



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
- Nov 2012: National WS with DIP (Thailand), NOIP (Viet Nam)
- Jan 2013: Sub-regional French speaking African IPOs
- Aug 2014: National WS with IPOPHL (Philippines)

Other funding:

- Mar and Aug 2012: Module for newly recruited examiners of IP India
- Dec 2013: Sub-regional Arab IPOs

Agenda

Outline of the workshop

- Challenges of small and medium IPOs
- Options for **substantive** examination:
 - Stand alone examination
 - **Passive worksharing**
 - Active worksharing
- Legislative foundations

IPO's challenges in many IP-DCs

- IP-DC: Country developing its IP infrastructure
- Establish efficient patent prosecution procedures (national phases) 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
- limitations of domestic IP culture (e.g. experienced patent lawyers, drafting skills of local applicants, ...)
- **despite similar patentability and quality requirements**
- **facing a lack of awareness/support by higher government authorities**

Substantive examination in small IPOs?

- Can small IPOs deliver quality substantive examination?
 - What is a sufficient size, i.e. number of examiners?
 - What access to database resources is needed?
 - What skills are needed?
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- I think: Yes, even small IPOs with limited resources can deliver quality patents if they have a proper strategy for the exploitation of external examination results for members of the patent family (passive worksharing)

"National phases" in general

Categories of patent applications to be examined

- **PCT national phase entries**

- application is member of **patent family**

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

- priority claimed: is member of (Paris Convention) **patent family**
- priority not claimed: is member of "**technical**" family because same invention

- **Truly national/domestic first filing**

- second filing abroad is possible, i.e. application may become member of **patent family**

Patent family > application is processed at several IPOs

> **Topic 3: patent families**

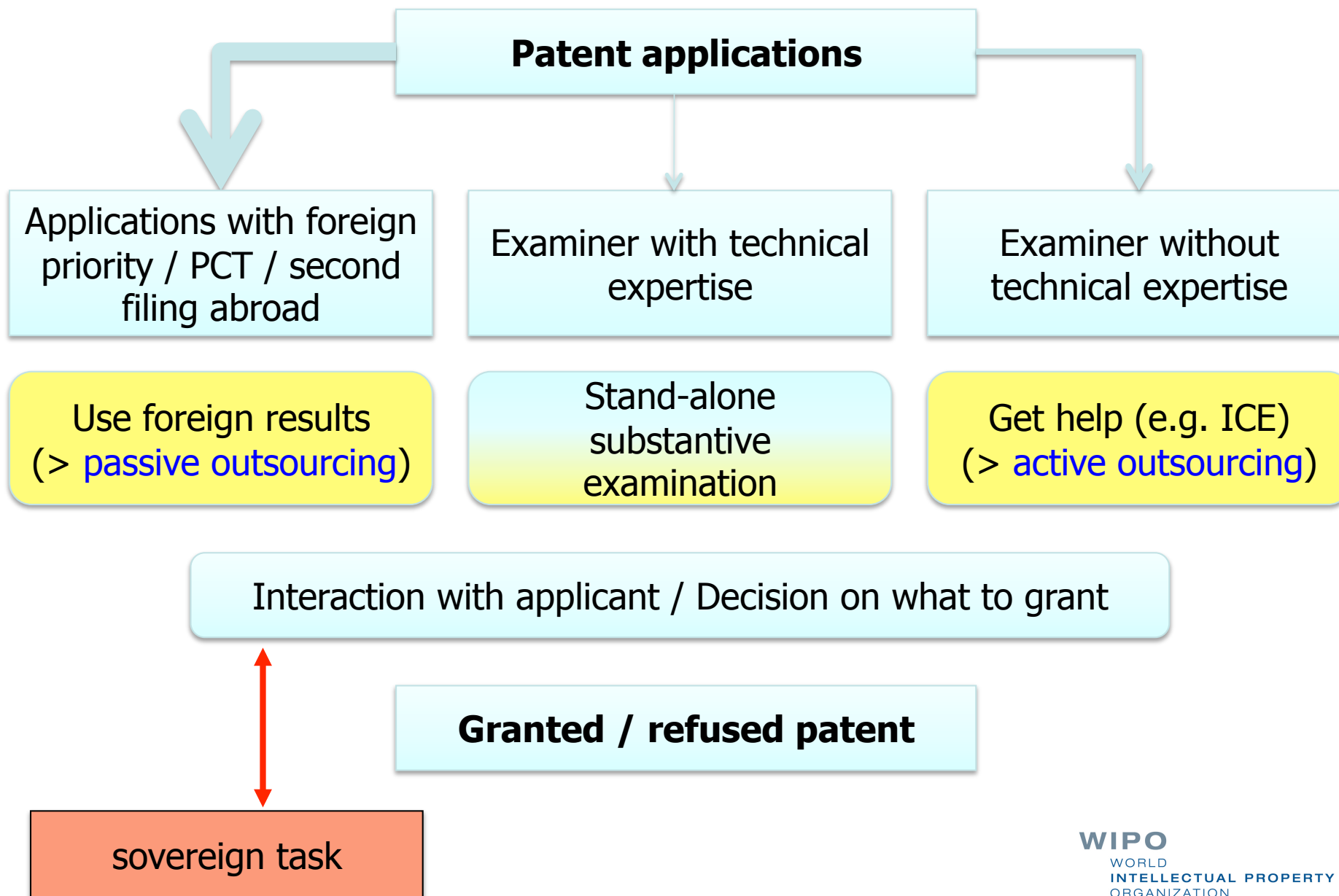
Opportunities through patent families

- Utilisation of external examination results is possible if same or similar invention was filed in several IPOs
 - OFF: Office of First Filing
 - OSFs: Office(s) of Second Filing
 - Simple family (usually same invention, ie most likely similar claims)
 - Extended family (at least similar invention, claims may differ)
 - Technical family
- **Active worksharing**: avoid **duplication of work** by active organisation of the work distribution; e.g. OFF treats applications with priority and OSFs wait for results
 - Some collaborations started, e.g. Vancouver Group (AU, CA, UK)
 - ASPAC?
- **„Passive worksharing“**: Use results that were obtained for family members at other IPOs

Passive worksharing (PW)

- PW is a very effective strategy for small IPOs to cover all technical areas
- PW can also also enhance efficiency and quality at any IPO
- Currently many IPOs examine in parallel, i.e. little active worksharing
- Utilization of examination results obtained by other IPOs provides general **benefits** and may improve patent quality at **any IPO**, because:
 - Other IPOs may have access to other information resources
 - Individual examiners at other IPO may have particular expertise in a certain field
 - Learning from/improving other search strategies
 - Examination reports may include valuable arguments/particular views
- There are also benefits derived from duplicated work

> This workshop



Patent prosecution – summary of options

Option 1

- ▶ Doing full substantive examination in **all** or **some** areas of technology

Option 2

- ▶ Use **grants/rejections** of other IPOs

> Topic 8, 9: claims

- requires identical claims & cooperative applicants

- requires claims compatible with national law

- implies considerable delay because final results have to become available

Option 3

- ▶ Use only **pre-grant results**, e.g. search reports, of other IPOs, e.g. via ICE, ASPEC, AIPN, KPION..

- implies some but smaller delay than option 3

> Topic 5, 6, 7

Example: Cambodia patent law

Section 39

Article 31.-

The applicant shall, at the request of the Registrar, furnish him with the following documents relating to one or more of the foreign applications referred to in Article 30 of this Law:

- (i) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;
- (ii) a copy of the patent granted on the basis of the foreign application;
- (iii) a copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application.

The applicant shall, at the request of the Registrar, furnish him with a copy of any final decision invalidating the patent granted on the basis of the foreign application referred to in the 1st paragraph of this Article.

Section 39

- The applicant shall, at the request of the Director, furnish him with the **date and number of any application for a patent filed by him abroad**, hereafter referred to as the "foreign application," **relating to the same or essentially the same invention** as that claimed in the application filed with the Office and **other documents** relating to the foreign application.

Example: Cambodia patent law

Article 37.-

The Registrar shall take into account, for the purposes of Article 36 of this Law, as following:

- (i) the results of any international search report and any international preliminary examination report established under the PCT in relation to the application; and/or
- (ii) a search and examination report submitted under item (i) of the 1st paragraph of Article 31 of this Law relating to, or a final decision submitted under item (iii) of the 1st paragraph of Article 31 of this Law on the refusal to grant a patent on, a corresponding foreign application; and/or
- (iii) a search and examination report which was carried out upon his request by an external search and examination authority.

Sovereign national prosecution

Paris Convention 1883:

- **No** obligation to follow/adopt conclusions of other IPOs or to use their results (Article 4bis)
- http://www.wipo.int/treaties/en/ip/paris/summary_paris.html
- Each IPO has obligation to observe national legislation
- Each PCT national phase examination is independent of other national phases
- Each IPO has responsibility/liability for quality patents
- Lawyers often refer to grants at other IPOs: just ignore that!

Legal basis of substantive examination

- ▶ Patent law/act (issued by parliament, i.e. legislative body)
 - [Republic Act No 8293](#)
- ▶ Patent rules/regulations/ordinances (issued by minister, commissioner/..., i.e. administrative body)
 - Revised Implementing Rules and Regulations ([IRR](#))
- ▶ 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>

[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)

▶ PCT Examination Guidelines

<http://www.wipo.int/export/sites/www/pct/en/texts/pdf/ispe.pdf>

▶ German Guidelines (in English)

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/PatentOfficeProcedure/PatentOfficeProcedure_2009.pdf

▶ USPTO Guidelines

<http://www.uspto.gov/web/offices/pac/mpep/documents/2100.htm>

Requirements of patentability

Substantive patent examination has to check

- Novelty
 - Inventive step
 - Industrial applicability
 - Unity
 - Technical nature
 - No case of **exclusion**
 - Sufficient disclosure
 - Legal certainty of claims (clarity)
 - Additions to initial disclosure
 - Deposit of novel microorganisms
 - (Disclosure of origin of genetic resources)
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- | | |
|---|----------------------------|
| Novelty, Inventive step, Industrial applicability | Section 21 |
| Unity | Section 38 |
| Technical nature | Section 21 |
| No case of exclusion | Section 22 |
| Sufficient disclosure | Section 35.1, Rule 406 |
| Legal certainty of claims (clarity) | Section 36.1, Rule 415b(b) |
| Additions to initial disclosure | Section 49 |
| Deposit of novel microorganisms | Rule 409 |
| (Disclosure of origin of genetic resources) | |

Differences of national patent legislations

- Basic categories of requirements are the same in most jurisdictions (unity, novelty, inventive step, technical nature, sufficient disclosure)
- Some differences exist in how the term "invention" or "patentable invention" is defined (positively, negatively)
- Differences, however exist mostly in terms of exclusions, e.g.
 - US do grant business methods, software patents,..
 - DE/EP grants new use of known compound, PK does not,..
 - Islamic countries exclude, e.g., inventions related to pork
 - Temporary exclusions in Myanmar: Section 8 (b)
- For analysis, see e.g. SCP studies on WIPO website:

http://www.wipo.int/edocs/mdocs/scp/en/scp_13/scp_13_3.pdf

Workshop objectives

- Understanding concepts of patent families
- Identification of foreign family members of pending national application and their examination status
 - Which databases include family information and examination status?
- Retrieval of (intermediary or final) results of examination of family members at other IPOs
 - Which types of results can be found in which databases?
- Utilization of results in national context
 - Are the external results compatible with the national practice?
- Enhancing efficiency of substantive examination while observing national sovereignty

Thank you

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