

Topic 13: Utilizing Claims of Granted Patents

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Colombo 16 February 2016

Agenda

- Retrieval options
- Issues
- Standardized procedures
 - Patent Prosecution Highway
 - Validation

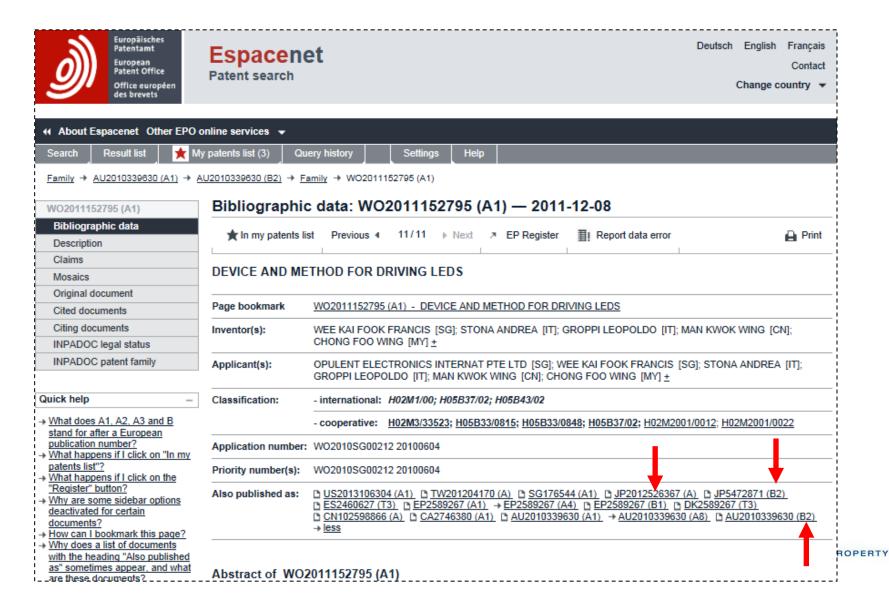


Retrieval options

- Publications of granted patents
 - Can easily be identified by kind codes (B1, B2, C1, C2,..) of domestic family members
 - Use PDFs of granted patents: they represent the official publications
 - Check if opposition was filed, and is pending or was settled by
 - Maintaining the patent
 - Revoking the patent
 - Restricting the patent: New publication of restricted claims
- File wrapper: e.g., for cases where examiner was ready to grant but applicant abandoned application nevertheless

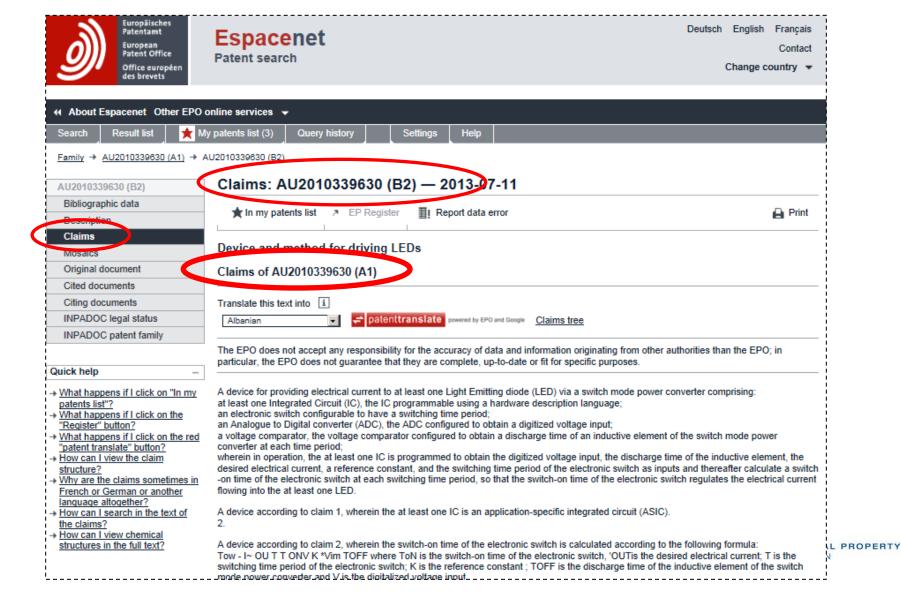


Espacenet retrieval

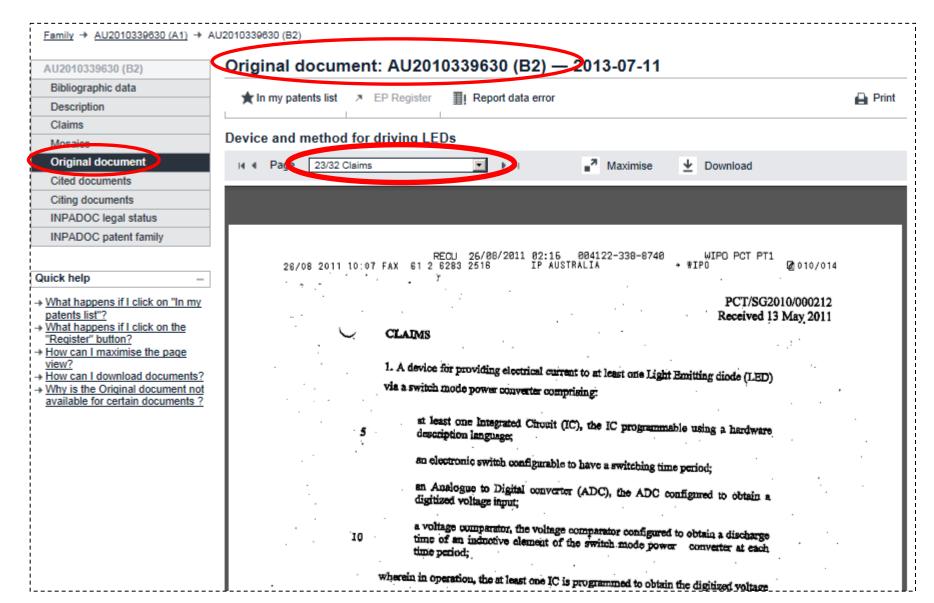


Espacenet retrieval - claims

WO2011152795



Espacenet retrieval



- Claims granted by different offices for 'same' invention are often quite different
 - Substantial differences
 - Totally different subject matter of independent claims
 - Some elements/features are different, i.e. some may be missing or others included
 - Non-substantial differences
 - One/two part claims where all features are present and only listed in different order
 - Wording is basically similar but uses synonymous/equivalent expressions
 - Additional or missing reference numerals



Claims

WO2011107527

1. Thread or stripe, preferably for the incorporation into or onto a value-document or currency substrate, comprising a plastic foil which carries a hardened coating comprising oriented magnetic or magnetizable pigment particles, the orientation of said pigment particles representing graphic information, the security thread or stripe being **characterized in that** said graphic information is a repetitive seamless pattern of suitable repetition length.



AU2011223000B2

Thread or stripe, comprising at least one plastic foil which carries a hardened coating comprising oriented magnetic or magnetizable pigment particles, the orientation of said pigment particles representing graphic information, the security thread or stripe being **characterized in that** said graphic information is a repetitive seamless pattern of suitable repetition length.



EP2542417B1

1. Security thread or stripe, preferably for the incorporation into or onto a value-document or currency substrate, comprising a first plastic foil which carries a first imprinting comprising oriented magnetic or magnetizable pigment particles, the orientation of said pigment particles representing graphic information, wherein said graphic information is a repetitive seamless pattern of suitable repetition length, the security thread or stripe being characterized in that said first imprinting is a hardened structured coating in the form of indicia.



US9216605B1

The invention claimed is:

- 1. A method for producing a security thread or stripe for incorporation into or onto a value document or a currency substrate, comprising:
 - coating a plastic foil with a coating composition comprising optically variable magnetic or magnetizable pigment particles;
 - orienting the magnetic or magnetizable pigment particles to represent graphic information;
 - hardening the oriented magnetic or magnetizable pigment particles coating to fix the magnetic or magnetizable pigment particles in their respective positions and orientations; and
 - slicing the plastic foil with the hardened into threads or stripes;
 - wherein the graphic information is produced with a magnetic orienting cylinder having a seamless and continuous repetitive magnetic field pattern having a repetition length.



Reasons for substantial differences

- Patents do not belong to same simple family, i.e. applicants have sought protection for different subject matter (e.g. continuations/divisions)
- Examiners may have applied different prior art
 - Different prior art searches, i.e. prior art documents
 - Different priority dates applied
- Differences in national legislation (exclusions) or case law
- Individual examiner's views



Checklist for using granted claims

- Research the simple family information and check for grants; if there are none, check the extended family.
- How many offices have granted a patent? Several, or just one?
 - If several, it is more likely that there is indeed patentable subject matter
 - However, they may have simply adopted the previous work of others; that would reduce the confidence somehow. Are there indications for that in the files?

ELLECTUAL PROPERTY

- In case of just one grant, try to confirm how thoroughly the search was done; check what the status is at other IPOs.
- Has any office rejected the application? Was any application withdrawn?
 - Check the prior art used by this examiner; did he/she find additional prior art?

Checklist for using granted claims

- Compare claims if several IPOs granted patents:
 - Are they consistent?
 - Are there substantial differences?
 - If so, compare prior art considered by the examiners
 - If prior art is not different, check the opinion of the examiner who granted more restricted claims; the examiner may have a valid argument, which the others overlooked.
 - Can the differences be explained by different national practices?
- Are the grants effective, or is opposition or appeal pending?
- Are the claims compatible with your law, in particular with exclusions?
- Carefully check whether claimed priorities are valid in your jurisdictions and whether they were considered valid by the other IPO



Differences of national patent legislations

- Basic categories of requirements are the same in most jurisdictions (unity, novelty, inventive step, technical nature, sufficient disclosure)
- Some differences exist in how the term "invention" or "patentable invention" is defined (positively, negatively)
- Differences, however exist mostly in terms of exclusions, e.g.
 - US do grant business methods, software patents,...
 - DE/EP grants new use of known compound, PK does not,...
 - Islamic countries exclude, e.g., inventions related to pork
 - Temporary exclusions in Myanmar: Section 8 (b)
- For analysis, see e.g. SCP studies on WIPO website:

http://www.wipo.int/edocs/mdocs/scp/en/scp_13/scp_13_3.pdf



Procedural principles

Principle of party disposition

Applicant determines beginning, end and extent of proceedings through requests

Applicant's requests determine the extent of each proceeding

- Binding effect for examiner as to content and sequence of requests, e.g. examiner can grant only claims with wording that the applicant requests
- Examiner to decide either "Yes" or "No"
- Examiner cannot amend and grant the application without the consent of the applicant



Fundamental procedural principle

- Right to be heard, fair trial
 - Guaranteed by constitution, international treaties, European Human Rights Charta,..
 - Adverse decisions like a rejection can only be based on reasons that
 - were previously communicated to applicant, and
 - if he has had an opportunity to respond to it (it is not necessary that he did respond)
- You can grant claims only if the applicant has given his consent!
- You can reject only, if you have informed the applicant of the reasons and grounds of rejection, e.g. you cannot introduce new prior art in your rejection decision!



Patent Prosecution Highway PPH

- JPO initiative to accelerate granting in case of grants at other IPOs, in case 'Office of Earlier Examination' has determined allowable / patentable subject-matter
- Bilateral agreements between IPOs
- Commitment to prioritize/accelerate examination in case of grant at other IPO
- No obligation to adopt claims/conclusions
- Accelerated examination has to be requested by applicant
- Condition: applicant submits identical claims that were granted



Validation

- EPC validation:
 - EPO grants patents
 - Patents are then "validated" in designated member countries, i.e. they become national patents
- EPO now concludes bilateral validation agreements with jurisdictions not being members of the EPC (e.g. Morocco, Tunisia, {OAPI})
- Morocco: entry into force on March 1, 2015
- Designation as extension countries in EPO application, therefore no need to file separate application > applicant driven
- Not possible retroactively for pending applications
- Requires harmonization of national laws with EPC
- Validating EPO decision includes effective adoption of case law as well

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Validation

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Thank you

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