

Patent Cooperation Treaty (PCT) Working Group

Fifteenth Session
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CITATION OF NON-WRITTEN DISCLOSURES

Document prepared by the International Bureau

SUMMARY

1. The Working Group is invited to endorse the principle of extending the definition of prior art under the PCT to include non-written disclosures and to invite the International Authorities to study the details necessary for implementation and to make proposals to future sessions of this Working Group and any other affected bodies.

BACKGROUND

2. In document PCT/MIA/29/2, the International Bureau invited International Authorities to comment on the idea of extending the definition of prior art for international search and preliminary examination under the PCT to include non-written disclosures. This would bring the definition more closely into line with the definitions used by many Contracting States. The proposal received broad support from Authorities, and it was observed that the proposal would improve the quality of international work products by allowing examiners to consider non-written disclosures when preparing reasoned statements on novelty and inventive step. On the other hand, a number of detailed issues were raised by Authorities. These included the changes that would be required to IT systems and the further guidance to examiners and patent Offices that would be required concerning the citation of non-written disclosures and for storage of disclosures in non-traditional media such as video and audio disclosures and their storage. This would become particularly important if an earlier disclosure was no longer available on the Internet by the time of national phase examination.

3. Following that session of the Meeting of International Authorities, the International Bureau initiated informal consultations via the Quality Subgroup wiki on a number of issues raised during the Meeting.

4. Concerning the drafting of amendments to the PCT Regulations, consideration was needed of whether to retain Rules 33.1(b) and 64.2 (and by consequence Rule 70.9), which were shown as deleted in the International Bureau's original proposal. These paragraphs require an international search report to list written disclosures that took place on or after the international filing date (for international search) or relevant date (for international preliminary examination) if they refer to a non-written disclosure before the respective date.

5. The provisional results of that consultation are that these rules remain useful. It may be desirable to change their emphasis slightly to reflect the fact that they are providing evidence to support the non-written disclosure that is the actual prior art. However, for the purpose of the discussion in this meeting, they have been left unchanged.

6. A second category of consultations addressed the more practical issues with regard to the citation of non-written disclosures, including:

- the citation of video and audio disclosures and their storage, means for providing evidence of such non-written disclosures, especially if an earlier disclosure was no longer available online;
- the documentation of videos in written form, including how to depict non-audible disclosures in videos in a transcript;
- issues with copyright and file size when saving, and distributing audio/video recordings;
- the reliable identification of dates of disclosure, and the distinction between the date of an original disclosure and the date when a particular record of that disclosure was made available on an online system; and,
- how Internet disclosures are made – for example one International Searching Authority prints the screenshot of the URL and treats it as a written disclosure rather than citing it as an "O" reference.

7. Authorities have been invited to comment and share practices on these and any other points that could be relevant to how any changes to the PCT Regulations could be implemented in modifications to the PCT Administrative Instructions and PCT International Search and Preliminary Examination Guidelines, or to the development of WIPO Standard ST.14. These consultations are ongoing.

PROPOSED UPDATES ON THE CITATION OF NON-WRITTEN MATERIAL

DEFINITION OF PRIOR ART

8. The Annex to this document sets out draft amendments to the PCT Regulations that would extend the definition of relevant prior art to cover all types of disclosures, both written and non-written. The definition of prior art contained in these amendments is intended to be consistent with national and regional patent jurisdictions. As discussed in paragraph 4 above, the proposed draft amendments differ from the amendments set out in the document PCT/MIA/29/2 in that Rules 33.1(b) and 64.2 are maintained in the draft amendments.

PRACTICES ON THE CITATION OF NON-WRITTEN DISCLOSURES

9. With the proposed amendments to the PCT Regulations, the specific processing of non-written disclosures would be discontinued, and various forms in PCT Chapters I and II would need to be significantly simplified. The main changes would affect forms ISA/237 and IPEA/408 or 409, including Box No. V and VI that were primarily designed to accommodate citations for written material. While simplifications are good *per se*, considerable work would still be necessary to adapt the PCT Administrative Instructions and PCT International Search and

Preliminary Examination Guidelines, and to review the content of WIPO Standard ST.14. Some of the practical issues to be addressed have been listed in paragraph 6 of this document. The difficulty of this work is partly due to the variety of formats for citations related to non-written material. Various kinds of non-written material such as videos, audio recordings or multimedia files have features that are not shared with standard citations of written material. Also, adjustments of IT systems used by Authorities to issue PCT forms will be required after a decision on implementation details and new practices related to the change. In particular, significant development work on the software environment used by patent examiners to enter citation data would be needed and would strongly affect the implementation timetable. A careful resource allocation plan for upgrades of IT systems would need to be devised accordingly. The International Bureau would update its ePCT services for International Authorities to accommodate the changes.

STORAGE OF NON-WRITTEN MATERIAL

10. The level of certainty of the publication date for a particular piece of prior-art depends heavily on the level of trust associated with the source of the prior art. An untrusted online source may at best provide a merely indicative date of publication, which would need to be confirmed by other means, for example, the Internet Archive Wayback Machine or other similar trusted digital archives of the Internet.

11. Storing copies of cited prior art found in searches is a service provided by certain Offices to alleviate the problem of citations being changed or made unavailable after their initial retrieval on the Internet, especially if sources do not guarantee availability of unmodified versions of the cited prior art over time. WIPO Standard ST.14 also recommends that copies of an electronic document should be retained if the same document may not be available for retrieval in the future, for example, when the source is the Internet and online databases. International Searching Authorities offering to store copies of cited prior art provide a valuable service also to designated and elected Offices, because access to the correct version of the cited prior art would be guaranteed after entry into the national or regional phase, though as with other types of prior art, copyright issues need to be considered.

12. A recommendation for International Searching Authorities to store systematically cited prior art in a dedicated database should be considered. It is noted that the European Patent Office already sends copies of cited documents to ePCT for the benefit of the applicant (but not made available on PATENTSCOPE for copyright reasons), except for a small number for which it does not have the appropriate rights. A central repository accessible by designated or elected Offices would strengthen the legal certainty of non-written material cited by a variety of International Authorities. Non-written material cited by a particular Authority in an international search report would then readily be available to other Authorities in Chapter II and to designated/elected Offices after entry into the national or regional phase.

NEXT STEPS

13. It is proposed that the International Authorities should continue to study the issues involved in the citation of non-written disclosures as prior art under the PCT and make recommendations to this Working Group and any other affected bodies for further steps within the PCT and any related issues, such as WIPO Standards.

14. The Working Group is invited to approve the principle of including non-written disclosures in the definition of prior art under the PCT and to invite the International Authorities to study the requirements for effective implementation of any such change

*and to make recommendations on
further work.*

[Annex follows]

DRAFT PROVISIONAL AMENDMENTS
TO THE PCT REGULATIONS¹

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

Rule 33

Relevant Prior Art for the International Search

33.1 *Relevant Prior Art for the International Search*

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

(b) *[No change]* When any written disclosure refers to an oral disclosure, use, exhibition, or other means whereby the contents of the written disclosure were made available to the public, and such making available to the public occurred on a date prior to the international filing date, the international search report shall separately mention that fact and the date on which it occurred if the making available to the public of the written disclosure occurred on a date which is the same as, or later than, the international filing date.

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

33.2 and 33.3 *[No change]*

Rule 64

Relevant Prior Art for the International Preliminary Examination

64.1 *Prior Art*

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

(b) [No change]

64.2 and 64.3 [No change]

[End of Annex and of document]