

Patent Cooperation Treaty (PCT) Working Group

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NON-PATENT LITERATURE UNDER THE PCT MINIMUM DOCUMENTATION

Document submitted by India

BACKGROUND

1. Article 15(4) of the PCT states that “the International Searching Authority [...] shall endeavor to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the Regulations”. PCT Rule 34 contains the definition of the documentation referred to in Article 15(4). With reference to Non-Patent Literature (NPL), the PCT Minimum Documentation comprises 145 journals.
2. Article 56(3) of the Patent Cooperation Treaty (PCT) states, inter alia, “[t]he aim of the [Committee for Technical Cooperation] shall be to contribute, by advice and recommendations: [...] (ii) to the securing, so long as there are several International Searching Authorities and several International Preliminary Examining Authorities, of the maximum degree of uniformity in their documentation and working methods and the maximum degree of uniformly high quality in their reports.”
3. Out of the 45 adopted recommendations under the WIPO Development Agenda, two recommendations were as follows:
 - (i) “8. Request WIPO to develop agreements with research institutions and with private enterprises with a view to facilitating the national Offices of developing countries, especially LDCs, as well as their regional and sub-regional intellectual property organizations to access specialized databases for the purposes of patent searches.”

- (ii) “10. To assist Member States to develop and improve national intellectual property institutional capacity through further development of infrastructure and other facilities with a view to making national intellectual property institutions more efficient and promote fair balance between intellectual property protection and the public interest. This technical assistance should also be extended to sub-regional and regional organizations dealing with intellectual property.”

NON-PATENT LITERATURE AND CHALLENGES

4. With the availability of electronic databases, the patent literature part of the PCT Minimum Documentation is available in forms that allow an effective search to be conducted. For instance, private service providers make available raw as well as value added collections, having a uniform structure in a format compatible with WIPO Standards, containing documents of various offices. In fact, the IP Offices have undertaken, *suo moto*, the work of standardisation of the contents of patent documents in the format prescribed by WIPO, which increases the efficacy of the data for the purpose of search.

5. The NPL forming part of the PCT Minimum Documentation also comprises material of particular relevance, not only for the International Authorities but also for National Offices. In some fields, such as biotechnology, the NPL assumes even greater importance due to the availability of a much higher percentage of potential prior art. The use of NPL for the purpose of conducting prior art search presents certain challenges which affect the efficiency of the Examiners. Publishers use different models/formats for providing access to their resources and use different structures for arranging the data. Most of the non-patent literature is not classified according to classification systems such as IPC. Search facilities of publishers and third parties allowing a single search in a number of titles are available due to which the challenge of searching the NPL part has reduced to a certain extent.

6. To further improve the search facilities with respect to NPL, some Offices acquire the data comprising a large number of titles of NPL from publishers and host the same locally on their internal servers or seamlessly access the data from servers of the publishers, through their internal customised electronic systems. This allows the Examiners to dig out the information from a much larger set by conducting a single search using their internal search systems, though such a single search has its inherent limitations, such as, search capability being limited by the common fields available in the said data. It has been observed that conducting a search through the internal search systems of the Office in the NPL hosted locally on the internal servers is beneficial as compared to searching through the tools made available by the publishers or third parties. Local hosting allows the Authorities or Offices to customize their search systems to a much higher extent according to the needs of their Examiners, thereby improving the efficiency of the Examiners.

EXPERIENCES OF INDIAN PATENT OFFICE (IPO)

7. Efforts for procuring data in the full-text format were made by the IPO. The publishers were initially reluctant to provide full-text for local hosting on IPO's servers. Pursuant to consistent efforts made by the IPO, the publishers offered to provide access to their NPL data by using various methods such as providing (i) online only access through their respective web portals, (ii) xml data feeds till abstract level with online only access to html and pdf versions of full text and (iii) full-text data for storage on internal servers of the Office. The exercise of discussing the possibility of storing full text data on the internal servers was resource intensive, but provided encouraging results. It is felt that more publishers will agree to provide data in the format required by the IPO in due course. It is understood that some Authorities have existing arrangements with publishers in accordance with their own requirements.

8. The Indian Patent Office believes that, at least for the titles comprising the NPL part of PCT Minimum Documentation, along with the methods currently adopted by the publishers to provide access to the NPL, the publishers should also be required to provide full-text data of the NPL in a pre-determined format. This will allow the Authorities and National Offices to use the information contained in the NPL in a more effective manner and also to handle issues such as inefficiency and non-uniformity in the structure of different databases of NPL part of the PCT Minimum Documentation in an effective manner. The Indian Patent Office, based on its recent experiences, is very hopeful that the concerns of publishers which preclude them from providing data in a particular format can also be addressed if a collective effort is made.

PROPOSAL BEFORE THE PCT WORKING GROUP

9. As the Authorities and National Offices may have different requirements, it is proposed that this working group recommend to the Assembly of the PCT Union that the Committee for Technical Cooperation consider this matter, if appropriate in coordination with the Meeting of International Authorities, considering the needs of the Authorities or Offices and the limitations of publishers at their next sessions, and make proposals for discussion by the Working Group at its next sessions, regarding a standard format or formats in which a publisher should be willing to provide data to the International Authorities or National Offices, before a title can be considered for inclusion in the PCT Minimum Documentation. Also, the publishers who are willing to provide data in the proposed format(s) may be identified by the Committee. A certain level of standardisation will enable the International Authorities and National Offices to accordingly invest in their electronic systems and will further contribute in enhancing the quality of examination.

10. In the alternative, the issue may be referred to the task force set up to prepare a detailed draft of all the technical specifications relating to the proposal to amend PCT Rule 34.

11. The PCT Working Group is therefore invited to note the contents of this document and to consider the proposed recommendations contained in para 9 and 10 above.

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