

# WIPO



PCT/A/28/3 Add.2

ORIGINAL: English

DATE: March 1, 2000

**WORLD INTELLECTUAL PROPERTY ORGANIZATION**

GENEVA

**INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)****ASSEMBLY****Twenty-Eighth (16<sup>th</sup> Extraordinary) Session  
Geneva, March 13 to 17, 2000****COMMENTS RELATING TO DOCUMENT PCT/A/28/3  
(IMPLEMENTATION OF ELECTRONIC FILING AND PROCESSING OF  
INTERNATIONAL APPLICATIONS)***Memorandum prepared by the International Bureau*

This document<sup>1</sup> consists of Annexes reproducing, for the benefit of the Assembly in its consideration of document PCT/A/28/3 (Implementation of Electronic Filing and Processing of International Applications), excerpts from comments received by the International Bureau after the issuance of the provisional version of that document. In the provisional version (document PCT/A/28/3 Prov.), it was stated that early comments would be welcomed by the International Bureau and would, where possible, be taken into account in the preparation of the final version.

A number of comments received by the International Bureau have been taken into account in the finalization of document PCT/A/28/3. Certain comments are not, however, reflected in the final version of that document – in some cases because they were of a general nature and did not necessarily require changes in the drafting of the document, in others because the International Bureau felt that changes would not be appropriate, and in others because the comments were not received by the International Bureau in sufficient time to be taken into account. Some comments are based on the final version of document PCT/A/28/3.

---

<sup>1</sup> WIPO's Internet site is at <http://www.wipo.int>. For this and other working documents for the Assembly's session, see [http://www.wipo.int/eng/document/govbody/wo\\_pct/index\\_28.htm](http://www.wipo.int/eng/document/govbody/wo_pct/index_28.htm).

The Annexes to the present document contain only those comments which, in the view of the International Bureau, have not been superseded by changes made during the finalization of document PCT/A/28/3; comments which, in the view of the International Bureau, have been superseded are not reproduced in this document but their deletion is marked by the indication “[...]”. It was therefore necessary to make certain other consequential changes of an editorial nature; certain changes in formatting were also necessary in order to facilitate the preparation of this document in electronic form.

## TABLE OF ANNEXES

<b>Annex</b>	<b>Comments received from</b>
I (AU)	IP Australia
II (GB)	United Kingdom Patent Office
III (JP)	Japanese Patent Office
IV (NL)	Netherlands Industrial Property Office
V (RU)	Russian Agency for Patents and Trademarks (ROSPATENT)
VI (US)	United States Patent and Trademark Office
VII (EP)	European Patent Office
VIII (AIPLA)	American Intellectual Property Law Association
IX (EPI)	Institute of Professional Representatives Before the European Patent Office

[Annex I (AU) follows]

ANNEX I (AU)

COMMENTS BY  
IP AUSTRALIA

**General Comments**

1. Australia is concerned that whatever systems are set up for electronic filing, the system is readily accessible to all users. In Australia's view, an applicant should be able (if they so want) to download all the necessary software and any other required elements from WIPO or other office. They should then be able to file their application without being required to seek further elements from third-party providers.

One of the major concerns with electronic filing is the issue of security of the Internet. But similar issues exist in current paper-based systems. For example, few people would contemplate mailing \$10,000 in cash through the normal mail; but many will readily mail patent applications. Despite the undeniable risk that mail could be intercepted or tampered with, countries do not insist that paper applications be delivered by way of "armed courier" or the like in order to be valid. There is a risk that Internet communications can be intercepted or tampered with; that risk is different to the risks with mail. Nevertheless, in dealing with this risk, care must be taken to ensure that the standard for electronic filing is consistent with the risks involved. We should avoid the equivalent of requiring the applicant to use an "armed courier" to validly file their application – unless that is really required. Otherwise we run the risk that the system will not be user friendly, may be inaccessible to a large number of applicants, and may fail to achieve the objective of having a widely available filing system that applicants will want to use.

2. Australia has concerns with the coverage and structure of Annex F. In particular, it is heavily focussed on on-line filing, with a particular solution that provides high security and non-repudiation – although the elements required for other forms of filing seem to be present. Australia doubts that it adequately sets out the minimum requirements for a valid electronic filing. However, recognizing the difficulties in establishing practical electronic filing, Australia believes it is appropriate to proceed on the basis of current Annex F with a range of changes that can readily be agreed at this time, with further refinement as the electronic filing environment develops. Australia does not wish see significant delays by trying to obtain a refined and comprehensive document in the first instance – provided that any standard adopted at this time is not treated in the future as an agreed minimum requirement for electronic filing.

3. While Rules 89bis and ter refer to electronic filing, media such as CDs are arguably not electronic, but optical media. It would seem that the rules should more accurately refer to filing digitally, with the administrative instructions similarly referring to digital filing rather than electronic filing. However AU considers this issue would be best addressed when the Rules are revised to incorporate electronic/digital filing, and does not press for relevant amendment at this time.

4. Electronic means, electronic form and electronic format at least should be defined in the administrative instructions, and consistently used throughout the administrative instructions [incl. Annex F]. Regard should also be had to whether the use of the term "electronic" is strictly appropriate – especially with reference to file structure and document layout. AU

additionally notes that given the relationship between the PLT and PCT, there is a strong need to have clear and unambiguous terminology that applies across the PCT and PLT.

5. While Australia recognizes the need for rigorous records management practices for electronic as well as paper records, it is of the view that in general the Administrative Instructions [via Annex F] should not prescribe detailed, mandatory records management standards.

It is considered that in addition to Rule 93 only those basic elements required for evidentiary purposes in relation to electronic transactions should be specified along lines of the UNCITRAL Model Law. That is, the integrity of the records, copies and files associated with an international application should be maintained by ensuring that they remain complete and unaltered apart from any endorsement or immaterial change which arises in the normal course of communication, storage or display.

If the standard for electronic filing includes a comprehensive standard for records management, there is a risk that an application could be found invalid because an office does not fully comply with the detail of that standard. This could be the case even if such lack of compliance had not compromised the integrity of the data record. That is, inclusion of detailed requirements as part of the standard for electronic filing results in the validity of applications being put at risk unnecessarily. [It is also interesting to note that in the current paper-based systems users are content to rely upon the integrity of offices to comply with Arts 30 and 38 and Rule 93. AU does not see any reason why offices can't be similarly "trusted" to maintain the integrity of electronic records in the context of electronic filing.]

Nevertheless, Australia strongly supports records management guidelines, and a detailed standard for those elements of records management practice that are essential for the efficient sharing of information between IPO's. [One such element is metadata.] But such guidelines and/or standards should be quite separate from the process of electronic filing.

These comments particularly apply to Sections 704 (c) & (e), 707, 711 and 713.

6. Annex F is critically dependent upon the Ticket mechanism. In principle, Australia supports the concept of the Ticket to address issues such as connection loss, or date changes, during an on-line session. However, Australia understands that the Ticket mechanism is the subject of patent applications in a number of countries – based on JP 9-352243 [**Applicant** – Hitachi Ltd; **Inventors** – Junko Hirato, Satoshi Takeuchi, & Koichi Yamai; **Title** – Document transmit system and Document Transmitting Method.]

Australia is concerned about the commercial issues associated with setting up an on-line filing mechanism that may be subject to monopoly rights, if the exposure of users (and/or Offices) to royalty payments [or infringement actions] is unknown.

Australia considers this issue to be of critical importance to the adoption of Annex F as a standard for electronic filing. Australia considers it would be irresponsible to establish the standard without commercial issues directly arising from that standard having been resolved. Accordingly Australia's support for the Ticket mechanism is dependant upon advice that WIPO is satisfied licenses exist [where required] to allow all offices and users to lawfully use the system.

## Comments on the draft Administrative Instructions PCT/A/28/3

7. **Section 701 (a)** – “considered to be [the original] [authentic] for the purposes of the treaty”

Australia does not support the use of the term “authentic” but prefers “the original”. “authentic” does not appear to have a special meaning in relation to the PCT or the UNCITRAL Model Law and Rule 89bis already provides the fundamental legal basis for electronic applications. Hence it would be unclear what would be added by “authentic” in section 701. On the other hand the purpose of this section appears to be to ensure the electronic filing is treated as the original and hence the Record Copy – see Admin Instructions Section 305 and compare Rule 92.4.

8. **Section 701 (b)** – AU notes that while the reference to Designated offices inherently covers elected offices, it does not cover Receiving offices that cannot be designated – ie RO/IB. Nor does it cover ISA’s or IPEA’s. AU considers that 701(b) should state:

“No receiving Office, designated Office, ISA, or IPEA ...”

9. **Section 701 (b)** – As currently worded, section 702 and Annex F appear to preclude an office from permitting filing in a format not specified by Annex F. Australia queries whether this restriction is appropriate. It prevents an office, should it want to, from accepting filings in other formats and undertaking the conversion to one of the standard formats.

If this principle is accepted, an extra administrative instruction would be required to allow that conversion, and to require that conversion before the file is sent to any other office (eg a receiving Office before sending to an ISA). Additionally, such an Office ought to be allowed to insist on compliance with matters relating to that form of filing – even though those requirements are not specified in Annex F – as a condition for using that form of filing. This would mean that section 701(b) should read something like:

No office which accepts documents in electronic form shall, subject to Rule 51bis, require compliance with requirements relating to international applications submitted in electronic form other than those contained in Annex F – except where the application is submitted in a form or format permitted by the Office but not specified in Annex F.

10. The effect of s.701(b) is to establish the standard of Annex F as a maximum requirement for electronic filing. The standard of Annex F ensures that situations requiring high levels of security and non-repudiation are fully dealt with. However it does not address which issues in fact require such high levels of security and non-repudiation. Rather it assumes that they necessarily apply to all electronic transactions associated with electronic filing.

Australia seriously doubts the need to have high levels of security and non-repudiation for all transactions. For example, under current paper-based systems most countries do not require any proof of identity of the applicant. This is reflected in Art 5(1)(ii) of the PLT, where all that is required is “indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the office”. Yet the PKI infrastructure potentially requires a level of identity (and corresponding burden) far greater than for paper-based systems.

Generally, Australia doubts that the requirements set out in Annex F are in fact the *minimum* requirements for a valid electronic filing. Desirably, Annex F should set out minimum requirements for a valid electronic filing, and additional optional requirements available to the applicant (at their choice) to allay concerns particular applicants may have with security-related issues. Section 701(b) should then, in setting the maximum that an office can require compliance with, refer to those minimum requirements for a valid filing.

11. **Section 702 (a)** – Australia is concerned that applicants should not unnecessarily lose a filing date merely because the document was filed in the wrong format – particularly if it is filed in the commercial format that the office uses in its internal day-to-day business. On the other hand, if the filed document was unreadable by the Office, Art 11.1(iii)(d) and (e) would not be satisfied, and a filing date could not be accorded. (Note that under the PLT, this situation of an unreadable file could be taken as being analogous to a filing in a foreign language [Art 5(2)(b)], with a corresponding opportunity to comply with the “language” requirement [Art 5(4)]. Unfortunately this option is not available under the PCT.)

Accordingly Australia considers that section 702 should oblige the receiving office to accept and process the application [with relevant non-compliance with the physical requirements of Art 14(1)(a)(v)] on the basis of what the Office is capable of reading from the file.

[...]

14. **Section 702 (g)** – “process such International applications in accordance with Annex F”

It is not clear what “process” may mean here over and above the requirements of sections 703 – 713 etc. If the provision is required it may be sufficient for it to indicate that receiving Offices shall process applications according to the administrative instructions.

[...]

16. **Section 704 (a)** – Australia’s understanding is that section 704(a) relates to on-line filing. In the case of an electronic filing on a physical medium (eg floppy disk, DC), the administrative instructions make no special provision. Accordingly, following rule 89bis.1(b) the regulations apply mutatis mutandis. This would mean that the date of filing is the date of receipt of the physical medium bearing the electronic file. If this is not the case, Australia suggests that a specific provision would be required in the administrative instructions, to establish the filing date.

17. **Section 704 (a)** – “... date of receipt shall be the date on which the International application [is fully and successfully received by](#) the receiving Office”.

Australia supports the alternative wording “enters the system established by” as it is consistent with Article 15(2) of the UNCITRAL Model Law and national laws that are based on it. In this regard it is not evident that the particular demands of the patent system are such to warrant the development of unique terminology. It is further considered that a valid interpretation is that a message only enters a system when it is fully received by that system. It is also noted that any issues arising from the completeness or legibility or “successfulness” of the transmission are provided for adequately by Section 705.

18. **Section 704 (b)** – “.. in electronic form or by electronic means ..” –

The “or” inserted here instead of “and” is unnecessary since the provision appears to relate solely to the routing of electronic communications, that is, in electronic form and by electronic means.

19. **Section 704 (d)** – By way of simplification, consider deleting the text as indicated:

“However, the applicant may indicate other means ~~acceptable to the national Office or intergovernmental organization, if any, by which he desires to receive invitations and/or notifications~~ from among those offered by the receiving Office and shall provide the necessary indications so that such invitations and/or notifications can be communicated by the means indicated.” –

20. **Section 704 (d)** – The last sentence “Section 703(c) shall apply *mutatis mutandis* to such electronic notifications and invitations” might better be drafted as a separate sub-section.

21. **Section 705(b)** – The consequence of this provision is that if a virus is included in a file, the applicant loses their filing date. While this is an appropriate remedy for a virus that is maliciously included, it is quite inappropriate for the usual applicant who may be unaware that their system is infected with a virus. It is well known that new viruses continue to be created, and can escape detection from older versions of virus scanners. Very few organizations would claim that they are absolutely immune from virus attacks. It is inevitable that from time to time an attorney firm will upload a number of applications that are inadvertently infected with viruses. The risk that all those applications will lose their filing date (with consequential loss of rights for the applicant) is likely to be enough to deter regular filers from using electronic filing.

It is suggested that section 705(b) should be treated in a manner analogous to s.702. That is, a filing date is obtained; but the applicant must provide an uninfected copy of the file.

An additional consideration is the manner of conveyance of the virus. If the virus is embedded in the file, it may be appropriate to require a new file. However, if the virus is ancillary to the file (eg a boot sector virus on a floppy disk) the office will probably be able to extract the file without the virus. In such situations, it seems inappropriate to require a replacement file.

In the event that a virus is detected, and that virus can be removed with standard software – should provision be made to allow the office at its discretion to clean the file and treat the cleansed file as the file “as filed”. Or must the applicant always supply an uninfected file?

22. **Section 705(c)** – what is meant by “take the appropriate action”? Whatever is involved, it should not result in any loss of filing date. The provision should end as: “...investigate the cause of the infection.”

23. **Section 706** – If the ticketing mechanism is retained, section 706 should specify the time allowed for completion of the ticketing transaction rather than have it covered in Annex F.

Also, as Australia understands the concept, it would allow an applicant to obtain a ticket, and later mail their application on a CD (for example). Australia considers that the ticket mechanism should generally be associated with on-line filing. Australia would not want to see a large number of cases filed on CD where a ticket had been obtained, as there may be significant work in verifying the ticket. However Australia recognizes that there will be a number of cases where, because of the size of the application, on-line filing becomes impracticable. For such limited cases Australia would support the ticket mechanism with filing on CD by mail within a certain time. If the on-line filing systems are fully efficient, Australia sees no need to include any specific limitation in the administrative instructions – but would want a file size restriction if that route became popular.

With regard to time limits. Previous documentation has suggested that a ticket would be valid for 5 days. For an on-line arrangement, this should be adequate. However, in the context of obtaining a ticket and then mailing a CD, the period needs to be sufficient to cover typical postal delays. Also, public holidays adjacent weekends can easily reduce “5 days” to 1 working day. Australia suggests that a period of 10 days is more appropriate.

24. **Section 707** – The terminology “national Office or intergovernmental organization” is inconsistent. Rule 93 refers to receiving Offices, the IB and Searching and Examining Authorities. Section 707 should be so limited.

See also the comment under (5) above. Australia considers it inappropriate to have *detailed* standards for storage as part of the administrative instructions for electronic filing.

25. **Section 710 (b)** – “.. not to regard the [documents](#) as attributable ...” - “international application” should be substituted for “documents”.

26. **Section 711** – See the comment under (5) above. Australia considers it inappropriate to have detailed standards for storage as part of the administrative instructions for electronic filing.

#### **Comments on Draft Annex F to the Administrative Instructions Version 3.1** (SCIT/P 8/99 Rev 1 Annex 5 – 20 December 1999)

27. **Para 2.1 Submission** – This section relates specifically to the on-line filing mechanism specified in Appendix 1. Para 2.1 should be redrafted to cover other submission mechanisms as referred to at para 4.2 eg e-mail, magnetic and optical disk etc and refer where necessary to appropriate appendices, eg Appendix 1, for technical detail. Hence the detailed explanation of the on-line ticketing mechanism could be removed from this paragraph.

In relation to disk filings, since media type and disk format are likely to impact only on receiving offices specifics could be left to their discretion. However file format and wrapping would be according to attachments 1 and 2 and requirements equivalent to paragraphs 44 and 45 of Annex C could be included.



28. **Para 2.2.3 Confidentiality – Encryption** – Last sentence could perhaps read “The confidentiality of [an on-line](#) connection between ...” since the paragraph has broader application.

29. **Para 2.2.4 Non-repudiation – Presumption of Attribution** is provided for by Section 710 of the Admin Instructions. Hence while receiving Offices should be permitted to implement systems in which the identity of the sender is established to a high level of certainty it should not be mandatory for Offices to seek verification beyond what is already required under the PCT. The distinctions between patents and general e-commerce transactions should be borne in mind.

30. **Para 2.3 Formal Document Requirements** – Attachment 1 to Appendix 1 is considered to be a key element underpinning electronic filing in all forms and should be included here or referenced directly. It would seem appropriate to specify in general that the documents making up an application be wrapped or zipped according to Attachment 2 – so that too could also be referenced here.

In relation to Attachment 1 however it is questioned whether the specified formats provide sufficiently for invitations, notifications and miscellaneous correspondence that may be contained in the body of an Email.

The second sentence of this paragraph is an unnecessary restatement of Section 702(a). The requirement that the resubmitted document be forwarded by the receiving Office with the original is implied if the process is based on Article 14 practice as indicated in 702(a). It is again restated in Para 3.1.

31. **Para 3.1** should refer to Section 702(a).

32. **Para 3.6 Electronic Records Management** –

As indicated above in para (5), Australia questions the necessity for mandatory records management standards and believes the records management content should be provided as guidelines. If “standards” are retained in paragraph 3.6 the following comments apply:

- The requirement for external audits is not supported.
- Much of Attachment 5 appears to be guidance in compliance with the “standards” in 3.6.1 and consequently compliance with the attachment should not be mandatory.
- To the extent that any elements of Attachment 5 are essential for interoperability of IPO systems eg metadata then these should be flagged and mandatory elements identified.
- S3 “... and the archive copies must be retained [in the electronic format in which they are submitted](#) ..” is not supported. This goes beyond what is required by Articles 8 and 10 of the UNCITRAL model law as to maintaining the integrity of data messages and appears not to be consistent with Attachment 5 which recognises the need to reformat for archival purposes.

- S6 “.. This requires the ability to verify the identity of the submitter – (the applicant or authorized representative) – ..” is not supported to the extent that it may imply verification requirements beyond that required for paper filings under the PCT. Reference is again made to Section 710

33. **Paras 4.1 and 4.2** – Need to be revised in light of final version of Section 702.

34. One of the document formats allowed by Annex F is JPEG – see attachment 1. The following is a simple explanation of the JPEG format [from the Help-file of a commercial image-processing software package.]

“The JPEG format is best suited for digital photographs and other natural-looking images. It is not as good for precise artwork such as line-art. This is because some “averaging” takes place during compression, and edges may be blurred. In photographs, this is not so noticeable because such sharp edges are rare.

“It uses a lossy compression method to achieve compression ratios of up to 100 to 1. This is far better than 10 to 1 which may be the best most other compression methods might produce. This format supports grayscale and True Color data types; because it uses a lossy compression method, indexed and black and white data types do not reproduce well and are not supported. One interesting feature of this format is that you can vary the degree of compression. So you can decide what level of data retention vs. space savings is best for your needs.”

Questions that arise with this format are:

- Are there additional requirements that need to be specified – such as use being limited to photographs, and the degree of compression – for the use of JPEG?
- Is it acceptable for an office to maintain a JPEG file at a greater loss factor than that used when the file was submitted? [Presumably no?]
- Is it acceptable for an office to convert documents submitted in one format to the JPEG format, using anything other than a zero loss factor?
- If an applicant submits a file in JPEG format using high compression (ie high loss) such that text is heavily blurred – can there be an Art 14 invitation regarding non-compliance with Rule 11? Prima facie, submission in JPEG format is under a special provision [Rule 89bis.1(b)] that overrides the effect of rule 11 in so far as lack of legibility arises solely from the use of that format.

[Annex II (GB) follows]

ANNEX II (GB)

COMMENTS BY THE  
UNITED KINGDOM PATENT OFFICE

**General concerns**

1. We are concerned that the Action Plan in Annex II envisages the promulgation of Administrative Instructions by April 2000 when, as is clear from paragraph 14, a number of questions of principle, some quite fundamental, remain outstanding. However, paragraph 14 does not make clear to whom the questions are addressed and whether the conclusion of the consultation process on the Instructions depends on satisfactory answers to all the questions. (See paragraph 7 below concerning question (j) on admissibility of electronic records.)
2. Para 10 states that, for Offices and PCT Authorities prepared to accept electronic filing and processing, “compliance ... with the applicable portions of the standard contained in Annex F will be mandatory”. This is a new departure for WIPO standards, which up until now have been no stronger than recommendations. Accordingly, and particularly in view of a number of requirements in the Instructions for procedures merely to be “in accordance with Annex F”, it is necessary to distinguish clearly between the optional and essential features in the Standard. The present draft Standard does not do this, and we would wish to see it revised to make a clearer distinction, eg using “must or shall” for mandatory elements and “should” for recommended but discretionary elements, with consequential revision of the references to the Standard in the Instructions
3. The introduction to the draft Standard states that it contains certain legal principles as well as technical principles. We accept that a clear distinction between technical and legal matters may not always be possible at the present time as regards electronic filing and processing. However, we do not consider it appropriate for the Standard to be a source of fundamental legal principles: users of the PCT would expect to find these laid down in the Treaty, Regulations and Administrative Instructions. In particular, the ERM standards S1-S14, which state mandatory requirements at a high level of generality, seem more appropriate for inclusion in the Administrative Instructions, with which they to some extent overlap.
4. Paragraph 2 states that “flexibility will be needed during the initial stages in the operation of the legal framework for electronic filing and processing”, but it is not altogether clear how such flexibility would be introduced in the context of a standard purporting to lay down mandatory requirement. Does this contemplate anything more than the possibility that requirements laid down in the Administrative Instructions might in due course “migrate” to the Rules?
5. Paragraph 5 stresses the need for an international system to be interoperable. Does the proposed timetable allow for any interoperability testing, and if so, which components are to be tested? Without such testing, it will not be possible to have confidence that the final systems will interoperate, especially as regards cross certification over the various PKIs. We are aware that some States propose to implement national PKIs: what testing will be done to ensure these particular elements interoperate?

## **Administrative Instructions**

[...]

7. The provision of Section 713 for electronic records created and kept in accordance with the Standard to be admissible in national legal proceedings is clearly necessary if a fully electronic international system is to be established. However, it may be premature at the present stage of development. Thus, whilst we accept that procedures are available for maintaining the shelf life of electronic records, this may not of itself be enough to satisfy a court.

## **Other matters**

8. The PCT Ad Hoc Advisory Group on Legal Matters noted that procedures might be necessary to handle joint signatures, but this does not appear to have been considered in the Instructions or the Standard.

[Annex III (JP) follows]

ANNEX III (JP)

COMMENTS BY THE  
JAPANESE PATENT OFFICE

**Section 701: Authenticity of Electronic Applications; Effects of Compliance with Standard**

(a) The sentence (a) of this section contains the expression “considered to be the original for the purposes of the Treaty.” However, introduction of the new concept, which is now referred as the word “originals” in the PCT electronic application procedures seems to be inappropriate. Although the word “originals” is used for Rule 95(a)(3) of the Regulations under the European Patent Convention, it does not necessarily mean by those used in this text of the PCT. In addition, if the word “original” should be used for Section 701, such use may be considered as incompatible with the word “record copy” which is defined as the true copy under Article 12 of the PCT. As the case may be, the word “original” can be misinterpreted or interpreted as different meanings depending upon situations. The JPO proposes that the following sentence should be incorporated quoting Article 5 of the UNCITRAL Model Law.

“(a) An international application which is submitted in electronic form shall not be denied legal effect, validity or enforceability solely on the grounds that it is in the form of a data message.”

**Section 702: Acceptance of International Applications Filed in Electronic Form**

(a) The JPO proposes that the provision should be amended to allow each receiving Office to choose one format from the document formats set out in Annex F. Currently, Annex F provides for the use of three document formats: XML, TIFF or JPEG, and PDF. However, the JPO intends to choose the XML format due to the availability of tags, and does not wish to receive applications in the PDF format, since they are difficult to handle as coded data. Annex F 2.3 indicates that “Each Receiving Office can choose whether to accept other document formats not specified in Appendix I.” The JPO proposes that Section 702(a) should be corrected in the similar manner of above-described Annex F 2.3. Japan does not plan to accept applications in formats that are not set out in Annex F.

(b) The definition for “electronic methods of communication acceptable for filing international applications” should be discriminated from the “electronic means” clearly. We confuse this terminology because electronic mail is not only electronic methods but also electronic means according to the Comments of Section 702 (b) and Section 704 (d).

(b) The JPO suggests that the electronic format chosen and adopted by a receiving Office must also be notified to the International Bureau.

(d) It is not clear what kind of examples are assumed as “in a particular case” in this context. We consider it more appropriate to indicate specific examples in the Comment on Section 702(d). We understand that an “emergency case” is included as one of such cases.

[...]

#### **Section 704: Processing of International Applications Filed in Electronic Form and by Electronic Means**

[...]

(b) It is understandable, as the purport of the provision, to obligate the receiving Office to establish procedures for the proper re-routing of documents received by electronic means and in electronic form which are misdirected to an improper address within that Office. However, it is unpredictably difficult for the receiving Office to see how, when and where such miss-routed documents will be delivered in the Office. The Office, as a result, shall be failed to re-route such documents with good intentions. The JPO proposes that a description “to the extent practicable” should be added as below.

“Each receiving Office shall establish, to the extent practicable, procedures for the proper re-routing of documents received by electronic means and in electronic form which are misdirected to an improper address within that Office.”

(c) We do not understand why Rule 93 is cited in Section 704(c). Although Section 704(c) provides “to establish and archive electronic records...in accordance with Rule 93,” Rule 93 provides “to keep records and files.”

- Since there is no description providing for the International Bureau as the receiving Office falling under Section 704(c), it may be more appropriate to add such description.
- The part of the Comment referring to the relation with Article 12 of the PCT should be described in the PCT Administrative Instructions. (“The electronic application which is forwarded to the International Bureau will be the record copy under Article 12 and this would leave in place the concept set out in Article 12(2), of the record copy being considered to be, for any purpose where such is necessary, the “true copy.””)

#### **Section 705: Legibility of International Applications filed in Electronic Form; Infected Files**

(a) It is not clear what cases are assumed as subject to the checking of legibility. We would like to know whether this includes a case where some of the included characters are accidentally converted to completely different characters. In any case, this check cannot be conducted electronically, so it must be carried out manually. We consider that obligation of such manual legibility check would run counter to reducing manual operations, which is meant to be one of the benefits of electronic application. Furthermore, if accidentally converted characters are also subject to the legibility check, obligation of the check will cause an extreme burden on the receiving Office, while at the same time, it will be considerably difficult to check the documents perfectly. The JPO proposes that the obligation should be relaxed by adding a description “if it finds,” or that the check should be limited to the extent that can be checked by mechanical processing. In Japan, such check is not conducted in the formality check process at present.

[...]

**Section 707: Storage of International Applications Filed in Electronic Form**

Since there is also no description providing for the International Bureau falling under Section 707, it may be more appropriate to add such description.

[Annex IV (NL) follows]

COMMENTS BY THE  
NETHERLANDS INDUSTRIAL PROPERTY OFFICE

**Preliminary remarks concerning document PCT/A/28/3 Prov.**

[...]

2. The relation between PCT Articles 11 and 14 and the three-level-structure suggested in paragraph 9 of document PCT/A/28/3 Prov. should be clarified:

(a) **minimum level** Article 11(1) is silent about signatures and physical requirements. It therefore is up to the receiving Office to indicate to which extent it is prepared to act as a receiving Office for international applications filed in electronic form. See Rule 89bis.1(d) and the proposed Section 702.

(b) **recommended basic level** Article 14(1)(a) refers to the Regulations for details about signatures and physical requirements. In the case of electronic filing, Rules 89bis.1(a) to (c) refer for such details to the Administrative Instructions. If these details are contained in the “recommended basic level”, each PCT Contracting State has, because of Article 27(1) to accept this “recommended basic level”.

(c) **advanced level** Why is an advanced level needed, given the legal consequences of the “recommended basic level”?

For applications filed in paper form PCT has no specific provisions relating to such things as the use of registered mail or the quality of envelopes used for the purpose of mailing.

3. Part 7 of the Administrative Instructions should contain a list of terminology and its intended meaning. See in document PCT/A/28/3 Prov. the words “form”, “format” and “means”, discussed in the comments to the proposed Section 702(a). See also in said document the word “original” used in the proposed Section 701(a). In the latter case, I note that PCT uses expressions such as “application as filed” and “record copy”. In my understanding, the electronic form of a document is “the original” if the document concerned is first filed in electronic form.

4. **Section 701(a)**

Does the proposed Section 701(a) also apply to electronic filings under Rule 89ter.1?

5. **Section 701(b)**

There is no need to repeat the essence of Article 27(1) in the Administrative Instructions. Remember that Annex F is itself part of the Administrative Instructions.

6. **Section 702(a)**

(a) The format used does not belong to the minimum requirements under Article 11(1) for obtaining an international filing date. The choice of acceptable formats should therefore be left to what the receiving Office is prepared to accept when acting as a receiving Office for



the filing of international applications in electronic form. It may be advisable to prescribe that a receiving Office should accept at least one format as set out in Annex F. Compare Rule 12.1(b)

(b) The second sentence in my opinion describes a correction of “Rule 26 type”. This sentence therefore better can be transferred to the proposed Section 704(d).

**7. Section 702(b)**

[...]

(b) If the presence of viruses or [other] malicious logic results in not granting an international filing (see the proposed Section 705(b)), it should be clear from the conditions relating to electronic receipt, that the receiving Office is not prepared to act as a receiving Office for the filing of international applications in electronic form containing a virus or [other] malicious logic. The mere fact that an application filed cannot be copied has no bearing on the determination of the international filing date under Article 11(1).

[...]

**9. Section 702(f)**

No need to repeat the essence of Rule 89bis.1 in the Administrative Instructions. Remember that Annex F itself is part of the Administrative Instructions.

**10. Section 703(a)**

What is the character of the acknowledgement of receipt? Is it a simple message that a given electronic message has been received. Or is it going beyond that? In document PCT/A/28/3 Prov. the third comment to the proposed Section 704(a) indicates an acknowledgement prior to any processing. Later on the filing may even be treated as not having been received (see the proposed Section 705). In such case the receiving Office yet again sends an electronic message; see the second comment to the proposed Section 705(a). Said comment gives the impression that the electronic message concerned is regarded as the acknowledgement.

The second comment to the proposed Section 703(a) gives the impression that the electronically filed application has been processed before sending the acknowledgement of receipt, since the application is identified.

**11. Section 703(b)**

If the applicant is not interested in an immediate acknowledgement of receipt by electronic means, the receiving Office should not be obliged to send it by other means. Under Section 301 the forwarding of an acknowledgement of receipt is not obligatory.

**12. Section 703(c)**

The telephone might be a quicker means of informing, and thereby reassuring, the applicant. A “written” confirmation may then follow in due course.

[...]

**14. Sections 704(c) and 707**

Since Rule 93 is mentioned, one apparently also has long-term storage in mind. However, in my understanding it still is an open question which carrier is the most suitable for long-term storage. The Netherlands Industrial Property Office will for the time being continue to use paper as the carrier for long-term storage.

**15. Section 704(d)**

This proposed Section shows that not only the receiving Office (see proposed Section 702(b)(iii)) but also the applicant has to present alternatives in case his electronic systems are not available.

**16. Section 704(e)**

I assume that Annex F shows how to amend or correct an international application filed in electronic form without impairing the integrity of the information. Then the proposed Section 704(e) can stop on the fourth line after “Annex F”.

**17. Section 705(b)**

(a) See our earlier remark No. 7(b) with relation to the proposed Section 702(b). The proposed Section 705(c) implicitly confirms that the presence of viruses of [other] malicious logic does not prevent the checking whether the requirements of Article 11(1) have been complied with.

(b) In document PCT/A/28/3 Prov. the third comment to the proposed Section 704(a) suggests that the checking for viruses, other malicious logic and legibility takes place prior to any further processing of the international application filed in electronic form. It therefore seems better to interchange the order of the proposed Sections 704 and 705.

**18. Section 705(c)**

(a) The first thing to be checked is whether the illegibility of the “infection” occurred during the transmission between the receiving Office and the International Bureau.

(b) Since an international filing date has been accorded, and this date would have to be changed as a consequence of both the proposed Sections 705(a) and 705(b), the appropriate action by the receiving Office seems to be a declaration under Article 14(4), assuming that Rule 30 applies. Then a procedure under Rule 29.4 results.

**19. Sections 707, 709, 711, 712 and 713**

Since Annex F is itself part of the Administrative Instructions, it seems that Rules 89bis and 93 do not require the additional instructions of the proposed Sections 707, 709, 711, 712 and 713.

**20. Section 710**

What is the sense of this proposed Section? What else would a receiving Office presume than that the name indicated as “applicant” shows who the applicant is? Only in case of contradicting information the receiving Office might come to another conclusion. But such conflicting information has nothing to do with the use of a certain Standard. The sense of the proposal becomes even more doubtful when a simple notice from the “applicant” would be sufficient proof that someone else filed the application. The proposal furthermore is silent about what then will happen to the application concerned.

[Annex V (RU) follows]

ANNEX V (RU)

COMMENTS BY THE  
RUSSIAN AGENCY FOR PATENTS AND TRADEMARKS (ROSPATENT)

**General**

1. On the whole Rospatent supports the elaborated draft of Part 7 and agrees with the approach adopted by the International Bureau envisaging that some provisions of principle in respect to electronic filing which deserve per se to be included in the text body of the PCT Treaty or Regulations under PCT have been proposed for inclusion into the Administrative Instructions only so as to avoid organizational difficulties arising out of the revision of the Treaty. Among such provisions of principle the following statements should be mentioned in the first line: 701 (a) “An international application which is submitted in electronic form shall be considered to be the original for the purposes of the Treaty” and, similarly, 709 “International applications which contain electronic signatures which comply with Annex F shall be considered to have been signed as required by the Treaty and Regulations.”
2. Despite our consent to the above cited compromises we consider as unacceptable the requirement contained in section 713 in respect of mandatory admissibility of electronic records in any proceeding under the Treaty and in legal proceedings in any designated State since this requirement contradicts the previously adopted provision in the Rule 89 bis1(d) of the Regulations under the PCT according to which “no national Office or intergovernmental organization shall be obliged to receive or process international applications filed in electronic form or by electronic means unless it has notified the International Bureau that it is prepared to do so...”
3. It should be noted as well that the deadline set forth for commenting on the proposed draft is too short so as to consider it in an exhaustive way. Moreover, frequent references to the draft standard in Annex F, which is still under elaboration make difficult the understanding of the draft Instruction. There are apprehensions that some legal and procedural provisions which ought to be in the Administrative Instructions will be incorporated in the standard only.
4. Some provisions of the Administrative Instructions relating to functions and actions on the part of the Receiving office and an applicant need to be elaborated in more detail ( so far this is done occasionally in the comments to the draft of Part 7). We consider it necessary to amend and revise accordingly at a later date the corresponding parts of the Guide for the RO and Applicant’s Guide. For example, item 704(b) (concerning proper re-routing of documents in electronic form which are misdirected to an improper address within that Office) should be transferred to the Guide for receiving Office. Similarly, actions of the applicant where he does not receive an acknowledgment of an electronic filing and should resubmit the application (see section 703 (c) ) should be described in applicant’s Guide.

## Specific comments

### 5. Section 701

This section should be amended as follows:

“An international application which is submitted in electronic form shall be considered to be the original for the purposes of the Treaty. [A Record copy received by the International Bureau in electronic form shall be considered to be a true copy](#)”

### 6. Section 702(d)

This section should be amended as follows: the first sentence remains unchanged

“... [In this case the Receiving Office shall submit the application filed in a format and by means envisaged by the standard and agreed upon with the International Bureau](#)”.

### 7. Section 703

Instead of expression “international applications” we propose to use “purported international applications”.

### 8. Section 704(a)

In relation of establishing the filing date of an application in electronic form we propose to retain the existing approach adopted for conventionally filed applications (article 11 and accordingly Rule 20) . Following this approach section 704(a) should read as follows:

“Where an international application is received in electronic form and by electronic means [without using a ticket mechanism as provided for in section 706](#) the date of receipt of such international application shall be the date on which the international application [is fully and successfully received by Receiving Office or, where the application is transmitted in parts, shall be the date on which the last mandatory \(meaningful\) part or corrections therefor are fully and successfully received by the Receiving Office as provided for by Rule 20 of the Regulations under PCT.](#)”

### 9. Section 713

In order to eliminate the contradiction pointed out in para 2 of this letter it is proposed to amend the wording as follows:

“Electronic records created and kept in accordance with Annex F shall be admissible in any proceeding under the Treaty and in legal proceedings in any designated State [provided the Office of the corresponding designated State has notified the International Bureau that it is prepared to do so in technical and legal respect in accordance with Rule 89 bis 1\(d\)](#)...

(b) For the designated States which are not prepared to accept applications in electronic form the International Bureau at the request of an applicant or an Office of the concerned designated State shall prepare and submit a paper copy in accordance with articles 13 and 20 of the Treaty and? Correspondingly Rule 47 of the Regulations under PCT which shall be considered a true copy of the application in electronic form.”

[Annex VI (US) follows]

ANNEX VI (US)

COMMENTS BY THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

**Paragraph 9**

Levels are not used throughout this document, and the introduction here seems unnecessary. But let us consider:

- (1) The major effort of the Annex F analysis has been to establish a global standard for secure communications with the Offices. That standard involves PKI, which is the primary mode of assuring the authenticity and integrity of communications over the Internet. That standard establishes a baseline of first quality security.
- (2) Having said that, however, we can appreciate that in certain circumstances with certain users an Office may be more liberal than the standard requires and provide for communications with less than full PKI assurances.
- (3) On top of that understanding, there is another principle to consider, that of granting filing dates to applicants when the legal requirements for an international application are met. Those requirements have always been less than the requirements for formal communications, and it is not inconsistent to exercise the most liberality for the acceptance of those important indicia.

[...]

**Paragraph 13 (Questions of principle)**

These questions, as important as they are, cannot be resolved except by trying the process. They are really evaluation criteria for the PCT e-Pilots, standards which will be satisfied, more or less, by the various systems, and against which the systems will be judged. For example, one must consider how a particular system's technology comes within the capabilities of a developing country.

**(Existing) Rule 89*bis*.1(a)**

This requires some clarification, as it is not clear whether the filing on paper is the official response, or it is merely to establish timeliness, and the Office can then require the electronic version as the formal response or filing. Note in the PLT Article 8 (1) (d), and the amplification in Note 8.04.

**(Existing) Rule 93**

We see a need for a Rule indicating a schema of certification and admissibility, instead of the technical statement buried in Section 713 of the Administrative Instructions.

In concept, each Office would certify that the electronic records were kept in accordance with the requirements and standards of Annex F, also perhaps known as International Standard STXX, and as such were a true and accurate record of the proceedings of that Office. This

certification would be presentable in a court of law, which would weigh strongly toward the admissibility of the electronic record in legal proceedings.

Possible wording for such a rule:

### **“93.5 Certification**

Each national Office or intergovernmental authority accepting or maintaining electronic records shall certify that the electronic records in its control are maintained in accordance with the requirements and standards of Annex F to the Administrative Instructions. A copy of this certification will be made available on request to any party for purposes of presentation to any court of law or for use in other proceedings to evidence the integrity and authenticity of the electronic records relating to international applications.”

#### **Section 701(a)**

[...]

We are concerned about introducing a new concept into the PCT, the “original”, when Article 12 refers to only copies (at least in the English edition). The idea of the Record Copy being the true copy is well established, and that terminology should be maintained. Authentic is a good term for this AI as indicated by its use in the title.

#### **Section 701(b)**

“(b) No designated or elected Office which accepts documents in electronic form shall, subject to Rule 51*bis*, require compliance with requirements relating to international applications submitted in electronic form other than those contained in Annex F.”

Recall that a DO/EO is not forced to accept electronic applications, so the (b) paragraph would only be applicable to those that do.

This is a rather strong provision for an AI, and we suggest that a Rule is more appropriate for something that so binds the various Offices concerning the very acceptance of international applications.

The amending of Rule 51*bis* suggested in the comment is an excellent idea, in view of the electronic submissions and the issues raised above in paragraph 14 of the opening Legal Framework section.

#### **Section 702(a)**

[...]

An electronic form, say by direct transmission, may be encoded in various formats, say TIFF or PDF. The format as well as the form must be acceptable to the RO. Note that some formats may be acceptable in one form (say on a CD) and not be acceptable in another form.



The language of the Rule 89*bis*(d) is used in the AI to make clear that the invitation to correct the format of the submission does not necessarily indicate that the international application will not be received for purposes of granting a filing date. Specifically, an RO may grant a tentative filing date if the submission is readable and otherwise compliant with Article 11.

While we agree that it is good to have definitions, especially those that are consistent with the PLT, we are concerned that the words chosen are not in common usage in commerce. It is far better to have words that are understandable on their face. The meaning chosen for “form” is more usually reserved for the “data carrier”, the paper, disk or electronic file. “Format” is ok. “Delivery means”, referring to the manner that the message was delivered to the Office, is more common than mere “means”.

We also note that the definitions should include the delivery of the message on a medium, such as a CD or disk.

Formats must also be decided upon for the CD form, if that is to be covered by Annex F. We need to be sure that electronic is defined somewhere to include digitally encoded files. A CD or optical media is not electronic but is a digital storage accomplished by physical changes to the media.

#### **Section 702(b)**

[...]

The notification should take place regardless of the means by which the electronic submission is made to the RO. For example, if a RO will accept electronic submissions on a CD by mail, hand delivery or certified carrier then those means should be defined.

[...]

In the middle of a reporting requirement was placed a substantive requirement on the RO, both in iii [...]and iv [...]. Both requirements belong in new sections (x) and (x2).

[...]

#### **Section 703(c)**

Each Office should be free to use the means that are usual in its circumstances. For example, e-mail may be the communications channel of choice in the circumstances.

#### **Section 704(a)**

[...]

UNCITRAL Article 15 attempts to define the time and place where offer meets acceptance to make a contract in the commercial world. It may or may not be controlling in the world of managed PCT submissions. In any event, “fully and successfully received” needs to be defined, with respect to documents, as “human readable, displayable, etc.” The date the submission “enters the system established by the receiving Office” does not account for the readability or integrity of the submission. Further, the beginning of a long data message may “enter” the receiving Office’s systems while the end of the message may still reside under the

applicant's control, and ability to change. Thus the United States prefers the "fully and successfully received by" language. We expect a tentative acknowledgement will be sent by the machine on receipt of something that "seems ok", but that a proper binding receipt will wait until human review of the contents.

Notice that the PLT in Note 5.04 indicates that each Contracting Party shall define the date of receipt for its national applications.

Notice that PCT Rule 92.4(c) defines fully and successfully received in a parallel situation referring to facsimile and similar transmissions, and encourages the choice of that type of concept here.

**Re Comment paragraph (3)(v):**

At this point in the sequence of events the notification could be sent.

[...]

**Paragraph 704(d)**

This section should be in Section 703 (Acknowledgement). The mutatis mutandis clause as described below has been commented on in that Section 703, where it is suggested that fax not be inflexibly mandated.

[...]

**Section 705(a)**

“(a) Upon receipt of an international application filed in electronic form in accordance with Section 702, the receiving Office shall check whether such international application is legible. Where all or part of the received purported international application is illegible or 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 the document is illegible, distorted in meaning or that the attempted transmission failed, and the receiving Office shall, if possible, promptly notify the applicant accordingly.”

Though in general this section advocates the noteworthy principle of “saving what you can” from the damaged or distorted message, we are concerned that the partial message we do receive may not be what was intended. “Do not add the pepper.” may be distorted on transmission into “Do~ add the pepper.” Under these circumstances the applicant should be invited to retransmit the whole message and a determination must be made by the receiving Office of whether the filing date can be maintained in light of the nature of the corrected matter submitted.

[...]

### **Section 705(b)**

Query: Is the filing date assumed to be lost? Proposal: Unless the submission can be rendered safely readable, then “yes” the filing date is lost. Considering these dire consequences, a clear warning should be given to the electronic filer to routinely check all submissions for viruses before sending the application.

[...]

### **Section 713**

We would like to wish this so, but an AI will not make it so. It would appear that something “stronger” is really needed. Please see the comment after Rule 93.4 above in Annex I.

[Annex VII (EP) follows]

COMMENTS BY THE  
EUROPEAN PATENT OFFICE

[...]

**Paragraph 14(d)**

2. It is fully appreciated that the issue here is, how to best ensure the legal value of the records, in particular how to ensure that the records can be fully acceptable also to a court in any given country and, that certification of compliance with the standard as to record keeping can be a very strong argument for acceptance. The tendency within the task force was to require external auditing, potentially by the IB or under their auspices, as they could be a trusted third party acceptable to any court (see also the comments of the IB to section 707). However, the system should certainly not be unnecessarily bureaucratic. For example, it could be considered to follow the system which has been successfully implemented for the evaluation of offices before they can become international authorities for search or examination which no doubt is also a very important issue. The SCIT could play its role in this respect like the committee for technical corporation does in the latter case (see Article 16(3)(e) PCT). It goes without saying that any solution should however be incontestably trustworthy.

**Annex 3 of document PCT/A/28/3 Prov.**

3. Generally it might be advisable to have a section on definitions. Here inter alia the comments to section 702 ie, the terminology explanations (form, format, means) could serve as a basis. However, definitions should be restricted to those which are of legal importance; as far as technical terms are concerned Annex F is the right place.

4. Of particular concern in this context is the absence of a definition of the “record copy” in the AIs. Indeed, the latter is not mentioned anywhere except in the comments to section 704, although rule 89bis.1(c) clearly requires the AIs to set out “provisions and requirements in relation to ... the operation of Article 12 in relation to the home copy, the record copy and the search copy ...”. This is all the more necessary since section 701 defines the electronic submission as the original. To the extent that the receiving Office (RO) may be any of the national/regional offices around the world and taking into account the impossibility to forward the very same electrons received by the RO to the IB, the record copy should be defined to be the copy of the original submission forwarded by the RO to the IB. At present Annex F, page 6, point 3.1 deals with this issue in a fairly complete way; however, this is material that should find its place in the AIs themselves and not in an annex.

**Section 701**

[...]

6. Further, 701(b) refers to designated but not to elected Offices.

7. Finally, slight amendments are proposed in both paragraphs as follows:

“(a) [For international applications filed in electronic form, [the](#)] [electronically submitted documents](#) shall be considered to be the originals for the purposes of the Treaty.”

Note: If the definition of the original has to be restricted to the application documents alone, the language in the square brackets should be used. If an “electronic” definition of the original is necessary, applicable in all proceedings under the Treaty, then the wording has to be much broader and can certainly not specifically refer to the application.

“(b) [For international applications filed in electronic form no](#) designated [or elected](#) Office shall, subject to Rule 51bis, require compliance with requirements other than those contained in Annex F.”

## Section 702

[...]

10. As to paragraph (i) it seems to be questionable if “conditions” and in particular “limitations” should be admissible and, if yes, to what extent. Such a clause might be interpreted as an invitation to dilute the standard.

[...]

## Section 703

13. There seems to be some confusion or misunderstanding concerning acknowledgment of receipt. The ticket mechanism, foreseen to be used for all submissions up to a certain size, has an integrated electronic acknowledgment of receipt. If the applicant gets no acknowledgment, it is clear there is a flaw somewhere, the transmission was probably not completed and he should preferably re-submit.

14. All the information required in comment No. (2) to this section is foreseen in this mechanism, except for items (f) and (g) and incorporating them should not be particularly problematic.

15. Finally, what the mechanism presently does not provide for is the possibility for the applicant to indicate his wish to receive the acknowledgment by alternate means, which however is in the first place a technical issue (the system must be set up such as to recognise such requests).

16. If the ticket mechanism is not implemented but rather a system allowing only for submission without an integrated acknowledgment of receipt functionality, then of course provision needs to be made for adequate acknowledgment procedures.

[...]

18. Finally, it was agreed also within the task force that resubmissions (see third but last line of the comment) should properly be marked as such in order to avoid double or triple allocation of the incoming application by the receiving Office. But for this to be implemented, it needs to be clearly provided for, presumably by the Offices when informing the IB of the modalities of their electronic filing systems under section 702.

#### **Section 704**

[...]

20. Further, the wording “fully and successfully received” appears clearer than “enters the system”, which is (at least presently where no part dealing with “definitions” is provided) undefined. However, “fully and successfully” are also undefined qualitatives to the extent they do not appear anywhere in the Treaty. They could be understood to imply that at least section 705 is satisfied, in which case a reference to this section should be included. A possible wording could be

“(a) Where an international application is [submitted](#) in electronic form and by electronic means, [its](#) date of receipt shall be the date on which the international application is received by the receiving Office [subject to section 706 and provided that the requirements of section 705 are fulfilled.](#)”

[...]

#### **Section 705**

23. If the integrity requirement was not restricted to document tampering but was to be including illegibility or the presence of virus or malicious logic, it seems to be necessary to clarify the relation between section 705 paragraph (a) and section 711 (page 20). It is understood that in principle an international application which is defectly transmitted or for other reasons not legible does not comply with the standard laid down in Annex F.

24. As to paragraph (a)’s first line it should be made clear that for the purpose of this paragraph an international application could only be a “purported” one. As to the second sentence reference to Annex F might be advisable; the defects as mentioned in that sentence could be used as an examples.

25. On paragraph (b) it is reminded that the ticket mechanism foresees an incorporated check for viruses or malicious logic. The comments to section 703 apply thus here as well. Informing the applicant should also be conditional to “if possible”, because information identifying the applicant might not be available, unless a ticket request has been submitted which is virus-free.

[...]

#### **Section 706**

[...]

The wording of comment No. (1) is rather cryptical and is not sufficient to prompt the desired discussion.

### **Section 707**

28. As to the comment to this section and, in particular the question of external audits of an office's records management practice reference is made to the re: page 6 of PCT/A/28/3 Prov (see 2).

### **Section 710**

29. The wording of both paragraphs would be more exact if the language "attributable to the applicant" were replaced by "[attributable to the person identified therein as the applicant](#)".

### **Section 711**

30. The relation of this section to section 705 is commented under 4 and 7. [See comment on Section 705.]

### **Section 712**

31. [...] Further, this section strongly supports the need for a broader definition of originals in section 701 than currently proposed.

### **Section 713**

32. This section supports the view that well-established and trustworthy external (by a trusted third party) audits of Offices' compliance to the standard on record creation and keeping is an absolute necessity or this provision will remain an expression of wishful thinking.

[Annex VIII (AIPLA) follows]

ANNEX VIII (AIPLA)

COMMENTS BY THE  
AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION (AIPLA)

**Ease of use of standard in all Contracting States**

- (a) *Will applicants from developing, as well as industrialized, countries have access to the necessary infrastructure and facilities to enable them to file applications complying with the recommended basic level?*

We are not in a position to comment on whether Applicants from Developing Countries will have access to the infrastructure and facilities to enable them to file applications. Applicants from the United States generally do have access to infrastructure and facilities associated with the Internet, although a few do not and they would not be candidates to use the electronic filing system.

- (b) *Are there any barriers to any class of applicant raised by the standard which could be avoided by taking a different approach?*

No. The standard does not create a barrier to any class of applicants from the United States. However, the national law of some Contracting States might impede the use of electronic filing. For example, national law regarding electronic transmission encryption or export of technical data could create barriers. In some countries, they already do.

- (c) *Is there any unjustified requirement for particular hardware or software, or for hardware or software meeting unnecessarily high standards?*

No. The computer and telecommunications industries are moving faster than the requirements of filing of applications via electronic means. Prices will decline, accessibility will increase, and any applicant interested in electronic filing is likely to be already quite active in electronic commerce techniques.

**Compliance by Offices with the standard (see proposed Section 702(f))**

- (d) *Should compliance by Offices with the standard be verified? If so, then how would compliance checking operate? (Self-certification by each Office concerned? Monitoring or audits by a third party; see draft Annex F, Part 3.6, fourth paragraph; document SCIT P8/99 Rev.1, Annex 5, page 7? How would an auditing party report non-compliance and what obligations would an auditing party have, for example, to applicants who file electronically with or through the Office in question? How uniform would compliance with the standard have to be; for example, should all Offices have the same method of acknowledgment of receipt, etc.?)*

Yes, compliance by Offices should be verified. AIPLA believes that uniformity among the various Offices is highly desirable. We believe that there should be monitoring by a group of experts, international in composition, who would report to WIPO as well as consult with, and provide assistance to, the Offices.



**Certificates and Public Key Infrastructure (PKI) (see draft Annex F, Appendix I, Part 3; document SCIT/P 8/99 Rev.1, Annex 5, page 14))**

(e) *Are the requirements for authentication of identity clear and justified?*

The requirements for authentication of identity are clearly justified, but it remains to be seen whether they will be clear to the applicants.

(f) *Are X.509 v.3 certificates (the type prescribed in draft Annex F, Appendix I, Part 3.2; see document SCIT/P 8/99 Rev.1, Annex 5, page 15) accessible to applicants in all PCT Contracting States?*

Theoretically yes, through the very same Internet connections they will use to file the applications. As a practical matter, however, the certificates will only be available to those who understand electronic commerce sufficiently well to make use of this access. Applicants from the United States will have the benefit of the use of these certificates to review the status of their unpublished patent applications, based on a program announced by the USPTO in December 1999.

(g) *Where certificates are used when filing, what degree of authentication of identity is (and should be) required?*

AIPLA believes that no “wet signature” should be required if filing via electronic means is used.

(h) *Will applicants be allowed to use biometric means (fingerprint, signature dynamics, etc.) or other means of authentication instead of certificates? (Note that while the standard does not currently provide for such technology neutrality, other provisions relating to electronic commerce, such as the European Commission Directive on a Community Framework for Electronic Signatures, the UNCITRAL Draft Uniform Rules on Electronic Signatures, and various national and states laws are technology-neutral, providing for the use of either option).*

AIPLA believes that the first hurdle in using certificates should be cleared before other means of authentication are considered. If those other means of authentication are considered, they should be optional and in addition to the use of certificates.

(i) *What role, if any, should WIPO play in an eventual PKI for industrial property; see draft Annex F, Appendix I, Parts 3.3 and 3.5; document SCIT/P 8/99 Rev.1, Annex 5, pages 16 and 19, respectively?*

WIPO should be a non-exclusive, but central source for all items necessary to file an application via electronic means. AIPLA believes that whatever standards are adopted should be non-proprietary, in the public domain, or owned by WIPO for benefit of all people. No private enterprise should be in a position to disrupt open access and use of filing via electronic means.

**Admissibility (see draft Annex F, Part 2.2; document SCIT/P 8/99 Rev.1, Annex 5, page 4)**

- (j) *Can it be guaranteed that electronic records kept in accordance with the standard will be admissible as evidence and acceptable under the national law of all PCT Contracting States (including in their national courts)?*

No guarantee is possible without considerable further study and years of lawsuits to establish a body of law or legislation which could itself become litigated for interpretation. Each Contracting State should be prepared to address this point at the Assembly. In the United States, under our Federal Rules of Evidence, proof of authenticity and originality of even paper documents has a considerable body of law that should be studied. The body of law with respect to electronic documentation is far less developed.

- (k) *Will the national law of all countries, including general patent laws as well as in connection with the PCT, accept and give legal effect to a filing date accorded on the basis of the “ticket system” as proposed in the draft standard?*

This seems highly unlikely, unless the law or regulations are amended. The proposed “Ticket System” has some similarities, but also considerable differences with the United States’ practice of filing via U.S. Postal Service Express Mail. End of the day deadlines will severely test the viability of the Ticket System. The pilot phase of the Annex II Schedule should focus on this critical, practical element of the system. The establishment of a Filing Date should also take into consideration those Contracting States which have multiple time zones and consider whether one time zone will establish the end of the day.

**AIPLA Concerns**

(1) Filing via electronic means must not be compromised by intellectual property rights held by a private enterprise that could interrupt the use of the system. Applicants must be assured that the means of filing patent applications does not create a potentially infringing act. Some countries’ laws will provide immunity for the Offices, but not the applicants. In the present documents, both “.pdf” files and ZIP files are from proprietary sources, yet are requirements of the system (Comment 2 to Section 702 and page 22 of Annex F, respectively).

(2) Beyond questions of principle that WIPO has carefully posed in Paragraph 14 of the Draft Assembly Document, there are many technical electronic and legal aspects to the voluminous Annex F. While AIPLA has very much appreciated the opportunity to comment at PCT Ad-Hoc Committee meetings, SCIT has not provided a similar forum. AIPLA hopes that there will be a similar opportunity at SCIT to deal with the particulars of Annex F before the rapid schedule in Annex II advances too far.

(3) The internal administration by the various Offices of Rule 89ter is important as a gauge of how electronic application filing will be administered. AIPLA would appreciate knowing how new Rule89ter is working before the various Offices take on new electronic administration duties.

(4) AIPLA believes that there should be no further amendment of Rule 51bis (identified in Section 701) to require “wet” signatures as evidence in addition to electronic signatures. AIPLA would also not wish to see Applicants facing different requirements in different Receiving Offices.

[...]

(6) AIPLA is concerned about the implications in Section 703(b) of failure to receive a USPTO acknowledgement within the prescribed period. With applicants confronted by a deadline in a very important case, human nature and the threat of malpractice will cause multiple application attempts if the acknowledgement is not very quickly received. This is another matter to consider during the pilot study, although it is perhaps not likely that a real test could be carried out since Applicants would not risk important cases in a pilot study.

(7) AIPLA believes with reference to Section 704(e) that a substantive legal effect could arise depending on how an Office entered an amendment or made a correction under the rubric of a “technical issue”.

(8) AIPLA urges that steps be taken to ensure that the Section 705(b) invitation to re-file the electronic submission will not impede the process for others if the re-filing applicant has a corrupted document.

(9) AIPLA seeks assurance with reference to the comment to Section 708 that scanning/OCR will be reliable enough for those Applicants that do not file electronically but whose paper applications later become available electronically.

(10) AIPLA finds the requirements of Annex F to be very complex. The ability to comply with Annex F will require considerable initial effort and continuous rigorousness. AIPLA is concerned about those good faith attempts to comply with Annex F that fail. The status of applications which do not fully comply with Annex F should be addressed in the Administrative Instructions.

(11) AIPLA is concerned that well-meaning, but ill-informed, potential applicants will not follow the requirements of Annex F, Appendix I which establishes certain limitations for file size, electronic signature formats, and encryption techniques. AIPLA is concerned not only for those applicants, but all other applicants “waiting in line” for their own electronic filing, who would be affected by an earlier applicant trying to file too large an application or creating other problem affecting later applicants. The recent rule changes are more applicant-friendly and accommodating of applicant errors such as filing papers in the wrong place or without the correct documents. In electronic filing, one applicant’s errors could have a cascading effect on other applicants. Such issues need some discussion and consideration by the PCT Assembly.

Despite the comments stated in this letter, AIPLA finds the movement to filing via electronic means very progressive. The AIPLA will support and participate with the International Bureau and the various Offices to understand the system and to recommend its use once it becomes fully functional.

[Annex IX (EPI) follows]

ANNEX IX (EPI)

COMMENTS BY THE  
INSTITUTE OF PROFESSIONAL REPRESENTATIVES  
BEFORE THE EUROPEAN PATENT OFFICE (EPI)

First, as our representative already indicated at the 6th meeting of the Ad Hoc Advisory Group on PCT Legal Matters, the present wording of Rule 89bis.1(d) PCT is somewhat unclear in that it could be interpreted to mean that even a designated or elected Office could refuse to process a PCT application transmitted in the usual paper form on the ground that it was “filed in electronic form or by electronic means” if said Office has made no specific notification to the International Bureau.

A possible amendment is submitted for your consideration in the following proposal that due to lack of time could not be discussed at the meeting.

Secondly, the document still contains the proposal to accord a filing date based on a “ticket” that does not contain a description and claims. As we indicated at the said meeting, we fear that this could constitute a violation of Article 11 PCT. A PCT Article cannot in our opinion be overruled by means of an Administrative Instruction. We are therefore against introduction of this “ticket system” as proposed in the draft standard in view of the legal uncertainty introduced by such a system if it is not accepted by all national courts.

Thirdly, as indicated in the attached proposal, an additional issue needs to be regulated in the Administrative Instructions. An electronically filed application must be forwarded to other Offices (ISA, IPEA, DO, EO) in conventional paper form, should such other Office not yet be prepared to accept applications in electronic form.

Finally, the rules as to evidence are put in the Administrative Instructions. We feel this should be upgraded to the Implementing Regulations that are part of the PCT itself. We suggest incorporating the most important rule into the Implementing Regulations as proposed in the attachment.

**Proposed amendments**

**Rule 89bis.1(d) PCT**

“(d) No national office or intergovernmental organization shall be obliged to [act as receiving Office](#) for international applications filed in electronic form or by electronic means unless it has notified the International Bureau that it is prepared to do so in compliance with the applicable provisions of the Administrative Instructions. The International Bureau shall publish the information so notified in the Gazette.”

**Rule 93.2(a) PCT**

“(a) The International Bureau shall keep the file, including the record copy, of any international application for at least 30 years from the date of receipt of the record copy in accordance with standards set out in the Administrative Instructions. [Each Contracting State shall accept this file as evidence of the facts appearing from this file unless the court, tribunal or administrative authority concerned is convinced, based on](#)

the other serious evidence, that this file contains errors. Documents incorporated in an electronic file shall be considered to be originals.”

Notes:

From the discussions during the meeting of the Ad Hoc Advisory Group in March 1999, it appeared that Rule 89bis.1(d) allows the International Searching or Preliminary Examining Authorities, and designated or elected Offices to refuse to deal with electronically filed international applications. This was never intended. The proposed amendment clarifies the original intention of Rule 89bis.1(d).

It is understood that the Administrative Instructions shall provide that the receiving Office shall forward search copies in conventional form to all International Searching Authorities that do not want to process international applications in an electronic manner.

It is understood that the Administrative Instructions shall provide that the International Bureau shall communicate international applications in conventional form to all International Preliminary Examining Authorities and designated or elected Offices that do not want to process international applications in an electronic manner.

From the discussions during the meeting of the Ad Hoc Advisory Group in November 1998, it appeared that the evidentiary value of electronically kept files is not certain. The proposed amendment assures that the International Bureau file, the only file kept for a period of 30 years and containing the record copy that is considered the true copy of the international application pursuant to Article 12(2), is accepted as evidence. The requirement that International Bureau has to follow prescribed standards in keeping its files, helps in making the International Bureau files acceptable as serious evidence by courts. On the other hand, the reference to the Administrative Instructions makes the standards flexible enough for the International Bureau to work with. The last sentence of the proposed amendment corresponds to Rule 95a(3) EPC as amended per 01.01.1999.

[End of Annex and of document]