

WIPO



PCT/A/28/3 Add.5

ORIGINAL: English

DATE: March 10, 2000

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

**Twenty-Eighth (16th Extraordinary) Session
Geneva, March 13 to 17, 2000**

**COMMENTS AND PROPOSALS 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 document¹ 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 Institute of Professional Representatives Before the European Patent Office (EPI). Other comments received by the International Bureau have been reproduced in documents PCT/A/28/3 Add.2, Add.3 and Add.4. Document PCT/A/28/3 Add.2 includes, as Annex IX (EPI), previous comments by EPI.

[Annex (EPI-2) follows]

¹ 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.

ANNEX (EPI-2)

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

In general, EPI is in favor of electronic filing. The legal framework should, however, be flawless given the high number of PCT Contracting States involved. Please note that not only the Offices that are ready to accept electronic filings are involved, but also all other offices, as an Office that is not yet ready to accept electronic filings in its capacity as Receiving Office, may still be involved in electronically filed PCT applications in its capacity as Designated Office. This illustrates the need for a flawless legal framework.

From the above example, it immediately follows that Rule 89*bis*.1(d) PCT has to be amended before the electronic filing system is started. We refer to our earlier written submission (see document PCT/A/28/3 Add 2).

As to draft Section 706, it is respectfully submitted that this section is unclear and appears incompatible with Article 11 PCT (the same holds with regard to draft Article 5 PLT). This article states that the filing date is the date on which the Office has received, *inter alia*, a description + claims (no claims but still the receipt by the Office of a description is required under the PLT). Consequently, the filing date is not earlier than the date of receipt of the full international application including the full description and claims; the date on which the message digest is received is irrelevant for the purposes of Article 11 PCT (and draft Article 5 PLT), as the message digest only contains a “hash” of the description and claims from which relatively very short number it is impossible to recover anything. In view of the fact that nothing can be recovered from a hash, for the present time and without further explanations we cannot see a hash without a full description and claims as just a formal deficiency that can be corrected later on. While it is understood that in the US, the US Postal Service is considered to be an agent for the USPTO for the purposes of receipt of documents, that situation (involving two US federal government agencies, in which a filing date is accorded as soon as the application has left the domain of the applicant and has been received by the government) is basically different from a situation in which the most important part of the application is still in the hands of the applicant or his agent, which is the case if the Office has only received the message digest, the full application including the full description and claims only being received (if ever) on some later date.

While the above analysis shows that draft Section 706 is probably incompatible with Article 11 PCT (and draft Article 5 PLT), we also feel that the text of draft Section 706 is unclear. The first sentence deals with the situation that the message digest is received on a date earlier than the date of receipt of the full international application. In view of Article 11 PCT, the latter date is the filing date! The second sentence states that if in such a situation, the message digest matches the international application, the application is considered to have been received on the date of receipt of the message digest. This draft Administrative Instruction appears to violate the higher ranking provision of Article 11 PCT. By virtue of an inserted text, the second sentence now also states that it is subject to compliance of the international application with the requirements of Article 11 PCT. This insertion appears to render the whole second sentence unclear, because Article 11 PCT appears to lead to a legal consequence that is opposite to the very purpose of this second sentence! The third sentence states that if in the situation of the first sentence, the message digest does not match the

international application and the non-matching international application is not replaced by a matching international application, the application shall be considered to have been received on the date of receipt of the international application. In our view, this is only a repetition of Article 11 PCT, because under Article 11 PCT the date of receipt of the message digest is irrelevant; it is the date of receipt of the full international application including the full description and claims that counts.

We thus share the feelings of the German Patent and Trademark Office as to proposed Section 706. We also share the concerns forwarded by the Australian delegation as to patent rights covering the “Ticket Mechanism”.

If one really wants to use the “Ticket Mechanism” with the legal effect set out in draft Section 706, one should amend Article 11 PCT first. Also, if the “Ticket Mechanism” with this legal effect is really wanted, Article 5 PLT should not be adopted as presently proposed. Both issues could perhaps be resolved on the Diplomatic Conference that is held for the PLT.

[End of Annex and of document]