

C. PCT 1660

January 4, 2024

Madam,
Sir,

Proposed modifications of the Administrative Instructions under the PCT (“the Administrative Instructions”) regarding PCT Minimum Documentation

This Circular is addressed to your Office in its capacity as an International Searching Authority (ISA), an International Preliminary Examining Authority (IPEA) and/or a designated or elected Office under the Patent Cooperation Treaty (PCT) for the purposes of consultation under PCT Rule 89.2(b). It is also addressed to certain non-governmental organizations representing users of the PCT System.

The purpose of this Circular is to consult on proposed new provisions of the Administrative Instructions which implement the amendments to Rules 34, 36 and 63 of the Regulations under the PCT (“the Regulations”) adopted by the PCT Assembly at its fifty-fifth session held in Geneva on July 6 to 14, 2023 (see document PCT/A/55/2, Annex II, and document PCT/A/55/4, paragraph 32), which will enter into force on January 1, 2026.

The above-mentioned amendments to the Regulations set out a revised definition of the minimum documentation that an International Searching Authority is required to consult during international search, along with changes to the minimum requirements that an International Searching and Preliminary Examining Authority needs to satisfy before it may be appointed and that it needs to continue to satisfy during its appointment.

The proposed modifications to the Administrative Instructions have previously been submitted by the PCT Minimum Documentation Task Force to the PCT Working Group (see document PCT/WG/16/6) and the PCT Working Group has taken note of the draft new provisions of the Administrative Instructions.

I. Proposed modifications of the Administrative Instructions

The proposed new provisions of the Administrative Instructions are as presented in document PCT/WG/16/6, except that an additional paragraph 23 in Part I of Annex H is proposed, following a suggestion by the European Patent Office and agreement within the PCT Minimum Documentation Task Force.

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The proposed new provisions of the Administrative Instructions contain a new Annex H of the Administrative Instructions, which sets out details of the technical and accessibility requirements and procedure for inclusion of patent and utility model documents, and non-patent literature in the PCT minimum documentation. That new Annex H would comprise two parts.

The provisions of Part I of Annex H aim at ensuring that all patent and utility model collections which are included in the minimum documentation are accessible free of charge to each International Authority. They establish a mechanism to allow the Offices concerned to publish relevant details about their collections, and International Authorities to access and effectively search those collections.

Part II of proposed new Annex H is dedicated to the non-patent literature. It sets out the process for International Searching Authorities to review the list of items of non-patent literature as referred to in current Rule 34.1(b)(iii) with a view to verifying that those items continue to meet the criteria for inclusion and to consider resources for addition to that list.

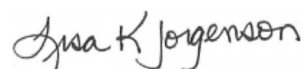
Detailed explanations of the proposed modifications are provided in paragraphs 4 to 22 of document PCT/WG/16/6.

./. The proposed modifications of the Administrative Instructions are set out in the Annex to this Circular.

II. *Comments on the proposed modifications of the Administrative Instructions*

Your Office is invited to provide comments, if any, by March 1, 2024, by e-mail to: pct.legal@wipo.int.

Yours sincerely,



Lisa Jorgenson
Deputy Director General
Patents and Technology Sector

Enclosure: Annex - Proposed modifications of the Administrative Instructions

PROPOSED NEW PROVISIONS OF THE PCT ADMINISTRATIVE INSTRUCTIONS

PART 1

INSTRUCTIONS RELATING TO GENERAL MATTERS

Section 116

Minimum Documentation

Patent documents made available under Rule 34.1(b)(i) for inclusion in the documentation referred to in Article 15(4) and utility model documents made available under Rule 34.1(c) shall comply with Part I of Annex H.

PART 5

INSTRUCTIONS RELATING TO THE INTERNATIONAL SEARCHING AUTHORITY

Section 521

Minimum Documentation

International Searching Authorities shall agree on the items of non-patent literature under Rule 34.1(b)(ii) for inclusion in the documentation referred to in Article 15(4) following the procedure in Part II of Annex H.

ANNEX H

TECHNICAL AND ACCESSIBILITY REQUIREMENTS AND PROCEDURE FOR INCLUSION OF PATENT AND UTILITY MODEL DOCUMENTS AND NON-PATENT LITERATURE IN THE MINIMUM DOCUMENTATION

INTRODUCTION

1. This Annex sets out the technical and accessibility requirements and procedure for inclusion of patent and utility model documents and non-patent literature in the minimum documentation, as defined in Rule 34.1.

PART I

PATENT AND UTILITY MODEL DOCUMENTATION

2. In this part, “patent documents” and “utility model documents” are as defined in Rule 34.1(a) and Rule 34.1(c), respectively.

Making Available of Documents and Use of Data

3. Each Office or successor Office whose patent collection, and, where applicable, utility model collection, belongs to the minimum documentation shall set up one or more secure repositories in which its text-searchable minimum documentation data is stored in either WIPO Standard ST.36 or ST.96 format, or in plain text format, or any combination thereof. Upon request by an International Authority, each said Office shall provide that International Authority with all the relevant information and authorization details necessary to access this data, for example the links, passwords, etc., so that it can access the data for free in bulk format electronically, preferably via FTP, SFTP or Web Services. Each Office shall ensure that all published data is made available in the said repository or repositories preferably within one month after its publication date, and in any event, no later than two months. If an Office also provides a search interface to its data, it shall preferably also provide access to such a search interface for free.

4. Any patent and utility model data made available by Offices to International Authorities within the context of paragraph 3 shall only be used by International Authorities for the purpose of conducting prior art search and related activities, including providing copies of cited documents to applicants and third parties. In case the said data is used for other purposes without the express consent of the providing Office, the access to the data in bulk format may be blocked by the providing Office, which would in turn inform the International Bureau accordingly.

5. Paragraphs 3 and 4 neither prevent Offices from having bilateral or multilateral agreements with the Offices providing the patent data to use and transform this data for other purposes, nor intends to replace any such existing bilateral or multilateral agreements.

6. Any Office whose patent collection and, where applicable, utility model collection belongs to the minimum documentation can delegate to an International Authority, or the International Bureau, the task of granting access to its data in accordance with the provisions set out paragraphs 3 and 4.

Authority File

7. The structure and file format of the authority file provided by an Office under Rule 34.1(d)(iii) and the data elements contained in that authority file shall comply with WIPO Standard ST.37.

8. For each publication, the authority file provided by an Office shall contain the following data elements referred to in WIPO Standard ST.37:

- (a) two-letter alphabetic code of the Office publishing the document (publication authority);
- (b) publication number;
- (c) kind code of the patent document as used by the Office publishing the document (kind-of-document code);
- (d) publication date of the patent document; and
- (e) subject to paragraph 10, indication of whether the abstract, description, claims of a publication are text-searchable, through selection of one of the following codes:
 - (i) "N" - Not available
 - (ii) "U" - Unknown
 - (iii) two-letter language code(s) in which the searchable text is available, either in the original language or in the language of an official translation.

9. The Office shall provide the data elements referred to in paragraph 8(a) to 8(d) as of [DATE OF ENTRY INTO FORCE OF AI] for each publication made by that Office or by its legal predecessor published on or after January 1, 1991.

10. With regard to the data elements referred to in paragraph 8(e), the Office shall provide indications:

- (a) from [DATE OF ENTRY INTO FORCE OF AI], at least for each publication on or after that date; and
- (b) from [DATE OF ENTRY INTO FORCE OF AI + 10 YEARS], at least for each publication or that of its legal predecessor on or after January 1, 1991.

11. Offices having documents available in text-searchable machine-readable form published between January 1, 1920 and December 31, 1990 shall preferably include, for these documents, the data elements referred to in paragraph 8(a) to 8(e).

12. An Office shall preferably provide a definition file in accordance with WIPO Standard ST.37 containing relevant publication exception codes that are present in its authority file and an overview of the scope of the document collections.

13. The International Bureau shall add any authority and definition files provided by an Office to the repository referred to in Rule 34.1(e) and shall make the repository available on the WIPO website. For each Office, the repository shall provide information on the date coverage of the authority file and information on dates and/or frequency of updates if provided to the International Bureau.

Making Available Documents Belonging to the Minimum Documentation

14. An Office shall make available in text-searchable machine-readable form in accordance with paragraph 17 any document published on or after [DATE OF ENTRY INTO FORCE OF AI] in its patent or utility model collection.

15. As of [DATE OF ENTRY INTO FORCE OF AI + 10 YEARS], an Office shall make available in text-searchable machine-readable form in accordance with paragraph 17 any document published on or after January 1, 1991 in its patent or utility model collection or that of a legal predecessor.

16. Where it is not mandatory to make a document available in text-searchable machine-readable form, an Office is recommended to make the document available in text-searchable machine-readable form in accordance with paragraph 17. Any document that is not made available in text searchable machine readable form shall preferably be made available in electronic form in accordance with paragraph 18.

Documents Made Available in Text-Searchable Machine-Readable Form

17. For each document that is made available in text-searchable machine-readable form, an Office shall provide International Searching Authorities with access to at least the full text of the abstract, description and claims in either XML format in compliance with WIPO Standard ST.36 or ST.96, or in plain text format. An Office shall also provide access to any electronically available sequence listings in a document. Each document in plain text format must have an unambiguous identifier, preferably the publication number, or otherwise, the application number. The same conditions as already described in paragraphs 3 and 4 also apply here.

Documents Not Made Available in Text-Searchable Machine-Readable Form

18. For each patent document or utility model document that is part of the minimum documentation but not made available in text-searchable machine-readable form, the Office or its legal successor shall provide International Searching Authorities, upon request, with access to a copy, preferably in electronic form. The copies of such documents shall preferably be in machine-readable electronic image format, e.g. PDF. For such documents, the code in the authority file for the data elements referred to in paragraph 8(e) should be "N" for elements that are not available in a text searchable format, or "U" for documents whose availability is unknown, or if the Office cannot easily provide an indication of such availability.

Optional Elements for Each Document in a Collection

19. Each Office shall preferably provide, insofar as they are available in machine-readable format, the following data elements for each document in its collection, using the appropriate tags foreseen for them:

- (a) the application number of the document;
- (b) the application numbers and filing dates of any earlier applications from which the patent or application claims priority;
- (c) the IPC (International Patent Classification) symbols assigned to the document;
- (d) any classification symbols assigned to the document according to any other classification scheme, e.g. CPC classification symbols or FI/F-term symbols.

Use of Publication Exception Codes

20. The authority file may optionally include the relevant publication exception code for any document in the collection of an Office for which the complete publication in machine-readable form is not available. If an authority file does not use publication exception codes, then for those documents that are not available in machine-readable format, the following applies:

- for documents that are not available in a text-searchable format, the code in the authority file for the data elements referred to in paragraph 8(e) should be "N".
- for documents whose availability is unknown, or if the Office cannot easily provide an indication of such availability, the code in the authority file for the data elements referred to in paragraph 8(e) should be "U".

21. Any publication exception codes included in the authority file shall be limited in the following ways:

- the code "P" shall not be used for patent documents published after [DATE OF ENTRY INTO FORCE OF AI];
- the code "X" shall not be used for patent documents published after [DATE OF ENTRY INTO FORCE OF AI] to indicate that a document is not available in machine-readable form; and
- as long as their use does not contravene the two immediately preceding bullet points above, an Office using specific customized codes before [DATE OF ENTRY INTO FORCE OF AI] may only continue to use those codes if it properly identifies the place where the definition of those codes is made freely available.

Notification to the International Bureau and Validation of Collections

22. The notification to the International Bureau under Rule 34.1(d)(i) shall specify the date as of which the patent documents and, where applicable, the utility model documents are available in accordance with the requirements set out in this Annex. Each Office shall provide access to its documents made available in text-searchable machine readable form as described in paragraph 3, as well as provide a link to its authority file and any definition file.

23. The International Bureau shall conduct the validations under Rule 34.1(e) as soon as possible after receipt of a notification under Rule 34.1(d)(i). The date from which the patent and utility model documents notified under Rule 34.1(d)(i) will become part of the minimum documentation shall be at least two months later than the date of publication in the Gazette of the details of the patent and utility model documents concerned.

PART II

NON-PATENT LITERATURE

Evaluation of Non-Patent Literature for Inclusion in the Minimum Documentation

24. Part II sets out the process for International Searching Authorities to review the list of items of non-patent literature referred to in Rule 34.1(b)(ii) ("the list") with a view to verify that items continue to meet the criteria for inclusion and to consider resources for addition to the list.

Criteria for Inclusion

25. An item must be represented by an individual title.
26. An item must be available electronically:
 - (a) to International Searching Authorities in at least one digital format that is readily available and acceptable to all Authorities, and
 - (b) to the public, online, for a reasonable commercial fee, as part of a personal or institutional subscription, or at no cost.
27. An item must be full text and accessible through an institutionally available search interface. Preferably, an item should also be available in a text-coded format that would allow it to be incorporated into a search interface. Full text, for the purpose of non-patent literature, is defined as an electronic resource that provides the entire text or content of a single work; not necessarily in a text-searchable machine-readable form.
28. Resources whose only electronic availability is as part of a subscription (“subscription-based resources”) must be institutionally accessible to be eligible for inclusion as an item; email subscription resources, or other personal use subscription resources, are not eligible for consideration. “Institutionally accessible” is defined as a resource that can be subscribed to or purchased by a single institution, with terms of use and search functionality applicable to all authorized users of the institution.
29. An item must provide terms of use that allow for copies of cited documents to be distributed to applicants as part of the international search and preliminary examination procedure, and to designated or elected Offices (DO/EO) upon request under Article 20(3) and Rule 44.3.

Updating the List of Minimum Documentation

30. A Task Force comprising representatives of International Searching Authorities (“the Task Force”) shall perform the review referred to in paragraph 24 and report on a regular basis to the International Searching Authorities. In that context, the Task Force shall convene a meeting every five years to undertake a comprehensive review of the list of items and any recommended resources based on the criteria in paragraph 34. International Searching Authorities shall agree on the International Searching Authority responsible for convening and organizing that meeting of the Task Force at least six months before the meeting.
31. Any International Searching Authority may recommend a resource that meets the criteria in paragraphs 25 to 29 for inclusion in the list by submitting a proposal to the Task Force at least four months before the meeting. The proposal shall include an explanation to show that the resource meets the criteria and may include information to accompany the recommendation such as details of usage of the resource, the need to include the subject matter of the resource in the minimum documentation, the value of the resource to search examiners, the impact factor of a journal resource, etc. The International Searching Authority shall provide the Task Force with any further information relevant to the recommendation if requested by any member of the Task Force.
32. The Task Force will not consider a resource that does not meet the criteria in paragraphs 25 to 29 for inclusion in the list.
33. Prior to the meeting, any International Searching Authority may comment on the suitability of a recommended resource for inclusion on the list, such as providing further

information on the usage of the resource, its contribution to the minimum documentation, and the impact of adding the resource on the list such as costs of obtaining access to the resource.

34. The Task Force shall evaluate the recommended resources for inclusion against the following:

- (a) the criteria in paragraphs 25 to 29;
- (b) international search report citation metrics from the preceding three years;
- (c) other evidence that demonstrate the value of a resource to an examiner performing international search and preliminary examination such as usage and examiner input;
- (d) subject matter of the resource, with a view to the list constituting a balanced representation of subject matter across all sections of the International Patent Classification scheme; and
- (e) cost of subscription or access to the resource.

35. The Task Force shall verify that existing items on the list continue to meet the inclusion criteria in paragraphs 25 to 29 and identify any items that have been discontinued.

36. Following the meeting referred to in paragraph 30, the Task Force shall submit a revised list to the International Searching Authorities for them to agree upon as the updated list under Rule 34.1(b)(ii). The revised list shall include any items recommended by the Task Force for addition to the list after the evaluation under paragraph 34 and all items that have been verified under paragraph 35 as continuing to meet the inclusion criteria and are either current or discontinued.

37. Notwithstanding the process in paragraphs 31 to 34, an International Searching Authority may share resources with the Task Force that are not on the list but could be useful for examiners to consult during international search. International Searching Authorities are also encouraged to ask questions or share any information and experiences that may contribute to enhancing the use of the minimum documentation during international search.

38. The International Bureau shall provide a mechanism for the public to suggest resources to consult during international search that are not on the list. The International Bureau shall share any such suggestion with the Task Force and ask the volunteer International Searching Authority, referred to in paragraph 41, to assess it. If it believes that the conditions are met, the volunteer International Searching Authority may recommend the resource to the Task Force for consideration in accordance with paragraphs 31 to 34.

Traditional Knowledge Non-Patent Literature

39. The present set of criteria applies to all sources of non-patent literature prior art, including Traditional Knowledge resources. Therefore, Offices recommending their Traditional Knowledge as part of the minimum documentation must comply with the present criteria. However, if, in the future, the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore and other relevant bodies within WIPO decide that Traditional Knowledge prior art should be treated differently than other non-patent literature prior art, then the Task Force shall meet to discuss additional criteria that is specifically directed to Traditional Knowledge resources in line with any new understanding on the treatment of such prior art.

Annual Review of List

40. The Task Force shall establish a schedule of volunteer International Searching Authorities to conduct an annual review of the list on a rotational basis for obsolete and discontinued resources, as well as metadata updates.

41. The volunteer International Searching Authority conducting the annual review shall verify the list for any discontinued or obsolete items and update any metadata from the list. This Authority shall share the findings from this review with the Task Force and provide the International Bureau with any updates that are required to the list, including removal of discontinued or obsolete items.

Access to Items on List

42. International Searching Authorities are required, at a minimum, to maintain full text access to the most recent five years of content calculated from the current date in the case of periodicals. When an item is added to the list, International Searching Authorities are required to obtain access to the item within two years from the date that the item is added.

43. An International Searching Authority may report to the volunteer International Searching Authority conducting the annual review under paragraph 41 at any time if it considers that an item on the list no longer meets the inclusion criteria in paragraphs 25 to 29, and inform the Task Force accordingly.

Appendix 1:

Example of an Authority File

Country Code	Publication Number	Kind Code	Publication Date	Exception Code (Optional)	Text-searchable Abstract as officially published Available? (Language codes/N/U)	Text-searchable Description Available? (Language codes/N/U)	Text-searchable Claims Available? (Language codes/N/U)	
1	EP	1	A1	19781220		de	de	de
2	EP	12493			U	U	U	U
3	EP	216086	A2	19870401	M	de	de	de
4	EP	272830	A2	19880629	M	en	en	en
5	EP	394856	A1	19901031		de,en	de	de
6	EP	394856	B1	19970604		en	de	de,en,fr
7								
8	CA	2787765	A1	20140222		en,fr	en	en
9								
10	CH	710284	A1	20160429		de	de	de
11	CH	711700	A2	20170428		it	it	it
12								
13	FI	101368	B	19980615		fi,sv	fi	fi
14	FI	20165833	L	20180508		fi,en	N	N
15								
16	WO	2010037978	A2	20100408		en,fr	fr	fr
17	WO	2021073392	A1	20210422		en,fr,zh	zh	zh

Table 1

The text below is a Version 2.2 ST.37 authority file, produced by an International Searching Authority or those Offices wishing their publications to be included in the minimum documentation set, represented using a TXT structure where the data elements are separated by a comma. It represents the data in Table 1 shown above:

...

EP,1,A1,19781220,ABST-de,DESC-de,CLMS-de<CRLF>

EP,12493,,,U,ABST-U,DESC-U,CLMS-U<CRLF>

EP,216086,A2,19870401,M,ABST-de,DESC-de,CLMS-de<CRLF>

EP,272830,A2,19880629,M,ABST-en,DESC-en,CLMS-en<CRLF>

EP,394856,A1,19901031,,,ABST-en,ABST-de,DESC-de,CLMS-de<CRLF>

EP,394856,B1,19970604,,,ABST-en,DESC-de,CLMS-de,CLMS-en,CLMS-fr<CRLF>

.....

CA,2787765,A1,20140222,,,ABST-en,ABST-fr,DESC-en,CLMS-en<CRLF>

.....

CH,710284,A1,20160429,, ABST-de, DESC-de, CLAMS-de<CRLF>

CH,711700,A2,20170428,,ABST-it, DESC-it, CLMS-it<CRLF>

FI,101368,B,19980615,,ABST-fi, ABST-sv, DESC-fi, CLMS-fi<CRLF>

FI,20165833,L,20180508,,ABST-fi, ABST-en, DESC-N, CLMS-N<CRLF>

WO,2010037978,A2,20100408,,ABST-en, ABST-fr,DESC-fr,CLMS-fr<CRLF>

WO,2021073392,A1,20210422,,ABST-en, ABST-fr, ABST-zh, DESC-zh, CLMS-zh<CRLF>

[End of Annex and of Circular]