

Patent Cooperation Treaty (PCT) Working Group

Fifth Session
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PCT MINIMUM DOCUMENTATION: DEFINITION AND EXTENT OF PATENT LITERATURE

Document prepared by the International Bureau

SUMMARY

1. The International Bureau wishes to propose a modification to PCT Rule 34 which would enable any PCT Contracting State, as of right, to have its national patent documentation (in a broad sense, including other forms of protection for inventions, such as utility models) considered part of the PCT minimum documentation, provided that it makes that documentation available in a specified electronic format, which would be set out in the PCT Administrative Instructions.
2. The Meeting of International Authorities has agreed to set up a task force to study the technical issues involved. The Working Group is invited to comment on the principles and to identify additional issues to be taken into account in developing a suitable proposal.

BACKGROUND

3. At present, subject to certain limitations, such as reducing the need to keep multiple versions of essentially the same disclosure, the PCT minimum documentation is made up of:
 - (a) certain national patent documents (Rules 34.1(b)(i) and (c) to (e));

- (b) all published international and regional patent documents (Rule 34.1(b)(ii)); and
 - (c) non-patent literature, as agreed on by the International Searching Authorities collectively (Rule 34.1(b)(iii)).
4. The national patent documents in turn are divided into two types:
- (a) a list of States and specific types of documentation (for example, patents, patent applications, inventor certificates, utility certificates) from these States (Rule 34.1(c)(i) to (v)); and
 - (b) a list of languages (currently English, French, German and Spanish), whereby patent documents in those languages can automatically become part of the minimum documentation if the relevant Offices sort out the applicable documents and make them available to the International Searching Authorities (Rule 34.1(c)(vi)).
5. The original States and languages in Rule 34.1(c) represented a useful enumeration of the *de facto* sets of readily available and regularly updated patent collections which existed at the time, as well as what would be practical for International Authorities to deal with in a paper search collection. These have been updated over time to recognize certain large new collections which have been made available in electronic form. However, the International Bureau believes that the Rule does not meet the needs of the patent system today in several respects:
- (a) It discriminates between States which must specifically request the Assembly to add their documentation by amendment to Rule 34.1 and those publishing in certain languages which can have their documentation added to the minimum documentation automatically when made available to International Searching Authorities. In view of advances in searching technology and increased diversity in linguistic skills among International Searching Authorities this distinction no longer appears to be of relevance.
 - (b) The fact that there is no right for a PCT Contracting State to have its documentation included in the PCT minimum documentation could reduce the incentive for States to make this documentation readily available. In such cases, the value of the disclosure aspect within the international patent system is reduced.
 - (c) The system does not in fact allow the exact extent of the minimum documentation to be readily determined for two reasons. First, there is no requirement for a national Office to notify the International Bureau that it is making its collection available to International Searching Authorities (it is believed that the collections of Australia, Austria, Canada and Switzerland are made available under Rule 34.1(c)(vi), but it is possible that other collections have also been made available). Second, there is no complete and reliable inventory of patent documents for the relevant countries to allow International Searching Authorities to determine whether their collection is complete (part 4.1 of the *WIPO Handbook on Industrial Property Information and Documentation*¹ performs this function in part, but it has not been updated since November 2001 and even then listed only number ranges which had been used, without documenting gaps in the numbering).
 - (d) Utility models are not currently included in the PCT minimum documentation (Rule 34.1(a)) despite these documents representing an important and increasing body of prior art.

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<http://www.wipo.int/standards/en/pdf/04-01-01.pdf>

POLICY GOALS

6. The International Bureau considers that any review of PCT Rule 34 should promote several goals:

- (a) to improve the quality of international search, which is supposed to reliably discover information on any prior art which could be relevant to the novelty or inventive step of an international application according to the national laws of any PCT Contracting State;
- (b) to encourage national Offices (where appropriate, with the assistance of the International Bureau or other partners) to make their patent collections available in a consistent electronic form, which can be readily incorporated into patent databases, including regular updates with new publications, both to allow more effective patent searches by International Searching Authorities and national Offices and to improve the disclosure of technology to third parties.
- (c) to allow International Searching Authorities more easily to determine the scope of the PCT minimum documentation in order to ensure that their search collections are complete.

7. Very similar goals could also be applied to the question of non-patent literature. However, it is suggested that Member States consider the issue of patent documentation separately since the publication and availability of the relevant documents is under the control of the Member States themselves and improvements can therefore be made more directly.

PROPOSED WAY FORWARD

8. The International Bureau would therefore like to propose, in the near future, a new definition for the patent documentation part of the PCT minimum documentation, based on the general principle that it should include patent documents (including utility models and other forms of protection for invention) equally from all PCT Contracting States, or former States of which a successor is a PCT Contracting State, irrespective of language, provided that the relevant documentation was made available in a specified electronic form.

9. To make searching practical and efficient, there would then be exceptions to what International Searching Authorities would be required to search, of the same general nature as present in Rules 34.1(d) and (e), allowing International Authorities to decide how best to deal with:

- (a) searching patent families where essentially the same disclosure is made in several different Contracting States, potentially several times each (for instance, as a published application and a granted patent); and
- (b) disclosures in languages which are not an official language of the Authority and for which no English language abstract is available (though the Rule should itself also at least encourage the availability of high quality abstracts).

CONSIDERATION BY THE MEETING OF INTERNATIONAL AUTHORITIES; TASK FORCE

10. Based on a working document prepared by the International Bureau, the issue of a possible revision of Rule 34 was discussed at the 19th session of the Meeting of International Authorities Under the PCT, held from February 8 to 10 in Canberra (see document PCT/MIA/19/7).

11. While noting a number of difficulties with some of the specific details of the arrangements set out in the document by way of example, the Meeting broadly approved the direction of the proposals and agreed to set up a task force to identify the technical requirements of standards which would be needed to allow International Authorities to upload new collections of patent documents into their search databases effectively and to audit the documentation involved, as well as identifying and addressing other challenges, such as ensuring that all the relevant documentation is classified effectively (paragraph 31 of document PCT/MIA/19/13).

FURTHER WORK

12. The International Bureau hopes to bring a specific proposal forward for discussion by the Working Group for its meeting in 2013. At present, it would welcome comments on the general principles set out in paragraphs 6 to 9, above, and on what further matters should be taken into account by the task force referred to in paragraph 11, above, or by the International Bureau in developing appropriate proposals for amendment of Rule 34.

13. *The Working Group is invited to:*

(i) comment on the principles set out in paragraphs 6 to 9 of this document; and

(ii) identify issues which should be considered by the task force referred to in paragraph 11 or by the International Bureau in developing proposals to give effect to those principles.

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