



Designing from scratch -

a *Gedankenexperiment* in building an IP system

Stephen Adams,
Magister Ltd.
www.magister.co.uk



Plus ça change....



- 1 Oct 1852: separate English and Scottish patents are abolished as a new UK-wide Patent Office formed.



- 3 Oct 1990: East and West Germany reunited.



- 25 Dec 1991: The Union of Soviet Socialist Republics was formally dissolved; 15 new patent offices eventually emerged.



- 1 Jan 1993: Czechoslovakia peacefully split into Czechia and Slovakia (without a referendum).



- 1989-1992: Yugoslavia disintegrated into (eventually) Bosnia/Herzegovina, Croatia, Kosovo, Montenegro, North Macedonia, Serbia and Slovenia.



- 26 Apr 2012: Moldova renounces Eurasian Patent Convention.



- 31 Jan 2020: Brexit.

- 2022-23 ? : IndyRef2 ?



- 2025 ? : Republic of Poundland ?



Issues which have to be faced



- International treaty status
- The back-file and pending applications
- The front-file; new applications for IPR
- Model patent legislation
- Establishing a new Patent Office
- Implementation of WIPO Standards
- Other economic and trade implications



International treaty status

- Any newly-formed state has to decide its adherence to:
 - the WTO / TRIPS (minimum standards)
 - the Paris Convention (priority rights)
 - the Patent Cooperation Treaty (international applications)
 - regional patent conventions (grant of regional patents)
 - trade rules within applicable Free Trade Areas (SPC Regulations / Unitary Patent)



If 'Poundland' stayed out....(I)

- WTO / TRIPS
 - no obligation to have minimum 20-year patent term or standards on patentable subject matter
 - cf. India Patent Act 1970; 14 years, only 7 years for food and drugs
 - no *de facto* recognition of filing priorities (TRIPS Art.2)
- Paris Convention
 - independent bi- or multi-lateral agreements would be a possible alternative (cf. Taiwan-GB agreement, Inter-American Convention 1910), with different priority periods recognised.
- Patent Cooperation Treaty
 - PCT could only be ratified once Paris Convention had entered into force in the country (PCT Art.62(1))
 - India acceded to both Paris and PCT on the same day (7th Sep 1998) and entered into force 3 months later.



If 'Poundland' stayed out...(II)

- Regional patent conventions
 - a new state may have to accede again to any regional treaties to which its predecessor state had been party
 - cf. 'declaration of continued applicability' by RU, post-SU
 - questions relating to the validity of existing regional patents designating the new state would have to be negotiated
 - cf. special treaty after Moldova left the EAPO
- Free Trade Agreements
 - subsequent accession to one or more FTAs or trading blocs might require adherence to internal IP rules
 - e.g. EU (recognition of internal Marketing Authorisation for Supplementary Protection Certificates)
 - e.g. Andean Community Decision 486 (common grace period)



The back-file

- Any newly-created state would have to create a re-registration regime, maintaining the validity of *existing* IPR effective in the same geographical area
 - automatic, if in force on independence date?
 - database reloaded with new CC; no other evidence?
 - accompanied by publication of new bibliographic record / document / new KD code?
 - e.g. SI-A8 publication post-YU breakup
 - deadline to register, otherwise loss of rights?
 - e.g. AM allowed up to 30th June 1995 for transfer of SU rights



Pending applications

- In addition, the new state would need to consider how to handle any applications which were *pending* at the time of independence
 - allow / disallow some or all previous priority claims?
 - depends upon treaty ratifications
 - satisfy new standards for application documents?
 - re-file in a new official language?
 - pay additional re-registration fees to allow progression under the new patent office?
 - re-issue previously published unexamined applications, with new CC/number?



The front file - new IPR filings

- A new body of IP law would be required.
- The new state's government could
 - a) take the opportunity to re-design from scratch, or
 - b) re-adopt much (perhaps all?) of what is already in place.
- In the case of (a), it presents a chance to develop an IP information system which is fully compliant with WIPO Standards and Recommendations
- It also allows for the possibility of (or may require the creation of) new kinds of IP right
 - e.g. the UK had to create a domestic Geographical Indications right after Brexit, in order to maintain effect to existing EU PGI/PDO rights.



New IP laws may mirror or supplement existing systems

- The 2013 Scottish independence campaign developed certain aims concerning IPR:

67. Will independence offer improved intellectual property services?

Yes. Independence will allow Scotland to offer a *simpler, cheaper and more business-friendly model* than the current UK one which is seen as bureaucratic and expensive, especially for small firms. The UK is one of very few EU countries which does not offer a “second tier”, or “utility” protection scheme which covers the basics of IP protection and is cheaper and quicker to access. *Scotland could follow, for example, the German utility model* which is more a protection of technical innovations. [my emphasis]

(Source: Scotland's Future (Q&A section). Available at www.scotland.gov.uk/Publications/2013/11/9348/15)



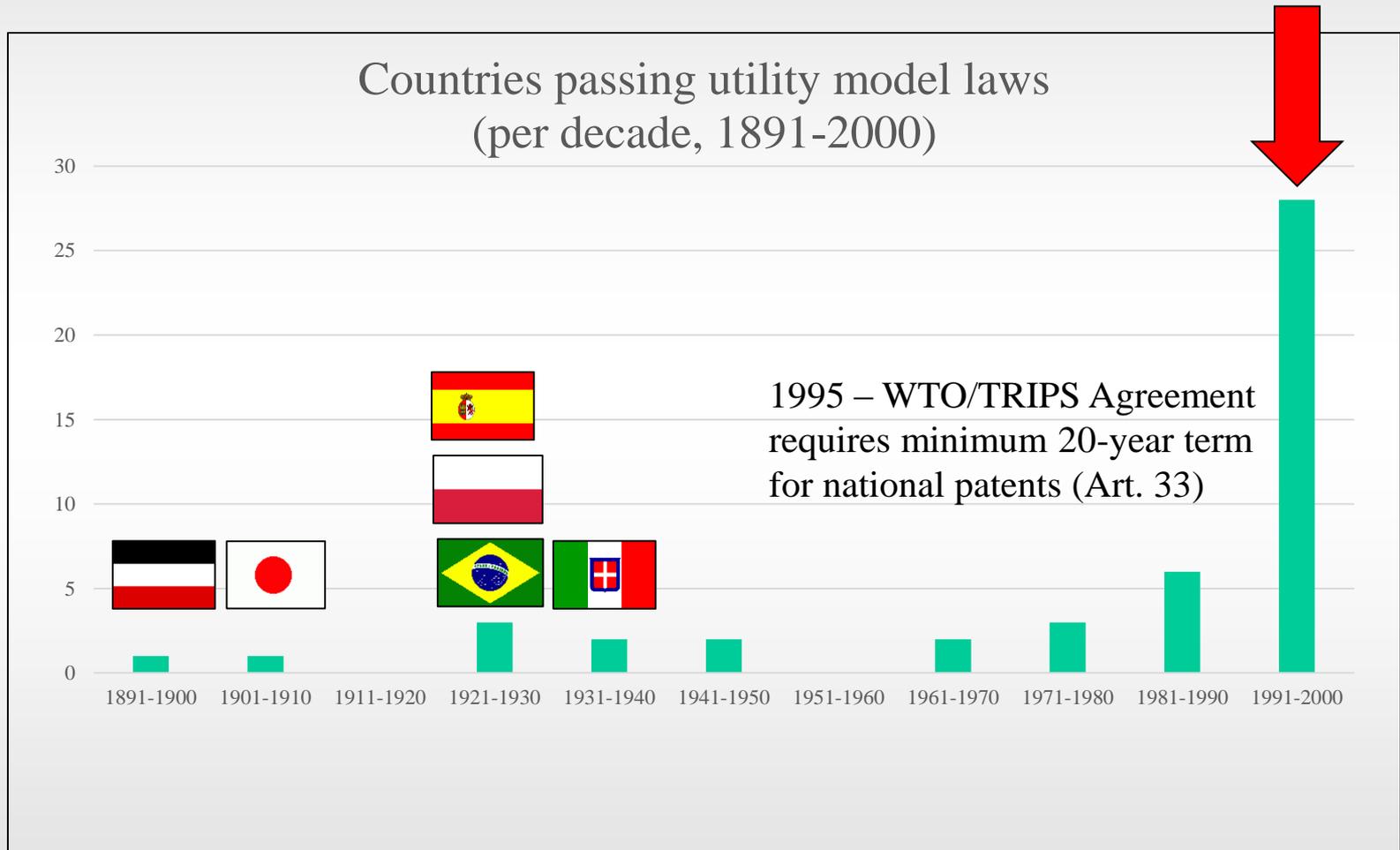
Where do utility models already exist?

- Statistics are unreliable – not all ‘utility models’ are called by this name, nor defined by a separate law:
 - they may be referred to as:
 - Utility model, *Gebrauchsmuster* (DE, AT)
 - Petty patent, innovation patent (AU)
 - *Certificat d'utilité* (FR)
 - Short-term patent (IE, HK)
 - Second-tier protection (generic)
 - term typically ranges from 7-15 years, no examination
- *At least* 100 countries in the world have active UM regimes at the present time
 - WIPO lists 73 national and 3 regional systems (equivalent to 112 jurisdictions)
 - other directories list at least 123 countries



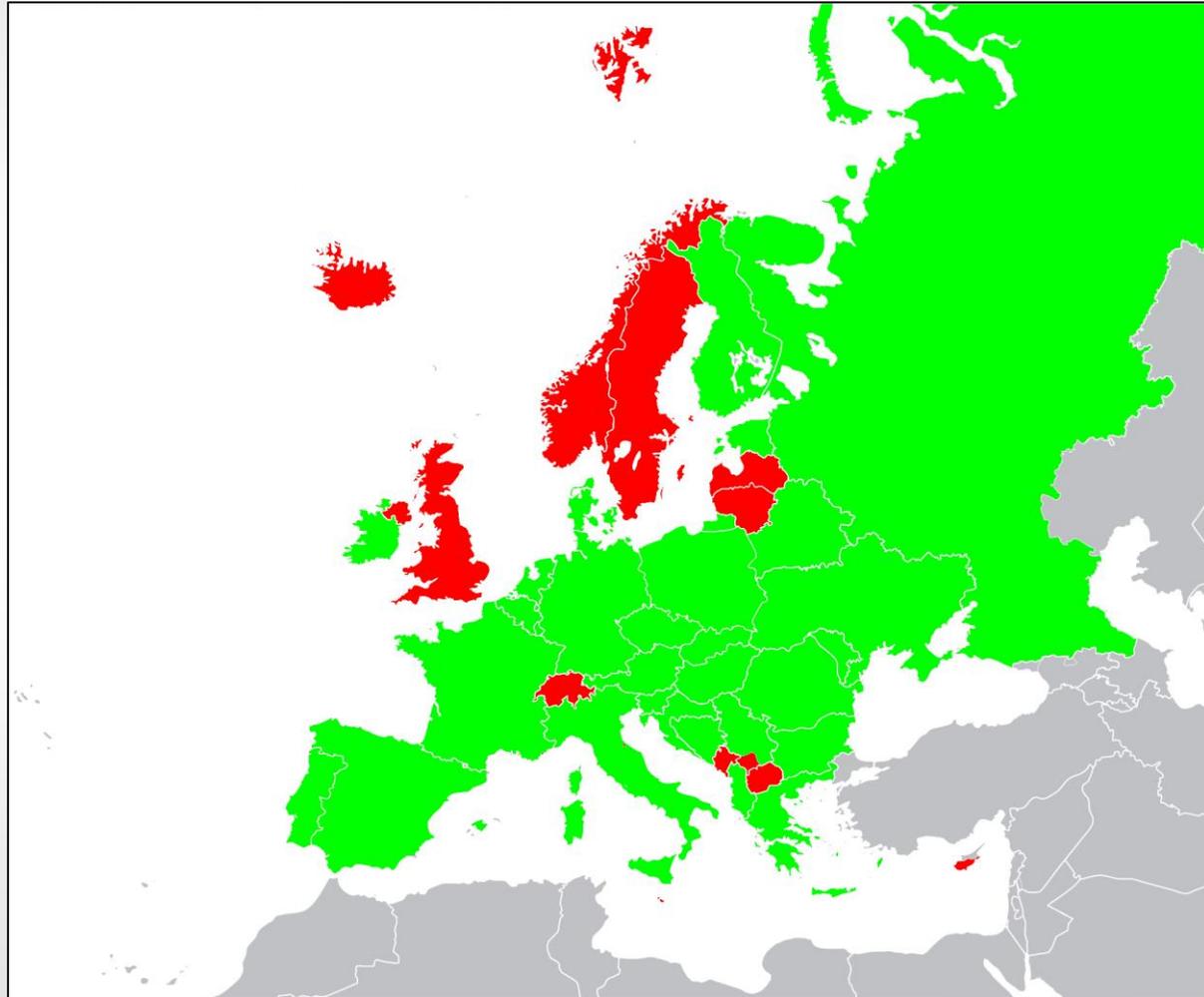
Did the need to ratify TRIPS trigger the creation of more *locally-relevant* IP systems?

- would a newly-independent, small economy follow suit?



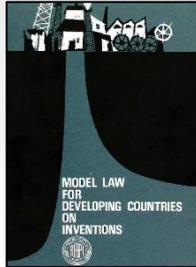


Utility model laws in Europe, 2021



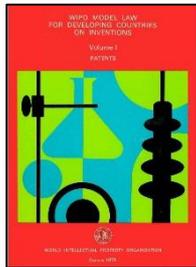


Model patent legislation does exist; many smaller countries have adopted *en bloc*.



BIRPI Model Law for Developing Countries on Inventions.
(Pub. No. 801(E), 1965, 126pp.)

https://www.wipo.int/edocs/pubdocs/en/wipo_pub_801.pdf



WIPO Model Law for Developing Countries on Inventions: Pub. No. 840(E) and 841(E).
Volume 1 - Patents (1979, 150pp.)
Volume 2 – includes Inventors' Certificates (1980, 104 pp.)

https://www.wipo.int/edocs/pubdocs/en/wipo_pub_840_vol_i.pdf

https://www.wipo.int/edocs/pubdocs/en/wipo_pub_841_vol_ii.pdf

Both sets of model law are ambiguous (at best) about recommendations for publication of unexamined applications – one of the cornerstones of modern patent documentation.



Establishing a Patent Office

- As a transition to full operation, a newly-independent country might request the former jurisdiction to continue to examine IPR on its behalf, and accept re-registered patents as valid on its territory
 - precedent from countries like Anguilla, Bermuda, Jersey, Sierra Leone, Eswatini *etc.*
- Similarly, the country might seek a validation agreement (cf. Morocco) or an extension state agreement (cf. Bosnia, Montenegro) with the EPO
 - although this route would still require some form of national IPO and national register to be in place.
- Art. 12 of the Paris Convention places an obligation on a signatory state to establish a “special industrial property service and a central office for the communication to the public of patents, utility models, industrial designs, and trademarks”.
 - i.e. the role of a patent office is not just to **grant** patents, but **publicise** them...



The public face of a patent office – “WIPO Recommendation on minimum contents of IPO websites” (2002)

Contents for *patent system users* include

- basic information about national IP rights,
- technical documents (e.g., guidelines, classification information),
- legal documents (e.g., treaties, laws),
- downloadable forms,
- fee schedules,
- annual reports (statistics) of the national office,
- links to other Intellectual Property Web sites,
- Intellectual Property information data,
- notices about changes in national intellectual property laws or administration,
- a News Section, or an Update Index, covering at least a six-month time period.

Contents for *new or non-users* include

- information about the procedures of the national office in the form of basic facts and frequently asked questions (FAQs);
- descriptions of products and services provided by the national office, including how to obtain them, their cost, and the media in which they are available; and
- references to sources for assistance or information, such as libraries and legal representatives or chambers.

“Other” information: **To the extent possible**, Intellectual Property Web sites should provide searchable databases or a link to databases relating to intellectual property documents of the IPO (such as legal status information). Links to other searchable databases should be included where appropriate.



WIPO Standards – what and why?

Timeline to the current CWS (Committee on WIPO Standards)



The common framework for industrial property information and documentation

1962 – Formation of Committee for International Cooperation in Information Retrieval among Examining Patent Offices (ICIREPAT) (eventually 20 national patent offices).

1968-1970 – ICIREPAT becomes a standing committee of the Paris Union, under BIRPI oversight; develops INID codes (= *ICIREPAT Numbers for the Identification of Data*) and standard Document Descriptions (DD) (later ST.9 and ST.16).

1975 – Some tasks under Strasbourg Union (classification), Paris Union (ICIREPAT) and PCT Union (international search) merged into a new Permanent Committee on Patent Information (PCPI), later PCIPI.

1998-2010 – PCIPI expands remit into electronic information as a SCIT working group, then split off to form CWS.



Key WIPO Standards on patent documentation

- the vast majority are *recommendations* or *guidelines* only

- *ST.3 Country codes*
- *ST.6 Numbering of publications*
- ST.9 INID codes
 - usually correspond to database search fields, but not always!
- *ST.13 Numbering of applications*
- ST.14 References cited
 - unfortunately, rarely used by patent drafters!
- *ST.16 Kind of Document codes*
- ST.17 Headings in patent gazettes
 - mostly phased-out with paper gazettes, but still of some value in smaller countries
- ST.26 XML presentation of nucleotide and amino acid sequence listings
 - not yet in force, ‘big-bang’ deferred until June 2022
- *ST.27 Exchange of legal status data*
- *ST.37 Authority file of published patent documents*
- *ST.50 Corrections, alterations and supplements relating to patent information*



ST.3 Country code – choosing a new code

Method 1: Initial letter of official country name in *English*, plus one letter

SCOTLAND:

SC, SO, ST, SL, SA, SN and SD are all taken.

Method 2: Initial letter of official country name in an *official language* of the country, plus one letter

ALBA: (Scots Gaelic)

AL taken, AA reserved; leaves **AB** possible.

Method 3: Initial letter of official country name in *French*, plus one letter

ÉCOSSE:

EC, ES and EE taken; leaves **EO** possible.

Not so easy, is it? – cf. HR (*Hrvatska* = Croatia) and DZ (*Al-dzāyir* = Algeria)



WIPO standards for application and publication numbers

- Application numbers (ST.13)
 - TT YYYY NNNNNNNNNN
 - e.g. 10-2016-000123456
 - tt = type of IP right (10 = patent, 11 = PCT national phase)
 - yyyy = year of *application* (not priority)
 - serial number not *required* to start at 1 for each new year.
- Publication numbers (ST.6) incorporating Country Codes (ST.3), and KD codes (ST.16)
 - CC TT YYYY NNNNNNNN-KD
 - e.g. AB 10/2018/0123456-A1
 - can re-use application number (e.g. CA, DE), or apply a new number with corresponding year of *publication*.



WIPO Standards may be implemented differently; depends upon local documentation practice.

- ST.16 Kind of Document codes para.9
 - “A one-digit numerical code following the letter code is to supplement, if necessary, the information contained in a letter code. *The numerical code must always be interpreted in conjunction with the two-letter code under WIPO Standard ST.3 and the above-mentioned letter code.*”
 - in other words...the Standard is only uniform at the LETTER level
 - each office (country code) defines its own LETTER+NUMBER combinations independently:
 - A, B, C = 1st , 2nd , 3rd publication level for patent applications
 - **BUT** A3 in one country ≠ A3 in a second country
 - e.g. EP-A3 (Separate publication of a European search report) ≠ ES-A3 (Patente de Introducción) ≠ FR-A3 (Demande de certificat d'utilité)



WIPO Standards may be implemented differently; depends upon local (legal) interpretation.

- ST.16 para 11 defines Group 2 codes (U, Y, Z) to be used “for utility model documents having a numbering series *other than the documents of Group 1* [patents]””
- Many countries therefore use
 - U or U1 if registered without examination
 - Y1 or Y2 if registered after some form of examination
- But beware! Some countries which number their utility models in the *same series* as their patents will use the Group 1 codes:
 - AR: -A4 (utility model application)
 - BE: -A6 or -A7 (6-year patent)
 - FR: -A3, followed by -B3 (*certificat d'utilité*)
 - HK: -A2 (short term patent)
 - IE: -A2, followed by -B2 (short term patent)
 - SI: -A2 (short term patent)



ST.27; Recommendation for the exchange of patent legal status data.

- Introduction, para. 2
 - “*This Standard aims at improving worldwide **availability, reliability and comparability** of patent legal status data.*”
- One of the longest and most complicated standards (outside of the IT area) yet produced; 13 pages to main Standard + 6 Annexes = 128 pages.
- Implementation (per current survey, which is not 100% accurate)
 - “completely implemented” = 2 (IL, TH !), “partly implemented” = 2 (DE, EA), “not implemented” = 6 (including EP, GB but known to be working towards this end), no comment by the remaining 35 authorities.
- The bad news
 - biggest hurdle to widespread adoption is ‘mapping’ current legal status processes and events to the ‘standard model’ of prosecution; patent offices are *very reluctant to accept the compromises* in terminology necessary to complete this task.
- The good news
 - smaller patent offices which use WIPO’s IPAS software suite for prosecution will be able to generate ST.27-compliant legal status data semi-automatically.



ST.37; Authority File of Published Patent Documents

- Simple concept – *“The primary purpose of the authority file ... is to allow other IPOs and other interested parties to assess the completeness of the available patent documentation.”*
- Also passed in 2020, but much bigger uptake (20/45 offices have completely implemented)
- Accompanied by publicly available portal to data files
 - https://www.wipo.int/standards/en/authority_file.html
 - some offices deposit files at WIPO, others provide a link to their own server



Example definitions in an ST.37 authority file (EPO)

EP authority file exception code

Entries in the EP authority file that do not feature an exception code are available on the European publication server as "regular" entries and are available in the ST.37 and WIPO ST.36 XML format. All other exception codes, which have the following meanings:

Exception code	Meaning
E	Not reported
S	Supplementary
W	Withdrawals
R	Reissued publications
N	Not used publication numbers
M	Missing publication documents
D	Deletions after publication
U	Unknown publication numbers
C	Defective publication documents

More information on data coverage, document kind codes and exception codes can be found in [the definition file](#) of the EP authority file.

N

Not used publication numbers

M

Missing publication documents

D

Deletions after publication

Resource for all users to identify (e.g.) gaps in number sequence, examples of rare KD codes *etc.*



ST.50; Corrections, alterations and supplements relating to patent information

- PDG fought long and hard to get this one through the system
 - designed to create a uniform system of identifying publications (in all media) which are:
 - replacing previously-published erroneous information,
 - deleting spurious information,
 - adding erroneously omitted information,
 - updating or replacing initially correct information,
 - providing new information in addition to that previously published.

Corrections

Alterations

Supplements



Implementation of ST.50 can vary, depending upon previous practice.

- The Standard only reserves the suffix '8' and '9' from the ST.16 (KD code) standard but **allows each IPO** to decide numbering system usage:
 - USPTO practice:
 - First publication US 2008/0261832-A1
 - Correction US 2012/0329677-A9 (*NOT* 2008/0261832-A9)
 - EPO practice:
 - First publication EP 3783014-A1 (2021.02)
 - Correction EP 3783014-A9 (2021.05)
 - AU practice vs. EP practice
 - EP 1934101-B8 = 1 page (new front page)
 - AU 2013200572-B8 = 27 pages (new front page + all old pages)



Why use WIPO Standards?

- Adoption of many Standards would help to ‘future-proof’ the documentation practices of any new patent office
 - cf. China had to change numbering systems 5 times in 25 years before adopting a (partly) WIPO-compliant format.
- More Standards are now geared to electronic-originated patent information and ease of exchange
- Most Standards are fairly short and the objectives are usually easy to understand, but widespread adoption requires a KISS approach
 - including input from industry users as well as IPOs/lawyers
 - CEPIUG is entitled to send participants to CWS meetings



Finally, the bigger picture: economic and trade implications of ‘starting anew’

- Taxation – “Patent Box” legislation
 - some countries have legislation allowing for a lower rate of corporation tax on profits from patented inventions
 - if a newly-independent country failed to maintain this provision, would it deter foreign investment, sales of patented products and/or company registrations?
- Revenue – annuity payments
 - would a newly-independent country continue to receive some of the fees paid for maintenance of regional patent rights (assuming that it continued to recognise those rights).
- Uncertainty
 - questions about ownership and/or validity of existing IP rights (especially those owned by foreign applicants) could be a major disincentive for foreign investment (cf. Volkseigener Betrieb in DDR)

