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**INTERNATIONAL PATENT COOPERATION UNION  
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OBSERVATIONS CONCERNING INTERNATIONAL SEARCH AND  
INTERNATIONAL PRELIMINARY EXAMINATION

*Memorandum received from the USSR State Committee for Inventions and Discoveries*

The Annex to this document contains observations received by the International Bureau on May 5, 1981, from the USSR State Committee for Inventions and Discoveries concerning international search and international preliminary examination.

[Annex follows]

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[Translation by WIPO]

EXPERIENCE OF THE USSR STATE COMMITTEE FOR INVENTIONS AND  
DISCOVERIES AS INTERNATIONAL SEARCHING AUTHORITY AND  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

I. Experience of Combining the PCT System with Other Regional and National Systems

I.1 Problem of Similar Procedures When Applied to Different Kinds of Searches and Examination

One of the important advantages offered by the PCT system in the field of technical cooperation lies in allowing all the interested national Offices to benefit by the results of international search and international preliminary examination carried out by the specialized International Searching Authorities and International Preliminary Examining Authorities, thus, reducing the necessity to carry out the said laborious procedures to a single-time minimum.

The PCT has established a new legal system providing for certain legal consequences (for example, delaying of national procedure, etc.), merits of technical cooperation within the said system manifest themselves in a form of certain prescribed advantages to the applicant and national Offices.

Nevertheless, one doesn't fail to perceive that the results of technical cooperation manifested in an international search report, or an international preliminary examination report can be also used outside the legal limits of the PCT (certainly, entailing no legal consequences provided for in the PCT, or entailing those of a different kind), consequently, from this context one can conclude that PCT technical system is somewhat wider than its legal system. Thus, a possibility arises to use the experience accumulated within the PCT system and transfer its technical procedures into other legal systems, both national and regional. This trend is characteristic of the PCT in general: it is to be reminded that such important projects as INPADOC and CAPRI originated in the process of technical preparation for the entry into force of the Treaty.

The PCT directly provides for a possibility of carrying out the international-type search and specifies that it is a search similar to an international search (see Article 15(5) (a)), at the same time the Treaty does not provide for any legal consequences of the carrying out the search other than a possibility of refund of the search fee for the subsequent international search. Experience proved that the national Offices or intergovernmental organizations - functioning as International Searching Authorities - have carried out searches of the most various legal status which do not fall under the definition of "international-type search", but which, at the same time, are at least so close to international search that their results may be used while carrying out the subsequent international search. This circumstance was legally enforced in June 1980 when the PCT Rules 4.11 and 41 were amended.

Since the legal systems in a natural way affect the respective technical procedures servicing them, a task of ensuring flexibility of the basic elements of such procedures arises accordingly. This task is essentially topical for those Patent Offices simultaneously performing both the functions of International Searching Authorities, as well as those of International Preliminary Examining Authorities under the PCT, and similar functions in respect of other national and regional systems.

In view of the above the State Committee would consider it expedient to discuss experience of International Searching Authorities and International Preliminary Examining Authorities in carrying out searches and examination procedures similar to those provided for in the PCT but having a different legal status, in particular the experience of those International Searching Authorities which, while carrying out international searches, use the results of searches, being neither international searches nor international-type searches under the PCT Rule 41.1.

## I.2 Experience of the State Committee with Application of Similar Procedures to Different Kinds of Searches and Examination

The USSR State Committee for Inventions and Discoveries, being an International Searching Authority and International Preliminary Examining Authority, simultaneously performs similar functions in the framework of bilateral Agreements concluded with a number of the Offices for Inventions of the CMEA countries on the basis of "Model Bilateral Agreement on Patent Retrieval and Examination of Applications Within the Framework of Scientific and Technical Cooperation" approved by the Conference of the Heads of the Offices for Inventions of the CMEA Countries at its 12th session.

The said Agreements provide that the State Committee, at the request of the interested Office for Inventions, carries out either patent searches or patent searches and examination of applications for invention.

While elaborating a draft Model Agreement and preparing the respective bilateral agreements the emphasis was laid on a possibility to bring the technical procedures under the said Agreements into line with technical procedures under the PCT. Thus, the definitions of the most essential notions, - that is, subject matter of applications not required to be searched, orientation of the search and approach to the notion of "state of the art" - are similar to those contained in the PCT. Requirements relating to such documents as search report, preliminary examination report and notification of the applicant to the effect that no search report and preliminary examination report will be established, correspond to the PCT requirements relating to international search report (PCT Rule 43), international preliminary examination report (PCT Rule 70) and declaration (PCT Article 17(2)(a)), respectively. The procedure in the case of lack of unity of invention is similar to that under the PCT.

The criteria used for the purposes of the preliminary examination under the Agreement, namely, novelty, an inventive step (non-obviousness) and industrial applicability - are fully identical to those used for the purposes of the international preliminary examination under the PCT. The importance of the fact becomes evident when considering the variety of differing criteria used in the countries whose Offices for Inventions have entered into the said Agreements. Therefore, the use of uniform criteria ensures an easier adaptation of the users, if they so desire, to the PCT system, while eventually facilitating the harmonization of various interpretations of criteria of patentability despite the existing differences in their denominations.

The specific purposes of the said Agreements have brought about certain distinctions as compared with the PCT. Thus, the scope of search, though based on the PCT Minimum Documentation, out of practical considerations was limited to a period beginning from 1950. The same reason, as well as certain specific uses of the results of preliminary examination (by the Offices for Inventions having a considerable experience in the field and reserving the right to take any actions entailing legal consequences, inclusive of any recommendations intended to amend the claims and the application itself), have led to a situation where preliminary examination might be demanded only simultaneously with the demand for carrying out the search (that is, either search or search and examination are demanded) and no contact with the applicant during the examination phase is stipulated, that means that the "preliminary examination report", established to order, in some cases may be compared with "the first written opinion of the International Preliminary Examining Authority" under the PCT.

There are some other distinctions. For example, while the PCT provides that any Contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law (PCT Articles 27(5) and 35(5)), the Agreements under consideration by means of special articles provide for independence of decisions taken by any Office for Inventions, which made the order, in respect of application being the subject of the order. The notification of the corresponding status of the preliminary examination report is reproduced directly on the report form.

The participation of the State Committee in the implementation of WIPO program for providing assistance to developing countries also manifests itself in carrying out searches and examining the applications for inventions.

Pursuant to the Agreement between the State Committee and the International Bureau relating to the carrying out the functions of the International Searching Authority and International Preliminary Examining Authority under the PCT, adopted by the PCT Assembly, - Article 13 thereof provides for special understandings intended to facilitate the program of technical assistance - in February, 1980 the Agreement between the USSR State Committee for Inventions and Discoveries and the International Bureau of the World Intellectual Property Organization for the procedure and conditions for carrying out patent searches and examining patent applications from developing countries was concluded. The elaboration of the said Agreement utilized the experience made in executing the orders for carrying out searches and examination under the above bilateral Agreements. Thus, the identity of searches and examination procedures carried out under the various Agreements was ensured, as well as a possibility to use their results while examining the international applications under the PCT.

Taking into account the above measures ensuring, while carrying out the international search, the use of the results of the search carried out to order, and pursuant to PCT Rule 41.1 the State Committee has notified the International Bureau to the effect that the refund of the search fee paid in respect of an international application will be made by the State Committee where an earlier search was made under:

- (a) a bilateral Agreement between the USSR State Committee for Inventions and Discoveries and the national Office for Inventions of a State which is a member of the Council for Mutual Economic Assistance for patent Retrieval and examination of applications, or
- (b) the Agreement between the USSR State Committee and the International Bureau of WIPO relating to the carrying out of patent search and examination by the State Committee for the benefit of developing countries.

The same conditions are fixed for making refund of the search fee as those provided for the refund in the case of full or partial use of the earlier international search or international-type search, however the amounts of the refund in the cases of full or partial use of the search under items (i) and (ii), above, constitute half the amounts of the refund in respect of the earlier international search or international-type search, since the former are carried out in a lesser depth of the search file which approximately, corresponds to one half of the cost of the international search.

Great importance is attached by the State Committee to the elaboration by the examiners of a uniform approach and the use of identical procedures while carrying out the above several types of searches and examination, and especially considering the fact that certain conditions under which they are carried out, as well as methods of expressing their results are somewhat different from those employed in the national examination procedure.

To facilitate the solution of this problem it was decided to introduce a common use of "Guidelines for International Search to be carried out under the PCT" and "Guidelines for International Preliminary Examination to be carried out under the PCT". The results of the search and examination are reflected by the examiners in the uniform printed forms, irrespective of the fact which particular search and examination is carried out. It is to be noted that the retyping of the search report and preliminary examination report into respective forms is effected by the staff of technical subdivision without the examiner being involved. Methodological expertise and advice are provided to examiners by a special staff having a vast experience in the field. Almost all members of the special staff participated in the preparatory work in connection with the PCT.

Generally, the most experienced examiners of the All-Union Scientific Institute of State Patent Examination, having accomplished a special training (linguistic, legal and that in the field of information), are entrusted to carry out the above types of searches and examination. In the course of training every examiner carries out a number of trial international searches and international preliminary examining procedures in respect of several applications. The staff of examiners (about 300) ensures a competent and practically overall coverage of classification units.

A uniform methodological and organizational approach to the carrying out of the said types of searches and examination assists to widen the experience gained by examiners in the course of training. Thus, if a total of 129 searches (including 44 international searches in respect of applications filed under the PCT) and 82 examinations were carried out in 1979; the respective figures in 1980 were 529 (including 195 international searches in respect of applications filed under the PCT) and 330; in accordance with estimate the respective figures in 1981 will be 700 and 400.

It is to be noted that the described organization of work not only harmonizes the procedures and methodological approach in respect of the discussed types of search and examination, but, in the opinion of the State Committee, also facilitates mutual improvement of the said procedures and approach. For instance, in the course of carrying out the search and examination to orders (under the bilateral Agreements) it was discovered that the establishment of a more precise definition of citations of particular relevance (category X) is greatly assisted by simultaneous preparation of the preliminary examination report. That is why at the first stage of carrying out the international searches under the PCT examiners were advised to reflect in their internal reports a possible correlation between a citation of particular relevance and a certain criterium, i.e. examiners were advised to simultaneously carry out the international search and the first stage of the international preliminary examination. Thus, each of the systems benefits by the experience of the other.

## II. The International Search

### II.1 Experience Concerning the Present System. Possible Measures for Harmonizing International Searches and International Search Reports

#### (a) Indication of Citations of Particular Relevance and Certain Special Categories of Documents Cited in the International Search Reports - Administrative Instructions, Sections 505 and 507

So far the experience of the examiners of the State Committee has revealed no problem in indicating certain special categories of documents cited in the international search reports in accordance with Section 507 of the Administrative Instructions. Though, it is worth mentioning that references to the kind of documents in the search reports are somewhat rare, future experience may, probably, reveal certain problems in this respect.

As to indication of citations of particular relevance in accordance with Section 505 of the Administrative Instructions, already the first stage of carrying out the searches has revealed various interpretations of the concept of "particular relevance" in the definition of category X. In order to harmonize the interpretations examiners were advised to assign the "particular relevance" denomination to those documents having a closer relevance to the object of search, containing certain features (or at least a feature) similar to those contained in the distinguishing part of the corresponding claim, as well as documents allowing to make a judgement as to lack of novelty or inventive step, or else, may cause the amendment of the applicant's claims.

It would seem expedient to discuss possibilities of elaborating a uniform definition of "citation of particular relevance", acceptable to all the interested International Searching Authorities and International Preliminary Examining Authorities, so that it could be subsequently incorporated either into Administrative Instructions or "Guidelines for International Search to be carried out under the PCT". It is to be noted that the elaboration of a uniform approach as to the matter in question is urgently necessitated by the fact that certain national legislations, in case of citations of particular relevance appearing in the international search report, provide for certain legal consequences in respect of the applicant (for instance, obligation to submit the translation of the citations).

#### (b) Experience with Practical Application of Article 17(2) (a) of the PCT, in particular, in respect of requirements to the carrying out of a valuable search

Article 17(2) (a) so far has never been applied in practice. Similar provisions of the bilateral Agreements have been applied only twice: in one instance - the drawing was missing and technical description was incomplete (it mainly contained references to the drawing); in the other - it was difficult to understand the technical description, since the terminology used was somewhat obscure.

(c) The Requirement of Unity of Invention under Article 17(3)(a) of the PCT and practical application thereof

Article 17(3) (a) has so far been of no practical impact in the experience of the State Committee. This applies both to the international applications filed under the PCT and those filed under the bilateral Agreements.

(d) Extent and Depth of Search required under Article 15(4)

As stated above, the State Committee performs varying in-depth searches-those covering the PCT Minimum Documentation beginning from 1920 in the case of the international searches and international-type searches, and those covering the PCT Minimum Documentation beginning from 1950 in the case of searches, carried out to order, under the bilateral Agreements with the interested Offices for Inventions of CMEA member-countries, as well as the searches carried out under the Agreement with the International Bureau of WIPO.

As to the coverage of classification units in the course of carrying out the searches, - examiners are advised to generally cover the analogous fields of technology as provided for in PCT Rule 32.2. As a rule, the search is deemed incomprehensive if it has been limited to the classification units appearing in the classification symbols assigned to the application.

(e) Experience of Identifying Patent Documents Cited in the Search Report - Administrative Instructions, Section 503(a)

The examiners of the State Committee while executing the orders under the bilateral Agreements, apart from indicating the elements provided for in Section 503(a) of the Administrative Instructions, also indicate the classification symbol assigned to the patent document by the Office which published the document. In the opinion of examiners, such an indication in certain cases facilitates an easier access of the user to the patent document.

It would seem to be expedient to discuss a possibility of introduction the said additional indication in the international search reports, especially taking into account the fact that major Patent Offices, publishing patent documents, tend to use the uniform international classification system.

## II.2 The Usefulness of International Search Reports for the National Phase

The State Committee has undertaken a study on the extent of use by examiners of the international search reports in the national phase. Since, at the outset of the study, it was decided not to base the arguments upon the results of the first decisions on the first international applications, considering a natural but at the same time complex process of adaptation to the new system, inclusive of psychological adaptation to be undergone by the applicants and examiners, the results of the study will be available in the beginning of 1982.

As a preliminary result - a decrease in number of cited foreign patent documents revealed in the course of carrying out additional search, may be taken note of. As a rule, additional citations when cited by examiner in respect of international applications in the national phase, are those of the Soviet patent file and Soviet non-patent literature, though in certain instances additional citations are made on the basis of other files constituting the PCT Minimum Documentation. Growing confidence in the international search on the part of examiners has become a general trend.

The most evident and doubtless factor, which testifies of the usefulness of the international search reports, is a considerable number of applications which the applicant, after the receipt of the search report, does not channel into the national phase. While reducing unnecessary expenditure on the part of the applicants this fact reduces, at the same time, the workload of the national Offices.

### III. The International Preliminary Examination

#### III.1 Experience with the Use of the Present System and the Application of PCT Article 33(1)

In 1978-1980 the State Committee received no demands for international preliminary examination. Nevertheless, as was already mentioned above, similar functions were extensively performed by the State Committee in respect of orders under the bilateral Agreements. The experience gained in this connection allows to supply the following comments:

– the form on which the international preliminary examination report is made out seems to be quite acceptable. The problem arising in the case of long explanations - particularly where a negative report was established in respect of inventive step - has found its solution through the use of an additional sheet, which was also practiced by certain International Preliminary Examining Authorities;

– there have been certain cases in the experience of the State Committee where, when drafting an international preliminary examination report, it was difficult to answer just “yes” or “no” in respect of non-obviousness of a claim. It seems to be expedient to discuss a possible amendment of PCT Rule 70.6(a) in the light of the proposal made by the International Bureau.

#### III.2 The Usefulness of the International Preliminary Examination Reports for the National Phase

As stated above in Section II.2 of this memorandum the study concerning this matter will be completed in the beginning of 1982.

As a preliminary result - growing confidence in the international preliminary examination reports on the part of examiners may be taken note of.

Taking into account the established practice of examining the international applications in the national phase the State Committee would like to point out that an extended time limit for carrying out the international preliminary examination could be very useful, in which case the State Committee would be prepared to receive the international preliminary examination report within two months after the start of the national phase, and consider a possibility of extending this time limit. But, at the same time, the State Committee is of the opinion that an amendment of Rule 69.1(a) and Rule 66.2(d) would be justified provided similar possibilities are available in the other elected Offices in order to avoid the creation of system of reservations which would unnecessarily complicate the use of the PCT.

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