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PATENT COOPERATION TREATY

INTERIM ADVISORY COMMITTEE FOR ADMINISTRATIVE QUESTIONS

Fourth Session: Tokyo, October 22 to 27, 1973

PROPOSALS OF GERMANY (FEDERAL REPUBLIC OF)
REGARDING THE DRAFT ADMINISTRATIVE INSTRUCTIONS UNDER
THE PATENT COOPERATION TREATY (DOCUMENT PCT/AAQ/IV/2)

prepared by the International Bureau

1. In a letter, dated September 18, 1973, the German Patent Office has presented the following observations on the Draft Administrative Instructions under the PCT (document PCT/AAQ/IV/2):

"Although it was suggested at the April meeting of the Standing Sub-Committee that citations of particular relevance should be indicated in the international search report not by underlining but by making a mark in an additional column of the international search report (Doc. PCT/TCO/SS/IV/15, page 3, para. 13), the recently submitted Draft Administrative Instructions under the PCT, Section 305, (Doc. PCT/AAQ/IV/2, page 18), provide again for underlining. In order to take into account the proposal submitted by the Standing Subcommittee I suggest to amend the text of Section 305 as follows:

"Section 305

CITATIONS OF PARTICULAR RELEVANCE IN THE INTERNATIONAL SEARCH REPORT UNDER RULE 43.5 (c)

Citation under Rule 33.1 (b) and Rule 33.1 (c), and citations of particular relevance under Rule 43.5 (c) shall be indicated by specifying the corresponding Rule in the column "Special mention" of the international search report."

According to the experiences I have made with isolated search, I also think it desirable to specially indicate those citations which are not meant to be citations against the characterizing portion of the claims but which a) concern the general prior art, b) contain the background art indicated in the introduction to the description without mentioning any particular citations, or c) concern the statement in the main claim indicating those technical features of the invention which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art. I therefore suggest to add to the PCT Administrative Instructions the following section:

"Section 308

CITATIONS IN THE INTERNATIONAL SEARCH REPORT NOT
ALLOCATED TO PARTICULAR CLAIMS

Citations which

- a) concern the general prior art,
- b) contain the background art indicated in the introduction to the description without mentioning the relevant citations,
- c) concern the statement in the main claim indicating those technical features of the invention which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art,

shall be indicated in the column "Special mention" of the international search report by specifying "Section 308 (a)", or "Section 308 (b)", or "Section 308 (c)", as the case may be."

2. It should be noted that with a view to furthering the study of the problem of how to indicate citations of particular relevance, the substance of the proposal referred to above made by the Standing Subcommittee in its fourth session has already been incorporated into the second draft of the printed forms (see document PCT/AAQ/IV/4). The PCT Interim Advisory Committee for Administrative Questions has so far not had the opportunity to consider this matter. Consequently, the Administrative Instructions have not yet been adapted to the method proposed by the Standing Subcommittee. Section 305 of the Administrative Instructions should, however, be considered together with the tentative proposal of the Standing Subcommittee, as implemented in the printed forms (see document PCT/AAQ/IV/4), and with the proposed amendment to that Section referred to above.

3. The Interim Committee is invited to consider the above proposals during the discussion of document PCT/AAQ/IV/2.

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