



WORLD INTELLECTUAL PROPERTY ORGANIZATION
ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE
GENEVA/GENÈVE

ADMINISTRATIVE INSTRUCTIONS UNDER THE
PATENT COOPERATION TREATY (PCT)
STANDARD FOR THE ELECTRONIC FILING AND PROCESSING
OF INTERNATIONAL APPLICATIONS

INSTRUCTIONS ADMINISTRATIVES DU
TRAITÉ DE COOPÉRATION EN MATIÈRE DE BREVETS (PCT)
NORME CONCERNANT LE DÉPÔT ET LE TRAITEMENT ÉLECTRONIQUES
DES DEMANDES INTERNATIONALES

PROPOSAL FOR CHANGE FILE DOSSIER RELATIF À LA PROPOSITION DE MODIFICATION			
SUBJECT: Means of Communication (Part 7, Section 709) SUJET: Moyens de communication (7 ^{ème} partie, Instruction 709)		PROPOSED BY: JP PROPOSÉE PAR:	
HANDLING: Annual cycle TRAITEMENT: Cycle annuel		PROPOSED DATE OF ENTRY INTO FORCE: — DATE PROPOSÉE D'ENTRÉE EN VIGUEUR:	
ANNEX/ ANNEXE	CONTENT/CONTENU	ORIGIN/ ORIGINE	DATE
1	Proposal/Proposition	JP	28.02.02
2	Circular C.PCT830/Circulaire C.PCT830	IB	04.04.02
3	Comments/Commentaires	AU	09.05.02
4	Comments/Commentaires	CA	13.05.02
5	Comments/Commentaires	US	15.05.02
6	Comments/Commentaires	KR	17.05.02
7	Proposal withdrawn (by the International Bureau)/ Proposition retirée (par le Bureau international)	IB	25.11.02

[Annex 1 follows/
L'annexe 1 suit]

NEXT ACTION: —	BY: —
PROCHAINE ACTION: —	POUR LE: —

PROPOSAL BY THE JAPAN PATENT OFFICE

Administrative Instruction Part 7
Section 709 (Page 10)

(a) Where an international application is filed in electronic form and by electronic means of transmittal, the receiving Office shall, if practicable, send any notifications, invitations and other correspondence to the applicant by electronic means of transmittal in accordance with Annex F, or by such other means indicated by the applicant from among those offered by the Office.

(b) Where it appears to the receiving Office that a notification, invitation or other correspondence sent to the applicant by electronic means of transmittal was not successfully transmitted, the Office shall, if practicable, promptly retransmit the notification, invitation or other correspondence by the same or another means.

(c) For a notification, invitation or other correspondence sent to the applicant by electronic means of transmittal, its reception by the applicant shall complete when it is delivered to and stored in the system that the applicant owns. In addition, the applicant (or the system the applicant uses) shall notify the reception to the receiving Office.

(d) When a notification, invitation or other correspondence is sent to the applicant by electronic means of transmittal, its receipt date shall be the date when its delivery is acknowledged in accordance with the procedure in Section 709(c) above.

(e) At times when the electronics systems of the receiving Office are not available for the filing of documents in electronic form or by electronic means of transmittal, the Office shall, if possible, promptly publish information to that effect by means reasonably available to it under the circumstances, for example, by including a notice on the Office's Internet site, if any.

[Annex 2 follows/
L'annexe 2 suit]

April4,2002

Madam,
Sir,

*Standardfortheelectronicfilingandprocessingof
internationalapplications:Proposalsforchange*

ProposedmodificationsoftheAdministrativeInstructionsunderthePCT

1. This circular concerns proposals for change to the standard for the electronic filing and processing of international applications under the Patent Cooperation Treaty (PCT) which will, if adopted, result in modifications of Part 7 and Annex F of the Administrative Instructions under the PCT. It is being sent, for the purposes of consultation pursuant to Rule 89.2(b) of the Regulations under the PCT, to the national and regional patent Offices of, or acting for, all PCT Contracting States, including all receiving Offices, International Searching Authorities, International Preliminary Examining Authorities, and designated and elected Offices, and to interested intergovernmental organizations, as well as to certain non-governmental organizations representing users of the PCT system.

2. The International Bureau has received a number of proposals for change to the standard for the electronic filing and processing of international applications which, if adopted, would result in modifications of Annex F of the Administrative Instructions under the PCT, together with related proposals for amendment to certain provisions of Part 7 of the Administrative Instructions.

3. The proposals are available on WIPO's Website (see http://www.wipo.int/pct/efiling_standard/en) as an annex to the following "Proposal for Change" (PFC) files:

- PCT/EF/PFC02/001 relating to Part 7, Section 709 "Means of Communication" (proposal by the Japan Patent Office);
- PCT/EF/PFC02/002 relating to Annex F, section 4 "IA Documents Packaging" (proposal by the Japan Patent Office);
- PCT/EF/PFC02/003 relating to Annex F, section 5 "Transmission" (proposal by the Japan Patent Office);
- PCT/EF/PFC02/004 relating to Annex F, Appendix I, section 4.1 "Package header" (proposal by the Japan Patent Office);

- PCT/EF/PFC02/005 relating to Annex F, Appendix I, section 3 “DTDs for new PCT applications (E -PCT)” (proposal by the United States Patent and Trademark Office);
- PCT/EF/PFC02/006 relating to Annex F would add a recommendation on a file naming convention (proposal by the United States Patent and Trademark Office);
- PCT/EF/PFC02/007 relating to Annex F, Appendix I, section 4.1 “Package header” (proposal by the United States Patent and Trademark Office);
- PCT/EF/PFC02/008 relating to Part 7, Section 703 “Filing Requirements; Basic Common Standard ” (proposal by the United States Patent and Trademark Office).

4. The International Bureau would appreciate receiving any comments on the proposed modifications by May 15, 2002. Comments should preferably be made by e-mail via the “Submit comments” facility on the Website, but may alternatively be made in writing by letter or by fax to +41(22)3388040. Comments will be included as Annexes to the relevant PFCs. Copies of the proposals on paper are available from the International Bureau on request. Inquiries concerning the proposals should be directed to Mr. Thiam Ming Song (e-mail: song@wipo.int; phone: 41(22)3389640; fax: 41(22)3388040).

5. In Circular C.PCT827, which is also dated April 4, 2002, the International Bureau proposes other modifications of the Administrative Instructions which would add to Annex F a new section 2.5 “Change procedure” dealing with special procedures for the proposal, consideration and implementation of future modifications of the standard for electronic filing and processing of international applications. It is intended that consideration of the proposals referred to in the present Circular will proceed independently of those other proposals.

6. The International Bureau intend to promulgate by June 30, 2002, the modifications proposed in the present Circular, revised if necessary in the light of comments received. It is envisaged that the modifications would enter into force on January 1, 2003.

Sincerely yours,

Francis Gurry
Assistant Director General

OMPI CIRCULAIRE C.PCT830

Le 4 avril, 2002

Madame,
Monsieur,

*Norme concernant le dépôt et le traitement électroniques
des demandes internationales : propositions de modification*

Propositions de modification des instructions administratives selon le PCT

1. La présente circulaire concerne des propositions de modification de la norme concernant le dépôt et le traitement des demandes internationales selon le Traité de coopération en matière de brevets (PCT) qui, si elles étaient adoptées, aboutiraient à la modification de la septième partie et de l'annexe F des instructions administratives du PCT. Elle est adressée, aux fins de la consultation prévue à l'article 89.2.b) du Règlement d'exécution du PCT, aux offices de brevets nationaux et régionaux de tous les États contractants du PCT ou agissant pour eux, notamment l'ensemble des offices récepteurs, des administrations chargées de la recherche internationale, des administrations chargées de l'examen préliminaire international et des offices désignés et élus, ainsi qu'aux organisations intergouvernementales intéressées et à certaines organisations non gouvernementales représentant les utilisateurs du système du PCT.
2. Le Bureau international a reçu un certain nombre de propositions de modification de la norme concernant le dépôt et le traitement électroniques des demandes internationales qui, si elles étaient adoptées, entraîneraient des modifications de l'annexe F des instructions administratives du PCT, ainsi qu'un certain nombre de propositions concernant les changements correspondants à apporter à certaines dispositions de la septième partie des instructions administratives.
3. Ces propositions peuvent être consultées sur le site Web de l'OMPI (voir http://www.wipo.int/pct/efiling_standard/fr) en tant qu'annexes des dossiers de propositions de modifications suivants :
 - PCT/EF/PFC02/001 concernant l'instruction 709 de la septième partie, intitulée "Moyens de communication" (proposition de l'Office des brevets du Japon);
 - PCT/EF/PFC02/002 concernant la section 4 de l'annexe F, intitulée "Empaquetage des documents constitutifs des demandes internationales" (proposition de l'Office des brevets du Japon);
 - PCT/EF/PFC02/003 concernant la section 5 de l'annexe F, intitulée "Transmission" (proposition de l'Office des brevets du Japon);
 - PCT/EF/PFC02/004 concernant la section 4.1 de l'appendice I de l'annexe F, intitulée "En-tête du paquet" (proposition de l'Office des brevets du Japon);
 - PCT/EF/PFC02/005 concernant la section 3 de l'appendice I de l'annexe F, intitulée "DTD pour de nouvelles demandes PCT présentées sous forme

électronique”(propositiondel’OfficedesbrevetsetdesmarquesdesÉtats -Unis d’Amérique);

- PCT/EF/PFC02/006concernantl’annexe F,visantàajouterunerecommandation relativeàuneconventiondedénominationdesfichiers(propositiondel’Office desbrevetsetdesmarquesdesÉtats -Unisd’Amérique);
- PCT/EF/PFC02/007concernantlasection 4.1del’appendice Idel’annexe F, intitulée“En -têtedupaquet”(propositiondel’Officedesbrevetsetdesmarques desÉtats -Unisd’Amérique);
- PCT/EF/PFC02/008concernantl’instruction 703delaseptième partie,intitulée “Exigencesdedépôt,normecommunedebase”(propositiondel’Officedes brevetsetdesmarquesdesÉtats -Unisd’Amérique).

4. LeBureauinternationalsouhaiteraitrecevoirtoutommentairesurcespropositionsde modificationpourle15 mai 2002auplustard.Lescommentairesdoiventdepréférenceêtre envoyésparcourrierélectroniquegrâceàlafonction“envoyeruncommentaire”prévuesurle site Web,maispeuventaussiêtreenvoyésparcourrierpostaloupartélécopie(41 -22-338 8040).Lescommentaireséventuelsserontinclusdanslesannexesdesdifférentes propositionsdemodification.Descopiesdecespropositionssousformeimpriméesont disponiblesauprèsduBureauinternational surdemande.Lesdemandesderenseignements concernantcespropositionssontàadresseràM. Thiam Ming Song(courrierélectronique : song@wipo.int;téléphone :41 -22-338 9640;télécopie : 41-22-338 8040).

5. DanslacirculaireC. PCT 827,qui estaussidatéedu4 avril 2002,leBureau internationalsuggèred’autresmodificationsdesinstructionsadministrativesvisantàajouterà l’annexe Funesection 2.5intitulée“Procéduredemodification”,quiprévoitdesprocédures spécialespourlaproposition,l’examenetlamiseenœuvredesfuturesmodificationsdela normeconcernantledépôtetletraitementélectroniquesdesdemandesinternationales. L’examen despropositionsfaissantl’objetdelaprésentecirculairedoits’effectuer indépendammentdeceluidecesautrespropositions.

6. LeBureauinternationalal’intentiondepromulguerlesmodificationsproposéesdansla présentecirculairele30 juin 2002,aprèslesavoirréviséessinécessaireen fonctiondescommentairesreçus.Cesmodificationsdevraiententreren vigueurle 1^{er} janvier 2003.

Veillezagrèer,Madame,Monsieur,l’assurance dema considération distinguée.

FrancisGurry
Sous-directeurgénéral

[Annex3 follows/
L’annexe3suit]

COMMENTS BY IPA AUSTRALIA

PCT/EF/PFC02/001

IP Australia cannot agree to this proposed change. The proposed change has the legal effect of elevating the date of receipt of documents by the applicant to primary importance. This is inconsistent with the context of the PCT, where time frames are driven by the date of transmittal from an office – ie, the date of putting the correspondence into the mail, and not the date of receipt by the addressee. See, for example, Rule 44.1 and 46.1. A change that has the effect of attaching priority to the date of receipt of correspondence has the effect of introducing uncertainty into any calculation to determine the expiration of any due period.

The proposal also has the unintended effect of allowing the applicant to 'control' the date of 'receipt'. Proposed S.709(d) suggests that the date of receipt is the date when receipt is acknowledged in accordance with 709(c). Hypothetically, under 709(c), the applicant could receive the notice on one day; several days later MAIL an acknowledgment to the Office; with the acknowledgment being received by the office several days later. The effect of 709(d) is that the 'receipt date' will be the date on which the office received the mail advice of acknowledgment – irrespective of when the applicant received the notice.

A further general complication arises in the context of offices that have to deal with multiple time zones. It can readily be the case that receipt/transmission of documents that occur 'instantaneously' actually occur on dates that are different as between the sender and recipient. In earlier discussions on the electronic filing issues, this was seen as too difficult to deal with, and was left to national law. In accordance with national law, IP Australia clearly defines that the date and time for electronic communications are calculated based on the time of dispatch not the time of receipt. Placing emphasis on the date of receipt by the applicant or agent, is inconsistent with this national law.

Further, in developing our electronic filing systems we have two basic models. For our major customers, the system is based on dedicated communication channels that involve the capacity for IP Australia having immediate communication with the customer. The change proposal has meaning in this context. However, we also have in place a system for dealing with minor customers, where there is no possibility of immediate communication from IP Australia to the customer's system. [In particular, where the customer communicates via the Internet on single sessions, at times of their choosing.] As described in our comments of August last year on the proposed Administrative Instructions (See **PCT/AI/1 Add.32**), the system developed by IP Australia for communicating with small users involves an E-mail message being sent to the user whenever a piece of correspondence is available for retrieval from a secure 'mailbox', with the user subsequently retrieving the correspondence from that mailbox. In this arrangement, Australian law has provided that the date of dispatch of the correspondence is taken to be the date on which the E-mail notification left IP Australia. The proposed change is fully inconsistent with this arrangement.

Accordingly, IP Australia has major difficulties with this proposal. In part, these difficulties could be addressed by prefacing the proposed additional text with something like:

Where it is necessary to establish the date of receipt of correspondence....

However further extensive changes are required to:

- limit the acknowledgment to being an 'immediate, on-line' acknowledgment;
- deal with the time zone issues; and
- adequately provide for communicationssituations where the customer communicates via the Internet on single sessions, at times of their choosing.

In the absence of such changes, IP Australia cannot agree to this proposed modification.

[Annex4 follows/
L'annexe4 suit]

COMMENTS BY THE CANADIAN INTELLECTUAL PROPERTY OFFICE

This comment is geared toward the PCT/EF/PFC02/001 document.

The Canadian Intellectual Property Office (CIPO) is currently redesigning its current TechSource system to make it user friendly and provide additional functionality to permit business changes such as PCT e-filing. One of the requirements CIPO came up with was similar to a point IP Australia made in its comments on REV3 of the PCT e-filing, the possibility, for a small applicant or inventor, to not have a fixed email address. To permit these small applicants to communicate with us easily, the idea was to give them an account where they can login and view their messages. With this in mind, our sole comment is to add the word “or uses” at the end of the first sentence of the newly added paragraph (c). This should allow our own system to send a notification once the message is in the mailbox of the applicant.

[Annex 5 follows/
L'annexe 5 suit]

COMMENTS BY THE UNITED STATES PATENT AND TRADEMARK OFFICE

Circular PCT/EF/PFC02/001(Administrative Instruction Part 7 Section 709)

1. It is unclear why newly proposed parts (c) and (d) are desired. If there are processing or policy issues that will be impacted by these proposed changes, they should be explained, as required by the procedures for PFCs.
2. The date of receipt by the applicant of Office -originated correspondence is not of particular relevance in the Patent Cooperation Treaty or in the PCT Rules or Administrative Instructions (AIs).¹ The crucial issue is how the Office dates the correspondence for beginning the response period. The mail date, not the receipt date by the applicant, of Office -originated correspondence is relevant under the Treaty, the Rules and the AIs. If the receipt date has importance in an Office's national stage or for national applications, then the definitions should be left to the national Office. All Offices may not legally define "reception" by the applicant in the manner described for national processing. This AI should not set a definition of "receipt" that may violate the definition of another country's national practice, when it is irrelevant to PCT practice.
3. With regard to newly proposed paragraph (c), there is no indication of the method by which the applicant should acknowledge receipt of the correspondence. It is unclear whether the applicant's acknowledgment must be in accordance with Annex For whether the acknowledgment may be made via standard mail 1.
4. With regard to newly proposed paragraph (d), the "receipt date" of correspondence is defined as the date that delivery of the correspondence is acknowledged by the applicant in accordance with paragraph (c). Paragraph (c) defines "reception" as when delivery and storage of the notification takes place. Accordingly, the receipt date and the date of reception may be two different dates if the applicant does not send the acknowledgement until some date later than the actual reception date. For example, the applicant may omit sending the acknowledgement of receipt because he is absent, or prefer to start a period of response at a later date. If a date of receipt is to be used, the USPTO does not believe a date of receipt that is dependent on a voluntary action by the applicant is trustworthy.
5. In the newly proposed paragraph (d), the acknowledgement is required to be in accordance with the procedure in Section 709(c). However, Section 709(c) does not specify the procedure that should be used for the acknowledgement, only that it must take place.

[Annex 6 follows/
L'annexe 6 suit]

¹The receipt date does have import in PCT Rule 80.6, which addresses the petitionable circumstance where the applicant receives a document or letter after a significant delay of more than seven days after it was mailed.

COMMENTS BY THE KOREAN INTELLECTUAL PROPERTY OFFICE

Comments on PCT/EF/PFC02/001 relating to Part 7, Section 709 "Means of Communication" (proposal by the JPO)

We agree with the JPO's proposal since it is taken for granted that the applicants shall notify the Receiving Office of the receipt, and the receipt date shall be the date when its delivery is acknowledged, in accordance with the procedure in Section 709(c).

[Annex 7 follows /
L'annexe 7 suit]

PROPOSALWITHDRAWN

This proposal has been withdrawn from further consideration under the special PFC change procedures since it affects the legal principles, rather than the technical requirements, underlying the standard for electronic filing and processing of international applications. It may, however, be reintroduced for consultation at a later date as a general proposal for modification of the Administrative Instructions.

[End of Annex and of file/
Fin del'annexe et du dossier]