

# Topic 4A: Retrieving and utilizing external examination results

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### Agenda

- Opportunities
- Requirements
- Types of results
  - final
  - intermediary
- Public resources for retrieval
- Issues



# Opportunities through patent families

- Utilisation possible if same invention was/is filed in several IPOs
  - OFF: Office of First Filing
  - OSFs: Office(s) of Second Filing
- Active worksharing: avoid duplication of work by active organisation of the work distribution; e.g OFF treats applications with priority and OSF wait for results
  - Some collaborations have started, e.g. Vancouver Group (AU, CA, UK)

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- Trilateral offices (EPO,JP,USPTO)
- "Passive worksharing": Use results that were obtained for family members at other IPOs

# Active worksharing trilateral offices

- 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)



### Passive worksharing

- Utilization of examination results obtained by other IPOs can save resources and improve quality, e.g.
  - Other IPOs may have access to other information resources
  - Individual examiners at other IPO may have particular expertise in a certain field
  - Learning from/improving other search strategies
  - Examination reports may include valuable arguments
- Effective strategy for small IPOs to cover all technical areas, instead of outsourcing of substantive examination (see presentation of topic 1)

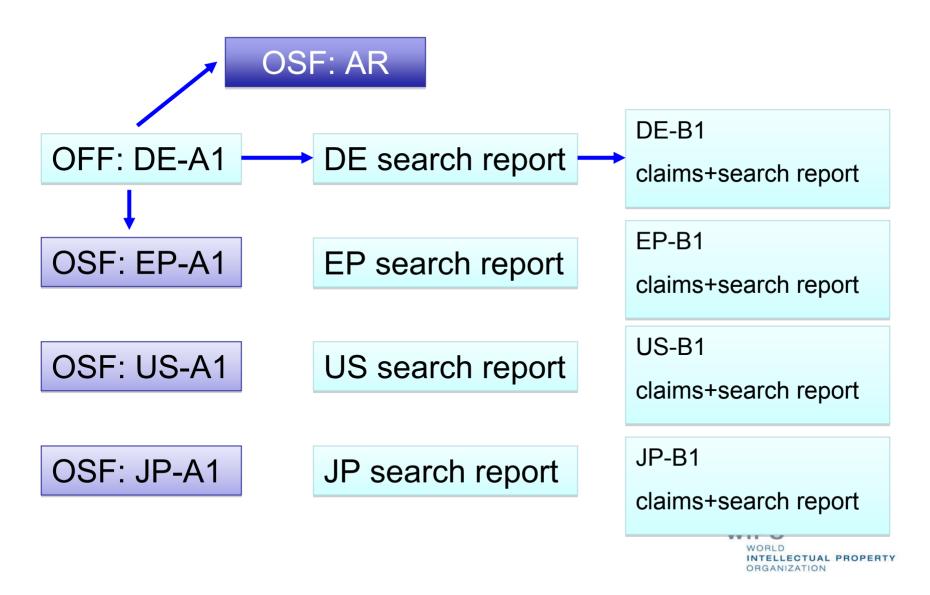


#### Types of examination results

- Intermediary or pre-grant results
  - Search reports (basic; enriched, e.g. with search strategies)
  - Written opinions, examination reports
  - Communications between applicant and examiner
  - Third party observations
- Final results
  - Granted claims
  - Rejections; withdrawls following substantive reports
- Post-grant results
  - Additional prior art from opposition/re-examination
  - Amended claims
  - Communications between involved parties (3+)



#### Usable results



#### Issues with final results

#### Utilization of final results

- Requires identical claims
- Requires cooperative lawyers/applicants that agree to use the claims granted abroad
- Requires the claims to be compatible with national law, e.g. exemptions
- Requires confidence in the work of other IPOs
- Implies considerable delay because final results have to become available
- (See separate presentation on topic 8 for use of granted claims)

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# Patent prosecution highway PPH

- JPO initiative to accelerate granting in case of grants at other IPOs
- In case of grants: Option for applicants to obtain patent protection more efficiently and faster in the Office of Second Filing when the Office of First Filing has determined allowable / patentable subject-matter.
- (See separate presentation on topic 8 for use of granted claims)



### Issues with intermediary results

- Implies some but smaller delay than waiting for final results
- Searches are based on claims: the foreign search results may be incomplete/inappropriate if claims are different
- Requires checking whether same priorities
- Different priorities and priority dates can lead to different claims or prior art
- Usually no problems if simple family
- Using results for members of extended family may be problematic



### Planning of utilization

- ► Utilization of examination results requires knowledge of
- Family information, i.e. where else has an invention been filed (Paris, PCT, technical family)
- Examination practice of other IPOs, i.e. do they have deferred examination (e.g. DE), is prior art search mandatory (e.g. EP, PCT)?
- Examination status, i.e. is substantive examination under way (i.e. national phase entry for PCT applications)
- ► Depending on national requirements, e.g. deadline for first action by examiner

### Retrieval options

- Active retrieval by examiner, i.e. research family information and research examination status and retrieve results from online resources
- Request applicant to submit information; some legislations provide for a respective obligation

#### **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 .... deemed to be withdrawhization

#### Online resource

- ► Various (public) online databases provide
- Family information (see topic 3)
- Examination status
- Published applications and granted patents with search reports, granted claims
- Several IPOs also offer access to the examination file (file wrapper), e.g.
  - Examination reports
  - Replies from applicants



#### Selected online resources

- European Patent Register (EP)
  - https://register.epo.org/espacenet/regviewer
- Common Citation Document (Pilot)
  - http://www.trilateral.net/ccd
- Patentscope
  - http://www.wipo.int/patentscope/search/en/search.jsf
- Public Pair (US)
  - http://portal.uspto.gov/external/portal/pair
- AIPN (JP)
  - http://aipn.ipdl.inpit.go.jp/
- K-PION (KR)
  - http://kposd.kipo.go.kr:8088/up/kpion/
- DPMAregister (DE)
  - http://register.dpma.de/DPMAregister/Uebersicht?langen

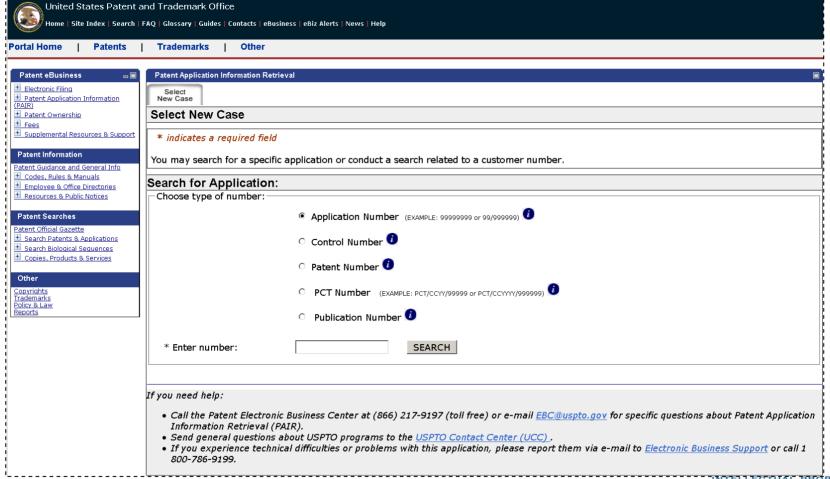
#### Online resources

- European Patent Register (EP)
  - EP applications: enriched SR, ER, examination status, file wrapper)
- Common Citation Document (Pilot)
  - SRs for EP, JP, US, WO,.....
- Patentscope
  - WO applications: enriched SR, ER, file wrapper
- Public Pair (US)
  - US applications: file wrapper with SR, ER, examination status
- AIPN (JP)
  - See topic 4B presented by JPO
- K-PION (KR)
  - See topic 4B presented by JPO
- DPMAregister (DE)
  - DE applications: SR, examination status



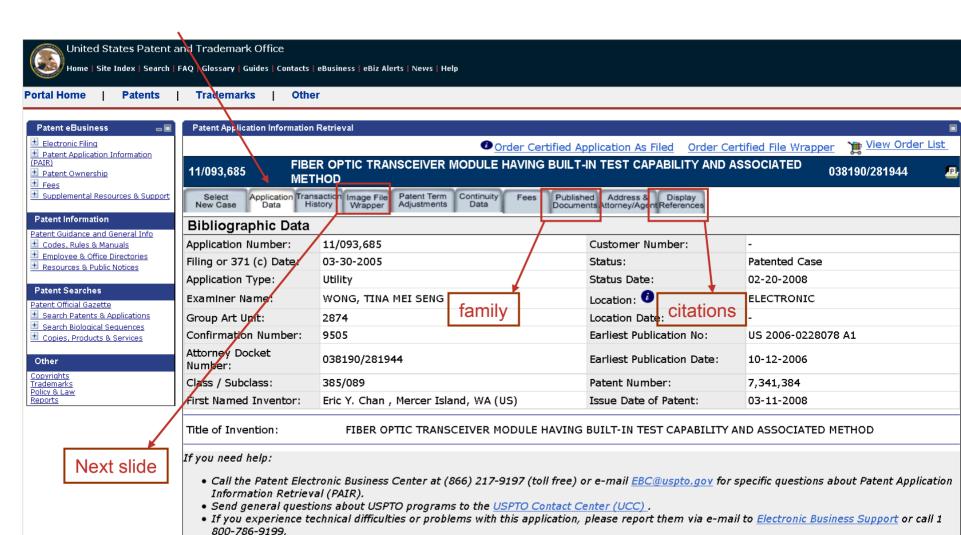
#### **USPTO - PAIR**

Patent Application Information Retrieval (PAIR)





#### **USPTO - PAIR**



#### **USPTO - PAIR**

#### "Image File Wrapper" contains search and examination reports



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# German Patent Office DPMAregister

Access to examination status and search reports of applications processed by German patent office: no file wrapper yet

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			Publikat	ionstag:		? z.B. 06.10.2010			
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# German Patent Office DPMAregister

#### Treffer 1/1, Registerauskunft

Aktenzeichen DE: 10 2005 050 747.6

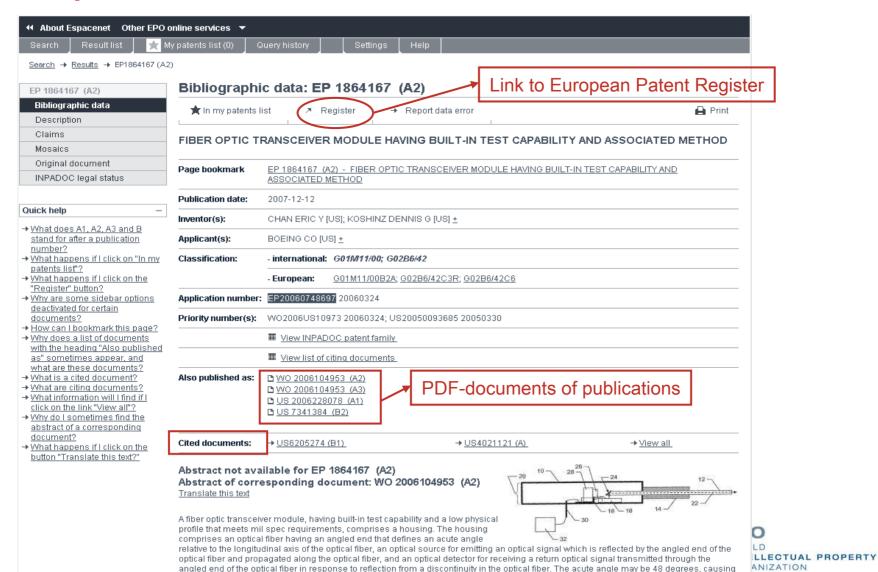
Schutzrechtsart: Patent Status: anhängig/in Kraft Stand am: 16. November 2011

Zurück zur Einsteigerrecherche Zurück zur Trefferliste

Stammdaten <u>Details schließen</u>						
INID	Kriterium	Feld	Inhalt			
	Schutzrechtsart	SART	Patent			
	Status	ST	Anhängig/in Kraft			
21	Aktenzeichen DE	DAKZ	10 2005 050 747.6			
54	Bezeichnung/Titel	TI	Multiplex-Sender für Polymerfaserübertragung und Verfahren zu dessen Herstellung			
51	IPC-Hauptklasse	ICM (ICMV)	H04J 14/02 (2006.01)			
22	Anmeldetag DE	DAT	22.10.2005			
43	Offenlegungstag	от	26.04.2007			
71/73	Anmelder/Inhaber	INH	ESA Patentverwertungsagentur Sachsen-Anhalt GmbH, 39114 Magdeburg, DE; Hochschule Harz (FH), 38855 Wernigerode, DE			
72	Erfinder	IN	Ulrich, Prof. Dr. Fischer-Hirchert, 38640 Goslar, DE			
74	Vertreter	VTR	Sperling, Fischer & Heyner Patentanwälte, 39108 Magdeburg, DE			
10	Veröffentlichte DE-Dokumente	DEPN	DE102005050747A1			
	Zustellanschrift		Sperling, Fischer & Heyner Patentanwälte, 39108 Magdeburg, DE			
	Fälligkeit	FT FG	31.10.2011 Jahresgebühr für das 7. Jahr			
	Zuständige Patentabteilung		55			
57	Zusammenfassung	АВ	Die Erfindung betrifft einen Multiplex-Sender für Polymerfaserübertragung und ein Verfahren zu dessen Herstellung.\$A Erfindungsgemäß besitzt der Multiplex-Sender einen Grundkörper mit Aussparungen, in denen Wellenleiter der Eingangskanäle sowie Wellenleiter des oder der Ausgangskanäle angeordnet sind, wobei sowohl der Grundkörper mit Aussparungen als auch die Wellenleiter Spritzgussteile sind.\$A Im Verfahren zur Herstellung eines Multiplex-Senders für Polymerfaserübertragung werden in einem ersten Verfahrensschritt der Grundkörper mit den Aussparungen als spritzgussteil hergestellt, während in einem zweiten Verfahrensschritt die Wellenleiter ebenfalls durch Spritzguss in Aussparungen des Grundkörpers eingebracht werden.			
56	Entgegenhaltungen	СТ	DE000019716838A1 DE000010323032A1 DE000069030437T2 US00006356692B1 US020050175347A1 US020050175347A1 US020050069013A1 DE000069013A1 DE000069013A1 DE000069013A1 DE000069013A1 DE000069013A1 DE000069013A1 DE000069013A1 DE			



### **Espacenet**



return optical signal to be transmitted through the angled end to a photodetector.

a desired portion of the signal emitted from the optical source to be propagated along the optical fiber and to cause a desired portion of the

# European Patent Register

- Contains procedural information on European patent applications once published (examination status, validity)
- Not to be confused with similar looking Espacenet interface; similar search options:
  - Number Search: Publication and Application Number, Filing Date
  - Advanced Search: Keywords, Applicant/Inventor, Representative, Opponent, Priority Dates and Numbers, IPC classes

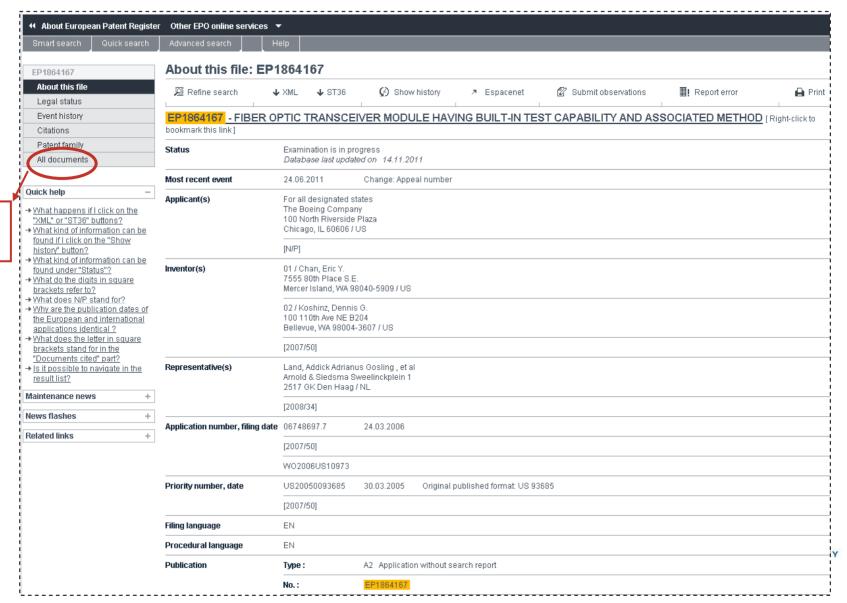


# European Patent Register



#### WIPO WORLD INTELLECTUAL PROPERTY ORGANIZATION

# European Patent Register



Next slide

#### **EPR - All documents**

·					
	14.02.2008	Annex to the communication			
	14.02.2008	Communication from the Examining Division			
	14.11.2007	Notification on forthcoming publication of bibliographic data			
	07.11.2007	Communication regarding possible amendment of claims/payment o			
	22.10.2007	Copy of the international preliminary report on patentability			
	03.10.2007	Amended claims filed after receipt of (European) search report			
	03.10.2007	Request for entry into the European phase			
	10.08.2007	Information on entry into European phase			
	16.03.2007	Notification of the recording of a change			
	30.11.2006	Copy of the international search report			



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Formalities Officer Name: SANCHEZ BARRIO, S Tell: +49.89.2399 - 2292 or call +31 (0)70.340.45.00

Substantive Examiner Name: Wolf, Steffen Tel: +49 89 2399 - 7029



Application No.	Ref.	Date	
06 748 697.7 - 2216	H/2FA75/AK/1066	14.02.2008	
Applicant The Boeing Company			

#### Communication pursuant to Article 94(3) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(2) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

#### of 4 months

from the notification of this communication, this period being computed in accordance with Rules 126(2) and 131(2) and (4) EPC.

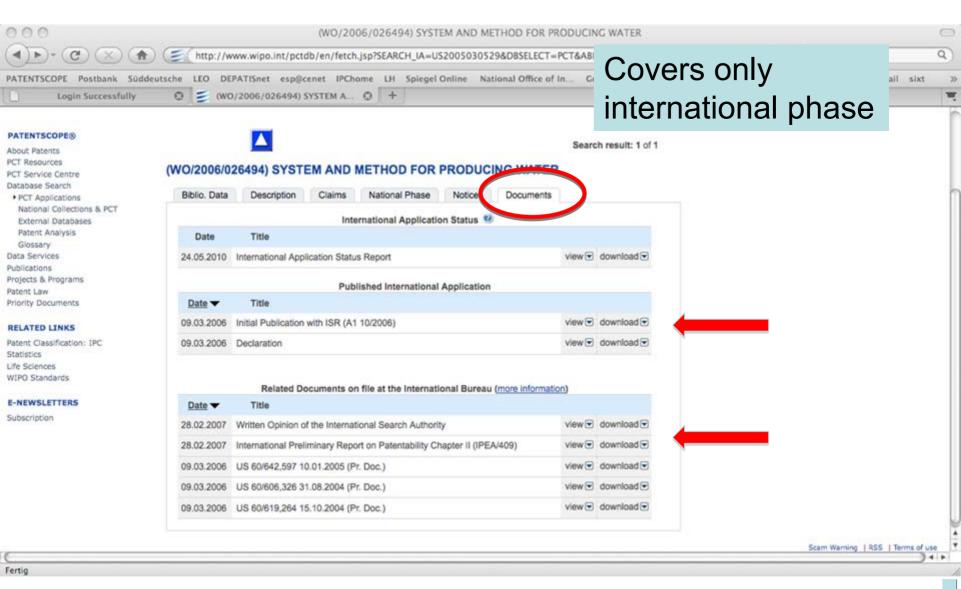
One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (R. 50(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Art. 94(4) EPC).



Wolf, Steffen Primary Examiner for the Examining Division

# Patentscope: PCT file inspection



### Common Citation Document (CCD)

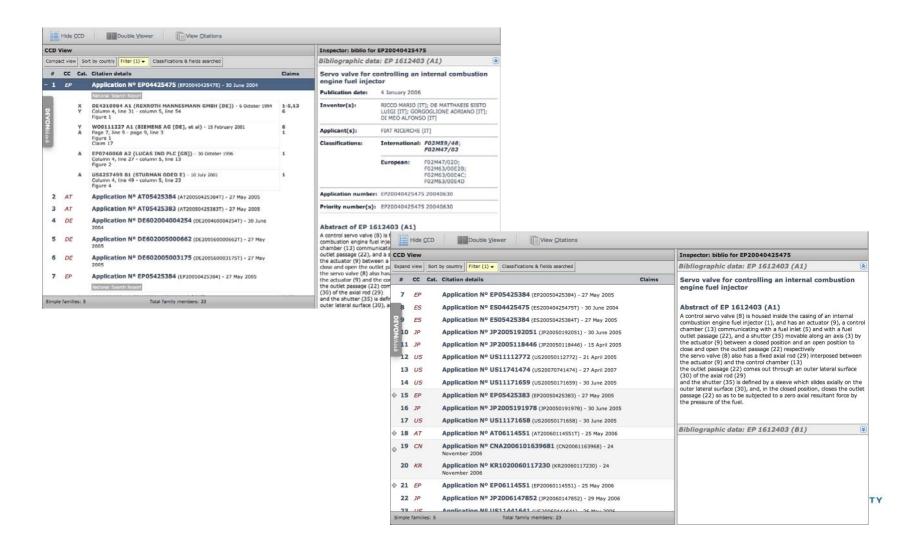
- CCD offers consolidated access to family information and the related citation data from JPO, USPTO, EPO, PCT, and several other jurisdictions for each respective family member.
- CCD builds on the EPO's family system and has been developed and is hosted by the EPO.
- CCD permits viewing of cited patent documents
- No examination reports included
- Various display options



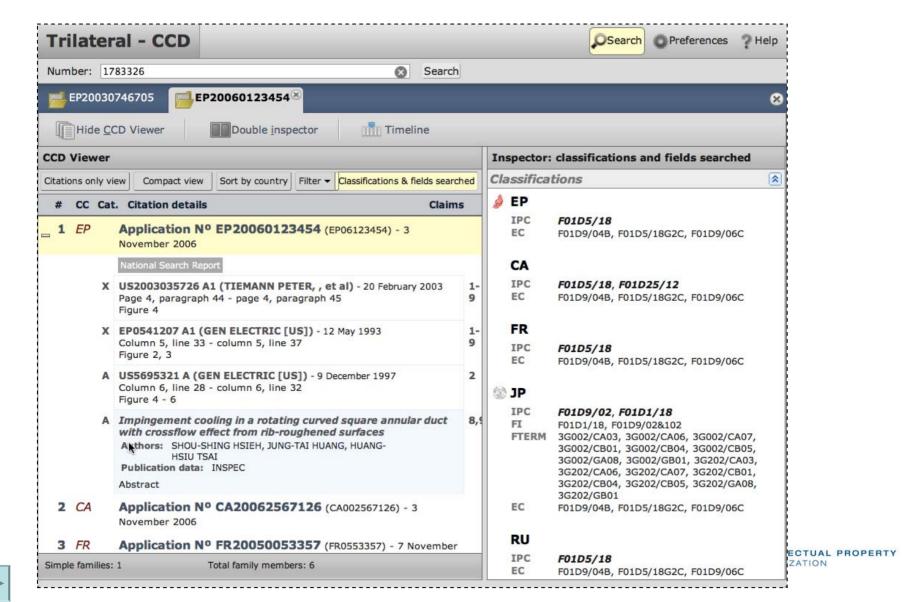


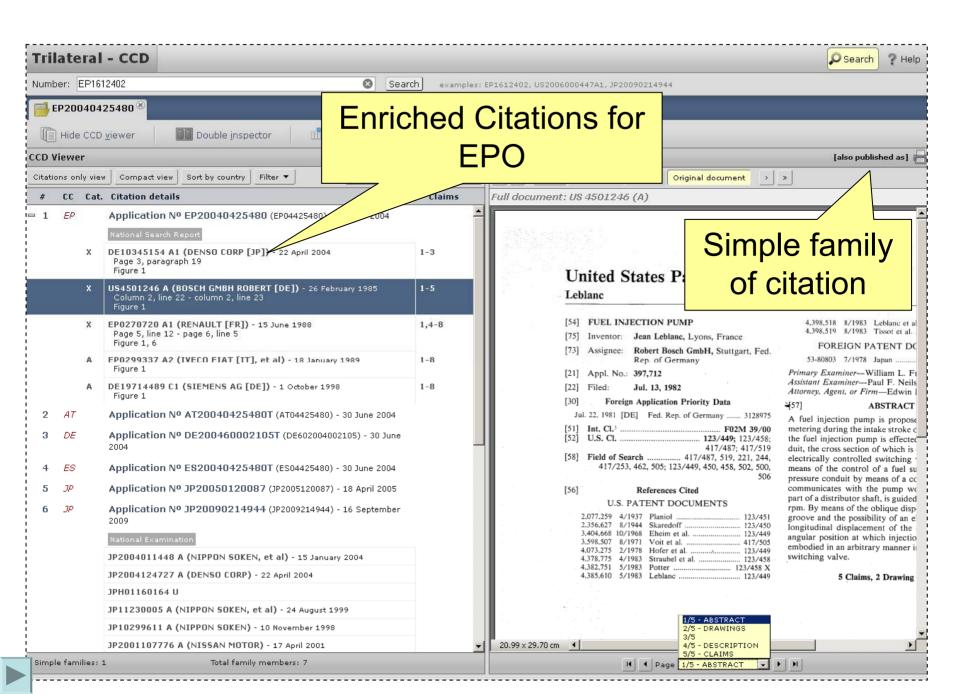
# Common Citation Document (CCD)

#### http://www.trilateral.net/ccd

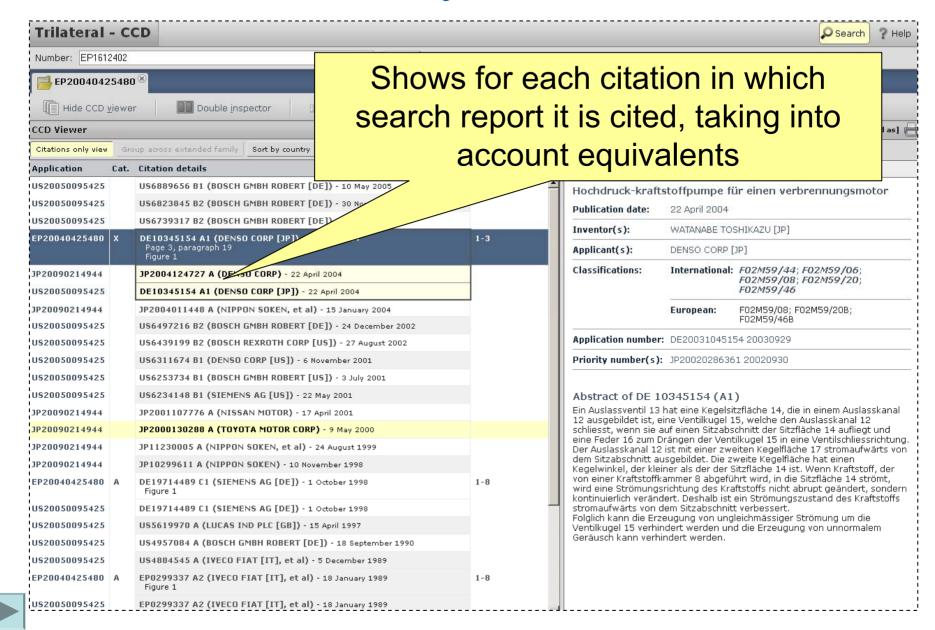


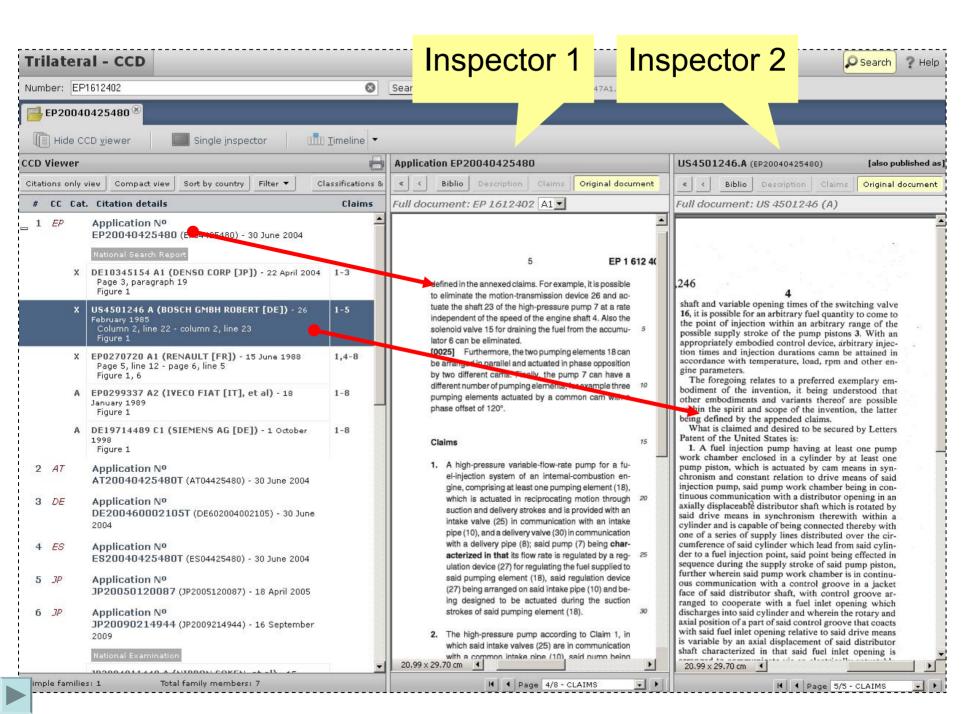
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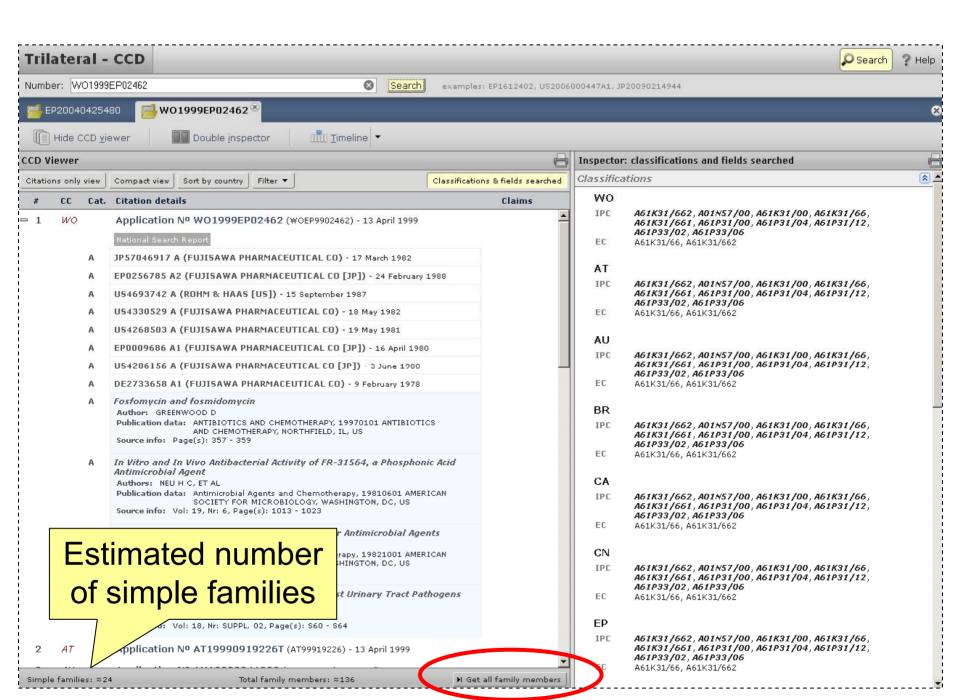


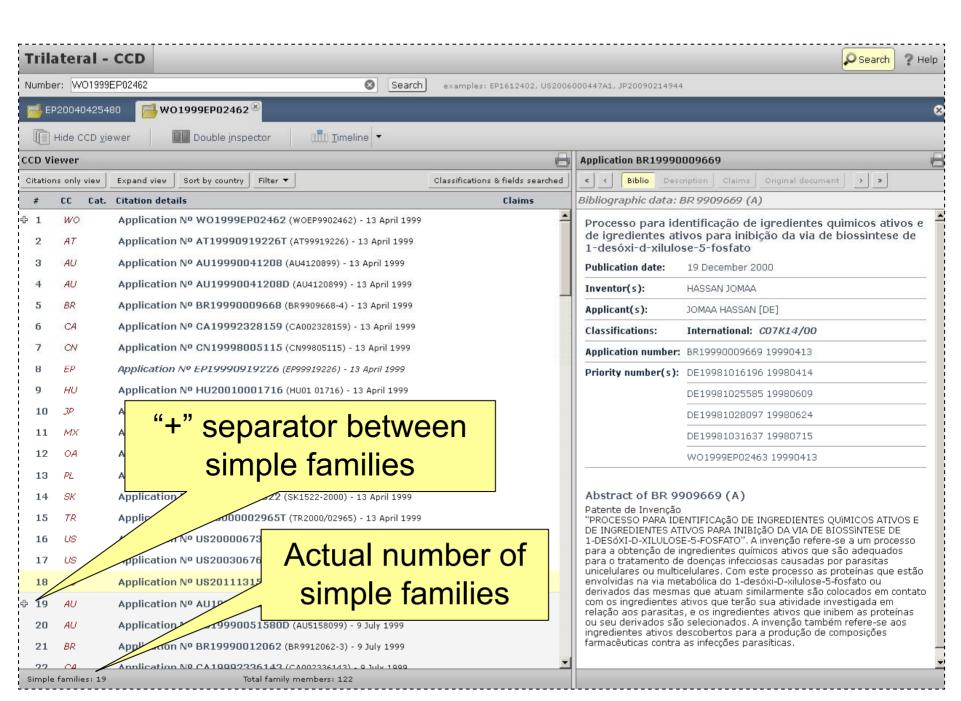


# CCD - citations only view









#### **REMINDER:** 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/liablity for quality patents