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IMPACT PROJECT: UPDATE ON PCT ELECTRONIC FILING

Document prepared by the International Bureau

1. During the 28th (16th extraordinary) session of the PCT Union Assembly held in Geneva from March 13 to 17, 2000, the International Bureau provided a progress report on the PCT automation project IMPACT (Information Management for the Patent Cooperation Treaty) (see document PCT/A/28/4¹.) In addition, discussion took place on amendments to the PCT Administrative Instructions required to enable electronic filing and processing of international applications. These discussions were based on document PCT/A/28/3 (a provisional version of which was notified to SCIT Task Force members on December 22, 1999), and comments subsequently received and published as documents PCT/A/28/3 Add.2, PCT/A/28/3 Add.3, PCT/A/28/3 Add.4, and PCT/A/28/3 Add.5.

2. At the fourth Plenary session of the Standing Committee on Information Technologies (SCIT) in December 1999, an Action Plan² for PCT on-line filing was adopted. At the same session it was agreed that this Action Plan would be subject to review in the first quarter of 2000.

¹ This and other documents of the PCT Assembly's session are available on WIPO's Internet site at http://www.wipo.int/eng/document/govbody/wo_pct/index_28.htm.

² The SCIT Action Plan is reproduced as an attachment in document PCT/A/28/3 Add.1 and is available on WIPO's Internet site at http://www.wipo.int/eng/general/scit/project/p8/an_6.pdf.

3. It is recalled that PCT electronic filing, which will be expanded to go beyond only on-line filing, to include other electronic media, for example, CD-ROM, DVD, diskette, etc., was from the outset foreseen to be part of the IMPACT Project, (see document A/32/5, paragraph 1³) which stated that one of the principle objectives of the PCT automation project would be:

“to create and make available to receiving Offices and PCT applicants electronic filing software.”

4. As such, the IMPACT Project team will be responsible for fully developing the PCT electronic filing project plan, taking into account the Action Plan for PCT on-line filing. Once the PCT electronic filing project plan has been finalized, including any additional information resulting from the current session of the SCIT Plenary, it will be made available to PCT Contracting States for them to express their views. In this regard, the PCT Assembly noted that the portion of the IMPACT Project plan relating to PCT electronic filing would supersede the present SCIT Action Plan for PCT On-Line Filing (see document PCT/A/28/5, paragraph 22(ii)).

5. During the process of finalizing the PCT electronic filing standards, the IMPACT Project team will continue to utilize the expertise of the SCIT Task Force established for that purpose. Recognizing that the SCIT membership also has a strong interest in PCT automation, the International Bureau will continue to keep the SCIT informed of progress made in the IMPACT Project.

6. Additionally, it is mentioned in the report of the 28th session of the PCT Assembly that (document PCT/A/28/5, paragraph 33):

“the International Bureau indicated that the task of defining the requirements for and ultimately producing the PCT electronic filing software would be undertaken in consultation with the PCT Contracting States, the Trilateral Offices, the SCIT Task Force and user representatives. The requirements of potential users of such software (both Offices and applicants) would be identified and documented at the outset in order to ensure that they were addressed by adopting appropriate technical solutions.”

7. In accordance with the commitment listed in paragraph 2 above, the International Bureau has continued with the consultation process. In particular:

(i) from April 5 to 7, 2000, a delegation from the International Bureau visited the United States Patent and Trademark Office (USPTO). During this visit, the requirements for electronic filing software were discussed. Furthermore, the USPTO shared with the International Bureau its understanding of applicants' requirements in relation to electronic filing software;

³ This document is available on WIPO's Internet site at http://www.wipo.int/eng/document/govbody/wo_gb_ab/a32_5.htm.

(ii) a representative of the International Bureau attended the MIPEX (Message based Industrial Property Information Exchange) Plenary Meeting which was held on May 12, 2000. At this meeting, the International Bureau observed presentations of activities in the area of electronic filing relating to MIPEX; and

(iii) the International Bureau is currently drafting and preparing to circulate a survey to establish user requirements in the areas of electronic filing and enterprise functionality for the PCT-EASY software.

8. Also in the report of the 28th session of the PCT Assembly, it is noted that the International Bureau envisaged that (document PCT/A/28/5, paragraphs 36(a); 36(b) and 36(c)):

“(a) the IMPACT Project team would coordinate and provide leadership in the redrafting of Annex F in consultation with interested Offices, in particular, drawing on the expertise of the Trilateral Offices, as they had delivered the first draft of Annex F. The redrafting exercise would take into account comments made by the SCIT Task Force, and the IMPACT Project team would continue to coordinate its work with the Office of the PCT; at the same time, the Office of the PCT would redraft Part 7, coordinating its work with the redrafting of Annex F;

(b) once redrafted, Annex F would be the subject of consultation with all PCT Contracting States and Authorities, with the members of the SCIT Task Force and with user representatives; redrafted Part 7 would also be the subject of consultation with all PCT Contracting States and Authorities and with user representatives;

(c) when there was agreement on both Part 7 and Annex F, they would both be promulgated; Annex F would then become the PCT standard and would be referred to SCIT for adaptation and adoption as a WIPO Standard; the promulgation of Part 7 would mean that Rule 89bis would enter into force, thus legally enabling the electronic filing of international applications under the PCT with those receiving Offices which had notified their acceptance of such filings.”

9. The International Bureau participated in a meeting of the Trilateral Working Group for Electronic Filing, which was held at the European Patent Office in The Hague from April 17 to 19, 2000. The purpose of this meeting was to discuss the redrafting of proposed new Annex F to the Administrative Instructions (entitled ***Standard for Electronic Filing, Processing, Storage and Records Management of International Applications under the Patent Cooperation Treaty (PCT)***). At the meeting responsibilities for redrafting various elements of this document were allocated. Subsequently, and in accordance with the commitment mentioned in paragraph 8(a) above, the International Bureau has produced a new appendix to Annex F, entitled ***Appendix 3, Electronic Filing Using Physical Media***, which contains the standards for filing electronically on physical media. The International Bureau has also contributed text for ***Appendix 1 of Annex F, Draft PCT Technical Standard for the On-line Exchange of IP Documents in a PKI Environment***, which describes the overall model for filing on-line using PKI (Public Key Infrastructure). Redrafted Part 7 of the

Administrative Instructions was posted on WIPO's Internet site on May 11, 2000⁴. A redraft of Annex F will be posted as soon as it is available.

10. In accordance with paragraph 8(b) of this document, an informal consultation on the redrafted documents has been convened and will take place in parallel with the July 2000 meeting of the SCIT Plenary.

11. The SCIT Plenary is invited to take note of the update on PCT electronic filing contained in this document.

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⁴ This document is available on WIPO's Internet site at http://www.wipo.int/eng/meetings/2000/pct_ef/index.htm