

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

March 15, 2017

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

Country: **United Kingdom**

Office: **United Kingdom Intellectual Property Office (UK IPO)**

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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”?

When we refer to “quality of patents” – we are primarily concerned with the validity of granted patents. Our goal is to grant patents which have a high presumption of validity. In other words, there should be a high presumption that the patents we grant meet all legal requirements. Achieving this goal will mean that patent holders, and the wider public, will be confident that the patents we grant are valid.

We are confident we achieve this goal because we have a robust, ISO 9001 certified, quality management system. This ensures we have the right business framework in place to process patent applications and grant patents which consistently meet legal requirements. A key part of this system is our quality assessment process. Under this process a random sample of completed patents work (for example search or examination actions) is reviewed by senior staff. The review involves determining whether the correct procedures were followed, and whether the legal requirements have been met. These reviews are carried out on a statistically significant portion of work, to ensure the results

are representative of overall performance. The process therefore enables us to monitor the performance of the office and determine what proportion of patents work meets legal requirements. Furthermore, our quality management system is linked to other processes within our office. For example, if a recurring issue is identified as a result of the assessment process, this will be fed in to training or guidance to prevent further issues arising.

Of course, patent quality is not solely determined by a quality management system. It is also important to recruit skilled staff, provide training and up to date guidance, and have good management and leadership. However, our quality management system helps us to ensure that, and verify whether, valid patents are being granted.

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 UK Intellectual Property Office (UK IPO) cooperates with respect to search and examination with a number of patent offices. Including;

- **Membership of the EPO Utilization Implementation Project (UIP). This involves the confidential sharing of IPO search and examination results with the EPO before publication of the UK application (the EPC means that the UK has a duty to share this information). This in accordance with section 118(3) (a) of the UK Patents Act 1977.**
- **The consideration of search and examination work products from other national offices on published equivalent applications, through e.g. WIPO CASE, AIPN, K-PION, USPTO-PAIR, AusPat, EPO European Patent Register, and Global Dossier access via Espacenet. We have been granted official CPES user status and are currently trialling the system.**
- **Reference to equivalent claims. UK IPO examiners can refer to granted claims on equivalent applications in other jurisdictions (e.g. US). Where it appears that such claims would comply with UK law and would not raise further UK objections, the examiner may bring this to the attention of the applicant.**
- **Participation in the Global Patent Prosecution Highway (GPPH). The UK IPO also has a PPH pilot program agreement with China (SIPO). The PPH facilitates the prosecution of patent applications by enabling accelerated processing in the national phase.**
- **Reissuing of Patent Cooperation Treaty (PCT) work products, where the UK examiner considers it appropriate or useful to progress an application most efficiently, in line with UK law. The PCT raises efficiency and timeliness by sharing work conducted by other offices.**
- **UK PCT Fast-Track option. This allows applicants to request accelerated examination in the UK national phase if the claims on file in the UK national phase sufficiently correspond to one or more claims indicated as acceptable in the IPRP or WO-ISA, and so long as any unacceptable claims are deleted on entry to the UK national phase. Applicants will also be able to use the service where the claims**

have been amended to be of a narrower scope than the ones found allowable in the IPRP or WO-ISA.

- Examiner exchanges with other offices, whereby bilateral case-analysis and sharing of best practice highlights areas for improvement and future collaboration.
- Cooperation between Vancouver Group (VG) offices (Australia, Canada, and UK), e.g. Inter-Office Quality Audit Program (review of inter-office work on equivalent cases), and efforts to develop common approaches to search strategies.
- Providing search functionality on behalf of the Irish Patent Office. Our examiners search 30-40 Irish applications (on average) each year.

Cooperation between offices assists the UK IPO in delivering quality search and examination work products. The decision about whether to grant a patent, however, remains under the control of the UK IPO.

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 UK IPO confidentially shares IPO search and examination results with the European Patent Office (EPO) before publication of the UK application as part of the EPO Utilisation Project (see above).

The information that the UK IPO currently provides to the applicant about the nature of the search includes the high level IPC areas covered by the search (e.g. C12N, C07C) and the databases used in the search (e.g. WPI, EPODOC). This information is included as standard on the external search report that is sent to the applicant/agent. This information becomes publicly available if and when the application is published (and can be accessed via the Office's online IPSUM service and WIPO-CASE).

The applicant may also be provided with additional information in the letter which accompanies the search report (for example, if the examiner has searched something other than the invention as specified in the claims, or where the claims relate to more than one invention). Again, this information becomes publicly available if and when the application is published.

We are also currently investigating within the Vancouver Group setting how other search strategy information could be shared.

All information provided by the UK IPO and accessible through our online IPSUM service and WIPO-CASE is available for other offices to use.

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

Access to published UK patent application information is provided to other offices through WIPO-CASE (and by extension One Portal Dossier), and to the public through our online IPSUM service.

- (ii) Platforms and tools used by your office

The UK IPO utilises the following platforms and tools;

- **WIPO-CASE (and by extension OPD)**
- **Global Dossier via Espacenet**
- **EpoqueNet, STN/CAS, EBI-EMBL, IEEE Xplore, Springer Link**
- **European Patent Register**
- **AusPat**
- **AIPN**
- **K-PION**
- **USPTO-PAIR**
- **Cloud Patent Examination System (CPES) – *under trial***
- **PATENTSCOPE**
- **Various journals e.g. Elsevier (XPESP database via Epoquenet), MEDLINE, PUBCHEM.**
- **Derwent World Patent Information**
- **Various standards e.g. telecommunications and engineering, IP.com**

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.

Access to documentation / work products

- **Sharing of work products (e.g. through PCT-PPH) reduces duplication, and therefore increases examination efficiency.**
- **Consideration of work products from other offices helps UK examiners process applications efficiently and identify relevant citations, in particular foreign language documents. This helps to ensure GB patents are granted with a high presumption of validity.**

Inter-Office collaboration

- **Inter-office collaboration (e.g. examiner exchanges and Vancouver Group) allows for sharing of best practice, skills and technical knowledge. This helps improve the quality of examination work products and granted 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.

N/A

[End of Questionnaire]