



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

Lutz Mailänder
Head, Patent Information Section
Global IP Infrastructure Sector

Bangkok
21-23 November 2012
Hanoi
26-28 November 2012

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. Jordan, Malaysia, Thailand, Viet Nam,...)
- IPOs with **long 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** (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 DCs

- Efficient patent prosecution procedures for
 - **foreign** (including PCT; 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
 - despite similar patentability and quality requirements
- Strategies for coping with limited resources:
 - Avoid duplication of work and exploit work/results of other IPOs where available (“**passive worksharing**”)
 - Active (i.e. coordinated) worksharing between IPOs

Required examiner capacities

Patent Examiner

Scientist / Engineer

Legal Specialist
„State Patent Attorney“

Depending on
application

Specific technical expertise in area of subject
matter

Knowledge in patent law, regulations:
Novelty, Inventive Step, Claim Wording,...

Independent of
application

Legal basis of substantive 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)

Examination Guidelines/Manuals

▶ EPO Guidelines

<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)

▶ 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>

> **Topic 10: differences**

Types of patent applications

- **Truly national/domestic first filing**

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

- **PCT national phase entries**

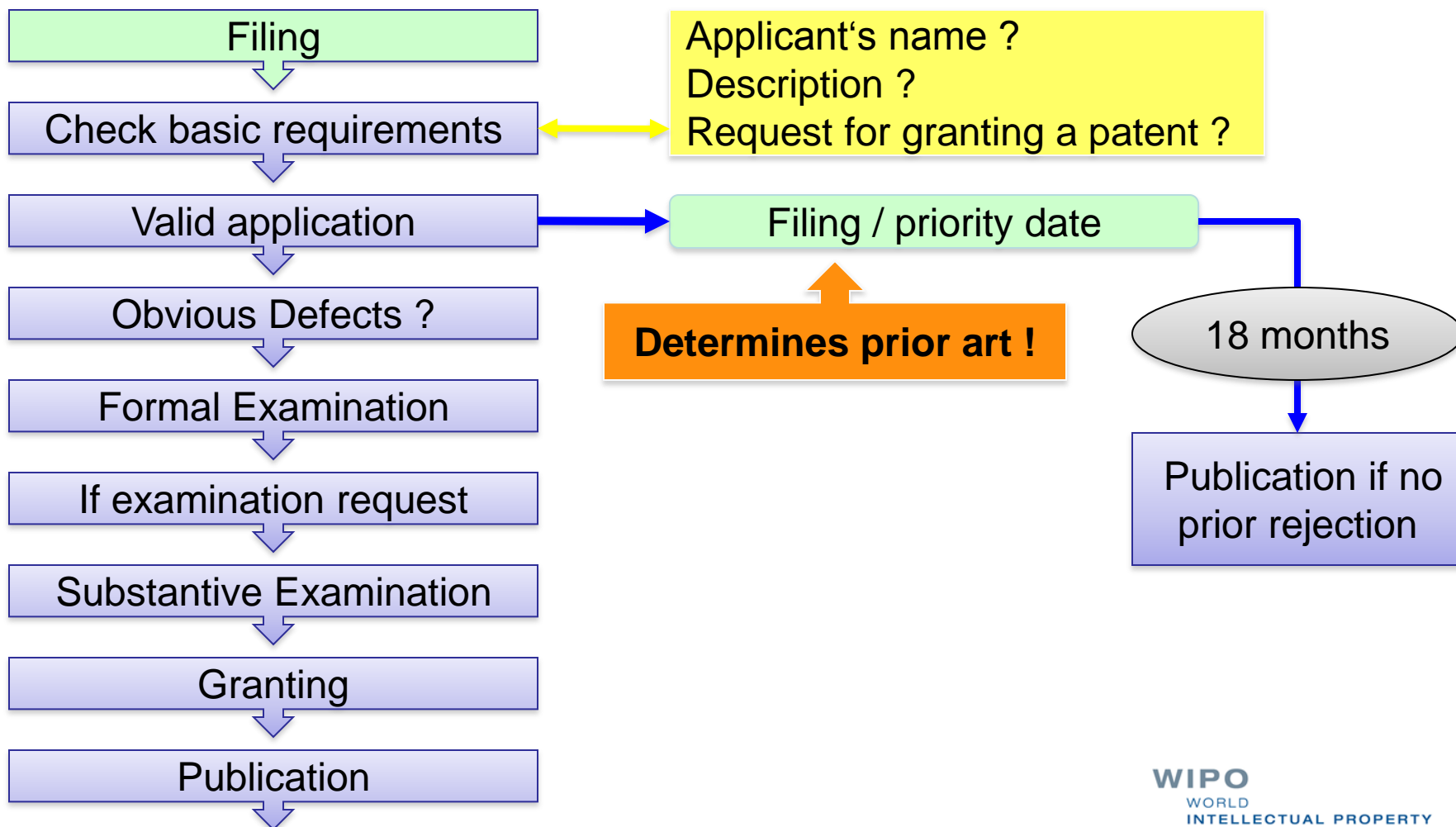
- application is member of **patent family**

- **non-PCT foreign filings (second filings)**

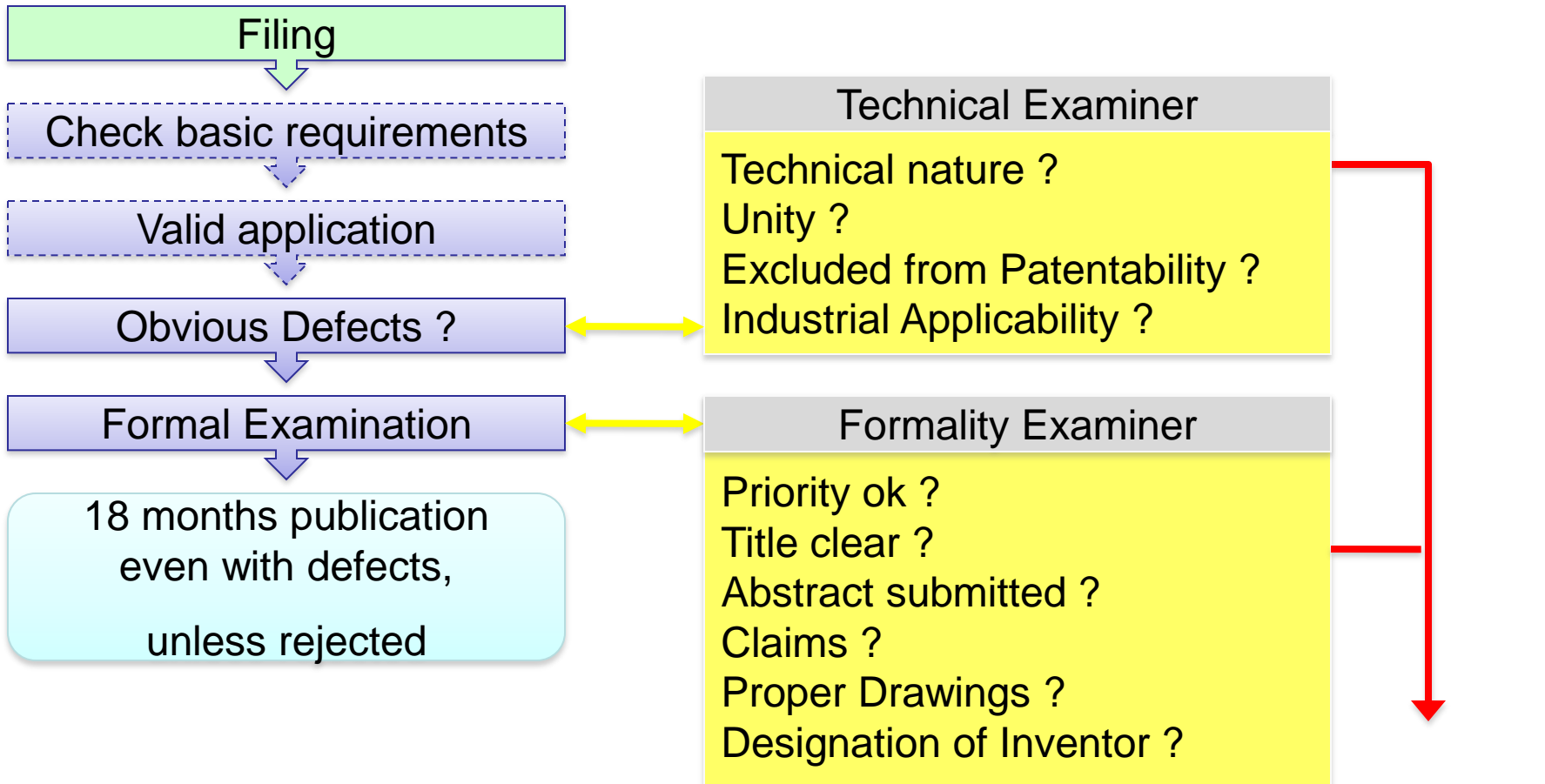
- priority claimed, i.e. is member of (Paris) **patent family**
- priority not claimed:
 - > **"technical" family** because same invention

> **Topic 3: patent families**

Elements of patent prosecution



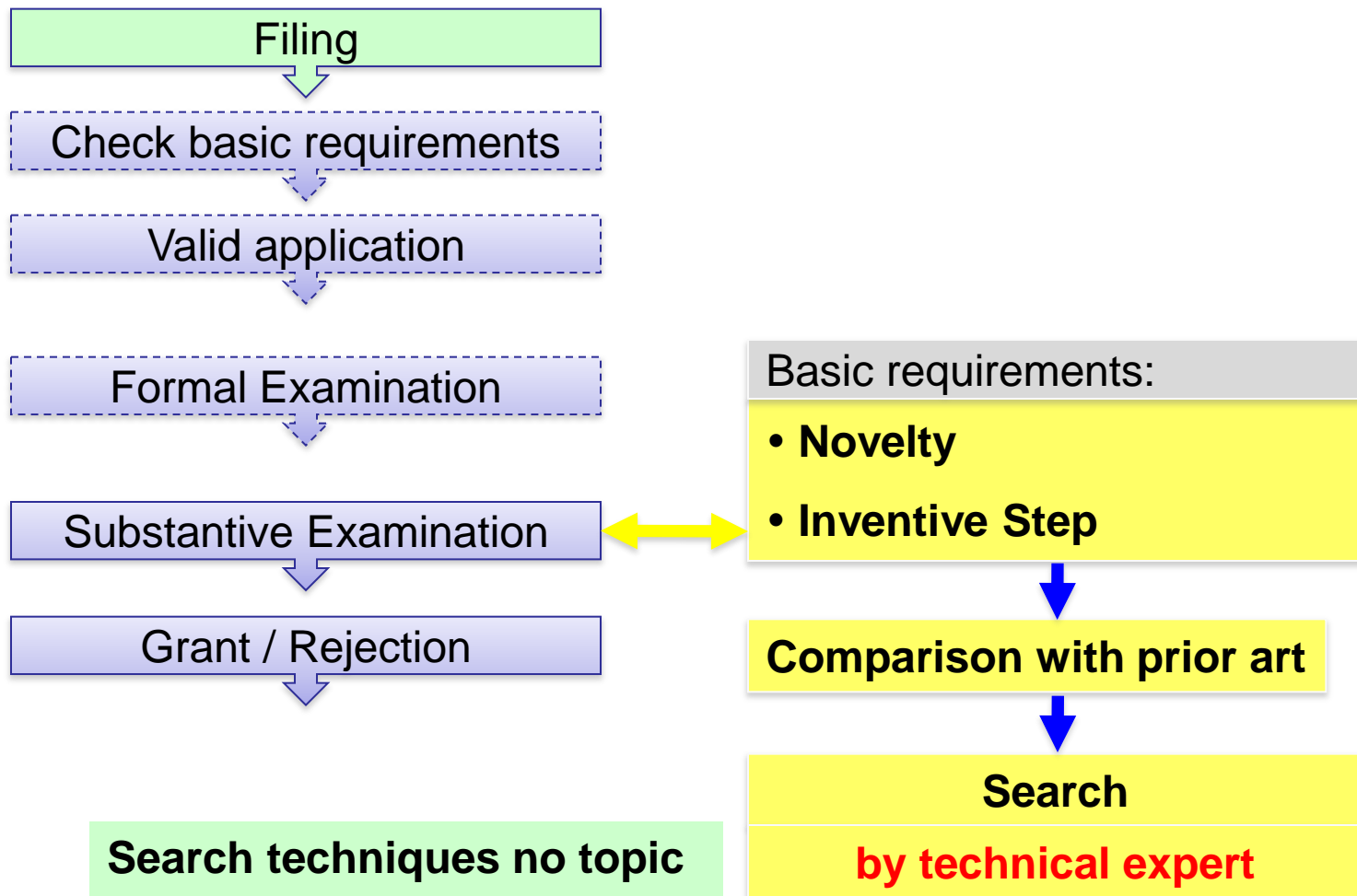
Elements of patent prosecution



Rejection

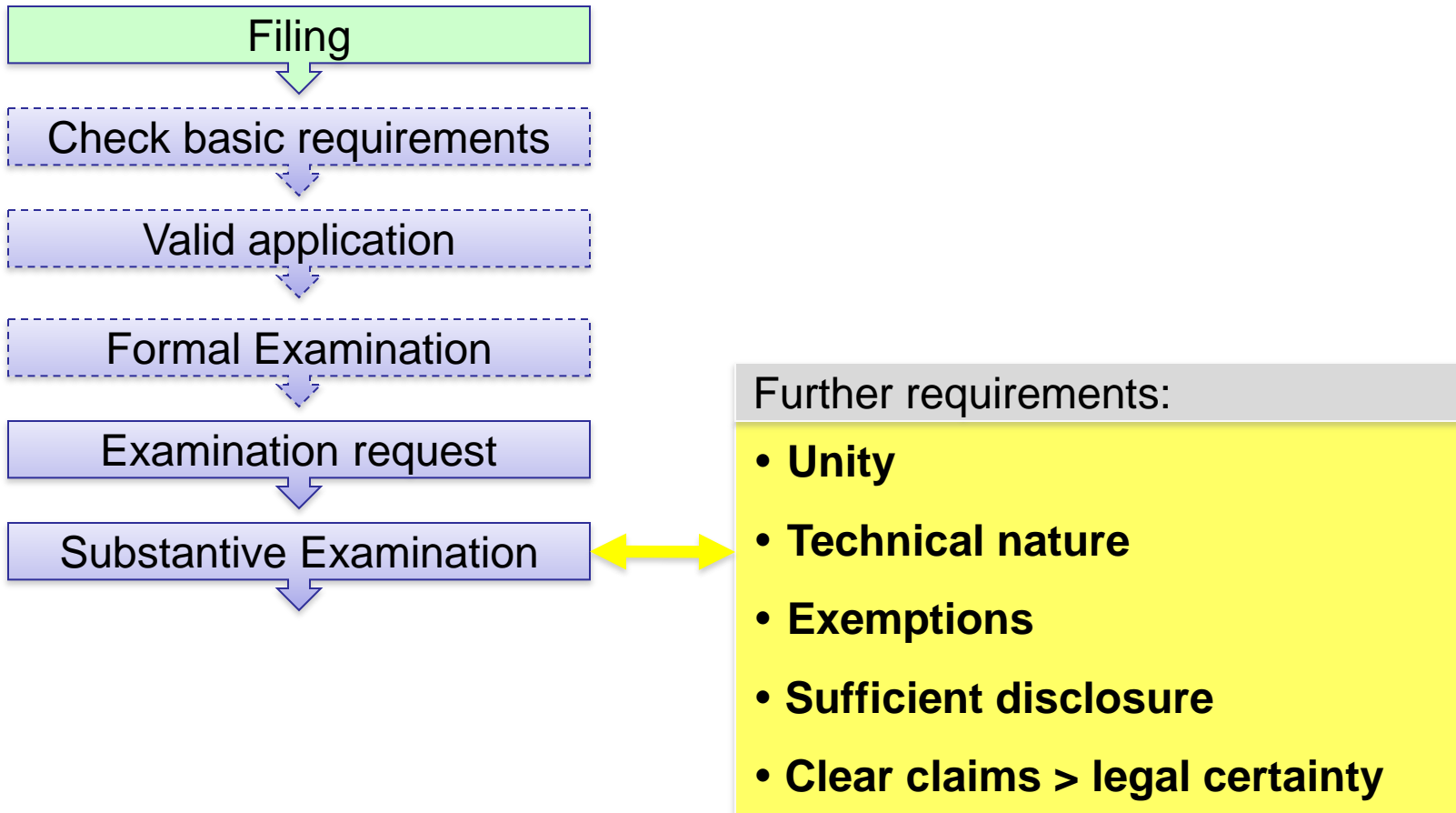
> **Topic 11**

Elements of patent prosecution



Search techniques no topic
Search reports: Topic 8

Elements of patent prosecution



> Topic 10

Elements of patent prosecution

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

Applicant's reply
with or without proposal for amended claims

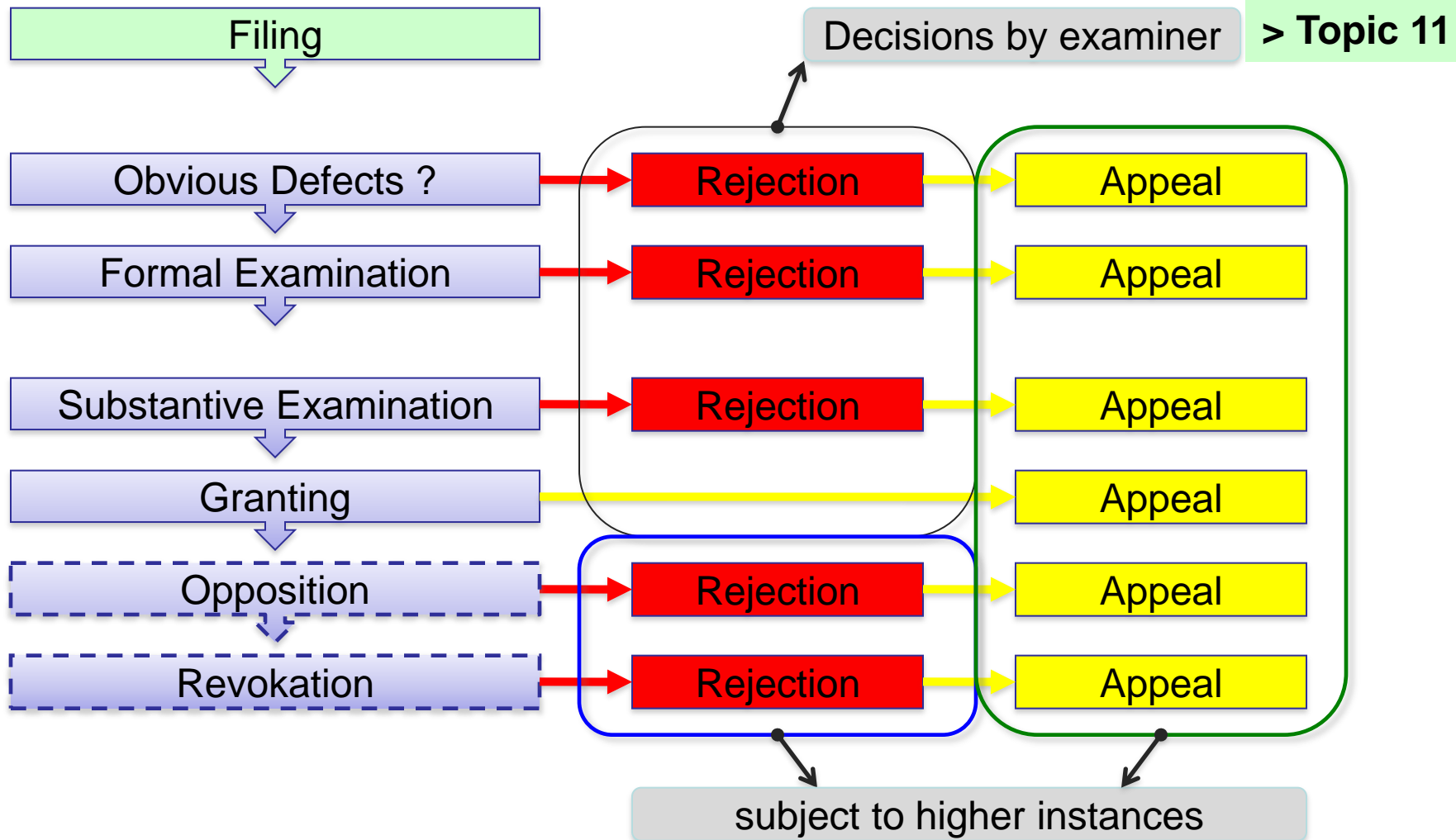
Examiner to check:

- 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

Examiner to reject with detailed reasoning
Examiner to grant and check publication (nothing added to initial disclosure)

Elements of patent prosecution



National patent applications

Applications with foreign priority / PCT / second filing abroad

Use foreign results
(> **passive outsourcing**)

Examiner with technical expertise

Do own substantive examination

Examiner without technical expertise

Get help (e.g. ICE)
(> **active outsourcing**)

Interaction with applicant / Decision on what to grant

Granted / refused patent

sovereign task

National sovereignty

Paris Convention 1883:

- **No** obligation to use results of others, or to follow their conclusions
- 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!

Options for substantive examination

National patent applications

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graph TD; A[National patent applications] --> B[Applications with foreign priority / PCT]; A --> C[Examiner with technical expertise]; A --> D[Examiner without technical expertise]; B --> B1[Use foreign results (> passive outsourcing)]; B --> B2[IL: using foreign results]; C --> C1[Do own substantive examination]; D --> D1[Get help (> active outsourcing)]; D --> D2[JO: Use ICE]; D --> D3[SG: paid outsourcing];
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Applications with foreign priority / PCT

Use foreign results
(> **passive outsourcing**)

IL: using foreign results

Examiner with technical expertise

Do own substantive examination

Examiner without technical expertise

Get help
(> **active outsourcing**)

JO: Use ICE

SG: paid outsourcing

Example: Singapore

- Outsourcing of paid S&E to other IPOs (AU, AT, HU, DK) for "local route"
- For all types of applications, including PCT national phase entries
- Outsourced examination based on SG patent law and regulations
- Self-assessment by applicant based on examination report (currently under review)
- Similar outsourcing by GCC, UAE, ...

Example: Israel

- Law explicitly authorizes that the granting decision is based on granting decisions of selected offices (e.g. US, EP, DE), if
 - applicant requests so
 - claims are identical
- Law authorizes the Registrar to proceed differently
- Applied to only 20% of possible cases
- Similar practice in other jurisdictions but often without legal foundation, just pragmatic approach

Example: Jordan

- Two track system:
 - foreign results available and usable:
 - > wait for availability of final results
 - foreign results unavailable or not usable:
 - submit request to WIPO's ICE service
 - preliminary examination prior to submission (claim quality,...)

Patent prosecution – summary of options

Option 1:

▶ Doing full substantive examination (search, examination, granting), in all or some areas of technology

Option 2

▶ Paid outsourcing of full search&examination

Patent prosecution – summary of options

Option 3

- ▶ Rely fully on **grants/rejections** of other IPOs
- possible for PCT, foreign priorities, including technical families
- not possible for truly national filings, unless in case of second filing abroad
- requires identical claims & cooperative applicants
- requires claims compatible with national law
- implies considerable delay because final results have to become available

Patent prosecution – summary of options

Option 4

- ▶ Use only **S&E results**, e.g. search reports, i.e. **not** the final results, of other IPOs, e.g. via ICE, ASPEC, AIPN, PPH, other regional cooperations:
 - possible for national filings (through ICE)
 - possible also for PCT, foreign priorities
 - implies some but smaller delay than option 3

Workshop objectives

- Understanding concepts of patent families
- Identification of foreign family members of pending national application and their examination status
- Retrieval of (intermediary or final) results of examination of family members at other IPOs that treat
- Utilization of results in national context
- Enhancing efficiency of substantive examination while observing national sovereignty

Thank you