

# WIPO



PCT/MIA/12/6

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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

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

Twelfth Session  
Geneva, December 12 to 16, 2005

PCT MINIMUM DOCUMENTATION:  
STATUS REPORT

*Document prepared by the International Bureau*

## SUMMARY

1. This document summarizes the actions taken with regard to the extension and review of PCT minimum documentation since the decisions made by the Meeting at its eleventh session held in Geneva from February 21 to 25, 2005. The Meeting is invited to take note of the progress made.

## BACKGROUND

2. The Meeting at its eleventh session discussed three items with regard to PCT minimum documentation (see document PCT/MIA/11/14, paragraphs 7 to 22) namely:

- (i) the extension of the non-patent literature part of the documentation to include traditional knowledge-related periodicals;
- (ii) a comprehensive review of the concept, definition and content of PCT minimum documentation; and
- (iii) the development of a Search Guidance Intellectual Property Digital Library.

3. This document provides a status report in respect of the first two items listed. A report on progress made in respect of the Search Guidance Intellectual Property Digital Library (SGIPDL) is given in document PCT/MIA/12/7.

4. With respect to 2(i) above, the Meeting reviewed the traditional knowledge-related periodicals proposed for inclusion and agreed that thirteen periodicals (as detailed in Annex I) should be added to the list of published items of non-patent literature forming part of the PCT minimum documentation under Rule 34.

5. With respect to 2(ii) above, the Meeting decided to set up a task force to undertake the requested comprehensive review of PCT minimum documentation and directed that the task force should address issues relating to both patent documentation, including questions of additional countries and languages, and to non-patent literature. The task force was also requested, as a priority task, to consider the technical issues that needed to be addressed to support the proposed addition of the patent documentation of the Republic of Korea into the set of patent documentation to be considered by the International Searching Authorities when conducting an international search.

## ACTION TAKEN

### *Update of the Non-Patent Literature List*

6. The updated non-patent literature list, incorporating the traditional knowledge-related periodicals and effective from June 1, 2005, was published on the WIPO website<sup>1</sup> and subsequently as Special Issue S-01/2005 of the PCT Gazette, dated August 11, 2005. As agreed by the Meeting in February, 2005, the new version was published in a new format which incorporated url references and also included updated information where appropriate in respect of periodicals already existing in the list.

### *Comprehensive Review*

7. Following the meeting in February 2005, the Authorities were invited to nominate representatives to the comprehensive review task force. All Authorities nominated at least one representative. A list of the task force members is provided in Annex II.

8. To facilitate the work of the taskforce, a section of the PCT Minimum Documentation pages on the PCT MIA website was set up exclusively for its use. These pages include an electronic forum to which members can post and read messages relating to their work. Relevant documents related to both the specific question of Korean Documentation and the wider issue of the Comprehensive Review were also included in the task force work area. Good use of the facilities were made to arrive at an agreed proposal in respect of the effective date of inclusion of the Korean Documentation into the PCT minimum documentation. It is hoped that the electronic forum will continue to be used to exchange information on any technical issues that might arise in respect of the implementation of the latter documentation into ISA search collections.

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<sup>1</sup> See <http://www.wipo.int/scit/en/standards/pdf/04-02-01.pdf>.

9. With regard to the broader issue of the review of PCT minimum documentation per se a first round of activity has taken place. To encourage contributions from task force members, the Chairman of the task force provided a list of suggested criteria to be taken into consideration when deciding on the material to be consulted during a Prior Art Search, reproduced in Annex III. Although to date responses have been received from only five of the Authorities the contributions themselves provide useful material to progress the discussions.

10. The USPTO provided a detailed response giving comments (by way of clarification and suggestions) on items included in the list of criteria. The importance of updating the PCT minimum documentation list to reflect new art areas and the desired linkage between PCT minimum documentation and the SGIPDL were also highlighted. The response from Australia also provided specific comments on the criteria as listed and proposed that a more limited set of criteria should apply namely ease and cost of access, reliability of the data and searchability of the documentation. The Russian response highlighted the additional need for some more formal criteria to assess the information value of a particular information source and proposed some tentative criteria for consideration.

11. Finally, with a view to improve the procedures relating to the update of the PCT minimum documentation list, the Austrian Office has proposed that Rule 34 PCT should be reviewed along the lines of Rule 89*bis*. In other words, Rule 34 would only state the principle of a minimum documentation and a broad outline of what should constitute it. The details of what constitutes PCT minimum documentation would then be dealt with in the Administrative Instructions which could then be modified as need be after consultation with the Offices and Authorities which have a direct interest in the proposed modification. The Austrian Office considers that in this way the PCT minimum documentation could be adapted speedily and non-bureaucratically to new developments.

#### NEXT STEPS

12. The International Bureau, in cooperation with the Comprehensive Review Task Force leader, will review the comments received from task force members with a view to the preparation of options and proposals on the way forward for further discussion early in 2006. Further input from the Meeting and/or comments from task force members will of course be welcome in the meantime.

*13. The Meeting is invited to note the progress made in respect of the update and review of the PCT minimum documentation.*

[Annexes follow]

## ANNEX I

### TRADITIONAL KNOWLEDGE-RELATED PERIODICALS ADDED TO THE LIST OF NON-PATENT LITERATURE FORMING PART OF THE PCT MINIMUM DOCUMENTATION

The following periodicals were added to the list:

- *Acta Pharmaceutica*;
- *Economic Botany, Journal of the Society of Economic Botany*;
- *Fitoterapia*;
- *Indian Journal of Traditional Knowledge*;
- *Journal of Chinese Medicine*;
- *Journal of Ethnopharmacology*;
- *Journal of Natural Products*;
- *Journal of Nutrition*;
- *Medicinal and Aromatic Plants Abstracts*;
- *Pharmaceutical Biology*;
- *Phytochemistry*;
- *Phytotherapy Research*;
- *Planta Medica*.

[Annex II follows]

## ANNEX II

### LIST OF TASK FORCE MEMBERS

#### AUSTRIAN PATENT OFFICE

Peter HOFBAUER, Head, Department Technics

Ingrid WEIDINGER, Head, Department of Information and Documentation

#### CANADIAN INTELLECTUAL PROPERTY OFFICE

Nathalie TREMBLAY, Project Officer

J. Scott VASUDEV, Acting Chief, Patent Administrative Policy, Classification and International Affairs

#### EUROPEAN PATENT OFFICE

Gérard GIROUD, Principal Director PD Tools

Marc KRIER, Director Applied Research and Development PD Tools

#### FEDERAL SERVICE FOR INTELLECTUAL PROPERTY, PATENTS AND TRADEMARKS OF THE RUSSIAN FEDERATION

Vera ARKHIPOVA, Head, International Legal Affairs Division

Gennady NEGULYAEV, Senior Researcher Associate

#### IP AUSTRALIA

Ed KNOCK, Supervising Examiner

#### JAPAN PATENT OFFICE

Ken-Ichiro NATSUME, Deputy Director, Examination Standards Office

Ken-Ichi MOROOKA, Deputy Director, Patent Examination Policy Planning Office

Hitoshi DOI, Deputy Director, Patent Information Promotion Policy Office

KOREAN INTELLECTUAL PROPERTY OFFICE

LEE Byung-Jae, Deputy Director, Information Planning Division

YOON Sei-Young, Deputy Director, Patent Examination Policy Division

NATIONAL BOARD OF PATENTS AND REGISTRATION OF FINLAND

Kristiina GRÖNLUND, Director, Patent Library and Advisory Services

Raimo HELLGREN, Senior Examiner

SPANISH PATENT AND TRADEMARK OFFICE

Gerardo PENAS, Head of the Technological Information Unit

Rosina VÁZQUEZ DE PARGA, Head of the Documentation Area

STATE INTELLECTUAL PROPERTY OFFICE OF THE PEOPLE'S REPUBLIC OF CHINA

WANG Ling, Deputy Division Director

SWEDISH PATENT AND REGISTRATION OFFICE

Kerstin BERGSTRÖM, Head, Patent Information

UNITED STATES PATENT AND TRADEMARK OFFICE

Ed RISHELL, International Liaison Staff

[Annex III follows]

## ANNEX III

### INITIAL PROPOSAL FROM THE TASK FORCE LEADER ON CRITERIA TO BE CONSIDERED IN THE MINIMUM REVIEW

2005-06-10

#### Minimum PCT Documentation MIA Task Force

Dear Colleagues,

Our task force should produce a proposal to “replace” the present “PCT Minimum Documentation Definition”.

We have the opportunity to adapt the concept to the present working environment of the Patent Offices and to propose an approach supporting the Patent System, its value for users and its acceptance by Society at large.

There was up to now very few mails exchange on the subject among the members of our Task force.

In order to invite contributions to our discussion and on the basis of the EPO presentation during the last MIA meeting, I have listed a series of criteria that we may consider in order to decide which material is to be consulted during a Prior Art Search.

*List of Criteria to consider including “publications” in the Minimum PCT Documentation List:*

#### *A- Patent Documents*

- 1. Data accessibility*
  - a. Data delivery*
  - b. Easy access*
  - c. Timeliness*
  - d. Completeness*
- 2. Data elements*
  - a. Bibliographic Data*
  - b. facsimile Images complete documents*
  - c. Abstracts in English and Original language*
  - d. Full text searchable complete documents*
  - e. Search reports*
- 3. Patent Information Policy:*
- 4. Effective Use of IPC 8 advanced level*
- 5. Backlog data available in facsimile form*
- 6. Development of a Machine Translation programme*

*B- Non Patent Literature*

1. *Availability in English AND electronic form.*
2. *Promote access to “Open Access” publications*
3. *Promote access to secondary publishers databases (efficiency)*
4. *Promote access to full text articles*
5. *Draw appropriate attention to “Open Access” and Internet Sources*
6. *Use of DOI*
7. *Promote Traditional Knowledge, biodiversity Information*
8. *Promote access to National NPL and translation*

*C- Specialized technologies and Databases*

1. *Chemistry*
2. *Biotechnology*
3. *Software*
4. *Traditional Knowledge*

I thank you in advance for your contribution and advice.

G rard Giroud

Chairman  
Task Force PCT Minimum Documentation

[End of Annex III and of document]