

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

**Twenty-Seventh Session
Gatineau, February 6 and 7, 2020**

MINIMUM DOCUMENTATION TASK FORCE: STATUS REPORT ON OBJECTIVE D

Document prepared by the United States Patent and Trademark Office

BACKGROUND

1. In December 2016, the European Patent Office (EPO) posted a high-level position paper on the activities of the Task Force on PCT Minimum Documentation, in their capacity as the head of the Task Force (see Appendix to document PCT/MIA/24/4). In that paper, the EPO proposed that the activities of the Task Force should be grouped into four objectives. The fourth objective, Objective D, was to develop criteria and standards for the review, addition and maintenance of non-patent literature (NPL) and traditional knowledge-based (TK) prior art. It also included assessing, based on those criteria and standards, the proposal from the Indian Patent Office to include the Traditional Knowledge Digital Library (TKDL) database in the PCT Minimum Documentation. The United States Patent and Trademark Office (USPTO) volunteered to lead the efforts with regard to Objective D. This document reports on work under Objective D; document PCT/MIA/27/11 provides a status report from the EPO on Objectives A to C.

2. In July 2018, an initial survey was sent to the International Authorities (ISA/IPEA) regarding their use of NPL and TK-based prior art sources and databases in their prior art searches. This survey resulted in 16 responses. These responses and further questions were discussed in May 2019, at the PCT Minimum Documentation Task Force meeting held in Munich. The outcome of this meeting for Objective D, was to continue the discussion and development of a proposal for criteria by which to evaluate NPL in the WIPO wiki. The USPTO posted a follow up questionnaire in July 2019 of which a summary and next steps are identified below.

CURRENT STATUS OF OBJECTIVE D DISCUSSIONS

3. The follow-up survey posted in July 2019 sought to identify criteria by which to evaluate NPL for inclusion in a revised PCT Min Doc list. These criteria largely fell within three categories: Subscription Practices, Subject Matter, and Quality and Reliability. An additional area of questions discussed considerations for future maintenance activities of the NPL PCT Min Doc list. This survey resulted in six responses.

4. Several themes emerged from an analysis of the responses provided, which indicate some areas of common views among the ISA/IPEAs with respect to the desired criteria for evaluation of NPL for PCT minimum documentation. Observations regarding the trends seen in the answers provided are set forth below:

5. Subscription Practices

(a) What format (print or electronic) should be preferred for PCT Minimum Documentation content?

The overwhelming preference of all respondents is only to include resources that are available in an electronic format.

(b) Should cost be part of the evaluation criteria for inclusion of content in the PCT Minimum Documentation list? If so, how do you propose that this should be judged?

Most Authorities indicated that cost should be considered upon initial inclusion of a resource to the PCT Min Doc list; however, Authorities also indicated that cost should be balanced with subject matter and contribution to the search process. Consensus should be reached by all Authorities on a resource before inclusion on the list to ensure that cost is not prohibitive to any one Authority.

(c) What (if any) access requirements would you propose in the evaluation of content for the PCT Minimum Documentation list? Access may include subscription/purchase terms, methods of electronic access such as IP or credentials, etc.

Overall, the preference from responding Authorities appears to be for IP authenticated access where available. Several Authorities indicated that the access requirements would vary from contract to contract, and the terms of use established via contractual methods; however, the ease of access was a criterion of importance.

6. Recommendations for Task Force Consideration for Subscription Practice Criteria:

- All resources considered for the NPL Minimum Documentation list must be available electronically.
- Cost should be considered in the evaluation of a resource for inclusion in the NPL Minimum Documentation list. Consensus amongst Authorities must be reached for adding a resource to the NPL Min Doc list. This topic should be further discussed to determine the process by which Authorities should evaluate cost.
- Ease of access should be considered when evaluating a resource for inclusion in the NPL Minimum Documentation list. This topic should be further discussed to identify any additional specifications associated with this.

7. **Subject Matter**

(a) Are there particular areas of examination or particular subject areas that are not sufficiently represented on the PCT Minimum Documentation list? If so, what areas would you propose?

Generally, the responding Authorities felt that the current list does appropriately cover a wide variety of technologies found in examination; however, reviewing the list provides an opportunity to update the subjects and resources contained. It is recognized that this list is meant to be a small sample of the overall NPL utilized by examiners in their day-to-day examination process. Additionally, the Task Force needs to balance the number and quality of resources on the list with the overall costs required to support those titles.

8. Recommendations for Task Force Consideration for Subject Matter Criteria:

- Once a set of criteria and guidelines has been finalized, current resources on the PCT Min Doc list should be evaluated and consensus should be reached on whether they should continue to be included in the new list. Additionally, the International Authorities will be invited to propose new resources for inclusion.

9. **Quality and Reliability**

(a) How do you judge quality/reliability of content for inclusion in your NPL collection?

Most respondents identified quality and reliability based on the following attributes: Consistency of publication; Commercial availability / known publisher; Examiner recommendation; Relevancy of content; and High use / demonstrated need.

(b) What criteria would you use to identify a reliable publisher?

Most respondents identified consistency of publications and established known publishers in the field as a method to identify a reliable publisher. Additionally, the use of the publications produced by the publisher is another factor in identifying a reliable publisher, to include how frequently journals are cited, the use of the technical community, and user recommendations.

(c) Do you think it is important to include the top publications found in particular subject/examination areas? If so, how would you propose that these be identified?

Five out of the six respondents identified top publications for examination be included in a PCT Min Doc list. The fifth respondent identified a combination of need and cost as a consideration in acquiring top publications.

The general consensus was that top publications could be identified through usage data. Suggestions for usage data included identifying bibliometrics, database/content usage statistics, or through Authorities' use in the patent process.

(d) Do you think it is important to consider the length of a publication's history in evaluating the reliability of the content/publisher? If so, what criteria would you propose?

The length of publication was important to some respondents and not to others. The amount of time that a resource has been published may have no bearing on the quality, authority and relevancy of the resource, especially in new and developing technology areas.

10. Recommendations for Task Force Consideration for Subject Matter Criteria:

- Publisher reliability and content quality may help guide the discussion on resources to be added NPL Min Doc list; however, due to the varied nature of reliability and quality characteristics, there should be no set criteria for this.
- Authorities should collate a list of top resources used at their individual office that they would like to be considered for inclusion on the revised PCT Min Doc list. These publications/resources should be discussed and evaluated against identified criteria and consensus reached for inclusion on the updated list. Further discussion is needed to determine whether the definition of use should be standardized across Authorities, or whether each Authority should determine their own method of identifying high use resources.

11. Regarding relevancy of content, high use / demonstrated need, and usage data discussed in 9(a) to (c) above, the USPTO would like to query the other members of the Task Force as to whether any would have the ability and resources, and would be willing, to provide the Task Force with a report on how often the various NPL/TK publications and documents that are currently included in the Minimum Documentation have been cited in international search reports over the past several years.

12. Maintaining the NPL PCT Minimum Documentation List

(a) *How frequently should this list be reviewed for updates?*

The majority of respondents felt that the list should be reviewed between three to five years. As some respondents noted, the schedule to review for removal of obsolete items or metadata updates may need to be more frequent. One additional suggestion was to use the WIPO wiki as place for Authorities to suggest potential NPL sources, even though these would not be officially included as part of the minimum documentation list.

(b) *What parameters would you propose in regard to retention of content? (i.e. would you propose that an Authority must maintain access to the full publication period of content, or would you propose access to specific date ranges? Or other thoughts on this topic?)*

There was a wide variety of responses to this question. Generally speaking, all responding Authorities felt that there should be some date limitations placed on the resources included in the PCT Min Doc list in order to contain the costs of subscriptions and space.

(c) *What publishing/access issues could create a barrier to compliance, and how do you propose that the Task Force address these?*

Overall, respondents confirmed that any resources that present access issues that create a barrier to compliance for any Authority is likely not a good candidate for the NPL PCT Min Doc list.

(d) *What other considerations should be discussed in the maintenance and upkeep of this list?*

Responding Authorities shared the following:

- Create a document that clearly states the defined criteria for inclusion/removal of content from the list.

- Create revision procedures.
- A method by which patent examiners can share and identify their most important sources would be helpful.
- There would be value in IPOs submitting statistics for established periods to determine if sources included on the list are being used for examination.
- Completely eliminate the NPL min doc list or limit its size.
- Identify a restricted list of compulsory NPL, plus a set of optional, recommended NPL.

13. Recommendations for Task Force Consideration for NPL PCT Min Doc List Maintenance:

- Every year, the Task Force should review the existing list for obsolete and discontinued resources for removal, as well as metadata updates. Every three years, the Task Force should review the list for updates and potential new resources.
- There should be retention parameters built into the NPL Min Doc list to allow Authorities to contain the cost and space required by subscriptions. The exact parameters required need further discussion by the Task Force.
- The Task Force should undertake further discussion on the overall maintenance of the PCT Min Doc list, and specific guidelines/procedures should be adopted.
- The Task Force should continue to discuss the issues and suggestions raised in paragraph 12(d).

NEXT STEPS

14. The Task Force will continue to discuss the issues and ideas raised through the second survey, and as discussed herein. In this regard, the USPTO would propose the following timeline for further work:

- The Task Force will submit further comments on this document to the wiki by the end of February 2020;
- The USPTO will take the responses to the second survey, the discussions by the Meeting, and the further comments submitted to the wiki, and develop an initial draft of proposed criteria and standards for the review, addition and maintenance of NPL and TK prior art in the PCT Min Doc, and will post them to the wiki by the end of April 2020;
- The Task Force will be invited to submit comments on the draft proposal by the end of June 2020;
- Based on the comments received, the USPTO will post a revised draft of proposed criteria by the end of August 2020;
- The Task Force will be invited to submit comments on the revised draft proposal by the end of October 2020;
- Based on the second round of comments, the USPTO will prepare a finalized set of criteria by which NPL Min Doc recommended resources are to be evaluated for presentation to the next session of the Meeting in 2021.

Once these steps are complete, the Task Force will determine next steps on identifying resources for evaluation and inclusion in the revised NPL/TK PCT Min Doc list.

15. Depending on the responses to the initial draft proposal discussed in the second bullet of paragraph 14, the Task Force may also wish to consider whether it should hold another physical meeting of the Task Force in 2020.

16. The Meeting is invited to comment on this update in general and specifically on:

(i) whether any Task Force member would be willing to provide a report regarding relevancy of content, high use / demonstrated need, and usage data as discussed under paragraph 11;

(ii) the recommendations for consideration as set forth in paragraphs 6, 8, 10, and 13; and

(iii) the next steps outlined in paragraphs 14 and 15.

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