

The answers to this questionnaire (circular 8625E) have been provided on behalf of:

Country: Canada

Office: Canadian Intellectual Property Office

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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”?

There are two ways our office understands the term “quality of patents”. First, as it relates to the quality of the patent itself, and second as it relates to the quality of the examination process.

A quality patent is one that complies with the requirements of patentability, as specified in the Patent Act, Patent Rules and jurisprudence at the time of grant. A high quality patent correctly and fully describes the invention and its operation or use as contemplated by the inventor, and defines distinctly and in explicit terms the invention for which an exclusive privilege or property is claimed.

Patent Quality as it relates to the examination process is defined as the Canadian Intellectual Property Office’s (CIPO) patent products conforming to CIPO’s quality standards. Quality Standards have been defined for National examination, International examination, Classification and Operations (support) processes. Quality verification activities are used to ensure CIPO’s products meet quality standards. Quality standards designate the degree of thoroughness and judgement expected in CIPO’s products prior release to the client.

More specifically, Patent Branch of CIPO has defined quality standards for national patent examination under six major headings:

- 1. Subject Matter: ensuring all patentable subject matter issues are appropriately addressed, and ensuring that reservation of examination opinion is done so only when appropriate.*
- 2. Prior Art: These standards relate to the proper formulation of a search strategy, the proper application of prior art for defects related to novelty, obviousness and double patenting.*
- 3. Application Formalities: All application formalities are addressed, including clarity, drawing quality, titles and abstracts.*
- 4. Prosecution: These standards relate to prosecution efficiency, the identification of defects in subsequent actions.*
- 5. Communication: These standards relate to sufficiently informative examination reports and that all appropriate requisitions are present at each report stage.*
- 6. Timeliness: This standard relates to all time limits being respected.*

Our standards for international examination follow a similar model.

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.

CIPO's experience is primarily through our collaboration with the Vancouver Group (AusPat, UKIPO and CIPO). For more than 5 years we have co-operated on quality assurance activities by reviewing and offering opinions on the patentability and conformance to our core quality standards of patents that would be granted in one partner office. These activities are limited to small numbers of applications within certain subject matter fields. Applications are routed to examiners who are skilled in the selected technical areas. We use templates to facilitate the circulation of opinions from the auditing examiner back to the audited examiner (and vice versa). We prepare reports on the results of audit activities for consideration of the executive office during regular Vancouver Group round tables.

Another major area of co-operation is CIPO work on Patent Prosecution Highway (PPH) agreements. Currently CIPO has PPH agreements with 25 other IPOs and the program continues to expand. A full list can be found on our website (http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr02160.html). PPH agreements leverage the work in other IPOs to reduce duplication of work by the CIPO examiner and improve speed of delivery to the client.

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?

Yes, CIPO shares its search queries with other offices. CIPO documents its national search strategies and queries using an in house designed software tool. This tool produces a standard document that summarizes the search and is attached to the examiner's report. The reports (and most correspondence) are available via the CIPO Document Access System (CDAS) where it can be accessed by any interested party.

We also record search queries and related search information during international examination. This information is uploaded to PatentScope for consideration by any designated office or interested party.

Additionally, during audits with the Vancouver Group, we upload relevant file information including search queries to GovDex for access by our partners.

Q4. 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

CIPO provides search information via the two databases mentioned above, our own CDAS system and our uploads to PatentScope.

(ii) Platforms and tools used by your office

CIPO examiners are trained to consider the prosecution in foreign jurisdictions as a way of reducing duplication of work and expediting examination. CIPO maintains a documented listing of all foreign document access systems and how Canadian examiners can access them to retrieve useful documents. In particular, CIPO examiners routinely consider USPTO PAIR, EPOLINE and PatentScope. We have only limited experience with WIPO CASE and IP5 Global Dossier. We have also participated in testing and providing feedback on the SIPO CPES system. This has taken the form of small numbers of examiners using the system and providing feedback via a standardized form, in 2016. The results of this usage are summarized and were communicated to SIPO as part of ongoing feedback processes.

Q5. 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.

Our Vancouver Group co-operation has resulted in the development of our own internal quality assurance process which has been going through several pilot projects. The results of the Vancouver Group Quality Assurance (VGQA) cooperation were critical to getting management support to invest in our own national system and there have been many fruitful discussions and interesting pilot results so far in this process.

With SIPO CPES, the impact has so far been minimal, we have only tested the system on limited occasions and provided feedback and wider test or training and deployment has not occurred at this time due to technical issues.

PPH co-operation has a positive impact on the pendency from request for examination to grant of patent applications. These types of partnerships lead to rapid amendments, which can in many cases lead to allowances in fewer office actions. This reduces turn-around-times (TATs) and examination costs.

Q6. 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

CIPO struggled with IT requirements for sharing documents during the VGQA process, having a widely accessible service where IPOs could easily post and access file information would be beneficial.

Timing is also difficult with international collaborations as the periods in which offices can effectively work collaboratively is limited to the 'shoulder seasons' of spring and summer due to examiners being away during summer (or winter in the southern hemisphere). This is an issue since Spring is typically quite full with planning and fiscal year end activities. It makes it difficult to find resources to commit to large collaborations.

Knowledge of foreign office practice is also important to build cooperation between offices. This requires an investment in research and training in order to build up an understanding of the similarities and differences between the two IPOs so that examiner's can properly contextualize and leverage the examination approach taken by the foreign examiner.

Additionally, having full time employee resources to engage in the discussion, review and planning for international collaboration is key. The quality program at CIPO is investigating the need to have a position created where these activities are permanently assigned as having experience and knowledge of a longstanding collaboration is necessary for effective management. However, staffing is difficult to justify as collaborative work fluctuates greatly over the year and is difficult to forecast effectively.