

Patent Cooperation Treaty (PCT) Working Group

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PCT MINIMUM DOCUMENTATION: DEFINITION AND EXTENT OF PATENT LITERATURE

Document prepared by the International Bureau

SUMMARY

1. The International Bureau is reactivating the PCT minimum documentation task force to continue work towards updating the patent literature part of the PCT minimum documentation. The first tasks will be: (i) investigation of whether the “Authority File” format developed by the IP5 Offices¹ could be useful, and (ii) the formats and means of distribution currently used for making national patent document collections available.

BACKGROUND

2. At the nineteenth session of the Meeting of International Authorities and the fifth session of the PCT Working Group, the International Bureau presented documents (PCT/MIA/19/13 and PCT/WG/5/16, respectively) suggesting the concept of amending Rule 34 to automatically include the national patent documentation of any PCT Contracting State as part of the PCT minimum documentation, provided that it was made available reliably in a suitable electronic format which would be easy for International Authorities to load into their databases. Certain technical limitations would continue to apply relating to avoiding duplicate documents and searching documents in languages which are inaccessible to the examiner.

¹ IP5 Offices: the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the State Intellectual Property Office of the People’s Republic of China (SIPO) and the United States Patent and Trademark Office (USPTO).

3. The aim of this initiative was to improve the availability of technical information from patent documents, in terms of the technical coverage and linguistic coverage of the documents, and of the searchability of the information contained. This is important to improving the quality of international search, as well as to allowing better access to patent information for third parties.

4. One of the key initial steps was to properly evaluate the extent of the existing minimum documentation. The inventory in the WIPO Handbook on Industrial Property Information and Documentation had not been updated since November 2001. Since that time, apart from the lists of publications for the Offices represented becoming out of date, two new collections had been added to the list in Rule 34.1(c)(ii) (those of the Republic of Korea and the People's Republic of China) and other States might have made their collections available in accordance with Rule 34.1(c)(vi).

5. Noting that a similar exercise to evaluate the extent of patent collections was under way between the IP5 Offices, it was agreed, at the nineteenth session of the Meeting of International Authorities and the fifth session of the PCT Working Group, to wait for the file specifications and the "Authority Files" produced by those Offices to become available in order to determine whether the same process would be suitable for use in documenting the PCT minimum documentation.

CURRENT PHASE OF WORK

6. The initial Authority files are now available². Consequently, the twenty-second session of the Meeting of International Authorities under the PCT recommended that it was now appropriate to reactive the PCT minimum documentation task force with an initial task of investigating and making recommendations in the following areas (see paragraphs 62 to 65 of document PCT/MIA/22/22, reproduced in the Annex to document PCT/WG/8/2):

(a) *Documenting National Collections*

(i) Is the IP5 Authority File specification a suitable basis for a recommendation on how other national Offices should document their national patent collections if they wish them to be included in the PCT minimum documentations?

(ii) Are any of the specific formats used by the different IP5 Offices particularly suitable to be the basis of a more specific recommendation, to ensure that Authority Files from a wide variety of different Offices can be processed reliably?

(iii) Is it a problem that the format is intended specifically for assessing the completeness of document collections and does not help address the question of identifying equivalent publications to reduce duplication (as per existing Rule 34.1(d))?

(b) *Making National Collections Available*

(i) What formats and distribution means do national Offices currently use to make their national collections available to International Searching Authorities, the International Bureau and database providers?

(ii) Are any of the formats particularly helpful in allowing the documents and data associated with the patent publications to be loaded easily and effectively into databases for search purposes?

(iii) Are there any significant difficulties with standards which should be brought to the attention of other bodies for consideration as soon as possible?

² See <http://www.fiveipoffices.org/activities/globaldossier/authorityfiles.html>.

7. The Meeting of International Authorities also noted additional issues which would need to be considered in relation to part (b) of the above tasks (see paragraph 64 of document PCT/MIA/22/22³) and invited the task force to consider issues concerning the format of non-patent literature forming part of the PCT minimum documentation (see paragraphs 70 to 73 of document PCT/MIA/22/22).

FUTURE STEPS

8. The intention of the phase of work described in paragraph 6, above, is to collect sufficient information on which to base future work on the development of:

(a) effective recommendations and 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; and

(b) new draft legal texts to define what is 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.

9. Any such proposals developed will be provided for the consideration of all PCT Contracting States, either through PCT Circulars or as documents to the PCT Working Group, as appropriate.

10. The Working Group is invited to note the current tasks of the PCT minimum documentation task force, and to comment on other issues which may need to be considered in order to improve the patent literature part of the PCT minimum documentation.

[End of document]

³ “64. One Authority emphasized the need for bibliographic data to be in text format in accordance with WIPO Standards ST.36 and ST.96. Another Authority underlined that the minimum documentation had to be freely accessible to IP Offices for bulk download and that bibliographic data, the abstract and citation information had to be provided in English. One Authority suggested to also address the following issues in the task force, in addition to those outlined in paragraph 10 of the document: media-less exchange of documents, the open distribution of patent information and the possible addition of utility model collections to the PCT minimum documentation.”