

Standing Committee on the Law of Patents

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REPORT ON WIPO'S TECHNICAL ASSISTANCE ACTIVITIES IN RESPECT OF ENHANCING PATENT EXAMINERS CAPACITY

prepared by the Secretariat

INTRODUCTION

1. At its twenty-seventh session held in Geneva from December 11 to 15, 2018, the Standing Committee on the Law of Patents (SCP) agreed that the Secretariat would report, at its twenty-eighth session, on technical assistance activities carried out by WIPO in respect of enhancing patent examiners capacity. This document sets out the report requested.

WIPO'S TECHNICAL ASSISTANCE ACTIVITIES IN RESPECT OF ENHANCING PATENT EXAMINERS CAPACITY

2. Like any other technical assistance activities provided by WIPO, patent examiners capacity building activities are carried out upon request by a WIPO Member State in full cooperation with that State. Some of those trainings address general patent search and examination competencies, while others focus on a special skill set (for example, the international patent classification or the use of WIPO CASE¹) or patent examination in a specific technical field (for example, in the field of computer and telecommunication and

¹ The WIPO CASE (Centralized Access to Search and Examination) system enables patent offices to securely share search and examination documentation related to patent applications in order to facilitate work sharing programs. See <http://www.wipo.int/case/en/>.

pharmaceuticals). Such trainings are held at the regional, sub-regional or national level. The duration of most of the on-site training courses is five days, although some of them may last eight to ten days. Their format is typically a mixture of lectures, practical exercises and case studies. Some of the training courses are funded by Fund-in-Trust arrangements or held with financial assistance or other contributions by partner patent offices.

3. The following paragraphs describe the summary of the WIPO's technical assistance activities with a view to enhance patent examiners capacity in carrying out their work.

Patent Search and Examination Training Activities

4. In order to support processing of PCT international applications in the national phase, WIPO organizes training activities at national and regional Offices, such as workshops, addressing particular needs of those Offices with regard to substantive examination of international applications which have entered the national phase before those Offices, as well as addressing the use of WIPO's International Cooperation on Examination (ICE) service in respect of national applications. Those activities explore strategies for managing the caseload of Offices whose examiners have limited technical expertise and limited access to professional search tools, with a view towards reducing existing, and avoiding future, backlogs of patent applications. 21 national and four regional/sub-regional activities have been held between 2014 and July 2018.

5. The program of this type of training activities typically contains a review of patent family members and their examination status as well as retrieval and analysis of related search and examination work products by other Offices (such as citations, written opinions, claims granted or rejected) by using various resources and databases. It also addresses issues such as clarity and conciseness of claims in patent applications, noting that WIPO's ICE service is available only for well drafted claims.

6. In addition, within the Professional Development Program carried out by the WIPO Academy, a number of on-site patent search and examination trainings have been held. Those training courses are conducted in order to enhance technical skills and knowledge of patent examiners from developing countries. Some of them cover broad aspects relating to prior art search and substantive examination, for example, role and responsibilities of patent examiners, procedural aspects, prior art search and preparation of search reports, substantive patentability assessment, preparation of examination reports and the PCT. Other training courses focus on a specific issue, such as search and examination in the field of pharmaceuticals, biotechnology or computer and telecommunication, the use of online tools to search patent information and non-patent literature, or patentability criteria (in particular, novelty, inventive step, industrial applicability and unity of invention). Between 2014 and 2017, 21 such training courses were held.

7. Beyond the targeted search and examination trainings, although many PCT technical assistance activities undertaken by the International Bureau do not have a direct bearing on prior art search and substantive patent examination, such training contribute to strengthening the general capacity of patent examiners in conducting their work. Comprehensive information on technical assistance activities relating to the PCT is regularly reported to the PCT Working Group.² In addition, following discussions and agreement among Member States in the PCT Working Group, the International Bureau is carrying out a pilot project aimed at developing a framework of technical competencies for substantive patent examiners as well as a learning

² The latest report is found in document PCT/WG/11/22, which is submitted to the eleventh session of the PCT Working Group, to be held in Geneva from June 18 to 22, 2018.

management system.³ Moreover, the International Bureau compiles, on an annual basis, information regarding training activities carried out by national/regional offices on substantive patent examination for examiners from other offices and reports that information to the PCT Working Group.⁴

WIPO CASE

8. WIPO organizes workshops in order to increase capacity and technical skills of patent examiners and administrative staff on the utilization of the WIPO CASE system. In 2017 alone, three such national workshops were held. Such workshops contribute to increased knowledge of patent examiners on how to access foreign dossier information and utilize the outcome of the patent examination work and better understanding of the latest CASE features and future development plan. For WIPO, it is an opportunity to obtain inputs from IP Offices of its Member States on future priorities.

9. Furthermore, an ASEAN Plus CASE Utilization Workshop was held in March 2017 in order to facilitate regional patent work-sharing initiatives in the Association of Southeast Asian Nations (ASEAN) through exploitation of the CASE System. During the Workshop, possible ways to increase efficiency and quality of patents from the perspectives of patent granting, business workflows and office actions were presented, and discussions on the ways and means of leveraging the technical platform and electronic means for the improvement of quality and performance of IP Offices were held. In addition, the participants exchanged information on quality of patents and patent examination practices in different IP Offices in order to assist ASEAN to identify ways in which IP Offices can improve the efficiency and quality of patent prosecution.

Distance Learning Programs

10. Many patent-related distance learning courses provided by the WIPO Academy not only support the core competencies of patent examiners, but also contribute to acquisition of supplementary but important sets of knowledge that expand the capacity of the examiners.⁵ Among those distance learning courses, DL-318 “Patent Information Search” should be highlighted.

11. The themes covered by DL-318 include the value of patent information, different types of patent search and strategic use of patent information, patent search techniques for efficient and effective searching and specialized searches. The participants also conduct patent search exercises and draft a patent search report. Between 2014 and 2017, 1821 participants attended this three-month online course. Currently, DL-318 is provided in English, French and Spanish. The WIPO Academy plans to translate DL-318 into Arabic, Chinese, Portuguese (already underway) and Russian.

³ The status of the pilot project is found in document PCT/WG/11/17.

⁴ The latest information is found in document PCT/WG/11/16.

⁵ Information concerning distance learning courses is available at:
http://www.wipo.int/academy/en/courses/distance_learning/.

International Patent Classification (IPC)

12. WIPO also provides IPC training, which normally takes place for three days. The training program contains the following themes: (i) introduction to the IPC; (ii) basic structure and elements of the IPC; (iii) Internet resources related to the IPC; (iv) classification practice; (v) how to search patent documents by using the IPC; and (vi) revision procedure of the IPC. Five national and one regional training workshops were held between 2014 to 2017.

13. In addition, trainings on the use of the IPC Revision Management System (IPCRMS system) were held, in particular, in 2016 and 2017, through video conferences. The IPCRMS system, developed by WIPO, facilitates IP Offices in preparing IPC revision proposals, comments, publishing new versions of the IPC, as well as helping national Offices to prepare and publish national language versions of the IPC.

Resources Relating to Traditional Knowledge and Genetic Resources

14. WIPO provides resources relating to traditional knowledge and genetic resources, which may be useful for patent examiners. For example, the WIPO Secretariat has collected, and keeps updating, information about databases and registries of traditional knowledge and genetic resources maintained and managed by WIPO Member States and other organizations, as well as about other repositories of traditional knowledge and genetic resources.⁶

15. Furthermore, the draft guidelines on examination of patent applications that cover inventions based on traditional knowledge, or developed by using traditional knowledge, are being prepared and are expected to be made available by the end of 2018, as an informal resource for patent Offices and other interested parties. These draft guidelines will be drawn from document WIPO/GRTKF/IC/13/7,⁷ which contains draft recommendations intended to promote greater and more effective attention to traditional knowledge during patent search and examination within the bounds of the existing legal framework.

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⁶ Information about Databases and Registries of Traditional Knowledge and Genetic Resources, available at: http://www.wipo.int/tk/en/resources/db_registry.html.

⁷ Document WIPO/GRTKF/IC/13/7 "Recognition of Traditional Knowledge with the Patent System", available at: http://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_13/wipo_grtkf_ic_13_7.pdf.