International Search

3257

7. Where the international application is so unclear that a meaningful search cannot be carried out, the International Searching Authority will make a declaration that it will not establish a search report. The same will occur if the subject matter of the invention falls into one of six categories listed in Rule 39 which the International Searching Authority may refuse to search. Examples are scientific theories, diagnostic methods, and computer programs.

8. The International Searching Authority examines whether the application complies with the requirement of unity of invention. As stated above, this means that the international application must either relate to only one invention or to a group of inventions which are so linked that they form a single general inventive concept.

9. If the International Searching Authority finds that unity of invention is lacking, it will invite the applicant to pay an additional search fee for each further invention claimed in the international application. The search report will in that case only be established for those inventions for which a search fee or an additional search fee has been paid unless the search examiner is able to make a complete search for all inventions with negligible additional work. No invitation to pay additional search fees should be issued in such a case. The decision not to ask for the payment of additional search fees, however, does not prevent any national office from raising the question of lack of unity of invention and from applying Rule 13 when deciding to grant (or refuse) a patent.

10. The International Searching Authority must, as a rule, establish the international search report within three months from the receipt of the search copy sent to it by the receiving Office or within nine months from the priority date, whichever expires later.

11. The international search report contains the citations of the documents considered to be relevant, the classification of the subject matter of the invention according to the International Patent Classification and an indication of the fields searched. The international search report does not contain any expression of opinion, argument or explanation. The evaluation of the search results is entirely left to the phase of the procedure devoted to substantive examination. However, it identifies the claims to which cited documents are relevant and contains also an indication of the Category of the cited document, in particular, whether it is of particular relevance with respect to the novelty or inventive step of the invention.

12. The International Searching Authority transmits copies of the international search report to the applicant and to the International Bureau. Copies of the documents cited in the international search report are usually enclosed with the mailing of the report to the applicant.

International Search (continued)

- The International Search Report (ISR) is mailed to the applicant and to the IB.
  - If priority is claimed, the ISR is issued at approximately 16 months from earliest priority date.
  - If no priority is claimed, the ISR is issued within 9 months of the international filing date.



30.01.96

Purpose of the International Search

"The Objective of the international search is to discover relevant prior art." (Article 15)



30.01.96

Chapter I Relevant Prior Art (Rule 33) (continued)

- Rule 33 also defines two "special" types of relevant prior art for Chapter I search purposes.
  - A previous oral disclosure, use, or exhibition.
  - Later patents or published patent applications having earlier filing or priority dates.

30.01.96

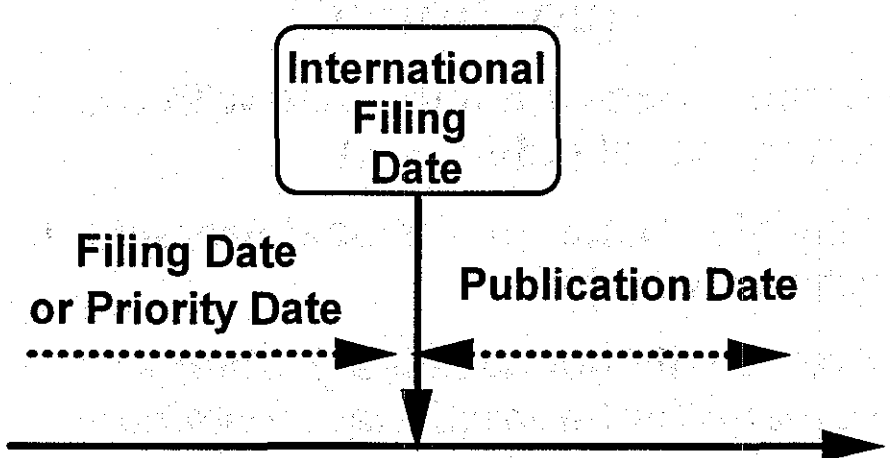
Previous Oral Disclosure, etc.

- A written disclosure
  - which refers to a previous oral disclosure, use, exhibition or other means whereby the contents of the written disclosure were made available to the public,
  - having a publication date ***on or after*** the international filing date,
  - wherein the making available to the public occurred ***before*** the international filing date.
- Cited on the search report as an "O" type document.

30.01.96

"E" Reference

US or Foreign Patent or Published Patent Application



30.01.96

Opportunity To File Amendments During Chapter I

- Only the claims may be amended.
  - Not the description
  - Not the drawings
  - Not the title or abstract
- One opportunity only.
- Normally filed within two months of the transmittal of the ISR to the applicant.
- Must be filed directly with the IB.
  - Do not file with RO
  - Do not file with ISA

30.01.96

Unity of Invention Procedures

- The ISA will invite the applicant to pay the supplemental search fees.
  - ISA/EP will search the main invention and send the results of this search with the invitation to pay supplemental search fees.
  - ISA/US normally sends the invitation without any partial search.
  - If there is a USPTO deposit account indicated in the application papers, ISA/US may make the invitation by telephone.



30.01.96

Unity of Invention Procedures (continued)

- The applicant may pay the supplemental search fees under protest.
- The applicant does not have to pay any of the requested supplemental search fees.



30.01.96

Protest Procedures (continued)

- If the ISA finds that the invitation was not justified or only partly justified, all or a portion of the supplemental search fees will be refunded.
- The ISA may ask for an additional fee to consider the protest.
  - ISA/US does not require such a fee.
  - ISA/EP may require a protest fee under certain circumstances.



30.01.96

Protest Procedures (continued)

- The applicant may request that the text of both the protest and the decision thereon be sent to the designated Offices together with the international search report (Rule 40.2(c)).
- The designated Offices may require a translation of the protest and any decision thereon.



30.01.96

Category

- Documents considered to be of "particular relevance" are identified by using the categories "X" or "Y."
- Other categories for cited documents are "A," "O," "E," "P," "T," "L," and "&."

30.01.96

An "X" Reference* Is One That Defeats

- Novelty or
- Inventive Step when considered by itself, i.e., where the missing element(s) would have been obvious to one skilled in the art without citation of other documents.

* See Section 505 of the Administrative Instructions

30.01.96

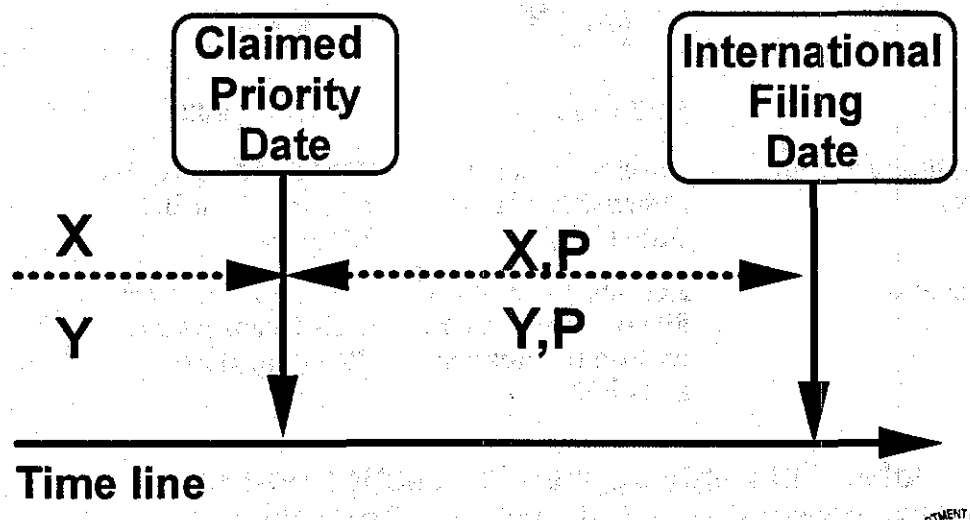
The "P" Category*

- This is a used in addition to other categories, e.g. "X,P" or "Y,P."
- A reference cited in the ISR is additionally categorized as a "P" reference if its publication date is earlier than the international filing date but later than the priority date.

* See Section 507(d) of the Administrative Instructions

30.01.96

Consider the Publication Date of the Reference



"P" references include journal articles, abstracts, books, patents and published patent applications.

30.01.96

Excluded Subject Matter *

- No International Searching Authority is required to search the following subject matter:
  - scientific and mathematical theories,
  - plant or animal varieties or essentially biological processes for the production of plants and animals, other than microbiological processes and the products of such processes,
  - schemes, rules or methods of doing business, performing purely mental acts or playing games,

* See Article 17 and Rule 39

30.01.96

Excluded Subject Matter (continued)

- No International Searching Authority is required to search the following subject matter:
  - methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods,
  - mere presentations of information, and
  - computer programs to the extent that the International Searching Authority is not equipped to search prior art concerning such programs.

30.01.96

PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

To: JOHN J. SMITH
220 JEFFERSON AVENUE
ARLINGTON, VIRGINIA 22202

PCT

NOTIFICATION OF TRANSMITTAL OF THE INTERNATIONAL SEARCH REPORT OR THE DECLARATION

(PCT Rule 44.1)

Applicant's or agent's file reference CMC-123-PCT	Date of Mailing *(day/month/year)* **FOR FURTHER ACTION** See paragraphs 1 and 4 below
International application No. PCT/US95/99999	International filing date *(day/month/year)* 02 OCTOBER 1995
Applicant Columbia Marine Corporation	

1. [X] The applicant is hereby notified that the international search report has been established and is transmitted herewith.

Filing of amendments and statement under Article 19:
The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46).

When? The time limit for filing such amendments is normally 2 months from the date of transmittal of the international search report; however, for more details, see the notes on the accompanying sheet.

Where? Directly to the International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland
Facsimile No.: (41-22) 740.14.35

For more detailed instructions, see the notes on the accompanying sheet.

2. [ ] The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect is transmitted herewith.

3. [ ] **With regard to the protest** against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:

[ ] the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.

[ ] no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. **Further action(s):** The applicant is reminded of the following:

Shortly after **18 months** from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in rules 90 *bis* 1 and 90 *bis* 3, respectively, before the completion of the technical preparations for international publication.

Within **19 months** from the priority date, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until 30 months from the priority date (in some Offices even later).

Within **20 months** from the priority date, the applicant must perform the prescribed acts for entry into the national phase before all designated Offices which have not been elected in the demand or in a later election within 19 months from the priority date or could not be elected because they are not bound by Chapter II.

Name and mailing address of the ISA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231	Authorized officer PAUL A. BELL
Facsimile No. (703) 305-3230	Telephone No. (703) 308-3000

INTERNATIONAL SEARCH REPORT

International application No.
PCT/US95/99999

Box I Observations where certain claims were found unsearchable (Continuation of item 1 of first sheet)

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

1. ☐ Claims Nos.:
because they relate to subject matter not required to be searched by this Authority, namely:

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

3. ☐ Claims Nos.:
because they are dependent claims and are not drafted in accordance with the second and third sentences of Rule 6.4(a).

Box II Observations where unity of invention is lacking (Continuation of item 2 of first sheet)

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

Please See Extra Sheet.

1. ☒ As all required additional search fees were timely paid by the applicant, this international search report covers all searchable claims.

2. ☐ As all searchable claims could be searched without effort justifying an additional fee, this Authority did not invite payment of any additional fee.

3. ☐ As only some of the required additional search fees were timely paid by the applicant, this international search report covers only those claims for which fees were paid, specifically claims Nos.:

4. ☐ No required additional search fees were timely paid by the applicant. Consequently, this international search report is restricted to the invention first mentioned in the claims; it is covered by claims Nos.:

Remark on Protest

☐ The additional search fees were accompanied by the applicant's protest.

☒ No protest accompanied the payment of additional search fees.

INTERNATIONAL SEARCH REPORT

International application No.
PCT/US95/99999

A. CLASSIFICATION OF SUBJECT MATTER

IPC(6) :B63H 25/02, B63H 25/04
US CL :114/144.3, 144, 39; 340/987
According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

U.S. : US Class 114/144.3, 144, 39, 142,145; 340/987, 226

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

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X --- Y	US, A, 3,880,104 (SAYE) 29 April 1975 (29.04.75), figure 1, column 4, lines 3 - 27.	1 ------ 2 - 4
Y	GB, A, 392,415 (JONES) 18 May 1933 (18.05.33) page 3, lines 5 - 7, figure 5--support 36.	2 - 4
A	H. Water, "Sailboat Construction," Volume 2, published 1974, Sweet and Maxwell (London) pages 138 to 192, especially pages 146 - 148.	1 - 4
A,P	IBM Technical Disclosure Bulletin, Volume 17, No. 6, May 1995 (Armonk, New York) , J. P. Green, "Integrated Circuit and Electronic Coompass," pages 1344 - 1345.	7 - 12

☐ Further documents are listed in the continuation of Box C. ☐ See patent family annex.

*	Special categories of cited documents:	"T"	later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
"A"	document defining the general state of the art which is not considered to be of particular relevance	"X"	document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
"E"	earlier document published on or after the international filing date	"Y"	document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
"L"	document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)	"&"	document member of the same patent family
"O"	document referring to an oral disclosure, use, exhibition or other means		
"P"	document published prior to the international filing date but later than the priority date claimed		

Date of the actual completion of the international search	Date of mailing of the international search report
08 FEBRUARY 1996	
Name and mailing address of the ISA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231 Facsimile No. (703) 305-3230	Authorized officer PAUL A. BELL Telephone No. (703) 308-3000

D | International Searching Authorities | D

US | UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO) | US

Search fee (PCT Rule 16):[1]	US Dollar (USD) 660 (430)[2] Swiss Franc (CHF) 740 (480)[2] The amount in parentheses is payable when a corresponding prior US national application has been filed and the basic national fee paid
Additional search fee (PCT Rule 40.2):[3]	USD 190[2]
Fee for copies of documents cited in the international search report (PCT Rule 44.3):[3]	None; applicant receives, together with the international search report, a copy of each document cited therein
Conditions for refund and amount of refund of the search fee:	Money paid by mistake, without cause, or in excess, will be refunded Where the international application is withdrawn or is considered withdrawn, under PCT Article 14(1), (3) or (4), before the start of the international search: refund of 100%
Languages accepted for international search:	English. International applications filed in Spanish at the Mexican Patent Office as receiving Office are acceptable for international search on the basis of a translation prepared under the responsibility of that Office (PCT Rule 12.1(c)).
Requirements concerning nucleotide and/or amino acid sequence listing:	A sequence listing must comply with WIPO Standard ST.23 (See PCT Gazette No. 20/1992, pages 8465 to 8485) and be presented in machine readable form as provided in Annex C of the PCT Administrative Instructions (see PCT Gazette No. 15/1992)
Subject matter that will not be searched:	The subject matter specified in items (i) to (vi) of PCT Rule 39.1 with the exception of subject matter which is searched in US national applications

[1] This fee is payable to the receiving Office in the currency or one of the currencies accepted by it (see Annex C).

[2] The amounts of these fees change periodically. The International Searching Authority or the Official Gazette of the United States Patent and Trademark Office should be consulted for the applicable amounts.

[3] This fee is payable to the International Searching Authority and only in particular circumstances.

Conditions for refund and amount of refund of the search fee:	Money paid by mistake, without cause, or in excess, will be refunded Where the international application is withdrawn or is considered withdrawn, under PCT Article 14(1), (3) or (4), before the start of the international search: refund of 100% Where the international search report is based on an earlier search (including a privately commissioned «standard» search) already made by the Authority on an application whose priority is claimed for the international application, the following refund is made: - no supplementary search performed: refund of 100% - supplementary search performed in the documentation relating to one or more subdivisions consulted in the earlier search or extended to one or more subdivisions not yet consulted: refund of 75% - supplementary search performed in the documentation relating to one or more subdivisions already consulted and extended to one or more subdivisions not yet consulated: refund of 50% - supplementary search performed in the documentation relating to subdivisions concerning a new aspect of the invention claimed (for instance, cases where the international application is based on several earlier applications only one of which was the subject of an earlier search report): refund of 25%
Protest fee (PCT Rule 40.2(e)):	Deutsche Mark (DEM)[7] 2,000
Languages accepted for international search:	English, French, German and, where the international application is filed with the Patent Offices of Belgium or the Netherlands, Dutch. International applications filed in Spanish at the Mexican Patent Office as receiving Office are accepted for international search on the basis of a translation prepared under the responsibility of that Office (PCT Rule 12.1(c)).
Requirements concerning nucleotide and/or amino acid sequence listing:	A sequence listing must comply with WIPO Standard ST.23 (see PCT Gazette No. 20/1992, pages 8465 to 8485) and be presented on an electronic data carrier (diskette), as provided in Annex C of the PCT Administrative Instructions (see PCT Gazette No. 32/1992, Section IV, and also OJ EPO 12/1992, Supplement No. 2)
Subject matter that will not be searched:	The subject matter specified in items (i) to (vi) of PCT Rule 39.1 with the exception of all subject matter which is searched under the European patent grant procedure.

[7] For the equivalent amounts in currencies other than DEM, reference should be made to the latest issue of the OJ EPO.

D International Searching Authorities D

EP EUROPEAN PATENT OFFICE (EPO) EP

Search fee (PCT Rule 16):[1]	Deutsche Mark (DEM)	2,400
	Pound Sterling (GBP)[2]	1,104
	French Franc (FRF)[2]	8,730
	Swiss Franc (CHF)[2]	2,040
	Netherlands Guilder (NLG)[2]	2,740
	Swedish Krona (SEK)[2]	12,700
	Belgian/Luxembourg Franc (BEF/LUF)[2]	50,300
	Lira (ITL)[2]	2,963,000
	Austrian Schilling (ATS)[2]	17,140
	Peseta (ESP)[2]	225,800
	Greek Drachma (GRD)[2]	400,000
	Danish Krone (DKK)[3]	9,840
	Portuguese Escudo (PTE)[3]	258,800
	Irish Pound (IEP)[3]	1,103
	Canadian Dollar (CAD)[3]	2,300
	Finnish Markka (FIM)[3]	7,500
	Icelandic Kronur (ISK)[3]	108,100
	Japanese Yen (JPY)[3]	169,000
	Malawi Kwacha (MWK)[3]	25,440
	Norwegian Krone (NOK)$_3$	10,660
	New Zealand Dollar (NZD)[3]	2,557
	Singapore Dollar (SGD)[3]	2,440
	US Dollar (USD)[3]	1,700
Additional search fee (PCT Rule 40.2):[4]	Same amounts as above in DEM, GBP, FRF, CHF, NLG, SEK, BEF/LUF, ITL, ATS, ESP, GRD, DKK, PTE or IEP	
Fee for copies of documents cited in the international search report (PCT Rule 44.3):	For applicants: none; applicant receives, together with the international search report, a copy of each document cited therein For designated Offices: DEM 1.30 per page[5]	
Fee for translation into English of the international application (PCT Rule 48.3(b)):[6]	Per 100 words of the original text: DEM 40 or NLG 45 or BEF 850	

[continued on next page]

[1] This fee is payable to the receiving Office in the currency of one of the currencies accepted by it (sse Annex C). This fee can be reduced by three-quarters for national of developing countries, in accordance with the decision of the EPO's Administrative Council of December 9, 1983, as amended on June 8, 1984 (see PCT Gazette, No. 25/1984, page 3097) and for nationals of "countries in transition" ("reform states"), according to the decision of the same Council of December 15, 1994 (see PCT Gazette No. 27/1995, page 10744). At present, nationals of developing countries and of the "countries in transition" may request such a fee reduction where the international application is filed, as applicable, with the receiving Office of or acting for the following developing countries: Barbados, Benin, Brazil, Burkina Faso, Cameroon, Central African Republic, Chad, Congo, Côte d'Ivoire, Gabon, Guinea, Kenya, Lesotho, Malawi, Mali, Mauritania, Mexico, Niger, Senegal, Singapore, Sri Lanka, Sudan, Swaziland, Togo, Uganda and Viet Nam, and for the following "countries in transition": Albania, Armenia, Belarus, Bulgaria, Czech Republic, Estonia, Georgia, Hungary, Kazakstan, Latvia, Lithuania, Poland, Republic of Moldova, Romania, Russian Federation, Slovakia, Slovenia, Tajiskstan, Ukraine and Uzbekistan.

[2] The equivalent amounts in currencies other then DEM are subject to change, due to currency fluctuations. For the current amount, reference should be made to the latest issue of the OJ EPO .

[3] The equivalent amounts in currencies other than DEM are subject to change due to currency fluctuations. For the current amount, reference should be made to the latest issue of the PCT Gazette or the PCT Newsletter.

[4] This fee is payable to the International Searching Authority and only in particular circumstances. The second and third sentences of footnote 1 also apply.

[5] For the equivalent amounts in currencies other than DEM, reference should be made to the latest issue of the OJ EPO.

[6] This fee is payable to the International Searching Authority and only in particular circumstances.

INTERNATIONAL SEARCH REPORT

International application No.
PCT/US95/99999

BOX II. OBSERVATIONS WHERE UNITY OF INVENTION WAS LACKING
This ISA found multiple inventions as follows:

This application contains the following inventions or groups of inventions which are not so linked as to form a single inventive concept under PCT Rule 13.1. In order for all inventions to be examined, the appropriate additional examination fees must be paid.

Group I, claim(s)1 - 6, drawn to a sailboat self-steering gear.
Group II, claim(s) 7 - 12, drawn to a compass with an alarm to indicate deviation from a planned course.

The inventions listed as Groups I and II do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature of the Group I invention is the claimed self-steering gear which is not present in the Group II invention. The special technical feature of the Group II invention is the claimed alarm, which is not present in the Group I invention.

INTERNATIONAL SEARCH REPORT

International application No.
PCT/US95/99999

Box III TEXT OF THE ABSTRACT (Continuation of item 5 of the first sheet)

The technical features mentioned in the abstract do not include a reference sign between parentheses (PCT Rule 8.1(d)).

NEW ABSTRACT

A wind vane steering gear (10) for a sailboat (1) comprising a bracket (11) adapted for attachment to the bow of the sailboat for pivotally supporting a forward rudder (12), and a wind vane (42) adjustable to different positions by means of an actuating member (65) to control the position of the rudder.

VII.22

PATENT COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference CMC-123-PCT	**FOR FURTHER ACTION**	see Notification of Transmittal of International Search Report (Form PCT/ISA/220) as well as, where applicable, item 5 below.
International application No. PCT/US95/99999	International filing date *(day/month/year)* 02 OCTOBER 1995	(Earliest) Priority Date *(day/month/year)* 03 OCTOBER 1994
Applicant Columbia Marine Corporation		

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

This international search report consists of a total of ____ sheets.

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

1. [ ] **Certain claims were found unsearchable** (See Box I).

2. [X] **Unity of invention is lacking** (See Box II).

3. [ ] The international application contains disclosure of a **nucleotide and/or amino acid sequence listing** and the international search was carried out on the basis of the sequence listing

   [ ] filed with the international application.

   [ ] furnished by the applicant separately from the international application,

      [ ] but not accompanied by a statement to the effect that it did not include matter going beyond the disclosure in the international application as filed.

   [ ] transcribed by this Authority.

4. With regard to the **title**,

   [X] the text is approved as submitted by the applicant.

   [ ] the text has been established by this Authority to read as follows:

5. With regard to the **abstract**,

   [ ] the text is approved as submitted by the applicant.

   [X] the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. The figure of the **drawings** to be published with the abstract is:

   Figure No. 1

   [X] as suggested by the applicant.

   [ ] because the applicant failed to suggest a figure.

   [ ] because this figure better characterizes the invention.

   [ ] None of the figures.

Excluded Subject Matter In ISA/US

- The United States Patent and Trademark Office has declared that it will search and examine all subject matter searched and examined in US national applications. (MPEP 1849)

30.01.96

Procedure Where An International Search Cannot Or Will Not Be Made.

- If none of the claims in the international application can be searched, the examiner will declare that no international search report will be established using form PCT/ISA/203.
- If only some of the claims are affected, an international search report will be prepared on the remaining claims and the applicant will be notified therein that certain claims were not searched.

30.01.96

Other Categories*

- "T" reference - principle or theory
- "L" reference - casts doubt on priority claim
- "&" reference - member of a patent family

* See MPEP, Appendix AI, Section 507.

30.01.96

PCT Practice v. US Practice

	PCT	US
Basis	PCT Rule 33	35 U.S.C. 102
Applicant's own work	Published before International Filing Date (IFD)	Published more than 1 year before US Filing Date
Public use	Act occurred before IFD but described in written disclosure after IFD	Act occurred more than 1 year before US Filing Date

Note: This only applies to practice before the International Authorities. Once the US National Stage has been entered, US law determines prior art and the conditions for patentability.

30.01.96

A "Y" Reference* Is One That Defeats

- Inventive Step when combined with one or more other references.

* See Section 505 of the Administrative Instructions

30.01.96

The "A" Reference*

- This is a reference which is not of particular relevance but which defines the general state of the art.

* See Section 507(c) of the Administrative Instructions

30.01.96

The International Search Report

- Form PCT/ISA/210 is the form used for the international search report.
- Form PCT/ISA/220 is attached as an "address sheet."



30.01.96

Citation of Documents in the PCT/ISA/210

- The "Documents Considered To Be Relevant" section is the most important portion of the international search report.
- It has three portions entitled
  - Category
  - Citation of document, ...
  - Relevant to claim No.



30.01.96

Consequences of Failure to Pay Supplemental Search Fees

- The inventions not paid for will not be searched but will remain in the international application.
- The International Preliminary Examining Authority is not required to examine claims directed to an invention which was not searched.

30.01.96

Protest Procedures (Rule 40.2)

- The applicant has no right to protest the lack of unity holding regarding any invention for which supplemental search fees have not been paid.
- When a protest accompanies the payment of supplemental search fees, the ISA will:
  - search the invention(s) covered by the supplemental search fees and
  - consider the protest.

30.01.96

Opportunity To File Amendments During Chapter I (continued)

- Amendments are published with the international publication.
- May give better provisional protection, where available.
- Are usually not necessary when a demand for international preliminary examination is filed.

30.01.96

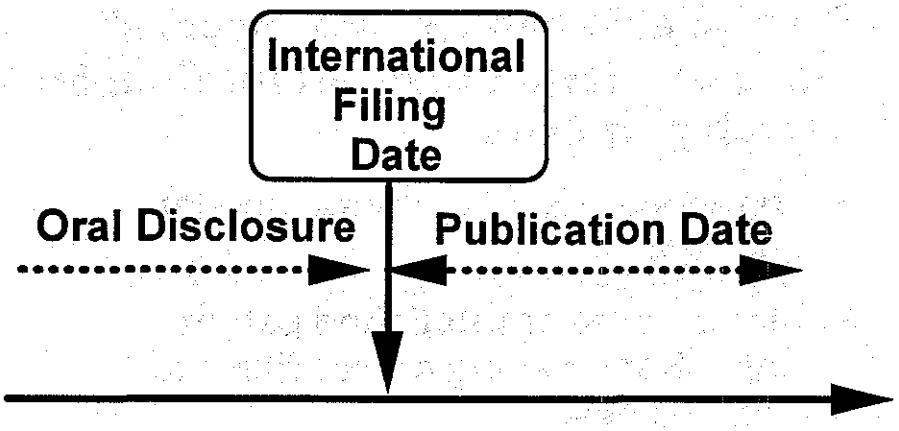
Lack of Unity of Invention (Rule 40)

- The unity of invention criteria are set forth in:
  - Rule 13 and
  - Annex B to the Administrative instructions.
- Where multiple inventions are claimed in the international application:
  - the first claimed invention will always be searched and
  - additional inventions may be searched if supplemental search fees are paid.

30.01.96

"O" Reference

Written Document Describing an Earlier Oral Disclosure



30.01.96

Later Patents, etc.

- A patent or published patent application
  - having a publication date *on or after* the international filing date,
  - which has a filing date or priority date which is earlier than the international filing date,
  - which would constitute relevant prior art if it had been published before the international filing date.
- This type of document is cited on the search report as an "E" type document.

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Chapter I Relevant Prior Art (Rule 33)

- It must have been made available to the public
  - somewhere in the world
  - by means of a written disclosure
  - prior to the international filing date of the international application.

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Chapter I Relevant Prior Art (Rule 33) (continued)

- It must be useful in determining if the claimed invention
  - is or is not novel and
  - does or does not involve an inventive step (e.g. is or is not obvious to one skilled in the art).

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International Search

- Unity of invention is checked (Rule 40).
- Title checked (Rule 37).
- Abstract checked (Rule 38).
- Certain claimed inventions searched (Article 15(3)).

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International Search (continued)

- International Search Report (ISR) prepared (Rules 42 and 43).
  - Contains listing of relevant prior art documents.
  - Contains indications relating to any finding of lack of unity of invention.

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International Search

General

1. This section deals with the procedure before the International Searching Authority. The first question to be considered is which of the several International Searching Authorities is(are) competent.

2. Where a national or regional Office acts as receiving Office, that Office specifies in a unilateral declaration to the International Bureau, in accordance with the provisions of the agreement between WIPO and each of the International Searching Authorities one or more such Authorities for the purpose of searching international applications filed with it. Where the International Bureau acts as receiving Office, the competent International Searching Authorities are those which would have been competent had the international application been filed with a competent national or regional Office. Where several Authorities are competent, the applicant must choose one of them.

3. The possibilities for the receiving Offices to specify International Searching Authorities are limited by the language capacities and the readiness of some Authorities to act only for applicants from certain countries. These limitations are spelled out with precision in the agreements referred to above.

Search Procedure

4. The objective of the international search is to discover what is called "relevant prior art." According to the PCT definition, "prior art" consists of everything which has been made available to the public anywhere in the world by means of a written disclosure (including drawings and other illustrations). The prior art is "relevant" if it is capable of being of assistance in determining whether the claimed invention is new and involves an inventive step and if it was made available to the public before the international filing date.

5. The documents in which the search is made are constituted by the so-called "PCT minimum documentation." Roughly stated, that documentation comprises the published patent documents issued from 1920 by France, Germany (until 1945) and the Federal Republic of Germany (since 1949), Japan, the former Soviet Union and the Russian Federation, Switzerland (except documents in Italian), the United Kingdom, the United States of America, the European Patent Office and the African Intellectual Property Organization. The documentation includes all international applications published by the International Bureau. It also includes patent documents published in any other country after 1920, in English, French, German or Spanish, provided no priority is claimed and the country places them at the disposal of each International Searching Authority. Furthermore, the documentation comprises non-patent literature contained in some 135 technical periodicals.

6. International Searching Authorities are obliged to consult not only the minimum documentation, but also any additional documentation at their disposal. For the Authorities other than the Japanese Patent Office, as far as the Japanese patent documents are concerned, and other than the Russian Patent Office, as far as patent documents from the former Soviet Union and the Russian Federation are concerned, there is a special exception. For these other Authorities, the said kinds of patent documents are part of the minimum documentation only to the extent that English abstracts are generally available.