

WIPO



PCT/R/1/23
ORIGINAL: English
DATE: May 18, 2001

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

COMMITTEE ON REFORM
OF THE PATENT COOPERATION TREATY (PCT)

First Session
Geneva, May 21 to 25, 2001

REFORM OF THE PCT:
SUBMISSIONS AND RESOLUTIONS BY CERTAIN
NON-GOVERNMENTAL ORGANIZATIONS CONCERNING
ELECTRONIC FILING OF PATENT APPLICATIONS

Document prepared by the International Bureau

1. The Annexes to this document reproduce submissions and resolutions by the following non-governmental organizations concerning the electronic filing of patent applications:

Annex I: American Intellectual Property Law Association (AIPLA);

Annex II: International Association for the Protection of Intellectual Property (AIPPI);

Annex III: International Federation of Industrial Property Attorneys (FICPI);

Annex IV: Intellectual Property Owners Association (IPO).

2. Background information concerning the Committee's session appears in document PCT/R/1/2.¹

3. *The Committee is invited to consider the proposals contained in this document.*

¹ The working documents for the Committee's session are available on WIPO's web site at the following address: http://www.wipo.int/pct/en/reform/index_1.htm

ANNEX I

AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION (AIPLA)
ELECTRONIC PATENT APPLICATION FILING STANDARD

The American Intellectual Property Law Association (AIPLA) continues to seek the harmonization of practices for obtaining patents from the various patent offices of the world. Harmonization benefits the users of the patent systems and the patent offices. An important attribute of the Patent Cooperation Treaty is the setting of a standard for patent applications that may be used in a multiplicity of countries. This is particularly important in the preparation of patent applications in paper and equally important when attempting to electronically file patent applications on-line. The effort of WIPO to address standards for filing PCT applications electronically is truly welcomed by the users of the patent systems of the world.

Once standards are established for PCT international applications to be filed on-line, the expectation is that the on-line standards for filing national patent applications would track the PCT international application standard. While such a tendency was experienced in regard to paper applications, there have been some reports that the same may not be true in regard to electronic filings. It has been reported, or at least alleged, that some patent offices are looking at electronic filing standards which do not adhere to any evolving single standard.

In 1998 the American Intellectual Property Law Association Board of Directors adopted a number of Resolutions advocating the establishment of an electronic patent application filing standard. These Resolutions were reaffirmed on February 3, 2001 and are even more critical at this time. The Resolutions read as follows:

RESOLVED, AIPLA favors, in principle, the accommodation of electronic filing of international applications for patent, and specifically favors an electronic filing regime that embraces at least the following Guiding Principles:

- a) Promotes uniformity between the international filing system and national filing systems;
- b) Considers existing regimes of non-patent electronic commerce;
- c) Utilizes commercially available technology where feasible;
- d) Accommodates varying member state laws;
- e) Minimizes complexity consistent with security requirements;
- f) Establishes appropriate legal presumptions and burdens of proof consistent with those presently extant in the paper filing regime;
- g) Facilitates the acquisition and confirmation of a valid filing date; and
- h) Reduces the cost to users of filing an international application.

RESOLVED, AIPLA favors, in principle, the accommodation of electronic filing of international applications for patent, and specifically favors a system that insures maintenance of and accessibility to electronic file histories sufficient to support future requirements of users for a period not less than the 30 years required by the present rules for paper file histories.

(Adopted by the AIPLA Board of Directors April 24, 1998 and February 3, 2001)

With one standard, both the users and the patent offices of the world benefit. The establishment of an electronic filing standard for use in the filing of PCT international applications will greatly advance the prospects of the various patent offices of the world to adhere to that standard, not only for PCT international applications, but also for national applications. For that reason, this Association supports WIPO's effort to establish such a standard.

[Annex II follows]

ANNEX II

INTERNATIONAL ASSOCIATION FOR THE
PROTECTION OF INTELLECTUAL PROPERTY (AIPPI)

ONLINE (ELECTRONIC) FILING OF PATENT APPLICATIONS

Quite a number of states being member of the PCT have amended their patent law in order to be prepared for online filing. The PCT is in the same process of preparation. The change from paper filing to online filing will be a significant change in the filing procedure of patent applications with deep consequences on the side of the applicants being the clients of the Patent Offices.

AIPPI is aware of the fact that despite of efforts from the side of WIPO there is not yet any realistic planning of a system for online filing, which is compatible with the corresponding systems as prepared by the mentioned offices. A diversity of systems of online filing would be a step to disharmony in contrast to the efforts of the WIPO to harmonize the patent system worldwide. A diversity of systems would be for the applicants as well as for the Patent Offices a disaster because it would make the direct contact of applicants with the Patent Offices different from office to office and dangerous because of possible mistakes, it would also impede the correspondence between Patent Offices. It is therefore the view of AIPPI that any possible efforts should be undertaken in order to harmonize the various systems so that at least they are compatible with each other.

AIPPI strongly hopes that this matter, in view of its urgency, will be taken up by the Committee on Reform of the Patent Cooperation Treaty (PCT) on May 21 to 25, 2001 for consideration of an initiative for the development of a harmonized Online-filing system.

AIPPI has adopted on its last Congress in Melbourne, Australia, on March 30, 2001 the following resolution Question 109, Patent Cooperation Treaty, online (electronic) filing of patent applications:

AIPPI CONSIDERS

that online filing of patent applications comes nearer and nearer. Countries with the larger Patent Offices and the PCT are prepared for the introduction of online filing. The necessary software is in preparation. The EPO has developed EASY, which is now in a testphase. It is not clear whether this software is compatible with software for PCT applications of WIPO. The US-PTO has developed its own software. Additionally some European national Patent Offices cooperate for development of their own software (Patent Offices of UK, Denmark, Finland, Germany, The Netherlands, Sweden, Switzerland) under the MIPEX project. The consequence of all these efforts is, the applicants and their representatives will have to face a situation in which their offices have to manage quite a number of different software packages each of which requires a corresponding investment. A further problem of this diversity will be the possibility of mistakes with fatal consequences because of a choice of wrong software in a particular case.

AIPPI takes the view that this technical new development, which essentially takes into consideration the wishes and needs of the various Patent Offices and of course legal certainty should be guided also by the needs of the applicants who are really the clients of the Patent Offices. As long as the online filing systems are still under development it should be possible to harmonize the various systems so that at least they are compatible with each other.

RESOLVES THAT

all authorities dealing with systems for online filing of patent applications should consult applicants and their representatives in order to harmonize those different systems with the goal to have one common standard, which is acceptable in all major Patent Offices and WIPO.

[Annex III follows]

ANNEX III

INTERNATIONAL FEDERATION OF
INDUSTRIAL PROPERTY ATTORNEYS (FICPI)

HARMONISATION IN ELECTRONIC FILING
(Resolution B)

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession of more than 70 countries, assembled at its Executive Committee meeting held in Seville from February 4 to 9, 2001, passed the following Resolution:

OBSERVING a huge diversity of efforts made by IP Offices around the world, notably the EPO, the JPO, the USPTO, the German Patent Office and WIPO, each on its own, to take profit of the fast development in e-commerce, and bearing in mind the interests of our mutual clients and of our profession of a simplified effective electronic access to the offices,

RESOLVES to urge all intellectual property offices and WIPO to harmonise these electronic access and filing modalities and to search for *one common standard* in this regard.

[Annex IV follows]

ANNEX IV

INTELLECTUAL PROPERTY OWNERS ASSOCIATION (IPO)

RESOLUTION ADOPTED UNANIMOUSLY BY BOARD OF DIRECTORS
(April 18, 2001)

RESOLVED: Intellectual Property Owners Association (IPO)

(1) encourages electronic systems for filing and administration of patent applications in national and regional patent offices, and

(2) discourages national or regional patent offices from developing electronic systems for filing or administration of patent applications that are not compatible with similar systems developed by other national or regional patent offices.

[End of Annex IV and of document]