

Exercises Topic 6A – exercises on file inspection in PATENTSCOPE and US Public Pair

We are going to use following freely accessible databases offering file inspection and examination status:

WIPO PATENTSCOPE (no explicit family information but information on selected PCT national phase entries, some of them being linked to the respective national registers):

<http://www.wipo.int/patentscope/search/en/search.jsf>

US-PAIR (only information on US national families, e.g. continuations):

<http://portal.uspto.gov/external/portal/pair>

The objective of these exercises is to explore file inspection opportunities of PATENTSCOPE and US Public Pair.

The answers reflect the prosecution status as of July 31, 2014.

Task 1: Search US application 11/093685 in US PAIR

Q: What is the examination status?

A: Patent is granted in US. Can be seen on tab "application data": status is 'patented case'; patent number, issue date are indicated.

Q: When was the search report established by the examiner?

A: Open tab "image file wrapper" or "display references": 04-28-2006. Note that the applicant later disclosed the WO-A3 search report (see below) to the US examiner which then also became recorded as relevant prior art ("List of References cited by applicant and considered by examiner").

Q: Is there information available regarding the examiner's search strategy?

A: Yes, see documents SRNT and SRFW in the image file wrapper. It refers to the search strategy applied for establishing the search report established on 28.4.2006.

Q: How can you view the full specification of the granted patent?

A: Select tab "published documents"; you get the full text and PDF; both also include the citations.

Q: Is there any family information in US PAIR?

A: See tab 'continuity data'. There is a PCT application (WO2006104953) claiming the priority of the US application.

Q: Can you follow the US decision to grant? Check the family information in Espacenet.

A: There is also a EP application.

Q: Check the examination status at the EPO.

A: Open the EP-Register by clicking on the link on the webpage displaying the bibliographic data of the EP family member. The application was rejected. Appeal is pending.

Q: Is the prior art considered by the EP examiner different?

A: You may view the citations in the CCD. The EP examiner considered fewer prior art documents but all of them were also considered by the US examiner

Q: What is argument of the EP to reject the application?

A: The EPO rejected the application because of a lack inventive step, see the 'grounds for the decision' document in the file wrapper. The EPO rejected the main request plus 3 auxiliary requests.

Task 2: [WO2014094844](#)

The US granted already a patent although the PCT application was published only recently and the 30 months deadline for PCT NPEs has not yet passed. We want to review what the US examiner did in this case and whether we feel confident with his decision to grant a patent.

Q: Check the family information. How many members has the simple or extended family. Has any other IPO granted a patent?

A: There are 6 family members. No other IPO has granted a patent.

Q: Open the corresponding US application in US Public Pair (you cannot use the PCT application number format shown in Espacenet). Where in US Pair do you find information that this is a PCT NPE?

A: You may search for the US application number 13/955699 which you find on the front page of the US-A1/B1 publications. Only when you click on the tab 'continuity data' you will get the information that it is a PCT NPE with the PCT application number PCT/EP2012/076170. You can also search US Pair with this number. Note that the PCT application number is formatted differently in Espacenet (WO2012EP76170) and would require a reformatting if you want to use in US Pair.

Q: Where do you find the list of documents cited as prior art? How are they called?

A: in tab 'Display References' or in tab 'Image File Wrapper';

Q: Which term is used by the USPTO for the communications from the examiner in which the examiner discusses the patentability of the claimed subject matter (other offices call it examination report/written opinion)? Which of the many documents cited as prior art have been referenced by the examiner in his 'examination report'?

A: non-final rejection

Q: Is there any description of the search strategy of the examiner?

A: Yes, see the SRNT and SRFW documents in the file wrapper.

Q: Do the Information Disclosure Statements include only patent publications?

A: No they also include other publications and also communications from other patent examiners (examination reports, etc..) on similar cases.

Q: Was a priority claimed when the PCT application was filed? Which is the Office of First Filing?

A: The priority information you find in US Pair.... This is an example where the first filing was with the PCT and the EPO as the receiving office of the PCT.

Q: Do the other family members claim any Paris convention priority?

A: No, they only reference the PCT application number. Only if the first filing had claimed a Paris priority then this would be transferred to and shown for all the NPEs.

Task 3: [WO2007111918](#)

Q: Retrieve the written opinion of the ISA from Patentscope. Is there any claim which could perhaps be granted? What is the problem with claims 17-22? Does the written opinion include any

observations other than those regarding novelty, inventive step and industrial applicability? Which ISA established the written opinion? How many citations does the examiner use in the WO and how many citations are listed in the ISR? How many citations of the ISR challenge the novelty of claim 1?

A: Claims 17-22 have not been searched because of a lack of unity. None of the other claims appears to be „patentable“, see the statements. The examiner also raises objections because the claims do not include reference numerals and because claim 6 and 9 include unclear wording. The WO was established by the EPO. The examiner uses only 3 of the citations of the 8 of the ISR. 3 citations in the ISR challenge the novelty of claim 1.

Q: Search the same application in Espacenet/EP-Register. What is the status at the EPO, what is the overall view of the examiner? Does EP-Register include the ISR and ISA-WO?

A: The application is deemed to be withdrawn since 24.9.2013 because the applicant did not reply to an office communication; however appeal is still possible. The examiner raised an objection because the amended claims include subject matter which was not part of the initial disclosure. He also objected unclear wording. On page 3 he states a very negative opinion that claims could be amended in anyway to satisfy novelty and inventive step requirements.

Q: Did any other patent office grant a patent?

A: Only the Eurasian Patent Office (EAPO) granted a patent, as you can see from the EA-B1 document listed in the Inpadoc family list on Espacenet.

Q: What is the status in the US? Check Inpadoc legal status in Espacenet and check US-PAIR.

A: When you select the US family member in the Inpadoc family list, you can check the legal status with the Inpadoc legal status link. It appears to be pending because the last legal event recorded was a change of assignment.

When you check this status in US-PAIR you will find that the application is deemed to be abandoned already since 30.5.2012 because of a failure to respond to an office action.

Q: What is the status at the JPO? Check Inpadoc legal status and AIPN.

A: At JPO the grant of a patent was refused according to the Inpadoc legal status.

Q: What is the status in CA ([CA2646350](#))? Use the link in Patentscope.

A: Examination requested (21.3.2012) according to Inpadoc. The CA Register confirms that, it also confirms that the application is still pending because maintenance fees have been paid in 2013. File inspection is not possible; no communications between the examiner and the applicant are accessible.

Q: The patent is pending in Cambodia; the claims submitted to examination there are claims 17-22. What would you recommend the examiners of Cambodia?