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Subject : Towards an Enhanced Partnership between Patent Offices under the Community Patent - European Standard for Searches

Delegations will find in Annex a Presidency working document for discussion at the meeting of the Intellectual Property (Patents) Working Party on 9 September 2009.

**Towards an Enhanced Partnership between Patent Offices under the Community Patent –
European Standard for Searches**

Introduction

1. The working document, *Towards an Enhanced Partnership between Patent Offices in Europe under the Community patent*, 6044/09 PI 9, presented by the Czech Presidency in February 2009, received broad support from Member States at the meeting of the Council Working Party on 17 February 2009. There seems to be an emerging consensus that a common ground should be explored, in order to enable National Patent Offices (NPO) who wish to do so to enter into enhanced partnerships with the EPO, in particular in the context of the future Community patent. Against this background the Presidency proposes the development of a *European Standard for Searches (ESS)*. ESS should be based on and implemented as a further development of the European Patent Network (EPN)¹, in particular the Utilisation Project² and the European Quality System.³ This paper intends to stimulate further deliberations between Member States in this area. It builds on the previous working document of the Czech Presidency which outlined criteria for enhanced partnerships (paragraph 8, doc. 6044/09).

Objectives and principles

2. Enhanced partnerships must add value to the work of the EPO as the main granting authority for patents in Europe. At the same time, NPOs wishing to participate in enhanced partnership with the EPO should be encouraged to do so. This partnership should both make use of NPOs existing expertise and strengthen their capacity to enhance the overall quality of the patent system in the future. In particular in the context of the future Community patent procedures should avoid duplication of work and should make most efficient use of resources. In order to facilitate the utilisation of work carried out by NPOs it is vital to introduce the highest common search standards in order to retrieve all relevant prior art documentation and to ensure predictability in the assessment of patentability and timeliness in the issuing of reports.

¹ EPO documents CA/120/06 and CA/PL 8/09.

² EPO document CA/147/08 Rev. 1.

³ EPO document CA/122/06.

3. Meeting all criteria in a European Standard for Searches – ESS should enable an NPO to qualify for an Enhanced partnership with the EPO. As a long term objective, the implementation of ESS should make it possible for the EPO to make use of searches with regard to applications first filed at an NPO. This standard could ease the workload and diminish the backlog of the EPO, hereby facilitating the timely delivery of patents and should fully respect the central role of the EPO in granting and administering of European patents, including the Community patent. It should help to maintain the quality of the patent system at the current high levels guaranteed by the EPO and contribute to further efficiency gains in the future.

4. In order to qualify for performing tasks under the ESS a basic requirement is that NPOs fulfil a high level of quality. A prerequisite for an efficient patent system without duplication of work is therefore the establishment of a well functioning quality system, which has to be in line with the standards established in the European Patent System. This quality system shall preferably be the European Quality Management System (EQMS)⁴ which is based upon the quality system decided by the PCT Assembly (PCT Guidelines, Chapter 21) and the Product Quality Standard (PQS)⁵. The PQS aims to contribute to the harmonising of what constitutes a quality product and how the quality of products can be measured against these standards. The definition of the objective assists the assessment of the extent to which patent products meet the PQS, whereby the EQMS provides a suitable infrastructure for the achievement of quality as defined by the PQS.

A European Standard for Searches – ESS

5. In order to establish a cost effective and efficient patent process in particular in the context of the future Community patent it is essential that the resources are used in an effective way and that the quality of the search and examination meet the expectations of the applicants. To achieve this long term objective, the first step could be the establishment of a set of common standards related to searches in the framework of the ESS.

6. The establishment of ESS would aim to create a basis for allowing in the future best use of the resources and previous work of the NPOs at the EPO. The ESS would include a system of collaboration between NPOs and the EPO regarding common standards and transfer of information

⁴ EPO document CA/57/07.

⁵ EPO document CA/135/08.

on how the search has been effected as well as feedback from the EPO to the NPOs. As already mentioned, it should be based on and implemented as a further development of the European Patent Network (EPN), in particular the Utilisation Project and the European Quality System.

7. The cornerstones for the introduction of the ESS would be:

- a) Search;
- b) Training;
- c) Patent practice;
- d) Tools;
- e) Size of the Patent Office (critical mass of examiners);
- f) Feedback system.

a) Search

To secure the quality and the usability of a search performed by an NPO in the EPO procedure, the ESS has to be defined by certain parameters having impact on the search result, for example: minimum documentation searched, searched classes according to defined classification systems, common search strategies, etc.

The entire search also has to be documented in a standardised way. Each search has to be accompanied by a “log sheet“ in which appropriate information concerning: consulted databases, search parameters (strategy, keywords etc), classification, relevant documents etc is given.

As a long term objective, this documentation system is meant to serve as basic information for the examiner in the EPO. The EPO examiner would use the information to determine the need for further search and decide on the scope of such search.

The aim would not be automatic recognition of the search performed by the NPO in the sense that regardless of the quality and result, the search should be accepted by the EPO. Whether a further search report is drawn up or to what extent a search performed by the NPO could be used should always be decided by the examiner at the EPO.

b) Training

The training of examiners is an absolutely essential element of a high quality patent system. It is indeed necessary that this training is harmonized and that all examiners who are entitled to perform an ESS have been given a comprehensive training programme. This training should be subject to a certification process.

It would seem suitable that the EPO could undertake the responsibility for the arrangement and the administration of a standardised training programme in which trainers from NPOs would be trained. For the further training of examiners in the NPOs the “train the trainer“ concept would be applied. The Commission could be invited to explore the possibility for Community funding for training. NPOs with limited resources should be given preferred access to such funding.

c) Patent practice

A standardised model for search and preliminary opinion regarding patentability needs to be developed and implemented. The standardised model has to cover the most essential definitions in patent practice, as:

- Novelty
- Inventive step (problem/solution approach)
- Industrial applicability
- Unity of invention
- Complex applications
- Non-searchable inventions (PCT Art. 17(2); EPC Art. 52)

d) Tools

Another very important element in relation to harmonized search results is to secure that all examiners irrespective of in which office they are performing the search, have access to the set of search tools defined in the standard. The standard shall therefore comprise a list of search tools and search-related tools such as databases, preparations, and others. The standard could also possibly include definitions of search strategies, databases to be searched and other search-related aspects, which have to be followed when performing the ESS.

e) Size of the Patent Office (critical mass of examiners)

In order to qualify for performing tasks under the ESS a prerequisite should be that NPOs fulfil a high level of quality in the searches. It has been discussed at several occasions what the appropriate number of examiners is for a patent office to be able to obtain such a level of quality. There is however no easy answer to this question.

The problem is that there is no linear correlation between the number of examiners and the quality of the search in the sense that it would always be better to have a technical field split on many

examiners to obtain a high quality. If the examiner has too narrow a technical field in which to work, he will become an expert in the details but will lose the more general overview which is of major importance when considering which technical fields to search and when addressing the question of inventive step. If when dividing the technical field among examiners the fields are too narrow, it is probably more appropriate to have examiners working in parallel in the same technical field, also giving the opportunity to have discussions and exchange experiences.

On the other hand too broad a technical field will lead to a lack of knowledge of the details in the specific technical field, which of course is also a critical point with respect to the understanding of the functionality of the invention.

The PCT regulations state that a PCT authority should have at least 100 full time examiners. This number could be the starting point for a discussion of the size of an office, fulfilling the requirements set out in a European standard.

If an NPO does not meet the number of examiners for fulfilling the standard for the critical mass of examiners, cooperation between NPOs in a specific region should be encouraged. The offices concerned would share technical competences, to obtain compliance with the ESS. It could also be discussed to limit an NPO which has sufficient competence in a specific technical field to meet the requirements in this specific area.

f) Feedback system

An essential instrument for fine-tuning the patent process is to implement a feedback system in order to obtain improved quality and efficiency. The result achieved downstream in the process has to be transferred to the origin in a systematic way resulting in a continuous work with improvements of the process. An appropriate model for this could be based on Deming's PDCA-model (Plan-Do-Check-Act).

g) Assessment system

Common standards for the assessment of the fulfilment of the criteria established under ESS should be set up to provide objective, transparent and reliable information on the quality of work and performance of the NPOs participating in the ESS. Any further development of the ESS towards its long term objective should be subject to such assessments. The evaluation could be carried out by the EPO, with an active participation of the NPOs and the users.

Closing remarks

8. The deployment of IT-related tools and possible common action under the ESS could equalise the basic conditions for the offices to perform an efficient and uniform high quality work and today it should be possible to accomplish the harmonization necessary to realize an effective European patent system.

9. The intention behind the ESS is to build a foundation for an efficient, world-class quality patent product in the sense of better utilisation of the available patent resources in Europe.

10. Besides better utilisation of available resources the proposal will have the advantage of strengthening the role of the NPOs, enabling them to offer patent support to applicants in their own language and in their local region.

Next steps

11. The present document provides one possible arrangement to explore in the pursuit of an efficient European patent system in particular in the context of the Community patent. Member States are invited to reflect on these ideas.
