

Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

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INFORMATION ON THE DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS (DAS)

Document prepared by the Secretariat

INTRODUCTION

1. At the thirty-fifth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from April 25 to 27, 2016, the Chair of the SCT took note of the request submitted by the Delegation of the United States of America to ask the Secretariat to present information on the Digital Access Service for Priority Documents (DAS) at the next session of the SCT (see document SCT/35/8 Prov., paragraph 121).
2. Accordingly, the Secretariat has prepared the present document, which provides background information on the DAS and summarizes the work of selected World Intellectual Property Organization's (WIPO) Committees and Working Groups on the extension of the DAS to priority documents for other intellectual property rights (IPRS).

I. BACKGROUND INFORMATION

3. Pursuant to Article 4D(3) of the Paris Convention for the Protection of Industrial Property (hereinafter "the Paris Convention"), the countries of the Union may require any person making a declaration of priority to produce a certified copy of the application previously filed, from which priority is claimed ("priority document").

4. The DAS is an electronic system allowing the secure exchange of priority documents and similar documents between Intellectual Property (IP) Offices which participate in the system. It is a safe digital alternative to the filing of certified paper copies of priority documents with multiple Offices. Instead of asking an Office a certified paper copy of a first application so as to send it to other Offices where subsequent applications have been filed, the DAS allows the applicant to request the first Office (“the Depositing Office” or “the Office of First Filing”) to upload priority documents in the electronic system and to request other Offices (“Accessing Offices” or “Offices of Second Filing”) to retrieve those documents in the system, using an access code¹ provided by the applicant directly to the Offices of Second Filing. The access code ensures the confidentiality of priority documents that are not yet publicly available.

5. The DAS is operational since April 1, 2009, and is currently used for priority documents relating to patent applications only. The use of the DAS is voluntary for both applicants and IP Offices.

6. The Offices of Australia, China, Denmark², Finland, Japan, New Zealand³, Republic of Korea, Spain, Sweden, United Kingdom and the United States of America are participating in the DAS system, as well as the International Bureau of WIPO as far as the PCT is concerned⁴.

II. SUMMARY OF THE WORK OF SELECTED WIPO'S COMMITTEES AND WORKING GROUPS RELATING, OR REFERRING, TO THE EXTENSION OF THE DAS TO INDUSTRIAL DESIGNS PRIORITY DOCUMENTS

SCT

7. At the twenty-first session of the SCT, held in Geneva from June 22 to 26, 2009, the Secretariat presented the DAS. At the issue of that session, the SCT requested the Secretariat to prepare a working document, for consideration at its next session, examining the possible extension of the DAS to priority documents for industrial designs and trademarks (see document SCT/21/9, paragraphs 141 to 145).

8. At the twenty-second session of the SCT, held in Geneva from November 23 to 26, 2009, document SCT/22/7, entitled “Digital Access Service for Priority Documents”, was discussed. The Chair concluded that the SCT requested the Secretariat to advance work on the establishment of the DAS for priority documents for industrial designs and trademarks, in a way that would ensure the largest possible participation of interested Offices in such a service (see document SCT/22/9, paragraph 78).

9. At the twenty-third session of the SCT, held in Geneva from June 30 to July 2, 2010, the Chair noted that the Secretariat was requested to make a presentation concerning the state of work in the DAS for industrial designs and trademarks at the next session of the SCT (see document SCT/23/7, paragraph 63).

10. At the twenty-fourth session of the SCT, held in Geneva from November 1 to 4, 2010, discussions on the DAS were based on an oral briefing presented by the Secretariat. The Chair concluded that a number of delegations had taken note with satisfaction of the progress made so far towards the extension of the DAS to trademark and industrial design priority documents,

¹ The access code procedure was introduced on July 1, 2012.

² The Danish Patent and Trademark Office is the only Office which operates DAS services as a “Depositing Office” only.

³ As from May 30, 2016.

⁴ List of participating Offices as of June 21, 2016.

and took note of the future plans concerning the work. In this context, a possible extension of the system for digital registration certificates was likewise encouraged (see document SCT/24/7, paragraphs 9 and 10).

Working Group on the DAS

11. At its third session, held in Geneva from July 12 to 15, 2011, the Working Group on the DAS agreed that the service should be extended to other types of priority documents, including those for trademarks, industrial designs and utility models. It was in particular noted that each Office would be able to decide if and when to participate in the system (“opt-in”) for each type of IP right, depending on the types of rights which it administered, the needs and priorities of the Office, and any legal or technical preparations that may be necessary (see document WIPO/DAS/PD/WG/3/7, paragraphs 5 and 6).

12. Following the recommendations of the DAS Working Group, the Framework Provisions for the DAS, established on March 31, 2009, were modified on July 1, 2012. Since then, Article 25(iii) of the Framework Provisions for the DAS defines an “application” as an application for the grant of a patent, for the grant of a utility model, for the registration or grant of an industrial design, or for the registration of a trademark (including a collective mark or a certification mark). International applications filed under the Hague Agreement are included in the definition.

13. Moreover, the second version of the DAS (DAS 2.0) supports color, greyscale and large-sized images, initially in JPEG and TIFF formats, which are used in industrial design and trademark applications⁵.

14. Priority documents in relation to IPRs other than patents can now be exchanged through the system, subject to the participating Offices making the necessary operational and technical changes in their systems⁶.

Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs (hereinafter “the Hague Working Group”)

15. At the third session of the Hague Working Group, held in Geneva from October 28 to 30, 2013, document H/LD/WG/3/4 entitled “Digital Access Service for Priority Documents and Other Means of Transmission of Certain Types of Documents under Rule 7(5)(f) and (g) of the Common Regulations” was discussed. Within the Hague System, the DAS could be potentially used in two situations: (i) the first one is where an international application contains a priority claim from an earlier filing and the Office of first filing, as well as the Office of the designated Contracting Party, are both DAS participating Offices; (ii) the second one results from the fact that an international application may be a first application and thus serve as a basis for claiming priority with regard to a subsequent national or regional application outside the realm of the Hague System. In those circumstances, the international application itself could be uploaded into the DAS digital library (see document H/LD/WG/3/4, paragraph 14). At the issue of that session, the Chair concluded that, at that stage, it was premature for the Offices of Contracting Parties of the Hague System to consider committing themselves to the uploading and retrieval of priority documents via the DAS (see document H/LD/WG/3/8, paragraph 84).

16. At its fourth session, held in Geneva from June 16 to 18, 2014, the Hague Working Group considered it desirable to add to the Administrative Instructions for the Application of the Hague Agreement a new Section 408, entitled “Permitted Matters in the International Application and

⁵ <http://www.wipo.int/das/en/description.html>

⁶ <http://www.wipo.int/das/en/>

Permitted Documents Accompanying an International Application” (see document H/LD/WG/4/7, paragraph 45). As a result of the said consultation pursuant to Rule 34(1)(a) of the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement, the Director General of WIPO amended the Administrative Instructions for the Application of the Hague Agreement accordingly. Section 408(a)⁷ enables the applicant to indicate, in his/her international application filed under the Hague System, an access code to retrieve the priority documents concerned in the DAS system.

CONCLUSION

17. In addition to patents, the DAS now permits the exchange of priority documents relating to other IPRs, including industrial designs, trademarks and utility models. However, as of today, the DAS is not yet used in relation to priority documents for IPRs other than patents.

*18. The SCT is invited
to take note of the present document.*

[End of document]

⁷ Administrative Instructions for the Application of the Hague Agreement as in force since July 1, 2014.