

# PATENTS CONSULTATION GROUP

29 October 2008

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| <b>Discussion paper: 8</b> | <b>Title: Best Practice Searching.</b>  |
|                            | <p><b>Purpose:</b></p> <p>Information item briefly outlining some changes to searching practice in IP Australia, which improve the overall quality of searching and reporting, and better align our practices with the PCT Guidelines.</p> <p><b>Background:</b></p> <p>(Previous reference at PCG Meeting of 13 May 2008.)</p> <p>IP Australia has been involved in providing international searches on a contract basis for the USPTO, and has also done some benchmarking concerning the international searching practices followed in the European Patent Office, and the Japanese and Korean Patent Offices. IP Australia has taken a critical look at the practices followed in these Offices, as well as the PCT Guidelines in order to determine PCT best practice and ensure that IP Australia issues international searches of good quality and value for money. As a result of this work several recommendations regarding the manner in which we apply the PCT Guidelines in undertaking searches including International Searches and Article 15(5) searches were made.</p> <p>The Assistant General Manager has advised that –</p> <p style="padding-left: 40px;"><b>“we need to continue working to implement the recommendations made by the Best Practice Team to ensure that the quality is built into the searches at the start rather than by a lengthy checking and rework process”.</b></p> <p>This Office has generally accepted the recommendations and has set in place the changes reflecting the new work practices.</p> <p>The new work practices include</p> <p><b>(1) Development of Search Strategy by a Three Person Team (3PT)</b><br/>Guidance is provided to examiners on the formation and conduct of each member of the 3PT, in executing and completing prior art searches. The reconvening of the 3PT and the circumstances under which further searching may be required are prescribed. The role of the 3PT in conducting quality checking is also outlined.</p> <p><b>(2) Interpretation of Terms/Words in Claims for Search and Examination</b><br/>A three-stage hierarchy of approaches to claim construction is presented, along with guidance as to when each level of the hierarchy should be applied. The circumstances under which a particular feature of a claim may be regarded as inherently (rather than explicitly) disclosed in a citation are also defined.</p> |

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|                        | <p><b>(3) Inventive Step Searching</b><br/> Guidance is provided on Inventive step searching methodology, reporting &amp; the level of detail required. Examples of Inventive Step discussion are provided. Particular issues associated with Inventive step searching on Article 15(5) applications and omnibus claims are also delineated.</p> <p><b>(4) Searching Broad Claims</b><br/> Broad claims are classified into four main types (with reference to illustrative examples), and a general approach to searching broad claims is outlined.</p> <p><b>PCT Articles 5 &amp; 6</b><br/> Guidelines and examples which illustrate the minimum requirements of well founded objections under each of Articles 5 &amp; 6 are provided.</p> <p><b>(5) PCT Detail of Reporting</b><br/> Minimum requirements are provided for satisfying an appropriate level of detail of reporting in the ISR/ISO. Some guidance aimed at increased efficiency and consistency in reporting in the ISR/ISO is also provided.</p> <p><i>Action:</i></p> <p>A brief discussion of the changes in searching and reporting practice will occur at the meeting.</p> |
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