

Standing Committee on the Law of Patent (SCP)

Portuguese Comments on Circular C.8076

Circular C.8076 asks for the submission of comments on two topics: “Patents and Health” (documents SCP/16/7 and SCP/17/11) and “Quality of Patents” (documents SCP/17/8, SCP/17/7 and SCP/17/10).

Considering the topic “Patent Quality”, our comments are as follows.

DISCUSSION ON PATENT QUALITY - SCP/17/8
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The Portuguese Institute of Industrial Property (INPI PT) has already expressed its support to the proposal of Canada and United Kingdom for a work program on quality of patents set out in document SCP/16/5 and also agrees with what is stated in document SCP/17/8. It is the INPI PT opinion that the three proposed components of work (technical infrastructure development; information exchange on quality of patents; and process improvement) would be beneficial to all parties involved in the patent system.

INPI PT states that quality could be defined as the fulfillment of patentability requirements, according to each national law, by Patent Offices, in a transparent way. For that reason, we think the creation of internal guidelines is adequate, by each National Office, and it is equally important to share them with the patent users.

Considering this, INPI PT highlights the importance of creating a forum, where all Offices can share information about the quality of patents and the information about the work done under the EQS. This information exchange would undoubtedly be helpful to improve the quality system in each National Office and to share best practices.

DISCUSSION ON PATENT QUALITY - SCP/17/7

INPI PT expresses its support to the proposal of Denmark for “the improvement of the quality of the search and examination of national patent applications by using foreign search and examination work”, set out in document SCP/17/7, and it is our opinion that the proposed subject would be beneficial to all involved in the patent system. As it is mentioned in this proposal, it is also our opinion that the use of foreign search and examination work in a National Patent Office’s own search and examination products will lead to more robust patents of high quality.

As an example of our participation in work-sharing projects, INPI PT is involved in the UIP project and has PPH agreements with Spain and with Japan in the near future.

However, some aspects should be taken in consideration. It is important to define how this use will be made, since not all National Offices publish their products together with the application at 18 months. We understand that this is a preliminary proposal and we agree with the general concept of sharing information, but all aspects should be addressed before taking any decision.

We now present comments and possible answers to the proposed questions made by Denmark:

- 1- How do the National Patent Offices use foreign search and examination work?

INPI PT has the possibility to consult search reports, written opinions and other documents available in Epoline Register Plus and PatentScope. This documentation is used as a basis for the production of our own products. As an example, INPI PT uses whenever available, the international reports produced

by ISA Authorities in the international phase of a PCT application, for the production of its own examination in the national phase of that PCT application.

2- What are the benefits of using foreign search and examination work?

This documentation makes easier the process of search for the national examiner, since it provides a correct classification and the most relevant state of the art documents considered by the Office of first filing. Documents sharing among Offices, as well as sharing best practices, allows an improvement of the quality of patents.

3- What are the challenges to the use of foreign search and examination work?

The biggest challenge that might stand in the way of this use is undoubtedly the language. National Offices produce their documentation in their native language, making impossible in many cases, the use of such documents. However, the search reports can always be used, as well as classification, since the relevant citation documents are always understood.

4- How could potential obstacles for using foreign search and examination work be overcome?

The existence of English machine translation engines may solve the language problem. On the other hand, the constant sharing of procedures can alert to possible differences in the legislation of the different countries involved in this document sharing. Furthermore, the availability of search reports produced by National Offices' examiners in their own website will be useful for other Offices, making thus possible to have access to those documents.

DISCUSSION ON PATENT QUALITY - SCP/17/10

INPI PT expresses its support for the proposal of the United States of America regarding the work program on quality of patents set out in document SCP/17/10, which allow firstly the share of the national goals of a patenting system and secondly the share of specific metrics that National Offices use for measuring quality. The work program described in document SCP/17/10 would be very helpful to an exchange of information about quality of patents between the National Offices and it would be very useful in the hard work to the definition of a high quality patent and to define what qualities must be possessed by a National Office to generate high quality patents.

1- Concerning the national goals of a patenting system, INPI PT considers crucial to achieve high quality patents, namely:

- Quality of search and patent applications examination – directly related with the availability of sources of information relevant to patentability: in order to ensure the access to appropriate search documentation it is important to be in compliance with the PCT minimum documentation; a good computerised system is also essential, in order to monitor workload of each examiner, assure that all legal deadlines associated to the processes are fulfilled, and avoid the existence of processes in paper.
- Average time to achieve a final decision about the grant or refusal of a patent application - for instance, in order to avoid backlog, the INPI PT examiners need to comply with quality deadlines of each item of their working list (formal exam, search reports, examination report and others). Therefore, we suggest that this point should be considered to the definition of the term quality in order to increase the patenting process improvement.

- Office examiners team - we consider that the quality of patents is related with the diversity of technological areas of the examiners thus allowing a high-quality patent examination at different technological fields.

INPI PT has 5 examination/technical clusters which are: Chemistry and Technologies (CQT), Biochemistry and Genetics (CBG), Technological Physics (CFT), Structures and Construction (CEC), and Industry and Materials (CIM); and 4 Knowledge clusters which are: Health, Eco-Technologies, Nano-Innovations and Information Technologies. In the knowledge clusters the examiners analyze information in the area, attend conferences, exhibitions, and workshops; and elaborate technical documents in relevant fields. Although these internal organization in clusters, the sharing of information is promoted among clusters and among examiners.

Concerning the training of the examiners team, another aspect with relevance to the patent quality system is the appropriate training of the examiners team, not only scientific training but also legislation and patent examination training.

At INPI PT there is a training and development program for all examiners, which involves: initial PI training (70h) (about patentability requirements, legal system, exam), and national or international intermediate training to acquire and improve specialized skills, and other trainings/courses whenever necessary. The training is planned and implemented as an answer to the necessities detected by the Head of Patent and Utility Model Department (DPMU) in cooperation with the Organization and Management Directorate (DOG).

- Training programs for the main patent system users: Another practice that could improve the quality of patents is the development of patent training programs for the main patent system users, for instance, universities and companies/enterprises, with the aim of approaching the Offices to users and potential users. This practice could improve the quality of the patent applications filed and, consequently, all the patent phases until the final decision would be faster. INPI PT offers several training programs directed specifically to

universities, enterprises and other users involved in Industrial Property. INPI PT has in course the program PAGE, which is a program of approach to large Portuguese companies/enterprises, with the aim of approaching the Portuguese Office to users and potential users. This program started in 2009 and has three different phases: first, an initial and general training course on Industrial Property is given by the examiners to the companies; then the companies develop an intensive internship at INPI PT with a designated examiner; and finally the examiner goes to the companies to train their employees in “Open Sessions”.

- INPI PT also develops sessions of awareness to the importance of Industrial Property (IP) in Universities and gives training in specialized sessions of the INPI PT IP Academy.

2 - Regarding the second element of the work program proposed by the United States of America, specific metrics for measuring quality, INPI PT fully supports the realization of a questionnaire among the National Offices in order to gather information related to specific metrics used in the quality evaluation of the granted patents.

Referring to this second element, INPI PT would like to provide already information about our experience on the quality assurance.

In 2008 an internal audit procedure was implemented in the Department of Patents and Utility Models. This procedure consists in restudying a random sample of 10% of the granted or refused patent or utility models files, per year, in different technical fields. The audit teams are composed by two examiners, being one of them an examiner that participates in every audit episode, and a rotating examiner indicated by the Head of the Department.

This was implemented to evaluate the decisions made by the examiners and to identify the existing errors in each file (formal requirements, content and decision parameters). These audits include, among other criteria, the monitoring of the attributed classification. To achieve these audit procedures template documents were developed

and a Manual was created to guide the examiners in the execution of these procedures.

A similar procedure to evaluate the quality of the decisions concerning Supplementary Protection Certificates (SPC) was developed and was also implemented at INPI PT.

The results achieved in the audits are statistically treated every three months, and are a part of the Quality indicators. INPI PT has an indicator related with "Internal audits", with five subdivisions which are: Percentage of errors in patent and utility model applications - formal parameter; Percentage of errors in patent and utility model applications - content parameter; Percentage of errors in patent and utility model applications - decision parameter; Percentage of errors in SPC - application parameter; and Percentage of errors in SPC - decision parameter.

Every three months, these results are also compiled in quality reports where for each type of error found, corrective and preventive actions are proposed to assure a continuous improvement of the established procedures.

Every year, INPI PT develops periodic internal and external audits to its services, in order to investigate if its quality requirements and goals are being effectively developed and completed. These internal audits are made by the INPI PT internal auditors that do not belong to the Patent and Utility Model Department, and external audits are made by an external certificated company.

Moreover, INPI PT has a battery of qualitative and quantitative indicators for the Quality Management to measure the quality of the work done by the examiners, which are:

Indicator		Calculation method	Periodicity of the Analyses	Annual objective	Target
1/N3	Formal Examination acts performed on time	Nr. of acts performed on time/ nr. of acts in Formal Examination phase	quarterly	> or = 95%	18 days
2/N3	Substantive Examination acts performed on time	Nr. of acts performed on time/ nr. of acts in Examination phase	quarterly	> or = 95%	18 days
3/N3	Administrative acts performed on time	Nr. of acts performed on time/ nr. of requested acts	quarterly	> or = 95%	7 days
4/N3	Average time of Regular Patent decision	Mean of the differences between date of Decision to Grant and date of Regular Application / total number of Decisions to Grant in case of Regular Applications	quarterly	100%	21 months
5/N3	Average time of Irregular Patent decision	Mean of the differences between date of Decision to Grant and date of Irregular Application / total number of Decisions to Grant in case of Irregular Applications	quarterly	100%	29 months
6/N3	Preliminary report performed on time	Nr. of preliminary reports performed on time / total number of preliminary reports	quarterly	> or = 95%	18 days

	Search report of provisional applications performed on time	Nr. of search reports of provisional applications performed on time / total number of search reports of provisional applications	quarterly	> or = 95%	36 days
7N3	% of errors in patent and utility model applications- formal parameter	Nr. of formal errors/ nr. of possible formal errors within the sample	quarterly	< or = 10%	-
	% of errors in patent and utility model applications- content parameter	Nr. of content errors/ nr. of possible content errors within the sample	quarterly	< or = 10%	-
	% of errors in patent and utility model applications- decision parameter	Nr. of decision errors/ nr. of possible decision errors within the sample	quarterly	< or = 5%	-
	% of errors in SPC- application parameter	Nr. of errors in the application/ nr. of possible errors within the sample	quarterly	< or = 10%	-
	% of errors in SPC- decision parameter	Nr. of decision errors/ nr. of possible decision errors within the sample	quarterly	< or = 5%	-

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