

Exercises A (Topic 3) – Exercises on families

We are going to use following freely accessible databases offering family information, patent status data and file inspection:

EPO Espacenet: <http://worldwide.espacenet.com/>

Espacenet also permits access to the EPO Register which permits file inspection.

Direct access to EPO Register: <https://register.epo.org/espacenet/regviewer>

EPO CCD: <http://www.trilateral.net/ccd>

WIPO Patentscope: <http://www.wipo.int/patentscope/search/en/search.jsf>

US-PAIR: <http://portal.uspto.gov/external/portal/pair>

DPMA Register: <http://register.dpma.de/DPMAregister/Uebersicht?lang=en>

The objective of these exercises is to familiarize ourselves with patent families (such with and without priorities) and the online resources permitting access to family information.

Task 1: [WO2011074782](#)

Q: Are the simple and extended families different?

A: Yes, the extended family also comprises KR20110068831, while the simple only comprises the domestic family WO-A2 and WO-A3.

Task 2: [DE19833712](#)

Q: How many domestic families are included in the extended (Inpadoc) family of DE19833712 ?

A: To see all domestic families, view the Inpadoc family in Espacenet. 5 domestic families are shown: DE-A1, FR-A1/B2, 2xJP-A/B2, US-A1/B2; i.e. there is one additional JP domestic family in comparison to the simple family.

Q: Which domestic family is not part of the simple family and why ?

A: The domestic family comprising JP 2007304109 A & JP 4179389 B2; compare the Inpadoc family with the equivalents shown under "also published as" (i.e. the simple family), or see the family information in the CCD. This domestic family claims the additional priority JP20070178418.

Q: How many domestic families are therefore included in the simple family of DE19833712?

A: 4 domestic (DE, FR, JP, US), see the field "also published as";

Q: How many family members has the extended family, including all domestic family members, and the simple family ?

A: The extended has 9 (DE-A1, US-A1, US-B1, FR-A1, FR-B1, 2x JP-A, 2x JP-B2) and the simple has 7 members, respectively; when one mentions the number of family members, one usually means all publications, including the subsequent ones of each domestic family; the CCD however counts domestic families when indicating the family size.

Q: How many JP national families are there in the extended family?

A: Just one national family but two domestic JP families; both domestic families are linked through the priority of the older JP application which is claimed for the younger JP application and therefore build a national family.

Task 3: [AU5314899A1](#), [DE102004051671A1](#), [US6565803](#)

Q: Check the size of the families. Can you count or guess how big the Inpadoc families are? Are the simple families smaller or equal in size?

A: The family size is indicated for the Inpadoc families in the left upper corner of Espacenet; and the lower line of CCD. The samples illustrate that there are very big extended families, eg the last one has more than 1700 members. Family members of such huge families may relate to different inventions that only have the area of technology in common. The many extensions show that these inventions are commercially quite important and have a global market. That is typical for medications.

AU5314899A1: approximately 150 Inpadoc family members, including 48 simple families according CCD. The simple family of AU5314899A1 has 16 domestic families as members.

US6565803: This illustrates problems that can arise when viewing the family with CCD, too large family, too many simple families.

Task 4: [WO2007008499](#)

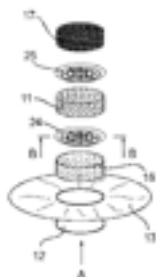
Q: Check the titles of the Inpadoc family; what do you notice?

A: This is a sample for data errors that sometimes occur; different inventions are mixed ("Zosuquidar,..."; "Content presentation optimizer", most likely because of a typo in a priority information; note also the various inventor names.

Task 5: Sample of technical family ("Nargilleh"; real case)

The patent office of O received an application from a foreign inventor in English language for which no priority is claimed. The foreign nationality of the applicant and the submission of the application in English are indicators that the application may have been filed elsewhere and that examination results may be available.

Inventor name: SHRAIBER Michael
Title: Tobacco cartridge for narghilles
Drawing:



Q: Check whether there are similar applications which constitute a **technical family** with the Omani application.

A: A short Espacenet search for the inventor name and subsequent comparison of drawings shows that this application is similar to an application filed with the EPO which was granted by the EPO on 28.10.2009 as [EP1702525B1](#).

Furthermore, a US patent US 7775218 B2 was granted and published on 17.8.2010.

Q: As an examiner in the office of O, how would you proceed in case the application was filed on

i) 20.6.2007

ii) 20.6.2006

A:

The application was published for the first time as EP 1702525 A1 on 20.9.2006.

In case i), it therefore constitutes relevant prior art and a patent may most likely not be granted provided the application filed in O does not include further details that were not disclosed in the EP-A1. In case there are further features, a separate search would be needed to determine whether these features are also known in the prior art.

In case ii), some claims may be granted most likely since the EP-A1 publication does not constitute prior art. However, the US and the EP claims are very different. The case is further explored in exercise F.