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TERMS OF REFERENCE FOR A STUDY PAPER REGARDING RECOMMENDATION 8

prepared by the Secretariat

1. At the first session of the Committee on Development and Intellectual Property (CDIP), held from March 3 to 7, 2008, Member States discussed possible activities for the implementation of adopted recommendation 8/26 and requested the Secretariat to prepare a draft paper as proposed in document CDIP/1/3. The said recommendation is reproduced below:

“Request WIPO to develop agreements with research institutions and with private enterprises with a view to facilitating the national offices of developing countries, especially LDCs as well as their regional and sub-regional organizations to access specialized databases for the purposes of patent searches.”

2. The CDIP also agreed that the paper would address other concerns raised by Member States, including the possibility of developing model contracts, making the WIPO databases available through a popular Internet portal, organizing a forum with database owners, enhancing PATENTSCOPE[®] to include further information on PCT applications in the national phase and also assess the human and financial resource requirements of different options for access to public and private specialized patent databases by IP offices taking care to avoid copyright infringements. The guiding principles in the development agenda would be recognized. The terms of reference for the paper would be presented by the Secretariat in the July session of the CDIP.

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3. Accordingly, the Secretariat has prepared the terms of reference, which are annexed. The terms of reference of the paper focus on the following issues:

- (a) Needs analysis for each country;
- (b) Review of specialized patent databases;
- (c) Review of specialized non-patent literature (NPL) databases;
- (d) Comparison analysis between the added value of commercial databases with respect to free-of-charge databases;
- (e) Possible issues and recommendations to be developed by the study paper; and
- (f) Necessary resources: human and financial.

4. *The Committee is invited to take note of the information contained in this document.*

[Annex follows]

ANNEX

TERMS OF REFERENCE FOR A STUDY PAPER REGARDING RECOMMENDATION 8

(a) Needs analysis for each country

In order to comprehensively assess the needs of a particular national patent or intellectual property (IP) office within the context of facilitating access to technical and scientific information, an effective needs analysis should be undertaken to provide the following information:

- National patenting activity (patenting propensity) in respect of relevant economic, financial and demographic statistics, e.g. number of first filings per million population;
- IP Offices' needs with regard to the requirements of the national patent system, in particular whether it provides for a prior art search and substantive examination or whether the system is registration only; and
- Users needs (whether academic, commercial or industrial) in regard to accessing specialized databases directly.

Not only the scope, but the breadth of the needs analysis should be clearly agreed. It is assumed that the needs analysis would be extended to low and middle income countries, including LDCs.

The needs analysis would be drafted with the aid of publicly available national patent statistics and information and complemented by a questionnaire sent to each national IP office.

(b) Review of specialized patent databases

Given the wide range of free-of-charge and commercial specialized database services now available on the Internet, a review of the search functionalities of these services will be made.

In particular, an assessment of costs should be made with regard to commercial database services. Because these costs are not always initially or clearly indicated by commercial service providers, direct enquiries will be made.

(c) Review of specialized non-patent literature (NPL) databases

A similar review as for patent databases should be undertaken for non-patent literature (NPL) databases. The accessibility and retrieval of NPL is rapidly developing, expanding and complementing the existing search possibilities of technical information in general, which until recently could only be searched using classified patent databases. Moreover, in certain technical fields, such as biotechnology, medical technology and computing, NPL provides the most important contribution to the available prior art.

Unlike basic patent documentation, which is made freely available by patent offices around the world, access to basic NPL is not necessarily available free of charge. This worsens the situation of many developing countries as regards accessibility to technical information.

The review will cover NPL open source and commercial publishers, together with related costs in respect of the latter.

(d) Analysis comparing the added value of commercial databases with regard to free-of-charge databases

Since the launch of free-of-charge databases on the Internet approximately a decade ago, these services have developed from offering only the most basic search functionalities, e.g. searching only the publication number, keywords in the title or the patent classification, to relatively sophisticated services. WIPO's search service PATENTSCOPE[®], for example, now provides full-text searches, graphical analysis, RSS notification for monitoring searches, etc. These developments will undoubtedly continue in the future.

Commercial databases clearly offer more powerful value-added functionalities as compared to free-of-charge services. However, given the often high costs of using such services, it is reasonable to investigate the extent of the benefits acquired in comparison to the costs.

It is proposed that a cost-benefit analysis should, therefore, be undertaken, in particular taking into consideration the IP Office needs analysis mentioned in point (a) above.

(e) Possible issues and recommendations to be developed by the study paper

The study paper would identify issues and develop recommendations which WIPO would coordinate and assist in implementing, including:

(i) An indication of which database services could be used by IP Offices as regards:

- Free-of-charge patent and NPL databases; and
- Commercial patent and NPL databases.

(ii) Provision of licenses for commercial databases to developing country national patent offices, including the establishment of criteria to define which national offices are eligible for such assistance.

(iii) Assess the possibility of negotiating model contracts and pricing on the basis of points (a) and (b) above.

(iv) Enhancing PATENTSCOPE[®]: WIPO's search service will continue to be developed, e.g. offering in the near future cross-language searching (the ability to search various language documentation using only one search language), as well as further search and graphical analysis tools; the provision of NPL services on PATENTSCOPE[®] should also be investigated.

The study should indicate how PATENTSCOPE[®] can maximize search and accessibility to patent and NPL information.

(v) WIPO Patent Information Services for Developing Countries (WPIS) have been specially developed by WIPO to directly assist developing countries in regard to their search and examination needs. These services have been offered for many years free of charge as a result of contributions made by industrial property offices throughout the world and by the International Bureau of WIPO.

The following services are provided within the framework of WPIS:

- State-of-the-art search reports for individuals and institutions carried out by donor IP Offices;
- Within the provisions of the International Cooperation for the Search and Examination of Inventions (ICSEI), search and examination is carried out on patent applications filed with IP Offices, e.g. patent applications from the African Regional Industrial Property Organization (ARIPO), which have no priority or for which no search reports have been established;
- Information on equivalent patent documents published in other countries (family patents); and
- Copies of individual patent documents.

The study should assess how WPIS and ICSEI could be further developed and updated so as to be used as an effective and centralized search and examination service for developing countries and others.

(vi) Organization of a database owner forum: Following the review of patent and non-patent literature databases and the analysis comparing free and commercial databases, the possibility of organizing a forum with commercial database owners in order to discuss and negotiate directly any possible preferential rates on a broad scale, should be investigated.

(vii) Analysis of training gaps in using free-of-charge and commercial databases could be undertaken so as to indicate how to target training and allow for the optimum use of specific databases.

(viii) Dissemination of patent information activities: Following the analyses mentioned above, further specifically targeted awareness raising campaigns could be undertaken.

(ix) Association with popular Internet portals: Contacts could be made with Internet portals such as Google to broaden awareness and accessibility of patent and non-patent literature.

(f) Human and Financial Resources

(i) The current terms of reference paper estimates the following human and financial requirements to carry out the analyses outlined above and complete the study paper:

- a consultant to be employed for 500 man-hours (approximately three months) for an estimated cost of CHF40,000; and
- in order to effectively undertake negotiations with the larger commercial database providers on a face-to-face basis, a travel budget of CHF50,000 could be foreseen.

(ii) The study paper will subsequently propose the necessary human and financial resources necessary to carry out the options and scenarios as outlined and agreed by the CDIP. It should be noted that these costs, which will include licensing fees, are likely to be significant.

(iii) The above-mentioned costs to draft the study paper and the eventual approved implementation costs defined by the study paper are not included in the current approved program and budget for 2008/2009.

(g) Conclusion

The study paper will aim to provide an overview of the current situation and future needs of developing countries regarding patent information services, as concisely as possible, through the use of graphs and tables and conclude with clear recommendations to allow WIPO to assist developing countries to meet their specific needs.

The CDIP is requested to provide its comments and suggestions in regard to the current terms of reference for the study paper as proposed.

[End of Annex and of document]