

ST.27 Revisions

CWS/7 item 11(c)

1. Proposed ST.27 Revisions Agreed by Task Force

- Clarifying types of applications and IP rights in category descriptions
- Clarifying updates to R13 / R14 (transfer vs correction)
- New event “IP right entered into force”
- Changing “issued” to “completed” in D14 / D15
- Rename category S
- Adding Common Scenarios Guidance Document

Clarifying application and right types

- **A. Application filing:** ... Types of applications covered include patents for inventions, utility models, supplementary protection certificates, plant patents, design patents, inventors' certificates, utility certificates, and patents of addition.
- **F. IP right grant:** ... Types of IP rights covered include patents of invention, utility models, supplementary protection certificates, and any other IP rights that result from the types of applications covered by Category A.

Clarifying updates to R13 / R14

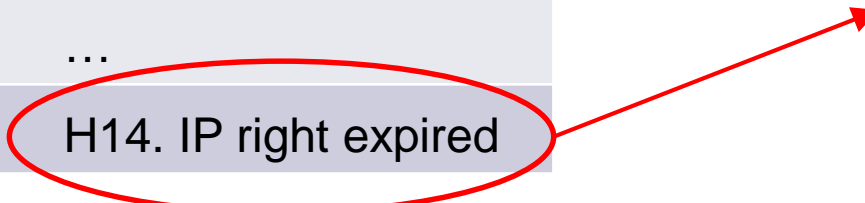
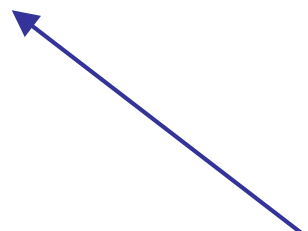
- R13*. Change to the name of applicant or owner recorded. (A change to the name(s) of the applicant(s) or owner(s) of the application or IP right that does not indicate a transfer was recorded by the IPO. The most common reasons for this type of change are name corrections, spelling mistakes, or legal name changes such as a corporate merger.)
- R14*. Transfer of ownership recorded. (A transfer of ownership, or an assignment, or a change to the composition of applicant(s) or owner(s) of the application or IP right was recorded by the IPO. This event indicates that the interest is given by one party to another, such as by a voluntary exchange, an assignment, or a contractual obligation.)

Motivation for New Event

- How to indicate when SPC protection starts?

Patent Event History
App num: 1234
Type: Patent
Related num: n/a
Event Data:
A12. Natl app filed
D15. Search report
F11. IP right granted
...
H14. IP right expired

SPC Event History
App num: 5678
Type: SPC
Related num: 1234
Event Data:
A12. Natl app filed
F12. IP right granted
<i>??? protection starts</i>



New event “IP right entered into force”

- F17. IP right entered into force.

(This event is for IP rights which enter into force at a later time after the grant, such as SPCs. Offices do not need to use this event when the grant and entry into force occur at the same time, such as a patent grant.)

Other Changes

■ Changing “issued” to “completed” in D14 / D15

D14. Search report ~~issued~~ completed (A prior art search report for an application was ~~issued~~ completed by the IPO.)

D15. Examination report ~~issued~~ completed (A substantive examination report was completed by the IPO ~~or a notification of the reason for refusal of the application was issued.~~)

■ Rename category S to "Licensing and related transactions"

- Better reflects events in Category S which do not involve licensing, such as security interests or royalty agreements

Common Scenarios Guidance Document

- Contains 5 scenarios that occur in many IPOs:
 - Application abandoned, ownership transfer, patent revoked after IP right review, SPC or PTE granted, utility model registered
- Examples from 4 - 6 IP Offices show how different Offices record the scenario in national data
 - Offices: DPMA, EPO, JPO, KIPO, UKIPO, USPTO
- Examples show how national data is translated into ST.27 data, including headers and supplementary data

2. Motivation for other proposal

All ST.27 Events at a Glance

Category A. Application filing	Category B. Application discontinuation	Category C. Application revival	Category D. Search and examination	Category E. Pre-grant review request	Category F. IP right grant	Category G. Protection beyond IP right term	Category H. IP right cessation	Category K. IP right revival	Category L. IP right review request	Category M. IP right maintenance
A10. Application filed	B10. Application discontinued	C10. Application revived	D10. Search and/or examination requested or commenced	E10. Pre-grant review requested	F10. IP right granted	G10. Protection beyond IP right term granted	H10. IP right ceased	K10. IP right revived	L10. IP right review requested	M10. IP right maintained
A11. Provisional application filed	B11. Application withdrawn	C11. Application revival requested	D11. Substantive examination requested	E11. Pre-grant opposition filed	F11. IP right granted following substantive examination	G11. Extension of SPC term requested	H11. IP right ceased following rejected request for revival	K11. IP right revival requested	L11. Post-grant opposition filed	M11. IP right maintained in full following an IP right review or an appeal
A12. National or regional application filed	B12. Application deemed to be withdrawn, abandoned or lapsed	C12. Request for application revival rejected	D12. Request for substantive examination rejected	E12. Pre-grant re-examination requested	F12. IP right granted following formality examination	G12. Extension of SPC term not granted	H12. IP right ceased following an IP right review	K12. Request for IP right revival rejected	L12. Post-grant re-examination requested	M12. IP right maintained in amended form following an IP right review or an appeal
A13. PCT application filed	B13. Regional filing not entered into the national phase	C13. Application revived following an application revival request	D13. Search requested	E13. Pre-grant limitation requested	F13. IP right granted in full following pre-grant review	G13. Extension of SPC term granted	H13. IP right lapsed	K13. IP right revived in full	L13. Limitation or reissue of IP right requested	M13. IP right maintained following rejected IP right review request
A14. Regional application entered into the national or regional phase	B14. PCT filing not entered into the national or regional phase	C14. Rights of priority restored	D14. Search report issued	E14. Pre-grant third party observation filed	F14. IP right granted in amended form following pre-grant review	G14. Extension of SPC term revoked	H14. IP right expired	K14. IP right revived in amended form	L14. Surrender of IP right requested	M14. Re-examination certificate issued
A15. PCT application entered into the national or regional phase	B15. Application refused following examination		D15. Examination report issued	E15. Request for pre-grant review rejected	F15. IP right granted following rejected pre-grant review request	G15. PTA requested	H15. IP right surrendered		L15. Invalidation requested	
A16. Divisional, continuation or continuation in part application filed	B16. Application discontinued following rejected revival request		D16. Fast track examination requested		F16. IP right converted from another IP right	G16. PTA not granted			L16. Post-grant third party observation filed	
A17. Divisional, continuation or continuation in part application rejected	B17. Application discontinued following pre-grant review		D17. Fast track examination accepted			G17. PTA granted			L17. Declaration of non-infringement requested	
A18. Application divided or continuation or continuation in part accepted			D18. Deferred examination requested			G18. PTE requested			L18. Request for IP right review rejected	
A19. Conversion application filed			D19. Deferred examination accepted			G19. PTE not granted			L19. Post-termination review requested	
A20. Conversion application rejected			D20. Deferred examination resumed			G20. PTE granted				
A21. Application converted from another type of IP right			D21. Rejection of application intended							
A22. Application converted from a regional or PCT application			D22. Grant of IP right intended							
			D23. Examination continued following pre-grant review							
			D24. Re-examination commenced							

Category N. Termination	Category P. Document modification	Category Q. Document publication	Category R. Party data change	Category S. Licensing information	Category T. Administrative procedure adjustment	Category U. Payment	Category V. Appeal	Category W. Other	Category Y. Correction and deletion of event information
N10. Application or IP right terminated	P10. Document modified	Q10. Document published	R10. Party data change recorded	S10. Licensing information recorded	T10. Administrative procedure adjusted	U10. Fee paid	V10. Appeal requested	W10. Other event occurred	Y10. Event information corrected or deleted
N11. Application terminated	P11. Amendment of application requested	Q11. Certain bibliographic information on the application published	R11. Change to the name of applicant or owner or transfer of ownership requested	S11. Voluntary license recorded	T11. Administrative time limit extension requested	U11. Full renewal or maintenance fee paid	V11. Administrative appeal requested		
N12. IP right terminated	P12. Request for amendment of application rejected	Q12. Application published	R12. Change to the name of applicant or owner or transfer of ownership recorded	S12. Recordation of voluntary license amended	T12. Administrative time limit extension not granted	U12. Designation fee paid	V12. Court appeal requested		
	P13. Application amended	Q13. IP right document published	R13. Change to the name of applicant or owner recorded	S13. Recordation of voluntary license cancelled	T13. Administrative time limit extension granted	U13. Renewal or maintenance fee not paid	V13. Appeal inadmissible, rejected or withdrawn		
	P14. Amendment of IP right document requested	Q14. Secret application or IP right declassified and published	R14. Transfer of ownership recorded	S14. Exclusive voluntary license recorded	T14. Administrative procedure suspended or stayed	U14. Designation fee not paid	V14. Decision remanded		
	P15. Request for amendment of IP right document rejected	Q15. Barrier publication cancelled	R15. Change to inventor requested	S15. Recordation of exclusive voluntary license amended	T15. Administrative procedure interrupted	U15. Partial renewal or maintenance fee paid modifying the IP right scope	V15. Decision substituted		
	P16. IP right document amended	Q16. A copy of IP right certificate issued	R16. Change to inventor recorded	S16. Recordation of exclusive voluntary license cancelled	T16. Administrative procedure resumed				
	P17. Translation of an application amended	Q17. Modified document published	R17. Change to representative recorded	S17. Non-exclusive voluntary license recorded					
	P18. Priority claim added or amended		R18. Changes to party contact information recorded	S18. Recordation of non-exclusive voluntary license amended					
	P19. Errors in documents containing IPO's decisions corrected		R19. Request for party data change rejected	S19. Recordation of non-exclusive voluntary license cancelled					
	P20. Errors in documents filed by the applicant or IP right owner corrected			S20. Security interest recorded					
	P21. Errors in published documents corrected			S21. Recordation of security interest amended					
	P22. Classification modified			S22. Recordation of security interest cancelled					
	P23. Related IP right document modified			S23. Compulsory license recorded					
	P24. Related application modified			S24. Recordation of compulsory license amended					
				S25. Recordation of compulsory license cancelled					

Issues with Current Approach

- Large number of events → harder to learn and use
- Relations between events are often not obvious
- Tension between adding new events and keeping list manageable
- Inconsistencies in level of detail recorded

Areas of Difficulty

- Finding related events within a category.
 - Example: A16, A17, A18: Divisional filed / rejected / accepted
- Finding related events across categories.
 - Example: E10 Pre-grant review → F13 IPR grant after review
- Search tool implementers and/or end users must understand relations between events at a deep level
- These relations are not explicitly recorded in ST.27

User's View / Implementer's View

A-0-1-A10-A16-x000

A-2-3-D10-D23-x000

A-1-1-A10-A18-x000

A-3-3-D00-D21-x000

A-2-2-B10-B12-x000

A-3-3-E10-E12-x000

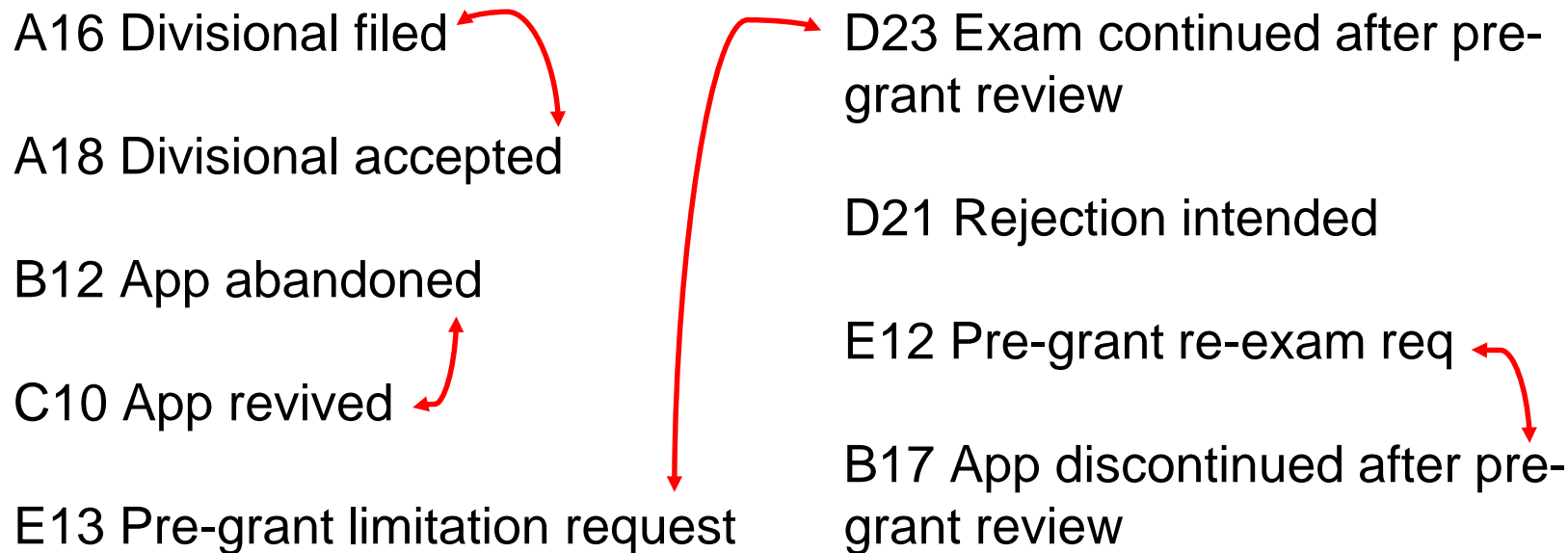
A-2-2-C10-C00-x000

N-3-6-B10-B17-x000

A-2-2-E10-E13-x000

- Which events are related? Requires deep understanding of event system.
- No indication which outcome goes with which source event.

Hidden relations



- These event relationships are hidden – not explicitly recorded in ST.27
- Can be difficult for users to figure out

3. Proposals still under consideration

Procedure tags

- Categorize each existing event by procedural type: request, acceptance, rejection, filing, etc
- Add the procedure type as a tag to the event encoding:
 - A16. A divisional, continuation or continuation in part application was filed → A16.fil
 - D11. Substantive examination requested → D11.req
 - D17. Fast track examination accepted → D17.acc

Potential Benefits

- Preserves current list of significant events
- Adjusts the event encodings slightly, without changing the meaning of any event
- 1 to 1 correspondence with existing events = simple update to Office mappings
- Procedure tags can be omitted when not relevant to text
- 70% of events use just 9 verbs
- Enables further improvements to event list...

Combine related encodings

- Related events in a category can be encoded together:

Current Encoding	Event Title	Proc. Tag Encoding	Combined Encoding
A16	Divisional filed	A16.fil	A16.fil
A17	Divisional rejected	A17.rej	A16.rej
A18	Divisional accepted	A18.acc	A16.acc

- Arbitrary combinations are still prohibited
 - e.g. A16.req not allowed

Potential Benefits of Combined Codes

- Makes relationships between some events more explicit
- Only the encoding changes; event meaning and detail preserved
- Can combine 45 numeric codes for a 25% reduction in number of unique number codes
- Could add new events related to existing events without a new numeric code
- Easier to implement: reduces need for a separate table to identify related events

Potential drawbacks

- Some Offices prefer shorter or simpler event codes.
- Some Offices want to maintain the current system to preserve their implementation investments or plans.
- Some Offices are not convinced that the potential benefits are worth the added complexity of the additional information.
- Some Offices think that more extensive reorganizations of the event list and encodings may be better.

4. IB Proposal

Reserved Tags

- Add three characters to ST.27 event codes (tags)
- Characters are fixed as “xxx” and reserved for future use
 - Example: A10 → A10.xxx, B17 → B17.xxx
- Task Force will explore possible uses for 3-letter tags and aim to present a proposal at CWS/8
- If no proposal is adopted by CWS, tags will remain fixed at “xxx” and reserved for possible future use

Benefits

- Allows Offices to proceed with implementation plans knowing that format of ST.27 codings will not change
- Follows common practice of industry ICT standards with reserved fields
 - Internet protocol TCP had 6 reserved header fields at adoption and 3 are still reserved today
- Supported by Task Force members at June 13 online meeting
- Members who want to explore alternate uses of tags report that 3 characters is sufficient

■ Thank you for your attention!