

Patent Cooperation Treaty (PCT) Working Group

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PCT MINIMUM DOCUMENTATION TASK FORCE: STATUS REPORT

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SUMMARY

1. This document reports on the PCT Minimum Documentation Task Force (hereinafter “the task force”) and summarizes the actions taken with regard to its reactivation since the most recent session of the Meeting of International Authorities (MIA), held in Santiago, Chile from January 20 to 22, 2016.

BACKGROUND

2. In 2005, the MIA decided to set up a task force, under the leadership of the European Patent Office (EPO), 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 (see paragraphs 9 to 12 and 18, document PCT/MIA/11/14). However, the process stalled in view of the lack of consensus on certain issues (see document PCT/MIA/13/5).

3. In 2012, the MIA decided to set up a task force with the aim of extending and updating the scope of the patent literature part of the PCT minimum documentation (see paragraphs 79 to 81, document PCT/MIA/19/14, and Circular C. PCT 1359, dated September 28, 2012). Since then, the PCT Minimum Documentation Task Force has operated using a dedicated electronic forum (hereinafter “the wiki”) facilitated by the International Bureau. However, the process was put on hold pending the outcome of the work on setting up prior art documentation standards being carried out within the context of the IP5 cooperation scheme (the IP Offices of China, Japan, the Republic of Korea and the United States of America, and the European Patent Office) (see document PCT/MIA/21/12).

4. In 2015, following the publication of “authority files” within the context of the IP5 cooperation scheme, the MIA decided to reactivate the task force, with the International Bureau as task force leader pending the appointment of an International Searching Authority (ISA) in its place (see paragraphs 62 to 65 and 73, document PCT/MIA/22/22). Little progress was made in 2015.

5. In January 2016, there was again consensus at the MIA to reactivate the PCT Minimum Documentation Task Force. However, the International Bureau pointed out that it lacked experience and expertise in the field, and invited one of the ISAs to replace it. The MIA invited the task force to resume its work on the basis of document PCT/MIA/23/5 (see paragraph 63, document PCT/MIA/23/14), and to recommence discussions on the addition to the PCT minimum documentation of databases, including traditional knowledge databases, as set out in document PCT/MIA/12/6 (see paragraph 85(a), document PCT/MIA/23/14).

6. In Santiago, the MIA also invited the Indian Patent Office to submit to the task force a detailed working document, including a revised draft of the access agreement, setting out its proposals with regard to the inclusion of the Indian Traditional Knowledge Digital Library (TKDL) in the PCT minimum documentation, taking into account previous discussions in the meeting, the task force and the IGC, as well as the discussions held at the present session. It also invited the International Bureau to work closely with the Indian Patent Office in the coming months with a view to moving the issue forward, where appropriate by means of informal consultations and written communications, such as PCT Circulars, to ensure proper preparation of the discussions to be held at the next session of the MIA in 2017 (see paragraph 85(b) and (c), document PCT/MIA/23/14).

7. In February 2016, the EPO responded positively to the call of the International Bureau and agreed to (once again) lead the PCT Minimum Documentation Task Force on the basis of the mandate given by the MIA. What follows is an outline of the proposed work of the task force as envisaged by the EPO.

EVALUATION AND OBJECTIVES

8. First, the task force will need to properly evaluate the extent of the existing PCT minimum documentation. The inventory in the WIPO Handbook on Industrial Property Information and Documentation has not been updated since November 2001. Since then, not only have the lists of publications for the offices represented become out of date, two new collections have 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 may have made their collections available in accordance with Rule 34.1(c)(vi).

9. Second, in line with the mandate set by the MIA, the task force will need to:

(a) 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.

(b) 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. Special attention will also be paid to criteria for the inclusion of utility models which form an important part of prior art.

(c) 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.
- (d) 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
- (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) Recommend criteria for the inclusion of traditional knowledge-based prior art in the non-patent literature part of the minimum PCT documentation, and in particular, work with the Indian authorities after they re-submit their detailed proposals for inclusion of the TKDL database in the PCT minimum documentation (see paragraph 85(b), document PCT/MIA/23/14).

METHODOLOGY AND TIMESCALE

10. The task force will conduct its discussions using the wiki. Each International Authority is invited to nominate representative(s), including at least one expert in the field of patent documentation if they have not done so already. As facilitator of the wiki, the International Bureau is responsible for the registration of these representatives.
11. In May, the EPO intends to post in the wiki a high-level document presenting the proposed evaluation and objectives set in paragraphs 8 and 9 above, as well as the annual work plan for the task force. Once agreement has been achieved on this document, the EPO will prepare a series of documents dedicated to the topics for review. The review will be carried out in rounds of discussions to take place in the wiki in the second half of 2016.
12. The aim of the EPO in its role as task force leader is to make progress in all topics for review under paragraphs 8 and 9 above and, if possible, to achieve concrete results as early as next year. A status report will be presented by the EPO at the next MIA in 2017.

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

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