

## **Patent Cooperation Treaty (PCT) Working Group**

**Eighth Session**  
**Geneva, May 26 to 29, 2015**

### **INFORMATION CONCERNING NATIONAL PHASE ENTRY AND TRANSLATIONS**

*Document prepared by the International Bureau*

#### **SUMMARY**

1. It is proposed to require designated Offices<sup>1</sup> to notify the International Bureau concerning international applications which enter the national phase.
2. The proposal aims to improve the quality of patent information in two main ways:
  - (a) improved access to information concerning where protection is and is not being sought; and
  - (b) access to the technical information contained in the international publications in a wider range of languages, by improving the ability of the International Bureau and other patent information providers to link the international publication to translations published by designated Offices in the national phase.
3. This will allow effective work towards recommendations which have been made in accordance with the WIPO Development Agenda concerning effective access to technical information and identification of technology which is free to use in a particular State.
4. A summary is provided of tools which the International Bureau provides to assist Offices in their role as designated Offices, which could assist the preparation and transmission of the relevant information elements to the International Bureau.

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<sup>1</sup> In this document, references to designated Offices refer equally to elected Offices; references to national Offices and the national phase refer equally to regional Offices and the regional phase.

## BACKGROUND

5. Information concerning national phase entry – including whether an international application has *not* entered the national phase – and subsequent status changes is important to users of patent information to help determine whether the information disclosed in a patent application is usable without seeking a license. At present, the availability of this information is very limited. Existing Rule 86.1(iv) envisages making available national phase entry data to the extent that it is supplied, but up to now it has not been mandatory for designated Offices to notify that information to the International Bureau and only a limited range of Offices have done so reliably. At the time of writing, 50 national and regional Offices in their role as designated Offices had provided some data to the International Bureau concerning national phase entry. However, only 16 of those had continued to supply data sufficiently regularly so that the information provided was within one year of being up to date.

6. Section 112 of the Administrative Instructions requires designated Offices to indicate the *number* of international applications which have *not* entered the national phase before the relevant time limit, but this obligation has not been widely met and does not assist third parties in identifying individual patent applications which have been abandoned for all or some markets.

7. Recommendations 10, 19, 20, 25 and 31 under the WIPO Development Agenda call for improved access to technical information and the ability for users in developing countries to identify information which is in the public domain. To this end, the PCT Working Group in 2010 endorsed the following recommendation (see paragraph 129 of document PCT/WG/3/14 Rev.):

“207. It is recommended that the IB work with national Offices to deliver effective patent status information covering not only PCT applications and subsequently granted patents but also normal national applications, including information concerning opposition of patents (pre and post-grant), revocation and lapse of patents, issuance of compulsory licenses, etc. This information would be integrated into a search system allowing technology which has fallen into the public domain to be identified more readily. The IB would take up a pilot project to develop an integrated system for automatic updating of the status of the application by linking it with national offices/organizations.”

## PROPOSAL

### Provision of National Phase Status Information

8. It is proposed to introduce a new Rule 95.1, making it mandatory for designated Offices to provide timely information on the following national phase actions:

- (a) national phase entry (the date of performance of the actions under Article 22(1) or 39(1)(a));
- (b) any national publication of the international application by the designated Office;  
and
- (c) the date of grant of a patent and the number and date of any associated publication.

9. A time limit for providing the information is proposed of one month from the date on which the relevant actions occurred. The specific figure is chosen arbitrarily, but the key issue is that the information needs to be provided on a regular basis so that the International Bureau can provide reliable up-to-date information.

10. While it would be desirable to receive information on further actions, such as:

- (a) a definitive statement that an international application has not entered the national phase;

- (b) refusal of the international application;
- (c) lapsing of the international application or any granted patent; and
- (d) any reinstatement of lapsed applications or patents;

it is not proposed to make submission to the International Bureau of this kind of information mandatory. It would simply overburden smaller Offices with very few national phase entries if those Offices would have to notify the International Bureau in respect of more than 200,000 international applications per year which had *not* entered the national phase.

11. Instead, it is proposed that the International Bureau would request designated Offices to provide more detailed information than is currently available (at least from a number of Offices) concerning the time limits within which national phase entry should *normally* occur and the extended periods within which there may be a possibility of restoration of rights, allowing the International Bureau to calculate the cases of non-entry on behalf of Offices not able to provide that information directly.

12. On the other hand, standards do exist for sharing information on the further actions set out in paragraph 9, above, and Offices which are in a position to share this information are strongly encouraged to make it available to the International Bureau.

#### Availability of Translations of International Applications

13. Existing Rule 95.1 (proposed to be renumbered as Rule 95.2, as set out in the Annex) has been in place since the Treaty was adopted and requires designated Offices, on request by the International Bureau, to provide copies of translations of the international application provided by applicants for the purpose of the national phase. However, up to this time, such requests have rarely, if ever, been made.

14. Consideration was given to proposing to make the provision of copies of translations a mandatory requirement in all cases. However, most of these translations already become publicly available by virtue of national publications. An analysis of patterns of national phase entry against the Offices which make their national collections available to PATENTSCOPE or other major patent information sources suggested that a mandatory requirement to make translations available in all cases would only lead to the public availability of a very small number of additional language versions of technical disclosures.

15. As such, it appears that the goal of improving availability of technical information in a wider variety of languages will be effectively served by providing information concerning national phase entry in order to more reliably match national publications to corresponding international publications, and by continuing to offer assistance to Offices to make their national patent collections available electronically. The International Bureau will review the possibility of making requests under existing Rule 95.1 (proposed to be renumbered as Rule 95.2) to individual Offices in cases where that would improve the availability of language versions, should this be an easier option for a particular designated Office than making its national collection available, whether for legal or technical reasons.

16. To assist access to patent information in a wide range of languages, PATENTSCOPE includes various tools to assist searching of documents across multiple languages, and for machine translation of publications for which no official translation is available in a particular language. The improved matching of existing translations should allow these tools to be refined, offering improved results for other international applications which do not enter a relevant national phase in order to make a translation available in any particular language.

### Availability of Status Information and National Phase Translations

17. The information which is provided under proposed new Rule 95.1 in relation to published international applications would be published on PATENTSCOPE in its role of providing the part of the PCT Gazette concerning events on individual international applications. Rule 86.1(iv) is proposed to be amended to make clear that the information published would not be limited to the information concerning national phase entry, but would also include the other status information sent under proposed new Rule 95.1. In addition to being made available on PATENTSCOPE, the information would be available in bulk format for subscribers to WIPO's subscription data services, allowing integration of the information into other services.

### **RELATIONSHIP TO STATUS INFORMATION CONCERNING NON-PCT PATENT FAMILIES**

18. Clearly, to allow users to gain a full picture of patent information, it is necessary to have status information on direct national applications. The International Bureau would like to encourage national patent Offices to make available information concerning non-PCT applications. However, that subject is beyond the scope of the PCT Working Group, save to note that:

- (a) it should not be necessary for a designated Office to provide a feed of information to the International Bureau explicitly for the purpose of proposed new Rule 95.1 if it can be extracted from a more general feed of information provided to the International Bureau for other purposes (such as publication of national collections in PATENTSCOPE) within the appropriate time limit;
- (b) the question of availability of national patent documentation is relevant to the review of the scope of the PCT minimum documentation (see document PCT/WG/8/9);
- (c) the International Bureau offers various services to assist national Offices in preparing and publishing their patent information on PATENTSCOPE or elsewhere (see paragraphs 19 to 22, below); and
- (d) to the extent that national Offices are aware of direct national applications which share identical priorities to a PCT application (such as "bypass" applications in the United States of America or divisional applications from international applications), the International Bureau would be prepared to record the relevant information in PATENTSCOPE.

### **TOOLS AVAILABLE TO ASSIST DESIGNATED OFFICES**

19. At present, the International Bureau provides specifications<sup>2</sup> for reporting national phase status information in CSV and XML formats, to be transmitted by e-mail or PCT-EDI, covering the following events:

- (a) national phase entry;
- (b) national publication;
- (c) refusal;
- (d) grant;

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<sup>2</sup> Available from the WIPO website at: [http://www.wipo.int/patentscope/en/data/national\\_phase/procedures.html](http://www.wipo.int/patentscope/en/data/national_phase/procedures.html)

- (e) withdrawal;
- (f) expired/non-maintained; and
- (g) non-entry.

20. In addition, in 2013 the Committee on WIPO Standards set up a Legal Status Task Force<sup>3</sup> with a mandate “to establish a new WIPO standard for the exchange of patent legal status data by industrial property offices”. The International Bureau will endeavor to accept the relevant information according to the new standard as soon as possible after it has been adopted.

21. ePCT for designated Offices provides an action for reporting national phase entries. At present, this is designed primarily for allowing access to the files of international applications which have entered the national phase prior to publication, but it could easily be extended to offer a system for reporting all the required status information by Offices which did not require a more automated solution.

22. The Industrial Property Automation System (IPAS) of the World Intellectual Property Organization (WIPO) is a flexible, modular system in use at over 60 national Offices. It can be customized to individual industrial property (IP) Offices to automate their IP business and administrative processes from application reception to registration, including post-registration actions such as amendments, assignment, renewal, annuities, etc. The main patents module by default allows designated Offices to collect all the information required. A data export module allows the appropriate information to be exported and transmitted to the International Bureau.

*23. The Working Group is invited to consider the proposed amendments to the Regulations contained in the Annex to this document.*

[Annex follows]

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<sup>3</sup> See document CWS/3/7 and paragraphs 50 to 54 of document CWS/3/14.

PROPOSED AMENDMENTS TO THE PCT REGULATIONS<sup>4</sup>

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<sup>4</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

**Rule 86**  
**The Gazette**

86.1 *Contents*

The Gazette referred to in Article 55(4) shall contain:

(i) to (iii) [no change]

(iv) information, ~~if and to the extent furnished to the International Bureau by the designated or elected Offices, on the question whether the requirements provided for in Articles 22 or 39 have been complied with in respect of the international applications designating or electing the Office concerned~~ concerning events at the designated and elected Offices notified to the International Bureau under Rule 95.1 in relation to published international applications;

(v) [No change]

86.2 to 86.6 *[No change]*

## Rule 95

### ~~Availability of Translations~~

#### Information and Translations from Designated and Elected Offices

##### 95.1 Information Concerning Events at the Designated and Elected Offices

Any designated or elected Office shall notify the International Bureau of the following information concerning an international application within one month of the occurrence of the relevant event:

(i) the date of the performance by the applicant of the acts referred to in Article 22 or 39;

(ii) the number and date of any publication of the international application by the designated or elected Office;

(iii) the date of grant of a patent and the number and date of any associated publication.

##### ~~95.1~~95.2 *Furnishing of Copies of Translations*

(a) At the request of the International Bureau, any designated or elected Office shall provide it with a copy of the translation of the international application furnished by the applicant to that Office.

(b) The International Bureau may, upon request and subject to reimbursement of the cost, furnish to any person copies of the translations received under paragraph (a).

[End of Annex and of document]