

Questionnaire on the Term “Quality of Patents” and Cooperation between Patent
Offices in Search and Examination
January 16, 2017

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

Country: ...Portugal.....

Office: ..National Institute of Industrial Property – INPI (Lisbon).....

Person to be contacted:

Name: ..Ana Margarida Bandeira.....

Title: ...Head of Trademarks and Patents Directorate.....

E-mail: ..ana.m.bandeira@inpi.pt.....

Telephone:

Facsimile:

Questionnaire circular C.8625

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”?

For the Portuguese Office, quality of patents is a very important subject. As expressed in its mission, vision and values, the key meaning of quality is to ensure customer satisfaction but above all to provide an excellent service to customers, taking into account legal requirements, within the established deadlines.

We believe that “patent quality” is a term that should not only be assessed by the final result. All steps leading to the final product should be monitored. Therefore, the Portuguese Office has quality indicators for process and product, with the goal of evaluating the compliance degree of its objectives. In what concerns the process level, Portuguese Office has indicators regarding timeliness associated to search reports and written opinions, formal examination, examination and provisional patent applications. At the product level we have indicators regarding number of non conformities detected and number of major nonconformities detected in product internal audits.

Regarding “Quality of patents”, it can be also defined as the compliance of patentability requirements, according to the national law in a transparent way. The definition and application of the patentability requirements – novelty, inventive step and industrial application – are undoubtedly important elements to take into account when evaluating the quality of patents. It is also important to monitor internal procedures and results that allow detecting, correcting and preventing mistakes and thus ensure that offices grant patents with

quality. Therefore, Portuguese Office develops internal and external audits to its services and to its products (as mentioned above), in order to investigate if quality requirements and goals are being effectively developed and completed. The internal audits to the products are made before the final decision, thus allowing changes to the process based on the results of the audit. These changes are made if a non-conformity is identified. Hence, this type of audit procedure allows the detection of mistakes and the implementation of corrective measures.

Concluding, we believe that “quality of patents” is also related with the quality of the applications filled in national offices, being thus able to produce a high quality final product.

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 Portuguese office is involved in Global PPH project (Patent Prosecution highway) and additionally has bilateral PPH agreements with Mexico and China. Among other advantages, these PPH agreements allow a quicker decision on patentability and improve the overall patent quality.

The Portuguese Office developed, in the beginning of 2009, a virtual cluster with the Spanish Office. This cluster consisted of a virtual team of patent examiners of the two offices, with the aim to develop, together, search activities of patent applications in specific technological areas. This specific cooperation is no longer in force. However, the Portuguese Office has other type of cooperation with the Spanish Office that is not related to search and examination. We elaborate Technological Surveillance Bulletins on Ocean Energies that aim to provide a quarterly monitoring of the latest news and publications of international patent applications in the technical field of Ocean Energies. In order to be a useful tool for both Portuguese and Spanish applicants, these bulletins are produced in both Portuguese and Spanish.

Furthermore, the Portuguese office and The Cape Verde Institute of Quality Management and Intellectual Property (IGQPI) signed in 2016 an agreement in which the Portuguese Office collaborates, upon request of IGQPI, in the analysis of patents (search and examination).

The Portuguese Office has also promoted in the past exchanges between Portuguese patent examiners and patent examiners from other Offices, such as Spain, Japan and Brazil, and has conducted specific training courses for patent examiners from other Offices, such as Brazil, and Portuguese speaking African countries.

The Portuguese office belongs also to IBEPI – Ibero-american Industrial Property program. IBEPI is an international program framed within the Ibero-American cooperation, whose goal is to promote the strategic use of industrial property as a tool for the development and integration of the Ibero-American communities.

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?

The Portuguese Office does not share search strategies and queries. We only make available search reports and written opinions in the Industrial Property Bulletin (BPI) (<http://www.marcaspatentes.pt/index.php?section=37>).

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

In the Portuguese office search reports and written opinions together with the corresponding applications are available in the Industrial Property Bulletin (BPI). This Bulletin is published every day and can be accessed by any person or office for consultation.

Also, the Portuguese Office sends to EPO's and WIPO's databases its national patent documents in order to make them available worldwide.

(ii) Platforms and tools used by your office

The Portuguese 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 Portuguese Office consults information on search and examination in Espacenet and Epoline Register Plus and PatentScope, as well as other national offices' websites.

Furthermore, the Portuguese office is in the process of joining *WIPO Case* as Accessing Office.

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.

In general, cooperation projects that include document sharing make easier the process of search for the national examiner and thus avoid duplication of work.

The Portuguese Office always takes into account the work done by other Patent Offices, both in search and examination, in order to complement its own work. However, even if there is already a report made by another office, the Portuguese examiners always do their own search and examination and elaborate their own reports.

The Portuguese 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 Portuguese Office uses, when available, the international reports produced by ISA authorities in the international phase of a PCT application, to help the production of its own examination 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.

On another perspective, exchange of examiners allows creating a common working practice and also allows the transfer of knowledge skills and expertise between examiners and avoids duplication of work.

These projects also allow sharing examination and search best practices and consequently it allows an improvement of the quality of patents.

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.

In our opinion, to conduct cooperation projects successfully is important the exchange of examiners for training.

In a more procedural approach, It is also important the following aspects:

- define specially the aim of the cooperation and the final goals. For instance, a memorandum between the offices involved in the project can be signed, specifying these objectives and the responsibilities of each partner;
- create computer tools for information sharing;
- exchange of experiences between the offices involved.

Also, other type of capacity building can be developed to conduct cooperation projects successfully. For instance, it can be developed a platform where the examiners working directly in the cooperation project can exchange opinions, ask questions and discuss real cases. Furthermore, the creation of specific training courses among offices for patent examination in certain technical areas, seeking best practices, will enhance the capacity of each Office.

Likewise, organizing workshops and debates on more controversial issues, involving not only offices but also other users of industrial property (such as patent attorneys and IP organizations), will support the development of knowledge and skills of office employees.

We also believe that keeping patent examiners up-to-date is very important, not only in respect of in-house work, but also for cooperation projects. Thus, in the Portuguese Office there is a training and development program for all examiners, which involves: initial PI training (70h) (about patentability requirements, patent databases, exam), and national or international training for improving and acquire specialized skills, and other trainings/courses whenever necessary. As an example, examiners attend every year EPO training events, as well as the online and webinar provided by this organization and also by WIPO. Portuguese patent examiners also periodical attend scientific conferences to be up-to-date with the new developments in Science.