

WIPO



PCT/WG/GSE/I/7

ORIGINAL: English

DATE: February 18, 1977

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

REPORT

INTRODUCTION

1. At its sixth session, in November 1976, the PCT Interim Committee for Technical Cooperation (hereinafter referred to as "the Interim Committee") decided to establish a Working Group on Guidelines for International Search and for International Preliminary Examination (hereinafter referred to as "the Working Group") for the purpose of assisting in the establishment of the PCT Guidelines for International Search and for International Preliminary Examination.
2. Pursuant to the decision of the Interim Committee, the Working Group held its first session in Geneva from February 14 to 18, 1977.
3. The following States, members of the Interim Committee, having expressed the wish to participate, were members of the Working Group: Austria, Germany (Federal Republic of), Hungary, Japan, Netherlands, Norway, Soviet Union, Sweden, United Kingdom, United States of America. Two intergovernmental organizations--the Interim Committee of the European Patent Organisation (EPO) and the International Patent Institute (IIB)--as well as four non-governmental organizations--the Council of European Industrial Federations (CEIF), the European Federation of Industrial Property Representatives of Industry (FEMIP), the International Federation of Industrial Property Attorneys (FICPI) and the Union of Industries of the European Community (UNICE)--also participated in the first session of the Working Group, having expressed a similar wish. The list of participants is annexed to this report.

ADOPTION OF THE AGENDA

4. The Working Group unanimously adopted its agenda, as contained in document PCT/WG/GSE/I/1. Rev.

OPENING OF THE SESSION

5. The session was opened by Mr. F. A. Sviridov, Deputy Director General of WIPO, who welcomed the participants on behalf of the Director General of WIPO.

ELECTION OF OFFICERS

6. The Working Group unanimously elected Mr. J. Delorme (IIB) as Chairman and Mr. L. Maassel (United States of America) and Mr. I. Yamamoto (Japan) as Vice-Chairmen. Mr. J. Franklin, Counsellor, PCT Division, WIPO, acted as Secretary to the Working Group.

GUIDELINES FOR INTERNATIONAL SEARCH UNDER THE PCT

7. The discussion of these Guidelines (hereinafter referred to as "the PCT Search Guidelines") was based on documents PCT/TCO/VI/8 and 13 and PCT/WG/GSE/I/2 and 4.

GENERAL DISCUSSION

8. The representative of the United Kingdom pointed to the fact that the international search report would be used by the International Preliminary Examining Authorities and by the designated Offices in the light of different national laws. In addition, the carrying out of the international searches by the International Searching Authorities would not result in any sanctions with respect to the international application. For that reason the PCT Search Guidelines should not be too dogmatic, in particular with respect to the distinction between novelty and inventive step.

9. The representative of the Soviet Union emphasized the importance of the PCT Search Guidelines for the success of the PCT and stated that it was essential that international search reports prepared in accordance with those Guidelines should meet the needs of users in many countries. The carrying out of international searches in respect of applications under the PCT and the subsequent examination of such applications being made separately in respect of place and time, the PCT Search Guidelines should have the necessary flexibility and universality to meet such needs while, at the same time, being sufficiently accurate to provide high quality international searches. The achievement of those objectives would give the PCT procedure greater attractiveness and reliability for both patent offices and applicants throughout the world.

10. The representative of the IIB said that the PCT Search Guidelines should differ as little as possible from the Guidelines for Search established in the framework of the Interim Committee of the EPO ("the EPO Search Guidelines") so that applicants would feel that the same standards were being applied in each case. Thus the PCT Search Guidelines should omit only those parts of the EPO Search Guidelines that were contrary to the spirit of the PCT to achieve harmonization between the two systems as far as possible. Furthermore, it was also desirable, in order to provide uniformity in the international search reports prepared by various International Searching Authorities, that the PCT Search Guidelines should provide explanations going beyond the specific provisions of the PCT.

11. The representative of the Netherlands, supporting the views expressed by the representative of the IIB, stated that the absence of sanctions under the PCT affected only the examination stage under the PCT and had no bearing on the international search and consequently should not influence the drafting of the PCT Search Guidelines. Moreover, different national practices with respect to novelty and inventive step need not be taken into account when establishing PCT Search Guidelines, since such differences would only be significant at the time of examination.

12. The representative of the United States of America said it was important that the PCT Search Guidelines should be drafted with the search examiner primarily in mind and that references to the provisions of the PCT, which the search examiner would already know, should be limited as much as possible.

13. The representative of Japan, while expressing preference for flexibility in the PCT Search Guidelines, considered that the first draft of such Guidelines contained in document PCT/TCO/VI/8 provided a good basis for the Working Group's discussion.

DISCUSSION IN DETAIL

14. The Working Group decided that this part of the report should only contain the conclusions reached by it as to the text to be included in the PCT Search Guidelines. The conclusions are set out below under the numbers and titles of the Chapters of the PCT Search Guidelines. The titles of the Chapters appear in capital letters with broken underlinings. Amendments to or deletions from the text of the draft PCT Search Guidelines, as contained in document PCT/TCO/VI/8, are reflected in this report. Conversely, no reference is made to the text of the said draft Guidelines which was retained by the Working Group without amendment, it being understood that square brackets enclosing text matter should be deleted where the enclosed text was retained with or without amendment.

CHAPTER I--INTRODUCTION

15. Paragraph 1: This paragraph should read as follows:
"These Guidelines were elaborated by the PCT Interim Committee for Technical Cooperation."

16. Paragraph 4: The first part of this paragraph should read as follows:
"In order to ensure uniform practice the International Searching Authorities are expected 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."

17. Paragraph 5: This paragraph should read as follows:
"These Guidelines were drafted for, and apply to, international searches and, where appropriate, international-type searches."

CHAPTER II--GENERAL

18. Paragraph 3: The first sentence of this paragraph should read as follows:
"The international search is essentially a documentary search in a document collection that is systematically arranged (or otherwise systematically accessible) for search purposes according to the subject-matter contents of the documents (PCT Rule 36.1(ii))."

19. Paragraph 5: This paragraph should read as follows:
"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 and the International Preliminary Examining Authorities (PCT Article 18(2), Article 20(1)(a), Article 21(3))."

20. Paragraph 6: This paragraph should read as follows:
"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 by the designated Offices or by the International Preliminary Examining Authorities, the separation of the two steps may be geographical as well as procedural."

21. Paragraph 8: This paragraph should read as follows:
"In order to be able to inform the designated Offices and the International Preliminary Examining Authorities of the documents necessary for them to assess novelty and inventive step, the search examiner must be familiar with the basic requirements of examination, especially with respect to novelty, inventive step and unity of invention. Also to be able to decide when the search need not be carried out or needs to be restricted, the search examiner must be aware of the subjects which are not required to be searched either because they may be excluded under PCT Rule 39, or because they are generally accepted not to be patentable subjects or susceptible of industrial application. On the other hand, feed-back from designated Offices and International Preliminary Examining Authorities to the International Searching Authorities on the general effectiveness of international search reports for the prosecution of international applications will be necessary to ensure that such searches are well adapted to the needs of examination and such feed-back should be encouraged by the International Searching Authorities."

22. Paragraph 9: This paragraph should read as follows:

"The international search shall be carried out and the international search report prepared by an International Searching Authority. 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 specialized fields, an international search report containing the work of two, or possibly three, search examiners may be necessary."

CHAPTER III--CHARACTERISTICS OF THE INTERNATIONAL SEARCH

23. Paragraph 1.1: The last two sentences of the first part of this paragraph should be replaced by a sentence reading as follows:

"However, these issues must be borne in mind by the search examiner in order to enable an effective international search to be carried out."

The example appearing at the end of this paragraph should be deleted.

[In the discussion of this paragraph, the Working Group took the view that, since by virtue of PCT Rule 43.9 no expression of opinion by the search examiner on novelty and inventive step should be mentioned in the international search report and since there was no provision in the PCT (including the Regulations) for any communication of such an opinion, the said opinion would not be communicated to the applicant, the International Preliminary Examining Authorities, the designated Offices or the public.]

24. Paragraph 1.2: This paragraph should read as follows:

"Occasionally the search examiner must also bear in mind 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.

Examples are to be found in Chapter VII: Unity of Invention and Chapter VIII: Exclusions from the International Search."

25. Paragraph 2.1: The second sentence of the first part of this paragraph should read as follows:

"Nevertheless, it must be realized that, even though completeness should be the ultimate goal of the international search, this goal may not be necessarily 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 second part of the paragraph should be deleted. The last sentence of the third part of this paragraph should read as follows:

"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 (see also Chapter III, paragraph 2.7)."

26. Paragraph 2.2: This paragraph should read as follows:

"The International Searching Authority carrying out the international search shall endeavor 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 (PCT Article 15(4))."

27. Paragraph 2.4: This paragraph should be deleted.

28. The title of paragraph 3: This title should be amended to read:

"Orientation and subject of the international search."

29. Paragraph 3.2: The first sentence of this paragraph should read as follows:

"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 (PCT Rule 33.3(a))."

30. Paragraph 3.4: This paragraph should read as follows:

"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 the applicant's attention by the receiving Office, the international search will be directed to the claims as originally filed."

31. Paragraph 3.5: This paragraph should read as follows:

"Claims that are deemed to be drawn to inventions for which no fees have been paid must be excluded from the international search (see PCT Article 17(3)(a) and Chapter VII)."

32. Paragraph 3.6: The third sentence of this paragraph should read as follows:
"Nevertheless, reasons of economy may make certain restrictions of the international search 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."

33. Paragraph 3.7: The second and third sentences of this paragraph should read as follows:

"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 center, the international search should not be extended to automatic telegraph exchanges, data switching centers, etc., merely because of the broad wording of the claim, except if it is probable that such an extended search could produce a document on the basis of which a reasonable objection as regards lack of novelty or inventive step could be established. 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."

34. Paragraph 3.8: This paragraph should read as follows:

"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 novelty and inventive step of the main claim are apparent 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 adds 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 novelty and inventive step of the illuminating means are apparent, the examiner should not extend his search for the connecting means to further search files specifically provided for these connections."

35. Paragraph 3.9: The first sentence should read as follows:

"However, where the novelty or inventive step 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."

36. Paragraph 3.11: The first sentence of this paragraph should read as follows:

"When the application contains claims of different categories, all 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."

37. Paragraph 3.12: This paragraph should read as follows:

"The search examiner should, in general, exclude from his international search subjects for which no searches are to be carried out or no meaningful search can be made; this may result, for example, from the fact that certain subjects are excluded from the search under PCT Rule 39, or that the international application is obscure (see Chapter VIII)."

38. Paragraph 3.14: The last line (in square brackets) of this paragraph should be deleted.

39. Paragraph 4: This paragraph should read as follows:

"4.1 International Searches

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

"4.2 International-type searches

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

CHAPTER IV--SEARCH PROCEDURE AND STRATEGY

40. Paragraph 1.1: This paragraph should read as follows:

"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, paragraphs 3.1 to 3.3. 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 totality of the means essential to the solution as particularly reflected in the technical features thereof found in the claims, and the results and effects obtained."

41. Paragraph 1.2: This paragraph should read as follows:

"If the search examiner notices any formal shortcomings which have been overlooked by the receiving Office, the International Searching Authority should call them to the attention of the receiving Office, which will take appropriate action. Similarly, if the International Searching Authority notes matter contrary to public order ("ordre public") or morality or disparaging statements which ought to be omitted from the international application as published, it should suggest to the applicant that he voluntarily correct his international application and should notify the receiving Office and the International Bureau accordingly (PCT Rule 9.2)."

42. Paragraph 1.3: The following sentence should be added at the end of this paragraph:

"If no copy of the document is received, the International Searching Authority shall first attempt to carry out the international search and then, if necessary, indicate that no meaningful search could be carried out in total (PCT Article 17(2)(a)(ii) or that the search needed to be restricted (PCT Article 17(2)(b))."

43. Paragraph 1.4: This paragraph should read as follows:

"The search examiner should then consider the abstract (together with the title of the invention and the figure of the drawings to be published with the abstract) in relation to the requirements of the Regulations under the Treaty (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. Under certain circumstances (see Chapter XI), the search examiner will himself have to establish the abstract and/or title, and/or select the figure to accompany the abstract for publication purposes. Whenever the search examiner establishes or modifies the abstract, he shall inform the applicant and invite him to comment within one month (PCT Rule 38.2(a))."

44. Paragraph 1.5: This paragraph should read as follows:

"The search examiner, after having considered the abstract, if any, will then classify the international application according to at least the International Patent Classification (see Chapter V)."

45. Paragraph 1.6: The following paragraph should be inserted:

"[If publication of the international application is due before international search, the search examiner will have to establish the classification of the application much earlier than he carries out the search (see Chapter V, paragraph 2); he will then at the same time briefly examine the abstract (together with the title and selected figure) for the purpose of publication. This examination of the abstract will not go beyond ensuring that it relates to the application concerned and that no conflict exists with the title of the invention or with the classification of the application. If at that time no abstract, title or figure selection has been provided by the applicant, the search examiner will have to do so.]"

[The above text in square brackets was adopted by the Working Group on the basis that the text would be subject to review after consideration by the PCT Working Group on Publication and Drawings of questions related to the publication of the international application.]

46. Paragraph 2.1: The third sentence of this paragraph should read as follows:
"At this time, the considerations relating to exclusion from the international search (see Chapter VIII) and to lack of unity of invention (see Chapter VII, paragraph 1) should be borne in mind."

The following sentences should be added at the end of this paragraph:

"Any restrictions of the international search on these grounds should be indicated in the international search report. If no search is made, a declaration should be issued under Article 17(2)(a) of the PCT."

47. Paragraph 2.2: This paragraph should read as follows:

"Next, the search examiner should select the units of the classification and/or other sections of the documentation (for example, mechanized search systems or abstracting journals) to be consulted for the international search, both in all directly relevant fields and in analogous fields. In searches made by using the International Patent Classification, the selection of classification units in related fields should be limited to:

- (i) higher subdivisions allowing searching by abstraction (generalization) inasmuch 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."

48. Paragraph 2.3: The second sentence of this paragraph should read as follows:
"He should give precedence to the units in which the probability of finding relevant documents is highest."

49. Paragraph 2.5: The first sentence of this paragraph should read as follows:
"The search examiner should concentrate his search efforts on the classification units in which the probability of finding highly relevant documents is greatest."

50. Paragraph 2.8: The second sentence of this paragraph should read as follows:
"The international search may also be stopped when documents have been found clearly demonstrating lack of novelty 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, application of which features would not involve inventive step."
The last sentence, in square brackets, should be deleted.

51. Paragraph 3.1: The last sentence of this paragraph should read as follows:
"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 and International Preliminary Examining Authorities the opportunity to consider the matter more fully."

52. Paragraph 3.2: The last sentence of this paragraph, in square brackets, should be deleted.

53. Paragraph 3.4: The third sentence of this paragraph should read as follows:
"Thereafter, if within two years from the priority date of the international application the International Searching Authority should discover any particularly relevant document, it should bring this to the notice of the applicant and of the International Bureau for subsequent communication to the designated Offices and International Preliminary Examining Authorities and for publication."

CHAPTER V (New)--CLASSIFICATION OF INTERNATIONAL APPLICATIONS

54. The Working Group decided to transfer the contents of Chapter V of the draft PCT Search Guidelines contained in document PCT/TCO/VI/8, Annex A (as amended by the Working Group), to Chapter VI of the Guidelines under an amended title (see paragraph 55 below). Furthermore, the Working Group adopted as Chapter V the title appearing above and the provisions set out hereunder:

"1. Classification involves the assigning of one or more classification symbols to a particular international application whereby the technical subject of the invention of that application is identified. Every international application must be classified by the International Searching Authority, at least, according to the International Patent Classification (IPC) in full (PCT Rule 43.3) and this Chapter deals only with such mandatory classification. This involves the assigning of the appropriate IPC symbols identifying the technical subject of the claimed invention (or the subjects of each of the claimed inventions, if there are more than one), such identification being as precise and comprehensive as the classification permits, together with the identification of any "supplementary" and "complementary" information contained in the document being classified which it is appropriate so to identify in accordance with the Guide to the IPC. The assigned IPC symbols appear on the published international application.

"2. The classification of the international application will be determined by the search examiner, who should apply all classification symbols required by the rules of the IPC, not only in respect of the claimed invention ("Obligatory Classification"), but also the "supplementary" and "complementary" information (Non-Obligatory Classification) as defined in the current edition of the Guide to the IPC. Preferably this should be done when he has studied the content of the application in order to carry out the search. However, if, exceptionally, publication of the application is due before search, it will be necessary for the search examiner to study the application sufficiently to determine the classification at this earlier stage. The terms "Obligatory Classification" and "Non-Obligatory Classification" are defined in the Recommendation of the Committee of Experts of the IPC Union annexed hereto (Annex A). The search examiner should first of all identify and classify the technical subject or subjects of the invention in accordance with the guidance given under "Obligatory Classification." Further guidance, if required, will be found in Chapter III, paragraphs 3.1 and 3.2.

"3. If the international application requires classification in more than one sub-class, or more than one main ("00") group within a sub-class, then all such classifications should be assigned. It is particularly important that the classification of the invention itself should be distinguished from any "supplementary" or "complementary" classification and that, where it is necessary to assign more than one symbol for the invention itself, that which in the search examiner's opinion most adequately identifies it, or, when this presents difficulties, that which identifies the invention for which most information is given, should be indicated first, e.g. in order to facilitate subsequent allotment of the applications.

"4. The classification should be determined without taking into consideration the probable content of the international application after any amendment, since this classification should relate to the disclosure in the international application as filed. If, however, the search examiner's understanding of the invention, or of the content of the application as filed, alters significantly as a result of the search (e.g., as a result of prior art found, or because of the clarification of apparent obscurities), he should amend the classification accordingly unless it is too late for publication.

"5. In the case where the international search report is not available in time for publication with the international application and is therefore published separately, and the search examiner finds it necessary to amend the original classification for the reasons given in paragraph 4 above, he should include the amended classification in the international search report, indicating that it replaces that published on the international application. Such amendment of the classification should not be made unless the search examiner is quite certain that it is necessary.

"6. When the scope of the invention is not clear, the classification will have to be based on what appears to be the invention insofar as this can be understood. It may then be necessary to amend it if obscurities are removed by the search, as discussed in paragraph 4 above.

"7. All claimed inventions must be fully classified, whether or not there is lack of unity of invention, since all will be disclosed in the published application. Each invention claimed is to be classified as set out in paragraphs 2 to 6 above."

CHAPTER VI (New) = CHAPTER V (Old)--RELEVANT PRIOR ART

55. In accordance with the decision of the Working Group referred to in paragraph 54, the title of Chapter VI (New), replacing the previous title, is as appears above (i.e., Relevant Prior Art). The Working Group retained only paragraph 2 of the previous Chapter VI in Chapter VI (New). The said paragraph 2 was placed at the end of the contents of the previous Chapter V (Chapter V (Old)) and renumbered accordingly as paragraph 8.1. The amendments made to the provisions of Chapter V (Old) are set out in paragraphs 56 to 70 below, which otherwise retain their previous paragraph numbering.

56. Paragraph 1.1: This paragraph should read as follows:

"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 (i.e., that it is or is not obvious), provided that the making available to the public occurred prior to the international filing date."

57. Paragraph 1.2: This paragraph should read as follows:

"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))."

58. Paragraph 2.1: This paragraph should read as follows:

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

59. Paragraph 2.2: This paragraph should read as follows:

"A document takes away the novelty of any subject matter explicitly contained in the document."

60. Paragraph 2.4: This paragraph should read as follows:

"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, e.g., a disclosure of copper takes away the novelty of metal, and one of rivets takes away the novelty of fastening means."

61. Paragraph 3: This paragraph should be deleted.

62. Paragraph 4: The title of this paragraph should read as follows:

"Documents to be cited according to PCT Rule 33.1(c)."

63. Paragraph 4.1: This paragraph should read as follows:

"Where the search examiner finds in the search files any published application or any patent whose publication date is later but whose filing date, or, where applicable, claimed priority date, is earlier than the international filing date of the international application searched, and which would constitute relevant prior art for the purposes of Article 15(2), had it been published prior to the international filing date, the application, or patent, shall be specially mentioned in the international search report (PCT Rule 33.1(c))."

64. Paragraph 5.1: This paragraph should read as follows:

"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 date for assessing relevant 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))."

65. Paragraph 5.2: The first sentence of this paragraph should read as follows:
"The International Searching Authority will therefore take into account 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."
66. Paragraph 5.3: The second sentence of this paragraph should read as follows:
"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 mentioned in the international search report."
The third sentence of this paragraph should read as follows:
"No special search 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 fact that the country of residence of the applicant is 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."
67. Paragraph 5.4: This paragraph should read as follows:
"The international search will mainly take into consideration documents published before the international filing date of the international application. However, some extension may be necessary for specific purposes, as is apparent from Chapter VI, paragraphs 1.2 and 4.1."
68. Paragraph 6.2: The following sentence should be added between the first and second sentences of this paragraph:
"Both documents should then be mentioned in the international search report."
69. Paragraph 7: The title of this paragraph should be amended as follows:
"Matters of doubt regarding relevant prior art."
70. Paragraph 7.1: The second sentence of this paragraph should be amended as follows:
"The International Searching Authority should try to remove any doubt that may exist and should cite the documents concerned in the international search report unless the date of publication or of public availability of the document concerned is clearly later than the filing date of the international application. Additional documents providing evidence in the matters of doubt may be cited."
The third sentence of this paragraph should be deleted.
71. Paragraph 7.2: The following paragraph should be inserted:
"Any indication in a document of the date of its publication should be accepted by the International Searching Authority as correct unless proof to the contrary is offered, e.g. by the International Searching Authority, showing earlier publication, or by the applicant, showing later publication. If the indicated date of publication is insufficiently precise (e.g., because a year or year and month only are given) to establish whether publication was before the filing date of the international application, the International Searching Authority should endeavor to establish the exact date with sufficient precision for that purpose. A date of receipt stamped on the document, or a reference in another document, which must then be cited, may be of assistance in this respect."
72. Paragraph 8: The title of this paragraph should read as follows:
"Evaluating the inventive step."
73. Paragraph 8.1: This paragraph (formerly paragraph 2 of Chapter VI (Old)), should read as follows:
"The inventive step will have to be evaluated 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

74. Paragraph 2: This paragraph should read as follows:

"The International Searching Authority will inform the applicant of the lack of unity of invention by a communication, preceding the issue of the international search report, which will contain an invitation to pay additional fees. This invitation must specify the reasons for which the international application is not considered as complying with the requirement of unity of invention, identify the separate inventions and indicate the amount to be paid (PCT Rule 40.1). The invention(s) or group(s) of inventions, other than the one first mentioned in the claims, will be searched only if the applicant pays the additional fees. Since these payments must take place within a period to be set by the International Searching Authority (PCT Article 17(3)(a) and Rule 40.3) and within the time limit for the international search report set by PCT Rule 42, the International Searching Authorities should endeavor to ensure that searches be made as early as possible."

75. Paragraph 5: This paragraph should read as follows:

"As indicated in Chapter VII, paragraph 1, the basic criterion for unity of invention is the presence of a single general 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 is in itself no reason for objection on the grounds of lack of unity of invention."

76. Paragraph 6: This paragraph should read as follows:

"Rule 13.2 particularly specifies certain combinations of different categories of claims that should not be objected to on the grounds of lack of unity of invention."

77. Paragraphs 9 to 11: These paragraphs should be replaced by the following:

"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 single general inventive concept.

"10. Whether the lack of unity of invention may be directly evident "a priori" or becomes apparent "a posteriori," the search examiner, when he finds that a situation of lack of unity of invention exists, shall (except in the situation referred to in paragraph 12) immediately inform the applicant of his finding and invite the applicant to pay additional search fees. The search examiner shall then search or continue to search the invention first mentioned in the claims ("main invention"). The international search for additional inventions will then have to be completed only if and when the additional fees are paid.

"11. Reasons of economy may make it advisable for the search examiner, while making the search for the main invention, to search at the same time, despite the non-payment of additional fees, the additional inventions in the classification units consulted for the main invention if this takes little or no additional search effort. The international search for such additional inventions will then have to be completed in any further classification units which may be relevant, when the additional search fees have been paid. This situation may occur when the lack of unity of invention is found either "a priori" or "a posteriori."

"12. Occasionally in cases of lack of unity of invention, especially in an "a posteriori" situation, 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 search examiner may decide to complete the international search for the additional invention(s) together with that for the invention first mentioned. All results should then be included in the international search report, and no objection of lack of unity of invention should be raised."

CHAPTER VIII--EXCLUSIONS FROM THE INTERNATIONAL SEARCH

78. The Working Group agreed that the title of this Chapter should be as appears above and that the contents of the Chapter should read as follows:

"1. Subjects

1.1 PCT Rule 39 specifies certain subjects which an International Searching Authority is not required to search. The subjects which a particular International Searching Authority will not search under PCT Rule 39 will be set forth in the agreement between that International Searching Authority and the International Bureau. Therefore, the subjects excluded from the international search under PCT Rule 39 may vary between the various International Searching Authorities. Furthermore, the International Searching Authorities are not required to search subjects that are generally accepted not to be patentable subjects or susceptible of industrial application.

1.2 Where the subject matter of only some of the claims is a subject excluded from the search (see paragraph 1.1 above), this will be indicated in the international search report. Search should of course be made in respect of the other claims.

1.3 In cases of doubt as to whether subject matter covered by a claim constitutes a subject excluded from the search, the International Searching Authority should carry out the international search to the extent that this is possible in the available documentation.

"2. Obscurities, Inconsistencies or Contradictions

2.1 A situation where a meaningful international search is not possible for all or part of the claimed subject matter, and where a declaration to this effect may take the place of the international search report or be an observation therein, may result from the fact that the international application contains 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 (PCT Article 17(2)(a)(ii) and (b)). The International Searching Authority in these cases should make a meaningful search to the extent that this is possible and should not ask for clarification."

CHAPTER IX--INTERNATIONAL SEARCH DOCUMENTATION

79. The Working Group agreed that the contents of this Chapter should be as follows:

"1. In Article 15(4) the PCT requires the International Searching Authority to endeavor to discover as much of the relevant prior art as its facilities permit and, in any case, consult the minimum documentation specified in PCT Rule 34. The International Searching Authority must have in its possession at least this minimum documentation properly arranged for search purposes (PCT Rule 36.1(ii)).

"2. The international search documentation is a document collection that is systematically arranged (or otherwise systematically accessible) for search purposes according to the subject matter content of the documents, which are primarily patent documents supplemented by a number of articles from periodicals and other non-patent literature.

"3. The minimum documentation consists of:

(i) national patent documents specified in PCT Rule 34.1(b)(i) and (c), a detailed list of which has been published by the International Bureau (see Annex B for the reference number of the published detailed list);

(ii) published international (PCT) applications, published regional applications for patents and inventors' certificates and published regional patents and inventors' certificates specified in PCT Rule 34.1(b)(ii);

(iii) such other published items of non-patent literature as are published in a list by the International Bureau under PCT Rule 34.1(b)(iii) (see Annex B for the reference number of the published list).

"4. Not all members of a patent family need to be physically present in the systematically arranged search files (see document PCT/TCO/IV/18, paragraph 28(i)). The question which member or members of a patent family should be included in the search file is left to the discretion of each International Searching Authority, so long as access to other members of the family is provided (see document PCT/TCO/VI/16, paragraph 81)."

CHAPTER X--THE INTERNATIONAL SEARCH REPORT

80. The Working Group agreed that the contents of this Chapter should be as follows:

"1. General

1.1 The results of the international search will be recorded in the international search report, which is transmitted to the applicant and to the International Bureau and serves as a basis for publication and for examination of the international application by the designated Offices and the International Preliminary Examining Authority.

1.2 The search examiner is responsible for seeing that the international search report is drawn up in handwriting or by typing on a preprinted form for subsequent retyping in final form.

1.3 This Chapter contains information which is necessary to enable the search examiner to complete the form correctly. Further information is contained in the following sections of the Administrative Instructions:

- for the indication of dates: Section 110
- for the classification of the international applications: Section 504
- for the identification of the cited documents: Section 503
- for the indication of special categories of documents: Sections 505 and 508
- for the indication of the claims to which cited documents are relevant: Section 509.

1.4 The international search report must contain no matter, in particular, no expressions of opinion, reasoning, arguments or explanations, other than as required by the form (PCT Rule 43.9).

"2. Different types of international search reports

2.1 The International Searching Authority shall draw up the following types of search report:

- (a) International search report (see Chapter III, paragraph 4.1),
- (b) International-type search report (see Chapter III, paragraph 4.2).

"3. Form and language of the international search report

3.1 The preprinted search report form for use by the search examiner contains two main pages to be used for all searches for recording the important features of the search such as the fields searched, and for citing documents revealed by the search, and two optional additional sheets (see Forms PCT/ISA/210 and 201 annexed to the Administrative Instructions). One of these is to be used only when modifications in the title or abstract to be published are desired (see Chapter X, paragraph 5). The other supplemental sheet is to be used only when restrictions have been applied as to the subject of the search (see Chapter X, paragraph 6).

3.2 The international search report shall be drawn up in the language in which the international application to which it relates is published (PCT Rule 43.4).

"4. Areas of technology searched

4.1 The international search report shall list the classification identification of the fields searched. If the IPC is not used for this purpose, the classification used has to be published (PCT Rule 43.6(a)).

4.2 Where the international search report is entirely or partly based on a previous search made for an application relating to a cognate subject, the search files consulted for this previous search must also be identified in the report as having been consulted for the international application in question.

"5. Abstract

5.1 In the international search report, the search examiner must indicate approval or amendment of the text of the abstract, the title of the invention, and the selection of the figure which is to accompany the abstract (PCT Rules 8 and 44.2) (see Chapter XI). If amendment is desired, the details thereof should be indicated.

"6. Restriction of the subject of the international search

6.1 The report must indicate whether the search was restricted or not for any of the reasons indicated in the following paragraph.

6.2 If any such restrictions were applied, the claims in respect of which a search has not been carried out must be identified and the reasons for this should be indicated.

The three categories where such restrictions may arise are:

- (a) lack of unity of invention (see Chapter VII); the total number of separate inventions is to be indicated;
- (b) claims drawn to subject matter excluded from the search (see Chapter VIII);
- (c) claims in respect of which a meaningful search cannot be carried out (see Chapter VIII).

"7. Authentication and dates

7.1 The identification of the International Searching Authority which established the international search report and the date on which the report was drawn up should be indicated in the report. This date should be that of the drafting of the report by the search examiner who carried out the search (PCT Rule 43.1 and 2).

7.2 The international search report should be signed by an authorized officer of the International Searching Authority (PCT Rule 43.8)."

CHAPTER XI--THE ABSTRACT AND THE TITLE OF THE INVENTION

81. Paragraph 1 (new paragraph): The following paragraph should be inserted:

"The international application must contain an abstract. The purpose of the abstract is to give brief technical information about the disclosure as contained in the description, claims and any drawings."

82. Paragraph 2: This paragraph (formerly paragraph 1 of Chapter XI) should read as follows:

"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 international application or later (PCT Rule 38.2(b))."

In doing this he should consider the abstract in relation to the application as filed (see Chapter IV, paragraph 1.4). [If the international search report is published later than the international application, the abstract published with the application will be as filed, subject to the results of the examination referred to in Chapter IV, paragraph 1.6, and the definitive abstract will be published together with the search report.]"

[The above text in square brackets was adopted by the Working Group on the basis that the text would be subject to review after consideration by the PCT Working Group on Publication and Drawings of questions related to the publication of the international application.]

83. Paragraph 3: This paragraph (formerly paragraph 2 of Chapter XI) should read as follows:

"In determining the definitive content of the abstract the search examiner should take into consideration the fact 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)."

84. Paragraph 4: This paragraph (formerly paragraph 3 of Chapter XI) should read as follows:

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

85. Paragraph 5: This paragraph (formerly paragraph 4 of Chapter XI) should read as follows:

"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 shall select a different figure, or figures, of the drawings if he considers that they better characterize 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."

86. Paragraph 6: (New paragraph) The following paragraph should be inserted

"The search examiner will be required to approve or establish the title of the invention (PCT Rules 37.2 and 44.2(a)). The cases in which he will be required to establish the title will be:

(i) where the international application does not contain the title and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish the title, or

(ii) where the search examiner finds that the title does not comply with the requirements set out in PCT Rule 4.3 (PCT Rule 37.2) (see also Chapter IV, paragraph 1.4)."

GUIDELINES FOR INTERNATIONAL PRELIMINARY EXAMINATION UNDER THE PCT

87. The Working Group held a general discussion on these Guidelines (hereinafter referred to as "the PCT Examination Guidelines") based on documents PCT/TCO/VI/9 and PCT/WG/GSE/I/3 and 5. Having regard to the fact that general comments were already contained in document PCT/WG/GSE/I/3, the Working Group limited its discussion to a consideration of the procedure that should be adopted to advance the work of finalizing these Guidelines.

88. The Working Group agreed that, since document PCT/TCO/VI/9 was more in the nature of a compilation of comments on provisions considered by various prospective PCT Authorities as appropriate for inclusion in guidelines for international preliminary examination under the PCT than of actual guidelines, it was desirable, in order to provide a better basis for the establishment of the PCT Examination Guidelines,

that a single draft text be prepared. The Working Group proposed that the International Bureau should undertake the task of preparing such a text. In preparing the text, the International Bureau should take into account such provisions of the latest (published) text of the Guidelines for Substantive Examination established in the framework of the Interim Committee of the EPO ("the EPO Examination Guidelines") as were appropriate to international preliminary examination under the PCT, as well as the responses from prospective PCT Authorities set out in document PCT/TCO/VI/9 and the observations contained in document PCT/WG/GSE/I/3.

89. The Working Group suggested that, where the responses that had already been received from prospective PCT Authorities indicated general agreement as to the inclusion of particular provisions, the International Bureau should include such provisions in the draft text to be prepared by it. However, where the proposals contained in the responses of the prospective PCT Authorities could not be reconciled, the International Bureau should make a compilation of these responses and also present its own proposals.

90. The Working Group proposed that the text prepared by the International Bureau be submitted to the members of the Working Group in sufficient time to enable detailed consideration to be given to the text. Taking into account the limited time available to the International Bureau for the completion of this work, the Working Group suggested that the International Bureau might submit its text on a Chapter-by-Chapter basis. It was further suggested that consideration be given to the early preparation of the Chapter dealing with examination procedure, particularly since the nature of international preliminary examination would require provisions in that Chapter substantially different from those contained in the EPO Examination Guidelines.

91. The next session of the Working Group will take place in Geneva from June 20 to 24, 1977.

92. This report was unanimously adopted by the Working Group at its closing meeting on February 18, 1977.

[Annex follows]

LIST OF PARTICIPANTS/
LISTE DES PARTICIPANTS

(in the English alphabetical order of the names of the States)
(dans l'ordre alphabétique anglais des noms des Etats)

I. STATES/ETATS

AUSTRIA/AUTRICHE

Mr. G. GALL, Ratssekretaer, Federal Ministry of Trade and Industry, Austrian Patent Office, Vienna (as of 16.2.77)

GERMANY (FEDERAL REPUBLIC OF)/ALLEMAGNE (REPUBLIQUE FEDERALE D')

Mr. J. HAUGG, Regierungsdirektor, German Patent Office, Munich

HUNGARY/HONGRIE

Ms. E. PARRAGH, Deputy Head of Section, National Office of Inventions, Budapest

JAPAN/JAPON

Mr. I. SHAMOTO, Appeal Examiner-in-Chief, Department of Appeal, Patent Office, Ministry of International Trade and Industry, Tokyo

NETHERLANDS/PAYS-BAS

Mr. J. DEKKER, Vice-President, Netherlands Patent Office, Rijswijk (Z.H.)

Mr. S. de VRIES, Examiner, Patents Council, Netherlands Patent Office, Rijswijk (Z.H.)

NORWAY/NORVEGE

Mr. O. OS, Overingeniør, Norwegian Patent Office, Oslo

SOVIET UNION/UNION SOVIETIQUE

Mr. L. KOMAROV, Deputy Chairman, State Committee for Inventions and Discoveries of the USSR Council of Ministers, Moscow

Mr. V. TROUSSOV, Head of Department, TSNIPPI, State Committee for Inventions and Discoveries of the USSR Council of Ministers, Moscow

Mr. S. EGOROV, First Secretary, Permanent Mission of the USSR, Geneva

SWEDEN/SUEDE

Mr. Y. TRUVE, Member of the Board of Appeal, Royal Patent and Registration Office, Stockholm

Ms. B. SANDBERG, Counsellor, Royal Patent and Registration Office, Stockholm

UNITED KINGDOM/ROYAUME UNI

Mr. D. G. GAY, Superintending Examiner, The Patent Office, London

Mr. M. F. VIVIAN, Senior Examiner, The Patent Office, London

UNITED STATES OF AMERICA/ETATS-UNIS D'AMERIQUE

Mr. L. MAASSEL, Patent Procedure Specialist, United States Patent and Trademark Office, Washington, D.C.

II. INTERGOVERNMENTAL ORGANIZATIONS/ORGANISATIONS INTERGOUVERNEMENTALES

EUROPEAN PATENT ORGANISATION (EPO)/ORGANISATION EUROPEENNE DES BREVETS

Mr. K. MELLOR, Administrator, Secretariat of the Interim Committee of the European Patent Organisation, Brussels

INTERNATIONAL PATENT INSTITUTE/INSTITUT INTERNATIONAL DES BREVETS (IIB)

M. J. DELORME, Directeur Général, IIB, Rijswijk (Z.H.), Pays-Bas

M. J. A. H. van VOORTHUIZEN, Directeur Technique Adjoint, IIB, Rijswijk (Z.H.) Pays-Bas

III. NON-GOVERNMENTAL ORGANIZATIONS/ORGANISATIONS NON-GOUVERNEMENTALES

COUNCIL OF EUROPEAN INDUSTRIAL FEDERATIONS (CEIF)/CONSEIL DES FEDERATIONS INDUSTRIELLES D'EUROPE

Mr. M. van DAM, Patent Agent, Eindhoven, Netherlands

EUROPEAN FEDERATION OF INDUSTRIAL PROPERTY REPRESENTATIVES OF INDUSTRY/
FEDERATION EUROPEENNE DES MANDATAIRES DE L'INDUSTRIE EN PROPRIETE INDUSTRIELLE (FEMIFI)

Mr. F. J. JENNY, Patent Department, Ciba-Geigy AG, Basle, Switzerland

INTERNATIONAL FEDERATION OF INDUSTRIAL PROPERTY ATTORNEYS/FEDERATION INTERNATIONALE DES CONSEILS EN PROPRIETE INDUSTRIELLE (FICPI)

M. R. M. CHAUCHARD, Conseil en Brevets, Paris, France

UNION OF INDUSTRIES OF THE EUROPEAN COMMUNITY/UNION DES INDUSTRIELS DE LA COMMUNAUTE EUROPEENNE (UNICE)

Mr. M. van DAM, Patent Agent, Eindhoven, Netherlands

IV. OFFICERS/BUREAU

Chairman/Président	:	Mr. J. DELORME	(IIB)
Vice-Chairmen/ Vice-Présidents	:	Mr. L. MAASSEL Mr. I. SHAMOTO	(United States of America/Etats Unis d'Amérique) (Japan/Japon)
Secretary/Secrétaire:	:	Mr. J. FRANKLIN	(WIPO/OMPI)

V. INTERNATIONAL BUREAU OF WIPO/BUREAU INTERNATIONAL DE L'OMPI

Mr. F. A. SVIRIDOV, Deputy Director General/Vice-directeur général

Mr. E. M. HADDRICK, Head, PCT Division/Chef de la Division du PCT

Mr. J. FRANKLIN, Counsellor/Conseiller, Head, PCT Technical Section/Chef de la section technique du PCT

Mr. N. SCHERRER, Counsellor/Conseiller, PCT Division/Division du PCT

Mr. D. BOUCHEZ, Technical Counsellor/Conseiller technique, PCT Division/Division du PCT

Mr. Y. GYRDYMOV, Technical Officer/Assistant technique, PCT Division/Division du PCT

Mr. A. OKAWA, Consultant, PCT Division/Division du PCT