

Meeting of International Authorities under the Patent Cooperation Treaty (PCT) Working Group

Eighteenth Session
March 15 to 17, 2011, Moscow

Search Strategy Information Provided in PCT International Search Reports

Proposal by the Canadian Intellectual Property Office

SUMMARY

1. Currently, the Patent Cooperation Treaty (PCT) International Search Report (ISR), Form PCT/ISA/210, provides a very limited area for details of the search strategy used by the examiner. It is proposed that this text area be expanded to provide a more comprehensive explanation of the search.
2. The introduction of a text area in the ISR to provide a more comprehensive and detailed explanation about the search strategy would help achieve an increase in confidence of the quality and usefulness of the ISR, resulting in the reports being more meaningful to the applicant, Contracting States, and third parties. Each International Authority would still be able to provide as much information regarding the search as they deem necessary, while the uniform format would result in all International Authorities including the same set of information in each report. This will result in the assurance that the PCT reports are comprehensive and will enable all users to have a thorough report available to them.

BACKGROUND

3. At both the third PCT Working Group meeting and the 17th Meeting of the International Authorities (MIA), much consideration was given to improving the PCT system, including the quality and usefulness of reports generated by the International Authorities. It is generally accepted that improvements should be sought which can be implemented without changing the PCT legal framework¹.
4. The PCT User Survey done by the International Bureau between October 1, 2009 and January 31, 2009 resulted in the identification of the need for an improved quality of search and examination reports². It was acknowledged at the 17th MIA that an improvement in the quality of international phase work would encourage its use in the national phase³. Additionally, high quality reports were identified as essential to not only other Offices and applicants, but also for setting up effective work sharing mechanisms based on PCT work products, such as PCT-PPH projects⁴.
5. Concerns raised by PCT Member States regarding the quality of the searches of the ISR⁵ could be lessened by the provision of more detailed information about the searches performed. Giving details of the process used to obtain the prior art results, including the scope of the search and the rationale for stopping the search, will help increase confidence in the reports of the International Authorities.
6. PCT Member States have asked for comprehensive and detailed information regarding the search⁶ to enable a more thorough understanding of the work performed and the context in which the Written Opinion was established⁷. Supplying information on the search strategy would facilitate the exploitation of the ISR in national phase which results in efficient work sharing and a reduction in duplication of work⁸.
7. These suggestions were accepted and reinforced at the third PCT Working Group (WG) in the discussion on the need for improving the functioning of the PCT system, notably that good explanations should be given on the relevance of cited documents⁹.

¹ Document PCT/MIA/17/12, paragraph 45

² Document PCT/MIA/17/7, Annex II, paragraph 73

³ Document PCT/MIA/17/12, paragraph 14(m)

⁴ Document PCT/MIA/17/12, paragraph 46

⁵ As example, Document PCT/WG/3/14 Rev. paragraphs 26, 37, 41, 46, 48, 52, 55, 59 and 77

⁶ Document PCT/WG/3/14 Rev., paragraphs 24 and 41

⁷ Document PCT/WG/3/14 Rev, paragraph 102 and PCT/MIA/17/12 paragraph 49(c)

⁸ Document PCT/MIA/17/12 paragraph 47

⁹ Document PCT/WG/3/2, paragraph 170(d)

8. Currently, the ISR (PCT/ISA/210) contains a text area where limited information is presented about the search. The information only provides classification terms, the databases searched and possibly key words. There is no information about how the classification, key words and databases were used, i.e. no clear search strategy is laid out¹⁰.
9. Many International Authorities currently have this information recorded by their examiners; it is not recorded in the ISR due to restrictions imposed by the form. As the search is already recorded, it would be a minimal amount of additional work for this information to be included in the ISR.

CONTENTS OF THE PROPOSAL

10. It is proposed that the amount of information provided by International Authorities in the ISR be increased such that a detailed account of the searching done by the examiner is understood by all users of the report. Further, the inclusion of subheadings in such an expanded search area would help to organize the information in a manner that could be easily understood by all users of the report. Expanding the search information provided in the ISR would improve the quality and usefulness of the report, without any required change to the PCT Regulations.
11. An example of the proposed change to the second sheet of form PCT/ISA/210 is provided in Annex I. The proposed amendments are found within Box B (Fields Searched) of Form PCT/ISA/210. Box B provides information about the search carried out by the International Search Authority. Currently Box B describes the minimum documentation searched, any documentation search over the required minimum and the electronic databases consulted with the search terms used if practical. A limitation of the information presented is there is no clear understanding of how the identified information was combined to achieve the results. The Proposed Box B comprises three sub-sections for identifying documents and databases used which exceed the minimum documentation required, discussing the search strategy used and for additional comments from the International Search Authority concerning the search.
12. The proposed Box B contains a section where the search strategy can be explained ("Search statements used"; Annex I). Under, "Search statements used", the International Search Authority can explain the search strategy which was developed to obtain the prior art results. An example of this is shown in Annex II; one can see the rational the International Search Authority used to find prior art on the subject matter. Search strings would be not included in "Search statements used" since they can be database specific and of little value for different databases. Rather, emphasis would be on underlying strategy the International Search Authority used in developing the search string itself. The aim of the information is to allow a third party to understand the search rational used in searching the subject matter of the invention.

¹⁰ Document PCT/WG/3/2 paragraph 77 (i)

13. The final section of amended Box B is for additional comments from the International Search regarding the search. This information could include the rationale of stopping the search, explanation for the use of databases and documentation beyond the minimum PCT requirement, information concerning the number of documents found and listed in Box C or any other comment the examiner wishes to make. This allows the International Search Authority to provide additional information they believe important to convey.
14. Specific areas identified for improving the usefulness of reports included giving better explanations of objections (notably concerning inventive step), more consistently observing the requirements of the Treaty in preparing the reports, and the simplification of the presentation of reports¹¹.
15. These suggestions were accepted and reinforced at the third PCT WG in the discussion on the need for improving the functioning of the PCT system, notably that good explanations should be given on the relevance of cited documents¹².

NEXT STEPS

16. International Authorities would need to provide input on the subheadings used in the search strategy box and on the level of detail to provide.
17. A modified version of the form PCT/ISA/210 would need to be distributed to all International Authorities for review and comment.
18. *The Meeting is invited to comment on the proposal by the Canadian Intellectual Property Office.*

[Annexes follow]

¹¹ Document PCT/MIA/17/12, paragraph 49(c)

¹² Document PCT/WG/3/2, paragraph 170(d)

ANNEX I

EXAMPLE OF THE MODIFIED FORM PCT/ISA/210

INTERNATIONAL SEARCH REPORT

International application No.

A. CLASSIFICATION OF SUBJECT MATTER

According to International Patent Classification (IPC) or to both national classification and IPC

B. SEARCH STRATEGY

Documentation and databases searched in addition to the minimum documentation:

Documentation :

Database(s):

Search statements used: (including classification(s) and keyword(s) searched)

Additional comments regarding the search:

Date of the actual completion of the international search

Date of mailing of the international search report

Name and mailing address of the ISA/CA

Authorized officer

INTERNATIONAL SEARCH REPORT

International application No.

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the	Relevant to claim No.

Further documents are listed in the continuation of Box C.

See patent family annex.

*	Special categories of cited documents :	"T"	later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
"A"	document defining the general state of the art which is not considered to be of particular relevance	"X"	document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
"E"	earlier application or patent but published on or after the international filing date	"Y"	document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
"L"	document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)	&	document member of the same patent family
"O"	document referring to an oral disclosure, use, exhibition or other means	"P"	document published prior to the international filing date but later than the priority date claimed

ANNEX II

EXAMPLE OF COMPLETED BOXES A AND B OF MODIFIED FORM PCT/ISA/210

INTERNATIONAL SEARCH REPORT	International application No.
A. CLASSIFICATION OF SUBJECT MATTER	
A61K 31/19 (2006.01), A61K 31.192 (2006.01), A61K 31/196 (2006.01), A61P 7/06 (2006.01)	
According to International Patent Classification (IPC) or to both national classification and IPC	
B. SEARCH STRATEGY	
Documentation and databases searched in addition to the minimum documentation:	
Documentation :	
Database(s):	
Search statements used: (including classification(s) and keyword(s) searched)	
Searched for the active compounds in classifications A61K 31/19, A61K 31/192 and A61K 31/196. Narrowed the search results by searching the broad drug classes of phenylpropionic acid, arylpropionic acid or NSAID (nonsteroidal anti-inflammatory). Also, searched the classification results for the exemplified/disclosed actives of diclofenac and ibuprofen. Provided results for the composition claims. Searched the results for the claimed use by the terms haematopoiesis, erythropoiesis, anaemia, haemoglobin, hematocrit, erythroid progenitor cells, erythrocytes, erythrocytosis, erythropoiesis-stimulating, erythropoietin.	
Structure search of formula I conducted in Chem. Abs.	
Additional comments regarding the search:	
Search of composition claims not limited by use.	
No search on A61P 7/06 conducted because only classifies the disorder not the actives, therefore not within the scope of the claimed subject matter.	
Stopped search as X and Y documents found for all claims.	
Date of the actual completion of the international search	Date of mailing of the international search report
Name and mailing address of the ISA/CA	Authorized officer

Form PCT/ISA/210 (second sheet) (July 2009)

[End of Annex II and of document]