

# WIPO



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**INTERNATIONAL PATENT COOPERATION UNION  
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**ASSEMBLY**

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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*

The Annex to this document<sup>1</sup> reproduces, for the benefit of the Assembly in its consideration of document PCT/A/28/3 (Implementation of Electronic Filing and Processing of International Applications), comments received by the International Bureau from the German Patent and Trade Mark Office. Other comments received by the International Bureau have been reproduced in document PCT/A/28/3 Add.2.

[Annex (DE) follows]

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<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).

COMMENTS BY THE  
GERMAN PATENT AND TRADE MARK OFFICE

**Comments on the Implementation of Electronic Filing and  
Processing of International Applications (Document PCT/A/28/3)**

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

The current wording of sentence 2 is not consistent with the approach that receiving Offices may limit the formats acceptable to them. Where the international application is not in a format acceptable to the receiving Office, the receiving Office has to invite the applicant, according to Section 706 sentence 2 and Art. 14 (1)(b) PCT, to correct the international application, that is to resubmit it in the prescribed format. That puts a much greater burden on receiving Offices than simply sending back the application in the wrong format, which is technically easily feasible. The receiving Office must handle a format although it is not acceptable to it. It has to make readable a multitude of formats. Consequentially all sorts of software must be available to the receiving Office which is expensive and may not be practicable for most of the offices. Furthermore it has to identify the resubmission and match it with the original document.

**Section 706: Legal Effect of Use of the “Ticket Mechanism”**

The Ticket Mechanism was already discussed in the meeting of the PCT Ad Hoc Advisory Group in September 1999. There it was introduced especially for large applications in order to accord an “earlier” international filing date. Now, the case of exceptionally large files (definition?) seems to be excluded. Thus, where the ticket and the application reach the receiving Office on the same day, there are no problems in according a filing date in compliance with Art. 11. However, in that case the ticket mechanism and Section 706 are not required. Therefore Section 706 is made for the situation that the application arrives on a later date than the ticket request. The Ad Hoc Advisory Group in September came – nearly unanimously – to the conclusion that under these circumstances the requirements of Art. 11 are not met and an international filing date cannot be accorded. It is therefore doubtful if Section 706 is compatible with Art. 11 PCT.

**Comments on the draft of the Standard for Electronic Filing, Processing, Storage and  
Record Management of International Applications under the Patent Cooperation Treaty  
(PCT), Annex F, Version 3.1 (Document SCIT/P 8/99 Rev. 1, Annex 5)**

The standard will have a far reaching impact, also on national applications. Rule 8 (2)(a) under the PLT obliges a Contracting Party, which permits electronic filing under the PCT, to accept as well the electronic filing of communications in respect to national applications in accordance with the PCT requirements. The German Patent and Trade Mark Office thinks that currently the standard does not go sufficiently into details. The document still needs to be discussed thoroughly clarified and amended before adoption. The German Patent and Trade Mark Office endorses the comments of the Swiss Federal Institute of Intellectual Property and of Mr. Brookes which were submitted for the SCIT meeting in December 1999. However, it would like to add the following comments:

(a) The new Standard mixes obligatory requirements and recommendations (compare also Mr. Brookes' comment). This renders the interpretation of the rules unclear. Section 3 (Requirements for Offices and Authorities) in particular seems to be unclear, specifically where "procedural requirements" are referred to as "more than simply recommendations". We suggest that the Standard should be clearly subdivided into "obligatory requirements" and "recommendations".

(b) The subject of the obligatory part of the Standard should be a clearly defined data format with DTD and the security requirements for the electronic PCT applications. The means, products and ways for achieving the data format and complying with the security requirements should receive status as recommendations, only.

(c) For all products and procedures (e.g. the ticket mechanism), stated in the recommendations, it must be clarified who is in charge of the technical support for the applicants' installations.

#### **Ad Section 2.1:**

- We have doubts as to the necessity and usefulness of the ticket mechanism in the future. The data transmission speed will steeply rise in the networks available in the future. The Standard should include the option of benefiting from the respective latest technology for the transmission processes.
- The legal consequence remains open in case the applicant has received an acknowledgement of receipt for sending the ticket, but the subsequent transmission of the correct application was not successful due to technical problems.
- The ticket mechanism provides opportunities for hackers since the receiving Office cannot defend itself against a flood of transmitted tickets (denial of service) which are only signed with a basic electronic signature.
- It remains unclear what procedure should be chosen for large files; the same applies to the definition of large files.
- Is the ticket mechanism obligatory for normal sized files or is it possible to send the application immediately? What is the point of the ticket mechanism for normal sized files?
- There is a danger that the applicant might abuse the ticket mechanism for obtaining a multitude of provisional filing dates, by filing tickets for formally still inadequate applications, while failing to resubmit the corresponding applications. It is true that this is basically also possible with regard to conventional applications, but it will be much easier by electronic filing.

#### **Ad Section 2.2:**

A common security policy is a precondition for this issue, particularly for the use of a Public Key Infrastructure; see also the detailed list of questions of the CH Patent Office concerning Annex F, Appendix I.