

TECHNICAL AND PRACTICAL ASPECTS RELATED TO PATENT QUALITY IN THE CONTEXT OF STANDARD ESSENTIAL PATENTS

Exploratory study for WIPO

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Study Objectives and Methodology

- Exploratory character:
 - recast the discussion around technical standards in the larger context of patent quality,
 - highlight the significance of the use of standards documents for the purposes of prior art,
 - illustrate best practices in the field and,
 - provide policy recommendations
- Content generated through analysis of extensive bibliography, publicly accessible secondary literature, surveys and interviews with subject-matter experts and PTO/SDO representatives (disclaimer)

Interface of Patent Quality and Standards

- No systematic research on the link between patent quality and technical standards
- Why is a sector-specific discussion on patent quality relevant?
- Why does prior art search in the field of standard-essential patents need particular attention in the context of search and examination?

EPO-SDO Collaboration

- MoU with ETSI, IEEE-SA and ITU; further cooperation with other SDOs envisioned
- Collaboration is based on establishing a mutual advantage for both partners
- Standard-specific internal database is interlinked with the ETSI database; frequent, automated updates allow access to *comprehensive, conclusive and timely* information
- Examiner training

Collaboration Benefits for SDOs

- Upgraded and enhanced functionality of the ETSI IPR database as best practice example
- Towards a centralized repository of IEEE-SA documents

JPO-SDO Collaboration

- JPO-ISO cooperation agreement and access to ITU, IEEE-SA and 3GPP documentation
- Internal database but not interlinked to the SDO
- Selected standards documents are stored in regular update cycles and through rigorous selection process
- Advanced retrieval and screening capabilities allow examiners to search and identify prior art in an efficient manner
- Examiner training

What about the other patent authorities?

- Lack of awareness or existing misconceptions?
- Infrastructure constraints and lack of technical capabilities?
- Financial constraints?
- Organizational inertia?
- Strategic and political concerns?

Is the notion of “public prior art” a stumbling block?

- Legal status of technical information related to standards – “public availability” and confidentiality regimes
- EPO approach to confidentiality and ETSI dissemination policy
- Copyright aspects

Is the fragmentation of NPL a stumbling block?

- Non-Patent-Literature related to standards (i.e., standards drafts) is largely inaccessible and non-searchable in an efficient and conclusive manner
- Not all that information is relevant for the purposes of prior art
- There are significant differences across the various SDOs in terms of standards definition, format and publication quality
- Best practices for retrieving and harmonizing standards drafts: NPL repositories, document acquisition, technical capabilities, classification/SEP mapping etc.

Recommendations and Policy Outlook (1)

- Intensified use of standards documents in prior art search:

Need for systematic accessibility and searchability of standards drafts and related data by patent examiner in a reliable and timely manner

- Collaboration between patent authorities and SDOs is isolated, but can be replicated - Not one size fits all:

Mutual benefits, balance of powers between patent and standardization systems, clear definition of public prior art and dissemination policies between PTO-SDO, common documentation format etc.

Recommendations and Policy Outlook (2)

- WIPO as a global contact point between patent authorities and SDOs:

WIPO could take on a multi-faceted role as advocate and facilitator, leveraging its political outreach and infrastructure

- Future research:

No systematic knowledge of cross-country search and examination processes worldwide, information asymmetries etc.

THANK YOU FOR YOUR ATTENTION

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Other relevant publications by the same author:

- *Licensing Terms of Standard Essential Patents – A Comprehensive Analysis of Cases*, JRC Report, European Commission, 2017
- *Innovation in the European Digital Single Market*, JRC Report, European Commission, 2015