

WORLD INTELLECTUAL PROPERTY
ORGANIZATION

世界知识产权组织

ORGANIZACION MUNDIAL
DE LA PROPIEDAD INTELECTUAL



ORGANISATION MONDIALE
DE LA PROPRIÉTÉ INTELLECTUELLE


المنظمة العالمية للملكية الفكرية

ВСЕМИРНАЯ ОРГАНИЗАЦИЯ
ИНТЕЛЛЕКТУАЛЬНОЙ СОБСТВЕННОСТИ

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./ The International Bureau of the World Intellectual Property Organization (WIPO) presents its compliments and has the honor to transmit herewith documents PCT/CTC/20/2 and PCT/CTC/20/3, prepared for the twentieth session of the *PCT Committee for Technical Cooperation* (PCT/CTC), which will be held in Geneva, at the headquarters of WIPO, from September 23 to October 1, 2002.

The French version will follow shortly. 

July 19, 2002

Enclosures: documents PCT/CTC/20/2 and 3 (in English)

WIPO



PCT/CTC/20/2

ORIGINAL: English

DATE: July 19, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

PCT COMMITTEE FOR TECHNICAL COOPERATION

Twentieth Session

Geneva, September 23 to October 1, 2002

ADVICE TO THE ASSEMBLY OF THE PCT UNION ON THE REQUEST OF THE
CANADIAN COMMISSIONER OF PATENTS TO BE APPOINTED AS
INTERNATIONAL SEARCHING AUTHORITY AND AS INTERNATIONAL
PRELIMINARY EXAMINING AUTHORITY

Document prepared by the International Bureau

1. In a letter dated July 5, 2002, the Canadian Commissioner of Patents expressed the wish to be appointed as an International Searching Authority (ISA) and as an International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT). The letter from the Canadian Commissioner of Patents is reproduced as an Annex to this document.¹
2. Article 16(3)(e) of the PCT provides that “Before the Assembly [of the PCT Union] makes a decision on the appointment of any national Office [as an ISA] ..., the Assembly shall ... seek the advice of the Committee for Technical Cooperation ...” (hereinafter referred to as the PCT/CTC).
3. According to Article 32(3) of the PCT, the provisions of Article 16(3) shall apply, *mutatis mutandis*, in respect of the appointment of an IPEA.

¹ Working documents for sessions of the Assembly and the Committee for Technical Cooperation are accessible via WIPO’s Web site at <http://www.wipo.int/pct/en/meetings>.

4. The advice given by the PCT/CTC at its twentieth session in respect of the request by the Canadian Commissioner of Patents will be submitted, together with that request and a draft agreement between the Canadian Commissioner of Patents and the International Bureau in respect of the Canadian Commissioner of Patents functioning as an ISA and IPEA, to the Assembly of the PCT Union for consideration at its thirty-first session in September 2002.

5. *The PCT/CTC is invited to give its advice on this matter.*

[Annex follows]

ANNEX

July 5, 2002

Dr. Kamil Idris
Director General
World Intellectual Property Organization
34, chemin des Colombettes
1211 Geneva 20
SWITZERLAND

Dear Dr. Idris:

I would like to take this opportunity to inform you that the Canadian Intellectual Property Office (CIPO) has decided to seek approval from the appropriate bodies of the World Intellectual Property Organization for status as an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT). I would request that this matter be considered during the annual WIPO Assemblies in September 2002. The anticipated start date for CIPO's new ISA/IPEA services is Summer 2004.

The attached submission has been prepared to support our request for appointment as an ISA and IPEA under Articles 16(3) and 32(3) of the PCT. The submission addresses the technical aspects of our request, the rationale for CIPO status as an ISA/IPEA, and how CIPO meets the minimum human resource and documentation requirements set out under the PCT. It is noted that in respect of the documentation requirements, minimal gaps currently exist. However, these gaps will be corrected before the anticipated start date of Summer 2004. Also attached is the draft agreement which sets out the terms and conditions for CIPO status as an ISA/IPEA.

CIPO's request builds on several rounds of consultations which were held with client groups on the relative merits and benefits of ISA/IPEA status. Informal discussions were also held with members of the international community. These consultations and informal discussions have revealed wide-ranging support for our request. As an ISA/IPEA, CIPO will be able to provide client groups with greater access to the international patent system. ISA/IPEA status would also reinforce CIPO's commitment to continued excellence in the areas of client relations and service delivery.

[...]

I would like to renew my assurances of continued cooperation with WIPO, and look forward to seeing you again this September.

Yours sincerely,

(signed)

David Tobin
Commissioner of Patents, Registrar of
Trade-marks and Chief Executive Officer

Enclosures

**Appointment of the Canadian Commissioner of Patents
as an International Searching Authority (ISA) and
International Preliminary Examining Authority (IPEA)
under the Patent Cooperation Treaty**

Background

1. The global knowledge-based economy of the 21st century depends on innovation, and the investments that countries make in promoting the creativity and talents of its people. Intellectual property, a fundamental pillar of the knowledge economy, has grown in importance and awareness in recent years. It is a fundamental lever of public policy, and plays a pivotal role in stimulating economic growth and enhancing social welfare on a global scale.
2. The administration of the intellectual property system, and the timely grant of intellectual property rights, supports and encourages innovation and creative spirit. The Canadian Intellectual Property Office (CIPO), under the direction of the Chief Executive Officer, Commissioner of Patents and Registrar of Trade-marks, is responsible for the administration of the various intellectual property statutes governing patents, trade-marks, copyrights, industrial designs, and integrated circuit topographies. CIPO was established as a Special Operating Agency (SOA) within the Department of Industry in 1994, after operating in various forms since 1869.
3. As an SOA, CIPO has greater flexibility than Canadian government departments in the management of human and financial resources. CIPO operates on a revolving fund and is completely funded by the fees it charges for the delivery of products and services. This flexibility has permitted CIPO to focus on service delivery and quality, taking into consideration evolving client needs (both domestically and abroad) and a competitive labour market.
4. Intellectual property offices around the world have faced increased demand for products and services. Patent applications have risen at unprecedented rates worldwide, leading to growing workloads for national offices, including CIPO. In 2001, CIPO received some 40,000 patent applications, an increase of almost 50% from the 27,000 received only five years earlier. As evidenced by the frequency and significance of discussions relating to workload amongst national offices and in international fora, many of these offices are experiencing difficulty in maintaining acceptable service levels under the weight of growing inventories.
5. The tremendous development of the patent system has been mirrored by the extraordinary success of the Patent Cooperation Treaty (PCT). Canadian applicants, like most patent applicants worldwide, have embraced the PCT system. In 2001, the Canadian receiving Office experienced a 16% increase to 2,000 PCT international applications filed. This compares to the 14% growth in applications processed by the International Bureau of WIPO over the same period. The result is not surprising given that Canadian applicants, as an entity, have consistently placed among the 10 most prolific users of the PCT system. Additionally, PCT applications entering the national phase now constitute more than two thirds of all patent applications filed in Canada.

6. The success of the system, however, has come at a price. Many PCT International Authorities are experiencing challenges in responding to the accelerated increase in patent filings. While Authorities have attempted to continue to comply with the PCT mandated time limits for the provision of search and examination reports, the focus on PCT-related work has created challenges in the fulfilment of their national or regional responsibilities.

CIPO as an ISA/IPEA

7. In the context of its mission to help accelerate Canadian economic development, CIPO established its vision:

“To be a leading intellectual property office recognized for excellence in our products and services and for strengthening Canada’s innovative capacity, through ongoing quality improvement, continuous development of our employees and adherence to our values.”

8. In order to fulfill its mandate, in light of key economic drivers such as increasing demand for international and domestic intellectual property services, and global harmonization efforts to effectively and efficiently respond to this demand, CIPO established five strategic priorities. Two of these five strategic priorities are to:
 - deliver high quality, timely and cost effective products and services that meet clients’ needs; and
 - position CIPO to thrive in a changing domestic and global environment with a modern and responsive intellectual property framework.
9. As part of its strategy for moving forward on these priorities, CIPO has undertaken to seek approval to join the community of national and regional offices which currently function as International Searching Authorities (ISAs) and International Preliminary Examining Authorities (IPEAs) under the PCT. As an ISA/IPEA, CIPO will:
 - facilitate the prosecution of PCT international applications for Canadian applicants, enabling them to be more productive and competitive in the knowledge-based economy;
 - enhance its international reputation as a mid-sized IP office by assuming a portion of the international workload burden;
 - reinforce its commitment to continued excellence in the areas of client relations and service delivery; and
 - strengthen the quality of Canadian search and examination through increased exposure to the PCT system and access to additional search tools.

Pursuit of Excellence in Service Delivery

10. In an effort to improve services to our clients, CIPO conducted an in-depth quality assessment in Fall 2000 using the Baldrige Criteria for Performance Excellence. This assessment led to a series of organizational priorities for service improvement. Building on the knowledge, experience, and feedback from the Baldrige quality assessment, CIPO now approaches service improvement from a broader quality management perspective. In this context, CIPO has now initiated the development of a Client Relationship Management (CRM) framework that strengthens client relationships and improves service delivery by ensuring that our service levels and products are in tune with client requirements.
11. CIPO's focus on client relations has been recognized at the international level by WIPO and officials from developing countries. Under the framework of WIPO's technical cooperation program, CIPO has offered, in partnership with WIPO, a specialized course on Client Relations and Quality Management in the Delivery of Patent Services. Through this specialized course, CIPO has been able to share with other countries its knowledge and practical experience in delivering quality products and services.
12. The patent profession in Canada represents one of CIPO's primary stakeholders. CIPO has regular dealings with the profession through quarterly formal meetings, comments submitted through the CIPO Web site, and frequent informal communications. The agent profession, represented in Canada by a number of professional associations, including the Intellectual Property Institute of Canada (IPIC), has continued to develop and expand in parallel with growth in the patent system. There are currently 521 registered patent agents in Canada, and 146 registered Canadian firms. The high level of expertise of the Canadian patent profession and their commitment to the patent system is demonstrated through their regular participation in international discussions and their nomination to positions of importance within international associations, such as the International Federation of Industrial Property Attorneys (FICPI).
13. CIPO actively participates in international discussions and plays a leadership role at the international level. CIPO continues to advance the views of mid-sized offices in respect of patent modernization and harmonization by playing an active role in WIPO bodies such as the Standing Committee for the Law of Patents and the Committee and Working Group for the Reform of the PCT.
14. While CIPO strives to positively contribute to international negotiations, it is also cognizant of the need to continually modernize its national legislation and office practices to reduce administrative burdens, to provide applicants with improved services, and to comply with changing international standards. CIPO is currently consulting with Canadian users in respect of an IP Improvement Bill which will streamline and facilitate the processing of applications for intellectual property rights. The IP Improvement Bill will also contain amendments which will make the Canadian patent legislation compliant with obligations under the PLT. Furthermore, enhancements will be made to the Patent Rules in order to facilitate the filing and

prosecution of large applications in electronic format, and to provide further safeguards to applicants in exceptional circumstances where there is potential for the loss of rights, while protecting the complementary rights of third parties.

Human Resources

15. In response to the increased demand for IP rights, CIPO has taken advantage of its flexibility as an SOA to hire additional examiners. CIPO has established a strong examination corps composed of three technology-specific divisions, a section dedicated to the classification of patent documents, and a Patent Appeal Board, whose duties include the review of patent prosecution and the resolution of conflicts between applicants (under Canada's former first-to-invent patent system).
16. There are currently 165 full-time patent examiners employed by CIPO, all of whom have the sufficient technical qualifications to carry out international searches and examinations. A large number of examiners are able to perform work in both English and French, and many examiners have a good knowledge of additional foreign languages. In respect of academic qualifications, all patent examiners must possess the minimum requirements of a degree in engineering, an honours degree in chemistry or physics, or a masters degree or higher in biochemistry or molecular biology from a recognized educational institution. In addition, there are 35 examiners who possess a doctorate degree, with the majority of these highly qualified personnel examining in the emerging field of biotechnology.
17. While CIPO's patent examination staff has grown extensively in recent years, the continued influx of patent applications and CIPO's ongoing commitment to maintaining and improving service levels has necessitated the aggressive recruitment of additional staff. CIPO plans to hire some 50 new examiners in 2002. A total of 375 examiners is expected by 2006.
18. One of the limitations placed on an organization's ability to hire new recruits is its capacity to provide proper training without incurring a substantial loss of production. CIPO's current training regime for patent examiners consists of a two-year apprenticeship augmented by formal training in a variety of patent law and examination subjects, such as the *Canadian Patent Act and Rules*, jurisprudence, advanced patent prosecution and patentable subject matter. In an effort to alleviate the dependency on senior, productive examiners, CIPO is currently reviewing its training program, evaluating alternative training tools, and exchanging best practice information with other patent offices. This will strengthen the quality of search and examination and enable CIPO to recruit additional examiners while minimizing impact on production.
19. Training efforts are not restricted to the education of new examiners. Experienced examiners are encouraged to keep abreast of technology developments in their field of specialty, by reviewing technical periodicals, attending conferences, and taking part in industrial tours of Canadian companies.

Information Technology

20. In the mid-1980s, CIPO began efforts to modernize its patent office by developing information technology solutions to the patent process in Canada, in order to improve access to its wealth of patent data and to achieve greater efficiency gains in the delivery of patent products and services. These early efforts led to the deployment in 1997 of TechSource, CIPO's automated system for patents. This automated system incorporates the entire process of patent administration from filing to grant, including search and examination functions. While some efficiency gains have been realized in the search and examination functions, the greatest productivity increases were achieved in patent operations. The capability of simultaneous access to a single document by a multiplicity of users has allowed CIPO to process a greater number of applications, correspondence and fee payments, without a corresponding increase in support staff.
21. The core of the TechSource system consists of the major integration of Commercial Off-The-Shelf products; Image Plus, to handle the scanning and image management related to patent applications; INQUIRE/Text to handle textual searching requirements; and QMF to provide interactive data query capabilities. These products operate in an IBM mainframe environment with a Line of Business (LOB) system. The LOB system is a mainframe CICS and DB2 application which handles patent application tracking, financial, and client management elements of the patent process. Bridging exists between the different applications to produce an integrated system.
22. All patent applications received in paper form are immediately scanned into the TechSource system while the images of applications entering the national phase under the PCT are loaded directly from the Espace World CDs/DVDs. The title, abstract, description, and claims of the application are converted to text using Optical Character Recognition (OCR). The text from the abstract and claims is verified for quality when the image is converted to text using OCR. The text of the description remains in unedited form. Once the patent application is scanned into the system and various quality control mechanisms have been undertaken, the paper file is destroyed and all patent processing is conducted using the TechSource system.
23. The bibliographic information and associated images of patent documents are available internally through CIPO's internal INQUIRE/Text system, or externally through the Canadian Patent Database (CPD) which is accessible from the CIPO Web site. In 2001, over 650,000 searches were conducted on the CPD.
24. CIPO patent examiners are equipped with Pentium workstations which have a CD-ROM drive and Internet access through a T1 high-speed connection. This permits access to the TechSource system, and provides patent examiners with the necessary facilities to conduct their search and examination functions.
25. Major enhancements to the TechSource system are being investigated to take advantage of advances in information technology, and to reflect changes in office practice, procedures and rules. One of the more significant changes which CIPO is presently assessing is the adoption of XML for at least the front end filing and entry processes, and for data export processes. CIPO's search engines will be replaced with a single web-based application, giving users combined functionality of the previous search engines, as well as added search functions. The data model, in particular the

client data, will be significantly modified and enhanced. Existing proprietary formats and applications will be replaced with more “open” systems. Information technology solutions are also being considered to expand remote access to the TechSource system for employees working at home.

Electronic Commerce

26. The Canadian Government has committed to provide all of its key services on-line by 2004 and CIPO has met 90% of its Government On-Line (GOL) commitments. The electronic filing of patent applications is available through a secure SSL server, however, the uptake has not been as widespread as expected. It is anticipated that the electronic filings will increase once the international standard for the electronic filing of patent applications is widely adopted and reliable software is made available to users and offices.
27. The greatest increase in the use of CIPO’s suite of e-services has been experienced in e-correspondence, a service which allows an applicant to perform on-line transactions such as national phase entry and the payment of fees. This service experienced a growth of 200% in 2001, with the largest increases occurring in the payment of maintenance fees.

Patent Documentation

28. Canadian laid-open applications and patents from 1920-to date are available electronically on the TechSource system. Text searches of the bibliographic elements may be conducted. Documents from 1978-to date have the added functionality of text searches of the abstracts, claims and description.
29. CIPO has established a collection of 25 million patent documents from more than 25 countries, dating back to 1824. These documents are stored on paper, microfiche, or DVD/CD-ROM. CIPO also subscribes to a collection of 169 periodicals and has access to almost the complete set of non-patent literature referred to in PCT Rule 34.1 (b)(iii) through the Canadian Interlibrary Loan Network.
30. In addition, CIPO has access to numerous commercial databases on patents and technical literature through Questel-Orbit, Delphion, STN, DIALOG, and other databases which are freely available over the Internet, such as Esp@cenet.
31. The proliferation of on-line patent databases and the advances in Internet technology have led CIPO to eliminate paper documents and microfiche where electronic alternatives are available. Given the rapid developments in information technology, it is no longer efficient for offices to accumulate individual libraries of foreign patent documents. Advances in data transfer capabilities will increasingly result in the mutual exchange of patent documents through electronic means.
32. CIPO has recently gained access to the Trilateral Network (TriNet), a virtual private network which connects the USPTO, the EPO, and JPO. Access to this secure network will provide CIPO with greater and faster access to data and information. CIPO is working with the USPTO to gain secure access to their WEST system through the TriNet connection, and would like to see this project expanded to include the other patent offices linked through this network.

33. Regarding the PCT minimum documentation, as elaborated in Rule 34, CIPO has a limited number of documents which are not presently accessible by Canadian patent examiners. CIPO has entered into discussions with several foreign patent offices in order to obtain the missing documentation, preferably in electronic form or through a virtual private network such as the TriNet. CIPO is confident of having complete access to the PCT minimum documentation by the date upon which the Agreement between the Canadian Commissioner of Patents and the International Bureau at WIPO enters into force.

Conclusion

34. CIPO has demonstrated that it meets the requirements to function as an ISA/IPEA under the PCT on the basis of the following attributes:
- a highly qualified, competent and growing corps of patent examiners in all disciplines, possessing bilingual, sometimes multilingual capabilities;
 - a modern and efficient automated patent processing system, supported by a forward-thinking and comprehensive IT infrastructure;
 - a vast collection of patent documents and on-line resources which will permit CIPO to meet the minimum documentation requirements;
 - an organizational commitment to the pursuit of excellence in client relations and service delivery; and
 - an examination capacity to manage the anticipated international workload and which may, eventually, be in a position to offer its services to applicants filing through other receiving Offices.

[End of Annex and of document]

WIPO



PCT/CTC/20/3

ORIGINAL: English

DATE: July 19, 2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

PCT COMMITTEE FOR TECHNICAL COOPERATION

Twentieth Session

Geneva, September 23 to October 1, 2002

ADVICE TO THE ASSEMBLY OF THE PCT UNION ON THE REQUEST OF THE
NATIONAL BOARD OF PATENTS AND REGISTRATION OF FINLAND TO BE
APPOINTED AS INTERNATIONAL SEARCHING AUTHORITY AND AS
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

Document prepared by the International Bureau

1. In a letter dated June 27, 2002, the National Board of Patents and Registration of Finland expressed the wish to be appointed as an International Searching Authority (ISA) and as an International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT). The letter from the National Board of Patents and Registration of Finland is reproduced as an Annex to this document.¹
2. Article 16(3)(e) of the PCT provides that “Before the Assembly [of the PCT Union] makes a decision on the appointment of any national Office [as an ISA] ..., the Assembly shall ... seek the advice of the Committee for Technical Cooperation ...” (hereinafter referred to as the PCT/CTC).
3. According to Article 32(3) of the PCT, the provisions of Article 16(3) shall apply, *mutatis mutandis*, in respect of the appointment of an IPEA.

¹ Working documents for sessions of the Assembly and the Committee for Technical Cooperation are accessible via WIPO's Web site at <http://www.wipo.int/pct/en/meetings>.

4. The advice given by the PCT/CTC at its twentieth session in respect of the request by the National Board of Patents and Registration of Finland will be submitted, together with that request and a draft agreement between the National Board of Patents and Registration of Finland and the International Bureau in respect of the National Board of Patents and Registration of Finland functioning as an ISA and IPEA, to the Assembly of the PCT Union for consideration at its thirty-first session in September 2002.

5. *The PCT/CTC is invited to give its advice on this matter.*

[Annex follows]

ANNEX

27 June 2002

PRH Dnro 442/06/02

Dr. Kamil Idris
Director General
World Intellectual Property Organization
34, chemin des Colombettes
1211 GENEVE 20
SUISSE

**Ref.: Appointment of the National Board of Patents and Registration of Finland
as International Authority under the PCT**

Dear Dr. Idris,

I would like to take this opportunity to express my sincere gratitude to you for the kind support and assistance that you have extended to the National Board of Patents and Registration of Finland (FIPO) in connection with the FIPO's wish to be appointed as an International Searching Authority (ISA) and as an International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT).

FIPO has been an examining office since its establishment in 1942. The Finnish patent system is, however, much older. The first patent was granted by the Finnish Senate in 1842; thus, the current year is the 160th anniversary of the Finnish patent and, at the same time, the 60th anniversary of our office. The number of domestic patent applications is 2,500 applications per year. In the last five years, the number of international applications indicating Finland as country of origin has doubled and was 1,623 in 2001.

The significant rise in the number of patent applications over the past few years has put to test especially the capacity of major patent offices and caused ever growing backlogs in search and examination. Clearly there is a need for additional processing capacity in the PCT field in Europe. We are convinced that the FIPO has the necessary qualifications for conducting novelty searches and examination work and thereby lightening the burden caused by PCT work. Annexes I and II report in detail the examination resources and PCT minimum documentation used by FIPO.

I therefore have the pleasure of addressing a formal request to have the National Board of Patents and Registration of Finland appointed as an ISA and as an IPEA in accordance with Article 16(3) and Art 32(3) of the PCT.

I would be most grateful if you could put this matter before the Committee of Technical Cooperation (PCT/CTC) in order to obtain the advice of the Committee as referred to in Article 16(3)(e) of the PCT and I look forward to your favourable consideration and cooperation in this matter.

Yours sincerely,

(signed)

Martti Enäjärvi
Director General

- Annexes:
- I Examination resources in the National Board of Patents and Registration of Finland
 - II PCT minimum documentation used by the National Board of Patents and Registration of Finland

27.06.2002

Examination resources in the National Board of Patents and Registration of Finland (FIPO)

1. Overview

The function of the National Board of Patents and Registration of Finland is - besides all other duties entrusted to it - to examine and grant patents. It aims to carry out this function in a high-quality and all-encompassing manner. The comprehensive novelty search on an application is performed rapidly to enable the applicant to have confidence on the outcome of the search and make use of it when considering whether to pursue the application abroad. The quality level target in the novelty search is at least that of a search carried out in the European Patent Office. In assessing patentability, the office aims at uniformity with the practice applied in the European Patent Office. The central factors in respect of the quality in search and examination work are a competent and motivated staff, high-level education, best possible search and examination tools and methods, as well as comprehensive search material, of which there is a separate description in Annex 2.

2. Searching and examining resources

In the spring of 2002, the Patents and Innovations Line of the FIPO employed a total of 92 persons with a university degree in technology or natural sciences and with sufficient technical qualifications to carry out searches and examinations. Of these, 80 persons were working as full-time examiners with the task of examining the novelty and patentability of patent applications. The examiners were divided between divisions so that both the Machinery and Equipment and the Fixed Constructions Division had 15 examiners, the Electricity and Physics Division had 30 examiners and the Chemistry Division had 20 examiners.

During the past two years the number of personnel has been increased by 12 examiners and the objective is to further increase the examiner capacity by five examiners by the end of 2002. The FIPO is ready to increase to 100 the number of personnel with sufficient technical qualifications to carry out searches and examinations by 1 January 2004, or according to a timetable to be agreed on separately.

3. The competence of the examiners

The examiners are all experts in their own branch of technology, and have as the basic education a higher academic degree in their respective branches of science or technology. Majority of the examiners also have a long-time experience in the patent field. All examiners have, besides the knowledge of Finnish and Swedish, also a good knowledge of English and German, some also of French or Russian. Currently, an application may be filed for examination in Finnish, Swedish or English.

In recruiting new examiners, profound mastering of technological fields is emphasized, because patent applications especially in high-tech fields today are increasingly theoretical and difficult in terms of their technical contents. Six of the examiners recruited during the past two years had a scientific postgraduate education (DSc, PhD or equivalent). The new examiners consequently have gained a profound experience in research and teaching in universities, industry in the field concerned or patent agencies.

4. The situation in respect of processing the patent applications

Most of the patent applications filed with the Office annually, over 2500, are non-priority applications, where the application is first filed with the FIPO. As patents may in Finland be acquired also directly through the European Patent Office, the trust of the applicants in the quality of novelty search in the FIPO must be seen as a significant reason for the high number of applications. The trust in the quality also gives the possibility to exploit the results in an international search.

For the most part the situation regarding the processing of the applications is very good, the novelty search on non-priority applications is carried out within 6 to 7 months from the filing of the application.

The target is that in the future the resources, especially in the field of electricity and communications technology, will be sufficient for the search and examination of even substantially higher numbers of applications. In other branches of technology, too, enough staff will be recruited to get sufficient resources for the new challenges. Focal areas in knowledge include, besides communications technology and information technology, inventions realised by means of computers in general, biotechnology, medical technology, and wood processing technology with paper machines and modern measurement and control technologies. All in all, the target is to increase the examiner resources from the present by at least twenty persons, whereby the examiner staff of the Office will grow to be over one hundred. The training system has been developed so that it permits the rapid recruitment and training of so many new examiners as the possible new demand requires.

5. Training and job descriptions of examiners

The personal tutor plays a central role in the training of a new examiner. A senior examiner trains the new examiner and is responsible for all his or her decisions until the new examiner is granted an independent power of decision, which takes about two years. The in-house training comprises a basic training period of about 50 hours for new examiners and the subsequent courses on particular themes and branches of technology. After the basic training period and initiation into the work, the examiners participate in a so-called *Extended patent course* organised by the Office jointly with the Helsinki University of Technology. The course consists of regularly organised two-day seminars. There is an examination after each period and at the end a special work is done on a chosen topic. The total scope of the course is ten credits. There is also continual in-house training in languages. Examiners are spurred to participate also in courses on technological branches organised outside the Office. The overall idea in the training is continuing education.

An examiner who has been granted an independent power of decision carries out the novelty search and patentability examination of patent applications independently. However, dismissals and opposition proceedings as well as some other specified measures have to be presented to a specified senior examiner.

The status of a senior examiner may be achieved by an examiner who has proven his or her competence and has a minimum of ten-year experience. Then his or her duties include, besides the tasks of the examiner, also the receiving of presentations and, where needed, the guiding of new examiners and other teaching and development tasks. Senior examiners also give statements to the Board of Appeal in appeal cases.

6. Quality control

In ensuring the quality of search and examination work, a central role is played by the continually updated *Patent Manual*, which contains extensive instructions in respect of the work. The purpose of the Patent Manual is to harmonise our practise with the practise laid down by the Guidelines for Examination in the European Patent Office. Daily monitoring of the work and the decisions taken is also the task of every Head of Division. The Head of Division is also responsible for the control of resources, other guiding of work and the uniformity of practices among divisions in his or her Division. Client feedback, if any, is always checked thoroughly and the action that may be needed is taken.

A specially appointed *Quality control working group* has the task of taking care, in different ways, of the quality of the examination work and its improvement and of the uniformity of work among different divisions. A *Training working group* is responsible for the training and its development. Its task is to realise the continually updated training plan which takes in good time into account also the future amendments of the patent system and the legislation. A special *Online working group* has been appointed to develop and support the search and examination methods based on the databases at the disposal of the FIPO (EPOQUE, commercial data banks, in-house information systems, Internet, see separate annex) and to train and support the examiners in these matters. The members of the Online group consist of our most competent examiners that are well acquainted with the use of databases.

7. Examination methods and tools

Novelty searches are mainly conducted electronically by using the same databases and search systems as the European Patent Office. The most important of these are the EPODOC, WPI, PAJ and INSPEC databases used through EPOQUE and for example the document databases (e.g. CA database) accessible through Dialog and STN. Delphion and other corresponding databases accessible through the Internet are naturally available. The tools each examiner personally uses are as modern as possible.

The collections of publications in paper form are also comprehensive, consisting of 30 million publications. The collections are well organised and they are used whenever needed, as is the case for the time being with the examination of Nordic publications.

The search and examination material at examiners' disposal is specified in Annex II.

8. Electronic filing and processing

Electronic filing of applications with the Office became possible in spring 2001; the first on-line application was filed on April 17, 2001. We aim at introducing electronic files and electronic filing in the processing of applications during 2002-2004. For this purpose, documentation relating to an application have been brought into electronic form since the beginning of 2001.

In this respect Finland has been a pioneer among the national offices in Europe. In this conjunction it may be mentioned that we have a long tradition of processing patent applications in Finland, as the patent system has been in force in Finland for as long as 160 years and the first patent was granted in 1842.

PCT minimum documentation used by the National Board of Patents and Registration of Finland (FIPO)

1. PCT minimum documentation

The PCT minimum documentation as defined in the Patent Co-operation Treaty Rule 34.1 (PCT Rule 34.1) comprises patent publications since 1920 on paper, microfilm or electronic carriers, such as CD/ DVD-ROM discs and computerized databases. An international search on a patent application shall be made by consulting at least the documentation under the PCT Rule 34.1, after which an international search report is established. The search report can only be prepared by an industrial property office having the PCT minimum documentation at its disposal. Eligible searching authorities today are industrial property offices of Australia, Austria, China, Japan, the Russian Federation, South Korea, Spain, Sweden, the United States of America and the European Patent Office.

2. The PCT minimum documentation includes

Patent publications

PCT Rule 34.1 covers the following patent publications, published patent applications and granted patents:

- (i) the patents issued in and after 1920 by France, the former *Reichspatentamt* of Germany, Japan, the former Soviet Union, Switzerland (in the French and German languages only), the United Kingdom, and the United States of America,
- (ii) the patents issued by the Federal Republic of Germany and the Russian Federation,
- (iii) the patent applications, if any, published in and after 1920 in the countries referred to in items (i) and (ii),
- (iv) the inventors' certificates issued by the former Soviet Union,
- (v) the utility certificates issued by, and the published applications for utility certificates of, France,
- (vi) such patents issued by, and such patent applications published in, any other country after 1920 as are in the English, French, German or Spanish language and in which no priority is claimed, provided that the national Office of the interested country sorts out these documents and places them at the disposal of each International Searching Authority.
- the published international (PCT) applications, the published regional applications for patents and inventors' certificates and the published regional patents and inventors' certificates.

Non-patent literature

The PCT Rule 34.1 also covers such other published items of non-patent literature as the International Searching Authorities shall agree upon and which shall be published in a list by the International Bureau. A list of non-patent literature (230 journals) in the fields of natural science and technology is available in the JOPAL Register <http://ipdl.wipo.int/en/help/jop/help-journals.html>.

3. EPOQUE Databases used by FIPO

Country	Access to			
	BNS	EPOQUE – Full-text	EPODOC	esp@cenet
CH – Switzerland	CH 1 – all since 1888	French and German full-texts since 1900	Since 1970 CH 492757 –	Biblio 1888 – Image 1888 –
DE – Germany	DE 1 – PS 1877 – DE 1000001– AS 1957 DE 1400001– OS 1968 – DE1289000U– GM 1934 –	German full-texts since 1925 DE 406021 –	Since 1969 (PS) DE 1802683 –	DE – Biblio 1967 – DE – Image 1877 – DEU –Biblio 1968 – DEU –Imag 1968 –
FR – France	FR 500000 – 1919 – FR 2000001U – 1969 –	French full-texts since 1920	Since 1970 FR 2002904 –	Biblio 1968 – Image 1920 –
GB – United Kingdom	GB 136000 – B 1920 – GB 2000001 – A 1979 –	English full-texts since 1919 GB318286 –	Since 1918 GB 142875 –	Biblio 1969 – Image 1920 –
JP – Japan	JP patents since 1970	PAJ – English abstracts since 1975		Biblio 1973 – Image 1980 –
SU – Sovjet Union RU – Russia	RU 2002798 – C 1993 –		English abstracts since 1998	Biblio 1972 – No images
US – U.S.A.	US 1 – all patents since 1836	Full-texts since 1836	Since 1968	Biblio 1968 – Image 1836 –

4. Commercial on-line databases used by FIPO

In addition to the EPOQUE databank, the examiners at the FIPO have access to commercial hosts which provide patent, scientific and technical databases. The most important databases are in the field of bioscience and chemical engineering. The most important commercial and so-called enhanced patent databases are:

- **Chemical Abstracts Society** databases that cover chemistry literature since 1907 with over 3 million abstracts, 37 million chemical substances, 17 million bio sequences, 300 000 searchable Markush structures and 2 million patent citations.
- **Derwent World Patent Index**, which is the most comprehensive commercial patent database covering over 40 patent authorities' patent data, 10 million patent records since 1963, and 4 million drawings.
- **Inspec**, a special database in the fields of physics, electronics and data processing.

Other database services used by FIPO

- **Delphion** – covers e.g. US patents in full-text since 1971
- **Dialog** – covers 450 databases, 20 of which are patent databases
- **MicroPatent** – covers e.g. many searchable full-text patent databases
- **Questel-Orbit** – covers e.g. the PLUSPAT-patent information database which contains 35 million patent records in English
- **STN International** – covers over 200 scientific, technical and patent databases, e.g. with facility to conduct searches of chemical structures

5. PCT minimum documentation in FIPO in-house collections

Country	Access to in-house collections			
	Years *	Publication	Publ. Number	Collection
CH – Switzerland	1944	patent	CH 230450 –	Paper
	1992	patent	CH 679197 –	CD-ROM
DE – Germany	1877	PS	DE 1 –	Paper
	1957-1981	AS	DE 1000001 –	Paper
	1968	OS	DE 1400001 –	paper
	1964	GM	DE 1895601U –	abstract
	1991	PS	DE 4010517 –	CD-ROM
	1991	GM	Nr/ year	CD-ROM
FR – France	1951	patent	FR 996581 –	paper, ac*
	1951 -1971	add. patent	FR 55351-96682	paper
	1960 -1971	pharm. patent (M)	FR 1-8469	paper
	1969	patent appl.	FR 2000001 –	paper, ac*
	1992	patent appl.	FR 2663812 –	CD-ROM
	1999	patent		CD-ROM
	1994	utility model		CD-ROM
GB – United Kingdom	1902	abstract	Since 1916 nr. 1	patent gazette
	1953	patent specif.	GB 70001 –	paper
	1979	patent appl.	GB 2000001 –	paper
	1991	patent appl.	GB 2232862 –	CD-ROM
JP – Japan	1952	publ. patent appl.	nr/ year	(Repository Library)
	1971	appl.	nr/ year	
	1976	PAJ abstract	nr/ year	CD-ROM
SU – Sovjet Union RU – Russia	1952 -1993	inventor's certificate	SU 100001 –	paper
	1993 -1995	inventor's certificate	RU 2000001 –	microfilm
	1996	patent	RU 2051478 –	CD-ROM
US – U.S.A.	1872	patent abstract	US 122304 –	patent gazette
	1872	reissue patent abstr.	RE 4687 –	patent gazette
	1836	patent	US 1 –	CD/ DVD-ROM
EP – EPO	1978	patent appl.	EPA 1 –	CD/ DVD-ROM
	1978	patent	EPB 1 –	CD/ DVD-ROM
	1978	patent appl.	EPA 1 –	CD/ DVD-ROM
	1978	patent	EPB 1 –	CD/ DVD-ROM
WO – PCT	1978	patent appl.	nr/ year	paper
	1978	patent appl.	nr/ year	CD/ DVD-ROM
AT – Austria	1963 - 1991	patent	AT 229251 –	paper
	1992	patent	AT 393900 –	CD-ROM
	1995	utility model	AT 1U –	CD-ROM
AU – Australia	1965	patent abstract	AU 256137 –	patent gazette
	1981	patent	AU 514001 –	microfilm
	1998	patent		CD-ROM
CA – Canada	1957	patent abstract	CA 546167 –	patent gazette
	1966	patent	CA 724836 –	paper, mf*
	1999	patent appl.		CD/ DVD-ROM
	1999	patent		CD/ DVD-ROM
DK – Denmark	1900	patent	DK 2746 –	paper
	1980	patent appl. abstr.	nr/ year	paper
	1992	utility model	nr/ year	paper
	1994	patent	DK 157383 –	CD-ROM
NO – Norway	1892	patent	NO 2841 –	paper
	1980	patent appl. abstr.	nr/ year	paper
SE – Sweden	1885	patent	SE 1 –	paper
	1981	patent appl. abstr.	nr/ year	paper

Years * - initial year, the second year means the end of the range

ac* - French patents on aperture cards 1971 - 1992

mf* - Canadian patents on microfilm 1976 – 1999

[End of Annex and of document]