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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

PATENT COOPERATION TREATY (PCT)

ADMINISTRATIVE INSTRUCTIONS
UNDER THE PATENT COOPERATION TREATY:

PROPOSED MODIFICATIONS RELATING TO THE
ELECTRONIC FILING, PROCESSING, STORAGE AND
RECORDS MANAGEMENT OF INTERNATIONAL APPLICATIONS

COMMENTS BY
IP AUSTRALIA

for consideration at a
PCT informal consultation meeting on electronic filing,
Geneva, July 11 to 14, 2000

ELECTRONIC FILING UNDER THE PCT

Australia remains concerned that certain aspects of the scheme for electronic filing as set out in Part 7 and Annex F of the Administrative Instructions, is inappropriate – indeed may be detrimental to the effective uptake of electronic filing by users.

Australia notes, with particular reference to the PKI environment, that despite the UNCITRAL model laws the legalities associated with e-commerce are not harmonized at a national level. Further, Australia perceives the current proposals as attempting to achieve a degree of certainty in the e-filing environment that does not actually exist in the paper world. If the requirements of e filing are over-engineered in the name of apparent certainty, Australia fears that the resultant system will be difficult to use and user-unfriendly – with the result that users will not use it. Further, to the extent that national laws are not harmonized, absolute certainty (if achievable at all) will require incorporation of the most rigorous elements across national laws.

When considering the requirements of an e-filing system, it is appropriate to have a clear understanding of how the current paper system functions. The paper system does not rely on standards of absolute certainty – but operates at various levels of trust and understanding. By way of example, any person that entrusts a courier or agent with the filing of documents makes certain presumptions about the security of that transmission. Most of the time that trust is well founded, and built on experience. Sometimes (not often) that trust turns out to be misplaced. Nevertheless, the real possibility of a loss of security does not result in offices insisting on high levels of security (such as requiring applications be filed only under an armed security escort.) Australia is most concerned that much of the debate about electronic filing seems to have, as a paramount issue, the provision of a level of certainty far greater than that currently existing in the paper world – with concomitant technical issues that may lead to a system that is difficult to use.

Many of the issues about e filing relate to the manner of communication between the applicant and an office, and an attempt to reach an agreed global standard for that communication. In the paper world, this would be equivalent to, for example, specifying that applicants must use Registered Mail rather than ordinary mail; that the envelope must be of a particular size, strength, durability; that the envelope must have means to indicate tampering, etc. However the PCT (and the PLT) do not attempt to set standards in this area. Rather, national law sets the acceptable ways of delivery to an office. Australia queries why this division of responsibility should not apply to electronic filing.

It has been suggested that part of the reason for the difference between paper and e-commerce is that the paper environment relies on signatures to establish authenticity, and PKI is the best way to replicate this function in the electronic environment. However, inn the paper environment there usually is no formal chain of connection by way of signatures from the filing of the priority document, to PCT application, to national phase entry. By way of illustration:

- The certified copies of priority documents from most countries do not include any signatures of the applicants or inventors; such names are presented (if at all) merely in typescript.

- The PCT pamphlet published by WIPO does not include any signatures of the applicant. A PCT applicant is required to sign the request form and/or a power of attorney. However Australia understands that the IB does not routinely send copies of the request form or power of attorney to *any* member state. That is, no PCT member state routinely has the signature of the PCT applicant on file.

Despite the absence of copies of the signature of the original applicant, applications proceed in the national phase. Clearly offices accept the identity of a person entering the national phase on some more general basis than a rigorous check of identity by way of signature comparisons. Australia queries why the situation should be different in the electronic filing environment – particularly if the difference gives rise to problems with the technical solution that otherwise would not exist.

With regard to the issues of records management, no one presently questions how an office (even those that are currently electronic) stores its applications, or makes applications available to the public. No one suggests that offices should be audited for compliance with Art 30 or 38, or Rule 93 of the PCT. This is not to say that offices are presently in *absolute* compliance with such provisions – most offices will have had some inadvertent lack of compliance with these provisions at some time or another. Again, why should the electronic environment require a different standard of records management?

At the PCT Assembly meeting, a basic set of principles for electronic filing evolved. Australia would like to suggest some further principles:

- The principles for electronic filing should not depart from the principles that currently exist with paper filings, without good reason;

- Dealings between the applicant and their national office/Receiving Office is essentially a matter of the national law of that country – whether the dealings be on paper or by e-commerce technology;

- The manner of electronic filing (including issues of establishing the identity of the applicant) in each country/RO is essentially a matter of national law of that country. The PCT regulations and administrative instructions should facilitate electronic transactions within the national legal and operational frameworks already in place;

- For effective communication of documents between offices, documents need to be in agreed standard formats. (Functionally, this is probably the most important standards requirement for electronic filing under the PCT.);

- There must be an effective and secure means for transmitting documents between Offices (eg $WIPO_{NET}$);

- The mode of accepting that the person entering the national phase is the applicant under the PCT, and was the applicant for the priority application, should not be more onerous than in the paper environment;

- The manner in which an office holds documents and runs its business is essentially a matter for that office - consistent with the usual obligation offices have to their country.

Following these principles, Australia makes the following suggestions for the structure of the provisions for electronic filing.

Annex F

Annex F should be limited to issues that are an essential requirement for the functioning of electronic transactions under the PCT. In essence, these would be:

- Document formats (ie XML, PDF, TIFF, JPEG)
- XML DTD's

Annex G

There should be a new Annex G, which contains *recommendations* to national offices of ways to implement electronic filing. This would include:

- PKI issues
- Document wrapping
- Physical media specifications
- Records Management principles

As a consequence, most of the material currently in Annex F would be transferred to Annex G

Administrative Instructions:

- 703(c)(i) – delete the reference to Annex F with respect to the means of filing. The means should be left to the office to specify, consistent with national law requirements.
- 707(d) – there will need to be matters specified regarding how amendments are to be incorporated in the specific document formats allowed. Also, there may be a need to deal with amendments filed on a different media, or using a different file format. There is a question, however, of whether those issues are part of the administrative instructions, or should be part of the Receiving Office guidelines. Other issues (if any) should be in Annex G, as guidelines.
- 708(a) – delete everything after 'Rule 93'. The requirements of Rule 93, at the broad level, is all that should be required.

- 708(b) – delete. This is not required for paper-based systems. The requirement for this for electronic based systems inappropriately assumes that offices should not be trusted in the electronic environment.

- 708(c) – move to Annex G. Properly considered, these paragraphs are guidelines as to best practice for maintaining records, and should be treated as such. The actual manner in which an office maintains its records should be left to each office, having regard to national law requirements and obligations.

- 709(a) – delete 'in accordance with Annex F'. All that is required is the general principle.

- 709(b) and (c) – delete - although it might be appropriate to have some guidelines in Annex G.

Software development

Australia notes the commitment of the IB to develop a software package to implement electronic filing under the PCT. In Australia's view, that package should be fully consistent with the Annex F requirements. With regard to the matters that Australia considers should be in an Annex G, Australia would envisage the package would

(i) adopt an approach to issues such as PKI that was appropriate to the majority of countries that would be reliant on the package – or several packages providing different levels of PKI that can be selected from according to a country's needs; and

(ii) allow applicants to use more stringent requirements if they so wished.

Additional Comments

Observations relating to other matters in the Administrative Instructions:

- 702(b) – Australia queries why the record copy is not merely a copy of the application – even in the environment where the document is wrapped. The equivalent in the paper environment would be to provide that the envelope, in which the application was mailed, is part of the record copy.

- 703(b) – while this deals with receipt in an incorrect format as a formality matter, it does not provide for receipt in an incorrect medium as a formality matter. This would appear to be an oversight.

- 703(f) – 2nd last line – presumably the effective date of any change shall be 'such later date' determined by the RO – so that the 2-month period is in fact a minimum period of notification.

- 704(a) – as currently worded, this would appear to imply that the attachment of any ‘acceptable’ electronic signature results in the document being considered to have been signed as required by the Treaty or Regulations – even if that signature, if executed in traditional manner, would not meet the requirements.

- 704(b) – shouldn’t this also apply to Designated Offices [or is that a matter for rule 51*bis*.?]

- 705(a) – line 5 – the reference to time should be deleted. Only date is relevant.

- 707(b) – refers to the application being ‘fully and successfully received’. This approach is inconsistent with the way the PCT generally, and s.706 in particular, allows for the receipt of incomplete applications.

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