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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

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TECHNICAL AND PROCEDURAL MATTERS RELATED TO THE PUBLICATION OF THE INTERNATIONAL SEARCH REPORT

Memorandum prepared by the International Bureau

Introduction

1. This document is concerned with technical and procedural matters related to the publication by the International Bureau of the international search report. Its purpose is to recall to the International Searching Authorities certain requirements which have to be observed when preparing the international search report and to consider possible measures to facilitate the publication of such reports with a view to rendering the procedure more economical and to reduce the volume of the pamphlet.

The international search report form: adequacy of the present format, possible improvements thereof

2. The international search report must be in the language in which the international application to which it relates is published (Rule 43.4). International search reports must, when not in English, be translated into English (Rule 45.1). The translation into English is to be prepared under the responsibility of the International Bureau (Rule 48.3(2), last sentence). The international search report must be published in the language of publication of the international application and if such language is not English, a translation into English must also be published (Rule 48.3(c)).

3. Up to the present time the language of publication of international applications has been English in about two-thirds of the cases. This means that almost every third international search report requires a translation into English by the International Bureau and a double publication of the international search report (i.e., in the language of publication and in English).

4. Although the preparation of the translated version of a search report does not involve, *per se*, much work or great difficulties, with the increasing number of search reports, it becomes burdensome.

5. Double publication of the international search report has a number of adverse consequences, such as, higher printing costs, an increased volume of the pamphlet, higher mailing costs and a need for more storage space. The latter point may also be of concern to the International Searching and Examining Authorities as well as for all other Offices maintaining patent documentation.

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6. With the increasing number of international applications, it is proposed to reconsider the present practice and to seek solutions for the problems resulting from the translation and double publication of the international search report.

7. The International Bureau is prepared to undertake, in close cooperation and consultation with the International Searching Authorities, a study with a view to finding a solution for the problems referred to under paragraphs 4 and 5, above, in particular to reduce translation work in the cases in which the international search report has to be published twice (in the language of the international publication and in the English translation).

8. A possible solution could be that, in all cases where the publication of the international application will not be effected in English, a bilingual version of the international search report form (Form PCT/ISA/210) would be used, i.e., in English and in the language of publication. As far as the text of the international search report is concerned, a significant part of it (e.g., document numbers, classification symbols) does not require translation (but does have to be retyped in the English version of the form). As far as the other part of the text matter is concerned, which requires translation or transliteration, it could be considered to amend Section 503 of the Administrative Instructions by prescribing the use of certain codes or symbols for text matter inserted when completing the international search report (e.g., codes or symbols for the words "page," "column," "line," etc.). Names of Offices which issued the document have already to be identified by the two-letter code (see Administrative Instructions, Section 503(a)(i)). Names of authors, titles of publications, names of publishers, etc., could, however, not be replaced by codes or symbols. In such a case, the only feasible solution would seem to be the indication of such names and titles in both the language of publication and in English or their transliteration into Latin characters.

9. International search reports established in the way outlined above would not require any translation. They could be reproduced for publication purposes as they are and thus lead to considerable savings for the International Bureau and reduce the volume of the pamphlet.

10. The International Searching Authorities are invited to express their views whether the suggestions made above are acceptable to them and, if so, to make proposals in particular for an amendment of Section 503 of the Administrative Instructions.

Observance of the time limit for the international search report

11. International search reports or the declaration referred to in Article 17(2)(a) are required to be established within a time limit which shall not exceed 3 months from the receipt of the search copy by the International Searching Authority, or 9 months from the priority date, whichever time limit expires later (Rule 42.1).

12. The purpose of these time limits is to allow the applicant to either withdraw his international application or some designations before the expiration of the time limit for the payment of the designation fee or before the international publication, whichever case applies, and to allow the filing of amendments of the claims under Article 19(1) early enough to permit publication of the international application with amended claims.

13. A timely establishment of the international search report is also of great importance for the International Bureau. Having regard to the requirement (under Rule 48.2) to publish the international search report and any amendments under Article 19(1), if available, together with the international application, both should be received in due time before publication. The International Bureau has, in the greatest majority of cases, been able, so far, to publish, in particular, the international search report together with the international application. However, in a number of cases, such publication has only been possible due to special processing (involving additional costs) of cases where the international search report was late. With an increasing number of international publications, and in view of the future computerization, it will be more and more difficult to apply such special processing.

14. Furthermore, the publication of international applications in the PCT Gazette appears in classified order. Only once the international applications to be published at a given date have been sorted according to the International Patent Classification (IPC), can a publication number be allotted to the international application. This has the great advantage of synchronizing both the classified and the numerical order. The classification of an international application, however, is only known once the international search report has been received. International applications for which such report is not available at the time of publication can therefore not be published with the international patent classification symbol pertaining thereto and do not fit in the sequence of international publications published in Section I of the Gazette. It is, of course, also not desirable for the users of the Gazette and the pamphlet, if the application is published without classification according to the IPC.

15. As far as amendments (under Article 19(1)) are concerned, late receipt by the International Bureau of international search reports from the International Searching Authorities results, in a rather high number of cases, in the publication of a pamphlet with the indication "Published before the expiration of the time limit for amending the claims and to be republished in the event of amendments." Any amendment received after termination of technical preparations for publication must then be published separately, which involves additional expense for the International Bureau and inconvenience for the user of the pamphlet.

16. The sequence of time limits provided in the PCT should ensure that in most cases the applicant will have filed any amendments in time for the amendments to be published together with the international application. For example, even in a case where the international application is filed at the end of the priority year, the following time sequence could be envisaged even where the full period for establishing the search report and amending the claims would be utilized.

<u>Event</u>	<u>Time (measured from priority date) when event occurs</u>
1. Search copy sent to ISA	end of 13th month
2. Search report established by ISA (time limit 3 months from 1)	end of 16th month
3. Amendments filed (time limit 2 months from 2)	end of 18th month

17. The experience of the International Bureau is that most receiving Offices take no more than 2-3 weeks (usually less) after the filing of the international application to send the record copy to the International Bureau. Since the search copy is sent to the International Searching Authority simultaneously with the sending of the record copy to the International Bureau and, moreover, since applicants rarely take the full period allowed for the filing of claims, it should only be the exceptional case where publication of amendments to the claims with the international applications is not achieved.

18. Inability to publish the amended claims with the international application will always be due to the occurrence of either or both of the following

(1) late sending by the receiving Office of the search copy to the International Searching Authority;

(2) exceeding, by the International Authority, of the specified time for the establishment of the international search report.

19. It is desirable that the International Searching Authorities

(1) inform the International Bureau of cases where the search copy is received consistently at a time which does not allow a desirable time sequence, leading to publication of amendments to the claims together with the international application, to be followed,

(2) continue efforts to establish international search reports in the shortest time possible and, in any event, within the prescribed time limit.

Publication of abstracts established by the International Searching Authority

20. The International Bureau is often faced with cases where the definitive text of the abstract has not been established and the period of one month allowed to the applicant pursuant to Rule 38.2 to comment on the abstract established by the International Searching Authority (because the abstract provided by the applicant does not comply with Rule 8) has not expired when the technical preparations for publication are completed. This situation would not, of course, occur if the time frames set out in paragraph 17 above were observed.

21. The PCT Regulations do not provide what shall be published in the case where the time limit fixed by the International Searching Authority for comments on the abstract expires after technical preparation for publication and the definitive text of the abstract has not been established. The practice followed by the International Bureau is to publish the abstract as established by the International Searching Authority (this abstract is invariably sent to the International Bureau together with the international search report even where that report indicates that the time limit for comments has not expired). No indication is given that the abstract is that established by the International Searching Authority and that the time limit for comment by the applicant pursuant to Rule 38.2 has not expired and it is not proposed to institute the practice of giving such an indication since this would involve an undue amount of work in calculating the time limits for comment under Rule 38.2 where that time limit applies. In practice, abstracts established by the International Searching Authority are rarely, if ever, changed. Should a case arise in which the abstract is changed, the International Bureau will republish the front page of the pamphlet and publish the revised abstract in Section II of the PCT Gazette.

22. A related problem for the International Bureau involving it in a good deal of work occurs with regard to the form (form PCT/ISA/205) used by the International Searching Authority to notify the International Bureau as to the definitive content of the abstract, after the time limit for comments under Rule 38.2 has expired. The usual practice is to attach the definitive text to the form. The International Bureau then has to compare this text with that previously established by the International Searching Authority and set out in, or attached to, the international search report. Since, as already noted, there is rarely, if ever, a change in the version established by the International Searching Authority the checking of the two texts is almost entirely wasted effort. It is proposed to revise form PCT/ISA/205 to include a check box enabling the International Searching Authority to indicate that the definitive text is that previously established by the International Searching Authority. A copy of the revised form is annexed to this document.

23. The International Searching Authorities are invited to indicate whether the revised form is acceptable to them.

Indication of international patent classification symbols

24. The international search report shall contain the classification of the subject matter according to the International Patent Classification (IPC) (Rule 43.3). Such classification is used for international publication (see paragraph 14, above). All International Searching Authorities apply the International Patent Classification in conformity with the said Rule but in preparing the pamphlet and the Gazette the International Bureau has, in a number of cases, found that the IPC symbols referred to in the international search report were wrong, defective, or incomplete.

25. The International Bureau has received international search reports where an element of the classification was missing (e.g., indication without Section: 47 C 1/10; indication without subclass: A 47 1/10). In other cases, the prescribed indication of the edition of the IPC was missing. In some international search reports, where complete IPC symbols were given, such classification symbols did not exist in the IPC.

26. Defects of the kind referred to in the preceding paragraph, if discovered, can, in most cases, not be corrected by the International Bureau without consultation with the competent International Searching Authority. Their correction increases publication work and may result in a delay of the publication of the international application.

27. Where an international search report refers to several classifications, various manners of indicating the symbols are used. The following example is given for illustration:

- (a) A 47 C 1/10
A 47 C 1/12
- (b) A 47 C 1/10, 1/12
- (c) A 47 C 1/10, 12

The examples given under (a) and (b), above, are clear and can both be used. The manner of indication under (c), above, however, does not permit a clear identification (the relevant group may have erroneously--by a typing mistake--been omitted). It is therefore desirable that only the manners of indication given in the examples (a) and (b), above, be used.

28. The International Searching Authorities are requested to take measures to assure a clear, complete and correct indication of IPC classification symbols in the international search report.

Drafting of abstracts

29. The International Bureau encountered difficulties in publishing abstracts the length of which exceeded the recommended maximum number of words. According to Rule 8.1(b) and Section 5 of the Guidelines for the Preparation of Abstracts of International Applications Under the Patent Cooperation Treaty, the abstract should preferably be in the range of 50 to 150 words; while a greater number of words is not excluded, this number should not exceed 250.

30. Abstracts which are too long cannot be included in toto on the front page of the pamphlet or in one entry in the Gazette, in particular where drawings and a translation of the abstract are to be published at the same time.

31. Section 5 of the said Guidelines for the Preparation of Abstracts prescribes also that phrases should not be used which can be implied, such as, "This disclosure concerns," "The invention defined by this disclosure" and "This invention relates to." More than one out of five abstracts received with the international search report, however, uses such implied phrases.

32. Where the international application contains drawings, the abstract shall, on publication, be accompanied by one or more figures of the drawings. The abstract should be drafted with this requirement in mind (see Section 5 of the said Guidelines for the Preparation of Abstracts). The International Bureau has received international search reports where, for example, 3, 4 or even more drawings have been specified for publication or where it was simply stated "figures 1 to 6." More than one or two drawings or figures, however, can hardly be included in one entry of the Gazette and on the front page of the pamphlet. In such cases it was necessary to publish in the Gazette several entries for the same international application and to continue the front page on the back side thereof.

33. When specifying drawings or figures to accompany the abstract on publication, due regard should, furthermore, be given to the inclusion of numerals which correspond to the selected figure or drawing. The International Bureau has received several complaints that the abstracts were not comprehensible due to the fact that they contained numerals which did not correspond to the numerals shown in the figure or drawing. A similar problem arises where the drawing contains text matter which does not correspond to the abstract. Abstractors should give due consideration to the matter outlined above to increase the quality of the abstract.

Translation of abstracts into English by the International Bureau

34. Where the language of the international publication is not English and a translation has to be prepared and published by the International Bureau, any text matter included in figures or drawings creates difficulties on publication. For technical reasons it is practically impossible, or requires an unjustified (and costly) effort to present on publication text matter or drawings in English translation as well as in the language of publication. The selection of figures or drawings containing text matter should therefore be avoided whenever possible.

35. The International Bureau draws the attention of the International Searching Authorities to the problems related to the drafting and translation of abstracts outlined in paragraphs 29 to 34, above, and invites their cooperation to facilitate the publication of abstracts and for the improvement of their quality.

[Annex follows]

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ANNEX

PATENT COOPERATION TREATY

TO

FROM the INTERNATIONAL SEARCHING AUTHORITY
Identified at the bottom of this page

NOTIFICATION OF ABSTRACT
APPROVED OR ESTABLISHED
issued pursuant to PCT Rule 44.2(c)⁽²⁾

Inscribe NAME and ADDRESS of the AGENT and if there is no agent, of the APPLICANT (1)	DATE OF MAILING by the International Searching Authority
	APPLICANT'S OR AGENT'S FILE REFERENCE (1)

IDENTIFICATION OF THE INTERNATIONAL APPLICATION	
International Application No.	International Filing Date
Applicant (Name)	

NOTIFICATION

The applicant is hereby notified that the time limit allowed for comments on the abstract established by this International Searching Authority for the above-identified international application has expired. This International Searching Authority:⁽²⁾

1. has received comments from the applicant and has considered such comments.
2. has not received any comments from the applicant within the said time limit.

The definitive contents of the abstract⁽³⁾:

- a. are as established by the International Searching Authority (without change).
- b. are changed in view of the comments to read as annexed.

A copy of this notification and any attachment has been sent to the International Bureau⁽²⁾

THE INTERNATIONAL SEARCHING AUTHORITY	
Name and Mailing Address	Authorized Officer