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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.

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[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

ANNEX I

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.

ANNEX II

27.06.2002

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 1957-1981 1968 1964	PS AS OS GM	DE 1 – DE 1000001 – DE 1400001 – DE 1895601U –	Paper Paper paper abstract
	1991 1991	PS GM	DE 4010517 – Nr/ year	CD-ROM CD-ROM
FR – France	1951 1951 -1971 1960 -1971 1969	patent add. patent pharm. patent (M) patent appl.	FR 996581 – FR 55351-96682 FR 1-8469 FR 2000001 –	paper, ac* paper paper paper, ac*
	1992 1999 1994	patent appl. patent utility model	FR 2663812 –	CD-ROM CD-ROM CD-ROM
GB – United Kingdom	1902 1953 1979	abstract patent specif. patent appl.	Since 1916 nr. 1 GB 70001 – GB 2000001 –	patent gazette paper paper
	1991	patent appl.	GB 2232862 –	CD-ROM
JP – Japan	1952 1971	publ. patent appl. appl.	nr/ year nr/ year	(Repository Library)
	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 1872	patent abstract reissue patent abstr.	US 122304 – RE 4687 –	patent gazette patent gazette
	1836	patent	US 1 –	CD/ DVD-ROM
EP – EPO	1978 1978	patent appl. patent	EPA 1 – EPB 1 –	CD/ DVD-ROM CD/ DVD-ROM
	1978 1978	patent appl. patent	EPA 1 – EPB 1 –	CD/ DVD-ROM 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]