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**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 Royal Patent
and Registration Office of Sweden*

The Annex to this document contains observations received by the International Bureau on April 13, 1981, from the Royal Patent and Registration Office of Sweden concerning international search and international preliminary examination.

[Annex follows]

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Section 503 of the Administrative Instructions regulates the methods of identifying documents cited in the International Search Report. In the experience of the Swedish Patent Office subparagraphs (a)-(c) of this Section have not created any serious problems.

As regards subparagraph (d) however, we do have experienced certain problems. In our opinion Section 503 (d) recommends more detailed citing of abstracts than is always practically possible. Should only the needs of a well equipped Searching Authority be covered, the rules for citation could be very much simpler, but one has to keep in mind also the public in its capacity as a potential receiver of a search report.

After careful consideration of all aspects the Swedish Patent Office has issued an office regulation for citing abstracts in international search reports (see the Annex to this memorandum). Said regulation has later been included also in the new common Nordic Patent Regulations, which have entered into force on January 1, 1981. It is to be noted here that we have deliberately adopted a regulation which does not completely correspond to the Administrative Instructions under the PCT. We have done so since we believe our regulation is better adapted to the real situation than Section 503 (d), which in fact was drafted many years ago.

3. Article 17(2)(a) has so far been of very little practical impact. However, there is one experience that might be reflected upon, and this refers to article 17(2)(a)(ii). It can occur sometimes, that an application contains so much uncorrelated technical matter that, although it may be possible to understand the technical description, it is impossible to deduct where the invention or inventions actually reside (see also point 4 below).

In a practical case in the Swedish Patent Office, priority in an international application was claimed from no less than five national applications. In order not to violate the requirement for unity of invention the applicant into one claim squeezed the common denominator of all technical matter in the priority applications. The result was that the claim became so broad that a meaningful search could not possibly be made. The remaining claims revealed a multitude of uncorrelated details whereby it was impossible to identify any main inventions in the application. In this case it was in fact a combination of defects according to articles 17(2)(a) and (b), which made it impossible to carry out an international search.

Literally it was in fact article 17 (2) (a) which should be applied, but in this article there is no possibility to invite the applicant to clarify the situation. Ob-

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PCT INTERNATIONAL MEETING, TOKYO 1981
Memorandum prepared by the Swedish Patent Office

1. The Administrative Instructions, Sections 505 and 507 define the indications used in conjunction with citations of different categories appearing in international search reports. For documents of particular relevance the indication required is the letter X. For documents defining the general state of the art, on the other hand, the letter A should be used (Section 507). These two indications are the ones most frequently used and also those which have created most of the problems.

The first problem lies in the question when to use X, and when to use A? From chapter VI in the Guidelines for International Search it can be understood that it is generally not permissible to combine or mosaic separate documents together. It is therefore logical, and also in accordance with the opinion of the Swedish Patent Office, that an X indication can only be used in conjunction with a document, which is so pertinent that the respective claim can not be considered patentable in its present form. In other words, to be patentable in view of the document marked with an X the claim must be amended. A document which shows that a part, but not all, of a claim is previously known must consequently be indicated with an A if the document is not pertinent enough to reject the whole claim.

A second problem results from the border-line area between these two cases. It is not uncommon that two documents together completely destroy the patentability of a claim, although each of these two documents alone is not pertinent enough. Presently these two documents have to be indicated with an A. The Swedish Patent Office, however, feels that another way of indicating the pertinence of these two documents would be of great assistance to the applicant in evaluating his search report. As a matter of fact it might be unfair to the applicant not to inform him of the effect of these documents. It is known that the European Patent Office for this kind of documents leaves a blank where the indication should have been. In other words, the EPO indicates so called combination documents with the absence of any special indication.

A similar procedure would be welcome also in the PCT. The question is whether Sections 505 and 507 will have to be amended to include a possibility of the kind mentioned above, or if Sections 505 and 507 could be regarded as not exhaustive in their present lay-out. As a matter of fact the heading of section 507 seems to indicate this, but then subparagraph (f) does not.

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It will be understood here that using this method, a search report may be established for one search fee wherein in fact the unity of invention is not fulfilled according to Rule 13.1. The question then arises whether or not this should be indicated in the search report. The form for the search report does not contain any proper place for indicating this, but it might be argued that it would be of value for the applicant to be informed of the lack of unity of invention. We have however concluded that in this stage (phase I) the applicant is not helped with a negative statement on the unity of invention, and we therefore do not indicate in the search report when the unity of invention is not fulfilled, although only one search fee has been levied. An important consequence of course is that the question of unity of invention is not a finished one: in the substantive examination under phase II of the PCT or before a designated office, it is important to examine the unity of invention with respect to all the further aspects of the PCT or any national patent law.

5. A main object of the PCT is of course a world-wide rationalization of the search work to be performed in patent applications filed in many countries. The expectation of course is that an international search report will speed up and facilitate the procedure before designated offices. It is self-evident that the more confidence a designated office places in the international procedure under the PCT, the more efficient and simple will the procedure before said office become. It is well known that the PCT has been a new and sometimes strange experience to applicants all over the world, but this is probably just as true for many of the patent offices. As more offices come to grips with the PCT, which in fact is much simpler than rumours will have it, the procedure before designated offices will become smoother and smoother. So while much is bound to improve with time, there are still some problems which can not be completely left to time.

The one problem we would like to take up here is the usefulness of references in international reports. If all the references in an international search report can be understood, the further prosecution in a designated office should be based on said search report and no further search should in principle be necessary. Problems develop however, when some parts of the search report cannot be readily understood.

Before the PCT came into force, the problem of interpreting references in difficult languages cited by an International Searching Authority was recognized. This problem should, it was calculated, be eliminated through the establishment of INPADOC, whereby patents in readily understandable languages could be traced and made to substitute any documents in difficult languages.

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viously the reason for this is that article 17(2)(a) was drafted on the presumption that the defects were so grave that any correction within the scope of the international application as originally filed would be impossible.

In the specific case we had in the Swedish Patent Office we in fact acted according to the spirit of article 17(2)(b), although we in fact applied article 17(2)(a). In other words, no search was started and the applicant was notified that unless he showed which invention he was actually interested in having searched, no international search report would be established.

4. The practical measures of handling cases covered by article 17 (3) (a) are pretty straight-forward according to the experience of the Swedish Patent Office. It is often no problem to identify the invention first mentioned in the claims (main invention) and then to invite the applicant to pay additional fees. Furthermore, the procedure according to rule 40 has in itself caused no practical problem.

What might be interesting here to discuss, however, could be the application of the requirement for unity of invention. The requirement for unity of invention is laid down in rule 13. The basic requirement is laid down in rule 13.1, and further requirements are laid down in rules 13.2, 13.3 and 13.4. For a smooth application of article 17(3)(a) it is necessary to decide on the application of rule 13.

It is important here to keep in mind that the international search report appears in phase I of the PCT procedure, and that substantive examination as to patentability is left to later stages: be it PCT procedures according to phase II or procedures before designated offices. In our opinion the application of rule 13 therefore should be made from the point of view of the International Searching Authority and its major function: to perform the international search. Another matter to keep in mind is the fact that the costs of preparing an international search report in the PCT should be covered by the search fee.

When we take all factors into consideration we come to the conclusion that if the requirement for unity of invention in rule 13.1 is fulfilled no additional search fee will be asked for. If the requirement for unity of invention in rule 13.1 is not fulfilled, but the search can be performed with very little extra effort for the main invention as well as for any further inventions, no additional search fee will be asked for. In both these cases rules 13.2, 3 and 4 play only a secondary role.

5. Experience in our office however, has shown that in not so few cases, an equivalent patent has not been issued in a second language.
- If an equivalent patent can not be found, you are left with the problem of understanding an international search report in which one or more of the pertinent documents are in a difficult language. A first possibility is of course to translate a document into the language in which the office is working. This is of course very expensive and for the Swedish Patent Office it is out of the question. A second possibility is of course to oblige the applicant to provide a translation of certain documents. Naturally it will be no less expensive for the applicant to translate them, and we have therefore been very reluctant to use this method so far. A third alternative would be to disregard the international search report and establish a national search report. From the point of view of the applicant and the effect of rationalization this would of course not be a very recommendable solution in the long run. Finally one could also consider the fourth alternative of accepting the international search as reported although you do not understand some of the references cited. On the assumption that an applicant would not fulfil his application in a designated state with a search report which is damaging to his invention, you could assume that a national search does not reveal any pertinent documentation. This alternative does not however seem very satisfactory.
- We presently feel that the second alternative above - i.e. to oblige the applicant to provide a translation - is the one which in the future might be the reasonable one. A prerequisite, however, is that the manner of indicating the cited references is improved (see above), that further only very pertinent documents will have to be translated and that, finally, this question is dealt with similarly by designated offices.
- When an international application is filed in the Swedish Patent Office as designated (or elected) office, we take into account the fact that in comparison with other patent applications claiming priority much work has already been laid down in examining the application. It is therefore the aim to deliver a first action in the fulfilled international applications within 30 months from the priority date, which in general is much sooner than in most regular applications claiming priority.
6. Although almost 56 % of the number of demands for international preliminary examination during 1979 and 1980 have been filed with the Swedish Patent Office, the experience so far has not revealed any significant problems in the phase II procedure.
6. There is however one point here which needs commenting upon, and this is the question of unity of invention. Regardless of how the question of unity of invention was treated in phase I, the requirement for unity of invention laid down in rule 13, in particular rule 13.1, must be contrasted against the international application. If the requirement is not fulfilled, this should be noted in the written opinion (PCT form 408).
- In the Swedish Patent Office we have come to the conclusion that it is not appropriate to make use of the possibility to invite the applicant to pay additional fees (article 34(3)). In contrast to what the case is in phase I, the extra effort of judging the patentability of more than one invention is negligible. Consequently the applicant is reminded of the possibility to restrict his application to fulfill the requirement of rule 13.1 but additional fees are not asked for.
- According to our experience it is not always necessary to issue a so called written opinion but in the cases where a written opinion is in fact issued, one opinion is very often enough. Should there remain any questions to be solved, they are solved after a telephone contact between the examiner and the applicant or his agent.
- As regards the question of providing for the possibility of extending the period for a reply by the applicant to a written opinion we have never experienced any cases where this has been asked for by the applicant. As far as we can judge now the reasons given during the PCT Assembly in June last year seem rather theoretical. The written opinion is issued almost two years after the priority date, and by that time most of the relevant information regarding the invention should have been gathered.
- If the period for reply is extended, the time limit for the establishment of the international preliminary examination report may also have to be extended and this, as a matter of fact, has also been suggested. If the time limit for the establishment of the international preliminary examination report was extended to expire one year (from six months as provided at present) after the start of international preliminary examination said report would not be established in time to be included in the application when the applicant fulfills his application in an elected office (25 months from the priority date). Since the usefulness of the international preliminary examination report would then become much less for the applicant as well as for the elected offices, such a consequence is highly undesirable.
- The Swedish Patent Office therefore does not agree to a general possibility to extend these time limits at the request of the applicant. It now seems to us that the very few and seldomly occurring instances where an extended time limit might be of help to the applicant do not justify a general change which would have the above-mentioned negative consequences.

7.

In the opinion of the Swedish Patent Office it is not advisable to open the possibility to indicate in a preliminary examination report that a claim may be patentable but only in an amended form. If this was stated in a report, but the amended form was not identified, the result would only be confusion. If the amended form was in fact a suggestion from the examination authority, then said authority assumes a great responsibility, and we do not think that this would be sensible. We therefore do not support any such amendment of rule 70.6.

We are of course ready to examine in a positive manner any suggestions intended to avoid the examination of particular questions thereby prolonging the international procedure unduly beyond the 25 months. As stated above the whole point of the preliminary examination report is to facilitate the procedure before the elected offices.

7. Except for some minor items the international search report form is functioning well. Report forms in different languages do not create any problems, since the contents of the report are standardized. There is consequently no need to translate the report form as such.

8. The indication of the international patent classification symbols should not create any problems: The guide to the IPC should of course be followed by everyone concerned. Proposes for changes in said indication should be channelled to the appropriate bodies (PCPI).

9. If a patent office is acting as an international searching authority as well as a national authority the office may feel some difficulties in applying several different kinds of standards to its procedure. In our opinion it is necessary to identify these different standards and to concentrate on fulfilling them correctly. The procedure under the PCT is laid down in international cooperation, whereas the procedure under the national laws are established by the national offices themselves. It is necessary for the acceptance and recognition of the PCT that all PCT Authorities act in the same manner. We therefore think it would be dangerous to try and align different procedures carried out by one office by way of applying a uniform procedure. The natural way of achieving uniform procedures is to amend the law and the regulations of the state in question and align it with the PCT. This will automatically bring the two procedures closer together.

Internal Office regulation of 1980-09-22
(Unofficial translation)

Re: Citations in International search reports

Citing of relevant documents shall follow the rules set forth in Sec. 503 of the Administrative Instructions. Corresponding rules may be found in "Guidelines for Examination in the EPO, Part B" p. 99-104.

However, as regards cited abstracts, somewhat less detailed rules shall be followed. Cited abstracts will often probably belong to one of the following three categories:

a) Abstracts of Soviet documents. Citing shall be done analogously to the following example:

"Derwent's abstract No. 88 963 B/49, SU 653 273"

b) Abstracts of Japanese documents. Citing shall be done analogously to the following example:

"Patent abstracts of Japan, abstract of JP 55-11 013, published 1980-01-25"

c) Abstracts from Chemical Abstracts. Citing shall be done analogously to one of the following two examples:

(i) "Chemical Abstracts, Vol. 75 (1971), abstract No. 120 718, Fiz.-Klim. Mekh. Mater. 1971 7(2), 7-11 (Russ.)."

(ii) "Chemical Abstracts, Vol. 92 (1980) abstract No. 215 278, SU 697 515."