



## **Topic 3: 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)
    - Technical family
- **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

- **Coordination between IPOs:** Utilisation requires that results produced by the OFF are available on-time at the OSF, e.g.
- DPMA and EPO perform 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)

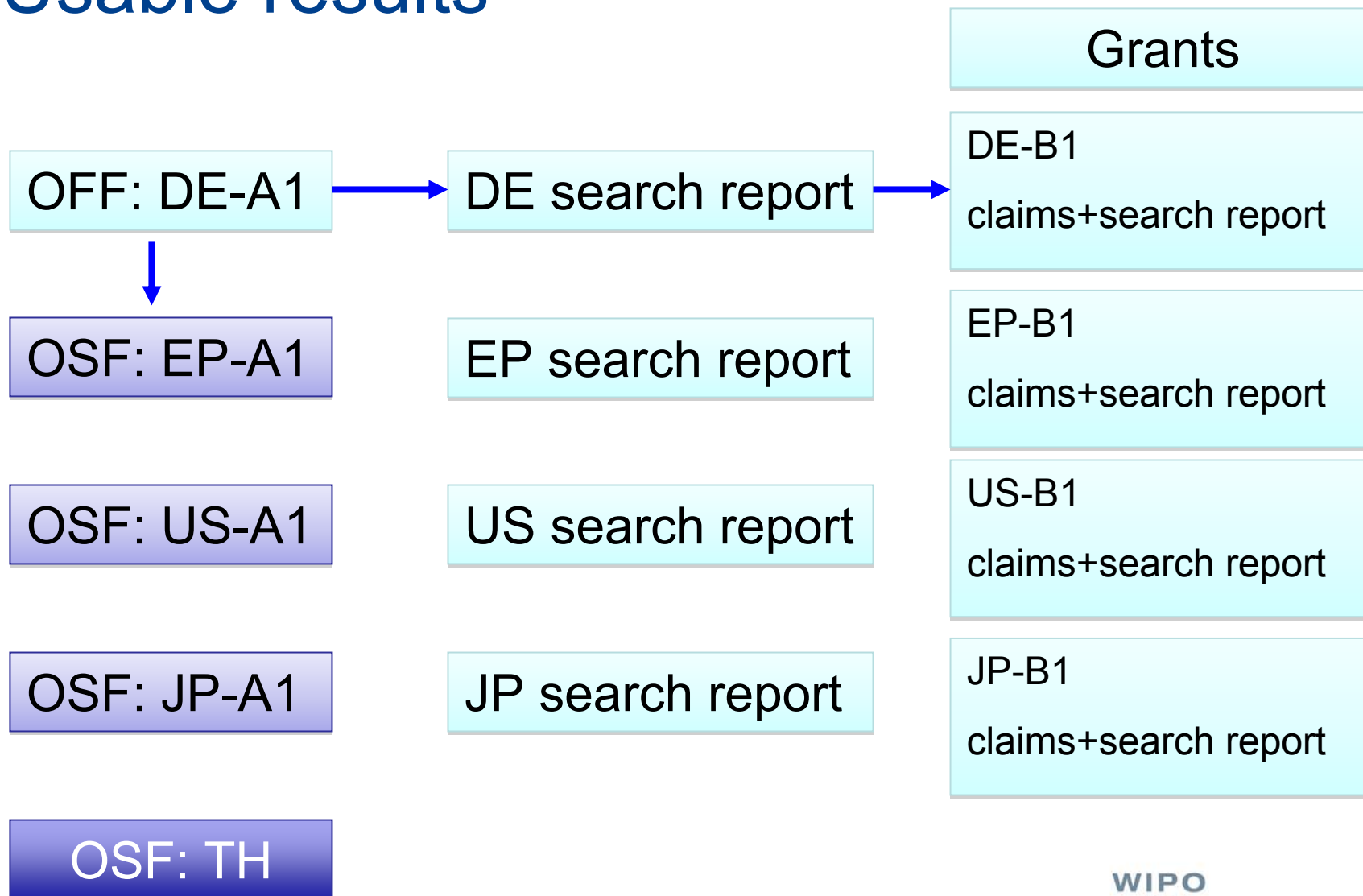
# Passive worksharing

- PW is a very effective strategy for small IPOs to cover all technical areas, instead of outsourcing substantive examination (see presentation of topic 1)
- Can be done by respectively trained examiners acting like "state patent attorneys"
- Utilization of examination results obtained by other IPOs provides general **benefits** and may improve quality at **any IPO**, because:
  - 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

# Types of examination results

- Intermediary or **pre-grant** results
  - Search reports (basic; enriched, e.g. including 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)
  - E.g. if original claims are similar

For grants:

- Requires cooperative lawyers/applicants that agree to use/submit the claims granted abroad
- Requires those claims to be compatible with national law, e.g. exclusions
- Requires confidence in the work of other IPOs
- Results from different IPOs may be different (see exercises)
- 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)
  - E.g. if 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 2)
  - Examination status (patent registers)
  - Published applications and granted patents with search reports, granted claims
  - Several IPOs also offer public file inspection, i.e. access to the examination file (file wrapper, dossier), e.g. to
    - Examination reports
    - Replies from applicants
    - Amended claims
    - 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
  - 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