

Patent Cooperation Treaty (PCT) Working Group

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PCT MINIMUM DOCUMENTATION TASK FORCE: STATUS REPORT

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SUMMARY

1. With a view to undertaking a comprehensive review of the PCT Minimum Documentation, since 2017, the PCT Minimum Documentation Task Force (“the Task Force”) follows the work plan endorsed by the Meeting of International Authorities under the PCT (MIA) in early 2017. In that work plan, the Task Force’s work has been divided in four objectives referred to as Objectives A, B, C and D (Appendix to document PCT/MIA/24/4). The work on Objectives A, B and C is being led by the European Patent Office (EPO) and the work on Objective D is being led by the United States Patent and Trademark Office (USPTO). Objective A was already achieved in the last quarter of 2017. Since 2018, the Task Force is working on Objectives B, C and D. The discussions that took place so far revealed that Rules 34 and 36 would need to be amended.

2. In order to make faster progress, a physical meeting of the Task Force took place on May 21 and 22, 2019 at the EPO’s headquarters in Munich. That two-day meeting allowed the Task Force members to have constructive discussions on Objectives B, C and D and provided substantial input for making further progress. At the twenty-seventh session of the MIA (February 6 and 7, 2020), the EPO announced that it was considering organizing a second physical meeting of the Task Force in Munich on April 28 and 29, 2020. Due to the COVID-19 pandemic, the second session of the Task Force had to be postponed but the Task Force continued its work using the Task Force’s electronic forum. It is planned to hold the second session of the Task Force as a virtual meeting in the last quarter of this year.

BACKGROUND

3. In 2005, the MIA decided to set up a Task Force to undertake a comprehensive review of the PCT Minimum Documentation. The Task Force was mandated to address issues relating to both patent documentation and non-patent literature, including traditional knowledge-related databases (document PCT/MIA/11/14). However, due to various reasons the process stalled for several years. In January 2016, there was consensus at the MIA to reactivate the Task Force and the International Bureau invited one of the International Searching Authorities (ISAs) to take up the role of task force leader. In February 2016, the EPO responded positively to the call of the International Bureau and, thereafter, the Task Force was reactivated under the lead of the EPO.

4. Since 2017, the Task Force follows the work plan endorsed by the MIA early 2017 with a view to achieving the following four objectives (Appendix to document PCT/MIA/24/4):

- 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 the Indian Traditional Knowledge Digital Library database.

5. Usually, the Task Force conducts its work using an electronic forum made available by WIPO ("the wiki"). The discussions on Objectives A, B and C are being led by the EPO and the discussions on Objective D are being led by the USPTO.

STATE OF PLAY

6. The discussions on Objective A were successfully concluded in the last quarter of 2017, i.e. when the up-to-date inventory of the current PCT Minimum Documentation was adopted by the Task Force members. The said up-to-date inventory should be published soon by WIPO on its website. Since 2018, the Task Force is working on Objectives B, C and D through a series of discussion rounds in the wiki.

7. With regard to Objective B, the first discussion round focused on addressing two main issues, namely:

(a) The first issue relates to the language-based criteria currently contained in Rule 34.1 PCT 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 patent 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.

8. With regard to Objective C, the first discussion round 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.

9. With regard to Objective D, the first step was the preparation by the USPTO of a questionnaire directed to the PCT International Authorities regarding their use of non-patent literature and traditional knowledge-based prior art sources and databases in their prior art searches. The questionnaire also addressed updates and additions of non-patent literature and traditional knowledge 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 Authorities on July 9, 2018 in Circular C. PCT 1544.

10. At the twenty-sixth session of the MIA on February 13 and 14, 2019, the EPO presented in the Task Force's status report (document PCT/MIA/26/8) the conclusions that could be drawn from the first discussion rounds on Objectives B and C. The USPTO presented in an Annex to that report some preliminary observations on the replies to the questionnaire contained in Circular C. PCT 1544 (Annex IV to document PCT/MIA/26/8). Authorities welcomed the progress that had been made in all areas, discussed the Task Force's status report (document PCT/MIA/26/8) and made several comments on issues related to Objectives B, C and D (paragraphs 74 to 83 of document PCT/MIA/26/13). 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).

11. Following the above suggestion from the EPO, the first session of the Task Force took place on May 21 and 22, 2019 at the EPO's headquarters in Munich. At that session, the EPO presented proposals aiming at updating and streamlining the definition of the patent literature part of the PCT Minimum Documentation (documents PCT/MD/1/2 and PCT/MD/1/3). More specifically, document PCT/MD/1/2 contained proposals for amendments of Rules 34 and 36, and document PCT/MD/1/3 proposals for the technical and accessibility requirements for which the proposed revised Rules refer to the PCT Administrative Instructions. The USPTO reported on the replies to the questionnaire contained in Circular C. PCT 1544, summarized some of the recurring themes noted in the replies and proposed several questions for additional discussion (document PCT/MD/1/4). That two-day session allowed the Task Force members to have constructive discussions on Objectives B, C and D. All delegations agreed on the need of reviewing the PCT Minimum Documentation, and generally agreed with the objectives of the reform. However, the issues that have been addressed show that much had still to be done to come to an agreement on how that reform should be.

12. At the twelfth session of the PCT Working Group from June 11 to 14, 2019, the EPO presented a status report (document PCT/WG/12/16) and orally reported about the first session of the Task Force. The PCT Working Group noted the contents of document PCT/WG/12/16 and all delegations taking the floor underlined the importance of the work of the Task Force (paragraphs 144 and 145 of document PCT/WG/12/24).

13. The follow-up work to the first session of the Task Force started on the wiki in summer 2019. With regard to Objectives B and C, at the beginning of August, the EPO launched the second discussion round on Objectives B and C. More specifically, the EPO posted on the wiki a document aiming at following up on the conclusions reached at that session regarding the proposals for amendments to the PCT Regulations (document PCT/MD/1/2/REV). In that document, the EPO presented, in particular, revised proposals for amendments of Rules 34 and 36. Together with document PCT/MD/1/2/REV, the EPO posted on the wiki a template for the assessment by ISAs of the current status of their patent document collections and a summary presenting the EPO's collection status. The EPO invited the other Task Force members to post by September 27, 2019 their comments on document PCT/MD/1/2/REV as well as a summary presenting the status of their collections. The results of these assessments should help the EPO to prepare a revised version of document PCT/MD/1/3 dealing with the technical and accessibility requirements to be specified in an Annex to the PCT Administrative Instructions.

14. The EPO received comments on document PCT/MD/1/2/REV only from the Finnish Patent and Registration Office, the Japan Patent Office, the Canadian Intellectual Property Office, the Indian Patent Office, the Korean Intellectual Property Office and the USPTO as well as from the International Bureau. The EPO also received summaries of the status of the patent documents' collections from the Finnish Patent and Registration Office, the Japan Patent Office, the Indian Patent Office, the Korean Intellectual Property Office and the USPTO. Moreover, the International Bureau has made available on the WIPO website a list indicating the data coverage of patent collections on PATENTSCOPE and the extent of coverage of documents in full text electronic searchable format.

15. With regard to Objective D, the USPTO posted in June 2019 on the wiki a spreadsheet compiling all of the replies to the questionnaire contained in Circular C. PCT 1544. Moreover, at the end of July, the USPTO posted an additional questionnaire on non-patent literature which should help the development of criteria and standards for the review, addition, and maintenance of non-patent literature and traditional knowledge-based prior art in the PCT Minimum Documentation. The Task Force members were invited to reply to that questionnaire by the end of November 2019. Only five Offices (Brazilian National Institute of Industrial Property, Canadian Intellectual Property Office, EPO, Japan Patent Office and USPTO) had replied to that questionnaire by the end of December 2019 when the USPTO posted a spreadsheet compiling all the replies on the wiki. The Korean Intellectual Property Office replied in January 2020.

16. At the twenty-seventh session of the MIA (February 6 and 7, 2020), the EPO reported on the progress made so far on Objectives A to C (document PCT/MIA/27/11) and the USPTO on Objective D (document PCT/MIA/27/12). The EPO announced that it was considering organizing a second physical meeting of the Task Force in Munich on April 28 and 29, 2020 but that this still needed to be confirmed. It was indicated that "the Task Force would seek to develop proposals for presentation to the Meeting and to the PCT Working Group, with a view to recommending that the PCT Assembly approve amendments to the PCT Regulations in 2022, to enter into force before work commences on the next round of reappointment of International Authorities in 2026" (paragraph 70 of document PCT/MIA/27/16, reproduced in the Annex to document PCT/WG/13/2 REV.). Authorities thanked the European Patent Office and the Task Force for the work done, and discussed the status reports presented by the EPO and the USPTO (paragraphs 70 to 74 and 77 to 80 of document PCT/MIA/27/16). The Meeting noted the report on progress of the Task Force and recommended that the work continue as proposed, including the convening of a physical meeting of the Task Force (paragraphs 75 and 81 of document PCT/MIA/27/16).

17. Due to the COVID-19 pandemic, the second session of the Task Force had to be postponed. With a view to making progress despite these circumstances, the EPO and the USPTO prepared documents to be discussed in the wiki.

18. With regard to Objectives B and C, on July 16, 2020, the EPO posted on the wiki two documents, i.e. document PCT/MD/1/2/REV2 containing revised proposals for Rule amendments and document PCT/MD/1/3/REV containing revised proposals for the technical and accessibility requirements under Objectives B and C, and invited the other Task Force members to provide comments on these documents. The proposals presented in document PCT/MD/1/2/REV2 are summarized in Annex I to the present document and those presented in document PCT/MD/1/3/REV are summarized in Annex II to the present document.

19. With regard to Objective D, on April 3, 2020, the USPTO posted on the wiki a document entitled "*Criteria for the Evaluation of Non-Patent Literature (NPL) including Traditional Knowledge-based (TK) Prior Art for Inclusion in the NPL Patent Cooperation Treaty (PCT) Minimum Documentation List*". That document proposed a process and criteria by which NPL, including traditional knowledge-based prior art, could be considered for inclusion to the list, and how the list could be maintained over time. Moreover, that document contained a set of questions for discussion. The USPTO invited the other Task Force members to post their comments and replies on the wiki by June 30, 2020. On September 2, 2020, only four Offices (Canadian Intellectual Property Office, EPO, Japan Patent Office, Indian Patent Office) and the International Bureau had replied to the USPTO's document.

20. It became clear that, in view of the COVID-19 pandemic, it would not be possible to organise a face-to-face meeting of the Task Force even during the second half of this year. Therefore, the EPO proposed on the wiki to organize a virtual e-meeting of the Task Force in the last quarter of this year. This proposal found the support of various Task Force members and the details of the meeting (dates, meeting platform) are being discussed on the wiki.

21. *The Working Group is invited to take note of the contents of the present document and its Annexes.*

[Annexes follow]

SUMMARY OF THE PROPOSALS OF DOCUMENT PCT/MD/1/2/REV2

The revised proposals of amendment of Rules 34 and 36 presented in document PCT/MD/1/2/REV2 are set out below:

1. It is proposed to include in the PCT Minimum Documentation the patent collections of all International Searching Authorities (ISAs), irrespective of their official language(s), and to make it a requirement for ISAs to make their patent collections available for consultation under clearly defined technical and accessibility requirements which need to be agreed upon within the framework of the upcoming discussions and specified in an Annex to the PCT Administrative Instructions.
2. It is proposed to relax the language-based criteria currently contained in Rule 34.1 and to avoid the current language-based variability of the contents of the PCT Minimum Documentation deriving from paragraph (e) of that Rule. At the same time, it is proposed to include in the PCT Minimum Documentation the patent collection of any Office not appointed as ISA, provided that the said Office has made its patent collection available for consultation in accordance with the technical and accessibility requirements specified in an Annex to the PCT Administrative Instructions (same requirements as for ISAs), and has expressly notified the inclusion of its patent collection in the PCT Minimum Documentation to the International Bureau.
3. It is proposed to include in the PCT Minimum Documentation the entire collections of Offices, being ISAs or not, as of 1920. The implications of this proposal in terms of applicable technical and accessibility requirements, e.g. which requirements would be applicable to which parts of the collections, are dealt with in document PCT/MD/1/3/REV.
4. It is proposed to expand the PCT Minimum Documentation to more utility model collections. However, in view of the practical concerns expressed by several Authorities, it is proposed to include utility model documents in the PCT Minimum Documentation only as an optional recommended part.
5. It is proposed to clarify the applicability of the proposed technical and accessibility requirements to regional patent documents as well as to the regional utility model documents. It is thus proposed that any paragraph of Rule 34.1 referring to national patent documents should also refer to regional patent documents and that any paragraph of that Rule referring to national utility model documents should also refer to regional utility model documents.
6. With a view to improving the readability of Rule 34.1, it is proposed to mention the inventors' certificates as a distinct item instead of listing them under the patent documents. Moreover, it is proposed to mention only the inventors' certificates issued by the former Soviet Union and to delete the regional inventors' certificates because the ones issued by the former Soviet Union are the only existing ones.
7. Since at the first session of the PCT Minimum Documentation Task Force the International Bureau confirmed that it is willing to take up the new tasks proposed in document PCT/MD/1/3 concerning the repository page and the making available of Authority Files, it is proposed to amend Rule 34.1 by adding a new paragraph in that regard.
8. It is proposed to take the occasion of this revision of Rule 34.1 to suggest the deletion of the example indicated in brackets in current paragraph (d) of that Rule which is out of date. This proposal was unanimously supported by the Task Force at its first session. In addition, it is suggested to further amend that paragraph in order to specify that in all cases of republication of a patent document ISAs would only need to keep in their documentation the first publication of that patent document if none of the subsequently published versions contains more prior art information.

9. It is proposed not to re-open the discussions regarding the possibility to exclude patent family members. Indeed, this issue was already discussed at the first session of the Task Force and it was concluded that the existence of family members could not be a criterion for excluding some documents from the PCT Minimum Documentation on both substantive and practical grounds (paragraph 18 of document PCT/MD/1/5, reproduced in the Appendix to document PCT/MIA/27/11).

10. Regarding the entry into force of the proposed amendments of Rules 34 and 36, in light of the discussions of the first session of the Task Force, it is proposed to have a clear-cut date for revised Rules 34 and 36 to enter into force and to avoid having a transitional period of several years. As indicated at the MIA 2020, the aim would be that the PCT Assembly approves amendments to the PCT Regulations in 2022, to enter into force before work commences on the next round of reappointment of International Authorities in 2026.

[Annex II follows]

SUMMARY OF THE PROPOSALS OF DOCUMENT PCT/MD/1/3/REV

With a view to facilitating the understanding of the proposals set out below, the attention is first drawn to a few preliminary remarks:

- (a) All patent collections belonging to the PCT Minimum Documentation must be accessible free of charge to each International Authority. Therefore, a mechanism must be defined that allows the Patent Offices concerned to publish relevant details about their collections on the one hand, and for International Authorities to access and effectively search those collections on the other hand.
- (b) WIPO ST.37 Authority Files only inform the reader about the presence or absence of any publication number in a patent Authority's collection. Additionally, by using publication exception code "P", it is possible to indicate which publication numbers in the Authority File are not completely available in machine-readable form.
- (c) For a patent document to be electronically searchable, at least a machine-readable abstract of that document must be available. It is even more desirable to have machine-readable full text of the description and claims of the patent document. However, a native ST.37 Authority File can only inform us if a patent document is available in machine-readable form only; but it does not inform us whether it is the full text, the abstract or the facsimile images that are available; it could be any one of them or any combination of these three components.
- (d) In order to unambiguously specify if a publication number in an ST.37 file is electronically searchable or not, we must extend the WIPO ST.37 Authority File with new features that will allow users of the Authority file to identify which patents have machine-readable versions or not, and whether machine-readable publication numbers have full text and/or abstracts available.

The main proposals presented in document PCT/MD/1/3/REV are the following ones:

1. From a formal point of view, it is proposed that any technical and accessibility requirements for patent and utility model data, including bibliographic and text components of that data, would not be directly included in Rule 34.1 but in (an Annex to) the PCT Administrative Instructions to which Rule 34.1 should refer to.
2. It is proposed that each IP Office whose patent collection belongs to the PCT Minimum Documentation shall provide the International Bureau with an Authority File of their patent documents at least annually, that must conform fully with, but not be limited to, the WIPO Standard ST.37.

MANDATORY BIBLIOGRAPHIC DATA ELEMENTS OF AUTHORITY FILES

3. It is proposed that the Authority Files provided by each IP Office whose patent collection belongs to the PCT Minimum Documentation must in principle contain the following mandatory bibliographic data elements:

- (a) the two-letter alphabetic code of the Patent Office publishing the document (publication authority);
- (b) the publication number or for those Authorities that publish Application numbers only, the Application Number;
- (c) kind code of the patent document (kind-of-document code);
- (d) publication date.

EXTENSIONS TO AUTHORITY FILES OF IP OFFICES WHOSE PATENT COLLECTIONS BELONG TO THE PCT MINIMUM DOCUMENTATION

4. It is proposed that IP Offices whose patent collections belong to the PCT Minimum Documentation shall append extra columns in their ST.37-conforming Authority Files to indicate the presence or absence of the following mandatory elements for each publication number therein:

- Full text, i.e. the description and claims in searchable text format
- Original abstract available in searchable text format
- English language abstract available in searchable text format.

MANDATORY ELEMENTS FOR EACH DOCUMENT IN A COLLECTION

5. It is proposed that each Patent Office shall provide the following mandatory elements for each document in their collection:

- (a) the complete full text (in either ST.36 or ST.96 formats), including any electronically available sequence listings (in either ST.25 format or ST.26 format);
- (b) facsimile images of all the pages of each document; and
- (c) the relevant publication exception code for all documents in the collection for which the complete publication in machine-readable form is not available.

OPTIONAL ELEMENTS FOR EACH DOCUMENT IN A COLLECTION

6. It is proposed that each Patent Office may provide, at its own discretion, the following optional elements for each document in their collection, insofar as they are available in machine-readable format:

- (a) the abstract of the document in the original language of publication;
- (b) the application number of the document;
- (c) the priority number of the document;
- (d) the IPC (International Patent Classification) symbols assigned to the document;
- (e) any classification symbols assigned to the document according to any other classification scheme, e.g. CPC classification symbols or FI/F-term symbols; and
- (f) the abstract of the document in the English language, if available.

PUBLICATION EXCEPTION CODES

7. It is recalled that, according to paragraph 22 of WIPO Standard ST.37, the publication exception code should be used for publication numbers for which the complete publication is not available in machine-readable form. It is proposed that the use of Publication Exception Codes in Authority Files be carefully regulated in order to ensure transparency and to avoid that publication exception codes not be used in an abusive way by an Office who would not be willing to make its national patent collection available for consultation as part of the PCT Minimum Documentation.

INFORMATION PROVIDED TO THE INTERNATIONAL BUREAU

8. It is proposed that IP Offices whose patent collections belong to the PCT Minimum Documentation shall also provide the International Bureau with an accompanying Definition File (see WIPO Standard ST.37 paragraphs 33 and 34 and Annex I) containing the relevant Publication Exception Codes that are present in that IP Office's Authority File (see WIPO Standard ST.37 paragraphs 22 to 25). The said Definition Files shall also include an overview of the scope of their document collections (kinds of documents and years of publications – see WIPO Standard ST.37 paragraph 34).

9. It is proposed that the Authority Files, as well as the Definition Files containing declarations about their scope and updates, shall be made available to International Authorities via a repository administered by the International Bureau.

10. It is proposed that each Patent Office shall provide the International Bureau with information disclosing how often they will update their Authority Files (see WIPO Standard ST.37 paragraphs 40 and 41). Furthermore, it is proposed that the Authority Files must be updated at least once per year.

11. It is proposed that each IP Office whose patent documents belong to the PCT Minimum Documentation shall also provide the International Bureau with hyperlinks to website(s) where the raw patent data of that IP Office is available to International Authorities for free. Any International Authority could then make use of those hyperlinks to access the raw patent data of each IP Office whose patent collections belong to the PCT Minimum Documentation.

AVAILABILITY IN MACHINE-READABLE SEARCHABLE FORM

12. It is proposed that for a period of 10 years as of entry into force of revised Rules 34 and 36, only those documents published as of the date of entry into force of the revised Rules must mandatorily be available in machine-readable searchable form. Availability in machine-readable searchable form is recommended for documents published prior to that date.

13. It is proposed that following that 10-year period, availability in machine-readable form should be mandatory for documents published as from 1976 onwards, or as from another yet-to-be-determined date, and recommended for documents published prior to that date.

14. If the Task Force cannot agree to use 1976 as a suitable starting date, in the absence of consensus on another date suggested by any other Task Force member, it is proposed that the to-be-determined date mentioned in the above paragraph be arrived at following an analysis of the publication years of citations in recent international search reports.

[End of Annex II and of document]