

Patent Cooperation Treaty (PCT) Working Group

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LEGAL MEASURES TO SUPPORT ELECTRONIC PROCESSING

Document prepared by the International Bureau

SUMMARY

1. The International Bureau wishes to improve clarity, accuracy and efficiency of processing through more efficient workflows and greater direct use of data provided by applicants and Offices. However, changes need to be made at a pace that can be accommodated by applicants and Offices and some changes would likely require extended periods of parallel processing of applications using old and new arrangements. The document makes a specific proposal concerning mandatory provision of email addresses and explores other areas to identify priorities and seek suggestions for ways to improve processes with minimal disruption.

ELECTRONIC PROCESSING OF INTERNATIONAL APPLICATIONS

2. Over 99 per cent of international applications are now filed in electronic format. The International Bureau and most national Offices have eliminated paper for internal processing purposes – paper correspondence is scanned as it arrives. Almost all transmission of documents between Offices is also now done electronically. Nevertheless, much of the subsequent processing is still conducted according to workflows based on paper processing and some Offices still send all or most communications to applicants on paper.

3. To date, although some specific Rules have been put in place to deal with matters such as the use of digital libraries for priority documents and delays caused by the unavailability of electronic systems, the primary legal basis for most electronic processing has been PCT Rule 89*bis* together with Part 7 and Annex F of the PCT Administrative Instructions.

4. Ideally, much of the legal framework would be revised to promote new workflows and the exchange of data in directly usable formats instead of images from which relevant data needs to be transcribed, with the time and risk of error involved, with paper processing options being included as the exception, rather than the model on which processes are based and understood.

5. However, a complete overhaul of the Rules in a single step is impractical. Moreover, international phase processing is a distributed process and the PCT is used differently according to the systems and options provided by national Offices and the behaviors influenced by national processing. Around 120 national and regional Offices as well as the International Bureau act as receiving Offices. Twenty-five Offices have been appointed as International Searching and Preliminary Examining Authorities and all applications are processed by the International Bureau. Improvements to processing needs to be underpinned by a strong legal basis and consistently implemented technical standards but must also take into account the capabilities of the Offices and applicants concerned.

FULL TEXT PROCESSING

6. One priority area is full text processing of the application body. Less than 30 per cent of applications are presently filed in XML format, though the China National Intellectual Property Administration now converts all applications to XML format for processing, irrespective of the format in which they were filed, meaning that over half of all international applications are received by the International Bureau for processing in XML format. New international publication processes are being phased in, which base international publication directly on the XML text, including any corrections, rectifications and Article 19 amendments that may be made prior to publication. A Text Processing Task Force has been created to address the barriers to filing and more efficient processing of applications in full text formats. This is intended to lead to a replacement of Rule 11 with new formalities requirements based primarily on electronic filing considerations, as well as consequential modifications elsewhere, such as in formalities examination under Rule 26 and rectification under Rule 91 where replacement sheets are required.

7. A further goal is using the XML already generated as part of Office processing more effectively to provide improved information and services. Some services can be provided informally without a specific legal basis, but where this affects the official records and actions of Offices and applicants, a legal basis is necessary. An aspect of this is dealt with in document PCT/WG/17/6, concerning languages of communication.

ELECTRONIC DELIVERY OF DOCUMENTS

8. Ideally, it would be encouraged for all communications to take place either through secure online portals such as ePCT, or else using machine-to-machine processes where documents and data could be exchanged directly between Office systems and the patent management systems used by most applicants. Various modifications to the Administrative Instructions have worked towards this, most recently the introduction of Section 709(b-*bis*), concerning the transmittal of documents by making them available to the applicant in a secure electronic system. However, to move more completely to electronic communications, a suitable electronic form of contact must be provided in all cases as well as encouraging greater use of secure systems such as ePCT and APIs for communication with the International Bureau and national Offices.

9. Annex I to this document sets out a draft amendment to Rule 4, requiring the applicant or agent to provide an email address. The same requirements would apply to the demand by virtue of the references in Rules 53.4 and 53.5; it is proposed to add a reference to Rule 4.4 in Rule 45*bis*.1(b)(i) to cover requests for supplementary search.

10. Some applicants at present do not provide email addresses at the time of filing because of concerns that these will be visible in the request form when published. The International Bureau already seeks to minimize this risk by excluding email addresses from the text form data published on PATENTSCOPE. However, any email provided addresses do remain visible in the image format views of the request and other forms. To address the issue more completely, Annex I also includes proposed amendments to Rule 94 to allow “redacted” views to be prepared of XML forms that exclude email addresses from public access. Applicants and national Offices in all capacities would retain access to the full data through XML versions of the forms as well as other data feeds and private data views visible through tools such as ePCT.

11. Proposed new Rule 94.4(e) is drafted in general terms allowing other exceptions from public access to personal data also to be provided by the Administrative Instructions – a likely further step would be hiding addresses of inventors during the international phase. Further considerations around personal data protection are set out in document PCT/WG/17/8.

12. Annex II sets out a possible first implementation of proposed Rule 94.4(e). Proposed Section 116 allows for redacting email addresses included in XML forms and data. It will take time for receiving Offices and International Authorities to update their stylesheets and potentially other aspects of their systems in order to stop generating images of email addresses. Consequently, draft Section 116 is presently written as an option to exclude public availability of the email address, rather than a requirement. However, it is hoped that all Offices will work in the direction of limiting access and that this provision can be strengthened in the future. Disclosure requirements for designated and elected Offices under Rules 94.2*bis* and 94.3 remain a matter of national law, subject only to the existing obligations under Article 30(2)(a).

13. Exclusion of personal information provided on paper or in electronic image or unstructured text formats would require significant manual effort to create redacted versions of documents. Consequently, it is not proposed to offer any possibility of requesting that email addresses provided in such ways be excluded from availability under Rule 94.4(e). However, this would not preclude the applicant from requesting the exclusion of such matter on a case-by-case basis under existing Rule 94.1(e), which is proposed to be moved to become Rule 94.4(a).

OTHER ISSUES

14. The issues referred to above are the ones currently being treated as priorities for improvement of the Rules and Administrative Instructions. However, views are welcome on whether other areas should also be given priority.

15. The Working Group is invited to comment on:

*(i) the proposals for amendment of Rules 4, 45*bis* and 94 set out in Annex I to this document; and*

(ii) other priorities for legal measures to support electronic processing of international applications.

[Annex I follows]

DRAFT AMENDMENTS TO THE PCT REGULATIONS¹

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 4

The Request (Contents)

4.1 to 4.3 *[No change]*

4.4 *Names and Addresses*

(a) [No change] Names of natural persons shall be indicated by the person's family name and given name(s), the family name being indicated before the given name(s).

(b) [No change] Names of legal entities shall be indicated by their full, official designations.

(c) Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, shall consist of all the relevant administrative units up to, and including, the house number, if any. Where the national law of the designated State does not require the indication of the house number, failure to indicate such number shall have no effect in that State. ~~In order to allow rapid communication with the applicant, it is recommended to indicate any teleprinter address, telephone and facsimile machine numbers, or corresponding data for other like means of communication, of the applicant or, where applicable, the agent or the common representative.~~ An email address and telephone number shall be provided for the applicant or, where applicable, the agent or the common representative. A facsimile machine number or corresponding data for other means of communication may be provided.

(d) [No change] For each applicant, inventor, or agent, only one address may be indicated, except that, if no agent has been appointed to represent the applicant, or all of them if more than one, the applicant or, if there is more than one applicant, the common representative, may indicate, in addition to any other address given in the request, an address to which notifications shall be sent.

4.5 to 4.19 [No change]

Rule 45bis

Supplementary International Searches

45bis.1 Supplementary Search Request

(a) [No change]

(b) A request under paragraph (a) (“supplementary search request”) shall be submitted to the International Bureau and shall indicate:

(i) the name and address of the applicant and of the agent (if any), the title of the invention, the international filing date and the international application number; [Rule 4.4 shall apply mutatis mutandis](#);

(ii) the International Searching Authority that is requested to carry out the supplementary international search (“Authority specified for supplementary search”); and

(iii) where the international application was filed in a language which is not accepted by that Authority, whether any translation furnished to the receiving Office under Rule 12.3 or 12.4 is to form the basis of the supplementary international search.

(c) to (e) [No change]

45bis.2 to 45bis.9 [No change]

Rule 94

Access to Files

94.1 *Access to the File Held by the International Bureau*

(a) At the request of the applicant or any person authorized by the applicant, the International Bureau shall furnish, subject to reimbursement of the cost of the service, copies of any document contained in its file.

(b) The International Bureau shall, at the request of any person but not before the international publication of the international application and subject to Article 38 and ~~paragraphs (d) to (g)~~ [Rule 94.4](#), furnish copies of any document contained in its file. The furnishing of copies may be subject to reimbursement of the cost of the service.

(c) The International Bureau shall, if so requested by an elected Office, but not before the international preliminary examination report has been established, furnish on behalf of that Office copies under paragraph (b) of any document transmitted to it under Rule 71.1(a) or (b) by the International Preliminary Examining Authority. The International Bureau shall promptly publish details of any such request in the Gazette.

~~(d) The International Bureau shall not provide access to any information contained in its file which has been omitted from publication under Rule 48.2(l) and to any document contained in its file relating to a request under that Rule.~~

~~(e) Upon a reasoned request by the applicant, the International Bureau shall not provide access to any information contained in its file and to any document contained in its file relating to such a request, if it finds that:~~

~~(i) this information does not obviously serve the purpose of informing the public about the international application;~~

~~(ii) public access to such information would clearly prejudice the personal or economic interests of any person; and~~

~~(iii) there is no prevailing public interest to have access to that information.~~

~~Rule 26.4 shall apply mutatis mutandis as to the manner in which the applicant shall present the information which is the subject of a request made under this paragraph.~~

~~(f) Where the International Bureau has omitted information from public access in accordance with paragraphs (d) or (e), and that information is also contained in the file of the international application held by the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, the International Bureau shall promptly notify that Office and Authority accordingly.~~

~~(g) The International Bureau shall not provide access to any document contained in its file which was prepared solely for internal use by the International Bureau.~~

94.1bis *Access to the File Held by the Receiving Office*

(a) [No change] At the request of the applicant or any person authorized by the applicant, the receiving Office may provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(b) [No change] The receiving Office may, at the request of any person, but not before the international publication of the international application and subject to paragraph (c), provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(c) The receiving Office shall not provide access under paragraph (b) to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication in accordance with Rule 48.2(l) or from public access in accordance with Rule ~~94.1(d) or (e)~~ 94.4(b) or (e).

94.1 ter Access to the File Held by the International Searching Authority

(a) [No change] At the request of the applicant or any person authorized by the applicant, the International Searching Authority may provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(b) [No change] The International Searching Authority may, at the request of any person, but not before the international publication of the international application and subject to paragraph (c), provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(c) The International Searching Authority shall not provide access under paragraph (b) to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication in accordance with Rule 48.2(l) or from public access in accordance with Rule ~~94.1(d) or (e)~~ 94.4(b) or (e).

(d) [No change] Paragraphs (a) to (c) shall apply *mutatis mutandis* to the Authority specified for supplementary search.

94.2 *Access to the File Held by the International Preliminary Examining Authority*

(a) [No change] At the request of the applicant or any person authorized by the applicant, the International Preliminary Examining Authority shall provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(b) [No change] At the request of any elected Office, but not before the establishment of the international preliminary examination report and subject to paragraph (c), the International Preliminary Examining Authority shall provide access to any document contained in its file. The furnishing of copies of documents may be subject to reimbursement of the cost of the service.

(c) The International Preliminary Examining Authority shall not provide access under paragraph (b) to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication in accordance with Rule 48.2(I) or from public access in accordance with Rule ~~94.1(d) or (e)~~ [94.4\(b\) or \(e\)](#).

94.2bis and 94.3 *[No change]*

94.4 Exceptions to Access to File

(a) [Moved from Rule 94.1(d)] The International Bureau shall not provide access to any information contained in its file which has been omitted from publication under Rule 48.2(l) and to any document contained in its file relating to a request under that Rule.

(b) [Moved from Rule 94.1(e)] Upon a reasoned request by the applicant, the International Bureau shall not provide access to any information contained in its file and to any document contained in its file relating to such a request, if it finds that:

(i) this information does not obviously serve the purpose of informing the public about the international application;

(ii) public access to such information would clearly prejudice the personal or economic interests of any person; and

(iii) there is no prevailing public interest to have access to that information.

Rule 26.4 shall apply *mutatis mutandis* as to the manner in which the applicant shall present the information which is the subject of a request made under this paragraph.

(c) [Moved from Rule 94.1(f) with consequential changes to paragraph references] Where the International Bureau has omitted information from public access in accordance with paragraphs (a) or (b), and that information is also contained in the file of the international application held by the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, the International Bureau shall promptly notify that Office and Authority accordingly.

(d) [Moved from Rule 94.1(g)] The International Bureau shall not provide access to any document contained in its file which was prepared solely for internal use by the International Bureau.

(e) The Administrative Instructions may permit the exclusion of personal data associated with the international application from public accessibility, other than:

(i) the name of the applicant, inventor and any agents;

(ii) at least one address allowing contact with the applicant or agent; and

(iii) the nationality and residence indications of the applicant.

[Annex II follows]

ANNEX II

DRAFT MODIFICATIONS TO THE PCT ADMINISTRATIVE INSTRUCTIONS

Section 116
Personal Data Protection

Where the International Bureau, the receiving Office, the International Searching Authority, any Authority specified for supplementary search or the International Preliminary Examining Authority receive or prepare forms or data in XML format, that Office, Bureau or Authority, or the International Bureau may render a view of that form or data excluding any email addresses and not make the XML available to the public.

[End of Annex II and of document]