

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

PCT COMMITTEE FOR TECHNICAL COOPERATION

Twenty-Second Session
Geneva, September 25 to October 3, 2006

ADVICE TO THE ASSEMBLY OF THE PCT UNION ON THE PROPOSED
APPOINTMENT OF THE NORDIC PATENT INSTITUTE AS AN INTERNATIONAL
SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

Document prepared by the International Bureau

1. The appointment of International Searching Authorities (ISAs) and International Preliminary Examining Authorities (IPEAs) under the Patent Cooperation Treaty (PCT) is a matter for the Assembly of the PCT Union and is governed by Articles 16 and 32(3) of the PCT.
2. In a letter dated July 7, 2006, the text of which appears in the Appendix, the Director General of the Danish Patent and Trademark Office, the Director General of the Icelandic Patent Office and the Director General of the Norwegian Patent Office have expressed the wish that the Nordic Patent Institute (NPI) be appointed as an ISA and IPEA.
3. Articles 16(3)(e) and 32(3) of the PCT require that, before the Assembly makes a decision on such an appointment, it shall seek the advice of the PCT Committee for Technical Cooperation. The Committee's advice, which is sought by the present document, will be submitted to the Assembly during its 35th session, which is being held during the same period as the session of the Committee.
4. *The Committee is invited to give its advice on this matter.*

[Appendix follows]

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APPENDIX

World Intellectual Property Organization
Attn.: Kamil Idris, Director General
34 Chemin des Colombettes
P.O. Box 18
CH-1211 Geneva 20
Switzerland

Taastrup, July 7, 2006

Re.: Appointment of Nordic Patent Institute as International Authority under the PCT

Dear Dr. Idris,

We hereby refer back to our letter of 5 July 2006, in which we informed you that the governments of Denmark, Iceland and Norway have established an intergovernmental organisation, Nordic Patent Institute (“NPI”), which shall act as a formal instrument for cooperation in the patent field between these countries.

In our above letter, we also informed you that the governments of Denmark, Iceland and Norway have decided to seek approval for status of NPI as an International Searching Authority (“ISA”) and International Preliminary Examining Authority (“IPEA”) under the Patent Cooperation Treaty (“PCT”) from the appropriate bodies of the World Intellectual Property Organization. Consequently, we would request that this matter be put on the agenda of the PCT Assembly during the annual WIPO Assemblies in September 2006 in order to enable NPI to start operation as an ISA and IPEA as soon as possible.

Patent protection on a global scale has become increasingly important in the knowledge-based society. Consequently, the need for an efficient patent system offering high quality products and services has also increased. The PCT system offers an excellent platform for such a global system, and we have noted with satisfaction the great success of the PCT system, although we are also concerned about the ensuing consequences on workload and backlogs at the PCT authorities.

It is our firm belief that an efficient and successful global patent system must start at the national level, i.e. by offering the best possible national framework conditions for protection of innovations. Access to high quality local IP competencies at the national patent offices will stimulate national innovation and generate high quality applications which will proceed to the international routes.

NPI will exploit the synergy of drawing upon the consolidated resources of the participating offices. This will enable NPI to meet the criteria for becoming an ISA and IPEA and to better offer products and services of a quality which meets international standards. The increased competencies and efficiency which is foreseen as a result of the cooperation will also improve quality and efficiency of work carried out by the individual offices.

Users in all the participating states therefore fully support the establishment of NPI and the intention of seeking status as ISA and IPEA for NPI. Furthermore, the addition of another PCT authority is seen as a contribution to adding further competent resources to those presently available for coping with the increasing workload within the PCT system.

We would also like to draw the attention to the fact, that the total number of PCT applications originating from Denmark, Iceland and Norway is quite high, in particular considering the number of inhabitants of these countries.

We kindly request that this matter be put before the Committee of Technical Cooperation (PCT/CTC) in order to obtain the advice of the Committee as referred to in Article 16(3)(e) of the PCT and we look forward to your favourable consideration and cooperation.

Yours sincerely,

Jesper Kongstad	Ásta Valdimarsdóttir	Jørgen Smith
Director General Danish Patent and Trademark Office	Director General Icelandic Patent Office	Director General Norwegian Patent Office

Annexes: 1. Presentation of NPI
2. Examination resources of NPI
3. Search Documentation used by NPI

ANNEX 1

PRESENTATION OF THE NORDIC PATENT INSTITUTE

1. *Aim of the Nordic Patent Institute (NPI)*

Statistical evidence shows a clear correlation between the innovative performance of a country and the quality of the local framework conditions for protection of innovation in that country. The NPI cooperation offers a concept for cooperation which aims at maintaining and improving such framework conditions in the participating countries at the same time as it offers a contribution to improving the efficiency and coherence of the patent system on a European and global level.

The NPI cooperation shall contribute to stimulating Nordic companies, in particular small and medium-sized enterprises, to innovation and economic growth. This shall be achieved by maintaining and further developing the national patent offices as competence centres for Industrial Property Rights in the individual countries, capable of offering customised services of a quality and efficiency which is competitive by international standards.

Another objective of NPI is to contribute positively to the development of a coherent and efficient European patent system based on the European Patent Convention and on cooperation between the European Patent Office and the national patent offices, and to offer Nordic users the best possible platform for taking advantage of such European cooperation.

Still another objective of NPI is to support the global development and usefulness of the PCT system by adding further competent resources to those presently available. This may in a long-term perspective pave the way for a global system based on re-utilisation of search work and elements of mutual recognition.

2. *Principles of NPI*

Tasks of NPI

The NPI cooperation shall comprise the following tasks:

- PCT applications (ISA/IPEA) and related work such as International Type Searches.
- Contract work, i.e. subcontracted work from other patent authorities and search services for private customers (large-scale contracts).

Organisation of NPI

The cooperation shall make the aggregated resources of the patent offices of the participating states available for performing all NPI tasks. Apart from a director, NPI will not have any staff of its own and will draw, upon payment, on the experts of the national patent offices. For search and substantive examination, the resources will be the examiners of the Danish and Norwegian offices, since the Icelandic office has chosen not to perform search and examination by its own staff. When performing tasks on behalf of NPI, national patent office staff will be under full instruction from NPI.

Applicants will not have the option of selecting the national office which shall perform the work on behalf of NPI. NPI will be responsible for distributing search and examination tasks between the examiners of any of the national offices in such a way that work will be performed by an examiner having the necessary competencies. For PCT applications, the national office used by the applicant when filing the application will, whenever possible, be used for carrying out the search and preliminary examination.

NPI will have an International Secretariat which will be the interface to all external parties, including the International Bureau of WIPO and the Receiving Offices of the national offices. The tasks of the International Secretariat will be performed by the staff of the national Receiving Offices acting under full instruction of NPI.

NPI is established by an agreement between the governments of the participating states. It has the status of an intergovernmental organisation and has full powers as an independent legal entity including the powers to enter into agreements with other parties and represent the member states in matters concerning its role as PCT authority. The seat is Taastrup, Denmark.

NPI will have a Head responsible for its management and will be supervised by a Board of Directors comprising members of each national office.

Use of NPI as a PCT authority will be open to applicants and residents of Denmark, Norway and Iceland who, however, will still have the option of choosing the Swedish office or EPO as PCT authority.

Quality Assurance

NPI will establish a Quality Assurance system which will be certified according to ISO 9001. The system will cover all services offered by NPI.

The participating national offices already have well established quality assurance systems covering the national patent granting procedures. The Danish system is ISO certified and the Norwegian one is expected to be so in 2007. The national systems comply with the provisions on quality assurance in the PCT International Search and Preliminary Examination Guidelines (PCT/GL/ISPE).

The NPI quality assurance system will be based on the national systems but will obviously have to be extended to cover the full PCT procedure. The quality standards and practices will be harmonised for all PCT work and brought in full compliance with the standards and practices established by the PCT and applied at the EPO. The Danish, Norwegian and Icelandic offices have for many years cooperated on harmonisation of patent practice and bench marking of the patent granting procedure including search and examination procedures and tools. This cooperation will be further strengthened as part of the NPI cooperation.

The competence and number of examiners is an important aspect of quality. The PCT minimum requirements are fully met in this respect. This is dealt with separately in Annex 2.

Another aspect of quality is the access to the PCT minimum documentation. To the best of our knowledge, these minimum requirements are also met by NPI. Any possible gaps that might be identified will be rectified before NPI will start operation as a PCT authority. Further details can be found in Annex 3.

ANNEX 2

EXAMINATION RESOURCES OF THE NORDIC PATENT INSTITUTE

1. Introduction

Search and Preliminary examination of PCT applications will be carried out by staff of the Danish or Norwegian patent offices on behalf of NPI. Information contained in the present Annex concerning examiner resources will therefore generally refer to the examiner resources of the Danish and Norwegian offices. As can be seen, however, there is a very significant degree of correspondence and similarities which is a consequence of many years of harmonisation and exchange of experience of best practice.

The Danish and Norwegian offices have for many years pursued a strategy of performing search and examination of a quality which matches international standards, and in particular the quality of work at the EPO. In this way, applicants can use the reports in national first filings as a reliable basis for deciding on the prospective of their invention and the international patenting strategy for the application. For the same reason, it has also been a top priority to issue the first official action (including a search report and an assessment of patentability) in good time before the end of the priority year.

Consequently, the patent offices have a long-standing tradition of ensuring highly competent and motivated staff as well as the best possible search and examination tools, comprehensive search material and general quality assurance.

2. Examiner Resources

Presently, the Danish Patent Office has approximately 80 examiners and plans for recruitment of 12 further examiners in the autumn of 2006 while the Norwegian Patent office has approximately 75 examiners. Most examiners of the two offices are employed on a full-time or almost full-time basis and are predominantly occupied with search and examination and related tasks such as training. The examiners have a university degree in technology or natural science and in some cases further postgraduate degrees such as DSc, PhD or equivalent.

The examining divisions of both offices are roughly similar and comprise a total of approximately 30 examiners in each of the divisions Electricity & Physics, Machinery, Biotechnology, and Organic Chemistry, a few less in Industrial Chemistry, and approximately 15 in each of the divisions Construction and Foodstuff & Healthcare.

3. Competence of Examiners

The examiners are all experts in their own branch of technology and allocated to specific technical areas. A large number of the examiners also have many years of experience in the patent field. The density of examiner competencies within the various technical disciplines obviously reflects the structure of national industry. In general, however, all technical areas are covered in each office, and taken together the two offices have a more than adequate coverage of all technical fields.

All examiners have, in addition to their ability to understand Danish, Norwegian and Swedish, excellent knowledge of English and good knowledge of German and French. Some also have knowledge of Spanish, Russian, Turkish and Persian.

4. Processing of Patent Applications and other Work

The Norwegian Patent Office receives about 1200 first filings per year and the Danish Patent Office about 2000. Close to fifty percent of the Danish applications, however, are filed in order to obtain a priority date and are not carried on to full examination. Patent protection in Denmark can also be obtained through a European patent. The Norwegian government has initiated the process towards Norwegian ratification of the European Patent Convention.

The high number of first filings at the Danish Patent Office despite the possibility of using the EPO signifies a trust in the quality of services delivered by the Danish office. It also reflects the importance of having access to highly competent national patent offices. If Norway ratifies the EPC, it will still be a priority for the Norwegian Patent Office to maintain high-quality search and examination competencies within all technical areas.

The Danish Patent Office also carries out a total of approximately 1100 searches and examinations per year for the patent offices of Great Britain, Turkey, Singapore and Iceland. Furthermore, it carries out a considerable number of searches for private customers. Similar kinds of activities will be taken up by NPI and will further strengthen the ability of NPI to ensure a broad expert coverage of all technical areas.

5. Training and Job Description

New examiners are trained and supervised by a senior examiner for about 18 months. The senior examiner plays the role of a personal tutor and is responsible for all decisions by the new examiner in the processing of an application. During the apprentice time, the new examiner takes part in in-house training programmes that gives a deep insight in the patent processing procedure including knowledge of the various legal aspects of patent law and the capability of performing searches. The training programmes also give the new examiner an understanding of the patent system in a wider perspective such as the role of patents as an economical tool for enhancing innovation and as a strategic business tool for companies.

All examiners are kept updated regarding changes in legislation, practice, and procedures. There are also regular training activities on improved search tools etc.

Examiners will only be authorised to take decisions on their own after a thorough verification of their competencies and skills.

An examiner, who has been authorised to make decisions, carries out search and examination of patent applications without detailed supervision. However, decisions on refusal of grant, in opposition procedures, and in certain other well-defined procedures must always be discussed with and approved by a senior examiner.

Examiners may be promoted through several standardised steps on a scale of competencies. Before any promotion, the examiner's competencies are tested against the required targets.

Examiners are invited to participate in seminars and courses in their respective technological fields in order to maintain and update their competencies at a high level.

6. *Quality Control*

The general principles of the forthcoming NPI Quality Assurance System are explained in Annex 1.

The existing national quality assurance systems in the Danish and Norwegian offices are ISO certified (Denmark) or will be so soon (Norway). Both offices have extensive manuals for all parts of the patent granting process, including in particular guidelines on search, examination and communication with the applicant. There are permanent working groups specifically dedicated to improvement of tools and procedures, quality control, and initiation of corrective action in response to feedback from the quality control. These features will be further strengthened in future with the aim of harmonising tools and procedures in the offices. The objective is to ensure that search and examination of any application will lead to the same result irrespective of which office performed the task.

As a further step of harmonisation, the quality standards, practice, tools and (where appropriate) procedures will be harmonised with those applied at the EPO.

7. *Examination Methods and Tools*

Novelty searches are mainly conducted online by using the same databases and search systems as used by the EPO. The most important databases are EPODOS, WPI, PAJ and INSPEC accessed via the EPOQUE search tool. Other important document databases are accessed for instance via Dialog and STN. Examiners also use full text databases in various languages and other databases containing articles and other non-patent literature. IT tools, including work stations, used by the examiners are of a high and modern standard.

The collection of patent documents and other publications in paper form is very comprehensive and is used whenever appropriate.

Annex 3 gives detailed information on the document files and databases available to examiners for search purposes.

8. *Electronic Filing and Processing*

Both the Danish and Norwegian patent offices are now able to accept electronic filing of patent applications. This also applies to filing of PCT applications.

ANNEX 3

SEARCH DOCUMENTATION USED BY NPI

1. PCT Minimum Documentation

PCT authorities must have access to the minimum documentation which comprises patent publications since 1920 on paper, microfilm, electronic carriers or databases as well as certain non-patent literature.

Patent Documents

According to PCT Rule 34.1, the minimum documentation comprises the following patent publications, published patent applications and granted patents:

- (i) the patents issued in and after 1920 by France, the former Reichspatentamt of Germany, Japan, the former Soviet Union, Switzerland (in the French and German language only), the United Kingdom, and the United States of America,
- (ii) the patents issued by the Federal Republic of Germany and the Russian Federation,
- (iii) the patent applications, if any, published in and after 1920 in the countries referred to in items (i) and (ii),
- (iv) the inventors' certificates issued by the former Soviet Union,
- (v) the utility certificates issued by, and the published applications for utility certificates of, France,
- (vi) such patents issued by, and such patent applications published in, any other country after 1920 as are in the English, French, German or Spanish language and in which no priority is claimed, provided that the national Office of the interested country sorts out these documents and places them at the disposal of each International Searching Authority,
- (vii) the published international (PCT) applications, the published regional applications for patents and inventors' certificates, and the published regional patents and inventors' certificates.

According to PCT Rule 34.1(e), NPI as a PCT Authority will only be requested to have access to patent documents of Japan, the Russian Federation and the former Soviet Union as well as Spanish language patent documents to the extent that English language abstracts of these documents are generally available.

Non-patent Literature

The PCT minimum documentation also covers such other items of non-patent literature which are agreed on by the international research organs and which are published in a register kept by the International Bureau of the World Intellectual Property Organization. An updated list of currently agreed non-patent literature is available at the WIPO website.

2. Search Files Used by NPI

Search Methods and Tools

Searches are primarily conducted electronically by both the Danish and Norwegian offices and generally by using the same databases and search tools and systems as those used by the European Patent Office.

Searches are conducted in paper files when necessary, which in particular is the case for searches in Danish and Norwegian patent literature. The paper based search files of both the Danish and Norwegian office are very comprehensive and organised by classification systems in a way suitable for searching.

Use of EPOQUE

The EPOQUE search tool gives access to the following patent literature:

Country	Access to		
	BNS	EPOQUE-Full-text	EPODOC
Switzerland, CH	All documents from: CH1 (A 1888 1101)	French, German and Italian Oldest document from 1900	All documents from: CH1 (A 1888 1101)
Germany, DE	Documents from: DE1 (C 1877 0702) DE1427159U (U 1933 0203)	German full-text since 1920 . Oldest document: DE318791 (C 1920 0207)	Documents from: DE1 (C 1877 0702) DE1427159U (U 1933 0203)
France, FR	Documents from: FR1983E (E 1900 0101) FR2000029 (A1 1969 0829) (Utility model)	French full-text since 1900 . Oldest document: FR1983E (E 1900 0101)	Documents. From: FR1983E (E 1900 0101)
United Kingdom, GB	Documents from: GB189503951 (A 1896 0330) GB20000136 (B 1979)	English full-text since: GB189503951 (A 1896 0330)	Documents from: GB189300739 (A 1893 101)
Japan, JP	JP documents from 1970	Not available	Documents from: JP40000046Y1 (Y1 1965 0106)
Soviet Union, SU Russia, RU	SU documents from 1972	Not available	SU documents from: SU115325 (A1 1972 1207)
USA, US	All documents from: USX000001 (A 1790 0731)	All documents from: US1 (A 1836 0713)	All documents from: US1 (A 1836 0713)

Other On-line Tools

For searching of patent literature use is made of EPOQUE and WPI together with certain full text databases. For non-patent literature, use is made of INSPEC, COMPENDEX, MEDLINE, ELSEVIER and IEEE among others via EPOQUE. Additionally, CHEMICAL ABSTRACT and BIOSIS, accessed via STN, are used for searches in chemistry, pharmaceuticals and other special technologies. STN, Dialog and QUESTEL are also used for accessing other databases as appropriate. Various useful internet sites, for instance concerning additional documentation and classification systems are available in a systematic way via a special "Patent Port" on the intranet.

Paper Based Search Files of the Danish Patent Office

Country	Patent number	Document code	Status of filing
Germany, DE	1 – 976.850		
	1800001 – 1000001 – 3159800	A B	Stopped 20001231
	4201806 –	C1	Stopped 20001231
Denmark, DK	1 – 110252		
	111001 –	A, B	Going on
Finland, FI	19401 – 40000		
	40001 –	B	Stopped 20031231
France, FR	317501 – 1605572		
	2583849 – 1 – 96689	A E	Stopped 20001231
	1 – 8496	M	
United Kingdom, GB	136850 – 1605400	Abridgement cards	
	2000001 – 2297886	A (Only frontpages)	Stopped 19960814
Norway, NO	1 – 115000		
	115001 – 180817	B	Going on
	300001 –	B	
Sweden, SE	1 – 228000		
	228001 – 470602	B	Stopped 20031231
	500001 –	C	

Documents for which filing of paper copies has been discontinued, are available for search electronically.

Paper Based Search Files of the Norwegian Patent Office

Country	Class (IPC) / Number collection	Last publ. date.	Publication	Collection
AT AT (A-F, H) AT (G) AT	Number 1 - 326.892		Patent	Microfilm
	Class 326.852 - 412.317	2004.12.27	Patent	Paper
	Class 326.852 - 403.410	1998.02.25	Patent	Paper
	Number 412.318 - →		Patent	CD-ROM
AU	Number 1/1926 - 4.951/1936			Microfilm
	Number 100.001-296.236			
	Number 400.001-496.937			
	Number 7/1999 - →			CD-ROM
CA	Number 10.829 - 1.340.137		Patent	Microfiche
	Number 2.000.000 - →		Patent	Microfiche
	Number 1999/1 - →		Patent appl.	CD-ROM
	Number 2000/201 - →		Patent	CD-ROM
CH CH (A-H) CH (G) CH	Number 1 - 623.442		Patent	Microfilm
	Class 335.501 - 467.000	2005.12.31	Patent	Paper
	Class 335.501 - 688.755	1998.02.27	Patent	Paper
	Class 683.055 - →			CD – ROM

DE	Number 1 - 1.800.000		Patent	Microfilm
DE	Class 1- 1.800.000			Paper
DE	Class			
DE (A-F)	Class	2005.12.31	Patent/appl.	Paper
DE (C)	Class	1999.04.29	Patent/appl.	Paper
DE (C02, C05F)	Class	2005.12.31	Patent/appl.	Paper
C10)	Class	2005.12.31	Patent/appl.	Paper
DE (G)	Class	1998.12.24	Patent/appl.	Paper
DE (H)	Class	1998.12.24	Patent/appl.	Paper
DE	Number 1999/001 - →			CD-ROM
DK	Class 1 - 110.250		Patent/abstr	Paper
	Class 111.000 - 166.396		Patent/abstr	Paper
	Class 166.397 - →		Patent/abstr.	Paper
EPO (A-F)	Class 1 - 1.610.060	2005.12.31	Appl.	Paper
EPO (C)	Class 1 - 824.300	1998.02.18	Appl.	Paper
(C02 and C05F)	Class 1 - 888.709	1999.01.07	Appl.	Paper
(C10)	Class 1 - 882.386	2005.12.31	Appl.	Paper
EPO (G-H)	Class 1 - 824.300	1998.12.09	Appl.	Paper
EPO (A3)	Class 16.414 - 74.347	1999.09.08		Paper
FR	Number 317.502 - 1.605.474		Patent	Microfilm
	Class 855.000 - 1.606.441		Patent	Paper
	Number 1 - 96.628		Add. Patent	Microfilm
	Class 50.000 - 96.646		Add. Patent	Paper
	Class 2.055.001 - 2.739.246	1997.03.28	Abstr.	Paper
	Class 2.000.001 - 2.734.169		Patent/appl.	Microfilm
	Class 1 - 8.483		Pharm.patent	Paper
	Number 1 - 6.190		Pharm.patent	Microfilm
	Number 2.663.812 - →		Appl.	CD-ROM
GB	Number 1/1900 - 19.225/1915			Microfilm/Paper
GB	Number 100.001 - 524.678			Microfilm/Paper
GB	Number 572.500 - 945.608			Microfilm/Paper
GB	Number 945.600 - 2.415.591			
GB (A-F)	Class	2005.12.31	Appl.	
GB (G)	Class 945.600 - 2.366.710	2005.12.31		
GB (H)	Class 945.600 - 2.366.710	2002.03.13		
		2002.03.13		
JP	1976-		PAJ. abstr.	CD-ROM
	Number 1994/06 - 000001			CD-ROM
NO	Number 1- 313.930			Paper
NO (A-H)	Class 1- 313.930			Paper
	Number 313.931 - →			PDF
SU	Number 307.690 - 1.839.717			
RU	Number 1999/2 - →			CD-ROM
SE	Class 1 - →		Patent	Paper
	Class 1969 - →		Abstr.	Paper
WO – PCT	Class 1996/18.287	1996.06.13	Appl.	Paper
WO – PCT	Number 00/74463 - →		Appl.	CD-ROM

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US	Number 574.369 - 2.469.461		Patent.	Microfilm
	Number 1.014.631 - 5.613.244		Patent	Paper
US (A-F)	Class 4.300.000 - →	2005.12.31	Patent	Paper
US (C)	Class 4.300.000 - 5.699.554	1997.12.16	Patent	Paper
(C02, C05F)	Class 4.300.000 - →	2005.12.31	Patent	Paper
(C10)	Class 4.300.000 - →	2005.12.31	Patent	Paper
US (G)	Class 4.300.000 - 5.613.244	1997.03.18	Patent	Paper
US (H)	Class 4.300.000 - 5.713.075	1998.01.27	Patent	Paper
US	Class (US) 10.000 - 30.799	2005.12.31	RE Patent	Paper
	Class (IPC) 30.800 - →	2005.12.31	RE Patent	Paper

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