

Patent Cooperation Treaty (PCT) Working Group

**Twelfth Session
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PCT MINIMUM DOCUMENTATION: STATUS REPORT

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SUMMARY

1. This document reports on the activities carried out by the PCT Minimum Documentation Task Force (“the Task Force”) in 2018-2019 and on its tasks for 2019-2020.

BACKGROUND

2. In January 2016, there was consensus at the Meeting of International Authorities (MIA) to reactivate the Task Force and the International Bureau invited one of the International Searching Authorities (ISAs) to replace it. The MIA invited the Task Force to resume its work on the basis of document PCT/MIA/23/5 (see paragraph 63 of document PCT/MIA/23/14), and “to recommence its discussions on the addition of databases, including traditional knowledge databases, to the PCT Minimum Documentation, as set out in document PCT/MIA/12/6” (see paragraph 85(a) of document PCT/MIA/23/14). Also, following India’s request that the Indian Traditional Knowledge Digital Library database (TKDL) be included in the PCT Minimum Documentation (see document PCT/MIA/23/10), the MIA invited the Indian Patent Office “to submit a detailed working document to the Task Force, including a revised draft of the access agreement, setting out its proposals with regard to the inclusion of the Indian TKDL into the PCT Minimum Documentation, taking into account previous discussions in the Meeting, the Task Force and the IGC, as well as the discussions held at the present session of the Meeting” (see paragraph 85(b) of document PCT/MIA/23/14). Finally, the MIA invited the International Bureau “to work closely with the Indian Patent Office in the coming months with a view to moving the issue forward, where appropriate by means of informal consultations and written communications, such as PCT Circulars, to ensure proper preparation of the discussions to be held at the next session of the Meeting in 2017” (see paragraph 85(c) of document PCT/MIA/23/14).

3. In February 2016, the European Patent Office (EPO) responded positively to the call of the International Bureau and agreed to lead the Task Force on the basis of the mandate given by the MIA (document PCT/MIA/23/14).

AGREED OBJECTIVES

4. Since 2005, the overarching objective of the Task Force has been to examine all factors relating to the maintenance and revision of the list of patent and non-patent literature collections belonging to the PCT Minimum Documentation, and to recommend objective criteria that patent and non-patent literature collections, in both paper and electronic formats, must adhere to in order to be considered for inclusion in the PCT Minimum Documentation.

5. The mandate given to the Task Force (see paragraph 9 of document PCT/WG/9/22), as noted by the PCT Working Group in May 2016, is as follows:

(a) Clarify the extent of the existing PCT Minimum Documentation, in view of the fact that the WIPO Handbook on Industrial Property Information and Documentation is outdated, the definition and extent of patent literature having last been revised in November 2001, and the definition and extent of non-patent literature having last been revised in February 2010.

(b) Make recommendations and draft standards which are reasonable for national offices to adhere to in order to have their national collections included in the PCT Minimum Documentation, and allow International Authorities and database providers to easily load the necessary information in a timely and reliable fashion. The question of whether utility models should also form part of the minimum documentation shall also be examined.

(c) Propose clearly-defined components of patent data that should be present in all patent collections belonging to the minimum PCT documentation list (for example, bibliographic data, abstracts, full text, facsimile images, classification data), as well as the quality and dissemination criteria such data must adhere to, in order to improve searchability and facilitate data exchange between patent offices and commercial database providers.

(d) Define the criteria necessary for a patent collection to become part of the PCT Minimum Documentation and the extent to which Authorities should be expected to include and search documents where they are in different languages or have equivalent technical disclosures to other patent documents.

(e) Improve the availability of technical information from patent documents, in terms of the technical and linguistic coverage of the documents, and of the searchability of the information contained. This will further improve the quality of international searches, and ensure better access to patent information for third parties.

(f) Make recommendations and propose mechanisms for reviewing and maintaining the non-patent literature part of the PCT Minimum Documentation, by taking into consideration factors such as:

- (i) practicable access to periodicals, including their availability in electronic form;
- (ii) the range of fields of technology covered by periodicals;
- (iii) access conditions applicable to periodicals, including cost and text searchability.

(g) Recommend criteria for the inclusion of non-patent literature in the PCT minimum PCT documentation, and in particular, conditions under which traditional knowledge-based prior art should be included. Moreover, the Task Force should work with the Indian authorities after receiving their revised detailed proposals for inclusion of the TKDL database in the PCT Minimum Documentation.

AGREED METHODOLOGY AND WORK PLAN

6. The Task Force conducts its discussions using the wiki. As Task Force leader, the EPO prepares and submits discussion papers for consideration of the other Task Force members, and coordinates the discussions through a set of “discussion rounds”. The EPO also sets deadlines for comments, and shapes the activities so that concrete proposals from the Task Force could be presented to the future sessions of the MIA and of the PCT Working Group.

7. In December 2016, the EPO posted in the wiki a high-level position paper on the activities of the PCT Minimum Documentation Task Force foreseen in 2017-2018 (see Appendix to document PCT/MIA/24/4). In this position paper, due to the interrelated nature of the seven objectives listed above under paragraph 5, the EPO proposed, for the sake of efficiency, that some of these objectives be grouped in view of being tackled by the Task Force, as follows:

- Objective A: Create an up-to-date inventory of the patent literature and non-patent literature parts of the current PCT Minimum Documentation.
- Objective B: Recommend criteria and standards for including a national patent collection in the PCT Minimum Documentation.
- Objective C: Propose clearly-defined bibliographic and text components of patent data that should be present in patent collections belonging to the PCT Minimum Documentation.
- Objective D: Recommend criteria and standards for the review, addition and maintenance of non-patent literature and traditional knowledge-based prior art, and afterwards assess, on the basis of the criteria that will have been established, the revised proposal from the Indian authorities on TKDL.

8. In the above-mentioned position paper, the EPO proposed to lead the discussions on Objectives A, B and C and invited one of the Task Force members to lead the discussions on Objective D.

9. The work plan proposed by the EPO found the support of the Task Force members and of the MIA (document PCT/MIA/24/15). The United States Patent and Trademark Office (USPTO) offered to lead the fourth objective and this was very appreciated by the MIA (see paragraphs 71 and 72 of document PCT/MIA/24/15).

STATE OF PLAY

10. The discussions on Objective A began in April 2017. They focused on revising the lists of both the patent and non-patent literature publications belonging to the PCT Minimum Documentation. Both lists were extensively reviewed, modified and expanded to bring their contents up-to-date and in line with Rule 34.1.

11. Following active participation and contribution by Task Force members, in the last quarter of 2017, the up-to-date inventory of the current PCT Minimum Documentation was finalized by the EPO and accepted by the Task Force members as the baseline upon which further improvements can be made, thereby meeting Objective A. The said up-to-date inventory will soon be published on the WIPO website.

12. In 2018, the Task Force started working on Objectives B, C and D through a series of discussion rounds in the wiki. Much progress was made on Objectives B and C as far as the main principles are concerned.

13. With regard to Objective B, the discussions focused on addressing two main issues, namely:

(a) The first issue relates to the language-based criteria currently contained in Rule 34.1 which give rise to the following situation:

- the national patent collections of some ISAs do not belong to the PCT Minimum Documentation;
- the contents of the PCT Minimum Documentation vary depending on the ISA's official language(s) and the availability of English abstracts; and
- the patent literature part of the PCT Minimum Documentation is limited to patents documents published in a limited number of languages.

(b) The second issue relates to utility models. Currently, Rule 34.1 only explicitly mentions the utility models of France as being part of the PCT Minimum Documentation, thereby omitting several other significant utility model collections that are important sources of relevant prior art.

14. With regard to Objective C, the discussions focused on examining whether the Authority File Standard ST.37 could be used to facilitate describing the contents of patent and utility model collections belonging to the PCT Minimum Documentation.

15. With regard to Objective D, the discussions are led by the USPTO, which developed a questionnaire directed to the PCT International Authorities (ISA/IPEA) regarding their use of NPL and TK-based prior art sources and databases in their prior art searches. The questionnaire also addressed updates and additions of NPL and TK information and databases to the list of PCT Minimum Documentation, the requirements for such databases to be useable by the International Authorities, possible problems in utilizing those databases and questions regarding potential confidentiality and other requirements attached to the use of those databases. The International Bureau sent the questionnaire to the International Searching and Preliminary Examining Authorities on July 9, 2018, in Circular C. PCT 1544.

16. At the twenty-sixth session of the MIA (February 13 to 14, 2019), the EPO presented in the Task Force's status report (document PCT/MIA/26/8) with the conclusions which could be drawn from the first discussion rounds on Objectives B and C.

17. With regard to the first issue relating to the language-based criteria addressed under Objective B, it was reported by the EPO that it could be concluded from the first discussion round that within the framework of a future revision of Rule 34.1, at least the following four goals should be achieved (paragraph 16 of document PCT/MIA/26/8):

- ensuring that the PCT Minimum Documentation should contain the patent collections of all ISAs, irrespective of their official language(s), by making it a requirement to be fulfilled by ISAs (through an amendment of Rule 36);
- relaxing the language-based criteria in Rule 34.1 so as not to exclude any patent Office's collection based on language criteria alone (i.e. deleting the references to English, French, German and Spanish languages currently contained in Rule 34.1(c)(vi));

- ensuring that any patent collection belonging to the PCT Minimum Documentation (whether from an ISA or from another patent Office) is available free of charge and fulfills the technical and accessibility requirements to be defined within the framework of the upcoming discussions (including but not limited to what is addressed in Objective C); and
- including in the PCT Minimum Documentation first filings in any other country published after 1920, and for which corresponding English abstracts are generally available six months after publication and for which the original language full text is provided.

18. With regard to the second issue relating to utility models addressed under Objective B, it was reported by the EPO that it could be concluded from the first discussion round that within the framework of a future revision of Rule 34.1 the following goal should be achieved (paragraph 17 of document PCT/MIA/26/8):

- expanding the PCT Minimum Documentation to more utility model collections, i.e. including utility model collections in the PCT Minimum Documentation under the same conditions and requirements as those which will be applicable to patent collections (e.g. language-based criteria, technical requirements, obligation for ISAs to include their utility model collections, if applicable, in the PCT Minimum Documentation).

19. With regard to Objective C, it was reported by the EPO that it could be concluded from the first discussion round that there is general agreement on using the Authority File Standard ST.37 for the purposes of Objective C, but the details needed to be further discussed. In this regard, it was proposed that the technical criteria which will be defined within the framework of the up-coming discussions on Objective C would not be directly included in Rule 34.1 but rather in (an Annex to) the PCT Administrative Instructions to which Rule 34.1 should refer (paragraph 20 of document PCT/MIA/26/8).

20. With regard to Objective D, the USPTO presented some preliminary observations on the replies to the questionnaire contained in Circular C. PCT 1544 (see Annex IV to document PCT/MIA/26/8).

21. At that session of the MIA, Authorities welcomed the progress that had been made in all areas, discussed the Task Force's status report referred to above (document PCT/MIA/26/8) and made several comments on issues related to Objectives B, C and D (see paragraphs 74 to 83 of document PCT/MIA/26/13, reproduced in the Annex to document PCT/WG/12/2). The EPO drew the attention to the fact that the outstanding details in Objectives B and C were complex and finalizing them through the electronic forum could be slow and difficult and, therefore, suggested to convene a physical meeting of the Task Force where the experts could meet face to face (paragraph 75 of document PCT/MIA/26/13).

22. Following the above suggestion from the EPO, a physical meeting of the Task Force has been convened, in particular with a view to make faster progress towards finalizing the criteria and standards for inclusion of national patent collections in the PCT Minimum Documentation, and the bibliographic and text components of patent data in the PCT Minimum Documentation. This meeting will take place on May 21 and 22, 2019, at the EPO's headquarters in Munich. It is hoped that the discussions could lead to the Task Force submitting detailed proposals regarding Objectives B and C to the PCT/MIA in early 2020. This physical meeting will also allow further discussion on Objective D. The EPO will report orally at the present session about the progress made at that meeting.

23. *The Working Group is invited to take note of the contents of the present document.*

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