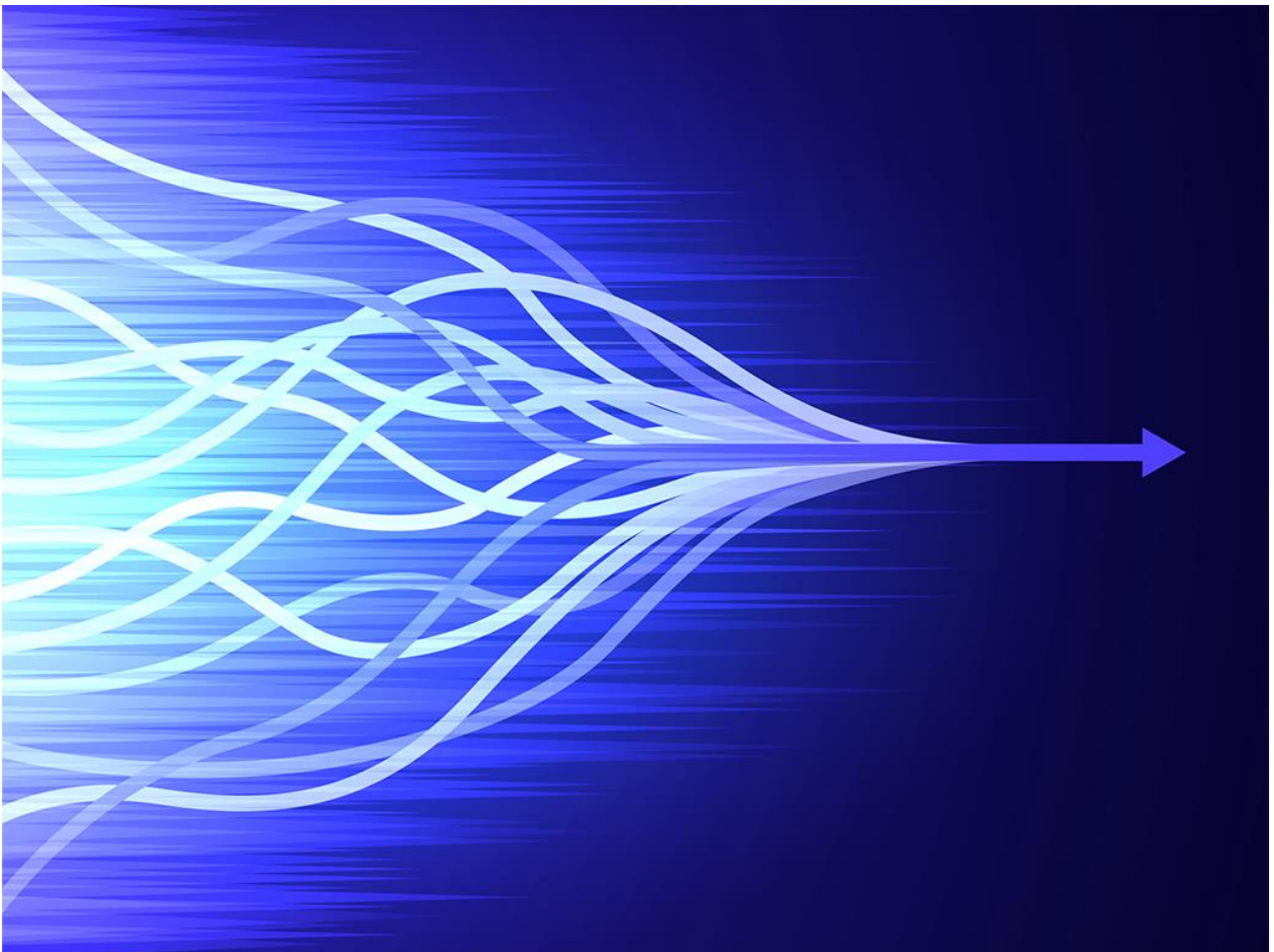# Convergence of practice

Common practice as regards issuing and accepting electronic priority documents

March 2024

Common practice as regards issuing and accepting electronic priority documents

In view of the evolving landscape of electronic document management, and particularly the increasingly widespread use of electronic means for the provision, storage, dissemination and exchange of documents related to patent procedures by both offices and applicants;

In view of the advantages for offices and applicants of being able to issue, obtain, submit and accept priority documents in electronic form;

Considering that a priority document should be a complete copy of the application (description, drawings, etc.) previously filed, where the copy should be certified as correct by the authority which received that application;

Considering that offices should decide what checks they want to conduct when receiving an electronic priority document;

Noting that any common practice will be implemented on a voluntary basis;

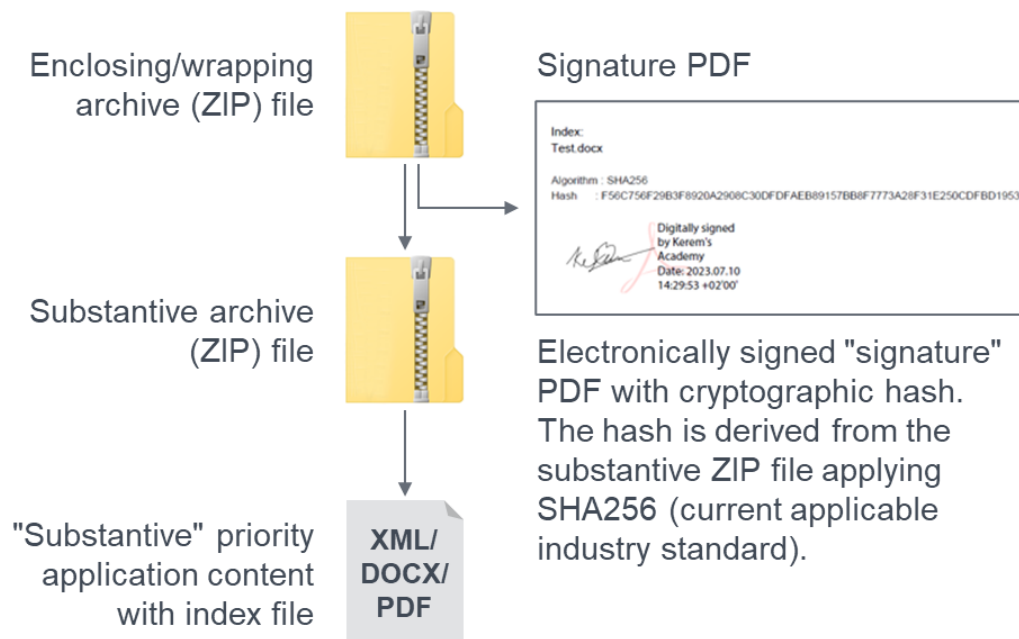Having regard to the opinion of the Committee on Patent Law;

The Administrative Council of the European Patent Organisation at its meeting on 20 March 2024 approved the following common practice as regards allowable features in drawings:

Issuing and accepting electronic priority documents

- Offices should ensure access to electronic priority documents via digital libraries, and particularly via the WIPO Digital Access Service (DAS), in line with the requirements of these services. Further, they should issue electronic priority documents to applicants as specified below and accept priority documents issued in this way. Offices should continue to offer the option to have priority documents issued on paper in cases where legally required.

Structure and format of electronic priority documents issued to applicants

- Electronic priority documents issued to applicants should consist of a "wrapping" archive (ZIP) file that contains:

a)   a "substantive" archive (ZIP) file with the substantive content of the priority

b)   a "signature" PDF file that is electronically signed and that contains a cryptographic hash of the "substantive" ZIP file together with an indication of the algorithm used, thereby certifying the integrity of the "substantive" ZIP file's content and structure. In addition, in this PDF the office may add text that certifies the copy and the filing date as correct, as well as other information needed for it to be considered the front page.

- The files making up the electronic priority document should be compliant with existing WIPO standards where applicable, in particular Annex F to the Administrative Instructions under the PCT. This includes WIPO ST.36, and ST.26 or ST.25 if there is a sequence listing.

Enclosing/wrapping archive (ZIP) file

Signature PDF

Index:
Test.docx

Algorithm : SHA256
Hash   : F56C756F29B3F8920A2908C30DFDFAEB89157BB8F7773A28F31E250CDFBD1953

Digitally signed
by Kerem's
Academy
Date: 2023.07.10
14:29:53 +02'00'

Substantive archive (ZIP) file

Electronically signed "signature" PDF with cryptographic hash. The hash is derived from the substantive ZIP file applying SHA256 (current applicable industry standard).

"Substantive" priority application content with index file

XML/ DOCX/ PDF

- The "substantive" ZIP file should contain a "substantive" PDF version of the priority application together with the application documents in the format originally filed, which could include DOCX or XML. Sequence listings are to be included in the originally filed format (ST.25 text, ST.25 PDF or ST.26 XML).

- Offices are encouraged to include in the "substantive" ZIP file complementary XML files provided by the office and containing structured data, such as the texts included in the PDF. Offices not providing an XML file containing the PDF content are encouraged to include readable structured data in the PDF version of the priority document.

- For the sake of clarity, offices should include in the "substantive" ZIP file an index file that provides a description of all the content. The index file should indicate for each item whether it is the document in the data format as originally filed or as subsequently provided by the office.

- If licensed fonts are used in the PDF, these fonts should be embedded into it.

- PDF and DOCX documents should be page-based in an A4 format suitable for printing. XML files are not page-based and may be rendered using the corresponding national or WIPO style sheets as a printable, page-based A4 format.

- The archive file should be created using the ZIP standard. ZIP is a de facto industry standard for archive file formats and is in line with Annex F to the Administrative Instructions under the PCT (see explanatory remarks). The software used to create the ZIP file must conform to the ZIP file format specification as published in the PKWARE® PKZIP® Application Note (Revised: 01.08.1998).

- The cryptographic hash should be generated using a cryptographic hash function which is a widely adopted, de facto industry standard hash algorithm. At present this is SHA-256.

- The above recommendation should be interpreted in line with, or adapted to, the evolving standards developed by the Committee on WIPO Standards (CWS) (see explanatory remarks), as well as de facto industry standards for archive files and cryptographic hash algorithms.

Use of certificate and source of trust when issuing electronic priority documents

- For electronic signature of priority documents, offices should use qualified certificates for electronic signature within the meaning of Article 3(15) and Annex I to the eIDAS Regulation (EU) 910/2014. Trust service providers should be established in the European Union or in a third country under the condition that the provider is recognised as legally equivalent (Article 14 eIDAS Regulation (EU) 910/2014). Unless restricted by national law, the trust service provider should appear on the European Union's trusted lists and preferably on the Adobe Approved Trust List (AATL) too.

Signature of electronic priority document

- Offices should embed the electronic signature produced with the qualified certificate in the "signature" PDF document included in the "wrapping" archive (ZIP) file.

- The electronic signature should be visible on the "signature" PDF document for printing.

- The machine-readable electronic meta data of the signature should also be embedded in the "signature" PDF document and accessible for validation by standard electronic signature validation tools.

Transfer of the issued electronic priority documents

- Offices should transfer electronic priority documents to users via a secure means of transmittal which ensures access is given only to entitled parties to proceedings.

Sharing technical specifications

- To facilitate validations at the office of second filing, offices are encouraged to share with other offices their technical specifications for issuing electronic priority documents. This is without prejudice to their ownership of intellectual property related to the information technology systems they have created.

Additional format of electronic priority documents

- Offices should not impose size limitations when accepting electronic priority documents, or should otherwise offer alternative options for receiving electronic priority documents that exceed their standard size limitations. Further, offices should strive for the availability of colour in electronic priority documents.

Validity of certified electronic priority documents

- Offices should consider certified electronic priority documents to be indefinitely valid. The qualified certificate provides certainty that the certificate applied to the document was valid at the time of signing.

1.   Introduction

The convergence of practice programme is a key initiative of the Strategic Plan 2023 (CA/65/19). After a first successful cycle of the programme, the Administrative Council approved its continuation and the launch of a second cycle with six new topics for discussion (CA/73/22 Rev. 1). It was also decided that WIPO would be invited to attend the meetings of the working groups as an additional observer.

As a first pair of topics (2023/2024) for the new cycle, the Administrative Council decided to roll out the topics "Allowable features in drawings" (WG7) and "Issuing and accepting electronic priority documents" (WG8). A call for interest was issued in December 2022, whereupon 29 EPC contracting states and 1 extension state indicated their interest in participating in the discussions of working group 8. BusinessEurope, epi and WIPO nominated one representative as an observer in the discussions of this working group.

The composition of this working group was thus as follows: Austria, Bosnia and Herzegovina, Bulgaria, Croatia, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Lithuania, Monaco, Montenegro, Netherlands, Norway, Poland, Portugal, San Marino, Serbia, Slovakia, Spain, Sweden, Turkey, the United Kingdom, epi, BusinessEurope, WIPO and the EPO (Chair).

According to the established practice within the previous working groups, the EPO established a detailed questionnaire in order to determine the existing practices in Europe on issuing and accepting electronic priority documents. The answers provided by the participants served as a basis for the discussions within the working group aiming at establishing a common practice in this field.

The discussions took place during five virtual meetings (19 April 2023, 26 May 2023, 5 July 2023, 27 September 2023, 23 November 2023), at which the working group identified eight areas where a convergence of practice was considered to particularly benefit both users and patent offices.

Users were consulted and updated on the progress of the work via the SACEPO Working Party on Rules on 16 March 2023 and 26 October 2023. In order to further broaden the scope of the consultation process, on 31 October 2023 the EPO organised the fourth virtual platform on convergence of practice and informed users and offices of the results achieved within working groups 7 and 8 up to then.

At its fifth meeting on 23 November 2023, the working group agreed to recommend to the Administrative Council the enclosed common practice as regards issuing and accepting electronic priority documents for adoption and any subsequent voluntary implementation (see Annex 1). The working group also agreed upon explanatory remarks to the nine different areas contained in this recommendation for a common practice, which are set out below. In addition, the working group recommends that the EPO may resume the discussions in the working group for adaptation of the recommended common practice if needed in view of evolving standards developed by the Committee on WIPO Standards (CWS).

2.   Explanatory remarks

2.1   Issuing and accepting electronic priority documents

Electronic priority documents are either exchanged between offices via the WIPO Digital Access Service (DAS) or issued directly to applicants. As regards participation in WIPO DAS, the majority of offices replied that they are either already participating in it or planning to do so.

At the time of receipt of responses to the questionnaire, only nine offices were already issuing electronic priority documents and seven offices were planning to do so. However, 21 offices were already accepting electronic priority documents.

On the basis of the approved common practice as regards the accordance of a date of priority, in line with the aforementioned questionnaire responses and considering the growing use of electronic means for the provision, storage, dissemination and exchange of priority documents, the working group recommends that offices ensure access to electronic priority documents via digital libraries, and particularly the WIPO DAS, which is recognised as trusted by many offices. Furthermore, it is recommended that offices issue electronic priority documents to applicants and accept those filed by applicants as it is particularly advantageous for users to be able to obtain and submit priority documents in electronic form.

Nevertheless, for cases where paper priority documents are still required, offices should continue to offer this option.

2.2   Structure and format of electronic priority documents issued to applicants

The results of the questionnaire showed that almost all offices prefer PDF and an A4 printable format but agreed that for sequence listings the originally filed ST.26 XML format should be made available as well. The recommended structure and format are also the result of both the technical analysis and discussions in the working group and consideration of the discussions taking place in parallel on the CWS Digital Transformation task force.

The structure parts described in a) and b) of the common practice on the structure and format of electronic priority documents issued to applicants are seen as the minimum content of the electronic priority document. The minimum content for part a) "substantive" archive (ZIP) file is a PDF version of the application as filed.

A cryptographic hash derived from a file is unique and changes as soon as anything is modified in that file. Therefore, in part b) both the cryptographic hash of the "substantive" ZIP file and an indication of the algorithm used are displayed in the "signature" PDF file at the very least, to ensure the integrity and non-modification of the electronic priority document contained in the "substantive" ZIP file. Applying an advanced or qualified electronic signature or a seal using a qualified certificate to the "signature" PDF certifies the integrity of that PDF. The "signature" PDF may also be used by offices as the front page of the priority document to certify the copy and the filing date as correct. In addition, offices may add a list of what is included in the "substantive" ZIP file to this front page.

The recommended structure and format may be used both by offices which offer electronic priority documents only in PDF format and by offices which offer various filing formats and are interested in additionally providing these formats in the electronic priority document to the applicant. The recommended structure and format allow applicants to be provided with DOCX, ST.36 or ST.96 representations if available, as well as ST.26 XML sequence listings for priority documents containing sequence listings.

WIPO standard for archive file formats:

- Paragraph 4.1.1 of Annex F to the PCT Administrative Instructions prescribes ZIP as the standard for packaging application documents.

- The software used to create the ZIP file must conform to the ZIP file format specification as published in the PKWARE® PKZIP® Application Note (Revised: 01.08.1998). All ZIP files must have a flat directory structure.

- The ZIP standard allows the compression software to select from among a number of compression algorithms. The compression method must be "deflation" with the normal compression option.

Evolving WIPO standards:

- One example of an evolving WIPO standard is the new standard currently being developed by the CWS Digital Transformation task force led by the USPTO, for the exchange of electronic priority documents between offices.

2.3 Use of certificate and source of trust when issuing electronic priority documents

The results of the questionnaire showed that for around two-thirds of offices the source of trust for the qualified certificates used for electronic signatures either is already obtained from the European Union's trusted list or will be in the future. The discussions within the working group highlighted the advantages of the trust service provider featuring on the European Union's trusted lists (https://eidas.ec.europa.eu/efda/tl-browser/#/screen/home) but preferably also on the Adobe Approved Trust List (AATL) (https://helpx.adobe.com/acrobat/kb/approved-trust-list1.html). Nevertheless, the working group acknowledged that there may still be restrictions imposed by national law.

2.4 Signature of electronic priority document

An electronic signature is an electronic indication of a person's intention to agree to the content of a document or set of data to which the signature relates. However, offices are given the option of using an advanced or qualified electronic signature using a qualified certificate when signing as a natural person, or an advanced or qualified electronic seal using a qualified certificate where the creator of that seal is a legal person (Annex III to the eIDAS Regulation (EU) 910/2014). Both electronic signature and electronic seal certify the integrity of the "signature" PDF.

The results of the questionnaire showed that the majority of offices either already issue electronic priority documents with an embedded electronic signature or believe that the electronic signature should be embedded in the priority document. Further, the majority of offices indicated that the electronic signature is or should be visible as meta data and reflected on the front page of the electronic priority document. The working group took these responses and the recommended structure and format into consideration for the recommendation regarding the signature.

The signature is particularly important for accepting offices when they check received electronic priority documents. Several offices stated in reply to the questionnaire that they check either the electronic signature itself or the validity of the signature.

In addition, the visibility of the signature for printing is important for third parties in cases where the office makes only image files of the received electronic priority document available to the public.

2.5   Transfer of the issued electronic priority documents

The results of the questionnaire showed that offices use or intend to use a large variety of means of transmittal. However, the majority of offices use or intend to use a secure means of transmittal. Examples of means of transmittal that are considered secure include secure online portals, certified/secure email, government mailbox, etc.

2.6   Sharing technical specifications

In the questionnaire the sharing of technical specifications was proposed if harmonisation could not be achieved. However, it was agreed in the working group that an exchange is of high value anyway, especially so that accepting offices can check and validate electronic priority documents received from applicants. For example, the type of signature and the type of electronic certificate used as well as the technical solution chosen for validating the signature should also be shared.

2.7   Additional format of electronic priority documents

Priority documents should be a complete copy of the application as filed, so offices should offer alternative options for applicants submitting electronic priority documents that exceed their standard size limitations. Application documents may also contain colour. Looking to the future, the working group agreed on a recommendation to strive to make colour available in electronic priority documents.

2.8   Validity of certified electronic priority documents

The use of a qualified certificate for signing the electronic priority document (i.e. the "signature" PDF) provides certainty that the certificate was valid at the time of signing. This is important for offices receiving such electronic priority documents when they are checking the signature. Recipients of the electronic priority document may wish to validate the signature of electronic documents, even if the qualified certificate has been revoked or has expired at the time of validation.

There may be different ways to support this, for example by enabling a Long Term Validation (LTV) signature, using a Time Stamp Authority service or other technical solutions. The recommendation leaves the implementation choice open.