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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
UNITED INTERNATIONAL BUREAUX FOR THE PROTECTION OF INTELLECTUAL PROPERTY  
GENEVA

**PATENT COOPERATION TREATY**

**INTERIM COMMITTEE FOR TECHNICAL COOPERATION**

**Third Session: Tokyo, October 23 to 27, 1973**

PROGRESS REPORT ON THE INCLUSION IN THE  
PCT MINIMUM DOCUMENTATION OF PATENT DOCUMENTS  
REFERRED TO IN PCT RULE 34.1(c) (vi)

Report by the International Bureau

1. The PCT Interim Committee for Technical Cooperation (hereinafter referred to as "the Committee") during its first session in Geneva in February 1971, recommended in its program that the International Bureau of the World Intellectual Property Organization take steps to prepare, in cooperation with the national Offices of interested countries, an inventory of those English, French and German language patent documents, which under PCT Rule 34.1(c) (vi), may be expected to be placed at the disposal of each International Searching Authority.
2. It is recalled that Rule 34.1(c) (vi) provides for the inclusion in the "minimum documentation" of the International Searching Authorities of "such patents issued by, and such patent applications published in, any other country /i.e. other than the countries specifically named in Rule 34.1(c) (i) to (v) / after 1920 as are in the English, French or German language and in which no priority is claimed, provided that the national Office of the interested country sorts out these documents and places them at the disposal of each International Searching Authority".
3. Accordingly, Circular letter C.1220 was addressed to the national Offices of Australia (AU), Austria (OE), Belgium (BE), Canada (CA), Sri Lanka (Ceylon) (CL), India (IN), Ireland (EI), Israel (IL), Luxembourg (LU), Monaco (MC), New Zealand (NZ), Pakistan (PK), Philippines (RP), South Africa (ZA) and to the African and Malagasy Industrial Property Office (OAMPI) (AM) asking each of these Offices whether it was prepared to sort out such patent documents and, if so, from what date, with a view to subsequently placing them at the disposal of each of the International Searching Authorities.
4. Nine responses to Circular letter C.1220 were received (Circular letter C.1220 and the responses are reproduced in documents PCT/TCO/SS/I/2, Annex J and PCT/TCO/SS/I/9). Six Offices (AU, OE, CA, EI, RP, AM) indicated that they would be willing to sort out their respective documentation. The dates from which the documents would be sorted and the criteria for sorting varied from Office to Office. (See the table in Annex I for particulars of answers of any given Office.) Two Offices (LU, NZ) indicated that they do not print patent documents and one Office (PK) indicated that it was unable to sort its patent documents.
5. The Standing Subcommittee of the PCT Interim Committee for Technical Cooperation (hereinafter referred to as "the Standing Subcommittee") in the Report of its third session (see paragraphs 17(iv) and 75 of document PCT/TCO/SS/III/23)

asked the International Bureau to continue its work with respect to the patent documents referred to in Rule 34.1(c)(vi). The Committee during its second session in Geneva in October 1972 approved the progress made by the Standing Subcommittee with the survey and asked that in addition to the continuation of the survey, the Standing Subcommittee should draft an analysis as to the most suitable and practical methods for the identification of patent documents under Rule 34.1(c)(vi).

6. The International Bureau, in order to complete the survey, solicited responses from the Offices that did not previously reply. Letters were sent to the six Offices (BE, CL, IN, IL, MC, ZA) which had not responded to the Circular letter as well as to the national Office of the German Democratic Republic (DL) in which each was asked to estimate the number of their non-priority claiming patent documents as well as to state, without any commitment, whether their office would want their patent documents included in the PCT minimum documentation and would be willing to sort out and furnish such documents. Two Offices (OE, AM) which had previously indicated a willingness to sort and furnish their non-priority patent documents were asked to estimate the number of non-priority claiming documents to be found among their patent documents.

7. Five Offices (OE, BE, MC, ZA, AM) responded (see Annex II to PCT/TCO/SS/IV/8 for these responses). One Office (BE) indicated that it was unable to sort and make copies, one Office (MC) indicated that it would make copies as it would involve no more than several dozen per year, two Offices (OE, AM) indicated the number of the documents involved and one Office (ZA) indicated the number of documents involved and further offered to effect a sorting and compilation of a list.

8. The International Bureau has prepared a table summarizing all responses received to date (see Annex I to this document). Of the Offices responding positively to the letters and offering to sort and furnish their documents, it must be noted that some Offices speak of furnishing non-priority claiming patent documents while others speak of furnishing non-duplicative patent documents. By non-duplicative patent documents these Offices mean a patent document not claiming the earlier priority of another patent document and not serving as the basis of a priority claim in another published patent document. Several of the countries speak of non-duplicative patent documents but do not universally extend their search for duplicates e.g. Ireland looks only to United Kingdom patents and Philippines looks only to United States of America patents for duplicates.

9. It is noted in the Table of Annex I that of the sixteen Offices issuing patent documents in English, French or German language and not presently part of the PCT minimum documentation, nine print the complete specification, three (IL, RP, ZA) print only an abridgment of the invention or one or more claims and four (LU, MC, NZ, CL) do not print any more than the title, as far as disclosure of the invention is concerned. Of these last four Offices not printing their patents however at least two (MC, NZ) make copies of applications available to the public.

10. The total number of copies of patent documents presently committed to be furnished to the PCT International Searching Authorities is approximately 5,900 as of January 1, 1971 with an annual increase of approximately 2,700 documents for each year after that date. It should be noted that this figure may be significantly altered if industrial property offices which have at present either not responded or which are not yet in a position to make commitments, later decide to introduce their documents into the PCT minimum documentation.

11. In continuation of the survey the four Offices which have not as yet responded to the previous questionnaires and in particular the two Offices of the four which print patent documents might again be asked if they would want their patent documents included in the PCT minimum documentation. Furthermore, of the industrial property Offices involved in this study it is probable that a number of them already make their patent documents available to some prospective International Searching Authorities and need not furnish additional documents to these Offices. It would be of benefit to these Offices to know the extent to which their patent documents are already in the search files of such authorities and the extent to which they are continuing to be introduced into the search files. Such information, which is not available from previous studies conducted within the PCT or ICIREPAT Committees, could be obtained through use of an easily answered survey among the prospective International Searching Authorities. Once this information is obtained the industrial property offices which have already made commitments to contribute documentation can reduce the number of sets of copies they have to provide by the number of sets

which are already being transmitted to the prospective International Searching Authorities, and industrial property offices which have not as yet made such commitments may be in a better position, in view of a possible lesser demand for their documentation, to make such commitments.

12. Once a determination is made as to which documentation will be furnished, general plans for effecting the transfer of such documentation should be considered by the Standing Subcommittee as the usual bilateral arrangements now used to transfer or exchange patent documentation may not be acceptable in all situations.

13. As an aid to those Offices contemplating such sorting and listing of their documentation the International Bureau prepared an analysis containing a summary of possible different methods of effecting such a sorting and listing procedure. The analysis was considered by the Standing Subcommittee in its fourth session and as now presented (see Annex II to this document) contains the suggestions of the Standing Subcommittee.

14. The Committee is invited to comment on the above progress report and the annex and to approve the continuation of the survey.

/Annexes I and II follow/

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Annex I

INDUSTRIAL PROPERTY OFFICE	Summary of response to circular letter No. 1220 and/or letter of Nov/Dec 1972			Total documents to be introduced in PCT Minimum Documentation		Note
	Estimate of number of non- priority claiming documents (year)	Will office sort and furnish copies and for what years?	Type of documents to be furnished Number of documents involved	From period 1920- 1970	From period 1971 on/ year	
Australia	95,000-100,000 (1920-1970) 2,100*/year (1971 on)	(1920-1970) unknown (1971 on) yes	<u>non-priority claiming</u> - 2,100*/year	unknown	2,100*/year	prints specification
Austria	65,000 (1920-1972)	under considera- tion	under considera- tion	unknown	unknown	prints specification
Belgium	50,000 (1920-1971)	no	none to be furnished	0	0	prints specification
Canada	85,000 (1948-1971)	yes (1948-1971 on)	<u>non-duplicative</u> 4,400 + 360/year	4,400	360/year	prints specification
German Demo- cratic Rep.	—	no response	—	—	—	prints specification
India	—	no response	—	—	—	prints specification
Ireland	no estimate given	yes (1950-1971)	<u>non-duplicative</u> 300 to 400 + 20*/year	300-400	20*/year	prints specification
Israel	—	no response	—	—	—	prints abridg- ment, does not print specifi- cation
Luxembourg	10,000 (1920-1971)	under consideration	under consideration	0	0	does not print patent documents
Monaco	350* (1957-1971)	Documents already sorted and list available	<u>non-priority claiming</u>	unknown	30*/year	does not print patent documents
New Zealand	—	see Note	see Note	0	0	does not print patent documents
Pakistan	no estimate given	Office is unable to sort documents	—	0	0	prints specification
Philippines	2,200 (1948-1971)	yes (1948-1971)	<u>non-duplicative</u> 1,152 + 170/year	1,152	170*/year	prints abridg- ment, does not print specifi- cation
South Africa	30,039 (1952-1972)	Office will sort 1952-1972 and establish a list	unknown	unknown	unknown	prints claim or claims, does not print specification
Sri Lanka (Ceylon)	—	no response	—	—	—	does not print specification
OAMPI	410 (origin-1971)	yes (unknown)	unknown	unknown	unknown	prints specification

\* WIPO estimate

Annex II 5/11/72

SORTING AND LISTING DOCUMENTS REFERRED TO  
IN PCT RULE 34.1(c) (vi)

The Problem

1. The problem is to determine methods by which countries publishing or issuing English, French or German language patent documents which are not now prescribed as forming part of the PCT minimum documentation might be able to simply and easily determine which of those patent documents are non-priority claiming or even better which are non-duplicative so that copies of these documents could be sorted out, and introduced into the search files of the prospective International Searching Authorities as part of the PCT minimum documentation.

Definitions Used Herein

2. The following definitions are used in this document

- (a) "Non-priority claiming patent document" are those patent documents of any given country which do not claim the priority of an earlier filed patent application.
- (b) "Non-duplicative patent documents" are those patent documents of any given country which, among the "non-priority claiming" documents, do not serve as a basis for a priority claim in any later published patent document forming part of the PCT minimum documentation.

Manual Methods of Listing of Non-priority Claiming or Non-duplicative Patent Documents

3. The safest method of determining the "non-priority claiming" patent documents of any given country, provided the country published patent documents with priority information, is to physically examine every patent document as to the bibliographic data contained therein concerning priorities claimed. Any document claiming a priority is excluded. Thus a list would be established of the numbers of all documents not excluded i.e., not claiming a priority. Countries which either do not publish patent documents or, if they do publish patent documents, do not publish any priority information on such documents, will have to consult the sources found in the following paragraphs to establish a list of non-priority claiming patent documents. Making the selection from the patent documents themselves presents the additional advantage that at least one set of documents to be put at the disposal of an International Searching Authority can be prepared while going through the sorting process.

4. Quite obviously as the bibliographic elements concerning priority claims may be reproduced by itself or with other information in a Gazette, this source could equally serve as a source for generating a list of numbers of non-priority claiming patent documents.

5. Should neither the patent documents nor other publications contain the bibliographic information necessary to establish a list of non-priority claiming patent documents, the primary source of the information, i.e. the files of the applications, would have to be consulted in order to generate a listing of numbers of non-priority claiming patent documents.

6. Once a listing of non-priority patent documents has been established for any given country, a listing of non-duplicative patent documents can be derived therefrom by physically examining all other foreign patent documents forming part of the PCT minimum documentation and eliminating from the listing the number of any patent document which is duplicated by any such foreign patent document. While the determination of a listing of non-duplicative patent documents through a physical examination of all other foreign patent documents results in the elimination of some of the documents which are found in a listing of non-priority claiming patent documents, such a determination is extremely difficult and time consuming particularly when done by manual methods. The extent of the examination of foreign patent documents may be limited to the patent documents of only particular countries, such as Canada

looking at only patent documents of the United States of America or Ireland looking only at patent documents of the United Kingdom. This will result in the listing containing some numbers representing patents which are duplicated in countries whose documents have not been examined for priorities.

Mechanical Methods of Listing Non-priority Claiming or Non-duplicative Patent Documents

7. It is to be noted that any system based on the elimination of all patent documents claiming a priority suffers from a number of deficiencies with respect to lack of completeness in some areas and risk of duplication in other areas. Quite obviously the elimination of all patent documents claiming a priority will eliminate some patent documents, probably a very small percentage, which are not found among the seven minimum documentation countries patent documents. This may be due to the fact that even if the priority of a patent application in one of the seven minimum documentation countries was claimed, the document itself may never have been published. The fact that the priority of an application filed in a country which is not one of the seven PCT minimum documentation countries was claimed does not automatically make a patent document non-duplicative for purposes of PCT minimum documentation. As a rule, subsequent applications will in such cases have been filed in one or more of the PCT minimum documentation countries and may have led to a publication there.

8. The optimum selection of documentation from countries having English, French or German language patent documents other than the seven countries referred to in Rule 34.1(c) (i) to (v) would be to include all documents which are not duplicated in the documentation of the said seven countries or in documents of other countries which are added to PCT minimum documentation. A reduced list containing only such documents could be achieved through the use of patent-family-determining facilities such as the newly created International Patent Documentation Center (INPADOC) in Vienna. INPADOC as far as it inputs the bibliographic data from patent documents of the seven countries named in Rule 34, will be able to produce lists of numbers of patent documents which are non-duplicative in nature. This will of course be possible only for the period for which the data base is complete and therefore will probably not permit the coverage of a period extending more than several years back into the past.

9. A list of non-duplicative patent documents would be made up of all numbers of patent documents which are not members of a patent family supplemented by the number of patent documents members of patent families of which no other member is a patent document from one of the seven minimum documentation countries or from one of the additional countries whose patent documents are being included. Such a listing could easily be made through use of INPADOC's patent family service but, as stated above, only within the limits of its data base.

Use of Existing Records for Listing Non-priority Claiming or Non-duplicative Patent Documents

10. Other possible methods of determining the non-priority or non-duplicative patent document numbers may be to utilize information which exists presently in national industrial property Offices. Such information may be derived from records established by these Offices upon receipt of foreign patent documents to determine which are duplicative and should not be entered into their search files.

11. A survey might be conducted among the larger national industrial property Offices in order to ascertain whether such information exists which would readily permit the establishment of a listing of non-priority or non-duplicative English, French or German language patent documents from a country not one of the seven PCT minimum documentation countries.

12. Another method would be that, simultaneously with the preparation of the annual statistics of any given national Office for publication by WIPO, that Office would also make a listing of non-priority patent documents. One of the statistical figures which is furnished to WIPO annually by most Offices is the number of applications and grants claiming foreign priority. A national Office could at the same time that that number is ascertained make a listing of the non-priority patent documents. The possibility of combining these tasks might be further studied.