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PATENT COOPERATION TREATY

INTERIM COMMITTEE FOR TECHNICAL COOPERATION

Fifth Session

Geneva, October 29 to November 3, 1975

STUDY OF THE QUESTIONS CONCERNING THE MEMBERS OF A PATENT FAMILY

PROGRESS REPORT

prepared by the International Bureau

1. At its fourth session held in Geneva in November 1974, the PCT Interim Committee for Technical Cooperation (hereinafter called the Interim Committee) adopted the following principles in respect of the members of a patent family :

- (i) PCT Rule 36.1(ii) does not require that all members of a patent family be physically present in the classified search files of the International Searching Authority;
- (ii) PCT Article 15(4) does not require that all documents disclosing the same relevant prior art (e.g. all members of a patent family) be discovered;
- (iii) PCT Rule 43.5(a) does not require that all documents disclosing the same relevant prior art (e.g. all members of a patent family) be cited.

2. The Interim Committee further agreed that the questions of which member or members of a patent family should, while preserving the principles referred to in the preceding paragraph, be included in the classified search files, and which should be cited in any particular international search report, should be examined later, at the latest in connection with the drawing up of guidelines on international search.

3. It is recalled that these decisions were expressly endorsed by each of the prospective International Searching Authorities present at the fourth session (Austria, Germany (Federal Republic of), Japan, Soviet Union, Sweden, United States of America, International Patent Institute) and were unanimously approved by the Interim Committee.

4. Since the question of guidelines for searching under the PCT will be considered at the forthcoming session of the Interim Committee (see document PCT/TCO/V/12), the Interim Committee might, at the same time, wish to reconsider and to decide the questions of which member or members of a patent family should be included in the search files and which should be cited in any particular international search report. A decision on these questions would appear to be necessary before finally establishing the guidelines for searching under the PCT.

5. In respect of the questions referred to in the preceding paragraph, the Interim Committee might consider the following solutions (either alternatively or in cumulation) :

- (i) inclusion and citation of the family member having the earliest publication date;
- (ii) inclusion and citation of the family member having the earliest filing date;
- (iii) inclusion and citation of the family member, or members, published in the language, or languages most practical for use by a particular International Searching Authority;
- (iv) inclusion and citation of the published family member with the widest scope of disclosure;
- (v) inclusion and citation of the family member, where re-publication occurred, which physically is the most condensed document;
- (vi) citation of the family member which has the most pertinent disclosure to the application under consideration.

6. The Interim Committee is invited to take note of this report, to consider the timeliness of taking a decision on the question of patent family members, and to provide its advice, if any, on further action to be undertaken by the International Bureau.

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