

Standing Committee on the Law of Patents

Twenty-Seventh Session
Geneva, December 11 to 15, 2017

UPDATED RESPONSES TO THE QUESTIONNAIRE ON THE TERM “QUALITY OF PATENTS” AND COOPERATION BETWEEN PATENT OFFICES IN SEARCH AND EXAMINATION (PART 1)

Document prepared by the Secretariat

INTRODUCTION

1. At its twenty-fourth session, held in Geneva from June 27 to 30, 2016, the Standing Committee on the Law of Patents (SCP) agreed that the Secretariat would prepare, based on the information received from the Member States and regional patent offices, a compilation of information gathered by the Questionnaire on the Term “Quality of Patents” and Cooperation between Patent Offices in Search and Examination that contains the following elements:

- how each Member State understands “quality of patents”; and
- implementation of cooperation and collaboration between patent offices in search and examination of patent applications, including experiences, their impacts, exchanging search strategies, tools to share information and capacity building needs in the area of such cooperation and collaboration. (See document SCP/24/5, paragraph 17).

2. Pursuant to the decision, above, Member States and regional patent offices were invited, through Notes C. 8625 and C. 8626 dated January 16, 2017, to respond to the Questionnaire, which contained six questions relating to the above subject. 60 Member States and two regional patent offices¹ responded to the Questionnaire prior to the twenty-sixth session of the SCP, which was held in Geneva from July 3 to 6, 2017. The Secretariat prepared two documents, compiling the responses to the Questionnaire (documents SCP/26/3 and SCP/26/4) and submitted them to the Committee at its twenty-sixth session. Following the discussion by the Committee, it was decided that the Secretariat would update the said documents, taking into account the additional responses to be submitted by Member States and regional patent offices, and submit the updated compilation to the twenty-seventh session of the SCP.

3. Consequently, Member States and regional patent offices were invited, through Notes C. 8687 and C. 8690 dated August 21, 2017, to respond to the Questionnaire, if they had not done so already. 20 additional Member States² submitted their responses (as of November 9, 2017). All the original responses from 80 Member States and two regional patent offices are available on the SCP electronic forum website at:
http://www.wipo.int/scp/en/meetings/session_27/comments_received.html.

4. This document is Part 1 of the said updated compilation document, in which responses to Question 1 are summarized. The responses to Questions 2 to 6 are summarized in Part 2 of the updated compilation, which is contained in document SCP/27/5.

QUESTION 1

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”?

5. As explicitly clarified by some countries, no legal definition of that term seems to exist. The intention of Question 1, however, is to gather information on how each IP office understands that term. In general, two main concepts emerged from the responses. The first concept is that the term “quality of patents” relates to the quality of a patent itself, while the

¹ Argentina, Austria, Bahrain, Belarus, Bosnia and Herzegovina, Canada, Cape Verde, Chile, China, Costa Rica, Czech Republic, Denmark, Ecuador, El Salvador, Estonia, Finland, France, Gabon, the Gambia, Georgia, Germany, Guatemala, Honduras, Hungary, Iceland, Italy, Ivory Coast, Japan, Kazakhstan, Kenya, Kuwait, Latvia, Liechtenstein, Mexico, Moldova, Morocco, Namibia, Norway, Oman, Panama, Philippines, Poland, Portugal, Qatar, Romania, Russian Federation, Saudi Arabia, Singapore, Slovakia, Spain, Switzerland, Tajikistan, Thailand, Turkey, Turkmenistan, Ukraine, United Kingdom, United States of America, Uzbekistan, Zambia, Eurasian Patent Office (EAPO) and European Patent Office (EPO).

² Albania, Algeria, Azerbaijan, Benin, Bhutan, Brazil, Cambodia, Colombia, Croatia, Dominican Republic, Greece, Iran (Islamic Republic of), Jordan, Kyrgyz Republic, Lithuania, Montenegro, Pakistan, Republic of Korea, South Africa and Sweden. In addition, Moldova, Slovakia, Thailand and Ukraine resubmitted their responses due to the change in their contact information.

second concept is that the term is understood in the context of the patent grant process within the IP offices. Some responses referred to the first concept only,³ and some other responses touched upon the second concept only.⁴ Many countries, however, discussed the both notions in their responses.⁵ As it will be explained below, those two concepts are closely related to each other.

6. Of responses in which the quality of patents is understood in such a way that it relates to the quality of a patent itself, the majority stated that a high quality patent shall meet the legal requirements prescribed in the applicable law. Most commonly, the responses refer to the compliance with the patentability criteria, which are patentable subject matter, novelty, inventive step, industrial applicability as well as sufficiency of disclosure and the requirements regarding claims. According to those responses, a patent that meets the legal requirements has a high presumption of validity, and would most likely not be revoked if it is challenged. This will create legal certainty for both the patent holder and third parties. In some responses, such patents are called “robust” patents.⁶ The response of Singapore stated that robust patents would increase the level of confidence that stakeholders and investors can give in its patent regime. The response of South Africa noted that its understanding of the term “quality of patents” is the extent to which the office would go to ensure and provide a level of certainty to the patentee that the patent granted by it was legally enforceable.

7. Although some countries relate high quality patents to the patents that comply with substantive patentability criteria, some other responses refer to all legal requirements or make a reference to formality and substantive examination, which may imply that compliance with not only the patentability criteria but also any other requirements under the applicable law are relevant to the quality of patents.⁷

8. In the context of an IP office engaged in granting high quality patents as understood in the sense described above, quality patents are closely related to quality of a patent granting process within that office, since the former is the desired “outcome” (patents), while the latter is the process that leads to that outcome. From that perspective, it is not surprising to find that many responses indicate both quality of a patent itself and quality of patent granting process as the elements that form the understanding of the term “quality of patents”. The European Patent Office (EPO), for example, states that “the patent grant process itself should offer the highest possible level of legal certainty.” Similarly, the response of France noted the importance of not to lose sight of the interdependency between the “management of procedural quality” and the “application of the condition of patentability”. By the same token, the response of Algeria noted that, from the viewpoint of its office, the term “quality of patents” means the quality of a patent system that provides a high level of legal certainty for inventors, which can relate to patent procedures and patent management within the office.

³ Responses from Albania, Belarus, Benin, Bhutan, the Dominican Republic, Gabon, Guatemala, Iceland, Ivory Coast, Japan, Latvia, Ukraine and Uzbekistan.

⁴ Responses from Honduras, Italy, Jordan, Kazakhstan, Kuwait, the Kyrgyz Republic, Moldova, Pakistan, the Philippines, Saudi Arabia, Thailand and Turkmenistan.

⁵ Responses from the following Member States and regional patent offices referred to both concepts: Austria, Azerbaijan, Bosnia and Herzegovina, Brazil, Cambodia, Canada, China, Colombia, Costa Rica, Croatia, Denmark, Ecuador, El Salvador, Estonia, Finland, France, the Gambia, Georgia, Germany, Hungary, Iran (Islamic Republic of), Kenya, Lithuania, Mexico, Montenegro, Morocco, Namibia, Norway, Panama, Poland, Portugal, Qatar, Republic of Korea, Romania, Russian Federation, Singapore, Slovakia, South Africa, Spain, Sweden, Switzerland, Turkey, United Kingdom, United States of America, Zambia, EAPO and EPO.

⁶ For example, responses from Chile and Singapore.

⁷ For example, responses from Bosnia and Herzegovina, Costa Rica, Jordan, Sweden and the United Kingdom.

9. Many responses further elaborated on how they understand the high quality patent granting process.

(i) Search and examination process

Many offices consider that the search and examination process should be thorough and comprehensive, complying with the applicable law and the established standard. For example, the response from Singapore noted that the process should provide valid, reliable and consistent search and examination products and services.⁸ The EPO stated that identification of prior art and reasoning of decisions should be relevant and comprehensive. Some responses⁹ pointed out that in order to ensure a thorough prior art search during the patent granting procedure, examiners need proper search tools and databases. In addition, some offices considered the consistency of search and examination decisions taken by patent examiners as an element of patent quality.¹⁰

(ii) Timeliness

Timeliness of office actions and decisions are also mentioned by many countries.¹¹ The National Institute of Industrial Property (INPI) of Brazil has been implementing a series of measures dedicated to reduce the backlog and the time for a final decision, such as a e-platform, hiring of new examiners, and accelerated examination of patent applications in certain technical fields and of applications under the pilot programs of the Patent Prosecution Highway (PPH) format.

(iii) Skilled staff

The importance of well trained staff having sufficient skills to carry out their duties is highlighted in some responses.¹² To ensure having skilled staff, various IP Offices conduct regular training of their staff.¹³ In this regard, the response of Croatia, for example, referred to a performance management system and human resources in general, and the response of the United Kingdom pointed out the importance of having good management and leadership.

(iv) Communication and transparency

In addition to the above, some offices noted the aspect of transparency within the patent system and communication between the office and stakeholders.¹⁴ For example, the responses of France and the EPO referred to the information made available to the public through the national databases and registry, and the public availability of search and examination results, respectively. As regards the quality of communication between the patent office and its users, Norway referred to good contact and dialogue with users. The

⁸ See also the responses from Ecuador and France, which referred to the quality of information contained in search reports.

⁹ For example, responses from Finland, Greece, Honduras, Kazakhstan, Guatemala, Mexico, Moldova, Morocco, Singapore and South Africa.

¹⁰ For example, responses from France and Greece.

¹¹ For example, responses from Canada, Chile, Denmark, El Salvador, France, the Gambia, Hungary, Italy, Mexico, Namibia, Norway, Portugal, the Russian Federation, Slovakia, Spain, Sweden, Thailand, Turkey, the EAPO and the EPO.

¹² For example, responses from Cape Verde, Germany, Jordan, Kazakhstan, Mexico, Panama, Singapore and the United States of America.

¹³ For example, responses from Finland, Greece, Mexico, South Africa, the United States of America and the EPO.

¹⁴ For example, responses from Croatia, France, Italy, Norway, Portugal, Sweden, the United States of America, Zambia and the EPO.

response of Sweden stated that any decision made by the Swedish patent office should be explained to its addressee so that it would fully understand the basis for, and the consequences of, such decision.

10. According to the response of Colombia, quality of patents is associated with the provision of appropriate mechanisms to ensure the “due process”; meaning that the application meets the conditions set out in the law, and third parties are able to avail themselves of an administrative step to exercise their right to oppose or seek the nullity of the granted patent.¹⁵ Similarly, the responses of Lithuania and South Africa also indicated the mechanisms for review of the office’s work as one of the elements for the consideration of patent quality.

11. The response of Portugal stated that “patent quality” should not only be assessed by the final result, but all steps leading to the final product should also be monitored. As a measure to monitor and control the patent granting process and product, some countries indicated their quality management systems introduced within their respective IP offices.¹⁶ For instance, the United States Patent and Trademark Office (USPTO) has been implementing the Enhanced Patent Quality Initiative which focuses on improving the quality management mechanisms of the Office by institutionalizing best practices and strengthening the USPTO’s work products, processes, and services at all stages of its patent granting process. In Brazil, the Directorate of Patents (DIPRA) Quality Group, established in INPI, prepared a “Validation Checklist for Quality Management of Examination Reports”. The United Kingdom Intellectual Property Office (UKIPO) responded that it implemented a review and audit system for search and examination work. Under such system, a senior staff would review, on a random basis, a sample of completed patents work. Some responses¹⁷ also stated that their national IP Offices obtained the ISO 9001 certification.

12. In addition, a clear and strong legal framework, including provision of clear legal requirements, is mentioned in some responses.¹⁸

13. Furthermore, some responses explicitly noted that not only the search and examination process but also the entire prosecution procedure before the office is relevant to the quality of the process.¹⁹ For example, the response of the United Kingdom stated that its quality management system was linked to other processes beyond the search and examination within its office. Similarly, the Canadian Intellectual Property Office (CIPO) includes classification and operations (support) processes in its quality management.

14. Some offices understand that quality of patents includes, or is influenced by, the elements that are beyond the patent prosecution and grant. For example, the response of Switzerland stated that the quality of patents was influenced by its entire “environment”, including enforcement processes as well as judicial processes before courts. Singapore observed that some of the parameters defining the quality of patents tend to be inextricably linked to the

¹⁵ The response of Pakistan noted that provision of a fair and concrete procedure for, for instance, patent opposition, enforcement and litigation was one of the elements that ensured patent quality.

¹⁶ For example, responses from Austria, Brazil, Croatia, Denmark, El Salvador, Finland, Germany, the Kyrgyz Republic, Lithuania, Poland, Portugal, Singapore, Spain, Turkey, the United Kingdom and the United States of America.

¹⁷ For example, responses from the Czech Republic, Estonia, Finland, France, Greece, Moldova, Poland, Romania, Singapore and the United Kingdom.

¹⁸ For example, responses from Italy, Mexico and Zambia.

¹⁹ For example, responses from Canada, Jordan, Sweden and the United Kingdom.

technological maturity of an invention and/or the patent strategy of the applicant. In addition, some other countries also mentioned the quality of drafting of patent applications as one of the aspects of patent quality.²⁰

15. The response of Iran (Islamic Republic of) also noted that the concept of “quality of patents” could be related to different factors, such as the patent procedures, full and accurate prior art search, quality of search reports and appropriate search tools, quality of drafting of patent applications and complete disclosure of the invention concerned. It further stated that the quality of patents could also be considered in terms of potential of productivity, creativity and usability of the invention, and in accordance with the technology needs of the society.

16. In addition to the elements, above, some responses outlined further aspects to be considered when defining the term “quality of patents”. The response of China, for example, stated that while providing a definition of quality of patents at the national, regional and global levels was a complex endeavor, in general, the following aspects could be taken into account: the extent of technological innovation; the drafting of patent documents; the stability of patent rights; the validity period of patents; and the utilization of patents. The Japan Patent Office (JPO) considers the quality of a patent to be high, where the patent satisfies the following three elements: (i) the patent will not be invalidated afterwards; (ii) the scope of the patent corresponds to the disclosure of the invention and the extent of its technical level; and (iii) the patent is recognized around the world. According to the response of Montenegro, the crucial criteria for determining quality of patents are: (i) optimal balance between the scope of protection and legal certainty; (ii) the extent of technological innovation; (iii) the drafting of patent applications; (iv) the stability of patent rights; (v) skilled staff; (vi) the validity period of patents; and (vii) the utilization of patents.

17. The response of the Eurasian Patent Office (EAPO) noted that quality of patents meant different for each stakeholder in different contexts.²¹ A patent holder may consider that a quality patent means a reliable patent from the viewpoint of enforcement, litigation and commercialization (for example, granting licenses). Applicants may seek patent applications that disclose the technical information only to such extent that is required by law, and allow him to apply for the broadest possible protection. For the beneficiaries of transfer of technology, a quality patent would be a patent that discloses all the aspects of the patented invention. Yet, from the viewpoint of the social interest, a patent quality may mean that the right conferred by a patent is proportionate to the contribution of the invention to the state of the art.

18. It appears that some responses address the issues from the aspect of the quality of a patent system as a whole. The response of Romania stated that a quality patent meant that the scope of protection stroke a balance between granting adequate rights to a patentee and preserving the public’s right to exploit the public domain. The responses of Namibia and Gabon also referred to the perspective of the users of the patent system and economic benefits of patents, respectively. Similarly, the response of Benin indicated that patent quality could relate to national development policy as well as market or economic value of patents.

²⁰ For example, responses from Azerbaijan, Croatia, Greece, Iran (Islamic Republic of), Lithuania Montenegro Pakistan and Portugal.

²¹ See also the response from the United States of America.

19. In addition, some of the responses highlighted various social benefits that quality patents would provide. The response of Mexico indicated that high quality patents were necessary to promote innovation, transfer of new technologies and economic development and competitiveness. Similarly, the response of Argentina noted that quality patents promoted, among other public policy goals, the well-being of populations and access to health. The response of Ecuador indicated that the grant of high-quality patents meant, among others, maintaining stimulus for genuine innovation and avoiding superfluous patents, thereby incentivizing competition.

[End of document]