

Subject: BUSINESSSEUROPE comments on digital access service for priority documents

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Dear Sirs,

We would like to thank you for the new proposals concerning a digital access service for priority documents.

In view of the first session of the Working Group on the Digital Access Service for Priority Documents (07-09 February 2007) BUSINESSSEUROPE would like to submit the following comments.

In general, BUSINESSSEUROPE is in favor of reducing formal obligations that do not bring real benefits. While we agree that priority documents should be present in patent application files so as to allow third parties to assess the validity of the patent (or the risk that a valid patent will be granted with a scope that may affect their business opportunities), it would be great if applicants and their representatives could be relieved from the burden to submit priority documents if smoother alternatives exist.

In view thereof, we believe that the existing fully transparent priority document exchanges between EPO and JPO, as well as between USPTO and EPO, are beneficial to applicants and their representatives, and an example for how the new system to be organized by WIPO should operate. For more details, reference is made to [http://www.european-patent-office.org/epo/president/e/2007\\_01\\_11\\_e.htm](http://www.european-patent-office.org/epo/president/e/2007_01_11_e.htm) <[http://www.european-patent-office.org/epo/president/e/2007\\_01\\_11\\_e.htm](http://www.european-patent-office.org/epo/president/e/2007_01_11_e.htm)>

All that a European patent applicant claiming a Japanese or US priority needs to do is to file the European patent application with the priority claim. Thereafter, the EPO, of its own motion and free of charge, ensures that the JP or US priority document is included into the file of the European patent application.

With these EP-JP and EP-US examples in mind, we believe that the new WIPO proposals as described in WIPO/DAS/PD/WG/1/3 should be made even more user-friendly.

Article 1

(iii) We appreciate this definition to cover WIPO in its capacities as RO/IB and/or IB under the PCT as well as regional patent offices (ARIPO, EPO, EAPO, OAPI).

(x) We propose to abandon the concept of an "access authorization code" altogether. In the above-mentioned priority document exchanges between EPO and JPO and between EPO and USPTO no such code has appeared to be necessary. As the combination of application number and filing date of a priority application is only known to the applicant, to the patent office with which the priority application has been filed, and to a patent office with

which a priority-claiming application is filed, any patent office that knows this combination must be deemed to be authorized by the applicant to obtain a copy of the priority document. The introduction of an “access authorization code” just adds unnecessary complexity to the system.

### Article 3

(1)(i) We propose to delete the words “on request by the applicant”. In the above-mentioned priority document exchanges between EPO and JPO, and between EPO and USPTO, no such request has appeared to be necessary. The mere fact that a priority-claiming application has been filed should automatically result in insertion of a copy of the priority document into the file of the priority-claiming application.

### Article 4

(1) For reasons mentioned above at Article 1(x), we propose that this paragraph be deleted. The concept of an “access authorization code” just makes the system unnecessarily complex. Also, for an applicant, the system should be fully transparent: he should not need to know whether his particular priority document is stored if he has filed the priority application with a Patent Office that participates in the new system. As a result, there is no need for notifications by WIPO to the applicant that his priority document is stored: this just adds an unnecessary flow of notifications to the system, thereby making the new system unnecessarily complex and costly.

(3) For the same reasons, we propose to delete “, shall state that the applicant has authorized the access, and shall specify the access authorization code”. Identification of the priority application by means of the secret combination of application number and filing date should suffice. We draw your attention to the fact that the “previously filed application” of Article 5(7) PLT is not necessarily an application the priority of which is invoked. In view thereof, we also propose to delete the words “the patent application claiming priority and”. So, all what should remain of Article 4(3) is: “A request referred to in paragraph (2) (i) shall identify the priority document by means of its application number and its filing date”.

(4) We propose to amend this subsection as follows: “(ii) if the Patent Office that issued the priority document informs the International Bureau, or if it appears from public records maintained by a Patent Office, that the document has become publicly available under the applicable law;”

There is no need for any information from the Patent Office that issued the priority document if it is clear to WIPO from public records maintained by that Patent Office, or another Patent Office with which an application is filed that claims the priority of the priority application, that the priority document is publicly available. Again, if somebody knows the combination of application number and filing date of a priority document, then either the applicant has given those details, or the priority application is no longer a secret, so that WIPO should be free to issue copies.

(6) For the reasons mentioned above, we propose to delete “and shall not disclose an access authorization code”.

3.

(7) We propose that this redundant paragraph be deleted. Of course applicants want priority documents stored in accordance with the new system to be used as priority documents (and/or as certified copies of previously filed applications under Article 5(7) PLT). If this paragraph is not deleted, there is a risk that an applicant who forgets to make this redundant request ends up with a deposit of a priority document that cannot be used for the sole purpose for which it is stored, viz. to be used as priority document.

#### Article 5

(2)(ii) As we observed above in relation to Article 4(1), the system should be fully transparent for applicants in that they should no need to know any details if they have filed the priority application with a Patent Office that participates in the new system. So, the words “contrary to a notification under Article 4(1) of these provisions” should be replaced by “despite the fact that the priority application was filed with a Patent Office that has concluded an agreement with the International Bureau to make all its patent applications not subject to a secrecy order available to the International Bureau”.

Finally, as to costs, we observe that the above-mentioned priority document exchanges between EPO and JPO, and between USPTO and EPO, is free of charge for European applicants. We believe that these laudable examples should be followed. After all, once the new system is up and running, a lot of costs are saved by the participating offices. There is no need anymore to monitor whether the applicant has filed a priority document, no need anymore to send the applicant invitations to submit a priority document, no need anymore to send the applicant decisions that the priority right has lapsed for failure to timely submit a priority document, no need anymore to review and decide on requests to reinstate the priority right because the failure to timely submit the priority document was notwithstanding all due care of the applicant, etc.

Therefore, as introduction of the new priority document exchange system is not only favorable to applicants, but also clearly favorable to offices, the system should be free of charge.

As regards the costs incurred by WIPO, we additionally observe that notwithstanding Article 57(4) PCT the PCT fees are way higher than necessary to operate the PCT system, so that WIPO has sufficient funds available to operate this new system without there being any need whatsoever to charge applicants. Also, a purely electronic document exchange that builds on an existing infrastructure does not incur high costs that justify a fee payment by applicants.

We hope that these comments will be useful for your upcoming deliberations.

Yours sincerely,

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