QUALITY OF PATENTS: A MATTER OF INFORMATION INPUTS

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Definition of “Industrial User”

The term “ industrial user ” encompasses both applicants/patentees and third parties.

Industrial users of the patent system are *simultaneously* applicants/patentees and third parties.

The logical position of an industrial user is not pro-patent or anti-patent, but pro-balance

What is a Quality Patent?

For an industrial user, a quality patent

- brings a technical contribution which is not straightforward vis-à-vis the prior art
- describes feasible means to make/use the invention
- has a scope commensurate to the contribution

Patent Quality and Patent Process

A quality patent is the product of a process. Typical sequence:

- assessment of invention (by applicant)
- drafting of an initial patent application (by applicant)
- prior art search (by the EPO or the competent patent office)
- filing of EPO or PCT application (by applicant)
- publication(s) of the application and of the search report (by the patent office)
- examination (by the patent office and applicant, possibly with third parties' intervention)

Patent quality is the result of quality at each step

Quality at each step is based on *information inputs* provided by the patent system

Information inputs

Information needed:

- the rules
- the prior art
- the search/examination file

Information must be

- reliable
- available as early as possible

The Rules

Rules: the EPC, guidelines for examination, case law of the EPO Boards of Appeal and national courts

Major concern for industrial users : *predictability*

Rules must be *simple*: complexity generates for users uncertainty, legal costs, defensive strategies, burdens the EPO, increases risks of inconsistent court decisions

Consistency of case law esp. of the EPO Boards of Appeal absolutely required

Rules must be as uniform as possible across technologies

EPO Database: the "Crown Jewel" (1)

- international coverage of patent documents
- technical library structured for efficient searching and access to cited and "citing" patents
- deserves high priority for keeping it updated, including documentation tasks
- lack of patent literature for computer-implemented inventions primarily responsible for grant of trivial patents in this field
- must not be compromised by any reform or international cooperation
- the EPO should request industrial users' help to include more non-patent documents

EPO Database: the "Crown Jewel" (2)

- free access through *espace@net* is of enormous value to users
- *espace@net* is a user-friendly tool, easy to use by non-specialists
- recent enhancements to *espace@net* : full-text documents, "citing patents", examination file
- applicants should be encouraged to always perform a pre-filing *espace@net* search and include findings, including search strategy, in the application
- US law (treble damages) deters monitoring of patent publications

Search Reports (1)

Knowledge of the relevant prior art critical for

- assessment of validity by applicant and decision to pursue the case
- substantive examination by the EPO

"patentability examination is only as good as the prior art search"

- assessment of validity/scope by third parties

Content : reasons for relevance must be documented

Requires staff with technical specialisation, linguistic skills

Timing of communication to applicant and publication : the sooner the better

Search Reports (2)

External benefits : EPO search reports used by many patent offices throughout the world

Quality of search reports can be objectively assessed on the basis of

- searches performed by other patent offices
- third parties' contributions (pre-grant observations and oppositions)
- third party observations should be encouraged

Examination issues

Novelty

- Correct understanding of the prior art is the basic issue, frequently determinative of grant decision

Processing time

- Frequent cases of truly unacceptable delays (no EPO communication 4+ years after the rexamination request)
- Bottlenecks must be healed

Centralisation

Centralisation is the cornerstone of the European patent system

It is critical esp. for ensuring that the EPO database will be properly maintained and search reports will meet the desired quality standards

Unravelling of the EPO would be very harmful to quality

Critics must be wary of the current threats to centralisation

The European system is a worldwide reference, recognised in recent US reform bills