

Day 2 Exercises D – Exercises on interpreting search and examination reports

We are going to use following freely accessible databases offering patent status data and file inspection:

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

Espacenet also permits access to the EPO Register which permits file inspection.

Direct access to **EPO Register:** <https://register.epo.org/espacenet/regviewer>

EPO CCD <http://www.trilateral.net/ccd>

WIPO Patentscope: <http://www.wipo.int/patentscope/search/en/search.jsf>

US-PAIR: <http://portal.uspto.gov/external/portal/pair>

DPMA Register: <http://register.dpma.de/DPMAregister/Uebersicht?lang=en>

The objective of these exercises is to familiarize ourselves with search and examination reports and their interpretation.

Task 1: US application 12/490,946 in US PAIR (see [EP2138396](#) of exercises C)

Q: What is the first issue raised by the US examiner? Did he examine novelty of any claims and what is his opinion on claim 1?

A: The US examiner stated a lack of unity regarding the subject matter of claims 9-13. In a telephone conversation with the representative it was agreed to skip examination of claims 9-13. All other claims have been examined. As for claim 1, the examiner raises objections regarding the inventive step. He cites two relevant prior art documents and considers the combination of certain features of sail membranes described in both documents as obvious for someone skilled in the art. That means that he does acknowledge novelty of the subject matter.

Task 2: US application 11/093685 by using the CCD and US-PAIR (see Task 4 and 5 of exercises D)

Q: What does it mean that, in the WO search report, the prior art US6205274B1 has categories X and Y?

A: The category X (challenging novelty) applies to claim 1-8 and 11, i.e. this document alone appears to include all features of all these claims; Y applies to claims 9,10,12-24 (challenging novelty in combination with at least one other prior art, or the general knowledge of someone skilled in the art), i.e. this document appears to include at least one of the features of each of these claims. The other features not included in this document may be known from other Y rated documents or may be attributed the general expert knowledge.

Q: Try to identify the features of claim 1 in this prior art document.

Q: Which other prior art is relevant for assessing the inventive step of claim 9?

A: US6205274B1, US4021121A and the article of 'Harres'; however, from the search report it is not clear whether all three of them need to be combined, e.g. only two of them may be enough. The Written Opinion includes further explanations, according to which only two of the documents need to be combined (see argument 3.1).

Q: The USPTO granted a patent but was there ever a notification of a final rejection mailed by the USPTO ? What happened afterwards?

A: Select tab "transaction history". Yes, a final rejection was filed on 10.11.2006. However, this final rejection only applied to claims 22, 23, 25, 26, claims 1-8, 11-21, 27,28 were considered as allowable. The applicant then disclosed the prior art of the WO-A3 search report ("List of References cited by applicant and considered by examiner") on 12.3.2007, i.e. one year after the WO-A3 was published. The examiner thereafter issued a further examination report declining the inventiveness of the claim subject matter that he previously considered as allowable, in view of the article by Harres (document CTNF on 30.3.2007 in the file wrapper).

Q: Could the US examiner have known the WO search report when he issued his first examination report in which he considered the claims patentable?

A: Most likely yes: the WO-A3 was published on 24.3.2006, the examination report was issued on 28.4.2006. The examiners search strategy records were saved on 24.4.2006 (see document SRNT in the image file wrapper).

Q: What is the status of examination at EPO? Is the decision final?

A: Open the family member EP1864167 in Espacenet. The grant of a patent was refused on 7.02.2011. The applicant has filed an appeal which is still pending.

Q: How would you proceed in such a case?

A: The USPTO has granted a patent, the EPO intends to refuse the grant. It is suggested to wait until the appeal has been settled and to compare the arguments of the EPO and the USPTO, and decide which ones are more convincing, e.g. because of different prior art.

Task 3: [EP282251](#)

Q: Compare the search reports of EP-B1 and EP-B2 (publication after opposition), which document was added during opposition?

A: B2 is after opposition, there are 2 additional DE documents cited.

Q: Are there English language equivalents for these two documents?

A: Yes, there are US-A's for [DE3336991](#) and for [DE1773815](#); so these prior art documents can also be used by examiners not speaking German.

Q: Compare the main claims; which features are different? Which feature is known from the new prior art?

A: Claims can only be compared by looking at the PDF copies. The HTML page only shows the claims of the EP-A1 !!

Q: Is it possible to follow the course of discussions during the opposition?

A: Yes most is on file in the EP Register.

Q: What else has been changed in the specification?

A: Drawing 8 was removed, and respective narrative.

Task 4: [EP2138396](#)

Q: Is there an EP search report? Is there another search report? Check the legal status in the Register.

A: No EP-A3; no other search report despite filing date in 12/2009; DE-A1 family member could have a search report but does not have; reason why no A3 not known, according register, the application is pending, the renewal fee was paid on 12.6.2012. There were deficiencies but they were remedied; a search report is overdue but should become available.

Q: Look up the same document in US-Pair. Use the US application number. What is the examination status there?

A: You have to use the US application number 12/490946 as shown on the US-A1 document. All other formats don't work. Substantive examination has not yet been conducted, no search report is available.

Task 5: [WO2005055733](#)

Q: Check the WO search report. Which claims could perhaps be granted since the examiner has not cited prior art for the particular claim?

A: Claims 9, 10, 14-16, 19, 20 are not explicitly referenced in the search report.

Q: Check the international preliminary examination report. Does the examiner address all claims? What about claim 19, could it be granted?

A: Yes he addresses all claims, though some of them only summarily. He denies patentability partly because of a lack of novelty and partly because of a lack of inventive step. E.g. for claim 19 for which he has not cited any document he would have to refer to the average knowledge of someone skilled in that art to select the temperature range, or he would have to do a supplementary search during the national phase.

Q: Is there any further examination report?

A: No there is no other later report neither from the EP national phase nor the US national phase.

Q: Compare the [list of citations](#) in the EP Register with the CCD list of citations, the [list of citations in Espacenet](#) , and the PDF version of the A1 search report.

A: The list of citations is rather long and includes non-patent literature next to patent literature. In particular, the bibliographic data of the NPL is presented in very different ways and more or less detailed. The CCD list is only partially enriched since it is not indicated to which claims each document relates in view of its x-rating. In the register citation list, each patent document is linked and can easily be viewed. The PDF version of the WO-A3 appears to present the enriched search report in the clearest way.