

Views of Users — Creation of a Universal Data Base – Problems and Advantages

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Thank you very much for inviting APAA to make presentation this very important topic. At the PCT reform meeting held last year, the U.K. delegation stated that offices were unfortunately still reluctant to rely on work performed by other offices because of a lack of confidence. Needless to say, confidence in the reliability of work performed by any other offices is essential to mutual recognition and acceptance of search results provided by any other office. In this regard, it is reported that in concurrent searches conducted by trilateral offices, the same conclusion regarding patentability with respect to both novelty and inventive step was reached in 90 percent of cases reviewed. However, it can be stated that a figure of 10 percent in which an accord in searches (inaudible) was not found is a fairly significant number. Establishing such guidelines and this exercising system of quality control are conceivable so as to improve conformity and reliability of such results. However, noticing such a need, I believe that in order to achieve such a goal, it is of fundamental importance to establish a universal prior art database for use by all ISAs. Considering that there are such procedures that exist at present and different to the provisions of the present Rule 34.1, a prior art

database should include both the originals and also abstracts prepared in English of all the documents (inaudible) with a publication.

Minimum documentation: I believe that the provision of Rule 34.1, providing minimum documentation, should be amended and a PCT regulation, Rule 34.1 for minimum documentation (inaudible) minimum documentation differed among ISAs. This inconsistency comes from the provision of Rule 34.1(e). Subparagraph (e) of Rule 34.1 states that any ISA whose language is not Japanese, Russian or Spanish need not include in its documentation any patent documents written in Japanese, Russian, or Spanish if a corresponding abstract in English is not generally available. It is certain that a majority of (inaudible) invention will be disseminated through the medium of the English language. However, it is (inaudible) recognized the fact that many inventions were likely not to be disseminated in English and may remain known and effective at the local and the national level.

The requirement of minimum documentation is based on the assumption that English is a dominant language to be relied upon in assessing documentation. In principle, I believe that this assumption is, in itself, realistic. However, its practice does give rise to some problems. I should indicate that, with respect to the languages such as Japanese, Russian and Spanish, although the technology cultures of the countries are advanced, only in the ISA (inaudible) languages those

documents are covered as minimum documentation. In other ISAs, it not included in the minimum documentation. Thus, such report will not be necessarily the same, and the search report prepared in other ISAs are insufficient and unsatisfactory.

Further, there are questions in the present (inaudible) based on the present minimum documentation with respect to English document (inaudible) minimum document. The ISAs in which English is the official language are able to carry out searches with almost no problem. However, in the ISAs in which English is not the official language, the situation is different and the (inaudible) is stated that such ISAs may not be able carry out searches in a satisfactory manner.

Fundamentally, it is true that the examiners belonging to any of the ISAs are expected to be able to understand English; however, it is natural that the culture and the environment make it inevitable that an affinity will exist in (inaudible) for their native language. Thus, a natural desire exists to conduct searches in the native language. Reflecting this (inaudible) in ISAs of knowingly speak in countries, there is a tendency for documents published in English to become subordinate and searches on the basis of the abstract of the document. Thus, preparation of abstracts is indispensable, even for English documents. In establishing a universal prior art database, such decision should be taken into account. Thus, the requirement for abstracts in English should be uniform among the documents not only written in another language, but also in English.

No English documents: With regard to documents that are published in any other country, there is language discrimination which is arising as a result of Rule 34.1(c)(vi), in which only English, French, German or Spanish languages are included in the minimum documentation, with some restrictions. This prevents the object of minimum documentation being fulfilled globally. I think that the provision must be amended. Thus, if any document can be placed at the disposal of each ISA in convenient form, for example, in the form of an English abstract, such document in any language should be included in minimum documentation. Based on the (inaudible) context, in order to establish English (inaudible) database, with respect to the document as stated, systematic work should be proceeded with respect to any language. I think, following the Japanese experience on the preparation of a patent abstract of Japan, it can be proceeded as a part of technical cooperation provided in Article 56.

Original documentation: I have discussed the issue of providing a database of abstract written in English. However, assuming that the proper database can be established, there remains a problem that the abstract can only function as a basis for a search of prior art and does not, in any way, in itself, constitute an actual prior art. Therefore, to take the (inaudible) of the document and {cover it} on the basis of its English abstract in the search, it is necessary to study the entire document in its original language. Linguistic diversity presents a problem here. With respect to some documents written in some limited languages, with aid of

dictionary resources, it may be possible to proceed with some study to some degree. However, in a case that, for example, a language such as Japanese, Russian or sometimes Spanish is (inaudible) there may be difficulties faced in any attempt to study original documentation which is uncovered by a search over English abstract. In such cases, the only way to properly proceed will be by obtaining a translation of the document. Envision this problem. There has been expressed the idea of relying on machine translation. However, this is not a wise way. Machine translation can provide a literal translation of nouns, noun phrases and whole myriad of syntax only, and is able to provide a rudimentary map of document.

Such being the case, it is absolutely necessary to find a reliable and convenient method of proceeding confirmation to the original documentation uncovered by a search of English (inaudible). I think that, therefore, to (inaudible) by mutual acceptable solution without delay. It is important to avoid any unfair (inaudible) advantage being closer to applicant by the above. Thus, in any case, invitation to applicants to submit their opinions would be inevitable, at least, in the event that it is difficult to confirm veracity of the documentation for the reasons outlined before. Notwithstanding such a problem, original documents should be included in the universal prior art database.

As I have stated, if we are to attain mutual recognition of such results among the national patent offices, the obvious and the commendable way for it would be construction of a universal prior art database, which is able for the use and the convenience of all ISAs. Such a database should include all patent documents published by any of international, regional or national route, with the basic condition that an abstract of any such document being {very} available in English. To achieve this goal, the first step is the revision of the requirement of minimum documentation and, also, it is necessary to address the connective problems. Standardization (inaudible) for uncovering (inaudible) of prior arts in a search and the standardization of means for confirming veracity of a {recent} document uncovered by such a search. Thank you very much for your attention.

(Applause)