



# 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
  - [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=26624](http://www.wipo.int/meetings/en/details.jsp?meeting_id=26624)
- Nov 2012: National WS with DIP (Thailand), NOIP (Viet Nam)
- Jan 2013: Sub-regional French speaking African IPOs
  
- Mar and Aug 2012: Module for newly recruited examiners of IP India
  
- Jul 2014: National WS with IPOPHL (Philippines)

# Agenda

- Challenges of small and medium IPOs
- Legislative foundations
- Elements of patent prosecution
- Options for **substantive** examination and implementation of patent prosecution

# Different categories of IPOs

## Expertise

- IPOs just **embarking on patent prosecution** (e.g. Bahrain, Oman, Bhutan, Cambodia, Kuwait, Ghana ...)
- IPOs having **established patent prosecution** ("emerging Offices"; e.g. GCC, Jordan, Malaysia, Saudi Arabia, Thailand, Viet Nam,...)
- IPOs with **long work experience** (DPMA, EPO, JPO, USPTO, ...)

## Size

- **Small IPOs** with very few examiners (e.g. Bahrain, Oman, Bhutan, Jordan, Syria, Kuwait, Ghana) and the capacity to **cover very few areas of technology**
- **Medium size** IPOs with the capacity to **cover some but (may be) not all areas of technology** (GCC, Saudia Arabia, Thailand, Viet Nam)
- **Large** IPOs with sufficient number of staff to cover all areas of technology (IP India, USPTO, EPO, JPO)

# IPO's challenges in many IP-DCs

- IP-DC: Country developing its IP infrastructure
- Establish efficient patent prosecution procedures 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
- limited 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**

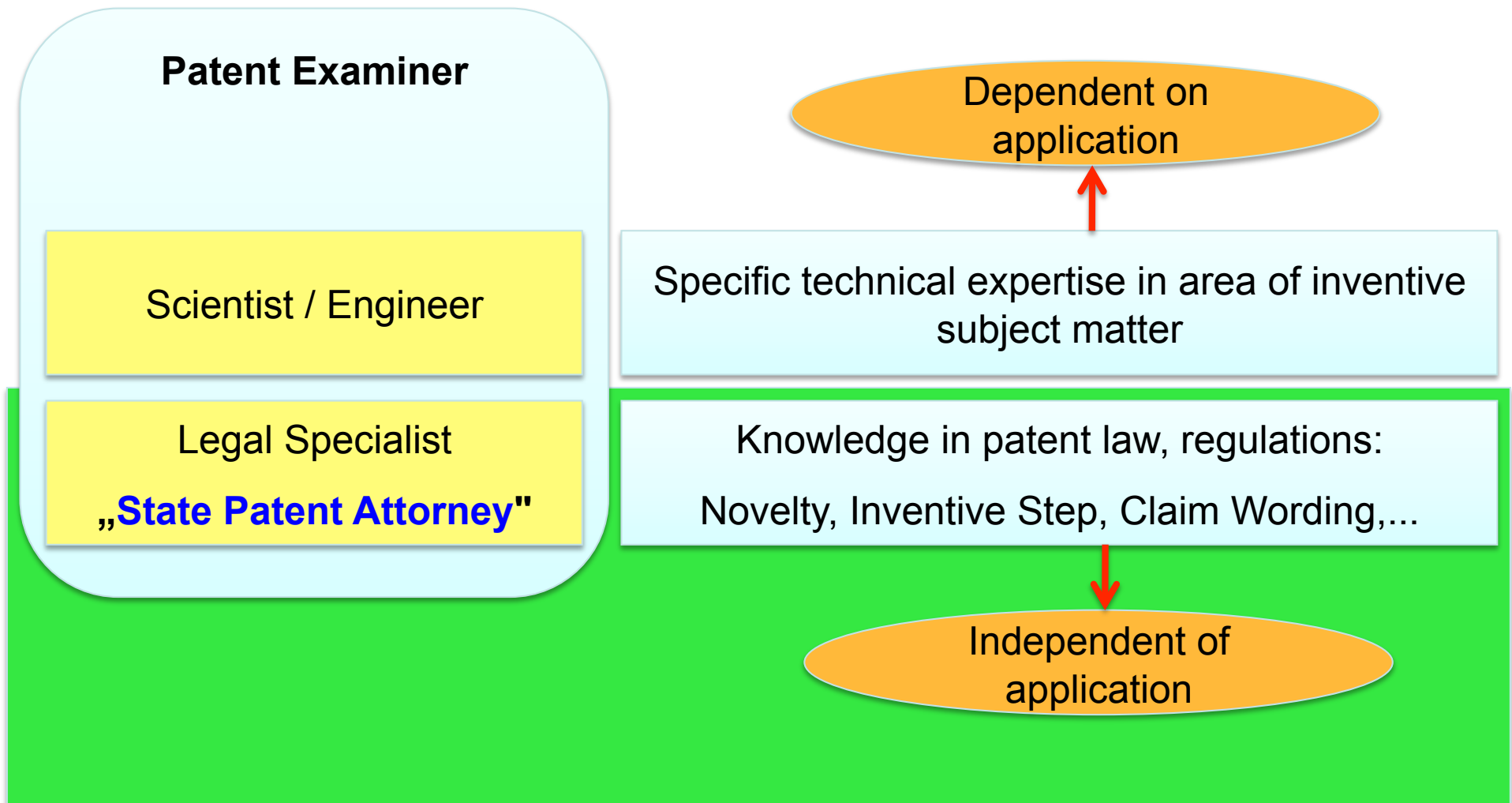
# Substantive examination in small IPOs?

- 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 training is needed?

## > Topic 7: national experiences

- I think: Yes, if trained as "state patent attorney,, and, in particular, if trained in the exploitation of external examination results for members of the patent family
- Agree?

# Required examiner capacities



# "National phases" in general

Categories of patent applications

- **PCT national phase entries**

- application is member of **patent family**

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

- priority claimed, i.e. is member of (Paris) **patent family**

- priority not claimed:

- > "**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 2: 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
- „**Passive worksharing**“: Use results that were obtained for family members at other IPOs
- **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)

# Passive worksharing

- PW is a very effective strategy for small IPOs to cover all technical areas
- PW can also also enhance efficiency at other IPOs
- 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
- Can be done by respectively trained examiners acting like "state patent attorneys"

> This workshop

# Legal basis of substantive examination

- ▶ Patent law/act (issued by parliament, i.e. legislative body)
- ▶ Patent rules/regulations/ordinances (issued by minister, commissioner/..., i.e. administrative body)
- ▶ 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](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/ipr/patent/DraftPatent_Manual_2008.pdf)

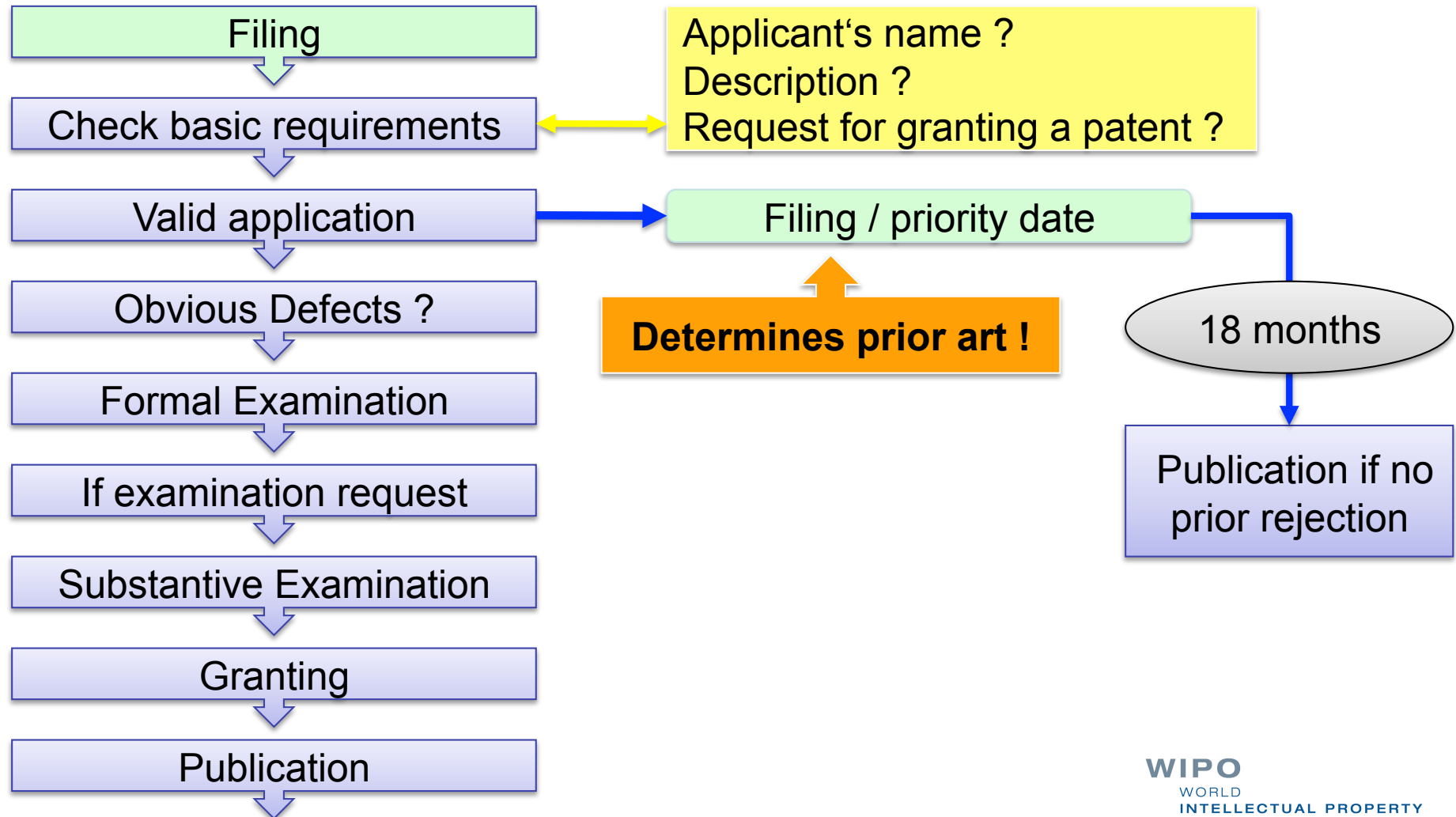
[http://ipindia.nic.in/PatentOfficeProcedure/PatentOfficeProcedure\\_2009.pdf](http://ipindia.nic.in/PatentOfficeProcedure/PatentOfficeProcedure_2009.pdf)

## ▶ USPTO Guidelines

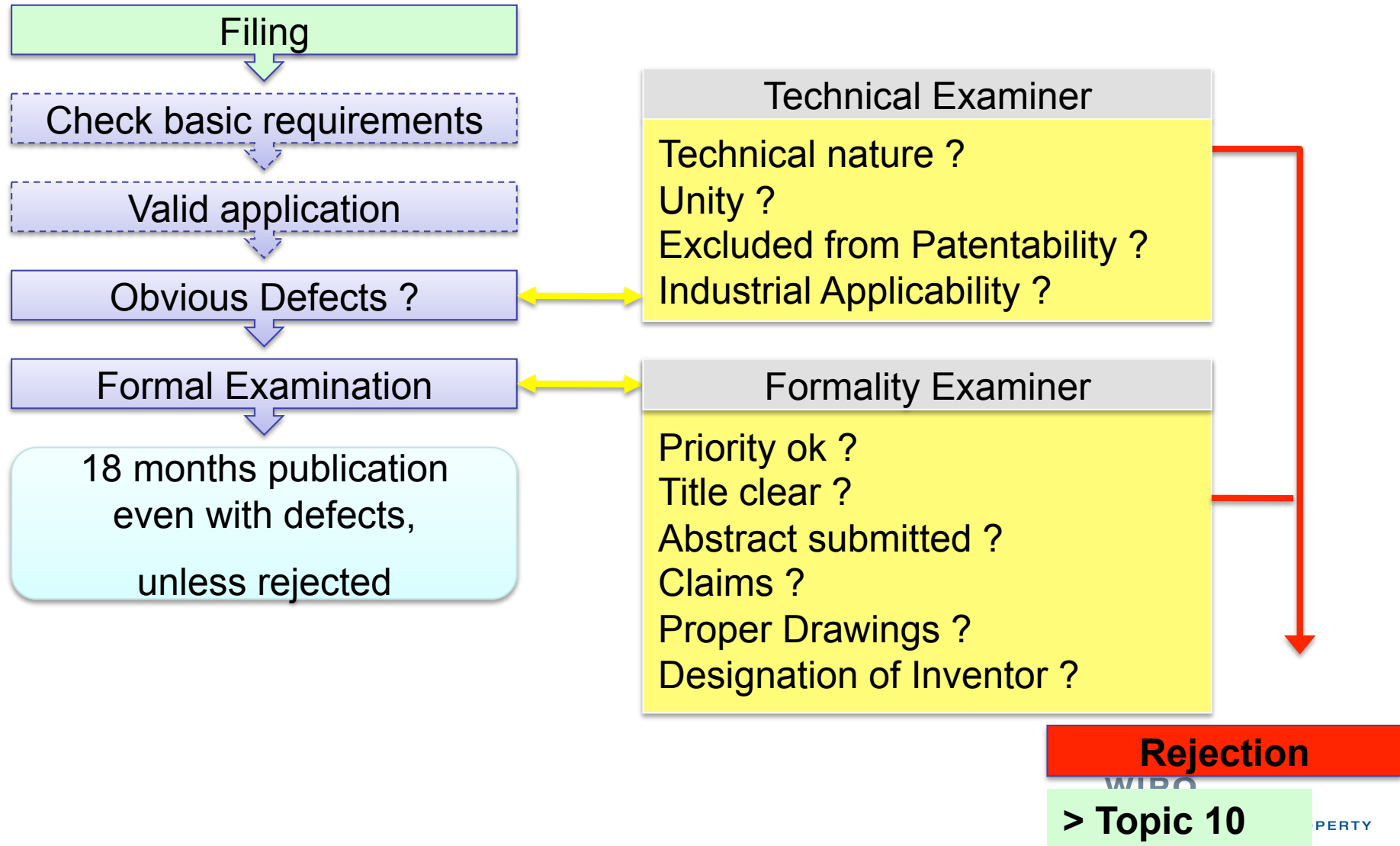
<http://www.uspto.gov/web/offices/pac/mpep/documents/2100.htm>

> **Topic 8: differences**

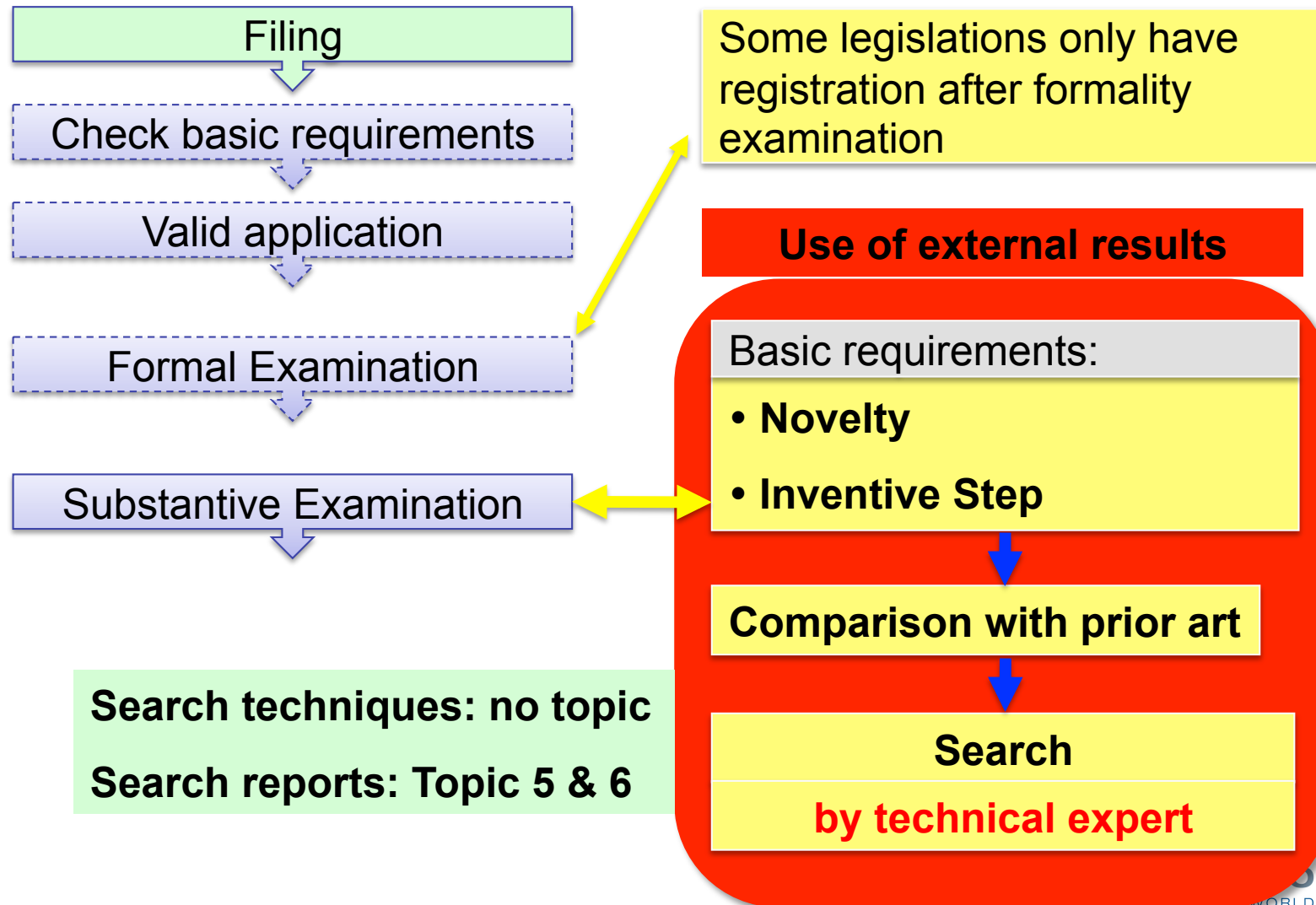
# Elements of patent prosecution



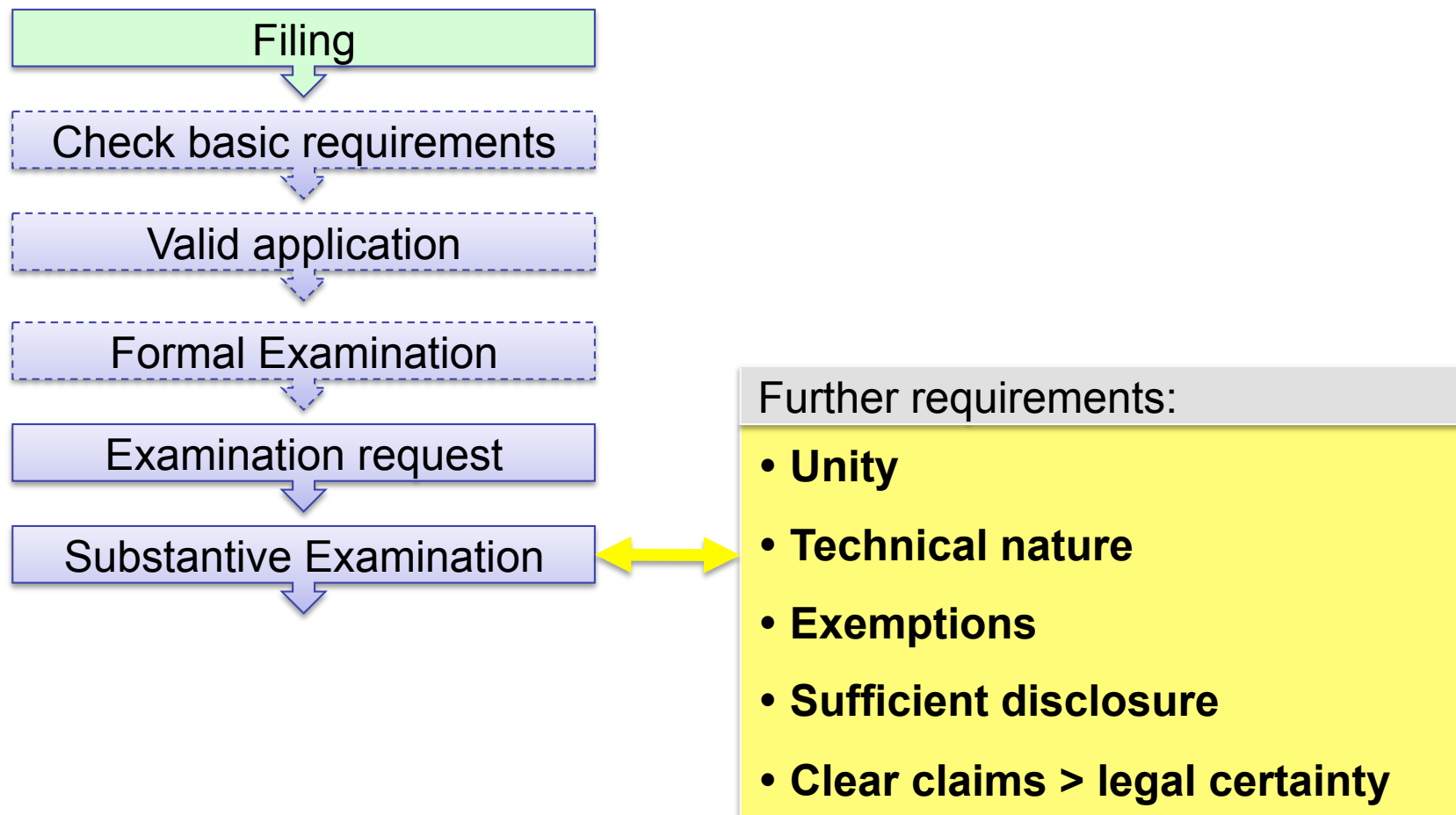
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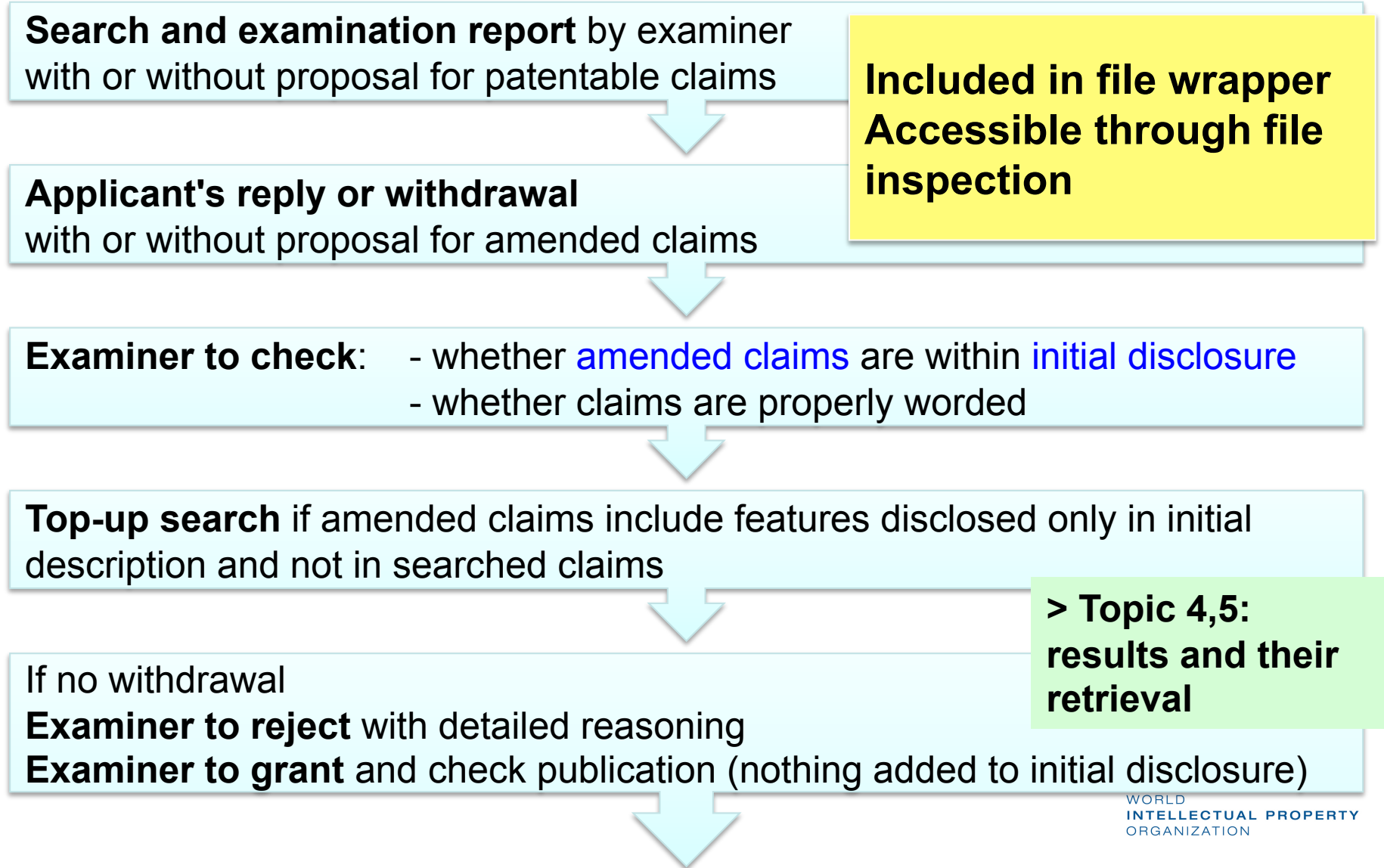
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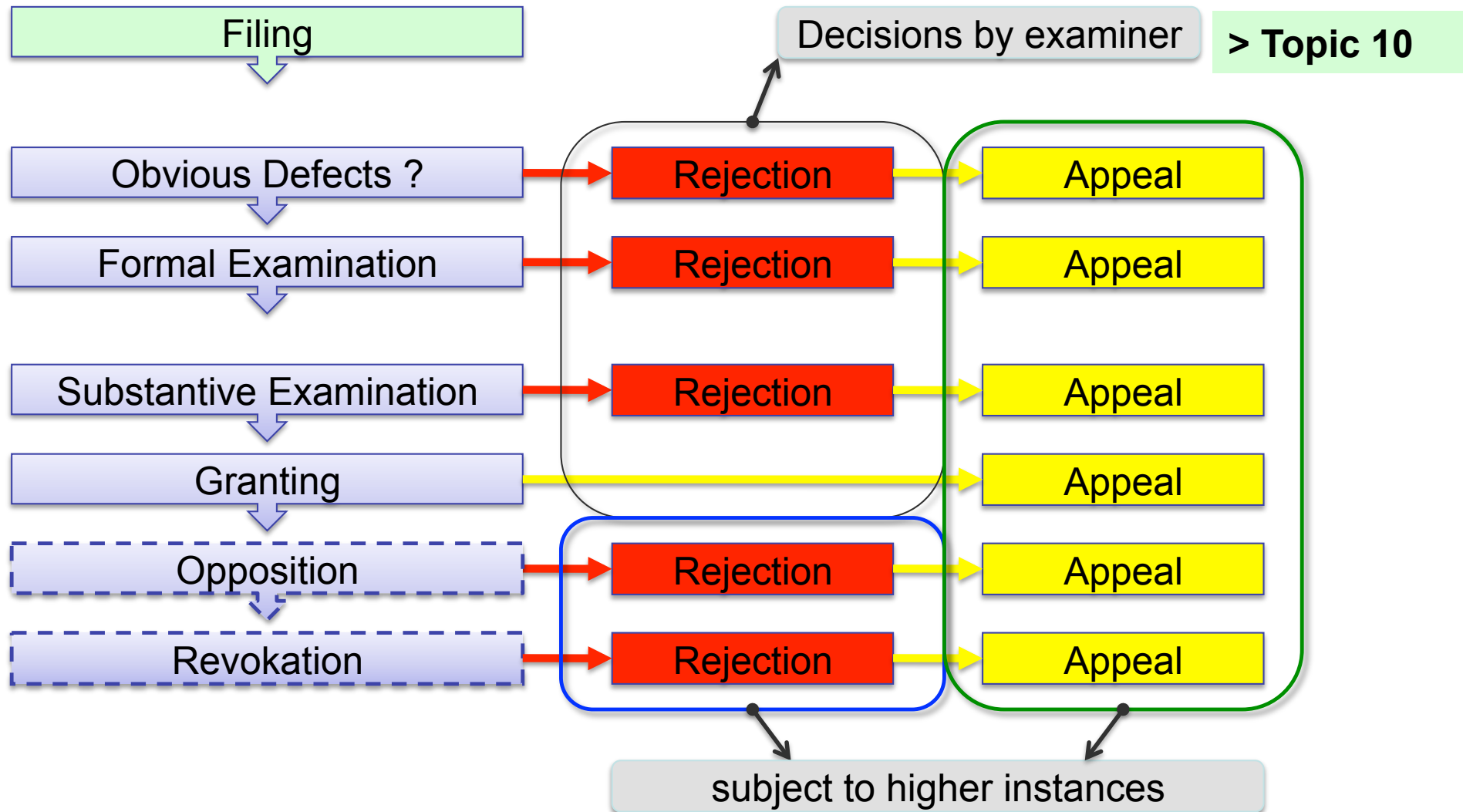
> Topic 8

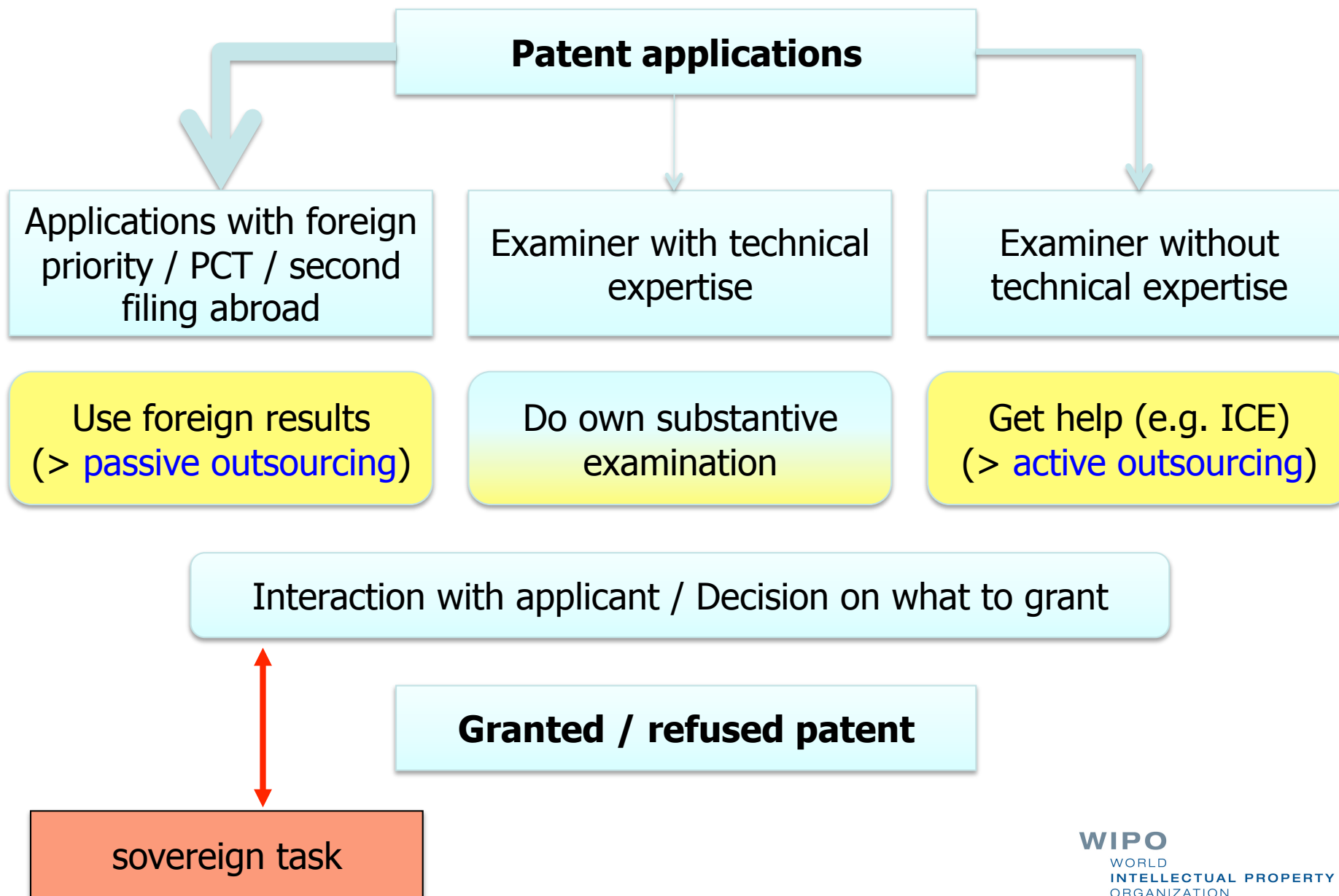


# Communications in patent prosecution



# Elements of patent prosecution





# 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](http://www.wipo.int/treaties/en/ip/paris/summary_paris.html)
- Each IPO has obligation to observe national legislation
- Each IPO has responsibility/liability for quality patents
- Lawyers often refer to grants at other IPOs: just ignore that!

# Example: Singapore

- Outsourcing of paid S&E to other IPOs (AU, AT, HU, DK) for "local route"
- For all types of applications, including PCT national phase entries
- Outsourced examination based on SG patent law and regulations
- Self-assessment by applicant based on examination report (currently under review)
  
- Similar outsourcing by GCC, UAE, ...

# Example: Jordan

- Two track system:
  - foreign results are available and usable:
    - > wait for availability of final results
  - foreign results unavailable or not usable:
    - submit request to WIPO's ICE service
    - preliminary examination prior to submission (claim quality,...)

# Patent prosecution – summary of options

## Option 1

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

## Option 2

- ▶ Rely fully on **grants/rejections** of other IPOs
- requires identical claims & cooperative applicants
- requires claims compatible with national law
- implies considerable delay because final results have to become available

> Topic 9: use claims

> Topic 10: use rejections

## 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

# Example: Cambodia patent law

## 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 1<sup>st</sup> paragraph of this Article.



# 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 1<sup>st</sup> paragraph of Article 31 of this Law relating to, or a final decision submitted under item (iii) of the 1<sup>st</sup> 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.

# Workshop objectives

- Understanding concepts of patent families
- Identification of foreign family members of pending national application and their examination status
- Retrieval of (intermediary or final) results of examination of family members at other IPOs
- Utilization of results in national context
- Enhancing efficiency of substantive examination while observing national sovereignty

Thank you

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