

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

**Twenty-Seventh Session
Gatineau, February 6 and 7, 2020**

PCT MINIMUM DOCUMENTATION TASK FORCE: STATUS REPORT

Document prepared by the European Patent Office

SUMMARY

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

2. In order to make faster progress, a physical meeting of the Task Force took place on May 21 and 22, 2019 at the EPO’s headquarters in Munich. That two-day meeting allowed the Task Force members to have constructive discussions on Objectives B, C and D and provided substantial input for making further progress. However, the issues which have been addressed show that much is still to be done. The follow-up work to the first session of the Task Force started in summer 2019 on the Task Force’s electronic forum, as further explained below.

BACKGROUND

3. In 2005, the MIA decided to set up a Task Force to undertake a comprehensive review of the PCT Minimum Documentation. The Task Force was mandated to address issues relating to both patent documentation and non-patent literature, including traditional knowledge-related

databases (document PCT/MIA/11/14). However, due to various reasons the process stalled for several years. In January 2016, there was consensus at the MIA to reactivate the Task Force and the International Bureau invited one of the International Searching Authorities to take up the role of task force leader. In February 2016, the EPO responded positively to the call of the International Bureau and, thereafter, the Task Force was reactivated under the lead of the EPO.

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

- Objective A: Create an up-to-date inventory of the patent literature and non-patent literature parts of the current PCT Minimum Documentation.
- Objective B: Recommend criteria and standards for including a national patent collection in the PCT Minimum Documentation.
- Objective C: Propose clearly-defined bibliographic and text components of patent data that should be present in patent collections belonging to the PCT Minimum Documentation.
- Objective D: Recommend criteria and standards for the review, addition and maintenance of non-patent literature and traditional knowledge-based prior art, and afterwards assess, on the basis of the criteria that will have been established, the revised proposal from the Indian authorities on the Indian Traditional Knowledge Digital Library database.

5. Usually, the Task Force conducts its work using an electronic forum made available by WIPO (“the wiki”). The discussions on Objectives A, B and C are being led by the EPO and the discussions on Objective D are being led by the USPTO. Document PCT/MIA/27/12 reports in more detail on the discussions under Objective D.

STATE OF PLAY

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

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

- (a) The first issue relates to the language-based criteria currently contained in Rule 34.1 PCT which give rise to the following situation:
- the national patent collections of some ISAs do not belong to the PCT Minimum Documentation;
 - the contents of the PCT Minimum Documentation vary depending on the ISA’s official language(s) and the availability of English abstracts; and
 - the patent literature part of the PCT Minimum Documentation is limited to patent documents published in a limited number of languages.

(b) The second issue relates to utility models. Currently, Rule 34.1 PCT only explicitly mentions the utility models of France as being part of the PCT Minimum Documentation, thereby omitting several other significant utility model collections that are important sources of relevant prior art.

8. With regard to Objective C, the first discussion round focused on examining whether the Authority File Standard ST.37 could be used to facilitate describing the contents of patent and utility model collections belonging to the PCT Minimum Documentation.

9. With regard to Objective D, the first step was the preparation by the USPTO of a questionnaire directed to the PCT International Authorities regarding their use of non-patent literature and traditional knowledge-based prior art sources and databases in their prior art searches. The questionnaire also addressed updates and additions of non-patent literature and traditional knowledge information and databases to the list of PCT Minimum Documentation, the requirements for such databases to be useable by the International Authorities, possible problems in utilizing those databases and questions regarding potential confidentiality and other requirements attached to the use of those databases. The International Bureau sent the questionnaire to the International Authorities on July 9, 2018 in Circular C. PCT 1544.

10. At the twenty-sixth session of the MIA on February 13 and 14, 2019, the EPO presented in the Task Force's status report (document PCT/MIA/26/8) the conclusions that could be drawn from the first discussion rounds on Objectives B and C. The USPTO presented in an Annex to that report some preliminary observations on the replies to the questionnaire contained in Circular C. PCT 1544 (Annex IV to document PCT/MIA/26/8).

11. At that session of the MIA, Authorities welcomed the progress that had been made in all areas, discussed the Task Force's status report referred to above (document PCT/MIA/26/8) and made several comments on issues related to Objectives B, C and D (paragraphs 74 to 83 of document PCT/MIA/26/13). The EPO drew the attention to the fact that the outstanding details in Objectives B and C were complex and finalizing them through the electronic forum could be slow and difficult and, therefore, suggested to convene a physical meeting of the Task Force where the experts could meet face to face (paragraph 75 of document PCT/MIA/26/13).

12. Following the above suggestion from the EPO, the first session of the Task Force took place on May 21 and 22, 2019 at the EPO's headquarters in Munich. At that session, the EPO presented proposals aiming at updating and streamlining the definition of the patent literature part of the PCT Minimum Documentation (documents PCT/MD/1/2 and PCT/MD/1/3). More specifically, document PCT/MD/1/2 contained proposals for amendments of Rules 34 and 36 PCT and document PCT/MD/1/3 proposals for the technical and accessibility requirements for which the proposed revised Rules refer to the PCT Administrative Instructions. The USPTO reported on the replies to the questionnaire contained in Circular C. PCT 1544, summarized some of the recurring themes noted in the replies and proposed several questions for additional discussion (document PCT/MD/1/4). That two-day session allowed the Task Force members to have constructive discussions on Objectives B, C and D. All delegations agreed on the need of reviewing the PCT Minimum Documentation, and generally agreed with the objectives of the reform. However, the issues that have been addressed show that much is still to be done to come to an agreement on how that reform should be. The summary of discussions of that first session (document PCT/MD/1/5) is included as an Appendix to the present status report.

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

14. The follow-up work to the first session of the Task Force started on the wiki in summer 2019. With regard to Objectives B and C, at the beginning of August, the EPO posted on the wiki a document aiming at following up on the conclusions reached at that session regarding the proposals for amendments to the PCT Regulations (document PCT/MD/1/2/REV). In that document, the EPO presented in particular revised proposals for amendments of Rules 34 and 36 PCT and invited the other Task Force members to post their comments by September 27, 2019.

15. The main proposals for Rules' amendments presented by the EPO in document PCT/MD/1/2/REV are set out below:

- (a) It has been proposed to include in the PCT Minimum Documentation the patent collections of all ISAs, irrespective of their official language(s), and to make it a requirement for ISAs to make their patent collections available for consultation under clearly defined technical and accessibility requirements which need to be agreed upon within the framework of the upcoming discussions and specified in an Annex to the PCT Administrative Instructions.
- (b) It has been proposed to relax the language-based criteria currently contained in Rule 34.1 PCT and to avoid the current language-based variability of the contents of the PCT Minimum Documentation deriving from paragraph (e) of that Rule. At the same time, it has been proposed to include in the PCT Minimum Documentation the patent collection of any Office not appointed as ISA, provided that the said Office has made its patent collection available for consultation in accordance with the technical and accessibility requirements specified in an Annex to the Administrative Instructions, and has expressly notified the inclusion of its patent collection in the PCT Minimum Documentation to the International Bureau.
- (c) It has been proposed to include in the PCT Minimum Documentation the entire collections of Offices, being ISAs or not, as of 1920, and to specify in an Annex to the PCT Administrative Instructions the requirements which would in a first time only apply to patent documents published as of the date of entry into force of revised Rules 34 and 36 PCT and the requirements which would apply to those published before that date. More specifically, it has been proposed that in a first time the availability in machine-readable form should apply only to patent documents published as of the date of entry into force of revised Rules 34 and 36 PCT.
- (d) It has been proposed to have a clear-cut date for revised Rules 34 and 36 PCT to enter into force and to avoid having a transitional period of several years. However, with a view to taking into account the practical concerns expressed by several delegations at the first session of the Task Force, it has been proposed to only progressively require the availability in machine-readable form for documents published prior to the date of entry into force of revised Rules 34 and 36 PCT. In order that the date as of which the availability in machine-readable form would be mandatory could be regularly revised (for example, every five years), it has been proposed to include a specific revision clause in an Annex to the PCT Administrative Instructions.
- (e) It has been proposed to expand the PCT Minimum Documentation to more utility model collections. The EPO considers that it would be desirable to include utility model documents in the PCT Minimum Documentation under the same conditions and requirements as those which will be applicable to patent documents. However, in view of some concerns regarding the practicability of this point, two options have been proposed:

- (i) including utility model documents in the PCT Minimum Documentation as a mandatory part under the same conditions as patents (including by making it a requirement for ISAs to make their utility model collections available for consultation as part of the PCT Minimum Documentation), or
- (ii) including utility model documents in the PCT Minimum Documentation as an optional but recommended part.

Regarding the latter option, it has been proposed that the utility models issued, and the utility model applications published, by any Office (being ISAs or not) should be included in the PCT Minimum Documentation, provided that the said Office has made them available for consultation in accordance with the technical and accessibility requirements to be specified in the above mentioned Annex to PCT Administrative Instructions, and has expressly notified their inclusion in the PCT Minimum Documentation to the International Bureau as should be specified in that Annex to the PCT Administrative Instructions. In any case, in light of the Task Force's discussions of its first session, any language related requirements which would be applicable to patents should also apply to utility models.

16. Moreover, together with document PCT/MD/1/2/REV, the EPO posted on the wiki a template for the assessment by ISAs of the current status of their patent document collections and invited the other Task Force members to post by September 27, 2019 a summary of the results of the performed assessment. The results of these assessments should help the EPO to prepare a revised version of its document PCT/MD/1/3 dealing with the technical and accessibility requirements to be specified in an Annex to the PCT Administrative Instructions.

17. The EPO received comments on document PCT/MD/1/2/REV only from the Finnish Patent and Registration Office, the Japan Patent Office, the Canadian Intellectual Property Office and the Indian Patent Office as well as from the International Bureau, and summaries of the status of the patent documents' collections from the Finnish Patent and Registration Office, the Japan Patent Office and the Indian Patent Office. In view of the limited feedback received the EPO extends the deadline for comments up until February 29, 2020.

18. With regard to Objective D, the USPTO posted in June on the wiki a spreadsheet compiling all of the replies to the questionnaire contained in Circular C. PCT 1544. Moreover, at the end of July, the USPTO posted an additional questionnaire on non-patent literature which should help the development of criteria and standards for the review, addition, and maintenance of non-patent literature and traditional knowledge-based prior art in the PCT Minimum Documentation. The Task Force members were invited to reply to that questionnaire by the end of November 2019. Only five Offices (Brazilian National Institute of Industrial Property, Canadian Intellectual Property Office, EPO, Japan Patent Office and USPTO) had replied to that questionnaire by the end of December 2019 when the USPTO posted a spreadsheet compiling all the replies on the wiki. The Korean Intellectual Property Office replied in January 2020. Document PCT/MIA/27/12 provides a status report from the USPTO on Objective D with further details of the responses.

19. The EPO reiterates its invitation to all International Authorities to participate in the Task Force's discussions in the wiki to ensure further progress on this important topic.

20. The Meeting is invited to take note of the contents of the present document.

[Appendix follows]

PCT Minimum Documentation Task Force

First session
Munich, 21-22 May 2019

Summary of discussions

adopted by the Task Force

1. The PCT Minimum Documentation Task Force (“the Task Force”) held its first session in Munich on 21-22 May 2019.
2. The list of participants is contained in the Annex to this document.

Item 1: Opening of the session

3. Mr C. Bogliolo, Head of Department PCT Affairs, European Patent Office (EPO) welcomed the participants as Chair of the session. In his opening remarks, Mr Bogliolo recalled that the EPO was organising this meeting in view of the fact that it was steering the Task Force on PCT Minimum Documentation under the PCT Meeting of International Authorities under the PCT (MIA). He further emphasized that the aim was generally to make progress in reviewing Rule 34 PCT and in establishing the criteria and standards for inclusion of national patent collections in the PCT Minimum Documentation as well as the bibliographic and text components of patent data in the PCT Minimum Documentation (Objectives B and C). It is intended to present concrete proposals regarding Objectives B and C to the PCT MIA at its next session in early 2020 following further consultations in the wiki on the basis of new documents prepared taking into account the feedback and guidance received at the present session. Moreover, he underlined that this session will also allow further discussion on Objective D with a view to hopefully also make further progress on that particular aspect of the PCT Minimum Documentation in the course of the year. Finally, he recalled that the aim of revising the PCT Minimum Documentation was to strengthen and harmonise the quality of PCT work products, in line with WIPO’s PCT Roadmap, in particular as regards the search, taking the following principles into consideration: simplification, transparency and usability, so as to ensure that the new PCT Minimum Documentation could be easily understood and implemented by all International Authorities. In the last few years, the focus of the PCT MIA has been essentially on enhancing the PCT Quality Management System. While that work will continue, updating the PCT Minimum Documentation became now a priority too. Around half of the PCT Authorities have been able to make it to Munich, and the outcome of the meeting will thus certainly be a good basis to achieve progress.
4. The International Bureau (IB) of WIPO thanked the EPO for hosting this meeting, and for taking up the secretariat. All delegations were thanked for attending the meeting on relatively short notice. The background and mandate of the Task Force were briefly recalled

and it was noted that much progress was made since the reactivation of the Task Force in 2016 under the lead of the EPO.

5. The Task Force adopted the agenda as set out in document PCT/MD/1/1.

Item 2: Objective B: Proposed amendments of Rules 34 and 36 PCT

6. Discussions were based on document PCT/MD/1/2.
7. The EPO presented its document PCT/MD/1/2. As a preliminary remark, the EPO underlined that Objectives B and C are closely related and explained that the said document is complementary to document PCT/MD/1/3. The EPO pointed out that the proposals presented in document PCT/MD/1/2 aim at updating and streamlining the definition of the patent literature part of the PCT Minimum Documentation, in particular with a view to addressing the two main issues identified by the Task Force under Objective B (see paragraph 8 of document PCT/MD/1/2). The said proposals are presented in paragraph 15 under the items (a) to (d), and in paragraphs 16 and 17 of that document. It was summarised that the three main objectives of the proposals are to expand the patent literature part of the PCT Minimum Documentation, to provide for simplification and to provide for greater flexibility. The EPO invited the other delegations to share their comments on document PCT/MD/1/2.
8. Concerns were expressed by INPI – Brazil, PRH – Finland and the JPO regarding the practical difficulties of making their complete patent collections as of 1920 available in searchable electronic format. The EPO replied that the proposals made in document PCT/MD/1/3 regarding the technical criteria refer to WIPO Standard ST.37 which provides for “Publication Exception Codes” to indicate documents for which the complete publication in machine-readable form is not available.
9. In the latter regard, the USPTO raised the issue that “Publication Exception Codes” could be used in an abusive way by an Office who would not be willing to make its national patent collection available for consultation as part of the PCT Minimum Documentation. The USPTO noted that it would then be left at the discretion of each Office whether to provide its national patent collection in searchable format or not. The USPTO hence considered that it was not clear to what extent the proposals in document PCT/MD/1/2 in conjunction with those in document PCT/MD/1/3 actually propose to make it a requirement for ISAs to make their complete patent collections available for consultation as part of the PCT Minimum Documentation. Moreover, as regards the drafting of the text proposed for Rule 34.1 PCT in document PCT/MD/1/2, the USPTO suggested including the clause contained at the end of paragraph (c)(ii) in paragraph (c)(i) as well, in order to have in that PCT Rule also for patent collections of ISAs a reference to the requirements specified in the PCT Administrative Instructions. In line with this comment, CIPO – Canada suggested referring in paragraph (c)(i) to Rule 36.1 PCT instead of repeating the information which is already contained in the new text proposed for Rule 36.1 PCT. In view of the possibility of using “Publication Exception Codes” for some parts of a national patent collection, CIPO – Canada and the USPTO questioned the usefulness of introducing a transitional period.
10. The EPO replied that it has to be further considered how to avoid abusive utilisation of “Publication Exception Codes”, for instance by having a clause in the Rule which would not allow documentation to be taken out of the PCT Minimum Documentation once it had been put in. The EPO also noted that the idea of a transitional period was to give ISAs from some additional time to comply with the new requirements which will be defined. The EPO added that a transitional period would provide the necessary transparency from the beginning regarding the documentation complying with the new requirements.

11. In order to provide further transparency, the IB offered to prepare a document listing the formats in which the patent documentation from ISAs is currently available on PATENTSCOPE. The IB also noted that they were in favour of a date for complete implementation without transition period. Any transition that might be agreed by PCT Member States could be in the form of a decision or understanding rather than an explicit provision in the PCT Regulations.
12. OEPM - Spain pointed out that according to current paragraph (f) of Rule 34.1 PCT, documents only laid open for public inspection are not part of the PCT Minimum Documentation and drew the attention to the fact that Spanish patent leaflets are available only from 1986 – before that date Spanish documents were only available for public inspection. It was added that Spanish patent documents between 1930 and 1986 have in the meanwhile been digitalised and published with a new kind code. In view of the latter fact, the Task Force concluded that the said patent documents could be considered as fulfilling the requirements of being published, thereby becoming part of the PCT Minimum Documentation. It was considered that it could be useful to introduce some information regarding the interpretation of current paragraph (f) of Rule 34.1 PCT in the PCT Administrative Instructions. Moreover, OEPM - Spain suggested that, for other Offices than ISAs, it could be envisaged to include their patent collections in the PCT Minimum Documentation, provided that they fulfil any new technical requirements, on the condition that they request such inclusion by a declaration to the IB. This would provide more transparency regarding the national patent collections which do form part of the PCT Minimum Documentation and those which do not.
13. PRH – Finland stated that a significant amount of Finnish patent documents were available via patent family members. Therefore, it was considered more useful if focus was put on making available in searchable electronic format only those Finnish patent documents for which there are no patent family members.
14. The JPO expressed its concern that there should not be any extra burden for the ISAs with regard to backlog files.
15. The USPTO expressed concerns with regard to IT implementation. In particular, the volume of data to be included in the PCT Minimum Documentation would be creating problems, especially by adding utility models. The USPTO underlined that the PCT Minimum Documentation should focus on setting minimum requirements and not creating the ideal collections. Furthermore, the added benefit of including all family members was questioned. The USPTO further stated that in terms of quantity of documents available to examiners, more is not always better; on the contrary, it might be considered a waste of time looking into collections which are in the end not useful.
16. The EPO replied that in terms of volume, 1.4 million CN utility models are expected per year. The EPO noted that many CN utility models are being cited in its search reports; the inclusion in the PCT Minimum Documentation was therefore being seen as necessary to maintain the quality of PCT work products in the long run. The EPO noted that the usability of a future extended Minimum Documentation is as important as providing equal access to all patent collections. The EPO added that the Task Force should further consider the question of where to draw the line between ensuring a harmonised high level of quality of PCT work products and ensuring the practicability of new criteria, especially regarding the inclusion or not of utility models. The EPO noted that powerful computer systems can handle a huge quantity of documents to be searched but that some Authorities might not have such tools. In view of the “data storage” issue, the EPO replied that there are two different approaches for searching: (a) loading patent data into its own systems, or (b)

searching the patent data via the systems of third parties (e.g. Espacenet or commercial providers).

17. With regard to the proposal contained in paragraph 15 (a) of document PCT/MD/1/2, the Task Force concluded that:
 - It is desirable to include in the PCT Minimum Documentation the patent collections of all ISAs but further consideration should be given to the practicability of this point (e.g. volumes concerned and usefulness);
 - Proposed new Rule 34 (c)(i) PCT should refer to Rule 36.1 (a)(i) PCT in order to clarify that requirements should be the same for all Offices, being ISAs or not;
 - Offices not being ISAs shall notify the IB that their patent collections are available according to the new technical requirements and expressly request the inclusion of their collections in the PCT Minimum Documentation;
 - With a view to addressing the risk that Offices might use their discretion to put restrictions on what they make available as part of the PCT Minimum Documentation, in principle a clause could be inserted in the Rule indicating that anything that has been made available as part of the PCT Minimum Documentation cannot thereafter be taken out of the PCT Minimum Documentation.
18. The OEPM – Spain recalled the issue of the redundancy of making available all family members; the EPO answered, however, that these might not be identical. Later discussions made it clear that it is not possible for all Offices to identify whether a priority document was available for a given file or not. After some discussions, it was finally concluded that the existence of family members could not be a criterion for excluding some documents from the PCT Minimum Documentation on both substantive grounds (family members are not necessarily identical to the priority) and practical grounds (as this would add some burden on ISAs when preparing Files).
19. Discussions continued with the proposal contained in paragraph 15 (b) of document PCT/MD/1/2.
20. The USPTO questioned the usefulness of adding patent collections that are published in a language which is only used by the providing Authority. The USPTO pointed out that English was the one language which was common to all Authorities for search and examination. The USPTO therefore suggested to include only in the PCT Minimum Documentation documents which are either in EN or have an EN abstract.
21. INPI – Brazil stated that, in particular in some technical fields, the USPTO proposal would lead to the exclusion from the PCT Minimum Documentation of very relevant documents. Hence, INPI – Brazil was not in favour of the USPTO proposal. OEPM-Spain stated that it did not support the USPTO proposal either, and was rather in favour of moving as a principle to the requirement of making available collections in full text, in particular in the light of the increased use in future of machine translations. Indeed, it was considered that EN abstracts alone are not sufficient to help examiners understanding the whole patent document. The EPO noted that the USPTO proposal would lead to excluding DE and FR collections which are quite relevant sources of prior art. In this regard, the USPTO asked whether it is known whether the UK, Germany and France will be willing to fulfil the new requirements proposed by the EPO. It was concluded that the USPTO proposal could be put for further discussion in the wiki and that the EPO will follow this up with the UK, Germany and France.
22. With regard to the proposal contained in paragraph 15 (c) of document PCT/MD/1/2, INPI-Brazil explained that it considers important to include utility model documents in the PCT Minimum Documentation. The USPTO stated that it has the same concerns regarding utility

models as those with patent documents. The USPTO pointed out that utility models are being treated differently in various Offices; some include them for search and examination, others just publish them. A way forward could be limiting to the utility models of these Offices which search and examine them. The OEPM – Spain stated that under Spanish law, utility models are not being searched and examined. However, Spanish SMEs do file them a lot because they are cheaper and SMEs are not necessarily interested in extending the scope of protection to other countries. The quality in terms of technological information of utility models is high (e.g. in shoe manufacturing industry). Spain endorsed the proposal to make utility models part of the minimum documentation since this is a sensitive issue for Spanish industry. The USPTO stated that it is unclear how China is dealing with utility models. Further information from CNIPA should be sought. OEPM-Spain stated that under Spanish law, they get only examined in case of infringement law suits. The EPO pointed out that from an examiner's point of view, it is only relevant that utility models are prior art; the validity is not primarily of interest. The IB stated that many patents are similar to utility models. The EPO reported that only one commercial provider is offering linkage data between utility models and patents without the same priority but with identical contents. Hence, regarding the proposal contained in paragraph 15 (c) of document PCT/MD/1/2, it was concluded that it should be further considered whether all utility models or only a restricted number of them (i.e. the examined ones) or none of them should be included in the PCT Minimum Documentation. Moreover, it was concluded that, if utility models will be included in the PCT Minimum Documentation, any language related requirements which would be applicable to patents should apply to utility models.

23. In addition, CIPO – Canada provided the following comments for further consideration by the Task Force: *“The proposed wording in Rule 34.1 (c)(iii) PCT is in conflict with transitional provisions nor is the wording complete enough to cover the situation of a non-compliant International Authority. Utility models from a particular ISA cannot be made a mandatory part of PCT minimum documentation under Rule 34.1 PCT if Rule 34.1 comes into force before the ISA starts making the documents available for consultation. This situation could be handled in a number of different ways such as including a transitional similar to what is proposed for Rule 36.1(1)(ii) PCT or by limiting Rule 34.1 PCT to apply only in respect of the utility models of an ISA that have been made available for consultation. In other words, the wording, “and made available for consultation”, taken from Rule 36.1(a)(ii) PCT should be added after “by its legal predecessor” so that the two Rules will be in accordance.”*
24. Besides, asked by the EPO, Rospatent – Russia confirmed that inventors' certificates issued by the former Soviet Union are electronically available back to 1920.
25. Regarding the cut-off date as 1920, IPO - India suggested a review of this cut-off year considering that this cut-off was decided based on the discussions in the PCT Interim Committee for Technical Cooperation (PCT/TCO) during the period 1971-1978 before the entry into force of the PCT. This could be reviewed based on data available as to date.
26. With regard to the proposal contained in paragraph 15 (d) of document PCT/MD/1/2 (deletion of the example), this proposal was unanimously supported by the Task Force.
27. With regard to the proposal contained in paragraphs 16 and 17 of document PCT/MD/1/2, the USPTO supported the principle laid down in proposed new Rule 36.1(a)(ii) PCT but that the exact contents of the proposed requirements need to be further clarified. The EPO stated that it has to be further considered how to avoid abusive utilisation of “Publication Exception Codes”. The timeline was considered ambitious in light of the outstanding issues. IPO – India suggested some form of a “grandfather-clause” since it seems feasible for it to meet the new requirements for future data but it would be difficult for it to predict for which parts of its already existing collection the new requirements could be fulfilled. The IB

indicated that it would favour a clear-cut date for the new provisions to enter into force and would prefer avoiding a transitional period of several years.

28. It was concluded that all Offices (present and non-present) should assess for which parts of their patent documentation they will be able to comply with the proposed new technical requirements (in particular the making available in searchable electronic format) and by which date.

29. The Task Force took note of document PCT/MD/1/2 and agreed to follow up the open issues as pointed out in paragraphs 20 to 22, 27 and 28 above via the wiki. The EPO will prepare revised proposals to be posted on the wiki.

Item 3: Objectives B and C: Technical and accessibility requirements for patent and utility model data, including bibliographic and text components of that data

30. Discussions were based on document PCT/MD/1/3.

31. With regard to technical and accessibility requirements, some delegations indicated that the conditions set in the proposals (e.g. paragraph 14 of document PCT/MD/1/3) seemed too ambitious in terms of implementation. Especially, making the complete patent collections available in full text does not seem possible for all Authorities by 2026. The USPTO also stated that the use of "Publication Exception Codes" would need to be carefully regulated in order to ensure transparency and avoid abuse.

32. The IB confirmed that it is willing to take up the new tasks proposed in document PCT/MD/1/3 concerning the repository page and the making available of Authority Files. This was welcomed by the EPO to support the envisaged new concept and also ensure the required level of transparency vis-à-vis Authorities, Offices and the public at large.

33. The EPO indicated that the present proposals are based on the areas of agreement that emerged on this matter after the first discussion round in the wiki in 2018 as well as at the 26th session of the PCT MIA in Cairo. The EPO invited the other Task Force members to examine carefully points (a) to (e) listed in paragraph 9 of document PCT/MD/1/3 and to confirm whether they still support them. Points (a) and (b) are endorsed on the condition that, at the beginning of both points, the words "as a principle" be added, and that at the end of both points, a wording be added to foresee an exception for older collections (the exact extent of this exception will have to be further specified in the PCT Administrative Instructions). Point (e) as set out in the document PCT/MD/1/3 needs to be clarified to ensure that there is no reference to internal search systems implied.

34. The EPO noted that a starting point for making further progress could be that each Authority assesses the current status of its collection on the basis of some of the requirements proposed in document PCT/MD/1/3. More specifically, the EPO invited Authorities to start investigations in their respective collections regarding the availability of the bibliographic data elements listed in paragraph 14 (v) of document PCT/MD/1/3 (sub-points (a) to (d) being mandatory and (e) and (f) being optional in the ST.37), the availability of their collections (or parts thereof) in searchable electronic format, the availability of abstracts (and if they are also available in English or not) and the availability of sequence listings in electronic format (ST.25).

35. The EPO agreed to post a template and examples on the wiki in order to make it easier for Authorities to collect the required information and compare results. Only the summary of the investigation done by each Authority would need to be posted on the wiki in order to have a global view of the Authorities collections today.

36. The question was raised whether the IPC symbols should be part of the information provided. It was agreed to indicate them to the extent that they are available (filings after 1971).
37. With regard to paragraph 14 (viii) of document PCT/MD/1/3, the EPO proposed that the investigation should look into the possibility to provide these optional elements. In view of the recommendation to provide EN abstracts, it was agreed to have this as an optional element added as point (viii)(e) of paragraph 14.
38. The EPO concluded the discussions on this topic by noting that there seems to be general agreement on the fact that, as of the date to be agreed upon for the implementation of the revised Rule 34 PCT, patent documents published from that date onwards would need to comply with the new requirements to be defined (in particular, availability in searchable electronic format). Moreover, a “grandfather clause” could be considered for documents published before that date. The EPO will prepare a respective proposal with a view to having older collections gradually digitalised and thus added to the PCT Minimum Documentation in order to progressively close the gaps.
39. The proposals for Rule changes will be revised by the EPO to distinguish the requirements which would apply to the documents published before the date of implementation of the revised Rules and the ones which would apply to the documents published after that date. Revised draft Rules will be posted by the EPO on the wiki together with the open questions/issues for further consideration in July, providing around three months’ time for Authorities to provide their assessment and comments. The objective remains to submit concrete proposals by end 2019 in order to have them discussed at the next session of the PCT MIA 2020.
40. *The Task Force took note of document PCT/MD/1/3 and agreed to follow-up the issues raised via an investigation by each Office as described in paragraphs 31 to 39 above. A decision will be taken after the results can be compared. The EPO will prepare revised proposals to be posted on the wiki.*

Item 4: Objective D: Criteria and standards for the review, addition and maintenance of non-patent literature and traditional knowledge-based prior art

41. Discussions were based on document PCT/MD/1/4.
42. The USPTO invited the other Offices to briefly explain their practices with regard to the handling of NPL. The EPO pointed out that it provides to applicants copies of cited NPL documents and stores a copy of such documents in its internal computer systems. Moreover, Digital Object Identifiers (DOIs) are captured and cited in search reports, whenever available. As regards the making available for the purposes of file inspection, usually a reference or the DOI is provided. For copyright reasons, if a reference is indeed supplied, this is subject to copyright law (disclaimer).
43. CIPO – Canada stated that, as regards the provision of copies of cited NPL documents, certain PCT provisions overrule national copyright rules and CIPO – Canada provides copies of cited NPL documents on a CD. CIPO – Canada added that in the past it was also sending a CD containing the patent citations. IPO – India explained that in its search reports, it cites NPL and applicants get copies on request and upon payment of an administrative fee, depending on the number of pages. Ukrpatent - Ukraine and IPO – Philippines confirmed that they apply the same practice. Rospatent - Russia provides copies free of charge upon request. INPI – Brazil stated that regarding cited Brazilian TK

documents, they are typically freely available and there are no issues with national copyright provisions. PRH – Finland provides NPL documents with copyright disclaimer. OEPM – Spain provides copies of cited NPL documents to applicants under a copyright exception foreseen for administrative procedures, however, not to third parties.

44. It was noted that all present delegations provide copies of cited NPL documents to applicants. The USPTO announced that it will post on the wiki a spreadsheet with the Office's replies to Circular C. PCT 1544. Such spreadsheet will provide a detailed overview of the various Offices' practices.
45. The USPTO underlined that in the replies to Circular C. PCT 1544, most Offices expressed degrees of concern regarding confidentiality provisions associated with access to databases. The USPTO pointed out that it does not make any distinction between PCT and national practice in terms of accepted confidentiality restrictions. It was noted that using a database with confidentiality restrictions would make the processes more cumbersome and therefore, this could not be implemented by the USPTO.
46. The EPO indicated that it shares USPTO's concerns and position. It does not support the inclusion of providers which prevent sharing of NPL with applicants and other Authorities. OEPM – Spain referred to the requirement that prior art per definition has to be available to the public.
47. IPO – India raised the issue of its Traditional Knowledge Digital Library (TKDL). It was explained that confidentiality provisions are similar to those of any commercial database provider. The Indian government maintains this database and wants to find a balance between (a) ensuring that prior art is not patented, therefore making it available to other Patent Offices for search purposes, and (b) ensuring that Indian indigenous populations benefit from traditional knowledge which they themselves preserved over history. The aim was to avoid misappropriation of this knowledge considering the high cost incurred by the government in revoking a patent. It was noted that documents contained in the TKDL are publicly available via ancient documents but the public does not have access to the TKDL database. However, IPO – India added that, once cited in the patent grant procedure, information from the TKDL database could be made available to applicants and third parties. IPO – India was invited to clarify this issue further. Furthermore, IPO – India mentioned that the special nature of traditional knowledge databases with respect to other NPL had been addressed in the past in the Task Force on PCT Minimum Documentation (the delegation referred to a document from the EPO). Therefore, IPO – India took the view that in the future, such distinction should be made when establishing the criteria for inclusion of TK databases vs. any other item of NPL, as well as considering international agreements and discussions relating to TK.
48. The USPTO stated that its NPL databases are not open for the public to search but that only patent examiners would get access to the documents. The public would only receive a copy if this document is associated with a specific patent.
49. Discussions continued on the template for the TKDL Access Agreement as drafted by the IPO – India (document PCT/MIA/25/9, Annex I). A provision of the said template states that *"the User shall use TKDL information only for the purposes of the patent grant procedure in all its phases including the inspection of files and for no other purpose"* (point (b)(I)). The EPO found that this clause needs to be clarified. Furthermore, it appears from that template (point (b)(II)) that the availability of the documents to the applicants and third parties seems to be restricted to a certain extent (by the terms "whenever required"). Reference was made to countries like China and South Korea which make their traditional knowledge databases available to the public. IPO – India reiterated that it wants to protect its communities who are

earning a living from traditional knowledge and preserve their cultural identity. The USPTO found that the concept of protecting traditional knowledge for the benefit of a certain community to be contradictory with traditional knowledge being part of the public domain.

50. The JPO felt that it was not possible to add TKDL to the PCT Minimum Documentation because it considered it as falling under the umbrella of trade secrets. As a way forward, IPO - India suggested consulting China and South Korea with regard to the practices used by them for the protection of their traditional knowledge. Furthermore, the EPO referred to two Indian Traditional Knowledge journals which are already contained in the PCT Minimum Documentation (Indian Journal of Traditional Knowledge and Medicinal and Aromatic Plant Abstracts) and also retrievable in TKDL database.
51. The next discussion point focused on the question of whether it would be acceptable that the access to contents of the PCT Minimum Documentation could be interrupted in case of an asserted breach of an access agreement. The USPTO reported that strong concerns were expressed in this regard by several Authorities. IPO – India was of the view that commercial providers of NPL already included in PCT Minimum Documentation had similar clauses regarding legitimate use of data for the purposes for which it is subscribed to, consequences on breach of agreement and a termination clause which permitted either party to give a notice for termination. The USPTO expressed its concern that a breach of such agreement would result in the loss of access to the TKDL database, and as such an Authority being in violation of the PCT Regulations. The EPO found such a situation of non-access for Authorities problematic.
52. The USPTO invited the IB to explore in which sense it could support the process relating to NPL (question 16). The IB stated that the list of NPL in the PCT Minimum Documentation is agreed upon by ISAs and published by the IB (Rule 34.1 (b)(iii) PCT). OEPM – Spain stated that it would be helpful if the IB could provide a list of access providers for journals and documents. In that regard, the EPO referred to Objective A, under which the up-to-date list contains URLs as reference points. It was considered a complex task updating such links.
53. Regarding proposal for discussion 1, the USPTO raised the question of whether NPL should be included as requirement in PCT Minimum Documentation or not given the concerns raised in response to the questionnaire. As an alternative, NPL could be listed as recommended resources.
54. CIPO – Canada was concerned that, if NPL would no longer be part of the PCT Minimum Documentation, transparency issues could arise. It was suggested that NPL lists could be annually updated by the MIA. A further question was raised by the USPTO of whether specific titles or characteristics of information should be used. Since the state of NPL is dynamic, the USPTO proposed that characteristics may provide more flexibility for the sake of PCT Minimum Documentation rather than the use of specific titles.
55. The EPO pointed out that it would be a permanent requirement to update any list (reference was made to objective A: the EPO updated the list under this objective and it proved to be a very intense and time-consuming work). The EPO furthermore stated that 10% of all citations at the EPO are NPL, at the USPTO 6%. For the reasons set out above, it was considered to be a difficult objective to have the inclusion of NPL set as a legal requirement for Authorities. It was suggested by the EPO that ISAs put more efforts in increasing the patent documents (objectives A to C) and less effort in terms of NPL. NPL could be taken off as compulsory element and kept as recommendation for ISAs (guidance), open for regular review by MIA. The EPO described its own mechanism applied for non-Minimum documentation NPL: at the end of a contract-renewal cycle, the EPO looks at the citation rate and also in the search record for guidance as to whether a title should be subscribed to

or not. The EPO expressed a concern that a characteristic-based approach would lead to difficulty in confirming whether or not an Authority was in compliance with its legal obligations.

56. IPO – India stated that the proposal for a reference list can be considered after due discussion in the wiki. The data of citations given in the search reports established by the different Authorities could be categorized according to the IPC classification assigned to the patent applications so that this can be used as a reference to find out how frequently journals are cited for a particular technical subject-matter. This will be a guidance for the Authorities to decide on what NPL needs to be subscribed to considering the technical subject-matter contained in the applications they deal with. It also suggested a WIPO portal to facilitate the same in the future. This could be possible as the XML data of some of the major Offices are already available. The Task Force may also explore the possibility of artificial intelligence to suggest useful titles. The EPO noted that to date, only 3 Offices made their search reports available in XML (EPO, KIPO, CNIPA), and that as a result this could not be implemented in an automated manner. The USPTO suggested keeping a “living” list of resources on wiki. It also considered a “hybrid situation” where certain NPL was mandatory (smaller list), and others as a recommendation to ISAs (larger, “living” list).
57. Furthermore, the IB stated that search reports in XML could enable the automatic retrieval and categorisation of NPLs cited. INPI – Brazil raised an issue with regard to the “living” list: It was a lengthy process for the Authority to get access to database providers since the budgetary approval from Congress was needed.
58. As far as Proposal for Discussion 4 is concerned, the USPTO suggested refraining from mentioning commercial databases (which contain collections of documents) in a future revised Minimum Documentation NPL list noting that they generally charge much higher prices for their services once listed in the PCT Minimum Documentation. The EPO took the view that focus should be put on titles (i.e. containing the prior art) rather than the databases. Furthermore, there was consensus that if access to a title or a database listed in the PCT Minimum Documentation is denied to any ISA by a sole provider for whatever reason, that database should not form part of the PCT Minimum Documentation any longer. IPO – India was of the view that any NPL which is published only electronically will also fall under the definition of a database.
59. As regards Proposal for Discussion 5, the EPO was in favour of having independently accessible documents for the public (post citations) in line with the spirit of the patent system which aims at ensuring that the public is informed. Databases which have restricted access to other Offices or to the public should not be part of the PCT Minimum Documentation unless they comply with strict conditions which remain to be agreed upon. This position was endorsed by OEPM – Spain.
60. CIPO – Canada stated that *“PCT Articles 20(3) and 36(4) require ISAs and IPEAs, upon request, to send copies of cited documents to DO/EOs and to applicants but CIPO is not aware of any provisions in the PCT that say anything about sharing cited prior art with the general public. CIPO notes, however, that once DO/EOs obtain documents, they are free themselves to make the documents available to the public in accordance with their national law subject to the confidentiality requirements under PCT Art. 30. From a policy point of view, CIPO believes it is important, at the international and the national level, for any prior art cited in respect of an application to be available to anyone in the general public and to the Courts of judicial proceedings. This is essential information for anyone seeking to evaluate the validity of any patent granted on the basis of the application. CIPO does not see any issue with such access being made subject to payment of reasonable fee. CIPO believes that whether the general public could independently access the content or is forced*

to seek it from the International Authority is not important to consider as far as defining what constitutes the contents of the PCT Min Doc as it relates to NPL. CIPO does believe it is important that any member of the public be able to obtain access anonymously.”

61. Upon request from the EPO and the USPTO, IPO – India stated that it could explore the possibility of providing information regarding the list of titles included in the TKDL on the wiki as soon as possible. Following intensive discussions, the Chair summarised that there were two options regarding the inclusion of databases such as TKDL, namely either (1) listing sources contained in such databases and see whether they could be separately included in the PCT Minimum Documentation together with other titles, or (2) deal with such databases as a specific different item of the PCT Minimum Documentation falling as an exception to the general principle, and thus complying with strict conditions as indicated in paragraph 59, above.
62. It was concluded that the USPTO will work on a new set of proposals taking into account the feedback received so far, and present it to the Task Force in the wiki for further discussion. The timeline for that document will be aligned with the EPO’s documents to be posted with the aim to have the respective documents ready for discussion at the next PCT MIA of 2020 (see paragraph 37).

63. The Task Force took note of document PCT/MD/1/4 and agreed to continue the discussions based on a new set of proposals (see paragraph 62).

Item 4: Conclusions of discussions, report, closing remarks

64. The Chair thanked the participants for the constructive contribution to the discussions. The feedback received during this session’s two days meeting has provided substantial input to help both the EPO as Task Force leader (in particular in view of Objectives B and C), and the USPTO leading Objective D, to prepare further revised documents for review in a second round of discussions in the wiki that will take place this year. All delegations agreed on the need of reviewing the PCT Minimum Documentation, and generally agree with the objectives of the reform. However the issues which have been addressed show that much is still to be done to come to an agreement on how that reform should be. Only once we know about that could we actually agree to the appropriate timeline to implement the necessary Rule changes.
65. The Chair concluded by wishing the participants a safe journey back to their respective home countries and encouraged them to participate actively to the coming round of discussions in the wiki. This call for active participation is of course also addressed to Authorities which could not attend the present meeting.

[Annex (to Appendix) follows]

ANNEX

List of participants

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