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PCT/WG/GSE/1/2

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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

PATENT COOPERATION TREATY

WORKING GROUP ON GUIDELINES FOR INTERNATIONAL SEARCH AND FOR INTERNATIONAL PRELIMINARY EXAMINATION

First Session

Geneva, February 14 to 18, 1977

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

BACKGROUND

1. For the sixth session (November 3 to 8, 1976) of the PCT Interim Committee for Technical Cooperation (hereinafter referred to as "the Interim Committee"), the International Bureau prepared a document dated August 9, 1976, bearing the number PCT/TCO/VI/8 and entitled "Guidelines for International Searches to be Carried Out under the Patent Cooperation Treaty (PCT)" (hereinafter referred to as "the Guidelines"). This document contained Draft Guidelines for International Searches to be Carried Out under the Patent Cooperation Treaty, consisting of an amended version of the EPO Guidelines for Searches prepared in accordance with the proposals of three prospective International Searching Authorities, as well as a comparative analysis of the said proposals. The Interim Committee also had before it comments from the European Federation of Industrial Property Representatives of Industry (FEMIP) as contained in document PCT/TCO/VI/13.
2. The Interim Committee, in its session referred to above, held only a general discussion of the subject covered in the Guidelines and decided to set up the present Working Group ("PCT Working Group on Guidelines for International Search and for International Preliminary Examination (GSE)") (hereinafter referred to as "this Working Group") for the purposes of assisting in the establishment of the PCT Guidelines for International Searches and for International Preliminary Examination (see document PCT/TCO/VI/16, paragraph 72). Concerning the composition of this Working Group, the Interim Committee decided that it would be open to all States members of the Interim Committee as well as all observer organizations which, by December 1, 1976, should express the wish to be its members. The following States expressed such a desire and are thus members of this Working Group: Hungary, Japan, Netherlands, Norway, Soviet Union, Sweden, United Kingdom and United States of America. The following two intergovernmental organizations, the Interim Committee of the European Patent Organization (EPO) and the International Patent Institute (IIP), as well as the following five non-governmental organizations, the Council of European Industrial Federations (CEIF), the European Federation of Industrial Property Representatives of Industry (FEMIP), the International Federation of Patent Agents (FICPI), the Union of Industries of the European Community (UNICE) and the Committee of National Institutes of Patent Agents (CNIPA), which also expressed such a desire, are also participating in this Working Group.
3. The Interim Committee invited all member States of the Interim Committee as well as observer organizations to submit to the International Bureau their written comments on the draft Guidelines contained in document PCT/TCO/VI/8. Such comments should be compiled by the International Bureau and submitted to this Working Group for its consideration (see document PCT/TCO/VI/16, paragraph 73).

CONTENTS OF THE PRESENT DOCUMENT

4. In response to the invitation of the Interim Committee, the International Bureau has received written comments from Hungary, Japan and the United Kingdom as well as from the IIB (comments prepared in consultation with the Patent Office of the Netherlands). These comments are attached to the present document as follows:

Annex A: comments received from the National Office of Invention of Hungary

Annex B: comments received from the Japanese Patent Office

Annex C: comments received from the Patent Office of the United Kingdom

Annex D: comments received from the IIB.

5. This Working Group is invited to consider these comments in conjunction with documents PCT/TCO/VI/8 and 13.

[Annex A follows]

PCT/WG/GSE/I/2

ANNEX A



ORSZÁGOS TALÁLMÁNYI HIVATAL
ELNÖK

PRESIDENT
OF THE NATIONAL OFFICE OF
INVENTIONS OF THE HUNGARIAN
PEOPLE'S REPUBLIC

ПРЕДСЕДАТЕЛЬ
ГОСУДАРСТВЕННОГО ВЕДОМСТВА
ПО ДЕЛАМ ИЗОБРЕТЕНИЙ
ВЕНГЕРСКОЙ НАРОДНОЙ РЕСПУБЛИКИ

Budapest, November 24th 1976

500-PCT/TCO-31

500-PCT/AAQ-39

Mr. K. P f a n n e r
Deputy Director General of WIPO,
G e n e v a

Dear Mr. Pfanner,

Please find enclosed herewith our comments to some of the documents discussed at the last session of the Interim Committees of the PCT.

In file of the decision taken by the Committees to form Working Groups we transmit to the International Bureau the following remarks relating to the documents on the prospective agenda of these Groups.

Yours faithfully,

NATIONAL OFFICE OF INVENTIONS

the president

/Emile Tasnádi/

Annexe

Ad PCT/TCO/VI/8 /Guidelines for international searches../:

In the title of the document "search" - as an abstract idea - should be in the singular, instead of the plural.

Annex A.

Chapter II., point 7, page 3: the cancellation of the first two sentences is proposed as far as it is prescribed in essence by Rules 33,2 and 33,3 that the search must be complete. The reasoning contained in the sentences mentioned above seems therefore to be superfluous. In consequence of the cancellation the word "therefore" becomes unnecessary.

Chapter II. point 8, page 4: in line 5, after the word "invention" the sentence should be finished, taking into consideration the following circumstances:

- a./ according to Article 15 /2/ "the objective of the international search is to discover relevant prior art", which art however - see Rule 33.1 - is of assistance only in determining whether novelty and an inventive step are present. The expression "patentability" is not used by Chapter I. of the Treaty and the relevant Regulations and the decision thereupon is taken by the designated Offices. The cancellation of the expression "patentability" seems to be necessary in other parts of the Guidelines as well.
- b./ Instead of "subject matter excluded from patentability" the formulation of Rule 39 and Article 17/2/ /a/ /subject matter which the International Searching Authority is not required to search/ should be used here and in other parts of the text as well.

c./ "Industrial applicability" is - according to Article 33 /1/ - an item of the International Preliminary Examination therefore it seems to have no place in Guidelines relating to search.

Chapter III., point 3, page 7: instead of the "subject" of the search the expression in Rule 33.3 /orientation/ should be used.

Chapter III., point 3.1, page 7: in line 2 "dur" is erroneous /presumably it stands for "due"/.

Chapter III., point 3.5, page 8: reference is to be made to Article 17 /3/ /a/ and to Chapter VII. of this document.

Chapter III., point 3.6, page 9: in line 5 in the word "transistor" a letter is missing.

Chapter III., point 3.11, page 10: line 2 should begin with the word "all". In the further parts of this point the example seems to be not free of misunderstandable parts as far as if a claim is directed to a chemical process, the final product is always to be searched as the International Patent Classification is built up - at least in the underclasses C 07 C and D relating to chemistry - according to compounds and the relevant prior art relating to the process can be found in the group /subgroup/ of the compound /final product/. In addition: one can not neglect the possibility of new starting products as well. Therefore the cancellation of the part of the text "except...known" /the last 6 words of this point/ and a redrafting is proposed.

Chapter III., point 3.14, page 11: the question is raised, what is the difference between "technological background and "general technological background"

/see lines 3 and 10 of this point/? The remark
"/ 3/ SU" seems to be worth of inclusion.

Chapter IV., point, page 13: in line 4 "analogous" is
the correct expression.

Chapter IV., point 2.3 and 2.5 /pages 13 and 14/:
redundancy seems to take place in connection with
the units in which the probability of finding do-
cuments is highest.

Chapter V., point 1, page 16: Article 15/2/ is to be
cited instead of 33 /2/.

Chapter V., point 2.3, page 17: in line 1 "considered"
should be read instead of "construed".

Chapter VI., point 1, page 20: as Article 33 /3/ relates
to the international preliminary examination, it
should not be cited here. The content of this
point is better based upon Rule 33.1.

Chapter VI., point 2, page 20: the present formulation
seems to give directives to designated Offices as
to the evaluation of the inventive step. In effect
the aspects described here ought to be taken into
consideration by the searching persons as these
Guidelines aim at the regulation of their work.

Chapter VII., point 5, point 21: in line 2 the expression
"single general inventive concept" /Rule 13.1/ is
recommended.

Chapter VII., point 10, page 22: Article 17 /3/ /a/ and
Rule 40.1 ought to be cited.

Chapter VIII., point 2, page 23: both Article 17 /2/ /a/
and /2/ /b/ should be cited.

[Annex B follows]

Chapter X., page 23: Rule 43 and the relevant parts of
the Administrative Instructions should be cited.

PATENT OFFICE
JAPANESE GOVERNMENT

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

TOKU SO 1335/51
December 23, 1976

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

Dear Sir:

In accordance with the decision of the 6th Session of PCT Interim Committee for Technical Cooperation held from Nov. 3 to 8, 1976, I am forwarding you enclosed the comments of the Japanese Patent Office at the present date concerning the "Guidelines for International Searches to be carried out under PCT (PCT/TCO/VI/8)".

Yours truly,



Kazuo Hoshikawa
Counsellor in charge of PCT & TRT

Enclosure 1

1. Chapter III, par. 1.1:

There are no provisions in PCT, on International Searching Authority forming "provisional opinions" concerning novelty and inventive step. Further, there are no provisions concerning the notification of such provisional opinions to the designated office. Therefore, remarks concerning such provisional opinions should be deleted.

2. Chapter III, par. 2.4:

As the content of this paragraph is actually indicated in the foregoing pars. 2.2 and 2.3, we think that par. 2.4 is not required. In our comments, which we previously submitted, (see PCT/TCO/VI/8, Annex C) we deleted the par. 2.4 for the same reason as mentioned above. We wish to point out that Comparative Analysis (see PCT/TCO/VI/8, Annex B, page 5) concerning this paragraph is not consistent with our view.

3. Chapter III, par. 3.4:

We understand that the Receiving Office is not obliged to notify the applicant concerning defects in Rule 10. Thus, we believe that to show Rule 10 as an example of notification by the Receiving Office to the applicant does not seem proper.

4. Chapter III, par. 3.8:

We believe that the content of the 1st and 2nd sentences seems proper in the light of the relevant PCT provision. That is, we also believe that dependent claims should be searched along with their parent claims. With the content of the first two sentences as premise, the 3rd sentence down is the natural conclusion deduced, and need not be deleted. Particularly, the 4th sentence may be allowed to stand, from the viewpoint of economic and rational cost of search. Thus, what is mentioned in Comparative Analysis concerning this paragraph is not appropriate (see PCT/TCO/VI/8, Annex B, page 8).

5. Chapter III, par. 3.9:

As the content of the 1st and the 2nd sentences seems proper, we believe they should not be deleted. We also wish to point out that the statement regarding Japan in Comparative Analysis (PCT/TCO/VI/8, Annex 8, page 9) concerning this paragraph is not correct. It is true we believe that no such special search should be made for features that are trivial or generally known in the art, but we do not say that search for dependent claims including such features is not necessary.

6. Chapter IV, par. 2.2:

As it is not clear what "or other sections of documentation" means exactly, it should be clarified.

7. Chapter IV, par. 2.8:

As the last sentence of this paragraph, "all decisions.....search report" concerns what is not provided in PCT, it should be deleted.

8. Chapter IV, par. 3.2:

What was approved by this Interim Committee concerning patent families should be reflected in the paragraph.

9. Chapter V, par. 5.3:

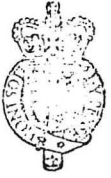
When documents showing that a priority claim might not be justified are discovered, it is not provided in PCT to draw the attention of the International Bureau concerning the above fact. Consequently, we believe that any mention about it should be deleted.

10. Chapter V, par. 6.2:

As the meaning of the 1st sentence of this paragraph is not clear, we hope it would be clarified.

11. Chapter VIII, par. 4:

We believe it is preferable to delete the line 9 of this paragraph, "ask for clarification, and after receipt thereof continue the search," because PCT does not demand such action on the part of International Searching Authorities and, further, in view of the time limit for making International Search Reports, it would not be practicable.



THE PATENT OFFICE

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Mr E M Haddrick
Head of the Patent Cooperation Treaty Division
WIPO
32 Chemin des Colombettes
1211 Geneva 20
Switzerland

Your reference

Our reference IPCD 40118 40120

Date 17 December 1976

Dear Mr Haddrick,

I have pleasure in enclosing the observations and comments of the United Kingdom delegation on the following documents:-

- (1) Draft Guidelines for publication under the PCT (PCT/AAQ/VII/4).
- (2) Draft Guidelines for the presentation and execution of drawings under the PCT (PCT/AAQ/VII/11).
- (3) Draft Guidelines for the International Searches to be carried out under the PCT (PCT/TCO/VI/8).
- (4) Draft Guidelines for International Preliminary Examination to be carried out under the PCT (PCT/TCO/VI/9).

These are forwarded, as requested by the Secretariat, for consideration by the TCO and AAQ Working Groups which are to take place next February.

I wish you a very happy Christmas.

Yours sincerely,

M F VIVIAN

(patents 2).

Observations of the United Kingdom on the Guidelines for
International Searches under the PCT (PCT/TCO/VI/8)

General

Our general approach to these guidelines is that they should result in a search report which can be used in proceedings before the national offices of all countries which ratify the PCT. Thus, for example they should not be too dogmatic on questions of novelty/inventive step as practice on these topics varies from country to country. A number of our comments should be read with this approach in mind.

Chapter I

Paragraph 1 The words "as regards matters of common interest" should be deleted. They do not seem to be appropriate in the PCT context: they were for EPO because two Working Parties were involved.

Chapter II We prefer "that is systematically arranged, or otherwise systematically accessible, for search purposes according to the subject-matter contents of the documents".

The matter between commas is needed to allow for the use of mechanical search instead of classified files of documents when so desired. We regard the sentence as explanatory of Rule 36.1(ii).

Paragraph 6 We prefer to delete "mainly" and insert 'usually' after "will" in line 4.

Paragraph 8 We feel that "a certain amount of feed-back may be desirably necessary" is not strong enough and suggest that the second sentence be replaced by:-

"On the other hand, feed-back from designated Offices to the International Searching Authorities on the general effectiveness of international search reports for the prosecution of PCT applications will be necessary to ensure that such searches are well adapted to the needs of examination".

Paragraph 9

We prefer the Japanese version of the first sentence. In the final sentence we suggest that the last three lines be amended to read:-
"specialised fields, a search report containing the work of two, or possibly three, search examiners may be necessary".

Chapter III

Paragraph 1
Point (2)

We consider that some reference to preliminary opinions must be included.

We support the US version of the first sub-paragraph of 1.1 (but not the second sub-paragraph) and suggest that the matter of paras 2 and 3 of the SU proposal (Annex B, page 2) be incorporated in para 2.1 instead of the bracketed text at point (3).

Paragraph 2.1

We suggest that the word 'always' in line 4 be deleted: 100% completeness is never attainable in practice for the reasons stated.

Point (3)

We feel that paras 2,3 of the SU proposal at Annex B, page 2 is preferable (see point (2) above).

We suggest the insertion of a statement that the

extent of the search must be specified accurately, especially if it is restricted for any reason, in case it is decided later that the search needs to be extended.

Paragraph 2.4

Point (4) We consider that 2.4 may not be realizable in practice. In any case it seems to be inconsistent with 2.5, 2.6 and 2.7. We suggest that it is deleted.

Paragraph 2.5

We feel that "may contain" is not strong enough and suggest that the first sentence of this paragraph be amended to read:-

"The international search must extend to those search files where highly relevant material can be expected to be found, given that it exists".

Paragraph 3.2

We prefer the deletion of the matter in square brackets. We suggest that the last part of the final sentence be replaced by:-

"should not be broadened to include matter having only a tenuous connection with the inventive concept".

Paragraph 3.4

Point (5) Since only examples are concerned, the difference is of no great significance. We prefer "Rule 9 defects".

Paragraph 3.7

We feel that the second sentence may discourage the making of a wide search in cases where such a search

is necessary and that reliance on the word "merely" to prevent this is dangerous. We suggest that the following sentence be inserted between the existing second and third sentences:-

"Of course, if the inventive concept is not peculiar to a telephone exchange extension of the search to other kinds of communication switching centres may well be justified (see paragraph 2.6 of this chapter)."

We also suggest that the words "and give no indication as to how" in the final sentence be amended to read:-

"and it is not apparent that"

Paragraphs 3.8 and 3.9

Point (6) We do not favour either of the versions put forward.

Point (7) We suggest:-

"3.8. The extent to which search should be made for matter specified in dependent claims will be governed by the extent to which prior art relevant to the main claim(s) is found. Clearly a document that is relevant to a main claim and also discloses matter relevant to dependent claims will be of increased importance and in searching the files relevant to the matter of the main claim(s) particular care should be taken to identify any such documents. Further, since it will not be clear until after the search for matter relevant to the main claim(s) has been made whether extension of the search is required in respect of the matter of dependent claims per se, in making the search in respect of the main claim(s) a note should be made of any documents in the files in which

the main claim(s) search is being made which are relevant to the matter of the dependent claims per se.

3.9. When the character of the prior art found in the main claim(s) search is such as to bring the patentability of the main claim(s) into question, it may be necessary (from line 2 to end of matter of 3.9 text)"

We favour the deletion of the example from 3.8.

Paragraph 3.10

Point (8) We prefer 3.10 to end:-
"if this is still necessary for assessing the patentability of the combination."

Paragraph 3.13

We suggest combining this with 3.5.

Paragraph 3.14

Point (9) We favour the addition proposed by SU.

Chapter IV

Paragraph 1.1

We suggest combining the first two sentences thus:-
"When taking up an international application to be searched the search examiner should first make a critical analysis of the claims in the light of the description and drawings in order to determine the subject of the claimed invention taking account of the guidance given in Chapter III, paragraph 3.

Chapter IV

Paragraph 1.2

Point (10) "Ordre public" is not directly translatable into

English and we suggest that the French term be retained (as is common practice in UK)-

In line 3 and in line 11 replace "he" by "the International Searching Authority".

Action to meet the Secretariat's point re Rule 9.1 defects should be taken.

Paragraph 1.3

The text of the second sentence leaves unanswered the question of what happens if a copy of the document is not provided within the time limits.

We suggest that the second sentence end before the square brackets and that a third sentence be added:-

"If a copy of the document is not provided in time to allow the search to be made and the search report prepared within the time limits therefor, the International Searching Authority shall transmit the declaration referred to in Article 17(2)(a) in lieu of a search report".

Paragraph 1.5

This implies that classification is to take place prior to search. We feel that this will result in a large number of useless classifications where claims are drafted broadly in ignorance of the prior art. We suggest that classification should normally take place after search and be performed in the light of the prior art revealed by the search, unless the search report is not available at the time of publication.

Paragraph 2.2

Point (12) We support the US addition as it is needed to allow the search examiner to use search systems other than classified search filed, eg mechanised systems.

Paragraph 2.5

There is redundancy between the first sentence of 2.5 and the second sentence of 2.3. Amendment is needed. The second sentence of 2.5 could advantageously be combined with the first sentence of 2.6.

Paragraph 2.8

Point (13) We favour the inclusion of the bracketed text. We note that the notes are to "annexed to" (not included in) the search report.

We feel however that the point made by the SU in the last sentence of paragraph 33 (Annex B; page 15) is an important one. Deciding whether the prior documents found "clearly demonstrate lack of inventive step" is a much more subjective matter than is that of deciding whether they "clearly demonstrate lack of novelty". Moreover, the standards required under the laws of designated countries for establishing lack of inventive step vary widely. Since the examination will take place in the light of those varying standards we consider it unwise to stop a search unless it is the novelty which is clearly demonstrated to be lacking. We therefore suggest that the words or "inventive step" in lines 5-6 of paragraph 2.8 be deleted.

Paragraph 3.2

Point (14) We see no advantage in citing the earliest published member of a family unless the others were published too late to be effective as prior art. We therefore favour deletion of the bracketed sentence.

Chapter V

Paragraph 1

Article 33(2), which is in Chapter II of the PCT, defines novelty, but only for the purposes of the International Preliminary Examination. It would not therefore seem to be relevant to the International Search. We note also that it does not refer to "the state of the prior art".

We also note that Rule 33.1 does not define "the state of the art" but "relevant prior art for the international search".

We suggest therefore that the title of Chapter V be amended to "RELEVANT PRIOR ART" and that paragraphs 1.1 to 1.3 be replaced by

"1.1 Article 15(2) states that the objective of the international search is to discover relevant prior art, which by the terms of PCT Rule 33.1(a) 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 (ie that it is or is not obvious), provided that the making available to the public occurred prior to the international filing date.

1.2. It follows that oral disclosure, use, exhibition or other means of disclosure is not relevant prior art for the purposes of the international search unless it is substantiated by a written disclosure. The date on which the written disclosure was made available to the public may have been after the filing date of the international application under consideration (PCT Rule 33.1(b)).

We have some doubt about the usefulness of paragraph 1.3 and suggest that it be not included in the Guidelines.

Paragraph 2.1

Since PCT does not talk of "the state of the art" we suggest that the words "constituting the state" be deleted.

Paragraph 2.2

The example at the end is ambiguous and could be taken to mean "takes away the novelty of the use of any other elastic material". To resolve this ambiguity we suggest that the final words be amended to read:-

"the novelty of the use of elastic material in general".

It would not take away the novelty of the use of another specific elastic material.

Paragraphs 3 and 3.1

We suggest deletion of these - see suggested text of 1.2 above.

Paragraphs 4 and 4.1

We support the inclusion of these paragraphs.

Paragraph 5.2

We suggest the insertion of "in the search report" after "include" in line 1.

We can find no PCT requirement that documents published before the international filing date but after the claimed priority date have to be indicated as such in the search report. We therefore suggest that the first sentence of 5.2 end at "consideration". (end of line 3) and that the second sentence be deleted.

Paragraph 5.3

Point (16)

We favour the inclusion suggested by the US, but feel that the words "beyond the filing date of the international application" should be deleted, viz. "No special search should normally be made for this purpose, except"

Paragraph 5.4

This appears to be inconsistent with 4.1. Paragraph 4.1 deals with a normal requirement and does not relate to an extension for a specific purpose. Paragraph 4.1 documents will only be found if the search does normally take into consideration documents published after the international filing date. Some clarification is needed.

Paragraph 6.2

Point (17)

We support inclusion of the proposed text.

Paragraph 7

Title. We suggest "Matters of doubt regarding prior art".

Paragraph 7.1

The second sentence appears to be somewhat misleading. It says that the document should be cited unless the doubt is removed or very little doubt remains.

Consider the case where there is doubt as to the exact publication date of a relevant document. It is known to be sometime in March 1977, and the international filing date of the application being searched is 17 March 1977.

The International Searching Authority makes an investigation and determines that the publication date was either 16 or 17 March 1977 and was probably 16 March 1977. Very little doubt remains. So following the guidelines it does not cite the document. Even if the doubt is completely removed and it knows that the date was 16 March 1977, if it follows the guideline it does not cite the document. On the other hand if the investigation throws up no more information and the doubt is not reduced, then following the guideline it does cite the document. This does not seem to be correct.

We suggest that the paragraph needs redrafting.

Chapter VI

Paragraph 1

Article 33 which is in Chapter II of the PCT relates to the International Preliminary Examination and hence the Article 33(3) definition of inventive step is not relevant to the International Search, but only to the International Preliminary Examination.

Chapter VI

Whole chapter We note that the results of the International Search may be used in connection with the laws of any designated state and hence that the meaning of novelty and inventive step may vary widely. These Guidelines for Searching should therefore not attempt to make a sharp distinction between novelty and lack of inventive step. We therefore suggest that Chapter VI be deleted, particularly in view of Article 33(5).

Chapter VII

Paragraphs 5 and 11 We prefer the US suggestion viz "common" in line 2 of paragraph 5 and line 6 of paragraph 11 and "related under PCT Rule 13.2 and 13.3" at lines 5-6 of paragraph 5.

Paragraph 6 We prefer "Rule 13.2" (which does "particularly specify").

Paragraph 11 We prefer "single" to be included.

Point (20)

Chapter VIII

Paragraph 1 We support the US suggestion to include the second sentence.

Point (21)

Paragraph 4 We feel that this paragraph needs to be split into two parts; the first dealing with the case in which a meaningful search is not possible and the second with the case in which it is partially possible. For the first case Article 17(2)(a) should be followed and no search be made; for the second case the proposed US text should be used.

Point (22)

Chapter IX

Paragraph 1

The tenth word should be "definitive" and the reference to (PCT Rule 38.2.(b)) should be moved to the end of the first sentence.

Paragraph 2

The fourth word should read "definitive"



INSTITUT INTERNATIONAL DES BREVETS

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BREVPATENT

TÉLEX No. 31.651

ADRESSE:

PATENTLAAN 2. RIJSWIJK (Z.H.)

(PAYS-BAS)

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Mr. E.M. HADDRICK,
Head PCT-Division,

"W.I.P.O.",

32, chemin des Colombettes,
1211 GENEVE 20 (SUISSE).

RIJSWIJK (Z.H.), le 24.12.1976.

Dear Mr. Haddrick,

Please find enclosed the observations of the IIB on the PCT guidelines for international searches. These observations have been drawn up in consultation with the Netherlands Patent Office.

We will not submit observations on the PCT guidelines for international preliminary examination. They will be incorporated in the observations on these guidelines to be submitted by the Netherlands Patent Office.

Yours sincerely,

A handwritten signature in dark ink, appearing to read 'J.A.H. Van Voorthuizen', is written over a horizontal line.

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

GENERAL REMARK.

We are of opinion that the PCT guidelines for searches should follow as closely as possible the EPO guidelines for reasons of harmonization between the two systems.

These latter guidelines contain some parts which find no direct basis in an Article or Rule of the Treaty although in general they do not depart from the spirit of it.

Such parts should only be deleted in case it is clear that they contain provisions which are contrary to the PCT.

I. OBSERVATIONS ON ITEMS 1 TO 22 OF ANNEX B.

- Item 2. In order to determine at which moment to stop or to reorientate his search, the search examiner has to form opinions on the value of the retrieved documents as regards novelty and inventive step. These opinions are of course not mentioned in the search report, and are provisional (or "informal") in the sense that they are subject to review later by the designated Office. It seems to us, that points 2 and 3 of the observations made by the S.U. office belong to Ch.IV.2(search strategy).
- Item 3. We consider that all the relevant classification units should be searched to the extent found necessary by the search examiner on technical grounds, without setting time-limits beforehand. As far as the number of documents to be cited is concerned, this may vary from case to case, in view of our present practice we expect that 5-6 documents per search report will represent a mean value. The Annex to the search report, proposed by the S.U.office seems to be in conflict with PCT.Rule 43.9(see also the last remark in the comparative analysis of Item 13).Would this Annex be published?
- Item 4. We support the point of view of the U.S.office(see published EPO Guidelines for the search Ch.III.2.4.) However the word "patent" should be deleted as not only patent documents have to be consulted (see PCT.Art.15(4) and Rule 34.1.(b)(iii)).
- Item 6. The objections of the U.S.office to the second part of 3.8 are not clear to us. The JA office is of opinion that there should be no further search in respect of the dependent claims as such, to which we agree.
- Item 7. The objections of the U.S.office to the first part of 3.9. are not clear to us. Point 10 raised by the S.U. office would appear to be already covered by Ch.III,§3,6.

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- Item 8. We consider that the last three lines of point 3.10 constitute an essential part of it, because without this indication the search examiner will not know under what circumstances he has to consult additional classification units. As far as we understand a conclusion as to obviousness can only be drawn after the search has been performed and on the basis of the documents found.
- Item 9. It is not clear to us why reference documents cited by the applicant should be made the subject of an extended search for the "technological background".Chapter IV point 1.3 appears to be relevant.
- Item 10. At the end should be added" the Receiving Office and the International Bureau".
- Item 12. It would seem to us, that the indications given in (i) and (ii) of 2.2. are very useful for the examiner and will contribute to the uniformity of searches carried out by different International Searching Authorities. In determining the units of classification to be consulted the examiner will have to use the classification system(s) in use in his office. The situation in this respect may be different for the various Authorities. The expression "or other sections of the documentation " should be retained. It refers to mechanized search systems for instance.
- Item 14. We agree with the point of view of the JA and U.S.offices. In connection with the observation by the S.U office the attention is drawn to § 84 of the report of the 1976 TCO session.
- Item 16. Documents showing that a priority claim might not be justified should be cited in the search report. These documents are of importance to the applicant, the designated offices and the IPEA because they assist in ascertaining the "relevant date" which determines what documents can be considered to constitute prior art e.g.documents made available to the public between the claimed priority date and the filing date (cf.Art.33 and Rule 64.1;) Rules 33.1(a) and 43.5(a) would seem to permit this practice(see also the published version of the EPO Guidelines Ch.VI.5.3.). In the last meeting of AAQ it has been decided to amend Section 508 of the Administrative Instructions by providing an additional lettercode L to identify, amongst others, documents of this sort.
- Item 17. We agree to the proposed addition.
- Item 19. In view of the fact that in Art.82 of the EPC the term "general inventive concept" is used(in fact this Article is identical to Rule 13.1 of PCT), we see no intentional difference in meaning between this word "general" and the word "common" which is used in the EPO Guidelines.
- Item 21. It seems preferable to use here the same wording as in PCT Art. 17(2) (a).

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II. OBSERVATIONS ON THE GUIDELINES FOR INTERNATIONAL SEARCHES.

In view of the obligation for the I.S.A. to effect the classification of the application(Rule 43.3) it seems highly desirable to incorporate in the guidelines a special Chapter on classification.

The contents of such a Chapter could be based on Chapter V of the EPO guidelines (published version).

- Chapter II.
§ 5. After "offices" should be added "and the IPEA", between the brackets the references should be completed by a reference to Art.33.6.
- § 8. Add in the first line and in the twelfth line : "and the IPEA".
- Chapter III.
§ 3.1. The last part "and with particulardirected" can be deleted as the same expression is used in the first sentence of § 3.2. We propose to replace it by : " since this determines the extent of the protection which will be conferred by the patent if granted"
- § 3.2. The addition proposed by the S.U.office appears unnecessary.
- Chapter IV.
§ 2.1. Replace in the 8th line " from patentability" by "for the international search ", in conformity with the title of CH.VIII.
- Chapter V.
§ 1.2. As far as oral disclosure, use or other means of disclosure are concerned, a written disclosure confirming this and available to the public must exist.

In the published version of the EPO guidelines a paragraph has been added (CH.VI.7.2.).
As its contents are also applicable under the PCT, we suggest to add such a paragraph to the PCT.guidelines.
- Chapter VII.
§ 2. The time limit for establishing the international search report shall not exceed 3 months from the receipt of the search copy (Rule 42.1).There is no provision for extension in the case of lack of unity.
Therefore all searches must be started as early as possible. Otherwise the applicant might not even have the opportunity to pay the additional fees within the prescribed time limit.
- § 10. At the end of this paragraph should be added : "... when the additional fees have been paid(see Art.17(3)(a); CH.VII paragraph 2)".
- Chapter XI.
In the published version of the EPO guidelines a new paragraph has been added (CH.XI.1). We suggest to add a similar paragraph in the PCT guidelines.

The I.S.A. will have to establish sometimes the title of the application(Rule 37.2).
We propose to add a paragraph to that effect to Chapter XI and broaden its title to " The abstract; the title".
