

**PCT/EF/PFC 20/001**  
**ORIGINAL: FRANCAIS / ENGLISH**  
**SITUATION AT: SEPTEMBER 14, 2020**  
**SITUATION AU : 14 SEPTEMBRE 2020**

**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 5.13 (modification of the DTD for the written opinion (ISA/237))</b>		PROPOSED BY: KR	
<b>SUJET : Modifications de la section 5.13 de l'appendice I de l'annexe F (modification du opinion écrite (ISA/237))</b>		PROPOSÉES PAR : KR	
HANDLING: Expedited cycle TRAITEMENT : Cycle accéléré		PROPOSED DATE OF ENTRY INTO FORCE: 01.01.2021 DATE PROPOSÉE D'ENTRÉE EN VIGUEUR :	
Annex/ Annexe	Content/Contenu	Origin/ Origine	Date
1	Modification of the DTD for the written opinion (ISA/237) Modification de le DTD du opinion écrite (ISA/237)	KR	07.05.2020
2	Comments by the Portuguese Institute of Industrial Property	PT	02.06.2020
3	Comments by the Federal Service for Intellectual Property	RU	16.06.2020
4	Comments by the Intellectual Property Agency of the Republic of Azerbaijan	AZ	19.06.2020

5	Comments by the National Institute of Industrial Property of Chile	CL	22.06.2020
6	Comments by the Japan Patent Office	JP	29.06.2020
7	Comments by the United States Patent and Trademark Office	US	03.07.2020
8	Comments by the European Patent Office	EP	16.06.2020
9	Comments from the International Bureau	IB	14.09.2020

Next action:	Entry into force	By:	01.01.2021
Prochaine action :	Entrée en vigueur	Pour le :	

[Annex I follows/  
L'annexe I suit]

Item 1	
Location:	Annex F, Appendix I, section 5.13, written-opinion-components DTD
Change:	<p><b>FROM:</b></p> <pre>&lt;!--non-establishment-of-opinion Non-establishment of opinion with regard to novelty, inventive step and industrial applicability.  entire-application No opinion could be established with respect to the entire application.  complex-application Indicates whether the objection results in the application to be treated as a complex application (Articles 17(2) (a) (ii) and 34(4) (a) (ii) PCT (Rule 63 EPC-2000).  Suggested value for id: wo-01-01-ne --&gt; &lt;!ELEMENT non-establishment-of-opinion (non-establishment- reason*,additional-info*) &gt;  &lt;!ATTLIST non-establishment-of-opinion %common_id_attribute_group;     complex-application (yes   no)    #IMPLIED     entire-application (yes   no)    #REQUIRED &gt;</pre> <p><b>TO:</b></p> <pre>&lt;!--non-establishment-of-opinion Non-establishment of opinion with regard to novelty, inventive step and industrial applicability.  entire-application No opinion could be established with respect to the entire application.  complex-application Indicates whether the objection results in the application to be treated as a complex application (Articles 17(2) (a) (ii) and 34(4) (a) (ii) PCT (Rule 63 EPC-2000).  Suggested value for id: wo-01-01-ne --&gt; &lt;!ELEMENT non-establishment-of-opinion (<b>non-establishment- claims?</b>,non-establishment-reason*,additional-info*) &gt;  &lt;!ATTLIST non-establishment-of-opinion %common_id_attribute_group;     complex-application (yes   no)    #IMPLIED     entire-application (yes   no)    #REQUIRED &gt;</pre>

	<pre>&lt;!ELEMENT non-establishment-claims (claim-num*, partially- for-claims?)&gt;  &lt;!ATTLIST non-establishment-claims %common_id_attribute_group;&gt;</pre>
Reason:	<p>This change is to allow the structured specification of the claims for which there is non-establishment of the written opinion.</p> <p>This proposal is to add a container element that reuses the <code>claim-num</code> and the <code>partially-for-claims</code> elements already used in the existing <code>non-establishment-reason</code> element.</p> <p>This change is needed to enable the provision of written opinions in XML.</p>

<b>Item 2</b>	
Location:	Annex F, Appendix I, section 5.13, written-opinion-components DTD
Change:	<p><b>FROM:</b></p> <pre>&lt;!--conflicting-document Any published application or any patent whose publication date is the same as, or later than, but whose filing date, or, where applicable, claimed priority date, is earlier than the international filing date of the international application searched, and which would constitute relevant prior art for the purposes of Article 15(2) had it been published prior to the international filing date, shall be specially mentioned in the international search report. Such published application or patent shall not be considered part of the prior art for the purposes of Article 33(2) and (3). Nevertheless, the international preliminary examination report shall call attention to such application or patent in the manner provided for in Rule 70.10.&lt;br/&gt; Rules 33.1(c) and 64(3) PCT  Recommended id='cit0001', 'cit0002', etc. For the SR: id='sr-cit0001', 'sr-cit0002' For the WO: id='wo-cit0001'  reference Identification given by the party to the document, e.g. A1.  exam-reference Identification given by the search or examining division to the document,</pre>

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e.g. D1.
-->
<!ELEMENT conflicting-document ((application-
reference,publication-reference,priority-date?) | text) >

<!ATTLIST conflicting-document
      id ID      #IMPLIED
      reference CDATA  #IMPLIED
      exam-reference CDATA  #IMPLIED >
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**TO:**

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<!--conflicting-document
Any published application or any patent whose publication
date is the
same as, or later than, but whose filing date, or, where
applicable,
claimed priority date, is earlier than the international
filing date of
the international application searched, and which would
constitute
relevant prior art for the purposes of Article 15(2) had it
been published
prior to the international filing date, shall be specially
mentioned in
the international search report.
Such published application or patent shall not be considered
part
of the prior art for the purposes of Article 33(2) and (3).
Nevertheless,
the international preliminary examination report shall call
attention to
such application or patent in the manner provided for in Rule
70.10.<br/>
Rules 33.1(c) and 64(3) PCT
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Recommended id='cit0001', 'cit0002', etc.
For the SR: id='sr-cit0001', 'sr-cit0002'
For the WO: id='wo-cit0001"
```

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reference
Identification given by the party to the document, e.g. A1.
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exam-reference
Identification given by the search or examining division to
the document,
e.g. D1.
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-->
<!ELEMENT conflicting-document ((category*,application-
reference,publication-reference,priority-date?,citation-
opinion?) | text) >
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<!ATTLIST conflicting-document
      id ID      #IMPLIED
      reference CDATA  #IMPLIED
      exam-reference CDATA  #IMPLIED >
```

	<pre>&lt;!ELEMENT citation-opinion(p+)&gt;  &lt;!ATTLIST citation-opinion   %common_id_attribute_group;&gt;</pre>
Reason:	<p>This change is to allow the inclusion of the category of the citation and the examiners opinion, reflecting current practice at ISA/KR, regarding the citation. This change is needed to enable the provision of written opinions in XML.</p> <p>This proposal is to add to the conflicting-document element the existing category element and a new container element, citation-opinion, that reuses the p element.</p>

Item 3	
Location:	Annex F, Appendix I, section 5.13, written-opinion-components DTD
Change:	<p><b>FROM:</b></p> <pre>&lt;!--non-written-disclosure In cases where the making available to the public occurred by means of an oral disclosure, use, exhibition or other non-written means ( non-written disclosure ) before the relevant date as defined in Rule 64.1(b) and the date of such non-written disclosure is indicated in a written disclosure which has been made available to the public on a date which is the same as, or later than, the relevant date, the non-written disclosure shall not be considered part of the prior art for the purposes of Article 33(2) and (3). Nevertheless, the international preliminary examination report shall call attention to such non-written disclosure in the manner provided for in Rule 70.9. See also Rules 33.1(b) and 64(2) PCT  Recommended id='cit0001', 'cit0002', etc. For the SR: id='sr-cit0001', 'sr-cit0002' For the WO: id='wo-cit0001"  reference Identification given by the party to the document, e.g. A1.  exam-reference Identification given by the search or examining division to the document, e.g. D1. --&gt;</pre>

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<!ELEMENT non-written-disclosure ((kind-of-disclosure,date,
    date-of-written-disclosure) | text) >

<!ATTLIST non-written-disclosure
    id ID #IMPLIED
    reference CDATA #IMPLIED
    exam-reference CDATA #IMPLIED >
TO:
<!--non-written-disclosure
In cases where the making available to the public occurred by
means of an
oral disclosure, use, exhibition or other non-written means (
non-written
disclosure ) before the relevant date as defined in Rule
64.1(b) and the
date of such non-written disclosure is indicated in a written
disclosure
which has been made available to the public on a date which
is the same
as, or later than, the relevant date, the non-written
disclosure shall
not be considered part of the prior art for the purposes of
Article 33(2)
and (3). Nevertheless, the international preliminary
examination report
shall call attention to such non-written disclosure in the
manner
provided for in Rule 70.9.
See also Rules 33.1(b) and 64(2) PCT

Recommended id='cit0001', 'cit0002', etc.
For the SR: id='sr-cit0001', 'sr-cit0002'
For the WO: id='wo-cit0001"

reference
Identification given by the party to the document, e.g. A1.

exam-reference
Identification given by the search or examining division to
the document,
e.g. D1.
-->
<!ELEMENT non-written-disclosure ((category*,kind-of-
disclosure,date,date-of-written-disclosure,citation-opinion?)
| text) >

<!ATTLIST non-written-disclosure
    id ID #IMPLIED
    reference CDATA #IMPLIED
    exam-reference CDATA #IMPLIED >

<!-- citation-opinion
For cases where the examiner provides an opinion related to a
cited document. This element, where present must contain a
paragraph contained in a p element.

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	<pre>--&gt;  &lt;!ELEMENT citation-opinion (p+) &gt;  &lt;!ATTLIST citation-opinion   %common_id_attribute_group;&gt;</pre>
Reason:	<p>This change is to allow the inclusion of the category of the citation and the examiners opinion regarding the citation, reflecting current practice at ISA/KR, and follows the same model as used in item 2 above. This change is needed to enable the provision of written opinions in XML.</p> <p>This proposal is to add to the <code>non-written-disclosure</code> element the existing <code>category</code> element and a new container element, <code>citation-opinion</code>, that reuses the <code>p</code> element.</p>

[Annex II follows/  
L'annexe II suit]

**Comments by the Portuguese Institute of Industrial Property**

In response to the Circular C. PCT 1600, I kindly inform WIPO that the Portuguese Institute of Industrial Property has no comments to the proposed changes to Annex F of the Administrative Instructions under the PCT and its appendices (modification of the DTD for the written opinion (ISA/237)).

[Annex III follows/  
L'annexe III suit]



**Comments by the Federal Service for Intellectual Property (ROSPATENT)**

I am contacting you in regards to the Circular C.PCT 1600 relating to the proposed modifications to Annex F of the PCT Administrative Instructions.

Having reviewed the Circular, my colleagues from the PCT Department have come to the conclusion that the Federal Service for Intellectual Property (Rospatent) has neither comments nor observations on the proposals of the Korean Intellectual Property Office (KIPO) to make.

[Annex IV follows/  
L'annexe IV suit]



**Comments by the Intellectual Property Agency of the Republic of Azerbaijan**

Thank you for your letter dated 25 May 2020 concerning proposed changes to Annex F for the Administrative Instructions under the PCT and its appendices (modification of the DTD for the written opinion (ISA/237)).

Please kindly be informed that the Intellectual Property Agency of the Republic of Azerbaijan does not have any comments in respect of the proposed modifications.

[Annex V follows/  
L'annexe V suit]



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

Referring to Circular C. PCT 1600 dated 05/22/2020 concerning the proposed changes to Annex F of the PCT Administrative Instructions and its appendices (modification of the DTD for the written opinion (ISA/237)) by KIPO concerning the modification of the specification of the written opinion so that this information can be transmitted.

INAPI's comments, in this regard, having reviewed the proposals made and given the nature of the proposals, we have no comments on them and agree with their content, as we believe that they are indeed aimed at facilitating the electronic filing and processing of international applications.

We hope that our comments will be of use to you, and we remain at your disposal for any further information you may require.

[Annex VI follows/  
L'annexe VI suit]



**Comments by the Japan Patent Office (JPO)**

The JPO has no strong objection to the adoption of the proposed addition of new Tag to the current DTD for the written opinion (ISA/237); provided, however, that the use of the new Tag is not mandatory.

The JPO is not faced with any troubles in establishing written opinions, and furthermore, the JPO does not have a plan to include a proposed optional category. The JPO therefore requests that the use of the new Tag added to the current DTD be not mandatory.

[Annex VII follows/  
L'annexe VII suit]



**Comments by the United States Patent and Trademark Office (USPTO)**

We invite clarifications per pfc document, pfc-20-001.pdf

- i. Do the proposals cover both written-opinion-components-v1-0.dtd and written-opinion-v1-0.dtd? Perhaps place the actual DTD name in the proposal for clarity.
- ii. It appears that USPTO is not producing the written opinions XML documents based the written opinion DTDs nor search-report-v2-0.dtd.
- iii. The proposed DTD changes do not have any deletions, only additions and reuse of existing components.

By way of information, our contractor does not yet provide XML data for search reports and/or written opinions. A decision to require XML data in the future is still under discussion. In a small number of applications, It is possible that the XML data is stored by internal USPTO software in order to generate the forms, but any such data is not readily available at this time.

[Annex VIII follows/  
L'annexe VIII suit]



**Comments by the European Patent Office (EPO)**

Please note that the EPO does not have objections to KIPO's PFC.

Only a remark is given regarding the subject title of the PFC submitted by KIPO "Changes to Annex F, Appendix I, section 3.6 (modification of the DTD for the written opinion (ISA/237))", as the impacted section seems to be 5.13 – Written opinion rather than 3.6 – Fee sheet.

[Annex IX follows/  
L'annexe IX suit]



### **Comments by 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:

- a. From the Japan Patent Office, the International Bureau confirms that the use of the new tag is not mandatory. Nonetheless, the International Bureau recommends that International Authorities, where possible, adopt similar practices in the production of reports in XML.
- b. From the United States Patent and Trademark Office, the International Bureau, in respect of the clarification requested, confirms that:
  - (i) the proposals essentially cover both DTDs as the improvement relates to the representation of the written opinion in XML which requires the use of both DTDs. In the proposal the written-opinion-components DTD is updated and the written-opinion DTD remains unchanged;
  - (ii) this is also the understanding of the International Bureau that the USPTO is not producing written opinions XML documents based the written opinion DTDs nor search-report-v2-0.dtd ; and,
  - (iii) the International Bureau agrees with the observation, that “*the proposed DTD changes do not have any deletions, only additions and reuse of existing components*”, and would add that the additions are all optional enabling instances created with the current DTD to validate using the proposed DTD.

With no controversial comments outstanding the International Bureau will adopt the proposal for entry into force on January 1, 2021.

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