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SURVEY ON THE CURRENT SEARCH PRACTICES OF
THE PROSPECTIVE INTERNATIONAL SEARCHING AUTHORITIES

Report

prepared by the International Bureau

SUMMARY

This document contains a comparative analysis of the current searching practices of the prospective International Searching Authorities based upon the responses of those Authorities to the questionnaire sent to them and in the light of the earlier reports on "isolated searches" prepared by the German Patent Office and the International Patent Institute.

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INTRODUCTION

Background

1. The PCT Interim Committee for Technical Cooperation (hereinafter referred to as the "Interim Committee"), at its fourth session held in Geneva in November 1974, after reviewing a questionnaire on the current search practices of the prospective International Searching Authorities, agreed that that questionnaire should be sent to prospective International Searching Authorities in order to solicit their responses thereto (see paragraph 42 of the Report of the fourth session, document PCT/TCO/IV/18). The questionnaire which was sent is set forth as Annex A of this document.

Questionnaire

2. The purpose of the questionnaire was to begin compiling an information base on the current searching practices of the prospective Authorities, particularly in the light of the requirements governing PCT searches. This information base serves to identify what additional information should be obtained and what particular areas of search practices should be further surveyed in more detail. Such information is designed to contribute to the establishment of guidelines under which the prospective International Searching Authorities will carry out PCT searches. The ultimate goal is, of course, the aim set forth in Article 56(3)(ii) of the PCT, that is to achieve a maximum degree of uniformity in the working methods of the International Searching Authorities and a maximum degree of uniform high quality search reports.

3. The manner in which the questionnaire was drafted is such that the responses initially give general information on the searching practices now being employed by the prospective International Searching Authorities and for which the PCT prescribes requirements. The questions were formulated so that they could be answered by a simple "yes" or "no". Where a question called for more than that, the Offices were requested to answer the question in brief, general terms, rather than being highly specific.

4. The responses to the questionnaire are set forth as Annexes B to H of this document.

Comparative Analysis

5. The Interim Committee, at its fourth session, requested the International Bureau to prepare a comparative analysis of the responses to the questionnaire on the current searching practices. That analysis should take into consideration, where applicable, the earlier reports on "isolated searches" which were prepared by the German Patent Office and the International Patent Institute and which were submitted to a previous session of the Interim Committee in document PCT/TCO/III/5.

6. The comparative analysis which follows was prepared in order to meet that request. It is presented in a manner which groups the responses to the questionnaire in relation to the particular questions asked. Then a brief summary analyzing the responses is given.

7. It is to be noted that the major distinction arising from a comparison of the information obtained to date on the basis of the questionnaire and that information contained in the earlier reports on "isolated searches" relates to the question of distinguishing as to the relevance of documents cited in the search report. (see question no. III.B.1(a) contained on page 13).

8. The Interim Committee is invited to consider the following comparative analysis of the information compiled to date. The Interim Committee is further requested to give its advice in respect of the need to compile additional information, the areas of searching practices in which further information should still be compiled, and the methods to be used in compiling such information. In giving its advice, the Interim Committee is asked to bear in mind the eventual needs of any guidelines for searching under the PCT to be established.

COMPARATIVE ANALYSIS

I. Procedural Checks of Requirements of an Application Prior to Search

A. Subject Matter - PCT Article 17(2)(a)(i) provides that International Searching Authorities are not required to search international applications which relate to subject matter as indicated in PCT Rule 39.

- 1. Does your Office presently search national applications relating to any of the subject matters indicated in Rule 39?

RESPONSES :

YES - Austria, Japan, Soviet Union, Sweden, United States and the [IIB].

NO - Federal Republic of Germany

- 2. If the answer to the above question is "yes", briefly indicate those subject matters indicated in Rule 39 which are searched.

RESPONSES :

Austria : "According to case law and literature diagnostic methods are not excluded from patent protection and therefore subject to search".

Japan : "All subject matters in PCT Rule 39(ii); and the treatment and diagnosis of animal body in (iv)".

Soviet Union : "Methods for treatment of human or animal body by surgery or therapy, as well as diagnostic methods".

Sweden : "Diagnostic methods and computer programs to a certain extent".

United States : "Plants produced asexually, methods for treating the human body and diagnostic methods United States patent classes 128 and 424, and computer programs but not patentability per se".

IIB : "Searches relating to subject matter indicated in Rule 39(i) and (iii) to (vi) are in principle carried out in as far as the existing documentation permits. However, in practice, this is done only for a few borderline cases".

Summary

The responses to the questions under item I.A. above (dealing with subject matter searched) give some idea on which of the matter listed under PCT Rule 39, if it were the subject of an invention described in an international application, any particular prospective International Searching Authority might perform an international search, although that Authority would not be required to do so under PCT Rule 39.

B. Meaningful Search - Article 17(2)(a)(ii) provides that the International Searching Authority is not required to search international applications in which the description, claims or drawings fail to comply with the prescribed requirements to such an extent that a meaningful search could not be carried out.

1. Does your national law prescribe requirements for the description, claims or drawings, in the nature of PCT Articles 5, 6 and 7, respectively, which have to be complied with in order that a meaningful search may be effected?

RESPONSES :

YES - Austria, Japan, Soviet Union, Sweden and the United States.

The Federal Republic of Germany indicated :

"Article 26 of the German Patent Law contains only basic concepts in respect to the requirements of patent applications. In addition thereto, there have been issued Regulations for Patent Applications containing the requirements regarding the description in Section 3, regarding the patent claims in Section 3a and in respect to the drawings in Section 4".

The IIB indicated :

"The national laws of CH. [Switzerland], FR. [France] and NL. [Netherlands] prescribe similar requirements".

2. If your national law prescribes such requirements, briefly state the substance of the requirements.

RESPONSES :

Austria : "The requirements of the Austrian Patent Law are the following :
'The description shall :
(i) describe the invention in a manner sufficiently clear, distinct and complete for the invention to be carried out by persons skilled in the art;
(ii) at the end of the description, emphasize precisely and distinctly what is new - thus constituting the subject of the patent - in one or more claims;
(iii) contain the drawings necessary for the carrying out of the invention. The drawings shall be of a durable nature and be accompanied, where necessary, by models and samples.' (Sec. 91, par. 1 of the Austrian Patent Law)".

Federal Republic of Germany : "Sections 3, 3a and 4 of the Regulations for Patent Applications are reproduced in the annex".

Japan : "By Japanese Patent Law Art. 36, Enforcement Regulations Art. 24 and Art. 25, it is required to mention (1) the title of the invention, (2) a brief explanation of drawings, (3) a detailed explanation of the invention and (4) the claim or claims. For the brief explanation of drawings, it should be mentioned whether a drawing presents a plane, a solid or a cross-sectional view; also explanatory notes for symbols, etc. The detailed explanation of the invention includes the purpose, constitution and effect of the invention in such a manner so that it may be easily worked by a person having ordinary skill in the art to which the invention pertains. The claim or claims state only the indispensable constituent features of the invention as described in the detailed explanation".

- Soviet Union : "The description of the invention must state the purpose of the invention and must describe the invention in detail, including its distinctive features; it should also contain data on the technical and economic effectiveness of the utilization of the invention, the fields of technology to which the invention relates and where the invention can be utilized, and the claims of the invention. The invention must be disclosed in the description, drawings, diagrams and other graphic materials with sufficient comprehensiveness and clarity as to show its novelty and essential distinctions and to make it possible to utilize the invention.
The description of a substance produced by a chemical process must also contain data on its chemical structure and physical and chemical properties, disclose the method (or methods) of producing it and indicate its field of application.
The description of the invention must end with its claims, which shall be the only criteria for defining the scope of the invention and shall be in the form of a briefly-worded statement indicating the essence of the invention from a technical viewpoint. In the claims, a device shall be characterized by reference to the features of its design, a process - by reference to a certain sequence of actions (methods, and operations with the help of material objects), and a substance - by reference to its ingredients and their quantitative ratios".
- Sweden : "The description and claims shall be in the Swedish language. The description must be sufficiently clear to enable the invention to be carried out by a person skilled in the art. The application shall contain an explicit statement of what is sought to be protected by the patent (i.e. claims)".
- United States : "35 USC 112 and 35 USC 113. (Similar to PCT Articles 5, 6 and 7)".
- IIB : "CH. : The description shall disclose the invention in such
[Switzerland] a manner that it can be carried out by a person skilled in the art. (Art. 50 CH. Patent Law 1954).
The claim(s) shall define the invention (Art. 51).
An integrating part of the description is formed by the drawings required for its understanding (Art. 49).
FR. : The claims define the scope of the protection sought.
[France] (Art. 13 FR. Patent Law 1968).
Drawings may, if necessary, complete the description.
(Art. 13).
NL. : The description shall be of such a nature, that the
[Netherlands] invention can be understood and carried out by a person skilled in the art. (Art. 22B NL Patent Law 1963).
The claims shall define the matter for which exclusive rights are sought. (Art. 22A).
The description shall be accompanied by drawings if necessary. (Art. 22B)".

Summary

The responses to the questions set forth under Item I.B. above (dealing with the requirements allowing for a meaningful search) show that the search practices which all of the prospective International Searching Authorities presently apply are established on the basis of national laws which require that the contents of an application have to meet certain high standards (in essence similar to the requirements under the PCT) before such Authorities will undertake to carry out a search on that application.

C. Unity of Invention - PCT Article 17(3) and PCT Rules 13 and 40 prescribe a requirement of unity of invention to be applied to international applications by the International Searching Authorities.

1. Does your Office presently apply a unity of invention requirement to national applications?

RESPONSES :

YES - Austria, Federal Republic of Germany, Japan, Soviet Union, Sweden and the United States.

The IIB indicated :

"Yes, but objections of non-unity are only raised in the search report if the scope of the search is affected, i.e. if the search would have to be extended to cover the non-unitary subject matter".

2. If the answer to the above question is "yes", does your Office, where it finds that an application lacks unity of invention, automatically, that is, before any further correspondence with the applicant is undertaken, proceed to select the particular invention (for example, the "main invention") to be searched?

RESPONSES :

YES - Austria, and the IIB.

Sweden indicated :

"Yes, often, but not always".

NO - Japan, Soviet Union, and the United States.

The Federal Republic of Germany indicated :

"No. If it is ascertained by the preliminary examination division in the course of the examination as to obviousness that the patent application is lacking uniformity, the applicant is requested to eliminate the non-uniform part and to continue that part in a divisional application. Then a separate search request may be filed for each of these applications. If, however, lack of uniformity is ascertained only during the search procedure, the search will be carried out for all inventions contained in the patent application".

3. If the answer to question 2 is also "yes", briefly state the basis on which the particular invention is selected (for example, the invention first mentioned in the claims).

RESPONSES :

Austria : "In principle, the invention first mentioned in the claims is subject to search".

Sweden : "No general answer can be given. However, in most cases a study of the description forms the basis for determining what is the 'main invention'".

IIB : "The invention first mentioned in the claims".

4. If your Office applies a unity of invention requirement, which of the following procedural options are available to an applicant failing to meet such requirements :

- (a) payment of additional fees?
(b) restriction of the invention?

RESPONSES :

Austria : "The applicant has to restrict his invention (option (b))".

- Federal Republic of Germany : "The applicant has to divide the originally filed non-uniform application into the parent application and the divisional application. Separate search requests have to be filed for each of these independent applications and the respective fees have to be paid".
- Japan : "Restriction of the invention. A notice is sent to the applicant notifying him of the grounds for rejection. Japanese Patent Law Act. 38 stipulates for one invention in one application, as a rule".*
- Soviet Union : "Yes (the applicant has the right to divide the application)".
- Sweden : "The application has to be restricted to one invention or a group of inventions covered by a single inventive concept. However, the deleted invention(s) can form the basis for a divisional application for which an application fee has to be paid. This fee covers, generally speaking, the costs of the search".
- United States : "(a) No, not in the same application;
(b) Yes".
- IIB : "The search is completed for the other inventions at the request of the national Office concerned and on payment of an additional fee".

Summary

The responses to the questions set forth under Item I.C. above (dealing with the requirement of unity of invention) show that, under present practices, all the prospective International Searching Authorities apply a concept of unity of invention. Not all such prospective Authorities, however, apply a practice of automatically proceeding to search the "main invention" (defined in Article 17(3)(a) of the PCT as the invention first mentioned in the claims). Some practices involve further contact with the applicant so that the latter may be called upon to exercise a choice as to how the application should be divided or restricted.

It is recalled that the time element under which an international search report is to be established in order that an international application enters the national phase properly prepared accounted for the necessity of having an automatic restriction under the PCT. The exercise of any choice on the part of the applicant under the PCT as to which invention he would wish to be searched results from the order in which the applicant mentions the invention in drafting his claims.

In view of the present search practices, particular attention should be given in any future guidelines for searching under the PCT to the question of unity of invention, particularly the aspects concerning the "main invention".

* This provision will, however, be changed by a new law entering into force on January 1, 1976, which will allow multiple claiming.

D. Title and Abstract - PCT Articles 3 and 14 require that an abstract and a title be part of the international application. The International Searching Authority may, under certain circumstances, be required to establish a title (PCT Rule 37.2) or establish an abstract (PCT Rule 38.2).

1. Does your Office presently require that a national application contain the following elements :

(a) a title?

RESPONSES :

YES - Austria, Federal Republic of Germany, Japan, Soviet Union, Sweden, United States, and the IIB.

(b) an abstract?

RESPONSES :

YES - United States
The IIB indicated : "FR [France] : Yes".

NO - Austria, Federal Republic of Germany, Japan, Soviet Union, Sweden.
The IIB indicated : "CH [Switzerland], NL [Netherlands] : No".

2. Does your Office presently engage in establishing titles and/or abstracts (and, if so, which) when those elements are :

(a) missing in the application?

RESPONSES :

YES - Sweden (titles), United States (titles, but not abstracts).

The Federal Republic of Germany indicated :
"If the title of the invention does not correspond to the formal requirements, the preliminary examination division requests the applicant to remedy this defect. For economical reasons, the preliminary examination division will, if possible, already propose a title to the applicant to which he will then merely have to agree".

NO - Austria, Japan, Soviet Union, and the IIB.

(b) contained in the national application, but are defective in that they do not meet the requirements of the national law?

RESPONSES :

YES - Soviet Union (titles), Sweden (titles), United States (titles and abstracts).
See the response of the Federal Republic of Germany under question 2.(a) above as to titles.

NO - Austria, Japan and the IIB.

Summary

The responses to the questions under Item I.D. above (dealing with the title and the abstract) point out that certain of the prospective International Searching Authorities already apply a practice of establishing titles both in the case where a title is missing from the application and, particularly, in the case where a title although contained in the application, is defective. However, not all of such prospective Authorities are experienced in the practice of establishing abstracts.

Thus, particular attention should also be given in any future PCT searching guidelines to the establishment of abstracts. It is noted that the Guideline for Abstracts under the PCT, which has been prepared and submitted for this session of the Interim Committee (see document PCT/TCO/V/10), will be of assistance in this respect.

II. Search

A. Objective of the Search - PCT Article 15(2) provides that the objective of the international search is to discover relevant prior art. PCT Rule 33.1 defines relevant prior art as consisting of everything which has been made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) and which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step (i.e., that it is or is not obvious), provided that the making available to the public occurred prior to the international filing date.

1. Is the discovery of worldwide prior art documents (everything which has been made available to the public anywhere in the world) an objective of the searches your Office presently performs?

RESPONSES :

YES - Austria, Japan, Soviet Union, Sweden, United States.

The Federal Republic of Germany indicated :

"Yes. However, not including written disclosures published after the application date, referring to an oral disclosure, a use, an exhibition or other measures and the date on which the oral disclosure had been made available to the public is prior to the application date".

The IIB indicated :

"Yes, in principle, but within economical and practical limits".

2. Do the searches your Office presently performs attempt to discover prior art documents relevant to the criterion referred to above of :

(a) novelty?

RESPONSES :

YES - Austria, Federal Republic of Germany, Japan, Soviet Union, Sweden, United States, and the IIB.

(b) inventive step?

RESPONSES :

YES - Austria, Federal Republic of Germany, Japan, Sweden, United States, and the IIB.

The Soviet Union indicated :

"Yes (analogous criterion is 'essential distinctions')".

Summary

The responses to the questions set forth under Item II.A above (dealing with the objective of the search) reveal that the present search practice of all of the prospective International Searching Authorities are consistent with the PCT requirements in that the principle of worldwide prior art is followed and in that the relevance of prior art documents are considered both in the light of the criteria of novelty and inventive step.

B. Field of Search - PCT Rules 33.2(b) and (d) require that the international search shall cover not only the art in which the invention is classifiable, but also analogous art, regardless of where classified, and equivalent subject matter.

1. Do the searches your Office presently performs extend to fields :
 - (a) of analogous art to the extent that that art is regarded to be analogous in the light of what appears to be the necessary essential function or use of the invention and not only specific functions expressly indicated in the application?

RESPONSES :

YES - Austria, Japan, Sweden, United States, and the IIB.

The Federal Republic of Germany indicated :

"Yes. However, for economical reasons, the examiner decides, in practice, on the basis of the search results so far obtained to what extent the search will have to be extended to similar technical fields and which objects considered to be equivalent to the subject matter of the invention claimed, will have to be included into the search".

The Soviet Union indicated :

"Yes (if no anticipatory references found in the result of search in the art in which the invention is classified)".

- (b) embracing all subject matter that is generally recognized as equivalent to the subject matter of the claimed invention for all or certain of its features?

RESPONSES :

YES - Austria, Japan, Sweden, United States, and the IIB.

The Soviet Union indicated :

"Yes (if no anticipatory references found in the analogous art)".

See the response of the Federal Republic of Germany under question 1.(a) above.

Summary

The responses to the questions set forth under Item II.B. above (dealing with the field of search) indicate that the present search practices of all of the prospective International Searching Authorities are consistent with the PCT requirements in that they take into consideration both analogous art and equivalent subject matter.

C. Orientation of the Search - PCT Rule 33.3 provides that the search shall be made on the basis of the claims with due regard to the description and the drawings, if any, and with particular emphasis on the inventive concept toward which the claims are directed? Furthermore, insofar as possible and reasonable, the international search must cover the entire subject matter to which claims are directed or to which they might reasonably be expected to be directed after they have been amended.

1. Do the claims in the national application primarily serve as the basis for the searches your Office presently performs?

RESPONSES :

YES - Federal Republic of Germany, Japan, Soviet Union, United States and the IIB.

Austria indicated :

"Yes. The search is based on the claims with due regard to the description".

Sweden indicated :

"Not necessarily".

2. Are the criteria of your national law for the orientation of the search similar to those of the PCT?

RESPONSES :

YES - Japan, Soviet Union, Sweden, United States and the IIB.

Austria indicated :

"The search of the Austrian Patent Office is part of the examination procedure. At present no so-called 'isolated search' is performed. However, the orientation of the search in principle is similar to the PCT-search".

The Federal Republic of Germany indicated :

"Yes. However, the criteria are not contained in the German Patent Law, but in the Guidelines for the Examination of Patent Applications (Richtlinien für die Prüfung von Patentanmeldungen) which have been issued in addition thereto".

3. If the answer to any of the above questions is "no", briefly indicate what part or parts of the application form the basis of the search in your Office or what other criteria for the orientation of the search are applicable?

Sweden, in order to elaborate on its response to question 1. above, indicated :
 "The claims have to be searched, but if they are not representative of the invention this - as understood from the description - must also be searched".

Summary

The responses to the questions set forth under item II.C. above (dealing with the orientation of the search) indicate that the searching practices presently applied by all of the prospective International Searching Authorities are oriented in the same direction as searches under the PCT. That is, the basic orientation of the search is directed towards the inventive concept defined by the claim, however, having due regard to the description and any drawings.

III. Preparation of the Search Report

A. Classification - PCT Rule 43.3 provides that the international search report must contain a classification determined by the International Searching Authority of the subject matter of the international application at least according to the International Patent Classification (IPC).

1. Does your Office presently classify national applications according to the IPC?

RESPONSES :

YES - Federal Republic of Germany, Japan, Soviet Union, and Sweden.

Austria indicated :

"When the applications are laid open for public inspection the IPC classification is applied up to the finest subdivision as subsidiary classification".

The United States indicated :

"Only to the extent that the IPC is printed on the patent".

The IIB indicated :

"The IIB does not classify national applications. However, patent documents to be entered into the search files are classified for the greater part according to the IPC".

2. If your Office presently classifies applications according to classification systems other than, or in addition to, the IPC, briefly indicate which classification system is (systems are) used.

RESPONSES :

Austria : "A national (Austrian) classification system is applied as principal classification".

Japan : "Japanese Patent Classification".

United States : "US patent classification system".

IIB : "The IIB is in the process of going over from the old IIB/OR internal classification scheme (IdT) to the IPC scheme".

Summary

The responses to the questions set forth under Item III.A. above (dealing with the classification of the subject matter of the application) show that, under present search practices, all of the prospective International Searching Authorities, including those Authorities which also employ a separate national classification scheme, have experience in dealing with classifying national applications or patent documents according to the IPC.

B. Citations - PCT Rule 43.5 provides that the international search report shall contain citations of relevant and particularly-relevant documents or parts thereof. Citations which are not relevant to all the claims shall be cited in relation to the claim or claims to which they are relevant.

1. Does your Office presently, in citing documents in its search reports :
 - (a) make a special distinction in respect of those documents which are considered of particular relevance?

RESPONSES :

YES - Japan, Soviet Union, and the United States.

Austria indicated :

"The answer is, in principle, Yes. However, this question is not pertinent to searches performed as part of an examination procedure. As the search under the Austrian Patent Act is an 'integrated' search and no 'isolated' one, only the following comments can be made :
There is no specific rule. However, as in ordinary cases, the first action of the examiner has to contain a statement on the patentability of the invention, the main documents are referred to as such in the rationale of the first action".

Sweden indicated :

"The question is irrelevant, since the documents cited are not contained in any separate list, but included in the official action (search and examination report)".

NO - Federal Republic of Germany, and the IIB.

- (b) make references to parts of the cited documents where only those parts are relevant or of particular relevance?

RESPONSES :

YES - Austria, Japan, Soviet Union, Sweden, United States, and the IIB.

The Federal Republic of Germany indicated :

"Yes, by indication of the page, column and the line or the illustrations".

- (c) distinguish whether any cited document relates either to all claims or to particular claims?

RESPONSES :

YES - Austria, Japan, Soviet Union, Sweden, United States, and the IIB.

The Federal Republic of Germany indicated :

"Yes, by the indication of the patent claims, to which the documents mentioned refer".

2. Does your Office automatically furnish, or does it provide on request, copies of the documents cited in the search report?

RESPONSES :

Austria : "Copies can be obtained upon request as part of a general copy service".

Federal Republic of Germany : "Against payment of a fee, the applicant may obtain, upon special request, copies of the documents mentioned in the search report".

Japan : "Yes, our Office provides such copies on request".

Soviet Union : "On request".

Sweden : "If requested, copies are furnished by a copying service which charges a fee to cover its costs".

United States : "Yes, one copy of each cited document".

IIB : "Copies of the documents cited are furnished automatically".

Summary

The responses to the questions set forth under item III.B. above (dealing with the citation of documents in the search report) point out that the major distinction between the searching practices applied by the prospective International Searching Authorities dealing with an "isolated search" and those dealing with a combined search and examination seems to appear in the preparation of the search report, i.e., particularly as to making a distinction on the relevance of any documents cited therein. The other aspects of the search practices presently applied by the prospective International Searching Authorities, such as orientation of the search, the field of search, etc., are quite similar and are not dependent upon whether the search is "isolated" or "integrated". Both the reports of the two prospective Authorities practising a purely "isolated" search, i.e. the German Patent Office and the IIB (see document PCT/TCO/III/5), and their responses to question 1.(a) under item III.B. above show that they do not make any distinction as to the relevance of the documents cited. Under the practices of the other prospective Authorities, however, a distinction is presently made as to the degree of relevance of any cited document. This is done by means of an examiner's opinion in which the cited documents are compared or combined in order to meet the claimed invention.

It would appear that any future guidelines for searching should readily be able to harmonize the practice under the PCT on this point. This flows from the fact that under the PCT the requirement to indicate cited documents as being of particular relevance is an approach which lies in between the two schools of present practice.

As to obtaining copies of documents cited, all prospective Authorities already offer this possibility.

C. Fields Searched - PCT Rule 43.6(a) provides that the international search report shall list the classification identification of the fields searched. PCT Rule 43.6(b) provides that, if the international search extended to documents of States, periods, or languages not included in the PCT Rule 34 minimum documentation, the international search report shall, when practicable, identify the kinds of documents, the States, the periods, and the languages to which it extended.

1. Does your Office presently indicate in its search reports the classification identification of the fields searched?

RESPONSES :

YES - Federal Republic of Germany.

The Soviet Union indicated :

"Yes (according to the official classification systems, which indexes are published according to the patents)".

NO - Austria, Japan, Sweden, and the IIB.

The United States indicated :

"No, but it is included in the printed patent and in the application file. However, class and sub-class of the cited documents are listed on the reference cited sheet of the Office action. Plans are now being made to include the fields searched in the Office action".

2. Does your Office provide in its search reports the following information for any given application searched :

- (a) kind of documents searched (patents, inventors' certificates, etc.)?

RESPONSES :

NO - Austria, Federal Republic of Germany, Japan, Soviet Union, Sweden, United States, and the IIB.

- (b) country of origin of documents searched?

RESPONSES :

YES - Federal Republic of Germany, Soviet Union.

NO - Austria, Japan, Sweden, United States, and the IIB.

- (c) range of years of documents searched?

RESPONSES :

YES - Soviet Union.

NO - Austria, Federal Republic of Germany, Japan, Sweden, United States, and the IIB.

- (d) languages of documents searched?

RESPONSES :

NO - Austria, Federal Republic of Germany, Japan, Soviet Union, Sweden, United States, and the IIB.

In respect to questions 2(a) to (d) above the United States indicated :
"Even though the specific answers to question 2 as worded are 'No', the various kinds of documents and foreign patents are classified according to class and sub-class. These documents and foreign patents are placed in the appropriate U.S. class and sub-class under the headings of literature and foreign patents respectively. When the U.S. class and sub-class are searched, the literature and foreign patents are also searched. Accordingly, for search purposes, everything including the materials listed in 2 would be searched in the U.S. classes and sub-classes. The language of the documents is not pertinent, since we consider documents in any language. The range of years is not pertinent, since any document in the sub-class from the oldest available date to the current date is considered".

In respect to questions 2(a) to (d) above, the IIB indicated :
"The searches for all national applications are performed according to the same guidelines and in the documentation at the disposal of the IIB".

Summary

The responses to the questions set forth under item III.C above (dealing with the fields searched) indicate that under present search practices the majority of the prospective International Searching Authorities do not identify the classification of those areas which were searched in the establishment of national search reports.

However, as this only requires a searcher to make notations during the course of his search so that he can later identify in the search report the fields that he actually searched, it should not entail any problems of harmonization for the future guidelines for searching under the PCT.

In respect of the identification of the kinds of documents, States, periods and languages to which search was extended, the responses indicate that the prospective International Searching Authorities for the most part do not undertake to identify such in their national search reports under present practices. Again no problem of harmonization is posed, since under the PCT such identification is to be made only if the International Searching Authority finds it practical to do so.

[The Questionnaire (Annex A), follows]



WORLD INTELLECTUAL PROPERTY ORGANIZATION
ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE

C.2133
PCT 21

2.

C.2133
PCT 21

February 28, 1975

Your are kindly requested to forward your Office's responses to the enclosed questionnaire to the International Bureau by April 30, 1975.

Sincerely yours,

K. Pfanner
Deputy Director General

Dear Sir,

The Patent Cooperation Treaty (PCT) Interim Committee for Technical Cooperation decided at its fourth session held in Geneva, from November 14 to 19, 1974, that the International Bureau shall send the enclosed questionnaire on current search practices to all the prospective International Searching Authorities (see paragraph 42 of the Report of the fourth session, document PCT/TCO/IV/18).

The purpose of this questionnaire is to obtain information on current searching practices, taking into account the requirements for PCT searches, in order to pursue the aim set forth in Article 56(3)(ii) of the PCT, that is, to achieve a maximum degree of uniformity in the working methods of the International Searching Authorities and a maximum degree of uniformly high quality in their search reports.

The questionnaire is drafted in such a way that the responses should give general information on the searching practices now being employed by the prospective PCT International Searching Authorities in order to provide some insight into the way these authorities would perform their searching activities under the PCT.

Most questions are formulated so that they may be answered by a simple "yes" or "no". Where a question calls for more than that, the Offices are requested to answer the question in brief, general terms, rather than being highly specific. The intention of the International Bureau is to first generate a general information base in the areas of the questions asked in order to enable it to propose the most suitable approach to be taken in obtaining further specific information.

PCT/TCO/IV/7
Annex A/Annexe A

QUESTIONNAIRE ON CURRENT SEARCHING PRACTICES

I. Procedural Checks of Requirements of an Application Prior to Search

A. Subject Matter - PCT Article 17(2)(a)(i) provides that International Searching Authorities are not required to search international applications which relate to subject matter as indicated in PCT Rule 39.

1. Does your Office presently search national applications relating to any of the subject matters indicated in Rule 39?

2. If the answer to the above question is "yes", briefly indicate those subject matters indicated in Rule 39 which are searched.

B. Meaningful Search - Article 17(2)(a)(ii) provides that the International Searching Authority is not required to search international applications in which the description, claims or drawings fail to comply with the prescribed requirements to such an extent that a meaningful search could not be carried out.

1. Does your national law prescribe requirements for the description, claims or drawings, in the nature of PCT Articles 5, 6 and 7, respectively, which have to be complied with in order that a meaningful search may be effected?

2. If your national law prescribes such requirements, briefly state the substance of the requirements.

C. Unity of Invention - PCT Article 17(3) and PCT Rules 13 and 40 prescribe a requirement of unity of invention to be applied to international applications by the International Searching Authorities.

1. Does your Office presently apply a unity of invention requirement to national applications?

2. If the answer to the above question is "yes", does your Office, where it finds that an application lacks unity of invention, automatically, that is, before any further correspondence with the applicant is undertaken, proceed to select the particular invention (for example, the "main invention") to be searched?

3. If the answer to question 2 is also "yes", briefly state the basis on which the particular invention is selected (for example, the invention first mentioned in the claims).

4. If your Office applies a unity of invention requirement, which of the following procedural options are available to an applicant failing to meet such requirements:

- (a) payment of additional fees?
- (b) restriction of the invention?

D. Title and Abstract - PCT Articles 3 and 14 require that an abstract and a title be part of the international application. The International Searching Authority may, under certain circumstances, be required to establish a title (PCT Rule 37.2) or establish an abstract (PCT Rule 38.2).

1. Does your Office presently require that a national application contain the following elements:

- (a) a title?
- (b) an abstract?

2. Does your Office presently engage in establishing titles and/or abstracts (and, if so, which) when those elements are:

- (a) missing in the national application?
- (b) contained in the national application, but are defective in that they do not meet the requirements of the national law?

II. Search

A. Objective of the Search - PCT Article 15(2) provides that the objective of the international search is to discover relevant prior art. PCT Rule 33.1 defines relevant prior art as consisting of everything which has been made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) and which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step (i.e., that it is or is not obvious), provided that the making available to the public occurred prior to the international filing date.

1. Is the discovery of worldwide prior art documents (everything which has been made available to the public anywhere in the world) an objective of the searches your Office presently performs?

2. Do the searches your Office presently performs attempt to discover prior art documents relevant to the criterion referred to above of:

- (a) novelty?
- (b) inventive step?

B. Field of Search - PCT Rules 33.2(b) and (d) require that the international search shall cover not only the art in which the invention is classifiable, but also analogous art, regardless of where classified, and equivalent subject matter.

1. Do the searches your Office presently performs extend to fields:

- (a) of analogous art to the extent that that art is regarded to be analogous in the light of what appears to be the necessary essential function or use of the invention and not only specific functions expressly indicated in the application?
- (b) embracing all subject matter that is generally recognized as equivalent to the subject matter of the claimed invention for all or certain of its features?

C. Orientation of the Search - PCT Rule 33.3 provides that the search shall be made on the basis of the claims with due regard to the description and the drawings, if any, and with particular emphasis on the inventive concept toward which the claims are directed? Furthermore, insofar as possible and reasonable, the international search must cover the entire subject matter to which claims are directed or to which they might reasonably be expected to be directed after they have been amended.

1. Do the claims in the national application primarily serve as the basis for the searches your Office presently performs?

2. Are the criteria of your national law for the orientation of the search similar to those of the PCT?

3. If the answer to any of the above questions is "no", briefly indicate what part or parts of the application form the basis of the search in your Office or what other criteria for the orientation of the search are applicable?

III. Preparation of the Search Report

A. Classification - PCT Rule 43.3 provides that the international search report must contain a classification determined by the International Searching Authority of the subject matter of the international application at least according to the International Patent Classification (IPC).

1. Does your Office presently classify national applications according to the IPC?

2. If your Office presently classifies applications according to classification systems other than or in addition to the IPC, briefly indicate which classification system is (systems are) used.

B. Citations - PCT Rule 43.5 provides that the international search report shall contain citations of relevant and particularly relevant documents or parts thereof. Citations which are not relevant to all the claims shall be cited in relation to the claim or claims to which they are relevant.

1. Does your Office presently, in citing documents in its search reports:

- (a) make a special distinction in respect of those documents which are considered of particular relevance?
- (b) make references to parts of the cited documents where only those parts are relevant or of particular relevance?
- (c) distinguish whether any cited document relates either to all claims or to particular claims?

2. Does your Office automatically furnish, or does it provide on request, copies of the documents cited in the search report?

C. Fields Searched - PCT Rule 43.6(a) provides that the international search report shall list the classification identification of the fields searched. PCT Rule 43.6(b) provides that, if the international search extended to documents of States, periods, or languages not included in the PCT Rule 34 minimum documentation, the international search report shall, when practicable, identify the kinds of documents, the States, the periods, and the languages to which it extended.

Annex to Circular No. 2133

Page 5

1. Does your Office presently indicate in its search reports the classification identification of the fields searched?
2. Does your Office provide in its search reports the following information for any given application searched:
 - (a) kind of documents searched (patents, inventors' certificates, etc.)?
 - (b) country of origin of documents searched?
 - (c) range of years of documents searched?
 - (d) languages of documents searched?

[End of Questionnaire]

[Annex B follows/
l'Annexe B suit]

Wien, am April 25, 1975
1., Kohlmarkt 9-10
Postanschrift: Postfach 95, A-1014 Wien

Zu GR 230/75

25. April 1975

GR 230/75

Mr.
Klaus P f a n n e r
Deputy Director General
WIPO
Geneva

Ref.: C.2133 PCT 21; Current Search Practices

Dear Mister Pfanner,

I have the honour to send you enclosed the
reply to your questionnaire concerning current
search practices.

Yours sincerely



(Dr. Leberl)

Enclosure

QUESTIONNAIRE ON CURRENT SEARCHING PRACTICES

Reply of Austria

Introductory Note

The answers are based on the following con-
siderations:

The search performed by the Austrian Patent Office
is an integral part of the examination procedure. A so-
called "isolated-search-report" is not established. The
search report issued under section 57 of the Austrian
Patent Act is not included in the replies as it does not
form part of the examination procedure.

I. Procedural Checks of Requirements of an Application

Prior to Search

A. Subject Matter

1. Does your Office presently search national applica-
tions relating to any of the subject matters in-
dicated in Rule 39?

YES

2. If the answer to the above question is "yes",
briefly indicate those subject matters indicated
in Rule 39 which are searched.

According to case law and literature diagnos-
tic methods are not excluded from patent pro-
tection and therefore subject to search.

B. Meaningful Search

1. Does your national law prescribe requirements for
the description, claims or drawings, in the nature
of PCT Articles 5, 6 and 7, respectively, which
have to be complied with in order that a meaning-
ful search may be effected?

YES

2. If your national law prescribes such requirements, briefly state the substance of the requirements.

The requirements of the Austrian Patent Law are the following:

"The description shall:

- (i) describe the invention in a manner sufficiently clear, distinct and complete for the invention to be carried out by persons skilled in the art;
- (ii) at the end of the description, emphasize precisely and distinctly what is new - thus constituting the subject of the patent - in one or more claims;
- (iii) contain the drawings necessary for the carrying out of the invention. The drawings shall be of a durable nature and be accompanied, where necessary, by models and samples." (Sec 91 par 1 of the Austrian Patent Law)

C. Unity of Invention

1. Does your Office presently apply a unity of invention requirement to national applications?

YES

2. If the answer to the above question is "yes", does your Office, where it finds that an application lacks unity of invention, automatically, that is, before any further correspondence with the applicant is undertaken, proceed to select the particular invention (for example, the "main invention") to be searched?

YES

3. If the answer to question 2 is also "yes", briefly state the basis on which the particular invention is selected (for example, the invention first mentioned in the claims).

In principle the invention first mentioned in the claims is subject to search.

4. If your Office applies a unity of invention requirement, which of the following procedural options are available to an applicant failing to meet such requirements:
 - (a) payment of additional fees?
 - (b) restriction of the invention?

The applicant has to restrict his invention (option b).

D. Title and Abstract

1. Does your Office presently require that a national application contain the following elements:
 - (a) a title?
 - (b) an abstract?

Title is required, no abstract (a).

2. Does your Office presently engage in establishing titles and/or abstracts (and, if so, which) when those elements are?
 - (a) missing in the national application?
 - (b) contained in the national application, but are defective in that they do not meet the requirements of the national law?

NO.

The applicant has to establish the title containing a brief designation of the invention. The title has to be fully supported by the description. This requirement is checked by the examiner during the granting procedure. The Office, however, does not establish missing or defective titles.

II. Search

A. Objective of the Search

- 1. Is the discovery of worldwide prior art documents (everything which has been made available to the public anywhere in the world) an objective of the searches your Office presently performs?

YES

- 2. Do the searches your Office presently performs attempt to discover prior art documents relevant to the criterion referred to above of:

- (a) novelty?
- (b) inventive step?

The criteria of both novelty and inventive step are applied (a + b).

B. Field of Search

- 1. Do the searches your Office presently performs extend to fields:

- (a) of analogous art to the extent that that art is regarded to be analogous in the light of what appears to be the necessary essential function or use of the invention and not only specific functions expressly indicated in the application?

YES

- (b) embracing all subject matter that is generally recognized as equivalent to the subject matter of the claimed invention for all or certain of its features?

YES

C. Orientation of the Search

- 1. Do the claims in the national application primarily serve as the basis for the searches your Office presently performs?

YES. The search is based on the claims with due regard to the description.

- 2. Are the criteria of your national law for the orientation of the search similar to those of the PCT?

The search of the Austrian Patent Office is part of the examination procedure. At present no so-called "isolated search" is performed. However, the orientation of the search in principle is similar to the PCT-search.

III. Preparation of the Search Report

A. Classification

- 1. Does your Office presently classify national applications according to the IPC?

When the applications is laid open for public inspection the IPC classification is applied up to the finest subdivision as subsidiary classification.

- 2. If your Office presently classifies applications according to classification systems other than or in addition to the IPC, briefly indicate which classification system is (systems are) used.

A national (Austrian) classification system is applied as principal classification.

B. Citations

- 1. Does your Office presently, in citing documents in its search reports:

- (a) make a special distinction in respect of those documents which are considered of particular relevance?

The answer is in principle YES. However, this question is not pertinent to searches performed as part of an examination procedure. As the search under the Austrian Patent Act is an "integrated" search and no "isolated" one only the following comments can be made:

There is no specific rule. However, as in ordinary cases the first action of the examiner has to contain a statement on the patentability of the in-

vention the main documents are referred to as such in the rationale of the first action.

- (b) make references to parts of the cited documents where only those parts are relevant or of particular relevance?

YES

- (c) distinguish whether any cited document relates either to all claims or to particular claims?

YES

2. Does your Office automatically furnish, or does it provide on request, copies of the documents cited in the search report?

Copies can be obtained upon request as part of a general copy service.

C. Fields Searched

1. Does Your Office presently indicate in its search reports the classification identification of the fields searched?

2. NO.

2. Does your Office provide in its search reports the following information for any given application searched:

- (a) kind of documents searched (patents, inventors' certificates, etc.)?
(b) country of origin of documents searched?
(c) range of years of documents searched?
(d) languages of documents searched?

(a) to (d): NO.

-.-.-

Dr. Arpad Bogsch
Director General
World Intellectual Property
Organization (WIPO)
32, chemin des Colombettes
CH - 1211 Genéve 20

Re: Answer to Questionnaire on Current Search Practices
Ref.: Circular No. 2133 dated February 28, 1975
Encl.: - 1 -

Dear Mr. Bogsch,

In the following please find the answers to the questions contained in the above mentioned questionnaire. In this connection it appears advisable to me to refer also to the report by the German Patent Office on the setting up of "isolated searches" as reproduced in document PCT/TCO/SS/III/12 Annex 1.

Answers to the individual items of the questionnaire:

- I. A. 1.: No
2.: -
I. B. 1.: Article 26 of the German Patent Law contains only basic concepts in respect to the requirements of patent applications. In addition thereto there have been issued Regulations for Patent Applica-

tions containing the requirements regarding the description in Section 3, regarding the patent claims in Section 3a and in respect to the drawings in Section 4.

2.: Sections 3, 3a and 4 of the Regulations for Patent Applications are reproduced in the annex.

- I. C. 1.: Yes
2.: No. If it is ascertained by the preliminary examination division in the course of the examination as to obviousness that the patent application is lacking uniformity, the applicant is requested to eliminate the non-uniform part and to continue that part in a divisional application. Then a separate search request may be filed for each of these applications. If, however, lack of uniformity is ascertained only during the search procedure, the search will be carried out for all inventions contained in the patent application.

3.: -

4.: The applicant has to divide the originally filed non-uniform application into the parent application and the divisional application. Separate search requests have to be filed for each of these independent applications and the respective fees have to be paid.

- I. D. 1. (a): Yes
2.: Corresponds to the title of the invention not to the formal requirements, thus the preliminary examination division is requesting the applicant to remedy this defect. For economical reasons the

preliminary examination division will, if possible, already propose a title to the applicant to which he will then merely have to agree.

II. A. 1.: Yes. However, not including written disclosures published after the application date, referring to an oral disclosure, a use, an exhibition or other measures and the date on which the oral disclosure had been made available to the public is prior to the application date.

2.(a): Yes
(b): Yes

II.B.1.
(a)(b): Yes. However, for economical reasons, the examiner decides in practice on the basis of the search results so far obtained to what extent the search will have to be extended to similar technical fields and which objects considered to be equivalent to the subject matter of the invention claimed, will have to be included into the search.

II. A. 1.: Yes
2.: Yes. However, the criteria are not contained in the German Patent Law but in the Guidelines for the Examination of Patent Applications (Richtlinien für die Prüfung von Patentanmeldungen) which have been issued in addition thereto.

3.: -

III.A.1.: Yes
2.: No, an additional classification system is not used.

III.B.1.(a): No

(b): Yes, by indication of the page, column and the line or the illustrations.

(c): Yes, by the indication of the patent claims, to which the documents mentioned refer.

III. B. 2.: Against payment of a fee the applicant may obtain, upon special request, copies of the documents mentioned in the search report.

III.C.1.: Yes
2.(a): No
(b): Yes
(c): No
(d): No

I do hope that the answers to this questionnaire have afforded you a further insight into the procedure followed by the German Patent Office in the setting up of "isolated searches" and that it will be of some use to the further work within the framework of PCT.

Sincerely yours,


Haertel

[Annex D follows/
l'Annexe D suit]

PATENT OFFICE
JAPANESE GOVERNMENT

4-3, Kasumigaseki 3-chome
Chiyoda-ku, Tokyo, Japan

POHU 80 561/50
May 23, 1975


Dr. A. Bogsch
Director General
World Intellectual Property Organization
32, chemin des Colombettes
1211 Geneva 20, Switzerland

Dear Sir:

Please find enclosed our answer to the Questionnaire on Current Searching Practices, attached to Circular 2133 PCT 21 dated Feb. 23, 1975.

The questions are listed on the left column by their number, and the corresponding answer on the right.

Yours truly,


Hideo Saito
Director General

- I A 1 Yes
- I A 2 All subject matters in PCT Rule 39 (ii); and the treatment and diagnosis of animal body in (iv).
- I B 1 Yes
- I B 2 By Japanese Patent Law Art. 36, Enforcement Regulations Art. 24 and Art. 25, it is required to mention (1) the title of the invention, (2) a brief explanation of drawings, (3) a detailed explanation of the invention and (4) the claim or claims. For the brief explanation of drawings, it should be mentioned whether a drawing presents a plane, a solid or a crosssectional view; also explanatory notes for symbols, etc. The detailed explanation of the invention includes the purpose, constitution and effect of the invention in such a matter so that it may be easily worked by a person having ordinary skill in the art to which the invention pertains. The claim or claims states only the indispensable constituent features of the invention as described in the detailed explanation.
- I C 1 Yes
- I C 2 No
- I C 3. Not applicable
- I C 4 (b) Restriction of the invention. A notice is sent to the applicant notifying him the ground for rejection. Japanese Patent Law Act. 38 stipulates for one invention in one application, as a rule.
- I D 1 (a) Yes
(b) No
- I D 2 No

II A 1 Yes
II A 2 (a) Yes
II A 2 (b) Yes
II B 1 (a) Yes
(b) Yes
II C 1 Yes
II C 2 Yes
II C 3 Not applicable

III A 1 Yes
III A 2 Japanese Patent Classification
III B 1(a) Yes
(b) Yes
(c) Yes
III B 2 Yes, our Office provides such copies on request
III C 1 No
III C 2(a) No
(b) No
(c) No
(d) No

Note : It appears that your questions were asked assuming that the isolated search is being conducted. But in Japan, we do not perform search on the above system of isolated search, and therefore, our answer for the questionnaire is based on our current method for finding a ground for rejection.

[Annex E follows/
l'Annexe E suit]

ГОСУДАРСТВЕННЫЙ КОМИТЕТ СОВЕТА МИНИСТРОВ СССР
ПО ДЕЛАМ ИЗОБРЕТЕНИЙ И ОТКРЫТИЙ

State Committee for Inventions and Discoveries
of the USSR Council of Ministers

Comité d'Etat du Conseil des Ministres de l'URSS
pour les inventions et les découvertes

Staatliches Komitee des Ministerrates der UdSSR
für Erfindungen und Entdeckungen

Address: USSR
Moscow, Centre
M. Cherkassky per. 2/6
Tel. 221-49-76
221-62-24
Telex: msk 7248

I4/II-504/45

23.IV.75г.

ЗАМЕСТИТЕЛЮ ГЕНЕРАЛЬНОГО
ДИРЕКТОРА ВОИС

г-ну К.ПФАННЕРУ

Женева
Швейцария

Глубокоуважаемый господин Пфаннер,

Направляю Вам ответы Государственного комитета Совета
Министров СССР по делам изобретений и открытий на вопросы,
содержащиеся в Ваших циркулярах № 2133 и 2136.

С уважением



Л. КОМАРОВ

Заместитель председателя
Госкомитета

Responses of the State Committee
for Inventions and Discoveries
of the USSR Council of Ministers
to the Questionnaire on current
searching practices.

Re C.2133
PCT 21

I. Procedural Checks of Requirements of an Application Prior
to Search.

- A.1. - yes.
- A.2. - methods for treatment of the human or animal body
by surgery or therapy, as well as diagnostic me-
thods.
- B.1. - yes.
- B.2. - the description of the invention must state the
purpose of the invention and must describe the
invention in detail, including its distinctive
features; it should also contain data on the
technical and economic effectiveness of the uti-
lization of the invention, the fields of techno-
logy to which the invention relates and where the
invention can be utilized, and the claims of the
invention.

The invention must be disclosed in the descrip-
tion, drawings, diagrams and other graphic mate-
rials with sufficient comprehensiveness and cla-
rity as to show its novelty and essential distin-
ctions and to make it possible to utilize the in-
vention.

PCT/TCO/V/7
Annex E/Annexe E

The description of a substance produced by a chemical process must also contain data on its chemical structure and physical and chemical properties, disclose the method (or methods) of producing it and indicate its field of application.

The description of the invention must end with its claims, which shall be the only criteria for defining the scope of the invention and shall be in the form of a briefly-worded statement indicating the essence of the invention from a technical viewpoint. In the claims, a device shall be characterized by reference to the features of its design, a process - by reference to a certain sequence of actions (methods, and operations with the help of material objects), and a substance - by reference to its ingredients and their quantitative ratios.

- C.1. - yes
- C.2. - no
- C.3. - -
- C.4(a) - no
- C.4(b) - yes (the applicant has the right to divide the application).
- D.1.(a) - yes.

- D.1.(b) - no.
- D.2.(a) - no (the application is not accepted in this case).
- D.2.(b) - yes.

II. Search.

- A.1. - yes.
- A.2.(a)- Yes.
- A.2.(b)- yes (analogous criterium is "essential distinctions").
- B.1.(a)- yes (if no anticipatory references found in the result of search in the art in which the invention is classified)
- B.1.(b)- yes (if no anticipatory references found in the analogous art)
- C.1. - yes.
- C.2. - yes.

III. Preparation of the Search Report.

(General notes: at present the Search Report is put only in the file of the application, but Official communications with the Applicant cite only the nearest references from the Search Report.)

- A.1. - yes.
- A.2. - no.
- B.1.(a)- yes. (see general notes)
- B.1.(b)- yes.
- B.1.(c)- yes.
- B.2. - on request.
- C.1. - yes (according to the official classification systems, which indexes are published

according to the patents).

C.2.(a)- no.

C.2.(b)- yes.

C.2.(c)- yes.

C.2.(d)- no.

Response of the State Committee for Inventions and Discoveries of the USSR Council of Ministers concerning the indication of any significant gaps in documentation collection.

Re C.2136
PCT 21

The documentation collection of the State Committee for Inventions and Discoveries of the USSR Council of Ministers presently has not any significant gaps in respect of the patent documents required to be included in the minimum documentation under PCT Rule 34.1(c)(i) to (v).

PCT/TCO/V/7
Annex E/Annexe E
page 3

[Annex F follows/
L'annexe F suit]

1975-04-29

Mr K. Pfanner
Deputy Director General
WIPO
32 chemin des Colombettes
1211 Genève 20

Your ref.: circular no. 2133
Subject: PCT questionnaire

Dear Mr. Pfanner,

Please find enclosed the replies from the SW Patent Office to the questionnaire annexed to the abovementioned circular of 1975-02-28.

The replies refer to the present situation but it should be pointed out that proposals for amendments of the patent law and decree have been worked out in Nordic cooperation and work is presently underway in formulating amendments to the Patent Office regulations. All these proposals for amendments aim at harmonization between the Swedish law, decree and regulations and the PCT articles and rules.

Yours sincerely


Lars Björklund

I.

- A.
- 1) Yes
 - 2) Diagnostic methods and computer programs to a certain extent.
- B.
- 1) Yes
 - 2) The description and claims shall be in the Swedish language.
The description must be sufficiently clear to enable the invention to be carried out by a person skilled in the art.
The application shall contain an explicit statement of what is sought to be protected by the patent (i.e. claims).
- C.
- 1) Yes
 - 2) Yes often but not always
 - 3) No general answer can be given. However in most cases a study of the description forms the basis for determining what is the "main invention".
 - 4) The application has to be restricted to one invention or a group of inventions covered by a single inventive concept. However the deleted invention(s) can form the basis for a divisional application for which an application fee has to be paid. This fee covers generally speaking the costs of the search.
- D.
- 1) a) Yes
b) No
 - 2) Yes both a) and b)

PCT/TCO/V/7
Annex F/Annexe F

II.

- A.
- 1) Yes
 - 2) Both
- B.
- 1) a) Yes
b) Yes
- C.
- 1) Not necessarily
 - 2) Yes
 - 3) The claims have to be searched, but if they are not representative of the invention this - as understood from the description - must also be searched.

III.

A.

- 1) Yes
- 2) -

B.

- 1) a) The question is irrelevant since the documents cited are not contained in any separate list but included in the official action (search and examination report).
 - b) Yes
 - c) Yes
- 2) If requested, copies are furnished by a copying service which charges a fee to cover its costs.

C.

- 1) No
- 2)
 - a) No
 - b) No
 - c) No
 - d) No

[Annex G follows/
l'Annexe G suit]

APR 28 1975



U.S. DEPARTMENT OF COMMERCE
Patent Office

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

Mr. Klaus Pfanner
Deputy Director General
World Intellectual Property
Organization
32 chemin des Colombettes
Geneva, Switzerland

Dear Mr. Pfanner:

This is in response to the Annex to Circular No. 2133 Questionnaire on Current Search Practices.

I. As to procedural checks of requirements of an application prior to search.

A. Subject matter

1. Yes
2. Plants produced asexually, methods for treating the human body and diagnostic methods United States patent classes 128 and 424, and computer programs but not patentability per se.

B. Meaningful Search

1. Yes
2. 35 USC 112 and 35 USC 113. (Similar to PCT Articles 5, 6 and 7)

C. Unity of Invention

1. Yes
2. No
3. Not applicable
4. (a) No, not in the same application
(b) Yes

D. Title and Abstract

1. (a) Yes 37 CFR 1.72
(b) Yes
- 2 (a) Yes
(b) Yes

Mr. Klaus Pfanner

- 2 -

2. (a) Title Yes but an abstract No
(b) Yes for both title and abstract

II. As to a search

A. Objection of the Search

1. Yes
2. (a) Yes
(b) Yes

B. Field of Search

1. (a) Yes
(b) Yes

C. Orientation of the Search

1. Yes
2. Yes
3. Not applicable

Before answering the questions in Part III of this questionnaire attention is directed to the fact that the U.S. Patent and Trade-mark Office does not issue a separate search report. We employ a combination patentability report and reference cited sheet to form an Office action. For the purpose of answering questions in Part III, the Office action is considered to be the Search report.

III. As to the preparation of the search report

A. Classification

1. Only to the extent that the IPC is printed on the patent.
2. U.S. patent classification system

B. Citations

1. (a) Yes
(b) Yes
(c) Yes

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2. Yes, one copy of each cited document.

C. Fields Searched

1. No, but it is included in the printed patent and in the application file. However, class and subclass of the cited documents is listed on the reference cited sheet of the Office action. Plans are now being made to include the fields searched in the Office action.
2. (a) No
(b) No
(c) No
(d) No

Note: Even though the specific answers to question 2 as worded are No, the various kinds of documents and foreign patents are classified according to class and subclass. These documents and foreign patents are placed in the appropriate U.S. class and subclass under the headings of literature and foreign patents respectively. When the U.S. class and subclass is searched, the literature and foreign patents are also searched. Accordingly, for search purposes everything including the materials listed in 2 would be searched in the U.S. classes and subclasses. The language of the documents is not pertinent since we consider documents in any language. The range of years is not pertinent since any document in the subclass from the oldest available date to the current date is considered.

It is hoped that these answers will provide the necessary insight as to searching practices now being employed by the U.S. Patent and Trademark Office. If further information is required after reviewing the above answers please feel free to contact me regarding the same.

Sincerely,



C. Marshall Dann
Commissioner of Patents
& Trademarks



INSTITUT INTERNATIONAL DES BREVETS

I.

ÉLÉPHONE: 906789
DRESSE TÉLÉGRAPHIQUE: BREVYPATENT
ÉLEX N° 31651
DRESSE: PATENTLAAN 2 RIJSWIJK (Z.H.) (PAYS-BAS)

Mr. K. PFANNER,
Deputy Director General,
World International Property
Organization;
32, Chemin des Colombettes,
1211-GENEVE 20-SWITZERLAND.

JVV/MB.

RIJSWIJK (Z.H.), le 7.5.1975.

Re: QUESTIONNAIRE ON CURRENT SEARCH PRACTICES.

Dear Mr. Pfanner,

Please find annexed the I.I.B.'s reply to the questionnaire enclosed with your circular C 2133 of february 28, 1975.

We are of course prepared to supply any additional information which you might need.

Yours sincerely,

J.A.H. Van Voorthuizen.
Dep. Technical-Director.

Annex.

GENERAL REMARK.

The term "national applications" should be understood in our case as meaning "national applications from the CH., FR., NL. Offices, for which the search is carried out by the I.I.B."

QUESTION.

REPLY.

I A 1.)
2.)

Searches relating to subject matter indicated in Rule 39(i) and (iii) to (vi) are in principle carried out in as far as the existing documentation permits. However in practice this is done only for a few borderline cases.

I B 1.

The national laws of CH., FR. and NL. prescribe similar requirements.

2.

CH.: The description shall disclose the invention in such a manner that it can be carried out by a person skilled in the art. (Art. 50 CH. Patent law 1954).
The claim(s) shall define the invention (Art. 51).
An integrating part of the description is formed by the drawings required for its understanding. (Art. 49).

FR.: The claims define the scope of the protection sought. (Art. 13 FR. Patent Law 1968).

Drawings may if necessary complete the description. (Art. 13).

NL.: The description shall be of such a nature, that the invention can be understood and carried out by a person skilled in the art. (Art. 22B NL Patent Law 1963).

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Annex H/Annexe H

QUESTION.	REPLY.
	NL.: The <u>claims</u> shall define the matter for which exclusive rights are sought. (Art.22A). The description shall be accompanied by <u>drawings</u> if necessary. (Art.22B).
I C 1.	Yes, but objections of non-unity are only raised in the search-report if the scope of the search is affected, i.e. if the search would have to be extended to cover the non-unitary subject matter.
2.	Yes.
3.	The invention first mentioned in the claims.
4.	The search is completed for the other inventions at the request of the national office concerned and on payment of an additional fee.
I D 1a.	Yes.
1b.	FR:Yes; CH.,NL.:No.
2.	No.
II A 1.	Yes, in principle but within economical and practical limits.
2a.	Yes.
2b.	Yes.
II B 1a.	Yes.
1b.	Yes.
II C 1.	Yes.
2.	Yes.
3.	---

QUESTION.	REPLY.
III A 1.	The I.I.B. does not classify national applications. However, patent documents to be entered into the search files are classified for the greater part according to the I.P.C.
2.	The I.I.B. is in the process of going over from the old I.I.B./O.R. internal classification scheme (IdT) to the I.P.C. scheme.
III B 1a.	No.
1b.	Yes.
1c.	Yes.
2.	Copies of the documents cited are furnished automatically.
III C 1.	No.
2a.	No. The searches for all national applications
2b.	No. are performed according to the same guidelines
2c.	No. and in the documentation at the disposal of
2d.	No. the I.I.B..

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[End of Annexes]

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Annex H/Annexe H
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