

Patent Cooperation Treaty (PCT) Working Group

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PCT MINIMUM DOCUMENTATION TASK FORCE: STATUS REPORT

Document submitted 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 fifteenth session of the PCT Working Group (October 3 to 7, 2022) and at the fifth session of the Task Force (November 14 to 18, 2022), the EPO and the United States of America have submitted to the PCT Working Group revised proposals to amend the PCT Regulations and modify the Administrative Instructions (see document PCT/WG/16/6).

BACKGROUND

2. In 2005, the Meeting of International Authorities under the PCT (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.

3. 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documentation, in view of the fact that the WIPO Handbook on Industrial Property Information and Documentation is outdated, the definition and extent of patent literature having last been revised in November 2001, and the definition and extent of non-patent literature having last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.
4. 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.

5. At its twenty-ninth session (June 20 to 22, 2022), the MIA agreed to add the following three objectives to the Task Force's mandate (see paragraph 22 of document PCT/MIA/29/4 and paragraph 51(c) of document PCT/MIA/29/10):

(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.

6. 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 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 session (May 21 and 22, 2019), the Task Force has been discussing proposals for Rule amendments presented by the EPO. At the fifteenth session of the PCT Working Group (October 3 to 7, 2022), delegations supported in principle the proposed amendments to Rules 34, 36 and 63 PCT set out in Annex I to document PCT/WG/15/11, and the draft Understanding regarding the interpretation of Rules 36 and 63 PCT set out in Annex II to that document (paragraph 57 of document PCT/WG/15/19). At the fifth session of the Task Force (November 14 to 18, 2022), these proposed Rule amendments and draft Understanding found the support of the Task Force members. As a result, the EPO is now in a position to present the final proposals to amend Rules 34, 36 and 63 (see Annexes I and II to document PCT/WG/16/6), 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 session, 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. At its second session (December 7 to 11, 2020), 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 session (May 17 to 21, 2021), 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. At its fourth session, the Task Force discussed proposals for draft PCT Administrative Instructions. At that meeting, consensus was reached on the proposed cut-off date of January 1, 1991.

12. Following discussions at the fourth session of the Task Force (December 13 to 17, 2021) and at the twenty-ninth session of the MIA (June 20 to 22, 2022), the EPO submitted to the PCT Working Group proposals for new provisions of the PCT Administrative Instructions dedicated to the said technical and accessibility requirements (see document PCT/WG/15/11). The PCT Working Group supported the proposals in principle but some comments were raised regarding the proposed Annex H to the Administrative Instructions (paragraph 59 of document PCT/WG/15/19). As a result, the Task Force was invited to further fine-tune the proposed provisions of the PCT Administrative Instructions and to bring this package back for discussion at the sixteenth session of the PCT Working Group (paragraph 60 of document PCT/WG/15/19).

13. At its fifth session (November 14 to 18, 2022), the Task Force discussed revised proposals for new provisions of the PCT Administrative Instructions, further fine-tuned the said provisions during the meeting and reached consensus on Part I of proposed Annex H to the Administrative Instructions dedicated to the patent and utility model documentation. Following the meeting, the Task Force members had the possibility to provide further comments via the wiki but no comments were raised. As a result, the EPO is now in a position to present a revised proposal for Part I of proposed Annex H to the Administrative Instructions. This proposal is set out in Annex III to document PCT/WG/16/6. At its fifth session, the Task Force

focused also on the implementation of the proposed new requirements in a timely manner by January 1, 2026. In particular, the Task Force started analyzing and discussing the current status of each ISA with respect to compliance with the proposed new requirements. Such “gap analysis” aims at helping ISAs identifying what needs to be addressed in the coming years.

14. With regard to Objective D, since its second session, 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.

15. At the fifth session of the Task Force (November 14 to 18, 2022), there was consensus with the exception of the Indian Patent Office on the provisions of Part II of proposed Annex H to the Administrative Instructions dedicated to the non-patent literature. The Indian Patent Office considers that traditional knowledge resources should benefit from a special treatment whilst the other International Authorities in the Task Force believe that such resources should abide by the same technical requirements as the other non-patent literature resources.

16. The Indian Patent Office underlined the special nature of traditional knowledge resources and reiterated that the criteria for the evaluation of traditional knowledge resources needed to be distinct from the criteria for the rest of non-patent literature. The Indian Patent Office recalled that it was not asking for a special treatment of the Indian Traditional Knowledge Digital Library (TKDL) database, but for traditional knowledge resources in general. The Indian Patent Office further underlined 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, but not to traditional knowledge resources. The Indian Patent Office reiterated that it could not agree with the requirement for an item of non-patent literature to be an individual title, or on the paragraph related to traditional knowledge non-patent literature (paragraphs 24 and 38 in Annex III to document PCT/WG/16/6). The Indian Patent Office proposed an alternative wording for the latter paragraph.

17. The USPTO underlined that the current wording of the paragraph related to traditional knowledge non-patent literature acknowledges the fact that there are ongoing discussions concerning traditional knowledge in other WIPO bodies. The USPTO also stressed that, while no consensus has yet been achieved regarding the treatment of traditional knowledge prior art, if agreement is eventually reached, the Administrative Instructions dedicated to the non-patent literature part of the PCT minimum documentation would be revisited in light of any such agreement. The USPTO reiterated that the PCT minimum documentation is meant to represent the minimum level of required content. It does not preclude offices from acquiring and/or accessing additional NPL and traditional knowledge resources. Additionally, the USPTO pointed out that the evaluation by title does not impede traditional knowledge resources from being included in the PCT minimum documentation, but actually facilitates the inclusion of more traditional knowledge resources in the PCT minimum documentation. Indeed, the evaluation by title allows individual titles contained in a database to be included in the PCT minimum documentation if they meet the proposed set of criteria.

18. The other Authorities represented in the Task Force supported the current wording of the paragraph of proposed new Annex H relating to traditional knowledge non-patent literature, as proposed by the USPTO. In particular, it was considered that this wording leaves the door open for a special treatment of traditional knowledge resources, should the IGC determine that such special treatment is appropriate. It was added that, at the same time, this wording allows the

Task Force to include in the PCT minimum documentation any traditional knowledge resources that would meet the present set of criteria.

19. No further comments were raised via the wiki. As a result, the proposed text of Part II of proposed Annex H to the Administrative Instructions which is supported by the vast majority of the Task Force members is set out in Annex III to document PCT/WG/16/6.

20. The proposed amendments to the PCT Regulations and modifications to the Administrative Instructions referred to above are presented in document PCT/WG/16/6 with a view to submitting the proposed Rule amendments to the PCT Assembly in 2023 for adoption. The intended entry into force of the revised set of Rules 34 and 36 would be on January 1, 2026, in order to match with the next round of reappointment of International Authorities.

21. The next meeting of the Task Force is tentatively planned from May 22 to 26, 2023 as a videoconference (two hours each day).

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

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