

[English translation by WIPO]

Circular C.8076: comments submitted by the National Institute of Industrial Property of France on the proposals for a work program on the quality of patents (documents SCP/17/8 and SCP/17/10)

I - Points on the work program proposed by the United Kingdom and Canada (document SCP/17/8) :

The National Institute of Industrial Property of France (INPI) wishes to reiterate its support for the revised work program on the quality of patents proposed by the United Kingdom and Canada. This document offers more information on what is understood by the phrase “quality of patents” and provides a non-exhaustive list of related activities.

From the INPI standpoint, the concept of “quality of patents” covers, at one and the same time, the quality of applications filed, the quality of the infrastructure and internal office procedures, and also the quality of results, since a system that manages the quality of patent procedures alone is not enough to ensure that national patent offices grant high quality patents. The application of patent criteria, such as novelty and inventive step, are important elements to consider when evaluating the quality of patents. In fact, it is important not to lose sight of the interdependence between “managing procedural quality” and implementing legal patentability requirements in order to produce a high quality final product.

In terms of the first component of the proposal, “technical infrastructure development”, the quality of search and examination reports is directly linked to the availability of information sources and access to appropriate search documentation. It is therefore important to work on the tools and search materials available to examiners.

Turning to the second component, “information access and exchange on the quality of patents”, the Committee could draw on the European Patent Network (EPN)’s work on the quality of patents. The EPN system is based on two key areas: the quality of search and examination procedures in place in national offices, and the quality standards for “products” that have to meet legal patentability conditions. Moreover, INPI supports the proposal by the United Kingdom to develop a questionnaire to gather information on how quality of patents is handled in national offices, as well as the ways in which offices encourage applicants to file high quality patent applications.

Finally, INPI believes that the third component of the work program, “process improvement”, should include a reference to improving the quality of searches by analyzing prior art and assessing the obviousness, or not, of an invention to a person skilled in the art. Further to these points, we support the proposal by Spain to launch a series of comparative studies on the concept of inventive step (focusing particularly on definitions of prior art and of a person skilled in the art) and methods for evaluating inventive step.

II – Points on the work program proposed by the United States (document SCP/17/10) :

In the view of INPI, the proposed work program put forward by the United States could complement the second component of the program proposed by the United Kingdom and Canada. The proposed questionnaire on how quality of patents is handled in national offices could include questions on the national goals of a patenting system that produces high quality patents and the specific metrics for measuring quality employed in patent offices.

III – The contribution of INPI to the discussion on quality of patents:

With the introduction of a quality management system (QMS), INPI should obtain ISO 9001 certification in April 2012. Before the introduction of this QMS as part of ISO 9001 certification, the patent office already had an in-house system to manage the quality of procedures, the goals of which were set by the patents management team together with the quality service.

The INPI quality measures are stated in the agreement of objectives concluded between INPI and the State for the period 2009-2012. The QMS will apply in particular to the processing of patents, from the filing of applications to the awarding of grants. The INPI quality measures are intended to ensure the compliancy and quality of services provided to system users and aim to demonstrate the reliability and thoroughness of in-house procedures.

As part of the quality policy, the Director General of INPI has defined four key areas of focus: listening to clients and anticipating their expectations; client satisfaction with the professionalism of staff; adapting staff capacities to the needs of the client; building relationships with INPI partners; and seven priority goals, including simplification of procedures for granting patents for industrial property by prioritizing paperless information exchange, reducing the processing time for grants, and making effective IT tools available to optimize the receipt, storage and distribution of documents.

In practice, the QMS takes a Plan-Do-Check-Act (PDCA) approach to interacting with clients, who are at the heart of the quality policy.

Mechanisms to monitor processes and measure quality have been formally established in each department.

A detailed description of the quality management system currently being introduced in the Patent Department can be found in the annex to this document.

ANNEX

Description of the quality management system currently being introduced in the Patent Department

The QMS has bolstered the formalization and harmonization of procedures in place in the Patent Department. A process applicable to the handling of patents was introduced in the Department to manage the processing of patent grants and the maintenance of the patents in force in France.

The process for handling patents is divided into 10 activities ranging from gathering patent applications and drafting preliminary search reports, to managing annual patent fees and making patent examination guidelines available to the public. For each of these 10 activities, a detailed description of each procedure has been established, enabling a number of non-conforming products (PNC) and non-conformities (NC) specific to each activity in the patent processing chain to be defined. Procedures have been put in place for all activities, to assist each INPI colleague in performing the required task.

The discovery of an anomaly through an auditing note, a colleague's spontaneous statement, a client's complaint, a procedural review, a management review, a risk analysis, a non-conforming product or a non-conformity leads to completion of an anomaly or improvement form (FAA), which is a suggestion for action that initiates a cycle of planning and implementation, and in turn leads to checks of the effectiveness of the action taken.

Monitoring and control of the quality of patents:

A department for quality and risk management has been established at INPI, with the aim of assisting the organization with its quality measures and ensuring continuous improvement in the quality of processes.

The Patent Department has also established a Quality Unit to implement this quality policy. Quality meetings between the head of the Unit and quality coordinators and advisers are organized monthly. Regular meetings are organized with all quality actors (process managers, advisers, auditors, supervisors).

Analysis tools have been introduced by INPI to analyze, monitor and measure the quality management system:

- ▶ The general management team at INPI issues quarterly management reviews to check that the quality management system remains appropriate, adequate and effective (these reviews involve evaluating opportunities for improvement and the need for changes to the system concerning the quality policy and set goals).
- ▶ In addition to the management reviews, quarterly procedural reviews are issued for each process to check whether clients' needs and expectations are met by procedure (external clients and internal users), and to identify any deviation from procedure, as well as any opportunity to improve procedure and address anomaly and improvement forms (FAA), and corrective or preventive action forms (FACP).

- ▶ An annual internal audit program ensures that staff are aware of the QMS, that it is implemented and that it complies with the requirements of ISO 9001 standards and is appropriate to attaining the strategic goals set by the management team. The results of these quality audits are evaluated during procedural and management reviews.
- ▶ Quality indicators have been identified for each process: in “patent processing”, performance indicators (such as the average time period for granting a patent) and risk indicators (such as the time taken to process the current set of examiners’ files and the deadline for forwarding PCT files) have been identified.
- ▶ The QMS is evaluated on a continuous basis and quality audits are scheduled every 6 to 12 months to ensure that the system remains appropriate and effective for meeting the quality goals and policies set by INPI.

Quality of tools in the Patent Department:

Aside from the introduction in the Patent Department of tools dedicated to quality management, such as a collaborative workspace and shared files, the department’s management team have also introduced and adopted a number of tools for different activities within the patent processing chain.

The Patent Department has modernized its reference management and file monitoring tool (Soprano), used throughout the process, from filing to rejection or granting of patent applications, and for managing annual fees.

The Patent Department has also adopted an images database for consulting files (Madras), which will, in time, enable paperless processing of files. This tool is linked to the Soprano tool.

Furthermore, publication at 18 months and the production of the Official Bulletin of Industrial Property (BOPI) Patents is made possible by the combined information provided by Soprano and Madras. In addition, information for online databases for public consultation of bibliographical data and files (the Espacenet database and the Patent Status database) is supplied using Soprano and Madras.

As for prior art searches undertaken at INPI, they are performed using the EPODOC and Derwent databases (for patent literature) and several databases of non-patent literature.

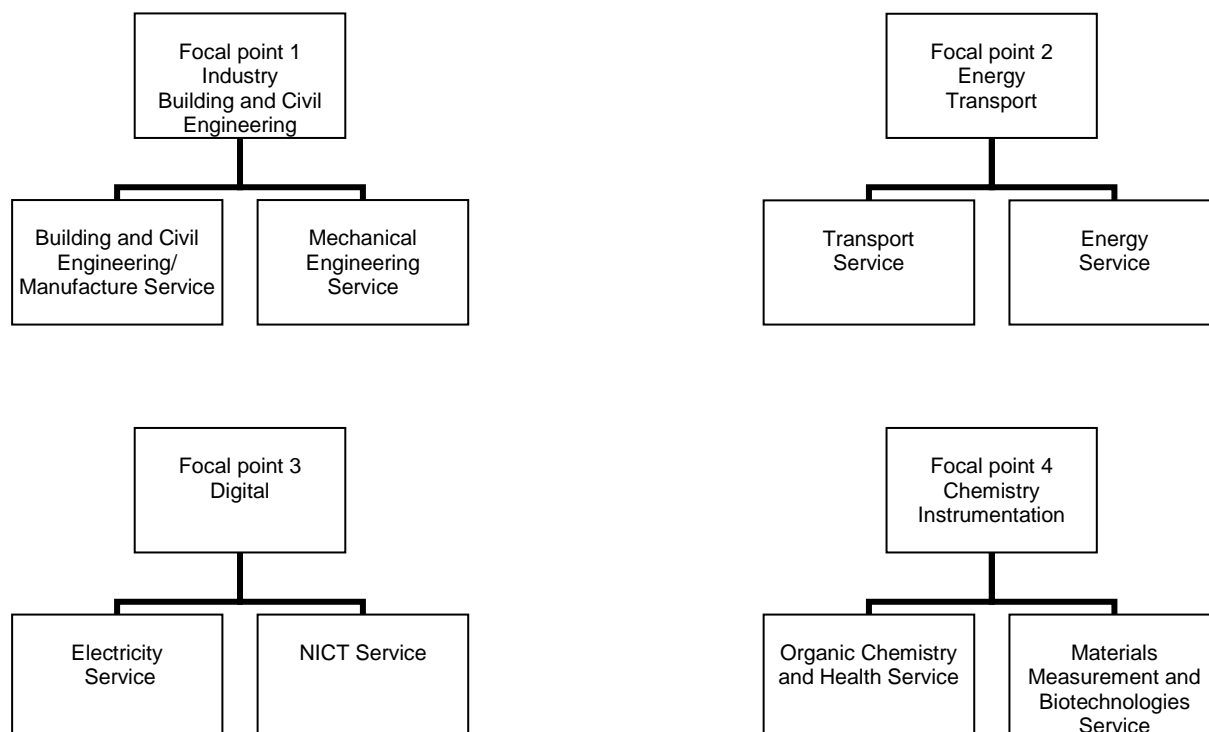
Recruitment and continuing professional development for examiners in the Patent Department:

The patent examiners recruited by INPI are engineers who are technical specialists in one or more fields. They need to have completed a university degree or an engineering institute program equivalent to secondary education plus five years’ higher education in a given scientific or technical field, and they must possess language skills (knowledge of two foreign languages, specifically English and German). They consider patent applications in the technical field appropriate to their initial training and professional experience.

The Patent Department consists of four focal points of examination by specialization, bringing together a staff of approximately 80 engineers:

- P1 : Industry - Building and Civil Engineering
- P2 : Energy - Transport
- P3 : Digital
- P4 : Chemistry - Instrumentation

Operational managers are responsible for the technical examination poles. Each technical examination pole is subdivided into two services that are led by a head of service, who is a line manager, and a technical and legal adviser.



Supervision of new technical examiners:

All new examiners follow a course of theoretical and practical training over six months.

Initial training lasting twelve hours introduces the basic principles of patents and patent processing, as well as introducing the examination of a patent application before it is forwarded for searching, including classification according to the International Patent Classification (IPC). This general training is rounded off by direct support from the examiner's head of service, who is responsible for training the examiner in his own specific technical field.

During the month after their arrival, new examiners receive general training on IPC (two hours), which is provided by the person responsible for IPC. Then, in the months that follow, the new examiners attend training on "awarding patents" (12 hours), in which the concepts of novelty and inventive step are raised and the examination procedure, from notification of the preliminary search report up until granting of the patent, is introduced. The training is based on the French Intellectual Property Code, directives and examples taken from case law. Following this training, examiners, under the supervision of their head of service, are then directed to handle responses to preliminary search reports.

The new examiners then attend training to learn how to carry out searches of prior art and how to draft search reports. This training has a five step structure: research training in six of the base modules; structuring a search report; structuring a written opinion; reproduction and group discussion of search results; use of IT tools to draft search reports and written opinions.

Under the supervision of the head of service, and after 12 to 18 months in the job, the authorized signatory of the Director General of INPI brings this training and supervision process to a close for most of the elements of the procedure. Certain acts nonetheless remain reserved to the Director of Patents or the Legal Director.
