

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

Twenty-Eighth Session
Geneva, March 24 to 26, 2021

CERTIFIED COPIES OF EARLIER INTERNATIONAL APPLICATIONS

Document prepared by the International Bureau

SUMMARY

1. The Meeting is invited to comment on options for facilitating the use of earlier international applications as priority documents, with a view to a possible proposal to the PCT Working Group by the Japan Patent Office.

BACKGROUND

2. While most international applications claim priority from earlier national applications, around 4,000 international applications per year are used as the basis of a priority claim in a later international application and a few are also used as the basis of a priority claim in a later national application. Around 80 per cent of these priority claims in international applications relate to earlier international applications filed at the same receiving Office, where the priority documents would be eligible for transmission under Rule 17.1(b). However, at a few receiving Offices, priority claims based on earlier international applications filed at other Offices are common.

3. At most national Offices, national and international applications are treated differently from one another. The process for obtaining certified copies of an international application may be different from that for national applications and, in some cases, less efficient for both the applicant and the Office. Around a quarter of the Offices acting as a depositing Office for national patent applications in the WIPO Digital Access Service for Priority Documents (DAS) do not also allow the deposit of international applications filed with that Office as receiving Office¹.

¹ A searchable index showing the types of applications for which an individual Office acts as a depositing Office or accepts as a priority document as an accessing Office in WIPO DAS is available on the [WIPO website](#).

4. The Japan Patent Office is considering making proposals to the PCT Working Group for more efficient arrangements for priority documents in the case where an international application claims priority from an earlier international application. The principle would be that the International Bureau use a record copy already in its possession instead of a receiving Office needing to prepare and transmit a further copy. The Japan Patent Office has invited the International Bureau to assess possible options to inform its work.

CONSIDERATIONS

5. Any arrangements put in place would need to meet the requirements of Article 4D(3) of the Paris Convention that:

“The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.”

6. In addition, noting that the numbers of applications involved are relatively small, it is desirable that a single approach should address all of the relevant cases, rather than trying to develop multiple systems for each separate set of applications, depending on the Offices concerned, whether the later application is an international application or a direct national application and whether the Offices where the earlier and later applications are filed are the same or different.

7. At present, the International Bureau is only authorized to prepare certified copies under Rule 21.2 of international applications for which it acted as receiving Office.

OPTIONS

8. The International Bureau does not recommend extending the power under Rule 21.2 to allow the International Bureau to prepare for the applicant certified copies of applications for which it did not act as receiving Office. However, objectively, the transmission of a record copy by the receiving Office to the International Bureau is a certification by the receiving Office that the record copy is a true copy of the international application as filed there. This opens at least three possibilities for consideration:

(i) When a later international application is filed at the same receiving Office as the earlier international application, that Office could request the International Bureau to use the record copy of the earlier application as a priority document, certifying on an individual basis that the earlier record copy was a true copy. The International Bureau would then copy the relevant record copy directly from the other earlier application file and add a conventional cover page to make the nature of the document clear for designated Offices.

(ii) Add new provisions into the PCT Regulations (likely in Rules 17 and 22) to state explicitly that transmission of a record copy constituted a certification by the receiving Office that it was a true copy of that international application. Any applicant could then choose to use the earlier record copy as a priority document by selecting the appropriate option on the request form, irrespective of whether the two receiving Offices were the same and without any case-by-case action by the receiving Office.

(iii) Add new provisions into the PCT Regulations (likely in Rules 21 and 22) to state explicitly that transmission of a record copy constituted a certification by the receiving Office that it was a true copy of that international application and allowing the International Bureau to place that copy into a digital library on behalf of the receiving Office if so required by the applicant. The applicant would then request the use of the earlier record

copy by placing an access code from the earlier application into the request (or a subsequent online action) in relation to the later international application in order to retrieve the application from DAS. Receipt of a valid code would result in the record copy being given a suitable front page and made available on the file of the later application in exactly the same manner as would happen at present if the earlier application has already been made available to DAS directly by the receiving Office.

9. All three would require similar amounts of IT development work at the International Bureau to extract a record copy and present it as a certified copy. The exact details of the work involved would depend on further studies of the required presentation of the contents. However, many aspects of this could be closely based on the preparation of certified copies done under Rule 21.2 by the receiving Office of the International Bureau and the front pages already attached to certified copies received under Rule 17 from other Offices or via DAS.

10. The main advantages and disadvantages of the options are as follows:

(i) From a legal point of view, Option (i) could probably be implemented merely by modifications of the Administrative Instructions (including notably the request form). However, it would only work for the case where the receiving Office was the same for both applications (excluding around one fifth of the potential cases) and would require both IT development by receiving Offices and an additional step for the receiving Office to make the appropriate individual certification of the earlier international application and request for a copy to be transferred to the later international application. As the possibility of the receiving Office transmitting the priority document to the International Bureau under Rule 17.1(b) would still be available, applicants may continue to request the transmission of the priority document for an earlier international application under this Rule (as they would continue to do where priority is claimed from a national application filed at the same receiving Office) instead of choosing Option (i) of requesting the receiving Office to request the International Bureau to use the record copy as the priority document.

(ii) Option (ii) would work irrespective of the receiving Offices involved and would not require any additional action by the receiving Office. However, it would not address the additional cases where the later application was not an international application and it would introduce a new burden for the International Bureau to ensure that the applicants for the earlier and later applications either matched, or else differences were properly explained by a suitable declaration, in order to avoid the risk of transferring an incorrect priority document as a result of any errors in the priority claim details.

(iii) Option (iii) has the benefit that it would work for any later application, either national or international, since the process of adding the earlier application into DAS would be triggered by a valid DAS request, which would be independent of the nature of the later application. There would be no changes required either to the request form or to the International Bureau's systems for import of the priority document because this would appear to the process exactly like any other DAS request. Furthermore, there would be no need for manual checks to ensure that the applicant had the right to request the document to be transferred in this way, since the DAS access code was designed as an effective "check digit" precisely to avoid the possibility of inappropriate transfers due to errors in the entry of priority claims.

11. If Contracting States consider action to be appropriate, the International Bureau would recommend the third option as the most promising for further consideration and development of legal and technical detail.

12. The Meeting is invited to comment on the options for using a record copy as an earlier international application as the certified copy of the priority document discussed in this document.

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