



Topic 1: **Challenges and Options in Substantive Patent Examination**

Lutz Mailänder

Head, International Cooperation on Examination and Training Section

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Agenda

- Challenges of small and medium IPOs
- Legislative foundations
- Elements of patent prosecution
- Options for **substantive** examination and implementation of patent prosecution

Different categories of IPOs

Expertise

- IPOs just **embarking on patent prosecution** (e.g. Bahrain, Oman, Bhutan, Cambodia, Kuwait, Ghana ...)
- IPOs having **established patent prosecution** ("emerging Offices"; e.g. GCC, Jordan, Malaysia, Saudi Arabia, Thailand, Viet Nam,...)
- IPOs with **long work experience** (DPMA, EPO, JPO, USPTO, ...)

Size

- **Small IPOs** with very few examiners (e.g. Bahrain, Oman, Bhutan, Jordan, Syria, Kuwait, Ghana) and the capacity to **cover very few areas of technology**
- **Medium size IPOs** with the capacity to **cover some but (may be) not all areas of technology** (GCC, Saudia Arabia, Thailand, Viet Nam)
- **Large IPOs** with sufficient number of staff to cover all areas of technology (IP India, USPTO, EPO, JPO)

IPO's challenges in many IP-DCs

- IP-DC: Country developing its IP infrastructure
 - Almost all IPOs adopted a system of substantive examination
 - Establish efficient patent prosecution procedures (national phases) for
 - **foreign** (including PCT; amount often to 90% of applications), and
 - **truly domestic** patent applications
- with **limited resources** (e.g. number of staff, legal and technical expertise of staff, access to databases..) in comparison to major IPOs

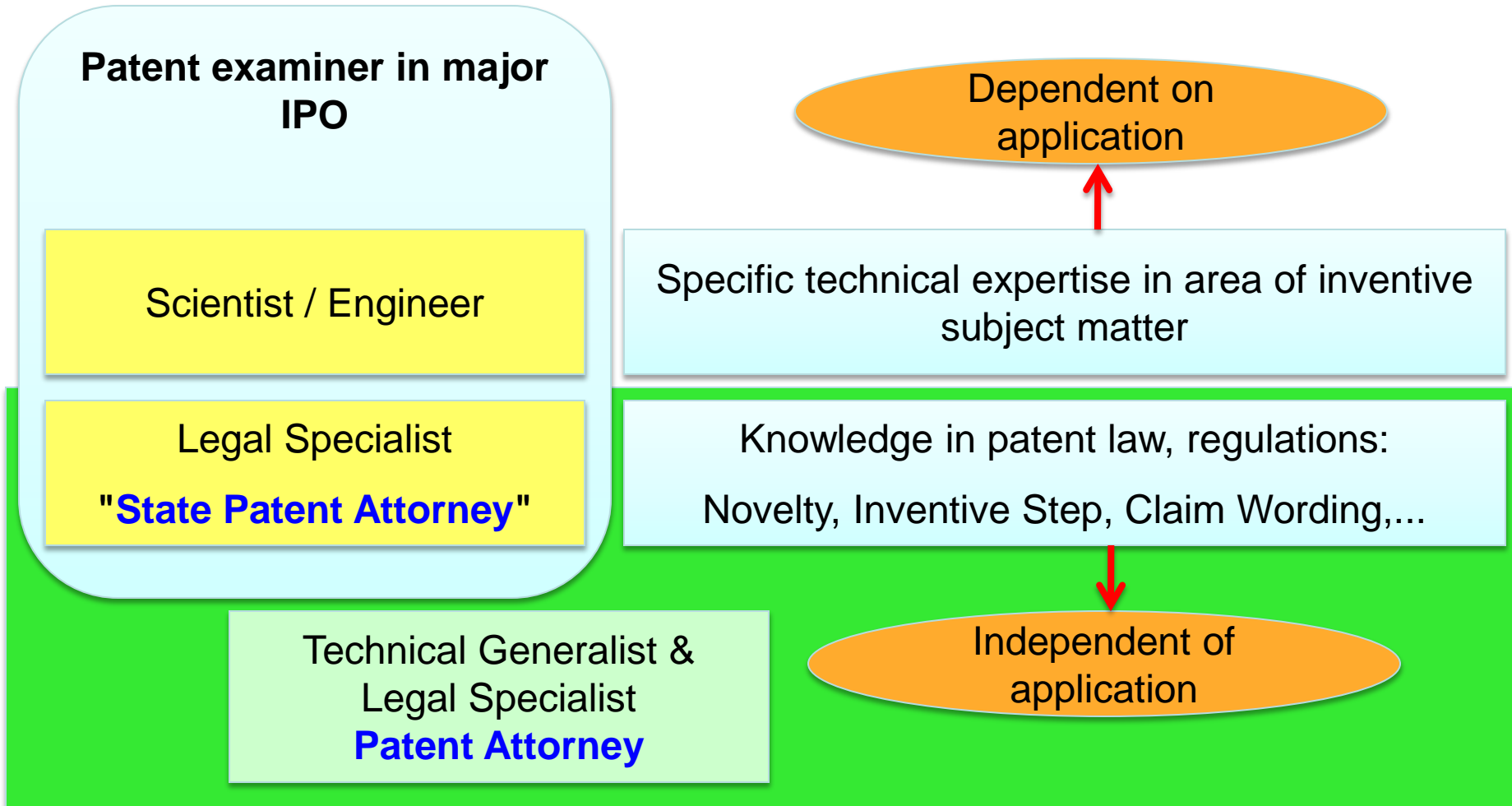
Building up of backlogs

- despite similar requirements for patentability and quality of examination
- facing a lack of awareness/support by higher government authorities
- limitations of domestic IP culture (e.g. experienced patent lawyers, drafting skills of local applicants, ...)

Substantive examination in small IPOs?

- Can small IPOs deliver quality substantive examination?
- What is a sufficient size, i.e. number of examiners?
 - To cover all areas of technology? Manage workload?
 - DE: 700
 - EP: 3000
 - AT: 50
- What access to database resources is needed?
- What training is needed?
- My view: Yes, even small IPOs with limited resources can deliver quality patents if they have a proper strategy for the exploitation of external examination results for members of the **patent family** (passive worksharing)
- Yes, if examiners are trained as "state patent attorney,"

Required examiner capacities



"National phases" in general

Categories of patent applications to be examined

■ PCT national phase entries

- application is member of **patent family**

■ non-PCT foreign filings (second filings)

- priority claimed: is member of (Paris Convention) **patent family**
- priority not claimed: is member of "**technical**" family because same invention

■ Truly national/domestic first filing

- second filing abroad is possible, i.e. application may become member of **patent family**

Patent family > application is processed at several IPOs

"State patent attorney" can utilize results from other IPOs

> **Topic 10: patent families**

Legal basis of patent examination

- ▶ **Patent law**/act (issued by parliament, i.e. legislative body)
- ▶ Patent rules/**regulations**/ordinances (issued by minister, commissioner/..., i.e. administrative body)

- ▶ International treaties (Paris Convention, PCT, TRIPS...)

require interpretation

- ▶ Case law (interpretation by court rulings)
- ▶ Examination guidelines (referring to essential CL)

South Africa is member

Examination Guidelines/Manuals

▶ EPO Guidelines

English: <http://www.epo.org/law-practice/legal-texts/guidelines.html>

[http://documents.epo.org/projects/babylon/eponet.nsf/0/7ffc755ad943703dc12576f00054cacc/\\$FILE/guidelines_2010_complete_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/7ffc755ad943703dc12576f00054cacc/$FILE/guidelines_2010_complete_en.pdf)

▶ PCT Examination Guidelines

<http://www.wipo.int/export/sites/www/pct/en/texts/pdf/ispe.pdf>

▶ German Guidelines (in English)

http://www.dpma.de/docs/service/formulare_eng/patent_eng/4/p2796_1.pdf

▶ Indian Manual (draft)

http://ipindia.nic.in/ipr/patent/DraftPatent_Manual_2008.pdf

http://ipindia.nic.in/PatentOfficeProcedure/PatentOfficeProcedure_2009.pdf

▶ USPTO Guidelines

<http://www.uspto.gov/web/offices/pac/mpep/documents/2100.htm>

Requirements of patentability

- Substantive patent examination has to check
 - Novelty
 - Inventive step
 - Industrial applicability
 - Unity
 - Technical nature
 - No case of **exclusion**
 - Sufficient disclosure
 - Legal certainty of claims (clarity)
 - Additions to initial disclosure
 - Deposit of novel micro-organisms
 - (Disclosure of origin of genetic resources)

Section

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none

none

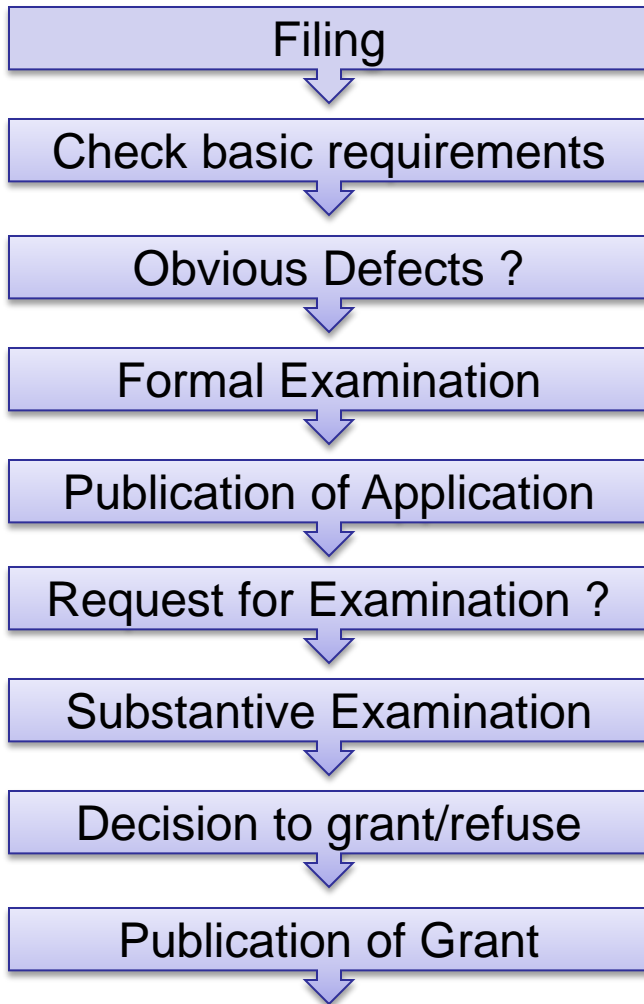
Differences of national patent legislations

- 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, see e.g. SCP studies on WIPO website:
http://www.wipo.int/edocs/mdocs/scp/en/scp_13/scp_13_3.pdf

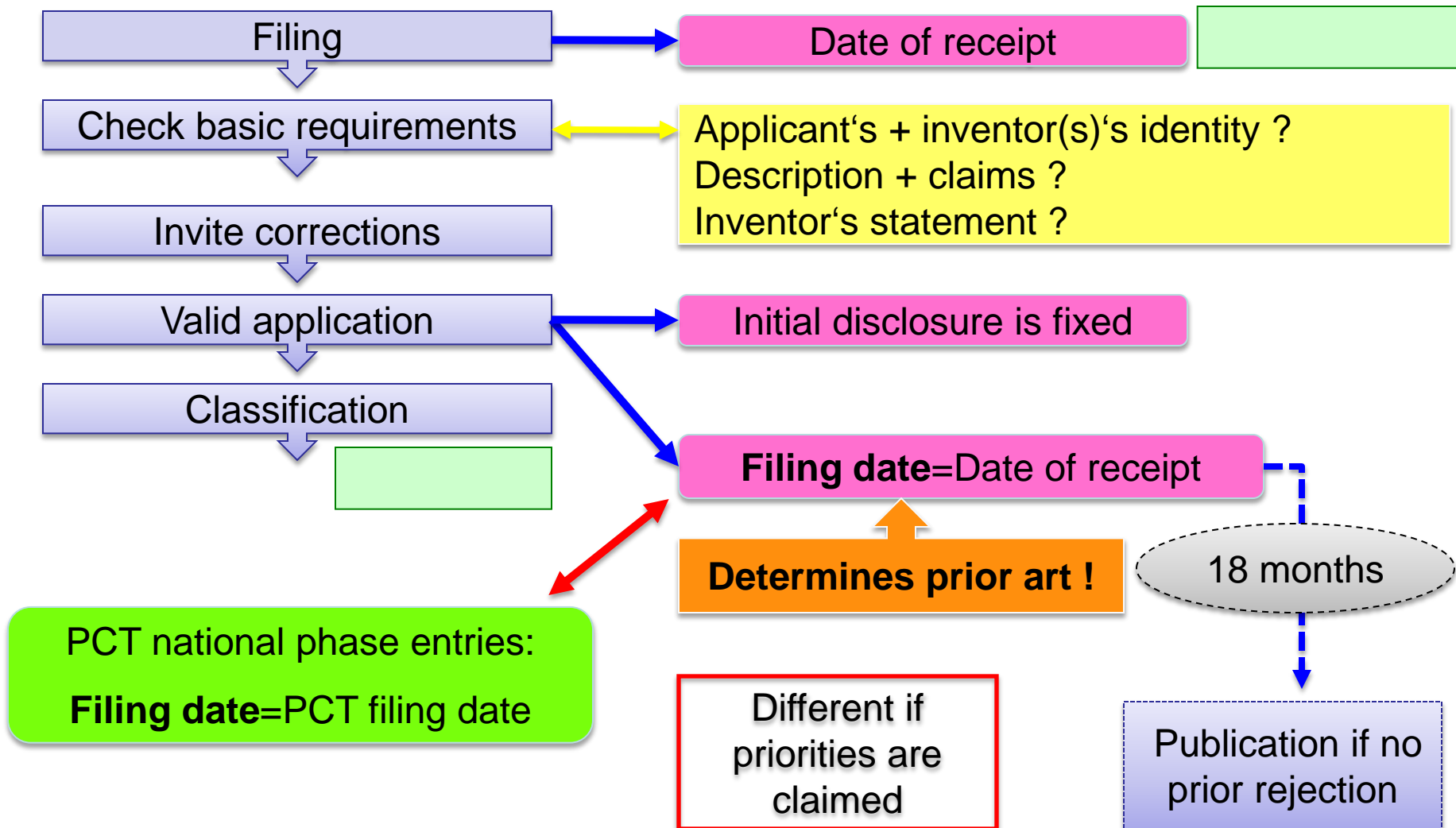
Differences of national patent legislations

- Paris Convention and PCT treaty do not address exclusions from patentability
 - PCT permits ISA to exclude certain subject matter from search
- TRIPS permits exclusions of certain subject matter
- Further important differences exist in case law, e.g.
 - Technical nature of software related patents
 - Inventive step
- Further important differences exist with respect to limitations of the rights of the owner of a granted patent, e.g. the research privilege

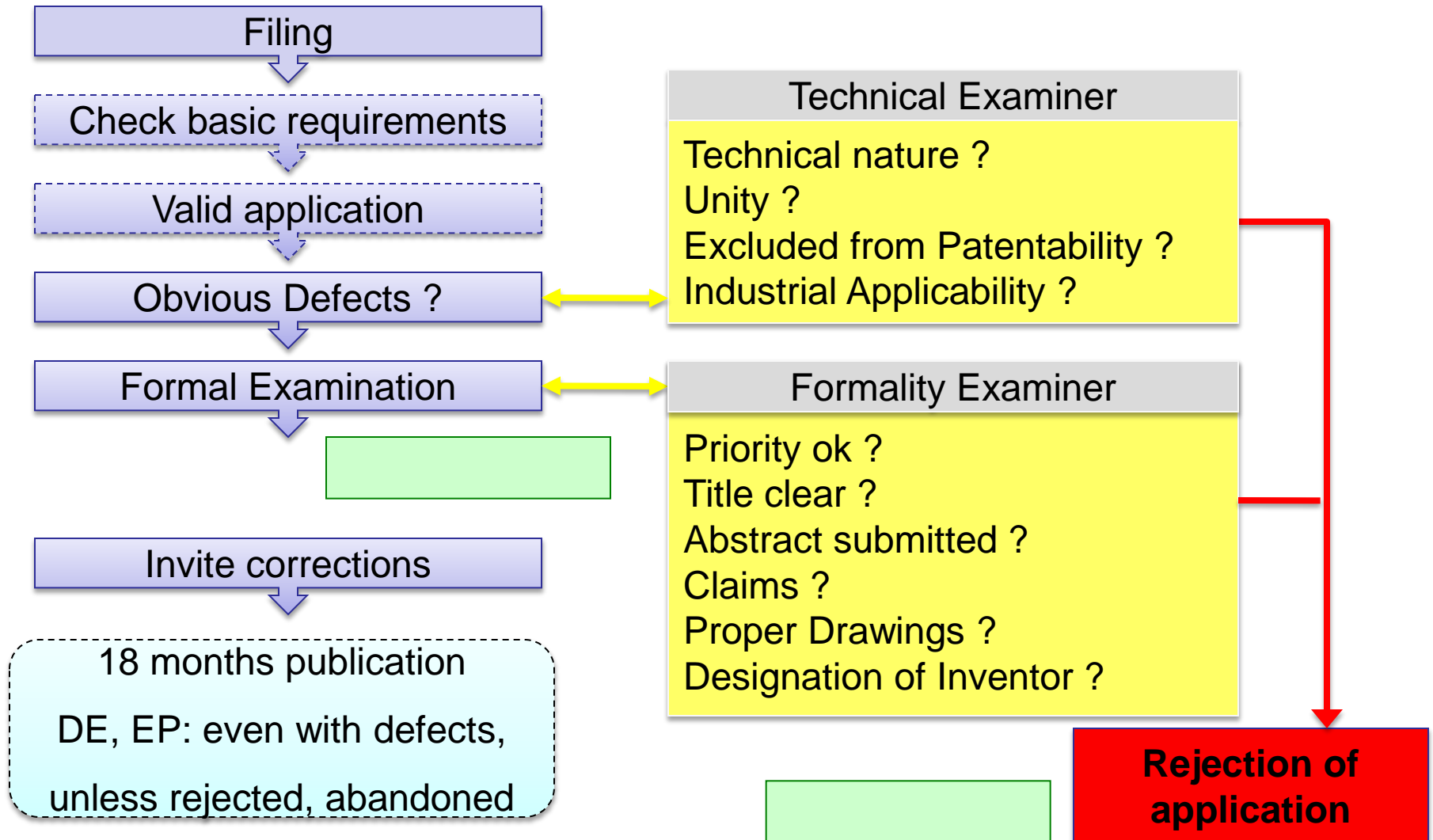
Overview of pre-grant prosecution



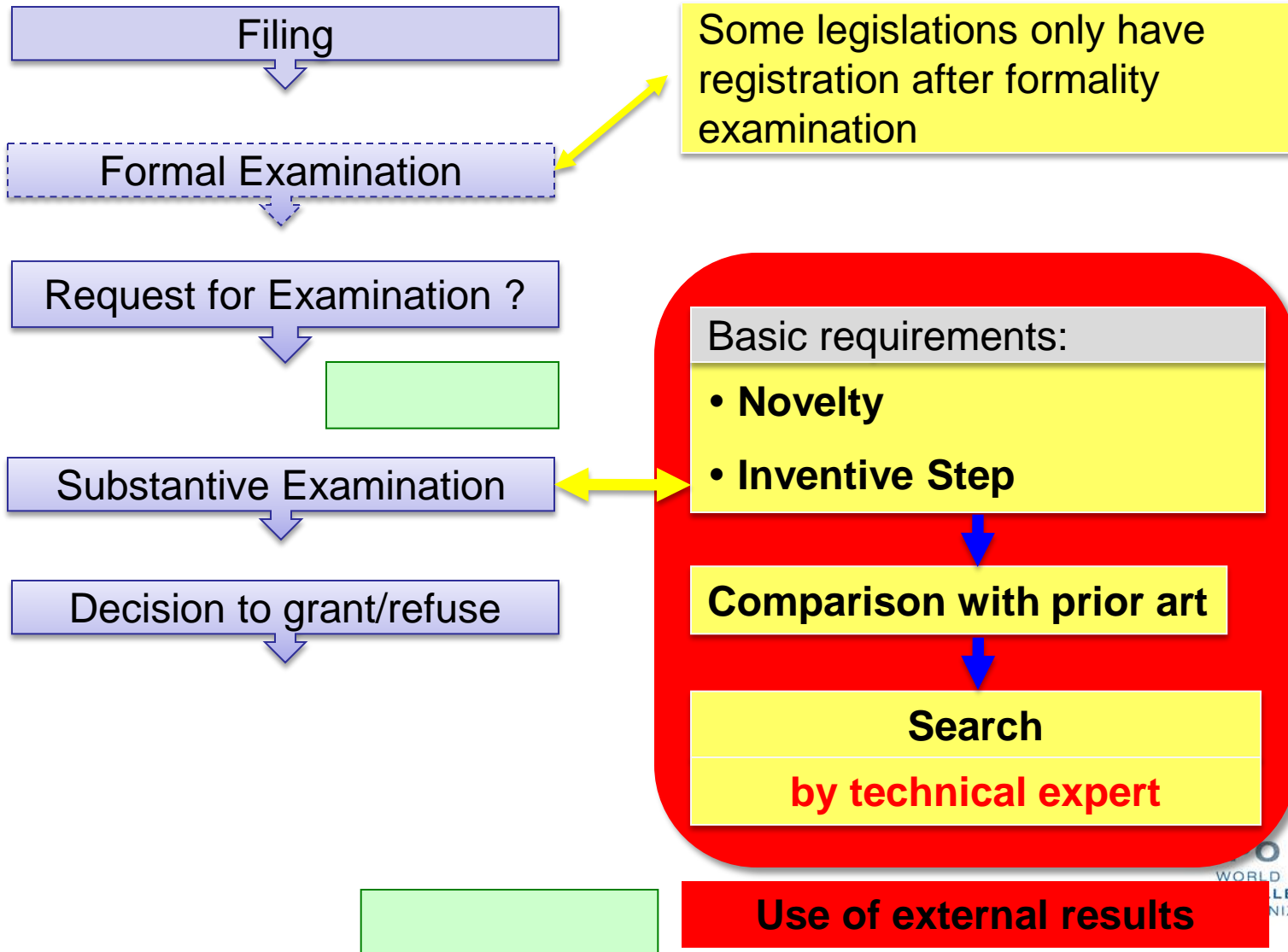
Elements of pre-grant prosecution



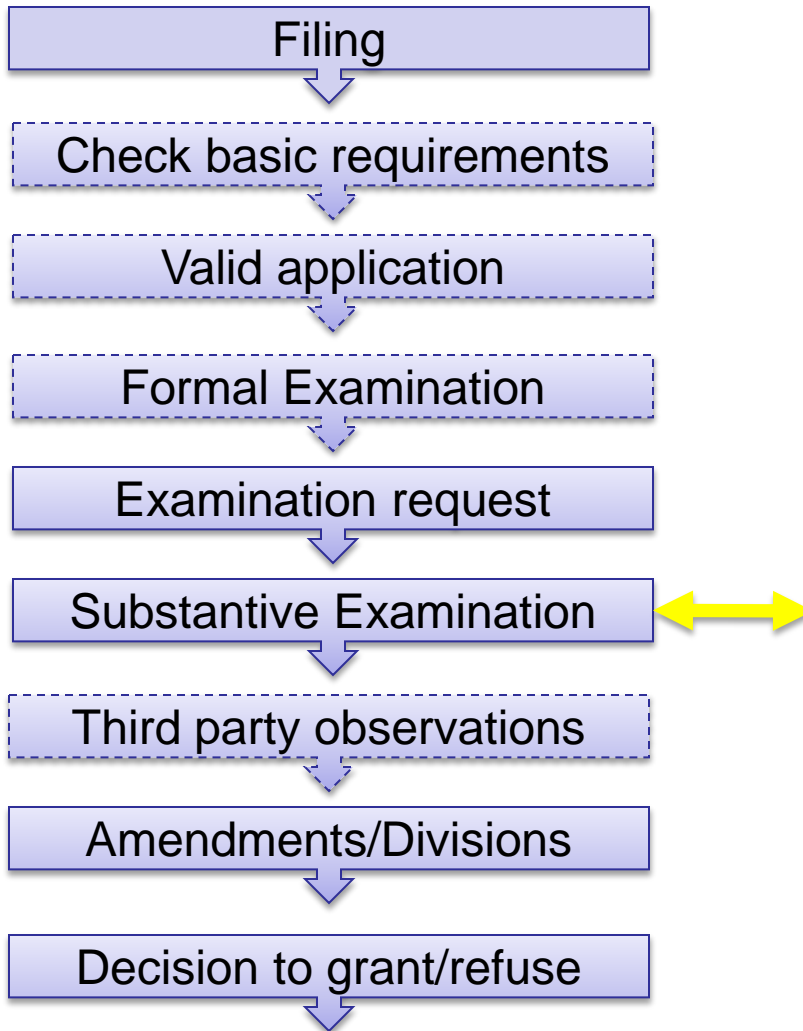
Elements of pre-grant prosecution



Elements of pre-grant prosecution



Elements of pre-grant prosecution



Further requirements:

- **Unity**
- **Technical nature**
- **Exemptions**
- **Sufficient disclosure**
- **Clear claims > legal certainty**
- **No additions to initial disclosure, e.g. through amendments**

Actions and communications

Search and examination report by examiner
with or without proposal for patentable claims

Included in file wrapper
Accessible through file inspection

Applicant's reply or withdrawal
with or without proposal for amended claims

Examiner to check:

- whether **amended claims** are within **initial disclosure**
- whether claims are properly worded

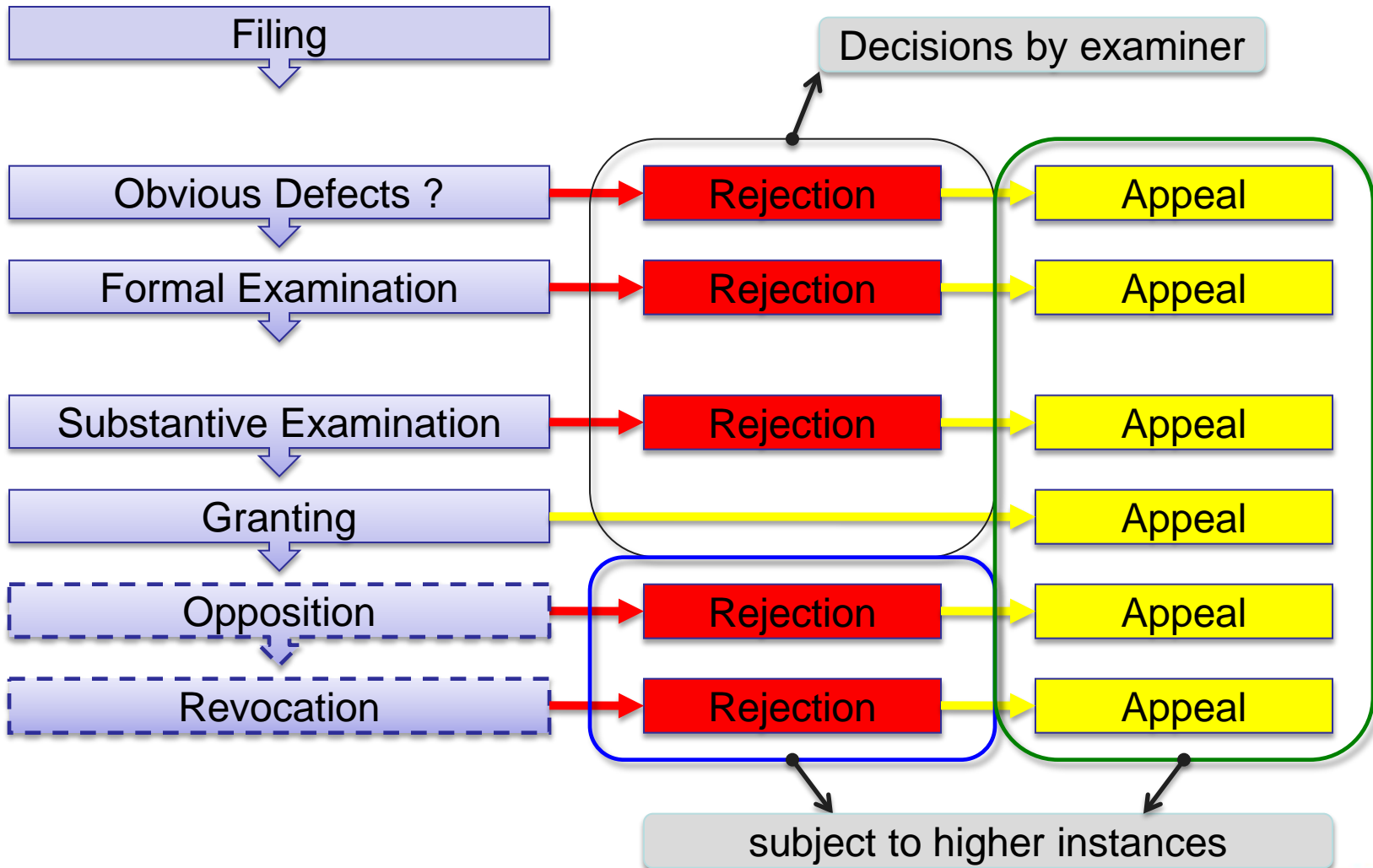
Top-up search if amended claims include features disclosed only in initial description and not in searched claims

If no withdrawal

Examiner to reject with detailed reasoning

Examiner to grant and check publication (nothing added to initial disclosure)

Elements of patent prosecution



Sequence of examination

■ Substantive patent examination has to check

- Technical nature
- Unity
- No case of **exclusion**
- Industrial applicability
- Novelty
- Inventive step
- Sufficient disclosure
- Legal certainty of claims (clarity)
- Additions to initial disclosure

Should be checked before prior art search

Requires prior art search

Grant phase

- In many jurisdictions, third parties are given the opportunity to file an opposition
- E.g. for EPO up to 9 months after publication of grant
- Examination may have overlooked certain relevant prior art, e.g. examiners focus on publications included in PCT minimum documentation
- Opposition body decides whether grant is
 - maintained
 - modified
 - revoked
-

Post grant phase

- Parties facing infringement litigation can request revocation of patents
- [redacted] Court may revoke patent on his own finding or on request by any party
- Almost the same patentability requirements apply
 - Except lack of unity
- [redacted] If patent was obtained by fraud or misrepresentation or **concealment** of any prescribed significant information

- How to organize efficient quality patent prosecution with limited resources?

A patent and its global family

- All starts with an **invention**



- Application for patent at **OFF** (**O**ffice of **F**irst **F**iling)



- Subsequent applications at **OSFs** (**O**ffice of **S**econd **F**iling)

- **With** claiming **OFF priority** (Paris Convention, TRIPS)

- > OSF recognizes filing date of OFF (priority date)

- **without** claiming priority

- > actual (later) filing date

Opportunities through patent families

- Utilisation of external examination results is possible if same or similar invention was filed in several IPOs
 - OFF: Office of First Filing
 - OSFs: Office(s) of Second Filing
 - Simple family (usually same invention, ie most likely similar claims)
 - Extended family (at least similar invention, claims may differ)
 - Technical family
- **Active worksharing**: avoid **duplication of work** by active organisation of the work distribution; e.g. OFF treats applications with priority and OSFs wait for results
 - Some collaborations started, e.g. Vancouver Group (AU, CA, UK)
 - ASPAC?
- **„Passive worksharing“**: Use results that were obtained for family members at other IPOs

Passive worksharing (PW)

- PW is a very effective strategy for small IPOs to cover all technical areas
- PW is an efficient strategy to cope with backlogs
- PW can also also enhance efficiency and quality at any IPO
- Currently many IPOs examine in parallel, i.e. little active worksharing
- Utilization of examination results obtained by other IPOs provides general **benefits** and may improve patent quality at **any IPO**, because:
 - Other IPOs may have access to other information resources
 - Individual examiners at other IPO may have particular expertise in a certain field
 - Learning from/improving other search strategies
 - Examination reports may include valuable arguments/particular views
 - However, there are also benefits derived from duplicated work

Example: PCT NPEs in Sri Lanka

National Application Number	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	Grants but in Extended Family	Observations
16814	WO2011098918	16	1	MA, US		JP	EP, AU, CA, CN, KR		negative reports by EP and AU; initially filed PCT claims not patentable; US-B2 claims 1 is very different from WO-A1 claim 1.
16825	WO2011101229	19	3 (to be corrected by EPO)	AU, MA, EP			US,		revived in US; intention to grant in EP, initially filed PCT claims do not appear to be patentable in view of EP and US reports. AU-B2 main claim is different from WO-A1 main claim.
16828	WO2011103120	44	4	AU, 4xUS		JP	EP, KR	3xUS-B2, CN-B, AU-B2, EA-B1, JP-B, MA-B1	4 US (divisions?) are an indication for a lack of unity; to be checked
16832	WO2011112816	24	1	AU, MA, 2xUS		JP	EP, KR		2 US are an indication for a lack of unity; to be checked. US-B2 and AU-B1 main claims are totally different from WO-A1.
13838	WO2011107527	23	1	AU, CN, EP, US			JP		All granted main claims are different from WO-A1 and also from other granted claims
16842	WO2011113363	28	1	AU, CN, CA, EA, EP, GE, MA, UA, US, JP, KR					ONLY A in ISR; US-B main claim is different from WO-A1 and AU-B, CA-C, EP-B main claims, which are identical
13843	WO2011112662	22	2	CN, JP, EP, US	AU		KR, CA		EP-B1 claim appears to be equivalent to very long WO-A1; US-B2 claim is different, appears to be wider.
16845	WO2011113362	28	1	AU, CA, CN, EA, EP, JP, KR, US					AU-B2, EP-B1, JP-B, CN-B and CA-C main claims are equivalent to WO-A1; US-B2, KR-B main claim is more narrow by incorporating claim 2 of WO-A1.
16847	WO2011112170	9	1	AU, CN, JP, US			EP		AU-B2 claim and US-B2 claims are different from main claim of WO-A1; WO-A1 should not be granted as is.
16849	WO2011121407	9	1	CN, EP, US			EP		US-B2 and EP-B1 main claims are restricted in comparison to WO-A1 main claim; WO-A1 claim includes additional options and should not be granted as is. (2xEP-A1: unity?)

Patent prosecution – summary of options

Option 1

- ▶ Doing full substantive examination in **all** or **some** areas of technology


Option 2

- ▶ Utilize **grants/rejections** of other IPOs
 - requires identical claims & cooperative applicants
 - requires claims compatible with national law
 - implies considerable delay because final results have to become available

Option 3

- ▶ Utilize **pre-grant results**, e.g. search reports, of other IPOs, e.g. via ICE, ASPEC, AIPN, KPION..
 - implies some but smaller delay than option 3

Example: Cambodia patent law




Article 31.-

The applicant shall, at the request of the Registrar, furnish him with the following documents relating to one or more of the foreign applications referred to in Article 30 of this Law:

- (i) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;
- (ii) a copy of the patent granted on the basis of the foreign application;
- (iii) a copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application.

The applicant shall, at the request of the Registrar, furnish him with a copy of any final decision invalidating the patent granted on the basis of the foreign application referred to in the 1st paragraph of this Article.

Example: Cambodia patent law


Article 37.-

The Registrar shall take into account, for the purposes of Article 36 of this Law, as following:

- (i) the results of any international search report and any international preliminary examination report established under the PCT in relation to the application; and/or
- (ii) a search and examination report submitted under item (i) of the 1st paragraph of Article 31 of this Law relating to, or a final decision submitted under item (iii) of the 1st paragraph of Article 31 of this Law on the refusal to grant a patent on, a corresponding foreign application; and/or
- (iii) a search and examination report which was carried out upon his request by an external search and examination authority.

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!

Procedural principles

■ Principle of party disposition


- Applicant determines beginning, end and extent of proceedings through requests

■ Applicant's requests determine the extent of each proceeding

- Binding effect for examiner as to content and sequence of requests, e.g. examiner can grant only claims with wording that the applicant requests
- Examiner to decide either “Yes” or “No”
- Examiner cannot amend and grant the application without the consent of the applicant

Fundamental procedural principle

■ Right to be heard, fair trial

- Guaranteed by constitution, international treaties, European Human Rights Charta,.. 

- Adverse decisions like a rejection can only be based on reasons that

- were previously communicated to applicant, and
- if he has had an opportunity to respond to it (it is not necessary that he did respond)

- Appeal to court against adverse decisions of the registrar (e.g. to reject) 

Thank you

lutz.mailander@wipo.int