

FRAMEWORK PROVISIONS: PROPOSED FINAL VERSION

(prepared by the Secretariat, February 27, 2009)

1. It is recalled that the Working Group on the Digital Access Service for Priority Documents, at its second session held in July 2007, agreed on the text of framework provisions (with explanatory notes) designed to implement the digital access service for priority documents, subject to possible further drafting changes to be made by the Secretariat after consultation with participants in the Working Group via the priority documents electronic forum; see document WIPO/DAS/PD/WG/2/4, paragraph 38, and the draft framework provisions set out in Annex III to that document. The possible changes related, in particular, to the matters mentioned in paragraphs 42 to 44 of that document.

2. As a result of subsequent consultations with certain Offices, the Secretariat now proposes that the framework provisions (with explanatory notes) be established with the inclusion of the drafting changes as set out on the following pages. The proposed changes and the reasons for which they are being proposed are set out in the following subparagraphs:

(a) The footnotes marked by an asterisk appearing in relation to the title and paragraph 14 of the framework provisions are no longer necessary and have therefore been deleted.

(b) Paragraphs 14 and 15 of the framework provisions are proposed to be combined and renumbered as paragraph 14(a) and (b), to be supplemented by new paragraph 15(a) and (b). While the provisions of paragraph 14 provide express safeguards to applicants who make use of the service, paragraph 15(a) and (b) would take into account different safeguards afforded to applicants under the applicable law in certain Offices, in particular, in the European Patent Office and the United States Patent and Trademark Office, respectively.

(c) The changes proposed to paragraph 17 of the framework provisions (see item (ii) and new item (iii) thereof), relating to public availability of priority documents pursuant to the applicable law applying to an accessing Office, would remove the need for the accessing Office to have the priority document physically in its possession.

(d) Changes are proposed to the explanatory notes to take account of the changes just outlined: see note 13 in relation to paragraphs 14 and 15 of the framework provisions, and note 15 in relation to paragraph 17.

3. The International Bureau is preparing to commence operations under the service from April 1, 2009, using systems developed in cooperation with certain interested Offices. The framework provisions should therefore be formally established before that date. Comments on the proposed final text of the framework provisions are invited to be submitted via the electronic forum at <http://www.wipo.int/patentscope/en/pdocforum/pdocforum.html> by March 20, 2009.

PROPOSED FINAL VERSION

*(Showing changes compared with document WIPO/DAS/PD/WG/2/4, Annex III.
Prepared by the Secretariat, February 27, 2009.)*

FRAMEWORK PROVISIONS FOR THE
DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS^{1*}

established on [date]

Digital Access Service

1. These provisions are established by the International Bureau in accordance with a decision of the Paris Union Assembly, the PLT Assembly and the PCT Union Assembly and the recommendations of the Working Group on the Digital Access Service for Priority Documents (“the Working Group”).²
2. The digital access service for priority documents (“the service”) operates in accordance with these provisions and having regard to the general principles and system architecture recommended by the Working Group.³
3. The aim of the service is to provide applicants and Patent Offices with a simple and secure option whereby priority documents may be furnished for the purposes of the applicable law, having regard to relevant international agreements and understandings.⁴
4. The implementation of these provisions by Patent Offices is a matter for the applicable law.⁵
5. These provisions come into effect from the date on which they are established, except that the service commences practical operations in terms of deposit of and access to priority documents from a date to be fixed by the International Bureau after consultation with the Consultative Group.⁶
6. Words and expressions used in these provisions are to be understood with reference to paragraph 26.

Participating Digital Libraries

7. A digital library participates for the purposes of these provisions (“participating digital library”):

* ~~See document WIPO/DAS/PD/WG/2/4, paragraphs 38 and 42 to 44, as to possible further drafting changes to the framework provisions.~~

(i) if it is so designated by the International Bureau when these provisions come into effect;⁷

(ii) if, upon request by a Patent Office, it is so designated by the International Bureau at a later time after consultation with the Consultative Group.

8. The criteria referred to in paragraph 23 apply to all participating digital libraries.

9. The giving by a Patent Office of a notification under paragraph 12 does not give rise to any obligation on the part of that Office to accept a participating digital library for the purposes of Rule 4(3) of the Regulations under the PLT.⁸

Depositing Offices and Availability of Priority Documents Via the Service

10. A Patent Office (“depositing Office”) may notify the International Bureau that copies of patent applications deposited by it in a participating digital library⁹ are to be made available via the service as priority documents in accordance with these provisions. The notification also informs the International Bureau of relevant operating procedures and technical requirements referred to in paragraph 23, including any specification of options from among those available.

11. The applicant may submit a priority document to the International Bureau, or to a Patent Office that is prepared to receive priority documents for the purpose, together with a request that it be deposited in a participating digital library and made available via the service.

Accessing Offices

12. A Patent Office (“accessing Office”) may notify the International Bureau that, for the purposes of the applicable law¹⁰ and subject to paragraphs 13 to 15, the Office treats a priority document that is available to it via the service as though it had been furnished to it by the applicant. The notification also informs the International Bureau of relevant operating procedures and technical requirements referred to in paragraph 23, including any specification of options from among those available.

13. A certificate by the International Bureau that a priority document is available via the service to a particular accessing Office, including bibliographic details¹¹ and the date on which the priority document became available, is made available via the service to the applicant and the Office.¹² The certificate is, subject to paragraphs 14 and 15, accepted by the Office for the purposes of the applicable law as proof of the matters it contains.

Opportunity to Comply

14. (a) Where a certificate referred to in paragraph 13 states that a priority document became available via the service to an accessing Office on a date which is on or before the date (“the relevant date”) by which the priority document is required to be furnished under the applicable law, but the Office finds, whether before, on or after the relevant date, that the priority document is in fact not available to it, the Office so notifies the applicant, giving the

opportunity to furnish the priority document to it, or to ensure that the priority document is made available to it via the service, within a time limit of not less than two months from the date of the notification.^{13*}

~~15.~~ (b) Where the priority document is furnished or becomes available to the Office within that time limit, it is treated as though it had been available on the date stated in the certificate. Where the priority document is not furnished or does not become available to the Office within that time limit, the consequences provided by the applicable law apply.¹³

15. (a) Paragraph 14 does not apply to an accessing Office whose applicable law provides that it shall notify the applicant where the priority document is not available to it on the date by which it is required to be furnished under that law, giving the opportunity to furnish the priority document to it, or to ensure that the priority document is made available to it via the service, within a time limit of not less than two months from the date of the notification. Where the priority document is not furnished or does not become available to the Office within that time limit, the consequences provided by the applicable law apply.¹³

(b) An accessing Office need not apply paragraph 14 where, under the applicable law:

(i) there is no fixed date, calculated from either the filing or the priority date, by which the priority document must be received by or made available to the Office;

(ii) it is required that the priority document be received by or made available to the Office before grant; and

(iii) the Office provides an online file inspection service enabling the applicant to monitor whether the priority document has been received by or made available to the Office.¹³

Priority Documents That Are Not Publicly Available

16. A priority document that is not publicly available under paragraph 17 is available via the service only to Offices (“authorized accessing Offices”) by which access is authorized by the applicant in accordance with the operating procedures and technical requirements referred to in paragraph 23.

Priority Documents Becoming Publicly Available

17. A priority document becomes publicly available via the service:¹⁴

(i) upon a request to that effect received by the International Bureau from the applicant;

* — See document ~~WIPO/DAS/PD/WG/2/4, paragraphs 38 and 42 to 44, as to possible further changes relating to this paragraph, in particular, of the framework provisions.~~

(ii) upon a notification received by, or on the basis of information obtained by, the International Bureau from the depositing Office ~~or an authorized accessing Office~~ that the document is publicly available under the applicable law;¹⁵

(iii) upon a notification received by, or on the basis of information obtained by, the International Bureau from an authorized accessing Office that the document is publicly available under the applicable law or would be so available if it had been furnished to that Office by the applicant;

~~(iii)~~(iv) if it becomes publicly available as a priority document held by the International Bureau in connection with an international application under the Patent Cooperation Treaty.¹⁶

18. A priority document that is publicly available under paragraph 17 is available to any accessing Office, and may be made available to the general public, without the need for authorization by the applicant.

Translations of Priority Documents

19. The International Bureau may establish procedures, after consultation with the Consultative Group, to enable translations of priority documents to be deposited and made available under the service.¹⁷

Publication of Information

20. The International Bureau publishes on WIPO's website information relating to the service, including:

- (i) the establishment of these provisions and any subsequent modifications of them;
- (ii) the commencement of practical operations of the service;
- (iii) participating digital libraries;¹⁸
- (iv) notifications and information received from Patent Offices¹⁹ under paragraphs 10 and 12;
- (v) operating procedures and technical requirements referred to in paragraph 23.

Consultative Group

21. The Consultative Group consists of:

- (i) Patent Offices from which the International Bureau receives a notification under paragraph 10 or 12;
- (ii) any other Patent Offices that notify the International Bureau that they wish to participate in the Group;
- (iii) as observers, interested organizations invited to meetings of the Working Group that notify the International Bureau that they wish to participate in the Consultative Group.

22. The proceedings of the Consultative Group take place primarily through correspondence and an electronic forum on WIPO's website.

Operating Procedures and Technical Requirements

23. The International Bureau may, after consultation with the Consultative Group, establish and modify operating procedures and technical requirements useful for the operation of the service, including criteria for the participating digital libraries²⁰ under paragraph 7 and the means by which applicants authorize access²¹ for the purpose of paragraph 16.

Modification

24. These provisions may be modified by the International Bureau in accordance with recommendations of the Working Group or after consultation with all of the members of the Working Group.

Languages

25. These provisions are established in the Arabic, Chinese, English, French, Russian and Spanish languages, all texts being equally authentic.²²

Meanings of Words and Expressions

26. In these provisions:

(i) "applicable law" means the national law or regional legal enactments under which a Patent Office operates;

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

(iii) "certified" means certified for the purposes of these provisions and Article 4D(3) of the Paris Convention, whether by the Office with which the patent application concerned was filed or by the International Bureau in connection with access via the service, and having regard to the agreed understanding of the Paris Union Assembly and the PCT Union Assembly concerning certification of priority documents;²³

(iv) "Consultative Group" means the Consultative Group referred to in paragraph 21;

(v) "International Bureau" means the International Bureau of WIPO;

(vi) "Paris Convention" means the Paris Convention for the Protection of Industrial Property;

(vii) "Paris Union" means the Paris Union for the Protection of Industrial Property;

(viii) "patent application" means an application of a kind referred to in Article 3 of the PLT;²⁴

- (ix) “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;²⁵
- (x) “PCT” means the Patent Cooperation Treaty;
- (xi) “PCT Union” means the International Patent Cooperation Union;
- (xii) “PLT” means the Patent Law Treaty;
- (xiii) “priority document” means a certified copy of a patent application;²⁶
- (xiv) “WIPO” means the World Intellectual Property Organization.

EXPLANATORY NOTES

1. The framework provisions are supplemented by these notes, prepared by the International Bureau for explanatory purposes, which do not form part of the framework provisions themselves but were approved by the Working Group together with the framework provisions (see document WIPO/DAS/PD/WG/2/4, paragraph 38). The explanatory notes may be modified by the International Bureau after consultation, on changes of substance, with the Consultative Group.
2. For the Assemblies’ decision that the service be established according to the recommendations of the Working Group, see their report, adopted on October 3, 2006, document A/42/14, paragraph 220. For the recommendations of the Working Group, see its report, adopted on July 19, 2007, document WIPO/DAS/PD/WG/2/4.
3. See document WIPO/DAS/PD/WG/2/4, paragraphs 23 and 35 and Annexes I and II.
4. The relevant international agreements and understandings include, in particular:
 - (i) the Agreed Statement by the Diplomatic Conference for the Adoption of the PLT, adopted on June 1, 2000, urging WIPO 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 (see Agreed Statement No. 3 appearing in document PT/DC/47 and in WIPO Publication No. 258);
 - (ii) the provisions of the Paris Convention, the PLT and the PCT concerning declarations of priority and priority documents (see, in particular: Paris Convention, Article 4D; PLT Article 6 and Rule 4; and PCT Article 8 and Rule 17);
 - (iii) the agreed understanding adopted by the Paris Union Assembly and the PCT Union Assembly on October 5, 2004, concerning the certification of priority documents

provided, stored and disseminated in electronic form (see document A/40/7, paragraph 173, referring to document A/40/6, paragraph 9);

(iv) the obligations of Members of the World Trade Organization that are not party to the Paris Convention to recognize priority rights, for which purpose priority documents may also be deposited and accessed via the service.

5. The framework provisions do not create international treaty-style obligations for participating Patent Offices. The provisions are intended to facilitate the furnishing of priority documents for the purposes of the Paris Convention but do not affect the basic rights and obligations established by that Convention or the PLT or give rise to any new obligation under the Paris Convention or the PLT; see, in particular, paragraph 9 of the framework provisions.

6. This will, for example, enable the giving of notifications under paragraphs 10, 12 and 21(ii) and (iii) of the framework provisions before the service commences practical operations, thus enabling the Consultative Group to have an active role in implementation of the service.

7. The International Bureau envisages that the initial designation of participating digital libraries would be of those Patent Offices which are already in practice exchanging priority documents in electronic form, namely, the State Intellectual Property Office of the People's Republic of China, the Japan Patent Office, the Korean Intellectual Property Office, the United States Patent Office and the European Patent Office, as well as of the International Bureau itself.

8. While a participating Patent Office would not be obliged to accept a participating digital library for the purposes of PLT Rule 4(3), it would of course be free to accept such a digital library for that purpose if it so wished.

9. A Patent Office which is not able, or does not wish, to establish and maintain its own digital library may make arrangements with the International Bureau, or with another Office that is prepared to handle such deposits, to deposit priority documents in the digital library maintained by the International Bureau or that other Office. The International Bureau is prepared for this purpose to receive such documents in electronic form or to scan them if received in paper form. The arrangements made would need to provide for certain technical matters such as the use of an appropriate data format.

10. See notes 4 and 5, above, as to the way in which the provisions operate in the context of the applicable law and the provisions of the Paris Convention and other international agreements and understandings.

11. Which bibliographic details would be included is a matter to be addressed by the Consultative Group, having regard, for example, to requirements under applicable laws as to maintaining the confidentiality of unpublished applications.

12. Certificates would be available to the applicant and the Office concerned (but not to others) for viewing on-line or by transmission on request.

13. The purpose of paragraph 14 of the framework provisions is to assure applicants that, if they make use of the service complying with the requirements of the provisions, their priority rights will be protected in a case where the priority document concerned is found not to be available to an accessing Office via the service. The time limit of two months referred to in paragraph 14(a) is consistent with the time limit prescribed in PLT Rule 6(1). An Office which follows in general the practice of sending ~~such~~ notifications referred to in paragraph 14(a) before the relevant date may of course do so whether or not the priority document in question is the subject of a certificate referred to in paragraph 13. Paragraph 14 does not apply to an accessing Office whose procedures provide for safeguards of the kind set out in paragraph 15(a), such as the European Patent Office, and need not be applied by an accessing Office whose procedures provide for safeguards of the kind set out in paragraph 15(b), such as the United States Patent and Trademark Office. Notifications by accessing Offices given to the International Bureau under paragraph 12, and published under paragraph 20(iv), include details of the applicable procedures under paragraphs 14 and 15. ~~The time limit of two months is consistent with the time limit prescribed in PLT Rule 6(1).~~

14. Paragraph 17 of the framework provisions is exhaustive of the ways in which a priority document may become publicly available via the service, but has no operation in relation to ways in which priority documents may become publicly available outside the service. It is envisaged that the operating procedures and technical requirements under paragraph 23 would include provisions designed to cover cases where the application claiming priority is withdrawn at a late stage.

15. While items (ii) and (iii) of paragraph 17 ~~(ii)~~ of the framework provisions ~~enables~~ enable the depositing Office or an authorized accessing Office, respectively, to notify the International Bureau that the priority document is, or would be if furnished, publicly available under the applicable law (that is, applicable by the Office giving the notification), such an Office is *not obliged* by ~~this~~ those provisions to give such a notification ~~where the priority document becomes so available~~. Information as to public availability could also, when authorized by an Office, be obtained by way of data obtained by the International Bureau from the Office.

16. See PCT Rule 17.2(c).

17. Operating procedures and technical requirements providing for the deposit of and access to translations would need to be established under paragraph 23 of the framework provisions before a date could be determined under paragraph 19. The framework provisions do not address or limit the kind of certification, etc., that accessing Offices are entitled to require in the case of translations, and do not assure that a translation submitted under the services would satisfy the needs of any particular accessing Office; those matters would be left to the applicable law in each Office. It is to be hoped, however, that future work might achieve a degree of commonality of approach on the matter, with the result that a single translation might be able to be accepted by a number of accessing Offices.

18. Published details concerning participating digital libraries would include, for example, the date on which a digital library is to commence operations under the service, document format requirements, etc.

19. The publication of up-to-date details of notifications and Office requirements, and changes therein, is of course vital to applicants wishing to rely on the service as a secure means of satisfying requirements for the provision of priority documents. As an example, it will be important to publish details of which possible routes for entry of priority documents into the service (see Annex I of document WIPO/DAS/PD/WG/2/4) are available in a particular Office of first filing.

20. It is envisaged that the criteria for participating digital libraries might include, for example, criteria as to giving access and ensuring confidentiality and a requirement that arrangements be in place for deposited priority documents to be stored for a specified period from the priority date. By way of comparison, it is noted that files relating to international applications under the PCT must be kept by the International Bureau for 30 years from the date of receipt of the record copy; see PCT Rule 93.2(a).

21. As explained in document WIPO/DAS/PD/WG/2/2, the only system presently envisaged for ensuring the applicant's authorization of access is by means of the applicant's control of a list of authorized Offices held by the International Bureau. An access control code will be used to confirm the identity of the applicant when maintaining the list, and the use of secure communication channels between the International Bureau and the accessing Office will assure the identity of the latter.

22. The working languages of the service in its practical operations would be the official working languages of the International Bureau (that is, English and French), with the possibility of extension to other languages when practicable.

23. See note 4(iii), above.

24. PLT Article 3(1) in turn refers to certain provisions of the Paris Convention and the PCT. See also the Explanatory Notes on PLT Article 3. While the definition refers to the PLT, that is purely for the sake of the definition; there is no implication that the Offices concerned must be bound by the provisions of the PLT. As a further point, while the definition covers most kinds of priority document that are likely to be important in practice, future review may be needed to determine whether other kinds of priority document should also be included (for example, priority documents relating to utility models).

25. See also note 4(iv), above.

26. See also the definition of "certified" in paragraph 26(iii) of the framework provisions.

[End of Annex III and of document]