

#### **Exercises Topic 4 – Priorities and relevant prior art**

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

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

**CCD:** [ccd.fiveipooffices.org/CCD-2.0.4/](http://ccd.fiveipooffices.org/CCD-2.0.4/)

The objective of these exercises is to familiarize ourselves with priorities, relevant prior art, and study some claims.

**Task 1:** [WO2011074782](http://www.patent.gov.tw/tw/article/view/1074782) in Espacenet (continuation from Task 1 of Topic 3 exercises)

Q: Fig. 5 of the EP application comes from which of the two KR priorities? Which priority date would be applicable for determining the relevant prior art related to technical features disclosed in relation to this figure? This is a tricky task! How do you check the disclosure of a priority and how do you find this disclosure?

A: You have to check the certified copies of the priority documents. The older priority KR..898 (please note, this is a priority number, not a publication number!) was never published as such. However, a certified copy is available, e.g., through file inspection of [EP-Register](#) or Patentscope. When you view the later applications claiming the priority of this older application you will never be able to distinguish the original disclosure of KR..898 from later additions.

Figure 5 is only disclosed in the later priority KR..035 and the priority date related to this priority application is 28.10.2010 which is 10 month after the other priority date of 16.12.2009 of KR..898.

Q: Is this figure also included in both KR publications in the extended family?

A: Both KR publications in the family show this figure, i.e. both applications include additions of subject matter in comparison to the first priority they claim. Although KR20130129336 claims only this priority (KR..898) it includes additions. The original disclosure of KR..898 is only accessible through the certified copy submitted to the EP and WO applications.

**Task 2:** Search [WO20130104074](http://www.patent.gov.tw/tw/article/view/130104074)

Q: Compare the drawings of the WO and CA family members (all have the same priority). Which drawings in the WO are additions of art not disclosed in the priority?

A: Fig. 1, 2 are different, Fig. 5 is totally new.

**Task 3:** Search [WO2013066270](http://www.patent.gov.tw/tw/article/view/13066270)

Q: Compare the drawings of the WO with the two SG priorities.

A: Many drawings are not even disclosed in the two priorities. The older SG priority has only one circuit lay-out.

Q: Where the time lines for claiming the two priorities observed?

A: Yes

**Task 4:** Search the family of [WO2006138751](http://www.patent.gov.tw/tw/article/view/2006138751) (an example from topic 3 exercises)

Q: How many family members are there in the extended family? What is the common priority and from when is it? Have any patents been granted?

A: There are 4 different domestic families (AU, WO, US, ZA). Each domestic family has a single member; the simple and extended families are identical. They all claim a ZA priority with priority date 23.6.2005. No patent has been granted.

Q: The ZA family member was published in 2009. When was it filed? What date would have to be applied for determining the relevant prior art if the PCT examination Guidelines were applied?

A: The ZA family was filed on 21.1.2008 and published approximately 15 months later on 24.6.2009. It claims the priority of an earlier domestic filing on 23.6.2005. According to PCT examination Guidelines, the priority date is applied for determining the relevant prior art only, if the later application claiming the priority was filed within 12 months from the priority date. That is not the case here! So, the date for determining the prior art would be the filing date which is 21.1.2008. Since a family member disclosing the invention was already published on 28.6.2006, a patent could most likely not have been granted because of a lack of novelty.

**Task 5:** Revisit the examples on slides 34 and 36 of the Topic 4 presentation, and try to determine the dates relevant for the prior art.

A: Slide 34 situation:

- i) the application claims priority 1 and 2: only priority 2 is validly claimed within the 12 months period; the respective priority date determines the prior art if claimed subject matter is fully disclosed in this priority document; for all claimed subject matter that is not fully disclosed therein, the application date determines the prior art.
- ii) the application claims priority 2 which claims priority 1: priority 2 is validly claimed within the 12 months period; for examination of the application, it doesn't matter that priority 2 has claimed priority 1, i.e. priority date 1 is irrelevant for examination of the application. Like in i), the respective priority date 2 determines the prior art if claimed subject matter is fully disclosed in this priority 2; for all claimed subject matter that is not fully disclosed therein, the application date determines the prior art.

Slide 36 situation:

- i) the application claims priority 1 and 2: both priorities are validly claimed within the 12 months period; the priority dates determine the prior art, provided the claimed subject matter is fully disclosed in the respective priority document.
- ii) the application claims priority 2 which claims priority 1: priority 2 is validly claimed within the 12 months period and determines the relevant prior art for claimed subject matter fully disclosed in priority 2. Priority date 1 is irrelevant for examination of the application.

**Task 6:** Search [US100000](#) and [WO2013083968](#)

Q: Would the claims of the US and claims 15 and 16 of the WO be acceptable nowadays?

A: No, they refer to features in the drawings without defining these features in the claim by using language. The scope of protection defined by the claims is not clear, i.e. open to interpretation (which features from the drawings?).

**Task 7:** [WO2010107294](#)

Q: Check the wording of claim 2 and claim 12.

A: Claim 2 is independent and is not presenting the solution but stating the problem, namely that the microorganism produces an antifungal compound. Most likely it was overlooked to relate it to claim 1.

Claim 12 covers a composition but refers to other claims of different categories, e.g. the methods of claims 8 to 11.

**Task 8:** [WO2013141722](#)

Q: Read the main claim; is the wording acceptable?

A: The last three features i, ii, iii are not really features describing solutions. They rather describe expected positive effect and not by which technical means these effects are achieved.

**Taks 9:** Deconstruct claim 1 of [WO2006138751](#) into distinct features. The claim has this wording:

*1. An electrical driven washing apparatus which includes a set of wheels, a cabinet fixed to the set of wheels, two tanks, one for clean water and one for dirty water, a water inlet to the clean water tank, an electric pump housed in the clean water tank, an electrical connection via an inverter to a battery or to an external source of power, a solar panel to charge the battery, an outlet from the clean water tank to a spray gun, a wax stick which contains cleaning chemicals and wax placed in the spray gun for soapy water, an inlet for the dirty water tank for dumping dirty water into the tank and an outlet for dumping dirty water into external drains.*

Q: How many are there?

A: 14 features, they are numbered below in brackets (the numbers are not meant as reference numerals referring to drawings!):

*1. An electrical driven washing apparatus which includes  
a set of wheels (1),  
a cabinet fixed to the set of wheels (2),  
two tanks, one for clean water (3) and one for dirty water (4),  
a water inlet (5) to the clean water tank,  
an electric pump (6) housed in the clean water tank,  
an electrical connection (7) via an inverter (8) to a battery or to an external source of power,  
a solar panel (9) to charge the battery,  
an outlet (10) from the clean water tank to  
a spray gun (11),  
a wax stick (12) which contains cleaning chemicals and wax placed in the spray gun for soapy water,  
an inlet (13) for the dirty water tank for dumping dirty water into the tank and  
an outlet (14) for dumping dirty water into external drains.*