specification
Sri Lanka (Ceylon)	—	no response	—	—	—	does not print specification
OAMPI	410 (origin-1971)	yes (unknown)	unknown	unknown	unknown	prints specification

(Translation)

DER PRÄSIDENT
DES ÖSTERREICHISCHEN PATENTAMTES

GR 1306/72

Wien, am January 30, 1973
I., Kohlmarkt 8-10
Postanschrift: Postfach 95, A-1014 Wien

Mr.

Dr. Arpad B o g s c h
First Deputy Director General

W I P O


G e n e v a

Re: PCT Minimum Documentation
Rule 43.1 (c) (vi) PCT

Dear Dr. Bogsch,

With reference to your letter of December 1, 1972
I have the honour to communicate the following information
on the estimate of the number of Austrian patents in which
no priority is claimed. According to our statistical
sources the number of Austrian patents to which R. 34.1
(c) (vi) PCT may become applicable is up to 65.000.
The question from which publication date these non-priority-
documents will be distributed to the International Searching
Authorities is still under consideration.

Yours sincerely,


(Dr. Thaler)

Ministry of Economic Affairs
Administration of Commerce
Industrial and Commercial
Property Department

Your letter of 1.12.72 Your reference: Circular No. 1220
Subject: PCT Minimum Documentation

Sir,

In reply to your letter of December 12, 1972, in which
you refer to your Circular No. 1220, I have the honor to
inform you that the approximate number of Belgian patents
issued since 1920 which are in French and contain no
priority claim may be estimated at about 50,000.

Moreover I take the liberty of drawing your attention to
the fact that documentation relating to Belgian patents
issued since 1926 is in the possession of the International
Patent Institute of The Hague, and that this documentation
is regularly updated.

Taking into account the tasks with which the Institute
may be entrusted under the PCT or in relation to the future
European Patent Office, as well as the heavy burden of
sorting the patents referred to above and, where applicable,
of supplying copies of them to each International Searching
Authority, we are for moment not in a position to take on
commitments towards other Authorities.

Sincerely yours,

R. Raux
Director General

(Translation)

PRINCIPALITY OF MONACO

Department of Finance
and Economic Affairs
Industrial Property Service

December 6, 1972

Sir,

In reply to your Circular No. 1220 PCT 21, I have the honor to inform you that copies of all our patents containing no priority claims have been sent at regular intervals to the International Patent Institute since the creation of this Service, that is, since 1957.

These copies are sent together with a document indicating the numbers of the patents sent. It will therefore be very easy to make copies of these documents if this should be useful to prospective International Searching Authorities.

We should also be willing to make copies of our patents, if the Searching Authorities are interested, especially since the number of patents which would be involved has not exceeded a few dozen a year since the Service was created.

Sincerely yours,

J.M. Notary
Director

Mr. Arpad Bogsch
First Deputy Director General
WIPO
32 chemin des Colombettes
1200 - Geneva
Switzerland

Telegramadres }
Telegraphic Address } "TRADENT"

REPUBLIEK VAN
SUID-AFRIKA



REPUBLIC OF
SOUTH AFRICA

DEPARTEMENT VAN HANDEL-DEPARTMENT OF COMMERCE

Navree/Enquiries:

Mnr./Mr. R. Wellman
Tel. 36098 Bylyn/Ext. 419
485500

Verwys asb. in u antwoord na
In reply please quote

41/79/1

Registrateur van Patente, Modelle, Handelsmerke,
Registrar of Patents, Designs, Trade Marks,

Maatskappye en Outeursreghof,
Companies and Copyright Tribunal,
Forumgebou/Forum Building,

Strubenstraat 159,
159 Struben Street,

Posbus }
P.O. Box } 429,

PRETORIA.

26th January, 1973.

AIRMAIL.

The First Deputy Director
General,
World Intellectual Property
Organization,
32 Chemin des Colombettes,
1211 Genève 20 (Suisse),
SWITZERLAND.

Dear Sir,

P.C.T. MINIMUM DOCUMENTATION.

1. Your Circular letter C.1220 of 24 March 1971 refers.
2. As patents are only valid for 16 years in South Africa, this office will be prepared to sort out "non-priority" patent documents issued by this office for the past 20 years, i.e. with effect from 1952.
3. The number of documents involved will be approximately 30 039 consisting of an average of 4 to 8 pages.
4. The list could be compiled in approximately 9 months.

Yours sincerely,

R. WELLMAN.
for REGISTRAR OF PATENTS.

(Translation)

AFRICAN AND MALAGASY INDUSTRIAL PROPERTY OFFICE
(OAMPI) No. 130/DG/OAMPI/OAF
Yaoundé

January 31, 1973

THE DIRECTOR GENERAL

To: WORLD INTELLECTUAL PROPERTY ORGANIZATION
United International Bureaux for the
Protection of Intellectual Property (BIRPI)
32, Chemin des Colombettes
1211 GENEVA 20 (Switzerland)

For the attention of Dr. Arpad Bogsch
First Deputy Director General

Dear Mr. Director General,

With reference to your correspondence of December 1, 1972,
I have the honor to inform you that the non-priority patents
issued by our Office up to the end of 1972 amount to
approximately 410 files.

Sincerely yours,

Denis EKANI
Director General

Annex III follows

SORTING AND LISTING PCT RULE 34.1(c) (vi)
DOCUMENTATION

The Problem

1. The problem is to determine methods by which countries publishing or issuing English, French or German language patent documents which are not now prescribed as forming part of the PCT minimum documentation might be able to simply and easily determine which of those patent documents are non-priority claiming or even better which are non-duplicative so that copies of these documents could be sorted out, and introduced into the search files of the prospective International Searching Authorities as part of the PCT minimum documentation.

Definitions Used Herein

2. The following definitions are used in this document

- (a) "Non-priority claiming patent document" are those patent documents of any given country which do not claim the priority of an earlier filed patent application.
- (b) "Non-duplicative patent documents" are those patent documents of any given country which, among the "non-priority claiming" documents, do not serve as a basis for a priority claim in any later published patent document.

Manual Methods of Listing of Non-priority Claiming or Non-duplicative Patent Documents

3. The safest method of determining the "non-priority claiming" patent documents of any given country, provided the country published patent documents with priority information, is to physically examine every patent document as to the bibliographic data contained therein concerning priorities claimed. Any document claiming a priority is excluded. Thus a list would be established of the numbers of all documents not excluded i.e., not claiming a priority. Countries which either do not publish patent documents or, if they do publish patent documents, do not publish any priority information on such documents, will have to consult the sources found in the following paragraphs to establish a list on non-priority claiming patent documents. Making the selection from the patent documents themselves presents the additional advantage that at least one set of documents to be put at the disposal of an International Searching Authority can be prepared while going through the sorting process.

4. Quite obviously as the bibliographic elements concerning priority claims may be reproduced by itself or with other information in a Gazette, this source could equally serve as a source for generating a list of numbers of non-priority claiming patent documents.

5. Should neither the patent documents nor other publications contain the bibliographic information necessary to establish a list of non-priority claiming patent documents, the primary source of the information i.e. the files of the applications, would have to be consulted in order to generate a listing of numbers of non-priority claiming patent documents.

6. Once a listing of non-priority patent documents has been established for any given country, a listing of non-duplicative patent documents can be derived therefrom by physically examining all other foreign patent documents and eliminating from the listing the number of any patent document which is duplicated by any foreign patent document. The extent of the examination of foreign patent documents may be limited to the patent documents of only particular countries, such as Canada looking at only patent documents of the

United States of America or Ireland looking only at patent documents of the United Kingdom. This will result in the listing containing some numbers representing patents which are duplicated in countries whose documents have not been examined for priorities.

Mechanical Methods of Listing Non-priority Claiming or Non-duplicative Patent Documents

7. It is to be noted that any system based on the elimination of all patent documents claiming a priority suffers from a number of deficiencies with respect to lack of completeness in some areas and risk of duplication in other areas. Quite obviously the elimination of all patent documents claiming a priority will eliminate some patent documents, probably a very small percentage, which are not found among the seven minimum documentation countries patent documents. This may be due to the fact that even if the priority of a patent application in one of the seven minimum documentation countries was claimed, the document itself may never have been published. The fact that the priority of an application filed in a country which is not one of the seven PCT minimum documentation countries was claimed does not automatically make a patent document non-duplicative for purposes of PCT minimum documentation. As a rule, subsequent applications will in such cases have been filed in one or more of the PCT minimum documentation countries and may have led to a publication there.

8. The optimum selection of documentation from countries having English, French or German language patent documents other than the seven countries referred to in Rule 34.1(c)(i) to (v) would be to include all documents which are not duplicated in the documentation of the said seven countries or in documents of other countries which are added to PCT minimum documentation. A reduced list containing only such documents could be achieved through the use of patent-family-determining facilities such as the newly created International Patent Documentation Center (INPADOC) in Vienna. INPADOC as far as it inputs the bibliographic data from patent documents of the seven countries named in Rule 34, will be able to produce lists of numbers of patent documents which are non-duplicative in nature. This will of course be possible only for the period for which the data base is complete and therefore will probably not permit the coverage of a period extending more than several years back into the past.

9. A list of non-duplicative patent documents would be made up of all numbers of patent documents which are not members of a patent family supplemented by the number of patent documents members of patent families of which no other member is a patent document from one of the seven minimum documentation countries or from one of the additional countries whose patent documents are being included. Such a listing could easily be made through use of INPADOC's patent family service but, as stated above, only within the limits of its data base.

Use of Existing Records for Listing Non-priority Claiming or Non-duplicative Patent Documents

10. Other possible methods of determining the non-priority or non-duplicative patent document numbers may be to utilize information which exists presently in national industrial property Offices. Such information may be derived from records established by these Offices upon receipt of foreign patent documents to determine which are duplicative and should not be entered into their search files.

11. A survey might be conducted among the larger national industrial property Offices in order to ascertain whether such information exists which would readily permit the establishment of a listing of non-priority or non-duplicative English, French or German language patent documents from a country not one of the seven PCT minimum documentation countries.

12. Another method would be that, simultaneously with the preparation of the annual statistics of any given national Office for publication by WIPO, that Office would also make a listing of non-priority patent documents. One of the statistical figures which is furnished to WIPO annually by most Offices is the number of applications and grants claiming foreign priority. A national Office could at the same time that that number is ascertained make a listing of the non-priority patent documents. The possibility of combining these tasks might be further studied.