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INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PATENT COOPERATION TREATY (PCT)

Tenth Session
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PCT MINIMUM DOCUMENTATION:
COMPREHENSIVE REVIEW

Document prepared by the International Bureau

SUMMARY

1. PCT Rule 34 was made at a time when the search collections of the International Authorities were based on physical collections of documents. However, the Authorities increasingly rely, both for performing the search and retrieving copies of citations, on electronic databases of prior art whose scopes do not fit in neatly with the periodicals which currently form the agreed list of published items of non-patent literature under Rule 34.1(b)(iii). The Annex provides some considerations, elaborated by the European Patent Office (EPO), in favor of reviewing the way that the PCT minimum documentation is defined.

BACKGROUND

2. The PCT minimum documentation is defined by PCT Rule 34 (together with a list of periodicals published in the PCT Gazette) as follows:

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Rule 34
Minimum Documentation

34.1 *Definition*

(a) The definitions contained in Article 2(i) and (ii) shall not apply for the purposes of this Rule.

(b) The documentation referred to in Article 15(4) (“minimum documentation”) shall consist of:

(i) the “national patent documents” as specified in paragraph (c),

(ii) the published international (PCT) applications, the published regional applications for patents and inventors’ certificates, and the published regional patents and inventors’ certificates,

(iii) such 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 when agreed upon for the first time and whenever changed.

(c) Subject to paragraphs (d) and (e), the “national patent documents” shall be the following:

(i) the patents issued in and after 1920 by France, the former *Reichspatentamt* of Germany, Japan, the former Soviet Union, Switzerland (in the French and German languages only), the United Kingdom, and the United States of America,

(ii) the patents issued by the Federal Republic of Germany and the Russian Federation,

(iii) the patent applications, if any, published in and after 1920 in the countries referred to in items (i) and (ii),

(iv) the inventors’ certificates issued by the former Soviet Union,

(v) the utility certificates issued by, and the published applications for utility certificates of, France,

(vi) such patents issued by, and such patent applications published in, any other country after 1920 as are in the English, French, German or Spanish language and in which no priority is claimed, provided that the national Office of the interested country sorts out these documents and places them at the disposal of each International Searching Authority.

(d) Where an application is republished once (for example, an *Offenlegungsschrift* as an *Auslegeschrift*) or more than once, no International Searching Authority shall be obliged to keep all versions in its documentation; consequently, each such Authority shall be entitled not to keep more than one version. Furthermore, where an application is granted and is issued in the form of a patent or a utility certificate (France), no International Searching Authority shall be obliged to keep both the application and the patent or utility certificate (France) in its documentation; consequently, each such Authority shall be entitled to keep either the application only or the patent or utility certificate (France) only.

(e) Any International Searching Authority whose official language, or one of whose official languages, is not Japanese, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan, the Russian Federation and the former Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available. English abstracts becoming generally available after the date of entry into force of these

Regulations shall require the inclusion of the patent documents to which the abstracts refer no later than six months after such abstracts become generally available. In case of the interruption of abstracting services in English in technical fields in which English abstracts were formerly generally available, the Assembly shall take appropriate measures to provide for the prompt restoration of such services in the said fields.

(f) For the purposes of this Rule, applications which have only been laid open for public inspection are not considered published applications.

3. Paragraphs (a) and (b) are unchanged since the PCT was adopted in 1970. The definitions of the patent and non-patent literature have expanded to include a larger number of periodicals and countries' patent documents, but have not changed in character since 1970.

4. The PCT Committee for Technical Cooperation, at its twentieth session, held in Geneva from September 23 to October 1, 2002, noted the growing use of certain electronic databases by International Authorities (see paragraphs 9 and 10 of document PCT/CTC/20/4). The Committee mandated the Meeting of International Authorities "to make recommendations to the Committee on proposed modifications of PCT Rule 34 and proposed mechanisms for reviewing and maintaining the non-patent literature part of the PCT minimum documentation" (see paragraph 10 of document PCT/CTC/20/5).

5. It should be recalled that previous sessions of the Meeting of International Authorities have recommended the creation of an easily-updated electronic reference source to help identify the most useful databases for search in various fields of technology. See, for example, paragraph 35 of the Report of the eighth session (document PCT/MIA/8/6):

"... In addition, the reference to 'Annex B' should be replaced by a reference to an 'Intellectual Property Digital Library' (IPDL) to be established on WIPO's website. The text for that IPDL would be provided by, and would be maintained in the future by, the United States Patent and Trademark Office in consultation with the other Authorities. ..."

6. Work has begun on identifying the requirements of such a system, but the service is not yet available.

ISSUE

7. The Annex contains some considerations, elaborated by the EPO, in favor of reviewing the way that the PCT minimum documentation is defined together with some related considerations.

8. The Meeting is invited to consider the need for, and appropriate extent of, a review of how the PCT minimum documentation is defined.

[Annex follows]

ANNEX

PCT MINIMUM DOCUMENTATION:
EPO CONSIDERATIONS FOR A NEW APPROACH

Introduction

1. The PCT minimum documentation is defined by Rule 34 of the Patent Cooperation Treaty. It divides documentation in 2 parts: patent documents and non-patent documents.
2. During the last months, proposals were examined in order to add, or not, some periodicals to the list of periodicals agreed upon by the International Searching Authorities (ISAs); the area of traditional knowledge was particularly addressed.
3. This was an opportunity to reflect on the purpose of the definition of a minimum documentation to be consulted by the ISAs and to examine if the present defined documentation corresponds to the documentation ISAs are really using today.

Objectives of a Definition of Documentation

4. To find the relevant prior art for the patent granting procedure, and therefore to maximize the value of the granted patents.
5. To facilitate the understanding of the scope of the prior art searched by an ISA and the reuse of the work done.

Reasons for a New Definition

6. Any definition offers a compromise between what should be considered in an ideal complete search and what is practically possible.
7. The present definition has been elaborated at a time where the paper documentation was the backbone of the Offices' search activities.
8. The electronic publications, the databases and network connections have completely modified the working environment of the Offices.
9. New relevant sources of information are necessary to follow the development of the patent system. New publications are available on Internet very rapidly: a need for a new cooperation in order to identify the best resources is necessary.

Elements to Consider in a New Approach

– *Patent Documents*

10. For the patent documents, all documents available in electronic form in searchable text should be included, if available in English language (for example 1920 should not be a limitation).
11. The patent documents of all countries providing abstracts in English should be included through their abstracts.

– *Non Patent literature*

12. The core part of the non patent literature relevant to the patent Offices' activities can be limited broadly to the scientific, technical and medical literature.

13. All periodicals available in searchable electronic form should be considered. A large number are published by commercial publishers or learned societies. The full text of the past publications is often made available.

14. New electronic publications are available free-of-charge as a result of the Open Access movement.

15. Electronic information is also produced by universities and government agencies.

16. New types of resources are relevant for, for example, business methods, software related inventions, traditional knowledge.

17. The Internet in general is presenting new relevant resources in some technical areas.

– *Databases*

18. A number of databases are inevitable for a relevant search in some areas, for example chemical structures, biological sequences.

19. For efficiency reasons, databases from secondary publishers are unavoidable. They can replace a requirement for searching the full title.

20. New full text search possibilities are offered on the Internet: for example, Google initiative, Crossref.

Copyright-Related Questions

21. Offices using copyrighted literature must pay special attention to the protection of the copyright in the framework of their activities.

22. Nevertheless the copyright should not limit the Offices' ability to consider the entire relevant prior art in order to grant solid patents.

23. In the long term, the use of copyrighted material by Patent Offices should be facilitated by appropriate interpretation of this use in the different national laws. It is presently the case in some national laws only.

Relationship with the Publishers

24. The Offices could consider collective or global agreements with the publishers to facilitate the use of copyrighted articles in their activities.

25. The right to produce free of charge copies of cited articles when they are used by an Office as evidence material in any legal patent procedure should be included in agreements.

26. Similarly the right to exchange among Patent offices such articles cited as evidence material in a procedure should be included in agreements.

27. The right to store in electronic form, for internal reuse, the articles used or cited by patent Offices should be included in agreements. This would assure the permanent availability of articles used as evidence material in a procedure.

[End of Annex and of document]