

Interpreting and Utilizing Search and Examination Reports

WIPO Sub-Regional Workshop, Kuala Lumpur, Malaysia
29.11.-01.12.2011

Steffen Wolf, European Patent Office, Munich, Germany



Work-sharing: Information that can be utilised

- **Search reports**

- Citations
- Document categories e.g. X, Y, A
- Relevant passages of citations
- Claims for which documents are cited
- Classification information

- **Written opinions / Grants / Refusals / Oral Proceedings**

- Patentability objections e.g. novelty, inventive step, clarity, unity
- Interpretation of cited documents

- **Documents with related subject-matter**

- Relevant cited and citing documents
- Top-up search before grant

- **Search strategies - if available**

- Elaborate and complement search queries

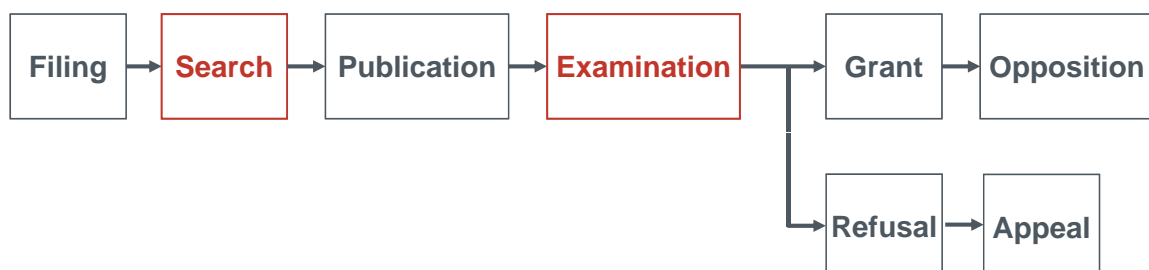
Overview

- **European Procedure**
- European Search Procedure
- European Examination Procedure



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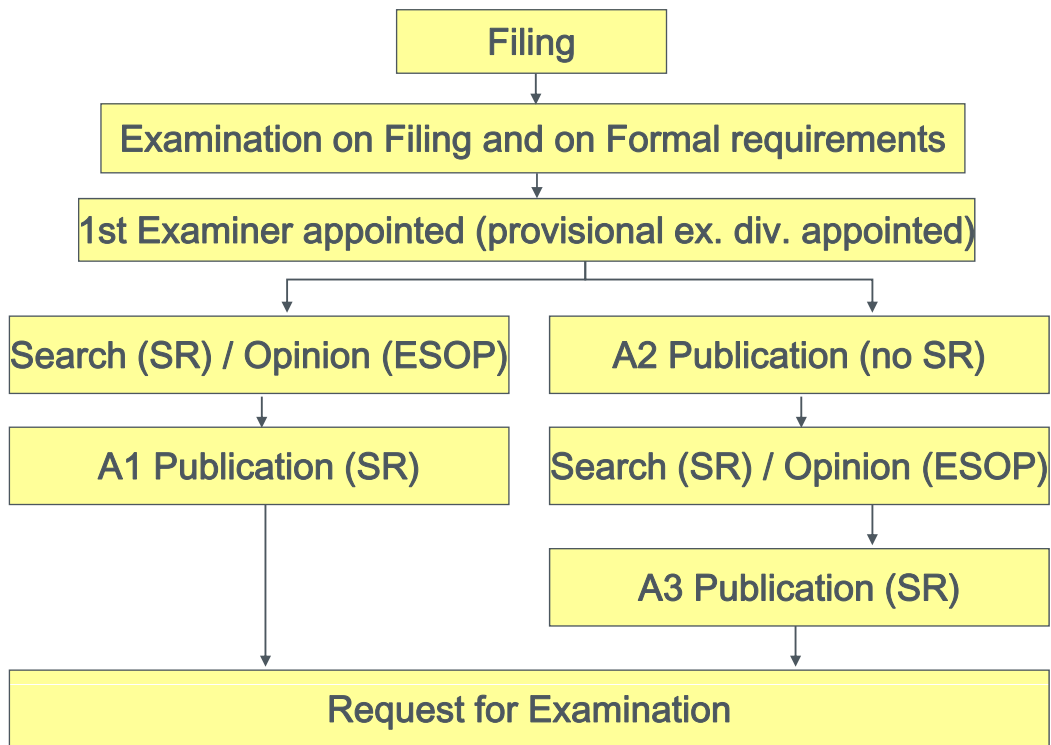
The European procedure



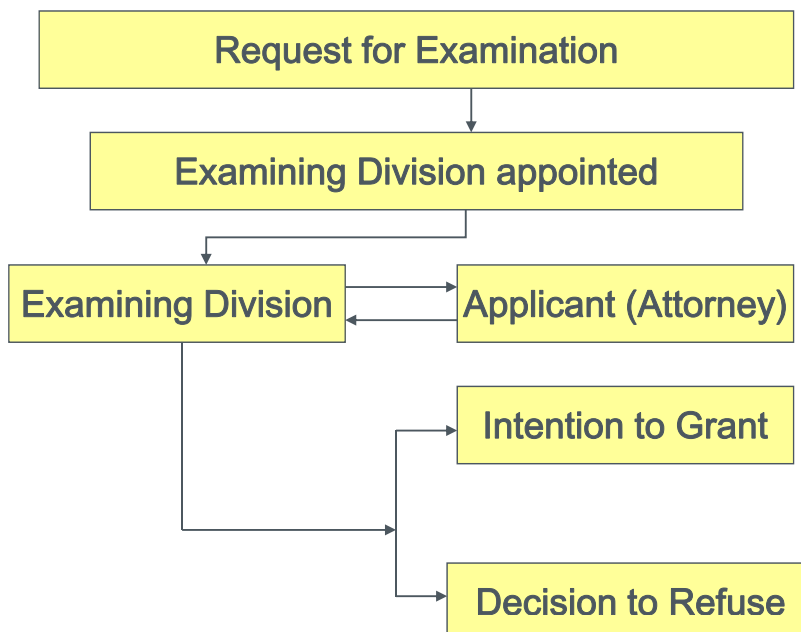
Within the legal framework defined by the **European Patent Convention**

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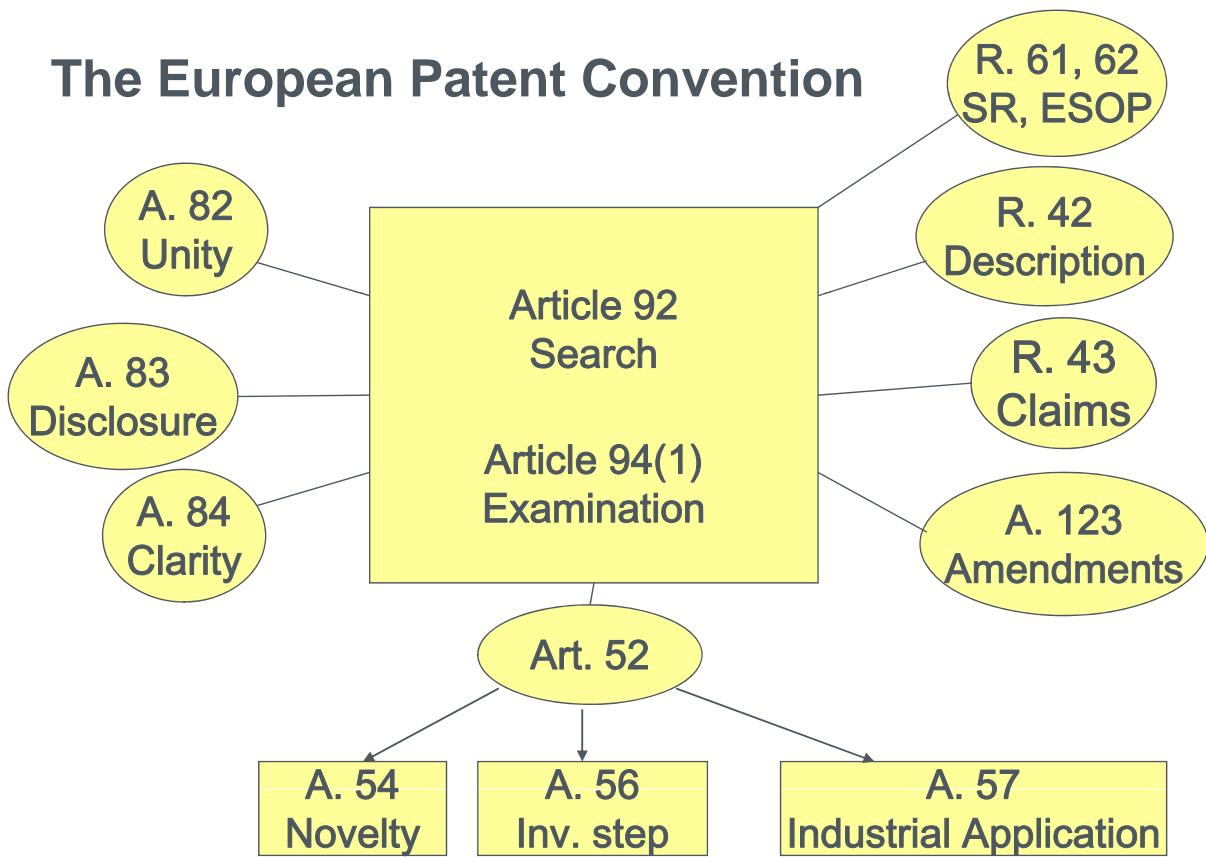
Overview of the Search Procedure



Overview of the Examination Procedure



The European Patent Convention



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Overview

- European Procedure
- **European Search Procedure**
- European Examination Procedure



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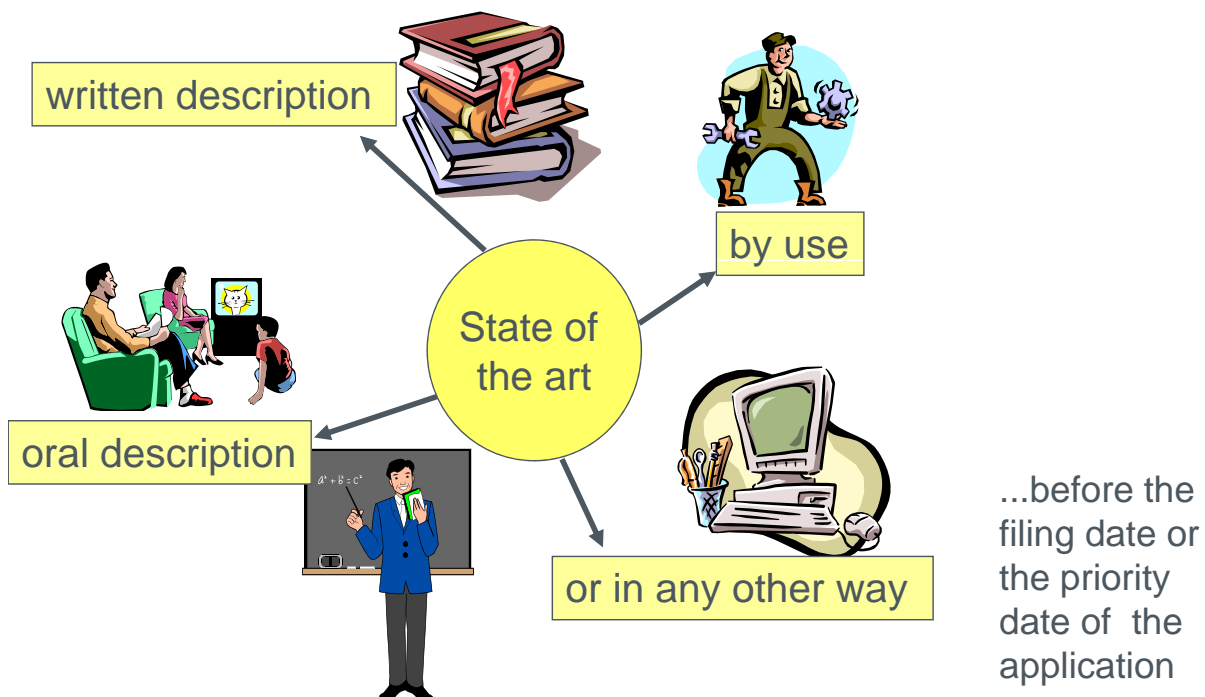
The Search Report

- **Rule 61 EPC** : Content of the European search report
(1) The European search report shall mention those **documents**, [...] which may be taken into consideration in deciding whether the invention [...] is **new** and involves an **inventive step**.
- **Rule 43.5 PCT** : Citations
(a) The international search report shall contain the citations of the **documents** considered to be **relevant**.
- Additionally, the Search Report in EP and PCT contain information about the classification, the fields searched, etc.

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State of the Art

Everything made available to the public by means of ...



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The Search Report



EUROPEAN SEARCH REPORT

Application Number
EP 09 16 8955

Application number

DOCUMENTS CONSIDERED TO BE RELEVANT			
Category	Citation of document with indication, where appropriate, of relevant passages	Relevant to claim	CLASSIFICATION OF THE APPLICATION (IPC)
X	EP 0 813 338 A2 (ROCKWELL INTERNATIONAL CORP [US]) 17 December 1997 (1997-12-17) * column 6, line 12 - column 8, line 26 * * column 8, line 52 - column 9, line 4; figure 1 *	1-13	INV. G01T1/17
Y	US 6 128 039 A (CHEN DATONG [US] ET AL.) 3 October 2000 (2000-10-03) * column 3, line 57 - column 4, line 28; figure 2 *	1, 3-7	
Y	US 6 163 029 A (YAMADA SHINICHI [JP] ET AL.) 19 December 2000 (2000-12-19) * column 15, line 30 - column 16, line 45; figures 2, 15, 16 *	1, 3-7	
A	FR 2 864 628 A1 (COMMISSARIAT ENERGIE ATOMIQUE [FR]) 1 July 2005 (2005-07-01) * page 4, line 18 - page 6, line 15; figure 3 *	1-13	
A,D	WO 2004/064168 A1 (SCHERRER INST PAUL [CH]; BROENIMANN CHRISTIAN [CH]; SCHMITT BERND [CH]) 29 July 2004 (2004-07-29) * the whole document *	1-13	TECHNICAL FIELDS SEARCHED (IPC) G01T
E	WO 2009/131151 A1 (HAMAMATSU PHOTONICS KK [JP]; MORI HARUICHI [JP]; KYUSHIMA RYUJI [JP];) 29 October 2009 (2009-10-29) * figure 12 *	1	
The present search report has been drawn up for all claims			
Place of search The Hague		Date of completion of the search 23 March 2010	Examiner Wuveryck, J
<p>CATEGORY OF CITED DOCUMENTS</p> <p>X: particularly relevant if taken alone Y: particularly relevant if combined with another document of the same category A: technological background O: non-written disclosure P: intermediate document</p> <p>T: theory or principle underlying the invention E: earlier patent document, but published on, or after the filing date D: document cited in the application L: document cited for other reasons S: member of the same patent family, corresponding document</p>			

International Patent Classification

Category X, Y, A, etc.

Relevant to Claim ...

Cited documents

Technical Fields Searched

Place of Search

Date of Completion of the Search

Examiner

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Categories of Citations

- **X** - particularly relevant if taken alone
Objection: Lack of novelty or lack of inventive step with one document
- **Y** - particularly relevant if combined with another Y-document
Objection: Lack of inventive step by combination of two (or more) documents, always in pairs
- **A** - Technological background, no objection of lack of novelty or inv. step
- **O** - Non-written (e.g. oral) disclosure
- **P** - intermediate document, published after priority date but before filing date of the application; used in combination with X, Y, A (e.g. XP)
- **T** - Theory or principle underlying the invention
- **E** - Earlier patent document, but published on, or after the filing date
- **D** - cited in the application
- **L** - cited for other reasons

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EUROPEAN SEARCH REPORT



European Patent Office

EUROPEAN SEARCH REPORT

Application Number
EP 07 12 3554

DOCUMENTS CONSIDERED TO BE RELEVANT		Relevant to claim	CLASSIFICATION OF THE APPLICATION (IPC)
X	US 5 754 386 A (BARBOUR ERSKINE [US] ET AL) 19 May 1998 (1998-05-19) * column 11, line 55 - line 67 * * column 13, line 12 - column 14, line 38 * * figures *	1	INV. H01H7/124 H01H7/12 H01F7/18
X	DE 100 67 360 A1 (CICHMONT AG [DE]) 23 May 2001 (2001-05-23) * the whole document *	1	
A	EP 1 009 803 A1 (SCHNEIDER ELECTRIC IND SA [FR] SCHNEIDER ELECTRIC IND SAS [FR]) 14 June 2000 (2000-06-14) * the whole document *	1	
			TECHNICAL FIELDS SEARCHED (IPC)
			H01H H01F
The present search report has been drawn up for all claims			
Place of search	Date of completion of the search	Examiner	
Munich	1 July 2008	Ramirez Fueyo, M	
<p>CATEGORY OF CITED DOCUMENTS</p> <p>X: particularly relevant if taken alone Y: particularly relevant if combined with another document of the same category A: technological background P: prior art document</p> <p>T: theory or principle underlying the invention E: earlier patent document, but published on or after the filing date D: document cited for other reasons L: document cited for other reasons A: document of the same priority/filing/continuation document</p>			

INTERNATIONAL SEARCH REPORT

INTERNATIONAL SEARCH REPORT

International application no
PCT/182008/053885

DOCUMENTS CONSIDERED TO BE RELEVANT		Relevant to claim
X	US 4 696 566 A (SEKIMOTO YOSHIEBO [JP] ET AL) 29 September 1987 (1987-09-29) abstract: figures 3, 5, 9, 10 column 2, line 24 - column 3, line 5 column 4, lines 14-66	1, 6, 8, 9
X	US 2002/018291 A1 (FUKUYAMA HIROYA [JP]) 14 February 2002 (2002-02-14) cited in the application paragraph [0058]; figure 4 paragraphs [0053], [0054] paragraph [0119]; claims 1, 5	1, 6, 8, 9
X	JP 62 054843 A (BROTHER IND LTD) 10 March 1987 (1987-03-10) abstract; figures	1, 5, 6, 8, 9
-/-		
<p><input type="checkbox"/> Further documents are listed in the continuation of Box C. <input type="checkbox"/> See patent family series.</p> <p>* Special categories of cited documents: *P* document published after the international filing date or priority date and as a result with the application and claims is concerned the priority or novelty of the invention. *Y* document published on or after the international filing date. *X* document which may be particularly relevant or which is cited to establish the publication date of another document in other special search (see paragraph 1.2). *T* document which is the theory or principle underlying the invention. *E* document which is an earlier patent document, but published on or after the international filing date. *D* document cited for other reasons. *L* document cited for other reasons. *A* document of the same priority/filing/continuation document.</p>		
Date of the official completion of the international search		Date of mailing of the international search report
3 February 2009		09/02/2009
Name and mailing address of the ISA: European Patent Office, P.O. Box 1, Postfach 1 63, 10001 Frankfurt Tel: +49 (0) 69 449-1000 Fax: +49 (0) 69 449-3000		Authorized officer: Hylla, Winfried

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The Search Opinion

- **Rule 62 EPC** : Extended European Search Report (EESR)
 - (1) The European search report shall be accompanied by an **opinion** on whether the application and the invention to which it relates seem to meet the **requirements of this Convention** [...].
- **Rule 43bis.1 PCT** : Written Opinion (WO-ISA)
 - (a) [...] the International Searching Authority shall [...] establish a **written opinion** as to:
 - (i) whether the claimed invention appears to be **novel**, to involve an **inventive step**, [...] and to be **industrially applicable**;
 - (ii) whether the international application complies with the **requirements of the Treaty and these Regulations** [...].

A reasoned statement provides better insight than a citation

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European Search Opinion- Example

Beschleid/Protokoll (Anlage)	Communication/Minutes (Annex)	Notification/Procès-verbal (Annexe)
Datum Date cf Form 1507	Blatt Sheet Folite 1	Anmelde-Nr. Application No. Demande n° 06 388 001.7

← Application Number

The examination is being carried out on the following application documents:

Description, Pages

1-15 as originally filed

← Application documents version

Claims, Numbers

1-15 as originally filed

Drawings, Sheets

1/7-7/7 as originally filed

1. The following documents, cited in the European search report, are referred to in this communication:

- D1: US-A-5 544 269 (HATTORI ET AL) 6 August 1996 (1996-08-06)
- D2: ANONYMOUS: "Fiber Optic Switch. April 1979." IBM TECHNICAL DISCLOSURE BULLETIN, vol. 21, no. 11, 1 April 1979 (1979-04-01), page 4686, XP002379775 New York, US

← Cited documents

2. The present application does not meet the requirements of Article 52(1) EPC, because the subject-matter of claims 1, 2, 5-12 is not new in the sense of Article 54(1) and (2) EPC.

← Objections

2.1 D1 discloses a package (Figs. 24-26 and corresponding text passages) comprising a substrate (1b) with a longitudinal direction and a lateral direction perpendicular thereto, said substrate having a recess (4) formed in a first surface and extending in the longitudinal direction of the substrate (Fig. 24b), said recess having an inner

[European Patent Register](#)

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PCT - WOISA - Example

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING
AUTHORITY (SEPARATE SHEET)

International application No.
PCT/US2010/020787

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	3, 19
	No: Claims	1, 2, 4-18, 20
Inventive step (IS)	Yes: Claims	
	No: Claims	1-20
Industrial applicability (IA)	Yes: Claims	1-20
	No: Claims	

2. Citations and explanations

see separate sheet

Form PCTISA/237 (April 2007)

1 Reference is made to the following documents:

- D1 US 2002/186921 A1 (SCHUMACHER LYNN C [CA] ET AL) 12 December 2002 (2002-12-12)
- D2 WO 2007/136816 A2 (MASSACHUSETTS INST TECHNOLOGY [US]; BULOVIC VLADIMIR [YU]; KYMISSIS IO) 29 November 2007 (2007-11-29)

2 The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claims 1, 4-15, 17-18, 20 is not new in the sense of Article 33(2) PCT.

2.1 D1 discloses

an optical fiber capable of being diagnosed non-invasively comprising an optical fiber (12) for conveying a light beam; said optical fiber comprising a first end for receiving said light beam and a second end opposed thereto, a core (14) comprising an inner wall, and a cladding (16) surrounding said core, said optical fiber further comprising at least one uncladded portion comprising a plurality of quantum dots (26) dispersed in a medium, wherein said quantum dots become activated by evanescent wave coupling resulting from total internal reflection of said light beam contacting said inner wall of said optical fiber core and wherein said activation results in emittance of light from said quantum dots (Fig. 2c; paragraphs [0033], [0045]).

Therefore, the subject-matter of present claim 1 is not novel over the teachings of D1.

2.2 D1 also discloses

[European Patent Register](#)

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Overview

- European Procedure
- European Search Procedure
- **European Examination Procedure**



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The Examination Process

- Start of Examination Process when objections apply: **Amendments** by applicant or issue of a **communication** by the examining division
- Most of the Communications in Examination usually follow a structure:
 - Prior Art
 - Unallowable Amendments
 - Clarity issues, Insufficiency of Disclosure
 - Assessment of Novelty and Inventive Step
 - Formal Comments: reference signs, acknowledgement of prior art
- A Communication shall contain **all the grounds** hindering the grant of a Patent (Rule 71(2) EPC)
- Grounds may be supported by references to the **Case Law**

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The Examination Process

...and looks like this

- 1 The following documents are referred to in this communication:
D1 : US 6 243 026 B1 (JUDGE KEVIN ET AL) 5 June 2001 (2001-06-05)

Clarity

2. The present application refers to a traffic signal priority system, although the wording of claim 1 is such that tries to encompass a generic entry/exit control system. This however is not in line with the description, page 3, lines 3-5, where it is clearly stated that the invention directs to a traffic signal priority system. As such will be the claimed invention understood in the following (Art. 84 EPC). The applicant is reminded that the full scope of the claims must be supported by the

3 Independent claims

- 3.1 The present application does not meet the criteria of Article 52(2) EPC because the subject-matter of claim 1 is **not new** in the sense of Article 54(1) and (2) EPC.

Document D1 discloses (the references in parenthesis applying to this document):

A mobile event triggering method, comprising
detecting an entry of a vehicle into a defined event location (D1, col. 14, line 53)
evaluating a vehicle status with respect to at least one entry criterion (col. 14, line 53)
conducting an event entry action when the vehicle status meets said at least one entry criterion (D1, col. 14, line 55; lines 26-28)
evaluating the vehicle status with respect to at least one mobile event criterion corresponding to at least one mobile event
activating said at least one mobile event when the vehicle status meets said at least one mobile event criterion corresponding to said at least one mobile event (D1, col. 14, line 56)
evaluating the vehicle status with respect to at least one exit criterion
and
conducting an event exit action when the vehicle status meets said at least one exit criterion (D1, col. 14, lines 63-65).

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The Examination Process

...or like this

4 Inventive Step - Article 56 EPC

The applicant is also reminded that a Board of Appeal has already discussed the case of broad claims in its decision T939/92. In the current application, the technical problem consists of forecasting the compressive strength of a cementitious material, wherein the first step corresponds to measuring a physical parameter over a predetermined time-interval. When applying the reasoning of the Board of Appeal decision, the question which arises is whether all the options covered by the claimed method solve the technical problem. The fact that the use of some physical parameters (e.g. sound wave velocity, electrical conductivity, viscosity, heat capacity, relaxation time distribution) allows one to solve the aforementioned technical problem, could not be regarded as sufficient evidence to lead to the inference that the use of any physical parameter would solve the technical problem. For example, measuring the temperature of the cementitious material over a predetermined time-interval would obviously not allow the skilled person to carry out the claimed invention.

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Refusal

- The Examining Division can not find any subject-matter that could be granted (or if the applicant does not amend the application accordingly)
- The Applicant always has the **right to be heard**
- He can request **Oral Proceedings** (as well as the Examining Division)
- If at least two members of the Examining Division agree, the application is refused

Oral Proceedings

Oral Proceedings may be held at **request of the applicant** or at the **examining division's discretion**

- In the **Summons** to oral proceedings a detailed explanation of the outstanding objections is given
- **Minutes** of the oral proceedings are provided and contain essentials of the objections, arguments, etc.

Reference 104 475 A/KM	Application No./Patent No. 04017304.9 - 2216 / 1574888
Applicant/Proprietor FUJITSU LIMITED	

Summons to attend oral proceedings pursuant to Rule 115(1) EPC

You are hereby summoned to attend oral proceedings arranged in connection with the above-mentioned European patent application.

The matters to be discussed are set out in the communication accompanying this summons (EPO Form 2906).

The oral proceedings, which will not be public, will take place before the Examining Division.

on 17.02.09 at 09.00 hrs at the EPO,
PschorrHöfe, Bayerstr. 34, D-80336 München

No changes to the date of the oral proceedings can be made, except on serious grounds (see OJ EPO)

Datum Date Date	05.05.2009	Blatt Sheet Feuille	1	Anmelde-Nr. Application No. Demande n°	04 017 304.9
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The chairman opened the proceedings at 9:05. The file number is EP 04017304. He announced that the representative had one main request and three auxiliary requests.

The chairman discussed the inventiveness of claim 1 of the main request. He said that the subject matter of claim 1 can be achieved by combining D2 and D3. D2 is regarded as the closest prior art. It discloses an optical element (213), a protective component (100) for protecting an optical transmission medium and an electrical wiring (104, 105) on the surface of the protective component extending from an upper to a side surface (Figs 1-3).

The Right to be heard

- Art. 113 (1) EPC
"The decisions of the European Patent Office may only be based on **grounds or evidence on which the parties concerned have had an opportunity to present their comments.**"
- General principle: the applicant should not be surprised by objections used in refusals.
- Always allow the applicant to comment on objections either in writing or orally (telephone, oral proceedings)
- Often further communications include replies to arguments presented by the applicant

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Refusal - structure and arguments

- Summary of facts and submissions

I. Facts and Submissions

- I.1 Application number 04017304.9 was filed on 22.07.2004 in the name of Fujitsu Limited claiming priority from Japanese application JP2004067288 filed on 10.03.2004.
- I.2 A European search report was completed on 13.09.2004. A first communication was issued on 25.11.2005 informing the applicant that the set of claims lacked unity. In response the applicant filed a new set of claims on 05.04.2006 which was considered by the examining division as being unitary. Further communications were issued on 04.08.2006 and 14.09.2007 informing

- Reasons for the decision

II. Reasons for the decision:

II.1 Main request:

- II.1.1 The present application does not meet the requirements of Article 52(1) EPC because the subject-matter of claim 1 does not involve an inventive step within the meaning of Article 56 EPC.
D2 discloses an optical module comprising an optical element (213), a protective component (100) for protecting an optical transmission medium (101, 102) to be optically coupled to said optical element (column 3, lines 29-31); and an electric wiring (104, 105) formed on said protective component for said

- Reply to arguments by applicant

II.5.3 Concerning the applicant's arguments:

The applicant's representative argued that the combination of teachings of three documents to prove lack of inventive step is not allowable. However, as shown in the previous section the subject-matter of claim 1 is seen as a mere juxtaposition of non-inventive features with no synergistic effect arising from their combination. In this case features from more than two documents may be combined to prove lack of inventive step.

- Refusals may be a good source for arguments etc. - detailed reasoning

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Grant

- The Examining Division can find subject-matter that could be granted
- The Examining Division may help the Applicant by making suitable **suggestions**, but the Applicant is **responsible** for them
- If at least two members of the Examining Division agree, the application is granted
- The application is **informed of the text with which the examining division intends to grant** (Rule 71(3) EPC)

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Suggestions to the applicant

- Even though it is not the responsibility of the examiner or examining division, **many applicants appreciate suggestions** to patentable subject-matter
- Suggestions often help to **speed up the procedure**
- Suggestions can be made by:
 - Writing a **communication** (e.g. in combination with objections to pending claims)
 - **Telephone Conversation**
 - **Personal interview**
 - **Oral Proceedings or Summons thereto**
- Examples of suggestions:
 - Invite the applicant to include a feature of a dependent claim into the independent claim
 - Invite the applicant to claim a certain embodiment
 - Clarifications
 - Formulate allowable claims

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Suggestions to the applicant - by telephone

The first Examiner telephoned the Applicant's representative on 09 August 2011.

The first Examiner explained the Applicant's representative that the application appears to provisionally fulfil the requirements of novelty and inventive step according to Articles 54(1), 54(2), 54(3), and 56 EPC in the light of the prior art.

However, in order for the application to be likely to proceed to the grant phase, the application should still be amended :

- **Clarity** (Article 84 EPC): The arrangement defined in claim 1 is ambiguous (e.g. on lines 13 and 14, an adhesion promoting layer is said to be disposed on the analyte sensing layer, whereas it is disposed on the protein layer, see description page 9, line 12 - page 12, line 15, figure 2 and claim 19). Claim 1 should therefore be redrafted in order to be supported by the description, and to be in line with claim 19.
- **Unallowable Amendment** (Article 123(2) EPC) : In the International Preliminary Report on Patentability, an objection of clarity was raised due to a functional feature in apparatus claim 1. When entering the regional phase, claim 1 has been amended by deleting said feature. The mere deletion of said feature has, however, for effect to enlarge the scope for which a protection is sought, and therefore contravenes the requirements of Article 123(2) EPC.

The first examiner therefore suggested to draft independent claim 1 as follow :

*An analyte sensor apparatus (100) for implantation within a mammal, the analyte sensor apparatus comprising:
a base layer (102);
a conductive layer (104) disposed upon the base layer (102) wherein the conductive layer (104) includes a working electrode;
an analyte sensing layer (110) disposed on the conductive layer (104), wherein the analyte sensing layer (110) detectably alters the electrical current at the working electrode in the conductive layer (104) in the presence of an analyte;*

means for providing anodic polarization such that the alteration in current is detected at the anode working electrode in the conductive layer of the analyte sensor apparatus, the alteration in current being correlated with the concentration of the analyte;

characterized in a protein layer (116) disposed on said analyte sensing layer (110); an adhesion promoting layer (114) disposed on said protein layer (116), and an analyte modulating layer (112) disposed on said adhesion promoting layer (114).

The Applicant's Representative was convinced by the arguments but asked for obtaining the agreement of her client. A period of 4 months was given for that.

Suggestion

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The End

- **Thank You very much for your attention**

Questions ?



Contact: swolf@epo.org

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