

# WIPO



PCT/MIA/10/7

ORIGINAL: English only

DATE: August 5, 2004

WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES  
UNDER THE PATENT COOPERATION TREATY (PCT)

Tenth Session  
Geneva, September 13 to 15, 2004

FORMAT OF REPORTS AND WRITTEN OPINIONS  
UNDER PCT CHAPTERS I AND II

*Document prepared by the International Bureau*

## SUMMARY

1. The Annexes contain a set of example reports and opinions showing, in more detail than in the drafts presented to earlier sessions, how reports and opinions of the International Authorities might be presented in a “linear” format, instead of the traditional “box” format. The Meeting is invited to consider whether this type of format should be adopted as an officially approved alternative to the box format and, if so, how this should be done. The Meeting is also invited to consider how this work should relate to the development of XML standards for reports and written opinions.

## BACKGROUND

2. At its ninth session, in July 2003, the Meeting agreed that the proposed single column “linear” format, as appearing in the Annexes to document PCT/MIA/9/5, was satisfactory, that is:

(a) that the contents should be presented as continuous flow of text in a single column, easily prepared using a basic word processor, rather than using the box format of the Forms shown in Annex A to the Administrative Instructions; and

E

(b) that only text which is relevant to the particular international application appears in each case (in the “box” format shown in the Administrative Instructions, all possibilities are printed and the relevant checkboxes are marked – only if the whole of a page is not relevant is anything missed out).

3. The Meeting further agreed that steps should be taken to develop this proposed format to the stage where it could be promulgated as an officially approved alternative to the traditional box format. It was stated that the text contained in the box version of the Forms should, except where unfeasible, be used in the new format of the Forms.

#### EXAMPLE REPORTS IN SUGGESTED FORMAT

4. The European Patent Office (EPO) has prepared a set of reports and opinions in this style, including as many as possible of the options which exist in the current Forms. These reports and opinions are set out in the Annexes to this document as follows:

Annex I: International Search Report

Annex II: Written Opinion of the International Searching Authority

Annex III: Written Opinion of the International Preliminary Examining Authority

Annex IV: International Preliminary Report on Patentability (Chapter II of the PCT)

5. The EPO has also prepared a provisional set of basic texts from which the standard portions of the Forms would be selected. These are set out in the corresponding annexes of document PCT/MIA/10/7 Add.1.

6. Having regard to these more detailed examples and the basic texts from which the appropriate elements might be selected to form the basis of any particular report or written opinion, it is necessary to confirm whether this approach is still considered appropriate and, if so, to identify what must be done in order to advance this format to the point where it might be adopted as an official alternative to the conventional box format of reports and opinions.

7. It should be emphasized that these are rough draft texts created for the purposes of discussion and identification of the direction and type of further work which may be needed. Consequently, the texts have not been given detailed legal scrutiny. Nor has detailed consideration been given to layout design or to the technical options which may be available and issues which may arise. The technical content is for purposes of illustration, allowing as many as possible of the options available in the standard Forms to be shown, and is not necessarily self-consistent.

#### PROCESSING REPORTS AND OPINIONS

8. A number of actions take place in relation to each report and opinion. It is necessary to consider each of these in order to determine the best means for creation, presentation, transmission, processing and storage of the document. Each document will be subject to some or all of the following actions:

(a) *Preparation*: the examiner must be able to create the document easily and accurately;

(b) *Transmittal*: the International Authority must transmit the document to the applicant and to the International Bureau;

- (c) *Publication*: the International Bureau must publish parts of the international search report along with the international application;
- (d) *Conversion or re-use*: the International Bureau or the International Authority may use, or modify, a written opinion to create an international preliminary report on patentability (or a further written opinion);
- (e) *Translation*: the International Bureau must translate reports into English;
- (f) *Communication*: the International Bureau must communicate reports to designated or elected Offices;
- (g) *Consideration*: the applicant or Office must be able to read and understand the report easily;
- (h) *Availability*: the International Bureau must store the file of the international application and, where appropriate, make documents available to the applicant, Offices or third parties for 30 years from receipt of the record copy.

#### *Some Issues*

9. The proposed new format shown in the Annexes is aimed primarily at addressing issues relating to actions 8(a) and 8(g). It is cumbersome to set up the box style reports, including their checkboxes and standard texts with insertion points, in a conventional word processor of the type with which patent examiners are usually familiar. Consequently, certain Authorities have adopted a two-part type of report, including the standard texts filled out using one system, followed by a reference to attached sheets containing the comments of the examiner. This means that the examiner is required to prepare the report in a cumbersome way and the applicants and Offices receive a report which is not continuous, requiring the reader to flick between different pages to read each section. Clearly, it would be a relatively simple matter for any International Authority to set up a system providing for the creation of reports with an appearance similar to the style shown in the Annexes using their preferred word processor.

#### – *Formats for Storage and Transmission*

10. However, for the other actions indicated, it would be desirable to consider the electronic format which is used to describe and store (and, preferably, transmit) the information in the documents. This may also affect the means by which International Authorities prepare reports and opinions.

11. For the purposes of efficient processing, it would be highly desirable for the documents to be transmitted electronically to the International Bureau (and also, in the future, to applicants who desire that means of communication) in a format which allows the contents to be stored and used effectively. To fit in with the strategy adopted for electronic processing under the PCT in general, this would involve the development of an appropriate XML file format. With suitably defined elements, this would permit effective processing for the purposes described in the following paragraphs, as well as the flexibility to render reports for the applicants and Offices in almost any style which is considered appropriate. This work has begun, with a draft DTD for search reports and international preliminary reports on patentability having been developed by the European Patent Office, the International Bureau,

the Japan Patent Office and the United States Patent and Trademark Office (see document PCT/EF/PFC 04/005).

12. It may be desirable to consider how the development of new standards for file formats should proceed in parallel with developments relating to means of creating and presenting the reports.

– *Publication and Re-use of Information from Documents*

13. A number of actions which take place during the international processing involve the inclusion of part of one document into another. For the International Bureau, the significant issues are the publication of the international search report with the international application, and the establishment of the international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty), which has the same contents as the written opinion of the International Searching Authority. International Authorities also re-use the contents of written opinions in many cases as the basis of either a later written opinion or of the international preliminary examination report.

14. It is usually easy for a person to identify and extract the relevant parts of the earlier document to be included into the later one. However, it is sometime time-consuming, particularly if the document is not available in electronic form, or it has been created using a different system from that in use by the later user. The processing could be made more efficient and the results made more user-friendly if the relevant portions could be extracted automatically and included into the later document without the need to screen off or amend headers and footers from the earlier document.

– *Translation*

15. The mixing of standard and non-standard text in a document which does not automatically distinguish between the two would cause significant difficulties for translation. The system of checkboxes and spaces in the traditional Forms means that the standard text part of the report (which is a very large proportion of the total in most cases) can be translated administratively by transferring the details directly into the equivalent spaces of an English Form. The translators can then concentrate simply on the non-standard text, which is clearly distinguished by its location and style.

16. The presentation of information shown in the Annexes does not distinguish between the standard and non-standard portions. While it may be possible to tag the regions of standard and non-standard text automatically, some consideration will need to be given to how to ensure that the text is not changed from the standard without being marked as such, as well as whether there are ways to ensure that the correct translation can be immediately selected from a number of options which may be quite similar. Assuming that the reports were provided in electronic format, translation assisting software might reduce these difficulties but, at the current state of development, would not eliminate them.

## CONSIDERATIONS OF STYLE

### *Language of Standard Texts*

17. The language of the standard texts which appear in the current Forms was developed for presentation in the form of checkboxes to be ticked or left blank, rather than as standalone

statements which are included only when the relevant situation occurs. Consequently, it has been necessary in some cases for the EPO to adapt the text from that which appears in the printed Forms. As noted above, this has been done for the purposes of illustration and discussion only and has not been subject to detailed legal scrutiny. It will be necessary to consider what further adaptation may be required, or whether the view of earlier meetings that the current text should be followed as closely as possible should be reviewed, to provide text more specifically designed for the new purpose.

### *Defining the Forms*

18. The reports and opinions should maintain a uniform content and appearance, irrespective of the Authority which issues them. The Meeting should indicate the degree of guidance which is appropriate in order to achieve this. For example, would it be sufficient if the “blank Forms” which were provided in the Administrative Instructions were set out in the relevant formats (in a manner similar to that in the Annexes to document PCT/MIA/10/7 Add.1, but without the change in top margin caused by the document header), or should detailed notes and explanations be provided on matters such as fonts, margins and headers? Should Word (or other) templates be provided having all the styles set up appropriately?

19. Other aspects of presentation which may need to be considered include:

(a) whether it is desirable to adopt aspects of appearance which allow the Forms to be immediately identified as PCT Forms, such as a PCT logo on the first page, or boxes around the printed area of the page, similar to that in the conventional Forms (note that this effect can be produced in Word and WordPerfect without the use of tables or frames, for example using the “page border” feature in Word).

(b) are the particular text styles and layouts shown (including font, paragraphs spacing, indentation, bullets, dividing lines and the like) satisfactory for easy production by the Authorities and easy use by the applicant and designated and elected Offices? Would there, for example, be any benefit in presenting the “standard” parts of the text in a different style, so that applicants (and translators) can more easily pick out the arguments specific to the case?

(c) how different portions of the text are numbered, for ease of reference by the applicant when responding, for example:

(i) in written opinions where not all of the sections equivalent to the 8 “Boxes” of the current report are used, should the sections be numbered consecutively according to those which actually appear, or should the same number always refer to the same section? (For example “lack of unity of invention” might always be numbered 4, irrespective of whether sections relating to “priority” and “non-establishment of opinion with regard to novelty, inventive step and industrial applicability” had been included.)

(ii) should paragraph numbering be used?

### MEANS OF ADOPTING NEW STYLE

20. The Forms, including the reports and written opinions of the International Authorities, are defined in Sections 102 and 103, and Annex A of the Administrative Instructions. In

order to formally adopt a new style of Form, modification of the Administrative Instructions seems to be required, if only by extending the Director General's authorization to determine permitted formats for the presentation of Forms as computer printouts under Section 102(i) to Forms other than the request and the demand. Since designated and elected Offices have a direct interest in the use of the reports and written opinions, the Director General would only promulgate the new version following consultation with those Offices in accordance with Rule 89.2.

*21. The Meeting is invited to express an opinion on the development of new formats for reports and opinions under Chapters I and II of the PCT.*

[Annex I follows]

ANNEX I

**PATENT COOPERATION TREATY (PCT)  
INTERNATIONAL SEARCH REPORT (ISR) - PART 1**  
(PCT Article 18 and Rules 43 and 44) - (Form PCT/ISA/210)

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**FOR FURTHER ACTION** See Notification of Transmittal of ISR (Form PCT/ISA/220) as well as, where applicable, abstract information below

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Applicant's or agent's file reference:	AGGR/01/01
International application No:	PCT/EP01/98989
International filing date:	01 April 2001 (01/04/2001)
(Earliest) priority date:	02 April 2000 (01.04.2000)
Applicant:	Heath Robinson

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This international search report has been prepared by this International Searching Authority (ISA) and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

It consists of two parts: Part 1 contains comments on the international application. Part 2 contains the results of the search, the subject matter classification and the fields searched.

It is also accompanied by a copy of each prior art document cited in this report.

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**(1) Basis of the report**

With regard to the **language**, the international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).

With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, and necessary to the claimed invention, the international search was carried out on the basis of:

A sequence listing and table(s) related to the sequence listing;  
in written format and in computer readable form;  
contained in the international application as filed;  
furnished subsequently to this Authority for the purposes of search.

In addition, as more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

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**PATENT COOPERATION TREATY (PCT)**  
**INTERNATIONAL SEARCH REPORT (ISR) - PART 1**  
(PCT Article 18 and Rules 43 and 44) - (Form PCT/ISA/210)

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**(2) Certain claims were found unsearchable**

This report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

Claim(s) No(s): 1,2

because they relate to subject matter not required to be searched by this Authority, namely:

*Claims 1,2 directed to an instruction manual with particular wording are considered to be mere presentations of information and is subject matter the ISA is not required to search under Article 17(2)(a)(i) and Rule 39.1(v).*

Claim(s) No(s): 3,4

because they relate to parts of the international application that do not comply with the prescribed requirements to such an extent that no meaningful international search can be carried out, specifically:

*Claims 3,4 seek protection for a "whatsit" which has no generally-recognised meaning and is undefined in the application as filed.*

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**(3) Unity of invention is lacking**

This International Searching Authority found multiple inventions in this international application, as follows:

- *Claims 1 - 18 directed to a sealing body and an instruction manual for its use*
- *Claim 19 - 28 directed to an apparatus, but not limited to an apparatus comprising the sealing body of claims 3 - 18*

No required additional search fees were timely paid by the applicant. Consequently, this International Search Report is restricted to the invention first mentioned in the claims; it is covered by claims Nos. 3-18

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**(4) Title**

The text is approved as submitted by the applicant.

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**(5) Abstract**

The text is approved as submitted by the applicant.

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**PATENT COOPERATION TREATY (PCT)**  
**INTERNATIONAL SEARCH REPORT (ISR) - PART 1**  
(PCT Article 18 and Rules 43 and 44) - (Form PCT/ISA/210)

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**(6) Drawings**

The figure of the drawings to be published with the abstract is Figure No: **1** as suggested by the applicant.

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**\*\* End of Part 1 of the ISR \*\***

**PATENT COOPERATION TREATY (PCT)**  
**INTERNATIONAL SEARCH REPORT (ISR) - PART 2**  
(PCT Article 18 and Rules 43 and 44) - (Form PCT/ISA/210)

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(21) **International application No.:** PCT/EP01/98989

(51) **CLASSIFICATION OF SUBJECT MATTER**

**IPC<sup>7</sup>:** G06K11/14

(58) **FIELDS SEARCHED**

**Minimum documentation searched:**

**IPC<sup>7</sup>:** G06K

**Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched:**

Not applicable

**Electronic database consulted during the international search:**

EPO-Internal, PAJ, WPI Data

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**DOCUMENTS CONSIDERED TO BE RELEVANT**

(Citation of document, with indication, where appropriate, of the relevant passage(\*), followed by category and claim(s) No(s))

(1) US 5 332 238 A (BORUCKI G) 26 July 1994; cited in the application

*\*column 2, line 1-27; figures 4,5\**

Category: **Y** Claims: **1,6,7,9**

*\*column 7, line 32-55\**

Category: **X** Claims: **18**

(2) US 5 784 054 A (KENT JOEL C ET AL) 21 July 1998; cited in the application

*\*column 6, line 61-65; figures 1,2,4,8, column 7, line 35-65\**

Category: **X** Claims: **1,6,7,14,15,18**

(3) US 4 816 811 A (BOGATIN ERIC L ET AL) 28 March 1989

*\*column 4, line 57,58; figures 2-4\**

Category: **A** Claims: **1,9**

(4) EP 0 740 264 A (GORE & ASS) 30 October 1996

*\*column 8, line 7-10; figure 1; column 9, line 18-column 13, line 8\**

Category: **Y** Claims: **1,6,7,9**

Category: **A** Claims: **2, 18**

**PATENT COOPERATION TREATY (PCT)**  
**INTERNATIONAL SEARCH REPORT (ISR) - PART 2**  
(PCT Article 18 and Rules 43 and 44) - (Form PCT/ISA/210)

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(5) WO 98 52184 A (ELO TOUCHSYSTEMS INC) 19 November 1998

*\*page 21, line 9-1; figures 5,6\**

Category: **A**      Claims: **1, 18**

(6) US 5 852 433 A (TODA KOHJI) 22 December 1998

*\*column 6, line 20-28; figure 1\**

Category: **A**      Claims: **1, 18**

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Special categories of cited documents:

A: document defining the general state of the art which is not considered to be of particular relevance.

X: The claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone.

Y: The 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.

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**Patent family information**

\* **US 4 816 811 A:**

EP 0 196 186	A,B	01.10.1986
JP 61223932	A	04.10.1986
US 4 816 811	A	28.03.1989
CA 1 270 309	A	12.06.1990
DE 3 682 927	D	30.01.1992
KR 9 309 671	B	08.10.1993

\* **EP 0 740 264 A:**

JP 9044291	A	14.02.1997
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\* **WO 98 52184 A:**

AU 7 151 098	A	08.12.1998
JP 11065765	A	09.03.1999
EP 1 019 897	A	19.07.2000
BR 9 809 121	A	01.08.2000
CN 1 269 043	T	04.10.2000
AU 732877	B	03.05.2001
US 6 236 391	B	22.05.2001

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**PATENT COOPERATION TREATY (PCT)**  
**INTERNATIONAL SEARCH REPORT (ISR) - PART 2**  
(PCT Article 18 and Rules 43 and 44) - (Form PCT/ISA/210)

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**ISA/Examiner:** European Patent Office  
SPIGARELLI, Alfred  
PB 5818, Patentlaan 2  
NL 2280 HV Rijswijk  
Tel. +31 - 70 340 2040  
Fax. +31 - 70 340 3016

Search completed: 24 July 2001  
ISR mailed: 28 July 2001

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**\*\* End of the ISR \*\***

[Annex II follows]

ANNEX II

**PATENT COOPERATION TREATY (PCT)**  
**WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY**  
(PCT Rule 43bis.1) - (Form PCT/ISA/237)

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International application No: PCT/EP2004/989898  
International filing date: 01 April 2004 (01/04/2004)  
Priority date: 02 April 2003 (02/04/2003)  
International Patent Classification (IPC)  
or national classification and IPC: G06K11/14

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**This opinion contains indications relating to:**

- Basis of the opinion
- Priority
- Non-establishment of opinion with regard to novelty, inventive step or industrial applicability
- Lack of unity of invention
- Reasoned statement with regard to novelty, inventive step or industrial applicability
- Certain documents cited
- Certain defects in the international application
- Certain observations on the international application

**FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered. If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of this opinion or before the expiration of 22 months from the priority date, whichever expires later.

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**(1) Basis of the opinion**

This opinion has been established on the basis of a translation from the original language into *English*, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).

With regard to any nucleotide and/or amino acid sequence disclosed in the international application, and necessary to the claimed invention, the international search was carried out on the basis of:

A sequence listing and table(s) related to the sequence listing;  
in written format and in computer readable form;  
contained in the international application as filed;

**PATENT COOPERATION TREATY (PCT)**  
**WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY**  
(PCT Rule 43bis.1) - (Form PCT/ISA/237)

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furnished subsequently to this Authority for the purposes of search.

In addition, as more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

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**(2) Priority**

The following document has not yet been furnished:

Copy of the earlier application whose priority has been claimed (Rules 43bis.1 and 66.7(a)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date is the claimed priority date.

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**(3) Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

The question whether the claimed invention appears to be novel, to involve an inventive step or to be industrially applicable have not been examined in respect of claims Nos. 1, 2, 17, 18 because:

Said claims Nos. 17, 18 are so inadequately supported by the description that no meaningful opinion could be formed.

No ISR has been established for said claims Nos. 1, 2.

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**(4) Lack of unity of invention**

The requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is not complied with for the reasons given in the ISR. In response to the invitation to pay additional fees due for searching under Article 17(3)(a), the applicant has not paid additional fees. Consequently, this opinion has been established in respect of the parts of the international application relating to claims 3- 16.

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**(5) Novelty, Inventive step and industrial applicability**

Novelty (N):	Claim(s) 3-15	Yes
	Claim(s) 16	No
Inventive Step (IS):	Claim(s) 8, 10-12	Yes
	Claim(s) 3-7, 9, 14-16	No

**PATENT COOPERATION TREATY (PCT)**  
**WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY**  
(PCT Rule 43*bis*.1) - (Form PCT/ISA/237)

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Industrial Applicability (IA):                      Claim(s) 3-16    Yes

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**INDEPENDENT CLAIM 3**

Document US-A-5 332 238, which is considered to represent the most relevant state of the art, discloses (cf. relevant passages indicated in the ISR) a device from which the subject-matter of independent claim 3 differs in that the elongate sealing body is an elongate gel body.

The problem to be solved by the present invention may therefore be regarded as finding a suitable material for making the elongate sealing body.

The solution proposed in claim 3 of the present application cannot be considered as involving an inventive step (Article 33(3) PCT) for the following reasons:

EP-A-0 740 264 (cf. relevant passages indicated in the ISR), discloses such a sealing body comprising a silicone elastomer, namely a sealing body made of a composition comprising a gel.

**INDEPENDENT CLAIM 15**

Document US-A-5 332 238 (cf. relevant passages indicated in the ISR) discloses in combination all the features defined in independent claim 15.

Therefore the subject matter of this claim is not new (Article 33(2) PCT).

**DEPENDENT CLAIMS**

The following dependent claims do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step:

The additional features of claims 4, 5 and 9 are known from document EP-A-0 740264 (cf. relevant parts indicated in the ISR);

the additional features of claims 6 and 7 are already disclosed in US-A-5 332 238 (cf. relevant passages indicated in the ISR);

dependent claims 14 and 16 define slight constructional details of the arrangement of the independent claim to which they refer.

The additional features of dependent claims 8 and 10-12 are neither disclosed nor suggested by any one of the available prior art documents. Therefore, a combination of at least one of these claims with the claims to which they refer could be considered as novel and inventive.

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**PATENT COOPERATION TREATY (PCT)**  
**WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY**  
(PCT Rule 43bis.1) - (Form PCT/ISA/237)

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**(6) Certain documents cited**

Certain published documents (Rules 43bis.1 and 70.10)

Application No. Patent No.	Publication date (day/month/year)	Filing date (day/month/year)	Priority date (valid claim) (day/month/year)
GB-A- 3 999 999	06.07.2004	07.10.2003	08.11.2002

Non-written disclosures (Rules 43bis.1 and 70.9)

Kind of non-written disclosure	Date of non-written disclosure (day/month/year)	Date of written disclosure referring to non-written disclosure (day/month/year)
Conference presentation	20.01.1999	03.03.2000

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**(7) Certain defects in the international application**

D1 has not been identified in the description nor has the background art disclosed therein been discussed. The requirements of Rule 5.1(a)(ii) PCT are thus not met.

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**(8) Certain observations on the international application**

Reference signs in parentheses should have been inserted in the claims to increase their intelligibility, Rule 6.2 (b) PCT. This applies to both the preamble and characterising portion.

The expression "toggle floggle" used throughout the claims and description is unclear (Article 6 PCT).

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**ISA** European Patent Office  
D-80298 Munich  
Tel: +49 89 2399-0  
Fax: +49 89 2399-4465

**Examiner:** Twist, Oliver

Date of completion of this written opinion:

30 August 2001

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**\*\* End of the Written Opinion\*\***

[Annex III follows]



ANNEX III

**PATENT COOPERATION TREATY (PCT)**  
**WRITTEN OPINION OF THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY**  
(PCT Rule 66) - (Form PCT/IPEA/408)

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Date of mailing (*day/month/year*) 15/03/2001

**REPLY DUE** within 2 months from the above date of mailing

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Applicant's or agent's file reference:	AGGR/01/94
International application No:	PC <del>7</del> EP01/98989
International filing date:	01 April 2001 (01/04/2001)
Priority date:	02 April 2000 (02/04/2000)
International Patent Classification (IPC) or national classification and IPC:	G01N33/569
Applicant:	Heath Robinson

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The written opinion established by the International Searching Authority:  
is considered to be a written opinion of the International Preliminary Examining Authority.

This second opinion contains indications relating to the following items:

- Basis of the opinion
- Priority
- Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- Lack of unity of invention
- Reasoned statement with regard to novelty, inventive step or industrial applicability
- Certain documents cited
- Certain defects in the international application
- Certain observations on the international application

The applicant is hereby **invited to reply** to this opinion.

**When?** See the time limit indicated above. The applicant, may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(e).

**How?** By submitting a written reply, accompanied, where appropriate, by amendments according to Rule 66.3. For the form and language of the amendments, see Rules 66.8 and 66.9.

**Also** For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4*bis*. For an informal communication with the examiner, see Rule 66.6.  
For an additional opportunity to submit amendments, see Rule 66.4.

**PATENT COOPERATION TREATY (PCT)**  
**WRITTEN OPINION OF THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY**  
(PCT Rule 66) - (Form PCT/IPEA/408)

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**If no reply is filed**, the international preliminary examination report will be established on the basis of this opinion

The final date by which the international preliminary report on patentability (Chapter II of the PCT) must be established according to Rule 69.2 is: **02 August 2002**.

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**(1) Basis of the opinion**

With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

This opinion is based on a translation from the original language into English, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).

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With regard to the elements of the international application, this opinion has been established on the basis of *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed")*:

The description, pages	
1-15, 17-21	as originally filed/furnished
16	received by this Authority on 02.01.2002

The claims, Nos.	
1-11	as originally filed/furnished
12-16	received by this Authority on 02.01.2002

The drawings, sheets/figs.	
1/2-2/2	received by this Authority on 02.01.2002

The amendments have resulted in the cancellation of:  
the description, pages 22-24  
the claims, Nos. 17, 18

---

This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)):

The following amendments are contrary to the provisions of Article 34(2)(b):

- (i) The range of values given on page 16 for the length of the cutting edge was not disclosed in the application as filed;
  - (ii) An essential feature of the invention, present in all the originally filed independent claims, relating to the gripping part of the knife, has been omitted from the latest filed claims.
-

**PATENT COOPERATION TREATY (PCT)**  
**WRITTEN OPINION OF THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY**  
(PCT Rule 66) - (Form PCT/IPEA/408)

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With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion was established on the basis of:

a sequence listing, table(s) related to the sequence listing;  
in written format, in computer readable form;  
filed together with the international application in computer readable form;  
furnished subsequently to this Authority for the purposes of search and/or examination.

In addition, as more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

---

**(2) Priority**

The following document has not yet been furnished:

Copy of the earlier application whose priority has been claimed (Rule 66.7(a)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date is the claimed priority date.

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**(3) Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

The question whether the claimed invention appears to be novel, to involve an inventive step or to be industrially applicable have not been examined in respect of claims Nos. 1, 2, 17, 18 because:

Said claims Nos. 17, 18 are so inadequately supported by the description that no meaningful opinion could be formed.

No ISR has been established for said claims Nos. 1, 2.

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**(4) Lack of unity of invention**

The requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is not complied with for the reasons given in the ISR. In response to the invitation to pay additional fees due for searching under Article 17(3)(a), the applicant has not paid additional fees. Consequently, this opinion has been established in respect of the parts of the international application relating to claims 3- 16.

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**PATENT COOPERATION TREATY (PCT)**  
**WRITTEN OPINION OF THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY**  
(PCT Rule 66) - (Form PCT/IPEA/408)

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**(5) Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

Novelty (N):	Claim(s) 3-15	Yes
	Claim(s) 16	No
Inventive Step (IS):	Claim(s) 8, 10-12	Yes
	Claim(s) 3-7, 9, 14-16	No
Industrial Applicability (IA):	Claim(s) 3-16	Yes

---

**INDEPENDENT CLAIM 3**

Document US-A-5 332 238, which is considered to represent the most relevant state of the art, discloses (cf. relevant passages indicated in the ISR) a device from which the subject-matter of independent claim 3 differs in that the elongate sealing body is an elongate gel body.

The problem to be solved by the present invention may therefore be regarded as finding a suitable material for making the elongate sealing body.

The solution proposed in claim 3 of the present application cannot be considered as involving an inventive step (Article 33(3) PCT) for the following reasons:

EP-A-0 740 264 (cf. relevant passages indicated in the ISR), discloses such a sealing body comprising a silicone elastomer, namely a sealing body made of a composition comprising a gel.

**INDEPENDENT CLAIM 15**

Document US-A-5 332 238 (cf. relevant passages indicated in the ISR) discloses in combination all the features defined in independent claim 15.

Therefore the subject matter of this claim is not new (Article 33(2) PCT).

**DEPENDENT CLAIMS**

The following dependent claims do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step:

The additional features of claims 4, 5 and 9 are known from document EP-A-0 740264 (cf. relevant parts indicated in the ISR);

the additional features of claims 6 and 7 are already disclosed in US-A-5 332 238 (cf. relevant passages indicated in the ISR);

**PATENT COOPERATION TREATY (PCT)**  
**WRITTEN OPINION OF THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY**  
(PCT Rule 66) - (Form PCT/IPEA/408)

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dependent claims 14 and 16 define slight constructional details of the arrangement of the independent claim to which they refer.

The additional features of dependent claims 8 and 10-12 are neither disclosed nor suggested by any one of the available prior art documents. Therefore, a combination of at least one of these claims with the claims to which they refer could be considered as novel and inventive.

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**(6) Certain documents cited**

Certain published documents (Rules 43*bis*.1 and 70.10)

Application No. Patent No.	Publication date (day/month/year)	Filing date (day/month/year)	Priority date (valid claim) (day/month/year)
GB-A- 2 999 999	06.07.1993	07.10.1992	08.11.1991

Non-written disclosures (Rules 43*bis*.1 and 70.9)

Kind of non-written disclosure	Date of non-written disclosure (day/month/year)	Date of written disclosure referring to non-written disclosure (day/month/year)
Conference presentation	20.01.1999	03.03.2000

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**(7) Certain defects in the international application**

D1 has not been identified in the description nor has the background art disclosed therein been discussed. The requirements of Rule 5.1(a)(ii) PCT are thus not met.

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**(8) Certain observations on the international application**

Reference signs in parentheses should have been inserted in the claims to increase their intelligibility, Rule 6.2 (b) PCT. This applies to both the preamble and characterising portion.

The expression "toggle floggle" used throughout the claims and description is unclear (Article 6 PCT).

The subject-matter of Claim 5 in combination with that of Claim 3 would therefore appear to meet the requirements of Articles 33(2) and 33(3) PCT.

Claims 6-8 contain modifications of the inventive idea embodied in the combination of Claims 3 and 5 and also meet the requirements of Articles 33 (2) and 33 (3) PCT.

The method of sharpening knives claimed in Claim 9 is based on US-A-1 111 111 as nearest prior art. Compared with this known method the angle of the grinding wheel is controlled between limits by a control unit which measures various parameters during the grinding operation. No prior art document gives a lead to these features: Claim 10 contains a minor modification of the inventive idea of Claim 9.

**PATENT COOPERATION TREATY (PCT)**  
**WRITTEN OPINION OF THE INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY**  
(PCT Rule 66) - (Form PCT/IPEA/408)

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**Examiner:**              Twist, Oliver

Date of submission of the demand:                      30 November 2001

Date of completion of this report:                      12 March 2002

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**\*\* End of the Written Opinion \*\***

[Annex IV follows]

ANNEX IV

**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY  
(Chapter II of the Patent Cooperation Treaty)**

(PCT Article 36 and Rule 70) - (Form PCT/IPEA/409)

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**FOR FURTHER ACTION** See Form PCT/IPEA/416

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Applicant's or agent's file reference:	AGGR/01/94
International application No:	PCT/EP01/98989
International filing date:	01 April 2001 (01/04/2001)
Priority date:	02 April 2000 (02/04/2000)
International Patent Classification (IPC) or national classification and IPC:	G01N33/569
Applicant:	Heath Robinson

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This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.

This REPORT consists of a total of 4 sheets, including this cover sheet.

This report is also accompanied by ANNEXES, comprising:

*(sent to the applicant and to the International Bureau)* a total of 12 sheets, as follows:

sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions);

sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated under (1);

*(sent to the International Bureau only)* a total of 4 CD-R, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).

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**This report contains indications relating to:**

- Basis of the opinion
- Priority
- Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- Lack of unity of invention

**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**  
**(Chapter II of the Patent Cooperation Treaty)**

(PCT Article 36 and Rule 70) - (Form PCT/IPEA/409)

- 
- Reasoned statement with regard to novelty, inventive step or industrial applicability
  - Certain documents cited
  - Certain defects in the international application
  - Certain observations on the international application
- 

**(1) Basis of the report**

With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.

This report is based on a translation from the original language into English, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).

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With regard to the elements of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed")*:

The description, pages

1-15, 17-21

as originally filed/furnished

16

received by this Authority on 02.01.2002

The claims, Nos.

1-11

as originally filed/furnished

12-16

received by this Authority on 02.01.2002

The drawings, sheets/figs.

1/2-2/2

received by this Authority on 02.01.2002

The amendments have resulted in the cancellation of:

the description, pages 22-24

the claims, Nos. 17, 18

---

This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)):

The following amendments are contrary to the provisions of Article 34(2)(b):

(i) The range of values given on page 16 for the length of the cutting edge was not disclosed in the application as filed;

(ii) An essential feature of the invention, present in all the originally filed independent claims, relating to the gripping part of the knife, has been omitted from the latest filed claims.

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**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**  
**(Chapter II of the Patent Cooperation Treaty)**

(PCT Article 36 and Rule 70) - (Form PCT/IPEA/409)

---

With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion was established on the basis of:

a sequence listing, table(s) related to the sequence listing;  
in written format, in computer readable form;  
filed together with the international application in computer readable form;  
furnished subsequently to this Authority for the purposes of search and/or examination.

In addition, as more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

---

**(2) Priority**

This report has been established as if no priority had been claimed due to the failure to furnish within the prescribed time limit the requested copy of the earlier application whose priority has been claimed (Rule 66.7(a)).

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**(3) Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

The question whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been examined in respect of claims Nos. 1, 2 because:

The subject-matter of claims 1, 2 does not require an international preliminary examination with respect to industrial applicability as it is directed to a method of treatment by surgery (Article 34(4)(a)(i), Rule 67.1 (iv)).

---

**(4) Lack of unity of invention**

The applicant has paid additional fees in response to the invitation to restrict or pay additional fees.

This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is not complied with for the following reasons:

- (i) Claims 3-8 relate to a surgical knife.
- (ii) Claims 9, 10 relate to a method of sharpening knives and are not restricted to the type of knife claimed in Claim 3.

Consequently, the parts of the international application relating to claims 3 - 8 were the subject of international preliminary examination in establishing this report.

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**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY  
(Chapter II of the Patent Cooperation Treaty)**

(PCT Article 36 and Rule 70) - (Form PCT/IPEA/409)

---

**(5) Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

Novelty (N):	Claim(s) 4, 5, 6-8, 9-10	Yes
	Claim(s) 3	No
Inventive Step (IS):	Claim(s) 5, 6-8, 9-10	Yes
	Claim(s) 3, 4	No
Industrial Applicability (IA):	Claims 3-10	Yes

---

A surgical knife for use in making incisions is disclosed in US-A-9 999 999 (hereinafter referred to as document 1) comprising the following features:

A, B, C - see column 1, lines 20-55 and Figures 2,3.

D, E - see column 3, lines 70-110 and Figure 4.

The subject-matter of Claim 3 does not therefore meet the requirements of Article 33 (2) of the PCT.

The additional features of Claim 4 are already known from DE-A-0 000 000 (document 2). Moreover the reasons why those features are used in the knife disclosed in that document are identical to the present application. The adoption of these features in the knife disclosed in document 1 is therefore obvious for the skilled man. The subject-matter of Claim 4 is accordingly lacking inventive step contrary to Article 33 (3) PCT.

None of the available prior art discloses the features claimed in Claim 5. Moreover, these features achieve the result of achieving a more precise incision than was hitherto possible using existing knives.

The subject-matter of Claim 5 in combination with that of Claim 3 would therefore appear to meet the requirements of Articles 33(2) and 33(3) PCT.

Claims 6-8 contain modifications of the inventive idea embodied in the combination of Claims 3 and 5 and also meet the requirements of Articles 33 (2) and 33 (3) PCT.

The method of sharpening knives claimed in Claim 9 is based on US-A-1 111 111 as nearest prior art. Compared with this known method the angle of the grinding wheel is controlled between limits by a control unit which measures various parameters during the grinding operation. No prior art document gives a lead to these features: Claim 10 contains a minor modification of the inventive idea of Claim 9.

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**Examiner:**              Twist, Oliver

**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY  
(Chapter II of the Patent Cooperation Treaty)**

(PCT Article 36 and Rule 70) - (Form PCT/IPEA/409)

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Date of submission of the demand: 30 November 2001

Date of completion of this report: 12 March 2002

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**\*\* End of the IPER \*\***

[End of Annex IV and of document]