

Standing Committee on the Law of Patents

Eighteenth Session
Geneva, May 21 to 25, 2012

QUESTIONNAIRE ON QUALITY OF PATENTS: PROPOSAL BY THE DELEGATIONS OF CANADA AND THE UNITED KINGDOM

Document prepared by the Secretariat

1. The Annex to this document contains a proposal submitted by the Delegations of Canada and the United Kingdom in respect of a questionnaire on quality of patents, for consideration under item 7 of the draft agenda: Quality of Patents, including Opposition Systems.

2. *The members of the Standing Committee on the Law of Patents (SCP) are invited to consider the contents of the Annex.*

[Annex follows]

I. INTRODUCTION

1. At the 16th Session of the Standing Committee on the Law of Patents (SCP) the Delegations of Canada and the United Kingdom put forward a joint proposal for a work program on the Quality of Patents (SCP/16/5). Some Member States submitted proposals for work streams which might fall under this work program. Some Member States did not feel ready to commit to the work program and called for a definition of “Quality of Patents” and clarification of the scope of work proposed.
2. For the 17th Session of the SCP a revised proposal (SCP/17/8) was submitted. The revised proposal attempted to provide a broad definition which would encompass all the definitions of “Quality of Patents” Member States might use, and addressed other concerns raised at the 16th Session of the SCP. However, during the course of the 17th SCP it became clear that the attempt to clarify a definition for “Quality of Patents” and the scope for future work had not been successful.

II. DEFINITION

3. The Delegations of Canada and the United Kingdom continue to believe that every member state has an interest in the quality of patents within its jurisdiction; however, it is clear that Member States have different definitions of what constitutes quality of patents. Rather than attempting to draft a common definition of quality of patents to which all Member States could agree, we believe it would be more beneficial to explore the various definitions Member States use within their national offices.

III. SCOPE OF WORK

4. In proposing an agenda item on Quality of Patents it was never the aim of the Delegations of Canada or the United Kingdom to prescribe the work the committee should undertake, rather the aim was to set out a framework under which work streams suggested by Member States might fall. A number of the suggestions for work streams falling under the framework were submitted to the electronic forum, and raised orally during plenary sessions. It is our observation that nearly all of the suggestions for work streams had as their starting point an initial question or questions. We believe that by exploring the answers to these questions the scope of work might be made clearer.

IV. QUESTIONNAIRE

5. To elicit the definitions and criteria Member States use to define quality of patents, and to help clarify the scope of for future work, it is proposed that Member States complete the attached questionnaire. The questionnaire is divided into three components corresponding to those of the proposals SCP/16/5 and SCP/17/8, namely:
 - a. Information access and exchange on quality of patents
 - b. Technical infrastructure development
 - c. Process improvement

The questions in the questionnaire are informed by those put forward in proposals, comments, and suggestions already submitted to the electronic forum, and raised during plenary sessions of the Committee.

6. We encourage Member States to complete this questionnaire.

Questionnaire on Quality of Patents

The answers to this questionnaire have been provided on behalf of:

Country: **Republic of Moldova**

Office: **State Agency on Intellectual Property of the Republic of Moldova (AGEPI)**

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Section I: Information access and exchange on quality of patents:

1. What definition/s of 'quality of patents' is used within your national jurisdiction?

The State Agency on Intellectual Property of the Republic of Moldova (AGEPI) states that quality could be defined as the fulfillment of patentability requirements, according to each national law, by Patent Offices, in a transparent way.

2. Do you use criteria in your national jurisdiction to define quality of patents from an application perspective? yes / no

If so, what criteria?

a) Quality of the invention: Do you use criteria to ensure the invention is sufficiently inventive? yes / no

If so, what criteria are used (e.g. inventive step, or innovative step)?

According to Article 10.1 of the Law No. 50-XVI/2008 on the Protection of Inventions an invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. Assessment of inventive step may be made by the problem-solution type approach providing for the following stages:

- a) selecting the proximate analogue of the prior art;
- b) determining the objective technical problem to be solved;
- c) assessing the extent to which the claimed invention, starting from the proximate analogue and the objective technical problem, would have been obvious to the skilled person at the date of filing or at the date of recognized priority.

b) Quality of drafting the patent application: Do you use criteria to ensure that the invention is clearly described in the application? yes / no

If so, what criteria are used?

According to Article 36.1 of the Law No. 50-XVI/2008 on the Protection of Inventions the patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Similarly and in accordance with Article 37.1 the claims shall define the

matter for which protection is sought, and with Article 37.2 the claims shall be clear and concise and shall be supported by the description of the invention.

3. Do you use in your national jurisdiction to define quality of patents from your IP office's perspective? yes / no

If so, what criteria?

- a) Quality of search for the state of the art: Do you use criteria to ensure that an examiner has identified the closest prior art? yes / no

If so, what criteria are used?

In order to apply the problem-solution method (for evaluating inventive step), it is necessary to determine which document represents the closest prior art. It shall be considered that said document shall be that which, since it belongs to the same field of technology, discloses the technical effects, objectives or particular use closest to the claimed invention or that which, since it shares the greatest number of technical characteristics with the invention, is capable of ensuring the claimed function of the invention.

- b) Quality of analysis of search results: Do you use criteria to ensure that prior art is correctly evaluated in relation to the application? yes / no

If so, what criteria are used?

In order to analyze whether the prior art has been evaluated correctly in relation to the application, it is verified whether, in order to examine the novelty of an invention, the documents in the prior art cannot be taken into consideration but individually for that invention (i.e. the elements of prior art can be taken into consideration only individually and cannot be combined). In a unitary group of inventions, the documents in the prior art shall be taken into consideration individually for each invention.

To analyze whether the prior art has been evaluated correctly from the point of view of evaluating inventive step, it is necessary for the closest prior art document to have been chosen and the problem-solution method to have been applied, at least in relation to the independent claim or claims. It is also crucial for the prior art documents, which may be combined and are used to evaluate inventive step, to belong to the same prior art as the claimed invention.

- c) Quality of the application of legal provisions: Do you use criteria to ensure that the applicable legal provisions observed and applied appropriately? yes / no

If so, what criteria are used?

In order to guarantee that the examiner applies correctly the legal provisions, i.e. the Law no. 50-XVI/2008 on the Protection of Inventions and the Implementing Regulations, it is made the permanent control of patent applications for compliance with the legal rules under the Regulations on the application of the Law. In the drafting of written opinions, the examiner must indicate the legal provision or article that has been used in each case.

- d) Quality of cooperation of the applicant and the examiner: Do you use criteria to assess the level of contact between examiner and applicant? yes / no

If so, what criteria are used?

The applicant shall furnish notices indicating the contact details of the examiner and the patent application, indicating the applicant's contact information, the examiner

during the examination can be contacted by phone to determine all questions. Examiner at any time is available for meetings with the applicant. The applicant may contact the examiner at any time and the examiner shall try to assist the applicant in order to respond to any doubt that may arise and help him to ensure the best possible quality of the patents.

- e) Quality of legal provisions: Do you use criteria to ensure that the legal provisions understandable and available to all parties concerned? yes / no

If so, what criteria are used?

Examiners always participate in certain conferences in universities, scientific institutions with reports about national legislation.

4. Do you use any other criteria in your national jurisdiction to define quality of patents? yes / no

If so, what criteria are used?

Permanent control of decisions to grant patents or refuse a patent application by the chief of the specialized division and Deputy Director or Director of the Inventions Department.

5. What specific national targets, if any, are used to define and ensure quality of national patents?

The application of patent criteria, such as novelty and inventive step, is an important element to consider when evaluating the quality of patents. In fact, it is important not to lose sight of the interdependence between “managing procedural quality” and implementing legal patentability requirements in order to produce a high quality final product.

6. What specific IP office targets, if any, are used to define and ensure quality of national patents?

Section II: Technical infrastructure development:

7. Please describe the nature of the scientific/technical training IP office examiners receive in order to ensure the quality of patents granted?

AGEPI patent examiners are higher level university graduates in technical fields relating to their area of examination. Examiners participate in seminars organized by AGEPI and EPO in the field of patent or non-patent databases used for search in determining the state of the art.

8. Please describe the nature of the legal system training IP office examiners receive in order to ensure the quality of patents granted?

For employment as an examiner at AGEPI there are organized training courses for office examiners, the course in patents is of 45 hours, upon its completion the graduates of the course take an examination. The course is given by experienced examiners with a large length of service in the field of patents. Once they are accepted, they receive relevant additional training and are periodically given refresher and update courses.

9. Please describe the nature of work done with users of the patent system to ensure that patents submitted to your national IP office are of a high quality?

On the Patent Office web page user information handbooks are published, and lectures are given at universities, technology firms and chambers of commerce, for the purposes of training potential applicants on how to file high-quality applications.

10. What search tools and options (hardware and software) are available to an examiner to ensure the quality of patents granted?

Patent examiners have access to the advanced databases in the patent search field, for example Espacenet, Patentscope and other special databases. Access is available to the minimum documentation established in the PCT Regulations, including the different periodical publications. Examiners also have access to national databases for conducting the patent search.

Section III: Process improvement:

11. Within the national IP office, what specific metrics are used in evaluating the quality of national patents granted?

Permanent control of the quality of search, the quality of drawing up the search report, examining the criteria of novelty and inventive step, the quality of drawing up the examination report. Also, control of observing the time of examination or implementing legal patentability requirements in order to produce a high quality final product.

12. Within the national IP office, what specific metrics are used in evaluating the quality of the work of patent examiners?

As indexes for assessing the quality of work done by examiners are the number of patent applications for re-examination or for conducting an additional search in the specialized division.

13. Please describe what quality control mechanisms are employed within your national IP office to ensure the quality of patents granted and the quality of the work of patent examiners?

Permanent control of the quality of decisions to grant patents or refuse a patent application by the chief of the specialized division and Deputy Director or Director of the Inventions Department. Permanent control of the patents granted and issued by the chiefs of the specialized divisions and the heads of the Inventions Department.

14. Please describe the quality management systems your IP office has in place to ensure quality of patents?

Currently is under development.

15. How does your national office use foreign search and examination work to ensure quality of patents?

The Office always takes into account the work done by other Patent Offices, both in relation to search and examination, in order to complement its own work, above all as regards documentation drafted in languages unknown to the majority of examiners. For AGEPI examiners are very useful the international search reports for the PCT applications, because the office has no access to multiple patent and non-patent databases.

16. What challenges does your national IP office face in the use of foreign search and examination work to ensure quality of patents?

In some cases the criteria or equations used for searching patent applications are not clear and also Office's limited access to non-patent literature to be retrieved and used to analyze the criteria of patentability.

17. How could potential obstacles for using foreign search and examination work be overcome?

The main obstacles lie in the access to search and examination information produced by other offices and also where such documentation is drafted in an unknown language. That could be overcome using databases that allowed access to such information and more powerful translation systems than those currently available.

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