European Industry proposals for Active part of Global Dossier

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Based on the presentation "Beyond the BIG 3"

Dr. Peter Kallas, EPOPIC 2014, Warsaw, 2014-11-05
and EPO survey of European Industry, reported at IP5 Meeting, Busan, 2014-06-05
EPO initiated study based on interviews with staff of large cross-filing companies in BE, FR, DE, NL, SE, CH and UK

Topics:

- Level on interest in transactional and information tools facilitating activities at an IP5 federated level

- Perceived gaps in existing patent filing and prosecution electronic tools/processes when pursuing an international filing at IP5 level

- Information about family member applications of an applicant and how to make available or searchable
Suggestions of European Industry for Active Part of Global Dossier

- One format for application forms
- Acceptance of international search report at national phase
- English as accepted as official language across IP5
- One Mailbox for IP5
- One examination report valid across IP5

Legal Status Data

- One consistent application number
- Completing forms requiring inventors’ signatures once at initial filing
- Electronical exchange of priority documents & other documents
- Standardising translation deadlines across IP5 (easier coordination of translation for applicant)
Industry’s needs - the results of a PDG survey in autumn 2014 on legal status data

Which are the most important new countries/offices to be included in INPADOC?
Which are the most important countries/regions already covered in INPADOC where additional data/events are needed?
The patent information workflow - Why legal status data?

- **Search**
- **Analysis**
- **Evaluation**

Technical relevance

Original Patent

Abstract

MT Full text

Legal status data

Request

Search in Databases
Legal status data means legal certainty

- The patenting system encourages further innovation and investment in technology for the benefit of society
- It is essential that all organizations participating in business activities are made aware of monopoly rights arising from IP rights held by others
- It is of paramount importance to know whether a patent is in force or not
- Other basic legal status data is of similar interest (e.g. current ownership)

→ Legal status data is key information that people need to know.

This information should be readily available as it has direct consequences not just for business, but for society in general.
How to reach legal certainty?

- In real life we need information on a range of legal status events from all (major) patent offices.

- The data should be available from one source connecting all patent family members: INPADOC.

- This data need to be up to date, reliable, comprehensive, comprehensible, standardized and in high quality.

- Hence, it is of critical importance that patent offices send their data in time, complete, standardized and in high quality to the EPO/INPADOC.
PCT-cases entering national/regional phase
Progress made
PCT-cases not entering national/regional phase
Only a few offices offer non-entry data...
PCT-cases entering the national/regional phase
Drawbacks: Recent concerns about timeliness and coverage...
The recommendation of PDG/ European Industry for legal status data
- Basic requirements

- To make life for all offices easier we started with the core events as "minimum requirements":

  - **Pre-grant events:**
    - Publication of the application
    - Examination
    - Application withdrawn
    - Application rejected
    - For PCT filings the entry / non entry into the national phase

  - **Grant**
    - Event code for grant missing

  - **Post-grant events:**
    - Opposition
    - Expiration
    - Fee payments
    - Reinstatements

  - **General:**
    - Change of ownership
    - SPC

  ➔ These core events are essential; but additional events are important too.
The recommendation of PDG/ European Industry for legal status data - The approach

- PDG developed a recommendation for minimum requirements for the delivery of legal status data

- In April 2013, this PDG proposal was discussed on WIPO level

- The proposal was accepted and reads “Prepare a proposal to establish a new WIPO standard for the exchange of patent legal status data by industrial property offices….”

- Based on this proposal, a WIPO Task Force on Legal Status (LSTF) started in December 2013

- Recently, the group defined legal status categories and events of individual patent offices

  - This could become a major step in improving the coverage and standardizing global legal status data.
Some required improvements for CN, JP, US and PCT!

- **CN**: Reinstatement, renewal fees paid, reassignment information (change of ownership) and faster updating

- **JP**: Result of appeal against decision of rejection and against examiner's decision, division applications, reassignment information (change of ownership), expiry data/patent term extensions and more backfile data

- **US**: Status of published applications

- **EP**: Grant event code

- **PCT**: Data on entry and **NON entry** into the national or regional phase!
A roadmap for the future - a proposal for the IP5 agenda

- General acknowledgement of the importance of legal status data by all intellectual property offices has to be achieved - **What could we do?**

- Quality of data has to be maintained at the source - **We need a global quality concept!**

- Transparent standards should facilitate the exchange of data between offices - **Could IP5 offices support?**

- No waste of effort - **At least one comprehensive source should be available.**

- The are use cases for INPADOC, PATENTSCOPE, Global Dossier, Federated Register - **Make data available for these cases!**

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**Legal status data – as the key to legal certainty in the patent information world – should also become part of IP5 GD activities!**