

C. PCT 1526

February 5, 2018

Madam,
Sir,

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

2. The purpose of this Circular is to consult on proposed modifications to the Administrative Instructions intended to facilitate electronic processing of international applications, the allowable length of file references and the shorting of the retention time for paper originals by Offices.

PROPOSED MODIFICATIONS TO THE PCT ADMINISTRATIVE INSTRUCTIONS

3. It is proposed to modify Sections 102, 109, 705*bis* and 713 of the Administrative Instructions. The proposed modifications are set out in the Annex to this Circular.

EXPLANATION OF THE PROPOSED MODIFICATIONS

Section 102 – Use of the Forms

4. It is proposed to add two new paragraphs (j) and (k) to Section 102.

5. Today, almost all PCT forms have corresponding DTDs to define the structure of the XML content in a machine-readable format as well as stylesheets to generate a view of the form easily read by humans. The stylesheets aim to produce a page-based rendering of the XML content which is readily recognizable as the corresponding PCT form, sharing a common look and feel with the paper forms in most respects. However, it is not always practical or desirable to ensure that the layout rendered by the stylesheet is exactly the same

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as the corresponding form in paper or PDF format and it is difficult to set out a generally-applicable description of the variations which would be appropriate. Proposed new Section 102(j) would provide that the layout rendered from the XML content of a form is acceptable if it is generated in accordance with a stylesheet provided by the International Bureau. This is intended to facilitate the use of forms based on XML content, allowing Offices to pass information to each other or to the applicant in machine-readable formats, which can greatly facilitate processing speed and accuracy.

6. In line with this new provision, the International Bureau would issue defined stylesheets for rendering the corresponding form if the information had been provided in XML format. This would be needed primarily for the following purposes:

(a) Where the form contains many options, most of which are unused in a particular case, it is not always desirable to show all of them – for example, in Form PCT/RO/106, some of the Annexes have around 100 checkboxes arranged in groups corresponding to more than 20 categories of possible defects. Listing potential defects which may not be relevant to a particular international application is necessary in a pre-printed form, but unnecessarily obscures the important information in a form which is generated specifically for the purpose of an individual international application. On the other hand, it is not appropriate to make a general statement that boxes which are not checked need not be shown, since in some cases, the form may be more difficult to understand or less useful if a line containing an unchecked box is not shown.

(b) As a consequential issue of what is set out in paragraph (a), above, it may not be desirable to make a page break in every place where one occurs in the paper form if only a small number of items from one page are relevant. The results are likely to be more easily read and less likely to give rise to the concern that information may have failed to be printed, since everything would appear on a single page, rather than multiple, mostly blank pages. On the other hand, where forms contain information, some of which is to be used elsewhere, certain page breaks may be essential. This is most notable in the international search report, Form PCT/ISA/210, where the “second sheet” (which, actually, is not only one “second” sheet but typically contains several pages) is split off to be appended to the published international application.

(c) Where the form contains free text areas, the text to be added may not always fit within the space available. In the paper form (such as the written opinions of the International Searching and Preliminary Examining Authorities, Forms PCT/ISA/237 and PCT/IPEA/408, respectively), this is handled by providing supplementary sheets to contain any overflow text. However, where a form is being generated for a specific international application, it will be both easier to produce and easier to read if the box is simply allowed to overflow onto the next sheet, rather than going into a supplementary box at the end of the form, disconnected from the first part of the text.

7. As such, for the case of information provided in XML format, the rules for which parts of a form must be shown and where page breaks are essential would be set out on a case-by-case basis in the stylesheets promulgated by the International Bureau.

8. Under proposed new Section 102(k), it would be permissible for a form to be sent in a character-coded format only (normally, but not necessarily, in XML format), without a copy rendered into a page-based easily readable format, provided that the recipient of the form has agreed to receive the information in such format only and, where necessary, that the recipient has agreed to prepare a page-based rendering if that is required for the file record. This would reduce costs for Offices, since it would minimize the need for Offices producing forms in XML format to maintain a page-based rendering of such forms.

Section 109 – File Reference

9. It is proposed to make a relatively small modification to Section 109, extending the permitted length of the file reference to 25 characters and explicitly permitting the use of the hyphen character as a separator.

10. Applicants have, over the course of many years, commented that the requirement in Section 109 that file references be a maximum of 12 alphanumeric characters is over-limiting. Systematic file references used by agents in private practice are likely to include identifiers for staff members, clients, patent families, regional issues and others, requiring separators in between.

11. In fact, the 12 alphanumeric character limit is not universally enforced. ePCT-Filing and PCT-SAFE strictly enforce the 12 character limit, but also allow hyphen characters (which are removed from filenames when creating the package for filing, since these would cause a conflict with the file naming convention which uses hyphen characters as separators for parts of the filename with different meanings). Furthermore, the restrictions are not generally observed for paper filings, applications prepared using certain other filing software or changes to the file reference made after filing.

12. An analysis of applications filed in 2015 found applications filed with 37 receiving Offices with file references greater than 12 characters in length, the longest being 31 characters (the International Bureau's systems are able to record file references with up to 50 characters, so this was presumably the longest actually received). Applications filed with 65 receiving Offices contained non-alphanumeric characters, most commonly hyphens and spaces (those two being used in applications from nearly all of the 65 receiving Offices), forward slashes, periods, underscores and brackets.

13. As far as can be determined, none of the special characters have in fact caused processing difficulties, save that the file reference is truncated in PCT forms issued by some Offices (for example, ISA/JP truncates longer file reference to 12 characters and ISA/EP to 18 characters).

14. In addition to proposing to extend the permitted length of the file reference to 25 characters, it is strongly recommended that Offices should ensure that their systems are able to handle the significant number of applications which already today extend beyond this new 25 characters limit, with a view to potentially relaxing the restrictions further at a later stage.

15. In case these modifications are adopted, further changes to at least the request form (Form PCT/RO/101) and paragraph 76 of the Receiving Office Guidelines will need to be implemented.

Section 705bis – Processing in Electronic Form of International Applications Filed on Paper: Home Copy, Record Copy and Search Copy

16. Under current Section 705bis(a), any receiving Office or International Authority wishing to process an international application electronically (including keeping electronic files) is supposed to notify the International Bureau of that fact. In practice, few such notifications have been received, though at least some degree of electronic processing is in place in almost all Offices. Given that electronic record keeping is now the norm, rather than the exception, it is proposed to delete the notification requirement. This is distinct from notifications concerning electronic filing under Section 710, which remain useful because of the importance of reliably informing applicants of the fact and conditions under which electronic filing is permitted.

17. Under current Section 705*bis*(c), where an international application is filed on paper but a copy in electronic form is kept as the record copy under Section 705*bis*(b)(ii), the original of the international application as filed on paper shall be kept, for a period of at least 10 years from the international filing date, by the International Bureau or, where so agreed by the receiving Office and the International Bureau, by the receiving Office on behalf of the International Bureau.

18. In respect of such cases where the international application is filed on paper but a copy in electronic form is kept as the record copy under Section 705*bis*(b)(ii), the International Bureau has received a request from a receiving Office, supported by several other Offices, to reduce the period during which receiving Offices are required to keep the original of the international application filed on paper from 10 to 5 years from the international filing date.

19. While the International Bureau does not immediately intend to reduce the length of time for which it keeps the original of the international application filed on paper, the proposed change would appear important to some receiving Offices so as to allow a consistent record retention policy for both national and international documentation.

20. Before the expiration of the proposed new 5 year time limit, each search copy (which is usually the same scan of the international application filed on paper as the record copy) will have been reviewed by the International Searching Authority, the record copy will have been reviewed by the International Bureau prior to publication and there will have been an opportunity for applicants and many patent information users to observe missing or poor quality sheets in the international publication. Consequently, there would appear to be very few cases where the original of the international application filed on paper would be required to verify the accuracy of the record copy. In practice, almost 99 per cent of requests to retrieve the original paper version of international applications occur prior to international publication. Very few requests are made during the national phase and the latest request which has been received was less than 5 years from the international filing date.

Section 713 – Application of Provisions to International Authorities and the International Bureau, and to Notifications, Communications, Correspondence and Other Documents

21. Under present Section 713(a), the provisions of Part 7 of the Administrative Instructions relating to the filing and processing in electronic form of international applications apply *mutatis mutandis*, except for a number of specific exceptions, not only to the receiving Office but also to the International Authorities and the International Bureau. Moreover, under present Section 713(b), the provisions of Part 7 apply *mutatis mutandis*, except for a number of specific exceptions, not only to international applications but also to notifications, communications, correspondence and other documents relating to international applications that are filed, processed or communicated in electronic form.

22. At present, Section 706 is one of the specific exceptions listed in both paragraphs (a) and (b) of Section 713, the effect of which is that applicants are not entitled to submit the pre-conversion format of a particular document as a back-up to its converted format. For example, at present, applicants are not entitled to submit to the International Bureau the pre-conversion format (say, MS Word) of Article 19 amendments which had been submitted to the International Bureau in XML format where those Article 19 amendments had originally been prepared in Word.

23. In particular with a view to encouraging the submission of Article 19 amendments in XML format by giving the reassurance of a back-up which can be used to correct any conversion errors, it is proposed to amend Section 713 by deleting the reference to Section 706 in both paragraphs (a) and (b) and thus to provide a legal basis for applicants to submit the pre-conversion format of Article 19 amendments filed in XML format.

24. This would be particularly significant in the context of the ePCT Article 19 amendment action, which permits the upload of a .docx file which is automatically converted to Annex F XML format.

25. In the longer term, it is hoped to encourage filing of XML documents more broadly and to consider giving a more direct legal basis to file formats such as .docx, from which machine-processable information can be reliably extracted in most cases, or problems detected at the time of upload otherwise.

COMMENTS ON THE PROPOSED MODIFICATIONS TO THE PCT ADMINISTRATIVE INSTRUCTIONS

26. Your Office is invited to provide comments, if any, to the International Bureau by March 30, 2018, by e-mail to: pct.legal@wipo.int.

Yours sincerely,



John Sandage
Deputy Director General

Enclosure: Annex – Proposed modifications to the Administrative Instructions under the PCT

ANNEX

PROPOSED MODIFICATIONS TO THE ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

PART 1 INSTRUCTIONS RELATING TO GENERAL MATTERS

Section 102 Use of the Forms

(a) Subject to paragraphs (b) to ~~(j)~~(k) and Section 103, the International Authorities shall use, or require the use of, the mandatory Forms specified below:

[List of forms omitted]

(b) to (i) [No change]

(j) The page-based rendering of a Form generated from a character-coded format shall be permitted if it is generated in accordance with a stylesheet provided by the International Bureau.

(k) A Form may be transmitted by one Office, International Authority or the International Bureau to another in character-coded format only, without its page-based rendering, if the recipient Office, Authority or Bureau has agreed to receive the information in such format and has agreed to generate any page-based rendering which may be required for file records.

Section 109 File Reference

(a) Where any document submitted by the applicant contains an indication of a file reference, that reference shall not exceed ~~42~~25 characters in length and may be composed of either letters of the Latin alphabet, or Arabic numerals, or both. The hyphen character (“-”) may also be used as a separator between alphanumeric characters.

(b) [No change]

PART 7 INSTRUCTIONS RELATING TO THE FILING AND PROCESSING IN ELECTRONIC FORM OF INTERNATIONAL APPLICATIONS

Section 705bis Processing in Electronic Form of International Applications Filed on Paper; Home Copy, Record Copy and Search Copy

(a) Where an international application is filed on paper, it may, subject to this Part, be processed and kept as a complete and accurate copy in electronic form prepared by the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau. ~~Any receiving Office, International Searching Authority or International Preliminary Examining Authority which proceeds under this paragraph shall notify the International Bureau accordingly.~~

(b) [No change]

(c) Where a copy in electronic form is kept as the record copy under paragraph (b)(ii), the original of the international application as filed on paper shall be kept, for a period of at

least ~~40~~⁵ years from the international filing date, by the International Bureau or, where so agreed by the receiving Office and the International Bureau, by the receiving Office on behalf of the International Bureau. The original shall be marked with the words “INTERNATIONAL APPLICATION – ORIGINAL AS FILED ON PAPER (SECTION 705*bis*)” or their equivalent in the language of publication of the international application on the bottom of the first page of the request and of the first page of the description.

(d) and (e) [No change]

Section 713

Application of Provisions to International Authorities and the International Bureau, and to Notifications, Communications, Correspondence and Other Documents

(a) The provisions of this Part, other than Sections 703(c), 704(c) to (g), ~~706~~, 707, 708(b)(iii) to (v), 710(a)(iv) and 714(b), shall, if they are capable of applying but do not expressly apply to the International Searching Authorities, the International Preliminary Examining Authorities and the International Bureau, apply *mutatis mutandis* to those Authorities and that Bureau.

(b) The provisions of this Part, other than Sections 703(c), 704(c) to (f), 705, 705*bis*(b) to (e), ~~706~~, 707, 708(b)(iii) to (v) and 710(a)(iv), shall, if they are capable of applying but do not expressly apply to notifications, communications, correspondence or other documents relating to international applications that are filed, processed or communicated in electronic form, apply *mutatis mutandis* to such notifications, communications, correspondence or other documents relating to international applications.

[End of Annex and of Circular]