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WORKING GROUP ON THE DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS

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DRAFT FRAMEWORK PROVISIONS FOR THE
DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS

Document prepared by the Secretariat

1. This document sets out draft framework provisions as required by the decision, reproduced in document WIPO/DAS/PD/WG/1/2, of the Assemblies of the Paris Union for the Protection of Industrial Property, the Patent Law Treaty and the International Patent Cooperation Union (PCT Union) approving the establishment of a digital access service for priority documents. The text of the draft provisions is essentially the same as that appearing in Annex I of document A/42/5, which was submitted to the Assemblies. The draft provisions are intended to be illustrative of the features of the new service, but final details will of course depend on the results of consideration by the Working Group.

2. *The Working Group is invited to consider and comment on the draft framework provisions set out in this document.*

DRAFT FRAMEWORK PROVISIONS FOR THE
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CONTENTS

Preamble	3
Article 1 Abbreviated Expressions	4
Article 2 Digital Access Service	6
Article 3 Priority Documents Stored In A Digital Library	7
Article 4 Access To Priority Documents	8
Article 5 Recognition Of Priority Documents Accessible Through Digital Access Service	10
Article 6 Translations Of Priority Documents	11
Article 7 Modifications; Operating Procedures; Consultative Group; Notifications.....	12

Preamble

The International Bureau of the World Intellectual Property Organization;

In accordance with the decision of the Assembly of the Paris Union for the Protection of Industrial Property, the Patent Law Treaty Assembly and the International Patent Cooperation Union Assembly (PCT Union Assembly) of October 3, 2006;

Taking into account the provisions of the Paris Convention for the Protection of Industrial Property, the Patent Law Treaty and the Patent Cooperation Treaty concerning declarations of priority and priority documents;

Also taking into account the Agreed Statement by the Diplomatic Conference for the Adoption of the Patent Law Treaty urging the World Intellectual Property Organization to expedite the creation of a digital library system for priority documents and noting that such a system would be of benefit to patent owners and others wanting access to priority documents;

Also taking into account the agreed understanding adopted by the Assemblies of the Paris Union and the International Patent Cooperation Union (PCT Union) on October 5, 2004, concerning the certification of priority documents provided, stored and disseminated in electronic form;

Establishes these Framework Provisions establishing a digital access service for priority documents.

Article 1

Abbreviated Expressions

In these provisions:

(i) “Paris Convention” means the Paris Convention for the Protection of Industrial Property;

(ii) “International Bureau” means the International Bureau of the World Intellectual Property Organization;

(iii) “Patent Office” means an authority entrusted with the granting of patents or the processing of patent applications by a State that is party to the Paris Convention or is a member of WIPO or by an intergovernmental organization at least one of whose member States is party to the Paris Convention or a member of WIPO;

(iv) “applicable law” means: in relation to a State, the law of that State; in relation to an intergovernmental organization, the legal enactments under which that intergovernmental organization operates; and in relation to a Patent Office, the law or legal enactments under which that Office operates;

(v) “patent application” means an application for a patent or for the registration of a utility model;

(vi) “applicant”, in relation to a patent application, means a person who appears as applicant in the records of the Patent Office with which the application was filed, and includes a representative of the applicant recognized under the applicable law;

(vii) “certified” means certified for the purposes of Article 4D of the Paris Convention having regard to the agreed understanding adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the International Patent Cooperation Union Assembly (PCT Union Assembly) on October 5, 2004;

(viii) “priority document”, in relation to a declaration of priority in a patent application, means a certified copy of the previously filed application that forms the basis for that declaration;

(ix) “digital access service” means the digital access service for priority documents referred to in Article 2;

(x) “access authorization code”, in relation to a priority document stored under Article 3, means the code established under Article 4(1).¹

¹ See footnote 2.

Article 2

Digital Access Service

The International Bureau shall establish and operate a digital access service for priority documents in accordance with these provisions.

Article 3

Priority Documents Stored In A Digital Library

(1) The International Bureau shall store in a digital library, for the purpose of giving access under the digital access service:

(i) a certified copy of a patent application submitted to the International Bureau, on request by the applicant, by a Patent Office with which the International Bureau has concluded an agreement for the purposes of this Article;

(ii) a certified copy of a patent application submitted by the applicant to the International Bureau.

(2) The International Bureau may, for the purposes of the digital access service, recognize a digital library other than that referred to in paragraph (1) in which priority documents are stored.

Article 4

Access To Priority Documents

(1) The International Bureau shall establish an access authorization code for each priority document that is to be accessible under the digital access service and shall notify the applicant of the code and that the priority document is accessible under the service.²

(2) The International Bureau shall make a priority document accessible under the digital access service:

(i) to a Patent Office that has made a declaration under Article 5(1), upon receipt of a request by the Office in accordance with paragraph (3) of this Article;

(ii) to the Patent Office with which the patent application concerned was filed;

(iii) to the applicant.

(3) A request referred to in paragraph (2)(i) shall identify the patent application claiming priority and the priority document, shall state that the applicant has authorized the access, and shall specify the access authorization code.

² The use of an access authorization code is included in this draft as an example of an authentication mechanism, but might be replaced in the framework provisions, after further consideration, by some other means of ensuring that the applicant has authorized access to an unpublished priority document.

(4) The International Bureau shall make a priority document publicly available under the digital access service:

(i) if so requested by the applicant;

(ii) if the Patent Office that issued the priority document informs the International Bureau that the document has become publicly available under the applicable law;

(iii) if the priority document becomes publicly available under the Patent Cooperation Treaty.

(5) The International Bureau shall keep a record of each instance of access to a priority document that is obtained pursuant to paragraph (2).

(6) The International Bureau shall not allow access to a priority document stored under Article 3, and shall not disclose an access authorization code, except as provided by this Article.

(7) The applicant may request that access to a priority document under the digital access service be recognized for the purposes of the provisions of the Regulations under the Patent Cooperation Treaty relating to availability of priority documents.

Article 5

Recognition Of Priority Documents

Accessible Through Digital Access Service

(1) A Patent Office may, in an agreement concluded with the International Bureau for the purposes of this Article, declare that paragraph (2) is applied by it.

(2) For the purposes of paragraph (1):

(i) where a priority document is accessible to a Patent Office through the digital access service on the relevant date, the requirements of Article 4D(3) of the Paris Convention shall be considered to have been complied with;

(ii) where, contrary to a notification under Article 4(1) of these provisions, a priority document was not in fact accessible to the Patent Office on the relevant date, the Office shall invite the applicant to furnish the priority document to it within a time limit which shall be reasonable in the circumstances;

(iii) where, within that time limit, the priority document becomes accessible to the Office through the digital access service or the applicant furnishes the priority document to the Office, the requirements referred to in item (i) shall be considered to have been complied with.

(3) The International Bureau shall take the necessary steps towards ensuring recognition of the digital access service for the purposes of the provisions of the Regulations under the Patent Cooperation Treaty relating to the availability of priority documents from a digital library.³

³ See PCT Rules 17.1(b-*bis*) and (d) and 66.7(a). Implementation of those provisions would require modification of the PCT Administrative Instructions.

Article 6

Translations Of Priority Documents

These provisions shall apply *mutatis mutandis* to a translation of a priority document that is submitted by the applicant to the International Bureau for the purpose of making it accessible under the digital access service.

*Article 7**Modifications; Operating Procedures;**Consultative Group; Notifications*

(1) The International Bureau may modify these provisions after consultation with a Consultative Group comprising the Patent Offices that have made declarations under Article 5, the Patent Offices with which agreements have been made under Article 3(1)(i) or 5(1), and any other Patent Offices that notify the International Bureau of their wish to participate in the Group.

(2) The International Bureau may, after consultation with the Consultative Group, establish and modify operating procedures useful for the implementation of the digital access service.⁴

(3) The International Bureau shall publish, and shall notify the Consultative Group of, details relating to the digital access service, including the following matters, in particular:

- (i) modifications of these provisions;
- (ii) agreements referred to in Articles 3(1)(i) and 5(1);
- (iii) digital libraries recognized by the International Bureau under Article 3(2);

⁴ Examples of matters which might be included in operating procedures include: procedures for the Office of first filing to make a priority document available to the International Bureau; bibliographic details (including the address of the applicant) needed from the Office of first filing by the International Bureau; details of the operation of the access authorization code or other authentication mechanism, including reissue or replacement of lost or “escaped” codes; details of the communication sent to the applicant when a priority document is placed in the service’s digital library; correction of errors in the digital library; authentication of ID of applicant; the kinds of records to be kept, possibly including records of access to priority documents via the service; required contents of requests for access; technical standards sufficient to ensure reliability and interoperability; details as to what agreements under Articles 3 and 5 must cover; etc.

(iv) the operation of the digital access service including, in particular, the means of, and conditions for, permitting access to priority documents under Article 4;

(v) the records to be maintained concerning the priority documents accessible through the service and the conditions for access to those records;

(vi) the establishment and modification of operating procedures under paragraph (2).

[End of document]