



JAPAN PATENT OFFICE



WORKSHOP

WIPO-ASPEC-ASEAN/IP/SIN/14/INF/4

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Technical Requirements to Facilitate ASPEC Work Sharing and ASEAN IP Portal

organized by
the World Intellectual Property Organization (WIPO)

in cooperation with
the Intellectual Property Office of Singapore (IPOS)

and with the assistance of
the Japan Patent Office (JPO)

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MEETING REPORT

prepared by the International Bureau of WIPO

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LIST OF ACRONYMS USED

ASEAN	Association of South East Asian Nations
ASPEC	ASEAN Patent Examination Cooperation
AWGIPC	ASEAN Working Group on Intellectual Property Cooperation
CASE	Centralized Access to Search and Examination
EDMS	Electronic Document Management System
ICT	Information and Communication Technology
IPOBSD	IP Office Business Solutions Division
IP	Intellectual Property
IP5	Five IP Offices (China, Europe, Japan, Korea, United States)
IPAS	Industrial Property Administration System
JPO	Japan Patent Office
PCT	Patent Cooperation Treaty
USPTO	United States Patent and Trademark Office
WIPO	World Intellectual Property Organization

BACKGROUND

ASEAN IP offices have agreed to use the WIPO CASE system as a platform to support work sharing in the region, in particular to support the ASPEC program and the ASEAN IP portal. Three offices in the region (Malaysia, Singapore, Viet Nam) have joined the CASE system as accessing offices, but there is a need to explore several issues in more detail, including governance structure, data ownership and technical details of the system. In addition to the functions and features currently available on WIPO CASE system, the ASPEC meeting in May 2014, in Singapore identified requirements for a communication platform to link WIPO CASE and the ASEAN IP Portal so that participating examiners can interact in a virtual environment.

In order to support the ASPEC work sharing and ASEAN IP Portal initiatives, detailed discussion was needed on the technical requirements, business needs and policy options. In particular, WIPO needed to reach an agreement with the ASEAN IP Offices on their specific requirements to develop a regional communication platform. The workshop program was designed to bring together three officials from each ASEAN member country, responsible for international cooperation, patent examination and information technology management so that the different needs and interests of the participating countries would be represented.

The objectives of the workshop were to:

- Support patent work sharing initiatives in ASEAN, in particular ASPEC and Community of Practice.
- Review business, technical and policy issues on ASEAN work sharing.
- Identify technical requirements to support the specific needs of ASEAN IP Offices.
- Make progress on WIPO CASE accession and utilization in ASEAN.

WORKSHOP OVERVIEW

The workshop was attended by representatives of all 10 ASEAN countries, with speakers from Singapore, Viet Nam, WIPO, JPO and USPTO.

The format of the workshop was designed to present the current status of WIPO CASE System, Singapore's proposal on new technical and functional requirements to support the ASPEC program and WIPO's future plans and demonstration of the improved CASE system and proposed communication platform for the ASEAN IP Portal. JPO and USPTO speakers shared their views on work sharing initiatives, including PPH and IP5 cooperation including the One Portal Dossier (OPD) and its linkage with WIPO CASE. The final session was allocated for the discussions and recommendations for ASPEC work sharing and communication platform.

The workshop program, list of attendees, presentations and supporting documents are published on the WIPO public website at the following address:

(http://www.wipo.int/meetings/en/details.jsp?meeting_id=33562).

CURRENT STATUS OF WIPO SYSTEM FOR ASEAN

WIPO provides several IT systems to offices to assist them with the business of administration of applications for IP rights in the region. Those systems include IPAS, WIPOScan (for digitization, indexation and quality control of paper documents), and EDMS. Five ASEAN IP offices use the WIPO IPAS system and others have benefited from assistance with digitization. WIPO is broadening its services to include assistance with online services (publication, search and filing). WIPO CASE is one of the new services that enables offices to improve quality and productivity of patent examination.

The WIPO CASE system was established following a request from the Vancouver Group offices (Australia, Canada and UK) to create a platform for the sharing of patent search and examination documents. The initial pilot of the system was made available in March 2011, and

enhancements have been added to the system since then. So far, there are 11 participating offices in the WIPO CASE, including 6 depositing offices (Australia, Canada, China, Israel, PCT/IB and UK), and 5 accessing offices (Malaysia, Mongolia, New Zealand, Singapore and Viet Nam).

Meanwhile, ASEAN IP offices have established a work sharing program (ASPEC) to enable re-utilization of patent search and examination results between offices. At the 2013 AWGIPC meeting ASEAN members adopted the WIPO CASE system as the technical platform for ASPEC to adopt and utilize ASEAN patent work sharing. Since then, WIPO initiated assistance projects to support ASEAN's participation in the WIPO CASE system and facilitate accessing the data of advanced IP offices.

During the workshop, WIPO presented the current status of WIPO CASE and the proposed communication platform. In addition, WIPO also made a presentation on the WIPO's support for IP offices in ASEAN for IP office business systems and digitization support, including support for regional sharing and dissemination of IP information. JPO's support for ASEAN was also highlighted.

In addition, the new WIPO Publication Server was introduced. This product supports online publication and search of all IP data and documentation and facilitates data exchange for regional and international projects such as TMview and Patentscope.

SUMMARY OF DISCUSSIONS

ASEAN is a highly diverse region in terms of social, economic and technological development and IP activities are correspondingly diverse. In particular, offices in the region are in the early stages of developing capacity for work sharing and patent examination.

The ASPEC program started in 2009. ASPEC is an applicant-driven program and it allows fast-track for applicants in any 9 ASEAN IP Offices based on 1 allowable claim. There are still challenges to use ASPEC to promote understanding and work-sharing among ASEAN patent examiners, in particular to share more information on national regulations and procedures that affect the implementation of ASPEC. The promising development of the Community of Practice (CoP) in ASEAN will assist with exchange of ideas on patentable subject matter, examiner training, sharing search strategies and streamlining patent examination practices.

Utilising the WIPO CASE system and embedded communication platform will help ASEAN IP offices to improve the level of cooperation and regional work sharing will be enhanced and bring benefits for the offices.

The comments and issues raised by participants are summarised below:

- The improvements to the CASE system that would be available to the ASEAN IP offices were appreciated and there is a noticeable improvement. Specially, when the CASE system includes features like communication platform, examiners would easily exchange information on similarities and differences in law and practice as well as strategies for efficient searching and examination. It would also create a great opportunity to enable networking and interaction among ASEAN patent examiners beyond work practices.
- WIPO's support in enhancing national offices for ASEAN to enjoy the benefits from CASE participation was highlighted, including the deployment of IPAS and related systems, and support for digitization projects.
- WIPO CASE was considered as a useful learning platform for examiners to learn about patent examination practices in different IP offices and to apply them to their current work.

- More information was needed on the process for offices to join WIPO CASE. It was agreed that each ASEAN country will send the notification letter to WIPO for CASE accession. A joint statement on ASEAN's commitment to CASE is also pending further discussion at the AWGIPC.
- Most ASEAN offices would like to use the CASE-OPD linkage to access the information and patent examination output from IP5 offices but the requirement to commit to reciprocity is preventing the offices from joining. Some offices do not yet have patent examination systems and others are not ready for legal or technical reasons. Since IP5 offices already provide their dossier information to the general public in transparent way, ASEAN offices requested that the IP5 offices should be more flexible about the reciprocity principle.
- The importance of providing patent family data was emphasized, including for accessing offices. Offices need to take this into account when they send the notification letter to WIPO. WIPO will closely follow up this issue with the national office when they join the CASE and sustainable data sharing mechanism should be considered.
- The creation of a regional-level data exchange model was discussed. The new WIPO Publication Server was demonstrated as an option to enable offices to participate more easily in the WIPO CASE system and exchange data with other offices, whether they are using WIPO IPAS or not. The Publication Server can also be hosted at the regional level to aggregate all public IP information (patents, designs and trademarks) from participating offices. It can be configured so that some published documents are only available to offices and other published documents are available to the public.
- There is a potential for more improvements to the ASPEC business processes. Offices could share more information on national practices and cooperation models and identify the information and documents that could be shared to facilitate the program.
- Offices were encouraged to consider becoming depositing offices in the CASE system. The system will be more valuable if information and documents from the ASEAN region is shared. In this connection, some offices will receive digitization assistance to create electronic records.
- The need for monitoring timelines was raised. The ASPEC process requires 6 months to react from the receipt of the document till the end of action. Several ideas of enhancing the communication between examiners were highlighted through the possible introduction of online tools in CASE.
- Subsequent training needs for the examiners and IT officials and awareness-raising activities in the ASEAN region for the implementation of CASE system was also highlighted.

NEXT STEPS

WIPO presented the proposed cooperation model to support ASPEC work sharing using WIPO CASE and the ASEAN IP portal. The main elements of the model are summarised below:

- **ASPEC IP Portal Communication Platform:** WIPO presented the possible platform to meet the requirements from ASPEC and showed the way of promoting the interaction among ASEAN patent examiners. WIPO will provide the platform, based on the new requirements identified during the workshop for the testing and feedback of ASPEC. Timeline for the next steps was agreed by WIPO and offices. WIPO will make the demo platform available and offices will provide feedback so that WIPO could develop the final product and demonstrate it during the next training workshop that is scheduled for December 2014.

- CASE data sharing: WIPO clarified the kinds of data to be shared for ASEAN offices to join the CASE system. New CASE members will need to put in place mechanisms to share the patent family data with WIPO.
- Further CASE Requirements: Several enhancements to CASE were identified during the workshop. WIPO would utilize the WIPO wiki page to collect the feedback and comments from ASEAN to develop the improvements to the CASE system and regional communication platform.
- CASE Participation: Some participants would like to receive a detailed information note on the CASE participation procedures and notification process.

RECOMMENDATIONS

The workshop discussed and agreed the following recommendations for WIPO, IP5 offices and for the participating ASEAN IP offices:

Recommendations for WIPO

WIPO should continue to improve the development and cooperation for ASEAN, taking into account the following recommendations:

- Implement new requirements in CASE.
- Make communication platform available for testing.
- Support digitization projects (on request).
- Briefing note about joining procedure and requirements.
- Regional training workshop in 2014 for delivery of final product.

Recommendations for IP5 Offices

IP5 offices should reconsider their guideline on data access, allowing more convenient and transparent way of providing data access and taking into account of the ASEAN's level of development and the following points:

- Consider flexibility on reciprocity principle for ASEAN.
- Encourage participation of other IP5 offices in CASE linkage.

Recommendations for ASEAN IP Offices

ASEAN IP offices should establish regional cooperation among themselves and agree on allocation of activities, taking into account the following points:

- Confirm participation in CASE (letter to WIPO), and consider method and frequency for providing patent family data to WIPO.
- Consider becoming depositing offices when ready.
- Test CASE and Forum and give feedback within two months after the test platform is made available.
- Consider revising legal constraints to sharing documents – Consider a survey of information sharing policies.

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