

Standing Committee on the Law of Patent

Portuguese Comments on Circular C. 8261

Circular C. 8261 asks for the submission of comments on four topics: "Exceptions and limitations to patent rights", "Quality of Patents", "Confidentiality of communications between clients and their patent advisors" (documents SCP/14/2, SCP/16/4 Rev., SCP/17/5 and SCP/18/6) and "Transfer of Technology".

Considering these topics, our comments are as follows:

Exceptions and limitations to patent rights

Relating to this topic, the Portuguese Institute of Industrial Property has already submitted the responses to the questionnaire on exceptions and limitations to patent rights. The PT Office shall inform that there has not been any change in the national applicable law relating to these matters and therefore it is not necessary to update the information already sent.

The input relating to the implementation of the five exceptions and limitations referred in Circular C. 8261 was already contemplated in the responses to the questionnaire on exceptions and limitations to patent rights.

Quality of patents

The PT Office is involved in the PPH (Patent Prosecution Highway) network and has agreements with Spain, Japan, United States, and with Hungary starting next week. Among other advantages, these PPH agreements allow a quicker decision on patentability and improve the overall patent quality. We are also involved in other work-

sharing projects such as UIP project, which is a project developed by EPO, whose benefits are: increased efficiency; avoidance of unnecessary duplication of work and improved quality of second filings (if the EPO can make use of work done by the NPO on classification, cited prior art and substantive examination issues, if applicable); and improved quality will result by the availability of national prior art documents possibly not available to EPO examiners.

PT Office develops patent examiner exchange programs with other Offices, such as Spain, Japan and Brazil, which allow a greater proximity between Offices, and the sharing of best practices on examination procedures.

We also conduct training courses for patent examiners from other Offices, such as the Portuguese-speaking African countries.

Regarding the cooperation between member states, the PT Office also refers that have developed, during 2009-2010, a virtual cluster with the Spanish Office. This cluster intended to create a common working practice and stimulate the transfer of knowledge skills and expertise between examiners. The PT Office is also currently cooperating with the Spanish Office in the elaboration of Technological Surveillance Bulletins on Ocean Energies, which aims to provide a quarterly monitoring of the latest news and publications of international patent applications in the technical field of Ocean Energies. In order for it to be a useful tool for both Portuguese and Spanish applicants, this document is made available both in Portuguese and in Spanish.

The PT Office always takes into account the work done by other Patent Offices, both in search and examination, in order to complement its own work. The PT Office has the possibility to consult search reports, written opinions and other documents available in Epoline Register Plus and PatentScope, as well as in other national offices' websites. As an example, the PT Office uses, when available, the international reports produced by ISA authorities in the international phase of a PCT application, for helping the production of its own examination report in the national phase of that PCT application. 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 considered by the ISA authority. Document sharing among offices, as well as sharing best practices, allows an improvement of the quality of patents.

**Confidentiality of communications between clients and their patent advisors
(documents SCP/14/2, SCP/16/4 Rev., SCP/17/5 and SCP/18/6)**

On this issue, PT, as a Member State of the European Union, has no specific legislation regarding the confidentiality of communications between a patent attorney and his client.

Currently, the patent attorneys who are members of ACPI (Portuguese Association of Industrial Property Consultants) are bound by ethical rules of the association and of the relevant technical international federation (FICPI). The patent attorneys who are also attorneys at law are as well subject to the rules established by their own professional bar that recognizes the obligation of confidentiality in communications with customers.

Thus, although there are no legally prescribed penalties in such cases, the duties of confidentiality are generally safeguarded in the national territory.

That is not true, however, at the international level, since there are no worldwide regulations regarding the subject, thus placing it at the mercy of disparities within the various jurisdictions. This lack of international regulation on the issue of confidentiality is more disturbing considering that the information contained in patent documents usually takes a cross-border character which would require that non-disclosure rules should have a transverse nature among several countries.

As patent advisors are often subject to distinct rules which called into question the confidentiality of communications, it is our opinion that the international patent system would benefit from the achievement of a common solution between the different Member States to ensure confidentiality of communications.

Therefore and as already stated by the European Union and its Member states, we think that the convergence of existing diverse systems in the area of confidentiality of communications between clients and patent advisors among WIPO Member States would be beneficial for users of the patent system.

Taking this into consideration, and in order to prevent that attorneys professional advice would be subject to distinct rules, which can often call into question the

confidentiality of the patent, it is clear that the international IP system would benefit if a common solution was achieved between the different States to ensure confidentiality.

Transfer of technology

The PT Office does not have expertise in the area of technology transfer and therefore is unaware of any patent-related incentives and impediments.

28th June 2013