

## Day 2 Exercises B – Exercises on retrieval and utilization of external examination results

We are going to use following freely accessible databases offering patent status data and file inspection:

**EPO Espacenet:** <http://worldwide.espacenet.com/>

Espacenet also permits access to the EPO Register which permits file inspection.

Direct access to **EPO Register:** <https://register.epo.org/espacenet/regviewer>

**EPO CCD** <http://www.trilateral.net/ccd>

**WIPO Patentscope:** <http://www.wipo.int/patentscope/search/en/search.jsf>

**US-PAIR:** <http://portal.uspto.gov/external/portal/pair>

**DPMA Register:** <http://register.dpma.de/DPMAREGISTER/Uebersicht?lang=en>

**DEPATISNET:** <http://depatisnet.dpma.de/DepatisNet/depatisnet?action=einsteiger>

**AIPN:** <http://aipn.ipdl.inpit.go.jp/> (requires registration with JPO)

The objective of these exercises is to familiarize ourselves with the online resources permitting access to examination results of other offices for family members, file inspection and examination status data. In this exercise we do not utilize the results (see exercises D and E), we only check availability and examination status.

**Task 1:** [DE19833712](#) (this case was considered already in exercises A)

Q: Is there any enriched search report?

A: No, this is a case where we do not have an EP or WO search report, i.e. an enriched SR with X,Y,.. ratings, ..).

Q: Which other search reports/lists of citations are available?

A: DE-B4 has citations on its front page which can also be seen when clicking on the link "citations" on Espacenet when you view the bibliographic data of the DE-B4; the citations of FR-A1 are also available when clicking on the link "citations" on Espacenet (make sure you view the bibliographic data of FR-A1); the citations of US-B2 are also available through this link; for the two Japanese domestic families not citation information is available through Espacenet although patents have been granted.

Q: Can you retrieve, on Espacenet, the claims granted by the French office? Can you think of other options?

A: No. The claims offered through Espacenet are those of the FR-A1! There is also no electronic copy of the original document FR-B1 downloadable from Espacenet. The PDF may neither be obtained from the French office (INPI) website since that website only links to a French version of Espacenet. However, the PDF of the FR-B1 document can be retrieved from the public German Database [DEPATISNET](#) (<http://depatisnet.dpma.de/DepatisNet/depatisnet?action=einsteiger>; search for FR2767193).

Q: How would you retrieve the claims granted by the JPO?

A: Search for publication number JP 2011-094666 A in AIPN. AIPN includes full Inpadoc family and file wrapper. Search strategy is included in file wrapper. Machine translation of granted claims. Second family is divisional application.

Q: How many prior art documents have been cited by the German examiner? Compare with the US and FR citations.

A: There are 5 citations for the DE-B4, less than for the US-B1 document which includes 19. The FR-A1 also includes 5 citations but they are partly different from the DE-A1 and include, e.g., with an XP document also non patent literature.

Q: How many other applications are citing this [DE19833712](#)?

A: Click in Espacenet on "citing documents"; currently, there are 11 different domestic families citing this document. This can be useful to find other prior art by checking the search report of these documents as well.

## **Task 2:** [EP2138392](#) in Espacenet

Q: How many EP publications with different kind codes are available and what do they mean?

A: 2; EP-A1 18 month publication of application with search report, EP-B1 publication of granted patent

Q: Is there an EP search report (citation list)?

A: There are 2 search reports, EP-A1 (separate pages; enriched search report), EP-B1 (summary of citations on front page, note the different formatting of publication numbers with kind codes after country code); both have same citations; note that applicant cites additional JP-A-2007 283927, as you can see when viewing the application in the EP Register or the last page of the EP-A1 search report.

Q: Is it possible to retrieve the French version of the claims granted by the EPO?

A: Yes, the EP-B1 publication includes also translations into French and German. The French claims may also be downloaded from the file wrapper accessible on the Register.

Q: Which other equivalent are there and what do their kind codes mean?

A: ES-T (Translation); AT-T (Translation); CN-A (publication of application); CN-B (granted patent).

For information on kind codes, please see:

<http://www.wipo.int/export/sites/www/standards/en/pdf/07-03-02.pdf>

Q: Is there a search report for the patent granted in China?

A: Yes, the front page of the CN-B document has a list of 4 citations under INID code 56.

Q: The priority is from Japan. Is there a JP equivalent, i.e. a publication of the Japanese priority application? And can you get information from AIPN on the examination status/results?

A: No, surprisingly there is no JP publication despite the JP priority. AIPN would not give any information since this JP application was not published.

Q: How much time did it take at the EPO from filing of the examination request to granting?

A: Examination request was filed on 2010/06/25 (to access this information from Espacenet, you need to use the "register" link). The intention to grant was communicated on 25.10.2010 (see section "Examination Procedure" of the summary in the EP Register), only 4 months after the examination request.

Q: Was the examination based on the initially filed claims?

A: No amended claims have been filed on 24.06.2010 prior to the examination request. The examiner was apparently immediately satisfied with these amended claims.

Q: Which external results are available in total?

A: The enriched search report EP-A1; the citations of the EP-B1 (they are considered as separate result since citations could be added during examination, e.g. because of a top-up search or because of third party observations; the claims as granted by the EPO examiner and published in the EP-B1 in English, French and German; the communication between the EPO examiner and the applicant; the list of citations on the front page of the [CN-B](#). The claims granted by the Chinese examiner are available in Chinese only in the CN-B document.

Q: What is the legal status of the EP grant in DE?

A: In the "About this file" view in the EP-Register, you will see that the patent has lapsed in most member countries of the EPC; DE is not included in this list. To view the status in DE you need to click on "Legal status" and click there on the link to DE register. The patent has lapsed in Germany as well. Note that this page "Legal status" includes links to most European online registers. This is called a federated register.

### **Task 3:** [EP2138396](#)

Q: Is there an EP search report? Is there another search report? Check the legal status in the Register.

A: No EP-A3; no other search report despite filing date in 12/2009; reason why there is no EP-A3 is not known, according to the register, the application is pending, there were deficiencies but they were remedied; a search report is overdue but should become available, the search fee has been paid.

Q: What is the status in DE?

A: The application is pending (as of 14.1.2013); however, examination has not yet been requested, therefore there are no citations included in the Register.

Q: Look up the same document in US-Pair. Use the US application number. What is the examination status there?

A: You have to use the US application number 12/490,946 as shown on the front page of the US-A1 document. All other formats don't work in US-PAIR. Substantive examination has started, a search report is available, and a first examination report was issued.

**Task 4:** US application 11/093685 in US PAIR

Q: What is the examination status?

A: Patent is granted in US. Can be seen on tab "application data": "patented case"; patent number, issue date.

Q: When was the search report established by the examiner?

A: Open tab "image file wrapper" or "display references": 04-28-2006. Note that the applicant later disclosed the WO-A3 search report (see below) to the US examiner which then also became recorded as relevant prior art ("List of References cited by applicant and considered by examiner").

Q: Is there information available regarding the examiner's search strategy?

A: Yes, see documents SRNT and SRFW in the image file wrapper. It refers to the search strategy applied for establishing the search report established on 28.4.2006.

Q: How can you view the full specification of the granted patent?

A: Select tab "published documents"; you get the full text and PDF; both also include the citations.

Q: Are there any French language translations available of the claims granted by the USPTO?

A: No certified translations into French would only be available for patents granted by the EPO.

Q: Is there any family information in US PAIR?

A: Only on domestic family, no foreign filings.

**Task 5:** Search the same application US application 11/093685 by using the CCD; search by typing "11/093685" or "11093685"

Q: How many family options are displayed and why?

A: Three different ones. The system searches for the string "11093685" in any number records of the database; it also appears in a JP application number a JP publication number. The first entry in the result list is the US application of this exercise.

Q: How many family members are there for the simple US family? And where was the invention filed for the first time, i.e. which is the OFF?

A: Three: EP, US, WO; OFF is US. Click on "compact view" to see just the family members.

Q: How many search reports are available in the CCD? Is any any of them an enriched report?

A: Two, the citations of the US application and the WO application. The EP application is referring to the WO report. The WO report is an enriched search report.

Q: Who did the WO search report? Compare both search reports.

A: The WO search report was established by the EPO (examiner Steffen Wolf). The US citation list in the CCD includes more prior art. However only 3 citations were identified by the US examiner, the others were cited by the applicant or derived from the WO report which the applicant disclosed to the USPTO on 12.3.2007 (see above task on US PAIR).

Q: What is the status of examination at EPO?

A: You have to check this in the EP register. There is no link in the CCD to the register; so you have to open the access the register separately. Examination is in progress (as of 14.1.2013).

Q: What procedural events have taken place at the EPO?

A: The grant of a patent was refused on 7.02.2011. The applicant has filed an appeal which is still pending.

Q: Are there any other PCT national phase entries? Please check the Patentscope database.

A: When you search [WO2006104953](#) on Patentscope, the tab "national phase" includes the EP national phase entry; German and Russian ones are said to be withdrawn.

#### **Task 6:** [EP2138569](#)

Q: What is the examination status at EPO ? Use the register link.

A: Examination request was filed on 2010/06/30; the last event (as of 15.1.2013) was the publication of an intent to grant. To access this information from Espacenet, you need to use the "register" link.

Q: Was the examination based on the initially filed claims?

A: No amended claims have been filed on 29.01.2010 (in German, hand written amendments); they were amended because of the European search report and opinion. Apparently, they were accepted during the subsequent examination, no further report was issued, the grant is based on these amended claims.

Q: Is there a French version of the granted claims?

A: No, neither a French version nor an English version is available as yet (15.1.2013). The applicant has to supply it however, and the French claims will be included in the EP-B1 document to be published.

Q: Is there a French or English version of the European search opinion ?

A: No the opinion is and will be available in German only. Only the claims that are granted will be translated and could be used by non German speakers.

Q: There are 2 search reports (DE-A1, EP-A1; are there differences between the cited prior art?

A: Yes; EP-A1 includes more citations; DE-A1 has one extra citation not included in EP-A1 (DE 10 2004 045239 A1)

Q: Which prior art is cited by the applicant?

A: 2 documents, see D label in EP-A1

Q: Where did the applicant cite them?

A: in paragraph 0003 of description

Q: Compare EP-A1 and "cited documents" (link in left hand menu)?

A: "cited documents" does not include all EP-A1 docs; unclear why.

Q: Where else do you find information on citations? Compare these data with EP-A1.

A: At the bottom of the register data; they are identical.

### **Task 7:** US application 12022866

Q: Search the application in the CCD and US-PAIR; what do you observe for the search reports? Who did the WO search report?

A: CCD only includes citations for the WO-A3, the report was established by the EPO, i.e. by a different examiner than the US search report (see, e.g., the original A3 report, 2<sup>nd</sup> page below). US-PAIR includes as citations by the examiner two non patent literature (NPL) documents which are not cited in the WO report. They cannot be viewed because of copyright issues, only the bibliographic data are available. This example shows that the citation information included in the CCD is not necessarily complete. It is always worth checking the other sources. According US-PAIR the US application is abandoned.

Q: View the EP family member in the EP register; is the presentation of citations same as in the CCD?

A: No the register includes DOI's, links to the publishers; the register citations are only partially enriched in comparison to the original report in the A3 document or the CCD citations.

Q: What is the price for reading the first article in the citations list?

A: 35\$ for 48h; click on DOI link, then select full text html view of article.