

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

Eighteenth Session
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Paragraph Amendment of PCT Applications

Document prepared by the International Bureau

SUMMARY

1. The International Bureau proposes to draw up a more complete plan for processing of international applications in XML format before agreeing on a common system for paragraph-based changes. In the meantime, the International Bureau and any concerned receiving Offices should continue and, where possible, extend *ad-hoc* arrangements for making changes to XML in order to allow delivery of XML to designated Offices as far as possible and to learn more about the issues involved.

BACKGROUND

2. Discussions have been going on in various fora since 2002 (see document PCT/EF/PFC 02/013) about how to make and process changes to international applications based on addition, deletion or modification of parts of the description, claims, drawings and abstract at the level of units such as paragraphs, sections or individual figures, which do not necessarily coincide exactly with printed pages, whether before or after the change is made.
3. This is traditionally of particular importance to international applications filed in XML format, since the details of the layout are not controlled by the applicant and may vary depending on the rendering systems available to the applicant or the Office. As a result:
 - (a) it is difficult for the applicant to provide replacement sheets which reliably match the page breaks in the home, search or record copy of the international application; and

- (b) using replacement sheets means that the application which had started off in full text format reverts to being an image-based application unless the Office processing the changes incorporates those changes manually into the XML, which can be time-consuming and introduces opportunity for error.
4. Now, many Offices are interested in processing applications in full text format in the national phase. Furthermore, accurate full text versions of applications are important for ensuring effective dissemination of the technical content of international applications. As such, the International Bureau needs to find a way of delivering this full text information efficiently and accurately for all international applications, not just those filed in XML format.
 5. For some time now, the International Bureau has been publishing full text versions of international applications filed in Chinese, Japanese and Korean, including corrections and rectifications introduced into the original XML by the International Bureau based on copying text from amendments supplied by the applicant in parallel with the processing of image-based amended sheets. Such parallel processing is, of course, inefficient and is intended as an interim procedure, pending the introduction of a proper paragraph-based amendment system and the removal of technical and legal obstacles to official publication in text format. The practical impact of the parallel processing is currently limited as a result of the limited number and nature of the changes which need to be handled, but would be very significant if extended to cover all changes (including Article 34 amendments) for all applications (including those originally filed in paper or PDF format).
 6. Since the discussions in the 17th session of the Meeting of International Authorities (see documents PCT/MIA/17/9 and 11 and paragraphs 83 to 88 of document PCT/MIA/17/12), the International Bureau has received a number of informal comments from Offices on the requirements of a paragraph-based amendment system. It is clearly important that the results of any correction, rectification or amendment process in the international phase are usable for the national phase processing, but there is a reluctance to accept material from the international phase which is not fully consistent with what would be expected from national processing. There is a willingness to change national procedures to some extent to take advantage of full text processing, but the visions for this in different Offices remain difficult to reconcile.
 7. Moreover, those differences between national procedures mean that, even where the relevant Offices have systems to process XML, it may be difficult to ensure consistent, accurate results if each Office uses its own system for international phase processing, especially in cases where several different Offices are responsible for approving different types of change to the same international application.

THE WAY FORWARD

8. The International Bureau is not yet ready to provide a proposal on how paragraph-based amendment should be implemented in the PCT. An effective solution seems only to be possible in the context of a full plan for the use of XML as the primary means for processing the application body throughout the international phase. Such a plan would need at least to consider all of the following elements:
 - (a) Agreement on whether all international applications which are not filed in XML should be converted to that format at an early stage of processing. From that point, all subsequent processing by Offices would be based on the XML version of the international application. Original paper, PDF or other versions of the international application would be kept solely for the purpose of verifying whether errors had been

introduced as a result. The alternative would be a hybrid arrangement where processing depended on whether the international application was filed in XML format or as either paper or PDF – this might anyway need to be considered as a possible transitional arrangement.

- (b) Changes which need to be authorized by different Offices would be made on an authoritative central version of the international application using a common tool. The updated version of the international application would be available to all Offices involved in the processing of the international application as soon as the changes had been authorized. Except where the Treaty does not permit it, the changes would also be made immediately available to third parties using PATENTSCOPE[®].
- (c) Applicants would retain the option of specifying changes on paper, which would then be incorporated into the authoritative central version of the application body either by the Office responsible for authorizing the changes or else by the International Bureau on behalf of those Offices. However, the preferred option would be for the applicant to submit the changes directly in electronic form to a centralized service maintained by the International Bureau and the relevant Office would be responsible for authorizing the changes also using that system.
- (d) To accommodate the needs of Offices with different methods of processing, the system would maintain sufficient information to either hold or generate on demand at least the following documents:
 - (i) Clean consolidated text of all versions of the application.
 - (ii) Marked up views comparing any two versions of the application and allowing the viewer to see what changes have been made at what time and, if possible without reducing clarity, for what reason (correction, rectification, amendment or incorporation by reference). The most common needs are to compare the latest version with either the previous version or the “as-filed” version, but the system should allow any pair to be compared.
 - (iii) A clean version of the application as filed, accompanied by a list of amendments which have been made up to any particular point.

Each of these documents would be available either as XML or as a rendered image.

- (e) Paragraph numbers, once created (they may need to be added *ex-officio* as part of the initial conversion of paper or PDF applications), should probably remain unchanged in most cases throughout the international phase processing, even if paragraphs are added or deleted before them. Any exceptions should involve either explicit renumbering by the applicant or else, possibly, an *ex-officio* action where the applicant is informed of the change and provided with a marked up version of the application body showing the old and new paragraph numbers.
9. The paragraph numbering should be treated as a technical and administrative matter and not as being part of the substantive content of the international application. This way, it may be possible to ensure that a consistent approach can be found for the international phase which allows paragraph numbers to be added to paper and PDF filings *ex-officio* and for consistent numbers to be used by the applicant and the different Offices for the duration of the international phase, while then allowing renumbering for the national phase according to the standards which are used by individual national Offices, without the need for the applicant to submit new copies of the international application solely to meet

numbering requirements. The exact details of the numbering system should be chosen as a matter of technical and administrative convenience, based on the detailed proposals for the centralized change management system and any tests conducted to try out different technical options.

10. The International Bureau proposes to prepare a more complete proposal on how full text versions of the international application could be used as the basis for all processing, the implications of this for Offices involved in the international phase processing, the likely costs and the benefits which could be achieved.
11. In the meantime, the International Bureau is looking at extending its *ad-hoc* procedures for preparing XML versions of application bodies including corrections and rectifications and believes that the experience gained in doing this will provide valuable information for preparing the more complete proposal. Information on the experience of such matters by other Offices, whether as part of their PCT processing or national processing, would be useful.

12. *The Meeting is invited to comment on the issues raised in this document.*

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