

## **Patent Cooperation Treaty (PCT) Working Group**

**Tenth Session**  
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### **PCT MINIMUM DOCUMENTATION: STATUS REPORT**

*Document prepared by the European Patent Office*

#### **SUMMARY**

1. This document reports on the PCT Minimum Documentation Task Force ("the task force"), and, in particular, outlines the methodology and work plan of activities foreseen for 2017 and 2018, based on a high level position paper by the European Patent Office (EPO) in its role as task force leader.

#### **BACKGROUND**

2. In 2005, the Meeting of International Authorities (MIA) decided to set up a task force, under the leadership of the European Patent Office (EPO), 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 (see paragraphs 9 to 12 and 18 of document PCT/MIA/11/14). However, the process stalled in view of the lack of consensus on certain issues (see document PCT/MIA/13/5).

3. In 2012, the MIA decided to set up a task force with the aim of extending and updating the scope of the patent literature part of the PCT minimum documentation (see paragraphs 79 to 81 of document PCT/MIA/19/14, and Circular C. PCT 1359, dated September 28, 2012). Since then, the task force has operated using a dedicated electronic forum (hereinafter "the wiki") facilitated by the International Bureau. However, the process was put on hold pending the outcome of the work on setting up prior art documentation standards being carried out within the

context of the IP5 cooperation scheme (the IP Offices of China, Japan, the Republic of Korea and the United States of America, and the European Patent Office) (see document PCT/MIA/21/12).

4. In 2015, following the publication of "authority files" within the context of the IP5 cooperation scheme, the MIA decided to reactivate the task force, with the International Bureau as task force leader pending the appointment of an International Searching Authority (ISA) in its place (see paragraphs 62 to 65 and 73 of document PCT/MIA/22/22). Little progress was made in 2015.

5. In January 2016, there was again consensus at the MIA to reactivate the task force and the International Bureau invited one of the ISAs to replace it. The MIA invited the task force to resume its work on the basis of document PCT/MIA/23/5 (see paragraph 63 of document PCT/MIA/23/14), and "to recommence its discussions on the addition of databases, including traditional knowledge databases, to the PCT minimum documentation of databases, as set out in document PCT/MIA/12/6" (see paragraph 85(a) of document PCT/MIA/23/14). Also, following India's request that the Indian Traditional Knowledge Digital Library database (TKDL) be included in the PCT minimum documentation (see document PCT/MIA/23/10), the MIA invited the Indian Patent Office "to submit a detailed working document to the Task Force, including a revised draft of the access agreement, setting out its proposals with regard to the inclusion of the Indian TKDL into the PCT minimum documentation, taking into account previous discussions in the Meeting, the Task Force and the IGC, as well as the discussions held at the present session of the Meeting" (see paragraph 85(b) of document PCT/MIA/23/14). Finally, the MIA invited the International Bureau "to work closely with the Indian Patent Office in the coming months with a view to moving the issue forward, where appropriate by means of informal consultations and written communications, such as PCT Circulars, to ensure proper preparation of the discussions to be held at the next session of the Meeting in 2017" (see paragraph 85(c) of document PCT/MIA/23/14).

6. In February 2016, the EPO responded positively to the call of the International Bureau and agreed to (once again) lead the task force on the basis of the mandate given by the MIA.

### **AGREED OBJECTIVES**

7. Since 2005, the overarching objective of the task force has been to examine all factors relating to the maintenance and revision of the list of patent and non-patent literature collections belonging to the PCT minimum documentation, and to recommend objective criteria that patent and non-patent literature collections, in both paper and electronic formats, must adhere to in order to be considered for inclusion in the PCT minimum documentation.

8. The mandate given to the task force (see paragraph 9 of document PCT/WG/9/22), as noted by the PCT Working Group in May 2016, is as follows:

(a) Clarify the extent of the existing PCT minimum documentation, in view of the fact that the WIPO Handbook on Industrial Property Information and Documentation is outdated, the definition and extent of patent literature having last been revised in November 2001, and the definition and extent of non-patent literature having last been revised in February 2010.

(b) Make recommendations and draft standards which are reasonable for national offices to adhere to in order to have their national collections included in the PCT minimum documentation, and allow International Authorities and database providers to easily load the necessary information in a timely and reliable fashion. The question of whether utility models should also form part of the minimum documentation shall also be examined.

- (c) Propose clearly-defined components of patent data that should be present in all patent collections belonging to the minimum PCT documentation list (for example, bibliographic data, abstracts, full text, facsimile images, classification data), as well as the quality and dissemination criteria such data must adhere to, in order to improve searchability and facilitate data exchange between patent offices and commercial database providers.
- (d) Define the criteria necessary for a patent collection to become part of the PCT minimum documentation and the extent to which Authorities should be expected to include and search documents where they are in different languages or have equivalent technical disclosures to other patent documents.
- (e) Improve the availability of technical information from patent documents, in terms of the technical and linguistic coverage of the documents, and of the searchability of the information contained. This will further improve the quality of international searches, and ensure better access to patent information for third parties.
- (f) Make recommendations and propose mechanisms for reviewing and maintaining the non-patent literature part of the PCT minimum documentation, by taking into consideration factors such as:
- (i) practicable access to periodicals, including their availability in electronic form;
  - (ii) the range of fields of technology covered by periodicals;
  - (iii) access conditions applicable to periodicals, including cost and text searchability.
- (g) Recommend criteria for the inclusion of non-patent literature in the PCT minimum PCT documentation, and in particular, conditions under which traditional knowledge-based prior art should be included. Moreover, the task force should work with the Indian authorities after receiving their revised detailed proposals for inclusion of the TKDL database in the PCT minimum documentation.

## **AGREED METHODOLOGY AND WORK PLAN**

9. The task force conducts its discussions using the wiki. As task force leader, the EPO prepares and submits discussion papers for consideration of the other task force members, and coordinates the discussions through a set of "discussion rounds". The EPO also sets deadlines for comments, and shapes the activities so that concrete proposals from the task force could be presented to the future sessions of the MIA and of the PCT Working Group.

10. In December 2016, the EPO posted in the wiki a high level position paper on the activities of the PCT Minimum Documentation Task Force foreseen in 2017-2018 (see Appendix to document PCT/MIA/24/4). In this position paper, due to the interrelated nature of the seven objectives listed above under paragraph 9, the EPO proposed, for the sake of efficiency, that some of these objectives be grouped in view of being tackled by the task force, as follows:

- 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 TKDL.

11. In the above mentioned position paper, the EPO proposed to lead the discussions on objectives A, B and C and invited one of the task force members to lead the discussions on objective D.

12. The work plan proposed by the EPO found the support of the task force members and of the MIA. The United States Patent and Trademark Office (USPTO) offered to lead the fourth objective and this was very appreciated by the MIA (see paragraphs 71 and 72 of document PCT/MIA/24/15).

13. According to the agreed work plan, the EPO will lead the discussions on objectives A, B and C and the USPTO on objective D. In April, the EPO will post a first discussion paper on objective A and looks forward to receiving feedback on the wiki.

*14. The Working Group is invited to take note of the contents of the present document.*

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