

Working Group on the Digital Access Service for Priority Documents

Third Session

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MODIFIED FRAMEWORK PROVISIONS FOR THE DIGITAL ACCESS SERVICE FOR PRIORITY DOCUMENTS (DAS) AND EXPLANATORY NOTES

Document prepared by the Secretariat

I. INTRODUCTION

1. The Framework Provisions for the Digital Access Service for Priority Documents (DAS) and explanatory notes, as currently in force, were established by the International Bureau of the World Intellectual Property Organization (WIPO) on March 31, 2009, in accordance with a decision of the Paris Union Assembly, the PLT Assembly and the PCT Union Assembly and the recommendations of the Working Group on the Digital Access Service for Priority Documents (“the Working Group”) set up by those Assemblies.
2. As recalled in document WIPO/DAS/PD/WG/3/2, DAS currently applies only to patent priority documents. Following a recommendation by the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) and informal suggestions from Offices using, or considering using the existing service, the International Bureau has examined the possibility of extending the service to priority documents relating to trademarks, industrial designs and utility models and has concluded that such extension would be feasible and beneficial both for Industrial Property Offices and applicants of industrial property rights.

3. In line with that conclusion, the present document contains a proposal to modify the DAS Framework Provisions and explanatory notes so as to enable DAS to handle not only patent priority documents but also priority documents relating to trademarks, industrial designs and utility models. A draft modified text of the Framework Provisions and explanatory notes is presented in Annex I for consideration by the Working Group. To facilitate the comparison with the current text, a copy marked in track changes is enclosed as Annex II.

II. PROPOSED MODIFICATIONS TO THE FRAMEWORK PROVISIONS

4. Most of the proposed modifications to the framework provisions are self-explanatory and do not require written comments. Nevertheless, a few comments on the main modifications proposed are given, below.
5. Throughout the text of the framework provisions (e.g., in paragraphs 3, 4, 7, 9, 10, etc.), the expressions “patent application” and “Patent Office” have been replaced by the words “application” and “Office”, respectively. Those words are defined in paragraph 25 (formerly 26). Thus, the scope of the provisions is extended to priority documents concerning also other categories of industrial property rights (in particular trademarks, industrial designs and utility models).
6. Modified paragraph 5 provides that the modified framework provisions will come into effect from the date of publication by the International Bureau on the WIPO website (DAS portal). This would be as soon as the system architecture within the International Bureau is technically ready to handle DAS procedures for trademark, industrial design and utility model priority documents. This would presumably take place by the first quarter of 2012. Meanwhile, the service would continue to operate under the framework provisions as established in March 2009.
7. In preparation for the extension of the system to different application types, modified paragraph 10 makes clear that a depositing Office is free to define the applications which it will deposit in the digital library in any way which it likes. Consequently, an Office may deposit patent applications and utility model applications but not trademark or industrial design applications. Alternatively, it may deposit patent applications filed in electronic format but not in paper format, or only applications filed after a certain date.
8. Similarly, modified paragraph 12 makes clear that an Office may act as an accessing Office for a limited range of types of later application, for example, patent applications but not utility models, trademarks or industrial designs. However, it should not restrict the types of priority documents which it will accept from the system if they are permitted to be used for claiming priority in relation to those later applications for which the Office acts as accessing Office. For example, an Office which acts as an accessing Office for later patent applications must accept priority documents based on earlier utility models as well as earlier patent applications.

9. Current paragraphs 16 to 18 are deleted and replaced by new paragraphs 16 and 17 that make two changes to the approach to access controls:
 - (a) The concept of being made "publicly available" via the service is removed. This term was misleading since the service only offers access to priority documents for Offices and not for the general public, so it only meant that the document was available to all Offices without the need for the applicant to specify individual Offices. Furthermore, it was intended to provide a mechanism whereby depositing Offices could indicate, either directly or by reference to a definitive list of publications, that an application had been published and that the priority document should be available to any Office without further permission from the applicant. In practice, no Office has expressed any desire to implement this option.
 - (b) While the current arrangements for patent priority documents would be extended to priority documents based on utility models and industrial design applications, the proposal assumes that priority documents based on trademark applications should be open to all accessing Offices.
 10. Paragraph 20 (formerly paragraph 21), as modified, provides that the members of the Consultative Group will be the Offices participating in DAS either as a "depositing Office" or "accessing Office" or in both capacities. Other interested Offices, as well as interested organizations invited to meetings of the Working Group, will be entitled to participate in the Consultative Group in an observer capacity provided that they notify the International Bureau that they wish to participate therein.
 11. Paragraph 22 (formerly paragraph 23), as modified, makes explicit provision for the establishment of service level agreements which would cover the core system operated by the International Bureau and the digital libraries operated by or on behalf of the depositing Offices. Such agreements would appear highly desirable to ensure reliable access to priority documents and should cover matters including both the availability of systems and the period for which priority documents must remain available within a digital library.
 12. In paragraph 25 (formerly 26), the old definitions given for the expressions "patent application" and "Patent Office" have been replaced by definitions of the words "application" and "Office". A new definition is added for the expression "digital library". The numbering of the definitions has been rearranged so that they continue to appear in alphabetical order.
- III. PROPOSED MODIFICATIONS TO THE EXPLANATORY NOTES
13. References in paragraphs 1 to 3 of the explanatory notes will be updated once the outcome of the third session of the Working Group is known.
 14. Paragraph 5 has been modified to include references to the Trademark Law Treaty (TLT) and the Singapore Treaty on the Law of Trademarks (Singapore Treaty).

15. As indicated in modified paragraph 7, the International Bureau envisages that the initial designation of participating digital libraries on the date of coming into effect of the modified framework provisions will be of those Offices that are already in practice exchanging priority documents in electronic form via DAS on that date.
16. As indicated in modified paragraph 9, an Office may notify the International Bureau that it will act as a depositing Office only with respect to priority documents relating to patents or trademarks or industrial designs or utility models or any combination thereof.
17. Similarly, as indicated in new paragraph 11, an Office may notify the International Bureau that it will act as an accessing Office only with respect to certain types of priority documents. However, certain combinations thereof would be mandatory for the office concerned (e.g., an office willing to accept patent priority documents should also be willing to accept utility model priority documents), taking into account that the Paris Convention explicitly allows patent applications and industrial design applications to claim priority from utility model applications and vice-versa.
18. As a consequence of the proposed deletion of paragraphs 16 to 18 of the framework provisions as currently in force, paragraphs 15 to 17 of the current explanatory notes would also be deleted.
19. Reflecting the current practice of DAS, modified paragraph 20 states that the working languages of the service in its practical operations are Chinese, English, French, Japanese, Korean and Spanish, and that the International Bureau will seek to add any other language of publication of the PCT when an Office for whose users such languages would be of benefit indicates a definite intention to join the system.
20. New paragraph 21 clarifies that the word “application” includes international applications filed under the PCT and under the Hague Agreement.
21. Finally, modified paragraph 22 recalls the fact that the Agreed Understanding adopted by the Paris Union Assembly and the PCT Union Assembly in 2004 applies to priority documents relating to patents, trademarks, industrial designs and utility models.

IV. OTHER MATTERS FOR CONSIDERATION

22. The proposed modifications to the Framework Provisions do not take into account the proposals for a “Route D” in document WIPO/DAS/PD/WG/3/6. The provisions in paragraphs 14 and 15 of the Framework Provisions on “opportunity to comply” would, if those proposals are accepted, require careful revision to ensure that suitable safeguards were required for applicants both in the event of system failure and where an error is made in the access code, since the system might no longer hold any information on the applicant having taken an action to ensure that a particular priority document was available to an Office on which to base a certificate.

V. ENTRY INTO FORCE OF REVISED FRAMEWORK PROVISIONS

23. The proposals for modification to the Framework Provisions are, in most respects, compatible with the continued operation of the existing system and could be brought into effect as soon with no adverse consequences for users or participating Offices as the International Bureau has extended the core systems to recognize priority documents based on different types of application.
24. According to the analysis by the International Bureau, the only matter which would require transitional arrangements would be paragraph 12, where current accessing Offices would need to update their systems to distinguish a request for a utility model priority document from a patent priority document, unless it could be guaranteed that all such priority documents could be distinguished by their application numbers alone.

25. *The Working Group is invited to:*

- (i) *consider the modified Framework Provisions for the Digital Access Service for Priority documents (DAS) and explanatory notes proposed in Annex I, and*
- (ii) *recommend that those modified Framework Provisions and explanatory notes be established by the International Bureau as soon as possible.*

[Annex I follows]