

Exercises Topic 11 – Priorities and relevant prior art

We are going to use following freely accessible databases offering patent family information:

EPO Espacenet: <http://worldwide.espacenet.com/>

CCD: <http://ccd.fiveipooffices.org/CCD-2.0.8/>

The objective of these exercises is to familiarize ourselves with priorities, relevant prior art, and study some claims.

Task 1: [WO2011074782](#) in Espacenet (continuation from Task 1 of Topic 10 exercises)

Q: Fig. 5 of the EP application comes from which of the two KR priorities? Which priority date would be applicable for determining the relevant prior art related to technical features disclosed in relation to this figure? This is a tricky task! How do you check the disclosure of a priority and how do you find this disclosure?

A: You have to check the certified copies of the priority documents. The older priority KR..898 (please note, this is a priority number, not a publication number!) was never published as such. However, a certified copy is available, e.g., through file inspection of [EP-Register](#) or Patentscope. When you view the later applications claiming the priority of this older application you will never be able to distinguish the original disclosure of KR..898 from later additions.

Figure 5 is only disclosed in the later priority KR..035 and the priority date related to this priority application is 28.10.2010 which is 10 month after the other priority date of 16.12.2009 of KR..898.

Q: Is this figure also included in both KR publications in the extended family?

A: Both KR publications in the family show this figure, i.e. both applications include additions of subject matter in comparison to the first priority they claim. Although KR20130129336 claims only this priority (KR..898) it includes additions. The original disclosure of KR..898 is only accessible through the certified copy submitted to the EP and WO applications.

Task 2: Search [WO20130104074](#)

Q: Compare the drawings of the WO and CA family members (all have the same priority). Which drawings in the WO are additions of art not disclosed in the priority?

A: Fig. 1, 2 are different, Fig. 5 is totally new.

Task 3: Search [WO2013066270](#)

Q: Compare the drawings of the WO with the two SG priorities.

A: Many drawings are not even disclosed in the two priorities. The older SG priority has only one circuit lay-out.

Q: Where the time lines for claiming the two priorities observed?

A: Yes

Task 4: Search the family of [WO2006138751](#) (an example from topic 3 exercises)

Q: How many family members are there in the extended family? What is the common priority and from when is it? Have any patents been granted?

A: There are 4 different domestic families (AU, WO, US, ZA). Each domestic family has a single member; the simple and extended families are identical. They all claim a ZA priority with priority date 23.6.2005. No patent has been granted.

Q: The ZA family member was published in 2009. When was it filed? What date would have to be applied for determining the relevant prior art if the PCT Examination Guidelines were applied?

A: The ZA family was filed on 21.1.2008 and published approximately 15 months later on 24.6.2009. It claims the priority of an earlier domestic filing on 23.6.2005. According to PCT examination Guidelines, the priority date is applied for determining the relevant prior art only, if the later application claiming the priority was filed within 12 months from the priority date. That is not the case here! So, the date for determining the prior art would be the filing date which is 21.1.2008. Since a family member disclosing the invention was already published on 28.6.2006, a patent could most likely not have been granted because of a lack of novelty.

Task 5: Revisit the examples on slides 34 and 36 of the Topic 4 presentation, and try to determine the dates relevant for the prior art.

A: Slide 34 situation:

- i) the application claims priority 1 and 2: only priority 2 is validly claimed within the 12 months period; the respective priority date determines the prior art if claimed subject matter is fully disclosed in this priority document; for all claimed subject matter that is not fully disclosed therein, the application date determines the prior art.
- ii) the application claims priority 2 which claims priority 1: priority 2 is validly claimed within the 12 months period; for examination of the application, it doesn't matter that priority 2 has claimed priority 1, i.e. priority date 1 is irrelevant for examination of the application. Like in i), the respective priority date 2 determines the prior art if claimed subject matter is fully disclosed in this priority 2; for all claimed subject matter that is not fully disclosed therein, the application date determines the prior art.

Slide 36 situation:

- i) the application claims priority 1 and 2: both priorities are validly claimed within the 12 months period; the priority dates determine the prior art, provided the claimed subject matter is fully disclosed in the respective priority document.
- ii) the application claims priority 2 which claims priority 1: priority 2 is validly claimed within the 12 months period and determines the relevant prior art for claimed subject matter fully disclosed in priority 2. Priority date 1 is irrelevant for examination of the application.