

WIPO



SCIT/SDWG/11/8

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

STANDING COMMITTEE ON INFORMATION TECHNOLOGIES STANDARDS AND DOCUMENTATION WORKING GROUP

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INFORMATION ON THE ENTRY INTO THE NATIONAL (REGIONAL) PHASE OF
PUBLISHED PCT INTERNATIONAL APPLICATIONS (TASK No. 23)

Document prepared by the Secretariat

1. The Standards and Documentation Working Group (SDWG) of the Standing Committee on Information Technologies (SCIT), at its eighth session in March 2007, considered the status reports concerning Task No. 23 prepared by the European Patent Office (EPO) and the International Bureau (IB). The SDWG also agreed to reword Task No. 23 to read as follows:

“Task No. 23 ‘Monitor the inclusion, in databases, of information about the entry, and, where applicable, the non-entry into the national (regional) phase of published PCT international applications’.”

(See paragraphs 45 to 48 of document SCIT/SDWG/8/14.)

2. The Secretariat was requested to report on the progress of the Task No. 23 at SDWG meetings every second year. (See paragraph 57 of document SCIT/SDWG/2/14.)

3. As a follow-up to the above, the Secretariat invited both the IB and the EPO to prepare their corresponding status reports on the progress made with regard to Task No. 23 since the eighth session of the SDWG. Annex I to this document, including the Appendix thereto, contains the said status report by the EPO, and Annex II the report by the IB.

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4. The SDWG is invited to note the contents of the status reports by the EPO and the IB on Task No. 23 reproduced as Annexes I and II, respectively, to this document.

[Annexes follow]

ANNEX I

STATUS REPORT ON SDWG TASK No. 23
*by the European Patent Office*Terms of reference

1. This is an update to the status report provided in March 2007. The current report refers to the situation at the end of July 2009 and follows the lines expressed by the working title allocated to Task No. 23 at the eighth session of the SDWG in Geneva, March 19 to 22, 2007: “Monitor the inclusion, in databases, of information about entry, and, where applicable, the non-entry into the national (regional) phase of published PCT international applications”

Progress made

2. The most significant progress resulted from the co-operation with WIPO in this task. Currently, out of 54 patent authorities contributing to the EPO's Legal Status Database, 35 are delivering information about the entry into the national (regional) phase. Taking into account, that several member states of the European and the Eurasian Patent Offices allow only regional designations, the number of countries covered is at least 45.

Present Status

3. For the legal status database of the EPO direct input from national offices as well as the updates sent by WIPO are used. At the moment the country distribution according to the source of data is:

- | | |
|--|----|
| - provided via WIPO and by the national office | 15 |
| - provided via WIPO only | 15 |
| - provided by national office only | 5 |

Details can be gathered from the attached database contents table (see Appendix to Annex I).

4. The exchange of PCT entry data between WIPO and the EPO is done at a monthly schedule. In order to avoid duplications in the legal status database two measures have been taken:

- the events reported via WIPO are stored with legal status codes different from those used for event received by national offices directly
- de-duplication of events reported from both sources takes place at a monthly schedule; the codes for the input via WIPO take precedence.

Due to reorganisation measures in the data exchange procedures of WIPO there was an interruption of data supply since October 2008. In the meantime the data supply has been resumed. The new data supply is restricted to PCT entry information. It does not cover follow-up events as national republication of the patent application or national grant because some offices restrict the right for redistribution. Currently WIPO investigates whether these events could be re-included or not. Please note that the attached database contents table (see Appendix to Annex I) does not yet reflect the latest deliveries by WIPO.

5. Concerning the non-entry information some progress has been achieved. Currently six Patent Offices invest in the efforts of supplying this kind of information: Canada, Germany, the EPO, Japan, the Republic of Korea (we have recently experienced some delays) and Russia (very up-to-date, but number formats need some post-processing).

Future Planning

6. The country coverage for the PCT entry information has to be further extended. Regions of particular interest are Latin America and the Middle East. Concerning the completeness of information further efforts have to be made to get hold of such important events as refusals or withdrawals of national entries. This information is not yet supplied by some of the PCT member states.

7. Concerning the non-entry information further efforts are necessary to convince more countries to provide. In particular for countries with a high activity in PCT entries in comparison to the number of designations this information is crucial for the patent information community.

[Appendix follows]

APPENDIX

DATABASE CONTENTS OF PCT ENTRY AND NON-ENTRY
INTO THE NATIONAL (REGIONAL) PHASE

Week: 2009/31

Edition: 30.07.2009

CC	Country	from	until	<CC>	EP	WO		Gaps	Additional comments	Last input week
AT	Austria	01.02.1995	30.10.2008			WO	PCT appl. entry into the national phase			2008/45
		01.02.1995	09.03.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/34
AU	Australia	28.11.2002	30.07.2004	AU		WO	PCT appl. entry into the national phase			2009/32
		01.01.2002	31.07.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/42
BG	Bulgaria	02.01.2001	17.06.2009			WO	PCT appl. entry into the national phase			2009/29
		02.01.2001	09.07.2007			WO	PCT application entry and further legal events delivered by WIPO			2008/18
BR	Brazil		02.01.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/18
BY	Belarus	15.06.2007	28.02.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/34
BZ	Belize	27.08.2002	23.03.2007			WO	PCT application entry and further legal events delivered by WIPO			2007/37
CA	Canada	01.04.1993	09.07.2004			WO	PCT appl. entry into the national phase			2006/12
		01.08.1999	24.02.2002			WO	PCT appl. non-entry into the national phase			2002/22
		01.04.1993	11.04.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/42
CH	Switzerland		02.01.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/18
CN	People's Republic of China	01.01.2002	31.12.2007			WO	PCT application entry and further legal events delivered by WIPO		only for appl.number < US2003025738 W	2008/42
CZ	Czech Republic	21.02.1995	02.08.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/42

CC	Country	from	until	<CC>	EP	WO		Gaps	Additional comments	Last input week
DE	Germany	17.05.2006	30.07.2009			WO	PCT appl. non-entering direct German phase			2009/31
		01.01.1993	28.02.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/42
EA	Eurasian Patent Office	18.04.2007	30.11.2007			WO	PCT application entry and further legal events delivered by WIPO			2008/34
EP	European Patent Office	20.12.1978	29.07.2009			WO	PCT appl. entry into the regional phase			2009/27
		20.12.1978	29.07.2009			WO	PCT appl. non-entering regional phase		Post grant information is sent from national offices	2009/27
ES	Spain	30.05.1990	23.06.2009			WO	PCT appl. Entry into the national phase			2009/31
			31.01.2007			WO	PCT application entry and further legal events delivered by WIPO			2008/34
FI	Finland		27.08.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/42
GB	United Kingdom	01.04.1998	22.07.2009			WO	PCT appl. Entry into the national phase		update week 26/2009 will be loaded in week 29/2009	2009/31
GE	Georgia	31.08.1998	30.06.2009			WO	PCT appl. entry into the national phase			2009/28
IL	Israel		31.07.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/42
JP	Japan	01.09.1996	30.06.2009			WO	PCT appl. entry into the national phase	1.11.1999 until 31.5.2001; Oct.,Nov. 03		2009/28
		01.09.1998	30.06.2009			WO	PCT appl. non-entry into the national phase	1.11.1999 until 31.5.2001; Oct.,Nov. 03		2009/28
		01.01.2002	07.05.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/42
KE	Kenya	11.12.1995	02.07.2009			WO	PCT appl. entry into the national phase			2009/31
		07.01.2004	05.05.2006			WO	PCT application entry and further legal events delivered by WIPO			2007/44

CC	Country	from	until	<CC>	EP	WO		Gaps	Additional comments	Last input week
KR	Republic of Korea	01.01.2000	31.12.2000			WO	PCT appl. entry into the national phase			2001/39
		01.01.2000	31.12.2000			WO	PCT appl. non-entry into the national phase			2001/39
		03.01.1997	13.04.2007			WO	PCT application entry and further legal events delivered by WIPO			2007/44
LT	Lithuania	01.07.1997	30.06.2009			WO	PCT appl. entry into the national phase			2009/27
		12.04.1995	26.11.2007			WO	PCT application entry and further legal events delivered by WIPO			2008/43
LV	Latvia	01.01.1998	01.06.2008			WO	PCT appl. entry into the national phase			2008/31
		22.11.2005	10.06.2006			WO	PCT application entry and further legal events delivered by WIPO			2007/44
MX	Mexiko	21.12.2005	11.07.2006			WO	PCT application entry and further legal events delivered by WIPO			2007/44
NZ	New Zealand	01.05.2001	31.03.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/43
PH	Philippines	14.03.2002	02.05.2007			WO	PCT application entry and further legal events delivered by WIPO			2007/44
PL	Poland	22.12.2002	30.01.2008			WO	PCT application entry and further legal events delivered by WIPO			2000/43
RO	Romania	01.01.2002	31.05.2009			WO	PCT appl. entry into the national phase			2009/29
		17.12.2004	30.01.2007			WO	PCT application entry and further legal events delivered by WIPO			2007/44
RU	Russia	03.01.2002	22.05.2009			WO	PCT appl. entry into the national phase	Dec.03, Jan.04,		2009/30
		03.01.2002	30.06.2009			WO	PCT appl. non-entry into the national phase			2009/28
		24.03.2004	31.03.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/43
SE	Sweden	18.08.1985	26.02.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/43
SI	Slovenia	01.01.2001	28.02.2007			WO	PCT appl. entry into the national phase			2007/11
SK	Slovakia	01.01.1993	30.06.2009			WO	PCT appl. entry into the national phase			2009/30
		29.12.2008	01.04.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/43

CC	Country	from	until	<CC>	EP	WO		Gaps	Additional comments	Last input week
US	United States	23.03.1993	30.09.2008			WO	PCT appl. entry into the national phase		gaps for 1998-2001 !!!!; 1.7.2005 to 31.12.2005	2008/41
		04.08.1992	29.05.2008			WO	PCT application entry and further legal events delivered by WIPO			2008/43
UZ	Uzbekistan	02-01-2001	30.06.2006			WO	PCT appl. entry into the national phase			2006/37
WO	WIPO (P.C.T.)	21.09.1978	23.07.2009			WO	PCT Applications, electronic input	25.10.2007	Info. about PCT appl. entry into / non-entry into the national phase are under the national offices; since 7.7.2006 new PRS codes used	2009/31
ZA	South-Africa		20.02.2007			WO	PCT application entry and further legal events delivered by WIPO			2007/47

[Annex II follows]

ANNEX II

STATUS REPORT ON SDWG TASK No. 23
by the International Bureau

Background

1. Starting in 2004, the International Bureau (IB) invited the national patent offices to supply the data regarding the entry into the national phase of PCT international applications, in order to improve the coverage and timeliness of the data. The IB proposed various data formats, in order to offer maximum flexibility to those national offices. Several national offices responded positively and provided requested data.
2. Rule 86 of the Regulations under the PCT envisages that designated/elected Offices should provide information on PCT national phase entries to the IB for the purposes of publication and further dissemination of information. In addition, Rule 95 provides for the furnishing, to the IB, of translations of the International Application for the purposes of national phase entry. While not all of the 112 designated offices of the PCT (as at June 2009) have the capacity to furnish such information, the PCT Regulations provide a sound basis for the collection of information in the PCT national phase.

Current Status

3. In 2006, the IB started to disseminate PCT national phase information via the PATENTSCOPE[®] service. Since that time, more offices have joined the program and there is now information available from 36 offices, amounting to more than 3.5 million PCT national phase notifications in total. Discussions are underway that should result in several more offices joining the program in 2009.
4. The PCT national phase information held by the IB is available for sharing with other offices or private-sector patent information companies, in most cases. At present, the IB shares PCT national phase information with the EPO, and requests have been received from some other offices for sharing the information. However, the data exchange agreements with some offices specify, on the request of the office, that information sent to the IB may not be redistributed.
5. In terms of legal status information, the table below shows that a number of offices are able to provide information on one or more status changes after the national phase entry. The IB recently changed the specifications for the national phase data exchange to include a new status code for patents that have expired or are no longer maintained but, as yet, no offices are supplying this information. Further work is required to standardize legal status codes for PCT national phase entries (and, by extension, to patents granted on the basis of non-PCT applications) and to assist offices in making that information available.

PCT National Phase Data Coverage

Office	Start	Latest Update	National Phase Entries	Status Updates			
				Publication	Grant	Refusal	Withdrawal/ Non-Entry
Australia	1997-12	2009-07	179 254	X	X	X	X
Austria	1980-11	2008-10	3 098				
Belize	2002-08	2007-02	108	X	X	X	
Bulgaria	2004-01	2006-01	830	X	X	X	X
Canada	1994-02	2009-03	266 986				
China	1998-01	2008-11	307 577				
Czech Republic	1990-11	2009-07	28 529	X	X	X	X
Egypt	2008-01	2009-04	1 888				
European Patent Office (EPO)	1980-05	2009-07	878 817	X	X	X	X
Finland	1980-01	2009-05	22 049		X		
Georgia	2002-10	2009-06	1 102				
Germany	1980-11	2009-07	35 313				
Hungary	2008-01	2009-04	33	X	X		
Israel	1996-12	2009-05	46 486	X	X		X
Japan	1991-04	2009-07	402 440				
Kenya	1998-01	2006-05	238				
Latvia	1998-01	2006-06	336				
Lithuania	1995-04	2009-01	678	X	X	X	X
Mexico	2004-01	2006-10	114 340				
New Zealand	1985-12	2008-03	52 016	X	X		
Philippines	2002-01	2008-12	14 025	X	X	X	X
Poland	2007-05	2008-06	4 546				
Republic of Korea	1997-01	2007-04	179 707	X	X	X	X
Romania	1990-01	2008-01	3 998				
Russian Federation	2001-07	2008-12	43 109				
Singapore	1995-02	2009-06	28 119				
Slovakia	1993-01	2007-03	13 490				
Slovenia	2001-01	2005-04	218				
South Africa	1999-12	2008-02	59 162				
Spain	1990-05	2009-06	1 527				
Sweden	1982-12	2008-02	1 811	X			
Turkey	1996-03	2005-07	12 231				
United Kingdom	2000-01	2009-06	23 322	X	X	X	X
United States of America	1991-02	2009-04	486 041	X			
Uzbekistan	2001-01	2006-06	966				
Viet Nam	1995-04	2009-06	11 852				

Further Work on Legal Status

6. As shown above, the coverage of legal status information for PCT applications in the national phase has improved in recent years. Similar improvements could be made to the coverage of legal status information for other, non-PCT applications, by applying a similar methodology.

7. While much progress has been made on improving access to legal status information, there remain many offices for which coverage is limited. In some cases, this may be due to lack of capacity of the offices. In other cases, it may be due to concerns over the re-use and dissemination of the information and this is reflected in the conditions under which some offices already exchange data with each other and with the IB.
8. Through its Office Modernization program, WIPO is providing technical assistance to more than 40 IP offices in developing countries. This potentially creates a rich source of legal status information that would benefit Offices and third parties worldwide.
9. In particular, the following activities could be considered:
 - Encouraging or assisting offices to create legal status registers for their patent collections, and making them available online.
 - Collection and dissemination of the information through a standardized infrastructure. Harmonizing legal status codes so that information can be compared across different jurisdictions.
 - Multi-lateral agreement on the terms and conditions under which data is exchanged between offices and with the private-sector, including agreement on pricing policies and sharing of any potential revenues.
10. Further work in this area will be the subject of specific proposals to be submitted by the IB.

[End of Annex II and of document]