

## **Patent Cooperation Treaty (PCT) Working Group**

**Fourteenth Session**  
**Geneva, June 14 to 17, 2021**

### **CERTIFIED COPIES OF EARLIER INTERNATIONAL APPLICATIONS**

*Document prepared by the International Bureau*

#### **SUMMARY**

1. The document outlines options and further details of a preferred option to allow record copies of international applications to be used as the basis of certified copies in the case where the international application is used as the basis of a priority claim in a later application – normally an international application, but also for later national applications.

#### **BACKGROUND**

2. The Japan Patent Office has invited the International Bureau to assess options for more efficient arrangements for priority documents in the case where an application, especially an international application, claims priority from an earlier international application.

3. 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.

4. 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 Office<sup>1</sup>.

5. The International Bureau prepared a document on certified copies of priority documents (document PCT/MIA/28/6) for the twenty-eighth session of the Meeting of International Authorities in March 2021. Paragraphs 15 to 22 of the Summary by the Chair of the session (document PCT/MIA/28/9, reproduced in the Annex to document PCT/WG/14/2) give details of the discussions of this document.

## CONSIDERATIONS

6. 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.”

7. In addition, noting that the numbers of applications involved are relatively small, it is important that the cost be reasonable and that a single approach, with little or no impact for receiving Offices, should address all of the relevant cases, rather than having to develop multiple systems covering different, even smaller groups of document exchange needs.

8. 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.

9. At the fortieth series of meetings of the Assemblies of the Member States of WIPO, from September 27 to October 5, 2004, the Assemblies of the Paris Union and of the PCT Union adopted an agreed understanding on the provision of priority documents (paragraph 9 of document A/40/6, emphasis added to item (i) and relevant parts of item (iii)):

“The Assemblies of the Paris Union and the PCT Union agree that the following principles shall apply to the application of Article 4D(3) of the Paris Convention, Article 8 of the PCT and Rule 17 of the PCT Regulations:

(i) *it is for the competent authority furnishing the priority document to determine what constitutes certification of a priority document and the date of filing, and how it will certify such a document;*

(ii) each Office will accept a single certification that applies to more than one priority document (“collective certification”), provided that such certification permits identification of all priority documents to which it relates;

(iii) a non-exhaustive list of examples of forms of certification of priority documents agreed to be acceptable consists of the following:

- certification in paper form;

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<sup>1</sup> 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](#).

- certification in electronic character coded form;
- an electronic image of a certification on paper;
- *the collective certification of multiple priority documents transmitted by an Office to another Office or to the International Bureau;*
- *the collective certification of multiple priority documents contained in an Office database providing access to such documents to those entitled;*

(iv) for the purpose of Article 8 and Rule 17 of the PCT, once a priority document has been issued and certified in accordance with the foregoing principles by the receiving Office, and transmitted to the International Bureau in electronic form, no designated or elected Office may require any different form of certification or any re-certification of that priority document; however, the International Bureau will continue, on request by any designated or elected Office, to furnish copies in paper form of priority documents held in connection with international applications under the PCT.”

## OPTIONS

10. 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.

11. However, in order for the PCT system to function effectively, the transmission of a record copy by the receiving Office to the International Bureau with the request stamped with the international application number and international filing date (or accompanied by the equivalent information in electronic format) must, in practical effect, be a certification by the receiving Office that the record copy is a true copy of the international application as filed there. Consequently, the International Bureau can be considered to be in possession of a certified copy of all international applications. 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 cover page drawing on the individual certification 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 (or alternatively, take equivalent actions in respect of a later national application). 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.

12. 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, the certified copy would contain all parts of the application as originally filed and any other elements included (such as corrections, as included in RO/IB certified copies in accordance with Rule 21.2) would be clearly marked to distinguish them from original pages. Eventually, the preparation of such a certified copy should be made fully automatic. However, this will be dependent on longer term developments establishing a more clear and consistent system of documentation of the application body from filing to publication (and beyond, embracing Chapter II amendments, for example). Initially, given the variation in presentation of the contents of record copies from different receiving Offices, the certified copies will need to be assembled largely manually by the International Bureau and will represent a significant burden per application, albeit manageable in view of the small number of international applications that would be involved.

13. 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 that a copy of the application 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. It would also 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.

14. Article 4D(3) of the Paris Convention indicates that a country "may require [the certified copy] to be accompanied by a certificate from the same authority showing the date of filing". However, it is undesirable to require the receiving Office to generate a new form of certificate for every international application (as might appear necessary for options (ii) and (iii)) when it would

only be used for a very small proportion of the total. Consequently, it is suggested that this requirement could be fulfilled by the inclusion in the certified copy of the request form, either as physically stamped by the receiving Office with the international application number and international filing date, or with a rendering of equivalent electronic data transmitted to the International Bureau with the record copy. The Paris Union and PCT Assemblies might acknowledge this with an understanding along the following lines:

“Having regard to the agreed understanding regarding the application of Article 4D(3) of the Paris Convention, Article 8 of the PCT and Rule 17 of the PCT Regulations, adopted at the fortieth series of meetings of the Assemblies of the Member States of WIPO, from September 27 to October 5, 2004, the Assemblies of the Paris Union and the PCT Union further agree that, in the case where the record copy of an international application is transmitted from a receiving Office to the International Bureau:

(a) the transmission of the record copy of the international application constitutes a certification that the copy is correct; and

(b) the request form stamped with the international application number and international filing date, or the provision of equivalent electronic data together with the record copy, shall be considered a certificate from the receiving Office, suitable for potential future use of the record copy as a certified copy under Article 4D(3) of the Paris Convention.”

15. The Annex to this document contains indicative draft amendments to the PCT Regulations, showing in more detail how option (iii) as outlined in paragraphs 10 and 13, above, might be implemented.

16. The above arrangements would have minimal impact on national Offices. For those few receiving Offices already supplying copies of international applications to DAS, they could continue to do so and the Service would, where appropriate, seek to obtain priority documents directly from the receiving Office before seeking to select one from the International Bureau. Receiving Offices would not need to become users of DAS either as depositing or accessing Offices – the International Bureau would act as the depositing Office and, as is the current arrangement, would be the sole Office accessing the Service to retrieve certified copies for use with later international applications.

*17. The Working Group is invited to comment on the proposals set out in this document.*

[Annex follows]



INDICATIVE DRAFT AMENDMENTS  
TO THE PCT REGULATIONS

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## Rule 21

### Preparation of Copies

21.1 and 21.2 [No change]

#### 21.3 Certified Copies for a Digital Library

Where an Office has supplied a certified copy of an earlier international application in accordance with Rule 22.1(a), the International Bureau may, in accordance with the Administrative Instructions, make that certified copy available to a digital library for use as a priority document.

[COMMENT: The Administrative Instructions would cover both the detail of when a certified copy would become available and the form that the copy would take. The International Bureau's collection of record copies would become a digital library associated with DAS. Availability would be, in principle, be triggered by the applicant for a later application supplying the correct international application number and associated access code. In most cases, the actual availability would be delayed by a few days because the certified copy would not be available in an appropriate form – the receipt of the application number and access code would trigger a task for the International Bureau to create the required document. In the early phases, this would be a manual process because the record copies sent by different receiving Offices are not sufficiently consistently indexed to allow a fully reliable automation.

In principle, the same arrangement could be extended to certified copies of applications other than earlier international applications and to copies received from applicants under Rule 17.1(a). However, this would involve additional costs that have not been assessed and would appear to be of limited value since retrieval of such documents from DAS should never be required for national phase entry (because the documents should already be available to designated Offices under Rule 17.2). The benefits of avoiding the need to provide additional certified copies would only be seen for applications running in parallel to the PCT application and for which the certified copy was not already available from DAS.]



## Rule 22

### Transmittal of the Record Copy and Translation

#### 22.1 Procedure

(a) If the determination under Article 11(1) is positive, and unless prescriptions concerning national security prevent the international application from being treated as such, the receiving Office shall transmit the record copy to the International Bureau. Such transmittal shall be effected promptly after receipt of the international application or, if a check to preserve national security must be performed, as soon as the necessary clearance has been obtained. In any case, the receiving Office shall transmit the record copy in time for it to reach the International Bureau by the expiration of the 13<sup>th</sup> month from the priority date. If the transmittal is effected by mail, the receiving Office shall mail the record copy not later than five days prior to the expiration of the 13<sup>th</sup> month from the priority date. The transmission of the record copy shall be considered a certification that the record copy is a correct copy of the international application as filed. The indications made on or together with the request form of the record copy shall constitute a certificate from the receiving Office showing the international filing date.

[COMMENT: Conventionally, the record copy is considered the original of the application, from which all processing in designated Offices originates. However, in digital terms, the difference between original and any other version is largely theoretical provided that the processing is done correctly. The words proposed here are intended to provide a basis for the transmission of the record copy explicitly meeting the requirement of Article 4D(3) of the Paris Convention, which requires (when applied to an international application) a certification by the receiving Office that a copy is a correct copy of the home copy (since that is the copy in the records of the receiving Office), as well as for enabling the possibility that a certificate be provided by the receiving Office indicating the international filing date. The wording “on or together with” is intended to allow for effective digital processing, which should not require images to be “stamped” with information, but rather allow the original applicant XML request form data to be accompanied by Office data providing the equivalent information in machine-readable format.]

(b) to (h) [No change]

22.2 *[Remains deleted]*

22.3 *[No change]*

[End of Annex and of document]