

Patent Cooperation Treaty (PCT) Committee for Technical Cooperation

**Thirtieth Session
Geneva, May 8 to 12, 2017**

EXTENSION OF APPOINTMENT OF THE SPANISH PATENT AND TRADEMARK OFFICE AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

Document prepared by the International Bureau

1. All of the existing International Authorities were appointed by the PCT Assembly for a period ending on December 31, 2017. In 2017, the Assembly will therefore need to make a decision on the extension of the appointment of each existing International Authority that wishes to seek an extension of its appointment, having first sought the advice of this Committee (see PCT Articles 16(3)(e) and 32(3)). Information concerning this process and the role of the Committee is set out in document PCT/CTC/30/INF/1.
2. On February 28, 2017, the Spanish Patent and Trademark Office submitted its application to extend its appointment as an International Searching Authority and International Preliminary Examining Authority under the PCT. This application is reproduced in the Annex to this document.
3. *The Committee is invited to give its advice on this matter.*

[Annex follows]

APPLICATION OF THE SPANISH PATENT AND TRADEMARK OFFICE
FOR EXTENSION OF APPOINTMENT
AS AN INTERNATIONAL SEARCHING AND
PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

1 – GENERAL

The Spanish Patent and Trademark Office (SPTO) intends to apply to the forty-ninth session of the Assembly of the International Patent Cooperation Union for the extension of the appointment as an International Authority.

Javier Vera, Technical Advisor at Patents and Technological Dept., will be the contact person for other members of the PCT/CTC.

2 – SUBSTANTIVE CRITERIA: MINIMUM REQUIREMENTS FOR ISA/IPEA

Since 1993, the SPTO has had the role of International Searching Authority (ISA) within the framework of the Patent Cooperation Treaty (PCT). In September 2001, the SPTO extended its activity as International Preliminary Examination Authority (IPEA), becoming the first competent Authority to conduct international searches and international preliminary examination in Spanish. This enabled Spanish-speaking applicants to perform all the processes of an international patent application in their own language, saving on costs and processes.

From the beginning, the SPTO met all substantive requirements for being a PCT International Authority. This included the new requirements, for example the implementation of a Quality Management System, which the PCT system has implemented in recent years.

2.1 – SEARCH AND EXAMINATION CAPACITY

Rules 36.1(i) and 63.1(i): The national Office or intergovernmental organization must have at least 100 full-time employees with sufficient technical qualifications to carry out searches and examinations.

The technical staff working at the SPTO is comprised of 127 full time Patent Examiners. All of them are public servants who have the required technical qualifications (such as MS Engineering, Architecture, Science, Physics, Chemistry...) to search and examine in the different technical fields. In addition to this, staff require a mastery of foreign languages to the level needed to read and understand technical texts, especially patent documents.

The competencies required for the examiners are the following:

A. Linguistic skills

Beside Spanish, a high level of proficiency in English is a mandatory requirement and ability in French or German is highly desirable. These language skills should enable the examiner to read and interpret technical texts in the examiner's technical field.

B. Patent law skills

B.1 An in-depth knowledge of the most important Articles and Rules of the PCT Treaty, the Search and Examination Guidelines, the relevant sections of other Treaty's Guidelines and Administrative Instructions. Examiners should also be familiar with International treaties, such

as the Paris Convention. Above all, knowledge of treaties relevant to the examiner's field should be seen as essential.

B.2 Apart from the above, there is a large body of knowledge and information that it is considered to be useful to an examiner's work: such as the Guidelines and Internal instructions for the PCT and its differences with the EPC. Knowledge on the significance of the TRIPS agreement and the general political environment is useful to understand the basics of Intellectual Property.

C. Technical & analytical skills

A university level qualification in a technical subject is a pre-requisite for examiners. An examiner should be able to focus on technical and procedural essentials, such as the need to be able to complete a competent claims analysis, synthesize legal and technical issues in applications, and deal with clarity issues to the required level, particularly with regard to "complex" applications.

The ability to plan and perform a search, optimize strategy, perform documentary analysis and determine its primary and secondary technical relevance is also essential, in addition to the ability to carry out work decisively and set appropriate priorities.

Familiarity with search tools (Epoque, WPI, NPL, etc.) and WIPO standards is equally useful in enhancing an examiner's work.

D. Classification skills

An in-depth understanding of classification systems in general (IPC, CPC, F(I)-terms, etc) and their basic philosophies is indispensable. Knowledge in their application when classifying technical documents is as important as an awareness of their usefulness as search tools.

E. IT skills & operation of electronic tools

All examiners need to be competent in the usage of electronic internal and external communication systems in the office. In-depth knowledge of modern IT systems implemented in the SPTO, such as the ALFA patent processing system, are also a requirement for examiners

F. Search strategy & search execution skills

For every examiner to be able to perform a quality search, search skills are of great importance. This means primarily an understanding of how search engines work. Thorough knowledge of the composition and content of databases and its relevance to particular fields is equally essential. Furthermore, devising focused strategies, knowledge of which are the most appropriate databases to be searched and sufficient knowledge of the technical field concerned to be able to take an informed decision on the extent of the search are all part of the basic skills of a competent examiner.

G. Drafting skills

All examiners need the ability to write structured and comprehensible opinions and to formulate substantiated arguments in writing.

Number of Employees qualified to carry out search and examination:

Technical field	Number (in full-time equivalent)	Average experience as examiners (years)
Mechanical	61	12
Electrical/electronic	26	14
Chemistry	17	18
Biotech	23	19
Total	127	15

Recruitment and Training programs in the Spanish Patent and Trademark Office

Next is a summary of the recruitment process and training programs for new examiners and ongoing training activities for existing examiners, including typical amount of time spent on training.

RECRUITMENT

Due to the special features of the Spanish Law concerning contracting people for working as civil servants, the recruitment process to become a Patent Examiner is extremely stringent. Only those with a technical degree, extensive language skills and knowledge of national and international laws can attend the competitive exams. After this, the patent examiner must show adaptability to the job in a trial period after which another evaluation will take place.

The number of examiners requested and the specialization is determined to ensure that the differences in the demand in the technological fields throughout time do not alter significantly the quality in terms of timeliness and completeness.

Similarly, administrative staff follow a very exigent process to become a civil servant with clear requirements with respect to education, languages, IT skills and previous experience.

A – Recruitment of examiners

Recruitment of Examiners is an open competition for a limited number of posts, consisting of four exams:

First Exam: 100 questions over:

- (a) Spanish Public administration
- (b) National, European and International Laws and Regulations
- (c) Technology Information and Documentation

Second Exam: Items on

- (a) Spanish Public Administration,
- (b) National Law and European and International Regulations on Industrial Property (Patentability, Novelty, Inventive Step, Granting procedures, etc)
- (c) Technology, Information and Documentation

Third Exam: Practical exam

- (a) Classification of patent documents
- (b) Search Report

Fourth Exam: Languages: English and either French or German

The participants that pass the four exams become an "*Examiner in practice*", remaining in this status for at least a period of 2 months.

Patent Examiners in practice receive an intensive course lasting two months regarding Industrial Property topics, national and PCT procedures, search, examination and data bases.

After the two-month initial training course, there is a final evaluation. If they pass it, they become Junior SPTO Patent Examiners. When a Spanish Patent Examiner begins to work at the SPTO he has a Senior Examiner as a tutor during 6 months. After that, the tutor acts as a patent assistant more until the Junior Patent Examiner becomes a Senior patent examiner (it takes 2-3 years).

B – Recruitment of administrative staff:

B1) Selection within the framework of the Spanish General Administration of the State.

The SPTO is an Autonomous Institution of the Ministry of Industry, Energy and Tourism. The access to the public function in Spain is determined by the national law, which establish three different ways of access, depending on the status of applicants within the public function, all of them based on an open competition. The selection process consists on different exercises

B2) Selection within the framework of the SPTO.

The candidates that comply with the requirements may apply for the post. Particular requirements are described in the table below:

Description of the Job	Courses required	Specific Merits
<ul style="list-style-type: none"> ○ Formal examination and procedure of PCT international applications. ○ Control, registry and verification of PCT applications 	<ul style="list-style-type: none"> ○ Related to Industrial Property, National administrative procedure and PCT. ○ Office computerization. ○ Knowledge of data bases 	<ul style="list-style-type: none"> ○ Experience in administrative procedures. ○ Knowledge of administrative procedures, special in Industrial Property and PCT. ○ English and/or French Knowledge

TRAINING

The SPTO employs three people-year to develop training courses according to the needs of the Departments of the Office. These people, with the participation of all parties involved, elaborate an annual training plan. The annual training plan and the different seminars, courses, etc. are evaluated to design future activities.

There is a continuous training programme for Spanish Patent Examiners. The SPTO every year organizes courses of general character or specifically related to certain matters: Courses on basic tools of computers, courses to emphasize on general administrative procedure or Industrial Property and courses to update any change in PCT Procedures.

A harmonised and continuous training programme is established for staff covering the main topics involved in the required competencies for examiners described above , i.e.:

- Language Training Courses
- Patent Law Seminars (PCT Procedure Revision, PCT new Guidelines, etc.)

- Technical and Analytical Skills (Technical courses on specific fields, work visits, Exchange Programme Examiners)
- IT Skills and operation of electronic tools (EPOQUENet, specific Databases, etc.)
- Classification Systems Seminars (IPC, CPC, F-terms)
- Search and Examination Skills (Courses on Novelty, Inventive step, Complex Applications, Non Unity, etc.)

These courses are conducted by heads of division and experienced Senior Examiners, as well as EPO experts.

Rules 36.1(ii) and 63.1(ii): That Office or organization must have in its possession, or have access to, at least the minimum documentation referred to in Rule 34, properly arranged for search purposes, on paper, in microform or stored on electronic media.

For decades there has been a sustained effort to improve the documentation in the SPTO. Starting from the traditional formats (paper, microfiche and microfilm) and as technology evolved very quickly; we have incorporated documents in other formats, CDs, DVDs. In this way, the SPTO already ensured, in the early 1990s, the requirement to have access to the PCT minimum documentation. Currently, online databases play a key role in accessing the documentation easier and quicker. The electronic tools for the examiners and administrative staff are continuously improved. This improvement means a continuous update of the computer infrastructure. As described below the SPTO has access to the most modern and complete databases, which allow us to obtain the most relevant information of patents and non-patent literature. Consequently, the SPTO has full access to all documentation as defined in Rule 34 PCT.

Access to the minimum documentation for search purposes:

(X) Full access

Search systems:

Below are the IT systems or paper collections used in the SPTO for search of different forms of prior art.

Main databases used currently by the SPTO (among others):

- EPOQUENet, incorporating access to Derwent World Patent Index (DWPI) (provider: Clarivate Analytics); BIOSIS (provider: Clarivate Analytics); COMPENDEX (provider Elsevier); EMBASE (provider Elsevier); SCIENCE DIRECT (provider Elsevier); INSPEC (provider IET); IEEE (provider: Institution of Electrical and Electronics Engineers).
- STN International databases, through the STN express platform. We use them mainly in the chemical, pharmaceutical, food and biotechnology fields (most used databases are, among others: Chemical Abstracts, Registry, FSTA, DGENE and so on)
- The SPTO is also using free databases for genetic sequences searching provided by EBI.

Databases for Spanish language collections:

- INVENES: Spanish documentation, not completely present at EPO databases, is assured by using this free public access database which includes the digitized Spanish documentation from 1826.
- LATIPAT: Documentation written in Spanish from Latin-American countries: more than 2,500,000 documents from 19 countries.

Non-Patent Literature; Magazine articles:

- SPTO retrieves most articles from the full text databases, for example, Elsevier.
- Other sources for providing articles come from agreements with Spanish university libraries. Also the Official Research Council of Spain, which has one of the most comprehensive network of libraries specialized in almost every field of technology, provides the SPTO with copies of the NPL articles upon demand.
- The British Library: In very specific cases the British Library also provides the SPTO with NPL upon demand.

SPTO access to patent documentation and non-patent literature exceeds by far the minimum documentation required by Rule 34. Therefore, the SPTO satisfies more than enough, the requirements established in the PCT Rules 36.1(ii) and 63.1(ii).

Rules 36.1(iii) and 63.1(iii): That Office or organization must have a staff which is capable of searching and examining the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated.

Before joining the SPTO, every examiner must have a thorough knowledge of English (mandatory) and French or German as a third language. This enables the examiner to read and interpret technical texts, especially patent documents, in the corresponding technical field.

Language(s) in which national applications may be filed and processed:

Spanish

Other languages in which large numbers of examiners are proficient:

English, French, German

Services available to assist search or understanding of prior art in other languages:

The Bilateral Cooperation Plan (BCP) between the European Patent Office and European Patent Organization Member States (including Spain), now renewed for the period 2016-2018, includes, among others, projects in the field of Patent Information and Awareness and Patent related IT services and tools. The project "General Language Training" (Category A08 under P02 European Patent Network Training) aims to improve the language proficiency of the European National Patent Offices staff, involved in patent related activities. It offers financial support for improving the language proficiency of National Patent Offices (NPOs) staff who don't have English, French or German as their mother tongue. Courses are provided by the following prestigious language institutes: the British Council, the Goethe Institute and the Institut Français. Language courses are offered to NPO staff via individual training courses for senior management, and in the form of group lessons for staff involved in patent-related activities such as patent examiners.

2.2 – QUALITY MANAGEMENT

Rules 36.1(iv) and 63.1(iv): That Office or organization must have in place a quality management system and internal review arrangements in accordance with the common rules of international search.

In relation to the requirement that the Office must have in place a quality management system and internal review arrangements in accordance with the common rules of international search,

SPTO refers to the 2016 annual report on its existing Quality Management System submitted to the International Bureau in accordance with Chapter 21 of the PCT International Search and Preliminary Examination Guidelines.

The 2016 annual report, following the template for this purpose, can be found at the following link: <http://www.wipo.int/pct/en/quality/authorities.html>

The SPTO has a Quality Management System externally reviewed and certified in conformance with ISO 9001:2008.

The System is well established and maintained as it has been in operation as a certified QMS from 2007.

The upgrade of the QMS to the latest version of the standard (ISO 9001:2015) will take place during 2017.

3 – INTENDED SCOPE OF OPERATION

Language(s) in which services would be offered:

Spanish

State(s) or receiving Office(s) for which Authority would offer to be competent:

The SPTO is currently competent for international applications filed at the following receiving Offices (or at the International Bureau where the applicant is a national or resident of one of those States): (in alphabetical order) Chile, Colombia, Costa Rica, Cuba, Dominican Republic, Ecuador, El Salvador, Guatemala, Honduras, Mexico, Nicaragua, Panama, Peru and Spain. However, in principle, the SPTO would be open to extending its services to any other receiving Office which permitted the filing of international applications in the Spanish language.

Limitations on scope of operation:

The SPTO shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1 (subject matter not required to be searched or examined), as the case may be, with the exception of any subject matter which is searched or examined under the patent grant procedure in accordance with the provisions of the Spanish Patent Law, Nr. 24/2015, of 24 July.

The SPTO does not conduct Supplementary International Searches

4 – STATEMENT OF MOTIVATION

The SPTO intends to apply for the extension of its appointment as International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty (PCT).

The aim of our participation in the PCT system is to foster research and innovation by making the international protection of patents and utility models more attractive and accessible to inventors, universities and companies, especially SMEs. Therefore, we would like to highlight the importance for Spain of continuing to play a key role in the international IP system as ISA/IPEA to ensure that the PCT system is accessible to users wishing to file in the Spanish language.

Spain strongly believes that the protection and promotion of Intellectual Property promotes the economic growth and development and acknowledges WIPO's fundamental mission of developing a balanced and effective international intellectual property (IP) system that enables innovation and creativity for the benefit of all.

Spain joined the PCT on 16th November 1989. Later on the SPTO was appointed as International Searching Authority (ISA) by the Assembly of the International Patent Cooperation Union in 1993, and the SPTO started to fulfill this role 1995. In 2001, the SPTO was appointed as Preliminary Examining Authority (IPEA) and started to act as such in 2003.

Thanks to our long experience in the PCT field, our experts have assessed and helped other offices in their process of becoming ISA/IPEA. One recent example is the evaluation conducted by our office of the Turkish Patent Institute.

We would like to emphasize that Spain is one of the member states currently participating in the PCT paperless pilot project. This is not the first project regarding electronic exchange of information between two offices that SPTO has taken part in, since our office is already working on the Utilization Implementation Project (UIP) of the EPO. Within these technical activities, SPTO is also working closely with WIPO to promote the use of WIPO's standards to exchange data.

The SPTO is committed to the use of IT throughout all the procedure. The development of tailored tools provides an effective management of both front office and back office. For instance, all the IPR applications can be submitted electronically at the SPTO and the examiners have a range of management tools that allow them to simplify processes and reduce timelines.

We would like to continue working with the aim of keeping and improving PCT standards of quality and its good reputation. As it is described in our annual report on quality management systems, the SPTO is certified according to ISO 9001:2008 for the PCT procedure amongst others.

Despite the difficult economic situation in recent years, SPTO has continuously invested in hiring new patent examiners and training its staff to keep them up-to-date and to ensure high quality reports. All SPTO examiners are specialized in a certain technical field, they are fluent at least in Spanish and English and they are full-time dedicated to patent related tasks (search, examination, classification and so on).

These efforts have been proved by the timeliness and quality of the reports made by the SPTO.

Spain has continuously supported activities related to the PCT in Latin-America, for instance, we have annually contributed to the celebration of the PCT regional seminar in Latin-America with our Fund in Trust. Also, the SPTO has strongly contributed to the creation of a Quality Manual for Receiving Offices in Latin-America. Traditionally, the relationship with Latin America in the field of Industrial Property has been one of the priorities of the SPTO. Therefore, our work as ISA/IPEA in Spanish has not only helped to meet the demand of PCT searches in Spain but also in Latin-America. The SPTO has been always devoted to the promotion of the Spanish language as a technological language.

Having this in mind, the SPTO has effectively worked to ensure that the patent documentation available is complete and exhaustive. In this regard, it is necessary to mention the LATIPAT Project whose aim is to maintain a free database, in Spanish and Portuguese, containing information on Patents from all Latin-American countries. LATIPAT is a cooperation-project between WIPO, European Patent Office (EPO), SPTO and 19 Industrial Property Offices from Latin-America.

The SPTO continues to respond to the needs of Spanish applicants through outreach, training and customer service activities. This includes a training programme with information on how to protect innovation abroad, SPTO experts gave more than 200 workshops and conferences at

different universities, institutions and research centers in 2016. In addition to this, an “on call examiner” service has been established to give direct assistance to applicants (face to face, by phone or e-mail) regarding national and PCT procedures and an “SME support service” has been established to provide information to entrepreneurs and SMEs.

A comprehensive survey of PCT and Patent users was conducted in 2015/2016 to measure satisfaction with the services provided by the office. More than 500 users responded to the survey. The overall satisfaction indicator for PCT services provided by the SPTO was 3.97 out of 5, with a marked improvement across all areas compared to previous surveys.

Last but not least, SPTO is deeply involved in all WIPO committees and working groups related to the PCT. Spanish experts actively take part and make proposals to enhance the international IP system to the benefit of users.

5 – APPLICANT STATE

Regional location



Spain and neighboring States

Regional organization memberships:

Spain is member of the following IP related organizations:

- World Intellectual Property Organization (WIPO)
- European Patent Organization (EPO)
- European Union Intellectual Property Office (EUIPO)
- Programa Iberoamericano de Propiedad Industrial y Promoción del Desarrollo (IBEPI)

Population: 46.77 millions (2015)

GDP *per capita*: 23,290 euros (2015)

Estimated national R&D expenditure (% of GDP): 1.22 per cent (2015)

Number of research universities: 83 universities (2015)

Summary of national patent information network (for example patent libraries, technology and innovation support centers):

– Patent libraries:

Spain has created its own patent databases in order to allow a free access to the patent documentation in Spanish: INVENES database, LATIPAT database (<https://www.oepm.es/en/invenciones/index.html>)

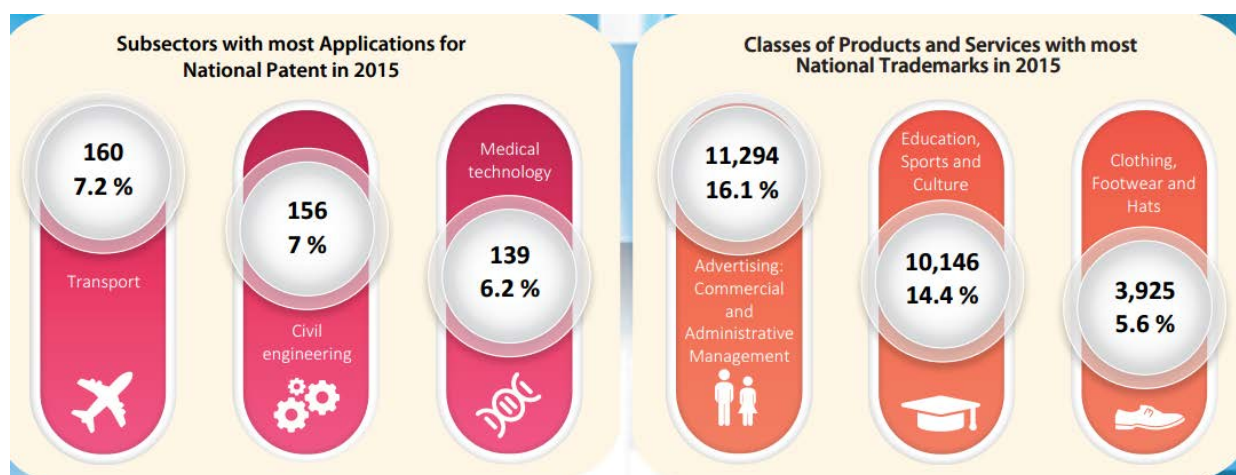
Spanish patent-documentation is also available through Espacenet (<https://es.espacenet.com/>) and Patentscope (<https://patentscope.wipo.int/search/es/search.jsf>)

– Technology and Innovation Support Centers:

There are 17 autonomous communities in Spain. Spain has created a network of technology and innovation support centers located in 16 of those communities.

The SPTO's website has a link with the contact information of each regional center. (http://www.oepm.es/es/propiedad_industrial/enlaces_de_interes/centros_regionales_informacion_propiedad_industrial/index.html)

Major local industries:



Major trading partner States: The EU countries (France, Germany, Italy, United Kingdom, Portugal...), the United States of America, Morocco

Other key information:

Spanish National Plan for Scientific and Technical Research and Innovation (2013-2016): (http://www.idi.mineco.gob.es/stfls/MICINN/Investigacion/FICHEROS/Spanish_RDTI_Plan_2013-2016.pdf)

6 – PROFILE OF PATENT APPLICATIONS

Number of national applications (Patents) received – by technical field

Year \ Technical Field	2012	2013	2014	2015	2016
Mechanical	1,618	1,629	1,374	1,348	1,378
Electrical/electronic	833	764	749	701	604
Chemistry	584	504	579	548	627
Biotech	326	236	329	285	228
<i>Total</i>	<i>3,361</i>	<i>3,133</i>	<i>3,031</i>	<i>2,882</i>	<i>2,837</i>

Breakdown is made by WIPO IPC-Technology concordance table¹

- Mechanical includes groups IV and V of the table
- Electrical/electronic includes group I and subgroups II.9, II.10 and II.12
- Chemistry includes subgroups II.11, III.14, III.17 and III.19 to III.24
- Biotech includes subgroups III.15, III.16 and III.18

Number of national applications (Utility Models) received – by technical field

Year \ Technical Field	2012	2013	2014	2015	2016
Mechanical	1,880	2,024	2,084	1,729	1,791
Electrical/electronic	438	404	410	432	325
Chemistry	191	193	183	154	291
Biotech	8	12	12	13	15
<i>Total</i>	<i>2,517</i>	<i>2,633</i>	<i>2,689</i>	<i>2,328</i>	<i>2,422</i>

Number of national applications (Patents and Utility Models) received – by route

Year \ Route	2012	2013	2014	2015	2016
National first filing/internal priority	5,683	5,538	5,579	5,057	5,121
Paris priority	195	228	141	153	155
PCT national phase entry	136	126	170	164	73

Number of international applications received as RO

Year \ Technical Field	2012	2013	2014	2015	2016
Mechanical	596	548	624	570	471
Electrical/electronic	378	335	350	304	266
Chemistry	415	431	428	411	341
Biotech	247	229	256	197	156
<i>Total</i>	<i>1,636</i>	<i>1,579</i>	<i>1,658</i>	<i>1,482</i>	<i>1,234</i>

Main Offices/States in which priority is claimed from national applications:

Main/Offices States in order of importance: United States, Japan, France, Germany and Italy

¹ http://www.wipo.int/ipstats/en/statistics/technology_concordance.html

Average time taken for national patent and Utility Models processing

Indicator	Measured from	Time (months)
To search and first examination ² .	From filing	9.7 months for National Patents
		No search is done for Utility Models
To grant	From filing	11.01 months in case the applicant choose accelerated procedure (20% of applications)
		20.85 months regular procedure
		4.2 months for Utility Models (9.2 months for those files with oppositions, 2.8% of the total files)

Data from 2016

National workload

Measure	Number of applications
All pending applications (in process before final resolution)	4,063 Patents 768 Utility Models
Applications awaiting search and first examination ² (where relevant fees paid)	502 Patents No search is done for Utility Models

Data from January 31, 2017

7 – SUPPORT REQUIRED

At this point, this Office doesn't consider necessary to require assistance from the International Bureau or other Contracting States in order to comply with the requirements for reappointment or for the effectiveness of the international search and preliminary examination processes carry out at SPTO.

Having said that, SPTO benefits and consider very helpful the work done by the International Office and International Authorities both through resources made available to PCT contracting states and also through discussion and meetings in order to share and disseminate good practices.

8 – OTHER

International Cooperation

Cooperation between the SPTO and other IP offices and international organizations has proved to be essential in order to exchange information and to achieve homogenous Intellectual Property practices.

In addition to strengthening relations, these initiatives protect and promote Intellectual Property Rights through partnerships based on mutual exchange of information, best practices and training activities, which result in shared experiences for mutual benefit.

The SPTO has signed several Patent Prosecution Highway (PPH) agreements with other IP offices (China, Colombia, Finland, Russia, Japan, Mexico, Turkey, Morocco, and Turkey). The spirit of these PPH Agreements is to promote worksharing and enable patent applicants to

² Spanish National Procedure includes a written opinion with the search results; therefore First examination is done at that point.

request accelerated processing of their applications. This Office has also signed a number of PCT-PPH agreements which include PCT work products. Additionally, in 2014, the SPTO joined the Global PPH Project that allows patent applicants to request accelerated examination at any of the 22 offices involved.

In addition to this, the SPTO has established bilateral cooperation programs with a number of countries (Argentina, Brazil, Colombia, Costa Rica, Cuba, Chile, China, Dominican Republic, Ecuador, El Salvador, Guatemala, Honduras, Israel, Jordan, Korea, Mexico, Morocco Panama, Paraguay, Peru, Portugal, Russia, Singapore, Turkey and Uruguay). These Memoranda of Understanding define a framework within IP offices share experiences or training programs, cooperate in search and examination applications, or exchange data in order to enhance the international patent system.

In the framework of these bilateral programs, the SPTO launched a training program on Patent Searches and Examination (CIBIT). The main objective of this program is to teach Ibero-American patent examiners to search in different databases and to use different technological information services.

Traditionally, the relationship with Latin America in the field of IP has been one of the priorities of the SPTO. With this in mind the Spanish Fund-in-Trust (FIT/ES) was established at WIPO in 2004. Since then, many projects have been supported by the FIT/ES. For instance, the LATIPAT Project to create a free database, in Spanish and Portuguese, containing information on Patents from all Latin-American countries. This project was conceived as a database that would act as a global reference tool. Moreover, interregional seminars for Latin-American judges and prosecutors have been organized on a yearly basis. The aim of these seminars is to achieve a greater protection of Industrial Property and to promote a uniform interpretation of current Industrial Property legislation. Also, this Fund-in-Trust has allowed the creation of a Harmonized Manual of criteria used to register distinctive signs for the countries of Central America and the Dominican Republic, which is used as a common reference tool for administrative and technical management of the procedure for granting trademarks. It has also financed a Patent Manual for the countries of Central America and the Dominican Republic, which defines common guidelines for examining applications for patent inventions in participating countries.

On top of that, the SPTO has signed a cooperation agreement with the CEDDET Foundation in order to offer online courses to Ibero-American IP stakeholders, such as examiners, judges and prosecutors. These courses aim to enhance the IP system at an international level by creating a network of IP experts, mainly in Ibero-America.

Also, the SPTO in cooperation with the WIPO Academy has organized since 1982 a trademark course called "*Curso de Formación Interregional sobre Marcas y aspectos comunes de la Propiedad Industrial*", which is aimed at Ibero-American trademark examiners from different IP Offices whose duties may require them to have a deep knowledge of the international IP system. This well-known course has duration of one week and it includes lectures from trademark experts, group discussions on selected IP topics and several cases studies.

The SPTO has also signed a Memorandum of Understanding with WIPO on cooperation in the field of IP dissemination. SPTO's experts have participated in different events in Moldavia, Uzbekistan, Slovenia and Ukraine with a view to fulfil the academic needs of the region and increase the quality of IP professionals in the region.

Last but not least, the SPTO maintains a fruitful cooperation with the EUIPO and the EPO that keeps our office up to date with the latest IT tools and databases on IP, tries to harmonise and converge the procedures and increase predictability for the benefit of users.

New Patents Act

On 25 July 2015 a new Patents Act (Act 24/2015, of 24 July) was published in the Spanish official bulletin, which will replace the Patents of Act 11/1986. The new Patent Act will enter in force on 1 April 2017.

The principal object of the new Patent Act is to harmonize the Spanish regulatory framework with the principles set forth in the European Patent Convention and the Patent Cooperation Treaty, to simplify and speed up the protection of inventions, and to strengthen legal security and provide "solid titles" to inventors.

The new Spanish Patents Act will introduce a number of changes, both in the granting procedures and in enforcement proceedings.

The main changes in the granting procedure are the following:

- A single Procedure of grant. There will be a single granting procedure which will examine patentability requirements; the old Patents Act featured a dual system where the applicant had two options: Either following the general procedure (grant without substantive examination of novelty and inventive step) or requesting a special procedure that included substantive examination of the patentability requirements.

The new Patents Act establishes a single procedure with a search report (and a written opinion) followed by a compulsory examination of novelty, inventive step and industrial applicability. As a consequence of this, "strong" patents will be granted.

- A simplification of the patent granting procedure. The procedure will be simplified to allow the applicant more time to decide whether to continue or not with the prosecution of the patent application and/or extend it abroad.
- A Post-grant opposition system will be implemented. Instead of the pre-grant opposition proceedings that were in place. The opposition under the new system must be filed within 6 months following the date of grant.

9 – ASSESSMENT BY OTHER AUTHORITIES

SPTO has been acting as an international Authority since 1995 and is requesting extension of its appointment. Therefore it is not expected to seek the assistance of other International Authorities as recommended to Offices seeking initial appointment.

On the contrary, SPTO has assisted another Office in the assessment of the extent to which it meets the criteria for appointment as an International Authority:

From December 2015 to March 2016, an assessment of the SPTO at the Turkish Patent Institute (TPI) took place in order to provide technical assistance to the TPI in its application process as a PCT International Authority (ISA/IPEA) according to the new requirements for those Patent Offices seeking appointment to become PCT International Authorities. The final outcome of this assistance was that the SPTO submitted an evaluation report that was used for the TPI in its application to become a new PCT ISA/IPEA. The Committee for Technical Cooperation (CTC) in May 2016 unanimously agreed to recommend to the Assembly of the PCT where finally the TPI was appointed.

As an example of ongoing activities between International Authorities with exchanges of information concerning good practice, the SPTO is involved in search harmonization activities in Europe in the PCT framework in accordance with the European Patent Convention Protocol of Centralization that stipulates cooperation between the European Patent Office (EPO) and the

rest of the European ISA/IPEA (currently 7 including the EPO). A Permanent Committee on Harmonization of Search Activities (PCHSA) and three Working Groups (Quality, Tools and Training) composed of representatives of each Office, were established and meet periodically. The cooperation is covering search procedures and methods, qualifications required for the recruitment and training of examiners, guidelines for the exchange of search, exchange of harmonization files and other services between the Offices as well as other measures needed to establish the required control and supervision.

Finally, in another example of collaboration with other authorities and good practices, the SPTO has participated in the pilot, together with other three Authorities, to provide a paper based audit of the Quality Management System of other Office based upon the Chapter 21 reports. As result of this pilot, this paired review has been adopted for future meetings of the Quality Subgroup as a good practice to exchange ideas and build networks.

[End of Annex and of document]