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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Seventh Session (5th Extraordinary)*
Geneva, June 29 to July 3, 1981

INFORMATION ON THE “PCT INTERNATIONAL MEETING” HELD IN TOKYO
FROM MAY 25 TO 29, 1981

Prepared by the International Bureau

INTRODUCTION

1. During its 6th session (4th extraordinary), the Assembly accepted a proposal of the Delegation of Japan to hold, at the invitation of the Japanese Patent Office, a “PCT International Meeting” in Tokyo, hosted by the Japanese Patent Office.
2. The PCT International Meeting was held in Tokyo from May 25 to 29, 1981 and was mainly concerned with questions affecting the activities of the International Searching and Preliminary Examining Authorities. The report of that Meeting (PCT/TIM/I/13) (hereinafter referred to as “the Report”) is reproduced in the Annex to this document.

Results of the PCT International Meeting

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3. As far as the results of the PCT International Meeting are concerned, reference is made to the Report.

4. Since the said Meeting was held shortly before the present session of the Assembly, detailed consideration of all matters discussed at the meeting and presentation of all the conclusions is not possible at this stage. This document deals, therefore, only with some aspects discussed at the said Meeting which require particular attention at this stage. All matters discussed during the PCT International Meeting which require further action from the side of the International Bureau and are not specifically referred to in this document, will be followed up by the International Bureau in due course.

5. *The Assembly is invited to take note of the Report.*

Translation of Documents Cited in the International Search Report

6. The attention of the Assembly is drawn to paragraphs 21 to 23 of the Report dealing with requirements to translate, in the national phase, documents cited in the international search report. These paragraphs, to the extent that they are relevant, read as follows:

“21.... it was emphasized that it was particularly important for the usefulness of international search reports for the users of the system and for the designated Offices to include as much patent family information in those reports as was feasible under the circumstances. This was of special significance in the case of citations of patent documents in languages with which some or most of the users or designated Offices were less familiar. Such practice would also reduce the need for translations of cited documents which should be avoided as much as possible”.

“22. In this context the Meeting considered the necessity for, and the usefulness of, requiring from the applicant translations of cited documents published in languages which are neither used nor understood by a particular designated Office. It was noted that the Australian Patent Office, the German Patent Office, the Japanese Patent Office and the United States Patent and Trademark Office did not require a translation of documents cited in the International Search Report from the applicant and had no intention to do so, whereas the Swedish Patent Office, so far applying the same practice, was now studying the possibility of requiring translations from the applicant. The practice of requiring such translations of documents of particular relevance was already applied by the United Kingdom Patent Office”.

“23. Attention was drawn to the view that it was the responsibility of the Patent Office to prove the lack of patentability of the invention which made it difficult to justify putting the burden for such translations on the applicant. Moreover, it was not normal under the national procedure of most countries to place such obligation on the applicant. One should avoid placing the PCT applicant reaching the national phase of the procedure in a less favorable position than the ordinary national applicant. To the extent that a need was nevertheless felt by some Offices to obtain translations in certain cases from the applicant, it was generally felt that the Offices so proceeding should limit such requirements to particularly important portions of citations of particular relevance and that the International Searching Authorities should assist the Offices in this respect

by carefully choosing the documents of particular relevance and by precisely indicating the relevant portions of such documents.”

7. The Assembly is invited to consider and to endorse the views expressed in the paragraphs of the Report cited above, in particular with regard to the desirability of avoiding the applicant who follows the PCT route being placed in a less favorable position than applicants who do not follow that route, and to make appropriate recommendations to the designated and elected Offices as well as to the International Searching Authorities.

The Usefulness of International Search Reports in the National Phase

8. The usefulness of the international search report was discussed in detail. The results of the discussion are summarized in paragraphs 32 and 33 of the Report, which read as follows:

“32. The Meeting agreed that the international search reports were useful for the procedure in the national phase as they facilitated that procedure and allowed it to be accelerated. In particular, it was stated by several participants that, in the experience of their Offices, the international search report allowed the Office to produce its first action in examining procedure usually much sooner than in the case of an ordinary national application. It was furthermore stressed by several participants that the experiences made allowed the conclusion that only a top-up search was needed in the ordinary case where an International Search Report was available and that a complete new search was only required in a relatively small number of cases. The hope was expressed that, with further experience in the carrying out of international search and in its use by the designated Offices, the already high degree of avoidance of duplication of search effort could steadily be increased”.

“33. In this context, it was stressed that the economies made, due to the international search report, in the national phase of the procedure before designated Offices should be reflected in so far as possible in certain benefits for the applicant, for instance (through an appropriate reduction of the national fees charged to the applicant or through an opportunity to accelerate the procedure for the grant of the patent as was already the practice of some Offices”.

9. It is the intention of the International Bureau to bring the conclusions contained in the cited paragraphs of the Report to the attention of all designated and elected Offices and to stress the importance of the international search report for the avoidance of duplication of search effort by the designated Offices and the need to reflect in so far as possible economies made in the national procedure in certain benefits for the applicant, e.g., reduction of national fees or acceleration of the procedure for the grant of the patent.

10. The Assembly is invited to note the conclusions reached in the cited paragraphs of the Report as to the usefulness of the international search report and to endorse the action proposed to be taken by the International Bureau.

Announcing of Certain Facts in the Gazette

11. The PCT International Meeting discussed the usefulness of supplying information under Rules 29.2 and 51.4 and of publishing such information (see paragraph 34 of the Report). The PCT International Meeting felt that, since under Rule 48.6 only the essence of notifications under Rules 29.2 and 51.4 was to be published, it would suffice if such information would be supplied on an annual basis in the form of statistical data.

12. The Assembly is invited to consider the above interpretation and if it agrees, to adopt it.

Usefulness of International Preliminary Examination Reports for the National Phase

13. The PCT International Meeting considered the international preliminary examination report and its usefulness for the national procedure before the elected Offices.

14. The results of the discussions are summarized in paragraph 43 of the Report, which reads as follows:

“43. During the discussion ..., it was stated that the international preliminary examination reports were particularly useful for elected Offices, since they facilitated their work and contributed significantly to a highly desirable worldwide standardization of the interpretation of the criteria of patentability. Several participants remarked that, for those reasons, the examiners of their respective Offices were instructed to give full consideration to such report and that the limited experience so far available had already shown a growing confidence of examiners in such reports. It was even more important under Chapter II than under Chapter I to grant certain benefits to the applicants using the procedure under Chapter II and providing international preliminary examination reports to elected Offices, for instance, in the way referred to in paragraph 33, above [quoted in paragraph 8 of this document]. Only the availability of such benefits would create a sufficiently strong incentive for applicants to use that optional part of the PCT procedure which would in turn be the only possibility of obtaining the advantages inherent in that procedure.”

15. It is the intention of the International Bureau to bring the conclusions contained in the cited paragraph of the Report to the attention of all elected Offices and to stress the importance of the international preliminary examination report for the avoidance of duplication of examination effort by the elected Offices and the need to reflect, in so far as possible, economies made in the national procedure in certain benefits, for instance, through an appropriate reduction of national fees or acceleration of the procedure for the grant of the patent.

16. The Assembly is invited to note the conclusions reached in the cited paragraph of the Report as to the usefulness of the international preliminary examination report and to endorse the action proposed to be taken by the International Bureau.

Extension of Time Limit for Establishment of International Preliminary Examination Report and Change to the Provisions of Rule 70.6

17. The Assembly, during its fifth session (3rd extraordinary) held in Geneva from June 9 to 16, 1980, considered the extension of time limits for the establishment of international preliminary examination reports and a change to the provision of Rule 70.6 (see document PCT/A/V/17, paragraph 29; see also documents PCT/A/V/3, Annex C, page 4 and Annex G, page 3 and PCT/A/V/4, pages 60 and 61). The Assembly invited the International Bureau to study the question further and, in doing so, to consult with the International Preliminary Examining Authorities.

18. The consultations referred to above took place at the PCT International Meeting and the conclusions which were reached are summarized in paragraphs 45 to 49 of the Report. These paragraphs read as follows:

“45. The Meeting noted the views of the International Bureau concerning the extension of the time limit for a reply to a written opinion of the International Preliminary Examining Authority under Rule 66.2(d). The Meeting agreed that no amendment was required since the present text of Rule 66.2(d) was flexible enough to give the applicant sufficient time for his reply. The time limit set for the reply to a written opinion could be extended and the Rule did not exclude the fixing of a second time limit for a further reply.

“46. In the course of the discussion of a possible ‘amendment to Rule 69.1(a), the view was expressed that in the majority of the cases the time limit for the establishment of the international preliminary examination report was sufficient to carry out the complete examination and to take into account replies received on written opinions. In this respect it was noted that some International Preliminary Examining Authorities made use of the telephone to clarify rapidly questions arising during examination with the applicant.

“47. However, the majority of the participants of the Meeting agreed with the view expressed by the International Bureau that in special cases an extension of the time limit under Rule 69.1(a) could be appropriate. It was proposed that an amendment to Rule 69.1(a) should be considered under a double condition, namely, that the applicant expressly requested extension and that the International Preliminary Examining Authority, on the basis of the reasons put forward by the applicant, thought fit to allow the extension. The delegation of the Soviet Union was of the opinion that any extended time limit under that Rule should not exceed eight months from the start of the international preliminary examination or two months from the expiration of the 25-month time limit provided for in Article 39(1) (a), whichever time limit expired later. The delegation of Japan felt that the present system was flexible enough to come in all possible cases to satisfactory results, in particular, in view of the interpretation of Rule 66.2(d) referred to in paragraph 45, above.

“48. The Meeting invited the International Bureau to further study the question of an amendment to Rule 69.1(a) and to prepare a proposal for consideration by the assembly of the PCT Union.”

19. It is the intention of the International Bureau to prepare the proposal referred to in paragraph 48 of the Report and submit it to a later session of the Assembly.

20. The Assembly is invited to consider the results of the discussion of the PCT International Meeting referred to in paragraph 16, above, and if it agrees,

(i) to adopt the views expressed during the said discussion and

(ii) to note the intention of the International Bureau referred to in paragraph 19, above.

Amendments to Sections 503, 505 and 507 of the Administrative Instructions

21. The PCT International Meeting discussed the modification of Sections 503, 505 and 507 of the Administrative Instructions as set out in Annex II to the Report (see paragraphs 12 to 20 and Annex II to the Report) .

22. It is the intention of the Director General to modify Sections 503, 505 and 507 of the Administrative Instructions as set out in Annex II to the Report.

23. The Assembly is invited to note the intention of the Director General referred to in paragraph 22.

Modification of Certain Forms Related to International Search and preliminary Examination

24. The PCT International Meeting considered several proposals for amendments of Forms (see paragraphs 36 to 41 and 56 of the Report). The International Bureau will, on the basis of the proposals and in the light of the discussion of the PCT International Meeting prepare in due course a revised version of all Forms referred to in the Report. The revised forms will then be promulgated by the Director General.

25. The Assembly is invited to note that amended Forms will be promulgated by the Director General in due course.

[Annex follow]

WIPO



PCT/TIM/II/13

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

TOKYO INTERNATIONAL MEETING
Tokyo, May 25 to 29, 1981

REPORT

Prepared by the International Bureau

INTRODUCTION

1. At the invitation of the Japanese Patent Office, a "PCT International Meeting" (hereinafter referred to as "the Meeting") was held in Tokyo from May 25 to 29, 1981.
2. The following eight Contracting States were represented at the Meeting: Australia, Austria, Democratic People's Republic of Korea, Japan, Soviet Union, Sweden, United Kingdom, United States of America.
3. The European Patent Office was represented in its capacity as International Searching and Preliminary Examining Authority.

4. The Republic of Korea participated in the Meeting as observer.
5. The following five international non-governmental organizations were represented by observers: Asian Patent Attorneys Association (APAA), European Federation of Agents of Industry in Industrial Property (FEMIP), International Association for the Protection of Industrial Property (IAPIP), Pacific Industrial Property Association (PIPA), Union of European Practitioners in Industrial Property (UEPIP).
6. The number of participants was about 30. The list of participants is contained in Annex I to this report.

OPENING OF THE MEETING

7. Deputy Director General K. Pfanner opened the Meeting and expressed on behalf of the Director General the thanks of WIPO to the Japanese Patent Office for the invitation to hold this Meeting in Tokyo and for its excellent work in the preparation of the Meeting. The objective of the Meeting was to study the possibilities to further harmonize and simplify the work of the International Searching and preliminary Examining Authorities and to facilitate the work of the designated and elected Offices, thus increasing the usefulness and the practicability of the system for the applicants. The moment for the Meeting was particularly timely as a few days from now, the PCT will have been operational for three years. The experience gathered with the more than 9000 international applications filed during these years had first of all shown that it was a well-functioning system which has proven its value. Furthermore, the experience gained, in particular by the International Searching and Preliminary Examining Authorities, allowed, as was the primary objective of the Meeting, to reconsider the procedure so far applied in order to improve it, where feasible.

8. Director General H. Shimada of the Japanese Patent Office welcomed the participants of the Meeting. He underlined the efforts made in Japan to promote the use of PCT, for instance by holding orientation meetings for PCT users (e.g. PCT Seminars) and by preparing a Japanese language version of the PCT Applicant's Guide. He expressed the expectation that the number of international applications would increase in quantity and that the Meeting would make an important contribution towards substantially improving the practical application of the PCT.

ELECTION OF OFFICERS

9. The participants of the Meeting appointed Mr. F.J. Smith (Australia) as Chairman, Mr. H. Iwata (Japan) as First Vice-Chairman and Mr. J. Delorme (EPO) as Second Vice-Chairman.
10. Mr. B. Bartels, Head, Legal Section, PCT Division, WIPO, acted as Secretary of the "Meeting.

THE INTERNATIONAL SEARCH

Amendments to the Administrative Instructions under the Patent Cooperation Treaty (PCT)

11. Discussions of possible recommendations for amendments to the Administrative Instructions were based on the proposals submitted by the European Patent Office as contained in document PCT/TIM/I/3, Annex; pages 1 to 4.
12. The Meeting recommended to amend Section 503 (Method of Identifying Documents Cited in the International Search Report) as set out in Annex II to this Report.
13. In the course of the discussion of Section 503, the Meeting expressed the opinion that the date of publication of patent documents should always be indicated and should be the publication date printed on the document. The delegation of the United States of America drew the attention of the International Searching Authorities to Section 110 (Dates) as international search reports received from several International Searching Authorities did not indicate dates in the manner prescribed by Section 110. This was noted by the International Searching Authorities.
14. The delegation of Sweden asked whether the footnote to Section 110 concerning the standard applicable for the indication of dates would not now have to be adapted to changes which have taken place in the meantime. The International Bureau informed the Meeting that the applicable WIPO standard still allowed two forms of indication of dates and that the ISO standard was not yet generally applicable. However, acceptance of the ISO standard as future WIPO standard was under consideration. Any such change in the WIPO standard would of course, where necessary, lead to an amendment to Section 110 and the related footnote.
15. With regard to the proposal of the Swedish delegation to amend Section 503(d), as contained in document PCT/TIM/I/S, pages 1 and 4, concerning the manner of citation of abstracts, the Meeting concluded that a reconsideration of the applicable WIPO standard should first be pursued in the framework of the competent body of WIPO. It was then a matter for the Director General to consider, in the light of the results of such work, any necessary amendments to the Administrative Instructions.

Indication of Citations of Particular Relevance and Manner of Indicating Certain Special Categories in the International Search Report

16. The Meeting recommended to amend Sections 505 and 507 as set out in Annex II to this Report.
17. In the course of the discussion which was mainly based on the proposal of the European Patent Office as contained in document PCT/TIM/I/3, pages 2 to 4, the Meeting considered it to be desirable to achieve greater harmonization in the indication of citations of particular relevance in the international search report by more clearly defining the use of the indication of the letter "X" and supplementing it by a new letter "Y" where, for purposes of determining

the inventive step, a citation is relevant only in combination with one or more other document.

18. The proposal of the European Patent Office to use the letter “D” for the identification of a document already cited by the applicant himself in the international application for which the search is carried out was not approved in the light of the views expressed by the majority of the participants of the Meeting.

19. Further modifications which were recommended to be made to the provisions relating to categories “A” and “L” are reflected in the relevant provisions contained in Annex II to this Report.

20. In connection with Section 507, the Meeting considered a proposal by the European Patent Office for a new paragraph (i) relating to the indication of documents which are members of a patent family and recommended to include such provision as paragraph (g) in Section 507, as shown in the proposed draft of that Section contained in Annex II to this Report.

21. In that context it was emphasized that it was particularly important for the usefulness of international search reports for the users of the system and for the designated Offices to include as much patent family information in those reports as was feasible under the circumstances. This was of special significance in the case of citations of patent documents in languages with which some or most of the users or designated Offices were less familiar. Such practice would also reduce the need for translations of cited documents which should be avoided as much as possible.

22. In this context the Meeting considered the necessity for, and the usefulness of, requiring from the applicant translations of cited documents published in languages which are neither used nor understood by a particular designated Office. It was noted that the Australian Patent Office, the German Patent Office, the Japanese Patent Office and the United States Patent and Trademark Office did not require a translation of documents cited in the international search report from the applicant and had no intention to do so, whereas the Swedish Patent Office, so far applying the same practice, was now studying the possibility of requiring translations from the applicant. The practice of requiring such translations of documents of particular relevance was already applied by the United Kingdom Patent Office.

23. Attention was drawn to the view that it was the responsibility of the Patent Office to prove the lack of patentability of the invention which made it difficult to justify putting the burden for such translations on the applicant. Moreover, it was not normal under the national procedure of most countries to place such obligation on the applicant. One should avoid placing the PCT applicant reaching the national phase of the procedure in a less favorable position than the ordinary national applicant. To the extent that a need was nevertheless felt by some Offices to obtain translations in certain cases from the applicant, it was generally felt that the Offices so proceeding should limit such requirements to particularly important portions of citations of particular relevance and that the International Searching Authorities should assist the Offices in this respect by carefully choosing the documents of particular relevance and by precisely indicating the relevant portions of such documents.

24. It was noted as a result of this discussion that the relevant paragraphs of the Guidelines for International Search to be Carried Out under the PCT (chapter IV, paragraph 3) required revision. In this context it was noted that the delegation of Japan suggested to replace in Chapter III, paragraph 3.14 of the said Guidelines the sentence starting with “- the state of the prior art ... “by”- the state of the prior art which is deemed to concern the technical features of each constituent of the claimed inventions”.

Experience with the Application of Article 17(2) (a) of the PCT, in Particular with the Requirements for Carrying Out a Meaningful Search

25. The Meeting noted that cases requiring application of that provision were found to be extremely rare and did not call for particular measures. Reference was made to a case of an application pertaining to perpetual motion (perpetuum mobile). The conclusion was that such cases should be subjected to international search unless the application was so unclear that the application of the principle of Article 17(2) (a) was required.

26. In that context and on the basis of a particular case brought to the attention of the Meeting, it was noted that Article 17(2) (a) allowed clarification of a doubtful case with the applicant before the International Searching Authority made its declaration under that provision.

Unity of Invention Required under Article 17(3) (a) of the PCT and its Practical Implications

27. The Meeting agreed that the experience in implementing the provisions of the PCT concerning unity of invention during the first phase of the international procedure had not shown any significant practical difficulties. One delegation felt that, in case of lack of compliance with the requirement of unity of invention and late payment of the additional fee required; there was not enough time to complete the search within the time limit under Rule 42.1. The majority of the participants felt, however, that, if possibilities of rapid contact with the applicant were used and some restraint was applied as to the kind of cases in which a request for additional fees was made, the search could even in that case be completed within that time limit.

28. It was generally felt that no request for an additional search should be made, if, despite lack of compliance with the requirement of unity of invention only little extra effort was needed to make a full search. Such procedure was also in the interest of the applicant in obtaining the search report before publication and in the interest of the general public in seeing the search report published together with the international application. Reference was made to chapter VII, paragraph 12; of the Guidelines for International Search to be Carried Out under the PCT which contained already a recommendation to the same effect.

29. The Meeting was furthermore of the opinion that it would be helpful for the applicant, the designated Offices and the International preliminary Examining Authorities if the International Searching Authority would, in the case referred to in the preceding paragraph, make a reference signaling the non-compliance with the requirement of unity of invention. This should, however, only be done in cases where the lack of such compliance was beyond

doubt. Furthermore, no statement on unity of invention should be made in cases where non-compliance with the requirement of unity of invention would only result from any amendment to the claims which might become necessary in view of the references cited in the international search report (see also chapter VII, paragraph 12 of the Guidelines for International Search to be Carried Out under the PCT).

Extent and Depth of Search Required under Article 15(4)

30. The Meeting noted with gratitude the interesting results of the study made by the Japanese Patent Office and contained in document PCT/TIM/I/4, in particular the analysis of the frequency of citations both as to the year of publication and the language of the document contained on pages 28 to 35 of that document.

31. In that context, the need to provide patent family information in the International Search Report, as indicated in paragraph 21 above, was again underlined. Furthermore, a desire was expressed to make use of the results of the analysis prepared by the Japanese Patent Office for the ongoing study of the International Bureau concerning the question of an appropriate cut-off date for the PCT minimum documentation under Rule 34 carried out in the framework of the PCT Committee for Technical Cooperation.

The Usefulness of International Search Reports in the National Phase

32. The Meeting agreed that the international search reports were useful for the procedure in the national phase as they facilitated that procedure and allowed it to be accelerated. In particular it was stated by several participants that, in the experience of their Offices, the International Search Report allowed the Office to produce its first action in examining procedure usually much sooner than in the case of an ordinary national application. It was furthermore stressed by several participants that the experiences made allowed the conclusion that only a top up search was needed in the ordinary case where an international search report was available and that a complete new search was only required in a relatively small number of cases. The hope was expressed that, with further experience in the carrying out of international search and in its use by the designated Offices, the already high degree of avoidance of duplication of search effort could steadily be increased.

33. In this context it was stressed that the economies made, due to the international search report, in the national phase of the procedure before designated Offices should be reflected in so far as possible in certain benefits for the applicant, for instance through an appropriate reduction of the national fees charged to the applicant or through an opportunity to accelerate the procedure for the grant of the patent, as was already the practice of some Offices.

34. On the basis of statistical information presented by the Japanese Patent Office, in document PCT/TIM/I/4 concerning the rather high percentage of cases (37%) in which an international application originally designating Japan was abandoned for that country without entering the national phase, it was felt that this effect was probably largely due to the international search although it could not be established with precision to what extent. In this context, the International Bureau was asked to remind all designated and elected Offices to supply the information required under Rules 29.2 and 51.4. It was felt, however, since under Rule 48.6 only the essence of such notification was to be published that it would suffice if such information would be supplied on an annual basis in the form of statistical data. Such procedure would also have the advantage of reducing considerably the flow of paper for the designated and elected Offices as well as for the International Bureau.

Experience in Applying Uniform Procedure for Several Kinds of Searches

35. Several participants stated that their respective Offices did already apply a uniform procedure for the several kinds of searches in the framework of the PCT and the applicable regional or national procedure which the said Offices were called upon to carry out. The experience with such uniform procedures was positive and its application was considered useful. The Meeting noted this information.

THE INTERNATIONAL PRELIMINARY EXAMINATION

Experience of the International Preliminary Examining Authorities Concerning the Present System, in Particular as to the International Preliminary Examination Report and as to Communications with the Applicant and Amendments before the International Preliminary Examining Authority

36. The Meeting discussed in this context initially questions and proposals relating to the international preliminary examination report form (form PCT/IPEA/409), taking into account in particular the proposals of the European Patent Office contained in document PCT/TIM/I/3.

37. The Meeting adopted as its recommendation the amendments proposed by the European Patent Office for page 1 of the said Form (see document PCT/TIM/I/3, Annex, page 7). It was, however, noted that two of the International Preliminary Examining Authorities represented at the Meeting preferred the use of additional blank sheets to insert information which was too lengthy for the Form rather than providing more space for such information on the form itself. The Meeting noted an objection of the delegation of Japan concerning the proposed manner of identification of application documents.

38. The Meeting accepted also the proposals of the European Patent Office for page 3 of the said Form (see document PCT/TIM/I/3, Annex/ page 9).

39. In this context, the proposal of the European Patent Office was discussed to include a reasoned statement in the report also where the report was positive with respect to novelty, inventive step and industrial applicability (document PCT/TIM/I/3, page 5, item II, paragraph

2.4). The majority of the participants expressed their agreement whereas several other participants said that it was not useful to give reasons in such a case. It was considered by the majority that such reasoned statements appeared to be of particular usefulness to the applicant himself to facilitate his decision whether or not to continue the procedure in the national phase and to elected Offices not having the necessary infrastructure for a sophisticated examination procedure at their disposal. In this context, particular reference was made to the interest of developing countries.

40. The Meeting considered the Form for a written opinion of the International Preliminary Examining Authority (PCT/IPEA/408), with particular reference to the proposals of the European Patent Office contained in document PCT/TIM/I/3, Annex, page 10. Agreement was reached to recommend to the International Bureau to redraft that Form on the basis of the proposals of the European Patent Office with the proviso that the Form should provide in part VII for the indication of the time limit expressed in "... MONTHS/ ... DAYS". The Meeting noted an objection of the delegation of Japan concerning the proposed manner of identification of application documents. In studying the revision of the Form, the question should also be examined whether the additional space proposed to be provided for in the draft submitted by the European Patent Office could not be saved by providing for an extra sheet which could contain more lengthy information. It was also suggested that the Form should, in an appropriate place in the Notes, contain a warning to the applicant to the effect that he may, under Rules 70.16 and 74, be required to prepare among other things translations of annexes to the international preliminary examination report and that in particular letters submitting amendments may have to be translated *in toto* including matter unrelated to such amendments.

41. With respect to the proposal of the European Patent Office in document PCT/TIM/I/3 to mark Forms used under Chapter II by inserting "PCT-II" or in any other easily visible way facilitating separation of mail upon its arrival at the International Preliminary Examining Authority, it was noted that the International Bureau would study that question further, considering also other means for easy distinction, such as difference in color.

42. The Meeting also considered the proposal by the Swedish Patent Office contained in document PCT/TIM/I/S, item 6, to the effect that it was not appropriate to make use of the possibility of inviting the applicant to pay additional fees under Article 34(3), since the extra effort of judging the patentability of more than one invention was negligible, and that the applicant should be reminded of the possibility of restricting his application in order to comply with Rule 13 without asking for additional fees. The Meeting agreed that the application of that principle would usually lead to a more expedient and economical procedure under Chapter II while preserving the possibility of drawing the attention of elected Offices to the lack of compliance with Rule 13.

Usefulness of International Preliminary Examination Reports for the National Phase

43. During the discussion of that item, it was stated that the international preliminary examination reports were particularly useful for elected Offices, since they facilitated their work and contributed significantly to a highly desirable world-wide standardization of the interpretation of the criteria of patentability. Several participants remarked that, for those reasons, the examiners of their respective Offices were instructed to give full consideration to such report and that the limited experience so far available had already shown a growing confidence of examiners in such reports. It was even more important under Chapter II than under Chapter I to grant certain benefits to the applicants using the procedure under Chapter II and providing international preliminary examination reports to elected Offices, for instance in the way referred to in paragraph 33, above. Only the availability of such benefits would create a sufficiently strong incentive for applicants to use that optional part of the PCT procedure which would in turn be the only possibility of obtaining the advantages inherent in that procedure.

Extension of Time Limit for Establishment of International Preliminary Examination Report and Change of the ProVISION of Rule 70.6 of the Regulations under the PCT

44. Discussions were based on the observations received in response to Circular C. 142/PCT 211 reproduced in documents PCT/TIM/I/7 and 7Add. as well as in the other PCT/TIM/I documents referred to in document PCT/TIM/I/7 and 7Add.

45. The Meeting noted the views of the International Bureau concerning the extension of the time limit for a reply to a written opinion of the International Preliminary Examining Authority under Rule 66.2(d). The Meeting agreed that no amendment was required since the present text of Rule 66.2(d) was flexible enough to give the applicant sufficient time for his reply. The time limit set for the reply to a written opinion could be extended and the Rule did not exclude the fixing- of a second time limit for a further reply.

46. In the course of the discussion of a possible amendment to Rule 69.1(a), the view was expressed that in the majority of the cases the time limit for the establishment of the international preliminary examination report was sufficient to carry out the complete examination and to take into account replies received on written opinions. In this respect it was noted that some International Preliminary Examining Authorities made use of the telephone to clarify rapidly questions arising during examination with the applicant.

47. However, the majority of the participants of the Meeting agreed with the view expressed by the International Bureau that in special cases an extension of the time limit under Rule 69.1(a) could be appropriate. It was proposed that an amendment to Rule 69.1(a) should be considered under a double condition, namely, that the applicant expressly requested extension and that the International Preliminary Examining Authority, on the basis of the reasons put forward by the applicant, thought fit to allow the extension. The delegation of the Soviet Union was of the opinion that any extended time limit under that Rule should not exceed eight months from the start of the international preliminary examination or two months from the expiration of the 25-month time limit provided for in Article 39 (1) (a), whichever time limit expired later. The delegation of Japan felt that the present system was flexible enough to

come in all possible cases to satisfactory results, in particular in view of the interpretation of Rule 66.2(d) referred to in paragraph 45 above.

48. The Meeting invited the International Bureau to further study the question of an amendment to Rule 69.1(a) and to prepare a proposal for consideration by the Assembly of the PCT Union.

49. With respect to the question of a possible amendment to Rule 70.6, the Meeting agreed with the views expressed by the International Bureau that at present no change of this Rule should be considered. The proposal to revise page 3 of the Form PCT/IPEA/409 (International Preliminary Examination Report) referred to under paragraph 38, above, would provide better possibilities for the International Preliminary Examining Authorities to specify, where any of the patentability criteria was not satisfied, why the statement was negative. Rule 70.B and Section 604 of the Administrative Instructions provided a sufficient basis for explanations of the reasons supporting the conclusion that any of the patentability criteria referred to in Article 35(2) were not satisfied. The explanations should be such that, where a claim was patentable only in an amended version, the applicant or the elected Office could easily identify the required amendment, without proposing a revised version of the claim.

TECHNICAL AND PROCEDURAL METHODS RELATED TO THE PUBLICATION OF THE INTERNATIONAL SEARCH REPORT

50. Discussions were based on the memorandum prepared by the International Bureau contained in document PCT/TIM/I/B.

The International Search Report Form: Adequacy of the Present Format, Possible Improvements Thereof

51. The Meeting invited the International Bureau to undertake the study referred to under paragraph 7 of document PCT/TIM/I/B. The Meeting noted that the Patent Offices of Japan and of the Soviet Union would study the feasibility of transliteration to Latin script by them of names and titles in Japanese or cyrillic characters, respectively, contained in the international search report.

52. In the course of the discussions, the view was expressed that the international search report must be easily comprehensible for the reader and that the use of codes should not go too far. Some standardization or codification, however, was felt to be desirable.

53. The delegation of the United States of America declared that the United States Patent and Trademark Office was prepared to accept names and titles of patent documents cited in the international search report without translation. The European Patent Office agreed to contribute to a study concerning the establishment of bilingual versions of the international search report, provided that this was limited to administrative work and would not require translation work to be performed by the search examiners. The delegation of the Soviet Union was of the opinion that the establishment of a bilingual form, in view of its volume,

might lead to a reduction of the work of the International Bureau but not to a reduction of the overall workload under the PCT system.

Observance of the Time Limit for the International Search Report

54. The Meeting noted that the International Searching Authorities would continue to make all possible efforts to establish the international search reports within the time limits under Rule 42. In view of the increasing number of international applications not claiming priority of earlier applications, the 9-month time limit under the said Rule would more frequently apply, thus allowing more time for the establishment of the international search report. In this respect the Meeting agreed with the opinion by the International Bureau that the transmittal of the search copy (which must be effected at the latest on the day of transmittal of the record copy to the International Bureau) must be effected in all cases promptly after receipt of the international application. This meant especially in cases where no priority of an earlier application was claimed, that the transmittal had to take place promptly in the sense of Rule 22.1(a), i.e. long before the expiration of the 13-month time limit under that Rule.

55. The Meeting agreed that it was desirable that the International Searching Authorities inform the International Bureau of cases where the search copy is received from the receiving Office consistently at a time which does not allow a desirable time sequence to be followed, permitting in particular the publication of amendments to the claims together with the international application.

Publication of Abstracts Established by the International Searching Authority

56. The Meeting agreed in principle with the proposal of the International Bureau to amend Form PCT/ISA/205 as reproduced in the Annex to document PCT/TIM/I/8. The Meeting noted that the final text would be established by the International Bureau after having studied the suggestions made by the Delegation of the United States of America concerning the said Form and concerning possible implications and consequential amendments to the Forms PCT/ISA/204 and 210.

Indication of International Patent Classification Symbols

57. The International Searching Authorities, all represented at the Meeting, agreed to take measures to assure a clear, complete and correct indication of IPC classification symbols in the international search report in order to avoid any of the erroneous indications referred to in paragraphs 24 to 27 of document PCT/TIM/I/8.

Drafting of Abstracts

58. The Meeting considered the problems relating to the drafting and translation of abstracts outlined in paragraphs 29 to 34 of document PCT/TIM/I/B. The International Searching Authorities expressed their readiness to cooperate with the International Bureau with a view

to facilitating the publication of abstracts and to improving their quality. They undertook to bring the problems referred to above to the attention of all search examiners.

59. The Meeting noted in this context the view of the International Bureau that no amendment of Rule 8 was desirable. The general understanding referred to above which was reached concerning the said problems should be sufficient to take all the measures required for an improvement of the quality of the abstract. It was understood, however, that it was not possible in all cases to include in the abstract all numerals contained in the figure or drawing accompanying the abstract. The inclusion in the abstract of numerals not contained in such figure or drawing should, however, preferably be avoided.

60. The International Bureau noted the proposal put forward by the European Patent Office to amend Rule 48.2(b) (ii) to the extent that, where no figure was necessary for the understanding of the abstract, the international application should be published without any of the figures or drawings contained in the international application.

CLOSING STATEMENTS

61. At the close of the Meeting, several statements were made by the Chairman, on behalf of the participants, and by the International Bureau, renewing the expression of gratitude to the Japanese Patent Office for the invitation to hold this important and very useful Meeting in Tokyo which could be expected to yield benefits both to the PCT Contracting States and the users of the PCT system. The Conference facilities put at the disposal of the Meeting were excellent, and the Japanese authorities had made an enormous effort in skillful and efficient organization. The many signs of warm hospitality shown by the Japanese Patent Office and by the five Japanese industrial property organizations which had made an important contribution to the program deserved a special word of gratitude and appreciation.

62. Mr. Iwata, Engineer General, Japanese Patent Office, thanked, on behalf of the Japanese Patent Office, the Chairman, all delegations participating in the Meeting and the International Bureau for their contribution. He expressed the expectation that the results of the Meeting would improve the international search and preliminary examination procedure and contribute to the usefulness of the PCT system.

*63. The Meeting adopted this Report
unanimously at its closing session on May 29,
1981.*

[Annexes follow]

LIST OF PARTICIPANTS/
LISTE DES PARTICIPANTS

(in the English alphabetical order of the names of the States)
(dans l'ordre alphabétique anglais des noms des Etats)

I. MEMBER STATES/ETATS MEMBRES

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Mr. J. DELORME (EPO/OEB)

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Mr. B. BARTELS, Head, Legal Section, PCT Division

Mr. A. OKAWA, Counsellor, Examination Section, PCT Division

[Annex II follows/
L'annexe II suit]

PROPOSALS FOR AMENDMENT TO THE ADMINISTRATIVE INSTRUCTIONS

Section 503

Method of Identifying Documents Cited in the
International Search Report

Identification of any document cited in the international search report referred to in Rule 43.5(b) shall be made by indicating the following elements in the order in which they are listed:

(a) In the case of any patent document (patent documents being patents within the meaning of Article 2(ii) as well as published applications relating thereto):

- (i) [no change]
- (ii) [no change]
- (iii) [no change]
- (iv) the name of the patentee or applicant (in capital letters, where appropriate abbreviated);
- (v) the date of publication of the cited patent document as indicated thereon;
and
- (vi) where applicable, the pages, columns or lines where the relevant passages appear, or the relevant figures of the drawings.

(The following example illustrates the citation of a patent document according to paragraph (a) above:

JP, B, 50-24535 (NCR CORPORATION) 28 May 1975 (28.05.75), see column 4, lines 3 to 27).

- (b) [No change]
- (c) [No change]
- (d) [No change]

Section 505

Indication of Citations of Particular Relevance in
the International Search Report

- (a) Where any document cited in the international search report is of particular relevance, the special indication required by Rule 43.5(c) shall consist of the letter(s) “X” and/or “Y” placed next to the citation of the said document.
- (b) Category “X” is applicable where a document is such that when taken alone, a claimed invention cannot be considered novel or cannot be considered to involve an inventive step.
- (c) Category “Y” is applicable where a document is such that a claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.

Section 507

Manner of Indicating Certain Special Categories of
Documents Cited in the International Search Report

- (a) [No change]
- (b) [No change]
- (c) Where any document cited in the international search report is not considered to be of particular relevance requiring the use of categories “X” and/or “Y” but defines the general state of the art, it shall be indicated by the letter “A” placed next to the citation of the said document (see III, 3.14 of the Guidelines for International Search to be Carried Out under the PCT).
- (d) [No change]
- (e) [No change]
- (f) Where in the international search report any document is cited for a special reason, such as:
- documents which may throw doubt on priority claim(s) (see VI, 4.3 of the Guidelines for International Search to be Carried Out under the PCT).
 - Documents cited to establish the publication date of another citation (see VI, 6.2 of the Guidelines for International Search to be Carried Out under the PCT),

such document shall be indicated by the letter “L” next to the citation of the document together with an explanation why that letter is used.

- (g) Where a document is a member of a patent family (see IV, 3.2 of the Guidelines for International Search to be Carried Out under the PCT), it shall, whenever feasible, be mentioned in the international search report in addition to the one cited belonging as well to this family and should be preceded by the sign ampersand (&). A document whose contents has not been verified by the search examiner but is believed to be substantially identical with that of another document which the search examiner has inspected may be cited in the international search report in the above-mentioned manner indicated for patent family members (see VI, 5.2 of the Guidelines for International Search to be Carried Out under the PCT).

[End of document]