

Exercises B (Topic 4) – Exercises on retrieval and utilization of external examination results

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 the online resources permitting access to examination results of other offices for family members, file inspection and examination status data.

Task 1: [DE19833712](#) (this is a case where we don't have an EP or WO search report, i.e. no X,Y,.. ratings)

Q: How many granted patents are in the extended family ? And in the simple family ?

A: 4 in the extended family, namely FR 2767193 B1, JP 4161410 B2, JP 4179389 B2, US 6595065 B2, and 3 in the simple family respectively.

Q: Can you retrieve the claims granted by the French office?

A: No. The claims offered through Espacenet are those of the FR-A1. There is also no original document of FR-B1 downloadable. The PDF may be obtained from the French office website, though.

Q: How would you retrieve the claims granted by the JPO?

A: Use AIPN.

Q: There is not yet a German patent. Is examination at DPMA still pending ? Check the Inpadoc legal status on Espacenet and check the status in the German register DPMARegister. Pay attention to the number formatting required there.

A: Last Inpadoc status entry is " REQUEST FOR EXAMINATION PARAGRAPH 44" from 2004/11/25; DPMARegister shows that the application is still pending. The register also shows that the fee for the 15th year is due on Jul 31, 2012.

Q: How many prior art documents have been cited by the German examiner?

A: You find them only in the register, not on the front page of the DE-A1 (the DE-A1 was published before the search was done; there are 5 citations, less than for the US-B1 document).

Q: How many other applications are citing this [DE19833712](#)?

A: Click in Espacenet on "citing documents"; there are 11 different domestic families citing this document. This can be useful to find other prior art by checking the search report of these documents as well.

Task 2: [EP2138392](#) in Espacenet

Q: How many EP publications with different kind codes are available and what do they mean?

A: 2; EP-A1 18 month publication of application with search report, EP-B1 publication of granted patent

Q: Is there an EP search report ?

A: There are 2 search reports, EP-A1 (separate pages), EP-B1 (summary on front page, note the different formatting of publication numbers with kind codes after country code); both have same citations; note that applicant cites additional JP-A-2007 283927

Q: Which other equivalents are there and what do their kind codes mean?

A: ES-T (Translation); AT-T(Translation); CN-A (publication of application)

For determination of kind codes see:

<http://www.wipo.int/export/sites/www/standards/en/pdf/07-03-02.pdf>

Q: The priority is from Japan. Is there a JP equivalent, i.e. a publication of the Japanese priority application?

A: No, surprisingly there is no JP publication despite the JP priority.

Q: What is the examination status at EPO ? Use the register link.

A: Examination request was filed on 2010/06/30; to access this information from Espacenet, you need to use the "register" link.

Q: Is the examination based on the initially filed claims?

A: No amended claims have been filed on 29.01.2010 (in German, hand written amendments)

Q: Was there already a written opinion sent to applicant?

A: No, see register entry

Q: There are 2 search reports (DE-A1, EP-A1; are there differences between the cited prior art?

A: Yes; EP-A1 includes more citations; DE-A1 has one extra citation not included in EP-A1 (DE 10 2004 045239 A1)

Q: Which prior art is cited by the applicant ?

A: 2 documents, see D label in EP-A1

Q: Where did the applicant cite them ?

A: in paragraph 0003 of the description

Q: Compare EP-A1 and "cited documents" (link in left hand menu) ?

A: "cited documents" does not include all EP-A1 docs; unclear why

Q: Where else do you find information on citations? Compare these data with EP-A1.

A: At the bottom of the register data; they are identical.

Task 3: [EP2138396](#)

Q: Is there a 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 to the register, the application is pending, 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 12/490 as shown on the US-A1 document. All other formats don't work. Substantive examination has not yet been conducted, no search report available.

Task 4: US application 11/093685 in US PAIR

Q: What is the examination status?

A: Patent is granted (US). Can be seen on tab "application data": "patented case"; patent number, grant date

Q: Was there ever a notification of final rejection mailed? What happened then ?

A: Select tab "transaction history"

Q: When was the search report established by the examiner

A: Open tab "display references tab 04-28-2006)

Q: How can you view the full specification of the granted patent?

A: select tab "published documents"; you get the fulltext and PDF; both also include the citations.

Q: Can you find information on the search strategy?

A: yes see Document SRFW in tab "file wrapper"

Q: Is there any family information in US PAIR?

A: Only on domestic family, no foreign filings

Task 5: Search the same application US application 11/093685 by using the CCD; search by typing "11/093685"

Q: How many family options are displayed?

A: Three different ones

Q: How many family members are there. And where was the invention filed for the first time, i.e. which is the OFF?

A: Three; EP,US,WO; OFF is US

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

A: The grant of a patent was refused on 7.02.2011. The applicant has filed an appeal which is still pending.

Q: What procedural events have taken place at the EPO?

Q: Are there any other PCT national phase entries? Please check the Patentscope database.

A:

Task 6: US application 12022866

Q: Search the application in the CCD and US-PAIR; what do you observe for the search reports? Who did the WO search report ?

A: CCD only includes citations for the WO-A3, the report was established by the EPO. US-PAIR includes two further non patent literature (NPL) documents. They cannot be viewed because of copyright issues, only the bibliographic data are available.

Q: View the EP family member in the EP register; is the presentation of citations same as in the CCD ?

A: No the register includes DOI's, links to the publishers.

Q: What is the price for reading the first article in the citations list?

A: 35\$ for 48h; click on DOI link, then select full text html view of article.