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The International
Patent System



PCT Updates

IP Information Roundtable

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PCT Minimum Documentation – Definition

PCT Rule 34 defines the minimum documentation that an International Searching Authority is required to consult:

- national patent documents (as specified in Rule 34.1(c))
- published international (PCT) applications, published regional applications for patents and inventors' certificates, and published regional patents and inventors' certificates
- other published items of non-patent literature as the International Searching Authorities shall agree upon and which shall be published in a list by the International Bureau ...

PCT Minimum Documentation – Issues

PCT minimum documentation needs revision:

- Definition of patent documents for electronic searching
 - Standards for Offices to have their national collections included in the PCT minimum documentation and allow access to Authorities and database providers
 - Types of documentation – utility models
 - Components of patent data that should be present in patent collections in PCT minimum documentation
- Non-patent literature
 - Electronic access to periodicals
 - Traditional knowledge databases (Indian TKDL)

PCT Minimum Documentation – Authority File

WIPO Standard ST.37 – Recommendation for an Authority File of Published Patent Documentation

- Authority file – list of all publication numbers assigned by an Office with various data elements
- Standard defines the data elements, and structure and format of file – adopted in May 2017
- Publication exception codes if document not available in machine-readable form
- Allows other IP Offices and other parties to assess completeness of available patent documentation
- [Authority File Portal](#) on WIPO website

PCT Minimum Documentation Task Force

European Patent Office took over leadership in 2016

- Four objectives (Appendix to document PCT/MIA/24/4)
 - Objective A: Create up-to-date inventory (patent and non-patent parts)
 - Objective B: Recommend criteria and standards for including a national patent collection
 - Objective C: Propose bibliographic and text components of patent data that should be present in patent collections
 - Objective D: Recommend criteria and standards for non-patent literature and assess proposal for adding Indian TKDL (led by USPTO)

PCT Minimum Documentation Task Force – Objective A

WIPO Handbook on Intellectual Property Information and Documentation

■ Part 4.1 – Inventory of Patent Documents

- Update to be published soon

- Links to authority files ([Authority File Portal](#), or IP Office website)

■ Part 4.2 – List of Non-Patent Literature

- Reflects information on each periodical as of June 1, 2020

PCT Minimum Documentation Task Force – Objectives B and C (1)

Proposed amendments to Rules 34 and 36

- Patent collections meeting technical and accessibility requirements will be part of PCT Minimum Documentation
- Any IP Office can make its patent collection available, but required for all International Authorities – more document collections
- Replaces current lists of countries and languages of national patent document in Rule 34.1(c)
- Utility model collections can be made available under same requirements as patent collections (searching preferred, but not mandatory)
- Entry into force before 2026

PCT Minimum Documentation Task Force – Objectives B and C (2)

Technical and accessibility requirements

- Electronically-searchable full text of document
- Machine-readable document in image format
- Publication exception code where not available

Applicability of requirements

- All documents published after entry into force
- Backfiles from a cut-off date (January 1, 1991) – to apply after transition period (10 years)

WIPO Standard ST.37 revised in November 2021

- New data elements to show availability and language of text-searchable abstract, description, claims

PCT Minimum Documentation Task Force – Objective D (1)

Criteria for inclusion of non-patent literature (NPL)

- Available to public in at least one online electronic format (for reasonable commercial fee, or at no cost)
- Readily available to International Searching Authorities in at least one acceptable online electronic format
 - With a search interface or indexed to be incorporated into search interface
- Terms of use must allow copies of citations to be sent to applicant, and designated/elected Office on request

PCT Minimum Documentation Task Force – Objective D (2)

Evaluation of resources for inclusion in PCT minimum documentation

- Comprehensive review by Authorities every 5 years
- Annual review to update metadata, and check for obsolete or discontinued resources
- Authorities recommend eligible resources for consideration and public can provide suggestions
- Evaluation criteria of a resource
 - Usage metrics
 - Subject matter
 - Cost of subscription or access

PCT Minimum Documentation Task Force – Next Steps

Virtual Meeting of Task Force from December 13 to 17, 2021

- PCT Administrative Instructions
 - Technical and accessibility requirements for patent documentation
 - Criteria for non-patent literature and review procedure
- Special treatment of traditional knowledge databases (e.g. Indian TKDL)
- Agreement to submit proposed amendments to PCT Meeting of International Authorities in 2022

PCT Assembly – October 2021

- Appointed Eurasian Patent Office as an International Searching and Preliminary Examining Authority
 - Effective when Office notifies date when it is ready to begin operations (probably early 2022)
- Reviewed supplementary international search system (next review at latest in 2027)
- Adopted Amendments to PCT Regulations to enter into force on July 1, 2022
 - Implementation of WIPO Standard ST.26 for presentation of sequence listings
 - Strengthening safeguards in case of general disruption

WIPO Standard ST.26 for Presentation of Sequence Listings using XML

- Transition by all Offices from WIPO Standard ST.25 to ST.26 on July 1, 2022 (“big bang” date)
- Amendment of PCT Rules 5, 12, 13^{ter}, 19.4 and 49
- Proposed modifications to Administrative Instructions with new Annex C – Circular C. PCT 1627
- WIPO Sequence Suite
 - WIPO Sequence – authoring tool for applicants to prepare ST.26-compliant sequence listings
 - WIPO Sequence Validator – enables IP Offices to verify compliance of sequence listings with ST.26

Strengthening Safeguards in Case of General Disruption

- Amendment of PCT Rule 82*quater*
 - Express authorization to waive the requirement to provide evidence to excuse delay in meeting a time limit
 - Authorization for Offices and Authorities to extend time limits covered by Rule 82*quater*, in addition to excusing delays in meeting such time limits
 - Start and end date of period of extension published and International Bureau notified
 - 2 month maximum extension period (additional periods can be established)

PCT Online Services

- XML Search Reports and Written Opinions – improvements to consistency and accuracy of data
 - Possible PCT citations database
- Transmission of National Phase Entry Information
- Modifications to PCT Administrative Instructions from January 1, 2022
 - Legal basis for conversion of applications into XML format
 - Encouraging more electronic communication between Offices and applicants
 - Decommissioning of PCT-SAFE



Thank you!

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