



# **Paris Convention and PCT applications**

## **Challenges & opportunities for their examination in the national phase**

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PCT International Cooperation Division

**Dhaka**  
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# Agenda

- What are the differences of examining Convention or PCT applications?
- Opportunities for both: Growing transparency of examination of members of patent family (emerging work-sharing platforms)
  - Diversity of examination work-products from various offices
    - Visible/accessible for other examiners
    - Visible for third parties (attorneys, competitors, ....)
- Potential benefits and challenges for national phase examination
  - Enhancing efficiency & improving quality through work-sharing
  - Quality monitoring/management
  - Examination results may be monitored by third parties

# Potential accession to PCT

- The PCT is not replacing the Paris Convention; it will complement it
- However, the majority of foreign applications will be filed through the PCT rather than through the Paris Convention route
  - Because most applicants already use the PCT for filing in other countries
  - Because of the benefits for applicants
  - > **Convention applications will be largely replaced by PCT applications**
- Are there further implications for examination of foreign applications due to PCT accession? Or for the work of attorneys?

# Impacting national examination?

- Claiming a Paris Convention priority right, and/or
- Filing of a patent application through the PCT

## Do they bind the examiners when examining the patent application?

- **No**; except that the priority date – if validly claimed – determines the relevant prior art.
- Even when deciding if it is validly claimed, each examiner is fully sovereign; that is, the examiner is not bound by the decision of examiners in other countries regarding the same priority right.

# Sovereign national prosecution

## Paris Convention 1883:

- **Article 4bis**: No obligation to follow/adopt conclusions of other IPOs or to use their results
- Each IPO has obligation to observe national legislation
- Each IPO has responsibility/liability for quality/validity patents

# Paris Convention Article 4bis

(1) **Patents** applied for in the various countries of the Union by nationals of countries of the Union **shall be independent of patents obtained for the same invention in other countries**, whether members of the Union or not.

# Sovereign national prosecution

**PCT addresses national sovereignty as well:**

- [Art 27 \(5\)](#) Chapter I
- [Art 33](#) Chapter II

# PCT Article 27(5)

(5) **Nothing** in this Treaty and the Regulations is intended to be construed as prescribing anything that would **limit** the **freedom** of each Contracting State **to prescribe such substantive conditions of patentability as it desires. ....**



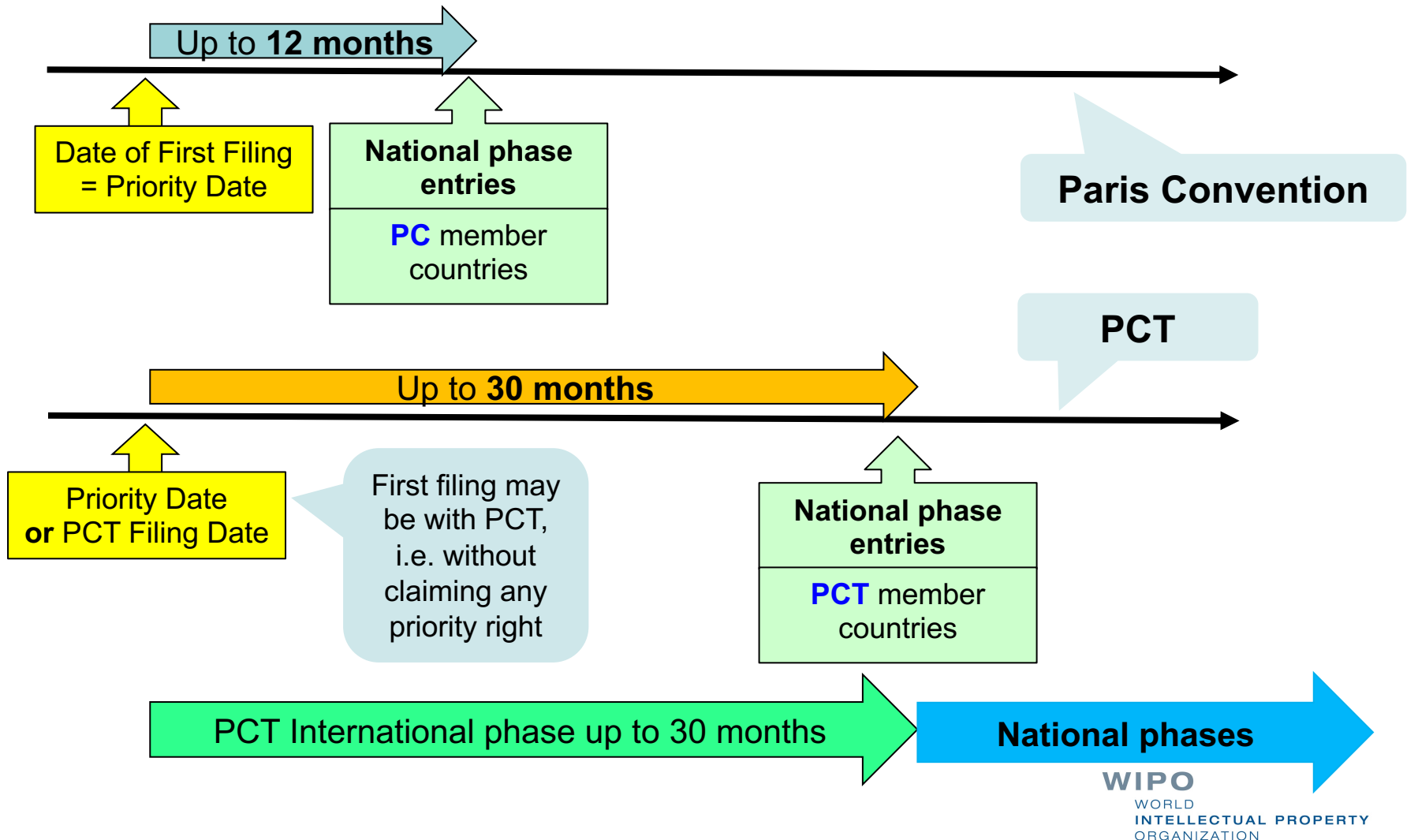
# PCT Article 33

(1) The objective of the international preliminary examination is to **formulate a preliminary and non-binding opinion** on the questions whether the claimed invention appears to be **novel**, to involve an **inventive step** (to be non-obvious), and to be **industrially applicable**.

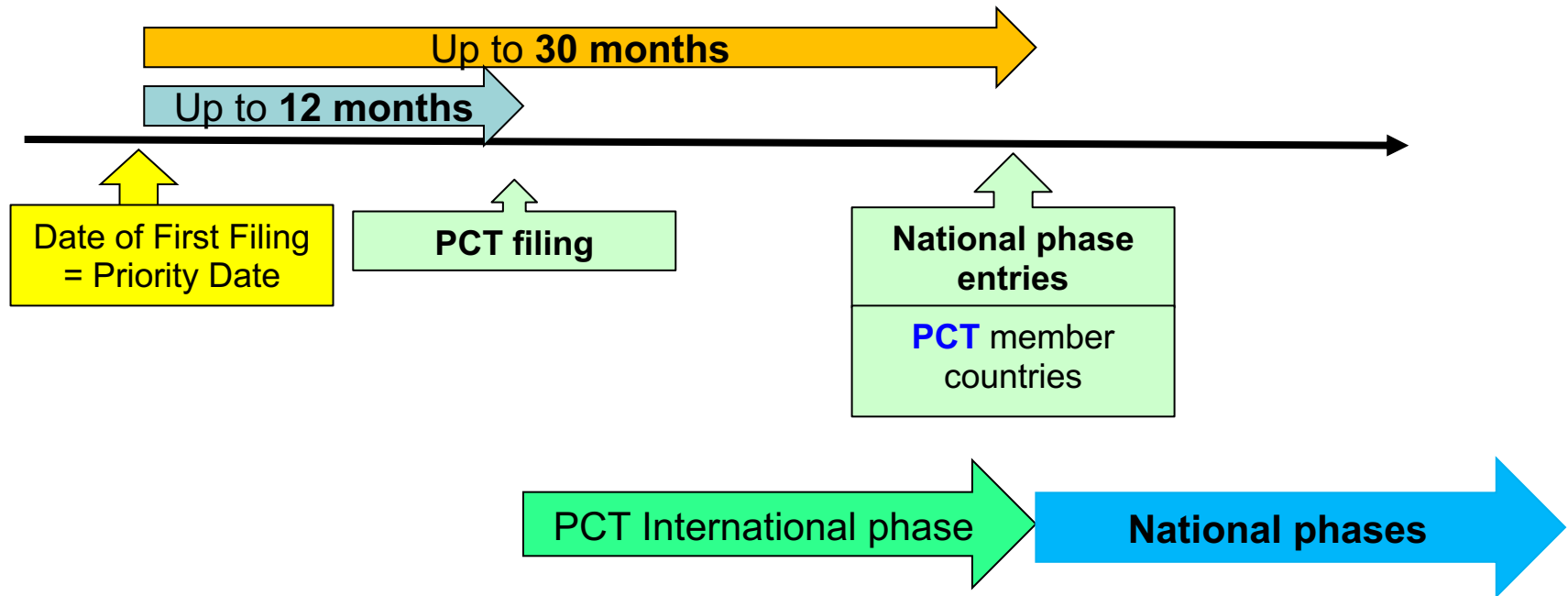
.....

(5) The criteria described above merely serve the purposes of international preliminary examination. **Any Contracting State may apply additional or different criteria for the purpose of deciding whether, in that State, the claimed invention is patentable or not.**

# Time lines of Paris Convention and PCT



# Using Paris Convention and PCT



# PCT International Phase

- ISA will conduct prior art search and issue a **non-binding** opinion on novelty, inventive step and industrial applicability of claimed subject matter
- Enables an informed decision of applicants on whether and how to continue
- Optionally, applicants may amend claims and obtain at least one further opinion (Chapter II)
- Prior art search reports (ISR) and opinions (WO, IPRP) serve also examination purposes in national phase
- Utilized already now by DPDT because most Convention applications have PCT application in the patent family

# Evolution of examination for PCT family

## Intermediary examination work products

International (phase)  
Search Report (ISR) &  
Written Opinion (WO)

1<sup>st</sup> national phase  
search report (SR)  
& opinion

2<sup>nd</sup> national  
phase SR &  
opinion

3<sup>rd</sup> national  
phase SR &  
opinion

...

Up to 30 months

Maximum term of  
protection:  
20 years after FD

Priority Date (PD)  
or Filing Date (FD)  
of **International  
Application**

**National phase  
entries**

trigger national  
examination  
US, EP, KR, JP,  
CN, MY, IR, BH,  
PG, ....

**PCT family**

1<sup>st</sup> Grant  
(OEE in PPH)  
(often priority  
country)

2<sup>nd</sup> Grant

3<sup>rd</sup> Grant

...

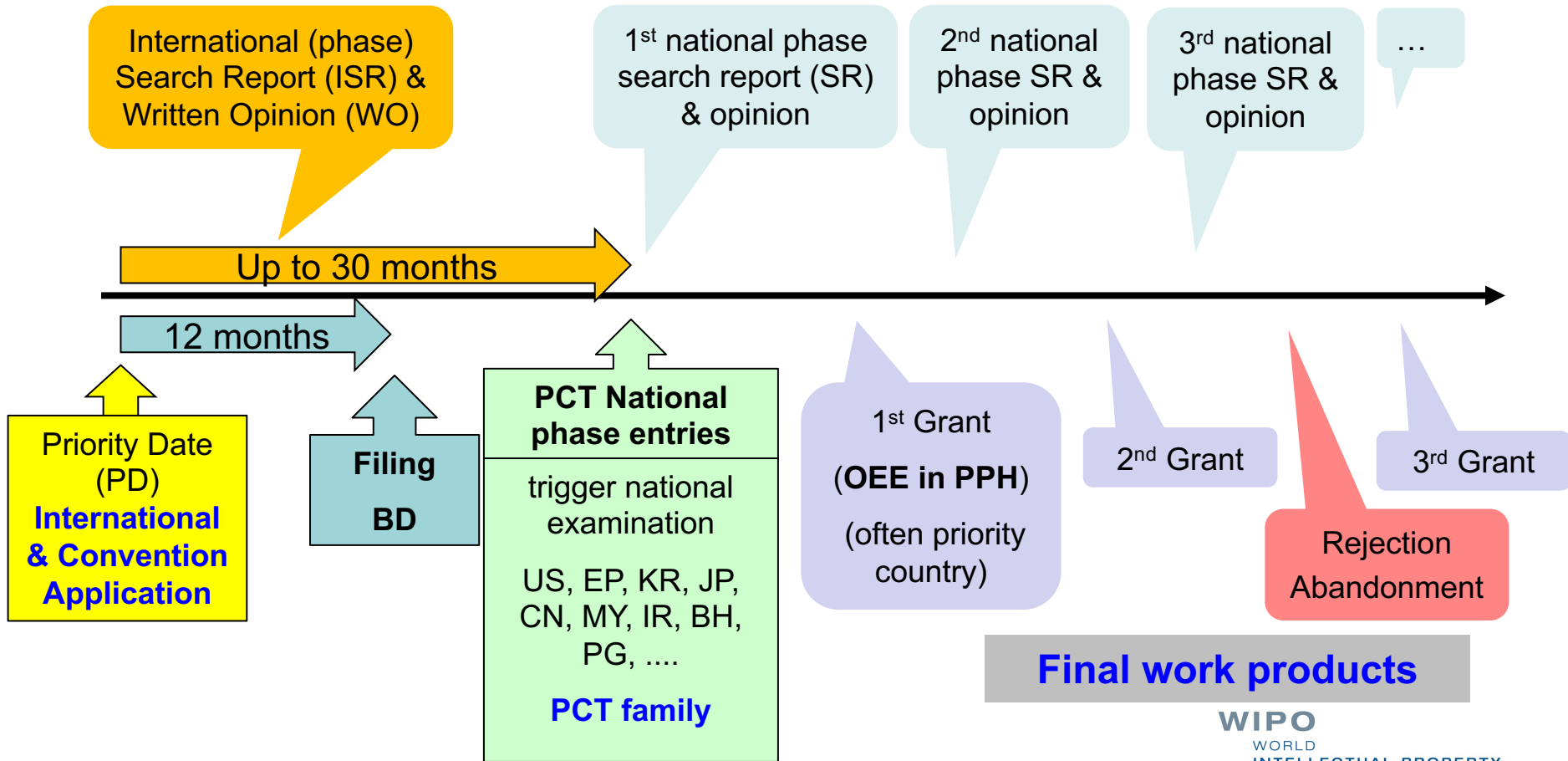
Rejection  
Abandonment

## Final work products

**WIPO**  
WORLD  
INTELLECTUAL PROPERTY  
ORGANIZATION

# Evolution of examination

## Intermediary examination work products



# Work-sharing (using foreign work products)

- **PCT patent family**: all applications linked through same PCT application number
- 'Simple' patent family: PCT family **plus** filings in non PCT member states (linked through priorities)
  
- **Patent families enable work-sharing (use of foreign examination results)**
- **Growing transparency of national phase examination** because of **public work-sharing platforms**:
  - Global Dossier (via ESPACENET, [USPTO Global Dossier](#), J-PlatPat, CPQUERY)
  - WIPO CASE (most dossiers also publicly accessible through PATENTSCOPE)
  - National Patent Registers (see WIPO Patent Register Portal)
  
- Easy access to a large diversity of examination work-products (search reports, opinions, rejection rulings, claim sets granted; opposition rulings) from family members
  - **Visible for examiners from any office**
  - **Visible for third parties (after publication)**

# Work-sharing in Bangladesh Patent Act 2022

## Section 12

### **Information Concerning Corresponding Foreign Patent Applications**

(1) The registrar, in case of necessity may issue notice in writing to produce the following necessary documents relating to **foreign patent application** and within 90 (ninety) days of issuance of notice, document shall required to be produced, as:

- (a) Copy of Examination report and notice relating to search report in foreign Country, if available;
- (b) Letters' patent pursuant to foreign application, a copy of the same;
- (c) If the foreign application is rejected, a copy of the same;
- (d) If applicable, copy of final order cancelling the granted patent.

....

(3) If the application fails to comply with the query of the registrar without explaining any reasonable cause or does not produce all relevant documents, **the application shall be deemed to have been refused** or repealed for the matters.



# Current situation of transparency

For published applications:

- One can follow examination process of **IP5 offices (CN, EP, JP, KR, US)** **with only short delay** via Global Dossier
  - Similarly possible for more and more other offices (AU, CA, GB, IN, SG,...; via national registers or WIPO CASE)
  
- Read examination reports
  - In several languages by means of machine translation (GD)
  
- Differences become visible as well; for example, by using tools like the Common Citation Document ([CCD](#)) for comparing the list of citations used by different examiners.
  - Identify citations found and used by one examiner only

# Delay of public access to office action

<input type="checkbox"/>				
<input type="checkbox"/>	03.01.2020	Communication regarding the transmission		
<input type="checkbox"/>	03.01.2020	European search opinion		
<input type="checkbox"/>	03.01.2020	Information on Search Strategy		
<input type="checkbox"/>	03.01.2020	Supplementary European search report		
<input type="checkbox"/>	11.12.2019	Search started		
<input type="checkbox"/>	02.10.2019	Notification on forthcoming publication of bi		
<input type="checkbox"/>	05.09.2019	(Electronic) Receipt		
<input type="checkbox"/>	05.09.2019	Letter accompanying subsequently filed ite		
<input type="checkbox"/>	05.09.2019	Matter concerning the application		
<input type="checkbox"/>	13.08.2019	Communication regarding possible amendr		
<input type="checkbox"/>	08.08.2019	Change to the inventor details		

The supplementary search report has been based on the last set of claims valid and available at the start of the search.			
1	Place of search Munich	Date of completion of the search 13 December 2019	Examiner Martínez Martínez, V
CATEGORY OF CITED DOCUMENTS		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	
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		& : member of the same patent family, corresponding document	

**3 weeks**

**Date of dispatch or receipt**

**Date of examiner action**

Date of posting in dossier? EPO: one day after dispatch

# Types of examination work products

- **Intermediary or pre-grant** work products
  - Search reports
    - basic list of citations (cited by examiner, by applicant)
    - enriched search reports (citation category X, Y, ...; relevant claims;...)
  - Search strategies
  - Written opinions, examination reports
  - Communications from applicant to examiner
  - Protocols of hearings
  - Third party observations
- **Final** work products/results
  - Granted claims; claims after opposition
  - Rejections; withdrawals following substantive reports; abandoned claims
- **Post-grant** work products/results
  - Additional prior art from opposition/re-examination/invalidation
  - Restricted claims
  - Communications between involved parties (3+)



**4. A METHOD FOR RECOVERING HYDROCARBON COMPOUNDS AND A HYDROCARBON RECOVERY APPARATUS FROM A GASEOUS BY-PRODUCT**

★ <b>Inventor:</b> TASAKA KAZUHIKO [JP]	<b>Applicant:</b> JAPAN OIL GAS & METALS JOGMEC [JP] INPEX CORP [JP] (+4)	<b>CPC:</b> B01D3/00	<b>IPC:</b> C10G2/00	<b>Publication info:</b> CA2752839 (A1) 2010-09-02 CA2752839 (C) 2014-02-18	<b>Priority date:</b> 2009-02-27
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Grant

**5. Method for collecting hydrocarbon compound from gaseous by-product and apparatus for collecting hydrocarbon**

★ <b>Inventor:</b> KAZUHIKO TASAKA	<b>Applicant:</b> JAPAN OIL GAS & METALS JOGMEC INPEX CORP (+4)	<b>CPC:</b> B01D3/00	<b>IPC:</b> C10G2/00	<b>Publication info:</b> CN102333846 (A) 2012-01-25 CN102333846 (B) 2014-01-29 <a href="#">Global Dossier</a>	<b>Priority date:</b> 2009-02-27
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Grant

**6. METHOD FOR COLLECTING HYDROCARBON COMPOUNDS FROM GASEOUS BY-PRODUCT AND APPARATUS FOR COLLECTING HYDROCARBON**

★ <b>Inventor:</b> Тасака, Казухико	<b>Applicant:</b> ДЖЭПЭН ОЙЛ, ГЭЭ ЭНД МЕТАЛЗ НЭШНЛ КОРПОРЕЙШН, ИНПЕКС КОРПОРЕЙШН, (+4)	<b>CPC:</b> B01D3/00	<b>IPC:</b> C10G2/00	<b>Publication info:</b> EA201170995 (A1) 2012-02-28 EA018772 (B1) 2013-10-30	<b>Priority date:</b> 2009-02-27
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Grant

publication kind  
code for grants  
B or C  
(sometimes A)

publication date

**7. METHOD FOR COLLECTING HYDROCARBON COMPOUND FROM GASEOUS BY-PRODUCT AND APPARATUS FOR COLLECTING HYDROCARBON**

★ <b>Inventor:</b> TASAKA KAZUHIKO [JP]	<b>Applicant:</b> JAPAN OIL GAS & METALS JOGMEC [JP] INPEX CORP [JP] (+4)	<b>CPC:</b> B01D3/00	<b>IPC:</b> B01D53/14	<b>Publication info:</b> EP2402418 (A1) 2012-01-04 EP2402418 (A4) 2012-11-21 <a href="#">Global Dossier</a>	<b>Priority date:</b> 2009-02-27
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No grant

Why?

**8. METHOD FOR COLLECTING HYDROCARBON FROM FT GAS COMPONENT AND APPARATUS FOR COLLECTING HYDROCARBON**

★ <b>Inventor:</b> TASAKA KAZUHIKO	<b>Applicant:</b> JAPAN OIL GAS & METALS JOGMEC INPEX CORP (+4)	<b>CPC:</b> B01D3/00	<b>IPC:</b> C10G2/00	<b>Publication info:</b> JP2010202677 (A) 2010-09-16 JP5301318 (B2) 2013-09-25 <a href="#">Global Dossier</a>	<b>Priority date:</b> 2009-02-27
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Grant



# European Patent Register

◀ About European Patent Register Other EPO online services ▼

Smart search | Advanced search | Help

EP2402418
European procedure
About this file
Legal status
Federated register
Event history
Citations
Patent family
<b>All documents</b>

**All documents: EP2402418** Dossier alert: RSS Email

Refine search    ↓ Selected documents    ↓ Zip Archive    ↗ Espacenet    Submit observations    Report error

All documents(38)

<input type="checkbox"/> <u>Date</u> ▲	Document type
<input type="checkbox"/> 18.09.2017	<a href="#">Closing of application</a>
<input type="checkbox"/> 07.06.2017	<a href="#">Application deemed to be withdrawn ( translations of claims/payment missing from 01-04-2012)</a> ←
<input type="checkbox"/> 04.04.2017	<a href="#">Notice drawing attention to the payment of the renewal fee and additional fee</a>
<input type="checkbox"/> 21.12.2016	<a href="#">Bibliographic data of the European patent application</a>
<input type="checkbox"/> 21.12.2016	<a href="#">Communication about intention to grant a European patent</a> ←
<input type="checkbox"/> 21.12.2016	<a href="#">Intention to grant (signatures)</a>
<input type="checkbox"/> 21.12.2016	<a href="#">Text intended for grant</a>
<input type="checkbox"/> 21.12.2016	<a href="#">Text intended for grant (clean copy)</a>

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Maintenance news +

# Work-Sharing in the PCT national phase

Utilizing examination work products from other national phases for improving **efficiency** and **quality** requires

- **Databases/platforms** providing
  - Patent **family information** (family table)
  - **Examination status** of family members
  - **Access to** examination **work products** (**dossiers**, file wrappers) of family members
  
- Ideally, platforms which integrate this information in a user-friendly manner, e.g. within family table; and with additional tools, for example, for comparing work products (Common Citation Document - CCD)
  
- Information on differing national practices (naming and content of work products; important case law; exclusions; ..)

# Families and Work-Sharing

## Family table (PCT family)

**PCT/xx** to be examined in national phase

<b>CN</b>	CN-A/B Publications	CN Dossier	CN Citations	}	<b>IP5</b>
<b>EP</b>	EP-A/B Publications	EP Dossier	EP Citations		
<b>JP</b>	JP-A/B Publications	JP Dossier	JP Citations		
<b>KR</b>	KR-A/B Publications	KR Dossier	KR Citations		
<b>US</b>	US-A/B Publications	US Dossier	US Citations		
<b>AU</b>	AU-A/B Publications	AU Dossier	AU Citations		
<b>CA</b>	CA-A/C Publications	CA Dossier	CA Citations		
<b>IN</b>	IN-A/B Publications	IN Dossier	IN Citations		
...					

There is no platform yet which includes this comprehensively

# Sources of family information

- **EPO's INPADOC database** is major source of such family information, accessible through:
  - Espacenet, EP-Register and CCD (simple and extended families; domestic families)
  - Other free patent information databases, like Depatis, Google Patents, ..
- **WIPO PATENTSCOPE**
  - aggregates **national phase entry data reported from Designated/Elected Offices** (obligation as from July 1, 2017; rule 95)
  - Proprietary family building (since 2021)
- **WIPO CASE** with proprietary family building based on application data shared by 'providing offices'; families are complex families (i.e. share at least one priority)
- **Commercial** patent databases obtain and use widely INPADOC data, and apply proprietary family building rules and data cleaning, e.g.
  - Clarivate/Derwent: WPI family
  - Questel/Orbit: Fampat family
  - ...
- Other specialized platforms, e.g. WIPO's [Pat-Informed](#) or MPP [MedsPal](#)
- **India Form 3**



# Dossier Access and Status Information

- **Primary sources:** each jurisdiction defines how **authoritative (official)** patent information is published and the respective authority in charge
- **National Patent Registers** are **authoritative** sources for
  - national **legal status: all do (many online)**
  - national family relations (divisions, continuations)
  - national publications
  - online access to national **dossiers** (public file inspection): **some do**
- **Secondary sources (dossier access platforms):** one-stop shops to access information from several primary sources through a unified user interface (building on a table of the patent family); access with English user interface:
  - **Espacenet - Global Dossier** (public)
  - **USPTO - Global Dossier** (public)(Google Patents links to USPTO GD)
  - **J-PlatPat - One Portal Dossier** (=Global Dossier; public)
  - **CPQUERY - Global Dossier** (registration required)
  - **WIPO CASE** (non-public)
  - **WIPO PATENTSCOPE** (public)

# Global Dossier

- Initially IP5 initiative (initially labelled One Portal Dossier)
- Access to **IP5 Offices' file wrappers/dossiers**
  - always up-to-date because it is retrieved on-the-fly from IP5 national registers
  - Machine translation for non-English documents
  - Accessible via Espacenet, USPTO-GD, J-PatPLat, CPQUERY, Google Patents
  - Same data, only different user interface
- Access to **non-IP5 dossiers** of 'providing' Offices of WIPO-CASE
  - partly operational
- Espacenet interface with additional information/tools
  - Different types of families viewable (USPTO GD only extended family)
  - Inpadoc legal status
  - integrated access to **Common Citation Document (CCD)**:
    - viewing and comparing of citations from members of extended and simple families from AP, AU, CA, CN, DE, EA, EP, JP, KR, RU, TW, US, WO, ....
    - '**comparing**': which examiners have seen a particular citation or an equivalent thereof

# Dossier access platforms

## WIPO-CASE (non-public) - Centralized Access to Search and Examination

- **Accessible only for 'accessing' and 'providing' Offices**
- 'Providing' offices share their dossiers with other participating offices:
  - IP5 dossiers obtained from GD/OPD (WIPO/EPO collaboration)
  - plus: [AU](#), [BN](#), [CA](#), [CL](#), [GB](#), [IL](#), [IN](#), [NZ](#), [SG](#) ..
- All ASEAN member offices are 'accessing' offices, only BN, SG are also 'providing'; others may become 'providing' in the near future
- Family information includes only so-called 'complex' families
  - **Proprietary family building** based on applications of 'providing' Offices recorded in CASE, and NPEs recorded in PATENTSCOPE
  - EPO INPADOC family data are not integrated
- No plans to open CASE to the public
- **Bangladesh** not yet a user of CASE
- Majority of dossiers are also [publicly accessible through PATENTSCOPE](#) 'document' tab (labelled as 'Global Dossier')

# Dossier access platforms

## PATENTSCOPE

- Public access to WIPO CASE dossiers through 'document' tab (labelled as 'Global Dossier')
- For jurisdictions which have authorized public sharing outside of CASE
- For some additional jurisdictions enabling deep-linking to their national registers
- Two distinct family tables
  - PCT family (National Phase Entries (NPE) reported to WIPO from Designated and Elected Offices)
    - only shown for WO publications
  - Additional proprietary family building based on simple family concept
  - EPO INPADOC family data are not integrated

# How different are examination results?

## Sample **WO2008035580**

- 2 JP priorities
- Extended family: 41 members
- Simple family: 35 members

Derived from kind codes of publications recorded in Espacenet

- **Simple** family: **grants** in AP, AU, CA, 2xCN, NZ, EA, EP, KR, MA, MX, MY, NZ, TW, UA, US, PH, VN, ....?
- **Extended** family: further grants in: 2xJP (priority country)
- **Pendency: 2-10 years**
  - 2006-09-20 earliest priority date
  - 2008-09-03 JP grant
  - 2016-10-26 EP
- Still pending in BH, LA,..

# Examples of grants: WO2008035580

## WO-A1 = AU-B2 = JP-B1

1. A plant cultivation system comprising:

- a nonporous hydrophilic film for cultivating a plant thereon, and
- a feeding means for supplying water or a nutrient fluid to the lower surface of said nonporous hydrophilic film in the absence of a hydroponic tank for accommodating water or a nutrient fluid and cultivating a plant therein.

AU, JP granted initial claims without any modification

## CA-C

1. A plant cultivation system comprising:

- a nonporous hydrophilic film for cultivating a plant thereon;
- a feeding means for feeding water or a nutrient fluid to the lower surface of said nonporous hydrophilic film,
- said feeding means comprising at least one layer which is a water impermeable material layer or a water absorbing material layer,
- said at least one layer is laid and extends under said nonporous hydrophilic film,
- wherein, when said feeding means comprises both the water impermeable material layer and the water absorbing material layer, the water absorbing material layer is disposed between said nonporous hydrophilic film and said water impermeable material layer and in contact with the lower surface of said nonporous hydrophilic film;
- and a drip tube as an irrigation means for supplying water or a nutrient fluid to the feeding means,
- said drip tube being disposed below said nonporous hydrophilic film in a manner such that water or a nutrient fluid supplied from the drip tube is fed to the lower surface of the nonporous hydrophilic film.

CA granted heavily modified claim

# Examples of grants: WO2008035580

## CA-C

1. A plant cultivation system comprising:
  - a nonporous hydrophilic film for cultivating a plant thereon;
  - a feeding means for feeding water or a nutrient fluid to the lower surface of said nonporous hydrophilic film,
  - said feeding means comprising at least one layer which is a water impermeable material layer or a water absorbing material layer,
  - said at least one layer is laid and extends under said nonporous hydrophilic film,
  - wherein, when said feeding means comprises both the water impermeable material layer and the water absorbing material layer, the water absorbing material layer is disposed between said nonporous hydrophilic film and said water impermeable material layer and in contact with the lower surface of said nonporous hydrophilic film;
  - and a drip tube as an irrigation means for supplying water or a nutrient fluid to the feeding means,
  - said drip tube being disposed below said nonporous hydrophilic film in a manner such that water or a nutrient fluid supplied from the drip tube is fed to the lower surface of the nonporous hydrophilic film.

## US-B2

1. A plant cultivation system comprising:
  - a nonporous hydrophilic film for cultivating a plant thereon,
  - a feeding means for feeding water or a nutrient fluid to the lower surface of said nonporous hydrophilic film in the absence of a hydroponic tank for accommodating water or a nutrient fluid and cultivating a plant therein,
  - said feeding means comprising at least one layer selected from the group consisting of a water impermeable material layer and a water absorbing material layer,
  - which is laid and extends under said nonporous hydrophilic film,
  - wherein, when said feeding means comprises both of said water impermeable material layer and said water absorbing material layer, said water absorbing material layer is disposed between said nonporous hydrophilic film and said water impermeable material layer and is in contact with the lower surface of said nonporous hydrophilic film,
  - and a drip tube as an irrigation means for supplying water or a nutrient fluid to said feeding means,
  - said drip tube disposed below said nonporous hydrophilic film in a manner such that water or nutrient fluid supplied from said drip tube is fed to the lower surface of said nonporous hydrophilic film;
  - wherein said nonporous hydrophilic film is a film which exhibits an electrical conductivity (EC) difference of 4.5 dS/m or less,
  - said EC difference being determined by a method comprising contacting water with a saline solution having a salt concentration of 0.5% by weight through said nonporous hydrophilic film, measuring the electrical conductivity of each of the water and the saline solution 4 days (96 hours) after the start of the contact, and calculating the difference in electrical conductivity between the water and the saline solution.

US granted even more restricted claim

# ISR: 2 category A documents only

INTERNATIONAL SEARCH REPORT		International application No. PCT/JP2007/067578
<b>A. CLASSIFICATION OF SUBJECT MATTER</b> A01G27/00(2006.01)i, A01G1/00(2006.01)i, A01G7/00(2006.01)i, A01G13/00(2006.01)i, A01G25/00(2006.01)i  According to International Patent Classification (IPC) or to both national classification and IPC		
<b>B. FIELDS SEARCHED</b>  Minimum documentation searched (classification system followed by classification symbols) A01G27/00, A01G1/00, A01G7/00, A01G13/00, A01G25/00  Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched Jitsuyo Shinan Koho 1922-1996 Jitsuyo Shinan Toroku Koho 1996-2007 Kokai Jitsuyo Shinan Koho 1971-2007 Toroku Jitsuyo Shinan Koho 1994-2007  Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)		
<b>C. DOCUMENTS CONSIDERED TO BE RELEVANT</b>		
Category	Citation of document, with indication, where appropriate, of the relevant part thereof	Relevant page(s)
A	JP 2001-292643 A (Taiyo Kogyo Kabushiki Kaisha), 23 October, 2001 (23.10.01) Full text; all drawings (Family: none)	
A	JP 2003-506051 A (E.I. Du Pont De Nemours & Co.), 18 February, 2003 (18.02.03), Full text; all drawings & US 6484439 B1 & WO 2001/010192 A1 & EP 1530896 A2	1-13

Only A documents  
Only JP publications



# EP-A4: Supplementary EP search report



## SUPPLEMENTARY PARTIAL EUROPEAN SEARCH REPORT

Application Number

under Rule 62a and/or 63 of the European Patent Convention.  
This report shall be considered, for the purposes of  
subsequent proceedings, as the European search report

EP 07 82 8221

### 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 1 695 615 A1 (UNIV LAVAL [CA]) 30 August 2006 (2006-08-30) * paragraph [0011] - paragraph [0013]; figures * -----	1	INV. A01G27/00 A01G1/00 A01G7/00 A01G13/00 A01G25/00 A01G31/02

Also seen by CA and US examiners

US20070376748		US2006257213 A1 - 16 November 2006	
US20070376748		US2006257213 A1 - 16 November 2006	
EP20070828221	X	EP1695615 A1 (UNIV LAVAL [CA]) - 30 August 2006 * paragraph [0011] - paragraph [0013]; figure - *	1
US20070376748		CA2498077 A1 (UNIV LAVAL [CA]) - 23 August 2006	
US20070376748		CA2498070 A1 (SOLENO TEXTILES TECH INC [CA]) - 23 August 2006	

comparing citations in CCD

# Sample PCT/CA2013/00083

- **Granted:** AU, CA, MX
- **Rejected:** EP, US
- No NPE in CN, JP, KR
  
- ISA CA: category X in ISR
- Supplementary search by EP: Additional prior art of category X

# Family table for PCT NPEs sample cases

Case studies BH, LK, MY, TH, BT, PH, KH, LA workshops															
Status: Aug 17, 2016															
Simple Family															
National Application Numbers	PCT Member of Family	Size of Inpadoc Family	Number of Simple Families in Inpadoc Family	Grants	Withdrawn or Lapsed or Dead or Abandoned	Refused or Rejected	Pending	Earliest priority/first/last grant dates	Pending range	Grants but in Extended Family	Observations Observations A?)	ISR (only)	Observations lack of unity (in ISR, or national reports)	Supplementary prior art searches in national phases (e.g. EP-A4)	main claims available in English (different, equivalent, equal to WO-A1/2? To grants in other jurisdictions?)
BH 20080018 MY 149627A PH 1-2008-502595 TH?	<a href="#">PCT/KR2007/00247</a> 9 <a href="#">stable composition</a>	24	1	AU, CA, EA, EP, US, JP, CN, 2xKR, UA, MY, MA, MX, NZ, UA, (CR, SV, GT), <b>PH</b>			BH	2006-05-22 KR(2); 2009-09-18 KR; 2016-01-06 EP	3-10		only A ISA=KR		no, 2 KR grants are the 2 priorities	EP-A4 JP more than ISR AU more than ISR US more than ISR	<b>MY</b> equal to WO-A1 AU-B different to WO-A1: one substantial difference (lyophilizing) EP-B a bit narrower US-B only method (a bit narrower than AU) <b>PH</b> has US main claim as composition
BH 20090030 LA 96 MY 147396A PH 1-2009-500273 TH?	<a href="#">PCT/JP2007/06757</a> 8 <a href="#">plant cultivation</a>	34	7	AP, AU, 2xCN, US, NZ, CA, KR, EA, JP, MA, MX, MY, TW, UA, E(i2g), <b>PH</b>			EP, BH	2006-09-20 JP(2); 2008-09-03 JP; 2014-04-01 TW	2-8+	JP	only A, only JP ISA=JP		EP-A4 CA, US more than ISR add prior art by CA seen also by US;	AU, JP, <b>MY</b> equal to WO-A1; CA is narrower; US narrower than CA <b>PH</b> mc equal to US mc	
BH? KH 2012/0150 MY 156685A PH 1-2013-501448 TH?	<a href="#">PCT/JP2012/00023</a> 7 <a href="#">solid liquid separation</a>	16	1	AU, CA, CN, EP, JP, KR, MY, RU,				2011-01-24 JP(2); 2012-02-08 JP;	1-5		only A ISA=EP		JP, KR, US more than ISR	<b>AU, CA, mc equal to WO-A1</b>	
BH 20080005 MY 150185A PH none TH?	<a href="#">PCT/EP2007/05301</a> 5 <a href="#">energy conversion</a>	19													
BH 20090006 MY 153238A PH 1-2009-500135 TH?	<a href="#">PCT/EP2007/05738</a> 0 <a href="#">pyrogenic engine</a>	24													
BH 20090047 MY 151581A PH 1-2009-501523 TH?	<a href="#">PCT/JP2008/05010</a> 2 <a href="#">insulated tank</a>	30													
BH 20090066 MY 150324A PH none TH?	<a href="#">PCT/US2008/00119</a> <a href="#">remote control</a>	7													
BH 20090019 MY 151783A PH 1-2009-500417 TH?	<a href="#">PCT/EP2007/05918</a> <a href="#">compressed air engine</a>	25													
BH 20090028 MY 148768A PH 1-2009-500495	<a href="#">PCT/US2007/07432</a> 7 <a href="#">secure transaction</a>	21	1	AU, US, NZ, TW, GB, EA, MX, MY, UA,	US, <b>PH</b>	EP, KR, JP business method	BH	2006-09-18 US+EP, GB; 2009-01-07 GB; 2014-09-21 TW	3-8		Y, A; only US ISA=US		KR, US more than ISR JP, US more than ISR AU only ISR	<b>AU and US equal and different from WO</b> GB different from AU and US <b>MY</b> appears 2b equal to GB CA, EP and AU different from WO-A1; subtle differences of EP and AU re catalyst layer details; CA and AU very similar but no	
BH 20080024 MY 150103A PH none TH?	<a href="#">PCT/JP2007/050357</a> <a href="#">polyolefin</a>	15	1	AU, CN, CA, KR, JP, EP, MX, MY, RU, FI			BH	2006-06-14 FI; 2010-11-15 FI; 2015-08-05 EP	4-9		X,Y ISA=EP		EP-A4 add EP prior art not seen by others AU only ISR		

Systematic analysis of samples of **pending cases** at workshops with

- Smaller IPOs: Bahrain, Sri Lanka, Laos, Cambodia, Qatar, Bhutan, Oman, Mongolia, Papua New Guinea, Pakistan, Iran
- Medium IPOs: Malaysia, Thailand, Philippines, Viet Nam, Indonesia

What work products are available for other PCT national phase entries in other jurisdictions, and how useful are they?

How to implement systematic passive work-sharing to make examination more efficient?

- Mostly older applications
- > more likely that national phase examination is completed

# Evidence & conclusions derived from sample set

- Large patent families: **10++ members**
  - Many work products from many other national phases can be utilized
- Large fraction of families with grants: **>95%**
  - **Most likely a patent can be granted; but which claims from which country are best?**
  - The first foreign grant (PPH; e.g. for the sake of speediness)?
- Wide range of pendencies: **3-10 years** after priority filing
  - What is backlog? How long to wait?
- **Granted claims substantially different** from claims granted in other jurisdictions: **>60%**
  - **Careful selection of suitable claim sets**
- Granted claims different from WO-A1/2 claims: **>90%**
- **Additional prior art searches in national phases: >90%**
  - Take into account for claim selection or decision to await further results
  - Do not solely rely on ISR
- Grants in some, rejections and withdrawals on other jurisdiction: **20%**
  - Carefully analyze reasons for rejections/substantial withdrawals

# What are the opportunities of transparency?

- Examination work products are **easily visible**, after application is published, for
  - Examiners
  - Third parties
- Foreign examination work products are **usable** for
  - Examiners in national phase (improving efficiency and quality)
    - Particular opportunities for small offices with limited capacities
    - For treating backlog
  - Managers to monitor examination quality
  - **Third parties (you and/or competitors) to monitor prosecution, examination quality, prepare oppositions, ....**
- **General rule for examiners: Available** foreign examination work products **must not be ignored** for national phase examination for the sake of validity of patents granted
- At least a check of additional relevant prior art from a national top-up search is needed.

# What may change with Bangladesh Patent Act 2022 and with PCT accession?

- Applicants need to request substantive examination within 3 years after filing (Section 17)
- Work-sharing approaches supported (Section 12)
- Applications will no longer lapse after 21 months, i.e. examination may continue for a longer time
  - Facilitates work-sharing (using final examination results from foreign offices rather than intermediary)
- PCT: national phase entry now simultaneously with other countries
  - Examination by work-sharing may effectively start earlier than now and more foreign work products may be considered
  - Work-sharing will effectively improve the validity of patent grants
  - Work-sharing enables a more effective use of examiner resources because novelty and obviousness analysis may not need be done inhouse

# What about opportunities for attorneys?

- May monitor the examination quality by comparing with examination results from other offices
  - Pending too long?
  - Considered all relevant prior art?
- May better understand an argument or a proposal made by the examiner because it may be based on findings established by other examiners
  - For example a proposal for granting a particular claim set granted already abroad
- Monitor the actions of foreign attorneys representing the same applicant in other countries
  - How do they argue or respond? What do they propose?

Thank you

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