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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

WORKING GROUP ON THE DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS

First Session
Geneva, February 7 to 9, 2007

REPORT

adopted by the Working Group

INTRODUCTION

1. The Working Group on the Digital Access Service for Priority Documents held its first session in Geneva from February 7 to 9, 2007.
2. The following members of the Working Group were represented: (i) the following Member States of the International Union for the Protection of Industrial Property (Paris Union), the Patent Law Treaty (PLT) Assembly and/or the International Patent Cooperation Union (PCT Union): Australia, Austria, Bangladesh, Belgium, Canada, China, Colombia, Costa Rica, Croatia, Czech Republic, Denmark, Ecuador, Egypt, Estonia, Finland, France, Germany, Greece, Hungary, Iran (Islamic Republic of), Italy, Japan, Kuwait, Latvia, Lithuania, Mexico, Monaco, Morocco, Netherlands, Nicaragua, Norway, Poland, Portugal, Republic of Korea, Romania, Russian Federation, Serbia, Slovakia, Spain, Sweden, Switzerland, Turkey, Ukraine, United Kingdom, United States of America, Uruguay; (ii) Eurasian Patent Organization, European Patent Office.
3. The following intergovernmental organizations were represented by observers: African Union (AU), Economic Community of West African States (ECOWAS).
4. The following international non-governmental organization was represented by observers: European Law Student's Association (ELSA International).

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5. The following national non-governmental organization was represented by an observer: Intellectual Property Institute of Canada (IPIC).
6. The list of participants is contained in document WIPO/DAS/PD/WG/1/INF/1.

OPENING OF THE SESSION

7. Mr. Francis Gurry, Deputy Director General of WIPO, on behalf of the Director General, opened the session and welcomed the participants.

8. The Working Group agreed that the two intergovernmental organizations participating in the session that represented regional Patent Offices, namely, the Eurasian Patent Organization and the European Patent Office, should be treated as having membership status in the Working Group.

ELECTION OF A CHAIR AND TWO VICE-CHAIRS

9. The Working Group unanimously elected Mr. Peter Back (United Kingdom) as Chair for the session, and Mrs. Nadia Abd-Allah (Egypt) and Mr. Gennady Negulyaev (Russian Federation) as Vice-Chairs.
10. Mr. Philip Thomas (WIPO) acted as Secretary to the Working Group.

ADOPTION OF THE AGENDA

11. The Working Group adopted the agenda as appearing in document WIPO/DAS/PD/WG/1/1 Rev.
12. The Working Group agreed that the record of the proceedings of the session would consist of a report in summary form, noting important matters raised in discussions and the conclusions reached.

ESTABLISHMENT OF THE DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS

13. The Secretariat recalled that the establishment of a digital access service for priority documents had been approved by the Paris Union Assembly, the PLT Assembly and the PCT Union Assembly, and would respond to an Agreed Statement by the Diplomatic Conference for the Adoption of the PLT. The International Bureau was required to establish the service according to recommendations of the Working Group, and to report to the Assemblies in September 2007, including on any implementation of the service that may have commenced. Participation in the service would be on a voluntary basis for both Offices and applicants. In particular, Offices would have the choice of participating as an Office of first filing or as an Office of second filing, or both. The service would permit use of a wide variety of media and formats, and would be complementary to other established systems for the exchange of priority documents.

SYSTEM ARCHITECTURE

14. Discussions were based on documents WIPO/DAS/PD/WG/1/2 and 5.¹ The Secretariat explained that document WIPO/DAS/PD/WG/1/2, insofar as it described the proposed system architecture, had in effect been superseded by document WIPO/DAS/PD/WG/1/5.

15. In introducing the documents, the Secretariat emphasized the following points:

(a) The system architecture of the new service would need to be refined taking into account the considerations of the Working Group. The architecture as proposed offered at least the same levels of confidentiality and security as already applied under the Patent Cooperation Treaty (PCT). The proposed architecture would be complementary to other document exchange systems, in particular the Trilateral Document Access (TDA) system (see paragraph 16, below).

(b) The proposed system architecture was designed to be flexible, allow for a wide variety of the possible data flows between the applicant, the Office of first filing, the Office of second filing, and the International Bureau. The service would wherever possible take advantage of existing PCT infrastructure, including scanning facilities and the Electronic Data Interchange (PCT-EDI), Communication on Request (PCT-COR) and PatentScope systems.

(c) The proposed access system relied on use of an access code which could act as a substitute for a priority document itself, and would allow applicants to manage the distribution of a priority document without the need to handle it.

(d) Three particular issues related to the proposed system architecture that needed consideration were:

(i) *Means of delivery of priority documents to Offices of second filing:* A new secure part of the PatentScope web site might be used, allowing for browser-based access to the priority document. Alternatively, the PCT-EDI system, based on the Secure File Transfer Protocol (SFTP), might emerge as a better delivery mechanism, as it had an Office authentication mechanism, and could be used for simple bulk data delivery.

(ii) *Centralized versus decentralized management of the distribution of priority documents to Offices of second filing:* The proposed architecture foresaw the applicant transmitting an access code to each Office of second filing in a decentralized fashion. The Working Group might wish to consider the merits of a system permitting applicants to use an access code to enter a centralized system from which the distribution of priority documents to Offices of second filing could be managed.

(iii) *Whether the access code should be generated and sent to the applicant by the Office of first filing or the International Bureau:* Under the proposed architecture, the Office of first filing would transmit the mailing address of the applicant and other meta-data to the International Bureau, which would generate and transmit the access code to the applicant. Users of the system might find it more convenient for the access code to be generated and sent to the applicant by the Office of first filing.

¹ Working documents and the electronic forum established to facilitate the work of the Working Group are accessible on WIPO's website via www.wipo.int/pdocaccess.

16. The Delegation of the United States of America, speaking also on behalf of the Delegation of Japan and the European Patent Office, welcomed the initiative to establish a digital access service for priority documents. The Delegation noted that the three Offices concerned (the “Trilateral Offices”) held a substantial majority of the world’s priority documents, and had already established a Trilateral-based digital access service called Trilateral Document Access (TDA) to facilitate transfer of priority documents between those Offices. The Delegation further stated that the Trilateral Offices shared the following views: (i) Security and access to unpublished applications are critical issues that must be addressed before the service can be considered usable. (ii) Similar to the Trilateral arrangement, the service should be free of charge to users. (iii) Given the substantial investment by the Trilateral Offices in the development and implementation of TDA, it was imperative that the integrity of TDA be maintained and that it be controlled by the Trilateral Offices, and that as a result, the Trilateral Offices favored a network or distributed model of cooperating services. The Delegation’s comments are reproduced in the Annex.

Agreed Principles

17. The Working Group, after considerable discussion, agreed that the digital access service for priority documents should be developed having regard to the following principles, noting that they might be subject to evolution with future consideration by the Working Group and that further principles might need to be included:

“1. Business need

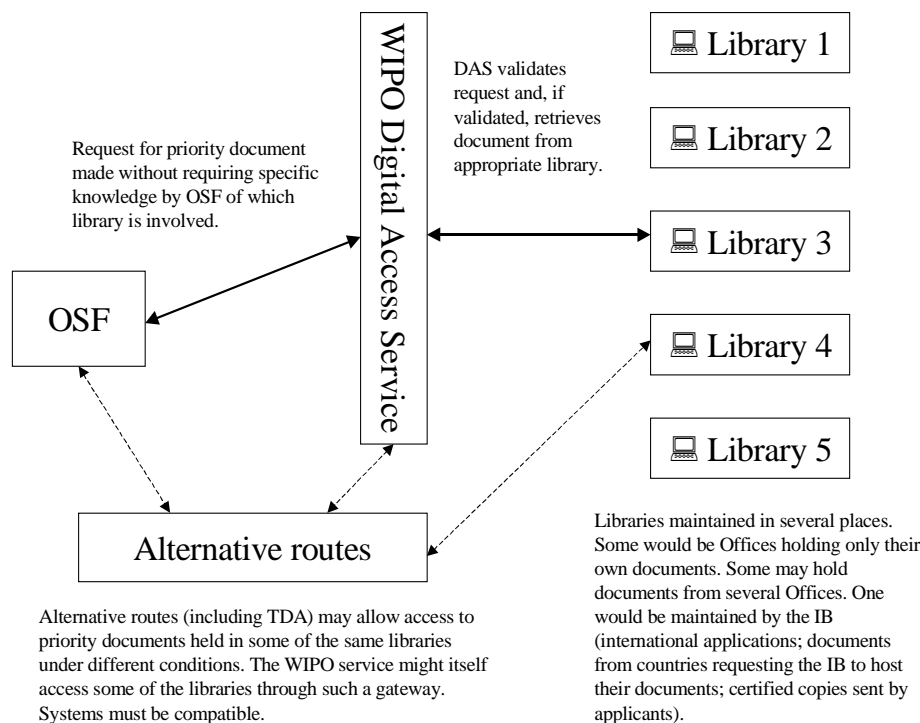
- (i) The fundamental requirement is to allow applicants to meet priority document requirements of Offices of second filing without having to physically obtain and submit certified copies with each of them.
- (ii) The system will enable voluntary participation by Offices from any Paris Union Member State, regardless of membership of other Treaties, taking into account the different capacities of Offices.
- (iii) Offices will be able to choose to obtain priority documents under an arrangement with the International Bureau as an alternative to multiple bilateral arrangements.
- (iv) The system must provide performance improvements and efficiencies for applicants, Offices and the International Bureau over traditional Paris Convention and paper-based arrangements.

“2. Network model

- (i) *Non-duplication of systems:* The system will make use of digital libraries in which Offices hold priority documents. The International Bureau’s digital library will hold priority documents from Offices which do not maintain their own.
- (ii) *Interoperability:* Common protocols and meta-information will be used to ensure that priority documents can be accessed in the same manner

irrespective of the digital library in which they are held, be it the International Bureau's, under TDA, or another.

*Conceptual Diagram of Networked System
(Access by Office of Second Filing)*



- “3. *Flexibility:* The system will allow a wide range of combinations of packaging channels (including paper, physical media (CD-R and DVD), SFTP and TDA) and document format (including paper, ST.36, PCT minimal specification (based on PDF and TIFF) and SDIF) in order to ensure that all existing systems for exchanging priority documents are accommodated. The system will permit the transformation of format in order to facilitate interoperability.
- “4. *Secure data transmissions:* The security of data transmissions will be at least equivalent to the levels that apply in the systems operating in the context of the PCT for the exchange of sensitive data.
- “5. *Confidentiality:* There must be an appropriate mechanism, in relation to priority documents that are not publicly available, for ensuring that access is given to Offices of second filing only where authorized by the applicant. One possible mechanism would rely on the use of an access code issued to the applicant, but other possible mechanisms need to be explored and evaluated so as to achieve minimum burden for Offices and applicants.
- “6. *Translations and other documents:* The system will enable applicants to deposit certified translations of priority documents in a digital library for making them accessible to Offices of second filing under generally similar arrangements to those for priority documents. Further work is needed to address the implications of different Offices' certification requirements for translations, the possibility of

obtaining translations from other sources, and the possible use of the system for other associated documents, for example, documents confirming the right of priority, in particular where the right is transferred to other persons.

“7. *Efficiency*

- (i) *Avoid duplication:* Duplication of work, data holdings and information between the International Bureau and Offices will be avoided. This applies in particular to existing digital libraries such as under TDA arrangements.
- (ii) *Improve technical capacity:* The system will be geared to handle large volumes of data and data transmissions, with appropriate speed of uploading and downloading, with built-in flexibility to cater to potentially increased needs in the future.
- (iii) *Transparency:* WIPO’s website will provide up-to date details about the system, including the conceptual framework, the nature and scope of participation by Offices in the system, the location of priority document holdings, Office requirements and operational details, including changes in those things.

“8. *Developing countries:* The International Bureau will provide technical assistance and adequate capacity building to developing countries, in particular least developed countries, based on discussion of their individual needs, to facilitate their participation in the system.

“9. *Charges:* The International Bureau will not charge a fee for use of the service.”

18. The Delegation of the United States of America reserved its position as to the possible use of the new service for making available documents relating to assignments of rights (see item 6 in the agreed principles set out in paragraph 17, above).

19. Certain other matters on which comments or clarifications were made during the discussions, apart from matters encapsulated in the agreed principles set out in paragraph 17, above, are noted in summary form in the following paragraphs.

20. *Contents of digital libraries:* It was confirmed that the digital access service would allow Offices to retrieve the full priority documents from the digital libraries, not only bibliographic details. The priority documents themselves would, of course, be in their original languages. The system would need to handle translations eventually, even if this was not part of the initial system. However, further consideration was needed of the best way to treat them, noting that they were not documents of record in the same way as the original documents.

21. *Certification:* It was clarified that it was envisaged that both priority documents and translations loaded into digital libraries under the new service would be available. When access to a priority document was obtained under the service by an Office of second filing, the Office would be obtaining a copy of the certified original, the validity of the copy being assured by the fact that it had been obtained under the service administered by the International Bureau. In that respect, the procedure would be the same as that which had long

operated successfully under the PCT in relation to priority documents. The available procedures for certification of priority documents (as distinct from translations, for which different requirements applied) should be understood in accordance with the agreed understanding adopted in 2004 by the Assemblies of the Paris Union and the PCT Union (reproduced in Part E of the Annex to document WIPO/DAS/PD/WG/1/2).

22. *Submission direct by applicants:* It was noted that further consideration was needed of what procedures should apply when priority documents and translations thereof were submitted direct by applicants for uploading into a digital library under the service.

23. *Period of availability of documents via the service:* It was noted that priority documents may be needed after the grant of a patent, and the service should accordingly provide for access for at least as long as the term of the relevant patents claiming priority. It needed to be recognized that, particularly in a distributed system such as was proposed, long-term availability of documents could not be absolutely guaranteed, and provision needed to be made to govern what could be done if a particular document ceased to be available. Offices of second filing would always be entitled, in such cases, to request the applicant to provide it, but applicants should not be penalized if they had complied with the requirements for making documents available via the service.

24. *Priority documents becoming publicly available:* It was noted that authorization of access by an Office of second filing should not be needed after a priority document had become publicly available (see also paragraph 38, below). The question whether third parties should have access via the service to publicly available priority documents needed further consideration, as did the ways in which a priority document might become publicly available.

25. *System capacity:* In response to concerns expressed about the speed of access to certain PCT services on which the system might be based, the Secretariat explained that this was not an issue of capacity of PCT systems themselves, but of limitations on Internet bandwidth between certain parts of the world. Nevertheless, the International Bureau was investigating possible arrangements with a third party Internet distribution supplier to improve data delivery to affected regions.

26. *Technical assistance and capacity building:* The Secretariat explained that WIPO's program for Office automation assistance had significantly evolved over the past few years. The Industrial Property Automation System (IPAS) common software, which automated the business processes of industrial property Offices, was provided to Offices free of cost, together with technical and financial assistance for its deployment. At present this software was being used by about 35 Offices. It was regularly maintained by way of updates and additional modules to extend its functionalities. The software was being migrated to the Java platform, which would allow its use through a web browser and provide greater flexibility for further enhancements. The deployment methodology was continually being refined, and WIPO provided post-deployment assistance and training to Offices. WIPO had also developed a methodology for assisting Offices in digitizing their records and, as a result, in developing comprehensive databases.

27. *Changes in national laws and regulations:* It was noted that certain aspects of the operation of the new service may need to be implemented by changes in national laws (in particular, the need for recognition of priority documents obtained via the service for the purpose of meeting Paris Convention requirements in relation to priority documents). It

seemed likely that such changes would be needed to regulations rather than the parent patent laws. The Secretariat confirmed its preparedness to provide advice and assistance in this respect to Offices which so requested.

Technical breakout sessions

28. Informal breakout sessions, in which all delegations were invited to participate, were held with the aim of considering some of the technical issues involved in the new service. At the invitation of the Chair, the Delegation of Canada outlined to the Working Group the main points that had been discussed in the first breakout session. The discussions had centered on two main components, namely, flow of data and control of access by Offices of second filing.

29. In relation to *flow of data*, the breakout session had identified a number of scenarios which needed to be considered, including the following:

(i) where the Offices of first and second filing were both part of a system covered by a different bilateral or multilateral agreement, such as TDA, in which case WIPO's digital access service would not need to be used, although its use would not be excluded;

(ii) where the Office of first filing communicated electronically with the International Bureau and maintained its own digital library;

(iii) where the Office of first filing communicated electronically with the International Bureau and did not maintain its own digital library;

(iv) where the Office of first filing did not communicate electronically with the International Bureau and paper documents needed to be sent;

(v) where the applicant wished to submit translations to the system; and

(vi) where it was desired to make corrections of errors in priority documents and notify the corrections to Offices of second filing which had already accessed the incorrect version (for example, if it was found that a page had been missed when the document was scanned by the Office of first filing or the International Bureau).

30. In relation to *access control*, the breakout session had considered various options covering ways in which the applicant might specify which Offices were permitted to access the priority document. Most of the discussion had focussed on a system under which the International Bureau issued a code to the applicant. Further possibilities were identified for the use of such a code, beyond that outlined in document WIPO/DAS/PD/WG/1/5 whereby the applicant would provide the code to Offices of second filing for use in requesting access. One such possibility was that the applicant could use it to access information about the status of the priority document within the system. Another possibility was for use of the code by the applicant to establish and maintain a list of those Offices of second filing that were permitted to access the priority document, in which case the list would be used by the service as a means of validating requests for access by Offices of second filing, the applicant would be relieved of the need to quote the code with each later filing, and Offices of second filing would not need to store or use the code to gain access.

31. Diagrams illustrating the data flow scenarios and further possibilities for use of the code, as outlined in paragraphs 29 and 30, above, were made available to delegations and would be posted on the priority documents electronic forum on WIPO's website.

32. The Chair noted that those present at the breakout sessions had found them very useful, and suggested that they take place again at the Working Group's next session in order to better prepare the matters discussed for consideration by the Working Group, although of course it remained a matter for the Working Group to agree on a recommended system architecture. Delegations were encouraged to participate in further consideration of the matters via the electronic forum.

ORGANIZATIONAL STRUCTURE

33. The Chair noted that, while certain issues relating to organizational structure had arisen in connection with the consideration of the system architecture (see above), other such issues would depend on the system architecture that would eventually be agreed upon by the Working Group.

34. The Working Group agreed to defer more detailed consideration of organizational structure to its next session.

TECHNICAL AND LEGAL CONSIDERATIONS

35. The Working Group had before it document WIPO/DAS/PD/WG/1/5, paragraph 22 of which outlined certain technical considerations that the Secretariat felt needed to be addressed, and documents WIPO/DAS/PD/WG/1/3 and 4, which set out, respectively, draft framework provisions and a draft model agreement between a participating Office and the International Bureau.

36. Certain technical and legal considerations are mentioned above in connection with the matter of the system architecture of the new service.

37. The Secretariat suggested that the legal framework necessary for the new service might be established by expanding the agreed principles set out in paragraph 17, above, for subsequent adoption as recommendations by the Working Group, rather than by establishing separate framework provisions as had been proposed in document WIPO/DAS/PD/WG/1/3. Moreover, it might be more appropriate for Offices to confirm their participation in the new system under less formal arrangements than agreements with the International Bureau.

38. In response to a question by one delegation in connection with Article 4(4) of the draft framework provisions, the Secretariat suggested that consideration needed to be given by the Working Group to the possibility that a priority document accessible under the service could be made publicly available upon notification by an Office of second filing that it had become publicly available under the provisions of the national law applied by that Office (see also paragraph 24, above).

39. Two delegations expressed the view that the reference in Article 5(2)(i) of the draft framework provisions to Article 4D(3) of the Paris Convention was too specific, leading to uncertain legal implications, notably regarding the interaction with PLT Rule 4(3), and suggested that wording similar to that used in the provisions of the PLT and the PLT

Regulations dealing with compliance with Paris Convention requirements where priority documents are available from a digital library might be preferable.

40. The Working Group agreed to defer more detailed consideration of technical and legal considerations to its next session.

41. The Secretariat informed the Working Group of its intention to review the legal framework with a view to proposing inclusion of necessary provisions in an expanded version of the agreed principles set out in paragraph 17, above, for consideration by the Working Group at its next session.

FUTURE WORK

42. The Secretariat informed the Working Group that it was envisaged that the second session of the Working Group would be convened from April 30 to May 3, 2007, that is, in the week following the ninth session of the Working Group on Reform of the PCT.

43. The Working Group unanimously adopted this report on February 9, 2007.

[Annex follows]

ANNEX

COMMENTS FROM THE EPO, THE JPO AND THE USPTO
ON DIGITAL ACCESS FOR PRIORITY DOCUMENTS

SUMMARY

1. The European Patent Office (EPO), the Japan Patent Office (JPO) and the United States Patent and Trademark Office (USPTO) welcome the initiative of the IB to set up an international framework for a digital access for priority documents. This initiative is in line with the Agreed Statement of the PLT Diplomatic Conference aiming at enhancing efficiency in the processing of priority documents to the maximum benefit of applicants and patent Offices, both under national procedures and under the PCT. The three Offices believe such a service should be free of charge for users.
2. The three Offices support the establishment of a network-based system for the exchange of priority documents. Indeed, the three Offices have already developed a system of exchange of priority documents which proves to be very successful and, in order to save time and resources, it is suggested that the new international system for a digital access to priority documents be consistent with such existing system. Within that framework, the IB would have a critical role as the interface with the Offices (and their users) which do not have digital libraries for priority documents already in place. In parallel to this, the EPO, the JPO or the USPTO could play a key regional role for the WIPO in this project.
3. It is suggested that the Working Group concentrates its efforts on agreeing on the main features of the new system rather than on discussing the particulars of the envisaged framework in document WIPO/DAS/PD/WG/1/3.

EXPERIENCE AT THE EPO, THE JPO AND THE USPTO ON THE EXCHANGE OF
PRIORITY DOCUMENTS

4. The EPO, the JPO and the USPTO have put in place a system of exchange of priority documents under the Trilateral Document Access (TDA) framework. The three Offices are pleased to inform the Working Group about the TDA and express their willingness to further cooperate with WIPO and other Offices on the establishment of an international digital access service for priority documents which would be consistent with the TDA.

What is the TDA?

5. The TDA is a system-to-system interface that enables effective mutual access to the electronic dossier of each of the three Offices members of the Trilateral cooperation (EPO, JPO, USPTO), and the retrieval of dossier images with associated bibliographic data, and *exchange priority documents electronically*. The exchange of patent information and priority documents between the three Offices is thereby significantly improved.
6. The TDA represents a set of business functionalities implemented as services based on the SOAP and Web Services. These services allow exchange of information related to patent applications in a decentralized and distributed environment, independently of both platform and language of programming. TDA services are subdivided into two sub-projects depending on their business and mode of exchange:

- *File Wrapper Access (TDA-FWA)*: this is a synchronous transmission typically initiated by an examiner browsing through an application. The contents are returned as single pages in TIFF format allowing the examiner to quickly navigate from page to page. TDA-FWA only allows access to published applications, with no current plans to access unpublished data.
- *Priority Document eXchange (TDA-PDX)*: this is an asynchronous transmission of a group of documents that make up a priority document. The documents are combined into a single PDF file which is digitally signed for authenticity. The documents are *automatically* ordered and loaded into the requestor's system. As of now, TDA-PDX retrieves published and unpublished priority documents.

Implementation and consolidation of the TDA

7. The Office-to-Office exchange of priority documents is in place since 1998 between the EPO and the JPO. The TDA project has defined the common Trilateral specifications for those exchanges including USPTO. The TDA will be extended to the exchange of priority documents between the EPO and the USPTO by the first quarter of calendar year 2007, and between the USPTO and the JPO by the third quarter of calendar year 2007.
8. The TDA-PDX covers the exchange of patent and utility model applications from which priority is claimed. It encompasses any priority document available in the automated electronic record management systems of the participating Offices, including applications first filed with the Offices themselves as well as certified electronic copies of priority documents originating from other Offices and either obtained by an Office through electronic means, or supplied by the applicant and loaded into the Office's automated system.
9. Where in a subsequent application, an applicant claims the priority of a first filing at the Office of First Filing (OFF), or requests a priority document originating from another Office and contained in the OFF's file, the Office of Second Filing (OSF) requests on the applicant's behalf the retrieval of the priority document(s) thus identified by the OSF. Unpublished files may be made available only at the applicant's request. The OFF should then transmit to the OSF a certified copy of the priority document(s) as identified in the subsequent application through the TDA system. Where the OSF has received a priority document from the OFF through electronic exchange in a timely manner, the applicant is deemed to have fulfilled his obligation to file a copy of that priority document.

[End of Annex and of document]