

ANNEX

SURVEY ON THE PRESENTATION OF PRIORITY APPLICATION NUMBERS

Introduction

1. The application number of the first filing of a patent application and the WIPO Standard ST.3 two-letter code of the country or organization where the said application was filed are used, respectively, to identify the so-called priority application in accordance with the Paris Convention for the Protection of Industrial Property and the country or organization where the priority application was filed. Application numbers, priority application numbers and WIPO Standard ST.3 codes are bibliographic data concerning patent documents widely used for information purposes in patent documents, official certificates, official gazettes, databases, etc.

2. A clear and unambiguous presentation of patent application numbers, and in particular of priority application numbers, is considered necessary and of great importance by industrial property offices (IPOs) and applicants, as well as by patent information providers and users. In order to ensure accurate and consistent references to priority application numbers, and to reduce the risk of error in subsequent applications, IPOs must present priority application numbers in a way that is clearly understood by all applicants. This clarity becomes crucial when presenting the application number in the notification of the first filing and when presenting the application number of a patent document in the certificate of priority.

3. WIPO Standard ST.10/C provides recommendations concerning the presentation of bibliographic data components of published patent documents. In particular, paragraph 12 sets out the following recommendations concerning the presentation of priority application numbers:

“12. (a) In order to improve the quality of patent family data and to avoid confusion in the presentation of priority application numbers, the following recommendations are made:

Industrial property offices (IPOs) should always provide priority application numbers complying with the “Recommended Presentation in Abbreviated Form as a Priority Application Number” given in the Appendix to the Standard ST.10/C, when presenting the application number of a patent document in the notification of the first filing and in the certificate of priority. The “Recommended Presentation in Abbreviated Form as a Priority Application Number” should be presented with the Standard ST.3 code (preferably in a specified line or column along with the title “The country code (in case of the international organization, ‘The organization code’) and number of your priority

application, to be used for filing abroad under the Paris Convention, is”) to be easily recognized as the priority number by other IPOs and applicants.

Example of presentation of “Recommended Presentation in Abbreviated Form as a Priority Application Number”:

(i) in case of the country:

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is JP2000-001234

(ii) in case of the international organization:

The organization code and number of your priority application, to be used for filing abroad under the Paris Convention, is EP79100953

(b) IPOs should encourage and facilitate the compliance by applicants of paragraph 12(a) of WIPO Standard ST.10/C when providing the priority application number in subsequent filings.”

4. The present survey of IPOs to determine their compliance with the provisions of paragraph 12(a) of WIPO Standard ST. 10/C has been prepared by the International Bureau (IB) on the basis of the replies to the questionnaire distributed along with Circular SCIT 2619, dated January 31, 2006. The survey presents the information provided by the following 33 IPOs: AM, AT, AU, BY, CA, CR, CU, CZ, DE, EE, ES, GB, GC, GE, GT, HU, IE, JP, KG, KR, LT, MD, MG, MX, PL, RU, SD, SE, SK, TH, TT, UA, and US.

5. The Appendix to the survey, for the purpose of informing as to how to proceed with regard to the priority application numbers of different offices, contains examples of copies of notifications of the first filing and certificates of priority of patent applications used by IPOs.

SURVEY RESULTS

Notifications of the first filing

6. Question 1(a): Does your Office/Organization comply with the provisions of paragraph 12(a) in WIPO Standard ST.10/C when presenting the application number of a patent document in the notification of the first filing?

Yes: CU, ES, GB, GE, IE, LT, TH, TT, US. (9)

No: AM, AT, AU, BY, CA, CR, CZ, DE, EE, GC, GT, HU, JP, KG, KR, MD, MG, MX, PL, RU, SD, SK, UA. (23)

Remarks:

AT: The formats used by the Office are as follows:

Patents: A 1234/2000
Utility models: GM 1234/2000
SPC: SZ 1234/2000
Topographies: HL 1234/2000
Trademarks: AM 1234/2000
Designs: MU 1234/2000

Each year, the Office starts a serial number starting with 1 for every kind of application. (For example, A 1/2006, GM 1/2006, AM 1/2006, etc.) The Office plans to introduce SOPRANO in 2007; it is not sure whether it will be able to keep this, or will have to change this practice at least in order to have a common series for patents, utility models and perhaps also for Supplementary Protection Certificates (SPCs).

CA: The Office currently does not include the WIPO Standard ST.3 country code within the application number.

DE: The applicant receives the application number from the Office which is identical to the publication number. An example of such an application number is 10 2005 012345.6, which complies with WIPO Standard ST.10/C, except for the leading country code.

ES: The letters P (patent for invention) and U (utility model) are used before the application number to denote the type of industrial property right.

- GC: The current format of a patent application number filed at the Office is as follows: GCC/P/4-digits Year No./Serial No. (e.g., GCC/P/2002/2304). This is the format in which the application number of a patent document is currently presented whether in the notification of the first filing or in the certificate of priority.
- KR: The Office does not present the priority application number in the notification of the first filing because the Office does not have an individual numbering system for priority application numbers. When necessary, the Office just uses the application number similar to that of its domestic publications and notifications, excluding the country code “KR”, for example “10-2006-0123456”.
- RU: The Office does not issue the notifications of the first filing themselves. Instead of using such notifications, the Office prints the date of filing on the inventor's copy of the application and adheres a label with an application number. Its application number format and “Recommended Presentation in Abbreviated Form as Priority Application Number” are the same.
- SD: In the case of PCT applications, the international application number is written as follows: e.g., PCT/SD 2004/000001. The Office does not have a model form for notification of the first filing.
- TT: Initially issued on hand-written forms and later on issued correspondence. Not available electronically.

7. Question 1(b): If the answer to Question 1(a) was “NO”, is your Office/Organization planning to implement the said paragraph 12(a) in the notifications of the first filing? If so, when?

Yes: AM on July 1, 2006; BY on January 1, 2007; CA (6-12 months); CR in 2006; GC in 2006; GT on May 2, 2006; MD on April 1, 2006; MG, MX in January 2007; PL on May 1, 2006; SD, SK on January 1, 2007. (12)

No: AT, AU, CZ, DE, EE, HU, JP, KG, KR, RU, UA. (11)

Remarks:

AT: At the occasion of this questionnaire, the Office considered introducing a presentation of the application number more compliant with the recommendation by simply changing a sentence of the notification of the first filing:

– Recent version of the sentence:

(We recommend writing the priority application number in the form given by the Austrian Patent Office)

(Es wird empfohlen, bei Auslandsanmeldungen das Aktenzeichen Ihrer prioritätsbegründenden Anmeldung ausschließlich in dem vom österreichischen Patentamt vergebenen Format anzugeben.)

– Planned version of the sentence:

(When taking this application as priority application, please write the number of this application in the form AT2000-012345).

(Sollte diese Anmeldung prioritätsbegründend für Auslandsanmeldungen werden, so wäre im Ausland das Aktenzeichen als AT«AnmJahr»-«AnmNummer» anzugeben.)

The formats planned to use were

(see <http://www.wipo.int/scit/en/standards/pdf/03-13-01.pdf>):

patents: AT2000-001234

utility models: AT2000-001234 U

SPC: AT2000-001234 C

Topographies: AT2000-001234 T

Trademarks: AT2000-001234 TM

Designs: AT2000-001234 S

However, the implementation of this new practice when delivering priority certificates could mean that the applicants would risk having problems when the format of the application number on the cover page of the priority certificate is not exactly the same format as the stamped number on the application. As the stamped

format does not comprise the country code "AT" and, furthermore, the order of application number and application year is inversed compared to the recommendation (see above), the AT2000-1234 format is not mentioned on the notifications, nor on the priority certificates.

From the technical point of view, it would be easy to indicate the application number in the format AT2000-001234, as the programs are prepared for it for the filing notifications, and the first page of the priority document is prepared in Word manually; that is, the application number is keyed in for each document.

The bigger problem seems to be that of completely introducing a new format in the Office (new stamps, and especially getting used to a few practice after so many years). But on the other hand, the Office plans to start with SOPRANO as a workflow for patent and utility models in 2007, so perhaps this could be taken as an occasion to change the stamped format of the application numbers too. For this, in addition to the answers to the questionnaire, the Office would like to hear about similar experiences, arguments and reasons for such a change, as this discussion could be helpful in order to "introduce" the new format together with SOPRANO. Please send comments regarding the said experiences to the e-mail katharina.fastenbauer@patentamt.at

- BY: If nothing changes when implementing the said paragraph 12(a), the application numbers will be as follows: Byu 20071234 or Byu 20071234.
- CA: Any changes to the IT systems need to be prioritized and worked on at an appropriate time.
- CR: The Office intends to implement paragraph 12(a) in notifications of the first filing in the second half of 2006.
- CZ: The Office does not use "the notification of the first filing".
- DE: The Office views the notification as an internal receipt issued by the Office to the applicant. For official documents, the country code will be included, see Question 2(a), below.
- GC: The Office plans to implement the said paragraph 12(a) after the Office's new patent applications integrated computer system - under construction - becomes ready in the year 2006. The intended format of a patent application number is: GC4-digits Year No./7-digits Serial No. (e.g. GC2002/0002304). Note: the 7-digits serial number is accumulative regardless of the year number.
- GT: The implementation is a work in progress.

- HU: The current Hungarian record limit is shorter in the Office's database.
- JP: The Office does not have a concrete plan to change the format for the notification of the filing at this time. The Office electronically processes the notification of the filing, and system developments required for modification of the format for notification could cost time and money. The Office fully understands the importance of properly indicating the application number in the notification of filing; however, the change of the notification of the first filing seems relatively less urgent since applicants usually refer to the priority certificate but not to the notification of first filing when they prepare their filing documents of foreign applications.
- KR: The Office does not have a plan for the implementation of the said paragraph 12(a). However, to apply the provision to the KR numbering system, the Office needs to amend relevant regulations and forms and upgrade the computer programs after an internal review and discussion.
- MX: A technical evaluation will be performed in order to modify the automated system.
- RU: Since only less than 10% of applicants in the Russian Federation file subsequent applications for the same or related subject matter abroad in accordance with the Paris Convention, the Office does not plan to implement paragraph 12(a) in the notification of the first filing in the near future.
- SK: The Office intends to implement paragraph 12(a) in notifications of the first filing by the end of the year 2006.
- UA: The Office is studying the possibility of the implementation of paragraph 12(a) in the notifications of the first filing.

Certificates of Priority

8. Question 2(a): Does your Office/Organization comply with the provisions of paragraph 12(a) in WIPO Standard ST.10/C when presenting the application number of a patent document in the certificate of priority?

Yes: CA, CU, DE, ES, GB, GE, IE, JP, LT, RU, TH, TT, US. (13)

No: AM, AT, AU, CR, CZ, EE, GC, GT, HU, KG, MD, MG, MX, PL, KR, SD, SK, UA. (18)

Remarks:

AT: See answer and remarks concerning Question 1, above.

CA: The Office changed their certification of priority document effective March 6, 2006, to include the WIPO Standard ST.3 country code to be compliant with WIPO Standard ST.10/C, e.g., CA2123123. Any documents prior to this date will be in the old format without the WIPO Standard ST.3 country code.

DE: Currently, the priority number complies with WIPO Standard ST.10/C except for the country code. The Office is in the process of implementing this addition, which it expects to have in place in several months. Please find a draft example of the cover page of a priority document in the Appendix to this Survey.

GC: The current format of a patent application number filed at the Office is as follows: GCC/P/4-digits Year No./Serial No. (e.g., GCC/P/2002/2304). This is the format in which the application number of a patent document is currently presented whether in the notification of the first filing or in the certificate of priority.

JP: The Office has changed the format of the priority certificate to comply with WIPO Standard ST.10/C as of April 1, 2005.

KR: See answer and remarks concerning Question 1(a), above.

RU: The Office provides a special certificate to the applicants inquiring a copy of the priority application for the abroad filing. In this certificate, the recommendations of paragraph 12 (a) are included.

SD: The Office does not have a model form for the certificate of priority.

TT: Initially issued on hand-written forms and later on issued correspondence. Not available electronically.

9. Question 2(b): If the answer to Question 2(a) was “NO”, is your Office/Organization planning to implement the said paragraph 12(a) in the certificates of priority? If so, when?

Yes: AM on July 1, 2006; AU, CR in 2006; CZ in September 2006; GC in 2006; GT on May 2, 2006; KG on April 1, 2006; MD on April 1, 2006; MG, MX in January 2006; PL on May 1, 2006; SD, SK on January 1, 2007. (13)

No: AT, EE, HU, KR, UA. (5)

Remarks:

AT: See answer and remarks concerning Question 1, above.

AU: The Office has not yet scheduled the change.

CR: The Office intends to implement paragraph 12(a) in the certificates of priority in the first half of 2006.

GC: The Office plans to implement the said paragraph 12(a) after the Office's new patent applications integrated computer system - under construction - becomes ready in the year 2006. The intended format of a patent application number is: GC4-digits Year No./7-digits Searial No. (e.g., GC2002/0002304). Note: the 7-digits serial number is accumulative regardless of the year number.

GT: The implementation is a work in progress.

KR: See answer and remarks concerning Question 1(b).

HU: Currently, the application number used in the Office contains a character showing the kind of protection too.

MX: A technical evaluation will be performed in order to modify the automated system.

PL: Copies of filing notifications and priority certificates will be sent after the implementation of the said paragraph 12(a).

SK: The Office intends to implement paragraph 12(a) in the certificates of priority by the end of the year 2006.

UA: The Office is studying the possibility of the implementation of the paragraph 12(a) of WIPO Standard ST.10/C in the certificates of priority.

Comments and conclusions

10. Paragraphs 1 and 2, above, refer to the reasons for emphasizing the importance of recording priority data accurately and consistently. The critical need to implement the recommendations set out in paragraph 12 of WIPO Standard ST.10/C, i.e., the importance of avoiding confusion in the presentation of priority application numbers in order to improve the quality of patent family data, is also explained in paragraph 11 of the said Standard, which reads as follows:

“11. Priority application numbers are provided to applicants by industrial property offices in the notifications of the first filing and in the certificates of priority under the Paris Convention. Priority application numbers are then cited by applicants when filing a subsequent application for the same or related subject matter before a subsequent industrial property office in accordance with the Paris Convention. The priority application number can then be used by industrial property offices to link all related patent document “families” together in databases and computerized search systems. This ability to create patent families is tremendously valuable to industrial property offices for examination purposes, for example, when a better date of filing is needed during the prosecution of a later unrelated application. Patent families also permit patent examiners to review previously published patent documents in a preferred language, if available. Patent families can help offices save significant classification resources (financial, staffing, etc.) by allowing industrial property offices to use the classifications of one patent family member for all members of the patent family.

These and other uses of patent families make the accurate recording of the priority application number by applicants a critical concern of all industrial property offices. Even small deviations from the correct priority application number format can cause patent documents not to be collected into a patent family. Correction of errors in priority data cause huge expense for industrial property offices. Therefore, it is critical that the provisions of this section of the Standard be implemented by IPOs as soon as possible.”

11. Most of the Offices that completed the questionnaires on the implementation of paragraph 12(a) of WIPO Standard ST.10/C reported either their compliance with the provisions of that paragraph, or their plans to comply with them in both the notifications of the first filing and the certificates of priority in 2006 or in the beginning of 2007. The number of Offices that already comply with the provisions of the said Paragraph 12(a) are nine for the notifications of the first filing, and 13 for the certificates of priority. The Offices reporting plans to implement the provisions are 12 for the notifications of the first filing, and 13 for the certificates of priority. This means that 21 Offices out of 32 have already implemented or intend to implement the provisions in the notifications of the first filing, and 25 out of 31 in the certificates of priority.

12. Among the Offices that do not yet comply with the provisions of paragraph 12(a) in the notifications of the first filing or in the certificates of priority, the number of offices that intend to implement them in 2006 or the beginning of 2007, is greater than the

number of offices that do not have yet any plans to implement them. Among the 23 Offices which have not yet implemented the provisions for the notifications of the first filing, 12 Offices reported plans to do so and 11 did not. With regard to the priority certificates, among the 18 Offices which have not yet implemented the provisions, 13 Offices intend to do so and five Offices did not report any such plans.

13. In the previous version of WIPO Standard ST.10/C, there was no recommendation equivalent or similar to that given in current paragraph 12(a). The addition of the new paragraph 12 to WIPO Standard ST.10/C, as well as the preparation of the responses to the questionnaire, have given IPOs an occasion to consider and discuss the implementation of a new practice aiming at facilitating accuracy and consistency by applicants when presenting priority application numbers in their filings abroad under the Paris Convention.

14. The results of the survey allow for a certain optimism regarding compliance with the said paragraph 12(a), since the implementation of the recommendations is either already a reality or a work in progress in many IPOs (see paragraph 11, above); however, it should be emphasized that further efforts should be made to encourage IPOs to implement the said recommendations. The current practices by IPOs, as described in their responses to the questionnaire and showed by the example copies of filing notifications and priority certificates provided by the IPOs, indicate that a relevant number of IPOs do not yet provide application numbers complying with paragraph 12(a) in order to avoid confusion in the presentation of priority application numbers (see paragraph 12, above). It should be noted that there have been more advances made in implementing the recommendation concerning priority certificates as compared to that concerning notifications of the first filing. Hopefully, the information and examples provided in this survey will encourage and help IPOs, which have not yet done so, to join the group of IPOs that are already compliant with the provisions of paragraph 12(a).

[Appendix follows]