Response by the Spanish Patent and Trademark Office to the questionnaire included in Circular No. C.8625 on "Quality of patents, including opposition systems"

Q1.   How does your office understand the term "quality of patents"?

The Spanish Patent and Trademark Office (OEPM) considers that the concept of "Quality of patents" is multifaceted. A patent may be considered to be of good quality in the following circumstances:

(a) It was granted following a rigorous examination of the compliance by the invention that is the subject of the patent with patentability and other requirements established in legislation, such as sufficiency of description.

(b) It is able to pass all tests to which it may be subjected after the grant, such as oppositions, administrative appeals and judicial proceedings.

(c) The description and in particular the claims are properly drafted, with a level of detail that is in accordance with the existing state of the art, which makes it difficult to "bypass" it without infringing it and makes its infringement easily detectable; in short, making it possible for the claims to form the basis of a successful business strategy.

(d) As regards the work of the OEPM, the OEPM is responsible for performing the task under point (a) above. In order to ensure that the patent granting procedure is properly applied, that the patent is granted without delay and with an efficient use of resources, a quality management system must be implemented, as the OEPM does.

Q2.   What experiences does your office have with respect to cooperation with other patent offices in the area of search and examination?

The OEPM does not conduct searches for other national patent offices, although it is an International Search and Examination Authority under the PCT for applications filed in Spanish in most Ibero-American countries.

Moreover, the OEPM does not commission searches or examinations from other national or regional patent offices.

The OEPM maintains a cooperation agreement with the European Patent Office (EPO) whereby patent examiners receive training in searching and examination. Also as a result of this cooperation with the EPO, there are regular exchanges of experiences in relation to the searching and examination of patents in specific technical sectors.

Thanks to the cooperation with the EPO, OEPM examiners have access to the EPOQUE platform, which includes a series of patent databases and non-patent literature in which it is possible to perform very comprehensive searches.

The OEPM has entered into cooperation with the EPO for a project to harmonize searches on PCT international applications.

In addition, the OEPM has cooperated with WIPO in the drafting of a manual for the organization and examination of patent applications for the countries of the Central American isthmus and the Dominican Republic.

The OEPM offers training in searching and examination through on-line courses and 6-month training on-onsite at the OEPM, with lecturers and examiners from Ibero-American countries. Examiners from other regions also visit the OEPM regularly. The OEPM also regularly hosts examiners for 3-5 days to learn the working methods of OEPM examiners.

The OEPM participates in the provision of examination and search courses in Latin American countries, with funding from the Spain Fund in Trust (FIT/ES) in WIPO for cooperation with Ibero-America.

Spain also cooperates with Portugal in the preparation of a technological surveillance bulletin for maritime energy and in the preparation of two technological surveillance bulletins within the Ibero-American Industrial Property Program (IBEPI).

The OEPM also participates, in cooperation with the EPO and WIPO, in the development of the LATIPAT (Patent Documents of Ibero-American Countries) database.

Spain has also signed agreements to reuse PPH-type work with the People's Republic of China, Colombia, Japan, Mexico, Finland, Peru, Taiwan, Morocco, Russia, Turkey and the global PPH.

Q3.   When performing on-line prior art search, patent examiners prepare a set of search queries to find relevant prior art. Does your office share (for example, via an official website), or exchange, such search queries with other offices?

OEPM patent examiners prepare strategies and search terms. Under the Utilisation Implementation Project (UIP) program, the OEPM provides the EPO with search strategies for Spanish applications that have priority over European patent applications.

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

The OEPM participates in the UIP with the EPO, by transmitting to the EPO a copy of the Search Report and the Written Opinion of those Spanish patent applications whose priority claims rely on European patent applications.

Q5.   What are the impacts of such cooperation to your office? If your office has different types of cooperation and each type of cooperation has different impacts, please indicate them separately.

Cooperation from a training point of view has the impact of better trained professionals, which means that patents granted are of higher quality.

The exchange of experiences with examiners from other national and regional offices makes for a degree of harmonization of practices in relation to searching and examination.

The UIP program reduces the administrative burden for Spanish applicants for European patents who have claimed a previous filing in Spain, since under rule 141(1) of the European Patent Convention it is mandatory to provide such information to the European Patent Office.

Furthermore, PPH or "reuse of work" agreements makes it possible to facilitate the search and examination to be carried out by the OEPM by obtaining information from other offices, even if the final decision always rests with the OEPM.

Q6.   What kinds of capacity building and trainings are required for cooperation between patent offices in search and examination? Please indicate any specific capacity building needs to conduct such cooperation successfully.

Capacity-building for patent offices should be based on two main pillars:

- access to databases of high quality patent and non-patent literature; and
- adequate training of patent examiners in searching (appropriate use of databases and efficient search strategy) and examination (knowledge for a proper assessment of patentability requirements), as well as regular exchange of experiences with examiners from other offices.

[End of Questionnaire]