

Working Group on the Digital Access Service for Priority Documents

**Third Session
Geneva, July 12 to 15, 2011**

ENHANCEMENT OF THE DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS (DAS) AND ENLARGEMENT OF ITS SCOPE

Document prepared by the Secretariat

I. SUMMARY

1. The document outlines the need to consider extension of the WIPO Digital Access Service for Priority Documents ("DAS") to cover applications for industrial designs, trademarks and utility models and the issues which need to be considered in order to implement such an extension. It also outlines the benefits of the system for Offices and applicants, and highlights the need to review the system to ensure that it is as secure, efficient and easy to use as possible.

II. INTRODUCTION

2. Since April 2009, DAS has been in operation facilitating access to patent priority documents issued by participating Patent Offices.
3. In June 2009, the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) requested the Secretariat to examine the possible extension of DAS to priority documents in the areas of industrial designs and trademarks. Accordingly, the Secretariat prepared a document entitled "Digital Access Service for Priority Documents" (document SCT/22/7) which concluded that the extension of DAS to industrial design and trademark priority documents would offer the possibility for a more streamlined and cost-efficient handling of such documents, for the benefit of both offices and applicants.

4. In November 2009, the SCT took note of document SCT/22/7, and requested the Secretariat to advance work on the establishment of a digital access service for industrial design and trademark priority documents in a way that would ensure the largest possible participation of interested offices in such a service (see document SCT/22/9, paragraphs 66 to 78).
5. In September 2010, the Director General sent a circular letter to all Member States of the Paris Union and WIPO, as well as to interested organizations, requesting feedback from Industrial Property Offices on the further enhancement of DAS and its possible extension to trademark and industrial design priority documents. The vast majority of the 45 Offices that replied to the questionnaire expressed a broad support to the extension of DAS to those types of documents (see information provided in Annex I).
6. Meanwhile, some Patent Offices already participating in DAS have suggested, first, that the system relating to patents should be extended to allow the transmission of priority documents which are copies of utility model applications and, second, that the system architecture of DAS could be enhanced so as to make the service more user-friendly and secure.
7. Following the above-mentioned initiatives, the International Bureau decided to convene a Third Session of the Working Group on the Digital Access Service for Priority Documents ("the Working Group")¹, with a view to examining proposals to enhance the operation of DAS and enlarge its scope.
8. In preparation for the Third Session of the Working Group, the International Bureau has prepared four working documents, as follows:
 - (i) The present document recalls the background and main features of DAS and analyzes in some detail the proposals made to enlarge its scope.
 - (ii) Document WIPO/DAS/PD/WG/3/3 describes the technical system architecture of DAS and suggests how it would support the extension of DAS to industrial designs utility models and trademarks and, in general terms, enable further improvement of the DAS usability.
 - (iii) Document WIPO/DAS/PD/WG/3/4 contains a proposal for the adoption of revised Framework Provisions that would enable DAS to handle not only patent priority documents but also trademark utility model and industrial design priority documents.
 - (iv) Document WIPO/DAS/PD/WG/3/5 contains a proposal for revisions to the applicant portal and to the bibliographic information transferred between Offices to accompany priority documents in order to provide some specific improvements to the service which is currently available for patent priority documents.
9. It is expected that, in addition, one or more proposals for revision to the system architecture will be presented by Member States in order to address various specific concerns with the system.

¹ The Working Group was established by a decision taken by the Assemblies of the Paris Union for the Protection of Industrial Property, the Patent Law Treaty (PLT) and the International Patent Cooperation Union (PCT Union) in 2006, and is composed of the States party to the Paris Convention, the PLT and the PCT.

III. DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS

Background

10. In accordance with Article 4D(3) of the Paris Convention for the Protection of Industrial Property (“the Paris Convention”), national and regional offices may require that priority claims in patent, trademark and industrial design applications be substantiated by certified copies of the application from which priority is claimed (“priority documents”).
11. Traditional paper-based means of furnishing and certifying priority documents are burdensome and inefficient, both for Offices which have to issue, receive and scan them (even though in many cases the earlier application would have been stored in electronic form by the Office of First Filing) and for applicants who have to obtain and transmit multiple copies.
12. In the field of patents, the handling of priority documents has been significantly rationalized. With regard to international applications under the Patent Cooperation Treaty (PCT), procedures have been put in place under the PCT Regulations to streamline and render more cost-effective the treatment of priority documents to the extent that later applications to other Offices are made using that system. Moreover, the Patent Law Treaty (PLT) contains several provisions which aim at rationalizing formalities relating to priority claims, in particular by providing that a Contracting Party is not to require applicants to file a copy of the earlier application where that earlier application is, *inter alia*, available to the Office of that Contracting Party from a digital library which the Office accepts for that purpose.
13. In April 2009, in order to facilitate access to patent priority documents, WIPO established DAS. DAS was established based on a decision taken by the Paris Union Assembly, the PLT Assembly and the PCT Union Assembly in 2006 (see Annex II).

Main Features

14. At present, DAS functions as follows:
 - (i) At the request of the applicant, the Office of first filing (“depositing Office”) registers a priority document with DAS (that is, it indicates or confirms that the document has been deposited in a digital library participating in DAS and is available to the service).
 - (ii) The applicant uses an access code (issued by the depositing Office or the International Bureau) to log into the DAS portal at WIPO’s website where he uses an “access control list” to indicate which Offices of second filing (“accessing Offices”) are permitted access to the document.
 - (iii) The applicant making a second filing, instead of submitting a paper copy of the priority document, asks the office of second filing (“accessing Office”) to retrieve a copy of the document via DAS. The accessing Office sends a request to DAS. If the relevant application number is known to the service and the applicant has specified that it should be open to that Office, a copy of the document is retrieved and passed on to it.
15. DAS offers multiple advantages to participating Offices and applicants using the service. Participating Offices benefit from a reduced need to prepare, check or scan certified paper copies of priority documents. By participating in DAS, they offer a new service at low cost for local applicants wishing to file applications in other countries. Applicants using DAS benefit from a quick and inexpensive service; they no longer need to provide certified paper copies separately to each Office of second filing participating in DAS.

System Requirements

16. For the purpose of communicating with participating offices, DAS builds on existing system architectures used by several offices and under the PCT, in particular the Electronic Document Interchange (PCT-EDI) and the Trilateral Document Access Priority Document eXchange (TDA-PDX) systems. Both systems implement secure transport mechanisms which take due account of the need to ensure the confidentiality of unpublished priority documents.
17. For the benefit of Offices lacking PCT-EDI or TDA-PDX system architectures, WIPO has developed a web portal access which allows Offices to participate in a small scale with no infrastructure other than a scanner, a PC with a good Internet connection and a WIPO digital certificate. This option is particularly suitable for Offices that expect to pass a maximum of about five documents a day.
18. DAS is available also to offices which are not in a position to handle documents in electronic form. Priority documents can be submitted in paper form and scanned by the International Bureau for uploading into the DAS digital library held in WIPO. Similarly, priority documents which are available in all participating digital libraries can be provided in paper form by the International Bureau to those offices which are not in a position to access them electronically. However, while this can provide some benefits to applicants, it is recognized that it does not offer Offices significant benefits over the conventional approach to priority documents and it is strongly recommended that small Offices consider the use of the web portal noted in paragraph 17, above, before seeking to use the paper-based option.

Participation in DAS

19. As of May 23, 2011, eight Patent Offices are participating in DAS. They include the national Offices of Australia, Finland, Japan, Republic of Korea, Spain, United Kingdom and the United States of America, as well as the PCT Receiving Office of the International Bureau. These eight offices are participating in the service both as depositing Office and accessing Office. Several other offices are at various stages of development towards using this service and expressions of interest have been received from many others.
20. The use of DAS is voluntary for both applicants and offices. WIPO does not charge for DAS. However, a fee may be charged by the depositing Office or the accessing Office for the storage or retrieval of documents.

Legal Framework

21. The functioning of DAS relies on an Agreed Understanding Concerning the Certification of Priority Documents adopted by the Assemblies of the Paris Union and the PCT Union in 2004 (see Annex III). This Agreed Understanding concerns the principles that shall apply to the application of Article 4D(3) of the Paris Convention and was adopted in order to enhance certainty with respect to the growing use of electronic means for the provision, storage and dissemination of priority documents.
22. DAS operates in accordance with the Framework Provisions for the Digital Access Service for Priority Documents ("the Framework Provisions"), established by the International Bureau on March 31, 2009, in accordance with the decision taken by the Paris Union Assembly, the PLT Assembly and the PCT Union Assembly in 2006 (see Annex II) and the recommendations of the Working Group convened following that decision. These Framework Provisions are important mainly to ensure sufficient consistency between Offices to allow the system to function securely and reliably and to guarantee that Offices using the system will in fact recognize the documents which are transferred as being valid priority documents according to their national laws.

IV. EXTENSION OF DAS TO INDUSTRIAL DESIGN PRIORITY DOCUMENTS

General Remarks

23. As indicated above, the SCT has recommended the extension of DAS to industrial design priority documents. This would facilitate a more streamlined and efficient handling of such documents, in the benefit of both applicants and Offices, as many Offices do require the filing of priority documents where priority has been claimed.
24. The general features of the service with regard to industrial design priority documents would be the same as for patent priority documents, as described in paragraph 14, above.
25. The extension of the service to industrial designs would also be of interest to the International Bureau in the context of the operation of the Hague Agreement for the International Registration of Industrial Designs ("the Hague Agreement"). An international industrial design application can serve as a basis for claiming priority and shall be the equivalent to a regular filing within the meaning of Article 4 of the Paris Convention². The International Bureau is the Office of first filing for many international applications filed under the Hague Agreement³. If DAS is extended to industrial design priority documents, the International Bureau will participate in the service in its capacity as filing Office under the Hague Agreement.

System Requirements

26. The extension of the current DAS to be able to handle also industrial design priority documents would build on the PCT-EDI transfer protocol. Not only is that system appropriate to handle priority documents for industrial designs, but it is also already used by a broad⁴ range of offices.
27. As indicated in document WIPO/DAS/PD/WG/3/3, some work has been advanced to allow the DAS system architecture to handle industrial design priority documents. However, certain technical features still need to be revised in order to meet specific requirements that are proper to industrial designs, such as the capacity to support exchange of color, grayscale and large-sized images.

² Article 4A(2) of the Paris Convention provides the following: "Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority".

³ In 2010, the International Bureau was the office of first filing with respect to approximately 1,500 international industrial design applications (around 63% of the total number of applications received that year), and that number is due to increase as new accessions to the Geneva Act of the Hague Agreement occur. In the same year, the International Bureau had to issue 395 extracts and 1,556 certified copies of international applications, all of which were transmitted in paper form.

⁴ At the date of drafting of this document, approximately 20 offices use the PCT-EDI transfer protocol for exchange of PCT application documents and data between Offices and WIPO.

Legal Considerations

28. While DAS was initially designed having regard to patent priority documents, and operates at present only for those documents, the decision taken by the Paris Union Assembly, the PLT Assembly and the PCT Union Assembly in 2006 (see Annex II) was not limited to the establishment of a service for priority documents for patents, but rather relates to a service for priority documents in general. Hence, operation of the service for industrial design priority documents would not require a new endorsement by the Assembly of the Paris Union.
29. In addition, the extension of the service to industrial design priority documents would rely on the Agreed Understanding Concerning the Certification of Priority Documents adopted by the Assemblies of the Paris Union and the PCT Union in 2004. That understanding, which is not limited to patent priority documents, is equally applicable to priority documents concerning other industrial property rights (see Annex III).
30. On the other hand, the Framework Provisions established by the International Bureau in March 2009 would need to be adapted to cover operation of the service with respect to industrial design priority documents. Draft changes to the Framework Provisions are proposed in document WIPO/DAS/PD/WG/3/4 for consideration by the Working Group.

V. EXTENSION OF DAS TO TRADEMARK PRIORITY DOCUMENTS

General Remarks

31. The general features of the service with regard to trademark priority documents would be similar to those for patent and industrial design priority documents as described above. However, the procedures to be followed by offices and applicants would be simpler, as explained below.
32. With respect to trademarks, the International Bureau would not be an Office of first filing. Under the Madrid Agreement for the International Registration of Marks and the Protocol Relating to that Agreement ("the Madrid System"), an international application must be based on a registration or, under the Madrid Protocol, an application of the mark in the Office of origin.
33. Neither would the service be used in respect of priority claims made in international applications filed under the Madrid System. Pursuant to Article 4(2) of the Madrid Agreement and Protocol, international registrations enjoy the right of priority, without it being necessary for them to comply with the formalities provided for in Section D of Article 4 of the Paris Convention.
34. The service would however be useful to streamline the procedures relating to priority claims outside the Madrid System, as national and regional offices generally require the filing of priority documents, where priority has been claimed.

System Requirements

35. The DAS system architecture proposed for the processing of both patent and industrial design priority documents, takes into account the need for a relatively high level of confidentiality in the relevant procedures. However, insofar as novelty and deferment of publication are not of concern with respect to trademarks, such high level of confidentiality would arguably not be required for trademark priority documents.
36. Consequently, as indicated in document WIPO/DAS/PD/WG/3/3 the system architecture for handling trademark priority documents would be simpler.

Legal Considerations

37. The extension of the existing DAS to trademark priority documents would not need an additional endorsement by the Paris Union Assembly. The considerations set out in paragraph 28, above, are applicable.
38. As would be the case for industrial designs, the operation of the service for trademark priority documents would also be based on the Agreed Understanding Concerning the Certification of Priority Documents adopted by the Assemblies of the Paris Union and the PCT Union in 2004 (see paragraph 29, above).
39. Finally, the Framework Provisions established by the International Bureau in March 2009 would need to be adapted to cover the operation of the service with respect to trademark priority documents. Draft changes to the Framework Provisions are proposed in document WIPO/DAS/PD/WG/3/4 for consideration by the Working Group.

VI. EXTENSION OF DAS TO UTILITY MODEL PRIORITY DOCUMENTS

General Remarks

40. The general features of the service with regard to utility model priority documents would be almost identical to those for patents.

System Requirements

41. From the perspectives of security and document contents, the requirements for priority documents based on utility models are identical to those for patents. The only significant difference is the greater likelihood that a utility model may be used as the basis for a priority claim in a later industrial design application, in addition to later patent and utility model applications.

Legal Considerations

42. The extension of the existing DAS to utility model priority documents would not need an additional endorsement by the Paris Union Assembly. The considerations set out in paragraph 28, above, are applicable.
43. As would be the case for industrial designs and trademarks, the operation of the service for utility model priority documents would also be based on the Agreed Understanding Concerning the Certification of Priority Documents adopted by the Assemblies of the Paris Union and the PCT Union in 2004 (see paragraph 29, above).
44. Finally, the Framework Provisions established by the International Bureau in March 2009 would need to be adapted to cover the operation of the service with respect to utility model applications. Draft changes to the Framework Provisions are proposed in document WIPO/DAS/PD/WG/3/4 for consideration by the Working Group.

VII. IMPROVING THE SECURITY, EFFICIENCY, RELIABILITY AND EASE OF USE OF THE SYSTEM

45. Experience with the system has shown that, while the system works effectively when used by applicants which fully understand it, there are too many errors as a result of the multiple stages which are involved in the process. There remains room to make it simpler.

46. In addition, while the system is very secure in terms of ensuring that documents cannot be accessed by anyone other than Offices to which permission has specifically been given, there remains scope for confidential information becoming available to third parties as a result of errors by applicants or Offices.
47. Finally, as the system becomes more widely used, it becomes ever more important that it is reliable. While the nature of the system is such that it does not necessarily need to be available at all times, certainty is needed of what levels of service can be guaranteed. This implies the need for a service level agreement between the International Bureau and participating Offices covering the availability of the core systems and the participating digital libraries (though the requirement may be notional in the case of Offices whose libraries are themselves hosted by the International Bureau).
48. These issues are explored in more detail in document WIPO/DAS/PD/WG/3/5, with proposals for consequential changes to the Framework Provisions in document WIPO/DAS/PD/WG/3/4.

VIII. POSSIBLE ESTABLISHMENT OF A DIGITAL ACCESS SERVICE FOR OTHER TYPES OF DOCUMENTS THAT MAY BE REQUIRED IN THE CONTEXT OF INDUSTRIAL PROPERTY PROCEDURES

49. In the course of the consultations held by the International Bureau in 2010 concerning the extension of DAS to trademark and industrial design priority documents, the question was raised whether the scope of DAS could be further enlarged so as to enable the service to also handle trademark registration certificates. This would be of particular interest to Offices and trademark owners in the context of the implementation of Article 6*quinquies* of the Paris Convention ("*telle quelle*" clause).
50. Paragraph A(1) of Article 6*quinquies* provides that "Every trademark duly registered in the country of origin shall be accepted for filing and protected as is ("*telle-quelle*") in the other countries of the Union, subject to the reservations indicated in this Article. Such countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin, issued by the competent authority. No authentication shall be required for this certificate". Offering a centralized digital access service for trademark registration certificates would thus present obvious advantages both for Offices and trademark owners.
51. At the SCT session held in November 2010, the possible extension of DAS to digital registration certificates was likewise encouraged (see document SCT/24/7, paragraph 10).
52. In addition, it has been suggested that the International Bureau and interested offices might wish to consider offering also a digital access service for other types of documents that may be required in the context of procedures for the registration or granting of industrial property rights. Such would be the case, for example, of documents that have to be submitted to industrial property offices in order to justify assignments or other transfers of ownership on industrial property rights; or documents referring to prior art that need to be produced in support of a design patent application. Such a service would certainly be of interest both to Offices and holders of industrial property rights.
53. Taking into account these suggestions, the International Bureau has planned to examine the possibility of establishing, in cooperation with interested Industrial Property Offices, a digital access service similar to DAS that would facilitate access to documents other than priority documents that such offices may require in the context of procedures for the registration or granting of industrial property rights.

54. *The Working Group is invited to:*
- (i) *consider the proposals made in this document and approve the extension of DAS to priority documents relating to trademarks, industrial designs, and utility models, and*
 - (ii) *take note of the plans of the International Bureau to examine the possibility of establishing, in cooperation with interested Industrial Property Offices, a digital access service similar to DAS that would facilitate access to documents other than priority documents that such Offices may require in the context of procedures for the registration or granting of industrial property rights.*

[Annexes follow]

FEEDBACK ON THE DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS (DAS)
RECEIVED IN RESPONSE TO WIPO CIRCULAR C.M. 1356 DATED SEPTEMBER 30, 2010

1. In September 2010, the Director General sent a circular letter to all Member States of the Paris Union and WIPO, as well as to interested intergovernmental organizations, requesting feedback from Industrial Property Offices on the enhancement of DAS and its possible extension to trademark and industrial design priority documents.
2. Replies to the circular were received from 45 Industrial Property Offices, including the Offices of Albania, Argentina, Armenia, Austria, Bahrain, Bangladesh, Brazil, Bulgaria, Chile, China, Colombia, Costa Rica, Croatia, Denmark, Ecuador, El Salvador, Estonia, Germany, Greece, Hungary, Iceland, Iraq, Japan, Latvia, Lithuania, Madagascar, Monaco, New Zealand, Norway, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Serbia, Slovakia, Slovenia, South Africa, Suriname, Sweden, Trinidad and Tobago, Turkey, United States of America, Uruguay and the African Regional Intellectual Property Organization (ARIPO).
3. From the answers received, the following information resulted:
 - (a) With respect to industrial design applications, 38 Offices (85%) systematically require the applicant to furnish a priority document whenever the priority of an earlier application is claimed; five Offices (11%) require the furnishing of a priority document only in special circumstances (for example, in case of opposition, or in case of doubt, or when the grant of the right to protection depends on the validity of the claim to priority, or when the office of first filing does not have an online register, etc.); two Offices (4%) never require a priority document (one of them only requires a simple copy of the earlier application).
 - (b) With respect to trademark applications, 36 Offices (80%) systematically require the applicant to furnish a priority document whenever the priority of an earlier application is claimed: seven Offices (16%) require such a document only in special circumstances; and two Offices (4%) never require such a document (one of them only requires a simple copy of the earlier application).
 - (c) 43 Offices (96%) issue certified copies of trademark and/or industrial design priority documents at the request of applicants wishing to file subsequent applications in other Offices and claim the priority of applications earlier filed with them; two offices (4%) do not issue certified copies of priority documents (one of them, however, issues filing certificates upon request).
 - (d) 39 Offices (89%) issue and transmit certified copies of priority documents (or filing certificates) only on paper form; five Offices (11%) issue and transmit certified copies of priority documents both on paper form and electronically.
 - (e) The numbers of trademark priority documents issued or requested by Offices per year vary between a two-digit figure and over 6,000.
 - (f) The numbers of industrial design priority documents issued or requested by Offices per year vary between a one-digit figure and over 15,000.
 - (g) No Office has so far concluded any agreement with another Office for the direct transmission of trademark or industrial design priority documents between their Offices.

- (h) 37 Offices (82%) have indicated that they are willing to use the services provided by WIPO under DAS for the exchange of trademark and/or industrial design priority documents with applicants and other national and regional Offices; eight of those offices have indicated that they may need to make some adjustments to their legal framework before they could join; another eight Offices (18%) have indicated that they are not planning to join the service for the time being but may consider doing so in the future.

[Annex II follows]

ESTABLISHMENT OF A DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS

DECISION TAKEN BY THE ASSEMBLIES OF THE PARIS UNION, PLT AND PCT UNION
ON OCTOBER 3, 2006

(DOCUMENT A/42/14, PARAGRAPH 220)

[...]

220. The Assembly of the Paris Union for the Protection of Industrial Property, the Patent Law Treaty Assembly and the International Patent Cooperation Union Assembly (PCT Union Assembly):

(a) approved the convening in early 2007 of an *ad hoc* Working Group to consider matters associated with the establishment of a digital access service for priority documents to be administered by the International Bureau;

(b) directed the International Bureau to establish framework provisions and appropriate procedures, according to the recommendations from the Working Group, for administering the digital service;

(c) directed the International Bureau to implement the digital access service in accordance with the established framework provisions and procedures;

(d) requested the International Bureau to report to them in September 2007 on the results of the *ad hoc* Working Group and on any implementation of the service that may have commenced.

[...]

[Annex III follows]

AGREED UNDERSTANDING CONCERNING THE CERTIFICATION OF PRIORITY DOCUMENTS

ADOPTED BY THE ASSEMBLIES OF THE PARIS UNION AND THE PCT UNION ON OCTOBER 5, 2004

(DOCUMENT A/40/7, PARAGRAPH 173, REFERRING TO DOCUMENT A/40/6, PARAGRAPH 9)

[...]

“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 III and of document]