

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

**Twenty-Second Session
Tokyo, February 4 to 6, 2015**

NON-PATENT LITERATURE UNDER THE PCT MINIMUM DOCUMENTATION

Document submitted by the Indian Intellectual Property Office

BACKGROUND

1. Article 15(4) of the Patent Cooperation Treaty (PCT) states that "the International Searching Authority [...] shall endeavor to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the Regulations". PCT Rule 34 contains the definition of the documentation referred to in Article 15(4). With reference to non-patent literature (NPL), the PCT minimum documentation comprises 145 journals.
2. Article 56(3) of the PCT states, *inter alia*, "[t]he aim of the [Committee for Technical Cooperation] shall be to contribute, by advice and recommendations: [...] (ii) to the securing, so long as there are several International Searching Authorities and several International Preliminary Examining Authorities, of the maximum degree of uniformity in their documentation and working methods and the maximum degree of uniformly high quality in their reports."
3. Out of the 45 adopted recommendations under the WIPO Development Agenda, two recommendations were as follows:
 - (i) "8. Request WIPO to develop agreements with research institutions and with private enterprises with a view to facilitating the national Offices of developing countries, especially LDCs, as well as their regional and sub-regional intellectual property organizations to access specialized databases for the purposes of patent searches."

(ii) “10. To assist Member States to develop and improve national intellectual property institutional capacity through further development of infrastructure and other facilities with a view to making national intellectual property institutions more efficient and promote fair balance between intellectual property protection and the public interest. This technical assistance should also be extended to sub-regional and regional organizations dealing with intellectual property.”

NON-PATENT LITERATURE AND CHALLENGES

4. With the availability of electronic databases, the patent literature part of the PCT minimum documentation is available in forms that allow an effective search to be conducted. For instance, private service providers make available raw as well as value added collections, having a uniform structure in a format compatible with WIPO Standards, containing documents of various offices. In fact, the IP Offices have undertaken, *suo moto*, the work of standardization of the contents of patent documents in the format prescribed by WIPO, which increases the efficacy of the data for the purpose of search.

5. The NPL forming part of the PCT minimum documentation also comprises material of particular relevance, not only for the International Authorities but also for national Offices. In some fields, such as biotechnology, the NPL assumes even greater importance due to the availability of a much higher percentage of potential prior art. The use of NPL for the purpose of conducting prior art search presents certain challenges which affect the efficiency of the examiners. Publishers use different models/formats for providing access to their resources and use different structures for arranging the data. Most of the non-patent literature is not classified according to classification systems such as the International Patent Classification (IPC). Search facilities of publishers and third parties allowing a single search in a number of titles are available due to which the challenge of searching the NPL part has reduced to a certain extent.

6. To further improve the search facilities with respect to NPL, some Offices acquire the data comprising a large number of titles of NPL from publishers and host the same locally on their internal servers or seamlessly access the data from servers of the publishers, through their internal customized electronic systems. This allows the examiners to dig out the information from a much larger set by conducting a single search using their internal search systems, though such a single search has its inherent limitations, such as, search capability being limited by the common fields available in the said data. It has been observed that conducting a search through the internal search systems of the Indian Patent Office in the NPL hosted locally on the internal servers is beneficial as compared to searching through the tools made available by the publishers or third parties. Local hosting allows the Authorities/Offices to customize their search systems to a much higher extent according to the needs of their examiners, thereby improving the efficiency of the examiners.

EXPERIENCES OF THE INDIAN PATENT OFFICE (IPO)

7. Efforts for procuring data in the full-text format were made by the IPO. The publishers were initially reluctant to provide full-text for local hosting on IPO's servers. Pursuant to consistent efforts made by the IPO, the publishers offered to provide access to their NPL data by using various methods such as providing (i) online only access through their respective web portals, (ii) XML data feeds till abstract level with online only access to HTML and PDF versions of full text and (iii) full-text data for storage on internal servers of the Office. The exercise of discussing the possibility of storing full text data on the internal servers was resource intensive, but provided encouraging results. It is felt that more publishers will agree to provide data in the format required by the IPO in due course. It is understood that some Authorities have existing arrangements with publishers in accordance with their own requirements.

8. The Indian Patent Office believes that, at least for the titles comprising the NPL part of PCT minimum documentation, along with the methods currently adopted by the publishers to provide access to the NPL, the publishers should also be required to provide full-text data of the

NPL in a pre-determined format. This will allow the Authorities and national Offices to use the information contained in the NPL in a more effective manner and also to handle issues such as inefficiency and non-uniformity in the structure of different databases of NPL part of the PCT minimum documentation in an effective manner. The Indian Patent Office, based on its recent experiences, is very hopeful that the concerns of publishers which preclude them from providing data in a particular format can also be addressed if a collective effort is made.

PROPOSAL BEFORE THE PCT WORKING GROUP

9. At the seventh session of the PCT Working Group held in Geneva from June 10 to 13, 2014, the Delegation of India submitted this proposal for developing standard format/formats in which a publisher should be willing to provide data to the International Authorities/national Offices, before a title can be considered for inclusion in the PCT minimum documentation (see document PCT/WG/7/28). It was also proposed that the publishers who are willing to provide data in the proposed format(s) may be identified. In the alternative, it was proposed that the issue may be referred to the task force set up to prepare a detailed draft of all the technical specifications relating to the proposal to amend PCT Rule 34.

DISCUSSIONS DURING THE SEVENTH SESSION OF THE PCT WORKING GROUP

10. Discussions of the proposal presented to the seventh session PCT Working Group are detailed in paragraphs 248 to 259 of the Report of the session (document PCT/WG/7/30).

11. The Delegation of Iran (Islamic Republic of) supported the proposal.

12. The Delegation of the United States of America preferred any further review of the proposal to take place in the context of the PCT minimum documentation task force, as was proposed in paragraph 10 of document PCT/WG/7/28. The Delegation did, however, question whether publishers would make the effort and incur additional expense merely for inclusion of their journals in the PCT minimum documentation, and whether it would be desirable to exclude useful documents that might not comply with the format from the PCT minimum documentation.

13. The Delegation of the European Patent Office was of the opinion that it was desirable to have consensus on technical standards for non-patent literature. However, the Delegation believed that adherence to such a standard by publishers should not be a condition for the inclusion of a scientific journal in the PCT minimum documentation. The journals currently listed in the non-patent literature part of the minimum documentation belonged to 30 different publishers, and it seemed unlikely that all of them would agree to such a standard, given that each had their own requirements. Technical documents should therefore be included in the minimum documentation based purely on technical merit and reference to prior art searching. The European Patent Office believed there was a solid basis of progress on this issue without compelling publishers to adhere to standards they might not necessarily want.

14. The Delegation of Japan believed that there was great merit in using commercial databases for conducting prior art searches of non-patent literature designated as PCT minimum documentation. Therefore, the Delegation was not able to commit itself to storing any non-patent literature from the PCT minimum documentation on the Japan Patent Office in-house databases. The Delegation was, however, always interested in procuring non patent literature documents and working to improve search efficiency and was interested in being informed of future discussions on this subject.

15. The Delegation of Ecuador stated that access to non-patent literature was a critical part of examination of patents, and commented on the need for support from WIPO in order to establish a mechanism which would allow the authors of scientific documents to assist its Office. An in-depth analysis was therefore required in order to have scientific databases which would provide support and assistance to examiners in developing countries.

16. The Delegation of Brazil indicated willingness to participate in consultations with the Delegation of India, which could address the concerns raised by other delegations on the proposal.

17. The Delegation of Kenya, speaking on behalf of the African Group, expressed its support for the proposal and looked forward to its discussion at the next session of the Working Group.

18. The Third World Network (TWN), an independent non-profit international network of organizations and individuals involved in issues relating to development, developing countries and North-South affairs, supported the proposal. The proposal aimed to ensure that Offices had access to non-patent literature that was included in the PCT minimum documentation, which would enable Offices to carry out the high quality search for prior art and thereby also enhancing the quality of granted patents. The Third World Network was of the view that by approving this proposal, the Working Group would send a positive signal with respect to the mainstreaming of implementation of the Development Agenda in its work, as this proposal was firmly anchored on both Recommendations 8 and 10, as was outlined by the Delegation of India.

PROPOSAL BEFORE THE MEETING OF INTERNATIONAL AUTHORITIES

19. It was noticed that there was an in-principle agreement on achieving consensus on technical standards for NPL. However, the views of the publishers were not available at that time. It is therefore proposed that the publishers may be requested by the International Bureau for their views as to the different formats in which access can be made available to the Authorities/Offices. The views of the publishers may be made available to the Authorities as soon as possible. This would enable a more informed discussion to take place.

20. The Meeting is invited to consider the issues outlined in this document and the proposal in paragraph 19, above.

[End of document]