

Evaluation of WIPO Survey on Availability of Patent Legal Status Data

This survey is related to the following 'feasibility study' requested by WIPO's Development Agenda Project DA_16_20_01 (see paragraph 3.2 of document CDIP/4/3 Rev):

"The Study would analyze the feasibility of WIPO supporting IP Offices that wish to establish a national database containing the legal status of national patents so that the register may enhance public access to the information necessary for identifying inventions in the public domain. The study also includes the possibility of creating a global portal in PATENTSCOPE®, which would link to those patent registers."

For the purpose of this study, the survey intended to investigate the availability and reliability of patent legal status data from primary sources of legal status data, i.e. national patent registers and patent gazettes or bulletins. A questionnaire was sent to all WIPO member countries and regional organizations in charge of granting patent rights (WIPO Circular C.N 3159).

A total of 87 replies were received from following countries or organizations (In the following the term "country" includes also regional organizations, unless specified otherwise): AM, AP, AR, AT, AU, AZ, BA, BE, BG, BH, BI, BO, BR, BT, BY, CA, CH, CL, CN, CO, CR, CU, CZ, DE, DJ, DK, DZ, EA, EC, EE, EG, EP, ES, FI, FR, GB, GE, GR, HK, HR, HU, ID, IE, IL, IS, IT, JO, JP, KE, KG, KZ, LI, LK, LT, LV, MA, MD, ME, MG, MX, MY, MZ, NL, NO, OM, PE, PG, PH, PK, PT, RO, RU, SA, SE, SG, SI, SK, SL, SR, SV, SY, TR, TT, UA, US, UY, UZ, ZA.

This evaluation is complemented by the separate document "*Statistical Summary of WIPO Questionnaire on Availability of Patent Legal Status Data*" including a simple statistical analysis of the replies, i.e. the Yes/No counts for each question that were to be answered by "Yes" or "No".

Availability of primary legal status sources

The primary sources of legal status data are patent gazettes/bulletins and patent registers. The survey was based on the following definition of these sources:

Patent Gazettes or Bulletins are individual publications published as separate issues on specific dates for the purpose of informing the public about patent applications that have been filed or/and patents that have been granted (see, e.g. WIPO Standard ST.18). Once published the content of a particular issue of the gazette or bulletin is not updated.

Patent Registers serve the purpose of informing the public about the most recent legal or administrative status of a pending application or a granted patent, i.e. they reflect the recent legal events or actions that changed or maintained the legal status. For the purpose of the study, a register is meant to be any electronic or non-electronic facility or service that allows the public to retrieve either directly (e.g. via the internet) or indirectly (e.g. via written request or a physical visit to the premises of the IPO) up-to-date information on the legal status related to individual national patent applications or patents. A patent register is considered operational if a requests regarding the legal status of national patent applications and/or granted patents can be submitted and processed.

Registers or gazettes are often defined by respective laws or regulations: 74 countries have replied that their patent legislation explicitly provides for a national patent register. For 12 countries this is not the case. In the vast majority of countries the register is also operational: only 5 of the 74 countries have replied that the register is not yet operational. 78 countries have replied that their patent legislation explicitly provides for a gazette; only one of these countries is not yet publishing such a gazette because it is in the process of implementing the patent system.

A register is already operational in 76 of the countries that have replied. 7 of these countries operate a register although it is not specified in the respective legislation. It can be assumed that a register is operational in some more countries because no replies were received from several countries which are known to have an efficient patent system operational.

10 countries have replied that they have no register operational; all of these 10 countries except for one publish legal status in a gazette though.

In summary, for a total of 85 countries some legal status information is available either through a register or a gazette.

With the exception of two countries (SV, TT), all countries with an operational register publish also a gazette although the data obtained from registers are usually more up-to-date. This is most likely explained by the fact that gazettes also serve the purpose of publishing other notifications not related to the status of individual patent rights.

Access to registers or gazettes

Internet access is possible for 47 of the 76 operational registers. For 29 registers that is not the case. For two registers (PT, ZA) access through the internet is the only way of obtaining legal status information.

For 74 of the 76 operational registers information on the legal status of an individual patent application or a granted patent can also or only be retrieved by submitting a (e.g. written) request to the Office. For 21 registers this is the only way of obtaining legal status information.

For all of the 29 registers that do not allow access through the internet, legal status can be obtained by such submission of a request, and for 7 of the 29 registers, such information can also be obtained by searching the register electronically other than through the internet (e.g. through terminals in the premises of the Office).

71 countries have replied that the gazette or bulletin is published electronically, e.g. in PDF format; however this electronic publication is accessible through the internet in only 66 countries. The respective URLs have been collected, will be verified and made available on a new WIPO website serving as a portal to gazettes and registers.

In summary, for a total of 65 countries some legal status information is available online through the internet, either through a register or a gazette.

Only 2 online registers require registration of the user.

The fee policy appears to be rather diverse, and the questionnaire did not intend to investigate comprehensively the details of the different fees that apply for different types of inquiries. However, for 50 registers at least some information can be obtained freely. More details can be obtained by referring to the individual replies to questions 7.1 to 7.4 of the questionnaire. The fee policy regarding gazettes was not investigated.

Update frequency

The update frequency of registers and gazettes reveals the different nature of the two sources.

Of the 47 online registers, a majority of 33 is updated daily, 7 are updated weekly, 2 are updated every second week, and 5 are updated monthly. 2 are updated at non-periodical intervals.

A majority of 33 gazettes is published regularly every month. 22 gazettes are published weekly, and others bi-weekly (6), bi-monthly (6) or quarterly (6).

Data content of registers and gazettes

The content of registers, i.e. the different types of patent status or legal events reflected in the register, varies strongly. The information details provided can be broadly separated in pre- and post-grant legal status.

As expected, the minimum information offered by a register relates to the grant of a patent right: 73 of the 75 IPOs with an operational register have replied that this information is indeed retrievable (2 IPOs with an operational register have not answered respective questions).

Explicit information on the invalidation, revocation, nullification, expiry or lapse of a patent is available from 70 of these 73 registers with grant information, and thereby permits verification of the validity of a granted patent; two additional registers allow for an indirect conclusion because they include at least information on fee payments (AR, SY), and only one register appears not to include any information on the validity of a granted patent (MA).

Only 62 registers do also provide information on patent applications prior to their grant. That can largely be explained by the fact that in these legislations patent applications are not published prior to grant (10 countries) and thereby do not make any information on such applications available in the register either.

Only 50 registers include information on the entry into the national phase of PCT applications. Several member states of the European Patent Organisation (EPO) have replied "No" on the respective question because the national phase entry for their country is via the EPO. The registers of further 7 PCT member states do not include such information. Information regarding the non-entry in the national PCT phase is very scarcely available in registers: only 12 registers make such information available.

Changes of ownership of the registered patent rights is recorded by 69 registers and thereby ranks second in the list of legal events recorded by registers. Surprisingly, 57 registers disclose also information related to licenses. The range of license information is quite diverse and appears to include compulsory, exclusive and non-exclusive licenses. For more details, reference is made to the compilation of replies to question 9.17 of the questionnaire.

It should be noted that the questionnaire only researched the publicly available legal status data. The office internal administrative systems most likely record many more legal events or actions.

The content of gazettes has not been researched by the questionnaire.

Sharing of register data

In view of the authoritative nature of the legal status data available in national register as primary sources, it is interesting to know to what extent the owner of such data would be able to share them with other database providers compiling and processing such information in order to make the whole data searchable through a single interface.

From a purely legal (and not technical) perspective, 73 IPOs would be able to share published legal status information with WIPO, i.e. there would be no legal impediments; 3 of these IPOs (KE, MY, PK) have indicated that the legal constraints would require the payment of a fee. 61 IPOs would also be in the position to share the data with other IPOs. However, only 43 IPOs would be able to share the data also with commercial providers of patent information. 5 IPOs appear to be able to share such data only with WIPO.

Only 26 of the 73 IPOs that would be able to share data with WIPO already exchange such data with WIPO while 43 IPOs exchange data with other IPOs, e.g. EPO's INPADOC database. Only 14 of the 43 IPOs that would be able to share data with commercial providers do indeed exchange data with them. The latter could perhaps be explained by the fact that many commercial providers obtain legal status data from INPADOC or that there is a mismatch between the prices offered by vendors and the prices asked by sellers.

38 IPOs of the 73 IPOs without any legal impediments for sharing data with WIPO would also technically be in the position to share such data. However, only 12 of these IPOs do not yet share the data with other IPOs, e.g. EPO's INPADOC database. And only 2 of these IPOs (AM, IS) appear to be able to share such data with WIPO only.

13 IPOs of the 73 IPOs without any legal impediments for sharing data with WIPO are technically not in the position to share such data. However, 5 IPOs (JO, KE, SA, UY, ZA) have indicated possibilities for technical support by WIPO, i.e. the adaption of WIPO's IPAS software.