

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

**Twentieth Session
Munich, February 6 to 8, 2013**

PCT MINIMUM DOCUMENTATION

Document prepared by the International Bureau

SUMMARY

1. The International Bureau would like to propose an amendment to PCT Rule 34 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.
2. A task force has been set up to consider the various technical issues involved, but has not yet reached conclusions in any of the areas.

BACKGROUND

3. 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.
4. 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.
5. 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.

SUBJECTS UNDER CONSIDERATION BY THE TASK FORCE

6. The task force is considering issues in four general areas, as follows (the specific questions which are under discussion are shown in italics).

General Principles

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

7. Discussion in the task force so far suggests that it may be acceptable to add collections without individual specific decisions by the PCT Assembly, subject to there being confidence that the International Bureau is able to make sufficient checks on the compliance of the data with the specified technical formats and finding an appropriate level of confidence that the data will be properly updated regularly. This will likely mean that one technical condition will be that not only is the backfile available, but also that several periodic updates have been made in a timely manner before the collection is formally included into the minimum documentation.

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?

8. So far, the only comment made on this point was that the aim was to improve searching and increase availability of data and that no advantage could be seen in distinguishing between collections published by the Offices PCT Contracting States and by any other Office.

Should the collections be time limited in any way?

9. Again, the only comment on this point suggests 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.

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

10. In general, comments made suggest that it was 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.

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

11. 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

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

12. 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, as well as the need to ensure that 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.

13. 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 very 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.

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

14. 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.

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

15. 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

16. A project to document the patent collections of the State Intellectual Property Office of the People's Republic of China, the European Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, and the United States Patent and Trademark Office is under way in those Offices as part of the "IP5" cooperation. The International Bureau has requested the IP5 Offices to use their proposed file format as the basis of discussions within the task force on how to go about ensuring that International Authorities are able to identify any documents missing from their existing search collections and ensure that new publications are all properly loaded as they become available.

Exceptions to Inclusion or Search

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?

17. 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.

18. 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, as well as to take account of the issues concerning database design and storage compared with maintaining a paper search collection.

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

How do the answers to questions 1 and 2 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?

19. One possible option to be considered is that limitations on the scope of the collection which needs to be available to an International Authority should be reduced to cover only cases of clear duplicate disclosures within a patent family and instead to place limitations on the extent to which documentation of certain types (notably, dependent on the language of the document or abstract) needs to be searched by a particular International Authority.

20. The approach decided will need to take into account not only the type of searching which is done today, but the extent to which searching systems are expected to develop in the foreseeable future, especially in relation to the use of bulk machine translation or cross-lingual search tools to assist search of documents in languages not spoken by the examiner conducting the search.

NEXT STEPS

21. The discussions in the task force have not reached the stage where it is likely that a concrete proposal can be discussed by the PCT Working Group at its sixth session, expected to be held from May 21 to 24, 2013. The International Bureau suggests the following timetable as a guide to further 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.

22. The time which would be required before any Rule change came into force would be a further matter to be recommended by the task force.

23. *The Meeting is invited to comment on:*

- (a) *any of the issues set out in paragraphs 6 to 20, above; and*
- (b) *the proposed approach to further work on this subject set out in paragraphs 21 and 22, above.*

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