

Patent Cooperation Treaty (PCT) Working Group

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PCT MINIMUM DOCUMENTATION TASK FORCE: STATUS REPORT AND EXTENSION OF MANDATE

Document prepared by the European Patent Office and the United States of America

SUMMARY

1. This document provides an update on the work of the PCT Minimum Documentation Task Force (“the Task Force”) led by the European Patent Office (EPO) and the United States Patent and Trademark Office (USPTO). Following discussions at the fourth meeting of the Task Force (December 13 to 17, 2021) and at the twenty-ninth session of the Meeting of International Authorities under the PCT (MIA) (June 20 to 22, 2022), the EPO and the United States of America have submitted to the PCT Working Group proposals to amend the PCT Regulations and modify the Administrative Instructions (see document PCT/WG/15/11).

2. In order to facilitate the transition to the proposed requirements for the PCT minimum documentation, this document proposes an extension to the mandate of the Task Force and to set up a standing Task Force to start operating when the revised requirements enter into force to follow up their implementation. The proposed standing Task Force would also deal with non-patent literature matters, including the future revisions of the list of items agreed on under Rule 34.1(b)(iii).

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. 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documentation, in view of the fact that the WIPO Handbook on Industrial Property Information and Documentation is outdated, the definition and extent of patent literature having last been revised in November 2001, and the definition and extent of non-patent literature having last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 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.

5. For the sake of efficiency, in the work plan endorsed by the MIA in early 2017, the objectives listed above have been grouped as follows (Appendix to document PCT/MIA/24/4):

- (a) Objective A: Create an up-to-date inventory of the patent literature and non-patent literature parts of the current PCT minimum documentation.
- (b) Objective B: Recommend criteria and standards for including a national patent collection in the PCT minimum documentation.
- (c) 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.
- (d) 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.

6. 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

7. 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 both the patent literature and the non-patent literature part of the PCT minimum documentation is available on the WIPO website. Since 2018, the Task Force has been working on Objectives B, C and D through a series of discussion rounds in the wiki.

8. With regard to Objectives B and C, two main issues emerged early in the discussions, namely:

- (a) The first issue relates to the language-based criteria currently contained in Rule 34.1 which give rise to the following situation:
 - (i) the national patent collections of some ISAs do not belong to the PCT minimum documentation;
 - (ii) the contents of the PCT minimum documentation vary depending on the ISA's official language(s) and the availability of English abstracts; and
 - (iii) 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.

9. The discussions soon revealed that Rules 34 and 36 would need to be amended and that such Rule changes would need to be accompanied by new provisions of the PCT Administrative Instructions dealing with the technical criteria.

10. Since its first meeting (May 21 and 22, 2019), the Task Force has been discussing proposals for Rule amendments presented by the EPO. The fourth meeting of the Task Force took place by videoconference from December 13 to 17, 2021 (two hours each day). At that meeting, the Task Force endorsed the revised proposals and an Understanding regarding the interpretation of the proposed Rule 36 in principle. It also agreed to proceed to a further refinement of some aspects of the wording via the wiki (see paragraphs 85 and 86 of document PCT/MD/4/5/REV, attached as an Appendix to document PCT/MIA/29/4). At the twenty-ninth session of the MIA (June 20 to 22, 2022), the EPO and the USPTO reported on the progress made so far (document PCT/MIA/29/4) and the EPO presented the revised proposals for Rule amendments and the said Understanding regarding Rule 36 (document PCT/MIA/29/5 and its Annexes I and II). The MIA discussed documents PCT/MIA/29/4 and PCT/MIA/29/5 (see paragraphs 43 to 51 of document PCT/MIA/29/10 and in particular, paragraphs 47 to 49 as far as the proposals for Rule amendments are concerned). Authorities generally endorsed the proposals. As a result, the EPO is now in a position to present in Annexes I and II to document PCT/WG/15/11 the final proposals to amend Rules 34, 36 and 63, and the proposed Understanding that would be adopted with the said amendments, respectively.

11. Regarding the technical and accessibility requirements under Objectives B and C, at its first meeting, the Task Force examined proposals about extending the ST.37 Authority File format to re-purpose it for specifying clearly-defined bibliographic and text components of patent data that should be present in patent collections belonging to the PCT minimum documentation. During the second meeting, the Task Force focused on the issue of the cut-off date as of which the proposed technical and accessibility requirements, in particular the availability of patent data in text-searchable machine-readable form, should become mandatory. At its third meeting, the Task Force made significant progress on both aspects and thus tasked the EPO with the preparation of a draft text for new provisions of the PCT Administrative Instructions setting out the technical and accessibility requirements of the patent documentation part of the PCT minimum documentation.

12. At its fourth meeting, the Task Force discussed proposals for draft PCT Administrative Instructions. At that meeting, further progress was made. In particular, consensus was reached on the proposed cut-off date of January 1, 1991 (paragraphs 16 and 37 of document PCT/MD/4/5/REV). In response to a request for support in implementing the new framework made by one delegation, the Chair acknowledged that it would be important to support the whole community of International Authorities and patent Offices whose patent documentation is included in the PCT minimum documentation to ensure a smooth transition. In that regard, the Chair suggested that one course of action could be to:

- (a) extend the mandate of the current Task Force up until the actual entry into force of the revised Rules 34 and 36 and the respective Administrative Instructions, with the additional tasks of:
 - (i) guiding and supporting Offices in being technically ready by the date of entry into force of the new legal framework for all applications published as of the said date of entry into force onwards, as well as
 - (ii) agreeing on a roadmap to support Offices in meeting the technical requirements from the cut-off date up until the said date of entry into force within the 10-year window; and
- (b) ensure that the implementation of the agreed roadmap is included in the mandate of the (future) standing Task Force on PCT minimum documentation under the PCT MIA which will start operating after the entry into force of the new set of Administrative Instructions (paragraph 32 of document PCT/MD/4/5/REV).

13. The above suggestion was posted on the wiki for further consideration and endorsed by the Task Force.

14. Following its fourth meeting, the Task Force discussed via the wiki a fine-tuned version of the draft provisions of the PCT Administrative Instructions. At the twenty-ninth session of the MIA, the EPO presented revised proposals for provisions of the PCT Administrative Instructions dedicated to the patent literature part of the PCT minimum documentation (document PCT/MIA/29/5 and its Annex III). The MIA discussed the proposals and Authorities generally supported them. A couple of Authorities provided the following comments (see paragraphs 50(a) and (b) of document PCT/MIA/29/10):

(a) One Authority considered that the inclusion of the information in paragraph 5(e) of proposed new Annex H to the Administrative Instructions should be optional in the Authority File, as was the case in WIPO Standard ST.37. The EPO indicated willingness to work with the Authority to consider the issues, but noted that, without the inclusion of the information in the said paragraph 5(e), beneficial information about the text searchability of patents would be lost.

(b) Concerning the terms of use of patent and utility model data made available to International Authorities under paragraph 20 of proposed new Annex H to the Administrative Instructions, one Authority underlined the importance of consent by the provider of the data before any sharing beyond that required for patent search and the provision of copies of cited documents under the PCT. Another Authority indicated the wish that the data be shared on PATENTSCOPE as this would provide a single source and single interface for applicants and national Offices to access data in the PCT minimum documentation.

15. As agreed at the last session of the MIA, the EPO considered the two comments mentioned above and further consulted the Task Force on this matter via the wiki. As a result, the EPO is now in a position to present the respective final proposal of new Annex H in Annex III to document PCT/WG/15/11.

16. With regard to Objective D, since its second meeting, which took place from December 7 to 11, 2020, the Task Force has been discussing proposals from the USPTO for criteria for the review of the non-patent literature (NPL) and traditional knowledge-based prior art. More specifically, the proposals presented 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.

17. At its fourth meeting, the discussions in the Task Force focused on the requirements for resources to provide a search interface, to be institutionally available, and to be electronically available to the public, and the proposal to set up the Task Force as a permanent body (paragraphs 40 to 70 of document PCT/MD/4/5/REV). For non-patent literature different from traditional knowledge resources, the Task Force reached consensus on all technical aspects. The Task Force invited the USPTO to formalize the proposals for the non-patent literature as draft provisions of the PCT Administrative Instructions and work together with the EPO on a joint document containing all proposed changes to the Administrative Instructions (paragraphs 51, 52 and 70 of document PCT/MD/4/5/REV).

18. In addition, as far as traditional knowledge resources are concerned, the Indian Patent Office recalled the uniqueness and complexities of traditional knowledge resources and that the latter are not always available in electronic form to the public. The Indian Patent Office further recalled that it is requesting the inclusion of the Indian Traditional Knowledge Digital Library database as a whole in the PCT minimum documentation. The Indian Patent Office underlined that the criteria for evaluation of traditional knowledge resources needed to be distinct from the

criteria for classic non-patent literature and clarified that it was not asking for a special treatment of the Traditional Knowledge Digital Library database, but for traditional knowledge resources in general (paragraphs 44 and 67 of document PCT/MD/4/5/REV). The Indian Patent Office further pointed out that “the discussions in the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC), where consideration has been given to the special nature of traditional knowledge resources, would have significant bearing on the current discussions and was of the opinion that until the IGC is able to take a decision on the matter, the proposed criteria may be applied only to modern science and technology literature, with due provision to assess traditional knowledge resources differently” (paragraph 44 of document PCT/MD/4/5/REV).

19. The USPTO underlined that traditional knowledge resources have not been granted special status so far by the IGC. Furthermore, the USPTO recalled its strong position that whatever is contained in the PCT minimum documentation must also be made available to the public. The USPTO suggested that, if the IGC decides that traditional knowledge resources should be granted special status, the criteria could be revisited by the Task Force. It was recalled that all Task Force members, apart from the Indian Patent Office, seemed to agree with the concept of equal availability of resources to ISAs and the public. The USPTO noted that the position of the Indian Patent Office, i.e. that the proposed criteria could not apply to traditional knowledge resources in general, would imply that traditional knowledge was to be treated differently than other prior art, and pointed out that such a position has not been agreed to by the international IP community as a whole (paragraphs 45 and 69 of document PCT/MD/4/5/REV).

20. Following the fourth Task Force meeting, the USPTO formalized the proposals as draft provisions of the PCT Administrative Instructions and presented them to the MIA at its twenty-ninth session (document PCT/MIA/29/5 and its Annex III).

21. At that session of the MIA, the USPTO reported that, following recent discussions between the USPTO and the Indian Patent Office, the USPTO was proposing an additional paragraph for the Administrative Instructions dedicated to the traditional knowledge non-patent literature (see paragraph 45 of document PCT/MIA/29/10). At the session, “the Indian Patent Office stated that it would provide its more considered views on this paragraph in time to try to finalize it before the next meeting of the PCT Minimum Documentation Task Force, planned for November 2022” (paragraph 46 of document PCT/MIA/29/10).

22. The MIA discussed the proposals presented by the USPTO. It was considered that the means of making items of non-patent literature available required in paragraph 23 of proposed new Annex H to the Administrative Instructions and full text access to the items required in paragraph 38 of proposed new Annex H should be clarified. It was indicated that the terms “digital format” and “full text access” did not make clear that online access was necessary. The USPTO indicated willingness to review the said paragraphs.

23. As agreed at that session of the MIA, after having taken into account the received comments and further consulted the Task Force via the wiki, the United States of America is now in a position to present the respective final proposal of Annex H in Annex III to document PCT/WG/15/11.

24. The proposed amendments to the PCT Regulations and modifications to the Administrative Instructions referred to above are presented in document PCT/WG/15/11 with a view to submitting the proposed Rule amendments to the PCT Assembly in 2023. If the Working Group agrees to submit the proposals to the PCT Assembly, their intended entry into force would be on January 1, 2026, in order to be taken into account during the next round of reappointment of International Authorities.

25. The next meeting of the Task Force is tentatively planned from November 14 to 18, 2022 as a videoconference (two hours each day).

EXTENSION OF THE MANDATE OF THE TASK FORCE

26. As suggested by the Chair at the fourth Task Force meeting and endorsed by the Task force via the wiki, the MIA at its twenty-ninth session agreed to extend the scope of the mandate of the current Task Force in order to facilitate the transition to the new requirements (paragraph 51(c) of document PCT/MIA/29/10). More specifically, it was agreed to add the following objectives to the Task Force's mandate recalled in paragraph 4, above:

(a) Guide and support Offices in being technically ready by the date of entry into force of the amended definition of the PCT minimum documentation to make available, in accordance with the technical and accessibility requirements, all patent documents, and where applicable utility model documents, published on or after the said date of entry into force.

(b) Agree on a roadmap over the 10 years following the date of entry into force of the amended definition of the PCT minimum documentation to support Offices in meeting the technical requirements to make available all patent documents, and where applicable utility model documents, published on or after the cut-off date up until the said date of entry into force.

(c) Ensure that the implementation of the agreed roadmap is included in the mandate of the (future) standing Task Force on PCT minimum documentation under the PCT MIA that will start operating after the entry into force of the amended Regulations and new provisions of the Administrative Instructions relating to the PCT minimum documentation.

27. As a next step, it was recommended at the last session of the MIA that the MIA sets up a standing Task Force on PCT minimum documentation which would start operating after the entry into force of the revised Rules and Administrative Instructions. That Task Force would follow-up the implementation of the roadmap referred to above to support the transition to the new requirements, and also deal with non-patent literature matters (in the latter regard, see document PCT/WG/15/11).

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

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