

**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**

PROPOSAL FOR CHANGE FILE/
 DOSSIER RELATIF A LA PROPOSITION DE MODIFICATION

SUBJECT: Changes to Annex F, Appendix I, section 3.6 (modification of the DTD for the request)		PROPOSED BY: IB	
SUJET : Modifications de la section 3.6 de l'appendice I de l'annexe F (modification de la DTD de la requête)		PROPOSÉES PAR : IB	
HANDLING: Expedited cycle		PROPOSED DATE OF ENTRY INTO FORCE:	
TRAITEMENT : Cycle accéléré		DATE PROPOSÉE D'ENTRÉE EN VIGUEUR : 01.07.2017	
Annex/ Annexe	Content/Contenu	Origin/ Origine	Date
1	Modifications of the DTD for the request to address the requirements for the changes to the request form required for PCT Rule 23bis Modification de la DTD de la requête pour tenir compte des modifications à apporter au formulaire de requête en vertu de la règle 23bis du règlement d'exécution du PCT	IB	13.3.2017
2	Comments	DE	11.4.2017
3	Comments	CH	19.4.2017
4	Comments	CN	24.4.2017
5	Comments	CL	24.4.2017
6	Comments	SK	25.4.2017

7	Comments	CR	25.4.2017
8	Comments	AU	27.4.2017
9	Comments	CO	3.5.2017
10	Comments	EP	12.5.2017
11	Comments	JP	24.5.2017
12	Comments	IB	30.5.2017

Next action:	Entry into force	By:	1.7.2017
Prochaine action :	Entrée en vigueur	Pour le :	

[Annex I follows/
L'annexe I suit]

Item 1	
Location:	Annex F, Appendix I, section 3.6, request DTD
Change:	<p>FROM: <!ELEMENT search-authority (isa , earlier-search-request?)> <!-- Request to use results of earlier search; reference to that search --> <!ELEMENT earlier-search-request (document-id , substantially-equivalent? , earlier-search-documents?)+></p> <p>TO: <!ELEMENT search-authority (isa , earlier-search-request? , <u>earlier-search-authorization?</u>)> <!-- <u>PCT/RO/101 Box No.VII(ii) :Authorization to RO to transmit earlier search results to International Searching Authority</u> --> <!-- <u>Authorization to RO to transmit earlier search</u> --> <u><!ELEMENT earlier-search-authorization (document-id)+></u> <u><!ATTLIST earlier-search-authorization request-ro-not-transmit (yes </u> <u>no) #IMPLIED</u> <u>applicant-authorizes-ro-transmit (yes </u> <u>no) #IMPLIED ></u> <!-- Request to use results of earlier search; reference to that search --> <!ELEMENT earlier-search-request (document-id , substantially-equivalent? , earlier-search-documents?)+></p>
Reason:	<p>This additional element is to enable the implementation of new PCT Rule 23bis(ii), noting that PCT Rule 23bis(i) is already enabled through the element earlier-search-request.</p> <p>The new elements structure supports the modifications to the PCT request form as proposed in C.PCT 1498, and also allows for a simplified version where the earlier-search-request and earlier-search-authorization boxes are combined.</p>

Comments by the German Patent and Trade Mark Office

With respect to PCT/EF/PFC 17/001, which contains modifications of the DTD for the request to address the necessary changes resulting from amendments to PCT Rule 23bis, we would like to make the following comments:

The proposed changes directly correspond to the layout of RO/101 previously proposed in Circular C.PCT 1498, Annex II, page 10, Box No. VII (ii). The proposed wording of the corresponding box in that circular was: "Authorization to transmit earlier search results by the receiving office". In my office's response to that circular, (e-mail from DPMAinternational, Mr Thorsten Ickenroth to pct.legal@wipo.int sent on 9 March 2017), we had suggested clarifying the layout of this box, to the effect that an applicant would be able to find the check box to request non-transmittal of the results of the previous search (opt-out provided for in Rule 23bis.b(2)) more easily. Our example had been to change the header of this box to a more neutral wording, i.e. "Transmission of earlier search results by the Receiving Office". In the request DTD, the naming of the elements corresponds closely to the appropriate elements on form RO/101. We greatly welcome this practice, as it makes the DTDs easy to understand and to use.

In the case of Box VII(ii), we understand that the element suggested in order to capture that boxes' contents is "earlier-search-authorization", whereby that element's two attributes "request-ro-not-transmit" and "applicant-authorizes-ro-transmit" capture the settings of the two respective check boxes.

We understand that these two circulars C.PCT 1498 and C.PCT 1505 might have been issued so closely after each other that adjustments to the wording according to our suggestions might not have been decided on yet. We would, however, greatly welcome maintaining the practice of keeping elements and text in RO/101 in close correspondence. Therefore, if the IB should decide to adapt the wording of Box VII(ii), we would like to propose also adapting the naming of the corresponding element, i.e. "earlier-search-transmission".

[Annex III follows /
L'annexe III suit]

Comments from the Swiss Federal Institute of Intellectual Property

L'Institut Fédéral de la Propriété Intellectuelle a consenti à cette façon de procéder concernant la circulaire C.PCT 1505.

The Swiss Federal Institute of Intellectual Property has consented to proceed with circular C.PCT 1505.

[Annex IV follows /
L'annexe IV suit]

Comments from the State Intellectual Property Office of the P.R.C (SIPO)

1. Only considering the system, even if our CEPCT system is not updated and continues to use the old form, it can still exchange documents with the International Bureau in a normal way; however, if the use of the new form is required, we need to update the CEPCT system accordingly.

2. If the International Bureau updates SAFE to a new version and the applicant submits an application using the new version of SAFE, the CEPCT system of the SIPO must be modified, otherwise it will not be able to process the application submitted through the new version of SAFE. Unfortunately this modification would involve many procedures and modules, and would take some time.

[Annex V follows /
L'annexe V suit]

Comments from the National Institute of Industrial Property of Chile

Please find below the comments of INAPI to Circular C. PCT 1505 dated 03/22/2017 on a series of proposals for changes to the standard for the electronic filing and processing of (Annex F of the Administrative Instructions of the PCT) concerning the PCT request form (PCT / RO / 101), the declarations, the search report and the written opinion.

In this regard, having reviewed all proposals made by the International Bureau, and taking into consideration that INAPI uses the ePCT system for the electronic filing of PCT international applications, we have no comments on them and we agree on their content.

[Annex VI follows /
L'annexe VI suit]

Comments from the Industrial Property Office of the Slovak Republic

The Industrial Property Office of the Slovak Republic (hereafter "the IPO SR") in its capacity as a receiving Office, International Search Authority, International Examining Preliminary Authority and designated or elected Office under the Patent Cooperation Treaty would like to inform you, that the proposals prepared by International Bureau were discussed with internal IT experts and the IPO SR has no comments on changes concerning the Standard for the Filing and Processing in Electronic Form of International Applications, declarations, search report and written opinion mentioned in the Circular C.PCT 1505.

We would like to thank the International Bureau for the prepared documents.

[Annex VII follows /
L'annexe VII suit]

Comments by the Register of Industrial Property of Costa Rica

For the moment, Costa Rica does not allow electronic filing of international applications.

However, by communication dated February 10, 2017, we reiterated to WIPO our interest in obtaining access to the e-PCT system for the reception, sending and consultation of international applications, which is in the process of authorization.

In accordance with the above, we currently have no comments or queries regarding the requirements of Circular C. PCT 1505 of March 22, 2017.

[Annex VIII follows /
L'annexe VIII suit]

Comments by IP Australia

PCT/EF/PFC 17/001:

In "<!ATTLIST earlier-search-authorization request-ro-not-transmit (yes | no) #IMPLIED", we could not understand the reason why the attribute name request-ro-not-transmit was chosen. A 'yes' value might mean 'transmit' for some and 'not transmit' for others. We would prefer to use the attribute name request-ro-transmit, which has no ambiguous meaning.

PCT/EF/PFC 17/003:

The XML comment "Indicator used to flag the fact that the drawings of the application have been furnished as color images

The indicators presence implies the drawings are in color format and absence implies that they are black and white" has some spelling mistakes. It would be better to change to "Indicator used to flag the fact that the drawings of the application have been furnished as color images; The indicator's presence implies that the drawings are in color format and its absence implies that they are black and white."

[Annex IX follows /
L'annexe IX suit]

**Comments from the Superintendencia de Industria y Comercio
Ministerio de Industria, Comercio y Turismo of Colombia**

In accordance with Rule 23bis of the PCT Regulations, where the priority of one or more prior applications filed with the same office as the recipient office is claimed in the international application, and that office conducted an earlier search With respect to that earlier application, or has classified it, the receiving office shall transmit to the International Searching Authority together with the copy for the search a copy of the results of the previous search in either form (For example, in the form of a search report, a prior art report or an examination report) where the office has them, and a copy of the results of the previous classification of that office Would have done, if they were already available. The receiving office may also transmit to the administration in charge of the international search as many other documents relating to the previous search as it may deem useful to that administration to carry out the international search.

The SIC fully agrees that in the format of the request the necessary modifications are made so that the receiving office can make the transmission of the documentation related to the previous search referred to in article 23bis of the Regulations of the PCT

[Annex X follows /
L'annexe X suit]

Comments from the European Patent Office

In reply to Circular C. PCT 1505, and particular in view of the PFC-17-003, for the EPO it is not totally clear what would be the exact workflow of a color filing at the RO/EP in terms of publication.

Further, the EPO suggest not encouraging a systematic use of color in filings but clearly indicating that those filings shall be made in color where necessary for a better understanding of the application.

At present the EPO could receive electronic filings including color but not process the color. However, it is a future goal to be able also to process color.

[Annex XI follows /
L'annexe XI suit]

Comments from the Japan Patent Office

As to the changes to the Annex F, we do not have any comments on any of the suggested modifications. However, as our internal IT system needs some adjustments, please note that the complete implementation by our Office of the modified DTDs is expected to be within 2019, at the earliest.

[Annex XII follows /
L'annexe XII suit]

Comments from The International Bureau

The International Bureau would like to express its thanks to the Offices that have reviewed the proposal and provided comments.

In respect of the comments received the international Bureau advises that it has taken into consideration the points raised by the DPMA and IP Australia in respect of the naming of the elements and has decided not to update the proposal noting that the wording on the paper request form proposal has been slightly revised, but the attribute naming correspondence remains understandable.

Specifically in the case of the naming of the attribute 'request-ro-not-transmit' the attribute naming is retained as the request form contains separate concepts of request to take into account an earlier search under rule 4.12 and the specific request not to transmit the earlier search results under Rule 23bis.

Furthermore it should be noted that the paper request form has been modified to include an addition checkbox to distinguish between the type of earlier application international or otherwise; for the electronic form this distinction is made looking at the earlier application number and thus an additional attribute is not required.

Considering the comments received from PCT member states and with no controversial comments outstanding the International Bureau will adopt the proposal for entry into force on July 1, 2017.

[End of Annex XII and of document/
Fin de l'annexe XII et du document]