

Committee on WIPO Standards (CWS)

Sixth Session
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REPORT ON TASK NO.47 BY THE LEGAL STATUS TASK FORCE

Document prepared by the International Bureau

INTRODUCTION

1. At its fifth session held from May 29 to June 2, 2017, the Committee on WIPO Standards (CWS) adopted WIPO Standard ST.27 “Recommendation for the exchange of patent legal status data”. The CWS also approved the following *Editorial Note* for ST.27 “The detailed events included in this Standard are provisional and will be reviewed and assessed by industrial property offices (IPOs) for one year. Based on the outcome of the review and the assessment reported by IPOs, a final proposal on the detailed events in this Standard will be submitted for approval at the sixth session of the CWS. IPOs may choose to exchange legal status data on the basis of categories and key events only, if they so desire.” (See paragraphs 50 and 51 of document CWS/5/22.)
2. The CWS requested the XML4IP Task Force to develop, in consultation with the Legal Status Task Force (LSTF), XML schema components based on the new WIPO Standard ST.27 in order to facilitate the exchange of patent legal status data. The CWS also requested that the outcome be reported at its sixth session.
3. The CWS revised the description of Task No. 47 as follows: “prepare a final proposal for the detailed events and a guidance document with regard to patent legal status data; prepare a recommendation for the exchange of legal status data on trademarks and industrial designs by industrial property offices” (see paragraph 55 of document CWS/5/22).

4. During the week of the fifth session of the CWS, the Legal Status Task Force held its meeting in person and reported to the CWS its agreement to map the national or regional legal events of Task Force members to the ST.27 events and to give priority to the preparation of a proposal for a new standard on industrial design legal status rather than trademark legal status.

PROGRESS REPORT

5. As a follow-up of the decision by the CWS, the Legal Status Task Force mainly worked to prepare:

- a final proposal for the detailed events considering the information on mapping between national or regional status events and the ST.27 events provided by IPOs;
- a guidance document which becomes a new Annex to Standard ST.27;
- a recommendation for the exchange of legal status data on industrial designs by industrial property offices.

6. The outcomes of the Task Force's activities are presented for consideration at the sixth session of the Committee as follows:

- the proposed revision of WIPO Standard ST.27, including the updated detailed events and a provisional guidance document (see document CWS/6/12); and
- the proposal for the new WIPO standard for the exchange of industrial design legal status data (see document CWS/6/14).

Implementation Plan of WIPO Standard ST.27

7. The Secretariat issued Circular C. CWS 92 on January 25, 2018, inviting IPOs to provide the results of (a) the assessment of their business practices and IT systems, including their tentative schedule for the implementation of WIPO Standard ST.27; and (b) the review of the provisional detailed events in accordance with their respective laws and practices. The summary of the responses to the Circular from 11 IPOs is available in paragraphs 5, 6, 7 and 8 of document CWS/6/13.

Mapping National/Regional Events to the Standard Events

8. IPOs also invited to map their national or regional patent legal status events to the categories and events defined in WIPO Standard ST.27. Some IPOs provided their mapping table in response to the Circular mentioned above, some other IPOs also shared their mapping table with the Task Force. Some of those IPOs which provided their mapping table reported that the comparison of certain their events with the Standard Events were not clear. The International Bureau worked together with the IPOs to improve their mapping and to prepare their final mapping table. Furthermore, the International Bureau consolidated the mapping tables received from the IPOs, which is reproduced as the Annex of document CWS/6/13.

9. In addition to the mapping tables provided by the IPOs mentioned above, the International Bureau collaborated with the European Patent Office (EPO) to prepare mapping tables for the national or regional patent legal status events included in the International Patent Documentation (INPADOC) database, to which around 50 IPOs provide their information. As the first outcome of the collaboration, the draft mapping INPADOC data regarding France was prepared and it was shared with the National Industrial Property Institute of France (INPI-FR) to clarify some events questioned with several updates of the table. EPO noted that some clarification on INPI-FR data is needed in INPADOC. Finally, INPI-FR agreed to share the final mapping table with other TF members and include it in the consolidated mapping table. It is planned to continue to map INPADOC data for other IPOs to Standard ST.27, in collaboration with the origin IPOs of legal status data. The International Bureau considers this collaborative work very important to provide more harmonized and accurate legal status information data following WIPO ST.27, which will benefit the whole IP community, in particular IP users.

Proposal for the revised WIPO Standard ST.27

10. Since the fifth session of the CWS, the Legal Status Task Force has continued its work to carry out Task No. 47 and noted the need of further revision of ST.27 other than just an update of Annex I and adding a new Annex of Standard ST.27. The Task Force proposes to amend the main body of ST.27, including modification to the Overall Patent/SPC Prosecution Model, modification of Annex I of ST.27, in particular to the list of detailed events, and add a provisional Guidance Document to the Standard. The proposed revision of WIPO Standard ST.27 is reproduced as the Annex of document CWS/6/12.

11. Regarding the proposed amendment to Standard ST.27, two rounds of discussions were held. Most notably, the Task Force members recommended changes to (1) key and detailed events, including both the list of events and their titles/descriptions, (2) the Overall Patent/SPC Prosecution Model, and (3) the supplementary event data included in Annex II of Standard ST.27.

12. With regard to the preparation of the proposed Guidance Document, the Legal Status Task Force carried out two rounds of discussion. Further information on the proposed provisional Guidance Document is available in document CWS/6/12, Section "New Annex V: Guidance Document".

Preparation of the New Standard on the Exchange of Industrial Design Legal Status Data

13. The Legal Status Task Force has also worked on the preparation of a proposal for a new standard on the exchange of industrial design legal status data, as outlined in Task No. 47. The Task Force members have been engaged in four rounds of discussions concerning the preparation of the new standard.

14. Similar to WIPO Standard ST.27, but for industrial designs in registration systems, the proposed standard is intended to promote the efficient exchange of legal status data in a harmonized manner between IPOs in order to facilitate access to that data by IP information users, IPOs, IP data providers, the general public and other interested parties. Further information on the proposed new standard is available in document CWS/6/14.

WORK PLAN

Patent Legal Status Data

15. The Legal Status Task Force plans to finalize the provisional detailed events and the provisional guidance document of WIPO Standard ST.27. With regard to the provisional guidance document, the Task Force notes that as a minimum around five IPOs should actively participate in the discussion to identify common lifecycle scenarios and to prepare a final guidance document, which will guide IPOs to map their national or regional legal status events to WIPO Standard ST.27 in a more harmonized manner.

16. The Task Force requests the CWS to invite IPOs to provide the International Bureau with their mapping table with regard to Standard ST.27. Once more mapping tables have been provided, the consolidated mapping tables should be updated and the provisional Guidance Document will also be revised as required.

17. The International Bureau and the EPO plan to continue the mapping of INPADOC data to WIPO Standard ST.27 in collaboration with the original IPOs of the patent legal status data in INPADOC as long as resources are available.

Industrial Design Legal Status Data

18. The Task Force plans to finalize the provisional detailed events of the new standard on industrial design legal status data and prepare a guidance document in due course.

Trademark Legal Status Data

19. The Task Force plans to commence its work to prepare a proposal for a new standard on trademark legal status data once the pending works on WIPO Standard ST.27 and a new standard on industrial design legal status data have been accomplished.

PROPOSAL TO REVISE THE DESCRIPTION OF TASK NO. 47

20. Taking into account the completed and remaining work on WIPO Standards regarding patent and industrial designs, it is proposed to revise the description of Task No. 47 as follows: "prepare a final proposal for the detailed events and a final proposal for the guidance document with regard to patent legal status data; prepare a final proposal for the guidance document with respect to industrial design legal status data; prepare a recommendation for the exchange of legal status data on trademarks by industrial property offices".

21. *The CWS is invited to:*

(a) note the results of the work of the Legal Status Task Force and the report of the Task Force leader, as set out in this document;

(b) note the work plan of the Legal Status Task Force and encourage IPOs to participate in the Task Force discussions, as referred to in paragraphs 15 to 19, above;

(c) encourage IPOs to provide their mapping table and participate in the Task Force discussions, as referred to in paragraphs 9, 16 and 17, above; and

(d) consider and approve the proposed modification of Task No. 47 and the assignment of modified Task No. 47 to the Legal Status Task Force, as indicated in paragraph 20, above.

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