

WIPO



WIPO/DAS/PD/WG/1/2
ORIGINAL: English
DATE: November 24, 2006

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

WORKING GROUP ON THE DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS

First Session
Geneva, February 7 to 9, 2007

ESTABLISHMENT OF A DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS

Document prepared by the Secretariat

SUMMARY

1. The Assemblies of the Paris Union for the Protection of Industrial Property, the Patent Law Treaty and the International Patent Cooperation Union (PCT Union), in the context of the 42nd series of meetings of the Assemblies of the Member States of WIPO held in Geneva from September 25 to October 3, 2006, approved the establishment of a digital access service for priority documents. Creation of the service will respond to an Agreed Statement by the Diplomatic Conference for the Adoption of the Patent Law Treaty in which WIPO was urged to expedite the creation of a digital library system for priority documents. The Assemblies (see document A/42/14, paragraph 220):

(a) approved the convening in early 2007 of an *ad hoc* Working Group to consider matters associated with the establishment of a digital access service for priority documents to be administered by the International Bureau;

(b) directed the International Bureau to establish framework provisions and appropriate procedures, according to the recommendations from the Working Group, for administering the digital service;

(c) directed the International Bureau to implement the digital access service in accordance with the established framework provisions and procedures;

(d) requested the International Bureau to report to them in September 2007 on the results of the *ad hoc* Working Group and on any implementation of the service that may have commenced.

The Working Group has now been convened for the present session. This document reproduces the substance of the introduction to the proposals considered by the Assemblies as contained in document A/42/5, as well as the background information contained in Annex II of that document.

2. The new service will offer possibilities for more streamlined handling of priority documents for the benefit of both Patent Offices and applicants, with considerable savings of financial and other resources, similar to possibilities available in the case of priority documents filed in connection with international applications under the Patent Cooperation Treaty (PCT). Participation in the service will be on a voluntary basis for both Patent Offices and applicants.
3. The service will provide a framework and administrative procedures under which priority documents could be made accessible in a digital library for the purposes of complying with national and regional requirements for the furnishing of priority documents. It will take advantage of the existing automated systems operated by the International Bureau for priority documents under the PCT, with certain additional features necessary in the context of Paris Convention filings.
4. Offices of first filing will be able to take advantage of the service to reduce the issuing of multiple copies of priority documents. Offices of second filing will be able to reduce the need to handle and store priority documents and to take administrative steps in cases where priority documents have not been furnished by applicants. Applicants will be able to rely, in relation to participating Offices of second filing, on a single reference to a priority document held in a digital library rather than having to obtain and furnish multiple priority documents to all Offices of second filing.

MAIN FEATURES

5. The digital access service will rely on framework provisions to be established by the International Bureau in accordance with the recommendations of the Working Group. It is envisaged that the framework provisions would need to cover at least the following key features:
 - (a) the establishment and operation of the service by the International Bureau;
 - (b) procedures for placing priority documents in a digital library for the purposes of the service, either obtained from the issuing Patent Office or submitted by the applicant, or for obtaining access to priority documents available from other digital libraries that are recognized for the purposes of the service;
 - (c) recognition by participating Patent Offices of priority documents that are accessible under the service;
 - (d) an appropriate authentication mechanism to ensure the confidentiality of unpublished priority documents, such that access would be given to Offices only with the applicant's authorization (for example, by use of a unique access code assigned to each

priority document stored for the purposes of the service); it must be remembered that priority documents are usually unpublished at the time when a copy is required by the Office with which a later application claiming priority has been filed;

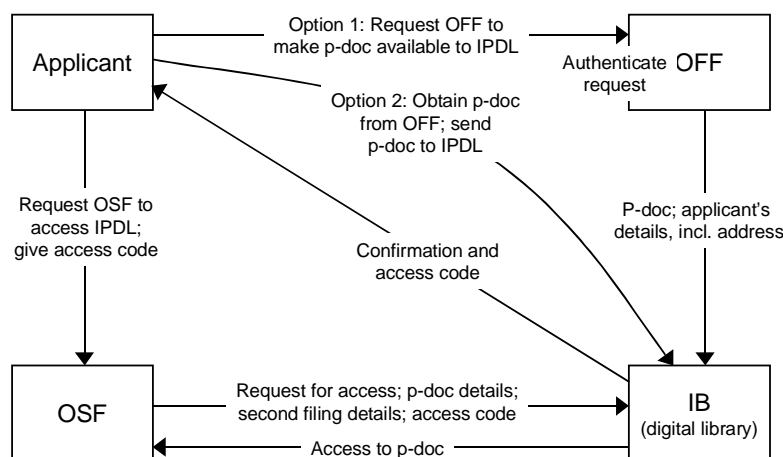
(e) agreements between the International Bureau and Patent Offices wishing to participate in the service, as either an Office issuing priority documents (“Office of first filing”) or an Office entitled and wishing to access priority documents under the service (“Office of second filing”), or in both capacities, in which the Office would declare that it applies the framework provisions.

6. It is envisaged that the service will rely for its operation on an agreed understanding of the Assemblies concerning certification of priority documents that was adopted in 2004 (paragraph 15, below, of the present document, and Part E of the Annex). Hence, it would be for the Office of first filing to decide what sort of certification it would use in the provision of the original priority documents that are made available via the service. The framework provisions would provide for Offices of second filing participating in the service to accept simple copies of those documents accessed via the service, in accordance with the framework provisions. Such acceptance of simple copies of certified priority documents is, of course, already an established feature of the procedures under the PCT (paragraph 16, below, of the present document).

7. While the service would in general operate on the basis of priority documents submitted and accessed in electronic form, it would also be available to Offices which are not in a position to handle documents in electronic form. Priority documents submitted in paper form would be scanned by the International Bureau for uploading into the digital library. Moreover, access in the form of paper copies provided by the International Bureau would be available to Offices needing limited numbers of priority documents if their systems do not enable electronic access.

8. The possible features of the service are illustrated in more detail in the draft framework provisions set out in document WIPO/DAS/PD/WG/1/3 and in the following diagram. Final details of the system are likely, however, to differ from those illustrated, depending on the results of the deliberations of the Working Group.

**Digital Access Service For Priority Documents:
Example of a Possible System**



P-doc = priority document OFF = Office of first filing OSF = Office of second filing

9. The possibility of charging of fees by Patent Offices and the International Bureau is not covered in the draft framework provisions, but will no doubt be considered by the Working Group.

BACKGROUND

10. The right of priority, established by Article 4 of the Paris Convention for the Protection of Industrial Property, is a central feature of the international patent system. Priority claims in patent applications need to be backed up by reliable copies of the earlier applications from which priority is claimed. Certified copies of such applications (“priority documents”) are routinely required by Patent Offices under the applicable national or regional laws as a condition for the recognition of priority rights, in accordance with Article 4D of the Paris Convention (reproduced in Part A of the Annex).

11. Traditional paper-based means of furnishing and certifying priority documents are burdensome and inefficient, both for Patent Offices which have to issue, receive and store them and for applicants who have to obtain and transmit multiple copies. Greater advantage needs to be taken of modern information technology in the processing of priority documents and in enabling applicants to meet the requirements of the Paris Convention.

12. The Patent Law Treaty (PLT) was adopted by a Diplomatic Conference in 2000, came into force on April 28, 2005, and at the time of finalizing the present document had 14 member States. The PLT contains several provisions relating to priority claims, including Article 6(5) and Rule 4 which deal specifically with priority documents (Annex, Part B). Those provisions rationalize formalities and procedures to a considerable extent, in particular by ensuring that a Contracting Party does not require applicants to provide copies (whether certified or not) of earlier applications where that earlier application either was filed with its Office or else is available to that Office from a digital library which the Office accepts for that purpose.

13. The PLT Diplomatic Conference adopted an Agreed Statement urging WIPO to expedite the creation of a digital library system for priority documents and noting that such a system would be of benefit to patent owners and others wanting access to priority documents (Annex, Part C).

14. Considerable rationalization in the handling of priority documents has been achieved for international applications under the Patent Cooperation Treaty (PCT). The PCT Regulations provide a variety of alternatives for obtaining, furnishing and storing priority documents, a direct means of supplying copies to designated Offices and third parties, and simplified recognition by designated Offices. Under the PCT procedures, which are outlined in more detail in paragraphs 16 to 18, below (also Annex, Part D), the International Bureau acts as a central repository for priority documents relating to PCT applications.

15. In 2004 the Assemblies of the Paris Union and the PCT Union adopted an agreed understanding concerning the certification of priority documents in order to enhance certainty with respect to the growing use of electronic means for the provision, storage and dissemination of priority documents (Annex, Part E). In accordance with that understanding, streamlined procedures should now be implemented, where appropriate, for certifying priority documents made available from digital libraries.

PCT PROCEDURES FOR HANDLING PRIORITY DOCUMENTS

16. The new service would, as mentioned above, build on existing procedures under the PCT, which provide streamlined, less costly and less resource-intensive treatment of priority documents filed in relation to PCT applications. The procedures have the following general features (see PCT Rule 17, reproduced in Part D of the Annex, for more detailed conditions and requirements, for example, as to time limits):

(a) the original of each priority document (that is, a single, certified, original) is stored by the International Bureau;

(b) after the international application claiming priority has been published, copies of the priority document are available to designated Offices and third parties from the International Bureau;

(c) designated Offices are required to accept such copies (that is, simple copies of the certified original) from the International Bureau for the purposes of the national phase, and are not permitted to require copies from applicants;

(d) the applicant has several options as to how PCT requirements in relation to the provision of priority documents may be complied with:

(i) the applicant may obtain the priority document from the issuing Office and furnish it to the receiving Office or the International Bureau;

(ii) if the national or regional Office with which the priority application was filed is the same Office as the PCT receiving Office, the applicant may, instead of having to obtain the priority document from the Office and forward it to the International Bureau, request the Office to transmit the priority document to the International Bureau;

(iii) the applicant is also entitled, where the priority document is available from a digital library in accordance with the PCT Administrative Instructions, to request the receiving Office or the International Bureau to obtain a copy from the digital library;

17. The International Bureau now stores all priority documents filed in connection with new PCT applications in electronic form, whether they are received in that form or received on paper and subsequently scanned by the International Bureau. Priority documents requested by designated Offices for the purposes of the national phase are available from the International Bureau in electronic form via the PCT COR (Communication on Request) system.

18. The following figures give some idea of the extent of the use of the International Bureau's automated procedures for handling priority documents under the PCT. In 2005, about 134,000 PCT applications were filed, of which 93% contained priority claims. Also in 2005, about 155,000 priority documents were furnished or transmitted to the International Bureau, of which 30% were furnished direct by the applicant, and 70% were transmitted by the receiving Office either on paper (38%) or in electronic form (32%). In the same year, the International Bureau fulfilled about 1,400,000 requests by designated Offices for copies of priority documents, of which 99% were provided in electronic form on physical media, 0.5%

were provided as copies on paper, and 0.5% were transmitted online using the PCT EDI (Electronic Document Interchange) system¹.

19. Arrangements are now in place with four receiving Offices for all or at least some priority documents issued by them in the context of PCT Rule 17 to be transmitted to the International Bureau in electronic form; those Offices together account for about 58% of all PCT filings. The International Bureau is actively seeking the participation by more Offices in systems for exchanging documents in electronic form.

DIGITAL LIBRARIES

20. As mentioned above, both the PLT and the PCT contain provisions designed to relieve applicants from having to supply priority documents that are available from digital libraries. In the case of the PLT, the digital library must be accepted for the purpose by the Office concerned. In the case of the PCT, availability of the priority document from a digital library must be in accordance with the PCT Administrative Instructions. The relief given to applicants under the PCT extends to submission of priority documents both during the international phase and also during the national phase (PCT Rule 17.1(b-*bis*) and 17.1(d)).

21. Consultations are presently being undertaken with a view to modification of the PCT Administrative Instructions to ensure the recognition of digital libraries for the purpose of those provisions of the PCT Regulations. It is envisaged that the PCT Administrative Instructions would be modified to ensure that the digital library maintained under the proposed new service would also be recognized.

22. It is envisaged that the new service would offer different possibilities to Patent Offices depending on the extent of automation of their procedures. Offices which do not have digital libraries of documents would be able to provide priority documents for uploading into the digital library to be established by the International Bureau for the purposes of the service. In the case of Offices which already have or in future establish digital libraries of priority documents, it is envisaged that access under the new service would be by way of links to those other digital libraries, so as to avoid unnecessary duplication of holdings of priority documents. The technical systems to be implemented would of course need to take these two possibilities into account.

IMPLEMENTATION; RESOURCE AND BUDGET IMPLICATIONS

23. In order to minimize the initial investment into the new service, it is proposed that a simple technical architecture should be adopted at first, based on existing IT systems and infrastructure at the International Bureau. Nevertheless, as experience evolves and system usage increases, it is likely that further investment into the technical architecture may be required so as to maintain required service levels.

24. The infrastructure at the International Bureau that could be leveraged for the new service includes the PCT COR and PCT EDI systems. As mentioned above, the PCT COR system is used to receive and store priority documents (before publication of the PCT application claiming priority) and then to distribute priority documents (after publication of

¹ Figures for other possible means of viewing and downloading priority documents from WIPO's website via the Internet are not available.

the PCT application). It is proposed that these systems be extended to handle priority documents under the proposed new service. In addition, PCT EDI is a secure transport mechanism that is already used to exchange priority documents between Patent Offices and the International Bureau.

25. The International Bureau is already committed to invest in adapting PCT COR to be compatible with the Trilateral Document Access (TDA) interface systems being established by the Japan Patent Office, the United States Patent and Trademark Office and the European Patent Office, and therefore would also be prepared to extend that investment to ensure such compatibility in the case of the proposed new service.

26. As most of the technical architecture under a simple starter system is already available, the majority of the initial investment would be absorbed by the International Bureau in the form of programmer resources adapting existing systems in addition to the work required to analyze, select and then implement a pragmatic authentication scenario from among a number that come to mind.

ELECTRONIC FORUM

27. An electronic forum has been established on WIPO's website, accessible via <http://www.wipo.int/pdocaccess>, to facilitate the work of the Working Group. Comments submitted by States and organizations participating in the Working Group may be browsed on the forum page, which also enables the submission of comments and subscription to an e-mail notification service.

28. The Working Group is invited to make recommendations concerning the new service to be established by the International Bureau.

[Annex follows]

ANNEX

SELECTED TREATY PROVISIONS AND DECISIONS OF WIPO
AND OTHER BODIES CONCERNING PRIORITY DOCUMENTS

PART A. PARIS CONVENTION FOR THE PROTECTION
OF INDUSTRIAL PROPERTY

Article 4

[A. to I. *Patents, Utility Models, Industrial Designs, Marks, Inventors' Certificates: Right of Priority.* — G. *Patents: Division of the Application*]

[...]

D. — (1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country shall determine the latest date on which such declaration must be made.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required.

Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.

[...]

PART B. PATENT LAW TREATY (PLT)

Article 6
Application

[...]

(5) [*Priority Document*] Where the priority of an earlier application is claimed, a Contracting Party may require that a copy of the earlier application, and a translation where the earlier application is not in a language accepted by the Office, be filed in accordance with the requirements prescribed in the Regulations.

[...]

REGULATIONS UNDER THE PLT

Rule 4
Availability of Earlier Application Under Article 6(5) and Rule 2(4)
or of Previously Filed Application Under Rule 2(5)(b)

(1) [*Copy of Earlier Application Under Article 6(5)*] Subject to paragraph (3), a Contracting Party may require that a copy of the earlier application referred to in Article 6(5) be filed with the Office within a time limit which shall be not less than 16 months from the filing date of that earlier application or, where there is more than one such earlier application, from the earliest filing date of those earlier applications.

(2) [*Certification*] Subject to paragraph (3), a Contracting Party may require that the copy referred to in paragraph (1) and the date of filing of the earlier application be certified as correct by the Office with which the earlier application was filed.

(3) [*Availability of Earlier Application or of Previously Filed Application*] No Contracting Party shall require the filing of a copy or a certified copy of the earlier application or a certification of the filing date, as referred to in paragraphs (1) and (2), and Rule 2(4), or a copy or a certified copy of the previously filed application as referred to in Rule 2(5)(b), where the earlier application or the previously filed application was filed with its Office, or is available to that Office from a digital library which is accepted by the Office for that purpose.

(4) [*Translation*] Where the earlier application is not in a language accepted by the Office and the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable, the Contracting Party may require that a translation of the earlier application referred to in paragraph (1) be filed by the applicant, upon invitation by the Office or other competent authority, within a time limit which shall be not less than two months from the date of that invitation, and not less than the time limit, if any, applied under that paragraph.

PART C. AGREED STATEMENT BY THE PLT DIPLOMATIC CONFERENCE

[...]

3. When adopting Articles 6(5) and 13(3), and Rules 4 and 14, the Diplomatic Conference urged the World Intellectual Property Organization to expedite the creation of a digital library system for priority documents. Such a system would be of benefit to patent owners and others wanting access to priority documents.

[...]

PART D. PATENT COOPERATION TREATY (PCT)

Article 8

Claiming Priority

(1) The international application may contain a declaration, as prescribed in the Regulations, claiming the priority of one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property.

(2)(a) Subject to the provisions of subparagraph (b), the conditions for, and the effect of, any priority claim declared under paragraph (1) shall be as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property.

(b) The international application for which the priority of one or more earlier applications filed in or for a Contracting State is claimed may contain the designation of that State. Where, in the international application, the priority of one or more national applications filed in or for a designated State is claimed, or where the priority of an international application having designated only one State is claimed, the conditions for, and the effect of, the priority claim in that State shall be governed by the national law of that State.

REGULATIONS UNDER THE PCT

Rule 17

The Priority Document

17.1 *Obligation to Submit Copy of Earlier National or International Application*

(a) Where the priority of an earlier national or international application is claimed under Article 8, a copy of that earlier application, certified by the authority with which it was filed (“the priority document”), shall, unless that priority document has already been filed with the receiving Office together with the international application in which the priority claim is made, and subject to paragraphs (b) and (b-bis), be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date, provided that any copy of the said earlier application which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the date of international publication of the international application.

(b) Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to prepare and transmit the priority document to the International Bureau. Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office to the payment of a fee.

(b-*bis*) Where the priority document is, in accordance with the Administrative Instructions, available to the receiving Office or to the International Bureau from a digital library, the applicant may, as the case may be, instead of submitting the priority document:

- (i) request the receiving Office to obtain the priority document from such digital library and transmit it to the International Bureau; or
- (ii) request the International Bureau to obtain the priority document from such digital library.

Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office or the International Bureau to the payment of a fee.

(c) If the requirements of none of the three preceding paragraphs are complied with, any designated Office may, subject to paragraph (d), disregard the priority claim, provided that no designated Office shall disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which shall be reasonable under the circumstances.

(d) No designated Office shall disregard the priority claim under paragraph (c) if the earlier application referred to in paragraph (a) was filed with it in its capacity as national Office or if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library.

17.2 *Availability of Copies*

(a) Where the applicant has complied with Rule 17.1(a), (b) or (b-*bis*) the International Bureau shall, at the specific request of the designated Office, promptly but not prior to the international publication of the international application, furnish a copy of the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy. The applicant shall not be required to furnish a translation to the designated Office before the expiration of the applicable time limit under Article 22. Where the applicant makes an express request to the designated Office under Article 23(2) prior to the international publication of the international application, the International Bureau shall, at the specific request of the designated Office, furnish a copy of the priority document to that Office promptly after receiving it.

(b) The International Bureau shall not make copies of the priority document available to the public prior to the international publication of the international application.

(c) Where the international application has been published under Article 21, the International Bureau shall furnish a copy of the priority document to any person upon request and subject to reimbursement of the cost unless, prior to that publication:

- (i) the international application was withdrawn,
- (ii) the relevant priority claim was withdrawn or considered, under Rule 26*bis*.2(b), not to have been made.

PART E. AGREED UNDERSTANDING ADOPTED BY THE
ASSEMBLIES OF THE PARIS UNION AND THE PCT UNION

(adopted by the Assemblies on October 5, 2004; document A/40/7, paragraph 173, referring to document A/40/6, paragraph 9, in which an agreed understanding was proposed in order to enhance certainty with respect to the growing use of electronic means for the provision, storage and dissemination of priority documents)

The Assemblies of the Paris Union and the PCT Union agree that the following principles shall apply to the application of Article 4D(3) of the Paris Convention, Article 8 of the PCT and Rule 17 of the PCT Regulations:

- (i) it is for the competent authority furnishing the priority document to determine what constitutes certification of a priority document and the date of filing, and how it will certify such a document;
- (ii) each Office will accept a single certification that applies to more than one priority document (“collective certification”), provided that such certification permits identification of all priority documents to which it relates;
- (iii) a non-exhaustive list of examples of forms of certification of priority documents agreed to be acceptable consists of the following:
 - certification in paper form;
 - certification in electronic character coded form;
 - an electronic image of a certification on paper;
 - the collective certification of multiple priority documents transmitted by an Office to another Office or to the International Bureau;
 - the collective certification of multiple priority documents contained in an Office database providing access to such documents to those entitled;
- (iv) for the purpose of Article 8 and Rule 17 of the PCT, once a priority document has been issued and certified in accordance with the foregoing principles by the receiving Office, and transmitted to the International Bureau in electronic form, no designated or elected Office may require any different form of certification or any re-certification of that priority document; however, the International Bureau will continue, on request by any designated or elected Office, to furnish copies in paper form of priority documents held in connection with international applications under the PCT.

[End of Annex and of document]