

WIPO



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COOPERATION UNDER THE AGREED STATEMENTS BY THE DIPLOMATIC CONFERENCE REGARDING THE PATENT LAW TREATY (PLT)

Document prepared by the Secretariat

I. INTRODUCTION

1. Item 4 of the Agreed Statements by the Diplomatic Conference for the Adoption of the PLT (Agreed Statements), adopted on June 1, 2000, states as follows:

“4. With a view to facilitating the implementation of Rule 8(1)(a) of this Treaty, the Diplomatic Conference requests the General Assembly of the World Intellectual Property Organization (WIPO) and the Contracting Parties to provide the developing and least developed countries and countries in transition with additional technical assistance to meet their obligations under this Treaty, even before the entry into force of the Treaty.

“The Diplomatic Conference further urges industrialized market economy countries to provide, on request and on mutually agreed terms and conditions, technical and financial cooperation in favor of developing and least developed countries and countries in transition.

“The Diplomatic Conference requests the WIPO General Assembly, once the Treaty has entered into force, to monitor and evaluate the progress of that cooperation every ordinary session.”

2. In accordance with the third paragraph of item (4) of the Agreed Statements, the General Assembly of WIPO is requested to monitor and evaluate the progress of technical and financial cooperation in favor of developing and least developed countries and countries in transition, which facilitates filing of communications in electronic form in those countries. Against this backdrop, industrialized market economy countries referred to in item 4 of the Agreed Statements above, are invited to provide information to the General Assembly as set out in that Agreed Statement.

II. ACTIVITIES OF WIPO

3. With respect to the relevant activities of WIPO, when adopting Rule 8 of the Regulations under the PLT at the Diplomatic Conference for the Adoption of the PLT, the Director General of WIPO stated that WIPO would remain committed to its technical cooperation program, and that it would further translate the content of Rule 8 into a meaningful capacity building for developing countries and countries in transition.¹

4. In addition, the recommendations of the WIPO Development Agenda refer to development and improvement of infrastructure and other facilities, including those relating to information and communication technologies (ICT). In particular, the following recommendations appear to be relevant in this context:

“10. To assist Member States to develop and improve national intellectual property institutional capacity through further development of infrastructure and other facilities with a view to making national intellectual property institutions more efficient and promote fair balance between intellectual property protection and the public interest. This technical assistance should also be extended to sub-regional and regional organizations dealing with intellectual property.”

“24. To request WIPO, within its mandate, to expand the scope of its activities aimed at bridging the digital divide, in accordance with the outcomes of the World Summit on the Information Society (WSIS) also taking into account the significance of the Digital Solidarity Fund (DSF).”

5. Specifically, between the previous ordinary session of the General Assembly of WIPO in 2007 and the beginning of June 2009, the following developments and solutions developed in the context of the Patent Cooperation Treaty (PCT) should be noted given the strong relationship between the PCT and the PLT. Since these activities have already been adopted in the framework of the PCT, they may have medium and long-term potential for application in the PLT context.

6. In the past two years, one more PCT receiving Office (RO), namely the Canadian Intellectual Property Office, started electronic filing under the PCT. This brings the total number of ROs that are accepting fully electronic filing under the PCT to twenty-one. With the exception of France, all of these ROs accept filings using the PCT-SAFE system. In the

¹ See paragraphs 2556 and 2563 of the Summary Minutes of the Main Committee I contained in the Records of the Diplomatic Conference for the Adoption of the Patent Law Treaty (WIPO publication No. 327).

case of on-line filing, this is done either directly from filer to Office using PCT-SAFE or in combination with the national on-line patent filing system (in Australia, Canada, the Republic of Korea and the United States of America). The Offices of the following developing and countries in transition (by order of entry into effect of e-filing) accept fully electronic PCT filings using PCT-SAFE: China, Malaysia, the Philippines, Poland, Romania and Slovakia.

7. Further, updated versions of the PCT-SAFE software and patches have been released in a timely manner in order to support the ongoing evolution of the legal and procedural framework of the PCT, such as various PCT Rule changes, and Korean and Portuguese language interface and processing capabilities.

8. In addition to providing updated PCT-SAFE client software to PCT filers, WIPO offers assistance to receiving Offices during the preparations for e-filing and also when e-filing has entered into effect. This includes technical assistance (e.g., providing test builds of the PCT-SAFE client software to the RO in order to test the end-to-end filing process, assistance with the installation of digital certificates on the receiving Office server, issuance of the digital certificate required by the RO to sign the record copy package before transmittal to the IB, as well as legal and procedural assistance. In addition, WIPO Certification Authorities (CA) that distribute and manage digital certificates have continued to operate. One CA is used by applicants, and another by offices to digitally sign and transmit patent data.

9. From June 2007 to June 2009, a number of enhancements were made to the PCT-ROAD (Receiving Office Administration) system, in cooperation with the Korean Intellectual Property Office (KIPO). PCT-ROAD is a simple software that can be used to support PCT receiving Office functions including permitting electronic filing on physical media. The enhancements made in the past twenty-four months include increased data output quality (enabling more automated processes between RO and the International Bureau), various functional and user interface improvements (including modifications to cover PCT rule changes and various enhancements to cover RO change requests), improved system performance, and finally a post implementation training and review workshop was conducted in Daejeon, the Republic of Korea, in February 2009.

10. WIPO has introduced or deployed the PCT-ROAD system to seventeen developing countries since September 2005. The PCT-ROAD software and user manuals are freely available to PCT receiving Offices for download from WIPO's website.²

11. Additionally, in April 2009, WIPO introduced the PATENTSCOPE[®] Priority Document Access Service. It is a new service based on its own Framework Provisions as established on March 31, 2009. It uses existing PCT infrastructure, and any PCT Contracting State can participate in the service.³ The Priority Document Access Service allows applicants to meet priority document requirements of Offices of second filing without having to physically obtain and submit certified copies with each of them. Currently, the Japan Patent Office, the United States Patent and Trademark Office and the IB (as a PCT receiving Office) participate. In most cases, document exchanges under the service are by electronic means, but the IB has committed to carrying out the scanning and/or printing functions for offices that do not have

² <http://www.wipo.int/pct-safe/en/pctroad/>

³ The PATENTSCOPE[®] Priority Document Access Service is available to a State that is party to the Paris Convention or is a member of WIPO, or an intergovernmental organization at least one of whose member States is party to the Paris Convention or a member of WIPO.

the capacity to process priority documents in electronic format. For example, the system allows offices or applicants from developing countries to furnish a priority document on paper. The IB would scan the priority document and distribute it to the Office(s) of Second Filing nominated by the applicant.

12. Finally, the IB has developed a system for the electronic filing of general correspondence after the initial filing of the application itself. In June 2009, a pilot of the system has been made available to a limited group of applicants and the service will be refined under the pilot before being made available for broader use.

13. With respect to the activities of WIPO beyond the PCT, the WIPO program for “IP Office Modernization” provides assistance to industrial property (IP) offices in developing countries, least developed countries and countries in transition to enhance the efficiency of IP registration activities and improve services provided by IP institutions to their stakeholders, through the use of modern tools, systems and best practices.

14. WIPO’s modernization assistance is based on a holistic approach and leverages on the collective knowledge and experience acquired over the last several years of implementing automation projects in IP institutions across all regions and with diverse profiles. The modernization services offered include technical consultancy, needs assessment, streamlining of workflow procedures, customized automation systems for IP administration, establishment of IP databases, training and knowledge transfer, technical support, system enhancements and post-implementation evaluation. In providing this assistance, WIPO uses the Industrial Property Automation System (IPAS) which it had developed over the years. It is a workflow-based system offering comprehensive and customized IP administration functionality, from application reception to grant as well as post-grant actions like annuities, assignment, amendments, etc. It also generates the necessary notifications, certificates, official publications, etc. from customized templates as part of the workflow actions. As one of the components of the global IP infrastructure, IPAS complies with the relevant WIPO Standards, includes data exchange capability (e.g. ST.36) and has built-in International Classifications (i.e. International Patent Classification (IPC)), Nice, Vienna and Locarno classifications). It has been improved on an ongoing basis with new functionality and value added services based on feedback from IP institutions.

15. To date, WIPO provided automation assistance to 53 IP offices, of which 27 are patent offices. The WIPO assistance enables them to participate in the global IP infrastructure and to maximize their benefits from the access, exchange and use of its collective resources.

16. The General Assembly of WIPO is invited to note the information contained in the present document.

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