

WIPO



PCT/R/WG/2/1 Add.1

ORIGINAL: English

DATE: April 25, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Second Session
Geneva, April 29 to May 3, 2002

PROPOSED EXPANDED INTERNATIONAL SEARCH SYSTEM: EPO RESPONSE
(ADDENDUM TO DOCUMENT PCT/R/WG/2/1)

Proposals submitted by the European Patent Office (EPO)

EPO RESPONSE TO DOCUMENT PCT/R/WG/2/1

Generally

1. The European Patent Office (EPO) supports in principle the proposal described in the working document, subject to certain points of detail which are mentioned at paragraphs 11-14 below. In fact the EPO sees an expanded international search report system as the preferred avenue for the international stage processing of all international applications in the longer term. *A model of such an expanded international search report comprising the international search report and an international search opinion is annexed to this document.* This would involve the removal of the current distinction between PCT Chapter I and Chapter II processing under PCT as has already been advocated by the US delegation in documents PCT/R/1/2 and PCT/R/WG/1/2.

2. While it appears to be recognized within the Working Group that the workload problems faced by some if not all International Authorities under PCT are “an important feature in the background” in fact the significance of this problem is much deeper; it has to be considered as a prime factor in the need for PCT reform. The intolerable burden on many

E

of the International Authorities under PCT (and here it should be borne in mind that the EPO performed over 60% of all international search work and 57% of all international preliminary examination work in 2001) represents not just a practical problem for the International Authorities concerned, rather a serious threat to the continuing viability of the PCT system as a whole.

3. The current inefficiencies in the system must be eliminated. An elaborate optional international preliminary examination system involving the issue of a first written opinion followed by an automatic right of response followed in turn by further possible written opinions followed by an International Preliminary Examination Report, all within a very narrow time limit, may have been feasible when the PCT was drafted, however, given the exponential growth in use of the system in recent years a fundamental overhaul is necessary.

Objectives of reform as seen by the EPO

4. What has to be achieved to ensure a functioning PCT system in the 21st Century is an efficient procedure for processing international applications which delivers high quality search reports and opinions on patentability which meet the needs of applicants as well as third parties and national offices and which can be delivered at reasonable cost and within a reasonable time frame. To this end the EPO considers that medium term efforts should concentrate on removing the uncertainty inherent in the current system whereby a demand for international preliminary examination may or may not be filed sometime after issue of the international search report. This has the added disadvantage that whether or not an opinion on patentability ultimately becomes available is entirely in the hands of the applicant.

5. In the EPO's view, it is both efficient and desirable to combine international search and the principal elements of international preliminary examination in an expanded international search report. This product would be available for all international applications without the need to file any demand for international preliminary examination and would represent significant added value compared with an international search report alone. The applicant would receive a preliminary opinion on patentability (ISO) at an early stage rather than as at present having to wait for a first written opinion and IPER. Third parties and national offices would have access to comprehensive information on whether a given invention meets the requirements of patentability, *without depending on the applicant to file a demand.*

Advantages of an EISR System

6. Combined with the recent change to Article 22 PCT *all applicants* would have maximum opportunity to consider the desirability of entering the national/regional phase. It could then reasonably be expected that most "dead wood" applications would be sifted out of the system during the international phase. This would also allow *national offices* to avoid the prohibition in Article 42 PCT forbidding national offices in receipt of an International Preliminary Examination Report from requiring the applicant to furnish information on the content of parallel prosecution of the application before other national offices. This would be a considerable advantage to those national offices which lack sufficient resources to examine international applications for themselves.

Procedure

7. The applicant's right to amend and/or comment on his application would not be affected under such a system. The EPO appreciates the concerns which may exist on the part of some

applicants about the effect of an ISO which is in any sense negative before certain designated offices. However, nothing would prevent applicants from filing amendments to the international application under Article 19 PCT or submitting comments on the EISR as envisaged at Paragraph 7 of the working document. These amendments/comments would be taken into account during national/regional as opposed to international processing. The right to amend before the designated offices under Article 28 PCT would also remain unaffected.

8. It is appreciated that the opportunity for dialogue between applicant and IPEA is enshrined in Chapter II of the PCT, however it is submitted that given the availability of an ISO in all cases, the longer term need for such a dialogue based system must be reconsidered. From a practical point of view also, if, as expected, only a minority of applicants continue to make use of Chapter II, the economic sustainability of such a system must be questionable. In the EPO's view the ISO would in due course replace PCT Chapter II. Of course the opportunity for dialogue must be preserved – but is it right that this should take place during international processing when the time available for genuine dialogue is very limited? It is suggested that it would be more appropriate to shift the dialogue phase of the PCT procedure to national/regional processing, when the time pressure is not so acute.

9. Applicants would of course remain free to initiate national/regional processing before any particular national office before expiry of the usual 30/31 month time limit under Article 23(2) PCT. This could well include the national or regional office responsible in its capacity as International Search Authority for the EISR. The international phase would still be pending before the other national offices but the communications between applicant and “the early entry” national office could, under certain circumstances, give rise to a product not dissimilar in content to a current IPER susceptible to assisting prosecution of the international application before those other national offices.

10. These comments represent the EPO's general outlook on the concept of an EISR System. It is appreciated that these ideas may involve a more fundamental revision of the PCT than is envisaged in this first stage of reform. However, the EPO is firmly of the view that the current proposal for EISR should be seen as a step in this overall direction and it should be avoided so far as possible at this stage to entrench in any proposed rule changes concerning EISR references to international preliminary examination which may well become obsolete and inappropriate in light of the development of the EISR system.

As to the working document itself, the following points occur:

11. *Paragraphs 9 and 10:* the EPO fully supports the applicant's right to submit comments and make amendments in light of the ISO but a clear distinction must be drawn between the two. If the applicant wishes amendments to be taken into account during national/regional processing he must clearly indicate this and where appropriate file replacement sheets. It should be avoided at all costs that the burden of deciding whether comments incorporate amendments fall upon the national offices. With this in mind it is suggested to amend proposed Rule 43*ter*.2 (b) to exclude the possibility of filing amendments within comments – rather amendments should always be filed separately.

12. *At paragraph 25:* reference is made to a “second written opinion.” This is unacceptable since Rule 66.4 already makes provision for the issue of one or more written opinions *at the discretion of the IPEA*. Introducing an *obligation* to issue a second written opinion could only increase the workload pressure on the International Authorities and lead to delay in establishing the IPER. This would be in the interest of neither the International

Authorities nor the elected offices. If the applicant reacted to the ISO it is suggested that the IPEA proceed immediately to issue of the IPER without any interim second written opinion. Of course provision could be made for the applicant to submit comments on the IPER, along the same lines as the procedure described at Paragraphs 8 and 9 of the working document in relation to the ISO, however these comments would be taken into account only during national/regional processing, not during the international phase. In view of these remarks it is suggested that all reference to the proposed Rule 66.4(a-bis) be deleted.

13. As to the question of introducing *a fixed time limit for filing the demand*, this is supported. However the time limit should be calculated with reference to the date of issue of the international search opinion only. The suggestion to allow the demand to be filed together with the international application is not supported. The purpose of the ISO would be to provide a high value written opinion in light of which the applicant should be in a position to assess the prospects for further prosecution of the international application. It is to be anticipated that this opinion will meet the needs of the vast majority of applicants and together with the recent amendment to the time limit under Article 22 PCT future use of Chapter II is likely to diminish. It would be contrary to the underlying rationale of the EISR proposal to allow demands to be filed before the international search opinion had even issued. International Authorities could then be faced with having to process demands for international preliminary examination which had only been filed as a precaution and which, had the applicant given due consideration to the international search opinion would not have been filed; they could also be faced with the administrative burden of dealing with large scale withdrawal of demands after issue of the international search opinion. Proposed Rule 54bis.1 should be amended accordingly. The following is suggested:

“Rule 54bis.1 *Time limit for Making a Demand*

“(a) A demand may be made within two months from transmittal of the international search opinion to the applicant under Rule 43bis.4.”

14. Consideration should be given to the question of transitional provisions for applications filed and still pending before entry into force of the proposed EISR system as well as an opportunity for the International Authorities to adapt themselves to the new system.

15. The Working Group is invited to consider the proposals contained in this document.

[Annex I follows]

ANNEX I

PATENT COOPERATION TREATY (PCT)
INTERNATIONAL SEARCH REPORT (ISR) - PART 1
(PCT Article 18 and Rules 43 and 44) - (Form PCT/ISA/210)

FOR FURTHER ACTION See Notification of Transmittal of ISR (Form PCT/ISA/220) as well as, where applicable, abstract information below

Applicant's or agent's file reference: AGGR/01/01
International application No: PCT/EP01/98989
International filing date: 01 April 2001 (01/04/2001)
(Earliest) priority date: 02 April 2000 (02/04/2000)
Applicant: Heath Robinson

This report has been prepared by this International Searching Authority (IPEA) and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

It consists of two parts: Part 1 contains comments on the international application. Part 2 contains the results of the search, the subject matter classification and the fields searched.

It is also accompanied by a copy of each prior art document cited in the report.

(1) Basis of the report

With regard to the language, the international search was carried out on the basis of the international application in the language in which it was filed.

With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international search was carried out on the basis of the sequence listing: not applicable.

(2) Certain claims were found unsearchable

This report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

Claim(s) No(s): 1,2

because they relate to subject matter not required to be searched by this Authority:

Claims 1,2 directed to an instruction manual with particular wording are considered to be mere presentations of information and is subject matter the ISA is not required to search under Article 17(2)(a)(i) and Rule 39.1(v).

(3) Unity of invention is lacking

This Authority found multiple inventions in this international application, as follows:

- *Claims 1 - 18 directed to a sealing body and an instruction manual for its use*
- *Claim 19 - 28 directed to an apparatus, but not limited to an apparatus comprising the sealing body of claims 3 - 18*

No required additional search fees were timely paid by the applicant. Consequently, this International Search Report is restricted to the invention first mentioned in the claims; it is covered by claims Nos. 3-18

(4) Title

The text is approved as submitted by the applicant.

(5) Abstract

The text is approved as submitted by the applicant.

(6) Drawings

The figure of the drawings to be published with the abstract is Figure No: 1 as suggested by the applicant.

**** End of Part 1 of the ISR ****

PATENT COOPERATION TREATY (PCT)
INTERNATIONAL SEARCH REPORT (ISR) - PART 2
(PCT Article 18 and Rules 43 and 44) - (Form PCT/ISA/210)

(21) International application No.: PCT/EP01/98989	Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched: Not applicable
(51) CLASSIFICATION OF SUBJECT MATTER IPC⁷: G06K11/14	
(58) FIELDS SEARCHED Minimum documentation searched: IPC⁷: G06K	Electronic database consulted during the international search: EPO-Internal, PAJ, WPI Data

DOCUMENTS CONSIDERED TO BE RELEVANT

(Citation of document, with indication, where appropriate, of the relevant passage(*), followed by category and claim(s) No(s))

(1) US 5 332 238 A (BORUCKI G) 26 July 1994 cited in the application <i>*column 2, line 1-27; figures 4,5*</i> Category: Y Claims: 1,6,7,9 <i>*column 7, line 32-55*</i> Category: X Claims: 18	more other such documents, such combination being obvious to a person skilled in the art.
<hr/>	
Patent family information	
* US 4 816 811 A:	
	EP 0 196 186 A,B 01.10.1986
	JP 61223932 A 04.10.1986
	US 4 816 811 A 28.03.1989
	CA 1 270 309 A 12.06.1990
	DE 3 682 927 D 30.01.1992
	KR 9 309 671 B 08.10.1993
* EP 0 740 264 A:	
	JP 9044291 A 14.02.1997
* WO 98 52184 A:	
	AU 7 151 098 A 08.12.1998
	JP 11065765 A 09.03.1999
	EP 1 019 897 A 19.07.2000
	BR 9 809 121 A 01.08.2000
	CN 1 269 043 T 04.10.2000
	AU 732877 B 03.05.2001
	US 6 236 391 B 22.05.2001
<hr/>	
(2) US 5 784 054 A (KENT JOEL C ET AL) 21 July 1998; cited in the application <i>*column 6, line 61-65; figures 1,2,4,8, column 7, line 35-65*</i> Category: Y Claims: 1,6,7,14,15,18	
(3) US 4 816 811 A (BOGATIN ERIC L ET AL) 28 March 1989 <i>*column 4, line 57,58; figures 2-4*</i> Category: A Claims: 1,9	
(4) EP 0 740 264 A (GORE & ASS) 30 October 1996 <i>*column 8, line 7-10; figure 1; column 9, line 18-column 13, line 8*</i> Category: Y Claims: 1,6,7,9 Category: A Claims: 2, 18	
(5) WO 98 52184 A (ELO TOUCHSYSTEMS INC) 19 November 1998 <i>*page 21, line 9-1; figures 5,6*</i> Category: A Claims: 1, 18	
(6) US 5 852 433 A (TODA KOHJI) 22 December 1998 <i>*column 6, line 20-28; figure 1*</i> Category: A Claims: 1, 18	

Special categories of cited documents:

- A: document defining the general state of the art which is not considered to be of particular relevance.
- X: The claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone.
- Y: The claimed invention cannot be considered to involve an inventive step when the document is combined with one or

ISA/Examiner: European Patent Office

SPIGARELLI, Alfred
PB 5818, Patentlaan 2
NL 2280 HV Rijswijk
Tel. +31 - 70 340 2040
Fax. +31 - 70 340 3016

Search completed: 24 July 2001
ISR mailed: 28 July 2001

** End of the ISR **

[Annex II follows]

ANNEX II

**PATENT COOPERATION TREATY (PCT)
INTERNATIONAL SEARCH OPINION**

International application No: PCT/EP01/98989
 International filing date: 01 April 2001 (01/04/2001)
 Priority date: 02 April 2000 (02/04/2000)
 International Patent Classification (IPC)
 or national classification and IPC: G06K11/14

This opinion contains indications relating to:

- Basis of the opinion
- Non-establishment of opinion with regard to novelty, inventive step or industrial applicability
- Lack of unity of invention
- Reasoned statement with regard to novelty, inventive step or industrial applicability

(1) Basis of the opinion

This opinion has been drawn up on the basis of
(Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as 'originally filed' and are not annexed to the report since they do not contain amendments):

The description,
 pages 1-21 as originally filed

The claims,
 Nos. 1-28 as originally filed

The drawings, sheets/figs.
 1/2-2/2 as originally filed

(3) Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The question whether the claimed invention appears to be novel, to involve an inventive step or to be industrially applicable have not been examined in respect of claims Nos. 1, 2 because:
 No ISR has been established in respect of the claim(s).

(4) Lack of unity of invention

The requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is not complied with for the reasons given in the ISR. In response to the invitation to pay additional fees due for searching under Article 17(3)(a), the applicant has not paid additional fees. Consequently, the parts of the international application relating to claims 3- 18 were the subject of this opinion.

(5) Novelty, Inventive step and industrial applicability

Novelty (N): Claim(s) 3-17 Yes

Inventive Step (IS): Claim(s) 8, 10-12 Yes
 Claim(s) 3-7, 9, 14-18 No

Industrial Applicability (IA): Claim(s) 3-18 Yes

INDEPENDENT CLAIM 3

Document US-A-5 332 238, which is considered to represent the most relevant state of the art, discloses (cf. relevant passages indicated in the ISR) a device from which the subject-matter of independent claim 3 differs in that the elongate sealing body is an elongate gel body.

The problem to be solved by the present invention may therefore be regarded as finding a suitable material for making the elongate sealing body.

The solution proposed in claim 3 of the present application cannot be considered as involving an inventive step (Article 33(3) PCT) for the following reasons:

EP-A-0 740 264 (cf. relevant passages indicated in the ISR), discloses such a sealing body comprising a silicone elastomer, namely a sealing body made of a composition comprising a gel.

INDEPENDENT CLAIM 18

Document US-A-5 332 238 (cf. relevant passages indicated in the ISR) discloses in combination all the features defined in independent claim 18.

Therefore the subject matter of this claim is not new (Article 33(2) PCT).

DEPENDENT CLAIMS

The following dependent claims do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step:

The additional features of claims 4, 5 and 9 are known from document EP-A-0 740264 (cf. relevant parts indicated in the ISR);

the additional features of claims 6 and 7 are already disclosed in US-A-5 332 238 (cf. relevant passages indicated in the ISR);

**** End of the ISO****

[End of Annex and of document]