WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

Topic 5: **Utilizing Claims Granted in other Jurisdictions**

Lutz Mailänder
Head, International Cooperation on Examination and Training Section
PCT International Cooperation Division

Cybercity
March 29, 2022

Agenda

- Claim retrieval options
- Comparing claims
- Reasons for differences
- Standardized work-sharing procedures/agreements
  - Patent Prosecution Highway
  - Validation
- Backlog processing

Example: **WO2008035580**

- 2 JP priorities
- Inpadoc family: 39 members
- Simple family; 35 members

- Simple family: **grants** in AP, AU, 2xCN, US, NZ, CA, KR, EA, MA, MX, MY, TW, UA, PH, VN, EP
- Extended family: further grants in: 2xJP

- **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.

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 man- ner such that water or a nutrient fluid supplied from the drip tube is fed to the lower surface of the nonporous hydrophilic film.

Examples of grants: **WO2008035580**

CA-C

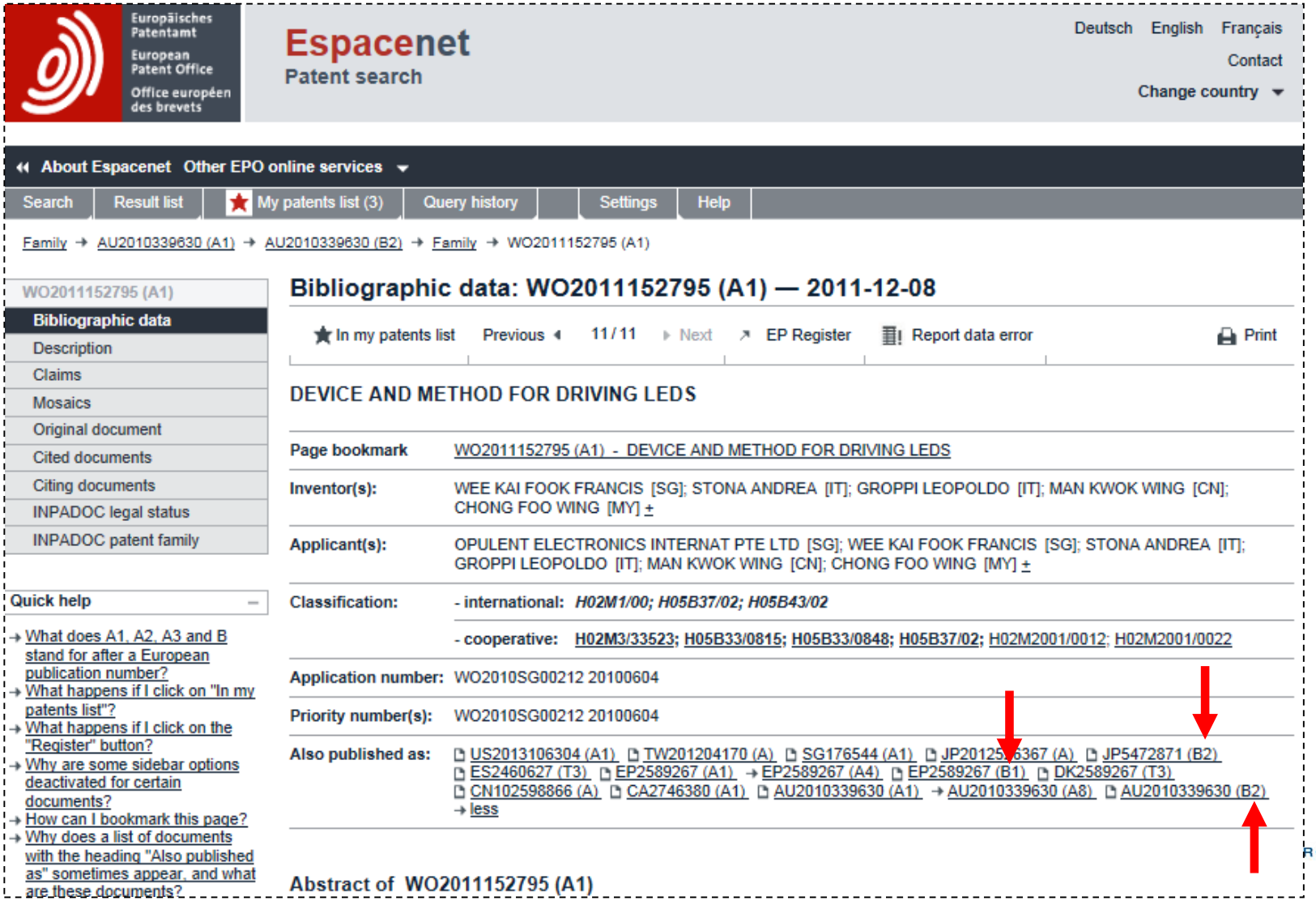
1. A plant cultivation system comprising:
- a nonporous hydrophilic film for cultivating a plant thereon;
- a feeding means for feeding water or a nutrient fluid to the lower surface of said nonporous hydrophilic film,
- said feeding means comprising at least one layer which is a water impermeable material 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 man- ner 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.

WO2011152795

Espacenet retrieval



Retrieval options

- **Publications** of granted patents
  - Can easily be identified by kind codes (B1, B2, C1, C2,..) of domestic family members
  - PDFs of granted patents: represent the **official publications**
  - Full text (HTML) version: includes sometimes OCR errors and errors with special characters, formulas
  - Publication doesn't mean that grant entered into force!!
  - Check if opposition was filed, is still pending or was settled by either
    - Maintaining the patent
    - Revoking the patent
    - Restricting the patent: New publication of restricted claims (different kind code)
- **File wrapper/dossier**: e.g., for cases where examiner was ready to grant but applicant abandoned application nevertheless; or for intentions to grant (before grants are published)

Espacenet retrieval – full text claims

US7833207 (B2)
Bibliographic data
Description
Claims
Mosaics
Original document
Cited documents
Citing documents
INPADOC legal status
INPADOC patent family

Claims: US7833207 (B2) — 2010-11-16

In my patents list Report data error Print

PANTS-TYPE WEARING ARTICLE

Claims of US7833207 (B2)

A high quality text as facsimile in your desired language may be available amongst the following family members:

BRPI0712274 (A2) CA2655926 (A1) CN101484116 (A) EA200900142 (A1) EP2039332 (A1) JP2008012115 (A) KR101369354 (B1) MX2009000135 (A) TW200819114 (A) WO2008004425 (A1)

Translate this text into

Select language

patenttranslate powered by EPO and Google

Original claims

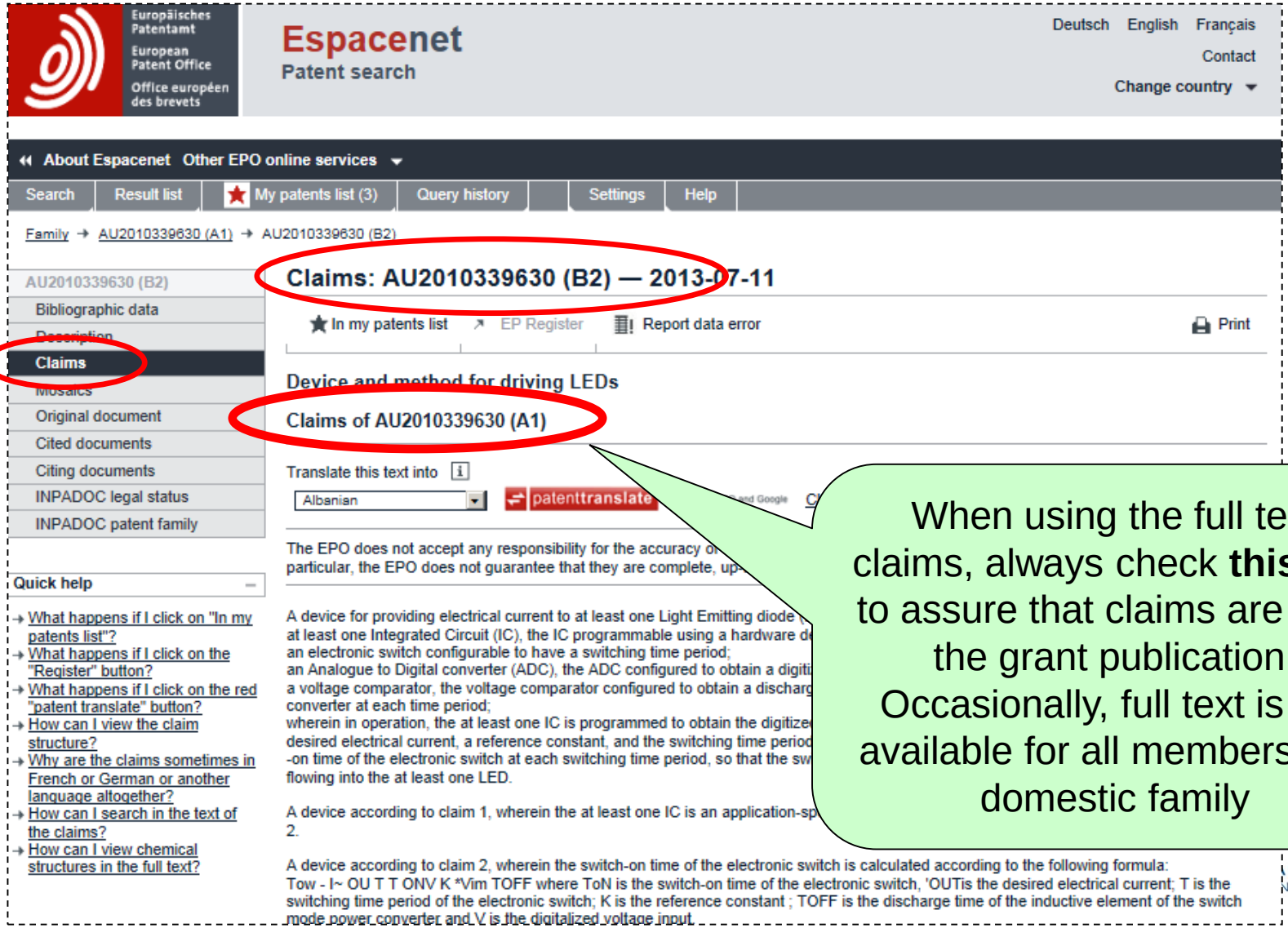
Full text facilitates copy/paste

1. What is claimed is: 1. A pants-type wearing article, comp…
a first waist region corresponding to one of front and re… …aist regions;
a second waist region corresponding to the other of …aid front and rear waist regions;
fastener members fastening said first and second waist regions together in a detachable and refastenable manner along transversely opposite edges of the waist regions so that,
in a state where said first and second waist regions are put flat together, said fastener members respectively have, as viewed in a circumferential direction of the wearing article, a Z-shape and an inverted Z-shape being symmetrical to each other about a center line bisecting a width of said first and second waist regions;
wherein each said fastener member includes
a supporting element folded in said Z-shape or said inverted Z-shape, and
a fastener element attached to said supporting element,
wherein said supporting element in the circumferential direction has a top section, a bottom section extending in parallel to the top section, and an intermediate section extending between said top section and said bottom section,
wherein

Quick help

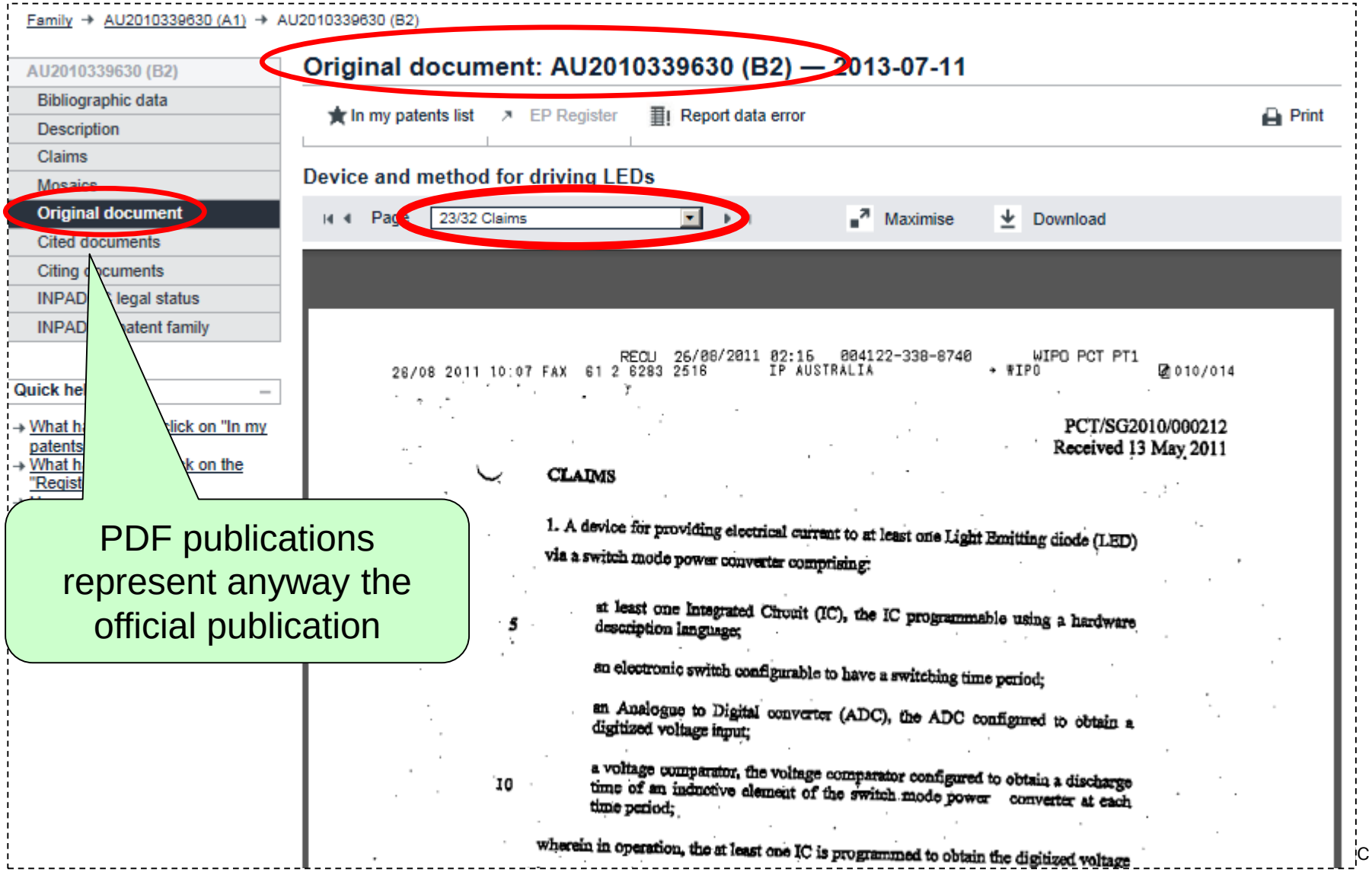
- What is meant by high quality text as facsimile?
- What happens if I click on "In my patents list"?
- What happens if I click on the "Register" button?
- What happens if I click on the red "patent translate" button?
- How can I view the claim structure?
- Why are the claims sometimes in French or German or another language altogether?
- How can I search in the text of the claims?
- How can I view chemical structures in the full text?
- What is Global dossier?

Espacenet retrieval - claims



When using the full text claims, always check **this line** to assure that claims are from the grant publication. Occasionally, full text is not available for all members of a domestic family

Espacenet retrieval: PDF



Intention to grant: EP2140598

Examination procedure	30.12.2008	Request for preli International Pre
	19.11.2009	Amendment by a
	19.11.2009	Examination requ
	18.02.2010	Despatch of a co M04)
	15.06.2010	Reply to a commu
	02.12.2010	Despatch of a communication from the examinin ime limit: M04)
	05.04.2011	Reply to a communication from the examining divi
	28.02.2012	Communication of intention to grant the patent
	10.07.2012	Application deemed to be withdrawn, date of legal effect [2013/03]
	16.08.2012	Despatch of communication that the application is deemed to be withdrawn, reason: fee for grant / fee for printing not paid in time [2013/03]

Withdrawn despite intention to grant

Patentable claims will therefore not be published as B1 document

Claims retrievable only by downloading from electronic dossier

Intention to grant: EP2140598

☐	28.02.2012	Communication about intention to grant a European patent
☐	28.02.2012	Intention to grant (signatures)
☐	28.02.2012	Text intended for grant
☐	10.05.2011	Communication of amended entries concerning the representative
☐	05.04.2011	(Electronic) Receipt
☐	05.04.2011	Amended claims with annotations
☐	05.04.2011	Claims
☐	05.04.2011	Document concerning representation

Communication that amended claims are patentable

Latest submission of amended claims = claims intended for grant

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

Comparing claims

Claim sample – two part claim

Introducing part (category, purpose)

1. A method of determining the torque induced in a rotating shaft (51),

A the shaft (51) having a torsional oscillation frequency that is dependent on the stiffness of the shaft (51),

B where the torsional oscillation frequency and the stiffness are dependent upon the operating conditions of the shaft (51),

characterized in that ← generic expression

C the torsional oscillation frequency of the rotating shaft (51) is measured (35);

D the twist induced in the rotating shaft (51) by the torque is measured (39); and

E the measured value of the torsional oscillation frequency and the measured value of the induced twist are used (41) to determine the torque induced in the shaft (51).

Sequence of 5 features A – E (added)

EP 2006651 A2

Deconstruction of claim wording

- Deconstruction of claim wording, i.e. structuring/sorting the subject matter of a claim into distinct features/elements facilitates:
  - Understanding of the subject matter
  - Checking the clarity of the claim wording
  - Searching of prior art
  - Assessing of novelty by comparing the distinct features with the prior art
  - Determination of the closest prior art
  - (Determination of the difference to the closest prior art)
  - **Comparison of claims** subject to examination at different IPOs (claims of different members of the patent family)

Differences of claims granted for family

- Claims granted by different offices for 'same' invention (simple family) are often quite different:
  - Substantial differences
    - Some elements/features are different, i.e. some may be missing or others included
    - Different category
    - Totally different subject matter of independent claims
  - Non-substantial differences (“equivalent” scope of protection)
    - One part claim instead of two part claims, where all features are present and only listed in different order
    - Wording is basically similar but uses synonymous/equivalent expressions
    - Additional or missing reference numerals

Differences of claims granted for family

Claims WO2011107527

1. Thread or stripe, preferably for the incorporation into or onto a value-document or currency substrate, comprising a plastic foil which carries a hardened coating comprising oriented magnetic or magnetizable pigment particles, the orientation of said pigment particles representing graphic information, the security thread or stripe being **characterized in that** said graphic information is a repetitive seamless pattern of suitable repetition length.

Differences of claims granted for family

AU2011223000B2

1. Thread or stripe, comprising at least one plastic foil which carries a hardened coating comprising oriented magnetic or magnetizable pigment particles, the orientation of said pigment particles representing graphic information, the security thread or stripe being **characterized in that** said graphic information is a repetitive seamless pattern of suitable repetition length.

Claim deconstruction

WO Thread or stripe,

preferably for the incorporation into or onto a value-document or currency substrate,

comprising a plastic foil which carries a hardened coating comprising oriented magnetic or magnetizable pigment particles,

the orientation of said pigment particles representing graphic information,

the security thread or stripe being characterized in that said graphic information is a repetitive seamless pattern of suitable repetition length.

AU Thread or stripe,

comprising at least one plastic foil which carries a hardened coating comprising oriented magnetic or magnetizable pigment particles,

the orientation of said pigment particles representing graphic information,

the security thread or stripe being characterized in that said graphic information is a repetitive seamless pattern of suitable repetition length.

Determining differences

WO Thread or stripe, preferably for the incorporation into or onto a value-document or currency substrate, comprising a plastic foil which carries a hardened coating comprising oriented magnetic or magnetizable pigment particles, the orientation of said pigment particles representing graphic information, the security thread or stripe being characterized in that said graphic information is a repetitive seamless pattern of suitable repetition length.

AU Thread or stripe, comprising at least one plastic foil which carries a hardened coating comprising oriented magnetic or magnetizable pigment particles, the orientation of said pigment particles representing graphic information, the security thread or stripe being characterized in that said graphic information is a repetitive seamless pattern of suitable repetition length.

// Thread or stripe, ~~preferably for the incorporation into or onto a value-document or currency substrate,~~ comprising ~~a~~at least one plastic foil which carries a hardened coating comprising oriented magnetic or magnetizable pigment particles, the orientation of said pigment particles representing graphic information, the security thread or stripe being characterized in that said graphic information is a repetitive seamless pattern of suitable repetition length.

Using document comparing function of WORD

WIPO
WORLD INTELLECTUAL PROPERTY ORGANIZATION

Differences of claims granted for family

EP2542417B1

1. Security thread or stripe, preferably for the incorporation into or onto a value-document or currency substrate, comprising a first plastic foil which carries a first imprinting comprising oriented magnetic or magnetizable pigment particles, the orientation of said pigment particles representing graphic information, wherein said graphic information is a repetitive seamless pattern of suitable repetition length, the security thread or stripe being **characterized in that** said first imprinting is a hardened structured coating in the form of indicia.

Determining differences

WO Thread or stripe, preferably for the incorporation into or onto a value-document or currency substrate, comprising a plastic foil which carries a hardened coating comprising oriented magnetic or magnetizable pigment particles, the orientation of said pigment particles representing graphic information, the security thread or stripe being characterized in that said graphic information is a repetitive seamless pattern of suitable repetition length.

EP Security thread or stripe, preferably for the incorporation into or onto a value-document or currency substrate, comprising a first plastic foil which carries a first imprinting comprising oriented magnetic or magnetizable pigment particles, the orientation of said pigment particles representing graphic information, wherein said graphic information is a repetitive seamless pattern of suitable repetition length, the security thread or stripe being characterized in that said first imprinting is a hardened structured coating in the form of indicia.

// ~~Thread~~Security thread or stripe, preferably for the incorporation into or onto a value-document or currency substrate, comprising a first plastic foil which carries a ~~hardened coating~~first imprinting comprising oriented magnetic or magnetizable pigment particles, the orientation of said pigment particles representing graphic information, ~~the security thread or stripe being characterized in that said~~ wherein said graphic information is a repetitive seamless pattern of suitable repetition length~~.~~ , the security thread or stripe being characterized in that said first imprinting is a hardened structured coating in the form of indicia.

Differences of claims granted for family

US9216605B1

The invention claimed is:

1. A method for producing a security thread or stripe for incorporation into or onto a value document or a currency substrate, comprising:

coating a plastic foil with a coating composition comprising optically variable magnetic or magnetizable pigment particles;

orienting the magnetic or magnetizable pigment particles to represent graphic information;

hardening the oriented magnetic or magnetizable pigment particles coating to fix the magnetic or magnetizable pigment particles in their respective positions and orientations; and

slicing the plastic foil with the hardened into threads or stripes;

wherein the graphic information is produced with a magnetic orienting cylinder having a seamless and continuous repetitive magnetic field pattern having a repetition length.

Reasons for substantial differences

- Examiners may have applied different prior art
  - Different prior art searches, i.e. prior art documents
  - Different priority dates applied
- Differences in national legislation (exclusions) or case law
- Individual examiner's views
- Patents do not belong to same simple family, i.e. applicants have sought protection for different subject matter (e.g. continuations/divisions); descriptions most likely differ

Differences of national patent legislations

- Basic categories of requirements are the same in most jurisdictions (unity, novelty, inventive step, technical nature, sufficient disclosure)
- Some differences exist in how the term "invention" or "patentable invention" is defined (positively, negatively)
- Differences, however exist mostly in terms of exclusions, e.g.
  - US do grant business methods, software patents,..
  - DE/EP grants new use of known compound, PK does not,..
  - Islamic countries exclude, e.g., inventions related to pork
  - Temporary exclusions in Myanmar: Section 8 (b)
- For analysis of different national practices, see e.g. SCP studies and surveys on WIPO website:
  - http://www.wipo.int/edocs/mdocs/scp/en/scp_13/scp_13_3.pdf
  - http://www.wipo.int/scp/en/exceptions/

Evolution of claims

- Claims of a patent application are usually different at different publication and prosecution stages of the application
- Before examination, the initially filed independent claims have a broader scope because applicants seek to get as much protection as possible
- Claims of granted patents are, in comparison to the initially filed claims,
  - Usually narrower, i.e. include additional features, or
  - May be totally different
- Claims after opposition have often narrower scope than claims after grant

Claim sample – as filed

1. A method of determining the torque induced in a rotating shaft (51),

A the shaft (51) having a torsional oscillation frequency that is dependent on the stiffness of the shaft (51),

B where the torsional oscillation frequency and the stiffness are dependent upon the operating conditions of the shaft (51),

characterized in that

C the torsional oscillation frequency of the rotating shaft (51) is measured (35);

D the twist induced in the rotating shaft (51) by the torque is measured (39); and

E the measured value of the torsional oscillation frequency and the measured value of the induced twist are used (41) to determine the torque induced in the shaft (51).

Claim sample – as granted

1. A method of determining the torque induced in a rotating shaft (51),

A the shaft (51) having a torsional oscillation frequency that is dependent on the stiffness of the shaft (51),

B where the torsional oscillation frequency and the stiffness are dependent upon the operating conditions of the shaft (51),

the method comprising:

C measuring (35) the torsional oscillation frequency of the rotating shaft (51);

D measuring (39) the twist induced in the rotating shaft (51) by the torque; and

E using (41) the measured value of the torsional oscillation frequency and the measured value of the induced twist to determine the torque induced in the shaft (51);

F the torsional oscillation frequency of the shaft (51) and the induced twist are measured (35) at the second set of operating conditions;

the method is **characterized by**

G determining the torsional oscillation frequency of the shaft (51) at a second set of operating conditions at which the stiffness of the shaft (51) can be determined (33) and

H determining the stiffness of the shaft (51) at the second set of operating conditions;

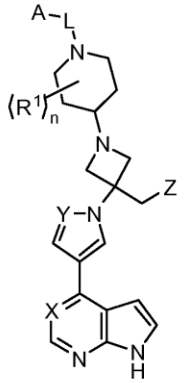
I the torque induced in the shaft (51) at the first set of operating conditions is determined (41) using the measured torsional oscillation frequency and the induced twist at the first set of operating conditions, and the measured torsional oscillation frequency and the stiffness at the second set of operating conditions

Added during examination

Claim sample – as filed

WHAT IS CLAIMED IS:

1. A compound of Formula (I):



I

or a pharmaceutically acceptable salt thereof; wherein:

X is N or CR^2;

Y is N or CR^3;

Z is H, cyano, halo, C_{1-3} alkyl, or C_{1-3} haloalkyl;

L is $C(R^4)_2$, C(=O), $C(=O)N(R^{4a})$, $C(=O)C(R^{4b})_2$, $S(=O)_2$, C(=O)O, $C(=O)OC(R^{4b})_2$ or $C(=O)N(R^{4a})C(R^{4b})_2$;

A is C_{1-6} alkyl, C_{3-14} cycloalkyl, C_{2-13} heterocycloalkyl, C_{6-14} aryl, or C_{1-14} heteroaryl; wherein said C_{1-6} alkyl, C_{3-14} cycloalkyl, C_{2-13} heterocycloalkyl, C_{6-14} aryl, and C_{1-14} heteroaryl are each optionally substituted with 1, 2, 3, 4, 5, or 6 independently selected R^5 groups;

each R^1 is, independently, C_{1-4} alkyl, hydroxyl, C_{1-4} alkoxy, fluoro, hydroxyl-C_{1-4}

WO2011112662A1

Claim sample – as granted

What is claimed is:

1. A compound, which is {1-{1-[3-Fluoro-2-(trifluoromethyl)isonicotinoyl]piperidin-4-yl}-3[4-(7H-pyrrolo[2,3-d]pyrimidin-4-yl)-1H-pyrazol-1-yl]azetidin-3-yl}acetonitrile, or a pharmaceutically acceptable salt thereof.

2. A salt, which is {1-{1-[3-Fluoro-2-(trifluoromethyl)isonicotinoyl]piperidin-4-yl}-3-[4-(7H-pyrrolo [2,3-d]pyrimidin-4-yl)-1H-pyrazol-1-yl]azetidin-3-yl}acetonitrile adipic acid salt.

US8765734B2

Admissible claim amendments

Applicant may usually amend/narrow claims anytime during examination, e.g. if originally filed claims are not patentable:

- Adding further features taken **from description** or from other claims
- Replacement of features
- Completely reworded claims

- All features have to be supported by the original description
- When adopting claims granted in another jurisdiction, the adopted claims have to be supported by the description of the local application.

- For applications in the same simple or PCT family it is very likely that descriptions are the same, and that adopted claims are therefore supported by it.
- For applications that are national phase entries of the same international application, it is almost guaranteed that descriptions are identical.

Patent Prosecution Highway PPH

- JPO initiative to accelerate granting in case of grants at other IPOs, in case ‘Office of Earlier Examination’ has determined allowable / patentable subject-matter
- Bilateral agreements between IPOs
- Commitment to prioritize/accelerate examination in case of grant at other IPO, namely accelerate **1st office action**
- No obligation to adopt claims/conclusions
- **Accelerated examination** has to be requested by applicant
- Condition: applicant submits identical claims that were granted

- Even if there is a PPH request, it would be obligatory to check other national phase work products.
- Claims subject to a PPH request must **not** be granted without further examination if the OEE examiner overlooked relevant prior art.

Validation

- EPC Validation System:
  - EPO grants patents
  - Patents are then "validated" in designated member countries, i.e. they become national patents
- EPO now concludes bilateral validation agreements with jurisdictions not being members of the EPC (e.g. Georgia, Morocco, Tunisia, Moldova, Cambodia)
- Morocco: entry into force on March 1, 2015
- Designation as extension countries in EPO application, therefore no need to file separate application > applicant driven
- Not possible retroactively for pending applications
- Requires harmonization of national laws with EPC
  - Lately a bit more relaxed; for example, offices may refuse grant of subject matter excluded from patentability according to their law (KH)
- Validating EPO decision includes effective adoption of case law as well

Validation

33.2 Es ist beabsichtigt, die Validierungsgebühr(en) für die nebenstehend angekreuzten Staaten zu entrichten. /
It is intended to pay the validation fee(s) for the states marked opposite with a cross. /
Il est envisagé de payer la (les) taxe(s) de validation pour les Etats dont le nom est coché ci-contre.

Hinweis: Im automatischen Abbuchungsverfahren werden nur für die hier angekreuzten Staaten Validierungsgebühren abgebucht, sofern dem EPA nicht vor Ablauf der Zahlungsfrist ein anderslautender Auftrag zugeht.

Note: Under the automatic debiting procedure, validation fees will be debited only for states indicated here, unless the EPO is instructed otherwise before expiry of the period for payment.

Veuillez noter que dans le cadre de la procédure de prélèvement automatique des taxes de validation, le compte est débité du montant dû seulement pour les Etats cochés ici, sauf instruction contraire reçue avant l'expiration du délai de paiement.

VAPT

☐ **MA** Marokko/ Morocco/ Maroc

☐

☐

(Platz für Staaten, mit denen Validierungsabkommen nach Drucklegung dieses Formblatts in Kraft treten) / (Space for states with which validation agreements enter into force after this form has been printed) / (Espace prévu pour des Etats avec lesquels des accords de validation entreront en vigueur après l'impression du présent formulaire)

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

Validation

Map showing the geographic coverage of European patents as of 1 December 2017

Member states (38)

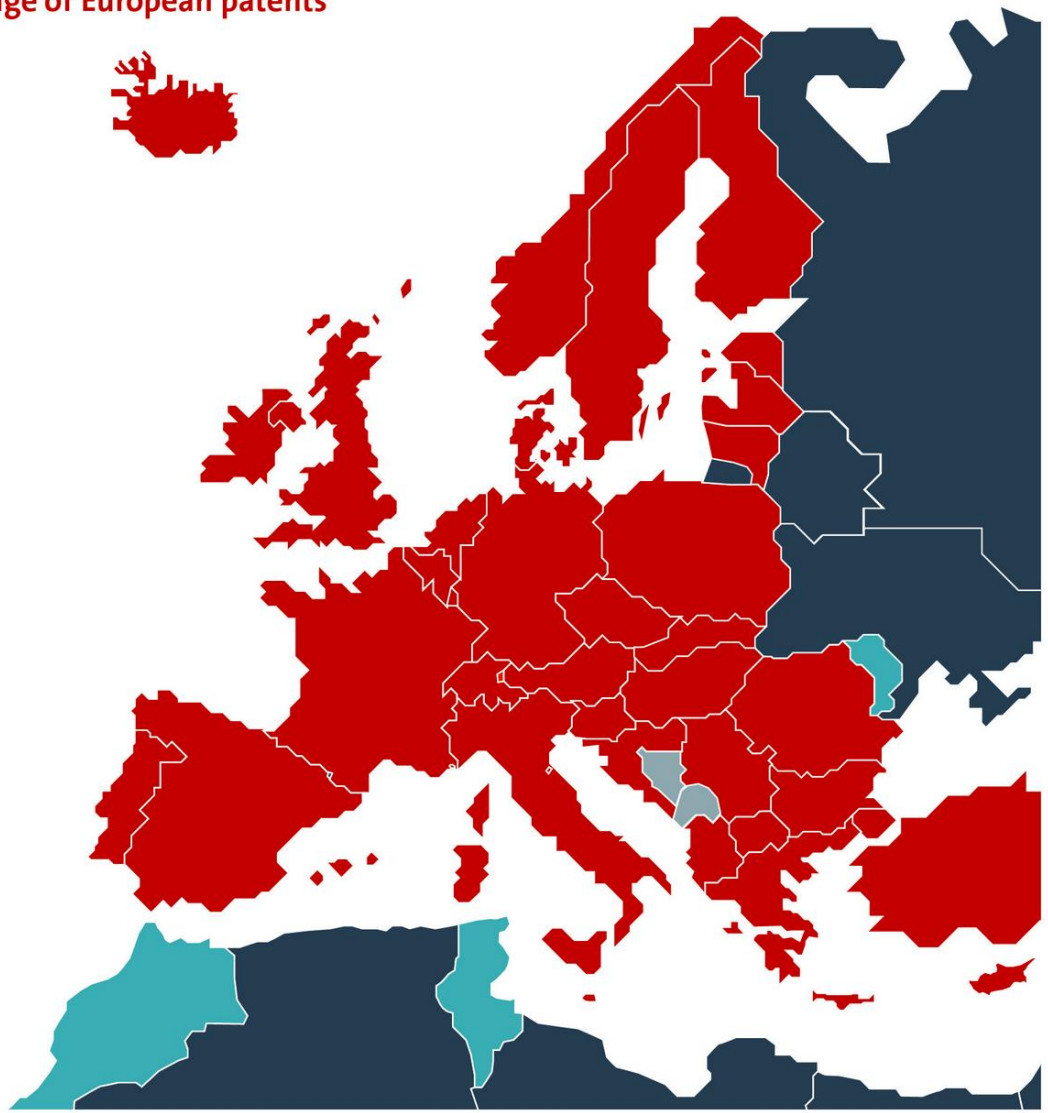
Albania
Austria
Belgium
Bulgaria
Croatia
Cyprus
Czech Republic
Denmark
Estonia
Finland
France
Germany
Greece
Hungary
Iceland
Ireland
Italy
Latvia
Liechtenstein
Lithuania
Luxembourg
Former Yugoslav Republic of Macedonia
Malta
Monaco
Netherlands
Norway
Poland
Portugal
Romania
San Marino
Serbia
Slovakia
Slovenia
Spain
Sweden
Switzerland
Turkey
United Kingdom

Extension states (2)

Bosnia-Herzegovina
Montenegro

Validation states (3)

Republic of Moldova
Morocco
Tunisia



Further initiatives

- EPO: Reinforced Partnership agreements
  - 18.11.21 latest agreement with Saudi Arabia
  - Argentina, Brazil, Colombia, Ethiopia, Malaysia, Mexico, Indonesia, South Africa, and ARIPO
- USPTO: Parallel Patent Grant initiative
  - Only with Mexico

Modified examination

- Some patent laws (MY) permit applicants to request examination based on grants issued in other jurisdictions
- Commitment to prioritize/accelerate examination in case of grant at other IPO
- No obligation to adopt claims/conclusions
- **Accelerated examination** has to be requested by applicant
- Condition: applicant submits identical claims that were granted

- Even if there is a request, it would be obligatory to check other national phase work products.
- Claims subject to a request must **not** be granted without further examination if the OEE examiner overlooked relevant prior art.

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

- 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!

Observations - Challenges

- **Foreign examination work** products (if available) **must not be ignored** for national phase examination
  - For PCT NPEs, examiners should never exclusively rely only on ISR/WO
  - Systematic checking of other work products prior to any grant decision
  - Even when examining requests from PPH or work-sharing agreements
- **Suitable work-sharing policies needed** (in particular, for under-resourced POs)
  - Work products become only gradually available and visible
  - Utilizing intermediary or final work product
    - Potentially limited utility of intermediary work products
    - Awaiting final results from other national phases may be an option for under-resourced Offices in particular; requires consent by applicant, i.e. respective request
    - **Most recent or last grant is potentially of best quality? Implication for PPH?**
- Duplication/repetition of work is not a bad thing as such
- Examination of PCT NPEs starts at the same time; is (regional) coordination needed?
- Cooperative examination approaches may not necessarily resolve limited examination capacities for NPE (differing claim sets)
- Are work-sharing agreements needed at all in view of transparency?

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

Strategy for backlog processing I

- **Preparatory stage (before communication with applicant)**
  - Research family and examination status
  - If several grants: compare claims and select suitable claim set (e.g. narrowest main claim; more citations considered; most recent grant), for example:
    - US-B
    - EP-B (narrowest)
    - JP-B

    It is usually the **same** applicant!
    Representatives and examiners differ
  - If still pending in other jurisdiction(s): check if additional prior art applied there warrants further waiting for completion of examination in that/those jurisdiction(s)
  - Confirm compatibility of selected set with national legislation
  - Check if claims are supported by description (usually the case for members of PCT family)

Strategy for backlog processing I

- **Preparatory stage**
  - Optionally (in case of backlog), sort and prioritize in
    - Easy cases: only grants, no rejections, no substantial withdrawals in family

    > grant is extremely likely

    > an analysis of the patentability of the pending claims may be avoided

    > one should attempt to get the applicant adopt the selected claim set

    - Complex/contentious cases: grants and rejections in same simple family

    > rejection may be due

    > Contentious cases may require a detailed analysis of the patentability of the pending claims and the claims granted by other IPOs

Strategy for backlog processing II

- **Applicant interaction stage**
  - Selected claims may not be granted immediately
  - Principles of 'party disposition' and 'fair trial' require communications/reports and consent of applicant

Easy cases

- Propose selected claim set to applicant
- "Motivate" applicant to adopt proposal, e.g. by issuing a **'smart' report** mentioning the comparison of results of other national phase, additional citations,..
- Initially avoid as much as possible discussion of patentability of pending claims (time consuming)
- If applicant doesn't agree, place case in contentious category

Contentious cases

- Most likely requires regular substantive examination procedure
- 1st action: report explaining non-patentability of pending claims

Summary

- Preparatory stage**:** Focusing on external grants may enable you to (most likely)
  - **Avoid your own prior art search**
  - **Avoid your own analysis of novelty and inventiveness**
  - Selection of claim set takes 1-3h per case for a skilled examiner

- Applicant interaction stage:
  - Most cases are expected to be easy cases: proposals likely to be adopted by applicant > efficient processing
  - May be time consuming for contentious cases, i.e.
    - If applicants disagree with proposed claim set and insist on their own claims
    - Additional prior art search may become necessary, e.g. if amended claims or parts thereof were never searched before
    - Rejection ruling may have to be issued
    - May require examiner with technical expertise, e.g. for conducting a supplementary search or analyzing obviousness
  - Difficult to estimate the time needed for contentious cases

Simplified Examination

Examination Report

Application No.: **102**
PCT Application No.: **PCT/IT2006/000825**
Date of report: **x July 2017**

1. The present application 102 is a PCT national phase entry of the International Application PCT/IT2006/000825. The Authority has reviewed the patents granted for other PCT national phase entries of this International Application in other jurisdictions, in particular following publications: AU2006351328B2, CA2670311C, EP2162617B1 and US8581431B2. The Authority has considered the prior art cited in the International Search Report as published in WO2008065684A1 as well as the prior art established in the other national phases.

2. The claims as received on *[date of receipt at office]* are not found to meet the requirements of Article 13 of the Law of Intellectual Property. However, the claims 1-19 granted by the European Patent Office as published in the document EP2162617B1 have been found to meet the requirements of Article 13 of the Law of Intellectual Property.

Simplified Examination

3. The applicant is therefore invited to submit a set of amended claims equivalent to the said claims as published in the document EP2162617B1. The applicant is further invited to amend accordingly the parts of the description relating to the claimed subject matter.

4. The applicant is further requested to confirm that the patents AU2006351328B2, CA2670311C, EP2162617B1 and US8581431B2, as well as other patents which have been granted for the same invention have not been subject to any post-grant reexamination, revocation, cancellation, invalidation or similar procedures.

5. If the applicant does not agree with the invitation of section 3 above, and wishes to amend the claims in other ways, the Authority will continue examination, taking into account any search and examination work products established by the International Search and Examination Authority and other patent authorities where the International Application entered the national phase. For that purpose, the applicant is requested to provide, according to Article 36 of the Law of Intellectual Property, information on any application filed in any jurisdiction and relating to the same claimed subject matter, and furnish copies of any such examination work products or decisions regarding these applications.

6. If the applicant fails to respond to this communication within 3 months from the date of receipt of this communication, the application will be considered abandoned according to Article 43 (2) and (5) of the Law of Intellectual Property.

Thank you

lutz.mailander@wipo.int

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION