

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION UNITED INTERNATIONAL BUREAUX FOR THE PROTECTION OF INTELLECTUAL PROPERTY GENEVA

PATENT COOPERATION TREATY

INTERIM COMMITTEE FOR TECHNICAL COOPERATION

Third Session: Tokyo, October 23 to 27, 1973

STUDY OF SEARCHING TECHNIQUES

Report prepared by the International Bureau

1. The Standing Subcommittee of the Patent Cooperation Treaty (PCT) Interim Committee for Technical Cooperation, at its third session, asked the Secretariat of WIPO to prepare a questionnaire on present search techniques as well as on prospective PCT search techniques.

2. The Secretariat was asked to utilize, to whatever extent possible, the answers submitted in response to a previous questionnaire which had been circulated by the International Committee for Information Retrieval Among Patent Offices (ICIREPAT) in 1969-70.

3. The Secretariat, in drafting a questionnaire to be distributed to all the members of the Standing Subcommittee noted a number of possible shortcomings in the approach being considered, i.e., the sending of a uniform questionnaire prepared by the International Bureau without further consultation with such members as to the areas to be covered, the type of questions to be asked and the nature of the answers to be given in response to the questions. Among these shortcomings were the necessity of asking several members of the Standing Subcommittee questions to which they may have already furnished, in regard to other activities of the International Bureau, answers which are still applicable, or questions which might unduly burden the member Office in answering. Moreover, in the absence of a prior discussion of the questions to be asked, it is perhaps unavoidable that misunderstandings occur on the part of various Offices as to the nature of the answers that are expected.

4. In order to obviate any such possible shortcomings, the Secretariat is suggesting to the PCT Interim Committee for Technical Cooperation to consider modifying somewhat the approach of the Standing Subcommittee to the study on search techniques. Such modification might take the form of either utilizing a somewhat different procedure in establishing a questionnaire or utilizing other means of obtaining the information. A third approach might be to use elements of both a questionnaire and other means to obtain the necessary information. If the questionnaire approach meets with the Committee's approval, it is suggested that such questionnaire should be based on the Standing Subcommittee's prior discussion and agreement as to:

- (i) areas to be covered by the study;
- (ii) questions to be asked; and
- (iii) nature of the answers to be given in response to the various questions.

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5. A draft questionnaire prepared by the Secretariat is annexed for consideration by the Committee to aid their decision as to whether a questionnaire should be utilized and if so, what its contents should be.

6. Should the Committee be of the opinion that no questionnaire--but other means only--should be used or that, in addition to the questionnaire, other means should be used too, for eliciting the required information, the Committee may wish to advise the Secretariat accordingly.

7. The Committee is invited to advise the International Bureau which approach the Standing Subcommittee should take in regard to the study on search techniques.

[Annex follows]

DRAFT

QUESTIONNAIRE ON CURRENT SEARCH TECHNIQUES
AND PROSPECTIVE PCT SEARCH TECHNIQUES

Introduction

1. The objective of this questionnaire is to obtain information on current searching techniques and prospective PCT search techniques useful for a maximum degree of uniformity in the documentation and working methods of the International Searching Authorities and a maximum degree of uniformly high quality in their search reports.
2. The questionnaire is drafted in such a way that the responses should give general information on the search or search-related tasks now being undertaken by the prospective PCT International Searching Authorities and for which the PCT prescribes requirements, standards or guidelines. The responses to the questionnaire should also give some insight into the way the prospective authorities would handle some of these tasks under the PCT.
3. Offices should answer the questions in general terms rather than being highly specific. The intention of the International Bureau is to first generate a general information base in the areas of the questions asked in order to enable it to propose the most suitable approach to be taken in obtaining further information.
4. Once the responses are received, the International Bureau will, in order to obtain more specific information on present search techniques as well as general information on prospective PCT search techniques, consider either developing a more detailed questionnaire intended for all prospective International Searching Authorities or drafting specific detailed questions addressed to certain of such Authorities.
5. Where, for any given question, an Office has, in connection with previous studies, already given a reply (for example, in connection with the ICIREPAT Search Standards Questionnaire) and such reply is still valid, such Office may, when replying to the annexed questionnaire, simply refer (by indicating date, etc.) to such earlier reply.

1. Patent Documentation and its Storage

The charts attached to this questionnaire seek information on the documentation of particular countries presently held by the prospective PCT International Searching Authorities. Chart 1 seeks information on documentation collections that are arranged only serially or chronologically, whereas Chart 2 seeks information on documentation collections that are arranged by subject matter or in a classified order.

In completing the charts, the Offices are asked to place in the appropriate locations on the charts:

- (i) the earliest known or estimated date for which the particular documents are available (if a range of dates, indicate the range);
- (ii) an 0 if no such documents are available; and
- (iii) an asterisk (*) if abstracts or abridgements represent the collection of documents.

II. Procedural Checks of Requirements of an Application Prior to Search

A. Subject Matter - Article 17(2)(a)(i) provides that International Searching Authorities are not required to search international applications which relate to subject matter as indicated in Rule 39.

1. Does your Office presently not search applications on any particular subject matter indicated in Rule 39, and if so, on which subject matter?
2. If your Office presently searches subject matter not required to be searched under Rule 39, does your Office envisage continuing to search such subject matter when acting as an International Searching Authority?

B. Meaningful Search - Article 17(2)(a)(ii) provides that the International Searching Authority is not required to search international applications in which the description, claims or drawings fail to comply with the prescribed requirements to such an extent that a meaningful search could not be carried out.

1. Does your Office prescribe requirements for the description, claims, or drawings, in the nature of PCT Articles 5, 6 and 7, respectively, which have to be complied with in order that a meaningful search may be effected?
2. If your Office prescribes such requirements, please state or summarize the substance of the requirements.

C. Unity of Invention - Article 17(3) and Rules 13 and 40 prescribe a requirement of unity of invention to be applied to international applications by the International Searching Authorities.

1. Does your Office apply a unity of invention requirement to applications and if so, what are the criteria?
2. If your Office applies a unity of invention requirement, what procedural options (such as payment of additional fees or restriction of the invention) are available to an applicant failing to meet such requirement?

D. Title and Abstract - Articles 3 and 14 require that an abstract and a title be part of the international application. The International Searching Authority may under certain circumstances be required to establish a title (Rule 37.2) or establish an abstract (Rule 38.2).

1. Does your Office presently require a title and an abstract as parts of an application?

2. Does your Office presently engage in establishing either titles or abstracts for applications and if so, under what circumstances and to what extent?

III. Method of Searching and Retrieval of Documentation

- A. Area of Search - Rule 33.2(b) and (d) requires that the international search shall cover not only the art in which the invention is classifiable but also analogous art, regardless of where classified, and equivalent subject matter.
 1. What requirements presently determine the area of search for any given application your Office searches?
 2. Does such a search extend to areas
 - (a) of analogous arts to the extent that that art is regarded to be analogous in the light of what appears to be the necessary essential function or use of the invention and not only specific functions expressly indicated in the application?
 - (b) embracing all subject matter that is generally recognized as equivalent to the subject matter of the claimed invention for all or certain of its features?
- B. Orientation of the Search - Rule 33.3 provides that the search shall be made on the basis of the claims with due regard to the description and the drawings, if any, and with particular emphasis on the inventive concept toward which the claims are directed. Furthermore, in so far as possible and reasonable, the international search must cover the entire subject matter to which claims are directed or to which they might reasonably be expected to be directed after they have been amended.
 1. What part or parts of the application presently form the basis of the search in your Office and if this basis includes the claims, does it also extend to possible amendments of the claims?
- C. In addition to the specific PCT related questions as to area of search and orientation of search, above, briefly indicate the usual procedure followed by your Office in conducting a search from the time search-related tasks on an application are begun until the time the search and search-related tasks are completed. If the procedures differ substantially because of the field or the subject matter of the application indicate such differences. The procedures should include reference to:
 - (i) any use of screening techniques, i.e. of abstracts, indexes, mechanical aids, etc. if such use is substantial and part of the ordinary procedure, and
 - (ii) the type of files (classified, serially arranged, etc.) of what documentation (domestic, foreign, patent, non-patent) usually consulted.

IV. Preparation of an International Search Report by the International Searching Authority

- A. Classification. Rule 43.3 provides that the international search report must contain a classification determined by the International Searching Authority of the subject matter of the international application at least according to the International Patent Classification (IPC).

- 1.* Does your Office presently classify applications according to the IPC?
 - 2.* Does your Office presently classify applications according to classification systems other than the IPC? If so, according to which classification system? If not for all fields, for which fields?
- B. Citations Rule 43.5 provides that the international search report must contain citations of relevant and particularly relevant documents or parts thereof cited in relation to all or some of the claims.
1. Does your Office presently cite documents, and if so:
 - (a) is a distinction made between relevant documents and those documents which are considered of particular relevance?
 - (b) are references made to particular parts of the documents?
 - (c) are documents cited both in relation to all or particular claims?
 2. Does your Office automatically furnish, or does it provide on request, documents cited in the processing of applications?
- C. Fields Searched Rule 43.6 provides that the international search report must list the classification identification of the field searched.
1. Does your Office presently indicate the classification identification of the fields searched and if so what is the classification system used?
 2. Does your Office maintain the following information for any given application searched:
 - (a) type of documents searched (patents, inventor's certificates, etc.)?
 - (b) country of origin of documents searched?
 - (c) range of years of documents searched?

* These questions may be answered by mere reference to any earlier detailed reply provided under the survey conducted by WIPO relating to the state of classification according to the IPC (see WIPO Circular No. 1361 of January 12, 1972).

Charts 1 and 2 follow

COLLECTION OF DOCUMENTS ARRANGED ONLY
SERIALLY OR CHRONOLOGICALLY

DOCUMENTS OFFICE	PCT Minimum Documentation as prescribed in Rule 34.1(c) (i) to (v)						
	Germany (Fed. Rep.)	France	Japan	Switzerland	United Kingdom	United States	Soviet Union
Austria							
Brazil							
Germany (Fed. Rep. of)							
Japan							
Netherlands /IIB							
Soviet Union							
Sweden							
United Kingdom							
United States							

*Documents in abstract or abridged form

COLLECTION OF DOCUMENTS ARRANGED ONLY
SERIALLY OR CHRONOLOGICALLY

DOCUMENTS OFFICE	Potential Supplemental PCT Minimum Documentation under Rule 34.1(c) (vi)						
	Australia	Austria	Canada	German Dem. Rep.	India	Ireland	OAMPI
Austria							
Brazil							
Germany (Fed. Rep. of)							
Japan							
Netherlands /IIB							
Soviet Union							
Sweden							
United Kingdom							
United States							

*Documents in abstract or abridged form

COLLECTION OF DOCUMENTS ARRANGED BY SUBJECT MATTER
OR IN CLASSIFIED ORDER

DOCUMENTS OFFICE	PCT Minimum Documentation as prescribed in Rule 34.1(c) (i) to (v)						
	Germany (Fed. Rep.)	France	Japan	Switzerland	United Kingdom	United States	Soviet Union
Austria							
Brazil							
Germany (Fed. Rep. of)							
Japan							
Netherlands /IIB							
Soviet Union							
Sweden							
United Kingdom							
United States							

*Documents in abstract or abridged form

COLLECTION OF DOCUMENTS ARRANGED BY SUBJECT MATTER
OR IN CLASSIFIED ORDER

DOCUMENTS OFFICE	Potential Supplemental PCT Minimum Documentation under Rule 34.1(c) (vi)						
	Australia	Austria	Canada	German Dem. Rep.	India	Ireland	OAMPI
Austria							
Brazil							
Germany (Fed. Rep. of)							
Japan							
Netherlands /IIB							
Soviet Union							
Sweden							
United Kingdom							
United States							

*Documents in abstract or abridged form

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Chart II