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

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

Country: Finland
Office: Finnish Patent and Registration Office

Person to be contacted:

Name: Mr. Jani Päiväsaari
Title: Head of Division for Chemical Technology, Patents and Trademarks
E-mail: jani.paivasaari@prh.fi
Telephone: +358 9 6939 5842

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”?

First of all, the quality of patents relates to legal certainty for the patent holders and third parties that granted patents are valid. In order to guarantee legal certainty, the authority has to perform novelty searches of high quality and transparently assess the patentability. The quality of patents relates to patent information. The authority has to make sure that granted patents (incl. abstract), and hence publications, are drawn up according to requirements laid down in national and international regulations and guidelines.

In order to meet the high quality standards for patents, The Finnish Patent and Registration Office (PRH) has, over the years, put into operation various quality improving procedures. PRH strives for continuously improving operational quality.

The Finnish Patent and Registration Office has an extensive quality management system. PRH obtained the first ISO 9001:2000 certificate for its PCT process (RO, ISA and IPEA) in 2006. In 2007, the certification was expanded to cover also the national patent application process. The latest certification was conducted by the certification body in autumn 2016 according to the revised standard ISO 9001:2015. The certificate now covers the processing of utility models, the processing of national patent applications, and the processing of international applications under the PCT.

Training of examiners is an integral part of operational quality. At PRH, the new examiners undergo 18 months of training to develop their patent search and examination skills. The training program consists of classroom lectures, project exercises and on-the-job training under the guidance of a personal tutor. The existing experienced examiners participate in advanced or expert level courses, seminars, and distance learning courses offered by the European Patent Academy (EPO) as well as

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scientific conferences and other seminars. The examiners taking part in education in the European Patent Academy have an obligation to train afterwards other examiners at PRH. Typically, over 10 examiners attend annually different courses and seminars organized by the European Patent Academy (EPO).

High operational quality cannot be reached without proper search tools. At PRH, the patent examiners have all the necessary equipment (hardware and software) for performing efficient and high-quality searches and examinations. The examiners have access to EPOQUENET and several other databases and search tools (e.g. STN) in order to meet the requirement for the minimum documentation referred to in PCT Rule 34. The examiners also have access to translation databases including the biggest Asian countries (China, Japan and Korea). Commercial patent database WPI and non-patent literature databases such as EMBASE, IEEE, INSPEC and MEDLINE are also accessible via EPOQUENET. The STN application is also available for the examiners. STN, containing databases such as CAS registry, USGENE and DGene, is used for searching mostly in the fields of chemistry and biotechnology. Through EPOQUENET and other search tools and portals, the examiners have access to a wide range of journals and other non-patent literature.

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.

The PRH has made Patent Prosecution Highway (PPH) agreements with a number of patent offices. The agreements also involve information exchange, resulting in less overlapping search and examination, and improved patent quality. However, at the PRH, searches and examinations are based on Finnish legislation (the Patents Act, Patents Decree and Patent Regulations). Therefore, PRH is responsible for its own decisions and the opinions of the other PPH offices do not bind PRH.

It should be emphasized that, generally, PRH is open to any collaboration projects but due to limited resources PRH has to prioritize which programs or projects it can join.

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?

When performing a prior art search, examiner at PRH prepares a full search strategy including all the queries. The search strategy is based on a Casper file recorded during the Epoquenet session.

When acting as an international search and examination authority for PCT applications, PRH shares the search strategies via PATENTSCOPE.

Q4. In order to facilitate the cooperation, what kinds of platforms and tools to share information on search and examination are available in your office? Such platforms and tools include, for example, WIPO CASE, databases allowing other offices to retrieve information and external databases used to retrieve information.

(i) Platforms and tools provided by your office

(ii) Platforms and tools used by your office

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- (i) Federated EP Register retrieves from PRH's database (PatInfo) up-to-date information about status of European patents validated in Finland.

PRH sends to EPO data packages containing bibliographic information and BNS images of Finnish patent applications and publications. PRH also takes part in the Quality at Source –project between EPO and national offices. Hence, Finnish patent applications can be comprehensively searched by using Epoquet, Espacenet, and Open Patent Service (OPS).

PRH shares the search strategies it prepares for PCT applications via PATENTSCOPE.

PRH uploads priority documents to the Digital Access Service (DAS).

- (ii) PRH retrieves from Open Patent Service (OPS) bibliographic information about prior art documents when generating search reports.

PRH retrieves priority documents from the Digital Access Service (DAS).

Examiners at PRH may retrieve earlier search and examination results from PATENTSCOPE.

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.

The foreign search and examination work are utilized by examiners whenever possible. If the examiner can start an examination with earlier search work at hand, the resulting quality of the patent issued can be expected to be higher. The presence of work from other patent offices serves a good starting point for the examiner. However, it should be noted that searches and examinations are based on Finnish legislation and guidelines. Therefore, PRH is responsible for its own decisions and the opinions of other offices do not bind PRH.

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.

PRH has no specific needs in this respect.