

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

Thirtieth Session
Geneva, November 1 to 3, 2023

CITATION OF NON-WRITTEN DISCLOSURES

Document prepared by the International Bureau

SUMMARY

1. This document provides an update on the work related to the citation of prior art that is not in written form. Following discussions during the twenty-ninth session of the Meeting of International Authorities in 2022, the International Bureau invited Authorities to submit comments on the topic of non-written disclosures on the Quality Subgroup wiki hosted by the International Bureau. This document presents the status of the discussions on this topic and outlines possible ways forward for improved citation and storage of non-written disclosures.

BACKGROUND

2. At the twenty-ninth session of the Meeting of International Authorities in June 2022, International Authorities discussed a document on the citation of prior art that is not in written form (document PCT/MIA/29/2). These discussions are summarized in paragraphs 28 to 33 of the Summary by the Chair of the session, document PCT/MIA/29/10.

3. All Authorities that took the floor broadly supported the main proposal in the document, to extend the definition of prior art under the PCT to include non-written disclosures. This would improve the quality of international work products by allowing examiners to consider non-written disclosures when drafting statements on lack of inventive step or novelty. However, Authorities raised practical and legal issues related to its implementation. Some Authorities also provided suggestions on the drafting of the provisional amendments to the PCT Regulations in the Annex to the document. The follow up to the discussion is set out in paragraph 33 of the Summary by the Chair, as follows:

“33. The Meeting invited the International Bureau to continue discussion of the proposal with a broader audience at the PCT Working Group and to begin informal consultations through the Quality Subgroup on detailed issues that International Authorities had raised during the session.”

4. To follow up the discussions at the twenty-ninth session, the International Bureau set up a page on the Quality Subgroup wiki and invited comments by July 31, 2022 on the issues raised during the session. Two Authorities provided information on their practices citing non-written disclosures. The International Bureau started a further round of discussions, asking for comment by July 31, 2023, in relation to two aspects of the citation of non-written disclosures, as follows:

(1) How Authorities cite non-written disclosures in a search report in practice, for example, including references to the applicable Authorities' Guidelines and concrete examples for video/audio recordings, Internet disclosures, etc.; and

(2) Whether Authorities store non-written disclosures for future use, and information on how this storage is done such as details of any repository. Authorities were also invited to comment on copyright issues that they had encountered regarding the distribution of non-written disclosures to the applicant and to other parties, such as an external repository used for storing and future retrieval of disclosures.

RESPONSES FROM INTERNATIONAL AUTHORITIES

5. By the end of July 2023, several Authorities had reacted to the call for comments and provided detailed contributions on the wiki page. In relation to the question (1) above, several Authorities explained that they relied on commercial Internet archiving services, such as the Wayback machine, for establishing a publication date when necessary, in absence of any trustworthy source of information regarding the date on which a certain disclosure was made available to the public on the Internet. Many responding Authorities indicated that they use internal, non-public servers to store data related to non-written disclosures, such as screenshots of a video. The recorded data is generally stored along with the relevant bibliographic information, and possibly a URL when the disclosure has been retrieved from the Internet. A conversion to PDF is generally carried out before recording the citation data, regardless of the nature of the evidence to be recorded (such as transcript of an audio file or screenshots of a video). In essence, the non-written disclosures after the conversion into PDF are treated by Authorities in the same manner as normal non-patent literature, save for the citation categories applied, as described below.

6. In international search reports, Authorities referred to a non-written disclosure with the letter “O”, accompanied by a symbol indicating the relevance of the citation, for example: “O, X”; “O, Y”; or “O, A”, as set out in paragraph 16.70 of the International Search and Preliminary Examination Guidelines. Some Authorities explained further that the category “L” would be assigned to a cited document that is relevant for the assessment of novelty or inventive step when its publication date cannot be established. Otherwise, the responding Authorities did not indicate that they face difficulties when it comes to the citation of non-written disclosures in search reports.

7. Regarding question (2) in paragraph 4, above, no Authorities addressed potential copyright issues when distributing non-written disclosures to the applicant and third parties. While some Authorities indicated that evidence and bibliographic data related to non-written disclosures were stored on restricted-access internal repositories, the use of an external repository for storing and future retrieval of disclosures has not been considered so far by the responding Authorities.

PROPOSED WAY FORWARD

8. The International Bureau recognizes the difficulties of establishing reliable dates for non-written disclosures, as well as the technical and legal issues involved in archiving and distributing copies of such disclosures when used as citations. These issues are considered further below. Nevertheless, the same problems are faced already by International Authorities in their roles as national Offices.

9. Although some progress on common practices would be important before bringing an amended rule into force, this should not prevent work to improve the quality of international search reports to the extent that International Authorities are able to search and cite material in their national roles. The International Bureau considers that it would be desirable for the next session of the PCT Working Group to consider a revised proposal for amendment of Rules 33 and 64, as well as consequential amendments. This would allow progress on the main legal principles and seek to drive forward discussion among the International Authorities on the related issues of implementation. The question of whether it is timely to submit proposed amendments to the PCT Union Assembly could be considered separately from the merits of the proposal itself.

CENTRAL REPOSITORY FOR STORING AND RETRIEVING DATA ON NON-WRITTEN DISCLOSURES

10. Two of the key issues of concern to International Authorities prior to extending the definition of prior art were:

- (i) how to store evidence of non-written disclosures such that they would remain available at a later date with the same substantive content seen by the search examiner, even if the original source material is subsequently modified or becomes unavailable; and
- (ii) the ability to transmit copies of such citations to applicants and designated Offices in accordance with PCT Article 20(3).

11. A partial solution proposed to this was the creation of a central repository for storing and retrieving data on non-written disclosures cited as prior art. In principle, the International Bureau would be prepared to host such a repository, noting that it already provides the possibility for International Searching Authorities to upload copies of cited documents onto the application file, with access rights limited to the applicant and national Offices, for use in the case where the Authority has the right to provide copies for such purpose. The extension to allow other file formats would, in itself be simple from a technical point of view; provided no significant additional features were required, the main issue would be assessing the likely cost of hosting and distributing the citations, based on an estimate of the expected volume of data. However, this does not address either the underlying copyright issues, which are essentially the same as those limiting the use of the existing service and are unlikely to be resolved in isolation, nor does it cover a means of converting content, where necessary, into formats that can be efficiently and reliably read at a later date.

12. Storing data related to non-written disclosures in a new, more convenient format, is desirable to cope with the variety of formats used in these disclosures. For instance, multimedia files use proprietary formats, videos and audio files are usually recorded according to various media standards, so that any conversion to a unique format for the purpose of recording citation data induces a loss of content for the non-written disclosure.

13. Defining a minimum set of attributes characterizing non-written disclosures is a first step towards the establishment of a central repository. These attributes shall be applicable to all different types of evidence and give relevant information about the disclosures, regardless of the format used for storing electronically the citation data. For instance, the URL of a particular YouTube video is an essential attribute for an online video. In addition to the official, purported

publication date, different dates are also useful to record, such as a date of retrieval of the document on the Internet by the patent examiner, or a date on which the prior art was accessible to the public with a high degree of certainty, for example, as provided by an Internet archiving service such as the Wayback machine.

14. Any repository would ideally be designed to store complete original pieces of prior art, for example full-length audio or video recordings, so that these records can be made available for a later retrieval of the evidence during the international phase or later, after entry into regional or national phase before elected or designated Offices. A central repository would offer various benefits such as the completeness of the recorded data and the assurance that the data stored on the repository corresponds to the original version of the non-written disclosure, as it was originally retrieved by the patent examiner. So far, many Authorities have chosen to store only fragments of recordings, or screenshots of videos in their internal, non-public servers. In contrast, a new repository could store unedited sequences or multimedia files, strengthening thereby the legal value to the cited non-written disclosure. The validity of non-written disclosures may be disputed if the related evidence is not available in its entirety. However, additional standard file formats, as well as metadata such as timed screenshots or automatic transcripts of audio, may be desirable to allow the content to be used more efficiently.

15. A central repository would likely not itself include the tools for making copies of non-written disclosures, adding metadata and converting them to formats suitable for reliable long-term storage and use. The development of common tools for this purpose would need to be considered separately, likely based on the experience of International Authorities in their national roles.

16. Consideration might also be given to access to copies of citations for interested third parties. This might take the form of direct access to copies uploaded to the central repository that were tagged as being free to access, or else ensuring that the metadata was sufficient to allow third parties to identify a source from which copies could be obtained, where necessary paying the appropriate licensing fees.

OTHER ISSUES

17. The discussions in the wiki suggested that International Authorities' main concerns involved the establishment of a reliable date of availability for non-written disclosures and archiving of any material found for later use in the examination process. Once this was done, there appeared to be little difficulty in the process of citing the relevant disclosures. Nevertheless, it may be desirable to review Chapters 11 and 16 of the PCT International Search and Preliminary Examination Guidelines, WIPO Standard ST.14 and the DTDs establishing the data structures for recording different types of non-patent literature in XML search reports in order to establish better and more consistent practices if necessary.

18. *The Meeting is invited to:*

(i) comment on the International Bureau's suggestion of bringing a revised proposal for amendment of PCT Rules 33 and 64 to the next session of the PCT Working Group;

(ii) comment on matters concerning the creation of a central repository for non-written disclosures and citing such disclosures as relevant prior art; and

(iii) decide how to advance discussion of issues necessary for the effective citation of non-written disclosures as part of the international search under the PCT.

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