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STANDING COMMITTEE ON THE LAW OF PATENTS

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AVAILABILITY OF PRIORITY DOCUMENTS

document prepared by the International Bureau

Introduction

1. At the second session of the Standing Committee on the Law of Patents (SCP), the Delegation of the United Kingdom proposed, in document SCP/2/11, that, in order to ensure the access of third parties to copies of priority documents throughout the life of a patent, Article 5(5)(a) of the draft Patent Law Treaty (PLT) should be amended to read:

“(5) [*Priority Document*] (a) Subject to subparagraph (c), where the priority of an earlier application is claimed, a Contracting Party may require that a copy of the earlier application be furnished to the Office within the time limit prescribed in the Regulations.

(*abis*) Where a Contracting Party does not require a copy of an earlier application to be furnished in accordance with paragraph (5)(a) above, and if, at the expiry of 18 months from the claimed priority date, no copy of the earlier application has been furnished to its Office, that Office shall notify the Office at which the earlier application was filed of the existence of the later application, and the Office at which the earlier application was filed shall either:

(i) keep a copy of the earlier application for [30] years from its date of filing, and, upon demonstration that the later application has been published, supply copies of the earlier application to third parties on demand; or

(ii) furnish a copy of the earlier application to an approved document depositary which will, upon demonstration that the later application has been published, supply copies of the earlier application to third parties on demand.”

2. The discussions on this proposal are summarized in document SCP/2/13, paragraph 59, as follows:

“The Chair summarized the discussion as reflecting general support for the idea that priority documents be made accessible to third parties throughout the life of the patent which claimed the priority, and that third parties should not have to rely on the applicant or owner for copies of the original document. One possible solution might be to keep copies of priority documents in a digital library. It was agreed that the issue would be referred to the International Bureau for further study, with the option of discussing proposals through the electronic forum.”

Analysis

3. In view of the discussion at the second session of the SCP, it is apparent that the procedure in question should meet the following essential requirements:

(i) it should ensure the availability of priority documents by third parties from an official source throughout the life of a patent;

(ii) it should not impose significant costs and burden on Offices;

(iii) it should be effectively and rapidly implemented in a large number of countries.

4. Concerning requirement (i) above, as it was pointed out during the discussion at the second session of the SCP, the current proposal in document SCP/2/11 does not address the issue of whether a Contracting Party which has received a copy of a priority document is allowed to provide a copy to third parties. It would appear that the proposal could be further explored in this context.

5. As regards requirement (ii) above, during the second session of the SCP, some delegations considered that any obligation for an Office to enter into communication with another Office could be burdensome to the Offices. Another delegation pointed out the burden on Offices of maintaining all priority documents for 30 years.

6. The proposal of the Chair for a solution based on keeping copies of priority documents in a digital library would impose a minimal burden on Offices. The creation of an Intellectual Property Digital Library (IPDL) is already under consideration by the Standing Committee on Information Technologies (SCIT). It is envisaged that, in the first place, the IPDL would allow intellectual property offices to exchange electronic copies of administrative files such as priority documents in a secured network environment. It will require a pilot project by

interested offices and the International Bureau of WIPO to study legal, administrative and technical questions, once the SCIT adopts standards for the on-line exchange of administrative files (including unpublished files) and the sharing such files in the IPDL. The adoption of the standards is expected at the upcoming session of the SCIT in December 1999. The on-line exchange of such files needs robust technical solutions to satisfy the requirements for the data integrity, authentication and the data security. Under the current model, the access to an electronic copy of priority documents is limited to patent offices which adopt the agreed standards and security policy. After an international mechanism is put in place for the electronic exchange and sharing of priority documents by the participating patent offices in the IPDL, the patent community may wish to expand the access to any authorized third parties. At present, without knowing the result of the first pilot project, it seems premature to discuss to what extent the access could be expanded and what business model should be explored.

7. Another question is whether a mechanism ensuring the access to copies of priority documents would be established under the PLT or under other forms of rule setting. This question should be considered taking into account the effective and rapid implementation by a large number of countries as described in paragraph 3 above. Were such a mechanism to be included in the draft PLT, implementation of that mechanism would only be effective if all countries concerned were parties to the PLT. An alternative approach could be to refer the issue with a recommendation to the General Assembly of WIPO and the Assembly of the Paris Union for its adoption. This type of solution is already proposed in respect of the protection of well-known marks by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT). Alternatively, a Memorandum of Understanding (MoU) or similar instrument that could be signed by the Offices concerned may be envisaged.

Suggestion

8. It is therefore suggested that a mechanism to ensure the access to priority documents by third parties utilizing, for example, the IPDL be further considered by the SCP, as a self-contained subject outside of the discussions concerning the draft PLT. The ongoing discussion under the SCIT for the creation of an IPDL should also be taken into account.

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