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PATENT COOPERATION TREATY

INTERIM COMMITTEE FOR TECHNICAL COOPERATION

Fourth Session: Geneva, November 14 to 19, 1974

SEARCHING UNDER THE PCT:
SEARCHING TECHNIQUES

Progress report prepared by the International Bureau

1. The Standing Subcommittee of the PCT Interim Committee for Technical Cooperation, at its third session, suggested that a survey of the searching techniques of the prospective PCT International Searching Authorities be carried out. It was proposed that this survey examine the current searching practices of the prospective International Searching Authorities in light of the searching standards to be applied under the relevant provisions dealing with PCT searches. (See paragraphs 56 to 58 of document PCT/TCO/SS/III/23.)

2. The PCT Interim Committee for Technical Cooperation (hereinafter referred to as "the Interim Committee"), at its third session held in Tokyo in October 1973, considered the question of what approach should be used to carry out the survey suggested by its Standing Subcommittee (see document PCT/TCO/III/8) and decided that the survey should be carried out through the use of a questionnaire, drawn up along the lines of the draft questionnaire annexed to document PCT/TCO/III/8 (see paragraph 65 of the Report of the third session, document PCT/TCO/III/13).

3. The members of the Interim Committee expressed their views on the questions contained in the draft questionnaire. They agreed that a revised draft questionnaire taking into account these views should be submitted to the Standing Subcommittee so that, before starting the survey, that Subcommittee may discuss the areas to be covered by the survey, the questions to be asked, and the manner in which the responses to the questions should be formulated.

4. The International Bureau has revised the draft questionnaire particularly in light of the views expressed by the members of the Interim Committee. However, since no meeting of the Standing Subcommittee has taken place in 1974, the revised draft questionnaire is being submitted to the Interim Committee for any further comments it may have before the questionnaire is submitted to the next session of its Standing Subcommittee.

5. The Interim Committee is invited to examine and comment on the revised draft questionnaire annexed hereto.

[Annex follows]

REVISED DRAFT QUESTIONNAIRE
ON CURRENT SEARCH TECHNIQUES
AND PROSPECTIVE PCT SEARCH TECHNIQUES

Purpose of the questionnaire

1. The purpose of this questionnaire is to obtain information on current searching techniques in light of the standards for PCT searches in order to pursue the aim set forth in Article 56(3)(ii) of the PCT, that is, to achieve a maximum degree of uniformity in the working methods of the International Searching Authorities and a maximum degree of uniformly high quality in their search reports.

Manner of conducting the survey

2. The questionnaire is drafted in such a way that the responses should give general information on the searching techniques now being employed by the prospective PCT International Searching Authorities and for which the PCT prescribes requirements, standards or guidelines. The responses to the questionnaire will provide some insight into the way the prospective authorities would perform searching activities, under the PCT.

3. Many questions are formulated so that they may be answered by a simple "yes" or "no". Where a question calls for more than that, the Offices are requested to answer the question in brief general terms rather than being highly specific. The intention of the International Bureau is to first generate a general information base in the areas of the questions asked in order to enable it to propose the most suitable approach to be taken in obtaining further specific information.

4. Once the responses are received, the International Bureau will, in order to obtain more specific information on present search techniques as well as general information on prospective PCT search techniques, seek the advice of the Standing Subcommittee of the PCT Interim Committee for Technical Cooperation as to whether it should either develop a more detailed questionnaire intended for all prospective International Searching Authorities, or whether it should draft specific detailed questions addressed to certain of such Authorities.

[Questions follow]

I. Procedural Checks of Requirements of an Application Prior to Search

- A. Subject Matter - Article 17(2)(a)(i) provides that International Searching Authorities are not required to search international applications which relate to subject matter as indicated in Rule 39.
1. Does your Office presently not search national applications on any particular subject matter indicated in Rule 39, and if so, on which subject matter?
- B. Meaningful Search - Article 17(2)(a)(ii) provides that the International Searching Authority is not required to search international applications in which the description, claims or drawings fail to comply with the prescribed requirements to such an extent that a meaningful search could not be carried out.
1. Does your national law prescribe requirements for the description, claims or drawings, in the nature of PCT Articles 5, 6 and 7, respectively, which have to be complied with in order that a meaningful search may be effected?
 2. If your national law prescribes such requirements, briefly state the substance of the requirements.
- C. Unity of Invention - Article 17(3) and Rules 13 and 40 prescribe a requirement of unity of invention to be applied to international applications by the International Searching Authorities.
1. Does your Office apply a unity of invention requirement to national applications and if so, what are the criteria?
 2. If your Office applies a unity of invention requirement, what procedural options (such as payment of additional fees or restriction of the invention) are available to an applicant failing to meet such requirement?
- D. Title and Abstract - Articles 3 and 14 require that an abstract and a title be part of the international application. The International Searching Authority may under certain circumstances be required to establish a title (Rule 37.2) or establish an abstract (Rule 38.2).
1. Does your Office presently require a title and an abstract as parts of a national application?
 2. Does your Office presently engage in establishing either titles or abstracts for national applications and if so, under what circumstances and to what extent?

II. Search

- A. Objective of the Search - Article 15(2) provides that the objective of the international search is to discover relevant prior art. Rule 33.1 defines relevant prior art as consisting 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.
1. Do the searches your Office presently performs attempt to discover prior art documents relevant to the criterion referred to above of
 - (a) novelty?
 - (b) inventive step?
 2. What, if any, additional criteria is your present search directed towards?

- B. Field of Search - Rule 33.2(b) and (d) requires that the international search shall cover not only the art in which the invention is classifiable but also analogous art, regardless of where classified, and equivalent subject matter.
1. What requirements presently determine the field of search for any given national application your Office searches?
 2. Does such a search extend to fields
 - (a) of analogous art to the extent that that art is regarded to be analogous in the light of what appears to be the necessary essential function or use of the invention and not only specific functions expressly indicated in the application?
 - (b) embracing all subject matter that is generally recognized as equivalent to the subject matter of the claimed invention for all or certain of its features?
- C. Orientation of the Search - Rule 33.3 provides that the search shall be made on the basis of the claims with due regard to the description and the drawings, if any, and with particular emphasis on the inventive concept toward which the claims are directed. Furthermore, in so far as possible and reasonable, the international search must cover the entire subject matter to which claims are directed or to which they might reasonably be expected to be directed after they have been amended.
1. What part or parts of the application presently form the basis of the search in your Office?
 2. If the basis of the search includes the claims, does it also extend to possible amendments of the claims?

III. Preparation of the Search Report

- A. Classification - Rule 43.3 provides that the international search report must contain a classification determined by the International Searching Authority of the subject matter of the international application at least according to the International Patent Classification (IPC).
1. Does your Office presently classify applications according to the IPC?
 2. If your Office presently classifies applications according to classification systems other than or in addition to the IPC, which classification system is (systems are) used?
- B. Citations - Rule 43.5 provides that the international search report shall contain citations of relevant and particularly relevant documents or parts thereof. Citations which are not relevant to all the claims shall be cited in relation to the claim or claims to which they are relevant.
1. Does your Office presently in citing documents in its search reports
 - (a) make a distinction between relevant documents and those documents which are considered of particular relevance?
 - (b) make references to particular parts of the documents?
 - (c) cite documents both in relation to all or particular claims?
 2. Does your Office automatically furnish, or does it provide on request, copies of the documents cited in the search report?
- C. Fields Searched - Rule 43.6(a) provides that the international search report shall list the classification identification of the fields searched. Rule 43.6(b) provides that, if the international search extended to documents of States, periods, or languages not included in the Rule 34 minimum

documentation, the international search report shall, when practicable, identify the kinds of documents, the States, the periods, and the languages to which it extended.

1. Does your Office presently indicate in its search reports the classification identification of the fields searched?
2. Does your Office maintain the following information for any given application searched:
 - (a) type of documents searched (patents, inventor's certificates, etc.)?
 - (b) country of origin of documents searched?
 - (c) range of years of documents searched?
 - (d) languages of documents searched?

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