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WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

SCP/27/5 REV.
ORIGINAL: ENGLISH
DATE: NOVEMBER 10, 2017

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 2)

Document prepared by the Secretariat

INTRODUCTION

1. The Standing Committee on the Law of Patents (SCP), at its twenty-sixth session held in Geneva from July 3 to 6, 2017, agreed that taking into account the additional responses to the Questionnaire on the Term "Quality of Patents" and Cooperation between Patent Offices in Search and Examination, the Secretariat would submit, to the twenty-seventh session of the SCP, an updated compilation of information gathered from the Questionnaire. This document is Part 2 of such updated compilation, which contains a summary of responses to Questions 2 to 6 of the said Questionnaire. The general introduction and the summary of responses to Question 1 of the Questionnaire are found in Part 1 of the updated compilation in document SCP/27/4.

QUESTION 2

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.

2. The responses show that extensive cooperation has been carried out between IP offices at the bilateral, regional and international levels. They can be between the offices of developed countries, between the offices of developed and developing countries or between those of developing countries. A wide range of cooperation has been observed: they include sharing patent information and search tools, conducting search and examination for other offices,

assisting training and capacity building of staff of another office, sharing search and examination work products and collaborating in prior art search and examination. While the original responses to the questionnaire[1] should be consulted in order to appreciate the full extent of such cooperation, seven areas of cooperation which are more frequently mentioned in the responses will be summarized in the following paragraphs.

Access to documents/databases/search systems of other offices

3. Beyond the international exchange of patent documents, some IP offices share their in-house search systems with other offices.[2] In addition, the Federal Service for Intellectual Property (ROSPATENT) and the Eurasian Patent Office (EAPO) provide their collaborating offices with access to paid databases.

Use of search and examination products produced by other offices

4. In many offices, examiners retrieve information relating to search and examination conducted by other offices with respect to the same invention, and use them as a starting point for national search and examination.[3] Search and examination reports, decisions regarding oppositions and legal status information, among others, may be retrieved from national/regional databases or regional/multilateral platforms, such as WIPO CASE, as summarized under the section relating to Question 4 of the Questionnaire, below.

5. While an examiner from any office may retrieve such information from free and publicly available databases, the responses from the offices which indicated this type of cooperation show that the managers of those offices take measures to create an environment conducive to utilizing search and examination work products produced by other offices, where appropriate, without compromising their obligation to examine patent applications in compliance with their respective national law. It can be a unilateral initiative by an office or under regional/international initiatives, such as PROSUR,[4] Vancouver Group,[5] Support System for the Search of Patent Applications for Central American Countries and the Dominican Republic (CADOPAT),[6] ASEAN Patent Examination Co-operation Program (ASPEC)[7] or the Patent Prosecution Highway (PPH)[8]. Information about the details of those initiatives can be accessed from the WIPO webpage “International Worksharing and Collaborative Activities for Search and Examination of Patent Applications”.[9] Some of those initiatives cover more comprehensive cooperation beyond the sharing and utilization of respective reports. For example, the Vancouver Group reviews, under the Inter-Office Quality Audit Program, inter-office work on

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1 http://www.wipo.int/scp/en/meetings/session_27/comments_received.html .

2 The ROSPATENT provides Kazakhstan with access to its search system PatSearch, and the European Patent Office (EPO) shares its search tool (EPOQUE) not only with its Member States, but also with two regional offices and 14 national offices from non-EPO members. The Companies and Intellectual Property Commission of South Africa signed a Memorandum of Understanding (MoU) with the EPO for the collaboration on best practices in terms of search and examination, including access to the EPOQUE NET and training for examiners.

3 Responses from Argentina, Austria, Canada, Chile, China, Costa Rica, the Czech Republic, Denmark, Estonia, Finland, Georgia, Germany, Hungary, Iran (Islamic Republic of), Japan, Jordan, Kenya, Mexico, Moldova, Morocco, the Philippines, Romania, Saudi Arabia, Thailand, Turkey, the United Kingdom, the United States of America, Zambia, the EAPO and the EPO.

4 Responses from Argentina, Brazil, Chile and Ecuador.

5 Responses from Canada and the United Kingdom.

6 Responses from Costa Rica, the Dominican Republic, El Salvador, Honduras and Mexico.

7 Responses from Cambodia, Singapore and Thailand.

8 Responses from Argentina, Austria, Brazil, Canada, China, Colombia, the Czech Republic, Denmark, Ecuador, Estonia, Germany, Hungary, Japan, Mexico, Morocco, the Philippines, Portugal, the Republic of Korea, Romania, Spain, Thailand, Turkey, the United Kingdom, the United States of America, the EAPO and the EPO.

9 http://www.wipo.int/patents/en/topics/worksharing/.

equivalent cases, and makes efforts to develop common approaches to search strategies,[10] and ASEAN Community of Practices (CoP) for Patent Examiners facilitates the sharing and better understanding of search and examination practices within the offices of the ASEAN region[11].

Collaborative search and examination

6. Several collaborative search and examination initiatives have been carried out by some offices. The United States Patent and Trademark Office (USPTO) has two pilot programs, one with the Japan Patent Office (JPO) and another with the Korean Intellectual Property Office (KIPO).[12] Under the framework of the IP5 Cooperation, a third pilot on collaborative search and examination is underway.[13] In that regard, IP5 offices established an IP5 Cooperation Framework on Collaborative Search and Examination under the PCT.[14]

Carrying out search and examination for/by other offices

7. Some regional patent offices assist with prior art search and/or examination of national patent applications filed with certain offices of its Member States. For example, such service has been offered by the African Regional Intellectual Property Office (ARIPO) to Gambia and Zambia, by the EAPO to Turkmenistan, and by the EPO to France, Italy, Latvia and Lithuania, among others. In addition, the IP offices of China, Denmark, Egypt, Hungary, Portugal, the Russian Federation, Singapore and the United Kingdom perform search and/or examination work for their respective collaborating offices. The IP Office of Brazil also provides other offices with search and examination reports under the cooperation agreements.

8. Some offices have an agreement with another patent office for cooperation on search and/or examination of patent applications in a special technical field.[15] Furthermore, some responses indicated that WIPO's ICE program facilitates comprehensive patent examination.[16]

9. On slightly different note, the EPO and the other European International Searching Authorities (ISAs) are establishing agreements for the purpose of harmonizing search activities in Europe under the PCT. Under these agreements, the EPO transmits to participating European ISAs a number of international applications to be searched, while the EPO remains responsible for carrying out the international search.

Exchange of examiners with other patent offices

10. The responses of Austria, Japan, Morocco, Portugal, Singapore, Sweden and the United Kingdom noted that their offices exchanged examiners with certain other offices. They share and discuss examination practices of each office and/or conduct case analysis.

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10 Response from the United Kingdom.
11 Response from Singapore.
12 Responses from Japan, the Republic of Korea and the United States of America.
13 Document PCT/WG/9/20.
14 Response form the United States of America.
15 For example, the agreement between the office of the Dominican Republic and the National Institute of Industrial Property of Chile in the area of biotechnology, and the agreement between the Hellenic Industrial Property Organization and the EPO covering a small number of patent applications relating to specialized technical fields which cannot be searched by the Hellenic Industrial Property Organization.
16 Responses from Bhutan, Kenya and Switzerland.

Training by other patent offices[17]

11. In order to improve skills for patent search and examination, some offices provide trainings at either their offices or beneficiary's office.[18] The Spanish Patent and Trademark Office (OEPM) offers search and examination training through on-line courses and six month onsite training at the OEPM for Ibero-American countries. The response of Belarus noted that it had benefited from an internship at the EAPO.

Others

12. In addition to the above, regular meetings between the cooperating offices to exchange experiences and best practices as well as other general cooperation frameworks are also mentioned in some responses.[19]

QUESTION 3

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?

13. Some responses indicated that search strategies and queries used during prior art search for national applications are made available via an on-line system or on their official websites that can be accessed by any interested party.[20] The EPO, as a pilot project, is supplementing its search reports with an annex "information on search strategy", which is also made publicly available via the European Patent Registry. Some patent offices share, with other patent offices, patent classification codes used during the prior art search.[21] The Swedish Patent Office does not share search strategies on a regular basis, but its several cooperation agreements include exchange of search queries and strategies.

14. Search strategies and queries are shared by some offices in the framework of regional cooperation. For example, the IP office of Kuwait shares the information with the Gulf Cooperation Council (GCC) Patent Office, the IP office of Mexico shares search terms through the CADOPAT platform, the offices of Spain and the United Kingdom share search strategies with the EPO under the Utilization Implementation Project (UIP) and the Canadian office shares

17 See also the summary of responses to Question 6.

18 The responses from Belarus, Benin, Gabon, Greece, Italy, Ivory Coast, the Philippines, South Africa and Turkey indicated such training activities from the beneficiary's side, and Mexico, Portugal, Spain and Switzerland described those activities from the trainer' side.

19 For example, the response of Estonia noted that annual meetings at the different functional levels are held among the offices of Nordic and Baltic countries. Further, according to the response from Morocco, the countries of the Agadir Agreement (Egypt, Jordan, Morocco and Tunisia) exchange experiences and share patent examination practices. Similarly, the cooperation agreements have been concluded between the authorities of Ecuador and the State Intellectual Property Office (SIPO) of China, based on which they share methodologies, procedures and experience in patent examination and exchange non-confidential documentation. In response to Question 5, IPO-Pakistan noted that it had signed an MoU with the patent office of Turkey in 2015, and with SIPO in 2017. It intends to sign a cooperation agreement with the USPTO in near future. The Ibero-American Industrial Property Program (IBEPI) aims at promoting the strategic use of industrial property as a tool for the development and integration of Ibero-American societies.

20 Responses from Canada, China, Moldova, Turkey and the United States of America.

21 Responses from Chile, Japan and the United Kingdom. Search reports published by INPI Brazil include the patent classification codes and searching tools used by the patent examiners.

the information with its partners during the audits with the Vancouver Group. Some offices noted that they shared patent search strategies and queries with other offices in the framework of the PPH,[22] collaborative search and examination pilot projects[23] and/or exchange programs on examination practices[24].

15. The response from Argentina noted that its office planned to share search strategies within PROSUR. Similarly, Saudi Arabia plans to exchange such information with the GCC Patent Office. Georgia plans to share search strategies through its online file inspection system, and the IP office of Hungary is investigating the feasibility of making search strategy information available to the public. The response from the United Kingdom noted that it had been investigating how search strategy information beyond the International Patent Classification (IPC) could be shared within the Vancouver Group. Switzerland responded that its office might share search strategy information with other offices, if useful and upon request.

16. Some patent offices indicated that as their role as the International Searching Authority (ISA) and the International Preliminary Examining Authority (IPEA), they share search queries and related search information regarding international PCT applications via PATENTSCOPE.[25]

QUESTION 4

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

17. The responses to Question 4 indicate various platforms and tools utilized by IP offices to share and access information regarding search and examination. While such platforms and tools provided and/or used by each patent office could be found in the original responses to the Questionnaire, the Annex to this document provides a list of platforms and tools for sharing information on search and examination, which are developed by various national/regional patent offices or through international initiatives.

18. Some responses also referred to national/regional patent databases for searching published patent applications and patents, including LATIPAT and ARABPAT. The responses indicate that many IP offices share patent information data with other offices so that patent applications filed in one country are accessible via various platforms.

QUESTION 5

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.

[22] Response from China.
[23] Responses from China and the United States of America.
[24] Responses from China and Singapore.
[25] Responses from Canada, Finland, Norway and the United States of America.

19. Regarding the impact of cooperation in the area of search and examination with other offices in general, many responses indicated that there is a positive impact on the validity of granted patents.[26] It was noted that prior art found by other offices complements the search work of examiners, particularly where prior art documents are in foreign languages or use of special search functionalities (such as chemical structure search) or special databases (for example, scientific literature databases) is necessary to retrieve those documents.[27] Furthermore, examiners, when conducting their own patentability evaluation, may consult opinions on patentability prepared by other offices, since they provide the rationale behind the decisions taken by the examiners of those other offices. Cooperation on the use of databases of other offices and commercial databases facilitates better prior art search.[28] Particularly, it was reported that small offices with limited resources benefit from other offices' search and examination reports and from cooperation on substantive examination work with other offices.[29] The EPO noted that standardization of classification and prior art document citation contributes to better quality of search.

20. Another impact stated in many responses is the reduction of the pendency period and improved efficiency in patent examination through the utilization of search and examination work conducted by other offices.[30] Some responses mentioned that the PPH program allows fewer office actions, which lead to reduced costs for applicants as well as for the offices.

21. In addition, many responses touched upon the effect of patent search and examination cooperation on development of institutional capacity in general and professional knowledge and competencies of examiners in particular.[31] They noted that cooperation with other offices results in development of its own best practice and/or reflection and optimization of its own internal processes, for example, developing its own quality assurance process. In addition, it is reported that work sharing and other cooperation activities, such as examiners' training and exchange of examiners between IP offices, contribute to improving professional knowledge and competencies[32] and deepening the understanding of other patent offices' practices.[33]

22. The response of Colombia noted that cooperation between patent offices in search and examination had an impact on IT departments of patent offices, in the sense that their IT infrastructure must continuously be up-to-date in order to meet the requirements for compiling, sending, receiving and viewing the patent information shared with other cooperating offices.

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26 Responses from Austria, Azerbaijan, Belarus, Bhutan, China, Colombia, Denmark, the Dominican Republic, Estonia, Finland, France, the Gambia, Georgia, Germany, Greece, Iran (Islamic Republic of), Japan, Lithuania, Mexico, Morocco, Panama, the Philippines, Poland, the Republic of Korea, Singapore, Switzerland, Turkey, the United Kingdom, the United States of America, the EAPO and the EPO.

27 Response from the Dominican Republic.

28 Responses from France, Kazakhstan, Moldova and Uzbekistan.

29 Responses from Bahrain, Iceland and Tajikistan.

30 Responses from Austria, Azerbaijan, Bhutan, Canada, China, Colombia, Costa Rica, the Czech Republic, Denmark, the Dominican Republic, El Salvador, Estonia, Greece, Iran (Islamic Republic of), Japan, Mexico, Morocco, Portugal, the Republic of Korea, Spain, Switzerland, Thailand, Turkey, the United Kingdom, the United States of America and the EAPO.

31 Responses from Austria, Benin, Canada, the Dominican Republic, France, Mexico, Poland, Portugal, Sweden, the United Kingdom and the EAPO.

32 Responses from Hungary, Kuwait, Poland, Spain, Switzerland and Turkey.

33 Responses from Denmark, Japan, Mexico and Singapore.

QUESTION 6

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.

23. In general, two types of capacity building are addressed in the responses to Question 6: developing search and examination capacity of patent examiners in general, and capacity building for utilizing search and examination work products of other offices. The former addresses general training needs of examiners and the latter focuses on the capacity building needs specifically required for more effective cooperation. Since those needs are related to a certain extent, this summary does not necessarily distinguish the two above.

24. Some offices noted that platforms and tools to facilitate work sharing are in general easy to use, and work sharing can be done without great expense of resources.[34] Nevertheless, various capacity building needs are identified by different offices, probably reflecting the nature and extent of the cooperation being carried out by each office as well as the general needs for capacity building in the area of search and examination in the office concerned.[35]

25. Many responses addressed the needs for enhancing search and examination capacity of examiners.[36] Examiners' ability in formulating appropriate search strategies and using various databases, among others, is mentioned. In order for examiners to properly contextualize and leverage the examination approaches taken by the examiners of other offices, they should be able to properly understand and interpret the search and examination reports prepared by examiners from other offices. To that end, some considered that knowledge of different patentability criteria and of patent examination practices in various countries is important. In addition, some patent offices noted the training needs in the area of classifications,[37] platforms for sharing search and examination information[38] and language used by collaborating offices[39]. Furthermore, some offices stated the training needs in certain technical fields, such as pharmaceuticals and computer-implemented inventions[40] and a quality management system[41].

26. As regards the modalities of such capacity building training, some offices consider that the training should closely relate to the daily work of examiners and be practical.[42] In the same light, on-the-job-training by experienced examiners from other offices, internship in other offices, exchange of examiners among patent offices were suggested by some offices.[43] Turkey reported that training activities involving examiners from various IP offices had been an efficient

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34 Responses from Singapore and the United States of America.

35 See the response from Brazil.

36 Responses from Albania, Algeria, Austria, Cambodia, Canada, China, Colombia, Costa Rica, Croatia, Denmark, the Dominican Republic, France, Kazakhstan, Morocco, Portugal, the Republic of Korea, South Africa, Spain, Switzerland, the EAPO and the EPO.

37 Responses from the Dominican Republic, Greece, Morocco, Pakistan, Panama, Zambia and the EAPO.

38 Responses from Algeria, Bahrain, Brazil, the Dominican Republic, Jordan, Morocco and Turkey.

39 Responses from China, Mexico and the EAPO.

40 Responses from Azerbaijan, the Dominican Republic, Jordan and Pakistan.

41 Response from Lithuania. The response of Azerbaijan noted that the capacity building is expected to be aimed to, *inter alia*, development of methodical materials on the quality of patent search and examination.

42 Responses from Austria and Zambia.

43 Responses from Austria, Bahrain, Costa Rica, Croatia, Ecuador, Norway, Pakistan, Panama, Qatar and the Russian Federation.

way to share different approaches and experiences among patent examiners. The Japan Patent Office shares the results of its examiner exchange program on its Intranet so that the outcomes of the program can be shared by other staff. China reported its positive experience that training core team members and managers (train the trainers) had ensured the smooth execution of the cooperation with the EPO. Some offices suggested that users of the patent system, such as patent attorneys and non-governmental organizations relating to intellectual property, be involved in capacity building activities for the development of knowledge and skills of office employees.[44]

27. In addition, many offices noted the usefulness of exchanging experiences on various issues relating to search and examination, including patentability criteria, office practices, tools and quality control.[45] This could be done either in person or via a web platform. The response of Greece noted that no fragmentation of tools for such an exchange of information should take place between the different patent offices. Some offices suggested holding awareness raising seminars on the benefits and usefulness of work sharing.

28. Considering the role of IT tools and platforms for sharing information among patent offices, some offices addressed capacity building in the areas of development of software and IT technical support.[46]

29. Furthermore, in order to successfully carry out cooperation programs among patent offices, some offices suggested concrete activities, such as: (i) establishing a global/regional inventory of the processing time for patent applications in various patent offices, and of quality assurance tools or mechanisms in various offices;[47] and (ii) establishing permanent channels of communication for examiners of cooperating offices, so that they can exchange opinions, and discuss real cases, directly[48].

30. On a different note, some responses addressed certain challenges relating to cooperation in search and examination. It was noted that, on the one hand, such cooperation might require additional human and financial resources, while on the other hand, successful cooperation might result in saving the resources.[49] Canada observed that although having full time employee resources for collaboration activities was key, it was difficult to justify staffing, as collaborative work fluctuated greatly over the year and was difficult to forecast the work effectively. The response of Finland, in relation to Question 2, noted that, although its office is open to any collaboration projects, due to limited resources, it had to prioritize the programs and projects it could join. In addition, Switzerland pointed out that the data exchange process, format and forms are not standardized among IP offices, and that each national office should have a full set of patent information in order to ensure exchange of complete and accurate national data with other offices.

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44 Responses from Croatia and Portugal.
45 Responses from Belarus, Chile, Colombia, Denmark, El Salvador, Honduras, Italy, Pakistan, Saudi Arabia, Spain and the EAPO.
46 Responses from Bosnia and Herzegovina, Brazil, Canada, Denmark, El Salvador, Kenya Pakistan and South Africa.
47 Response from Colombia.
48 Responses from Croatia and Portugal.
49 Responses from Austria.

31. The response of Sweden indicated a set of capacities, or building blocks, for successful cooperation between patent offices in search and examination, as follows: (i) a vision and/or strategy for cooperation; (ii) a clearly defined framework for the cooperation, including a resource planning; (iii) cooperation execution procedures, such as benchmarking, implementation and evaluation; (iv) preparation and development of common technical platforms; and (v) training for managers and examiners.[50]

[Annex follows]

[50] The response of Portugal also noted that it is important to define the aim of the cooperation and its final goals.

Responses to Question 4: List of Platforms and Tools Developed by Various National/Regional Patent Offices and Initiatives

Australia	AusPat (including an eDossier system allowing access to recent documents that are Open for Public Inspection (OPI))
Brazil	BUSCA WEB (including official INPI communications, search and examination reports and a process monitoring function)
China	Cloud Patent Examination System (CPES); Patent Search and Services System (PSS) (including English legal status information, citations and information on patent families can be retrieved); CPQUERY
Denmark	PVS Online (DKPTO file inspection system)
France	BaseBrevets (including all documents in the files and search reports)
Germany	DPMAregister (including the file inspection functionality and prior art citations)
Greece	National Patent Register Database (including a list of all cited documents in search reports; in Greek and English)
Japan	Advanced Industrial Property Network (AIPN); J-PlatPat (including information on the legal status of patents)
Philippines	E-gazette of the IPOPHL (including search reports); IPOPHL Patent Search (status of applications available)
Portugal	Industrial Property Bulletin (including search reports and written opinions)
Mexico	CADOPAT(Patent Application Support System for the Central American Countries and the Dominican Republic)
Poland	Register Plus (including search reports)
Republic of Korea	K-PION, KIPRIS
Russian Federation	Open Register
United States of America	Patent Application Information Retrieval (PAIR)
EPO	Espacenet; EPOQUEnet; European Patent Registry/Federated European Patent Register
EAPO	EAPATIS search and retrieval system
IP5	IP5 Global Dossier; One Portal Dossier; Common Citation Documents (CCD) (single-point access to citation data)

Certain Latin American countries	PROSUR initiative (sharing of search and examination reports among South American IP offices)
WIPO	PATENTSCOPE; WIPO CASE; WIPO DAS

[End of Annex and of document]