

**PCT/EF/PFC 20/006**  
**ORIGINAL: FRANÇAIS / ENGLISH**  
**SITUATION AT: APRIL 9, 2021**  
**SITUATION AU : 9 AVRIL 2021**

**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, sections 3 and 5 (modification of the international search report and data and IB publication DTDs)</b>                        |   | PROPOSED BY: KR  |            |
|--|---|--|------------|
| <b>SUJET : Modifications des sections 3.1 et 5.7 de l'appendice I de l'annexe F (modification de les DTDs du rapport de recherche internationale et du IB publication)</b> |   | PROPOSÉES PAR : KR   |            |
| HANDLING: Expedited cycle<br>TRAITEMENT : Cycle accéléré   |   | PROPOSED DATE OF ENTRY INTO FORCE: 01.07.2021<br>DATE PROPOSÉE D'ENTRÉE EN VIGUEUR : |            |
| Annex/<br>Annexe   | Content/Contenu   | Origin/<br>Origine   | Date       |
| 1  | Modification of rel-passage element to allow the inclusion of additional information regarding the citation and passage<br><br>Modification de l'élément 'rel-passage' pour permettre l'inclusion d'informations complémentaires concernant la citation et le passage | KR   | 15.12.2020 |
| 2  | Comments  | CR   | 07.01.2021 |
| 3  | Comments  | SG   | 02.02.2021 |
| 4  | Comments  | JPO  | 04.02.2021 |
| 5  | Comments  | WIPO   | 04.02.2021 |

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|----|----------|----|------------|
| 6  | Comments | RU | 08.02.2021 |
| 7  | Comments | KR | 16.02.2021 |
| 8  | Comments | US | 17.02.2021 |
| 9  | Comments | CN | 19.02.2021 |
| 10 | Comments | EP | 23.02.2021 |
| 11 | Comments | IB | 09.04.2021 |

|                    |                   |           |            |
|--------------------|-------------------|-----------|------------|
| Next action:       | Entry into force  | By:       | 01.07.2021 |
| Prochaine action : | Entrée en vigueur | Pour le : |            |

[Annex I follows/  
L'annexe I suit]

|           |  |
|-----------|--|
| Item 1    |  |
| Location: | Annex F, Appendix I, section 3.3 application-body, 3.9 table , 5.6 IB bibliographic data, 5.7 IB publication, 5.8 amendment-request, 5.9 search-report, 5.10 iprp and 5.14 written-opinion-components DTDs   |
| Change:   | <p><b>FROM:</b></p> <pre>&lt;!--   Relevant passage group within patent; most used in search   reports   - use text in abstract, description and claims  --&gt; &lt;!ELEMENT rel-passage (text   (passage+ , (category , rel- claims?)*))&gt;</pre> <p><b>TO:</b></p> <pre>&lt;!--   Relevant passage group within patent; most used in search   reports   - use text in abstract, description and claims  --&gt; &lt;!ELEMENT rel-passage (text   (passage+ , (category , rel- claims?)*, <b>additional-info?</b>))&gt;</pre> <p><b>&lt;!--</b><br/> <b>Additional information.</b><br/> <b>(ST.32:B513)</b><br/> <b>--&gt;</b><br/> <b>&lt;!ELEMENT additional-info (p+)&gt;</b></p> |
| Reason:   | <p>This change adds the possibility of inserting in the citation structure, relating to a cited document or passage, examiner comments improving the readability of the citation. This additional information will be provided in International Search Reports and IB publication.</p> <p>Note: the additional-info element is already present in the search-report, iprp, wo-bibliographic-data, written-opinion-components and IB publication DTDs. While the intended usage is only within search report, other DTDs also use the same citation structure and are thus changed.</p> <p>The proposed changes are backwardly compatible.</p>  |

**Comments from the Permanent Mission of Cost Rica to the United Nations**

Costa Rica has no particular comments on this matter.

[Annex III follows /  
L'annexe III suit]

**Comments from the Intellectual Property Office of Singapore**

The team at the Intellectual Property Office of Singapore thanks WIPO for your continued efforts to enhance the PCT regime. In response to Circular C. PCT 1615, we have the following query regarding the proposal for PCT/EF/PFC 20/006. It is uncertain what additional information are intended and how it will be displayed. Therefore, it would be useful to provide guidance or examples for reference.

[Annex IV follows /  
L'annexe IV suit]

**Comments from the Japan Patent Office**

This is the reply from the Japan Patent Office (JPO) to the C.PCT 1615. The JPO would appreciate your giving consideration to the following comments.

Regarding the proposed change of PCT/EF/PFC 20/005, the JPO is aware of the necessity of the proposed change in line with the implementation of WIPO Standard ST.26 from January 1, 2022. The JPO has no objection with the proposed change of PCT/EF/PFC 20/005.

Regarding the proposed changes of PCT/EF/PFC 20/002, 003, 004 and 006, the JPO has not recognized any troubles of the current DTDs and any needs to change from PCT users or JPO examiners. Thus the JPO is not aware of the necessity of the proposed changes. If a majority of contracting parties is aware of the necessity of the proposed changes with any reason, the JPO requests that the use of the proposed DTDs be not mandatory since it would take a large amount of cost and time for the JPO to adopt the proposed DTDs for system conversion.

[Annex V follows /  
L'annexe V suit]

## Comments from the WIPO Standards Section

PFC-20-006

- Relevant DTD: application-body, written-opinion, search-report, bib-data
- Change proposed: Extension of rel-passage to include new additional-info

Relevant ST.96 component: pat: ReferenceCitation

```
<xsd:complexType name="ReferenceCitationType">
  <xsd:sequence>
    <xsd:choice>
      <xsd:element ref="com:PatentCitation"/>
      <xsd:element ref="com:NPLCitation"/>
    </xsd:choice>
    <xsd:choice minOccurs="0">
      <xsd:element ref="pat:CitedPassageBag"/>
    </xsd:choice>
    <xsd:sequence>
      <xsd:element ref="pat:DocumentRelevanceBag"/>
      <xsd:element ref="pat:CitedPassageBag" minOccurs="0"/>
      <xsd:element ref="pat:PatentClassificationBag"
minOccurs="0"/>
    </xsd:sequence>
  </xsd:sequence>
  <xsd:element ref="com:CommentText" minOccurs="0"/>
</xsd:sequence>
<xsd:attribute ref="com:id"/>
<xsd:attribute ref="com:sequenceNumber"/>
<xsd:attribute ref="pat:citedPhaseCategory"/>
<xsd:attribute ref="pat:citingPartyCategory"/>
</xsd:complexType>
```

- Potential impact: In terms of ST.96, pat:ReferenceCitationType already has com:CommentText as an optional element to allow insertion of additional information. As such, there is not impact to ST.96 in this regard.
- However, the example KIPO instance below addresses a further problem where PatentClaimRange cannot include within the claim number range any non-numeric characters:
- The proposal here is to allow PatentClaimStartNumber and PatentClaimEndNumber to be of type 'string' in ST.96 to resolve this problem.

[Annex VI follows /  
L'annexe VI suit]

**Comments from the Federal Service for Intellectual Property (Rospatent)**

I am writing with regards to Circular C. PCT 1615 concerning Proposed changes to Annex F of the Administrative Instructions under the PCT and its appendices.

Rospatent is not currently using XML to deliver written opinions. At the moment the documents are sent in PDF. At the same time, our Office is planning to start delivering written opinions in XML in near future. Therefore, we do not have any comments regarding the Circular PCT 1615.

[Annex VII follows /  
L'annexe VII suit]



**Comments by the Korean Intellectual Property Office (KIPO)**

Comment from STS (follow up with KIPO): "Potential impact: The proposed change will require a revision to ST.96 version 4.0 component TopUpSearchBasis. However, it is not clear which components should be provided as 1..n: the TopUpSearchAdditionalInformation component or just the TopUpSearchDate. According to the proposed changes to DTD, TopUpSearchAdditionalInformation should be updated, but it may need to change only the date component for business point of view. So it is suggested to discuss with KIPO, proponent of the PFC, what changes they proposed in PCT DTD."

# KIPO's feedback

KIPO wants to have multiple dates in top-up-search-carried-out. Under the current written-opinion-components-v1-1.dtd, date is a CDATA attribute of top-up-search-carried-out and it is not so easy to expand multiple dates.

In order to clearly describe multiple dates, KIPO propose to repeat its parent element - top-up-search-carried-out. KIPO welcomes any possible solutions and further discussion on this issue.

```
# written-opinion-components-v1-1.dtd <!ELEMENT top-up-search-carried-out EMPTY>
<!ATTLIST top-up-search-carried-out
  date CDATA #REQUIRED
  document-found (yes | no) #REQUIRED>
```

For your information, ST.96 amendment works along with PFC 20/002, 004, 006 revision under issue-id 676, 677, 678 as attached.

[Annex VIII follows /  
L'annexe VIII suit]

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

After consideration, please be informed that USPTO has no comments on this Circular at this time.

[Annex IX follows /  
L'annexe IX suit]

**Comments from the State Intellectual Property Office of the P.R.C (SIPO)**

CNIPA has not different opinions about the proposed changes to Annex F of the Administrative Instructions under the PCT and its appendices.

[Annex X follows /  
L'annexe X suit]

## **Comments from the European Patent Office**

Following the Circular C.PCT 1615 you may find below EPO's feedback to each of the PFCs.

### **PFC-20-002**

The EPO informs that, in Chapter 2 proceedings, its examiners perform one mandatory top-up search. Since the proposed change to the dtd is backwardly compatible, i.e. no IT changes required on IPEA/EP's side, the EPO does not object to this proposal.

### **PFC-20-003**

The EPO supports a flawless processing of PCT Direct letters. It is crucial that, at the time of filing the application, the user be in a position to select the correct document type when uploading the PCT Direct letter. In that respect, the present PFC seems to fall short of any benefits for users. At present, the EPO has an automation in place for PCT Direct letters, under other-doc in other-documents. Therefore, should this PFC be eventually implemented, it is important for the EPO to ensure backward compatibility, i.e. the information that is already in the package data should be kept as is. Further, it must be kept in mind that all Offices will have to update the eOLF servers with the new DTD.

### **PFC-20-004**

There is no comment from the EPO on this PFC.

### **PFC-20-005**

There is no comment from the EPO on this PFC.

### **PFC-20-006**

The EPO informs that its examiners are not following the practice suggested in the PFC. However, since this change is backwardly compatible there is no objection from the EPO. Further, the EPO suggest not encouraging a systematic use of color in filings but clearly indicating that those filings shall be made in color where necessary for a better understanding of the application.

[Annex XI follows /  
L'annexe XI 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 taken into consideration the points raised:

- i. by the Japan Patent office in respect of the necessity of implementation for this PFC, noting that this PFC is necessary to support the migration of reports to XML authoring at KIPO and that with the DTD being backwardly compatible any current usage of the DTD by JPO will remain compatible;
- ii. by the WIPO Standards Section in respect of the compatibility of WIPO Standard ST.96; and,
- iii. by the European Patent Office in respect of the need to retain the 'other-doc' entry in the package data, noting that the proposal is backwardly compatible.

Additionally, the IB has noted that the following DTDs, that are used by the IB, also contain elements updated by this backwardly compatible PFC:

- wo-form-ipea-v1-0n.dtd
- wo-form-isa-v1-0p.dtd
- wo-form-ro-v1-0r.dtd
- wo-application-body-v1-9.dtd
- wo-international-application-status-v0.3.dtd.

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 July 1, 2021.

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