

PCT/FF/PFC 18/001  
ORIGINAL: FRANCAIS / ENGLISH  
SITUATION AT: JANUARY 8, 2019  
SITUATION AU : 8 JANVIER 2019

**Administrative Instructions Under the  
Patent Cooperation Treaty (PCT)  
Standard for the Electronic Filing and Processing of International Applications**

**Instructions administratives du  
Traité de coopération en matière de brevets (PCT)  
Norme concernant le dépôt et le traitement électroniques**

PROPOSAL FOR CHANGE FILE/  
DOSSIER RELATIF A LA PROPOSITION DE MODIFICATION

<b>SUBJECT: Changes to Annex F, Appendix I, section 3.6 (modification of the DTD for the PCT fee sheet and the PCT fee sheet chapter 2)</b>		PROPOSED BY: EP	
<b>SUJET : Modifications de la section 3.6 de l'appendice I de l'annexe F (modification des DTDs de la feuille de calcul des taxes et la feuille de calcul des taxes chapitre II)</b>		PROPOSÉES PAR : EP	
HANDLING: Expedited cycle TRAITEMENT : Cycle accéléré		PROPOSED DATE OF ENTRY INTO FORCE: 01.04.2019 DATE PROPOSÉE D'ENTRÉE EN VIGUEUR :	
<b>Annex/ Annexe</b>	<b>Content/Contenu</b>	<b>Origin/ Origine</b>	<b>Date</b>
1	Modifications of the DTD for the fee sheet and the fee sheet chapter 2 to enable automated reimbursement processing  Modifications des DTDs pour la feuille de calcul des taxes et la feuille de calcul des taxes chapitre II afin de permettre le traitement automatisé des remboursements	EP	26.10.2018
2	Comments from the Swedish Patent and Trademark Office	SE	20.11.2018
3	Comments from the International Bureau	IB	20.11.2018

4	Comments from the National Institute of Industrial Property of Chile (INAPI)	CL	20.11.2018
5	Comments from the Japan Patent Office	JP	07.12.2018
6	Comments from the German Patent and Trade Mark Office (DPMA)	DE	19.12.2018
7	Comments from the United Kingdom Intellectual Property Office (UKIPO)	GB	07.01.2019
8	Comments from the International Bureau	IB	08.01.2019

  

Next action:	Entry into force	By:	01.04.2019
Prochaine action :	Entrée en vigueur	Pour le :	

[Annex I follows/ L'annexe I suit]

Item 1	
Location:	Annex F, Appendix I, section 3.6, fee-sheet DTD
Change:	<p><b>FROM:</b> &lt;!ELEMENT fee-sheet ((file-reference-id? , applicant-name , prescribed-fees , amount-grand-total+ , deposit-account? , dtext* , payment-contact?))   doc-page+)&gt;</p> <p><b>TO:</b> &lt;!ELEMENT fee-sheet ((file-reference-id? , applicant-name , prescribed-fees , amount-grand-total+ , deposit-account? , dtext* , payment-contact?, <u>reimbursement-deposit-account?</u>))   doc-page+)&gt;</p> <p><u>&lt;!-- Instructions to reimburse to a deposit account --&gt;</u></p> <p><u>&lt;!ELEMENT reimbursement- deposit-account (ro, account-no, date, %name_group;)&gt;</u></p>
Reason:	<p>This change is requested so as to enable automated reimbursement procedures at RO, ISA and IPEA using reimbursement information to be provided at the time of filing an international application.</p> <p>At present the applicant/agent is able to indicate in PCT-SAFE as a “mode of payment” “authorization to charge current account” and in ePCT as a “payment method” “deposit account” for payment of fees in the fee sheet accompanying the PCT/RO/101.</p> <p>With the implementation of this proposal the applicant/agent should have the optional possibility to indicate a (different) deposit account for reimbursements to be made to, independent from the payment method indicated. This indication of a deposit account for reimbursement does not require a signature from the deposit account holder but is covered by the signature of the applicant/agent on the PCT/RO/101.</p> <p>This would result in fee-sheet XML instances containing structures as follows:</p> <pre>&lt;fee-sheet&gt; ...   &lt;reimbursement-deposit-account&gt;     &lt;ro&gt;       &lt;country&gt;EP&lt;/country&gt;     &lt;/ro&gt;     &lt;account-no&gt;28123456&lt;/account-no&gt;     &lt;date&gt;20180925&lt;/date&gt;     &lt;name name-type="legal"&gt;TheName&lt;/name&gt;   &lt;/reimbursement-deposit-account&gt; &lt;/fee-sheet&gt;</pre>
Item 2	
Location:	Annex F, Appendix I, section 3.6, fee-sheet-chapter2 DTD

<p>Change:</p>	<p><b>FROM:</b>        &lt;!ELEMENT fee-sheet-chapter2 ((application-reference? , file-reference-id? , applicant-name , further-applicant? , currency , preliminary-examin-fee , handling-fee , amount-total , payment-mode , deposit-account-ipea? , reimbursement-deposit-account-ipea?)   doc-page+)&gt;</p> <p><b>TO:</b>        &lt;!ELEMENT fee-sheet-chapter2 ((application-reference? , file-reference-id? , applicant-name , further-applicant? , currency , preliminary-examin-fee , handling-fee , amount-total , payment-mode , deposit-account-ipea? , <u>reimbursement-deposit-account-ipea?</u>)   doc-page+)&gt;</p> <p><u>&lt;!--        Instruction to reimburse to a deposit account        --&gt;</u></p> <p><u>&lt;!ELEMENT reimbursement-deposit-account-ipea (ipea, account-no, date, %name_group; )&gt;</u></p>
<p>Reason:</p>	<p>This change is requested so as to enable automated reimbursement procedures at IPEA using reimbursement information to be provided at the time of filing a demand for international preliminary examination.</p> <p>For the fee sheet accompanying the PCT/IPEA/401 the applicant/agent is able to indicate in the ePCT as a “payment method for fees payable to IPEA” “Deposit account with IPEA” and in the PCT-DEMAND plug-in as a “method of payment” “debit from deposit account” for payment of fees.</p> <p>With the implementation of this proposal the applicant/agent should have the optional possibility to indicate a (different) deposit account for reimbursements to be made to, independent from the payment method indicated. This indication of a deposit account for reimbursement does not require a signature from the deposit account holder but is covered by the signature of the applicant/agent on the PCT/IPEA/401.</p> <p>This would result in fee-sheet-chapter2 XML containing structures as follows:</p> <pre>&lt;fee-sheet-chapter2&gt; ...   &lt;reimbursement-deposit-account-ipea&gt;     &lt;ipea&gt;       &lt;country&gt;EP&lt;/country&gt;     &lt;/ipea&gt;     &lt;account-no&gt;28123456&lt;/account-no&gt;     &lt;date&gt;20180925&lt;/date&gt;     &lt;name name-type="legal"&gt;TheName&lt;/name&gt;   &lt;/reimbursement-deposit-account-ipea&gt; &lt;/fee-sheet-chapter2&gt;</pre>

**Comments from the Swedish Patent and Trademark Office**

PRV has no comments regarding this circular.

[Annex III follows / L'annexe III suit]

### Comments from the International Bureau

The International Bureau proposes that an alternate solution for this markup be adopted to properly reflect the case of reimbursements to be made by an Office other than the receiving Office. This will be particularly significant in the case where the process is extended to cover applications where different Offices act in the capacities of receiving Office and International Searching or Preliminary Examining Authority.

This proposal allows for the Office processing the reimbursement to be different from the receiving Office, introducing an element "ip-office" in a common reimbursement-deposit-account element for use in both the RO/101 fee calculation sheet and the IPEA/401 fee calculation sheet. This proposal would result in the DTD changes as follows:

Item 1	
Location:	Annex F, Appendix I, section 3.6, fee-sheet DTD
Change:	<p><b>FROM:</b>  <code>&lt;!ELEMENT fee-sheet ((file-reference-id? , applicant-name , prescribed-fees , amount-grand-total+ , deposit-account? , dtext* , payment-contact?))   doc-page+)&gt;</code></p> <p><b>TO:</b>  <code>&lt;!ELEMENT fee-sheet ((file-reference-id? , applicant-name , prescribed-fees , amount-grand-total+ , deposit-account? , dtext* , payment-contact? , <u>reimbursement-deposit-account*</u>)   doc-page+)&gt;</code></p> <p><u>&lt;!--  Instructions to reimburse to a deposit account  --&gt;</u></p> <p><u>&lt;!ELEMENT reimbursement-deposit-account(ip-office, account-no, date, %name_group;)&gt;</u></p>
Reason:	<p>This change is requested to enable automated reimbursement procedures at RO, ISA and IPEA using reimbursement information to be provided at the time of filing an international application.</p> <p>At present, the applicant/agent is able to indicate in PCT-SAFE as a "mode of payment" "authorization to charge current account" and in ePCT as a "payment method" "deposit account" for payment of fees in the fee sheet accompanying the PCT/RO/101.</p> <p>With the implementation of this proposal, the applicant/agent should have the optional possibility to indicate a (different) deposit account for reimbursements to be made to, independent from the payment method indicated. This indication of a deposit account for reimbursement does not require a signature from the deposit account holder but is covered by the signature of the applicant/agent on the PCT/RO/101.</p> <p>This would result in fee-sheet XML instances containing structures as follows:</p>

	<pre> &lt;fee-sheet&gt; ...   &lt;reimbursement-deposit-account&gt;     &lt;ip-office&gt;EP&lt;/ip-office&gt;     &lt;account-no&gt;28123456&lt;/account-no&gt;     &lt;date&gt;20180925&lt;/date&gt;     &lt;name name-type="legal"&gt;TheName&lt;/name&gt;   &lt;/reimbursement-deposit-account&gt; &lt;/fee-sheet&gt; </pre>
--	---

Item 2	
Location:	Annex F, Appendix I, section 3.6, fee-sheet-chapter2 DTD
Change:	<p><b>FROM:</b>  &lt;!ELEMENT fee-sheet-chapter2 ((application-reference? , file-reference-id? , applicant-name , further-applicant? , currency , preliminary-examin-fee , handling-fee , amount-total , payment-mode , deposit-account-ipea? , reimbursement-deposit-account-ipea?)   doc-page+)&gt;</p> <p><b>TO:</b>  &lt;!ELEMENT fee-sheet-chapter2 ((application-reference? , file-reference-id? , applicant-name , further-applicant? , currency , preliminary-examin-fee , handling-fee , amount-total , payment-mode , deposit-account-ipea? , <u>reimbursement-deposit-account*</u>)   doc-page+)&gt;</p> <p><u>&lt;!--  Instruction to reimburse to a deposit account  --&gt;</u></p> <p><u>&lt;!ELEMENT reimbursement-deposit-account(ip-office, account-no, date, %name_group; )&gt;</u></p>
Reason:	<p>This change is requested to enable automated reimbursement procedures at IPEA using reimbursement information to be provided at the time of filing a demand for international preliminary examination.</p> <p>For the fee sheet accompanying the PCT/IPEA/401 the applicant/agent is able to indicate in the ePCT as a “payment method for fees payable to IPEA” “Deposit account with IPEA” and in the PCT-DEMAND plug-in as a “method of payment” “debit from deposit account” for payment of fees.</p> <p>With the implementation of this proposal, the applicant/agent should have the optional possibility to indicate a (different) deposit account for reimbursements to be made to, independent from the payment method indicated. This indication of a deposit account for reimbursement does not require a signature from the deposit account holder but is covered by the signature of the applicant/agent on the PCT/IPEA/401.</p> <p>This would result in fee-sheet-chapter2 XML instances containing structures as follows:</p>

<pre>&lt;fee-sheet-chapter2&gt; ...   &lt;reimbursement-deposit-account &gt;     &lt;ip-office&gt;EP&lt;/ip-office&gt;     &lt;account-no&gt;28123456&lt;/account-no&gt;     &lt;date&gt;20180925&lt;/date&gt;     &lt;name name-type="legal"&gt;TheName&lt;/name&gt;   &lt;/reimbursement-deposit-account &gt; &lt;/fee-sheet-chapter2&gt;</pre>
---

[Annex IV follows / L'annexe IV suit]



**Comments from the National Institute of Industrial Property of Chile (INAPI)**

Regarding Circular C. PCT 1549 dated 12/11/2018, in which our Office is invited to provide comments on the proposed changes to the standard for the electronic filing and processing of international applications (Annex F of the PCT Administrative Instructions) in relation to the fee calculation sheet and the fee calculation sheet chapter II, our comments are as follows: having reviewed the proposals made by the International Bureau, we have no comments on them and we agree with their content, as we believe that these effectively aim to facilitate the electronic filing and processing of international applications.

[Annex V follows / L'annexe V suit]

**Comments from the Japan Patent Office**

Concerning Circular C. PCT 1549, the Japan Patent Office (JPO) reviewed the original proposal PCT/EF/PFC 18/001 and the alternative proposal made by the IB, and has no comments.  
Thank you.

[Annex VI follows / L'annexe VI suit]

**Comments from the German Patent and Trade Mark Office (DPMA)**

The German Patent and Trade Mark Office (DPMA) welcomes the opportunity to provide comments on the proposals contained in Circular C.PCT 1549. Since the DPMA only acts as RO and not IPEA, we only refer to the proposed changes in PCT/RO/101.

The DPMA does not have any objections against the proposed changes to the Standard for the Filing and Processing in Electronic Form of International Applications.

Just one further comment: the DPMA would welcome a further change in the document PCT/RO/101 Annex Fee Calculation Sheet, namely including the IBAN/BIC and the unique Mandate reference in order to simplify the payments.

[Annex VII follows / L'annexe VII suit]

**Comments from the United Kingdom Intellectual Property Office (UKIPO)**

Providing the change is being carried out centrally, the UKIPO has no objections to the introduction of a new field in which the applicant can disclose their deposit account at the EPO for any refunds issued by them as the ISA. The only comment we have is that the field should be suitably named, e.g. ISA deposit account number (in case of refunds), to ensure the user provides their deposit account at the ISA instead of a random account number.

[Annex VIII follows / L'annexe VIII suit]

### **Comments from the International Bureau**

The International Bureau would like to express its thanks to the Offices that have reviewed the proposal and provided comments.

In respect of the comments received, the international Bureau advises:

- that it has noted the point raised by the DPMA with regard to its proposal to including the IBAN/BIC and unique mandate reference on fee sheets to simplify payment processing; the International Bureau is concerned that the public file should contain a minimum of private payment information for reasons of security and thus proposes not to add this information to the form at this time; and,
- that it has noted the point raised by the UKIPO in respect of the identification of the fields in the user interface to minimize the risk of an applicant mistakenly referring to a deposit account at an Office other than the Office that would be processing the reimbursement.

In respect of the original proposal from the EPO and the alternate solution proposed by the International Bureau, the alternate proposal has been selected, noting that there were no controversial comments, on the basis that it provides for the possibility for future implementation should an implementation require that the receiving Office is not the same Office as the International Searching Authority.

It is noted that the paper request form has not been modified to include this change as this change is being implemented for applications filed electronically.

Considering the comments received from PCT member states and with no controversial comments outstanding, the International Bureau will adopt the proposal for entry into force on April 1, 2019.

[End of Annex VIII and of document/  
Fin de l'annexe VIII et du document]