



# Retrieval of Examination Work Products (AIPN) and Utilizing Claims Granted in Other Jurisdictions (PPH)

Masao Goto, JETRO Dubai





- Background for Work Sharing
- II. Patent Family
- III. Retrieving Examination Work Products (AIPN)
- IV. Utilizing Claims Granted in Other Jurisdictions (PPH)





- II. Patent Family
- III. Retrieving Examination Work Products (AIPN)
- IV. Utilizing Claims Granted in Other Jurisdictions (PPH)

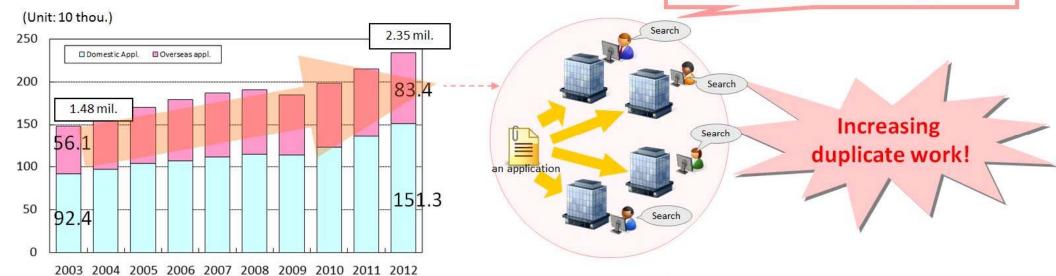




## **Growing Demand for Work Sharing**

Changes in Patent Appl. Filed throughout the Whole World

The number of applications filed in many offices is increasing.



Source: WIPO Industrial Property Statistics

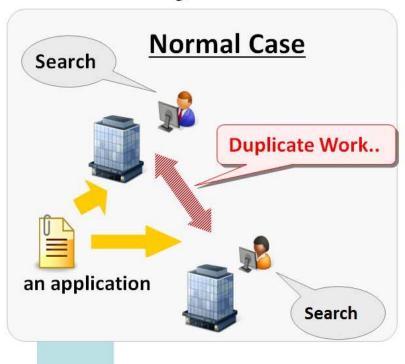
Year

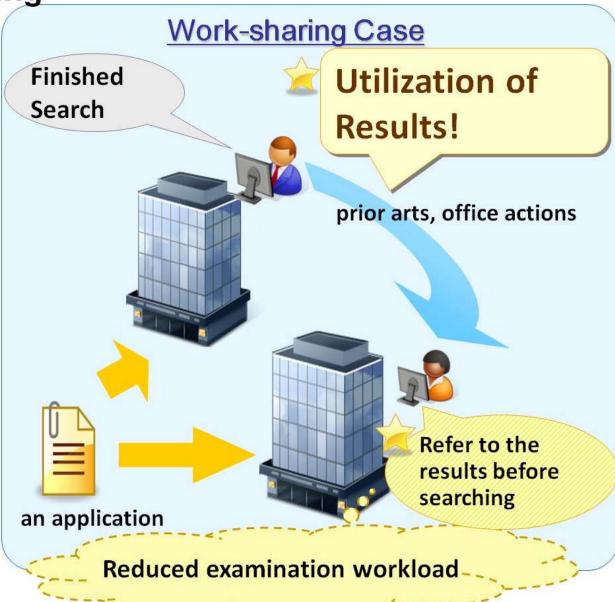
**Growing Demand for Work Sharing** 





**Efficiency of Work Sharing** 

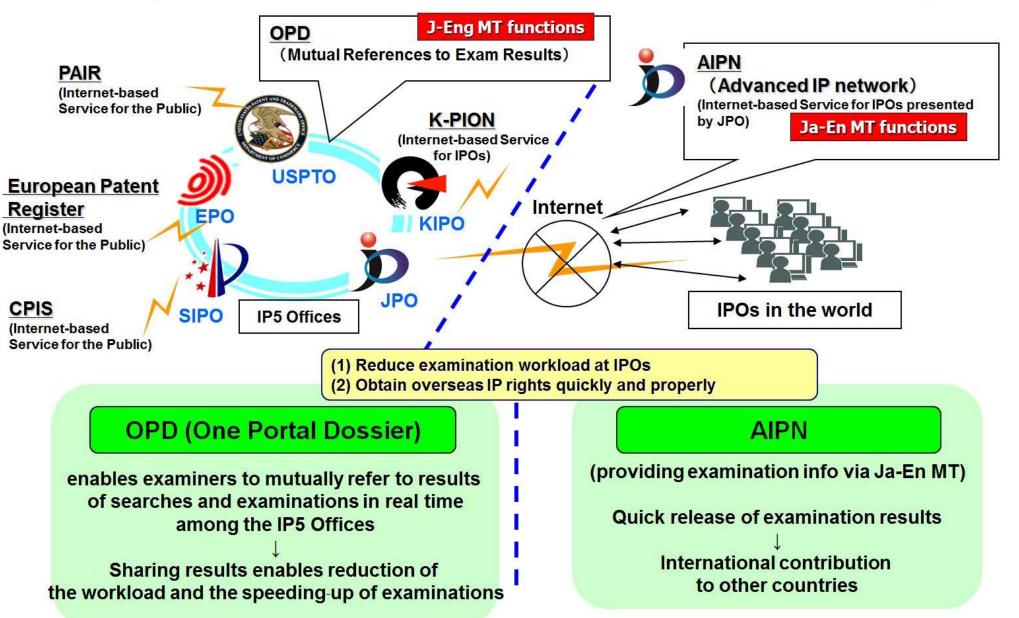








#### Mutual exploitation of search/examination results - Dossier Access System-







- I. Background for Work Sharing
- **II. Patent Family**
- III. Retrieving Examination Work Products (AIPN)
- IV. Utilizing Claims Granted in Other Jurisdictions (PPH)

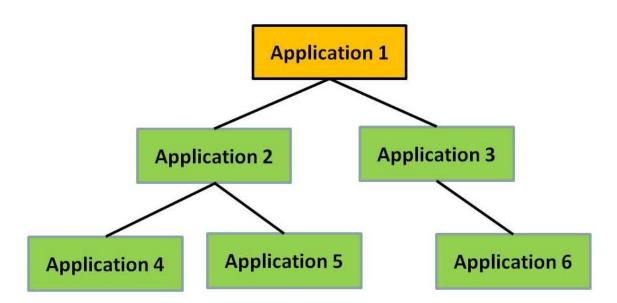
## II. Patent Family





#### A. What's Patent Family?

When a Patent application is filed in two or more countries based on the Paris Convention for Protection of Industrial Property, these patent applications form a "patent family."



## II. Patent Family

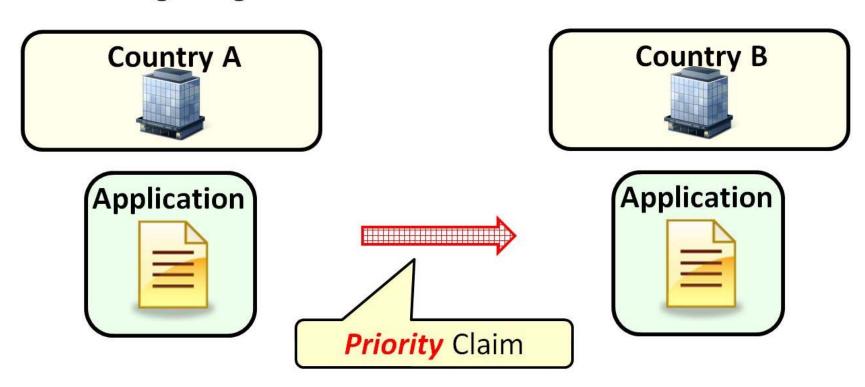




## B. Types of patent family -1/2

#### 1. Filings abroad:

Using Paris convention priority only PCT filing using Paris convention



## II. Patent Family

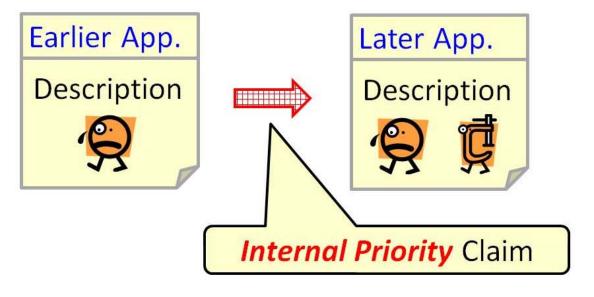




#### B. Types of patent family -2/2

2. National family (internal priority, divisional application)











- Background for Work Sharing
- II. Patent Family
- III. Retrieving Examination Work Products (AIPN)
- IV. Utilizing Claims Granted in Other Jurisdictions (PPH)





#### Overview of Sources to Retrieve Examination Work Products

- AIPN (JP)
   https://aipn.j-platpat.inpit.go.jp/AI2/cgi-bin/AIPNSEARCH
- Patentscope (WIPO)
   http://www.wipo.int/patentscope/search/en/search.jsf
- US-pair (US)
   http://portal.uspto.gov/external/portal/pair
- European Patent Register (EP)
   https://register.epo.org/espacenet/regviewer
- Other countries
   DPMAregister (Germany), K-PION(Korea), CPIS(China)





- 1. Overview of the AIPN -1/5
- Services Only for Examiners in the Foreign IP Offices
- <u>Dossier Information</u> and <u>Legal Status</u> of Published Applications Filed with the JPO
- English-translated Documents (Machine Translation)
- <u>Useful Tool for Referring to Examination Results</u> Provided by the JPO.





#### 1. Overview of the AIPN - 2/5

Advanced Industrial Property

Network (AIPN)

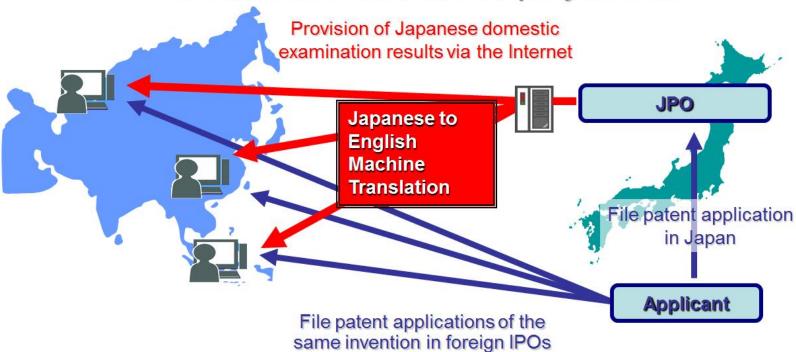
Provision of Japanese application information



#### Providing the JPO examination results to foreign IPOs in English

- (1) Reduction of examination workload in foreign IPOs
- (2) High-Quality Examination through AIPN members
- (3) An aid for applicants' smooth obtainment of IP rights

#### AIPN: Advanced Industrial Property Network

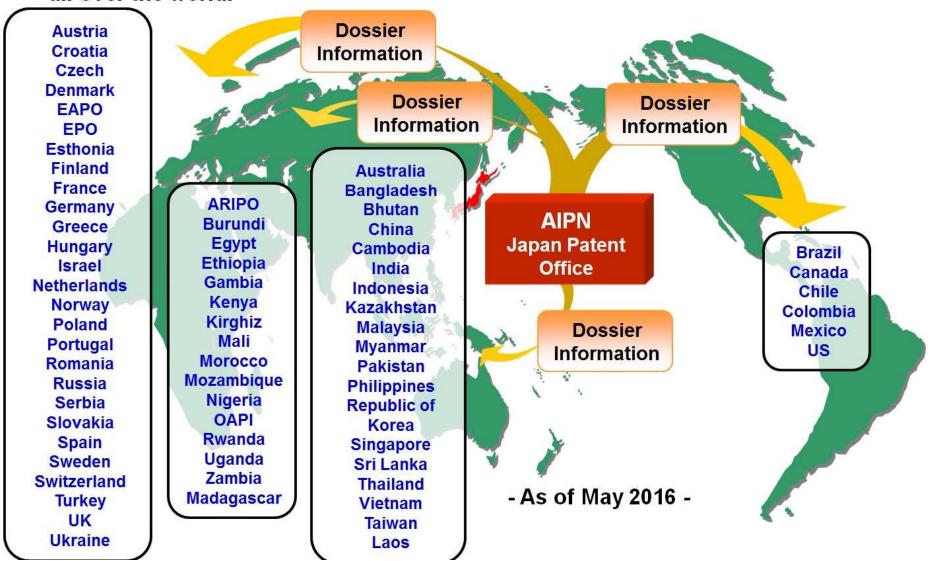






#### 1. Overview of the AIPN - 3/5

After the AIPN started servicing on 12 October 2004, now it is used by 68 IP Offices all over the world.







1. Overview of the AIPN - 4/5

#### Services of the AIPN

- Dossier Information
  - Specification, Office Actions, and Other Prosecution Documents
- <u>Legal Status</u> of the Application and Prosecution History
- Cited Documents / Patent Family Information





#### 1. Overview of the AIPN - 5/5

#### Updating Frequency of Databases in the AIPN

- File Wrapper Information
  - → after either an application is published or the application is registered as a patent
- Legal Status, Cited Documents
  - → every week\*

\*Legal status and cited documents will be available for browsing within AIPN at most a month later after either an application is published or the application is registered as a patent.

- Patent Family
  - → updated at any time





#### 2. Access to Dossier Information - 1/16

#### URL:https://aipn.j-platpat.inpit.go.jp/AI2/cgi-bin/AIPNSEARCH

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	ce is available to dary use such as			offices only. e to the third par	ty is prohibit	ed.
arch from	JAPANESE App	olication/Prio	rity/Publication	on/Patent Numb	er	
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		eg. 2015-00012X				
Display Typ	oe .	● File Wra	apper Informati	on © Patent Fam	nily	
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Application Priority Nu Select up to 3 Dictionary1	Number eg. U	IS-2015-00012X ries in order of p			(	Submit

This is the User Interface of AIPN.

<u>"File Wrapper Information"</u> and <u>"Patent Family"</u> are retrievable with the AIPN.

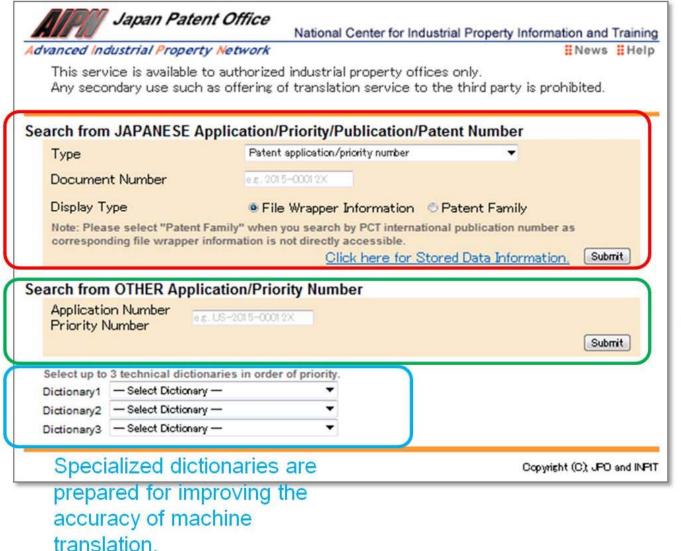
Search results are provided in English through the machine translation.

Since AIPN provides
specialized dictionaries, users
are able to select some of them
to improve accuracy of the
machine translation.





#### 2. Access to Dossier Information - 2/16



Search with JP document number, such as;

- · Application Number,
- Priority Number,
- Publication Number, or
- Patent Number.

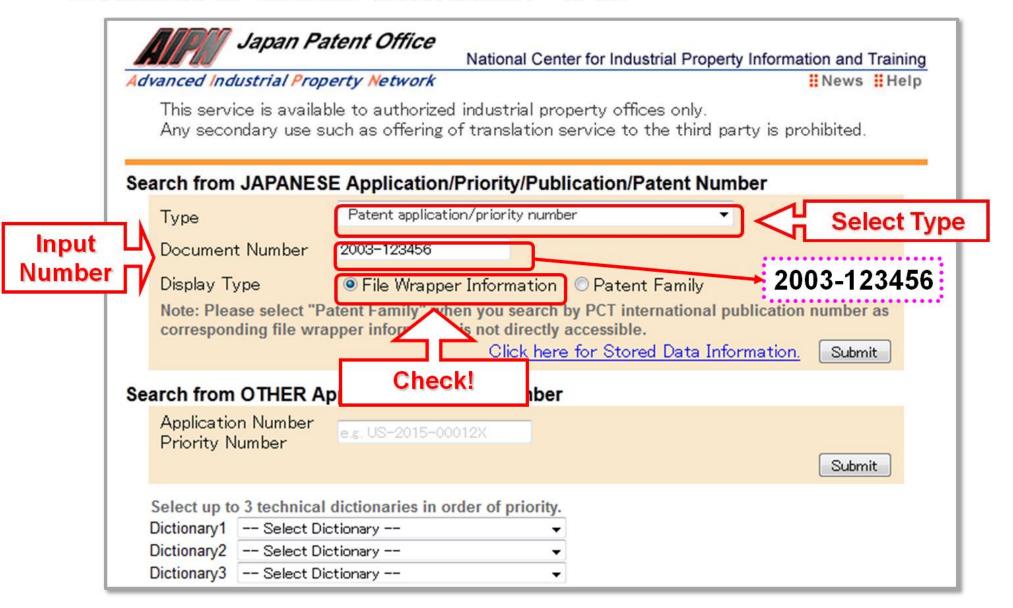
Search with foreign document number, such as;

- Application Number, or
- Priority Number.





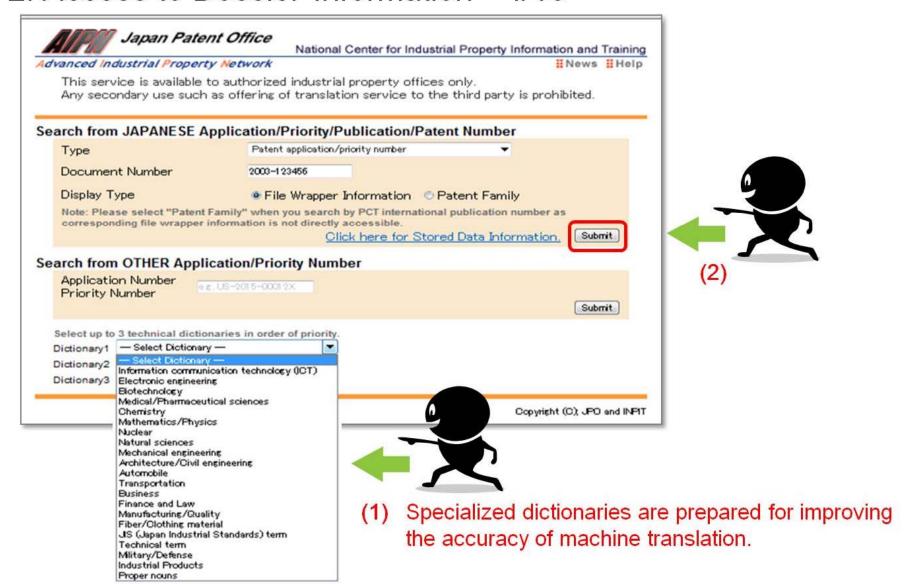
#### 2. Access to Dossier Information - 3/16







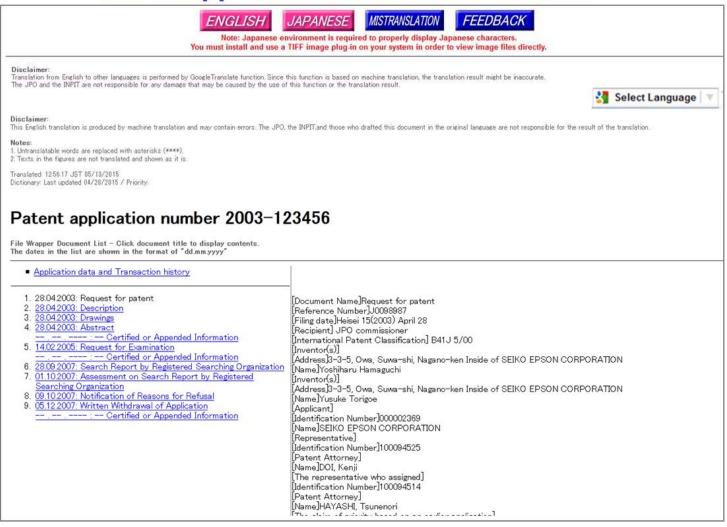
#### 2. Access to Dossier Information - 4/16







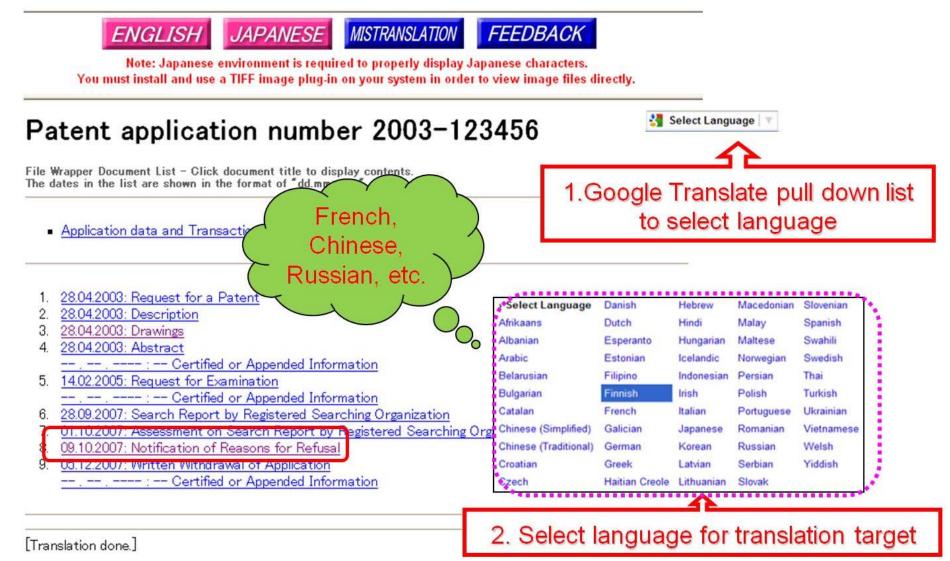
## 2. Access to Dossier Information - 5/16 File wrapper information search result







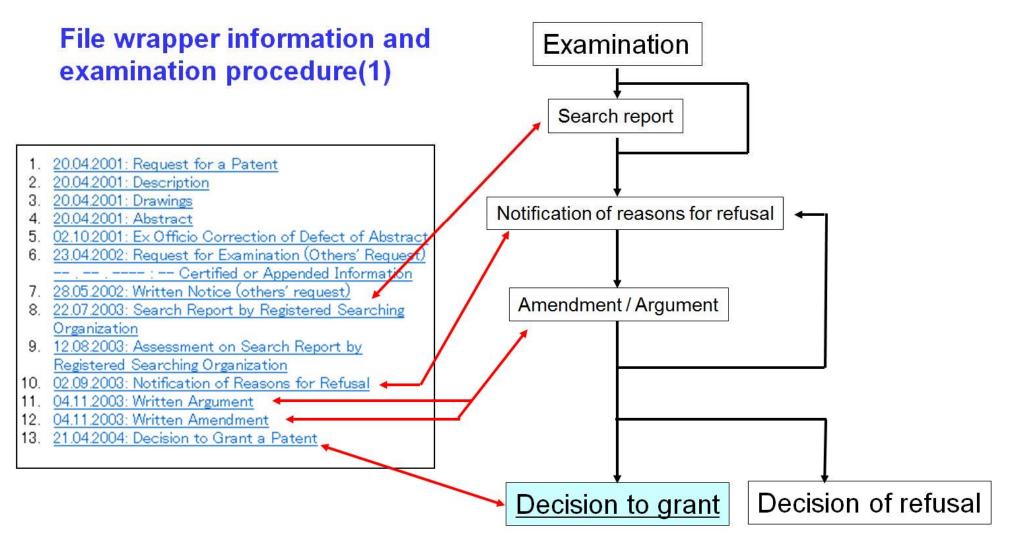
#### 2. Access to Dossier Information - 6/16







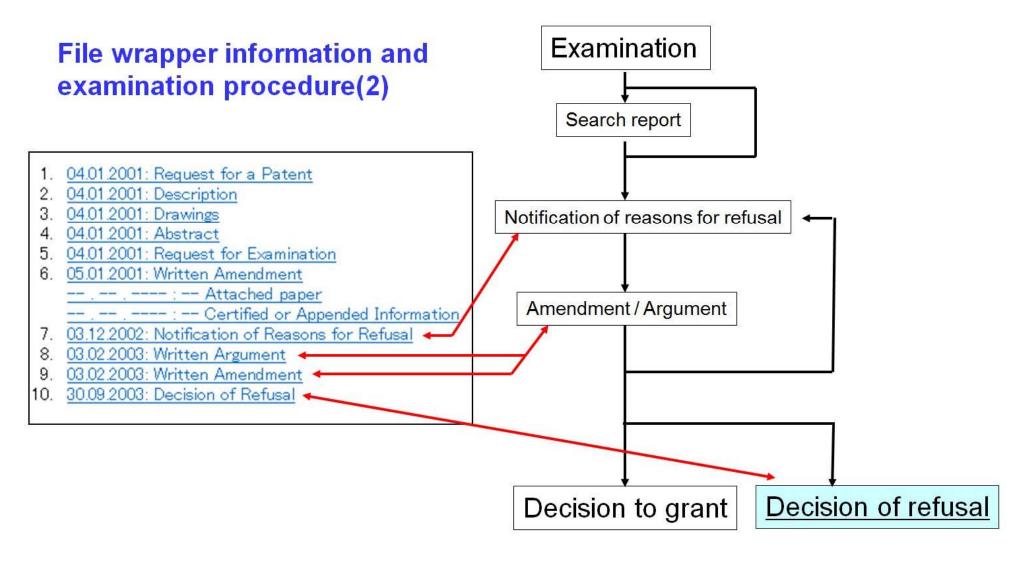
#### 2. Access to Dossier Information - 7/16







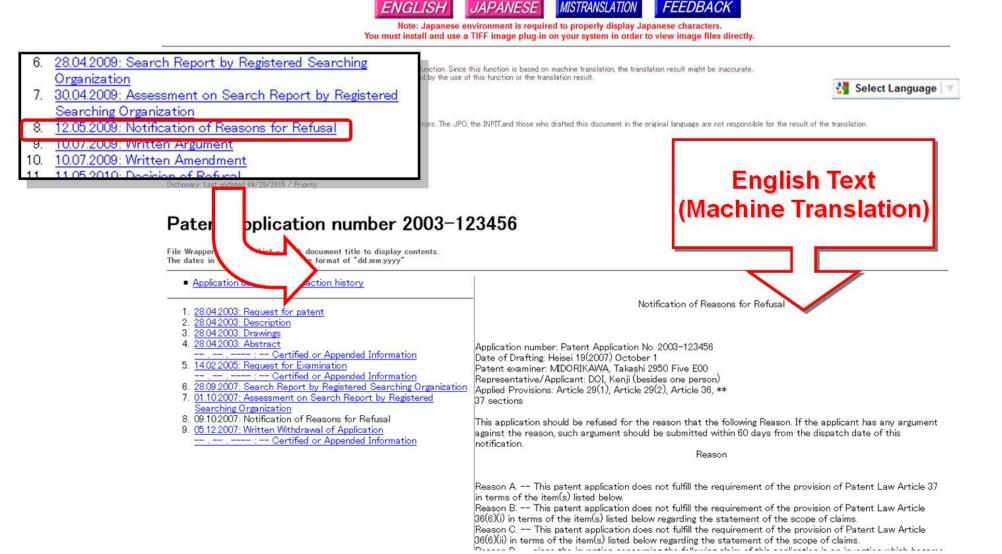
#### 2. Access to Dossier Information - 8/16







#### 2. Access to Dossier Information - 9/16

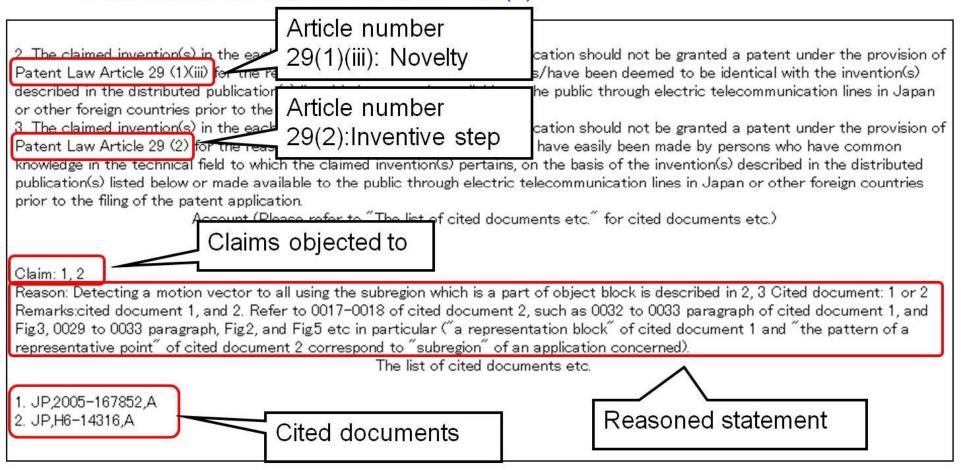






#### 2. Access to Dossier Information - 10/16

Notification of Reasons for Refusal (1)

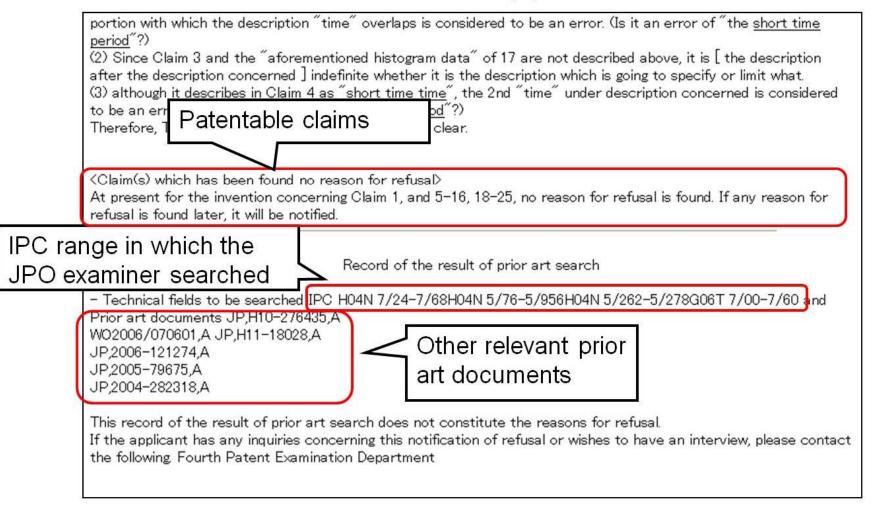






#### 2. Access to Dossier Information - 11/16

#### Notification of Reasons for Refusal (2)







#### 2. Access to Dossier Information - 12/16

## Patentability: Major Articles in the Japanese Patent Acts

29(1) Statutory subject matter / Industrial applicability

29(1)(iii) Novelty

29(2) Inventive step

29bis Secret prior art

39 Double patenting

36(6)(ii) Clarity of claims

36(6)(i) Requirement of support in description

36(4)(i) Enablement requirement

37 Unity of invention

17bis(iii) New matter in amendment





#### 2. Access to Dossier Information - 13/16

#### **Decision to Grant a Patent**

#### Decision to Grant a Patent

#### Bibliographic data

Application number: The application for patent 2005-090000

Date of Drafting: Heisei 20(2008) October 15

Patent examiner: Tokkyo, Taro

Title of invention: An information processing method, a computer program, and

an information processor The number of claims: 5

Applicant: AAA LIMITED Representative: DAIRI, Nin

About this application, since no reason for refusal is found, Decision to Grant a Patent is rendered.





## Access to Dossier Information - 14/16 Decision of Refusal (1)

#### Decision of Refusal

#### Bibliographic data

Application number: 2005-090000

Date of Drafting: Heisei 20(2008) November

Patent examiner: Tokkyo, Taro

Title of invention: Peripheral processing unit which realizes a disposal method of a recognition impossible character, and a disposal method

for the same

Applicant: AAA

Representative: DAIRI, Nin (besides one person)

#### Conclusion

About this application, it should refuse by the [Reason 3] written in the Notification of Reasons for Refusal as of Heisei 20(2008) June 6. Although the contents of Written Argument and the Written Amendment were examined, the antecedent basis which is sufficient for reversing reasons for refusal cannot be found out.





## 2. Access to Dossier Information - 15/16

Decision of Refusal (2)

#### Remarks

#### Account

Examiner's Opinion

Cited Parts

[ however the constitution (refer to [0020] and [0027]) of the invention indicated to cited document 1 which it supposes "it is an abnormal condition when a recognition result is with / of three or more characters / a reject" ] It corresponds with the constitution of the invention concerning Claim 1 of an application concerned judged as "There are more predetermined signs after the end of character reading and recognition operation than a predetermined number", [ what an abnormal termination step is performed for in the case of an abnormal condition (error) ] Considering it as the invention which has composition which performs an abnormal termination step when there are more predetermined signs than a predetermined number, and relates to Claim 1 of an application concerned after the end of character reading and recognition operation is that the person skilled in the art could accomplish easily. About the invention concerning the Claims 2-10 of an application concerned as well as above-mentioned Claim 1, a person skilled in the art can invent easily.

Rejected Claims

When "For invention concerning the claims  $O-\Delta$ , no reason for refusal is found" is written clearly, the claims  $O-\Delta$  are allowable.





## Access to Dossier Information - 16/16 Decision of Refusal (3)

#### **List of Cited Documents**

The list of cited documents etc.

<u>1. JP,H6-15149,U</u> 2. JP,H7-296102,A

Documents of category "X" or "Y"

#### Time Limit of Response

Time Limit of Response

When this final decision has an appeal, a Commissioner of the Patent Office can be asked for a referee within 3 months after a day with delivery of the copy of this final decision (if a resident abroad has, it is less than 4 months) (Patent Law Article 121(1)). (Instruction based on Administrative Case Litigation Law Article 46(2))

To this final decision, a revocation suit can be raised only to the trial

To this final decision, a revocation suit can be raised only to the trial decision to the demand for trial about this final decision (Patent Law Article 178(6)).





#### 3. Access to Patent Family and Legal Status - 1/15

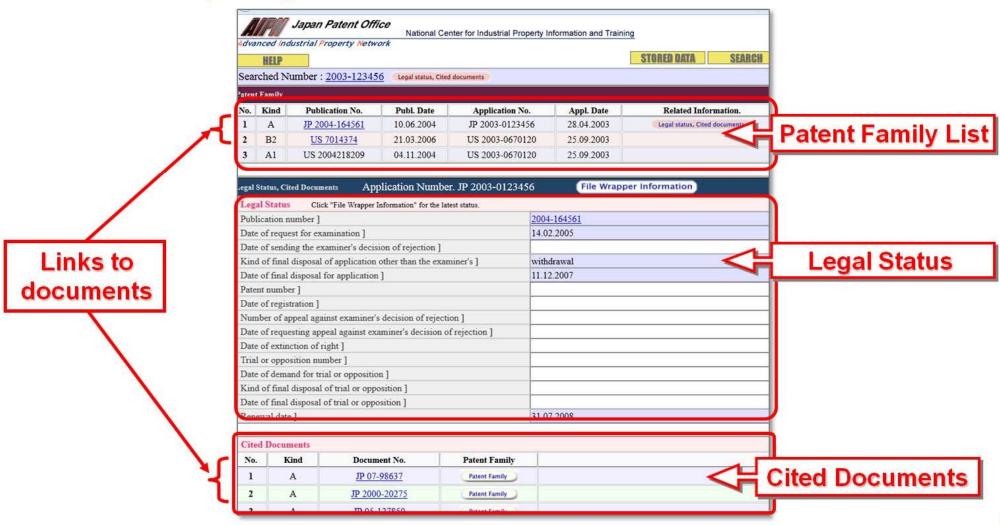
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arch from	JAPANESE Appli	cation/Priority/Public	cation/Patent Number
Туре		Patent application/priority	number
Documer	nt Number	2003-123456	
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	on Number	2015-00012X	Submit
Application Priority N	on Number eg. US-	2015-00012X	Submit
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#### 3. Access to Patent Family and Legal Status - 2/15

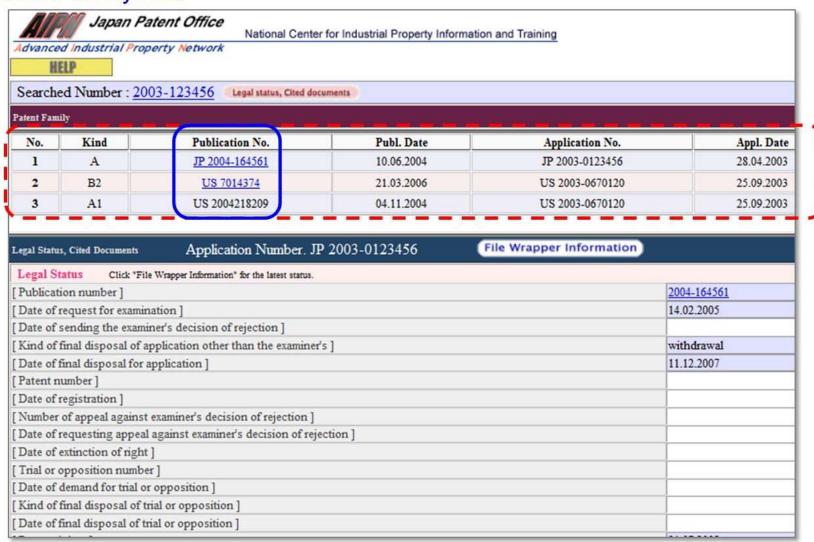
#### Patent Family & Legal Status Window







# 3. Access to Patent Family and Legal Status - 3/15 Patent Family List

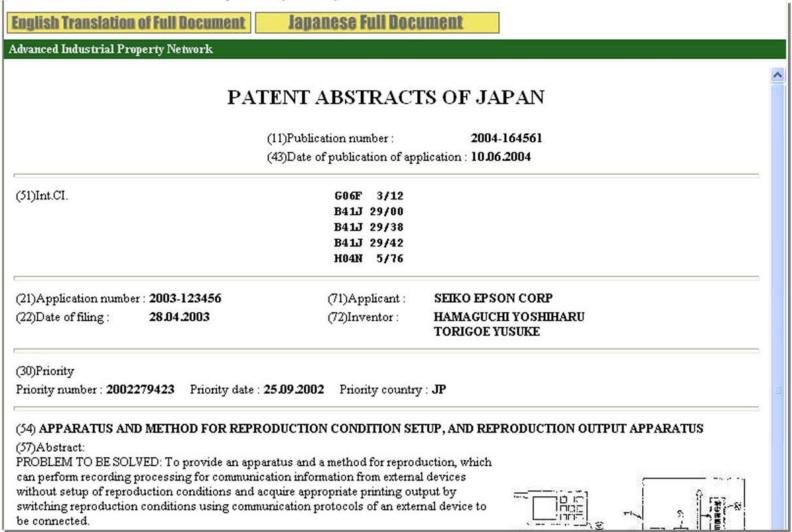






### 3. Access to Patent Family and Legal Status - 4/15

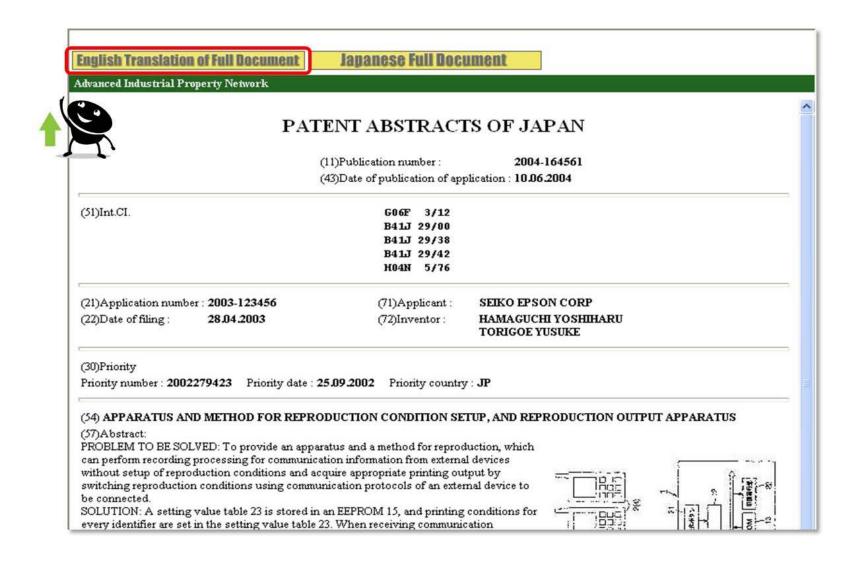
Patent Abstracts of Japan (PAJ)







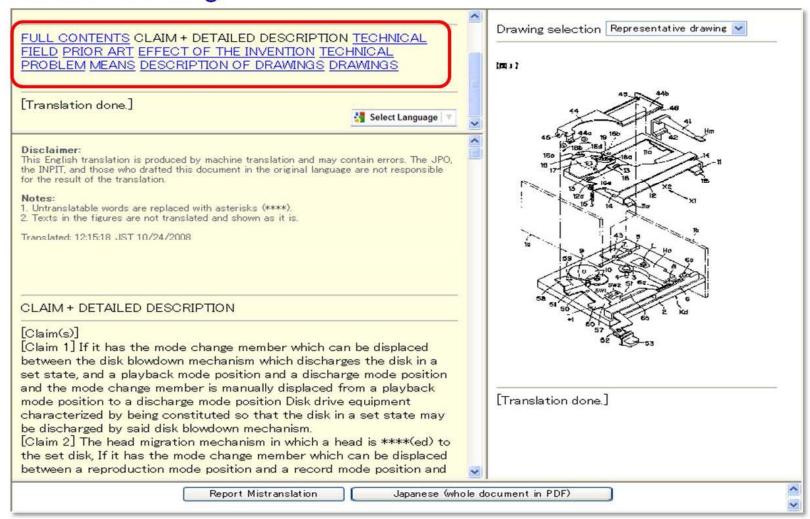
#### 3. Access to Patent Family and Legal Status - 5/15







# Access to Patent Family and Legal Status - 6/15 Document Screening

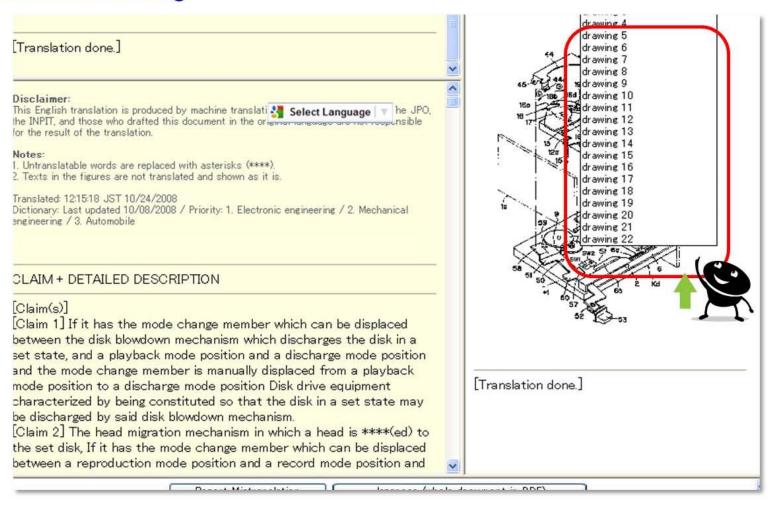






### 3. Access to Patent Family and Legal Status - 7/15

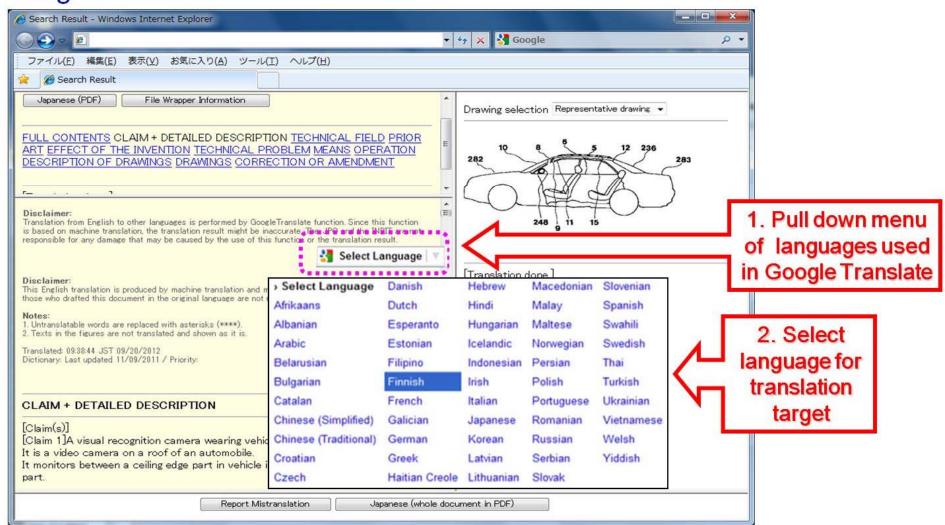
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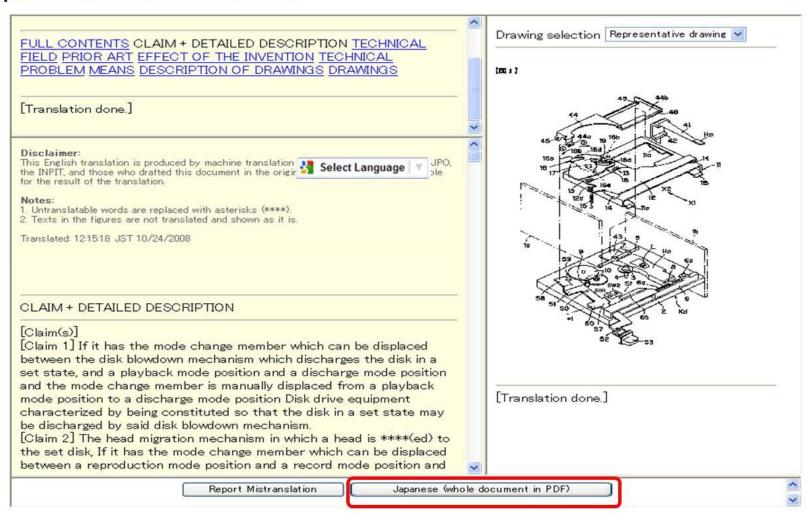
Access to Patent Family and Legal Status - 8/15
 Google Translate







# Access to Patent Family and Legal Status - 9/15 Japanese Document in PDF

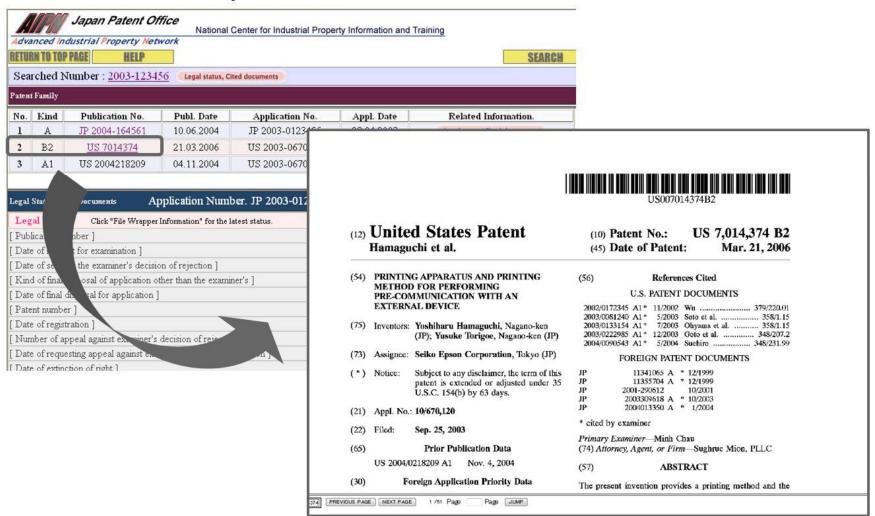






### 3. Access to Patent Family and Legal Status - 10/15

#### Link to Patent Family Gazette







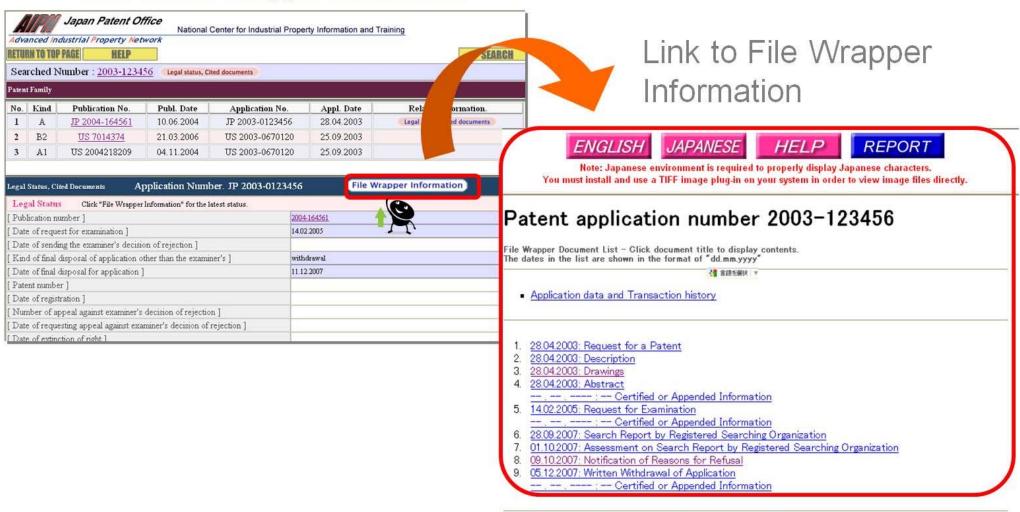
# 3. Access to Patent Family and Legal Status - 11/15 Legal Status & Cited Documents

No.	Kind	Publication No.	Publ. Date	Application No.	Appl. Date	Related Information.
1	A	JP 2004-164561	10.06.2004	JP 2003-0123456	28.04.2003	Legal status, Cited documents
2	B2	US 7014374	21.03.2006	US 2003-0670120	25.09.2003	
3	A1	US 2004218209	04.11.2004	US 2003-0670120	25.09.2003	L
Legal	Status, Cit	ed Documents A	pplication Numb	er. JP 2003-01234	56 File V	Vrapper Information
Leg	al Status	Click "File Wrapper	Information" for the 1	atest status.		
[ Publ	ication nu	mber ]			2004-164561	
Date	of reque	st for examination ]			14.02.2005	
Date	of sendir	ng the examiner's decisi	on of rejection ]			
Kino	of final o	disposal of application o	ther than the examir	ner's ]	withdrawal	
Date	of final d	lisposal for application ]	<u> </u>		11.12.2007	
Pate	nt numbe	r ]				
Date	of registr	ration ]				
Nun	nber of ap	peal against examiner's	decision of rejectio	n ]		
Date	of reque	sting appeal against exa	miner's decision of	rejection ]		
Date	of extino	tion of right ]				
Trial	or oppos	sition number ]				
Date	of dema	nd for trial or opposition	n ]			
Kind	of final o	disposal of trial or oppo	sition ]			
Date	of final d	lisposal of trial or oppos	sition ]			
Ren	ewal date	1			31.07.2008	





#### Access to Patent Family and Legal Status - 12/15 Link to File Wrapper Information

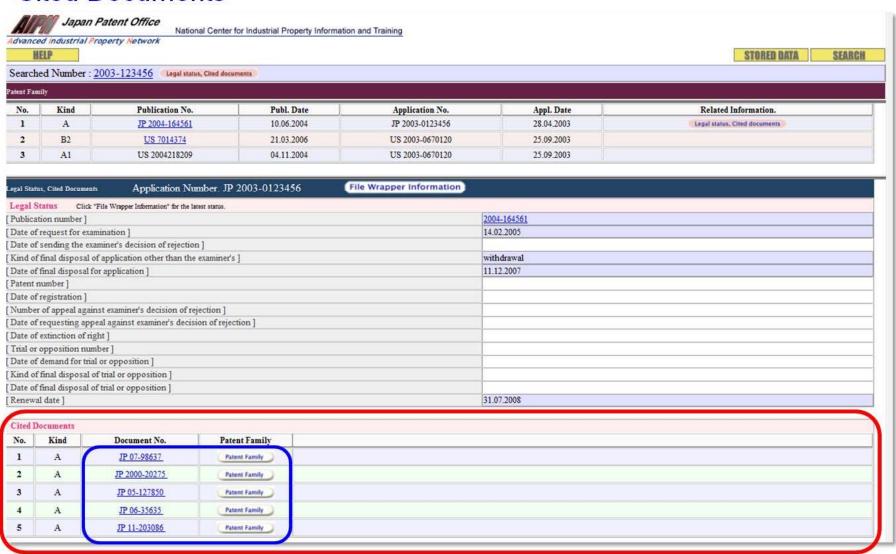


[Translation done.]





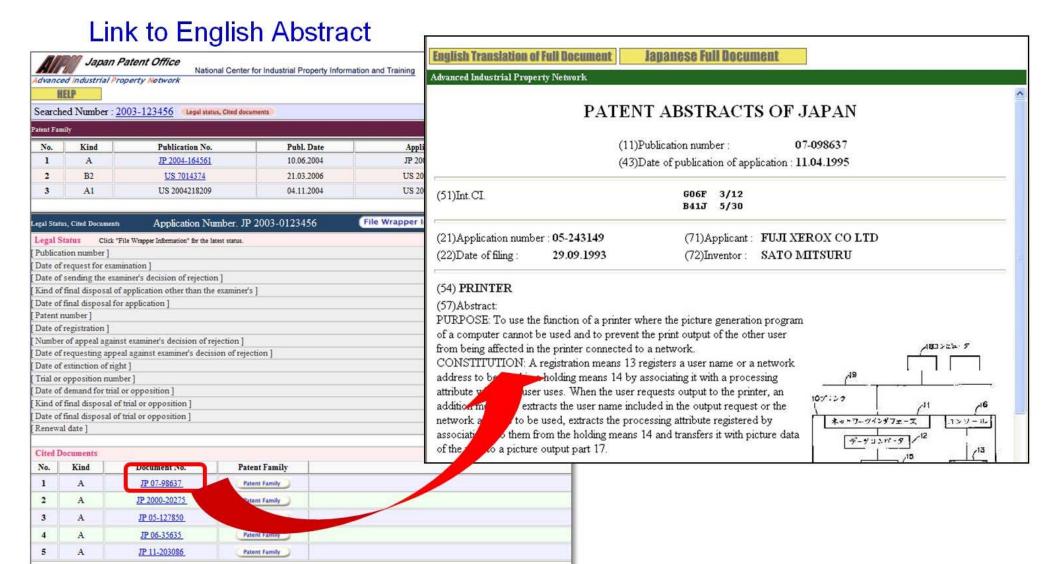
## Access to Patent Family and Legal Status - 13/15 Cited Documents







### 3. Access to Patent Family and Legal Status - 14/15

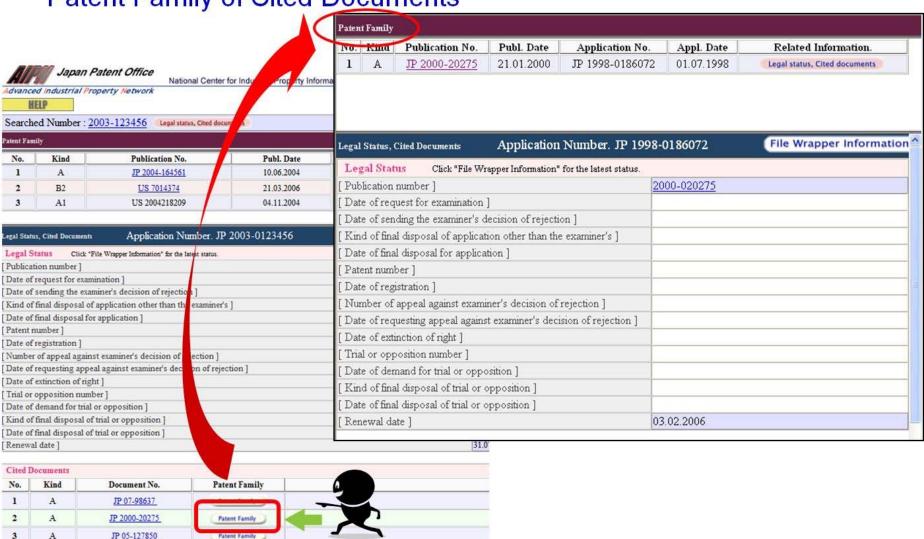






#### 3. Access to Patent Family and Legal Status - 15/15

Patent Family of Cited Documents





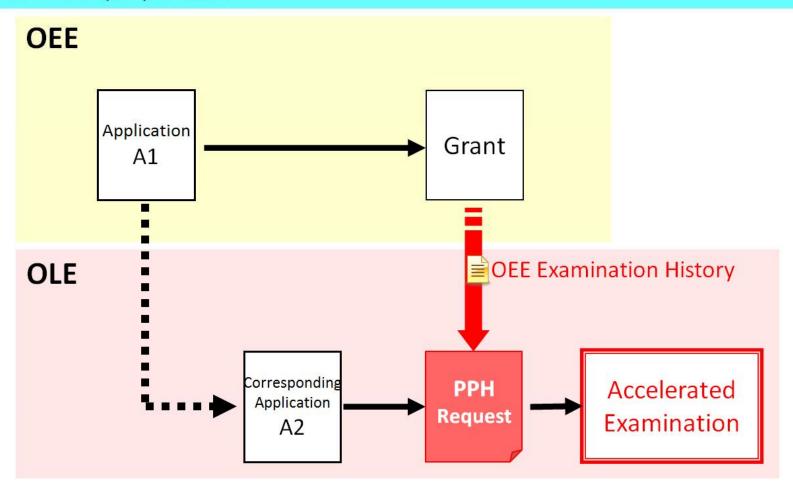


- Background for Work Sharing
- II. Patent Family
- III. Retrieving Examination Work Products (AIPN)
- IV. Utilizing Claims Granted in Other Jurisdictions (PPH)



#### Outline of the PPH

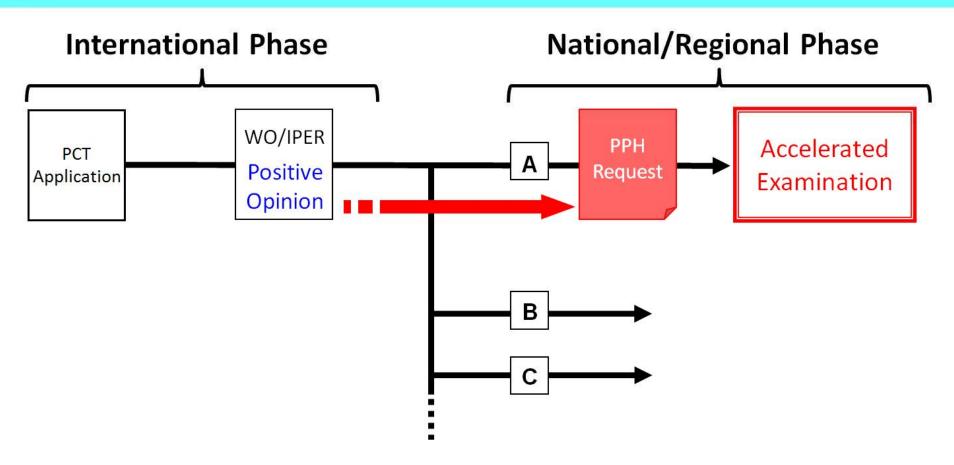
- The PPH (Patent Prosecution Highway) is a framework for Work-Sharing.
- When an application is determined to be granted in the Office of Earlier Examination (OEE), an applicant can request an accelerated examination in the Office of Later Examination (OLE) with the applicant's simple procedure.





#### PCT - PPH

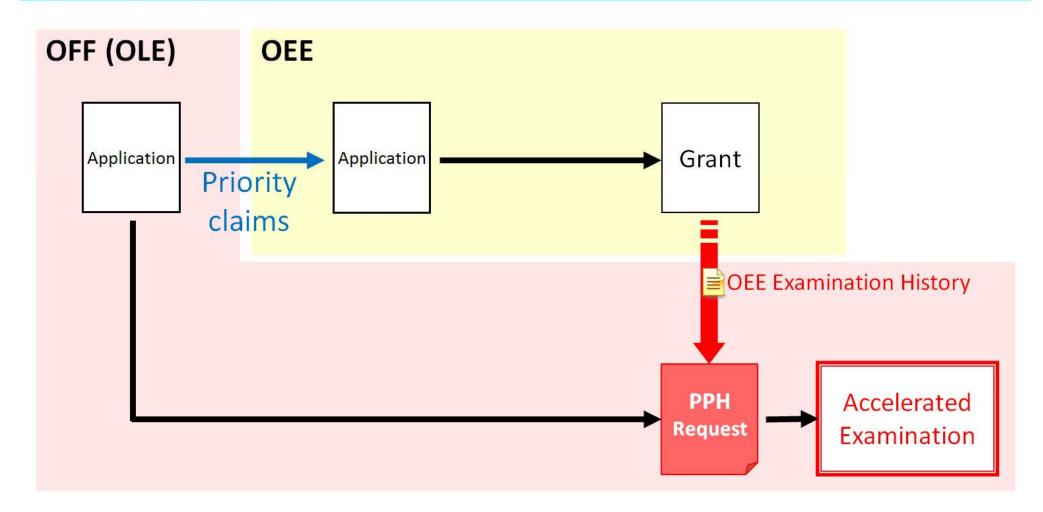
When a PCT application is determined to be patentable in its written opinion or international preliminary examination report, the PCT-PPH enables the applicant to request an accelerated examination on the corresponding domestic application based on the result of the PCT international phase.





#### PPH MOTTAINAI – 1/2

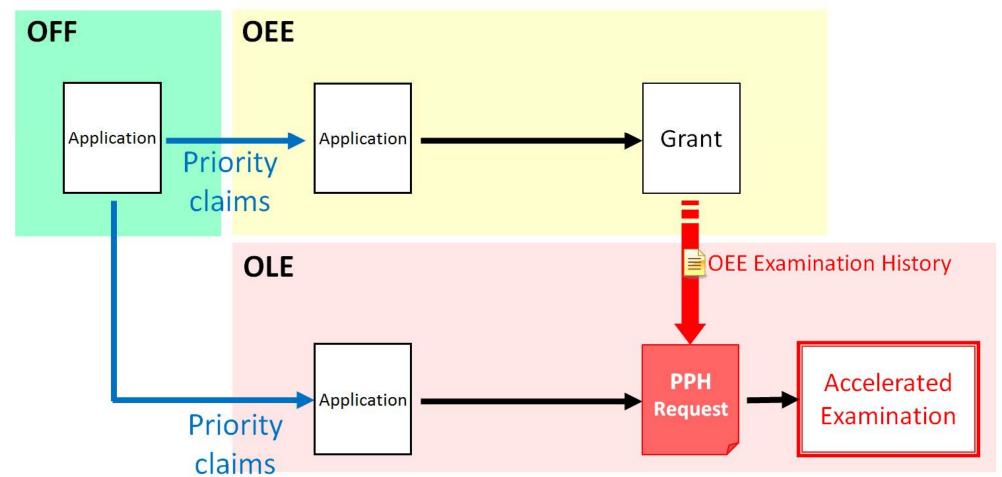
PPH MOTTAINAI allows applicants to use PPH when an application is determined to be granted by any one of participating patent offices in the framework.





#### PPH MOTTAINAI – 2/2

When some applications claiming priority based on the application filed in OFF and one of the applications is determined to be granted in OEE, the applicant can request PPH MOTTAINAI at OLE based on the result of OEE.







#### Merit of PPH For Patent Offices – 1/4

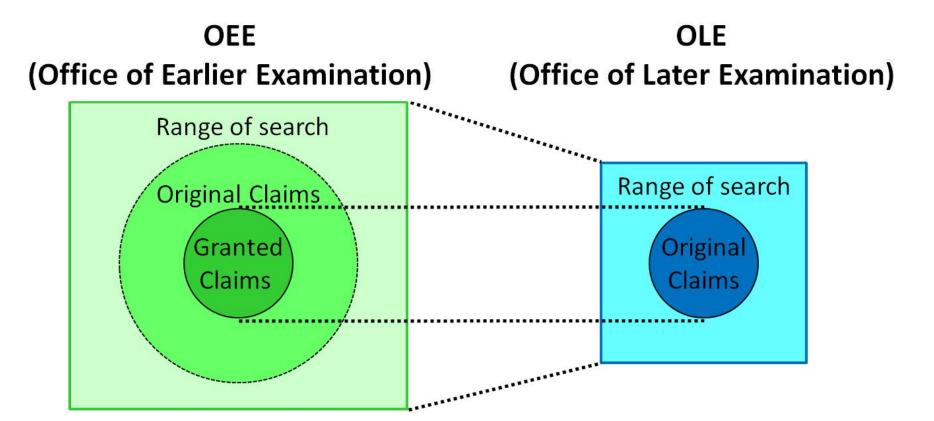
- 1. Limiting the range of search
- 2. Utilizing the examination history
- 3. Decreasing the number of office actions



#### Merit of PPH For Patent Offices – 2/4

Limiting the range of search

- Examiners in OLE examine the claims which are limited in advance to the claims granted by OEE.
- Therefore, the examiners in OLE can limit the range of search when they examine the claims in their office.

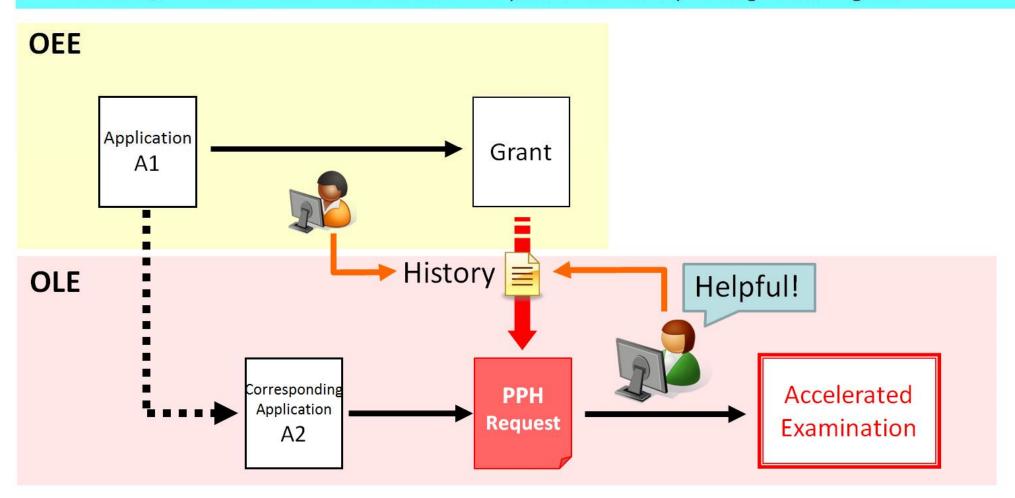




#### Merit of PPH For Patent Offices – 3/4

Utilizing the examination history

- The history contains a lot of useful information (office actions, search strategies, etc.).
- Therefore, the examiners in OLE can examine patents efficiently through referring to it.





#### Merit of PPH For Patent Offices – 4/4

Decreasing the number of office actions

PPH can decrease the number of office actions due to improved efficiency in OLE.



Average number of office actions

Period: Jul-Dec 2014

\*US All Appl.: Jan-Jun 2014

\*US PPH Appl.: Jan-Jun 2014

### IV. Utilizing Claims Granted in Other Jurisdictions(PPH) JPO JAPAN PATENT OFFICE JAPAN



### Merit of PPH For Applicants – 1/4

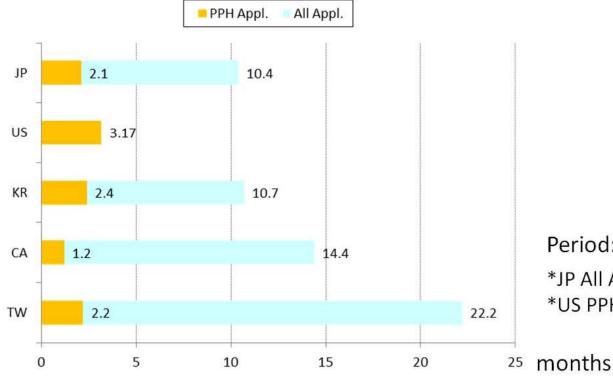
- 1. High speed
- 2. Low cost
- 3. High predictability



### Merit of PPH For Applicants – 2/4

High speed

PPH gives applicants accelerated examinations. An average pendency of first office action of PPH applications is much shorter than that of regular applications.



Period: Jul-Dec 2014

\*JP All Appl.: Mar 2014

\*US PPH Appl.: Jul-Dec 2014

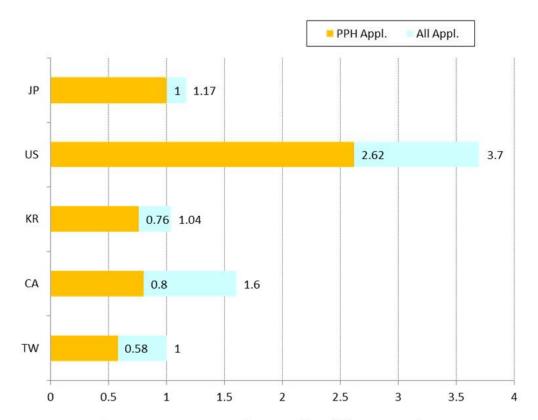
Average pendency from PPH or examination request to First Office Action



#### Merit of PPH For Applicants – 3/4

Low cost

Decreasing office actions enables applicants to reduce costs.



Average number of office actions

Period: Jul-Dec 2014

\*US All Appl.: Jan-Jun 2014

\*US PPH Appl.: Jan-Jun 2014



#### Merit of PPH For Applicants – 4/4

### High predictability

- The clams in OLE are the same as the claims already granted in OEE.
- Therefore, the applicants can have a high expectancy to obtain a decision to grant in OLE.



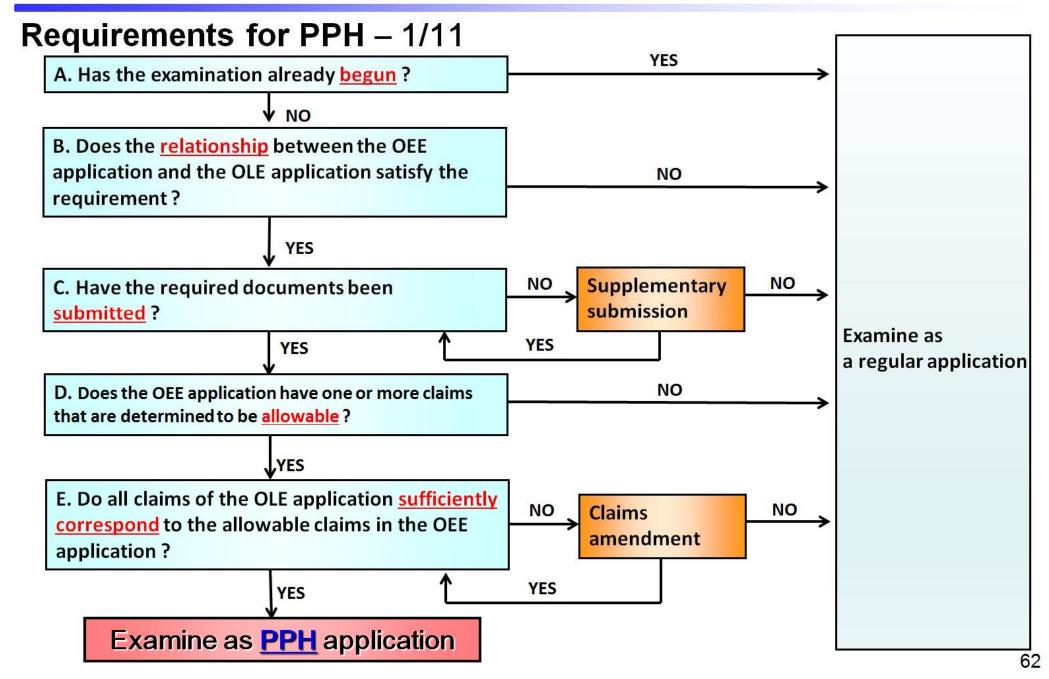
Period: Jul-Dec 2014

\*JP All Appl.: Jan. –Dec. 2013

\*US All Appl. & US PPH Appl.:

Jan-Jun 2014







### Requirements for PPH – 2/11

A. Has the examination already begun?

### PPH request form Check the status of Subject: Request for an accelerated examination under the PPH pilot program Date of filing: Date of filing PPH request your application Application number of OLE application Application number: Title of the invention: Applicant: Corresponding JPO Application number: Corresponding OEE application number Documents submitted: Copies of all office actions (which are relevant to substantial examination for patentability in the JPO) which were issued for the corresponding application by the JPO and translations of them Copies of all claims determined to be patentable/allowable by the JPO and translations of them Copies of references cited by the JPO examiner Claim correspondence table



#### Requirements for PPH – 3/11

B. Does the relationship between the OEE application and the OLE application satisfy the requirement?

#### Examples of particular relationship

The OLE application is:

- 1. an application which validly claims priority under the Paris Convention to the corresponding OEE application,
- 2. a PCT national phase application, or
- an application which validly claims priority under the Paris Convention to the PCT application(s)



### Requirements for PPH – 4/11

C. Have the required documents been submitted?

#### Required documents

- A copy of all claims determined to be allowable by the OEE, and its translation\*
- 2. Copies of all office actions of the OEE, and their translations\*
- 3. Documents cited by the OEE examiner\*\*
- 4. A claims correspondence table

(\*The applicant does not have to submit the copies if it is available via the dossier access system.)

(\*\*If a cited document is a patent document, the applicant does not have to submit it. )



### Requirements for PPH – 5/11

D. Does the OEE application have one or more claims that are determined to be allowable in the latest office action?

Patentable/ allowable claims in the latest office action by the OEE are indicated

#### Claims correspondence table

The claim filed to the OLE	The claim determined to be allowable in the OEE	Comments about the correspondence
1	1	Both claims are the same.
2	2	Both claims are the same except for the claim format.
3	1	Claim 3 in the OLE application adds composition A to claim 1 filed at the OEE.



#### Requirements for PPH – 6/11

Office actions which show allowable claim(s) in the **JPO** are:

- Decision to grant a patent
- 2. Notification of reason for refusal with the expression of "At present for the invention concerning Claim\_, no reason for refusal is found."
- 3. Decision of refusal (when one or more claims are not refused)
- 4. Appeal decision (to grant a patent)

See Appendix for the sample office actions in the JPO



### Requirements for PPH – 7/11

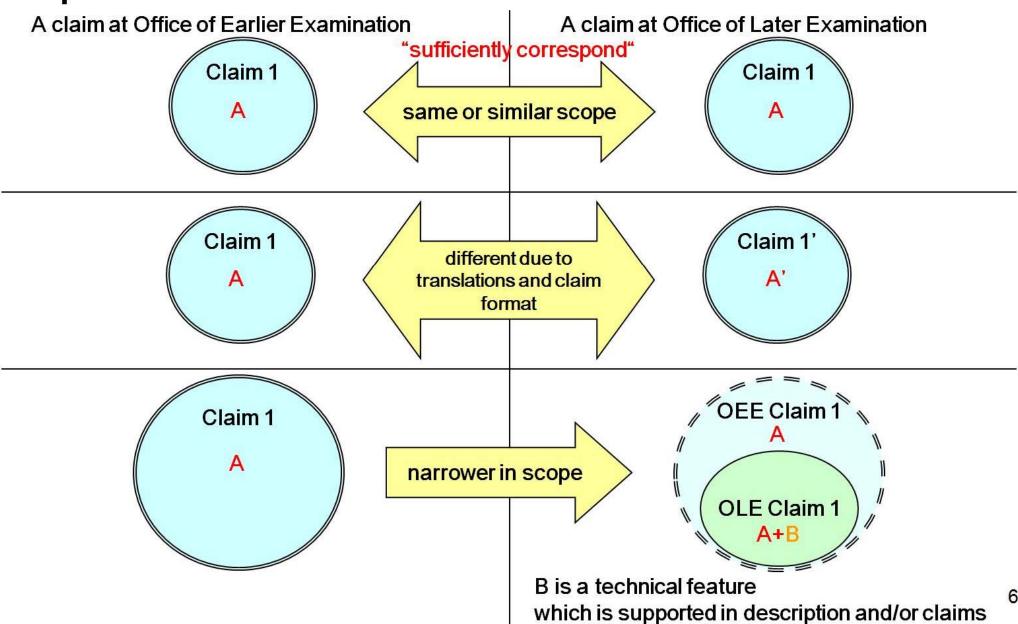
E. Do all claims of the OLE application sufficiently correspond to the allowable claims in the OEE application?

#### Claims are considered to "sufficiently correspond", when

- (i) accounting for differences due to translations and claim format, the claims of the OLE application have the <u>same or similar</u> scope as the claims determined as patentable/allowable in the latest office action do, or
- (ii) the claims of the OLE application are <u>narrower</u> in scope than the claims determined as patentable/allowable in the latest office action



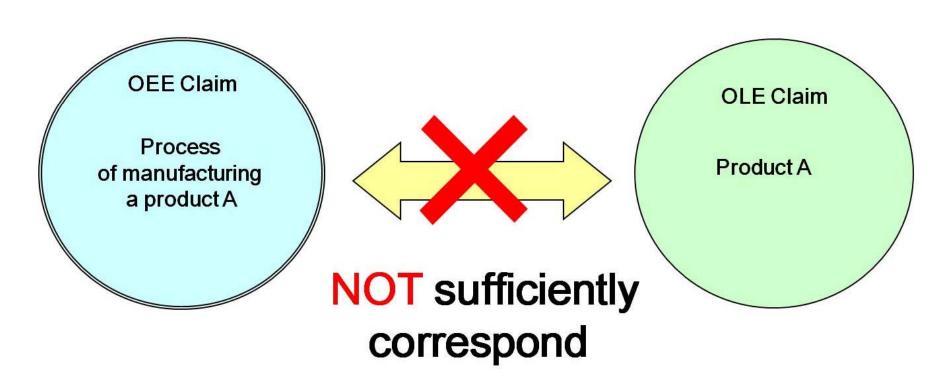
#### Requirements for PPH – 8/11





#### Requirements for PPH – 9/11

A claim is NOT considered to sufficiently correspond when a <u>new/different category</u> of claims are introduced to those claims determined as patentable/allowable in the latest office action.





### Requirements for PPH – 10/11

Claims correspondence table indicates how all claims sufficiently correspond to the allowable/patentable claims in the OEE application.

The claim filed to the OLE	The claim determined to be allowable in the OEE	Comments about the correspondence
1	1	Both claims are the same.
2	2	Both claims are the same except for the claim format.
3	1	Claim 3 in the OLE application adds composition A to claim 1 filed at the OEE.

### IV. Utilizing Claims Granted in Other Jurisdictions(PPH) JPO JAPAN PATENT OFFICE JAPAN



### Requirements for PPH – 11/11

### **Summary**

Requirements	A. The examination has not begun in the OLE.  B. The OLE application is in a particular relationship with the OEE application.  D. The OLE application has at least one claim that was determined by the OEE to be allowable.  E. All the claims in the OLE application sufficiently correspond or are amended to sufficiently correspond to the allowable/patentable claims in the OEE application.
List of Required Documents	C-1. A copy of all <u>claims</u> and its <u>translation</u> * C-2. Copies of the OEE <u>office actions</u> and their <u>translations</u> * C-3. Copies of all <u>cited documents</u> * C-4. <u>Claims Correspondence Table</u> *These documents are not required to be submitted on the certain condition.





## Thank you for your attention!