

Patent Cooperation Treaty (PCT) Working Group

**Eleventh Session
Geneva, June 18 to 22, 2018**

PCT MINIMUM DOCUMENTATION: STATUS REPORT

Document prepared by the European Patent Office

SUMMARY

1. This document reports on the activities carried out by the PCT Minimum Documentation Task Force ("the Task Force") in 2017-2018 and on its tasks for 2018.

BACKGROUND

2. In January 2016, there was consensus at the Meeting of International Authorities (MIA) to reactivate the Task Force and the International Bureau invited one of the International Searching Authorities (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, 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).

3. In February 2016, the European Patent Office (EPO) responded positively to the call of the International Bureau and agreed to lead the Task Force on the basis of the mandate given by the MIA (document PCT/MIA/23/14).

AGREED OBJECTIVES

4. 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.

5. 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

6. 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.

7. 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 5, 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.

8. 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.

9. The work plan proposed by the EPO found the support of the Task Force members and of the MIA (document PCT/MIA/24/15). 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).

STATE OF PLAY

10. The discussions on Objective A began in April 2017. They focused on revising the lists of both the patent and non-patent literature publications belonging to the PCT Minimum Documentation. Both lists were extensively reviewed, modified and expanded to bring their contents up-to-date and in line with Rule 34.1.

11. Following active participation and contribution by Task Force members, in the last quarter of 2017, the up-to-date inventory of the current PCT Minimum Documentation was finalized by the EPO and accepted by the Task Force members as the baseline upon which further improvements can be made, thereby meeting Objective A.

12. During the first round of discussions on Objective A, two issues emerged that need to be tackled with high priority. First, in view of the definition of the patent literature part of the PCT Minimum Documentation contained in Rule 34.1, it is difficult to determine the exact scope of the patent collections belonging to the PCT Minimum Documentation. This is because even though Rule 34.1 explicitly mentions 16 patent collections as being part of the PCT Minimum Documentation, it also allows for first filings from other national patent collections to be considered part of the PCT Minimum Documentation, as long as they are published in English, French, German or Spanish, “provided that the national Office of the interested country sorts out these documents and places them at the disposal of each International Searching Authority”. However, the latter condition is not very precise. Moreover, for any ISA whose official language, or one of whose official languages, is not Chinese, Japanese, Korean, Russian or Spanish, Rule 34.1(e) explicitly excludes from the PCT Minimum Documentation “those patent documents of the People’s Republic of China, Japan, the Republic of Korea, the Russian Federation and the former Soviet Union as well as those patent documents in the Spanish language, respectively, for which no abstracts in the English language are generally available”. This means that the list of patent collections belonging to the PCT Minimum Documentation varies according to the official language(s) of the ISA. This language-based variability makes it difficult to establish a comprehensive list of patent collections belonging to the PCT Minimum Documentation and has triggered several suggestions from members of the Task Force to relax the language-based requirements in Rule 34.1.

13. The second issue that needs to be resolved with high priority relates to utility models. Indeed, currently Rule 34.1 only explicitly mentions the utility models of France as being part of the PCT Minimum Documentation but there are several other significant utility model collections that are important sources of relevant prior art. Options that should be explored comprise whether to include other utility model collections in the PCT Minimum Documentation (thereby increasing the burden on ISAs who have to acquire, search and possibly translate more documents than today), or whether to exclude all utility models collections from the PCT Minimum Documentation.

14. These two issues will be tackled during the discussion rounds on Objectives B and C starting in the course of 2018. Since Objectives B and C are closely interrelated, they will be tackled at the same time. With regard to Objective C, the Task Force will examine if the recently announced Authority File Standard ST.37 can be used to facilitate describing the contents of those patent collections belonging to the PCT Minimum Documentation.

15. At the twenty-fifth session of the MIA, which took place from February 21 to 23, 2018, Authorities noted with approval “that significant progress had been made on identifying many of the issues involved in improving what was currently an extremely complicated situation of how patent documents belonged to the PCT minimum documentation” (see paragraph 63 of document PCT/MIA/25/13, reproduced in the Annex to document PCT/WG/11/2).

16. Finally, with regard to Objective D, as per the work plan (see Appendix to document PCT/MIA/24/4) it is foreseen that the USPTO should launch the discussion rounds in the course of 2018. At the twenty-fifth session of the MIA, the USPTO indicated “that it would shortly submit a survey to Authorities relating to the use of non-patent literature for search, including issues of source, modality of search, language issues, use of abstracts, conditions on sharing the citations and other types of restriction which may apply” (see paragraph 66 of document PCT/MIA/25/13, reproduced in the Annex to document PCT/WG/11/2). Moreover, the Indian Patent Office reiterated its request that the TKDL be added to the PCT minimum documentation

and submitted a revised TKDL Access Agreement together with a detailed working document for consideration by the Task Force (document PCT/MIA/25/9). In that regard, "Authorities reaffirmed their view that the TDKL represented a valuable source of information for search of patent applications in various fields of technology. Nevertheless, they added that further work on the principles of non-patent literature in the PCT minimum documentation needed to be completed by the Task Force before it could be added" (see paragraph 70 of document PCT/MIA/25/13, reproduced in the Annex to document PCT/WG/11/2). Moreover, the Indian Patent Office was advised to post in the wiki any document to be considered by the Task Force.

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

[End of document]