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ASSEMBLY

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MATTERS CONCERNING THE PCT UNION

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1. PCT Rule 93 is entitled “Keeping of Records and Files.” It provides how long (10 years) the receiving Office has to keep the records relating to each international application or purported international application, including the home copy (Rule 93.1); how long (30 years) the International Bureau has to keep the file, including the record copy, of any international application (Rule 93.2(a)); and how long (10 years) the International Searching Authority (“ISA”) and the International Preliminary Examining Authority (“IPEA”) have to keep the file of each international application they receive (Rule 93.3). In respect of the International Bureau, it also provides that its “basic records” have to be kept indefinitely (Rule 93.2(b)).
2. In respect of all four of these entities--that is, the receiving Office, the International Bureau, the ISA and the IPEA--the same Rule provides, in Rule 93.4, entitled “Reproductions,” the following:

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“For the purposes of this Rule, records, copies and files shall also mean *photographic reproductions of records*, copies and files, whatever may be the form of such reproductions (microfilms or other).” [Emphasis added.]

3. This Rule was written 25 years ago, that is, at a time when practically the only widely used way of keeping great quantities of texts and drawings, particularly by patent offices, was to make microfilms of the paper copies of their records and the patent applications, patents and other papers kept in their files.

4. Today, although microfilming is still used, other ways of reproduction are used. Among them are the storage of documents on and the preparation of reproductions from optical disks and magnetic tapes. Still other, particularly other electronic, ways may in the future become possible and particularly useful for patent offices.

5. In order to clearly cover these new ways of reproducing, and in order to clearly permit the keeping of what has to be kept by the receiving Offices, the International Bureau and the ISAs and IPEAs, in the form not only of paper, microfilm or other photographic reproductions but also, and instead of paper or photographic reproductions, in the said more modern ways and forms, it is proposed that Rule 93.4 be amended to read as follows:

“For the purposes of this Rule, records, copies and files shall also mean photographic reproductions, as well as reproductions on magnetic tapes, optical disks and any other electronic data carrier.” [The newly added words are underlined.]

In addition, it is proposed that the title of Rule 93 be amended, in French, in order to align it more closely to the title in English; the proposed title can be found in the French version of this document.

6. The amendment of Rule 93.4 would have the consequence that any copies to be furnished by the receiving Office, by the International Bureau or by any ISA or IPEA *could be prepared from* a magnetic tape, an optical disk or any other electronic data carrier (rather than from a paper or microfilm). It should be noted that the proposed amendment does not regulate the question of in what form (paper or other) *the copy furnished* must be. The answer to this question would, even after the amendment, depend on the wish of the party (“the receiving party”) to which the copy has to be furnished, be that party the receiving Office, the International Bureau, the ISA or the IPEA. For example, if any receiving party wishes to receive the copies which have to be furnished to it in paper form, the copies will have to be furnished in paper form. Naturally, if the receiving party and the furnishing party agree on furnishing in a certain form (other than paper), then that form will have to be used. What the amendment means is merely that the copy--for example, the paper copy--to be furnished may be *derived from* magnetic tape, optical disk or other electronic data carrier rather than from paper or microfilm.

7. This would apply, for example,

(i) as far as the receiving Office is concerned, to its preparing (where necessary) the home copy (which it keeps) as well as the record copy and the search copy which it has to furnish to the International Bureau and the competent ISA, respectively (Article 12 and Rules 21, 22 and 23);

(ii) as far as the International Bureau is concerned, to its preparing the copies of the international application and the international search report it has to furnish to the designated Offices (Articles 13 and 20 and Rules 31 and 47), to its preparing the copies of the international preliminary examination report it has to furnish to the elected Offices (Article 36 and Rule 73) and to its preparing copies of any priority document it may have to furnish to designated Offices or, in certain circumstances, to members of the public (Rule 17.2);

(iii) as far as the ISA is concerned, to its preparing the copies of its report it has to furnish to the International Bureau and the applicant (Article 18(2) and Rule 44);

(iv) as far as the IPEA is concerned, to its preparing the copies of its report (and any annexes to that report) it has to furnish to the International Bureau and the applicant (Article 36(1) and Rule 71.1).

8. The national and regional Offices which act as receiving Offices or which act as ISAs and/or IPEAs will, each, weigh the advantages that the possibility offered by the amended Rule gives them and will, if they are equipped for it and so desire, keep, entirely or in part, their records and files on magnetic tapes, optical disks or other electronic data carriers and will, if they are equipped for it and so desire, prepare the copies they have to furnish to third parties by deriving such copies from such data carriers.

9. As far as the International Bureau is concerned, the files of international applications are presently kept by the International Bureau in paper form. However, a system is going to be introduced before the end of 1995 whereby the files of international applications filed in the future will, under the "Document Imaging and Computer-Assisted Publishing System (DICAPS)," be stored in facsimile form on optical disks. In the rest of this document, the international applications which will be so stored are called "DICAPS-stored applications," and the others "pre-DICAPS applications."

10. The International Bureau plans to store the some 200,000 pre-DICAPS applications on magnetic tape, optical disk or microfilm and then to eliminate the paper files. The cost of this operation is under investigation but it would certainly be more than compensated by the savings resulting from the fact that the required storage space will diminish one hundred-fold, the integrity of the files will be better assured, and access to them will be faster and simpler.

11. The number of the DICAPS-stored applications is expected to total in the last four years of this century over 150,000. As said in paragraph 9, above, these applications will be electronically stored in the DICAPS system. The same is true in respect of other documents such as international search reports, international preliminary examination reports and priority documents. If an application or other document is received in paper form, the paper form will be eliminated shortly after storing its contents in the DICAPS system. This way of proceeding is regarded as already implicitly authorized under Rule 93 as it is, but it will be expressly authorized under the proposed amendment of that Rule.

12. The Assembly is invited to adopt, with the effective date of October 1, 1995, the amendment of PCT Rule 93.4 as proposed in paragraph 5, above.

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