

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

**Nineteenth Session
Canberra, February 8 to 10, 2012**

PCT MINIMUM DOCUMENTATION: DEFINITION AND EXTENT OF PATENT LITERATURE

Document prepared by the International Bureau

SUMMARY

1. At its 16th and 18th sessions, the Meeting generally approved the principle that the patent literature part of the PCT minimum documentation should be extended to include more documents. Any Contracting State should have a right to have its patent documentation included, provided it is willing to ensure that it is made available in a format useful to International Authorities in conducting an international search. In this document, “patent documentation” should be understood in a broad sense, notably including utility model publications.
2. To move to allow the minimum documentation to be extended in a way which is effective in allowing International Authorities to properly update their databases:
 - (a) the current patent documentation and new publications should be documented, at least to the extent that they are included in the minimum documentation and preferably more generally;
 - (b) the places from which International Authorities (and other Offices and third party patent information providers) are able to access bulk information for inclusion into their search systems should be documented;

(c) from this information, the International Bureau (or another entity acting on behalf of the International Bureau) should hold a detailed catalog of relevant documents and sources from which they can be obtained and provide full or update lists to Offices regularly or on demand; and

(d) a set of criteria should be established describing what a Contracting State needs to provide in order for its patent documentation to be included in the PCT minimum documentation and the International Bureau should simply notify International Authorities of new collections which a Member State has requested be added to the minimum documentation, subject only to a formal check that the collection has been made available in the appropriate format and that new publications are being made available and notified in the appropriate manner.

3. Expert-level discussions between the International Authorities should determine the data required and appropriate formats in which it should be provided. This should be followed up by contacting national Offices to request as much of the necessary data as possible to be provided from the authoritative source.

BACKGROUND

4. At its 16th and 18th sessions, the Meeting generally approved the principle that the patent literature part of the PCT minimum documentation should be extended to include all patent documents which were made available in appropriate electronic formats, but noted that many technical issues needed to be addressed (see documents PCT/MIA/16/7, paragraphs 81 to 84 of PCT/MIA/16/15, PCT/MIA/18/11 and paragraphs 75 to 81 of PCT/MIA/18/16).

5. The most recent survey of the patent literature part of the PCT minimum documentation was published in November 2001 as part 4.1 of the *WIPO Handbook on Industrial Property Information and Documentation*¹. The lists of publication numbers were provided as ranges, but do not identify all numbers which were not used. Consequently, even at that time it was difficult to be certain whether a collection of documents in a database was complete. Since then, further publications have been made by the Offices listed in that survey, patent documentation has been explicitly added from China and the Republic of Korea, and other countries' documentation may, in principle, have become automatically included as a result of making it available to International Authorities in accordance with PCT Rule 34.1(c)(vi) (though the International Bureau is not aware of any national collections for which this is in fact the case).

GENERAL PRINCIPLES

6. The aim of the international search is to provide reliable information on any prior art which could be relevant to the novelty or inventive step of an international application according to the national laws of any PCT Contracting State. Improving the quality of search with regard to patent documentation should be addressed quickly and separately from the issues relating to non-patent literature because the PCT Member States can themselves act directly (with the help of the International Bureau where necessary and requested) to ensure that the patent documentation is available for International Authorities to use effectively in their search systems.

¹

<http://www.wipo.int/standards/en/pdf/04-01-01.pdf>

7. Ideally, the patent literature part of the PCT minimum documentation would extend to all patent documents ever published. However, this is clearly not practical. To maximize the extent of the search while being certain of what documentation is in fact available, it is necessary to identify criteria which:

- (a) encourage Member States to provide patent information regularly and in a form which allows effective searches to be conducted;
- (b) allow International Authorities to know the extent of the existing patent documentation and identify new documents which need to be loaded into their search systems, whether due to new availability of the documents or because of identifying existing gaps in the documentation which is included in their search systems; and
- (c) allow International Authorities to identify and use reliable sources for adding any further documentation required, which – bearing in mind that the ownership of and access to this material is directly in the hands of the PCT Contracting States – should be free of charge for use by the International Authorities in their search systems.

8. As a broader policy issue, such information should equally be available to the national Offices of other PCT Contracting States and third party patent information providers, though the relevant national Offices should remain free to determine the appropriate pricing arrangements should they wish to recover their costs in this way. Such availability should at least be considered for inclusion as part of the requirements to become part of the PCT minimum documentation in order to encourage the provision of patent documentation in a way which assists not only with international search but also with national search and technology transfer.

TECHNICAL ISSUES

9. The issues to be considered fall into essentially two categories:

- (a) How to collect information on the existence of patent publications and the formats and sources of the documents and data relating to these publications, and to present this information in a way which allows International Authorities to:
 - (i) check the completeness of their existing collections;
 - (ii) verify whether they are adding the documents and data for all new publications; and
 - (iii) recognize and use improved documentation (such as full text data) which becomes available for publications already contained in their existing collections.
- (b) To identify preferred formats of publications and associated bibliographic data which can easily be loaded into search systems by all International Authorities which maintain their own databases.

10. Annex I contains a first draft of the type of information which should be collected and made available in relation to each patent document which forms part of the PCT minimum documentation. Ideally, the same format of data should be delivered by all relevant Offices for three purposes: a major initial stocktaking, subsequent regular updates at the time of new publications, and indicating the subsequent availability of enhanced information or documents in new formats.

11. Annex II contains a first draft of a possible specification for the format and extent of data documentation which would allow a national patent collection to be added automatically to the PCT minimum documentation if a national Office agreed to provide it. It should be emphasized that this process is intended to extend the scope of the minimum documentation and should not reduce it in any way or force International Authorities to change their existing data sources if they already provide the necessary information in easily searchable format. Consequently, it must be clear that:

- (a) an indication that documents are available from a particular source does not mean that International Authorities are obliged to use that source if an alternative source is more convenient to them;
- (b) International Authorities should similarly be permitted to load data in formats which do not comply with the specification in Annex II if they prefer to do so, as long as it permits them to search the resulting database effectively; and
- (c) A “grandfather clause” should require International Authorities to maintain the use of sources of information in other formats relating to document collections which currently form part of the minimum documentation (both existing documents and new publications from the same Offices) which are not currently available according to the specification in Annex II.

PROPOSED WAY FORWARD

12. It is proposed to convene an informal electronic task force of experts from International Authorities to identify data formats:

- (a) for documenting and notifying the extent of existing patent collections and the delivery of new publications or of enhanced information or new formats of existing publications; and
- (b) for patent documents and associated data which all Authorities can easily import into their systems, such that it would be possible for such Authorities to guarantee that all documents which were made available to them in such a format could (where required) be added into their systems within 6 months of notification that the document or data existed.

13. On completion of this work, each national Office the patent documents of which are currently part of the PCT minimum documentation would be invited to provide a list of their patent publications going back to at least 1920 and also including earlier documents to the extent that they wish such earlier documents to become part of the PCT minimum documentation, and to prepare a system for providing equivalent information in the same format every time new publications are made. Ideally, the Offices would indicate the locations from which the relevant documents were electronically available at this stage if they provide such services; otherwise, the information on availability could be added at a later stage by the body which makes the information available on behalf of the originating Office.

14. Offices of States which are successors to former States the patent documents of which form part of the minimum documentation would be invited to perform the same tasks on the document collection of the former States. National Offices whose patent documents do not currently form part of the PCT minimum documentation would also be informed of the exercise and be invited to provide details of their patent collections in the same way if they so wished, though this would only lead to their documentation subsequently being included if they also ensured that they were made available in the agreed format.

15. Any Office would be permitted to nominate another Office to provide the information on its behalf if it considered that Office to have sufficiently complete information.

16. Offices would be invited to provide regular updates to indicate the publication of new documents or availability of enhanced data.

17. The information collected would be hosted by the International Bureau or by another party on its behalf, creating a catalog of documents with indications of where the documents and related abstracts and bibliographic data could be obtained. It would provide Offices (and preferably private sector patent information providers) with data files for catalog entries in the same format as used for notifications by Offices to cover at least:

- (a) Automatic daily digests of all updates to publications in the database.
- (b) One-off requests for complete documentation sets for a country or for all countries covered by the catalog.

18. When information concerning a new country's documentation is added to the database with an indication that the country wishes its documentation to become part of the PCT minimum documentation, the International Bureau (or a party acting on its behalf) would be responsible for checking that the indicated documentation was in fact available from the indicated source, both for the backfile documents initially provided and for at least two regular (typically weekly) publication updates. If this requirement is met, the International Bureau would notify all International Authorities that the relevant documentation would be considered to be part of the PCT minimum documentation with effect from 6 months after the date of the notification. Authorities would be required to include the backfile documentation in their databases by that date and then to add any necessary documents from the regular updates within a month of the notification of their availability.

19. The technical system should be running with complete coverage of at least the existing minimum documentation before a new PCT Rule 34 is brought into force.

LEGAL ISSUES

20. PCT Rule 34 would need to be amended to provide a new definition of the patent documentation. This would involve a general statement that the PCT minimum documentation included all patent documentation, including published utility model documents, which were made available in an accepted electronic format by or on behalf of a PCT Contracting State or former State of which a successor is a PCT Contracting State. The format would be defined in the Administrative Instructions. The Rule would include exceptions to what needs to be searched along the lines of those existing today, such as:

- (a) International Authorities would only be required to include one member of each patent family in their documentation.
- (b) International Authorities would not be required to search documentation where there was no family member and no abstract in English or in a working language of the Authority.

21. It is proposed to prepare a draft amendment to PCT Rule 34 to this effect for preliminary consideration by the PCT Working Group in 2012, taking into account any comments made by the Meeting on the general principles and the nature of exceptions which would be required. Taking into account the time which would be required to agree suitable data formats, audit the existing patent documents and ensure reliable delivery of information on new publications from at least the Contracting States the documentation of which currently forms part of the minimum documentation, it is likely that the aim in 2012 would be simply to confirm the general approval of the Contracting States for such a new approach and only to adopt a new Rule at the PCT Assembly in 2013, when it could be determined when it would be practical to bring it into force.

22. The Meeting is invited to comment on the proposed way forward set out in paragraphs 12 to 18, above, and to provide preliminary feedback on the specifications in Annex I and II which might form the basis for discussions of the Task Force referred to in paragraph 12, above.

[Annexes follow]

ANNEX I

DRAFT INFORMATION TO BE COLLECTED
CONCERNING EXISTENCE OF PATENT PUBLICATIONS
AND AVAILABILITY OF DOCUMENTS AND DATA

INFORMATION REQUIRED

The information required concerning the existence and updating of information about each publication (including multiple publications of the same application) might be as follows:

- Indication of whether entry relates to a new publication or an update concerning availability of previously notified documents or information relating to the publication
- Country code
- Publication number
- Kind of document code
- Publication date
- Reference to earlier full publication in case of notional republication (for example, PCT applications in national phase where the national Office gives a publication number but either publishes only a front page or else no actual new document at all)
- Priority application country codes and application numbers (as single field, where known)
- Code indicating format(s) in which publication is available from a particular source
- Code indicating format(s) and language(s) in which abstract is available from a particular source
- Code indicating format(s) in which extended bibliographic data is available from a particular source

This might be provided as a CSV or similar delimited text file with lines such as:

N, EP, 2387302, A1, 20111123, WO2010081998,
WO2010FR50062;FR20090000185;FR20090000186, , , EP1-st36;EP2-docdb

to represent new publication EP 2387302 A1, published 23 November 2011 as a republication of WO 2010/081998 with 3 priority applications. Because this is a virtual publication there is no specific document or abstract available, but extended bibliographic data is available in ST.36 format from server "EP1" or in docdb format from "EP2"; or

N, WO, 2011/144761, A1, 20111124, , EP10163604.1, IB1-st36;IB1-tiff, IB1-txt, IB1-st36

to represent new publication WO 2011/144761 A1, published 24 November 2011 with 1 priority application. Full text and image versions of the main publication as well as text abstract and ST.36 format bibliographic data are available from server "IB1" (PATENTSCOPE).

Issues for consideration would include:

- whether the publication numbers should be presented strictly as they originally appeared or be converted to an alternative, consistent format.
- whether to use original kind of document codes (if any) which were used in the original publication or codes which do not match the printed documents but more consistently describe the nature of the publication.
- whether special codes should be provided to notify the correction or removal of a record where an error had been discovered in what had been previously notified.

[Annex II follows]

ANNEX II

DRAFT SPECIFICATION FOR DOCUMENTS AND DATA
REQUIRED TO ALLOW PATENT DOCUMENTS TO BE INCLUDED AUTOMATICALLY
AS PART OF THE PCT MINIMUM DOCUMENTATION**TYPES OF DOCUMENT AND DATA REQUIRED**

BIBLIOGRAPHIC DATA

For each document which is to be included in the PCT minimum documentation, the following minimum bibliographic data is required for identification:

- Country code
- Publication number
- Kind of document code (if used in national system at relevant date)
- Publication date
- Title of invention
- Publication language

The following bibliographic information is strongly preferred and should be required for patent documents published after 1990 [*note: this is a year selected essentially as a guess as to when most Offices with numbers of publications which would be difficult to collect backfile information on would have automated their systems to the necessary extent. It should be revised depending on the assessment of the data currently available*].

- Application number (explicitly, even in cases where this is identical to the publication number)
- Application number of any earlier application of which this application is a divisional, continuation or similar
- Filing date
- Earliest priority date (if any)
- Priority application numbers (if any)
- At least 1 applicant name
- IPC (including edition)

Preferably, associated information should also be provided about all publications which are made in relation to a particular patent application (for example, republications of the application, publication of the granted patent, or publications of post-grant amendments), whether or not those publications are made available for the purpose of inclusion as part of the minimum documentation.

The bibliographic information should be provided as ST.36 XML in accordance with [*a DTD to be specified*], Unicode 3.0 compatible, encoded as UTF-8. This DTD provides for many other pieces of bibliographic information, which Offices are encouraged to include, but which are not required for inclusion of the associated document as part of the PCT minimum documentation.

PATENT DOCUMENT

Each document which is to be included in the PCT minimum documentation should be made available in at least one of the following forms:

- Image of document as collection of TIFF images (JPEG or PNG permitted for drawings section of document if color is used)
- Full text of description and claims in ST.36 XML format with referenced drawings in TIFF, JPEG or PNG format. Text should be Unicode 3.0 compatible, encoded as UTF-8.

ABSTRACTS

An abstract should be provided in text format at least for those documents which are not available in full text format. The abstract may be included as part of an ST.36 XML also including the description, claims and references to drawings, or else may be a separate file in TXT format (Unicode 3.0, UTF-8 encoded).

Preferably, an English language abstract should be provided – it is likely that exceptions to the requirement to include a document in the scope of search will continue to apply if neither the document itself nor an abstract are available in either English or a working language of the relevant International Authority.

[End of Annex II and of document]