

Questionnaire on the Term “Quality of Patents” and Cooperation between Patent Offices in Search and Examination

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The answers to this questionnaire have been provided on behalf of:

Country: Brazil

Office: Brazilian National Institute of Industrial Property

Q1. Various aspects may be relevant to the concept of "quality of patents". It may relate to, for example, quality of patent procedures and management in the office, quality of search and examination, quality of granted patents or quality of a patent system. In addition, the expression "quality of patents" may be understood differently depending on the perspectives of various stakeholders, for example, the perspectives of a patent office, an applicant etc.

How does your office understand the term "quality of patents"?

The term “quality” may be associated to different aspects in the field of patents.

We understand that it is possible to address “quality” in regards to formal aspects related to substantive harmonization and, ultimately, to legal harmonization. INPI is not in favor of legal harmonization and understands that, in some degree, substantive harmonization may be necessary.

“Quality” may equally be associated to certification of processes and proceedings. This “quality” is equally associated to pre-established proceedings patterns of which we are favor of, like certification ISO of our processes.

There is also “quality” in the substantive examination. In this sense, INPI considers the expression “quality of patents” as related to patents granted in conformity with requisites and patentability conditions as established by the current legislation in force. A patent granted with quality remains valid even when submitted to processes of nullity in the administrative and judicial spheres.

In order to assure the quality of the process of patent granting, INPI counts with a full technical body of trained examiners, responsible for examining patents filed in Brazil, either in national level, either as International Searching and Preliminary Examining Authority (ISA/IPEA). Recently hired patent examiners participate in the “Training Program for New Patent Examiners”, with the total duration of 3 (three) years, which encompasses a stage of classroom-based courses in patent legislation and procedures for substantive examination, followed by a stage of “*on the job*” trainings, in which the new examiners conduct search and examination of patent applications under the supervision of an experienced examiner. All

examiners participate periodically of up-to-date courses on legislation, procedures for patent examination and new technologies.

In order to achieve excellence in our services and to establish a Quality policy, INPI adopted a System of Quality Management (SQM), implementing, within the Directorate of Patents (DIRPA), the DIRPA Quality Group, responsible for the management of quality, which includes the examination of patent applications. As a first step, the formal procedures and the guidelines related to the examination of patent applications were documented and made available in a digital format in order to allow access to examiners and public in general. More recently, the DIRPA Quality Group prepared a "Validation Checklist for Quality Management of Examination Reports", containing items related to internal procedures and to the national legislation to be checked in regards to adequacy by the heads of the examining divisions.

INPI also considers the time until a patent is granted as a factor of quality in the process of patent granting. In this sense, the Institute has been implementing a series of measures dedicated to reduce the number of pending patent applications (the "backlog") and the time for a final decision, such as the digitalization of patent applications, the launch of a platform for electronic filing of patent applications, the development of state machine and the hiring of new examiners. Besides, the Institute offers some special lines for accelerated examination of patent applications in certain technological fields, such as patents related to technologies for the environment (also called "green patents") and for the health, and applications participating of pilot programs of PPH format (*Patent Prosecution Highway*).

Q2. What types of cooperation with other patent offices does your office have with respect to search and examination?

Those types of cooperation may include, for example, access to documents/databases of other offices, use of search and examination work products, expertise and resources available in other offices, collaborative search and examination, outsourcing search and examination etc.

INPI has mainly 3 different types of cooperation with IP offices with respect to search and examination:

- 1) cooperation agreement with IP offices, carrying out these activities on their behalf and providing them the search and examination reports;
- 2) projects of cooperation along regional IP offices focused on the formulation of a tool destined to work sharing in search and examination between IP Offices - PROSUR;
- 3) pilot programs in the Patent Prosecution Highway (PPH) format.

Q3. When performing prior art search, patent examiners prepare search strategies and queries (for example, indications of databases and publications, classification codes, search terms and key words used) to find relevant prior art.

Does your Office share (for example, via an official website), or exchange, such search strategies and queries with other collaborating offices?

Since 2011, INPI publishes freely search and substantive examination reports of patent applications in its homepage by the means of the “e-Patentes” system.

Search reports inform about the searched technological field (Classification IPC/CPC) and the searching tools used by the patent examiner. The documents quoted in the examination reports are made available in digital format, for online consultations.

In spite of that, the search strategy is not yet shared among third parties, although INPI understands that such practice should be enhanced with the aim at sharing information and improvement of quality of examination above referred.

Q. 4. In order to facilitate the cooperation, what kinds of platforms and tools to share information on search and examination are available in your office? Such platforms and tools include, for example, WIPO CASE, databases allowing other offices to retrieve information and external databases used to retrieve information.

(i) Platforms and tools provided by your office

“BUSCA WEB”

The “BUSCA WEB” is a system made available free of cost by INPI in its internet portal which allows patent searching filed in Brazil by the means of accessing the internal database of the Institute. It is possible to carry out searches by the means of keywords e/or number of the application. Aside from allowing access to bibliographic database of the applications, official INPI communications and the application document as filed, the system allows process monitoring of the patent applications. The published search and substantive examination reports are made available for consultation.

E-PEC

The “E-PEC” is a platform created in order to provide a collaborative exam between South American Patent Offices which are part of the PROSUR – South American System of Regional

Cooperation. This platform allows sharing substantive examination and prior art cited by patent examiners in engaged countries.

(ii) Platforms and tools used by your office

EXTERNAL DATABASES

INPI makes use of external databases in order to carry out the search of prior art and other relevant information concerned to substantive examination of patent applications. Some external databases accessed by patent examiners are free of cost, such as Espacenet, PATENTSCOPE, Portal CAPES and homepages of scientific journals in general, meanwhile others are paid, such as EpoqueNet, Thompson Reuters and STN.

INTERNAL DATABASES

Beside the free of cost databases made available on internet and hired databases, INPI makes use of two internal platforms that allows sharing of information among examiners.

SISCAP

The SISCAP (Production Monitoring System) is an internal system created by INPI to make the search and substantive examination reports available to examiners, monitoring the process flow and carry out publications in the Industrial Property Gazette ("RPI"). The system allows search of substantive opinions and prior art as quoted by examiners by the means of keywords.

SINPI

Aside from allowing the administrative management of patent applications, the SINPI (Integrated System of Industrial Property) allows internal users to search in our databases by the means of keywords, classification, filing dates, among others.

Q.5. What are the impacts of such cooperation in the area of search and examination to your office? If your office has different types of cooperation and each type of cooperation has different impacts, please indicate them separately.

INPI currently participates in three pilot projects of work sharing in the *Patent Prosecution Highway* (PPH) format in a partnership with the United States of America, Japan and PROSUR destined to information sharing related to search and substantive examination of the partner offices. Evaluation of impacts of these cooperative measures shall be organized by the end of these projects, still ongoing.

Q.6. What kinds of capacity building are required for different types of cooperation between patent offices in search and examination? Please indicate any specific capacity building needs to conduct such cooperation successfully.

In this context, the capacity building is understood to refer to various activities and trainings that support development of knowledge and skills of office employees for effective cooperation between offices in search and examination.

It is important to stress, beforehand, that the demands of infrastructure and capacity building between offices may vary from one office to another, depending on the number of examiners, the search and examination experience, Information Technology infrastructure, among others.

It is possible, however, to highlight a minimum standard of infrastructure and capacity building required to enable collaborative examination:

Basic IT Infrastructure;

Capacity building in the use of platforms of collaborative examination;

Capacity building in search of prior art in databases;

Capacity building on substantive examination.