

Committee on WIPO Standards (CWS)

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STATUS REPORT ON THE PREPARATION OF A PROPOSAL TO ESTABLISH A NEW WIPO STANDARD FOR THE EXCHANGE OF PATENT LEGAL STATUS DATA BY INDUSTRIAL PROPERTY OFFICES

Document prepared by the Secretariat

INTRODUCTION

1. Since the fourth session of the Committee on WIPO Standards (CWS), held in May 2014, the Legal Status Task Force (LSTF) continued its work to carry out Task No.47: “prepare a proposal to establish a new WIPO standard for the exchange of patent legal status data by industrial property offices. Once this task is completed, the corresponding proposal should be extended to trademarks and industrial designs.”
2. At the time of preparing this document, the representatives of 25 countries, intergovernmental organizations and international non-governmental organizations participate in the Task Force. Since May 2014, the Task Force conducted its discussion through e-forum and online conference as well as at the face-to-face meeting held in June 2015.
3. As the outcome of the discussions, the LSTF tentatively agreed on the following important parts of the new standard: objectives and scope of the new standard; composition of legal status event information; and list of key events. The LSTF also agreed to include an overall patent prosecution model in the new standard to have a common overview of patent procedure worldwide. The agreed draft model is reproduced in Annex I to this document.

ROADMAP FOR DEVELOPMENT OF NEW STANDARD

Objectives and Scope

4. The LSTF tentatively agreed that the new standard be aimed at providing recommendations to national, regional and international authorities who deal with industrial property (IP) information on the basis of national IP laws or international IP conventions.
5. The LSTF considers that the standard should promote efficient exchange of patent legal status data in a harmonized manner by industrial property offices (IPOs) in order to facilitate access to that data by IP information users, IPOs, IP data providers, the general public and other interested parties. It should provide the list of events that may take place during the life-cycle of a patent. It should also provide technical features of the data associated to events, such as data components and structure, for the purpose of electronic data exchange.
6. It is highlighted that patent legal status can be determined by one or several events that took place in accordance with the respective patent laws and regulations of a particular jurisdiction. Taking into consideration the diversity of patent law and practice among various jurisdictions, the LSTF agreed that the new standard should not intend to harmonize procedural and substantive requirements under the national or regional laws and regulations.
7. For the exchange of patent legal status data in a harmonized manner, the LSTF considers that the new standard specifies:
 - what legal status data should be exchanged; and
 - how that data should be structured.

Working Procedure

8. In order to carry on its discussions, the LSTF identified the following three Phases with specific topics:
 - (a) Phase 1: global picture and the scope of the new standard;
 - (b) Phase 2: legal status data to be exchanged, particularly the list of events; and
 - (c) Phase 3: structure of data in view of minimum data set e.g. identification of event, associated bibliographic data, etc., and codification of legal status data for the electronic data exchange.
9. It is noted that the LSTF had completed Phase 1 in January 2014 and was working on Phase 2 at the time of writing this document.

COMPOSITION OF LEGAL STATUS EVENT INFORMATION

10. The LSTF agreed that a legal status event consists of the three components, i.e., Stage, Event and State, to indicate the status information of an application or patent at the given time. The LSTF also agreed the following descriptions for the three components:
 - (a) Stage: Stage of processing/prosecution of the application or patent at the given time under the applicable law of the IPO.
 - (b) Event: Event occurring in the processing/prosecution of the application or patent at the given time under the applicable law of the IPO, which may cause a change in the state and/or status of the application or patent. An event is triggered by an action by the IPO, applicant, owner or a third party.
 - (c) State: State of the application or patent at the given time according to the applicable law of the IPO.

Stages

11. The following six stages were provisionally agreed upon by the Task Force members:

- (a) Filing
- (b) Examination
- (c) Pre-grant
- (d) Grant
- (e) Post-grant
- (f) Termination (likely)

Events

12. The LSTF agreed to define two sets of events in the new standard, which are the set of key events and the set of detailed events. Moreover, the Task Force members agreed on the draft 18 key events, which are reproduced in Annex II to this document. The LSTF requests the CWS to comment on the key events which are a milestone for the development of the new standard.

13. With regard to the set of detailed events, the LSTF members prepared three draft versions and discussed them in several rounds of discussion. There are around 130 detailed events in the latest draft and the LSTF will continue its discussion to complete the list of detailed events.

States

14. The LSTF agreed on the three states, i.e. “Active”, “Inactive” and “Terminated” along with the following descriptions:

- (a) Active: the application or patent was in force at the time the legal status information was provided by the IPO.
- (b) Inactive: the application or patent was not in force at the time the legal status information was provided by the IPO, e.g. due to lack of payment, withdrawal or expiry.
- (c) Terminated: the application or patent had been permanently terminated by the IPO. Please note that not all IPOs apply this state under the standard. Exceptionally this state may return to “Active” or “Inactive” due to a court decision or a change in IP legislation.

STRUCTURE OF LIST OF EVENTS

15. The LSTF discussed how to list up events in the standard and how to cluster them. It was agreed that the list of standard events would consist of three parts: category, key events and detailed events. It was also agreed that the relevant key and detailed events be grouped into the same category, and key events be placed in the first position in the respective categories. For example,

[Category]

- Application discontinuation

[Key events]

- Application discontinued

[Detailed events]

- Application withdrawn

- Application deemed to be withdrawn, abandoned or lapsed
- Application refused following examination
- ...

OPEN ISSUES

16. At the time of preparing this document, the LSTF is working on the following open issues:

- (a) whether the key events should be mandatory or not;
- (b) whether snapshot or history of events should be exchanged;
- (c) what would be a recommendation for the exchange frequency of legal status data;
- (d) what set of events to be delivered: only key events; key and detailed events; or key and detailed events with raw events that IPOs currently produce;
- (e) whether stage transition information (from one stage to another stage) should be delivered with events or not;
- (f) descriptions for the six stages; and
- (g) list of detailed events.

WORK PLAN

17. The LSTF plans to complete the draft list of detailed events in the first half of 2016. In preparing the events list, the Task Force members also plan to compare the actual legal status events, which their Office currently disseminate, to the draft standard events, i.e. key events and detailed events, in order to know whether their actual events can be mapped into the standard events list.

18. In order to finalize the standard events list and discuss open issues, the LSTF will organize its face-to-face meeting(s) in 2016.

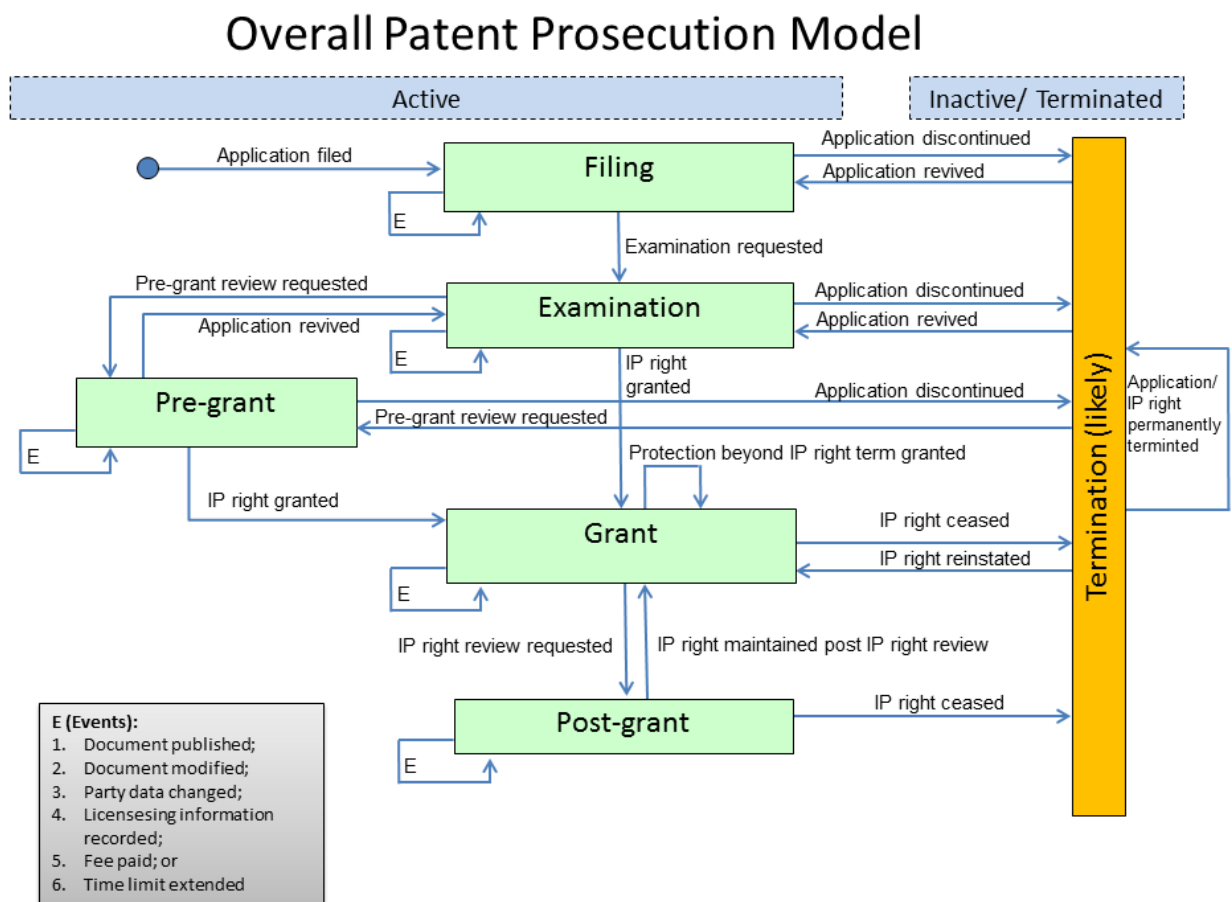
19. *The CWS is invited to*

(a) note the results of the work of the Legal Status Task Force and the report of the Task Force leader, as set out in this document; and

(b) comment on the key events referred to in paragraph 12 above, and reproduced in Annex II to the present document.

[Annex I follows]

OVERALL PATENT PROSECUTION MODEL (DRAFT)



[Annex II follows]

18 KEY EVENTS

1. Application filed: A national or regional application filed or PCT national phase processing started with a national or regional IP Office.
2. Application discontinued: The application has been discontinued due to refusal by the IP Office, a withdrawal by the applicant(s) or a failure to prosecute, for example, non-payment of fees or not responding to an office action within the relevant period.
3. Application revived: The application has been revived.
4. Examination requested: The examination of application has been requested.
5. Pre-grant review requested: Pre-grant review, e.g. administrative appeal and opposition, has been requested to challenge a decision by the competent IP Office.
6. IP right granted: Patent has been granted, or is intended to be granted, after examination or pre-grant proceedings in full or in amended form.
7. Protection beyond IP right term granted: Patent term adjustment (PTA), patent term extension (PTE) or supplementary protection certificate (SPC) has been granted.
8. IP right ceased: IP right has ceased due to expiry, revocation or surrender of the right, non-payment of renewal fee or as a result of IP right review e.g. post-grant appeal or opposition.
9. IP right reinstated: IP right has been reinstated after its cessation.
10. IP right review requested: Post-grant review process has been requested e.g. appeal, opposition, re-examination.
11. IP right maintained post IP right review: IP right has been maintained in full or amended form after IP right review process.
12. Application or IP right permanently terminated: Application or IP right has been permanently terminated.
13. Document modified: Amendment or correction has been made in application or patent document.
14. Document published: Application, patent or bibliographic information has been published by an IP Office.
15. Party data changed: A change in data identifying parties concerned with the application or IP right e.g. name or address of applicant, inventor, representative or owner.
16. Licensing information recorded: Licensing information has been recorded, e.g., information regarding licenses, security interest, pledge or mortgage.
17. Time limit extended: Extension of a time limit or continued processing to complete necessary procedure e.g. payment of fee, completion of specification.
18. Fee paid: Payment of fees was made e.g. renewal or maintenance fee.

[End of Annex II and of document]