

C. PCT 1286

January 19, 2011

Madam,  
Sir,

1. This Circular is addressed to your Office in its capacity as a receiving Office, International Searching Authority, International Preliminary Examining Authority and/or designated or elected Office under the Patent Cooperation Treaty (PCT). It is also being sent to interested intergovernmental organizations as well as certain non-governmental organizations representing users of the PCT system.
2. The purpose of this Circular is to provide information about a project currently undertaken by the International Bureau to develop a new IT system for use by external users who own or manage international applications filed under the PCT. The aim of the system is to provide a suite of secure online services that will add efficiency to the PCT system and provide opportunities to streamline business processes and communication methods between applicants/agents and the International Bureau and, ultimately, also with other stakeholders in the PCT process in later stages of the project.
3. Please find attached a system overview document that outlines the features and functions which are currently planned for implementation in the new system over a series of stages.
4. Although no feedback is specifically being sought at this time, the International Bureau would nevertheless welcome any comments, which may be submitted to the PCT Business Development Division of WIPO at the following e-mail address: [pctbdd@wipo.int](mailto:pctbdd@wipo.int).

Yours sincerely,



Francis Gurry  
Director General

Attachment: PCT Secure Online Services – System Overview

## PCT SECURE ONLINE SERVICES SYSTEM OVERVIEW

### INTRODUCTION

1. The International Bureau wishes to reinforce the PCT system as the most simple, cost-effective and user-friendly filing route for any applicant seeking international patent protection. One important aspect of further improving our services is to provide effective, secure systems for managing the files of international applications online. This will:
  - increase efficiency and confidence in the communications which are required between applicants and the International Bureau;
  - allow the applicant to check on the current status of the international application; and
  - increase the quality of processing of the international application by reducing the risk of errors and allowing the introduction of more efficient processes.
2. A major step in this process is the introduction of a new service, which is yet to be officially named, to allow pre-publication access for applicants and/or agents to the documents and up-to-date bibliographic data on file at the International Bureau. The system will also include and provide improvements to the existing PCT online services already launched by WIPO, namely, electronic versions of PCT forms to applicants via e-mail, Online Document Upload, PCT E-Payment and PATENTSCOPE®.
3. The current target is to complete the development of an initial pilot version of the system by the end of 2010 and to make it available to a subset of PCT users as of January 2011. This first pilot phase (“Stage 1”) will offer pre-publication online secure file inspection to an initially limited group of applicants and/or agents for international applications filed electronically at the receiving office of the International Bureau (RO/IB) using the PCT-SAFE software and a WIPO digital certificate. As the pilot progresses, participation will gradually be extended to increasing groups of users and also to international applications filed with other PCT receiving Offices using other types of electronic filing software. Ultimately, when sufficient experience has been gained with electronic filings, the system will be extended to include international applications filed on paper or filed electronically on physical media without the use of digital certificates. The system will eventually be available for use with any international application filed on or after 1 January 2009.

4. The system will gradually be extended to include additional secure online services, permitting applicants and/or agents to manage and interact with their international applications electronically by performing a wide range of actions directly online, for example, uploading data modifications relating to requests for change under Rule 92*bis* which will both reduce duplication of effort and accelerate the processing of such changes by the International Bureau.
5. The timing of the further developments to the system will be strongly dependent on testing and feedback from users. The International Bureau's first priority is to ensure that the system is secure, including the need for users to understand their own responsibilities in maintaining the security of their confidential information within the system. Subject to that overriding consideration, the International Bureau will seek to ensure that the services which are provided are as easy to use as possible and meet the actual needs of the applicants and agents who use the system.

#### **STAGE 1 – INITIAL PILOT FOR INTERNATIONAL APPLICATIONS FILED ELECTRONICALLY AT RO/IB**

6. The first use of the system will be a pilot involving a limited number of users responsible for international applications which meet all of the following conditions:
  - (i) the international application was filed in electronic form at the International Bureau using PCT-SAFE and a WIPO digital certificate for submission (for multiple applications filed by the same user, the same digital certificate must have been used); and
  - (ii) at the time when the user first seeks to view the contents of the international application's file, the digital certificate must still be valid, the international application must not yet have been published, the user must have access to Form PCT/IB/301 (Notification of receipt of record copy) as issued by the International Bureau for the international application in question, and no changes must have been notified under Rule 92*bis*.
7. The main new function at this stage will be to offer online inspection of the International Bureau's file for these international applications. The function has several significant component features:
  - provision of an account specific to an individual, which can be associated with one or more international applications for which he is responsible (normally as either applicant or agent);
  - system for reliably associating an international application with the account of a person authorized to act in relation to that international application ("first owner");
  - system for viewing the International Bureau's file relating to such an application at any time after the association has been made, whether the international application has been published or not;
  - system allowing the first owner to delegate to other account holders the right to view the file, including a system to provide confidence that the other account holder is in fact a person known to the first owner.
8. Further details of how these components will work are set out in the Annexes.

9. This first stage is expected to begin in December 2010 with around 30 agents from different countries and from different types of organization (in-house agents, large and small private practices) testing the user account facilities, together with a test version of the other components, which will not carry any real data. The same group will then begin an initial production pilot of the live system in January 2011. Depending on positive trials and implementation of any required changes, the pilot should be extended to a larger group of users around March 2011 and the system will then subsequently be opened up to any applicant with international applications meeting the criteria listed in paragraph 6, above, possibly towards the middle of 2011.

#### **STAGE 2 – EXTENSION OF SYSTEM TO INTERNATIONAL APPLICATIONS FILED ELECTRONICALLY WITH OTHER RECEIVING OFFICES AND OTHER DIGITAL CERTIFICATES**

10. The next expected stage would be to open up the system for use with international applications filed electronically at other receiving Offices and using digital certificates other than those issued by WIPO. The pre-conditions for this stage are successful completion of the pilot of Stage 1 and a confirmation of the security model for associating an international application with the first owner. It is expected that a pilot of this stage would launch at around the same time that Stage 1 was opened up to all qualifying users, namely, mid-2011.

#### **STAGE 3 – EXTENSION TO ALL OTHER INTERNATIONAL APPLICATIONS**

11. Stage 3 involves extending the system to all other international applications, notably including those filed on paper and those for which changes to the applicant or agent have been notified under Rule 92*bis*. In these cases, there is no digital certificate to give extra confidence that the account holder is the person who filed the international application and so the main requirement for this stage is confirmation of a security model for associating the international application with the first owner (see Annex II).

#### **STAGE 4 – ADDITIONAL SERVICES**

12. The International Bureau plans to offer a range of additional services through this facility. The priority of these services will depend on security issues, user feedback and resources required for implementation. The services under consideration include:
  - editing functions, allowing certain actions to be taken directly through the website instead of by filling in and uploading forms or letters;
  - improved portfolio management, allowing actions (notably Rule 92*bis* changes) to be undertaken for groups of international applications simultaneously;
  - improved management of digital certificates (expiry of a digital certificate can cause difficulty in creating an association between an international application and an account, as well as in accessing the account-based services);
  - web-based online filing.

#### **INFORMATION SHARING, FEEDBACK AND USER SUPPORT**

13. In order to promote awareness about the advantages of the new system for PCT secure online services and to provide reliable support for its users, WIPO will undertake a number of promotional and training activities, including webinars, electronic feedback mechanisms, online training material, regular reports in the PCT *Newsletter* and “news updates” on WIPO’s PATENTSCOPE® website.

[Annexes follow]

## ANNEX I

### DETAILS OF THE ACCESS RIGHTS FUNCTIONS ENVISAGED IN STAGE 1

#### ESTABLISHING ACCESS RIGHTS TO E-FILED APPLICATIONS FOR ONLINE PRE-PUBLICATION FILE INSPECTION (“E-OWNER” SET-UP)

1. In order to set up online access rights to an e-filed international application via the system during Stage 1, the following steps are required:
  - *E-File an international application:* The applicant/agent files an international application at RO/IB using PCT-SAFE and a WIPO digital certificate.
  - *Create a Basic WIPO User Account:* The applicant/agent creates a basic user account by registering online on WIPO’s website, resulting in the creation of an account with login based on a user ID and password which by default gives the registered user access to a number of WIPO online services that do not require any additional level of security, e.g., access to online discussion forums. Creation of the basic user account is entirely automated and the only confirmation required is for the applicant/agent to click on a link in an automatically generated e-mail to confirm that the e-mail address specified for the account is correct.
  - *Request upgrade of the basic user account for PCT secure online services:* The applicant/agent makes an online request via WIPO’s website to upgrade the basic user account to a higher level of security that will permit access to PCT secure online services. This step involves logging in with the newly-created basic user account and associating, or linking, that account with the WIPO digital certificate that the account holder used for submitting the international application at the time of filing. The upgrade process is validated automatically and immediately as long as the digital certificate in question is available for upload to the system from the workstation on which the request is being made, is still valid, has not been revoked and is not already associated with another user account. At the time of validation of the account upgrade for PCT secure online services, the system attributes a PCT Customer ID number to the user account, which is required for subsequent online actions (see below).
  - *“Associate” an international application with the upgraded user account:* The applicant/agent logs into PCT secure online services where he associates an already-filed international application with his upgraded user account by entering the international application number, international filing date and also the unique code appearing at the bottom of Form PCT/IB/301 as issued by the International Bureau for the international application in question. The international application is then automatically associated in the system with that upgraded user account (i.e., the holder of the account is flagged in the system as the “e-Owner” of that international application) provided that all of the following conditions are met:
    - (i) the code entered by the user matches the unique code appearing on Form PCT/IB/301 as issued by the International Bureau, or on any subsequently issued corrected versions of that form, and international publication has not yet taken place;
    - (ii) there has been no change of owner or agent registered with the International Bureau under Rule 92*bis* since the application was filed and prior to the request for association with a user account; and
    - (iii) the digital certificate used to upgrade the account for PCT secure online services is the same as the certificate that was used for submission at the time of filing the e-filed international application and is still valid at the time when the request is made to associate the user account with the international application in question.

2. The above steps may be repeated to associate the upgraded user account with additional e-filed international applications provided that the three conditions outlined above are met. Once the association is made, the applicant is able to use PCT secure online services to view the file contents of those international applications even before international publication, including some documents which are never available to the public even after international publication (such as documents relating to Chapter II).
3. **IMPORTANT:** Note that, on the day of international publication of an international application when Form PCT/IB/301 becomes a publicly available document via WIPO's PATENTSCOPE® website, the unique code appearing on any Form PCT/IB/301 issued by the International Bureau will be blocked by the system as a means of associating an upgraded user account with an international application for online access. As of the date of publication, a separate process will be required in order to obtain an access code from the International Bureau in order to set up online private file inspection. The details of such a process have not yet been fully defined at this stage and will most likely require a specific written request to be submitted by the applicant/authorized agent to the International Bureau. In any case, it is expected that, for the most part, the process to set-up online private file inspection will happen prior to international publication.
4. When a digital certificate used to upgrade a user account for PCT secure online services is about to expire, the e-Owner obtains a new digital certificate, logs into the secure service for user account administration via WIPO's website prior to the expiry of this current certificate and registers the new certificate with the account. As from this point, the new digital certificate will be required to log in, but access is nevertheless retained to international applications filed using the previous digital certificates which have already been registered with the account, provided that no change under Rule 92*bis* has taken place which affects the access rights of the e-Owner with regards to the international application. It will also be possible in a later release of the system to replace a digital certificate after it has expired, but in the early stages of the system this action may require assistance from WIPO Support staff.

#### **DELEGATING ACCESS RIGHTS TO OTHER INDIVIDUALS (“E-ASSOCIATES”)**

5. The e-Owner of an electronically filed international application, once established in the system by the procedure outlined above, may subsequently delegate online secure access rights to that international application to other collaborators (the “e-Associates”) via the PCT secure online services system, as per the following process:
  - *Perform an “e-handshake”:* This new dedicated function permits the e-Owner of an international application to create an association, or link, between his user account for PCT secure online services and the user account of an associate. A pre-condition for the e-handshake process is that the associate must have already created a basic WIPO online user account and upgraded it for PCT secure online services by way of a digital certificate, and the e-Owner must know the associate's PCT Customer ID number. If the above pre-conditions are met, the e-Owner can submit an “e-handshake” request via the system, by quoting the Customer ID of the associate in question, who is subsequently informed of the request by e-mail. If the recipient selects the dedicated link to confirm acceptance of the e-handshake request, an association is created in the system between the user accounts of the e-Owner and that of the newly-established “e-Associate.”
  - *Delegating access rights to e-Associates:* The e-Owner of an international application may delegate, and may subsequently also revoke, access rights to e-Associates for any international application for which he is recorded in the system as the e-Owner. Two distinct levels of access rights can be delegated:

“Editor rights” = user can access the IA freely and perform all processing functions, but cannot delegate any access rights to anyone else.

“Owner rights” = in addition to the editor rights described above, the user has the ability to sub-delegate Owner rights. An international application must have at least one e-Owner, but can have several; each e-Owner can subsequently delegate access rights to any e-Associate.

## **SUSPENSION AND DELETION OF ACCESS RIGHTS**

6. The International Bureau retains the right to be able to suspend or delete user accounts or to suspend or delete the association of an international application with a user account. The International Bureau is already able to revoke WIPO digital certificates, which would have the effect of preventing access to PCT secure online services to both e-owners and e-associates. Cases where these actions may be needed include:
  - changes of applicant or agent under Rule 92*bis* – any change in person or name (and in certain instances also a change of address) should result in the immediate temporary suspension of an association between the affected international applications and a user account, pending review of whether the change means that the account holder is no longer authorized to act in respect of the international application, in which case the association would be cancelled by an action taken in the system by the International Bureau;
  - the International Bureau receives a statement from a company declaring that an account holder who had access rights to an international application has left the firm without himself revoking or transferring his rights;
  - suspicion that the security of a user account may have been compromised, for example, the number of attempts to log in to a user account surpasses the maximum number of attempts.

[Annex II follows]

## ANNEX II

### **ESTABLISHING ACCESS RIGHTS FOR INTERNATIONAL APPLICATIONS FILED ON PAPER (INCLUDING APPLICATIONS FILED ELECTRONICALLY ON PHYSICAL MEDIA WITHOUT USE OF A DIGITAL CERTIFICATE)**

1. It is envisaged to base the business process for establishing an e-Owner and the subsequent delegation of access rights for paper filings on the process described above for electronic filings. The applicant/agent who wishes to set up online private file inspection for an international application filed on paper, or indeed for an international application filed electronically on physical media without the use of any digital certificate, could follow the steps below:
  - create a basic online WIPO user account;
  - select the dedicated function on WIPO's website to upgrade the basic user account for PCT secure online services – during that step, if the user does not already have a digital certificate, the system will make it possible to obtain a WIPO digital certificate, which would subsequently be used for the purposes of the account upgrade;
  - once the user has obtained a user account upgraded for PCT secure online services using a digital certificate, the account holder would follow the process described in Stage 1 to link his account with a particular international application by entering the unique code appearing on Form PCT/IB/301.
2. The usual pre-conditions regarding Rule 92*bis* requests and international publication still apply, namely, there must have been no change of owner or agent registered with the International Bureau under Rule 92*bis* since the application was filed, and the international publication must not have yet taken place. As explained above, if an international application has been published, or if there has been a change of owner or agent recorded for the international application, the code on the form PCT/IB/301 would no longer be confidential and an alternative process to obtain an access code from the International Bureau would be required.
3. The International Bureau would in particular welcome user comments and feedback on this proposal on the establishment of access rights for international applications filed on paper.

[End of Annex and document]