
WIPO

DRAFT

WIPO PRIORITY DOCUMENT ACCESS SERVICE (DAS)

**LEGAL AND ADMINISTRATIVE CONSIDERATIONS
PRIOR TO OFFERING SERVICES**

Draft: Version 0.2



**WORLD INTELLECTUAL PROPERTY
ORGANIZATION**

GENEVA

Document Information

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Revision History

| Version | Date | Remarks | Distributed to & Reviewed by |
|-----------|--------------|---------------------------|---|
| Draft 0.1 | 3 June 2009 | Initial draft for review | PT, KK, DC, AB |
| Draft 0.2 | 24 July 2009 | Incorporating KK comments | Informally sent to a number of Offices, noting that not complete and not fully reviewed |

Document Reviewers

| Name | Title |
|------|-------|
| | |

Document Approvals

| Name | Title |
|------|-------|
| | |

Document References

| Reference | Document Name | Release |
|-----------|--|---------|
| | <i>DAS Framework Provisions</i> <i>http://www.wipo.int/export/sites/www/patentscope/en/pdocforum/pdf/fp.pdf</i> <i>[note that the version in Annex III of WIPO/DAS/PD/WG/2/4 was not final]</i> | 1.0 |
| | <i>System Architecture for the Digital Access Service for Priority Documents</i> <i>Annex I of document WIPO/DAS/PD/WG/2/4</i> | 1.0 |
| | <i>General Principles for the Implementation of the Digital Access Service for Priority Documents</i> | 1.0 |

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| | <i>Trilateral Document Access Interface Specifications Documentation, 31 March 2008</i> | 1.7.1 |
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1 INTRODUCTION

1.1 THE PRIORITY DOCUMENT ACCESS SERVICE

Digital Access Service

1. *These provisions are established by the International Bureau 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").*
2. *The digital access service for priority documents ("the service") operates in accordance with these provisions and having regard to the general principles and system architecture recommended by the Working Group.*
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.*
4. *The implementation of these provisions by Patent Offices is a matter for the applicable law.*
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.*

1.1.1 The WIPO PATENTSCOPE[®] Priority Document Access Service is a service designed 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. The main requirements of the service are set out in the Framework Provisions as established on 31 March 2009, extracts of which are included in this document in boxes, presented as above.

1.1.2 Use of the service is optional both for Offices and for applicants.

1.1.3 The normal functioning of the system is broadly as follows:

(a) the applicant requests an Office (normally, but not necessarily, the Office of first filing) to make his first application available to the system for later use as a priority document;

(b) the applicant is issued with an access code which is secret and unique to the particular application, which allows him to specify, through a website maintained by the International Bureau, which other Offices should have access to that application through the Priority Document Access Service;

(c) where the applicant asks a participating Offices of second filing to retrieve a copy of the document, that Office will recognize their national priority document requirements as having been met as long as the applicant gave them permission to access the document by the time when it would normally have been required to provide a paper certified copy under the relevant national laws.

1.2 SCOPE OF THIS DOCUMENT

1.2.1 This document is intended to be a simple guideline on legal and administrative matters for Offices wishing to offer services to their customers through the Priority Document Access Service.

1.2.2 The information is intended to be accurate, but it is not legally definitive and may not cover all of the possible issues which every Office should consider. In particular, it covers the technical requirements only to the extent necessary to indicate the legal and administrative processes and requirements which need to consider the technical issues.

1.2.3 For further details of the technical requirements, Offices should consider:

(a) the *System Architecture for the Digital Access Service for Priority Documents* (Annex I of document WIPO/DAS/PD/WG/2/4);

(b) the *Trilateral Document Access Interface Specifications Documentation v.1.7.1*, 31 March 2008;

(c) [*DAS-EDI specifications, to be completed – in the meantime find appropriate reference for the telegrams*]

and consult the International Bureau, as necessary.

2 TERMINOLOGY

2.1 THE SERVICE

2.1.1 The Framework Provisions legally establish the “Digital Access Service for Priority Documents”, but the operating name of the service, used on the WIPO website and forms is the “WIPO PATENTSCOPE[®] Priority Document Access Service” or “Priority Document Access Service”.

2.2 DEFINITIONS FROM THE FRAMEWORK PROVISIONS

6. Words and expressions used in these provisions are to be understood with reference to paragraph 26.

Meanings of Words and Expressions

26. 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;

(iv) “Consultative Group” means the Consultative Group referred to in paragraph 21;

(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 of a kind referred to in Article 3 of the PLT;

(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;

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

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

(xii) “PLT” means the Patent Law Treaty;

(xiii) “priority document” means a certified copy of a patent application;

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

2.2.1 Paragraph 26 of the Framework Provisions specifically defines a number of terms for use within those provisions. Apart from the name of the service and the terms mentioned below, this document and the service use the terminology of the Framework Provisions, where possible.

2.2.2 In addition the term “participating digital library” is defined in paragraph 7 of the Framework Provisions: see section 4.4 of this document for further information.

2.2.3 The terms “depositing Office” (defined primarily by paragraph 10 of the Framework Provisions) and “accessing Office” (defined primarily by paragraph 12 of the Framework Provisions) are not used in the web portal or the general applicant literature relating to the system. Instead, the terms “Office of first filing” and “Office of second filing”, respectively, are used since these have passed into common use. This document generally uses the terms Offices of first and second filing, but refers to depositing and accessing Offices in addition where it is necessary to specifically refer to matters within the Framework Provisions, or to explain certain situations where the term “Office of first filing” might be misleading (see especially paragraph 3.2.3, below).

2.3 OTHER RELEVANT ABBREVIATIONS

2.3.1 The following further abbreviations are used:

(i) “EDI”: PCT Electronic Data Interchange¹ – a system used primarily for transfer of documents between Offices of PCT Contracting States and the International Bureau, based on the Secure File Transfer Protocol (SFTP).

(ii) “TDA”: Trilateral Document Access – a system for transfer of documents between Offices based on a Simple Object Access Protocol (SOAP) service specified by the Trilateral Offices (European Patent Office, Japan Patent Office, United States Patent and Trademark Office).

¹ <http://www.wipo.int/patentscope/en/pct-edi/>

3 ROLES OF OFFICES

3.1 INTRODUCTION

3.1.1 Offices play two separate roles in the system: those of Office of first filing (where a “first” application in the sense of Article 4C of the Paris Convention is filed, which may need to be used as a priority document) and Office of second filing (where an application claiming priority is filed and a copy of the priority document may be needed in relation to that priority claim). It is permitted for an Office to perform one of those functions without the other provided that their notifications make this clear.

3.2 OFFICE OF FIRST FILING (DEPOSITING OFFICE)

3.2.1 The Office of first filing (paragraph 10 of the Framework provisions) makes a patent application available to other Offices by making it available through its *participating digital library*.

3.2.2 The Office is permitted to define the extent of its participating digital library. Consequently, the documents which it makes available through its participating digital library may only be a subset of the patent applications which the Office holds in its digital library as a whole. For example, the Office may begin with a small scope of available documents and extend this as time goes on, in accordance with the procedures described below.

3.2.3 The term “depositing Office” was used in the Framework Provisions because “Office of first filing” may, on occasion, be misleading since the function may be provided in some cases through the digital library of another Office which holds a copy of the patent application which has been certified by the actual Office of first filing. In fact, the patent application may be made available by any (or, in principle, all) of the following:

- (a) the actual Office where the application was originally filed;
- (b) in the case of regional or international applications filed through a national Office, the regional Office or the International Bureau;
- (c) another Office which holds a certified copy of the application in its digital library, most commonly because a paper copy has already been deposited for use as a priority document in respect of a later application;
- (d) the International Bureau (or, in principle, any other Office offering an equivalent service) where an applicant or Office sends a certified copy of the patent application to the Bureau for inclusion in the system (paragraph 11 of the Framework Provisions).

Nevertheless, “Office of first filing” is normally used in the system and general literature because it is the term in general use and describes the common arrangement well (see also paragraph 2.2.3).

3.3 OFFICE OF SECOND FILING (ACCESSING OFFICE)

3.3.1 An Office of second filing which has signed up to the system (paragraph 12 of the Framework Provisions) must, subject to specifically defined exceptions, recognize any priority document that is available to it via the service as though it had been furnished to it by the applicant.

3.3.2 The Framework Provisions use the term “accessing Office” for this function, but this document and the system generally use the common term “Office of second filing”. This should not cause any confusion as long as it is recognized that the term is only being used for Offices which have notified that they will act in this role and which are processing patent applications which claim priority from an application which is available from the service.

3.3.3 Unlike the role of Office first filing which may define the extent of its service (see paragraph 3.2.2, above), an Office of second filing must take the system “all or nothing”:

(a) it must accept any priority document which is available to it through the system as if it had been furnished by the applicant in the normal way, subject to the specific exceptions set out in the framework provisions; and

(b) in the case of those exceptions, it must provide suitable safeguards to the applicant to ensure that priority rights are not lost due to system failures, as defined in the Framework Provisions.

3.3.4 An Office should therefore not make a notification to the International Bureau under paragraph 12 of the Framework Provisions until it has made the checks indicated in section 5.

4 PROCESSES FOR BECOMING AN OFFICE OF FIRST FILING (DEPOSITING OFFICE)

4.1 INTRODUCTION

4.1.1 There is a two stage formal administrative process before an Office can make priority documents from its digital library available through the system:

(a) the digital library must be designated by the International Bureau as a *participating digital library*;

(b) the Office must make a notification to the International Bureau under paragraph 10 of the Framework Provisions.

4.1.2 However, it is best to begin by contacting the International Bureau informally.

4.2 LEGAL AND PRACTICAL CONSIDERATIONS

4.2.1 The system is designed so that, in most countries, no special legal provision will be needed in order to allow the Office to act as an Office of first filing, since unpublished priority documents are only made available at the specific request of the applicant. Nevertheless, the Office should give consideration to the confidentiality aspect and ensure that the technical “route” chosen from the *System Architecture for the Digital Access Service for Priority Documents* and associated Office procedures meet the requirements of confidentiality under its national law.

4.2.2 The Office should also consider how the system can be most effectively implemented for its applicants, for example considering whether access codes might be issued automatically without any special action on the part of the applicant in some or all cases, or else whether a simple checkbox might be included in the application form to minimize the burden for applicants and Offices in requesting and providing access codes.

4.3 INITIAL INFORMAL DISCUSSIONS

4.3.1 Before a formal request is made for designation of a digital library, it is best to contact the International Bureau informally to discuss what the best approach would be and what timetable for implementation might be realistic. This will depend, amongst other things, on:

(a) whether there are existing TDA or EDI connections between the International Bureau and the Office;

(b) the nature of the digital library at the Office

(c) the format and availability of priority documents in the digital library at the Office

(d) using paper in certain cases for offices without the capacity to participate using electronic copies of priority documents

(e) resources available in the Office and in the International Bureau to make any necessary changes; and

(f) any issues particular to national law.

4.3.2 In most cases, the informal procedure should continue to the stage of at least some basic connectivity tests and passing of sample information before the formal procedures described in the following sections begin.

4.3.3 The current contacts for such discussions are:

Legal issues: Michael RICHARDSON, Head, Institutional Relations Section,
PCT International Cooperation Division
tel: +41 22 338 9171; fax: +41 22 338 7150
e-mail: michael.richardson@wipo.int

Technical issues: Daniel CHENG, Head, Venture Applications Development Unit,
PCT Information Systems Division,
tel: +41 22 338 8611; fax: +41 22 338 8100
e-mail: daniel.cheng@wipo.int

General support: PCT-SAFE helpdesk,
details to be added

4.4 DESIGNATION OF A PARTICIPATING DIGITAL LIBRARY

Participating Digital Libraries

7. *A digital library participates for the purposes of these provisions ("participating digital library"):*

(i) if it is so designated by the International Bureau when these provisions come into effect;

(ii) if, upon request by a Patent Office, it is so designated by the International Bureau at a later time after consultation with the Consultative Group.

8. *The criteria referred to in paragraph 23 apply to all participating digital libraries.*

9. *The giving by a Patent Office of a notification under paragraph 12 does not give rise to any obligation on the part of that Office to accept a participating digital library for the purposes of Rule 4(3) of the Regulations under the PLT.*

4.4.1 The purpose of designation of a digital library of an Office of first filing is to ensure that the International Bureau and Offices which are already using the service to share priority documents are confident that they will technically be able to receive and process documents which applicants wish them to retrieve from that digital library.

4.4.2 Certain digital libraries which were already exchanging priority documents (those of the State Intellectual Property Office of the People's Republic of China, the Japan Patent Office, the Korean Intellectual Property Office, the United States Patent Office, the European Patent Office, and the International Bureau) were designated under paragraph 7(i) of the Framework Provisions when they came into force. Other digital libraries must request the International Bureau to designate the digital library.

4.4.3 A request for designation of a digital library should include as much information as possible which will assist other Offices in assessing whether they will be able to retrieve and process patent applications from that digital library through the service. Such information should include at least:

(i) the format in which the patent applications will be sent by the digital library to the Priority Document Access Service;

(ii) the scope of the digital library (for example, whether it contains all applications filed at that Office or a limited selection, such as those filed in electronic form);

(iii) the expected availability of the digital library (hours of service; frequency and length of regular maintenance, etc.);

(iv) the format of application numbers used by that system.

4.4.4 On receipt of such a request, the International Bureau will check that it has all the information which appears to be necessary to proceed. If it does, it will add any further information which is relevant to the process, such as the results of connectivity tests (see paragraph 4.3.1, above) and send the relevant information to the Consultative Group for comment. Assuming that there are no negative comments, the International Bureau will then designate the digital library and publish that fact on the website².

4.4.5 The fact that a digital library has been designated as a participating digital library does not mean that it immediately offers services. This only occurs from a date which is later specified in a formal notification in accordance with paragraph 10 of the Framework Provisions, as described below.

² <http://www.wipo.int/patentscope/en/pdocforum/participating.html>

4.5 NOTIFICATION BY THE OFFICE

Depositing Offices and Availability of Priority Documents Via the Service

10. A Patent Office (“depositing Office”) may notify the International Bureau that copies of patent applications deposited by it in a participating digital library 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 23, including any specification of options from among those available.

11. 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 a participating digital library and made available via the service.

4.5.1 Once the relevant digital library has been designated as a participating digital library, the Office can notify the International Bureau that copies of patent applications deposited in that library are to be made available via the service as priority documents in accordance with the Framework Provision. The main items which need to be included in such a notification are:

- (i) a statement that it is a notification under paragraph 10 of the Framework Provisions for the Digital Access Service for Priority Documents and the date from which the notification is effective;
- (ii) the applications to which the notification applies (types and dates of applications which applicants may request to be included);
- (iii) the service (EDI, TDA, etc.) by which the transfer will be made;
- (iv) the file format and contents of the package which will be transferred;
- (v) the “route” which has been selected for confirming the availability of documents according to the *System Architecture for the Digital Access Service for Priority Documents*;
- (vi) if the participating digital library is to be hosted by the International Bureau on behalf of the Office, a statement of that fact;
- (vii) what (if anything) the applicant needs to do to request that an application be deposited in the digital library, or else to request an access code in order to make the application available to other Offices; and
- (viii) where an applicant can find further information on procedures relevant to use of the system through that Office.

4.5.2 Annex I contains a sample letter to the Director General of WIPO, making a notification under both paragraphs 10 and 12 of the Framework Provisions.

5 PROCESSES FOR BECOMING AN OFFICE OF SECOND FILING (ACCESSING OFFICE)

5.1 GENERAL

5.1.1 Though there is no requirement for consultation with the Consultative Group or formal scrutiny procedures prior to making a notification under paragraph 12 of the Framework Provisions equivalent to the designation procedure described in section 4.4, it is essential to ensure that, before any such notification comes into force:

- (a) the technical aspects of the system have been properly implemented and tested;
- (b) the law properly recognizes all documents retrieved from the system; and
- (c) the law provides suitable opportunities to rectify problems which may occur if a priority document cannot be retrieved for any reason, despite the applicant having taken all the appropriate steps by the relevant dates under the national law.

5.1.2 Failure to ensure any of these matters may result in irreparable loss of rights for an applicant. Consequently, it is strongly recommended to discuss both the legal and technical requirements with the International Bureau fully at an early stage, and to discuss draft notifications informally before a final notification is submitted.

5.2 TREATMENT OF PRIORITY DOCUMENTS AVAILABLE VIA THE SERVICE

Accessing Offices

12. A Patent Office ("accessing Office") may notify the International Bureau that, for the purposes of the applicable law and subject to paragraphs 13 to 15, 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 23, including any specification of options from among those available.

5.2.1 Patent applications which are available from the system must be treated as if they were conventional priority documents furnished by the applicant. This should apply to all priority documents available from the service, irrespective of the library which they are retrieved from. Furthermore, it should not be limited to the case where the Office *actually retrieves* the document before any relevant date under the national law (which is beyond the control of the applicant). The significant issue is that the document was available to the Office through the service by the relevant date. Moreover, it should be recognized that availability from the system does not necessarily mean that it is possible for the Office of second filing to retrieve the document instantly.

5.2.2 It should be noted that these requirements do not require Offices to change the substantive requirements of their patent laws in respect of priority – the Office is not expected to recognize a patent application retrieved from the system as being a valid basis for priority if it would not recognize the same document furnished as a paper certified copy (for example, because the document was not the “first application” in the sense of Article 4C of the Paris Convention, because the document does not disclose the relevant subject matter, or because the later application was filed after the priority period expired);

5.2.3 Moreover, the Office is not required to extend the period by which the priority document is, *in principle*, supposed to be available to the Office.

5.2.4 However, it may be necessary to make changes to the national law in respect of more administrative aspects before beginning to operate as an Office of second filing under the system:

(a) to ensure that a document available from the system is recognized as if a normal paper certified copy had been furnished by the applicant;

(b) to ensure that, even if the Office actually attempts to retrieve the document on a date later than the applicant would normally have been expected to furnish it, the document is considered to have been provided on time, as long as the applicant had taken all the necessary actions to ensure that it was available by the relevant date;

(c) that there is no penalty to the applicant for delays in retrieval of the document which are a normal part of the service (for example, because of short-term unavailability of the relevant digital library due to maintenance, or because a very large document is to be sent by post on CD or DVD instead of being transmitted online); or

(d) that where the service fails to deliver the document despite the applicant having taken the necessary steps by the appropriate date, the applicant should be given an opportunity to rectify the situation as described in section 5.3, below.

5.3 OPPORTUNITY TO COMPLY

13. 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 via the service to the applicant and the Office. The certificate is, subject to paragraphs 14 and 15, accepted by the Office for the purposes of the applicable law as proof of the matters it contains.

Opportunity to Comply

14. (a) Where a certificate referred to in paragraph 13 states that a priority document became available via the service to an accessing Office on a date which is on or before the date ("the relevant date") by which the priority document is required to be furnished under the applicable law, but the Office finds, whether before, on or after the relevant date, that the priority document is in fact not available to it, the Office so notifies the applicant, giving the opportunity to furnish the priority document to it, or to ensure that the priority document is made available to it via the service, within a time limit of not less than two months from the date of the notification.

(b) Where the priority document is furnished or 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 is not furnished or does not become available to the Office within that time limit, the consequences provided by the applicable law apply.

15. (a) Paragraph 14 does not apply to an accessing Office whose applicable law provides that it shall notify the applicant where the priority document is not available to it on the date by which it is required to be furnished under that law, giving the opportunity to furnish the priority document to it, or to ensure that the priority document is made available to it via the service, within a time limit of not less than two months from the date of the notification. Where the priority document is not furnished or does not become available to the Office within that time limit, the consequences provided by the applicable law apply.

(b) An accessing Office need not apply paragraph 14 where, under the applicable law:

(i) there is no fixed date, calculated from either the filing or the priority date, by which the priority document must be received by or made available to the Office;

(ii) it is required that the priority document be received by or made available to the Office before grant; and

(iii) the Office provides an online file inspection service enabling the applicant to monitor whether the priority document has been received by or made available to the Office.

5.3.1 The system is intended to be robust and to reliably provide documents to Offices of second filing which the applicant has specified should have access. However, occasionally, a failure in the system may occur such that a document which is supposed to be available to an Office is in fact not available. This might be caused by a problem with the core part of the service operated by the International Bureau, with the relevant participating digital library or by communications between any of the relevant Offices.

5.3.2 The “normal” minimum safeguard is set out in paragraph 14 of the Framework Provisions as above (special cases which were discussed by the Working Group and felt to provide a sufficient safeguard in an alternative way appear in paragraph 15 of those Provisions). According to this, if the applicant had taken all the steps necessary to make the document available to the Office through the system by the relevant date under the applicable national law (which can be confirmed using a certificate generated by the system), he should be notified of the problem and given two months to rectify it – either by furnishing a conventional certified copy of the application, or else through the problem in the service being rectified.

5.3.3 National laws are, of course, permitted to offer conditions which are more favorable to the applicant than the minimum safeguards which are required by the Framework Provisions. For example:

(a) a longer period than 2 months may be given to make a document available; or

(b) the applicant may be given the opportunity to validly furnish a document even though he had not taken the steps necessary to ensure that it was available to the Office of second filing on the date by which the national law would normally require it to be furnished – the Office would send a notice to the applicant whenever the problem was detected giving 2 months to rectify the problem (either by furnishing a document or by ensuring that the problem in the system was fixed) without the need to consider the certificate mentioned in paragraphs 13 and 14 of the Framework Provisions to determine whether the applicant had taken the necessary steps to ensure the availability of the document or not (this particular possibility is, in fact, specifically provided for in paragraph 15(a) and applies at the European Patent Office).

5.4 NOTIFICATION BY THE OFFICE

5.4.1 Once the Office is convinced that the technical systems are properly in place and that its national law fully recognizes priority documents available from the system as described in section 5.2 and offers appropriate safeguards as described in section 5.3, it may notify the International Bureau that that it will begin acting as an accessing Office using the service. The main items which need to be included in such a notification are:

(i) a statement that it is a notification under paragraph 12 of the Framework Provisions for the Digital Access Service for Priority Documents and the date from which the notification is effective;

(ii) the applications claiming priority which are entitled to use the service (whether the applications have to be filed on or prior to the effective date of the notification, or whether earlier applications for which the period for furnishing the priority document has not yet expired can also benefit);

(iii) the provisions of the national law which give recognition to documents available through the service and which give an opportunity to comply in accordance with paragraphs 14 and 15 of the Framework Provisions in case the document is in fact not available;

(iv) the service (EDI, TDA, etc.) by which the requests and priority documents should be transferred;

(v) what (if anything) the applicant needs to do to request that the Office attempt to retrieve the priority document from the service;

(vi) in the case of transfer using EDI, the hours of availability of the service by that Office, policies on scheduled maintenance and other downtime, and contact points for system notification and support (in the case of transfer using TDA, this information is included separately in the service level agreement); and

(vii) where an applicant can find further information on procedures relevant to use of the system through that Office.

5.4.2 Annex I contains a sample letter to the Director General of WIPO, making a notification under both paragraphs 10 and 12 of the Framework Provisions.

6 CONFIDENTIALITY

Priority Documents That Are Not Publicly Available

16. A priority document that is not publicly available under paragraph 17 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 23.

Priority Documents Becoming Publicly Available

17. 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, or on the basis of information obtained by, the International Bureau from the depositing Office that the document is publicly available under the applicable law;

(iii) upon a notification received by, or on the basis of information obtained by, the International Bureau from an authorized accessing Office that the document is publicly available under the applicable law or would be so available if it had been furnished to that Office by the applicant;

(iv) 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.

18. A priority document that is publicly available under paragraph 17 is available to any accessing Office, and may be made available to the general public, without the need for authorization by the applicant.

6.1 OVERVIEW OF SERVICE SECURITY FEATURES

6.1.1 The confidentiality of unpublished patent applications which are entered into the service is assured by a number of basic features of the system:

(a) Documents are only transferred between Offices using secure services which have been found suitable for transferring such documents for other purposes.

(b) The central part of the Priority Document Access Service, maintained by the International Bureau, will not attempt to access a document from a participating digital library until it has been properly notified that either:

(i) the document both exists and the applicant wishes it to be used by the service (Offices of second filing can request other documents, but they will simply receive error messages indicating that they are not available). The system supports several different ways of doing this, which the Office can select from according to its needs. The main options are shown as Routes A, B and C in the *System Architecture for the Digital Access Service for Priority Documents*. A further, paper-based system also applies for cases where applicants from countries whose Offices do not host a participating digital library; or

(ii) the document has been published.

(c) Offices can only access the document once the applicant has indicated that this is permitted for any specific Office. To set this information requires a code specific to an individual application (the applicant is able to change this code to be the same for all his applications, but he would be responsible for any reduction in security which this caused).

(d) Even if the access code becomes known to a third party, this does not give direct access to an unpublished priority document: this only permits setting the availability of the document to Offices of second filing.

6.2 SECURITY ISSUES TO BE CONSIDERED BY OFFICES

6.2.1 The International Bureau has made all efforts to ensure that the central services which it administrates are secure, but proper security also requires appropriate implementation by depositing and accessing Offices. The Office needs to be certain that the arrangements for making the connections to the Priority Document Access Service do not open up possible routes for access to systems by third parties.

6.2.2 Where the Office issues access codes to the applicants, these should be generated in a manner which cannot be guessed by third parties. Moreover, they should be communicated to the applicant in a form which is not available to the public at a time when it can cause difficulties. Ideally, any document communicating the access code should never become open to public inspection.

6.2.3 If national law requires that such documents be made available once the application is published, it is recommended either that a route is chosen where the International Bureau creates the access code and transmits it to the applicant, or else that the International Bureau is routinely informed when applications are published, so that it can from that point mark applications as available to any Office and prevent malicious third parties from removing rights of Offices to retrieve the document which had been set earlier by the applicant (noting that it might cause loss of rights if the system showed that a particular Office had not been given access to the document with effect from an earlier date than the publication date).

6.3 PRIORITY DOCUMENTS BECOMING PUBLICLY AVAILABLE

6.3.1 The service offers options whereby the applicant, the depositing Office and *authorized* accessing Offices may indicate that a specific priority document is publicly available. In this case, the document becomes available to *any* Office, whether the applicant has authorized it or not. In principle, the priority document may also be made available to the general public, though the service does not offer any such facility at the present time.

6.3.2 It is intended to include further details of this process in a later revision of this document. For the moment, Offices should contact the International Bureau if they wish to set up services for notifying the International Bureau that priority documents are publicly available (this can be done either by sending notifications specifically for the service, or else by indicating the availability of a definitive list of published application numbers from that Office in a suitable electronic form). As noted in paragraph 6.2.3, this may be important if the Office is required to make details of access codes available once the application is published.

7 ENSURING THAT THE SERVICE IS USEFUL

[Chapter to deal with recommendations on how to make the system easy and desirable for applicants to use - some issues

- o Must be accessible
- o Keep it free
- o EP example of using e-filing data as default ACC, promotes e-filing and is accessible
- o Sufficient and clear information, eg on websites
- o Ensure interoperability with WIPO works well
- o Work with applicants
- o etc

]

8 ADMINISTRATIVE MATTERS

Publication of Information

20. *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) participating digital libraries;*
- (iv) notifications and information received from Patent Offices under paragraphs 10 and 12;*
- (v) operating procedures and technical requirements referred to in paragraph 23.*

Consultative Group

21. *The Consultative Group consists of:*

- (i) Patent Offices from which the International Bureau receives a notification under paragraph 10 or 12;*
- (ii) any other Patent Offices that notify the International Bureau that they wish to participate in the Group;*
- (iii) as observers, interested organizations invited to meetings of the Working Group that notify the International Bureau that they wish to participate in the Consultative Group.*

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

Operating Procedures and Technical Requirements

23. *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 participating digital libraries under paragraph 7 and the means by which applicants authorize access for the purpose of paragraph 16.*

Modification

24. *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.*

Languages

25. *These provisions are established in the Arabic, Chinese, English, French, Russian and Spanish languages, all texts being equally authentic.*

8.1.1 In future versions of this document, this chapter will include information relating to certain matters relating to the administration of the service, especially those relating to publications and the Consultative Group.

9 POSSIBLE FUTURE EXTENSIONS OF THE SERVICE

9.1 BACKGROUND

9.1.1 Offices and the International Bureau were aware of certain limitations of the system when it was set up. These were based on compromises necessary in order to gain agreement on a system which could be implemented quickly and it was always envisaged that certain matters might be reviewed later in order to provide a more complete, efficient and useful service. Some of these matters which may be of relevance to designing appropriate flexibilities into legal and technical arrangements are indicated below.

9.2 TYPES OF DOCUMENT AVAILABLE

Translations of Priority Documents

19. *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.*

9.2.1 At present, the service extends only to patent applications (applications of a kind referred to in Article 3 of the Patent Law Treaty). It does not permit the making available of utility models or certain other kinds of protection which could conceivably form the basis of a right of priority under different patent laws. However, the Working Group on the Digital Access Service for Priority Documents envisaged that, if successful, the service would be extended to other types of documents, in particular:

(a) Paragraph 19 of the Framework Provisions allows the International Bureau, following consultation with the Consultative Group, to establish procedures enabling translations of priority documents to be deposited and made available under the service.

(b) The Working Group envisaged that the Framework Provisions might be revised, once the service was up and running, to include utility models and the like (paragraph 50 of document PCT/WG/2/4).

9.3 MEANS OF AUTHORIZING ACCESS

9.3.1 At present, except in certain cases where the applicant or a relevant Office has indicated that a priority document is publicly available, applicants must individually authorize each Office through the website maintained by the International Bureau, using a separate access code for each patent application, before the Office of second filing can access the application. While more efficient than dealing with paper certified copies, it is recognized that for people dealing with many applications, this remains time-consuming task with potential for error. Consequently, it is likely that the Framework Provisions or operating procedures under those Provisions will be reviewed to include:

(a) recognition of bilateral arrangements between Offices where unpublished priority documents can be shared without specific permission by the applicant; and

(b) account-based systems, where the priority document is associated with a portfolio for the applicant which can be managed more efficiently, for example by offering default access permissions or by allowing changing of permissions for individual applications in the portfolio without needing to login for each with the individual access codes.

Comment [K1]: Do we need to update framework provisions or operating procedures for this?

ANNEX I

SAMPLE LETTER MAKING A NOTIFICATION UNDER PARAGRAPHS 10 AND 12 OF THE FRAMEWORK PROVISIONS

The following is a sample letter showing the type of information which should be included in a notification under paragraphs 10 and 12 of the Framework Provisions.

Items in square brackets within individual paragraphs show options to be selected or parts which would typically need to be adapted to the requirements of any specific national system. Many of the paragraphs as a whole are merely examples of the types of possible relevant information: not all should be included in any specific letter and further, similar options might need to be included appropriate to any specific Office.

While it is hoped that eventually as many Offices as possible will use the service both as Offices of first and second filing, it is possible to make notifications under either paragraph 10 or paragraph 12 individually, without offering services relevant to the other.

Dear Dr. Gurry,

I have pleasure in notifying you that, in accordance with the paragraphs 10 and 12 of the Framework Provisions for the Digital Access Service for Priority Documents, as established on March 31, 2009, that the *[NAME OF OFFICE]* will make available documents from its digital library to the Digital Access Service and treat priority documents available to it from the Digital Access Service as though they had been furnished to it by the applicant, with effect from *[DATE]*.

The legal basis for recognition of priority documents made available through the service, and the opportunity for applicants to comply with the requirements at a later date in the event that a priority document cannot be retrieved by the Office despite the applicant having taken all the necessary steps in due time are set out in [Section XX of the Patents Act 2005 and Rule YY of the Patents Regulations 2008].

Following consultation with the Consultative Group and designation by the International Bureau on *[DATE]*, the scope of the Office's participating digital library which it makes available as a depositing Office is as follows:

- (i) all national patent applications filed at the Office in electronic form on or after *[DATE]*;
- (ii) all other national patent applications filed at the Office on or after *[DATE]* which the applicant specifically requests be made available to the service;
- (iii) all certified copies of patent applications furnished to the Office for use as priority documents in respect of a national patent application on or after *[DATE]* which the applicant specifically requests be made available to the service.

Annex I: Sample letter making a notification under paragraphs 10 and 12 of the Framework Provisions

As an accessing Office, the Office will recognize priority documents available to it through the service for the purposes of [later applications filed on or after *[DATE as in the first paragraph]*] [any application for which the time for furnishing the priority document has not expired by *[DATE as in the first paragraph]*].

Regarding the technical arrangements for this arrangement:

(i) all documents and information will be exchanged [over PCT-EDI in accordance with *title of the document setting out the PCT-EDI transmission specification – not yet finalized*] [over the Trilateral Document Access (TDA) service, in accordance with version 1.7.1 of the TDA specifications, including the provisions relating to electronic Priority Document Exchange (PDX) systems and the Digital Access Service, as well as the sending of over-sized documents on CD or DVD].

(ii) as a depositing Office, the Office has adopted [Route A] [Route B] [Route C] from the alternative entry routes set out in the system architecture described in Annex I of document WIPO/DAS/PD/WG/2/4.

The following practical information may be useful to applicants:

A request to the Office to make an application available through the service may be made [by checking the relevant box in the application form,] [using Form XXX, available from the Office website at www.xxxxxx.xxx, or] [by sending a letter clearly stating the relevant application number and indicating that it should be made available to WIPO Priority Document Access Service].

All applications filed in electronic form at this Office will automatically be made available to the Priority Document Access Service: for these applications, the “digest of submission” code shown on the filing receipt acts as the applicant’s “access code” and can be copied and pasted into the relevant field in the Priority Document Access Service web portal.

To request the Office as accessing Office to retrieve the document from the service, the applicant should [check the relevant box next to the priority claim on the application form] [or send a letter to the Office].

As an accessing Office, the Office will automatically attempt to retrieve all priority documents from the service: if an applicant believes that he has taken the steps at the Office of first filing and the service’s applicant portal necessary to make the document available to this Office, he does not need to make any special indication to the Office. If the Office has not either received a conventional certified copy by the relevant date or been able to access the document from the service, it will contact the applicant, offering a period of at least two months to rectify the problem.

Further details on the Office’s participation in the service can be found at [...].

Yours sincerely ...

ANNEX II

CHECKLIST OF ISSUES TO CONSIDER AND STEPS TO TAKE

[to be added]