

## Exercises Topic 11 – Utilization of claims granted by different IPOs

The objective of these exercises is to study cases of granted patents where some offices granted claims with sometimes different wording, or where some offices granted a patent while others refused.

The answers reflect the prosecution status as of July 31, 2014.

### Task 1: [EP1702525B1](#) ("Nargileh" case of exercises A; differently worded main claims issued by different IPOs)

Q: This case was already studied in the exercises on patent families. Compare the main claims granted by the EPO ([EP1702525B1](#)) and the USPTO ([US7775218B2](#)). Compare them with the originally filed claims of the EP-A1.

A: To compare the granted claims you have to view the PDF version of the publications of the granted patents, i.e. the EP-B1 and the US-B2 (click on "original document"; do not click on "claims" in the left hand Espacenet menu since you get then only the claims of the A1 documents). The EP-B1 was granted on 28.10.2009, and the US-B2 was granted on 17.8.2010 (seen the publication dates in the Inpadoc family list). The characterizing part of the respective claims are completely different. In the US-B2 this part of claim 1 includes features that are mentioned in claim 2 of the EP document. Both are also different from the originally filed claims in the EP-A1 document.

Q: What may be the reason for the different main claims? Compare the prior art cited by the respective examiners.

A: The American examiner has cited additional prior art (US1967438, US2935987, US3292634) that is not included in the EP citations. To check these citations either see the front page of the EP-B1 and the US-B2, or open the family in the CCD. It is therefore likely that the EP claims are not patentable because of this additional prior art. One of the additional documents most likely describes the feature that is in the characterizing part of EP-B1.

Unfortunately, there is no enriched search report for the US application that would permit the immediate identification of the relevant prior art. The main claim granted by the EP examiner comes from original claim 10. If the US search report was an enriched report it would permit to identify the prior art from which that feature is known.

Q: How do you proceed in case the application was also filed in your office, but on 20.6.2006 without claiming any priority?

A: The application was published for the first time as EP1702525A1 on 20.9.2006, i.e. after the filing date in your office. This publication is therefore not considered as prior art. It would be prior art only if it was published before the filing date in your office.

Some claims may therefore most likely be granted. As explained above, it is likely that the EP claims are not patentable because of the additional prior art of the US application. It is recommended to propose to the applicant to base his request on the claims granted by the USPTO.

Q: The following applications appear to cover the same invention: AU2007216620, CA2599199, MA30365, MY143938. Can a patent be granted?

A: These applications were found during the search for the technical family members in the exercises on patent families. They appear to cover the same invention like the US application (e.g., the AU and CA applications have the same drawings) but they do not claim the US priority. Therefore the respective application dates are relevant for determining the prior art. Since all these applications were filed in 2007 the EP or the US have to be considered as prior art. If the content of any one of the AU, CA, MA, MY applications were identical with the US application, a patent could not be granted because of a lack of novelty. If the content is different, i.e. additional technical features are described, then a patent could perhaps be granted, provided that the difference to the prior art known from [US7775218B2](#) could be considered as the result of an inventive step.

Q: As additional exercise you may check whether US2006207621A1 and AU2007216620 and CA2599199 are identical (PDF copies of these applications are accessible on Espacenet).

**Task 2: [WO9707818](#)**

Q: How many patents have been granted for the extended family? And how would you proceed?

A: There are 11 domestic families in the Inpadoc family but only Australia has granted a patent (AU726542B2). That should make you suspicious whether the AU examiner overlooked some prior art. Or else, examination may be still pending at the other IPOs; you need to check this.

For AU kind codes see, e.g., <http://www.patentlens.net/daisy/patentlens/3493.html>  
<http://pericles.ipaustralia.gov.au/ols/auspat/applicationDetails.do?applicationNo=1996068268>

Q: What is the examination status at the EPO and the USPTO?

A: For EPO, select the EP family member and click on the EP Register link. The application is deemed to be withdrawn. There have been numerous communications between the applicant and the examiner (to get a list, click on "all documents").

For USPTO, search the application number 09/731878 in US-PAIR (you can get this format of the application number from the front page of the US-A1 document). The application has been abandoned.

Q: How would you proceed in such a case if a family member was also filed with your office?

A: Check the prior art that was cited by the EPO and the USPTO and compare with prior art of the AU examiner. Most likely the AU examiner overlooked something. So it would not be advisable to grant a patent based on the AU claims. To get a proper picture you would need to read the examination reports of the EP and the US examiner to see their arguments.

**Task 3: [WO9834604](#)**

Q: How many domestic families are in the Inpadoc family and does the Inpadoc family include a granted patent?

A: There are 8 domestic families. Only the USPTO has granted a patent ([US6447801B1](#)).

Q: What is the legal status (examination status) of the EP application?

A: The application is deemed to be withdrawn.

Q: Which office established the ISR (the SR published with the WO-A1)

A: USPTO; the ISA is indicated in the lower left box of the ISR

Q: Is the prior art used by the EP examiner the same?

A: No, the EP examiner has identified additional prior art (US5173303 and NPL publication XP002910730). That may be the reason why the EPO has refused to grant a patent. To see the prior art applied by the EP examiner you have to click either on "cited documents" in the left hand menu of the EP family member [EP0963198](#) or you have to open the link to the European register which you find in the row above the title of the bibliographic data view of [EP0963198](#). There is no PDF EP-A1 publication including a search report.

Q: How would you proceed in such a case?

A: In such a case one should not easily grant a patent based on the claims granted by the USPTO. Instead, one would need to check why the EPO and the other offices did not grant a patent, in particular whether the additional prior art played an important role in the examination.

Q: Can you view the examination reports? Did the EPO examiner examine a claim worded similarly to the US main claim?

A: Yes, you can read, e.g., all communications between the EPO examiner and the applicant when you open the application in the EP Register ([EP0963198](#)) and click on "All documents". Examination reports are usually termed "Annex to Communication". E.g., the last report issued on 24.10.2007 (which is not the first examination report!) acknowledges novelty of the claim subject matter but denies an inventive step. Note that this report does not address the initially filed claims but amended claims filed on 14.6.2007. There are also earlier reports on other claim versions.

This exercise cannot give a clear recommendation how to proceed, in particular as the application pending at the EPO was not rejected but deemed to be withdrawn because the applicant failed to reply in time to the examination report. As such it is not clear whether the EPO examiner would have finally granted some main claim with amended wording. However, the main claim granted by the USPTO is almost identical to claim 17 as filed on 14.6.2007 for which the EPO examiner declined an inventive step. As such, one would need to very carefully examine the EPO reasoning before granting this particular claim.

Q: The EPO examiner cited the non patent literature document XP002910730 which you can search in Espacenet? Why can't you view the full document?

A: Because it is a copyright protected article in a scientific journal. Patent publications can be viewed in full because they are not copyright protected.

Q: Is the US patent still in force?

A: Yes, see US-PAIR.

Q: Can you view the US examination reports?

A: No, the examination was conducted in a time period of which US-PAIR does not include file wrapper documents, only the date of events are recorded. For all currently cases pending at the USPTO, reports are accessible.

#### **Task 4:** [WO2011152795](#)

Q: How many and which offices have granted patents?

A: There are 11 members in the extended family, and there are AU-B2, EP-B1, and JP-B2 publications which are publications of grants according to their kind codes.

Q: Compare the main claims granted by the respective offices. Are they substantially different? Which one would you consider more suitable?

A: To view the claims that were granted you have to open the original PDF document of each B1/B2 publication. Please note, when you click on the 'claims' link in the left hand menu of Espacenet, you only get the claims published with the unexamined applications (EP-A1, AU). The claims granted by EP and AU are quite similar, the EP claims being slightly more precise, and therefore perhaps more suitable. The JP claims are not available in English. Machine translation of those claims may not be of sufficient quality to compare those claims with the EP and AU claims. Since several examiners have worked on different national phase entries, and, in particular, since the JP and the EP examiners have apparently conducted an additional search and identified also additional prior art (see the question below), it appears that the application includes patentable subject matter. As a further safeguard one might await the results of the pending US examination (see the question below).

Q: Compare the prior art considered by the different examiners? Is it the same? Is it different from the ISR? Which ISA prepared the ISR? What is the easiest way to compare citations by different examiners?

A: The easiest way to compare prior art cited by each examiner is by opening the application in the CCD by clicking on the link 'CCD' on the page showing the extended family. By comparing the citations, e.g. on the front page of the AU-B2 and EP-B1 publications you will see, that the CCD reflects those citations considered by the examiners. They are different, however. AU cites only 3 documents that were already cited in the ISR (WO-A1, which was prepared by AU) while EP cites additional documents which were not cited in the ISR, including JP publications. Citations from JPO are also included in CCD but they are again different from the EPO citations. In summary, the examination in national phases has identified additional relevant prior art which was not yet covered by the PCT ISR.

Q: What is the status at the USPTO?

A: You can search, e.g., for the application number 13/143107, the publication number US 2013-0106304 A1 (no other format is accepted), or PCT/SG10/00212 as PCT number. Examination is pending; no examination report has yet been sent to the applicant. That is why the CCD does not yet show and citations for the US family member.

Q: This application was also filed in Cambodia without claiming any priority; filing date is 5.12.2012. What would you do?

A: The [CA2746380A1](#) is the earliest publication of the family and was published on 4.12.2011. Since it was published before the filing date in Cambodia it is relevant prior art and a patent cannot be granted because of a lack of novelty.

#### **Task 5:** [WO2008025203](#)

Q: How many and which offices have granted patents?

A: There are 11 members in the extended family, and there are AU-B2, JP-B2, RU-C2/C9, US-B2 publications which are publications of grants according to their kind codes.

Q: Which ISA prepared the ISR? Check the ISR for X, Y documents, and the perspectives that some claims may be granted. Which keywords were used by Ms/Mr Zhao?

A: The ISA was CIPO, the Chinese IPO. Since there are no X, only Y and A something may perhaps be granted, in particular since for claims 2 and 3 it appears that 3 documents are needed for questioning the inventive step. In part B some keywords are listed.

Q: When you open the link 'cited documents' for the WO family member, does the list of citations include X, Y, A,... indicators, i.e. is the list 'enriched' like the ISR? What about the list of citations in the EP-Register, and in the CCD?

A: No, for 'cited documents, the list of citations is not enriched. In the CCD it is enriched, in EP-Register

Q: At first, it appears that some claims can be granted. However, the EPO has not granted anything yet. Check the examination status. Check the latest actions, and the view of the EP examiner.

A: Open EP-Register. Examination is pending at the EPO. The last written opinion was communicated on 4.4.2013, and denies novelty of an amended main claim filed on 5.2.2013. The EP examiner introduced 2 new documents during examination.

Q: Is there an English language equivalent for the new German prior art document DE3122547? Can you use it without German language skills?

A: No, there is no other family member in English. The EP opinion is in English. You can utilize the EP explanations in the opinion. You can also use the machine translation for the description and claims.

Q: What would you do?

A: Because of the additional prior art, it is not suggested to grant any claims that were granted by any of the other IPOs. Wait for the progress of the EP examination; or utilize the additional prior art to come to your own conclusion..

Q: This application was also filed in Cambodia without claiming any priority; filing date is 12.3.2013. What would you do?

A: The family member NZ575658 was already published on 26.8.2011, i.e. almost 2 years before the filing date. Therefore a patent cannot be granted because of a lack of novelty.