

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

**Fourteenth Session**  
**Geneva, June 14 to 17, 2021**

### **PCT MINIMUM DOCUMENTATION TASK FORCE: STATUS REPORT**

*Document prepared by the European Patent Office*

#### **SUMMARY**

1. With a view to undertaking a comprehensive review of the PCT Minimum Documentation, since 2017, the PCT Minimum Documentation Task Force (“the Task Force”) follows the work plan endorsed by the Meeting of International Authorities under the PCT (MIA) in early 2017. In that work plan, the Task Force’s work has been divided in four objectives referred to as Objectives A, B, C and D (Appendix to document PCT/MIA/24/4). The work on Objectives A, B and C is being led by the European Patent Office (EPO) and the work on Objective D is being led by the United States Patent and Trademark Office (USPTO). Objective A was already achieved in the last quarter of 2017. Since 2018, the Task Force is working on Objectives B, C and D. The discussions soon revealed that Rules 34 and 36 would need to be amended.

2. Usually, the Task Force conducts its work using an electronic forum made available by WIPO (“the wiki”). In addition, where felt appropriate to facilitate progress in the discussions, the Task Force meets either physically or virtually. The first meeting of the Task Force took place on May 21 and 22, 2019 at the EPO’s headquarters in Munich. Due to the COVID-19 pandemic, the second meeting of the Task Force took place by videoconference from December 7 to 11, 2020 (two hours each day). For the same reason, the third meeting of the Task Force will take place by videoconference from May 17 to 21, 2021 (two hours each day).

#### **BACKGROUND**

3. In 2005, the MIA decided to set up a Task Force 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 (document PCT/MIA/11/14). However, due to various reasons the process stalled for several years. In January 2016, there was consensus at the MIA to reactivate the Task Force and the International Bureau invited one of the International Searching Authorities (ISAs) to take up the role of Task Force leader. In February 2016, the EPO responded positively to the call of the International Bureau and, thereafter, the Task Force was reactivated under the lead of the EPO.

4. Since 2017, the Task Force follows the work plan endorsed by the MIA in early 2017 with a view to achieving the following four objectives (Appendix to document PCT/MIA/24/4):

- 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 the Indian Traditional Knowledge Digital Library database.

5. Usually, the Task Force conducts its work using the wiki. In addition, where felt appropriate to facilitate progress in the discussions, the Task Force meets either physically or virtually. The discussions on Objectives A, B and C are being led by the EPO and the discussions on Objective D are being led by the USPTO.

## **STATE OF PLAY**

6. The discussions on Objective A were successfully concluded by end 2017, i.e. when the up-to-date inventory of the current PCT Minimum Documentation was adopted by the Task Force members. The up-to-date inventory of the non-patent literature part of the PCT Minimum Documentation was published on October 30, 2020 by the International Bureau on the WIPO website and the up-to-date inventory of the patent literature part should be published soon. Since 2018, the Task Force is working on Objectives B, C and D through a series of discussion rounds in the wiki.

7. With regard to Objective B, the first discussion round focused on addressing two main issues, namely:

(a) The first issue relates to the language-based criteria currently contained in Rule 34.1 which give rise to the following situation:

- the national patent collections of some ISAs do not belong to the PCT Minimum Documentation;
- the contents of the PCT Minimum Documentation vary depending on the ISA's official language(s) and the availability of English abstracts; and
- the patent literature part of the PCT Minimum Documentation is limited to patent documents published in a limited number of languages.

(b) The second issue relates to utility models. Currently, Rule 34.1 explicitly mentions the utility certificates of France as being part of the PCT Minimum Documentation, but omits significant utility model collections that are important sources of relevant prior art.

8. With regard to Objective C, the first discussion round focused on examining whether the Authority File Standard ST.37 could be used to facilitate describing the contents of patent and utility model collections belonging to the PCT Minimum Documentation.

9. With regard to Objective D, the first step was the preparation by the USPTO of a questionnaire directed to the PCT International Authorities regarding their use of non-patent literature and traditional knowledge-based prior art sources and databases in their prior art searches. The questionnaire also addressed updates and additions of non-patent literature and traditional knowledge information and databases to the list of PCT Minimum Documentation, the requirements for such databases to be useable by the International Authorities, possible problems in utilizing those databases and questions regarding potential confidentiality and other requirements attached to the use of those databases. The International Bureau sent the questionnaire to the International Authorities on July 9, 2018 in Circular C. PCT 1544.

10. At the twenty-sixth session of the MIA on February 13 and 14, 2019, the EPO presented in the Task Force's status report (document PCT/MIA/26/8) the conclusions that could be drawn from the first discussion rounds on Objectives B and C. The USPTO presented in an Annex to that report some preliminary observations on the replies to the questionnaire contained in Circular C. PCT 1544 (Annex IV to document PCT/MIA/26/8). Authorities welcomed the progress that had been made in all areas, discussed the Task Force's status report (document PCT/MIA/26/8) and made several comments on issues related to Objectives B, C and D (paragraphs 74 to 83 of document PCT/MIA/26/13). The EPO drew the attention to the fact that the outstanding details in Objectives B and C were complex and finalizing them through the electronic forum could be slow and difficult and, therefore, suggested to convene a physical meeting of the Task Force where the experts could meet face to face (paragraph 75 of document PCT/MIA/26/13).

11. Following the above suggestion from the EPO, the first session of the Task Force took place on May 21 and 22, 2019 at the EPO's headquarters in Munich. At that session, the EPO presented proposals aiming at updating and streamlining the definition of the patent literature part of the PCT Minimum Documentation (documents PCT/MD/1/2 and PCT/MD/1/3). More specifically, document PCT/MD/1/2 contained proposals for amendments of Rules 34 and 36, and document PCT/MD/1/3 proposals for the technical and accessibility requirements for which the proposed revised Rules refer to the PCT Administrative Instructions. The USPTO reported on the replies to the questionnaire contained in Circular C. PCT 1544, summarized some of the recurring themes noted in the replies and proposed several questions for additional discussion (document PCT/MD/1/4). That two-day session allowed the Task Force members to have constructive discussions and provided substantial input for making further progress. All delegations agreed on the need of reviewing the PCT Minimum Documentation, and generally agreed with the objectives of the reform. However, the issues that have been addressed showed that much had still to be done to come to an agreement on how that reform should be. Further details may be found in the summary of discussions of that first session (document PCT/MD/1/5, reproduced in the Appendix to document PCT/MIA/27/11).

12. At the twelfth session of the PCT Working Group from June 11 to 14, 2019, the EPO presented a status report (document PCT/WG/12/16) and orally reported about the first session of the Task Force. The PCT Working Group noted the contents of document PCT/WG/12/16 and all delegations taking the floor underlined the importance of the work of the Task Force (paragraphs 144 and 145 of document PCT/WG/12/24).

13. The follow-up work to the first session of the Task Force started on the wiki in summer 2019. With regard to Objectives B and C, at the beginning of August, the EPO launched the second discussion round on Objectives B and C. More specifically, the EPO posted on the wiki a document aiming at following up on the conclusions reached at that session regarding the proposals for amendments to the PCT Regulations (document PCT/MD/1/2/REV). In that document, the EPO presented, in particular, revised proposals for amendments of Rules 34 and 36. Together with document PCT/MD/1/2/REV, the EPO posted on the wiki a template for the assessment by ISAs of the current status of their patent document collections and a summary presenting the EPO's collection status. The EPO invited the other Task Force members to post by September 27, 2019 their comments on document PCT/MD/1/2/REV as well as a summary presenting the status of their collections.

14. The EPO received comments on document PCT/MD/1/2/REV only from the Finnish Patent and Registration Office, the Japan Patent Office, the Canadian Intellectual Property Office, the Indian Patent Office, the Korean Intellectual Property Office and the USPTO as well as from the International Bureau. The EPO also received summaries of the status of the patent documents' collections from the Finnish Patent and Registration Office, the Japan Patent Office, the Indian Patent Office, the Korean Intellectual Property Office and the USPTO. Moreover, the International Bureau has made available on the WIPO website a list indicating the data coverage of patent collections on PATENTSCOPE and the extent of coverage of documents in full text electronic searchable format.

15. With regard to Objective D, the USPTO posted in June 2019 on the wiki a spreadsheet compiling all of the replies to the questionnaire contained in Circular C. PCT 1544. Moreover, at the end of July, the USPTO posted an additional questionnaire on non-patent literature which should help the development of criteria and standards for the review, addition, and maintenance of non-patent literature and traditional knowledge-based prior art in the PCT Minimum Documentation. The Task Force members were invited to reply to that questionnaire by the end of November 2019. Only five Offices (Brazilian National Institute of Industrial Property, Canadian Intellectual Property Office, EPO, Japan Patent Office and USPTO) had replied to that questionnaire by the end of December 2019 when the USPTO posted a spreadsheet compiling all the replies on the wiki. The Korean Intellectual Property Office replied in January 2020.

16. At the twenty-seventh session of the MIA (February 6 and 7, 2020) the EPO reported on the progress made so far on Objectives A to C (document PCT/MIA/27/11) and the USPTO on Objective D (document PCT/MIA/27/12). The EPO announced that it was considering organizing a second physical meeting of the Task Force in Munich on April 28 and 29, 2020 but that this still needed to be confirmed. It was indicated that "the Task Force would seek to develop proposals for presentation to the Meeting and to the PCT Working Group, with a view to recommending that the PCT Assembly approve amendments to the PCT Regulations in 2022, to enter into force before work commences on the next round of reappointment of International Authorities in 2026" (paragraph 70 of document PCT/MIA/27/16). Authorities thanked the European Patent Office and the Task Force for the work done and discussed the status reports presented by the EPO and the USPTO (paragraphs 70 to 74 and 77 to 80 of document PCT/MIA/27/16). The Meeting noted the report on progress of the Task Force and recommended that the work continue as proposed, including the convening of a physical meeting of the Task Force (paragraphs 75 and 81 of document PCT/MIA/27/16).

17. Due to the COVID-19 pandemic, the second session of the Task Force had to be postponed. With a view to making progress despite these circumstances, the EPO and the USPTO prepared documents to be discussed in the wiki.

18. With regard to Objectives B and C, on July 16, 2020, the EPO posted on the wiki two documents, i.e. document PCT/MD/1/2/REV2 containing revised proposals for Rule amendments and document PCT/MD/1/3/REV containing revised proposals for the technical

and accessibility requirements under Objectives B and C, and invited the other Task Force members to provide comments on these documents. The EPO received comments only from the Japan Patent Office, the USPTO and the International Bureau. In parallel, the EPO consulted informally the United Kingdom, German and French Offices on the proposals contained in these documents. The proposals presented in documents PCT/MD/1/2/REV2 and PCT/MD/1/3/REV are summarized in Annexes I and II of document PCT/WG/13/12 for the thirteenth session of the PCT Working Group that took place from October 5 to 8, 2020.

19. With regard to Objective D, on April 3, 2020, the USPTO posted on the wiki a document entitled “Criteria for the Evaluation of Non-Patent Literature (NPL) including Traditional Knowledge-based (TK) Prior Art for Inclusion in the NPL Patent Cooperation Treaty (PCT) Minimum Documentation List”. That document proposed a process and criteria by which NPL, including traditional knowledge-based prior art, could be considered for inclusion to the list, and how the list could be maintained over time. Moreover, that document contained a set of questions for discussion. The USPTO invited the other Task Force members to post their comments and replies on the wiki by June 30, 2020. Only four Offices (Canadian Intellectual Property Office, EPO, Japan Patent Office, Indian Patent Office) and the International Bureau replied to the USPTO’s document.

20. In view of the COVID-19 pandemic, the second session of the Task Force took place by videoconference on the WebEx platform from December 7 to 11, 2020 (two hours each day). At that session, the EPO presented revised versions of the proposals contained in documents PCT/MD/1/2/REV2 and PCT/MD/1/3/REV (documents PCT/MD/2/2 and PCT/MD/2/3), the USPTO presented a revised version of its document of April (document PCT/MD/2/4) and the Indian Patent Office gave a presentation on the Indian Traditional Knowledge Digital Library (document PCT/MD/2/5). This virtual meeting allowed the Task Force to make considerable progress on all pending objectives. Regarding Objective B, the Task Force provisionally agreed on the proposals for Rule amendments proposed by the EPO, subject to further feedback from Offices in the electronic forum and overall agreement over both Objectives B and C. Regarding Objective C, the Task Force is close to reaching consensus on the way of using WIPO Standard ST.37 Authority Files for that purpose (including any required extensions of such Authority Files) as well as on the cut-off date for the applicability of the new technical and accessibility requirements. Regarding Objective D, the Task Force has almost agreed on the criteria for NPL. Further details may be found in the summary of discussions of that session (document PCT/MD/2/6, reproduced in the Appendix to document PCT/MIA/28/4).

21. On December 11, 2020, the USPTO posted an updated version of its document PCT/MD/2/4 reflecting the input received during the second session of the Task Force and invited the Task Force members to provide comments. Only five Offices (Canadian Intellectual Property Office, EPO, Japan Patent Office, Korean Intellectual Property Office, USPTO) and the International Bureau provided a reply.

22. At the twenty-eighth session of the MIA (March 24 to 26, 2021), on the basis of the Task Force’s status report (document PCT/MIA/28/4), the EPO and the USPTO “outlined the significant progress in revising the patent and non-patent literature parts of the PCT minimum documentation, respectively”. It was announced that “a Task Force meeting would be convened from May 17 to 21, 2021, where further progress was sought towards bringing recommendations for amendment of the PCT Regulations and agreements concerning the non-patent literature at the relevant bodies in the course of 2022” (paragraph 40 of document PCT/MIA/28/9).

23. As announced at the MIA, the third meeting of the Task Force will take place by videoconference on the WebEx platform from May 17 to 21, 2021 (two hours each day). The EPO will report orally at the present session about the progress made at that meeting.

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

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