



## DISCUSSION ON PATENT QUALITY – NOTE FROM THE GERMAN PATENT AND TRADE MARK OFFICE (DPMA)

### I. INTRODUCTION

1. At the sixteenth session of the WIPO Standing Committee on the Law of Patents the delegations of Canada and the United Kingdom proposed in SCP/16/5 a "Work Program on Quality of Patents".
2. We consider this topic to be an important and essential one for the further development of the existing patent systems worldwide. The constant increase of patent applications has led to a growing number of pending applications awaiting a final decision. There is no legal certainty in respect of these applications. This situation which is called "backlog" has prompted various joint international efforts of patent offices in work-sharing or mutual recognition of work results like the Utilisation Implementation Project (UIP) within the European Patent Network (EPN) or the so-called Patent Prosecution Highways (PPH), i.e. bilateral agreements of a number of patent offices.
3. In this situation "patent quality" becomes a crucial factor of the system. This in turn leads to the legitimate question what is meant by the term "patent quality". There is probably no single helpful definition of a concept with such a wide scope, applying to procedures and products alike, and to formalities as well as to content. The scope of the term "patent quality" begins with incoming applications and may end with the validity of patents being contested in litigation before the courts.
4. On a general note one may define quality as "the extent to which patent systems comply with their patentability conditions in a transparent way"<sup>1</sup>. We strongly support constructive discussions in order to get a clear picture of the respective perceptions of quality and a mutual understanding of the work of the Member States done in this field.

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<sup>1</sup> Bruno van Pottelsberghe de la Potterie: „The Quality Factor in Patent Systems“. Vienna, PATSTAT Conference 2010



## II. CRITERIA OF PATENT QUALITY - DPMA APPROACH

5. In order to gain a clearer understanding of what patent quality means we suggest to use the following criteria for determining patent quality ("DPMA Criteria of Patent Quality").
6. Patent quality is determined by three components which mirror the phases of the life of a patent and take into account the perspectives A) of the applicant, B) of the patent office and C) of the use of the patent after grant. Depending on the perspective, the term "patent quality" will be perceived differently. These components can be further subdivided as follows:

### **A) Patent quality from the applicant's perspective**

#### *(1) Quality of the invention:*

Does the invention, with respect to the solution of the objective problem, constitute a very small improvement in a known technical subject-matter, in the sense of an incremental improvement (low degree of inventiveness), or the solution of a previously unsolved problem (high degree of inventiveness)?

#### *(2) Quality of drafting the patent application:*

Is the invention clearly described in the application?

Deficiencies in this area may be due to the following:

- 2.1. the applicant has insufficient knowledge of prior art in the technological field to which his invention relates;
- 2.2. the applicant is not sufficiently skilled to appropriately describe a technical or scientific issue;
- 2.3. the applicant submits a poor translation into the application language;
- 2.4. the applicant wishes to maintain ambiguity about the core issue of the invention and therefore hides the true invention within the application.



## **B) Patent quality from the office's perspective**

(3) *Quality of search for the state of the art:*

Does the examiner identify the closest prior art? What search tools and options (hardware and software) are available?

(4) *Quality of analysis of search results:*

Is prior art correctly evaluated in relation to the application?

(5) *Quality of the application of legal provisions:*

Are the applicable legal provisions observed and applied appropriately ?

(6) *Quality of cooperation of the applicant and the examiner:*

Does the examiner offer proposals e.g. on the wording or drafting of claims? Are decisions reasoned and transparent? Do both sides work together in a constructive manner?

(7) *Quality of legal provisions:*

Are the legal provisions understandable and available to all parties concerned?

## **C) Patent quality from the use perspective**

(8) *Quality of legal validity:*

Can a granted patent be successfully enforced or defended in court?

(9) *Quality in terms of the economic value of a patent:*

Is the patent associated with economic added value for the patent owner? Is the patent useful for the economy and for the society?



### III. THE VALUE OF PATENT QUALITY

7. We think it is adequate to focus particularly on patent quality from the office's perspective as previously laid out since it is encompassed by the office's competence and can be directly influenced by the office itself and the respective government. The core elements of the patent system, from an office's perspective, are search and grant.
8. Patent protection can only be provided for inventions that are innovative, the disclosure of which will enrich the present state of the art beyond the obvious. Patents for trivial developments or inventions where the technical teaching is not sufficiently disclosed are the result of low quality work of a patent office. Such patents would impede rather than foster new developments. An inflation of industrial property rights would lead to increased research costs and obstruct competition unnecessarily. At an advanced stage it could even lead to a collapse of the entire protection system.
9. Since 2006 the European Patent Network (EPN) has played an important role in intensifying the discussion on patent quality with the active participation of the German office. The development of a European Quality System (EQS) provides a basis for continually improving the quality of products (such as searches and patents) of the participating offices of the European member states. EQS comprises the following two parts:
  - (a) The Standard for a European Quality Management System (EQMS) deals with the quality of processes in patent offices, for instance search and examination procedures. Its main requirements are largely based on the international quality standard ISO 9001.
  - (b) The Product Quality Standards (PQS) define the minimum requirements for classifying applications, drafting reports on search results, written communications, as well as requirements for refusals and patent grants.



We think that the information about the work done under the EQS could be helpful for an in-depth discussion within the WIPO Standing Committee on the Law of Patents as well.

10. A quality management system alone does not necessarily lead to good work results. In our view, a high quality patent necessitates compliance with the individual steps of the second component, i.e. patent quality from the office's perspective. With respect to legal certainty it is particularly advisable to carry out a thorough search for the closest state of the art. It is equally important to reach the correct decision as to whether the subject matter of an application fulfils the requirements of patentability with a particular focus on the question whether the subject matter was obvious to a person skilled in the art. This work must be carried out very carefully and takes time to produce high-quality results. Considering the complexity of the tasks we feel that it would not be appropriate to unduly regulate and quantify the workflow of the examiners.
11. Besides the legal requirements patent quality is influenced by various other key issues within the patenting process which are not readily calculable. From our viewpoint the following aspects are essential:
  - (a) a thorough scientific and technological prior education and knowledge of patent examiners that enables them to carry out high-quality patent examination;
  - (b) a careful selection of staff members and their sustainable training, since well qualified staff is the key to high-quality work;
  - (c) a high degree of independence and personal responsibility of patent examiners which are prerequisites of good work results.

We therefore appreciate a constructive debate on patent quality and encourage the Member States to participate in it.