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GENEVA

PATENT COOPERATION TREATY

INTERIM COMMITTEE FOR TECHNICAL COOPERATION

Fourth Session: Geneva, November 14 to 19, 1974

PCT MINIMUM DOCUMENTATION (PATENT DOCUMENTS):

TREATMENT OF PATENT FAMILIES

Report prepared by the International Bureau

Introduction

1. At its third session, held in Tokyo in October 1973, the PCT Interim Committee for Technical Cooperation (hereinafter referred to as "the Interim Committee") agreed that its Standing Subcommittee should study the questions related to the proposal of the United States of America with respect to the treatment of patent families in the framework of the PCT minimum documentation, bearing in mind the views expressed by the Interim Committee (see paragraph 78 of the report of the third session, document PCT/TCO/III/13).

Proposal of the United States of America

2. The problem which is the subject of the proposal of the United States of America is summarized in the proposal itself as follows: "At the present time a degree of indecision exists regarding the interpretation of PCT Rule 34.1(b)(i). Specifically, prospective International Searching Authorities are not certain whether this Rule must be applied in its strictest meaning (i.e., the inclusion of duplicative patent documents from the several minimum documentation countries) or whether it could be satisfied by way of a family of patents system or some other arrangement which would avoid the burdensome problems created by a narrow and inflexible interpretation of the Rule." (See document PCT/TCO/III/9.)

Relevant Provisions of the PCT

3. During its discussion of the proposal, the Interim Committee noted the relevance of the following provisions of the PCT for the consideration of the problem raised:

- (i) Article 15(4) states that the International Searching Authority shall endeavour to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the Regulations.

- (ii) The reference in Article 15(4) to "the documentation" specified in the Regulations" means the PCT minimum documentation as specified in Rule 34.
- (iii) Rule 36.1(ii) requires the International Searching Authorities to have in their possession at least the minimum documentation referred to in Rule 34, properly arranged for search purposes.
- (iv) Rule 43.5(a) prescribes that the international search report shall contain the citation of the documents considered to be relevant.

4. The views expressed at the third session of the Interim Committee are reflected in paragraphs 66 to 78 of document PCT/TCO/III/13.

Further Action

5. As stated above, the Interim Committee requested its Standing Subcommittee to study the possibility of establishing guidelines as to the manner in which members of a patent family are to be properly arranged for search purposes. Since the Standing Subcommittee has not met in 1974, that study was not undertaken so far and the question arises whether the Interim Committee itself would wish to consider the question further at this stage.

6. With respect to this question, the International Bureau is of the opinion that, in view of the particularly difficult technical questions involved, it would be more useful if the Interim Committee took up discussion of this question only after its Standing Subcommittee has had an occasion to perform a thorough study.

7. The Interim Committee is invited to express its views on this question, in particular on the proposed procedure.

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