

C. PCT 1544

July 9, 2018

Questionnaire on Non-Patent Literature, Traditional Knowledge-Based Prior Art and Inclusion of Databases in the PCT Minimum Documentation

Madam,
Sir,

This Circular is addressed to your Office in its capacity as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty (PCT).

In December 2016, the European Patent Office (EPO), as leader of the PCT Minimum Documentation Task Force (the Task Force), posted a high level position paper on the activities of the Task Force foreseen in 2017-18. This paper proposed the activities to be grouped into four objectives, as follows:

- Objective A: Create an up-to-date inventory of the patent literature and non-patent literature parts of the current PCT Minimum Documentation.
- Objective B: Recommend criteria and standards for including a national patent collection in the PCT Minimum Documentation.
- Objective C: Propose clearly-defined bibliographic and text components of patent data that should be present in patent collections belonging to the PCT Minimum Documentation.

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- Objective D: Recommend criteria and standards for the review, addition and maintenance of non-patent literature and traditional knowledge-based prior art, and afterwards assess, on the basis of the criteria that will have been established, the revised proposal from the Indian authorities on the inclusion of the Traditional Knowledge Digital Library (TKDL) database in the PCT Minimum Documentation.

In relation to Objective D, the United States Patent and Trademark Office (USPTO) responded to the invitation of the EPO for one of the other Task Force members to lead discussions on this objective. As a first step in these discussions, the USPTO has developed a questionnaire for International Authorities on their use in prior art searching of non-patent literature (NPL) and traditional knowledge-based prior art (TK) sources and databases containing these sources. The survey also includes questions on the addition of NPL and TK sources and databases to the PCT Minimum Documentation. The USPTO posted a draft of the questionnaire on the Task Force wiki on May 10, 2018, and invited other Task Force members to make comments on the draft by the end of May 2018.

./ The USPTO has since finalized the questionnaire, which is enclosed as an Annex to this Circular. You are invited to submit your responses to the questionnaire by September 7, 2018, preferably by filling in the electronic copy available on the WIPO website at <http://www.wipo.int/pct/en/circulars> and the Task Force wiki, and uploading your response to the Task Force wiki. Alternatively, you can email the response to pct.mia@wipo.int. You should also use this e-mail address if you would like to request access to the pages of the Task Force wiki.

With reference to the revised proposal for the inclusion of the Indian TKDL in the PCT minimum documentation referred to in Objective D, the Indian Patent Office posted a working document and revised access agreement on the Task Force wiki in June 2018. Authorities are also invited to add their comments to these documents through the wiki.

Yours sincerely,



John Sandage
Deputy Director General

Enclosures: Annex — Questionnaire on Non-Patent Literature, Traditional Knowledge-Based Prior Art and Inclusion of Databases in the PCT Minimum Documentation

Questionnaire to PCT International Authorities on Non Patent Literature (NPL), Traditional Knowledge-Based Prior Art (TK) and Inclusion of Databases in the PCT Minimum Documentation (PCT Min Doc)

Responding Office:

Name of contact person:

Position:

Email address:

Use of NPL:

1. Do you use sources of NPL and TK in searching that are not currently included in the PCT Min Doc? If yes, please describe those sources.
2. How do you keep your collection of NPL and TK prior art sources current?
3. How do you ascertain the technical accuracy and trustworthiness of new sources of NPL and TK prior art which you consider using for prior art searches, such as new journals and new databases?
4. With respect to sources of NPL and TK prior art including journals, periodicals, print collections and databases, please describe what standards those sources must meet to be used by your office in prior art searches. Please indicate, if applicable, which standards are preferences and which are firm requirements.
5. Regarding NPL and TK used as prior art, do you provide the applicant with a complete reference or with only a summary or citation to the reference? If a summary is provided, how detailed is it?
6. If your office does not provide the applicant with a copy of the complete reference, do you provide a link whereby applicant may access the reference such as through a digital object identifier (DOI)?

Addition of NPL and TK to the Min Doc:

7. Are there additional specific sources of NPL or TK that you would favor including in the PCT Min Doc? Which ones? Why?
8. Would you be willing to notify WIPO when a NPL or TK source is added or is removed from your collection, so that its addition to the PCT Min Doc could be evaluated?

Use of databases:

9. Does your office provide or maintain its own database of NPL and/or TK prior art? If so, is it available to the public? Is there a fee to access the database? Are there other restrictions to accessing the database? If so, what is the purpose of those restrictions?
10. With respect to sources of NPL and TK prior art including journals, periodicals, print collections and databases, please answer the questions below if not already addressed:
- (a) Do you use NPL or TK sources such as printed publications that do not provide the ability to conduct text searches and other database operations?
 - (b) Do you require the ability to load database information in your office's IT system?
 - (c) How sensitive are you to pricing of the databases?
 - (d) How significant is for your office the availability of English (or other language used by your office) language abstracts?
 - (e) Are currently available English-language abstracts of NPL and TK references sufficiently detailed to use in a PCT search?
 - (f) What level of detail provided by the abstracts or other translation do you consider sufficient to utilize a NPL or TK reference in a language not used by your office?
 - (g) Would you use a database from a commercial vendor, at an additional cost, if the vendor packaged otherwise available NPL or TK information in an easier to use format?
 - (h) Would you use a NPL and/or TK database if you were required to maintain its contents as proprietary and / or confidential information?

Addition of databases to the Min Doc:

11. With respect to sources of NPL and TK prior art including journals, periodicals, print collections and databases, please answer the questions below if not already addressed:
- (a) Would you oppose inclusion of a NPL or TK database in the PCT Min Doc because of high cost?
 - (b) Would you oppose inclusion of a NPL or TK database in the PCT Min Doc if you were required to maintain the information therein as proprietary and / or confidential information?
 - (c) Would you oppose inclusion of a NPL or TK database in the PCT Min Doc if you were prohibited from sharing the information therein with third parties or with the public?
12. Would you oppose inclusion of a required database in the PCT Min Doc if access to that database could be curtailed because of failure to abide by provisions mandated by the database provider?

13. Are you concerned that access to a required database in the PCT Min Doc could be interrupted by an asserted breach of an agreement with the database provider?
14. Do you foresee any difficulties for your office in including NPL and TK databases in the PCT Min Doc, as compared to the existing required journals and other NPL printed publications?
15. In your office, do you expect that requirements for handling databases listed in the PCT Min Doc would be different from those of printed publications? In what ways?
16. Is there something that WIPO can do to assist International Authorities in managing changes in the contents of the PCT Min Doc, such as mergers and discontinuations of journals and other references?

[End of Annex and of Circular]