

International

Search

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Preliminary

Examination



**International
Search**



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**Preliminary
Examination**

Overview

- ◆ **International Searching and Preliminary Examination System**
- ◆ **Value of the International Search Report (ISR) and Written Opinion/International Preliminary Report on Patentability (IPRP)**
- ◆ **Responding to Written Opinions: Types of Responses and Advantages and Disadvantages**
- ◆ **Use of ISR and IPRP in Making Better Informed Business Decisions**

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Background

All International Applications filed after 1st January 2004 will follow a modified system of international search and preliminary examination. In the process for applications filed prior to 2004, an applicant received an international search report during the first part of the PCT process (Chapter I) and then had the option of utilizing the preliminary examination procedure (Chapter II) if circumstances and advantages of the procedure warranted the additional cost. As of April 2002, most PCT contracting states gave an applicant 30 months from the priority date to complete national entry; a few states maintain(ed) reservations, requiring an applicant to file a DEMAND by 19 months to utilize Chapter II to extend the time for entry from 20 to 30 months.

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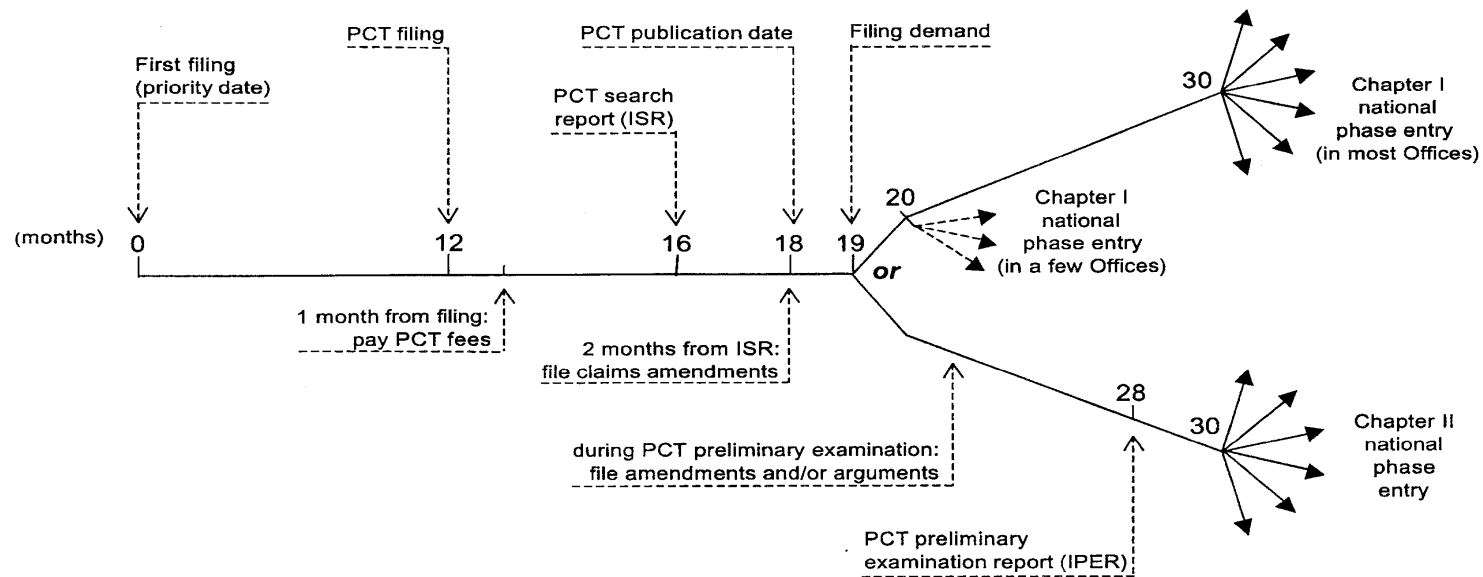


Preliminary
Examination

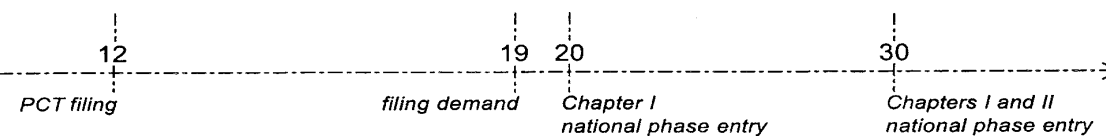
Background

For example:

PCT TIMELINE A — PCT filing at the end of the priority year



Main decisions
to be taken:



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Background

As of 1st January 2004, the new system went into effect and the new process, combining search and the initial opinion under the Chapter I proceedings, is in effect...

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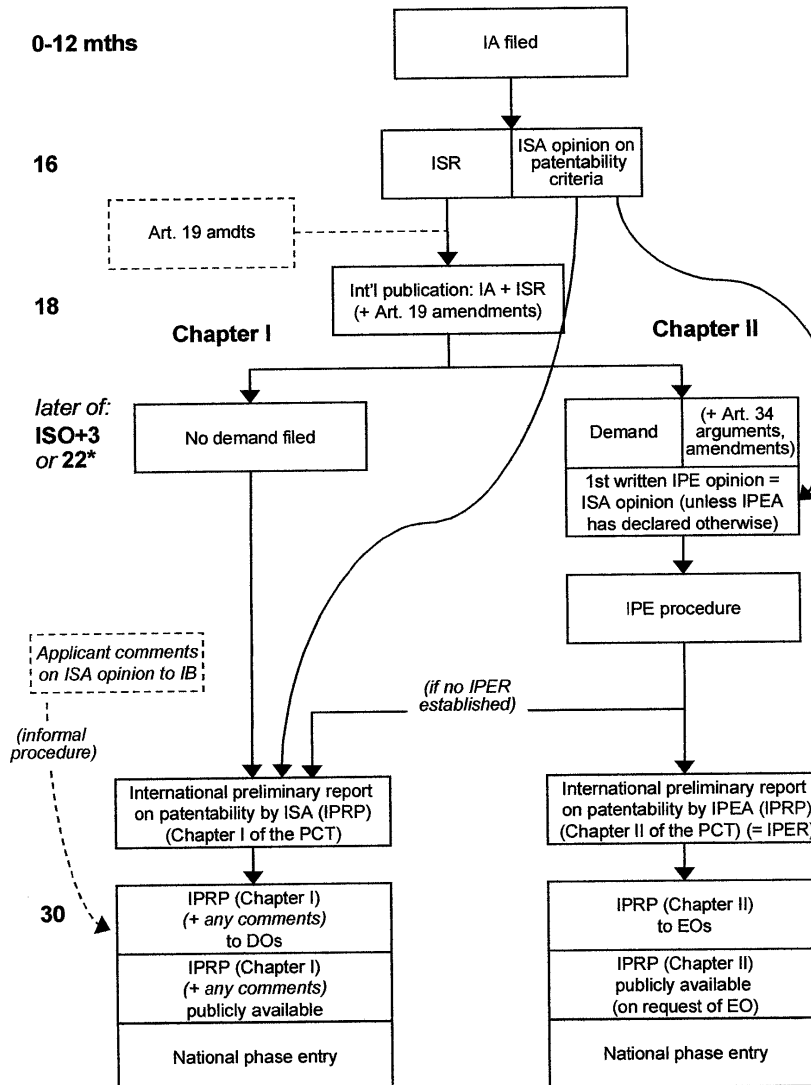


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Preliminary Examination

Enhanced International Search and Preliminary Examination System



EISPE

**Enhanced
International
Search
and
Preliminary
Examination
System**

* must in practice file demand by 19 months for Article 22 transitional reservation countries

International Search



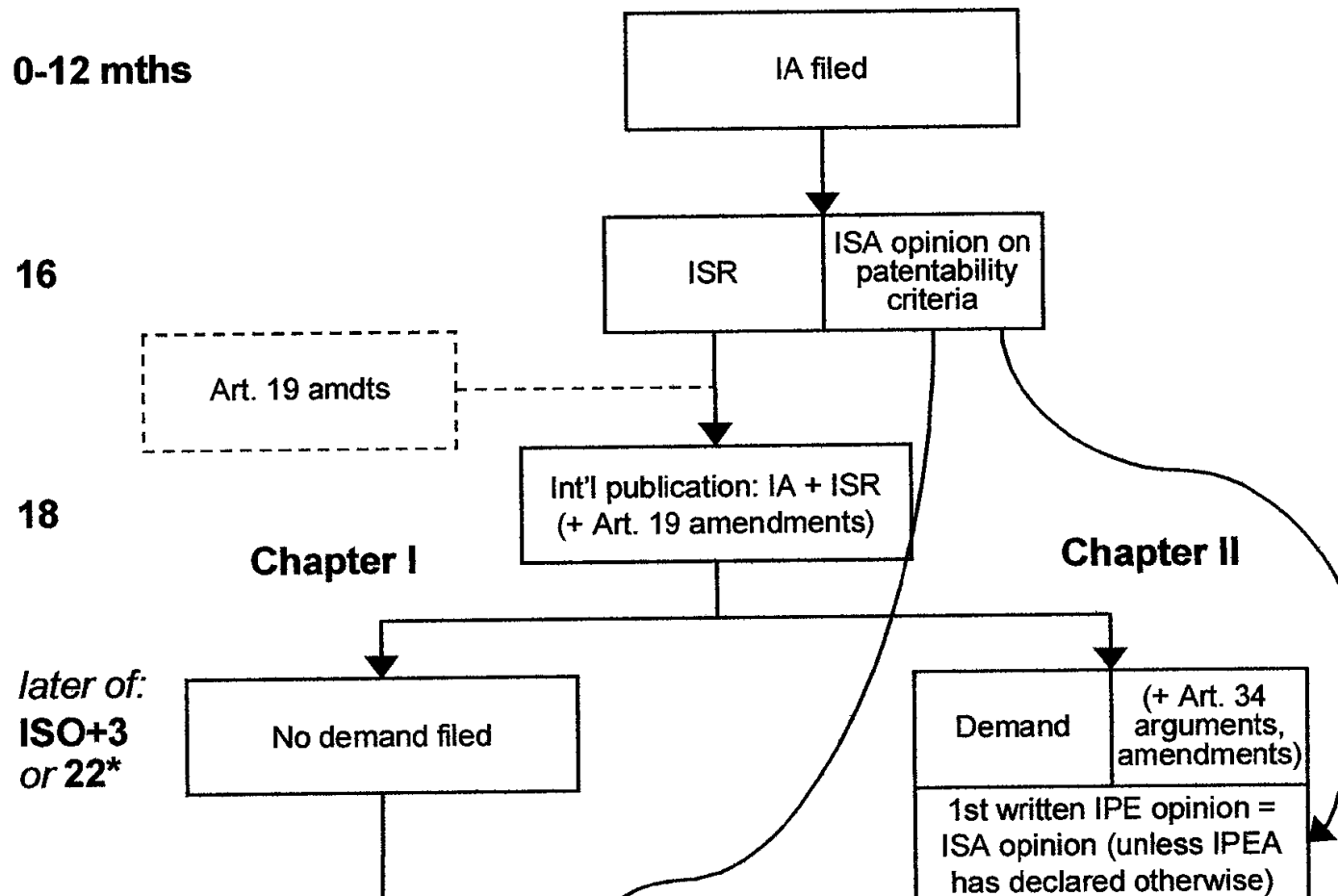
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Preliminary Examination

EISPE

Enhanced International Search and Preliminary Examination System



International
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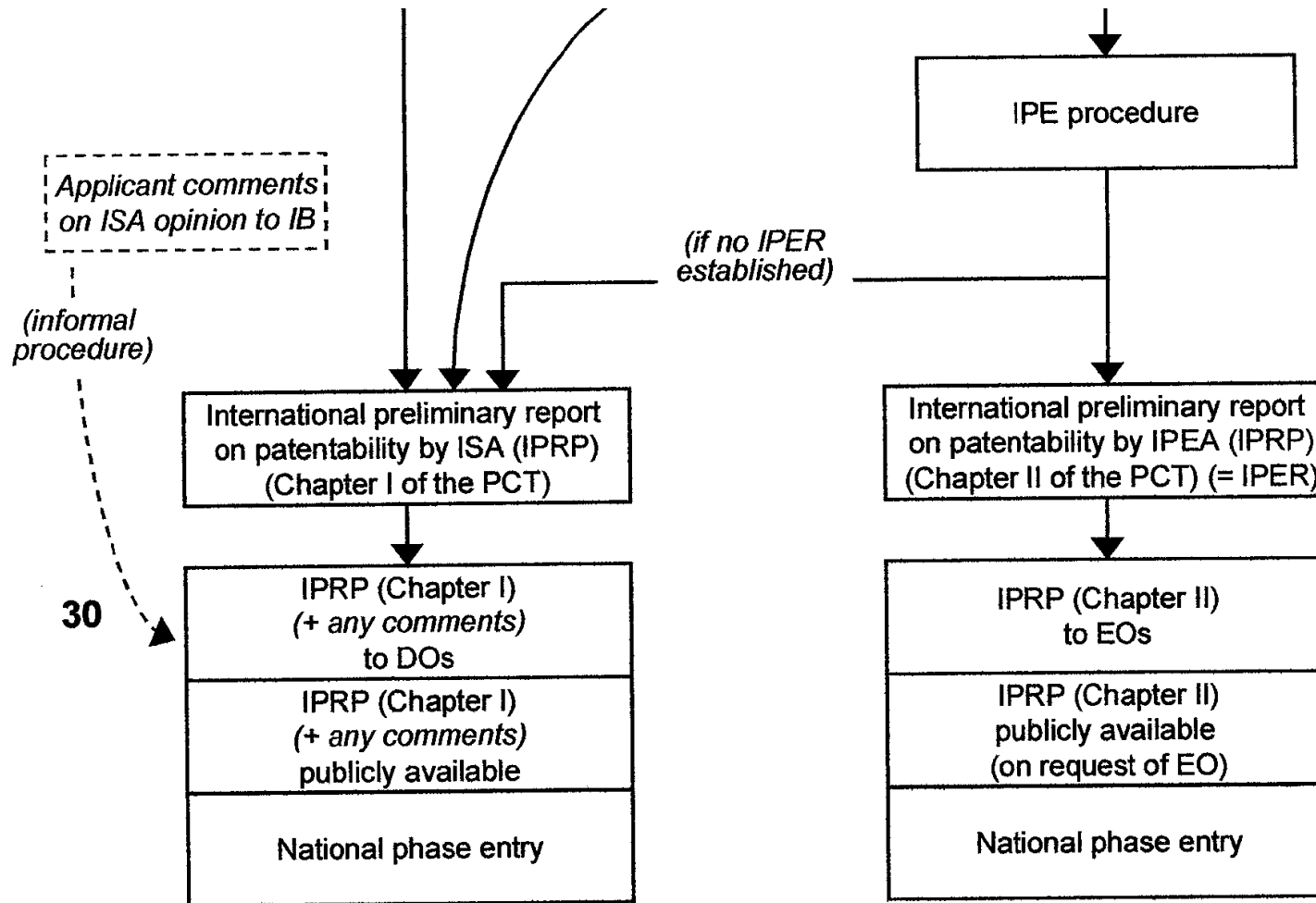


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Preliminary
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EISPE



* must in practice file demand by 19 months for Article 22 transitional reservation countries

International
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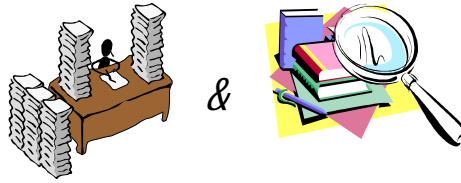
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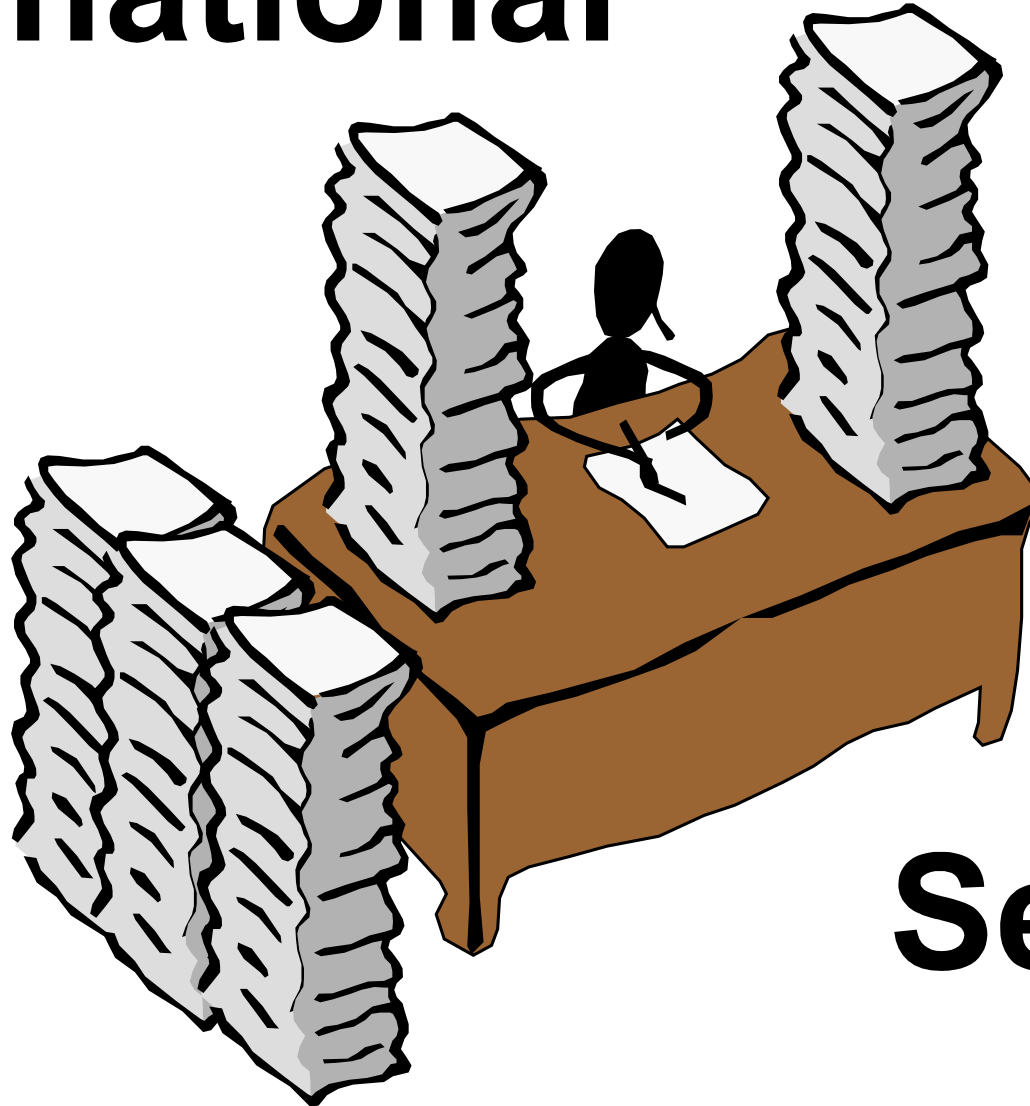
Preliminary
Examination

EISPE

Compared to the former process, the new search and preliminary examination system provides applicants with more information at an earlier stage in the PCT process, allowing applicants to better manage their application's journey through the PCT process and provides additional options for applicants desiring to participate in Chapter II examination.



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International Search

The international search is conducted by an International Searching Authority (ISA) selected by the applicant from a list of ISAs specified by the applicant's home Receiving Office (RO). For example, applicants from India can choose their ISA from:

Australian Patent Office (ISA/AU)

Austrian Patent Office (ISA/AT)

China Intellectual Property Office (ISA/CN)

European Patent Office (ISA/EP)

Swedish Patent Office (ISA/SE)

United States Patent and Trademark Office (ISA/US)

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International Search

Applicants from the US can choose between the European Patent Office (ISA/EP) or the United States Patent & Trademark Office (ISA/US).

Applicants from the Republic of Korea can choose between the Australian Patent Office (ISA/AU), the Austrian Patent Office (ISA/AT), the Japan Patent Office (ISA/JP), and the Korean Intellectual Property Office (ISA/KR).

Some applicants have no choice. For example applicants filing with the Canadian Receiving Office may only select the ISA/CA; applicants filing with the European Receiving Office may only select the ISA/EP.

The competent ISAs for each RO are listed in the *PCT Applicant's Guide*.

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International Search

Each ISA has qualified as a searching authority by meeting specific requirements set forth in PCT Article 16 and Rule 34, including having a minimum set of prior art documents available for the examiners to utilize during the searching process. (Any ISA may have and utilize more than the minimum required document set.)

This “quality control” helps provide applicants with a competent prior art search covering a wide range of prior art documents.

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International Search

Applicant's receipt of the International Search Report (ISR -- now accompanied by an ISA Opinion on Patentability Criterion (or Written Opinion) by the searching examiner) is one of the most valuable features of the PCT process and should be utilized in making key decisions regarding future direction of the claimed invention and International Application.

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/US98/99999	International filing date (<i>day/month/year</i>) 12 May 1998 (12.05.98)	(Earliest) Priority Date (<i>day/month/year</i>) 03 June 1997 (03.06.97)
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 6 sheets.

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

1. **Basis of the report**

a. With regard to the **language**, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

the international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).

b. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international search was carried out on the basis of the sequence listing:

contained in the international application in written form.

filed together with the international application in computer readable form.

furnished subsequently to this Authority in written form.

furnished subsequently to this Authority in computer readable form.

the statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.

the statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

2. **Certain claims were found unsearchable (See Box I).**

3. **Unity of invention is lacking (See Box II).**

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

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.

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

as suggested by the applicant.

None of the figures.

because the applicant failed to suggest a figure.

because this figure better characterizes the invention.



INTERNATIONAL SEARCH REPORT

International application No.

PCT/US98/99999

Box I Observations where certain claims were found unsearchable (Continuation of item 2 of first sheet)

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

1. Claims Nos.: 6
because they relate to subject matter not required to be searched by this Authority, namely:

Claim 6 directed to an instruction manual with particular wording is considered to be a mere presentation of information and is subject matter which the International Searching Authority is not required to search under Article 17(2)(a)(i) and Rule 39(v).

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 3 of first sheet)

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

- I. Claims 1-5 directed to a sailboat self-steering gear.
- II. Claims 7-12 directed to a compass with an alarm to indicate deviation from a planned course.

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/US98/99999

<p>A. CLASSIFICATION OF SUBJECT MATTER</p> <p>IPC⁶ B63H 25/02, B63H 25/04, G01C 17/10</p> <p>According to International Patent Classification (IPC) or to both national classification and IPC</p>																													
<p>B. FIELDS SEARCHED</p> <p>Minimum documentation searched (classification system followed by classification symbols)</p> <p>IPC⁶ B63H 25/02, B63H 25/04, G01C 17/10</p> <p>Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched</p> <p>Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)</p> <p>WPI, INSPECT "self-steering compass", "sailing alarm"</p>																													
<p>C. DOCUMENTS CONSIDERED TO BE RELEVANT</p> <table border="1"> <thead> <tr> <th>Category*</th> <th>Citation of document, with indication, where appropriate, of the relevant passages</th> <th>Relevant to claim No.</th> </tr> </thead> <tbody> <tr> <td>X</td> <td>JP 50-14535 B (NCR CORPORATION) 28 May 1975 (28.05.75), column 4, lines 3 to 27</td> <td>7-9, 11</td> </tr> <tr> <td>X</td> <td>GB 392415 A (JONES) 18 May 1933 (18.05.33) Fig. 1</td> <td>1-3</td> </tr> <tr> <td>Y</td> <td>page 3, lines 5-7</td> <td>4, 10</td> </tr> <tr> <td>A</td> <td>Fig. 5, support 36</td> <td>11-12</td> </tr> <tr> <td>X</td> <td>GB 2174500 A (STC) 5 November 1986 (05.11.86) page 1, lines 5-15, 22-34, 46-80; Fig. 1</td> <td>1-3</td> </tr> <tr> <td>Y</td> <td></td> <td>4</td> </tr> <tr> <td>A</td> <td>US 4322752 A (BIXTY) 30 March 1982 (30.03.82) claim 1</td> <td>1</td> </tr> <tr> <td>A</td> <td>GREEN, J.P. Integrated Circuit and Electronic Compass, IBM Technical Disclosure Bulletin, October 1975, Vol. 17, No. 6, pages 1344 and 1345</td> <td>1-5</td> </tr> </tbody> </table>			Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.	X	JP 50-14535 B (NCR CORPORATION) 28 May 1975 (28.05.75), column 4, lines 3 to 27	7-9, 11	X	GB 392415 A (JONES) 18 May 1933 (18.05.33) Fig. 1	1-3	Y	page 3, lines 5-7	4, 10	A	Fig. 5, support 36	11-12	X	GB 2174500 A (STC) 5 November 1986 (05.11.86) page 1, lines 5-15, 22-34, 46-80; Fig. 1	1-3	Y		4	A	US 4322752 A (BIXTY) 30 March 1982 (30.03.82) claim 1	1	A	GREEN, J.P. Integrated Circuit and Electronic Compass, IBM Technical Disclosure Bulletin, October 1975, Vol. 17, No. 6, pages 1344 and 1345	1-5
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<p>Date of the actual completion of the international search</p> <p>18 August 1998</p>		<p>Date of mailing of the international search report</p> <p>31 August 1998</p>																											
<p>Name and mailing address of the ISA/EP</p> <p>European Patent Office Patentlaan 2, Rijswijk, Netherlands Facsimile No.</p>		<p>Authorized officer</p> <p>DE LAERE, Ann Telephone No.</p>																											



International Search

INTERNATIONAL SEARCH REPORT

International application No.
PCT/US98/99999

A. CLASSIFICATION OF SUBJECT MATTER

IPC⁶ B63H 25/02, B63H 25/04, G01C 17/10

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)

IPC⁶ B63H 25/02, B63H 25/04, G01C 17/10

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)

WPI, INSPECT "self-steering compass", "sailing alarm"



International Search

C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	JP 50-14535 B (NCR CORPORATION) 28 May 1975 (28.05.75), column 4, lines 3 to 27	7-9, 11
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Y		4
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<input checked="" type="checkbox"/> Further documents are listed in the continuation of Box C. <input checked="" type="checkbox"/> See patent family annex.		



International Search

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<p>Date of the actual completion of the international search</p> <p>18 August 1998</p>		<p>Date of mailing of the international search report</p> <p>31 August 1998</p>	
<p>Name and mailing address of the ISA/EP</p> <p>European Patent Office Patentlaan 2, Rijswijk, Netherlands Facsimile No.</p>		<p>Authorized officer</p> <p>DE LAERE, Ann</p> <p>Telephone No.</p>	



INTERNATIONAL SEARCH REPORT
Information on patent family members

International application No.
PCT/US98/99999

Patent document cited in search report	Publication date	Patent family member(s)	Publication date
JP 50-14535 B	28.05.75	None	

GB 392415 A	18.05.33	None	

GB 2174500 A	05.11.86	None	

US 4322752 A	30.03.82	WO 8102084 A	23.07.81
		EP 0043828 A B	20.01.82
		CA 1157145 A	15.11.83



International Search

INTERNATIONAL SEARCH REPORT
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US 4322752 A	30.03.82	WO 8102084 A EP 0043828 A B CA 1157145 A	23.07.81 20.01.82 15.11.83

**International
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**Preliminary
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Advantages of the
International Search Report

- ◆ **Provides an independent assessment of the applicable IPCs (and US PC, if ISA/US is utilized)**
- ◆ **Foreshadows possible unity of invention issues**
- ◆ **Provides an independent view of the applicable prior art (possibly with multiple language coverage)**
- ◆ **May provide patent-family cross reference to aid in broader art searches**
- ◆ **Allows for applicant's continued assessment of patentability in light of discovered prior art**

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ISA Opinion on Patentability Criterion (Written Opinion – Chapter I)

Under the EISPE system, the ISA examiner will also provide the applicant with an Opinion on Patentability Criterion (or Written Opinion (WO)) in which the examiner will assess the novelty, inventive step and industrial applicability of the claimed invention (PCT Article 33) in light of the art cited in the ISR.

This Opinion provides the applicant with further information to aid in the assessment of the patentability of the claimed invention and the future of the International Application.

PATENT COOPERATION TREATY



From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

WRITTEN OPINION

(PCT Rule 66)

To:		Date of mailing (day/month/year)	
Applicant's or agent's file reference		REPLY DUE within _____ months/days from the above date of mailing	
International application No.	International filing date (day/month/year)	Priority date (day/month/year)	
International Patent Classification (IPC) or both national classification and IPC			
Applicant			

1. This written opinion is the _____ (first, etc.) drawn by this International Preliminary Examining Authority.

2. This opinion contains indications relating to the following items:

- I Basis of the opinion
- II Priority
- III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV Lack of unity of invention
- V Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI Certain documents cited
- VII Certain defects in the international application
- VIII Certain observations on the international application

3. The applicant is hereby invited to reply to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: _____

Name and mailing address of the IPEA/	Authorized officer
Facsimile No.	Telephone No.

International
Search



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International Preliminary Examination

Decision Point – Chapter I and Chapter II

Upon receipt of the ISR and the WO from the ISA, an applicant must decide whether to utilize the optional Chapter II process or to accept the ISA examiner's opinion (with or without informal comment) in the knowledge that the final International Preliminary Report on Patentability (IPRP -- which will be distributed to all Designated Offices) will be identical to the WO if Chapter II is not utilized.

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International Preliminary Examination

Decision Point – Chapter I and Chapter II

If the WO is favorable, then there is usually no need to utilize Chapter II

If there is a need to amend the description or drawings prior to national phase entry, then Chapter II provides the only route to enter the needed amendment. (Claims can be amended under Article 19.)

If the opinion is negative, a decision is needed.

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International Preliminary Examination

Decision Point – Chapter I and Chapter II

Prosecution aimed at a favorable IPRP under Chapter II is a cost-effective way to advance the prosecution of your application in all PCT member states *with the professional effort of a single official action response.*

Many PCT member states and several non-member states gave significant weight to a positive IPER and are expected to give the same weight to a positive IPRP

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International Preliminary Examination

Decision Point – Chapter I and Chapter II

When faced with a negative Written Opinion, the decision reduces to, “Respond once under Chapter II, or many times during the national phase.” Non-examining and self-assessment countries may also require additional effort.

(An applicant can respond to a negative WO informally under Chapter I, placing comments regarding the examiner’s opinion before the Designated Offices.)

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International Preliminary Examination

International Preliminary Report on Patentability

Regardless of whether an applicant utilizes Chapter II, at the end of the PCT process (about 28 months) an IPRP will be issued. If Chapter II is not utilized, The IPRP-Chapter I will be issued by the International Bureau on behalf of the IPEA. If Chapter II is utilized, an IPRP-Chapter II (equivalent to the IPER under pre-2004 system) will be issued by the IPEA.




PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/GB 92/55555	International filing date (day/month/year) 22.04.1992	Priority date (day/month/year) 02.06.1991
International Patent Classification (IPC) or national classification and IPC A61C7/12		
Applicant BRIGGS DENTAL COMPANY		
<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>7</u> sheets, including this cover sheet.</p> <p><input checked="" type="checkbox"/> This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of <u>5</u> sheets.</p>		
<p>3. This report contains indications relating to the following items:</p> <p>I <input checked="" type="checkbox"/> Basis of the report</p> <p>II <input type="checkbox"/> Priority</p> <p>III <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p>IV <input checked="" type="checkbox"/> Lack of unity of invention</p> <p>V <input checked="" type="checkbox"/> Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p>VI <input type="checkbox"/> Certain documents cited</p> <p>VII <input checked="" type="checkbox"/> Certain defects in the international application</p> <p>VIII <input type="checkbox"/> Certain observations on the international application</p>		
Date of submission of the demand 12.12.1992	Date of completion of this report 19.09.1993	
Name and mailing address of the IPEA/  European Patent Office D-80298 Munich Tel. (+49-89) 2399-0, Tx: 523656 epmu d Fax: (+49-89) 2399-4465	Authorized officer W. ADAMS Telephone No. (+49-89) 2399-	



INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/GB 92/55555

I. Basis of the report

1. This report has been drawn on the basis of (Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.):

- the international application as originally filed.
- the description, pages 1-14, as originally filed,
pages _____, filed with the demand,
pages _____, filed with the letter of _____,
pages _____, filed with the letter of _____.
- the claims, Nos. _____, as originally filed,
Nos. _____, as amended under Article 19,
Nos. _____, filed with the demand,
Nos. 1-9, filed with the letter of 06.03.1993,
Nos. 10-14, filed with the letter of 01.08.1993.
- the drawings, sheets/fig 3/4, 4/4, as originally filed,
sheets/fig _____, filed with the demand,
sheets/fig 1/4, 2/4, filed with the letter of 01.08.1993,
sheets/fig _____, filed with the letter of _____.

2. The amendments have resulted in the cancellation of:

- the description, pages _____
- the claims, Nos. _____
- the drawings, sheets/fig _____

3. This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

4. Additional observations, if necessary:



INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
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IV. Lack of unity of invention

1. In response to the invitation to restrict or pay additional fees the applicant has:

- restricted the claims.
 paid additional fees.
 paid additional fees under protest.
 neither restricted nor paid additional fees.

2. This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.

3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is

- complied with.
 not complied with for the following reasons:

1. The separate inventions are: A dental device according to Claim 1; A dental packaging assembly according to Claim 10 and A packaging assembly according to Claim 13.

The common concept linking together the independent Claims 1 and 10 is "a dental appliance". This common concept is not novel, see document US-A-, col. 1, line 52.

Therefore, the subject-matter of Claims 1 and 10 are not so linked as to form a single general inventive concept (Rule 13 PCT).

4. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this report:

- all parts.
 the parts relating to claims Nos. _____



INTERNATIONAL PRELIMINARY EXAMINATION REPORT

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V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	<u>1 - 12</u>	YES
	Claims	<u>13, 14</u>	NO
Inventive step (IS)	Claims	<u>1 - 9</u>	YES
	Claims	<u>10 - 12, 13, 14</u>	NO
Industrial applicability (IA)	Claims	<u>1 - 14</u>	YES
	Claims	<u></u>	NO

2. Citations and explanations

1. The difference between the article of Claim 1 and D1 (see fig. 9, col. 1, lines 54 - 62), is that the "straight section (52) of the flexible film (48) is substantially free of direct connection to said substrate".

The problem solved by this difference is that the film undergoes a peeling motion relative to the adhesive as the appliance is lifted from the substrate, rather than moving in a direction perpendicularly away from the appliance in generally flatwise fashion. The peeling motion facilitates separation of the film from the adhesive and permits the use of adhesives that are less viscous. Securing the curved section of the film to the substrate obviates the need for separate handling of the film, so that the film and substrate can be disposed of together (description p. 3, lines 8-19).

No document of the search report teaches the use of a flexible film which has a straight section secured to the substrate and a curved section in contact with the adhesive of the dental appliance but free of direct connection to said substrate.



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International application No.

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Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Point V., No. 2, Citations and explanations

Therefore, the article of Claim 1 is novel and involves an inventive step as required by Art. 33 (2) (3) PCT.

2. Claims 2-9 define particular embodiments of the article of Claim 1 and would fulfil the requirements of Art. 33 (2)-(4) PCT in combination with this claim.

3. D1 discloses a dental packaging assembly having all of the features of Claim 10 (see figs. 7-9) except for the feature "the sidewall of each container includes a recess in contact with said edge structure for retaining said container in said opening".

The objective problem to be solved by this distinguishing feature is to locate in a precise manner the container and thereby avoid the possibility of it becoming loose.

GB-A- (D2) however, teaches a dental package assembly in which the same problem is addressed and solved in a similar manner to the distinguishing feature of claim 10 (see page 3, lines 51-67, and Fig. 2, 2a).

It would therefore be obvious for the skilled man, seeking to overcome the objective problem in relation to D1, to adopt the teaching of D2. He would therefore arrive at the subject-matter of claim 10 without exercising inventive activity. Claim 10 accordingly lacks inventive step (Article 33 (3) PCT).

4. Claims 11 and 12 define minor modifications of the packaging assembly of Claim 10. These modifications are, however, clearly disclosed in D2 (see page 4, lines 11-25, Figs. 3, 4). These claims also lack inventive step.



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Supplemental Box
(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Point V., No. 2, Citations and explanations

5. D1 discloses all the features of Claims 13 and 14 see
figs. 7-9, col. 1, line 40 - col. 2; line 32, col. 4,
lines 56-60 (if the cover is in several pieces,
partially connected, there will be a "line of perforations"
as in Claim 13).

Therefore, the subject-matter of the Claims 13 and 14
is not new as required by Art. 33 (2) PCT.

**VII. Certain defects in the international application**

The following defects in the form or contents of the international application have been noted:

Although the independent Claim 1 is cast in the two part form (Rule 6.3 (b)), the features "the device (10) includes a film (48) having a straight section (52) and a curved section (54) spaced from said straight section (52), said straight section (52) including a low adhesion surface in contact with said adhesive (60), and means (50) for securing said curved section (54) to said substrate (42, 142)" are known from D1 (see col. 1, lines 54-62 and fig. 9), and should therefore be transferred from the characterising portion of Claim 1 to the preamble.

International
Search



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Preliminary
Examination

Advantages of

International Search and Preliminary Examination

- ◆ At the completion of the PCT process an applicant has received an independent look at the prior art as it relates to the claimed invention and a considered opinion on the novelty, inventive step and industrial applicability of the invention in light of the cited art.
- ◆ If the Chapter II process is elected, the applicant receives a cost-effective way of advancing prosecution in all PCT member states.
- ◆ Unrelated to patentability of the claimed invention, the ISR also contains an indication of the state of the relevant art which can prove valuable in other research projects.

International
Search



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Preliminary
Examination

Advantages of the International Search

- ◆ **Importantly, the ISR and the IPRP provide the applicant with critical information required to make informed decisions about the future of the application and the invention and the possibility of obtaining exclusivity around the world. The optional Chapter II process provides the applicant with a cost saving method of prosecuting the invention in multiple countries with the effort of a single official action response.**

**International
Search**



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**Preliminary
Examination**

Parting Comment

With the rapidly rising costs of global patenting where patenting a single invention in 50+ countries can easily cost in excess of US\$ 500,000 across the 20-year term of the patents, having the important information available through the International Search Report and the International Preliminary Report on Patentability to aid in making decisions regarding national phase entry is critical.

Having the option of more cost-effective international prosecution through the optional Chapter II process further adds to the value gained through using the PCT.

Thank



You