

WIPO



PCT/TCO/VI/13

ORIGINAL: English

DATE: October 27, 1976

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

PATENT COOPERATION TREATY

INTERIM COMMITTEE FOR TECHNICAL COOPERATION

Sixth Session

Geneva, November 3 to 8, 1976

ADDENDUM TO DOCUMENT PCT/TCO/VI/8

(GUIDELINES FOR INTERNATIONAL SEARCHES
TO BE CARRIED OUT UNDER THE PATENT
COOPERATION TREATY (PCT))

Comments received from the European Federation of Agents
of Industry in Industrial Property (FEMIPI)

The International Bureau has received the attached letter enclosing comments from the European Federation of Agents of Industry in Industrial Property (FEMIPI) concerning the Draft Guidelines for International Searches to be carried out under the Patent Cooperation Treaty as contained in document PCT/TCO/VI/8.

[Annex follows]

VIPS

Verband der Industrie-
patentanwälte in der Schweiz

ACBJS

Association des Conseils en
Brevets dans l'Industrie Suisse

Präsident: Dr. Felix A. Jenny
 Adresse: c/o CIBA-GEIGY AG
 Patentabteilung
 CH-4002 Basel / Schweiz
 Telephon: 061 / 36 50 65
 Telex: 62991
 Privat: Casinostrasse 4
 CH-4052 Basel / Schweiz
 Telephon: 061 / 35 72 53
 Postcheckkonto: 40-25879; Verband der
 Industriepatentanwälte
 in der Schweiz, Basel

Dr. K. Pfanner
 Deputy Director General
 World International Property
 Organisation
 32, Chemin des Colombettes
 1211 G e n è v e

Unser Zeichen: Jn/uh

Basel, October 21, 1976

Ihr Zeichen:

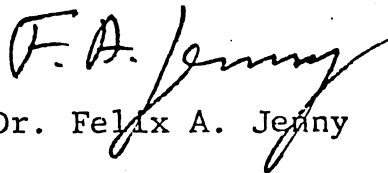
Dear Dr. Pfanner,

Please find enclosed the comments of FEMIPi on document PCT/TCO/VI/8 (Draft Guidelines for Searches to be carried out under the PCT).

Since it is felt that it will presumably for lack of time not be possible to discuss the Draft Guidelines in detail at the next session of the PCT-Interim Committees (November 1 to 8, 1976) at which I will represent FEMIPi, I thought it preferable to send you our comments in advance.

I hope that it will be possible for you to take the comments into consideration and remain

Yours truly,



Dr. Felix A. Jenny

Representative of the Fédération
Européenne des Mandataires de
l'Industrie en Propriété
Industrielle (FEMIPi) at the
1976 session of the PCT Interim
Committees.

Observations

on the draft guidelines for searches to be carried out under the Patent Cooperation Treaty (Document PCT/TCO/VI/8)

A. General, preliminary remarks

The International Bureau has prepared a modified version of the draft guidelines for searches to be carried out under the European Patent Convention (document CI/52/75 which had been reproduced as document PCT/TCO/V/12). The following comments are based on that version (document PCT/TCO/VI/8). As these documents do not contain Chapters IX and X, the comments on these two Chapters will have to be made later.

The following comments are offered as a response to the invitation of the Interim Committee for Technical Cooperation at its 5th session (Geneva, October 29 to November 3, 1975) to the interested circles to comment on the search guidelines (see document PCT/TCO/V/20, page 10, item 70 (iv)).

In drawing up the present Draft Guidelines a number of passages contained in the Guidelines for Searches to be carried out under the European Patent Convention, which did not seem to be compatible with the Treaty or the Regulations have correspondingly been amended or deleted in this entirety. Careful consideration should now be given to whether these deleted passages - possibly in amended form - ought not to be included again.

Only a reference to the corresponding articles or rules has been inserted into some passages. For easier comprehension of the Guidelines and to avoid having to consult the relevant Articles or Rules, these references should be replaced by the text of the entire Rules or the relevant portions thereof.

The Guidelines give the examiner in the International Searching Authorities a relatively large amount of freedom for interpretation and decision-making. This is natural since problems can differ widely depending on the field of technology concerned and, even within one specific field, they can vary quite considerably from one search to the other. Nevertheless applicants should be treated equally as far as possible when these guidelines are applied in practice.

The following comments concern the individual sections of the guidelines:

B. Comments on particular problems

(page and line numbers referred to are those of the Annex A to document PCT/TCO/VI/8)

1) Page 2; I 4

The PCT only has attractions for the applicant if the centrally made searches enable him to avoid additional searches (and thereby search fees - which offset the additional international fees) in the individual examination countries. The examining designated Offices will be most likely to waive the requirement for a supplemental search if the standard of examination in all international searching authorities is the same.

It is therefore suggested to replace the word "encouraged" by a stronger word, e.g. by the word -- bound -- used in the European Search Guidelines.

2) Page 2; I 5

For the sake of completeness line 2 of paragraph I 5 should be amended to read:

-- international searches and international type searches.--

3) Page 2; I 7 to 10

In order to give more information concerning the competence of the International Searching Authorities and other general questions, the following paragraphs should be inserted into Chapter I:

-- 7. Each international application is the subject of an international search. It is carried out by an International

Searching Authority, which may be either a national Office or an intergovernmental organisation (Articles 15 (1) and 16 (1)). The International Searching Authorities are appointed by the Assembly (Article 16 (3)) according to the principles laid down in the Treaty.

8. Where there are several International Searching Authorities, each receiving Office specifies the International Searching Authority or Authorities competent for the searching of international applications filed with that Office (Article 16 (2)).

9. When more than one International Authority is competent, the receiving Office declares whether all of them are competent for any international application filed with it, or one or more are competent for certain kinds of international applications filed with it and one or more others for other kinds of international applications filed with it. If for some kinds of application, or for all kinds, several International Searching Authorities are competent, the choice is left to applicant. The information on which International Searching Authorities are competent for international Applications filed with a given receiving Office is published by the International Bureau in the Gazette (Rule 35) as soon as such information has been transmitted by the receiving Offices.

10. For all International Searching Authorities the time limit for establishing the international search report or the declaration that no international search report can be established is months from the receipt of the search copy by the International Searching Authority or months from the priority date, whichever time limit expires later. (For a transitional period of 3 years from the entry into force of the Treaty, the said time limit may vary from one International Searching Authority to the other. According to the agreements concluded with the International Searching

Authorities the time limit varies from to).

4) Page 3; II 6

Since - as outlined under item 1) - supplemental searches by the designated Offices should be avoided to the greatest possible extent, it is suggested to delete the word "mainly" in line 4 of paragraph 6.

5) Page 5; III 1.1 and 1.2

The decision concerning novelty and inventive step is solely the responsibility of the designated Offices. If the Search Examiner has to form an opinion on these questions, he may not express this opinion and prejudice the decision by the designated Offices.

It is therefore suggested to amend lines 4 to 6 on page 5 as follows:

-- instances it may be necessary for the Search Examiner to form a personal opinion on these issues to enable an effective search to be carried out. Such --

[The last sentence is omitted in its entirety]

(cf. also item 9 of document PCT/TCO/V/12 (page 2)).

For the same reason, in line 2 of paragraph 1.2 "provisional" should be replaced by -- personal --.

6) Pages 5/6; III 2.1

At this point the examiner is urged to complete the search in such a way that the risk of overlooking something which is a vital part of the relevant state of the art is reduced to a minimum. A lower search rate is acceptable, on the other

hand, for less relevant elements of the state of the art. It must be noted, however, that a deficient inventive step is just as much a bar to a patent as a lack of novelty. The search should therefore be as complete as possible not only with respect to citations which help to assess novelty, but also with respect to those which help to assess the inventive step. Other parts of the guidelines also mention this (cf. e.g. page 3 (II.2); page 4 (III 1.1, first sentence) and especially page 7 (III 2.7, in fine). For the sake of clarity, it is therefore suggested to add the following reference to the end of point III 2.1:

-- (cf. in this context, however, also Chapter III 2.7 at the end) --

7) Page 6; III 2.2

For the sake of conciseness, it is suggested to amend lines 1 and 2 of paragraph 2.2 to read:

-- The International Searching Authority performing the international search --

and to amend line 6 of paragraph 2.2 to read:

-- Regulations (Article 15(4)). --

8) Page 6; III 2.3, and page 15; IV 3.2

Here the examiner is urged to consider only one member of a patent family as a rule.

Members of a patent family do not need to be identical but may differ considerably in content. In some cases, however, they only differ in details which cannot even be discovered without thorough and time-consuming study. It is precisely such details, however, that may be important for assessing the patentability of an application. If the Search Examiner encounters several members of a patent family during his search he should therefore quote all of them (and possibly specify them as members of the same patent family) but without making a special search for them. Quoting all the members of a patent family which

have been discovered instead of only quoting one does not really mean spending more time on this, but may help to avoid unpleasant surprises at a later date, e.g. when oppositions are filed.

The above-mentioned omission of a special search for other members of a patent family can, however, only be warranted if the material for examination has been compiled so that it contains as far as possible publications of applications or patents which have not been examined (in which the subject of the application usually covers the widest scope) and American continuation-in-part-applications (which may differ quite considerably from the other members of the same family).

It is therefore suggested to make the following amendments:

Page 6, lines 13 and 14 of paragraph 2.3 should read:

-- of technology in question began to develop. Likewise he need not make a special search for further members of a patent family --

Page 6, last line should read:

-- in the content of different members of the same family. If, however, he comes across several such members he should cite them. --

page 15, lines 6 to 8 of paragraph 3.2 should read:

-- a search file, the search examiner need not make a special search for all of them. If, however, he encounters them he should cite them in the international search report. In selecting from these documents for citation, the search examiner --

9) Page 9; III 3.7

This section requires the Search Examiner to assess whether a claim is "speculative" or not. However, at the search stage of the proceedings this cannot be assessed, since the applicant does not participate in the proceedings. The problem with an invention which is considered "speculative" by the examiner is usually not the deficient original disclosure of the invention, but the fact that the examiner does not believe the invention to be operable in the scope disclosed and claimed. In many cases, however, these doubts can be eliminated by arguments and or by the subsequent filing of additional examples at a later stage in the examination proceedings. The Search Examiner cannot, however, foresee the way in which the examination proceedings will develop. He cannot therefore judge whether an invention is "speculative". Furthermore, it is believed that the Examples given are irrelevant and therefore misleading. Accordingly they should be deleted.

It is therefore suggested to amend paragraph III 3.7 as follows:

-- 3.7 If the claims go far beyond that which is supported by the specification, a search into the novelty of the claims will nevertheless have to be made, but no special effort need be made in respect of their obviousness. --

[The remaining part of III 3.7 is omitted]

10) Pages 9 and 10; III 3.8 to 3.10

The US have suggested deleting the second part of III 3.8, the first sentence of III 3.9 and two and a half lines at the end of III 3.10 which were contained in the European Search Guidelines. In our opinion these passages should be retained.

We agree, however, to the deletion of the second sentence of III 3.9 of the European Search Guidelines and this for the

following reason.

Discontinuing the search owing to features which are "trivial or generally known in the art" seems a doubtful procedure, since this requires the Search Examiner to assess the invention in a manner reserved for the designated Office and since every anticipation must be proved by a reference. The search should only be discontinued if in actual fact the subject of the invention has been completely anticipated (i.e. the subject-matter of all the claims).

11) Page 11; III 4

For the sake of completeness the following new paragraph 4.1 should be inserted and the present paragraph 4.1 renumbered as 4.2.

-- 4.1 International Searches

The task of the International Searching Authority is primarily to carry out international searches and to draw up international search reports on international patent applications. --

In Paragraph 4.2 (previously 4.1), line 1 should be amended to read:

-- 4.2 International-type Searches

An International Searching Authority may also be --.

12) Page 13; IV 1.5

It is not clear why part of paragraph 1.5 of the European Search Guidelines has been deleted.

13) Page 13; IV 2.1

For the sake of clarity and to bring these Guidelines more into conformity with the rules, it is suggested to amend paragraph 2.1 as follows:

i) amend line 8 of 2.1 to read:

-- considerations relating to subject-matters which the International Searching Authority is not required to search --

ii) amend line 14 of 2.1 to read:

-- his search if such obscurities are cleared away during the search. If no search report can be established on these grounds by the International Searching Authority, the applicant and the International Bureau should be notified that no search report will be established. Any restrictions of the search on these grounds should be indicated in the search report (Article 18 (2)).--

14) Page 15; IV 2.8

α) Since, as has already been mentioned, only the designated Office is responsible for assessing novelty and the inventive step, page 15, lines 5 and 6 of paragraph 2.8 must be amended as follows:

-- when documents have been found clearly demonstrating lack of novelty in the entire subject-matter of the claimed --

β) Item 2.8 states that the Search Examiner should cease his investigations if it is absolutely clear from the documents which have been found that neither novelty nor inventive step are present in the entire subject-matter of the claimed invention or the embodiments contained in the specification. Something which seems "clear" to a Search Examiner may, however, at a later stage in the examination proceedings, when the applicant can file an argument - which he cannot do at the search stage - turn out to be no longer clear or even wrong. If the search is discontinued prematurely on these grounds, this should be mentioned in the search report, so that the designated Office knows that the Search has not been carried out completely if it emerges from the examination proceedings that this might be an invention after all.

It is therefore suggested to amend page 15, lines 9 to 15 of IV 2.8 to read:

-- field under consideration; in this event this must be mentioned in the search report. --

-) Page 15; IV 3.2 see item 8) above.

15) Page 16; IV 3.4

According to this provision the applicants are not notified of further relevant documents found by the Search Examiner. The applicant is, however, interested in knowing all the search results. Allowing all the results to be known helps to create clear legal situations in opposition and infringement proceedings and does not create much extra work for the International Bureau.

It is therefore suggested to amend the last line of item 3.4 on page 16 as follows:

-- International Bureau by means of an internal communication. The later discovered documents should be notified to the applicant by the International Bureau as soon as they become available. --

16) Page 17; V 2.2 and 2.4

Only something which is explicitly mentioned in a document or emerges inevitably from it is prejudicial to the novelty of an invention. Anything else, i.e.: something which can merely be derived from what has already been described, must refer to the inventive step.

The Example showing that the term "rubber" prejudices the novelty of "elastic material" demonstrates that a specific term prejudices the novelty of a generic term which is outlined in paragraph 2.4. Logically, therefore, the example mentioned under 2.2 should be mentioned in paragraph 2.4.

In addition, the example "rubber" is a poor one, since not every rubber (e.g. hard rubber) is (soft) elastic. In the art there is also a difference between "soft elastic" and "hard elastic". This example should therefore be replaced by a better example, e.g. "rivet/fastening means".

It is therefore suggested that sections V 2.2 and 2.4 be amended as follows:

Page 17, line 1 of paragraph 2.2, after "subject-matter" insert -- when it is --

Page 17, lines 3 to 6 of paragraph 2.2 should read:

-- in the light of common general knowledge, including any features that are the inevitable result of carrying out the teaching explicitly contained in the document by a person skilled in the art; anything which is merely derived from the document is not a criterion for assessing the question of novelty but that of inventive step. --

Page 17, line 4 of paragraph 2.4 should read:

-- does take away the novelty of any generic claim embracing that disclosure; for example, the disclosure of the use of a rivet is prejudicial to the novelty of a claim for the use of a fastening means (insofar as a rivet is not explicitly excluded from the patent claims), but not vice versa. --

17) Page 17; V 3.1

For the sake of completeness and in order to bring paragraph 3.1 into closer conformity with the Rules, it is suggested to amend it as follows:

i) page 17, line 1 of paragraph 3.1 should read:

-- 3.1 Rules 33.1 (a) and (b) recognise oral --

ii) page 17, line 4 of paragraph 3.1 should be amended to read:

-- the filing date of the international application under consideration. If the written disclosure was made available to the public on a date later than the international filing date,

the international search report shall separately mention this fact (Rule 33.1 (b)). --

18) Page 17; V 4.

It is not clear why the major part of subchapter 4 present in the European Search Guidelines has been deleted.

It is therefore suggested to amplify subchapter 4 and rewrite it as follows:

-- 4. Prior art, - Conflicting applications

4.1 There may also be published applications or patents whose publication date is later but whose filing date, or, where applicable, claimed priority date, is earlier than the international filing date of international application searched, and which would constitute relevant prior art had it been published prior to the international filing date (herein referred to as conflicting applications). Any of those which are present in the search files should be noted and specially mentioned in the international search report (PCT Rule 33.1 (c) and Section 508 (b) of the Administrative Instructions).

4.2 Since the International Search Authority will not verify the justification of the claimed priority dates, there may be uncertainty about which of the two applications is the earlier one. Therefore the search for conflicting applications should be extended so as to cover all published applications filed up to one year after the filing date of the application under consideration.

4.3 For the purposes of search for published conflicting applications the "whole contents" approach is to be applied, i.e. conflict is constituted not merely by the contents of the claims, but by the whole disclosure, i.e. description, drawings (if any) and claims (but not the abstract) of the published earlier application; however, subject-matter disclaimed or stated to belong to the prior art is excluded, unless it is explicitly disclosed.

4.4 Often, however, it will not be possible at the time of the search to make a complete search for conflicting applications. This search will therefore have to be completed at the examination stage by the designated Offices. --

19) Page 18; V 5.2

For the sake of clarity and with reference to the general aim of a search, paragraph 5.2 should begin:

-- The International Searching Authority will therefore also include documents --.

In line 11 of 5.2 the expression "equally relevant" should also be defined more precisely, e.g. by amending line 11 as follows:

-- where there are two documents where the passages relevant to the search are equivalent and one of which is published before --

If these points are different, both documents should be quoted since priority has not (yet) been recognised.

20) Page 19; V 6.2

It seems that the words "and cited" at the end of line 4 of paragraph 6.2 are inappropriate and should therefore be deleted.

In this section the Search Examiner is allowed to replace a previously published document with a subsequently published one "under certain circumstances provided there is justification for the assumption that there is identity of contents with another document which the Search Examiner has inspected". This provision can only be approved if it is interpreted strictly, i.e. the afore-mentioned "assumption" should only be admissible in the cases listed as examples i.e. for members of the same patent families or in documents which are explicitly designated as translations of prior publications.

It is therefore suggested to make the following amendments on page 19:

Lines 4 and 5 of 6.2 should read:

-- document which the search examiner has inspected. Thus, if instead of a document published before the international --

Lines 7 to 10 of 6.2 should read:

-- the Search Examiner has inspected a corresponding document in a more convenient language and possibly published after the international filing date, he is entitled to cite also the latter document, provided the two documents are members of the same patent family or one of them is an explicitly designated translation of the other. Also the International --

21) Page 19; V 6.3

Since in the first instance the onus of proof that a cited document is relevant is on the competent Patent Office, and in order to expedite prosecution, it is suggested to insert at the end of V 6.3:

-- In such a case an inofficial translation of the relevant parts is provided by the International Searching Authority. --

22) Page 21; VII 2.

For the sake of completeness it is suggested to make the following amendments to this paragraph:

i) line 3 of paragraph VII 2 should read:

-- the international search report. This invitation to pay additional fees must specify the reasons for which the international application is not considered as complying with the requirement of unity of invention and indicate the amount to be paid. The other invention(s) or --

ii) line 6 of paragraph VII 2 should be amended to read:

-- a period to be set by the International Searching Authority, which may not be shorter than 15 or 30 days, depending on whether the applicant's address is in the same country as or in a different country from that in which the International Searching Authority is located, and may not be longer than 45 days, from the date of the invitation to pay the fees --

23) Page 21; VII 6

It is not clear why letters (a) and (b) of paragraph 6 of Chapter VII contained in the European Search Guidelines have been totally deleted. It is therefore suggested to amend the last line of paragraph 6 (last line of page 21) to read as follows:

-- the grounds of lack of unity:

"(i) in addition to an independent claim for a given product, the inclusion in the same international application of one independent claim for one process specially adapted for the manufacture of the said product, and the inclusion in the same international application of one independent claim for one use of the said product, or

(ii) in addition to an independent claim for a given process, the inclusion in the same international application of one independent claim for one apparatus or means specifically designed for carrying out the said process." (Rule 13.2).

Other combinations may be acceptable provided there is a common inventive concept (PCT Rule 13). --

24) Page 23; VIII 3 (deleted from European Guidelines)

It is not clear why item 3 contained in the European Search Guidelines has been deleted. It should not have been deleted but brought into conformity with the PCT Rules.

It is therefore suggested to insert the following as item 3 and to renumber items 3 and 4 into 4 and 5 (as originally in the European Guidelines).

-- 3. Accordingly, it may be necessary for the Search Examiner to consider whether the claimed invention, wholly or in part, belongs to one of the following categories:

- (i) scientific and mathematical theories; or
- (ii) plant or animal varieties or essentially biological processes; or
- (iii) schemes, rules or methods of doing business, performing purely mental acts or playing games; or
- (iv) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised on the human or animal body. It should be noted, however, that products, in particular substances or compositions, for use in any of these methods, are not to be excluded from the search, provided the use of the product for any such method is not comprised in the state of the art; consequently after the search has discovered one such use, no further search is necessary to establish whether the exact use claimed is novel; or
- (v) mere presentations of information, or
- (vi) computer programs to the extent that the International Searching Authority is not equipped to search prior art concerning such programs. (PCT Rule 39.1) --

25) Page 23; chapters IX and X

Comments on chapter IX (International Search Documentation) and on chapter X (International Search Report) will have to be made later on since they have not yet been worked out.

26) Pages 34/35; XI 3

Paragraph 3 should be amplified to recite the relevant passages of Rule 8 and of the Guidelines for Preparation of Abstracts.

27) Page 35; XI 4

In order to show more clearly that the examiner in the Search Division should always make use of the authorisation mentioned in Rule 8.2 if a drawing other than that given by the applicants gives a better characterisation of the invention, line 4 of paragraph 4 the word "may" should be replaced by "should".