

WIPO



PCT/TCO/SS/I/17

ENGLISH ONLY

DATE: December 15, 1971

WORLD INTELLECTUAL PROPERTY ORGANIZATION

UNITED INTERNATIONAL BUREAUX FOR THE PROTECTION OF INTELLECTUAL PROPERTY

PATENT COOPERATION TREATY

INTERIM COMMITTEE ON TECHNICAL COOPERATION

STANDING SUBCOMMITTEE

First Session: Geneva, December 8 to 10, 1971

REPORT

INTRODUCTION

1. The Standing Subcommittee of the PCT Interim Committee for Technical Cooperation (hereinafter referred to as "the Standing Subcommittee"), set up by the Interim Committee in February 1971 (document PCT/TCO/I/6, paragraph 15), held its first session in Geneva from December 8 to 11, 1971.

2. The members of the Standing Subcommittee are the countries whose national industrial property Offices are prospective International Searching or International Preliminary Examining Authorities under the PCT, that is, Austria, Germany (Federal Republic), Japan, the Netherlands, the Soviet Union, Sweden, the United Kingdom and the United States of America. The International Patent Institute is also a member of the Standing Subcommittee. Brazil is an observer member of the Standing Subcommittee. All members were represented at this session. The list of participants is annexed to this Report.

3. The Standing Subcommittee unanimously elected Mr. R. Wahl (United States of America) as Chairman, and Mr. L. Komarov (Soviet Union) and Mr. D. Gay (United Kingdom) as Vice-Chairmen.

4. Mr. Klaus Pfanner, Senior Counsellor, Head of the Industrial Property Division, WIPO, acted as Secretary of the Subcommittee.

ADOPTION OF RULES OF PROCEDURE

5. The Standing Subcommittee decided that its Rules of Procedure would be those applicable to "ad hoc Committees of Experts," as provided for in the General Rules of Procedure of WIPO, subject to the understanding that the members other than the International Patent Institute would be States and would be represented by government-appointed delegations. The Standing Subcommittee also noted the information contained in paragraph 3 of document PCT/TCO/SS/I/5, subject to the understanding that the International Bureau agreed to provide for interpretation from and into Russian but no other language.

AGENDA

6. The Standing Subcommittee adopted its agenda as contained in document PCT/TCO/SS/I/1.Rev.

MINIMUM DOCUMENTATION: NATIONAL PATENT DOCUMENTS

7. Discussions were based on documents PCT/TCO/SS/I/2 and 9.

8. Upon an observation made by the Delegation of the Soviet Union, the Secretariat stated that (i) in future documents the adjective "German," used in connection with the patent documents of the Federal Republic of Germany, would be qualified accordingly and that the adjective "former" would be used whenever reference was made to the Reichspatentamt, and (ii) as to the identification of non-priority patent documents under PCT Rule 34.1(c)(vi), the Inventions Office of the German Democratic Republic would be approached as soon as its general situation in the context of WIPO had been clarified.

9. A number of observations were made on details of the inventories of national patent documents set out in the Annexes to document PCT/TCO/SS/I/2. These observations were noted by the Secretariat, which will take them into account in the preparation of any new edition of the said document.

10. In connection with the said Annexes, the Standing

Subcommittee discussed in particular:

(i) the feasibility and usefulness of identifying existing gaps in the serial numbers of national patent documents which were due to the fact that under certain individual serial numbers or groups of serial numbers no patent documents had been published;

(ii) the question whether the abridgments of patents published by the UK Patent Office, as well as design patents, Alien Property Custodian publications and defensive publications issued by the US Patent Office, should be considered "national patent documents" for the purposes of the PCT minimum documentation.

11. With respect to existing gaps in the serial numbers of national patent documents, some delegations were of the opinion that the establishment of lists of missing serial numbers for the national patent documents of the minimum documentation countries would be eminently useful for facilitating the task of the prospective PCT Authorities in checking the completeness of their collections. Others expressed the view that the elaboration of such lists was not indispensable. In conclusion, the Standing Subcommittee adopted the view that it would be useful, wherever practicable at low cost, to identify the existing gaps and establish lists of missing numbers. Several of the delegations expressed their willingness to furnish to the International Bureau lists of serial numbers for which no patent documents had been published.

12. In connection with the discussion of gaps in the serial numbers of national patent documents, the view was expressed that, if national Offices whose numbering system so allowed published for each serial number under which no patent document issued a separate sheet referring to that fact, the need to identify gaps could be avoided.

13. As to the question of the inclusion of the documents referred to in item (ii) of paragraph 10, the Standing Subcommittee expressed the view that the said documents should not be considered "national patent documents" for the purposes of the PCT minimum documentation and should consequently not be included in the inventories of national patent documents under Rule 34 of the PCT Regulations.

14. The Secretariat informed the Standing Subcommittee, at the latter's request, that the total number of patent documents

published between January 1, 1920, and mid-1971, falling under the definition of PCT minimum documentation (excluding any document which would fall under PCT Rule 34.1(c)(vi)), was estimated to be between 6.5 and 7 million, and that the annual future growth of that number was estimated to be around 500,000.

15. The Standing Subcommittee invited the International Bureau to improve the inventory of national patent documents contained in document PCT/TCO/SS/I/2 in the light of the observations made by the Standing Subcommittee, and to keep the information contained in the inventory up to date. With respect to the identification of gaps in serial numbers of national documents, the International Bureau was invited to undertake the task of establishing the lists of gaps within the limits referred to in paragraph 11, above.

16. With regard to the inventory of those English, French and German language documents which, under Rule 34.1(c)(vi) of the PCT Regulations, may be expected to be included in the PCT minimum documentation, the Standing Subcommittee invited the International Bureau to complete the survey so far undertaken and to establish an inventory of the national patent documents belonging to that category as well.

MINIMUM DOCUMENTATION: NON-PATENT LITERATURE

17. Discussions were based on documents PCT/TCO/SS/I/3, 12 and 15.

18. The definition of "non-patent literature" given in paragraph 2 of document PCT/TCO/SS/I/3 was noted with approval by the Standing Subcommittee, subject however to additionally considering that proceedings of periodic technical or scientific conferences, symposiums, etc., should also be included in the list of non-patent literature.

19. The question of a definition for the term "systematically used" in regard to the use of non-patent literature was discussed at length. It was suggested that distinctions might be made between periodicals circulated to examiners, periodicals used only as library material kept in the examining area, and periodicals from which articles are copied and inserted in classified search files.

20. Another question discussed at length was the determination of the criteria for selection of periodicals to be included in the minimum documentation. The following criteria were mentioned in addition to those applied in selecting the list in the Annex to document PCT/TCO/SS/I/3:

A. Frequency of use: (i) in classified search files, (ii) in central files, libraries, etc., (iii) by examiners for background information or current awareness, (iv) as library material kept in the examining area.

B. Frequency of citation.

C. Coverage of technical fields.

D. Coverage of languages.

21. A working group of the Standing Subcommittee was established to draft a questionnaire incorporating and expanding the criteria discussed above. That Working Group submitted to the Standing Subcommittee a draft questionnaire (see PCT/TCO/SS/I/15, Annex 1).

22. The Delegation of Germany (Federal Republic) suggested an alternative draft questionnaire (see PCT/TCO/SS/I/15, Annex 2) for consideration by the members of the Standing Subcommittee.

23. In view of the differences in approach to establishing the criteria of selection of non-patent literature expressed in the discussion, the Standing Subcommittee decided that the International Bureau should communicate with the prospective Authorities in order to gather information on the principal methods by which such Authorities selected non-patent literature for examiners and channelled it to them, and by which such literature was kept for recall when needed. On the basis of that information, the International Bureau should establish a draft questionnaire which, before being addressed to the members of the Standing Subcommittee, should be cleared with them or submitted for approval to the Standing Subcommittee.

24. The Secretariat stated that it would also welcome written comments and observations from the members of the Standing Subcommittee which would be useful in the preparation of the questionnaire.

25. Furthermore, the Standing Subcommittee decided that the

International Bureau should collect or establish statistics, based on sample batches of limited numbers of searched or examined patent documents pertaining to different fields of technology (distinguishing between "old" and "recent" fields), concerning the number of citations in respect of each of them of non-patent literature items and their proportion to the number of citations of published patent documents.

MINIMUM DOCUMENTATION: NON-PATENT LITERATURE
COOPERATION WITH THE INTERNATIONAL ATOMIC ENERGY AGENCY

26. Discussions were based on document PCT/TCO/SS/I/11.

27. With reference to paragraph 11 of the Annex to the said document, the Delegation of the United Kingdom stated that the UK Patent Office was also in a position to accept standing orders for newly issuing patent documents relating to specified fields of technology such as the peaceful application of nuclear energy.

28. The Standing Subcommittee noted with approval the report set forth in the document.

MINIMUM DOCUMENTATION: ABSTRACTING AND TRANSLATION
SERVICES FOR PATENT DOCUMENTS

29. Discussions were based on document PCT/TCO/SS/I/4.

30. The Standing Subcommittee noted with approval the definitions of "abstracting service" and "translation service" set forth in paragraphs 3 and 4, respectively, of that document.

31. In discussing the question of a minimum standard for abstracts, the Standing Subcommittee considered in particular the question whether abstracts should meet the criteria set forth in Rule 8 of the PCT Regulations. The Standing Subcommittee agreed that Rule 8 applied only to an abstract which was part of the international application whereas any other abstract, in order to be considered in the context in question, needed to consist of only as much information as to allow examiners to make a decision on the question whether the full text of the patent document was likely to contain material relevant to the search or examination.

32. The International Bureau noted the corrections to the Annexes submitted by several members of the Standing Subcommittee. They will be taken into account for the next edition of the document.

33. As to the questionnaire appearing in Annex III of the document, the Standing Subcommittee approved it, subject to the inclusion of the following additional points:

(i) physical characteristics of the abstract (separate sheets for each abstract, abstracts printed in periodicals, printed on one side of the page or both sides of the page, size of the page, size of type, etc.);

(ii) arrangement of and/or means of access to abstracts (chronological, sequencing, technological field grouping, classification grouping, company code grouping, etc.);

(iii) percentage represented by patent abstracts in the total of the abstracts of each service;

(iv) structure of fees, particularly as to whether entry or membership fee also required.

34. The Standing Subcommittee invited the International Bureau to incorporate the above additional points in the questionnaire and to distribute it to all known abstracting services. The Delegation of the United States of America gave the International Bureau a list of 96 abstracting services. The Chairman invited other members of the Subcommittee to furnish lists of abstracting services known to them.

35. The Standing Subcommittee further invited the International Bureau to continue the survey on abstracting and translation services with a view to updating the information collected, to provide the members of the Standing Subcommittee with specimens of the abstracts produced by the various services, and to ascertain the costs of the services to the prospective PCT Authorities as well as the future plans of those services.

PATENT ASSOCIATED LITERATURE (PAL)

36. Discussions were based upon document PCT/TCO/SS/I/6.

37. The Representative of INSPEC ("Information Services in Physics, Electrotechnology, Computers and Control," operated by the Institute of Electrical Engineers, London)* presented the proposal, summarized in the said document, for a system to facilitate access by national Offices to selected areas of non-patent literature ("Patent Associated Literature" (PAL) System). The full text of the proposal was distributed to the participants.

38. The proposal envisaged providing English language abstracts of articles published in periodicals, indexes, and a magnetic-tape service, with application of the International Patent Classification (IPC) to sub-group level. It also envisaged providing copies of the full texts of the articles if required by the national Offices; such a copy service would require negotiations to obtain the prior consent of the owners of the copyright in the articles copied, which, in the opinion of the Representative of INSPEC, was unlikely to be withheld.

39. The coverage of the PAL System would be developed in three phases. Phase 1 would be limited to the existing data base of INSPEC, which covered the fields of physics, electrical and electronics engineering, computers and control; in phase 2, the fields would be extended to include mechanical engineering. Extension into further fields (phase 3) would be based on cooperation with other organizations; so far as the chemical field was concerned, Chemical Abstracts Service (Columbus, Ohio, USA) had already expressed its willingness to cooperate.

40. The selection of documents likely to be relevant for the purposes of patent searches would be based on criteria to be established in close cooperation between INSPEC, the prospective PCT International Searching and Preliminary Examining Authorities, and the International Bureau. INSPEC currently scanned some 2,000 periodicals containing roughly 500,000

* INSPEC was represented by Mr. D.H. Barlow, Director; Mr. M.D. Martin, Systems Manager; and Mr. R.B. Cox, Product Development.

articles per year, from which some 125,000 articles were selected. It was expected that, during phase 1, about 15,000 items per year of patent associated literature would be selected from these articles on the basis of the criteria to be established. A similar service was currently being provided to the US Patent Office on the basis of criteria established by that Office. Under existing services, the normal period between publication of an article and issue of the INSPEC abstract was about 65 days.

41. Annual costs for the basic services during phase 1 were estimated at US \$20,000 per subscribing Office if three Offices subscribed (the minimum number practicable for INSPEC), or US \$10,000 if seven or more subscribed. The abstract sheets would cost US \$0.08 each. These estimates did not include the cost of copies of the full texts or of the inclusion of any drawings in the abstracts.

42. In the ensuing discussion, the Standing Subcommittee expressed its appreciation to the Representative of INSPEC for the presentation of the PAL proposal, which it considered to be of particular interest for the efforts of prospective PCT Authorities to solve the problem of non-patent literature within the framework of the PCT minimum documentation. The Standing Subcommittee stated its general approval of the principles of the proposal and was of the opinion that it merited further study.

43. The Standing Subcommittee expressed the view, however, that more information was needed before a decision could be made. In particular, the prospective Searching Authorities wished to have some practical experience with samples of abstracts.

44. Several delegations pointed to the need to have the full text of the article available together with the abstract since the latter's role was only to facilitate access to the full information which was always needed if the document was considered relevant for a particular search.

45. INSPEC was asked to study the possibility of reproducing on the abstract sheet itself the most significant drawing, if any, contained in the article.

46. After this discussion, the Representative of INSPEC made the following suggestions, which were welcomed by the Standing Subcommittee:

- (i) INSPEC will produce a sample output of two weeks (roughly 600 items) of its current service for the US Patent Office and will send a set to each member of the Standing Subcommittee and to the International Bureau.
- (ii) In addition, a sample of some 20 items will be prepared by INSPEC in a format corresponding to the envisaged output form of the PAL project. These items will be distributed as indicated in (i), above.
- (iii) The members of the Standing Subcommittee will evaluate the quality of the service and will make observations within three months from the receipt of the material referred to in (i) and (ii), above.
- (iv) INSPEC will discuss the question of a full-text copy service with the interested publishers and will inform the International Bureau about the outcome of such discussions.
- (v) INSPEC will explore the possibilities and the cost of including a drawing in the abstract and will inform the International Bureau accordingly.
- (vi) INSPEC will agree with the International Bureau on the detailed procedure to be followed for the tests and studies, and the International Bureau will inform the members of the Standing Subcommittee accordingly.
- (vii) The test material and other documents referred to above will be provided by INSPEC in late January or early February, 1972.
- (viii) INSPEC will negotiate with the International Bureau a draft agreement to be considered by the Standing Subcommittee. At the same time, INSPEC will directly approach members of the Standing Subcommittee in order to obtain expressions of intent to subscribe or, preferably, subscriptions to the PAL series.
- (ix) The PAL project could become operational within three or four months from the time it is endorsed by the Standing Subcommittee, the agreement between INSPEC and the International Bureau is concluded, and a sufficient number of subscribers is achieved.

47. The agreement to be concluded between the International Bureau and INSPEC would be merely concerned with principles and criteria, whereas the individual agreements between the national Offices and INSPEC would deal with the individual needs of each Office and the subscription fees.

PATENT DOCUMENTS SERVICE

48. Discussions were based on document PCT/TCO/SS/I/8.

49. The Delegations of Austria and of the International Patent Institute, as well as the Representative of Derwent Publications Ltd. (London)*, explained their written proposals.

50. The Standing Subcommittee then put questions to each of the three parties, to which they replied.

51. After a general discussion, tentative conclusions were presented to the Standing Subcommittee in document PCT/TCO/SS/I/14. The conclusions contained therein met with general approval, subject to certain amendments (which appear in the text of the decision as approved; see paragraph 52, below) and the following remarks:

(i) On the request of the Representative of Derwent, it was decided to emphasize its role through an express reference to Derwent in paragraph (d)(i) of the decision and note that Derwent was ready to give advice on the services to be marketed so that they meet also the needs of private customers.

(ii) Pursuant to a proposal by the Delegation of the Soviet Union, emphasizing the fact that the Austrian Government undertook responsibility for the project and the efficiency of the proposed Vienna Institute, it was decided expressly to refer to the responsibility of the said Government in paragraph (a)(i) of the decision.

(iii) The Delegation of Japan declared that the Japan Patent Information Center was ready to cooperate with the proposed Institute, and its declaration was noted with appreciation.

* Derwent was represented by Mr. M. Hyams (Managing Director, Derwent) and Mr. G. Cohen (Solicitor to Derwent).

(iv) Pursuant to a proposal by the Delegation of Germany (Federal Republic), it was decided that the investigations should include also microfilm aperture cards and the possibilities of coordination among the three parties in respect of their copy services, in particular concerning 16mm. microfilms.

52. Thereupon the Standing Subcommittee unanimously adopted the following decision:

"(a) The Standing Subcommittee of the PCT Interim Committee for Technical Cooperation decides to invite the Director General of WIPO to continue negotiations with the Austrian Government, with the International Patent Institute (IIB) and with Derwent Publications Ltd., London (Derwent), upon the following basis and with the following aims:

"(i) the Patent Documents Service ("Service") should, to the greatest possible extent in cooperation with the IIB, be operated by an Institute to be established by and under the responsibility of the Austrian Government in Vienna ("proposed Institute"); the role of WIPO should be along the lines proposed by the Austrian Government in its reply to the WIPO questionnaire;

"(ii) the IIB should produce the computer input of the bibliographic data of the countries it needs for its own services, whereas the proposed Institute should produce the computer input of the bibliographic data of all other countries;

"(iii) the proposed Institute and the IIB should agree on compatible carriers for the information and each should exchange with the other the input and output produced by it; should the value of the contribution of one substantially exceed that of the contribution of the other, a formula for compensating the difference should be worked out;

"(iv) the data should comprise those described in the WIPO questionnaire, including the IPC symbols where available; national classification symbols, titles of inventions, and names of applicants, patentees, inventors or assignees would not be included;

"(v) arrangements should be made between the proposed Institute and the IIB for common development of the computer software and for reciprocally licensing the use of future developments and improvements achieved by either party;

"(vi) the proposed Institute and the IIB should, each as far as it is concerned, enjoy full freedom to use, exploit and sell the products of their separate or cooperative efforts.

"(b) The question should be explored whether the proposed Institute and the IIB could not arrive at an arrangement with Derwent, particularly in the field of marketing.

"(c) As part of these negotiations, the International Bureau of WIPO should contact:

"(i) the main national Offices and documentation centers, to explore the extent to which and the ways and means by which they could facilitate the tasks of the Service, particularly by furnishing data in machine-readable form, and the conditions under which they would be willing to furnish such data;

"(ii) the Austrian Patent Office, the IIB and Derwent, to explore the possibilities of coordination among them in furnishing copy services (paper, microfilm, aperture cards).

"(d) The Director General of WIPO should convene the Standing Subcommittee as soon as the negotiations have sufficiently advanced in order to:

"(i) inform the Standing Subcommittee of the detailed plans, including in particular the coverage of the countries by the Service, the timetable for the initiation of the Service, the cooperation of the IIB with the proposed Institute, the role of national Offices and documentation centers, the role of Derwent, and the costs of the operations and services;

"(ii) submit to the Standing Subcommittee for approval any draft agreement to which the International Bureau would be party;

"(iii) inform the Standing Subcommittee of the results of the explorations concerning copy services."

UNIFORMITY IN DOCUMENTATION AND WORKING METHODS:
METHODS OTHER THAN INFORMATION MEETINGS
AND TEST SEARCHES

53. Discussions were based on documents PCT/TCO/SS/I/7 and 10.

54. While recognizing the usefulness of test searches, of an exchange of examiners and of information meetings, and while agreeing to maintain these items on the program, the Standing Subcommittee expressed the opinion that priority should be given to the task of completing the minimum documentation and arranging it in a way that would facilitate the establishment of uniformly high quality search reports.

55. As to the exchange of examiners, the International Bureau was invited to collect information concerning the experience obtained from bilateral exchange programs carried out by certain national Offices in recent years.

56. The Standing Subcommittee noted with appreciation the offer of the German Patent Office to make a report on its experience in performing "isolated searches," similar to the expected PCT searches, and invited the International Bureau to circulate that report to the prospective PCT Authorities.

57. The IIB also agreed to make a report on its experience with "isolated searches," it being understood that the IIB report would also cover such searches made for the Netherlands Patent Office and would be established after the report of the German Patent Office was available.

58. The Standing Subcommittee, having noted that the International Bureau already disposed of some information on the search methods of various examining Offices in the framework of ICIREPAT, invited the International Bureau to extract such information as might be useful in connection with the exploration of the possibilities of establishing uniform search methods among PCT Authorities, and to present such information to the Standing Subcommittee.

NEXT SESSION

59. The Subcommittee decided to hold its next session on April 6 and 7, 1972, at the Headquarters of WIPO in Geneva, mainly, if not exclusively, to deal with developments in the Patent Documents Service project.

60. This Report was unanimously adopted by the Subcommittee at its meeting of December 11, 1971.

/List of Participants follows/

ANNEX

LIST OF PARTICIPANTS

I. FULL MEMBERS OF THE STANDING SUBCOMMITTEE

AUSTRIA

T. LORENZ, Vorsitzender Rat, Austrian Patent Office, Vienna
O. SIMMLER, Director, State Library, Vienna
W.W. TABARELLI, Expert, Ministry of Finance, Vienna
G. GALL, Commissaire, Ministry of Commerce and Industry,
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GERMANY (FEDERAL REPUBLIC)

R. SINGER, Abteilungspräsident, German Patent Office, Munich
A. WITTMANN, Abteilungspräsident, German Patent Office, Munich
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NETHERLANDS

J. DEKKER, Vice President, Netherlands Patent Office, The Hague

SOVIET UNION

L. KOMAROV, Director, All-Union Research Institute of State
Patent Examination, Committee for Inventions and Discoveries
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I. TCHERVIAKOV, Deputy Director, Central Institute of Patent
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T. NEMANOVA (Mrs.), Head of Division, All-Union Research
Institute of State Patent Examination, Committee for Inven-
tions and Discoveries attached to the Council of Ministers
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UNITED KINGDOM

D.G. GAY, Superintending Examiner, Patent Office, London

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E.G. MISEY, Legal Adviser, US Permanent Mission, Geneva

INTERNATIONAL PATENT INSTITUTE

G. FINNISS, Director General, The Hague

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G. PUTZ, Head of Mechanization Section, The Hague

II. OBSERVER MEMBER OF THE STANDING SUBCOMMITTEE

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L.A. de ARAUJO CASTRO, Third Secretary, Permanent Mission of Brazil, Geneva

III. WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

Professor G.H.C. BODENHAUSEN, Director General

Dr. Arpad BOGSCH, First Deputy Director General

K. PFANNER, Senior Counsellor, Head of the Industrial Property Division

I. MOROZOV, Head of the PCT Section, Industrial Property Division

P. CLAUS, Technical Counsellor, Head of the ICIREPAT Section, Industrial Property Division

C. WERKMAN, Project Officer, PCT Section, Industrial Property Division

N. SCHERRER, Project Officer, PCT Section, Industrial Property Division

P.M. McDONNELL (Miss), US Patent Office

IV. OFFICERS OF THE STANDING SUBCOMMITTEE

CHAIRMAN: R.A. WAHL (United States of America)
VICE-CHAIRMEN: L. KOMAROV (Soviet Union), D.G. GAY (United
Kingdom)
SECRETARY: K. PFANNER (WIPO)

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