



Challenges and Options in Patent Examination

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Agenda

- Challenges
- Elements of patent prosecution
- Options for substantive examination and implementation of patent prosecution
- WIPO's ICE service

Different categories of IPOs

Expertise

- IPOs just **embarking on patent prosecution** (e.g. Bahrain, Oman, Bhutan, Cambodia, Kuwait...)
- IPOs having **established patent prosecution** ("emerging Offices"; e.g. Jordan, Malaysia, Viet Nam,...)

Size

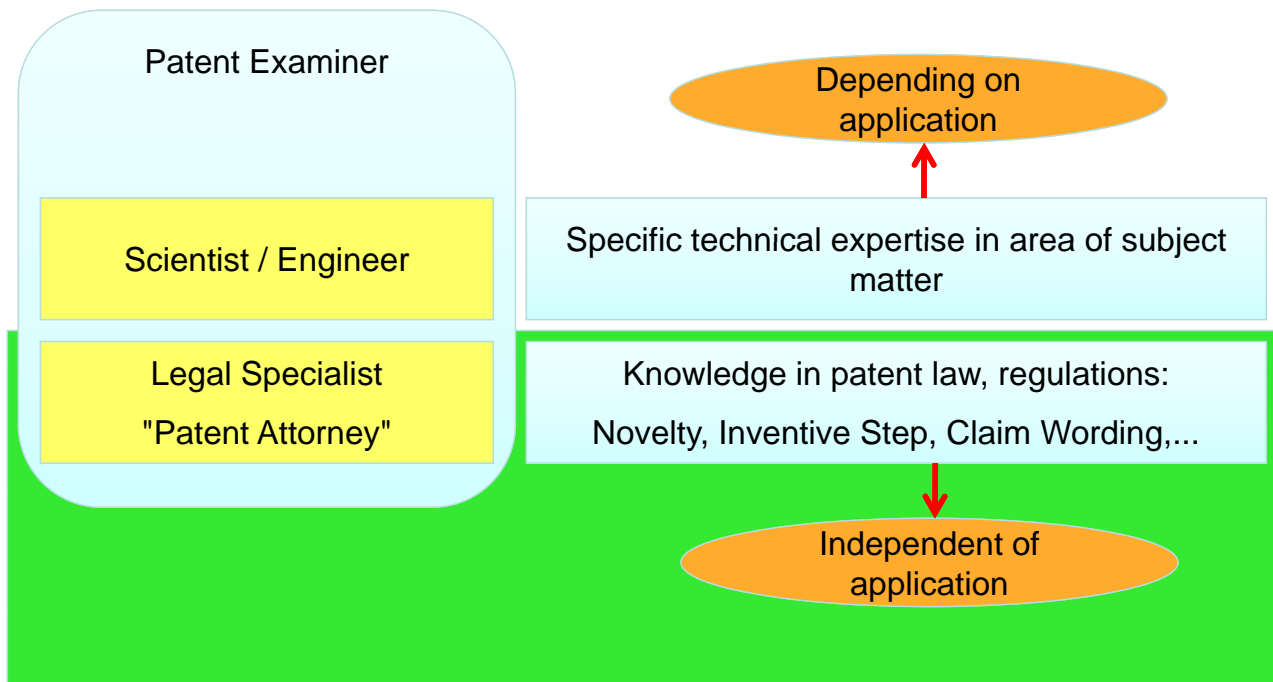
- **Small IPOs** with very few examiners (e.g. Bahrain, Oman, Bhutan, Jordan, Syria, Kuwait) and the capacity to **cover very few areas of technology**
- **Medium size IPOs** with the capacity to **cover some but not all areas of technology**

IPO's challenges

- Efficient patent prosecution procedures for
 - **foreign** (including PCT) and
 - **truly national** patent applicationswith **limited resources** (e.g. legal and technical expertise of staff, access to databases..)
- Avoid duplication of work, exploit work/results of other IPOs where available

> topic of this workshop

Required examiner capacities



Legal basis of substantive examination

- ▶ Patent law
- ▶ Patent rules/regulations

require interpretation

- ▶ Case law (interpretation by court rulings)
- ▶ Examination guidelines (referring to essential CL)

e.g. German Guidelines

http://www.dpma.de/docs/service/formulare_eng/patent_eng/4/p2796_1.pdf

Types of patent applications filed at IPO

■ Truly national first filing

- second filing abroad is possible, i.e. application may become member of **patent family**

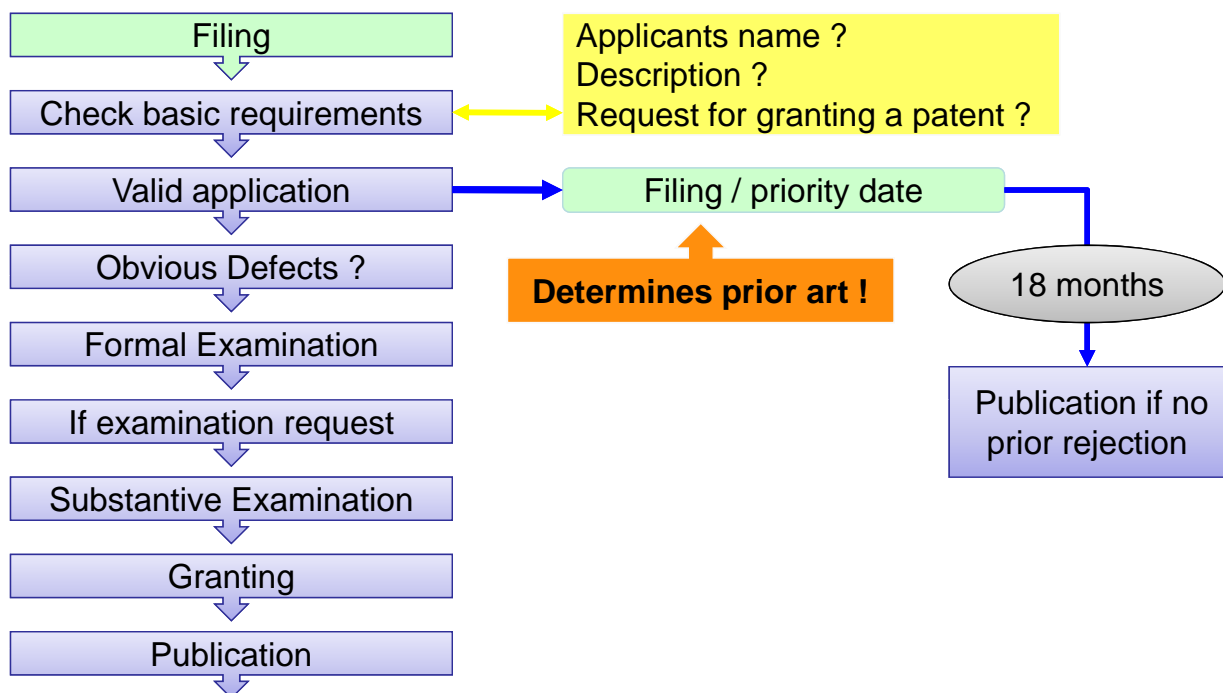
■ PCT national phase entries

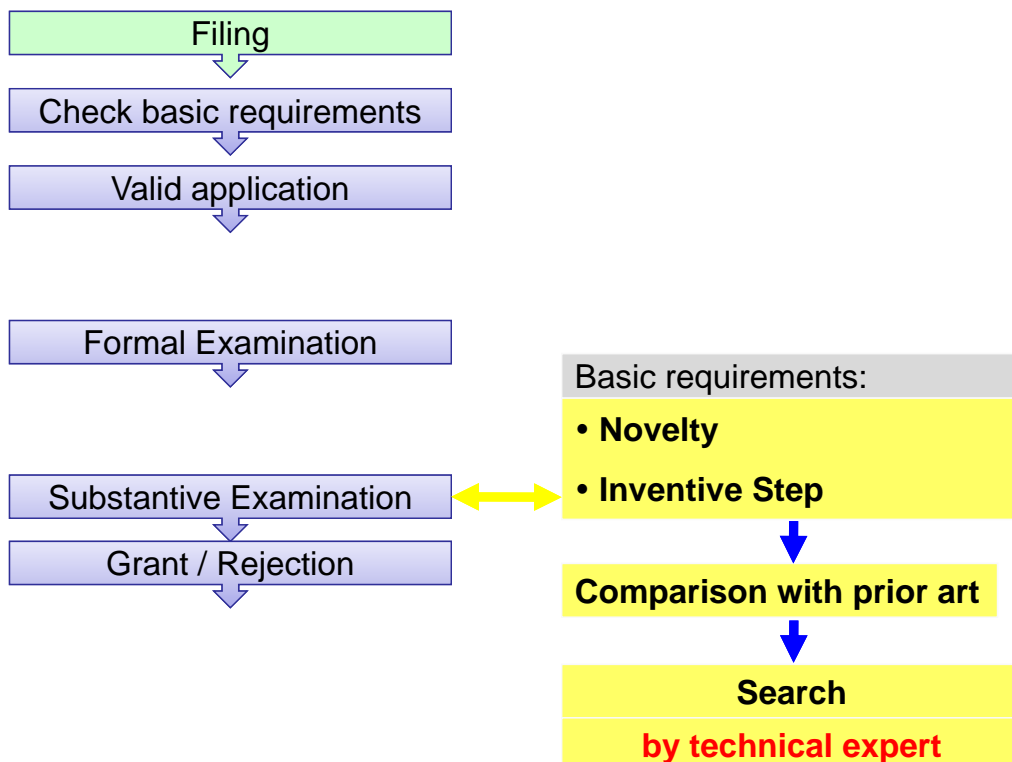
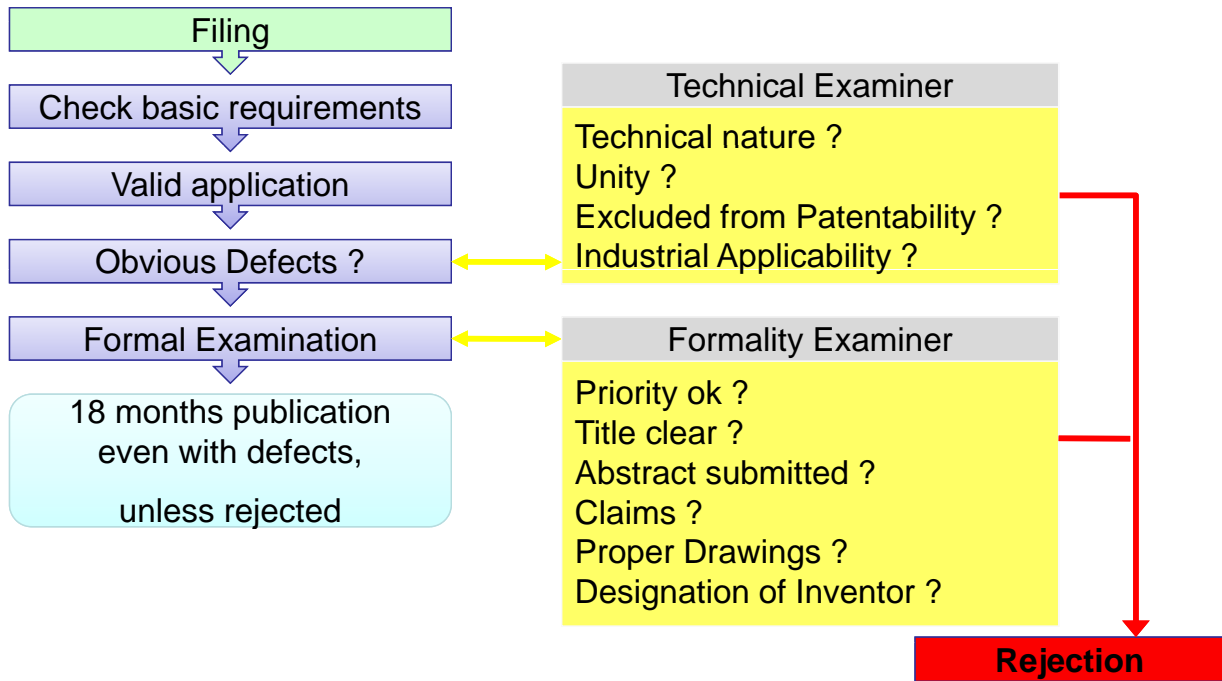
- application is member of **patent family**

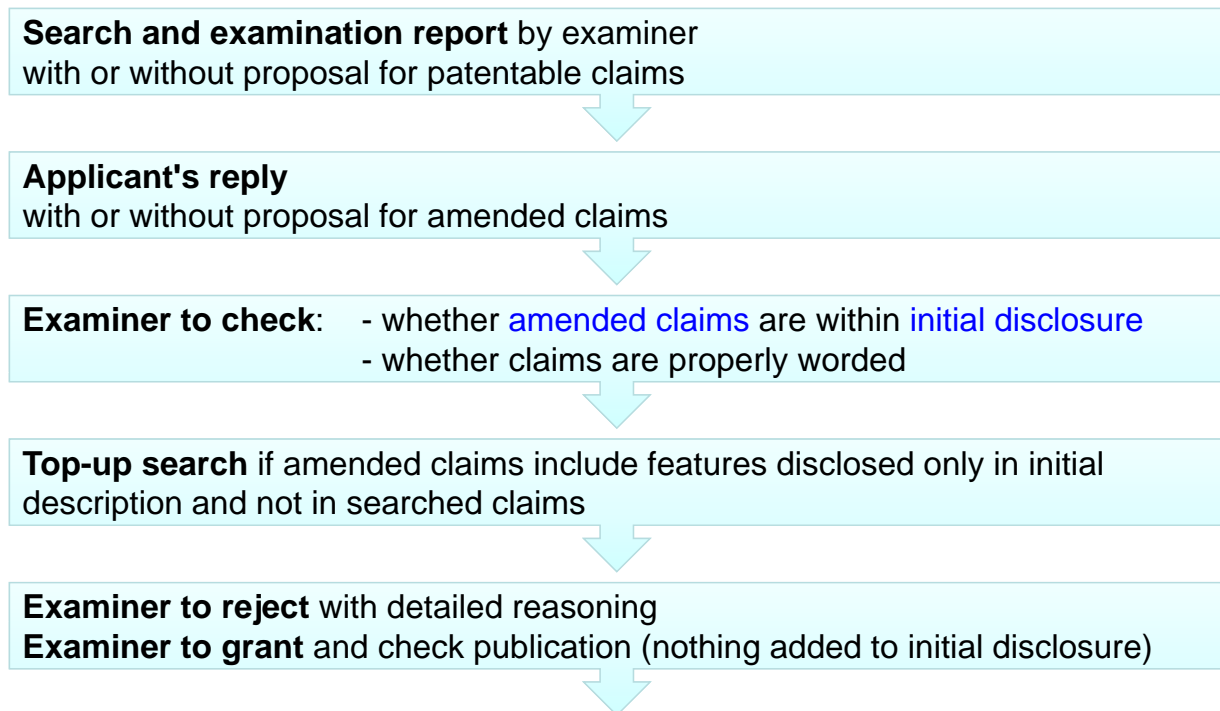
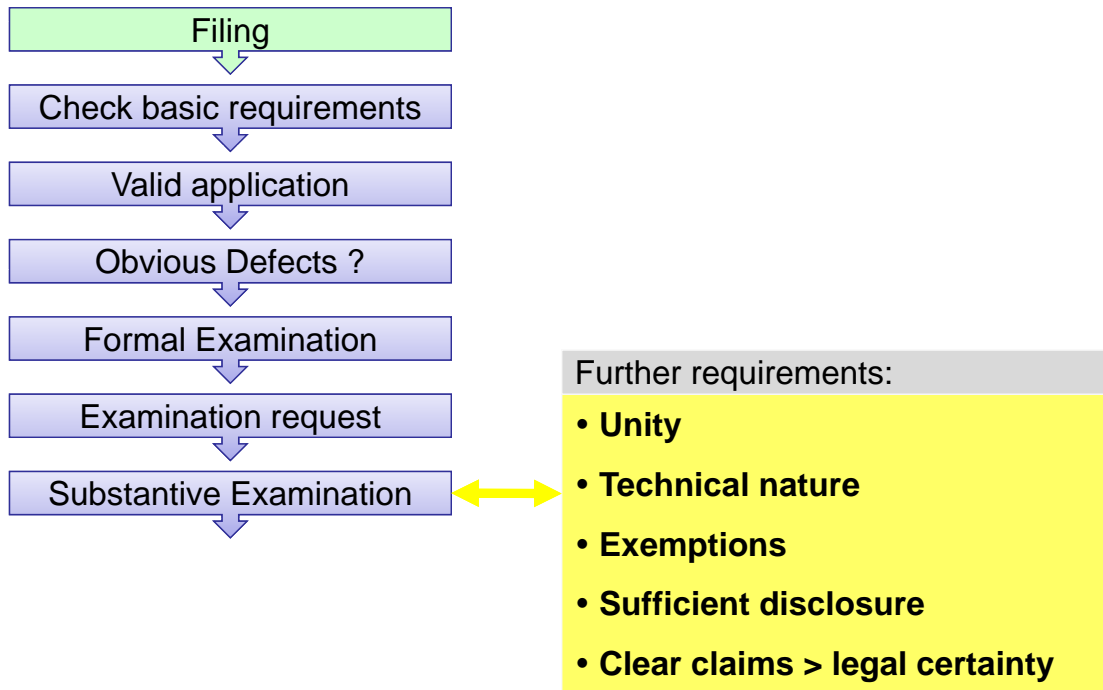
■ non-PCT foreign filings (second filings)

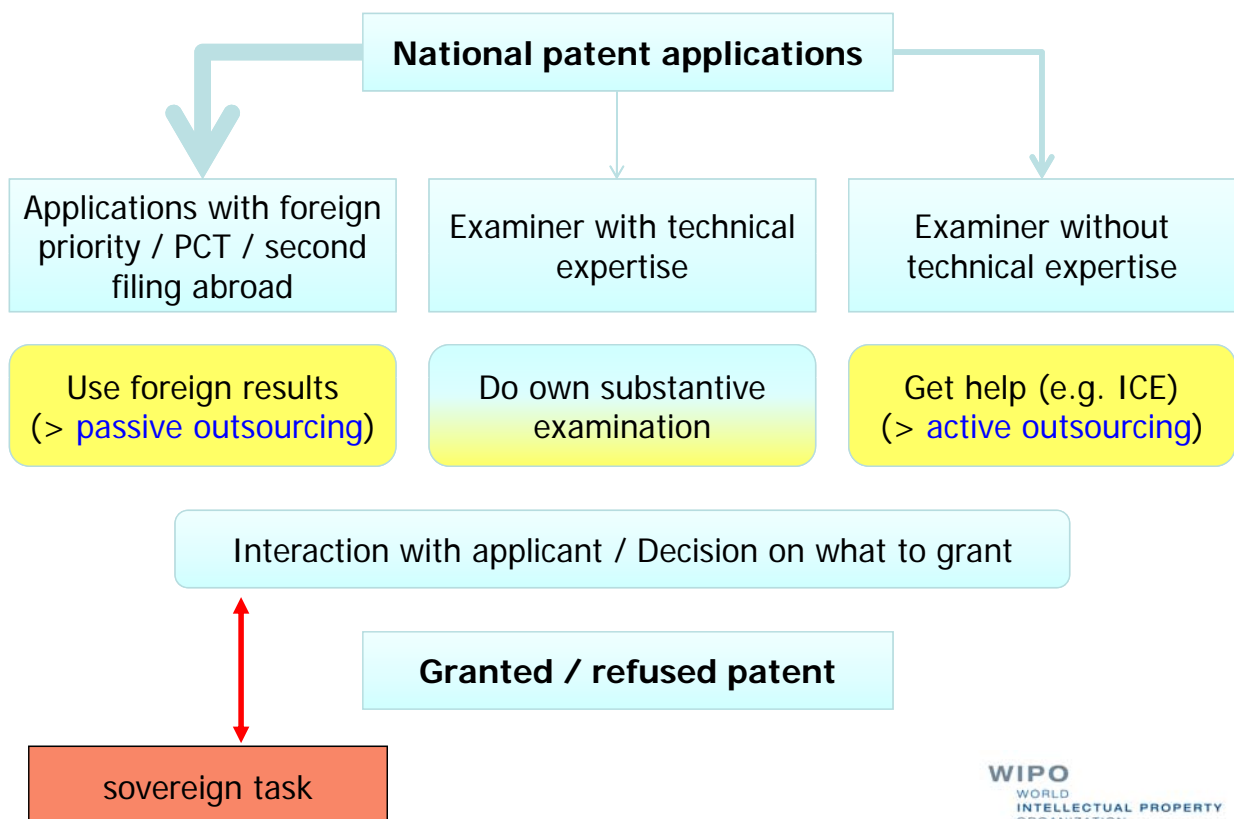
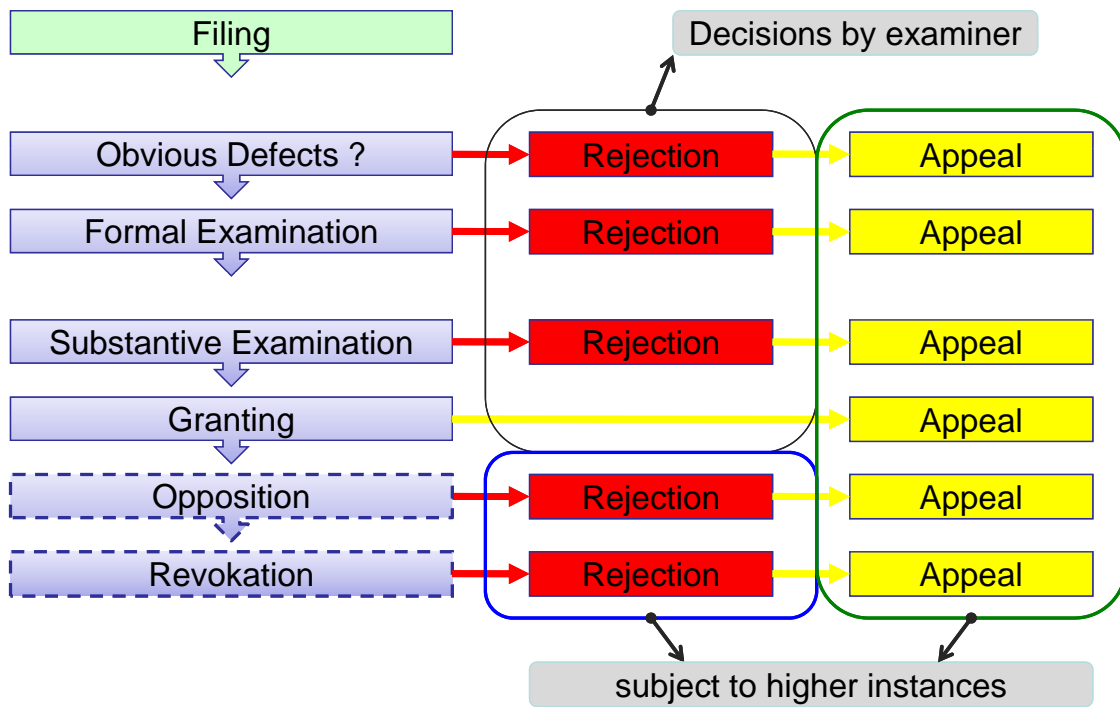
- priority claimed, i.e. is member of (Paris) **patent family**
- priority not claimed:
 - > "**technical**" family because same invention

> Topic 2: Patent families









National sovereignty

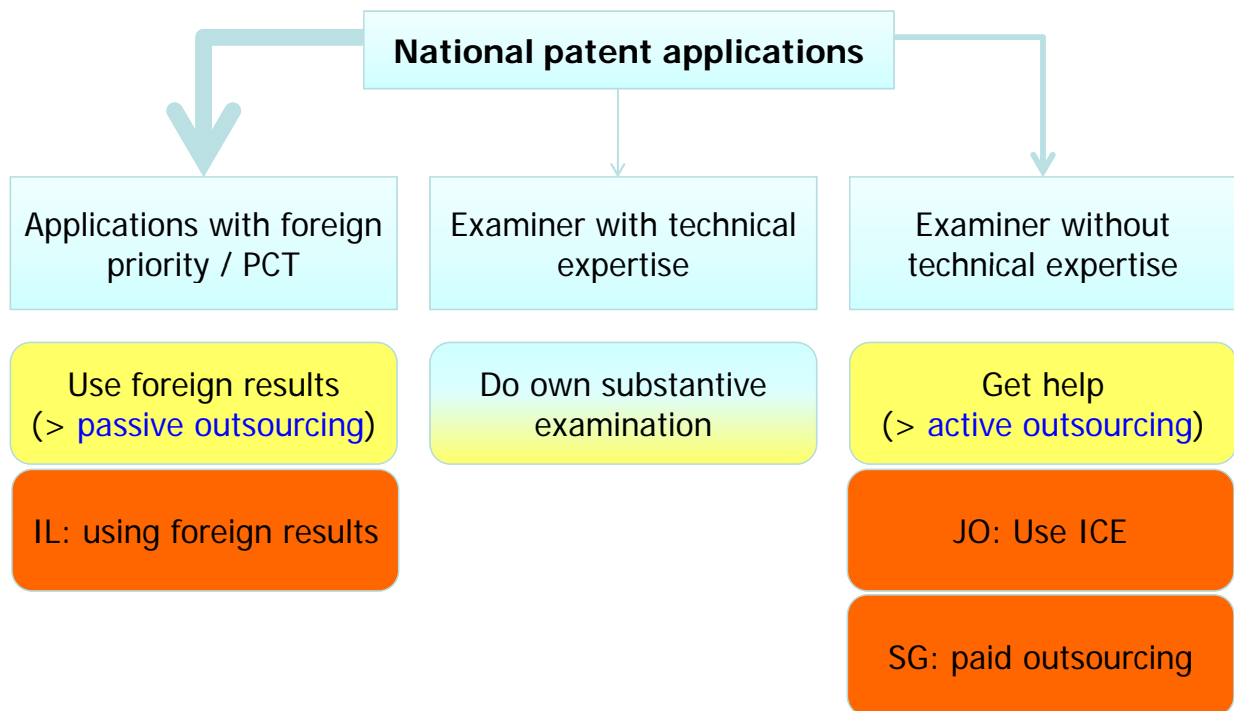
Paris Convention:

- **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

Global Symposium IP Authorities 2010

- Discussion on challenges in substantive examination
- http://www.wipo.int/meetings/en/2010/symp_ip_auth/program.html
- Three samples: Singapore, Jordan, Israel

Options for substantive examination



Example: Singapore

- Outsourcing of S&E for a fee to other IPOs (AU, AT, HU, DK) for "local route"
- For all types of applications, including PCT national phase entries
- Outsourced examination based on SG patent law and regulations
- Self-assessment by applicant based on examination report (currently under review)
- Similar outsourcing by GCC, UAE, ...

Example: Israel

- Law explicitly authorizes that the granting decision is based on granting decisions of selected offices (e.g. US, EP, DE), if
 - applicant requests so
 - claims are identical

- Law authorizes the Registrar to proceed differently
- Applied to only 20% of possible cases

Example: Jordan

- Two track system:
 - foreign results available and usable:
 - > wait for availability of final results

 - foreign results unavailable or not usable:
 - submit request to WIPO's ICE service
 - preliminary examination prior to submission (claim quality,...)

Patent prosecution – options

Option 1

▶ Doing full substantive examination (search, examination, granting), in all or some areas of technology

Option 2

▶ Outsourcing full search&examination

Patent prosecution – option 3

- ▶ Rely fully on **grants/rejections** of other IPOs
 - possible for PCT, foreign priorities, including technical families
 - not possible for truly national filings, unless in case of second filing abroad
 - requires identical claims & cooperative applicants
 - requires claims compatible with national law
 - implies considerable delay because final results have to become available

Patent prosecution – option 4

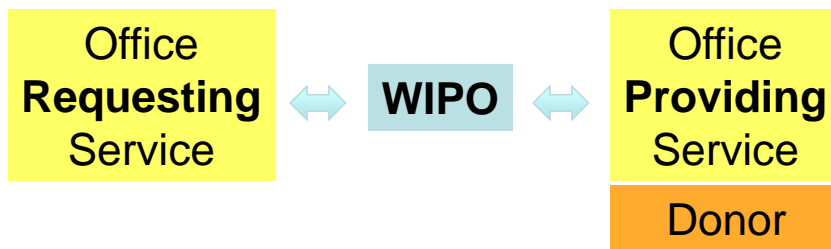
- ▶ Use only **S&E results**, e.g. search reports, i.e. **not** the final results, of other IPOs, e.g. via ICE, ASPEC, AIPN, PPH, other regional cooperations:
 - possible for national filings (through ICE)
 - possible also for PCT, foreign priorities
 - implies some but smaller delay than option 3

Summary of challenges for options 3&4 (&2)

- Technical expertise of examiners
- Legal expertise
- Claim drafting/wording
- Retrieving results of other IPO
- Exploiting in national context the external
 - Search/examination reports
 - Final results, e.g. grants
- Rejection rulings
- (Opposition/appeals)

WIPO's ICE service

- ICE provides search and examination reports, **free of charge**, upon request by national Intellectual Property Office (IPO) of developing countries
- WIPO acts mainly as "agent"



- Reports done by "donor offices" with expertise
- Option for cases without external results

Options for redesigned ICE

- ▶ Covering full patent prosecution beyond just one set of search and examination reports:
 - Top-up searches for amended claims
 - Examination reports for amended claims
 - Rejections
 - Opposition, invalidation, revocation
 - Inclusion of PCT national phase (ideally done by ISA examiner)

Thank you

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