

# European Industry proposals for Active part of Global Dossier

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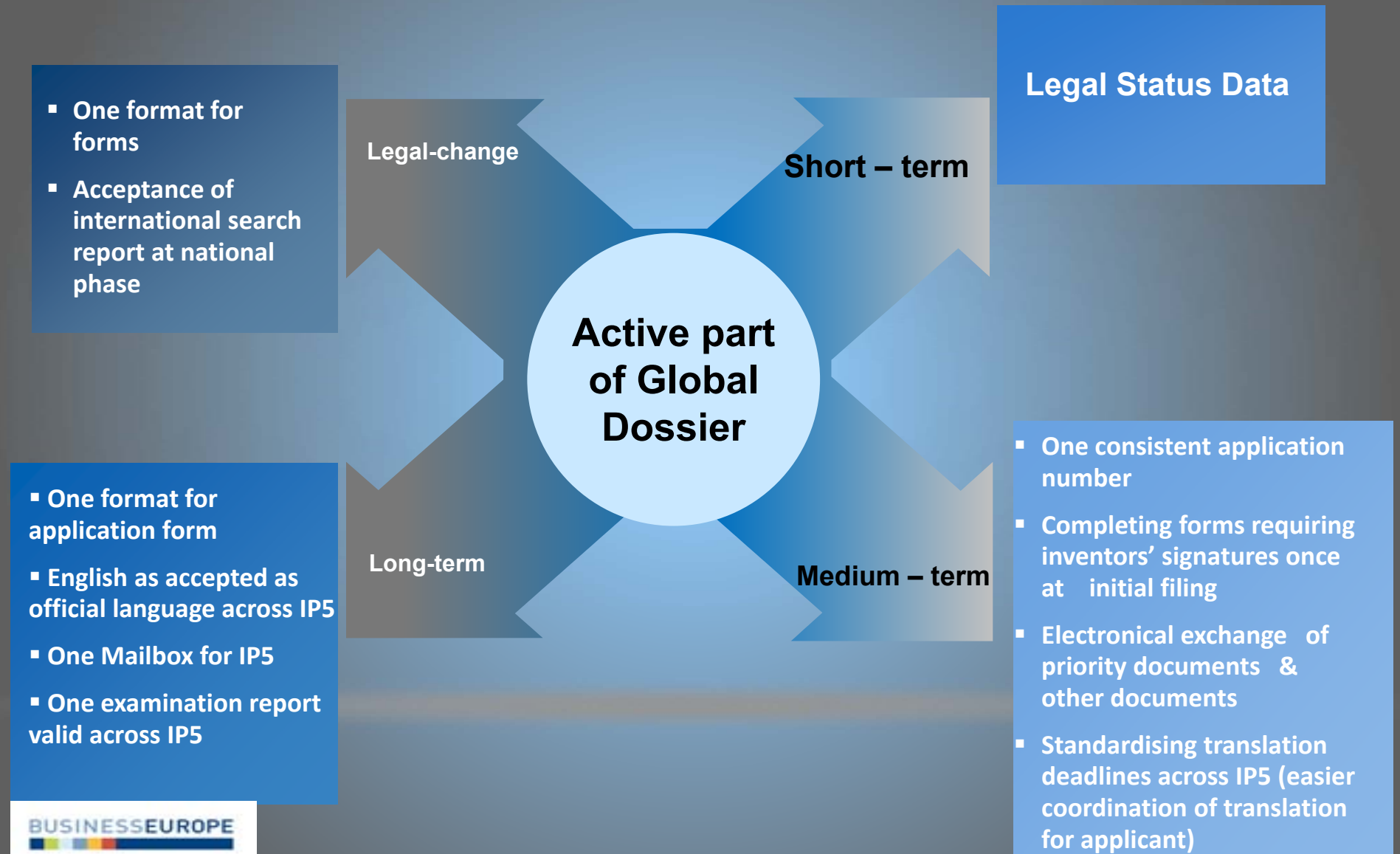
Based on the presentation "*Beyond the BIG 3*"  
*Dr. Peter Kallas*, EPOPIC 2014, Warsaw, 2014-11-05  
and EPO survey of European Industry, reported at  
IP5 Meeting, Busan, 2014-06-05

**EPO initiated study based on interviews with staff of large cross-filing companies in BE, FR, DE, NL, SE, CH and UK**

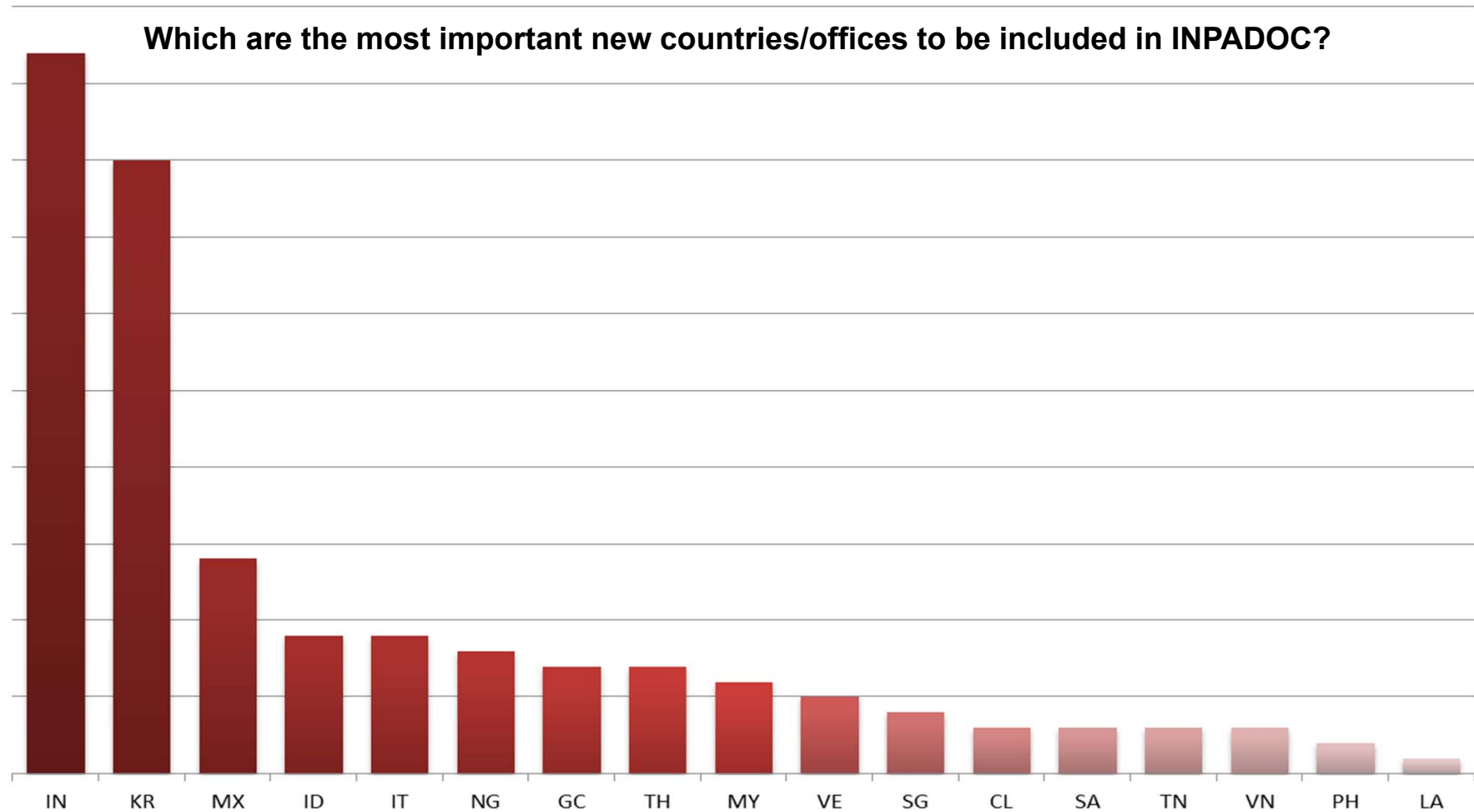
Topics:

- 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

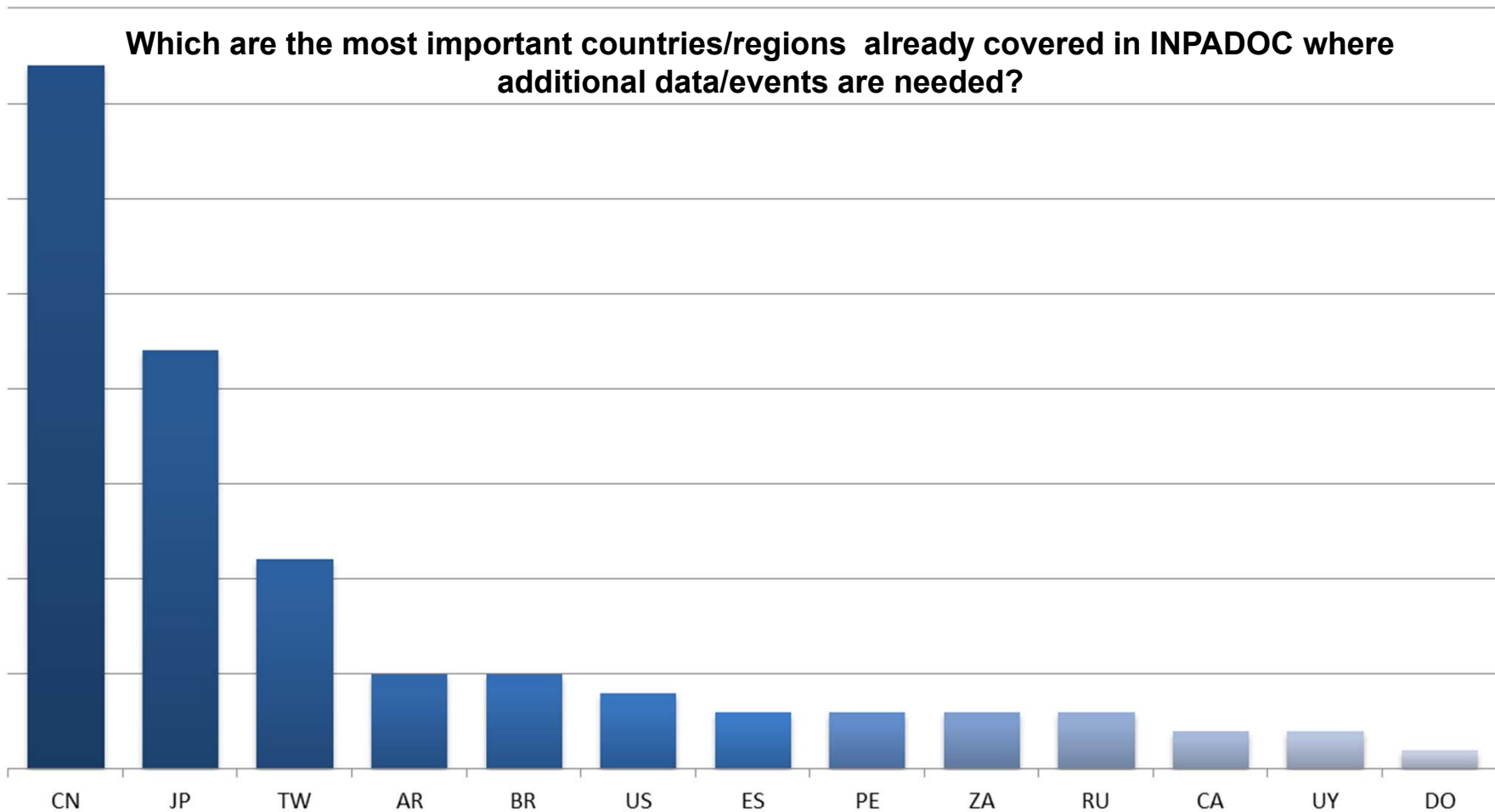
## Suggestions of European Industry for Active Part of Global Dossier



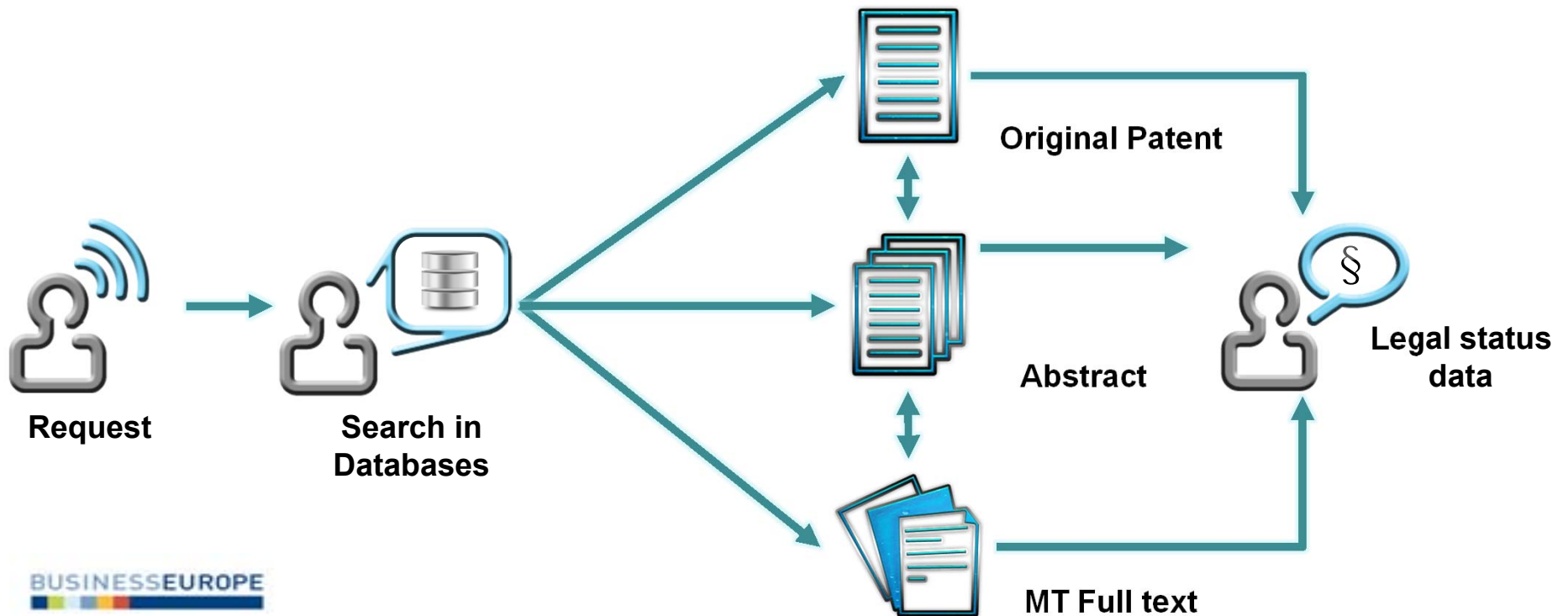
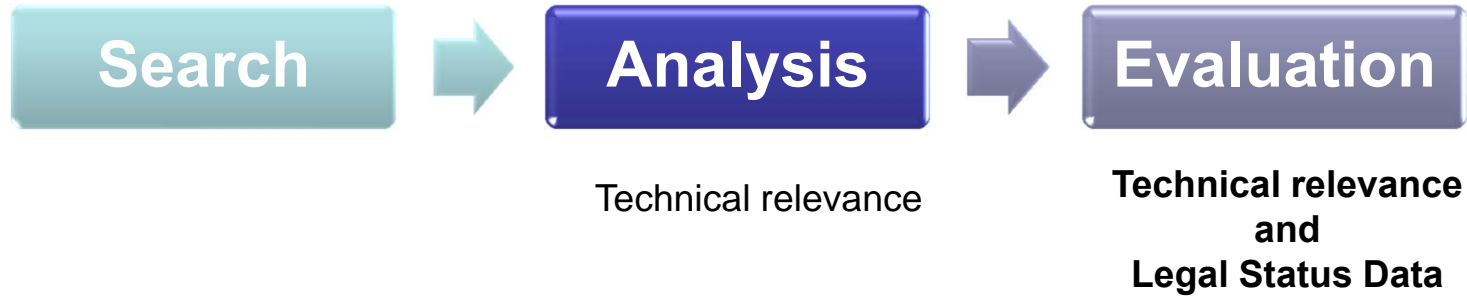
Industry's needs - the results of a PDG survey in autumn 2014 on legal status data



PDG Questionnaire - the results of a PDG survey in autumn 2014 on legal status data II



# The patent information work flow - Why legal status data?



## 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





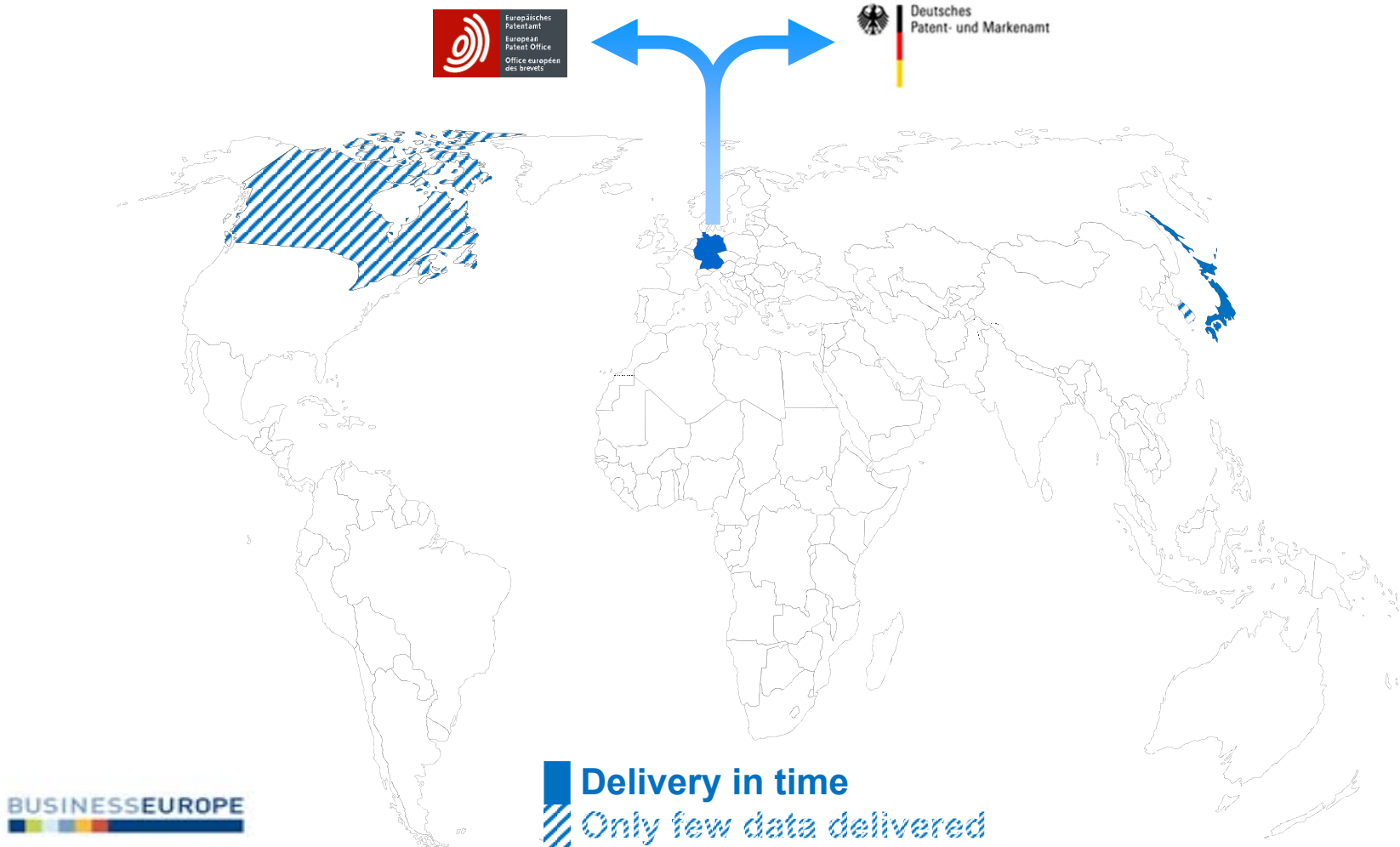
## PCT-cases entering national/regional phase

Progress made



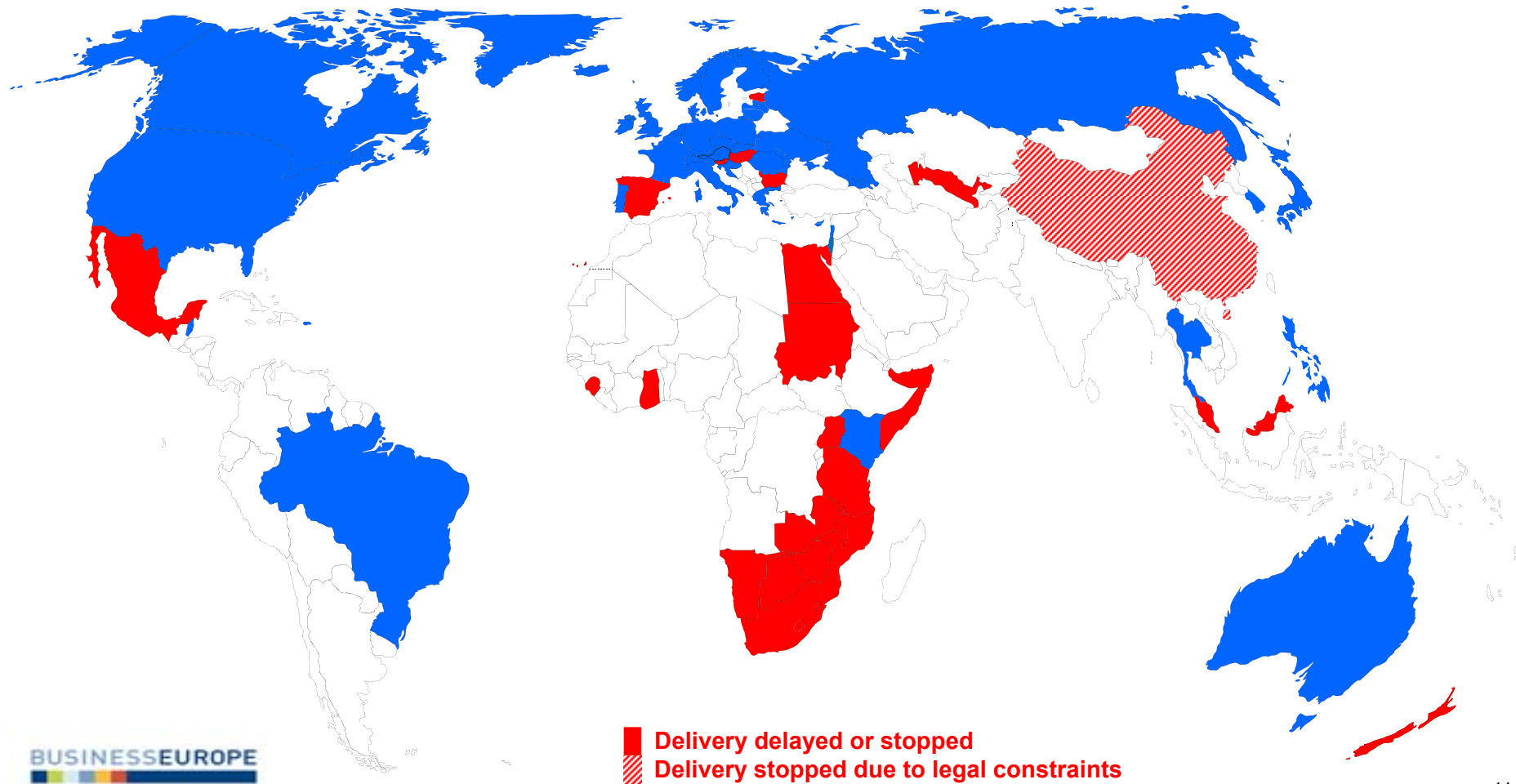
# PCT-cases not entering national/regional phase

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!**



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