

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PATENT COOPERATION TREATY (PCT)

Seventeenth Session
Rio de Janeiro, February 9 to 11, 2010

PCT PARAGRAPH REPLACEMENT AND PROPOSED PFR ST.36 2009/007

Proposal by the European Patent Office

BACKGROUND

1. On 9 November 2009, the Trilateral Offices made a proposal to modify WIPO Standard ST.36 with a view to supporting XML tagging corrections and change (PFR ST.36 2009/007¹). The discussions on PCT replacement paragraph and on the proposed PFR are closely intertwined since the ST.36 standard should support any provisions on replacement paragraph, especially in the case of the processing of applications filed in XML.
2. The purpose of this paper is to clarify the current discussions by highlighting that the proposed PFR is both:
 - (i) a necessary step before adoption of the PCT replacement paragraph; and
 - (ii) a proposal that fits both the PCT and the national patent procedures.
3. One issue of particular interest within the framework of the discussions on the PCT replacement paragraph is that the proposed PFR can accommodate any numbering scheme.

¹ Discussed in the ST.36 task force; a copy of the proposal has been made available on the Meeting's private forum at <http://www.wipo.int/pct-mia/>.

A NECESSARY STEP BEFORE ADOPTION OF THE PCT REPLACEMENT PARAGRAPH

4. The processing of amendments, rectifications, corrections of patent applications is not yet automatic. The aim of the proposed PFR is to update the current ST.36 standard on XML so as to support the electronic processing of applications filed in XML such as international applications during the international or national phase, as well as national applications.

5. As many other national patent procedures, the PCT does not provide yet any specific provisions regarding the replacement of paragraphs, including the addition or deletion of paragraphs. The current practice consists of filing and processing substitute sheets. In the case of applications filed in XML, a conversion to an image format is effected. In order to facilitate the electronic filing and processing of modifications to applications filed or processed in XML, the page-based system needs to be complemented by a paragraph-based system. This relates essentially to applications filed and processed in XML so the update of the corresponding ST.36 standard is of primary importance.

6. In this respect, a distinction is to be drawn between changes which affect the application body and those which do not. Rectifications of the description, claims or drawings authorised by the International Searching Authority (ISA) under Rule 91 PCT, or missing parts or elements incorporated by the RO under Rule 20 PCT would result in a modification of the body of the application as filed. In the case of missing parts or elements incorporated by the RO, the record copy contains the changes. The same applies to corrections under Rule 26 PCT. In the case of rectifications authorised by the ISA, the international application as published by WIPO is affected. In the case of rectifications authorised by the International Preliminary Examining Authority (IPEA) (generally after the international publication), the corresponding information is published by WIPO separately. The proposed PFR ST.36 2009/007 would, in particular, support all these cases. Modifications that would not affect the application body, for example, rectifications of the description, claims or drawings authorised by the IPEA under Rule 91 PCT or amendments under Article 34 PCT which are either published or made available to designated Offices separately from the rest of the application are also supported by the proposed PFR.

A PROPOSAL THAT FITS BOTH THE PCT AND THE NATIONAL PATENT PROCEDURES

7. The proposed PFR introduces a new International Common Element, <document-amendments>, supporting the building up of an electronic file (further referred to as eDossier) that would enable offices to track the history of all modifications effected to the application body. The proposed PFR therefore provides more legal certainty in the processing of the application and renders the processing itself more efficient, especially from the view point of the office of second filing (Paris route) or designated Office (PCT).

8. The eDossier would indeed contain the complete history of the modifications while enabling the rollback of any modification to a previous version as well as a clear indication whether or not a specific modification was executed, that is, actually performed on the relevant part.

9. Furthermore, the proposed PFR can accommodate any numbering scheme (such as for paragraphs of the description or claims, consecutive or branch numbering), including the lack of numbering. There is no aim at harmonising current national practices but rather to support any of them. The Annex to this document illustrates the proposal.

CONCLUSION

10. A common standard on XML tagging corrections and changes is highly desirable to ensure consistency between the international and national phase (PCT) as well between offices of first and second filing (Paris route). In addition, it is complementary to the common application format (CAF) project to further streamline the processing of patent applications in general. The EPO hopes that the present document clarifies the proposed PFR ST.36 2009/007 and it encourages participants to the MIA to support the adoption of the PFR thereby paving the way for adoption of paragraph replacement provisions within the PCT framework.

11. The Meeting is invited to comment on the EPO's proposal for a common system of marking changes to the application body in XML format.

[Annex follows]

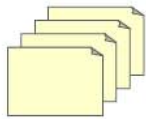
ANNEX

ILLUSTRATION OF THE PROPOSED PFR (EFFECT IN THE PCT PROCEDURE)



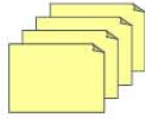
RO Business

International Application



filing

RO In/Out



Record Copy
Search Copy

ISA and
IB

(id)	(num)	(object)
Description		
p0001	0001	<p>
p0002	0002	<p>
p0003	0003	<p>
p0004	0004	<p>
p0005	0005	<p>
Claims		
c0001	1	<claim>
c0002	2	<claim>
c0003	3	<claim>

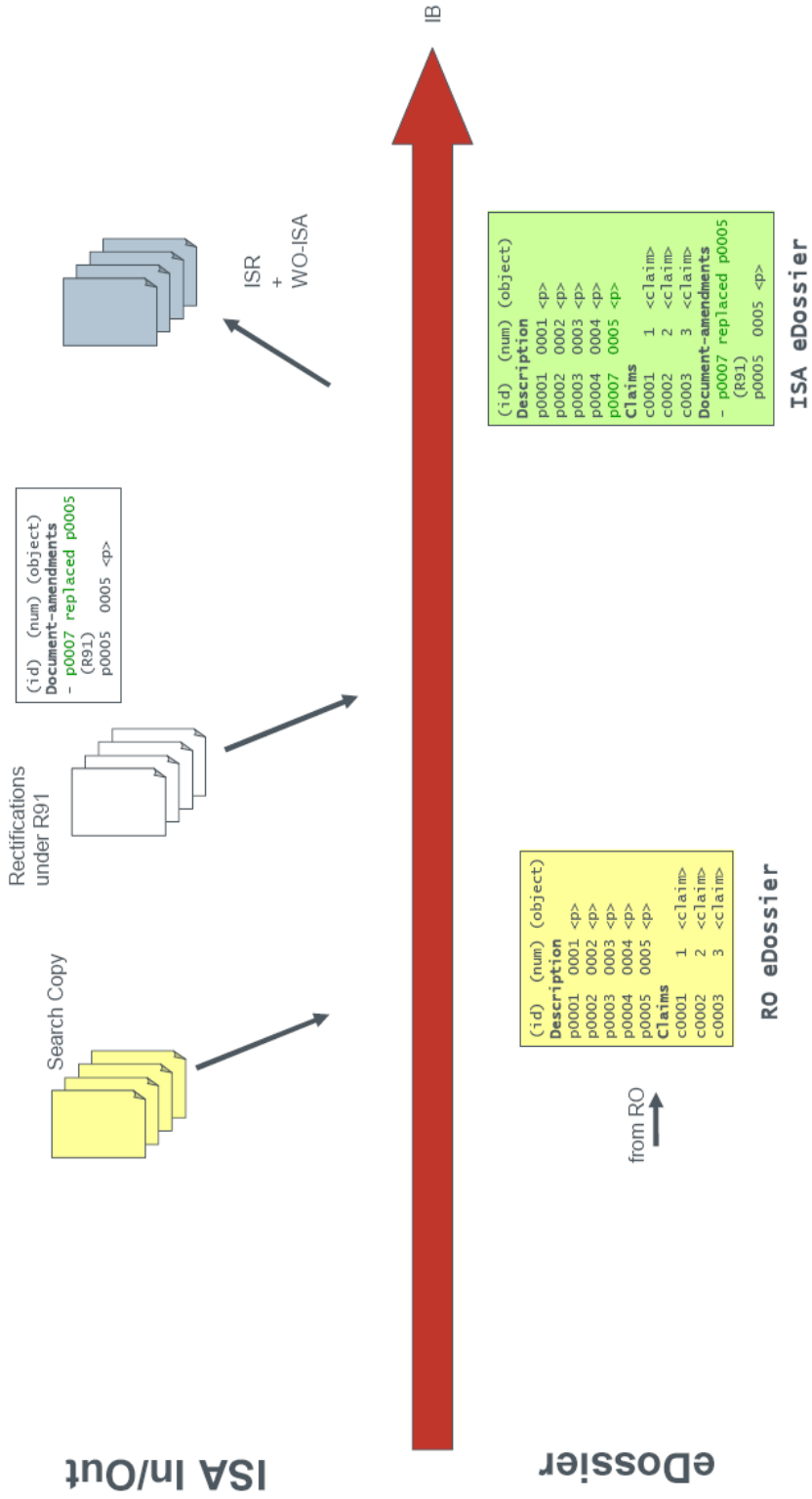
(id)	(num)	(object)
Description		
p0001	0001	<p>
p0002	0002	<p>
p0003	0003	<p>
p0004	0004	<p>
p0005	0005	<p>
Claims		
c0001	1	<claim>
c0002	2	<claim>
c0003	3	<claim>

RO eDossier

eDossier

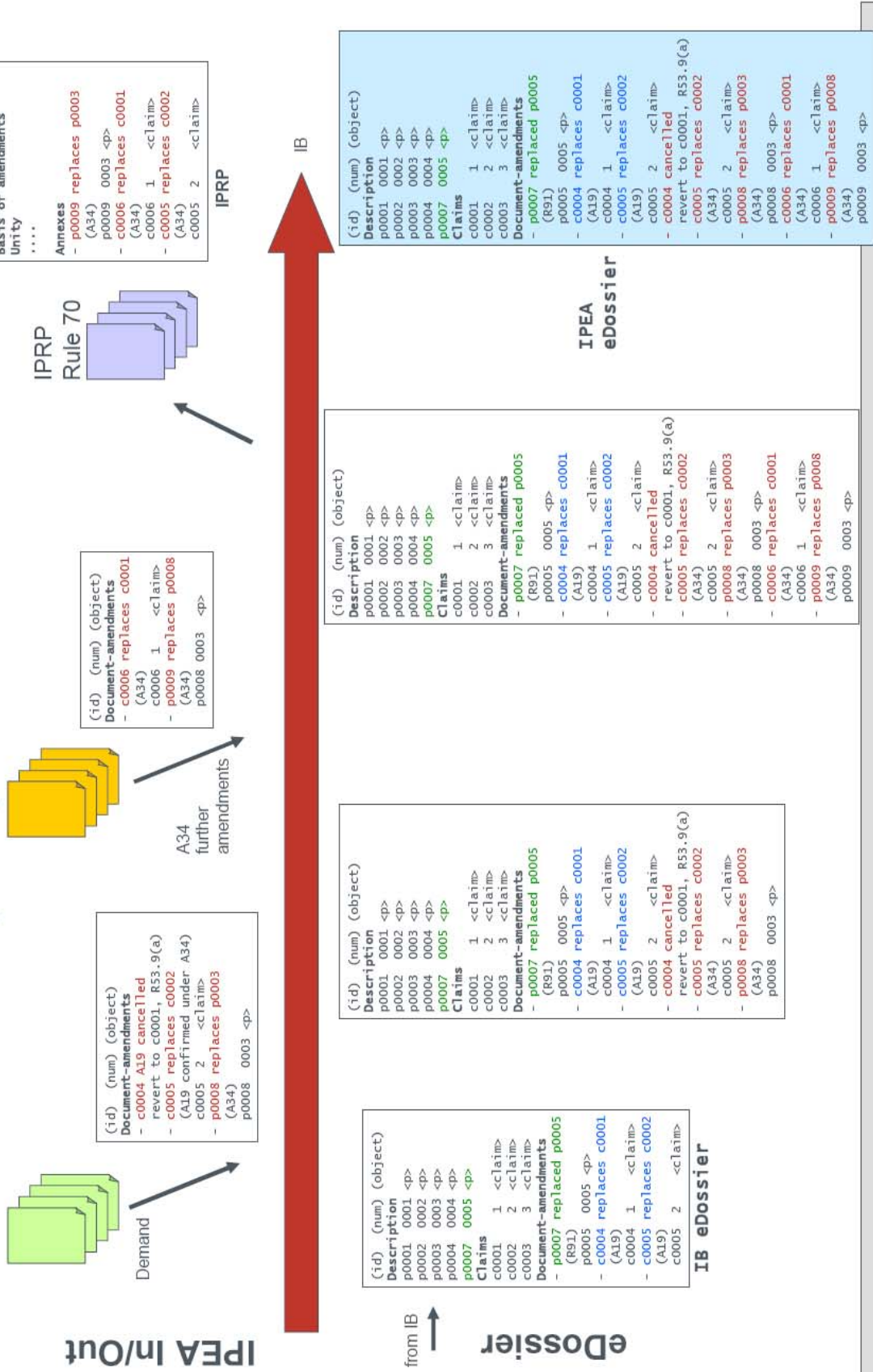


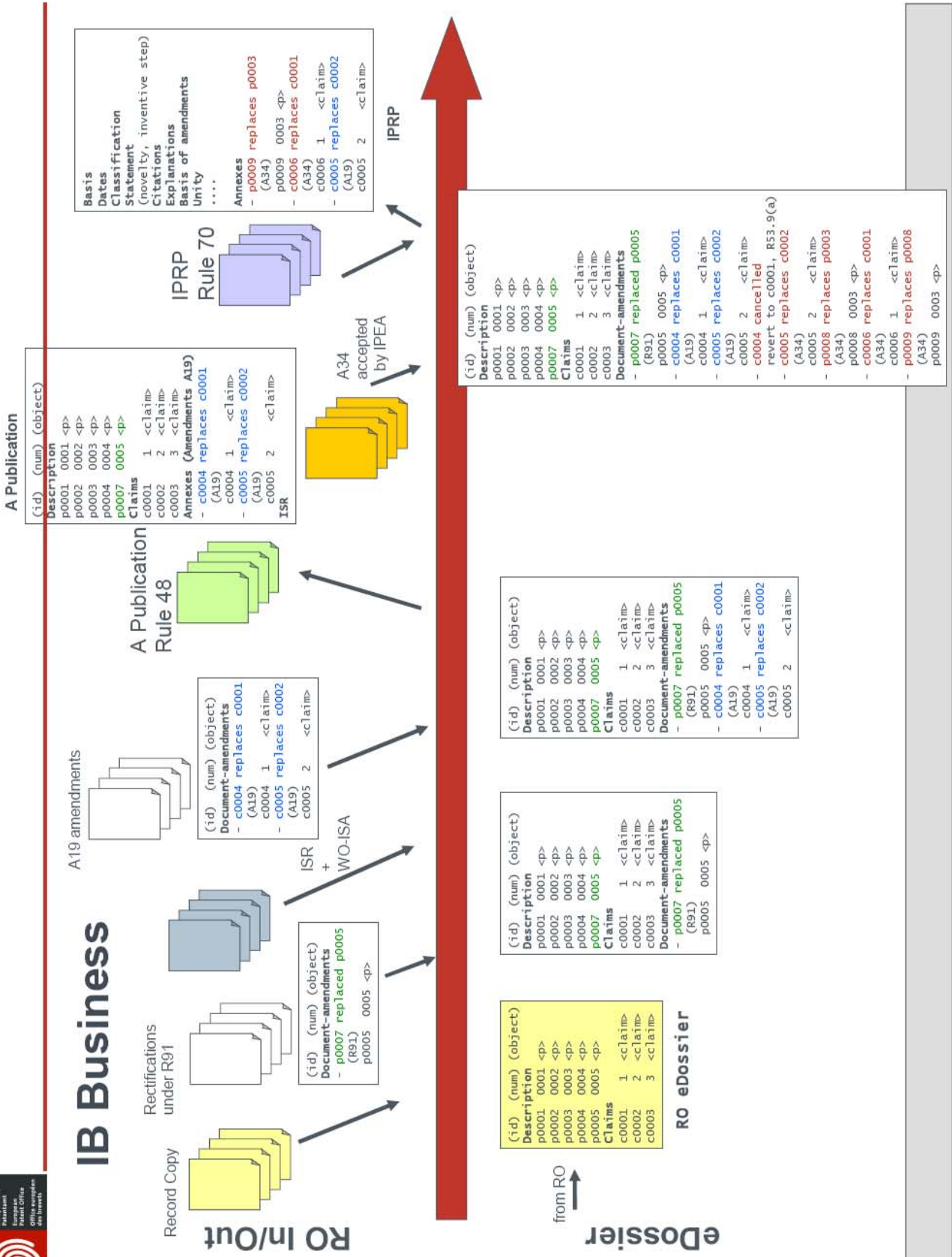
ISA Business (Ch I)





IPEA Business (Ch II)





Entry into regional / national phase

After Ch I

```
(id) (num) (object)
Description
p0001 0001 <p>
p0002 0002 <p>
p0003 0003 <p>
p0004 0004 <p>
p0007 0005 <p>
Claims
c0001 1 <claim>
c0002 2 <claim>
c0003 3 <claim>
Document-amendments
- p0007 replaced p0005
(R91)
p0005 0005 <p>
- c0004 replaces c0001
(A19)
c0004 1 <claim>
- c0005 replaces c0002
(A19)
c0005 2 <claim>
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from IB ↑

After Ch II

```
(id) (num) (object)
Description
p0001 0001 <p>
p0002 0002 <p>
p0003 0003 <p>
p0004 0004 <p>
p0007 0005 <p>
Claims
c0001 1 <claim>
c0002 2 <claim>
c0003 3 <claim>
Document-amendments
- p0007 replaced p0005
(R91)
p0005 0005 <p>
- c0004 replaces c0001
(A19)
c0004 1 <claim>
- c0005 replaces c0002
(A19)
c0005 2 <claim>
- c0004 cancelled
revert to c0001, R53.9(a)
- c0005 replaces c0002
(A34)
c0005 2 <claim>
- p0008 replaces p0003
(A34)
p0008 0003 <p>
- c0006 replaces c0001
(A34)
c0006 1 <claim>
- p0009 replaces p0008
(A34)
p0009 0003 <p>
```

from IB ↑

