

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

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

Country:

Office: Eurasian Patent Organization
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Person to be contacted:

Name: Aurelia Ceban
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Title: Head, Department of Appeals and Quality Control
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E-mail: aceban@eapo.org
.....

Telephone: +7 (495) 411 61 58
.....

Facsimile:
.....

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”?

A 1. Quality of patent has different meanings for different stakeholders in different contexts – for a patent holder it is important to have a reliable patent from the point of view of its viability when it is enforced or litigated and of its commercialization value (i.e. when it is licensed); for an applicant it is of most importance to have a good description of his invention disclosing the technical information at minimum but sufficient to realize (reproduce) the invention and to have as broad a scope of protection as possible; while for beneficiaries of transfer of technologies a good patent means a maximum disclosure of all of the invention’s technical aspects; from the point of view of the society interest the patent quality means a patent monopoly commensurable to contribution of invention to the state of the art.

The main task of a patent office is to strike a balance between the rights of applicants / patent holders and interest of the society by ensuring the quality of granted patents.

The term “quality of patents” from our patent office perception includes two main elements managed totally by the office - the quality of granted patents and the quality of examination processes, and other two elements which go beyond the IPO competence - the quality of patent applications and the quality of the patent system, including the system of IP rights enforcement.

As EAPO is an intergovernmental organization, the main function of which is the grant of Eurasian patents, the term of “quality of patents” is presented thus from the perspective of aspects (elements) related to this EAPO activity.

The term “quality of patents” is treated in its large sense and covers the meaning of the quality of the product or service provided by the office (the quality of patent as such) and also the meaning of the quality of product realization processes (quality of examination).

The quality of patent is understood as:

- strict compliance of granted patent with statutory requirements (on patentability, clarity of claims, unity of invention);
- the scope of protection is clearly defined and corresponds to the contribution of invention to the state of the art and to the limits of disclosure in patent application as filed;
- in opposition procedures / litigations the patent is maintained as granted or in amended form.

The quality of examination is understood as consistency and effectiveness of examination processes, including search, organized and performed in efficient way resulting in granting a qualitative patent (or taking a correct final decision) in the least number of office actions (examination efficiency).

The quality of examination is characterized by following elements:

- compliance of patent examiner actions with statutory requirements (reasoning of decisions, non-omitted and non-pertinent decisions, interpretation of the prior art etc.);
- timeliness of search/examination actions;
- optimisation process that balances the quality of granted patents and timeliness of office actions;
- consistency of technological, methodological, organizational and normative regulatory support aspects of processes.

It is clear that the quality of granted patent is directly related to the quality of processes (procedures).

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.

A2.

1) Under bilateral agreements:

- access to documents/databases of EPO, Rospatent, JPO, SIPO, KIPO;

- Rospatent's Federal Institute of Industrial Property carries out international-type searches for some Eurasian applications.
- 2) PPH agreement with JPO.
- 3) Under preparation PPH agreements with EPO and SIPO.

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?

A3. No

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.

A4.

(i) Platform and tools provided by EAPO:

- EAPATIS search and retrieval system – available to public with limited functionality, accessible by some IPOs and other institutions with full functionality, used by EAPO patent examiners
- internal patent prosecution infrastructure SOPRANO and E-PHOENIX – not accessible directly by other IPOs, but serve as sources of data provided upon request.

(ii) Platform and tools used by EAPO:

To retrieve information on search and examination work products:

- IP5 offices - Global Dossier
- EPO – EPO Registry
- USPTO – USPTO Registry
- SIPO – CPES (Cloud Patent Examination System)
- WIPO – WIPO CASE (as accessing office)

For patent search purposes:

- EPO – EPOQUE
- ESPACENET
- RU – PatSearch (Since April, 2017)
- USPTO – database at website
- WIPO – PatentScope
- JPO – JPO IPDL
- External DBs of other IP offices.

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.

A5.

- Increased quality of search and examination by using additional prior art searches on applications pertaining to the same patent family.
- Increased quality of examination by consulting (not mandatory using!) opinions/reasons on patentability provided by others IPOs on applications pertaining to the same patent family.
- Reduced terms of patent examination - Accelerated examination under PPH and EAPO's fast track initiative
- Work share is a source of improvement of one's own patent system by using the best practices of other IPOs
- Work share is a good source of self-evaluation and self-training of patent examiners.

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 between offices in search and examination.

A6.

- 1) Development of language skills of examiners
- 2) Continuous improvement of machine translation tools
- 3) Development of tools for interaction of patent examiners (online, web forum etc.) from different IPOs involved in examination of patent application pertaining to the same patent family
- 4) Exchange of experience between patent examiners of IPOs involved in bi- or multilateral agreements
- 5) Training of examiners on:
 - use of patent classification
 - search strategies
 - evaluation of patentability criteria under the national/regional law and, in case of bilateral agreements on work share, on differences in approaches used by collaborative IPOs, in order to have a better understanding of the reasoning/grounds on work products provided by other IPOs.