

WIPO



PCT/TCO/SS/I/7

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DATE: October 14, 1971

WORLD INTELLECTUAL PROPERTY ORGANIZATION

UNITED INTERNATIONAL BUREAUX FOR THE PROTECTION OF INTELLECTUAL PROPERTY

PATENT COOPERATION TREATY

INTERIM COMMITTEE ON TECHNICAL COOPERATION

STANDING SUBCOMMITTEE

First Session : Geneva, December 8 to 10, 1971

PROPOSALS FOR METHODS OTHER THAN
INFORMATION MEETINGS
AND TEST SEARCHES

Report by the International Bureau

SUMMARY

This document summarizes the replies submitted by the Netherlands and four non-governmental organizations with regard to proposals for methods other than information meetings and test searches which would permit the PCT Interim Committee for Technical Cooperation to achieve certain of its objectives.

1. The PCT Interim Committee for Technical Cooperation in its first session which took place in Geneva from February 8 to 11, 1971, gave the International Bureau the task to invite the members of the Standing Subcommittee and the interested nongovernmental organizations to make concrete proposals for methods other than the said information meetings and test searches for the securing of the maximum degree of uniformity in the documentation and working methods of International Searching and International Preliminary Examining Authorities (document PCT/TCO/I/6).

2. In compliance with this task, the International Bureau mailed on March 24, 1971, to members of the Standing Subcommittee and to interested nongovernmental organizations, circular letter C.1221/PCT 081.3 (annexed to this document) which contained such invitation.

3. The Netherlands Octrooiraad and four international nongovernmental organizations replied. Their replies are summarized in the following paragraphs, whereas the full texts of the same replies are attached as an Annex to this document.

4. Netherlands. The reply of the Netherlands proposed a method to be applied prior to or in lieu of conducting information meetings whereby the Standing Subcommittee would evaluate what results could be achieved towards its objectives if it were to hold discussions based upon a working paper to be prepared by utilizing two reports already produced by Technical Committees under the ICIREPAT program, namely, document IC/TCL/20 which summarizes the replies of major patent offices (many of which are prospective International Searching Authorities) to questionnaires concerning search standards and document IC/TCC/V/5 which points out the matters of agreement and disagreement among the various offices in respect of said search standards.

5. The Netherlands' reply also dealt with the method of test searches and proposed the use of test searches of a different character than that of the test searches proposed by the Federal Republic of Germany and discussed at the first session of the PCT Interim Committee for Technical Cooperation (February 1971). The test searches proposed in the Netherlands reply would have as an objective the establishment of a numerical measure of the quality of searches being performed by each of the prospective International Searching Authorities and to apply such numerical measures to extrapolate a realistic numerical measure of the quality which should be set for PCT searches.

6. International Association for the Protection of Industrial Property (AIPPI). The reply of AIPPI proposed the formation of a special group of experts knowledgeable on the problems associated with international searching to conduct a training program to qualify the examiners of all prospective International Searching Authorities as "international examiners." Said group of experts would further be responsible for the establishment of a set of general rules to guide the searching practices of the international examiners.

7. The AIPPI reply also proposes the formation of a central technical commission which would be entrusted with making the decisions on how to deal with the special cases which present difficult problems of uniformity. Said commission would further be entrusted with performing regular checks to establish that a uniformity in the quality of search reports is being maintained.

8. The AIPPI reply also dealt with the problem of mechanical retrieval of patent documents and with the problem of the classification of documentation under the International Patent Classification system. The PCT Interim Committee for Technical Cooperation in its first session decided not to include these matters in its program as it was felt that such matters could best be dealt with by the organs in charge of administering the ICIREPAT and International Patent Classification programs.

9. Committee of National Institutes of Patent Agents (CNIPA). The reply of CNIPA indicated the intention to further study the matter but that presently CNIPA had no proposals to make for methods other than information meetings and test searches.

10. Union of Industries of the European Community (UNICE). The reply of UNICE likewise indicated the intention to further study the matter but that UNICE had no proposals to make at present.

11. Union of European Patent Agents (UNION). The reply of UNION dealt with the method of test searches and suggested soliciting the cooperation of the patent departments of large industries to find a substantial number of patent applications filed on the same invention in the various countries of the prospective International Searching Authorities to be used for the test.

12. The Subcommittee is invited to make a decision on the question whether--in view of the fact that, apparently, most of the members of the Subcommittee are not interested in methods other than information meetings--the search for such methods should continue or whether one should revert to the idea of such meetings.

/Annex follows/

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C.1221
PCT O81.3

March 24, 1971

I have the honor to refer to the program suggested by the PCT Interim Committee for Technical Cooperation at its First (February 1971) Session according to which the Standing Subcommittee of that Committee is to "study the merits, costs, feasibility, usefulness and possible timetable of information meetings on searching techniques and of test searches" (document PCT/TCO/I/6, paragraph 26). At the same time, the International Bureau has been given the task to "invite the members of the Standing Subcommittee and the interested nongovernmental organizations to make concrete proposals for methods other than the said information meetings and test searches for achieving the said objectives" (ibid, paragraph 26), namely, "the securing, so long as there are several International Searching Authorities and several International Preliminary Examining Authorities, of the maximum degree of uniformity in their documentation and working methods and the maximum degree of uniformly high quality in their reports," (PCT, Article 56(3)(ii)).

We would appreciate it if you could let us have your proposals, if any, preferably before October 1, 1971.

Sincerely yours,

Arpad Bogsch
First Deputy Director General

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C.1221
PCT O81.3

March 24, 1971

I have the honor to refer to the program suggested by the PCT Interim Committee for Technical Cooperation at its First (February 1971) Session according to which the Standing Subcommittee of that Committee is to "study the merits, costs, feasibility, usefulness and possible timetable of information meetings on searching techniques and of test searches" (document PCT/TCO/I/6, paragraph 26). At the same time, the International Bureau has been given the task to "invite the members of the Standing Subcommittee and the interested nongovernmental organizations to make concrete proposals for methods other than the said information meetings and test searches for achieving the said objectives" (ibid, paragraph 26), namely, "the securing, so long as there are several International Searching Authorities and several International Preliminary Examining Authorities, of the maximum degree of uniformity in their documentation and working methods and the maximum degree of uniformly high quality in their reports," (PCT, Article 56(3)(ii)).

We would appreciate it if you could let us have your proposals, if any, preferably before October 1, 1971.

Sincerely yours,

Arpad Bogsch
First Deputy Director General

<i>uw brief van</i>	<i>uw nummer</i>	<i>ons nummer</i>	<i>bijlagen</i>
24-3-1971	<u>C. 1221</u> PCT 081.3	S 71/461	

datum September 24, 1971

onderwerp

Mr. A. Bogsch,
First Deputy Director General,
World Intellectual Property
Organization,
32, chemin des Colombettes,
1211 GENEVA 20.

Dear Mr. Bogsch,

1. This is in response to WIPO-circular letter C.1221 directed to the members of the Standing Subcommittee of the PCT Interim Committee for Technical Cooperation.
2. At the first meeting of the Interim Committee we expressed our opinion that the information meetings as proposed in items 23 and 24 of PCT/TCO/I/2 form very costly and rather inefficient means for distributing information on and familiarizing examiners with search practices in other offices. In view of the ready availability of other means serving the same purpose (see 3 and 4 below) we consider that an elaborate program of meetings as proposed is superfluous and certainly premature at the present stage.
3. The information concerned has to a large extent been collected recently for Technical Committee I of ICIREPAT by questionnaires on search standards sent out by the International Bureau in 1969. Replies were received by the International Bureau in 1969 and 1970 from many patent offices including nearly all prospective search authorities. The International Bureau, acting as secretariat for ICIREPAT, in september 1970 produced a report, including a list of the questions asked and an extensive summary of the replies received (document IC/TCL/20 (70) with its annexes A and B). On request of TC I the secretariat then in november 1970 prepared an interim report introducing in a general manner the most important items in the summary and pointing out matters of agreement and disagreement between the various offices, for consideration by the TCC (document IC/TCC/V/5, first supplement with Annex). The report of the fifth session of the TCC (IC/TCC/V/13, page 12, item 48) states that the TCC took note of this interim report.
4. We propose that as a first step the Standing Subcommittee requests the International Bureau to extract from the wealth of information contained in the replies to the questionnaires, basing itself primarily on the summary of replies and the interim report, the information regarding the prospective Search Authorities and relevant to the present problem, in the form of a working paper for discussion by the Standing Subcommittee.

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The Subcommittee would then be in a position to decide:

- a. whether additional information is needed and should be collected from the prospective search authorities
 - b. whether and in what form the information available (possibly after completion) should be distributed to the offices for the purpose of informing the examiners
 - c. what modifications in the search practices in these offices will be necessary in order to obtain the desired degree of uniformity and harmonization.
 - d. what suggestions can be given to these offices in order to assist them in bringing this about.
5. At the first meeting of the Interim Committee, we also stated that we doubt the usefulness of the German proposal for a PCT Test Search (PCT/TCO/I/2, pages 9 and 10, items 25 and 26, and Annex) in the form proposed and at this time. Nevertheless, we agree with the German Patent Office that before PCT becomes operational test searches should be conducted in order to establish the degree of uniformity of search in the various Search Authorities. We are of opinion however that such a test should be delayed until the necessary modifications in search practices have been identified and efforts have been made to bring about the required harmonisation indicated in 4 above. Also we find it impractical and unrealistic to base such a test on artificial cases as proposed, and instead would much prefer to use true cases.
6. However, we propose that a test of a different character be performed as soon as possible. In discussing the quality of PCT searches as well as national searches, it is of great importance that a method be established to attach a numerical measure to this quality of search, that the numerical measure of the quality of searches as performed at present in the various prospective search authorities be established, and that a realistic, economically feasible numerical measure of the desired quality of a PCT search be extrapolated from these figures, in order to give the prospective search authorities guidance in the scope of the modifications to be introduced in their search practices and afterwards to make it possible to check whether the desired target quality is being obtained. We are of opinion that the pilot test performed by the Netherlands Patent Office under ICIREPAT auspices and fully reported in IC/TC.I/14 (70) has shown that it is indeed feasible to establish such a measure and to perform such a test, based on a comparison of the references found by various offices in their searches with respect to corresponding applications for patent. On request by the TCC we have proposed a procedure for a full scale test (IC/TC.I/23 (70)); this was discussed in the fourth session of TC I, as a result of which that committee decided to recommend to the TCC that such a full scale test should be undertaken (IC/TC.I/25 (70), pages 5-7, items 23-27). The TCC in its fifth session of december 1970 considered several comments with respect to this recommendation (IC/TCC/V/5 second supplement with five Annexes) and decided not to proceed with that test. It expressed some doubt as to the utility of such a test and considered that such a test belonged to the scope and task of the PCT-TCO committee rather than to ICIREPAT (IC/TCC/V/13, page 12, item 51).

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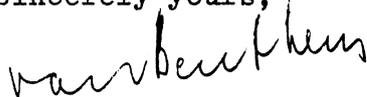
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7. We maintain that performance of such a test is of great and fundamental importance both to PCT and ICIREPAT, and we propose that the standing subcommittee recommends that such a test be undertaken forthwith for the benefit of both organizations, and should be organized by an appropriate working group of either organization.
8. Finally we stress that, since the area of interest of the Subcommittee to a fair extent coincides with areas of interest of working groups of ICIREPAT and the International Classification, there is considerable danger of duplication of work. This of course should be avoided, and the Subcommittee should therefore make optimal use of the work of these organizations and their more specialized working groups. In our opinion the International Bureau, by acting as secretariat for both these organizations as well as PCT, is in an excellent position to identify areas of common interest and of work performed in one of these organizations and of use to this Subcommittee, and should accordingly act as main center of liaison and communication.

Sincerely yours,



J.B. van Benthem,
President.

AIPPI

Association Internationale
pour la Protection
de la Propriété Industrielle

Secrétaire général:
Dr. Rudolf E. Blum
Zurich 8 (Suisse)

Mühlebachstrasse /
Kirchenweg 5
Téléphone 051 47 54 54

Mr. Arpad Bogsch
First Deputy Director General
Organisation Mondiale de la
Propriété Intellectuelle
32, chemin des Colombettes
1211 Genève 20

September 27, 1971

C 1221
PCT 081.3

Dear Mr. Bogsch,

with reference to your letter of March 24, 1971 you will find enclosed the requested proposals on PCT Art. 56(3) (ii) which are worked out by a special committee of AIPPI.

Sincerely yours,



Dr. Rudolf E. Blum
Secretary General

PCT, Article 56(3) (II): Uniformity in documentation and
working methods of the International Searching Authorities

(methods other than information meetings and test searches)

In order to obtain uniformity of international searches and examination reports, it is necessary - as indicated in Article 56(3) (II) of the PCT Plan - to consider in particular the uniformity of

- 1) the examination material, and
- 2) the working methods.

I. Examination material

With regard to the examination material, two aspects have to be distinguished:

- A) the examination material per se, and
- B) the form in which the documentation for examination is made available to the examiner.

A) The examination material per se

The minimum documentation of patent specifications which should be available to any International Searching Authority, has already been established in the rules of the proceedings (rule 34). In this connection, it has to be pointed out that the International Searching Authorities of the Western countries need not include, in their examination material, any Japanese or Russian patent specifications for which no

English summaries are available. Such summaries have only been in existence since 1961 in the case of Russian patents and certificates of authorship and since 1962 in the case of Japanese patents in the chemical field. Since this point will undoubtedly create discrepancies in search results, it is absolutely essential to additionally include English summaries of the older Russian and Japanese patent specifications as soon as possible, in the documentation of those Searching Authorities which do not have Russian or Japanese as official language.

With regard to publications (articles in journals, books etc.) other than patent literature, the International Bureau has yet to publish a list of the minimum documentation. It is highly recommended that this list be prepared with the assistance of interested and specialized circles, since the International Searching Authorities alone will not be able to draw up the list of all important journals or other publications which should be considered. It is also important, in this connection, that all new and relevant publications (e.g. new journals) immediately be included in this list of minimum documentation and that all International Searching Authorities immediately be informed about these extensions of the minimum documentation.

B) Form in which documentation is available to the examiner

In order to make searches practically possible, documentation may be divided into many thousands of classes, as has been generally customary until now, or may be stored, for example

on tapes, for carrying out mechanical searches.

a) The Patent Classification System

If this system is to be maintained wholly or partially, uniformity must be aimed at in the following respects:

- 1) Searches, either of the full publications (patent specifications, articles in journals etc.) or of the summaries thereof, should be carried out. Since, however, it is to be expected that examiners will consider full texts only when they are written in their own language, or, possibly, in one or two other languages, and that other publications included in the minimum documentation will only be available as summaries, the minimum documentation could never be used in the same form by the examiners of the different Searching Authorities. Only a mechanical storage and retrieval system can provide a solution to this problem.

- 2) Classification of patent specifications and other publications should not only be made on the basis of the most important characteristics, but all information contained in the particular document should be taken into account. For this reason, in most cases, one class per document will not suffice; in some cases it will be necessary to classify the same document in ten or more classes. Classification according to only one aspect would neglect much

important information and only if full classification, according to all disclosed aspects, is systematically carried out by all Searching Authorities, can an equally high quality of search reports be achieved,

- 3) Since the patent classification systems employed in the different patent offices differ considerably, which thus often leads to different search results, a uniform classification system which can be used by all International Searching Authorities should be aimed at. After some adaptation, the International Patent Classification (IPC) could be used for this purpose.

b) The mechanical searching systems

Since, under these systems, all essential data of a publication is coded and stored, it is available to all Searching Authorities in the same form. A document, therefore, has to be analysed only once, for example, in the country from which the publication or patent application originated. It is true that such an analysis requires a lot of time, but the search can be carried out considerably more quickly later on. Language difficulties will thus disappear, since all data is either coded or given, for example, in English key words.

These mechanical storage and searching systems, therefore, form the ideal solution for obtaining uniform results from a search carried out at different places.

ICIREPAT (International Cooperation on Information Retrieval among Examining Patent Offices), already working in this field, could be used and developed in working out these mechanical searching systems.

II. Working methods

In order to obtain the same search result from different examination places, it is not enough to offer the same documentation in the same form. Thus, in addition, the examiners must use this documentation in the same way (search the same classes or the same key words during the mechanical search) and must evaluate this documentation in the same way (the same documents should be considered as relevant and included in the search report).

As far as the desired uniformity in this field is concerned, great difficulties have to be reckoned with, since, even a search carried out independently by several examiners of the same patent office, will often lead to different results and, furthermore, the examiners of each country receive a different training depending on the patent law and practice of the country concerned and therefore judge many patent problems differently.

No major difficulties should arise as to the finding and evaluation of material prejudicial to novelty. It will, however, be more difficult to obtain from all examination places a consistent assessment of the state of the art in the absence of novelty destroying material.

In such cases, the first priority should be to evaluate the present state of the art in as much detail as possible, i.e. all aspects of the invention should be considered (e.g. compounds, production, use) and the search should not be restricted to the actual scope of invention, but the examiner should also search for analogous compounds, processes or uses. In order to achieve favourable results, each examiner of the International Searching Authority must not only have a profound knowledge of his own field and the adjacent fields of technical science as well as of the patent classification or the mechanical searching system, but must also, independent of each patent law, practice and legislation, be able to compile from the material available to him, a complete state of the art, suitable for use in the judgement of patentability in all countries.

The following measures could promote the desired uniformity:

- 1) Training of examiners of all International Searching Authorities to become "international examiners" by a group of special experts who have studied in detail the problems of international searching. This training could take place in the individual patent offices at the beginning of the PCT plan; later on the trained examiners would attend to the training of the newcomers.
- 2) General rules set up by the experts mentioned under 1) for the examiners of International Searching Authorities.
- 3) Setting up of a central technical commission which,

particularly at the beginning, deals with all difficult and complicated cases submitted by the Searching Authorities in order to decide centrally how these special cases are to be dealt with. As a consequence of such decisions, the rules mentioned under 2) may be amended or completed. The difficult and delicate problem of uniformity of applications should initially and to a large extent be submitted to this commission for decision.

- 4) The commission mentioned under 3) should regularly check by test samples that a satisfactory uniformity in search reports is being obtained and should take the necessary steps to remove any inconsistencies.

Summary

The following measures (besides information meetings and test searches) are suggested in order to obtain the greatest possible uniformity of the examination material and the working methods of the different International Searching and Examination Authorities:

A) Examination material

- 1) Including English summaries of Russian and Japanese patent specifications (starting 1920) in the documentation of all Searching Authorities.
- 2) Development of mechanical searching systems for all

technical fields. These systems should comprise the entire minimum documentation. The documents of those fields not yet having mechanical systems should be divided according to a uniform classification (IPC). All published data should be considered in the classification of a document and, if necessary, a document should be classified according to many aspects.

B) Working methods

- 1) Training of examiners of the International Authorities as "international examiners" by a special group of experts.
- 2) Setting up of general rules for the examiners.
- 3) Setting up of a central commission to decide on complicated cases.
- 4) Permanent checking of uniformity of search and examination reports by the same commission and the taking of all necessary steps to avoid inconsistencies.

**COMMITTEE OF NATIONAL INSTITUTES OF PATENT AGENTS
C.N.I.P.A.**

secretariat: Ir. P. L. Hazelzet - 1e Lieven de Keylaan 116 - EINDHOVEN - Netherlands

EINDHOVEN,

To the First Deputy Director General
of WIPO,
Dr Arpad Bogsch,

G E N E V A

re : your letter C.1221 /PCT 081 3

Dear Sir,

On behalf of CNIPA I beg to acknowledge receipt of your letter of 24th March 1971, contents of which had the attention of the delegates of the Chartered Institute of Patent Agents, the German Patentanwaltskammer, the Austrian Patentanwaltskammer and the Dutch Orde van Octrooigemachtigden, which are gathered in CNIPA.

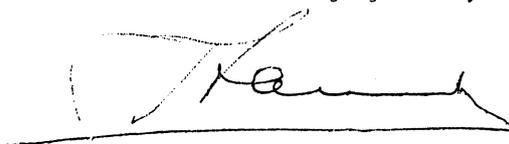
They have requested me to inform you that the important aim of securing uniformity in the operations of the several International Searching Authorities and the several International Preliminary Examining Authorities under PCT and the means for achieving that aim according to CNIPA's opinion are essentially a matter for Patent Offices, Government Departments and the like.

For the present CNIPA has no proposals which might be a useful contribution to this subject.

CNIPA - and consequently the above-mentioned four institutes of patent agents remain highly interested in the further development of this matter.

CNIPA will be glad to study and if possible answer any practical questions you might wish to put to CNIPA when proposals of the authorities have matured.

Sincerely yours,



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UNION DES INDUSTRIES
DE LA COMMUNAUTÉ EUROPÉENNE
4, RUE RAVENSTEIN BRUXELLES 1
TÉL.: 13.45.62 - ADR. TÉL.: UNINDUSEUROP
TELEX : UNICE BRU 22038

HMC/HK/AG/5.1 C.3

Le 29 septembre 1971.

C. 1221
Monsieur le Directeur Général,

J'ai l'honneur de me référer à votre lettre du 24 mars 1971 par laquelle vous invitez l'U.N.I.C.E. à vous faire des propositions concrètes pour des méthodes de techniques de recherche.

Le sujet a rencontré la plus grande attention des membres du Groupe de travail "Brevets" de l'U.N.I.C.E. A l'heure actuelle, ce groupe n'est, cependant, pas en mesure de vous soumettre des propositions concrètes. Toutefois, les experts de l'U.N.I.C.E. en cette matière suivront attentivement le développement en ce domaine. Ils aimeraient, dès lors, apprendre les résultats des recherches-test qui sont envisagées dans le programme du Comité Intérimaire d'Assistance Technique dans le cadre du PCT.

Je vous remercie vivement à l'avance pour toute communication à ce sujet et vous prie d'agréer, Monsieur le Directeur Général, l'assurance de ma considération très distinguée.



H.M. Claessens,
Secrétaire Général.

Monsieur Arpad BOGSCH
Premier Vice-Directeur général
O.M.P.I.
Chemin des Colombettes 32
CH - 1211 - GENEVE 20

UNION

DES CONSEILS EN BREVETS EUROPÉENS
EUROPÄISCHER PATENTANWÄLTE
OF EUROPEAN PATENT AGENTS

Le Président

The Hague, 8th June, 1971

Mr. A. Bogsch
First Deputy Director General
of the World Intellectual
Property Organization
32, chemin des Colombettes
1211 - G E N E V A

SWITZERLAND

Your ref. C 1221
PCT 081.3

Dear Mr. Bogsch,

Thank you for your letter of March 24, 1971 in which you asked to make concrete proposals for harmonizing the results of the several international searching authorities.

I inform you that the Union is of the opinion that the best method will be to have the various searching authorities examine a large number of the same patent applications, e.g. at least 100 chemical patent applications, 100 mechanical patent applications and 100 electrical patent applications.

We are convinced that the results in the various searching offices will be strongly varying, so that it will be necessary to study why these results are so different and how a maximum degree of uniformity can be obtained.

The Union appreciates that it will be difficult to find such a big number of patent applications filed in countries of the various searching authorities, particularly since at present not so many patent applications from abroad are filed in Russia.

We think, however, that in case that the patent departments of big industries, which file patent applications in the countries of the various searching authorities and in countries which entrust the I.I.B. with the novelty search, are requested to cooperate with you in giving the results of the various novelty searches, you will

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get the results in the simplest way, without burdening
the searching offices with additional work.

With kindest regards,

sincerely yours,

A handwritten signature in cursive script, appearing to read "Kees Davidson", with a horizontal line drawn underneath it.

(Kees Davidson)

/End of Annex,
end of document/