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## **WORKING GROUP ON THE DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS**

**Second Session  
Geneva, July 16 to 19, 2007**

### **FRAMEWORK PROVISIONS AND ORGANIZATIONAL STRUCTURE**

*Document prepared by the Secretariat*

#### **SUMMARY**

1. Implementation of the digital access service for priority documents is proposed on the basis of a number of (previously) agreed principles and a set of framework provisions set out in this document, as well as the system architecture proposed in document WIPO/DAS/PD/WG/2/2. Participation will be optional for both Patent Offices and applicants. Implementation of the framework provisions by Patent Offices will be a matter for the applicable national or regional law rather than an international obligation. Applicants who comply with the requirements of the applicable law by using the new service will be able to remedy the situation in the event that a priority document is not available in a particular case.
2. As explained in more detail in document WIPO/DAS/PD/WG/2/2, the confidentiality of priority documents that are not publicly available will be preserved by restricting access to Offices that are authorized by the applicant, authorization being assured by 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. The identity of Offices will be assured by the use of secure channels in communications with the International Bureau.
3. Existing systems for the exchange of priority documents in electronic form will continue to operate alongside the new service as well as in cooperation with it. Participation

in the new service will be possible for Offices which do not have the necessary computerized systems by using paper-based communications with the International Bureau.

## INTRODUCTION

4. It is recalled that the International Bureau is required by the Paris Union Assembly, the Patent Law Treaty Assembly and the PCT Union Assembly to, *inter alia*, establish framework provisions for the digital access service for priority documents according to the recommendations of the Working Group (see document A/42/14, paragraph 220).

5. At its first session held in February 2007, the discussions of the Working Group focused on the proposed system architecture and there was no detailed consideration of draft framework provisions (see document WIPO/DAS/PD/WG/1/3) or of organizational structure. The report of the discussion at the session on organizational structure and framework provisions is reproduced for convenient reference in Annex I.

6. At its first session, the Working Group, after considerable discussion, agreed that the new service should be developed having regard to a number of agreed principles, noting that they might be subject to evolution with future consideration by the Working Group and that further principles might need to be included (see paragraph 17 of the report of the first session, reproduced in the Annex to document WIPO/DAS/PD/WG/2/2). The Secretariat suggested that the legal framework necessary for the new service might be established by expanding the agreed principles for subsequent adoption as recommendations by the Working Group, rather than by establishing separate framework provisions as had been proposed in document WIPO/DAS/PD/WG/1/3, and also suggested it might be more appropriate for Offices to confirm their participation in the new system under less formal arrangements than agreements with the International Bureau (see paragraph 37 of the report of the first session, reproduced in Annex I to the present document).

7. Following informal discussions with certain delegations about the system architecture for the new service, revised proposals for the system architecture are now made in document WIPO/DAS/PD/WG/2/2<sup>1</sup>. It also seems that a more simplified approach can be taken to the establishment of framework provisions. While the agreed principles adopted by the Working Group at its first session should continue to be endorsed, it is now suggested that the Working Group not proceed to a more detailed elaboration of them.

8. It does not seem necessary at this stage to elaborate detailed technical standards and procedures for the service. It is suggested that the first implementation of the service be on the basis of technical systems which are in practical use by Offices which already exchange priority documents in electronic form, on the understanding that those systems will be made available to other Offices which wish to participate in the service (see the further discussion in paragraph 26 and in document WIPO/DAS/PD/WG/2/2).

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<sup>1</sup> Working documents and the electronic forum established to facilitate the work of the Working Group are accessible on WIPO's website via [www.wipo.int/pdocaccess](http://www.wipo.int/pdocaccess).

## AGREED PRINCIPLES

9. While, as mentioned in paragraph 7, above, a more detailed elaboration of the principles agreed by the Working Group at its first session is not proposed, it would be appropriate for the Working Group to repeat its endorsement of those principles, with changes necessary to take into account the proposals made in document WIPO/DAS/PD/WG/2/2 in relation to the system architecture and those made below in relation to framework provisions. A text is proposed in Annex II, in which there are two changes from the text as agreed at the first session, one a straightforward clarification and the other a change having regard to what is now proposed in document WIPO/DAS/PD/WG/2/2. The changes are explained in footnotes.

## FRAMEWORK PROVISIONS

10. Proposed framework provisions are set out in Annex III. The provisions are intended to establish a sufficient legal basis for the purposes of both applicants and Patent Offices and to encapsulate the overall operation of the service, but they do not attempt to regulate all details of the system.

11. The proposed framework provisions are supplemented by explanatory notes which it is envisaged would be published together with the provisions. Certain matters remaining to be addressed are indicated by surrounding the text concerned with square brackets. The main features of the provisions are outlined in the following subparagraphs:

(a) deposit of a priority document by a participating “depositing Office” or by the applicant in a recognized digital library (paragraphs 7, 8 and 9 of the proposed framework provisions (“FP”) in Annex III);

(b) recognition by a participating “accessing Office” of access via the service as a means of satisfying Paris Convention requirements for the provision of a priority document (see FP paragraph 10);

(c) implementation of the framework provisions will be a matter for the applicable (national or regional) law, sufficient for Offices and applicants to rely on, but without creating any international treaty-style obligation on participating Patent Offices (see FP paragraph 4);

(d) a deposited priority document that is not publicly available via the service will be available to an accessing Office only with the authorization of the applicant (see paragraphs 18 and 19, below, and FP paragraph 14);

(e) protection against arbitrary loss of rights by an applicant who complies with the requirements of the applicable law by giving access to a priority document via the service arising from a failure of the service to make it available in practice, but at the same time the accessing Office is entitled ultimately to require the applicant to ensure that the priority document is provided in such a case (see FP paragraphs 12 and 13);

(f) translations of priority documents will be included in the operation of the service at some stage when practicable (see FP paragraph 17);

(g) publication of information concerning the service (see FP paragraph 18);

(h) general administration of the service by the International Bureau will be in consultation with a Consultative Group on significant issues such as the recognition of digital libraries and the establishment of operating procedures and technical standards (see FP paragraphs 7, 19 and 21);

(i) the Working Group will be involved in any future modifications of the framework provisions (see FP paragraph 22).

12. Selected treaty provisions and decisions of WIPO and other bodies concerning priority documents are reproduced in Annex IV for convenient reference.

13. Certain aspects of the service are explained in more detail in the following paragraphs.

*Participation by Offices; Relationship with Paris Convention, etc.*

14. The framework provisions do not establish any formal obligation that must be undertaken by participating Offices but instead provide for a simple notification by Offices to the International Bureau of their participation in the main procedures, namely, deposit of priority documents in the system and recognition of deposited priority documents (see FP paragraphs 8 and 10). The provisions are intended to facilitate the furnishing of priority documents for the purposes of the relevant international agreements but do not diminish the basic rights and obligations established by them. Implementation of the framework provisions is left to the applicable national or regional law (see FP paragraph 4), but the International Bureau will publish information concerning participating Offices (see FP paragraph 18(iv)), which appears to provide a sufficient basis for applicants to rely on with confidence.

15. In drafting the proposed framework provisions, the use of the term “shall” has been avoided with this approach in mind. Moreover, the provision for formal agreements between participating Offices and the International Bureau which was made in the documents submitted to the first session of the Working Group has now been omitted.

16. A notification by an accessing Office under FP paragraph 10 enables both Offices and applicants to rely on the service for the purposes of satisfying the Paris Convention requirement that a priority document be furnished. Such a notification would, however, also be based upon the applicability of the (other provisions of the) framework provisions which include, notably, FP paragraphs 11 to 13. The effect of the provisions when read together can be summarized as follows:

(a) If the applicant follows the procedures for making a document available via the service within the time limit fixed under the applicable law for the furnishing of priority documents, it follows from FP paragraph 10 that this would in general be considered as complying with Article 4D(3) of the Paris Convention insofar as the furnishing of the priority document is concerned. Compliance with other requirements of Article 4D, in particular substantive requirements, would of course need to be addressed by the accessing Office independently of the framework provisions.

(b) The International Bureau’s certificate (see FP paragraph 11) would be, in effect, *prima facie* proof that the priority document was available via the service, and hence treated as having been furnished for the purposes of Article 4D(3) of the Paris Convention, on the date specified in the certificate.

(c) Ultimately, however, it would remain the applicant's responsibility to furnish the priority document to the Office if the Office finds that the document is not available via the service, which might happen, for example, because of a failure on the part of the digital library concerned or of the access control mechanism. In such a case, the applicant would be protected by being afforded the opportunity to rectify the situation, within a time limit, by furnishing the priority document directly to the Office or by ensuring that it becomes available to the Office via the service. In the event of failure to comply with the invitation in a timely fashion, the consequences would be as provided by the applicable law.

17. It has been usual to discuss the proposed system in terms of participation by "Offices of first filing" (OFFs) with which an application forming the basis for a later priority claim is filed, and "Offices of second filing" (OSFs) with which an application claiming priority from the previous application is filed. There are some circumstances, however, where a priority document may be made accessible via the service by an OSF rather than the OFF in respect of the application concerned. In the context of the framework provisions, therefore, the terms "depositing Office" and "accessing Office" have been used.

#### *Applicants and the access control code*

18. The system of access control to be used in practice, which would under FP paragraph 14 be provided for as part of the operating procedures and technical requirements established under FP paragraph 21, is outlined in paragraph 2, above. More details, including the ways in which the access control code may be generated, and its uses in connection with the control of access to a deposited priority document, are given in document WIPO/DAS/PD/WG/2/2.

19. One matter requiring further consideration is what role the code might play in actions that might be taken by persons other than the applicant (for example, the applicant's assignee) in the depositing of priority documents, the control of access, the making of requests that a priority document become publicly available and the depositing of translations of priority documents (see FP paragraphs 9, 15(i) and 17).

#### *Provision of priority documents outside the service*

20. It is emphasized that the new service will be as flexible as possible in terms of participation. Use of the service will be optional for both applicants and Patent Offices. Offices which wish to maintain their existing systems for handling priority documents will be able to do so. Applicants who wish to continue to provide priority documents directly to Offices of second filing will be able to do so. Offices which already have systems in place for the exchange of priority documents in electronic form (such as the Trilateral Offices under their TDA arrangements) will be able to continue to use those systems.

#### *Participation by Offices and applicants without necessary technical systems; Technical assistance*

21. Offices which wish to develop systems enabling electronic exchange of priority documents under the new service will be able to seek technical assistance from the International Bureau (see paragraph 8 of the agreed principles set out in Annex II). On the other hand, it will also be possible for Offices which wish to use the new service to do so even if they are not in a position to implement the necessary technical systems. The International Bureau will be prepared to receive priority documents on paper, either from a depositing

Office or from the applicant, and to scan them for inclusion in the International Bureau's digital library. The International Bureau is also prepared to provide priority documents to accessing Offices, on request, as paper printouts of the files held in its digital library.

#### *Commencement of practical operations*

22. FP paragraph 5 provides for the service to commence practical operations on a date to be fixed by the International Bureau after consultation with the Consultative Group to be established under FP paragraph 19. This will enable the completion of the work necessary to make priority documents available through the service from at least one recognized digital library and to establish the necessary access control mechanism. The International Bureau hopes that the first practical implementation of the service will be put in place in the first half of 2008.

#### *Recognized digital libraries and delivery of documents*

23. In order to allow the system to be set up quickly with the potential for access to a large number of priority documents, it is necessary to focus initial development work on providing access to libraries and delivering documents using the existing infrastructure to the greatest extent possible. The largest existing digital libraries are held by the Japan Patent Office, the United States Patent and Trademark Office and the European Patent Office ("the Trilateral Offices"), which communicate using the Trilateral Document Access (TDA) protocols. Paragraph 15 of document WIPO/DAS/PD/WG/2/2 recommends that initial development of the system be done providing communications with depositing and accessing Offices using services based on either TDA or existing PCT communication systems. It is envisaged that the digital libraries to be recognized at the outset will be those operated by the Trilateral Offices and the International Bureau.

#### *Future extension to translations of priority documents*

24. The framework provisions allow for the future extension of the service to allow deposit of and access to translations of priority documents (see FP paragraph 17). The provisions do not, however, 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 made accessible via the services would satisfy the needs of any particular accessing 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.

### ORGANIZATIONAL STRUCTURE

25. The matter of organizational structure was on the agenda of the Working Group's first session but detailed discussion was deferred (see paragraphs 33 and 34 of the report of the first session, reproduced in Annex I).

26. The International Bureau necessarily has a role in coordinating the service, which will operate through a network of cooperating services. Priority documents will be held in digital libraries maintained by different Patent Offices, and access will be sought by a number of different Offices. At the outset, the major holdings will be those of the Trilateral Offices, accessible under the TDA system (as well as the digital library of the International Bureau). The point was made by the Trilateral Offices at the first session of the Working Group that the

Trilateral Offices will need to control and maintain the integrity of their TDA system (see paragraph 16 of the first session report, reproduced in Annex I).

27. It is essential, of course, that changes to the technical systems be made in a coordinated way. However, a highly formal approach to the management of the system does not seem to be necessary. FP paragraph 19 therefore makes provision for operating procedures and technical requirements to be established by the International Bureau after consultation with a Consultative Group comprising all participating Patent Offices together with any other interested Patent Offices and (with observer status, so as to enable the views of applicants and other users to be put forward) interested organizations. In practice, based on experience in the context of the Administrative Instructions and the various Guidelines under the PCT, such consultation would invariably proceed on the basis of consensus.

28. *The Working Group is invited to recommend that the digital access service for priority documents be implemented in accordance with:*

*(i) the agreed principles set out in Annex II; and*

*(ii) the framework provisions set out in Annex III.*

[Annexes follow]

ANNEX I

EXTRACT FROM THE REPORT OF THE  
FIRST SESSION OF THE WORKING GROUP  
(document WIPO/DAS/PD/WG/1/6, paragraphs 35 to 41)

ORGANIZATIONAL STRUCTURE

33. The Chair noted that, while certain issues relating to organizational structure had arisen in connection with the consideration of the system architecture (see above), other such issues would depend on the system architecture that would eventually be agreed upon by the Working Group.

34. The Working Group agreed to defer more detailed consideration of organizational structure to its next session.

TECHNICAL AND LEGAL CONSIDERATIONS

35. The Working Group had before it document WIPO/DAS/PD/WG/1/5, paragraph 22 of which outlined certain technical considerations that the Secretariat felt needed to be addressed, and documents WIPO/DAS/PD/WG/1/3 and 4, which set out, respectively, draft framework provisions and a draft model agreement between a participating Office and the International Bureau.

36. Certain technical and legal considerations are mentioned above in connection with the matter of the system architecture of the new service.

37. The Secretariat suggested that the legal framework necessary for the new service might be established by expanding the agreed principles set out in paragraph 17, above,<sup>[1]</sup> for subsequent adoption as recommendations by the Working Group, rather than by establishing separate framework provisions as had been proposed in document WIPO/DAS/PD/WG/1/3. Moreover, it might be more appropriate for Offices to confirm their participation in the new system under less formal arrangements than agreements with the International Bureau.

38. In response to a question by one delegation in connection with Article 4(4) of the draft framework provisions, the Secretariat suggested that consideration needed to be given by the Working Group to the possibility that a priority document accessible under the service could be made publicly available upon notification by an Office of second filing that it had become publicly available under the provisions of the national law applied by that Office (see also paragraph 24, above).

39. Two delegations expressed the view that the reference in Article 5(2)(i) of the draft framework provisions to Article 4D(3) of the Paris Convention was too specific, leading to uncertain legal implications, notably regarding the interaction with PLT Rule 4(3), and suggested that wording similar to that used in the provisions of the PLT and the PLT

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<sup>1</sup> That is, paragraph 17 of document WIPO/DAS/PD/WG/1/6, which is reproduced in document WIPO/DAS/PD/WG/2/2.



Regulations dealing with compliance with Paris Convention requirements where priority documents are available from a digital library might be preferable.

40. The Working Group agreed to defer more detailed consideration of technical and legal considerations to its next session.

41. The Secretariat informed the Working Group of its intention to review the legal framework with a view to proposing inclusion of necessary provisions in an expanded version of the agreed principles set out in paragraph 17, above,<sup>[2]</sup> for consideration by the Working Group at its next session.

[Annex II follows]

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<sup>2</sup> That is, paragraph 17 of document WIPO/DAS/PD/WG/1/6, which is reproduced in document WIPO/DAS/PD/WG/2/2.

ANNEX II

PROPOSED AGREED PRINCIPLES  
FOR THE IMPLEMENTATION OF THE  
DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS<sup>1</sup>

1. *Business need*

(i) The fundamental requirement is to allow applicants to meet priority document requirements of Offices of second filing without having to physically obtain and submit certified copies with each of them.

(ii) The system will enable voluntary participation by Offices of or acting for<sup>2</sup> any Paris Union Member State, regardless of membership of other Treaties, taking into account the different capacities of Offices.

(iii) Offices will be able to choose to obtain priority documents under an arrangement with the International Bureau as an alternative to multiple bilateral arrangements.

(iv) The system must provide performance improvements and efficiencies for applicants, Offices and the International Bureau over traditional Paris Convention and paper-based arrangements.

2. *Network model*

(i) *Non-duplication of systems:* The system will make use of digital libraries in which Offices hold priority documents. The International Bureau's digital library will hold priority documents from Offices which do not maintain their own.

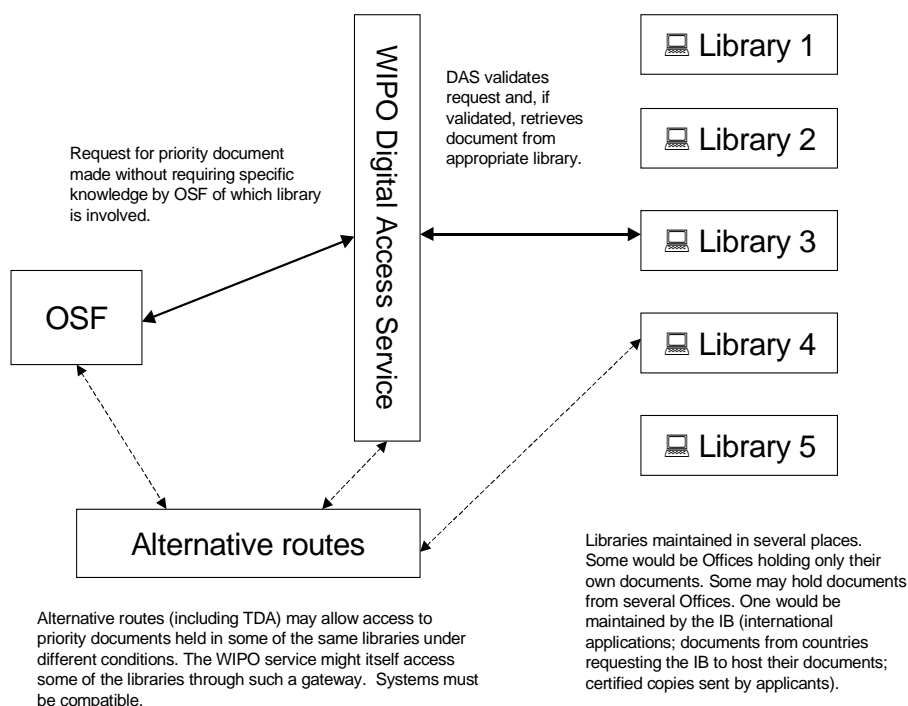
(ii) *Interoperability:* Common protocols and meta-information will be used to ensure that priority documents can be accessed in the same manner irrespective of the digital library in which they are held, be it the International Bureau's, under TDA, or another.

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<sup>1</sup> The text of the agreed principles here is the same as that which appears in paragraph 17 of the report of the Working Group's first session in document WIPO/DAS/PD/WG/1/6, subject to two changes identified in the following footnotes.

<sup>2</sup> The words "of or acting for" have been inserted, replacing the word "from", so as to put it beyond doubt that regional Offices, as well as national Offices, can participate in the system.

*Conceptual Diagram of Networked System  
(Access by Office of Second Filing)*



3. *Flexibility:* The system will allow a wide range of combinations of packaging channels (including paper, physical media (CD-R and DVD), SFTP and TDA) and document format (including paper, ST.36, PCT minimal specification (based on PDF and TIFF) and SDIF) in order to ensure that all existing systems for exchanging priority documents are accommodated. The system will permit the transformation of format in order to facilitate interoperability.

4. *Secure data transmissions:* The security of data transmissions will be at least equivalent to the levels that apply in the systems operating in the context of the PCT for the exchange of sensitive data.

5. *Confidentiality:* There must be an appropriate mechanism, in relation to priority documents that are not publicly available, for ensuring that access is given to Offices of second filing only where authorized by the applicant. This will be implemented by an access control list managed by the applicant, normally through the service's website, but alternatively by sending the required details to the International Bureau if the applicant does not have access to the Internet.<sup>3</sup>

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<sup>3</sup> The second sentence, having regard to what is now proposed in document WIPO/DAS/PD/WG/2/2, replaces that which appeared in document WIPO/DAS/PD/WG/1/6. The original second sentence read: "One possible mechanism would rely on the use of an access control code issued to the applicant, but other possible mechanisms need to be explored and evaluated so as to achieve minimum burden for Offices and applicants."

6. *Translations and other documents:* The system will enable applicants to deposit certified translations of priority documents in a digital library for making them accessible to Offices of second filing under generally similar arrangements to those for priority documents. Further work is needed to address the implications of different Offices' certification requirements for translations, the possibility of obtaining translations from other sources, and the possible use of the system for other associated documents, for example, documents confirming the right of priority, in particular where the right is transferred to other persons.

7. *Efficiency*

(i) *Avoid duplication:* Duplication of work, data holdings and information between the International Bureau and Offices will be avoided. This applies in particular to existing digital libraries such as under TDA arrangements.

(ii) *Improve technical capacity:* The system will be geared to handle large volumes of data and data transmissions, with appropriate speed of uploading and downloading, with built-in flexibility to cater to potentially increased needs in the future.

(iii) *Transparency:* WIPO's website will provide up-to date details about the system, including the conceptual framework, the nature and scope of participation by Offices in the system, the location of priority document holdings, Office requirements and operational details, including changes in those things.

8. *Developing countries:* The International Bureau will provide technical assistance and adequate capacity building to developing countries, in particular least developed countries, based on discussion of their individual needs, to facilitate their participation in the system.

9. *Charges:* The International Bureau will not charge a fee for use of the service.

[Annex III follows]

ANNEX III

PROPOSED FRAMEWORK PROVISIONS FOR THE  
DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS

*established on [date]*

*Digital Access Service*

1. The digital access service for priority documents (“the service”) operates in accordance with these provisions.
2. These provisions are established by the International Bureau in accordance with the recommendations of the Working Group on the Digital Access Service for Priority Documents (“the Working Group”)<sup>1</sup>, as decided by the Paris Union Assembly, the Patent Law Treaty Assembly and the PCT Union Assembly<sup>2</sup>.
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<sup>3</sup>.
4. The implementation of these provisions by Patent Offices is a matter for the applicable law<sup>4</sup>.
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<sup>5</sup>.
6. Words and expressions used in these provisions are to be understood with reference to paragraph 23.

*Recognized Digital Libraries*

7. A digital library is recognized for the purposes of these provisions (“recognized digital library”) if it is so designated by the International Bureau when the service commences practical operations<sup>6</sup> or, having regard to the criteria referred to in paragraph 21 and after consultation with the Consultative Group, at a later time.

*Depositing Offices and Availability of Priority Documents Via the Service*

8. A Patent Office (“depositing Office”) may notify the International Bureau that copies of patent applications deposited by it in a recognized digital library<sup>7</sup> 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 21, including any specification of options from among those available.
9. 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 the recognized digital library operated by the Bureau or the Office, respectively, and made available via the service.

### *Accessing Offices*

10. A Patent Office (“accessing Office”) may notify the International Bureau that, for the purposes of the applicable law<sup>8</sup> and [in accordance with these provisions] [subject to paragraphs 11 to 13], 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 21, including any specification of options from among those available.

11. A certificate by the International Bureau that a priority document is available via the service to a particular accessing Office, including bibliographic details and the date on which the priority document became available, is made available on WIPO’s website to the applicant and the Office. The certificate is, subject to [these provisions] [paragraphs 12 and 13], accepted by the Office for the purposes of the applicable law as proof of the matters it contains. A copy of the certificate is sent by the International Bureau, upon request, to the applicant or the Office.

### *Opportunity to Comply*

12. Where a certificate referred to in paragraph 11 states that a priority document was available via the service to an accessing Office on a date which was on or before the date by which the priority document was required to be furnished under the applicable law, but the Office finds, on or after the latter date, that the priority document is in fact not available to it, the Office invites the applicant to furnish the priority document to it, or to ensure that the priority document is made available to it via the service, within [a reasonable time limit] [a time limit of not less than [one month] from the date of the invitation].

13. Where the priority document 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 does not become available to the Office within that time limit, the consequences provided by the applicable law apply.

### *Priority Documents That Are Not Publicly Available*

14. A priority document that is not publicly available under paragraph 15 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 21.

### *Priority Documents Becoming Publicly Available*

15. A priority document becomes publicly available via the service:

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

(ii) upon a notification received by the International Bureau from the depositing Office or an authorized accessing Office that the document is publicly available under the applicable law;

(iii) 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<sup>9</sup>.

16. A priority document that is publicly available under paragraph 15 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*

17. 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, and these provisions shall apply *mutatis mutandis*<sup>10</sup>.

#### *Publication of Information*

18. 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) recognized digital libraries;
- (iv) notifications and information received from Patent Offices under paragraphs 8 and 10;
- (v) operating procedures and technical requirements referred to in paragraph 21.

#### *Consultative Group*

19. The Consultative Group consists of:

- (i) Patent Offices from which the International Bureau receives a notification under paragraph 8 or 10;
- (ii) any other Patent Offices that notify the International Bureau that they wish to participate in the Group;
- (iii) with observer status, interested organizations invited to meetings of the Working Group that notify the International Bureau that they wish to participate in the Group.

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

#### *Operating Procedures and Technical Requirements*

21. 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 recognition of digital libraries<sup>11</sup> under paragraph 7 and the means by which applicants authorize access<sup>12</sup> for the purpose of paragraph 14.

*Modification*

22. 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.

*Meanings of Words and Expressions*

23. 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<sup>13</sup>;

(iv) “Consultative Group” means the Consultative Group referred to in paragraph 19;

(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 to which the Patent Law Treaty applies<sup>14</sup>;

(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<sup>15</sup>;

(x) “PCT” means the Patent Cooperation Treaty;

(xi) “PCT Union” means the International Patent Cooperation Union;

(xii) “priority document” means a certified copy of a patent application<sup>16</sup>;

(xiii) “WIPO” means the World Intellectual Property Organization.



EXPLANATORY NOTES

*(not forming part of the framework provisions)\**

1. For the recommendations of the Working Group, see its report, adopted on [July 19, 2007], document WIPO/DAS/PD/WG/2/[...], paragraphs [...].
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.
3. The relevant international agreements and understandings include, in particular:
  - (i) the Agreed Statement by the Diplomatic Conference for the Adoption of the Patent Law Treaty, 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 for the Protection of Industrial Property ("Paris Convention"), the Patent Law Treaty ("PLT") and the Patent Cooperation Treaty ("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.
4. That is, 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 relevant international agreements but do not diminish the basic rights and obligations established by them. See also paragraphs 14 to 16 in the main body of this document.
5. This will, for example, enable the giving of notifications under paragraphs 8, 10 and 19(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.

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\* The explanatory notes would be supplemented by further information, for example, extracted from the main body of the present document, when the framework provisions are published.

6. The International Bureau envisages that the initial designation of recognized digital libraries would be of those Patent Offices which are already in practice exchanging priority documents in electronic form, namely, the Japan Patent Office, the United States Patent Office and the European Patent Office, as well as of the International Bureau itself.
7. 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.
8. See paragraphs 14 to 16 in the main body of this document and notes 3 and 4, 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.
9. See Rule 17.2(c) of the PCT Regulations.
10. Operating procedures and technical requirements providing for the deposit of and access to translations would need to be established under paragraph 21 of the framework provisions before a date could be determined under paragraph 17. 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.
11. It is envisaged that the criteria for recognition of digital libraries might include, for example, a requirement that arrangements be in place for deposited priority documents to be stored for [at least 30 years] 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 Rule 93.2(a) of the Regulations under the PCT.
12. 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.
13. See note 3(iii), above.
14. The kinds of applications to which the Patent Law Treaty applies are set out in Article 3(1) of that Treaty, which in turn refers to certain provisions of the Paris Convention and the PCT. See also the Explanatory Notes on Article 3 of the Patent Law Treaty.

15. See also note 3(iv), above.
16. See also the definition of “certified” in paragraph 23(iii) of the framework provisions.

[Annex IV follows]

ANNEX IV

SELECTED TREATY PROVISIONS AND DECISIONS OF WIPO  
AND OTHER BODIES CONCERNING PRIORITY DOCUMENTS

PART A. PARIS CONVENTION FOR THE PROTECTION  
OF INDUSTRIAL PROPERTY

*Article 4*

[A. to I. *Patents, Utility Models, Industrial Designs, Marks, Inventors' Certificates: Right of Priority.* — G. *Patents: Division of the Application*]

[...]

D. — (1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country shall determine the latest date on which such declaration must be made.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required.

Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.

[...]

PART B. PATENT LAW TREATY (PLT)

*Article 6*  
*Application*

[...]

(5) [*Priority Document*] Where the priority of an earlier application is claimed, a Contracting Party may require that a copy of the earlier application, and a translation where the earlier application is not in a language accepted by the Office, be filed in accordance with the requirements prescribed in the Regulations.

[...]

REGULATIONS UNDER THE PLT

*Rule 4*  
*Availability of Earlier Application Under Article 6(5) and Rule 2(4)*  
*or of Previously Filed Application Under Rule 2(5)(b)*

(1) [*Copy of Earlier Application Under Article 6(5)*] Subject to paragraph (3), a Contracting Party may require that a copy of the earlier application referred to in Article 6(5) be filed with the Office within a time limit which shall be not less than 16 months from the filing date of that earlier application or, where there is more than one such earlier application, from the earliest filing date of those earlier applications.

(2) [*Certification*] Subject to paragraph (3), a Contracting Party may require that the copy referred to in paragraph (1) and the date of filing of the earlier application be certified as correct by the Office with which the earlier application was filed.

(3) [*Availability of Earlier Application or of Previously Filed Application*] No Contracting Party shall require the filing of a copy or a certified copy of the earlier application or a certification of the filing date, as referred to in paragraphs (1) and (2), and Rule 2(4), or a copy or a certified copy of the previously filed application as referred to in Rule 2(5)(b), where the earlier application or the previously filed application was filed with its Office, or is available to that Office from a digital library which is accepted by the Office for that purpose.

(4) [*Translation*] Where the earlier application is not in a language accepted by the Office and the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable, the Contracting Party may require that a translation of the earlier application referred to in paragraph (1) be filed by the applicant, upon invitation by the Office or other competent authority, within a time limit which shall be not less than two months from the date of that invitation, and not less than the time limit, if any, applied under that paragraph.

PART C. AGREED STATEMENT BY THE PLT DIPLOMATIC CONFERENCE

[...]

3. When adopting Articles 6(5) and 13(3), and Rules 4 and 14, the Diplomatic Conference urged the World Intellectual Property Organization to expedite the creation of a digital library system for priority documents. Such a system would be of benefit to patent owners and others wanting access to priority documents.

[...]

PART D. PATENT COOPERATION TREATY (PCT)

*Article 8*  
*Claiming Priority*

(1) The international application may contain a declaration, as prescribed in the Regulations, claiming the priority of one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property.

(2)(a) Subject to the provisions of subparagraph (b), the conditions for, and the effect of, any priority claim declared under paragraph (1) shall be as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property.

(b) The international application for which the priority of one or more earlier applications filed in or for a Contracting State is claimed may contain the designation of that State. Where, in the international application, the priority of one or more national applications filed in or for a designated State is claimed, or where the priority of an international application having designated only one State is claimed, the conditions for, and the effect of, the priority claim in that State shall be governed by the national law of that State.

REGULATIONS UNDER THE PCT

*Rule 17*  
*The Priority Document*

17.1 *Obligation to Submit Copy of Earlier National or International Application*

(a) Where the priority of an earlier national or international application is claimed under Article 8, a copy of that earlier application, certified by the authority with which it was filed (“the priority document”), shall, unless that priority document has already been filed with the receiving Office together with the international application in which the priority claim is made, and subject to paragraphs (b) and (b-*bis*), be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date, provided that any copy of the said earlier application which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the date of international publication of the international application.

(b) Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to prepare and transmit the priority document to the International Bureau. Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office to the payment of a fee.

(*b-bis*) Where the priority document is, in accordance with the Administrative Instructions, available to the receiving Office or to the International Bureau from a digital library, the applicant may, as the case may be, instead of submitting the priority document:

- (i) request the receiving Office to obtain the priority document from such digital library and transmit it to the International Bureau; or
- (ii) request the International Bureau to obtain the priority document from such digital library.

Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office or the International Bureau to the payment of a fee.

(c) If the requirements of none of the three preceding paragraphs are complied with, any designated Office may, subject to paragraph (d), disregard the priority claim, provided that no designated Office shall disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which shall be reasonable under the circumstances.

(d) No designated Office shall disregard the priority claim under paragraph (c) if the earlier application referred to in paragraph (a) was filed with it in its capacity as national Office or if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library.

## 17.2 *Availability of Copies*

(a) Where the applicant has complied with Rule 17.1(a), (b) or (*b-bis*) the International Bureau shall, at the specific request of the designated Office, promptly but not prior to the international publication of the international application, furnish a copy of the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy. The applicant shall not be required to furnish a translation to the designated Office before the expiration of the applicable time limit under Article 22. Where the applicant makes an express request to the designated Office under Article 23(2) prior to the international publication of the international application, the International Bureau shall, at the specific request of the designated Office, furnish a copy of the priority document to that Office promptly after receiving it.

(b) The International Bureau shall not make copies of the priority document available to the public prior to the international publication of the international application.

(c) Where the international application has been published under Article 21, the International Bureau shall furnish a copy of the priority document to any person upon request and subject to reimbursement of the cost unless, prior to that publication:

- (i) the international application was withdrawn,
- (ii) the relevant priority claim was withdrawn or considered, under Rule 26*bis*.2(b), not to have been made.



PART E. AGREED UNDERSTANDING ADOPTED BY THE  
ASSEMBLIES OF THE PARIS UNION AND THE PCT UNION

(adopted by the Assemblies on October 5, 2004; document A/40/7, paragraph 173, referring to document A/40/6, paragraph 9, in which an agreed understanding was proposed in order to enhance certainty with respect to the growing use of electronic means for the provision, storage and dissemination of priority documents)

The Assemblies of the Paris Union and the PCT Union agree that the following principles shall apply to the application of Article 4D(3) of the Paris Convention, Article 8 of the PCT and Rule 17 of the PCT Regulations:

- (i) it is for the competent authority furnishing the priority document to determine what constitutes certification of a priority document and the date of filing, and how it will certify such a document;
- (ii) each Office will accept a single certification that applies to more than one priority document (“collective certification”), provided that such certification permits identification of all priority documents to which it relates;
- (iii) a non-exhaustive list of examples of forms of certification of priority documents agreed to be acceptable consists of the following:
  - certification in paper form;
  - certification in electronic character coded form;
  - an electronic image of a certification on paper;
  - the collective certification of multiple priority documents transmitted by an Office to another Office or to the International Bureau;
  - the collective certification of multiple priority documents contained in an Office database providing access to such documents to those entitled;
- (iv) for the purpose of Article 8 and Rule 17 of the PCT, once a priority document has been issued and certified in accordance with the foregoing principles by the receiving Office, and transmitted to the International Bureau in electronic form, no designated or elected Office may require any different form of certification or any re-certification of that priority document; however, the International Bureau will continue, on request by any designated or elected Office, to furnish copies in paper form of priority documents held in connection with international applications under the PCT.

[End of Annex IV and of document]