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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)**

**TOKYO INTERNATIONAL MEETING  
Tokyo, May 25 to 29, 1981**

OBSERVATIONS CONCERNING INTERNATIONAL SEARCH AND  
INTERNATIONAL PRELIMINARY EXAMINATION

*Memorandum received from the Australian Patent Office*

The Annex to this document contains observations received by the International Bureau on April 14, 1981, from the Australian Patent Office concerning international search and international preliminary examination.

[Annex follows]

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PATENT, TRADEMARKS AND DESIGNS OFFICES

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ADDRES ALL CORRESPONDENCE TO THE COMMISSIONER OF PATENTS

IN REPLY PLEASE QUOTE: 81/0082

Your Ref: C. 142  
PCT 211

7 April, 1981

Dr. K. Pfanner,  
Deputy Director General,  
W.I.P.O.,  
34 chemin des Colombettes,  
1211 Geneva 20  
SWITZERLAND

Dear Dr. Pfanner,

Activities of International Searching  
Authorities (ISA) and International  
Preliminary Examining Authorities (IPEA).

In response to your request for a written memorandum  
by the Australian Patent Office as an ISA and IPEA, I am  
forwarding the following information in response to your  
queries.

ISA in respect of:  
Experience of the Australian Patent Office as an

(i) indication of citations of particular relevance  
and of certain special categories of documents cited  
(Administrative Instructions, sections 505 and 507).

In the view of the Australian Patent Office, there  
are two main factors contributing to lack of uniformity in  
international search reports.

The first concerns the determination of whether or  
not a document cited in the report should be categorised by  
the letter X as being "of particular relevance". The AU Office  
has interpreted "particular relevance" to mean that, in relation  
to the invention as claimed at filing (or even as it could be  
claimed), the document is potentially citable in an objection  
going to lack of novelty or inventive step. This does not  
necessarily mean that the document of itself must anticipate  
a claim as filed. Thus, in order to establish lack of novelty  
or inventive step it may be that the disclosures of an X category  
document have to be read in conjunction with the disclosures of  
another or other X document(s) cited in the report and/or  
combined with common general knowledge.

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The second concerns the determination whether or not  
it is useful to categorise a cited document by more than one  
of the category letters available e.g. PA, PX. From the point  
of view of the reader of the search report we believe that it  
is useful to know if, for instance, a P category document is  
being cited because it defines the general state of the art or  
would be citable in an objection going to lack of novelty or  
inventive step if the priority date claimed is not appropriate.

It is felt that the Administrative Instruction could  
be more definite as regards Category X and A definitions or  
alternatively Chapter X of PCT/INI/5 could elaborate upon the  
meaning of the definitions.

There does not appear to be consistency of interpretation  
amongst the ISAs. AU uses the X category over 4 times more  
frequently than the A category. Conversely, the EPO uses  
category A more frequently than category X.

A copy of instructions issued to examiners is  
attached (annex AU/ISA/5).

(ii) application of Article 17(2)(a) of the PCT.

To date, the experience of the Australian Patent  
Office in respect of Article 17(2)(a) is minimal, involving  
only one application containing claims to a diagnostic method.  
In this instance, the claims were in fact searched since we  
were in a position to carry out a meaningful search.

(iii) unity of invention required under Article 17(3)(a)  
of the PCT and its practical implications.

To date, lack of unity of invention has been raised  
against only 4% of the international applications searched by  
the Australian Patent Office and has only been taken in the  
clearest of cases. In all cases, additional search fees have  
been paid without objection.

A practical problem in relation to a notification of  
lack of unity of invention occurs where the additional search  
fee(s) are paid near the end of the prescribed time limit. In  
such circumstances, very little time may be available for the  
performance of the additional search(es) if the time limit for  
establishing the international search report is only 3 months  
from the date of establishment of the search copy file.

A specific instance of an international application  
considered to be borderline in relation to the question of  
lack of unity of invention is PCT/AU81/00017 currently being  
processed by AU as ISA. That application describes and claims  
a microbiological process for preparing steroids and seco-  
steroids with independent claims to seven steroid compounds  
per se, and three seco-steroid compounds per se. Since we  
are not sure how PCT Rule 13.2(1) is to be interpreted in this  
instance we are inclined to give the applicant the benefit of  
the doubt.

A copy of instructions issued to examiners is attached  
(AU/ISA/3).

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- (iv) extent and depth of search required under Article 15(4).

It is believed that AU international searches are both extensive and in-depth. All international searches are preceded by an AU document search from 1920 onwards and the minimum patent documentation is then searched via CAPRI and/or US Sub-class lists and/or C.B. Abridgements, and also via INFADOC. If it is considered probable that highly relevant art exists before 1920 this is searched in the US and/or GB documents. AU is unable to comprehensively cover the minimum documentation when English language abstracts are not available for JP or SU documents.

A comparison of the reports from all ISA's shows AU has on average more foreign citations (6.4) than other Searching Authorities (SE 3.0, JP 1.5, EPO 1.3 and US 0.6) and has, after Sweden, the smallest proportion (27%) of national citations (SE 25%, JP 74% and US 91%).

Non-patent literature is searched via Chemical Abstracts or Engineering Index, and also in some instances via computer data bases available on-line through Lockheed Dialog. Thus periodicals in excess of the minimum documentation are covered.

- (v) usefulness of international search reports in the national phase.

Examination under national law of international applications designating Australia has not yet commenced, although it is anticipated that the processing of the first such applications will commence within the next few weeks. Accordingly, it is not possible for this Office to comment authoritatively on the usefulness of international search reports in the national phase.

It is the intention of this Office, however, to rely heavily on international search reports in the national phase. Thus, in most instances, the international search report will not be supplemented by a search of priority documents in AU search files. Arrangements are currently being made for each of the other international searching authorities to have at its disposal sorted sets of published specifications of AU applications and patents in which no Convention priority is claimed. In accordance with rule 34.1(c)(vi), these documents will be required to form part of the minimum documentation of such searching authorities and it should then be unnecessary for non-priority AU documents to be searched during national phase examination.

- (vi) identification of patent documents cited in the international search report (Administrative Instructions, Section 503(A)).

Our experience as an ISA in preparing search reports indicates that the method is satisfactory for that purpose. As we have had virtually no experience in using search reports, we are unable to comment at this stage on the adequacy of the identification method from the user's point of view

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- (vii) usefulness of applying uniform procedures for several kinds of searches, e.g. international, regional, national, carried out by the Patent Office as an ISA.

The Australian Patent Office does not conduct regional searches. The nature of the systems used, and sizes of the data bases in respect of international and national searches, are so different that no uniform procedures are used. It should be mentioned that a national search is conducted as the first stage of an international search. As the extent of national searches is enlarged to encompass more of the PCT minimum documentation, the introduction of uniform procedures will be possible and, it is believed, most useful.

Experience of the Australian Patent Office as an IPEA concerning the present system and of the application of Article 33(1):

- (viii) international preliminary examination report: consideration of the adequacy of the present format and procedure, desirability of changes and for comments related to documents cited in the international search report.

The Australian Patent Office has negligible practical experience as an IPEA. To date, only three demands for international preliminary examination have been submitted, none of which has progressed to the stage of an international preliminary examination report. Further, as examination has not yet been begun on any PCT route application that designated AU, this Office has no experience with IPEA reports in the national phase.

Experience indicates that the classification of citations is a subjective matter and cannot be attributed with any meaning in evaluating an international search report. Comments with an international search report would give some indication of the searcher's intentions in raising the citations. Comments might also go some way in enabling applicants to understand their position in relation to the citations on an international search report, negate the need for a demand for international preliminary examination in those cases where an applicant wishes to know his position in relation to the citations, and give applicants assistance in considering what Article 19 amendments might be made before the IPEA or national Offices.

- (ix) communication with the applicant and amendments before the IPEA and usefulness of international preliminary examination reports for the national phase.

In view of the lack of experience, no comment is possible at this stage.

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As regards the further matters upon which comment is invited:

- (x) Should Rule 69.1(a) be amended to permit the time limit for the establishment of the international preliminary examination report to be extended to expire one year after the start of international preliminary examination where a request for such extension is made by the applicant?

The value of an extension of the present time limit to an applicant is dependent upon whether national examination in elected countries can be deferred beyond the period provided in Article 40. In the absence of a uniform approach to this question by countries party to Chapter II of the Treaty, the value of such extension must be limited. However, see also the comments under item (xi).

- (xi) Is it desirable to provide for the possibility of extending the period for a reply by the applicant to a written opinion from an IPEA under Rule 66.2(d)?

Extension of the time limit for replying to an international preliminary examination report is intimately related to the preceding question. Clearly, any time limits imposed should recognise the times required, in practice, for communication between applicants and IPEAs, particularly where an Office acts as an IPEA for applicants from a number of countries. In this regard, the present time limits in Rule 66.2(d) are believed to be too short. Accordingly, provision for either an increase in, or an extension of, the present period is considered to warrant consideration to obtain the views of all member countries.

- (xii) Can the form of international preliminary examination reports be improved so that the usefulness of the report may be increased and whether, in particular, the requirement under Rule 70.6 of answering YES or NO in all cases should not be modified to accommodate cases where a claim may be patentable but only in an amended form?

We agree that an amendment to Rule 70.6 permitting explanation in circumstances where a claim may be patentable if suitably amended is desirable and would result in the usefulness of the report being increased.

Moreover, so far as consideration of Art. 19 amendments by an IPEA is concerned, Rule 70.2(c) is quite explicit in requiring consideration of the claims as lodged where Art. 19 amendments go beyond the scope of the disclosure. However, should the new matter be of a minor nature or occur in a subsidiary claim, it may be inappropriate to consider the claims as lodged if they lack novelty or inventive step. Accordingly, when an amendment involves a set of new claims, it might be appropriate to report on those claims which do not add new matter.

6.

- (xiii) Should measures be adopted to avoid the examination of a particular question prolonging the international procedure unduly beyond the 25th month thus reducing the chances for the report to be taken into account in the national phase?

It is not entirely clear how avoidance of a particular question will increase the chances of an international preliminary examination report being taken into account by an elected country in view of the time limits presently prescribed for the establishment of a report. Nor is it clear what circumstances should be taken into account in determining whether an issue should be so avoided. However, it may be appropriate for a report to be established in all cases on the expiry of a particular period (e.g. the period prescribed in Article 40) without prejudice to the subsequent establishment of a further report at a later date. However, in the absence of an appreciation of the circumstances upon which this query is based, the proposal above is merely speculative.

Yours sincerely,

(C.H. FRIEMANN)  
Deputy Commissioner of Patents

AU/ISA/3

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6. Lack of a general inventive concept may become apparent during the search in which case it is important to have commenced the search as quickly as possible so that the applicant may be informed immediately and invited to pay the additional fees.

The time limitation, i.e. the Search Report must be established within 3 months from the receipt of the search copy or nine months from the priority date, whichever time limit expires later, applies equally to any additional searches to be made under Article 17(3)(a).

AU/ISA/3

UNITY OF INVENTION

References:

- (i) PCT/Int/5, Chapter VII
- (ii) PCT Rule 13
- (iii) PCT Article 17(3)
- (iv) International Searching Procedures within the Australian Patent Office, Chapter III
- (v) Form PCT/ISA/206

1. Examiners are required to determine whether the application complies with the requirements of Rule 13.1, i.e. it relates to one invention only or to a group of inventions so linked as to form a single general inventive concept.

2. Lack of unity of invention is not to be raised merely because the claims do not contain a novel unifying feature, e.g. as a result of the number in which the claims have been drafted, nor raised because more than one abstract set is involved in the search. The overriding requirement is that a single general inventive concept be defined in the claims.

3. The communication to the applicant is an invitation to pay additional fees, thus it is evident that the allegation of lack of unity of invention must be based on sound grounds.

4. If it is considered that there is lack of unity of invention, the examiner will inform his Supervising Examiner, who will then consult with the PSE. Upon agreement that Rule 13.1 has not been complied with, the examiner will complete Form PCT/ISA/206 and the procedure outlined in Chapter III of Reference (iv) will be followed.

5. Where it is agreed that Rule 13.1 has not been complied with, the examiner will request an abstract set for each of the inventions claimed and those sets will be prepared.

He will initially search only the invention first mentioned in the claims (i.e. the main invention) however, if the search for the additional inventions would require little extra effort then that search may be combined with the main search despite the non-payment of additional fees.

The remaining abstract set(s) will only be searched when the applicant pays the additional fees.

April, 1980.

AU/ISA/5

SPECIAL CATEGORY OF DOCUMENTS CITED

Documents which are cited in an International Search Report are given an alphabetical category. The categories are X, O, E, A, P, T and L and are defined in Sections 505 and 507 of the Administrative Instructions (PCT/INT/2) as well as in the notes to the Search Report form itself.

The most frequently occurring category will be X which covers those documents "of particular relevance". This category covers all documents which establish lack of novelty (i.e. prior publication in Australian terms) and also all documents which may comprise a mosaic for purposes of inventive step (obviousness) consideration.

Category A covers those documents "which define the general state of the art" and will be used for those documents which establish common general knowledge or which describe the state of the art against the background of which the question of inventive step is to be determined.

It is possible that a particular document may have more than one category specified in the report. For instance a citation may be an anticipation and so be indicated as X, and also in its introductory portion contain a good description of the developments in the appropriate field up to that time, and so also be indicated as A.

A category should always be indicated for each document cited.

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