

## **Patent Cooperation Treaty (PCT) Committee for Technical Cooperation**

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

### **EXTENSION OF APPOINTMENT OF THE NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY OF CHILE 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 March 1, 2017, the National Institute of Industrial Property of Chile 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 NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY OF CHILE  
FOR EXTENSION OF APPOINTMENT  
AS AN INTERNATIONAL SEARCHING AND  
PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

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**1 – GENERAL**

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**Name of Office or intergovernmental organization:**

Instituto Nacional de Propiedad Industrial de Chile / National Institute of Industrial Property of Chile

The National Institute of Industrial Property of Chile (INAPI) is a decentralized public service, technically and legally responsible for the care and management of all industrial property services in Chile. INAPI is in charge of promoting the protection granted by industrial property and disseminating technological knowledge and information. Among other responsibilities, INAPI is advisor to the President on matters related to industrial property both domestically and internationally, and is also a first instance court in opposition and nullity procedures.

INAPI started operating in January 2009, replacing the former Department of Industrial Property of the Ministry of Economy. The creation of INAPI was a milestone in Chile's system of innovation and one of several important measures taken by the Government of Chile that show its clear commitment to the promotion of innovation, competition and entrepreneurship through intellectual property.

For the performance of its functions, INAPI is organized in three main areas: Trademarks, Patents and Transfer of Knowledge (other areas are the Legal and the Administrative, the Operations and Finance Divisions). These areas are supported by a group of professional advisors to the National Director in areas of policy (i.e. Legislative, International, Strategy and Public Policy Departments).

In its core business areas, namely patents and trademarks, lawyers, examiners, technical and administrative personnel perform the examination of all applications in order to determine whether or not to grant each right. Through its Transfer of Knowledge Division, INAPI promotes and encourages the use of industrial property and knowledge transfer. Pursuing this same objective, INAPI launched at the beginning of 2012 INAPI-Proyecta ([www.inapiprojecta.cl](http://www.inapiprojecta.cl)), a platform developed in conjunction with the European Union to facilitate access to technological information, provide tools for better use of industrial property rights and to learn about intellectual property through online courses.

Continuing this initiative, INAPI launched two new web services in 2016 for encouraging the use of IP among the public. The first one, called INAPI Conecta ([www.inapiconecta.cl](http://www.inapiconecta.cl)), is a web service in which the applicant uploads as much information concerning his/her application as wanted in order to get in touch with any interested investor, who is also registered in this web page and therefore may have access to the information posted in this site. In this way, INAPI Conecta provides a linking service between applicants and possible investors in order to plan a strategy for licensing, assignments or whatever business services they want to run with their IP right.

Another web service recently created at INAPI is INAPI Analiza (<http://www.inapi.cl/portal/publicaciones/608/w3-propertyvalue-12030.html>), a statistical tool which retrieves information concerning 25 years of applications filed in INAPI, as well as statistics of Chilean applicants abroad. This web service provides information based on country of origin and the classification of the applications filed, among others. It makes the distinction of the year of filing, allowing the user to analyze the changes in the technological trends over the

years. This tool covers the PCT statistics, both for Receiving Office and INAPI as an International Authority, thereby retrieving information concerning country of origin, kind of applicant, technical field of the applications filed as well as their way of filing, among other information of interest.

Within its policy areas, INAPI employs intellectual property experts responsible for crafting new legislation on industrial property, including a bill submitted to Congress for a new industrial property law, delivering technical opinions on various international issues and advising other agencies of Government in intellectual property matters.

Complementing all the above, through its support areas, INAPI has carried forward a series of programs aimed at designing a completely new on-line services platform, stable and dynamic, that allows for a total online processing of industrial property rights.

**Date on which application for appointment was received by the Director General:**  
March 1, 2017

**Session of the Assembly at which reappointment is to be sought:** PCT Union Assembly 2017.

**Expected date at which operation as ISA/IPEA could commence:** Already working as an International Searching Authority and International Preliminary Examining Authority (ISA/IPEA) since October 22, 2014.

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## 2 – SUBSTANTIVE CRITERIA: MINIMUM REQUIREMENTS FOR APPOINTMENT

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### 2.1 – SEARCH AND EXAMINATION CAPACITY

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**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.*

**Employees qualified to carry out search and examination:**

Technical field	Number (in full-time equivalent)	Average experience as examiners (years)	Breakdown of qualifications
Mechanical	29	10.3	-
Electrical/electronic	12	8.5	-
Pharmaceuticals	29	12.6	-
Chemistry	24	10.6	-
Biotech	30	7.4	-
Industrial Designs	5	17.7	-
<i>Total</i>	129	10.3	-

The Office has both internal and external experts trained and qualified for properly performing search and examination of applications. External experts are mainly working in domestic applications. The internal experts are specially focused on PCT applications in the international phase, but they also are responsible for examining the domestic applications when analyzing whether to recommend grant or refusal of these applications.

As for the breakdown of qualifications, our specialists are well qualified to perform search and examination in every section of the classifiers related to mechanics, electronics, pharmaceuticals, chemistry and biotech, as detailed in the table above.

## Training Programs

The process of incorporating new professionals starts by identifying needs in technical areas and building a profile for the post. Then a public application process specifying qualifications is conducted which concludes with the selection of candidates. These candidates are subject to a comprehensive training and selection that is divided in two stages: first an "induction", focused on providing general knowledge and expertise with regards to patents and industrial property. A second stage corresponds to the training itself. During this period the candidate works under the guidance of experts at INAPI, conducting examination of actual patent applications.

The entire process is overseen by the heads of the technical areas of the Department of Examination who finally evaluate the performance and capacity of the candidates, selecting those who meet the requirements set by INAPI.

Finally, once candidates are accepted as part of INAPI, each selected candidate has an assigned tutor that supervises and provides support when preparing their first reports. Tutoring is held for one year with different supervisors within the same technical area. The performance of new professionals is assessed every four months. If after a year (or earlier), the candidate demonstrates the development of skills and abilities necessary to perform search and examination reports, he may start working independently. The purpose of this process is that, within an 18-month period, all new experts must be prepared for search and examination without the supervision of a tutor, taking into account the law, regulations and the Guidelines.

The process of recruitment and training has been developed and designed so as not to affect the productivity of the Office. This has been reflected in the fast reduction of pending applications over the past years.

***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.***

### **Access to the minimum documentation for search purposes:**

(X) Full access

### **Search systems:**

Currently INAPI has access to the most important databases that collect the widest extension of patent and non-patent literature for searching purposes. These databases include free access databases such as Patentscope, Espacenet, Latipat and the available collections on the different IP Offices web pages (such as INAPI, SPTO, USPTO, JPO-AIPN-, KIPO (K-Pion), SIPO, among others).

Apart from the above, we also have access to private databases especially designed to collect and make available Patent and Non-Patent Literature Documentation. Therefore, we have access to EpoqueNet, Thomson Innovation (Now Clarivate Analytics), IEEE, STN, Proquest Dialog, Genome Quest and the Electronic Library of Scientific Information (BEIC), which is a searching tool developed by the National Commission of Technical and Technological Research (CONICYT) and which allows searching in scientific publications such as Oxford University Press, Elsevier, AAAS, American Chemical Society, Annual Reviews, Nature, Springer Links and Wiley-Blackwell. The creation of this platform involved a big cost for the Government, exceeding 10 million United States dollars of expenses for this item.

Not only that, but we have signed Agreements with the Indian Council of Scientific and Industrial research to have access to the TKDL, as well as Agreements with SIPO, KIPO and JPO to have access to specific databases of these Offices.

***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.***

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

INAPI only accepts applications filed in Spanish. Any application filed in any other language must be properly translated for the application to be processed toward search and examination.

**Other languages in which large numbers of examiners are proficient:**

Our examiners have a high proficiency on English (about 80% of them have an advanced level in this language and keep being continuously trained in this skill) and knowledge of French and German.

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

As it was stated above, the training in the English language is considered as part of the annual training program for our staff and this provides an effective tool for helping them to have a better overview when searching and understanding the prior art in other languages.

Besides of the latter, some of our databases include machine translation and some others with translation made by persons (for example, Thomson Innovation) in order to be more accurate, especially when it comes to Asian documents, for which machine translation can sometimes be difficult to understand.

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## **2.2 – QUALITY MANAGEMENT**

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***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.***

**National quality management system:**

INAPI has a quality management system in compliance with the requirements of Chapter 21 of the PCT International Search and Preliminary Examination Guidelines. Its annual reports in accordance with those Guidelines since 2013 are available from the WIPO website at <http://www.wipo.int/pct/en/quality/authorities.html>.

Although the ISA/IPEA activities have not yet been certified under ISO 9001, as our Receiving Office procedure already is, we intend to include both in the scope for the recertification in 2018 (with the logical transition to ISO 9001:2015 version) and therefore every activity considered within the ISA/IPEA process has been designed accordingly, including the necessary records and the preventive and corrective actions, and the logical of continuous improvement lying behind the ISO 9001 standard. This system has been in operation since our very beginning as ISA/IPEA in October 2014, given that the process was initially designed under the ISO logic.

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## **3 – INTENDED SCOPE OF OPERATION**

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**Language(s) in which services would be offered:** Spanish

**State(s) or receiving Office(s) for which Authority would offer to be competent:** Countries within Latin-America and the Caribbean. Currently INAPI has been designated as possible ISA/IPEA for 11 countries, namely Chile, Peru, Ecuador, Colombia, Panama, Cuba, Dominican Republic, Guatemala, Costa Rica, El Salvador and Mexico.

**Limitations on scope of operation:** INAPI will not perform international search and preliminary examination in applications filed in languages other than Spanish.

As for the subject matter not excluded from search or examination, it refers to all subject matter searched or examined in Chilean national applications.

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#### **4 – STATEMENT OF MOTIVATION**

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Both the creation of INAPI and the work done since its installation have helped to move towards a new stage in the process of transforming the intellectual property system in Chile. In this context, INAPI has become a modern and efficient Office not only able to provide quality services but also to interact effectively with the international intellectual property system as a whole.

INAPI strongly believes in the importance of the international intellectual property system for the promotion of innovation and entrepreneurship. In this context, the Patent Cooperation Treaty (PCT) plays a key role, so since its entry into force in Chile, its implementation has been a strategic priority for INAPI.

The Government of Chile sees in the PCT a real and concrete possibility for member countries to interact and effectively contribute to the system, making it more attractive and accessible to all users. By re-appointing INAPI as an ISA/IPEA, the Government of Chile is of the opinion that it can help further develop the system in the region and encourage the filing of PCT applications in Latin America. This is particularly important if we consider new filings only grew by 4.8 per cent between 2005 and 2010, well below other regions such as Asia, where the number of PCT filings increased by 10.9 per cent during the same period.

In addition, it is INAPI's belief that its role as a native Spanish language speaking ISA/IPEA benefits the countries within the Latin-American region that have not yet adhered to the Treaty or may be in the process of considering becoming part of it. The active participation of INAPI in all instances of the PCT system permits it to share the experience and help those countries that are either implementing or want to be part of the system. Having a Spanish speaking ISA/IPEA within the region that can carry on international searches as well as preliminary examinations certainly benefits the system as a whole.

In this sense, and as a strategy to promote the use of the system as a whole, the Government of Chile considers that the existence of an ISA/IPEA in the Latin American region is nowadays very important to avoid possible delays in the processing of PCT international applications due to work overload in some offices. Furthermore, we believe that searching resources must be allocated in different parts of the world so that they are used more efficiently.

Considering Chile's interest to promote innovation and entrepreneurship and recognizing the importance that the international patent system has on these objectives, we consider it appropriate to re-appoint INAPI as an ISA/IPEA. INAPI meets the technical requirements to offer its search and examination services to both its nationals and other members of the PCT, particularly to applicants from Latin American members of the PCT, promoting and increasing the use of the PCT in the region.

Over the years in which INAPI has been acting as an International Authority, we have witnessed an important and remarkable increase of PCT filings, not only from Chilean applicants, but also from applicants within the region, such as Mexico, Colombia, Peru, Ecuador and El Salvador. That confirms our statement that an ISA/IPEA within the region would encourage the usage of PCT in Latin America countries. Particularly, INAPI received 136 PCT applications in 2015 and 163 in 2016. This number is expected to increase over the years and shows a significant

growth in the usage of PCT, especially considering that in 2014 the applications filed at INAPI as RO barely reached 90.

As for the ISA activities at INAPI, during our first year of operations we were designated for conducting the international search in 182 applications, where this number increased to 219 in 2016.

Not only that, but we have also identified many applicants who have filed more than one application selecting INAPI as their ISA, which demonstrates that there is great confidence and certainty in the quality of our work as well as in the acknowledgement of our efficiency when conducting international search activities.

Furthermore, the role of INAPI as an ISA/IPEA has brought more advantages to our users as it was recognized by the Chilean Government when it conferred INAPI the National Award for Excellence in Public Service, which positioned INAPI as one of the three best public institutions of the country. This recognition is given to the national institutions which facilitate major developments in the quality of life of their users, such as the raising of awareness of the IP system and the advantages of filing patents applications abroad in our case. In fact, since we started acting as an International Authority, the filing rate for international applications has grown immensely and an important number of applicants who were not aware of the IP system have asked for information about the usage of the Treaty, which led to the entry of new participants in the system.

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## 5 – APPLICANT STATE(S)

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### Regional location



*[Map showing State(s) and neighboring States]*

### Regional organization memberships:

- **Prosur:** It is an initiative gathering the Latin America Industrial Property Offices aiming at strengthening the use of the IP system within the Region and encouraging the work sharing among these Offices. The countries taking part in this initiative are Argentina, Brazil, Chile, Colombia, Costa Rica, Ecuador, Paraguay, Peru and Uruguay.
- **Alianza del Pacífico:** This is a governmental initiative aiming at facilitating trade and enhance the development and growth between their State Members (Chile, Colombia, Mexico and Peru).

As member of Prosur and Alianza del Pacífico, INAPI signed Patent Prosecution Highway agreements (PPHs) in 2016, in order to make available the quality standards of INAPI as an ISA/IPEA, as well as giving even more utility to our work as an International Authority, for the benefit of the Region.

**Population:** 17.95 million (*information World Bank*)

**GDP per capita:** 22,370 United States dollars (year 2015) (PPP) (*Information World Bank*)

**Estimated national R&D expenditure (% of GDP):** 0.39 (year 2015) (*Information World Bank*)

**Number of research universities:** There are 25 universities in Chile that are part of the Council of Rectors and are public. In addition, there are also 31 private universities. All the universities in the country must carry out research, as it is one of the requirements that must be met in order to be recognized as an educational institution by the Government.

**Summary of national patent information network (for example patent libraries, technology and innovation support centers):** The generation of relevant documentation for applicants and users of the patent system is a key issue for INAPI. Our institution now takes part in the initiative "WIPO depository libraries". The information can be found in the following link: [http://www.wipo.int/library/en/depository\\_libraries.jsp](http://www.wipo.int/library/en/depository_libraries.jsp). At the moment our officials can have access to the documentation that WIPO has provided and we are working on enabling an adequate space so that any user can have access to this important information.

In addition to that, and as a complement to the WIPO library project, we are finalizing the adjustments of our application for being part of the WIPO Technology and Innovation Support Center (TISC) program.

**Major local industries:** Mining, fishing, timber/cellulose, wine, agriculture.

**Major trading partner States:** China, USA, Japan, South Korea, Brazil, Peru, Spain, Mexico, Colombia, Argentina.

**Other key information:**

In 2016 the Chilean Government launched the National Strategy of Industrial Property, which was prepared and drafted by INAPI. This strategy includes topics such as PCT usage and the participation of Chileans in the patent system abroad.

This strategy can be accessed (in Spanish) through the following link:  
[http://www.inapi.cl/portal/publicaciones/608/articles-9870\\_recurso\\_1.pdf](http://www.inapi.cl/portal/publicaciones/608/articles-9870_recurso_1.pdf)



## 6 – PROFILE OF PATENT APPLICATIONS

### Number of national applications received – by technical field

<b>Technical Field</b> \ <b>Year</b> <sup>1</sup>	2013	2014	2015	2016
Mechanical	1,118	1,291	1,221	1,050
Electrical/electronic	313	420	391	372
Pharmaceuticals	660	355	562	476
Industrial Chemistry	809	516	644	544
Biotech	259	645	559	577
<i>Total</i> <sup>2</sup>	3,159	3,227	3,377	3,019

### Number of national applications received – by route

<b>Route</b> \ <b>Year</b>	2013	2014	2015	2016
National first filing/internal priority	418	534	510	460
Paris priority	241	223	159	148
PCT national phase entry	2,500	2,470	2,708	2,411
<i>Total</i>	3,159	3,227	3,377	3,019

### Number of international applications received as RO

<b>Technical Field</b> \ <b>Year</b>	2012	2013	2014	2015	2016
Mechanical	36	63	45	57	81
Electrical/electronic	13	4	11	26	23
Pharmaceuticals	3	3	4	8	7
Chemistry	11	20	21	25	22
Biotech	16	12	9	20	30
<i>Total</i>	79	102	90	136	163

<sup>1</sup> For some tables the year 2012 has not been considered since it was only in 2013 when the IPAS System was fully operational and available to extract data. Therefore, it was decided to use a more accurate source of information contained in a unique DB instead of collect data from several different systems which were operative before the implementation of this IT system at INAPI.

<sup>2</sup> The total number of applications does not include the applications filed for Industrial Designs and Industrial Drawings, as well as Schemes, although these applications are in fact considered as a part of the patents division and examined there in consequence.

### Average time taken for national patent processing

Indicator	Measured from	Time (months)
To search and first examination <sup>3</sup>	Filing of the application	24
To grant <sup>4</sup>	Filing of the application	48

### National pending applications

Measure	Number of applications
All pending applications	13,565
Applications awaiting search and first examination (where relevant fees paid)	1,171

It is important to point out that the total number of pending applications has been continuously decreasing over the past years, even though INAPI started acting as an International Authority. This shows the remarkable improvement of the efficiency and quality of our processes. Nowadays the number of applications being solved (grant or refused) is higher than the applications filed, thereby reducing our pending applications.

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## 7 – SUPPORT REQUIRED

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INAPI is a self-sufficient Office, which, although it does not require any special support to maintain its current functioning as an ISA/IPEA with high quality and in an efficient manner, it is motivated to continuously improve the skills of its staff in their work as International Authority.

In this regards, during its first years of implementation and starting operations, INAPI sought and received assistance from other Offices which were already working as an Authority for a considerable period of time. This has been a significant benefit to the Office as an Authority and, while not specifically requiring assistance, the Office is conscious that working together with other Offices can be mutually beneficial to the quality of search and examination carried out within the scope of the PCT.

WIPO assisted in coordinating activities with the United States Patents and Trademarks Office (USPTO), the Canadian Intellectual Property Office (CIPO) in 2013 and IP Australia in 2014.

Along with these activities INAPI organized training activities together with the Israeli Patent Office (ILPO), CIPO and IP Australia in 2013, where the activities were coordinated by both Offices taking part of the initiative, in a collaborative work and joint effort to design activities which had never been done before. There was also an activity with offered by the Japanese Patent Office (JPO) in Chile in 2015, where this Office has also been constantly providing INAPI with new training activities in Japan of which at least 6 examiners have taken part with great success. Furthermore, CIPO also has offered INAPI to take part in workshops for exchanging best practices among Offices.

In 2014 the European Patent Office (EPO) offered a training course on EpoqueNet to examiners.

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<sup>3</sup> Currently INAPI does not conduct search and examination as two different activities but they are conducted simultaneously and their results are submitted to the applicant in one report collecting all the information on the search results and the opinion on the legal requirements. This average time is being measured from 2009 as it was the year when INAPI started its functioning and a new search and examination procedure was developed in order to make it more efficient.

<sup>4</sup> This information refers to the PCT applications filed at INAPI (National Phase).

In November 2016, WIPO organized a joint activity between INAPI and the Austrian Patent Office (APO) aiming at exchanging best practices between the Offices in order to follow the principles of continuous improvement and adoption of quality standards as ISA/IPEA.

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**8 – OTHER**

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N/A.

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**9 – ASSESSMENT BY OTHER AUTHORITIES**

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