

Patent Cooperation Treaty (PCT) Working Group

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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/16/7, the PCT Minimum Documentation Task Force (“the Task Force”) made much progress in its review of the PCT minimum documentation. Following the fifteenth session of the PCT Working Group (October 3 to 7, 2022), the Task Force has fine-tuned the proposed amendments to the PCT Regulations and Administrative Instructions discussed during that session of the Working Group. The revised 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 recommend the submission of the proposed Rule amendments to the PCT Assembly in 2023 for adoption. The intended entry into force of the proposed Rule amendments would be on January 1, 2026, in order to match with 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. Except for some minor editorial edits, the proposed Rule amendments are identical to the ones submitted to the PCT Working Group at its fifteenth session (see document PCT/WG/15/11). 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 Meeting of International Authorities under the PCT (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) as 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 RULES 36 AND 63

3. As also indicated in document PCT/WG/16/7, it is suggested that the PCT Assembly adopts an Understanding on how the requirements in the proposed amendments to Rules 36 and 63 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. It is suggested that this Understanding be submitted for adoption to the PCT Assembly at the same time as the amendments to Rules 36 and 63.

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.

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 proposed new provisions provide 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 to 6 and 17 of proposed new Annex H. The revised wording of paragraphs 3 to 6 of proposed Annex H leaves each providing Office with the task of issuing the access credentials to its patent collection to the ISAs which request such access. Contrary to what was originally proposed in document PCT/WG/15/11, the International Bureau of WIPO would not be involved in the distribution of access credentials to ISAs. Hence, in case of an abusive use of data, the access to the data could be blocked directly by the providing Office, which would in turn inform the International Bureau accordingly. It is expected that the International Bureau of WIPO would in turn make this information known to all ISAs. Paragraphs 3 and 4 of proposed Annex H neither prevent 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.

(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, 15 and 17 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 18 of proposed new Annex H (see paragraphs 16 and 18 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 8 to 11 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 8(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. Having the data elements referred to in paragraph 8(e) of Annex H as mandatory for PCT minimum documentation purposes brings many benefits: being able to quickly identify the language of publication of the abstracts, description, and claims of each document belonging to the PCT minimum documentation; the ability to easily identify which documents in a collection are not available electronically, but only available on paper; plus the ability to easily identify publication numbers for which no documents exist (i.e. the gaps in a collection). These benefits allow Offices to master their workload and to ensure that their examiners have access to the most comprehensive and high-quality patent documentation for their international searches.

9. Paragraph 19 of proposed new Annex H specifies the optional data elements that shall be contained in the WIPO ST.37 Authority Files.

10. Paragraph 12 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 under paragraphs 20 and 21 of proposed new Annex H.

11. Paragraph 13 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 24 to 28 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. The word “online” was added to paragraph 25(b) of proposed new Annex H after feedback received from the Japan Patent Office. Paragraph 25(b) of proposed new Annex H now reads: “An item must be available electronically [...] to the public, online, for a reasonable commercial fee, as part of a personal or institutional subscription, or at no cost.”

15. 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.

16. Paragraphs 29 to 37 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).

17. 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 36 of proposed new Annex H).

18. 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 37 of proposed new Annex H).

19. Paragraph 38 of proposed new Annex H is dedicated to traditional knowledge non-patent literature. The current wording of that paragraph acknowledges that there are ongoing discussions concerning traditional knowledge in other WIPO bodies. This wording leaves the door open for a special treatment of traditional knowledge resources, should the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC) determine that such special treatment is appropriate. At the same time, this wording allows the Task Force to include in the PCT minimum documentation any traditional knowledge resources which would meet the present set of criteria. Some traditional knowledge resources are already part of the current PCT minimum documentation and will continue to be part of the PCT minimum documentation under the new set of criteria.

20. Paragraphs 39 and 40 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 to the Task Force through its electronic forum and provide the International Bureau with any updates that are required to the list.

21. In paragraph 41 of the proposed new Annex H, the terms “in the case of periodicals” were added to the first sentence following a suggestion from the Indian Patent Office at the fifteenth session of the PCT Working Group. That sentence now reads: “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 in the case of periodicals.”

22. 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

23. 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 for adoption. The intended entry into force of the proposed Rule amendments would be on January 1, 2026, in order to match with the next round of reappointment of International Authorities.

24. 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 REGULATIONS¹

TABLE OF CONTENTS

| | |
|--|---|
| Rule 34 Minimum Documentation..... | 2 |
| 34.1 <i>Definition</i> | 2 |
| Rule 36 Minimum Requirements for International Searching Authorities | 5 |
| 36.1 <i>Definition of Minimum Requirements</i> | 5 |
| Rule 63 Minimum Requirements for International Preliminary Examining Authorities | 6 |
| 63.1 <i>Definition of Minimum Requirements</i> | 6 |

¹ 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) published 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 protection referred to in items (ii) to (v) above, published in and after 1920.

(b) Notwithstanding paragraph (c), ~~T~~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 RULES 36.1(II) AND 63.1(II)

“In adopting the amendments to Rules 36.1 and 63.1 setting out the minimum requirements referred to in Articles 16(3)(c) and 32(3), respectively, 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 Rules 36.1(ii) and 63.1(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 and Use of Data

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. Upon request by an International Authority, each said Office shall provide that International Authority with all the relevant information and authorization details necessary to access this data, for example the links, passwords, etc., so that it can access the data for free in bulk format electronically, preferably via FTP, SFTP or Web Services. Each Office shall ensure that all published data is made available in the said repository or repositories preferably within one month after its publication date, and in any event, no later than two months. If an Office also provides a search interface to its data, it shall preferably also provide access to such a search interface for free.

4. Any patent and utility model data made available by Offices to International Authorities within the context of paragraph 3 shall 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 providing Office, which would in turn inform the International Bureau accordingly.

5. Paragraphs 3 and 4 neither prevent 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.

6. Any Office 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 paragraphs 3 and 4.

Authority File

7. 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.

8. 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 as used by the Office publishing the document (kind-of-document code);
- (d) publication date of the patent document; and
- (e) subject to paragraph 10, 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.

9. The Office shall provide the data elements referred to in paragraph 8(a) to 8(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.

10. With regard to the data elements referred to in paragraph 8(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.

11. 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 8(a) to 8(e).

12. 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.

13. 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

14. An Office shall make available in text-searchable machine-readable form in accordance with paragraph 17 any document published on or after [DATE OF ENTRY INTO FORCE OF AI] in its patent or utility model collection.

15. 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 17 any document published on or after January 1, 1991 in its patent or utility model collection or that of a legal predecessor.

16. 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 17. 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 18.

Documents Made Available in Text-Searchable Machine-Readable Form

17. 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. Each document in plain text format must have an unambiguous identifier, preferably the publication number, or otherwise, the application number. The same conditions as already described in paragraphs 3 and 4 also apply here.

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

18. 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 8(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

19. 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

20. 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 8(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 8(e) should be "U".

21. 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

22. 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.

PART II

NON-PATENT LITERATURE

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

23. 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 COMMENT²: 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.]

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

Criteria for Inclusion

24. An item must be represented by an individual title.
25. An item must be available electronically:
 - (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].

26. 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.

27. 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.

28. 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

29. A Task Force comprising representatives of International Searching Authorities (“the Task Force”) shall perform the review referred to in paragraph 23 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 33. 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.

30. Any International Searching Authority may recommend a resource that meets the criteria in paragraphs 24 to 28 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.

31. The Task Force will not consider a resource that does not meet the criteria in paragraphs 24 to 28 for inclusion in the list.

32. 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.

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

- (a) the criteria in paragraphs 24 to 28;
- (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.

34. The Task Force shall verify that existing items on the list continue to meet the inclusion criteria in paragraphs 24 to 28 and identify any items that have been discontinued.

35. Following the meeting referred to in paragraph 29, 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 33 and all items that have been verified under paragraph 34 as continuing to meet the inclusion criteria and are either current or discontinued.

36. Notwithstanding the process in paragraphs 30 to 33, 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.

37. 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 40, 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 30 to 33.

Traditional Knowledge Non-Patent Literature

38. 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

39. 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.

40. 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

41. 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 in the case of periodicals. 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.

42. An International Searching Authority may report to the volunteer International Searching Authority conducting the annual review under paragraph 40 at any time if it considers that an item on the list no longer meets the inclusion criteria in paragraphs 24 to 28, 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>

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]