

Committee on WIPO Standards (CWS)

Third Session
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CREATION OF A TASK TO ESTABLISH REQUIREMENTS FOR THE DELIVERY OF LEGAL STATUS INFORMATION BY INDUSTRIAL PROPERTY OFFICES

Document prepared by the Secretariat

1. Patent legal status data are an important component of patent information because they are used to determine, e.g.:
 - whether examination of a patent application is still pending;
 - whether search and examination reports had been issued;
 - whether the application had been amended;
 - whether the application has been withdrawn or was rejected;
 - whether a patent has been granted and is still valid; or
 - whether a granted patent has expired, lapsed or been limited, amended or revoked.
2. As such, they play an essential role, e.g., in technology transfer since they answer the question which technology is still protected and where, or whether it will soon become freely available to the public.
3. Legal status data need to be up-to-date to allow correct conclusions. However, given that the legal status of patents is linked to legal events or actions, the status changes over time and therefore poses particular problems to the availability and reliability of up-to-date information.
4. No WIPO Standard has been developed to cover the format of data concerning patent legal status. As the exchange and dissemination of patent information are undertaken by electronic data transfer from one database to another, it is necessary to develop such a standard to promote efficient digital data exchange between IP Offices and WIPO IB.

5. The IB promotes the goal to narrow the knowledge gap in the world and to develop an enabling infrastructure for promoting technology transfer through effective use of patent information. The IB has therefore launched activities for improving worldwide availability, reliability and comparability of patent legal status data, e.g., to further develop patent legal status databases and widen the participation of countries in data sharing.
6. As a first step in the framework of the Development Agenda project “Intellectual Property and the Public Domain”, a “Study on availability, reliability and comparability of patent legal status data” was prepared and was submitted for consideration at the eighth session of the Committee on Development and Intellectual Property (CDIP) in November 2011.
7. The executive summary of the Study is attached as Annex I to this document. Particular attention is drawn to the current diversity of legal status data deriving from different national jurisdictions and data collected in the INPADOC database, and thus the Study states that the “standardization or use of unified codes that are applicable to describe events in a global manner is highly desirable”(paragraph 11 of the executive summary). As recorded in the report (see paragraphs 137 to 144 of CDIP/8/9), the Study prompted one delegation to give a particular support to “the creation of a database on national patent registers and its linkage to Patentscope”.
8. The issue of availability of high quality legal status information has been considered as of paramount importance by the Patent Documentation Group (PDG). The PDG is a non governmental non-profit international organization based in Europe, consisting of research driven companies which utilize scientific, technical, patent and other intellectual property related information for their business. It has the status of official observer at WIPO and in that capacity participates in several WIPO meetings.
9. The PDG is advocating the importance of legal status data harmonization at various meetings including the WIPO Symposium. At the meeting of the PDG IMPACT Working Group held in September 2012, a proposal has been prepared which collates users’ wishes and requirements (see Annex II to this document). This proposal aims at enhancing the coverage of legal status data and formulating a minimum set of data to be delivered by offices to central repositories such as INPADOC and PATENTSCOPE. It has been presented to the IB for consideration.
10. The IB proposes that, in view of general support from both CDIP and PDG, the CWS should consider the need for developing a new WIPO Standard for patent legal status data.
11. The CWS is invited to consider this proposal and in that respect to consider the creation of a new task to establish a new WIPO standard for the exchange of patent legal status data by industrial property offices. It should be understood that the objective of this task is not to harmonize national laws and regulations concerning patent legal status. It should be international standardization of data and its technical features that should be coordinated and converged. A proposed scope of this task would include a list of legal status data for the purpose of electronic data exchange among IP offices and the IB of WIPO. Such a list could consist of the most important data of patent legal status which IP offices wish to exchange and share with other IP offices. This list could be composed of not only the minimum set of legal status data that IP offices need to exchange, but also an optional set of additional data of legal status that IP offices desire to exchange if such additional data are applicable or technically available. The list may be further elaborated by defining standardized format of such data. The scope of the task and its details outlined above may be left to further discussions by the new task force, if the CWS so agrees.

12. *The CWS is invited to:*

(a) consider and approve the creation of the following new task: "Prepare a proposal to establish a new WIPO standard for the exchange of patent legal status data by industrial property offices", as referred to in paragraph 11, above;

(b) consider and approve the establishment of a new task force to handle the new task; and

(c) designate the International Bureau as task force leader.

[Annexes follow]

EXECUTIVE SUMMARY (CDIP/4/3 REV./STUDY/INF/3)

INTRODUCTION

1. The study (hereinafter referred to as “the Study”) focuses on the technical aspects related to patent legal status information. These aspects mostly fall into the three categories of availability, reliability and comparability of such data.
2. Patent legal status information comprises all data related to legal events or actions as defined by the respective patent law and regulations of a particular jurisdiction. The authority in charge of executing these actions is also usually in charge of informing the public about relevant legal events, such as the grant of a patent, and thereby serves as the authoritative or primary source of such information.
3. Traditionally two major primary sources of legal status data can be distinguished: Patent Gazettes and Patent Registers. Gazettes were and are sometimes still published at regular intervals in paper form, i.e. in individual editions which inform about the latest events changing the legal status of a patent application or a granted patent, e.g. a change in ownership. On the other hand, such status can change from day to day. Registers are, therefore, a kind of facility or service that records such changes and makes available up-to-date and authoritative information in a more frequent manner, ideally on a daily basis.
4. Users of patent information however often refer to secondary sources of legal status information which collect such data from primary sources, process the data and make it searchable. The important advantages of these secondary sources reside in the availability of such data in combination with patent family information allowing an effective investigation of the status of several related patent rights filed in different jurisdictions by searching through a unified interface. Disadvantages of such use of secondary sources are mainly the delay in publication and the lack of some data from primary sources.

ANALYSIS OF WIPO SURVEY AND OF EXISTING DATABASES

5. For the purpose of this study, WIPO has conducted a survey on the availability of legal status data from primary sources by sending a questionnaire to Member States and Regional Patent Offices. 87 replies have been received. The detailed evaluation results are available on the website at: http://www.wipo.int/patentscope/en/programs/legal_status/index.html.
6. In summary, in jurisdictions where the patent system is already operational for a considerable time (some 40 countries), the access to legal status information is mostly sufficient and, in particular, patent registers are operational, often searchable through the internet, updated daily and the data are shared with secondary databases.
7. In many emerging economies and developing countries the situation is less favorable. In several jurisdictions registers are not operational, or operational only in the sense that only (e.g. written) requests for information and legal status data can be submitted to the Office. Registers are frequently not searchable through the internet. The range of searchable data is limited, and data are rarely shared with secondary sources. Roughly one third of the registers provide information against a fee.
8. The study has also investigated secondary sources of legal status information with a special focus on the International Patent Documentation Center (INPADOC), which is widely recognized as the leading secondary source of legal status data from which many other providers of patent information obtain or purchase legal status data. INPADOC was initiated in 1972 by WIPO and was later taken over by the European Patent Office (EPO). It currently collects legal status data from 57 jurisdictions. Input data from up to 10 different input channels

per country are retrieved and processed for standardizing the data and for complementing them with respective INPADOC family information for each patent application. The number of items and diversity of data reported from each IPO also vary. This laborious processing incurs delays of availability of the data that varies from 2 days to 3 months depending on the primary source. The processed data are up-dated weekly and available for search through various EPO patent information services, e.g. free of charge through Espacenet, or as raw data products to other IPOs or private information providers. The reliability of such data is greatly influenced by the correctness of the raw data obtained from the primary sources, their completeness and their publication frequency.

9. Other secondary sources of legal status information are WIPO's PATENTSCOPE database to the extent that it includes data of legal events of the PCT international phase and the entry into the national phase. The latter information is provided only on a voluntary basis from selected PCT Member States and with varying regularity since there is no obligation to provide such information to WIPO. The data for identifying international applications which have not entered into the national/regional phase are important to identify technologies included in the applications that are considered to have entered into the public domain.

10. Other important secondary sources of legal status information for professional use are commercial databases which obtain a lot of their raw data from INPADOC due to the cost savings with respect to collecting and pre-processing such data. However, these providers also derive some data from selected primary sources.

11. Because legal status data are in principle related to the different actions and events defined by each jurisdiction there is a large variety of such data: certain events that may occur in one jurisdiction may not have been foreseen in another; and certain events or actions that occur in the lifetime of a patent application may not even be defined explicitly, but are necessary for automated monitoring of internal procedures. The different legal definitions inevitably also limit the comparability of such data. Even rather similar events could be defined slightly differently or depend on different conditions. In view of these limitations, INPADOC, therefore, records each legal event reported from a particular country with a different code, i.e. a particular code describing a particular legal event is applied only for the patent application data of that country. INPADOC data, thus, comprises several thousand different types of legal status data. Standardization or use of unified codes that are applicable to describe events in a global manner is highly desirable, but it would require a careful comparison of the individual definitions and has not yet been undertaken.

CONCLUSIONS

12. Based on the evaluation of WIPO survey and inputs received for the preparation of the Study, the Secretariat of WIPO suggests the following conclusions: Most jurisdictions/countries that responded to WIPO's Questionnaire (some 80 countries) keep records of legal status data of patents and many IP offices make databases accessible to the public on the Internet. In this regard, public access to the information necessary for identifying inventions in the public domain appears to be met. However, many issues remain to be resolved to enhance public access to the legal status data.

13. The availability of legal status data of some 50 countries/jurisdictions (most of them are developing countries and LDCs) is limited, since many of them do not have the legal status data in digital form and national on-line registers (accordingly secondary sources do not include such data). The diversity of legal events and their changing character over time pose specific challenges to maintaining and disseminating the legal status data.

14. The availability of legal status data is better in other countries/jurisdictions (some 40 countries/jurisdictions) which provide the data in on-line patent registers on the Internet. However, there is still much room for improvement in the content and reliability of such data.
15. The availability of the data does not necessarily mean that there is an easy access to data for the identification of inventions available in the public domain. Difficulties arise from a need for visiting a number of different on-line databases to perform a global search, a need for understanding different definitions of legal events in different jurisdictions, a need for a fee payment to access legal status data in some countries, and different interfaces and languages of the existing national on-line registries when performing a global search.
16. As regards a policy of sharing and disseminating data for the public availability, the majority of countries have already adopted a policy of free of charge access to the legal status data of patents, whereas some others have not.
17. The availability of licensing information is limited in most countries.
18. The availability of information with regard to entry and/or non-entry of international applications into national/regional phase is still limited in PATENTSCOPE, since efforts to collect such data depend on voluntary participation by IP offices. Non-entry data, if used and analyzed properly, would be useful to identify inventions in the public domain.
19. The reliability of data needs to be improved, e.g. by increasing the frequency of updates and synchronizing their publication, and by implementing standardized mechanisms for error correction notifications that facilitate the updating of secondary sources of legal status data information.
20. In view of the fact that the majority of countries have national on-line registers, it is possible and feasible to create a global portal in PATENTSCOPE with links to national patent online registers.
21. Effective public knowledge of the existence and status of patent rights is essential for assisting technology transfer, either by encouraging licensing of rights which already exist, or by identifying opportunities to freely use and develop technology which is in the public domain in some or all Member States. With globalization, activities for identifying inventions in the public domain and possible licensing opportunities will continue to grow geographically and seek potential partners worldwide. If Member States see further needs for improving public access to the legal status data information of patents in this context, any WIPO project in response to those needs will require an active participation by a large majority of the Member States, mainly because primary sources must be generated and shared by each Member State.
22. The WIPO Secretariat will seek strong support from policy makers in each Member State to enhance public access to the legal status data of patents and will continue to provide technical assistance to countries where resources and capacities are too limited to create on-line patent registers in accordance with WIPO Standards.
23. The WIPO Secretariat will also create a prototype of a global portal on the WIPO website which will contain links to URLs of the existing national patent registries and will continue to enhance PATENTSCOPE in terms of its content and functions to facilitate patent information search regarding inventions in the public domain.

[Annexe II follows]

Patent Documentation Group

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12.09.2012

Re: Requirements of industry with regard to minimum requirements of legal status data delivery

Dear Mr. Takagi,

We would like to contact you on behalf of the PDG's IMPACT Working Group to inform you about our views on legal status data.

High quality legal status information is of paramount importance for industry as it is the prerequisite for a reliable analysis of the patent situation and thus crucial for well-informed decision making by management.

On account of this understanding, the PDG has recently established a Task Force of the IMPACT Working Group which intends to strongly emphasize the industrial requirements for legal status information which require it to be comprehensive, reliable, up-to-date and standardized. In addition, legal status and bibliographic data must be made available in a consistent and user-friendly manner.

Therefore, IMPACT would now like to approach WIPO with a proposal for a new initiative aimed at:

- enhancing the coverage of legal status data and
- formulating a minimum set of data to be delivered by offices to central repositories such as INPADOC and PATENTSCOPE.

We are pleased to mention that the PDG Working Group is the leading users' voice with respect to legal status data worldwide. We are therefore trust that our contribution will be valuable to all providers of patent information, particularly to the EPO, WIPO, national patent offices, patent information providers but needless to say also to the global user community.

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A Requirement Paper (RP) has therefore been prepared (see attachment) which collates users' wishes and requirements.

We plan to inform the IMPACT Working Group of the RP paper during our forthcoming meeting on September 20-21, 2012 in Heidelberg hosted by BASF. We are looking forward to welcoming representatives of the EPO, WIPO, several national offices, major providers and, of course, the industrial user community based on 39 PDG member companies.

A copy of this letter including the RP will be made available to the EPO.

As our Task Force would be happy to collaborate with your organization on the proposed initiative, we would welcome a positive response from you.

We are looking forward to discussing further details with WIPO, for more information please contact the Chairman of PDG's IMPACT Working Group - Dr. Peter Kallas (peter.kallas@basf.com).

Kind regards,



Dr. Alexander Mullen
Secretary General

Patent Documentation Group registered at the Trade Register Office of Basel-Stadt, Switzerland, under number 1627 (31.03.1993)

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Requirements of industry with regard to minimum requirements of legal status data delivery

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IMPACT's Task Force would be happy to collaborate with WIPO and national and international patent offices on the proposed initiative.

Appendix 1

Requirement Paper

Minimum requirements for the delivery of legal status data

General Remarks

The patenting system provides a mechanism to encourage further innovation and investment in technology and it is in every nation's best interest to support technical advancements for the benefit of society and its people. Consequently, it is essential that any person or organization participating in business activities be made aware of the monopoly rights arising from patents which are held by others in the relevant field.

However, this alone is not enough. Since most patents have a potential lifetime of around 20 years, one can only guess how long a monopoly right will exist on the basis of the specification data alone - and this can be grossly misleading. In practice, patentees frequently do not keep up the annuity payments for the full period of their monopoly entitlement and allow their patent rights to lapse - on average, around 11-12 years after filing. Consequently, it is important that the potential users of an invention, other than the patentee, can easily find information as to whether a patent is in force or not. In this way, they can see whether they are free to utilize the invention e.g. if they can introduce a competing product onto the market or if they have to license a patented process first.

Hence, legal status data is key information which people need to know and it follows that the ready availability of this information has direct consequences, not just for business, but for society in general.

The patent community highly acknowledges and appreciates efforts e.g. by the EPO or WIPO to collect and consolidate legal status data. To date, the central source is the EPO database - INPADOC. All information should at least be available via this centralized source.

As most companies need global legal status, the preferred way to access legal status data, for a first overview, is a central source to avoid having to access various sources for a global legal status survey.

Therefore, the most important legal status data should be provided to such a source.

- In time
- Comprehensive
- Reliable
- Correct
- With further explanations of the meaning when codes are used or provided in other languages than English

These general requirements are of paramount importance to the user community.

Main legal events

As a first priority, the PDG focuses on the main legal status events which are:

Pre-grant events:

- Filing data (although the publication is usually the first piece of information is made available to the public the filing date is of high importance: many dates are based on the filing date like the patent term itself, priority right, SPC, or national phase entry (no country can require national phase entry before 30 months from priority).
- Publication of the application (link to publication should be provided)
- Examination
- Application withdrawn
- Application rejected
- For PCT filings at least the entry into the national phase

Grant

Post-grant events (link to the publication should be provided: it is important to see what has been granted)

- Opposition (data and opponent(s))
- Expiration
- Fee payments
- Reinstatements

General

- Change of ownership
- SPC issued
- List of patent family members with a link to the publications

These minimum requirements are the basis for a more comprehensive legal status data delivery. Every office planning to make legal status data available to the public should deliver the minimum set to centralized sources on a non-discriminatory basis. Afterwards, more detailed data should be made available.

We would like to recommend starting an initiative to make available the minimum requirements for the delivery of legal status data for those offices which have not yet started to disseminate legal status data to centralized sources and encourage those offices that are already providing legal status data to further enrich the scope of the information supplied.

[End of Annex II and of document]