

Utilization of Search and Examination Results at the EPO

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

Steffen Wolf, European Patent Office, Munich, Germany



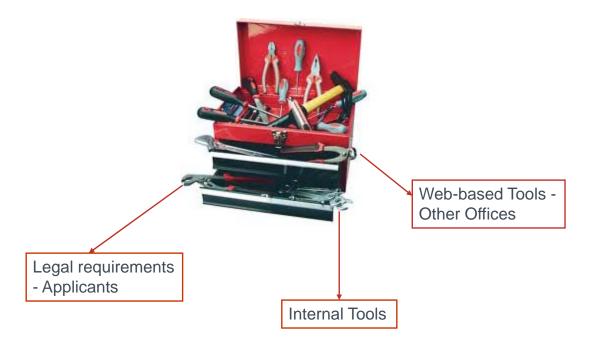


Outline

- Tools used by an EPO examiner
 - Legal Requirements of the European Patent Convention
 - Internal tools : Combi, DI+
 - US Search and Examination Reports US PAIR
 - European National Offices
- Tools to access EPO Search and Examination Reports
 - ESPACENET
 - CCD (Common Citation Document)
 - European Patent Register
- Work-sharing between patent offices



An EPO examiner's Toolbox



20/12/2011



Legal Requirements of the European Patent Convention

Article 124 EPC

- (1) The European Patent Office may, in accordance with the Implementing Regulations, invite the applicant to provide information on prior art taken into consideration in national or regional patent proceedings and concerning an invention to which the European patent application relates.
- (2) If the applicant fails to reply in due time to an invitation under paragraph 1, the European patent application shall be deemed to be withdrawn.



Legal Requirements of the European Patent Convention - Implementing Regulations

Rule 141 (1) EPC

An applicant claiming priority within the meaning of Article 87 shall file a copy of the results of any search carried out by the authority with which the previous application was filed together with the European patent application, in the case of a Euro-PCT application on entry into the European phase, or without delay after such results have been made available to him.

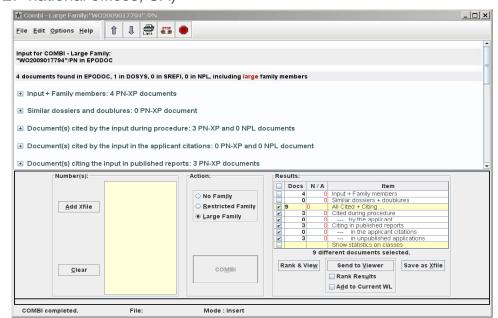
(entered into force 01.01.2011)

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Internal tool ..combi

- searches for all cited and citing documents of all family members
- done for EP applications at least before suggestion to grant
- EPO collects citation data from other offices (e.g. JPO, USPTO, EP national offices, CA)





Internal Tool DI+: Dossier Inspection Plus

➤ What is DI+?

DI+ is an enhanced dossier inspection tool which allows inspection of EP, JP and US file wrappers (before end 2011 also of KR file wrapper)

► How do we access DI+?

Through the integrated buttons in VIEWER or TRIMARAN

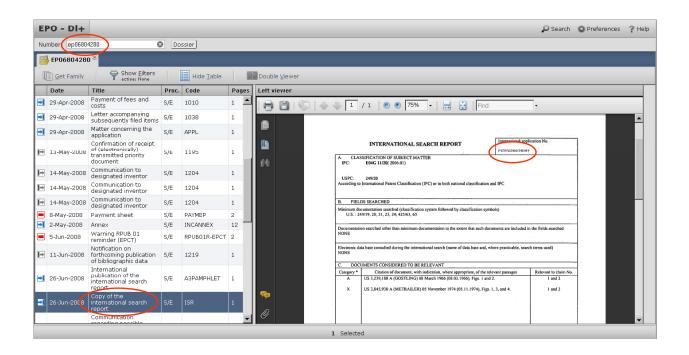




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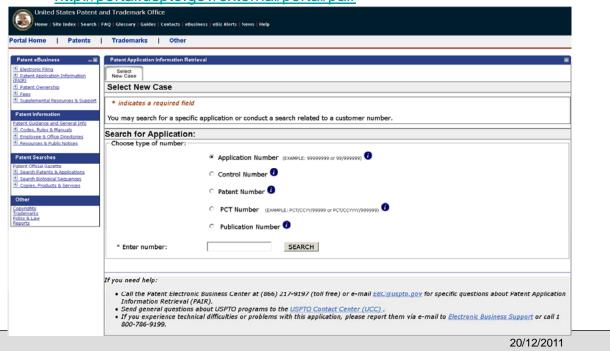
... and it looks like this





USPTO - PAIR

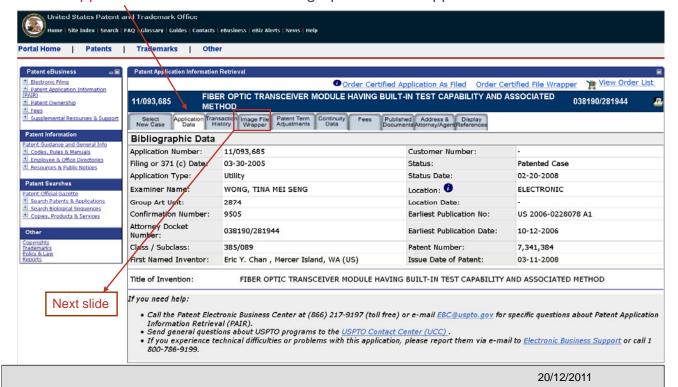
- <u>Patent Application Information Retrieval</u> (PAIR)
- Public PAIR Retrieving Information on Applications processed by USPTO http://portal.uspto.gov/external/portal/pair





USPTO - PAIR

"Application Data" contains Bibliographic Data of application





USPTO - PAIR

"Image File Wrapper" contains search and examination reports

09-28-2006 WFEE <u>Fee Workshee</u> 04-28-2006 CTNF Non-Final Rej						ksheet (SB06)				PROSECUTION PROSECUTION		
	4-28-2006 1449 List of References cited by applicant examiner						d considered by PRIC			DR ART	10 1	
04-28-2006 892 List of references cited by exar						nces cited by examiner		PRIOR ART			1	
04-28-2006 FWCLM Index of Claim					laims			PROSECUTION		1		
Application/Control No. Applicant(s)/Patent Under Reexamination CHAN ET AL												
	Notice of References Cited Examiner						CHAN ET AL.					
						Tina M. Wong	2874	Page 1 of 1				
U.S. PATENT DOCUMENTS												
1	Document Number Date Country Code-Number-Kind Code MM-YYYY				Name			Classification				
	* A US-6,081,638 06-2000 Zhou, Ping * B US-6,842,467 01-2005 Aronson et al. * C US-5,179,420 01-1993 So et al.					Ping	385/31					
							372/27					
									356/73.1			
	D US-											
E US-												

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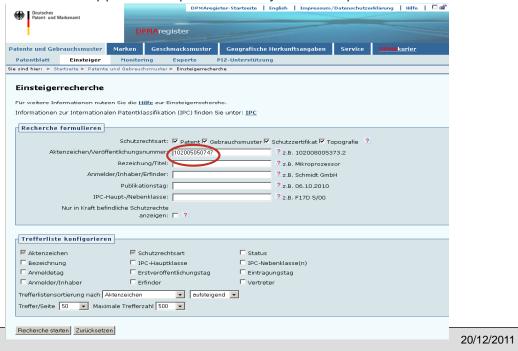
More Online Services of USPTO

- Get an overview of other online services of USPTO http://www.uspto.gov/ebusiness/services
- Private PAIR Secure, authorized access to private application info and documents
- PatFT Granted Patents Full Text Search
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German Patent Office DPMAregister

- http://register.dpma.de/DPMAregister/uebersicht or through http://www.dpma.de/
- Access to applications processed by German patent office





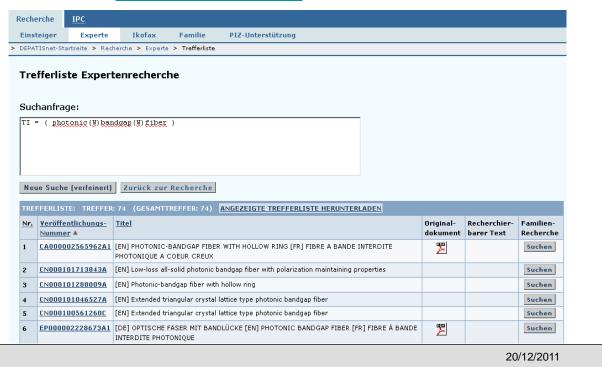
German Patent Office DPMAregister





German Patent Office - DEPATISnet

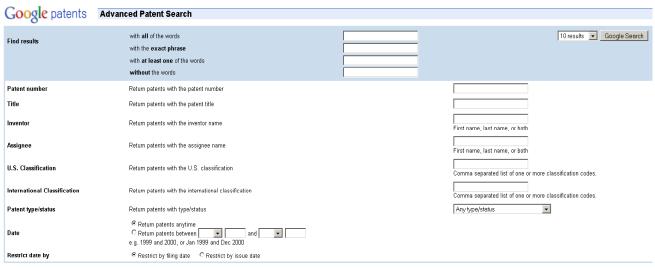
 Search in published patent applications using numbers, text, dates, classes http://depatisnet.dpma.de





Internet searches - Google

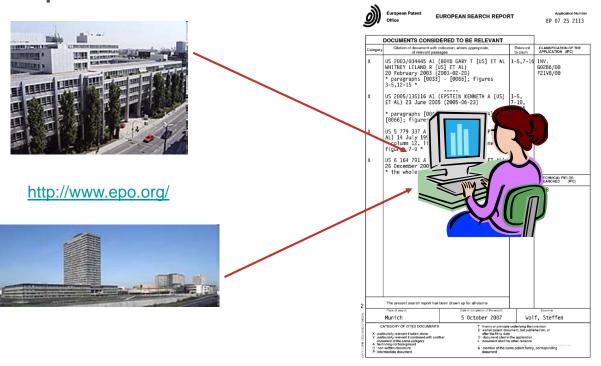
- Standard Google Searches
- Google Patents http://www.google.com/patents
- Advanced Patent Search



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Tools to access EPO Search and Examination Reports



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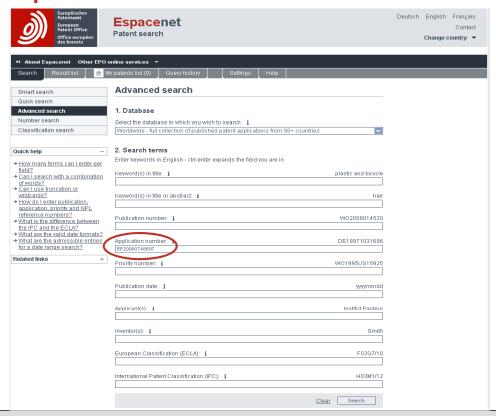


Espacenet

- http://www.epo.org/
- Search for published applications from more than 80 countries
- Number Search: Application, Publication, or Priority Number
- Advanced Search: Keyword, Applicant/Inventor, Publication Dates
- Classification Search: International Patent Classification (IPC), European Classification (ECLA)



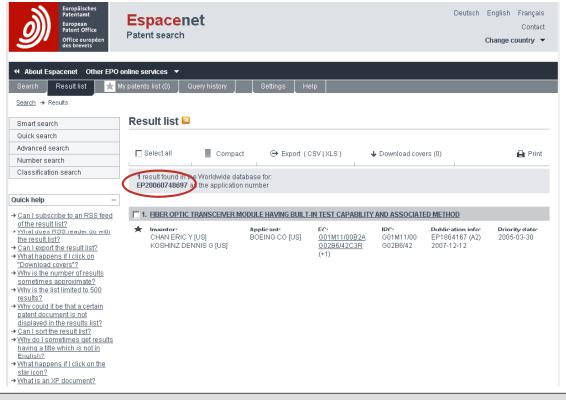
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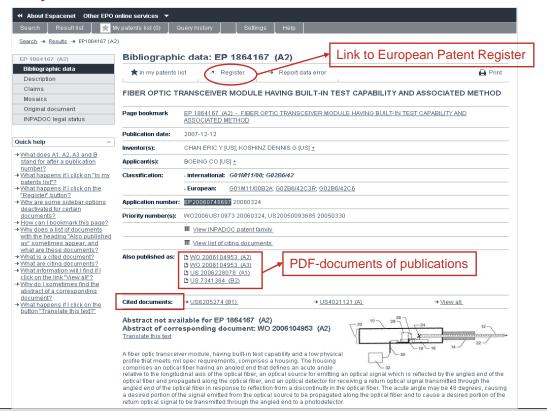


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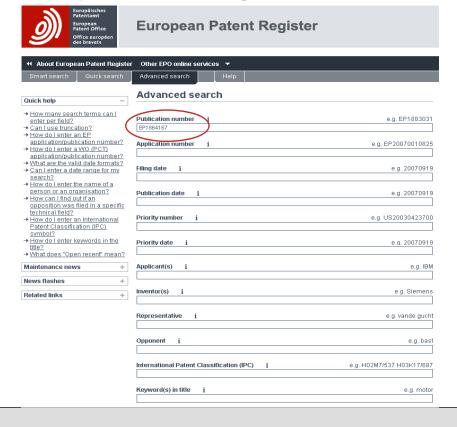
European Patent Register

- https://register.epo.org/espacenet/regviewer or through http://www.epo.org/
- Contains procedural information on European patent applications once published
- Number Search: Publication and Application Number, Filing Date
- Advanced Search: Keywords, Applicant/Inventor, Representative, Opponent, Priority Dates and Numbers, IPC classes

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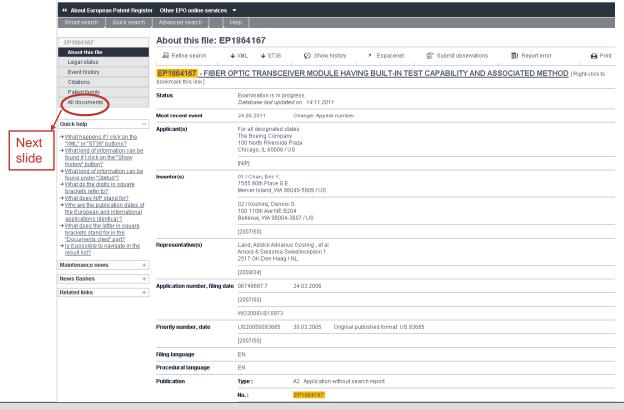
European Patent Register



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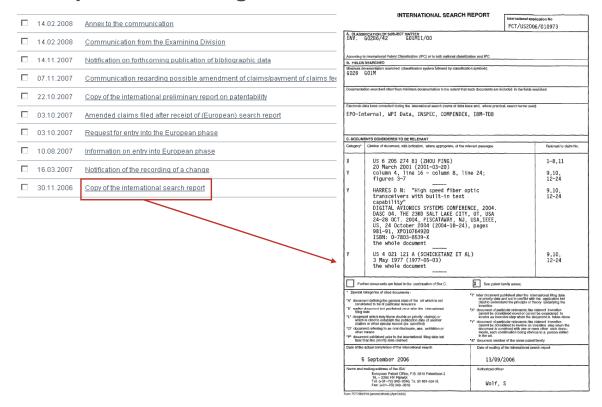


European Patent Register





European Patent Register - All documents



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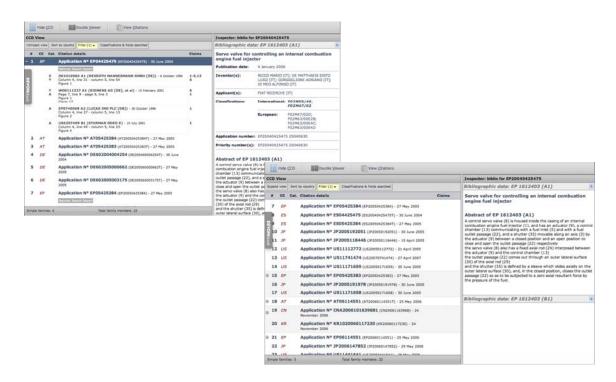


Common Citation Document (CCD)

- Common Citation Document (CCD) was initially asked by industry.
- CCD offers consolidated access to citation data from JPO, USPTO, EPO
 (Trilateral) combining a priority-based family of patent applications with the cited prior art for each family application.
- CCD is based on published data or on data made publicly available by Patent Offices.
- CCD involves the commitment of the Trilateral Offices to engage into the exchange of the relevant citation data.
- CCD builds on the EPO's family system and has been developed and is hosted by the EPO. Developments took as much as possible comments from the industry and Trilateral Offices into account.

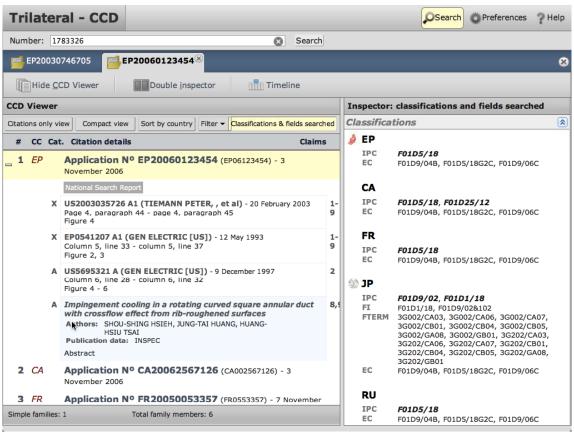


CCD is available under: http://www.trilateral.net/ccd



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Need for work-sharing schemes

- The EPO consider as an important goal to enhance utilisation, e.g. work-sharing. This requires that two conditions are met: Timeliness of results and quality of results.
- Timeliness is related to the First Office Action being available before the Office of Second Filing starts the work:
 - For PCT applications, this is already available
 - For Paris Route applications (national applications), this needs to be organised. Should be based on office prioritising actions

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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
- 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



Work-sharing: Paris route applications (national applications)

- Utilisation requires that results produced by the Office of First Filing are available on-time at the Office of Second Filing
- The EPO performs systematic prioritisation of first filings. Utilisation at the EPO requires that other offices also do the same:
 - JP-FIRST: JP Fast Information Release Strategy JPO launched in 2009 this pilot to prioritise certain first filings that are subsequently filed at the EPO and USPTO
 - SHARE: Strategic Handling of Application for Rapid Examination. USPTO launched in 2010 a pilot with the EPO and JPO where this office prioritises first filings (FLASH - First Look Application Sharing)
 - PPH: Patent Prosecution Highway. Option for applicants to obtain patent protection more efficiently and faster in the Office of Second Filing when the Office of First Filings has determined allowable / patentable subject-matter. Currently the EPO has pilot projects with the USPTO and JPO as well as a Trilateral PCT/PPH.

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The End

Thank You for your attention

Questions?



Contact: swolf@epo.org