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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 Patent and Trademark Office
of the United States of America*

The Annex to this document contains observations received by the International Bureau on May 25, 1981, from the Patent and Trademark Office of the United States of America concerning international search and international preliminary examination.

[Annex follows]

The United States Patent and Trademark Office has the following comments on agenda items.

Agenda items I (i) – Experience of the United States Patent and Trademark Office (USPTO) concerning:

(a) The indication of citations of particular relevance and of certain special categories of documents cited.

It should initially be indicated that the USPTO does not consider the citation of the categories to be of major importance to it as a designated Office. If the relevant documents are cited the examiner can readily determine its usefulness during patentability examination. The appropriate category indication is more useful to the applicant in determining whether to continue and for statistical studies to indicate uniformity.

The initial USPTO position and instructions to the examiners were to use category “X” for all documents which would normally be used in rejecting the claims. Category “A” was used for “state of the art” citations. Since the Administrative Instructions did not mention the use of no category, substantially all prior art documents contained at least one letter designation.

Subsequently, the USPTO was informed by a visiting European Patent Office (EPO) that the USPTO use of categories was not in agreement with the EPO position. In view of the information received from the EPO, the instructions to the USPTO examiners were modified to conform to the EPO practice to the extent that the EPO practice was understood. At the present time different examiners are using different criteria. Some examiners are using the initial instructions and some are using the modified instructions. The amendments proposed by the EPO as to the category definitions is acceptable and the additional detail of the definitions should be useful in promoting increased uniformity.

One situation we have experienced which is not covered is where a prior art document is an “X” document for certain claims and an “A” document for others. Our current practice has been to only use the “X” citation. This practice does not, however, reflect the examiner’s true position with respect to the references.

(b) Experience with the application of Article 17(2)(a). Only one international search report has had a question as to searchability under Article 17(2)(a) raised therein. The holding under Article 17(2) (a) was not made since other examiners did not agree with the conclusion. Some claims have been held to be unsearchable because the claims were not proper multiple dependent claims. We discourage the use of Article 17(2)(a) in such a situation but do permit its use where the examiner feels that the combinations to be searched are not understandable.

(c) Unity of invention under Article 17(3)(a). From a recent sampling of 670 search reports, lack of unity of invention was held in 42 international applications, or 6.2%. The USPTO is basically interpreting Article 17(3)(a) in the same manner as the national restriction practice. The guidelines are set forth in sections 1.141-1.146 of the Rules of Practice in Patent Cases and in Chapter 800 of the Manual of Patent Examining Procedure. Such interpretation is consistent with the broad wording of PCT Rule 13. The practice relating to unity of invention has not caused any major problems to the USPTO as an ISA or DO. Although section 372(c) of the U.S. patent law does provide for charging the special fee provided for in PCT Article 17(3)(b), no such fee has been required to date. The USPTO position is that the current unity of invention practice is working satisfactory and no changes are necessary at this time.

(d) Extent and depth of search required under Article 15(4).

The question as to adequacy of search relates to many factors such as the classification system used, the skill of the searcher, the completeness of the search file (are copies missing?). The completeness of the search is of serious concern to the USPTO. The major problem in this area is to determine why a pertinent prior art document located later was not cited in the search report. It is recognized that different searchers may honestly come to different conclusions. Possibly some exchange of information between patent offices in this regard may be beneficial. This topic is closely related to the next agenda item.

(ii) The usefulness of international search reports in the national phase. In the USPTO, the major problem has been obtaining copies of the cited documents for the examiner with a minimum of effort. The USPTO has not made any detailed studies at this time as to the savings resulting from international search reports.

(iii) Experience in applying uniform procedure for several kinds of searches. All searches made by the USPTO are uniform. The U.S. patent rule 1.104(c) indicates that an international-type search will be made in all national applications filed on and after June 1, 1978.

Agenda item 2 – The international preliminary examination.

We have no comments to make relative to Agenda item 2.