

Standing Committee on the Law of Patents

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RESPONSES TO THE QUESTIONNAIRE ON THE TERM “QUALITY OF PATENTS” AND COOPERATION BETWEEN PATENT OFFICES IN SEARCH AND EXAMINATION (PART 1)

Document prepared by the Secretariat

INTRODUCTION

1. At its twenty-fourth session, held in Geneva from June 27 to 30, 2016, the Standing Committee on the Law of Patents (SCP) agreed that the Secretariat would prepare, based on the information received from the Member States and regional patent offices, a compilation of information gathered by the Questionnaire on the Term “Quality of Patents” and Cooperation between Patent Offices in Search and Examination that contains the following elements:

- how each Member State understands “quality of patents”; and
- implementation of cooperation and collaboration between patent offices in search and examination of patent applications, including experiences, their impacts, exchanging search strategies, tools to share information and capacity building needs in the area of such cooperation and collaboration. (See document SCP/24/5, paragraph 17).

2. Pursuant to the decision, above, Member States and regional patent offices were invited, through Notes C. 8625 and C. 8626 dated January 16, 2017, to respond to the Questionnaire, which contained six questions relating to the above subject. 57 Member States and two regional patent offices¹ responded to the Questionnaire. The original responses are available

¹ Argentina, Austria, Bahrain, Belarus, Bosnia and Herzegovina, Canada, Cape Verde, Chile, China, Costa Rica, Czech Republic, Denmark, El Salvador, Estonia, Finland, Gabon, Gambia, Georgia, Germany, Guatemala, Honduras, Hungary, Iceland, Italy, Ivory Coast, Japan, Kazakhstan, Kenya, Kuwait, Latvia, Liechtenstein, Mexico, Moldova, Morocco, Namibia, Norway, Oman, Panama, Philippines, Poland, Qatar, Romania, Russian Federation, Saudi Arabia, Singapore, Slovakia, Spain, Switzerland, Tajikistan, Thailand, Turkey,

on the SCP electronic forum website at:
http://www.wipo.int/scp/en/meetings/session_26/comments_received.html.

3. This document is Part 1 of the said compilation document, in which responses to Question 1 are summarized. The responses to Questions 2 to 6 are summarized in Part 2 of the said compilation, which is contained in document SCP/26/4.

QUESTION 1

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”?

4. As explicitly clarified by some countries, no legal definition of that term seems to exist. The intention of Question 1 is rather to gather information on how each IP office understands that term. In general, two main concepts emerged from the responses. The first concept is that the term “quality of patents” relates to the quality of a patent itself, while the second concept is that the term is understood in the context of the patent grant process within the IP offices. Some responses referred to the first concept only,² and some other responses touched upon the second concept only.³ Many countries, however, discussed the both notions in their responses.⁴ As it will be explained below, those two concepts are closely related to each other.

5. Of responses in which the quality of patents is understood in such a way that it relates to the quality of a patent itself, the majority stated that a high quality patent shall meet the legal requirements prescribed in the applicable law. Most commonly, the responses refer to the compliance with the patentability criteria, which are patentable subject matter, novelty, inventive step, industrial applicability as well as sufficiency of disclosure and the requirements regarding claims. According to those responses, a patent that meets the legal requirements has a high presumption of validity, and would most likely not be revoked if it is challenged. This will create legal certainty for both the patent holder and third parties. In some responses, such patents are called “robust” patents.⁵ The response of Singapore stated that robust patents would increase the level of confidence that stakeholders and investors can give in its patent regime.

[Footnote continued from previous page]

Turkmenistan, Ukraine, United Kingdom, United States of America, Uzbekistan, Zambia, Eurasian Patent Office (EAPO) and European Patent Office (EPO).

² Responses from Belarus, Gabon, Guatemala, Iceland, Ivory Coast, Japan, Latvia, Ukraine and Uzbekistan.

³ Responses from Honduras, Kazakhstan, Kuwait, Moldova, Philippines, Saudi Arabia, Thailand and Turkmenistan.

⁴ Responses from the following Member States and regional patent offices referred to both concepts: Austria, Bosnia and Herzegovina, Canada, China, Costa Rica, Denmark, El Salvador, Estonia, Finland, Gambia, Georgia, Germany, Hungary, Italy, Kenya, Mexico, Morocco, Namibia, Norway, Panama, Poland, Qatar, Romania, Russia, Singapore, Slovakia, Spain, Switzerland, Turkey, United Kingdom, United States of America, Zambia, EAPO and EPO.

⁵ For example, the responses from Chile and Singapore.

6. Although some countries relate high quality patents to the patents that comply with substantive patentability criteria, some other responses refer to all legal requirements or make a reference to formality and substantive examination, which may imply that compliance with not only the patentability criteria but also any other requirements under the applicable law are relevant to the quality of patents.⁶

7. In the context of an IP office engaged in granting high quality patents as understood in the sense described above, quality patents are closely related to quality of a patent granting process within that office, since the former is the desired “outcome” (patents), while the latter is the process that leads to that outcome. From that perspective, it is not surprising to find that many responses indicate both quality of a patent itself and quality of patent granting process as the elements that form the understanding of the term “quality of patents”. The European Patent Office (EPO), for example, states that “the patent grant process itself should offer the highest possible level of legal certainty.”

8. Many responses further elaborated on how they understand the high quality patent granting process.

(i) Search and examination process

Many offices consider that the search and examination process should be thorough and comprehensive, complying with the applicable law and the established standard. For example, the response from Singapore noted that the process should provide valid, reliable and consistent search and examination products and services. The EPO stated that identification of prior art and reasoning of decisions should be relevant and comprehensive. Some responses⁷ pointed out that in order to ensure a thorough prior art search during the patent granting procedure, examiners need proper search tools and databases.

(ii) Timeliness

Timeliness of office actions and decisions are also mentioned by many countries.⁸

(iii) Skilled staff

The importance of well trained staff having sufficient skills to carry out their duties is highlighted in some responses.⁹ To ensure having skilled staff, various IP Offices conduct regular training of their staff.¹⁰ In this regard, the response of the United Kingdom, for example, pointed out the importance of having good management and leadership.

⁶ For example, responses from Bosnia and Herzegovina, Costa Rica and the United Kingdom.

⁷ For example, responses from Finland, Honduras, Kazakhstan, Guatemala, Mexico, Moldova, Morocco and Singapore.

⁸ For example, responses from Canada, Chile, Denmark, El Salvador, Gambia, Hungary, Italy, Mexico, Namibia, Norway, the Russian Federation, Slovakia, Spain, Thailand, Turkey, the EAPO and the EPO.

⁹ For example, responses from Cape Verde, Germany, Kazakhstan, Mexico, Panama, Singapore and the United States of America.

¹⁰ For example, responses from Finland, Mexico, the United States of America and the EPO.

(iv) Communication and transparency

In addition to the above, some offices noted the aspect of a transparent process and communication between the office and stakeholders.¹¹ For example, the EPO referred to the public availability of search and examination results, and Norway referred to good contact and dialogue with users.

9. As a measure to monitor the patent granting process, some countries indicated their quality management systems introduced within their respective IP offices.¹² For instance, the United States Patent and Trademark Office (USPTO) has been implementing the Enhanced Patent Quality Initiative which focuses on improving the quality management mechanisms of the Office by institutionalizing best practices and strengthening the USPTO's work products, processes, and services at all stages of its patent granting process. The IP office of the United Kingdom responded that it implemented a review and audit system for search and examination work. Under such system, a senior staff would review, on a random basis, a sample of completed patents work. Some responses¹³ also stated that their national IP Offices obtained the ISO 9001 certification.

10. In addition, a clear and strong legal framework, including provision of clear legal requirements, is mentioned in some responses.¹⁴

11. Furthermore, some responses explicitly noted that not only the search and examination process but also the entire prosecution procedure before the office is relevant to the quality of the process. For example, the response of the United Kingdom stated that its quality management system was linked to other processes beyond the search and examination within its office. Similarly, Canada includes classification and operations (support) processes in its quality management.

12. Some offices understand that quality of patents includes, or is influenced by, the elements that are beyond the patent prosecution and grant. For example, the response of Switzerland stated that the quality of patents was influenced by its entire "environment", including enforcement processes as well as judicial processes before courts. Singapore observed that some of the parameters defining the quality of patents tend to be inextricably linked to the technological maturity of an invention and/or the patent strategy of the applicant.

13. In addition to the elements, above, some responses outlined further aspects to be considered when defining the term "quality of patents". The response of China, for example, stated that while providing a definition of quality of patents at the national, regional and global levels was a complex endeavor, in general, the following aspects could be taken into account: the extent of technological innovation; the drafting of patent documents; the stability of patent rights; the validity period of patents; and the utilization of patents. The Japan Patent Office (JPO) considers the quality of a patent to be high, where the patent satisfies the following three elements: (i) the patent will not be invalidated afterwards; (ii) the scope of the patent corresponds to the disclosure of the invention and the extent of its technical level; and (iii) the patent is recognized around the world.

¹¹ For example, responses from Norway, the United States of America, Zambia and the EPO.

¹² For example, responses from Denmark, El Salvador, Finland, Germany, Poland, Singapore, Spain, Turkey, the United Kingdom and the United States of America.

¹³ For example, responses from the Czech Republic, Estonia, Finland, Moldova, Poland, Romania, Singapore and the United Kingdom.

¹⁴ For example, responses from Italy, Mexico and Zambia.

14. The response of the Eurasian Patent Office (EAPO) noted that quality of patents meant different for each stakeholder in different contexts.¹⁵ A patent holder may consider that a quality patent means a reliable patent from the viewpoint of enforcement, litigation and commercialization (for example, granting licenses). Applicants may seek patent applications that disclose the technical information only to such extent that is required by law, and allow him to apply for the broadest possible protection. For the beneficiaries of transfer of technology, a quality patent would be a patent that discloses all the aspects of the patented invention. Yet, from the viewpoint of the social interest, a patent quality may mean that the right conferred by a patent is proportionate to the contribution of the invention to the state of the art. Similarly, the response of Romania emphasized the importance of the right balance between granting an adequate rights to a patentee and preserving the public's right to exploit the public domain. The responses of Namibia and Gabon also referred to the perspective of the users of the patent system and economic benefits of patents, respectively.

15. In addition, some of the responses highlighted various social benefits that quality patents would provide. Response of Mexico indicated that high quality patents were necessary to promote innovation, transfer of new technologies and economic development and competitiveness. Similarly, the response of Argentina noted that quality patents promoted, among other public policy goals, the well-being of populations and access to health.

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¹⁵ See also the response from the United States of America.