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PCT COMMITTEE FOR ADMINISTRATIVE AND LEGAL  
MATTERS

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ELECTRONIC FILING OF INTERNATIONAL APPLICATIONS USING THE "EASY"  
SYSTEM: PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE PCT

*Memorandum prepared by the International Bureau*

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\* *Editor's Note:* This electronic document has been created from the paper original and may contain errors. Please bring any such errors to the attention of the PCT Legal Division by e-mail at [pct.legal@wipo.int](mailto:pct.legal@wipo.int)

## INTRODUCTION

1. In the context of their ongoing trilateral cooperation, the United States Patent and Trademark Office (USPTO), the European Patent Office (EPO) and the Japanese Patent Office (JPO) in 1992 created a project dedicated to an easy application system (the EASY project). The project was included in the Tenth Memorandum of Understanding between those Offices in October 1992. Using the very positive results achieved by the JPO in the field of electronic filing, the USPTO and the EPO decided to jointly develop software which would enable applicants to prepare European, US and, subject to agreement with WIPO, international patent applications under the PCT in electronic form. WIPO's participation in the project was invited and was agreed to by the Director General.
2. While the ultimate aim is to achieve complete on-line electronic filing leading to the elimination of paper filing, the EASY project aims initially at the development of a means to enable electronic filings on diskette. The USPTO is acting as the "lead Office" for the project.
3. It is expected that significant benefits and savings for applicants and patent Offices will result from the preparation of patent applications using the EASY system, including immediate validation of data when entered, the use of help screens, reduction of paper used, reduction in data entry and checking costs for the Offices concerned, and more streamlined and better quality publication of patent applications.
4. Implementation of the EASY system for filing international applications under the PCT requires amendment of the Regulations. The proposals for such amendments contained in this document, primarily the proposed addition of new Rule 89bis\*, are designed to provide a legal basis for implementation of the system.

## Development of the EASY system

5. The development of the EASY software has been scheduled in four successive stages called "Pilots", Pilots 1 to 3 providing for the filing of applications on diskettes and, ultimately, Pilot 4 providing for on-line filing of applications via telecommunication means.
  - (a) pilot 1 provides for the filing on diskette of an entire application in two parts, the "request part", containing the bibliographic data entered by the applicant through the completion of logical screens, and the "application part", containing the description, claims, abstract and drawings (if any), in the form of a word processing file. Pilot 1 would cover the development of the installation program for applicants, form software with associated validation, fee processing, electronic sealing, file management, help screens, word processor interface, print/display capability, generation of the filing docket, and possible interfaces with applicant data bases and patent office systems.

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\* References in this document to "Articles" and Rules" are, respectively, to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT ("the Regulations"), or to such provisions as proposed to be amended or added, as the case requires.

(b) Pilot 2 incorporates the procedures of Pilot 1, additionally providing for the development and testing of software enabling conversion of the application, by the Office receiving it, from a word processing format into a common mixed-mode format using SGML (Standard Generalized Mark-Up Language), including drawings and embedded images. The use of the SGML conversion software would enable the Offices using EASY to publish applications in composed layout at a much lower cost than is presently possible.

(c) Pilot 3 will move the conversion and printing software developed and tested during Pilot 2 to the applicant's environment. The conversion software made available to applicants would provide for validation of the application's contents and resolution of formatting problems before the application is filed, thus permitting maximum standardization and relieving the Office of the conversion task, thereby contributing to more rapid and efficient publication.

(d) Pilot 4 will provide for the on-line filing of applications via telecommunication means as an alternative to filing on diskette.

6. The scheduling and scope of implementation of the Pilots will be dealt with separately by each of the three participating organizations.

#### Effects of the EASY system on PCT users and Offices

7. In view of the advantages which will accrue from filing patent applications in electronic form, it is proposed that the Regulations be amended so as to permit electronic filing of international applications with receiving Offices to the extent that they are prepared to receive them. It is proposed that the amendments to the Regulations enter into force on January 1, 1994. However, electronic filing would not be possible in practice before Administrative Instructions implementing the amended Regulations have been made.

8. No applicant would be obliged, as a result of the amendments, to depart from the usual (non-electronic) procedures for filing an international application under the PCT. Nor would any PCT receiving Office or other authority be obliged to receive or handle applications other than in paper form.

9. It would be open to any receiving Office to take advantage of the possibilities afforded by the amended Regulations and, where an international application has been filed using EASY, for other Offices and authorities to take advantage of that fact. If the changes proposed to the Regulations in document PCT/CAL/V/2 are adopted, the International Bureau will act as an "alternative" receiving Office for residents and nationals of all PCT Contracting States. In that event, the International Bureau as receiving Office would intend to take advantage of certain possibilities offered by the EASY system.

10. In order to assist the Committee in its consideration of the proposed amendments to the Regulations, the following summary outlines a plan for gradual implementation of the EASY filing system in relation to international applications. The proposed amendments would allow for the implementation plan to be varied as developments in the EASY project occur.

Proposed plan for implementation of EASY filing of international applications under the PCT

11. It is planned to provide for step-by-step implementation of the EASY system for filing international applications. As mentioned above, the use of the EASY system would be optional for receiving Offices and, where available at a particular receiving Office, would be optional for applicants.

12. The International Bureau proposes that, initially, only the "form software" module of Pilot 1 would be made available to applicants for the filing of international applications in English, French or German. Applicants would complete the logical screens of the "request part" of the international application, taking advantage of the validation and help screens. The request prepared in this way would be printed, signed, and filed with the rest of the international application as hard copy, accompanied by a diskette containing the request in EASY format. The diskette could then be used by the receiving Office and the International Bureau to download bibliographic data, making data capture simpler and more accurate.

13. The details of the requirements for the request in EASY format would be laid down by the Administrative Instructions, which would ensure that the format of the printed request prepared using the EASY software would be acceptable to receiving Offices. The administrative procedures of receiving Offices would be virtually the same as at present. However, the task of the receiving Office would be simpler because the request would have been prepared with the advantage of the inbuilt validation procedures available in the EASY software. The international application in its entirety would thus be filed in paper form, as it presently is. The diskette accompanying it would not be considered as part of the international application.

14. Further stages of implementation would be decided upon later in the light of practical experience gained in the initial stage and in the light of developments in Pilots 2, 3 and 4.

Proposed amendments of the Regulations

15. Since, in the initial stage described above, it is envisaged that the use of the EASY software would be optional and that the international application would still be filed, in its entirety, in paper form, that stage could, in principle, be implemented without amending the Regulations. However, further implementation of EASY will undoubtedly require the introduction of provisions diverging from the present requirements of the Regulations, and it is therefore desirable to amend the Regulations now so as to enable future developments in the system to be readily accommodated.

16. The proposed amendments would provide the option of filing international applications, later documents and/or correspondence by electronic means or in electronic form, although no Office would be required to accept such filings. Since the details of implementation would, under the proposed amendments, be governed by the Administrative Instructions, the way in which the EASY system is implemented will be subject to consultation with all PCT Contracting States in the course of the preparation of the necessary modifications of the Administrative Instructions.

17. The keeping of records and files is an issue related to the electronic filing of applications and documents. It is proposed to amend Rule 93.4 to add provisions allowing for storage in microform or on electronic media.

18. The proposals contained in this document are submitted for consideration by the Committee at its fifth session. It is then intended that proposed amendments to the PCT Regulations will, taking into account the conclusions of the Committee, be submitted to the Assembly of the PCT Union for consideration and, if appropriate, adoption, at its 21st session in September 1993.

19. The amendments to the Regulations which are proposed by the International Bureau, together with explanations, appear below. The text of the proposed amendments appears on the odd-numbered pages, whereas the corresponding explanations appear on the opposite even-numbered pages. In the text itself of the Rules proposed to be amended, what is new as compared to the present text is indicated by underlining.

*20. The Committee is invited to consider and advise the International Bureau on the proposed amendments contained in the present document.*

## EXPLANATION OF THE PROPOSED AMENDMENTS

*Ad Rule 89bis*

1. In order to implement the EASY system, it is preferred to avoid multiple amendments to the Regulations themselves. It would be impracticable to attempt to formulate amendments to all the Rules which might be involved, particularly since step-by-step implementation is planned, with future steps depending on experience gained in the initial stages. It is therefore proposed to include a new Rule 89bis as an "umbrella" provision which would enable the EASY system to be implemented by the Administrative Instructions, subject to certain limitations and safeguards in the Rule itself. It is felt that this approach best addresses the need for flexibility in order to accommodate future developments and changes in the EASY system.
2. Proposed Rule 89bis.1(a) makes general provision for the filing of international applications by electronic means (which would include, for example, direct on-line filing) or in electronic form (for example, on a computer diskette). The requirements for filing and processing such applications would, under proposed Rule 89bis.1 (b), be governed by the Administrative Instructions, notwithstanding the existing provisions of the Regulations (in particular, those relating to the form, physical requirements and general processing of the international application). The requirements for the substantive contents of the international application would not be changed. It is made clear by proposed Rule 89bis.1(c) that no national Office or intergovernmental organization would be obliged to receive or process international applications filed in electronic form or by electronic means, unless it is prepared to do so. Proposed Rule 89bis.2 would extend the new provisions to apply to other documents and correspondence relating to international applications.
3. It is envisaged that Administrative Instructions made for the purposes of proposed Rule 89bis.1(b) would cover all aspects of the processing of international applications under the Treaty, including, but not limited to, the preparation, transmittal and communication of copies or reproductions of international applications (including the various copies referred to in Article 12), international publication, international search, international preliminary examination and the keeping of records and files. The Administrative Instructions would initially provide for the filing of only certain elements of the international application (such as the request) in electronic form. Other matters to be covered by the Administrative Instructions would include the format of the computer printout of the request, procedures for making changes to the request, provisions for the mailing and labeling of the filed diskette, information on how to obtain the EASY software, etc.

TEXT OF THE PROPOSED  
AMENDMENTS

Rule 89bis\*

Filing by Electronic Means or in Electronic Form

89bis.1 *International Applications*

(a) Notwithstanding any provision in these Regulations relating to the form, physical requirements and processing of the international application and subject to paragraphs (b) and (c), international applications may be filed by electronic means or in electronic form.

(b) The requirements for the filing and processing of international applications filed wholly or partly by electronic means or in electronic form shall be as prescribed by the Administrative Instructions.

(c) No national Office or intergovernmental organization shall be obliged to receive or process international applications filed by electronic means or in electronic form unless it has notified the International Bureau that it is prepared to do so and the International Bureau has published information thereon in the Gazette.

89bis.2 *Other Documents*

Rule 89bis.1 shall apply mutatis mutandis to other documents and correspondence relating to international applications.

*Ad Rule 93.4*

1. The present limitation in Rule 93.4 to photographic reproductions of records, copies and files has become out of date in the light of technological advancements which have facilitated the storage of records and files on computer disks, optical disks or in microform. In addition, Rule 93.4 should take into account proposed new Rule 89bis which would provide the possibility of filing international applications by electronic means or in electronic form. It is therefore proposed that Rule 93.4 be amended to add provisions allowing for storage in microform or on electronic media.

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\* New Rule 89bis is proposed to be included before Rule 90 in Part F of the Regulations.

Rule 93

Keeping of Records and Files

93.1 to 93.3 [No change]

93.4 Reproductions

For the purposes of this Rule, records, copies and files shall also mean photographic, electronic or other reproductions of records, copies and files, for example, on paper, in microform or stored on electronic media (microfilms, computerized records, optical discs, or other).

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