



# **Topic 1: Transparency of examination in the PCT National Phases**

## **opportunities & implications**

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PCT International Cooperation Division

**Cybercity**  
**October 19, 2021**

# Agenda

- Growing transparency because of work-sharing platforms
  - Diversity of examination work-products
    - Visible for other examiners
    - Visible for third parties
  
- Opportunities and implications for national phase examination
  - Enhancing efficiency & improving quality
  - Backlog
  - Quality Monitoring/Management

# Life cycle of a PCT patent family

## Intermediary examination work products

International (phase)  
Search Report (ISR) &  
Written Opinion (WO)

1<sup>st</sup> national phase  
search report (SR)  
& opinion

2<sup>nd</sup> national  
phase SR &  
opinion

3<sup>rd</sup> national  
phase SR &  
opinion

...

Up to 30 months

Maximum term of  
protection:  
20 years after FD

Priority Date (PD)  
or Filing Date (FD)  
of **International  
Application**

**National phase  
entries**

trigger national  
examination  
US, EP, KR, JP,  
CN, MY, IR, BH,  
PG, ....

**PCT family**

1<sup>st</sup> Grant  
(OFE in PPH)  
(often priority  
country)

2<sup>nd</sup> Grant

3<sup>rd</sup> Grant

...

Rejection  
Abandonment

## Final work products

# Work-sharing (using foreign work products)

- **PCT family**: all applications linked through same PCT application number
- **Growing transparency of national phase examination** because of **public work-sharing platforms**:
  - Global Dossier (via ESPACENET, [USPTO Global Dossier](#), J-PlatPat, CPQUERY)
  - WIPO CASE (most dossiers also publicly accessible through PATENTSCOPE)
  - National Patent Registers (see WIPO Patent Register Portal)
- Access to a large diversity of examination work-products (search reports, opinions, rejection rulings, claim sets granted; opposition rulings)
  - **Visible for examiners from any office: YOU**
  - **Visible for third parties (after publication): YOU**

# Current situation of transparency

For published applications:

- One can follow examination process of **IP5 offices (CN, EP, JP, KR, US) with only short delay** via Global Dossier
  - Similarly possible for more and more other offices (AU, CA, GB, IN, SG,...; via national registers or WIPO CASE)
  
- Read examination reports
  - In several languages by means of machine translation (GD)
  
- Differences become visible as well; for example, by using tools like the Common Citation Document ([CCD](#)) for comparing the list of citations used by different examiners.
  - Identify citations found and used by one examiner only

# Delay of public access to office action

**Date of dispatch or receipt**

- 03.01.2020 Communication regarding the transmission
- 03.01.2020 European search opinion
- 03.01.2020 Information on Search Strategy
- 03.01.2020 Supplementary European search report
- 11.12.2019 Search started
- 02.10.2019 Notification on forthcoming publication of bi
- 05.09.2019 (Electronic) Receipt
- 05.09.2019 Letter accompanying subsequently filed ite
- 05.09.2019 Matter concerning the application
- 13.08.2019 Communication regarding possible amendr
- 08.08.2019 Change to the inventor details

**3 weeks**

The supplementary search report has been based on the last set of claims valid and available at the start of the search.

1 EPO FORM 1503 03.82 (P04C04)	Place of search <b>Munich</b>	Date of completion of the search <b>13 December 2019</b>
CATEGORY OF CITED DOCUMENTS 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		
Examiner <b>Martínez Martínez, V</b>		

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  
 & : member of the same patent family, corresponding document

**Date of examiner action**

Date of posting in dossier? EPO: one day after dispatch

# Delay of public access to office action

28.05.2019	<a href="#">Issue Information including class</a>
08.04.2019	<a href="#">EFS Acknowledgment Receipt</a>
08.04.2019	<a href="#">Applicant Arguments/Remarks M</a>
08.04.2019	<a href="#">Fee Worksheet (SB06)</a>
08.04.2019	<a href="#">Amendment/Req. Reconsiderati</a>
08.04.2019	<a href="#">Claims</a>
22.01.2019	<a href="#">Examiner's search strategy and</a>
22.01.2019	<a href="#">Index of Claims</a>
22.01.2019	<a href="#">List of References cited by applic</a>
22.01.2019	<a href="#">List of references cited by exami</a>
22.01.2019	<a href="#">Non-Final Rejection</a>
22.01.2019	<a href="#">Bibliographic Data Sheet</a>
22.01.2019	<a href="#">Search information including clas</a>



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF  
**United States Patent and Trademark Office**  
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 www.uspto.gov

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/865,229	01/08/2018	Chien-Hwa Hwang	MDT-355	9228
96758	7590	01/22/2019	EXAMINER	
Law Office of Zheng Jin P.O.Box 731450 San Jose, CA 95173			ZEWDU, MELESS NMN	
			ART UNIT	PAPER NUMBER
			2643	
			MAIL DATE	DELIVERY DATE
			01/22/2019	PAPER

Same day



Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Types of examination work products

- **Intermediary or pre-grant** work products
  - Search reports
    - basic list of citations (cited by examiner, by applicant)
    - enriched search reports (citation category X, Y, ...; relevant claims;...)
  - Search strategies
  - Written opinions, examination reports
  - Communications from applicant to examiner
  - Protocols of hearings
  - Third party observations
- **Final** work products/results
  - Granted claims; claims after opposition
  - Rejections; withdrawals following substantive reports; abandoned claims
- **Post-grant** work products/results
  - Additional prior art from opposition/re-examination/invalidation
  - Restricted claims
  - Communications between involved parties (3+)





**4. A METHOD FOR RECOVERING HYDROCARBON COMPOUNDS AND A HYDROCARBON RECOVERY APPARATUS FROM A GASEOUS BY-PRODUCT**

★ <b>Inventor:</b> TASAKA KAZUHIKO [JP]	<b>Applicant:</b> JAPAN OIL GAS & METALS JOGMEC [JP] INPEX CORP [JP] (+4)	<b>CPC:</b> B01D3/00	<b>IPC:</b> C10G2/00	<b>Publication info:</b> CA2752839 (A1) 2010-09-02 CA2752839 (C) 2014-02-18	<b>Priority date:</b> 2009-02-27
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Grant

**5. Method for collecting hydrocarbon compound from gaseous by-product and apparatus for collecting hydrocarbon**

★ <b>Inventor:</b> KAZUHIKO TASAKA	<b>Applicant:</b> JAPAN OIL GAS & METALS JOGMEC INPEX CORP (+4)	<b>CPC:</b> B01D3/00	<b>IPC:</b> C10G2/00	<b>Publication info:</b> CN102333846 (A) 2012-01-25 CN102333846 (B) 2014-01-29 <a href="#">Global Dossier</a>	<b>Priority date:</b> 2009-02-27
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Grant

**6. METHOD FOR COLLECTING HYDROCARBON COMPOUNDS FROM GASEOUS BY-PRODUCT AND APPARATUS FOR COLLECTING HYDROCARBON**

★ <b>Inventor:</b> Тасака, Казухико	<b>Applicant:</b> ДЖЭПЭН ОЙЛ, ГЭЭ ЭНД МЕТАЛЗ НЭШНЛ КОРПОРЕЙШН, ИНПЕКС КОРПОРЕЙШН, (+4)	<b>CPC:</b> B01D3/00	<b>IPC:</b> C10G2/00	<b>Publication info:</b> EA201170995 (A1) 2012-02-28 EA018772 (B1) 2013-10-30	<b>Priority date:</b> 2009-02-27
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Grant

publication kind code for grants B or C (sometimes A)

publication date

**7. METHOD FOR COLLECTING HYDROCARBON COMPOUND FROM GASEOUS BY-PRODUCT AND APPARATUS FOR COLLECTING HYDROCARBON**

★ <b>Inventor:</b> TASAKA KAZUHIKO [JP]	<b>Applicant:</b> JAPAN OIL GAS & METALS JOGMEC [JP] INPEX CORP [JP] (+4)	<b>CPC:</b> B01D3/00	<b>IPC:</b> B01D53/14	<b>Publication info:</b> EP2402418 (A1) 2012-01-04 EP2402418 (A4) 2012-11-21 <a href="#">Global Dossier</a>	<b>Priority date:</b> 2009-02-27
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No grant

Why?

**8. METHOD FOR COLLECTING HYDROCARBON FROM FT GAS COMPONENT AND APPARATUS FOR COLLECTING HYDROCARBON**

★ <b>Inventor:</b> TASAKA KAZUHIKO	<b>Applicant:</b> JAPAN OIL GAS & METALS JOGMEC INPEX CORP (+4)	<b>CPC:</b> B01D3/00	<b>IPC:</b> C10G2/00	<b>Publication info:</b> JP2010202677 (A) 2010-09-16 JP5301318 (B2) 2013-09-25 <a href="#">Global Dossier</a>	<b>Priority date:</b> 2009-02-27
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Grant



# European Patent Register

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<b>EP2402418</b>
European procedure
About this file
Legal status
Federated register
Event history
Citations
Patent family
<b>All documents</b>

**All documents: EP2402418** Dossier alert: RSS Email

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All documents(38)

<input type="checkbox"/> <u>Date</u> ▲	<u>Document type</u>
<input type="checkbox"/> 18.09.2017	<a href="#">Closing of application</a>
<input type="checkbox"/> 07.06.2017	<a href="#">Application deemed to be withdrawn ( translations of claims/payment missing from 01-04-2012)</a> ←
<input type="checkbox"/> 04.04.2017	<a href="#">Notice drawing attention to the payment of the renewal fee and additional fee</a>
<input type="checkbox"/> 21.12.2016	<a href="#">Bibliographic data of the European patent application</a>
<input type="checkbox"/> 21.12.2016	<a href="#">Communication about intention to grant a European patent</a> ←
<input type="checkbox"/> 21.12.2016	<a href="#">Intention to grant (signatures)</a>
<input type="checkbox"/> 21.12.2016	<a href="#">Text intended for grant</a>
<input type="checkbox"/> 21.12.2016	<a href="#">Text intended for grant (clean copy)</a>

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**Maintenance news** +

# Work-Sharing in the PCT national phase

Utilizing examination work products from other national phases for improving **efficiency** and **quality** requires

- **Databases/platforms** providing
  - Patent **family information** (family table) [>Topic 2]
  - **Examination status** of family members [>Topic 3]
  - **Access to examination work products** (**dossiers**, file wrappers) of family members [>Topic 3]
  
- Ideally, platforms which integrate this information in a user-friendly manner, e.g. within family table; and with additional tools, for example, for comparing work products (Common Citation Document - CCD)
  
- Information on differing national practices (naming and content of work products; important case law; exclusions; ..)

# Sources of family information

- **EPO's INPADOC database** is major source of such family information, accessible through:
  - Espacenet, EP-Register and CCD (simple and extended families; domestic families)
  - Other free patent information databases, like Depatis, Google Patents, ..
- **WIPO PATENTSCOPE**
  - aggregates **national phase entry data reported from Designated/Elected Offices** (obligation as from July 1, 2017; rule 95)
  - Proprietary family building (since 2021)
- **WIPO CASE** with proprietary family building based on application data shared by 'providing offices'; families are complex families (i.e. share at least one priority)
- **Commercial** patent databases obtain and use widely INPADOC data, and apply proprietary family building rules and data cleaning, e.g.
  - Clarivate/Derwent: WPI family
  - Questel/Orbit: Fampat family
  - ...
- Other specialized platforms, e.g. WIPO's [Pat-Informed](#) or MPP [MedsPal](#)
- India Form 3

# Source of family information: Espacenet

Europäischen Patentamt  
 European Patent Office  
 Office européen des brevets

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 Patent search

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**Bibliographic data: WO2007111918 (A2) — 2007-10-04**  
 In my patents list EP Register Report data error Print

**HEAT PROCESSING SYSTEMS, APPARATUSES, AND METHODS FOR COLLECTION AND DISPOSAL OF INFECTIOUS AND MEDICAL WASTE**

Page bookmark [WO2007111918 \(A2\) - HEAT PROCESSING SYSTEMS, APPARATUSES, AND METHODS FOR COLLECTION AND DISPOSAL OF INFECTIOUS AND MEDICAL WASTE](#)

Inpadoc patent family

**Inpadoc ('extended') family**

Classification:
 

- international: A61B19/02; A61L11/00; A61M5/32; B09B3/00
- cooperative: A61B19/0288; A61L11/00; B09B3/0075; B09B3/0083; A61B2019/024; A61B2019/0294; A61B2019/0295; A61B2019/0296

Application number: WO2007US07071 20070322

Priority number(s): US20060785512P 20060323 ; US20060785548P 20060323

Also published as: [WO2007111918 \(A3\)](#) → [UY30238 \(A1\)](#) [US2007224077 \(A1\)](#) [TW200812650 \(A\)](#) → [PE12992007 \(A1\)](#) → more

**Priorities (here 2 US) create family relations**

**Abstract of WO2007111918 (A2)**

Translate this text into

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Various embodiments of systems and methods for collection and disposal of infectious and medical waste are disclosed. An embodiment includes a system with a body having a chamber that receives a container of medical waste. The chamber may include a canister that has limited access to the interior of the

**Simple family ('equivalents')**

WORLD INTELLECTUAL PROPERTY ORGANIZATION

WIPO PUBLIC

# Dossier Access and Status Information

- **Primary sources:** each jurisdiction defines how **authoritative (official)** patent information is published and the respective authority in charge
- **National Patent Registers** are **authoritative** sources for
  - national **legal status: all do (many online)**
  - national family relations (divisions, continuations)
  - national publications
  - online access to national **dossiers** (public file inspection): **some do**
- **Secondary sources (dossier access platforms):** one-stop shops to access information from several primary sources through a unified user interface (building on a table of the patent family); access with English user interface:
  - **Espacenet - Global Dossier** (public)
  - **USPTO - Global Dossier** (public)(Google Patents links to USPTO GD)
  - **J-PlatPat - One Portal Dossier** (=Global Dossierpublic)
  - **CPQUERY - Global Dossier** (registration required)
  - **WIPO CASE** (non-public)
  - **WIPO PATENTSCOPE** (public)



# SEARCH RESULT

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## JOURNAL

## INFORMATION

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Patent  Utility Model  Industrial Design  Trademark Help ?

PCT Application No.(FNA) ▼

Cellphone And SmartPhone

Search

Search result for : {FNA:PCT/EP13/058245}

Search from the result

Patent (1)

Utility Model (0)

Industrial Design (0)

Trademark(0)

Ranking ▼

Bibliography

Drawing

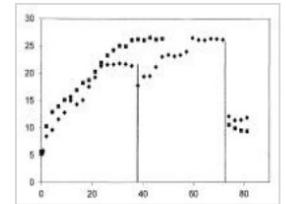
### Magnetic separation of particles including one-step-conditioning of a pulp

Appl.No.: AP/P/2014/008061 Patent No.: Status: Substantive examination

IPC: B03C1/01(2006.01)

Filing Date: 22.04.2013 Applicant: BASF SE.

The present invention relates to a process for separating at least one first material from a mixture comprising this at least one first material and at least one second material, which comprises contacting of the mixture comprising at least one first material and at least one second material at...



Legal status, no dossier access

Item per page : 10 ▼

<< < 1 > >>

# Global Dossier

- Initially IP5 initiative (initially labelled One Portal Dossier)
- Access to **IP5 Offices' file wrappers/dossiers**
  - always up-to-date because it is retrieved on-the-fly from IP5 national registers
  - Machine translation for non-English documents
  - Accessible via Espacenet, USPTO-GD, J-PatPLat, CPQUERY, Google Patents
  - Same data, only different user interface
- Access to **non-IP5 dossiers** of 'providing' Offices of WIPO-CASE
  - partly operational
- Espacenet interface with additional information/tools
  - Different types of families viewable (USPTO GD only extended family)
  - Inpadoc legal status
  - integrated access to **Common Citation Document (CCD)**:
    - viewing and comparing of citations from members of extended and simple families from AP, AU, CA, CN, DE, EA, EP, JP, KR, RU, TW, US, WO, ....
    - 'comparing': which examiners have seen a particular citation or an equivalent thereof



# Dossier access platforms

## WIPO-CASE (non-public) - Centralized Access to Search and Examination

- Accessible only for 'accessing' and 'providing' Offices
- 'Providing' offices share their dossiers with other participating offices:
  - IP5 dossiers obtained from GD/OPD (WIPO/EPO collaboration)
  - plus: AU, BN, CA, CL, GB, IL, IN, NZ, SG ..
- All ASEAN member offices are 'accessing' offices, only BN, SG are also 'providing'; others may become 'providing' in the near future
- Family information includes only so-called 'complex' families
  - Proprietary family building based on applications of 'providing' Offices recorded in CASE, and NPEs recorded in PATENTSCOPE
  - EPO INPADOC family data are not integrated
- No plans to open CASE to the public
- Majority of dossiers are also publicly accessible through PATENTSCOPE 'document' tab (labelled as 'Global Dossier')

# Dossier access platforms

## PATENTSCOPE

- Public access to WIPO CASE dossiers through 'document' tab (labelled as 'Global Dossier')
- For jurisdictions which have authorized public sharing outside of CASE
- For some additional jurisdictions enabling deep-linking to their national registers
- Two distinct family tables
  - PCT family (National Phase Entries (NPE) reported to WIPO from Designated and Elected Offices)
    - only shown for WO publications
  - Additional proprietary family building based on simple family concept
  - EPO INPADOC family data are not integrated

# How different are examination results?

## Sample **WO2008035580**

- 2 JP priorities
- Extended family: 39 members
- Simple family: 35 members

Derived from kind codes of publications recorded in Espacenet

- **Simple** family: **grants** in AP, AU, CA, 2xCN, NZ, EA, EP, KR, MA, MX, MY, NZ, TW, UA, US, PH, VN, ....?
- **Extended** family: further grants in: 2xJP (priority country)
- **Pendency: 2-10 years**
  - 2006-09-20 earliest priority date
  - 2008-09-03 JP grant
  - 2016-10-26 EP
- Still pending in BH, LA,..

# Examples of grants: WO2008035580

## WO-A1 = AU-B2 = JP-B1

1. A plant cultivation system comprising:

- a nonporous hydrophilic film for cultivating a plant thereon, and
- a feeding means for supplying water or a nutrient fluid to the lower surface of said nonporous hydrophilic film in the absence of a hydroponic tank for accommodating water or a nutrient fluid and cultivating a plant therein.

AU, JP granted initial claims without any modification

## CA-C

1. A plant cultivation system comprising:

- a nonporous hydrophilic film for cultivating a plant thereon;
- a feeding means for feeding water or a nutrient fluid to the lower surface of said nonporous hydrophilic film,
- said feeding means comprising at least one layer which is a water impermeable material layer or a water absorbing material layer,
- said at least one layer is laid and extends under said nonporous hydrophilic film,
- wherein, when said feeding means comprises both the water impermeable material layer and the water absorbing material layer, the water absorbing material layer is disposed between said nonporous hydrophilic film and said water impermeable material layer and in contact with the lower surface of said nonporous hydrophilic film;
- and a drip tube as an irrigation means for supplying water or a nutrient fluid to the feeding means,
- said drip tube being disposed below said nonporous hydrophilic film in a manner such that water or a nutrient fluid supplied from the drip tube is fed to the lower surface of the nonporous hydrophilic film.

CA granted heavily modified claim

# Examples of grants: WO2008035580

## CA-C

1. A plant cultivation system comprising:
  - a nonporous hydrophilic film for cultivating a plant thereon;
  - a feeding means for feeding water or a nutrient fluid to the lower surface of said nonporous hydrophilic film,
  - said feeding means comprising at least one layer which is a water impermeable material layer or a water absorbing material layer,
  - said at least one layer is laid and extends under said nonporous hydrophilic film,
  - wherein, when said feeding means comprises both the water impermeable material layer and the water absorbing material layer, the water absorbing material layer is disposed between said nonporous hydrophilic film and said water impermeable material layer and in contact with the lower surface of said nonporous hydrophilic film;
  - and a drip tube as an irrigation means for supplying water or a nutrient fluid to the feeding means,
  - said drip tube being disposed below said nonporous hydrophilic film in a manner such that water or a nutrient fluid supplied from the drip tube is fed to the lower surface of the nonporous hydrophilic film.

## US-B2

1. A plant cultivation system comprising:
  - a nonporous hydrophilic film for cultivating a plant thereon,
  - a feeding means for feeding water or a nutrient fluid to the lower surface of said nonporous hydrophilic film in the absence of a hydroponic tank for accommodating water or a nutrient fluid and cultivating a plant therein,
  - said feeding means comprising at least one layer selected from the group consisting of a water impermeable material layer and a water absorbing material layer,
  - which is laid and extends under said nonporous hydrophilic film,
  - wherein, when said feeding means comprises both of said water impermeable material layer and said water absorbing material layer, said water absorbing material layer is disposed between said nonporous hydrophilic film and said water impermeable material layer and is in contact with the lower surface of said nonporous hydrophilic film,
  - and a drip tube as an irrigation means for supplying water or a nutrient fluid to said feeding means,
  - said drip tube disposed below said nonporous hydrophilic film in a manner such that water or nutrient fluid supplied from said drip tube is fed to the lower surface of said nonporous hydrophilic film;
  - wherein said nonporous hydrophilic film is a film which exhibits an electrical conductivity (EC) difference of 4.5 dS/m or less,
  - said EC difference being determined by a method comprising contacting water with a saline solution having a salt concentration of 0.5% by weight through said nonporous hydrophilic film, measuring the electrical conductivity of each of the water and the saline solution 4 days (96 hours) after the start of the contact, and calculating the difference in electrical conductivity between the water and the saline solution.

US granted even more restricted claim

# ISR: 2 category A documents only

INTERNATIONAL SEARCH REPORT		International application No. PCT/JP2007/067578
<b>A. CLASSIFICATION OF SUBJECT MATTER</b> A01G27/00(2006.01)i, A01G1/00(2006.01)i, A01G7/00(2006.01)i, A01G13/00(2006.01)i, A01G25/00(2006.01)i  According to International Patent Classification (IPC) or to both national classification and IPC		
<b>B. FIELDS SEARCHED</b>  Minimum documentation searched (classification system followed by classification symbols) A01G27/00, A01G1/00, A01G7/00, A01G13/00, A01G25/00  Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched Jitsuyo Shinan Koho 1922-1996 Jitsuyo Shinan Toroku Koho 1996-2007 Kokai Jitsuyo Shinan Koho 1971-2007 Toroku Jitsuyo Shinan Koho 1994-2007  Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)		
<b>C. DOCUMENTS CONSIDERED TO BE RELEVANT</b>		
Category	Citation of document, with indication, where appropriate, of the relevant part	Relevant page(s)
A	JP 2001-292643 A (Taiyo Kogyo Kabushiki Kaisha), 23 October, 2001 (23.10.01) Full text; all drawings (Family: none)	
A	JP 2003-506051 A (E.I. Du Pont De Nemours & Co.), 18 February, 2003 (18.02.03), Full text; all drawings & US 6484439 B1 & WO 2001/010192 A1 & EP 1530896 A2	1-13

Only A documents  
 Only JP publications

# EP-A4: Supplementary EP search report



## SUPPLEMENTARY PARTIAL EUROPEAN SEARCH REPORT

Application Number

under Rule 62a and/or 63 of the European Patent Convention.  
This report shall be considered, for the purposes of  
subsequent proceedings, as the European search report

EP 07 82 8221

### 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 1 695 615 A1 (UNIV LAVAL [CA]) 30 August 2006 (2006-08-30) * paragraph [0011] - paragraph [0013]; figures * -----	1	INV. A01G27/00 A01G1/00 A01G7/00 A01G13/00 A01G25/00 A01G31/02

Also seen by CA and US examiners

US20070376748		US2006257213 A1 - 16 November 2006	
US20070376748		US2006257213 A1 - 16 November 2006	
EP20070828221	X	EP1695615 A1 (UNIV LAVAL [CA]) - 30 August 2006 * paragraph [0011] - paragraph [0013]; figure - *	1
US20070376748		CA2498077 A1 (UNIV LAVAL [CA]) - 23 August 2006	
US20070376748		CA2498070 A1 (SOLENO TEXTILES TECH INC [CA]) - 23 August 2006	

comparing citations in CCD

# Sample PCT/CA2013/00083

- **Granted:** AU, CA, MX
- **Rejected:** EP, US
- No NPE in CN, JP, KR
  
- ISA CA: category X in ISR
- Supplementary search by EP: Additional prior art of category X



# Family table for PCT NPEs sample cases

Case studies BH, LK, MY, TH, BT, PH, KH, LA workshops														
Status: Aug 17, 2016														
Simple Family														
National Application Numbers	PCT Member of Family	Size of Inpadoc Family	Number of Simple Families in Inpadoc Family	Grants	Withdrawn or Lapsed or Dead or Abandoned	Refused or Rejected	Pending	Earliest priority/first/last grant dates	Pending range	Grants but in Extended Family	Observations Observations ISR (only A?)	Observations lack of unity (in ISR, or national reports)	Supplementary prior art searches in national phases (e.g. EP-A4)	main claims available in English (different, equivalent, equal to WO-A1/2? To grants in other jurisdictions?)
BH 20080018 MY 149627A PH 1-2008-502595 TH?	<a href="#">PCT/KR2007/00247</a> 9 <a href="#">stable composition</a>	24	1	AU, CA, EA, EP, US, JP, CN, 2xKR, UA, MY, MA, MX, NZ, UA, (CR, SV, GT), <b>PH</b>			BH	2006-05-22 KR(2); 2009-09-18 KR; 2016-01-06 EP	3-10		only A ISA=KR	no, 2 KR grants are the 2 priorities	EP-A4 JP more than ISR AU more than ISR US more than ISR	<b>MY</b> equal to WO-A1 AU-B different to WO-A1: one substantial difference (lyophilizing) EP-B a bit narrower US-B only method (a bit narrower than AU) <b>PH</b> has US main claim as composition
BH 20090030 LA 96 MY 147396A PH 1-2009-500273 TH?	<a href="#">PCT/JP2007/06757</a> 8 <a href="#">plant cultivation</a>	34	7	AP, AU, 2xCN, US, NZ, CA, KR, EA, JP, MA, MX, MY, TW, UA, E(12g), <b>PH</b>			EP, BH	2006-09-20 JP(2); 2008-09-03 JP; 2014-04-01 TW	2-8+	JP	only A, only JP ISA=JP		EP-A4 CA, US more than ISR add prior art by CA seen also by US;	AU, JP, <b>MY</b> equal to WO-A1; CA is narrower; US narrower than CA <b>PH</b> mc equal to US mc
BH? KH 2012/0150 MY 156685A PH 1-2013-501448 TH?	<a href="#">PCT/JP2012/00023</a> 7 <a href="#">solid liquid separation</a>	16	1	AU, CA, CN, EP, JP, KR, MY, RU,				2011-01-24 JP(2); 2012-02-08 JP;	1-5		only A ISA=EP		JP, KR, US more than ISR	<b>AU, CA, mc equal to WO-A1</b>
BH 20080005 MY 150185A PH none TH?	<a href="#">PCT/EP2007/05301</a> 5 <a href="#">energy conversion</a>	19												
BH 20090006 MY 153238A PH 1-2009-500135 TH?	<a href="#">PCT/EP2007/05738</a> 0 <a href="#">cryogenic engine</a>	24												
BH 20090047 MY 151581A PH 1-2009-501523 TH?	<a href="#">PCT/JP2008/05010</a> 2 <a href="#">insulated tank</a>	30												
BH 20090066 MY 150324A PH none TH?	<a href="#">PCT/US2008/00119</a> <a href="#">remote control</a>	7												
BH 20090019 MY 151783A PH 1-2009-500417 TH?	<a href="#">PCT/EP2007/05816</a> <a href="#">compressed air engine</a>	25												
BH 20090028 MY 148768A PH 1-2009-500495	<a href="#">PCT/US2007/07432</a> 7 <a href="#">secure transaction</a>	21	1	AU, US, NZ, TW, GB, EA, MX, MY, UA,	US, <b>PH</b>	EP, KR, JP business method	BH	2006-09-18 US+EP, GB; 2009-01-07 GB; 2014-09-21 TW	3-8		Y, A; only US ISA=US		JP, US more than ISR AU only ISR	<b>AU</b> and US equal <b>different from WO</b> GB different from AU and US <b>MY</b> appears 2b equal to GB CA, EP and AU <b>different from</b> WO-A1; subtle differences of EP and AU re catalyst layer details; CA and AU very similar but no
BH 20080024 MY 150103A PH none TH?	<a href="#">PCT/JP2007/050357</a> <a href="#">polyolefin</a>	15	1	AU, CN, CA, KR, JP, EP, MX, MY, RU, FI			BH	2006-06-14 FI; 2010-11-15 FI; 2015-08-05 EP	4-9		X,Y ISA=EP		EP-A4 add EP prior art not seen by others AU only ISR	

Systematic analysis of samples of **pending cases** at workshops with

- Smaller IPOs: Bahrain, Sri Lanka, Laos, Cambodia, Qatar, Bhutan, Oman, Mongolia, Papua New Guinea, Pakistan, Iran
- Medium IPOs: Malaysia, Thailand, Philippines, Viet Nam, Indonesia

What work products are available for other PCT national phase entries in other jurisdictions, and how useful are they?

How to implement systematic passive work-sharing to make examination more efficient?

- Mostly older applications
- > more likely that national phase examination is completed

# Evidence & conclusions derived from sample set

- Large patent families: **10++ members**
  - Many work products from many other national phases can be utilized
- Large fraction of families with grants: **>95%**
  - **Most likely a patent can be granted; but which claims from which country are best?**
  - The first foreign grant (PPH; e.g. for the sake of speediness)?
- Wide range of pendencies: **3-10 years** after priority filing
  - What is backlog? How long to wait?
- **Granted claims substantially different** from claims granted in other jurisdictions: **>60%**
  - **Careful selection of suitable claim sets**
- Granted claims different from WO-A1/2 claims: **>90%**
- **Additional prior art searches in national phases: >90%**
  - Take into account for claim selection or decision to await further results
  - Do not solely rely on ISR
- Grants in some, rejections and withdrawals on other jurisdiction: **20%**
  - Carefully analyze reasons for rejections/substantial withdrawals

# Further Evidence for CII sample set

- Sample set of some 30 applications (Computer Implemented Inventions - CII) with examination completed in all IP5 jurisdictions
- Large PCT patent families: **10++ members**
- Large fraction of families with grants: **>95%**
- **Granted claims substantially different** from claims granted in other jurisdictions: **>60%**
  - because of different prior art, and
  - differing law (e.g., exclusions) and case law
- Grants in some, rejections and withdrawals in other jurisdictions: **39%**
- **Top-up searches in national phases: >90%**
- Additional relevant prior art (category X or Y) for at least one NPE: **85%**

# What are the opportunities of transparency?

- Examination work products are **easily visible**, after application is published, for
  - Examiners
  - Third parties
- Foreign examination work products are **usable** for
  - Examiners in national phase (improving efficiency and quality)
    - Particular opportunities for small offices with limited capacities
    - For treating backlog
  - Managers to monitor examination quality
  - **Third parties (you and/or competitors) to monitor prosecution, examination quality, prepare oppositions, ....**
- **General rule for examiners: Available** foreign examination work products **must not be ignored** for national phase examination
  - Even examination of PPH requests need to include a check if other work products from further national phases have become available, in particular relevant prior art.

# Form 3 of IP India

**PCT/EP2017/056134**

## UPDATED ANNEXURE TO FORM 3

Details of Foreign Applications corresponding to  
 INDIAN PATENT APPLICATION NO. 201817038931 FILED ON 15 October 2018  
 in the name of SOLVOTRIN THERAPEUTICS LTD  
 Corresponding PCT Application No. : PCT/EP2017/056134 Dated 15 March 2017

COUNTRY	APPLN. NO.	PCT FILING DATE	STATUS Such as pending, accepted, refused, abandoned, withdrawn, opposed etc.
United Arab Emirates	P6001293/2018	15/03/2017	Pending
ARIPO	AP/P/2018/011052	15/03/2017	Abandoned
Australia	2017232266	15/03/2017	Pending
Bahrain	167/2018	15/03/2017	Pending
Brazil	BR112018068571-2	15/03/2017	Abandoned
Canada	3,017,556	15/03/2017	Pending
Chile	2018002632	15/03/2017	Abandoned
China	2017800245532	15/03/2017	Response due by 11 February 2021
Colombia	CO2018010940	15/03/2017	Response filed on 1 October 2020
Costa Rica	2018-000488	15/03/2017	Pending
Cuba	2018-0108	15/03/2017	Abandoned
Djibouti	DJ/B/2018/0002	15/03/2017	Abandoned
Algeria	180499	15/03/2017	Pending
Eurasia	201892065	15/03/2017	Response to be filed by 21 March 2021
Ecuador	2018-77068	15/03/2017	Abandoned
Egypt	1439/2018	15/03/2017	Pending
EPO	17710019.5	15/03/2017	Pending

**India:** Obligation for applicants to disclose all PCT national phase entries and submit respective examination results

Due to increasing transparency such **disclosure requirements** may **not** be needed anymore

**47 national phase entries**

**Only 22 recorded in INPADOC**

Accessible via patent register of India [inPASS](#)

# Observations/Conclusions

- Duplication/repetition of work is not a bad thing as such
  - Improves the overall quality of patents
  - For PCT NPEs, examiners should **never** exclusively rely only on ISR/WO
  - However, work products become only gradually available and visible
  - Awaiting results from other national phases may be an option to enhance quality and efficiency, particularly in under-resourced Offices
  - Most recent or last grant is potentially of best quality
    - What does this mean for PPH?
- Suitable examination policies are required
- Currently examination of PCT NPEs starts in many jurisdictions at almost the same time; no coordination
- Cooperative examination would be the ideal way for improving
  - Quality of all patents of a family, and not just those ones granted last, and
  - Efficiency of procedures overall

# Observations/Conclusions

- Sharing of application and legal status data (including NPE) still needs to improve, e.g. for **regional cooperation**
- Family building needs to be expanded, in particular with a view to IPOs in emerging and developing economies
- Patent families are global: Only platforms for work-sharing with global coverage make work-sharing efficient
  - regional solutions are not really useful
- Which work-products from other national phases to use?
  - 'Trusted' Offices?

# Opportunities for WIPO

- Proper implementation of work-sharing will
  - strengthen sovereign patent prosecution of even small IPOs;
  - raise the confidence in the patent system; and
  - alleviate concerns towards patent grants from developed economies being imposed on developing economies
- WIPO perceived as impartial training organizer; ICET organized training doesn't promote
  - any single work-sharing platform (despite WIPO CASE); or
  - work products from any single jurisdiction
  - doesn't discriminate between small and large offices (EPO, for example, prioritizes larger offices)



# Sovereign national prosecution

## Paris Convention 1883:

- **No** obligation to follow/adopt conclusions of other IPOs or to use their results (Article 4bis)
- [http://www.wipo.int/treaties/en/ip/paris/summary\\_paris.html](http://www.wipo.int/treaties/en/ip/paris/summary_paris.html)
- Each IPO has obligation to observe national legislation
- Each IPO has responsibility/liability for quality patents
- Lawyers often refer to grants at other IPOs: just ignore that!

Thank you

[lutz.mailander@wipo.int](mailto:lutz.mailander@wipo.int)