

Patent Cooperation Treaty (PCT) Working Group

Sixth Session
Geneva, May 21 to 24, 2013

PCT MINIMUM DOCUMENTATION

Document prepared by the International Bureau

SUMMARY

1. The present document contains a progress report of the issues currently under discussion in the task force set up to prepare a detailed draft of all technical specifications relating to the proposal to amend PCT Rule 34 so as to make it a right for PCT Contracting States to have the patent documentation published by their national Offices included as part of the PCT minimum documentation, provided that it is made available reliably in a specified electronic format which is easy for International Authorities to load into their databases.

BACKGROUND

2. At the 19th session of the Meeting of International Bureau and the fifth session of the PCT Working Group, the International Bureau presented documents (PCT/MIA/19/13 and PCT/WG/5/16) suggesting the concept of amending Rule 34 to automatically include the national patent documentation of any PCT Contracting State as part of the PCT minimum documentation, provided that it was made available reliably in a suitable electronic format which would be easy for International Authorities to load into their databases.

3. The aim of this initiative was to improve the availability of technical information from patent documents, both in terms of the technical coverage and linguistic coverage and, as a result, to help improve the quality of international search.

TIMETABLE

4. Subject to comments on various details, the Meeting and Working Group agreed with the principle of this initiative and a task force was established to consider the details. The 20th session of the Meeting of International Authorities endorsed the following timetable as a guide to the necessary work.

- (a) Q1-Q2 2013: Task force to prepare first detailed draft of all technical specifications;
- (b) Q3 2013: Technical review by International Authorities and the International Bureau of their ability to generate data in the relevant formats, the likely ability of other Offices to generate data in the relevant formats and the ease with which such data can be loaded into search databases;
- (c) Q4 2013: Task force to finalize proposed technical specifications and preparation of recommendations on related principles (such as the time which should be permitted by the Rule between new collections being found to meet the requirements to be part of the minimum documentation and the expectation that the documents will be searchable in an International Authority's database);
- (d) Q1 2014: Consideration by the Meeting of International Authorities;
- (e) Q2 2014: Specific proposal to the PCT Working Group;
- (f) Q3 2014: Proposal to the PCT Assembly.

SUBJECTS UNDER CONSIDERATION BY THE TASK FORCE

5. The International Bureau wishes to propose a system which encourages patent Offices to make as much of their patent document collection as possible available in formats which allow the technical information to be searched and read in as many languages as possible, thereby enabling international searches to be as effective as possible. The initial assumption is that this would best be achieved by allowing an automatic right for Offices to have their patent documents included in the minimum documentation, subject to them making the documents available in a suitable electronic format. However, expert advice is required on various issues concerning importing documents into search databases and using it effectively for searching.

6. The task force is considering issues in four general areas, as follows.

General Principles

7. The specific questions under discussion in the task force are as follows:

- (a) Should there be an absolute right to having a collection included provided that the appropriate technical conditions are met?

As noted above, the International Bureau believes that this would, in principle, be the best way to encourage Offices to make the investment necessary to make their patent document collections available. However, Authorities have pointed out the importance of ensuring certainty that the documentation is in fact provided in the correct formats and that newly published documents will continue to be made available reliably. Some Authorities have also noted the importance of ensuring that the Assembly is adequately informed of new collections being added and retains the appropriate degree of control of what is included.

(b) Should it be possible to add collections from Offices other than those of the PCT Contracting States? If so, should this be under the same conditions?

So far, discussions suggest that there would be no advantage in distinguishing between collections published by the Offices of PCT Contracting States and by any other Office.

(c) Should the collections be time limited in any way?

Discussions so far suggest that it would be desirable to include patent documents published prior to 1920 to the extent that the relevant Office was prepared to make them available in an acceptable format.

(d) Should it be permitted for a collection to be made available by an Office other than that which published it?

As far as possible, it seems preferable that collections be made available by the Office which originally published them (or by another party at that Office's specific request where digitization has been done with the assistance of a partner Office or organization). However, it is clear that special cases will be required at least in the case of Offices of successor States to former States.

(e) What period should be allowed for ISAs to add a new collection to their database?

This is a question which can only be resolved once the relevant formats have been agreed and the impact of loading data from them properly assessed.

Availability of Patent Collections

8. The specific questions under discussion in the task force are as follows:

(a) What should be the minimum bibliographic information provided for each patent publication to be included in the minimum documentation? What additional information is desirable?

Discussions so far have focused on the importance of full text information and abstracts, especially where documents are in languages which go beyond those currently envisaged by PCT Rule 34 as it applies to any particular International Authority. In addition, a "grandfather clause", aimed at ensuring that existing parts of the minimum documentation are all retained, should have sufficient scope to cover gazettes and related documentation as well as patent documents as such.

The International Bureau considers that the task force will need to give additional consideration to the best balance between seeking maximum inclusion of data which may be useful for searching and family matching, and encouraging maximum availability of technical information provided that there is sufficient information given to permit some degree of searching. It may be necessary to have different standards for new and recent patent documentation (for which it is reasonable to expect full text and detailed bibliographic data to be provided) and very old documents, where some of the bibliographic data may be lost or else the work involved in digitizing it in full would not be proportionate to the benefits for searching and information dissemination.

(b) What format(s) should be accepted for the required information?

The proposals currently under discussion suggest broad compatibility with WIPO Standard ST.36 and Annex F of the PCT Administrative Instructions, but there has so far been little analysis of exactly how the formats should be defined.

(c) How should the information be made available to ISAs and relevant database providers?

It will be necessary to reach consensus on the formats required and the means by which updates would be provided before finalizing this point, but it seems likely that the information would be made available using FTP or SFTP from one or more servers run by or notified to the International Bureau.

Documenting Patent Collections

9. To ensure that search collections are complete, it is important to know the exact extent of patent document collections. The inventory of patent documents in the PCT minimum documentation published by the International Bureau is out of date and lists only ranges of numbers without indicating exactly which numbers were used.

10. The specific questions under discussion in the task force are as follows:

(a) Should a complete inventory of patent documents included in the PCT minimum documentation be made and regularly updated?

The International Bureau believes that it is important to ensure a reliable, up-to-date inventory of documents.

(b) If so, what format should the information be provided in?

A similar stocktaking is under way in the context of the IP5 cooperation (the Offices of China, Japan, the Republic of Korea and the United States of America, and the European Patent Office). The file format being used in that exercise has been offered for evaluation to determine whether it would be appropriate also in this context.

(c) At what frequency should the information be updated?

The International Bureau would prefer the information to be updated at the same time that new publications are first made available to the International Searching Authorities, but a lower frequency could be acceptable as long as this was reliably done at least once a year.

Exceptions to Inclusion or Search

11. At present, International Authorities are permitted to exclude documents which are in principle part of the PCT minimum documentation from their search collections for two reasons:

(a) Where an Office publishes a particular application more than once (for example, as a published application and a granted patent), only one version need be kept.

(b) Where a patent document is published in Chinese, Japanese, Korean, Russian or Spanish, an International Authority which does not have the relevant language as one of its official languages may exclude the document from its collection if there is no English language abstract available.

12. Exclusions of these general types may remain important for conducting an efficient search, avoiding spending examiners' time looking at multiple versions of effectively the same disclosure or in looking at text in languages which they cannot understand. However, it may be desirable to revise the details to take account of the likely increase in range of languages which will form part of the minimum documentation, the issues concerning database design and storage compared with maintaining a paper search collection, and the development of technologies for assisting searches across publications in different languages.

13. The specific questions under discussion in the task force are as follows:

(a) What exceptions should be made to the International Authorities' requirement to maintain access to the full range of documents which is made available for the purposes of the PCT minimum documentation?

(b) What exceptions should be made to the International Authorities' requirement to search all the documentation within the PCT minimum documentation?

(c) How do the answers to questions (a) and (b) relate to the manner in which your Office's search systems are maintained and function at present, or else developments which are expected to be put in place within the next few years?

14. The Working Group is invited to note the contents of this document.

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