

Patent Cooperation Treaty (PCT) Working Group

Seventeenth Session
Geneva, February 19 to 21, 2024

FILING MEDIUM OF INTERNATIONAL APPLICATIONS AND RELATED DOCUMENTS

Document submitted by Brazil

SUMMARY

1. The present document proposes an amendment of the Regulations under the Patent Cooperation Treaty, aiming to allow receiving Offices to require the filing of international applications and the submission of subsequently-filed documents to be performed only in electronic form and not on paper. For the applicants from the receiving Offices that had made such option there will be the alternative of filing paper applications at the receiving Office of the International Bureau.
2. A second option is also included, intended for use by Offices that wish that filing of international applications and subsequently-filed documents be performed in electronic form but consider that paper needs to be permitted for the purpose of obtaining a filing date or meeting a deadline. This permits an Office to require resubmission of an application or document in electronic form within two months of making a submission on paper.

BACKGROUND

3. The electronic filing system brings benefits for all participants of the PCT, for instance, reduction in cost and processing time for the Offices, special discount applied in several fees related to an international application for the applicants. The ePCT system developed by WIPO has been used in a wide range of online services by applicants and patent Offices as receiving Office (RO), International Searching Authority (ISA) and International Preliminary Examination Authority (IPEA). Currently, ePCT-Filing is used by 87 receiving Offices and some others maintain their own electronic filing systems.

4. In 2022, the international applications filed on paper corresponded to 0.9 per cent of the total of PCT filings. This scenario is not the same for all receiving Offices: while some of them receive less than 1 per cent of paper applications, others receive 100 per cent of them.

5. At the fifteenth session of the Working Group, Brazil presented a proposal of amendment of Rule 89*bis*.1 and Rule 89*bis*.2 to allow receiving Offices to require that the filing of international applications, the submission of subsequently-filed documents and entry into the national phase be performed only in electronic form and not on paper (see document PCT/WG/15/13). The proposal received support of several delegations, noting that the amendment is optional and that the International Bureau could offer a route for filing paper if required. Some delegations were concerned about making the electronic format mandatory because, under exceptional circumstances, filing on paper could be the only option for the applicant. Other delegations expressed concerns about inconsistency with the Patent Law Treaty (PLT). The Working Group invited the Delegation of Brazil to revise the proposal working with the International Bureau and Contracting States interested in this issue, focusing on the filing of international applications and the submission of subsequently-filed documents.

6. With regard to the entry into national phase only in electronic format, the International Bureau was invited to study and analyze the issues for discussion at a future session of the Working Group (see paragraph 39 of document PCT/WG/15/19).

MAIN CONCERNS

7. During the fifteenth session of the Working Group, two main concerns were raised:

(i) to find an option for applicants to file on paper under exceptional circumstances, where the receiving Offices require only filing in electronic format; and

(ii) to be consistent with PLT.

8. The first concern can be addressed by ensuring that paper can continue to be filed at the International Bureau. This can be achieved by excluding the International Bureau from any provision allowing the exclusion of paper filing. Allowing paper filing to continue at the receiving Office of the International Bureau without any limitation would also address a secondary concern expressed by some delegations – that if Offices were required to accept paper in “exceptional circumstances”, there would be an additional burden of deciding whether that condition had been met. If the International Bureau provides a paper filing route that is always available, this would not be necessary.

9. Regarding the compatibility with the Patent Law Treaty (PLT), it should be noted that the PLT governs national or regional applications and the PCT governs international applications. They are distinct and different regimes. Consequently, any differences in approach between the two are questions of consistency, rather than compatibility. The proposal to ensure that applications can always be filed at the receiving Office of the International Bureau provides one degree of consistency with the PLT for the system as a whole.

10. However, for Offices that wish to move more completely to electronic filing, but still allow a high degree of consistency with the PLT within the Office itself, an alternative safeguard is proposed, whereby an Office may accept the filing of the international application on paper for the purpose of obtaining a filing date, but require an electronic version of the application to be submitted within two months.

REVISED PROPOSAL

11. The revised amendment of Rule 89*bis*.1 proposes two optional and exclusive options to receiving Offices that wish international applications be filed only in electronic format and not on paper:

- (i) The receiving Office may require any applications or subsequently filed documents to be submitted in electronic form – this option would not be open to the receiving Office of the International Bureau, which would consequently always accept paper filings.
- (ii) For the applicants from a receiving Office which due to national legislation, agreements or any other type of impediment, is unable to declare that it does not accept paper filings, the applicant will be able to file on paper to ensure the filing date and the Office will make a request for the documents to be submitted in electronic format.

12. Thus, receiving Offices would have three options:

- (i) continue allowing paper or electronic filings as at present;
- (ii) strictly require electronic filing at their own receiving Office, leaving the International Bureau as an option open to applicants wishing to file on paper; or
- (iii) allow applications and subsequently filed documents to be submitted on paper, but require corresponding electronic documents to be submitted within two months.

13. Annex II contains proposed modifications to Section 703 of the PCT Administrative Instructions, to clarify that an Office that chose option (b) would nevertheless be permitted to accept an international application filed on paper if it considered it appropriate to do so in particular circumstances.

14. The Working Group is invited to consider the proposed amendments to the PCT Regulations set out in the Annex to this document.

[Annex I follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 89bis
Filing, Processing and Communication
of International Applications and Other Documents
in Electronic Form or by Electronic Means

89bis.1 *International Applications*

(a) International applications may, subject to paragraphs (b) to (e), be filed and processed in electronic form or by electronic means, in accordance with the Administrative Instructions; ~~provided that any receiving Office shall permit the filing of international applications on paper.~~

(b) [No change] These Regulations shall apply *mutatis mutandis* to international applications filed in electronic form or by electronic means, subject to any special provisions of the Administrative Instructions.

(c) [No change] The Administrative Instructions shall set out the provisions and requirements in relation to the filing and processing of international applications filed, in whole or in part, in electronic form or by electronic means, including but not limited to, provisions and requirements in relation to acknowledgment of receipt, procedures relating to the according of an international filing date, physical requirements and the consequences of non-compliance with those requirements, signature of documents, means of authentication of documents and of the identity of parties communicating with Offices and authorities, and the operation of Article 12 in relation to the home copy, the record copy and the search copy, and may contain different provisions and requirements in relation to international applications filed in different languages.

(d) [No change] No national Office or intergovernmental organization shall be obliged to receive or process international applications filed in electronic form or by electronic means unless it has notified the International Bureau that it is prepared to do so in compliance with the applicable provisions of the Administrative Instructions. The International Bureau shall publish the information so notified in the Gazette.

(d-bis) A national Office or intergovernmental organization, other than the International Bureau, that has made a notification under paragraph (d) may notify the International Bureau that it will only receive international applications if they are filed in electronic form or by electronic means. The International Bureau shall publish a notification made under this paragraph in the Gazette.

(d-ter) A national Office or intergovernmental organization that has made a notification under paragraph (d) but not paragraph (d-bis) may notify the International Bureau that any application filed on paper must be resubmitted by electronic means within two months from the date of an invitation by such Office or organization. If corresponding documents are not timely received, the international application shall be considered withdrawn and the receiving Office shall so declare. The International Bureau shall publish a notification made under this paragraph in the Gazette.

(e) [No change] No receiving Office which has given the International Bureau a notification under paragraph (d) may refuse to process an international application filed in electronic form or by electronic means which complies with the applicable requirements under the Administrative Instructions.

89bis.2 *Other Documents*

Rule 89bis.1 shall apply *mutatis mutandis* to other documents and correspondence relating to international applications, provided that, where a national Office or intergovernmental organization has made a notification under Rule 89bis.1(d-ter), any such documents or correspondence filed on paper and not resubmitted by electronic means within two months from the date of a corresponding invitation shall be disregarded.

[NOTE: This paragraph would act on the amended Rule 89bis.1 to extend the possibility of excluding paper or requiring resubmission in electronic form to subsequently-filed documents. It would be possible to go step-by-step and notify the International Bureau that paper was no longer accepted for filing and for subsequently-filed documents from different dates, provided that the relevant IT systems used by the Office allowed for this.]

89bis.3 *Communication between Offices*

[No change] Where the Treaty, these Regulations or the Administrative Instructions provide for the communication, notification or transmittal (“communication”) of an international application, notification, communication, correspondence or other document by one national Office or intergovernmental organization to another, such communication may, where so agreed by both the sender and the receiver, be effected in electronic form or by electronic means.

[Annex II follows]

PROPOSED MODIFICATIONS TO THE ADMINISTRATIVE INSTRUCTIONS
UNDER THE PCT

Section 703

Filing Requirements; Basic Common Standard

(a) to (d) [No change]

(e) [No change] Any receiving Office may refuse to receive an international application submitted to it in electronic form if the application does not comply with paragraph (b), or may decide to receive the application.

(e-bis) Any receiving Office that has made a notification in accordance with Rule 89bis.1(d-bis) may refuse to receive an international application submitted to it on paper, or may decide to receive the application.

(f) [No change]

[End of Annex II and of document]