

1. Identifier: PFR ST.36/2009/007

2. Procedure for handling the PFR: Fast-Track Procedure by the ST.36 Task Force

3. Submitted by: the European Patent Office, the Japan Patent Office and the United States Patent and Trademark Office

4. Submitted on: November 9, 2009

5. Subject of the PFR: Corrections and Changes in Patent Documents

6. WIPO Standards & Items impacted

- Annex A (xx-patent-document.dtd)
 - Annex C (International Common Elements: ICEs): the elements "statement", "amend-body", "amended-claims", "amended-claims-statement", "amendment-request", "delete-object", "insert-before-object", "insert-after-object", "replace-object" and "xx-patent-document"
 - Other standard: Annex F of the PCT Administrative Instructions
 - amendment-request.dtd, iprp.dtd, wo-published-application.dtd
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7. Reasons for Presenting the PFR

At present there is no way to mark up corrections or changes in patent documents using WIPO Standard ST.36 (without using office specific tags). The current proposal gives the least disruptive and generic method to mark up corrections or changes within patent and other documents.

There are several types of corrections and amendments during the life of a patent document, some of which are possibly shared by the national procedures:

- correction of obvious mistakes (PCT Rule 91)
- missing parts, incorporation by reference (PCT Rule 20.6)
- later submitted documents (PCT Rules 20.3(b)i and 20.5)
- amendments after the search report (PCT Article 19)
- amendments during examination (PCT Article 34)
- corrections and changes in published patent documents (WIPO Standard ST.50)

Some of the above amendments and corrections are currently captured (see category amendments of the ST.36 ICEs). Nonetheless throughout the different DTDs, there is no consistent way of handling amendments and corrections (compare e.g. the tag amended-claims in xx-patent-document and wo-amended-claims in wo-published-application).

Additionally, the existing structure do neither enable to group the requested change by sets (e.g. a first set submitted with a first request, a second with a further request, ...) nor ensure that a cross-reference between tags would behave in a predictable manner since a same ID would be present within the body of an application and the amendments part.

Although this proposals' first aim is to cover the necessity to indicate corrections or changes in the abstract, description, claims and drawings of corrected or re-issued patents, it should be left open for dealing with amendments and changes during the life cycle of an application.

The proposal aims also at avoiding substantially affecting the current DTDs in order to ensure backwards compatibility and no adverse impact on current publishing systems.

8. Detailed Description of the PFR

8.1 Detailed Reason

The proposed solution has been developed with the following requirements in mind:

- keeping the solution as open as possible so as to cover most of, if not all, the cases whether in national or PCT phase;
- ensuring that the original document can be reconstructed from the available information;
- ensuring that this proposal is fully backwards compatible with the previous versions of the xx-patent-document DTD;
- ensuring that the IDs remain unique within a document;
- ensuring that the publication processes are not impacted at all or to a very limited extent;
- avoiding the use of unparsed data and entities.

On top of the above requirements the Open Document Format ([ODF version 1.1, OASIS, 1 February 2007^a](#)) has been consulted for ideas.

The sections of a patent document needing change tracking are:

- the abstract
- the description
- the claims
- the drawings

Potentially sequence-listings and associated tables may also need such tracking.

Within the above section, the tags containing an ID, i.e. the lowest level of element that can be uniquely identified, are:

- invention-title;
- heading;
- p;
- claim;
- figure;
- doc-page;

or entire sections of the application:

- abstract;
- description;
- claims;
- figures.

A software could then by means of well known algorithms (see e.g. [RevXML[®]](#)) highlight the differences between the objects.

The proposed solution reuses some of the elements in amendment-request (amendment-request-v1-4.dtd) and could possibly render the amendment-request.dtd obsolete and to be replaced by document-amendment.dtd.

In view of the proposed modifications tags like <amended-claims> and <amended-claims-statement> may become deprecated and may trigger updates of other DTDs.

ADVANTAGES OF THE PROPOSED SOLUTION:

- Old data is kept separate, so it has no impact on rendering, indexing or publication processes.
- It allows changes across tags; one has only to choose an element with id attribute spanning the whole change.
- Single manner of processing all document changes.

DISADVANTAGES OF THE PROPOSED SOLUTION:

- The complete tag (the shortest one with an id attribute) needs to be rewritten.
- Rendering of modifications together with current version may be complex in some cases.

8.2 Proposed Solution (Modifications to the elements)

1. Replace the two elements amended-claims and amended-claims-statement by a new element document-amendments in the element xx-patent-document:

```
<!ELEMENT xx-patent-document (doc-page+ | ((bibliographic-data | SDOI),
description,claims+,amended-claims*,amended-claims-statement*,
abstract*,drawings?,search-report-data*,sequence-list-doc?,
table-external-doc*, document-amendments?)) >
```

2. Add the element document-amendments:

```
<!ELEMENT document-amendments (document-amendment +)>
```

3. Add the element document-amendment:

```
<!ELEMENT document-amendment (file-reference-id?, application-reference?, publication-reference?, statement?, (amend-body | amend-object+))>
<!ATTLIST document-amendment
  id ID #REQUIRED
  amend-procedure CDATA #REQUIRED
  amend-reason ( obvious-mistake | later-submitted-doc | incorporation-by-ref | after-srep | examination | opposition | limitation | republication | other)
#REQUIRED
  amend-reason-detail CDATA #IMPLIED
  amend-source ( electronic | letter | fax | email | office-form | other ) #IMPLIED
  source-date CDATA #IMPLIED
  received-date CDATA #IMPLIED
  amend-author CDATA #IMPLIED
  publication-info CDATA#IMPLIED>
```

4. Modify the element amend-body:

```
<!ELEMENT amend-body (doc-page+ | (description? , claims? , abstract? , drawings? , statement))>
<!ATTLIST amend-body
  id ID #IMPLIED
  lang CDATA #REQUIRED
  status CDATA #IMPLIED
  amend-status ( pending | accepted | rejected | cancelled ) #IMPLIED>
```

5. Deprecate the elements delete-object, insert-before-object, insert-after-object, replace-object.

6. Modify the element statement:

```
<!ELEMENT statement ( (b, i, u, o, sup, sub)* | (heading*, p+) )>
<!ATTLIST statement
  id ID #IMPLIED
  idrefs IDREFS #IMPLIED
  legal-basis CDATA #IMPLIED
  legal-reference CDATA #IMPLIED>
```

7. Add the element amend-object:

```
<!ELEMENT amend-object ((invention-title | heading | p | doc-page | claim |
figure), statement)>
<!ATTLIST amend-object
  id ID #IMPLIED
  idref IDREF #IMPLIED
  amend-status ( pending | accepted | rejected | cancelled ) #IMPLIED
  amend-operation ( delete | replace | insert-before | insert-after ) #REQUIRED
  amend-position IDREF #IMPLIED>
```

9. APPENCIDES

Appendix 1: Proposed Modifications to the ST.36 ICES

Element name	Description	Uses	Used by	in DTD	Category	Entry or revision date
document-amendments	Any changes are identified by the presence of the <document-amendments> element where varying levels of change may be indicated. Normally changed documents would also be indicated by data in the bibliographic data part of any file, for example, as specified in WIPO ST.50; that is, for example, data in <st50-republication> or <B150>. How changes are indicated in the actual document is a matter for each office. There will be no indication of changes in the description, claims, etc; it will simply contain the latest version of the document.	document-amendment	xx-patent-document	xx-patent-document	Amendments	(new)
document-amendment	Each change to the application documents is identified by <document-amendment> element. The attributes for this element are:: id, an identifier (ch####); the date at which the change was requested and received; an identification of the initiator of the change; an identification of the reason for the change.	statement, file-reference-id, application-reference, publication-reference, amend-body, amend-object	document-amendments	xx-patent-document	Amendments	(new)
statement	Statement concerning amendments (PCT Article 19.1, PCT Rule 46.4) contains the reasoning sustaining any assertion, objection or defect related to the application. The attributes legal-basis and legal-reference indicate the legal basis of the reasoning. The idref attribute provides the possibility to cross-reference other statements.	b, i, u, o, sup, sub, heading, p	amend-statement, document-amendment, amend-body, amend-object	amendment-request, wo-published-application, xx-patent-document	Amendments	(Modified) 2008.09.15 2004.11.11(E)
amend-body	Amend entire sections of the application-body.	doc-page, description, claims, abstract, drawings, <u>statement</u>	amendment-request, <u>document-amendment</u>	amendment-request, wo-published-application, xx-patent-document	Amendments	(Modified) 2004.11.11(E)
amend-object	Provides an amended object either by deletion, insertion or modification.	invention-title, heading, p, doc-page, claim, figure, statement	document-amendment	xx-patent-document	Amendments	(new)
amended-claims	Amended content of original application	doc-page, heading, claim, amended-claims-statement	xx-patent-document	xx-patent-document	Amendments	Deprecated
amended-claims-statement	Amendment statement (PCT Article 19.1, PCT Rule 46.4). eg. See EP 1367825 A1 and PCT/JP02/02111 Recommended id = 'asclaim'	doc-page, claims-statement	xx-patent-document, amended-claims	xx-patent-document, amended-claims	Amendments	Deprecated
delete-object	Delete object from document; e.g., paragraph, claim, etc. e.g. <delete-object id="p06"></delete-object>		amendment-request	amendment-request, wo-published-application, xx-patent-document	Amendments	Deprecated
insert-after-object	Insert new content after referenced object; e.g., <insert-after-object id="p02"><p id="p03" num="003">(new content)</p></insert-after-object>		amendment-request	amendment-request, wo-published-application, xx-patent-document		Deprecated
insert-before-object	Insert new content before referenced object; e.g., <insert-before-object id="p02"><p id="p01a" num="001a">(new content)</p></insert-before-object>		amendment-request	amendment-request, wo-published-application, xx-patent-document		Deprecated
replace-object	Replace referenced object with new content ; e.g., <replace-object id="p02"><p id="p01a" num="001a">(new content)</p></replace-object>		amendment-request	amendment-request, wo-published-application, xx-patent-document		Deprecated

Appendix 2: [Proposed Modifications to xx-patent-document.dtd](#)⁸

Appendix 3: [Examples of Corrected Patent Documents](#)⁹