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The International
Patent System



PCT Update

Intellectual Property Roundtable

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PCT Rule Changes as of July 1, 2022 – Sequence Listings (1)

- Transition from WIPO Standard ST.25 to XML-based ST.26 for presentation of sequence listings in international applications filed on or after July 1, 2022
- Amendment of PCT Rules 5, 12, 13^{ter}, 19.4 and 49
- New Annex C to PCT Administrative Instructions
- Receiving Office specifies language(s) accepted for free text
- WIPO Sequence Suite
 - WIPO Sequence – authoring tool for applicants
 - WIPO Sequence Validator – IP Office validation tool

PCT Rule Changes as of July 1, 2022 – Sequence Listings (2)

■ Future Developments

- Proposed revisions of WIPO Standard ST.26 (version 1.6) at CWS/10 (November 21 to 25, 2022)
- Discussion on new standard for transmission of ST.26 sequence listings as part of priority documents and other certified copies
- Improved viewing facilities for ST.26 sequence listings in PATENTSCOPE

PCT Rule Changes as of July 1, 2022 – Safeguards

- Amendment of PCT Rule 82*quater*
 - “Epidemic” added as one of the emergencies listed
 - Allowing Offices to waive the requirement to provide evidence in excusing delays under Rule 82*quater*.1
 - Authorization for Offices to establish a period of extension (maximum 2 months) for time limits in the case of general disruptions
- Applies to time limits fixed in the Regulations that expire on or after July 1, 2022

PCT International Searching and Preliminary Examining Authorities (ISA/IPEA)

- Eurasian Patent Office (EAPO) started operations as an ISA/IPEA on July 1, 2022
- 24 operating ISA/IPEAs
- PCT Committee for Technical Cooperation recommendation for PCT Assembly to appoint Saudi Authority for Intellectual Property (SAIP) as ISA/IPEA
- Next PCT Assembly from July 6 to 14, 2023

Future Developments

- No amendments to the PCT Regulations for July 1, 2023
- PCT Working Group
 - Fifteenth session - October 3 to 8, 2022
 - Sixteenth session - February 6 to 8, 2023 (virtual only)
- PCT Assembly next session – July 6 to 14, 2023

PCT Minimum Documentation - Issues

Definition of PCT minimum documentation needs revision for electronic searching

■ Patent documents

- Move from language-based criteria to technical requirements for Offices to provide access for International Authorities and database providers

- Coverage of utility models

■ Non-patent literature

- Electronic access to periodicals

- Traditional knowledge databases (TKDL)

PCT Minimum Documentation – Task Force

European Patent Office took over leadership in 2016

- Four objectives (Appendix to document PCT/MIA/24/4)
 - Objective A: Create up-to-date inventory (patent and non-patent parts)
 - Objective B: Recommend criteria and standards for including a national patent collection
 - Objective C: Propose bibliographic and text components of patent data that should be present in patent collections
 - Objective D: Recommend criteria and standards for non-patent literature and assess proposal for adding Indian TKDL (led by USPTO)

PCT Minimum Documentation – Objective A

WIPO Handbook on Intellectual Property Information and Documentation

■ Part 4.1 – Inventory of Patent Documents

- Coverage up to September 30, 2021

- Links to authority files (Authority File Portal, or IP Office website)

■ Part 4.2 – List of Non-Patent Literature

- Reflects information on each periodical as of June 1, 2020

Authority File

Authority file – list of all publication numbers of patent documents assigned by an Office with various data elements

- WIPO Standard ST.37 – defines the data elements, and structure and format of file
- Publication exception codes if document not available in machine-readable form
- Allows other IP Offices and other parties to assess completeness of available patent documentation
- [Authority File Portal](#) on WIPO website

PCT Minimum Documentation Task Force – Objectives B and C (1)

Proposed amendments to Rules 34, 36 and 63

- Patent collections meeting technical and accessibility requirements will be part of PCT Minimum Documentation
- Any IP Office can make its patent collection available, but required for all International Authorities – more document collections
- Replaces country and language criteria in Rule 34.1(c)
- Utility model collections can be made available under same requirements as patent collections (searching preferred, but not mandatory)
- Entry into force from 2026

PCT Minimum Documentation Task Force – Objectives B and C (2)

Technical and accessibility requirements

- Electronically-searchable full text of document
- Machine-readable document in image format
- Publication exception code where not available

Applicability of requirements

- All documents published after entry into force
- Backfiles from a cut-off date (January 1, 1991) – to apply after transition period (10 years)

WIPO Standard ST.37 revised in November 2021

- New data elements to show availability and language of text-searchable abstract, description and claims

Authority File - example

	Country Code	Publication Number	Kind Code	Publication Date	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	XXXXXXX	A1	20260108	de	de	de
2	EP	XXXXXXW	A1	20260108	en	en	en
3	EP	XXXXXXV	A1	19901218	U	U	U
4	EP	XXXXXXQ	A1	19901211	U	U	U

- Language codes to show availability of searchable text (required for patent documents published after 2026)
- Recommended but not mandatory for patents published before January 1, 1991

PCT Minimum Documentation Task Force – Objective D (1)

Criteria for inclusion of non-patent literature (NPL)

- Available to public in at least one online electronic format (for reasonable commercial fee, or at no cost)
- Readily available to International Searching Authorities in at least one acceptable online electronic format
 - With a search interface or indexed to be incorporated into search interface
- Terms of use must allow copies of citations to be sent to applicant, and designated/elected Office on request

PCT Minimum Documentation Task Force – Objective D (2)

Evaluation of resources for inclusion in PCT minimum documentation

- Comprehensive review by Authorities every 5 years
- Annual review to update metadata, and check for obsolete or discontinued resources
- Authorities recommend eligible resources for consideration and public can provide suggestions
- Evaluation criteria of a resource
 - Usage metrics
 - Subject matter
 - Cost of subscription or access

PCT Minimum Documentation Task Force – Next Steps

Virtual Meeting of Task Force from November 14 to 18, 2022

- Proposed Modifications PCT Administrative Instructions
 - Application of requirements to patent collections
 - Traditional knowledge non-patent literature
- Launch of permanent Task Force after entry into force
- Preparation for implementation of new requirements and 10-year roadmap for patent documents until 2036

PCT Working Group from February 6 to 8, 2023

- Discussion of amendments to PCT Regulations for potential submission to PCT Assembly in July 2023

Citation of Non-Written Disclosures

Extension of Rule 33 and 64 definition of relevant prior art to include non-written disclosures

- Alignment with national laws
- Non-written disclosures considered when preparing reasoned statements on novelty and inventive step
- Further consideration among International Searching Authorities of practical matters:
 - Citation of disclosures and their distribution
 - Storage and documentation
 - Date of disclosure

PCT Online Services

- Full-text processing of international applications
 - Online workshops with Offices and users
- XML search reports and written opinions
 - 85% of international search reports from 9 ISAs
 - On-demand machine translation in PATENTSCOPE into the 10 PCT publication languages
 - Improved links to IPC, citations and patent families

Other Proposals

- WIPO Fee Transfer Service
- Formalities Checking in the PCT
- Mixed-Language International Applications
- Filing Medium of International Applications and Related Documents
- Improvement of International Search Report and Written Opinion



Thank you!

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