

## **Meeting of International Authorities under the Patent Cooperation Treaty (PCT) Working Group**

**Eighteenth Session  
March 15 to 17, 2011, Moscow**

### **PCT Minimum Documentation: Definition and Extent of Patent Literature**

*Document prepared by the International Bureau*

#### **SUMMARY**

1. A new definition is proposed for the patent literature part of the PCT minimum documentation, which aims to encourage the effective distribution and effective searching of patent information of all types from a greater range of States, as well as to give greater transparency to the extent of the documentation and to eliminate unnecessary distinctions between different classes of documentation based on language.
2. This document does not address the issue of the definition of non-patent literature. The International Bureau considers that it is more appropriate to await further analysis of the current extent and use of documentation by Authorities, which is being conducted in other fora (notably as part of one of the “Foundation Projects” of the “IP5” Offices), before taking any further action.

#### **CURRENT DEFINITION OF THE PATENTS LITERATURE PART OF THE PCT MINIMUM DOCUMENTATION**

3. The patent literature in the PCT minimum documentation currently consists of all international and regional patents, inventors’ certificates and applications for patents and inventors’ certificates, together with the “national patent documents”.
4. The current definition of “national patent documents” which form part of the PCT minimum documentation is complicated and does not give a clear result. It consists of a general definition followed by two exceptions, as outlined in the following paragraphs.

## General Definition

5. The general definition of national patent documents in Rule 34.1(c) includes:
  - (a) a list of countries whose patent documentation forms part of the minimum documentation, divided into item (i) (the patents issued after 1920 of countries which existed in 1920), item (ii) (the patents of countries which came into existence after 1920), and item (iii) (the patent applications published after 1920 of those sets of countries);
  - (b) additional publications similar to patent applications, including item (iv) (Soviet Union inventors' certificates) and item (v) (French utility certificates and applications for those certificates);
  - (c) in item (vi), any patent document published after 1920 in English, French, German or Spanish where no priority is claimed (so as not to duplicate disclosures already included under the previous categories), provided that the national Office of the interested country sorts them out and places them at the disposal of each International Searching Authority.
6. The items falling into categories (a) and (b), above, are clear and were practical in terms of the reality of what patent documentation was available at the time when the Rule was originally drafted and at the various times at which it was amended to include newly available major sources of patent documentation.
7. The final category (c), on the other hand, appears arbitrary in that it allows document collections to be added as a result of unilateral action by some national Offices but not others, based on a list of publication languages which has little practical relevance when compared to the range of languages which are likely to be understood by examiners in the Offices which today act as International Searching Authorities.
8. Furthermore, this provision has resulted in a situation where there is no reliable record of which Offices are actually making their documentation available. The *Inventory of Patent Documents According to PCT Rule 34.1 (Period From 1920 to 2000)* (Part 4.1 of the WIPO *Handbook on Industrial Property Information and Documentation*) states that Australia, Austria and Canada had chosen to make their documentation available in accordance with this provision, but there is no mechanism requiring Offices to notify the availability of their documentation to the International Bureau and the list has not been updated since November 2001. Consequently, despite the fact that many countries have scanned their old patent documentation and moved to electronic publication to make their patent information more readily available, it is not clear whether other Offices' documentation should currently be considered part of the PCT minimum documentation.

## Exceptions

9. Rule 34.1(d) provides a limitation to the documentation to say that, where a document is published more than once (as an application and a patent, or in republications of either type of document), the Office only needs to keep one version. This is a very practical limitation, allowing the volume of documentation which needs to be searched to be reduced without affecting the quality of the result since the technical content of the disclosure should be identical in all of the different versions (save for removal of embodiments not relevant to patents as finally granted). This exception should, however, be reviewed to consider taking patent families into account.

10. The limitation set out in Rule 34.1(e) allows International Authorities to exclude certain documentation where it is in a language which is not an official language of their Office and there is no English language abstract. This limitation is sensible in principle, since it reduces the volume of documentation to be stored and searched without materially affecting the result. However, the difference in languages listed in this exception compared to the documentation in the general definition means that, in practice, it is almost impossible for International Authorities to fully meet their obligations under Rule 36.1(iii), requiring Authorities to “have a staff which is capable of searching the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated”. While the fact that English language abstracts are available for the vast majority of the documentation listed in Rules 34.1(c) items (i) to (iii) means that the actual extent of this problem is limited, it would nevertheless be desirable to review the definition so as to promote a high quality result but still be realistically possible for International Authorities to use the relevant documentation.

### **Definition of Patents and Applications**

11. The definition of patents and applications for the purpose of Rule 34 is narrower than elsewhere within the PCT. Notably, it excludes utility models. If it were desired to add these to the PCT minimum documentation, it would presently be necessary to treat them as items of non-patent literature.

### **AIMS OF THE PATENT LITERATURE PART OF THE PCT MINIMUM DOCUMENTATION**

12. An important outcome agreed in the discussions during the 3rd session of the PCT Working Group was the need to improve the quality of the international search (see especially recommendations in paragraphs 143, 165 and 170 of document PCT/WG/3/2) and to reduce the number of invalidly granted patents.
13. From this perspective, the ideal aim of the patent literature part of the minimum documentation would be to ensure that all International Searching Authorities would search all technology which has been published as a patent document in any State (including those which are not party to the PCT), in any language, at any time, as long as the document's claimed priority date is prior to the filing date of the relevant international application.
14. Clearly, this ideal aim is still not realistic in practice both because of the lack of availability of many patent collections in formats practical for searching and for language-related reasons. Nevertheless, the Rule should encourage all States to make their documentation available in a usable form to International Authorities (as well as to other patent Offices and the general public) and require the International Searching Authorities to make the best use of the documentation which is supplied to them.
15. More generally, the definition of the minimum documentation should also promote the effective dissemination of technical information from a wider range of geographical sources and in a wider range of languages. In line with the recommendation set out in paragraph 165(c) of document PCT/WG/3/2, the International Bureau has assisted a number of national and regional Offices to digitize and make available their patent documents and is working with others to extend this further. For other Offices, the knowledge that they would have the right to include their patent documents into the PCT minimum documentation may be an additional incentive to join such programs and to make sure that their documents become available in a standard format which Offices and researchers can use effectively.

## PROPOSED NEW APPROACH

16. The Annex to this document contains draft amendments to Rule 34:
  - (i) to provide that the patent documentation part of the minimum documentation should, in principle, be all patent documentation which is available freely to national Offices and database providers in an electronic form meeting appropriate standards to be defined in the Administrative Instructions; while at the same time
  - (ii) providing a mechanism that ensures that there is a reliable indicator of what the extent of this documentation is and at least one source from which it can be obtained; and
  - (iii) maintaining a minimum set of exceptions to what International Authorities are required to search, tied more closely than at present to the actual needs of efficient searching and eliminating language-based differences which do not appear to serve any practical current purpose.
17. The term "patent documentation" would be construed in the broad sense which is generally understood by the Treaty, notably including utility models. The actual introduction of utility model collections into the minimum documentation would, however, only occur if the particular collection was the subject of a decision by the Assembly or a notification by an Office.
18. The exceptions referred to in paragraph 16(iii), above, are intended to allow the International Authorities to arrange and limit the documentation which they use in a way which maximizes their efficiency without reducing the quality of the international search in practice. These would permit (but not require) International Authorities to limit their search documentation:
  - (i) to a single member of each patent family, chosen at the convenience of the Authority, and
  - (ii) to patent families where at least one member is either published in, or has an abstract in, either English or a language of search of the Office.
19. An alternative approach to these exceptions could be to require that the databases used by International Authorities contain a copy of at least one version of every patent application falling within the basic definition (keeping the limitation that Offices do not need to keep all republications and granted patents as well as applications), but that the search may be conducted in a manner which limits the results to patent families where at least one member has been published in, or has an abstract in, either English or a language of search of the Office. This may be closer to how most International Authorities would work in practice, but would require the inclusion into databases of many documents which would probably never be retrieved except by application number as a result of a reference being found elsewhere.
20. It is also envisaged that the exception referred to in paragraph 18(ii), above, may be revisited in a few years time to deal with the question of machine translation-assisted searching, but the systems for searching patent documents with the assistance of machine translation are not yet sufficiently mature to justify taking this into account in the definition. On the other hand, given that machine translations are sometimes used to allow examiners to decide whether it is worth obtaining a high quality human translation, the Meeting may also wish to consider arrangements for making available any human translations which are

made, whether on an ad-hoc basis by the Office or provided by the applicant as part of an application file but not formally published, to assist search and technology transfer in the future.

## **IMPLEMENTATION**

### **Decisions and Notifications**

21. When adopting Rule 34 as proposed to be amended, the Assembly would be requested to make a decision as to the extent of the collections of national patent documents to be searched as of entry into force of the Rule as amended, such as that the extent of the collections of national patent documents would initially be considered to be the collections which were actually available (or scheduled to become available) in the search collections of International Authorities at the time of entry into force. This would include at least the present national patent documents, but would probably also extend the collection both in terms of countries of coverage and time periods.
22. To prepare this decision effectively, the International Authorities would be required to inform the International Bureau of the States whose national documentations are included in their search databases and of the earliest dates from which each national collection is believed to be complete in respect of:
  - (i) images of the documents;
  - (ii) title information for the documents;
  - (iii) abstracts for the documents;
  - (iv) full text information for the documents;
  - (v) classification information for the documents.

For the States referred to in Rule 34.1(c)(i), the complete collection for at least the images or the abstracts and titles of the documents should go back to at least 1920. For the States referred to in Rule 34.1(c)(ii), that collection should go back to the first published patents and applications.

23. It would then be open to any national Office to make a notification of availability of its national documentation. This would not necessarily require Offices to digitize their State's entire set of publications but could be limited to documents published as of a particular date, for example, to documents published since 1990. The draft Rule only provides for notifications to be made after the new Rule comes into force, but it is envisaged that transitional provisions would also allow such notifications to be made during the period following the adoption of the new Rule but before its entry into force, in which case the notification would become effective either one year from the date of its publication or from the date of entry into force of the new Rule, whichever came later.
24. In addition to the notification of entirely new collections by an Office whose national patent collection does not at present form part of the minimum documentation, notifications could also cover changes of source of availability for existing collections or extensions of existing collections to cover earlier dates.

### Appropriate Format of Availability

25. In order to encourage national Offices to make their patent collections freely available in a consistent format which will be easy to load into the various search databases used by different Offices, it will be necessary to define a standard to be included in the Administrative Instructions. It is envisaged that such a standard would need to include at least the following minimum features:
  - (i) each patent document represented as a ZIP file containing images of the pages in TIFF format, including indexing information to distinguish between the front page, description, claims, drawings and any other sections, such as search reports;
  - (ii) details in a ST.36-compliant XML format (either as indexes for the collection or as separate files for each publication) containing at least the publication number, earliest priority date, filing date, date of publication, title of the invention and abstract (in any language) for each publication. The abstract could be omitted in the case of documents for which abstracts are readily available to the public from an alternative source, such as a commercial patent database provider.
26. The standard should also cover information which is not essential but preferred to be included, including:
  - (i) the text of the description, claims and, where relevant, abstract in ST.36-compliant XML format;
  - (ii) classification information;
  - (iii) other bibliographic information, such as the names of the applicants and inventors, detailed priority data and citation information provided by the applicant or found as part of a national search;
  - (iv) machine-readable versions of complex structures within the description, claims or drawings, such as chemical formulae.
27. The preferred means of making the information available would be to include it on a server from which national Offices (including International Authorities) and database providers would be permitted to download it in bulk, though of course any supplier would be free also to offer alternative methods of distribution. The International Bureau maintains such a server holding international applications and would be willing to extend this facility to cover the national collections of any Office which wished to send their documents to the International Bureau on physical media, such as DVD. Alternatively, International Authorities should also consider whether documentation supplied only on physical media ought also to be accepted.
28. The term “freely available” should be understood to allow the provider hosting the collection to charge an administrative fee for access to the documents, providing that this was a fair reflection of the marginal costs of maintaining the data supply. The International Bureau would not charge any fee to national Offices for any such data which it supplied to them from its own data sources.
29. Some of the features listed as “preferred” might be included as requirements for new publications, even though it might be unreasonable to expect national Offices to collect the information as part of digitizing their backfiles.

30. The definition should also make clear that Offices which are already making their applications available in a different format to International Authorities can continue doing so and would not be required to change their output to a different format immediately for their future publications to remain part of the minimum documentation.

31. *The Meeting is invited to:*

- (i) comment on the proposals set out in the Annex;*
- (ii) make initial comments on the appropriate decisions and information referred to in paragraphs 22; and*
- (iii) make initial comments on the appropriate format of availability referred to in paragraphs 25 to 30.*

[Annex follows]

## ANNEX

## Rule 34

## Minimum Documentation

## 34.1 Definition

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

*[COMMENT: The definitions referred to are as follows:*

- (i) “application” means an application for the protection of an invention; references to an “application” shall be construed as references to applications for patents for inventions, inventors’ certificates, utility certificates, utility models, patents or certificates of addition, inventors’ certificates of addition, and utility certificates of addition;*
- (ii) references to a “patent” shall be construed as references to patents for inventions, inventors’ certificates, utility certificates, utility models, patents or certificates of addition, inventors’ certificates of addition, and utility certificates of addition’.*

*The minimum documentation would thus be extended to allow inclusion of all of these types of protection, to the extent that they were recognized as being available by virtue of a decision or notification as proposed in new paragraph (b), below.]*

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

- (i) the “national patent documents” as specified in paragraph ~~(e)~~(b),
- (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.

*[COMMENT: Renumbering only]*

[Rule 34.1, continued]

- ~~(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, the Republic of Korea 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.~~
- (b) Subject to paragraphs (e) and (f), the “national patent documents” shall be the patents issued and applications published by any State party to the Paris Convention for the Protection of Industrial Property or to the Convention Establishing the World Intellectual Property Organization, to the extent that those documents have been made freely available to national Offices and database providers in electronic form in accordance with the Administrative Instructions from at least one source either recognized by a decision of the Assembly or notified to the International Bureau by the national Office of the relevant State or a successor State.

*[COMMENT: This would permit the patents part of the minimum documentation to be extended to all patent documentation (in the broad sense of Article 2(i) and (ii)) from all Paris or WIPO States which are prepared to make it available in electronic form, while also ensuring that the scope of the documentation is clearly stated for any Office which wishes to check whether it in fact has access to all of it. New documentation sets could be included either collectively by a decision of the Assembly or unilaterally by a notification made by the national Office of a State which wished its documentation to be included and had made it available in a suitable format.]*

- (c) Any decision by the Assembly under paragraph (b) shall be published in the Gazette and shall, unless otherwise specified, be effective one year from the date of publication.

*[COMMENT: In general, a year should be sufficient to allow procedures to be set up for retrieving the relevant documentation and ensuring that it is properly integrated into search databases. The Assembly could also be reliably advised by International Authorities of cases where the documentation is in fact already available to them, permitting an earlier start date to be specified.]*

[Rule 34.1, continued]

(d) The International Bureau shall confirm the availability and format of documents referred to in a notification by a national Office under paragraph (b) and, if availability and format of documents are confirmed, promptly publish the notification in the Gazette. The notification shall be effective one year from the date of publication.

[COMMENT: For notifications made unilaterally by Offices, a year should be sufficient to allow procedures to be set up for retrieving the relevant documentation and ensuring that it is properly integrated into search databases. In this case, there is no possibility proposed for a shorter time period since the International Authorities will not have had any opportunity to indicate that they would be capable of including the documents earlier.]

~~(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) Where a family of applications or patents within the documents referred to in paragraph (b) includes multiple publications of the same invention, the documentation kept or used by an International Searching Authority need not include all of those publications but must, subject to paragraph (f), include at least one of those publications.

[COMMENT: This would allow each International Authority to decide which family member to keep, based on any criterion that it wished (for example, choosing a preferred language version and favoring patent applications over granted patents). The means of defining a family is deliberately not limited to basing the question on common priorities since some family databases include matching based on more sophisticated techniques.]

~~(e) Any International Searching Authority whose official language, or one of whose official languages, is not Japanese, Korean, Russian or Spanish is entitled not to include in its documentation those patent documents of Japan, the Republic of Korea, 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.~~

[Rule 34.1, continued]

(f) Any International Searching Authority is entitled to exclude from the documentation which it keeps or uses any families of documents for which there is no document referred to in paragraph (b) where either the document or an abstract of the document is available in either English or an official language of search of that Authority. Where abstracts subsequently become available in English or an official language of search of an Authority, the relevant families shall be included in the Authority's documentation no later than six months from the date when the abstracts become available.

*[COMMENT: English language abstracts are produced for at least one member of a large majority of patent families and it is important that an Authority is able to make use of these to conduct a high quality search. However, there does not appear to be any justification for the assumption implicit in the difference between the languages in existing paragraph (e) and existing paragraph (c)(vi) that the examiners in all Authorities must be fluent also in French, German and Spanish.*

*The term "official language of search" is intended to cover both official languages of the Office and other languages in which an Office conducts national or international searches. For example, the European Patent Office has English, French and German as official languages, but also conducts certain searches on applications or international applications filed in Dutch, and the Brazilian National Institute of Industrial Property has Portuguese as an official language, but also conducts searches on international applications filed in English and Spanish.]*

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

*[COMMENT: Renumbering only]*

(h) Where

(i) documentation which had been the subject of a decision by the Assembly or a notification by a national Office under paragraph (b) ceases to become available from the relevant source; or

(ii) the establishment of English abstracts is interrupted where they had previously been available for patent documents from a particular State or in a particular technical field,

the Assembly shall take appropriate measures to provide for the prompt restoration of availability of the documentation or abstracting services. Failing this, a notice of the ceasing of the relevant supply shall be published in the Gazette.

*[COMMENT: based on the requirements at the end of existing paragraph (e).]*

[End of Annex and of document]