

## **Patent Cooperation Treaty (PCT) Working Group**

**Fifteenth Session**  
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### **PCT MINIMUM DOCUMENTATION: PROPOSED AMENDMENTS TO THE PCT REGULATIONS**

*Document submitted by the European Patent Office and the United States of America*

#### **SUMMARY**

1. As reported in document PCT/WG/15/12, the PCT Minimum Documentation Task Force (“the Task Force”) made much progress in its review of the PCT minimum documentation. Following the twenty-ninth session of the Meeting of International Authorities under the PCT (MIA) (June 20 to 22, 2022), the Task Force has finalized the proposed amendments to the PCT Regulations and Administrative Instructions discussed during that session of the MIA. The finalized proposals are contained in the Annexes to this document and presented below. The document invites the Working Group to consider the proposals with a view to the submission of the proposed Rule amendments to the PCT Assembly in 2023. If the Working Group agrees to submit the proposed Rule amendments to the PCT Assembly, their intended entry into force would be on January 1, 2026, in order to ensure that they could be taken into account during the next round of reappointment of International Authorities (the current ISA/IPEA Agreements terminate on December 31, 2027).

#### **PROPOSED AMENDMENTS TO THE PCT REGULATIONS**

2. Annex I to this document sets out proposed amendments to Rules 34, 36 and 63. The amendments proposed to Rules 34 and 36 are identical to the ones submitted to the MIA at its last session (see document PCT/MIA/29/5); the amendments proposed to Rule 63 aim at aligning the requirements set out in that Rule with the ones proposed for Rule 36. The proposed Rule amendments are presented here below:

- (a) It is proposed to include in the PCT minimum documentation the patent collections of all International Searching Authorities, irrespective of their official language(s), and to make it a requirement for International Searching Authorities to make their patent collections available for consultation under clearly-defined technical and accessibility requirements specified in the PCT Administrative Instructions. Therefore, it is suggested to amend Rule 36.1 by adding a new paragraph (ii) and to insert a reference to new Rule 36.1(ii) in proposed Rule 34.1(b)(i).
- (b) It is proposed to avoid any language-based criteria in Rule 34. At the same time, it is proposed to include in the PCT minimum documentation the patent collection of any Office not appointed as International Searching Authority, provided that the said Office has made its patent collection available for consultation in accordance with the technical and accessibility requirements specified in the PCT Administrative Instructions (same requirements as for International Searching Authorities). Moreover, it is suggested to specify that any Office making its document collection available in accordance with the requirements specified in the Administrative Instructions shall notify the International Bureau accordingly. This proposal is reflected by proposed paragraphs (b)(i) and (d)(i) of Rule 34.1.
- (c) It is proposed to clarify that the technical and accessibility requirements would apply to all "patent documents" as defined in paragraph (a) of proposed Rule 34.1. This proposal is reflected by proposed paragraphs (a) and (b)(i) of Rule 34.1. Proposed Rule 34.1(a) provides a definition of "patent documents" for the purposes of this Rule and Rule 34.1(b)(i) requires compliance with technical and accessibility requirements for "patent documents" as defined in paragraph (a).
- (d) In view of the importance of utility model documents and the practical concerns expressed by several Authorities at various occasions, it is proposed to include utility model documents in the PCT minimum documentation only as an optional recommended part. The utility model documents of any Office could be included in the PCT minimum documentation, provided that they have been made available in accordance with the technical and accessibility requirements specified in the Administrative Instructions (same requirements as for patents). This proposal is reflected by proposed paragraph (c) of Rule 34.1.
- (e) It is proposed to amend Rule 34.1 by adding two new paragraphs (d) and (e). Proposed new paragraph (d) is dedicated to the tasks to be performed by Offices with regard to the making available of their collections in compliance with the requirements specified in the Administrative Instructions, and proposed new paragraph (e) is dedicated to the tasks to be performed in that regard by the International Bureau (validation of the availability of the patent and utility model documents, publication in the Gazette of details of the documents concerned and of their date of inclusion in the PCT minimum documentation, administration of a repository containing the authority files). These two paragraphs would apply to the documents of both International Searching Authorities and other Offices.
- (f) It is proposed to delete the example indicated in brackets in current paragraph (d) (renumbered as (f)) of that Rule which is out of date. This proposal was already unanimously supported by the Task Force at its first session. In addition, it is suggested to further amend that paragraph renumbered as (f) in order to specify that in all cases of republication of an application, International Searching Authorities would only need to keep in their documentation the first published version if none of the subsequently published versions contains additional matter. In reply to a comment received at the last session of the MIA (see paragraph 48 of document PCT/MIA/29/10), it is clarified that, since amendments shall not go beyond the disclosure in the application as filed, normally

none of the subsequently published versions should contain additional matter which extends beyond the content of the application as filed. Should some national provisions allow that in certain cases a subsequently published version contains additional matter, the respective Office should make available for consultation as part of the PCT minimum documentation only the subsequently published version containing additional matter. In this way, International Searching Authorities would have no doubts regarding the version that they would need to keep in their documentation.

(g) It is proposed that the meaning of “published” be clarified for the purposes of the contents of the PCT minimum documentation not only for applications but also for patents. Therefore, it is proposed to insert in current paragraph (f) (renumbered as (g)) of Rule 34.1 the term “patents” after “applications”.

(h) As far as Rule 36 is concerned, in addition to the insertion of a new paragraph (ii) suggested above under point (a), it is proposed to remove from that Rule the requirement for staff to have the required language facilities and to move to paragraph (i) the requirement for staff to be capable of searching the required technical fields. Moreover, it is proposed to revise the wording of paragraph (iii) in order to use a more up-to-date wording referring to the Administrative Instructions.

(i) It is proposed to align the requirements set out in Rule 63 with the ones proposed for Rule 36. Therefore, it is suggested to insert in Rule 63.1 the same new paragraph (ii) than in Rule 36.1, to remove also from Rule 63 the requirement for staff to have the required language facilities, and to move to paragraph (i) of that Rule the requirement for staff to be capable of examining the required technical fields.

### **PROPOSED DRAFT UNDERSTANDING REGARDING THE INTERPRETATION OF RULE 36**

3. As also indicated in document PCT/WG/15/12, it is suggested that the PCT Assembly adopts an Understanding on how the requirements in the proposed amendments to Rule 36 should apply to making patent collections available in the case where an intergovernmental organization has been established for the collaboration between national Offices of the States that are members of that organization and wishes to be appointed as an International Searching Authority, and that organization does not itself grant patents or publish patent applications. In such a case, the national Offices of the member States of that organization shall make available for consultation as part of the minimum documentation, any patent issued and any patent application published by them, and where applicable, by their legal predecessor(s). A draft Understanding reflecting this proposal is contained in Annex II to this document. Such an Understanding could be adopted by the PCT Assembly at the same time as the amendments to Rule 36.

### **PROPOSED MODIFICATIONS TO THE PCT ADMINISTRATIVE INSTRUCTIONS**

4. Annex III to this document sets out the technical and accessibility requirements and procedure for inclusion of patent and utility model documents, and non-patent literature in the PCT minimum documentation. All technical requirements and details would be contained in a new Annex H to the Administrative Instructions, with two new sections referring to Annex H. A few minor changes were introduced in proposed new Annex H to address comments received at the last session of the MIA.

### **PART I OF PROPOSED NEW ANNEX H: PATENT AND UTILITY MODEL DOCUMENTATION**

5. The provisions of Part I of Annex H aim at ensuring that all patent and utility model collections belonging to the PCT minimum documentation are accessible free of charge to each International Authority. Therefore, these new provisions set up a mechanism to allow the Offices concerned to publish relevant details about their collections on the one hand, and International Authorities to access and effectively search those collections on the other hand.

6. In order to ensure accessibility of the patent and utility model collections belonging to the PCT minimum documentation without placing a prohibitive burden on International Authorities to digitize their back files, the new provisions propose that:

(a) An Office, whose collection belongs to the PCT minimum documentation, shall make available in text-searchable machine-readable form any document published on or after the date of entry into force of the Administrative Instructions in its patent or utility model collection, under the conditions and formats specified in paragraphs 3 and 14 of proposed new Annex H (see paragraphs 3, 11 and 14 of proposed new Annex H). The Task Force recognizes the fact that most International Authorities today have access to patent data belonging to the current PCT minimum documentation via bilateral and/or multilateral agreements. For these Authorities, it is expected that they will continue accessing such patent data in the future in the same way as they do currently. Paragraph 3 of proposed new Annex H specifies a fallback mechanism for International Authorities to access patent data belonging to the PCT minimum documentation in the future in those rare situations where their access to a patent collection is not covered by an existing bilateral or multilateral data access agreement.

(b) After a transition period of 10 years, i.e. as of the date of entry into force of the Administrative Instructions plus 10 years, any such Office shall make available in text-searchable machine-readable form any document published on or after January 1, 1991 in its patent or utility model collection or that of a legal predecessor (see paragraphs 3, 12 and 14 of proposed new Annex H).

(c) Where it is not mandatory to make a document available in text-searchable machine-readable form, an Office is recommended to make the document available in text-searchable machine-readable form. Any document that is not made available in text-searchable machine-readable form shall preferably be made available in electronic form in accordance with the conditions specified in paragraph 15 of proposed new Annex H (see paragraphs 13 and 15 of proposed new Annex H).

7. It is proposed that Offices whose patent documents belong to the PCT minimum documentation use WIPO Standard ST.37 to publish information about the patent documents that belong to their collection.

8. Paragraphs 5 to 8 of proposed new Annex H specify the mandatory data elements that shall be contained in the WIPO ST.37 Authority Files. As far as the availability in text-searchable format of the abstract, description, claims of a publication is concerned (data elements referred to in paragraph 5(e) of Annex H), during a transition period of 10 years, Offices would be required to provide the indications regarding that availability only for each publication on or after the date of entry into force of the Administrative Instructions. After that transition period, these requirements would be extended to documents published on or after January 1, 1991.

9. Paragraph 16 of proposed new Annex H specifies the optional data elements that shall be contained in the WIPO ST.37 Authority Files.

10. Paragraph 9 of proposed new Annex H proposes that an Office shall preferably provide a definition file in accordance with WIPO Standard ST.37 containing relevant publication exception codes that are present in its authority file and an overview of the scope of the document collections. The use of publication exception codes would be optional and regulated by paragraphs 17 and 18 of proposed new Annex H.

11. Paragraph 10 of proposed new Annex H proposes that the International Bureau shall add any authority and definition files provided by an Office to the repository referred to in proposed Rule 34.1(e) and shall make the repository available on the WIPO website. For each Office, the repository shall provide information on the date coverage of the authority file and information on dates and/or frequency of updates if provided to the International Bureau.

#### PART II OF PROPOSED NEW ANNEX H: NON-PATENT LITERATURE

12. Part II of proposed new Annex H sets out the process for International Searching Authorities to review the list of items of non-patent literature referred to in current Rule 34.1(b)(iii) ("the list") with a view to verifying that items continue to meet the criteria for inclusion and to consider resources for addition to the list. It is noted that non-patent literature includes traditional knowledge resources.

13. Paragraphs 22 to 26 of Annex H propose a set of objective criteria for inclusion of non-patent literature in the PCT minimum documentation. The proposed criteria are summarized as follows:

- (a) An item must be represented by an individual title.
- (b) An item must be available electronically:
  - (i) to International Searching Authorities in at least one digital format that is readily available and acceptable to all Authorities, and
  - (ii) to the public, online, for a reasonable commercial fee, as part of a personal or institutional subscription, or at no cost.
- (c) An item must be full text and accessible through an institutionally available search interface. Preferably, an item should also be available in a text-coded format that would allow it to be incorporated into a search interface.
- (d) Subscription-based resources must be institutionally accessible.
- (e) An item must provide terms of use that allow for copies of cited documents to be distributed to applicants as part of the international search and preliminary examination procedure, and to designated or elected Offices upon request under Article 20(3) and Rule 44.3.

14. In order to ensure that the list of non-patent literature items in the PCT minimum documentation remains up-to-date, the new provisions propose two distinct but complementary reviews of the non-patent literature list, namely:

- (a) a comprehensive review of the list of items and any recommended resources which would take place every five years, and
- (b) an annual review of the list to find obsolete and discontinued resources and to update any metadata from the list.

15. Paragraphs 27 to 35 of proposed new Annex H detail the organization and steps of the comprehensive review. The comprehensive review should be entrusted to a standing Task Force on PCT minimum documentation comprising representatives of International Searching Authorities. The Task Force would report on a regular basis to International Searching Authorities, usually at the Meeting of International Authorities (MIA). A meeting of that Task Force should be convened every five years by an International Searching Authority (agreed upon by other International Searching Authorities). Following that meeting, the Task Force would submit a revised list to International Searching Authorities to agree upon under

Rule 34.1(b)(ii) as the updated list. This process would be expected to take place at the MIA, where all International Searching Authorities would be involved. However, as the MIA is not defined as a decision-making body in the PCT, Annex H refers to International Searching Authorities agreeing on changes to the list, in line with Rule 34.1(b)(ii).

16. In addition, it is proposed that an International Searching Authority may share resources through the electronic forum of the Task Force that are not on the list but are considered useful for examiners to consult during international search (see paragraph 34 of proposed new Annex H).

17. Moreover, it is suggested that the International Bureau shall provide a mechanism for the public to suggest resources to consult during international search that are not on the list. The International Bureau would post any such suggestion on the electronic forum of the Task Force and ask the volunteer International Searching Authority referred to below to assess it (see paragraph 35 of proposed new Annex H).

18. Paragraphs 37 and 38 of proposed new Annex H set out the annual review of the list. In that regard, it is proposed that the Task Force shall establish a schedule of volunteer International Searching Authorities to conduct an annual review of the list on a rotational basis. The volunteer International Searching Authority conducting the annual review shall share findings and provide justifications from this review with the Task Force through its electronic forum and provide the International Bureau with any updates that are required to the list.

19. It is added that International Searching Authorities would be required, at a minimum, to maintain full text access to the most recent five years of content calculated from the current date. Upon adoption of the Non-Patent Literature Minimum Documentation List, International Searching Authorities would have two years to reach compliance and obtain access to the required resources.

## **NEXT STEPS**

20. These proposed amendments to the PCT Regulations and modifications to the Administrative Instructions are presented in this document and its Annexes with a view to submitting the proposed Rule amendments to the PCT Assembly in 2023. If the Working Group agrees to submit the Rule amendments to the PCT Assembly, their intended entry into force would be January 1, 2026, in order to ensure that they would be taken into account during the next round of reappointment of International Authorities.

*21. The Working Group is invited to comment on the proposed amendments to the PCT Regulations in Annex I to this document, on the draft Understanding in Annex II to this document, and on the proposed modifications to the Administrative Instructions in Annex III to this document.*

[Annexes follow]

DRAFT PROVISIONAL AMENDMENTS  
TO THE PCT REGULATIONS<sup>1</sup>

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<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

## Rule 34 Minimum Documentation

### 34.1 *Definition*

(a) The definitions contained in Article 2(i) and (ii) shall not apply for the purposes of this Rule. For the purposes of this Rule, "patent documents" shall include:

(i) published international applications,

(ii) published regional patents,

(iii) national patents issued by a national Office or its legal predecessor in and after 1920,

(iv) utility certificates issued by France in and after 1920,

(v) inventors' certificates issued by the former Soviet Union, and

(vi) applications for any of the forms of title referred to in items (ii) to (v) above, published in and after 1920.

(b) Notwithstanding paragraph (c), ~~the~~ the documentation referred to in Article 15(4) ("minimum documentation") shall consist of:

(i) the "~~national~~ patent documents" as specified in paragraph ~~(e)(a)~~, that have been made available by or on behalf of the relevant national Office or its legal successor or, as the case may be, by the International Bureau in accordance with the technical and accessibility requirements specified in the Administrative Instructions and, where applicable, with the provisions of Rule 36.1(ii), and

~~(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.

(c) In addition to consulting the required documentation set forth in paragraph (b), the International Searching Authority should also preferably consult utility model documents consisting of the utility models issued, and the utility model applications published, in and after 1920 by a national Office or its legal predecessor, provided that the said utility model



documents have been made available by or on behalf of the relevant national Office or its legal successor in accordance with the technical and accessibility requirements specified in the Administrative Instructions.

~~(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 People's Republic of China, 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.~~

(d) Each national Office making its patent documents and, where applicable, its utility model documents available in accordance with the requirements specified in the Administrative Instructions shall:

(i) notify the International Bureau accordingly,

(ii) make newly published patent documents and, where applicable, utility model documents available regularly, and

(iii) provide to the International Bureau at least annually an authority file, detailing the current extent of the available patent documents and, where applicable, utility model documents in accordance with the Administrative Instructions.

(e) The International Bureau shall validate the availability of the patent and utility model documents notified in accordance with paragraph (d) and publish in the Gazette details of the documents concerned and the date from which they will become a part of the minimum documentation. The International Bureau shall administer a repository containing the authority files referred to in paragraph (d)(iii) as specified in the Administrative Instructions.

~~(d)(f) Where an application is republished once (for example, an Offenlegungsschrift as an Auslegeschrift) or more than once, no each International Searching Authority shall be obliged to keep all versions in its documentation only the first published version if none of the subsequently published versions contains additional matter; 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) Any International Searching Authority whose official language, or one of whose official languages, is not Chinese, Japanese, Korean, Russian or Spanish is entitled not to include in its documentation those patent documents of the People's Republic of China, 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.~~

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

## Rule 36

### Minimum Requirements for International Searching Authorities

#### 36.1 *Definition of Minimum Requirements*

The minimum requirements referred to in Article 16(3)(c) shall be the following:

(i) the national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out searches in the required technical fields;

(ii) that Office or organization must make available for consultation as part of the minimum documentation referred to in Rule 34, in accordance with the requirements specified in the Administrative Instructions, any patent issued, and any patent application published, by it, and where applicable by its legal predecessor(s);

~~(ii)(iii)~~ that Office or organization must have in its possession, or have-maintain access to, at least the minimum documentation referred to in Rule 34, for search purposes in accordance with the Administrative Instructions ~~properly arranged for search purposes, on paper, in microform or stored on electronic media;~~

~~(iii) that Office or organization must 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;~~

(iv) that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international search;

(v) that Office or organization must hold an appointment as an International Preliminary Examining Authority.

## Rule 63

### Minimum Requirements for International Preliminary Examining Authorities

#### 63.1 *Definition of Minimum Requirements*

The minimum requirements referred to in Article 32(3) shall be the following:

(i) the national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out examinations in the required technical fields;

(ii) that Office or organization must make available for consultation as part of the minimum documentation referred to in Rule 34, in accordance with the requirements specified in the Administrative Instructions, any patent issued, and any patent application published, by it, and where applicable by its legal predecessor(s);

~~(ii)~~(iii) that Office or organization must have at its ready disposal at least the minimum documentation referred to in Rule 34, properly arranged for examination purposes;

~~(iii) that Office or organization must have a staff which is capable of examining in 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;~~

(iv) that Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international preliminary examination;

(v) that Office or organization must hold an appointment as an International Searching Authority.

[Annex II follows]

DRAFT UNDERSTANDING WITH REGARD TO  
THE INTERPRETATION OF RULE 36.1(ii)

“In adopting the amendments to Rule 36.1 setting out the minimum requirements referred to in Article 16(3)(c), the Assembly agreed that, in the case of an intergovernmental organization that has been established for the collaboration between national Offices of the States that are members of that intergovernmental organization and does not itself issue patents or publish patent applications, the requirements in Rule 36.1(ii) for the organization are that the national Offices of those States make available for consultation as part of the minimum documentation any patent issued, and any patent application published, by them, and where applicable by their legal predecessor(s).”

[Annex III follows]

PROPOSED NEW PROVISIONS OF THE PCT ADMINISTRATIVE INSTRUCTIONS

**PART 1**

**INSTRUCTIONS RELATING TO GENERAL MATTERS**

**Section 116**

**Minimum Documentation**

Patent documents made available under Rule 34.1(b)(i) for inclusion in the documentation referred to in Article 15(4) and utility model documents made available under Rule 34.1(c) shall comply with Part I of Annex H.

**PART 5**

**INSTRUCTIONS RELATING TO THE INTERNATIONAL SEARCHING AUTHORITY**

**Section 521**

**Minimum Documentation**

International Searching Authorities shall agree on the items of non-patent literature under Rule 34.1(b)(ii) for inclusion in the documentation referred to in Article 15(4) following the procedure in Part II of Annex H.

## ANNEX H

### TECHNICAL AND ACCESSIBILITY REQUIREMENTS AND PROCEDURE FOR INCLUSION OF PATENT AND UTILITY MODEL DOCUMENTS AND NON-PATENT LITERATURE IN THE MINIMUM DOCUMENTATION

#### INTRODUCTION

1. This Annex sets out the technical and accessibility requirements and procedure for inclusion of patent and utility model documents and non-patent literature in the minimum documentation, as defined in Rule 34.1.

#### PART I

##### PATENT AND UTILITY MODEL DOCUMENTATION

2. In this part, “patent documents” and “utility model documents” are as defined in Rule 34.1(a) and Rule 34.1(c), respectively.

##### **Making Available of Documents**

3. Each Office or successor Office whose patent collection, and, where applicable, utility model collection, belongs to the minimum documentation shall set up one or more secure repositories in which its text-searchable minimum documentation data is stored in either WIPO Standard ST.36 or ST.96 format, or in plain text format, or any combination thereof. Each said Office shall provide the International Bureau with all the relevant information and authorization details necessary to access this data, for example the links, passwords, etc., so that the International Bureau and International Authorities can access the data for free in bulk format electronically, preferably via FTP, SFTP or Web Services, and in accordance with paragraph 20. The International Bureau shall provide the said information and authorization details to any International Authority on request. Each Office shall ensure that all published data is made available in a repository no later than one month after its publication date. If an Office also provides a search interface to its data, it shall preferably also provide access to such a search interface for free. Any Office that is not an International Authority, but whose patent collection, and, where applicable, utility model collection, belongs to the minimum documentation, can delegate to an International Authority or the International Bureau the task of granting access to its data in accordance with the provisions set out in this paragraph.

##### **Authority File**

4. The structure and file format of the authority file provided by an Office under Rule 34.1(d)(iii) and the data elements contained in that authority file shall comply with WIPO Standard ST.37.

5. For each publication, the authority file provided by an Office shall contain the following data elements referred to in WIPO Standard ST.37:

- (a) two-letter alphabetic code of the Office publishing the document (publication authority);
- (b) publication number;
- (c) kind code of the patent document (kind-of-document code);
- (d) publication date of the patent document; and

(e) subject to paragraph 7, indication of whether the abstract, description, claims of a publication are text-searchable, through selection of one of the following codes:

(i) "N" – Not available

(ii) "U" – Unknown

(iii) two-letter language code(s) in which the searchable text is available, either in the original language or in the language of an official translation.

6. The Office shall provide the data elements referred to in paragraph 5(a) to 5(d) as of [DATE OF ENTRY INTO FORCE OF AI] for each publication made by that Office or by its legal predecessor published on or after January 1, 1991.

7. With regard to the data elements referred to in paragraph 5(e), the Office shall provide indications:

(a) from [DATE OF ENTRY INTO FORCE OF AI], at least for each publication on or after that date; and

(b) from [DATE OF ENTRY INTO FORCE OF AI + 10 YEARS], at least for each publication or that of its legal predecessor on or after January 1, 1991.

8. Offices having documents available in text-searchable machine-readable form published between January 1, 1920 and December 31, 1990 shall preferably include, for these documents, the data elements referred to in paragraph 5(a) to 5(e).

9. An Office shall preferably provide a definition file in accordance with WIPO Standard ST.37 containing relevant publication exception codes that are present in its authority file and an overview of the scope of the document collections.

10. The International Bureau shall add any authority and definition files provided by an Office to the repository referred to in Rule 34.1(e) and shall make the repository available on the WIPO website. For each Office, the repository shall provide information on the date coverage of the authority file and information on dates and/or frequency of updates if provided to the International Bureau.

### **Making Available Documents Belonging to the Minimum Documentation**

11. An Office shall make available in text-searchable machine-readable form in accordance with paragraph 14 any document published on or after [DATE OF ENTRY INTO FORCE OF AI] in its patent or utility model collection.

12. As of [DATE OF ENTRY INTO FORCE OF AI + 10 YEARS], an Office shall make available in text-searchable machine-readable form in accordance with paragraph 14 any document published on or after January 1, 1991 in its patent or utility model collection or that of a legal predecessor.

13. Where it is not mandatory to make a document available in text-searchable machine-readable form, an Office is recommended to make the document available in text-searchable machine-readable form in accordance with paragraph 14. Any document that is not made available in text-searchable machine-readable form shall preferably be made available in electronic form in accordance with paragraph 15.



### **Documents Made Available in Text-Searchable Machine-Readable Form**

14. For each document that is made available in text-searchable machine-readable form, an Office shall provide International Searching Authorities with access to at least the full text of the abstract, description and claims in either XML format in compliance with WIPO Standard ST.36 or ST.96, or in plain text format. An Office shall also provide access to any electronically available sequence listings in a document. For any documents in XML format, the bibliographic data tags should be filled. The same conditions as already described in paragraph 3 also apply here.

### **Documents Not Made Available in Text-Searchable Machine-Readable Form**

15. For each patent document or utility model document that is part of the minimum documentation but not made available in text-searchable machine-readable form, the Office or its legal successor shall provide International Searching Authorities, upon request, with access to a copy, preferably in electronic form. The copies of such documents shall preferably be in machine-readable electronic image format, e.g. PDF. For such documents, the code in the authority file for the data elements referred to in paragraph 5(e) should be “N” for elements that are not available in a text-searchable format, or “U” for documents whose availability is unknown, or if the Office cannot easily provide an indication of such availability.

### **Optional Elements for each Document in a Collection**

16. Each Office shall preferably provide, insofar as they are available in machine-readable format, the following data elements for each document in its collection, using the appropriate tags foreseen for them:

- (a) the application number of the document;
- (b) the application numbers and filing dates of any earlier applications from which the patent or application claims priority;
- (c) the IPC (International Patent Classification) symbols assigned to the document;
- (d) any classification symbols assigned to the document according to any other classification scheme, e.g. CPC classification symbols or FI/F-term symbols.

### **Use of Publication Exception Codes**

17. The authority file may optionally include the relevant publication exception code for any document in the collection of an Office for which the complete publication in machine-readable form is not available. If an authority file does not use publication exception codes, then for those documents that are not available in machine-readable format, the following applies:

- for documents that are not available in a text searchable format, the code in the authority file for the data elements referred to in paragraph 5(e) should be “N”.
- for documents whose availability is unknown, or if the Office cannot easily provide an indication of such availability, the code in the authority file for the data elements referred to in paragraph 5(e) should be “U”.

18. Any publication exception codes included in the authority file shall be limited in the following ways:

- the code “P” shall not be used for patent documents published after [DATE OF ENTRY INTO FORCE OF AI];

- the code “X” shall not be used for patent documents published after [DATE OF ENTRY INTO FORCE OF AI] to indicate that a document is not available in machine-readable form; and
- as long as their use does not contravene the two immediately preceding bullet points above, an Office using specific customized codes before [DATE OF ENTRY INTO FORCE OF AI] may only continue to use those codes if it properly identifies the place where the definition of those codes is made freely available.

### **Notification to the International Bureau and Validation of Collections**

19. The notification to the International Bureau under Rule 34.1(d)(i) shall specify the date as of which the patent documents and, where applicable, the utility model documents are available in accordance with the requirements set out in this Annex. Each Office shall provide access to its documents made available in text-searchable machine-readable form as described in paragraph 3, as well as provide a link to its authority file and any definition file.

### **Use of data**

20. Any patent and utility model data made available by Offices to International Authorities within the context of, and in accordance with the requirements set out in, this Annex may only be used by International Authorities for the purpose of conducting prior art search and related activities, including providing copies of cited documents to applicants and third parties. In case the said data is used for other purposes without the express consent of the providing Office, the access to the data in bulk format may be blocked by the International Bureau. This paragraph neither prevents Offices from having bilateral or multilateral agreements with the Offices providing the patent data to use and transform this data for other purposes, nor intends to replace any such existing bilateral or multilateral agreements.

## **PART II NON-PATENT LITERATURE**

### **Evaluation of Non-Patent Literature for Inclusion in the Minimum Documentation**

21. Part II sets out the process for International Searching Authorities to review the list of items of non-patent literature referred to in Rule 34.1(b)(ii) (“the list”) with a view to verify that items continue to meet the criteria for inclusion and to consider resources for addition to the list.

[DRAFTING COMMENT<sup>2</sup>: This part has been drafted to use the term “list” for the non-patent literature minimum documentation, “item” for an entry on the list (the same terminology used in Rule 34.1(b)(ii)) and “resource” for something that an examiner could consult that might be eligible for inclusion on the list.]

[COMMENT: Non-patent literature includes Traditional Knowledge resources.]

### **Criteria for Inclusion**

22. An item must be represented by an individual title.
23. An item must be available electronically:

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<sup>2</sup> Comments are for explanatory purposes only and do not form part of the Administrative Instructions.

- (a) to International Searching Authorities in at least one digital format that is readily available and acceptable to all Authorities, and
- (b) to the public, online, for a reasonable commercial fee, as part of a personal or institutional subscription, or at no cost.

[COMMENT: Digital format covers both digital and digitized].

24. An item must be full text and accessible through an institutionally available search interface. Preferably, an item should also be available in a text-coded format that would allow it to be incorporated into a search interface. Full text, for the purpose of non-patent literature, is defined as an electronic resource that provides the entire text or content of a single work; not necessarily in a text-searchable machine-readable form.

25. Resources whose only electronic availability is as part of a subscription (“subscription-based resources”) must be institutionally accessible to be eligible for inclusion as an item; email subscription resources, or other personal use subscription resources, are not eligible for consideration. “Institutionally accessible” is defined as a resource that can be subscribed to or purchased by a single institution, with terms of use and search functionality applicable to all authorized users of the institution.

26. An item must provide terms of use that allow for copies of cited documents to be distributed to applicants as part of the international search and preliminary examination procedure, and to designated or elected Offices (DO/EO) upon request under Article 20(3) and Rule 44.3.

### **Updating the List of Minimum Documentation**

27. A Task Force comprising representatives of International Searching Authorities (“the Task Force”) shall perform the review referred to in paragraph 21 and report on a regular basis to the International Searching Authorities. In that context, the Task Force shall convene a meeting every five years to undertake a comprehensive review of the list of items and any recommended resources based on the criteria in paragraph 31. International Searching Authorities shall agree on the International Searching Authority responsible for convening and organizing that meeting of the Task Force at least six months before the meeting.

28. Any International Searching Authority may recommend a resource that meets the criteria in paragraphs 22 to 26 for inclusion in the list by submitting a proposal to the Task Force at least four months before the meeting. The proposal shall include an explanation to show that the resource meets the criteria and may include information to accompany the recommendation such as details of usage of the resource, the need to include the subject matter of the resource in the minimum documentation, the value of the resource to search examiners, the impact factor of a journal resource, etc. The International Searching Authority shall provide the Task Force with any further information relevant to the recommendation if requested by any member of the Task Force.

29. The Task Force will not consider a resource that does not meet the criteria in paragraphs 22 to 26 for inclusion in the list.

30. Prior to the meeting, any International Searching Authority may comment on the suitability of a recommended resource for inclusion on the list, such as providing further information on the usage of the resource, its contribution to the minimum documentation, and the impact of adding the resource on the list such as costs of obtaining access to the resource.

31. The Task Force shall evaluate the recommended resources for inclusion against the following:

- (a) the criteria in paragraphs 22 to 26;
- (b) international search report citation metrics from the preceding three years;
- (c) other evidence that demonstrate the value of a resource to an examiner performing international search and preliminary examination such as usage and examiner input;
- (d) subject matter of the resource, with a view to the list constituting a balanced representation of subject matter across all sections of the International Patent Classification scheme; and
- (e) cost of subscription or access to the resource.

32. The Task Force shall verify that existing items on the list continue to meet the inclusion criteria in paragraphs 22 to 26 and identify any items that have been discontinued.

33. Following the meeting referred to in paragraph 27, the Task Force shall submit a revised list to the International Searching Authorities for them to agree upon as the updated list under Rule 34.1(b)(ii). The revised list shall include any items recommended by the Task Force for addition to the list after the evaluation under paragraph 31 and all items that have been verified under paragraph 32 as continuing to meet the inclusion criteria and are either current or discontinued.

34. Notwithstanding the process in paragraphs 28 to 31, an International Searching Authority may share resources with the Task Force that are not on the list but could be useful for examiners to consult during international search. International Searching Authorities are also encouraged to ask questions or share any information and experiences that may contribute to enhancing the use of the minimum documentation during international search.

35. The International Bureau shall provide a mechanism for the public to suggest resources to consult during international search that are not on the list. The International Bureau shall share any such suggestion with the Task Force and ask the volunteer International Searching Authority, referred to in paragraph 38, to assess it. If it believes that the conditions are met, the volunteer International Searching Authority may recommend the resource to the Task Force for consideration in accordance with paragraphs 28 to 31.

### **Traditional Knowledge Non-Patent Literature**

36. The present set of criteria applies to all sources of non-patent literature prior art, including Traditional Knowledge resources. Therefore, Offices recommending their Traditional Knowledge as part of the minimum documentation must comply with the present criteria. However, if, in the future, the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore and other relevant bodies within WIPO decide that Traditional Knowledge prior art should be treated differently than other non-patent literature prior art, then the Task Force shall meet to discuss additional criteria that is specifically directed to Traditional Knowledge resources in line with any new understanding on the treatment of such prior art.

### **Annual Review of List**

37. The Task Force shall establish a schedule of volunteer International Searching Authorities to conduct an annual review of the list on a rotational basis for obsolete and discontinued resources, as well as metadata updates.

38. The volunteer International Searching Authority conducting the annual review shall verify the list for any discontinued or obsolete items and update any metadata from the list. This Authority shall share the findings from this review with the Task Force and provide the International Bureau with any updates that are required to the list, including removal of discontinued or obsolete items.

#### **Access to Items on List**

39. International Searching Authorities are required, at a minimum, to maintain full text access to the most recent five years of content calculated from the current date. When an item is added to the list, International Searching Authorities are required to obtain access to the item within two years from the date that the item is added.

40. An International Searching Authority may report to the volunteer International Searching Authority conducting the annual review under paragraph 38 at any time if it considers that an item on the list no longer meets the inclusion criteria in paragraphs 22 to 26, and inform the Task Force accordingly.

Appendix 1:

Example of an Authority File

Country Code	Publication Number	Kind Code	Publication Date	Exception Code (Optional)	Text-searchable Abstract as officially published Available? (Language codes/N/U)	Text-searchable Description Available? (Language codes/N/U)	Text-searchable Claims Available? (Language codes/N/U)
1	EP	1	A1	19781220	de	de	de
2	EP	12493		U	U	U	U
3	EP	216086	A2	19870401	M	de	de
4	EP	272830	A2	19880629	M	en	en
5	EP	394856	A1	19901031	de,en	de	de
6	EP	394856	B1	19970604	en	de	de,en,fr
7							
8	CA	2787765	A1	20140222	en,fr	en	en
9							
10	CH	710284	A1	20160429	de	de	de
11	CH	711700	A2	20170428	it	it	it
12							
13	FI	101368	B	19980615	fi,sv	fi	fi
14	FI	20165833	L	20180508	fi,en	N	N
15							
16	WO	2010037978	A2	20100408	en,fr	fr	fr
17	WO	2021073392	A1	20210422	en,fr,zh	zh	zh

Table 1

The text below is a Version 2.2 ST.37 authority file, produced by an International Searching Authority or those Offices wishing their publications to be included in the minimum documentation set, represented using a TXT structure where the data elements are separated by a comma. It represents the data in Table 1 shown above:

...

EP,1,A1,19781220,ABST-de,DESC-de,CLMS-de<CRLF>

EP,12493,,U,ABST-U,DESC-U,CLMS-U<CRLF>

EP,216086,A2,19870401,M,ABST-de,DESC-de,CLMS-de<CRLF>

EP,272830,A2,19880629,M,ABST-en DESC-en, CLMS-en<CRLF>

EP,394856,A1,19901031,,ABST-en, ABST-de,DESC-de,CLMS-de<CRLF>

EP,394856,B1,19970604,,ABST-en, DESC-de, CLMS-de, CLMS-en, CLMS-fr<CRLF>

''''''''

CA,2787765,A1,20140222,,ABST-en, ABST-fr,DESC-en, CLMS-en<CRLF>

''''''''

CH,710284,A1,20160429,, ABST-de, DESC-de, CLAMS-de<CRLF>

CH,711700,A2,20170428,,ABST-it, DESC-it, CLMS-it<CRLF>

\*\*\*\*\*

FI,101368,B,19980615,,ABST-fi, ABST-sv, DESC-fi, CLMS-fi<CRLF>

FI,20165833,L,20180508,,ABST-fi, ABST-en, DESC-N, CLMS-N<CRLF>

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WO,2010037978,A2,20100408,,ABST-en, ABST-fr,DESC-fr,CLMS-fr<CRLF>

WO,2021073392,A1,20210422,,ABST-en, ABST-fr, ABST-zh, DESC-zh, CLMS-zh<CRLF>

[End of Annex III and of document]