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

First draft

prepared by the International Bureau

Background to the Present Document

1. The PCT Interim Committee for Technical Cooperation (hereinafter referred to as "the Interim Committee"), at its fifth session, held in Geneva from October 29 to November 3, 1975, requested the International Bureau to prepare a draft of "Guidelines for Searches under the PCT" (hereinafter referred to as "the PCT Guidelines") for discussion at the next session of the Interim Committee.
2. The Interim Committee, at its fifth session, had before it "Draft Guidelines for Searches to be Carried Out under the European Patent Convention" of July 8, 1975 (hereinafter referred to as "the EPO Guidelines") (document PCT/TCO/V/12), as well as the EPO Guidelines as marked up by the United States Patent and Trademark Office with changes designed to enable the EPO Guidelines to be used as a draft of the PCT Guidelines (document PCT/TCO/V/14), and general observations concerning the use of the EPO Guidelines for the purpose of drafting PCT Guidelines provided by the State Committee for Inventions and Discoveries of the USSR Council of Ministers (document PCT/TCO/V/18). The EPO Guidelines were, at the time of the said fifth session, incomplete, Chapters X and XI thereof not having been completed.
3. The Interim Committee requested the International Bureau to prepare the draft PCT Guidelines on the basis of document PCT/TCO/V/14, as well as the final Guidelines to be established in the framework of the EPO and the observations to be received primarily from the Japanese Patent Office and the State Committee for Inventions and Discoveries of the USSR Council of Ministers (these being the two prospective International Searching Authorities not involved in the work being undertaken in relation to the EPO Guidelines in the framework of the EPO) on points on which their views differed from the proposals of the United States Patent and Trademark Office as contained in document PCT/TCO/V/14.
4. At the time of the preparation of the present document, work on the completion of the EPO Guidelines was still in progress. The EPO Guidelines submitted to the Interim Committee at its said fifth session have therefore been used in the preparation of the PCT Guidelines.

Contents of the Present Document

5. Annexed to the present document are:

- (i) the draft PCT Guidelines ("Draft Guidelines for International Searches to be Carried Out under the Patent Cooperation Treaty (PCT)")--Annex A;
- (ii) a comparative analysis of the proposals of the Japanese Patent Office, the State Committee for Inventions and Discoveries of the USSR Council of Ministers and the United States Patent and Trademark Office (hereinafter referred to as "the Authorities") where those proposals differ as to what should be provided in the PCT Guidelines--Annex B;
- (iii) copies of letters from the International Bureau to the Japanese Patent Office and the State Committee for Inventions and Discoveries of the USSR Council of Ministers, inviting comments in relation to the PCT Guidelines and the replies received--Annex C. The marked-up copy of the EPO Guidelines prepared by the United States Patent and Trademark Office, having been reproduced in document PCT/TCO/V/14 (see paragraph 2 above), is not included as such in Annex C. It is to be noted, however, that the said marked-up copy was further marked-up by the Japanese Patent Office for the purpose of presenting the proposals of that Office for the PCT Guidelines and appears in this form in Annex C.

Draft PCT Guidelines (Annex A)

6. The draft PCT Guidelines have been prepared mainly by amending the EPO Guidelines in accordance with the proposals of the Authorities. In the case where the proposed amendments were identical (or, in the case of one Authority which did not present its proposals in the form of a marked-up copy of the EPO Guidelines, where its response did not appear to require a change in the text proposed by the other two Authorities) no indication is given in the PCT Guidelines as to the changes made to the EPO Guidelines. Such changes may, nevertheless, be readily noted by simply referring to the marked-up copy of the EPO Guidelines contained in Annex C (see paragraph 5 above).

7. Chapters IX and X of the PCT Guidelines have still not been included pending the completion of the EPO Guidelines (see paragraph 2 above).

8. For the assistance of the Interim Committee, the following identification marks appear in the draft PCT Guidelines (Annex A):

- (i) Arrow accompanied by a number in the margin. This indicates each instance where the proposals by different Authorities appeared to present substantive differences, or where a question of substance warranting consideration by the Interim Committee appeared to be involved in the text. In each case, the number accompanying the arrow corresponds to the number of the relevant item in the comparative analysis (Annex B) of such proposals prepared by the International Bureau.
- (ii) Square Brackets. Where the Authorities proposed different wordings, whether by way of deletion from, or addition to, the EPO Guidelines, the different wordings have been placed within square brackets and the Authorities wishing to retain the text placed within square brackets have been indicated by means of a footnote. As mentioned above, where the different wordings appear to involve questions of substance, further identification by means of an arrow and number has also been included.
- (iii) Broken line beneath words. This indicates changes included by the International Bureau, generally being minor changes of a drafting nature in order to bring the language of the Guidelines into conformity with that of the PCT (e.g. "international search" instead of "search", etc.).

Comparative Analysis (Annex B)

9. The comparative analysis has been prepared in order to identify, for the assistance of the Interim Committee, the differences of substance in the proposals of the Authorities. Wherever appropriate, reference has been made to provisions of the PCT, the Regulations or the Administrative Instructions thereunder which, in the view of the International Bureau, may have to be taken into account in giving consideration to such differing proposals.

10. The Interim Committee is invited to consider the draft PCT Guidelines and to give its advice to the International Bureau so that the PCT Guidelines may be finally established.

[Annexes follow]

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

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CHAPTER I

INTRODUCTION

1. These Guidelines were elaborated by the PCT Interim Committee for Technical Cooperation as regards matters of common interest.
2. (Omitted by the International Bureau.)
3. The Guidelines constitute elaborations and clarifications of the provisions of the Treaty and the Regulations thereunder and their relevant Articles and Rules and Sections of the Administrative Instructions thereunder with respect to international search.
4. In order to ensure uniform practice the International Searching Authorities are encouraged to adhere to these Guidelines to the extent that they are not amended or revoked by the Committee for Technical Cooperation established under Article 56 of the Treaty.

Nevertheless, the application of the Guidelines to, and the interpretation thereof in respect of, individual international applications is the responsibility of the International Searching Authorities and it may be necessary for search examiners to depart from the general instructions given here in exceptional cases.

5. These Guidelines were drafted for, and apply to, international searches.
6. References to the relevant provisions of the Articles of the Treaty, Rules of the Regulations under the Treaty and sections of the Administrative Instructions under the Treaty are included in these Guidelines in the appropriate places.

CHAPTER II

GENERAL

1. The procedure through which an international application proceeds from the filing of the application to the granting of a patent (or the refusal thereof) comprises two clearly separated basic stages, i.e. the international search and the substantive examination by an international, regional or national office.

CHAPTER II (continued)

2. The objective of the international search is to discover the prior art which is relevant for the purpose of determining whether, and if so to what extent, the claimed invention to which the international application relates is or is not new and does or does not involve an inventive step, (PCT Art. 15(2), Rule 33.1(a)).
3. The international search is essentially a documentary search in a document collection that is properly [systematically]⁽¹⁾ arranged [(or otherwise systematically accessible)]⁽¹⁾ for search purposes according to the subject-matter contents of the documents [(PCT Rule 36.1 (ii))]⁽²⁾. These are primarily patent documents of various countries, supplemented by a number of articles from periodicals and other non-patent literature.
4. An international search report will be prepared containing the results of the international search, in particular by identifying the documents constituting the relevant prior art (PCT Art. 16(1), Rule 43.5).
5. The international search report serves to provide information on the relevant prior art to the applicant, to the public if the international application is published and to the designated Offices (PCT Art. 18(2), Art. 20(1)(a), Art. 21(3)).
6. Since the international search will be carried out and the international search report will be prepared by the International Searching Authorities and the examination will be carried out [mainly]⁽¹⁾ by the designated Offices, the separation of the two steps may be geographical as well as procedural.
7. In some instances there are no facilities for systematic searching by the designated Offices, other than for conflicting national applications. Some designated Offices may, therefore, be dependent on the work of the International Searching Authorities for their knowledge of the state of the art on which their assessments of the patentability of the

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CHAPTER II (continued)

invention will be based. The international search must, therefore, be as complete and effective as possible, within the limitations necessarily imposed by economic considerations (see Chapter III, paragraph 2).

8. In order to be able to inform the designated Offices of the documents necessary to decide on patentability, the search examiner must be familiar with the basic requirements of examination, especially with respect to novelty, inventive step, unity of invention, and subject-matter excluded from patentability either specifically or because of lack of industrial applicability (see Chapters V to VIII). On the other hand, a certain amount of feed-back to the International Searching Authority of the consequences of the international search, in particular the actions taken by the applicant and the designated Office as a result of the international search report, may be desirably necessary in order to obtain searches well adapted to the needs of the examination.
9. [The unit responsible for carrying out the international search and drawing up the international search report for an international application is the International Searching Authority]⁽¹⁾. [International search shall be carried out by an International Searching Authority]⁽²⁾. The international search itself will normally be performed by one search examiner. In exceptional cases, where the invention is of a nature requiring searching in widely dispersed specialised fields, a special search containing the work of two, or possibly three, search examiners may be necessary.

CHAPTER III

CHARACTERISTICS OF THE INTERNATIONAL SEARCH

1. The objective of the international search

1.1 As stated in Chapter II, paragraph 2, the objective of the international search is to discover relevant prior art for the purpose of assessing novelty and inventive

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CHAPTER III (continued)

② → [step. Decisions on novelty and inventive step are the province of the designated Offices. [However, in many instances provisional opinions on these issues must be formed by the search examiner in order to enable an effective international search to be carried out. Such provisional opinions will be subject to review by the designated Office at the examination stage.]⁽¹⁾

[Examples are to be found in Chapter III, paragraphs 3.9 - Search for subject-matter of dependent claims, 2.5 to 2.7 - Search in analogous art, Chapter IV, paragraph 2.8 - Stopping search when only trivial matter remains, Chapter VII, paragraph 9 - Lack of unity a posteriori.]⁽¹⁾

1.2 Occasionally the International Searching Authority will have to form provisional opinions on matters of substantive examination other than novelty or inventive step, in order to be able to proceed with the international search or to decide to restrict the search; here again these opinions are subject to review by the designated Office.

Examples are to be found in Chapter VII - Unity of invention and Chapter VIII - Subject-matter excluded from patentability and obscurities etc. preventing a meaningful search.

2. Scope of the international search

2.1 The international search is essentially a thorough, high quality, all-embracing search. Nevertheless, it must be realised that in a search of this kind, 100% completeness cannot always be obtained, because of such factors as the inevitable imperfections of any classification system and its implementation, and may not be economically justified if the cost is to be kept within reasonable bounds.

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CHAPTER III (continued)

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[If there are too many documents and it is impossible to study them within the time devoted to the search, the scope of the search may be reduced numerically but the reasons for this should be noted and should be annexed to the search report, since, if it is necessary, the decision may be taken to continue the search.]⁽³⁾

The search examiner should therefore organise his search effort and utilise his search time in such a manner as to reduce to a minimum the possibility of failing to discover existing highly relevant prior art, such as complete anticipations for any claims. For less relevant prior art, which often exists with a fair amount of redundancy amongst the documents in the search collection, a lower retrieval ratio can be accepted.

2.2 The PCT stipulates in Article 15(4) that the International Searching Authority performing the international search shall endeavour to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the PCT Regulations.

2.3 This implies first of all that the International Searching Authority in searching an international application will, in principle, consult all documents in the relevant classification units of the search files, irrespective of their language or age, or of the type of document. Nevertheless the search examiner should for reasons of economy exercise his judgment, based on his knowledge of the technology in question and of the documentation involved, to omit sections in which the likelihood of finding any documents relevant to the international search is negligible, for example documents falling within a period preceding the time when the area of technology in question began to develop. Similarly he need only consult one member of a patent family unless he has good reason to suppose that, in a particular case, there are relevant substantial differences in the content of different members of the same family.

CHAPTER III (continued)

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[2.4 All relevant patent documents included in the search files, should be consulted for international searches performed by an International Searching Authority.]⁽¹⁾

[2.5] The international search shall be carried out on the basis of the search files which may contain material pertinent to the invention (PCT Rule 33.2(a)). It should first cover all directly relevant technical fields, and may then have to be extended to analogous fields (PCT Rule 33.2(b)), but the need for this must be judged by the search examiner in each individual case, taking into account the scope of the search in the initial fields.

[2.6] The question of which arts are, in any given case, to be regarded as analogous shall be considered in the light of what appears to be the necessary function or use of the claimed invention and not only the specific functions expressly indicated in the international application (PCT Rule 33.2(c)).

[2.7] The decision to extend the international search to fields not mentioned in the international application must be left to the judgment of the search examiner, who should not put himself in the place of the inventor and try to imagine all the kinds of applications of the invention possible. The over-riding principle in determining the extension of the search in analogous fields should be whether it is possible that a reasonable objection that there is lack of inventive step could be established on the basis of what is likely to be found by the search in these fields.

3. The subject of the international search

3.1 The international search should be directed to the invention defined by the claims, as interpreted with due regard to the description and drawings (if any) and with particular emphasis on the inventive concept towards which the claims are directed (PCT Art. 15(3), Rule 33.3(a)).

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CHAPTER III (continued)

3.2 This implies that in the international search special emphasis should be directed to the inventive concept underlying the invention to which the claims are directed [in accordance with the contents of the international application]³ (PCT Rule 33.3(a)). Consequently the search should on the one hand not be restricted to the literal wording of the claims, but on the other hand should not be broadened to include everything that might be derived by a person skilled in the art from a consideration of the description and drawings.

3.3 As a consequence the international search should usually embrace also subject-matter that is generally recognised as equivalent to that which is specified in the claims. This applies to the claimed subject-matter as a whole, and also to its individual features even though, in its specifics, the invention as described is different (PCT Rule 33.2(d)). For example, if the claim specifies a cable clamp having a certain construction, the search should embrace pipe and similar clamps likely to have the specified construction. Likewise, if the claim is directed to an article consisting of several parts which are defined by their function and/or structure, and the claim stipulates that certain parts are welded together, the search should also embrace equivalent methods of connecting such as glueing or riveting, unless it is clear that welding possesses particular advantages required for the invention.

3.4 Since the applicant may not amend the claims before receiving the international search report except to correct formal matters which are contrary to the PCT and are called to applicant's attention by the receiving Office, (for example, Rule [9]⁽¹⁾ [9.2]⁽²⁾ and Rule [10]⁽¹⁾ [11]⁽²⁾ defects) the international search will be directed to the claims as originally filed.

3.5 Claims that are deemed to be drawn to inventions for which no fees have been paid must be excluded from the international search.

3.6 In principle, and in so far as possible and reasonable, the international search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been

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CHAPTER III (continued)

amended (PCT Rule 33.3(b)). For example, where an international application relating to an electric circuit contains one or more claims only directed to the function and manner of operation, and the description and drawings include an example with a detailed non-trivial transistor circuit, the search must necessarily include this circuit. Nevertheless, reasons of economy may make certain restrictions necessary, for example when there is a broad claim and many examples and it is not possible to foresee which will be the subject of amended claims.

3.7 No special search effort need be made for searching unduly wide or speculative claims, beyond the extent to which they are supported by the description. For example if in an international application relating to and describing in detail an automatic telephone exchange, the claims are directed to an automatic communication switching centre, the international search should not be extended to automatic telegraph exchanges, data switching centres etc., merely because of the broad wording of the claim. Likewise, if a claim is directed to a process for manufacturing an "impedance element" but the description and drawings relate only to the manufacture of a resistor element, and give no indication as to how other types of impedance elements could be manufactured by the process of the invention, extension of the search to embrace, say, manufacture of capacitors, would not normally be justified.

3.8 The international search carried out in the classification units of the search files to be consulted for the main claim(s) must include all dependent claims. Dependent claims should be interpreted as being restricted by all features of the claim(s) from which they depend. [Therefore, where the subject-matter of the main claim is novel, that of the dependent claims will also be novel. When the patentability of the main claim is not questioned as a result of the international search, there is no need to make a further search in respect of the subject-matter of the dependent claims as such. For example, in an international application relating to cathode ray oscilloscope tubes, in which the main claim is directed to specific means along the edge of the front of the tube for illuminating the screen, and a dependent claim is directed to a specific connection between the front and the main part of the tube, the search examiner should, in the search files he consults for searching the illumination means, also search for the connecting means whether

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CHAPTER III (continued)

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(contd)

in combination with the illumination means or not. When after this search the patentability of the illuminating means is not questioned, the examiner should not extend his search for the connecting means to further search files specifically provided for these connections.]⁽²⁾

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3.9 [However, where the patentability of the main claim is questioned, it may be necessary for assessing inventive step of a dependent claim to establish whether the features of the dependent claim as such are novel by searching one or more additional classification units. No such special search should be made for features that are trivial or generally known in the art.]⁽²⁾ When the dependent claim adds a further feature (rather than providing more detail of an element figuring already in the main claim), the dependent claim in effect constitutes a combination claim and should be dealt with accordingly (see Chapter III, paragraph 3.10).

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3.10 For claims characterised by a combination of elements (e.g. A, B and C) the international search should be directed towards the combination; however, when searching classification units for this purpose, sub-combinations, including the elements individually (e.g. AB, AC, BC and also A, B and C separately) should be searched in those units at the same time. A search in additional classification units either for subcombinations or for individual elements of the combination should only be performed if this is still necessary [for establishing the novelty of the element in order to assess the inventive step of the combination].⁽²⁾

3.11 When the application contains claims of different categories, these must be included in the international search, and even when the international application contains only claims of one category, it may be desirable to include other categories in the search. For example, generally, except when the international application contains indications to the contrary, one may assume that in a claim directed to a chemical process, the starting products form part of the state of the art and need not be searched; the intermediate products will only be searched when they form the subject of one or more claims; but the final products will always have to be searched, except when they are evidently known.

CHAPTER III (continued)

3.12 The search examiner should, in general, exclude from his international search subject-matters for which no meaningful search can be made; this may result from certain subject-matters being excluded from the search under PCT Rule 39, or from the international application being obscure (see Chapter VIII).

3.13 When the claims of the international application do not relate to one invention only, nor to a group of inventions so linked as to form a single general inventive concept and the required additional fees have not been paid within the prescribed time limit, the international search will normally be restricted to the invention, or so linked group of inventions, first mentioned in the claims (see Chapter VII). If the additional fees have been timely paid, all inventions covered thereby must also be searched.

3.14 In certain circumstances it may be desirable to extend the subject-matter of the international search to include the "technological background" of the invention (see Chapter IV, paragraph 2.4). This would include:

- the preamble to the first claim, i.e. the part preceding the expression "characterised by";
 - the prior state of the art which is deemed to be known in the introduction of the description of the international application but not identified by specific citations;
 - the general technological background of the invention (often called "general state of the art");
- ⑨ → [- the reference documents cited by the applicant.](³)

4. Types of searches

4.1 International-type searches

Under the PCT, an International Searching Authority may be entrusted to carry out "international-type searches" for national applications (PCT Article 15(5)). These searches are by definition similar to international searches, and the same considerations will apply.

CHAPTER IV

SEARCH PROCEDURE AND STRATEGY

1. Procedure prior to searching

1.1 When taking up an international application to be searched, the search examiner should first consider the application in order to determine the subject of the claimed invention taking account of the guidance given in Chapter III, paragraph 3. For this purpose he should make a critical analysis of the claims in the light of the description and drawings. Although he need not study all details of the description and drawings, he should consider these sufficiently to identify the problem underlying the invention, the insight leading to its solution, the means essential to the solution as particularly reflected in the technical features thereof found in the claims, and the results and effects obtained.

10 → 1.2 If the search examiner notices any formal shortcomings which have been over-looked by the receiving Office, he should call these to the attention of the receiving Office which will take the appropriate action. Similarly, if he notes matter contrary to "public order" or morality or disparaging statements which ought to be omitted from the international application as published, he should notify the applicant.

1.3 Documents cited in the international application under consideration should be examined if they are cited as the starting point of the invention, or as showing the state of the art, or as alternative solutions to the problem concerned, or when they are necessary for a correct understanding of the application; however, when such citations clearly relate only to details not directly relevant to the claimed invention, they may be disregarded. If the international application cites a document that is not published or otherwise not accessible to the International Searching Authority and the document appears essential to a correct understanding of the invention to the extent that a meaningful international search would not be possible without knowledge of the content of that document, the International Searching Authority may postpone the search and request the applicant to provide first a copy of the document, [if possible to do so within the time limits for the preparation of the international search report under the PCT.] (1) (2)

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CHAPTER IV (continued)

1.4 The search examiner should then consider the abstract in relation to the requirements (see Chapter XI). Since the abstract should relate to the international application as filed, the search examiner should consider it and determine its definitive content before carrying out the international search, in order to avoid being inadvertently influenced by the results of the search. However, if there are initial obscurities, which are cleared away in the course of the search, he may have to return to the abstract after the search is completed.

1.5 The search examiner will then classify the international application according to at least the International Patent Classification.

2. Search strategy

2.1 Having determined the subject of the invention, as outlined in Chapter IV, paragraph 1.1, it may be desirable for the search examiner to prepare first a written search statement, defining the subject of his search as precisely as possible. In many instances one or more of the claims may themselves serve this purpose, but they may have to be generalised in order to cover all aspects and embodiments of the invention. At this time the considerations relating to subject-matters excluded from patentability (see Chapter VIII), and lack of unity of inventions (see Chapter VII, paragraph 1) should be borne in mind. The search examiner may also have to restrict the subject of the international search because of obscurities (see Chapter VIII, paragraph 4); but he should not do this if it can be avoided and he should subsequently adjust his search if such obscurities are cleared away during the search.

12 → 2.2 Next the search examiner should select the units of the classification [(or other sections of the documentation)]⁽¹⁾ to be consulted for the international search, both in all directly relevant fields and in analogous fields.

2.3 Often various search strategies are possible, and the search examiner should exercise his judgment based on his experience and knowledge of the search files, to select the search strategy most appropriate to the case in hand, and establish the order in which various classification units are to be consulted accordingly. He should give precedence to the units in which the probability

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CHAPTER IV (continued)

of finding documents is highest. Usually the main technical field of the international application will be given precedence, starting with the classification units most relevant to the specific example(s) of the claimed invention.

2.4 The search examiner should then carry out the international search, directing his attention primarily to novelty, but also at the same time paying attention to any prior art likely to have a bearing on inventive step. He should also note any documents that may be of importance for other reasons, such as documents putting doubt upon the validity of any priority claimed, contributing to a better or more correct understanding of the claimed invention, or illustrating the technological background; but he should not spend time in searching for these documents, nor in the consideration of such matters unless there is a special reason for doing so in a particular case.

2.5 The search examiner should initially concentrate his search efforts on the classification units in which the probability of finding highly relevant documents is greatest. He should always take account of the search results already obtained in considering whether to extend the search to other areas.

2.6 The search examiner should continuously evaluate the results of his search, and if necessary reformulate the subjects of the international search accordingly. The selection of the classification units to be searched or the order of searching them may also require alteration during the search as a consequence of intermediate results obtained. The search examiner should also use his judgment, taking into account results obtained, in deciding at any time during or after the systematic search, whether he should approach the search documentation in some different manner, e.g. by consulting documents cited in the description of documents produced by the search or in a list of references of such documents, or whether he should turn to documentation outside that which is available in the search files.

2.7 If no documents of a more relevant nature for assessing novelty and inventive step are available, the search examiner should consider citing any documents relevant to the "technological background" of the invention (see Chapter III, paragraph 3.14), which he may have noted during the international search. Generally speaking no special search effort will be undertaken for this purpose; however, the search examiner may exercise his discretion

CHAPTER IV (continued)

here in special cases. In exceptional cases an international search may be completed without any relevant document having been found.

2.8 Reasons of economy dictate that the search examiner uses his judgment to end his search when the probability of discovering further relevant prior art becomes very low in relation to the effort needed. The international search may also be stopped when documents have been found clearly demonstrating lack of novelty or inventive step in the entire subject-matter of the claimed invention and its elaborations in the description, apart from features which are trivial or common general knowledge in the field under consideration. [All decisions taken by the search examiner during the international search relating to the restrictions on the scope of the search, as well as all temporary decisions concerning novelty, inventive step and industrial applicability of the claimed invention, should be noted by the search examiner and should be annexed to the international search report.]⁽³⁾

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3. Procedure after searching

3.1 After completion of the international search, the search examiner should select from the documents retrieved, the ones to be cited in the international search report. These should always include the most relevant documents (which will be specially characterised in the report, PCT Rule 43.5(c)). Less relevant documents should only be cited when they concern aspects or details of the claimed invention not found in the documents already selected for citation. In cases of doubt or borderline cases in relation to novelty or inventive step, the search examiner should readily make citations in order to give the designated Offices the opportunity to consider the matter more fully.

3.2 To avoid increasing costs unnecessarily; the search examiner should not cite more documents than is necessary, and therefore when there are several documents of equal relevance the international search report should not normally cite more than one of them. When more than one member of the same patent family is present in a search file, the international search need not discover all of them nor need the international search report cite all of them. In selecting from these documents for citation, the search examiner should pay regard to language convenience, and preferably cite (or at least note) documents in the language of the international

CHAPTER IV (continued)

14 → [application. [In particular, among patent family members, preference should be given to the document having the earliest date of publication.] (3)

3.3 Finally the search examiner should prepare the international search report (see Chapter X).

3.4 It may happen occasionally, that after completion of an international search report, the International Searching Authority discovers further relevant documents (e.g. in a later search for a related application). These should be added to the international search report up to the time that preparations for its publication are completed. Thereafter, such later discovered documents should be brought to the notice of the designated Office via the International Bureau by means of an internal communication.

CHAPTER V

THE STATE OF THE PRIOR ART

1. Prior art generally

1.1 A claimed invention shall be considered to be novel if it does not form part of the state of the prior art as defined in Article 33(2) and PCT Rule 33.

1.2 The state of the prior art shall be held to comprise everything made available to the public by means of a written or oral disclosure, by use, or in any other way, before the date of filing of the international application (PCT Rule 33.1(a) and (b)).

1.3 It is to be noted that there is no restriction whatever with respect to the geographical place where, or the language or manner in which, the relevant information was made available to the public; also no age limit is stipulated with respect to documents containing this information.

2. Novelty

2.1 In considering novelty, the documents constituting the state of the prior art should be considered separately; consequently it is not permissible to combine or mosaic separate documents together.

CHAPTER V (continued)

2.2 A document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document when considered in the light of common general knowledge, including any features implicit to a person skilled in the art in what is explicitly contained in the document, e.g. a disclosure of the use of rubber takes away the novelty of the use of an elastic material.

2.3 A prior document should be construed only in the light of knowledge available at the time the document was published, and excluding any knowledge subsequently discovered.

2.4 In considering novelty it should be borne in mind that a generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but that a specific disclosure does take away the novelty of any generic claim embracing that disclosure.

3. Prior art, - oral disclosure etc.

3.1 The PCT Regulations according to Rule 33.1 (a) and (b) recognise oral disclosure, use, exhibition, etc., as prior art only when this is substantiated by a written disclosure, which may have been published after the filing date of the international application under consideration.

4. Special category of documents to be cited in the international search report - conflicting applications.

4.1 Where the search examiner finds in the search files an application, or patent, published after the international filing date and having a claimed priority earlier than the international filing date of the international application searched, and which would constitute relevant prior art had it been published prior to the international filing date, the application, or patent, shall be specially mentioned in the international search report for information (PCT Rule 33.1(c) and Section 508(b) of the Administrative Instructions).*

5. Date of reference; filing and priority date

5.1 Since the International Searching Authority is not responsible for the verification of any claimed priority date (which in the examination stage takes the place of the filing

* This text, proposed by the International Bureau, would replace an amended version of the text of the EPO Guidelines proposed by two Authorities (JA, US). The amended version of the EPO Guidelines reads as follows:

"4. Prior art

4.1 There may also be applications coming within the "intervention period". Any of these which are present in the search files should be noted and mentioned in the search report for information (PCT Rule 33.1(c))."

CHAPTER V (continued)

date for assessing prior art and determining precedence), the basic reference date for the international search must be taken as the international filing date of the international application as accorded by the receiving Office (PCT Rule 33.1(a)).

5.2 The International Searching Authority will therefore include documents published between the priority date or dates and the filing date of the international application under consideration, and these must be identified as such in the international search report. For identifying these documents when an international application has more than one priority date, the oldest date is to be applied for this purpose. When deciding which documents to select for citing in the international search report, the search examiner will have to refer to these dates and should preferably choose any published before the date of priority. Thus for example, where there are two equally relevant documents one published before the date of priority and the other after that date but before the international filing date, he should choose the former (see Chapter IV, paragraph 3.2).

5.3 It is the responsibility of the designated Office to check whether and to what extent the priority claim is justified; therefore the International Searching Authority will not check whether the contents of the international application correspond to those of the priority application(s). [Nevertheless, documents showing that a priority claim might not be justified (e.g. an earlier application or patent resulting therefrom, by the same applicant indicating that the application from which priority is claimed may not be the first application for the invention concerned), should be drawn to the attention of the International Bureau. No special search beyond the filing date of the international application should normally be made for this purpose, except when there is a special reason to do so, e.g. when the priority application is a "continuation in part" of an earlier application from which no priority is claimed; also sometimes the country of residence of the applicant being different from the country of the priority application may be an indication of possible lack of first filing, justifying a certain extension of the international search].⁽¹⁾

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5.4 The international search will not normally take into consideration documents published after the international filing date of the international application. However, some extension may be necessary for specific purposes, as is apparent from Chapter V, paragraph 3 and Chapter V, paragraph 4.1.

(1) US

CHAPTER V (continued)

5.5 Certain other situations may occur in which a document published after the international filing date is relevant; examples are a later document containing the principle or theory underlying the invention, which may be useful for a better understanding of the invention, or a later document showing that the reasoning or the facts underlying the invention are incorrect. The international search should not be extended for this purpose, but documents of this nature known to the search examiner could be selected for citation in the international search report.

6. Contents of prior art disclosure

6.1 ~~As a general rule~~ the International Searching Authority will select for citation only documents which are present in its search files or which it has access to in some other manner; in that way no doubt will exist about the contents of the documents cited, since the search examiner will generally have physically inspected each document cited.

6.2 However, under certain circumstances a document whose contents have not been verified may be cited, provided there is justification for the assumption that there is identity of contents with another document which the search examiner has inspected and cited. For example, instead of the document published before the international filing date in an inconvenient language and selected for citation, the search examiner may have inspected a corresponding document (e.g. another member of the same patent family, or a translation of an article) in a more convenient language and possibly published after the international filing date; also the International Searching Authority may assume that, in the absence of explicit indications to the contrary, the contents of an abstract are contained in the original document. Also the search examiner should assume that the contents of a report of an oral disclosure are in agreement with that disclosure.

6.3 Before citing documents in a language with which he is not familiar, the search examiner should satisfy himself that the document is relevant (e.g. through translation by a colleague, through a corresponding document or abstract in a familiar language, through a drawing, or chemical formula in the document).

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CHAPTER V (continued)

7. Matters of doubt in the state of the art

7.1 Since decisions with respect to novelty are not the responsibility of the International Searching Authority but of the designated Offices, the International Searching Authorities should not discard documents because of doubt as regards for example the exact date of publication or public availability, or the exact contents of an oral disclosure, exhibition etc. to which such documents may refer. The International Searching Authority should try to remove whatever doubt may exist and should cite the documents concerned in the international search report unless the doubt is removed or very little doubt remains; additional documents providing evidence in the matters of doubt may be cited. Comments on these documents, as well as citation of documents for which greater doubt remains, should be made in the international search report citation page.

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CHAPTER VI

INVENTIVE STEP

1. An invention shall be considered as involving an inventive step if, having regard to the state of the art at the prescribed relevant date, it is not obvious to a person skilled in the art (PCT Art. 33(3)).
2. In evaluating inventive step the designated Office will have to consider this in relation to all aspects of the claimed invention, such as the underlying problem (whether explicitly stated in the international application or implied), the insight upon which the solution relies, the means constituting the solution, and the effect or results obtained. Therefore, the international search will take all these aspects into consideration.

CHAPTER VII

UNITY OF INVENTION

1. The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (PCT Rule 13.1). If the International Searching Authority considers that the international application does not comply with the requirement of unity of invention, it must search,

CHAPTER VII (continued)

and draw up the international search report for, those parts of the international application which relate to the invention (or group of inventions forming unity) first mentioned in the claims and those parts of the international application which relate to inventions for which additional fees have been paid (PCT Art. 17(3) (a)).

2. The International Searching Authority will inform the applicant of the lack of unity of invention in a communication separate from the international search report. The other invention(s) or group(s) of inventions will be searched only if the applicant pays the additional fees. These payments must take place within a period to be set by the International Searching Authority (PCT Art. 17(3) (a) and Rule 40.3).
3. The applicant may protest the allegation of lack of unity of invention or that the amount of the additional fee is excessive and request a refund of the additional fee(s) paid. If the International Searching Authority finds the protest justified the fee(s) will be refunded. (PCT Rule 40.2(c)).
4. From the preceding paragraph it is clear that the decision with respect to unity of invention rests with the International Searching Authority. In particular the International Searching Authority should not raise objection of lack of unity of invention merely because the inventions claimed are classified in separate classification units, or merely for the purpose of restricting the international search to certain classification units.
5. As indicated in Chapter VII, paragraph 1 the basic criterion for unity of invention is the presence of a [common]⁽¹⁾ [general]⁽²⁾ inventive concept. Consequently, the mere fact that an international application contains several independent claims of the same category or claims of different categories [related under PCT Rules 13.2 and 13.3]⁽¹⁾ is in itself no ground for objection of lack of unity of invention.
6. Rule 13 [2]⁽²⁾ particularly specifies certain combinations of different categories of claims that should not be objected to on the grounds of lack of unity.

(1) US

(2) JA

CHAPTER VII (continued)

7. Lack of unity of invention may also exist within a single claim. Where the claim contains alternatives which are not linked by a single general inventive concept, the objection as to lack of unity of invention should be raised.
8. Objection of lack of unity of invention does not normally arise because a claim contains a number of individual features in combination even if these are unrelated (see Chapter III, paragraph 3.10).
9. Lack of unity of invention may be directly evident "a priori", i.e. before considering the claims in relation to any prior art, or may only become apparent "a posteriori", i.e. after taking the prior art into consideration, e.g. a document discovered in the international search shows that there is lack of novelty in a main claim, leaving two or more dependent claims without a [common]⁽¹⁾ [general]⁽²⁾ inventive concept. In this case the International Searching Authority may raise the objection of lack of unity of invention and limit the search to the invention (or group of inventions) first mentioned in these dependent claims, if no additional search fee is paid.
10. Where the search examiner finds a situation of lack of unity of invention to exist, reasons of economy may make it advisable to search the additional invention(s) together with the invention mentioned first in the claims, in the classification units consulted for the latter invention if this takes little or no additional search effort. The international search for such additional invention(s) will then have to be completed in any further classification units which may be relevant.
11. Occasionally in cases of lack of unity of invention, especially "a posteriori", the search examiner will be able to make a complete international search for both or all inventions with negligible additional work, in particular when the inventions are conceptually very close and none of them requires search in separate classification units. In those cases, the international search for the additional invention(s) should be completed together with that for the invention first mentioned. All results should then be included in a [single]⁽¹⁾ search report, and no objection of lack of unity of invention should ordinarily be raised.

(1) US

(2) JA

CHAPTER VIII

SUBJECT-MATTERS TO BE EXCLUDED FOR THE INTERNATIONAL SEARCH

1. PCT Rule 39 specifies certain subject-matters which need not be searched.

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[The search files need not, and in many situations do not, contain such subject-matter, so that a meaningful international search therefor is not possible and a declaration to that effect takes the place of the search report (PCT Art. 17(2)(a)(i)).]⁽¹⁾

2. This situation may also occur for part of the claims, in which case a partial international search is made, and the partial international search report is then supplemented with a declaration.

3. In cases of doubt the International Searching Authority should carry out the international search to the extent that this is possible in the available documentation.

4. A further situation where a meaningful international search is not possible or only partially possible, and where a declaration to this effect may take the place of or supplement the international search report, may result from the international application containing obscurities, inconsistencies or contradictions to the extent that it is impossible to arrive at a reasonable conclusion as to the scope of the claimed invention. The International Searching Authority in these cases [may not suspend the search, ask for clarification, and after receipt thereof continue the search, but]⁽¹⁾ should make a meaningful search to the extent that this is possible. (PCT Art. 17(2)(a)(ii)).

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CHAPTER IX - INTERNATIONAL SEARCH DOCUMENTATION

to be included later (see PCT Rules 34 and 36)

CHAPTER X - INTERNATIONAL SEARCH REPORT

to be included later

CHAPTER A - B

EFFECT OF INTERNATIONAL SEARCH REPORT

- Y.1 After receipt of the international search report the applicant may amend the claims before the International Bureau (PCT Art. 19(1)). The amendments shall not go beyond the disclosure of the international application as filed (PCT Art. 19(2)).

CHAPTER XI

THE ABSTRACT

1. The search examiner has the task of determining the definite content of the abstract which is initially supplied by the applicant, and which will subsequently be published with the application or later. In doing this he should consider the abstract in relation to the application as filed (see Chapter IV, paragraph 1.4) (PCT Rule 38.2(b)). If the international application does not contain an abstract, the search examiner shall comply with PCT Rule 38.2(a).

2. In determining the definite content the search examiner should take into consideration that the abstract is merely for use as technical information, and in particular must not be used for the purpose of interpreting the scope of the protection sought. The abstract should be so drafted that it constitutes an efficient instrument for purposes of assisting the scientist, engineer or researcher in searching in the particular technical field, and should in particular make it possible to assess whether there is need for consulting the international application itself (PCT Rule 8.3).

3. The abstract must meet the requirements of PCT Rule 8 and of the Guidelines for Preparation of Abstracts (see document PCT/TCO/V/10).

4. The search examiner should consider not only the text of the abstract but also the selection of the figures for publication with it. He should alter the text to the extent that this may be necessary in order to meet the requirements set out in PCT Rule 8. He may select a different figure, or figures, of the drawings if he considers that they better characterise the invention and note it in the international search report (PCT Rule 8.2). In determining the definitive content of the abstract, the search examiner should concentrate on conciseness and clarity, and refrain from introducing alterations merely for the purpose of embellishing the language.

ANNEX B

COMPARATIVE ANALYSIS OF PROPOSALS CONCERNING THE DRAFT GUIDELINES FOR INTERNATIONAL SEARCHES TO BE CARRIED OUT UNDER THE PATENT COOPERATION TREATY (PCT) IN CASES WHERE THE PROPOSALS INVOLVE DIFFERENCES IN SUBSTANCE OR WHERE AN ADDITIONAL COMMENT IS MADE

This Annex sets out the responses received from the Patent Office of Japan (identified in this Annex by the code "JA"), the State Committee for Inventions and Discoveries of the USSR Council of Ministers (identified in this Annex by the code "SU") and the United States Patent and Trademark Office (identified in this Annex by the code "US") (referred to in this Annex as "the Authorities"), whenever the proposals contained in the responses present differences of substance or where an additional comment is made by the International Bureau. The responses are followed in each case by a comparative analysis prepared by the International Bureau. Each question dealt with has been given an item number against which is shown the chapter and paragraph of the PCT Guidelines in which the question arises. The item numbers correspond with the numbers marked with an arrow appearing in the margin of the PCT Guidelines.

Item 1, Chapter II, paragraph 3 - document collection for international search.

Responses

- US: 3. The search is essentially a documentary search in a document collection that is systematically arranged properly (or otherwise systematically accessible), according to for search the subject-matter contents of the documents. These purposes are primarily patent documents of various countries, supplemented by a number of articles from periodicals and other non-patent literature.
- JA: 3. The search is essentially a documentary search in a document collection that is systematically arranged properly (or otherwise systematically accessible), according to for search purposes the subject-matter contents of the documents. These (PCT Rule 36.1(ii)) are primarily patent documents of various countries, supplemented by a number of articles from periodicals and other non-patent literature.

Comparative Analysis

The responses set forth under Item 1 above (dealing with the document collection used for searching) indicate that the practices proposed by the Authorities are not necessarily consistent in that one Authority (US) defines the document collection for international search as "properly systematically arranged (or otherwise systematically accessible) according to the subject-matter contents of the documents", whereas the other Authority (JA) defines the document collection for international search as "properly arranged for search purposes". The latter response is framed in terms of the specific requirements of PCT Rule 36.1(ii).

[Item 2 follows]

Item 2, Chapter III, paragraphs 1.1 and 1.2 - whether search examiners, under certain circumstances, form provisional opinions for the purpose of assessing novelty and inventive step.

Responses

US:

1. The objective of the search

1.1 As stated in II, 2, the objective of the search is to discover relevant prior art for the purpose of assessing novelty and inventive step. Decisions on novelty and inventive step are the province of the Examining Divisions. However, in many instances provisional opinions on these issues must be formed by the Search Division in order to enable an effective search to be carried out. Such provisional opinions will be subject to review by the Examining Division at the examination stage.

designated
Offices
search
examiner
designated
Office

JA:

1. The objective of the search

1.1 As stated in II, 2, the objective of the search is to discover relevant prior art for the purpose of assessing novelty and inventive step. Decisions on novelty and inventive step are the province of the Examining Divisions. However, in many instances provisional opinions on these issues must be formed by the Search Division in order to enable an effective search to be carried out. Such provisional opinions will be subject to review by the Examining Division at the examination stage.

designated
Offices

SU:

1. The objective of the search is to discover relevant prior art concerning the claimed invention. Relevant prior art shall consist 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 making available to the public occurred prior to the international filing date.

2. The search should be directed to revealing the prior art which is relevant to the claimed invention and the subsequent selection of the restricted number of references to be included in the search report.

3. In the first place, during the search, it is necessary to reveal the documents which might require restriction of the claims filed by the applicant. If, during the search, such documents have not been found, it is necessary to select a restricted number of documents to be included in the search report which reflect the relevant prior art and which allow the formulation of an opinion on whether the claimed invention appears to be novel, to involve an inventive step, or to be industrially applicable.

4. The international search should be formally separated from subsequent examination. During the search, formal conclusions concerning novelty, inventive step and industrial applicability should not be made, but the documents found as the result of such search should provide a basis for subsequent decisions on these questions.

Comparative Analysis

The responses set forth under Item 2 above (dealing with search examiners forming provisional opinions for the purpose of assessing novelty and inventive step) indicate that the searching practices proposed by two Authorities (JA and US) differ as to the forming of provisional opinions by search examiners in respect of questions of patentability. The response of the other Authority (SU) although not specifically referring to the provisional opinion of the search examiner with respect to patentability, could possibly be interpreted as contemplating a provisional opinion. The response of this Authority (SU) reiterates PCT Rule 33.1 for defining the objective of the international search and also suggests restriction of the number of references to be included in the international search report.

[Item 3 follows]

Item 3, Chapter III, paragraph 2.1 - scope of the international search - utilisation of search time to reduce to a minimum the possibility of failing to discover existing highly relevant prior art.

Responses

US: 2. Scope of the search

2.1 The European search is essentially a thorough, high quality, all-embracing search. Nevertheless, it must be realized that in a search of this kind, 100% completeness cannot always be obtained, because of such factors as the inevitable imperfections of any classification system and its implementation, and may not be economically justified if the cost is to be kept within reasonable bounds. The examiner should therefore organise his search effort and utilise his search time in such a manner as to reduce to a minimum the possibility of failing to discover existing highly relevant prior art, such as complete anticipations for any claims. For less relevant prior art, which often exists with a fair amount of redundancy amongst the documents in the search collection, a lower retrieval ratio can be accepted.

JA: Identical to US response.

SU: 18. It must be realized that, 100% completeness of search cannot always be obtained, because of the inevitable imperfections in any classification system, as well as because of the fact that too broad a search may not be economically justified. The search examiner should, therefore, organize his search effort in such a manner as to reduce to a minimum the possibility of failing to discover the material which is necessary to carry out subsequent examination, for example, the material which anticipates the novelty of the claimed invention. If there are too many documents and it is impossible to study them within the time devoted to the search, the scope of the search may be numerically reduced but the reasons for this should be noted and should be annexed to the search report, since, if it is necessary, the decision may be taken to continue the search.

43. It is not necessary to overload the international search report by too great a number of references. It hampers the use of the report. Experience shows that, if the claims consist of not many items, as a rule it is enough to cite not more than ten references to discover relevant prior art. However, as a rule, it is not enough to cite one or two references to discover relevant prior art.

Comparative Analysis

The responses set forth under Item 3 above (dealing with the scope of the international search) indicate that the searching practices proposed by all Authorities (JA, SU, US) are based on the same general principle, namely, that the organization of the search effort is required in order to reduce to a minimum the possibility of failing to discover existing highly relevant prior art. The response of one Authority (SU) makes the distinction that, if there are too many documents to study within certain time limits for searching, the scope of the international search may be numerically reduced and a decision made on whether or not to continue the search. In addition, the same Authority (SU) points out that the citation of not more than ten (10) references should suffice for an international search but as a rule, citation of only one or two references would not suffice to discover relevant prior art.

Item 4, Chapter III, paragraph 2.4 - as to the patent documents outside the PCT minimum documentation to be included in the search file and consulted for international searches.

Responses

US: ~~2.4 The question whether certain categories of documents that are of special relevance to the European patent system, and that do not form part of the PCT minimum documentation, such as patent documents of the Scandinavian countries, if included in the search files, will have to be consulted for international searches performed by the Search Service of the EPO, and conversely, whether certain categories of documents that are of special relevance to the PCT, e.g. patent documents of certain countries not contracting to the European patent system, will have to be consulted for European searches, is left open until the matter of the extent of the search documentation of the Search Service of the EPO has been dealt with.~~ All relevant documents should be consulted by an International Searching Authority

JA: ~~2.4 The question whether certain categories of documents that are of special relevance to the European patent system, and that do not form part of the PCT minimum documentation such as patent documents of the Scandinavian countries, if included in the search files, will have to be consulted for international searches performed by the Search Service of the EPO, and conversely: whether certain categories of documents that are of special relevance to the PCT, e.g. patent documents of certain countries not contracting to the European patent system, will have to be consulted for European searches, if left open until the matter of the extent of the search documentation of the Search Service of the EPO has been dealt with.~~

Comparative Analysis

The responses set forth under Item 4 above (dealing with patent documents outside the PCT minimum documentation included in the search file and to be consulted for international searches) indicate that a major distinction exists between the searching practices proposed by two of the Authorities (JA and US). One Authority (JA) suggests that it should not be necessary to consult all relevant documents for international searches. The other Authority (US) proposes a search of all relevant prior art.

The provisions of Article 15(4) and PCT Rule 33.1(a) are relevant to a consideration of issues raised by the responses.

[Item 5 follows]

Item 5, Chapter III, paragraph 3.4 - amendment of claims for correction of formal matters before receiving the international search report.

Responses

US: 3.4 Since the applicant may not amend the claims before receiving the search report, the search will be directed to the claims as originally filed in the European application. Therefore, if the European application derives from an earlier international (PCT) application or national application, but has claims that are different from those of that earlier application (e.g. as a consequence of an international or national search report), the claims as filed in the European application form the basis of the European search (see III, 4.3).

international
except to correct formal matters which are contrary to the Treaty and are called to applicant's attention by the receiving Office, (for example, Rule 9 and Rule 10 defects)

JA: 3.4 Since the Applicant may not amend the claims before receiving the search report, the search will be directed to the claims as originally filed in the European application. Therefore if the European application derives from an earlier international (PCT) application or national application, but has claims that are different from those of that earlier application (e.g. as a consequence of an international or national search report), the claims as filed in the European application form the basis of the European search (see III, 4.3).

international
except to correct formal matters which are contrary to the Treaty and are called to applicant's attention by the receiving Office, (for example, Rule 9.2 and Rule 10 defects)

↑ 11

Comparative Analysis

The responses set forth under Item 5 above (dealing with amendment of claims to correct formal matters before receiving the international search report) indicate that both Authorities (US and JA) agree that defects drawn to the attention of the applicant by the receiving Office may be corrected by the applicant. One Authority (US) cites PCT Rule 9 generally, whereas the other Authority (JA) cites more specifically Rule 9.2. One Authority (US) considers that, if defects in relation to terminology and signs (PCT Rule 10) are drawn to the attention of the applicant by receiving Office, these defects may likewise be corrected by the applicant. The other Authority (JA) suggests that defects under PCT Rule 11 in relation to the physical requirements of the international application may likewise be corrected by the applicant.

It is desirable that the search practice to be followed in respect of PCT Rule 10 be decided.

[Item 6 follows]

Item 6, Chapter III, paragraph 3.8 - concerning whether dependent claims need be searched when the claim from which they depend is patentable.

Responses

US: 3.8 The search carried out in the classification units of the search files to be consulted for the main claim(s) must include all dependent claims. Dependent claims should be interpreted as being restricted by all features of the claim(s) from which they depend, ~~therefore, where the subject matter of the main claim is novel, that of the dependent claims will also be novel.~~ When the patentability of the main claim is not questioned as a result of the search, there is no need to make a further search in respect of the subject-matter of the dependent claims as such. For example, in an application relating to cathode ray oscilloscope tubes, in which the main claim is directed to specific means along the edge of the front of the tube for illuminating the screen, and a dependent claim is directed to a specific connection between the front and the main part of the tube, the search examiner should, in the search files he consults for searching the illumination means, also search for the connecting means whether in combination with the illumination means or not. When after this search the patentability of the illuminating means is not questioned, the examiner should not extend his search for the connecting means to further search files specifically provided for these connections.

JA: 3.8 The search carried out in the classification units of the search files to be consulted for the main claim(s) must include all dependent claims. Dependent claims should be interpreted as being restricted by all features of the claim(s) from which they depend; therefore, where the subject-matter of the main claim is novel, that of the dependent claims will also be novel. When the patentability of the main claim is not questioned as a result of the search, there is no need to make a further search in respect of the subject-matter of the dependent claims as such. For example, in an application relating to cathode ray oscilloscope tubes, in which the main claim is directed to specific means along the edge of the front of the tube for illuminating the screen, and a dependent claim is directed to a specific connection between the front and the main part of the tube, the search examiner should, in the search files he consults for searching the illumination means, also search for the connecting means whether in combination with the illumination means or not. When after this search the patentability of the illuminating means is not questioned, the examiner should not extend his search for the connecting means to further search files specifically provided for these connections.

SU: 9. The subject matter of the search must include all dependent claims. Any dependent claim should be constructed as including all the limitations contained in the claim from which it depends. Taking into consideration dependent claims is especially important. When a dependent claim gives not only more detailed enumeration of what has already been said in the independent claim, but also adds new features of the invention, such a dependent claim is specially important to be taken into consideration.

Comparative Analysis

The responses set forth under Item 6 above (dealing with whether dependent claims should be searched when their parent claim is patentable) show that two of the Authorities (US and SU) consider that dependent claims should be searched along with their parent claims. Conversely, one Authority (JA) in its response considers that dependent claims should not be searched whenever their parent claims are patentable.

[Item 7 follows]

Item 7, Chapter III, paragraph 3.9 - searching dependent claims when they add further features.

Responses

- US: 3.9 ~~However, where the patentability of the main claim is questioned, it may be necessary for assessing inventive step of a dependent claim to establish whether the features of the dependent claim as such are novel by searching one or more additional classification units. No such special search should be made for features that are trivial or generally known in the art.~~ When the dependent claim adds a further feature (rather than providing more detail of an element figuring already in the main claim), the dependent claim in effect constitutes a combination claim and should be dealt with accordingly (see III, 3.10).
- JA: 3.9 However, where the patentability of the main claim is questioned, it may be necessary for assessing inventive step of a dependent claim to establish whether the features of the dependent claim as such are novel by searching one or more additional classification units. No such special search should be made for features that are trivial or generally known in the art. When the dependent claim adds a further feature (rather than providing more detail of an element figuring already in the main claim), the dependent claim in effect constitutes a combination claim and should be dealt with accordingly (see III, 3.10).
- SU: 9. The subject-matter of the search must include all dependent claims. Any dependent claim should be constructed as including all the limitations contained in the claim from which it depends. Taking into consideration dependent claims is especially important. When a dependent claim gives not only more detailed enumeration of what has already been said in the independent claim, but also adds new features of the invention, such a dependent claim is specially important to be taken into consideration.
10. The search of certain claims may not be carried out if such claims were unsatisfactorily drafted, that is, if they do not add new features to the subject-matter of the search. However, if the description provides a basis for proper amendment of the claim, such amended claim should be taken into consideration during the search.

Comparative Analysis

The responses set forth under Item 7 above (dealing with the situation when dependent claims should be searched) indicate that three Authorities (JA, SU and US) consider that provision should be made for searching dependent claims when the dependent claims add further features. However, one Authority (JA) specifically indicates that, if the dependent claim contains features that are trivial or generally known in the art, no international search of the dependent claim should be carried out.

[Item 8 follows]

Item 8, Chapter III, paragraph 3.10 - whether the international search in additional classification units for the subcombination claim will permit assessment of the inventive step of the combination.

Responses

US: 3.10 For claims characterized by a combination of elements (e.g. A, B and C) the search should be directed towards the combination; however, when searching classification units for this purpose, subcombinations, including the elements individually (e.g. AB, AC, BC and also A, B and C separately) should be searched in those units at the same time. A search in additional classification units either for subcombinations or for individual elements of the combination should only be performed if this is still necessary for establishing the novelty of the element in order to assess the inventive step of the combination.

JA: 3.10 For claims characterised by a combination of elements (e.g. A, B and C) the search should be directed towards the combination; however, when searching classification units for this purpose, subcombinations, including the elements individually (e.g. AB, AC, BC and also A, B and C separately) should be searched in those units at the same time. A search in additional classification units either for subcombinations or for individual elements of the combination should only be performed if this is still necessary for establishing the novelty of the element in order to assess the inventive step of the combination.

SU: 11. If the claims are characterized by a combination of elements (e.g. A, B and C) the subject of search should include such a combination, as well as combinations AB, AC, BC and elements A, B, C taken separately, if a possibility of such combinations and elements is obvious for a person skilled in the art.

Comparative Analysis

The responses set forth under Item 8 above (dealing with the reason for searching the subcombination of a combination) indicate that one Authority (US) does not feel that the search in additional classification units for a subcombination will of itself necessarily permit assessment of the inventive step of the combination without first discovering the combination. One Authority (JA) in its response considers that such a search should help to assess the inventive step of the combination, whereas the other Authority (SU) points out that such search should help to assess the inventive step of the combination if combining the individual elements of the subcombination is obvious to a person skilled in the art.

[Item 9 follows]

Item 9, Chapter III, paragraph 3.14 - extension of the subject-matter of the international search to include the technological background of the invention (background art).

Responses

- US: 3.14 In certain circumstances it may be desirable to extend the subject-matter of the search to include the "technological background" of the invention (see IV, 2.4). This would include:
- the preamble to the first claim, i.e. the part preceding the expression "characterised by";
 - the prior state of the art which is deemed to be known in the introduction of the description of the application but not identified by specific citations;
 - the general technological background of the invention (often called "general state of the art").
- JA: Identical to US response.
- SU: 12. When determining the subject-matter of the search, it is also necessary to take into account:
- the preamble of the claim;
 - the reference documents cited by the applicant;
 - the general technological background of the invention.

Comparative Analysis

The responses set forth under Item 9 above (dealing with extension of the subject-matter of the international search with respect to background art) indicate that there are no major differences between the searching practices proposed by the three Authorities (JA, SU, and US) under this Item. The response of one of the Authorities (SU) points out that extension of the international search with respect to the "prior state of the art" should take into account the references cited by the applicant.

PCT Rule 5.1(a)(ii) is relevant to the consideration of the issues raised.

[Item 10 follows]

Item 10, Chapter IV, paragraph 1.2 - notification to the receiving Office and applicant by the search examiner if any formal shortcomings have been overlooked by the receiving Office.

Responses

US: 1.2 If the search examiner notices any formal shortcomings which have been overlooked by the Receiving ~~Section~~, he should call these to the Office attention of the ~~Receiving Section (or of the Examining Division in the case of an additional search requested by that Division)~~ Office, which will take appropriate action. Similarly, if he notes matter contrary to "ordre public" or morality or disparaging statements which ought to be omitted from the application as published he should notify the ~~Receiving Section~~ applicant.

JA: Identical to US response.

Comparative Analysis

The responses set forth under Item 10 above (dealing with formal shortcomings not noted by the receiving Office) indicate that no major differences exist between the search practices proposed by two Authorities (JA and US) under this Item.

Paragraph 1.2 of Chapter IV of the draft PCT Guidelines appears to be consistent with PCT Rule 28.1. However, the paragraph needs to be further considered having regard to PCT Rule 9.2 which provides that the International Bureau is to be informed when the International Searching Authority notes a lack of compliance with the prescriptions of PCT Rule 9.1. The informing of the International Bureau is highly desirable to assist it in excising matter contrary to public order or disparaging statements at the time of the publication of the international application.

[Item 11 follows]

Item 11, Chapter IV, paragraph 1.3 - request to applicant that an essential cited document in the international application be sent to the International Searching Authority.

Responses

- US: 1.3 Documents cited in the application under consideration should be examined if they are cited as the starting point of the invention, or as showing the state of the art, or as alternative solutions to the problems concerned, or when they are necessary for a correct understanding of the application; however, when such citations clearly relate only to details not directly relevant to the claimed invention, they may be disregarded. If the application cites a document that is not published or otherwise not accessible to the ~~Search Division~~ and the document appears essential to a correct understanding of the invention to the extent that a meaningful search would not be possible without knowledge of the content of that document, the ~~Search Division should postpone the search and request the applicant to provide first a copy of the document.~~ International Searching Authority
International Searching Authority may if ^{it is} possible to do so within the time limits for the preparation of the international search report under the Treat
- JA: Identical to US response.
- SU: 25. Documents cited by the applicant himself should be examined to find out if they show the state of the prior art, if they disclose alternative solutions, or if documents are necessary for a correct understanding of the international application. If the claimed invention cites a document that was not published or otherwise not accessible to the search examiner, although this document is necessary, the examiner should take the necessary steps in order to invite the applicant to provide a copy of the document.

Comparative Analysis

The responses set forth under Item 11 (dealing with asking the applicant to send an essential cited document) illustrate that a similar search practice is proposed by all three Authorities (JA, SU and US), particularly in relation to the need to acquire essential documents cited by the applicant which are not accessible to the International Searching Authority. The response of one Authority (SU), however, does not mention whether the postponement of the international search for the purpose of acquiring an essential document should be made within the time limit for the preparation of the international search report under the PCT.

While the practice proposed under this Item is not specifically provided for under the PCT, its inclusion in the PCT Guidelines does not appear inconsistent therewith and would facilitate the carrying out of a uniformly high quality international search.

[Item 12 follows]

Item 12, Chapter IV, paragraph 2.2 - whether the search examiner should select units of the classification or other sections of the documentation as part of the search strategy.

Responses

US: 2.2 Next the examiner should select the units of the classification (or other sections of the documentation) to be consulted for the search, both in all directly relevant fields and in analogous fields. ~~The selection of classification units in related fields should be limited to:~~

~~(i) higher subdivisions allowing searching by abstraction (generalisation) in as much as this is justified from a technical viewpoint, and~~

~~(ii) parallel subdivisions, bearing in mind the fact that the fields in question will become increasingly unrelated.~~

JA: 2.2 Next the examiner should select the units of the classification (or other sections of the documentation) to be consulted for the search, both in all directly relevant fields and in analogous fields. ~~The selection of classification units in related fields should be limited to:~~

~~(i) higher subdivisions allowing searching by abstraction (generalisation) in as much as this is justified from a technical viewpoint, and~~

~~(ii) parallel subdivisions, bearing in mind the fact that the fields in question will become increasingly unrelated.~~

SU: 17. To determine the scope of the search, it is necessary to carry out the detailed classification of the claimed invention in accordance with IPC and the national classification systems of the inventions of those countries whose patent collections must be taken into consideration during the search. It is necessary to bear in mind that the process of classification, when determining the scope of the search, has many aspects and it should be carried out with due regard to particulars of national systems of classification of inventions, as well as the particulars of the search files. Thus, the determination of the scope of the search on the basis of patent documentation consists of the determination of the classification units of the search files which should be studied during the search. The completeness of the search depends on the correct determination of the scope of the search.

Comparative Analysis

The responses set forth under Item 12 above (dealing with search strategy) indicate that, in general, the three Authorities (JA, SU and US) propose the same search strategy, that is, the basic search strategy employed by the search examiner will be to first select the units of classification to be consulted for international search, both in all directly relevant fields and in analogous fields. However, whereas the response of one Authority (US) includes the selection of other sections of the documentation, the response of another Authority (JA) excludes such other sections of the documentation. The third Authority (SU) has made no specific observation on this question.

Item 13, Chapter IV, paragraph 2.8 - when the international search may be stopped.

Responses

- US: 2.8 Reasons of economy dictate that the search examiner uses his judgment to end his search when the probability of discovering further relevant prior art becomes very low in relation to the effort needed. The search may also be stopped when documents have been found clearly demonstrating lack of novelty or inventive step in the entire subject-matter of the claimed invention and its elaborations in the description, apart from features which are trivial or common general knowledge in the field under examination. ~~The search for conflicting applications should, however, always be completed to the extent that these are present in the search files.~~
- JA: Identical to US response.
- SU: 33. The search may be stopped when documents have been found clearly demonstrating lack of novelty of the claimed invention. However, it is necessary to do this very carefully, taking into account the many aspects of the nature of the invention. It may occur that the documents retrieved do not anticipate the novelty of certain features of the invention for which the applicant is in a position to maintain the claims, for example after clarification thereof. In any case, the documents anticipating the inventive step, but not anticipating the novelty, are not grounds for stopping the search.
34. All decisions taken by the search examiner during the search relating to the restriction on the scope of the search, as well as all temporary decisions concerning novelty, inventive step and industrial applicability of the claimed invention, should be noted by the search examiner and should be annexed to the search report.

Comparative Analysis

The responses set forth under Item 13 above (dealing with when the international search may be stopped) point out that the searching practices proposed by two Authorities (JA and US) are compatible as regards permitting the search to be stopped when documents have been found clearly demonstrating lack of novelty or inventive step in the entire subject matter of the claimed invention. The response of one Authority (SU) makes the distinction that the action of restricting or stopping the international search on the part of the search examiner should take place only when documents have been found anticipating lack of novelty exclusive of inventive step of the search and that such restriction and stopping should be noted in the international search report.

The provisions of the PCT concerning the international search (especially Article 15(4)) need to be taken into account in the consideration of the Item. Furthermore, it is noted that the PCT does not specifically provide for the notation in the international search report that the international search has been stopped for any of the reasons set out under this Item.

Item 14, Chapter IV, paragraph 3.2 - citation of members of the same patent family.

Responses

US: 3.2 To avoid increasing costs unnecessarily, the examiner should not cite more documents than is necessary, and therefore when there are several documents of equal relevance the search report should not normally cite more than one of them. Where more than one member of the same patent family is present in a search file, the search need not discover all of them nor need the search report cite all of them. In selecting from these documents for citation, the examiner should pay regard to language convenience, and preferably cite (or at least note) documents in the language of the application. ~~(This is in accordance with a decision taken by IC/PCT/TCO at its November 1974 meeting. Further details still to be elaborated).~~

JA: Identical to US response.

SU: 40. To avoid unnecessary expenditure, the search examiner should not select for inclusion in the search report more documents than is necessary to discover relevant prior art. In particular, among patent family members, preference should be given to the document having the earliest date of publication.

Comparative Analysis

The responses set forth under Item 14 (dealing with which members of the same patent family should be cited in the international search report) indicate that the searching practices proposed by the Authorities (JA, SU and US) are not fully compatible as to which members of the same patent family should be cited in the international search report. The responses of two Authorities (JA and US) show that they prefer the citation of documents having regard to their language convenience. The response of one Authority (SU) shows that it prefers citation of documents having the earliest date of publication.

The PCT makes no provision with respect to the search practice to be followed regarding citation of members of the same patent family in the international search report. The discussion of the treatment of patent families, including the citation of members of a patent family, at the fifth session of the PCT Interim Committee for Technical Cooperation, needs to be taken into account in the consideration of this Item (see paragraphs 48 to 57 of document PCT/TCO/V/20, especially paragraph 57(iv) as to the attitude of the prospective International Searching Authorities).

[Item 15 follows]

Item 15, Chapter V, paragraph 4.1 - special categories of documents to be cited in the international search report - conflicting applications.

Responses

US: 4.6 There may also be ~~national~~ applications of ~~one~~
1 ~~or more States designated in the European application~~
~~and~~ coming within the "intervention period". Any of
these which are present in the search files should be
noted and mentioned in the search report for informa-
tion (PCT Rule 33.1(c)).

JA: Identical to US response.

Comparative Analysis

The responses set forth under Item 15 (dealing with conflicting applications) indicate that two Authorities (JA, US) are in agreement as to the text to be included in the PCT Guidelines regarding the search practice to be followed in relation to conflicting applications, that is, applications coming under PCT Rule 33.1(c). The third Authority (SU) has made no specific reference to the question.

It is to be noted that the expression "intervention period" which appears in the said text, is not defined in the draft PCT Guidelines. The International Bureau has, therefore, prepared an alternative text, in the light of PCT Rule 33.1(c), which avoids the use of this expression.

[Item 16 follows]

Item 16, Chapter V, paragraph 5.3 - checking of the validity of a priority claim.

Responses

- US: 5.3 It is the responsibility of the examining designated Office Division to check whether and to what extent the priority claim is justified; therefore the Search International Searching Division will not check whether the contents of Authority the European application correspond to those of international the priority application(s). Nevertheless, documents showing that a priority claim might not be justified (e.g. an earlier application or patent resulting therefrom, by the same applicant indicating that the application from which priority is claimed may not be the first application for the invention concerned), should be drawn to the attention of the Examining Division. No special International Bureau search beyond the filing date of the application should normally be made for this purpose, except when there is a special reason to do so, e.g. when the priority application is a "continuation in part" of an earlier application from which no priority is claimed; also sometimes the country of residence of the applicant being different from the country of the priority application may be an indication of possible lack of first filing, justifying a certain extension of the search.
- JA: 5.3 It is the responsibility of the examining designated Office Division to check whether and to what extent the priority claim is justified; therefore the Search International Searching Division will not check whether the contents of Authority the European application correspond to those of international the priority application(s). ~~Nevertheless, documents showing that a priority claim might not be justified (e.g. an earlier application or patent resulting therefrom, by the same applicant indicating that the application from which priority is claimed may not be the first application for the invention concerned), should be drawn to the attention of the Examining Division. No special search beyond the filing date of the application should normally be made for this purpose, except when there is a special reason to do so, e.g. when the priority application is a "continuation in part" of an earlier application from which no priority is claimed; also sometimes the country of residence of the applicant being different from the country of the priority application may be an indication of possible lack of first filing, justifying a certain extension of the search.~~

Comparative Analysis

The responses set forth under Item 16 above (dealing with checking the validity of the priority claim) show that a major difference exists between the practice proposed by two Authorities (JA and US) regarding a check of the priority claim, i.e. as to an indication that a priority claim may not be justified and the communication of such indication to the International Bureau. The response of one Authority (US) indicates that the International Searching Authority should draw to the attention of the International Bureau documents which indicate that the priority claim may not be justified. The other Authority (JA), however, suggests that only the designated Offices should have the responsibility of checking the validity of a priority claim, and, by inference, that the International Searching Authority should not be required to take any action in this regard.

The powers and functions of the International Bureau in relation to priority claims are set out in PCT Rules 4.10(b), (c) and (d) and 17. These powers and functions do not extend to a consideration of the validity of the priority claim, except for the reasons set out in those Rules. In the event that the proposed practice is adopted, whereby the International Bureau is notified of documents indicating doubt as to the validity of the priority claim, the function of the International Bureau should only be to transmit such notification to the designated Offices when communicating the international search report.

[Item 17 follows]

Item 17, Chapter V, paragraph 6.2 - circumstances wherein citation of a document whose contents have not been verified, provided there is justification for the assumption that there is identity of contents with another document which has been cited and inspected by the search examiner.

Responses

US: 6.2 However, under certain circumstances a document whose contents have not been verified may be cited, provided there is justification for the assumption that there is identity of contents with another document which the examiner has inspected. For example, and cited instead of the document published before the filing date in an inconvenient language and selected for citation, the search examiner may have inspected a corresponding document (e.g. another member of the same patent family, or a translation of an article) in a more convenient language and possibly published after the filing date; also the Search Division may International Searching Authority assume that, in the absence of explicit indications to the contrary, the contents of an abstract are contained in the original document. Also the examiner should assume that the contents of a report of an oral presentation are in agreement with that presentation (any comments or explanations should be in the internal search note).

JA: Identical to US response.

Comparative Analysis

The responses under Item 17 above (dealing with certain circumstances and assumptions wherein a document whose contents have not been verified may be cited) show that two Authorities (JA and US) are oriented at the same direction insofar as their making a distinction in respect of citing documents whose contents have not been verified is concerned.

Consideration may have to be given to the inclusion of a further provision in Section 508 of the Administrative Instructions, which now provides for indications for citing special categories of documents in the international search report, to cover the citation of documents under this Item.

[Item 18 follows]

Item 18, Chapter V, paragraph 7.1 - matters of doubt in the state of the art.

Responses

US: 7.1 Since the decisions with respect to novelty are not the responsibility of the ~~Search Divisions~~ but of the ~~Examining Divisions~~, the ~~Search Divisions~~ should not discard documents because of doubt as regards for example the exact date of publication or public availability, or the exact contents of an oral disclosure, exhibition etc. to which such documents may refer. The ~~Search Division~~ should try to remove whatever doubt may exist and should not cite the documents concerned in the report unless the doubt is removed or very little doubt remains; additional documents providing evidence in the matters of doubt may be cited. Comments on these documents, as well as citation of documents for which greater doubt remains, should be made in the ~~internal~~ search note.

International Searching Authority designated Offices International Searching Authorities International Searching Authority

report citation page

JA: Identical to US response.

Comparative Analysis

The responses set forth under Item 18 above (dealing with matter of doubt in the state of the art) indicate that two Authorities (JA and US) reveal no major differences in respect of the citation of additional documents providing evidence in the matters of doubt, as well as on documents for which substantial doubt remains.

The PCT Guidelines should be able to harmonize the practice under the PCT on this point. While the PCT makes no specific provision concerning the citation of such additional documents in the international search report, PCT Rule 43.5(a), which is included within the scope of PCT Rule 43.9, may not exclude this possibility. The requirement of commenting on additional documents providing evidence in matters of doubt might be regulated by a suitable Administrative Instruction.

[Item 19 follows]

Item 19, Chapter VII, paragraphs 5 and 9 - the basic criterion for unity of invention.

Responses

US: 5. As indicated in VII, 1 the basic criterion for unity of invention is the presence of a common inventive concept. Consequently, the mere fact that an application contains several independent claims of the same category or claims of different categories is in itself no ground for objection of lack of unity of invention related under PCT Rules 13.2 and 13.3

9. Lack of unity of invention may be directly evident "a priori", i.e. before considering the claims in relation to any prior art, or may only become apparent "a posteriori", i.e. after taking the prior art into consideration, e.g. a document discovered in the search shows that there is lack of novelty ~~or inventive step~~ in a main claim, leaving two or more dependent claims without a common inventive concept. In the latter case the Search Division may raise the objection of lack of unity and restrict the search to the invention (or group of inventions) first mentioned in these dependent claims, disregarding "trivial" claims as in III, 3.9. this International Searching Authority limit if no additional search fee is paid

JA: 5. As indicated in VII, 1 the basic criterion for unity of invention is the presence of a common general inventive concept. Consequently, the mere fact that an application contains several independent claims of the same category or claims of different categories is in itself no ground for objection of lack of unity of invention.

9. Lack of unity of invention may be directly evident "a priori", i.e. before considering the claims in relation to any prior art, or may only become apparent "a posteriori", i.e. after taking the prior art into consideration, e.g. a document discovered in the search shows that there is lack of novelty ~~or inventive step~~ in a main claim, leaving two or more dependent claims without a common inventive concept. In the latter case the Search Division may raise the objection of lack of unity and restrict the search to the invention (or group of inventions) first mentioned in these dependent claims, disregarding "trivial" claims as in III, 3.9. general this International Searching Authority limit if no additional search fee is paid

Comparative Analysis

The responses under Item 19 above (dealing with the basic criterion for unity of invention) show that, while both Authorities accept paragraph 1 of Chapter VII which defines unity of invention in terms of PCT Rule 13.1, two Authorities (JA and US) have proposed somewhat differing terminology in paragraphs 5 and 9. One Authority (JA) has used the expression "general inventive concept" while the other Authority (US) has used the expression "common inventive concept".

While the use of either term may have no consequences in paragraph 5 in view of the second sentence of that paragraph, substantial consequences may flow from choice of the expression in paragraph 9. The provisions of PCT Rule 13.1 are clearly relevant to a consideration of the issues raised by the differing terminologies proposed in relation to paragraph 9.

Item 20, Chapter VII, paragraph 11 - making a complete international search with negligible additional work in cases where lack of unity exists and the results are included in a single international search report.

Responses

US: 11. Occasionally in cases of lack of unity, especially "a posteriori", the examiner will be able to make a complete search for both or all inventions with negligible additional work, in particular when the inventions are conceptually very close and none of them requires search in separate classification units. In those cases, the search for the additional invention(s) should be completed together with that for the invention first mentioned. All results should then be included in a single search report, and no objection of lack of unity should be raised. ordinarily

JA: 11. Occasionally in cases of lack of unity, especially "a posteriori", the examiner will be able to make a complete search for both or all inventions with negligible additional work, in particular when the inventions are conceptually very close and none of them requires search in separate classification units. In those cases the search for the additional invention(s) should be completed together with that for the invention first mentioned. All results should then be included in a single search report, and no objection of lack of unity should be raised. ordinarily

Comparative Analysis

The responses set forth under Item 20 above, (dealing with lack of unity of invention and carrying out a complete search to be included in a single international search report) show that the two Authorities (JA and US) have proposed making a complete international search in cases of lack of unity of invention when all inventions can be searched with negligible additional work.

However, one Authority (JA) has indicated that the results of the complete search under Item 20 above should be in an international search report, whereas the other Authority (US) indicates that the results of their complete search should be included in a single international search report.

It would appear that the PCT Guidelines should readily be able to harmonize the practice under the PCT on this point. For example, under Article 17(3)(a) and PCT Rule 43.7, even in the case where additional fees are paid due to lack of unity of invention, only one international search report is envisaged.

[Item 21 follows]

Item 21, Chapter VIII, paragraph 1 - subject-matter to be excluded from the international search.

Responses

US: 1. ~~Article 52 specifies certain subjects which are not to be regarded as patentable inventions, whilst Article 53 specifically excludes certain matter from patentability (PCT Art. 17(2)(a)(i), Rule 39.1).~~ The search files need not, and in general do not, contain such subject-matter, so that a meaningful search therefor is not possible and a declaration to that effect takes the place of the search report (PCT Art. 17(2)(a)(i)).

Rule 39
need not be searched.
many situations

JA: 1. ~~Article 52 specifies certain subjects which are not to be regarded as patentable inventions, whilst Article 53 specifically excludes certain matter from patentability (PCT Art. 17(2)(a)(i), Rule 39.1).~~ The search files need not, and in general do not, contain such subject-matter, so that a meaningful search therefor is not possible and a declaration to that effect takes the place of the search report (PCT Art. 17(2)(a)(i)).

Rule 39
need not be searched.

Comparative Analysis

The responses under Item 21 above (dealing with subject matter to be excluded from the international search, indicate no major differences between the searching practices proposed by two Authorities (JA and US). One Authority (JA) indicates that the subject matter under PCT Rule 39 need not be searched while the response of the other Authority (US) further explains that the search files need not, and in many situations do not, contain such subject matter.

It would appear that the PCT Guidelines should readily be able to harmonize the practice under the PCT on this paragraph, since it is completely optional under Article 17(2)(a)(i), as far as the International Searching Authority is concerned, whether an international search is made in relation to the subject-matter specified in PCT Rule 39.

[Item 22 follows]

Item 22, Chapter VIII, paragraph 4 - concerning where in practice a meaningful international search is not possible.

Responses

- US: 4. A further situation where a meaningful search is not possible or only partially possible, and where a declaration to this effect may take the place of or supplement the search report, may result from the application containing obscurities, inconsistencies or contradictions to the extent that it is impossible to arrive at a reasonable conclusion as to the scope of the claimed invention. ~~The Search Division in these cases may not suspend the search, ask for clarification, and after receipt thereof continue the search, but should make a meaningful search to the extent that this is possible. When later clarifications are received, these will be considered by the Examining Division to perform an additional search, see III, 4.2).~~ International Searching Authority
PCT Art. 17(2) (a) (ii)
- JA: 4. A further situation where a meaningful search is not possible or only partially possible, and where a declaration to this effect may take the place of or supplement the search report, may result from the application containing obscurities, inconsistencies or contradictions to the extent that it is impossible to arrive at a reasonable conclusion as to the scope of the claimed invention. ~~The Search Division in these cases may not suspend the search, ask for clarification, and after receipt thereof continue the search, should make a meaningful search to the extent that this is possible. When later clarifications are received, these will be considered by the Examining Division (which then may request the Search Division to perform an additional search, see III, 4.2).~~ International Searching Authority
PCT Art. 17(2) (a) (ii)

Comparative Analysis

The responses under Item 22 above (dealing with the practice where a meaningful international search is not possible) indicate that there are no major differences in the searching practices proposed by two Authorities (JA and US). Both Authorities, in their responses have indicated that, whenever a meaningful international search is not possible or only partially possible as the result of obscurities, inconsistencies and contradictions in the international application, the International Searching Authority should make a meaningful search to the extent that is possible. One Authority (US), however, would state specifically that, in the case where a meaningful search is not possible or only partially possible, the Authority may not suspend the search, ask for clarification from the applicant and after receipt thereof continue the search. The response of the other Authority (JA) has omitted such specific directions.

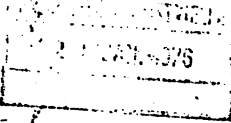
The provisions of Article 17(2) (a) (ii) and the need to observe the time limits (provided under Rule 42) for the establishment of the international search report need to be taken into account in a consideration of the questions raised by the responses of the two above-mentioned Authorities.

ANNEX C

This Annex contains a copy of a letter from the International Bureau inviting comments from the Japanese Patent Office in relation to the PCT Guidelines, together with the reply received, marked as Part I, and a copy of a similar letter to the State Committee for Inventions and Discoveries of the USSR Council of Ministers, together with the reply received, marked as Part II.

[Part I follows]

cc : Mr. Franklin



January 20, 1976

JF/EMM/jf

PCT 2802-081-3

Dear Mr. Director General,

Referring to the last session of the PCT Interim Committee for Technical Cooperation (October 29 to November 3, 1975), I wish to convey the appreciation of the International Bureau of WIPO for the indication given to the Interim Committee by the Delegation of Japan that Japan would be willing to present comments with respect to the Guidelines for Searches under the PCT contained in document PCT/TCO/V/12, two copies of which are attached (see, in particular, paragraph 70(iii) of the report of the fifth session of the Interim Committee, document PCT/TCO/V/20).

Your comments will be reflected in a working document establishing Guidelines for Searches under the PCT which is now in the course of preparation and which will be submitted to the next meeting of the Interim Committee for Technical Cooperation. It would facilitate our work greatly to have your comments at your earliest convenience and, preferably, not later than the end of February.

The International Bureau is, of course, at your disposition for any assistance it may be able to render in this matter.

Sincerely yours,

Felix A. Sviridov
Deputy Director General

Mr. Hideo Saito
Director General
Japanese Patent Office
4-3 Kasumigaseki 3-chome
Chiyoda-ku
Tokyo
Japan

PATENT OFFICE
JAPANESE GOVERNMENT

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

FORU 30 136/51
March 3, 1976

Mr. Felix A. Sviridov
Deputy Director General
World Intellectual Property Organisation
32, chemin des Colombettes
1211 Geneva 20, Switzerland

Dear Sir:

Referring to your letter dated Jan. 20, 1976 concerning the Guidelines for Searches under the PCT, please find enclosed the comments of the Japanese Patent Office on the attached sheets.

You may notice that asterisks (*) are put where we disagree with the United States Patent Office.

Yours truly,

Shiro Kitayama
Shiro Kitayama
Director General

Encl:
As stated above

PCT/TCO/VI/8
ANNEXE C, PART I/ANNEX C, PART I

PCT/TCO/VI/8

Annex

INTERIM COMMITTEE FOR TECHNICAL COOPERATION

of the European Patent Organisation

- Secretariat -

Brussels, July 8, 1975

61452/75

DRAFT GUIDELINES FOR THE SEARCHES
TO BE CARRIED OUT UNDER THE EUROPEAN PATENT CONVENTION
PATENT COOPERATION TREATY

PCT/TCO/VI/8

Annex

INTERIM COMMITTEE

of the European Patent Organisation

Patent Cooperation Treaty

- Secretariat -

Brussels, July 8, 1975

61452/75

DRAFT GUIDELINES

FOR THE SEARCHES TO BE CARRIED OUT

UNDER THE EUROPEAN PATENT CONVENTION

PATENT COOPERATION TREATY

Cover Note

~~The enclosed draft Guidelines for the searches to be carried out under the European Patent Convention, which have been prepared by Working Party II, are being distributed to all the delegations on the Interim Committee and to the observer organisations for consultation. Chapters on search documentation and on the search report will be added to these draft Guidelines at a later stage.~~

The draft Guidelines for substantive examination have already been submitted to the same delegations and organisations under reference CY/45/75. The draft Guidelines for formalities examination will follow shortly, and the draft Guidelines for opposition later this year.

The delegations and observer organisations are requested, in order to enable Working Party II to give due consideration to their comments on the enclosed draft, to submit their comments in writing to the Secretariat by:

(a) 1 October 1975, in the case of the delegations on the Interim Committee;

(b) 1 November 1975, in all three languages of the Interim Committee, in the case of the observer organisations.

The subsequent procedure in respect of the enclosed draft will be the reverse of that announced in respect of the draft Guidelines for substantive examination.

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DEBAT GUIDELINES FOR THE SEARCHES TO BE CONDUCTED OUT
UNDER THE INTERNATIONAL PATENT COOPERATION TREATY

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CHAPTER I

INTRODUCTION

1. These Guidelines were elaborated by Working Party II of the Interim Committee for Technical Cooperation with and with agreement from Working Party III as regards matters of common interest. They were then accepted with minor amendments by the Interim Committee in its meeting of the
 2. The Director General of WIPO in his decision of has adopted these Guidelines (.. with minor amendments ...) as internal administrative instructions and guidance for the public in accordance with Rule 89.2(a) of the Treaty
 3. These Guidelines constitute elaborations and clarifications of the provisions of the Treaty and the relevant Articles and Rules, as indicated in the Annex. Similarly, a Guideline was elaborated for the formalities examination of the where appropriate, reference to these other Guidelines (these references are to be added later)
 4. In order to ensure uniform practice the International Searching Authorities are encouraged to adhere to these Guidelines to the extent that they are not amended or revoked by the Director General of the of the by the
- Nevertheless, the application of the Guidelines to, and the interpretation thereof in respect of, individual patent applications is the responsibility of the International Searching Authorities in exceptional cases.

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5. These Guidelines were drafted for, and apply to, ~~European searches, but also~~ ~~national searches, but also~~ ~~international searches, but also~~ ~~European applications.~~ ~~In addition to these searches the Search Divisions of the European Patent Office will be called upon to carry out other types of searches (see XII, 4). It is intended that these Guidelines should apply to these other types of searches to the largest extent possible, and any deviations from these Guidelines applying to these other searches will be indicated where appropriate and will be summarised in ~~Annex I.~~~~ international

6. ~~Special mention is made of international (PCT) searches carried out by the European Patent Office acting as an International Searching Authority under the Patent Cooperation Treaty. Since the requirements of that Treaty and the European Patent Convention with respect to the search and search report are to a very large extent identical or at least compatible, when elaborating these Guidelines the opportunity was taken to make them applicable also to PCT searches to the largest extent possible. References to the relevant Articles and Rules of the PCT are included in these Guidelines in the appropriate places.~~

~~7. The Search Divisions of the European Patent Office will take over the task of the International Patent Institute (IPI) with respect to the searching of national applications of its Member States. These Guidelines are not necessarily fully applicable to these national searches, nor are the ways in which these searches differ from European searches specifically pointed out. Nevertheless it is to be expected that at least for those Member States of the IPI which are also party to the EPC, these national searches will to a large extent be identical with, or compatible with, European searches.~~

Prot. Contr. I(1)(b)

Art. 17

Prot. Contr. I(1)(c), V

~~8. European searches will be carried out in the Search Divisions of the Search Service in the branch at The Hague and in the sub-office thereof in Berlin, and may also be entrusted to the central industrial property offices of certain Contracting States. Searches in documents in foreign languages shall be carried out in the Search Divisions of the European Patent Office, or by a central office, or by one or more designated national patent offices. These Guidelines apply to the International Patent Institute and to the International~~

~~Art. 17, 19~~
international

~~Art. 17(2)~~

Art. 17, 23
Rule 44(1)

~~Art. 52(2), 57~~

1. The procedure through which ~~a European~~ an international patent application proceeds from the filing of the application to the granting of a patent (or the refusal thereof) comprises two clearly separated basic stages, i.e. the search and the substantive examination, by the national Office
2. The objective of the search is to discover the prior art which is relevant for the purpose of determining whether, and if so to what extent, the invention to which the application relates is ~~new and inventive~~ new or is not new or is not new and does or does not involve an inventive step, (PCT Art. 15(2), Rule 33.1(a)).
3. The search is essentially a documentary search in a document collection that is properly ~~systematically arranged for this purpose~~ ~~systematically accessible according to the subject-matter contents of the documents.~~ systematically arranged for search purposes ~~These are primarily patent documents of various countries, supplemented by a number of articles from periodicals and other non-patent literature.~~ (*)
4. A search report will be prepared containing the results of the search, in particular by identifying the documents constituting the relevant prior art (PCT Art. 16(1), Rule 43.5). An international
5. The search report serves to provide international information on the relevant prior art to the applicant, to the public, and to the designated Offices ~~Examining Divisions of the European Patent Office (PCT Art. 18(7), Art. 21(3), Art. 33(6), Rule 62.1(b)).~~ if the application is published
6. Since the search will be carried out and the search report will be prepared by the International Searching Authority and the examination will be carried out by the designated Offices ~~by the Examining Divisions of the European Patent Office~~ internationally ~~by the Examining Divisions of the European Patent Office~~ (*)

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CHAPTER II

7. There are ~~no~~ facilities for systematic searching by the ~~Examination Division~~, other than for conflicting ~~European~~ applications ~~(see V, 14).~~ ~~The Examination Division~~ therefore, dependent on the work of the ~~Search Division~~ for their knowledge of the state of the art on which assessments of the patentability of the invention will be based. The search must, therefore, be as complete and effective as possible, within the limitations necessarily imposed by economic considerations (see III, 2).

In some instances, there designated Offices national. Some designated Offices may International Searching Authorities' their international

-Rule 14(1)-

8. In order to be able to inform the ~~Examination Division~~ of the documents necessary to decide on patentability, the search examiner must be familiar with the basic requirements of examination, especially with respect to novelty, inventive step, unity of invention, and subjects excluded from patentability either specifically or because of lack of industrial applicability (see Chapters V to VIII). On the other hand, a certain amount of feed-back to the ~~Search Division~~ of the consequences of the search, in particular the actions taken by the applicant and the ~~Examination Division~~ as a result of the search report, ~~is necessary~~ in order to obtain searches well adapted to the needs of the examination.

International Searching Authority designated Office may be desirable

international

9. The unit responsible for carrying out the search and drawing up the search report for an application is a Search Division, which consists normally of one search examiner. In exceptional cases, where the invention is of a nature requiring searching in widely dispersed specialised fields, a special Search Division consisting of two, or possibly three, examiners may be formed.

International search shall be carried out by an International Searching Authority. The search itself will normally be performed by search containing the work necessary

Art. 17

.../...

CHAPTER III

CHARACTERISTICS OF THE SEARCH

1. The objective of the search

1.1 As stated in VI, 2, the objective of the search is to discover relevant prior art for the purpose of assessing novelty and inventive step. Decisions on novelty and inventive step are the province of the ~~Examination Division. However, in many instances~~ ~~provisional opinions on these issues must be~~ ~~formed by the Search Division in order to~~ ~~enable an effective search to be carried out.~~ Such provisional opinions will be subject to review by the ~~Examination Division~~ at the ~~examination stage.~~

designated Offices

~~1.2 Examples are to be found in paragraph III, 3.9 - Search for subject-matter of dependent claims, III, 2.5 to 2.7 - Search in analogous art, IV, 2.8 - Stopping search when only trivial matter remains, VII, 9 - Lack of unity a posteriori.~~

2 1.3 Occasionally the ~~Search Division~~ will have to form provisional opinions on matters of substantive examination other than novelty or inventive step, in order to be able to proceed with the search or to decide to restrict the search; ~~these~~ ~~opinions~~ these opinions are subject to review by the ~~Examination Division~~ designated Office

International Searching Authority

1.4 Examples are to be found in Chapter VII - Unity of invention and Chapter VIII - Subject-matter excluded from patentability and obscurities etc. preventing a meaningful search.

2. Scope of the search

2.1 The ~~European~~ search is essentially a ~~thorough, high quality, all-embracing search.~~ ~~Nevertheless, it must be realised that in a search of this kind, 100% completeness cannot always be obtained, because of such factors as the inevitable imperfections of any classification system and its implementation, and may not be economically justified if the cost is to be kept within reasonable bounds.~~ international

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The examiner should therefore organise his search effort and utilise his search time in such a manner as to reduce to a minimum the possibility of failing to discover existing highly relevant prior art, such as complete anticipations for any claims. For less relevant prior art, which often exists with a fair amount of redundancy amongst the documents in the search collection, a lower retrieval ratio can be accepted.

2.2 The PCT stipulates in Article 15, paragraph 4, that the International Searching Authority performing the search shall endeavour to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the PCT Regulations. ~~Since the European Patent Office is expected to become an International Searching Authority (PCT, Article 16, paragraph 1, specifically refers to this possibility), and it is clearly desirable for European and international searches to be fully compatible, the above definition of the scope of the search should be regarded as also applicable to the European searches.~~

2.3 This implies first of all that the ~~Search Division~~ in searching an application will, in principle, consult all documents in the relevant classification units of the search files, irrespective of their language or age, or of the type of document. Nevertheless the search examiner should for reasons of economy exercise his judgment, based on his knowledge of the technology in question and of the documentation involved, to omit sections in which the likelihood of finding any documents relevant to the search is negligible, for example documents falling within a period preceding the time

International
Searching Authority

when the area of technology in question began to develop. Similarly he need only consult one member of a patent family unless he has good reason to suppose that, in a particular case, there are relevant substantial differences in the content of different members of the same family.

~~2.4 The question whether certain categories of documents that are of special relevance to the European patent system, and that do not form part of the PCT minimum documentation, such as patent documents of the Scandinavian countries, if included in the search files, will have to be consulted for international searches performed by the Search Service of the EPO, and conversely: whether certain categories of documents that are of special relevance to the PCT, e.g. patent documents of certain countries not contracting to the European patent system, will have to be consulted for European searches, is left open until the matter of the extent of the search documentation of the Search Service of the EPO has been dealt with.~~

4 ~~2.4~~ The search shall be carried out on the basis of the search files which may contain material pertinent to the invention (PCT, Rule 33.2(a)). It should first cover all directly relevant technical fields, and may then have to be extended to analogous fields (PCT Rule 33.2 (b)), but the need for this must be judged by the examiner in each individual case, taking into account the outcome of the search in the initial fields.

5 ~~2.4~~ The question of which arts are, in any given case, to be regarded as analogous shall be considered in the light of what appears to be the necessary essential function or use of the invention and not only the claimed specific function expressly indicated in the application (PCT Rule 33.2 (c)).

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6 ~~2.3~~ The decision to extend the search to fields not mentioned in the application must be left to the judgment of the search examiner, who should not put himself in the place of the inventor and try to imagine all the kinds of applications of the invention possible. The over-riding principle in determining the extension of the search in analogous fields should be whether it is probable that a reasonable objection that there is lack of inventive step could be established on the basis of what is likely to be found by the search in these fields.

3. The subject of the search

3.1 The search should be directed to the invention defined by the claims, as interpreted with due regard to the description and drawings (if any), ~~and to determine the extent of the protection which will be conferred by the European patent if granted (PCT Article 15, paragraph 3, Rule 33.3(a)).~~

and with particular emphasis on the inventive concept towards which the claims are directed.

3.2 This implies that in the search special emphasis should be directed to the inventive concept underlying the invention to which the claims are directed (PCT Rule 33.3(a)). Consequently the search should on the one hand not be restricted to the literal wording of the claims, but on the other hand should not be broadened to include everything that might be derived by a person skilled in the art from a consideration of the description and drawings.

3.3 As a consequence the search should usually embrace also subject-matter that is generally recognised as equivalent to that which is specified in the claims. This applies to the claimed subject-matter as a whole, and also to its individual features (PCT Rule 33.3(d)). For example, if the claim specifies a cable clamp having a certain construction, the search should embrace pipe and similar clamps likely to have the specified construction. Likewise, if the claim is directed to an article consisting of several parts which are defined by their function or structure, and the claim stipulates that certain parts are to be joined, the search should also embrace alternative means of connection, such as sheet metal rivets, if it is clear that within the scope of the invention...

even though, in its specifics, the invention as described is different

equivalent

Art. 92(1)
Art. 69(1), 84

Prot.
Art. 69

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International

3.4 Since the applicant may not amend the claims before receiving the search report, the search will be directed to the claims as originally filed in the European application. Therefore, if the European application derives from an earlier international (PCT) application or national application, but has claims that are different from those of that earlier application (e.g. as a consequence of an international or national search report), the claims as filed in the European application form the basis of the European search (see III, 1.3).

except for correct formal matters which are contrary to the Treaty and are called to applicant's attention by the receiving Office, (for example, Rule 9.2 and Rule 10 do- facts)

3.5 Claims that are deemed to have been abandoned for non-payment of fees must be excluded from the search.

be drawn to inventions for which no fees have been paid

3.6 In principle, and in so far as possible and reasonable, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended (PCT Rule 33.3(b)). For example, where an application relating to an electric circuit contains one or more claims only directed to the function and manner of operation, and the description and drawings include an example with a detailed non-trivial transistor circuit, the search must necessarily include this circuit. Nevertheless, reasons of economy may make certain restrictions necessary, for example when there is a broad claim and many examples and it is not possible to foresee which will be the subject of amended claims.

3.7 No special search effort need be made for searching unduly wide or speculative claims, beyond the extent to which they are supported by the description. For example, if in an application relating to and describing in detail an automatic telephone exchange, the claims are directed to an automatic communication switching centre, the search should not be extended to automatic telegraph exchanges, data switching centres etc., simply because of the broad wording of the claim. Likewise,

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if a claim is directed to a process for manufacturing an "impedance element" but the description and drawings relate only to the manufacture of a resistor element, and give no indication as to how other types of impedance element could be manufactured by the process of the invention, extension of the search to embrace, say, manufacture of capacitors, would not normally be justified.

3.8 The search carried out in the classification units of the search files to be consulted for the main claim(s) must include all dependent claims. Dependent claims should be interpreted as being restricted by all features of the claim(s) from which they depend; therefore, where the subject-matter of the main claim is novel, that of the dependent claims will also be novel. When the patentability of the main claim is not questioned as a result of the search, there is no need to make a further search in respect of the subject-matter of the dependent claims as such. For example, in an application relating to cathode ray oscilloscope tubes, in which the main claim is directed to specific means along the edge of the front of the tube for illuminating the screen, and a dependent claim is directed to a specific connection between the front and the main part of the tube, the search examiner should, in the search files he consults for searching the illumination means, also search for the connecting means whether in combination with the illumination means or not. When after this search the patentability of the illuminating means is not questioned, the examiner should not extend his search for the connecting means to further search files specifically provided for these connections.

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Rule 29(4)

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3.9 However, where the patentability of the main claim is questioned, it may be necessary for assessing inventive step of a dependent claim to establish whether the features of the dependent claim as such are novel by searching one or more additional classification units. No such special search should be made for features that are trivial or generally known in the art. When the dependent claim adds a further feature (rather than providing more detail of an element figuring already in the main claim), the dependent claim in effect constitutes a combination claim and should be dealt with accordingly (see III, 3.10).

3.10 For claims characterised by a combination of elements (e.g. A, B and C) the search should be directed towards the combination; however, when searching classification units for this purpose, sub-combinations, including the elements individually (e.g. AB, AC, BC and also A, B and C separately) should be searched in those units at the same time. A search in additional classification units either for sub-combinations or for individual elements of the combination should only be performed if this is still necessary for establishing the novelty of the element in order to assess the inventive step of the combination.

3.11 When the application contains claims of different categories, these must be included in the search, and even when the application contains only claims of one category, it may be desirable to include other categories in the search. For example, generally, ~~if~~ except when the application contains indications to the contrary, one may assume that in a claim directed to a chemical process, the starting products form part of the state of the art and need not be searched; the intermediate products will only be searched when they form the subject of one or more claims; but the final products will always have to be searched, except when they are evidently known.

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3.12 The examiner should, in general, exclude from his search subjects for which no meaningful search can be made; this may result from certain subjects being excluded from patentability, or from the application being obscure (see Chapter VIII).

the search under PCT Rule 39

3.13 When the claims of the application do not relate to one invention only, nor to a group of inventions so linked as to form a single general inventive concept, the search will normally be restricted to the invention, or to linked group of inventions, first mentioned in the claims (see Chapter VII). ~~Restrictions of the search for the above reasons will be notified to the applicant in a communication separate from the search report.~~

and the required additional fees have not been paid within the prescribed time limit

3.14 In certain circumstances it may be desirable to extend the subject-matter of the search to include the "technological background" of the invention (see IV, 2.4). This would include:

If the additional fees have been timely paid, all inventions covered thereby must also be searched.

- the preamble to the first claim, i.e. the part preceding the expression "characterised by";
- the prior state of the art which is deemed to be known in the introduction of the description of the application but not identified by specific citations;
- the general technological background of the invention (often called "general state of the art").

4. Types of searches

4.1 ~~European searches~~
The task of the Search Service is of course primarily to carry out searches and draw up search reports in relation to European patent applications. In addition to these usual searches, the Search Divisions of the European Patent Office may be called upon to perform various other types of searches, which are listed in the following paragraphs.

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At the examination stage of a European application for patent an additional search may be necessary. The Examining Divisions are not equipped for this purpose other than for completion of the search for conflicting applications (see V, 4); all such search work will invariably be referred back to the Search Division, which should promptly carry out this search. The reasons for such an additional search may be for example:

- a. amendment of claims so that they embrace matter not covered by the original search;
- b. clarification of obscurities, etc. that resulted in an incomplete search under Rule 45 (see VIII, 5);
- c. reversal of a provisional opinion of the Search Division with respect to novelty (Chapter V), lack of inventive step (Chapter VI), unity of invention (Chapter VII), or exclusions from patentability (Chapter VIII);
- d. limitations or imperfections in the initial search.

Rule 45

Rule 46

The Examining Division requesting such an additional search will precisely indicate the reason for the request and the subject-matter to be searched. The Search Division will communicate an account of the additional search performed containing the results obtained, to the Examining Division; this account is not sent to the applicant nor is it published by the Search Division, since any necessary communication resulting from it will be the responsibility of the Examining Division.

4.3 Supplementary European searches

An international (PCT) application, for which the European Patent Office acts as designated Office or elected Office shall be deemed to be a European patent application. Where an international (PCT) search report is already available this will take the place of the European search report. In those cases the Search Division will draw up a supplementary European search report. However, the Administrative Council may decide under what conditions and to what extent the supplementary European search report is to be dispensed with. Details about the supplementary search report and the supplementary search report

Art. 150(3)

Art. 157(1)

Art. 157(2)(a)

Art. 157(3)

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noted that in case of conflict the provisions of the PCT prevail over those of the EPC.

4.4 International (PCT) searches

When the European Patent Office acts as an International (PCT) Searching Authority in accordance with Article 154 (PCT Article 16, paragraph 1) it is anticipated that the international searches it performs and the international search reports it draws up, will be identical with, or very similar to, European searches and search reports. (A list of differences will be included here later.)

4.5 International-type searches

Under the PCT, the European Patent Office, as an International Searching Authority, may be entrusted to carry out "international-type searches" for national patent applications (PCT Article 15, paragraph 5). These searches are by definition similar to international searches, and the same considerations will apply.

CHAPTER IV

SEARCH PROCEDURE AND STRATEGY

1. Procedure prior to searching

1.1 When taking up an application to be searched, the search examiner should first consider the application in order to determine the subject of the claimed invention taking account of the guidance given in III, 3. For this purpose he should make a critical analysis of the claims in the light of the description and drawings. Although he need not study all details of the description and drawings, he should consider these sufficiently to identify the problem underlying the invention, the insight leading to its solution, the means essential to the solution as particularly reflected in the technical features thereof found in the claims, and the results and effects obtained.

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Art. 78
Rules 26-36

Art. 53(a)
Rule 34

1.2 If the search examiner notices any formal shortcomings which have been overlooked by the Receiving Section, he should call these to the attention of the Receiving Office Section (or of the Examining Division in the case of an additional search requested by that Division), which will take appropriate action. Similarly, if he notes matter contrary to "ordre public" or morality or disparaging statements which ought to be omitted from the application as published, he should notify the Receiving Section. Applicant

1.3 Documents cited in the application under consideration should be examined if they are cited as the starting point of the invention, or as showing the state of the art, or as alternative solutions to the problem concerned, or when they are necessary for a correct understanding of the application; however, when such citations clearly relate only to details not directly relevant to the claimed invention, they may be disregarded. If the application cites a document that is not published or otherwise not accessible to the Search Division, and the document appears essential to a correct understanding of the invention to the extent that a meaningful search would not be possible without knowledge of the content of that document, the Search Division should inform the search and request the applicant to provide first a copy of the document. International Searching Authority International Searching Authority may

Rule 37
Rule 33

Art. 53(a)

1.4 The examiner should then consider the abstract in relation to the requirements laid down in the Implementing Regulations (see Chapter XI). Since the abstract should relate to the application as filed, the examiner should consider it and determine its definitive content before carrying out the search, in order to avoid being inadvertently influenced by the results of the search. However, if there are initial obscurities, which are cleared away in the course of the search, he may have to return to the abstract after the search is completed. if possible to do so within the time limits for the preparation of the international search report under the Treaty

CHAPTER IV

2.6 The examiner should continuously evaluate the results of his search, and if necessary reformulate the subjects of the search accordingly. The selection of the classification units to be searched or the order of searching them may also require alteration during the search as a consequence of intermediate results obtained. The examiner should also use his judgment, taking into account results obtained, in deciding at any time during or after the systematic search, whether he should approach the search documentation in some different manner, e.g. by consulting documents cited in the description of documents produced by the search or in a list of references of such documents, or whether he should turn to documentation outside that which is available to the Search Divisions in the search files.

2.7 If no documents of a more relevant nature for assessing novelty and inventive step are available, the examiner should consider citing any documents relevant to the "technological background" of the invention (see III, 3.14), which he may have noted during the search. Generally speaking, no special search effort will be undertaken for this purpose; however, the examiner may exercise his discretion here in special cases. In exceptional cases a search may be completed without any relevant document having been found.

2.8 Reasons of economy dictate that the search examiner uses his judgment to end his search when the probability of discovering further relevant prior art becomes very low in relation to the effort needed. The search may also be stopped when documents have been found clearly demonstrating lack of novelty or inventive step in the entire subject-matter of the claimed invention and its elaborations in the description, apart from features which are trivial or common general knowledge in the field under examination. The search for such documents should be stopped when the examiner has reached the point where the probability of discovering further relevant prior art becomes very low in relation to the effort needed.

CHAPTER IV

3. Procedure after searching

3.1 After completion of the search, the examiner should select from the documents retrieved, the ones to be cited in the report. These should always include the most relevant documents (which will be specially characterised in the report, PCT Rule 43.5(c)). Less relevant documents should only be cited when they concern aspects or details of the claimed invention not found in the documents already selected for citation. In cases of doubt or borderline cases in relation to novelty or inventive step, the search examiner should ~~also refer to~~ make citations ~~the Examining Division~~ designated Offices ~~the opportunity to~~ consider the matter more fully.

3.2 To avoid incurring costs unnecessarily, the examiner should not cite more documents than is necessary, and therefore when there are several documents of equal relevance the search report should not normally cite more than one of them. Where more than one member of the same patent family is present in a search file, the search need not discover all of them nor need the search report cite all of them. In selecting from these documents for citation, the examiner should pay regard to language convenience, and preferably cite (or at least note) documents in the language of the application. ~~(This is in accordance with a decision taken by IC/TCO/TCO at its November 1974 meeting. Further details still to be elaborated.)~~

3.3 Finally the examiner should prepare the search report, and where necessary, the internal search note (see Chapter X).

3.4 It may happen occasionally, that after completion of a search report, the Search Division discovers further relevant documents (even in a later search for a related application). These should be added to the search report up to the time that preparations for its publication are completed. Thereafter, such later discovered documents should be brought to the attention of the designated Office via the International Searching Authority.

International
Searching
Authority

Designated Office
via the International
Bureau

THE STATE OF THE ART

1. Prior art generally

1.1 An invention shall be considered to be novel if it does not form part of the state of the art (PCT Art. 33, paragraph 2). A claimed novel

1.2 The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the international patent application (PCT Rule 33.1(a) and (b)). prior art as defined in the Regulations

1.3 It is to be noted that there is no restriction whatever with respect to the geographical place where, or the language or manner in which, the relevant information was made available to the public; also no age limit is stipulated with respect to documents containing this information.

2. Novelty

2.1 In considering novelty, the documents constituting the state of the art should be considered separately; consequently it is not permissible to combine or mosaic separate documents together.

2.2 A document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from the document when considered in the light of common general knowledge, including any features implicit to a person skilled in the art in what is explicitly contained in the document, e.g. a disclosure of the use of rubber takes away the novelty of the use of an elastic material.

2.3 A prior document should be construed only in the light of knowledge available at the time the document was published, and excluding any knowledge subsequently discovered.

2.4 In considering novelty it should be borne in mind that a generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but that a specific disclosure does take away the novelty of any generic claim embracing that disclosure.

CHAPTER V

3. Prior art, - oral disclosure etc.

3.1 The PCT according to its Rule 33.1(a) and (b) recognizes oral disclosure, use, exhibition, etc., as prior art only when this is substantiated by a written disclosure, which may have been published after the filing date of the application under consideration. Although the PCT does not contain a specific provision, the same practice should be followed for the European search. The cases in which the search examiner knows of an oral disclosure, etc., without a written confirmation will be very rare, and in those cases he could mention the earlier oral disclosure only in the international search report.

4. Prior art, - conflicting applications

Art. 34(3),
Art. 56

purpose of determining novelty, the state of the art is considered to comprise the content of European applications as filed, of which the dates of filing are prior to the filing date of the application under consideration, and which were published as European applications on or after that date (herein referred to as conflicting applications). This provision will, however, only be applied in so far as a Contracting State designated in the latter application was also designated in respect of the earlier application as published (PCT Rule 33.1(c)).

Art. 54(4)

4.2 The prior art also includes as conflicting applications international (PCT) applications whose dates fall within the "intervention period", designating, for the purpose of obtaining a European patent, a European State which is a contracting party to both the PCT and the EPC systems, and which is also designated in the European application under consideration.

Art. 153(1)
Art. 158(1)

4.3 Since the Search Division will not verify the justification of the claimed priority dates, there may be uncertainty as regards 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

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Art. 54(3)

Art. 85

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 (see Guidelines for substantive examination, Chapter IV, 6.1).

4.5 Generally it will not be possible at the time of the search to make a complete search for conflicting European and international applications. This search will therefore have to be completed at the examination stage by the Examining Division which for this purpose will have available classified search files of these published applications. The Search Divisions should therefore not attempt to discover as yet unpublished conflicting applications, nor to undertake special documentation efforts to allow a search thereof; however, when the search examiner knows of such an application, he should mention it in the internal note, but he must not cite it in the search report.

4.6 There may also be ~~national~~ applications of ~~one or more States~~ ~~originating in the European application~~ and coming within the "intervention period". Any of these which are present in the search files should be noted and mentioned in the search report for information (PCT Rule 33.1(c)).

5. Date of reference; filing and priority date

5.1 Since the ~~Search Division~~ is not responsible for the verification of any claimed priority date (which in the examination stage takes the place of the filing date for assessing prior art and determining precedence), the basic reference date for the search must be taken as the date of filing of the ~~European~~ application as accorded by the receiving ~~national~~ ~~office~~ ~~in accordance with PCT Rule 33.1(a)~~.

International Searching Authority

international

Office (

Art. 80, 82

Art. 83(2)

CHAPTER V

5.2 The ~~Search Division~~ will therefore include documents published between the priority date or dates and the filing date of the application under consideration, and these must be identified as such in the search report. For identifying these documents when an application has more than one priority date, the oldest date is to be applied for this purpose. When deciding which documents to select for citing in the search report, the examiner will have to refer to these dates and should preferably choose any published before the date of priority. Thus for example, where there are two equally relevant documents one published before the date of priority and the other after that date but before the date of filing, he should choose the former (see IV, 3.2).

International Searching Authority

5.3 It is the responsibility of the ~~Examining Division~~ designated Office to check whether and to what extent the priority claim is justified; therefore the ~~Search Division~~ will not check whether the contents of the ~~European~~ application correspond to those of the priority application(s). ~~Nevertheless, documents showing that a priority claim might not be justified (e.g. an earlier application or patent resulting therefrom, by the same applicant indicating that the application from which priority is claimed may not be the first application for the invention concerned), should be drawn to the attention of the Examining Division.~~

International Searching Authority

international

No special search beyond the filing date of the application should normally be made for this purpose, except when there is a special reason to do so, e.g. when the priority application is a "continuation in part" of an earlier application from which no priority is claimed; also sometimes the country of residence of the applicant being different from the country of the priority application may be an indication of possible lack of first filing, justifying a ~~certain extension of the search.~~

5.4 When the search is extended for this purpose, it should cover the published applications filed up to one year after the filing date of the application under consideration, for the reasons given in V,

CHAPTER V

5.1 The search will not normally take into consideration documents published after the filing date of the application. However, some extension may be necessary for specific purposes, as is apparent from V.3, ~~V.4~~ and V.5.3

4.1.

5.5 ~~5.6~~ Certain other situations may occur in which a document published after the filing date is relevant; examples are a later document containing the principle or theory underlying the invention, which may be useful for a better understanding of the invention, or a later document showing that the reasoning or the facts underlying the invention are incorrect. The search should not be extended for this purpose, but documents of this nature known to the examiner could be selected for citation in the report.

~~5.7 Disclosure of the invention occurring no earlier than six months preceding the filing of the European patent application and due to an evident abuse in relation to the applicant or his legal predecessor, or due to display at an officially recognised international exhibition, should not be taken into consideration in determining novelty. The Search Division should, nevertheless, cite in the search report any documents it has reason to believe come within one of the categories mentioned. In this case too the reference date for the search will be the filing date of the application (see V.5.1). Since the matter of abuse will generally only be raised after the transmission of the search report, and the disclosure at an exhibition involves the question of identity between the displayed and claimed invention, both matters are better resolved by the Examining Division.~~

6. Contents of prior art disclosure

6.1 As a general rule the ~~Search Division~~ will select for citation only documents which are present in its search files or which it has access to in some other manner; in that way no doubt will exist about the contents of the documents cited, since the search examiner will generally have physically inspected each document cited.

International Searching Authority

CHAPTER V

6.2 However, under certain circumstances a document whose contents have not been verified may be cited, provided there is justification for the assumption that there is identity of contents with another document which the examiner has inspected. For example, instead of the document published before the filing date in an inconvenient language and selected for citation, the search examiner may have inspected a corresponding document (e.g. another member of the same patent family, or a translation of an article) in a more convenient language and possibly published after the filing date; also the ~~Search Division~~ **International Searching Authority** may assume that, in the absence of explicit indications to the contrary, the contents of an abstract are contained in the original document. Also the examiner should assume that the contents of a report of an oral presentation are in agreement with that presentation ~~(any necessary explanation should be in the interest of search report).~~

6.3 Before citing documents in a language with which he is not familiar, the search examiner should satisfy himself that the document is relevant (e.g. through translation by a colleague, through a corresponding document or abstract in a familiar language, or through a drawing or chemical formula in the document).

7. Matters of doubt in the state of the art

7.1 Since decisions with respect to novelty are not the responsibility of the ~~Search Division~~ but of the ~~Examining Division~~, the ~~Search Division~~ should not discard documents because of doubt as regards for example the exact date of publication or public availability, or the exact contents of an oral disclosure, exhibition etc. to which such documents may refer. The ~~Search Division~~ should try to remove whatever doubt may exist and should not cite the documents concerned in the report unless the doubt is removed or very little doubt remains; additional documents providing evidence in the matters of doubt may be cited. Comments on these documents, as well as citation of documents for which greater doubt remains, should be made in the ~~national search report~~ report citation page

International Searching Authority designated Offices International Searching Authorities

International Searching Authority

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CHAPTER VI

INVENTIVE STEP

- 1. An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. (PCT Art. 33(4), Rule 33.1(a)). at the pro-scribed date
- 2. In evaluating inventive step the ~~Examination~~ designated Office Divisions will have to consider this in relation to all aspects of the claimed invention, such as the underlying problem (whether explicitly stated in the application or implied), the insight upon which the solution relies, the means constituting the solution, and the effect or results obtained. Therefore, the search will take all these aspects into consideration.

~~3. European applications of earlier filing date but published on or after the date of filing of the application under consideration are not to be considered when assessing inventive step (but only when assessing novelty).~~

(Further sections explaining the concept of inventive step in greater detail to the extent that this is useful for the purpose of searching, will be extracted from the Guidelines for substantive Examination that are under preparation by Working Party III, in consultation with that Working Party).

CHAPTER VII

UNITY OF INVENTION

- 1. The ~~European patent~~ international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept" (PCT Rule 13.1). If the ~~Search Division~~ International Searching Authority considers that the application does not comply with the requirement of unity of invention, it must search, and draw up the search report for, those parts of the application which relate to the invention (or group of inventions forming unity) first mentioned in the claims (PCT Art. 17(3)(a)).

and those parts of the application which relate to inventions for which additional fees have been paid.

CHAPTER VII

- 2. The ~~Search Division~~ International Searching Authority will inform the applicant of the lack of unity of invention in a communication separate from the search report. The other invention(s) or group(s) of inventions will be searched and separate ~~search reports therefor will be prepared, only~~ International Searching Authority if the applicant pays the additional fees. These payments must take place within a period to be set by the ~~Search Division, which may not~~ International Searching Authority be less than two weeks and may not be more than six weeks. (PCT Art. 17(3)(a) and Rule 40.3)

3. At the ~~examination stage~~ International Searching Authority the applicant may protest ~~contest the allegation of non-unity and request a refund of the additional fee(s) paid.~~ or that the amount of the additional fee is excessive If the ~~Examination Division~~ International Searching Authority finds the protest justified the fee(s) will be refunded. (compare PCT Rule 40.2(c)).

- 4. From the preceding paragraph it is clear that the decision with respect to unity of invention rests with the ~~Examination Division~~ International Searching Authority. Consequently the criteria to be applied in this respect by the ~~Search Division~~ International Searching Authority should not be different from those applied by the ~~Examination Division~~ International Searching Authority. In particular the ~~Search Division~~ International Searching Authority should not raise objection of lack of unity merely because the inventions claimed are classified in separate classification units, if merely for the purpose of restricting the search to certain classification units.

5. As indicated in VII, 1 the basic ~~criteria~~ (*) for unity of invention is the presence of a ~~single~~ general inventive concept. Consequently, the mere fact that an application contains several independent claims of the same category or claims of different categories is in itself no ground for objection of lack of unity of invention.

- 6. Rule 13.2 particularly specifies certain 13.2 combinations of different categories that should not be objected to on the grounds of lack of unity. (*)

CHAPTER VII

~~And in addition to an independent claim for a product, an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for a use of the product; or~~

(b) In addition to an independent claim for a process, an independent claim for an apparatus or means specially designed for carrying out the process; or

(c) In addition to an independent claim for a product, an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for an apparatus or means specially designed for carrying out the process.

(Similarly for Rule 13(2). Other combinations may be acceptable provided there is a common inventive concept.

(Further guidance with respect to the application of the criteria for unity of invention in specific situations will be extracted from the Guidelines for Substantive Examination under preparation by Working Party III, in consultation with that Working Party.)

7. Lack of unity of invention may also exist within a single claim where the claim contains alternatives which are not limited by a single general inventive concept; and the objection should be raised.

as to lack of unity

8. Objection of lack of unity does not normally arise because a claim contains a number of individual features in combination even if these are unrelated (see III, 3.10).

~~It should be noted that an objection of lack of unity should be raised with respect to a dependent claim and the claim from which it depends (see III, 3.6 and 3.7).~~

9. Lack of unity of invention may be directly evident "a priori", i.e. before considering the claims in relation to any prior art, or may only become apparent "a posteriori", i.e. after taking the prior art into consideration, e.g. a document discovered in the search shows that there is lack of

.../...

CHAPTER VII

novelty or inventive step in a claim, leaving two or more dependent claims without a common inventive concept. In the latter case the search examiner may raise the objection of lack of unity and limit the search to the invention (or group of inventions) first mentioned in these dependent claims, ~~disregarding the other claims in the claim.~~ **International Searching Authority limit if no additional search fee is paid.**

10. Where the search examiner finds a situation of lack of unity of invention to exist, reasons of economy may make it advisable to search the additional invention(s) together with the invention mentioned first in the claims, in the classification units consulted for the latter invention if this takes little or no additional search effort. ~~Of lack of unity is noticed, the results of the search for the additional invention(s) may not be made part of the search report, but must be kept for a later additional search report if this is requested and the additional fees are paid.~~ The search for such additional invention(s) will then have to be completed in any further classification units which may be relevant.

11. Occasionally in cases of lack of unity, especially "a posteriori", the examiner will be able to make a complete search for both or all inventions with negligible additional work, in particular when the inventions are conceptually very close and none of them requires search in separate classification units. In those cases, the search for the additional invention(s) should be completed together with that for the invention first mentioned. All results should then be included in a single search report, and no objection of lack of unity should **ordinarily** be raised.

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CHAPTER VIII

When in a supplementary European search following an international (PCT) search a problem of unity of invention arises, the Search Division should avoid whenever possible deviations from the position taken by the International Search Authority in the international search report, except where the claims have been changed, or the interpretation of the rules regarding unity of invention was clearly incorrect. It should be borne in mind that in case of conflict, e.g. because certain differences in the provisions relating to claims of different categories in EPC Rule 30 and PCT Rule 13(2), the provisions of the PCT prevail. When as a result of the supplementary search lack of unity "a posteriori" is found to exist, the Search Divisions should act accordingly (see part VII-5).

Art. 150(2)

Art. 157(2)(a)

CHAPTER VIII

SUBJECTS TO BE EXCLUDED FROM THE SEARCH

1. ~~Article 53 specifies certain subjects which~~ **Rule 39**
~~are not to be regarded as patentable~~
~~inventions, which Article 53 specifically~~ (need not be searched) (*)
excludes certain matter from patentability (PCT Art. 17(2)(a)(i), Rule 39-47). The search files need not, and in general do not, contain such subject-matter, so that a meaningful search therefor is not possible and a declaration to that effect takes the place of the search report (PCT Art. 17(2)(c)).
2. This situation may also occur for part of the claims, in which case a partial search is made, and the partial search report is then supplemented with a declaration.
3. ~~Although a decision on these matters rests~~
~~with the Examining Division, nevertheless,~~
~~provisional opinions on these matters must~~
~~be sometimes furnished by the Search Division,~~
~~which will thus have to consider the require-~~
~~ments for patentability other than novelty~~
~~and inventive step. In particular it may be~~
~~necessary to consider any of the following~~
~~questions:~~

Art. 52(1)

Art. 52(2) to (4) 53(b)

(Rule 45)

CHAPTER VIII

Art. 52(2)

(i) whether a claimed invention belongs to the categories excluded from being regarded as patentable inventions in Article 52, paragraph 2, i.e.

"(a) discoveries, scientific theories and mathematical methods;

(b) aesthetic creations;

(c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;

(d) presentations of information";

or

Art. 52(4)

(ii) whether the invention is susceptible of industrial application having regard to Article 52, paragraph 4, i.e. whether it is a method for treatment of the human or animal body by surgery or therapy, or a diagnostic method 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 excluded from patentability, 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;

Art. 54(5)

(iii) whether the subject-matter is excepted from patentability having regard to Article 53, sub-paragraph (b), i.e. "plant or animal varieties or essentially biological processes for the production of plants or animals" (note however that this exception does not apply to micro-biological processes or the products thereof) (PCT Art. 17(2)(c)).

Art. 53(b)

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CHAPTER VIII

Rule 45

3 In cases of doubt the Search Division should carry out the search to the extent that this is possible in the available documentation.

International Searching Authority

4 A further situation where a meaningful search is not possible or only partially possible, and where a declaration to this effect may take the place of or supplement the search report, may result from the application containing obscurities, inconsistencies or contradictions to the extent that it is impossible to arrive at a reasonable conclusion as to the scope of the claimed invention. The Search Division in these cases may not suspend the search, ask for clarification, and after receipt thereof continue the search, but should make a meaningful search to the extent that this is possible. When later clarifications are received, these will be considered by the Examining Division (which then may request the Search Division to perform an additional search, see III, 4.3).

International Searching Authority

PCT Art. 17(2) (a)(ii).

CHAPTER IX. - SEARCH DOCUMENTATION

CHAPTER X. - SEARCH REPORT

CHAPTER X - Y

Effect of Search Report

Y.1 After receipt of the search report the applicant may amend the description, the drawings and (in particular) the claims (similarly: PCT Art. 19 (1)).

before the International Bureau

Also if the request for examination was made before the issue of the search report, the applicant will be invited to confirm the request.

Y.2 After publication of the application and the search report the applicant may file amendments which will be taken into consideration by the Examining Division at the examination stage.

The amendments can not go beyond the disclosure of the international application as filed.

Rule 60(2)

Art. 90(1)

Art. 115

Art. 95

Y.3 After publication of the search report and filing (or confirmation) of a request for examination, the Examining Division will examine the application, basing its assessment of novelty and inventive step upon the prior art mentioned in the search report. This is dealt with in the Guidelines for Substantive Examination (PCT Art. 33(6), Rule 62.1(b)).

Art. 90(2)

Rule 41(1)

CHAPTER XI

THE ABSTRACT

Rule 47

Rule 49

1. The search examiner has the task of determining the definitive content of the abstract which is initially supplied by the applicant, and which will subsequently be published with the application or later. In doing this he should consider the abstract in relation to the application as filed (see IV, 1.4) (PCT Rule 38.2(b); Rule 48.2(a)(iii)).

2. In determining the definitive content the examiner should take into consideration that the abstract is merely for use as technical information, and in particular must not be used for the purpose of interpreting the scope of the protection sought. The abstract should be so drafted that it constitutes an efficient instrument for purposes of searching in the particular technical field, and should in particular make it possible to assess whether there is need for consulting the European patent application itself (PCT Rule 8.3).

Art. 85

Rule 33(5)

3. The abstract must

Rule 33(1)

Rule 33(2)

- i. indicate the title of the invention
- ii. indicate the technical field to which the invention pertains,
- iii. contain a concise summary of the disclosure as contained in the description, claims and drawings, which must be so drafted as to allow a clear understanding of the technical problem, the gist of the solution of that problem through the invention and the principal use of the invention, and where applicable, it should contain the chemical formula which, among those contained in the application, best characterises the invention.

assisting the scientist, engineer or researcher in international

meet the requirements of Rule 8.

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CHAPTER II

~~iv. may contain statements on the alleged merits or value of the invention or its speculative application,~~

~~v. preferably not contain more than one hundred and fifty words,~~

~~vi. be accompanied by an indication of the figure or exceptionally more than one figure of the drawings which should accompany the abstract. Each main feature mentioned in the abstract and illustrated by a drawing, should be followed by a reference sign in parenthesis (PCT Rule 8.1).~~

~~Rule 33(4)~~ 4. The examiner should consider not only the text of the abstract but also the selection of the figures for publication with it. He should alter the text to the extent that this may be necessary in order to meet the requirements set out in ~~vi, 5~~. He may select a different figure, or figures, of the drawings if he considers that they better characterise the invention, (PCT Rule 8.2). In determining the definitive content of the abstract, the examiner should concentrate on conciseness and clarity, and refrain from introducing alterations merely for the purpose of embellishing the language.

Rule 8

and note it in the search report

[End of Document]

[Part II follows/1a partie II suit]

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JF/EMH/jf

January 20, 1976

Dear Chairman Maksarev,

Referring to the last session of the PCT Interim Committee for Technical Cooperation (October 29 to November 3, 1975), I wish to convey to the State Committee for Inventions and Discoveries of the USSR Council of Ministers the appreciation of the International Bureau of WIPO for the indication given to the Interim Committee by the Delegation of the Soviet Union that the State Committee would be willing to review its general comments set out in document PCT/TCO/V/18, in connection with the Guidelines for Searches under the PCT contained in document PCT/TCO/V/12, two copies of which are attached (see, in particular, paragraph 70(ii) of the report of the fifth session of the Interim Committee, document PCT/TCO/V/20).

The further comments of the State Committee will be reflected in a working document establishing Guidelines for Searches under the PCT which is now in the course of preparation and which will be submitted to the next meeting of the Interim Committee for Technical Cooperation. It would facilitate our work greatly to have your further comments at your earliest convenience and, if possible, not later than the end of February.

The International Bureau is, of course, at your disposition for any assistance it may be able to render in this matter.

Sincerely yours,

Felix A. Sviridov
Deputy Director General

Mr. Yuri E. Maksarev
Chairman
The State Committee for Inventions and
Discoveries of the USSR Council of Ministers
M. Cherkassky per. 2/6
Moscow (Centre)
Soviet Union

Response of the State Committee for Inventions and Discoveries of the USSR Council of Ministers with respect to the EPO Guidelines.

TRANSLATION

prepared by the International Bureau

State Committee for Inventions and Discoveries of the USSR Council of Ministers, Moscow.

No. 14/11-4726/45

February 25, 1976

Dear Mr. Sviridov,

In reply to your letter of January 20, 1976 concerning the preparations of the Guidelines for Searches under the PCT, I am sending you herewith an "Outline of the Guidelines for Searches under the PCT" in addition to our observations stated in document PCT/TCO/V/18. This Outline concerns methods of searching, but makes no reference to the introductory part as well as certain other parts of the aforementioned Guidelines. The Outline consists of five parts which are arranged in accordance with the sequence of the work performed by a search examiner.

Many items of the said Outline are identical to the first draft of the Guidelines for Searches under the PCT submitted at the last session of the PCT Interim Committee for Technical Cooperation (document PCT/TCO/V/12). Several items of our Outline take into account the observations of the US Patent and Trademark Office submitted in document PCT/TCO/V/14. Finally, the remaining items of the Outline take into account the "Provisional Guidelines" which have been used in our Office to carry out test searches under the PCT.

The references to pertinent Chapters and items of the first draft of the Guidelines for Searches under the PCT have been included in the margins of our Outline to facilitate comparison of our Outline with the aforementioned Guidelines. It is hoped that our present Outline will aid the work of the International Bureau whenever it prepares the new draft of the Guidelines for Searches under the PCT to be presented for discussion at the next session of the PCT Interim Committee for Technical Cooperation.

Sincerely yours,

L. Komarov
Deputy Chairman of
the State Committee

Mr. F. Sviridov
Deputy Director General
WIPO
Geneva
Switzerland

PCT/TCO/VI/8
ANNEXE C, PART II/ANNEX C, PART II

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-4726/45

25.2.76.

ЗАМЕСТИТЕЛЮ ГЕНЕРАЛЬНОГО ДИРЕКТОРА
ВСЕМИРНОЙ ОРГАНИЗАЦИИ ИНТЕЛЛЕКТУАЛЬНОЙ
СОБСТВЕННОСТИ

г-ну Ф.СВИРИДОВУ

32, Шенен де Коломбет,
1211, Женева, 20
Швейцария

Уважаемый господин Свиридов !

Ссылаясь на Ваше письмо от 20 января 1976 г. относительно подготовки Руководства по поиску РСТ, и в дополнение к нашим замечаниям, изложенным в документе РСТ/ТСО/У/18, направляю Вам материал под названием "Фрагменты руководства по поиску в соответствии с РСТ".

Этот материал, касающийся методических вопросов, проведения поиска, и не затрагивающий вводной части, а также ряда других частей Руководства, содержит пять разделов, расположенных, как нам представляется, в соответствии с порядком работы эксперта - поисковика.

Многие пункты прилагаемого материала имеют формулировки, идентичные формулировкам первого проекта (документ РСТ/ТСО/У/12), ряд пунктов учитывает замечания Патентного ведомства США (документ РСТ/ТСО/У/14), а некоторые пункты сформулированы с учетом "Временного руководства", используемого в нашем ведомстве при проведении пробных поисков РСТ.

2.

Для удобства использования прилагаемых "фрагментов руководства по поиску в соответствии с РСТ", на полях проставлена нумерация соответствующих глав и пунктов первого проекта.

Мы надеемся, что указанный материал облегчит работу Международного бюро при подготовке нового проекта Руководства для рассмотрения на следующем заседании Временного Комитета по техническому сотрудничеству.

С искренним уважением



И. Комаров

Заместитель Председателя
Государственного комитета

Outline of the Guidelines for Searches
under the PCT

The Objective of the Search

III, 1.1 1. The objective of the search is to discover relevant prior art concerning the claimed invention. Relevant prior art shall consist 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.

2. The search should be directed to revealing the prior art which is relevant to the claimed invention and the subsequent selection of the restricted number of references to be included in the search report.

IV, 3.1 3. In the first place, during the search, it is necessary to reveal the documents which might require restriction of the claims filed by the applicant. If, during the search, such documents have not been found, it is necessary to select a restricted number of documents to be included in the search report which reflect the relevant prior art and which allow the formulation of an opinion on whether the claimed invention appears to be novel, to involve an inventive step, or to be industrially applicable.

4. The international search should be formally separated from subsequent examination. During the search, formal conclusions concerning novelty, inventive step and industrial applicability should not be made, but the documents found as the result of such search should provide a basis for subsequent decisions on these questions.

The Subject of the Search

III, 3.2 5. The search shall be made on the basis of the claims, with due regard to the description and the drawings. The search shall cover the entire subject-matter to which the claims are directed, or to which they might reasonably be expected to be directed in accordance with the contents of the application. Consequently, the search should, on the one hand, not be restricted to the

literal wording of the claims, but, on the other hand, should not be broadened to include everything that might be obvious to a person skilled in the art. In determining the subject of the search, special attention should be paid to the inventive concept to which the claims, as they are filed by the applicant, are directed.

- III, 3.3 6. The subject of the search should embrace all subject matter that is generally recognized as equivalent to the subject matter of the claimed invention for all or certain of its features, even though the specific features of the invention as disclosed in the international application are different. For example, if the claim specifies a cable clamp having a certain construction, the search should embrace pipe and similar clamps likely to have the specified construction.
- III, 3.6 7. In principle, and insofar as is possible and reasonable, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended. For example, where an application relating to an electric circuit contains one or more claims only directed to the function and manner of operation, and the description and drawings include an example with a detailed non-trivial transistor circuit, the search must necessarily include this circuit. Nevertheless, reasons of economy may make certain restrictions necessary, for example, when there is a broad claim or many examples.
- III, 3.7 8. No special search effort need be made to extend the subject-matter of the search if the claims are too broad and they are poorly supported by the description or if the claims are too speculative.
- III, 3.8 9. The subject-matter of the search must include all dependent claims. Any dependent claim should be construed as including all the limitations contained in the claim from which it depends. Taking into consideration dependent claims is especially important. When a dependent claim gives not only more detailed enumeration of what has already been said in the independent claim, but also adds new features of the invention, such a dependent claim is specially taken into consideration.
10. The search of certain claims may not be carried out if such claims were unsatisfactorily drafted, that is, if they do not add new features to the subject-matter of the search. However, if the description provides a basis for proper amendment of the claim, such amended claim should be taken into consideration during the search.

III, 3.10 11. If the claims are characterized by a combination of elements (e.g. A B C), the subject of the search should include such a combination, as well as combinations AB, AC, BC and elements A, B, C taken separately if a possibility of such combinations and elements is obvious to a person skilled in the art.

III, 3.14 12. When determining the subject-matter of the search, it is also necessary to take into account:

- the preamble of the claim;
- the reference documents cited by the applicant;
- the general technological background of the invention.

13. In the course of the search, depending on the results obtained, the need may arise to clarify the subject-matter of the search, but it should be avoided by means of paying attention to the complete determination of the subject-matter of the search at the very beginning, in order to exclude duplication of work during the study of the documentation to be searched.

Scope of the Search

14. The scope of the search is determined by those information sources which are used during the search. The scope of the search depends on subject-matter of the search, peculiarities of the search files as well as those documentation sources wherever the necessary information could be found.

III, 2.2 15. For the purposes of the international search, the following patent documentation (PCT minimum documentation) of the following countries must be used:

United States of America, former Reichspatentamt of Germany, Federal Republic of Germany, the United Kingdom, France, Switzerland, published in and after 1920, as well as of patent documentation of the Soviet Union and Japan for which abstracts in the English language are available.

16. The international search should also be carried out on non-patent literature (scientific-technical journals, books, reference literature, booklets of firms, exhibition catalogues,

abstracts, journals, etc.) and, in particular, on those periodicals which should be included in the PCT minimum documentation.

- IV, 2.2 17. To determine the scope of the search, it is necessary to carry out the detailed classification of the claimed invention in accordance with IPC and the national classification systems of the inventions of those countries whose patent collections must be taken into consideration during the search. It is necessary to bear in mind that the process of classification, when determining the scope of the search, has many aspects and it should be carried out with due regard to particulars of national systems of classification of inventions, as well as the particulars of the search files. Thus, the determination of the scope of the search on the basis of patent documentation consists of the determination of the classification units of the search files which should be studied during the search. The completeness of the search depends on the correct determination of the scope of the search.
- III, 2.1 18. It must be realized that, 100% completeness of search cannot always be obtained, because of the inevitable imperfections in any classification system, as well as because of the fact that too broad a search may not be economically justified. The search examiner should, therefore, organize his search effort in such a manner as to reduce to a minimum the possibility of failing to discover the material which is necessary to carry out subsequent examination, for example, the material which anticipates the novelty of the claimed invention. If there are too many documents and it is impossible to study them within the time devoted to the search, the scope of the search may be reduced numerically but the reasons for this should be noted and should be annexed to the search report, since, if it is necessary, the decision may be taken to continue the search.
- III, 2.3 19. The search examiner should, based on his knowledge of the technology in question and of the documentation involved, omit those sections of the search collections in which the likelihood of finding any document relevant to the subject of search is negligible. For example, documents falling within a period preceding the time when the area of technology in question began to develop.

III, 2.5 20. The search should first cover the technical field directly relevant to the subject-matter of the invention in question and may also then have to be extended to analogous fields, but the need for this must be judged by the examiner in each individual case, taking into account the outcome of the search in the main field, for example, when, in the main field, the sufficient relevant material for discovering prior art has not been found.

III, 2.6 21. The question of which arts are, in any given case, to be regarded as the main fields or analogous fields, shall be considered not only in the light of the specific functions expressly indicated in the application, but also in the light of what appears to be the most essential function or field of use of the claimed invention.

III, 2.7 22. The decision to extend the search to analogous fields of technology not mentioned in the claimed invention must be left to the judgement of the search examiner who should not put himself in the place of the inventor. The main principle in a solution to this question is whether it is possible to find material in one or another field of search which anticipates the novelty or inventive step of the claimed invention.

23. The scope of the search should be determined before the search is carried out and the scope of the search should be decided upon during implementation of the search.

Search Strategy

24. The search examiner should begin the search after the determination of the subject-matter of the search and scope of the search.

IV, 1.3 25. Documents cited by the applicant himself should be examined to find out if they show the state of the prior art, if they disclose alternative solutions, or if documents are necessary for a correct understanding of the international application. If the claimed invention cites a document that was not published or otherwise not accessible to the search examiner, although this document is necessary, the examiner should take the necessary steps in order to invite the applicant to provide a copy of the document.

- IV, 2.1 26. It is desirable for the search examiner to prepare, for his own purposes, a written search plan in accordance with subject-matter of the search and classification units of the field of search. In some instances, the claims may themselves serve this purpose and the search can be started from main claim(s). In other instances, an additional study is necessary to take into account all aspects or features of the invention. It may be necessary at the first stage of the search that the search examiner would also have to restrict the subject and scope of the search because of obscurities or general inconcrete parts of the description and the claims, but, if it can be avoided, a restriction of the subject (scope) of the search should not be made; if such obscurities are eliminated during the search, the search should move in the direction which allows as comprehensive a search as possible.
- IV, 2.3 27. Often various search strategies are possible. The search examiner should exercise his judgement, based on his experience and knowledge of the search files, to select the search strategy most appropriate to the case in hand, and establish the order in which various classification units are to be consulted.
- IV, 2.5 28. The search examiner should initially concentrate his searching efforts on the classification units in which the probability of finding necessary documents, is the greatest. This probability usually, is the main technical field and the classification units highly relevant to the claimed invention. The search examiner should always rely upon the results already obtained when considering whether it is necessary to extend the search to other technical fields.
29. During the search, the search examiner should pay attention to any document that may be of importance to determine relevant prior art, i.e. not only to the documents which are most relevant to the claimed invention, but also to those illustrating the technological background and contributing towards a better or more correct understanding of the substance of the claimed invention as well as the field of its use.
30. The search examiner should note the information concerning a document which could be useful in determining the relevant prior art, and he should also note the main features of such a document which are relevant to the claimed invention.

- IV, 2.6 31. The search examiner should continuously evaluate the results of his search and, if necessary, further define the subject and scope of the search. The selection of the classification units to be searched may require alteration as a consequence of intermediate results obtained. If, during the search, the documents pertaining to relevant prior art have already been found, it would be useful to study reference material cited in such documents to further determine the classification units where the necessary information may be found.
- IV, 2.7 32. Before the search is completed, the search examiner should check whether the documents retrieved are sufficient to indicate relevant prior art in respect of all aspects of the invention. If no documents of a more relevant nature for assessing novelty and inventive step are available, the search examiner should consider citing any documents relevant to the technological background of the invention which he may have noted during the search. If, at the very beginning, the search examiner pays attention to the retrieved documents, he will not have to carry out an additional search to discover relevant prior art; otherwise, he will have to consider again the question concerning correctness and completeness of determination of the subject and scope of the search.
- IV, 2.8 33. The search may be stopped when documents have been found clearly demonstrating lack of novelty of the claimed invention. However, it is necessary to do this very carefully, taking into account the many aspects of the nature of the invention. It may occur that the documents retrieved do not anticipate the novelty of certain features of the invention in respect of those claims which the applicant may amend, for example, after amending the claims. In any case, the documents anticipating the inventive step, but not anticipating the novelty, are not grounds for stopping the search.
34. All decisions taken by the search examiner during the search relating to the restrictions on the scope of the search, as well as all temporary decisions concerning novelty, inventive step and industrial applicability of the claimed invention, should be noted by the search examiner and should be annexed to the search report.

Selection of References

35. After completion of the search, the search examiner should select a restricted number of references to be cited in the search report from the documents retrieved.

IV, 3.1 36. First of all, the most relevant documents should be selected as references which anticipate novelty, inventive step or industrial applicability of the claimed invention or which require a restriction of the claims as filed by the applicant. In addition to such documents, the less relevant documents reflecting prior art, in total, should be included in the search report. For example, if the most relevant reference anticipates the novelty of the main claim, but does not touch novelty of the dependent claim, additional references which were discovered may be cited for relevant prior art in respect of the dependent claim.

IV, 3.1 37. If, during the search, the most relevant references have not been found, other references should be selected to be included in the report which could be useful for the purposes of subsequent examination to determine the essence of novelty and inventive step of the claimed invention.

38. The references which are included in the international search report should disclose to a sufficient degree relevant prior art and should contain all necessary information in order to allow the person skilled in the art to carry out the subsequent examination in respect of novelty, inventive step and industrial applicability.

39. It is necessary to bear in mind that the process of selection of references, as well as the process of determining the subject-matter of the search, has many aspects. For example, it is necessary to try to have at least one reference on every claim, although one and the same reference may be relevant to several claims at the same time. This does not mean that an additional search is necessary if references in respect of any claim have not been found, as long as there is assurance that, during the search, all necessary classification units have been considered.

IV, 3.2 40. To avoid unnecessary expenditure, the search examiner should not select for inclusion in the search report more documents than is necessary to discover relevant prior art. In particular, among patent family members, preference should be given to the document having the earliest date of publication.

V, 5.2 41. The documents having an earlier date of publication than the priority date or the filing date of the claimed invention should be cited as references. The documents containing indications of the disclosure date of the claimed invention, for example, of a date of an oral disclosure, which is earlier than the priority date of the claimed invention, should also be cited. The documents having a later date of publication, but an earlier priority date than the date of priority of the application, should be included in the search report as subsidiary information and only in the case when they are very relevant to the claimed invention.

V, 5.5 42. A special situation can arise where a document published after the date of the claimed invention is relevant to the invention, for example, when the later document shows that the reasons or information stated in the claimed invention are not correct or where a later document supports the usefulness or importance of the claimed invention. It is not necessary to extend the scope of the search in order to find such documents. However, if such documents are known to the search examiner, they should be included in the search report as subsidiary information.

43. It is not necessary to overload the international search report by too great a number of references. It hampers the use of the report. Experience shows that, if the claims consist of not many items, as a rule it is enough to cite not more than ten references to discover relevant prior art. However, as a rule, it is not enough to cite one or two references to discover relevant prior art.

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