

Topic 5: Retrieving and Utilizing External Examination Results – Types of Results

Lutz Mailänder
Head, Patent Information Section
Global IP Infrastructure Sector

Manila
6 August 2014

Agenda

- Opportunities
- Types of results
 - Intermediary
 - PCT
 - final
- Overview of public resources for retrieval
- Issues

Opportunities through patent families

- If same or similar invention was **filed in several IPOs**
 - e.g. a PCT application entered several national phases, the results of substantive examination for these members of the patent family may be utilized
- Types of families
 - Simple family (**usually same invention**, most likely similar claims)
 - Extended family (at least similar invention, claims may differ)
 - Technical family
- Need for **databases** providing
 - Family information
 - National examination status, to check if examination is pending
 - National file inspection, to access examination reports, rejections

Types of examination results

- Intermediary or **pre-grant** results
 - Search reports (basic; enriched, e.g. including search strategies)
 - List of citations
 - Written opinions, examination reports
 - Communications between applicant and examiner
 - Third party observations
- **Final** results
 - Granted claims; claims after opposition
 - Rejections; withdrawals following substantive reports
- **Post-grant** results
 - Additional prior art from opposition/re-examination
 - Amended claims
 - Communications between involved parties (3+)

Overview of different terminology

- Search reports (basic; enriched)
 - USPTO: "List of references cited by examiner", "List of references cited by applicant and considered by examiner"
 - JPO: "Search Report by Registered Searching Organization"
 - EPO: "European Search Report"
- Written opinions, examination reports
 - PCT: "Written opinions" = examiner statements before IPRP issuance (sent to applicant)
 - IPRP = Written opinion sent to designated/elected offices at the end of the international phase
 - EPO: "European search opinion", "Communication from the examining division" (subsequent written opinions during examination)
 - USPTO: "non-final rejections", "final rejections"
 - JPO: "Notification of Reasons for Refusal"

Main products of PCT international phase

- **Publication of international application** (bibliographic data, abstract, description, drawings, claims)
- **International search report (ISR)**
- **Written opinion of ISA (WO-ISA)**
 - prepared as part of international search, but deals in substance with examination matters
- (Where applicable) supplementary international search report (SISR)
- (Optional) informal comments by applicant on WO-ISA
- **International preliminary report on patentability (IPRP)**
 - IPRP (Chapter I) = WO-ISA plus cover sheet
 - IPRP (Chapter II) = international preliminary examination report (IPER)

International publications

- 18 month after filing/priority date: **WO-A1** or **WO-A2**
- **WO-A1**: international application + international search report
- **WO-A2**: international application only if ISR not yet available
 - Front page, description, drawings, claims
 - Declaration that no ISR will be established (Article 17(2)(a))
- **WO-A3**: Later publication international search report + front page
- **WO-A4**: Later publication of amended claims and/or statement (Article 19)
- **WO-A8**: Republication front page with corrections
- **WO-A9**: Republication of full application or ISR with corrections, alterations or supplements

ISR

- Established by (selected) competent ISA
- **Search based on claims as originally filed (Article 15)**
- Search performed according to PCT examination Guidelines
- Prior art is everything made available to the public (Rule 33)
 - in written disclosure (may refer to oral disclosure, exhibition)
 - **prior to the international filing date** (ie priority is irrelevant, in case priority claims is invalid for certain subject matter)
- Not any written disclosure is to be searched: only PCT minimum documentation (Rule 34)
- In case of lack of unity, only "first" invention will be searched (Rule 40), unless additional fees are paid
- ISA can decline search of certain subject matter (Rule 39), namely subject matter that is often excluded from patentability in national laws (PCT does not define what is patentable!)

ISR

- ISR is "**enriched**" **search report** as it includes
 - List of relevant prior art documents (citations): plus indications:
 - For which claims a document is relevant
 - Which parts of the document are relevant (eg. Line 5-6, page 7; drawing 6) for those claims
 - Why the document is relevant (challenging novelty, inventive step; describing background art)
 - IPCs of the claimed subject matter
 - Limited search strategy: technology areas (IPC) searched
- Includes observations regarding lack of unity, or whether no meaningful search could be performed (clarity of claims)

Enriched prior art search reports



EUROPEAN SEARCH REPORT

Application Number
EP 09 16 8955

Application number

DOCUMENTS CONSIDERED TO BE RELEVANT			
Category	Citation of document with indication, where appropriate, of relevant passages	Relevant to claim	CLASSIFICATION OF THE APPLICATION (IPC)
X	EP 0 813 338 A2 (ROCKWELL INTERNATIONAL CORP [US]) 17 December 1997 (1997-12-17) * column 6, line 12 - column 8, line 26 * * column 8, line 52 - column 9, line 4; figure 1 *	1-13	INV. G01T1/17
Y	US 6 128 039 A (CHEN DATONG [US] ET AL) 3 October 2000 (2000-10-03) * column 3, line 57 - column 4, line 28; figure 2 *	1,3-7	
Y	US 6 163 029 A (YAMADA SHINICHI [JP] ET AL) 19 December 2000 (2000-12-19) * column 15, line 30 - column 16, line 45; figures 2,15,16 *	1,3-7	
A	FR 2 864 628 A1 (COMMISSARIAT ENERGIE ATOMIQUE [FR]) 1 July 2005 (2005-07-01) * page 4, line 18 - page 6, line 15; figure 3 *	1-13	
A,D	WO 2004/064168 A1 (SCHERRER INST PAUL [CH]; BROENNIMANN CHRISTIAN [CH]; SCHMITT BERND [CH]) 29 July 2004 (2004-07-29) * the whole document *	1-13	TECHNICAL FIELDS SEARCHED (IPC) G01T
E	WO 2009/131151 A1 (HAMAMATSU PHOTONICS KK [JP]; MORI HARUMICHI [JP]; KYUSHIMA RYUJI [JP];) 29 October 2009 (2009-10-29) * figure 12 *	1	
The present search report has been drawn up for all claims			
Place of search The Hague		Date of completion of the search 23 March 2010	Examiner Wulveryck, J
<p>CATEGORY OF CITED DOCUMENTS</p> <p>X : particularly relevant if taken alone Y : particularly relevant if combined with another document of the same category A : technological background O : non-written disclosure P : intermediate document</p> <p>T : theory or principle underlying the invention E : earlier patent document, but published on, or after the filing date D : document cited in the application L : document cited for other reasons & : member of the same patent family, corresponding document</p>			

International Patent Classification

Category X, Y, A, etc.

Relevant to Claim ...

Cited documents

Technical Fields Searched

Searching Authority

Date of Completion of the Search

Examiner

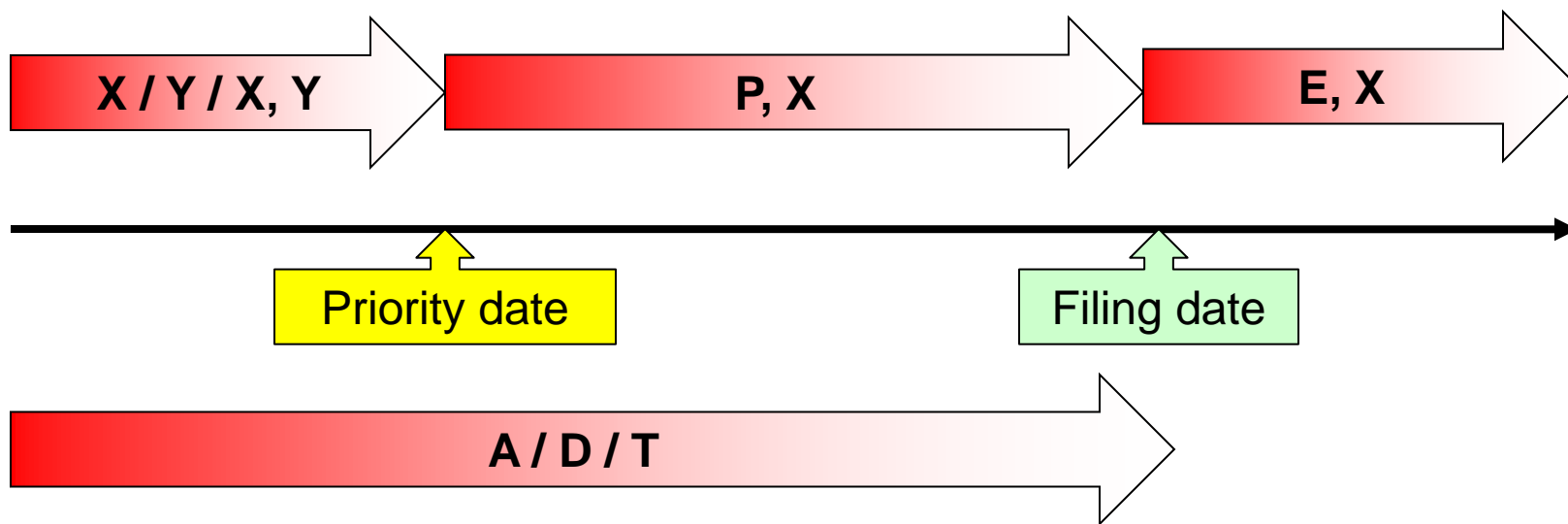
Categories of citations

- X particularly relevant if taken alone (novelty) Rule 204 (a)
- Y particularly relevant if combined with another document of the same category (inventive step)
- A technological background
- O non written disclosure
- P intermediate document, i.e. published between the earliest priority date and the filing date Rule 204 (c)
- T theory or principle underlying the invention
- E earlier document but published on or after the filing date Rule 204 (d)
- D document cited in the application

See 16.59ff of the PCT Examination Guidelines

Prior art categories

Publication dates of prior art documents



Summary: prior art

Regular patent document publications:

- Publications of search reports (EP-A1/A3, WO-A1/A3)
- Front pages of publications of granted patents, republications after opposition (EP-B1/B2..)

Other access options per application


- Search reports accessible through file inspection (US-Pair, AIPN, KPION...)
- Prior art citations lists in registers (e.g DE or EP Register)
- Lists of forward and backward citations in patent databases, e.g. Espacenet, commercial providers,...


Other access options per family:

- CCD
- Forward citations: only Espacenet (per document, not per family)

Citations only, e.g. EP-B1

Patent literature


 Europäisches Patentamt
 European Patent Office
 Office européen des brevets


 Publication number: **0 282 251 B1**

EUROPEAN PATENT SPECIFICATION

Date of publication of patent specification: 17.03.83 Int. Cl. G01N 8/00, G01N 11/16
 Application number: 8801957.2
 Date of filing: 07.03.88





Priority: 11.03.87 GB 8705757
 Date of publication of application: 14.05.88 Bulletin 88/27
 Publication of the grant of the patent: 17.03.83 Bulletin 83/27
 Designated Contracting States: AT BE CH DE FR IT LI NL SE
 References cited: GB-A-2 131 952

Proprietor: SCHLUMBERGER INDUSTRIES LIMITED
 124 Victoria Road
 Farnborough Hampshire, GU14 7PW (GB)
 Inventor: Radkin, Mark Jonathan
 10 Deigh Road
 Windesore (Sussex) (GB)
 Inventor: Atkinson, David Ian Heaton
 4 Dottle Drive
 Farnham Surrey (GB)
 Representative: Stooles, Brian David et al
 Schlumberger Electronics (U.K.) Limited 124
 Victoria Road
 Farnborough Hampshire GU14 7PW (GB)

THE MARCONI REVIEW, vol. XLIII, no. 218, 1980, pages 156-175, Rugby, GB; R.M. LANGDON: "Vibratory process control transducers"
 IEEE TRANSACTIONS ON INSTRUMENTATION AND MEASUREMENT, vol. IM-32, no. 3, September 1983, pages 434-437, IEEE, New York, US; E. STEMME et al.: "Measuring liquid density with a tuning-fork transducer"
 I.S.A. TRANSACTIONS, vol. 20, no. 3, 1981, pages 67-75, Research Triangle Park, NC, US; B.W. BALLS: "A new on-line density meter for viscous liquids and slurries"

Note: Within nine months from the publication of the mention of the grant of the European patent, any person may give notice to the European Patent Office of opposition to the European patent granted. Notice of opposition shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the opposition fee has been paid (Art. 99(1) European patent convention).

EP 0 282 251 B1

EP 0 282 251 B1
 (B6) References cited:
GB-A- 2 131 952
 THE MARCONI REVIEW, vol. XLIII, no. 218, 1980, pages 156-175, Rugby, GB; R.M. LANGDON: "Vibratory process control transducers"
 IEEE TRANSACTIONS ON INSTRUMENTATION AND MEASUREMENT, vol. IM-32, no. 3, September 1983, pages 434-437, IEEE, New York, US; E. STEMME et al.: "Measuring liquid density with a tuning-fork transducer"
 I.S.A. TRANSACTIONS, vol. 20, no. 3, 1981, pages 67-75, Research Triangle Park, NC, US; B.W. BALLS: "A new on-line density meter for viscous liquids and slurries"

Farnham Surrey (GB)
 (74) Representative: Stooles, Brian David et al
 Schlumberger Electronics (U.K.) Limited 124
 Victoria Road
 Farnborough Hampshire GU14 7PW (GB)

Non patent literature

Note: Within nine months from the publication of the mention of the grant of the European patent, any person may give notice to the European Patent Office of opposition to the European patent granted. Notice of opposition shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the opposition fee has been paid (Art. 99(1) European patent convention).

Sort by Sort order Sort show citations

<input type="checkbox"/> 1. SYSTEM AND METHOD FOR BILATERAL COMMUNICATION BETWEEN A USER AND A SYSTEM						
★	Inventor: LUCENTE MARK [US] POLISH NATHANIEL [US]	Applicant: SOLQUE SOFTWARE LTD LIABILITY [US]	CPC: G10L15/22	Citations:	Publication info: AT422089 (T) 2009-02-15	Priority date: 1999-02-04
<input type="checkbox"/> 2. System and method for bilateral communication between a user and a system						
★	Inventor: LUCENTE MARK POLISH NATHANIEL	Applicant: SOLILOQUY INC	CPC: G10L15/22	Citations:	Publication info: AU3589600 (A) 2000-08-25	Priority date: 1999-02-04
<input type="checkbox"/> 3. SYSTEM AND METHOD FOR BILATERAL COMMUNICATION BETWEEN A USER AND A SYSTEM						
★	Inventor: POLISH NATHANIEL [US] LUCENTE MARK [US]	Applicant: SOLILOQUY INC [US]	CPC: G10L15/22	Citations:	Publication info: CA2361429 (A1) 2000-08-10	Priority date: 1999-02-04
<input type="checkbox"/> 4. SYSTEM AND METHOD FOR BILATERAL COMMUNICATION BETWEEN A USER AND A SYSTEM						
★	Inventor: LUCENTE MARK [US] POLISH NATHANIEL [US]	Applicant: SOLILOQUY INC [US]	CPC: G10L15/22	Citations: XP004117212	Publication info: EP1163665 (A1) 2001-12-19 EP1163665 (A4) 2005-09-14 EP1163665 (B1) 2009-01-28	Priority date: 1999-02-04
<input type="checkbox"/> 5. System and method for bilateral communication between a user and a system						
★	Inventor: LUCENTE MARK [US] POLISH NATHANIEL [US]	Applicant: SOLQUE SOFTWARE LTD LIABILITY [US]	CPC: G10L15/22	Citations: WO9821679 A1 XP004117212	Publication info: EP2085963 (A1) 2009-08-05	Priority date: 1999-02-04
<input type="checkbox"/> 6. SYSTEM AND METHOD FOR BILATERAL COMMUNICATION BETWEEN A USER AND A SYSTEM						
★	Inventor:	Applicant:	CPC: G10L15/22	Citations:	Publication info: JP2002536755 (A) 2002-10-29	Priority date: 1999-02-04
<input type="checkbox"/> 7. Bilateral speech system						
★	Inventor: POLISH NATHANIEL [US]	Applicant: SOLILOQUY INC [US]	CPC: G10L15/22	Citations: US4445187 A US5197005 A US5265065 A US5369575 A US5418948 A (+19)	Publication info: US6430531 (B1) 2002-08-06	Priority date: 1999-02-04

Summary: Access to written opinions, etc

- File inspection gives access to all communications between applicant and office/examiner, in particular
 - E.g. **examination reports/written opinions** which are not published like search reports
 - Final **rejection rulings**
 - **Grant decisions**
 - Amended claims
- Possible usually through registers; e.g., at Patentscope, EP-Register, US-PAIR, AIPN, DPMA Register (soon)
 - Provide also up-to-date legal status information, i.e. whether
 - Application/examination is pending
 - Patent is in force, lapsed, ...
- For general information see WIPO register portal (see browse tab of Patentscope) or at: <http://www.wipo.int/branddb/portal/portal.jsp>

WIPO patent register portal



The screenshot shows a web browser window with the address bar displaying `patentscope.wipo.int/search/en/search.jsf`. The page header includes the WIPO logo and the text "PATENTSCOPE Search International and National Patent Collections". A navigation menu contains "Search", "Browse", "Translate", "Options", "News", "Login", and "Help". The "Browse" menu is open, showing options: "Browse by Week (PCT)", "Sequence listing", "IPC Green Inventory", and "Portal to patent registers" (highlighted in yellow). Below the menu, there is a search box with "Front Page" selected and a "Search" button. A notification at the bottom states "National patent collection of Canada now available".

<http://www.wipo.int/branddb/portal/portal.jsp>

Saudi Arabia

also part of [Patent Office of the Cooperation Council for the Arab States of the Gulf \(GCC\)](#)

Online National Register

Y

English Interface

Y

Inventor Search

Y

PCT Search

N

PCT National Phase Entry

N

Fee Payment

N

Most Recent Legal Status

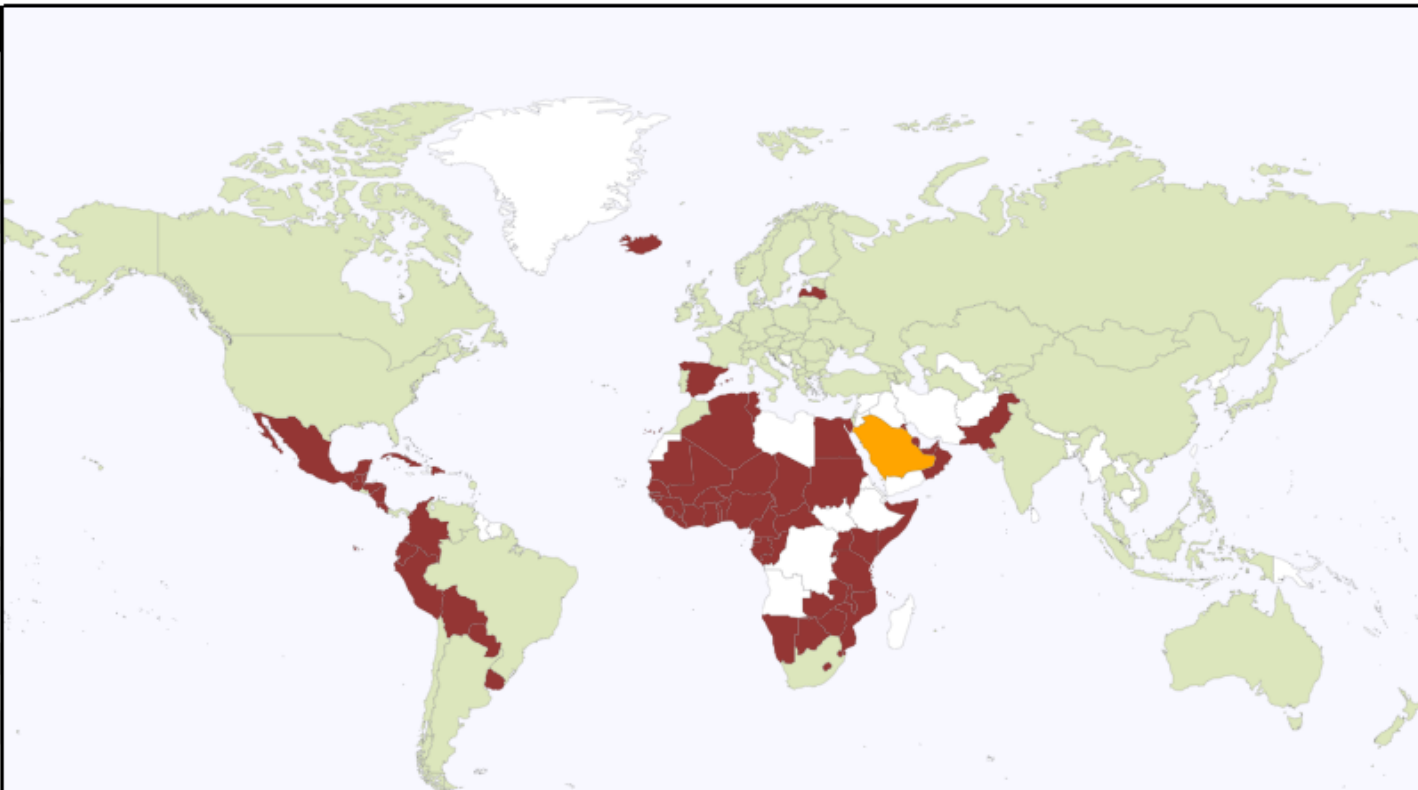
Y E.g. 'Lapsed' for application number 1210694

File Inspection

N

Full Publications

Y Documents are available in random manner, e.g. for application number 5260065: Open the link behind the title and select whether you want to see the publication of the application or the



+

-

Jurisdiction	Online National Register	English Interface	Inventor Search	PCT Search	PCT National Phase Entry	Fee Payment	Most Recent Legal Status	File Inspection	Full Publications	Online Gazette
African Intellectual Property Organization (OAPI)	N	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N	N
African Regional Intellectual Property Organization (ARIPO)	N*	N/A	N/A	N/A	N/A	N/A	N/A	N/A	N	N

Selected online resources

- European Patent Register (EP)
 - <https://register.epo.org/espacenet/regviewer>
- Common Citation Document (Pilot)
 - <http://www.trilateral.net/ccd>
- Patentscope
 - <http://www.wipo.int/patentscope/search/en/search.jsf>
- Public Pair (US)
 - <http://portal.uspto.gov/external/portal/pair>
- AIPN (JP)
 - <http://aipn.ipdl.inpit.go.jp/>
- K-PION (KR)
 - <http://kposd.kipo.go.kr:8088/up/kpion/>
- DPMAregister (DE)
 - <http://register.dpma.de/DPMAregister/Uebersicht?lang=en>

Online resources

- European Patent Register (EP)
 - EP applications: enriched SR, ER, examination status, file wrapper)
- Common Citation Document
 - SRs for EP, JP, US, WO,.....
- Patentscope
 - WO applications: enriched SR, ER, file wrapper
- Public PAIR (US)
 - US applications: file wrapper with SR, ER, examination status
- AIPN (JP)
 - See topic 6 presented by JPO
- K-PION (KR)
 - See topic 6 presented by JPO
- DPMAregister (DE)
 - DE applications: SR, examination status (file wrapper from Q3/2013)

Issues with final results

Utilization of final results (grants/refusals)

- Requires identical/similar invention (simple family)
 - E.g. if original claims are similar

For grants:

- Requires cooperative lawyers/applicants that agree to use/submit the claims granted abroad
- Requires those claims to be compatible with national law, e.g. exclusions
- Requires confidence in the work of other IPOs
- Results from different IPOs may be different (see exercises)
- Implies considerable delay because final results have to become available

Issues with final results

Utilization of final results (grants/refusals)

- Requires identical/similar invention (simple family)
 - E.g. if original claims are similar

For rejections:

- Requires access to file wrapper (file inspection) to see rejection ruling
- Rejection ruling only applicable if claims to be rejected are similar

Issues with intermediary results

- Implies some but smaller delay than waiting for final results
- Searches are based on claims: the foreign search results may be incomplete/inappropriate if claims are different
- Requires checking whether same priorities
- Different priorities and priority dates can lead to different claims or prior art
- Usually no problems if simple family
- Using results for members of extended family which are not in same simple family may be problematic (compare claims !)

Planning of utilization

- ▶ Utilization of examination results requires knowledge of
 - Family information, i.e. where else has an invention been filed (Paris, PCT, technical family)
 - Examination practice of other IPOs, i.e. do they have deferred examination (e.g. DE), is prior art search mandatory (e.g. EP, PCT) ?
 - Examination status, i.e. is substantive examination under way (i.e. national phase entry for PCT applications); requires publicly accessible patent register
- ▶ Depending on your national requirements, e.g. deadline for first action by examiner

Retrieval options

- Request applicant to submit information; some legislations provide for a respective obligation
- Can you trust the applicant? Would he submit a rejection ?
- Active retrieval/checking by examiner, i.e.
 - **Research family information** and
 - **Check examination status** and
 - **Retrieve results** from online resources

Retrieval options

- Active retrieval by examiner, i.e. **research family information** and **research examination status** and **retrieve results** from online resources
- Request applicant to submit information; some legislations provide for a respective obligation

Article 124 EPC

(1) The European Patent Office may, in accordance with the Implementing Regulations, **invite the applicant to provide information on prior art taken into consideration in national or regional patent proceedings** and concerning an invention to which the European patent application relates.

(2) **If the applicant fails to reply deemed to be withdrawn.**

Checklist for using external examination products

- Active retrieval by examiner, i.e.
 - **Research family information** and
 - Check examination status and
 - **Retrieve results** from online resources
- Request applicant to submit information
- Carefully check whether results are applicable:
 - Same or similar claims (claim correspondance table) ?
 - Compatible with your exclusions from patentability,...?
 - Is priority valid?
 - New search needed, eg if claims were not searched by ISA?
 - Can you wait for results from other IPOs ?
 - Are the results of other IPOs consistent ?

REMINDER: National sovereignty

Paris Convention:

- **No** obligation to use results of others, or to follow their conclusions
- IPO has obligation to observe national legislation
- IPO has responsibility/liability for quality patents

Thank you

lutz.mailander@wipo.int