



Patent Quality

It is a basic requirement of a good patent system that granted patents should be of high quality: i.e., the patents can be presumed valid with a high degree of certainty. Those states and regional groups that provide for search and examination before grant should carry out these procedures to a high standard; while those states that do not examine before grant should be able to rely on the international system (PCT) and/or the work of examining offices to achieve quality.

It is vital that the search and examination procedures operated by examining patent offices and authorities, and their interactions with applicants, are professional, thorough, efficient and timely. In recent years, the Federation has been concerned about lapses in the achievement of consistently adequate quality and has made a number of submissions to European and international authorities concerning the need for improvements in practice and procedure.

European Patent Office (EPO)

It has always been the expectation of users and the aim of the Office that the EPO will deliver high quality patents. The EPO has established a reputation for high quality examination work – some of the best in the world. In recent years, against a background of ever increasing workload, several initiatives have been pursued vigorously by the Office, under headings such as mastering the workload, European quality management system, patent quality standards, “[raising the bar](#)” and compact prosecution, with the objective of maintaining and indeed improving the efficiency of procedures and the quality of the granted patents. Many of the procedural changes resulting from these initiatives have however tended more to restrict the freedom of manoeuvre of applicants, e.g., by limiting the opportunities for dialogue with the examiner and/or for amending or dividing applications in the light of developments and prior art, rather than to ensure that applications will be thoroughly searched and examined in a consistent manner by expert staff who are fluent in the language of the application.

The Federation has collected information about, and submitted schedules of, applications which appear to demonstrate systematic failures in search and examination, either in particular technical areas or more generally. These submissions have been politely received and discussed with Federation members. However, it is not clear that lessons from them have been promulgated to the examining staff as a whole. There is a tendency to treat such material only as evidence of “one-off” failure.

In response to a workload study by the EPO (2008) and proposals on procedural efficiency (2009/10), the Federation has submitted papers commenting on the EPO

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systems (papers PP05/08, PP03/10). While recognising the generally high quality of EPO work, the papers contain suggestions for improvement. A crucial point is that examination work should be predicated on a high quality search. For this, careful analysis of the patent claims by examiners skilled in the relevant art is necessary and we have suggested that a three person division should be responsible for this analysis and the formulation of an appropriate search strategy in response to it. We also consider that the analysis and search strategy should be published with the search report so that applicants and third parties can evaluate it. We consider that quality control should be enhanced and made more transparent by involving the outside experience of users and possibly others with quality control expertise. The work of boards of appeal should not be immune from quality monitoring. More dialogue with users is needed to enhance understanding of the business and technical purposes of the patents being applied for. In some areas, more attention to training, mentoring and supervision is needed, with closer involvement of senior staff in the complex work of the examiners. It should be ensured that examiner expertise is built up and retained in difficult technological fields. We have been unhappy that in some fields, examiners seem not to properly understand the technology. This may be due to language problems and the cadre of mother tongue English speakers needs to be improved, particularly bearing in mind that more than 75% of EPO work is in English. We consider that the attitudes of many EPO examiners to amendment during pre grant procedures and to the ways in which claims are formulated are over-restrictive, such that there is a negative effect on the quality of the end product.

We have also commented in detail on the numerous EPO proposals for rule changes that impose substantial restrictions on the drafting of applications, timing of amendments, submission of divisional applications and conduct of oral hearings.

As might be expected, the EPO reaction to our suggestions has been guarded but we trust that in the longer term our points will not be ignored.

Patent Cooperation Treaty (PCT)

At the international level, we consider that the potential of the Patent Cooperation Treaty has yet to be fully realised. Making use of the PCT, it should be possible to achieve, in the international phase, an extensive, high quality search and a convincing examination report that makes a reliable assessment of the adequacy and validity of the patent application, such that any national authority will have little work to do in granting a quality patent when the application enters the relevant national phase. In January 2009 we made suggestions in an informal discussion paper (PP02/09) to WIPO for desirable improvements to the PCT. We highlighted the need to improve the international search, in particular by improving performance in international search authorities and, especially, by collaborative effort between international search authorities, such that each could search to its particular strengths in language and subject matter. We again suggested that claim analysis and search strategy should be made transparent by publication of the strategy. We also considered that examination in the international phase should be substantially improved, in particular by allowing time for dialogue between the examiner and applicants and third parties. We drew attention to the need for quality monitoring and control.

The International Bureau of WIPO is of course concerned that the PCT is not being used as fully as it should be and the Director General circulated a paper during the first part of 2009 outlining a roadmap for improvement, emphasising the need for member states to adopt similar standards for patent grant and to cooperate more

closely. Many of his proposals were consistent with ours. The Director General's paper received a favourable reaction and discussions in international circles are ongoing. Pressures are being applied on member states to remove the various restrictions and opt-outs permitted by the Treaty and on international search authorities to accept applications for supplementary search. This would be a significant step towards the collaboration on search that would do a great deal to improve quality.

National level

In the UK, the IPO follows and participates in the European and international discussions and initiatives. It has consulted on the positions to take and is aware of our positions in relation to the EPO and WIPO. In relation to the improvement of the PCT, the IPO issued a detailed questionnaire to users, and we made the points outlined above in our reply (PP16/09).

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