



Documentation and quality – Quo vadis patent system? A patent attorney's view

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ABSTRACT

Various aspects and developments of the world – especially the European – patent system relating to documentation at large, and ultimately to the quality of patents are described and commented upon: international cooperation, the Community Patent, machine translation, office backlogs, the Patent Network, quality standards and inventive merit are amongst the areas explored.

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1. Introduction

This article is derived from the final speech delivered at the seminar “East meets West 2009” organized by the European Patent Office, Vienna branch. It gives a personal view on the recent and coming developments in the patent world, looking at patent documentation from Asia in a wider context. It stresses on the importance of quality for a patent system that delivers its promise: legal safety and the benefit of real progress for all parties involved.

2. Patent 5 and Prosecution Highway

Internationalization of the patent world is not only driven by globalization, but also by the fact that it absorbs considerable resources in brain power and money. Therefore, efforts are made to unify the patent system in various ways. The European, Japanese and US patent offices formed a body called “Trilateral” many years ago, later joined by China and Korea to form a “Patent 5” [1].

The “Patent 5” aims at unifying material patent law and procedures. The USPTO suggested a Patent Prosecution Highway [2], as a project for sharing work between the offices, for the time being of Europe, Japan and US. A pilot project is in progress. Regarding the backlog of the offices, this seems to make sense. But the difficulties are enormous and some believe it to be utopia or hell (e.g. problems such as mutual recognition, as in the late Soviet Union and satellites) or have doubts that the benefit will be shared fairly

among the participating offices. Many realists hold the opinion that the PCT should be carried further instead. PCT has the potential to assist national/regional office's substantive examination by virtue of the International Preliminary Examination and its gradual introduction into the search report stage.

3. PCT and Asian languages

The PCT system is developing at a slow but steady pace, in spite of its complexity. The specification of a minimum content of the search documentation was and still is a cornerstone of a novelty search that is in line with the universal novelty criterion. Coverage of Japanese patent publications is long standing; further country's publications – in particular Chinese and Korean (and more countries to come) – need to be included. Asian documentation to be intelligible for Europeans and European (other than English) documentation to be intelligible for Asian professionals need machine translation to be affordable and to cope with the ever increasing number and complexity of publications.

4. PCT and ISAs

It is foreseeable that the number of national patent offices being installed as international search authorities for PCT applications will also increase. For these, language skills are of increasing importance. At present, it can be observed that national offices, even as ISAs, tend to cite mainly documents in their own language and sometimes US documents. For example: a search report citing

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only documents in English in the automobile field raises the suspicion that the search has not been complete. This is because at least half of the German applications in this field are not published in any other language.

5. IPC

WIPO, the mother organization of PCT is also updating the International Patent Classification regularly. In March 2009 WIPO decided to abolish the distinction between core and advanced level [3]. It is also envisaged to unify at least three fully developed classification systems (US classification, IntCL/ECLA, and Japanese FI/F-Terms). This seems a herculean task (and reclassifying existing documents back to 1900!). Some search experts would prefer to keep the existing classification systems, achieving a better coverage by using them selectively.

6. Community Patent

The core of internationalization at the European level is the project of a Community Patent. The negotiations have been going on for over 40 years; the European Patent Convention was only a first step on the way. Negotiations have gathered pace in the last decade, the main practical stumbling blocks being still jurisdiction and translations. For jurisdiction, two solutions are at hand, the European Community Patent Courts Agreement (ECPCA) and a Patent Litigation Agreement between signatories of the Munich Convention, the first leading at present (July 2009).

7. Machine translation

As to the translations required for the Community Patent, the London protocol [4] was a first step, a further reduction of translation requirements alas lacks consent. Then, machine translation seems the only way to give all languages their due at acceptable cost, at least at the level of unexamined publications. At present, machine translations are difficult to read and sometimes barely intelligible. Very often words are translated out of context. A likely breakthrough solution was suggested during the recent Slovenian presidency of the European Union: machine translation of the unexamined application (e.g. the EP-A publication) linked to a dictionary based on the classification of the application [5]. For non-patent literature a unit of classification can be entered when machine translation is required. This approach is a likely remedy for the shortcomings of machine translations as at present. Such a system will be very costly to develop and take years, but could be up and running by the time the first Community Patent Applications are published. May be wishful thinking? Some difficulties remain even for such an enhanced translation: long nested clauses, relative pronouns and (in German) the verb at the end.

8. Patent office backlogs

The ever increasing number of applications entails backlogs in many offices (EPO as well as national patent offices). The first reaction of an office to master the workload is to impose a strict time regime, which inevitably is at the expense of quality, in particular for searching. This is because searching basically is an open-ended process, unless a knock-out publication is found.

EPO introduced BEST (“Bring Examination and Search Together”) on a large scale. Some dissenters believe that BEST is not the best solution. The saving in time is obvious, but some examiners are better at search, others at examination. Further, EPO restructured the units of Directorates I and II at its three sites (Munich, The Hague and Berlin) in technical clusters, each

cluster bridging the sites. For assessment of the effects on backlog and quality we will have to wait until it is fully implemented and running smoothly. Deferred examination is being discussed, but this would be against the original intentions of the Munich convention.

9. Patent Network

A further measure has been initiated by the Administrative Council of EPO (conveniently consisting of representatives of the national offices of EPC-countries): a Patent Network knit between EPO and national offices for using each other's products [6]. This means initially that the search results of national offices of first filing will be used by EPO (if EPO is the office of second filing), saving EPO examiners time on the search.

Experienced practitioners see this as a disadvantage [7]. They prefer two or three imperfect searches to one almost perfect search. It could be added: even if the latter is almost perfect, which it is as often as not, with some offices. A number of national offices seem ambitious to participate in the Patent Network, but will have to conform to quality standards to qualify.

A utilization pilot program (UPP) was run with four selected countries (DE, AT, DK and GB) [8]. Applicants had to volunteer with their first filings to be included in the project. No complete evaluation has been published so far. But the number of volunteers indicates that the project met with little sympathy from applicants. Applicants seem to prefer the filtering effect of a good search for the first filing which is an important task of the national offices, in part justifying their continuing existence besides the EPO. In doing so, national offices merely discharge their duty, no extra reward from EPO seems justified. Nevertheless the project is likely to be pushed ahead.

10. Standards – EPO

The EPO installed a working party with the task of drafting quality standards for the process (including quality control and handling of complaints) [9] and following up for the products [10]. It consisted of a handful of experts from EPO, about 20 representatives of the national offices and only 2 representatives of European industry.

These standards have been finalized and accepted by the president of EPO and by the Administrative Council late in 2008. The products are: classification, (enhanced) search report, official action and patent. The structure of the product-standards is modular. This means, that an office is only bound to the standards for the product which it will furnish.

The most important items listed in the product-standard are, as far as the product search report is concerned:

- full classification for the entire claimed invention, as comprehensive classification is prerequisite for a good search and a good search documentation,
- search in the PCT minimum documentation (WO, EP, DE, FR, GB, CH, JP, SU, US and KR), as defined in the Patent Cooperation Treaty. If not, to be stated explicitly in the search report (this addition offers an escape),
- search according to guidelines (e.g. those of EPO), in all relevant classes and databases; full adoption of EPO's guidelines did not meet with consent,
- search until documents relevant to all claims are found or classes and databases have been fully covered,
- the search report cites all relevant documents, available to the searching office at the time of the search (the second half-clause is a compromise),

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