



Basic Principles of the Common Application Format

Prepared by the Trilateral Offices

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Prepared by the Technical Working Group on Formal Aspects of Patent Applications

I. Background

At the November 2005 Trilateral Pre-Conference, the Trilateral Offices established a Technical Working Group on the Formal Aspects of Patent Applications in response to a request made by the Industry Trilateral that the Trilateral Offices begin working on the standardization of formal aspects of patent applications.

The Trilateral Offices have come to an understanding with respect to a common format for patent applications in response to the request from users, after having intensive discussions at six Working Group meetings from 2006 to 2007.

The Common Application Format developed by this Trilateral Working Group with the participation of the World Intellectual Property Organization is in support of a Trilateral goal of a global standardized application format which would allow applicants to prepare a single application that could be accepted by each participating office without the need for further changes to comply with formal requirements.

The project furthers the principle of the Patent Law Treaty using PCT standards when applicable. It takes into consideration the preparations for the implementation of the PLT and the further adoption of XML processing.

II. Mandate for the Technical Working Group on the Formal Aspects of Patent Applications (Annex 1 of the Report of the 23rd Trilateral Pre-Conference and as amended at the 24th Trilateral Pre-Conference, further amended at the Strategic Working Group in September 2007)

The Technical Working Group shall formulate recommendations for addressing the following issues:

1. Standardization of patent applications, with a view to maximizing compatibility with the requirements of the PLT, PCT, and Trilateral Offices;
2. Standardization of the patent application format, taking into consideration the promotion of electronic filing and processing; such that an application drafted in conformance with the common application format will be acceptable in any of the Trilateral offices without further modification.

It is the understanding of the Technical Working Group that the results of this project will be provided to the XML Technical Working Group for consideration of amendments to WIPO Standard ST.36.

In formulating these recommendations, the Technical Working Group should work on them concurrently and attempt to identify issues that can be dealt with rapidly at a practical level, drawing on current practices and formats and taking into consideration the potential impact on the offices and the viewpoints of the relevant stakeholders.

The Technical Working Group shall be comprised of representatives from each of the Trilateral Offices and the WIPO.

III. Basic Principles

1. The objective of the Common Application Format is to provide a basis for filing applications that is beneficial to both applicants and participating offices.
2. Although the use of the Common Application Format by applicants is optional, any filing claiming to be in the Common Application Format must implement all of the requirements.
3. The Common Application Format will be based on the best practices applied to the existing PCT format and is aimed at addressing remaining differences in national/regional law and practices.
4. The Common Application Format will be applicable eventually to all forms of patent submissions and it is a long term goal of the Trilateral Offices to accept applications in text-based XML.
5. The Common Application Format will ensure that applications will meet the formal requirements of the Trilateral Offices.
6. The Common Application Format will be progressively applied to each kind of application filed with each office.
7. Comments from Industry Trilateral are taken into account in the Common Application Format.
8. An application which complies with the Common Application Format shall be accepted without any further amendment by any of the Trilateral Offices as a national/regional application as far as the agreed-upon formal requirements are concerned. Each of the Trilateral Offices may provide requirements which are more favorable for applicants than the requirements provided for by the Common Application Format.
9. After some experience, the Trilateral Offices will consider whether it is necessary to amend the PCT.

IV. The Common Application Format

The Common Application Format is described in **Annex I**.

The comparative table of examples for each type of the applications is shown in **Annex II**.

1. Permissibility of Delimiter

An application filed on paper or in PDF format tagged with a specific delimiter (for example, “Sumitsuki” bracket “【】” or curly bracket “{}”) for the headings including section titles, paragraph numbers, and signs of numbering as defined in Annex I (e.g., “Fig. 1”, “Table 1”) shall be accepted by all the Trilateral Offices.

2. XML e-filing

Electronically filed applications with XML tags are accommodated in the Common Application Format. That is to say, WIPO Standard ST.36 & Annex F to the PCT Administrative Instructions shall be updated to correspond to Common Application Format headings.

V. Pilot Project

The user group participants of the 4th Working Group and the Trilateral Offices implemented the pilot project from April to August 2007, according to the steps described in Annex II and III to the report of the 4th session of the Working Group.

In the pilot project, the user group participants prepared hypothetical applications in the Common Application Format. The Trilateral Offices confirmed whether the submitted hypothetical applications complied with all the requirements of the agreed-upon Common Application Format and whether they are acceptable to each of the Trilateral Offices. As a result of the pilot project, the main indication among those submitted by the user group participants and the Trilateral Offices is as follows:

Common Issues

- Placement of section titles, paragraph numbers and claim numbers, etc.
- Use of bold, italics and underlining in the application, especially in section titles
- Insertion of "the" into section titles, e.g., "Title of the Invention"

Issues for Tagging

- Benefit of tagging to Non-XML applications as compared to the costs incurred
- Difficulty for an XML converter to automatically distinguish the curly brackets used in the pilot project as “tags” from the curly brackets used in mathematical expressions or the like
- Need to develop tools to make tagging and translation easy and accurate

Evaluation by the Trilateral Offices

The Evaluation of the pilot project by the Trilateral Offices is as follows:

EPO

From a legal point of view, the requirements for a European patent application as laid down in the EPC are fulfilled for all applications submitted by the JPO and the USPTO.

The differences in the presentation of applications are of minor technical importance for the EPO. A change of the headings or adding new headings to PatXML would not cause the EPO problems.

JPO

The JPO was informed from the JP users that the standardization of the application format is useful because there was no need for rewording of the content of the description caused by the change of section title order.

Furthermore, the JPO found that tagging is highly beneficial for both Trilateral users and offices. For example, a total of 300 CHF is reduced when an applicant submits an XML application using PCT-SAFE. Likewise, data entry fee for paper application is not required for XML application in the JPO. For the TOs, the benefit of XML application is significant. The each office has to input the data into its database for later use such as the gazette publication. In the JPO, where around 98% of applications are submitted in the form of XML, the time and cost for publishing gazette is minimal.

As a result of this pilot project, the JPO concluded that the CAF will reduce the burden of applicants. The JPO also recognized that tagging is useful not only for XML converter but also for application by paper or PDF because:

- (i) In the case of paper filing, it is easy to make the format for an XML converter by OCR.
- (ii) In general, applicants prepare electronic application documents using wide-spread word processing software, even if the application is submitted to the Office in which only paper applications are acceptable. If the document is tagged with the specific delimiters, the applicant can easily submit the application to other Offices to which XML applications are acceptable, as well as PCT e-filing.

USPTO

The USPTO confirmed that a patent application prepared in conformance with the Common Application Format will be accepted by the USPTO. US users reasserted their desire that the Trilateral Offices' work to ensure that an application which is prepared in compliance with the Common Application Format will not be subject to requests from the Trilateral Office examiners to make further corrections with regard to formal aspects of the application during the examination process.

US applicants also reasserted their desire for standardization among the Trilateral Offices with regard to the five substantive legal issues that were identified at the Trilateral Working Group meeting that was held from 27 February to 01 March 2007. Specifically, the US users have requested standardization among the Trilateral Offices with respect to 1) prior art citations, 2) legends, 3) conforming specifications to cite prior art, 4) conforming specifications to the claims, and 5) use of reference numbers in the abstract and claims.

The Common Application Format Working Group has made progress with regard to items 1) and 2) as indicated under the headings entitled "National Legends and Designations – Cross References to Related Applications and Federal Funding" and "Citation of Prior Art in the

Application” in the Common Application Format. In addition, the US users also questioned the value of tagging to US applicants compared to the costs incurred.

VI. Relation of the Common Application Format to the PLT and PCT

The Common Application Format rationalizes divergent filing requirements applied in each of the Trilateral Offices. Noting that the Patent Law Treaty (PLT) has not yet come into force for any of the Trilateral Offices, some elements of the Common Application Format harmonize diverging filing requirements for national/regional applications filed in each of the Trilateral Offices by referring to the corresponding PCT provisions, which would apply prior to the PLT coming into effect for all of the Trilateral Offices. Other elements of the Common Application Format address issues not regulated by the PCT for which the offices have different practices. Still other elements pertain to issues that go beyond the PCT but, in terms of future development, represent what the offices consider to be appropriate means for addressing those issues.

A. PCT and PLT

The PLT requires that offices of Contracting Parties shall not require compliance with any requirement relating to the form or contents of an application different from or additional to the requirements relating to form or contents which are provided for in respect of international applications under the PCT. Because the PLT has not yet come into effect for any of the Trilateral Offices, however, there remain at present a number of diverging filing requirements for national/regional applications filed in each of the Trilateral Offices. The Common Application Format (items b), d), g) and (i)) would allow for the harmonization of these national filing requirements prior to the PLT coming into effect for all of the Trilateral Offices.

B. Elements Not Regulated by the PCT or PLT

Other elements of the Common Application Format (items a) and c)) are not regulated by the PCT, nor, by extension, the PLT. By identifying an approach acceptable to each of the Trilateral Offices, the Common Application Format provides an important benefit in terms of the amount of additional work an applicant may have to undertake to prepare an application for filing in each of the Offices. This approach is also considered by the Offices to be a best practice acceptable for introduction into the PCT at an appropriate stage, in an effort to further develop the PCT for the benefit of offices and users.

C. Other Elements

A number of elements of the Common Application Format (items e), f), h), j), k) and l)) go beyond what the PCT requires (and therefore the PLT), but represent what the Offices consider to be an ideal practice for future development of applications filed in electronic form using XML conversion software. In this regard, the Common Application Format is a significant contribution to the further development of electronic filing systems and end-to-end electronic processing of applications, which will have important benefits for both offices and users.

VII. Benefits of the Common Application Format

The Common Application Format can be implemented immediately in any filing format. This simplification of the application filing requirements in each office means an applicant wishing to file an application in each office need only prepare a single application in the Common Application Format, and it will be accepted by each office without the need for amendments (except for amendments made in response to substantive objections/rejections that may be required by national/regional law after filing). The need to prepare only a single application will result in a considerable cost savings to applicants.

With respect to future developments, the offices recognize that XML-based application filing provides a number of important advantages for applicants and offices. Thus, even though not all of the Trilateral offices are currently in a position to implement XML, the Common Application Format will provide the basis for such implementation. When implemented, XML will allow end-to-end electronic processing of applications and allow the offices to capture and share application data, which will help improve search and examination efforts across the offices.

VIII. Future Work

With the work on the basic format completed, the project is being turned over to the Trilateral Technical Working Group to decide on appropriate implementation steps for electronic processing as it relates primarily to the XML-related provisions of the Common Application Format. It is envisaged that the Technical Working Group will recommend revisions to either WIPO Standard ST.36 (relating to XML) or Annex F to the PCT Administrative Instructions (relating to electronic processing of PCT and, via the PLT, national/regional applications), or both, in order to provide a firm foundation for expanding the Trilateral efforts on this project.