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DE INDUSTRIA, ENERGÍA
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Oficina Española
de Patentes y Marcas

[ENGLISH TRANSLATION BY WIPO]

From: Spanish Patent and Trademark Office, Ministry of Industry, Energy and Tourism

COMMENTS BY SPAIN RELATING TO THE QUALITY OF PATENTS (STANDING COMMITTEE ON THE LAW OF PATENTS – 18th SESSION)

In response to **WIPO** letter **C.8076**, this Delegation has the pleasure to enclose its comments on documents **SCP/17/8** (proposal by **Canada** and the **United Kingdom**), document **SCP/17/7** (proposal by **Denmark**) and **SCP/17/10** (proposal by the **United States of America**), all of which relate to the **"Quality of Patents".**

As regards the proposal by **Canada** and the **United Kingdom** (**SCP/17/8**), the **Delegation of Spain** wishes to reiterate its support for the proposal and express its satisfaction at the inclusion in the Committee agenda of such a vital subject in the sphere of patents.

Similarly, the **Delegation of Spain** welcomes with great satisfaction the fact that the proposal has taken into account a number of recommendations from the **Development Agenda**, specifically Recommendations **10**, **11**, **19** and **29**.

The work plan detailed in document **SCP/17/8** (proposed by **Canada** and the **United Kingdom**) includes as one of its three components **"process improvement"**. This point is an opportunity for the **Committee** to continue its study of **substantive aspects of patent law**.

There is broad agreement among professionals in the world of patents regarding the most controversial and difficult element in relation to the evaluation of patentability requirements, constituted by the **evaluation of inventive step**.

In the Committee the opposition of a significant group of Member States to the harmonization of patent legislation has been reiterated. However, with minor amendments, the definition of the inventive step requirement is very similar in the majority of legislative systems. There does not therefore appear to be a pressing need for harmonization of national and regional patent legislation in this sense.

Given the complexity of evaluating inventive step, as indicated previously, benefit could be gained from the proposal made by the Delegations of **Canada** and the **United Kingdom**, a revised version of which is contained in document **SCP/17/8** to initiate a series of studies that the Secretariat would prepare with the collaboration of the Member States and which would be designed to enable better understanding of the subject.

A start could be made with studies on the main elements involved in the definition of inventive step: the **prior art** and the **relevant expert**, ex officio expert or person skilled in the art. Definitions in this area would be studied in the different legislative systems and, above all, how the guidelines for patent examiners' internal use refer thereto.

Efforts would continue with a **comparative study of the different methods of evaluating inventive step used in the Member States**. This study should be very practical in nature, with a large number of examples. **Cases could be examined**, in which the **results of the evaluation of inventive step have shown differences** in different Member States.

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These studies would contribute to a **better understanding of the requirement of inventive step** and of its evaluation, the result of which would be that the exclusive rights conferred by a patent will be granted to a greater extent to inventions which so merit.

As regards the proposal by **Denmark**, contained in document **SCP/17/7**, the Delegation of Spain supports the proposal by the Delegation of **Denmark** whereby this **Committee** should study the aspects relating to the reuse by National Patent Offices of the search and examination work already completed by other Offices.

The search report is usually published together with the patent application and a large number of Offices possess **databases**, where it is possible to consult **all or most of the documents generated during the grant procedure.**

The reuse of the search and examination results produced by other offices is a routine practice in the majority of Patent Offices, including the **Spanish Patent and Trademark Office**. The first search carried out by a patent examiner, in addition to the search by the inventor and applicant, is the search of other applications already published from the same family.

The existence of **searches and/or examinations already carried out** on the same invention **guides and facilitates the examiner's subsequent work**, even where the final decision is always to be taken by the National or Regional Patent Office responsible for granting the patent, irrespective of the decisions taken by other National or Regional Patent Offices.

Spanish legislation provides for the use of previous search and examination results, thereby reducing the corresponding fee, depending on the extent to which such prior work has been of use.

In recent experiments conducted within our Office as part of the **Patent Prosecution Highway** program (within which we have agreements with **Mexico**, **Canada**, **Finland**, **Portugal**, **Japan**, **Republic of Korea, United States of America** and **Russian Federation**), we have discovered that the main problem in taking advantage of the results of searches and examinations already carried out by other national offices in relation to patent applications is the issue of different languages, especially in the case of languages which are totally unrelated to the native language of examiners.

Regrettably, **automatic translation systems** currently available **do not provide the requisite quality**. Therefore, this Delegation considers that that is the **main obstacle** to appropriate reuse of the search and examination results of other offices, although we are fortunately aware that a great deal of effort is being made to achieve progress in this area.

As long as the most advanced computer translation systems are not available, it will not be possible to take full advantage of the search and examination results of other Patent Offices. **WIPO should collaborate in the efforts designed to obtain automatic translation systems relating to patents that are sufficiently reliable.**

Another situation in which the use of a prior search or examination is complicated is when the application on which this work has been done has undergone changes with

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regard to the application examined by the second Office. In order to overcome such difficulties, **a framework of equivalence of claims**, facilitating the use of work done by another Office, could be created, as within the Patent Prosecution Highway agreements.

Another point on which the **National Offices** should work is the supply of **databases**, where access can be gained to search **reports and examination results** generated during the patent grant procedure and which are freely available, at least to other National and/or Regional Patent Offices.

The efforts made within the **PCT** may be included within this point, as contained in documents **PCT/MIA/18/6** and **PCT/MIA/19/3**, and intended to allow the contribution of observations to the International Search Report by any third party, to which those designated National Offices, which carry out a search in addition to that already done by the International Searching Office, disclose their search report (produced in the context of the national grant procedure) through **PATENTSCOPE**. It is also envisaged that the National Offices designated and/or selected may send comments to the different International Searching Authorities in relation to the International Search Reports issued.

In relation to the **proposal by the United States of America** (document **SCP/17/10**), the Delegation of Spain welcomes the proposal for **"a work program in which Offices of Member States are invited to reflect upon and to share the high-level goals that they consider crucial to a patenting system that produces high quality patents".**

It would be highly **beneficial in terms of making progress in the discussion** of this subject for **National Offices**, as indicated by the proposal of the United States of America, **to respond to a questionnaire** on the tasks considered to be essential for a system to produce high-quality patents and a **questionnaire** on the quality control mechanisms which each Office uses.

In this connection, this Delegation wishes to respond to a questionnaire circulated unofficially in this respect during the last session of the Committee and which, if answered by other States, would provide an overview of what the situation is in relation to the quality of patents:

1. **Do you use criteria in your national jurisdiction to define quality of patents from an application perspective?**

   (a) Quality of the invention: Do you use criteria to ensure the invention is sufficiently inventive?

   The Spanish Patent and Trademark Office (OEPM) uses the novelty and inventive step requirements. According to Article 6.1 of the Law on Patents No. 11/1986, an invention shall be novel if it is not included in the prior art. According to Article 8.1 of the same Law, an invention shall involve an inventive step if the invention is not obvious from the prior art to a person skilled in the art. At OEPM, the problem-solution method is used to evaluate inventive step, with the aim of guaranteeing harmonized treatment of this issue.

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(b) Quality of drafting the patent application. Do you use criteria to ensure that the invention is clearly described in the application?

In relation to the clarity of the description, Article 25.1 of the Law on Patents No. 11/1986 states that the invention must be described in the patent application in a manner sufficiently clear and complete for a person skilled in the art to carry it out. Similarly and in accordance with Article 35, the description and the claims should be sufficiently clear so as to allow the Prior Art Report to be prepared. In relation to claims, Article 26 states that such claims shall define the subject matter for which protection is requested and must be clear and concise and based on the description.

2. Do you use criteria in your national jurisdiction to define quality of patents from your IP Office's perspective?

(a) Quality of search for the state of the art: Do you use criteria to ensure that an examiner has identified the closest prior art?

In order to apply the problem-solution method (for evaluating inventive step), it is necessary to determine which document represents the closest prior art. It shall be considered that said document shall be that which, since it belongs to the same field of technology, discloses the technical effects, objectives or particular use closest to the claimed invention or that which, since it shares the greatest number of technical characteristics with the invention, is capable of ensuring the claimed function of the invention.

(b) Quality of analysis of search results: Do you use criteria to ensure that prior art is correctly evaluated in relation to the application?

In order to analyze whether the prior art has been evaluated correctly in relation to the application, it is verified whether, in order to examine the novelty, the claims have been compared with the prior art documents (one by one, without it being possible to combine documents).
To analyze whether the prior art has been evaluated correctly from the point of view of evaluating inventive step, it is necessary for the closest prior art document to have been chosen and the problem-solution method to have been applied, at least in relation to the independent claim or claims. It is also crucial for the prior art documents, which may be combined and are used to evaluate inventive step, to belong to the same prior art as the claimed invention. The evaluation of inventive step must be explained in as detailed a manner as possible.

(c) Quality of the application of legal provisions: Do you use criteria to ensure that the applicable legal provisions are observed and applied appropriately?

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In order to guarantee that the examiner applies correctly the legal provisions, i.e. the Law on Patents 11/1986 and the Regulations thereunder, OEPM publishes on its web portal and keeps up to date certain examination guidelines. In the drafting of written opinions, the examiner must indicate the legal provision or article that has been used in each case.

(d) Quality of cooperation of the applicant and the examiner: Do you use criteria to assess the level of contact between examiner and applicant?

In all the communications between the examiner and applicant, the applicant's name and telephone number are included. The applicant may contact the examiner at any time and the examiner shall try to assist the applicant in order to respond to any doubt that may arise and help him to ensure the best possible quality of the patents.

(e) Quality of legal provisions: Do you use criteria to ensure that the legal provisions are understandable and available to all parties concerned?

As indicated previously, OEPM publishes and keeps up to date certain examination guidelines to facilitate the understanding of the applicable legal provisions.

(3) Infrastructure

(a) Please describe the nature of the scientific/technical training IP office examiners receive to ensure the quality of patents granted.

OEPM patent examiners are higher level university graduates in technical fields relating to their area of examination. Together with the conduct of entry exams, this requirement guarantees advanced technical and scientific training from the beginning.

To complement the above, in certain fields in which science is advancing more quickly, examiners receive periodical refresher courses. Similarly, examiners receive initiation and update courses in relation to the patent databases most widely used for the prior art search.

(b) Please describe the nature of the legal/legal system training IP office examiners receive in order to ensure the quality of patents granted.

In order to join OEPM, examiners must pass a series of examinations on national and international patent legislation. Once they are accepted, they receive relevant additional training and are periodically given refresher and update courses.

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(d)Please describe the nature of work done with users of the patent system to ensure that patents submitted to your national IP office are of a high quality.

On the Patent Office web page user information handbooks are published, together with internal examination guidelines, and lectures are given at universities, technology firms and chambers of commerce, for the purposes of training potential applicants on how to file high-quality applications.

(c) What search tools and options (hardware and software) are available to an examiner to ensure the quality of patents granted?

Patent examiners have access to the most advanced databases in the patent search field, for example the Spanish database INVENES, the series of EPOQUE databases (produced by the European Patent Office) and other specialized databases. Access is available to the minimum documentation established in the PCT Regulations, including the different periodical publications. Similarly, the ALFA application is available, which facilitates the management of patent procedures (national and PCT) in completely electronic form. As regards quality management, a process and documentation management application is available, INCAWEB, which allows, for example, files to be reviewed using check lists, the establishment of cases of non-compliance, corrective and preventive actions, etc.

(4) Process improvement

(a) Please describe which quality control mechanisms are employed within your national IP Office to ensure the quality of patents and the quality of the work of patent examiners

All the search and examination reports produced by patent examiners are revised, before they are issued, by the head of service or coordinator for the area of examination in question. Also, following its issue, the quality of reports is controlled using a number of check lists produced on a sample of randomly selected reports.

(b) Please describe the quality management system your IP office has in place to ensure quality of patents.

OEPM has implemented the ISO9001:2008 Quality Management System for the PCT procedure.

(c) How does your national Office use foreign search and examination work to ensure quality of patents?

The Office always takes into account the work done by other Patent Offices, both in relation to search and examination, in order to complement its own work, above all as regards documentation drafted in languages unknown to the majority of examiners.

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(d) How could potential obstacles for using foreign search and examination work be overcome?

The main obstacles lie in the access to search and examination information produced by other offices and also where such documentation is drafted in an unknown language. That could be overcome using databases that allowed access to such information and more powerful translation systems than those currently available.

Lastly this Delegation would like to provide more details to other Member States on the Committee regarding the **Quality System** established by **OEPM.**

OEPM has, since it was set up, had a **constant commitment to quality**, being aware that this is an essential element in achieving a new Authority able to respond to the challenges resulting from the transformation of society and the demands of citizens.

In February **2007** the **OEPM** Directorate signed a Resolution which defined and expanded the **OEPM quality policy**, with a view to introducing a Quality Management System, currently based on standard **ISO 9001:2008,** for **PCT** patent applications.

The main challenges of this activity have been to obtain the **ISO9001:2008 Certificate for the PCT Service and the Search Service, and Certification of the Technology Monitoring System of the Search Service, according to standard UNE166006:2011. The scope of the quality system also includes the procedures for distinctive signs and industrial designs.**

Quality is a relevant element within the Patent Cooperation Treaty **(PCT)**, as contained in **Chapter 21 of the PCT International Search and Preliminary Examination Guidelines**, which urges International Authorities to adopt a Quality Management System.

This has allowed **International Authorities** to define certain **common requirements** which increase trust in their work in relation to national and regional offices, as well as among applicants themselves.

A faithful reflection of this commitment are the reports published annually by the International Authorities under the **PCT**, which describe the situation regarding their quality management system (International Search Authorities monitoring reports **(PCTMIA)).**

Following these guidelines, **OEPM** has opted for the introduction of a Quality Management System based on standard **ISO 9001:2008**, for the **PCT** international patent application processing procedure, both in the Receiving Office phase and as refers to its activities as an International Searching Authority and International Preliminary Examining Authority. Said Management System has been certified by the firm **AENOR** which has verified the compliance of the System introduced with the standard and granted **OEPM** the corresponding quality certificate that must be renewed annually.

This certification is in addition to the **OEPM Service Card as an International Searching and Examining Authority**, which involves a commitment by OEPM to verify the periods for conducting international searches.

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OEPM wishes to explain the measures taken to control the quality of the Search Reports and examinations carried out by examiners, both in the PCT procedure and in the national patent grant procedure.

Where an **examiner** issues a search report, accompanied by his written opinion or an examination, said search or examination report is sent electronically to the corresponding **head of service**, who carries out a **first quality control,** and requests the examiner to correct what does not correspond to the provisions of the quality procedures**.**

Likewise, a number of **search and examination reports are selected at random** on a monthly basis and are subject to a **point-by-point analysis** by the corresponding **head of service**, using a number of **check lists** designed for that purpose. The sample is selected such that reports by all examiners are analyzed by this system.

If as a result of the analysis **defects are detected**, the corresponding **non-conformity** ruling will be given, in order for it to be corrected. Also, **corrective actions** are **occasionally** taken, intended to avoid defects recurring in the future.

The results obtained from said quality controls are analyzed periodically as a whole by the **Quality Group** in order to identify ways to improve them.

The **Quality Management System** also contains the opinion of the applicants and agents by means of various systems, one of which is complaints and claims. The complaints and claims received are studied firstly by the **Quality Group** and, where necessary, by the **Quality Committee** in order to ensure that they have been correctly resolved, and similarly to study possible courses of action in order to avoid the recurrence of such issues.

In addition, **satisfaction surveys** are conducted annually among users, both professional and private, which help us to be aware of their perception of our services and the degree of importance which they attach to each one of them, as well as possible areas for improvement. This information is also analyzed by the **Quality Group** which approves the courses of action for improvement that are considered appropriate in view of the survey results.

Also, the **Innovation and Patent Forum** is held annually, a meeting with the main users at which general issues are discussed for improvement of the system and, on the other hand, meetings with agents, to study specific problems in the processing of files.

All these tools help us to improve, in a continuous manner and in relation to specific databases, the services provided by OEPM.

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