

Exercises E (Topic 7) – 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 the online resources permitting access to examination results of other offices for family members, file inspection and examination status data.

Task 1: US application 11/093685 by using the CCD; search by typing "11/093685" or "11093685"

Q: Why do you get three different results?

A: Because the application searches the string "11093685" in any number record of the database. This string also appears eg in the publication number of a JP application. The first entry in the result list is the US application of this exercise.

Q: What does it mean that in the WO search report, the prior art US 6205274 B1 has categories X and Y?

A: The category X (challenging novelty) applies to claim 1-8, 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), 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: The US4021121A and the article of 'Harres'

Q: Compare with the citations of the US family member. Who did the WO search report.

A: The US examiner has cited many more prior art than the EP examiner preparing the WO search report.

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 til the appeal has been settled and to compare the arguments of the EPO and the USPTO, and decide which ones are more convincing, eg because of different prior art.

Task 2: [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 US-A 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 Register.

Q: What else has been changed in the specification?

A: Drawing 8 was removed, and respective narrative.

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 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 available.

Task 4: [WO2005055733](#)

Q: Check the search report. Which claims could perhaps be granted since the examiner has not found prior art ?

A: Claim19; but that is not to be taken serious because there are so many claims and examiners do not search for all claims if there are too many. The examiner would do a subsequent search if the applicnat came with the request that a patent should be granted based on claim19.

Q: Check the preliminary examination report. What does the examiner say about claim 19 ?

A: He denies patentability of any claim but since there is no prior art mentioned for claim 19 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.