

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

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CITATION OF NON-WRITTEN DISCLOSURES

Document prepared by the International Bureau

SUMMARY

1. This document discusses the citation of prior art which is not in a written form. With the growing popularity of the Internet, non-written disclosures such as video or audio files are becoming increasingly relevant as a means to disseminate technical information. In the PCT, the definition of relevant prior art for both international search and international preliminary examination is limited to written disclosures. This document discusses issues related to broadening this definition to cover all types of disclosure, along with related changes to the legal framework that would allow consideration of non-written disclosures in the reasoned statement related to novelty and inventive step in written opinions and international preliminary reports on patentability.

BACKGROUND

PCT LEGAL FRAMEWORK

2. PCT Rules 33.1(a) and 64.1(a) define relevant prior art as being everything which has been made available to the public anywhere in the world prior to the relevant date (either the international filing date or a claimed priority date) “by means of written disclosure (including drawings and other illustrations)”.

3. When preparing the international search report, Rule 33.1(b) requires examiners to mention separately any written disclosure made on or after the international filing date that refers to a non-written public disclosure (such as oral disclosure, use or exhibition) that took place prior to the international filing date.

4. When preparing the written opinion or international preliminary report on patentability, Rule 64.2 deals with non-written disclosures. Such disclosures are not considered as prior art for the consideration of novelty and inventive step. Where the disclosure took place prior to the relevant date and is referred to in a written disclosure made on or after the relevant date, Rule 70.9 requires the opinion or report to indicate the kind of disclosure, the date on which the written disclosure was made available to the public, and the date on which the non-written disclosure occurred in public. However, the opinion or report does not include any reference to the relevance of non-written disclosure to novelty or inventive step.

HISTORICAL CONTEXT

5. The limitation to written disclosures in the definition of relevant prior art was a pragmatic reaction to the International Searching Authority basing its search on documents in its files. Paragraph 27 of the “Memorandum on Questions concerning the Proposed International Search” (document PCT/II/2) prepared for the Working Group on the BIRPI Plan for Facilitating the Filing and Examination of Applications for the Protection of the Same Invention in a Number of Countries: Plan for a Patent Cooperation Treaty (PCT) that met in Geneva from March 25 to 29, 1968, explains the intended scope of the proposed international search:

“27. International search will be based on documents. Even if the definition of prior art refers to ‘everything made available to the public ... by means of ... oral description, use ...,’ it is understood that the Searching Authority will not monitor lectures and uses but will take them into account only if the oral description or the actual use is recorded in a document it has in its files. Of course, the date of the first oral delivery or of the first use (rather than the date of the document) may be relevant in some countries, but that is a different matter”.

6. With the advent of video or audio sharing platforms on the Internet, companies and academic institutions have been increasingly relying on online services to inform the public about new products or technologies. Consequently, patent examiners drafting international search reports have been citing more non-written material. In 2007, only one international search report included a YouTube citation. Ten years later, in 2017, this number increased to 351, while in 2020, this figure reached 488¹.

CITATION OF NON-WRITTEN DISCLOSURES

CURRENT PRACTICE

7. With regard to non-written disclosures retrieved from the Internet, such as videos and audio files, paragraph 15 of WIPO Standard ST.14 “Recommendation for the inclusion of references cited in patent documents” gives examples for the citation of video, audio, or multimedia files made available on the Internet (see Examples 15 to 17). The examples indicate the format of the publication content, the publication date, the date that the document was retrieved from the Internet and the URL.

8. Section 507(a) of the Administrative Instructions requires any document referring to a non-written disclosure to be cited using the letter “O” in the international search report, which shall be accompanied by one of the categories “X”, “Y” or “A”. This is also reflected in paragraph 16.70 of the International Search and Preliminary Examination (ISPE) Guidelines.

9. For the written opinion or international preliminary report on patentability, if the examiner has discovered a relevant document which refers to a non-written disclosure before the relevant date, but the document was only published on or after the relevant date of the international application, the examiner would not make a detailed explanation of the relevance to novelty and inventive step in Box No. V of the opinion or report. Rather, Box No. VI would include an

¹ Figures extracted from European Patent Office Espacenet database: <https://worldwide.espacenet.com/>.

indication of: (i) the kind of non-written disclosure; (ii) the date on which the non-written public disclosure occurred; and (iii) the date on which the document was made available to the public (paragraph 17.46 of the ISPE Guidelines).

10. It would appear useful both to applicants and to designated/elected Offices if this practice were changed to explain the apparent relevance of non-written disclosures in the same way as for written ones.

Legal Certainty for Non-Written Disclosures

11. The definition of prior art in national and regional laws generally covers any means of public disclosure, be it in a written form, oral form, use, etc. It is believed that all PCT Contracting States would consider a non-written disclosure as prior art, subject to appropriate evidence being available. The International Bureau therefore recommends amending Rules 33.1 and 64.1 to make this the case for international search and preliminary examination, as discussed below.

12. As the final decision on novelty and inventive step lies with the designated or elected Office, the ISPE Guidelines indicates that an examiner should cite documents in the case of doubt of their relevance. Paragraph 15.64 of the ISPE Guidelines states:

“15.64 Since the final decision with respect to novelty is not the responsibility of the International Searching Authority but of the designated Offices, the International Searching Authorities should not discard documents merely because of doubt as regards, for example, the exact date of publication or public availability, or the exact contents of an oral disclosure, exhibition, etc., to which such documents may refer. The International Searching Authority should try to remove any doubt that may exist and should cite the documents concerned in the international search report unless the date of publication or of public availability of the document concerned is clearly the same as, or later than, the filing date of the international application. Additional documents providing evidence in matters of doubt may be cited. Where the date of the reference is not clearly established, the examiner should cite the document as a category ‘L’ document (see paragraph 16.75) and indicate in the search report that the exact date of publication has not been established.”

13. In general, patent examiners are limited to the evidence visible directly from the source of the citation, or occasionally trusted secondary archives as discussed below. They cannot actively seek additional evidence. Nevertheless, it would generally be useful for the written opinion to include a detailed explanation of the apparent relevance of a non-written disclosure to novelty and inventive step, provided there is at least *prima facie* evidence that the material was available before the relevant date.

14. Internet citations may provide a level of legal certainty of the publication date when the prior art is made available by a trusted online content provider. For instance, when citing a YouTube video, the upload date associated with the video is widely recognized as the official publication date. In other cases, however, the content may be only temporarily available online, or may be modified several times after its initial publication. The date of publication may also be merely indicative if the source is not a trusted content provider. As a remedy, some Authorities rely on a digital archive of the Internet such as the Internet Archive Wayback Machine in order to establish the content obtained from a certain URL at a precise point in time, although not all Internet resources are indexed by this service.

15. Many Offices seek to store copies of citations found in searches of sources that do not guarantee availability of unchanged versions at a later date. Where this can be done by International Searching Authorities in a way that would guarantee availability also to designated and elected Offices after entry into the national or regional phase, this would be a significant

benefit. However, the International Bureau does not propose at this stage to create an obligation in this regard, beyond what currently appears in Articles 20(3) and 36(4).

UPDATING THE LEGAL FRAMEWORK

Definition of Prior Art

16. The Annex to this document sets out draft amendments to the PCT Regulations that would extend the definition of relevant prior art to cover all types of disclosure, both written and non-written. These amendments intend to provide a definition of the prior art that is consistent with national and regional patent jurisdictions.

Citing Non-Written Disclosures in International Search Reports, Written Opinions and International Preliminary Reports on Patentability

17. The amendments to the PCT Regulations would require consequential simplifications of the forms for written opinions and international preliminary reports on patentability by removing the distinct treatment of non-written disclosures. The examiner would consider non-written disclosures in the reasoned statement with regard to novelty, inventive step and industrial applicability in Box No. V, removing the need for the second section of Box No. VI of these opinions and reports. Some further clarifications to the ISPE Guidelines on citation of non-written prior art could be considered.

18. Section 503 of the Administrative Instructions requires any document cited in the international search report to be as provided in WIPO Standard ST.14. Paragraph 15 of WIPO Standard ST.14 lists items to be provided for electronic documents. For non-written disclosures on the Internet, this includes the URL, publication date and retrieval date. However, this paragraph does not distinguish between the date of the disclosure and the date that the disclosure was uploaded onto the Internet. In addition, there is no explicit recommendation on how an examiner should identify relevant passages for videos or audio recordings, such as timestamps (e.g. "0:20 to 0:45"), or via virtual chapters when the video is broken up into sections. There may therefore be a need to add further guidance in the ISPE Guidelines on the information from a non-written disclosure that should be included in the international search report to provide for a uniform approach between International Authorities. Any guidance in this area could also be proposed in a revision to WIPO Standard ST.14.

NEXT STEPS

19. If the Meeting considers that these proposals are broadly in the right direction, the International Bureau would propose amendments to the PCT Regulations for consideration by the PCT Working Group and begin informal consultations through the Quality Subgroup electronic forum on the recommendations for citations by means of draft modifications to the ISPE Guidelines, with a view to preparing formal proposals in a PCT Circular at a later date.

20. The Meeting is invited to comment on the issues set out in paragraphs 11 to 19 of this document.

[Annex follows]

DRAFT PROVISIONAL AMENDMENTS
TO THE PCT REGULATIONS²

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² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 33

Relevant Prior Art for the International Search

33.1 *Relevant Prior Art for the International Search*

(a) For the purposes of Article 15(2), relevant prior art shall consist of everything which has been made available to the public anywhere in the world by means of written **disclosure** (including drawings and other illustrations) or oral disclosure, use, exhibition or other means and which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step (i.e., that it is or is not obvious), provided that the making available to the public occurred prior to the international filing date.

(b) [Deleted] ~~When any written disclosure refers to an oral disclosure, use, exhibition, or other means whereby the contents of the written disclosure were made available to the public, and such making available to the public occurred on a date prior to the international filing date, the international search report shall separately mention that fact and the date on which it occurred if the making available to the public of the written disclosure occurred on a date which is the same as, or later than, the international filing date.~~

(c) [No change] Any published application or any patent whose publication date is the same as, or later than, but whose filing date, or, where applicable, claimed priority date, is earlier than the international filing date of the international application searched, and which would constitute relevant prior art for the purposes of Article 15(2) had it been published prior to the international filing date, shall be specially mentioned in the international search report.

33.2 and 33.3 [No change]

Rule 43

The International Search Report

43.1 to 43.8 [No change]

43.9 *Additional Matter*

The international search report shall contain no matter other than that specified in Rules 33.1(~~b~~) and (c), 43.1 to 43.3, 43.5 to 43.8, and 44.2, and the indication referred to in Article 17(2)(b), provided that the Administrative Instructions may permit the inclusion in the international search report of any additional matter specified in the Administrative Instructions. The international search report shall not contain, and the Administrative Instructions shall not permit the inclusion of, any expressions of opinion, reasoning, arguments, or explanations.

43.10 [No change]

Rule 64

Relevant Prior Art for the International Preliminary Examination

64.1 *Prior Art*

(a) For the purposes of Article 33(2) and (3), everything made available to the public anywhere in the world by means of written **disclosure** (including drawings and other illustrations) or oral disclosure, use, exhibition or other means shall be considered prior art provided that such making available occurred prior to the relevant date.

(b) [No change]

64.2 *[Deleted] Non-Written Disclosures*

~~In cases where the making available to the public occurred by means of an oral disclosure, use, exhibition or other non-written means (“non-written disclosure”) before the relevant date as defined in Rule 64.1(b) and the date of such non-written disclosure is indicated in a written disclosure which has been made available to the public on a date which is the same as, or later than, the relevant date, the non-written disclosure shall not be considered part of the prior art for the purposes of Article 33(2) and (3). Nevertheless, the international preliminary examination report shall call attention to such non-written disclosure in the manner provided for in Rule 70.9.~~

64.3 *Certain Published Documents*

[No change] In cases where any application or any patent which would constitute prior art for the purposes of Article 33(2) and (3) had it been published prior to the relevant date referred to in Rule 64.1 was published on a date which is the same as, or later than, the relevant date but was filed earlier than the relevant date or claimed the priority of an earlier application which had been filed prior to the relevant date, such published application or patent shall not be considered part of the prior art for the purposes of Article 33(2) and (3). Nevertheless, the international preliminary examination report shall call attention to such application or patent in the manner provided for in Rule 70.10.

Rule 70
International Preliminary Report on Patentability
by the International Preliminary Examining Authority
(International Preliminary Examination Report)

70.1 to 70.8 *[No change]*

70.9 *[Deleted]* ~~*Non-Written Disclosures*~~

~~Any non-written disclosure referred to in the report by virtue of Rule 64.2 shall be mentioned by indicating its kind, the date on which the written disclosure referring to the non-written disclosure was made available to the public, and the date on which the non-written disclosure occurred in public.~~

70.10 *Certain Published Documents*

[No change] Any published application or any patent referred to in the report by virtue of Rule 64.3 shall be mentioned as such and shall be accompanied by an indication of its date of publication, of its filing date, and its claimed priority date (if any). In respect of the priority date of any such document, the report may indicate that, in the opinion of the International Preliminary Examining Authority, such date has not been validly claimed.

70.11 to 70.17 *[No change]*

[End of Annex and of document]