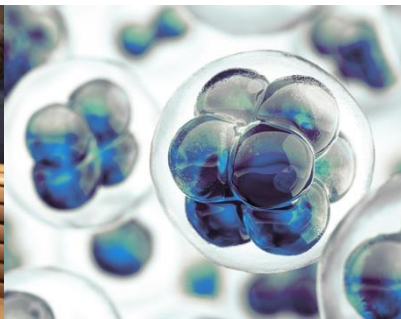




Europäisches
Patentamt
European
Patent Office
Office européen
des brevets

PCT Minimum Documentation Task Force

Documents PCT/WG/15/11 and PCT/WG/15/12



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PCT Minimum Documentation Task Force

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Background

- The definition of the PCT minimum documentation currently contained in Rule 34 PCT was conceived for the paper era.
- The MIA set up in 2016 "the **PCT Minimum Documentation Task Force**" constituted of representatives from the International Authorities and the International Bureau of WIPO under EPO lead.
- **Task Force's mandate:** to undertake a comprehensive review of the PCT minimum documentation (patent and non-patent literature) and bring it to current digital era standards in support of ISA work

Background

- **Task Force's objectives:**

- Objective A: up-to-date inventory of the current PCT min doc
- Objective B: criteria and standards for national patent collections
- Objective C: bibliographic and text components of patent data
- Objective D: criteria and standards for non-patent literature (NPL) and traditional knowledge-based prior art

- **Task Force's work plan:** Objectives A, B, C (EPO lead) and Objective D (USPTO lead)

Background

- **Objective A:** Discussions were **successfully concluded** in **2017**, i.e. when the Task Force **adopted the up-to-date inventory** of the **current** PCT minimum documentation
 - up-to-date inventory of the current patent documentation and the non-patent literature parts is now available on the WIPO website
- **Since 2018**, the Task Force has been working intensively on **Objectives B, C and D**.

Background

Two main issues emerged early in the discussions on Objective B:

- The current **language-based criteria** have the following negative impact:
 - national patent collections of some ISAs do not belong to the PCT min. doc.;
 - the contents of the PCT min. doc. vary depending on the ISA's official language(s) and the availability of English abstracts; and
 - the patent documentation part is limited to documents published in few languages.
- **Rule 34** explicitly mentions the utility certificates of France as being part of the PCT min doc, but **omits** significant **utility model collections**.

Background

- **At the last session of the MIA**, the EPO and the USPTO presented:
 - draft **amendments to the PCT Regulations and Administrative Instructions**
 - a proposal for an **extension of the mandate of the current Task Force** to facilitate the timely implementation of the proposed new provisions
 - a proposal to set up a **standing Task Force** which would start operating after the entry into force of the proposed provisions (as in draft Administrative Instructions)
- The **MIA agreed** to the proposed extension to the mandate of the current Task Force and to the submission of finalised proposals to the present WG

Proposed standing Task Force – Main aspects

- A **Task Force** (to be set up by the MIA) with representatives of ISAs
- **Main goal: dealing with non-patent literature matters**, in particular:
 - performing a **comprehensive review** of the list of NPL items and any recommended resources (every five years),
 - establishing a schedule of volunteer ISAs to conduct, on a rotational basis, an **annual review** of the list to find obsolete and discontinued resources and to update any metadata,
 - reporting on a regular basis to ISAs, usually at the MIA
- **Other goal:** follow-up the implementation of new requirements for patent documents and **supporting ISAs** during the **10-year transition** period

Doc. PCT/WG/15/11 and PCT/WG/15/12 – Overview

- **Document PCT/WG/15/11:**

- proposed amendments to the PCT Regulations → Annex I
- proposed draft Understanding → Annex II
- proposed modifications to the Administrative Instructions → Annex III

- **Document PCT/WG/15/12:**

- status report on the Task Force's work
- extension to the mandate of the Task Force (approved by the MIA)

→ The **WG** is invited to **consider** the **proposals** (15/11) and to **endorse** proposed **amendments to the PCT Regulations and draft Understanding**

Proposed amendments to the PCT Regulations

- Inclusion of **national patent collections** of all ISAs
- Each ISA's national patent collection must be made available to other ISAs under clearly **defined technical and accessibility criteria**
- Proposed new Rule 36.1(ii):
 - (ii) that Office or organization must make available for consultation as part of the minimum documentation referred to in Rule 34, in accordance with the requirements specified in the Administrative Instructions, any patent issued, and any patent application published, by it, and where applicable by its legal predecessor(s);

Proposed amendments to the PCT Regulations

- **Language-based criteria deleted** from Rules 34 and 36
- Inclusion of patent collections of Offices not appointed as ISA is possible, provided that they are made available under the same conditions as ISAs
 - Any Office making its collection available must notify the IB
 - see proposed paragraphs (b)(i) and (d)(i) of R. 34.1
- Technical and accessibility **requirements apply to all** "patent documents"
 - see proposed paragraphs (a) and (b)(i) of R. 34.1

Proposed amendments to the PCT Regulations

- Inclusion of **utility models** as an **optional recommended part** under the same requirements as for patents for both providing Offices and for ISAs

- Proposed new paragraph (c) of R. 34.1:

(c) In addition to consulting the required documentation set forth in paragraph (b), the International Searching Authority should also preferably consult utility model documents consisting of the utility models issued, and the utility model applications published, in and after 1920 by a national Office or its legal predecessor, provided that the said utility model documents have been made available by or on behalf of the relevant national Office or its legal successor in accordance with the technical and accessibility requirements specified in the Administrative Instructions.

Proposed amendments to the PCT Regulations

- Addition of two new paragraphs in Rule 34.1:
 - paragraph (d) dedicated to the **tasks** to be performed **by Offices** with regard to the making available of their collections, and
 - paragraph (e) dedicated to the **tasks** to be performed in that regard **by the International Bureau**

- Amendment of current paragraph (d) (new (f)) of R. 34.1 as follows:
 - deletion of the example indicated in brackets which is out of date
 - clarification that ISAs would only need to keep the first published version if none of the subsequently published versions contains additional matter

Proposed amendments to the PCT Regulations

- **Clarification of the meaning of "published"** for the purposes of the contents of the PCT min doc not only for applications but **also for patents**
 - in current paragraph (f) (renumbered as (g)) of R. 34.1, the term "patents" was inserted after "applications"
- Other consequential amendments to Rules 36 and 63:
 - Requirement for staff to **search the required technical fields** moved from paragraph (iii) to paragraph (i)
 - New wording of paragraph (iii) referring to PCT Admin. Instructions

Proposed amendments to the PCT Regulations

Two additional minor edits

- In proposed **R. 34.1(a)(iii)**: insertion of "**published**" before "national patents", i.e.
 - (iii) **published** national patents issued by a national Office or its legal predecessor in and after 1920

→ to ensure consistency of language and of treatment with regional patents

- In proposed **R. 34.1(a)(vi)**: **substitution** of "**title**" by "**protection**"
 - (vi) applications for any of the forms of **titleprotection** referred to in items (ii) to (v) above, published in and after 1920

→ to improve the wording and avoid any misunderstandings

Proposed draft Understanding regarding R. 36 and 63

National Offices of an intergovernmental organisation that does not itself grant patents or publish patent applications must make available for consultation any patent issued and any patent application published by them.

"In adopting the amendments to Rules 36.1 and 63.1(ii) setting out the minimum requirements referred to in Articles 16(3) and 32(3), respectively, the Assembly agreed that, in the case of an intergovernmental organization that has been established for the collaboration between national Offices of the States that are members of that intergovernmental organization and does not itself issue patents or publish patent applications, the requirements in Rules 36.1(ii) and 63.1(ii) for the organization are that the national Offices of those States make available for consultation as part of the minimum documentation any patent issued, and any patent application published, by them, and where applicable by their legal predecessor(s)."

Proposed modifications to the PCT AIs

Part I of proposed new Annex H to the PCT AIs aims at ensuring that all patent and utility model collections belonging to the PCT min doc be accessible free of charge to each ISA

→ proposed provisions set up a mechanism to allow Offices to publish relevant details about their collections on the one hand, and ISAs to access and effectively search those collections on the other hand

Mechanism to allow Offices to publish relevant details about their collections belonging to the PCT Min Doc

- Offices agreed that, latest 10 years after new Administrative Instructions enter into force, they will make their patents published after 1st January 1991 electronically searchable and available in bulk to ISAs
- Offices agreed to publish Authority Files in a new format containing extra information about their patent collections indicating:
 - Availability or not of searchable full text for the Abstract, Description, and Claims of each patent document
 - The language(s) of publication in which searchable full text of the Abstract, Description, and Claims of each document are available

Benefits of using ST.37 Authority Files in the new format

- **Allows a Patent Office that produces the Authority File to:**
 - provide an inventory of all patents that are present in its patent collection, so other IP offices can assess the completeness of the available patent documentation
 - For each individual patent, the capability to independently indicate:
 1. the availability of any text-searchable abstract, and in which languages such searchable abstracts are available;
 2. the availability of any text-searchable description, and in which languages such searchable descriptions are available;
 3. the availability of any text-searchable claims, and in which languages such searchable claims are available.

- **Allows International Authorities to** quickly identify electronically searchable patents in the new PCT minimum documentation patents and to quickly assess the completeness of the prior art consulted for their PCT searches.

Example Authority File in the new format

	Country Code	Publication Number	Kind Code	Publication Date	Text-searchable Abstract as officially published Available? (Language codes/N/U)	Text-searchable Description Available (Language codes/N/U)?	Text-searchable Claims Available (Language codes/N/U)?
1	EP	XXXXXXXX	A1	20260108	de	de	de
2	EP	XXXXXXW	A1	20260108	en	en	en
3	EP	XXXXXXV	A1	19901218	U	U	U
4	EP	XXXXXXQ	A1	19901211	U	U	U

- Only patents published after January 1st (Lines 1 and 2) must mandatorily be text-searchable, i.e. have language codes filled in in the last 3 columns
- It is acceptable for patents published before 1st January 1991 to have "U" in the last 3 columns (see lines 3 and 4)
- Recommended: if available, fill in language codes for patents published before 1st January 1991

Mechanism for ISAs to access and effectively search PCT Min Doc collections

- Offices must establish a repository where other ISAs and IB can access their bulk full text data for free via FTP, SFTP or Web Services
 - Offices must provide the IB with the relevant information and authorization details necessary to access the data
 - The IB will provide the said access details to any ISA on request
- see paragraph 3 of proposed new Annex H

Safeguards regarding the use of patent data by International Authorities:

- Paragraph 3 of proposed new Annex H explicitly refers to paragraph 20 of new Annex H to clearly limit the purpose for which the data may be used to conducting prior art search and related activities, including providing copies of cited documents to applicants and third parties.
- No other use of the data is allowed, except if it is allowed by a bilateral or multilateral agreement.
- c.f. in paragraph 20 of Annex H:
"In case the said data is used for other purposes without the express consent of the providing Office, the access to the data in bulk format may be blocked by the International Bureau."

Some Key remarks

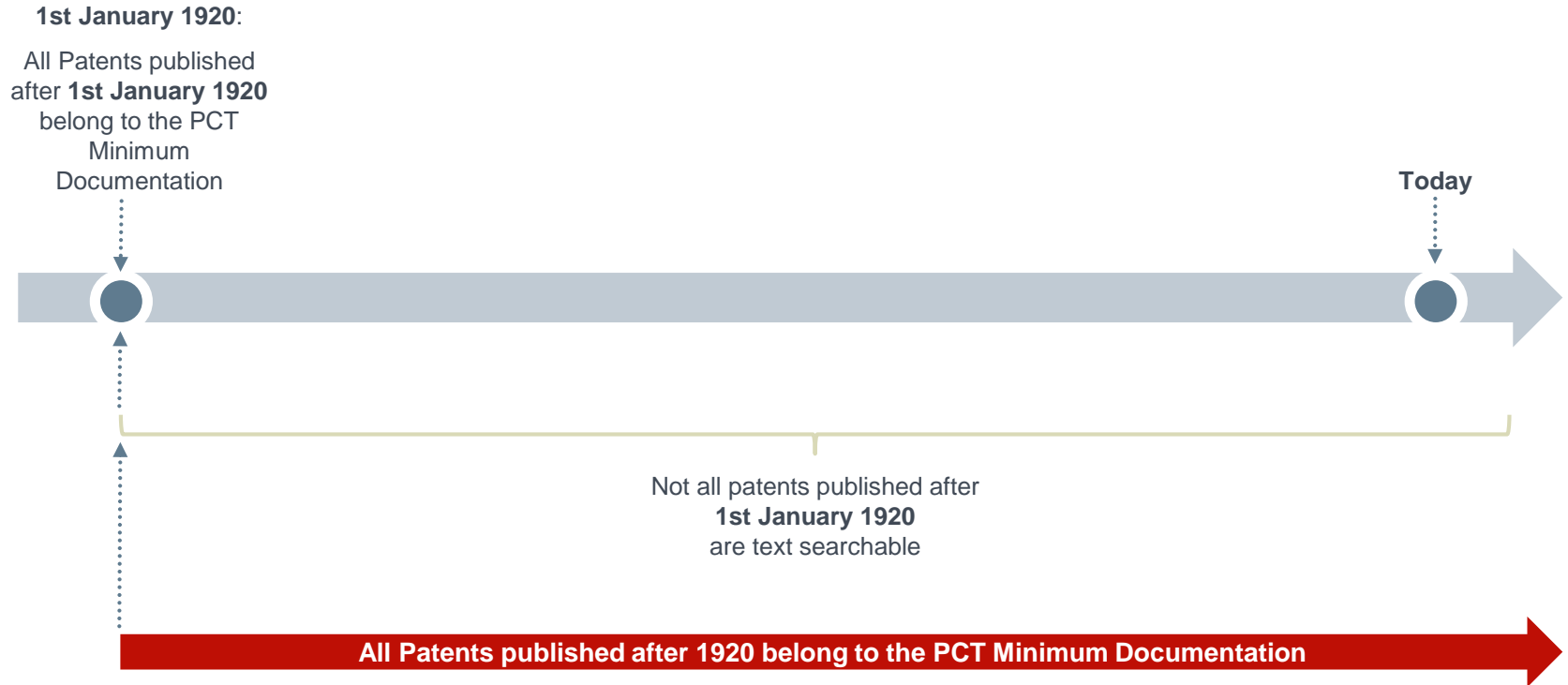
- Paragraph 3 of proposed new Annex H specifies a fallback mechanism for ISAs to access patent data belonging to the PCT min doc in the future in those rare situations where their access to a patent collection is not covered by an existing bilateral or multilateral data access agreement.
- All existing bilateral and multilateral data exchanges between Offices remaining unaffected by the introduction of the proposed new Administrative Instructions. The proposals are not intended to prevent or affect any possible future bilateral or multilateral data exchange agreements that might be agreed between Offices in the future.

Entry into force of new proposals: 2 Stages

Offices will be given time to comply with the new Administrative Instructions after they enter into force in 2 distinct Stages:

- Stage 1: Making patents published on or after 1st January 2026 text-searchable according to the new Administrative Instructions
- Stage 2: 10 years after the new Administrative Instructions enter into force (transition period), making patents published on or after 1st January 1991 text-searchable according to the new Administrative Instructions

Situation Today

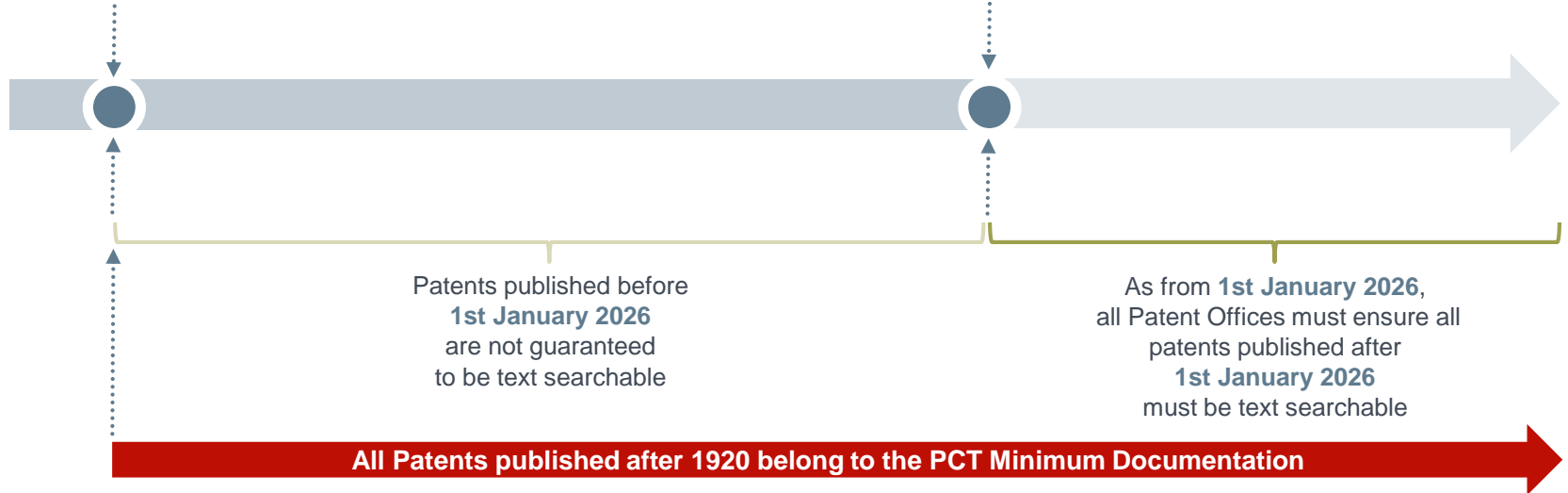


Stage 1: Situation on the Date when new Administrative Instructions are introduced (1st January 2026)

1st January 1920:

All Patents published
after **1st January 1920**
belong to the PCT
Minimum
Documentation

1st January 2026

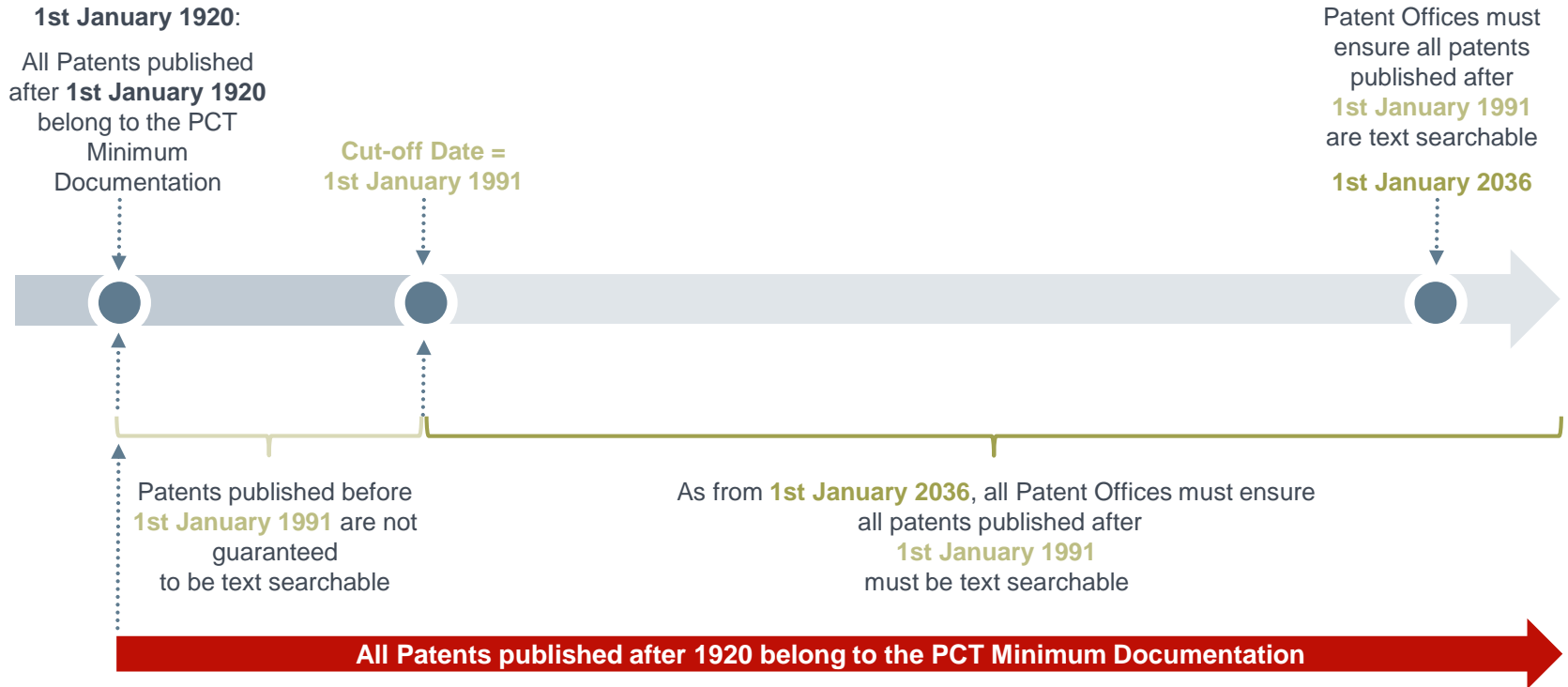


Patents published before
1st January 2026
are not guaranteed
to be text searchable

As from **1st January 2026**,
all Patent Offices must ensure all
patents published after
1st January 2026
must be text searchable

All Patents published after 1920 belong to the PCT Minimum Documentation

Stage 2: Situation 10 years after new Administrative Instructions are introduced (1st January 2036)



Next steps

- **Fifth Task Force meeting** (14-18 November 2022, 2 hours per day) focusing on the timely implementation of the new legal framework
- **Adoption by the next PCT Assembly (2023)** of Rule amendments for an entry into force before the next ISA reappointment period (on 1st January 2026)

Thank you for your attention

