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PATENT COOPERATION TREATY (PCT)

ADMINISTRATIVE INSTRUCTIONS
UNDER THE PATENT COOPERATION TREATY:

PROPOSED MODIFICATIONS RELATING TO THE
ELECTRONIC FILING, PROCESSING, STORAGE AND
RECORDS MANAGEMENT OF INTERNATIONAL APPLICATIONS

*prepared by the International Bureau for consideration at a
PCT informal consultation meeting on electronic filing,
Geneva, July 11 to 14, 2000*

INTRODUCTION

1. At its twenty-eighth (16th extraordinary) session, held in Geneva in March 2000, the PCT Union Assembly considered the implementation of electronic filing and processing of international applications. The Assembly's discussions were based on document PCT/A/28/3, which included proposed modifications of the Administrative Instructions under the PCT,¹ and the comments of delegations and user representatives on that document which were reproduced in documents PCT/A/28/3 Add.2 to Add.5. The discussions also took into account the documents reproduced in document PCT/A/28/3 Add.1 relating to the development of the necessary technical standard to enable implementation of electronic filing and processing of international applications. The Assembly agreed that proposed new Part 7 of the Administrative Instructions under the PCT (Instructions Relating to Electronic Filing, Processing, Storage and Records Management of International Applications) and draft Annex F of the Administrative Instructions (Standard for Electronic Filing, Processing, Storage and Records Management of International Applications) needed extensive redrafting, and that further consultations on the redrafted versions were necessary (see the Assembly's report, document PCT/A/28/5, paragraph 24).²
2. This document³ contains a redraft of proposed Part 7 of the Administrative Instructions for the purposes of continuing the consultation under Rule 89.2(b) which was begun in conjunction with the twenty-eighth session of the Assembly.
3. Proposed Annex F to the Administrative Instructions is also being redrafted and will be made available separately.

¹ References in this document to "Articles," "Rules" and "Sections" are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT ("the Regulations") and of the Administrative Instructions under the PCT ("the Administrative Instructions"), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO's Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>. References to "national law," "national applications," "national Offices," etc., include reference to regional law, regional applications, regional Offices, etc.

² The report and other documents for the Assembly's session are available on WIPO's Internet site at http://www.wipo.int/eng/document/govbody/wo_pct/index_28.htm.

³ This and other documents for consideration by the PCT informal consultation meeting on electronic filing are available on WIPO's Internet site at http://www.wipo.int/eng/meetings/2000/pct_ef/index.htm

PROPOSED MODIFICATIONS OF THE
ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

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AND RECORDS MANAGEMENT OF INTERNATIONAL APPLICATIONS

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Section 701

Definitions

For the purposes of this Part, unless the contrary intention appears:

[COMMENT: Definitions of terms are needed in Part 7 and Annex F.]

(i) “means” in connection with a document in electronic form, refers to the manner in which a document is transmitted, for example, by electronic means or physical means;

[COMMENT: Part 7 envisages that international applications (and related documents) may be submitted in electronic form by either electronic means or physical means. For example, an electronic transmission from computer to computer would represent a document in electronic form transmitted by electronic means while a floppy disk or CD-ROM mailed to an Office would represent a document in electronic form transmitted by physical means.

(ii) “electronic document format” refers to the presentation or arrangement of the information in a document in electronic form;

[COMMENT: Annex F currently provides for three permissible electronic document formats:

(a) Extensible Markup Language (XML), a subset of Standard Generalized Markup Language (SGML), which is the preferred electronic document format because it is based on international standards and character coded;

(b) standard image format (TIFF or JPEG); and

(c) PDF (industry de facto standard).

“Electronic document format” requirements include those relating to the acceptable character set. Draft Annex F, Appendix I, Attachment 1 sets out the acceptable character sets for documents submitted in XML format.]

[Section 701, continued]

(iii) “electronic signature” refers to information in electronic form which is attached to, or logically associated with, an electronic document and which indicates the signer’s approval of the content of the document;

[COMMENT: Annex F sets out the types of acceptable signatures. Each receiving Office accepting electronic filing will need to decide what type is acceptable to it (see Section 703(c)(i)). Each designated Office accepting international applications in electronic form will need to decide what type is acceptable in order to meet national law requirements when the applicant enters the national phase (see Section 711(b)).]

(iv) “digital certificate” refers to a record issued by a certification authority and which purports to ascertain the identity of a person or entity who holds a particular key pair, in the context of public key infrastructure;

[COMMENT: The term is referred to in Sections 703(c)(i) and 711(b). The definition is slightly modified from that which appears in Article 2(c) of the UNCITRAL Draft Uniform Rules on Electronic Signatures.]

(v) “certification authority” refers to a person who or entity which issues certificates or provides other services related to electronic signatures.

[COMMENT: The term is referred to in Section 703(c)(i). The definition is slightly modified from that which appears in Article 2 of the EC Directive on a Common Framework for Electronic Signatures.]

Section 702

Effect of International Applications in Electronic Form; Record Copy

(a) International applications filed in electronic form, subject to this Part, shall have the effect of a regular national application in each designated States as of the international filing date.

[COMMENT: By virtue of PCT Articles 11, 14 and 27(1) and Rule 89bis.1, an international application filed in electronic form in accordance with Part 7 (and hence Annex F) would be validly filed under the PCT and could not be denied legal effect, validity or enforceability solely on the grounds that it is in electronic form or that it existed at one time in electronic form. This is consistent with the general principle stated in UNCITRAL Model Law Article 5. Rule 89bis.2 would make this provision (and the other provisions in proposed Part 7) applicable to other documents submitted in relation to international applications.]

(b) Where an international application is filed in electronic form, the record copy in relation to that application for the purposes of Article 12 shall be:

(i) where the application is filed, whether by electronic means or by physical means, as a signed wrapped application document package in accordance with Annex F, a copy of that package;

(ii) where the application is not filed as a signed wrapped application document package in accordance with Annex F, a copy of the application as filed.

[COMMENT: For additional information concerning the creation of the “signed, wrapped application document package”, see Annex F, Appendix 1, Part 5. Where the international application as submitted is not in an electronic document format accepted by the receiving Office and Section 703(b) applies, the record copy does not include any corrections submitted with a view to bringing the application into an acceptable format: In such a case, however, the corrected application—in an electronic document format accepted by the receiving Office—will be used for practical purposes for subsequent processing. Both the record copy and the corrected copy will be sent by the receiving Office to the International Bureau.]

[Section 702, continued]

(c) Where the international application is filed in electronic form on a physical medium, the record copy does not include the physical medium.

(d) Where an international application is filed on paper, any receiving Office may choose to forward scanned images of the paper application in electronic form to the International Bureau as the record copy.

[COMMENT: This paragraph is designed to provide receiving Offices with the facility to transmit the record copy to the International Bureau in electronic form even where the international application was filed on paper. Several Offices have urged the International Bureau to permit this practice, particularly those Offices which scan incoming paper national and regional applications.]

Section 703

Acceptance of International Applications

Filed in Electronic Form

(a) An international application may be filed in electronic form by any means accepted by the receiving Office and shall be in one of the electronic document formats set out in Annex F which is accepted by the receiving Office. Each receiving Office which accepts the filing of international applications in electronic form shall accept at least one format for such filings from among those set out in Annex F.

[COMMENT: The acceptable electronic document formats are set out in Annex F, Appendix 1, Attachment 1.]

(b) Where the international application is not in an electronic document format accepted by the receiving Office, the receiving Office shall not be obliged to receive or otherwise process the application in such a format. If the receiving Office decides to receive the international application, it shall be considered not to comply with the prescribed physical requirements referred to in Article 14(1)(a)(v) and the receiving Office shall proceed accordingly.

[Section 703, continued]

(c) Each receiving Office which accepts the filing of international applications in electronic form shall notify the International Bureau accordingly, specifying:

[COMMENT: Rule 89bis.1(d) provides for receiving Offices to notify the International Bureau if they accept international applications filed in electronic form. Similar to the requirements concerning languages, fees and filing by facsimile transmission, applicants need to be on notice as to which electronic formats and the means are acceptable to which receiving Offices. Paragraph (c) thus requires receiving Offices to inform the International Bureau of the electronic formats and the means which the receiving Office will accept as well as other details. Details are set out in items (i) to (iv), under which the notification must include the specification of the requirements of the receiving Office and the electronic methods of communication accepted by the receiving Office, such as electronic mail, etc.]

(i) the means and electronic document formats accepted by the receiving Office from among those set out in Annex F, including, but not limited to, the requirements as to electronic signature, electronic envelope format, acceptable Certification Authorities, and acceptable classes of digital certificates;

[COMMENT: Annex F, Appendix 1, Part 3, contains details concerning the classes of digital certificates and Certification Authorities, and Part 4 contains details of the types of electronic signatures available.]

(ii) the conditions, rules and procedures relating to electronic receipt, including hours of operation, choices for acknowledgment processes, choices for electronic receipt of invitations and notifications, any methods of online payment, details concerning any help desks, electronic and software requirements and other administrative matters related to the electronic filing of international applications and related documents;

[COMMENT: The reference to electronic payment does not imply that receiving Offices are required to offer means of online payment.]

[Section 703(c), continued]

(iii) procedures which applicants may follow as alternatives when the electronic systems of the Office are not available for the filing of documents in electronic form;

(iv) any change to the matters indicated under items (i), (ii) and (iii).

(d) The International Bureau shall promptly publish in the Gazette any notifications furnished to it under paragraph (c).

[COMMENT: In relation to Certification Authorities (CAs), the International Bureau will publish the list of those specified by the receiving Offices as in (c)(i), and will include a link to the published certification policy statements of the CAs.]

(e) When the electronic systems of the receiving Office are not available for the filing of documents in electronic form, the receiving Office shall take action by means reasonably available under the circumstances to so inform applicants and potential applicants.

[COMMENT: An example of the “means reasonably available” would be a notification on the Internet site of the Office that its electronic systems are not available.]

(f) The effective date of a change of electronic document format or means accepted by a receiving Office under paragraph (c)(i), or of any other change which restricts filing options, shall be two months after the date of publication of the notification of such change in the Gazette; otherwise, the effective date of any change shall be determined by the receiving Office.

[Section 703, continued]

(g) Nothing in this Section shall prevent any receiving Office from accepting, in a particular case, the filing of an international application in electronic form by a means or in an electronic document format other than that which the receiving Office has notified the International Bureau that it accepts.

[COMMENT: By the wording “in a particular case” it is meant that, if the receiving Office is able to read the electronic document without resorting to extraordinary measures and if it chooses to do so, it may receive and process the international application despite the fact that it is not required to do so. A receiving Office is thus not limited by the indications notified by it under Section 703(c)—it could be more accommodating, where possible.]

(h) Any receiving Office may permit applicants to file, at the same time as any international application in electronic form, a copy of such application on paper. Where such a paper copy is received on the same day as the application in electronic form, the paper copy may be substituted for the application in electronic form by the receiving Office where the document in electronic form is unusable, and the receiving Office shall inform the applicant accordingly.

[COMMENT: An electronic submission would be defective or unusable when it is found to be illegible or is found to contain a virus or other malicious logic. Where no such paper copy has been filed, Section 706 would apply. The possibility of parallel paper filings has been included in response to the concerns expressed by the Delegation of Kenya at the March 2000 meeting of the PCT Assembly (see document PCT/A/28/5, paragraph 50), in relation to the consequences of submitting an international application in electronic form which was infected by a virus.]

Section 704

Signature of International Applications

Filed in Electronic Form

(a) An international application filed in electronic form shall be signed using a type of electronic signature accepted by the receiving Office in accordance with Section 703. Any international application so signed shall be considered to have been signed as required by the Treaty and the Regulations.

[COMMENT: Under Section 703(c)(i), receiving Offices must indicate their requirements as to electronic signature. Permissible types of electronic signature may be any or all of the following, which are explained in Annex F, Appendix 1, Part 4: a basic electronic signature (which can be a string of characters, a facsimile image of a signature or a “click-wrap” signature), or an enhanced electronic signature (for example, a digital signature supported by certificates). By deciding which electronic signature type(s) they will accept, receiving Offices should keep in mind the options which are reasonably available to the applicants who file with them. Under Section 711(b), designated Offices are also required to indicate the types of electronic signature acceptable to them, thus providing applicants with the information they need in order to comply with electronic signature requirements in the national phase.]

(b) Where a type of electronic signature other than a type accepted by the receiving Office is used, the receiving Office shall invite the applicant to furnish a complying signature, in accordance with Article 14(1)(b).

[COMMENT: This situation is analogous to paper. Where an electronic document is not signed in the manner prescribed by the receiving Office in accordance with Section 703(c)(i), it is in fact considered not to have been signed in accordance with Article 14 and the receiving Office makes the appropriate invitation to correct.]

Section 705

Acknowledgment of Receipt of International Applications

Filed in Electronic Form and by Electronic Means

(a) Subject to paragraph (b), each receiving Office which accepts the filing of international applications in electronic form and by electronic means shall, where possible and in accordance with Annex F, acknowledge receipt by electronic means of any international application so filed. Such acknowledgment shall include the identity of the Office, the date and time of the document's receipt, and an Office-assigned reference number or application number, if assigned.

[COMMENT: Rule 89bis provides that the Administrative Instructions should set out the provisions for acknowledgment of receipt of international applications filed in electronic form. This draft Section would make the default acknowledgment by electronic means for electronic filings, where it is possible for the receiving Office to do so; that is, where the receiving Office has the ability to do so and where the applicant has provided the necessary data (for example, an email address) so that an electronic acknowledgment can be sent. This Section should not be interpreted to mean that the document whose receipt was acknowledged was being treated as an international application or that it had received an international filing date (see paragraph 46, Assembly report).]

(b) Any applicant filing an international application in electronic form and by electronic means may indicate other means by which the applicant desires to receive acknowledgment of receipt of the international application from among those offered by the receiving Office and shall provide the necessary indications so that receipt can be acknowledged by the means indicated. Where the applicant makes such indications, the receiving Office shall acknowledge receipt by the means indicated.

[Section 705(b), continued]

[COMMENT: All Offices must have a default practice (indicated in paragraph (a)) in case the applicant does not make any indication about the type of acknowledgment he desires. Paragraph (b) allows the applicant to choose from the available means the one by which he wishes to have the receipt of his international application acknowledged. Applicants desiring to select such an alternative means of acknowledgment of receipt should select from those means indicated by the receiving Office in accordance with draft Section 703(c)(ii). The addition of the words “in electronic form” make this provision inapplicable to applications received by fax (fax transmission is an electronic means but the application is in paper form, not electronic form).]

(c) Where the receiving Office sends an electronic acknowledgment of receipt in accordance with paragraph (a) and it becomes apparent to that Office that the acknowledgment was not successfully transmitted, the Office shall promptly transmit such acknowledgment by other means where the necessary indications furnished to that Office so permit. The other means shall be described in the Office’s notification under Section 703(c).

[COMMENT: Where the receiving Office finds a problem with the electronic acknowledgment (for example, an e-mail is found to be undeliverable), the receiving Office should default to paper medium, preferably by fax, assuming the necessary indications have been furnished by the applicant. This puts an obligation on Offices to track what happens to their electronic acknowledgments and to make such fax capability available. As a practical matter, where the applicant files by electronic means and has not made an indication under paragraph (b) but does not receive an electronic acknowledgment of receipt from the receiving Office in accordance with paragraph (a) within a reasonable period after the filing, the applicant should consider resubmitting the application. Where no acknowledgment of an electronic filing has been received within such reasonable period, applicants would be on notice that it may be necessary to resubmit the application.]

Section 706**Legibility of International Applications Filed in Electronic Form; Infected Files**

(a) Upon receipt of an international application filed in electronic form in accordance with Section 703(a), the receiving Office shall check whether such international application is legible. If all or part of the international application is illegible [or appears to be distorted in meaning] or if part of the international application appears not to have been received, the international application shall be treated as not having been received to the extent that it is illegible, [has been distorted in meaning] or that the attempted transmission failed, and to the extent that Section 703(h) is not applicable, and the receiving Office shall, if possible, promptly notify the applicant accordingly.

[COMMENT: (1) Paragraph (a) is based on current Rule 92.4(c) and paragraph 16 of the Receiving Office Guidelines concerning transmission by facsimile or other like means. Paragraph (a) also reflects the practice currently in place for the filing of diskettes containing electronic data in connection with PCT-EASY filings (as set out in Circular PCT 697, paragraphs 37 and 38, December 22, 1998).

(2) The “if possible” language was included specifically because if the submission is an initial filing and the electronic file cannot be read, it may not be possible to contact the applicant. The receiving Office should attempt to do so, however, by sending a message to the originating electronic address. In such situations, draft Section 705(c) may apply and as a result the applicant who does not receive an acknowledgment of receipt will be on notice to re-file that submission.

(3) Other errors may occur in relation to the electronic filings which may result in partial illegibility of the application documents, for example, transposition of characters due to use of an incorrect code page or incorrect rendering of allowed characters in sequence listings. It is in the interest of all PCT Offices and Authorities as well as PCT applicants that automatic mechanisms to conduct a check for such defects should be explored for future use. However, while such solutions are being investigated, it is urged on all PCT Offices and Authorities that PCT Rule 91 be interpreted and applied liberally in the interests of applicants to allow the correction of such defects.]

[Section 706, continued]

(b) Any receiving Office which accepts international applications filed in electronic form in accordance with Section 703(a) shall check those applications for viruses and other forms of malicious logic. If it finds that an application is infected with a virus or other form of malicious logic, it shall promptly notify the applicant, may require the applicant to resubmit a clean copy of the application, and shall use all means reasonably available to it to read the document (for the purposes of performing an Article 11 check), including but not limited to printing the application. The receiving Office is not obliged to disinfect the infected files, but shall take all appropriate actions consistent with the objective of preserving, where possible, the international filing date.

[COMMENT: In accordance with paragraph (b), all Offices and Authorities which accept electronic submissions under the PCT are required to scan those submissions for the presence of viruses. The recommended methodology for carrying out this scanning will be included in Annex F and suitable software will be made available by the International Bureau to all receiving Offices participating in the WIPONET project (see PCT Assembly report (document PCT/A/28/5), paragraph 50). The WIPONET project will also include a central virus scanning system and the distribution of manuals containing security guidelines to all Offices which are users of the WIPONET. Annex F will be amended to contain explicit guidance on how the virus check referred to in this paragraph should be performed, for example, using what software and what criteria.]

(c) Where the International Bureau finds that an electronic document is illegible or is infected with a virus or other form of malicious logic, it shall promptly draw the situation to the attention of the receiving Office which transmitted the illegible or infected file and that Office shall proceed to investigate the cause of the infection or the illegibility. Where the international application as filed was so infected or illegible, the receiving Office shall proceed under paragraph (a).

Section 707

Processing of International Applications

Filed in Electronic Form and by Electronic Means

(a) Any receiving Office which accepts the filing of international applications in electronic form shall process such applications in accordance with Annex F.

(b) Where an international application is filed in electronic form and by electronic means, its date of receipt shall be the date on which the application is fully and successfully received by the receiving Office.

[COMMENT: Technical input will be necessary in order to better understand whether evidence could later be produced as to when an application is fully and successfully received and what type of evidence that might be.]

(c) Where the Treaty, the Regulations or these Administrative Instructions provides for the issuance of an invitation or notification and the international application has been filed by electronic means, such invitation or notification shall be transmitted to the applicant by electronic means in accordance with Annex F. However, the applicant may indicate other means by which he desires to receive invitations and notifications from among those offered by the receiving Office and shall provide the necessary indications so that such invitations and notifications can be communicated by the means indicated. Section 705(c) shall apply *mutatis mutandis* to such electronic notifications and invitations.

[Section 707(c), continued]

[COMMENT: (1) This proposal enables an Office to communicate invitations and notifications to the applicant by electronic means (for example by electronic mail) where the international application was received by electronic means. Paragraph (c) would allow applicants to indicate the means by which they wish to have their invitations and notifications sent in relation to international applications filed by electronic means, but Offices and Authorities must have a default practice in case the applicant does not make any indication. Receiving Offices are required under draft Section 703(c)(ii) to furnish these details.

(2) The reference to Section 705(c) in the last sentence means that Offices which send electronic invitations/notifications should default to paper, preferably fax, where it is clear that that invitation/notification has not been successfully transmitted. This obliges Offices to track what happens to their electronic notifications and invitations.]

(d) Where the Treaty, the Regulations or these Administrative Instructions provide for the incorporation of amendments of or corrections to an international application by a national Office or intergovernmental organization, the incorporation of such amendments or corrections into an international application stored in electronic form shall be undertaken in accordance with the principles in Section 708(c) and the electronic records management requirements of Annex F.

[COMMENT: Aside from following the Regulations and Administrative Instructions already in place, how an Office performs the amendment or correction on international applications in electronic form is a technical issue. This proposal merely recognizes that such a procedure should not impair the integrity of the application.]

Section 708

Storage of International Applications Filed in

Electronic Form

(a) All national Offices and intergovernmental organizations which accept or process international applications in electronic form shall keep and store records, copies and files in relation to such applications in accordance with Rule 93 and as provided in Annex F, including all documents in electronic form in connection with such applications.

[COMMENT: The purpose of paragraph (a) is to preserve, until the expiration of the time limits indicated in Rule 93, a chain of evidence containing the state of the application from the time it was filed until it was communicated to the designated Offices. The details of how that storage and record keeping is to be accomplished are dealt with in Annex F (Part 3.6 and Appendix I, Attachment 5). As stated in this Section, the records management practices of all Offices and Authorities which accept electronic filings will have to comply with these electronic records management (ERM) standards. It seems clear, however, that when an international application is filed electronically, as indicated in Annex F, the receiving Office will be obliged to make an archive copy of that electronic document for record keeping purposes and will ultimately forward the electronic application to the International Bureau, after having made copies for itself and for the International Searching Authority. (Note that any receiving Office which accepts electronic filings should be considered to de facto waive its "number of copies" requirement in relation to such filings, since copies can be made so easily.) It is important to note that Annex F, Part 3.6, states that "in order to ensure compliance with these [ERM] requirements, it could be foreseen that regular external audits of an Office's ERM implementation will be undertaken with the results being published by the IB." The mechanism for such audits will have to be discussed and agreed upon. Paragraph (a) also applies to the International Bureau.]

(b) All national Offices and intergovernmental organizations which accept or maintain electronic records shall certify that the electronic records in their control are maintained in accordance with the requirements of Annex F. A copy of that certification shall be made available on request to any party for purposes of presentation to any court of law or for use in other proceedings as evidence of the integrity and authenticity of the electronic records relating to international applications.

[Section 708(b), continued]

[COMMENT: This is based on a proposal by the Delegation of the United States of America (for a new Rule 93.5) referred to in the PCT Assembly's report (document PCT/A/28/5, paragraph 69). The Delegations of France and the United Kingdom reserved their position on this proposal and several delegations indicated their preference for third party certification or audits of compliance with the applicable requirements relating to electronic records management. This certification does not necessarily preclude the use of audits. It would mean that all Offices accepting electronic filings would have to be prepared to issue such certifications.]

(c) In fulfilling their obligations under paragraph (a), all national Offices and intergovernmental organizations shall comply with the following principles of electronic records management:

[COMMENT: The principles contained under this paragraph were previously contained in Annex F, Section 3.4.1 as standards S1 to S14.]

(i) all documents filed in electronic form shall be capable of being printed on paper, and transferred to archival media, without loss of content or material alteration;

(ii) information that is routinely collected by the automated systems concerning the record, often called "metadata," is to be considered part of the electronic records and maintained by the automated systems;

[COMMENT: A complete record as defined in archival science, and being more broadly accepted as a best practice consideration in electronic records management, has three primary elements: content, structure, and context.

"Content" is the actual data resulting from a transaction conducted in the normal course of business, such as from a receipt or creation process. For example, the filing of a patent application includes the application form with various data fields and a signature.

[Section 708(c)(ii), continued]

“Structure” is generally defined in two parts: logical structure and physical structure. The logical structure of a record are the identifiable parts of the record, such as the title, applicant and inventor(s) name, date, and signature on a patent application. These parts may be both computer identifiable, as in metadata, and/or human identifiable, as when rendered on a viewing screen or printer. The physical structure relates to the format of the record, such as the type font, spacing, page margins, logo, and the encoding of the file, which provide information for processing (rendering) or transferring of the record over the full retention period. “Context” is the meaning of the record, or the “what” and “why” of the business transaction from which the record was created or received. The context may be implicit in the content and structure of the record, such as a patent application which contains a form number or description and a signature block which states the specific intent of the signer.

One of the key requirements for admissibility in evidence in a court is that the record and the system receiving or creating the record store an “accurate” representation of the record. A record is more likely to be perceived as accurate and complete when as many elements of the record as possible are recorded, either within the content of the record or as metadata. The more complete a record can be shown to be, the more weight will be attributed to it for admissibility and for any subsequent cross-examination. It is recommended that the full content, structure and context of electronic records be acquired and stored. The complete electronic record document should be accessible and be able to be rendered on display screen or printer without any loss or alteration of content or structure for the full retention period. If the electronic document was originally generated on or from paper, then the appearance on the paper should be maintained, at least in the archived copy of the received document. If the submitted document only existed as a string of text, then that is all that must be archived. If the received information is simply bibliographic data, then the context of that data must be preserved. For example, if the applicant has answered questions on an input form, either on paper or on a web page, then at least the wording of the questions must be captured and associated with the data elements entered by the applicant. Thus if “1997” is entered by the applicant, then at least the relevant question, “What was the date of your invention?” must be captured. Even better would be the ability to recreate the screen into which the applicant placed the answer.]

(iii) archive copies shall be retained in the electronic document format in which they are submitted;

[Section 708(c), continued]

(iv) a mechanism shall be provided to ensure the authenticity and integrity of the electronically filed document; this requires the ability to verify the identity of the submitter (the applicant or authorized representative), as well as the ability to verify that a document has not been altered without authorization since it was filed;

[COMMENT: Note that the current thrust of the e-filing proposals would allow for filings in which there was no ability to “verify the identity” of the submitter, for example, those in which low-level, ad hoc certificates were used. This would mean that while electronic records management systems should have the ability to capture and store data relating to the authentication of the identity of the submitter, not all applications will be submitted so as to allow for such verification.]

(v) electronic filing systems shall provide backup and recovery mechanisms to protect electronic filings against system failures;

(vi) electronic records shall be maintained for long-term access and retention;

[COMMENT: The fundamental principle of electronic records management is to provide for long-term access and retention over the complete life cycle. Providing long-term access requires that every electronic case file or individual electronic record be searchable and retrievable and that it can be rendered (displayed) on a display screen or printer without loss of content or structure.

Retention requirements stipulate that the integrity of the electronic case file and associated records be preserved over the full life cycle, independent of changes in media technology or system obsolescence. As such, electronic records management solutions should not be predicated on a particular media or a single systems or application environment. The records should migrate to the newer technologies as they are installed, with no loss of content or structure.]

[Section 708(c), continued]

(vii) electronic records management systems shall provide mechanisms for quality assurance and quality control of the submitted documents;

[COMMENT: The Office is responsible for ensuring the accuracy of its application file management data. How an Office chooses to ensure accuracy is a local Office management decision. Electronic filing systems should enable the Office to review submissions and validate the accuracy of the application file management data before accepting and docketing an electronic filing. These functions need to be supported by both the electronic filing system and the receiving Office's other automation systems.]

(viii) electronic record management systems shall maintain an audit trail of all additions to or alterations of the electronic records, recording the receipt information or other information about the generation of each record and of all changes to the records.

[COMMENT: The audit trail essentially shows the use history of the electronic case file or record. From a records management and legal perspective, an audit trail details the "chain of custody" whereby the who, what, and when of each action, or event related to an electronic case file or record is evident. Events could include the creation or receipt, processing, access, routing, dissemination, copy, reformat, transfer, or disposal of an electronic patent case file. From a legal perspective, an audit trail can also be used to provide proof that, for admissibility as evidence in a court, the authenticity of a record has been maintained, that is, that the integrity of the content, structure and context has not been altered, misused or inappropriately destroyed.]

Section 709

Access to Electronic Form of Documents

(a) Where the Treaty, the Regulations or these Administrative Instructions permit access to the international application, and the international application was filed in or is stored in electronic form, such access may, at the option of the Office, be provided by the use of electronic means, in accordance with Annex F.

[COMMENT: This proposal provides for access to be given to international applications and related documents, in accordance with the existing provisions of the Treaty (Articles 30 and 38) and Regulations (Rule 94), by giving access to electronic copies of the application or related document. Annex F will contain recommendations on how such access could be provided (for example, by furnishing electronic copies of documents or by secure online access once entitlement has been verified). Such access to electronic documents, particularly when requested by applicants desiring access to their own application or file, also raises the issue of the authentication of identity of the applicants (for example, via electronic certificates). This provision should also provide the basis for access to information about the status of the filing as the USPTO is doing with its PAIR system and the EPO is doing with its online register of European patent application data via EPOLine. Under future automated systems, all PCT applications will be held in electronic form, either by the applicant submitting an electronic version or by scanning/OCR, etc. Thus, there will always be an electronic version which can be given for access.]

(b) If access to confidential data by electronic means is allowed, this access shall be secure and shall be available to authorized viewers only. Measures to assure the protection of these files from alteration shall be taken.

[COMMENT: The published case files and dockets of the Offices are public records where so provided by the PCT. Regardless of the electronic filing process that is adopted, adequate public access outside the Office is recommended. If an Office chooses to image its paper submissions and combine them with electronically filed documents to form a single electronic case file, then the public should have electronic access to all documents in the electronic case file, whether or not they were originally submitted in electronic form. This does not require extensive conversion of non-electronic filings if the Office chooses not to maintain a single electronic case file for all its filings.]

[Section 709, continued]

(c) Access to computers used for electronic filing shall not jeopardize the security of other Office networks and applications.

[COMMENT: The public must not be permitted access to internal Office networks or computers upon which Office operations are performed. One way to isolate Internet web sites that may be used for electronic filing is to use an Internet firewall. Additional network security methods can be combined with a firewall to further enhance network security. Similar security precautions should be taken for electronic filing implementations.]

Section 710

Applicability to National Offices and Intergovernmental Organizations

The provisions of this Part shall apply *mutatis mutandis*, to the extent applicable, to any document relating to the international application which is received in electronic form by any national Office or intergovernmental organization.

[COMMENT: This provision makes the provisions of Part 7 applicable, in particular, to International Searching Authorities and International Preliminary Examining Authorities.]

Section 711

Requirements of Designated Offices

(a) No designated Office which accepts documents in electronic form shall, subject to this Part and Rule 51bis, require compliance with requirements relating to international applications submitted in electronic form other than those contained in this Part and Annex F.

[COMMENT: The goal of paragraph (a) is to make clear that, while compliance with the standard in Annex F is not mandatory for applicants, such compliance is very attractive for applicants since compliance means that only certain, specified adjustments required to be made by designated Offices for national phase entry. The making of this paragraph subject to Rule 51bis is to provide that PCT Contracting States can require certain categories of further evidence in relation to information which the applicant provided in his application when filed in electronic form in accordance with the standard in Annex F. Rule 51bis will need to be amended to allow designated Offices to require:

(a) an “enhanced electronic signature” in the national phase where a “basic electronic signature” was employed when the application was filed;

(b) the furnishing of a “recognized certificate” in the national phase where an “ad hoc certificate” was employed when the application was filed.

Consistent with Art. 11(3), 11(4) and 27(1) PCT, designated Offices cannot question the validity of the signature mechanisms used in the international phase provided they are selected from the list specified in the standard. It remains an objective that there be one type of signature that is acceptable to all ROs and DOs. A step in this direction may be the acceptance by all ROs of the EES (Digital Signature). The software being created by the International Bureau (see the PCT Assembly report, document PCT/A/28/5, paragraph 32) will support all acceptable types of signature.]

[Section 711, continued]

(b) Each designated Office which accepts the filing of international applications in electronic form shall notify the International Bureau of the type of electronic signature and the classes of digital certificates from among those set out in Annex F which are accepted by it. The International Bureau shall promptly publish in the Gazette any such notifications.

[COMMENT: See the PCT Assembly report, document PCT/A/28/5, paragraph 45. Receiving Offices notify this same information under Section 703(c)(i)].

(c) Any designated Office may request the International Bureau, or where applicable, the receiving Office, to furnish to it a copy on paper of any document which was filed or is stored in electronic form.

[COMMENT: This paragraph is designed to cover the situation of designated Offices requiring paper documents from the International Bureau (see PCT Assembly report, document PCT/A/28/5, paragraph 27) and also ISA and IPEAs as stated in EPI comments (document PCT/A/28/3 Add. 2, Annex IX (EPI)). As noted in the Comment to 702(a), in accordance with paragraph 27 of the Assembly report, paragraph (a) would require any designated Office which receives documents on paper from the International Bureau which were originally filed in electronic form to give full force and effect to such documents, subject to the Office's being satisfied as to the authenticity of the document.]

[End of document]