

# WIPO



PCT/TIM/II/2

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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 United Kingdom Patent Office*

The Annex to this document contains observations received by the International Bureau on April 2, 1981, from the United Kingdom Patent Office concerning international search and international preliminary examination.

[Annex follows]

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Memorandum prepared by the United Kingdom on matters concerning Agenda items 1(i) and 2(i).

Agenda item 1(i)

No comment.

Agenda item 2(i)(a)

- 1 During 1980, the United Kingdom Patent Office established 47 international preliminary examination reports.
- 2 Form PCT/IPEA/409 is considered unsatisfactory in that the spaces for insertion of details, explanations and notes are unnecessary in the majority of cases and are inadequate for the purpose when needed.
- 3 The time limit prescribed in Rule 69.1 was found to be adequate in most cases: only on one occasion did lack of time prevent further opportunity for amendment to remedy defects noted in the written opinion. In the other instances where a negative report was established, the applicant indicated that he was not prepared at this stage to remedy the noted defects.

No defects were found in only one case and the report was established without a written opinion being issued. A single written opinion sufficed in 41 cases. Where the applicant replied promptly, there was adequate time for the issue of further written opinions: two written opinions were issued in 4 cases, and three written opinions in 1 case.

- 4 Following Rule 66.2(d), in each case the applicant was invited to reply to the written opinion within a time limit of 2 months. Since it is within the competence of the Examining Authority to fix a time limit of 3 months, requests from the applicant for extension of the time limit up to a time limit of 3 months were allowed in order to expedite the establishment of a "YES" report within the Rule 69.1 time limit.

It is suggested that this possibility be mentioned in Chapter VI, 5.15 of the Guidelines.

- 5 The comments on the usefulness of international search reports in the national phase (Agenda item 1(ii)) apply to International Preliminary Examining Authority.

Agenda item 2(i)(b)

- 1 Form PCT/IPEA/40 8 is considered unsatisfactory for the reasons given in respect of Form PCT/IPEA/409.
- 2 Section 1, “Basis of Opinion” should indicate the application documents examined and these should include all amendments submitted. If it is the opinion of the Examining Authority that certain amendments go beyond the disclosure as filed, this should be explained in the written opinion and the observations of the applicant invited.
- 3 It is considered desirable to include in the Notes to Form PCT/IPEA/408 a warning to the applicant that he may be required to prepare any translation of the annexes to the report and that amendments submitted in the form of a letter will necessitate translation of the full text of the letter including any matter unrelated to the amendments.
- 4 14 (about 30%) of the reports prepared by the United Kingdom Patent Office were established after the Article 39 time limit.

It is suggested that the Notes to Form PCT/IPEA/408 should alert the applicant to the requirement for furnishing elected States with any replacement page or letter communicating an amendment, or a translation thereof as appropriate, as prescribed in Rule 74.

Report submitted by the United Kingdom concerning agenda items 1(ii) and 2(ii)

Agenda item 1(ii)

- 1 The United Kingdom substantive examiner is under instruction to re-search a national application processed via the PCT only if he is reasonably sure that the UK search files will yield more pertinent art. Otherwise, his searching is restricted to the “top-up” search and any supplementary search necessitated by allowable amendment of the claims.
- 2 Of the relatively small number of applications examined (671 applications were received during 1980), about 10% were re-searched and more-relevant prior art found.
- 3 In most cases the international search report was considered useful and adequate – with reports from particular International Searching Authorities in certain technical areas being considered particularly useful eg reports established in Japan on inventions in the internal combustion engine field, and in the USA on inventions in the telephone and line transmission fields.
- 4 Doubts arose as to the reliability of search report in the following circumstances:
  - (a) When the claims clearly relate or may be construed as relating to aspects of the invention which appear not to be covered by the International Patent Classification (IPC) symbols identifying the “Fields Searched”.  
It is suggested that the report should identify each independent claim and the field(s) in which the claim was searched.
  - (b) Where the claims are not clear or are ambiguous and may be construed as relating to aspects of the invention which are covered by a single IPC symbol.

It is suggested that in these circumstances the report should indicate the aspects searched.

5 Reports have been criticised as follows:

- (a) The relevance of citations is over-valued. About 50% of citations identified as “X” documents were considered to be “A” documents.

It is suggested that where a citation is considered to be an “X” document, the pertinent parts of the document should be identified.

- (b) Citations of only marginal relevance to the general state of the art are included.

It is suggested that the International Searching Authority be more selective in respect of these documents.

- (c) A report is established (for practical reasons) on all inventions claimed even where the requirement of unity of invention is clearly not complied with.

It is suggested that the report should indicate that although the requirement of unity of invention is not complied with) the International Searching Authority has chosen not to invite the applicant to pay additional fees and the report is established in respect of the entire international application.

6 It is suggested that where a citation is not in an official language of any of the designated States, the report should indicate either the appropriate “family match” or that no “family match” is known to the International Searching Authority.

Agenda item 2(ii)

- 1 Although the United Kingdom substantive examiner is not bound by the international preliminary examination report, he is instructed to give it full consideration.
- 2 It is recognised that the report is the opinion of an experienced examiner applying internationally accepted criteria in the light of his experience in his national or regional procedure. It follows that in the United Kingdom the examiner will ensure that the conclusions presented in the report accord with the national examination standard and full benefit of international preliminary examination is enjoyed only when the report is established in the United Kingdom or the European Patent Office.