

## **Patent Cooperation Treaty (PCT) Working Group**

**Seventeenth Session**  
**Geneva, February 19 to 21, 2024**

### **CITATION OF NON-WRITTEN DISCLOSURES**

*Document prepared by the International Bureau*

#### **SUMMARY**

1. This document sets out draft amendments to the PCT Regulations to broaden the definition of relevant prior art for both international search and international preliminary examination to include non-written disclosures. The document also provides an update on the work between International Authorities to consider before implementing this change related to storing non-written disclosures and making them available to applicants, designated Offices and other parties.

#### **BACKGROUND**

2. At the twenty-ninth session of the Meeting of International Authorities under the PCT (PCT/MIA) 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). This document presented some draft provisional amendments to the PCT Regulations that would broaden the definition of relevant prior art in the PCT to cover both written and non-written disclosures. The document also discussed modifications to practices in citation of prior art that would be needed to broaden the definition of relevant prior art in the PCT to cover both written and non-written disclosures. These discussions are summarized in paragraphs 28 to 33 of the Summary by the Chair of the session, document PCT/MIA/29/10.

3. The International Bureau presented a document on non-written disclosures including revised draft amendments to the fifteenth session of the Working Group in October 2022 (document PCT/WG/15/5). Paragraphs 61 to 65 of the Summary by the Chair of the session, document PCT/WG/15/19, set out the discussions on this subject. While it was acknowledged that the legal framework needed to be updated to include non-written disclosures in the

definition of prior art, delegations observed that the proposed extension of the definition of prior art would present challenges from a technical and legal point of view. The Working Group therefore invited International Authorities to study the requirements for effective implementation of the proposal, considering comments made, and to make recommendations on further work.

4. At the thirtieth session of the Meeting of International Authorities in November 2023, International Authorities discussed ways forward for the improved citation and storage of non-written disclosures, including issues around the creation of a central repository for storing and retrieving data (see document PCT/MIA/30/5 and paragraphs 22 to 27 of the Summary by the Chair, document PCT/MIA/30/10). Paragraph 27 of the Summary by the Chair sets out the agreed follow up:

“27. The Meeting invited the International Bureau:

(a) to prepare draft amendments to PCT Rules 33, 64 and related provisions for consideration by the PCT Working Group;

(b) to create entries in the quality subgroup wiki seeking information on systems used by International Authorities for recording non-written disclosures and any analysis that the International Bureau or International Authorities could perform concerning types of non-written disclosures allowing copyright issues to be addressed.”

## **PROPOSED UPDATES TO THE LEGAL FRAMEWORK CONCERNING NON-WRITTEN MATERIAL**

### **DEFINITION OF PRIOR ART**

5. The Annex to this document sets out draft amendments to the PCT Regulations that would extend the definition of relevant prior art to cover all types of disclosures, both written and non-written. The definition of prior art contained in these amendments is intended to be consistent with most current national and regional patent laws.

6. This proposed definition takes into account comments during previous sessions of the Working Group and Meeting of International Authorities. In particular, the proposal sets out revised Rules 33 and 64 in light of comments expressed during the twenty-ninth session of the Meeting of International Authorities (see document PCT/MIA/29/10, paragraph 31). The new wording provides a universal definition of prior art disclosures covering all kinds of written and non-written material, without having to formulate a specific definition of what is meant by non-written disclosures.

### **CITATION OF PRIOR ART**

7. While the proposed amendments to Rules 33.1(a) and 66.1(a) eliminate the need to define non-written disclosures, issues remain around citation of disclosures. Rules 33.1(b) and 64.2 provide for including in the search report a written disclosure that is not prior art in itself because it was published on or after the filing date (Rule 33) or priority date (Rule 64), but provides evidence of an earlier non-written disclosure.

8. The purpose of these Rules is not fundamentally about whether either the earlier or later disclosures are in written or non-written form. Rather, the issue is of having a permanent record published after the relevant date that documents an earlier, ephemeral disclosure. In principle, this could include an earlier disclosure in the form of writing on a blackboard at a public lecture that was subsequently erased but was documented in an audio recording made available a few days later.

9. Nevertheless, it is not proposed to amend Rules 33.1(a) and 64.2. The aim is to make clear that any form of public disclosure can, in principle, be prior art and that an international search report or written opinion may refer to disclosures that are not in themselves prior art but provide evidence of an earlier disclosure. The important change is to make the definition of prior art clear. The questions of how to cite, store and evaluate evidence of an earlier disclosure are matters that can be left largely to the International Search and Examination Guidelines (and, particularly in the case of evaluation, decisions of courts and tribunals) provided that the general principle of being able to refer to later disclosures is established.

#### **FURTHER WORK**

10. Regarding the issue of non-patent literature copyright, no practical solution exists to date. On this complex topic covering legal and technical aspects, concrete questions need to be addressed at first and it is likely that no complete international solution will be found. The International Bureau will invite further discussion within the PCT/MIA quality subgroup wiki. As indicated in paragraph 27(b) of document PCT/MIA/30/10 (see paragraph 4, above), the next phase is expected to be sharing of information on systems used by International Authorities for recording and archiving non-written disclosures. This should allow identification of practical options for technical work and help to define more clearly the particular copyright issues to be addressed.

#### **NEXT STEPS**

11. It is not proposed to invite the PCT Union Assembly to amend Rules 33 and 64 at its next session. Rather, it is proposed that any agreement on the draft amendments in the Annex to this document be considered provisional and that the International Authorities should continue to study the issues involved in the citation of non-written disclosures as prior art under the PCT and make recommendations for further steps.

*12. The Working Group is invited to comment on the draft amendments to Rules 33 and 64 set out in the Annex to this document and on the requirements for further work in this area.*

[Annex follows]

DRAFT PROVISIONAL AMENDMENTS  
TO THE PCT REGULATIONS<sup>1</sup>

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<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

## Rule 33

### Relevant Prior Art for the International Search

#### 33.1 *Relevant Prior Art for the International Search*

(a) For the purposes of Article 15(2), relevant prior art shall consist of everything which has been made available to the public anywhere in the world by any means ~~of written disclosure (including drawings and other illustrations)~~ and which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step (i.e., that it is or is not obvious), provided that the making available to the public occurred prior to the international filing date.

(b) *[No change]* When any written disclosure refers to an oral disclosure, use, exhibition, or other means whereby the contents of the written disclosure were made available to the public, and such making available to the public occurred on a date prior to the international filing date, the international search report shall separately mention that fact and the date on which it occurred if the making available to the public of the written disclosure occurred on a date which is the same as, or later than, the international filing date.

(c) *[No change]* Any published application or any patent whose publication date is the same as, or later than, but whose filing date, or, where applicable, claimed priority date, is earlier than the international filing date of the international application searched, and which would constitute relevant prior art for the purposes of Article 15(2) had it been published prior to the international filing date, shall be specially mentioned in the international search report.

33.2 and 33.3 *[No change]*

## Rule 64

### Relevant Prior Art for the International Preliminary Examination

#### 64.1 *Prior Art*

(a) For the purposes of Article 33(2) and (3), everything made available to the public anywhere in the world by any means ~~of written disclosure (including drawings and other illustrations)~~ shall be considered prior art provided that such making available occurred prior to the relevant date.

(b) [No change]

64.2 and 64.3 [No change]

[End of Annex and of document]