

# WIPO



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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)**

**MEETING OF INTERNATIONAL AUTHORITIES  
UNDER THE PCT**

**Sixth Session  
Canberra, February 17 to 21, 1997**

REPORT

*adopted by the Meeting*

## INTRODUCTION

1. The Meeting of International Authorities under the PCT (hereinafter referred to as “the Meeting”) held its sixth session in Canberra from February 17 to 21, 1997.
2. The following nine International Authorities were represented at the session: the Australian Industrial Property Organisation, the Austrian Patent Office, the Chinese Patent Office, the European Patent Office, the Japanese Patent Office, the Russian Agency for Patents and Trademarks, the Swedish Patent Office and the United States Patent and Trademark Office, in their capacities as International Searching Authorities and International Preliminary Examining Authorities, and the Spanish Patent and Trademark Office in its capacity as an International Searching Authority.
3. The list of participants is contained in Annex I to this report.

## OPENING OF THE SESSION

4. Mr. Busso Bartels (Director, PCT Sector), on behalf of the Director General of WIPO, opened the session and welcomed the participants, thanking the Director General of the Australian Industrial Property Organisation for hosting the session.

## ELECTION OF A CHAIRMAN

5. The Meeting unanimously elected Mr. Bruce Murray (Commissioner of Patents and Registrar of Designs, Australian Industrial Property Organisation) as Chairman.

## ADOPTION OF THE AGENDA

6. The Meeting adopted the agenda appearing in Annex II to this report.

7. The Meeting agreed that this report\* would contain only conclusions and decisions.

## POSSIBLE MODIFICATIONS OF THE PCT SEARCH GUIDELINES

8. Discussion was based on document PCT/MIA/VI/2.

9. The Meeting agreed that the PCT Search Guidelines should be modified along the lines of the proposed modifications contained in Annex III to this report, with the understanding that further changes of an editorial nature would be proposed by the International Bureau and submitted for consultation with the International Searching Authorities before promulgation of the modifications.

10. The Meeting agreed that modification of the Guidelines required consensus among the International Searching Authorities.

11. The Meeting agreed that the explanation of the nature of the PCT Search Guidelines should be adapted to the corresponding explanation in the PCT Preliminary Examination Guidelines, taking into account the modifications made to Chapter I, paragraph 3.3, of the latter (see paragraph 14, below), by replacing paragraphs 1 to 3 of Chapter I of the PCT Search Guidelines with the following two paragraphs, and renumbering paragraphs 4 and 5 accordingly:

“1. The Guidelines give instructions as to the practice to be followed in the various stages of the international searching of international applications. They are addressed to the examiners in the various International Searching Authorities but it is hoped that they will also be of assistance to applicants and patent practitioners. Furthermore, the Guidelines may be useful to the patent Offices of the designated States in the national phase in the searching and examination of the international application and in better understanding the international search report. Although the Guidelines deal with international applications, they may be used *mutatis mutandis* by national Offices in dealing with national applications if the national law so permits; also they may be used in revising national laws with the purpose of unification of current practices in patent Offices of various countries.

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\* References in this report to “Articles,” “Rules,” “Sections” and “Forms” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”), of the Administrative Instructions under the PCT (“the Administrative Instructions”) and of the Forms annexed to the Administrative Instructions, or of those provisions as proposed to be amended, as the case requires.

“2. These Guidelines are common rules of international search and assist in the application of the provisions of the PCT, PCT Regulations and PCT Administrative Instructions relating to international search. They are intended to cover typical occurrences. They should therefore be considered only as general directives; examiners will have to go beyond the instructions in exceptional cases. Nevertheless, applicants can expect the International Searching Authorities to act, as a general rule, in accordance with the Guidelines until such time as they are revised. It should be noted also that the Guidelines do not have the binding authority of a legal text. These Guidelines have been designed to assist International Searching Authorities in establishing an international search report in accordance with PCT Articles 17 and 18. For the ultimate authority on questions concerning international search, it is necessary to refer to the PCT itself interpreted, where necessary, by reference to the Minutes of the Washington Diplomatic Conference and interpretations given by the PCT Assembly. Any failure of an International Searching Authority to follow these Guidelines would not of itself constitute a basis for review of the action of the Authority except where such review is provided for under the applicable national law and practice.”

#### PROPOSED MODIFICATIONS OF THE PCT PRELIMINARY EXAMINATION GUIDELINES AND PROPOSED AMENDMENTS OF PCT RULES 64 AND 70.10

12. Discussions were based on document PCT/MIA/VI/6.

13. The Meeting agreed that modification of the Guidelines required consensus among the International Preliminary Examining Authorities.

14. The Meeting agreed to the proposed modifications of the PCT Preliminary Examination Guidelines set out in Annex I to document PCT/MIA/VI/6, subject to the following observations and further changes:

(a) In Chapter I, paragraph 3.1 should be deleted and the remaining paragraphs renumbered accordingly.

(b) In Chapter I, renumbered paragraph 3.2, the first sentence should be deleted and replaced by: “These Guidelines are common rules of international preliminary examination and assist in the application of the provisions of the PCT, PCT Regulations and PCT Administrative Instructions relating to international preliminary examination. They are intended to cover typical occurrences.”

(c) In Chapter I, renumbered paragraph 3.2, the last sentence as proposed to be inserted should be modified to read: “Any failure of an International Preliminary Examining Authority to follow these Guidelines would not of itself constitute a basis for review of the action of the Authority except where such review is provided for under the applicable national law and practice.”

(d) In Chapter II, paragraph 4.4, the third sentence should be amended to read: “The insertion into the statement of prior art of references to documents identified subsequently, for example by the search report, may be appropriate provided that the amendment would not go beyond the disclosure in the international application as filed.”

(e) Chapter III, paragraph 4.9 should not be modified, but the following footnote should be added at the end of the first sentence of that paragraph: “However, it should be noted that, in the national phase in the United States of America, ‘use of’ claims are considered for the purposes of the national law to be improper process claims which lack clarity and constitute excluded subject matter.”

15. The Meeting agreed to the proposed amendments of Rules 64 and 70.10 set out in Annex II to document PCT/MIA/VI/6, subject to the following observations and further changes:

(a) The Meeting noted that proposed new Rule 64.4 reflected the content of Article 33(6), second sentence.

(b) The Meeting noted that proposed new Rule 64.4 would provide for the citation, for example, of documents relevant to the issue of industrial applicability published after the relevant date, of documents which did not themselves qualify as citations but which included hearsay references to prior disclosures which were not otherwise documented, and of documents resulting from double patenting.

(c) The Meeting agreed that Rule 70.10(a) should be amended to read as follows:

“Any published application or any patent referred to in the report by virtue of Rule 64.3 shall be mentioned as such and shall be accompanied by an indication of its date of publication, of its filing date, ~~and~~ of its claimed priority date (if any), and by an explanation as to its relevance. In respect of the priority date of any such document, the report may indicate that, in the opinion of the International Preliminary Examining Authority, such claimed priority is not valid ~~date has not been validly claimed.~~”

#### ESTABLISHMENT OF A UNIFORM STANDARD FOR THE PRESENTATION OF NUCLEOTIDE AND/OR AMINO ACID SEQUENCE LISTINGS IN INTERNATIONAL APPLICATIONS

16. Discussion was based on document PCT/MIA/VI/15.

17. The Meeting agreed with the general approach taken in the draft standard for the presentation of sequence listings contained in the Annex to that document, which draft was under consideration by the European Patent Office, the Japanese Patent Office and the United States Patent and Trademark Office in the course of their trilateral cooperation, and suggested the following changes:

(a) In paragraph 1, first sentence, the reference to national and regional patent applications should be deleted. In the second sentence, the reference to WIPO Standards ST.23 and ST.24 should be deleted. In the third and fourth sentences, the references to particular media (“both on paper and on electronic data carrier” and “on paper and in machine

readable form”) should be deleted. The last sentence should be amended to read: “... to make for easier presentation of sequences for the benefit of applicants, examiners and the public, ...”

(b) In paragraph 2(i), first line, “separate” should be deleted. Paragraph 2(ii) should be amended to specifically exclude from the standard sequences with fewer than four specifically defined nucleotides or amino acids.

(c) Throughout paragraph 5, “should” should be replaced by “shall.” In the same paragraph, in order to avoid the inclusion of language-dependent text, a language-neutral code should be established to replace the indication “This sequence is omitted” where no sequence is present for a given integer identifier.

(d) The last sentence of paragraph 10 should be deleted.

(e) In paragraph 15, “the maximum of 15” should be replaced by “the maximum of 16.”

(f) In paragraph 23, third line, “equivalent” should be replaced by “corresponding.”

(g) In paragraph 33, second line, the maximum number of lines allowed for free text should be changed to 4.

(h) Paragraphs 37 and 42 should be revised to reflect the requirement that a listing on diskette or other electronic medium complying with the standard must be accepted not only by the International Searching Authority during the international phase but also by designated/elected Offices during the national phase.

(i) Concerning the inclusion in sequence listings of language-dependent data elements, the Meeting agreed that it would be desirable to avoid, if possible, the mandatory inclusion of data element <120> “Title of invention” (see paragraph 24). In any event, the standard should envisage the possibility (to be dealt with in the Regulations) that any language-dependent text in a sequence listing, including data elements <120> “Title of Invention” and data element <223> “Other information” (see paragraphs 28, 34 and 35), be permitted, for the purposes of both the international phase and the national phase, to be in English, whatever language may be used in the body of the description, possibly with a requirement in such a case for the language-dependent text concerned to appear also in the body of the description in the language thereof.

(j) Throughout the standard, references to codes set out in Annex 2 should also refer to the applicable tables contained in that Annex.

(k) Throughout the Standard, “typed” should be replaced by a term applicable to other means of presenting indications in the sequence listing on paper or in machine readable form.

18. The Authorities exchanged views about the desirability of requesting the applicant to submit to Authorities alleged prior art sequence information in machine readable form which so far is not available to them in such form. Noting that the PCT generally does not provide for the furnishing of alleged prior art information, the Meeting agreed that the introduction of such

a requirement, while it may be enforced under national law during the national phase procedure, would burden and slow down the procedure during the international phase and would thus not be desirable.

19. The Meeting agreed that the International Bureau should further revise the draft standard in consultation with the European Patent Office, the Japanese Patent Office and the United States Patent and Trademark Office, with the aim of finalizing a draft for consultation with all Authorities in the first half of 1997. The Meeting agreed on the need for a transition period before the standard, once agreed upon, should enter into force so to ensure enough time available for national Offices to finalize the setting up of appropriate receiving systems. The standard would be submitted to the WIPO Permanent Committee on Industrial Property Information for its consideration when revising Standards ST.23 and ST.24.

#### INTERNATIONAL SEARCH AND INTERNATIONAL PRELIMINARY EXAMINATION OF INTERNATIONAL APPLICATIONS CONTAINING LARGE NUMBERS OF SEQUENCE LISTINGS; PROPOSED MODIFICATIONS OF THE PCT ADMINISTRATIVE INSTRUCTIONS

20. Discussion was based on documents PCT/MIA/VI/9 and 10.

21. The Meeting noted that the United States Patent and Trademark Office as International Searching Authority had, after consultation with the industry concerned, established a practice (see the Annex to document PCT/MIA/VI/9) for the searching of international applications claiming large numbers of nucleotide sequences. In such cases, the Office would carry out the international search while limiting the number of additional search fees required to be paid by the applicant. The basis of the practice was related to the reasonableness of the number and size of the sequences claimed, the *prima facie* rule being that the international search fee would cover the first ten sequences claimed and an additional search fee would be required for each subsequent group of four sequences. The Office explained that where ten nucleotide sequences were claimed, there was usually a finding of lack of unity of invention. The Office noted that international applications claiming amino acid sequences had not so far raised problems because of large numbers of sequences claimed.

22. Some Authorities felt that ten or more nucleotide sequences claimed would, in many cases, fulfill the PCT criteria for unity of invention. To cope with large numbers of sequences claimed, the existing wording of the PCT Search Guidelines (notably, in Chapter VII, paragraphs 11 and 12) enabled them, where unity of invention was lacking, to exercise sufficient flexibility to choose to reduce the number of additional fees charged.

23. The Meeting noted that, in general, a high degree of complexity of the subject matter of an application, whether or not large numbers of sequences were claimed, led to the raising of questions about whether the search fee charged was commensurate with the effort involved in carrying out the search. The Meeting discussed the relationship between the complexity of the subject matter and the effort required to carry out the search, on the one hand, and the application of the criteria of unity of invention, on the other.

24. The Meeting agreed that no change to the Administrative Instructions or the Guidelines related to this question should be made, at least for the time being, but that the matter should be taken up in the context of the study to be undertaken on international search of international applications involving a disproportionate number of claims or extremely broad, vague and/or imprecise claims (see paragraph 28, below).

#### INTERNATIONAL SEARCH IN CASE OF DISPROPORTIONATE NUMBER OF CLAIMS OR EXTREMELY BROAD, VAGUE AND/OR IMPRECISE CLAIMS

25. Discussion was based on documents PCT/MIA/VI/13 and 14.

26. The Meeting noted that some cases raised valid questions as to whether the International Searching Authority should be able to restrict the international search for reasons of “economy.”

27. The Meeting noted that the PCT and Regulations did not, at present, provide for the imposition, assessment or collection of search fees scaled according to the complexity or number of, or number of embodiments of the invention included in, the claims to be searched, but that Article 3(4)(iv) provided for the charging of “prescribed fees” generally. There would be difficulties in establishing such a system of scaled search fees to be collected by the receiving Office, since technical judgment would need to be exercised in assessing whether, and what amount of fees, were payable; such judgment would need to be exercised by the International Searching Authority. If a system of scaled fees depending on the complexity of the international search were to be introduced, appropriate possibilities for applicants to ask for review of the examiner’s discretion would need to be provided for. Any such system of scaled fees must not discriminate against any particular field of technology.

28. The Meeting accepted an offer by the European Patent Office to lead a study on the issue. The study would include in its scope the problems raised by international applications claiming large numbers of sequences (see paragraphs 20 to 24, above) and would need to clearly distinguish between applications lacking unity of invention and applications complying with unity of invention criteria but requiring an exceptional effort for searching and therefore possibly justifying higher search fees.

29. The Meeting noted that the absence of a “claims fee” for international applications, as distinct from national or regional applications, where such a fee was payable, could be abused by applicants by including an excessive number of claims.

30. The Meeting noted that the international search report was intended to help not only applicants but also designated Offices, notably those in developing countries, which relied on having thorough international search results covering the complete international application before deciding whether or not to grant a patent.

31. Noting that there was a need to consult user groups on the matter, the Meeting agreed that it would be premature for this issue to be submitted to the meeting of an *Ad Hoc* PCT Advisory Group to be held in April 1997.

## ADDITIONAL SEARCH AND PRELIMINARY EXAMINATION FEES WHERE LACK OF UNITY OF INVENTION IS FOUND

32. Discussion was based on document PCT/MIA/VI/3.

33. The Meeting agreed that the first sentence of Rule 40.2(c) should be amended by clarifying that the expression “excessive” relates to the number of additional inventions for which additional fees are required rather than to the prescribed amount of the additional fee.

34. The Meeting also exchanged views about the desirability or otherwise of additional search and preliminary examination fees being set at lower levels than the corresponding fees for search and preliminary examination of the main invention. The Authorities which charged the same amount believed that their practice was fully justified because they would frequently, where lack of unity was found, make a complete search of all inventions claimed without issuing an invitation to pay any additional search or preliminary examination fee. Invitations to pay additional fees would, in general, be issued by those Authorities only where a major effort was required or where the additional search or preliminary examination would have to be carried out by a second examiner. Those Authorities believed that some applicants intentionally included multiple inventions in one international application, and that lower additional fees would inevitably encourage such undesirable practice.

35. The International Bureau stressed the importance for national Offices to have the benefit of complete search and preliminary examination reports covering all inventions claimed. This was particularly the case for the designated Offices of developing countries, which relied to an increasing extent on those reports.

36. The Russian Agency for Patents and Trademarks suggested that, even if the amount of the additional fee was the same as the fee for the search or preliminary examination of the main invention, a refund of up to 25% of the additional fee could be considered when the effort required for the search or preliminary examination of the further invention(s) was clearly lower than that required for the main invention. None of the other Authorities concerned was, however, prepared to consider the possibility of such a refund.

PROPOSED AMENDMENT OF PCT RULE 13*bis* (MICROBIOLOGICAL INVENTIONS)

37. Discussion was based on document PCT/MIA/VI/11.

38. The Meeting agreed to the proposed replacement of the term “microorganism” by “biological material” throughout the text of Rule 13*bis*. One Authority expressed the view that a final view should not be taken by the Meeting before a decision had been taken on a draft European Parliament and Council General Directive on the Legal Protection of Biotechnological Inventions.

39. The Meeting did not support the proposal made by the European Patent Office to require, in Rule 13*bis*, proof of the depositor’s consent in the case where the biological material had been deposited by a person other than the applicant. The Meeting was of the opinion that, for the case where the deposit has been made by a third party, it was the applicant’s responsibility to fulfill all necessary requirements to allow, in accordance with the national law applicable by the designated Office, access to the deposited biological material.



For such a case, a statement made by the applicant alleging the right to use the deposited biological material for the purposes of patent proceedings was sufficient. It was the applicant's obligation to make all necessary arrangements with the depository institution which would allow an interested third party the desired access to the deposited material. If such access was not possible, the disclosure of the invention was not sufficient.

40. Following a question raised by the International Bureau, all Authorities indicated that they had never made use of the possibility of requiring the furnishing of a sample of a deposited microorganism as provided for under Rule 13*bis*.6(a). The Meeting agreed that Rule 13*bis*.6(a) could be deleted as a consequence of an obvious lack of need for such a provision.

41. The Meeting discussed the need for publication of indications relating to a deposited microorganism or biological material and concluded that only the essence of relevant information furnished separately from, or subsequently to, the description should be included in the international publication. Copies of certificates issued by the depository institution and any other material would not have to be published, as such, with the international application.

#### DEMAND FOR INTERNATIONAL PRELIMINARY EXAMINATION: LATE FILING; RIGHT TO FILE; LATE PAYMENT FEE; FILING WITH NON-COMPETENT AUTHORITY

42. Discussion was based on documents PCT/MIA/VI/5 and 12.

43. The International Bureau was invited to further develop proposals in the light of the discussion and of the conclusions set out in the following paragraphs.

#### *Late filing of demand*

44. The Meeting considered a proposal by the International Bureau contained in document PCT/MIA/VI/5 for a new Rule 53*bis* and a further proposal by the European Patent Office concerning that proposed new Rule, contained in document PCT/MIA/VI/12.

45. Most Authorities expressed support for the idea of finding a way to afford relief, at least in certain circumstances, to applicants who inadvertently filed a demand after the expiration of 19 months from the priority date. The Meeting recognized the difficulty faced by applicants if the International Preliminary Examining Authority did not notice the late filing in sufficient time to warn the applicant so as to enable entry into the national phase within the applicable time limit under Article 22.

46. Some Authorities expressed doubts as to whether new Rule 53*bis* as proposed by the International Bureau, in providing for deemed compliance with the 19-month time limit in cases where an election was in fact made after that time limit, would be consistent with Article 39(1)(a). It was, however, noted that there were already provisions in the Regulations (for example, Rule 16*bis*) which included this kind of deeming provision.

47. The Meeting agreed that thought should also be given to alternative approaches to dealing with the problem, for example, by relying more, in some way, on the possibilities for elected Offices to excuse late filing under national law, under either Article 39(1)(b) or Article 48(2)(b), or to include in the Regulations a procedure which gave effect to such possibilities in a “collective” way. It was further noted that there may be a need to include a provision allowing Offices not to apply the procedure for as long as the national law remained inconsistent with it.

48. In response to queries by certain Authorities, the International Bureau explained that proposed new Rule 53*bis* depended on the making of an election, rather than the making of the demand, since Article 39(1)(a) itself operated in that way.

49. The Meeting recognized the need, if a provision were to be introduced to alleviate the consequences of late filing of the demand, to enable the charging of a fee sufficient to discourage deliberate late filing.

50. Most Authorities having expressed sympathy with the aims of the International Bureau’s proposal, the International Bureau stated that it would further develop a solution, taking into account the comments made by the Authorities.

#### *Right to file demand*

51. The Meeting expressed general agreement with the amendment of Rule 54.2 proposed by the International Bureau in document PCT/MIA/VI/5. The Meeting also agreed with the suggestion of the United States Patent and Trademark Office that item (ii) of that Rule be omitted.

#### *Late payment fee for filing demand*

52. The Meeting agreed that a late payment fee, for the benefit of the International Preliminary Examining Authority, should be introduced for cases of late payment of the handling fee and/or the preliminary examination fee (see the proposal by the European Patent Office for amendment of Rules 57 and 58, as set out in document PCT/MIA/VI/12).

53. The Meeting agreed that the procedure to be introduced should be parallel, so far as possible, to that presently applicable under Rule 16*bis*. Rule 58.1(b) should be amended to provide that the preliminary examination fee was payable at the time of filing the demand, as was already provided for the handling fee under Rule 57.3(a). The amount of the late payment fee should be equal to the handling fee, subject to possible increase in the future if it emerged that some applicants were deliberately delaying fee payment.

#### *Filing of demand with non-competent Authority*

54. The Meeting expressed general agreement with the proposal by the International Bureau for a new Rule 59.3 as set out in document PCT/MIA/VI/5. The Meeting also agreed that the new Rule should apply in cases where the demand was filed incorrectly with any receiving Office or International Searching Authority or with the International Bureau, as well as with a non-competent International Preliminary Examining Authority; that the non-competent Authority or Office should have the option of sending the demand directly to the competent

Authority, as an alternative to sending it to the International Bureau; and that a consequential amendment should be made to Rule 69.2 to ensure that the (competent) International Preliminary Examining Authority would always have nine months from the date of actual receipt of the demand to establish the international preliminary examination report.

#### CONFIDENTIAL NATURE OF THE INTERNATIONAL PRELIMINARY EXAMINATION

55. Discussion was based on document PCT/MIA/VI/4.

56. The Meeting discussed Article 38(1) and the interpretation of that Article agreed upon by the Meeting at its fourth session held in Geneva in 1994. Several Authorities reported concerns expressed by certain interested circles over the inability of third parties to gain access to the contents of the international preliminary examination file. Given the current interpretation of Article 38, several Authorities, in their capacity as elected Offices, reported practical problems faced by examiners in the national phase and expressed concerns over the inability of elected Offices to use certain kinds of material from the international preliminary examination file during the national examination procedure, particularly in cases where the elected Office had acted as the International Preliminary Examining Authority.

57. The Meeting considered the conflict between, on the one hand, access to the international preliminary examination file by third parties and, on the other hand, the preliminary, non-binding and advisory nature of the international preliminary examination, and the fact that a given elected Office's decision as to the grant of a patent may often be based on claims which have been further amended upon entry into the national phase (see Article 41), that is, on claims different from those on which the international preliminary examination report was based and independent of any statements by the applicant during the international preliminary examination. However, in the light of the above-mentioned concerns expressed by third parties and the practical problems faced by examiners in elected Offices, the Meeting agreed that a new approach would be needed towards the confidentiality of the file of the international preliminary examination and that a more liberal interpretation of Article 38(1) would be desirable.

58. The Russian Agency of Patents and Trademarks proposed to liberalize access to the international preliminary examination file by amending the last sentence of the interpretation of Article 38(1) agreed upon by the Meeting at its fourth session held in Geneva in 1994 (see document PCT/MIA/IV/4, paragraph 74) to read: "Only the international preliminary examination report and those parts of the international preliminary examination file which are referred to by the applicant for the national (regional) processing would become part of the file of the elected Office and would be subject to public inspection to the same extent as the rest of that file."

59. The Meeting agreed that the exception provided for in Article 38(1) allowing access to the file of the international preliminary examination by elected Offices should not be interpreted as limiting that access to the elected Offices themselves. Consistent with this interpretation, elected Offices whose national law made application files publicly accessible should no longer be required to remove the international preliminary examination file when allowing such access. Not only the international preliminary examination report but also the remainder of the international preliminary examination file, if available at the elected Office, should become part

of the file of that Office and should be subject to public inspection to the same extent as the rest of that file.

60. The Meeting agreed that a corresponding amendment of the Regulations would be desirable in order to clarify this interpretation of Article 38(1) and to provide a clear legal basis for the change of policy towards greater access to the file of the international preliminary examination. The Meeting further agreed that such amendment to the Regulations should also address the question of the reimbursement of the cost of the service offered by elected Offices, particularly in cases where the elected Office did not carry out the international preliminary examination, of obtaining a copy of the file, of allowing access to the file, and of furnishing copies of documents contained in the file.

61. The Meeting noted the possible administrative burden for International Preliminary Examining Authorities in making copies available to elected Offices and for elected Offices in obtaining copies of and giving access to the file of the international preliminary examination. The Meeting also noted that, once an electronic filing system was in place, it would be easier for elected Offices, and via these Offices, third parties, to gain access to the content of the international preliminary examination file, thus avoiding the need for paper copies of the file to be made available to elected Offices.

#### RENEWAL OF THE AGREEMENTS UNDER WHICH THE INTERNATIONAL SEARCHING AUTHORITIES AND INTERNATIONAL PRELIMINARY EXAMINING AUTHORITIES CARRY OUT THEIR FUNCTIONS

62. The Meeting agreed with the draft text proposed by the International Bureau in document PCT/MIA/VI/8 as a basis for renewal of the above-mentioned Agreements, subject to the following observations and changes:

(a) The second and third sentences of Article 2(1) in the draft text should be revised to read: "In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT Search Guidelines and the PCT Preliminary Examination Guidelines."

(b) Article 2(2) in the draft text should be revised to read as follows: "The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder."

63. It was agreed that the International Bureau would, on the basis of the draft text, prepare draft Agreements for the purposes of further consultation with each Authority concerned, with a view to submission of draft Agreements to the Assembly in September-October 1997 for its approval. The various Authorities agreed to prepare translations into any languages other than English in which the Agreement should also be signed.

ACCEPTANCE OF EVIDENCE OF MAILING A DOCUMENT IN CASE OF LOSS OR DELAY WHERE A DELIVERY SERVICE OTHER THAN THE POSTAL AUTHORITIES IS USED

64. In response to a question raised by the European Patent Office, those Authorities which were prepared to accept evidence from a delivery service for the purposes of the operation of Rule 82.1 indicated that no problems in this connection had arisen. A suggestion by the Australian Industrial Property Organisation that the second sentence of Rule 82.1(a) might be deleted was not favored by the Meeting.

USE OF THE INTERNET DURING INTERNATIONAL SEARCH AND INTERNATIONAL PRELIMINARY EXAMINATION

65. The Meeting considered document PCT/MIA/VI/7 and an excerpt of a report on Trilateral Project 14.6, "Citations of Electronic Resources," distributed by the United States Patent and Trademark Office.

66. Views were exchanged about the nature of publications on the Internet and the manner of citing them. It was considered to be necessary, if a document was found on the Internet which was not clearly also contained in a printed publication, for the search examiner to print a copy of the document and to record where and when it was found.

67. The Meeting proposed that the International Bureau should study whether a new special category (for example, the letter "I") should be established, under which documents could be cited which contained relevant prior art but for which the publication date could not be established.

68. The Meeting also requested the International Bureau to review WIPO Standard ST.14 with due regard to ISO Standard DIS 690-2, and to make a proposal for the manner in which documents found on the Internet should be cited.

69. The Meeting noted the practice of the United States Patent and Trademark Office, as laid down in Chapter 2128 of the Manual of Patent Examining Procedure, concerning "Printed Publication as Prior Art." There was basic agreement with that practice.

70. As far as the further impact of the Internet on search and examination is concerned, the Meeting agreed to await the results of the ongoing Trilateral study expected to be available in June 1997. The United States Patent and Trademark Office undertook to prepare a proposal for an appropriate amendment of the PCT Search Guidelines.

71. The Meeting noted a document distributed by the United States Patent and Trademark Office, "Use of the Internet in the USPTO for the Patent Examination Process: A Discussion Paper in Support of International Harmonization of Patent Systems," dated November 8, 1996.

72. The Meeting noted a document distributed by the Japanese Patent Office, "The Utilization of the Internet as a Search tool in JPO."

IMPACT OF ELECTRONIC TRANSMISSION OF DOCUMENTS (INCLUDING INTERNATIONAL APPLICATIONS AND INTERNATIONAL SEARCH REPORTS) ON THE PCT PROCEDURE

73. The Meeting took note of a proposal distributed by the United States Patent and Trademark Office entitled "Electronic PCT Application Filing and Management System for Receiving Offices." That Office gave to the Meeting a demonstration of a prototype for electronic preparation and filing of international applications via the Internet.
74. The European Patent Office gave to the Meeting a demonstration of its latest version of the EASY software and an explanation of the future system for filing of European applications in machine readable form, which would also become available for the filing of international applications under the PCT later in 1997.
75. The International Bureau reported on the progress made in the course of its technical cooperation with the European Patent Office in setting up a system for electronic exchange of data, and invited the other Authorities to join in the cooperation with the International Bureau with a view to exchanging data relating to international applications in electronic form.
76. The European Patent Office offered to host a session of the Meeting, at which the Authorities would be represented by technical experts, for the purpose of discussing future exchange of data by electronic means. That Meeting was planned to be held at the Directorate-General 1 of the European Patent Office in The Hague early in the second half of 1997. The Meeting thanked the Office for its offer.
77. The International Bureau informed the Meeting about the current development of an electronic system to enable electronic filing of international applications via the Internet with the International Bureau as receiving Office. The system would be developed on the basis of software and hardware available on the market. It was not planned to develop any proprietary system.
78. The International Bureau informed the Meeting of its intention to propose to the meeting of an *Ad Hoc* PCT Advisory Group in April 1997 a draft Rule for inclusion in the Regulations which would permit electronic filing of international applications. For matters of detail, that Rule would refer to the Administrative Instructions. This approach was suggested in order to expedite necessary changes and adaptations resulting from rapid technical development and experience gained with the implementation of the system.
79. The United States Patent and Trademark Office offered its cooperation in the development of the legal and technical infrastructure of the electronic filing system. Certain Rules on electronic transmittal, certification, signature of documents, etc., elaborated for the courts of the United States of America, could be adapted for the purposes of the PCT.
80. The International Bureau explained in detail the consequences of electronic filing for the Authorities as well as for designated/elected Offices. International applications filed in electronic form should preferably be transmitted to International Searching Authorities in that form. The electronic format of international applications would allow the inclusion of the full text in electronic form for search in databases, a feature which was becoming increasingly important for reliable searches in view of the technical contents of international applications. It

would also permit the photocomposition of PCT pamphlets, thus reducing their volume by more than half.

81. The International Bureau informed the Meeting of its intention to make greater use of CD-ROMs as a carrier of PCT information, replacing paper copies, and to issue, in cooperation with the European Patent Office, the ESPACE FIRST CD-ROM containing front pages of PCT pamphlets in mixed mode MIMOSA format. This would allow all Authorities and Offices to extract and download PCT data in machine readable form according to their needs, and should replace the various kinds of magnetic tapes furnished at present to different Authorities and Offices.

82. The Meeting considered a document, "ISA Search Report Revision," prepared by the European Patent Office in follow-up of its last technical meeting with the International Bureau at the beginning of February 1997. The contents and approach taken by this document met with general approval. The outlined alternative manner of presenting international search reports on the basis of SGML tagged electronic data was welcomed by all Authorities. The Meeting noted that the European Patent Office and the International Bureau planned to elaborate a detailed system which could easily be adopted by other International Searching Authorities, preferably even by those using characters other than those of the Latin alphabet. The proposed system of presentation of the search report, based on data established in electronic form, would permit Authorities to print international search reports for applicants and to electronically transmit those reports to the International Bureau. The International Bureau could then photocompose the search report data for publication as part of the PCT pamphlet, electronically store that data, and possibly use them for supplementing the first page data in MIMOSA format on the ESPACE FIRST CD-ROM.

83. The European Patent Office confirmed its interest in supplementing international search reports established by other International Searching Authorities with any available patent family information from that Office's patent family data base. The electronic transmittal of the references cited would save the European Patent Office from having to capture data relating to such references for its use.

84. The Meeting noted that the International Bureau intended to propose a uniform format for international search reports to be established and transmitted in electronic form. This new format could be used as an alternative to Form PCT/ISA/210. A corresponding modification to the Administrative Instructions would be submitted for consultation and promulgated as soon as possible. The International Bureau and the European Patent Office also agreed to provide technical advice and detailed instructions needed for the implementation of the new system.

85. It was also agreed that the new system should be further developed in order to allow the establishment of written opinions and international preliminary examination reports in electronic SGML coded form.

OTHER MATTERS

*Activities under the PCT in 1996*

86. The Meeting noted WIPO Press Release PCT/106, outlining activities under the PCT in 1996, and the summary thereof by the International Bureau.

*Korean Industrial Property Office*

87. The International Bureau informed the Meeting that the Industrial Property Office of the Republic of Korea had expressed the wish to be appointed, in the course of 1997, as an International Searching and Preliminary Examining Authority and of the procedure suggested by the Director General to that Office.

*Incorporation of disclosure by reference*

88. Upon a proposal by the International Bureau, the Meeting agreed that a study should be made of the different practices relating to the handling of “incorporation by reference” in patent applications, with a view to formulating a common approach to be reflected in the PCT Preliminary Examination Guidelines. The European Patent Office undertook to prepare the study and to propose a text for inclusion in those Guidelines, and invited all Authorities to send to it an outline of their practice in this respect.

89. *The Meeting unanimously adopted this report on February 21, 1997.*

[Annex I follows]



ANNEX I

LIST OF PARTICIPANTS

I. INTERNATIONAL AUTHORITIES

(in the English alphabetical order of their names)

AUSTRALIAN INDUSTRIAL PROPERTY ORGANISATION

Bruce MURRAY, Commissioner of Patents and Registrar of Designs

David HERALD, Deputy Commissioner of Patents 3

Ed KNOCK, Supervising Examiner of Patents, Patent Examination B4

AUSTRIAN PATENT OFFICE

Eckehardt ENDLER, Presidential Department II

CHINESE PATENT OFFICE

SUN Ke (Mrs.), Deputy Director General, Mechanical Examination Department

LIU Jiafei, Examiner, PCT Division

EUROPEAN PATENT OFFICE

André CARDON, Director, Directorate-General 1

Arnold VAN PUTTEN, Project Leader, Directorate-General 1

Colin PHILPOTT, Director, Directorate-General 2

York BUSSE, Principal Administrator, Directorate-General 5

JAPANESE PATENT OFFICE

Junji YUITA, Director, 2nd Examination Department

Noriyuki TAKEBAYASHI, Director, Examination Standards Office

RUSSIAN AGENCY FOR PATENTS AND TRADEMARKS

Valeri DJERMAKIAN, Deputy Director, All-Russian Scientific Research Institute of State Patent Examination (VNIIGPE)

Evgueni BOURIAK, Consultant, VNIIGPE

SPANISH PATENT AND TRADEMARK OFFICE

Miguel HIDALGO LLAMAS, Legal Advisor

SWEDISH PATENT OFFICE

Jan-Eric BODIN, Deputy Head, Patents

Marie ERIKSSON (Ms.), Head of Legal Division, Patent Department

UNITED STATES PATENT AND TRADEMARK OFFICE

Stephen KUNIN, Deputy Assistant Commissioner for Patent Policy and Projects

Robert STOLL, Administrator, Office of Legislation and International Affairs

II. OFFICERS

Chairman: Bruce MURRAY (Australian Industrial Property Organisation)

Secretary: Philip THOMAS (WIPO)

III. INTERNATIONAL BUREAU  
OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

Busso BARTELS, Director, PCT Sector

Philip THOMAS, Director, PCT Legal Division

Claus MATTHES, Senior Legal Officer, PCT Legal Division

[Annex II follows]

ANNEX II

AGENDA

*adopted by the Meeting*

1. Opening of the session
2. Election of a Chairman
3. Adoption of the agenda
4. Possible modifications of the PCT Search Guidelines (document PCT/MIA/VI/2)
5. Proposed modifications of the PCT Preliminary Examination Guidelines and proposed amendments of PCT Rules 64 and 70.10 (document PCT/MIA/VI/6)
6. Establishment of a uniform standard for the presentation of nucleotide and/or amino acid sequence listings in international applications (document PCT/MIA/VI/15)
7. International search and international preliminary examination of international applications containing large numbers of sequence listings; proposed modifications of the PCT Administrative Instructions (documents PCT/MIA/VI/9 and PCT/MIA/VI/10)
8. International search in case of disproportionate number of claims or extremely broad, vague and/or imprecise claims (documents PCT/MIA/VI/13 and PCT/MIA/VI/14)
9. Additional search and preliminary examination fees where lack of unity of invention is found (document PCT/MIA/VI/3)
10. Proposed amendment of PCT Rule 13*bis* (Microbiological Inventions) (document PCT/MIA/VI/11)
11. Demand for international preliminary examination: late filing; right to file; late payment fee; filing with non-competent Authority (documents PCT/MIA/VI/5 and PCT/MIA/VI/12)
12. Confidential nature of the international preliminary examination (document PCT/MIA/VI/4)
13. Renewal of the Agreements under which the International Searching Authorities and International Preliminary Examining Authorities carry out their functions (document PCT/MIA/VI/8)
14. Acceptance of evidence of mailing a document in case of loss or delay where a delivery service other than the postal authorities is used
15. Use of the Internet during international search and international preliminary examination (document PCT/MIA/VI/7)

16. Impact of electronic transmission of documents (including international applications and international search reports) on the PCT procedure
17. Other matters
18. Adoption of the report of the session
19. Closing of the session

[Annex III follows]

ANNEX III

PROPOSED MODIFICATIONS OF THE PCT SEARCH GUIDELINES BASED ON THE  
COMMON GROUND RULES FOR INTERNATIONAL SEARCH ADOPTED BY THE  
EUROPEAN PATENT OFFICE, THE JAPANESE PATENT OFFICE AND  
THE UNITED STATES PATENT AND TRADEMARK OFFICE

*Insert in Chapter III, paragraph 3.2:*

A document alone which indicates an abstract idea of a claimed invention but fails to disclose all the features set forth in a claim is not enough to negate the patentability of the claimed invention, unless it is shown that the missing feature is so well-known that documentary evidence seems unnecessary. In other words, the subject of search should not be identified based on the description of an invention (e.g., object, work, or effect of an invention) apart from the features set forth in a claim.

*Insert in Chapter III, paragraph 3.3:*

The search examiner should construe the terms of the claims broadly. This broad construction must, nevertheless, be reasonable and consistent with the specification.

*Insert between Chapter III, paragraph 3.11 and Chapter III, paragraph 3.12:*

In evaluating novelty or inventive step, the search examiner should consider which type of the transition phrase, such as “consisting of,” “comprising,” characterized by,” the claims have. The subjects to be searched are specified according to the type of transition phrases.

(1) Closed Type. Where a claim is drafted in a closed type, the ~~claims claim~~ cannot be read on products or processes that include structural elements or process steps other than those set forth in the claim.

For example, if a claim recites “A product consisting only of A, B and C.” ~~in English~~, it does not read on and is novel over prior art that discloses a product having A, B, C and D, or any other additional feature or elements.

(2) Open Type. Where a claim is drafted on an open type, this type of ~~claims claim~~ can be read on products or processes that include non-recited structural elements or process steps.

For example, if a claim recites “A product comprising A, B and C.” ~~in English~~, it reads on and lacks novelty over prior art that discloses a product having A, B, C and D, as well as any additional feature or element.

*Insert in Chapter III, paragraph 3.14 (at the beginning):*

The claimed invention includes the limitations of the preamble in combination with the limitations in the ~~improvement~~ characterizing portion of the claim. In these cases, the preamble is regarded as a claim limitation.

*Insert between Chapter III, paragraph 3.11 and Chapter III, paragraph 3.12 [and renumber Chapter III, paragraph 3.13 and Chapter III, paragraph 3.14]:*

Product (Apparatus) claims containing the “means plus function” language should be considered to include all means consistent with the specification capable of performing the stated function unless the means are further specified in the claims. If the means are further specified, the claims would be interpreted to include those further specified limitations. For example: A claim recites valve means for restricting the flow of fluid. The claim would be interpreted by the search examiner to include the further specified limitation of a valve means rather than any means for restricting flow of fluid. The search examiner should, however, consider extending the search to analogous means.

Note: The words “consistent with the specification” means that the limitations are interpreted with due regard to the description and drawings (if any) and with particular emphasis on the inventive concept towards which the claims are directed.

Where a claim defines a product by its manufacturing process, determination of the subject of search is based on the product itself rather than the process steps since the claim, as a whole, is directed to a product.

Novelty of the product ~~is denied~~ may be brought into question even if an identical prior art product was made by a different process.

[Example 1] “Protein which is obtained by process P (steps P1, P2, ...)”

If the protein which is obtained by process P is identical to a prior art protein Z which is manufactured by process Q that is different from process P, ~~the claim in example 1 is denied novelty~~ the novelty of the claim in example 1 is brought into question.

In those certain cases where the product can only be defined by the process steps, the examiner would consider the process steps in determining the subject of search.

[Example 2] “A two-layer structured panel which is made by welding together an iron sub-panel and a nickel sub-panel”

The process of “welding” would be considered by the search examiner in determining the subject of search since the process of welding produces physical properties in the end product which are different from processes other than welding, i.e., the product can only be defined by the process step. ~~The claim is not defined novelty~~ Novelty of the claim is not brought into question unless an identical two-layer structural panel made by means of welding is shown in the prior art.

Product limitations in apparatus claims are generally given no weight in assessing novelty and inventive step. For example: A claim recites a cutting machine for cutting meat comprising apparatus limitations. The claim language “meat cutting machine for cutting meat” sets forth only the function of the apparatus (i.e., for cutting meat) without any positive structural limitations and would not be given any weight in assessing novelty and inventive steps as long as the prior art cutting machine was capable of cutting meat. In this case, one should treat the limitation machine for cutting meat, as if the statement were to be a machine adapted to cut meat. Thus, one would look to the prior art to see whether the cutting machine would be inherently capable of cutting the meat whether the prior art description recited what is being cut or not.

Apparatus limitations in process claims are only taken into account when the apparatus limitations affect the process ~~in a manipulative sense~~.

*Insert in Chapter III, paragraph 3.7 (end):*

However, if a meaningful search for a claim not ~~covered~~ supported by the description can be carried out without many extensions of the scope of search and much increase in the effort of search, and its scope is not unduly wide, the search should be extended to cover the claimed subject matter that is not supported by the description. [For example: A broad Markush grouping in insecticidal agents which includes halogenated hydrocarbons, carbamates and pyrimidine derivatives would not necessitate a search for halogenated hydrocarbons, if no specific halogenated hydrocarbons were disclosed in the description since, as to halogenated hydrocarbons, they are not supported by the description.]

*Amend Chapter VIII, paragraph 1.1 to read as follows:*

1.1 Rule 39 specifies certain subjects matter which an International Searching Authority is not required to search. Any subject matter under Rule 39 which a particular International Searching Authority is prepared to search is set forth in an Annex to the Agreement between that International Searching Authority and the International Bureau. Therefore, the subjects matter under Rule 39 excluded from the international search may vary between the various International Searching Authorities. Furthermore, the International Searching Authorities are not required to search subjects matter that ~~are~~ is generally accepted not to be patentable or susceptible of industrial application. If the claims are open to objections in this respect, ~~the possibility of a future amendment which would remove the deficiency and which might reasonably be expected should be taken into consideration in carrying out the search (see Chapter III, paragraph 3.6).~~ the search examiner conducts the search based on the subject matter which might reasonably be expected to be claimed from the contents of the description and drawing by amendment if the expected amended claims would make a meaningful search possible. This shall be indicated in the international search report.

*Amend Chapter VIII, paragraph 2.1 to read as follows:*

2.1 A situation where a meaningful international search is not possible for all or part of the claimed subject matter, and where a declaration to this effect may take the place of the international search report or be an observation therein, may result from the fact that the international application contains obscurities, inconsistencies or contradictions to the extent that it is impossible to arrive at a reasonable conclusion as to the scope of the claimed invention. The International Searching Authority in these cases should make a meaningful search to the extent that this is possible. The International Searching Authority may, where it thinks it appropriate in a doubtful case, informally ask the applicant for clarification before making a declaration that a meaningful international search is not possible.

*Insert between Chapter VIII, paragraph 2.1 and Chapter VIII, paragraph 2.2:*

~~In this item "Lack of Clarity" of the claim means~~ A need for clarification as referred to in paragraph 2.1 of this Chapter may arise where there are any kind of defects in the claims and the defects cause any difficulty in determining the scope of the claims based on the claimed language only, e.g., obscure, inconsistency, vague, ambiguous expression in the claims. These kinds of defects include not only the cases where the claim languages are not clear even after taking the specification into account but also the cases where the claim languages are not clear by themselves but the scope of the claim becomes clear in light of the specification.

Where ~~a~~ the claim has is unclear descriptions, and the technical features of a claimed invention cannot be identified at all even after taking into account all of the contents of the description and drawings and common general knowledge, it is obscure and therefore no international search will be implemented.

When the claimed subject matter taken as a whole includes alternatives some of which are a clear realization of the invention as well as other alternatives which are an unclear realization of the invention (partially unclear), the search examiner should search the clear realization of the invention. With regard to the unclear features, the search examiner should determine the subject of search based on the subject matter which might reasonably be expected to be claimed by amendment taking into account the contents of the description and drawings and the common general knowledge in the relevant technical field and conduct the search based on the determined subject.

For example: if the invention relates to a combination of  $a + b + c + d$  in which  $b$  is obscure no search will be performed. However, if the invention relates to a combination of  $a_1$  or  $a_2 + b_1$  or  $b_2$ , in which  $a_2$  is obscure, the combination of  $a_1 + b_1$  and  $a_1 + b_2$  will be searched.

It should be noted, however, that a reasonable effort should be made before the search examiner concludes that a part of the claimed subject matter is too unclear to be included in the subject of search.



*Insert between Chapter IV, paragraph 2.1 and Chapter IV, paragraph 2.2:*

The field of search should, where appropriate, include analogous fields with respect to claimed inventions which are construed broadly to the extent they are consistent with the description and drawings of the specification.

For a ~~Jepson claim~~, or a two-part claim (known as Jepson claim in US practice), the search examiner should consider not only the limitations set forth in the body characterizing portion of a claim but also those in the preamble in planning the field of search.

*Insert in Chapter IV, paragraph 2.2 (end) [or after Chapter IV, paragraph 2.6]:*

In determining analogous fields into which the search should be extended, it would be useful to give consideration to:

- a. Fields in which the same or similar structure ~~is~~ would be expected by a person skilled in the art to be employed in different work or use.
- b. Fields to which a generic concept of claimed features pertains.
- c. Art within the field of the inventor's endeavour and reasonably pertinent to the particular problem with which the inventor was involved.
- d. Fields relevant to the function or utility inherent in the subject matter covered by the claims, i.e. the field to which the application is most probably applied in addition to the general field of the subject matter would be searched.

*Add to the end of Chapter VI:*

## EVALUATION OF DOCUMENTS

### A. GENERAL PRINCIPLES

1. The category symbol assigned to a cited reference should be based on the real claims as a general rule. The symbols "X", "Y" and "A" are to be used to indicate the technical relevance of the cited documents in relation to the claims concerned.

In evaluating cited documents, the search examiner should not read into claims any limitations that are disclosed in the specification but not claimed.

2. When assessing novelty and inventive step, the search examiner should interpret claims giving them the broadest reasonable interpretation consistent with the specification just as stated in the "determination of the subject of search".
3. Claim in Two-Part Form. In applying the inventive step standard, if the search examiner was unable to locate a reference of the preamble, and it is understood that from the description ~~in the specification~~ the applicant is considered to have admitted that the features in the preamble were known to public, the search examiner is entitled to consider the features in the

preamble to be known. However, since this presumption is rebuttable, the examiner should search and cite documents as far as possible.

4. In cases where the search examiner makes specific claim interpretations described in “I. DETERMINATION OF THE SUBJECT OF SEARCH” (e.g., type of claims in two-part form, types of expression), the evaluation of references for such claim also follows the claim interpretations mentioned above.

However, special attention should be paid in evaluating the references when assessing the subject matters which may be excluded from the international search:

a. in the ~~Office~~ International Searching Authority where such subject matters are considered nonstatutory, the category symbol is assigned based on the subject matter which might reasonably be expected to be claimed by amendment, but if possible, the assessment is done based on other real claims, which are statutory and

b. in the ~~Office~~ International Searching Authority where such subject matters are statutory, the category symbol is based on the real claim.

## B. SYMBOL “X”

### 1. Evaluation of Novelty

a. A document whose content destroys the novelty of at least one independent claim, and possibly that of one or more claims depending on it is categorized as “X”.

b. Where there is a trivial difference - merely in wording, but not essential between the claimed subject matters and those in the reference, category “X” is assigned to the reference.

c. Generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but a specific disclosure does take away the novelty of any generic claim embracing that disclosure. Therefore, where a claimed subject represents a generic concept, category “X” is assigned to the document.

### 2. Evaluation of Inventive Step

A document whose content alone calls into question the inventive step of at least one independent claim, and possibly that of one or more claims depending on it would be categorized as “X”.

This occurs in the following cases, for example,

1) where a technical feature known in a technical field is applied from its original field to another field and its application therein would have been obvious to a person of ordinary skill in the art;

2) where a difference between the document’s content and the claimed matter is so well-known that documentary evidence seems unnecessary;

3) where a claimed subject matter relates to a use of a known product, and the use would have been obvious from a the known properties of the product;

4) a claimed invention differs from the known art merely in the use of equivalents that are so well known that the citation of documentary evidence is unnecessary.

[PCT Preliminary Examination Guidelines, IV 8.8 (A1) (ii)]

### 3. Others

Dependent claims must be read as a whole taking into account and incorporating limitations of the claim from which they depend.

In assessing dependent claims, the following points are to be considered.

a. Documents assigned “X” category for dependent claims, would also be assigned category “X” for the claims from which it depends.

b. Relevant documents should be assigned category “X” when a claim involves several options and the novelty is destroyed or inventive step is called into question of at least one option, solely by the documents concerned.

### C. SYMBOL “Y”

#### 1. General

a. In order to deny patentability based on lack of inventive step, the claimed invention taken as a whole must have been obvious to a person of ordinary skill in the art.

b. There must be some collective “teachings” in the prior art that would suggest to a person of ordinary skill in the art why the references’ teachings are combinable. ~~The “teaching”~~ It would be preferable if the “teaching” would be to describe described explicitly in a prior document. But the “teaching” to combine references need not be explicitly found in the reference. This includes such cases where the prior arts produce the grounds for reasoning that a person skilled in the art could have easily arrived at the claimed invention based on the prior art documents.

c. Inventive step can be called into question by combination of cited documents for example in the following cases:

1) Obvious choice from a number of alternatives which are equivalent.

In a case where a document disclosed all the claimed features except for the selection of alternatives, and another document teaches that the two alternatives are equivalent in their work and result, it would have been expected of a person skilled in the art to combine the two documents, which make up the claimed features.

2) A claimed invention consists merely in the juxtaposition or association of known devices or processes functioning in their normal way and not producing any non obvious working interrelationship.

3) The collective suggestions of the references show recognition and solution of the problem addressed by the applicant as providing a rationale for combining “teachings” of the references.

## 2. Evaluation of Dependent Claims

Dependent claims must be read as a whole taking into account and incorporating limitations of the claim from which they depend.

In assessing dependent claims, the following points are to be considered:

a. A combination of “Y” documents should be concerned not only with a dependent claim’s characterizing portion itself but with its combination with the claim(s) on which it depends.

b. A combination of “Y” documents obviously cannot be used for a dependent claim if the claim(s) on which it depends is/are not also called into question by the combination of “Y” documents or by one of them designated “X”.

## 3. Others

a. Category “Y” should not be used for one document only.

b. “Y” category documents relevant to the same claims should be cited in a successive order as much as possible.

c. Relevant documents should be assigned category “Y”, when a claim involves several options and the documents can be assigned in two ways, i.e. category “Y” or category “A” according to the contents of the options.

## D. SYMBOL “A”

### 1. Documents Which ~~Covers~~ Cover the Prior Art Portion

“A” is assigned to

a. a document intended to exemplify or delimit the prior art portion of an independent claim more satisfactorily, but there is no located document which in combination would have called into question the inventive step of a claim and therefore not calling itself the inventive step into question;

b. a document describing the background art, assumed to be known in the context of the introductory part of the description but not identified by precise citations.

2. Documents Which ~~Covers~~ Cover the Characterizing Portion

“A” is assigned to a document concerning the part of the features of a claim’s body or characterizing portion, but not calling the inventive step into question.

3. Other Type Documents

“A” is also assigned to a document describing the general technological background to the invention.

E. SYMBOL “E”

“E” is used when the document was filed before the international filing date ~~is~~ and was published ~~or granted~~ after the ~~application’s~~ international filing date.

“E” should always be accompanied by a symbol indicating the relevance of the document (“X”, “Y” or “A”).

F. SYMBOL “L”

The symbol “L” should be used for citing documents which are not otherwise designated by other symbols such as undated printed publications. The reason for citing the documents should be described next to the citation of the documents.

In the case where undated printed publications are cited, the examiner should point out the close similarity of the subject matter described to applicants claims and should indicate that the publications’ dates are being sought.

G. SYMBOL “O”

The symbol “O” is used to designate documents which contain information concerning prior oral disclosure, public use or other prior public knowledge on the invention.

“O” should always be accompanied by a symbol indicating the relevance of the document (“X”, “Y” or “A”).

H. SYMBOL “P”

The symbol “P” is used to designate documents having a publication ~~or grant~~ date prior to the filing date of the international application but after the priority date of the application.

“P” should always be accompanied by a symbol indicating the relevance of the document (“X”, “Y”, or “A”).

The symbol “T” is used to designate the documents which may be useful for a better understanding of the invention.