

Standing Committee on the Law of Patents

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**QUALITY OF PATENTS: COMMENTS RECEIVED FROM MEMBERS AND
OBSERVERS OF THE STANDING COMMITTEE ON THE LAW OF PATENTS (SCP)**

Document prepared by the Secretariat

Pursuant to the decision of the Standing Committee on the Law of Patents (SCP) at its seventeenth session held in Geneva from December 5 to 9, 2011, the Secretariat invited the members and observers of the SCP, through Note C.8076, to submit comments on the topic of quality of patents. This document contains, in the Annex, the comments received.

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COMMENTS RECEIVED FROM MEMBERS AND OBSERVERS OF THE SCP

COSTA RICA

With reference to the invitation issued through communication C.8076 of December 22, 2011, the Industrial Property Registry of Costa Rica thanks the Delegations of Canada, United Kingdom, Denmark and United States of America for the proposals put forward concerning the subject of “the quality of patents”.

It is important to improve examination and search processes and it is also fundamental for examiners to develop and share search strategies. Mechanisms should therefore be sought in order to improve exchange of information, for the purposes of achieving the objectives proposed regarding the quality of patents.

The Patent Office of the Industrial Property Registry has, for the purposes of granting high-quality patents, launched the process of subscription to the Access to Specialized Patent Information (ASPI) program made available by the World Intellectual Property Organization (WIPO) and, since 2008, has received support from the Mexican Institute of Industrial Property (IMPI) through its CADOPAT portal.

We consider the questions raised with delegations in the proposal submitted by Denmark, for the purposes of enriching the discussions of the SCP, to be very valuable. Equally, the information shared by the United States Patent and Trademark Office (USPTO) regarding quality control of its patents is of interest for our Office; it is, however, clear that for offices in countries such as Costa Rica, in which there are few examiners, such quality control becomes a complex issue.

For that reason, the Industrial Property Registry welcomes the proposals put forward, owing to the fact that these proposals will allow the subject to be discussed more comprehensively at the next SCP session.

FRANCE

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.

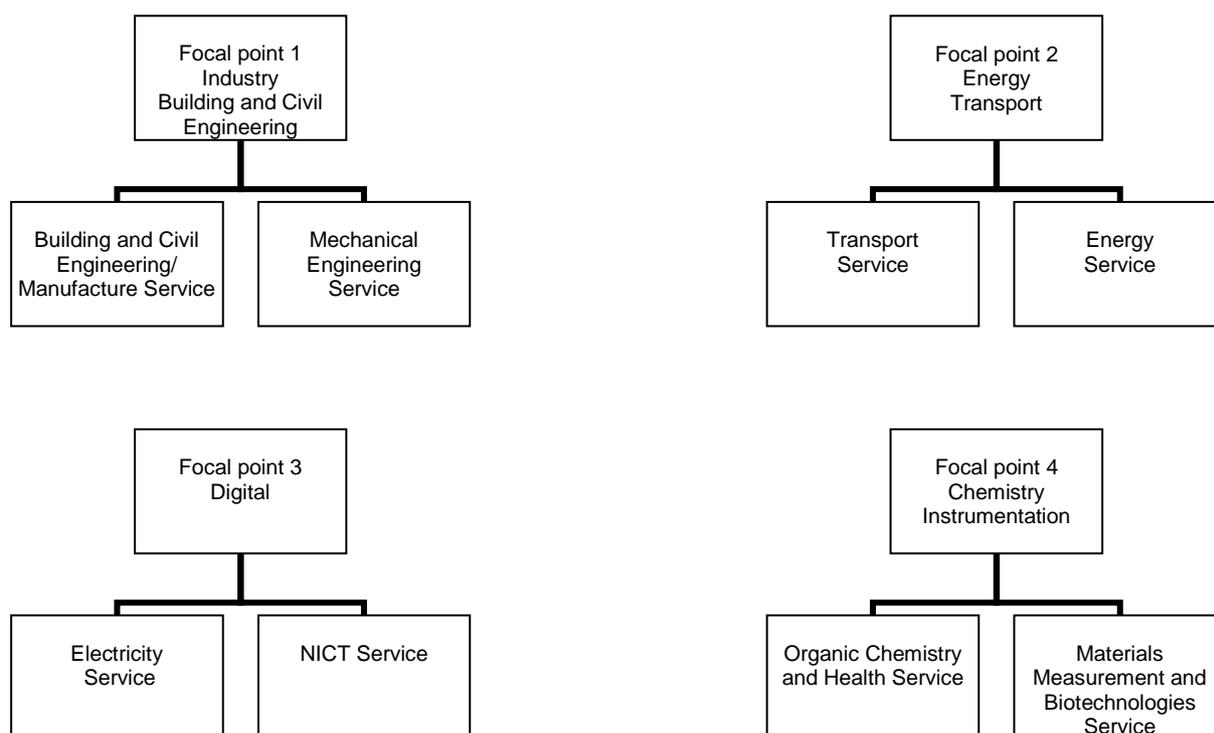
Recruitment and continuing professional development for examiners in the Patent Department:

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.

PORTUGAL

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.

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.

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

Indicator		Calculation method	Periodicity of the Analyses	Annual objective	Target
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%	-

REPUBLIC OF KOREA

The trial system related to Intellectual Property Rights is a three instance procedure which consists of the Intellectual Property Tribunal (IPT), the Patent Court and the Supreme Court. Its purpose is to promote and strengthen the protection of IPR while guaranteeing fair and prompt settlements of IPR-related disputes.

Invalidation Trial of Patent

Due to a mistake of an examiner or appeal examiners, some patents which should not have been granted may exist. In such cases, an interested party or an examiner may demand a trial to invalidate the patent, and for a patent containing two or more claims a demand for an invalidation trial may be made for each claim. The reasons for invalidation of the patent are generally the same as reasons for the rejection of a patent application.

A trial for invalidation of a patent may be demanded even after the expiration of the patent right. Where a trial decision invalidating a patent has become final and conclusive, the patent right shall be deemed never to have existed; however, where a patent is invalidated by any reason that has arisen after the grant of a patent, the patent right is deemed not to have existed from the time when such reason originated.

Korean Patent Act Article 133 (Invalidation Trial of Patent)

(1) In any of the following cases, an interested party or an examiner may request a trial to invalidate a patent. In such cases, that patent contains two or more claims, a request for the invalidation trial may be made for each claim : if three months have not passed since the date of registration publication of the patent right after registration of its establishment, any person may make a request for the invalidation trial on the grounds that the patent falls under any of the following subparagraphs (excluding subparagraph 2):

1. Where a person has violated Article 25, 29, 32, 36(1) through (3), or 42(3) or (4);
2. Where the patent has been granted to a person not entitled to obtain the patent under the main sentence of Article 33(1), or in violation of Article 44;
3. Where a person is unable to obtain the patent under the proviso to Article 33(1);
4. After the grant of the patent, where the patentee is no longer capable of enjoying the patent right under Article 25, or the patent comes to be contrary to a treaty;
5. Where a person is unable to obtain the patent for violating a treaty;
6. Where the application is amended beyond the scope under Article 47(2);
7. Where the application is a divisional application filed beyond the scope under Article 52(1);
8. Where the application is a converted application beyond the scope under Article 53(1).

(2) A trial under paragraph (1) may be requested even after the extinguishment of a patent right.

(3) Where a trial decision invalidating a patent has become final and conclusive, the patent right shall be deemed never to have existed: Provided, That where a patent falls under paragraph (1)4 and a trial decision invalidating the patent has become final and conclusive, the patent right shall be deemed not to have existed at the time when the patent first became subject to the said subparagraph.

(4) Where a trial under paragraph (1) has been requested, the presiding administrative patent judge shall notify the exclusive licensee of the patent right and any other person having registered rights relating to such patent of the purport of such request.

Number of invalidation / Number of invalidation trial (Invalidation rate)

	2005	2006	2007	2008	2009	2010
Patent	221/438	228/454	359/623	360/615	318/529	336/633
	50.5%	50.2%	57.6%	58.5%	60.1%	53.1%
Utility model	50.1%	59.4%	53.7%	56.8%	62.9%	62.5%
	202/403	148/249	160/298	134/236	110/175	85/136

RUSSIAN FEDERATION

Firstly, we note the substantive information on ensuring the quality of patents provided by the Delegation of the United States of America (document SCP/17/10).

The Russian patent office, Rospatent, shares the position of the Member States of the Standing Committee on the Law of Patents, including the United States of America, who hold that it is difficult to come to agreement on the definition of the term “high quality patent”.

Rospatent supports the work program, proposed by the American delegation, to survey the specific metrics for patent quality used by national offices. The results of this research could be taken as a basis for general recommendations on evaluating the quality of patents.

It is most timely to address this issue, given the development of contemporary patent cooperation practices that use the results from a previous search and examination performed by a patent office on a first application, or by a competent international body, before making a decision on according legal protection to the subject matter of patent law in conformity with national legislation.

Furthermore, the exchange of information on ensuring the quality of patents is an important element in the development of national patent systems.

National Goals of a Patenting System

1. In 2011, during the implementation of the framework to reduce administrative barriers and improve the quality and availability of public services in 2011-2013, approved by the Government of the Russian Federation, Rospatent activities related to according legal protection to the results of intellectual activity and to granting patents were categorized as public services.

Providing high quality public services, in particular high quality examination of applications and of the documents sent to applicants during the examination process, is one of the strategic priorities for developing the Rospatent system up until 2015.

Providing high quality public services for the protection of the results of intellectual activity is directly related to promoting and commercializing innovative developments.

Rospatent’s quality assurance policy is being developed with due consideration of the requirements of national legislation on according legal protection to the results of intellectual activity, the commitments of the Russian Federation ensuing from participation in international

agreements on legal protection of the results of intellectual activity, and the strategic priorities for economic development and innovation in Russia. The Deputy Director General of Rospatent and the Department for Supervision and Control in the field of Protection of Intellectual Property Rights are responsible for matters relating to the running and improvement of the Rospatent quality management system.

A number of specialist control subdivisions of the Federal Institute of Industrial Property (FIPS), which comes under the authority of Rospatent, are also involved in the Rospatent quality management system:

- (a) the Division for Monitoring the Quality of Public Services (Quality Service);
- (b) the Division for the Chamber of Patent Disputes (PPS Division);
- (c) the Department for International Patent Cooperation.

(a) The Quality Service undertakes activities to implement the framework to improve the quality and availability of public services, as applied to the specific activities of the examination subdivisions. The Quality Service undertakes in particular:

- routine and operational monitoring of the examination subdivisions;
- checking of complaints received from applicants;
- monitoring and technical supervision of the examination subdivisions' activities, as well as developing proposals to provide, develop and improve legal protection for the results of intellectual activity;
- drafting practical recommendations and administrative documents on the examination subdivisions' activities, which take into account the results of monitoring.

The Quality Service also produces reports, provides statistical and analytical processing of written appeals regarding the examiners' activities (including complaints), monitors the time frame for carrying out planned tasks, and organizes training and instruction for examination staff. The Quality Service includes:

- (1) the department of technological and administrative quality assurance for public services;
- (2) the department of legal quality assurance for public services;
- (3) the department for training and analysis of the quality metrics for public services;
- (4) the department for monitoring the examination subdivisions' activities.

The department for monitoring the examination subdivisions' activities was established in 2011 following the reorganization of the Quality Service.

The department is responsible for the following key tasks:

- monitoring the legislative compliance of documents prepared by examiners on intellectual property during the administrative process;
- monitoring the quality of information searches;
- developing administrative, practical, technical, information and training mechanisms, including mechanisms aimed at eliminating the breaches identified during document monitoring and their causes, and at eliminating the deficiencies and conflicts identified in the standards provided by Russian regulatory legislation and office regulatory tools;
- offering systematic, practical help, including operational assistance, to the examination subdivisions by training staff, in particular intellectual property examiners, and providing them with advice on legal and practical questions relating to the examination of patent law applications.

(b) The PPS Division is responsible for considering objections to decisions made following the examination of applications and objections to the grant of patents.

Objections are considered on a collegiate basis at a session of the PPS board with no less than three of its members present, including the chairperson and the member responsible for consideration. Consideration procedures involve checking, as part of the grounds for objection, that the results of intellectual activity are patentable and that the decision made regarding the application is valid.

The management of the PPS Division carry out internal quality control of the consideration of objections in board sessions and also monitor the decisions prepared after objections are considered, as well as checking whether deadlines for consideration are met.

(c) The Department for International Patent Cooperation carries out quality control of international search reports, written opinions and international preliminary examination reports.

2. Monitoring the quality of public services, particularly the quality of application examinations and of documents intended for applicants, is achieved by (a) ongoing, (b) routine and spot checks.

The checks reveal (c) failures in public service provision and the appropriate measures are then taken to eliminate and prevent such failures.

(a) Ongoing checks provide pre-emptive monitoring of compliance with the regulations on legal protection for the results of intellectual activity.

Ongoing monitoring is carried out by designated managers and supervisors in the examination subdivisions.

It is undertaken on a random basis before the examination documents are sent to the applicant. During the process of checking, examiners' activities and documents prepared by them are evaluated for compliance with the requirements of legislation.

Following these checks, documents prepared by examiners in breach of the requirements are returned to them for revision.

The results of monitoring are documented.

(b) Routine and spot checks monitor the integrity and quality of public services.

(b-1) Routine checks are scheduled each quarter by the specialist control subdivision. They are random checks performed once documents prepared by examiners have been sent.

During the process of checking, the integrity and quality of the public services provided are evaluated. Before the checks are carried out, aims and procedures are identified, notably the procedure for selecting documents for checking.

The results of monitoring are documented.

(b-2) Spot checks are carried out by those responsible: the Director General of Rospatent and his deputy, the directors of the subdivisions of Rospatent, the Director of FIPS and his deputies, and the directors of the subdivisions of FIPS. They carry out checks either independently, or with the involvement of the specialist control subdivision, to consider applicants' complaints, either about the actions (inaction) of examiners, or in connection with their disagreement with a decision taken.

The results of monitoring are documented.

(c) Failure to comply with legislation on established administrative procedures, office regulations or the requirements for the corresponding examination documents are classified as breaches.

(c-1) Examiners are responsible for meeting the deadlines for completing administrative steps relating to applications and their appropriate quality and integrity.

The Directors of the examination subdivisions (and their deputies) ensure that administrative procedures are completed and are responsible for organizing work to meet the deadlines for administrative procedures and their appropriate quality and integrity.

(c-2) If routine checks (b-1) or spot checks (b-2) should find breaches regarding the transmission of an illegal document to an applicant, the Director General of Rospatent, or an authorized official, has the right to recognize the document as invalid and to withdraw it.

The right to withdraw a document does not extend to a decision to grant or refuse a patent that was made following checks that the claimed subject matter of patent law is patentable.

Such decisions can be disputed by an applicant in the administrative manner provided for in the Russian Civil Code, which is by means of submitting objections to the Chamber of Patent Disputes.

Specific Metrics for Measuring Quality

A system of metrics is used to define the quality of public services provided by Rospatent.

- (a) The most important metrics for the quality of application examinations are:
- the results from monitoring searches, including international searches carried out by Rospatent as a competent International Searching Authority;
 - the results from monitoring the validity of decisions made as to whether a claimed subject matter is patentable during the application examination stage (up until a decision is made on the application);
 - the number of application decisions withdrawn by the Chamber of Patent Disputes following the consideration of objections by an applicant;
 - the number of application decisions made by the Chamber of Patent Disputes following the consideration of objections that are appealed in court;
 - the results from monitoring compliance with established administrative procedures, including deadlines and the rules for preparing examination documents;
 - the results from monitoring examiners' activities for a consistent approach to the examination of applications;
 - the number of applicants' complaints regarding the actions (or inaction) of examiners or in connection with application decisions that are found to be valid.

Analytical reports are drafted on the basis of these metrics, gathered from ongoing, routine and spot checks, noting the breaches discovered and the reasons for them, as well as suggesting measures to eliminate and prevent such breaches.

The reports are presented to the management of Rospatent and FIPS in order to find balanced solutions, designed to ensure the provision of quality public services. This includes the holding of thematic training for examiners, developing practical recommendations for examiners' problem areas and taking disciplinary measures against examiners who make errors. The results of the consideration of complaints are published quarterly on the Rospatent and FIPS websites, and at the end of the reporting year in Rospatent's Annual Report.

- (b) The metrics for the quality of public service provision are:
- the number of applications registered;
 - the number of examinations carried out and the number of decisions made;
 - the average time taken to examine an application;
 - the number of patents granted and the time taken to grant them;
 - the number of agreements and deals registered;
 - the number of valid complaints (as a percentage of the overall number of applications filed);
 - the number of decisions to grant and refuse patents for applications (including as a percentage of the overall number filed);
 - the number of objections to application decisions submitted to the Chamber of Patent Disputes;
 - the number of those objections granted and refused (including as a percentage of the overall number of objections);
 - the number of objections against granting patents brought before the Chamber of Patent Disputes;
 - the number of those objections granted and refused (including as a percentage of the overall number of objections);
 - the number of patent application decisions appealed in court.

The metrics for the last five years, including the financial reporting year, are published in the Rospatent Annual Report, which can be found on the Rospatent website (<http://www.rupto.ru/>).

The given metrics are used to determine Rospatent's strategic direction and to develop short and long-term programs to that end, including activities to ensure the provision of high quality public services.

SPAIN

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.

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 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.

(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?

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.

(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.

(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.

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.

[End of Annex and of document]