

11 Quality Control (Management) of Operations Peripheral to Formality Examination and Other Operations^(*)

With the advancing globalization of corporate activities, it has become necessary to obtain and exploit intellectual property rights in many countries in recent years. Along with this, diversified right protection systems have been established on a global basis. Consequently, the competitive age has begun in which system users choose intellectual property offices in the world in consideration of services provided and quality.

Some intellectual property offices in other countries, including Europe and the United States, are promoting improvement of services, for example, by obtaining a qualification for an international-standard quality management system (ISO9001) and making active efforts to maintain and improve the quality of the overall procedures, including substantive examination.

On the other hand, the Japan Patent Office (JPO) has just started efforts for the quality control (management) of operations, and there is a high need for further quality improvement.

Against such backdrop, we gained an understanding of the need for quality control (management) on the user side, conducted broad surveys on systems, rules, implementation frameworks, status of efforts, etc. concerning quality control (management) of formality and substantive examinations at major intellectual property offices in other countries, and conducted study through analysis and examination of the survey results.

I Purpose of This Study

With the advancing globalization of corporate activities, it has become necessary to obtain and exploit intellectual property rights in many countries in recent years. Along with this, diversified right protection systems have been established on a global basis. Consequently, the competitive age has begun in which system users choose intellectual property offices in the world in consideration of services provided and quality.¹ Such trend is expected to further accelerate with further progress of harmonization of intellectual property right systems and work-sharing on a global basis.

The JPO has just started efforts for the quality control (management) of operations, and there is a high external need for further quality improvement. The Intellectual Property Strategic Program 2011² also states that "The world-class quality management is to be implemented" and advocates the strengthening of quality control. Therefore, in providing high-quality services, the JPO also needs to promote designing of a control (management) system and establishment of a control (management) framework for the overall operations of the JPO, including operations peripheral to formality examination,³ by further examining the quality control (management) framework and methods for examination, etc. toward realizing quality control (management)

beyond the international standard in reference to advanced efforts made by intellectual property offices in other countries.

Against such backdrop, in this study, we gained an understanding of the need for quality control (management) on the user side, conducted broad surveys on systems, rules, implementation frameworks, status of efforts, etc. concerning quality control (management) of formality and substantive examinations at major intellectual property offices in other countries, including specific examples of quality control (management) processes, etc., such as the actual conditions and outcomes of the latest quality management system (QMS) and details of the checking method in the PDCA cycle, and conducted study through analysis and examination of the survey results.

II Method of Conducting This Study

1 Overseas intellectual property office survey

(1) Survey targets

We conducted the survey targeting the following 10 offices.

(*) This is an English translation of the summary of the FY2011 JPO-commissioned research study report on the issues related to the industrial property rights system.

Name of the intellectual property office	Content of the survey
USPTO (US)	Interview survey
PRV (Sweden)	Interview survey
NBPR (Finland)	Questionnaire survey
APO (Austria)	Questionnaire survey
IPA (Australia)	Questionnaire survey
Office A	Interview survey
Office B	Questionnaire survey
Office C	Interview survey
Office D	Interview survey
Office E	Questionnaire survey

(2) Survey perspectives

- Status of implementation of quality evaluation of formality and substantive examinations by external users
- Office's policy for improving the quality of examinations
- Framework to monitor and measure the quality of formality and substantive examinations in the office
- Cases where quality management led to improvements

2 Domestic user survey

(1) Survey targets

20 patent firms and 10 applicants in Japan

(2) Survey perspectives

We conducted the interview from the following evaluation perspectives.

- ① Evaluation of the quality of formality examination, etc.
 - (i) Quality of documents issued by the JPO in formality examination, etc.
 - Collective impression, quality of content of statements, and fluctuation (content of statements and determination of patentability)
 - (ii) Quality of responses by officials of the JPO
 - Collective impression, quality of responses to inquiries, and fluctuation
- ② Quality management of paperwork for filing by each of the firms/applicants subject to the survey

Quality management framework/methods

- Quality management policy, quality management organization, subject-matter, methods, and feed-back

- ③ Difference in quality between the JPO and intellectual property offices in other countries
 - (i) Formality examination and (ii) substantive examination (including comparison among five major intellectual property offices)

3 Overseas patent firm survey

(1) Survey targets

We conducted the survey targeting the following 10 firms.

Country where the firm is located	Survey item
China	Questionnaire survey
Denmark	Questionnaire survey
Austria	Questionnaire survey
Germany	Questionnaire survey
Sweden	Questionnaire survey
UK	Interview survey
UK	Interview survey
South Korea	Interview survey
US	Interview survey

(2) Survey perspectives

- Quality of examinations at the intellectual property office in the home country
- Quality of examinations at the JPO
- Quality management methods adopted at the intellectual property office in the home country
- Quality management framework/methods adopted by each of the firms subject to the survey

III Quality Management at the JPO

1 Flow of monitoring and measurement of patent substantive examinations

Name of the measurement department		Quality Management Office		Quality Management Office	Quality Management Office	Quality Management Office
Formality/substantive		Substantive		Substantive	Substantive	Substantive
Patent (utility model) /design/trademark		Patent		Patent	Patent	Patent
(1) Specific methods of monitoring and measurement in the JPO	(i) Subject-matter of monitoring and measurement	Cases whose examination has been completed	Cases for which a PCT application has been filed	First actions	Cases for which a decision of refusal has been rendered	Office actions which have been approved
	(ii) Sample extraction method	Random	Random	Extracted from the layer of the cases for which the rate of cases for which a decision to the effect that a patent is to be granted was rendered is low	Extracted from the layer of the cases for which the rate of cases for which a decision to the effect that a patent is to be granted was rendered is low	Random
	(iii) No. of samples	144 samples (2011) 0.04% 13 persons About 2 hours per sample	120 samples (scheduled in 2011) 0.38% 13 persons About 2 hours per sample (estimation)	439 samples 0.12% 13 persons About three and half hours per sample	Expected to be around 440 samples 0.12% (estimation) 13 persons About one and half hours per sample (estimation)	About 4,800 samples 1.08% 16 persons About 15 minutes
	(iv) Evaluation perspectives/items	Compliance with laws and regulations and communication with the applicant	Compliance with laws and regulations and communication with the applicant	Compliance with laws and regulations and communication with the applicant	Compliance with laws and regulations and communication with the applicant	Check the formality matters of the content of the drafts from the perspective of compliance with laws and regulations and communication with the applicant
(2) Details of the methods of feeding back the monitoring and measurement results		A user questionnaire survey concerning the samples subject to the checking is conducted at the same time. Analysis information is provided to the examination departments and the results of checking an individual case are provided to the immediate manager (Director) of the examiner in charge of the case.	A user questionnaire survey concerning the samples subject to the checking is conducted at the same time. Analysis information is provided to the examination departments and the results of checking an individual case are provided to the immediate manager (Director) of the examiner in charge of the case.	Analysis information is provided to the examination departments and the results of checking an individual case are provided to the immediate manager (Director) of the examiner in charge of the case.	Analysis information is provided to the examination departments and the results of checking an individual case are provided to the immediate manager (Director) of the examiner in charge of the case. (scheduled).	Analysis information is provided to the examination departments and the results of checking an individual case are provided to the immediate manager (Director) of the examiner in charge of the case. (scheduled).

* In (iii), the number of samples, the rate of samples, the number of persons who check the samples, and processing time for one sample are indicated in this order.

2 Flow of monitoring and measurement of design/trademark substantive examinations

Name of the measurement department		Design Examination Quality Management Committee	Trademark Examination Quality Management Committee	Trademark Examination Quality Management Committee	Trademark Examination Quality Management Committee
Formality/substantive		Substantive	Substantive	Substantive	Substantive
Patent (utility model) /design/trademark		Design	Trademark	Trademark	Trademark
(1) Specific methods of monitoring and measurement in the JPO	(i) Subject-matter of monitoring/measurement	Cases which have been approved	Decisions of registration as the first action which have not been approved (scheduled in 2011)	Notices of reasons for refusal which have not been approved (scheduled in 2011)	Decisions of refusal which have not been approved (scheduled in 2011)
	(ii) Sample extraction method	Random	Random	Random	Random
	(iii) No. of samples	72 (twice in a fiscal year)	72 (scheduled in 2011)	180 (scheduled in 2011)	108 (scheduled in 2011)
	(iv) Evaluation perspectives/items	Compliance with laws and regulations and communication with the applicant	The formality matters of the content of the drafts are checked from the perspective of compliance with laws and regulations and communication with the applicant.	The formality matters of the content of the drafts are checked from the perspective of compliance with laws and regulations and communication with the applicant.	The formality matters of the content of the drafts are checked from the perspective of compliance with laws and regulations and communication with the applicant.
(2) Details of the methods of feeding back the monitoring and measurement results		A user questionnaire survey concerning cases subject to the checking is conducted at the same time in the sample check at the later stage. Analysis information is provided to the examination department and the results of checking an individual case are provided to the immediate manager of the examiner in charge of the case.	Analysis information is provided to the examination department and the results of checking an individual case are provided to the immediate manager (Director) of the examiner in charge of the case.	Analysis information is provided to the examination department and the results of checking an individual case are provided to the immediate manager (Director) of the examiner in charge of the case.	Analysis information is provided to the examination department and the results of checking an individual case are provided to the immediate manager (Director) of the examiner in charge of the case.

3 User evaluation of the quality of formality examination

(1) Quality of documents issued by the JPO

Users' opinions concerning documents issued by the JPO as a whole were that the documents are "basically easy-to-understand."

Users pointed out fluctuation in statements, fluctuation among examiners, and fluctuation among organizations. In addition, users expressed opinions concerning procedures for a Japanese application by a foreign applicant and identification number.

Many users said that they did not feel much

fluctuation in statements.

Regarding fluctuation among examiners, users pointed out that examiners are divided in terms of responses, for example, receiving/not receiving and giving an invitation to correct/making a correction by ex officio.

Regarding procedures for a Japanese application by a foreign applicant, there were many opinions concerning signed documents which are submitted by foreign companies. Regarding identification number, users pointed out that unavailability of number search is inconvenient for users.

(2) Quality of responses

As a collective impression, users answered that most of the responses are basically good through some users said that improvements were necessary for some points.

Many users said that the responses were generous. However, some responses require improvements.

While some users said that they did not feel fluctuation, other users pointed out fluctuation among examiners and fluctuation among organizations. Users also pointed out that different answers were given to the same inquiry in some cases.

4 User evaluation of the quality of substantive examination

The substantive examination at the JPO is highly evaluated by domestic users and overseas patent firms.

In comparison with overseas offices, domestic users evaluated the JPO as follows.

Domestic users most highly evaluated the JPO in terms of patents, designs, and trademarks.

Patent: JPO>EPO>KIPO>USPTO>SIPO

Design: JPO>KIPO>USPTO

Trademark:

JPO>OHIM>KIPO>USPTO>CTMO

The offices are lined from the left in descending order of the quality.

Many overseas patent firms answered that patent, design, and trademark examinations at the JPO were "appropriate."

IV Quality Management at Overseas Intellectual Property Offices

1 Characteristics of quality management in each country

All the offices make the propriety of search, appropriateness of notices of reasons for refusal, and compliance with laws and regulations subject to evaluation. In addition, the USPTO (United States) make conformity with best practices subject to evaluation, office A makes conformity with customer service standards subject to evaluation, and the IPA (Australia) makes conformity with the Product Quality Standard (PQS) subject to evaluation.

The length of the hours required for sample check is basically longer for patent substantive examination, design substantive examination, trademark substantive examination, and formality examination, in this order.

The subject-matter of monitoring and measurement in terms of patents includes (1) search, (2) first notice of refusal, (2) second and subsequent notices of refusal, and (4) final disposition (decision of refusal and decision to the effect that a patent is to be granted). In addition, some offices make "PCT applications" and "approach to solve the problem of inventive step" subject to monitoring and measurement.

The PRV (Sweden), the NBPR (Finland), and APO (Austria) do not conduct sample check but evaluate all the relevant cases for some kinds of cases.

At the PRV, two examiners double-check all the first office actions. The NBPR compares differences between search report of an application at the national phase and search report of the application at the PCT phase for all new cases. The APO answered that its PCT department conducts additional check on all the PCT applications though the additional check is not described in the flow of monitoring and measurement. In addition, the APO conducts sample check in the manner that all the examiners become subject to it at least biennially. Medium-sized offices in Europe appear to take a lot of time and effort to evaluate examination results.

2 Results of implementation of quality management

At all the offices, feedback of quality management is communicated to examiners and

managers. Other examples of cross-organizational improvements include improvements concerning search, revision of examination standards, and provision of training for examiners.

All the offices answered that quality management activities greatly contributed to improvements in process.

3 Policy for improving the quality of examination

According to the tabulation results of answers of all the offices, the following processes appear to be attached importance.

Regarding patents, search process, process of communication between examiners and users, and classification process are attached importance. Regarding designs, process of communication between examiners and users is attached importance. Regarding trademarks, search process is attached importance.

According to the tabulation results of answers of all the offices, matters which the offices are now working on or intend to work on in the future are the enrichment of training for examiners and the formulation of a check list for the content of drafts to be used by examiners or those who give approval. Other examples of their efforts include enrichment of the control indicator (quality index) and continuous renewal of ISO9000.

According to the tabulation results of answers of all the offices, personnel evaluation of examiners/departments in charge in terms of process improvement activities (including sharing of search strategies) is considered as effective in enhancing the motivation of examiners in quality management activities. As an actual example, efforts have been made in the form in which "all the examiners have an individual target concerning quality and productivity and the target is used for annual operation assessment."

V User Evaluation of Overseas Intellectual Property Offices

Formality examination

The KIPO (South Korea) was evaluated as an office where office procedures are very high-quality.

Patent

Appropriateness of prior art search

The EPO (Europe) was evaluated as having high search ability for patents outside the

English-speaking sphere.

Appropriateness of statements in notices of reasons for refusal, etc.

The USPTO (United States) was evaluated as an office whose statements in notices of reasons for refusal, etc. are easy-to-understand as all constituent features of all the claims are stated and examiner's responses to applicant's opinions are also stated.

Design

The OHIM (Europe) was evaluated as an office where the examiner responds to inquiries at any time.

Trademark

Appropriateness of statements in notices of reasons for refusal, etc.

The KIPO was evaluated as an office where examiners state their own opinions in detail.

Fluctuation in examinations

The UKIPO was evaluated as an office whose examinations fluctuate very little and fluctuate least compared to the OHIM and the JPO.

Quality management

The DKPTO (United Kingdom) was evaluated as an office whose quality was improved as a whole through introduction of the same examination approach as the EPO.

VI Quality Management Frameworks and Methods of Companies

Most domestic users and overseas patent firms have not obtained ISO9001 certification. However, they are firmly aware of (1) commitment as an organization and (2) active participation of all constituent members. In addition, their intention to control factors that have a significant effect on outputs with a focus on the process is apparent in the management methods, and they have realized quality management-conscious operations.

VII Conclusion

1 Quality management of formality examination in Japan

This study indicates that division in terms of responses among examiners in charge has been becoming obvious with regard to specific subjects,

such as signed documents submitted by foreign companies and processing concerning identification number. A possible measure for further improving the quality is an well-modulated efficient method in which intensive double-check is conducted on subjects and cases for which determination tend to fluctuate as mentioned above and sample check is conducted on other subjects and cases.

2 Quality management of substantive examination in Japan

Overseas intellectual property offices generally adopt additional search by a third party in their monitoring and measurement methods as part of quality management. Overseas intellectual property offices are highly interested in search in terms of both specially emphasized processes and matters to be worked on in the future. The JPO also has room to consider introduction of quality management of search, including management of outsourcing of search.

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¹ For example, for an international application under the Patent Cooperation Treaty, the applicant may choose an International Searching Authority (4.1(b)(iv) of the Regulations under the Patent Cooperation Treaty).

² "31. Strengthening of quality control of patent examination (short/medium-term)," Intellectual Property Strategy Headquarters (June 3, 2011).

³ Chapter 21 of the PCT International Search and Preliminary Examination Guidelines provides not only quality control (management) of examination but also quality control (management) of formality operations and establishment of a framework thereof.