

C. PCT 1332

February 17, 2012

Madam,
Sir,

Electronic Transmission of Search Copies of International Applications

This Circular is addressed to your Office in its capacity as a receiving Office and/or an International Searching Authority under the Patent Cooperation Treaty (PCT).

It is recalled that, at its first session held in May 2008, the PCT Working Group noted with approval plans by the International Bureau, as set out in document PCT/WG/1/8, to offer a service whereby the receiving Office would be able (with the agreement of the International Bureau and the International Searching Authority) to transmit the search copy and other documents necessary for international search to the International Searching Authority in electronic form via the International Bureau, using the receiving Office's existing communication link to the International Bureau, for example, via the existing PCT Electronic Data Interchange (PCT-EDI) system.

Noting that, up to the end of 2010, no Offices had agreed to use this arrangement in practice, the issue was again discussed at the 2011 session of the PCT Meeting of International Authorities, based on a proposal prepared by the International Bureau as to how such an arrangement could work in practice (document PCT/MIA/18/5). At that session, the International Authorities expressed a broad general support for the proposal. It was agreed that the International Bureau should further refine the proposal, taking into account the comments made and the concerns expressed, and further consult with all Offices in their various PCT capacities (as receiving Offices and/or International Authorities) by way of a Circular (see the report of the session, document PCT/MIA/18/16, paragraphs 98 to 105).

This Circular sets out the refined proposal prepared by the International Bureau and invites Offices in their capacity as a receiving Office and/or an International Searching Authority to indicate their preparedness in principle to transmit and receive, respectively, search copies of international applications in electronic form via the International Bureau.

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TRANSMISSION OF SEARCH COPIES IN ELECTRONIC FORM

Document PCT/MIA/18/15 set out a proposal as to how the electronic transfer of search copies from the receiving Office to the International Searching Authority could be implemented. Taking into account the comments made and the concerns expressed at the 2011 session of the PCT Meeting of International Authorities, the International Bureau has further refined the proposal for the procedure as follows:

- (i) the receiving Office would send the record copy package (an electronic bundle of documents including the record copy and a number of accompanying items) as per the current procedure to the International Bureau, using electronic transfer, namely, PCT-EDI;
- (ii) in addition to the transmission of search copies in its role as receiving Office, including Rule 19.4 cases, the International Bureau would transmit search copies (constructed using documents contained in the electronic record copy package received from the receiving Office) to International Searching Authorities on behalf of the receiving Office, provided that both Offices concerned have agreed to use this service. In all cases this transmission would be performed in a common format prepared by the International Bureau and would be identical to the format used for the transmission of search copies for the purposes of supplementary international search;
- (iii) to prepare the search copies, the International Bureau would extract the documents from the record copy package transmitted by the receiving Office and prepare the documents which are relevant for forwarding to the International Searching Authority. To the extent possible, this action would be entirely automated; and,
- (iv) having checked that the International Searching Authority chosen by the applicant was competent to carry out the international search and, optionally, upon receipt of a notification from the receiving Office that the search fee had been paid by the applicant, the International Bureau would promptly forward the prepared search copy to the International Searching Authority, using the existing PCT-EDI link. In all cases, the forwarded package should reach the International Searching Authority faster than at present where a paper copy is usually sent by post.

As mentioned above, the formatting of the search copy would follow the formatting of the search copies that are currently sent by the International Bureau to International Searching Authorities for the purposes of supplementary international search (subject to the responses to the consultation question regarding formatting, below), noting the following additional considerations:

- (i) sequence listings should be transmitted to International Searching Authorities as part of the search copy package in text form suitable for machine processing, as per WIPO Standard ST.25, or the future WIPO Standard ST.26;
- (ii) the latest bibliographic data extracted from the International Bureau's operational database will be transmitted in an eXtensible Markup Language (XML) file;
- (iii) in respect of virus checking and other security matters, it is expected that receiving Offices will furnish record copies free of viruses to the IB and that these virus free files will be used to compose the search copy files for transmission to International Searching Authorities; it should be noted that the existing PCT-EDI

virus checking environment has to date never detected any virus-infected transmissions. The security of the existing PCT-EDI infrastructure is viewed as sufficient for the identification of the recipient International Searching Authority and transfer channel encryption;

- (iv) in respect of the packaging of the search copies, this proposal envisages the transmission of a stream of document packages, constituting the search copy forwarded promptly upon its receipt at the International Bureau and, if desirable, after the confirmation to the International Bureau by the receiving Office of the payment of the corresponding search fees;
- (v) any further documents which were not included in the record copy package and that are transmitted to the International Bureau by the receiving Office at a later point in time (for example, a later received translation prepared for the purposes of international search) will also be subsequently forwarded via PCT-EDI to the International Searching Authority promptly after receipt by the International Bureau. Furthermore, to assist with the international search in cases where the record copy received by the International Bureau contains the description and claims in image format, a full text version created by the International Bureau using Optical Character Recognition (OCR) would also be forwarded to the International Searching Authority; and,
- (vi) both the International Bureau and the International Searching Authority are dependent on the prompt transmission by the receiving Office of any correction information or substitute sheets. In all cases it is expected that, in preparing the record copy for the International Bureau, all known corrections prior to the transmission will be included in the transmitted record copy, so that this corrected version would be transmitted as the search copy to the International Searching Authority by the International Bureau. Similarly, any correction information or substitute sheets received by the receiving Office after the transmittal of the record copy should be forwarded to the International Bureau as promptly as possible so that they can be routed to the International Searching Authority.

Regarding the choice of format for the electronic transmission of search copies on behalf of the receiving Office, the International Bureau has considered the formats currently used for the transmission of copies of international applications in electronic form for the purposes of international search, supplementary international search and proposals for the electronic transmission of international applications to national Offices in the case of early entry into the national phase. The current format used for supplementary international search transmission has the following advantages:

- (i) it is more suited to transmitting documents in a form that is not based on page images and has the capacity, with little revision, for the inclusion of bibliographic and full text data;
- (ii) it is suited to the transmission of international applications for three types of transmission needs (international search, supplementary international search and national phase entry);
- (iii) it allows the recipient Office to receive any full text versions of documents available at the International Bureau instead of delivering documents in an image format only; and,
- (iv) while still providing a consolidated application body it is already capable of transmitting in an automated manner subsequently received documents from receiving Offices to International Searching Authorities.

The concern expressed at the 2011 session of the PCT Meeting of International Authorities regarding the level of security risk within the PCT-EDI infrastructure has not been further reviewed in the context that the system requires secure private key pair authentication and that to date there have not been any reported issues. The International Bureau treats the security of unpublished data as a matter of paramount concern and would welcome either comments on procedures which are sufficiently specific to investigate and act upon, or else to discuss with Offices the level and nature of security testing which would be necessary to allay concerns.

CONSULTATION

Your Office is invited to comment on the further refined proposal outlined above.

In particular, your Office is requested to indicate:

- (a) whether your Office, in its capacity as a receiving Office, is prepared to transmit search copies of international applications using this mechanism to any competent International Searching Authority prepared to receive search copies in such a way; in addition, your Office is invited to confirm that it would be capable of *promptly* transmitting information, in a text form suitable for automatic processing, regarding the payment of the search fee to the International Bureau;
- (b) whether your Office, in its capacity as an International Searching Authority, is prepared to receive search copies of international applications using this mechanism; in addition, your Office is invited to inform the International Bureau whether or not it would require a notification that the search fee had been paid to be sent to it by the International Bureau together with the search copy;
- (c) whether your Office, in its capacity as an International Searching Authority or in its capacity as a receiving Office, has already entered into bilateral agreements with corresponding Offices for the transmission of search copies in electronic form and if so, describe the format and mechanism used for the transmission according that agreement;
- (d) whether your Office, in its capacity as an International Searching Authority, would find it advantageous to receive, and if so by when, in cases where the search copy was sent only as page images, the text of the application body captured using OCR as soon as it has been prepared by the International Bureau; and,
- (e) with regards to the security concerns expressed previously, please indicate any specific concerns, or security testing requirements, that your Office feels should be addressed in the PCT-EDI infrastructure.

Comments and feedback are invited to be submitted to the International Bureau by April 6, 2012, preferably by email to: pct.icd@wipo.int or by fax to: (+41 22) 910 71 50. For any specific questions you may also contact Mr. Peter Waring, (Peter.Waring@wipo.int, telephone: (+41 22) 338 8521).

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Following the receipt of your comments and your feedback, the International Bureau will approach “matching” pairs of Offices (receiving Office and competent International Searching Authority) which have indicated their preparedness to transmit and receive, respectively, search copies using this mechanism with a view to initiating concrete project work to develop, test and implement this procedure in the production environment.

Yours sincerely,

A handwritten signature in blue ink, appearing to read "James Pooley". The signature is fluid and cursive, with the first name "James" and the last name "Pooley" clearly distinguishable.

James Pooley
Deputy Director General