

Workshop on Examination in the PCT National Phase

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Options for Sub-regional Collaboration on Examination in PCT National
Phases

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Constraints to Patent Examination in the Region



- ▶ Relatively low numbers of patent applications (5-10/year avg. in some states)
- ▶ Difficulty in justifying acquisition of a Patent Examiner on staff based on low application numbers, if the national law requires substantive examination

Pragmatic Options



- ▶ Establish a regional or sub-regional patent administration system
- ▶ Outsource examination outside the region
- ▶ Leverage examination expertise within the region
- ▶ Develop examination expertise within the sub-region
- ▶ Utilise search and examination reports from other offices

Developing examination expertise within the sub-region

- ▶ Do you need complete capacity? Patent Examiners for each IPC art area, minimum documentation, search tools etc.
- ▶ Will they leverage the reporting from larger offices (e.g. the IP5, IPEAs)
- ▶

Sub-regional Patent Project



- ▶ Recognised similar applications being filed in multiple territories
- ▶ Outsourced substantive examination
- ▶ Offices provided with responses based on examination already performed by the IP5 and a few based on favourable Written Opinions
- ▶ Develop examination expertise within the sub-region
- ▶ Utilise search and examination reports from other offices

Sample results

| Year | Int'l App Number | Name of Applicant | Title of Invention | OECS states | Opinion/ equivalent | Action |
|------|-------------------|------------------------------|--|------------------|----------------------------|--------------------------------------|
| 2015 | PCT/US2014/026461 | University of North Carolina | Method of Treating Pancreatic and Liver Conditions by Transplantation of Stem cells into Bile Duct Walls | A, SKN | Method of treatment claims | Refuse |
| | PCT/US2014/023388 | Forma Therapeutics Inc. | Novel Compounds and Compositions for Inhibition of FASN | A, D, SKN, SV | EP 2 968 316 B1 | Amend to conform to EP 2 968 316 B1 |
| | PCT/FR2013/052670 | Laboratoire HRA-Pharma | Co-Micronisation Product Comprising Ulipristal Acetate | A, SV | EP 2 916 871 B1 | Amend to conform to EP 2 916 871 B1 |
| | PCT/FR2013/052671 | Laboratoire HRA-Pharma | Co-Micronization Product Comprising A Selective Progesterone-Receptor Modulator | A, SV | EP 2 916 823 B1 | Amend to conform to EP 2 916 823 B1 |
| | PCT/FR2013/052952 | Laboratoire HRA-Pharma | Solid Dispersion of a Selective Modulator of the Progesterone Receptor | A, SV | EP 2 928 499 B1 | Amend to conform to EP 2 928 499 B1 |
| 2016 | PCT/IB2014/002991 | Crystal Lagoons Curacao BV | Floating Lake System and Methods of Treating Water within a floating lake | A, D, G, SKN, SV | US 9,920,498 B2 | Amend to conform to US 9,920,498 B2 |
| | PCT/IB2014/002891 | Crystal Lagoons Curacao BV | System and method for maintaining water quality in large water bodies | A, D, G, SKN, SV | US 9, 470,008 B2 | Amend to conform to US 9, 470,008 B2 |
| | PCT/IB2015/052010 | Gert Frederick Meyer | Method of and System or creating and managing a combined advertisement using a mobile device | A, D, G, SKN, SV | Method of doing business | Excluded from patentability |

| 2017 | PCT/US2009/06700 2 | Gilead Sciences Inc | Modulators of Toll Like Receptors | EP 2 818 469 (B1) | Amend to conform to EP 2 818 469 (B1) |
|------|-----------------------|----------------------------|---|-------------------|---------------------------------------|
| | PCT/US2015/051314 | Macrogenics Inc | Bi-specific monovalent disbodies that are capable of binding CD19 and CD3 and uses thereof | No opinion yet | Check again in 6 months |
| | PCT/US2010/034600 | Gilead Pharmasset LLC | Antiviral compounds | EP 3 309 157 (B1) | Amend to conform to EP 3 309 157 (B1) |
| | PCT/US2012/065681 | Gilead Pharmasset LLC | Condensed imidazolylimidazoles as antiviral compounds | EP 2 907 816 (B1) | Amend to conform to EP 2 907 816 (B1) |
| | PCT/IB2014/065981 | Crystal Lagoons Curacao BV | Suctioning device for large artificial water bodies | EP 3 217 854 (B1) | Amend to conform to EP 3 217 854 (B1) |
| | PCT/US2014/049388 | LIQWD Inc | Methods for fixing hair and skin | EP 3 001 809 (B1) | Amend to conform to EP 3 001 809 (B1) |
| | PCT/US2013/049119 | Gilead Sciences Inc | Inhibitors of hepatitis C virus | EP 3 159 345 (B1) | Amend to conform to EP 3 159 345 (B1) |
| | PCT/US2013/022997 | Gilead Sciences Inc | Apoptosis signal- Regulating Kinase inhibitor | EP 2 807 151 (B1) | Amend to conform to EP 2 807 151 (B1) |
| | PCT/IB2016/000305 | Suneel Navnitdas Parekh | Method of making a mercury based compound, methods of using the mercury based compound and uses of the mercury based compound | No opinion yet | Check again in 6 months |

Applicant Trends



- ▶ Most applications are for pharmaceuticals
- ▶ Higher proportion of environmental and renewable energy applications than in Trinidad and Tobago
- ▶ Many individual local inventors have not given deep thought to commercialisation
- ▶ Many of their inventions are not novel, non-obvious or industrially applicable



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