

Exercises F (Topic 8) – exercises on claims granted by different jurisdictions

We are going to use following freely accessible databases offering family information, 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:

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 study cases of patents granted by different offices with differing claims.

Task 1: [EP 1702525 B1](#) ("Nargilleh" case of exercise A)

Q: Compare the patents granted by the EPO and the USPTO. Compare them with the originally filed claims of the EP-A1.

A: To compare the granted claims you have to view the PDF version of the publications of the granted patents, i.e. the EP-B1 and the US-B2 (click on "original document"; do not click on "claims" in the left hand espacenet menu since you get then only the claims of the A1 documents). The EP-B1 was granted on 28.10.2009, and the US-B2 was granted on 17.8.2010 (can be seen by looking at the publication dates in the Inpadoc family list). The characterizing part of the respective claims are completely different. In the US-B2 this part of claim 1 includes features that are mentioned in claim 2 of the EP document. Both are also different from the originally filed claims in the EP-A1 document.

Q: What may be the reason? Compare the prior art.

A: The American examiner has cited additional prior art that is not included in the EP citations. To check these citations either see the front page of the EP-B1 and the US-B2, or open the family in the CCD. It is therefore likely that the EP claims are not patentable because of this additional prior art. One of the additional documents most likely describes the feature that is in in the characterizing part of EP-B1.

Q: How do you proceed in case the application was also filed in your office, but on 20.6.2006 without claiming any priority?

A: The application was published for the first time as EP 1702525 A1 on 20.9.2009, i.e. after the filing date in your office. This publication is therefore not considered as prior art. It was only prior art if it was published after the filing date in your office.

Some claims may therefore be most likely be granted. As explained above, it is likely that the EP claims are not patentable because of the additional prior art of the US application. It is recommended to propose to the applicant to base his request on the claims granted by the USPTO.

TASK 2: [WO9707818](#)

Q: How many patents have been granted for the extended family? And how would you proceed ?

A: There are 11 domestic families in the Inpadoc family but only Australia has granted a patent (AU726542B2). That should make you suspicious whether the AU examiner overlooked some prior art. Or else, examination may be still pending at the other IPOs; you need to check this.

Q: What is the examination status at the EPO and the USPTO ?

A: For EPO, select the EP family member and click on the EP Register link. The application is deemed to be withdrawn. There have been numerous communication between the applicant and the examiner (to get a list, click on "all documents")

For US, open US-PAIR and search the application number 09/731878 (you can get this format of the application number from the front page of the US-A1 document). The application has been abandoned.

Q: How would you proceed in such a case if a family member was also filed with your office ?

A: Check the prior art that was cited by the EPO and the USPTO and compare with prior art of the AU examiner. Most likely the AU examiner overlooked something. So it would not be advisable to grant a patent based on the AU claims. To get a proper picture you would need to read the examination reports of the EP and the US examiner to see their arguments.