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STANDING COMMITTEE ON INFORMATION TECHNOLOGIES
STANDARDS AND DOCUMENTATION WORKING GROUP

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RE-ACTIVATION OF TASK No. 15

Document prepared by the Secretariat

Introduction

1. The rapid development of information technologies in recent years has resulted in radical changes in procedures for the filing and processing of patent applications and related documents. Electronic filing and processing of patent applications as well as other communications are increasing. The international legal framework for handling patent applications needs continuous adjustment to accommodate these developments; one of such adjustment is to clarify the provision and exchange in electronic form of priority documents in respect of national, regional and international applications.

2. As a first step towards such adjustment, the Assemblies of the Paris Union and the PCT Union, held in Geneva in conjunction with the 40th series of meetings of the Assemblies of the Member States of WIPO from September 27 to October 5, 2004, agreed upon a common understanding to the effect that neither the Paris Convention nor the PCT prevent an Office from determining alternative forms of certification of priority documents in electronic form which appropriately correspond to the electronic environment (see document A/40/6), without prejudice to an Office's continued right to require a priority document to be furnished to it on paper. The common understanding adopted by the Assemblies of the Paris Union and the PCT Union is contained in the Annex to this document.

3. During the discussions at the Assemblies of the Paris Union and the PCT Union relating to the common understanding referred to in above paragraph, Member States stressed the need – as stated in document A/40/6 – that, subsequent to the adoption of the common understanding, certain operational issues relating to the processing and certification in electronic form of priority documents would need to be addressed, and that the technical details relating to the establishment of a standard to facilitate the electronic exchange of priority documents should be discussed in the Standing Committee for Information Technologies.

4. Task No. 15, entitled “Study the consequences of electronic filing of applications on the production of certified office copies with particular reference to those used for priority purposes”, was initiated in 1993 and discussed at the PCIPI/MI/XII meeting held in December 1993. However, it has been held in abeyance since then, pending further developments on Task No. 13 (“Consider the “E-PCT” Standard for adoption as a WIPO Standard for e-filing, processing and storage of patent applications”). In respect of Task No. 13, no work is expected before appropriate experience is gained with the E-PCT standard (see document SCIT/SDWG/5/10, Annex I).

5. Noting the above and, as recognized by Member States, the need to resolve certain operational and technical issues relating to the processing and certification in electronic form of priority documents (see paragraph 3, above), the International Bureau proposes:

(a) to re-activate Task No. 15 so as to elaborate standards and procedures relating to the provision (including certification) and exchange in electronic form of priority documents, taking into account the experience gained with the E-PCT standard (Task No. 13), and to rename Task No. 15 accordingly;

(b) to designate the International Bureau as the Task Leader;

(c) to request the International Bureau as the Task Leader to report to the Standards and Documentation Working Group at its next session, and also to the Working Group on Reform of the PCT at its next session, on the progress of the task.

6. The Standards and Documentation Working Group is invited to consider and, if found appropriate, to approve the proposal contained in paragraph 5, above.

[Annex follows]

ANNEX

COMMON UNDERSTANDING CONCERNING
THE APPLICATION OF ARTICLE 4D(3) OF THE PARIS CONVENTION,
ARTICLE 8 OF THE PCT AND RULE 17 OF THE PCT REGULATIONS

*(as agreed by the Assemblies of the Paris Union and the PCT Union,
held in Geneva in conjunction with the 40th series of meetings of the Assemblies of the
Member States of WIPO from September 27 to October 5, 2004 (see document A/40/6)*

“The Assemblies of the Paris Union and the PCT Union agree that the following principles shall apply to the application of Article 4D(3) of the Paris Convention, Article 8 of the PCT and Rule 17 of the PCT Regulations:

“(i) it is for the competent authority furnishing the priority document to determine what constitutes certification of a priority document and the date of filing, and how it will certify such a document;

“(ii) each office will accept a single certification that applies to more than one priority document (“collective certification”), provided that such certification permits identification of all priority documents to which it relates;

“(iii) a non-exhaustive list of examples of forms of certification of priority documents agreed to be acceptable consists of the following:

- certification in paper form;
- certification in electronic character coded form;
- an electronic image of a certification on paper;
- the collective certification of multiple priority documents transmitted by an office to another office or to the International Bureau;
- the collective certification of multiple priority documents contained in an office database providing access to such documents to those entitled;

“(iv) for the purpose of Article 8 and Rule 17 of the PCT, once a priority document has been issued and certified in accordance with the foregoing principles by the receiving office, and transmitted to the International Bureau in electronic form, no designated or elected office may require any different form of certification or any re-certification of that priority document; however, the International Bureau will continue, on request by any designated or elected office, to furnish copies in paper form of priority documents held in connection with international applications under the PCT.”

[End of Annex and of document]