



Topic 4: Retrieving and utilizing external examination results – Types of results

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Agenda

- Opportunities
- Requirements
- Types of results
 - final
 - intermediary
- Public resources for retrieval
- Issues

Opportunities through patent families

- Utilisation possible if same or similar invention was filed in several IPOs
 - OFF: Office of First Filing
 - OSFs: Office(s) of Second Filing
 - Simple family (usually same invention, ie most likely similar claims)
 - Extended family (at least similar invention, claims may differ)
- **Active worksharing**: avoid duplication of work by active organisation of the work distribution; e.g. OFF treats applications with priority and OSFs wait for results
 - Some collaborations have started, e.g. Vancouver Group (AU, CA, UK)
 - Trilateral offices (EPO, JPO, USPTO)
- „**Passive worksharing**“: Use results that were obtained for family members at other IPOs

Active worksharing trilateral offices

- Utilisation requires that results produced by the OFF are available on-time at the OSF
- The EPO performs systematic prioritisation of first filings. Utilisation at the EPO requires that other offices also do the same:
- **JP-FIRST:** JP Fast Information Release Strategy - JPO launched in 2009 this pilot to prioritise certain first filings that are subsequently filed at the EPO and USPTO
- **SHARE:** Strategic Handling of Application for Rapid Examination. USPTO launched in 2010 a pilot with the EPO and JPO where this office prioritises first filings (FLASH - First Look Application Sharing)

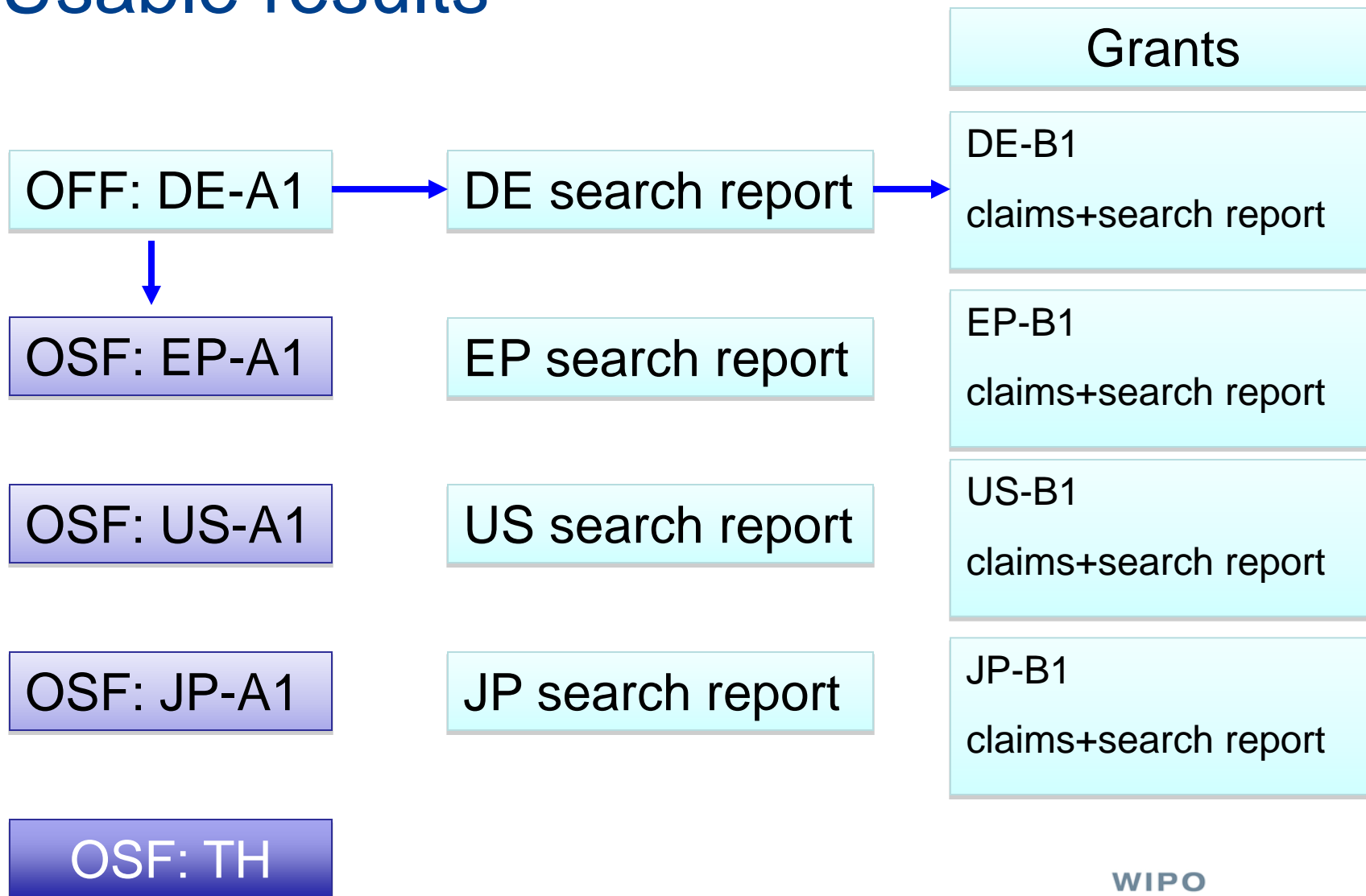
Passive worksharing

- Utilization of examination results obtained by other IPOs can save resources and improve quality, e.g.
 - Other IPOs may have access to other information resources
 - Individual examiners at other IPO may have particular expertise in a certain field
 - Learning from/improving other search strategies
 - Examination reports may include valuable arguments/particular views
- PW is very effective strategy for small IPOs to cover all technical areas, instead of outsourcing of substantive examination (see presentation of topic 1)
- Can be done by respectively trained examiners acting like "state patent attorneys"

Types of examination results

- Intermediary or pre-grant results
 - Search reports (basic; enriched, e.g. with search strategies)
 - Written opinions, examination reports
 - Communications between applicant and examiner
 - Third party observations
- Final results
 - Granted claims
 - Rejections; withdrawals following substantive reports
- Post-grant results
 - Additional prior art from opposition/re-examination
 - Amended claims
 - Communications between involved parties (3+)

Usable results



Issues with final results

Utilization of final results (grants/refusals)

- Requires identical/similar invention (simple family)
 - i.e. original claims are similar(for grants:)
- Requires cooperative lawyers/applicants that agree to use the claims granted abroad
- Requires the claims to be compatible with national law, e.g. exclusions
- Requires confidence in the work of other IPOs
- Implies considerable delay because final results have to become available

Issues with final results

Utilization of final results (grants/refusals)

- Requires identical/similar invention (simple family)
 - i.e. original claims are similar
(for rejections:)
- Requires access to file wrapper (file inspection) to see rejection ruling
- Rejection ruling only applicable if claims to be rejected are similar

Patent prosecution highway PPH

- JPO initiative to accelerate granting in case of grants at other IPOs
- **In case of grants:** Option for applicants to obtain patent protection more efficiently and faster in the Office of Second Filing when the Office of First Filing has determined allowable / patentable subject-matter.
- (See separate presentation on topic 8 for use of granted claims)

Issues with intermediary results

- Implies some but smaller delay than waiting for final results
- Searches are based on claims: the foreign search results may be incomplete/inappropriate if claims are different
- Requires checking whether same priorities
- Different priorities and priority dates can lead to different claims or prior art
- Usually no problems if simple family
- Using results for members of extended family which are not in same simple family may be problematic (compare claims !)

Planning of utilization

- ▶ Utilization of examination results requires knowledge of
 - Family information, i.e. where else has an invention been filed (Paris, PCT, technical family)
 - Examination practice of other IPOs, i.e. do they have deferred examination (e.g. DE), is prior art search mandatory (e.g. EP, PCT) ?
 - Examination status, i.e. is substantive examination under way (i.e. national phase entry for PCT applications); requires publicly accessible patent register
- ▶ Depending on your national requirements, e.g. deadline for first action by examiner

Retrieval options

- Active retrieval by examiner, i.e. **research family information** and **research examination status** and **retrieve results** from online resources
- Request applicant to submit information; some legislations provide for a respective obligation

Article 124 EPC

(1) The European Patent Office may, in accordance with the Implementing Regulations, **invite the applicant to provide information on prior art taken into consideration in national or regional patent proceedings** and concerning an invention to which the European patent application relates.

(2) **If the applicant fails to reply deemed to be withdrawn.**

Online resource

- ▶ Various (public) online databases provide
 - Family information (see topic 3)
 - Examination status (patent registers)
 - Published applications and granted patents with search reports, granted claims
 - Several IPOs also offer access to the examination file (file wrapper), e.g.
 - Examination reports
 - Replies from applicants
 - Rejection rulings

Selected online resources

- European Patent Register (EP)
 - <https://register.epo.org/espacenet/regviewer>
- Common Citation Document (Pilot)
 - <http://www.trilateral.net/ccd>
- Patentscope
 - <http://www.wipo.int/patentscope/search/en/search.jsf>
- Public Pair (US)
 - <http://portal.uspto.gov/external/portal/pair>
- AIPN (JP)
 - <http://aipn.ipdl.inpit.go.jp/>
- K-PION (KR)
 - <http://kposd.kipo.go.kr:8088/up/kpion/>
- DPMAregister (DE)
 - <http://register.dpma.de/DPMAregister/Uebersicht?lang=en>

Online resources

- European Patent Register (EP)
 - EP applications: enriched SR, ER, examination status, file wrapper)
- Common Citation Document (Pilot)
 - SRs for EP, JP, US, WO,.....
- Patentscope
 - WO applications: enriched SR, ER, file wrapper
- Public Pair (US)
 - US applications: file wrapper with SR, ER, examination status
- AIPN (JP)
 - See topic 6 presented by JPO
- K-PION (KR)
 - See topic 6 presented by JPO
- DPMAregister (DE)
 - DE applications: SR, examination status (file wrapper from Q3/2013)

REMINDER: National sovereignty

Paris Convention:

- **No** obligation to use results of others, or to follow their conclusions
- IPO has obligation to observe national legislation
- IPO has responsibility/liability for quality patents