

Standing Committee on the Law of Patents

Seventeenth Session
Geneva, December 5 to 9, 2011

PROPOSAL BY THE DELEGATION OF DENMARK

Document prepared by the Secretariat

1. The Annex to this document contains a proposal submitted by the Delegation of Denmark entitled "Improving the quality of the search and examination of national patent applications by using foreign search and examination work", for consideration under item 6 of the revised draft agenda: Quality of Patents, including Opposition Systems.

2. *The members of the Standing Committee on the Law of Patents (SCP) are invited to consider the contents of the Annex.*

[Annex follows]

PROPOSAL: IMPROVING THE QUALITY OF THE SEARCH AND EXAMINATION OF NATIONAL PATENT APPLICATIONS BY USING FOREIGN SEARCH AND EXAMINATION WORK

I. INTRODUCTION

1. At the 16th session of the Standing Committee on the Law of Patents (SCP) the Committee decided that the topic of “Quality of Patents, including Opposition Systems” should remain on the agenda of the 17th session of the SCP.
2. Discussions should be based on the proposal by the delegations from Canada and the United Kingdom (document SCP/16/5) and other comments/proposals presented by member states.
3. This document is intended to be a sub-item under the main component “Process improvement” as outlined in document SCP/16/5.
4. The scope of this document is to explore the subject of improving the quality of the search and examination of national patent applications by using foreign search and examination work performed by other patent offices.
5. Experiences gained so far demonstrate that the use of foreign search and examination work in a national patents office’s own search and examination leads to more robust patents of higher quality.
6. The use of foreign search and examination work is only possible when parallel Paris Convention patent applications (members of the same patent family) has been filed at different patent offices and the result of the search and/or examination work performed at one or more patent office(s) is available for other patent offices.
7. The intention of this document is not to explore the use of foreign work in search and examination as a means for reducing patent backlogs or to suggest a common practice or patent law harmonization.
8. This document will deal with the following items:
 - II. The Danish Patent and Trademark Office’s (DKPTO) use of foreign work
 - III. Benefits from using foreign search and examination work
 - IV. Examples of enhanced patent quality through use of foreign work
 - V. Challenges to the use of foreign search and examination work
 - VI. Proposal

II. THE DANISH PATENT AND TRADEMARK OFFICE’S (DKPTO) USE OF FOREIGN WORK

9. The DKPTO has a long-standing tradition for using foreign search and examination work from other patent offices in its national search and examination procedure. The foreign search and examination work is used to the extent possible. This does not entail any acceptance or transfer of other patent offices’ practices or foreign patent laws/regulations. The term “to the extent possible” implies that it is up to the examiner’s discretion to what extend he/she can use the foreign search and examination work.

10. A Danish patent must fulfil the requirements in the Danish legal framework. This, *inter alia*, implies that the DKPTO on its own motion shall examine and decide whether the patentability criterias and other criterias such as, e.g., clarity and support in the description are fulfilled before a patent is granted.
11. Further, the presence of work from other patent offices merely serves as a better starting point for the DKPTO's search and examination work due to, e.g., 1) language barriers at the foreign office when searching prior art, or 2) the fact that the Danish patent application may have been amended following the work done by a foreign office.
12. When performing search and examination of patent applications, Danish examiners will examine whether the Danish patent application has other patent family members and whether the search and examination results for patents in the same patent family are publicly available. Such information may typically stem from other offices' electronic patent databases/file-dossier systems. Further, according to section 42 of the Danish Order on Patents and Supplementary Protection Certificates, the DKPTO can also request an applicant to supply information on foreign patent offices' search and examination results.
13. The gathered information on foreign search and examination results may include found prior art, the technical area searched and the office actions on patentability. This information is used by the Danish examiner as a foundation for performing a search or a supplementary search and thus as background information when performing the examination.
14. The use of foreign work remains an important tool that provides guidance and input to the DKPTO patent examiners when performing their search and examination tasks.

III. BENEFITS FROM USING FOREIGN SEARCH AND EXAMINATION WORK

15. An important objective of using foreign search and examination is to improve the quality of a national patent offices' own search and examination work. This in turn leads to more robust patents of high quality.
16. One of the most important preconditions for granting robust patents is to ensure that the prior art relevant to the patentability of the invention has been revealed. Only then can the patentability criteria be assessed properly.
17. Having *foreign search work* at hand when performing prior art searches on national patent applications thus helps to ensure that prior art, which might otherwise not have been found due to e.g. language barriers or lack of access to specific documentation, is revealed. Further, it guarantees that the search result for the national patent application is at least as good as the one produced by the foreign office, as the prior part found by the foreign office can not be overlooked by the national patent office.
18. Thus, the use of foreign search work can only be an improvement of a national patent offices' search work regardless of the national office's level of development. The contribution of the foreign search work will be even more noticeable for national patent offices with limited access to patent documentation.
19. Likewise, having *foreign examination results/office actions* at hand when performing national examination of patent applications will increase the quality of the national examination work.

20. Such information on foreign examination work provides important inputs and guidance for examiners when examining national applications, as the information may disclose the relevance of the prior art found.

21. The use of foreign search and examination work thus provides a better starting point for performing search and examination work. It is underlined that use of such foreign work does not entail any acceptance or transfer of other patent offices' practices or patent laws/regulations, as national patents are granted subject to national patent legislation.

IV. EXAMPLES OF ENHANCED PATENT QUALITY THROUGH USE OF FOREIGN WORK

22. The use of foreign search and examination work in national processing of patent applications is neither new nor unexplored. A number of bilateral and multilateral programs and agreements are already in place and experiences demonstrate that it improves the quality of the national search and examination work leading to more robust patents of high quality.

23. Some examples of successful programs making use of foreign search results are mentioned below.

24. In the European context, a Utilization Pilot Project (UPP) within the European Patent Network was launched in 2007. The object of this project was to test whether national search work from EPO member states on patent applications that were subsequently filed as European patent applications could be utilised by the EPO. The result of the UPP showed that EPO examiners experienced a quality gain. More prior art was revealed and the patent classifications furnished by the national offices were useful. As a consequence, the Administrative Council of the European Patent Organisation decided to implement the pilot project into a permanent arrangement with effect from 1st January 2011, thus making it mandatory that the search results from national offices should be furnished together with the filing of the European patent application.

25. The Patent Prosecution Highway (PPH) program was initiated in 2006, when the Japanese Patent Office and the United States Patent and Trademark Office launched the first PPH. In the PPH program an Office of Second Filing makes use of the search and examination work from an Office of First Filing. The global PPH figures show that patent applications filed under the PPH program has significantly higher grant rates compared with non-PPH (normal) patent applications.

V. CHALLENGES TO THE USE OF FOREIGN SEARCH AND EXAMINATION WORK

26. Even though current experiences clearly demonstrate that use of foreign search and examination work lead to more robust patents of higher quality, there are challenges which can impede such procedures, e.g.

27. Access to foreign search and examination work results are naturally a key issue. A significant number of electronic patent databases/file-dossier systems are publicly available on websites. Examples are, e.g., EPO's Epoline Register Plus, USPTO's PAIR, DKPTO's PVSONline etc. It would increase the possibility to use foreign search and examination work, if more offices had publicly available file-dossier systems.

28. The examiners' language skills may mean that even though foreign search and examination results are available, they are written in a language which is difficult to understand for examiner's in another patent office.

29. Lack of knowledge about foreign patent offices' patent search and examination practise might be a barrier or introduce a lack of confidence.

VI. PROPOSAL

30. In DKPTO's view, improvement of the quality of search and examination of national patent applications through use of foreign search and examination work is an issue of interest to member states at all levels of development. Likewise, it is also of interest to users and society in general.

31. To serve their purpose, granted patents must be robust and of high quality.

32. In order to explore the subject of enhanced quality through use of foreign search and examination work, the DKPTO will propose that the SCP undertakes to gather information on the questions below. This will allow the members of the SCP to exchange views for mutual inspiration and consideration;

33. Proposed questions for consideration by the SCP:

- How do the national patent offices use foreign search and examination work?
- What are the benefits of using foreign search and examination work?
- What are the challenges to the use of foreign search and examination work?
- How could potential obstacles for using foreign search and examination work be overcome?

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