



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

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# Previous similar workshops

Funded by FIT-JP

- Nov 2011: Sub-regional Asian IPOs
- Jul 2012: Sub-regional English speaking African IPOs
  - [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=26624](http://www.wipo.int/meetings/en/details.jsp?meeting_id=26624)
- Nov 2012: National: Thailand, Viet Nam
- Q2 2013: Arab IPOs
  
- Mar and Aug 2012: Module für newly recruited examiners of IP India

# 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

# Substantive examination in small IPOs?

- What is the minimum size, i.e. number of examiners ?
- What access to database resources is needed ?

# 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

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

French: [http://www.epo.org/law-practice/legal-texts/guidelines\\_fr.html](http://www.epo.org/law-practice/legal-texts/guidelines_fr.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](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/ipr/patent/DraftPatent_Manual_2008.pdf)

[http://ipindia.nic.in/PatentOfficeProcedure/PatentOfficeProcedure\\_2009.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**

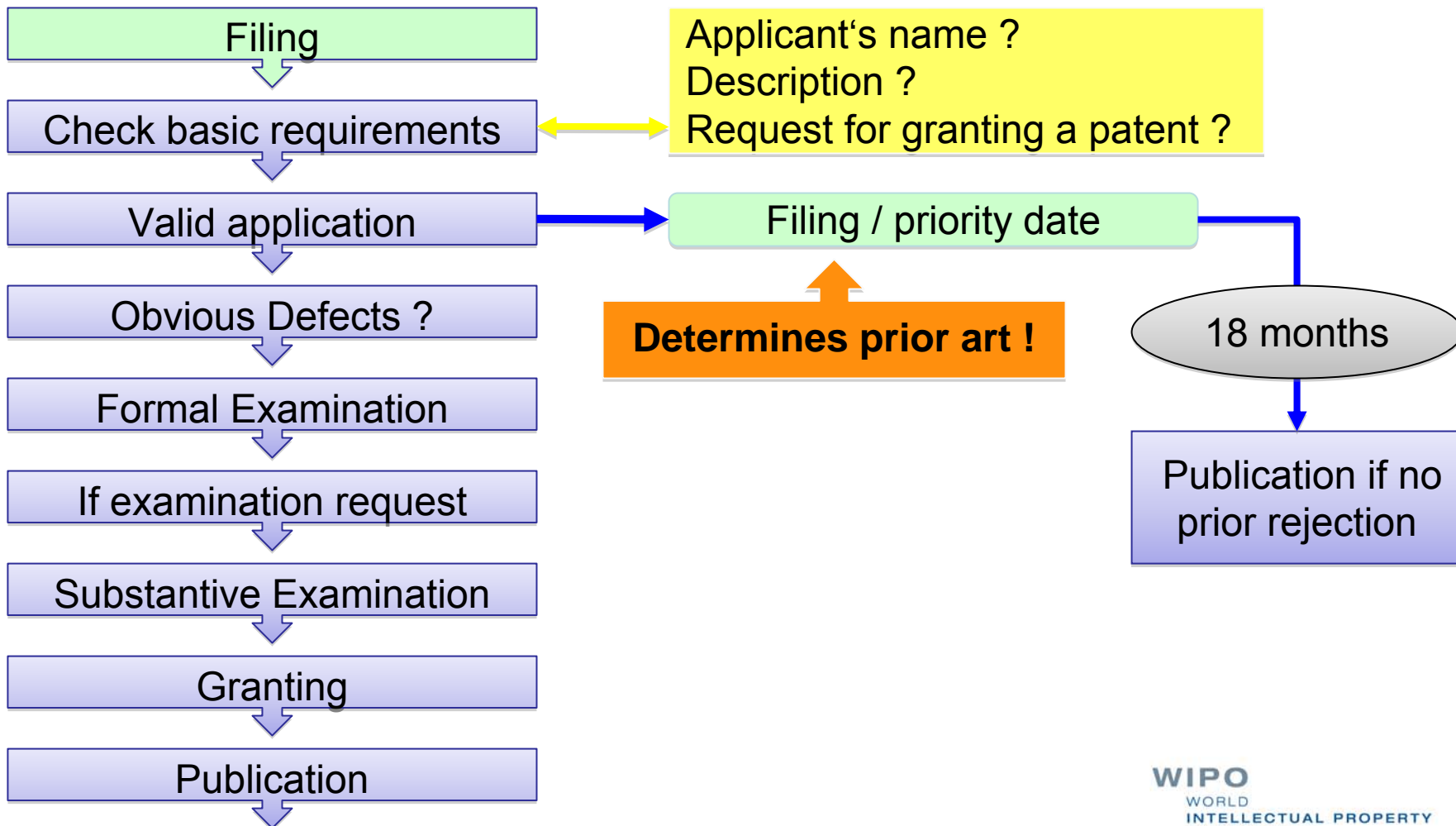
- application is member of **patent family**

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

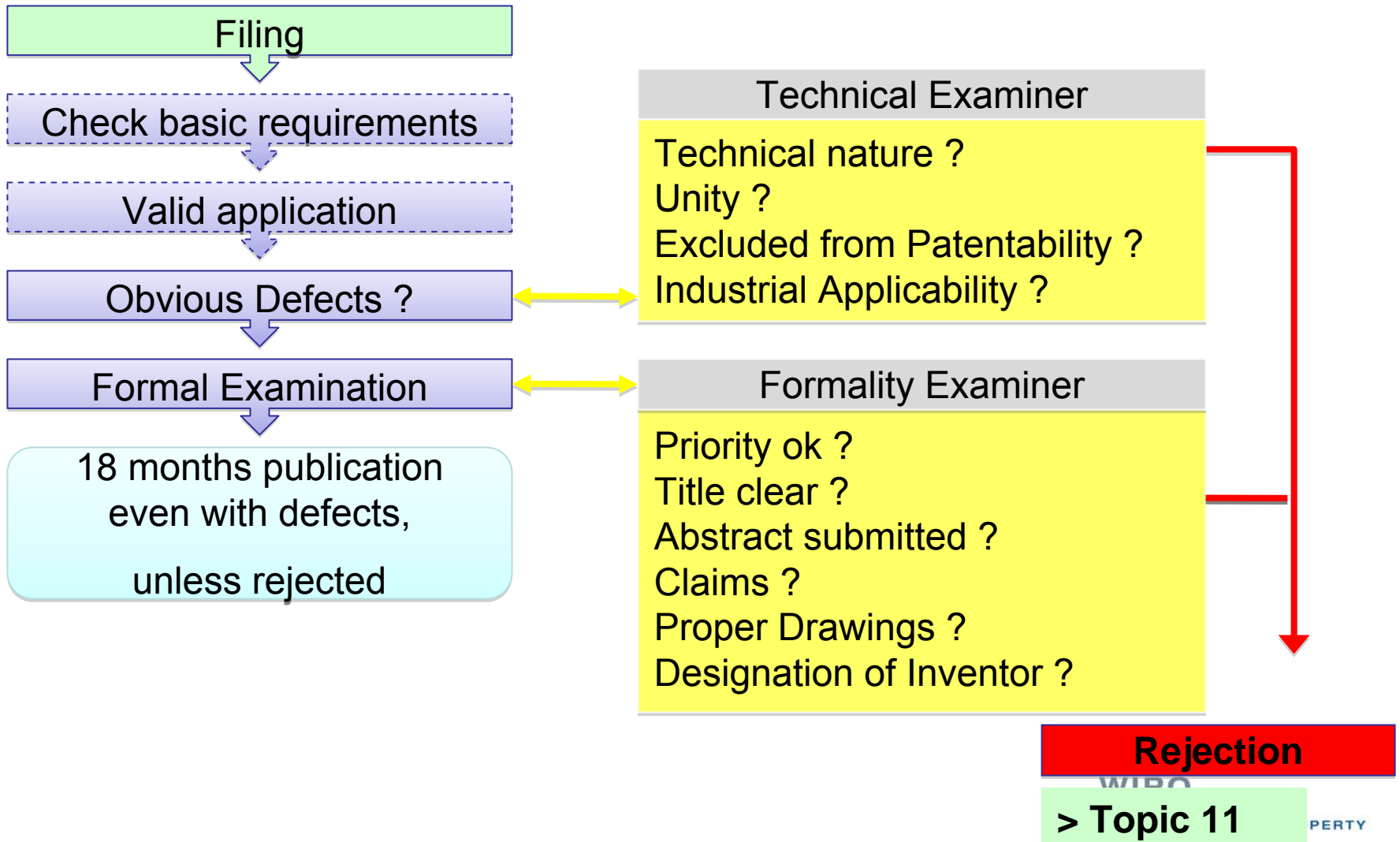
- priority claimed, i.e. is member of (Paris) **patent family**
- priority not claimed:
  - > **"technical" family** because same invention

> **Topic 2: patent families**

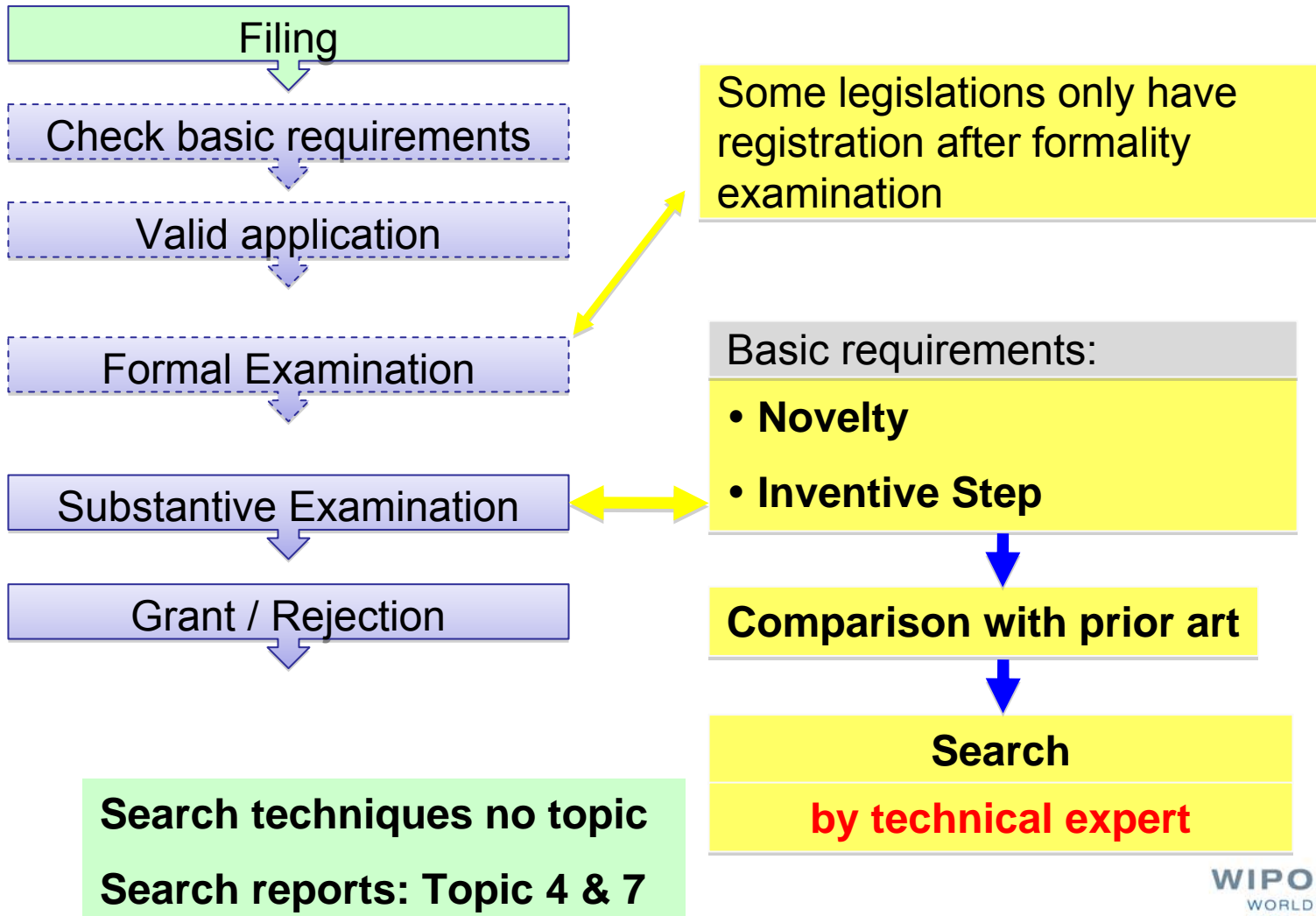
# Elements of patent prosecution



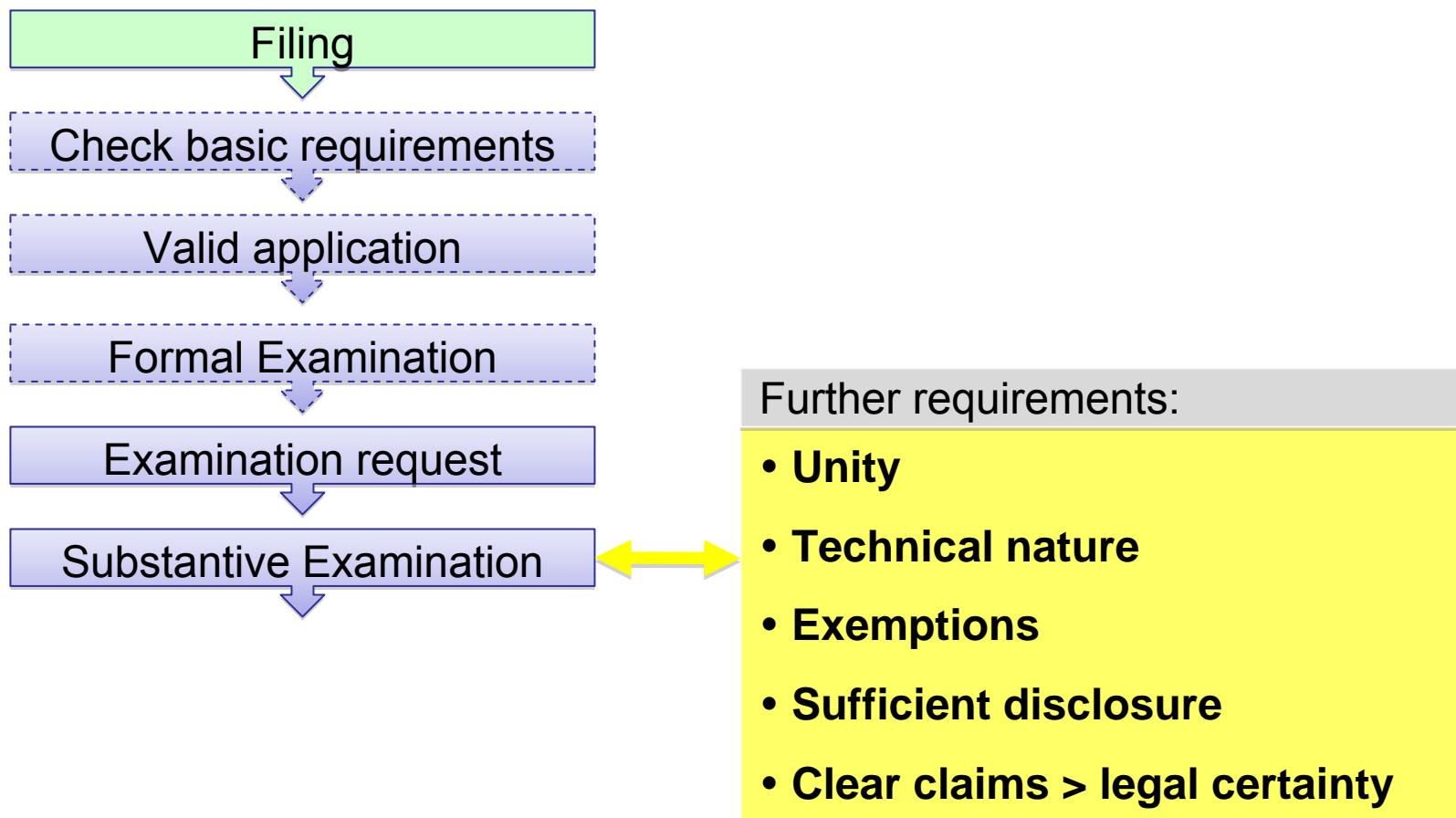
# Elements of patent prosecution



# Elements of patent prosecution



# Elements of patent prosecution



> Topic 10

# Communications in patent prosecution

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

**Included in file wrapper**  
**Accessible through file inspection**

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

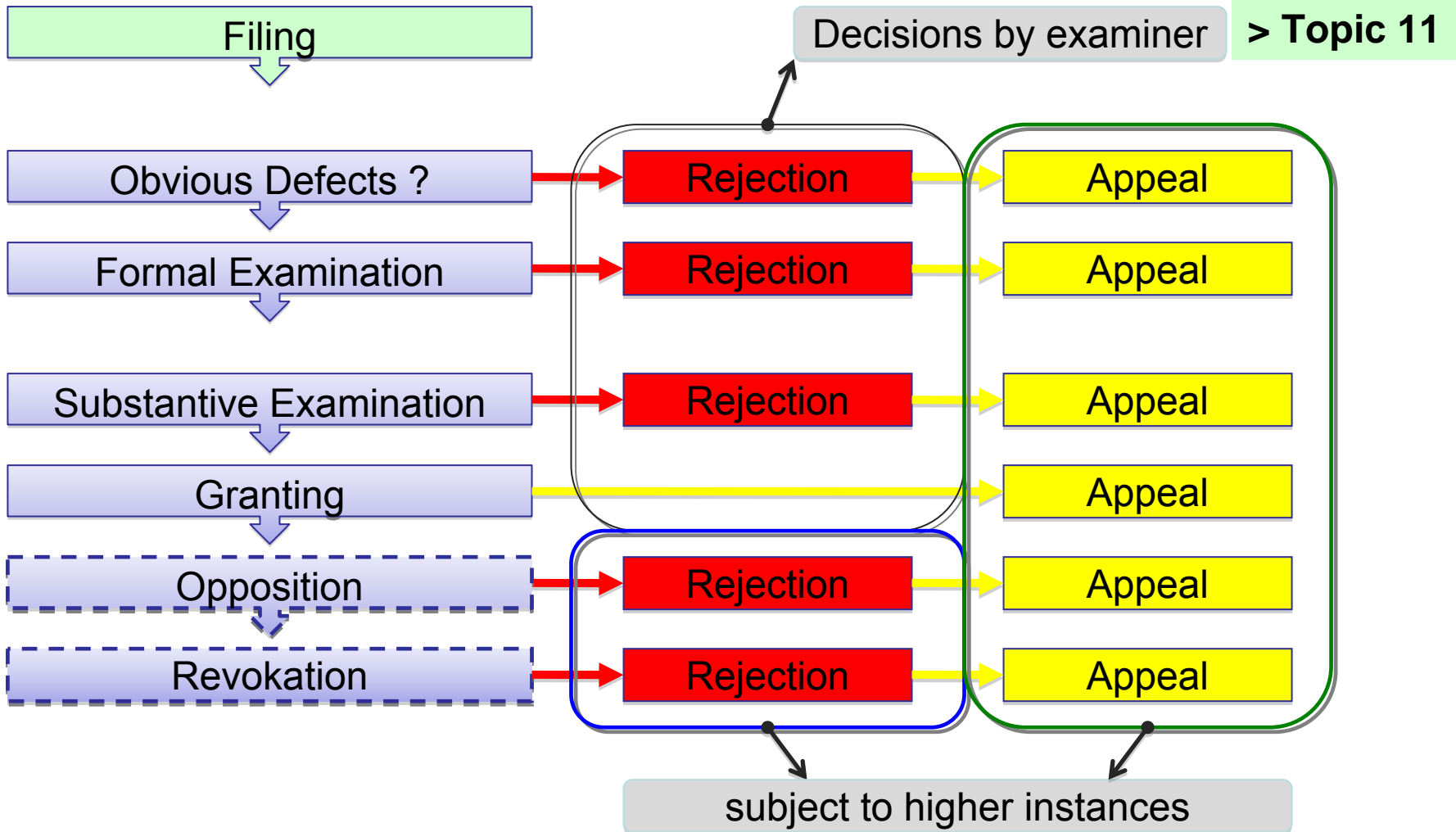
**Examiner to check:**

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

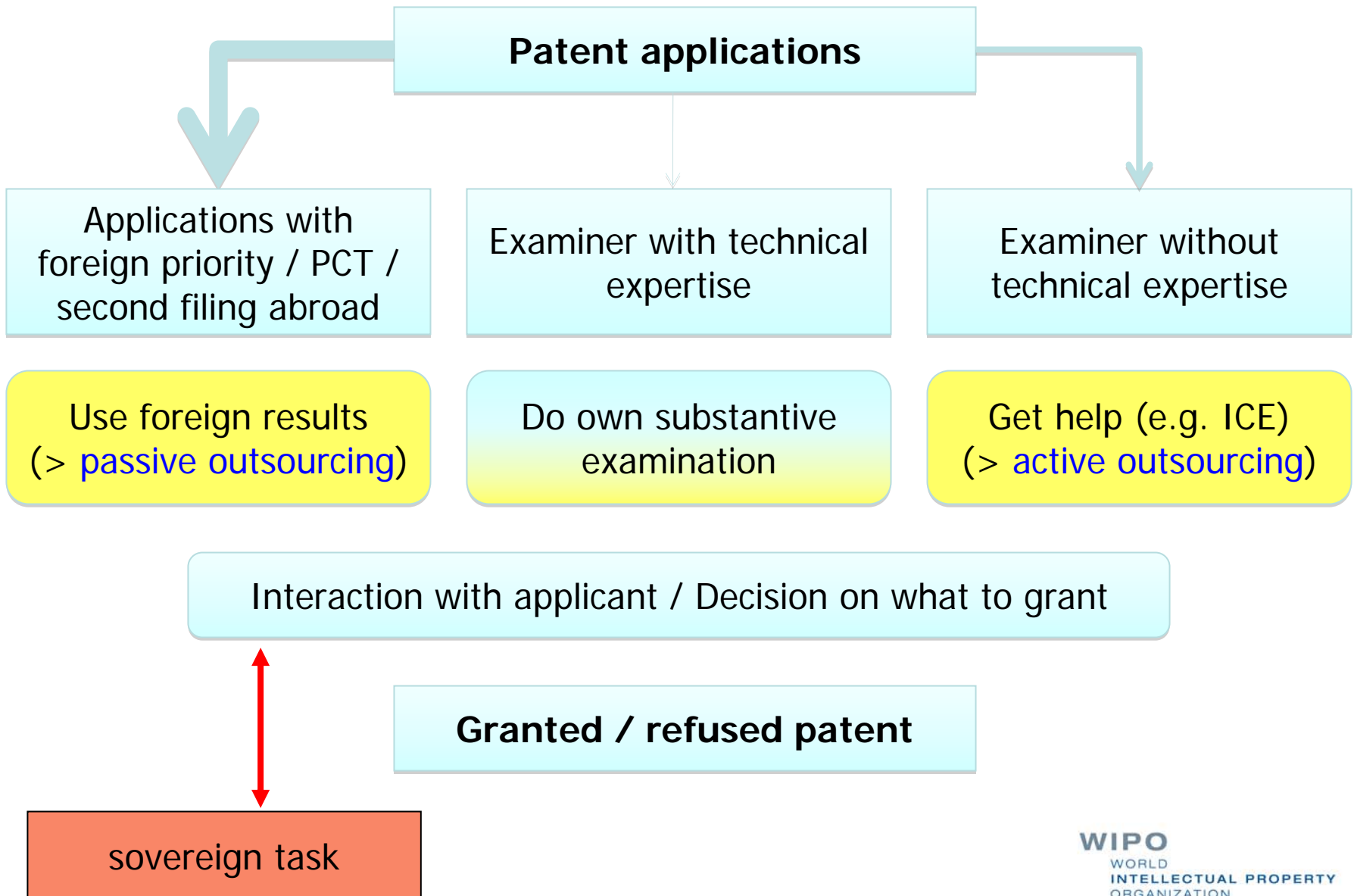
**Top-up search** if amended claims include features disclosed only in initial description and not in searched claims

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

# Elements of patent prosecution





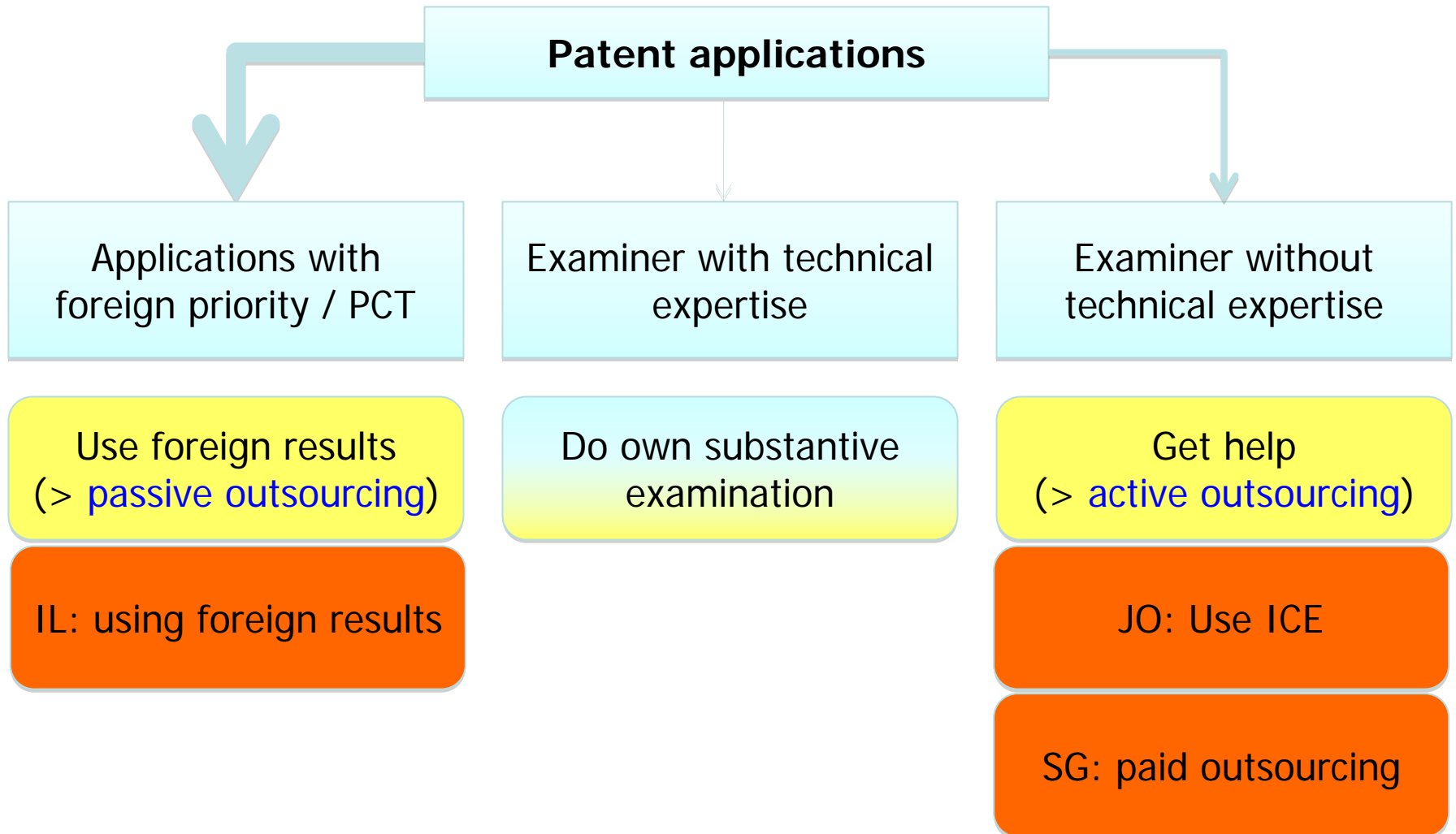


# National sovereignty

## 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](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



# 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; e.g. via PPH
- 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, KPION and 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

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