

Committee on WIPO Standards (CWS)

Sixth Session
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REVISION OF WIPO STANDARD ST.27

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 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 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).

PROPOSED REVISION OF STANDARD ST.27

3. Within the framework of Task No. 47, the Legal Status Task Force (LSTF) prepared a proposal for the revised WIPO Standard ST.27, in particular updating the list of detailed events and adding a new Annex V - Guidance Document.

Summary of proposed amendments to Standard ST.27

4. The proposed amendments to WIPO Standard ST.27 include the updates of the Overall Patent/SPC Prosecution Model and the proposed correction and clarification in the main body of Standard ST.27; the changes to the key and detailed events, including both the list of events and their titles/descriptions defined in Annex I of Standard ST.27; and the amendment to Annex II of ST.27 - Supplementary Event Data. The proposed amendments to Standard ST.27 is reproduced as Annex I of this document.

5. Considering the inputs regarding the review and assessment of detailed events provided by IPOs, some modifications to the event list were proposed. This included adding new detailed events as well as modifying the titles and descriptions of existing events. For example, the description of category M. IP right maintenance and key event "M10. IP right maintained" were updated to explicitly cover full and partial renewals. Additional detailed events were added, for example, "M15. IP right maintained in full or amended form following a full or partial renewal", and "U14. Designation fee not paid" were added to describe prosecution practices of IPOs which were not covered by existing events. Lastly, modifications to the titles and/or descriptions of some existing detailed events were made to provide further clarity: for example, the description of D14. Search report issued, was modified to explicitly distinguish "issue" from "publication" (issuance relates to a communication with the applicant while publication relates to a public communication).

6. The Overall Patent/SPC Prosecution Model was also updated to add a recursive arrow to the Grant Stage, corresponding to key event "M10. IP right maintained", to describe the scenario where an IP right is maintained due to payment of an annual maintenance fee, for example.

7. With regard to the supplementary event data included in Annex II of Standard ST.27, modifications were made to supplementary data for certain Categories.

8. Even though the Task Force proposes amendments to the list of events defined in Annex I of Standard ST.27, it considers that the detailed events listed in Annex I should be further reviewed and assessed due to the complexity of various practices of IPOs; for example, the level of granularity of detailed events in particular in Category S - Licensing information. Therefore, the Task Force requests more time to prepare a final list of detailed events and also request the CWS to encourage IPOs to participate in the discussion.

New Annex V: Guidance Document

9. The Task Force prepared a proposal for a Guidance Document to be added to WIPO Standard ST.27 as Annex V. The proposed new Annex V of Standard ST.27 is reproduced as Annex I of this document.

10. The proposed Guidance Document includes examples of possible event histories based on the mapping tables provided by the Task Force Member Offices so that the proposed Guidance Document provides guidance for IPOs to map their national/regional events to the standard events, and how they can use standard events to describe various prosecution practices.

11. While the proposed Guidance Document would be useful, as is, for IPOs to map their events to the standard events, the Task Force considers that it could be improved in particular to enhance readability in a more structured form based on lifecycle scenario and completeness with more relevant examples from varying IPOs. Therefore, it is suggested that the proposed Guidance Document is considered as provisional.

Amendment to Editorial Note

12. Taking into account the pending work in relation to the list of detailed events and the guidance document, mentioned above, the International Bureau proposes to amend the current Editorial Note, included in the front of Standard ST.27, with the following text:

“Editorial Note by the International Bureau

The detailed events included in Annex I of this Standard were reviewed and assessed by industrial property offices (IPOs) for one year after its provisional adoption at the CWS/5. Based on the outcome of the review and assessment reported by IPOs, the provisional detailed events were revised. Due to the complexity of various practices of IPOs, more intensive assessment is required to prepare a final proposal on the detailed events, which will be submitted for approval at the seventh 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.

The Guidance Document, Annex V of this Standard, is provisional and will be reviewed and assessed by IPOs as well as the Legal Status Task Force. The final proposal will be submitted for consideration and adoption at the seventh session of the CWS.”

13. *The CWS is invited to:*

(a) note the content of the present document;

(b) consider and approved the amendments to the Main Body and Annexes I to IV of WIPO Standard ST.27, as reproduced in Annex I to the present document;

(c) consider and approve the proposed new Annex V of Standard ST.27 as provisional, as referred to paragraphs 9 to 11 above and as reproduced in Annex II to the present document; and

(d) consider and approve the proposed modification to the Editorial Note, as referred to in paragraph 12.

[Annex I follows]